

Goodman

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**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451**

Mailed: March 17, 2009

Opposition No. **91166939**

Bassani Manufacturing

v.

Monty Allen Campbell

Before Quinn, Grendel and Walsh, Administrative Trademark Judges.

By the Board:

Applicant Monty Allen Campbell seeks to register in standard character form X-PIPE for "internal combustion engine exhausts" in International Class 7.¹ Opposer, Bassani Manufacturing, has opposed registration on the grounds that X-PIPE is generic, and if not generic, X-PIPE is merely descriptive and lacks acquired distinctiveness; X-PIPE has been abandoned due to prolific uncontrolled use in the automotive and motorcycle industry; and fraud. Applicant, in his answer, denied the salient allegations of the notice of opposition.²

¹ Application Serial No. 78004925, filed April 20, 2000 under Section 1(a), claiming dates of first use of February 15, 1982, and claiming acquired distinctiveness under Section 2(f). The Section 2(f) claim is based on an allegation of substantially exclusive and continuous use in commerce for the five years before the date when the distinctiveness claim was made.

² On July 25, 2006 the Board struck applicant's affirmative defense of unclean hands (affirmative defense nos. 4, 5 and 6) as

Now before the Board are the following motions:

- 1) applicant's motion, filed September 3, 2008, to extend the discovery period;
- 2) opposer's motion, filed September 24, 2008, for summary judgment;
- 3) opposer's motion, filed September 25, 2008, to extend time to respond to discovery;
- 4) applicant's motion, filed October 20, 2008, to reopen time to answer opposer's motion for summary judgment;
- 5) applicant's, motion, filed October 20, 2008, to amend the application drawing to a special-form version of applicant's mark³; and
- 6) applicant's motion, filed December 31, 2009, to remove interlocutory attorney or alternatively for the three judge panel to consider applicant's motion (filed December 5, 2008) to strike opposer's reply to summary judgment (amended motion to strike opposer's reply filed January 5, 2009).⁴

Turning first to applicant's motion to extend time to respond to the motion for summary judgment, we find the motion moot inasmuch as applicant's response to the motion for summary judgment was timely.

We turn next to opposer's motion for summary judgment on the grounds of genericness; and that X-PIPE has lost its

unavailable against claims of genericness, descriptiveness, fraud and abandonment.

³ The Board's order of October 3, 2008 suspending proceedings for summary judgment advised that any paper filed not relevant to the motion for summary judgment would be given no consideration. Inasmuch as the motion to amend is not germane to the motion for summary judgment, it will not be considered. We note that even if we considered and allowed this amendment, it would not alter our decision on summary judgment.

⁴ In resolving opposer's motion for summary judgment, we find it is unnecessary to consider opposer's reply. Inasmuch as we are not relying on opposer's reply in determining the motion for summary judgment, applicant's motion to strike and or amended motion to strike is deemed moot. *Cf., Team Play, Inc. v. Boyer*, 391 F.Supp.2d 695 (N.D. Ill. 2005) (declining to consider motion to strike materials attached to reply on summary judgment because

significance as an indication of origin through uncontrolled widespread use through third parties⁵; and naked licensing⁶.

Opposer's evidence on summary judgment consists of the declaration of its attorney, Jonathan A. Hyman, through which opposer makes of record, inter alia, printouts of magazine articles, newspaper articles, online publications, website printouts, copies of catalogs and the declaration of Boyd Butler, President of Dr. Gas Incorporated, a competitor of applicant's.

Applicant's evidence in response consists of a printout of opposer's website (Exhibit I), opposer's discovery responses in a prior Board opposition proceeding (Exhibit II), printed material and website printouts relating to Dr. Gas Incorporated (Exhibits III-VIII), and "opposer exhibit breakdown" analysis (Exhibit IX).⁷

the court, in considering the motion, found it unnecessary to consider those materials).

⁵ We construe any arguments on this ground to be an iteration of the genericness claim.

⁶ We deem opposer's motion for summary judgment on the naked licensing ground to be based on and a further elaboration of opposer's abandonment claim in the notice of opposition. We note that applicant, in its response to the motion for summary judgment, has denied that any license agreements were executed between himself and his competitors.

⁷ These exhibits were not accompanied by an affidavit or declaration. Applicant's internet evidence and other printed material do not qualify as printed publications, are not self authenticating, and absent a declaration or affidavit do not constitute admissible evidence on summary judgment (Exhibit I, III-VIII). TBMP Section 528.05(e) (2d. ed. rev. 2004). Additionally, Exhibits I-II relate solely to the unavailable defense of unclean hands, see n. 2 supra, which applicant has argued in its response brief.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S. Ct. 2548 (1986).

To prevail on its motion, opposer must show the absence of genuine issues of material fact as to its standing to bring this action and as to its claim that "x-pipe" is generic. For the reasons stated below, we find that there are no genuine issues of material fact in dispute that "x-pipe" is generic and that summary judgment is appropriate in this case.

We previously granted partial summary judgment for opposer on the question of standing in our order dated September 5, 2007.⁸ Therefore, we turn to the question of whether "x-pipe" is generic.

A mark is a generic name if it refers to the class, genus or category of goods and/or services on or in connection with which it is used. See *In re Dial-A-Mattress*

⁸ Although standing has been determined, applicant has continued to put forward standing arguments (i.e., damage) in its response to opposer's motion.

Operating Corp., 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001) (citations omitted). The test for determining whether a mark is generic involves a two-step inquiry. First, what is the genus (category or class) of goods or services at issue? Second, is the term sought to be registered understood by the relevant public primarily to refer to that genus (category or class) of goods or services? *Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986).

With regard to the first part of the genericness inquiry, the evidence of record establishes that there is no genuine issue of material fact that the genus of applicant's goods is internal combustion engine exhausts which contain exhaust pipes and discharge pipes. (Applicant's identification of goods, involved application Serial No. 78004925; opposer's exhibit C: Applicant's Patent No. 4800719 Exhaust System (Abstract: "The [exhaust] system comprises a plurality of . . . exhaust pipes. . . . The [exhaust] System further includes discharge pipes) and Applicant's Patent No. 4953352 Exhaust System (Abstract: "The [exhaust] system comprises a plurality of exhaust pipes which are operably flow connected to exhaust ports . . . and to discharge pipes").

With regard to the second part of the inquiry, evidence of the relevant public's understanding of a term may be

obtained from any competent source including consumer surveys, dictionary definitions, newspapers and other publications. *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985).

Opposer has not submitted any dictionary evidence of the term "x-pipe", and applicant argues that the lack of dictionary evidence evidences that "x-pipe" is not generic for internal combustion engine exhausts. However, the lack of dictionary evidence of the term "x-pipe" is not dispositive of the issue of genericness. *Continental Airlines Inc. v. United Air Lines Inc.*, 53 USPQ2d 1385, 1393 (TTAB 1999) ("Although there is no dictionary listing for the term "e-ticket" per se, this fact is not dispositive of the issue. No dictionary is complete or completely up to date, or tracks the language of the marketplace perfectly. A number of generic terms are not found in dictionaries."). "Whether a term is generic is determined by actual common usage." *In re Deutsche Airbus GmbH*, 224 USPQ 611, 614 n. 12 (TTAB 1984).

While neither party submitted evidence of the dictionary definition of the term "pipe," we judicially notice⁹, for present purposes, the definitions in Delmar's

⁹ It is well established that the Board may properly take judicial notice of dictionary definitions. *See, e.g., University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

Automotive Dictionary (1997) that "pipe" is defined as "an exhaust system" and "pipes" is defined as "[a] dual-exhaust system." We are of the view that the judicially noticed dictionary definitions, while not dispositive, tend to support opposer's position that "x-pipe" is used as a name for a category of internal combustion engine exhausts.

Opposer has provided ample evidence showing various uses of the term "x-pipe" to support its assertion that the relevant public uses the term "x-pipe" in a generic manner. These exhibits include examples of use in various print and online publications and use by competitors.¹⁰ The following examples of usage are illustrative:

Printed Publications

Exhibit G-2,

An X-pipe's supposed advantage is that because the bends are smoother at the convergence, the flow and scavenging are both better, and hence the X-pipe is worth more power.

(5.0 Mustang, H-pipe or X-pipe? Which makes the most power? November 1999)

Exhibit G-8

. . . MRT's exhaust maintains that deep Mustang exhaust note rather than raising the pitch as X-pipe systems might do. (*Detroit News*, Add Muscle to your Mustang, September 10, 2003)

¹⁰ Opposer has also provided evidence of use by the public via posting of messages on online forums. Applicant argues that the online forum evidence opposer provided is sponsored and "edited by competitor 'Companies'" and therefore "not 'relevant'." We note that some sources, such as opposer's online forum evidence, is of limited probative value and may be inconclusive with regard to a genericness claim. *In re Noon Hour Food Products, Inc.* 88 USPQ2d 1172, 1178 (TTAB 2008).

Exhibit G-9

. . . tubular headers fitted with an X-pipe, exiting through a set of Tom Williamson-crafted chrome rectangular exhaust tips(*Witchita Eagle*, Special delivery: Two Falcon fans turn a two-door station wagon into a sedan, July 27, 2003)

Exhibit G-15

An efficient exhaust system (header and/or X-pipe/H-pipe) will scavenge the exhaust (*National Dragster*, Perfecting the Powerband, Part Two, May 9, 2008)

Exhibit G-16

A high-flow exhaust system with X-pipe crossover offers better power delivery (*Ancaster News*, Shelby drops its top for 2008 model year, September 14, 2007)

Exhibit G-17

. . . an X-pipe for the exhaust system and freer-flowing after market mufflers. (*Dallas Morning News*, Ok, he'll pony up: In a Mustang Shelby GT, maturity and cash fly out the windows, July 1, 2007)

Exhibit G-18

The system uses an X-pipe with twin mufflers, saving more than 30 pounds. (*Autoweek*, Packing powerful BMW performance, Volume 57, Issue 19, May 7, 2007)

Exhibit G-19

. . . modify it with Ford parts that include cold air and muffler kits, an X-pipe, a performance exhaust system and a power pack (*Boston Herald*, Hertz saddles up wild Mustangs, July 23, 2006)

Exhibit G-23

So, to shed some well-needed light on these questions, we put together a collection of five off-road X-pipes . . . and a catted version of one of the X-pipes. (*Mustang Enthusiast*, Volume 3, Issue 2, March 2005)

Online Publications

Exhibit G-1

"We picked up this X-pipe from Pacifica Performance While improving the sound of your pony is reason enough to install an off-road X pipe" (*FordMuscleWebmagazine*, <http://www.fordmuscle.com/>)

archives/2004/12/Xhale/index.php).

Exhibit G-27

The theory behind this design is that it will keep the velocity of the exhaust gases moving quickly through the header sink to the X-pipe to maximize the scavenging effect (*Car Craft Magazine, An Exhaust System Based on a Universal X-Pipe Crossover and A Pair of Stainless Steel Street Series Mufflers* www.carcraft.com/techarticles/exhaust_system_installation/index)

Exhibit G-28

. . . an X-pipe's scavenging advantage over an H-pipe increases with rpm. . . . In the X-pipe design, because the right and left exhaust pipes are siamesed for some distance (*5.0 and Super Fords magazine, 1999 Cobra X-Pipe This Time we X-Periment on a Four-Valve Modular, http://www.mustang50magazine.com/techarticles/17880_1999_cobra*).

Use by Others in the Trade

Exhibit D-1

An x pipe is named after its shape The difference is that the X pipe shape allows you to get some extra horsepower out of your engine." (www.carpartswholesale.com)

Exhibit D-2

Many "X" pipes on the market are nothing more than two 90 Degree Elbows" All "X" Pipes are NOT the same. (www.torquetechexh.com)

Exhibit D-4

. . . we wanted to ensure that our new Section 2 x-pipe was both high quality as well as functional. . . . As an added feature, we've incorporated an external 'dump' at the end of the X-pipe for total user controllable sound. (www.rougueengineering.com)

Exhibit D-6

Rated one of the bet[sic] X-pipes for the money by 5.0 Mustang. (www.hedman.com)

Exhibit D-9

All BBK Full Length X-Pipes are Direct Replacements for

Stock or Aftermarket Shorty Header
(www.bbkperformance.com)

Exhibit D 10
Your car's x pipe will be specifically made for your
vehicle-- (www.thepartsbin.com)

Exhibit D 13
"Replace your restrictive worn out catalytic converters
with these free flowing, all Stainless Steel 2-1/2"
high flow catalytic converter X-Pipe. (www.steeda.com)

Exhibit D 14

. . . the X Pipes are a classic over-and-under
shotgun design Check out the magazine and TV
project bikes and you are sure to see X Pipes up close!
(www.supertrapp.com)

Exhibit D 15

Our new X-Pipe is the best fitting system available
without question Also unlike all the
competitors so called X-Pipes that use a box design or
stamped steel that mimic a real X-Pipe design but have
settled for a cheap design . . . (www.uprproducts.com)

Exhibit D 16

Our universal X-pipes fit an overwhelming variety of
classic cars with ease of installation.
(www.pypesexhaust.com)

Exhibit D 17

. . . these X-pipes use free-flowing mandrel-bent
tubing (www.americanmuscle.com)

Applicant contends that all of opposer's evidence is
not reflective of "'relevant public opinion'" as
"[e]verything Opposer presented was from his fellow
competitors, not from the public" and therefore, this
evidence fails to prove applicant's mark is generic.

We find applicant's protests against the probative
value of the competitor evidence unconvincing. "[T]he cases

have recognized that competitor use is evidence of genericness," *BellSouth Corp. v. DataNational Corp.*, 60 F.3d 1565, 35 USPQ2d 1554, 1558 (Fed. Cir. 1995), and that "evidence of competitors' use of particular words as the name of their goods or services, is . . . persuasive evidence that those words would be perceived by purchasers as a generic designation for the goods or services." *Phillip Morris Incorporated, et. al. v. Williamson Tobacco Corporation*, 230 USPQ 172, 176 (TTAB 1986). In this case, opposer's evidence establishes competitor use of the term "x-pipe" in a generic manner for exhaust products.

Additionally, the newspaper and magazine evidence provides strong evidence of the relevant public's perception of the designation "x-pipe" as a generic term. See e.g., *In re Log Cabin Homes Ltd.*, 52 USPQ2d 1206 (TTAB 1999) (noting that stories from magazines and newspapers demonstrate that the term "log cabin homes" has a well understood meaning).

Applicant further argues that even if "any [competitor] use is pertinent," opposer's "exhibits fail" because applicant's mark "was used only 16 times" and the mixture of usages do not show by clear evidence that applicants' mark is generic. (Applicant's Exhibit IX).

However, applicant's attempt to discount the evidence of use of "x-pipe" by competitors is not convincing as minor variations in the display of a generic term (in this case,

e.g., "xpipe", "XPIPE", "X pipe", "x pipe", "X pipes", "X Pipe", "X Pipes", "X-PIPE", "X-PIPES") typically are legally insignificant and do not avoid a finding of genericness. *In re Noon Hour Food Products Inc.*, 88 USPQ2d at 1173 n.2 (TTAB 2008) ("Certainly an upper-case letter or the addition of a hyphen (or a space) cannot obviate the statutory bar to registration of a generic designation any more than can a slight misspelling of such a term").

Opposer has also provided evidence of use of the terms H-pipe and Y-pipe for exhaust systems and exhaust pipes as evidence of naming conventions in the industry with regard to exhaust systems and exhaust pipes. This evidence is further supported by the declaration of Boyd Butler, President of Dr. Gas Incorporated, a competitor of applicant, who declares that his company has "used the terms y-pipe, h-pipe, t-pipe and q-pipe generically and descriptively in connection with exhaust system and exhaust pipes . . . it is common practice to use the alphabet to describe piping joint layout configurations, in this and other industries." Opposer's Exhibit L, Butler declaration at paragraph 5.¹¹

¹¹ In applicant's response brief, applicant complains that the Butler declaration offers a legal conclusion that Butler used the mark 'generically.' For purposes of the motion for summary judgment, we have considered and accorded appropriate probative weight to the factual statements in the Butler declaration to the extent that they are made on personal knowledge, that they set forth facts as would be admissible in evidence, and that they

Although applicant argues that this evidence is not relevant, we find that this evidence is relevant to opposer's genericness claim. In short, the way in which "x-pipe" is used with exhausts is similar to the use in the industry of other descriptive or generic terms for the same type of goods (e.g., Y-pipe or H-pipe) and provides further evidentiary support for opposer's claim of genericness for the term "x-pipe".

Applicant's Use (Opposer's Exhibit A)

Opposer's evidence includes copies of pages from applicant's website. This evidence does show use of X-PIPE by applicant in the manner of a trademark. However, in view of opposer's clear evidence of genericness, this evidence is not sufficient to raise a genuine issue of material fact by creating a mixed record of generic use. See e.g., *In re International Business Machines Corporation*, 81 USPQ2d 1677, 1684 (TTAB 2006) (finding significant evidence of generic use is not offset by applicant's evidence that shows proper trademark use by applicant).

Accordingly, we find that there is no genuine issue of material fact that the relevant public perceives "x-pipe" as

show that the declarant is competent to testify as to the matters set forth therein. See Fed. R. Civ. P. 56(e); TBMP Section 528.05(b). Applicant also complains that the Butler declaration is "un-notarized." Because the Butler declaration is subscribed to by a written declaration under Trademark Rule 2.20, it is acceptable. See TMEP Section 804.01 (5th ed. September 2007).

referring to internal combustion engine exhausts which contain exhaust pipes and discharge pipes and, thus, the term is generic for applicant's goods. Applicant's arguments with respect to the evidence of record are not persuasive of a contrary result.

Based on the parties' arguments and evidence of record we find that opposer has met its burden of establishing that there is no genuine issue of material fact that the primary significance of "x-pipe" is as a generic term, and not as a source identifier for applicant's goods, "internal combustion engine exhausts".

Accordingly, opposer's motion for summary judgment is granted, the opposition is sustained and registration to applicant's application Serial No. 78004925 is refused.¹²

¹² In view of our decision herein, we need not reach the naked licensing issue on summary judgment. Additionally, all pending motions and requests of the parties not addressed herein are deemed moot.