

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

TBC Trademarks, LLC

v.

Heckethorn Products, Inc.

Opposition No. 91179460
to Application Serial No. 77017321
filed October 10, 2006

Carrie A. Shufflebarger of Thompson Hine LLP for TBC Trademarks, LLC.

W. Lewis Jenkins, Jr. of Wilkerson Gauldin Hayes & Jenkins, and Edward D. Lanquist, Jr. of Wadley & Patterson, P.C., for Heckethorn Products, Inc.

Before Bucher, Bergsman and Gorowitz, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Heckethorn Products, Inc. (“applicant”) filed an intent-to-use application to register the mark ROUGH COUNTRY, in standard character form, for ‘tires, namely tires for off road trucks and vehicles,” in Class 12. Applicant claimed ownership of Registration No. 1006015 for the mark ROUGH COUNTRY, in typed

drawing form, for “motor vehicle suspension components – namely, shock absorbers and springs,” in Class 12.¹

TBC Trademarks, LLC (“opposer”) opposed the registration of applicant’s mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d). Opposer alleged that applicant’s mark ROUGH COUNTRY for tires for off road truck and vehicles so resembles opposer’s mark WILD COUNTRY for tires as to be likely to cause confusion. Opposer claimed ownership of the following registrations for “tires,” in Class 12:²

1. Registration No. 1755187 for the mark WILD COUNTRY, in typed drawing form;³

2. Registration No. 2939499 for the mark WILD COUNTRY XRT, in standard character form;⁴ and

3. Registration No. 3031118 for the mark WILD COUNTRY RADIAL XTX, in standard character form.⁵

Applicant, in its answer, denied the salient allegations in the notice of opposition.

¹ Second renewal.

² Opposer also claimed ownership of Registration No. 3113431 for the mark WILD COUNTRY RADIAL TXR, in typed drawing form, but this registration was canceled because opposer did not file a declaration of use under Section 8 of the Trademark Act.

³ Registered March 2, 1993; renewed. To date, opposer has not filed a Section 8 declaration of use or Section 9 renewal application.

⁴ Registered April 12, 2005; affidavits under Sections 8 and 15 accepted and acknowledged.

⁵ Registered December 20, 2005; affidavits under Sections 8 and 15 accepted and acknowledged. Opposer disclaimed the exclusive right to use “Radial.”

The Record

In addition to the pleadings, the file of the opposed application is part of the record without any action by the parties. Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b).

A. Opposer's testimony and evidence.

1. Testimony deposition of Jon David Vance, the Director of Product Marketing for TBC Wholesale, a related company to opposer, with attached exhibits; and

2. A notice of reliance on the following items:

- a. Copies of opposer's pleaded registrations printed from the electronic database of the U.S. Patent and Trademark Office showing the current title and status of the registrations;⁶
- b. Applicant's responses to opposer's interrogatory Nos. 4 and 6;
- c. Applicant's responses to opposer's requests for admission;
- d. Copies of dictionary definitions of the words "Rough" and "Wild";
and
- e. Copies of news articles from printed publications;

B. Applicant's testimony and evidence.

1. Testimony deposition of Michael Heckethorn, applicant's President, with attached exhibits;

⁶ Opposer attached to the notice of opposition copies of its pleaded registrations printed from the electronic database of the U.S. Patent and Trademark Office showing the current title and status of the registrations. *See* Trademark Rule 2.122(d)(1).

2. A second testimony deposition of John Vance with attached exhibits;
and
3. Applicant's notice of reliance on the following items:
 - a. Applicant's Registration No. 1006015 for the mark ROUGH COUNTRY;
 - b. Copies of third-party registrations consisting in part of the word "Country" for tires;
 - c. Excerpts from applicant's website showing use of the mark ROUGH COUNTRY for lift kits, shocks and springs; and
 - d. Excerpts from third-party websites.

Standing

As opposer has properly made its pleaded registrations of record, opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 U.S.P.Q.2d 1842, 1844 (Fed. Cir. 2000); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 U.S.P.Q. 185, 189 (C.C.P.A. 1982).

Priority

As opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in this case as to the marks and the goods covered by the registrations. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 U.S.P.Q. 108, 110 (C.C.P.A. 1974).

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 issue of

likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks”). These factors, and any other relevant *du Pont* factors in the proceeding now before us, will be considered in this decision.

A. The similarity or dissimilarity and nature of the goods.

Opposer has registered its marks for “tires” and applicant seeks to register its mark for “tires for off road trucks and vehicles.” Because opposer’s “tires” encompass “tires for off road trucks and vehicles,” the goods are legally identical.

B. Likely-to-continue, established channels of trade and classes of consumers.

Because the goods are legally identical, we must presume that the channels of trade and classes of purchasers are the same. *See American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *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.”). *See also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even

though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion).

C. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression and the strength of opposer's marks.

We turn now to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1987). In comparing the marks, we are mindful that where, as here, the goods are legally identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

Further, 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 impression so that confusion as to the source of the goods offered under the respective marks is likely

to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992).

Applicant is seeking to register the mark ROUGH COUNTRY while opposer has registered the mark WILD COUNTRY and variations thereof. The marks are similar to the extent that they both include the word “Country” as the second word. The initial words “Rough” and “Wild” look different and sound different, but they have similar meanings and engender similar commercial impressions.

The word “Rough” is defined, *inter alia*, as

1 not smooth or level. 2 not gentle. 3 (of weather or of the sea) wild and stormy.⁷

The word “Wild” is defined, *inter alia*, as

2 (of scenery or a region) not lived in or changed by people. 3 lacking discipline or control.⁸

Synonyms for “Wild” include “rough.”⁹

Two designations may be dissimilar in appearance yet create the same mental impression because they share the same meaning or connotation. To the extent that the similarity of mental impression predominates over the

⁷ OXFORD AMERICAN DESK DICTIONARY & THESAURUS, p. 680 (3rd ed. 2010) attached as Exhibit H to opposer’s notice of reliance. *See also* THE RANDOM HOUSE COLLEGE DICTIONARY, p. 1148 (Rev. Ed. 1975) (“steep, uneven, or wild: *rough country*.”); THE CASSELL THESAURUS, p. 572 (1998) (“7 (turbulent) agitated, choppy, inclement, squally, stormy, tempestuous, turbulent, wild.”)

⁸ *Id.* at p. 877. *See also* THE CASSELL THESAURUS, p. 752 (5 (way-ward, disorderly) ... rough ...”)

⁹ *Id.*

dissimilarities in appearance, a likelihood of confusion may result.

RESTATEMENT [THIRD] OF UNFAIR COMPETITION § 21, cmt. F, at 231 (1995). *See also Hancock v. American Steel & Wire Co., of New Jersey*, 203 F.2d 373, 97 USPQ 330, 332 (CCPA 1953) (“In determining likelihood of confusion between marks on identical goods, it is proper to consider their appearance, sound and meaning. [Internal citation omitted]. Clearly the involved marks “Tornado” and “Cyclone” do not look or sound alike. But a combination of all three factors need not necessarily exist, and an opposition to registration may be sustained if the marks are identical or so similar in meaning that confusion as to origin is deemed likely.”); *United Rum Merchants Limited v. Fregal, Inc.*, 216 USPQ 217, 219 (TTAB 1982) (“Looking at the marks themselves and recognizing that similarities in sound and appearance between ‘TIA LOLA’ and ‘TIA MARIA’ are largely limited to the term ‘TIA’, the Board is nevertheless persuaded that these marks, viewed in their entirety, readily evoke the same commercial impression. It is well established that similarity of connotation or commercial impression alone is sufficient to support a finding of likelihood of confusion between marks.”). We find that both marks engender the commercial impression of uninhabited, unpopulated, rugged country.

On the other hand, applicant contends that “too many others in the off road tire space also tries [sic] to achieve the same connotation.”¹⁰ Applicant references eight third-party registrations consisting of, in part, the word “Country” for tires, including ALL COUNTRY (Reg. No. 3073522), OPEN COUNTRY (Reg. No.

¹⁰ Applicant’s Brief, p. 9.

3068763) and HIGH COUNTRY (Reg. No. 1787465).¹¹ In addition, Mr. Heckethorn, applicant's President, testified that applicant sells the DICK CEPEK MUD COUNTRY tires and the FUN COUNTRY tires.¹² Mr. Heckethorn also testified that the day before his deposition, he looked up the third-party registrations on the Internet and saw that they were all offered for sale.¹³

The third-party "Country" registrations may be used in a manner similar to dictionaries to show how the word "Country" may be perceived. *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1285 (Fed. Cir. 1984) (third-party registrations can demonstrate the ordinary dictionary meaning of a word); *Tektonrix, Inc. v. Daktronics, Inc.*, 187 USPQ 588, 592 (TTAB 1975) (third-party registrations serve to suggest that the suffixes "tronics" and "tronix" were adopted to convey that the goods are electrical). In this case, the third-party registrants adopted the word "Country" as part of their marks to capture the rural, rustic, farmland, parkland or sparsely populated meaning that the word conveys.

However, third-party registrations are not evidence of what happens in the marketplace or that customers are familiar with the marks. *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973). Likewise,

¹¹ Applicant's notice of reliance, Exhibits B-J.

¹² Heckethorn Dep., pp. 8 and 12.

¹³ Heckethorn Dep., pp. 8-12. Opposer objects to Mr. Heckethorn's testimony regarding the third-party use of the "Country" marks on the ground that the testimony is hearsay and it is uncorroborated. Opposer's objections are overruled. Mr. Heckethorn's testimony is not hearsay. He is testifying about the results he found when he surveyed the internet for third-party use and his testimony was subject to cross-examination. The fact that Mr. Heckethorn's testimony is uncorroborated because applicant did not produce the Internet results viewed by Mr. Heckethorn, goes to the weight of the testimony not its admissibility.

Mr. Heckethorn's testimony that he encountered these marks on the Internet is not very probative of what happens in the marketplace or that customers are familiar with the marks. Mr. Heckethorn was looking for those specific tires for purposes of his testimony, rather than acting as a consumer would when searching for an off road tire. Thus, we would be speculating if we were to conclude from Mr. Heckethorn's testimony that the marks were in use on a commercial scale or that the public has become familiar with them, especially because, as opposer pointed out, applicant did not introduce the Internet evidence about which Mr. Heckethorn testified.

Further, opposer contends that its WILD COUNTRY marks have a strong market presence in the tire field. Opposer began using the WILD COUNTRY mark in 1977.¹⁴ Because opposer has designated its sales figures as confidential, we can only refer to them in general terms. In this regard, opposer's sales in terms of units and revenue have been significant.¹⁵

In view of the foregoing, we find that similarities of marks outweigh the dissimilarities. In this regard, we note that there is a heavy burden on the newcomer to avoid consumer confusion as to products and their source. *Bridgestone*

¹⁴ Vance Dep., p. 21.

¹⁵ Confidential Vance Dep., pp. 5-17 and Exhibits 23-25. Opposer overstates the unsolicited media attention its WILD COUNTRY mark has received. For example, although the article in *Modern Tire Dealer* about Les Schwab, one of the country's leading tire retailers, showed a photograph of Mr. Schwab's JEEP with WILD COUNTRY tires, a reader probably would not have noticed the tires unless it was pointed out. Moreover, the article states that "many Schwab customers buy Les Schwab tires with scarcely a look at the brand name on the sidewall." (Opposer's notice of reliance, Exhibit R). WILD COUNTRY is merely a passing reference in the other articles.

Americas Tire Operations LLC v. Federal Corp., 673 F.3d 1330, 102 USPQ2d 1061, 1065 (Fed. Cir. 2012) (MILANZA for tires is likely to cause confusion with opposer's POTENZA and TURANZA marks since “[t]here is a heavy burden on the newcomer to avoid confusion as to products and their source.”).

D. Balancing the factors.

In light of the identity of the goods, the presumption that the channels of trade and classes of consumers are the same, opposer's lengthy prior use of WILD COUNTRY, the market strength of the WILD COUNTRY mark, and the similarities of the connotation and commercial impression engendered by the marks, we find that applicant's proposed use of ROUGH COUNTRY for ‘tires, namely tires for off road trucks and vehicles’ is likely to cause confusion with opposer's WILD COUNTRY marks for tires.

To the extent that there is any doubt about the likelihood of confusion, that doubt must be resolved in favor of opposer. *Nike Inc. v WNBA Enterprises LLC*, 85 USPQ2d 1187, 1202 (TTAB 2007); *Hard Rock Cafe International (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1514 (TTAB 2000).

Decision: The opposition is sustained and registration to applicant is refused.