

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451**

Lykos

Mailed: March 8, 2006

Opposition No. 91163232

Big O Tires, Inc.

v.

Bigfoot 4x4, Inc.

Opposition No. 91166074

Bigfoot 4x4, Inc.

v.

Big O Tires, Inc.

(as consolidated)¹

Before Walters, Rogers, and Kuhlke, Administrative Trademark Judges.

By the Board:

On December 19, 2001, Bigfoot 4x4, Inc. ("Bigfoot 4x4") applied to register the mark BIGFOOT for "videotapes featuring monster trucks; interactive video game programs featuring monster trucks; multimedia software recorded on CD ROM in the field of monster truck races and demonstrations; and digital video discs featuring monster trucks" in

¹ As further explained in this order, the above referenced proceedings have been consolidated. Any future filings with the Board should be captioned in the above manner, with Opposition No. 91163232 as the parent case.

International Class 9.² Big O Tires, Inc. ("Big O Tires") filed a notice of opposition on December 1, 2004 on the grounds that Bigfoot 4x4's applied-for mark (1) so resembles Big O Tires' previously used and registered marks that it is likely to cause confusion, mistake, or deceive prospective consumers under Section 2(d) of the Lanham Act; and (2) will dilute the distinctive quality of Big O Tires' marks under Section 43(c) of the Lanham Act as amended. The Board instituted the case the next day, and assigned it Opposition No. 91163232. Bigfoot 4x4 answered the notice of opposition by denying the salient allegations, and asserting various affirmative defenses, including that Big O Tires is barred by "estoppel" and by "accord and satisfaction" from asserting its claims.

On February 17, 2004, after Big O Tires had already filed the opposition referenced above, Big O Tires also applied to register the mark BIG FOOT, but for different goods -- "batteries" in International Class 9.³ On July 25, 2005, Bigfoot 4x4 filed a notice of opposition against the Big O Tires application, on the same grounds asserted by Big O Tires in the earlier opposition -- that is, Bigfoot 4x4 asserted that Big O Tires' applied-for mark (1) so resembles

² Application Serial No. 76350720, alleging 1987 as the date of first use anywhere and in commerce.

³ Application Serial No. 76576412, alleging a bona fide intention to use the mark in commerce.

Bigfoot 4x4's previously used and registered marks that it is likely to cause confusion, mistake, or deceive prospective consumers under Section 2(d) of the Lanham Act; and (2) will dilute the distinctive quality of Bigfoot 4x4's marks under Section 43(c) of the Lanham Act as amended. The Board instituted this second proceeding on July 30, 2005, as Opposition No. 91166074.

In lieu of answering Opposition No. 91166074, on September 8, 2005, Big O Tires submitted a filing captioned as a "motion to dismiss or in the alternative motion for summary judgment" as well as a separate motion to amend its application. Bigfoot 4x4 filed responsive briefs to both motions, and Big O Tires submitted a reply brief in support of its "motion to dismiss or in the alternative motion for summary judgment" which the Board has exercised its discretion to consider. See Trademark Rule 2.127(a). Insofar as Big O Tires' "motion to dismiss" relies on matters outside the pleadings, the Board is treating the motion as one for summary judgment under Fed. R. Civ. P. 56.⁴ Thereafter, on November 2, 2005, Bigfoot 4x4 filed a

⁴ Bigfoot 4x4, in its responsive brief, treated Big O Tires' motion as both a motion to dismiss, and alternatively, as a motion for summary judgment, thereby obviating the need for additional briefing. See *Institut National Des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875 (TTAB 1998).

motion for summary judgment in Opposition No. 91163232 which is fully briefed as well.⁵

I. Consolidation

As a preliminary matter, inasmuch as the notices of oppositions involve the same parties, same marks, and similar issues, the Board hereby orders upon its own initiative the consolidation of the above referenced cases. See Fed. R. Civ. P. 42(a) and TBMP § 511 and authorities cited therein. The parties are reminded, however, of their duty to inform the Board of related proceedings. This reminder is included in the Board's institution order for all cases, and is meant to ensure consistent treatment of related proceedings.

II. Civil Action Involving Bigfoot 4x4 and Big O Tires

Before reviewing the parties' arguments in the pending motions, we note that the papers submitted by the parties in each case reveal that Bigfoot 4x4 and Big O Tires were involved in civil litigation. On February 27, 2001, Big O Tires filed suit in the U.S. District Court for the District of Colorado against Bigfoot 4x4 asserting various claims, including trademark infringement and dilution.⁶ The

⁵ Bigfoot 4x4's motions to extend the close of testimony and respond to outstanding discovery requests due to the death of an employee, filed October 3, 2005 and October 23, 2005, are granted for good cause. See Fed. R. Civ. P. 6(b). Accordingly, Bigfoot 4x4's motion for summary judgment is timely. See Trademark Rule 2.127(e)(1).

litigation was resolved on January 21, 2004 by a consent judgment with the court entering a final order and permanent injunction against Bigfoot 4x4 to enforce a settlement agreement of the parties. The order held that:

Plaintiff Big O [Big O Tires herein] is the owner of the trademark BIG FOOT, as well as the design of a "Bigfoot" or Sasquatch character, as exemplified by Exhibit A, hereto, and the design of a "big foot", as exemplified by Exhibit B, hereto, in connection with the following items for vehicles: Tires, wheels, Tires accessories, wheel accessories, cargo restraints, shock absorbers, struts, suspension parts and vehicle replacement parts [hereafter, collectively referred to as the "Big O BIG FOOT Marks(s)"], and the U.S. registrations therefor, nos. 1,102,058; 1,102,059; 1,904,955; and 2,314,775 [hereafter, the "Big O BIG FOOT Registrations"].
"Final Order and Permanent Injunction on Consent," Paragraph 3.

According to the terms of the injunction, Bigfoot 4x4 is permanently enjoined from:

applying, or authorizing or licensing another to apply, the trademark BIG FOOT (alone or in conjunction with any other word, design or symbol, and whether as one word or two) to, and/or from using BIG FOOT (alone or in conjunction with any other word, design or symbol, and whether as one word or two) as a trade name, trademark or service mark for, and/or in connection with, any of the following items for vehicles: (a) Tires; (b) wheels; (c) shock absorbers, struts and/or suspension parts; (d) Tires accessories; (e) wheel accessories; (f) cargo restraints; and (g) **vehicle replacement parts.**

"Final Order and Permanent Injunction on Consent," Paragraph 4 (emphasis added).

⁶ Civil Action No. 01-B-349.

The order further provides that any use of the BIG FOOT mark in violation of the injunction constitutes infringement of the rights of Big O Tires in its BIG FOOT marks. *Id.* at Paragraph 4.

The court found binding and enforceable the parties' settlement agreement which carves out mutually exclusive rights to use the mark BIG FOOT or variations thereof for various categories of goods. In particular, Paragraph 1 of the agreement states that Bigfoot 4x4 "shall have the exclusive rights to use the mark 'Bigfoot' for "monster trucks," "depictions of monster trucks" and "audio/visual except as permitted in paragraph 3." Paragraph 3(c) of the agreement provides the following qualification:

In connection with audio/video, Big O has the exclusive right to use the Big Foot mark with regard to the exclusive products listed in paragraph 2. Big O agrees not to use or depict a monster truck (as defined in paragraph 1a) nor use the Bigfoot mark on the vehicle, in such a medium.

The agreement also provides that Big O Tires shall have "exclusive rights" to the mark for tires and various other auto related goods, including "vehicle replacement parts." Settlement Agreement, Paragraph 2.

Post-settlement, Bigfoot 4x4 sought to limit the definition of the term "vehicle replacement parts" to parts that "contribute to or permit the performance of the basic function of the vehicle, namely locomotion (e.g. spark

plugs, fuel injectors, exhaust systems); and [meet] original equipment manufacturer's specifications." Big O Tires, disagreeing with Bigfoot 4x4's interpretation, sought guidance from the district court by filing a motion to enforce the settlement agreement. The district court concluded that Bigfoot 4x4's interpretation of the term "vehicle replacement parts" was under-inclusive, finding instead that it is an "undefined term which stands on its own" and "is clear and unambiguous and does not require further definition to be understood." Recommendation of the U.S. Magistrate Judge, November 10, 2003, Paragraph 14.

The settlement agreement also states in relevant part that:

2. Big O will not challenge the existence and operation of the existing BIG FOOT retail store (such single store can continue to sell all of those types of items previously sold in the store), or up to ten (10) additional locations (not limited to St. Louis) so long as it is not within a Big O franchisee's exclusive territory. In the event that the alternate site(s) precedes development of a franchise territory by Big O than [sic] the Big foot 4x4 retail location will not be required to relocate by Big O at such time as a franchised location is developed. Big O agrees that it will not develop a Big O franchise within 2 miles of one of these ten (10) locations provided notice of the location is made to Big O on a timely basis.

Bigfoot 4x4 may open as many novelty and accessory stores as it determines. Such stores will not market the items listed in paragraph 2 unless pursuant to a Big O franchise agreement.

III. The Doctrines Of Claim Preclusion (*Res Judicata*) And Issue Preclusion (Collateral Estoppel)

The summary judgment motions pending in each case require the Board to consider whether the doctrines of claim preclusion (*res judicata*) or issue preclusion (collateral estoppel) have preclusive effect on the respective oppositions filed by Bigfoot 4x4 and Big O Tires.

As a threshold matter, we note that because no issues were actually litigated in the parties' prior civil action, the doctrine of issue preclusion does not apply to either opposition proceeding.⁷ See *Chromalloy American Corporation v. Kenneth Gordon (New Orleans), Ltd.*, 736 F.2d 694, 222 USPQ 187 (Fed. Cir. 1984); *Flowers Industries Inc. v. Interstate Brands Corp.*, 5 USPQ2d 1582 (TTAB 1987).

Furthermore, we find that the doctrine of claim preclusion (or *res judicata*) does not apply to either case. Under the doctrine of claim preclusion, the entry of a final

⁷ The requirements that must be met for issue preclusion are:

- (1) the issue to be determined must be identical to the issue involved in the prior action;
- (2) the issue must have been raised, litigated and actually adjudged in the prior action;
- (3) the determination of the issue must have been necessary and essential to the resulting judgment; and
- (4) the party precluded must have been fully represented in the prior action.

Larami Corp. v. Talk To Me Programs Inc., 36 USPQ2d 1840, 1843-1844 (TTAB 1995), citing *Lukens Inc. v. Vesper Corporation*, 1 USPQ2d 1299 (TTAB 1986), *aff'd*, Appeal No. 87-1187 (Fed. Cir. Sept. 18, 1987) (unpublished).

judgment "on the merits" of a claim (i.e., cause of action) in a proceeding serves to preclude the relitigation of the same claim in a subsequent proceeding between the parties or their privies, even in those cases where the prior judgment was the result of a default or consent. See *Lawlor v. National Screen Service Corp.*, 349 U.S. 322, 75 S.Ct. 865, 99 L.Ed. 1122 (1955); *Chromalloy American, supra*; and *Flowers Industries, supra*. A second suit is barred by res judicata or claim preclusion if

(1) the parties (or their privies) are identical;

(2) there has been an earlier final judgment on the merits of a claim; and

(3) the second claim is based on the same set of transactional facts as the first.

Jet, Inc. v. Sewage Aeration Systems, 223 F.3d 1360, 55 USPQ2d 1854, 1856 (Fed. Cir. 2000).

While no genuine issue of material fact exists regarding the first two factors (that the present proceedings involve the same parties as were involved in the prior district court action, and that there has been an earlier final judgment on the merits of the claims as evidenced by the parties' settlement agreement and the court's final order and permanent injunction on consent), a genuine issue of material fact exists regarding whether the claims of likelihood of confusion and dilution asserted in

both oppositions are based on the same set of transactional facts as those in the civil action. In particular, we note that because we do not have the pleadings from the civil action before us, we are unable to reach a determination regarding this factor. As such, it would be inappropriate for the Board to invoke the doctrine of *res judicata* in either case.

IV. Contractual Estoppel

Although issue preclusion does not apply to these oppositions, and the pleadings from the civil action have not been provided to assess whether claim preclusion applies, that does not end our inquiry. Instead, we now must consider whether entry of summary judgment is appropriate on the ground of contractual estoppel. See *Chromalloy American, supra*, 222 USPQ at 190.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). A genuine dispute with respect to a material fact exists if sufficient evidence is presented that a reasonable fact finder could

decide the question in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts as to whether any factual issues are genuinely in dispute must be resolved against the moving party and all inferences must be viewed in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

A. Bigfoot 4x4's Motion for Summary Judgment in Opposition No. 91163232

First, we will consider Bigfoot 4x4's motion for summary judgment in Opposition No. 91163232. In its motion for summary judgment, Bigfoot 4x4 asserts that according to the terms of the parties' settlement agreement, Big O Tires expressly agreed not to use the BIGFOOT mark to depict monster trucks in an audio/visual medium; that the goods contained in Bigfoot 4x4's application are narrower in scope than the goods for which Big O Tires is contractually barred from use; that Bigfoot 4x4's application therefore falls within the parameters of the parties' settlement agreement; and that as such, Big O Tires is contractually estopped from

bringing the instant case.⁸

In opposition thereto, Big O Tires contends that Bigfoot 4x4's application seeks rights beyond those enumerated in the settlement agreement insofar as the inclusion of the terms "featuring" and "in the field of" in the identification of goods do not limit the application to the identified goods; that the goods listed as "software" and "games programs" fall outside the rubric of audio/visual medium; and that the settlement agreement does not confer to Bigfoot 4x4 an absolute right to use the BIGFOOT mark in connection with the specified goods. In support of its position, Big O Tires has submitted, among other papers, an online dictionary definition of the word "feature."

In reply, Bigfoot 4x4 maintains that Big O Tires' argument that the terms "featuring" and "in the field of" are not limiting language is contrary to Trademark Office Practice; and that Big O Tires mischaracterizes the settlement agreement as a consent-to-use agreement whereby Big O has consented to a particular use by Bigfoot 4x4, rather than an affirmative agreement that Big O Tires will

⁸ Bigfoot 4x4's arguments regarding Big O Tires' lack of standing to bring this case, aside from being unavailing, are more appropriate for a motion to dismiss pursuant to Fed. R. Civ. P. 12(b)(6). Big O Tires, by pleading ownership of numerous previously used marks, has asserted a "real interest" in this case, and therefore standing to bring this opposition. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999).

not use the BIGFOOT mark in an audio/visual medium.

After careful consideration of the parties' arguments and supporting papers, the Board holds that Big O Tires is contractually estopped from bringing the instant opposition proceeding. See *M-5 Steel Mfg. Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086 (TTAB 2001) and cases cited therein. The issue of whether Big O Tires is contractually barred from opposing Bigfoot 4x4 applied-for mark clearly falls within the jurisdiction of the Board. See *Kimberly-Clark Corp. v. Fort Howard Paper Co.*, 772 F.2d 860, 227 USPQ 36 (Fed. Cir. 1985). The Board can give effect to a settlement agreement to the extent that the agreement is relevant to issues properly before the Board. See *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641 (Fed. Cir. 1983). As explained below, this case presents issues squarely within the parameters of the settlement agreement.

The construction of an agreement is a question of law, and the meaning and interpretation of a contract may be resolved by the Board on summary judgment. See *Interstate Gen. Gov't Contractors, Inc. v. Stone*, 980 F.2d 1433 (Fed. Cir. 1992). As an initial matter, we note that the parties' settlement agreement lacks a choice of law clause. We therefore must apply general principles of contract interpretation. In interpreting contracts, "unless a different intention is manifested, ... where language has a

generally prevailing meaning, it is interpreted in accordance with that meaning." See Restatement (Second) of Contracts, Section 202(3)(a) (1981). Thus, the interpretation of an agreement must be based, not on the subjective intention of the parties, but on the objective words of their agreement. See *Novamedix Ltd. v. NDM Acquisition Corp.*, 166 F.3d 1177, 49 USPQ2d 1613 (Fed. Cir. 1999).

As a threshold matter, we find that the terms "featuring" and "in the field of" constitute limiting language in the identification of goods. According to U.S. Patent and Trademark Office practice in regard to trademark application identifications of goods, the inclusion of these terms render the identification sufficiently definite and limited to the particular subject matter identified therein. See e.g., TMEP § 1402.03(d) (4th ed. April 2005). The goods identified in Bigfoot 4x4' application therefore fall under the domain of the settlement agreement.

Next, we must examine the scope of Bigfoot 4x4' rights in its applied-for mark. The settlement agreement clearly indicates that Big O Tires agreed not to "use or depict a monster truck . . . nor use the Bigfoot mark on the vehicles" in audio/visual medium. The settlement agreement also clearly indicates that Bigfoot 4x4 "shall have the exclusive rights to use the mark 'Bigfoot' for" monster

trucks, depictions of monster trucks and audio/visual. It logically follows that Bigfoot 4x4 is the sole entity possessing the right to federally register its mark for the goods listed in the application. This is distinct from a consent-to-use arrangement because it contains an explicit prohibition regarding the use of the BIGFOOT mark. Indeed, the circumstances presented here are similar to those found in *Vaughn Russell Candy Co. v. Cookies in Bloom, Inc.*, 47 USPQ2d 1635 (TTAB 1998). In that case, the Board held that pursuant to a settlement agreement reached among the parties in which applicant agreed to discontinue all use of the phrase "Incredible Edible Cookie Arrangements," applicant was contractually estopped from seeking registration of the identical mark. In reaching that determination, the Board reasoned that because applicant was expressly prohibited under the terms of the agreement from lawfully using in commerce the mark for which registration was sought, it could not "assert the exclusive right to use in commerce the mark for which registration" was sought. Consistent with this principle, according to the terms of the settlement agreement involved in this case, Big O Tires has agreed not to use the mark BIGFOOT on the precise goods listed in Bigfoot 4x4's application. Clearly, each of the goods -- videotapes, interactive video game programs, multimedia software recorded on CD ROM, and digital video discs -- fall

within the category of "audio visual medium" and each directly pertains to the subject matter specified in the agreement -- monster trucks. Indeed, to otherwise permit Big O Tires to move forward with this opposition would undermine the intent of the parties' settlement agreement and create an environment of uncertainty regarding each party's respective rights pursuant to the agreement.

We therefore find as a matter of law that Big O Tires is contractually estopped from opposing Bigfoot 4x4's application to register the mark BIGFOOT for "videotapes featuring monster trucks; interactive video game programs featuring monster trucks; multimedia software recorded on CD Rom in the field of monster truck races and demonstrations; and digital video discs featuring monster trucks."

Accordingly, the Board grants Bigfoot 4x4's motion for summary judgment. Judgment is entered against Big O Tires, and Opposition No. 91163232 is dismissed with prejudice.

B. Big O Tires' Motion to Amend its Application and Motion for Summary Judgment in Opposition No. 91166074

We turn now to the motions pending in the second opposition. First, we will consider Big O Tires' motion to amend its application. Big O Tires seeks to amend the identification of goods from "batteries" to "vehicle batteries." Bigfoot 4x4 does not oppose Big O Tires' motion

to amend the identification of goods. Inasmuch as Big O Tires' proposed amendment is limiting in nature in accordance with Trademark Rule 2.71(b), and because Bigfoot 4x4 does not object to the amendment, it is approved and entered. See also Trademark Rule 2.133(a).

Next, we consider Big O Tires' motion for summary judgment. Big O Tires argues that under the principles of *res judicata* and *collateral estoppel*, and because the term "vehicle replacement parts" includes "vehicle batteries," the present opposition proceeding should be dismissed with prejudice based on the federal court's order and determination that Big O Tires has the exclusive rights in the BIGFOOT trademark for all "vehicle replacement parts."

In response thereto, Bigfoot 4x4 maintains that in this case, because "vehicle batteries" may be sold as something other than "vehicle replacement parts" (e.g., as new items that would, theoretically, then be sold to auto makers), the amended identification of goods does not fall within the scope of the court's order and parties' settlement agreement. Bigfoot 4x4 further contends that to the extent that "vehicle batteries" only partially falls within the scope of "vehicle replacement parts," Big O Tires does not have the exclusive right to use a BIGFOOT mark in conjunction with the sale of "vehicle batteries" pursuant to the terms of the parties' settlement agreement. Bigfoot

4x4, in making this assertion, relies on the provision that it may continue to sell all parts that it previously sold at its existing locations, arguing that because Bigfoot 4x4 previously sold vehicle replacement parts from its retail locations, Big O Tires' rights are not exclusive.

In reply, Big O Tires points to the determination of the magistrate judge that the term "vehicle replacement parts" is "clear and unambiguous without further requirement for further definition to be understood." Big O Tires also argues that Bigfoot 4x4 has essentially misconstrued the terms of the settlement agreement by confusing the sale of BIGFOOT branded products with the sale of products at a BIGFOOT store. Finally, Big O Tires points out that Bigfoot 4x4 has failed to introduce any evidence that it ever did sell vehicle replacement batteries in its store at that time, and the notice of opposition does not plead such use or rights.

For the reasons set forth *supra*, Big O Tires' arguments with respect to the doctrines of *res judicata* and *collateral estoppel* are unavailing in this case.

The Board does hold, however, that, as with the earlier filed opposition, Bigfoot 4x4 is contractually estopped from bringing the instant opposition proceeding. See *M-5 Steel Mfg. Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086 (TTAB 2001) and cases cited therein. Here, we are basing our decision not

on the *res judicata* effect of the permanent injunction issued by the court as a final judgment, but rather on the effect of the parties' settlement agreement as to the registrability of Big O Tires' applied-for mark, as we did in Opposition No. 911632332. Compare *Chromalloy American Corp. v. Kenneth Gordon, Ltd.*, *supra*, and *Kimberly Clark Corporation v. Fort Howard Paper Company*, 772 F.2d 860, 227 USPQ 36 (Fed. Cir. 1985). Although neither party expressly raised the theory of contractual estoppel in their briefs in this case, both parties were involved in the earlier filed opposition where Bigfoot 4x4 did expressly move for summary judgment on the ground of contractual estoppel. Moreover, in this case, not only did the parties acknowledge the existence of the settlement agreement and rely on its terms in setting forth their respective arguments, but also discussed at length their respective interpretations thereof. As such, the Board is well within its discretion to base its ruling on the principle of estoppel by contract since both parties effectively were on notice. See *Celotex Corp. v. Catrett*, *supra*. ("[C]ourts are widely acknowledged to possess the power to enter summary judgment *sua sponte* so long as the losing party was on notice that she had to come forward with all of her evidence").

The crux of the parties' dispute in this opposition lies in their disagreement regarding the interpretation of

the term "vehicle replacement parts," the precise issue considered and ruled upon by the magistrate judge of the district court. As such, we must look to the determination of the district court for guidance. As noted *supra*, the term "vehicle replacement parts" is to be construed consistent with the ordinary meaning of the words. In accordance with this principle, we find that Big O Tires' newly amended identification of goods, "vehicle batteries," falls within the scope of "vehicle replacement parts," and is therefore governed by the terms of the parties' settlement agreement.⁹

Even if we were to accept Bigfoot 4x4's contention that a distinction exists regarding replacement versus new vehicle parts, any "new" parts would effectively be limited to a channel of trade involving selling batteries to auto makers (for what new car does not come with a battery, and any new battery sold in the auto parts market is still a replacement battery). By logical extension, auto makers, as more sophisticated consumers of auto products, would be much less likely to confuse the two sources of BIGFOOT products. For this reason, Bigfoot 4x4's argument ultimately fails to advance its position.

Next, we must examine the scope of Big O Tires' rights

⁹ An amendment by Big O Tires to "vehicle replacement parts, namely, batteries" would have also been acceptable.

in its applied-for mark. The settlement agreement clearly indicates that Bigfoot 4x4 agreed that Big O Tires has the *exclusive* right to use the mark BIG FOOT and variations thereof in connection with "vehicle replacement parts."¹⁰ It logically follows that Big O Tires is the sole entity possessing the right to federally register its mark for the newly amended goods listed in the application. At this juncture, a comparison of the settlement agreement at issue here with the contract involved in *Chromalloy American Corp. v. Kenneth Gordon, Ltd.*, 736 F.2d 694, 222 USPQ 187 (Fed. Cir. 1984) is instructive. In *Chromalloy*, the Federal Circuit reversed the Board's ruling that opposer was expressly barred from challenging applicant's right to register the mark LADY GORDON based on a consent judgment entered into between the parties in a civil action. In reaching its decision, the court noted that it disagreed with the Board's interpretation of the parties' consent agreement that opposer consented to applicant's use and registration of all combinations of the mark GORDON with any four letter word (except for those containing a geographic name or certain enumerated displays). The court further remarked that "while the decree is not a model of clarity," it could not unequivocally conclude that opposer gave its

¹⁰ This language is bolstered by the injunction which expressly prohibits Bigfoot 4x4 from using the Bigfoot mark in connection with these goods.

consent to applicant to use the applied-for mark. By contrast, the settlement agreement here is clear and unambiguous since it specifically enumerates the goods upon which Big O Tires has the exclusive right to use the BIGFOOT mark. From this basis, we can draw the conclusion that in this particular case, Bigfoot 4x4 effectively granted its consent to Big O Tires to use the BIGFOOT mark on the goods identified in the application as amended.

We further note Bigfoot 4x4's contention that, because Bigfoot 4x4 claims to have previously sold vehicle replacement parts from its retail location, Big O Tires' rights are not exclusive. This argument is not persuasive. In our view, Bigfoot 4x4 has misconstrued those terms of the settlement agreement. That particular provision applies to the use of the BIG FOOT marks in connection with retail store services, not trademark usage on goods sold in those stores.

Having sued for infringement and dilution in federal court, and obviously being aware of any potential for confusion or dilution, Big O Tires, in apparent reliance on the parties' settlement agreement and court order enforcing the agreement, filed its pending application. To allow Bigfoot 4x4 to proceed with the present opposition would not only contravene the explicit terms of the agreement, but also reopen for litigation an issue already resolved by the

parties. Clearly, the parties' settlement agreement, coupled with the court's injunction enforcing the agreement, act as a bar to this opposition as well.

We therefore find as a matter of law that Bigfoot 4x4 is contractually estopped from opposing Big O Tires' application to register the mark BIG FOOT for "vehicle batteries." Accordingly, in view of the evidence submitted by the parties, the Board grants Big O Tires summary judgment, finding *sua sponte* that Bigfoot 4x4 is contractually estopped from opposing Big O Tires' application to register the mark BIG FOOT for "vehicle batteries."

Accordingly, judgment is entered against Bigfoot 4x4, and Opposition No. 91166074 is dismissed with prejudice.