

**THIS OPINION IS NOT A  
PRECEDENT OF  
THE TTAB**

Mailed: April 3, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

---

Trademark Trial and Appeal Board

---

Big O Tires, LLC  
v.  
Wheel Specialties, LTD.

---

Opposition No. 91163791 to application Serial No. 78644475  
filed on June 18, 2003

---

Marsha G. Gentner and Matthew J. Cuccias of Jacobson Holman  
PLLC for Big O Tires, LLC.

Warren A. Sklar and Donald L. Otto of Renner, Otto,  
Boisselle & Sklar, LLP for Wheel Specialties, LTD.

---

Before Cataldo, Taylor and Bergsman, Administrative  
Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Wheel Specialties, LTD. has filed an application to  
register on the Principal Register the mark BIGG WHEELS, in  
typed format, for "Wheels for automobiles."<sup>1</sup> The word  
"WHEELS" is disclaimed.

---







<sup>1</sup> Serial No. 78264260, filed on June 18, 2003 with an allegation  
of a bona fide intention to use the mark in connection with the  
recited goods in commerce. During prosecution, applicant filed  
an amendment to allege use and now alleges February 20, 2004 as  
the date of first use of the mark anywhere and in commerce.

Registration has been opposed by Big O Tires, LLC on the grounds of priority and likelihood of confusion and dilution. Opposer specifically alleges that since prior to the date of first use alleged in applicant's involved application, opposer has, and is now, engaged in the advertising, marketing, distribution and sale of 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 trademarks BIG O and BIG O TIRES [BIG O Marks], BIG FOOT and BIG FOOT COUNTRY [BIG FOOT Marks], as well as the marks BIG HAUL and BIG LIFT [BIG Marks]; that opposer has continuously used its 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 opposer's businesses from those of others; and that it is the owner of and will rely on the following registrations:<sup>2</sup>

---


<sup>2</sup> Opposer also pleaded ownership of application Serial No. 76605325 for the mark BIG FOOT COUNTRY (in stylized format) for "tires" and indicated that it intended to rely on the registration when it issued. On February 22, 2005, the application matured into Registration No. 2927656, which we have considered in this decision.

Opposer also pleaded ownership of Registration No. 2821058. It is clear from the record that there was a typographical error in the registration number. Accordingly, the registration has not been considered. In addition, opposer made of record a status and title copy of Registration No. 2834058 for a miscellaneous

Reg. No.	Mark	Goods/Services	Issue Date
2821055		Retail store services featuring automotive parts and accessories; and Automotive maintenance and repair services	3/9/2004
2821054		Retail store services featuring automotive parts and accessories; and Automotive maintenance and repair services	3/9/2004
2821053		Retail store services featuring automotive parts and accessories; and Automotive maintenance and repair services	3/9/2004
2821052		Retail store services featuring automotive parts and accessories; and Automotive maintenance and repair services	3/9/2004
2821051		Retail store services featuring automotive parts and accessories; and Automotive maintenance and repair services	3/9/2004
2514975		Retail stores 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	12/4/2001, Section 8 & 15 affidavits, accepted and acknowledged

design. Because the mark was not pleaded, it too, has not been considered.

Finally, although opposer pleaded ownership of the mark BIG HAUL in the notice of opposition, it neither submitted a registration for that mark nor adduced any testimony as to such ownership. Accordingly, we consider opposer to have withdrawn its claim of ownership of the BIG HAUL mark. Opposer also pleaded ownership of Registration No. 2520443 for the mark BIG LIFT; because that registration has been cancelled under Section 8 of the Trademark Act, we give no further consideration to the BIG LIFT mark.

		services; and Vehicle maintenance and repair services	
2411926 <sup>3</sup>	BIG O TIRES (typed)	Tires for land vehicles; Retail stores 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	12/12/2000, Section 8 & 15 affidavits, accepted and acknowledged
1904955	BIG FOOT (typed)	Vehicle tires	7/11/1995, Section 8 & 15 affidavits, accepted and acknowledged
1611160 <sup>4</sup>		Tires; Retail tire store services	8/28/1990, renewed
1102059 <sup>5</sup>	BIG FOOT 70 (typed)	Vehicle tires	9/12/1978 Section 8 & 9 affidavits received
1102058 <sup>6</sup>	BIG FOOT 60 (typed)	Vehicle tires	9/12/1978, renewed
994466	BIG O (typed)	Retail tire and accessory store services and rendering technical assistance in connection with the establishment and/or operation of retail tire and accessory stores	10/1/ 1974, renewed
993415	BIG-O (typed)	Vehicle tires	9/24/1974, renewed

Opposer further asserts that applicant's mark, when used on applicant's goods, so resembles opposer's BIG O, BIG FOOT and BIG Marks as to be likely to cause confusion, mistake, and/or to deceive the public in general into believing that applicant's goods are sold by, emanate from, and/or in some

<sup>3</sup> "Tires" is disclaimed.

<sup>4</sup> "Tires" is disclaimed. The registration includes the following statement: "The stippling in the drawing is for shading purposes only."

<sup>5</sup> "70" is disclaimed.

<sup>6</sup> "60" is disclaimed.

way associated with opposer to the damage and detriment of opposer.

Opposer also alleges that since prior to the date of first use alleged in the opposed application, Opposer's BIG O and BIG FOOT marks have been, and are, distinctive and famous and that registration of the BIGG WHEELS mark by applicant will dilute the distinctive quality of opposer's famous and distinctive BIG O and BIG FOOT marks.

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

**EVIDENTIARY MATTERS**

Opposer has filed numerous objections against certain testimony and exhibits introduced by applicant primarily regarding third-party references. Opposer contends that they are not probative in the absence of evidence as to the extent of the third-parties' use and promotion of their marks. Applicant did not respond to the objections. Opposer particularly objects to applicant's two notices of reliance; the first on copies of third-party registrations<sup>7</sup> of "BIG" formative marks which opposer asserts are irrelevant, and the second, on what applicant characterizes as "Internet publications,"<sup>8</sup> as not being admissible by notice of reliance. Opposer requests that the notices be

---

<sup>7</sup> (Exh. 11-21).

<sup>8</sup> (Exh. 22-52).

stricken. We overrule opposer's objection as to the first notice of reliance because the objection is essentially directed to the probative value of the third-party registrations. However, we sustain as to the second. While printed publications are admissible by notice of reliance, see Trademark Rule 2.122(e), materials retrieved from the Internet are not, as they require authentication. See *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370 (TTAB 1998). A review of the documents described as "Internet Publications" reveal that they are not publications, but are rather in the nature of online business directories, yellow pages and state records.<sup>9</sup> Accordingly Exhibits 22-52 have been stricken.

Opposer also objects to portions of the testimony deposition of Mark Lamb and Exhibits 3 and 6-10 thereto. Exhibit 3 is a summary of applicant's sales of BIGG WHEELS wheels to opposer; Exhibit 6 is a web page of Big Brand Tire Co.; Exhibit 7 consists of printouts from an Internet search of automotive companies that include the word "big"; Exhibit 8 is applicant's customer contact list; Exhibit 9 is Custom Wheel's Unlimited's Virginia customer phone list and Exhibit 10 is a list of locations for Big Brand Tire Company. Opposer objects to exhibits 3, 6 and 8 as not having been

---

<sup>9</sup> We add that these online records are not admissible by notice of reliance as official records as they are not certified.

timely disclosed in discovery. Similarly, opposer objects to Exhibits 9-10 as not having being disclosed despite opposer's Interrogatory Request No. 15 and Document Request no. 60, which specifically sought information and documents related to alleged third-party use. We overrule the objection to Exhibit 3. Although the summary was not produced until two weeks before trial, opposer had, or should have had, a record of its purchases of BIGG WHEELS wheels in its possession. We sustain the objections as to Exhibits 6-10; Exhibits 7 and 9 not being produced, and Exhibits 6, 8 and 10 as not being seasonably produced - the document requests having been served in 2005 and applicant's silence with regard to the objections, telling. Accordingly, Exhibits 6-10 and pertinent testimony regarding these exhibits have not been considered.<sup>10</sup>

As to the remaining objections to the testimony based on lack of foundation, hearsay, vagueness and leading questions, we find it unnecessary to address each objection specifically. The objections relate principally to the probative value to be accorded the testimony in question,

---

<sup>10</sup> We further note with regard to Exhibit 7 that opposer's objection based on lack of foundation has merit. When asked "[w]ho was the search conducted by? Mr. Lamb responded "[o]ne of my employees and me." As noted above, Internet evidence is not self-authenticating and Mr. Lamb did not indicate what documents were retrieved from his searches or that he supervised his employee's search. Further, there is no indication on the documents which were retrieved as a result of Mr. Lamb's search.

and we have accorded the relevant testimony the appropriate probative value.

We also note with regard to opposer's notice of reliance, filed June 9, 2008, on certain printed publications (Exhibits 59-64), the exhibits were introduced on CD-Rom. By amendment effective August 31, 2007, the Board deleted Trademark Rule 2.126(b) which gave parties the option of making submissions to the Board in CD-Rom form. Trademark Rule 2.126(a)(6) makes clear that "[e]xhibits pertaining to a paper submission must be filed on paper and comply with the requirements for a paper submission." Because applicant's exhibits 59-64 were not filed on paper as required under the operative Trademark Rule, they have not be considered in this decision.

#### **THE RECORD**

In light of the foregoing, the record consists of the pleadings and the file of application Serial No. 78264260. Also of record are copies of agreements between opposer and third-parties submitted by stipulation of the parties herein. In addition, opposer, during its testimony period submitted:

- 1) the testimony deposition, with Exhibits 1-34D, of Richell Bennett, opposer's consumer advertising coordinator;
- 2) the testimony deposition, with exhibits 34A-35F, of Michael Kinnen, vice president of operations;



- 3) A notice of reliance on certain discovery produced by applicant; and
- 4) a notice of reliance on status and title copies of its pleaded registrations.

Applicant, during its testimony period, submitted:

- 1) the testimony deposition, with Exhibits 1-10, of Mark Lamb, applicant's CEO; and
- 2) a notice of reliance on eleven third-party registrations.

## **FINDINGS OF FACT**

### **Opposer**

Opposer was founded in the early 1960's as a tire-buying cooperative. (Bennett tr. p. 11). Today, opposer is a wholesale distributor of the BIG O TIRES brand line of tires, as well as other major brands of tires, wheels and automotive parts. Opposer is also North America's largest independent tire franchiser, with more than 540 stores located in twenty-one states throughout the Mid-West and West of the Mississippi. (Bennett tr. p. 9, 11-12, exhs. 1A-1G, 10). 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. p. 11). Opposer has been selling tires under the BIG O TIRES MARK for over four decades. In addition to selling tires, opposer sells custom wheels, brakes, shock absorbers, struts and assorted parts.

(Bennett tr. p. 9, exhs., 3, 5A-B, 6A-I). Opposer sells and installs custom wheels at its Big O Tire stores. (Bennett tr. p. 9, exhs. 3, 10, and 40). Custom wheels are promoted in opposer's product catalogs and on its website. (Bennett tr. p. 27, exh. 10).

Since its earliest days, opposer has used its BIG O TIRES trade name, trademark and service mark alone, and as a house mark in connection with the operation of its large network of retail tire stores and the sale at wholesale and retail of vehicle parts and accessories, and related motor vehicle care services. (Bennett tr. p. 11). Opposer and its franchisees use the BIG O TIRES Mark on signage as well as on posters and banners displayed in the retail stores, as well as outside the stores. (Bennett tr. pp. 13-15). All Big O Tire retail locations have the BIG O TIRES mark on the exterior of the store. (Bennett tr. pp. 13-15).

Opposer advertises in different media, including but not limited to print, newspaper and direct mail, with every piece of advertising containing the BIG O TIRES mark. (Bennett tr. pp. 22-23). Opposer also advertises on television and radio. (Bennett tr. pp. 23-25). Since 2000, opposer has maintained a website, which is used to advertise tires, wheels, and vehicle maintenance and repair services. (Bennett tr. p. 28, exh. 11).

Although opposer's advertising expenditures are confidential, they are substantial, and have increased steadily for more than twelve years.<sup>11</sup> (Bennett tr. p. 29-34, exh. 12). Similarly, opposer's total sales figures from 2001 to March 2007 are impressive. (Kinnen tr. pp. 5-8, exh. 12).

Opposer received "Customer Satisfaction" awards in 1995, 1996 and 1998 by J.D. Power and Associates<sup>12</sup> for "Best Replacement Tire ~ Passenger Vehicles." (Bennett tr. p. 38-39, exhs. 15A-C). Opposer also received recognition from others in the business community. For example, in the January 1999 issue, marking the 20<sup>th</sup> annual "Franchise 500" edition, *Entrepreneur* magazine ranked opposer as No. 1 in the overall tire franchisers category. (Bennett tr. p. 41, exh. 16D).

Opposer has also publicized its BIG O TIRE mark through sports sponsorships. Opposer has been a sponsor of the Colorado Rockies Major League Baseball team since 2003, with the mark being prominently displayed in signage at Coors Field in Denver, Colorado, which averages about two (2) million visitors a year. (Bennett tr. p.43 and 52-54, exhs. 22 A-C). Opposer is also affiliated with the National Hot

---

<sup>11</sup> The figures presented represented total annual advertising and marketing expenditures.

<sup>12</sup> According to opposer, J.D. Power and Associates is an international company that analyzes customer behavior and ranks different product categories.

Rod Association (NHRA) racing circuit, and sponsors three cars. Each car is painted with the company colors and prominently displays the BIG O TIRES logo. Opposer is also an advertising sponsor at the Bandimere Speedway outside of Denver, Colorado, where it displays the BIG O TIRES Mark throughout the facility. Opposer's Northern California franchise group is a sponsor at the Infineon Raceway, where opposer prominently displays its mark on signage, and its Lexington, Kentucky franchise group has aired opposer's radio advertisements and promotions during live broadcasts of the games of the Indianapolis Colts on the Colt's radio network. (Bennett tr. pp. 43, exhs. 17A-B, 18A-B, 19A-B, 20A-C and 21A-B).

Last, opposer promotes its mark in connection with various charities and other public service organizations, e.g., Alex's Lemonade Stand,<sup>13</sup> Susan G. Komen Breast Cancer Foundation (Colorado Race for the Cure), and the Red Cross. Applicant displays its BIG O TIRE mark in association with these fund-raising activities. (Bennett tr. pp. 56-70, exhs. 24A-30).

***Applicant***

Applicant is in the business of wholesaling custom wheels and accessories and tires for cars. (Lamb tr. p. 5).

---

<sup>13</sup> Alex's Lemonade Stand is a charitable organization supporting pediatric cancer research.

Applicant's customers are retail automobile stores that sell tires and brakes and also service cars. (Lamb tr. p. 6). 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. pp. 33 and 36). Opposer is a customer of applicant's to whom applicant has sold its BIGG WHEEL product line since 2004. (Lamb tr. p. 15-17). Applicant's CEO adopted the BIGG WHEELS mark to emphasize the big styling for its particular style of wheels. (Lamb tr. pp. 5 and 9). Applicant asserts that applicant has been aware of opposer since a cold call on one of opposer's Kentucky stores resulted in a sale of eight wheels in August of 2002. (Lamb tr. pp. 15-17, and opposer's not. of. rel., exh. 39).

## **DISCUSSION**

### ***Opposer's Standing and Priority of Use***

Because opposer has properly made its pleaded registrations of record, we find that opposer has established its standing to oppose registration of applicant's mark. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Moreover, because opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in this case as to the marks therein and goods and

services covered thereby. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). We further note that applicant does not contest that opposer has made prior use of the marks in its pleaded registrations.

***Likelihood of Confusion***

We note that opposer has pleaded ownership of fifteen registrations in the notice of opposition. In analyzing likelihood of confusion, we limit our discussion to Registration No. 2411926 for the mark BIG O TIRES for "tires for land vehicles; retail stores 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," as the mark and goods and services are the closest to applicant's mark and recited goods.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In*

re Majestic Distilling Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

***Fame***

We begin our likelihood of confusion analysis with the fifth du Pont factor, which requires us to consider evidence of the fame of opposer's mark and to give great weight to such evidence if it exists. See Bose Corp. v. QSC Audio Products Inc., 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); Recot Inc. v. Becton, 214 F.3d 1322, 54 F.2d 1894 (Fed. Cir. 2000); and Kenner Parker Toys, Inc. v. Rose Art Industries, Inc., 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

Fame of an opposer's mark or marks, if it exists, plays a "dominant role in the process of balancing the DuPont factors," Recot, 214 F.3d at 1327, 54 USPQ2d at 1456, and "[f]amous marks thus enjoy a wide latitude of legal protection." *Id.* This is true as famous marks are more likely to be remembered and associated in the public mind than a weaker mark, and are thus more attractive as targets for would-be copyists. *Id.* Indeed, "[a] strong mark ... casts a long shadow which competitors must avoid." Kenner Parker Toys, 963 F.2d at 353, 22 USPQ2d at 1456. A famous mark is one "with extensive public recognition and renown." *Id.*

Bose Corp. v. QSC Audio Products Inc., *supra*, 63 USPQ2d at 1305.

Upon careful review of the record in this case, we find that opposer's BIG O TIRES mark has achieved regional fame for purposes of our likelihood of confusion analysis.

Opposer has used its mark for more than 45 years. We note, however, that its stores are located only in the Midwest and west of the Mississippi River. In addition, the record shows that opposer's promotion and marketing of its mark, especially in connection with sporting events, takes place in those regions. Opposer has introduced testimony evidence regarding substantial expenditures in advertising, promotion and marketing of its products and services, resulting in tremendous sales. Again, while such sales suggest that opposer has enjoyed a significant degree of success, it is unclear on this record how many people outside of the Midwest and areas west of the Mississippi River are familiar with the mark BIG O TIRES. In other words, we simply cannot determine from the evidence whether such sales reach people throughout the United States.

Nonetheless, while this evidence falls short of demonstrating that awareness of opposer's goods and services among those segments of the population translates into nationwide fame, we have no doubt that opposer has attained a degree of renown in the Midwest and west of the Mississippi River, which we characterize as niche market fame. See *ProQuest Information and Learning Co. v. Island*, 83 USPQ2d 1351 (TTAB 2007) *citing to Berghoff Restaurant Co. v. Washington Forge, Inc.* 225 USPQ 603 (TTAB 1985) (opposer's proof of fame of its mark within a limited



geographic area sufficient to find its mark famous for purposes of likelihood of confusion analysis where applicant's goods were marketed in that geographic area).

Based on the record, we find THE BIG O TIRES mark inherently distinctive and strong and entitled to a broad scope of protection. In coming to this determination, we have considered all of the evidence relevant thereto, including applicant's evidence, more fully discussed *infra*, of third-party registrations of various "BIG" formative marks. "BIG" formative marks.

***The goods and services***

We now compare the goods and services. Applicant's goods are identified as "wheels for automobiles." Opposer has submitted status and title copies of a number of pleaded registrations, including Registration No. 2411926, covering tires for land vehicles; retail stores 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.

We find that applicant's wheels are closely related to opposer's tires and retail stores services featuring, among other vehicle parts and accessories, tires. Applicant does not argue otherwise. In fact, applicant's brief is silent

with regard to this issue. Opposer's testimony and evidence establish that wheels and tires are complementary goods, used at the same time and for related purposes. To state the obvious, tires are mounted on wheels and placed on vehicles to facilitate locomotion. In addition, applicant's wheels are very closely related to opposer's retail store services featuring tires and wheels, as well as to opposer's vehicle maintenance and repair services, all being part of the automotive aftermarket.

Further, because applicant's identification of goods contains no limitations or restrictions as to types of purchasers or channels of trade, we must presume that applicant sells its wheels in all channels of trade that would be normal for such goods, including retail stores featuring automotive aftermarket parts and accessories, and to all normal purchasers, including ordinary consumers. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Indeed, applicant has admitted that tires and wheels are sold in the automotive aftermarket through similar channels of trade. (Opposer's not. of rel. exh. 40, 90-91).

### ***Third Party Registrations***

Applicant has made of record eleven third-party registrations, which include the word BIG in combination with other matter for automotive related goods and services, apparently to show that the term "BIG" is weak and entitled

to a narrow scope of protection. While third-party registrations may be used to demonstrate that a portion of a mark is suggestive or descriptive, they are not evidence that the marks shown therein are in use or that the public is aware of them. See *AMF Incorporated v. American Leisure Products, Inc.*, 177 USPQ 268, 269 (CCPA 1973) ("little weight is to be given such registrations in evaluating whether there is likelihood of confusion."). Thus, they are not proof that consumers are familiar with such marks so as to be accustomed to the existence of similar marks in the marketplace and, as a result, are able to distinguish between the BIG marks based on slight differences between them.

Moreover, of the eleven, four are expired (Registration Nos. 772529, 900272, 1388039 and 2580562), thus implying that they are no longer in use. Six others (Registration Nos. 2146279, 2402092 and 3454188 - owned by the same entity - for the mark BIG MAX, Registration No. 2875923 for the mark BIG JAKE, Registration No. 3221264 for the mark BIG DAWG, and Registration No. 2596506 for the mark BIG WHEEL ROSSI) are more dissimilar to opposer's BIG O TIRE mark than is applicant's mark. The single remaining registration, i.e., Registration No. 2195058 for the mark BIG BRAND, is not sufficient to support a finding that opposer's pleaded

BIG O TIRES mark is weak, or otherwise justify the registration of another confusingly similar mark.

***Applicant's Intent***

Next, opposer points out that applicant has admitted that its selection and use of the BIGG WHEELS mark for wheels, and the filing of its involved application, was made with actual knowledge of opposer, its BIG O TIRES mark and businesses. To the extent that opposer is arguing that applicant adopted its mark in bad faith, there is insufficient evidence to show or from which we can infer this. Mere knowledge of the existence of opposer's mark does not, in and of itself, constitute bad faith. See *Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ 1307 (Fed. Cir 1989). *Ava Enterprises, Inc. V. Audio Boss USA, Inc.*, 77 USPQ2d 1783 (TTAB 2006). Opposer must show that applicant intentionally sought to trade on opposer's good will.

***The marks***

We now consider applicant's BIGG WHEELS mark and opposer's BIG O TIRES mark. In determining whether or not these marks are similar, we must consider them in their entireties in terms of sound, appearance, meaning and commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin*, *supra*. The test is not whether the marks can be distinguished when subjected to a side-by-side

comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods or services offered under the respective marks is likely to result.

We note first that BIG O is the dominant element is opposer's mark; "TIRES" being merely generic for opposer's goods and has been disclaimed. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 Fed. Cir. 1985) (Although marks must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature). Although "WHEELS" is likewise a generic and disclaimed term in relation to applicant's goods, we cannot not say that BIGG dominates applicant's mark. We find so because in the context of applicant's mark, the term "BIGG" has a suggestive quality not present in opposer's mark. Further, the term "BIGG" appears to modify the term "WHEELS" in applicant's mark. In any event, disclaimed matter must be considered with the rest of the mark as a whole in assessing the similarity between the marks. See *Giant Food, Inc. v. Nation's Foodservice*, 710 F.2d 1565, 218 USPQ2d 390, 395 (Fed. Cir. 1983) ("it is well settled that the disclaimed material still forms a part of the mark and cannot be ignored in determining likelihood of confusion." (citations omitted)).

When comparing applicant's mark BIGG WHEELS to opposer's mark, BIG O TIRES, we find they differ in both appearance and sound due to the different elements in each mark. While both marks share the term "BIG" or "BIGG,"<sup>14</sup> its combination with the single letter "O" and the five-letter word "TIRE" on the one hand and the five-letter word "wheel," on the other, that gives each mark a unique visual impression and cadence when spoken. Further, the marks differ in connotation. The word "big" is defined, inter alia, as "large or great in dimensions, bulk, or extent <a big house>; also large or great in quantity, number, or amount <a big fleet> ... [and] outstandingly worthy or able." Merriam Webster Online Dictionary, 2009.<sup>15</sup> There is nothing in the record to suggest any particular meaning of opposer's mark in the context of tires. The only meaning we can attribute to opposer's mark is a large letter "O." On the other hand, the term "BIG(G)" in applicant's marks evokes an image of dimensionally large and outstandingly worthy wheels, a must have for any auto enthusiast. It is this play of the word "big(g)" on the term "wheels" that creates a meaning and connotation in applicant's mark that is

---

<sup>14</sup> Interestingly, applicant never explained, nor did opposer ask, why applicant chose the spelling "BIGG" as opposed to "BIG."

<sup>15</sup> Retrieved March 30, 2009, from <http://www.merriam-webster.com/dictionary/big>. The Board may take judicial notice of standard reference works, including online reference works which exist in printed format. In re Spirits International N.V., 86 USPQ2d 1078, 1081, n.5 (TTAB 2008).

distinct from that of opposer's BIG O TIRES mark. Consequently, the mere fact that applicant's mark incorporated the term "BIGG" does not mean that applicant's mark is sufficiently similar in meaning, or projects a similar commercial impression to opposer's mark. Instead, when viewed in their entirety, applicant's BIGG WHEELS mark is different from opposer's BIG O TIRES mark and the dissimilarities in the marks outweigh all other relevant *du Pont* factors. *Kellogg v. Pack'Em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

For the reasons discussed, there is no likelihood of confusion between applicant's mark and any of the other pleaded marks. Opposer's pleaded BIG O marks create essentially the same commercial impression as its BIG O TIRES mark and, based upon the above analysis, are no more similar to applicant's mark in appearance, sound, meaning or commercial impression than BIG O TIRES. With respect to the Big Foot marks, i.e., BIG FOOT, BIG FOOT 60, BIG FOOT 70 and BIG FOOT COUNTRY, there are differences in connotation between those marks and applicant's mark that obviate any similarities. First, opposer's marks suggest in their overall commercial impression a big foot or print as could be made by Sasquatch<sup>16</sup> ("Bigfoot") or an area proliferated

---

<sup>16</sup> Merriam-Webster Online Dictionary, 2009, defines "Bigfoot" as "[from the size of the footprints ascribed to it]: Sasquatch," and further defines Sasquatch as a hairy creature like a human

by Bigfoot. Moreover, the "60" and "70" are merely descriptive grade designations. With respect to the remaining word marks or combination word and design marks (WWW.BIGOTIRES.COM (stylized) and BIG O TIRES and tire tread design), while they contain additional elements, those elements are descriptive (i.e. www.--.com) or tend to further distinguish (the tread design) applicant's mark. Finally the sasquatch design marks create an entirely different commercial impression that serves to distinguish them from applicant's BIGG WHEELS word-only mark.

Based on the foregoing, we conclude that despite the fame of opposer's marks, and the substantially related goods and services, opposer's marks and applicant's mark are so dissimilar that their contemporaneous use is not likely to cause confusion. While opposer is correct that any doubt must be resolved in its favor, based on this record, we have no doubt that the parties' respective marks are not confusingly similar.

#### **DILUTION**

In addition to its Section 2(d) claim, opposer has asserted a dilution claim. The Lanham Act provides for a cause of action for the dilution of famous marks. For

---

being reported to exists in the northwestern United States and Canada and said to be a primate between 6 and 15 feet (1.8 and 4.6 meters tall - called also *bigfoot*."



purposes of dilution, a party must prove more than confusing similarity, it must show that the marks are "identical or very substantially similar." *Carefirst of Maryland v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1514 (TTAB 2005). We have already found that applicant's BIGG WHEELS mark is not similar to opposer's BIG O TIRE Marks for purposes of likelihood of confusion. It thus stands that opposer has not proven that the marks are identical or substantially related for purposes of dilution. Having so found, we need not address the other factors involved in a dilution analysis, including whether opposer's niche fame suffices for establishing dilution. *See id.*

**Decision:** The opposition is dismissed as to both the likelihood of confusion and dilution grounds.