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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Mark S. Dimulias

Serial No. 78353428

Thomas P. Philbrick of Allmark Trademark for Mark S.
Dimulias

Mary Boagni, Trademark Examining Attorney, Law Office 114
(K. Margaret Le, Managing Attorney)

Before Seeherman, Walters and Bucher, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Mark S. Dimulias has appealed from the final refusal of the Trademark Examining Attorney to register EVIL TWINS and design, as shown below, as a collective membership mark for "indicating membership in a motorcycle club."¹ The lining shown in the drawing is a feature of the mark. The

¹ Application Serial No. 78353428, filed January 17, 2004, based on Section 1(b) of the Trademark Act (intent-to-use).

colors black, red, blue, yellow, orange, and gray are claimed as a feature of the mark.

The wording Evil Twins and MC are in red lettering on blue background banners. The pitchforks are red. The devils are red with yellow and orange teeth. The engine body graphic is gray. The engine flames are yellow, orange and red. The background behind the blue banners, pitchforks, devil heads and engines is black.

Applicant has disclaimed exclusive rights to use MC apart from the mark as shown.



Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the mark EVIL TWIN, previously registered for "motorcycles,"² that, if used as a collective membership mark for a motorcycle club, it is likely to cause confusion or mistake or to deceive.

Applicant and the Examining Attorney have filed briefs.³ Applicant did not request an oral hearing.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic*

² Registration No. 2589088, issued July 2, 2002.

³ With its brief applicant submitted two exhibits, with Exhibit A consisting of a large number of third-party registrations. It appears that, for the most part, these registrations were previously submitted with applicant's request for reconsideration; the only difference is that the earlier filed registrations were taken from the USPTO TARR database, and the documents filed with the appeal brief were taken from the USPTO TESS database. Therefore, we consider them to be legal equivalents. However, to the extent that any additional registrations were submitted with the brief, they have not been considered. See Trademark Rule 2.142(d) (the record in an application should be complete as of the filing of the notice of appeal). The Exhibit B that is attached to the appeal brief appears to be a slightly different version of the Exhibit B that was attached to applicant's request for reconsideration. Because it is the earlier-submitted version that is properly of record, that is the exhibit that we have considered in making our decision herein. We add, though, that our decision would be the same if the later-filed version had been made of record.

Distilling Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In this case, because applicant has applied to register a collective membership mark, we are not dealing with "services" per se, but the indication of membership in a motorcycle club.

Thus, although the ultimate inquiry is the same, the analysis under Section 2(d) with respect to collective membership marks is somewhat different from that with respect to trademarks or service marks. The trademark or service mark analysis typically involves a determination of likelihood of confusion among purchasers as to the source of goods or services. However, as the Board stated in *In re Code Consultants Inc.*, 60 USPQ2d 1699, 1700-01 (TTAB 2001), a collective membership mark does not involve purchasers of goods or services. The sole purpose of a collective membership mark is to indicate membership in an organization. While goods or services may be provided by the members of an organization, a collective membership

mark, as used or displayed by the members of an organization, serves only to identify the fact that such members belong to the collective organization and to inform relevant persons of the members' association with the organization. See, e.g., *Allstate Life Insurance Company et al. v. Cuna International, Inc.*, 169 USPQ 313 (TTAB 1971). Thus, the finding of likelihood of confusion between a collective membership mark and a trademark or service mark is not based on confusion as to the source of any goods or services which happen to be provided by the members of the collective organization. Rather, the question is whether relevant persons are likely to believe that the collective organization is endorsed by or in some other way associated with the owner of the trademark for the goods.

Nevertheless, the principles involved in the analysis of the du Pont factor of the similarity of goods/services are similar, i.e., are the goods and the indication of membership in a motorcycle club sufficiently related that, if confusingly similar marks were used in connection with them, relevant persons would be likely to believe that the motorcycle club in which the mark indicates membership is sponsored by or affiliated with the source of the motorcycles. Relevant persons in the context of

applicant's collective membership mark do not consist of "purchasers" as such, but rather could encompass all who might know of the motorcycle club and then become purchasers or potential purchasers of motorcycles or, conversely, could be purchasers or potential purchasers of motorcycles and then be exposed to the membership mark.

Applicant quotes from a book published by Matthew Bender to assert that "in analyzing noncompeting goods [in] trademark cases, courts often consider a list of factors developed from prior case law." The quote goes on to list particular factors, including "whether the respective products are of the same genus" and "the fame of the owner's mark."⁴ It appears that the quote is referring to the entire likelihood of confusion analysis, and not to the individual factor of the similarity of the goods/services. As noted, we are guided in the analysis of likelihood of confusion by the factors listed in the du Pont decision. With respect to the particular factor of the similarity of the goods/services, we follow the well-established principle, set forth in *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978):

It is not necessary that the goods of the parties be similar or competitive,

⁴ The citation provided by applicant is "2-5 Trademark Protection and Practice §5.05."

or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer.

To demonstrate the necessary relationship between motorcycles and membership in a motorcycle club, the Examining Attorney has submitted a number of third-party registrations which show that such companies as Harley-Davidson, Inc. and Indian Motorcycle International, LLC have registered their marks for motorcycle club services or for association services, namely, promoting the interests of motorcycle riders. See Registration No. 1455825 for HARLEY OWNERS GROUP and Registration No. 1436034 for LADIES OF HARLEY, and Registration No. 2914846 for INDIAN. The Examining Attorney has also made of record third-party registrations owned by automobile companies for use of their marks for motor club services. See, for example, Registration No. 2742936 for FORDDIRECT, owned by Ford Motor Company, for, inter alia, motor clubs, namely automobile clubs and Registration No. 1848622 for MERCEDES-BENZ CLUB and design, owned by Daimlerchrysler AG for,

inter alia, services of an automobile club, namely, arranging and conducting motor sport competitions, and organizing and conducting meetings of a social nature.

In addition, the Examining Attorney has submitted Internet web pages which show a connection between motorcycle clubs and motorcycles with specific trademarks, including, in the first-listed excerpt, a statement that motorcycle club websites are linked to the websites of the motorcycles themselves:

Motorcycle Clubs

Some clubs exist to further a particular make and model such as the Honda PC-800 club, the GWRRA, or the Cushman Motor Scooter Club.

...That's why I continue to make a concerted effort to seek out motorcycle clubs that have Web sites and get them linked to the Motorcycles site. ... I would also hope that each club Web site would also put up a link to the Motorcycles site.

[http://motorcycles.about.com/cs/clubsand groups/a/motorcycleclubs.htm](http://motorcycles.about.com/cs/clubsandgroups/a/motorcycleclubs.htm)

Kawasaki Owners Club

Description

A Mailing list/Forum for owners and enthusiasts of Kawasaki Motorcycles. Meet others and share your experiences with Kawasaki motorcycles. All are invited to join. Here you can discuss the bikes, post pictures, add links etc. This site has been created as a resource for all Kawasaki owners and enthusiast's. [sic]

[htt://motorcylces.about.com/gi/dynamic/offsite.htm](http://motorcylces.about.com/gi/dynamic/offsite.htm)

There are also search summaries from the Google website which, because they are fragments, are rather limited in what they show,⁵ but there are several listings of "Honda Riders Association—HRA: The office Honda motorcycle club," and the "Kawasaki Motorcycle Club."

Applicant discounts this evidence because:

in every example cited by the Examining Attorney, the "enthusiast" club involved an undeniably "famous" trademark and/or product. This includes the attachments for "Kawasaki Motorcycle Club," "Suzuki Motorcycle Club," "Honda Motorcycle Club," "Indian Motorcycle Club of America," and the "Harley Owners Group." There can be no doubt that every one of these clubs concerns a "famous" motorcycle brand.

Brief, p. 4. (emphasis in original). However, with respect to the mark EVIL TWIN, it is applicant's position that this brand is not famous; rather, these motorcycles "are unknown to anyone remotely familiar with motorcycles." Brief, p. 4. Thus, while applicant acknowledges the credibility of the Examining Attorney's argument that "a consumer who encounters a mark indicating membership in a motorcycle club is likely to believe that the registrant's motorcycles are endorsed by ... the collective organization" when a

⁵ See TBMP §1208.03 (a search result summary from a search engine, such as Yahoo! or Google, which shows use of a phrase as key words by the search engine, is of limited probative value.)

famous brand of motorcycle is involved, he argues that "the same cannot be said for obscure, non-famous makes of motorcycles." Brief, p. 5.

We consider the evidence of record, along with applicant's acknowledgements, sufficient to show that companies that make motorcycles also have trademarks for motorcycle clubs, and/or sponsor or are affiliated with motorcycle clubs and the services connected with such clubs. Further, there is obviously a complementary relationship between motorcycle clubs and motorcycles; motorcycle clubs are clearly clubs for people who own and/or ride motorcycles. Thus, the relevant persons for applicant's membership mark and the purchasers of the registrant's goods are, in part, the same. See *In re Code Consultants Inc.*, supra.⁶ The fact that there is no evidence that EVIL TWIN is a famous mark for motorcycles does not affect the relatedness of motorcycle clubs and motorcycles. Moreover, for purposes of our analysis, we cannot accept applicant's statement that EVIL TWIN motorcycles "are unknown to anyone remotely familiar with motorcycles." Obviously, if we posit that no one has seen

⁶ As discussed infra, the relevant public would also include a motorcycle purchaser or potential purchaser who is exposed to a motorcycle club membership mark through news reports.

or heard of a cited mark, or will ever encounter it, there would never be a likelihood of confusion. But we are required to determine likelihood of confusion based on what is on the Register. The question, thus, is whether those people who are familiar with EVIL TWIN motorcycles might encounter applicant's mark indicating membership in a motorcycle club and, if so, whether they might believe that a motorcycle club membership is related to motorcycles, such that a connection in affiliation or sponsorship will be presumed if confusingly similar marks are used.

For the reasons we have discussed above, we answer both questions in the affirmative. Simply put, people who own motorcycles (including the EVIL TWIN motorcycle) are likely to encounter motorcycle clubs and/or offers of membership in such a club. Therefore, they may be exposed to both applicant's and the registrant's marks. Further, because of the evidence that owners of trademarks for motorcycles own registrations for motorcycle club services and/or have official motorcycle clubs, and because of the complementary nature of motorcycles and motorcycle clubs, the consuming public is likely to assume a connection if confusingly similar marks were used for both.

We note that applicant has submitted a large number of third-party registrations for motorcycle club services that

do not contain a motorcycle mark, or for which there is no corresponding motorcycle mark.⁷ There is no question that a mark may be registered for motorcycle club services or to indicate membership in a motorcycle club which makes no reference to a trademark for motorcycles. Further, it is likely that, compared to the total number of motorcycle club service marks, there would be very few membership/motorcycle club service marks that are the same as or a variation of a mark for motorcycles, since there are a limited number of motorcycle brands. The fact that applicant has submitted so many "unaffiliated" third-party marks, however, does not affect our conclusion that applicant's motorcycle club and motorcycles are related. The question before us is whether, if a trademark for a motorcycle is used as, or as part of, a collective mark indicating membership in a motorcycle club, relevant persons would be likely to assume a connection or affiliation with or sponsorship by the owner of the

⁷ Applicant has stated that in his search of the Office records for "goods/services motorcycle club!" and status, "not a single motorcycle club mark was also registered in connection with actual motorcycles." (emphasis in original), brief, p. 7. However, as the Harley-Davidson registrations show, the marks for motorcycle club services appear to be a variation on the name HARLEY-DAVIDSON, including LADIES OF HARLEY and HARLEY OWNERS CLUB. The same is true for the marks for automobile club services, e.g., MERCEDES-BENZ CLUB and design and FORDDIRECT.

motorcycle trademark. As stated previously, the answer to that question is yes.

This brings us to a consideration of the marks. We note that the registered mark, EVIL TWIN, must be considered a strong mark. Applicant states that, while it "is admittedly not a particularly 'weak' mark, it is also not an obviously 'strong' mark such as 'Kodak' or Cisco'." Brief, p. 4. Although the registered mark is not an invented term like KODAK, but consists of two recognizable English words, EVIL TWIN is an arbitrary term as applied to motorcycles, and therefore is entitled to a broad scope of protection. Moreover, there is no evidence of any third-party uses of EVIL TWIN or similar marks which might indicate that relevant persons would look to other elements of the mark to distinguish one EVIL TWIN mark from another. The du Pont factor of the number of similar marks for use on similar goods/services therefore favors a finding of likelihood of confusion.

As noted previously, the registered mark is EVIL TWIN. Applicant's mark is EVIL TWINS depicted on a scroll, situated above a design of two devils and two exhausts that are essentially in a mirror image. The letters MC, which stand for motorcycle club, appear in smaller letters to the right of, and toward the bottom of, the design.

It is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). In the present case, although the design element in applicant's mark figures prominently, it is our view that the word portion, EVIL TWINS, is the dominant element and deserves greater weight in our comparison of the marks. The words EVIL TWINS is how the motorcycle club would be referred to when speaking of it, as it is the only element that can be articulated. As a result, the words are likely to make a stronger impression. See In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987). Further, the design element reinforces the meaning of the words, as the design would be perceived as twin devils, i.e., evil twins. The two engine bodies continue the twin motif. All in all, while the design adds certain differences to the appearance of the marks, these differences in appearance are outweighed by the identical pronunciation and connotation of the marks. Although the relevant persons may certainly note the

design, they are likely to regard applicant's mark as a variation of the word mark EVIL TWIN. This is especially likely in view of the fact that many of the motorcycle and automobile club registrations are for marks that are variations on the marks used for motorcycles and automobiles. Thus, we find that the marks convey similar commercial impressions.

We add that we are aware that applicant's mark uses the words EVIL TWINS, while the cited mark is for EVIL TWIN. However, we do not think that relevant persons will note the presence or absence of the "S" or, if they do, that they will ascribe any source-differentiating significance to it. Similarly, while we note the additional element MC in applicant's mark, these letters, which are a recognized abbreviation for "motorcycle club" and have been disclaimed by applicant in acknowledgement of this fact, do not have any source-indicating significance. To the extent that relevant persons notice the letters, they will assume that they are present in this mark, and not in the registered mark EVIL TWIN, because this mark is used for a motorcycle club, while EVIL TWIN is used for motorcycles.

Applicant has argued that "the 'motorcycle club' community is extremely sophisticated in matters of

motorcycles and motorcycle clubs." Brief, p. 6. Applicant further asserts that the commitment of a member to his club comes above family, friends, job, personal possessions and personal safety, and that the process of becoming a formal member takes several years. As a result, applicant argues that the decision to become a member of a club is not made on impulse. Applicant apparently bases these assertions on Exhibit B, which is a policy statement by a particular motorcycle club about what a motorcycle club is. We note that this policy statement also recognizes that "there are many lesser clubs whose membership is made up of equally lesser individuals." It would appear from this statement that not all clubs would have the same rules about becoming a member.

However, even if we accept that it takes a certain amount of time to become a full member of a club, such that, before one ultimately would join applicant's club, one would know that the club is not associated with the maker of EVIL TWIN motorcycles, that is not determinative of the question of likelihood of confusion. The question is whether one might first consider or attempt to join the club because he believes that there is an association or connection. We do not dispute that one making a decision to join a club will note the differences between EVIL TWIN

and applicant's EVIL TWINS and design marks; however, as discussed, they will not ascribe these differences to different sources of the goods/membership club. As to the sophistication of motorcycle club members or potential members, because there is evidence, as discussed above, that manufacturers of motorcycles (and cars) use and/or register their motorcycle (and automobile) marks or a variation thereof for motorcycle (and automobile) clubs and/or club services, the fact that those in the motorcycle club community are sophisticated will not prevent them from believing that there is an association between the maker of a motorcycle and a motorcycle club if a similar mark is used for both.

We also point out that members or potential members of applicant's motorcycle club are not the only persons that are likely to be confused. The general public may be aware of motorcycle clubs through news reports, especially if, as Exhibit B mentions, "one club causes a problem that touches the public sector." That exhibit goes on to say that in that situation, "the general public does not draw a distinction between different club colors," and "the offending club's identity is either confused or ignored, and heat comes down to suppress all clubs." As a result, if applicant's motorcycle club, identified by its EVIL

TWINS and design mark, receives bad publicity, it might affect the purchasing decision of someone who is not a motorcycle aficionado or part of the club community, and result in his not buying a EVIL TWIN motorcycle.

After considering all the du Pont factors on which there is evidence or argument, we find that, if applicant were to use his applied-for mark to indicating membership in a motorcycle club, it is likely to cause confusion with the previously registered mark EVIL TWIN for motorcycles.

Decision: The refusal of registration is affirmed.