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THE TTAB

Mailed:
November 30, 2006
PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Big O Tires, Inc.

v.

Big 10 Tire Company, Inc.

Opposition No. 91078343
to application Serial No. 73654393
filed on April 10, 1987

Marsha Gentner and Philip O'Neill of Jacobson Holman PLLC
for Big O Tires, Inc.

Bruce W. Baber of King & Spaulding for Big 10 Tire Company,
Inc.

Before Hairston, Bucher and Zervas, Administrative Trademark
Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by Big 10 Tire Company,
Inc. to register the mark BIG 10 TIRES (TIRES is disclaimed)
for "new, used and recapped vehicle tires, tubes, valve
stems, automotive vehicle parts, namely wheels, shocks and
struts" in International Class 12; "auto lubricating,
maintenance and repair services" in International Class 37;

and "retail store services in the field of auto parts and accessories" in International Class 42.¹

Registration has been opposed by Big O Tires, Inc. under Section 2(d) of the Trademark Act. Opposer alleges that it and its predecessor-in-interest have used the mark BIG O in connection with products and services related to vehicle tires and retail tire and accessory store services; that opposer is the owner of the following registrations: Registration No. 993415 (issued September 24, 1974, renewed) for the mark BIG-O for "vehicle tires;" Registration No. 994466 (issued October 1, 1974; renewed) for the mark BIG O for "retail tire and accessory store services and rendering technical assistance in connection with the establishment and/or operation of retail tire and accessory stores;" Registration No. 1611160 (issued August 28, 1990; renewed) for the mark BIG O TIRES and tire tread design (TIRES is disclaimed) as shown below,



¹ Serial No. 73654393, filed April 10, 1987, alleging a date of first use anywhere of September 27, 1957 and a date of first use in commerce of November 15, 1957.

for "tires" in International Class 12 and "retail tire store services" in International Class 42; and Registration No. 1952457 (issued January 30, 1996; renewed) for the mark COST U LESS BIG O TIRES and design (TIRES is disclaimed) as shown below,



for "vehicle tires" in International Class 12, "tire installation, alignment, balancing, rotation, and repair services; maintenance and repair of automobile parts, namely brakes, shock absorbers, front end suspension parts, bearings, struts and batteries" in International Class 37, and "retail tire and automotive accessory store services; automotive inspection of automobile parts, namely brakes, shock absorbers, front end suspension parts, bearings, struts and batteries" in International Class 42; and that applicant's mark, when applied to applicant's goods and services, so resembles opposer's previously registered marks as to likely to cause confusion.²

² Opposer did not plead ownership of Registration Nos. 1611160 and 1952457 in the notice of opposition inasmuch as these registrations issued after this opposition was filed by more than three and six years respectively. However, opposer, during its testimony period, filed a notice of reliance on these registrations and applicant did not object thereto. Under the circumstances, the notice of opposition is deemed amended to

Applicant, in its answer, has denied the salient allegations of the notice of opposition.³

Evidentiary Matters

We note that opposer has submitted a notice of reliance on several newspaper and magazine articles and two press releases. In its brief on the case, opposer cites to information in the newspaper and magazine articles and press releases concerning its business activities, e.g., the length of time during which opposer has been in business, the number of stores operated by opposer, and opposer's ranking among retail tire franchisors.

Insofar as the press releases are concerned, we have given them no consideration in reaching our decision herein. Press releases are not proper subject matter for a notice of reliance. See *Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1403 (TTAB 1998) and *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73, 74 n.2 (TTAB 1983).

include opposer's claim of ownership of these registrations and a likelihood of confusion with the marks therein. See Fed. R. Civil P. 15(b) and TBMP § 507.03 (2nd ed. rev. 2004).

³ Applicant also counterclaimed to cancel opposer's pleaded Registration No. 994466 on the ground of fraud. After proceedings were extended/suspended for twelve years for settlement discussions, on October 6, 2000, judgment was entered against applicant on the counterclaim and the counterclaim was dismissed with prejudice. This proceeding was then suspended for another four years while the parties discussed settlement. Now, the only remaining claim for decision is opposer's likelihood of confusion claim.

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Further, newspaper and magazine articles are admissible in evidence under Rule 2.122(e), only for what they show on their face, not for the truth of the matters contained therein, unless a competent witness has testified to the truth of such matters. See TBMP §704.08 and cases cited therein. In this case, opposer did not take testimony and, therefore, the articles may not be relied on to establish that the activities mentioned therein have occurred.

The Record

The record, therefore, consists of the pleadings, the file of the involved application, and opposer's notices of reliance on certified copies of its pleaded registrations, and newspaper and magazine articles.

Applicant did not take testimony or submit any other evidence. Only opposer filed a brief.

Priority

Inasmuch as certified copies of opposer's pleaded registrations are of record, there is no issue with respect to opposer's priority. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Likelihood of Confusion

The central issue in this case is likelihood of confusion. Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth

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in *In re E. I. duPont 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 any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

As noted previously, the only evidence properly of record consists of certified copies of opposer's pleaded registrations and newspaper and magazine articles concerning opposer. These articles make reference to opposer's BIG O vehicle tires and retail tire and accessory store services, and its franchising activities. We have no information about applicant and its activities.

We consider first the goods and services of the parties. Opposer's goods and services, as identified in its registrations are "vehicle tires" (Registration No. 993415); "retail tire and accessory store services and rendering technical assistance in connection with the establishment and/or operation of retail tire and accessory stores" (Registration No. 994466); "tires and retail tire store services" (Registration No. 1611160); and "vehicle tires;

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tire installation, alignment, balancing, rotation, and repair services; maintenance and repair of automobile parts, namely brakes, shock absorbers, front end suspension parts, bearings, struts and batteries; retail tire and automotive accessory store services; and automotive inspection of automobile parts, namely brakes, shock absorbers, front end suspension parts, bearings, struts and batteries" (Registration No. 1952457).

Applicant's goods and services, as identified in its application are "new, used and recapped vehicle tires, tubes, valve stems, automotive vehicle parts, namely wheels, shocks and struts"; "auto lubricating, maintenance and repair services," and "retail store services in the field of auto parts and accessories." It is clear that there is a substantial overlap in the goods and services identified in opposer's pleaded registrations and the goods and services identified in applicant's application (e.g., vehicle tires, auto maintenance and repair, and retail tire store services which is encompassed within retail store services in the auto parts field). Such goods and services may be offered in the same channels of trade and may be purchased by the general public.

Turning then to the marks, we note that the most relevant of opposer's marks are the BIG-O, BIG O and BIG O

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TIRES and tire tread design marks.⁴ We must determine whether these marks and applicant's mark, when compared in their entireties, are similar or dissimilar in terms of sound, appearance, connotation and commercial impression. Although the 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 in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Furthermore, 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 terms of their commercial impression that confusion as to the source of the goods and/or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Finally, "when marks would appear on virtually identical goods or services, the degree of

⁴ Indeed, in its brief on the case, opposer's arguments with respect to likelihood of confusion are directed to these three marks and applicant's mark. Thus, we have given no further consideration to opposer's COST U LESS BIG O TIRES and design mark (Registration No. 1952457).

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similarity necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed Cir. 1992).

When we compare opposer's BIG-O, BIG O and BIG O TIRES and tire tread design marks and applicant's BIG 10 TIRES mark in their entireties, we find that they are very similar in sound, appearance, connotation and commercial impression. The word "TIRES" in opposer's BIG O TIRES and tire tread design mark and applicant's BIG 10 TIRES mark is merely a generic or descriptive term for opposer's and applicant's respective goods and services. Further, insofar as the tire tread design in opposer's mark is concerned, when a mark comprises both words and a design, the words are normally accorded greater weight because they would be used by purchasers to request the goods or services. In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987). Here, the tire tread design simply reinforces the word "TIRES" in opposer's mark.

Thus, it is the term BIG(-)O in each of opposer's marks that is dominant, and it is the term BIG 10 in applicant's mark that is dominant. Due to the shared term BIG plus an arbitrary element with no apparent relationship to the goods

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or services of either party, namely the single letter "O" in the case of opposer's marks and the two digit number "10" in the case of applicant's mark, the dominant portions of the marks are very similar. We note that is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered. See *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895 (TTAB 1988). Because the marks are dominated by the terms BIG(-)O and BIG 10, we find that the marks are similar in sound and appearance when considered in their entireties. Although the marks can be distinguished when viewed side by side, under actual marketing conditions consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must rely upon their imperfect recollections. *Dassler KG v. Roller Derby Skate Corporation*, 206 USPQ 255 (TTAB 1980).

With respect to meaning, we recognize that the letter "O" and the number "10" in the respective marks, leads to somewhat different connotations. Nonetheless, we find that the similarities in sound and appearance outweigh the differences in connotation.

In sum, when each of opposer's marks and applicant's mark are considered in their entireties, the marks are sufficiently similar in sound, appearance and commercial

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impression that when used on identical goods and services, confusion would be likely to occur.

Finally, we note that opposer, in its brief on the case, argues that its BIG O mark is famous and entitled to a broad scope of protection. However, there is no proper evidence of the extent of opposer's use of the BIG O mark, its sales, and its advertising/promotional activities. The evidence that opposer's BIG O vehicle tires and its retail tire and accessory stores have been the subject of some articles in the press is simply insufficient evidence to demonstrate that the mark is famous. Opposer's failure, however, to prove the fame of its BIG O mark is not a critical factor in this case.

In view of the similarity in sound, appearance, and commercial impressions of each of opposer's marks and applicant's mark, the identity of the respective goods and services, trade channels and purchasers, confusion as to the source or sponsorship of such goods and services is likely to result.

Decision: The opposition is sustained.