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BAC

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JULY 22, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Bridgestone/Firestone Research, Inc., substituted for
Bridgestone/Firestone, Inc.¹

v.

Automobile Club De L'Quest De La France (A.C.O.)

Cancellation No. 19,683

Cameron C. Powell of Foley & Lardner for
Bridgestone/Firestone Research, Inc., substituted for
Bridgestone/Firestone, Inc.

Michael J. Striker, Esq. for Automobile Club De L'Quest De
La France (A.C.O.)

Before Hanak, Quinn and Chapman, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

This case involves only a counterclaim petition to
cancel. In 1991 Bridgestone/Firestone, Inc. (hereinafter

¹ The records of the Assignment Branch of this Office indicate that in 1998 petitioner/counterclaim respondent's pleaded Registration No. 756,436 was assigned to Bridgestone/Firestone Research, Inc. (See reel 1772, frame 758). Accordingly,

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Bridgestone) filed a petition to partially cancel Supplemental Registration No. 1,386,349 owned by Automobile Club De L'Quest De La France (A.C.O.) (hereinafter the Automobile Club) for the mark shown below

for "automobile tires" in International Class 12.² The Automobile Club filed a counterclaim to cancel Bridgestone's pleaded Registration No. 756,436³ for the mark LEMANS for "pneumatic rubber tires."

On July 29, 1994, the Board granted Bridgestone's petition to partially cancel pursuant to Trademark Rule 2.134(a) and (b) based on the Automobile Club's failure to file a Section 8 affidavit with regard to its goods "automobile tires" in its Supplemental Registration No. 1,386,349. The Board explained that the counterclaim would go forward.

Bridgestone/Firestone Research, Inc. is substituted as the petitioner/counterclaim respondent.

² Reg. No. 1,386,349, issued March 11, 1986 with goods in Classes 4, 7, 12, 16, 28 and 34; Section 8 affidavit filed for part of the Class 16 goods accepted.

³ Reg. No. 756,436, issued September 10, 1963, on the Principal Register, Section 8 affidavit accepted, Section 15 affidavit acknowledged, renewed. The claimed date of first use and first use in commerce is October 26, 1962. This registration originally issued to Seiberling Rubber Company; was assigned to The Firestone Tire & Rubber Company in 1965; which changed its

In its counterclaim, the Automobile Club pleaded, inter alia, that Bridgestone filed the partial petition to cancel against the Automobile Club's registration alleging a likelihood of confusion and that tires offered by the Automobile Club would be sold to the same classes of purchasers through the same channels of trade as Bridgestone's tires; that Bridgestone is the owner of Registration No. 756,436, and Bridgestone offers for sale automobile tires under the mark LEMANS; that since 1923 the Automobile Club and its predecessors have sponsored, organized and promoted the Le Mans 24-Hour Grand Prix d'Endurance race; that said race is the world's best known automobile race; and that the Le Mans automobile race is generally known throughout the United States and has been since its inception because it is reported through newspapers, sporting magazines and automobile magazines as well as being broadcast on television and radio in the United States.

The Automobile Club further alleges that winning the Le Mans race is a "coveted achievement" (paragraph 20) which is used by the winner to promote sales of the winning automobile in the United States and elsewhere; that since long prior to any use of the mark LEMANS by Bridgestone, the term had become famous and inextricably linked with the

name to Bridgestone/Firestone, Inc. in 1989; and in 1998, there

Automobile Club and its Le Mans race; that pneumatic tires are "closely linked" (paragraph 21) to automobile racing; that one of the most noticeable and important aspects of automobile racing is the automobile tires which are used and replaced during the race; that persons seeing the term LEMANS, particularly when used in association with automotive products, will assume some link, association or sponsorship with or by the Automobile Club; and that Bridgestone intended, actually or impliedly, to create a false association with the Automobile Club and its race through the use of the mark LEMANS for pneumatic rubber tires.

Based on the above, the Automobile Club contends that Registration No. 756,436 should be cancelled under Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), because the mark is deceptive⁴ and falsely suggests a connection with the Automobile Club.

In its answer to the counterclaim Bridgestone admitted, inter alia, that it owns the registration and that it offers tires for sale under the involved mark; and that it filed the petition for partial cancellation alleging a likelihood of confusion and that tires offered by the Automobile Club and those offered by Bridgestone involve the same channels

was an assignment to Bridgestone/Firestone Research, Inc.

⁴ The Automobile Club submitted no evidence on the claim that the mark is deceptive, and did not argue the issue in its brief. Thus, this claim will not be further considered.

of trade and the same classes of purchasers. Bridgestone otherwise denied the salient allegations of the counterclaim.

Further, Bridgestone raised the affirmative defenses that the counterclaim fails to state a claim; that the counterclaim is barred under the doctrines of laches, acquiescence, estoppel and waiver; that the counterclaim is essentially a claim of trademark priority and is barred by the statute of limitations; that the Automobile Club cannot be damaged because it is not the true and rightful owner of the marks LEMANS for tires; and that at the time the Automobile Club filed its application for its mark for, inter alia, tires, it knew or should have known it was not the rightful owner of the mark for tires.⁵

⁵ The only affirmative defenses maintained by Bridgestone in its brief were "laches" and "estoppel by laches." The record does not reflect evidence on these defenses; and in Bridgestone's brief, it stated only very general information about its alleged reliance on the Automobile Club's delay in seeking cancellation of Bridgestone's registration. For example, Bridgestone stated that "... in reliance on the lack of any objection for so many decades [27 years], [Bridgestone] has designed, marketed, and sold **many** tires under the name LEMANS." (brief, p. 37); and "Firestone would obviously not have invested **so much time and money** in its LEMANS tires had [the Automobile Club's] objections been timely raised...". (brief, p. 38) (Emphasis ours). Bridgestone provided absolutely no specific information regarding its alleged reliance on the Automobile Club's alleged silence. While it is clear that there has been a delay in seeking cancellation of Bridgestone's registration, Bridgestone has not proven the elements of the affirmative defenses of laches and estoppel by laches.

None of Bridgestone's remaining affirmative defenses were tried or briefed by Bridgestone and therefore will not be further considered herein.

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The record consists of the counterclaim pleadings; the file of **Bridgestone's** registration; and as counterclaim petitioner's (the **Automobile Club**) case-in-chief the testimony, with exhibits, of Jacques Grelley, a retired French race car driver; a notice of reliance on its Registration No. 1,393,543 for the mark shown below

for "organization and conducting of automobile races"⁶; and notices of reliance on several printed publications.

Counterclaim respondent (**Bridgestone**) submitted the testimony, with exhibits, of Michael Mileski, manager of marketing and product planning at Dayton Tire, a division of Bridgestone; the testimony, with exhibits, of Michel Bonny, a 30-year employee of Michelin Tires; the testimony, with exhibits, of Vincent Desnoes, a librarian at the Alliance Francaise and a student at George Mason University; the testimony, with exhibits, of Donna Lee Rowe, a photographer; and a notice of reliance on a variety of items under Trademark Rule 2.122.

⁶ Reg. No. 1,393,543 issued May 13, 1986 on the Principal register under Section 2(f), Section 8 affidavit accepted, Section 15 affidavit acknowledged. The registration includes a statement that "The mark consists of the term 'LE MANS' inside a design of the Le Mans auto raceway"; and the design of the raceway route is disclaimed. This registration is based on Section 44(e) under a French registration.

Both parties filed briefs on the case, and were represented by counsel at an oral hearing held before the Board on July 22, 1998.

As a preliminary matter, we note that both parties' attorneys made several objections during the trial testimony depositions, and the Automobile Club filed a written objection to seven items in Bridgestone's notice of reliance. None of the objections was preserved by raising same in the respective briefs on the case, with two exceptions. See TBMP §718.04. In its brief, Bridgestone objected to (i) Exhibits 19-22 introduced on cross-examination at Bridgestone's deposition of Vincent Desnoes; and (ii) the Automobile Club's cross-examination of Bridgestone's witness Michael Mileski using the term "association."

With regard to the first objection, Exhibits 19-22 of the Desnoes testimony each consist of the cover page, title page, and relevant page from four separate travel guides; and Bridgestone objected on the basis that these were neither properly authenticated nor introduced under the Federal Rules of Evidence. This objection is overruled because these documents could be properly introduced as printed publications under Trademark Rule 2.122(e). The Automobile Club offering the items as exhibits on cross-examination testimony is fully the equivalent of offering

the documents by way of a notice of reliance under Trademark Rule 2.122(e). See Volkswagenwerk Aktiengesellschaft v. Clement Wheel Company, Inc., 204 USPQ 76, 80 (TTAB 1979).

Bridgestone's objection to the Automobile Club's questioning of the witness Michael Mileski about an "association" as vague and ambiguous is also overruled. Bridgestone's objection goes to the probative value of the testimony, not the admissibility thereof.

The issue before this Board is whether Bridgestone's mark LEMANS as applied to "pneumatic rubber tires" falsely suggests a connection with the Automobile Club and its 24 Hour Le Mans Race within the meaning of Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a).

As discussed by our primary reviewing court in the case of University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc., 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), the portion of Section 2(a) dealing with false suggestion of a connection resulted from the desire to give statutory effect to the notions of rights of privacy and of publicity, the elements of which are distinctly different from elements of a trademark or trade name infringement claim, which are the essence of Section 2(d). Specifically, the Court stated as follows:

Under concepts of the protection of one's "identity," in any of the forms which have so far been recognized, the initial and critical requirement is that the name

(or an equivalent thereof) claimed to be appropriated by another must be unmistakably associated with a particular personality or "persona."

Thus, to show an invasion of one's "persona," it is not sufficient to show merely prior identification with the name adopted by another. Nor is it sufficient, as urged by the University, that the fame of the name of an institution provides the basis for protection in itself. The mark, NOTRE DAME, as used by Gourmet, must point uniquely to the University. (footnotes omitted)

Following the University of Notre Dame case, the Board then enumerated the elements necessary to establish a claim under Section 2(a) (false suggestion of a connection). The plaintiff must prove (i) that the defendant's mark is the same or a close approximation of plaintiff's previously used name or identity; (ii) that the mark would be recognized as such (i.e., that the mark points uniquely and unmistakably to the plaintiff); (iii) that the plaintiff is not connected with the activities performed by the defendant under the mark; and (iv) that the plaintiff's name or identity is of sufficient fame or reputation that when the defendant's mark is used on its goods or services, a connection with the plaintiff would be presumed. See *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985). See also, *In re Sloppy Joe's International Inc.*, 43 USPQ2d 1350 (TTAB 1997); and *In re Kayser-Roth Corp.*, 29 USPQ2d 1379 (TTAB 1993).

Further, in a petition to cancel under Section 2(a) (false suggestion), the plaintiff must demonstrate that at the time of issuance of the registration sought to be cancelled, the term must have pointed uniquely to the plaintiff such that the defendant's mark used in connection with the goods (or services) listed in the registration falsely suggests a connection with the plaintiff. See *The Board of Trustees of the University of Alabama v. BAMA-Werke Curt Baumann*, 231 USPQ 408 (TTAB 1986). Both parties referred to the date of registration as the operative time frame in their briefs on the case.

There is no dispute that **Bridgestone's** mark (LEMANS) is the same or a close approximation of the **Automobile Club's** previously used name or identity (LE MANS); and that **the Automobile Club** is not connected with the activities performed by **Bridgestone** under the mark.

The dispute arises over whether the term LE MANS points uniquely and unmistakably to **the Automobile Club and/or its race**, and whether the **Automobile Club's** name or identity is of such fame or reputation that, when the mark LEMANS is used by **Bridgestone** on its goods, a connection with the **Automobile Club** would be presumed (as of the date of registration).⁷

⁷ We note that in its brief as counterclaim petitioner **the Automobile Club** states the following:

The record shows that the 24-hour Le Mans automobile race was started in 1923, and has been run annually (with a few exceptions) since that time at a track near Le Mans, France. There are of record three issues of the Britannica Book of the Year, for the years 1961, 1962 and 1963, each of which includes an entry under the "Automobile Racing" section for the "Le Mans race". Each one sets forth the particulars of the race, such as the dates, the winning drivers and the winning cars.

A slightly later publication, The Encyclopedia of Motor Sport (1971), includes a section titled "Le Mans Circuits", with a subsection titled "Le Mans 24-Hour Race" with the following statement:

This is undoubtedly the most widely-known motor race in the world, a standing which is sometimes difficult to justify and which is at least in part due to the fascination it has for British and American enthusiasts.

It is beyond discussion that [the Automobile Club] has clearly met the first three arms of the Section 2(a) test. The mark involved is identical and would be clearly recognized as such, and there is no connection between the plaintiff and the defendant.

Rather, [Bridgestone] apparently seeks to hang its hat on the fourth arm of the Section 2(a) test, and it is this issue which will be principally addressed in this brief. (brief, p. 4)

It appears to the Board that the Automobile Club does not understand that it is the second element in the Section 2(a) false suggestion test which relates to the question of whether the mark points uniquely and unmistakably to the plaintiff.

This encyclopedia also includes in this section information that the first such race was run on May 26, 1923; and that when the capacity limit was lifted in 1960 American cars appeared again (Corvettes in that year).

The New Encyclopedia Britannica (appears to be dated 1973-1974) entry refers to the "Le Mans 24-hour Grand Prix d'Endurance" as "probably the world's best-known automobile race, run annually with few exceptions since 1923 at the Sarthe road racing circuit near Le Mans, France."

In Motor Sports, A Pictorial History (1975) by Raymond Flower, under a section titled "Bentleys at Le Mans", it states as follows in referring to the French town of Le Mans: "But the real reason for its fame was the sports car race - Les 24 Heures du Mans - that still stands supreme as the international test of speed and endurance."

These materials clearly evidence that the LE MANS race was highly publicized in the United States; and the entries in the Britannica yearbooks of 1961, 1962 and 1963 evidence the fact that the LE MANS automobile race was of sufficient fame, notoriety and interest that it achieved mention therein at least as of the early 1960s.⁸

⁸ While articles in books and magazines are not proof of the truth of the statements made in them, they do show that the public has been exposed to the statements. See *Kabushiki Kaisha Hattori Seiko v. Satellite International Ltd.*, 29 USPQ2d 1317, footnote 1 (TTAB 1991). With regard to the encyclopedias, we may

The Automobile Club's witness, Jacques Grelley, a retired race car driver from France, testified that he attended the Le Mans race from 1949 to 1962 as a spectator at first, but as a race car driver in 1959, 1960 and 1961, and about 10 to 12 times as a spectator since 1962; and that the Le Mans race is the most important race to him because "It's sports car racing. Le Mans is the top of the list" (Dep., p. 9). He explained that the race is a 24-hour endurance race, 4pm Saturday to 4pm Sunday, and "the overall winner is the most powerful car who does the most miles, the distance winner" (Dep., p. 12); and there is a winner for using the least gas in attaining the fastest speed.

Mr. Grelley testified that Ford Motor Company participated in the Le Mans race from 1967 to 1969 and that it was then televised on ABC; and the race is still televised on the ESPN and Speedvision channels. His understanding of Firestone's⁹ first participation in the race was in 1929, but he personally remembers Firestone's attendance in 1972, as well as later years.

He further testified that sponsorship by companies of racing cars and teams began when the factories not only

take judicial notice of the information in standard reference materials. See Sprague Electrical Company, Inc. v. Electrical Utilities Company, 209 USPQ 88, footnote 3 (TTAB 1980).

⁹ Firestone Tire & Rubber Company changed its name to Bridgestone/Firestone, Inc. in 1989.

built the car but supported the team financially; that in the United States companies such as Hertz, Texaco, and Tide sponsor race cars or race teams; that manufacturers of parts for cars sponsor race cars, such as Champion; and all of the tire companies ("Michelin, Dunlop, Firestone, Goodyear, Goodrich" - Dep., p. 15) sponsor race cars. When asked why tire companies sponsor race cars he testified:

To them it's part of their promotion. If their tire, any company, can win a race, so they are good enough. If they were good enough to win a race, they are good enough for the consumer, all the people. (Dep., p. 15).

When asked why tire companies would manufacture racing car tires, he answered:

Commercially the tires used in racing are not the same that you use on the street, but the name being there, many people think that if Goodyear or Firestone used their tire for racing and win, the tire must be good on their car. (Dep., p. 23).

He explained there is a huge commercial advantage to winning the car race, for the manufacturers of the automobile, the tires and the engine. Mr. Grelley gives an example that in the 1950's Jaguar won the Le Mans race several times and sales were very good, and when Jaguar quit racing their sales went down by half in five years (Dep., p. 24).

Mr. Grelley also testified that there are Dunlop tire bridges over the Le Mans raceway in three different places; and that about 20 years ago in the United States there was a movie called "Le Mans" starring Steve McQueen.

Bridgestone's witness, Michael Mileski, an employee of the Dayton Tire Division of Bridgestone, testified that he started with the company in 1975, and Bridgestone was involved in auto racing "well before my time." When asked if Bridgestone was always involved, he answered "Bridgestone I'm not as clear on. The Firestone brand image was developed through auto racing in various formats in the endurance racing, drag racing." (Dep., p. 26). He went on to testify as follows:

Firestone had created their brand image based on the early endeavors in racing and gotten out of racing in the mid '70s, and the brand image began to decline. The brand name still had very high recognition among dealers and consumers, but the image was declining. So two years ago, Firestone embarked on a program to improve their brand image. They went racing again is what they did. (Dep., p. 36).

Mr. Mileski further explained Bridgestone backed out of racing in the 1970's because of cost considerations, but it got back into "big time racing" in the last few years. In fact, Firestone sponsors the Firehawk Indy Light race, which is the race before the Indy 500, and that it has returned to

participation in the Indy 500; and that Bridgestone produces auto racing tires (one such tire is sold under the mark "Firestone Firehawk").

In discussing Bridgestone's LEMANS tires, Mr. Mileski testified that the LEMANS tire is the lowest price tire for its segments (e.g., touring, light truck). According to Mr. Mileski the most significant attribute of these types of tires is price. The LEMANS tires are generally advertised in newspapers (sometimes by price only), and these tires are also on the floor of the retail stores. "That's the tire that you're advertising to build traffic to come into the store, brand name means nothing. They usually have minimal performance characteristics." (Dep., p. 30). "Its function is strictly to build traffic. ... The whole intent is to drive traffic based on this, and actually step them up to a branded product, a non LEMANS branded product." (Dep., p. 51).

Mr. Mileski also testified that the LEMANS brand tires' getting any sort of recognition based on the annual race in Le Mans, France would be only to "hard-core motor sports enthusiasts" (Dep., p. 54), and that "the majority of the people that would have heard of it [the Le Mans race] have to be the hard-core enthusiasts".¹⁰ (Dep., p. 55). But, when asked on cross examination, if the hard-core

enthusiasts would make some association between the mark LEMANS on tires and the Le mans race, he answered "yes, they will." (Dep., p. 56); and that "there could be or there is a small segment I'm sure that could make the association [between the tire and the automobile race]." (Dep., pp. 56-57). He further testified that he did not know how large a segment of the general population that would be, but probably "extremely small." (Dep., p. 57). He acknowledged that he is one (of the few people) who would associate the word LEMANS with the race.

In addition, he testified the Firestone brand was, in part, formed by racing in that it had won the Indianapolis 500 several times and it was able to advertise "they had the winning tires and it created a recognition factor for the consumer." (Dep., p. 60). He explained that the reason people would buy normal tires just because the races were won is that "you can assume that if they won a race, they make good tires. If they make good race tires, that could translate into good passenger." (Dep., p. 61).

During the deposition of Bridgestone's witness Mr. Michel Bonny, a retired Michelin employee, he testified that the first Le Mans 24-hour race was run in 1923; that it was popular in the mid-seventies, declined in the mid-eighties due to big auto makers not appearing in the race, and it is

¹⁰ He pointed out that performance enthusiasts are not generally

now back in popularity as it was in the mid-seventies; that the Le Mans race is most popular with the French, then the British; and that the world's most famous car races are the Monte Carlo rally, the Monte Carlo Grand Prix, the Indy 500, and Le Mans.

Regarding the promotion of tires, Mr. Bonny testified "Racing is part of the promotion for tires", and winning a race was good because you could say you beat the other cars using other tires in the race. (Dep., p. 90-92). He acknowledged that if you have a sports enthusiast who knows about racing that person might associate LEMANS on tires with the Le Mans race; and on cross-examination after some interesting banter between counsel, Mr. Bonny testified that automobile tires have been promoted at the Le Mans automobile race, and that he sees an association between LEMANS on tires and the famous automobile race. (He did point out that there is also a car by that name, the Pontiac LeMans.) Also, according to Mr. Bonny, one could associate Dunlop tires with Le Mans race because they are run there; and that he believes only a few people in the United States would be able to identify Le Mans as a race.

The party asserting a claim of false suggestion must prove its claim by a preponderance of the evidence. See *Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*,

looking for entry level tires.

892 F.2d 1021, 13 USPQ2d 1307, 1310 (Fed. Cir. 1989).

Further, the Court of Appeals for the Federal Circuit cautioned in the case of *West Florida Seafood Inc. v. Jet Restaurants Inc.*, 31 F.3d 1122, 31 USPQ2d 1660 (Fed. Cir. 1994) that individual pieces of evidence must be taken together, so that the body of evidence is viewed as a whole.

The Court of Appeals for the Federal Circuit noted in The University of Notre Dame case, *supra*, 217 USPQ at 509 that "Notre Dame" was not a term uniquely associated with the University, as it also served to identify the famous Cathedral in Paris, and therefore the term could name a persona other than the University. However, the Court went on to explain:

This conclusion could be changed if the evidence showed that Gourmet intended to identify the University, as the university argues. Evidence of such intent would be highly persuasive that the public will make the intended false association. The defense that the result intended was not achieved would be hollow indeed.

Although the Automobile Club's submission of evidence in this case is not overwhelming, when it is coupled with the testimony, and the concessions by two of Bridgestone's witnesses, we find that the record sufficiently establishes that in the United States, the term LE MANS pointed uniquely and unmistakably to the Automobile Club; that the Automobile Club's mark LE MANS and design had achieved fame; and that

there was a connection between pneumatic rubber tires and automobile racing in 1963.

Bridgestone conceded (through the cross-examination of its witnesses Michael Mileski and Michel Bonny) that serious racing enthusiasts in the United States would be aware of the 24-hour Le Mans race, and would associate the term LEMANS on tires with the LE MANS race. Bridgestone's identification of goods in the involved registration (LEMANS) is very broad - "pneumatic rubber tires" - with no restriction as to type of performance tire (e.g., high or low ratings); nor to any particular type of tire (e.g., racing, passenger, or even automobile or tractor); nor to any specific class of consumers (e.g., sports enthusiasts). Therefore, automobile racing enthusiasts are certainly included within the classes of possible relevant purchasers of Bridgestone's LEMANS tires. And this record clearly shows that racing enthusiasts would associate the term LEMANS on tires with the LE MANS race.

We look by analogy to a case decided by the Board regarding the question of genericness, wherein it is stated that if a mark is found to be generic of one or more items of goods in an application, but it is descriptive or suggestive as to other items of goods, then registration is properly refused registration because the term is generic for any of the goods sought to be registered. See In re

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Analog Devices Inc., 6 USPQ2d 1808 (TTAB 1988) [aff'd, in a decision marked not citable as precedent, but published at 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989)]. See also, 2 McCarthy on Trademarks and Unfair Competition, § 11:51 and 12:57 (4th ed. 1999).

Moreover, the record before us shows that Bridgestone, through its promotional efforts, intended to draw a relationship between tires and racing, (e.g., Mr. Mileski's testimony that Firestone created their brand image on early endeavors in automobile racing). We emphasize the Court of Appeals for the Federal Circuit stated evidence relating to such intent is "highly persuasive."

Bridgestone introduced evidence attempting to show that the term LE MANS does not point uniquely and unmistakably to the Automobile Club because the term also refers to such things as the town itself; the town history as the center of invention for the automobile, the steam train, and the airplane; a cathedral; a type of potted pork; the Pontiac LeMans automobile; and even Bridgestone's tires.

Bridgestone contends therefrom that the term LEMANS does not point solely and uniquely to the Automobile Club. This is unpersuasive. Just because the term Le Mans has been used to identify a cathedral, potted pork, the history of the town, and the like simply does not detract from the fact that when the term LE MANS is used on tires, it is uniquely

and unmistakably associated with the very famous automobile race. We take the term "solely," as used in prior case law, to mean in the context of the relevant goods or services (i.e., tires), not in the context of absolutely no other possible meaning or connotation. Cf. *In re McIlhenny Co.*, 278 F.2d 953, 126 USPQ 138 (CCPA 1960); *Ex parte Haig & Haig, Ltd.*, 118 USPQ 229 (Asst. Comm. 1958); and *In re E S Robbins Corp.*, 30 USPQ2d 1540 (TTAB 1992). Thus, the fact that a term may have even one other meaning does not automatically negate the term pointing uniquely and unmistakably to one "persona" or "identity" within the meaning of Section 2(a) of the Trademark Act.

While we acknowledge that the existence of the Pontiac LeMans car may have bolstered Bridgestone's defense in this case, Bridgestone presented no specific evidence to show exactly which years that car was produced, nor the amount of sales or advertising to show the exposure to the purchasing public, especially in relation to the relevant time frame around 1963.

In summary, the record before us establishes that the term LEMANS points uniquely and unmistakably to the Automobile Club, and that the Automobile Club's race is of sufficient fame or reputation that when Bridgestone's mark LEMANS is used on tires, a connection with the Automobile Club would be presumed. We find that this was true as of

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1963, the registration date of Registration No. 756,436,
forty years after the LE MANS race was first run.

Decision: The counterclaim petition to cancel is
granted, and Registration No. 756,436 will be cancelled in
due course.

E. W. Hanak

T. J. Quinn

B. A. Chapman
Administrative Trademark Judges,
Trademark Trial and Appeal Board