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THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 9/11/98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

The Goodyear Tire and Rubber Company
v.
Interco Tire Corporation

Opposition No. 96,404 to application Serial No. 74/279,000
filed on May 27, 1992

Albert Robin and Howard B. Barnaby of Robin, Blecker, Daley &
Driscoll for The Goodyear Tire and Rubber Company.

Edward J. Kondracki and Joseph S. Presta of Kerkam, Stowell,
Kondracki & Clark, P.C. for Interco Tire Corporation.

Before Cissel, Hanak and Hohein, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Interco Tire Corporation has filed an application to
register the tread design reproduced below

as a trademark for "tires".¹ Registration on the Principal Register is sought on the basis that the tread design, which the parties in this proceeding refer to as a "three-stage lug" design or configuration, has acquired distinctiveness.

The Goodyear Tire and Rubber Company has opposed registration on the grounds that, since long prior to applicant's alleged date of first use of its tread design on October 3, 1977, opposer "has been and now is engaged in the manufacture, offering for sale and sale of tires"; that opposer "uses a number of different tread designs on the tires which it manufactures, most of which tread designs are primarily functional in nature"; that, "[a]s a manufacturer of tires, opposer is in position to use on its tires tread designs which are the same as or similar to those depicted in applicant's [a]pplication ... in order to benefit from their functional advantages"; that, on information and belief, "other tire manufacturers have used tread designs which are the same as or similar to that shown in [the application] ... in order to obtain the functional advantages provided by such tread designs"; that "[s]ince the tire tread design which applicant seeks to register is de jure functional, it cannot serve a source-identifying function"; that registration thereof "would be inconsistent with the rights of ... others in the tire industry to use treads of the same or similar design for their functional advantages"; and that inasmuch as "[t]he evidence

¹ Ser. No. 74/279,000, filed on May 27, 1992, which alleges a date of first use anywhere of October 3, 1977 and a date of first use in commerce of October 25, 1977. It is also stated in the application that: "The stippling in the mark is for shading purposes only."

submitted by applicant [with its application] to support its claim of acquired distinctiveness is insufficient on its face," applicant "has failed to prove that the tire tread design shown [in its application] ... has acquired distinctiveness".²

Applicant, in its answer, has denied the salient allegations of the notice of opposition.³

The record includes the pleadings; the file of the opposed application; and, as opposer's case-in-chief, the testimony, with exhibits, of Michael A. Kolowski, chief engineer of opposer's advanced tire design section for multi-purpose vehicles, and Thomas P. Lewandowski, a tire patent attorney in opposer's legal department. Applicant, as its case-in-chief, submitted a notice of reliance on opposer's answers to certain of applicant's first set of interrogatories; copies of the declarations filed with its involved application in support of its claim of acquired distinctiveness;⁴ and the testimony, with

² Although opposer has also set forth, as a separately stated ground for opposition, that applicant's "tire tread design ... does not serve among the relevant universe to identify the source of applicant's tires and distinguish them from tires made or sold by others," such allegation would appear to be simply another way of asserting the claim that applicant's tire tread design is unregistrable because, as a de facto functional design, it lacks distinctiveness. Such ground will accordingly be so construed.

³ While applicant has also alleged what it asserts to be various affirmative defenses, such "defenses" are not, properly speaking, affirmative defenses and thus will not be given further consideration.

⁴ Applicant's motion on consent for the stipulated entry thereof, without authentication and after the close of testimony periods, is granted. Such declarations are from applicant's president and three independent tire sellers.

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exhibits,⁵ of Warren L. Guidry, applicant's president, and Nick Pathiakakis, an operator of a mail-order 4-wheel drive accessories business, which includes the sale of tires, and a former owner of a retail shop specializing in such accessories.⁶ Opposer, in rebuttal, filed a notice of reliance upon copies of a magazine devoted to 4-wheel drive and off-road vehicles, a tire tread design patent and a tire tread utility patent.⁷ The parties also furnished, as rebuttal testimony for opposer, stipulated testimony from Stephanie C. Brown, an employee of opposer's tire engineering staff, and stipulated testimony and accompanying exhibits from Randy L. Hershey, a photographer employed by opposer. In addition, the parties filed, as surrebuttal testimony for applicant, stipulated testimony and related exhibits from applicant's president.⁸ Briefs have been filed and an oral hearing, attended by counsel for the parties, was held.

⁵ Applicant's uncontested request for substitution of its Exhibit Nos. 3 through 20 and opposer's Exhibit Nos. 2, 5 and 6, due to the court reporter having erroneously labeled such exhibits as pertaining to a related opposition involving applicant rather than this proceeding, is approved.

⁶ Applicant's uncontested requests for substitution of photographs for certain bulky exhibits introduced during the testimony depositions of its witnesses are granted.

⁷ Opposer's motion on consent for leave to file such notice outside of its rebuttal testimony period is granted.

⁸ Although the Board's rules of practice do not provide for the submission of surrebuttal evidence, we have considered such since the parties have so stipulated.

The issues to be determined are whether applicant's three-stage lug tire tread design is de jure functional and, if not, whether such design has acquired distinctiveness.⁹

According to the record, opposer is one of the three main tire manufacturers in the United States. Opposer currently sells two tires, known as the "Wrangler MT" and "Workhorse Extra Grip," which are each categorized, like applicant's subject tire, as a mud tire. Neither of such tires, however, has a tread design which is the same as or similar to applicant's three-stage lug design. One of opposer's witness, Mr. Kolowski, in fact admitted that applicant's subject design is clearly distinct in appearance from the tread designs on opposer's two mud tires. Opposer, moreover, is not aware of any tire tread designs which it has manufactured or sold which are the same as or similar to the three-stage lug configuration which applicant seeks to register.

The testimony of Mr. Kolowski indicates that the function of the tire tread design which applicant seeks to register is, generally speaking, that of a typical "off-road" tire and, in particular, that of a "mud area" tire. (Kolowski dep. at 7.) Applicant's specific design is one of "a very open tire" in that the "material hitting the road is low compared to most other types of tires." (Id. at 7-8.) The shoulder area of applicant's design has "very lateral functional elements that

⁹ It is well settled that "[e]vidence of distinctiveness is of no avail to counter a de jure functionality rejection" or claim. In re R.M. Smith, Inc., 734 F.2d 1482, 222 USPQ 1, 3 (Fed. Cir. 1984).

help in traction, especially deep type traction like mud," while the centerline elements, which provide directional stability, "go more circumferential" to "give ... a more directional type feel". (Id. at 8.) In particular, the chevrons which form the "centerline rows or elements" of applicant's tread design and which "help the tire [to] have directionality" and give it "some traction features" as well, are a common shape for the centerline treads on tires. (Id. at 10.) Mr. Kolowski, in fact, has seen similar chevron shapes in the centerlines of other tires.

As to the other treads on applicant's design, namely, the shoulder area lugs, Mr. Kolowski noted that such features are "basically lateral ... to get traction in deep stuff in the forward direction". (Id. at 11.) The reason why "[t]here is a lot of void between the [lug] elements ... is so that stuff such as mud ... does not stick in that area" and cause a loss of traction. (Id.) The need for variation in the size of the lugs is due to "pitching" considerations since, when a tire is rotating, "if the size of a lug or even the design of an element in a rib remain[s] constant, the tire would have at one peak a tremendously high frequency or noise generation." (Id.) To avoid such, tire designers "jumble or scramble the tread, so that a tread design is basically always made up of at least three different size elements."¹⁰ (Id. at 12.) Pitching, in fact, is

¹⁰ Although Mr. Kolowski also testified that he was "sure" that opposer has used the same pattern of lug sizes as featured in applicant's design (Kolowski dep. at 14), no examples thereof were produced and, as previously noted, an interrogatory answer by opposer indicates that it is not aware that any of the tire tread designs which it has

a noise abatement feature common to most tire tread designs, including applicant's subject design.

Similarly, as stated in a review which appeared in the July 1983 issue of 4-Wheel & Off-Road magazine, applicant's "Super Swamper TSL" tire, which features the subject tread design, "was designed for one thing: mud." The review also points out that:

From the standpoint of what a mud tire must accomplish, the TSL displays an intelligent design concept. TSL stands for three-stage lug, a design that incorporates three alternating lug sizes and corresponding gaps The tall, massive lugs and wide-open lug gaps provide excellent directional traction, digging deep into the slush for more solid footing. As the tread bites, it picks up huge chunks of mud that, due to their sheer weight and mass, are easily thrown as the tire revolves. Self-cleaning characteristics are important in mud tires, and the TSL rates very high.

Staggered between these big lugs are medium and small lugs. By alternating the lug (and lug gap) size, harmonic resonance is dampened and tire noise is reduced. By integrating small and large lugs, the tire can lay down more lugs on the surface at one time. With more lugs on the ground, traction is increased. Finally, staggering the lug size better distributes the punishing leverage created by a wide-open design.

Although the TSL's mud performance was impressive, we were surprised at how well it performed overall. Its protruding sidewall lugs were especially functional in hard-packed snow and ice.

Likewise, one of applicant's earliest brochures, which appeared in 1982 in conjunction with applicant's introduction of

manufactured or sold are the same as or similar to the three-stage lug configuration which applicant seeks to register.

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the current version of its "Super Swamper TSL" tire, touts the three-stage lug design as a "tread concept [which] offers unsurpassed traction" and asserts that "[n]ine years of testing and developing have produced the ultimate tire tread design featuring a uniquely arranged short, intermediate, and long lug, each proportioned and spaced to dig deep and self-clean rapidly." Such brochure, which is applicant's Exhibit 13, states in particular that its "tires are designed for maximum traction and rapid cleaning at minimum RPM (Revolutions Per Minute)" and also claims that applicant's subject design "offers increased mileage"; provides "a quieter, smoother ride, [with] less rolling resistance, and tougher sidewalls"; and "gives ... a tire that is both directionally and laterally stable."

While opposer, in addition, introduced a copy of U.S. Patent No. 5,259,429, issued to a third party on November 9, 1993, for what is described in the abstract thereof as "[a]n all terrain vehicle tire [which] has an improved tread including primary lugs arranged in sets equally spaced around the periphery of the tire on each side of the tire centerline with each set including a long lug, at least one intermediate lug and a short lug, with the sets on opposite sides of the centerline being offset substantially one half the pitch of the lug sets," the tread design which is shown in such utility patent, although nominally a three-stage lug design, is strikingly different in appearance from applicant's three-stage lug configuration and there is nothing of record which indicates that the patented

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design is actually in use. Moreover, as the utility patent shows and Mr. Kolowski conceded on cross-examination, the tread design on mud tires can present a variety of appearances.

In addition, Mr. Kolowski noted that from 1995 to 1996, opposer produced about "half a dozen" all-terrain tire tread designs (*id.* at 29); that in the ten years prior thereto, it produced some 12 to 15 tire tread designs for all-terrain tires; and that all of such designs were distinct from applicant's subject design. The record also reflects that opposer has received numerous design patents for various tire tread designs and that none of such designs resembles applicant's three-stage lug design. In fact, the record reveals that there are many alternative tread designs which are in use by competitors for mud and other types of tires.

Mr. Kolowski further admitted that, unlike design patents for tires, which typically pertain only to the ornamental appearance or design of a tread pattern, utility patents for tires generally are directed to the function of the tire tread. Applicant, however, has not sought utility patent protection for either its three-stage lug or its two-stage lug tread designs, although it did own a design patent for the former, covering the ornamental design depicted below,

which expired after 14 years on October 13, 1995.¹¹

One of applicant's witnesses, Mr. Guidry, acknowledged that the traction characteristics of applicant's subject tire tread pattern are affected by both the dimensions and spacing between the lugs and that the pitch or width thereof is used for noise abatement. On cross-examination, Mr. Guidry also confirmed that the previously mentioned review from the July 1983 edition of 4-Wheel & Off Road magazine was correct in stating that the subject tread design featured on applicant's "Super Swamper TSL" tire provides excellent traction (although such tire is not a directional tire). While he further agreed with the statement therein that, by alternating the lug (and lug gap) size, harmonic resonance is dampened and tire noise is reduced, he noted that "all tires do that." (Guidry dep. at 38.) However, Mr. Guidry expressed the opinions that, on the whole, the review was "pretty poorly written"; that whoever wrote it did not have a good understanding of tires; and that he could not say that the review was otherwise accurate. (Id.) Nevertheless, as to the statements noted previously from applicant's Exhibit 13, Mr. Guidry agreed that the statements in that 1982 brochure, like those in its other brochures of record, are accurate.

¹¹ U.S. Patent Des. No. 261,257, issued on October 13, 1981, which states that the figure shown above "is a perspective view of a tire showing" a new ornamental design, "it being understood that the tread pattern is repeated throughout the circumference of the tire as shown schematically by solid lines, the opposite side being the same as that shown".

Furthermore, with respect to the functionality of applicant's three-stage lug design, applicant's other witness, Mr. Pathiakis, confirmed on cross-examination that the "Super Swamper TSL" tire which bears applicant's subject tread pattern "was designed to be a mud tire" and is purchased for such purpose, although some of his customers also utilize them as "show tires". (Id. at 34.) The function of the overhanging or protruding lugs in applicant's design, he admitted, is "for a traction purpose," while the use of three differently sized lugs, he believes, is to reduce tire noise. (Id. at 35.) Similarly, Mr. Guidry acknowledged on cross-examination that the function of the protruding or overhanging lugs on the sidewall of applicant's various "Super Swamper" tires is to provide extra traction as well as to protect the sidewall.

Mr. Pathiakis testified on direct examination, however, that tires with applicant's subject design do not provide better traction, noting that "on the other vehicles that I drive and have sold them to, they don't seem to be any better in mud than most of these other tires that are available." (Pathiakis dep. at 25.) The significance of the lugs as shown in applicant's subject design, Mr. Pathiakis added, is "mainly more for looks than anything else," resulting in what he characterized as an "overly aggressive, almost alien-like looking tire." (Id. at 26.) Mr. Pathiakis admitted, however, that he is not familiar with the term "pitching" as it relates to tire engineering since he "is not that far into the manufacturing and designing of a tire." (Id.) Nevertheless, he also indicated that "in the mud

design or heavy lug pattern" category of tires, "there's probably ... at least a hundred" alternative designs available, all of which to him are distinctly different in appearance from applicant's subject design. (Id. at 30.) In fact, he testified that he "is not aware of anybody that has copied that pattern." (Id. at 32.) Mr. Pathiakis reiterated, on cross-examination, his opinion that applicant's three-stage lug tread design is "not any better in the mud than any other tire out there. It doesn't perform any better." (Id. at 39.)

Under cross-examination, Mr. Guidry similarly insisted that the purpose behind the third lug in applicant's subject tread pattern was to create a design which "was uniquely different" in appearance since "[t]he industry had nothing like it." (Guidry dep. at 35.) While conceding that "[a]ll treads serve some degree of function or we wouldn't put them on the tire," Mr. Guidry indicated that, as to applicant's three-stage lug concept, he could not say that it "serves a function more or less than any other tread." (Id.) Also, while applicant's "Super Swamper" tires are the only tires with a three-stage lug design in the marketplace, Mr. Guidry could not say that such tires are the best performing tires of their type. Instead, Mr. Guidry stated that while he wished that were true, "we get beat pretty regular" by such other brands as "a Gumbo Mudder, ... a Ground Hawg, a Buckshot. Numerous tires beat us." (Id. at 39.)

Furthermore, for tires of similar weight and type of construction, Mr. Guidry testified that applicant's three-stage lug design tires "may be a little more expensive because these

tires take a longer cure time." (Guidry dep. at 27.) Cure time, Mr. Guidry explained, "is a variable that will affect cost" and, thus, tires with applicant's subject design are more expensive to manufacture than comparable tires. (Id.)

Thomas P. Lewandowski, who has knowledge of tread designs used in the tire industry, testified that a periodical publication known as the Tread Design Guide "is an annual collection of tires that are commercial in the industry". (Lewandowski dep. at 10.) Such guide lists and illustrates tires which are actually being sold. A search of copies of the Tread Design Guide for the years 1967, 1968, and 1970 through 1995 for "tires that have similar appearance" to the tread design applicant seeks to register revealed a number of tread designs in use by third parties and which, according to Mr. Lewandowski, would be "the most difficult to distinguish" from applicant's subject design. (Id. at 12 and 14.) The most pertinent of such designs, and the years in which they appeared, are indicated below:

Security Commercial
Traction 1967-1978

Phillips 66 Super
X-T 1976-1979

General Ameri*Lug
1986-1994

Regul Mud King
X/T 1988-1995

Firestone Super All
Traction 1988-1995
(directional model)

Co-op Mud King
X/T 1994-1995

Opposer also introduced photographs of the following two tires, which are illustrated below as they appear in the 1996 edition of the Tread Design Guide, along with testimony that such tires were purchased by Stephanie C. Brown for opposer on October 25, 1996:

Gateway Gumbo Mudder

Gateway Buckshot Radial Mudder

Strictly speaking, however, neither of such tires has chevrons for centerline tread elements like applicant's subject design, although applicant's president claims that the two-stage lug design therein is a copy of the two-stage lug design originally utilized by applicant.

In addition, other excerpts from the 1996 edition of the Tread Design Guide, introduced as applicant's Exhibit 11, reveal that not only are the Regul Mud King X/T, Firestone Super All Traction (directional model) and Co-op Mud King X/T tread designs shown above still in use, but a number of tread designs listed under the heading of "SMALL HIGHWAY & LIGHT TRUCK TIRES," which is the category into which applicant's "Super Swamper TSL"

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tires fall, are akin to applicant's subject design and are in use by third parties. The most relevant thereof are shown below:

Atlas (Canada) Mud
King XT

Brunswick Mud
King XT

Cascade Radial
Mud XT

Cavalier Mud King
XT

Ceat Traction Grip
N.D.

Crown Mud King
X/T

Delta Mud Trac
X/T

Firestone Super
All Traction
(non-directional)

Hood Mud King
XT

Madison Radial Mud
King XT

Medalist Mud King
XT

Miller Mud King
XT

Regul Trailblazer
MT

Spartan Radial Mud
King XT

Stratton Mud King
XT Steel Radial

Applicant, the record shows, is a small family-run tire business which was incorporated in 1975. Its president, Warren Guidry, is the designer of applicant's two-stage lug tires, which were introduced in 1970, and its three-stage lug tires, which were first marketed in October 1977, although the design thereof was completed around 1972 or 1973. Applicant, however, does not manufacture the tires which it sells. Instead, they are made for applicant by Denman Tire Corporation and Specialty Tires of America. Although its application identifies its goods simply as "tires," all of the goods which applicant sells fall into the category of light truck tires. Moreover, while applicant's tires are primarily directed to the "entire market" for 4-wheel drive vehicles, that market is composed of such segments as show trucks, other competition trucks, and general or utility service trucks, which include farm and other commercial vehicles.

According to the declaration submitted by Mr. Guidry in support of the contentions in applicant's application that its

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three-stage lug tire tread design is not de jure functional and that such design has acquired distinctiveness, the tread pattern for which applicant seeks registration "*is one of dozens of many possible tire tread designs available for and used by other manufacturers of tires*"; its "tire tread design *is not more cost effective to produce than other designs*"; its tread design "is also the subject of its U.S. Design Patent No. 261,257 for the ornamental features of the tread design" and "[i]t is that same ornamental appearance for which ... protection as a trademark" is now sought; its predecessor, Interco Marketing, Inc., obtained Supplemental Register Reg. No. 1,206,827 for a two-stage lug tire tread design which "is no more and no less 'functional'" than applicant's current three-stage lug tire tread design; the three-stage lug tread design "is no more functional than any of dozens of other tread designs that are known to exist"; applicant is not aware of any "objective proof" that such design "is so superior to any other tread design of a competing manufacturer that such [a] manufacturer would be at a competitive disadvantage to be without its use"; and applicant is also "not aware that the subject tread design has been legally used on tires by any manufacturer, distributor, or dealer" other than applicant and its authorized manufacturers, distributors and dealers since the origination of such design in late 1977. (Guidry dec. at 1-3; *emphasis added.*) Mr. Guidry additionally notes in his declaration that, as of June 16, 1993, applicant "has sold \$56,000,000 of tires bearing the subject trademark; that "[t]hose sales have involved 740,000 units of tires being sold and

distributed"; and that applicant "has expended \$300,000 in advertising and promoting the tires to which the subject mark is applied". (Id. at 3.)

In a similar vein, each of the form declarations submitted by applicant from three independent tire sellers states, except for respectively reciting eight, 17 and 18 years of experience (as of early February 1994) in the selling applicant's tires, that the declarant "is familiar with [applicant's] application ... and the tire tread design which is the subject matter" thereof; that such design "*is one of many possible tire tread designs available for and used by other manufacturers for tires*" and "is sold in competition with tires of other named manufacturers"; that applicant's subject design "is no more functional than any of the other tread designs that are known to exist" (although no such designs were specifically identified); that the declarant is familiar with and sells several other particular brands of tires; and that, based upon his experience, the declarant believes that the tread design which is the subject matter of applicant's application "is recognized in the trade and by consumers of tires as the design of ... and denoting products of" applicant alone (*emphasis added*).

According to applicant's witness, Mr. Pathiakis, he has been involved in the sale of tires for just over 10 years. His experience with selling tires began in 1986 as the owner and operator, until 1992, of a retail shop which specialized in the installation of tires, wheels and related accessories for 4-wheel

drive vehicles. Since then, he has run a mail-order business which involves the sale of such 4-wheel drive accessories as tires, wheels, suspensions, winches and shock absorbers. Mr. Pathiakis is familiar with applicant's products, which he buys from a distributor, as a result of both reselling such products through his mail-order business and using them personally on his show truck, which he exhibits in "Show and Shine" competitions¹² held at exhibitions of 4-wheel drive and off-road vehicles. Mr. Pathiakis, who is also familiar with tires made by such manufacturers as Bridgestone/Firestone, BF Goodrich, Goodyear, Kelly and Gateway, testified that he can identify applicant's subject tire tread design "[b]y the unique, three-stage lugs on the side of the tire" and by the way such lugs "protrude out of the sidewall." (Pathiakis dep. at 7.) He further indicated that, while is also familiar with differences in tire appearance in light of his experience in attending over 50 truck shows since 1989 and seeing what other competitors are using, he is not familiar with any other tires that have a lug pattern like that shown in applicant's subject design.

In particular, Mr. Pathiakis stated that he uses applicant's "Super Swamper TSL" tires because, "[b]asically, in the market there is nothing else available to the public at this time that is as radically design-looking as the Super Swamper

¹² Such competition is judged solely on the basis of appearance. In 1992, Mr. Pathiakis won first prize for best mini-truck in the "Show and Shine" category at an exhibition, attended by 2,000 participants and 45,000 spectators, held in Bloomsburg, Pennsylvania. A previous version of his truck, featuring applicant's "Super Swamper TSL" tires,

is." (Id. at 12.) To Mr. Pathiakis, the reason why applicant's tread design is such a radically appearing or "eye-catching" tire is "[t]he oversized lugs on the outside of the tire." (Id.) It is by the "staggered appearance" created by such lugs, which protrude from or overhang the tire's sidewall and create "a distinctive look over most tires," that Mr. Pathiakis recognizes the subject tread design as applicant's "Super Swamper" tire. (Id. at 13.) In his experience, applicant is "the only manufacturer that builds such an outrageous lug pattern with their tire." (Id.) Likewise, according to Mr. Guidry, he has never known any other tire manufacturers to produce a tread design which to him is similar in appearance to the three-stage lug design of applicant's "Super Swamper" tires, which he regards as the distinguishing feature of its tires.

Furthermore, while confirming that "[o]ther tires definitely have lugs," Mr. Pathiakis indicated that the pattern in applicant's tread design is different therefrom in that the lugs on applicant's tires "are staggered over the edge that overhang the sidewall." (Id.) Thus, while he has seen some other tires which similarly are "aggressive" looking, such as the lug patterns on the National Mud Trac, reproduced below,¹³

appeared in a photograph on the front cover of the October 1990 issue of Off-Road magazine.

¹³ Mr. Pathiakis, who uses National Mud Trac tires on another of his vehicles, testified that while such a tire has a stagger to it, the lugs do not actually overhang the sidewall.

National Mud Trac

and the Gateway Buckshot Radial Mudder, shown previously,¹⁴ there are no tires which, in his opinion, look like or are similar to the staggering or protruding lugs in applicant's subject tread design.¹⁵ (*Id.* at 18.) Although he has also observed a number of two-stage lug designs, he indicated that he has never seen another tire manufacturer's tire which "actually had three ... different size lugs on it." (*Id.* at 35.) Mr. Pathiakis further noted that he readily recognizes the differences in competitors' tread patterns and indicated that he would not be confused as to the source thereof in any side-by-side comparison with applicant's tire design due, chiefly, to the

¹⁴ While, in particular, Mr. Pathiakis indicated that he is familiar with the Gateway Buckshot Radial Mudder tire and confirmed that the lugs thereon overhang the sidewall a little bit, we again note that the centerline of such tire does not feature a chevron pattern which is either the same as or substantially similar to that of applicant's subject design.

¹⁵ Among other things, Mr. Pathiakis testified that the Co-op Mud King X/T tire, which he has actually used on one of his vehicles, is "not at all like" applicant's subject design in appearance; that the Firestone Super All Traction tire is "not at all" similar to such a design because "the side lugs don't protrude beyond the tire" and "seem to be repetitious all the way down"; and that the General Ameri*Lug tire, which he has sold, is "[n]ot at all" similar to applicant's subject design. (Pathiakis dep. at 19 and 21.) He also expressed the opinion that "[t]here's no similarity" in the Regul Mud King X/T, the Phillips 66 Super X-T or the Security Commercial Traction tires to the tread design applicant seeks to register. (*Id.* at 23 and 24.) Moreover, as to the tread designs displayed in the 1996 edition of the Tread Design Guide, he indicated that none of the tires therein looked at all like applicant's subject design.

"profound" manner by which the lugs on applicant's "Super Swamper TSL" tire overhang the sidewall. (Id. at 36.)

Mr. Kolowski testified that, as a tire engineer, he can distinguish the appearance of applicant's three-stage lug design from that of two-stage lug designs, such as the tread pattern Mr. Guidry designed for applicant's original "Swamper" tire around 1970 and for which applicant received a Supplemental Register registration for the tread design shown below:¹⁶

However, Mr. Kolowski acknowledged that while, to a tire engineer, a tire with a two-stage lug design would be different in appearance to a tire with a three-stage lug design, he added that he was "not sure" that such would be apparent to a non-engineer. (Id. at 27.) Mr. Guidry, however, maintains in his testimony that a three-stage lug pattern is distinct in appearance from a two-stage lug pattern. He also indicated that, just as the lugs and the gaps between lugs vary in size in applicant's three-stage lug design and thereby affect the appearance of the tread, the chevrons in the centerline of

applicant's subject design correspondingly alternate in three different sizes and thus likewise contribute to the overall aggressive appearance of applicant's "Super Swamper TSL" tires.

Although Mr. Guidry could not remember the exact date when sales of applicant's "Super Swamper" tires began, he indicated that sales of applicant's original "Super Swamper" tires, which featured a two-stage lug design, commenced sometime in the early 1970s and have been continuous. Mr. Guidry also stated, however, that the two-stage lug tread design thereon "differs significantly in appearance" from applicant's three-stage lug design, which was designed by him "to be uniquely different in appearance than other tread designs, including the Two Stage Lug design of the [original] Swamper, Gumbo Mudder and Buckshot Mudder tires." (Stipulated testimony at 3.)

Sales of applicant's "Super Swamper" tires featuring the three-stage lug tread design which is the subject of both this proceeding and its expired design patent began in October 1977 and have been continuous. While the precise figures (unlike those in Mr. Guidry's declaration) are confidential, sales of applicant's "Super Swamper" tires during the period from 1981 to 1995 generally reflect a pattern which its president referred to as being "a steady increase," with sales of some sizes and models rising to a level of at least several hundred thousand dollars

¹⁶ Reg. No. 1,206,827, issued on August 31, 1982, which sets forth a date of first use anywhere of December 31, 1970 and a date of first use in commerce of February 26, 1971.

annually.¹⁷ (Guidry dep. at 17.) According to Mr. Guidry, except for "slight differences depending on the diameter of the tire" (and which affect the sequencing of the lug patterns), all models of its "Super Swamper" tires are similar in appearance, regardless of size, and differ only in terms of the proportions in their tread designs. (Id. at 19.)

Applicant has advertised the three-stage lug design of its tires in its product literature, including the use since about March 1995 of a brochure which features a die-cut picture of its "Super Swamper TSL" tire to emphasize the staggered or protruding lugs in the tread design. Other pieces of product literature, while evolving over time, have been utilized since about 1975 and have been distributed to individuals, distributors and dealers. Applicant has also distributed T-shirts imprinted with a "footprint" of its subject tread design (although a pattern of three differently sized lugs is not readily apparent) and bearing the phrases "INTERCO SUPER SWAMPER," "THREE STAGE LUG" and "THE SUPER PERFORMER". Such T-shirts are sold to applicant's distributors, who give them away to customers who request them. In addition, applicant has promoted its goods through the use of caps, stickers and banners. In particular, banners picturing the various models of applicant's tires,

¹⁷ While the sales tabulation, which was prepared by one of the manufacturers of applicant's tires, does not indicate whether the amounts shown represent units sold or dollar volume, we have assumed, in light of the negative amounts for certain sizes and models in some years, that the sales figures represent dollar amounts. Mr. Guidry, we note, made the same assumption, although he added that he was "not sure". (Guidry dep., confidential portion, at 3.) Mr. Guidry also noted that sales of applicant's tires with its two-stage lug design do not represent a significant portion of applicant's total sales.

including those which incorporate its three-stage lug design, have been provided to applicant's distributors to hang as advertising in their retail establishments.

Applicant also has received some free publicity for its subject design due to the fact that pictures of its tires have appeared in publications directed to the 4-wheel drive market, including magazines such as Off-Road, Four Wheeler, Peterson's Four Wheeler & Off-Road and Sport Utility. Moreover, while applicant does not presently advertise in any publications, its distributors advertise its products in magazines, such as those mentioned above, which appeal to persons interested in 4-wheel drive vehicles and their accessories. In fact, a two-page ad by one of applicant's distributors in the June 1995 issue of Four Wheeler pictures applicant's "Super Swamper TSL" tire along with illustrations of such tires as the Gateway Buckshot Mudder (reproduced earlier in this opinion) and a Sport King Mud King XT.¹⁸

Turning first to the issue of de jure functionality, our principal reviewing court, in the leading case of *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 USPQ 9, 15-16 (CCPA 1982), outlined the following general evidentiary factors to be considered in determining such an issue (*emphasis by the court*):

Keeping in mind ... that "functionality" is determined in light of "utility," which is

¹⁸ The Sport King Mud King XT is identical in appearance to the other brands of "Mud King XT" tires which have been illustrated previously in this opinion.

determined in light of "superiority of design," and rests upon the foundation "essential to effective competition," ... there exist a number of factors, both positive and negative, which aid in that determination.

Previous opinions of this court have discussed what evidence is useful to demonstrate that a particular design is "superior". In *In re Shenango Ceramics, Inc.*, 53 CCPA 1268, 1273, 362 F.2d 287, 291, 150 USPQ 115, 119 (1966), the existence of an expired utility patent which disclosed the *utilitarian advantage of the design* sought to be registered as a trademark was evidence that it was "functional". It may also be significant that the originator of the design touts its utilitarian advantages through advertising.

Since the effect upon competition "is really the crux of the matter," it is, of course, significant that there are other alternatives available.

It is also significant that a particular design results from a comparatively simple or cheap method of manufacturing the article.

However, as the court subsequently pointed out in *In re Teledyne Industries, Inc.*, 696 F.2d 968, 217 USPQ 9, 11 (Fed. Cir. 1982):

Simply dissecting ... [an] alleged trademark into its design features and attributing to each a proven or commonly known utility is not, without more, conclusive that the design, considered as a whole, is de jure functional and not registrable. In other words, merely labeling each design feature as "useful" or as "serving a utilitarian purpose" cannot, as a matter of law, render the entire configuration de jure functional. Rather, the decisive consideration is whether the overall design ... is so superior in de facto function or economy of manufacture that recognition of that design as a trademark would hinder competition in the ... trade.

While this case, especially in light of the utilitarian advantages touted in applicant's advertising literature, presents a close question, we find on consideration of the above evidentiary factors that, on balance, applicant's three-stage lug tire tread design as a whole is not de jure functional.

Opposer correctly contends that the critical question determinative of whether applicant's subject configuration is de jure functional is whether a three-stage lug tire tread design works better than other tread designs and, hence, is a superior design which others should be permitted to copy in order to compete effectively. Opposer argues that U. S. Patent No. 5,259,429, a utility patent issued to a third party, describes a tire tread with sequences of small, intermediate and large lugs which are "remarkably applicable to three lug configuration" that applicant seeks to register, including lugs which protrude or overhang the tire sidewall, and that "[g]iven the functional advantages of a three-lug tread design, there is a need to copy such ... in order to compete effectively." In addition, opposer claims that applicant's advertising and promotional materials tout the utilitarian advantages of applicant's three-stage lug tread design, which opposer insists "is one of a few superior designs for mud tires". The availability of alternative designs which assertedly work equally as well as applicant's subject design, opposer maintains, does not overcome the fact that applicant's tread design is marketed as providing improved traction under off-road conditions. Moreover, notwithstanding that applicant's "Super Swamper TSL" tires are a bit more

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expensive to produce, and hence cost more, because they require a longer cure time than comparable tires, opposer urges that the additional cure time does not affect the cost of producing or molding the three-stage lug design itself. Opposer asserts that the cost differential accordingly does not establish "the non-functionality of the tread design at issue" since such design "could be produced by competitors at comparable cost".

We concur with applicant, however, that its subject three-stage lug pattern has not been shown on the whole to be a superior design. Such design, on this record, is not any more functional than other tire tread designs, whether of a two-stage lug or three-stage lug variety, for achieving maximum traction while providing directional stability and reducing generation of road noise. While the different sized lugs and the correspondingly different spacing between them affect the traction, self-cleaning and noise characteristics of applicant's subject design, other sizes and arrangements of lugs provide comparable levels of traction and self-cleaning in mud and on other surfaces. Noise reduction or pitching, however, is related to the *width* of the lugs and the gaps between lugs rather than to the *length* of the lugs or to their protrusion or overhang of the sidewall of a tire. Moreover, as illustrated below,

the tire tread design disclosed by the third-party utility patent introduced by opposer, although nominally a three-stage lug design, is sharply and strikingly different in appearance from applicant's three-stage lug configuration.

Plainly, whatever improved traction, directional stability or other benefits a three-stage lug design may provide over the more common or traditional two-stage lug patterns may be achieved without resort to the particular arrangement of short-, intermediate- and large-length lugs and centerline chevrons utilized in applicant's subject tread design. Furthermore, the fact that such design is the subject of a recently expired design patent owned by applicant, while not precluding a finding of de jure functionality, establishes a rebuttable presumption that applicant's three-stage lug design is basically ornamental rather than essentially utilitarian in concept. See, e.g., *In re Morton-Norwich Products, Inc.*, supra at 17 n. 3 [ownership of design patent "for the design in issue, ... at least presumptively, indicates that the design is not de jure functional"].

Thus, while the absence of a utility patent which specifically discloses the utilitarian advantages of the tire tread design applicant seeks to register is an evidentiary factor which favors applicant, it is significant that applicant touts the utilitarian advantages of its three-stage lug configuration in its advertising and promotional materials. Applicant claims in its ads that, inter alia, its subject three-stage lug tire

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design offers unsurpassed traction; that such configuration is the ultimate in tire tread design inasmuch as the lugs are portioned and spaced to dig deep and self-clean rapidly; and that its design offers increased mileage, provides a quieter, smoother ride, and results in a tire that is both directionally and laterally stable. Product reviews of applicant's "Super Swamper TSL" tire likewise contain the same or similar statements as to the functional advantages of its tread design. Applicant asserts in its brief, however, that such claims do not demonstrate that its subject tire tread design is de jure functional, contending instead that:

Applicant, like any manufacturer[,] extols the benefits of its unique design, but this is no more than standard advertising puffery used by all manufacturers to advertise their products. Applicant certainly believes it has an excellent product and makes claims to this effect as any manufacturer would, but such claims are nothing more than the reality of the market place and have been recognized by the Board to be within acceptable limits of advertising puffery.

Furthermore, contrary to the claims of superior performance in applicant's advertising and in product reviews, Mr. Pathiakis testified that, as noted earlier, tires with applicant's subject design do not provide better traction, while its president similarly insisted that, although he wished otherwise, he could not say that such tires are the best performing tires of their type.

Opposer, in its reply brief, points out that the Board has rejected a party's efforts to discount claims of functional

superiority as mere puffery or to dismiss utilitarian features which, while touted in advertising as being better, are claimed not to be so in reality. In particular, as noted by opposer, the Board in *In re Witco Corp.*, 14 USPQ2d 1557, 1560 (TTAB 1989), stated with respect to a claim that statements in promotional literature were mere puffery that: "This explanation is not persuasive to rebut the specific statements touting the functional advantages of these features, in view of the significant number of promotional materials ..., which focus directly on the advantages of the configuration" Likewise, as stated by the court in *In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1, 6 (Fed. Cir. 1985): "In concluding that the ... design is one of the best from the standpoint of performance ..., we need only believe [the party's] ... own statements [in its advertising]." Consequently, the statements in applicant's advertising, as well as those made in reviews of its products, favor opposer's position that applicant's subject design is de jure functional.

The record also shows, however, that the competitive need for tires which provide maximum traction in mud or on other types of terrain may be met by a variety of alternative designs which are in actual use or which are potentially available, through licensing of patent rights, for use by opposer and third parties. Opposer, in fact, currently sells two different mud tires, but neither has a tread pattern which is the same as or similar to applicant's three-stage lug design. Such design is also clearly distinct from any of the other tire tread patterns

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which opposer has manufactured or sold, including roughly six designs for all-terrain tires which it produced during the period from 1995 to 1996 and another 12 to 15 designs for such tires which it utilized in the preceding ten-year interval. In fact, opposer has received numerous design patents for its tire tread designs and none of such designs resembles applicant's subject configuration.

As Mr. Kolowski acknowledged and the record reflects, the tread pattern on mud or all-terrain tires can take a variety of appearances and still function for the general purposes of providing increased traction and directional stability. The testimony and the portions from the various editions of the Tread Design Guide establish that there are many alternative tread designs for mud and other types of tires which have been and/or are presently in use by competitors and which are not identical or even similar to applicant's subject design. While the evidence also shows that there are and have been a number of third-party tire tread designs in use which are substantially similar to the overall appearance of applicant's three-stage lug configuration (as discussed later in this opinion), no one in the tire industry has copied that exact configuration (although applicant's two-stage lug design, which served as the precursor thereto, has been copied by others in the tire trade). In particular, the record reveals that overhanging or protruding lugs found in applicant's subject design and their three different lengths, which applicant regards as the features primarily responsible for the uniqueness of its "Super Swamper

TSL" tires, are mainly for the sake of appearance, rather than for any specific functional advantage. Thus, the third *Morton-Norwich* factor dictates a finding that applicant's three-stage lug tire tread design is not de jure functional.

The last of the *Morton-Norwich* factors also favors applicant's position. Although the evidence is sparse, Mr. Guidry's unrebutted testimony indicates that in comparison to tires of similar weight and type of construction, applicant's three-stage lug design tires are a bit more expensive to manufacture because they require a longer cure time. Opposer's speculative assertion that the additional cure time does not affect the cost of producing or molding the three-stage lug design itself, even if true, does not negate the fact that once a tire with such a design has left the mold, its longer cure time in the production process nevertheless increases the overall cost of its manufacture and thus results in a slightly more expensive product. Accordingly, because for tires of similar weight and type of construction, applicant's subject design does not result from a comparatively simple or cheaper method of manufacturing its product, the fourth *Morton-Norwich* factor does not demonstrate that such design is de jure functional.

On balance, therefore, while the advertising and product reviews for tires containing applicant's three-stage lug design are strongly indicative of a superior design which others should be permitted to copy in order to compete effectively, the absence of any utility patent directed specifically to the elements of applicant's subject design (as contrasted to

applicant's recently expired design patent for the ornamental features thereof), the availability of a wide variety of alternative tread designs for mud and all-terrain tires, and the slightly more expensive cost of producing tires with applicant's subject design convince us that applicant's overall design is not so superior in function or economy of manufacture that recognition of its subject design as a trademark would hinder competition in the tire trade. Opposer, of course, has the burden establishing a prima facie case of de jure functionality for applicant's three-stage lug design in order to shift the burden to applicant of showing that its subject design is not functional. See, e.g., *Textron, Inc. v. U.S. International Trade Commission*, 753 F.2d 1029, 224 USPQ 625, 629 (Fed. Cir. 1985). Opposer, on this record, has failed to meet its burden of proof to demonstrate prima facie that in its entirety applicant's three-stage lug design is de jure functional.

Turning next to the remaining issue in this case, we note at the outset that inasmuch as applicant seeks registration for its subject design on the basis of a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, it is opposer who has the initial burden of showing that the evidence which applicant submitted with its application is insufficient to establish such a claim. Once such burden is met, the burden of going forward shifts to applicant to show, by a preponderance of the evidence of record, that its three-stage lug design has in fact acquired distinctiveness and thus functions as a trademark for tires. As set forth in *Yamaha International Corp. v. Hoshino*

Gakki Co. Ltd., 840 F.2d 1572, 6 USPQ2d 1001, 1004-05 (Fed. Cir. 1988), in which registration of the shape or appearance of a guitar peg head was sought, our principal reviewing court noted that:

[O]ne opposing a Section 2(f) registration published for opposition on the basis of that section must have at least the initial burden of challenging or rebutting the applicant's evidence of distinctiveness made of record during prosecution which led to publication of the proposed mark.

An opposer to an application submitted under Section 2(f) sufficiently meets its initial burden if it produces sufficient evidence or argument whereby, on the entire record then before the board, the board could conclude that the applicant has not met its ultimate burden of showing acquired distinctiveness.

....

Where, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the statute accepts a lack of inherent distinctiveness as an established fact.

....

If the opposer does present its prima facie case challenging the sufficiency of applicant's proof of acquired distinctiveness, the applicant may then find it necessary to present additional evidence and argument to rebut or overcome the opposer's showing and to establish that the mark has acquired distinctiveness.

Thus, as further noted by the court, "the ultimate burden of persuasion under Section 2(f) on the issue of acquired distinctiveness is on ... [the] applicant." 6 USPQ2d at 1006. Moreover, contrary to applicant's strenuous contentions that opposer must initially show that others are using tread designs

which have *virtually the same* pattern of features as applicant's subject design, we observe that the court also pointed out that (*emphasis added*): "In most oppositions to registrations under Section 2(f), prevailing opposers have presented some evidence that the mark has not acquired distinctiveness, such as others' use of the proposed mark or *similar* marks." *Id.* at 1008-09.

We find that opposer has satisfied its initial burden of establishing a *prima facie* case, the principal facet of which is that the showing applicant made in its application does not suffice to establish acquired distinctiveness, and that on the entire record applicant has not met its ultimate burden of persuasion to establish that its three-stage lug design has acquired distinctiveness. This is because the record shows that applicant's subject design essentially is a mere refinement of a common basic design for mud, all-terrain and other maximum traction tires which has been utilized for many years in the tire industry.¹⁹ Thus, notwithstanding applicant's almost 20 years of continuous use of its particular three-stage lug design, as reflected, *inter alia*, in the declarations from its dealers attesting to their recognition of such design, its steadily increasing sales of tires bearing that design and the use thereof by applicant and its distributors in advertising and promotional

¹⁹ Although applicant, among other things, repeatedly emphasizes the "unique" or novel appearance of its subject tire tread design and the record reflects that no one else in the tire industry has made or sold a tire with exactly the same tread pattern as applicant's three-stage lug design, the fact that applicant's design is the one and only of its kind does not necessarily mean that it is *inherently* distinctive, much less that it has *acquired* distinctiveness through use and promotion as a mark. *See, e.g.,* In re In re E S Robbins Corp., 30 USPQ2d 1540, 1542-43 (TTAB 1992) and cases cited therein.

materials, the evidence nevertheless is insufficient to establish acquired distinctiveness. As applicant concedes in its brief, "meeting this standard of preponderance of the evidence becomes more difficult as the descriptiveness of the mark increases," citing *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, supra at 6 USPQ2d 1008. While, as applicant has also admitted, its three-stage lug tire tread design "is only de facto functional," it is still the case that, like the guitar peg head in *Yamaha*, such a design--because it constitutes the appearance of the product--is highly descriptive of the goods.

As shown by the pages from the various annual editions of the Tread Design Guide which have been made of record by both opposer and applicant,²⁰ there are numerous tire tread designs

²⁰ Applicant, in its brief, has reiterated the objection it interposed at the deposition of Mr. Lewandowski to the introduction of opposer's Exhibit 3, which constitutes a compilation of excerpted pages from various issues of the Tread Design Guide together with a summary sheet listing the tire tread designs which Tina Taylor, an administrator in opposer's trademark group who did the search of such guides, found to "have similar appearance" to applicant's subject design. (Lewandowski dep. at 12.) Applicant, characterizing Exhibit 3 in its brief as a "report," has objected to "the introduction of this report based on the fact that it was not authenticated and that it constitutes inadmissible hearsay" since, as Mr. Lewandowski admitted on cross-examination, he did not prepare such compilation and summary listing, he did not give instructions to Ms. Taylor and he thus did not know what instructions were given. However, as opposer persuasively points out in its reply brief:

[T]he excerpts from the 1967-1995 Tread Design Guides ... should be admissible on this issue. These excerpts are from a recognized publication which depicts tires of many manufacturers, each of them being displayed with their identifying word marks. While Tina Taylor ... marked certain tires which appeared to be visually similar to the Super Swamper [TSL] tire, this determination of similarity can be made by the Board from its own examination of the tires in these publications. Interco's inability to cross-examine Tina Taylor as to her selection process has no bearing on the authenticity of these excerpts from the Tread

which have been in use over the years in which, like applicant's subject design, chevrons are used in dual centerline rows to give tires directionality and other traction features. Chevrons plainly are a common shape for the centerline treads on tires. In consequence thereof, the fact that those in the centerline of applicant's "Super Swamper TSL" tires alternate in three different sizes, so as to correspond with the variations in lengths of the sidewall lugs, would not be readily apparent (as a

Design Guides. The Board need not rely on Goodyear's statement that the designs are similar any more than it should rely on Interco's insistence that they are dissimilar.

Accordingly, while we have not considered the hearsay statement on the summary sheet that the excerpted designs are "similar," we have otherwise considered Exhibit 3 and note that, in any event, the excerpted pages are not inadmissible as hearsay. Specifically, Fed. R. Evid. 803(17) provides that the following are not excluded by the hearsay rule: "Market quotations, tabulations, lists, directories, or other published compilations, generally used and relied upon by the public or by persons in particular occupations." The testimony in this case establishes that editions of the Tread Design Guide are relied upon not only by law enforcement agencies but also by those in the tire industry to identify tires by their tread patterns.

look at applicant's actual tire and the photographs thereof confirms) to the average purchaser of tires in general or mud tires in particular.

Similarly, while no other manufacturer or seller of tires markets a tire which features a pattern of three different length lugs in which the larger lugs extend appreciably beyond the sidewall, such a design is in essence a mere refinement of long-standing two-stage lug designs like applicant's widely copied "Swamper" tire. Moreover, in light of the fact that applicant's design patent for its subject three-stage lug design did not expire until October 13, 1995, it is not surprising, inasmuch as the trial of this proceeding closed only about 15 months later on January 10, 1997, that neither opposer nor any third party has utilized a tread pattern for their tires which is either the same or virtually identical to that for which applicant now seeks trademark protection.

Thus, contrary to the insistence by applicant that its subject design is completely different in all respects from any of the other tire tread patterns in the record, we find upon a comparison thereof that its three-stage lug configuration is substantially similar in its overall design elements and appearance to such third-party tread patterns as those on the General Ameri*Lug, the Cascade Radial Mud XT, the Delta Mud Trac, the Regul Trailblazer MT, the National Mud Trac and the various brands of Mud King XT and X/T tires. All of these designs, like applicant's "Super Swamper TSL" tires, have an aggressive or radical appearance due to their common dual centerline chevrons

and large, different length lugs. Also similar in their design concept, although admittedly not quite as close visually to applicant's subject design as those just mentioned, are the tread patterns on the Security Commercial Traction, the Firestone Super All Traction (both directional and non-directional models) and the Ceat Traction Grip tires. Applicant, in this regard, admits in its brief that it "does not dispute the fact that many tire designs include tread patterns incorporating two outer rows of lugs and two inner rows of center tread elements arranged in a more or less chevron pattern."

Accordingly, while persons with many years of experience in the tire industry, such as tire engineers, tire dealers and tire producers, can upon inspection distinguish applicant's "Super Swamper TSL" tire from various other brands of tires by their specific tread designs,²¹ applicant simply has not shown that the differences in appearance of such designs are of source-indicative significance to ordinary retail purchasers of tires or that such consumers, in particular, would be aware of and consequently would distinguish mud or all-terrain tires by

²¹ Although Mr. Pathiakis indicated, for example, that there definitely were distinct differences between applicant's three-stage lug design and the more than 100 alternative mud tire designs shown in the 1996 Tread Design Guide, he further testified that:

Q Is it differences that you can readily recognize as soon as you look at the tire?

A For me, yes.

Q Why do you say for you?

A It's just that I have an opportunity to see all these tires. That tire still stands out above all of them.

the relatively minor refinements or differences in the appearance of their tread patterns. See, e.g., In re General Tire & Rubber Co., 404 F.2d 1396, 160 USPQ 415, 417 (CCPA 1969) [in light of general public's long familiarity with whitewalls as trade dress or ornamentation for tires, "a typical purchaser ... would be more likely to consider a 3-ring whitewall as just a refinement of this general ornamental concept, rather than as a trademark."] This is especially so since applicant's particular design repetitively covers the entirety of the tread surface of its tires. See In re Soccer Sport Supply Co., Inc., 507 F.2d 1400, 184 USPQ 345, 347 (CCPA 1975) [design which is mere refinement of commonly-adopted and well-known form of ornamentation for class of goods would presumably be viewed by public as trade dress or ornamentation, "[e]specially ... when such design is applied repetitively to the entire surface of the goods."]

Measured against this marketplace reality, applicant's evidence is insufficient to establish that its subject tire tread design has acquired distinctiveness. While applicant, commencing in October 1977, has had continuous sales of tires bearing its three-stage lug design²² and such sales, during the period from 1981 to 1995, reflect a steady increase, with sales of some sizes and models reaching a level of at least several hundred thousand dollars annually, mere sales alone, even over an appreciable time

(Pathiakis dep. at 30.)

²² Although applicant, since 1970, has also continuously sold tires featuring the two-stage lug design which is the subject of its Supplement Register registration, such sales have not only been relatively insubstantial, but more importantly, as applicant's

period, do not suffice to establish acquired distinctiveness in and of themselves. At best, applicant's sales figures may be said to demonstrate a growing degree of popularity or commercial success for its tires, but such evidence does not demonstrate recognition by the purchasing public of its three-stage lug configuration as a trademark. See, e.g., In re Bongrain International (American) Corp., 894 F.2d 1316, 13 USPQ2d 1727, 1729 (Fed. Cir. 1990) [growth in sales may be indicative of popularity of product itself rather than recognition of a term or design as denoting origin] and WLWC Centers, Inc. v. Winners Corp., 221 USPQ 701, 707 (M.D. Tenn. 1983) [popularity in sales alone cannot establish secondary meaning]. Moreover, although sales, as stated in Mr. Guidry's June 16, 1993 declaration, of \$56,000,000, which represent 740,000 tires sold, may appear in the abstract to be appreciable, such figures cannot be said to have made a substantial impact either in the market as a whole or in the category of mud tires, particularly in light of the fact that applicant is such a small producer of tires that its products are not even listed in any of excerpts from or issues of the Tread Design Guide which are of record.²³

Furthermore, as previously mentioned, applicant has acknowledged that the greater the degree of descriptiveness which

president admitted, such design differs significantly in appearance from applicant's subject design.

²³ While, as reflected earlier in this opinion, we have also considered the additional sales figures revealed in the confidential portion of Mr. Guidry's deposition and the exhibit thereto, such amounts do not alter our conclusion.

a design possesses, the heavier is a party's burden of proving that such a design has in fact become distinctive of the goods with which it is associated. Here, given the high degree of descriptiveness inherent in tire tread designs, together with the fact that many third parties have used designs similar to that of applicant--including a significant number of substantially similar, but not identical, tire tread designs for mud and other all terrain tires, we are not convinced that the purchasing public has come to view applicant's three-stage lug configuration as a trademark for its tires. Being a mere refinement of a common basic design, applicant's subject design, like the substantially similar tread patterns of on a number of third-party tires, shares essentially the same aggressive or radical appearance due to the presence in each of the designs of dual centerline chevrons and large, different length lugs. Thus, while applicant has had nearly 20 years of *continuous* use of its particular three-stage lug configuration, it simply cannot be said, in light of the many uses by third parties of similar and, in some instances, substantially similar designs for maximum traction tires, that applicant, as required by Section 2(f) of the Trademark Act, has had *substantially exclusive* use.²⁴ See, e.g., *Levi Strauss & Co. v. Genesco, Inc.*, 840 F.2d 1579, 222 USPQ 939, 940-41 (Fed. Cir. 1984) ["When the record shows that

²⁴ Section 2(f) of the statute provides, in relevant part, that (*emphasis added*): "The Commissioner may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of *substantially exclusive and continuous* use thereof as a mark by the applicant in commerce"

purchasers are confronted with more than one ... independent users of a term [or design]..., an application under Section 2(f) cannot be successful, for distinctiveness upon which purchasers may rely is lacking under such circumstances."]; *Racine Industries Inc. v. Bane-Clene Corp.*, 35 USPQ2d 1832, 1840 (TTAB 1994); and *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1204 (TTAB 1993), *aff'd*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994).

Applicant's advertising expenditures and promotional materials also fail to demonstrate that its subject design has acquired distinctiveness. Although, in particular, its advertising and promotional expenditures, as of Mr. Guidry's June 16, 1993 declaration, have totaled \$300,000, such amount is quite modest when viewed over the course of nearly twenty years of use of its three-stage lug design and, in any event, is not determinative of the success of applicant's attempts to develop distinctiveness for its tread pattern. See, e.g., *In re Semel*, 189 USPQ 285, 287 (TTAB 1975) ["in evaluating the significance of advertising figures ..., it is necessary to consider not only the extent of advertising but also whether the use of the designation [or design] therein has been of such nature as to create in the minds of the purchasing public an association of the designation [or design] with the user and/or his goods"] and *Ralston Purina Co. v. Thomas J. Lipton, Inc.*, 173 USPQ 820, 824 (S.D.N.Y. 1972) [promotional expenditures indicate efforts to establish secondary meaning, but do not determine the success thereof].

In particular, we observe that except for the sale of some T-shirts bearing a relatively indistinct reproduction of the "footprint" of applicant's three-stage lug tread pattern and the phrase "THREE STAGE LUG",²⁵ applicant's attempt in its product literature to promote its subject design as a trademark for its "Super Swamper TSL" tires, through the use of a single die-cut brochure, only commenced in March 1995, and there is no indication as to the extent of the distribution of such advertising. Moreover, while applicant also distributes banners for use by retailers of its tires, such banners, as is the case with its earlier advertising literature, merely picture applicant's goods. Such promotional materials, however, do not indicate that the tire tread pattern depicted in the representation of applicant's "Super Swamper TSL" tires is to be regarded as one of applicant's trademarks. Consequently, in the absence of any significant promotion by applicant of its subject design as a trademark for its tires, its meager advertising expenditures and limited promotional materials cannot be said to establish that the purchasing public has come to view applicant's three-stage lug design as a trademark. See, e.g., In re Pingel Enterprise Inc., 46 USPQ2d 1811, 1823 (TTAB 1998) [applicant's catalog and advertisements showed use of its motorcycle fuel valve and filter configuration solely as product illustration].

²⁵ Although applicant promotes that descriptive phrase, as well as the terminology "TSL," in its advertising, the issue of acquired distinctiveness depends upon whether the particular tread pattern which constitutes applicant's subject design per se has come to be recognized by the purchasing public as denoting the source of applicant's goods.

Likewise, while applicant's distributors have advertised its "Super Swamper TSL" tires by picturing them in their ads, purchasers and potential customers for applicant goods would regard such pictures as nothing more than illustrations of the products being offered for sale and not as indicia of origin. Similarly, while tires bearing applicant's subject design have been given free publicity by being depicted in a number of publications directed to those interested in 4-wheel drive and other off-road activities, in each instance applicant's three-stage lug design is presented merely as a photograph of its product, i.e., a representation of what applicant's tires look like, and not as an indication of source for such product.

Additionally, the fact that the ornamental appearance of applicant's three-stage lug design was formerly the subject of a now expired design patent does not mean that such design has become distinctive for purposes of trademark law. As our principal reviewing court, quoting from the Board's decision in *In re Honeywell Inc.*, 187 USPQ 576, 578 (TTAB 1975), stated in *In re R.M. Smith, Inc.*, supra at 222 USPQ 3: "[T]he fact that a device ... was the subject of a design patent does not, without more, bestow upon said device the aura of distinctiveness or recognition as a trademark."

Finally, with respect to the declarations applicant submitted from three independent tire sellers having many years of experience in selling applicant's tires, the conclusory statements, in each instance, that the declarant, who is familiar

with and has sold various other brands of tires, believes that applicant's subject tread design "is recognized in the trade and by consumers of tires as the design of ... and denoting products of" applicant alone fail to establish that such design has acquired distinctiveness. This is because the declarations, like the testimony of Messrs. Guidry and Pathiakis, essentially reveal nothing as to how or why the ultimate purchasers of tires recognize or otherwise regard applicant's subject tread pattern as a source indicator. However, as pointed out in *In re Semel*, supra at 288: "It is well settled that the assertions of retailers, who know full well from whom they are buying, that they themselves recognize a particular designation [or design] as a trademark ... cannot serve to establish that members of the purchasing public, who come to the marketplace without such specialized knowledge, would in fact recognize the designation [or design] as an indication of origin." See also *In re Meyer & Wenthe, Inc.*, 267 F.2d 945, 122 USPQ 372, 376 (CCPA 1959) [it was incumbent upon applicant to submit proof that its mark is distinctive, not only to experts in the field, but to purchasing public].

Consequently, viewing the totality of the evidence of record, applicant has not met its burden of establishing that its de facto functional three-stage lug design has in fact acquired distinctiveness. Nothing in the record shows that the purchasing public identifies and distinguishes the source of tires of any kind, much less mud, all-terrain and other maximum traction tires, by their tread patterns. Admittedly, those in the

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industry, such as tire manufacturers, engineers, distributors and retailers, can distinguish tires (in some instances more readily than in others) by their tread designs, but the evidence is simply lacking that ordinary retail purchasers, without the years of experience and specialized knowledge of those in the tire field, are likewise able to do so, especially in cases where the tread patterns essentially involve mere refinements of a common basic design. More importantly, despite almost 20 years of continuous use and steadily increasing sales, applicant's meager advertising and promotional outlays, coupled with the virtual absence, until very recently, of any advertisements which even arguably promote its three-stage lug configuration as a source-signifying design, are insufficient to demonstrate that applicant's subject design has in fact acquired distinctiveness in the marketplace for tires.

Decision: The opposition is dismissed as to the ground that applicant's three-stage lug tire tread design is de jure functional, but the opposition is sustained, and registration to applicant is refused, on the ground that such design is de facto functional and has not acquired distinctiveness.

R. F. Cissel

E. W. Hanak

G. D. Hohein
Administrative Trademark Judges,

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Trademark Trial and Appeal Board