

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB AUGUST 13, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

TBC Corporation
v.
The Hercules Tire & Rubber Company

Opposition No. 103,349 to application Serial No. 75/000,029
filed on October 2, 1995

Marsha G. Gentner and Andrew J. Gray, IV of Jacobson, Price,
Holman & Stern, PLLC for TBC Corporation.

Donald R. Fraser and Richard G. Martin of MacMillan, Sobanski &
Todd, LLC for The Hercules Tire & Rubber Company.

Before Hohein, Wendel and Bucher, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

The Hercules Tire & Rubber Company has filed an
application to register the mark "GRAND VALLEY" for "tires for
motor vehicles".¹

TBC Corporation has opposed registration on the ground
that, "long prior to the filing date of the application opposed
herein, Opposer has, and is now, engaged in the marketing,

¹ Ser. No. 75/000,029, filed on October 2, 1995, which alleges a *bona fide* intention to use the mark in commerce.

distribution and sale of vehicle tires, wheels and other motor vehicle products ... under and in connection with the trademarks GRAND PRIX, GRAND AM, GRAND SPORT and GRAND SPIRIT [hereinafter ... referred to as Opposer's 'GRAND Mark(s)']; that opposer is the owner of valid and subsisting registrations for the following "GRAND Mark(s)" and associated goods and services:

(1) the mark "GRAND PRIX," which is registered for (a) "automobile tires";² (b) "motor vehicle parts--namely, wheels";³ (c) "motor oil" and "filters and oil filters for land vehicles and shock absorbers";⁴ (d) "storage batteries for automobiles and trucks";⁵ (e) "mufflers and brake parts for automotive vehicle[s]";⁶ (f) "battery chargers and battery cables";⁷ (g) "car wash services";⁸ and (h) "vehicle chassis parts; namely, ball joints, bushings, control arms, drag links, idler arms, stabilizer links, tie

² Reg. No. 690,249, issued on December 22, 1959, which sets forth a date of first use of February 13, 1959 and a date of first use in commerce of March 17, 1959; renewed.

³ Reg. No. 1,075,901, issued on October 25, 1977, which sets forth dates of first use of November 6, 1975; renewed.

⁴ Reg. No. 1,157,619, issued on June 16, 1981, which sets forth dates of first use of August 17, 1978; combined affidavit §§8 and 15.

⁵ Reg. No. 1,183,571, issued on December 29, 1981, which sets forth dates of first use of March 6, 1980; combined affidavit §§8 and 15.

⁶ Reg. No. 1,224,147, issued on January 18, 1983, which sets forth dates of first use of November 5, 1981; combined affidavit §§8 and 15. As subsequently amended, such registration shows the mark in the format reproduced below:

⁷ Reg. No. 1,258,438, issued on November 22, 1983, which sets forth dates of first use of July 14, 1982; affidavit §8.

⁸ Reg. No. 1,655,035, issued on August 27, 1991, which sets forth dates of first use of August 5, 1987; affidavit §8.

rod ends, constant velocity joints, and king bolts";⁹

(2) the mark "GRAND PRIX RADIAL G/T" and design, as illustrated below,

which is registered for "automobile vehicle tires";¹⁰

(3) the mark "GRAND SPORT," which is registered for "vehicle tires";¹¹ and

(4) the mark "GRAND SPIRIT," which is registered for "vehicle tires";¹²

and that applicant's mark, when used in connection with its goods, so resembles opposer's "GRAND Mark(s)" as to be likely to cause confusion, mistake or deception.

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

⁹ Reg. No. 1,926,381, issued on October 10, 1995, which sets forth dates of first use of December 1992.

¹⁰ Reg. No. 1,164,594, issued on August 11, 1981, which sets forth dates of first use of March 3, 1980; combined affidavit §§8 and 15. The terms "RADIAL G/T" are disclaimed.

¹¹ Reg. No. 1,421,825, issued on December 23, 1986, which sets forth dates of first use of February 25, 1986; combined affidavit §§8 and 15.

¹² Reg. No. 1,958,273, issued on February 27, 1996, which sets forth dates of first use of January 1987.

The record includes the pleadings; the file of the involved application; and, as part of opposer's case-in-chief, the testimony, with exhibits, of its director of communications, James R. Pascover. Opposer, as the rest of its case-in-chief, submitted notices of reliance upon: certified copies of its pleaded registrations; applicant's responses to opposer's requests for admissions;¹³ and applicant's answers to certain of opposer's interrogatories and requests for production of documents.¹⁴ Applicant, however, did not take testimony, nor did it otherwise introduce any evidence in its behalf. Briefs have been filed,¹⁵ but an oral hearing was not requested.

Opposer's priority of use of its "GRAND PRIX," "GRAND SPORT" and "GRAND SPIRIT" marks is not in issue inasmuch as the certified copies of its registrations therefor show that, in each instance, such registrations are subsisting and owned by opposer. See King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). The record, as noted below, establishes in any event that opposer's use of such marks in connection with automobile or vehicle tires is prior to the

¹³ While several of applicant's requests for admissions refer to attached copies of exhibits A and B, which assertedly are copies of letters from counsel for opposer to applicant's attorney, such exhibits are not attached to the notice of reliance and thus are not of record herein.

¹⁴ Although responses to requests for production of documents are not proper subject matter for a notice of reliance, inasmuch as applicant has in effect treated such responses as constituting part of the record, they are considered to have been stipulated into the record pursuant to Trademark Rule 2.123(b).

¹⁵ Opposer's consented motion for an extension of time to file its reply brief is granted.

October 2, 1995 filing date of applicant's application, which is the earliest date upon which applicant can rely in this case since it failed to take testimony or otherwise present any evidence in its behalf.¹⁶ The record also indicates that opposer likewise has priority of use of its "GRAND AM" mark for tires for automobiles. The only real issue to be determined in this proceeding,¹⁷ therefore, is whether applicant's "GRAND VALLEY" mark, when used in connection with tires for motor vehicles, so resembles opposer's "GRAND PRIX," "GRAND AM," "GRAND SPORT"

¹⁶ 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).

¹⁷ Opposer, in its main brief, contends that this proceeding presents an additional "issue as to whether Applicant actually had a *bona fide* intent to use the ... GRAND VALLEY mark as of the filing date of that application." Specifically, citing Commodore Electronics Ltd. v. CBM Kabushiki Kaisha, 26 USPQ2d 1503 (TTAB 1993), opposer insists that "the record herein reveals an absence of any evidence to establish that Applicant ... possessed ... a *bona fide* intent to use the GRAND VALLEY mark at the time it filed the opposed application." Opposer's claim that applicant lacked a *bona fide* intention to use such mark, however, was neither pleaded in the notice of opposition nor, despite the fact that applicant has responded to the merits thereof in its brief, can it be fairly said that the pleadings should be deemed to be amended in accordance with Fed. R. Civ. P. 15(b) because the issue was tried by the express or implied consent of the parties. Thus, not only has applicant not been given adequate notice of such a claim, but in any event the record is simply devoid of any evidence to establish that as of the filing date of the opposed application, applicant lacked a *bona fide* intention to use such mark. While opposer asserts that applicant's responses to certain interrogatories and requests for production show that applicant had no documents to support its claim of a *bona fide* intent to use the "GRAND VALLEY" mark for tires, a careful reading of such responses demonstrates that applicant actually referred to "a search printout received from Applicant's attorney dated September 21, 1995" and stated that it did not have any documents "apart from the documents produced in response to preceding requests." In view thereof, and since it is clear from the admission in the record that applicant is a competitor of opposer that applicant has the capacity to market and/or manufacture tires and thus is not a newcomer to the field, the claim by opposer that applicant lacked a *bona fide* intention to use the "GRAND VALLEY" mark for tires is plainly without merit. See Commodore Electronics Ltd. v. CBM Kabushiki Kaisha, supra at 1507.

and/or "GRAND SPIRIT" marks for vehicle tires¹⁸ that confusion is likely as to the source or sponsorship of the parties' respective goods.¹⁹

According to the record, opposer began business in 1956 as Cordovan Associates and, upon going public in 1983, became known as TBC Corp. Opposer's business consists of marketing and distributing private brand vehicle tires,²⁰ including replacement passenger tires and performance tires, which it does under its three principal house marks of "CORDOVAN," "MULTI-MILE" and "SIGMA". Opposer does business in every state of the United States and, in terms of units sold, is the fourth largest seller of tires,²¹ trailing only Goodyear, Firestone and Michelin, which constitute the three major manufacturers of tires. Opposer sells its vehicle tires to regional distributors, who resell such goods to retailers within the distributor's territory, and directly to

¹⁸ In light of the statement in opposer's main brief that "the only issue ... is whether there exists a likelihood of consumer confusion between TBC's GRAND Marks and the Opposed mark, both as used for tires," no further consideration will be given as to whether applicant's "GRAND VALLEY" mark is likely to cause confusion with opposer's "GRAND PRIX" mark for car wash services or for any of its automotive products other than vehicle tires.

¹⁹ Although applicant argues at length in its brief that opposer has failed to establish that it has a family of "GRAND" marks, opposer in its reply brief stresses that it "has neither pleaded, nor argued herein, the existence of a family of GRAND Marks." The issue of likelihood of confusion, as indicated above, must accordingly be determined by comparing applicant's mark for its goods with each of opposer's marks for its vehicle tires.

²⁰ Such a tire, according to Mr. Pascover's testimony, is one which "is marketed under a brand name which is different from the name of the tire's manufacturer." (Pascover dep. at 11.)

²¹ In particular, opposer holds a market share of "six and a half percent," which Mr. Pascover testified is "an enormous share of the replacement tire market." (Id. at 17.)

major retailers, who in turn sell opposer's vehicle tires through independent tire retailing outlets. Opposer's tire retailers include free-standing tire stores, major automotive retailers, gas stations and service garages. Most of such retailers also sell other brands of tires.

Opposer uses the marks "GRAND PRIX" and "GRAND AM" in connection with passenger tires and performance tires and has continuously done so since, respectively, about 1959 and the late 1970s. Opposer uses the mark "GRAND SPORT" for passenger tires and light truck tires and has continuously done so since the middle to late 1980s. Opposer, in addition, uses the mark "GRAND SPIRIT" for passenger tires and has continuously done so since the late 1980s. In each case, such marks appear on the sidewalls of such tires and on tire labels affixed to the goods. The marks are also used on a variety of point-of-sale merchandising materials including posters, banners, tire centers, tire toppers, display racks, outdoor signs, product specification sheets, pocket catalogs and warranty booklets. Opposer distributes such materials for use by its dealers and their retail outlets, and it also prepares occasional radio ads and provides camera-ready art for use in newspaper advertising.

While opposer's "GRAND SPIRIT" passenger tires are sold under each of its three house marks, its "CORDOVAN" dealers also sell its "GRAND PRIX" tires. Similarly, its "MULTI-MILE" dealers also offer its "GRAND AM" tires, while its "SIGMA" dealers, instead, additionally carry its "GRAND SPORT" tires. Opposer

also has customers who buy all four of such brands of tires.²² According to Mr. Pascover, opposer's retail customers are accustomed to seeing more than one brand of tire with a "GRAND"-formative mark being sold in the same retail outlet and thus, in his opinion, applicant's "GRAND VALLEY" tire "would look like another TBC tire in a retailer's showroom." (Pascover dep. at 112.) However, while acknowledging, on cross-examination, that tires bearing all four of its "GRAND"-based marks would not typically be sold together by a retailer which opposer directly supplies, Mr. Pascover reiterated that opposer has wholesale customers "who buy all four brands" and that "they could in turn sell them all to a single retail outlet." (Id. at 124-25.)

From 1991 until September 1997, opposer has had "sales of about seven hundred million ... on behalf of the Grand marks" for its vehicle tires. (Id. at 94.) In particular, Mr. Pascover indicated that opposer's sales of its "GRAND PRIX" tires were "in the neighborhood of about two hundred million dollars," while

²² Specifically, Mr. Pascover testified as follows:

Q. Do any of TBC's customers sell tires from more than one of TBC's product lines?

A. Yes.

....

Q. Does TBC have any customers who buy Grand Prix, Grand Am, Grand Sport and Grand Spirit tires?

A. Yes, we do.

Q. Could you name one of these?

A. Carroll Tire in Hapeville, Georgia, would buy all four.

(Id. at 92-93.)

those of its "GRAND SPORT" tires were approximately "fifty million" dollars, its "GRAND SPIRIT" tires were "about a hundred million" dollars and its "top selling" "GRAND AM" tires were "about three hundred and fifty million" dollars. (Id. at 94-95.) During the same period, opposer has spent \$2.3 million on advertising materials featuring its pleaded marks and estimates that sellers of its tires have, in turn, expended a comparable amount to advertise such goods.

Opposer has policed its marks, having in particular "opposed [the mark] Grand Country [for tires] and ... received a preliminary injunction against the manufacturer and their use of that designation." (Id. at 114.) Other than such mark, Mr. Pascover testified that he is not aware of any two-word marks for tires which include the word "grand" in the marks. Mr. Pascover nevertheless acknowledged on cross-examination that, as to marks for tires in which the terms "grand" or "gran" have been run together to form a single designation, he has "twice" seen the mark "Grandtrek" and that opposer has "had some discussions about" the "name Grandtour, one word." (Id. at 123-24.) No indication was given, however, as to the extent of such uses, nor were there any other reported instances of third-party use.

The record contains relatively little information about applicant, although it does establish that applicant is a competitor of opposer. Like opposer, applicant sells its motor vehicle tires to tire wholesalers, distributors and retailers. In particular, applicant intends for its "GRAND VALLEY" mark to

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be used in connection with tires which will be sold through independent tire dealers in the tire replacement market. Although, prior to adopting its "GRAND VALLEY" mark, applicant was aware of opposer and its "GRAND PRIX," "GRAND AM," "GRAND SPORT" and "GRAND SPIRIT" marks for tires, there is nothing in the record which suggests that applicant adopted its mark in bad faith or otherwise seeks to trade on the goodwill in opposer's marks. Applicant, however, has yet to use its "GRAND VALLEY" mark in connection with any products or services. Moreover, while it has received various communications which mention opposer and/or opposer's "GRAND"-prefixed marks, such have been in the form of "catalogs, advertisements and other general business communications." (Answer to Interrogatory No. 16(b).)

Turning to the issue of likelihood of confusion, we find upon consideration of the pertinent factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973), that confusion as to source or affiliation is likely to occur. As a starting point, the parties' vehicle tires must be considered to be legally identical goods and, as such, would be sold through the same channels of trade to the identical classes of purchasers. Consequently, if the goods were to be sold under the same or similar marks, confusion as to the source or sponsorship of the parties' tires would be likely to occur.

Applicant, with respect to the parties' marks, contends among other things that opposer's marks "are weak and should be afforded a narrow scope of protection" because each contains "the common, laudatory prefix GRAND." The record, however, is devoid

of any evidence that such term is in common use by third parties in connection with marks for tires or other automotive products. Moreover, while the term "GRAND" undoubtedly possesses a laudatory significance, our principal reviewing court (one panel member dissenting), in reversing this Board and finding a likelihood of confusion between the mark "GRAND SLAM" for tires for motor vehicles and opposer's mark "GRAND AM" for automobile tires, stressed in *TBC Corp. v. Holsa Inc.*, 126 F.3d 1470, 44 USPQ2d 1315, 1318 (Fed. Cir. 1997), that:

It does not matter that GRAND is "laudatory," a characteristic the Board thought contributed to its "weakness" as a trademark. It is a major contributor to overall similarity.

Moreover, while opposer's advertising expenditures have been relatively meager, it has nevertheless enjoyed substantial sales during the most recent several years for which sales figures were provided. As a result of such sales success, opposer's "GRAND PRIX," "GRAND AM," "GRAND SPORT" and "GRAND SPIRIT" marks must be regarded as strong marks which have gained a measure of customer recognition and are entitled to a correspondingly broader scope of protection, notwithstanding the suggestiveness inherent therein.

Applicant nevertheless further asserts that confusion is not likely because the respective marks are readily distinguishable by their suffix portions, which in combination with the term "GRAND" create marks which "are distinct in their sound, appearance, meaning and overall commercial impression." However, as opposer correctly notes, our principal reviewing

court has pointed out that, as a general proposition, "[w]hen marks would appear on virtually identical goods . . . , the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1994). Here, despite their differences in sound and connotation, the respective marks are otherwise substantially similar in their overall structure, general appearance and commercial impression, due to the fact that each of opposer's marks and applicant's mark are two-word marks which begin with the identical term "GRAND". Moreover, as was the case with the "GRAND SLAM" mark in *Holsa*, the differences in connotation between the respective marks would appear to be "entitled to little or no weight." 44 USPQ2d at 1318. Here, applicant's mark "GRAND VALLEY," like the mark "GRAND SLAM," "is wholly arbitrary, *i.e.*, it has no meaning at all" with respect to tires for motor vehicles. 44 USPQ2d at 1317.

In view thereof, and considering that vehicle tires are sold to all manner of people, we are constrained to agree with opposer that contemporaneous use of its "GRAND PRIX," "GRAND AM," "GRAND SPORT" and/or "GRAND SPIRIT" marks and applicant's "GRAND VALLEY" mark, in connection with vehicle tires, would be likely to cause confusion as to the origin or affiliation of such goods. Particularly in the absence of any evidence of significant third-party use in the tire and related automotive products field of marks which consist of or include the term "GRAND," it would not be unreasonable, for example, for ordinary consumers, familiar

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with the "GRAND PRIX" and "GRAND SPIRIT" tires available at opposer's "CORDOVAN" retailers, the "GRAND AM" and "GRAND SPIRIT" tires offered by its "MULTI-MILE" dealers and/or the "GRAND SPORT" and "GRAND SPIRIT" tires marketed through its "SIGMA" retail outlets, to believe, upon encountering applicant's substantially similar "GRAND VALLEY" tires, that opposer has introduced a new product line which is specifically for sale through the retailers offering such goods.

As a final consideration in this regard, we note that to the extent that we may have any doubt as to our conclusion that confusion is likely, we resolve such doubt, as we are required to do, in favor of opposer as the prior user and registrant. See, e.g., TBC Corp. v Holsa Inc., supra at 1318; and In re Pneumatiques Caoutchouc Manufacture et Plastiques Kelber-Columbes, 487 F.2d 918, 179 USPQ 729 (CCPA 1973).

Decision: The opposition is sustained and registration to applicant is refused.

G. D. Hohein

H. R. Wendel

D. E. Bucher
Administrative Trademark Judges,
Trademark Trial and Appeal Board