

ESTTA Tracking number: **ESTTA1022368**

Filing date: **12/13/2019**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Cummins Engine IP, Inc.
Granted to Date of previous extension	12/15/2019
Address	1400 73RD AVE. NE MINNEAPOLIS, MN 55432 UNITED STATES

Attorney information	KRISTINE M. YOUNG MAYER BROWN LLP P.O. BOX 2828 CHICAGO, IL 60690-2828 UNITED STATES kyoung@mayerbrown.com, ipdocket@mayerbrown.com, mmthomas@mayerbrown.com 3127018162
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Applicant Information

Application No	88314446	Publication date	06/18/2019
Opposition Filing Date	12/13/2019	Opposition Period Ends	12/15/2019
Applicant	Toyo Tire Corporation 2-2-13 FUJINOKI ITAMI-SHI HYOGO, 664-0847 JAPAN		

Goods/Services Affected by Opposition

Class 012. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: light truck tires, specifically excluding all terrain vehicle and bicycle tires
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	800956	Application Date	04/14/1965
Registration Date	12/28/1965	Foreign Priority Date	NONE

Word Mark	RECON
Design Mark	
Description of Mark	NONE
Goods/Services	Class 007. First use: First Use: 1963/10/07 First Use In Commerce: 1963/10/07 REBUILT PARTS FOR INTERNAL COMBUSTION ENGINES

Attachments	Notice of Opposition - RECON GRAPPLER.pdf(3296803 bytes)
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Signature	/Kristine M. Young/
Name	KRISTINE M. YOUNG
Date	12/13/2019

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

In the matter of Serial No. 88/314,446
Filed: February 29, 2019
For the mark: RECON GRAPPLER
Published in the Official Gazette: June 18, 2019

CUMMINS ENGINE IP, INC.,)	
)	
Opposer,)	
)	
v.)	Opposition No.: Pending
)	
TOYO TIRE CORP.,)	
)	
Applicant.)	

NOTICE OF OPPOSITION

Opposer, Cummins Engine IP, Inc. (“Opposer” or “Cummins”), believes that it is being, and will be, damaged by registration of the mark RECON GRAPPLER (Serial No. 88/314,446) for use in connection with “*light truck tires, specifically excluding all terrain vehicle and bicycle tires*” in International Class 012 (the “Toyo Tire Application”). The mark applied for in the Toyo Tire Application is identical, in part, to Cummins’ RECON mark. Accordingly, Cummins hereby opposes Serial No. 88/314,446 pursuant to Section 13(a) of the Trademark Act of 1946, as amended (the Lanham Act), 15 U.S.C. § 1063(a).

Cummins and Its Rights in the RECON Mark

1. Cummins is a corporation organized under the laws of the State of Delaware, with its principal place of business located at 500 Jackson Street, Columbus, Indiana 47202.
2. Cummins was founded nearly a century ago and is a global power leader with complementary business units that design, manufacture, distribute and service engines and related technologies, including fuel systems, controls, air handling, filtration, emission solutions and

electrical power generation systems. In this regard, since as early as 1963, Cummins has extensively used and promoted its RECON mark in U.S. commerce in connection with engines and components thereof; electronic control modules sold as an integrated component of engines; and computer software for performing electronic calibration, engineering, programming and tuning of engines, integrated as a component in an electronic control module. As a result of this extensive use, advertising and promotion, Cummins' RECON mark has become well known as a distinctive indicator of the origin of Cummins' goods and services and has become a valuable symbol of Cummins' goodwill. Some examples of Cummins' use of the RECON mark within the past 20 years are attached as Exhibit A. Additional information regarding Cummins' current use of the RECON mark can be found at <<https://www.cummins.com/parts/recon>> and <<https://quickserve.cummins.com/info/qsol/products/summary.html>>.

3. Cummins owns an incontestable federal trademark registration for the RECON mark on the Principal Register that covers "*rebuilt parts for internal combustion engines*" in Class 07, Registration Number 800,956. A copy of the registration and a screen shot of the USPTO database showing assignment of this registration from Cummins Engine Company, Inc. to Cummins Engine IP, Inc. are attached as Exhibit B and Exhibit C.

Applicant and Its RECON GRAPPLER Application

4. On information and belief, applicant Toyo Tire Corporation ("Applicant") is a Japanese corporation with an address at 2-2-13 Fujinoki Itami-Shi, Hyogo, Japan 664-0847.

5. On February 15, 2019, Applicant filed U.S. Application No. 88/314,446 for the mark RECON GRAPPLER under Section 1(b), claiming "*light truck tires, specifically excluding all terrain vehicle and bicycle tires*" in International Class 012 (hereinafter, the "Toyo Tire Mark").

6. The Toyo Tire Mark is identical, in part, to Cummins' RECON mark in appearance, sound and commercial impression.

7. Also, the Toyo Tire Application covers the following goods in International Class 012, which are at least similar and/or related to the electronic control modules, computer software, engines and the like that Cummins offers under its RECON mark: "*light truck tires, specifically excluding all terrain vehicle and bicycle tires.*"

Likelihood of Confusion with Cummins' Prior Existing Registration and Common Law Rights in Its RECON Mark
(Section 2(d), 15 U.S.C. § 1052(d))

8. Cummins repeats and re-alleges each and every allegation set forth in Paragraphs 1-7.

9. Cummins' rights in its RECON Mark date back to at least as early as 1963. On the other hand, the Toyo Tire Application was filed on February 25, 2019, on an intent-to-use basis, and, on information and belief, Applicant has not yet commenced use of the mark. Therefore, Cummins has priority based on its senior use of the RECON mark for over 55 years.

10. Consumers of Cummins' RECON-branded products and related services include, but are not limited to, distributors, dealers, individual consumers, repair shops, and others who own, operate, repair and/or replace engines for vehicles and other machinery. Indeed, Cummins distributes its RECON products throughout the United States through its nationwide distributor network, which consists of over 150 distributor branches.

11. Cummins' RECON-branded products have a wide variety of applications, including, but not limited to, use in vehicles and generators, as well as for many other industrial, construction, marine, logging and agricultural purposes. (See Exhibit D.)

12. Over the past 50 years, Cummins has invested millions in the development and promotion of its RECON-branded goods and related services. Since 1996, Cummins has generated over \$12.25 billion in revenues as a result of its sale of RECON-branded products worldwide. Based on Cummins' widespread and continuous use of its RECON mark in U.S. commerce, Cummins' RECON mark clearly and unmistakably indicates to consumers that Cummins is the one and only source of such goods and related services. Accordingly, Cummins owns strong nationwide common law trademark rights in its RECON mark, and Cummins has not abandoned these common law rights.

13. Cummins also owns incontestable federally registered rights in the RECON mark, and these rights are valid and subsisting. (*See Exhibit B*).

14. On information and belief, Applicant adopted the applied-for RECON mark over five decades after Cummins began using its RECON mark in the United States, and Applicant has modeled its trademark filings after the branding strategy established by Cummins for its RECON mark.

15. The Toyo Tire Application is for a mark, RECON GRAPPLER, that is at least partially identical to Cummins' RECON mark in appearance, sound and commercial impression. Indeed, the marks are, in part, spelled and pronounced exactly the same—both including the distinctive term RECON—and neither mark includes a design element. Accordingly, consumers will mistakenly believe that goods and services offered in connection with the applied-for mark in the Toyo Tire Application originate from and/or are endorsed and/or sponsored by Cummins.

16. The highly similar nature of the parties' respective marks is particularly pronounced given that the goods claimed in the Toyo Tire Application—light truck tires—are highly similar and/or related to the goods and services offered by Cummins in connection with its RECON mark.

Indeed, on information and belief, Toyo Tire has an extensive business dedicated to vehicles that is the same and/or similar to Cummins' business, which is dedicated, in part, to the manufacture, promotion and sale of engines for vehicles and other related parts for vehicles, and the channels of trade and consumers of the parties' respective goods and services are overlapping. (*See, e.g., Exhibits D and E*).

17. The goods and services that Cummins offers in connection with its RECON mark are computer software for performing electronic calibration of engines, engineering, programming and tuning of engines, engines for land vehicles and electronic control modules sold as an integrated component of engines and marine engines and related electronic control modules. Cummins offers its products in connection with the RECON mark to distributors, dealers, individual consumers, repair shops, original equipment manufacturers, and others who own and/or operate and/or repair or replace engines and who generally work with vehicles and heavy machinery. Similarly, on information and belief, Applicant intends to offer or offers its light truck tires to companies and/or individuals who own and/or operate and/or repair or replace various machine components and parts for vehicles (*i.e.*, commercial trucks). Accordingly, the parties' goods and services, as well as the relevant consumers and channels of trade, are highly similar.

18. Applicant's junior application for and/or intended use and/or use of a partially identical trademark for use in connection with highly similar goods duplicates Cummins' RECON mark and will inevitably lead consumers to mistakenly believe that Cummins is the source of Applicant's goods and that Applicant is affiliated with, endorsed by, or sponsored by Cummins, all in violation of Cummins' rights in its RECON mark.

19. Applicant's intended use of a nearly identical mark in connection with light truck tires is highly similar to Cummins' longstanding use of the mark RECON for use in connection

with computer software, electrical components of vehicle engines and vehicle engines for marine and land vehicles.

20. For the foregoing reasons, Cummins believes and alleges that it is being, and will be, damaged by the registration of the Toyo Tire Application.

21. WHEREFORE, Cummins respectfully requests that judgment in the present opposition be entered in favor of Cummins and against Applicant and that Application Serial No. 88/314,446 be refused registration pursuant to 15 U.S.C. § 1052(d).

Cummins hereby gives notice under Rule 2.122(d) of the Trademark Rules of Practice that, at hearing and in any appeal on this opposition proceeding, it will rely on its Registration Number 800,956 as evidence in support of this Notice of Opposition. A true and correct printout of the registration certificate for Cummins' Registration Number 800,956 from the United States Patent and Trademark Office's TSDR database is attached hereto as Exhibit B.

Respectfully submitted,

CUMMINS ENGINE IP, INC.

Dated: December 13, 2019

By: /Kristine M. Young/
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William M. Siegel
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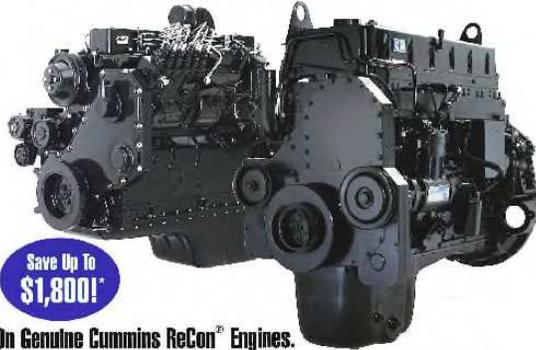
CERTIFICATE OF SERVICE

I hereby certify that, on December 13, 2019, this Notice of Opposition was sent via email to Applicant's attorney of record at the addresses below:

Carla Calcagno
Calcagno Law PLLC
2101 L Street NW, Suite 800
Washington, DC 20037
Email: carla.calcagno@calcagnolaw.com; cccalcagno@gmail.com; docketing@1027tm.com

By: /Madelaine M. Thomas/
Attorney for Opposer, Cummins Engine IP, Inc.

BUILT TO LAST.



Save Up To
\$1,800!*

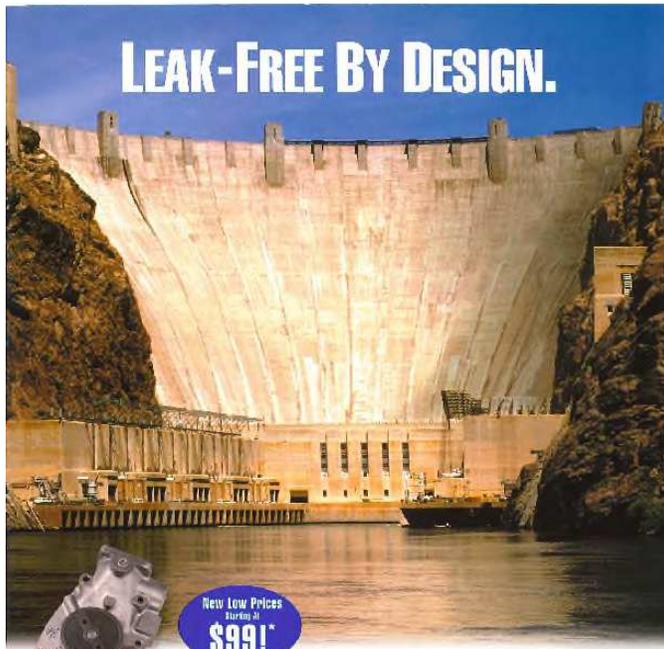
On Genuine Cummins ReCon® Engines.

We've reduced prices on many Cummins ReCon engines, from the 4B to the N14, with savings of up to \$1,800.* You can't beat the long-lasting value of our ReCon engines – especially at these nice, low prices. Cummins ReCon engines are completely remanufactured to factory specs, fully warranted and backed by the world's largest parts and service network. They're built to last – but these prices won't. See your participating Cummins dealer or distributor,** visit www.cummins.com or call 1-800-ESE-3 (1-800-343-7357) today. And be sure to ask about our K19 ReCon engine, available now.



ReCon

*Savings available on select engines. See dealer for details. **Participating Cummins dealers and distributors only. ©2002 Cummins Inc. All rights reserved. Cummins is a registered trademark of Cummins Inc.



LEAK-FREE BY DESIGN.



New Low Prices
Starting At
\$99!*

Get A Genuine Cummins ReCon® Water Pump For Under \$100!

It doesn't pay to gamble when you're replacing a water pump. Not when you can get a premium quality Cummins ReCon water pump – with a superior seal design – for as low as \$99* (including a free coolant test too)! It's our best price ever on the best remanufactured water pump in the business, backed by the best warranty in the industry – a full 2 years or 200,000 miles (321,869 km)! 

*MSRP. Dealer price may vary. ©2002 Cummins Inc. All rights reserved. Cummins is a registered trademark of Cummins Inc.

ReCon



ReCon

EVERY ROAD.



**CUMMINS RECON™
HEAVY DUTY AUTOMOTIVE ENGINES**

Exhibit B

United States Patent Office

800,956
Registered Dec. 28, 1965

PRINCIPAL REGISTER Trademark

Ser. No. 216,486, filed Apr. 14, 1965

RECON

Cummins Engine Company, Inc. (Indiana corporation)
1000 5th St.
Columbus, Ind.

For: REBUILT PARTS FOR INTERNAL COM-
BUSTION ENGINES, in CLASS 23.
First use Oct. 7, 1963; in commerce Oct. 7, 1963.

W. J. PARKER, *Examiner.*

Exhibit C

[Assignments on the Web](#) > [Trademark Query](#)

Trademark Assignment Abstract of Title

Total Assignments: 1

Serial #: [72216486](#)

Filing Dt: 04/14/1965

Reg #: [800956](#)

Reg. Dt: 12/28/1965

Registrant: CUMMINS ENGINE COMPANY, INC.

Mark: RECON

Assignment: 1

Reel/Frame: [2569/0881](#)

Recorded: 10/31/2002

Pages: 4

Conveyance: ASSIGNS THE ENTIRE INTEREST

Assignor: [CUMMINS ENGINE COMPANY, INC.](#)

Exec Dt: 10/01/2000

Entity Type: CORPORATION

Citizenship: INDIANA

Entity Type: CORPORATION

Citizenship: DELAWARE

Assignee: [CUMMINS ENGINE IP, INC.](#)

1400 73RD AVE NE

MINNEAPOLIS, MINNESOTA 55432

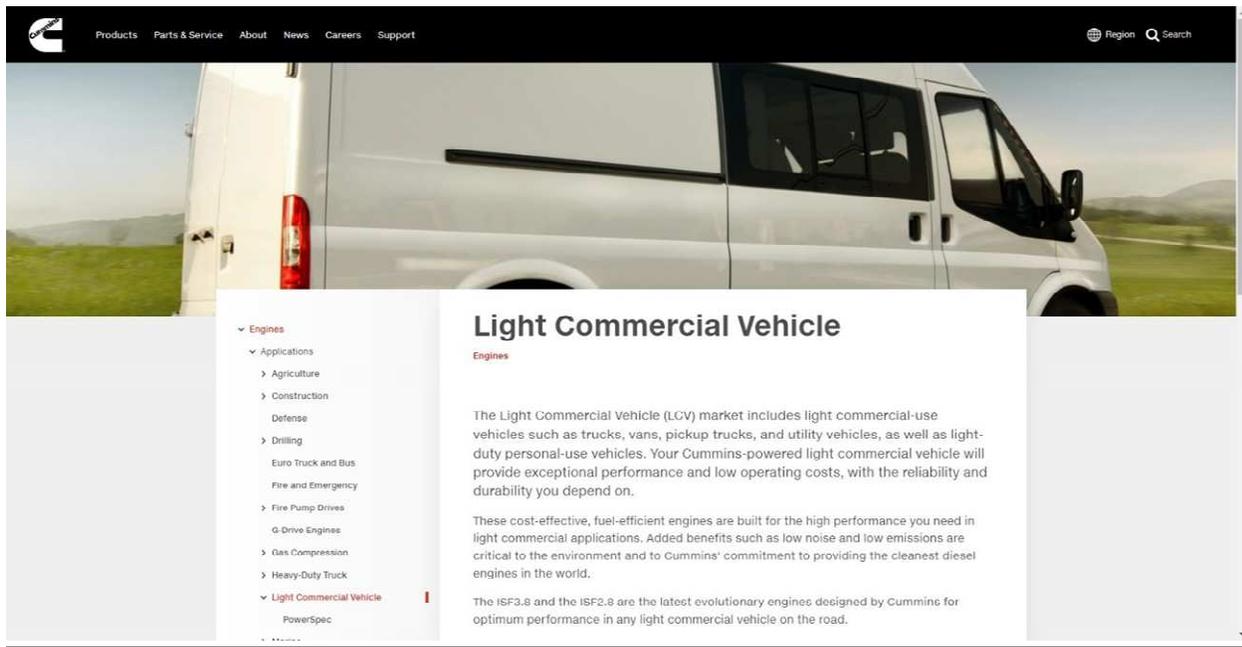
Correspondent: SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH PA

CHARLES E. STEFFEY

PO BOX 2938

MINNEAPOLIS, MN 55402-0938

Exhibit D



Source: Cummins' website - <https://www.cummins.com/engines/light-commercial-vehicle>
Accessed: November 26, 2019



Factory Remanufactured vs Uncertified Rebuilds & Repairs

Climbing steep grades with an 18-wheeler? Navigating the world's waters in a Cummins powered boat? Moving a mountain with a bulldozer? Or making sure children arrive to school on time? Cummins ReCon engines handle the job with power to spare. Cummins offers factory remanufactured Short Blocks, Long Blocks and engines for Cummins Heavy-duty L10, M, N and ISX/QSX engine platforms as well as MidRange B, C and ISL/QSL engine platforms.

In fact, more fleets and owner/operators are switching from major overhauls to Cummins ReCon engine options than ever before and with good reason. With a ReCon engine, you're not going to have any surprises and you'll quickly be back to work.

	Cummins ReCon Engines	vs. Uncertified Rebuilds & Repairs
<p> Every Minute Counts</p>	<ul style="list-style-type: none"> • Engine swaps require less downtime than other major repair events • Lower risk of having to come back in for additional repairs 	<ul style="list-style-type: none"> • Takes longer to order and install parts than engine swapping • Potential for installation errors can lead to future repair needs • Hidden surprises can create additional delays
<p> Lower Total Cost of Ownership</p>	<ul style="list-style-type: none"> • More uptime produces more opportunity for earning • No hassle core exchange • Savings through improved fuel economy 	<ul style="list-style-type: none"> • May cost less initially but can cost more in the long run • Requires more labor hours and potential for additional repair cost • Will have your equipment down for a

Source: Cummins' website - <https://www.cummins.com/parts/recon>
Accessed: November 26, 2019

Exhibit E

The screenshot shows the Toyo Tires website interface. At the top, the 'TOYOTIRES' logo is on the left, and navigation links for 'FIND TIRES' and 'WHERE TO BUY' are in the center. On the right, there are links for 'Español', a search icon, and a menu icon. Below the navigation is a large banner image of three commercial vans in a parking lot. Overlaid on the banner is the text 'COMMERCIAL VAN' in large white letters, with 'LONG WEARING TIRES FOR CARGO AND PASSENGER DELIVERIES' in smaller white letters below it. Underneath the banner is a search bar with the text 'Find Your Tires' and several filter buttons: 'VEHICLE', 'SIZE', 'RIM', and 'Where to Buy'. The 'Where to Buy' button is active and contains a text input field for 'ZIP CODE OR CITY & STATE' and a 'GO' button. Below the search bar is a dark grey horizontal bar with the text 'H-LINE / LONG WEARING COMMERCIAL GRADE DURABILITY'. The main content area features a large image of a Toyo H08+ commercial van tire on the left. To the right of the tire, the text reads 'H08+' in bold, followed by 'COMMERCIAL VAN ALL-SEASON TIRE' and a small icon with the text 'ALL-SEASON'. Below this is a short paragraph: 'The Toyo H08+ is built for the rigorous demands placed on modern commercial vans.' At the bottom of this section is a blue button with the text 'VIEW DETAILS >'. The entire screenshot is framed by a thin grey border.

Source: Toyo Tires' website - <https://www.toyotires.com/tire/vehicle/commercial-van>
Accessed: November 26, 2019



THE LEADING VALUE ALTERNATIVE TIRES

Toyo commercial tires combine top tier product performance, application versatility, and a competitive acquisition point for a lower cost per mile, making it a leading value alternative brand. Peace of mind and maximum profitability - standard with every purchase.

[Learn more >](#)



Source: Toyo Tires' website - <https://www.toyotires.com/commercial-truck-tires>
Accessed: November 26, 2019