

Hearing:
June 3, 2009

Mailed:
September 14, 2009
Bucher

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hyundai Motor America

Serial No. 78889340

Howard N. Aronson, Nancy Dwyer Chapman, Cathy E. Shore-Sirotin and Renee L. Duff of Lackenbach Siegel LLP for Hyundai Motor America.

David H. Stine, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

Before Bucher, Zervas and Taylor, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Hyundai Motor America seeks registration on the Principal Register of the mark **ECHELON** (*in standard character format*) for "automobiles" in International Class 12.¹

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to

¹ Application Serial No. 78889340 was filed on May 22, 2006 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce. The application initially identified the goods as "automobiles and structural parts therefor."

register this designation based upon Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). The Trademark Examining Attorney has taken the position that applicant's mark, when used in connection with the identified goods, so resembles the mark **ECHELON** (*in standard character format*) for "automotive tires"² in International Class 12, as to be likely to cause confusion, to cause mistake or to deceive.

The Trademark Examining Attorney and applicant have fully briefed the issues involved in this case and an oral hearing was held on June 3, 2009. We reverse the refusal to register.

In support of its position, applicant cites the admonition from *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973) [*emphasis in original*]:

It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won't. A mere *assumption* that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not.

Applicant stresses that the Board should recognize and acknowledge present realities "from those on the firing line." Given that twenty-five pairs of substantially

² Registration No. 1745163 issued to Treadways Corporation on January 5, 1993, renewed.

identical marks for automobiles and for automotive tires currently exist on the federal Trademark Register, applicant implores us to respect the boundaries of use in these industries:

... In this sense, the registrations tend to define fields of use and, conversely, the boundaries of use and protection surrounding the marks and marks comprising the same word ... for their various products. The mutual respect and restraint exhibited toward each other by the owners of the plethora of marks, evidenced by their coexistence on the Register, are akin to the opinion manifested by knowledgeable businessmen

Keebler Company v. Associated Biscuits Limited, 207 USPQ 1034, 1038 (TTAB 1980).

The Trademark Examining Attorney assigned to this case made, and then maintained, his Final refusal with substantial reliance on the holding of *In re Jeep Corporation*, 222 USPQ 333 (TTAB 1984). However, he also subsequently made of record websites offering evidence supporting the position of applicant. The Trademark Examining Attorney argues that although the refusal is supported, if not mandated, by case law such as *In re Jeep Corp.*, all the evidence of record supports the position taken by applicant.³ Notably, at the oral hearing, the

³ While TMEP § 710.01 (5th ed. 2007) provides that "the examining attorney may also present evidence that may appear contrary to the USPTO's position, with an appropriate explanation as to why this evidence was not considered controlling," this case is unusual because the Trademark Examining Attorney

Trademark Examining Attorney and applicant both argued that this mark should be registered inasmuch as the evidence supports our reversing this refusal to register.

Our likelihood of confusion determination must be based upon our analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Each of these factors may, from case to case, play a dominant role. *Id* at 567.

We should point out initially that we agree with the concurring opinion that to the extent *In re Jeep Corp.* has been interpreted as presenting a *per se* rule - e.g., that automobiles and automotive tires are *per se* related, such that there must be a likelihood of confusion from the use of the same or similar marks in relation to this pairing of goods - this is an incorrect reading of the *In re Jeep Corp.* case and its progeny. Rather, we need to look at the factual evidence of record to determine whether these goods are related as closely under trademark law as tires are when securely mounted on auto wheels.

presented evidence contrary to the USPTO's position and argued that such evidence is, in fact, controlling.

Inasmuch as the marks herein are identical, this factor supports a finding of likelihood of confusion. Nonetheless, that is clearly not the end of our determination in a case such as this. Specifically, we should not overlook the critical role played by well known/famous marks for automobiles in reported decisions⁴ -- such as PACKARD,⁵ CADILLAC,⁶ COBRA,⁷ MERCEDES-BENZ and FORD,⁸ where likelihood

⁴ In *General Motors Corporation v. Pacific Tire & Rubber Company*, 132 USPQ 562, 564 (TTAB 1962) [Opposer's BEL-AIR automotive vehicles versus applicant's BEL-AIR tires and tubes], the Board cited, *inter alia*, to two pre-Lanham Act cases from the 1920's. *Akron-Overland Tire Co. v. Willys-Overland Co.*, 273 F. 674, 676 (3rd Cir. 1921); and *Wall v. Rolls Royce of America*, 4 F.2d 333 (3rd Cir. 1925). Yet, in a 1978 decision citing to these same two auto/auto parts decisions, the Third Circuit discussed these as examples where it had earlier found that a well-known mark provided protection against goods in "non-competing" markets. See *Scott Paper Company v. Scott's Liquid Gold, Inc.*, 589 F.2d 1225, 200 USPQ 421, 424 (3rd Cir. 1978).

⁵ *Nash-Kelvinator Corporation v. Imperial Tire Company*, 45 USPQ 587, 588-89 (Com'r. 1940).

⁶ *General Motors Corporation v. Aluminum Products, Inc.*, 120 USPQ 502 (TTAB 1959) [GM's long and extensive use and promotion of its CADILLAC mark means it is "exceedingly well-known" in the automotive trade. Moreover, applicant has chosen to display its CADILLAC mark using "an exact simulation of a style of lettering long used by opposer" in displaying its CADILLAC mark!].

⁷ *Ford Motor Company v. Hi-Performance Motors, Inc.*, 186 USPQ 64 (TTAB 1975) [Applicant's use of visual representation of a coiled snake for automobile wheels, and opposer's use of the word COBRA and coiled snake design for automobiles and automobile components was likely to cause confusion]. As to the fame of the COBRA mark, a reported decision almost forty years later noted the continuing fame of Ford's COBRA mark. *Ford Motor Co. v. A.C. Car Group Ltd.*, 62 USPQ2d 1701 (E.D.Mi. 2002).

⁸ *Jetzon Tire & Rubber Corporation v. General Motors Corporation*, 177 USPQ 467 (TTAB 1973) [In a case where "GM" was

of confusion was found. Granted, the renown of a registered mark is often difficult to determine in the *ex parte* context. And while the record in this case does not contain any information on this factor, it is significant to our understanding of the continuing reach of cases such as *In re Jeep Corp.* That is, a registration for a mark of some renown registered in connection with automobiles should remain a good *ex parte* citation against the manufacturer or merchant with the temerity to adopt and use an identical mark for tires. In the event that the Trademark Examining Attorney cannot demonstrate such renown, then certainly the automobile manufacturer *qua* opposer or cancellation petitioner should be permitted to make such a showing in an *inter partes* proceeding. By contrast, where the Trademark Examining Attorney, like trademark tribunals, is faced with less well-known marks like IMPERIAL⁹ or GRAND PRIX,¹⁰ presumably no likelihood of confusion would be found.

part of one of applicant's marks, opposer made of record two third-party registrations to show that the marks MERCEDES-BENZ and FORD have been registered in the United States Patent and Trademark Office by a single party for both automobiles and tires].

⁹ *In re Dayco Products-Eaglemotive Inc.*, 9 USPQ2d 1910 (TTAB 1988) [Due to weakness of IMPERIAL marks, no likelihood of confusion between registered mark for automobiles and structural parts, and applicant identical mark for automotive products.

¹⁰ *In re General Motors Corp.*, 23 USPQ2d 1465 (TTAB 1992) [Applicant was applying for GRAND PRIX for "motor vehicles; namely,

While we could well go back through a century of history, and focus at length on conclusory statements made over the years by various tribunals as to the relationship of automotive tires to automobiles, we are much more interested in the relevant evidence (or lack thereof) on that relationship contained within this record.

Clearly, tires are included on virtually every new automobile sold, and are absolutely necessary for the operation of such vehicles throughout their useful life. These are clearly not "competitive" goods, but neither do we believe they should be considered to be "complementary goods" as that term is used in likelihood of confusion decisions." Some goods will be regarded as related because they are complementary in the sense that they might be used together (e.g., skirts and blouses, pancakes and syrup, camera and film). Generally, the focus is on products that the consumer might well purchase separately but routinely use together. With such products, when faced with identical or highly similar marks, consumers will have the expectation of some connection or sponsorship. "Complementary goods" continues to be a useful category of related goods, whether

automobiles, engines therefor, and structural parts thereof" versus a variety of GRAND PRIX marks for automotive tires; no likelihood of confusion found where during a thirty year interval of contemporaneous usage and "sustained success," there were reportedly no instances of actual confusion].

from the standpoint of current and prospective trademark owners and their counsel, or as a rationale for intellectual property tribunals in determining the relatedness of goods. However, merely because two products are attached or used together does not necessarily mean they are closely related. Consumers do not purchase an automobile without tires, and then later go looking for tires. Nothing in this record points to a single source for automobiles and tires. Accordingly, there is no reason to presume such a perception on the part of consumers of automobiles. We find nothing in the record to support a conclusion that automobiles and their tires are "closely related," as that term is used in the jurisprudence developed around likelihood of confusion.

We now turn to trade channels, another critical factor when dealing with the nexus of the automobile and tire industries. As to the respective channels of trade employed by the automotive industry and the tire industry, the file contains evidence of the virtual separation of these trade channels. For example, according to "Market Profile," a 2007 annual report put out by *Tire Review Online*, a global website that covers the tire industry, it appears that at present, only two to four percent of aftermarket automobile

tires in the United States are sold through automotive dealerships.¹¹

Furthermore, each automobile is an expensive item (e.g., generally, from thousands to tens-of-thousands of dollars), presumably purchased with a great deal of care. See *In re General Motors Corp.*, 23 USPQ2d at 1471 [the purchase of an automobile is "typically a major and expensive purchase"]. One cannot assume quite the same level of purchaser care for tires - even when multiple tires are marketed for hundreds of dollars. However, according to this record, the motorist in need of new tires will go to the local tire dealer located in a traditional brick-and-mortar establishment, or may order tires online to be shipped, and then mounted and balanced locally. To make this point more clearly, the Trademark Examining Attorney submitted evidence from an online tire retailer which explained in detail the online purchasing process facing the hypothetical owner of a 2006 Camry.¹² Hence, unsophisticated

¹¹ We have considered the evidence from "Market Profile," at 16 <http://www.tirereview.com/files/PDF/marketprof07revA.pdf>, although there may well be an element of hearsay to this evidence. Inasmuch as this is a website that covers the tire industry, we detect no bias in the evidence. The Board generally takes a somewhat more permissive stance with respect to the introduction and evaluation of evidence in an *ex parte* proceeding than it does in an *inter partes* proceeding. See *In re Hudson News Co.*, 39 USPQ2d 1915 (TTAB 1996); and *In re Broadway Chicken, Inc.*, 38 USPQ2d 1559 (TTAB 1996).

¹² <http://www.tirerack.com/tires/>

tire purchasers would not be able to purchase tires without the assistance of expert, trained store personnel, or without computerized matrices, to ensure proper fitment based upon the make, model, year, rim size, etc., of their vehicles. This hypothetical automobile owner in need of replacement tires (who assumes a separate source for the tires) checks carefully the specifications for the tire but is not concerned about matching the brand of tires to the automobile.

Another hypothetical consumer, one so ill-informed that he mistakenly assumes source connection of tires based merely upon a coincidence that they bear the same mark as his car, would be disabused quickly of this notion. Practically, the Trademark Examining Attorney has shown from his TireRack example that (1) the pull-down matrices prevent the selection of a tire with an incorrect fitment, and (2) the chance that one would find a brand of tires that fits a car of the same name appears to be infinitesimally small. In the local brick-and-mortar location, a capable sales person would not agree to sell and mount tires that do not fit the auto's wheels. Hence, despite themselves, such consumers are forced to exercise a high degree of care when purchasing tires.

Similarly, applicant has demonstrated from examples of real-world, online sources that some of the largest auto manufacturers and the most well-known tire manufacturers readily permit the same mark to coexist for automobiles and automobile tires.

CHARGER tire/auto pairing as seen in the marketplace:

Applicant demonstrates that the Charger performance radial tire by Kelly/Springfield is available online in 14", 15" and 16" tires.

<http://www.kellytires.com/auto/products/csr.html>



KELLY TIRES

Charger® By
Kelly
Performance
Radial



By contrast, the 2008 Dodge Charger is a muscle car available with 17", 18" and 20" wheels.

<http://www.dodge.com/en/2008/charger/>

EXPLORER tire/auto pairing as seen in the marketplace:

Applicant demonstrates that the Explorer radial tire by Kelly/Springfield is available online in 13", 14" and 15" tires.

<http://www.kellytires.com/auto/products/exp.html>

KELLY TIRES

Explorer®
All-Season
Steel-Belted
Radial





By contrast, the 2008 Ford Explorer is a sports utility vehicle available with 18" and 20" wheels. <http://www.fordvehicles.com/suvs/explorer/>

NAVIGATOR tire/auto pairing as seen in the marketplace:



A Good Deal
On A Great Tire™

[SITE MAP](#) | [CONTACT US](#) | [SEARCH](#)

[AUTO & LIGHT TRUCK](#) | [COMMERCIAL TRUCK](#)

[Tire Catalog](#) | [Tire School](#) | [Tire Registration](#) | [30 Day Test Drive](#) | [Find A Retailer](#) | [The Kelly Tire Card](#)



A GOOD
DEAL ON A
GREAT TIRE™

Auto & Light Truck

[Search Results Detail](#)



Navigator Touring Gold

Premium Ride Comfort And Dependable All-Season Performance

Applicant demonstrates that the Navigator tire by Kelly/Springfield is available in 15", 16" and 17" tires.¹³ By contrast, the 2008 Lincoln Navigator is the largest luxury SUV made by Ford Motor Company, with 18" and 20" tires.



PILOT tire/auto pairing as seen in the marketplace:

Finally, **PILOT** includes Michelin's line of ultra-high performance tires (ranging from 17" to 22") for exotic sports cars, "Y" rated for speeds up to 186 miles per hour. By contrast, although Honda's **PILOT** registration lists "all

¹³ http://www.kellytires.com/kellytires/display_tire.jsp?prodline=Navigator+Touring+Gold&mrktarea=Passenger

terrain vehicles," applicant has submitted for the record online ads showing that the 2008 Honda **PILOT** is a somewhat-bulky, midsize, crossover SUV.

We emphasize that even twenty-five pairs of substantially identical marks for automobiles and for automotive tires currently existing on the federal Trademark Register does not have the persuasive value of a written, mutual consent between an applicant and senior user/registrant. There is simply no way of knowing whether the owners of a particular pair of registrations actually had any dealings whatsoever. As such, our decision herein is not meant to imply that third-party registrations should be given such evidentiary weight. On the other hand, the fact that there are numerous third-party registrations for similar marks owned by different entities for tires and automobiles is consistent with the conclusion that trademark owners in these respective industries do not believe that there is a likelihood of confusion between these marks for the listed goods.

The U. S. Patent and Trademark Office itself seems to be of two minds on how best to handle applications such as the present one. While some Trademark Examining Attorneys take the position that the holding of cases like *In re Jeep Corp.* mandates this refusal, others have over the years repeatedly registered identical, arbitrary marks for

automobiles and for auto tires. The junior users/registrants in many of the following pairs were issued federal trademark registrations in the years since *In re Jeep Corp.* was decided. This provides additional evidence corroborating contemporary marketplace realities, namely, that the automobile and tire industries permit co-terminus use and open coexistence on the federal Trademark Register of substantially identical marks for vehicles and tires without any evidence anyone has been confused thereby. Here are some of the examples placed into the record:

<i>AUTOMOBILES / LAND VEHICLES</i>	<i>TIRES</i>
ASTRA¹⁴	ASTRA¹⁵
AVALANCHE¹⁶	AVALANCHE¹⁷
CHARGER¹⁸	CHARGER¹⁹

¹⁴ Registration No. 3403244 for "motor land vehicles" (Owned by Saturn Corporation) issued on March 25, 2008.

¹⁵ Registration No. 1216617 for "tires" (owned by Continental Tire North America, Inc.) issued on November 16, 1982, renewed.

¹⁶ Registration No. 2866966 for "motor land vehicles, namely automobiles, trucks, sport utility vehicles, vans, engines therefor and structural parts thereof excluding railcars or parts thereof" (owned by General Motors Corporation) issued on July 27, 2004.

¹⁷ Registration No. 2289115 for "tires for motor vehicles" (owned by Hercules Tire Company of Canada, Inc.) issued on October 26, 1999, renewed.

¹⁸ Registration No. 2985653 for "motor vehicles, namely automobiles and structural parts therefore" (owned by Chrysler Group LLC) issued on August 16, 2005.

AUTOMOBILES / LAND VEHICLES	TIRES
<i>Continental</i> ²⁰	Continental ²¹
EXPLORER ²²	EXPLORER ²³
GENESIS ²⁴	GENESIS ²⁵
GRAND PRIX ²⁶	BRAND X PRIX ²⁷

¹⁹ Registration No. 0833697 for "tires" (owned by the Kelly-Springfield Tire Company) issued on August 15, 1967, second renewal.

²⁰ Registration No. 0591601 for "motor cars" issued on June 22, 1954, third renewal; and Registration No. 2908822 for the mark CONTINENTAL for "vehicles, namely cars, trucks, vans and sport utility vehicles" issued on December 7, 2004 (both owned by Ford Motor Company).

²¹ Registration No. 0622300 for "pneumatic tires and solid rubber tires for bicycles, passenger cars, trucks, tractors, lorries, wheel barrows, and motor cars" (owned by Continental Aktiengesellschaft) issued on February 28, 1956, third renewal.

²² Registration No. 1193137 for "pick up trucks and their structural parts" (owned by Ford Motor Company) issued on April 6, 1982, renewed.

²³ Registration No. 0607305 for "tires" (owned by The Goodyear Tire & Rubber Company) issued on June 14, 1955.

²⁴ Registration No. 3531628 for "automobiles" (owned by Hyundai Motor America) issued on November 11, 2008.

²⁵ Registration No. 2934609 for "vehicle tires" (owned by Treadways Corporation) issued on March 22, 2005.

²⁶ Registration No. 1889797 for "motor vehicles; namely, automobiles, engines therefor, and structural parts thereof" (owned by General Motors Corporation) issued on April 18, 1995, renewed. Board found no likelihood of confusion with tires, *In re General Motors Corp.*, 23 USPQ2d 1465, (TTAB 1992).

AUTOMOBILES / LAND VEHICLES	TIRES
HIGHLANDER²⁸	HI-LANDER²⁹
LARAMIE³⁰	LARAMIE³¹
LEGACY³²	LEGACY³³
LEGEND³⁴	LEGEND³⁵
MAXIMA³⁶	MAXIMA³⁷

²⁷ Registration No. 0690249 for "automobile tire[s]" issued on December 22, 1959, second renewal; and Registration No. 1164594 for GRAND PRIX RADIAL G/T (with the term "Radial G/T" disclaimed, shown in a special form drawing, as shown at right for "automotive vehicle tires" issued on August 11, 1981, renewed (owned by TBC Corporation).



²⁸ Registration No. 2249838 for "automobiles and structural parts thereof" issued on June 1, 1999, renewed; and Registration No. 2339104 for "land motor vehicles, namely, sport utility vehicles, and structural parts thereof" issued on April 4, 2000, (both owned by Toyota Jidosha Kabushiki Kaisha).

²⁹ Registration No. 0696074 for "tires" (owned by The Goodyear Tire & Rubber Company) issued on April 12, 1960, second renewal.

³⁰ Registration No. 1973148 for "motor vehicles and structural parts therefore" (owned by Chrysler LLC) issued on May 7, 1996, renewed.

³¹ Registration No. 1088647 for "vehicle tires" (owned by Treadways Corporation) issued on April 4, 1978, second renewal.

³² Registration No. 1721734 for "automobiles and structural parts thereof (excluding tires)" (owned by Fuji Jukogyo Kabushiki Kaisha) issued on October 6, 1992, renewed.

³³ Registration No. 1393967 for "vehicle tires" (owned by Big O Tires, Inc.) issued on May 20, 1986, renewed.

³⁴ Registration No. 1574715 for "automobiles and structural parts thereof" (owned by Honda Giken Kogyo Kabushiki Kaisha) issued on January 2, 1990, renewed.

³⁵ Registration No. 3039122 for "vehicle tires" (owned by Treadways Corporation) issued on January 10, 2006.

³⁶ Registration No. 1432854 for "automobiles and structural parts therefor, excluding tires" (owned by Nissan Jidosha Kabushiki Kaisha) issued on March 17, 1987, renewed.

AUTOMOBILES / LAND VEHICLES	TIRES
NAVIGATOR³⁸	NAVIGATOR³⁹
ODYSSEY⁴⁰	ODYSSEY⁴¹
PATRIOT⁴²	PATRIOT⁴³
PILOT⁴⁴	PILOT⁴⁵

³⁷ Registration No. 0926329 on the Supplemental Register for "non-metallic tires" (owned by Continental Tire North America, Inc.) issued on December 28, 1971, second renewal.

³⁸ Registration No. 1749362 for "vehicles; namely, motor homes" (owned by International Truck Intellectual Property Company, LLC.) issued on January 26, 1993, renewed; also Registration No. 2111095 for "motor vehicles, namely trucks and their structural parts" (owned by Ford Motor Company) issued on November 4, 1997, renewed.

³⁹ Registration No. 0812177 for "tires" (owned by The Goodyear Tire & Rubber Company) issued on August 2, 1966, second renewal.

⁴⁰ Registration No. 2039315 for "passenger land motor vehicles, namely, minivans, and structural parts thereof" (Owned by Honda Giken Kogyo Kabushiki Kaisha) issued on February 18, 1997, renewed.

⁴¹ Registration No. 1687087 for "automotive tires" (owned by Treadways Corporation) issued on May 12, 1992, renewed.

⁴² Registration No. 2841486 for "motor vehicles, namely, automobiles and structural parts and engines therefor, sold exclusively through authorized dealerships to its retail customers and excluding buses" (owned by Chrysler LLC) issued on May 11, 2004.

⁴³ Registration No. 3320224 for "tires" (owned by The Goodyear Tire & Rubber Company) issued on October 23, 2007.

⁴⁴ Registration No. 1596280 for "all terrain vehicles and structural parts thereof" (owned by Honda Giken Kogyo Kabushiki Kaisha) issued on May 15, 1990, renewed.

⁴⁵ Registration No. 1342457 for "tires" (owned by Michelin North America, Inc.) issued on June 18, 1985, renewed.

AUTOMOBILES / LAND VEHICLES	TIRES
<i>Le Sabre</i> ⁴⁶	SABRE ⁴⁷
TRACKER ⁴⁸	TRACKER ⁴⁹
VIPER ⁵⁰	VIPER ⁵¹
WRANGLER ⁵²	WRANGLER ⁵³

Although we often remind litigants that the federal Trademark Register may not actually reflect what is happening in the real world, applicant has shown in detail how many of these respective pairs are currently used in the marketplace using Internet evidence of contemporary usage.

⁴⁶ Registration No. 0573739 for "automobiles and parts thereof" (owned by General Motors Corporation) issued on April 28, 1953, third renewal.

⁴⁷ Registration No. 0926463 for "pneumatic tires" (owned by Treadways Corporation) issued on January 4, 1972, second renewal.

⁴⁸ Registration No. 1520766 (owned by General Motors Corporation) issued on January 17, 1989; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

⁴⁹ Registration No. 1074959 (owned by The Goodyear Tire & Rubber Company) issued on October 11, 1977; second renewal.

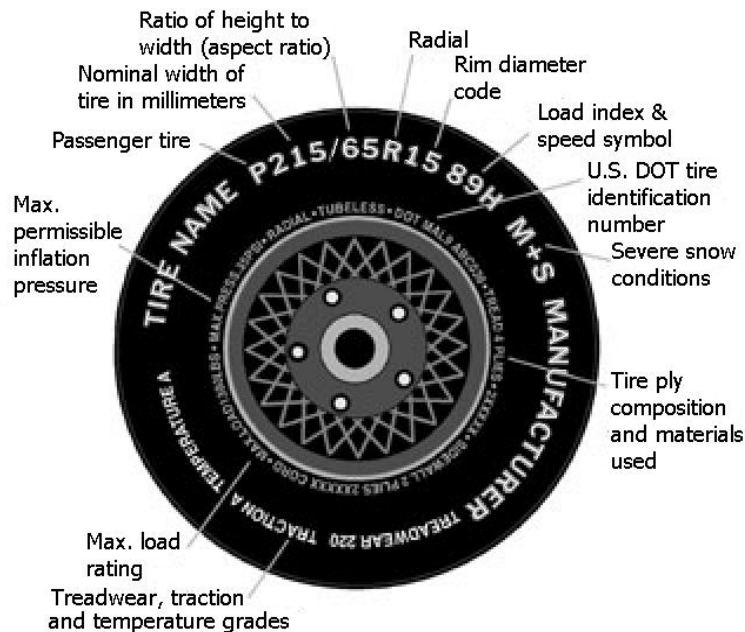
⁵⁰ Registration No. 1800654 for "automobiles and structural parts therefore" (owned by Chrysler LLC) issued on October 26, 1993; renewed.

⁵¹ Registration No. 2153975 for "tires for automobiles" (owned by Cooper Tire & Rubber Company) issued on April 28, 1998; renewed.

⁵² Registration No. 1557843 for "automobiles" (owned by Chrysler Group LLC) issued on September 26, 1989.

⁵³ Registration No. 0811711 for "tires" (owned by The Goodyear Tire & Rubber Company) issued on July 26, 1966, second renewal.

Finally, applicant points to the current tire industry practice for sidewall markings based upon federal regulations. Although the regulations do not explicitly require that the ultimate corporate source of the tires be listed on the sidewall, this reality reduces even further any chance of inadvertent confusion, i.e., with both the manufacturer's name and the product/tire name appearing prominently on the tire sidewall.



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Accordingly, the *du Pont* factor focusing on the conditions under which sales are made favors reversal.

⁵⁴ <http://www.safercar.gov/portal/site/safercar/menuitem.13dd5c887c7e1358fefe0a2f35a67789/?vgnextoid=8e1c4507fe526110VgnVCM1000002fd17898RCRD>; 49 CFR Part 575, 575.6(a); 46 FR 13193, 02/17/1981; 64 FR 51920, 09/27/1999; Uniform Tire Quality Grading Standards (UTQGS) of the Consumer Information Regulations at 49 CFR 575.104, and the tire labeling sections of the Federal Motor Vehicle Safety Standards (FMVSS) at 49 CFR 571.109, 117, and 119).

We thus find that automobiles and automobile tires are not closely-related goods given the current marketing conditions for the replacement tire industry and the totally disparate channels of trade between tires and automobiles. With the possible exception of automobile marks of demonstrated renown - a fact pattern not shown to be the case herein - the chances for likelihood of confusion in the real world are *de minimis* under these circumstances. After all, as our reviewing court has stated, "[w]e are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with *de minimis* situations but with the practicalities of the commercial world, with which the trademark laws deal." *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992).

The cumulative evidence in this case, assembled between 2006 and 2008, is substantial and overwhelming, and supports a reversal herein. When it comes to likelihood of confusion, trademark practitioners and jurists know that there are no *per se* rules as to the relatedness of goods. Therefore, contrary to the positions of both applicant and the Trademark Examining Attorney, we cannot discern a rule of law from *In re Jeep Corp.* in need of being overturned. Furthermore, although the briefing and oral arguments urge

us to do so, we do not find it necessary to take a position herein on whether precedential cases decided decades ago were then supported by the realities of the marketplace or their respective factual records.

We do emphasize that this is not simply a case where the Trademark Examining Attorney relied solely upon the results of a previous decision, thereby losing the appeal because of a failure to gather evidence. To the contrary, it is apparent that the Trademark Examining Attorney sought mightily to support the Office's refusal with evidence, but after a most thorough investigation, found only evidence supporting applicant's position that automobiles and automobile tires are not closely-related goods.

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

CONCURRING OPINION

Zervas, Administrative Trademark Judge:

In my view, the refusal must be reversed, not for the reasons stated by the majority, but rather because the examining attorney has not made out a prima facie case of likelihood of confusion.

The examining attorney did not introduce any evidence regarding the *du Pont* factors in his first Office action or in his final Office action. It was only in his denial of his request for reconsideration that he introduced any evidence; this evidence, however, favored applicant's position.⁵⁵

The Federal Circuit, our primary reviewing Court, requires that the Office make out a *prima facie* case of likelihood of confusion supported by evidence. *In re Pacer Technology*, 338 F.3d 1348, 67 USPQ2d 1629, 1632 (Fed. Cir. 2003) ("we look only for substantial evidence, or more than a scintilla of evidence, in support of the PTO's *prima facie* case"). The Trademark Manual of Examining Procedure ("TMEP") requires an examining attorney to "always support

⁵⁵ The examining attorney explains at unnumbered p. 4 of his brief:

As the arguments and supporting evidence featured at pp. 11-14 of applicant's Appeal Brief were raised for the first time therein, a remand of the file was requested to permit further review of this material, and to supplement the record. This remand was granted, and extensive further research pertaining to applicable marketplace conditions was conducted. Additional evidence resulting from this research was made of record by Office Action issued October 27, 2008. It is noted that the results of additional research conducted by the undersigned clearly support and further buttress applicant's arguments at pp. 11-14 of the Appeal Brief Accordingly, it is respectfully suggested that a considered review of the specific holding of *In re Jeep Corp*, 222 USPQ 333 (TTAB 1984), along with its predecessors and progeny, is clearly warranted.

his or her action with relevant evidence." TMEP Section 710.01.⁵⁶

In lieu of evidence and in the context of the *du Pont* factors regarding the goods and the trade channels, the examining attorney relied on several Board decisions which found the use of identical or similar marks on automobiles and on tires likely to cause confusion. One problem with the examining attorney's reliance on these decisions is succinctly stated in TMEP §1207.01(a)(iv); because "[t]he facts in each case vary and the weight to be given each factor may be different in light of the varying circumstances ... there can be no rule that certain goods ... are per se related, such that there must be a likelihood of confusion from the use of similar marks in relation thereto (citations omitted)." A second problem is that we cannot take judicial notice of facts in a prior case where the Board found goods or trade channels to be related under the facts presented in the prior case:

In the instant case, although it may be said that the opinions of the U.S. District Court for the Northern District of California and the U.S. Court of Appeals for the Ninth Circuit may be relevant under the broad definition of "relevant evidence" in Rule 401, the Board remains of the opinion that

⁵⁶ TMEP Section 710.01 adds that when an examining attorney introduces evidence contrary to the USPTO's position "[i]n appropriate cases," he or she should provide "an appropriate explanation as to why this evidence was not considered controlling."

such "evidence" is not competent evidence in a proceeding before it to prove uniqueness, notoriety or market power of opposer's mark in the marketplace today. For it is well settled that a decision in a prior case is incompetent as proof of any fact recited therein as against one who was not a party thereto. See: *Aloe Creme Laboratories, Inc. v. Bonne Bell, Inc.*, 168 USPQ 146 (TT&A Bd., 1970), and cases cited therein.

Chicken Delight, Inc. v. Delight Wholesale Co., 193 USPQ 175, 177 (TTAB 1976).

In the context of the goods, the TMEP could not be clearer:

The examining attorney must provide evidence showing that the goods and services are related to support a finding of likelihood of confusion. Evidence of relatedness might include news articles and/or evidence from computer databases showing that the relevant goods/services are used together or used by the same purchasers; advertisements showing that the relevant goods/services are advertised together or sold by the same manufacturer or dealer; or copies of prior use-based registrations of the same mark for both applicant's goods/services and the goods/services listed in the cited registration.

TMEP § 1207.01(a)(vi) (emphasis added). Prior Board decisions are not listed as factual evidence in support of a refusal.⁵⁷

⁵⁷ I view it unlikely that the Federal Circuit, if given an opportunity to consider an appeal in this case, would consider itself bound by the Board decisions cited by the examining attorney or find that the Board decisions alone are "substantial evidence" of the similarity of particular goods.

Thus, I too would reverse, but on the basis that the examining attorney has not made out a prima facie case in support of his likelihood of confusion refusal. I believe that if it is the position of the examining attorney's law office that a likelihood of confusion does not exist between a registered mark and an applicant's mark, and the evidence does not support such a refusal, the examining attorney should not refuse to register the applicant's mark. As stated above, "there can be no rule that certain goods ... are per se related, such that there must be a likelihood of confusion from the use of similar marks in relation thereto." TMEP §1207.01(a)(iv).