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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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The Goodyear Tire & Rubber Company
v.
Camoplast, Inc.

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Opposition No. 91152083
to Application No. 75609586
filed on December 21, 1998

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Albert Robin, Howard B. Barnaby and Ned W. Branthover of
Robin Blecker & Daley and Kenneth C. Williams, Esq. for The
Goodyear Tire & Rubber Company.

Anthony R. Masiello and Thomas W. Brooke of Holland & Knight
for Camoplast, Inc.

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Before Seeherman, Walters and Drost, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

The Goodyear Tire & Rubber Company filed its opposition
to the application of Camoplast, Inc. to register the mark
shown below for "rubber tracks used in land vehicles," in
International Class 12.¹

¹ Application Serial No. 75609586 was filed December 21, 1998, based
upon an allegation of a bona fide intention to use the mark in commerce
in connection with the identified goods, under Section 1(b) of the
Trademark Act, 15 U.S.C. 1051(b), and asserting a claim of priority



The application includes the following statement: "The mark consists of the tread pattern which is located over the entire outside surface of the track. This tread pattern consists of two rows of alternating tread lugs (or tread grousers) equally spaced along the track. The representation of the track shown in dotted lines does not form part of the mark."

As grounds for opposition, opposer asserts that the above design which applicant seeks to register is not a trademark because it is *de jure* functional; that the design is not inherently distinctive; and that the design has not been used in connection with the identified goods in the United States and it has not acquired distinctiveness as a mark in connection with such goods.

Applicant, in its answer, denied the salient allegations of the claims.

based on a Canadian application, under Section 44(d) of the Trademark Act, 15 U.S.C. 1126(d). Applicant subsequently deleted its Section 1(b) basis and submitted, under Section 44(e) of the Trademark Act, 15 U.S.C. 1126(e), the Canadian registration that issued from its claimed application.

The Record

The record consists of the pleadings; the file of the involved application; and the testimony depositions by opposer of Terrance Robert Andrew, opposer's global marketing manager for off-the-road products, Paul J. Peterson, opposer's team leader of rubber track development group, and Randy Ladd, opposer's marketing manager, with accompanying exhibits. Applicant took no testimony and filed no evidence during its testimony period. Only opposer filed a brief on the case and opposer's request for a hearing was withdrawn and no hearing was held.

Factual Findings

Opposer has manufactured rubber track for vehicles primarily for the agricultural and construction industries since 1991. Mr. Peterson, opposer's rubber track development group team leader, stated that "a rubber track is a reinforced flat belt with tread lugs on one side and other lugs on the inside that we tend to call guide lugs or drive lugs and it is used for traction on agricultural or industrial vehicles ... in place of tires." (Peterson Dep. p. 5.) Opposer develops and manufactures rubber tracks to the specification of the original equipment manufacturer ("OEM") purchaser for a particular vehicle.

Opposer's brochure for its rubber tracks (Opposer's Exhibit 15) includes the following statements:

In selecting a rubber track, there are four basic parameters which must be determined:

1. Track Width
2. Track Length
3. Tread Pattern
4. Guide/Drive Lug

. . . .

Tread Patterns

Goodyear makes a variety of tread patterns appropriate to the wide range of agricultural, industrial and construction applications in which rubber tracks are used. In addition to these standard tread patterns, Goodyear frequently works with OEMs to develop unique tread patterns for special applications.

The brochure pictures several tread patterns, and for each pattern the brochure lists the application (e.g., "construction," or "agriculture") and a description (e.g., "designed for high load carrying ability, high damage tolerance and long life," or "designed for traction in loose soils and for long life").

Opposer markets its rubber track products at trade shows for the relevant industries and directly to OEM's, including Case New Holland, John Deere and Blaw-Knox. Opposer also markets and sells its replacement rubber tracks to farm equipment distributors, including selling replacement rubber tracks for Caterpillar vehicles. Opposer's rubber tracks contain the trademarks GOODYEAR and/or TRACKMAN on the edge thereof.

Mr. Andrew, opposer's global marketing manager for off-the-road products, stated that, in addition to manufacturing rubber tracks, opposer manufactures tires with various tread

designs for construction and agricultural vehicles; that its tire tread designs are for various utilitarian applications; and that opposer's "Sure-Grip" tire has a tread design that is very similar to the track tread design that is the subject of the application herein. (See Opposer's Exhibits 31 and 38.)

Mr. Peterson stated that other major rubber track manufacturers include Bridgestone/Firestone and, historically, Caterpillar; and that applicant purchased Caterpillar's rubber track manufacturing facilities and business in 2002 and currently manufactures rubber tracks. Both applicant and opposer supply new and replacement rubber tracks to some of the same manufacturers, for example, John Deere and Caterpillar.

Applicant's rubber track products brochure (Opposer's Exhibit 9) describes several different types of rubber tracks for different uses. Beside each of these descriptions is a drawing of a different lug design. The lug design corresponding to the design that is the subject of this application is labeled as the "Hi-Yield" brand. The brochure contains the following description of the Hi-Yield rubber track:

The Hi-Yield is our every day general duty track. Built to last, we designed it to handle a variety of wet and dry soil conditions. With its 6" pitch the Hi-Yield will deliver a smoother ride over hard packed surfaces while supplying needed traction for all your applications.

Applicant's website contains essentially the same description. There is no reference to any of the three lug designs except with respect to their functional features.

Applicant's "Rubber Track Warranty" (Opposer's Exhibit 7, p. 1) states that applicant's rubber track products include three "brands," namely, "Hi-Yield," "Severe Duty," and "Hi Traction." Page 7 of the Warranty is entitled "Identifying a Camoplast Track" and states the following:

Agricultural tracks produced by Camoplast all have a Camoplast ID.

This identification includes Camoplast logo, brand logo, serial number and part number. The part number is located immediately beside the brand or OEM logo on the outer edge of the track.

The serial number is located immediately below the Camoplast logo (opposite brand logo) on inside of track.

Although the track lug design is shown in the warranty document as a reference for showing placement of the Camoplast and brand logos, there is no reference to the lug design as a source identifier. Mr. Ladd, opposer's marketing manufacturer, confirmed that he has seen applicant's "small Camoplast logo" on the tread of its rubber tracks between the tread lugs.

Mr. Peterson identified U.S. Patent No. 6,322,172B2, entitled "Endless Belt for Use with Heavy Duty Track Vehicles" (Opposer's Exhibit 2), which lists applicant as the assignee from the original inventor. The design of the

tread, or lug design, as shown in Figures 1 and 3 of the patent, is identical to the drawing of the proposed mark herein. The statement of the claim in the patent includes the tread and the juxtaposition of the interior and exterior lugs to each other and to the edges and center of the track.

The three claims in the patent are stated below:

1. An endless belt for use with a heavy duty track vehicle comprising:

An elongated endless body made of polymeric material, said body having a longitudinal direction, an outer surface and an inner surface;

A plurality of longitudinally spaced guide members integrally formed to said inner surface extending transversely to the longitudinal direction at mid-section of said body and defining first valleys between adjacent guide members; and

Two rows of longitudinally spaced tread members integrally formed to said outer surface; the tread members of a first of said rows being longitudinally offset relative to the tread members of a second of said rows; each said tread member of said first and said second rows having an inner edge area located at a midsection of said body and extending transversely to a longitudinal direction of the belt; said tread members defining second valleys between adjacent inner edge areas of each said rows and an outer edge area; said tread members defining a series of pitches on said outer surface of said track wherein a pitch is defined as including a tread member of the first row and an adjacent tread member of the second row; each said inner edge area of said tread members being in vertical alignment with a corresponding one of said guide members on said inner surface of said body and parallel to the corresponding one of the guide members;

Wherein two longitudinally spaced guide members are provided on the inner surface for each pitch of said outer surface and wherein each first valley is in vertical alignment with

corresponding second valley so that flexing of said track, when bending, occurs in said first and second valleys where thickness of the body is at its minimum.

2. An endless belt as defined in claim 1, wherein said transversely extending inner edge area is defined by opposite parallel side faces and a rounded inner end face; said side faces extending in a plane perpendicular to the longitudinal plane of said endless body;

3. An endless belt as defined in claim 2, wherein said outer edge area of each said tread member extends obliquely from transversely extending inner edge thereof to the outer edge of said body.

Mr. Peterson made the following statements about the claims in the patent and the functionality of the tread design that is the subject of the application herein (Peterson Dep. pp. 30-31):

A. This patent claims that tread lugs of this shape, in combination with guide lugs of this shape in the orientation described with tread lugs and guide lugs, oriented vertically with each other, will reduce the tendency to crack between the lugs when flexed.

Q. That is for the track to crack?

A. Yes.

Q. Do they also claim other benefits in the patent?

A. That is the primary benefit that they claim in the patent.

. . .

Q. So is it fair to say, as set forth in this patent, Exhibit 2, that the particular design and shape of the tread members or lugs are functional to achieve the results of the patent?

A. Yes, they are necessary to achieve the results of the patent.

Q. And those are the same shape and design of the pattern that is pictured in the trademark application ...?

A. They are.

Q. So is it your opinion that those shapes are functional as they appear in the [application]?

A. They are functional.

Opposer also submitted the brochures of several third-party rubber track manufacturers. The brochure for Ohtsu Tire and Rubber Co. (Opposer's Exhibit 27) includes the following statement regarding tread design:

Various lug designs are available to suit the application conditions, vehicle weight, cargo load, speed and terrain. Numerous track widths and lengths are also available as standard items. Custom lug designs and track sizes are available by special order to suit a wide range of applications.

The rubber track brochure for Firestone (Opposer's Exhibit 29) includes the statement that "tread bars are designed to provide excellent traction, long life and a smooth ride." Firestone refers to its agricultural rubber tracks in the brochure as "Firetrax."

Analysis

De Jure Functionality

Opposer contends that the track tread design that is the subject of the application herein is similar, or identical, to the functional lug design in applicant's U.S. Patent No. 6,402,268 (Figure 3 therein) for an endless belt for use with heavy-duty track vehicles; that applicant's rubber tracks work better because of their tread design; and that applicant does not use or promote the design herein as a mark. Opposer also contends that opposer and third-party track tread manufacturers use track tread designs and tire tread designs similar to that depicted in the application

herein; that opposer promotes its track tread designs for their functional advantages; and that opposer and third-party track tread manufacturers identify their tracks with various brand names.

A mark is *de jure* functional if the configuration of the product or its packaging embodies a design feature which is essential to the use or purpose of the article or it affects the cost or quality of the article. See *TraFFix Devices Inc. v. Marketing Displays Inc.*, 532 U.S. 23, 58 USPQ2d 1001 (2001); *Valu Engineering, Inc. v. Rexnord Corporation*, 278 F.3d 1268, 61 USPQ2d 1422 (Fed. Cir. 2002). See also *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 USPQ 9 (CCPA 1982). Functionality rests on utility which is determined in light of superiority of design. *Valu Engineering, Inc. v. Rexnord Corporation*, *supra* at 1277, quoting *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 1531, 32 USPQ2d 1120, 1122 (Fed. Cir. 1994). As set out in *In re Morton-Norwich Products, Inc.*, *supra*, there are a number of factors which are useful in determining whether particular product designs are superior, including:

- (1) the existence of a utility patent that discloses the utilitarian advantages of the design;
- (2) advertising materials in which the originator of the design touts the design's utilitarian advantages;

- (3) the availability to competitors of alternative designs; and
- (4) facts indicating that the design results from a comparatively simple or cheap method of manufacturing the product.

In this case, we find that opposer has established that the tread design which is the subject of the application is *de jure* functional and not entitled to trademark registration. As discussed in detail *supra*, applicant owns a utility patent that discloses the utilitarian advantages of a lug design that is essentially identical to the design that is the subject of this application. The claims in the patent pertain specifically to the exterior tread lug design and the interior lugs and their juxtaposition relative to one another.

Additionally, applicant's brochure describes the different functional features of each of its three tread lug designs and identifies the design herein by the name "Hi-Yield." The purpose of the lug design, as described by applicant is clearly utilitarian. Further, the third-party brochures discuss the utilitarian benefits and features of tread lug designs. Also, there is evidence that opposer has a similar tread design on its tires used for similar purposes on the same types of vehicles; and opposer's witnesses state that its tire tread designs are utilitarian in nature.

There is no evidence in the record that applicant, opposer or third parties tout their respective lug designs as trademarks. To the contrary, they tout the utilitarian advantages of those designs. While the record does not contain sufficient evidence to draw any conclusions regarding the third and fourth *Morton-Norwich* factors, we find the evidence regarding the first two factors sufficient to establish the *de jure* functionality of the lug design herein. See *TraFFix Devices Inc. v. Marketing Displays Inc.*, *supra*.

Inherent Distinctiveness and Acquired Distinctiveness

Should applicant ultimately prevail on the issue of *de jure* functionality on appeal, we alternatively conclude that there is no question that the lug design that is the subject of the application herein constitutes the product design and, as such, it is not, and cannot be, inherently distinctive. See *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 54 USPQ2d 1065 (2000). It is, therefore, at least *de facto* functional. Further, the application is not based on use and applicant has made neither a claim nor showing of acquired distinctiveness. Thus, we also conclude that acquired distinctiveness of the lug design has not been established.

Decision: The opposition is sustained.