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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91194974
Party	Defendant GFA Brands, Inc.
Correspondence Address	MARTA LEVINE QUARLES BRADY LLP 411 EAST WISCONSIN AVE MILWAUKEE, WI 53202 UNITED STATES marta.levine@quarles.com, david.cross@quarles.com
Submission	Opposition/Response to Motion
Filer's Name	John E. Conour
Filer's e-mail	john.conour@quarles.com, marta.levine@quarles.com, david.cross@quarles.com, veronica.brooks@quarles.com, crdickson@jonesday.com
Signature	/John E. Conour/
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**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

PROMARK BRANDS INC., & H.J.
HEINZ COMPANY,

**Opposition Nos. 91194974
91196358**

Opposers,

U.S. Trademark Application 77/864,305
For the Mark **SMART BALANCE**
Published in the Official Gazette on April 20, 2010

v.

GFA BRANDS, INC.,

U.S. Trademark Application 77/864,268
For the Mark **SMART BALANCE**
Published in the Official Gazette on August 10, 2010

Applicant.

APPLICANT'S OPPOSITION TO OPPOSERS' MOTION TO STRIKE

SUMMARY OF ARGUMENT

Opposers' motion to strike Applicant GFA Brands' survey expert report should be denied because it is: (a) procedurally improper, and (b) wrong on the merits. The motion is procedurally improper because, as the Board explained in its March 16, 2012 Order denying Opposers' previous attempt to block GFA's rebuttal survey, "Objections regarding the rebuttal survey are properly left for trial. The Board does not entertain motions in limine. TBMP Sections 707.01 and 527.01(f)." (A copy of the March 16, 2012 Order is Exhibit 1 to Opposers' Motion to Strike, p. 4, ft. nt. 3). Opposers' motion should be denied on its merits because, as the Board has repeatedly held, a survey offered in response to an opposing party's survey is perfectly appropriate rebuttal evidence, even if it could have been offered in a party's case in chief.

ARGUMENT

I. OPPOSERS' MOTION IS PROCEDURALLY IMPROPER BECAUSE IT VIOLATES THE BOARD'S POLICY AGAINST CONSIDERING OBJECTIONS TO TRIAL EVIDENCE BEFORE FINAL DECISION.

The Opposers' latest motion, its second improper attempt to prevent GFA from responding to Opposers' survey with a survey of its own, violates the Board's practice against "prospective or hypothetical evidentiary rulings." TBMP § 527.01(f). As explained in at least three places in the Board's Manual of Procedure, it is the Board's policy not to read trial testimony or examine other trial evidence prior to final decision. For this reason, "the Board will defer consideration of substantive objections to trial evidence (e.g., on grounds of hearsay, relevance, or that the evidence constitutes **improper rebuttal**) until final decision." TBMP § 502.01 (emphasis added). The proper practice for objecting prospectively to trial evidence is to "file a motion to strike or otherwise object to such evidence after it is introduced, identifying the specific evidence objected to and the asserted basis for exclusion thereof." TBMP § 527.01(f); see also § 707.02(c) (objections about "improper rebuttal" should be raised in the objecting party's trial brief).

As Opposers point out, substance matters more than labels.¹ Accordingly, the Board has consistently followed its policy against addressing objections to rebuttal evidence before trial regardless of whether the motion is labeled a motion to strike, a motion in limine, or a motion to exclude. See M-Tek Inc. v. CVP Systems Inc., 17 USPQ2d 1070, 1072 (TTAB 1990) ("motion to strike"); Greenhouse Systems Inc. v. Carson, 37 USPQ2d 1748, 1750-51 (motion "in limine" for "exclusion" of evidence) (TTAB 1995).

¹ Oddly, while arguing that labels do not matter Opposers also criticize GFA for not labeling Mr. Johnson's survey report a "rebuttal."

Opposers' violation of this policy is surprising, given the Board's March 16, 2012 Order in which it brought its policy to Opposers' attention. The Board specifically warned Opposers that any objections Opposers may have to GFA's "rebuttal survey are properly left for trial." March 16, 2012 Order, p. 4, ft. nt. 3. Opposers moved to strike anyway. Their motion should be denied for this reason alone.

II. GFA'S SURVEY EXPERT REPORT IS PROPER REBUTTAL.

In response to Opposers' survey conducted by Dr. Sabol, purporting to show a likelihood of confusion, GFA has disclosed the expert report of Leon Kaplan, which is a critique of Sabol's survey methods. But Mr. Kaplan did not perform a survey of his own. GFA therefore also commissioned a survey conducted by Phillip Johnson, a highly qualified survey expert, which shows no likelihood of confusion. GFA went beyond merely disclosing an expert's criticism of Sabol's survey, because criticizing a survey is not as persuasive as also proving that survey results actually differ when the survey is done correctly.

Mr. Johnson's survey, which is conducted in accordance with generally accepted survey methodology and corrects the errors Mr. Kaplan identified in the Sabol survey, yields significantly different results -- just 2% of respondents indicated confusion compared to 32% in Sabol's survey. Pointing out flaws in a survey without more is not as compelling as taking the additional step of proving whether those flaws actually affect survey results. GFA's rebuttal survey picks-up where Leon Kaplan's critique of Sabol's survey leaves off -- Mr. Johnson's rebuttal survey proves that Sabol's survey is flawed in ways that actually matter, yielding a significantly different conclusion about whether GFA's proposed use of the SMART BALANCE mark should be allowed.

The Board has repeatedly held that responsive surveys and accompanying expert testimony are appropriate rebuttal evidence. Furthermore, the Board has specifically held that

surveys are appropriate rebuttal evidence even if they could have been offered in a party's case in chief. For example, just two weeks ago in AMBEV v. The Coca-Cola Company, Opposition Numbers 91178953, et al. (May 2, 2012) (non-precedential)(attached as Exhibit 1), the Board held that a survey and accompanying expert testimony are proper rebuttal in response to an opposing party's survey. The Board specifically addressed the argument raised by Opposers here, that a rebuttal survey should not be allowed because it is evidence that could have been offered in the proponent's case in chief: "Moreover, the fact that evidence might have been offered in chief does not preclude its admission as rebuttal. Data Packaging Corp. v. Morning Star, Inc., 212 U.S.P.Q. 109, 113 (TTAB 1981)." Id. at p. 5. The Board has reached the same conclusion in at least two other cases, Helene Curtis Industries, Inc. v. Suave Shoe Corp., 13 U.S.P.Q.2d 1618, 1624-1628 and ft. nt. 33 (TTAB 1989) and Bridgestone Fire North American Tire v. Federal Corporation, Opposition No. 91168556, p. 2 (TTAB 2010) (non-precedential) (attached as Exhibit 1).

Rather than filing a premature and substantively wrong motion to strike, Opposers could have availed themselves of their right under Rule 26(a)(2)(D)(ii) to submit contradictory or rebuttal evidence on the same subject matter identified by GFA in Mr. Johnson's survey report. Under the rules, Opposers could have devoted their attention to working with their expert to formulate a rejoinder to Johnson's report. They had 30 days after GFA served Mr. Johnson's report on April 28, 2012 to do so. That they have not strongly suggests they have no expert who could credibly criticize Mr. Johnson's methodology.

CONCLUSION

Denying Opposers' motion to strike is completely in accord with Board precedent, both as to the proper procedural mechanism for challenging evidence that is purportedly improper

rebuttal and on the merits (or lack thereof) of Opposers' motion. Furthermore, Opposers' claim that they will be prejudiced ignores the procedural avenue they had to challenge Mr. Johnson's findings with contradictory or rebuttal expert evidence of their own, within 30 days of service of Mr. Johnson's report. GFA respectfully requests that Opposers' motion to strike should be denied.

Respectfully submitted,

Dated: May 17, 2012

By: /John E. Conour/
David R. Cross
John E. Conour
david.cross@quarles.com
john.conour@quarles.com
QUARLES & BRADY LLP
411 E. Wisconsin Avenue
Ste 2350
Milwaukee WI 53202-4426
Telephone: (414) 277-5669

Attorneys for GFA, GFA Brands, Inc.

EXHIBIT 1

T.T.A.B. NON-PRECEDENTIAL DECISIONS

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

Mailed: May 2, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Companhia de Bebidas das Américas - AMBEV

v.

The Coca Cola Company

Opposition Nos. 91178953; 91180439; 91180442; 91183447; 91183448;
91183452; 91183464; 91183465; 91183467; 91185734; 91185739;
91185750; 91186620; 91186661; 91188229; 91188396; and 91189018¹

W. Mack Webner and Jody H. Drake of Sughrue Mion, PLLC for
Companhia de Bebidas das Américas - AMBEV.

Bruce W. Baber of King & Spalding LLP for The Coca-Cola Company.

Before Bucher, Zervas, and Shaw,
Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

The Coca-Cola Company ("TCCC" or "applicant") has filed seventeen applications for the following marks, all containing, *inter alia*, the term ZERO for use on "beverages, namely soft drinks; syrups and concentrates for the making of the same," in International Class 32.

¹ Consolidated on May 5, 2008, December 24, 2008 and March 6, 2009.

SPRITE ZERO²
COCA-COLA ZERO³
FANTA ZERO⁴
COKE ZERO⁵
VAULT ZERO⁶
PIBB ZERO⁷
COKE ZERO ENERGY⁸
COKE ZERO BOLD⁹
COKE CHERRY ZERO¹⁰
CHERRY COCA-COLA ZERO¹¹
COCA-COLA CHERRY ZERO¹²
CHERRY COKE ZERO¹³
COCA-COLA VANILLA ZERO¹⁴
VANILLA COKE ZERO¹⁵
VANILLA COCA-COLA ZERO¹⁶
POWERADE ZERO¹⁷
FULL THROTTLE ZERO¹⁸

² Application Ser. No. 78316078, filed October 20, 2003, alleging first use anywhere and in commerce on September 13, 2004.

³ Application Ser. No. 78580598, filed March 4, 2005, alleging first use anywhere and in commerce on June 13, 2005.

⁴ Application Ser. No. 78620677, filed May 2, 2005, alleging a bona fide intent to use the mark.

⁵ Application Ser. No. 78664176, filed July 6, 2005, alleging first use anywhere and in commerce on June 13, 2005.

⁶ Application Ser. No. 78698990, filed August 24, 2005, alleging first use anywhere and in commerce on December 2, 2005.

⁷ Application Ser. No. 77097644, filed February 27, 2007, alleging first use anywhere and in commerce as July 2005.

⁸ Application Ser. No. 76674382, filed March 22, 2007, alleging a bona fide intent to use the mark.

⁹ Application Ser. No. 76674383, filed March 22, 2007, alleging a bona fide intent to use the mark.

¹⁰ Application Ser. No. 77175066, filed May 8, 2007, alleging first use anywhere and in commerce on January 29, 2007.

¹¹ Application Ser. No. 77175127, filed May 8, 2007, alleging a bona fide intent to use the mark.

¹² Application Ser. No. 77176279, filed May 9, 2007, alleging first use anywhere and in commerce on January 29, 2007.

¹³ Application Ser. No. 77176127, filed May 9, 2007, alleging a bona fide intent to use the mark.

¹⁴ Application Ser. No. 77176108, filed May 9, 2007, alleging a bona fide intent to use the mark.

¹⁵ Application Ser. No. 77176099, filed May 9, 2007, alleging a bona fide intent to use the mark.

¹⁶ Application Ser. No. 77257653, filed August 17, 2007, alleging a bona fide intent to use the mark.

¹⁷ Application Ser. No. 77309752, filed October 22, 2007, alleging first use anywhere and in commerce as May 2008.

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In each of these applications TCCC has claimed that ZERO has acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).

Companhia de Bebidas das Américas - AMBEV ("Ambev" or "opposer") has opposed registration of each application on the same grounds, namely, that the term ZERO is merely descriptive and that the evidence of acquired distinctiveness is insufficient to permit registration on the Principal Register under Section 2(f).

Applicant, in its answer, denied the salient allegations of the notice of opposition. The case is fully briefed and an oral hearing was held on October 5, 2011.

The Record

The evidence of record, as fully referenced in the parties' briefs, is voluminous, consisting of the pleadings, the files of the involved applications, third party registrations of marks including the term ZERO, surveys and testimony depositions on behalf of opposer and applicant, respectively, all with accompanying exhibits, and numerous additional exhibits made of record by the parties' notices of reliance (NOR).

Opposer's Evidentiary Objections

Ambev has made two objections to TCCC's evidence.

First, Ambev objects to the survey and testimony of TCCC's expert witness, Dr. Simonson, as improper rebuttal because he was

¹⁸ Application Ser. No. 77413618, filed March 5, 2008, alleging

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identified only as a rebuttal witness, not as a witness for TCCC's case in chief.¹⁹

As background, we note that during its main testimony period, opposer introduced the testimony deposition of Dr. Thomas D. Dupont, former President of D2 Research, a company that specialized in designing and conducting surveys to measure consumer perception. Dr. Dupont, through D2 Research, conducted a survey to determine "the main function of the word "zero" . . . in the brand name Coca-Cola Zero." Dupont testimony at 6.

Applicant introduced the testimony deposition of Dr. Alex Simonson, applicant's expert witness regarding surveys. Dr. Simonson was identified by applicant in its expert disclosures as a rebuttal witness. Applicant's Br. at 29. Dr. Simonson critiqued the survey conducted by Dr. Dupont and opined as to how the survey should have been conducted. Dr. Simonson also conducted a "standard secondary meaning survey as to ZERO." *Id* at 12.

Ambev argues that the Simonson survey and testimony should be excluded because it constitutes improper rebuttal in that it did not "test the same question that was posed in the Ambev survey it purports to rebut." Opposer's Br. at 7, n.2. Ambev is correct that TCCC identified Simonson as a rebuttal witness and therefore his survey and testimony should be limited to rebuttal.

a bona fide intent to use the mark.

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However, the rebuttal survey and testimony need not be limited to the same question that was posed in Ambev's survey. The purpose of rebuttal is to "introduce facts and witnesses appropriate to deny, explain or discredit the facts and witnesses adduced by the opponent. . . ." *Royal Crown Cola Co. v. Bakers Franchise Corp.*, 150 USPQ 698, 700 (TTAB 1966), *affirmed*, 160 USPQ 192, (CCPA 1969).

Because Dr. Simonson's survey and testimony regarding that survey are proper rebuttal to the extent that they bear on the validity and probative value of the Dupont survey, Ambev's objection is not well taken. Moreover, the fact that evidence might have been offered in chief does not preclude its admission as rebuttal. *Data Packaging Corp. v. Morning Star, Inc.*, 212 USPQ 109, 113 (TTAB 1981). Accordingly, we have considered the Simonson survey and testimony to the extent that they seek to "deny, explain or discredit" Ambev's survey and testimony. *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1625 n.33 (TTAB 1989). To that extent, Ambev's objection is overruled.

Second, Ambev objects to the portion of TCCC's notice of reliance that was filed on Ambev's responses to Applicant's Requests for Documents and Things. Opposer's Br. at 7, n.3. Ambev argues that responses to document requests are not

¹⁹ Neither party challenged the qualifications of the other's expert; we therefore accept that both experts are qualified to offer expert testimony.

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admissible under a notice of reliance. TCCC responds that it is not relying on any documents produced but only upon Ambev's written responses, which are properly submitted through a notice of reliance. Applicant's Br. at 11, n.2.

Documents produced in response to document requests may not be submitted via a notice of reliance except to the extent they are admissible by notice of reliance under Trademark Rule 2.122(e) (printed publications and official records). Conversely, written responses to document production requests, for example, indicating that no responsive documents exist, may be submitted via a notice of reliance. See *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1886 at n.5 (TTAB 2008). Since TCCC is only relying on Ambev's written responses, the objection is overruled.

Preliminary Issues

A. Whether Genericness was Tried by the Parties

As indicated above, opposer pleaded in its notice of opposition that the term ZERO is merely descriptive of applicant's goods and that opposer, by virtue of being in the beverage industry, "is in a position to use in the future the term ZERO descriptively in its ordinary descriptive sense in connection with its beverage products." Notice of Opposition dated August 15, 2007. Ambev did not raise the issue of genericness in any of its seventeen notices of opposition. Ambev argues in its brief that that "ZERO defines a genus of soft drink

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and is incapable of becoming a trademark for Coke's colas and other soft drinks." Opposer's Br. at 19. TCCC objects to this characterization of the issues before the Board on the ground that Ambev is raising the issue of genericness for the first time and the issue was neither pleaded nor litigated by the parties. Applicant's Br. at 38. TCCC's objection is well taken.

Since Ambev did not raise the issue of genericness in any of its notices of opposition, we may consider the issue only if we find that the issue was tried by the consent of the parties. Implied consent to the trial of an unpleaded issue can be found only where the nonoffering party (1) raised no objection to the introduction of evidence on the issue, and (2) was fairly apprised that the evidence was being offered in support of the issue. There must be no doubt that the non-moving party was aware that the issue was being tried. TBMP § 507.03(b) (3d ed. 2011) and cases cited therein.

We find no evidence that TCCC was aware that Ambev intended to argue genericness until opposer filed its brief. Ambev argues that the very nature of the term ZERO and TCCC's use of ZERO makes the issue "obvious." Opposer's Reply Br. at 6. However, much of the evidence discusses ZERO only when used as part of phrases such as ZERO-CALORIE, or ZERO-CARB and not by itself, or even as used by TCCC, with its other marks such as COKE, SPRITE, and FANTA. Thus, we do not find the issue to be as obvious as Ambev claims and it would be unfair to permit opposer to raise

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genericness at this late date. See *The U.S. Shoe Corp. v. Kiddie Kobbler Ltd.*, 231 USPQ 815, 817 (TTAB 1986); *Long John Silver's, Inc. v. Lou Scharf Inc.*, 213 USPQ 263, 266 (TTAB 1982). We conclude that genericness was not tried by either implied or express consent and is not an issue in this opposition.

B. Whether Mere Descriptiveness is an Issue in this Opposition

TCCC states that one of the issues in this opposition is whether "the preponderance of the evidence establish[es] that ZERO in the TCCC ZERO marks either is suggestive (and inherently distinctive) or has acquired distinctiveness." Applicant's Br. at 5. The suggestiveness (or inherent distinctiveness) of the term ZERO as part of TCCC's marks is not an issue in this opposition. All of TCCC's ZERO marks published showing a claim of acquired distinctiveness of the term ZERO under Section 2(f) of the Trademark Act. Publication under Section 2(f) is a concession that the relevant term or matter is not inherently distinctive. "Where, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the *statute* accepts a lack of inherent distinctiveness as an established fact. *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1571, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) (emphasis in original).

TCCC argues that its claim of acquired distinctiveness "was made in the alternative and did not constitute a concession by TCCC that ZERO, as used in the ZERO marks, is not inherently distinctive." Applicant's Br. at 15. TCCC cites to TMEP

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§ 1212.02(c) for support for this proposition but this section is of no avail. Section 1212.02(c) applies to the examination stage prior to publication and allows applicants to argue against a finding of descriptiveness while also submitting evidence of acquired distinctiveness. There is no evidence that TCCC complained to the Office after the Office published its applications that the Office had made a mistake showing that applicant claimed acquired distinctiveness in part as to the term ZERO. Having accepted publication of its ZERO marks under Section 2(f), TCCC may not now argue that ZERO is inherently distinctive or suggestive. *Yamaha*, 6 USPQ2d at 1005; TMEP Section 1212.02(c) (8th ed. 2011).

Accordingly, the only issue in this consolidated opposition is whether ZERO in each of TCCC's marks has acquired distinctiveness under Section 2(f).

The Parties

Ambev is a Brazilian company that manufactures and sells soft drinks and beers "throughout North and South America." Opposer's Br. at 2. Ambev also has filed an application to register the mark GUARANA ANTARCTICA ZERO AÇÚCAR and design for soft drinks.²⁰

Applicant is The Coca-Cola Company, "the world's largest beverage company." Applicant's Br. at 13. Beginning in 2005, applicant (hereinafter, "TCCC") began marketing and selling COCA-

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COLA ZERO as well as SPRITE ZERO, FANTA ZERO, and number of other beverages, all including the term ZERO.

Standing

"Any person who believes that he would be damaged by the registration of a mark upon the principal register . . . may, file an opposition . . . stating the grounds therefor." Section 13 of the Trademark Act of 1946, 15 U.S.C. § 1063(a). Thus, a party has standing to oppose in a Board proceeding if it can demonstrate a real interest in the proceeding. *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982), citing *Universal Oil Prods. Co. v. Rexall Drug and Chem. Co.*, 463 F.2d 1122, 174 USPQ 458 (CCPA 1972).

It is recognized that a party need not be a manufacturer or seller of the goods in connection with which a descriptive, misdescriptive, or merely ornamental designation is used in order to object to the registration thereof. It is sufficient that the party objecting to such registration be engaged in the manufacture and/or sale of the same or related goods and that the product in question be one that could be produced in the normal expansion of that person's business. If the designation in question is found to be merely descriptive, merely ornamental or the like, damage is presumed since a registration thereof with the statutory presumptions afforded the registration would be inconsistent with the right of another person to use these designations or designs in connection with the same or similar goods as it would have the right to do when and if it so chooses. Thus, opposer as a competitor of applicant, is a proper party to challenge applicant's right of registration.

Federal Glass Co. v. Corning Glass Works, 162 USPQ 279, 282-83 (TTAB 1969). See also 3 J. Thomas McCarthy, *McCarthy on*

²⁰Application Ser. No. 77181474, filed May 15, 2007, pursuant to

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Trademarks and Unfair Competition, § 20:11 (4th ed. 2007)

("Standing to oppose is presumed when the mark sought to be registered is allegedly descriptive of the goods and the opposer is one who has a sufficient interest in using the descriptive term in his business.").

Ambev has introduced evidence that it is a beverage company engaged in the marketing and sale of beverages in the United States and that it has filed an application for a trademark including the term ZERO for soft drinks. Ambev's application has been suspended pending the outcome of this proceeding. In view thereof, and because opposer's potential interest in using the term ZERO on beverages sold in the United States is sufficient to demonstrate that opposer has a real interest in this proceeding, opposer has established its standing.

Acquired Distinctiveness

As *Yamaha* explains, when matter proposed for registration under Section 2(f) is approved by the United States Patent and Trademark Office for publication, there is a presumption that the examining attorney found a prima facie case of acquired distinctiveness by the applicant for registration. *Yamaha*, 6 USPQ2d at 1004. In an opposition, "the opposer has the initial burden to establish prima facie that the applicant did not satisfy the acquired distinctiveness requirement of Section 2(f)." *Id.* "If the opposer does present its prima facie case

Section 1(b) of the Trademark Act.

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challenging the sufficiency of applicant's proof of acquired distinctiveness, the applicant may then find it necessary to present additional evidence and argument to rebut or overcome the opposer's showing. . . ." *Id.* However, under this analysis, the "ultimate burden of persuasion" is on the applicant. *Id.*

Finally, the standard for applicant to meet is preponderance of the evidence, "although logically that standard becomes more difficult to meet as the mark's descriptiveness increases."

Yamaha, 6 USPQ2d at 1008.

As discussed above, descriptiveness is not an issue given applicant's resort to Section 2(f) of the Trademark Act. Nonetheless, it is necessary to determine, at the outset, the degree of descriptiveness of ZERO as used in connection with the identified goods given that this determination will have a direct bearing on the amount of evidence necessary to show acquired distinctiveness. *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). The amount and character of evidence required to establish acquired distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered. *See Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 829, 166 USPQ 34, 39 (CCPA 1970). Typically, more evidence is required where a mark is so highly descriptive that purchasers seeing the matter in relation to the named goods or services would be less likely to believe that it indicates source in any one party. *See, e.g.,*

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In re Bongrain Int'l Corp., 894 F.2d 1316, 1318, 13 USPQ2d 1727, 1729 (Fed. Cir. 1990).

There is no question that the beverage industry, including the soft drink industry, commonly uses the term ZERO in direct association with nutritional facts or the names of ingredients such as "calories," "carbohydrates," "carbs," or "sugar" to identify the contents of soft drinks. Both parties have introduced ample evidence to show that terms such as "zero-calorie," "zero-carb," "zero-sugar," and the like are widely used by soft drink manufacturers. The testimony of Mary Krizan, Ambev's witness who testified that she purchased numerous beverages bearing the term ZERO, disclosed products such as ROCKSTAR ZERO CARB energy drink; EATING RIGHT, a "zero calorie" enhanced water beverage; ZEVIA, a diet soda with "ZERO calories"; and PEPSI MAX, a "zero calorie cola." Krizan Test. P. 5, Exh. Nos. 2, 18, 26, 64, and 72.

Ambev also introduced a number of third party trademark registrations for beverage marks including the disclaimed term ZERO such as "NO-CAL ZERO CALORIE SODA POP" and design (non-alcoholic beverages), "NO CARBS ZERO CALORIES" and design (drinking water with vitamins), "ZERO CALORIE SARATOGA SPLASH (flavored spring water beverages)," and "ZERO CAL" and design (soft drinks). Ambev's second NOR, dated April 28, 2010. While we do not consider these registrations as evidence proving use, these third party registrations can be considered in the manner

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of a dictionary to show the descriptive nature of ZERO for soft drinks.

Similarly, TCCC introduced product samples for a number of its beverages featuring the term ZERO in direct association with nutritional ingredients, such as "zero calorie cola," "zero sugar lemon lime soda," and "zero calorie sports drink." Baker Test., Exh. Nos. 1, 3, and 15.

While the foregoing evidence demonstrates that ZERO is treated as merely descriptive when used in connection with the nutritional facts or the names of ingredients of a variety of beverages including soft drinks, some of the evidence of record is more ambiguous. During the examination of Serial No. 78580598 for the mark COCA-COLA ZERO, TCCC introduced a number of third party registrations for beverage marks including the term ZERO on the Principal Register without a disclaimer of ZERO. Thus, LACTO ZERO (milk), BRUT ZERO (sparkling wines), SUB ZERO (alcoholic drinks), ZERO MANIPULATION (wines), TRIPLE ZERO (tequila and liqueurs), and ZERO LIMIT (smoothies) are all registered for various beverages without a disclaimer of zero. Application Serial No. 78580598, applicant's Response to Office Action, dated October 3, 2005.

These instances tend to show that when ZERO is not used in direct association with beverage ingredients, the treatment of ZERO as merely descriptive is mixed, at best. The evidence indicates that while ZERO may describe the particular amount of

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an ingredient or the nutritional content, by itself, ZERO only describes a general absence of some ingredient normally present. Thus, we are convinced that while ZERO merely describes a feature or characteristic of soft drinks, it is not so highly descriptive as to identify a product category.

Acquired distinctiveness may be shown by direct and/or circumstantial evidence. Direct evidence includes actual testimony, declarations or surveys of consumers as to their state of mind. Circumstantial evidence is evidence from which consumer association might be inferred, such as years of use, extensive amount of sales and advertising, and any similar evidence showing wide exposure of the mark to consumers. There is no fixed rule for the amount of proof necessary to demonstrate acquired distinctiveness. *Yamaha*, 6 USPQ2d at 1008 (evidence required to show acquired distinctiveness is directly proportional to the degree of non-distinctiveness of the mark at issue). Thus, even long periods of substantially exclusive use may not be sufficient to demonstrate acquired distinctiveness. Moreover, the burden is particularly heavy when that use has not been exclusive. *In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1952 (TTAB 2001) (66 years of use not sufficient given similarity of configuration to other guitars).

We first consider opposer's claim that applicant's evidence is insufficient to establish acquired distinctiveness. Ambev argues that TCCC must prove acquired distinctiveness as of the

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date the Section 2(f) claim was made, and not as of the pendency of these proceedings. Opposer's Br. at 22. This is incorrect. It is well-settled that acquired distinctiveness and buyer recognition are to be tested in an opposition proceeding as of the date the issue is under consideration. The filing date or even the publication date is not a cutoff for any evidence developing after that time. Evidence of sales and advertising after the filing date of the application will be considered. See *McCormick & Co. v. Summers*, 354 F.2d 668, 148 USPQ 272 (CCPA 1966); *Harsco Corp. v. Elec. Sci., Inc.*, 9 USPQ2d 1570 (TTAB 1988); and *Kaiser Aluminum & Chem. Corp. v. Am. Meter Co.*, 153 USPQ 419 (TTAB 1967).

TCCC's eight years of continuous use since at least 2004 on SPRITE ZERO, COCA-COLA ZERO and the other ZERO marks is more than five years contemplated by Section 2(f), but this is not necessarily conclusive or persuasive on the showing of acquired distinctiveness. In prior cases involving usage of comparable or even longer duration, and with some of these uses even being coupled with significant sales and advertising expenditures (not to mention direct evidence of customers' perceptions), the Board or its primary reviewing court has found a failure to demonstrate acquired distinctiveness within the meaning of Section 2(f). See *In re Andes Candies, Inc.*, 478 F.2d 1264, 178 USPQ 156, 158 (CCPA 1973); and *In re Packaging Specialists, Inc.*, 221 USPQ 917, 920 (TTAB 1984).

Applicant's sales, on the other hand, suggest that applicant has enjoyed a substantial degree of success with its ZERO line of beverages. In application Ser. No. 78580598 for the mark COCA-COLA ZERO, TCCC identified sales in the two years preceding its 2007 claim of acquired distinctiveness as exceeding one billion dollars, with over one-third of that amount attributable to sales of COCA-COLA ZERO alone. By 2007, over fifty million 288-fluid ounce cases of COCA-COLA ZERO had been sold by Applicant.

Application Serial No. 78580598, applicant's Response to Office Action, dated January 27, 2007; Baker Test. at 62, Exh. 19.

These are significant numbers by any measure. Furthermore, according to the non-confidential portions of the Baker testimony, sales of the ZERO line of beverages, including COCA-COLA ZERO, SPRITE ZERO, PIBB ZERO, FANTA ZERO, and other ZERO beverages have increased in the ensuing years to over four billion dollars, with over eight hundred and sixty million cases of COCA-COLA ZERO being sold. Baker Test. at 67, 70.

Advertising expenditures since 2004 likewise are a substantial sum. By early 2007, TCCC claimed that it had spent

in excess of one hundred fifty million dollars advertising and promoting its ZERO family of beverage products, which includes COCA-COLA ZERO, SPRITE ZERO, FANTA ZERO, VAULT ZERO, and PIBB ZERO, through a myriad of advertising and promotional channels. Applicant has spent over one hundred million dollars advertising and promoting COCA-COLA ZERO alone.

Application Serial No. 78580598, applicant's Response to Office Action, dated January 27, 2007. Again, we note that these are

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significant numbers by any measure. According to the non-confidential portions of the Baker testimony, TCCC's advertising expenditures for its entire line of ZERO line of beverages had risen to five hundred and thirty seven million dollars by mid-2010. Baker Test. at 111-112.

TCCC also has submitted a variety of advertising samples showing how the ZERO line of beverages is presented to consumers. The following representative example is from the Section 2(f) showing in application Serial No. 78580598:



Application Serial No. 78580598, applicant's Response to Office Action, dated January 27, 2007. We agree with TCCC that such advertisements attempt to convey to the consumer that ZERO as used on the goods is intended to serve in a "trademark sense as part of the product brand name" and not merely as conveying nutritional information. Applicant's Br. at 21.

Both during examination and during this proceeding, TCCC submitted numerous articles demonstrating unsolicited media coverage of its ZERO line of marks. Most of these fall into the category of press releases picked up by media outlets or stories about marketing campaigns. Nevertheless, the articles show that the ZERO line of beverages and TCCC's numerous marketing campaigns have been widely discussed in the media.

Finally, both parties submitted surveys. Ambev introduced the survey and testimony deposition of Dr. Dupont who sought to determine "the main function of the word "zero" . . . in the brand name Coca-Cola Zero." Dupont testimony at 6. The concern with the Dupont survey is that it is a survey more of meaning than source identification. The source identifying function of a trademark and the "main function" - as Dr. Dupont put it - of a word in that mark are not necessarily the same things. If, as Ambev argues, the term ZERO is merely descriptive, it would not be inconsistent for consumers to view the term ZERO as both describing a characteristic of COCA-COLA ZERO while still perceiving the term to be a source indicator. The "main function" premise of the survey and source identification are not mutually exclusive. Put another way, it is possible that a "main function" of ZERO in TCCC's marks is to identify a characteristic of applicant's goods, but consumers nevertheless may have come to recognize that applicant is the only entity that identifies the characteristic of its goods in that manner. It is not enough

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that consumers merely know that ZERO means "something" is missing from COCA-COLA ZERO. The survey needs to test whether consumers view ZERO in the marks as indicating a source of the goods.

TCCC's rebuttal survey was more on point. Rather than look for the "main function" of ZERO, the Simonson survey attempted to rebut the Dupont survey by determining whether ZERO in COCA-COLA ZERO served a trademark function. The Simonson survey examined acquired distinctiveness to see if ZERO was associated with one company or more than one company. Applicant's Br. at 26. Simonson found that 61% of respondents "perceive" that ZERO was associated with only one company as opposed to 6% for the term DIET. Simonson Test. pp. 56-57.

We find that the Simonson survey validates the significant sales and advertising numbers discussed above. Consumers have been exposed to TCCC's ZERO products and advertising on television, over the radio, via print media, and in every conceivable retail outlet. Billions of the products have been sold since 2004. Ambev's attempt to show that the ZERO marks have not acquired distinctiveness simply fails in light of the scope of TCCC's significant sales and marketing numbers.

Opposer also argues that applicant has not enjoyed exclusive use of ZERO on beverages due to third-party use of ZERO on a variety of beverages as well. Opposer's Br. at 27. As an initial matter, there is no requirement that TCCC's use be entirely exclusive. It need only be substantially exclusive.

Opposition Nos. 91178953 et al.

The substantially exclusive standard makes allowance for use by others that may be inconsequential or infringing, which does not necessarily invalidate the applicant's claim. *L.D. Kichler Co. v. Davoil, Inc.*, 52 USPQ2d 1307, 1309 (Fed. Cir. 1999).

Opposer's evidence does not establish substantial third party use of ZERO in connection with soft drinks and/or syrups. While several third parties may have made use of ZERO in connection with beverages and numerous third parties have used "zero-calorie," "zero-carbs," and other such highly descriptive zero-formative phrases, such use does not undercut TCCC's claim of acquired distinctiveness. We find that the cumulative effect of TCCC's use of ZERO in connection with its line of beverages is so extensive that it qualifies as "substantially exclusive" as required under Section 2(f). *Kichler* at 1309.

We conclude that applicant's use has been substantially exclusive and that the evidence of record is sufficient to support registration on the Principal Register under Section 2(f).

DECISION: The oppositions are dismissed with prejudice.

U.S. Trademark Trial and Appeal Board

BRIDGESTONE FIRESTONE NORTH AM. TIRE v. FEDERAL, 91168556 (TTAB 12-8-2009)

Bridgestone Firestone North American Tire, LLC and Bridgestone
Corporation v. Federal Corporation

Opposition No. 91168556 to application Serial No. 78495477

filed on October 6, 2004

United States Patent and Trademark Office

Trademark Trial and Appeal Board

Hearing: December 8, 2009

Mailed: February 24, 2010

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THIS OPINION IS NOT A PRECEDENT OF THE T.T.A.B.

Douglas A. Rettew and Danny M. Awdeh of Finnegan,
Henderson, Farabow, Garrett & Dunner, L.L.P. for
Bridgestone Firestone North American Tire, LLC and Bridgestone
Corporation.

Everett E. Fruehling of Christensen O'Connor Johnson Kindness
PLLC and W. David Shenk of Whyte Hirschboeck Dudek S.C. for
Federal Corporation.

Before Hairston, Holtzman and Bergsman, Administrative
Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Federal Corporation ("applicant") filed an intent-to-use
application for the mark MILANZA, shown below, for "tires," in
Class 12.

MILANZA

Bridgestone Firestone North American Tire, LLC and Bridgestone
Corporation ("opposers") opposed the registration of
applicant's mark on the ground of priority

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of use and likelihood of confusion under Section 2(d) of
the Trademark Act of 1946, **15 U.S.C. § 1052**(d).

Specifically, opposers alleged that they own the trademarks
POTENZA, TURANZA and ALENZA for tires, that their three
trademarks form an "NZA" suffix family of marks, and that
MILANZA for tires so resemble opposers' individual marks and
"NZA" suffix family of marks as to be likely to cause
confusion. Opposers pleaded ownership of the following
registrations:

1. Registration No. 1281463 for the mark POTENZA, in typed
drawing form, for "tires and tubes";**[fn1]** and

2. Registration No. 2842949 for the mark TURANZA, in typed
drawing form, for, *inter alia*, "tires."**[fn2]**

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

Evidentiary Issue

During its main testimony period, opposers introduced the testimony deposition of Hal Poret, Vice President of Guideline, a company that specializes in designing and conducting surveys to measure consumer perception. Mr. Poret, through Guideline, conducted a likelihood of confusion survey to determine whether the mark MILANZA for

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tires is likely to cause confusion with opposers' POTENZA and TURANZA marks.

Applicant introduced the testimony deposition of Harvey H. Sundel, Ph.D., applicant's expert witness regarding surveys to measure consumer perception. Dr. Sundel critiqued the survey conducted by Guideline. Dr. Sundel also opined as to how the survey should have been conducted.

During opposers' rebuttal testimony period, Guideline conducted a likelihood of confusion survey to determine whether the mark MILANZA for tires is likely to cause confusion with opposers' POTENZA and TURANZA marks in accordance with the suggestions offered by Dr. Sundel. Opposers introduced the results of the second survey through Mr. Poret's rebuttal testimony deposition.

Applicant objected to the second survey as improper rebuttal. Applicant's objection is overruled. Guideline's second survey and Mr. Poret's rebuttal testimony regarding that survey are proper rebuttal to the extent that they bear on the validity and probative value of the first survey. Thus, we have considered the second survey and Mr. Poret's rebuttal testimony deposition to that extent. We have not considered the second survey and the corresponding testimony for purposes of supporting opposers' case-in-chief on its claim of likelihood of confusion. *Helene Curtis Industries*

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Inc. v. Suave Shoe Corp., 13 USPQ2d 1618, 1625 n. 33 (TTAB 1989).

After opposers took Mr. Poret's rebuttal testimony deposition and introduced the second likelihood of confusion survey, applicant filed a motion to reopen its testimony period to take the deposition of its expert, Dr. Sundel. The Board denied applicant's motion to reopen its testimony period in an order dated March 4, 2009. In its brief, applicant again argued that it should have been allowed to take Dr. Sundel's testimony regarding opposers' second likelihood of confusion survey.

The Board's March 4, 2009 order was correct. Our rules of practice do not make any provision for rebuttal testimony by the defendant. *Osage Oil & Transportation Co. v. Standard Oil Co.*, 226 USPQ 905, 907 n. 10 (TTAB 1985). Therefore, it was incumbent upon applicant, being cognizant of our rules, to have anticipated that opposers would attempt to rehabilitate the purported deficiencies in its first survey, including, however unlikely, a second survey correcting the purported deficiencies.

The Record

By rule, the record includes applicant's application file and the pleadings. Trademark Rule 2.122(b), **37 CFR § 2.122**(b). In addition, the parties introduced the following testimony and evidence:

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A. Opposers' evidence.

1. Notice of reliance on copies of opposers' pleaded registrations prepared from the electronic database records of

the U.S. Patent and Trademark Office showing both the current status of and current title to the registrations. **[fn3]**

2. Stipulated testimony declaration of Dana Nicoletti, a litigation legal assistant for opposers' counsel, introducing excerpts from third-party websites.

3. Notice of reliance on applicant's responses to opposers' requests for admission Nos. 1-6, 10-15 and 41-42.

4. Notice of reliance on applicant's responses to opposers' interrogatory Nos. 7(a), (b), (e) and (f), 10 and 12.

5. Notice of reliance on printed publications pursuant to Trademark Rule 2.122(e).

6. Notice of reliance on a copy of an amended petition for cancellation filed by opposers in another proceeding purportedly to show that opposers police their marks.

7. Testimony deposition of Hal Poret with attached exhibits.

8. Rebuttal testimony deposition of Hal Poret with attached exhibits.

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9. Testimony deposition of Philip J. Pasci, opposers' Vice President of Consumer Marketing, with attached exhibits.

B. Applicant's evidence.

1. Notice of reliance on two third-party registrations for marks ending in "NZA." **[fn4]**

2. The stipulated testimony declaration of Anne Calico, litigation paralegal for applicant's counsel, introducing excerpts from third-party websites.

3. The testimony deposition of Yeh Chia-Che, applicant's Deputy Manager for Sales, with attached exhibits.

4. The testimony deposition of Dr. Harvey H. Sundel, Ph.D.

Standing

Because opposers have properly made their pleaded registrations of record, opposers have established their standing.

Cunningham v. Laser Golf Corp., **222 F.3d 943**,

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55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton*

Industries, Inc. v. Ralston Purina Co., **670 F.2d 1024**,

213 USPQ 185, 189 (CCPA 1982).

Priority

Because opposers' pleaded registrations for the marks POTENZA and TURANZA are of record, Section 2(d) priority is not an issue in this case as to the marks and the products covered by the registrations. *King Candy Co. v. Eunice King's Kitchen, Inc.*, **496 F.2d 1400**, 182 USPQ 108, 110 (CCPA 1974).

Although opposers did not allege ownership of Registration No. 3169216 for the mark ALENZA for "vehicle tires; inner tubes for vehicle tires; wheel rims for vehicles," opposers introduced a copy of the registration through the testimony of Philip Pasci. However, Mr. Pasci did not testify as to the current status of the registration. Because opposers did not allege ownership of the ALENZA registration and because Mr. Pasci did not testify as to the current status of the ALENZA registration, opposers may not rely on the registration for purposes of establishing

priority. With respect to priority of the ALENZA mark, Mr. Pasci testified that opposers began using the ALENZA trademark in March 2005.^[fn5] Because the filing

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date of the application at issue is October 10, 2004, applicant has priority vis-à-vis opposers' ALENZA trademark.

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).

A. Opposers did not establish a family of "NZA" marks.

Opposers contend that they have "rights in the family of - NZA suffix marks through substantial use and promotion of those distinctive marks together."^[fn6] Opposers assert that the "POTENZA, TURANZA, and ALENZA marks are prominently displayed together through the strategic placement of those marks and tires throughout 2,200 company-owned stores" (emphasis in the original),^[fn7] they appear together in promotional materials and in-store point-of-sale displays, and "on large signs covering the front entrance of stores."^[fn8] In addition, opposers have introduced advertisements that opposers contend show the marks used together, as well as

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noting news articles referencing the marks.^[fn9] In particular, opposers reference a November 1994 article in *Modern Tire Dealer* magazine quoting the following passage:

To create a stronger family image among its tires a manufacturer may use names that complement each other.

Bridgestone did this when it developed a touring line, changing "Potenza" to create "Turanza."

The Court of Appeals for the Federal Circuit has defined a family of trademarks as follows:

A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be a recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods. . . .

Recognition of the family is achieved when the pattern of usage of the common element is sufficient to be indicative of the origin of the family.

J & J Snack Foods Corp. v. McDonald's Corp., **932 F.2d 1460**, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991).

In order to create the requisite recognition of the common element of the marks or "family surname," the common

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element must be so extensively used and advertised that the

public recognizes the "family surname" as a trademark.
Reynolds & Reynolds Co. v. I.E. Systems, Inc.,
5 USPQ2d 1749, 1751 (TTAB 1987) (the marks must be used in a
manner calculated to impress upon the relevant public that the
marks indicate a single source).

In order to establish a "family of marks," it must be
demonstrated that the marks asserted to comprise its
"family" or a number of them have been used and
advertised in promotional material or used in everyday
sales activities in such a manner as to create common
exposure and thereafter recognition of common
ownership based upon a feature common to each mark.

American Standard Inc. v. Scott & Fetzer Co.,
200 USPQ 457, 461 (TTAB 1978).

Furthermore, to establish a family of marks, it must be shown
that prior to applicant's first use of its mark, the marks
containing the claimed family feature (i.e., the "NZA"
suffix) were used and promoted together by opposers in such a
manner as to create public recognition in the family feature.
Marion Laboratories v. Biochemical/Diagnostics,
6 USPQ2d 1215, 1218 (TTAB 1988). Because opposers must prove that
they established a family of marks prior to applicant's first
use its mark, and because applicant's effective first use date
of MILANZA precedes opposers' first use of ALENZA, we will not
consider any promotion or use of

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ALENZA in determining whether opposers have established a
family of marks.

In the absence of direct testimony by purchasers, we must place
ourselves in the position of average consumers and attempt to
understand their reaction to the marks as they are encountered
in the marketplace. *Id.* In this regard, the "family"
concept is bottomed on recognition of the common feature as the
distinguishing feature of each mark." *Id.*

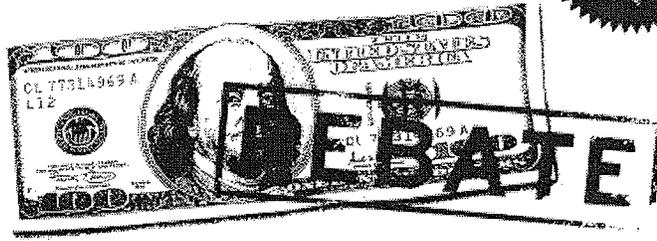
Based on the record before us, opposers have failed to
establish that the "NZA" suffix is recognized by the purchasing
public as exclusively identifying opposers in connection with
tires. Opposers' advertising emphasizes the BRIDGESTONE mark
and identifies sub-brands such as POTENZA, TURANZA, DUELER and
BLIZZAK. ^[fn10] In fact, the vast majority of
advertising by opposers feature the BRIDGESTONE mark in
connection with a specific sub-brand. By highlighting the
BRIDGESTONE mark and using POTENZA and TURANZA with DUELER
and/or BLIZZAK with the BRIDGESTONE mark, opposers do not draw
attention to the purported "NZA" family. Even the
advertisements referenced by opposers in their reply brief,

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shown below, do not emphasize or highlight the purported
"NZA" suffix or draw the consumer's attention to the "NZA"
suffix as indicating a single source.

BRIDGESTONE
need new tires?

ACT TODAY!
OFFER VALID
APRIL 6-MAY 6,
2006



**GET UP TO A
\$100 MAIL-IN REBATE*
ON A SET OF FOUR SELECT
BRIDGESTONE TIRES**

Purchased between April 6 and May 6, 2006!

\$100 Rebate	\$75 Rebate	\$50 Rebate	\$25 Rebate
<ul style="list-style-type: none"> Potenza® RE950A Pole Position* Potenza® PASSION Potenza® RE950-SPORT* Potenza® RE950AS Pole Position* Turanza® LS-2 Turanza® LS-V Dueler® HP Sport Dueler® HP 	<ul style="list-style-type: none"> Turanza® CLARUS V Dueler® H/L Silence Dueler® A/T Rev 	<ul style="list-style-type: none"> Potenza® RE750 Potenza® G059 Turanza® LS-H Turanza® LS-T Dueler® A/T 	<ul style="list-style-type: none"> Turanza® EL-050 H Turanza® EL-050 T Dueler® M/T Insignia® SE200

PASSION
for EXCELLENCE

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BRIDGESTONE

Choose from today's brands for your brand of driving

Get up to a \$100 rebate on a set of four select

Offer good from April 7 to May 7, 2006. Ask your participating Bridgestone retailer for complete details and eligible sites.

- BLISS®**
 - Potenza® RE950
 - Potenza® S-05 Pole Position*
 - Turanza® LS-2
 - Turanza® LS-V
 - Dueler® HP
- SAVO®**
 - Potenza® RE950
 - Dueler® H/L Silence
 - Dueler® A/T Rev
- ELITE®**
 - Potenza® RE750
 - Potenza® G059
 - Turanza® LS-H
 - Turanza® LS-T
 - Dueler® A/T
- ELITE™**
 - Turanza® EL-050 T
 - Insignia® SE200
 - Dueler® M/T
 - Dueler® HP

PASSION
for EXCELLENCE

The advertising by third-party retailers also emphasizes the BRIDGESTONE mark. The third-party advertising does not draw attention to the "NZA" suffix. Representative advertisements from the Nicoletti Declaration are shown below.

BRIDGESTONE Firestone

need new tires?
SPRING MAIL-IN REBATE PROMOTION

UP TO \$100 REBATE
Turanza™ LS-7
Turanza™ LS-V
Dueler™ H/P
Potenza™ RE960AS
Pole Position™

UP TO \$75 REBATE
Turanza™ EL-400V
Dueler™ H2L Alenza™
Dueler™ A/T Revco

UP TO \$50 REBATE
Potenza™ 0099
Turanza™ LS-H
Turanza™ LS-T
Dueler™ A/T

UP TO \$25 REBATE
Turanza™ EL400H
Dueler™ H/T
Insignia™ SE200
Turanza™ EL400T

We Service What We Sell

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BRIDGESTONE Firestone

buy safe
BONDED
INSPECTED & MONITORED

Part, Data, Tire, Center

POTENZA RE910 POTENZA S03 RE92 POTENZA RE918

FR490 TURANZA EL42 AFFINITY FIREHAWK GT402

The store signs and in-store displays do not draw attention to the "NZA" suffix. In the signs and displays, the TURANZA and POTENZA marks appear with other sub-brands, such as DUELER, FIREHAWK, and WILDERNESS.^[fn11] Because the marks are featured together, nothing draws attention to the "NZA" suffix and it does not stand out.

With the exception of the one article in the *Modern Tire Dealer* magazine referenced above, the news articles submitted by opposers do not support opposers' contention that it has a family of "NZA" marks. Most of the articles reference only one of the marks. Those articles that mention both the TURANZA and POTENZA marks do so in conjunction with the BRIDGESTONE mark and they do not emphasize the "NZA" suffix or show any recognition of that

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an "NZA" suffix points exclusively to opposers. The excerpt shown below is representative of the manner in which the articles reference opposers' marks.

UNI-T is already incorporated in the Bridgestone Potenza S-02 ultra-high performance tire (introduced in 1995), and some are incorporated into the new generation of Bridgestone Turanza touring tires which arrived in retail stores last month.^[fn12]

Opposers' internal marketing plans belie opposers' contention that they have a family of "NZA" marks. Opposers never referenced the "NZA" family of marks in any of its internal marketing bulletins.^[fn13] In opposers' promotional materials catalogue for dealers (e.g., consumer handouts, banners, posters, decals, patches, pennants, etc.), there are no products highlighting the "NZA" suffix.^[fn14] In fact, opposers articulated its intention to promote the BRIDGESTONE mark, not a family of "NZA" marks.

BRIDGESTONE

Bridgestone advertising goes BIG time in the U.S.

The new executions capitalize on the equity we've built with our spots featuring "The Wheel." Now we're taking the brand to an even higher level, continuing to promote the premium image of Bridgestone. We're targeting both current and new customers, creating awareness and demand for the Potenza,

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Turanza, Dueler and Blizzak families of products.**[fn15]**

In other words, opposers intended to build BRIDGESTONE brand recognition using sub-brands directed to different market segments.

We've tested our messages to our target customers and they have told us that; Potenza = performance, Turanza = wet and quiet, Dueler = SUV elegance and Blizzak = snow and ice.**[fn16]**

There is nothing in the record indicating that opposers' "target customers" recognize the "NZA" suffix as pointing exclusively to opposers.

Based on the record before us, opposers have failed to establish that they have advertised or promoted their TURANZA and POTENZA marks sufficiently to establish recognition or awareness in the public or the trade as to a family of marks identified by the "NZA" suffix. Accordingly, opposers' claim of likelihood of confusion must be based solely on whether MILANZA so resembles POTENZA or TURANZA as to be likely to cause confusion.**[fn17]**

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B. The similarity or dissimilarity and nature of the products described in the application and registration and likely-to-continue trade channels and classes of consumers.

Both parties use their marks to identify tires. Because the goods are identical, we must presume that they are sold in the same channels of trade and to the same classes of consumers.

C. The strength of opposers' marks.

Opposers contend that their POTENZA and TURANZA marks are both inherently strong and have marketplace strength, thus, entitling their marks to a broad scope of protection. With respect to the inherent strength of the marks, opposers assert that both marks are fanciful terms that have no meaning when applied to tires.**[fn18]**

With respect to the marketplace strength, opposers have been using the POTENZA mark since 1981 and the TURANZA mark since 1991.**[fn19]** Because opposers designated their sales and advertising figures as confidential, we may only refer to them in general terms. In that regard, opposers' sales and advertising figures are impressive under any standard. According to the January 30, 2008 issue of *Modern Tire Dealer* magazine, in 2007, opposers were "leader in U.S. and Canadian new-tire sales."**[fn20]** In 2007, opposers' POTENZA,

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TURANZA, DUELER H/P SPORT, and DUELER H/L ALENZA received the *Consumer's Digest* magazine "Best Buy Award."**[fn21]** The POTENZA and TURANZA tires are offered as original equipment on many new cars.**[fn22]**

Despite this evidence of renown, opposers' POTENZA and TURANZA marks are always used in tandem with BRIDGESTONE. Cf. *Bose Corp. v. QSC Audio Products Inc.*, **293 F.3d 1367**, 63 USPQ2d 1303, 1308 (Fed. Cir. 2002) (if product marks are used in tandem with a famous house mark, the party asserting that the product marks are famous should prove that the product marks "can properly be seen as independent of the famous house mark"). In the newspaper and magazine

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advertisements referenced in opposers' brief, POTENZA and TURANZA always appear with the BRIDGESTONE mark. **[fn23]** The BRIDGESTONE mark is also highly prominent in opposers' product placement efforts where POTENZA tires have been featured in third-party programs or commercials. **[fn24]** In this regard, the Sponsors Reports for the Champ Car World Series prepared by Joyce Julius and Associates, Inc. demonstrate that opposers' sponsorship of a Formula 1 World Championship series redounds to the benefit of the BRIDGESTONE mark with minimal benefit to the POTENZA mark. **[fn25]** Because the Sponsors Reports were designated as confidential, we may only refer to them in general terms. The report measures the television exposure of sponsorship brands and converts them into the equivalent of 30 second television commercials. **[fn26]** Suffice it to say that advertising value of POTENZA mark was less than 1.5% of the value to the BRIDGESTONE mark and Bridgestone B logo.

Opposers' point-of-sale materials, brochures, mailers and other print materials feature the BRIDGESTONE mark in conjunction with the POTENZA and TURANZA marks. **[fn27]**

Opposers contend that they have advertised their POTENZA tires on billboards at locations with significant

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exposure to the public and the media (e.g., in Times Square in New York City and at the Indianapolis Speedway). **[fn28]** However, these billboards also prominently feature the BRIDGESTONE trademark.

Opposers' television advertisements emphasize BRIDGESTONE. **[fn29]** There are two commercials: one for POTENZA and one for TURANZA. While POTENZA and TURANZA appear briefly on a tire in their respective commercials, the emphasis is unmistakably on BRIDGESTONE.

Finally, opposers assert that their "tremendous investment in developing, promoting, and marketing its POTENZA, TURANZA, and ALENZA tires, and the commercial success of those tires, has attracted significant unsolicited media attention." **[fn30]** While opposers' tires have been referenced in the media, the references are news reports involving industry news such as the introduction of new products, new sponsorships and the like. The news articles do not demonstrate that opposers' marks have achieved a high degree of recognition and renown. Furthermore, POTENZA and TURANZA are identified as BRIDGESTONE brands and are not referenced separate and apart from BRIDGESTONE.

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Unlike the use of the ACCOUSTIC WAVE and WAVE trademarks by Bose Corporation, 63 USPQ2d at 1308, opposers have not established that POTENZA and TURANZA have brand recognition separate and apart from BRIDGESTONE. There is simply nothing in the record to demonstrate that the marks POTENZA and TURANZA have achieved any significant recognition independent of the BRIDGESTONE mark. In view of the foregoing, we find that while opposers' POTENZA and TURANZA marks are inherently distinctive, any market strength that they have is tied to the BRIDGESTONE mark.

D. Evidence of actual confusion.

Survey evidence is circumstantial evidence of actual confusion. See *Blue Cross & Blue Shield Association v. Harvard Community Health Plan, Inc.*, 17 USPQ2d 1075, 1078 n. 7 (TTAB 1990); *McCarthy On Trademarks and Unfair Competition* § 32:184 (4th ed. 2010). Opposers submitted a likelihood of confusion survey taken by Guideline. Mr. Poret testified that the survey showed that there is a 29.9% level of confusion between the mark MILANZA and the marks POTENZA, TURANZA and DUELER. [\[fn31\]](#)

However, there is a problem with the survey format that affects its probative value. The relevant survey instructions are set forth below.

All respondents were first handed 3 blue cards, one displaying the name DUELER,

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one the name POTENZA, and one the name TURANZA. Respondents were informed that the names on the blue cards are 3 models of automobile tires made by the same tire company.

* * *

After the blue cards were put out of sight, respondents were handed a white card containing one of four other tire model names, either MILANZA, EAGLE, ZEON, or PILOT. Respondents were then asked whether or not they thought the tire model on the first white card is made by the same company as, or by a company that is connected or affiliated with, the tire company that makes the tire models listed on the blue cards. . . . The first white card was then taken back and respondents were given a second white card containing another of the above-mentioned tire model names. Respondents were identically questioned about the name on the second white card, and this process was repeated until respondents had been separately shown and questioned about each of the four tire model names, Milanza, Eagle, Zeon, and Pilot. [\[fn32\]](#)

As indicated previously, the record does not support the existence of an "NZA" suffix family of marks. There is no pattern of advertising, promotion or use that draws attention to the "NZA" suffix. However, in the survey, the respondents were shown TURANZA, POTENZA and DUELER and told that these marks were owned by one company and then asked whether the control marks and MILANZA were associated or affiliated with the owner of the first three marks. By

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telling the respondents that TURANZA, POTENZA and DUELER were owned by the same company, Guideline planted the seed that the "NZA" suffix was significant and, therefore, it influenced respondents by stating the marks were related and suggesting that one or more of the marks shown later might also be related. There was no basis to state that TURANZA, POTENZA and DUELER were related in the minds of the relevant consumers. In other words, the survey format led the respondents to the desired response that MILANZA was associated or affiliated with the company that owns the TURANZA, POTENZA and DUELER marks.

Opposers contend that Dr. Sundel, applicant's survey expert, approved the format of showing respondents both TURANZA and POTENZA because they reflect the existing marketing conditions.

Q. Now, could you - because in this case, you understand Bridgestone uses Potenza and Turanza. They often appear together in stores. Is it proper to show

people those two tires because those two tires are

-

A. Together?

Q. - shown and marketed together?

A. If that's how they're marketed together, then you'd probably keep them together.

Q. And get rid of Dueler?

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A. I would not have Dueler in there because it sets up a different situation, as I explained earlier.

Q. Sorry to interrupt. So on the blue cards, to fix this, Guideline should have gotten rid of Dueler and then just kept Potenza and Turanza?

A. Correct. **[fn33]**

Dr. Sundel's objection to showing DUELER to the respondents in conjunction with TURANZA and POTENZA is that it created a "comparative" bias toward Italian-sounding-names (i.e., MILANZA is closer to TURANZA and POTENZA than the controls are to DUELER). **[fn34]** Moreover, opposers' statement that POTENZA and TURANZA appear together is misleading. POTENZA and TURANZA appear together along with BRIDGESTONE, DUELER, FIRESTONE, BLIZZAK, AFFINITY and many other brand owned by opposers.

In view of the foregoing, we find that the opposers' likelihood of confusion survey has little probative value.

E. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont*

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De Nemours & Co., 177 USPQ at 567. 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.*, 9 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). In comparing the marks, we are mindful that 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 USPQ 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Since the goods at issue are tires, we are dealing average consumers.

We also note that where, as here, the goods are 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*

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Real Estate Corp. v. Century Life of America,
970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992);
*Schering-Plough HealthCare Products Inc. v. Ing-Jing
Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007); *Jansen
Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB
2007).

Applicant's mark MILANZA and opposers' marks POTENZA and TURANZA have obvious points of similarity: the marks end in "NZA" and they are Italian-sounding. On the other hand, the marks look different, sound different and they have different meanings and engender different commercial impressions.

With respect to appearance and sound, we find that the dominant portion of the marks is the first two syllables (*i.e.*, MILAN, POTEN, and TURAN) with the final syllable, the letters "ZA," providing an Italian accent. In considering the marks in their entireties, the final syllable is too insignificant to hold that the marks are similar.

With respect to the meaning and commercial impression of the marks, the marks are not similar. POTENZA is Italian for "power." It is used to identify a high performance tire and engenders the commercial impression of potency or power.^[fn35] TURANZA is used to identify a touring tire and, although a coined term, it engenders the commercial
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impression of touring.^[fn36] MILANZA engenders the commercial impression of something from Milan.

In view of the foregoing, we find that the marks are not similar in appearance, sound, meaning or commercial impression.

F. The conditions under which and buyers to whom sales are made, *i.e.* "impulse" vs. careful, sophisticated purchasing.

Just based on the products involved in this proceeding, one would expect that purchasers would exercise a high degree of care when making their purchasing decision. However, there was very little testimony and evidence proffered regarding this factor, and neither party referenced this factor in their briefs.

The following facts demonstrate that consumers exercise a high degree of care when purchasing tires. The products are relatively expensive. The price of opposers' tires may range from \$70 to \$400 per tire.^[fn37] The price of applicant's tire may range from \$70 to \$200 per tire.^[fn38] Individuals do not purchase tires frequently; tires tend to last several years.^[fn39] Clearly, the purchase of tires is not an impulse purchase because some degree of thought goes into it.

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On the other hand, the universe of potential consumers include everyone who owns an automobile, SUV, or truck, including consumers who do not exercise a high degree of care in making their tire purchasing decisions and those who make their decision based only on price. In this regard, Mr. Pasci testified that tire industry research shows that 45% of vehicle owners replace old tires with the same tire brand that is currently on their vehicle.^[fn40] Thus, potentially 45% of the consumers purchase replacement tires without regard to the brand.

To the extent a consumer cares about which tire he/she is buying, this factor weighs slightly in favor of opposer.

G. Balancing the factors.

Despite the identity of the goods, channels of trade and classes of consumers, we find that the differences between the marks warrant a finding that there is no likelihood of confusion. Simply put, we find that the dissimilarity of the marks simply outweighs the other relevant factors. *Kellogg Co. v. Pack'em Enterprises, Inc.*, 14 USPQ2d 1545, 1550 (TTAB 1990), *aff'd*, **951 F.2d 330**,

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21 USPQ2d 1142 (Fed. Cir. 1991). In reaching this conclusion, we have carefully considered all of the evidence pertaining to the relevant *du Pont* factors, as well as all of the parties' arguments with respect thereto (including any evidence and arguments not specifically discussed in this opinion).

Decision: The opposition is dismissed with prejudice.

[fn1] Issued June 12, 1984; renewed. In the registration, opposers state that "'Potenza' is an Italian word which may be translated as 'power' or 'potency' in English." Opposers also claimed ownership of registrations for POTENZA RE91 and POTENZA RE050A SCUDERIA. Because it is the similarity of applicant's MILANZA mark that is the gravamen of opposers' claim, we focus our attention on opposers' POTENZA mark.

[fn2] Issued May 18, 2004.

[fn3] See *Research In Motion Limited v. NBOR Corporation*, **92 USPQ2d 1926, 1928** (TTAB 2009).

[fn4] Applicant also included three applications. However, an application has "no probative value other than as evidence that the application was filed." *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1049 n. 4 (TTAB 2002). Also, the notice of reliance included only a list of registrations. Applicant did not include copies of the registrations. If applicant wanted to make third-party registrations of record, it must introduce copies of the registrations, not just a list, through a notice of reliance in accordance with Trademark Rule 2.122(e). *Andre Oliver Inc. v. Products Exchange Company, Inc.*, 1 USPQ2d 1817, 1818 (TTAB 1986); see also *In re Duofold, Inc.*, 184 USPQ 638, 640 (TTAB 1974). Nevertheless, because opposers did not object and, in fact treated the registrations as if they were properly made of record, we have considered this evidence on its merits.

[fn5] *Pasci Dep.*, p. 22.

[fn6] Opposers' Brief, p. 31.

[fn7] Opposers' Reply Brief, p. 13.

[fn8] Opposers' Reply Brief, p. 14.

[fn9] Opposers' Reply Brief, p. 15.

[fn10] See for example *Pasci Dep.*, Exhibit 116. Mr. Pasci identified BIDGESTONE and FIRESTONE as opposers' primary brands. POTENZA, TURANZA, and DUELER are sub-brands within the

BRIDGESTONE brand. (Pasci Dep., p. 6). ALENZA is a sub-brand of the DUELER sub-brand. The name of the tire is the DUELER H/L ALENZA. (Pasci Dep., pp. 17 and 216). "The Alenza mark in print or on the tire never appears by itself." (Pasci Dep., p. 217).

[fn11] Pasci Dep., Exhibit 75.

[fn12] Opposers' Notice of Reliance No. 4, Exhibit 73.

[fn13] Pasci Dep., Exhibits 79-89.

[fn14] Pasci Dep., Exhibit 74.

[fn15] Pasci Dep., Exhibit 83.

[fn16] Pasci Dep., Exhibit 85.

[fn17] As indicated in the discussion regarding priority, applicant has priority vis-à-vis opposers' ALENZA trademark. Accordingly, we focus the remainder of the likelihood of confusion analysis on the POTENZA and TURANZA trademarks.

[fn18] Opposers' Brief, p. 35.

[fn19] Pasci Dep., pp. 19 and 21.

[fn20] Pasci Dep., p. 208, Exhibit 130. This evidence of market share is ambiguous. First, opposers comprise two primary brands:

BRIDGESTONE and FIRESTONE. Second, the BRIDGESTONE brand is comprised of at least the following sub-brands: POTENZA, TURANZA, DUELER and BLIZZAK. It is not clear what percentage of market share the BRIDGESTONE brand and the POTENZA and TURANZA sub-brands comprise.

[fn21] Pasci Dep., p. 70.

[fn22] Pasci Dep., p. 31. This fact is ambiguous in analyzing the meaning of the sales figures. First, it is common knowledge that other tire manufacturers provide their tires as original equipment on new cars. Thus, selling tires as original equipment to vehicle manufacturers is standard practice in the tire industry. Second, it is not clear whether opposers' brands are offered as an option to a new car purchase or as a default selection. Finally, 45% of the consumers will replace the tires on their vehicle with the same tire brand currently on the vehicle. (Pasci Dep., p. 32). While some of the consumers may be aware of the tire model or sub-brand on their vehicle, others may request BRIDGESTONE or they may simply request the same, *albeit* unknown, brand that is currently on their vehicle. Accordingly, some percentage of replacement tire customers purchase opposers' tires without regard to the brand, thus, reducing the probative value of opposers' sales to some unknown extent.

[fn23] Pasci Dep., Exhibits 17-42.

[fn24] Pasci Dep., Exhibits 15, 16, and 131.

[fn25] Pasci Dep., Exhibits 110 and 111.

[fn26] Pasci Dep., p. 171.

[fn27] Pasci Dep., Exhibits, 61, 72, and 75.

[fn28] Pasci Dep., pp. 148-149, Exhibits 98 and 99.

[fn29] Pasci Dep., Exhibits 13 and 14

[fn30] Opposers' Brief, p. 17.

[fn31] Poret Testimony Dep., p. 48 and Exhibit 1, p. 5.

[fn32] Poret Dep., Exhibit 1, pp. 3-4.

[fn33] Sundel Testimony Dep., pp. 131-132.

[fn34] Sundel Testimony Dep., pp. 33-37 and Exhibit 2,
p. 5.

[fn35] Pasci Dep., p. 16.

[fn36] Pasci Dep., p. 16. The Italian word for "touring" is
"turismo." Cassell's Italian Dictionary, p. 1028
(1977).

[fn37] Pasci Dep., p. 17.

[fn38] Chia-Che Dep., p. 134.

[fn39] In selecting the universe of respondent's for opposers' likelihood of confusion survey, Mr. Poret testified that potential candidates purchased tires within the past two years or intended to purchase tires within the next two years because he wanted the universe to reflect the life cycle of the product. "Tires are not a product that people are buying every week or month, or even every year, they're a product that people replace every several years." (Poret Testimony Dep., p. 26). Dr. Sundel approved of Mr. Poret's criteria for selecting the universe of respondents.

[fn40] Pasci Dep., p. 32.

