

THIS OPINION
IS NOT A PRECEDENT
OF
THE TTAB

January 22, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Tire Mart, Inc.

Serial No. 78292388

Laila S. Wolfgram, Stinson Morrison Hecker, LLP for applicant
Tire Mart, Inc.

Christopher L. Boungiorno, Examining Attorney, Law Office 102
(Matthew Kline, Senior Attorney).

Before Walters, Bucher, and Mermelstein, Administrative Trademark
Judges.

Opinion by Mermelstein, Administrative Trademark Judge:

Tire Mart, Inc. has applied to register the mark shown below
on the Principal Register for "tires for motor vehicles" in
International Class 12.¹



On January 16, 2006, following publication for opposition,
applicant filed a statement of use pursuant to Trademark Act

§ 1(d); 15 U.S.C. § 1051(d), alleging dates of use in commerce and first use of the mark "at least as early as" July 29, 2004. With its statement of use, "applicant ... submitt[ed] [two] specimen[s] ... consisting of ... photographs of [a] tire showing [the] mark in tire tread."

The examining attorney has made final a refusal to register the mark on the basis that the mark as used in the specimens of record is merely ornamental, and does not function as an indication of source. Trademark Act §§ 1, 2, and 45; 15 U.S.C. §§ 1051, 1052, and 1127. As the examining attorney noted, "the specimens show the proposed mark appearing on the topside of tires in an ornamental fashion[and] trademarks for tires do not customarily appear so that they are perceived as being incorporated in the tread of the tire." Final Office Action, September 18, 2006.

The specimens submitted by applicant are reproduced below. As can be readily seen, applicant's lightning bolt design is molded into the goods beginning on the outside shoulder of the tire, and extending onto the sidewall. The design is molded in groups of three lightning bolt designs decreasing in size closer to the bead, and arranged radially around the tire. While the record does not include the depiction of an entire tire, it is

¹ Filing date August 26, 2003, based on a *bona fide* intent to use the mark in commerce.

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estimated that the groups of three lightning bolts are repeated fifteen to twenty times around the tire.



Applicant filed a timely appeal from the final refusal to register. Both applicant and the examining attorney have filed briefs. We reverse.

At the outset, we wish to make clear that this case is not about whether the mark, as molded into applicant's goods, is functional, as now codified in Trademark Act § 2(e)(5); 15 U.S.C. § 1152(e)(5). The stated refusal, evidence, and arguments have all been directed to the examining attorney's refusal on the ground that the

specimens reveal that the mark appears on the topside of tires in an ornamental fashion. Because trademarks for tires do not customarily appear so that they are perceived as being incorporated in the tread of the tire, the examining attorney refuses registration on the Principal Register because of ornamental use of the mark. Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§ 1051, 1052 and 1127.

Office Action, March 21, 2006.

Accordingly, we express no opinion as to whether applicant's mark, as molded into the goods, serves any functional purpose, and if so, whether that function renders the mark unregistrable under Trademark Act § 2(e)(5). Compare *Goodyear Tire and Rubber Co. v. Interco Tire Corp. (US Pats)*, 49 USPQ2d 1705 (TTAB 1998) (tire tread design held unregistrable as functional).

Applicable Law

The purpose of a trademark is to identify the source of the associated goods in commerce and distinguish them from the goods of others; any "mark" which cannot or does not do this is simply not a trademark. A designation which serves only as ornamentation or decoration on the goods is thus not registrable on the Principal Register. Trademark Act §§ 1 ("The owner of a trademark used in commerce..."), 2 ("No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless..."), 45 ("The term 'trademark' includes any word, name, symbol, or device ... used ... or [intended to be used] to identify and distinguish [the owner's] goods ... from those manufactured or sold by others and to indicate the source of the goods.") (emphasis added); see, e.g., *In re Villeroy & Boch S.A.R.L.*, 5 USPQ2d 1451 (TTAB 1987).

Nonetheless, just because a "mark" is visually pleasing or serves in some way to ornament the goods does not render it unregistrable if the mark is also inherently distinctive, *In re:*

Swift & Co., 223 F.2d 950, 106 USPQ 286, 288 (CCPA 1955), or if it has acquired distinctiveness.²

[W]hile not every sign used on a product, or on its label, package, etc., functions as an indication of source of the product on which it is used - e.g. some are merely part of the aesthetic ornamentation - the broad and liberal interpretation of our law is that, where such a sign also serves a source indicating function, it should be regarded as acceptable subject matter for registration. (citations omitted)

In re Paramount Pictures Corp., 213 USPQ 1111, 1113 (TTAB 1982).

In deciding this case, we must therefore determine whether applicant's mark is inherently distinctive; in other words, whether - as used on the specimens of record - the mark is an indication of source, notwithstanding any aesthetic qualities it may have.

Discussion

In response to the initial refusal (which included no supporting evidence) applicant submitted four examples of its use of the mark on other goods:

1. What appears to be a website banner on which the words "Pit Bull Tires" appears prominently. The letter "P" in "Pit Bull" ends in a zigzag design similar to the applied-for mark;³
2. What may be the "temporary tattoo" mentioned in applicant's response. The stylized words "Pitbull Tires"

² Although invited by the examining attorney to demonstrate acquired distinctiveness (if possible), applicant's arguments throughout examination and on appeal focus instead on the inherent distinctiveness of its mark. Accordingly, acquired distinctiveness is not an issue.

³ The banner also depicts a shirt and cap in the background of the right hand side. We cannot see whether the lightning bolt is depicted on the clothing.

are bordered on each end by a horizontal, double lightning bolt design;

3. A photograph of a tire and wheel, with a decorative wheel rim featuring the words "Pit Bull" bordered at each end by a horizontal single lightning bolt design; and
4. A photograph of a "Beware of the Dog" sign. If the lightning bolt design is part of the sign, it is not legible on the evidence of record.

In support of the refusal to register, the examining attorney attached to the final office action a number of web pages depicting nine tires with various tread designs.

The examining attorney bears the burden of making a *prima facie* showing that the mark is merely ornamental, and does not function as a trademark. While the conclusion is somewhat subjective, *Swift & Co.*, 106 USPQ at 288,⁴ we find that the evidence and argument of record do not support the refusal in this case.

The examining attorney proffered the pictures of other tires with various tread designs to show that "tire tread consists of many designs that resemble recognized objects. The specimens show the proposed mark appearing several times in a pattern on

⁴ Since the line distinguishing between mere ornamentation and ornamentation which is merely an incidental quality of a trademark is not always clearly ascertainable, the application of legal principles to fit one situation or the other requires proper reflection upon the impression likely to govern the ordinary purchaser in the market place. For that reason, the merits of each case of the character here presented must be individually and accordingly adjudged.

Swift & Co., 106 USPQ at 288.

the goods. This use of the proposed mark does not convey a source indicator." Office Action (Final), at 2 (Sept. 18, 2006). There are two problems with this argument.

First, we can see no "designs resembl[ing] recognized objects," on the tire treads depicted, and the examining attorney has not specifically identified any.

Second, although the examining attorney refers to applicant's mark as "tread" and compares it to various tire tread designs, applicant responds that this "is inaccurate as Applicant has noted several times that its mark is not incorporated into the tire tread pattern at all."⁵ Reply Br. at 2. Indeed, it does not appear clear that the embossed mark is "tread" in the sense of tire lugs. The specimens of record clearly show the raised area containing three imprinted molds of the alleged mark have a considerably lower profile than the adjacent tread. Accordingly, it is unlikely that the raised area containing the lightning bolt designs would contact the road surface under normal use. Moreover, the mark does not appear "where the rubber meets the road," but rather wraps laterally around the edge of the outside shoulder and onto the exterior face of the tire. Because applicant's mark does not appear to be tire tread, nor

⁵ In its Statement of Use, under "Specimen Description," applicant inserted "photographs of tire showing mark in tire tread." However, this statement must be viewed in the context of the specimens themselves, as well as applicant's later qualification of the mark as "not being incorporated in the tire tread." We note that a description of the specimens is not a required feature of a Statement of Use. See Trademark Rule 2.88(b).

does it even appear on the part of the tire usually covered by tread, the examining attorney's argument that applicant's purchasers would simply view the mark as an ornamental tread design is substantially undercut.

We agree with the examining attorney that applicant's evidence of use of the mark on collateral goods is entitled to little weight. As we understand it, applicant presented this evidence to show that its use of the mark on other goods, in a more traditional trademark manner, has created an association between the lightning bolt design and applicant. Thus associated, the relevant purchasers would view the lightning bolt as it appears on applicant's tires - not as an ornamental design - but as applicant's trademark. This is essentially an argument that the mark has acquired distinctiveness, which is not the issue before us. Further, of the four pieces of evidence proffered, a lightning bolt is visible on only three of them, two of which differ substantially from the mark which applicant seeks to register. The closest evidence is the picture of applicant's decorative wheel cover, in which the lightning bolt is horizontal, not vertical. There is no evidence of how many of these decorative wheel covers have been distributed (*e.g.*, sales or advertising figures) or whether the association urged by applicant has actually occurred (*e.g.* surveys, affidavits, evidence of recognition in publications). In short, we simply do not view applicant's evidence as indicative of whether consumers

would consider the lightning bolt as used on applicant's tires as an indication of source.

Applicant also argues that no other tire manufacturer places its trademark on its product in the manner applicant has done here, and that applicant's design will therefore be distinctive as a mark. While uniqueness alone does not necessarily indicate that the design is a source indicator, neither has it been shown that applicant's design is the same as or highly similar to common and pervasive ornamentation used in the industry.

In *In re General Tire & Rubber Co.*, 404 F.2d 1396, 160 USPQ 415 (CCPA 1969), the proposed mark comprised "three narrow white concentric rings of approximately equal width applied to the outer surface of a dark sidewall tire." 160 USPQ 416. In analyzing the case, the Court pointed out that

white stripes are so common on the sidewalls of tires as to have created in the minds of purchasers a type of tires known as whitewalls. This situation does not exist as to white stripes placed on containers or other articles. [Quoting appellees brief].

This, it seems to us, reaches the heart of the matter. The general public, it is well known, has long been familiar with whitewalls as a dress or ornamentation for tires. It therefore seems to us that a typical purchaser, having the idea that whitewall indicia is primarily for ornamentation, would be more likely to consider a 3-ring whitewall as just a refinement of this general ornamental concept, rather than as a trademark. This it seems distinguishes the present situation from Swift^[6] because, although Swift's two spaced

⁶ *Swift and Co., supra*, involved an application for registration of a mark comprising two polka dot bands surrounding a cylindrical can of cleanser. The CCPA reversed the refusal to register, finding that the

polka dot bands might be considered a special species of polka dot banding, there was no general understanding of the public in Swift that polka dot banding, even in a single band, was a commonly adopted and well known form of ornamentation for cylindrical containers for household commodities.

160 USPQ 417 (affirming refusal of registration).

Here, the examining attorney has presented no evidence that applicant's designation and its placement on the goods - or designs similarly placed - are widely-viewed as mere ornamentation in the tire industry in the way that the variation on whitewalls was viewed in *General Tire and Rubber*. While some of the tires pictured in the examining attorney's evidence appear to have designs extending onto the sidewall, some do not. (Of the tires that do appear to have such designs, it cannot be clearly seen from the record evidence what those designs are.) There is no evidence (such as articles or advertisements) that consumers actually perceive sidewall designs as merely ornamental, or any evidence that the lightning bolt itself is merely decorative.

Conclusion

It remains the examining attorney's burden to come forward with evidence and argument to support a *prima facie* case for refusal of registration. On this record, we find that this burden has not been sustained.

mark, while "incidentally" ornamental, was nonetheless an indication of source. 106 USPQ at 289.

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Decision: The refusal under Trademark Act §§ 1, 2, and 45
is REVERSED.