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Paper No.10
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Toyo Tire & Rubber Co., Ltd.**

Serial No. 76/**313,168**

Leigh Ann Lindquist and Gary D. Krugman of Sughrue Mion, PLLC
for **Toyo Tire & Rubber Co., Ltd.**

John T. Lincoski, Trademark Examining Attorney, Law Office 113
(Odette Bonnet, Managing Attorney).

Before **Simms, Hohein and Holtzman**, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Toyo Tire & Rubber Co., Ltd. has filed an application
to register the mark "NITTO TERRA GRAPPLER" for "tires and inner
tubes for vehicles."¹

¹ Ser. No. 76/313,168, filed on September 17, 2001, which is based on an allegation of a bona fide intention to use the mark in commerce. Among other things, applicant claims ownership of Reg. No. 855,563, issued on August 27, 1988 and renewed, for the mark "NITTO" for "vehicle tires and tubes".

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 goods, so resembles the mark "GRAPPLER," which is registered for "vehicle tires,"² as to be likely to cause confusion, or to cause mistake, or to deceive.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity of the goods and the similarity of the marks.³ Here, inasmuch as it is obvious and applicant admits that the respective goods (vehicle tires) are legally identical products, the focus of our

² Reg. No. 966,488, issued on August 21, 1973, which sets forth a date of first use anywhere and in commerce of February 7, 1972; renewed.

³ The court, in particular, pointed out that: "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."

inquiry is on whether the marks at issue are so similar that their contemporaneous use would be likely to cause confusion as to the source or sponsorship of the respective goods.

Applicant argues that, when considered in its entirety, its mark "is dominated by the NITTO TERRA portion of the mark" because such portion, being "the first portion of the mark a purchaser would encounter[,] ... is likely the portion a consumer would remember." Applicant further asserts that the word "GRAPPLER," which is the sole term that its mark has in common with registrant's mark, "is a relatively weak and highly suggestive term" because, "[a]s applied to vehicle tires, GRAPPLER suggests the tire's ability to grip the road and have good traction." In consequence thereof, applicant insists that registrant's "GRAPPLER" mark "is a weak mark entitled to a narrow scope of trademark protection" which does not extend to include applicant's "NITTO TERRA GRAPPLER" mark. Specifically, applicant maintains that "the addition of other matter to the term 'GRAPPLER,' such as NITTO TERRA as in applicant's mark, will distinguish the marks from one another in the minds of the consuming public."

Applicant also contends that the different numbers of words and syllables contained in the respective marks "further distinguishes Applicant's mark from the mark in the cited registration." Applicant accordingly concludes that, "when

compared side-by-side,"⁴ such marks "should not be viewed as confusingly similar" because they "appear different, are pronounced differently and create separate commercial impressions."

The Examining Attorney, on the other hand, takes the position that the marks at issue "are highly similar and create the same commercial impression." In particular, the Examining Attorney notes that applicant's mark incorporates registrant's mark in its entirety and argues that the additional matter in applicant's mark is not sufficient to preclude a likelihood of confusion inasmuch as such mark is dominated by the term "GRAPPLER." The reason therefor, according to the Examining Attorney, is in part that consumers, as applicant concedes in its reply brief, would regard the term "NITTO" as a house mark⁵ and would view the phrase "TERRA GRAPPLER" in applicant's mark

⁴ It is pointed out, however, that a side-by-side comparison is not the proper test to be used in determining the issue of likelihood of confusion inasmuch as it is not the ordinary way that customers will be exposed to the marks. Instead, it is the similarity of the general overall commercial impression engendered by the marks which must determine, due to the fallibility of memory and the concomitant lack of perfect recall, whether confusion as to source or sponsorship is likely. The proper emphasis to keep in mind is accordingly on the recollection of the average purchaser, who normally retains a general rather than a specific impression of marks. See, e.g., *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973); *Envirotech Corp. v. Solaron Corp.*, 211 USPQ 724, 733 (TTAB 1981); and *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

⁵ Specifically, applicant admits that its mark "includes its well-known house mark NITTO" and that "NITTO is a well-known registered mark that consumers recognize."

as identifying "one product under the 'NITTO' umbrella."⁶ In view thereof, and citing dictionary definitions of the terms "terra" and "grappler,"⁷ the Examining Attorney further contends that (footnote omitted):

While "TERRA GRAPPLER may be meant to be read together, the term "TERRA" is weak with regard to the goods. As shown in the attached definitions, "terra" is the Latin word for "earth," and it remains in common usage today either alone or in such phrases as "terra firma" and "terra incognito." As such, consumers will readily translate the term as being equivalent to "earth" when viewing the mark. "Terra" or "earth" is weakly suggestive when used with regard to vehicle tires because [those] goods are meant to come into contact with [the] earth and traverse it. The addition of "terra" to the mark therefore adds little additional meaning.

"GRAPPLER," on the other hand, is a much more distinctive term. As a noun, it is synonymous with a wrestler, a combatant

⁶ Stated a bit differently, the Examining Attorney urges that "those viewing the [applicant's] mark are likely to insert a mental pause between 'NITTO' and 'TERRA GRAPPLER,' in essence reading the mark as 'TERRA GRAPPLER' by 'NITTO.'"

⁷ Although a definition of the word "grappler" as meaning "grapple" was made of record with the final refusal, in his brief the Examining Attorney has requested that the Board take judicial notice of various definitions of the term "terra." While applicant, in its reply brief, has objected thereto on the ground that such evidence is technically untimely under Trademark Rule 2.142(d), the definitions have been considered inasmuch as it is settled that the Board may properly take judicial notice of dictionary definitions. See, e.g., *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 860 n. 7 (TTAB 1981).

or one who struggles. Given these meanings, the term is clearly fanciful with regard to tires and inner tubes. As such, it carries a much greater punch than "terra" and dominates the phrase "TERRA GRAPPLER."

The Examining Attorney also asserts that "applicant's argument that the term 'GRAPPLER' is weak with regard to the goods [at issue] is belied by the registrations provided in the final action," noting that of the seven registrations made of record which consist of or contain such term, only the cited registration is for goods in the same field as those of applicant. Thus, according to the Examining Attorney, "the term 'GRAPPLER' is clearly not diluted with regard to vehicle tires" and "is highly distinctive and fanciful with regard to the goods." In consequence thereof, the Examining Attorney maintains that "the registrant's mark is entitled to a greater degree of protection than it would be if 'GRAPPLER' was a weak mark."

Based on such considerations, the Examining Attorney concludes that:

[W]hile the applicant's mark contains elements not found in the registered mark, the differences are not sufficient to preclude a likelihood of confusion. Those who encounter both the applicant's "NITTO TERRA GRAPPLER" tires and inner tubes and the registrant's "GRAPPLER" tires would likely believe that the "GRAPPLER" tire is part of the NITTO product line or that the registrant produced the applicant's goods. While the marks may share some visual

dissimilarities, they share the same term -- "GRAPPLER -- and [substantially] the same connotation. In total, the differences between the marks at issue, when considered in their entirety, are not sufficient to preclude the likelihood that the contemporaneous use of those marks will result in confusion or mistake or deception.

We agree with the Examining Attorney's conclusion that confusion is likely. As set forth in TMEP Section 1207(b)(iii):

It is a general rule that likelihood of confusion is not avoided between otherwise confusingly similar marks merely by adding ... a house mark or matter that is descriptive or suggestive of the named goods or services. See, e.g., ... *In re Apparel Ventures, Inc.*, 229 USPQ 225 (TTAB 1986) (SPARKS BY SASSAFRAS (stylized) for clothing held likely to be confused with SPARKS (stylized) for footwear); ... [and] *In re Riddle*, 225 USPQ 630 (TTAB 1985) (RICHARD PETTY'S ACCU TUNE and design for automotive service stations held likely to be confused with ACCUTUNE for automotive testing equipment).

Exceptions to the above stated general rule regarding additions ... to marks may arise if: (1) the marks in their entirety convey significantly different commercial impressions, or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted.

In this case, applicant has in essence simply added its house mark "NITTO" and the suggestive term "TERRA" to registrant's "GRAPPLER" mark. The mark "NITTO TERRA GRAPPLER," however, when considered in its entirety, does not convey such a significantly different commercial impression from that

projected by registrant's "GRAPPLER" mark that, when used in connection with vehicle tires, confusion as to the origin or affiliation of such goods would not be likely. In particular, irrespective of whether the term "GRAPPLER" is the dominant part of applicant's mark, it clearly is a significant component thereof which is neither descriptive of tires for vehicles nor shown to be so extensively used by others in connection therewith as to be diluted in terms of its source-indicative capacity.

Moreover, while the relevant definitions of record from The American Heritage Dictionary of the English Language (3rd ed. 1992) show that the word "grappler" possesses some suggestiveness when used in connection with vehicle tires inasmuch as it is defined as noun meaning "1. a. An iron shaft with claws at one end, usually thrown by a rope and used for grasping and holding 2. The act of grappling," with the term "grappling" in turn listed as a verb connoting "1. To seize and hold, as with a grapple. 2. To seize firmly, as with the hands,"⁸ it is not so weak that customers for applicant's goods would be unlikely to perceive the word "GRAPPLER" as a significant source-distinguishing element of applicant's "NITTO

⁸ As mentioned by the Examining Attorney, the word "grappler" also has a wrestling connotation in that the same dictionary indicates that, as a noun, such word signifies "3. Sports. a. A contest in which the participants attempt to clutch or grip each other. b. A grasp or grip

TERRA GRAPPLER" mark. Furthermore, the presence of the terms "NITTO" and "TERRA" does not serve to change or otherwise appreciably alter the connotation of the word "GRAPPLER" in applicant's mark because, as the Examining Attorney has pointed out, the term "TERRA" would be perceived as meaning "earth," which is something that tires may "grip" or "grasp" to provide traction," while the term "NITTO" would be regarded, as applicant concedes, as a house mark for its goods. Consequently, the word "GRAPPLER" in applicant's mark has essentially the same connotation as does such word when used as registrant's mark.

We therefore conclude that, due to the shared term "GRAPPLER," it is the case that the respective marks, when considered in their entirety, are so substantially similar in sound, appearance, connotation and general commercial impression that, when used on legally identical goods, confusion as to source or sponsorship thereof would be likely. In particular, customers for vehicle tires who are familiar or acquainted with registrant's "GRAPPLER" mark are likely to believe, upon encountering tires for vehicles under applicant's substantially similar "NITTO TERRA GRAPPLER" mark, that the latter are part of the same product line as those of the former.

in such a contest," while as a verb it denotes "3. To struggle, in or if in wrestling"

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Decision: The refusal under Section 2(d) is affirmed.