

ESTTA Tracking number: **ESTTA224614**

Filing date: **07/16/2008**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	BIG O TIRES, LLC
Granted to Date of previous extension	07/16/2008
Address	12650 EAST BRIARWOOD AVENUE CENTENNIAL, CO 80112 UNITED STATES

Attorney information	Marsha G. Gentner Jacobson Holman PLLC 400 - 7th Street, N.W. Washington, DC 20004 UNITED STATES trademark@jhip.com, mgentner@jhip.com Phone:202-638-6666
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Applicant Information

Application No	77109547	Publication date	03/18/2008
Opposition Filing Date	07/16/2008	Opposition Period Ends	07/16/2008
Applicant	Weems Industries, Inc. 6281 North Gateway Drive Marion, IA 52302 UNITED STATES		

Goods/Services Affected by Opposition

<p>Class 007. First Use: 2000/12/01 First Use In Commerce: 2000/12/01 All goods and services in the class are opposed, namely: Air-operated power tools, namely, impact wrenches, ratchets, sanders, air hammers, chisels, drills, nailers, grinders, cut-off discs; abrasive disks for air-operated power sanders; grinding disks for air-operated power grinders, blow guns; compressed air pumps, machine parts, namely, metal air nozzles, air hose adapters, air hose chucks, needles and connectors which are parts of air-operated power tools; needles for pumps for inflating tires; tire inflation nozzles; air operated grease systems, namely, grease pumps, grease guns, grease reservoirs, hoses, hose reels, couplers, plugs, dollies, fittings for connection of hoses, clamps, grease fitting repair tools, grease storage containers, grease dispensers, grease, rechargeable batteries, grease injectors, grease injector needles, grease gun nipples, air bleeder valves, grease gun holders, warming bags for grease guns and grease all for use with dispensing grease; air operated oil systems, namely, oil pumps, oil control guns, oil gun extensions, oil nozzles, oil swivels, hoses, suction tubes for oil pumps, oil dispensing tappers for oil pumps, couplers, plugs, meters for measuring volume, dollies, oil storage containers, and waste oil recovery containers all for use with pumping oil</p>
<p>Class 009. First Use: 1991/01/01 First Use In Commerce: 1991/01/01 All goods and services in the class are opposed, namely: Tire pressure gauges, tire tread depth gauges, and electrical circuit testers</p>

<p>Class 021. First Use: 1989/01/01 First Use In Commerce: 1989/01/01 All goods and services in the class are opposed, namely: Plastic compressed air hose nozzles, hose nozzles, pouring spouts and funnels; plastic pour spouts with valve for mounting on motor oil bottle; plastic spray nozzles</p>

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1393967	Application Date	10/31/1985
Registration Date	05/20/1986	Foreign Priority Date	NONE
Word Mark	LEGACY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 012. First use: First Use: 1985/09/01 First Use In Commerce: 1985/09/01 VEHICLE TIRES		

U.S. Registration No.	3003292	Application Date	11/12/2003
Registration Date	10/04/2005	Foreign Priority Date	NONE
Word Mark	LEGACY TOUR PLUS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 012. First use: First Use: 1997/04/00 First Use In Commerce: 1997/04/00 TIRES		

Attachments	73566064#TMSN.jpeg (1 page)(bytes) 76559495#TMSN.gif (1 page)(bytes) i5878.nop.pdf (5 pages)(399798 bytes) i5878.att.pdf (6 pages)(403178 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Marsha G. Gentner/
Name	Marsha G. Gentner
Date	07/16/2008

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

BIG O TIRES, LLC)
)
 Opposer,)
)
 v.) Opposition No.
)
 WEEMS INDUSTRIES, INC. dba)
 LEGACY MANUFACTURING COMPANY)
)
 Applicant.)

NOTICE OF OPPOSITION

In the matter of application to register a trademark under the Trademark Act of 1946, Serial No. 77/109,547, for the mark LEGACY, filed February 16, 2007, in the name of Weems Industries, Inc., dba Legacy Manufacturing Company, published for opposition in the TRADEMARK OFFICIAL GAZETTE of March 18, 2008, Vol. 1328, No. 3, at page TM 73, the Opposer, Big O Tires, LLC, believes it will be damaged by registration of said alleged trademark in International Classes 7, 9, and 21, and hereby opposes same. The grounds for opposition are as follows:

1. The Opposer, Big O Tires, LLC [hereinafter "Big O"], is a limited liability company duly organized and existing under the laws of the State of Nevada and having its place of business at 12650 East Briarwood Avenue, Centennial, Colorado 80112. Opposer distributes and sells a variety of vehicle products, and operates a franchised system of retail stores.

2. Commencing prior to the earliest date of first use alleged in the application opposed herein, Opposer Big O has, and is now, engaged in the production, advertisement, marketing, distribution and sale of its vehicle products in commerce under and in connection with the mark

LEGACY. Opposer continuously has used said **LEGACY** mark alone and in combination with other words and symbols in commerce in connection with its vehicle products advertised, offered, marketed, distributed, and sold by Big O, and to identify and designate same, and to distinguish those goods, and Opposer Big O's business, from those of others.

3. Opposer Big O is the owner of and will rely on herein, the following U.S. trademark registrations:

REGISTRATION NO.	ISSUE DATE
1,393,967	May 20, 1986
3,003,292	October 4, 2005

Said registrations are valid and subsisting, and operate as conclusive and/or *prima facie* evidence of Opposer's ownership of the marks set forth therein and exclusive right to use the registered marks in commerce. Attached hereto is a current printout of information from the electronic database records of the U.S. Patent and Trademark Office showing the current status and title of the aforementioned registrations.

4. On February 16, 2007, Applicant filed an application to register the mark **LEGACY**. Said application was accorded serial no. 77/109,547, and was published for opposition in the **OFFICIAL GAZETTE** of March 18, 2008, at page TM 73, identifying the goods in International Classes 7, 9, and 21 as follows:

Air-operated power tools, namely, impact wrenches, ratchets, sanders, air hammers, chisels, drills, nailers, grinders, cut-off discs; abrasive disks for air-operated power sanders; grinding disks for air-operated power grinders, blow guns; compressed air pumps, machine parts, namely, metal air nozzles, air hose adapters, air hose chucks, needles and connectors which are parts of air-

operated power tools; needles for pumps for inflating tires; tire inflation nozzles; air operated grease systems, namely, grease pumps, grease guns, grease reservoirs, hoses, hose reels, couplers, plugs, dollies, fittings for connection of hoses, clamps, grease fitting repair tools, grease storage containers, grease dispensers, grease, rechargeable batteries, grease injectors, grease injector needles, grease gun nipples, air bleeder valves, grease gun holders, warming bags for grease guns and grease all for use with dispensing grease; air operated oil systems, namely, oil pumps, oil control guns, oil gun extensions, oil nozzles, oil swivels, hoses, suction tubes for oil pumps, oil dispensing tappers for oil pumps, couplers, plugs, meters for measuring volume, dollies, oil storage containers, and waste oil recovery containers all for use with pumping oil, in Class 7;

Tire pressure gauges, tire tread depth gauges, and electrical circuit testers, in Class 9; and

Plastic compressed air hose nozzles, hose nozzles, pouring spouts and funnels; plastic pour spouts with valve for mounting on motor oil bottle; plastic spray nozzles, in Class 21.

5. The mark sought to be registered by Applicant is identical to, a colorable imitation of, and confusingly similar to, Opposer's prior and aforesaid **LEGACY** mark.

6. On information and belief, the Class 7, 9, and 21 goods identified in the application opposed herein are the same, similar and/or related, to the goods in connection with which Big O uses Opposer's **LEGACY** mark, and are and/or will be sold and/or offered through the same and/or similar channels of trade, and/or to the same general class of purchasers, in and to which Big O's products and services are marketed and/or sold.

7. The registration and/or use of the mark set forth in the opposed application in connection with the Class 7, 9, and 21 goods as identified therein, is likely to cause confusion, mistake, and/or to deceive as to origin, sponsorship, and/or association of Applicant's goods sold under the mark sought to be registered by Applicant vis-a-vis Opposer and/or Opposer's **LEGACY**

mark, and/or to mislead purchasers of Applicant's goods and/or Opposer's goods, and/or the public in general, into believing that Applicant's goods are sold by, emanate from, and/or in some way, directly or indirectly, are associated with Big O, and/or Opposer's **LEGACY** mark and/or Opposer's goods, or business, or vice versa, to the damage and detriment of Big O.

8. If Applicant is granted registration on the application opposed herein, and Applicant obtains such rights as conferred under the Principal Register of the Trademark Act of 1946, Applicant will obtain unlawful gain and advantage to which it is not entitled under the Trademark Act of 1946, to the detriment and harm of Opposer.

WHEREFORE, this Opposer, Big O Tires, LLC, believes and alleges that it will be damaged by registration of Serial No. 77/109,547 in International Classes 7, 9, and 21 , as aforesaid, and prays that:

- A. judgment in the present opposition be entered in favor of Opposer;
- B. the present opposition be sustained; and
- C. registration of application serial no. 77/109,547, for the Class 7, 9, and 21 goods set forth therein, be rejected and refused.

Respectfully submitted,

BIG O TIRES, LLC

By:



Marsha G. Gentner
JACOBSON HOLMAN PLLC
400 Seventh Street, N.W.
Washington, D.C. 20004
(202) 638-6666
Email: mgentner@jhip.com

Date: July 16, 2008

CERTIFICATE OF SERVICE

I hereby certify that on this 16th day of July, 2008, the foregoing Notice of Opposition was served, by mailing same first class and postage prepaid, on the following correspondent as set forth in the records of the U.S. Patent and Trademark Office:

Brian J. Laurenzo
Dorsey & Whitney LLP
801 Grand Avenue
Suite 3900
Des Moines, Iowa 50309-2790

Teresa L. Brooks

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2008-02-08 10:16:43 ET

Serial Number: 73566064 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 1393967

Mark (words only): LEGACY

Standard Character claim: No

Current Status: This registration has been renewed.

Date of Status: 2006-09-22

Filing Date: 1985-10-31

Transformed into a National Application: No

Registration Date: 1986-05-20

Register: Principal

Law Office Assigned: (NOT AVAILABLE)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: SH0 -Office Of Public Record - Special Handling

Date In Location: 2007-09-05

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. BIG O TIRES, INC.

Address:

BIG O TIRES, INC.
12650 EAST BRIARWOOD AVE, STE 2D
CENTENNIAL, CO 80112
United States

Legal Entity Type: Corporation

State or Country of Incorporation: Nevada

GOODS AND/OR SERVICES

International Class: 012

Class Status: Active

VEHICLE TIRES

Basis: 1(a)**First Use Date:** 1985-09-01**First Use in Commerce Date:** 1985-09-01

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2006-09-22 - First renewal 10 year

2006-09-22 - Section 8 (10-year) accepted/ Section 9 granted

2006-09-07 - Section 7 amendment issued

2006-05-16 - Combined Section 8 (10-year)/Section 9 filed

2006-06-26 - Assigned To Paralegal

2006-05-16 - Section 7 amendment filed

2006-05-16 - PAPER RECEIVED

1992-08-28 - Section 8 (6-year) accepted & Section 15 acknowledged

1992-05-19 - Section 8 (6-year) and Section 15 Filed

1986-05-20 - Registered - Principal Register

1986-02-25 - Published for opposition

1986-01-26 - Notice of publication

1986-01-03 - Approved for Pub - Principal Register (Initial exam)

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

MARSHA G GENTNER

Correspondent

MARSHA G GENTNER
JACOBSON HOLMAN PLLC
THE JENIFER BUILDING
400 SEVENTH STREET, N.W.
WASHINGTON, D.C. 20004-2201

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2008-02-08 10:17:27 ET

Serial Number: 76559495 Assignment Information Trademark Document Retrieval

Registration Number: 3003292

Mark

LEGACY TOUR PLUS

(words only): LEGACY TOUR PLUS

Standard Character claim: Yes

Current Status: Registered.

Date of Status: 2005-10-04

Filing Date: 2003-11-12

Transformed into a National Application: No

Registration Date: 2005-10-04

Register: Principal

Law Office Assigned: LAW OFFICE 107

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 650 -Publication And Issue Section

Date In Location: 2005-10-04

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Big O Tires, Inc.

Address:

Big O Tires, Inc.
12650 East Briarwood Avenue, Suite 2-D

Englewood, CO 80112
United States
Legal Entity Type: Corporation
State or Country of Incorporation: Nevada

GOODS AND/OR SERVICES

International Class: 012
Class Status: Active
TIRES
Basis: 1(a)
First Use Date: 1997-04-00
First Use in Commerce Date: 1997-04-00

ADDITIONAL INFORMATION

Disclaimer: "TOUR"
Prior Registration Number(s):
1393967

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

- 2005-10-04 - Registered - Principal Register
- 2005-07-12 - Published for opposition
- 2005-06-22 - Notice of publication
- 2005-03-24 - Law Office Publication Review Completed
- 2005-03-18 - Assigned To LIE
- 2005-03-16 - Approved for Pub - Principal Register (Initial exam)
- 2005-01-11 - Amendment From Applicant Entered
- 2004-12-28 - Communication received from applicant
- 2004-12-28 - PAPER RECEIVED

2004-06-28 - Non-final action mailed

2004-06-25 - Assigned To Examiner

2003-12-08 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

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