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

Proceeding	91163791
Party	Plaintiff BIG O TIRES, INC.
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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.	)	

REPLY TRIAL BRIEF OF OPPOSER

Opposer, Big O Tires, LLC (hereinafter "Opposer" or "Big O Tires"), hereby submits its Reply Trial Brief in this opposition proceeding; and respectfully submits that the opposition should be sustained on both grounds raised in the Notice of Opposition, namely, likelihood of confusion and dilution.

I. LIKELIHOOD OF CONFUSION

As Applicant has acknowledged, the test for determining likelihood of confusion involves the assessment of a number of factors under the *duPont* analysis. Opposer's trial brief ("Opposer's Brief") set forth six (6) of these factors as pertinent to this case. Applicant's trial brief ("Applicant's Brief") limited itself to only three (3) *duPont* factors – the similarity of marks, the claimed existence of third party references, and the claimed good faith adoption of Applicant's mark – and ignored the remainder. Thus, Applicant has conceded the fame of Opposer's **BIG O TIRES** Mark, a dominant factor in the *duPont* analysis. *Kenner Marker Toys v. Rose Arts Industries*, 936 F.2d 350, 352, 22 U.S.P.Q. 2d 1453 (Fed. Cir. 1992). As such, Opposer's **BIG O TIRES** Mark is entitled to the broadest possible scope of protection available, reducing the quantum of evidence of the remaining factors necessary to establish a likelihood of confusion. *See, e.g., Kenner Parker Toys, Inc.*, 963

F.2d at 352-3.

Similarly, Applicant has conceded that the goods set forth in the opposed BIGG WHEELS application are identical and/or closely related to Opposer's **BIG O TIRES** products, service and business. Additionally, Applicant has conceded that the channels of trade and customers for the goods in the opposed BIGG WHEELS application and those for Opposer's **BIG O TIRES** goods, services, stores and business are identical and/or overlapping. Hence, a much lower threshold degree of similarity of the marks, themselves, is required to establish a likelihood of confusion. *See e.g., RJR Foods, Inc. v. White Rock Corp.*, 201 USPQ 578 (SDNY 1978). However, in view of the stark similarity between Opposer's **BIG O TIRES** Mark and the opposed BIGG WHEELS mark, such legal inferences are not required to find a likelihood of confusion.

1. The Opposed BIGG WHEELS Mark Is Virtually Identical to Big O Tires's Famous BIG O TIRES Mark.

The first *duPont* factor – the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression – weighs strongly in favor of a finding of likely confusion. Indeed, Applicant has admitted the aural similarity of the marks. *See* Applicant's Brief, p. 6.

Applicant's attempts to distinguish Opposer's **BIG O TIRES** Mark from Applicant's BIGG WHEELS[1] mark are without merit. Applicant's argument for distinguishing the appearance of the marks is that "the term BIGG of Applicant's mark includes two Gs, which gives it an entirely different appearance from the term BIG." Applicant's Brief, p.6. Applicant offers no explanation

[1] Not only have Applicant's BIGG WHEELS wheels been promoted and sold under the single word mark "BIGG", Applicant's CEO conversationally refers to the mark by the single word "BIGG". *See* testimonial deposition transcript of Mark Lamb ("Lamb Tr."), Tr. 15:13 ("This is the amount of BIGG WHEELS we sold . . . .").

for this conclusionary assertion. Similarly, there is no citation to the record to support the assertion that BIGG appears "entirely different" from BIG; or that any such difference would be perceived, and then understood, by the consuming public as a distinguishing feature of the mark. Indeed, to the extent that any consumer recognizes the repetitive second letter "G" in Applicant's mark, Opposer respectfully submits that it would only enhance confusion since the shape and appearance of the letter "G" and the letter "O" in the respective marks is quite similar. Alternatively, the term "BIGG" may be viewed as a non-standard variation of the word "BIG".[2] Thus, Opposer respectfully submits that Applicant's BIGG WHEELS mark is similar in appearance to Big O's **BIG O TIRES** Mark.

Applicant seeks to distinguish the meaning or commercial impression of the marks on the basis that Applicant adopted the mark "in order to create the connotation and commercial impression that the automobile wheels to which the mark is applied had 'big styling'". *See* Applicant's Brief, p.7. The argument is without merit. As an initial matter, there is no explanation – in the record or even in Applicant's Brief – as to the meaning of "big styling". Thus, even as a conceptual matter, this undefined "difference" cannot serve to distinguish the connotation of the parties' respective marks. Moreover, it is not Applicant's attempt to create a certain commercial impression that is relevant, but whether the consuming public perceives the connotation and appreciates it as distinguishing it from other marks. Clearly, the record is devoid of any such evidence.

Finally, since Applicant's goods are identical and/or closely related to Opposer's **BIG O TIRES** products, service and business – a contention conceded by Applicant – a lesser similarity of the marks at issue is required to establish a likelihood of confusion. *See Fossil Inc. v. Fossil Group*,

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[2] Indeed, Applicant, itself, characterizes the term that is "shared" by the parties' marks as "BIG" (*i.e.,* without the second "G"). *See* Applicant's Brief, p.6 (The parties marks "all share a *term* that sounds the same, namely, BIG.") (emphasis supplied).

49 USPQ2d 1451 (TTAB 1998) ("[A]s the degree of similarity of the goods of the parties increases, 'the degree of similarity [of the marks] necessarily to support a conclusion of likely confusion declines.'").

Accordingly, Opposer respectfully submits that Applicant's BIGG WHEELS mark is similar to Big O's **BIG O TIRES** Mark, and this factor heavily weighs in favor of a finding of confusing similarity.

2. There Is No Admissible Evidence of Any Relevant Similar Marks in Use on Similar Goods/Services.

In view of certain third party references, Applicant contends 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." Applicant's Brief, p.14. However, there is no competent evidence in the record to support Applicant's contention. Applicant's "evidence" takes the form of federal trademark registrations in the name of third parties, as well as internet printouts and Applicant's prospective lead/customer list. None of this "evidence" is relevant to the present query.

A. Third Party Registrations Are Irrelevant

Applicant seeks to rely on eleven (11) third party registrations. AX11-21. As discussed more generally below, these registrations are irrelevant. However, it is noted that of the eleven (11) registrations, several registrations have been cancelled (*e.g.*, nos. 772,529 [AX11]; 900,272 [AX12]; and 1,388,039 [AX13]) or are about to be cancelled since the grace period has ended without the filing of the required declarations (*i.e.*, nos. 2,580,562 [AX17] and 2,596,506 [AX18]). Of the six (6) remaining registrations only one (1) registration issued without Big O's

express consent and subject to substantial limitations and restrictions imposed by Big O. *Compare* AX14, 16, 19-21 *with* Exhibit A-C to Joint Stipulation Regarding Evidence.[3]

Even if all of the third party registrations were still viable and did not issue pursuant to restrictions imposed by Big O, they would still be wholly irrelevant to the *duPont* analysis. The TMEP (and the applicable law) distinguish between third party *uses* (relevant under *duPont* factor 6) and third party *registrations*. *See* TMEP §1207.01(d)(iii) ("Generally, the existence of third-party registrations cannot justify the registration of another mark that is so similar to a previously registered mark as to create a likelihood of confusion, or to cause mistake, or to deceive."). As, the predecessor to the Federal Circuit opined:

> Third party registrations are often cited in an effort to prove that, because the marks appearing in those registrations are similar to the mark in use by an applicant, an opposer, or cancellation petitioner, the public has learned to distinguish among them and would not be confused by the addition to the marketplace of the mark sought to be registered or by continued use of the mark sought to be maintained on a register. Whether the public has been so conditioned turns on whether it has been actually exposed to the similar third party marks in the marketplace, and on the extent and intensity of that exposure. A registration does not inherently evidence that exposure, and the presumption that registered marks of third parties are in use does not clothe the cited registrations with that evidentiary effect.

In re Clorox Co., 578 F.2d 305, 198 U.S.P.Q. 337 (C.C.P.A. 1978) (Markey, C.J., specially concurring). *See also*, Sams, Third Party Registrations in T.T.A.B. Proceedings," 72 Trademark Rep. 297 (1982) ("third party registrations are of extremely limited evidentiary value).

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[3] Applicant mischaracterizes the effect of Big O's settlement agreements – "in each agreement, Opposer acknowledged the owner's rights to use their respective marks for all of the goods specified in the corresponding registrations." The agreements imposed significant restrictions on the third parties' right to use the various marks. *Id.*

It is axiomatic that third party registrations do not evidence a "use" of the registered mark that is relevant to the sixth *du Pont* factor. *See San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 196 USPQ 1 (CCPA 1977) ("With respect to the many third-party registrations put into the record of marks using 'mono' or 'micro' or 'ceramic' or parts thereof, there is no evidence showing that any of them are in use so as to have conditioned the minds of prospective purchasers."). Rather, it "is well settled that third-party registrations are not evidence of what happens in the marketplace or that the public is familiar with the use of the subject marks." *See National Aeronautics & Space Administration v. Record Chemical Co.*, 185 USPQ 563, 567 (TTAB 1975); *ProQuest Information and Learning Company v. Island*, 83 USPQ2d 1351 (TTAB 2007) (same). Accordingly, Opposer respectfully submits that the third party registrations submitted by Applicant (at AX11-21) are wholly irrelevant.[4]

Finally, the Examiner's decision to publish the opposed application for opposition is not dispositive of, or even relevant to, the present *inter partes* proceeding; and Applicant's historical recitation of its arguments raised during prosecution, Applicant's Brief, pp.10-12, is irrelevant (as are the referenced registrations that were not properly introduced into evidence).

B. Alleged Third Party "Uses" Are Irrelevant.

Applicant contends that public has learned to distinguish among various third party marks and would not be confused by the addition to the marketplace of Applicant's BIG WHEELS mark. However, this determination "turns on whether it has been actually exposed to the similar third party marks in the marketplace, and on the extent and intensity of that exposure." *In re*

[4] Opposer asserted the irrelevancy of the third party registrations in its trial brief. *See* Opposer's Brief, pp. 34-35. That Applicant did not challenge this assertion, or seek to distinguish its relied-upon registrations, stands as a concession to the lack of relevance of the third party registrations.

Clorox Co., supra. The "probative value of third-party trademarks depends entirely upon their usage." *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005), *citing Scarves by Vera, Inc. v. Todo Imports, Ltd.*, 544 F.2d 1167, 1173 (2d Cir.1976) ("The significance of third-party trademarks depends wholly upon their usage. Defendant introduced no evidence that these trademarks were actually used by third parties, that they were well promoted or that they were recognized by consumers."). Since Applicant has not demonstrated that the consuming public has "been actually exposed to the similar third party marks in the marketplace, and on the extent and intensity of that exposure", the references are without probative value.

i. Internet Search Results Improperly Sought to Be Introduced by Notice of Reliance Should Be Stricken

Applicant sought to introduce numerous "Internet publications" by way of Notice of Reliance, pursuant to 37 C.F.R. §2.122(e). *See* AX22-52. However, such documents facially are not admissible by way of Notice of Reliance:

> **Internet evidence and other materials that are not self-authenticating.** Certain printed publications qualify for submission by notice of reliance under Trademark Rule 2.122(e) because they are considered essentially self-authenticating. That is, permanent sources for the publications are identified and the nonoffering party is readily able to verify the authenticity of the documents. The element of self-authentication cannot be presumed to be capable of being satisfied by information obtained and printed out from the Internet. Internet postings are transitory in nature as they may be modified or deleted at any time without notice and thus are not "subject to the safeguard that the party against whom the evidence is offered is readily able to corroborate or refute the authenticity of what is proffered." For this reason, Internet printouts cannot be considered the equivalent of printouts from a NEXIS search where printouts are the electronic equivalents of the printed publications and permanent sources for the publications are identified.

See TBMP §704.08. Accordingly, Opposer moved to strike the documents attached to AX22-52. *See* Opposer's Brief, pp.34-35. Applicant's Brief failed to respond to Opposer's motion, nor has it sought to defend the admissibility of AX22-52. Accordingly, the "evidence" should be stricken.[5]

ii. Internet Search Results Introduced During Deposition

During the testimonial deposition of Applicant, Applicant sought to introduce Internet search results. *See* AX7. The nearly seventy (70) pages of printouts should be stricken since the documents were never disclosed by Applicant in response to Opposer's discovery requests seeking this very information (as evidenced by the absence of bates numbers).[6] *See* Lamb Tr. 28:1-3. Indeed, the July 26, 2008 "print" date on the documents was more than one full month before Applicant's testimonial deposition, yet Applicant failed to produce the documents.[7]

However, even if not stricken, the printouts are irrelevant since there is no evidence or testimony that the marks referenced therein were in use. Applicant's witness only testified that the companies identified in the search were automotive companies dealing with automotive related products and services. He did not testify that he knew of these businesses, that they were actively engaged in business, or (if so) how long they had been so engaged. Additionally, there is no evidence or testimony that the businesses/trademarks are well promoted to, or even recognized by, the consuming public. Similarly, the record is devoid of the geographic area of

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[5] Alternatively, if not stricken, no weight should be accorded AX22-52 since there is no competent evidence as to the length of the use of the marks, how well promoted they have been, or whether they are recognized by the consuming public.

[6] *See* Interrogatory no. 15 and document request no. 60, attached as Exhibit A to Opposer's January 30, 2006 Motion to compel.

[7] There are technical and other problems with the submission as well. For example, some of the printouts are incomplete or do not indicate whether the business is located in the United States.

alleged use or the commercial impact the marks have in the market place. Accordingly, there is no probative value to the alleged third party uses. *See Palm Bay Imports, Inc., supra.*

iii. Applicant's "List" (AX8)

Applicant seeks to rely on exhibits and testimony regarding company names that contain the term "big" which are on a list of Applicant's *prospective* leads or customers. *See* AX8. However, Applicant did not know how many of the companies on the list were actual, current customers. Lamb Tr. 35:23-36:7. Indeed, Applicant only identified two of the companies as current customers. Lamb Tr. 34:23-35:4; 35:16-22.

In any event, these references are irrelevant since there is no indication that the companies are active going concerns[8], that they operate in the marketplace under the identified names (as opposed to a "dba"), the length of time they have been used (with one possible exception), or the "extent and intensity" of the exposure to the consuming public.

Finally, Applicant improperly attempted to submit "evidence" along with its trial brief. *See* "Attachment A to Trial Brief of Applicant". The proffer is untimely, *see* 37 CFR § 2.123(l), TBMP §706, and Opposer respectfully submits that it and the related portions of Applicant's Brief should not be considered by the Board. *Id.*

3. Applicant's Pre-Filing Knowledge of Opposer

Applicant admits that its selection and use of the BIGG WHEELS mark for wheels and the filing of the opposed application was made with actual knowledge of Big O Tires, its **BIG O TIRES**

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[8] Applicant did not testify that the list is regularly reviewed to weed out "dead" prospective leads. Indeed, when Applicant's counsel asked if this is "a current list or an outdated list", Applicant responded only that it was "recent". Lamb Tr. 36:14-20. There are other reasons to question the accuracy of the list. For example, Applicant contends that Big O was a customer, yet it is not listed on AX8.

Mark, business, stores and/or registrations. Indeed, prior to the selection, use or filing of an application for the BIGG WHEELS mark, Applicant had visited Big O Tires's stores, wherein the **BIG O TIRES Mark** is conspicuously promoted. Moreover, prior to the selection of the BIGG WHEELS mark, Applicant engaged in commerce with a Big O Tires franchisee, selling it non-BIGG WHEELS wheels. Thus, Applicant possessed actual knowledge of Big O Tires and its rights for nearly identical marks in connection with nearly identical goods and/or highly related services.

Applicant – being aware that "[a]dopting a designation with knowledge of its trademark status permits a presumption of intent to deceive. . . . In turn, intent to deceive is strong evidence of a likelihood of confusion."[9] – seeks to argue that its adoption of the BIGG WHEELS mark was in good faith. This argument is without merit.

Applicant points to three circumstances which it says supports its good faith adoption of the mark. First, Applicant argues that at the time Applicant's CEO "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." *See* Applicant's Brief, p.14. However, the only citation to the record was Applicant's one-word affirmation of Applicant's counsel's leading question (to which Opposer objected). *See* Lamb Tr. 10:6-24. Moreover, there is no identification of these companies, as they existed in 2003. Accordingly, the weight – if any – accorded to this self-serving testimony should be quite limited.

Second, Applicant contended that it did not consider Opposer or any of its marks in the selection of the BIG WHEELS mark. Again, the only evidence supporting this assertion is

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[9] *Interstellar Starship Services, Ltd. v. Epix Inc.*, 184 F.3d 1107, 51 (9th Cir. 1999), *cert. denied*, 528 U.S. 1155, 120 S. Ct. 1161, 145 L. Ed. 2d 1073 (2000).

Applicant's extremely terse response to its counsel's leading question. *See* Lamb Tr. 9:17-21. Accordingly, this self-serving testimony should be accorded no weight.

Finally, Applicant states that the reason the BIGG WHEELS mark was adopted was to "emphasize the big styling for this particular style of wheels". *See* Applicant's Brief, p.14. However, as discussed above, this is a non sequitur. The term "big styling" has absolutely no meaning in the record, and even Applicant's Brief does not attempt to explain, or expound upon, it. Accordingly, this cannot support Applicant's "good faith adoption" argument.

4. Applicant's Improper Attempt to Raise Affirmative Defense

Applicant's Brief mentions that one[10] of the 550 Big O franchisees purchased BIGG WHEELS wheels from Applicant; but does not discuss its alleged significance. It is possible that the reference is intended to constitute an impermissible attempt to belatedly raise an affirmative defense, such as laches or acquiescence. Any such effort should be rejected.

As an initial matter, since Applicant never pleaded laches, acquiescence or a similar affirmative defense in its Answer, it is not entitled to rely on it at trial. *See* TBMP 311.02(c) ["Except as provided in Fed. R. Civ. P. 12(b) and 12(h)(2) (which allow a defendant to raise certain specified defenses by motion), an unpleaded defense cannot be relied upon by the defendant unless the defendant's pleading is amended (or deemed amended), pursuant to Fed. R. Civ. P. 15(a) or 15(b), to assert the matter"]. Accordingly, Applicant may not rely on any unpleaded affirmative defense at trial.

[10] Apparently, AX9 is a list of "customers" from theVirginia location of Custom Wheels. It is not specifically customers of Applicant's BIGG WHEELS wheels. Indeed, Applicant sells wheels under other marks than that involved in this dispute. *See e.g.*, Lamb Tr. 12:18-23.

Not only was Opposer not put on notice of these phantom affirmative defense(s) by way of Applicant's Answer, but the timing and manner of the disclosure of the relied upon information is suspect. Applicant did not timely produce the document found at AX3 – and never produced the documents found at AX 9 – in response to Opposer's discovery requests. While the information in AX3 dates back to 2004, it was not produced until January 28, 2008, which, at the time, was only two weeks before the beginning of the trial. Accordingly, the testimony and exhibits were objected to during the testimonial deposition. *See e.g.,* Lamb Tr. 15:2, 15:19-24, 16:10-11, 17:4-7, 38:11-13.

In short, Applicant has failed to establish that it is entitled to rely on any affirmative defense to which the above-referenced sale would be relevant – let alone identify the specific theory, annunciate its operative elements, and explain how the facts support the theory. Accordingly, Applicant has failed to carry its burden. In view of this failure, Opposer will not take it upon itself to identify each *possible* affirmative defense, outline the relevant elements of same, and argue why the facts do not support each such possible defense).[11]

II. DILUTION

The two page portion of Applicant's Brief dedicated to Opposer's dilution claim simply recites the applicable standard and then, in a conclusionary fashion, asserts that Opposer has not met its burden. Applicant's Brief does not articulate a basis for this assertion; and such treatment should stand as a concession to the dilution claim.

[11] Moreover, the quantity of wheels allegedly purchased by a franchisee is miniscule compared to the total number of wheels purchased by all of Big O's franchisees, *compare e.g.*, AX3 with OX35D, and would not have served to put Opposer on notice.

III. CONCLUSION

The record establishes – and Applicant concedes – that Opposer's **BIG O TIRES Mark** is distinctive, famous, and strong, and, thus, entitled to the broadest scope of protection. Similarly, Applicant's concessions track the record, which establishes that Opposer's goods and services and those in the opposed application are identical or highly similar, are sold in the same channels of trade, to the same customers under circumstances which only serve to heighten confusion.

In view of these established facts, the degree of similarity of the marks needed to support a finding of a likelihood of confusion is lowered. However, even without these legal presumptions, the Board can find that the first *duPont* factor favors Opposer in that the marks are highly similar. Indeed, Applicant concedes the aural similarity of the parties' marks; and its attempts to distinguish the appearance and meaning of the respective marks is unavailing.

Opposer's pleaded **BIG O TIRES Mark** has been registered for decades, and its fame demands that Applicant steers clear of encroaching on the mark. Nevertheless, Applicant selected its mark with full knowledge of Opposer and its rights; Applicant's unpersuasive explanations notwithstanding.

The third party references cited by Applicant are not properly before the Board and/or are irrelevant to the present inquiry.

As set forth in Opposer's Brief, Applicants's BIGG WHEELS mark dilutes the distinctive quality of Big O Tires's distinctive and famous **BIG O TIRES Mark**.

Accordingly, and for all of the reasons referenced above and in Opposer's Brief, Opposer respectfully submits that the present opposition should be sustained, and registration of application serial no. 78/264,260 be refused.

Respectfully submitted,

BIG O TIRES, LLC

Date: February 5, 2009 By: _____

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CERTIFICATE OF SERVICE

I hereby certify that on the 5th day of February, 2009, I caused a true and correct copy of **REPLY TRIAL BRIEF OF OPPOSER** to be served on Applicant, by mailing same, U.S. first class mail, postage pre-paid, to the following:

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