

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

BIG O TIRES, LLC )  
 )  
 Opposer, )  
 )  
 v. )  
 )  
 WHEEL SPECIALTIES, LTD. )  
 )  
 Applicant. )

# 78264260

Opposition No. 91163791

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TRIAL BRIEF OF APPLICANT

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BIG O TIRES, LLC	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. 91163791
	)	
WHEEL SPECIALTIES, LTD.	)	
	)	
Applicant.	)	

**TRIAL BRIEF OF APPLICANT**

Applicant, Wheel Specialties, Ltd. (hereafter "Applicant"), hereby submits its Trial Brief.

I. DESCRIPTION OF THE RECORD

A. Applicant has submitted:

1. Testimonial deposition of Mark Lamb ("Lamb Tr."), taken August 28, 2008 and Applicant's Exhibits ("AX") 1-10.
2. Copies of third party registrations AX 11-21.
3. Copies of Internet publications AX 22-52.
4. Opposed Application Serial No. 78/264,260 is also of record.

B. Opposer has submitted:

1. Testimonial deposition of Richell Bennett ("Bennett TR."), taken June 5, 2008 and Opposer's Exhibits ("OX") 1-34D.
2. Testimonial deposition of Michael Kinnen ("Kinnen Tr.") taken June 5, 2008 and OX 35A-35F.

3. Discovery produced by Applicant OX 36-42.
4. Status and title copies of Opposer's US registrations OX 43-58.
5. Sampling of printed publications for the years 2000-2007, OX 59-64.
6. Copies of agreements entered into by Opposer and submitted to the Board on October 16, 2008 as OX A-C to Joint Stipulation Regarding Evidence.

## II. STATEMENT OF THE ISSUES

A. Whether Applicant's BIGG WHEELS Mark as applied to "wheels for automobiles" in International Class 12 so resembles Opposer's BIG O TIRES Mark for tires and retail store services and vehicle maintenance and repair services as to be likely to cause confusion.

B. Whether Applicant's BIGG WHEELS Mark as applied to wheels for automobiles dilutes Opposer's BIG O TIRES Mark.

## III. RECITATION OF THE FACTS

### A. Brief Statement of the Case

On June 18, 2003 Applicant filed US Application No. 78/264,260 for registration of the mark BIGG WHEELS for "wheels for automobiles" in International Class 12 under Section 1(b) (intent to use). On February 27, 2004, Applicant filed an Amendment to Allege Use, claiming use of its BIGG WHEELS mark on or in association with wheels for automobiles at least as early as February 20, 2004.

Registration of Applicant's BIGG WHEELS mark was opposed by the Opposer Big O Tires on two grounds (1) likelihood of confusion under Section 2(d) of the Trademark Act and (2) dilution.

Applicant in its Answer has denied the salient allegations in the Notice of Opposition.

B. Applicant Wheel Specialties, Ltd.

1. Applicant's Business

Applicant is in the business of wholesaling custom wheels and accessories and tires for cars. Lamb Tr. 5:21-24. Applicant's customers are retail automobile stores that sell tires, brakes, service cars, anything automobile or truck related. Lamb Tr. 6:21-7:1.

Applicant maintains a customer contact list for all of its active customers and prospective customers to whom it sends catalogs and other information. Lamb Tr. 33:10-25, 36:8-18. AX 8 is a list of the companies in Applicant's customer contact list that includes the word BIG in their company names/trade names. One of Applicant's wheel customers listed on AX 8 is Big Brand Tire Company. Lamb Tr. 33:10-34:7.

Another customer of Applicant for its BIGG WHEELS product line is Opposer. Applicant has sold its BIGG WHEELS product line to Opposer since 2004 and Opposer is still buying the BIGG WHEELS product line from Applicant. AX 3 lists the number of BIGG WHEELS units sold to Opposer by year. Lamb Tr. 15:10-17; 16:18-17:2; 17:8-21.

2. Applicant's Selection and Adoption of its BIGG WHEELS Mark

Applicant's CEO Mark Lamb made the decision to adopt and use the mark BIGG WHEELS for a new line of custom wheels for automobiles. The reason he adopted the BIGG WHEELS mark was to emphasize the big styling for this particular style of wheels.

Lamb Tr. 5:13-15; 9:9-10:5. At the time Mr. Lamb made the decision to adopt the BIGG WHEELS mark, he was aware that the term BIG was commonly used as part of company names in the automotive field, and did not consider the Opposer or any of its marks in his selection of the BIGG WHEELS mark. Lamb Tr. 9:9-10:16.

### 3. Applicant's Awareness of Opposer

Applicant first became aware of Opposer by cold calling one of Opposer's stores in Kentucky. This resulted in a sale by Applicant of eight wheels to Opposer's Kentucky store in August of 2002. Lamb Tr. 11:15; 12:2-15:5. Also Applicant has sold its BIGG WHEELS product line to Opposer since 2004 and Opposer is still buying the BIGG WHEELS product line from Applicant. AX 3 lists the number of BIGG WHEELS units sold to Opposer by year. Lamb Tr. 15:10-17; 16:18-17:2; 17:8-21.

### 4. Third Party Uses of the Word BIG in Their Company Names/Trade Names

At the time Applicant's CEO Mark Lamb adopted the BIGG WHEELS mark, he was aware that the term BIG was commonly used as part of company names/trade names in the automotive field. Lamb Tr. 10:6-16. Also a number of Applicant's active customers and prospective customers to whom it sends catalogs and other information include the word BIG in their company names/trade names. AX 8 is a list of the companies in Applicant's customer contact list that include the word BIG in their company names/trade names. Lamb Tr. 33:10-34:7; 36:8-18.

AX 7 is a copy of the results of an Internet search conducted by Applicant for various automotive companies that have the word BIG in their company names/trade names or the products that they sell. Lamb Tr. 26:3-16. AX 22-52 are copies of other

Internet publications of third parties including the word BIG in their company names/trade names that offer automotive related goods/services.

5. US Registrations That Include the Term BIG as Part of Composite Marks for Automotive Related Goods/Services.

AX 11-21 are copies of third party US registrations of composite marks including the term BIG for automotive related goods/services.

C. Opposer Big O Tires, LLC

Opposer sells and services its own private brands of tires as well as offering retail store services and vehicle maintenance and repair services under the BIG O, BIG O TIRES and BIG FOOT marks (collectively the "BIG O TIRES Mark"). Bennett Tr. 11:8-16. In addition to selling private brand tires and major national brands of tires of others, Opposer also sells custom wheel brands of others including American Racing, Wheel Pro, etc. Bennett Tr. 11:8-16; 44:16-22. Opposer has a separate wheel catalog displaying some of these custom wheel brands of others. Bennett Tr. 9:21-24, OX 5A, 5B. Applicant has also sold its BIGG WHEELS product line to Opposer since 2004 and Opposer is still buying the BIGG WHEELS product line from Applicant. Lamb Tr. 15:10-17; 16:18-17:2; 17:8-21; AX 3.

#### IV. ARGUMENT

A. Applicant's BIGG WHEELS mark is not confusingly similar to any of Opposer's BIG O TIRES Marks.

A determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563 (CCPA 1973). The factors Applicant considers to be key to this determination are discussed below.

1. The similarity or dissimilarity of Applicant's BIGG WHEELS mark and Opposer's BIG O TIRES Marks in their entireties as to appearance, sound, connotation and commercial impression.

The similarity or dissimilarity of Applicant's and Opposer's mark is a predominant inquiry. *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ 2d 1375 (Fed. Cir. 2002).

Opposer states on page 21 of its trial brief that it is the owner of no less than 15 alive, pleaded registrations for its trademarks and service marks in connection with tires, retail store services and vehicle services. However, on page 3 of its brief, Opposer only identifies the BIG O, BIG O TIRES and BIG FOOT marks collectively as the BIG O TIRES Mark (which are covered by pleaded registrations OX 43-50 and 58). Thus the most relevant of Opposer's Marks are BIG O, BIG O TIRES and BIG FOOT.

Applicant's BIGG WHEELS mark and Opposer's BIG O, BIG O TIRES and BIG FOOT marks all share a term that sounds the same, namely, BIG. However, the term BIGG of Applicant's mark includes two Gs, which gives it an entirely different appearance from the term BIG.

Moreover, Applicant's CEO Mark Lamb, who made the decision to adopt and use the mark BIGG WHEELS, did so in order to create the connotation and commercial impression that the automobile wheels to which the mark is applied had "big styling". Lamb Tr. 5:13-15; 9:9-10:5. This is entirely different from the connotation and commercial impression created by Opposer's BIG O, BIG O TIRES and BIG FOOT marks as applied to Opposer's goods/services.

Moreover, for purposes of determining likelihood of confusion, trademarks must be considered in their entireties and not dissected into their component parts. *China Healthways Inst., Inc. v. Wang*, 491 F.3d 1337, 1340, 83 USPQ 2d 1123 (Fed. Cir. 2007). At the same time, however, it is well settled that one feature of a mark may be more significant than another and given greater weight than other elements in determining the commercial impression created by the mark. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

In this particular case, the term BIG O of Opposer's BIG O and BIG O TIRES marks is dominant and the term BIG FOOT of Opposer's BIG FOOT marks is dominant.

In Applicant's BIGG WHEELS mark, the term BIGG is dominant, the word WHEELS being generic or descriptive for Applicant's wheels for automobiles. However, the mark BIGG WHEELS as a whole creates an entirely different commercial impression as applied to wheels for automobiles than Opposer's Marks as applied to its goods/services.

Moreover, there can be no dispute that neither the Opposer nor anyone else has exclusive rights to use the term BIG as applied to automotive related products/services

in view of the number and nature of other composite marks including the term BIG in use on or in association with similar goods/services as discussed below.

2. The number and nature of other names/marks including the term BIG for the same or similar goods/services.

Applicant's customers for its wheel products are retail automotive stores that sell tires, brakes, service cars, anything automobile or truck related. Lamb Tr. 6:21-7:1. Applicant maintains a customer contact list for all of its active customers and prospective customers to whom it sends catalogs and other information. Lamb Tr. 33:10-25; 36:8-18. AX 8<sup>1</sup> is a list of the companies in Applicant's customer contact list that include the word BIG in their company names/trade names. Lamb Tr. 33:10-34:7; AX 8. Examples of these are Big 10 Tire & Accessories, Big 5 Tire & Auto Service, Big Body Car & Truck Acc., Big Dog, Big Spring Tire, Big Tex Tire (AX 8:WSL 251), Big Chief's Tire Co., Big Daddy's Tire, Big Dog's Tire, Big Frank's Tire, Big Oak Tires, Big Rims Inc., Big T Tire, Big Tires & More (AX8:WSL 252), Big Brand Tire Company, Big Jim's Tire Pro's (AX8:WSL 253), Big L Tire, Big & Little Tire SVC, Big F Tires, Big R Tire Car Care, Big Tex Tire & Wheel (AX8:WSL 255), Big 4 Tire, Big B, Big D Tire, Big John's Tire & Auto (AX8:256), Big A Auto Parts, Big G Tire Company (AX8:WSL 257), Big 10 Tire (AX 8:WSL 259, 260), Big Orange Tire, Big River Tire Co., Big T Tire & Wheel, and Big Tire Inc. (AX 8:WSL 260).

One of Applicant's wheel customers listed on AX 8:WSL 253 is Big Brand Tire Company. This is the dba for Majco, Inc., the owner of US Registration 2,195,058 (AX 15) of the mark BIG BRAND for distributorships in the field of vehicle tires, brake pads and shock absorbers, as evidenced by the fact that the combined declarations for

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<sup>1</sup> AX 8 was produced by Applicant during discovery under production Nos. WSL 251-260.

renewal under sections 8 and 9 filed in the BIG BRAND registration on July 24, 2008 gives the same address of 805 Via Alondra, Camarillo, CA 93012 as Big Brand Tire Co. on AX 8: WSL 253. Also the specimen that accompanied the sections 8 and 9 renewal of the BIG BRAND registration consists of a picture of a storefront and a sign out front on which the dba name Big Brand Tire Company appears. A copy of the sections 8 and 9 renewal application as filed in the BIG BRAND registration on July 29, 2008 and notice of acceptance thereof is attached as attachment A.

Another customer of Applicant for its BIGG WHEELS product line is Opposer. Applicant has sold its BIGG WHEELS product line to Opposer since 2004 and Opposer is still buying the BIGG WHEELS product line from Applicant. Lamb Tr. 15:10-17; 16:18-17:2; 17:8-21; AX 3. As shown in AX 3<sup>2</sup>, Applicant's BIGG WHEELS unit sales to Opposer were 44 in 2004, 76 in 2005, 106 in 2006 and 337 in 2007.

Opposer also sells custom wheel brands purchased from other vendors besides Applicant, including American Racing, Wheel Pro, etc. Bennett Tr. 44:16-22. Also Opposer has a separate wheel catalog displaying some of these custom wheel brands of others. Bennett Tr. 9:21-24, OX 5A, 5B. Accordingly, ordinary customers who purchase custom wheels from Opposer would know they are not Opposer's own private brand custom wheels.

Applicant also conducted an Internet search for various automotive companies that have the word BIG in their company names/trade names or the products that they sell. Lamb Tr. 26:3-16, AX 7. Examples of automotive company names turned up in the Internet search with the word BIG in their company names/trade names are Big D Auto Parts (AX 7:3), Big Daddy's Auto Parts (AX 7:7), Big Dave's Auto Parts (AX 7:10),

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<sup>2</sup> Ax 3 was produced by Applicant during discovery under production No. WSL 288.

Big Dog Automotive (AX 7:11), Big E Automotive (AX 7:12), Big G Auto Service (AX 7:14), Big M Automotive (AX 7:18), Big Sky Accessories (AX 7:21), Big Texas Auto Parts (AX 7:24), Big Auto Repair (AX 7:54), Big 4 Auto Parts (AX 7:57), Big 10 Tires (AX 7:58), Big 5 Tire & Auto Service (AX 7:59), Big A Auto Parts (AX 7:60), Big B Auto (AX 7:61), Big Boy Tires, Inc. (AX 7:62) and Big Brand Tire Company (AX 7:66).

AX 22-52<sup>3</sup> are copies of other Internet publications of third parties including the term BIG in their company names/trade names that offer automotive related goods/services. Examples of these are Big Chief's Tire Co. (AX 22), Big A Auto Parts (AX 23), Big D Tire Inc. (AX 25), Big Time Auto Parts (AX 26), Big 3 Auto Parts (AX 31), Big 4 Tire (AX 32), Big 4 Auto Parts (AX 38, 39), Big Bear Tire (AX 40), Big Boss (AX 42), Big 8 Tyre & Auto Center (AX 45), Big "L" Tire (AX 46), Big 10 Tires (AX 47), Big Brand Tire (AX 48), Big Dave's Auto Parts (AX 49), Big A Auto Parts (AX 50), Big Muffler Shop (AX 51, 52).

During examination of Applicant's BIGG WHEELS application opposed herein, the Examining Attorney initially refused registration because of a likelihood of confusion with the marks in three of Opposer's US registrations, namely, 993,415 (OX 43) of the mark BIG O for "vehicle tires", 1,611,160 (OX 47) of the mark BIG O TIRES and design for "tires" and "retail tire store services" and 2,411,926 (OX 49) for the mark BIG O TIRES for "tires for land vehicles", "retail store services featuring vehicle tires, parts and accessories; franchising, namely, offering technical assistance in the establishment and/or operation of retail stores featuring vehicle parts and accessories, and vehicle maintenance and repair services" and "vehicle maintenance and repair services".

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<sup>3</sup> Ax 22-52 were produced by Applicant during discovery under the WSL production numbers appearing thereon.

In response, Applicant pointed out that the cited registrations commonly include the term BIG-O or BIG O not just the term BIG, and argued that the term BIGG of Applicant's mark creates an entirely different commercial impression than the term BIG-O and/or BIG O of the cited registrations.

Moreover, Applicant directed the Examining Attorney's attention to the existence of several other third party registrations of composite marks including the term BIG for related goods/services, as follows:

(1) BIG BRAND Reg. No. 2,195,058 (AX 15) for "distributorships in the field of vehicle tires, brake pads and shock absorbers", owned by Majco, Inc.

(2) THE BIG "G" IS YOUR GUARANTEE Reg. No. 772,529 (AX 11) for "tires", owned by Gencorp. Inc.

(3) BIG A and design Reg. No. 1,388,039 (AX 13) for "automobile engine parts - namely, carburetors, ignitions, distributors, alternators and generators; and parts therefor" and "automobile parts and accessories - namely, mufflers and muffler body clamps; exhaust pipes and clamps therefor; air, oil and gas filters; and fuel, water and power steering pumps", owned by A.P.S. Inc.

Applicant argued that this is further evidence that Applicant's mark BIGG WHEELS when considered in its entirety is sufficiently different from the marks BIG-O, BIG O TIRES and design and BIG O TIRES of the cited registrations to avoid any likelihood of confusion.

In addition, Applicant directed the Examining Attorney's attention to expired Reg. No. 900,272 (AX 12) of the mark BIG WHEEL for "pneumatic tires", owned by The Jetzon Tire and Rubber Company, Inc. Applicant pointed out that although this

registration expired on October 6, 1990, it was in force when the cited BIG-O registration (No. 993,415) for "vehicle tires" was granted on September 24, 1974 and the cited BIG O Tires and design registration (No. 1,611,160) was granted on August 28, 1990. Since these two registrations (of Opposer) were permitted to be registered over Reg. No. 900,272 of the mark BIG WHEELS for "pneumatic tires", Applicant argued that Applicant's BIGG WHEELS mark should also be permitted to be registered over these two cited registrations as well as the third cited registration (No. 2,411,926) for the mark BIG O TIRES. Thereafter Applicant's BIGG WHEELS mark opposed herein was approved for publication for opposition.

The BIG "G" IS YOUR GUARANTEE Registration 772,529 (AX 11) and BIG A and design Registration 1,388,039 (AX 13) are now expired. Nevertheless, Applicant submits they are relevant to show the relative weakness of composite marks including the term "BIG" at the time of Applicant's adoption, filing and use of Applicant's BIGG WHEELS mark and therefore such marks should be narrowly construed to be limited to the particular forms of the marks as a whole and the goods/services with which the marks are used.

The following additional third party US registrations are also submitted as being relevant to the issue of likelihood of confusion:

(1) BIG WHEEL ROSSI Reg. Nos. 2,508,562 (AX 17) and 2,596,506 (AX 18) for "retail store services featuring automotive parts" and "automotive repair and maintenance", respectively. Although the grace period has ended in AX 17 and is about to end in AX 18, both of these registrations were in existence at the time of Applicant's adoption, filing and use of Applicant's BIGG WHEELS mark opposed herein and are

therefore relevant to show the relative weakness of composite marks including the term "BIG" at that time for the same or related goods/services.

(2) BIG DAWG Reg. No. 3,221,264 (AX 20) for "tires for industrial equipment not for highway service".

(3) BIG JAKE Reg. No. 2,875,923 (AX 19) for "tires for industrial, mining, agricultural and forestry applications".

(4) BIG MAX Reg. Nos. 2,146,279 (AX 14), 2,402,095 (AX 16) and 3,454,188 (AX 21) for "trailers to be pulled behind vehicles", "battery booster cables", and "emergency automobile tire change kit consisting of a hydraulic car jack", respectively.

All of these latter third party registrations AX 20, AX 19, AX 14, AX 16, and AX 21 are still in force. Opposer entered into agreements with the owners of the marks BIG DAWG, BIG JAKE and BIG MAX relating to the use of their respective marks. See Opposer's Exhibits A-C to joint stipulation regarding evidence. However, in each agreement Opposer acknowledged the owners' rights to use their respective marks for all of the goods specified in the corresponding registrations, including for example use of the mark BIG MAX for emergency automobile tire change kit consisting of a hydraulic jack, covered by Reg. No. 3,454,188 (AX 21) and battery booster cables covered by Reg. No. 2,402,095 (AX 16), which are unquestionably automotive related products.

Moreover, there are absolutely no restrictions on the use of BIG BRAND by the owner of Reg. No. 2,195,058 (AX 15) discussed previously for "distributorships in the field of vehicle tires, brake pads and shock absorbers", which unquestionably relate to automotive goods/services.

From this it is submitted that composite marks including the term "BIG" for automotive related products/services should be narrowly construed to be limited to the particular forms of the marks as a whole and the goods/services with which the marks are used.

### 3. Applicant's Awareness of Opposer

Applicant first became aware of Opposer by cold calling one of Opposer's stores in Kentucky. This resulted in a sale by Applicant of eight wheels to Opposer's Kentucky store in August of 2002. Lamb Tr. 11:4-15, 12:2-15:5, AX 1. However, this prior knowledge by Applicant of Opposer and possibly some of Opposer's Marks does not, without more, create an inference of bad faith. *Playtex Products, Inc. v. Georgia-Pacific Corp.*, 390 F.3d 158, 166, 73 USPQ 2d 1127 (2d Cir. 2004).

To the contrary, Applicant's CEO Mark Lamb, who made the decision to adopt the BIGG WHEELS mark, did not consider the Opposer or any of its marks in his selection of the BIGG WHEELS mark. The reason he adopted the BIGG WHEELS mark was to emphasize the big styling for this particular style of wheels. Lamb Tr. 9:9-10:6. Also at the time Mr. Lamb adopted the BIGG WHEELS mark he was aware that the term BIG was commonly used as part of company names/trade names in the automotive field. Lamb Tr. 10:6-16. From this it is evident that Applicant adopted its BIGG WHEELS mark in good faith.

### B. Dilution

The owner of a famous mark may oppose a trademark application or file a petition for cancellation based on whether the opposed mark will dilute the famous

mark. However, to prevail, the opposer must prove that (1) opposer's mark is famous and distinctive, (2) opposer's mark became famous before the priority date of applicant's mark, and (3) applicant's mark is likely to cause dilution of the famous mark's distinctive quality through blurring or tarnishment. 15 U.S.C. 1125(c)(1).

To be famous under the federal dilution statute, a mark must be "widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the marks' owner." 15 U.S.C. 1125(c)(2).

In determining whether a mark possesses the requisite degree of recognition to qualify as a famous mark for protection from dilution, the Board may consider all relevant factors, including the following:

- (i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.
- (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.
- (iii) The extent of actual recognition of the mark.
- (iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the Principal Register. 15 U.S.C. 1125(c)(2)(A).

Even if the evidence proffered by Opposer were found to establish that the BIG O TIRES Mark has achieved substantial public recognition, Applicant submits that Opposer has not established the requisite widespread recognition of the mark by the general consuming public outside Opposer's specific trading fields as a designation of source of the goods or services of the Opposer.<sup>4</sup> Therefore, Opposer's BIG O TIRES Mark should not be afforded protection under the dilution law. That is reserved for a

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<sup>4</sup> 15 U.S.C. 1125(c)(2)

small number of especially famous and distinctive marks that are truly prominent and renowned, and a household name. *Avery Dennison Corp. v. Sumpton*, 189 F.3d 868, 875, 51 USPQ 2d 1801 (9<sup>th</sup> Cir. 1999), *Thane Int'l v. Trek Bicycle Corp.*, 305 F.3d 894, 911, 64 USPQ 2d 1564 (9<sup>th</sup> Cir. 2002).

Even if Opposer's BIG O TIRES Mark were found to be famous under the federal dilution statute, Applicant's BIGG WHEELS mark is not likely to cause dilution of the distinctive quality of Opposer's Mark through blurring or tarnishment. The dilution statute defines "dilution by blurring" as an "association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark"<sup>5</sup>, and defines "dilution by tarnishment" as an "association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark"<sup>6</sup>.

Applicant submits there is no similarity between Applicant's BIGG WHEELS mark and Opposer's BIG O TIRES Mark that would impair the distinctiveness or harm the reputation of Opposer's BIG O TIRES Mark for the reasons previously discussed in the prior section on likelihood of confusion.

## V. SUMMARY

When Opposer's BIG O, BIG O TIRES and BIG FOOT marks ("BIG O TIRES Marks") and Applicant's BIGG WHEELS mark are considered in their entirety, Applicant's BIGG WHEELS mark is sufficiently different from Opposer's BIG O TIRES

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<sup>5</sup> 15 U.S.C. 1125(c)(2)(B).

<sup>6</sup> 15 U.S.C. 1125(c)(2)(C)

Mark in sound, appearance and commercial impression so as not to cause any likelihood of confusion as to source or sponsorship of the goods/services offered under the marks.

Moreover, the evidence submitted by the Opposer of the extent of use of Opposer's BIG O TIRES Mark, its sales of goods/services offered thereunder, and its advertising and promotional activities relating thereto are not sufficient to establish that Opposer's BIG O TIRES Mark is famous. Therefore, Opposer's BIG O TIRES Mark is not entitled to protection under the federal dilution statute.

Even if Opposer's BIG O TIRES Mark were found to be famous for protection from dilution, Applicant's BIGG WHEELS Mark is not likely to cause dilution of the distinctive quality of Opposer's BIG O TIRES Mark through blurring or tarnishment.

Accordingly, Applicant respectfully submits that the opposition should be dismissed, and Applicant's BIGG WHEELS mark should be permitted to proceed to registration.

Respectfully submitted,

WHEEL SPECIALTIES, LTD.

Date: January 21, 2009

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*Attorneys for Applicant*

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing TRIAL BRIEF OF APPLICANT was served on the following attorney of record for Opposer by depositing same in the United States mail, postage prepaid, this 21<sup>st</sup> day of January, 2009.

Marsha G. Gentner  
Matthew J. Cuccias  
JACOBSON HOLMAN, PLLC  
400 Seventh Street, N.W.  
Washington, D.C. 20004

  
\_\_\_\_\_  
Donald L. Otto

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Trademarks  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

on January 21, 2009

  
\_\_\_\_\_  
Donald L. Otto

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

BIG O TIRES, LLC	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. 91163791
	)	
WHEEL SPECIALTIES, LTD.	)	
	)	
Applicant.	)	

**ATTACHMENT A  
TO  
TRIAL BRIEF OF APPLICANT**

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451  
www.uspto.gov

REGISTRATION NO: 2195058 SERIAL NO: 75/285978 MAILING DATE: 08/19/2008  
REGISTRATION DATE: 10/13/1998  
MARK: BIG BRAND  
REGISTRATION OWNER: MAJCO, INC.

**CORRESPONDENCE ADDRESS:**

GENE W ARANT  
Gene W Arant, Attorney  
1818 NE 21st  
PO Box 269  
Lincoln City, OR 97367

**NOTICE OF ACCEPTANCE**

15 U.S.C. Sec. 1058(a)(3)

THE COMBINED AFFIDAVIT AND RENEWAL APPLICATION FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 8 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1058. ACCORDINGLY, THE SECTION 8 AFFIDAVIT IS ACCEPTED.

\*\*\*\*\*

**NOTICE OF RENEWAL**

15 U.S.C. Sec. 1059(a)

THE COMBINED AFFIDAVIT AND RENEWAL APPLICATION FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 9 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1059. ACCORDINGLY, THE REGISTRATION IS RENEWED.

\*\*\*\*\*

**THE REGISTRATION WILL REMAIN IN FORCE FOR CLASS(ES):**  
035.

CONLEY, JOYCE MARIE  
PARALEGAL SPECIALIST  
POST-REGISTRATION DIVISION  
571-272-9500

**PLEASE SEE THE REVERSE SIDE OF THIS NOTICE FOR INFORMATION  
CONCERNING REQUIREMENTS FOR MAINTAINING THIS REGISTRATION  
ORIGINAL**

**REQUIREMENTS FOR MAINTAINING A FEDERAL TRADEMARK REGISTRATION) SECTION 8: AFFIDAVIT OF CONTINUED USE** The registration shall remain in force for 10 years, except that the registration shall be canceled for failure to file an Affidavit of Continued Use under Section 8 of the Trademark Act, 15 U.S.C. Sec. 1058, at the end of each successive 10-year period following the date of registration.

**Failure to file the Section 8 Affidavit will result in the cancellation of the registration.**

**II) SECTION 9: APPLICATION FOR RENEWAL** The registration shall remain in force for 10 years, subject to the provisions of Section 8, except that the registration shall expire for failure to file an Application for Renewal under Section 9 of the Trademark Act, 15 U.S.C. Sec. 1059, at the end of each successive 10-year period following the date of registration. **Failure to file the Application for Renewal will result in the expiration of the registration.**

**NO FURTHER NOTICE OR REMINDER OF THESE REQUIREMENTS WILL BE SENT TO THE REGISTRANT BY THE PATENT AND TRADEMARK OFFICE. IT IS RECOMMENDED THAT THE REGISTRANT CONTACT THE PATENT AND TRADEMARK OFFICE APPROXIMATELY ONE YEAR BEFORE THE EXPIRATION OF THE TIME PERIODS SHOWN ABOVE TO DETERMINE APPROPRIATE REQUIREMENTS AND FEES.**

## Combined Declaration of Use In Commerce & Application For Renewal of Registration of A Mark Under Sections 8 & 9

The table below presents the data as entered.

Input Field	Entered
REGISTRATION NUMBER	2195058
REGISTRATION DATE	10/13/1998
SERIAL NUMBER	75285978
<b>MARK SECTION</b>	
MARK	BIG BRAND
<b>OWNER SECTION (current)</b>	
NAME	MAJCO, INC.
STREET	805 VIA ALONDRA
CITY	CAMARILLO
STATE	California
ZIP/POSTAL CODE	93012
COUNTRY	United States
<b>OWNER SECTION (proposed)</b>	
NAME	MAJCO, INC.
STREET	805 VIA ALONDRA
CITY	CAMARILLO
STATE	California
ZIP/POSTAL CODE	93012
COUNTRY	United States
PHONE	805-388-0223
<b>ATTORNEY SECTION (current)</b>	
NAME	GENE W ARANT

FIRM NAME	P.O. BOX 269
STREET	LINCOLN, OR 93012
ATTORNEY DOCKET NUMBER	134000.0033
<b>ATTORNEY SECTION(proposed)</b>	
NAME	GENE W ARANT
FIRM NAME	Gene W Arant, Attorney
INTERNAL ADDRESS	1818 NE 21st
STREET	PO Box 269
CITY	Lincoln City,
STATE	Oregon
POSTAL CODE	97367
COUNTRY	United States
PHONE	541-557-1716
EMAIL	gwapat@charterinternet.com
AUTHORIZED TO COMMUNICATE VIA E-MAIL	Yes
ATTORNEY DOCKET NUMBER	0134
<b>GOODS AND/OR SERVICES SECTION</b>	
INTERNATIONAL CLASS	035
GOODS OR SERVICES	KEEP ALL LISTED
SPECIMEN FILE NAME(S)	<u>\\TICRS\EXPORT2\IMAGEOUT2</u> <u>\752\859\75285978\xml1\S8 90002.JPG</u>
SPECIMEN DESCRIPTION	Picture of store front for Big Brand
<b>PAYMENT SECTION</b>	
NUMBER OF CLASSES	1
NUMBER OF CLASSES PAID	1
SUBTOTAL AMOUNT	500
TOTAL FEE PAID	500
<b>SIGNATURE SECTION</b>	
SIGNATURE	/Gene W Arant/

<b>SIGNATORY'S NAME</b>	Gene W Arant
<b>SIGNATORY'S POSITION</b>	Attorney of Record
<b>DATE SIGNED</b>	07/24/2008
<b>PAYMENT METHOD</b>	DA
<b>FILING INFORMATION</b>	
<b>SUBMIT DATE</b>	Thu Jul 24 15:39:23 EDT 2008
<b>TEAS STAMP</b>	USPTO/S08N09-68.116.42.28 -20080724153923007578-219 5058-400f18a9a4cbbf23688c d597cba425758-DA-836-2008 0724144844233749

US Form 19e3 (Rev 5/2005)  
 12/11/2011 10:15 (Exp 12/31/2011)

**Combined Declaration of Use In Commerce & Application For Renewal of  
 Registration of A Mark Under Sections 8 & 9**

**To the Commissioner for Trademarks:**

**REGISTRATION NUMBER:** 2195058

**REGISTRATION DATE:** 10/13/1998

**MARK:** BIG BRAND

The owner, MAJCO, INC., having an address of  
 805 VIA ALONDRA  
 CAMARILLO, California 93012  
 United States

is filing a Combined Declaration of Use In Commerce & Application For Renewal of Registration of A  
 Mark Under Sections 8 & 9.

For International Class 035, the mark is in use in commerce on or in connection with **all** goods or services  
 listed in the existing registration for this specific class; or, the owner is making the listed excusable nonuse  
 claim.

The owner is submitting one specimen showing the mark as used in commerce on or in connection with  
 any item in this class, consisting of a(n) Picture of store front for Big Brand.

Specimen File1

The registrant hereby appoints GENE W ARANT of Gene W Arant, Attorney  
1818 NE 21st  
PO Box 269  
Lincoln City,, Oregon 97367  
United States

to file this Combined Declaration of Use In Commerce & Application For Renewal of Registration of A  
Mark Under Sections 8 & 9 on behalf of the registrant. The attorney docket/reference number is 0134.

A fee payment in the amount of \$500 will be submitted with the form, representing payment for 1  
class(es), plus any additional grace period fee, if necessary.

### **Declaration**

#### **Section 8: Declaration of Use in Commerce**

*Unless the owner has specifically claimed excusable non-use, the owner, or its related company, is using the mark in commerce on or in connection with the goods and/or services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce.*

#### **Section 9: Application for Renewal**

*The registrant requests that the registration be renewed for the goods and/or services identified above.*

The undersigned being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of this document, declares that he/she is properly authorized to execute this document on behalf of the Owner; and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.

Signature: /Gene W Arant/ Date: 07/24/2008  
Signatory's Name: Gene W Arant  
Signatory's Position: Attorney of Record

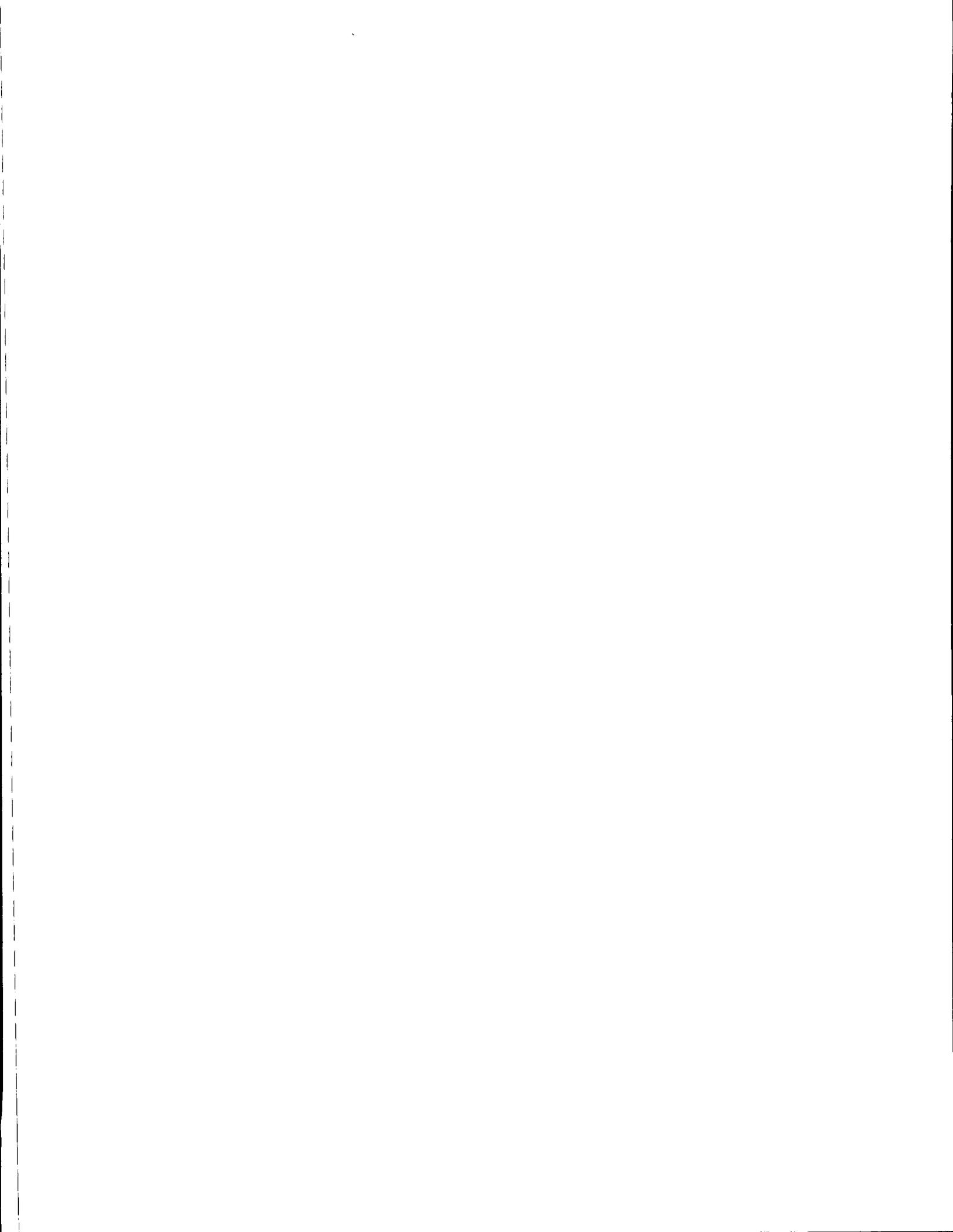
#### **Mailing Address (current):**

P.O. BOX 269  
LINCOLN, OR 93012

#### **Mailing Address (proposed):**

Gene W Arant, Attorney  
PO Box 269  
Lincoln City,, Oregon 97367

Serial Number: 75285978  
Internet Transmission Date: Thu Jul 24 15:39:23 EDT 2008  
TEAS Stamp: USPTO/S08N09-68.116.42.28-20080724153923  
007578-2195058-400f18a9a4cbbf23688cd597c  
ba425758-DA-836-20080724144844233749





**ROUTING SHEET TO POST REGISTRATION (PRU)**

**Registration Number:** 2195058



**Serial Number:** 75285978



**RAM Sale Number:** 836

**RAM Accounting Date:** 20080725

**Total Fees:** \$500

Note: Process in accordance with Post Registration Standard Operating Procedure (SOP)

<u>Transaction</u>	<u>Fee Code</u>	<u>Transaction Date</u>	<u>Fee per Class</u>	<u>Number of Classes</u>	<u>Number of Classes Paid</u>	<u>Total Fee</u>
§8 affidavit	7205	20080724	\$100	1	1	\$100
Application for Renewal (§9)	7201	20080724	\$400	1	1	\$400

Physical Location: 900 - FILE REPOSITORY (FRANCONIA)

Lost Case Flag: False

In TICRS (AM-FLG-IN-TICRS): True

**Transaction Date:** 20080724



