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Paper No. 12  
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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re The Yokohama Rubber Co., Ltd.

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Serial No. 75/516,756

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**Curtis B. Hamre** of Merchant & Gould P.C. for The Yokohama Rubber Co., Ltd.

David H. Stine, Trademark Examining Attorney, Law Office 114 (**Margaret Le**, Managing Attorney).

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Before Seeherman, Hairston and Chapman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On July 10, 1998, The Yokohama Rubber Co., Ltd. filed an application to register the mark shown below

for "tires for all vehicles." The application is based on applicant's assertion of a bona fide intention to use the mark in commerce.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the

ground that applicant's mark, when applied to its identified goods, would so resemble the registered mark IT510 for "tires"<sup>1</sup> as to be likely to cause confusion, mistake or deception.

When the refusal was made final, applicant appealed. Briefs have been filed, but an oral hearing was not requested. We reverse the refusal to register.

The parties' respective identified goods are identical, both being tires. Also, identical goods would certainly travel through all the same channels of trade to all the usual purchasers. See *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994).

However, applicant contends that the purchasers are sophisticated, that tires are relatively expensive, and that buying tires is not an impulse purchase, with purchasers investigating what tires to buy in advance (e.g., manufacturers, composition) or taking into consideration the recommendation of professionals in the industry. Therefore, it is applicant's position that the differences in the marks will be noted, and that these differences are sufficient to distinguish the marks.

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<sup>1</sup> Registration No. 2,003,648, issued September 24, 1996 to The Goodyear Tire & Rubber Company. The claimed dates of first use and first use in commerce are February 8, 1995.

The Examining Attorney argues that applicant's assertions regarding the conditions of purchase and consumer sophistication are unpersuasive because "tires are a relatively basic and routine purchase item," (brief, p. 4) commonly purchased by the general public, who will be more concerned with price and convenience.

While tires are purchased by the general public, nonetheless, tires are not inexpensive, and they are not generally purchased on "impulse," nor are they frequently replaced goods. Tires must be matched with the particular vehicle, and thus, some degree of knowledge or care must be exercised, i.e., the individual consumer must have this knowledge or the consumer must seek the advice of a professional for assistance. Therefore, although the fact that the goods are identical is a factor which favors a finding of likelihood of confusion, in this case, the conditions under which the purchases are made is a factor favoring a finding of no likelihood of confusion.

Turning to a consideration of the involved marks, applicant contends that the marks have "totally dissimilar overall visual impact" (brief, p. 2), with registrant's mark consisting of a combination of letters and numbers while applicant's mark is a stylized mark consisting of the letter "i" with a star design, a slash, and the letter "T";

and that the Examining Attorney dissected the marks, instead of considering the marks as a whole.<sup>2</sup>

The Examining Attorney contends that the dominant, literal portion of both marks is "IT"; that the common feature of both marks is the arbitrary letter combination "IT"; and that both marks create the same overall commercial impression, especially when considered in the context of the general rather than specific impression in consumers' memories.

Because applicant's mark is essentially a stylized letter mark, the degree of stylization affects the overall visual impact of the involved marks. The Court of Appeals for the Federal Circuit addressed this type of situation in *In re Electrolyte Laboratories Inc.*, 913 F.2d 930, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) as follows:

There is no general rule as to whether letters or design will dominate in

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<sup>2</sup> Applicant also argues in its brief that the letters "IT" are commonly used in the tire industry, such that the "IT" in registrant's mark must be considered a weak element. Applicant attached photocopies of five third-party registrations to its brief. Although the copies were untimely filed by applicant, the Examining Attorney did not object thereto, and treated the registrations as being of record. Thus, we consider the Examining Attorney to have stipulated the third-party registrations into the record. However, these third-party registrations do not establish that "IT" is a weak element of registrant's mark because none of these marks contain the element "IT" per se. Rather, the marks are INDEPENDENT TIRE DEALER BUYING GROUP ITD OUR VOLUME SAVES YOU MONEY! and design for retail tire store services, ITL, RIMFIRE XT, and VERSA TRAC LT, all for tires, and TIRE-TELE and design for electronic tire condition sensors.

composite marks; nor is the dominance of letters or design dispositive of the issue. No element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone. ...

...[T]he spoken or vocalizable element of a design mark, taken without the design, need not of itself serve to distinguish the goods. The nature of stylized letter marks is that they partake of both visual and oral indicia, and both must be weighed in the context in which they occur.

...[E]ven if the letter portion of a design mark could be vocalized, that was not dispositive of whether there would be likelihood of confusion. A design is viewed, not spoken, and a stylized letter design can not be treated simply as a word mark.

In this case we agree with applicant that these marks, when considered in their entireties, are different in appearance and create different commercial impressions. Registrant's mark is a typed combination of two letters and three numbers, shown as a typed drawing, whereas applicant's mark is a composite mark consisting of three distinct characters, with a star design and overall stylized lettering. Applicant's mark is so highly stylized it is questionable how the purchasing public would perceive the mark. Although the "IT" in applicant's mark can be pronounced (if it is perceived by the purchasing public as

"IT"), the numbers and designs in the respective marks are substantially different therefrom.

Based on the dissimilarity of the appearance and the commercial impressions of these marks, as well as the conditions of sale and sophistication of purchasers, we cannot find on this record that likelihood of confusion has been shown. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). However, we point out that we have reached this decision based on the ex parte record herein. We express no view on what the Board might find in the context of an inter partes proceeding.

**Decision:** The refusal to register under Section 2(d) is reversed.