

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

In the matter of Trademark Reg. No. 2,595,712
Trademark: X TRAC
Issued: July 16, 2002

TTAB

-----X	:	
MICHELIN NORTH AMERICA, INC.	:	
	:	
Petitioner,	:	
	:	
v.	:	Canc. No. 92,042,951
	:	
CARLISLE INTANGIBLE COMPANY	:	
	:	
	:	
Registrant.	:	
-----X	:	

ATTN: BOX TTAB-^{NO}FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

FIRST AMENDED PETITION TO CANCEL

MICHELIN NORTH AMERICA, a corporation organized and existing under the laws of the State of New York with its principal place of business at One Parkway South, Greenville, South Carolina, 92615 ("Michelin" or "Petitioner"), believes that it will be damaged by registration of X TRAC, Reg. No. 2,595,712 which issued on July 16, 2002 to Carlisle Intangible Company ("Carlisle").

As grounds for this opposition, Michelin alleges as follows:

1. Michelin's primary business is the manufacture and distribution of tires throughout the world, including the United States. Michelin and its predecessors in interest, since at least as early as 1950, have continuously used the trademark "X", either alone or in



Likelihood of Confusion

8. On information and belief, Carlisle's X TRAC mark so resembles Michelin's mark X as to be likely, when applied to Carlisle's tires, wheels, and tire and wheel assemblies to cause consumer confusion, mistake and deception as to the source of origin of Carlisle's goods and/or deceive consumers into the mistaken belief that Carlisle's goods are connected or affiliated with Petitioner's under 15 U.S.C. § 1052(d) and causing damage to Michelin within the meaning of 15 U.S.C. §1063.

9. On information and belief, Carlisle's X TRAC, when applied to Carlisle's tires, wheels, and tire and wheel assemblies so resembles Michelin's mark X as to constitute a false designation of origin whereby the consuming public is likely to believe that (i) Carlisle's goods are approved or sponsored by Michelin; (ii) Michelin's business is connected or affiliated with Carlisle; (iii) Carlisle's mark is a version of Michelin's mark X, and/or (iv) the respective products and services are related, thereby deceiving the public pursuant to 15 U.S.C. § 1052(d) and 15 U.S.C. § 1125(a) causing damage to Michelin within the meaning of 15 U.S.C. §1063.

DILUTION

10. On information and belief, the continued use and registration of X TRAC has lessened the capacity of Michelin's famous and distinctive mark X to distinguish and identify Michelin's goods and services from those of others, thereby diluting the distinctive quality of its X Mark in violation of 15 U.S.C. § 1125(c). Accordingly, Carlisle's alleged mark is not entitled to registration pursuant to Section 2 of the Trademark Amendments Act of 1999.

11. In addition, on information and belief, the continued use and registration of X TRAC dilutes the strength of Michelin's mark X to act as a unique indicator of the source of Michelin's products in that (i) it would enable Carlisle to take advantage of the fame and

goodwill which have been associated with Michelin's mark X; (ii) it would enable others to pass off Carlisle's goods as those of Michelin's; and (iii) it would take the reputation and goodwill associated with Michelin's mark X out of Michelin's control and make it subject to the quality standards of Carlisle, therefore causing damage to Michelin within the meaning of 15 U.S.C. §1063.

The Family of X Marks

12. Michelin also owns numerous registrations for "X in combination with other letters, numbers or words. Such registrations include, but are not limited to, the following:

<u>Mark</u>	<u>Registration No.</u>
X	558,774
X-STRADDLE	2,753,892
X-HAUL	2,765,039
X MINE	2,571,183
X SNOPLUS	2,587,914
X ONE	2,100,165
BIB'X	1,113,100
GREEN X	1,958,324
XSE	1,892,642
XZE	2,080,198
XZX	1,095,907
XZY	1,143,280
XAS	1,036,181
XCX/APT	2,160,977
XD2	2,181,396
XD4	2,343,109
XDA	1,144,919
XDA2	2,020,970
XDE	2,355,807
XDHT	1,780,172
XDL	1,778,861
XDN	2,385,170
XDS	2,494,340
XDU	2,385,194
XDY	1,777,801
X G C	2,655,753

<u>Mark</u>	<u>Registration No.</u>
XGT	1,510,879
XGT V	1,512,604
XH	1,431,032
XLM H/T	1,280,661
XM+S4	2,385,195
XML	2,332,720
XPS RIB	1,544,329
XPS TRACTION	1,573,211
XRV	2,079,201
XSE	1,892,642
XT-1	2,382,754
XTA	1,778,862
XTE2	2,341,346
XW4	1,545,298
XZ2	2,173,845
XZA2	2,022,072
XZE	2,080,198
XZT	1,810,664
XZU	2,379,121
XZU4	1,780,171
LTX	1,841,295
MICHELIN LX1	1,543,438
MUD KING XT	1,836,695
MXT	1,584,546
MXV4	1,896,116
MXX	1,786,678
TIGER PAW XTM	1,602,128
TRX	1,099,430

The above registrations are valid and subsisting and except for registration Nos. 2,343,109; 2,355,807; 2,385,194, 2,385,195; 2,332,720; 2,173,845; 2,385,170; 2,494,340; 2,382,754; 2,753,892; 2,765,039; 2,571,183; 2,655,753, 2,341,346, 2,587,914 and 2,379,121 are incontestable.

13. The foregoing marks have been registered, used, and extensively advertised and promoted together by Michelin such that the purchasing public recognizes that the common characteristic X is indicative of the common origin of Michelin's goods. Thus, the

foregoing marks constitute a family of marks based on the letter "X" and are identified by the public exclusively with Michelin and its high quality tires and related goods and services.

14. As a result of Michelin's and its predecessors' extensive sales, advertising, and promotion of its family of X marks, Michelin has built a well-known and valuable reputation as well as extensive goodwill, in and to its family of X marks.

15. Michelin's first use of its family of X marks was long prior to the date of first use, May 15, 2000, alleged in Registration No. 2,595,712.

16. On information and belief, Carlisle's X TRAC so resembles Michelin's family of X marks as to be likely, when applied to Carlisle's tires, wheels, and tire and wheel assemblies, to constitute a false representation under 15 U.S.C. §1125(a) that (i) Carlisle's goods are approved or sponsored by Michelin; (ii) Carlisle's business is connected or affiliated with Michelin; (iii) X TRAC is another member of Michelin's family of X Marks; or (iv) the respective products are related, thereby deceiving the public, all causing damage to Michelin within the meaning of 15 U.S.C. §1063.

17. On information and belief, the use and registration of X TRAC is likely to cause consumer confusion, mistake and deception under 15 U.S.C. §1052(d) and is therefore causing damage to Michelin within the meaning of 15 U.S.C. §1063.

18. Additionally, on information and belief, the registration of X TRAC has lessened the capacity of Michelin's famous and distinctive family of X marks to distinguish and identify Michelin's goods and services from those of others, thereby diluting the distinctive quality of its famous and distinctive family of X marks in violation of 15 U.S.C. § 1125(c). Accordingly, Carlisle's alleged mark is not entitled to registration pursuant to Section 2 of the Trademark Amendments Act of 1999.

19. In addition, on information and belief, the continued registration of X TRAC dilutes the strength of Michelin's family of X marks to act as a unique indicator of source of Michelin's products in that (a) it would enable Carlisle to take advantage of the fame and goodwill which have been associated with Michelin's family of X marks; (b) it would enable others to pass off Carlisle's goods as those of Michelin's; and (c) it would take the reputation and goodwill associated with Michelin's family of X marks out of Michelin's control and make it subject to the quality standards of Carlisle, thereby causing damage to Michelin within the meaning of 15 U.S.C. §1063.

20. In view of the foregoing, Michelin would be, and already has been, damaged by the continued registration of Registrant's alleged mark within the meaning of 15 U.S.C. §1063.

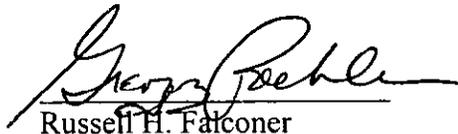
WHEREFORE, Michelin prays that Reg. No. 2,595,712 be cancelled.

Respectfully submitted,

BAKER BOTTS L.L.P.

Dated: July 7, 2004

By:

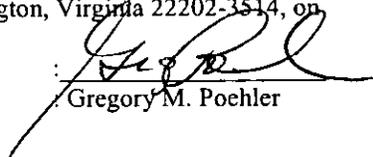


Russell H. Falconer
Gregory M. Poehler
30 Rockefeller Plaza
New York, NY 10112
Attorneys for Petitioner
(212) 408-2666

CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited with the United States Postal Service as "Express Mail Post Office to Addressee Service" in an envelope addressed to: BOX TTAB FEE Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514, on

Date of Deposit : 7-7-04 Signature Name



Gregory M. Poehler