

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

12/12/00

Hearing:
June 27, 2000

Paper No. 69
JQ

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Michelin North America, Inc.
v.
Max-Trac Tire Co., Inc.

Opposition No. 103,919
to application Serial No. 75/013,863
filed on November 2, 1995

Steven R. Gustavson of Baker Botts for Michelin North America, Inc.

Meredith Wilkes, Timothy P. Fraelich and Robert C. Kahrl of Jones, Day, Reavis & Pogue for Max-Trac Tire Co., Inc.

Before Quinn, Bottorff and Rogers, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Max-Trac Tire Co., Inc. to register the mark MTX for "tires."¹

Registration has been opposed by Michelin North America, Inc. under Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to

applicant's goods, so resembles opposer's previously used family of X marks for tires as to be likely to cause confusion.² Opposer claims ownership of the following previously registered marks: X for "tires;"³ MXV for "pneumatic tires and tubes for vehicle wheels;"⁴ MXT for "pneumatic tires and tubes for vehicle wheels;"⁵ MX for "pneumatic tires, tubes for vehicle wheels and treads for retreading tires;"⁶ MXX for "tires for vehicle wheels;"⁷ LTX for "tires;"⁸ and MXV4 for "tires."⁹

Applicant, in its answer, denied the salient allegations of the notice of opposition.¹⁰ Applicant

¹ Application Serial No. 75/013,863, filed November 2, 1995, alleging first use anywhere on October 4, 1995 and first use in commerce on October 23, 1995.

² Opposer also alleged that applicant's mark falsely suggests a connection with opposer under Section 2(a). Opposer did not pursue this issue at trial and, indeed, opposer's brief on the case does not mention this claim. Accordingly, the Section 2(a) claim is considered to be waived.

³ Registration No. 558,774, issued May 13, 1952; renewed.

⁴ Registration No. 1,577,670, issued January 16, 1990; renewed.

⁵ Registration No. 1,584,546, issued February 27, 1990; renewed.

⁶ Registration No. 1,778,838, issued June 29, 1993; combined Sections 8 and 15 affidavit filed.

⁷ Registration No. 1,786,678, issued August 19, 1993; combined Sections 8 and 15 affidavit filed.

⁸ Registration No. 1,841,295, issued June 21, 1994; combined Sections 8 and 15 affidavit filed.

⁹ Registration No. 1,896,116, issued May 30, 1995; combined Sections 8 and 15 affidavit filed.

¹⁰ Applicant subsequently sought to amend its answer to assert a counterclaim to cancel three of opposer's pleaded registrations on the ground of abandonment. The Board, in an order dated June 2, 1998, denied the motion to amend on the basis that the amendment "would avail applicant of nothing and would be a futile act." Thus, to the extent that applicant, in its final brief, contends that opposer cannot show use of its registered

Opposition No. 103,919

affirmatively states that opposer previously registered the mark MTX for "tires" (Registration No. 1,322,062), but that the registration was canceled for failure to file a Section 8 affidavit of continued use.

The record consists of the pleadings; the file of the involved application; trial testimony, with related exhibits, taken by each party; status and title copies of opposer's pleaded registrations, excerpts from printed publications, discovery depositions, with related exhibits, and discovery responses, introduced by way of opposer's notice of reliance; and discovery depositions made of record in applicant's notice of reliance. The parties filed briefs on the case and both were represented by counsel at an oral hearing held before the Board.

Opposer is engaged in the sale and manufacture of tires. Over the years, opposer has enjoyed significant success. Although a confidentiality agreement prevents setting forth the specifics of opposer's sales and advertising expenditures, suffice it to say that the numbers are substantial. The tires are sold in a variety of retail outlets, including mass merchandise retailers,

mark MXT, the contention cannot be heard in the absence of a counterclaim. We would add that, in any event, opposer's evidence shows sales, albeit small, under the mark.

Opposition No. 103,919

large tire retailers, independent dealers and warehouse clubs. Opposer's tires have been promoted through television and radio, as well as through newspaper and magazine advertisements. Promotional efforts also have included opposer's appearances at trade shows, maintenance of an Internet website, and distribution of point-of-sale materials.

Applicant likewise is engaged in the tire business, but on a much smaller scale. Applicant was founded by Mickey Thompson, a car designer, race promoter and race car driver. Through the years, applicant has used the letters "M" and "T" (signifying, according to applicant, Mickey Thompson's initials) in connection with its tires, which are designed for a niche market, namely four-wheel drive, off-road vehicles and racing cars. Applicant's main promotional efforts are advertisements in trade publications and appearances at trade shows. Applicant also maintains a website and has placed some television ads. Applicant's tires are sold in the usual retail outlets for tires.

In view of opposer's ownership of valid and subsisting registrations for its pleaded marks, there is no issue with respect to opposer's priority. King Candy

Opposition No. 103,919

Co., Inc. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

We now turn to the issue of likelihood of confusion. Our determination under Section 2(d) of the Act is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). These, and other du Pont factors deemed pertinent in the proceeding now before us, are discussed below.

With respect to the parties' goods, for purposes of our likelihood of confusion analysis, the goods are legally identical (i.e., "tires"). It is well settled that in cases such as this one the registrability of an applicant's mark must be evaluated on the basis of the identification of goods set forth in the involved application and the opposer's registration(s) of record, regardless of what the record may reveal about the particular nature of the respective goods. Canadian

Opposition No. 103,919

Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987).

During the course of this proceeding, applicant has gone to great lengths to draw differences between its tires and opposer's tires. Given the legal constraints of Board proceedings indicated above, these differences, for the purposes of this proceeding, are irrelevant. The record shows that applicant specializes in off-road and racing tires. The identification of goods in the involved application is not so limited, however, and we must assume that applicant's tires include the same types of tires sold by opposer.

Further, neither opposer's nor applicant's identification of goods is limited as to classes of consumers or channels of trade. Therefore, we must deem the parties' tires to travel in the same channels of trade and to be sold to the same classes of customers. CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199; and Squirtco v. Tomy Corp., 697 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). In any event, the evidence shows that the parties' tires have been sold in the same retail stores to the same classes of customers. The parties also attend the same trade show every year.

Opposition No. 103,919

Aside from the legal identity between the parties' goods, we note that applicant has touted the "smooth highway ride" of its tires and that its MTX brand tire delivers "all season highway and off-road driving" and that the MTX, "on the street," has a "steel-belted construction for a smoother, more responsive ride, excellent treadwear and minimal highway noise." Excerpts from magazines such as *Open Road* and *Hot Rod* likewise highlight the relatedness between the parties' tires, as for example by showing cars with a combination of opposer's and applicant's tires ("Wheel and tire package includes polished Center Lines surrounded by Michelin fronts and Mickey Thompson rears.").

Applicant urges that "[t]ires are certainly more costly items which implicate greater purchaser care" and that the "typical consumer is likely to inquire and carefully decide which tires to purchase." In response, we would point out that tires for motor vehicles are bought by a wide variety of people, most of whom are ordinary consumers with no special sophistication in the tire field. Although tires play an important role in the safe operation of motor vehicles, consumers generally would be expected to use nothing more than ordinary care

Opposition No. 103,919

in purchasing tires. Applicant failed, in any event, to support its contention with any direct evidence.

We next turn to consider the marks. Opposer has claimed a family of "X" marks comprising the marks X, MXV, MXT, MX, MXX, LTX, and MXV4. As noted above, applicant is attempting to register the mark MTX.

With respect to opposer's claim that it owns a family of marks, we look to our primary reviewing court for guidance:

A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods. Recognition of the family is achieved when the pattern of usage of the common element is sufficient to be indicative of the origin of the family.

J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991). In the past, the Board has looked at whether the marks asserted to comprise a "family" have been used and advertised in promotional material or used in everyday sales activities

Opposition No. 103,919

in such a manner as to create common exposure and, thereafter, recognition of common ownership based upon a feature common to each mark. *American Standard, Inc. v. Scott & Fetzer Co.*, 200 USPQ 457, 461 (TTAB 1978).

We do not view opposer's evidence as establishing that it has a family of "X" marks. While the record includes a few instances where some of the marks have been used together, the evidence is sparse. Moreover, the record is devoid of any direct evidence that purchasers consequently would recognize common ownership based on the letter "X" feature common to each mark. The mere fact of adoption, use and/or registration of several marks with the letter "X," as in the case here with opposer, does not in itself prove that a family of marks exists. *Polaroid Corp. v. Richard Mfg. Co.*, 341 F.2d 150, 144 USPQ 419 (CCPA 1965); and *Consolidated Foods Corp. v. Sherwood Medical Industries, Inc.*, 177 USPQ 279 (TTAB 1973).

Another du Pont factor to consider in comparing the marks is opposer's contention that its marks are famous. Fame is a significant factor in the determination of likelihood of confusion, and can play a dominant role in cases featuring a famous mark. *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453

(Fed. Cir. 1992). There is no question but that opposer has enjoyed great success with some of its tires. As noted earlier, although a confidentiality agreement prevents us from setting forth opposer's sales volume and advertising expenditures, they are, in their entirety, impressive. That is not to say, however, that all of opposer's tires have been success stories. Sales of tires sold under the mark X have been significant, but sales under the marks MX and MXT have been minimal. In sum, we conclude, based on the record before us, that opposer's X mark is well known. Cf: Michelin Tire Corp. v. The General Tire & Rubber Co., 202 USPQ 294 (TTAB 1979)[opposer's X mark for tires is "an exceedingly well-known trademark in the trade and to the general public"]. We cannot conclude, however, that any of the other marks claimed by opposer falls into the same category. The record simply does not support such a conclusion.

Applicant's principal argument in support of its position of no likelihood of confusion centers on the nature and number of third-party uses of "X-formative" marks in the tire trade.¹¹ According to applicant, the

¹¹ Although applicant contends, in its brief, that "[t]here are literally dozens of federally registered trademarks that encompass the letter 'X' to identify tires," no such evidence is of record. In the earlier case of Michelin Tire Corp. v. General Tire & Rubber Co., supra, third-party registrations were

Opposition No. 103,919

"crowded field" militates against finding that confusion is likely to occur between the parties' marks. In connection therewith, applicant introduced testimony and evidence regarding actual third-party uses of "X-formative" designations in the tire industry. The Board has in the past given weight to evidence of widespread and significant use by third parties of marks containing elements in common with the mark being opposed on grounds of likelihood of confusion to demonstrate that confusion is not, in reality, likely to occur in the marketplace. See: *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445, 1462 (TTAB 1987). The justification is, of course, that the presence in marks of common elements extensively used by other unrelated users may cause purchasers to not rely upon such elements as source indicators but to look to other elements as a means of distinguishing the sources of the goods. By relying on third-party uses of "X-formative" designations in the tire industry, applicant would have us conclude that small variations in the marks in the industry, including opposer's and applicant's marks, are sufficient to avoid confusion.

submitted. The Board, in accord with its usual view toward such evidence, gave the third-party registrations limited probative value.

Applicant took the testimony of third-party witnesses, all involved in some capacity in the tire industry, who testified regarding the uses of "X-formative" marks in connection with tires. Although the record also includes evidence of opposer's active policing efforts, the witnesses' testimony reveals a variety of such third-party uses (numbering about 40), and it is impossible to ignore the fact that "X-formative" letter marks have been commonly adopted in the trade. We would add, however, that many of the uses include a word portion in addition to the letter combination. While we have taken this third-party usage evidence into account, and while it certainly is an important factor to consider in this case, its probative value is diminished by the absence of corroborating evidence regarding the extent of use of the third-party designations. Although some of the witnesses alluded to the sale of millions of certain branded tires in the marketplace, and asserted that some of the tires are used as original equipment by automobile manufacturers, the testimony is somewhat vague, with no firm figures given. We agree with opposer's overall assessment that applicant "has simply introduced multiple vague allegations of usage, with no proof of any actual individual sale, much

less of the aggregate figures involved, or the geographic area of any alleged trademark usage." (reply brief, p. 6). We are, therefore, at a disadvantage in gauging whether consumers are able to distinguish between "X-formative" marks based on small differences.

As a final point with respect to the third-party uses, we would add that although all of the uses are in connection with tires, not one is for any of the letter combinations claimed by opposer. In response to an inquiry from the Board at the oral hearing, applicant acknowledged, and the record shows, that applicant's MTX mark is closer in similarity to opposer's MXT mark than is any of the third-party marks.

Inasmuch as a family of marks has not been established, we must compare each of opposer's pleaded marks (X, MXV, MXT, MX, MXX, LTX and MXV4) with the mark sought to be registered (MTX). In doing so, we keep in mind, of course, the renown of opposer's X mark and the evidence of third-party uses of "X-formative" marks in the tire industry. We note at the outset of this portion of the analysis that if the goods are identical, as they are in this case, "the degree of similarity [between the marks] necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v.*

Opposition No. 103,919

Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

We will begin by comparing opposer's MXT mark with applicant's MTX mark because, in our view, this is opposer's mark which is closest to applicant's mark. The marks are substantially similar in appearance and overall commercial impression. Both comprise three-letter combinations, with the only difference being that the second and third letters are reversed. As has been stated in the past, it is more difficult to remember a series of arbitrarily arranged letters than it is to remember words, figures, phrases and the like. *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840, 1841 (Fed. Cir. 1990); *Cluett, Peabody & Co., Inc. v. J.H. Bonck Co., Inc.*, 390 F.2d 754, 156 USPQ 401 (CCPA 1968); and *Edison Brothers Stores, Inc. v. Brutting E.B. Sport-International GmbH*, 230 USPQ 530 (TTAB 1986).¹² The fact that applicant uses its MTX mark in close proximity to the name "Mickey Thompson" is of no

¹² With regard to the respective meaning of the marks, opposer's X marks are derived from the fact that opposer invented the radial tire. This tire had a characteristic construction, that is, the steel belts inside the tire were constructed in a letter "x" fashion. Applicant's mark MTX was derived from its founder's initials "MT" (for Mickey Thompson), and the letter "X" suggested "extreme." Although we accept these meanings advanced by the parties, there is no evidence suggesting that the consuming public would even be aware of them.

Opposition No. 103,919

moment inasmuch as the name is not part of the mark sought to be registered.

Likewise, we find opposer's marks MXX and MXV to be similar in appearance and overall commercial impression to applicant's MTX mark. Again, the marks are similarly constructed with three letters, begin with the same letter, and differ by only one letter.

Opposer's marks X, MX, LTX and MXV4, on the other hand, are sufficiently different from applicant's mark MTX that confusion is unlikely to occur. Even considering the renown of opposer's X mark, we do not believe that the scope of protection of this particular mark extends to prevent registration of applicant's mark, especially given the existence of third-party "X-formative" marks in the tire industry. As to the marks MX, LTX and MXV4, we find that the differences in appearance, coupled with the existence of the third-party uses, eliminates the likelihood of confusion. Opposer's MX mark comprises only two letters as opposed to applicant's three letter mark. The mark LTX differs significantly from applicant's mark MTX in that the first letter (i.e., the one most likely to be remembered by consumers) is different. The MXV4 mark is a four

Opposition No. 103,919

character mark which contains the portion V4 which is not similar to any letters in applicant's mark, thereby creating a different commercial impression when the marks are compared in their entireties.

With regard to applicant's reliance on the absence of actual confusion, it may well be that the actual nature of applicant's tires, that is, tires for a small niche market of car enthusiasts, effectively eliminates the likelihood of confusion in the marketplace. However, as previously noted, our analysis must be based upon the goods as described in the application and the pleaded registrations. Further, evidence of actual confusion is difficult to ascertain, and the applicable test is the likelihood of confusion. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983).

We conclude that purchasers familiar with opposer's tires sold under the marks MXT, MXX and MXV would be likely to believe, upon encountering applicant's mark MTX for tires, that the goods originated with or are somehow associated with or sponsored by the same entity. We find no likelihood of confusion with respect to opposer's marks X, MX, LTX and MXV4 and applicant's mark MTX.

Opposition No. 103,919

Decision: The opposition is sustained to the extent indicated above, and registration to applicant is refused.