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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Kumho Tire Co., Inc.

Serial No. 77377089

Laurel V. Dineff and R. Peter Spies of Dineff Trademark Law Limited for Kumho Tire Co., Inc.

Paul E. Fahrenkopf, Trademark Examining Attorney, Law Office 101 (Ronald R. Sussman, Managing Attorney).

Before Walters, Mermelstein and Ritchie, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Kumho Tire Co., Inc. has filed an application to register the standard character mark ECSTA LX PLATINUM on the Principal Register for "tires; inner tubes for vehicle tires; mud flaps for vehicles; inner tubes," in International Class 12.¹ Applicant voluntarily entered a disclaimer of PLATINUM apart from the mark as a whole.

¹ Serial No. 77377089, filed January 1, 2008, based on an allegation of a bona fide intention to use the mark in commerce.

The examining attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark PLATINUM previously registered for "tires,"² that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.

Applicant has appealed. Both applicant and the examining attorney have filed briefs. We reverse the refusal to register.

Introduction

Applicant contends that the registered mark, PLATINUM, is a weak mark because the term is laudatory and, thus, it is entitled to only a limited scope of protection; that ECSTA, applicant's alleged house mark, is the dominant portion of its mark because ECSTA is arbitrary and it is the first word in its mark; and that the ECSTA LX portion of its mark is sufficient to distinguish the marks. In support of its statement that ECSTA is its house mark, applicant notes its ownership of the following active registrations:

- No. 1936287 - ECSTA for "automobile tires and inner tubes";

² Registration No. 3507520 issued September 30, 2008. The owner is PT. Multistrada Arah Sarana.

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- No. 2739837 - ECSTA STX for "brake pads for land vehicles, brake linings for land vehicles, windshield wipers, automobile tires, and parts for automobile tires, namely - tubes for reserve air and flaps to combine the tubes to the tires"; and
- No. 2782283 - ECSTA SUPRA for "tires."

In support of its position that PLATINUM is a weak, laudatory term, applicant submitted excerpts from Internet websites, as follows:

- Pokemon Platinum Version - pokemonplatinum.com
- Wells Fargo Platinum Card - wellsfargo.com
- VMware Platinum Support & Subscription Service - vmware.com
- MasterCard Platinum Credit Cards - mastercard.com
- AAdvantage Platinum - aa.com
- Citi Platinum Select MasterCard - citicard.com
- Shell Platinum MasterCard - shell.us
- Priscilla of Boston - platinum bridal gown collection - priscillaofboston.com
- Platinum Card from American Express - americanexpress.com

Applicant submitted the following excerpts from Internet websites³ pertaining to the auto accessory industry:

- Tires-easy.com; bizrate.com - American Radials - Platinum tires
- Best-price.com - Enkei performance LSF Platinum; Metallic Wheels; Westin Platinum Wheel To Wheel Nerf Bars Ford F-450...

³ References at Ultrawheel.com and wheelsnext.com to "Platinum wheels," and references at Thewheelsconnection.com and hubcap-tire-wheel.com to "Platinum Wheels and Platinum Rims," could refer to registrant's goods. Thus, we do not consider these excerpts to be of probative value.

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- Local.yahoo.com - Platinum Tire Center - Allen Park, MI
- Ebay.com - Letro Legend Platinum Tires Wheel White.
- Keystone-auto.com - Platinum Plus label meets our own rigorous standard for quality. Platinum Plus program - replacement parts aimed at collision centers.

Applicant submitted copies of the following third-party registrations in support of its position that applicant is but one among a crowded field of registrations with marks containing the weak, laudatory term PLATINUM in International Class 12:

- **PLATIN**, US Reg. No. 3352617 for "land vehicles and parts and fittings therefor, namely, **tires**, wheels, wheel rims; aircraft, airplanes and parts and fittings therefor, namely, tires, wheels, wheel rims" in Class 12. The word PLATIN is the German word for PLATINUM.
- **LIQUIDPLATINUM**, US Reg. No. 3378589, for "truck parts and accessories, namely, fenders and fender attachment brackets" in Class 12.
- **PLATINUM**, US Reg. No. 3241812, for "bicycles; bicycle parts, namely, front forks, bicycle cranks, bicycle rims, seatposts, handlebars, bottom brackets, chainrings, headset bearings, bicycle hubs, bicycle spokes, bicycle brakes, bicycle chains, handlebar stems, and bicycle gears" in Class 12.
- **PLATINUM PLUS**, US Reg. No. 3156184, for "land vehicle parts, namely, automobile structural parts, namely, body panels, bumpers and bumper covers; turn signals for vehicles" in Class 12.
- **PLATINUM**, US Reg. No. 2992266, for "flatbed utility trailers" in Class 12.
- **PLATINUM SERIES**, US Reg. No. 2994844, for "helm chairs" in Class 12.

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- **PLATINUM**, US Reg. No. 2927989, for "seat belts for use in vehicles" in Class 12.
- **PLATINUM**, US Reg. No. 2973717, for "tie down straps, tarp straps for use on moving vehicles" in Class 12
- **F-150 PLATINUM**, US Reg. No. 3722751, for "land motor vehicles, namely, automobiles; exterior insignia badges for vehicles" in Class 12.
- **PLATINUM**, US Reg. No. 2638435, for "recreational vehicles, namely, motor homes" in Class 12.
- **PLATINUM**, US Reg. No. 2067466, for "high performance motorcycle parts, namely, motorcycle, exhaust systems comprised of mufflers and exhaust pipes" in Class 12.

Applicant also submitted evidence with its brief purporting to show registrant's actual use of its registered mark. The examining attorney properly objected to this untimely submission of evidence and we have given it no consideration.

The examining attorney states that both identifications of goods include "tires," and, thus, the goods are identical in part and applicant's "inner tubes for vehicle tires," are closely related to "tires" because they are an integral part of some tires. He also acknowledges that the registered mark, PLATINUM, is a weak mark because the term is laudatory; and that PLATINUM is not the dominant portion of applicant's mark. He contends that, even though the registered mark may be weak, it is

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entitled to protection, particularly herein where the goods, tires, are identical.

The examining attorney contends that applicant has merely added its house mark to registrant's mark, which increases, rather than decreases, the likelihood of confusion, alleging that "LX" is a commonly used letter combination and, thus, does nothing to distinguish the marks.

The examining attorney challenged the relevance of applicant's evidence, asserting that only uses or third-party registrations pertaining to the identical goods, tires, are probative given the highly suggestive nature of the registered mark. He added that the one coexisting third-party registration for PLATIN for, in part, tires, is not probative because consumers are unlikely to translate the German term into its English equivalent, i.e., PLATINUM.

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *See In re E. I. du Pont de Nemours and Co.*, 476 f.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin maison*

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Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

The Goods, Channels of Trade and Consumers

The question of likelihood of confusion must be determined based on an analysis of the goods recited in applicant's application vis-à-vis the goods recited in the registration, rather than what the evidence shows the goods actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987).

While applicant's identification of goods includes several items, one of these items is "tires," which is identical to the "tires" identified in the cited registration. Moreover, we agree that, at least,

applicant's "inner tubes for vehicle tires" are closely related to registrant's "tires." To find that the goods are the same for the likelihood of confusion analysis, it is only necessary that one of the items within applicant's identification of goods be the same as or related to registrant's goods.

Moreover, because at least two of applicant's identified goods are identical or closely related to registrant's goods, we must presume that they travel in the same channels of trade and are sold to the same classes of consumers. *See Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers").

These *du Pont* factors weigh against registration.

The Marks

We now consider whether applicant's mark and the registered mark, when viewed in their entireties, are similar in terms of appearance, sound, connotation and commercial impression. In analyzing the similarity or dissimilarity of the marks, we are mindful that where, as here, the goods at issue are identical, the degree of similarity between the marks need not be as great as where there is recognizable disparity between goods. *In re Tender Tootsies Limited*, 185 USPQ 627, 628-629 (TTAB 1975).

The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715 (TTAB 2008). Furthermore, although the marks at issue must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Both applicant's and registrant's standard character marks contain the word PLATINUM. In fact, PLATINUM is registrant's mark in its entirety. Applicant's mark consists of the word PLATINUM preceded by the wording ECSTA LX.

We do not agree with the examining attorney's analysis of applicant's evidence. We find that this evidence, particularly the evidence of use of the term PLATINUM, is relevant for determining the strength or weakness of the registered mark.

We note that there is no evidence in the record as to a specific meaning of PLATINUM. However, the extensive evidence of third-party use and registration submitted by applicant suggests that the term may be perceived as indicating quality; and the number of third-party uses and registrations indicates that PLATINUM may be a weak mark in connection with tires, automotive goods and a wide range of products. Nonetheless, even weak marks are entitled to protection and applicant has not challenged the registrability of the cited mark, which it can do only in the context of a cancellation proceeding.

There is nothing in the record to indicate that ECSTA is other than an arbitrary term in connection with the identified goods. There is also no evidence as to the

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significance of LX in connection with these goods, thus, we cannot conclude that it is merely descriptive and of no significance. As such, the similarity of the marks turns on whether the addition of ECSTA LX is sufficient to distinguish the marks for these identical goods.

We find that it is. With the suggestive term "PLATINUM" as the sole shared term between the mark in the application and that in the cited registration, we find the marks to be more dissimilar than they are similar in sight, sound, and commercial impression.

This is analogous to the case of *Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313 (TTAB 2005) (NORTON MCNAUGHTON ESSENTIALS allowed to register despite opposition from owner of ESSENTIALS). There, in a situation similar to this one, the parties had in-part-identical goods and the applied-for-mark incorporated in full the registered mark. The Board found, however, that the registered mark (*i.e.*, the shared term) was "highly suggestive as applied to the parties'" goods. *Id.* at 1315. Furthermore, the Board found that the addition of applicant's house mark to what the evidence had shown to be a "highly suggestive" shared term resulted in a showing of no likelihood of confusion. Presented with similar circumstances here we reach the same result.

In sum, we find that, viewed in their entirety, the dissimilarities of the marks outweigh their similarities.⁴ We further find that consumers would be likely to distinguish the marks based on those differences. Accordingly, we find that this *du Pont* factor weighs in favor of registration.

Conclusion

Despite the identity of the goods, we find the factor of the distinctions in the marks sufficient to avoid a likelihood of confusion.

Decision: The refusal under Section 2(d) of the Act is reversed.

⁴ This result is without prejudice to an opposition, which might include different evidence and produce a different result.