

Hearing:  
September 16, 1997

Paper No. 37  
GDH/gdh

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Bridgestone/Firestone, Inc.  
v.  
Interco Tire Corporation

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Opposition No. 96,405 to application Serial No. 74/279,000  
filed on May 27, 1992

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Peter G. Mack, Lisa A. Smith and Cameron C. Powell of Foley &  
Lardner for Bridgestone/Firestone, Inc.

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

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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".<sup>1</sup> 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.

Bridgestone/Firestone, Inc. has opposed registration on the ground that, since long prior to applicant's alleged date of first use of its tread design on October 3, 1977, opposer "has been engaged in the manufacture, offering for sale and sale of tires having various tread designs ... and is now still so engaged"; that "[a]s a manufacturer and seller of tires, opposer is in a position to use on its tires tread designs that are the same as or similar to the applicant's tread design which is the subject of the application herein opposed"; that granting the registration sought by applicant "would be inconsistent with opposer's freedom to use such tread designs on its tires"; that continuously, "[s]ince at least as early as 1954, opposer has used on one of its FIRESTONE® brand tires, known as its 'SUPER ALL TRACTION' tire, a tread design ('opposer's tread design') that closely resembles and is substantially similar to applicant's tread design"; that in view of such use by opposer, "applicant's use of applicant's tread design has not been substantially exclusive for the five years preceding the filing date of the application herein opposed or for any other period of time"; and that, accordingly, "applicant's tread design does not

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<sup>1</sup> 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."

serve to identify the source of applicant's tires from tires made and sold by opposer."<sup>2</sup>

Additionally, in the event that applicant is found to have acquired distinctiveness in its three-stage lug tire tread design, opposer further alleges as an alternative ground that it "adopted opposer's tread design long before applicant adopted applicant's tread design"; that "opposer has continuously used opposer's tread design in commerce from the time of its adoption through the present"; that, in consequence thereof, "if any one of the parties to this proceeding is entitled to claim exclusive rights in a design like opposer's and applicant's tread designs, opposer, and not applicant, would be entitled to make such claim of exclusive rights"; and that the registration sought by applicant "would be inconsistent with opposer's rights":

Because applicant's tread design closely resembles and is substantially similar to opposer's tread design, because opposer would have prior and superior rights in and to its tread design if any party is entitled to such exclusive rights, because the goods of opposer and applicant to which their respective tread designs are applied are of the same kind and type and are sold to the same or similar classes of purchasers through the same or similar channels of trade, the tread design sought to be registered by applicant so resembles opposer's tread design

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<sup>2</sup> Although opposer has also set forth, as a separately stated ground for opposition, that "[t]he evidence submitted by applicant in connection with the prosecution of the application herein opposed to show acquired distinctiveness is inadequate, incomplete, and insufficient to demonstrate acquired distinctiveness," 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 consequently will be so construed.

as to be likely to cause confusion, or to cause mistake, or to deceive.

Applicant, in its answer, has denied the salient allegations of the notice of opposition.<sup>3</sup>

The record includes the pleadings; the file of the opposed application; and, as opposer's case-in-chief, a notice of reliance on applicant's responses to certain of opposer's first set of interrogatories, and the testimony, with exhibits, of Alan D. Clark, an off-the-road and truck tire development engineer employed by opposer, and Franklin Dale Rettig, an engineer with opposer's truck tire engineering group. Applicant, as its case-in-chief, submitted a notice of reliance on opposer's answers to various interrogatories propounded in applicant's first set of interrogatories and applicant's responses to several other interrogatories contained in opposer's first set of interrogatories;<sup>4</sup> and the testimony, with exhibits, 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.<sup>5</sup> Briefs have been filed and an oral hearing, attended by counsel for the parties, was held.

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<sup>3</sup> 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.

<sup>4</sup> Submission of the latter, applicant states in its notice of reliance, is necessary in order to "complete the evidence regarding the issues in this proceeding and to avoid the possibility of a decision being based on selected interrogatory answers which, in isolation, may not present a complete picture regarding the issues presented herein ...."

<sup>5</sup> Applicant's uncontested requests for substitution of photographs for certain bulky exhibits introduced during the testimony depositions of

The issues to be determined are whether applicant's three-stage lug tire tread design has acquired distinctiveness; whether opposer has priority of use of any tire tread design; and, if so, whether applicant's three-stage lug tire tread design, when used in connection with its tires, so resembles a tread design used by opposer for its tires that confusion is likely as to the source or sponsorship of the parties' products.

According to the record, opposer is a wholly owned subsidiary of Bridgestone Corporation, which purchased The Firestone Tire & Rubber Company, as opposer was formerly known for many years, in 1988. Following such acquisition, opposer changed its name to its present name, Bridgestone/Firestone, Inc., in early 1989. Opposer's principal products are tires, which it sells primarily under the "FIRESTONE" brand. Since 1954, opposer has continuously manufactured and sold a tire, known as the Firestone "Super All Traction," which it contends is the same or substantially similar in appearance to the tire tread design which applicant seeks to register. Such tire has been available in a directional model, shown on the right below, and has been offered, since about 1979 or 1980, in non-directional versions, depicted on the left and in the center below:

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its witnesses and to submit the previously retained videotape exhibit from the testimony deposition of Mr. Pathiakis are granted.

Each of the above variations of opposer's "Super All Traction" tire has had the same tread pattern during the entire time each has been sold.

All of the versions of opposer's "Super All Traction" tire, as of the March 13, 1996 date of the depositions of opposer's witnesses, are in use. Such tires, like tires which feature applicant's subject design, are categorized as maximum traction tires and are primarily used on sport utility vehicles, including pickups and other light trucks, with opposer's tires also being used on heavy-duty trucks, delivery trucks, recreational vehicles, off-road vehicles, school buses, dump trucks and mining equipment. Opposer sells its tires to consumers through tire dealers and to large volume users like automobile manufacturers and fleet operators. In addition, Opposer has advertised the versions of its "Super All Traction" tire in advertisements, brochures, fliers, tire guides, price lists and other promotional materials which illustrate such tires and tout them as providing maximum traction and stability in off-road, mud and snow conditions.

One of opposer's witness, Alan D. Clark, testified that he first learned of applicant when someone in opposer's legal department asked him if he could identify applicant's tire from the subject three-stage lug configuration which was published in the Official Gazette. According to Mr. Clark, his first reaction was that applicant's subject design "was a direct copy of our

Super All Traction design that we use for maximum traction type service." (Clark dep. at 9.) Mr. Clark described the particular designs as each consisting basically of a "discontinuous center rib and separate or discontinuous shoulder lugs." (Id. at 11.) Specifically, it is the non-directional, discontinuous lug model of opposer's "Super All Traction" tire (previously illustrated on the left above) which, in the appearance of its tread pattern, is the most similar to applicant's three-stage lug configuration<sup>6</sup>

Although, on cross-examination, Mr. Clark admitted that it was "fair to say" that applicant's subject design is not a direct copy of either of the other two versions of opposer's "Super All Traction" tire and that he could tell each of those tire patterns apart by looking at them, he nevertheless believed such design was a direct copy, when he first saw it, of the non-directional, discontinuous lug tire offered by opposer.<sup>7</sup> (Id. at 48.) While he no longer believes applicant's subject design to be a direct copy thereof, his "reaction has only changed in the fact that they are very, very similar," notwithstanding that on opposer's tire each lug has a slit in it; the spacing between the lugs appears to be substantially constant; and the lugs and

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<sup>6</sup> Unlike directional tires, which maximize functions such as traction only when operating in a certain direction, non-directional tires can be mounted in any direction. A simple way to tell the former from the latter is that "as you look at the [opposing shoulder] lugs, they both form a 'V'" on a directional tire. (Clark dep. at 18.) The general trend in tires, however, is away from directional types.

<sup>7</sup> On redirect examination, Mr. Clark noted that his initial reaction was influenced by the fact that, when he first saw applicant's subject design as depicted in the Official Gazette, he was looking at "an artist's concept of what the tread ought to look like" and that "that [rendering] was what I referred to as being a direct copy to our Super All Traction" tire. (Id. at 82.)

centerline chevrons are substantially the same in size and shape. In contrast, Mr. Clark admitted that in looking closely at applicant's three-stage lug pattern, the discontinuous lugs therein vary significantly in size and shape, as do the spaces between adjacent lugs and the centerline chevrons, and that some of the lugs extend outwardly from the sidewall. (Id. at 50.)

Moreover, while further conceding that the two other versions of opposer's "Super All Traction" tire have "some differences" from applicant's three-stage lug configuration which are apparent on a side-by-side comparison, he maintained that such are "[n]ot significant differences". (Id. at 49.) In essence, Mr. Clark testified that while "up close, certainly there are differences" between applicant's subject design and the tread patterns on the various versions of opposer's "Super All Traction" tire, "[a]t a distance" of about 20 to 30 feet he "would take it as being similar," as would be the case with many other tires, since the size of the individual lugs could no longer be distinguished. (Id. at 72-73.) Mr. Clark added, on redirect examination, that as a tire engineer he can quickly spot tread details due to his "trained eye" in tire design. (Id. at 81.) He also indicated, upon looking at one of the specimen photographs of applicant's tire with its non-directional three-stage lug design, that such tire and the non-directional versions of opposer's "Super All Traction" tire overall have a generally similar appearance due to the patterns of their discontinuous center ribs and discontinuous shoulder lugs.

Opposer's other witness, Franklin Dale Rettig, offered basically the same testimony. In particular, he indicated that he first learned of applicant's application when a paralegal in opposer's legal department called and requested him to look at applicant's subject three-stage lug design as published in the Official Gazette. According to Mr. Rettig, his "immediate reaction was, it is a Firestone tire, it was a copy of a tire we had." (Rettig dep. at 7.) Specifically, upon looking at such design, he thought that it "was very similar, if not identical, to the Super All Traction tire," which opposer sells under its "FIRESTONE" brand rather than as a private label product. (Id.) Mr. Rettig, however, had not previously heard of applicant and, like Mr. Clark, described such designs as consisting basically of a "disconnected center rib ... with independent shoulder lugs which are not connected to the center ribs." (Id. at 10.)

Mr. Rettig further indicated that, in his opinion, the size or width of a tire "very definitely" has a bearing on the appearance of the tread and that such appearance is "absolutely" going to be different if the same tread pattern is applied to a narrow rather than a wide tire. (Id. at 47-48.) In addition, he noted that engineering considerations dictate variations in the size of tread elements to minimize tire noise or pitching:

[M]ost tires today are designed with different size elements in the tread. This is part of a system called the noise treatment in a tire, and it is done to break up the pitch or the frequency at which the tire is turning, so that it does not generate an objectionable noise.

(Id. at 46.) Specifically, he explained that:

If every element is exactly the same size, when the tire is turning at a particular speed, they will all hit the road in sequence and it will generate a particular pitch. Now, by making the size of the elements larger and smaller and spacing these around the tire, what happens is you generate different frequencies with those. Because of that, they tend to cancel each other out, and the tire becomes much quieter on the road.

(Id. at 47.)

On cross-examination, Mr. Rettig conceded that, from a visual standpoint, it was fair to say that, unlike the case with applicant's subject design, both the shoulder lugs and centerline chevrons on opposer's "Super All Traction" tire are substantially identical in size and shape. He added, however, that if noise reduction treatment were currently to be done with such a tire, one "simple" version thereof "would [be to] have three different sizes of elements in the shoulder lugs and the center chevrons would be made correspondingly in three different lengths, small, medium and large length." (Id. at 56.) When asked whether the variations in pitch would be immediately recognizable when one looks at such a tire, Mr. Rettig answered that they would not be since "[i]t takes a trained eye" to spot such differences. (Id. at 57.) He admitted, however, that noticing the differences in size of tread elements was dependent upon the complexity of the particular design, with the variations in some patterns, such as applicant's three-stage lug design, being easier to discern "because the elements are so large ... that you could actually pick it up." (Id.) Mr. Rettig also stated that, while he has never designed a tire which, like applicant's subject design,

features lugs which protrude or overhang the sidewall, such a design in his engineering judgment "could affect the noise [generated], ... but I don't know that for a fact." (Id. at 59.)

Mr. Rettig further indicated his belief that many others in the tire industry have copied opposer's "Super All Traction" tire tread design. Thus, when he sees a tire that has discontinuous lugs extending from a centerline pattern of chevrons, he often confuses such a tire as being a "FIRESTONE" brand, even though the design thereof is not unique to opposer.

In particular, with respect to third-party tire tread designs, Mr. Rettig, testified that he is familiar with an annual publication known as the Tread Design Guide, which "is a compilation of most of the tread patterns that are available on a commercial basis in passenger, trucks and off-the-highway ... designs." (Rettig dep. at 39.) Such guide thus lists and illustrates tires which are actually being sold in a particular year. Mr. Rettig noted, however, that he has never seen any of applicant's tires, including its "Super Swamper TSL" brand tires which incorporates applicant's three-stage lug design, listed in an issue of the Tread Design Guide.

Excerpts from editions of such guide for each of the years 1966 through 1994 illustrate various models of opposer's "Super All Traction" tire which were then in use. In addition, other excerpts from the 1996 edition of the Tread Design Guide, introduced as applicant's Exhibit 5, reveal that a number of tread designs listed under the heading of "SMALL HIGHWAY & LIGHT TRUCK TIRES," which is the category into which both applicant's

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"Super Swamper TSL" and opposer's "Super All Traction" 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.*

**Co-op** *Mud King X/T*

**Crown** *Mud King XT*

**Delta** *Mud Trac X/T*

**Hood** *Mud King XT*

**Madison** *Radial Mud  
King XT*

**Medalist** *Mud King  
XT*

**Miller** *Mud King  
XT*

**National** *Mud Trac*

**Regul** *Trailblazer  
MT*

**Spartan** *Radial  
Mud King XT*

**Stratton** *Mud King  
XT Steel Radial*

Among other things, Mr. Rettig's testimony specifically confirms that, as shown above, such non-directional tires as the Atlas (Canada) Mud King XT, Brunswick Mud King XT, Ceat Traction Grip N.D. and Hood Mud King XT all feature a discontinuous lug and chevron pattern.<sup>8</sup> In fact, according to Mr. Rettig, the 1996

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<sup>8</sup> However, with respect to the Atlas (Canada) tire, Mr. Rettig conceded that he could "see a distinction in the lugs" and thus at first glance he would "probably ... not" think that it is a "FIRESTONE" tire. (Rettig dep. at 67.) Likewise, he admitted that since the Brunswick tire "is distinguished by its sharp angles on the shoulder lugs," he would not immediately think of it as a "FIRESTONE" tire. (*Id.* at 68.) The Ceat tire, he observed, "has considerably more siping, which are

edition of the Tread Design Guide shows many tire designs which are characterized by a discontinuous lug and chevron pattern, but which are still distinguishable from one another. The reason why such a tread design has become fairly common, he added, is "because it has been very successful over the years, and people copy something that is going to perform." (Id. at 71-72.) Mr. Rettig reiterated, however, that he has a "trained eye more or less for these things" and accordingly can readily detect differences in tread patterns. (Id. at 74.)

As to applicant's three-stage lug design, Mr. Rettig testified, with respect to the drawing thereof shown in the Official Gazette, that at first glance all of the lugs in the configuration looked identical inasmuch as "[i]t is not what I would call a drawing that you use to distinguish one particular tire from another". (Id. at 75.) He acknowledged, however, that upon a second glance, "there are [distinguishing] differences in several parts of the tire," although "the drawing is so bad that it ... is very difficult to tell." (Id. at 75-76.) In particular, Mr. Rettig further testified with respect to applicant's subject design as follows:

Q And when you see these various ... lugs, those ... vary from lug to lug, isn't that true?

A Yes, as a matter of fact, they do. But that isn't what you see when you first look at the tire. When you first look

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the slots in the center [of the] lugs," and thus is distinguishable from opposer's "Super All Traction" tire. (Id. at 69.) Nevertheless, as to the Hood tire, Mr. Rettig stated that it "could be misconstrued as a Firestone tire" but that he knows that it "definitely" is not one. (Id. at 70.)

at the tire, you see the chevrons in the center and they appear the same, and you see lugs coming off there that are disconnected from them. And then you start to look at the minor details ... and you see there are differences, but they are not the things that strike you in the eye right off the bat.

Q At least not in the first fraction of a second?

A Correct.

Q But as soon as you spend more than a second or two looking at it, those become readily apparent to you?

A But to a layman, I think you would look at that and never pick those details up.

Q We are asking you what your testimony is here today?

A My testimony is after I look at it, I can pick up differences.

Q After you look at it for more than a second or so?

A Yes, that's correct.

Q You can also pick up differences on the outside lug pattern, as well as on the inside lug pattern?

A That is correct.

(Id. at 78-79.)

Mr. Rettig added, however, that as to the variations in the size of the lugs in applicant's subject design, "it is extremely difficult to tell if this one is smaller or this one or this one," and thus he "couldn't tell which of those is larger or smaller," due to the perspective utilized in the drawing of such design, which he characterized as "a very poor attempt to duplicate" the actual tread pattern on applicant's "Super Swamper

TSL" tires. (Id. at 81 and 87.) Nevertheless, he admitted that after taking a closer look, he "could tell that there were probably some differences, [and] that it probably was not a Firestone tire." (Id. at 93-94.) He also conceded that he was not aware of any version of opposer's "Super All Traction" tire which, like applicant's subject design, has variations in the width of the lug elements. Mr. Rettig stressed that when it comes to tire tread designs, he is "probably one of the oldest experts around"; that as a senior project engineer, he spends most of his time looking at tire tread designs; and that given his trained eye, it is very common for him to notice differences or distinctions in tread patterns which other people, such as customers for tires, do not see. (Id. at 94.) In particular, he stated that, unlike ordinary consumers, "I can immediately see things that they have no idea exist in a tire." (Id.)

In consequence thereof, Mr. Rettig ultimately conceded that, despite what to him is a poor quality representation, the drawing of applicant's subject design does in fact depict the actual tread configuration of applicant's "Super Swamper TSL" tires. While also offering the opinion that such design "is a poor design" from an engineering standpoint,<sup>9</sup> he acknowledged upon viewing one of applicant's tires that, unlike the three-stage lug configuration featured thereon, none of the models of opposer's "Super All Traction" tire has a large discrepancy in

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<sup>9</sup> Specifically, he stated that "there is a lot of trouble with this design" and that, "if I were designing it, I would not design it like this" because the overhanging or protruding lugs "are going to tear

both lug sizes and in the spacing between lugs, nor do any of the lugs overhang the sidewall. (Id. at 100.) He further testified, however, that while he could see such differences when looking "very closely" at one of applicant's "Super Swamper TSL" tires, he "might have trouble" detecting them at a distance of beyond ten to 15 feet away since he "would see the center ribs and the lugs and ... would assume it was a Firestone tire:"

Q Do you think that that tire that you see in front of you is distinct ... from the Super All Traction tire ....?

A As I am looking at it directly above, yes, I can see differences ....

Q So, in your mind, it is a distinct tread design from the Super All Traction tread design?

A Let me qualify that. It has the same center as ours, except these [chevrons] are variable in length. It has different bars [or lugs], but the bars [or lugs] are basically curved, the same as ours. It has differences. But I would not consider them distinct differences.

(Id. at 104-06.)

Applicant, the record shows,<sup>10</sup> is a small family-run enterprise which is engaged in the design, development and

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off very quickly. You get up against a stump, and they are gone." (Id. at 100-01.)

<sup>10</sup> In its main brief, opposer has renewed its objection to applicant's introduction of "pictures and photographs of applicant's SUPER SWAMPER tires into the record ... on the grounds that only the drawing in the application and the specimens filed with the application are relevant." In particular, opposer states that:

[O]pposer objects to Interco's attempt to introduce photographs of its tires, and actual tires, which are different from Interco's tire tread design as shown in the drawing of [opposed] application Ser. No. 74/279,000. Evaluation of whether or not Interco's tire tread design

marketing of light truck and all-terrain vehicle ("ATV") tires. Applicant, through its predecessors, has been involved in such business since its incorporation, originally as Interco Marketing, Inc., in July 1975. Interco Marketing, Inc., which operated such business through its Interco Tire Company division, amended its articles of incorporation on October 10, 1983 to change its name to applicant's present name, Interco Tire Corporation.

Applicant's president, Warren L. Guidry, is the designer of its two-stage lug tires, which were introduced under the "Swamper" name in 1970, and its three-stage lug tires, which were first marketed under the "Super Swamper" designation in October 1977, although the design thereof was begun in late 1972 and completed around 1973. Around 1982, applicant began marketing its three-stage lug concept tires under the "Super Swamper TSL" brand name. According to Mr. Guidry, the terminology "three-stage lug" designates a tire design which has "three distinctly different length lugs in the tread pattern." (Guidry dep. at 11.) In the case of applicant's "Super Swamper TSL" tires, the three-stage lug design therein includes a

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[has acquired distinctiveness or] is confusingly similar is limited to the tire tread design [as shown on the drawing].

While opposer is correct that it is the registrability of the mark as shown on the drawing which is at issue in this proceeding, the pictures and actual samples of applicant's tires, like the photographs thereof submitted as specimens, are admissible to demonstrate the manner in which applicant uses its purported mark. The fact that the proportions--and hence the actual appearance--of applicant's subject design must necessarily vary, depending upon both the width and the circumference of tires on which it is used, does not alter the fact that the basic overall tread pattern, as shown on the drawing, remains essentially the same. Accordingly, opposer's objection is overruled.

repetitive pattern of lugs which Mr. Guidry described as being "[l]ong or large, short or small, and intermediate" in length.<sup>11</sup> (Id.) Although applicant once owned a design patent, covering the ornamental design depicted below,

for its three-stage lug tread design, such patent expired after 14 years on October 13, 1995.<sup>12</sup> Applicant's two-stage lug tread pattern, as shown below,

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<sup>11</sup> Applicant's brief specifically describes its subject design as one in which "the overall tread design includes two outer circumferential rows of tread elements called 'lugs' and two inner circumferential rows of tread elements called 'center treads'." However, "using the letter 'L' for large lug, 'S' for small lug and 'I' for intermediate lug," applicant states in a footnote to its brief that "[t]he repetitive pattern [of its subject design] is made up of sets of four lugs, L,S,I and S. Thus, each set includes two lugs of the same length, and lugs of three different lengths." This description, we note, differs somewhat from the description indicated by Mr. Guidry in the testimony quoted above in that the small lug repeats itself every other element while the large and intermediate lugs repeat themselves every fourth element. Mr. Guidry further testified, in any event, that he "doesn't know of any tires that incorporate a sequence of more than three lugs." (Guidry dep. at 11.)

<sup>12</sup> 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".

is the subject of a Supplemental Register registration which it has received.<sup>13</sup> Applicant's two-stage lug design, however, has not been shown to have been the subject of any utility or design patent, nor has its three-stage lug configuration been the subject of any utility patent or a Supplemental Register registration.

Applicant does not manufacture the tires which it sells. Instead, they are made for applicant, using its molds, by Denman Tire Corporation and Specialty Tires of America. Although applicant still markets its original "Swamper" tire on a limited basis, the focus of its business is principally on the sale of tires bearing its three-stage lug design, rather than those with a two-stage lug configuration, since Mr. Guidry considers the newer design to have a "much better appearance". (Guidry dep. at 10.) Besides the repetition in the pattern of large or long, small or short, and intermediate lugs around the circumference, Mr. Guidry pointed out that tires with applicant's subject design have variations in the spacing between both the shoulder lugs and the centerline chevrons. In addition, he observed that some of

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<sup>13</sup> 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.

the lugs extend beyond the sidewall of the tire, a feature of applicant's three-stage lug design which "makes it distinctly different from any tire on the market today." (Guidry dep. at 15.) In fact, according to Mr. Guidry, who among other things admitted that he is familiar with opposer's "Super All Traction" tire, "there is no other tire in existence today ... that resembles" applicant's three-stage lug design. (Guidry dep. at 13.) Thus, in his opinion, none of the versions of opposer's "Super All Traction" tire is substantially similar in appearance to applicant's "Super Swamper" tires, including its "Super Swamper TSL" products.

Although the application identifies applicant's goods simply as "tires," all of the goods which it sells fall into the category of light truck tires. Applicant has continuously sold tires featuring its subject three-stage lug design since their introduction, as noted earlier, in October 1977. Moreover, according to Mr. Guidry, he knows of no other company, at least with respect to light truck tires, which incorporates a three-stage lug design into their tires. Sales of applicant's original "Super Swamper" tires, which as previously noted began around 1970 and feature the two-stage lug tread pattern which is the subject of its Supplemental Register registration, have also been continuous.

Applicant, during the ex parte prosecution of its application, submitted several declarations in support of its contentions that, inter alia, its three-stage lug design has

acquired distinctiveness.<sup>14</sup> According to the declaration from Mr. Guidry, 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 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.

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<sup>14</sup> Ordinarily, as set forth in TBMP §704 (*emphasis in original*):

While the file of a particular application ... may be of record in a Board inter partes proceeding, by operation of [Trademark Rule] ... 2.122(b) (see TBMP §703.01) or otherwise, the allegations made, and documents and other things filed, in the application ... are not evidence in the proceeding on behalf of the applicant .... Allegations must be established by competent evidence properly adduced at trial, and the documents and other things in an application or ... are not evidence, in an inter partes proceeding, on behalf of the applicant ... unless they are identified and introduced in evidence as exhibits during the testimony period. See: [Trademark Rule] ... 2.122(b). ....

....

Affidavits or declarations in an application ... file cannot be relied upon by the applicant ..., in an inter partes proceeding, as evidence of the truth of the statements contained therein; the statements must be established by competent evidence at trial. ....

....

Although the allegations made and documents and things filed in an application ... are not evidence, in a Board inter partes proceeding, on *behalf* of the applicant ... (unless they are properly proved at trial), they may be used as evidence against the applicant ..., that is, as admissions *against* interest and the like. ....

We note, however, that in this case, opposer states in its main brief that, among other things, the record includes "the file history of application Ser. No. 74/279,000". Consequently, such declarations are deemed to have been stipulated into the record. See Trademark Rule 2.123(b).

1,206,827 for a two-stage lug tire tread design; and applicant is "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 among other things 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 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. Nick Pathiakis,<sup>15</sup> he has been involved in the sale of tires for a number of years. His experience with selling tires began as the owner and operator, until about 1992, of a retail establishment which sold tires, wheels and other accessories for 4-wheel drive vehicles. Since then, he has run a mail-order business which likewise involves the sale of such 4-wheel drive accessories as tires, wheels, winches and suspension lifts. 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" competitions<sup>16</sup> held at exhibitions

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<sup>15</sup> Opposer, in its main brief, has renewed its objection "to the admission into evidence [of the] deposition testimony of Mr. Pathiakis on the grounds that the deponent was not identified during the discovery process." Opposer, however, has failed to substantiate its objection by pointing to any interrogatory or other discovery request which requests the identity of the witness(es) which applicant intended to present at trial. Opposer's objection is therefore overruled. In any event, such objection would appear to have been waived since, as asserted by applicant in its brief:

Opposer was notified of Applicant's intention to take the testimony of Mr. Pathiakis by Notice of Taking Testimony served April 25, 1996. However, the testimony of Mr. Pathiakis was not actually taken until June 24, 1996, two months after Opposer was notified of Applicant's intent to take such testimony. Opposer made no attempt during this two-month period to reopen the discovery period, and, therefore, no prejudice to Opposer should be inferred. Opposer had a full opportunity to cross-examine the witness. The record is devoid of any indication that Applicant intentionally or in bad faith failed to identify Mr. Pathiakis during the discovery process, and Opposer does not and cannot so contend. ....

<sup>16</sup> Such competitions are judged solely on the basis of appearance. In 1992, Mr. Pathiakis won first prize for best mini-truck in the "Show

of 4-wheel drive and off-road vehicles. Applicant's "Super Swamper TSL" tires have accounted for about 75 to 80 percent of Mr. Pathiakis' sales due, in his opinion, to the fact that they are "probably one of the most aggressive looking tires on the market, [and are] pretty much a unique design ...." (Pathiakis dep. at 8.) By an "aggressive looking tire," Mr. Pathiakis indicated that he meant that "the lug pattern on the tire[,] as far as the way the lugs appeared on the sidewall and the way they were staggered[,] made it look above and beyond the normal tire ...." (Id.)

Mr. Pathiakis, who is also familiar with tires made by such manufacturers as Bridgestone/Firestone, Goodyear, Dick Cepek, Denman and Gateway, testified that he can identify applicant's subject tire tread design "[b]y the different sized lugs on the side of the tire" and by "how they stagger the pattern back and forth and raise from small to large." (Id. at 9.) He further indicated that he has not seen any other tires which have a tread pattern like that shown in applicant's three-stage lug design. In this regard, Mr. Pathiakis stated that he bought and uses applicant's "Super Swamper TSL" tires "[b]asically for the way they look" rather than how they function. (Id. at 10.) The reason why the appearance of such tires was the factor leading to their selection, he indicated, was that he "competed in a lot of shows with a truck that we

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and Shine" category at an exhibition held in Bloomsburg, Pennsylvania. A previous version of his truck, featuring applicant's "Super Swamper TSL" tires, appeared in a photograph on the front cover of the October 1990 issue of Off-Road magazine.

built, and we were trying to find the most radically looking tire that was on the market ..., and this one definitely stuck out."

(Id.) Specifically, he noted that he chose applicant's "Super Swamper TSL" tires "because they were the most aggressive, unnatural looking tires that were available." (Id. at 22.)

While Mr. Pathiakis added that the 1996 Tread Design Guide shows that there are "quite a numerous amount" of competing tire designs, such as the Atlas (Canada) Mud King XT (illustrated previously), which are "aggressive tread-wise," he observed that none of those "is at all similar [in appearance] to the Super Swamper tire." (Id. at 16-17.) To Mr. Pathiakis, the reason therefor is that "the Super Swamper tire is quite a unique tire" in that "the side lugs ... protrude out beyond the sidewall of the tire" to a "profound" degree which is "really noticeable" compared to what is "the norm of a regular mud tire." (Id.) Moreover, with respect to both the directional and non-directional versions of opposer's "Super All Traction" tire, Mr. Pathiakis noted that he does not consider such models to be designs which are in competition with applicant's subject design because the former are "older design tires" and, as such: "They're not ... the state-of-the-art design that they have nowadays. They don't have protruding lugs on the side at all." (Id. at 18.) In consequence thereof, Mr. Pathiakis indicated that, while the parties' tires are classified as traction tires,

he can "definitely" distinguish applicant's three-stage lug design from the designs utilized by opposer.<sup>17</sup> (Id.)

Mr. Pathiakis also remarked, when asked whether he had seen many other tires which look similar to the various versions of opposer's "Super All Traction" tire, that "[q]uite a few manufacturers make a traction tire like that." (Id. at 32.) He stated, however, that since applicant's "Super Swamper TSL" tires are the only ones which feature aggressive, overhanging lugs, the company with which he associates such a distinguishing feature is applicant. To him, "[t]he thing that comes to mind every time you see a Super Swamper[,] that catches your attention[,] is that three-stage lug, the large lugs that protrude out the side of the tire." (Id. at 33.) According to Mr. Pathiakis, not only has no other manufacturer copied applicant's subject design, but he is not aware, as of the June 24, 1996 date of his deposition, of "anybody that's built anything closely" resembling such design "at all."<sup>18</sup> (Id. at 35.)

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<sup>17</sup> The latter, in his opinion, bear no resemblance "at all" to applicant's subject design. (Pathiakis dep. at 29-30.)

<sup>18</sup> Mr. Pathiakis nevertheless conceded on cross-examination that, as an enthusiast who exhibits his show truck in contests which are judged solely upon the appearance of the vehicles, he is cognizant of details which ordinary consumers might miss. In particular, he testified as follows:

Q With all the time you've spent with your truck, you've really gotten to know a lot of the details about the tread on your tires.

A Yes.

....

Q You have an enthusiast's perspective on your tires?

A Yes.

In the opinion of Mr. Pathiakis, applicant's "Super Swamper" tires, particularly in the larger sizes thereof, are "well known" inasmuch as "[t]hey're basically the most ... asked for when one's selling tires." (Id. at 36.) Their popularity, he added, is due "more for the look of the tire" rather than because they provide better traction. (Id.) Nevertheless, on cross-examination, he admitted that when he ran his retail store, he only "rarely" (once or twice) sold tires to customers who owned sport utility vehicles which had not been modified and thus were primarily for street rather than off-road use. The reason therefor, he indicated, is that "[t]he people that buy new vehicles like that aren't looking for a tire like the Super Swamper, because to them, it's too aggressive, and they want a tire that's more like an all-terrain, quieter looking tire." (Id. at 58.)

Consequently, while applicant's "Super Swamper TSL" tires are approved for street use by the U.S. Department of Transportation and Mr. Pathiakis has seen such tires on trucks which are highway driven, he admitted that it typically would take a lot of time and attention before an ordinary consumer would recognize that such tires look different from other tires, even though for him the differences therein are immediately apparent. Still, according to Mr. Pathiakis, the reaction of his

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Q And its different from a commercial truck owner's perspective?

A Yes; definitely.

(Id. at 55-56.)

retail store customers upon seeing applicant's subject three-stage lug design was that "[t]hey were amazed that there could be anything that radically designed as far as being a tire" was concerned. (Id. at 61.) He further admitted, however, that while not drawing "quite as big a reaction, ... there are other tires on the market that are a little bit unique, too." (Id.)

Mr. Guidry, in his testimony, admitted that, of the tires shown in the 1996 edition of the Tread Design Guide, it was fair to say that those with large, aggressive tread designs, such as the Ceat Traction Grip N.D., Cascade Radial Mud XT and various brands of Mud King XT tires,<sup>19</sup> are in competition with applicant's Super Swamper TSL" tire. Mr. Guidry maintained, however, that in his opinion, none of the tires shown in such guide is either substantially similar to or otherwise closely resembles the three-stage lug design utilized by applicant. Furthermore, Mr. Guidry indicated that 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

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<sup>19</sup> According to Mr. Guidry, those tires and others with similar tread patterns are "generic" in the sense that "they're made from the same green tire. They make slight changes so that they can market it under a different brand name." (Guidry dep. at 76.) In this regard, he further testified that:

Q Who makes it; do you know?

A General makes a lot of them, B.F. Goodrich makes a lot of them, such as all of these that were shown as Mud King .... The Mud King is a tire made by B.F. Goodrich that may be sold under five, six, seven, eight different names. I'm not sure.

(Id. at 76.)

distinguishing feature of its tires. He observed, instead, that most tire sellers "in the industry use what I would call no-stage or two-stage" lug designs. (Guidry dep. at 66.) In particular, he characterized the directional version of opposer's "Super All Traction" tire as having a two-stage lug design with a "[m]edium" aggressive tread. (Id.)

Mr. Guidry also acknowledged, however, that the two-stage lug tread design on applicant's original "Swamper" tire is "distinct" in appearance from the subject three-stage lug design utilized in its "Super Swamper TSL" tires. (Id. at 118.) The former, however, presently is not one of applicant's main products and thus does not account for a large amount of its sales. Applicant, in any event, has not taken legal action against the many third parties who are selling tires which are essentially copies of such design due to a recognition, according to Mr. Guidry, that its ownership of a Supplemental Register registration for the design is not necessarily indicative of having exclusive rights therein and that the design has "become public domain, essentially." (Id. at 120.) Mr. Guidry noted, moreover, that applicant has principally "moved on from that design" to marketing tires with its subject three-stage lug configuration. (Id.) While the precise sales figures for the latter (unlike those stated 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 may be characterized as one of a steady increase, with sales of

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some sizes and models rising to a level of at least several hundred thousand dollars annually.<sup>20</sup>

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. Such literature has been disseminated to individuals, distributors and dealers. Applicant has also distributed T-shirts imprinted with a "footprint" of its subject tread design<sup>21</sup> (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" (with the last two phrases in much smaller size than the first phrase). Such T-shirts have been disseminated to applicant's distributors and to retail customers.<sup>22</sup> In addition, applicant has promoted its goods through the use of banners picturing various models of its tires, including those which incorporate its three-stage lug design. Such banners have been provided to applicant's dealers to hang as advertising in their

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<sup>20</sup> 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.

<sup>21</sup> According to Mr. Pathiakis, the term "footprint" means the imprint or "actual pattern [which] the tire makes" upon contact with a surface. (Pathiakis dep. at 38.)

<sup>22</sup> It would appear, however, that the distribution of such T-shirts has neither been continuous nor relatively extensive. Specifically, when Mr. Pathiakis was shown one of applicant's T-shirts and asked whether he had "seen the footprint promoted on any clothing or other advertising materials from Interco," he replied: "I've seen it on a

retail stores and service areas. Currently, since applicant is "not doing any magazine advertising," the only advertising which it does "is in the form of making banners and product brochures available." (Id. at 49.)

Applicant, however, 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, Dirt Wheeler, Four Wheeler, Peterson's Four Wheeler & Off-Road and Sport Utility. Moreover, unlike applicant, 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, which Mr. Guidry testified is a copy of the two-stage lug design of applicant's original "Swamper" tire,<sup>23</sup> and a Sport King Mud King XT.<sup>24</sup> Applicant's distributors also advertise its tires in trade journals at no cost to applicant.

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T-shirt long ago similar to this quite a few years back. I didn't know they still made these shirts." (Pathiakis dep. at 40.)

<sup>23</sup> According to Mr. Guidry, Gateway "copied it around 1972 or '73" and, as far as he knows, is still using such design. (Guidry dep. at 73.)

<sup>24</sup> The Sport King Mud King XT is identical in appearance to the other brands of "Mud King XT" tires which have been depicted previously in this opinion. In addition, Mr. Guidry confirmed that all of the other brands of tires shown in such ad are in the same general category as are applicant's "Super Swamper" tires.

Mr. Guidry, like Mr. Pathiakakis, demonstrated an ability in his testimony to identify certain brands of tires by their tread designs. For example, when shown an article from the October 1990 issue of Off-Road magazine, which pictured a sport utility vehicle with tires having a prominently displayed tread pattern, he testified on cross-examination as follows:

Q [I] ask you whether you know whose tires those are?

A It's the Gumbo Monster Mudder, which is a copy of our original Swamper.

Q How are you able to identify the tire?

A I have to answer that humorously. It's like knowing your own child.

Q You know tire designs real well.

A Yes.

Q And you pick up little details that other people would miss.

A Yes; and I designed that tire.

(Id. at 85.)

Mr. Guidry, as mentioned earlier, is familiar with opposer's "Super All Traction" tire and testified that such tire "has been around for twenty-five or thirty years ... or longer". (Id. at 110-11.) He admitted, in fact, that such tire was in use not only before applicant was started, but was also in use prior to his designing both the three-stage lug and two-stage lug designs utilized, respectively, in connection with applicant's "Super Swamper" and "Swamper" tires. Applicant, however, has no knowledge of anyone who has been confused, mistaken or deceived as to the source of the parties' goods or as to any relationship

between the parties. In particular, Mr. Guidry testified that he knows of no one who has mistakenly identified one of applicant's tires as opposer's "Super All Traction" tire. Mr. Guidry additionally noted, however, that while he has been in the tire business for 30 to 40 years, to his knowledge none of applicant's tire tread designs has ever been shown in an issue of the Tread Design Guide even though applicant presently has "many tread designs" instead of just one. (Id. at 68.)

Turning first to the issue of whether applicant's subject tire tread design, although de facto functional, has nevertheless acquired distinctiveness, we note at the outset that inasmuch as applicant seeks registration thereof 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, as to whether it must be shown initially that others, including opposer, are using tire 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, ATV and other maximum traction tires which has been utilized for many years by opposer and other in the tire industry.<sup>25</sup> 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 materials, the evidence nevertheless is insufficient to establish acquired distinctiveness. As applicant acknowledges 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. In this case, because

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<sup>25</sup> 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 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.

applicant's three-stage lug tire tread design, like the guitar peg head in *Yamaha*, constitutes the appearance of the product, it is highly descriptive of the applicant's goods.

As shown by the pages from the various editions of the Tread Design Guide which have been made of record, there are numerous tire tread designs which have been in use by opposer and others over the years in which, like applicant's subject design, chevrons are used in dual centerline rows. Chevrons plainly are a common shape for the centerline treads on tires. The fact, therefore, 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 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 less than a year later on September 26, 1996, 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 Cascade Radial Mud XT, the Delta Mud Trac, the National Mud Trac, the Regal Trailblazer MT 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 opposer's "FIRESTONE" brand "Super All Traction" tire (both directional and non-directional models)<sup>26</sup> and the tread pattern on the Ceat Traction Grip tire. Applicant, in this regard, concedes in its brief that it "does not dispute the fact that many tire designs, including Opposer's Super All-Traction tires, include tread patterns incorporating two outer rows of lugs and

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<sup>26</sup> To be clear, we find that the heavy-duty, non-directional version of such tire (which was introduced about 1979 or 1980 and is the one depicted on the left in the illustration of the models of opposer's tire previously reproduced in this opinion), is the most similar version of opposer's tire to the subject three-stage lug design of applicant's "Super Swamper TSL" tires.

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, 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 ATV tires by 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 design<sup>27</sup> 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 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

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<sup>27</sup> Although, as previously indicated, applicant has also continuously sold tires since 1970 which feature the two-stage lug design which is the subject of its Supplement Register registration, such sales have not only been relatively insignificant, but more importantly, as applicant's president admitted, such design is distinctly different in appearance from applicant's subject design.

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.<sup>28</sup>

Furthermore, as indicated previously, applicant has acknowledged that the greater the degree of descriptiveness which 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 opposer and 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

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<sup>28</sup> 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.

particular three-stage lug configuration, it simply cannot be said, in light of the uses by opposer and many 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.<sup>29</sup> 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 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

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<sup>29</sup> 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 ...."

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 distributing 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",<sup>30</sup> 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 furnishes 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

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<sup>30</sup> Although applicant promotes that descriptive phrase, as well as the term "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.

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].

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

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In re Honeywell Inc., 187 USPQ 576, 578 (TTAB 1975), stated in In re R.M. Smith, Inc., 734 F.2d 1482, 222 USPQ 1, 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, ATV and other maximum traction tires, by their tread patterns. Admittedly, those in the 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.

Nevertheless, in the event that our finding that applicant's de facto tire tread design lacks distinctiveness is ultimately reversed, we turn to the remaining issues of priority of use and likelihood of confusion raised by opposer's

alternative claim. Opposer argues basically that in light of its continuous use of the tread patterns on its "Super All Traction" tire since 1954, it has priority of use. While applicant "does not dispute that the Super All-Traction directional tire shown on the right [of the illustration of the versions of opposer's tire reproduced previously] has been sold since 1954," applicant correctly points out that "the record is undisputed that the other two tread designs were not introduced until at least twenty-five (25) years after the introduction of the first Super All-Traction tire in 1954." Specifically, inasmuch as the non-directional versions of such tire, including the heavy-duty model which is the most similar of the tread designs used by opposer, were not marketed by opposer until 1979 or 1980 at the earliest, applicant maintains, in light of the continuous use of its subject tread design since October 1977, that it "enjoys priority of use of its mark with respect to both of Opposer's Super All-Traction tires." According to applicant, "the only issue under ... [the alternative claim of priority of use and likelihood of confusion] is Opposer's use of its Super All-Traction directional tire."

Neither party, however, has focused its attention on the real issue determinative of the question of priority in this case, which is which party has priority of secondary meaning (i.e., acquired distinctiveness) for its respective tire tread pattern(s). Given the fact that both parties utilize what, as stated earlier, is essentially a common basic design for the tread patterns found on mud, ATV and other maximum traction

tires, such patterns are lacking in inherent distinctiveness. Applicant, as also noted above, has properly acknowledged that the greater the degree of descriptiveness which a design--such as a tire tread pattern--possesses, the heavier is a party's burden of proving that the design has in fact become distinctive of the goods with which it is associated. See Yamaha International Corp. v. Hoshino Gakki Co. Ltd., supra at 6 USPQ2d 1008. Here, given the high degree of descriptiveness inherent in tire tread designs, opposer must show, in order to have priority therein, that the tread pattern for each of the versions of its "Super All Traction" tire has acquired distinctiveness prior to either applicant's subject design having acquired distinctiveness or, in the absence thereof, the May 27, 1992 filing date of the involved application, which is otherwise the earliest date upon which applicant can rely for priority purposes. See, e.g., Lone Star Manufacturing. Co., Inc. v. Bill Beasley, Inc., 498 F.2d 906, 182 USPQ 368, 369 (CCPA 1974) and Columbia Steel Tank Co. v. Union Tank & Supply Co., 277 F.2d 192, 125 USPQ 406, 407 (CCPA 1960).

Thus, as pointed out by the Board in Perma Ceram Enterprises Inc. v. Preco Industries Ltd., 23 USPQ2d 1134, 1138 (TTAB 1992):

[T]he controlling law ... is that where the mark [or trade dress] relied upon by a plaintiff in support of its priority of use and likelihood of confusion claim is ... descriptive ..., then the plaintiff must establish priority of acquired distinctiveness. As noted above, the priority contest ... is not solely one of who used the mark [or trade dress] first chronologically-- rather, the test is which party first achieved secondary meaning in its mark [or

trade dress]. See: J. T. McCarthy,  
*Trademarks and Unfair Competition*, Section  
16:12 (2d ed. 1984). ....

As we have previously found in this opinion, nothing in the record shows that the purchasing public, unlike some members of the tire industry, identifies and distinguishes the source of tires of any kind, much less mud, ATV and other maximum traction tires, by their tread patterns. The evidence is simply lacking that ordinary retail purchasers, without the years of experience and specialized knowledge of those in the tire field, are able to discern relatively minor differences in the details of tread designs, particularly in instances where the tread patterns essentially involve mere refinements of a common basic design.

The record in this proceeding reveals, as is the case with applicant's subject design, that third parties have used tread designs for maximum traction tires which are substantially similar to those utilized by opposer in the versions of its "Super All Traction" tire. Moreover, in some instances, the third-party tread designs have been indicated to be virtually identical to opposer's tread patterns. In particular, one of opposer's own witnesses testified that:

Q All right. Mr. Rettig, do you believe that many other people have copied the Super All Traction tire tread design?

A Yes, I believe it has been copied many times.

Q And so when you see a tire that has a lug that is discontinuous [and has a centerline] in a chevron pattern, do you believe that that is a Firestone tire?

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A We often confuse them, yes. You see them in the field on a truck, and you think that is your tire and you walk up to it and it is not.

Q Okay. So having a discontinuous lug [and a centerline] in a chevron pattern is not something that is unique to Firestone?

A No, I believe that's correct, it is not unique to Firestone.

(Rettig dep. at 65-66.) Just as in the case of applicant's three-stage lug configuration, we are not convinced in view thereof that the purchasing public has come to view any of the tread patterns on opposer's "Super All Traction" tire as having acquired secondary meaning as a source indicator. Such designs, instead, are merely minor variations of a common basic design for mud, ATV and other maximum traction tires, and thus they share essentially the same aggressive or radical appearance due to the presence in each of dual centerline chevrons and prominently large lugs. As applicant persuasively points out, "[i]f Mr. Rettig, a tire engineer who has been working for Opposer for 37 years, cannot tell when he sees a tire having the asserted tread design that it is a tire of Opposer, the asserted design clearly is not distinctive and ... cannot operate as [a] source identifier to ordinary tire consumers."

Consequently, notwithstanding over 40 years of continuous use by opposer of the directional version of its "Super All Traction" tire and over 25 years of continuous use of the non-directional models thereof, such use plainly has not been substantially exclusive on the part of opposer and has not

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resulted in secondary meaning for the tire's tread patterns. Furthermore, in light of the total absence on this record of any sales and advertising figures, along with the lack of any advertisements or other marketing materials which even arguably demonstrate that opposer has promoted its various tread designs as trademarks instead of just picturing what its products look like, opposer has simply failed to establish that any of the tread pattern designs on the versions of its "Super All Traction" tire has acquired distinctiveness prior to any date upon which applicant can rely.

Accordingly, even if one or more of opposer's tire tread designs were to be considered as so closely resembling applicant's subject tire tread design as to be likely to cause confusion, because opposer has not shown priority of secondary meaning therein, its alternative claim must fail.

**Decision:** The opposition is sustained, and registration to applicant is refused, as to the ground that applicant's three-stage lug tire tread design is de facto functional and has not acquired distinctiveness, but the opposition is dismissed with respect to the ground of priority of use and likelihood of confusion.

R. F. Cissel

E. W. Hanak

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G. D. Hohein  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board