

Wolfson

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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

Mailed: November 18, 2008

Opposition No. 91178685

Opposition No. 91178688

BIG O TIRES, INC.

v.

67 AND LATHAM, LLC

**Before Bucher, Zervas and Wellington,
Administrative Trademark Judges.**

By the Board:

Opposer, Big O Tires, Inc. has filed an opposition against registration of the marks A BIG RIG RESORT and DANNY'S A BIG RIG RESORT, filed by 67 and Latham, LLC, both for "retail store services featuring convenience store items and gasoline."¹ Opposer asserts that the marks so resemble opposer's "BIG O" and "BIGFOOT" marks, which opposer alleges to have previously used or registered for goods and services related to vehicle tires, parts and accessories, as to be likely, when applied to applicant's services, to cause confusion among prospective purchasers.² Applicant filed an

¹ Serial Nos. 78815618 and 78811121.

² Opposer pleaded ownership of 18 registrations. Eleven of the registrations are for marks that include the words BIG O or BIGFOOT. These marks are BIG O, BIG-O, BIG FOOT 60, BIG FOOT 70, BIG O TIRES and Design, BIG FOOT, COST U LESS BIG O TIRES and

answer denying the salient allegations in the notice of opposition.

This case now comes before the Board for consideration of applicant's "Motion To Dismiss Or In The Alternative, For Summary Judgment" (filed November 30, 2007 and renewed January 4, 2008). The motion has been fully briefed.³

The parties briefed this case as a motion for summary judgment and they have submitted matters outside the pleadings that have not been excluded by the Board. Accordingly, the motion has been treated as a motion for summary judgment under Fed. R. Civ. P. 56. See TBMP § 503.04 (2d ed. rev. 2004).

A motion for summary judgment is a pretrial device, intended to save the time and expense of a full trial when a party is able to demonstrate, prior to trial, that there is no genuine issue of material fact, and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(c);

Design, BIG O TIRES, WWW.BIGOTIRES.COM and Design, BIG O TIRES LUBE CENTER, and BIGFOOT. Opposer also pleaded ownership of registrations for six marks consisting of a design only. Opposer also pleaded ownership of a registration 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.

³ On June 17, 2008, applicant filed a contested motion, later withdrawn, to exclude opposer's response to applicant's summary judgment motion as untimely. As it has been withdrawn, we have not considered the motion. Applicant also filed a contested motion to extend its time to file a reply brief. Inasmuch as applicant timely filed its reply brief within fifteen days after the service date of opposer's response, the motion is denied.

TBMP § 528.01 (2d ed. rev. 2004). To prevail on its motion, applicant must establish that there is no genuine issue of material fact in dispute, thus leaving the case to be resolved as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); and *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). Applicant may discharge its burden "by 'showing' - that is, pointing out to the [Board] - that there is an absence of evidence to support the nonmoving party's case." *Celotex Corp.*, 477 U.S. at 325.

Applicant's motion for summary judgment is brought on opposer's pleaded likelihood of confusion claim under Section 2(d) of the Trademark Act. Our 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 issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."

Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

As set forth in *E.I. du Pont, supra*, "[t]he evidentiary elements are not listed ... in order of merit" inasmuch as "[e]ach may from case to case play a dominant role." *E.I. du Pont*, 177 USPQ at 562. Our primary reviewing court has made it clear that in appropriate cases, one *du Pont* factor can outweigh all of the other factors. See *Kellogg Co. v. Pack'em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991). That one factor can outweigh all others is "especially [true] when that single factor is the dissimilarity of the marks." *Champagne Louis Roederer v. Delicato Vineyard*, 148 F.3d 1173, 47 USPQ2d 1459, 1460 (Fed. Cir. 1998).

Applicant contends that the first *du Pont* factor, the similarity or dissimilarity of the marks, outweighs all other factors in this case because its marks, when compared with opposer's, are so dissimilar in appearance, meaning, sound, and overall commercial impression that opposer could not prove at trial that a likelihood of confusion exists.

For purposes of its motion, applicant has conceded that the other *du Pont* factors weigh in opposer's favor, with the exception of the factor regarding actual confusion.⁴ The

⁴ Opposer was permitted limited discovery on the *du Pont* factors relating to actual confusion on grant of opposer's motion for discovery under Fed. R. Civ. P. 56(f). In briefing this motion,

two most important of these "conceded factors" are the factors regarding the similarity of the goods and services and the fame of opposer's marks.

As to applicant's concession of the fame of opposer's marks for purposes of this motion, we consider such fame to cover not only the goods recited in opposer's registrations but also to extend to the services identified in applicant's applications. We keep in mind too that the fame of a prior mark "plays a dominant role in cases featuring a famous or strong mark." *Century 21 Real Estate Corp. v. Century Life of America*, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), quoting *Kenner Parker Toys v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

This brings us to the *du Pont* factor regarding the similarity or dissimilarity of the marks. We consider opposer's BIG O and BIGFOOT (or BIG FOOT) marks of Registration Nos. 0994466, 0993415, 1904955 and 3233881, as they are the most similar to applicant's marks.⁵ We examine the marks in their entirety as to appearance, sound, connotation and commercial impression. See *Palm Bay Imports*

opposer presented no evidence showing actual confusion. We have therefore treated this factor as neutral in our likelihood of confusion analysis.

⁵ With respect to opposer's other word marks, while they contain additional elements, the additional elements do not add significantly to the marks in their overall impressions. The additional elements are either descriptive (as in "tires," "tires lube center," "tires cost u less," and "www.--.com") or model or grade designations (as in "60" and "70").

Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772,
396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005).

In appearance, the marks BIG O and BIGFOOT (or BIG FOOT) clearly differ from the marks A BIG RIG RESORT and DANNY'S A BIG RIG RESORT. The only common element is the descriptive term "big," prominently located as the first word in opposer's marks but relegated to the middle of applicant's marks. The marks also differ in their aural qualities. Applicant's marks contain alliteration ("rig" and "resort"), and rhyming elements ("big" and "rig"). Opposer's BIG O mark, on the other hand, contains a "pure sound" element, the letter "O." Neither of opposer's marks rhyme or contain alliteration.

The main difference between the marks, however, lies in their connotations. 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>." *Merriam-Webster Online Dictionary, 2008*.⁶ There is nothing in the record to suggest any particular meaning of either of opposer's marks in the context of tires. The only meanings we can attribute to opposer's BIG

⁶ Retrieved November 5, 2008, 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).

O mark is a large letter "O" or a big tire (the letter suggesting the tire's shape). The marks BIGFOOT and BIG FOOT connote a large foot, good traction of the tire on the road, or "bigfoot," otherwise known as Sasquatch.⁷ On the other hand, the phrase "big rig" has a distinct meaning as a term separate and apart from the two individual words "big" and "rig" that make up the phrase.

Applicant submitted a copy of a print-out from the website "dictionary.com" which, citing to *Webster's New Millennium Dictionary of English*, Preview Edition (v. 0.9.7 2008), defines the phrase "big rig" as "a tractor-trailer truck."⁸ Thus, applicant's marks A BIG RIG RESORT and DANNY'S A BIG RIG RESORT connote a place of relaxation for drivers of "big rigs"; in other words, a truck stop where drivers of tractor-trailer trucks may take a break or purchase convenience items and gasoline. The marks also play on the meaning of the word "resort" as an upscale vacation spot, "a place frequented by people for relaxation

⁷ Merriam-Webster Online Dictionary, 2008, defines "Bigfoot" as "[from the size of the footprints ascribed to it]: Sasquatch," and further defines Sasquatch as "a hairy creature like a human being reported to exist in the northwestern United States and western Canada and said to be a primate between 6 and 15 feet (1.8 and 4.6 meters) tall -called also *bigfoot*."

⁸ Opposer's objection to this dictionary entry on the ground of authentication is overruled; applicant authenticated the dictionary entry with its attorney's declaration, filed with applicant's reply brief.

or recreation: a *ski resort*.”⁹ The juxtaposition of such connotation to an establishment that sells fuel and convenience items to drivers of tractor-trailer trucks creates an irony that is not found in opposer’s marks.

Considering the overall commercial impressions of the marks, again we find that opposer’s marks identify an object, suggesting in their overall commercial impression a big foot or print as could be made by a large tire, or Sasquatch (“Bigfoot”), or a big tire itself (the “O” being the shape of a tire). Applicant’s marks create an entirely different overall commercial impression. They suggest leisure, a place for long-haul truck drivers to stop and rest, a “resort for big rigs.”

In view of the above, we conclude that the marks are dissimilar in sound, connotation, appearance and commercial impression. Further, we find that actual confusion was not conceded or established by the evidence.¹⁰

Despite applicant’s concession regarding the remaining *du Pont* factors, including that the goods and services are related and of the fame of opposer’s marks, we find the dissimilarities of the marks so great as to outweigh the

⁹ *The American Heritage Dictionary of the English Language*: Fourth Edition 2000.

¹⁰ Moreover, the relevant test under Section 2(d) is likelihood of confusion, not actual confusion. *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990), and TMEP § 1207.01(c)(iii).

other *du Pont* factors. See *Kellogg Co. v. Pack'em, supra* [no likelihood of confusion between mark "FROOTIE ICE" and elephant design for packages of flavored liquid frozen into bars and mark "FROOT LOOPS" for, *inter alia*, cereal breakfast foods and fruit-flavored frozen confections because -- while such goods are very closely related, move through the same channels of trade to the same classes of purchasers, are purchased casually rather than with care, and despite the fact that the mark "FROOT LOOPS" is a very strong, well known and, indeed, famous, mark -- the respective marks differ so substantially in appearance, sound, connotation and commercial impression that likelihood of confusion did not exist as a matter of law]. Applicant has shown an absence of evidence supporting opposer's claim that confusion as to the source of applicant's services in view of opposer's pleaded marks is likely.

Accordingly, no genuine issues of material fact remain for trial, and applicant is entitled to judgment as a matter of law. Applicant's motion for summary judgment is granted and the opposition is dismissed.

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