

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

Hearing: December 8, 2009

Mailed: February 24, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

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

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

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";¹ and
2. Registration No. 2842949 for the mark TURANZA, in typed drawing form, for, *inter alia*, "tires."²

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

¹ 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.

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*

² Issued May 18, 2004.

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:

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.³

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.

³ See *Research In Motion Limited v. NBOR Corporation*, 92 USPQ2d 1926, 1928 (TTAB 2009).

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."⁴

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,

⁴ 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.

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 2005.⁵ Because the filing

⁵ Pasci Dep., p. 22.

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."⁶ 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),⁷ they appear together in promotional materials and in-store point-of-sale displays, and "on large signs covering the front entrance of stores."⁸ In addition, opposers have introduced advertisements that opposers contend show the marks used together, as well as

⁶ Opposers' Brief, p. 31.

⁷ Opposers' Reply Brief, p. 13.

⁸ Opposers' Reply Brief, p. 14.

noting news articles referencing the marks.⁹ 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

⁹ Opposers' Reply Brief, p. 15.

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

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.¹⁰ 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,

¹⁰ See for example Pasci Dep., Exhibit 116. Mr. Pasci identified BRIDGESTONE 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).

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

REBATE

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

Purchased between April 6 and May 6, 2006!

Best Buy

\$100 Rebate	\$75 Rebate	\$50 Rebate	\$25 Rebate
Potenza [®] RE050A Pole Position [™] Potenza [®] RE050A Potenza [®] RE050 RFT [™] Potenza [®] RE960AS Pole Position [™] Turanza [®] LS-Z Turanza [®] LS-V Dueler [®] H/P Sport Dueler [®] H/P	Turanza [®] EL400 V Dueler [®] H/L Alenza Dueler [®] A/T Revo	Potenza [®] RE750 Dueler [®] G009 Dueler [®] LS-H Dueler [®] LS-T Dueler [®] A/T	Turanza [®] EL400 H Turanza [®] EL400 T Dueler [®] H/T Insignia [®] SE200

**PASSION
for EXCELLENCE**

*Offer valid only at participating Bridgestone dealers and subject to Bridgestone's rules and regulations. See your local retailer. See original registration coupon and original order of purchase. See your participating Bridgestone dealer for complete details and applicable laws.

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, 2005.
Ask your participating Bridgestone retailer
for complete details and eligible tires.

Save \$25

- Potenza® RE050
- Turanza® S-03 Pole Position™
- Turanza® LS-Z
- Turanza® LS-V
- Dueler® H/P

Save \$25

- Potenza® RE950
- Dueler® H/L Alenza
- Dueler® A/T Revo

Save \$25

- Potenza® RE750
- Potenza® G009
- Turanza® LS-H
- Turanza® LS-T
- Dueler® A/T

Save \$25

- Turanza® EL400 T
- Insignia® SE200
- Dueler® H/T
- Dueler® H/T

MSRP MSRP MSRP

MSRP MSRP MSRP

MSRP MSRP MSRP

*MSRP. Actual dealer price may vary. ©2005 Bridgestone North America, Inc. All rights reserved.

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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



We Service What We Sell

UP TO \$100 REBATE

- Turanza™ LS-Z
- Turanza™ LS-V
- Dueler™ H/P
- Potenza™ RE960AS
- Pole Position™

UP TO \$75 REBATE

- Turanza™ EL-400V
- Dueler™ H/L Alenza™
- Dueler™ A/T Revo

UP TO \$50 REBATE

- Potenza™ G009
- Turanza™ LS-H
- Turanza™ LS-T
- Dueler™ A/T

UP TO \$25 REBATE

- Turanza™ EL400H
- Dueler™ H/T
- Insignia™ SE200
- Turanza™ EL400T



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.¹¹ 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

¹¹ Pasci Dep., Exhibit 75.

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.¹²

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.¹³ 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.¹⁴ 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,

¹² Opposers' Notice of Reliance No. 4, Exhibit 73.

¹³ Pasci Dep., Exhibits 79-89.

¹⁴ Pasci Dep., Exhibit 74.

Turanza, Dueler and Blizzak families of products.¹⁵

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.¹⁶

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.¹⁷

¹⁵ Pasci Dep., Exhibit 83.

¹⁶ Pasci Dep., Exhibit 85.

¹⁷ 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.

- 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.¹⁸

With respect to the marketplace strength, opposers have been using the POTENZA mark since 1981 and the TURANZA mark since 1991.¹⁹ 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."²⁰ In 2007, opposers' POTENZA,

¹⁸ Opposers' Brief, p. 35.

¹⁹ Pasci Dep., pp. 19 and 21.

²⁰ Pasci Dep., p. 208, Exhibit 130. This evidence of market share is ambiguous. First, opposers comprise two primary brands:

TURANZA, DUELER H/P SPORT, and DUELER H/L ALENZA received the *Consumer's Digest* magazine "Best Buy Award."²¹ The POTENZA and TURANZA tires are offered as original equipment on many new cars.²²

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

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.

²¹ Pasci Dep., p. 70.

²² 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.

advertisements referenced in opposers' brief, POTENZA and TURANZA always appear with the BRIDGESTONE mark.²³ The BRIDGESTONE mark is also highly prominent in opposers' product placement efforts where POTENZA tires have been featured in third-party programs or commercials.²⁴ 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.²⁵ 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.²⁶ 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.²⁷

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

²³ Pasci Dep., Exhibits 17-42.

²⁴ Pasci Dep., Exhibits 15, 16, and 131.

²⁵ Pasci Dep., Exhibits 110 and 111.

²⁶ Pasci Dep., p. 171.

²⁷ Pasci Dep., Exhibits, 61, 72, and 75.

exposure to the public and the media (e.g., in Times Square in New York City and at the Indianapolis Speedway).²⁸

However, these billboards also prominently feature the BRIDGESTONE trademark.

Opposers' television advertisements emphasize BRIDGESTONE.²⁹ 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."³⁰ 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.

²⁸ Pasci Dep., pp. 148-149, Exhibits 98 and 99.

²⁹ Pasci Dep., Exhibits 13 and 14

³⁰ Opposers' Brief, p. 17.

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.³¹

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,

³¹ Poret Testimony Dep., p. 48 and Exhibit 1, p. 5.

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.³²

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

³² Poret Dep., Exhibit 1, pp. 3-4.

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?

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.³³

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).³⁴ 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 entirety 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 entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont*

³³ Sundel Testimony Dep., pp. 131-132.

³⁴ Sundel Testimony Dep., pp. 33-37 and Exhibit 2, p. 5.

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*

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.³⁵ TURANZA is used to identify a touring tire and, although a coined term, it engenders the commercial

³⁵ Pasci Dep., p. 16.

impression of touring.³⁶ 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.³⁷ The price of applicant's tire may range from \$70 to \$200 per tire.³⁸ Individuals do not purchase tires frequently; tires tend to last several years.³⁹ Clearly, the purchase of tires is not an impulse purchase because some degree of thought goes into it.

³⁶ Pasci Dep., p. 16. The Italian word for "touring" is "turismo." Cassell's Italian Dictionary, p. 1028 (1977).

³⁷ Pasci Dep., p. 17.

³⁸ Chia-Che Dep., p. 134.

³⁹ 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

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.⁴⁰ 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,

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.

⁴⁰ Pasci Dep., p. 32.

21 USPQ2d 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.