

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: March 13, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Volvo Truck Corporation
v.
Mac Tíre Clothing LLC
—

Opposition No. 91264810
—

Leigh Ann Lindquist of Sughrue Mion, PLLC,
for Volvo Truck Corporation.

Xavier Hailey of Hailey Law PLLC,
for Mac Tíre Clothing LLC.

—
Before Bergsman, Wolfson, and Allard,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Mac Tíre Clothing PLLC (“Applicant”) seeks registration on the Principal Register
of the mark MAC TÍRE CLOTHING (in standard characters) for

Hats; Baseball caps and hats; Stocking caps; Stocking hats;
Shirts; Shirts and short-sleeved shirts; t-shirts; Short-
sleeved or long-sleeved t-shirts; Sweatshirts; Hooded

sweatshirts; Coats; Pants; Shorts, in International Class 25.¹

Applicant disclaims the exclusive right to use the word “Clothing” and claims the English translation of “Mac Tíre” is “Wolf.”

Volvo Truck Corporation (“Opposer”) filed a Notice of Opposition against the registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Opposer claims ownership, inter alia, of the registered marks listed below:

- MACK (typed drawing form) for, inter alia, “Trucks, Truck-Tractors,” in International Class 12;²

- MACK TRUCKS and design, reproduced below, for “shirts and hats,” in International Class 25;³ and



- MACK (in standard characters) for “Sweaters including fleece pullovers, polo shirts, T-shirts, shirts including dress shirts, caps including knit caps and fleece caps, sport jackets, sweatshirts, pants, namely, jogging pants, coats, neckwear; outerwear,

¹ Application Serial No. 88751005 was filed on January 8, 2020, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant’s assertion of a bona fide intention to use the mark in commerce.

² Registration No. 1146847 registered February 10, 1981; third renewal.

³ Registration No. 1258633 registered November 22, 1983; second renewal.

namely, leather jackets; jeanswear, namely, jeans, work coveralls of denim, jean jackets, jean shirts,” in International Class 25.⁴

In addition, Opposer opposes the registration of Applicant’s mark on the ground that the application is void ab initio because Applicant did not have a bona fide intention to use the mark as of the filing date of the application.

Applicant, in its Amended Answer, denies the salient allegations of the Notice of Opposition.⁵

⁴ Registration No. 3308148 registered October 9, 2007; renewed. During the prosecution of the underlying application, the Trademark Examining Attorney refused to register the mark MACK under Section 2(e)(4) of the Trademark Act, 15 U.S.C. § 1052(e)(4), on the ground that MACK is a primarily merely a surname. September 20, 2004 Office Action. Opposer, in its March 17, 2005 Response to an Office Action, amended the application to seek registration under the provisions of Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).

⁵ Applicant also asserts purported affirmative defenses. Applicant’s “affirmative defenses” designated as paragraph Nos. 18-23 of the Amended Answer are not affirmative defenses but rather amplifications of Applicant’s denials of the allegations contained in the Amended Notice of Opposition.

Because Applicant’s affirmative defense in paragraph No. 24 consists of a bald assertion that Opposer’s claims are barred by laches, Applicant has failed to assert a factual foundation for the laches defenses. *See Ashcroft v. Iqbal*, 556 U.S. 662, 663 (2009); *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007) (elements of each claim should include enough detail to give fair notice of claim). Moreover, equitable defenses such as laches are generally not available in opposition proceedings because these defenses start to run from the time the mark is published for opposition. *See Nat’l Cable Television Ass’n v. Am. Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991); *Barbara’s Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1292 n.14 (TTAB 2007) (defenses of laches, acquiescence or estoppel generally not available in opposition proceeding). In view thereof, we strike the laches affirmative defense.

In its last affirmative defense (paragraph No. 25), “Applicant reserves the right to assert any and all other affirmative defenses of which Applicant become aware during the pendency of this matter.” “Applicant’s attempt to reserve the right to add defenses is improper under the Federal Rules of Civil Procedure, because that would not give ... [Opposer] fair notice of such defenses.” *Philanthropist.com, Inc. v. Gen. Conf. Corp. of Seventh-Day Adventists*, 2021 USPQ2d 643, at *4 n.6 (TTAB 2021); *see also FDIC v. Mahajan*, 923 F.Supp. 2d 1133, 1141 (N.D. Ill. 2013) (“[A]ffirmative defenses that purport to reserve the right to add affirmative defenses at a later date ... are stricken because they are improper reservations under the Federal Rules.”).

When we cite to the record, we refer to TTABVUE, the Board's docketing system by docket entry and page number (e.g., 18 TTABVUE 34).

I. Preliminary Issue

Before proceeding to the merits of Opposer's claims, we address a preliminary matter. Opposer originally opposed the registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground of likelihood of confusion.⁶ Opposer pleaded that its MACK trademark for vehicles is famous.⁷ On June 4, 2021, Opposer filed a motion to amend its Notice of Opposition to add the claim that Applicant's application is void ab initio because Applicant did not have a bona fide intent to use its mark as of the filing date of its application.⁸ Again, Opposer alleged that its MACK mark for vehicles is famous.⁹ The Board granted Opposer's motion in an order dated October 13, 2021.¹⁰

Opposer, in its brief, for the first time states that "given the fame of the MACK mark, the MAC TIRE CLOTHING [mark] dilutes the strength and distinctive nature of the MACK mark."¹¹ Applicant, in its brief, notes that Opposer, in its brief, raised the unpleaded issue of dilution and objects.¹² Opposer, in its reply brief, continues to

⁶ 1 TTABVUE.

⁷ Notice of Opposition ¶ 4 (1 TTABVUE 6).

⁸ 6 TTABVUE.

⁹ Amended Notice of Opposition ¶ 4 (6 TTABVUE 9).

¹⁰ 16 TTABVUE.

¹¹ Opposer's Brief, p. 1 (55 TTABVUE 9). *See also* Opposer's Brief, pp. 34-36 (55 TTABVUE 42-44).

¹² Applicant's Brief, p. 3 (56 TTABVUE 9). *See also* Applicant's Brief, p. 40 (55 TTABVUE 46).

assert that Applicant's mark dilutes Opposer's mark and fails to address Applicant's objection.¹³

When issues not raised by the pleadings are tried by the express or implied consent of the parties, the Board will treat them in all respects as if they had been raised in the pleadings. *See Conolty v. Conolty O'Connor NYC LLC*, 111 USPQ2d 1302, 1306 (TTAB 2014) (nonownership claim tried by implied consent under Fed. R. Civ. P. 15(b)(2)); *Morgan Creek Prods. Inc. v. Foria Int'l Inc.*, 91 USPQ2d 1134, 1138 (TTAB 2009).

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. *Noble House Home Furnishings, LLC v. Floorco Enters., LLC*, 118 USPQ2d 1413, 1414-15 (TTAB 2016) (motion to amend petition after close of trial denied where defendant did not know or agree that the newly asserted claim was being tried, and where plaintiff unduly delayed in moving to amend); *Productos Lacteos Tocumbo S.A. de C.V. v. Paeteria La Michoacana Inc.*, 98 USPQ2d 1921, 1924-27 (TTAB 2011) (1. petitioner's rights in unpleaded marks tried by implied consent, and Board deemed pleadings to be amended to conform to the evidence, where plaintiff stated the relevance of the submissions under notices of reliance, emphasized its intention to rely on such marks through testimony, and where respondent did not object to the testimony at the time, was afforded an opportunity to cross-examine, and raised an

¹³ Opposer's Reply Brief, pp. 1 and 11-12 (57 TTABVUE 6 and 16-17).

untimely objection; and 2. unpleaded tacking and prior registration defense were not tried by implied consent where petitioner was not fully apprised of respondent's reliance on use and registration of another mark), *aff'd*, 188 F. Supp. 3d 22 (D.D.C. 2016), *aff'd*, 743 F. App'x. 457, 128 USPQ2d 1172 (D.C. Cir. 2018); *Morgan Creek Prods.*, 91 USPQ2d at 1138-39; *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1629 (TTAB 1998) (applicant did not object to testimony but was not fairly apprised that evidence, which also related to existing claim, was being offered in support of unpleaded claim). Fairness dictates whether an issue has been tried by consent – there must be an absence of doubt that the nonmoving party is aware that the issue is being tried. *Safer Inc. v. OMS Inv. Inc.*, 94 USPQ2d 1031, 1034-35 (TTAB 2010) (applicant was not aware opposer intended to rely on registration to prove likelihood of confusion until opposer filed rebuttal notice of reliance); *Morgan Creek Prods.*, 91 USPQ2d at 1139.

There is nothing in the record to find Applicant was aware Opposer was introducing evidence of fame to support a dilution claim. Applicant lodged its objection to Opposer's dilution claim in Applicant's brief after Opposer raised the dilution for the first time in its brief. We sustain Applicant's objection to Opposer's dilution claim and give the dilution claim no consideration.

II. The Record

The record includes the pleadings, and under Trademark Rule 2.122(b), 37 C.F.R.

§ 2.122(b), the file of Applicant's application.¹⁴ In addition, Opposer's pleaded registrations are of record because Opposer attached to its Notice of Opposition copies of those registrations printed from the USPTO Trademark Status and Document Retrieval (TSDR) system showing their current status and title.¹⁵ Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1).

The parties introduced the testimony and evidence listed below:

A. Opposer's testimony and evidence

1. Notice of reliance on Applicant's response to Opposer's interrogatory Nos. 8-13;¹⁶
2. Notice of reliance on copies of third-party registrations purportedly to show that third parties have adopted and registered trademarks for vehicles in International Class 12 and clothing in International Class 25;¹⁷
3. Notice of reliance on Internet materials purportedly to show the estimated number of people in the United States who speak Irish Gaelic;¹⁸
4. Notice of reliance on Internet materials from newspapers and magazines purportedly displaying advertisements for Opposer's goods;¹⁹

¹⁴ Therefore, it was not necessary for Applicant to introduce a copy of the March 28, 2020 Examiner's Amendment in the application being opposed. 37 TTABVUE 29-31.

¹⁵ Therefore, it was not necessary for Opposer to introduce its pleaded registrations through a notice of reliance. 23 TTABVUE.

¹⁶ 24 TTABVUE.

¹⁷ 25 TTABVUE.

¹⁸ 26 TTABVUE.

¹⁹ 27 TTABVUE.

5. Notice of reliance on Internet materials for newspaper and magazine articles purportedly referring to Opposer and its goods or services;²⁰
6. Notice of reliance on Internet materials purportedly from Amazon Disney Car Store, Bruder's online store, and the Department of Sanitation for New York City to show Opposer's relationships with third parties;²¹
7. Two notices of reliance on Internet materials purportedly posted on Opposer's YouTube channel;²²
8. Notice of reliance on Internet materials purportedly to show third party references to Opposer's MACK TRUCKS;²³ and
9. Testimony declaration of Cam Creech, Licensing and Merchandising Manager for Mack Trucks, Inc.²⁴

B. Applicant's testimony and evidence²⁵

²⁰ 28 TTABVUE.

²¹ 29 TTABVUE.

²² 30 and 31 TTABVUE.

²³ 32 TTABVUE.

²⁴ 33, 35, and 36 TTABVUE (public); 34 TTABVUE (confidential).

²⁵ Applicant attempted to introduce through a notice of reliance a copy of an email from the Trademark Examining Attorney to Applicant's attorney. 37 TTABVUE 26-267. However, an email is not the type of document that may be introduced through a notice of reliance. Accordingly, we give the email no consideration unless it is part of the prosecution history that is already be part of the record.

Applicant also attempted to introduce through a notice of reliance a copy of the September 20, 2003 Office Action in application Serial No. 78376865, the underlying application for Opposer's pleaded Registration No. 3308148. 37 TTABVUE 36-43. However, a copy of an Office Action from an application that is not at issue in the opposition proceeding is not the type of document that be introduced through a notice of reliance, nor was the Office Action made part of the record by virtue of Opposer having introduced the registration certificate for this pleaded registration. Accordingly, we give the Office Action no consideration.

Finally, Applicant attempted to introduce "Selected Printouts from Kantar Brandz BRANDZ TOP 100 MOST VALUABLE US BRANDS 2020" (41 TTABVUE 46-49) and "Selected Printouts from Kantar Brandz's 2021 MOST VALUABLE GLOBAL BRANDS" (41 TTABVUE 51-56). Because these documents do not display a URL and because Applicant did not provide a URL, they are not Internet documents. Also, they are not self-authenticating.

1. Notice of reliance on OXFORD ADVANCED LEARNER'S DICTIONARY definition of the term "Mack";²⁶
2. Notice of reliance on an excerpt from the BiteSize Irish Blog (bitesize.irish/blog) regarding how to say wolf in Irish Gaelic;²⁷
3. Notice of reliance on the Wiktionary.org definition of "mac tire";²⁸
4. Notice of reliance on an excerpt from the Census.gov website regarding residents of the U.S. with Irish ancestry;²⁹
5. Notice of reliance on an article regarding diacritical marks posted on Merriam-Webster.com;³⁰
6. Notice of reliance on an excerpt from the Mack Trucks website (macktrucks.com);³¹
7. Notice of reliance on a list of search results for a Google search for "mac tire";³²
8. Notice of reliance on a screenshot of the Google Image search for "mac tire";³³

Accordingly, these documents are not the type of document that may be introduced through a notice of reliance and we do not give them any consideration.

²⁶ 37 TTABVUE 6. The definition is based on British English.

²⁷ 37 TTABVUE 9-11.

²⁸ 37 TTABVUE 15-16.

²⁹ 37 TTABVUE 18-24.

³⁰ 37 TTABVUE 33-34.

³¹ 37 TTABVUE 45.

³² 37 TTABVUE 47-48 and 54-55. A list of Internet search results generally has little probative value, because such a list does not show the context in which the term is used on the listed web pages. *In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1715 (TTAB 2011); *see In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007) (deeming Google® search results that provided very little context of the use of ASPIRINA to be "of little value in assessing the consumer public perception of the ASPIRINA mark"); *In re Tea & Sympathy, Inc.*, 88 USPQ2d 1062, 1064 n.3 (TTAB 2008) (finding truncated Google® search results entitled to little probative weight without additional evidence of how the searched term is used).

³³ 37 TTABVUE 51-52 and 57-63.

9. Notice of reliance on an excerpt from the Mac Tire Pros website (mactirepros.com);³⁴
10. Notice of reliance on an excerpt from the Mac's Tire Pros website (macsservicecenter.com);³⁵
11. Notice of reliance on an excerpt from the Mac's Tire Center website (macstire.com);³⁶
12. Notice of reliance on an excerpt from the Mac's Tire Service website (macstireservice.com);³⁷
13. Notice of reliance on an excerpt from the MAC Tire Facebook page (Facebook.com/MacTireInc);³⁸
14. Notice of reliance on an excerpt from the Big Mac's Tire Store website (bigmactirestore.com);³⁹
15. Notice of reliance on an excerpt from the Mar Mac Tire Co. website (marmactire.com);⁴⁰
16. Notice of reliance on an excerpt from the Mac Tools website (mactools.com);⁴¹
17. Notice of reliance on the MERRIAM-WEBSTER DICTIONARY (merrriam-webster.com) definition of "clothing";⁴²
18. Notice of reliance on THE RANDOM HOUSE UNABRIDGED DICTIONARY (2022) (dictionary.com) definition of "Mack";⁴³

³⁴ 37 TTABVUE 65-69.

³⁵ 37 TTABVUE 71-80.

³⁶ 37 TTABVUE 85-86.

³⁷ 37 TTABVUE 88-92.

³⁸ 37 TTABVUE 94-99.

³⁹ 37 TTABVUE 101-102.

⁴⁰ 37 TTABVUE 104-105.

⁴¹ 37 TTABVUE 107-113.

⁴² 37 TTABVUE 115-116.

⁴³ 37 TTABVUE 118-122.

19. Notice of reliance on the summary list of a USPTO Trademark Electronic Search System (TESS) search for “Mack”;⁴⁴
20. Notice of reliance on the summary list of a USPTO TESS search for “Mack” in International Class 25;⁴⁵
21. Notice of reliance on excerpts from third-party websites offering the sale of clothing under “Mack” and “Mac” formative marks;⁴⁶
22. Notice of reliance on copies of third party “Mack” or “Mac” formative marks registered in International Class 25;⁴⁷
23. Notice of reliance on Internet websites regarding the most followed companies;⁴⁸
24. Notice of reliance on Internet documents purportedly relevant to show Applicant’s bona fide intent to use its mark;⁴⁹
25. Notice of reliance on Applicant’s certificate of good standing from the Office of the Minnesota Secretary of State;⁵⁰ and

⁴⁴ 38 TTABVUE 6-10. Mere listings of registrations, without copies or electronic printouts of the registrations, are not sufficient to make the registrations of record. That is, a trademark search report is not credible evidence of the existence of the registrations listed in the report. *See Weyerhauser Co. v. Katz*, 24 USPQ2d 1230, 1231-32 (TTAB 1992); *Nat’l Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212, 1215 n.3 (TTAB 1990); *Kellogg Co. v. Pack’Em Enters. Inc.*, 14 USPQ2d 1545, 1549 (TTAB 1990), *aff’d*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). To be sure, third-party registrations may be made of record with a notice of reliance filed during the offering party’s testimony period, but the notice must be accompanied by legible, soft copies of the registrations themselves, *see Kellogg*, 14 USPQ2d at 1549 (citing *In re Hub Distributing, Inc.*, 218 USPQ 284, 285 (TTAB 1983)), or the electronic equivalent thereof. *Weyerhauser*, 24 USPQ2d at 1232. However, because Opposer did not object, we will consider the list for whatever probative value it may have.

⁴⁵ 38 TTABVUE 12. *See* note 44.

⁴⁶ 38 TTABVUE 15-159.

⁴⁷ 39 and 40 TTABVUE.

⁴⁸ 41 TTABVUE 6-44.

⁴⁹ 42 TTABVUE.

⁵⁰ 43 TTABVUE.

26. Testimony declaration of Michael C. Flynn, Applicant's owner and Manager.⁵¹

C. Opposer's rebuttal testimony and evidence

1. Notice of reliance on Applicant's responses to Opposer's request for production of documents Nos. 2-8 and 12;⁵²
2. Notice of reliance on excerpts from the Factory45.co website;⁵³
3. Notice of reliance on Applicant's pretrial disclosures;⁵⁴
4. Notice of reliance on TTABVUE records for applications Opposer has opposed and registrations Opposer has sought to cancel;⁵⁵
5. Notice of reliance on Internet documents purportedly to prove that Opposer's MACK mark has been used in the Radiator Springs attraction and Disneyland;⁵⁶
6. Notice of reliance on Internet documents purportedly to show the fame of Opposer's MACK mark;⁵⁷ and

⁵¹ 44 TTABVUE (public); 45 TTABVUE (confidential). Applicant improperly over-designated the Flynn exhibits as confidential. For example, Applicant designated as confidential a "manufacturing kit containing a basic checklist for starting a clothing line," the receipt for that kit, draft logos, receipts for the draft logos, and a sample hat. Pursuant to Trademark Rule 2.116(g), 37 C.F.R. § 2.116(g), "[t]he Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party." Accordingly, we treat only commercially sensitive and trade secret information as confidential.

⁵² 46 TTABVUE. Applicant's responses to requests for production of documents are admissible only to prove that no documents exist. *See McGowen Precision Barrels, LLC v. Proof Research, Inc.*, 2021 USPQ2d 559, at *5 n.6 (TTAB 2021) (written responses to requests for production of documents introduced through a notice of reliance are admissible solely for the purpose of showing that a party has stated that there are no responsive documents); *City National Bank v. OPGI Mgm't GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1674 n.10 (TTAB 2013) (same); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036 n.7 (TTAB 2012) (same).

⁵³ 47 TTABVUE.

⁵⁴ 48 TTABVUE.

⁵⁵ 51 TTABVUE.

⁵⁶ 52 TTABVUE.

⁵⁷ 53 TTABVUE.

7. Rebuttal testimony declaration of Cam Creech.⁵⁸

III. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action, formerly referred to as “standing” by the Federal Circuit and the Board, is an element of the plaintiff’s case in every inter partes case. *See Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 2671 (2021); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 (Fed. Cir. 2020), *cert. denied*, 142 S. Ct. 82 (2021); *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). To establish entitlement to a statutory cause of action, a plaintiff must demonstrate: (i) an interest falling within the zone of interests protected by the statute and (ii) a reasonable belief in damage proximately caused by the registration of the mark. *Meenaxi Enter., Inc. v. Coca-Cola Co.*, 38 F.4th 1067, 2022 USPQ2d 602, at *2 (Fed. Cir. 2022) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 129, 132 (2014)); *Corcamore*, 2020 USPQ2d 11277, at *4. *See also Empresa Cubana*, 111 USPQ2d at 1062; *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (TTAB 1982); *Spanishtown Enters.*, 2020 USPQ2d 11388, at *1 (TTAB 2020).

Opposer’s use and registration of its MACK marks establish that it is entitled to oppose the registration of Applicant’s mark.⁵⁹ *Cunningham v. Laser Golf Corp.*,

⁵⁸ 50 TTABVUE (public); 49 TTABVUE (confidential).

⁵⁹ Creech Testimony Decl. ¶¶ 4-6 and Exhibit N (33 TTABVUE 3).

222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (pleaded registrations “suffice to establish ... direct commercial interest”; a belief in likely damage can be shown by establishing a direct commercial interest); *New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *6 (TTAB 2020) (pleaded registrations establish statutory entitlement to bring opposition); *Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1118 (TTAB 2009) (testimony that plaintiff uses its mark “is sufficient to support [plaintiff’s] allegations of a reasonable belief that it would be damaged”).

IV. Priority

These same pleaded registrations, which Applicant has not counterclaimed to cancel, establish that priority is not an issue as to the marks and the goods covered by the registrations. *See Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1469 (TTAB 2016) (citing *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d. 1400, 182 USPQ 108, 110 (CCPA 1974)).

V. Likelihood of Confusion

Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), prohibits the registration of a mark that:

[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

We base our determination under Section 2(d) on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion.

In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, referred to as “*DuPont* factors”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). “Whether a likelihood of confusion exists between an applicant’s mark and a previously registered mark is determined on a case-by-case basis, aided by application of the thirteen *DuPont* factors.” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1689 (Fed. Cir. 2018). “In discharging this duty, the thirteen *DuPont* factors ‘must be considered’ ‘when [they] are of record.’” *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997) and *DuPont*, 177 USPQ at 567). “Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances. Any single factor may control a particular case.” *Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, at *3 (Fed. Cir. 2020) (citing *Dixie Rests.*, 41 USPQ2d at 1533).

“Each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973). “Two key factors in every Section 2(d) case are the first two factors regarding the similarity or dissimilarity of the marks and the goods or services, because the ‘fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *In re Embiid*, 2021 USPQ2d 577, at *10 (TTAB 2021) (quoting *Federated Foods, Inc. v. Fort*

Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)). See also *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.’”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004).

A. Similarity or dissimilarity and nature of the goods

As indicated above, Applicant seeks registration of the mark MAC TÍRE CLOTHING for the clothing listed below:

Hats; Baseball caps and hats; Stocking caps; Stocking hats; Shirts; Shirts and short-sleeved shirts; t-shirts; Short-sleeved or long-sleeved t-shirts; Sweatshirts; Hooded sweatshirts; Coats; Pants; Shorts, in International Class 25.

Opposer has registered MACK TRUCKS and design, reproduced below, for “shirts and hats,”



and MACK (in standard characters) for, inter alia, polo shirts, T-shirts, shirts including dress shirts, caps including knit caps and fleece caps, pants, namely, jogging pants, coats.

The goods are in-part identical and otherwise related.

Under this *DuPont* factor, Opposer need not prove, and we need not find, similarity as to each product listed in the description of goods. It is sufficient for a claim based on likelihood of confusion that we find any item encompassed by the identification of goods in a particular class in the application and registration related. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *General Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1588 n.1 (TTAB 2011), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014).

B. Established, likely-to-continue channels of trade and classes of consumers

Because the goods described in the application and opposer's pleaded registrations are in-part identical, we presume that the channels of trade and classes of purchasers for these goods are the same. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (identical goods are presumed to travel in same channels of trade to same class of purchasers) (cited in *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) ("With respect to similarity of the established trade channels through which the goods reach customers, the TTAB properly followed our case law and 'presume[d] that the identical goods move in the

same channels of trade and are available to the same classes of customers for such goods....”); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same).

C. The conditions under which and consumers to whom sales are made

Because the descriptions of goods are for clothing, including hats and t-shirts, without any limit regarding price point or quality, we must treat the clothing products at issue as including inexpensive as well as more costly products and, therefore, presume that purchasers for the clothing include ordinary consumers who may buy inexpensive clothes on impulse. *See Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014) (recognizing Board precedent requiring consideration of the “least sophisticated consumer in the class”). *See also In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1195 (TTAB 2018) (“Wine purchasers are not necessarily sophisticated or careful in making their purchasing decisions” and because “there is no restriction in the subject application [] and registration as to price or quality, there is no reason to infer that the consumers or purchasers of these alcoholic beverages will be particularly discriminating or careful in distinguishing Applicant’s wine from Registrant’s.”); *In re Sailerbrau Franz Sailer*, 23 USPQ2d 1719, 1720 (TTAB 1992) (finding that not all purchasers of wine may be discriminating because while some may have preferred brands, “there are just as likely to be purchasers who delight in trying new taste treats.”).

D. The strength of Opposer's MACK marks

In determining the strength of a mark, we consider both its inherent strength, based on the nature of the mark itself, and its commercial strength, based on the marketplace recognition value of the mark. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”); *Top Tobacco, L.P. v. N. Atl. Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006); 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:80 (5th ed. March 2023 Update) (“The first enquiry focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another’s use.”). Market strength is the extent to which the relevant public recognizes a mark as denoting a single source. *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d at 1899.

1. Inherent Strength

Because Opposer's MACK mark in standard characters (Registration No. 3308148) is registered under the provisions of Section 2(f) of the Trademark Act, Opposer has conceded that MACK is primarily merely a surname when used in connection with clothing. *See* note 4 above. However, by registering its mark under Section 2(f), Opposer claims that through use MACK has developed trademark

significance. *See G.H. Mumm & Cie v. Desnoes & Geddes Ltd.*, 917 F.2d 1292, 16 USPQ2d 1635, 1637 (Fed. Cir. 1990) (Acquired distinctiveness “arises when a symbol or device, not inherently distinctive at the time of its adoption, later acquires distinctiveness such that the symbol or device serves as a mark to indicate the source of the associated goods. (internal citation omitted). A mark that has acquired secondary meaning may serve as a trademark and be protected even if the mark was not distinctive at the time of its adoption.”); *Yamaha Int’l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F2d 1572, 6 USPQ2d 1001, 1007 (Fed. Cir. 1988) (“Section 2(f) permits registration of marks that, despite not qualifying for registration in light of Section 2(e), have nevertheless ‘become distinctive of the applicant’s goods in commerce.’”).

Marks registered under the provisions of Section 2(f) are registered on the Principal Register and, therefore, provide the owner (i.e., Opposer) with a statutory presumption of trademark rights to preclude others from such use as would result in confusion. *See* Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b) (i.e., validity of the registered mark and of the registration of that mark, registrant’s ownership of the mark, and the registrant’s exclusive right to use the registered mark on or in connection with the goods or services specified in the registration).

Despite Opposer’s amendment to register MACK under the provisions of Section 2(f) in response to the USPTO refusal to register MACK on the ground that it is primarily merely a surname under Section 2(e)(4) of the Trademark Act, 15 U.S.C. § 1052(e)(4), Applicant introduced evidence showing that MACK is not primarily merely a surname. THE RANDOM HOUSE UNABRIDGED DICTIONARY (2022)

(dictionary.com) defines “Mack” as, inter alia, “a male given name.”⁶⁰ A standard reference defining MACK as something other than a surname rebuts the presumption that MACK is primarily merely a surname.⁶¹

To show that Opposer’s MACK mark is conceptually weak, Applicant introduced a USPTO TESS search summary of 132 MACK or MAC formative registered marks,⁶² a USPTO TESS search summary of 24 MACK or MAC formative marks registered in International Class 25,⁶³ and copies of 22 MACK, MAC, or MAX formative marks registered in International Class 25.⁶⁴ The registrations listed below are illustrative:

⁶⁰ 37 TTABVUE 118-122.

⁶¹ Applicant concedes that “Mack” is not primarily merely a surname. Applicant’s Brief, pp. 19-20 (56 TTABVUE 25-26) (“In addition to being defined as ‘a male given name,’ the term MACK is a quite common last name. ... The combination of MACK being defined as ‘a given male name’ and being well known to the average consumer as a surname is a very strong indicator that the term MACK has a connotation or commercial impression of a surname or personal name ...”).

⁶² 38 TTABVUE 6-10.

⁶³ 38 TTABVUE 12.

⁶⁴ 40 TTABVUE.

Third-party registrations are relevant evidence of the inherent or conceptual strength of a mark or term because they are probative of how terms are used in connection with the goods or services identified in the registrations. “Third party registrations show the sense in which the word is used in ordinary parlance and may show that a particular term has descriptive significance as applied to certain goods or services.” *See, e.g., Institut Nat’l Des Appellations D’Origine v. Vintners Int’l Co.*, 958 F.2d 1574, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992). *See also Juice Generation, Inc. v. GS Enters., LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674-75; *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015). Third-party registrations used in this manner are not evidence that customers are accustomed to seeing the use of other, similar, marks in the marketplace, but rather evidence that a term is suggestive or descriptive of the relevant goods or services, just as in the case of a dictionary definition. Such terms may be conceptually weak because the more suggestive or descriptive a term is, the less likely prospective purchasers are to attach source-identifying significance to the term. *In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1744-46 (TTAB 2016).

- Registration No. 1503125 for the mark MACK'S SHUT-EYE SHADE for "sleep masks";⁶⁵
- Registration No. 4207789 for the mark MACK WELDON for "clothing, namely, undergarments, t-shirts, tank tops, undershirts, socks, lounge wear, pajamas, robes, belts, ties, bow ties, collar protectors, scarves, ear muffs, gloves and mittens";⁶⁶ and
- Registration No. 4861412 for the mark SILVER & MACK for a wide variety of clothing items.⁶⁷

The list of MACK, MAC, or MAX formative marks also included four registrations where MACK is a surname. For example,

- Registration No. 2903269 for the mark KATE MACK for "girl's clothing, namely, dresses, skirts, overalls, jumpers, jackets, blouses, t-shirts, vests, sweaters, pants, shorts, leggings, caps, hats, headbands, swimwear, and sandals";⁶⁸
- Registration No. 3343800 for the mark PENELOPE MACK for a wide variety of clothing items;⁶⁹
- Registration No. 4274469 for the mark EMY MACK for "footwear, namely, custom fitted fashion shoes for women";⁷⁰ and

⁶⁵ 40 TTABVUE 10.

⁶⁶ 40 TTABVUE 23.

⁶⁷ 40 TTABVUE 38.

⁶⁸ 40 TABVIE 16-17.

⁶⁹ 40 TTABVUE 19.

⁷⁰ 40 TTABVUE 26.

- Registration No. 6689867 for the mark DEBORAH ANN MACK for “coats; jumpsuits; bottoms as clothing; tops as clothing; women’s clothing, namely, shirts, dresses, skirts, blouses.”⁷¹

The fact that MACK is registered on the Principal Register under Section 2(f) of the Trademark Act means that despite any inherent weakness as either a given name or a surname, we presume MACK has acquired source-indicating significance in the marketplace, the extent of which is discussed more fully below.

2. Commercial Strength

As discussed above, Opposer alleges that MACK is a famous mark. Commercial strength or fame is the extent to which the relevant public recognizes a mark as denoting a single source. Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir.

⁷¹ 40 TTABVUE 70.

2012) (citing *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007)).

However, a mark's commercial strength or fame is not a binary factor in the context of a likelihood of confusion analysis. *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) ("The TTAB applied a legally incorrect standard in applying an all-or-nothing measure of 'fame,' more akin to dilution analysis."). Rather, likelihood of confusion fame "varies along a spectrum from very strong to very weak." *Id.* The proper standard is the mark's "renown within a specific product market," *id.*, and "is determined from the viewpoint of consumers of like products," *id.* at 1735, and not from the viewpoint of the general public.

Commercial strength or fame may be measured indirectly by the volume of sales and advertising expenditures in connection with the goods or services sold under the mark, and other factors such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the goods or services identified by the marks; and the general reputation of the goods or services. *Weider Publ'ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1354 (TTAB 2014), *appeal dismissed per stipulation*, No. 2014-1461 (Fed. Cir. Oct. 10, 2014); *see also Bose*, 63 USPQ2d at 1308 (recognizing indirect evidence as appropriate proof of strength); *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1056 (TTAB 2017) (finding petitioner's evidence of commercial strength included unsolicited media coverage); *ProQuest Info. & Learning Co. v. Jaques R. Island*, 83 USPQ2d 1351, 1358 (TTAB

2007) (finding widespread unsolicited media is probative of fame). In addition, some context in which to place raw statistics may be necessary (e.g., the substantiality of the sales or advertising figures for comparable types of products or services). *Bose*, 63 USPQ2d at 1309.

Cam Creech, the licensing and merchandising manager for Mack Trucks, Inc., testified as follows regarding the commercial strength of the MACK trademarks:⁷²

- “The MACK mark has been used in connection with vehicles since 1900.”⁷³
- “[Opposer] holds a market share in the Class 8 truck segment of 8.4% according to the data from American Truck Dealers. Mack holds the sixth largest percentage of this market out of seven main manufacturers. Mack has recently launched new vehicles in the Class 7 and Class 6 markets, further increasing the number of MACK trucks in the marketplace and supplying vehicles to a broader customer base.”⁷⁴

⁷² Mack Trucks, Inc. is a wholly-owned subsidiary of AB Volvo of Sweden. Volvo Truck Corporation of Sweden is a wholly-owned subsidiary of AB Volvo of Sweden. Volvo Truck Corporation of Sweden licenses the MACK marks to Mack Trucks, Inc. Creech Testimony Decl. ¶ 3 (33 TTABVUE 2-3).

⁷³ Creech Testimony Decl. ¶ 4 (33 TTABVUE 3).

⁷⁴ *Id.* at ¶ 26 (33 TTABVUE 10). Because Opposer did not define Class 6, 7, and 8 trucks, the testimony about Opposer’s market share is not as persuasive as it might have been with such an explanation. In addition, Creech Exhibit 14, a summary of the number of trucks Opposer has sold from 2015 through the second quarter of 2021, is not probative because Opposer listed North American sales and did not parse out U.S. sales or provide an estimate of U.S. sales. Creech Exhibit 14 (34 TTABVUE 361) (confidential).

We also had difficulty understanding the Creech testimony regarding Opposer’s revenues for its “branded” and “licensed” products because while Mr. Creech differentiated the two, he did not explain the difference between a branded product and a licensed product. Creech Testimony ¶¶ 21-22 (34 TTABVUE 9-10) (confidential). Because we do not understand the testimony and because we do not want to speculate, we simply note that Opposer earned revenues from its licensed and branded products.

- “Since at least as early as the 1980s, the MACK mark has been used continuously on or in connection with clothing.”⁷⁵

- Opposer has “advertised and promoted MACK clothing and accessories for decades through catalogs and direct mailers, as well as at trade shows, and special events. The online MACK SHOP has been available to the general public for over a decade. MACK branded goods are also available at four Mack Trucks’ brick and mortar stores in Greensboro, North Carolina; Allentown, Pennsylvania; Hagerstown, Maryland; and Macungie, Pennsylvania.”⁷⁶

- “In addition to [Opposer’s] branded stores, [Opposer’s] dealers promote and sell MACK branded merchandise in their locations. There are currently 316 MACK branded dealers throughout the United States. Many of these dealers sell MACK branded merchandise at their locations. Mack dealers also use merchandise, such as caps and t-shirts, as promotional give-a-ways to Mack truck customers.”⁷⁷

- Opposer has licensed the use of the MACK mark on clothing to third-party retailers such as Wal-Mart, JC Penney, Kohl’s, Urban Outfitters, AutoZone, and Tractor Supply.⁷⁸

- “Over the years, the MACK mark has been licensed to a number of different entities.”⁷⁹ For example,

⁷⁵ *Id.* at ¶ 5.

⁷⁶ *Id.* at ¶ 7.

⁷⁷ *Id.* at ¶ 9 (33 TTABVUE 3-4). Presumably the “branded merchandise” refers to clothing and accessories that Opposer has advertised and promoted. *Id.* at ¶ 7 (33 TTABVUE 3).

⁷⁸ *Id.* at ¶ 11 (33 TTABVUE 4).

⁷⁹ *Id.* at ¶ 12 (33 TTABVUE 4).

- Disney/Pixar for use in the “Cars” film series;
- Hasbro, Lego, and others for toys; and
- Dreamworks/Paramount/Hasbro in connection with characters in the “Transformers” film series.⁸⁰

- “There has been prominent use of MACK trucks in a number of films over the years such as *Convoy*, *Mad Max 2: The Road Warrior*, and *Transformers: Dark Side of the Moon*. MACK trucks were used in *Pete’s Dragon*, *Bohemian Rhapsody*, and *Bad Boys II*. ... The character Dale Gribble in *King of the Hill* wore a MACK truck hat throughout the series. The MACK mark appeared in every episode in which Dale Gribble appeared. Mack Trucks’ president has appeared on the CBS show *Undercover Boss*.”⁸¹

- Opposer spends millions of dollars each year advertising its MACK branded goods and services. In addition, each year, Opposer’s authorized dealers also spend a substantial amount advertising the MACK brand.⁸²

Opposer also submitted news articles and Internet materials from third parties referring to Opposer’s MACK marks.⁸³ For example,

⁸⁰ *Id.* at ¶ 12 (33 TTABVUE 4-5).

⁸¹ *Id.* at ¶ 15 (33 TTABVUE 6).

⁸² *Id.* at ¶ 23 (34 TTABVUE 10). Because Opposer designated its advertising expenditures confidential, we refer them only in general terms.

Opposer introduced sample advertisements through a notice of reliance posted at 27 TTABVUE.

⁸³ 28 and 32 TTABVUE.

- A Detroit Free Press (May 2, 1964) headline reads “Veteran Firm’s Reputation ‘Built Like a Mack Truck’”⁸⁴

- The Spokane-Review Spokane Chronicle (July 28, 1987)

‘Summer School’ isn’t heavy, man, it’s light and fun

The name Carl Reiner on a movie is usually a warning label for heavy-handed comedy. Most jokes in his film hit you like a Mack truck.⁸⁵

- The York Dispatch (August 15, 1978)

Vasily in capitalistic role

Alexeev: built like a Mack truck⁸⁶

- Northwest Herald (May 22, 2005)

Watercraft hits pier on lake; Mundelein man recovering

“I got there half a minute after it happened,” Cortesi said.
“It sounded like a Mack truck hit something in that lake.”⁸⁷

⁸⁴ 28 TTABVUE 12. Other than the headline, the article was illegible as were other articles. *See, e.g.*, 28 TTABVUE 13, 14, 15, 16, 18, 21, 23 and others. It is the responsibility of the party introducing the evidence to ensure that it has been properly made of record and is legible. Trademark Rule 2.126(a)(2), 37 C.F.R. § 2.126(a)(2) (“Exhibits pertaining to an electronic submission must be made electronically as an attachment to the submission and must be clear and legible.”). *See also Weider Publ’ns*, 109 USPQ2d at 1350-51; *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 170, 1758 n.16 (TTAB 2013) (“[T]he onus is on the party making the submissions to ensure that, at a minimum, all materials are clearly readable by the adverse party and the Board.”), *aff’d mem.*, 565 F. App’x (Fed. Cir. 2014); *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1404 (TTAB 1998) (“It is reasonable to assume that it is opposer’s responsibility to review the documents it submits as evidence to ensure that such submissions meet certain basic requirements, such as that they are legible and identified as to source and date.”)

⁸⁵ 28 TTABVUE 17.

⁸⁶ 28 TTABVUE 20. Other than the headline, the article itself was illegible.

⁸⁷ 28 TTABVUE 22.

- Kid Rock, Nicki Minaj, Ice-T, Grateful Dead, Pitbull, Cardi B, Jay Z, Trace Adkins, Sheryl Crow, and Debby Harry among others include Mack trucks in their song lyrics.⁸⁸

- Public Books website (publicbooks.org) (February 9, 2020)

How Greta Gerwig’s “Little Women” Misses The Mark

... I first read *Little Women* at age nine, at a time when – even downtown New York in the ‘70s, even with freethinking bohemian parents – I could see a Mack truck of gendering bearing down on me.⁸⁹

- A review of Grant by Ron Chernow says, “Eminently readable but thick with import ... Grant hits like a Mack truck of knowledge.”⁹⁰

- A review of “The Play,” a book by Karina Halle describes a character as follows: Lachlan is her sexual fantasy come to life – tall, tatted, and built like a Mack truck.”⁹¹

- Sports Illustrated website (si.com) (April 20, 2021)

Why LSU Football Recruit and 2022 Athlete Kendrick Law is Underrated

He’s built like a Mack truck.⁹²

- The Seattle Times (March 27, 2005)

Fullback brought passion to gridiron

Les Mueller ran like a Mack truck accelerating downhill, terrorizing defensive backs who learned that the raging

⁸⁸ 32 TTABVUE 6, 37, 43, 50, 53, 56, 65, 78, 81, 103.

⁸⁹ 32 TTABVUE 121.

⁹⁰ 32 TTABVUE 132.

⁹¹ 32 TTABVUE 137.

⁹² 32 TTABVUE 171.

Hungarian fullback preferred to run over, rather than around, his opponents.⁹³

To show that MACK is not commercially strong, Applicant introduced evidence of third-party uses of MAC-formative marks in connection with retail tire store services and automobile repair services. *See In re FCA US LLC*, 126 USPQ2d 1214, 1224 (TTAB 2018) (“Evidence of third-party use may reflect commercial weakness.”).

For example,

- Mac Tire Pros website (mactirepros.com) located in Snow Camp, North Carolina;⁹⁴

- Mac’s Tire Pros & Auto Repair website (macsservicecenter.com) located in Ashland and Troy, Virginia;⁹⁵

- Mac’s Tire Center website (macstire.com) located in Tupelo and New Albany, Mississippi;⁹⁶

- Macs Tire Services (macstireservice.com) located in Washington, D.C.;⁹⁷

- MAC Tire Facebook page (facebook.com/MACTireInc) located in Moss Bluff, Louisiana;⁹⁸

⁹³ 32 TTABVUE 222.

⁹⁴ 37 TTABVUE 65-69.

⁹⁵ 37 TTABVUE 71-80.

⁹⁶ 37 TTABVUE 85-86.

⁹⁷ 37 TTABVUE 88-92.

⁹⁸ 37 TTABVUE 94-99.

- Big Mac's Tire Store website (bigmacstirestore.com) located in Greenwood, South Carolina;⁹⁹
- Mar Mac Tire Co. website (marmactire.com) located in Kensington, Pennsylvania;¹⁰⁰ and
- Mac Tools website (mactools.com) a company that manufactures tools for the repair and maintenance of tires and wheels.¹⁰¹

In assessing Applicant's evidence of third-party use, we note that the third-party marks are MAC-formative marks, not MACK-formative marks. None of the third-party marks consist of the name "Mack." We also note that all of the third-party uses relate to retail tire store services and automobile repair services with the exception of the tool manufacturer. The MAC-formative marks do not identify trucks or clothing. Finally, the third-party retailers using the MAC-formative marks are in distinct, local markets indicating that consumers are unlikely to encounter multiple MAC tire stores and, thereby distinguish among them by looking at features other than the name "Mac." See *Anthony's Pizza & Pasta Int'l, Inc. v. Anthony's Pizza Holding Co., Inc.*, 95 USPQ2d 1271, 1278 (TTAB 2009), *aff'd*, 415 Fed. Appx. 222 (Fed. Cir. 2010). Accordingly, Applicant's evidence of third-party use does not detract from the strength of Opposer's MACK mark in connection with trucks or clothing.

⁹⁹ 37 TTABVUE 101-102.

¹⁰⁰ 37 TTABVUE 104-105.

¹⁰¹ 37 TTABVUE 107-113.

With respect to the commercial strength of Opposer's MACK mark for trucks, we find the evidence sufficient to show that the mark falls on the strong side of the spectrum of from very strong to very weak. *Joseph Phelps Vineyards*, 122 USPQ2d at 1734. That is, Opposer's market share in the truck industry proves that Opposer's vehicles are commercially successful. In addition, third parties refer to "Mack truck" to create an image that others will understand that proves the renown of the mark for trucks.

Despite any inherent or conceptual weakness of the name "Mack" because it may be considered a surname and, therefore, Opposer registered it under the provisions of Section 2(f), the evidence shows the MACK mark to be commercially strong in connection with trucks, and entitled to a broad scope of protection. In this regard, a mark that is well known for its original or core product is often used in connection with other products (e.g., clothing). It is common knowledge that famous marks are frequently used on collateral or merchandising products such as clothing, mugs and other consumer goods.

We agree with the board that appellee's evidence establishes that appellee has built up an enormous goodwill in the mark MONOPOLY, which has been used since 1935 for a board game and that MONOPOLY may properly be termed a "famous" mark. We also find no error in the board's conclusion that it is a matter of common knowledge that famous marks are frequently used on items such as clothing, glassware, and trash cans and that appellee's licensing of its mark for use on certain novelty items supports this conclusion.

Tuxedo Monopoly, 209 USPQ at 988.

Likewise, as the Board found in *Harley-Davidson Motor Co. v. Pierce Foods Corp.*, 231 USPQ 857, 863 (TTAB 1986):

That the mark HARLEY-HOG used on pork products is likely to be associated as to source with opposer is also corroborated by the fact that opposer's uses of HARLEY and HOG in relation to its collateral goods frequently have been whimsical in character (e.g., HOG piggy banks, T-shirts bearing the phrase, 'I LOVE MY HOG HARLEY,' 'the HOG Tales' publication, etc.). Because of these uses, a person having knowledge of them would not be surprised to see HARLEY-HOG used in connection with hot dogs or similar products, and the association with opposer of the mark so used would also be not at all surprising.

The likelihood of confusion is further enhanced by the fact that opposer's line of products has been extended to include such goods as beer, wine coolers and chocolate bars. While these products are different than pork, the fact that beer and hot dogs or pork sausages are frequently consumed together, for example, is significant.

See also L.C. Licensing Inc. v. Berman, 86 USPQ2d 1883, 1889 (TTAB 2008) ("It is common knowledge, and a fact of which we can take judicial notice, that the licensing of commercial trademarks on 'collateral products' has become a part of everyday life."); *Turner Entm't Co. v. Nelson*, 38 USPQ2d 1942, 1945 (T.T.A.B. 1996) ("It is common knowledge, and in the present case, undisputed that video games, t-shirts, beach towels, caps and other logo-imprinted products are used as promotional items for a diverse range of goods and services."). Because of the renown of the MACK marks in connection with trucks and Opposer's licensing of collateral products such as clothing, consumers are likely to associate similar marks for clothing with Opposer's well known MACK marks for trucks.

E. The similarity or dissimilarity of the marks

We now turn to the *DuPont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019); *accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted).

In comparing the marks, we are mindful that where, as here, the goods are in-part 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. *Coach Servs.*, 101 USPQ2d at 1721; *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007).

“The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Cai*, 127 USPQ2d at 1801 (quoting *Coach Servs.* 101 USPQ2d at 1721).

We keep in mind that “[s]imilarity is not a binary factor but is a matter of degree.” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1062 (Fed. Cir. 2003)).

Applicant is seeking to register MAC TÍRE CLOTHING for clothing and Opposer’s pleaded registrations include MACK for trucks and clothing and MACK TRUCKS and design for shirts and hats. Applicant contends that “MAC TÍRE’ is the Irish word that means ‘wolf’ and is phonetically pronounced as <mok cheer-a>.”¹⁰² However, according to “Detailed Languages Spoken at Home and Ability to Speak English for the Population 5 Years and Over: 2009-2013,” posted on the U.S. Census Bureau website (census.gov), there are approximately 20,950 Irish Gaelic speakers in the United States.¹⁰³ Accordingly, a substantial segment of the relevant consumers for clothing (with no restrictions as to channels of trade, classes of consumers, or price) will not perceive MAC TÍRE as “wolf,” pronouncing it “mok cheer-a,” but simply take the mark as it is, as MAC TÍRE, and pronounce TÍRE any number of ways, such as “tier-ray” or “tire,” as discussed more fully below.¹⁰⁴ “When it is unlikely that an American buyer will translate the foreign mark and will take it as it is, then the

¹⁰² Applicant’s Brief, p. 13 (56 TTABVUE 19) (citing “How To Say – Wolf In Irish Gaelic,” posted on the BiteSize Irish Blog (bitesize.irish.blog/) (37 TTABVUE 9-11)).

Although Applicant contends that “[m]ore than 31.5 million residents claim Irish ancestry” (37 TTABVUE 18), that does not mean that they speak Irish Gaelic. Applicant’s Brief, p. 13 (56 TTABVUE 19).

¹⁰³ 26 TTABVUE 8.

¹⁰⁴ We note “there is no correct pronunciation of a trademark that is not a recognized word.” *StonCor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 111 USPQ2d 1649, 1651 (Fed. Cir. 2014).

doctrine of foreign equivalents will not be applied.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005) (citing *In re Tia Maria, Inc.*, 188 USPQ 524 (TTAB 1975)). Accordingly, we find it unnecessary to delve into an analysis of the doctrine of foreign equivalents and decline to apply the doctrine in this case.

With respect to that segment of the consuming public that does not recognize MAC TÍRE as “mok cheer-a,” that is, as a term with a defined meaning in Irish Gaelic, Applicant asserts that it is nonetheless “highly likely that the average consumer would realize that the forward-leaning acute accent (´) in the term MAC TÍRE means that this term comes from a foreign language.”¹⁰⁵ Quoting from the article “A Guide to Deciphering Diacritics,” Applicant argues that diacritical marks “are important in correctly pronouncing many foreign words that have migrated into the English language.”¹⁰⁶ Assuming the relevant consuming public recognizes MAC TÍRE as a foreign term that has migrated into the English language, Applicant argues they will analyze MAC TÍRE as follows:

Next, the average consumer would attempt to pronounce TÍRE in a foreign language that is familiar to the average consumer, for example Spanish. Because of this recognition of the accent or diacritics, the average consumer would not attempt to pronounce the foreign word as an English word.

Alternatively, assume that the average consumer would attempt to pronounce TÍRE as an English word. The average consumer would stress the letter accented “I” to pronounce TÍRE as “tee-rah” instead of ignoring the

¹⁰⁵ Applicant’s Brief, p. 13 (56 TTABVUE 19).

¹⁰⁶ Applicant’s Brief, p. 13 (56 TTABVUE 19).

accented “T” to pronounce TÍRE as “tire,” where “tire” is the pronunciation that Opposer is advocating.

As a result, the term MAC TÍRE in Applicant’s mark still requires the average consumer to pronounce Applicant’s mark differently than the average consumer would pronounce Opposer’s marks.¹⁰⁷

Assuming arguendo that some segment of the relevant consuming public would analyze MAC TÍRE as a foreign term, a substantial segment of the public would still perceive MAC TÍRE as MAC TIRE. As noted above, because there are no restrictions or limitations to Applicant’s description of goods, we must assume that Applicant intends to market its clothing in all channels of trade and to all classes of consumers who purchase clothing. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); *Paula Payne Prods. Co. v. Johnson Publ’g Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). That includes consumers who may not be particularly careful in parsing the origins of Applicant’s mark. *See Stone Lion Capital Partners*, 110 USPQ2d at 1163-64 (recognizing Board precedent requiring consideration of the “least sophisticated consumer in the class”).

In this regard, the proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014); *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Winnebago Indus., Inc. v. Oliver & Winston*,

¹⁰⁷ Applicant’s Brief, p. 14 (56 TTABVUE 20).

Inc., 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). As indicated above, the average customer is an ordinary consumer of apparel.

Ordinary consumers do not scrutinize marks. *See B.V.D. Licensing Corp. v. Body Action Design, Inc.*, 846 F.2d 727, 6 USPQ 1719, 1721 (Fed. Cir. 1988) (“The purchasing public, we believe, does not indulge in such recognitional contortions but sees things as they are.”); *In re Johnson Prods. Co., Inc.*, 220 USPQ 539, 540 (TTAB 1983) (“It is undeniable that if the mark is carefully examined, the two overlapping ‘S’s can be discerned. What is more significant, however, is that this sort of studied analysis of the mark is unlikely to occur in the marketplace where these products are sold.”). They do not focus on minutia such as the placement of diacritical marks, if they even notice the accent mark, or the counting of the number of syllables in each mark, but rather form “general rather than specific impressions” of marks. *See Conwood Corp. v S.A. Bongrain-Gerard (Les Matires Fromagers)*, 190 USPQ 155, 158 (TTAB 1976) (purchasers are not apt to place much significance on accent mark appearing above letter in trademark); *In re John Scarne Games, Inc.*, 120 USPQ 315, 316 (TTAB 1959) (“Purchasers of game boards do not engage in trademark syllable counting[;] they are governed by general impressions made by appearance or sound, or both.”). *See also B.V.D. Licensing v. Body Action Design*, 846 F.2d 727, 6 USPQ2d 1719, 1721 (Fed. Cir. 1988) (B.A.D. will be viewed as the word “bad”); *Henry I. Siegel Co., Inc. v. Highlander, Ltd.*, 183 USPQ 496, 499 (TTAB 1974) (H.I.S. will be viewed as “his”).

In sum, even if some consumers recognize MAC TÍRE as the Irish Gaelic term for “wolf,” and some consumers dissect MAC TÍRE into its composite parts so that “the composite term becomes ‘Son of the Land,’ where ‘MAC’ means ‘son of’ and ‘TÍRE’ means ‘earth/land’ in English (both terms translated from Irish). 37 TTABVUE 15,”¹⁰⁸ a significant segment of the relevant public will still perceive MAC TÍRE as MAC TIRE.

Having determined that some significant segment of the relevant public will perceive MAC TÍRE as MAC TIRE, we turn to the similarity or dissimilarity of Applicant’s MAC TÍRE CLOTHING with Opposer’s marks MACK and MACK TRUCKS and design. We find Applicant’s MAC TÍRE mark and Opposer’s MACK and MACK TRUCKS and design marks look and sound alike and engender similar commercial impressions.

Opposer’s registration for MACK in standard characters contains no additional elements. With respect to Opposer’s mark MACK TRUCKS and design, the name “Mack” is the dominant part of the mark for two reasons. First, “[i]n the case of marks, such as [MACK TRUCKS and design], consisting of words and a design, the words are normally accorded greater weight because they are likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the goods.” *Aquitaine Wine USA*, 126 USPQ2d at 1184 (citing *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983)). That is because “[t]he word

¹⁰⁸ Applicant’s Brief, p. 9 (56 TTABVUE 15).

portion of a word and design mark ‘likely will appear alone when used in text and will be spoken when requested by consumers.’” *Aquitane Wine USA*, 126 USPQ2d at 1184 (quoting *Viterra*, 101 USPQ2d at 1911).

Second, the name “Mack,” as the lead element of the term MACK TRUCKS has a position of prominence; it is likely to be noticed and remembered by consumers and so as to play a dominant role in the mark. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (finding “the identity of the marks’ two initial words is particularly significant because consumers typically notice those words first”); *Palm Bay Imps. Inc.*, 73 USPQ2d at 1692 (“Veuve” is the most prominent part of the mark VEUVE CLICQUOT because “veuve” is the first word in the mark and the first word to appear on the label.); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word).

There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, such as a common dominant element, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *Viterra*, 101 USPQ2d at 1908; *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Likewise, the name “Mac” is the dominant part of Applicant’s mark MAC TÍRE CLOTHING for two reasons. First, the word “Clothing” is descriptive and Applicant disclaimed the exclusive right to use it. It is well-settled that disclaimed, descriptive matter may have less significance in likelihood of confusion determinations because

consumers will tend to focus on the more distinctive parts of marks. *See Detroit Athletic Co.*, 128 USPQ2d at 1050 (citing *Dixie Rests.*, 41 USPQ2d at 1533-34); *Cunningham v. Laser Golf Corp.*, 55 USPQ2d at 1846 (“Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’”) (quoting *Nat’l Data Corp.*, 224 USPQ at 752); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression.”).

Second, “Mac” has a position of prominence in the mark MAC TÍRE CLOTHING inasmuch as it is the lead element of the mark. We emphasize that in this part of the analysis, we are considering consumers who do not perceive MAC TÍRE as a unitary term being the Irish word for “wolf” or “son of the land,” but ordinary, U.S. consumers who perceive MAC TÍRE as MAC TIRE.

MAC TÍRE CLOTHING is similar, albeit not identical, in appearance and sound to MACK and MACK TRUCKS. “Exact identity is not necessary to generate confusion as to source of similarly-marked goods.” *Bridgestone Ams. Tire Operations LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064, (Fed. Cir. 2012). Because of the fame of Opposer’s mark MACK for trucks, Applicant’s MAC TÍRE calls to mind Opposer’s MACK marks because of the association between tires and vehicles. In other words, consumers encountering MAC TÍRE CLOTHING are going to mistakenly believe that Applicant’s clothing products are associated with Opposer because of the renown of Opposer’s MACK mark for trucks and the similarity of the

marks MAC TÍRE CLOTHING and MACK and MACK TRUCKS and design, especially where, as here, the goods are in-part identical.

In such circumstances, the difference between MAC TÍRE CLOTHING and MACK or MACK TRUCKS and design does not create dissimilar marks. *See, e.g., Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1741 (TTAB 2014) (AKEA is similar to IKEA); *RE/MAX of America, Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964 (TTAB 1980) (REMACS and RE/MAX indistinguishable in sound); *U.S. Mineral Prods. Co. v. GAF Corp.*, 197 USPQ 301, 306 (TTAB 1977) (“‘AFSCO’ and ‘CAFSCO,’ which differ only as to the letter ‘C’ in USM’s mark, are substantially similar in appearance and sound.”); *In re Bear Brand Hosiery Co.*, 194 USPQ 444, 445 (TTAB 1977) (“The mark of the applicant, ‘KIKS’ and the cited mark ‘KIKI’ differ only in the terminal letter of each mark. While differing in sound, the marks are similar in appearance and have a somewhat similar connotation.”).

We find that Applicant’s mark MAC TÍRE CLOTHING is similar to Opposer’s marks MACK and MACK TRUCKS and design in their entirety in terms of appearance, sound, and commercial impression. These similarities outweigh any perceived differences in connotation.

F. Conclusion

Because the marks are more similar than dissimilar, the goods are in-part identical and the parties are presumed to offer the goods in the same channels of trade to the same classes of consumers, we find that Applicant’s mark MAC TÍRE CLOTHING for “Hats; Baseball caps and hats; Stocking caps; Stocking hats; Shirts;

Shirts and short-sleeved shirts; t-shirts; Short-sleeved or long-sleeved t-shirts; Sweatshirts; Hooded sweatshirts; Coats; Pants; Shorts” is likely to cause confusion with Opposer’s marks MACK for trucks and “sweaters including fleece pullovers, polo shirts, T-shirts, shirts including dress shirts, caps including knit caps and fleece caps, sport jackets, sweatshirts, pants, namely, jogging pants, coats, neckwear; outerwear, namely, leather jackets; jeanswear, namely, jeans, work coveralls of denim, jean jackets, jean shirts” and MACK TRUCKS and design for “shirts and hats.”

Because we have found for Opposer on its likelihood of confusion claim, we need not reach the merits of its claim that Applicant’s mark is void ab initio on the ground that Applicant did not have a bona fide intent to use its mark when it filed its application. *See Multisorb Techs., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170 (TTAB 2013).

Decision: We sustain the opposition.