

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

AUG 10, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Klein Bicycle Corporation

Serial No. 74/436,521

Jim Zegeer for Klein Bicycle Corporation.

Andrew P. Baxley, Trademark Examining Attorney, Law Office
104 (Sidney I. Moskowitz, Managing Attorney).

Before Simms, Hairston and Walters, Administrative Trademark
Judges.

Opinion by Simms, Administrative Trademark Judge:

Klein Bicycle Corporation (applicant), a corporation of
the state of Washington, has appealed from the final refusal
of the Trademark Examining Attorney to register the mark
PRIME for high technology bicycle tire rims.¹ The Examining
Attorney has refused registration under Section 2(d) of the
Act, 15 USC §1052(d), on the basis of Registration No.
1,898,080, issued June 6, 1995, for the mark PRIME AERO (in

¹ Application Serial No. 74/436,521, filed September 17, 1993,
based upon applicant's bona fide intention to use the mark in
commerce under Section 1(b) of the Act, 15 USC §1051(b).

the form shown below) for bicycles and structural parts thereof: namely, frames, brakes, chains, handlebars,

PRIME AERO

saddles, gears, wheels, and gear shifters.²

Applicant and the Examining Attorney have submitted briefs but no oral hearing was requested.

We affirm.

Applicant argues that confusion is unlikely for several reasons. First, applicant points to the suggestive nature of the term "PRIME," as well as a number of third-party registrations which include the term "PRIME."³ Accordingly, applicant argues that the term "PRIME" is a weak mark and that, therefore, protection should be afforded against only substantially similar trademarks which contain this word.

With respect to the goods, applicant maintains that its high

² In his appeal brief, the Examining Attorney has withdrawn the refusal of registration under Section 2(d) with respect to two other registered marks which the Examining Attorney had earlier cited against registration of applicant's mark. These two registrations, both held by the same entity, covered the marks PRIME and PRIME USA for a number of items of bike clothing as well as identification plates for bicycles, among other goods. The Examining Attorney has stated that one of these registrations has become "abandoned," while an affidavit filed under Sections 8 and 15 of the Trademark Act, 15 USC §§1058 and 1065, deleted "the relevant goods" from the identification in the other registration.

³ Applicant has submitted a computer printout of over four hundred such third-party registrations.

technology bicycle rims will likely be purchased by discriminating purchasers who are not likely to be confused.

The Examining Attorney concedes that "PRIME" is a "laudatorily suggestive" word meaning, among other things, "of first importance," "first in rank, authority, or significance," or "having the highest quality or value." The Examining Attorney argues, however, that "PRIME" is the dominant part of the registered mark "PRIME AERO." The term "AERO" in the registered mark, as used in connection with the goods listed in the registration, would be considered "puffery," according to the Examining Attorney, because "bicycles generally do not fly in an aeronautic sense." Brief, 3. It is the Examining Attorney's position that the common use of "PRIME" in both marks gives them the "same overall commercial impression."

Further, the common use of PRIME by the applicant and the registrant is likely to cause reverse confusion by giving consumers, who retain only a general recollection of trademarks, a mistaken belief that that [sic] prime is a house mark for both the applicant's and the registrant's goods and that PRIME AERO bicycles and structural parts therefor are made by the applicant.

Brief, 3.

With respect to the goods, the Examining Attorney points out that there is no limitation in the registration. Accordingly, the Examining Attorney states that he must presume that registrant's goods include "high technology"

bicycles and parts therefor. According to the Examining Attorney, applicant's goods may, therefore, be replacement parts for registrant's bicycles. The Examining Attorney also notes that the registration lists "wheels," goods which are identical or similar to applicant's tire rims. The Examining Attorney argues that the goods of registrant and applicant would be sold in the same channels of trade (bicycle stores) to the same class of purchasers -- bicyclists.

We agree with the Examining Attorney that the respective goods are substantially similar. And, as we and the Court of Appeals for the Federal Circuit have noted, where the goods are identical or substantially similar, less similarity is required in the marks in order to support a finding of likelihood of confusion. *Century 21 Real Estate v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

With respect to the marks -- PRIME and PRIME AERO -- we believe this is a relatively close case. The registered mark contains the additional word "AERO" not contained in applicant's mark. This word creates some difference in the respective marks. However, given the fallibility of memory and other factors, consumers may well believe that bicycle parts sold under the marks PRIME and PRIME AERO come from the same source. Purchasers may well believe, as the

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Examining Attorney contends, that PRIME is a house mark and that the PRIME AERO goods are another line of products coming from the same source. If there is any doubt in this matter, according to precedent, that doubt must be resolved in favor of the registrant and against the newcomer. We also observe, as did the Examining Attorney, that the numerous third-party registrations cover goods remote from bicycle equipment (except for the registration covering the mark PRIME VISION for a type of bicycle computer). In any event, third-party registrations, without more, are not evidence of what happens in the marketplace or that the public is familiar with them. See *AMF Inc. v. American Leisure Products Inc.*, 474 F.2d 1403, 177 USPQ 268, 269-70 (CCPA 1973).

Decision: The refusal of registration is affirmed.

R. L. Simms

P. T. Hairston

C. E. Walters
Administrative Trademark
Judges,
Trademark Trial and
Appeal Board