

ESTTA Tracking number: **ESTTA23291**

Filing date: **01/12/2005**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

### Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

#### Opposer Information

<b>Name</b>	BIG O TIRES, INC.
<b>Granted to Date of previous extension</b>	01/12/2005
<b>Address</b>	12650 EAST BRIARWOOD AVENUE CENTENNIAL, CO 80112 UNITED STATES

<b>Attorney information</b>	MARSHA G. GENTNER JACOBSON HOLMAN PLLC 400 SEVENTH STREET, NW WASHINGTON, DC 20004 UNITED STATES mgentner@jhip.com Phone:202-638-6666
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#### Applicant Information

<b>Application No</b>	78264260	<b>Publication date</b>	09/14/2004
<b>Opposition Filing Date</b>	01/12/2005	<b>Opposition Period Ends</b>	01/12/2005
<b>Applicant</b>	WHEEL SPECIALTIES, LTD. 2088 Center Ridge Road, Suite 100 Rocky River, OH 44116		

UNITED STATES
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**Goods/Services Affected by Opposition**

Class 012. First Use: 20040220First Use In Commerce: 20040220 All goods and services in the class are opposed, namely: Wheels for automobiles
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<b>Attachments</b>	Bigg Wheels Notice of Opp.pdf ( 6 pages )
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<b>Signature</b>	/Marsha G. Gentner/
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<b>Name</b>	MARSHA G. GENTNER
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<b>Date</b>	01/12/2005
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January 12, 2005

Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

RE: New Opposition  
Big O Tires, Inc. v. Wheel Specialties, Ltd.  
BIGG WHEELS - Serial No. 78/264,260  
Our Ref.: 11386/I-5156

Sir:

We enclose the following for filing in the Patent and Trademark Office:

Notice of Opposition  
 Notice of Appeal

Payment of the required filing fee in the amount of \$300.00 has been charged to our firm's credit card. Should this be insufficient, authorization is granted to deduct such amount/deficiency from Deposit Account No. 06-1358.

Respectfully submitted,

Marsha G. Gentner

MGG/tlb  
Enclosures



vehicle products and services, retail store and franchise services, in commerce in the United States, under and in connection with the trade name(s) and trademark(s) **BIG O** and **BIG O TIRES** [hereafter, collectively, Opposer’s “**BIG O Marks**”], the marks **BIG FOOT** and **BIGFOOT COUNTRY** [hereafter, collectively, Opposer’s “**BIG FOOT Marks**”], as well as the trademarks **BIG HAUL** and **BIG LIFT** [hereafter, collectively, Opposer’s “**BIG Marks**”]. Opposer Big O continuously has used said Opposer's **BIG O**, **BIG FOOT** and **BIG** Marks, alone and in combination with other words, designs, and/or symbols, in commerce in connection with its products, services and stores, to identify and designate same, and to distinguish those goods, services, stores and Big O’s business from those of others.

3. Opposer Big O is the owner of, and will rely on herein, the following U.S. trademark registrations:

<i>REGISTRATION No.</i>	<i>ISSUE DATE</i>
2,821,058	April 20, 2004
2,821,055	March 9, 2004
2,821,054	March 9, 2004
2,821,053	March 9, 2004
2,821,052	March 9, 2004
2,821,051	March 9, 2004
2,514,975	December 4, 2001
2,520,443	December 18, 2001
2,514,975	December 4, 2001
2,411,926	December 12, 2000
1,904,955	July 11, 1995

<i>REGISTRATION NO.</i>	<i>ISSUE DATE</i>
1,611,160	August 28, 1990
1,102,059	September 12, 1978
1,102,058	September 12, 1978
994,466	October 1, 1974
993,415	September 24, 1974

Said registrations are valid and subsisting, and constitute *prima facie* and/or conclusive evidence of Opposer Big O's ownership of Opposer's **BIG O, BIG FOOT** and **BIG** Marks, and exclusive right to use same in commerce in connection with the goods and services set forth in said registrations. Opposer also is the owner of application serial no. 76/605,325, for its **BIGFOOT COUNTRY** mark, and Opposer also will rely herein on the registration of that application when such issues.

4. On June 18, 2003, Applicant filed an application to register the mark **BIGG WHEELS**. Said application was accorded serial no. 78/264,260, and was published for opposition in the Official Gazette of September 14, 2004, at page 362, identifying the goods as "wheels for automobiles."

5. Applicant's **BIGG WHEELS** mark sought to be registered by Applicant is a colorable imitation of, and/or is confusingly similar to, Opposer's prior and aforesaid **BIG O, BIG FOOT** and **BIG** Marks.

6. The goods set forth in the application opposed herein are identical, similar and/or related to the goods and services in connection with which Big O uses its **BIG O, BIG FOOT** and **BIG** Marks, and on information and belief, the goods set forth in the opposed application are and/or

will be sold through the same and/or similar channels of trade, and/or to the same general class of purchasers, in and to which Opposer's products and services are marketed and/or sold.

7. The registration and/or use of the BIGG WHEELS mark, as set forth in the opposed application, is likely to cause confusion, mistake, and/or to deceive as to origin, sponsorship, and/or association of Applicant's goods to be sold under the opposed mark sought to be registered by Applicant vis-a-vis Opposer's **BIG O**, **BIG FOOT** and **BIG** Marks, and/or to mislead purchasers of Applicant's and/or Opposer's goods and/or services, and/or the public in general, into believing that Applicant's goods are sold by, emanate from, and/or in some way, directly or indirectly, are associated with Big O, and/or Opposer's **BIG O**, **BIG FOOT** and **BIG** Marks, products, services and/or business, or vice versa, to the damage and detriment of Big O.

#### COUNT II - DILUTION

8. Opposer restates and realleges ¶¶1-7, inclusive, above, of this Notice of opposition, and hereby incorporates same as if fully set forth herein.

9. Since prior to the date of first use alleged in the application opposed herein, Opposer's **BIG O** and **BIG FOOT** Marks have been, and are, distinctive and famous.

10. On information and belief, the registration of the opposed BIGG WHEELS mark by Applicant has and/or will cause dilution of the distinctive quality of Opposer's aforesaid famous and distinctive **BIG O** and **BIG FOOT** Marks.

11. By virtue of the foregoing, Big O believes it will be damaged by the registration by Applicant of the BIGG WHEELS mark, as set forth in the application therefor, Serial No. 78/264,260.

12. If Applicant is granted the registration opposed herein, and Applicant obtains such rights as conferred under the Principal Register of the Trademark Act of 1946, Applicant will obtain unlawful gain and advantage to which it is not entitled under the Trademark Act of 1946, to the detriment and harm of Opposer.

WHEREFORE, Opposer Big O believes and alleges that it will be damaged by registration of the BIGG WHEELS mark of application Serial No. 78/264,260, as aforesaid, and pray that:

- A. judgment in the present opposition be entered in favor of Opposer on Counts I through II, inclusive;
- B. the present opposition be sustained; and
- C. registration of application Serial No. 78/264,260 be rejected and refused.

Respectfully submitted,

BIG O TIRES, INC.

Date: January 12, 2005

By:



Marsha G. Gentner  
JACOBSON HOLMAN PLLC  
400 Seventh Street, N.W.  
Washington, D.C. 20004  
(202) 638-6666