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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

State Fair of Texas

v.

Judson-Atkinson Candies, Inc.

Opposition No. 121,897
to application Serial No. 75/941,731
filed on March 10, 2000

Dennis T. Griggs of Griggs & Johnston, LLP for State Fair of Texas.

Carl W. Covert, Jr. for Judson-Atkinson Candies, Inc.

Before Seeherman, Hairston and Rogers, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

The State Fair of Texas, a Texas corporation, has opposed the application of Judson-Atkinson Candies, Inc. to register BIG TEX as a trademark for "confectionaries,

Opposition No. 121,897

namely, jelly beans."¹ As grounds for opposition, opposer has alleged in its amended notice of opposition that it is the owner of a registration for BIG TEX for "arranging and conducting state fair activities, namely competitive exhibits featuring home, farm, business and industrial products; arranging and conducting entertainment and amusement services, namely sideshows, rides and games; and arranging and conducting educational services in the nature of public exhibits and presentations featuring achievements in the arts and sciences";² that it has used BIG TEX as a common law mark in association with the annual State Fair of Texas since October 1952 in connection with food services provided to persons attending the annual Texas State Fair and related exhibition activities; that opposer's licensed food services include the sale of jelly beans and other confections; that opposer has used BIG TEX in connection with its sale of jelly beans and other confections since long prior to any use of the mark by applicant; that applicant's use of its mark is likely to cause confusion with opposer's common law BIG TEX mark, contrary to the provisions of Section 2(d) of the Trademark Act; that

¹ Application Serial No. 75/941,731, filed March 10, 2000, and asserting dates of first use of May 15, 1967.

² Registration No. 1,551,364, issued August 8, 1989; Section 8 affidavit accepted; Section 15 affidavit received.

Opposition No. 121,897

opposer owns a registration for a cowboy character³; that opposer adopted BIG TEX as the name of the cowboy character and has promoted this name and character since 1952 as opposer's trade identity; that opposer has made common law use of the cowboy character and BIG TEX name since 1952 in connection with entertainment services performed during the annual State Fair of Texas, and has used the character and character name in the advertising and promotion of food services provided at the State Fair of Texas; that the food services promoted by the BIG TEX cowboy character include the retail sale of jelly beans during the annual State Fair of Texas; that the mark BIG TEX and the BIG TEX name of the cowboy character are uniquely identified with opposer and the annual State Fair of Texas in the context of confections and jelly beans since long prior to applicant's adoption of the mark BIG TEX; and that because applicant's mark BIG TEX is identical to opposer's common law BIG TEX mark, because each mark is used in connection with the retail sale of identical food products, because applicant's mark is identical to the name of opposer's cowboy character, and because of the association of the cowboy character and name BIG TEX with opposer, purchasers will assume that jelly beans sold by applicant under the mark BIG TEX have been

³ Registration No. 1,375,156, issued December 10, 1985; Section 8 affidavit accepted; Section 15 affidavit received.

Opposition No. 121,897

sponsored or endorsed by opposer, and such presumption of a business relationship would be false and misleading and contrary to the provisions of Section 2(a) of the Trademark Act.

In its answer to the amended notice of opposition applicant has admitted that opposer is the owner of Registration Nos. 1,551,364 and No. 1,375,156; that opposer's claimed common law mark BIG TEX and applicant's mark BIG TEX are visually and phonetically identical; that opposer has adopted BIG TEX as the name of its cowboy character (although denying that the character is known as BIG TEX by the public); and has otherwise denied the remaining salient allegations in the amended notice of opposition.⁴

⁴ It is unclear to us why applicant chose to repeat, in its answer to the amended notice of opposition, each of the allegations as recited in the notice of opposition, turning the opposer's statements into multiple sentences, e.g., "Applicant denies the allegations as set out in paragraph 20 of the Notice of Opposition in which Opposer alleges Opposer's licensed food services involved the sale of a wide variety of freshly prepared food items. Applicant denies the allegations as set out in paragraph 20 of the Notice of Opposition in which Opposer alleges that the freshly prepared food items include ice cream and other confections served in paper cups and plastic containers to the public by the Opposer's authorized vendors and concessionaires during the annual State Fair of Texas. Applicant denies the allegations as set out in paragraph 20 of the Notice of Opposition in which Opposer alleges that the Opposer's BIG TEX mark and an image of its cowboy character are applied directly onto the paper cups and plastic containers in which the above food items are advertised and served to the public by the licensed food service vendors and concessionaires." This resulted in a 13-page answer. The format used by applicant in its answer to the original notice of opposition, in which applicant merely indicated the paragraph number and denied or stated that it was without knowledge or information and therefore

The record includes the pleadings; the file of the opposed application; the trial testimony, with exhibits, of opposer's witnesses Ronald E. Black, Joseph B. Rucker, Robert B. Smith and Nancy N. Wiley; applicant's witnesses Amy Atkinson Voltz, Eduardo Granado, Dominga Cordova and Socoro Pacheco; and opposer's rebuttal witness, John Glowinkowski.⁵ Opposer submitted, under notices of reliance, a definition of the word "confection," (Exhibit QQ, 12/10/01); opposer's pleaded registrations for BIG TEX (Registration No. 1,551,364) and for a figure in a cowboy costume (Registration No. 1,375,156)⁶ (12/10/01); and applicant's responses to certain of opposer's interrogatories and certain of opposer's requests for admission.⁷ Applicant submitted, under notices of reliance,

denied the allegations set forth in the paragraph, (such that applicant indicated its responses to the allegations in the eight paragraphs in the original notice of opposition in two pages) is preferred by the Board.

⁵ The parties are advised that trial testimony does not need to be submitted under a notice of reliance, nor is it necessary to indicate the purpose for which the testimony is taken. Moreover, once testimony is taken by one side, it is of record, and the adverse party need not take any action in order to rely on it.

During the deposition of Mr. Glowinkowski, applicant's attorney objected to his testimony as improper rebuttal. We agree that Mr. Glowinkowski's testimony related to information that should have been part of opposer's case-in-chief. However, applicant did not maintain its objections in its brief, thereby waiving such objections; on the contrary, it referred to Mr. Glowinkowski's evidence in its recitation of facts. Accordingly, we have considered Mr. Glowinkowski's testimony.

⁶ This registration identifies the services as "arranging and conducting state fairs."

⁷ During its initial testimony period opposer had submitted a copy of its requests for admission, which applicant had failed to respond to, such that they were deemed to be admitted. Subsequently the parties stipulated that applicant could

a newspaper article from "The San Antonio Light"; third party registrations for marks consisting of or containing the term BIG TEX; dictionary definitions for "Tex," "production," "big" and "license"; and certain printouts taken from the Internet. It should be noted that printouts from Internet websites may not normally be made of record by notice of reliance because they do not meet the criteria for printed publications under Trademark Rule 2.122(e). See **Raccioppi v. Apogee Inc.**, 47 USPQ2d 1368 (TTAB 1998)

However, opposer has treated this material as being of record, see opposer's brief, pages vi and 2, and therefore we will deem it to have been stipulated into the record.

Opposer and applicant filed main briefs on the case, and opposer filed a reply brief. Applicant has moved to strike the latter document as untimely, and opposer requested that the Board consider the brief. Because the untimeliness of the reply brief was minimal, briefs aid the Board in its decision-making, and we do not believe defendant will suffer any prejudice,⁸ the Board has exercised its discretion and has considered the brief.⁹

substitute its responses to the requests for admission, and therefore the original submission has been given no consideration.

⁸ Applicant's argument that it is prejudiced by the fact that it has adhered to the Trademark Rules and opposer has not is not persuasive.

⁹ In its reply brief opposer has asked that the reference in applicant's brief to a pending application of opposer's be stricken because that application is not of record. We agree

Opposition No. 121,897

Opposer is a nonprofit corporation which puts on an annual fair, known as the State Fair of Texas. The fair has been held under that name each year since 1904, with the exception of the world wars. It is now the largest annual fair in the United States. The fair is held for 24 days, in September and October, and in the 20-year period from 1981-2000, attendance has averaged 3.2 million people per year.

The fair is located in Dallas. Although people from every state and many foreign countries have attended the fair through the years, its primary marketing area is within a 100-mile radius of Dallas. Opposer also markets the fair statewide and, to some extent, regionally, such as through the magazine "Southern Living."

The fair activities include agricultural and educational events, amusement rides, food services and exhibits. The food services consist of approximately 200 locations which serve a variety of products, from typical fair food such as cotton candy, corn dogs, hamburgers, funnel cakes and snow cones, to more unusual items such as Cajun and Asian food. Additional "confectionary" items, as shown in the food guide from the 1994 Visitor's Guide, are Austrian strudel and puff pastries, Belgian waffles, brownies, candy apples and caramel apples, chocolate nut

that such evidence is not of record, and therefore the comments regarding such an application will be given no consideration.

Opposition No. 121,897

bars, fried pies, frozen custard, ice cream/ice cream bars and taffy.

Another aspect of the fair is food contests, in which various food items submitted by contestants are judged. These foods include jelly, preserves, marmalade and jams of various flavors; pies with various flavor categories; desserts in the categories of cookies/cookie bars, puddings/confections, pies, and other desserts not included in other classes; cookies (categories: drop cookies, ice box, bars, brownies and holiday/party); and candy (categories: fudge, divinity, pralines, pecan roll, mints, hand-dipped chocolates, nut brittles, toffee and hard candies).

Ms. Wiley, opposer's vice president of marketing and public relations, testified that Frontier Fruit and Nut Company, one of the fair vendors, sells candies and nuts by the quarter or half pound, and that these include jelly beans, sour balls, rock candy and fudge. Ms. Wiley did not give any information as to the amount of sales of the jelly beans, and Mr. Black, opposer's vice president of food and beverages for the fair, was vague about the sale of jelly beans, stating that he believed that they were sold in the exhibits area, and that this was not his area of responsibility. Mr. Glowinkowski, who is the proprietor of Frontier Fruit and Nut, testified that he had sold jelly

Opposition No. 121,897

beans, including applicant's BIG TEX jelly beans, at the fair, but he could not remember with any detail when they were sold. His recollection was that jelly beans were sold sometime during the decade of the 80's, jelly beans being a popular item then because President Reagan liked them.

In 1952 opposer erected a 52-foot high statue of a cowboy as a focal point of the fair. It was originally referred to as, "Tex," then "big Tex," and by 1959 "Big Tex" was its official name. Big Tex acts as a spokesman for the fair; a recorded voice says "This is Big Tex," welcomes people to the fair, and announces different events and attractions, including foods that are available. The statue is noted on maps of the fair, and a picture of it, as well as the words BIG TEX, appears on the cups in which beverages are served and on souvenir mugs. The picture and words also appear on promotional materials, such as newspaper advertising inserts; brochures which are distributed through visitor centers in advance of the fair; and visitor guides which are given out to visitors at the fair gates.

Applicant is a company located in Texas. Through its predecessor-in-interest it began using the mark BIG TEX on jelly beans perhaps as early as 1961 or 1962, and certainly by 1967. (The information about this first use did not come from written company records, but was testimony by witnesses who worked at the company for fifty years. They had some

Opposition No. 121,897

difficulty remembering the date of the introduction of BIG TEX jelly beans with particularity, having to time it with other events in their lives.) The jelly beans are larger than normal size, and the name was chosen because the company is in Texas, and everything from Texas is supposed to be big. BIG TEX jelly beans are sold in packages, such as "two for \$1.00" packages, and larger bags and boxes, and also in bulk form to companies that may repackage the candy or simply sell it from their own tubs. Applicant sells its BIG TEX jelly beans to small and large grocery stores; to wholesale distributors who, in turn, sell them to convenience stores, candy chains, and bulk food stores; and to big repacking companies. Applicant promotes its BIG TEX candy through trade shows such as the National Association of Convenience Stores, the American Wholesale Marketers Association and the All Candy Expo. It distributes slicks and price lists to brokers and stores; there is no evidence of advertising to the ultimate consumers of the products. In 2001 sales of BIG TEX jelly beans amounted to \$220,000.

We turn first to an examination of the question, what are the grounds for opposition? Although opposer's amended notice of opposition refers to common law trademark rights in the mark BIG TEX for jelly beans, it is clear from opposer's brief that opposer is not asserting likelihood of

Opposition No. 121,897

confusion based on such a claim.¹⁰ Rather, opposer has characterized the grounds of opposition as (1) likelihood of confusion caused by applicant's use of BIG TEX as a trademark for jelly bean products, in view of opposer's prior use and registration of BIG TEX in connection with entertainment services and food services provided to persons attending the annual Texas State Fair and related exhibition activities [Section 2(d)]; and (2) false suggestion of a connection or business relationship between applicant and opposer due to applicant's use of BIG TEX for jelly bean products [Section 2(a)].

Opposer also states, at p. 3-4, that the issues to be determined are:

... whether the Applicant's use of BIG TEX as a trademark for jelly beans is likely to cause confusion to consumers when used contemporaneously with Opposer's use of BIG TEX for food services rendered in connection with an annual state fair in which confectionery food items, including jelly beans, are sold by food vendors and concessionaires licensed exclusively by the Opposer; and

...whether Applicant's use of BIG TEX as a trademark for jelly beans, contemporaneously with Opposer's use of BIG TEX for food services rendered in connection with an annual state fair in

¹⁰ In any event, opposer has not proven common law use of the mark BIG TEX for jelly beans. At most, opposer has shown that jelly beans are sold at booths at its fair; however, the mark BIG TEX is not used on the packaging for the candy, which is sold in plain paper bags, nor is there evidence of any signage used in connection with the sales that might perhaps be construed as displays associated with the goods.

which confectionery food items, including jelly beans, are sold by food vendors and concessionaires licensed exclusively by the Opposer, is likely to suggest, contrary to fact, the existence of a business relationship between the Applicant and the Opposer that would cause consumers to believe that the Applicant's BIG TEX jelly beans are somehow connected with the Opposer.

As a preliminary matter, we find that opposer has established its standing in view of its registration and use of the mark BIG TEX.

We turn first to the issue of likelihood of confusion. Priority is not in issue in view of opposer's ownership of its pleaded registration for the word mark BIG TEX, which registration is of record. With respect to the question of likelihood of confusion, our determination of this issue is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in **In re E. I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Several factors favor opposer. In particular, the marks are identical in appearance, pronunciation and connotation.¹¹ The goods and services are sold to the same

¹¹ Applicant argues that the marks differ in connotation because opposer's mark refers to the statue at the fair. However, we are not persuaded by this argument, which essentially asserts that we should not look to the words themselves to determine the connotation of opposer's mark, but treat the connotation as what the words have come to mean as a trademark. Therefore, the mark, as registered, does not have the limited connotation applicant asserts, even though the mark is also used as the name of the

Opposition No. 121,897

classes of consumers, the general public, and would be purchased without a great deal of care or thought, candy such as jelly beans being a prime example of an impulse purchase.

However, we cannot find on this record that BIG TEX is a famous mark for state fair services. Although BIG TEX has been used for more than 40 years, that use has been limited to an event that lasts for just 24 days each year. The attendance of approximately 3 million people per year, while impressive, includes people who attend the fair more than once in a season, and also people who are repeat visitors from year to year. According to a survey conducted by opposer in 2000, 41% of fair visitors are what were called "loyalists" and had attended every year between 1996 and 2000 (while in 1996 that figure was 36 per cent). Even some of the group classified as "new visitors" had attended the fair previously, but it was prior to 1996. So some of the 19% of "new visitors" were actually repeat visitors. More importantly, the fair is essentially local in nature. The primary marketing area is a 100-mile radius of the fair. The survey conducted by opposer in 2000 included questions which were "solely for Dallas-Ft. Worth visitors to capture information about their media usage habits that could

statue. Thus, opposer's registered mark and applicant's mark have the same connotation.

potentially enhance the Fair's future advertising campaigns." Exhibit GG, p. a-13. The fact that opposer chose to direct certain of its questions regarding radio listening and newspaper reading habits to local visitors supports the relatively local nature of the fair's attendees.

Although opposer presented some testimony of national exposure for the fair on the television programs "Good Morning America" and "Wheel of Fortune," there are no details as to when or how often this exposure occurred, nor whether the mark BIG TEX was mentioned. Ms. Wiley specifically testified that opposer does not have advertisements in general circulation magazines. p. 42. The only advertisement that is of record that can be considered a national advertisement is one that appeared in "Billboard Magazine" in 1960. Aside from the fact that this advertisement appeared so long ago that it has no bearing on the fame of the mark at the present time, according to Ms. Wiley's testimony, "Billboard Magazine" is primarily directed to the amusement and entertainment and food service industries.

Although people from every state in the United States may have attended the fair at one time or another (as Mr. Rucker testified, people would have guests in town who they'd take to the fair), we cannot find on this record that

the mark BIG TEX has achieved the kind of national recognition that would entitle it to be considered a famous mark.

Moreover, there are several factors which favor applicant, and we find these factors, and in particular, the question of the relatedness of the goods and services, to be dispositive. The similarities between the goods and services are, of course, one of the key considerations in the likelihood of confusion analysis. See **Federated Foods, Inc. v. Fort Howard Paper Co.**, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). Here, although opposer has gone to great lengths to establish that its food services are related to jelly beans, on closer examination we find that they are not. First, it must be remembered that opposer's registration for BIG TEX is for "arranging and conducting state fair activities, namely competitive exhibits featuring home, farm, business and industrial products; arranging and conducting entertainment and amusement services, namely sideshows, rides and games; and, arranging and conducting educational services in the nature of public exhibits and presentations featuring achievements in the arts and sciences." Food services per se are not even specified in these activities, although, because it is common knowledge that fairs include booths where food and beverages are served, we treat such food service as encompassed within

Opposition No. 121,897

state fair activities. However, the mere fact that prepared food items are offered at a fair does not necessarily mean that consumers will assume an association between state fair activities and jelly beans which are sold off the fair site.

Here, opposer has presented no evidence that jelly beans would be recognized as a typical food item sold at a state fair. On the contrary, opposer's witnesses referred to "typical" fair food, and no mention was made of jelly beans. Nor are jelly beans listed in the food guide directory as items which can be found at the fair. Mr. Black, opposer's vice president of food and beverages at the fair, could not even say with certainty that jelly beans were sold at the fair, even though he is responsible for the 200 food vendor locations at the fair. He stated that jelly beans were not his area of responsibility, and that he believed that they were sold in the exhibits area. Ms. Wiley, who testified that jelly beans were sold at one of the pavilions at the fair, did not provide any evidence of the amount of such sales. And Mr. Glowinkowski, whose company has for many years been a vendor of candy, dried fruit and nuts at the fair, was very vague about sales of jelly beans. Although, as noted above, he testified that his company had sold jelly beans at the fair, he could not remember any particular years when he sold jelly beans. When asked for a decade when jelly beans were sold, he

testified that they were sold in the 80's because jelly beans were popular then. He provided no information whatsoever as to the amount of sales.

Opposer has shown that jelly beans are confectionery items. However, one cannot equate jelly beans with such "fair food" confectionery as cotton candy or funnel cakes. The fact that a single term can be found that generically describes the goods is not sufficient to show that applicant's goods and opposer's fair activities, including the sale of prepared food, are related. See **General Electric Company v. Graham Magnetics Incorporated**, 197 USPQ 690 (TTAB 1977). Jelly beans are simply not food items that one would think of as being typically sold at food booths at a state fair.

Further, no food items sold at the fair are foods which are made or licensed by opposer. Thus, for example, sodas are sold under trademarks like COCA COLA or PEPSI, while the taffy is SUTTER'S. Essentially, visitors to the fair do not purchase any food sold under opposer's BIG TEX mark. Even the beverages which are sold in cups with the words BIG TEX and a picture of the statue are for third-party brand name sodas or beer, and they would be ordered by the particular brand name.

As for the exhibits and food contests, aside from the fact that jelly beans are not one of the candy categories,

clearly these are products made by members of the public who submit their creations for judging; they are not, and would not be regarded, as products produced by opposer.

Moreover, not only does opposer not sell any food under the mark BIG TEX, but opposer has a policy not to sell any products under the mark BIG TEX off the fair grounds. Thus, the channels of trade for opposer's services, including its food services, and applicant's goods are different. It need hardly be said that opposer cannot argue that there would be confusion if applicant were to sell its BIG TEX jelly beans at opposer's fair. Opposer cannot take part in creating confusion and then claim that it is likely to occur.¹²

Given these facts, consumers who are familiar with the BIG TEX mark for opposer's state fair are not likely to believe, upon seeing BIG TEX on jelly beans sold off the fairgrounds, that there is any connection between the goods and services despite the identity of the marks.

Another factor favoring applicant is the number and nature of similar marks in use on similar goods. In this

¹² We note Mr. Glowinkowski testified that at one point his stands at the fair sold applicant's BIG TEX jelly beans, and that a label identifying the jelly beans as BIG TEX and indicating the price, appeared on the front of the tubs containing the loose jelly beans. It appears from Mr. Glowinkowski's testimony, which was rather vague, that this occurred for only a short period of time, at some point during the 1980's. Although there is no evidence of any confusion occurring from this incident, we cannot consider such sales to support a finding of likelihood of confusion because the sale of BIG TEX jelly beans was within opposer's control.

connection, there is testimony of third-party use of BIG TEX by Texas Citrus Exchange for citrus juice. Applicant has also made of record Internet evidence from the New York, TX Cheesecake Co. website, www.nytxccc.com, offering 'Big Tex 14" Tall' peanut brittle. In addition, there is evidence of third-party registrations for, inter alia, BIG TEX for cooked hamburger sandwiches for consumption on or off the premises;¹³ BIG TEX for citrus juices¹⁴ and BIG TEX RIO RED (RIO RED disclaimed) for grapefruit juice and grapefruit drinks,¹⁵ both owned by Texas Citrus Exchange; as well as listings in the Yahoo Yellow Pages of various companies with "Big Tex" in their names, e.g., Big Tex Tire & Wheel, Big Tex Air Conditioning Inc., Big Tex Sandblasting. These registrations and listings show that BIG TEX has a significance for such goods and services, a significance which we have no doubt refers to something that comes from Texas.

We also note that there has been concurrent use of opposer's and applicant's mark for almost 40 years without any evidence of actual confusion. We recognize that evidence of actual confusion is notoriously difficult to obtain and, given the very low cost of applicant's jelly

¹³ Registration No. 1,226,815.

¹⁴ Registration No. 1,314,909.

¹⁵ Registration No. 2,198,648. (Registration Nos. 1,314,909 and 2,198,648 are owned by the same party.)

Opposition No. 121,897

beans, it is not clear that a consumer would be likely to apprise opposer of confusion if any had occurred.

Therefore, we do not rest our decision on this factor, but only point out that, if it favors either party, it favors applicant.

The factor of the variety of goods on which a mark is used must be considered neutral, or not to favor opposer. As previously discussed, opposer uses the mark BIG TEX only for its state fair activities and on a souvenir cup.

As for the extent to which opposer (or applicant) has a right to exclude others from use of its mark on its services or goods, there is testimony that opposer has taken action against some companies using the name BIG TEX. In particular, "Big Tex Auto Glass" auto services company agreed to remove "Big Tex" from its trade name; the domain name BIGTEX.COM was transferred by the party which had obtained it to opposer;¹⁶ and Mr. Jim's Pizza agreed to cease using the name "Big Tex" for one of its pizzas. However, Mr. Smith, opposer's corporate secretary and outside counsel, was aware of BIG TEX citrus juice in South Texas, and did not do anything about that use, despite his belief that it would cause confusion, because that company

¹⁶ According to Mr. Smith's testimony, the domain name was transferred in 1997. Opposer now uses this domain as its website address, and the website contains the same information that is in opposer's press kits or brochures.

had established their use of BIG TEX before opposer did. This factor must be considered to be either neutral or not to favor opposer.

In sum, although some of the duPont factors favor opposer, when we consider all the relevant factors, and especially the differences between the services for which opposer's mark BIG TEX is used and applicant's BIG TEX jelly beans, we find that opposer has not established that confusion is likely. Accordingly, the opposition must be dismissed as to this ground.

The second issue before us is whether applicant's use of BIG TEX for jelly beans falsely suggests a connection with opposer, the State Fair of Texas. Opposer's position is that the 52-foot statue of a cowboy which has appeared at the State Fair of Texas since 1952, and which has been known as BIG TEX since the late 50's, is the official ambassador or dominant icon of the fair.¹⁷ Opposer's witnesses have

¹⁷ Opposer also makes the argument, in the section of its brief regarding its Section 2(a) claim, that "the mark BIG TEX has become uniquely identified with the Opposer and the annual State Fair of Texas as an indicator or origin for confection food items, offered to the public by Opposer's food service operations long prior to Applicant's filing date or any date of use that can be proven by the Applicant." p. 27. This argument, however, goes to the issue of likelihood of confusion. Further, as the Court of Appeals for the Federal Circuit said in **University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.**, 703 F.2d 1372, 217 USPQ 505, 508 (Fed. Cir. 1983), "to the extent that the University [plaintiff] relies upon its prior use of NOTRE DAME for particular goods and services and there is no proof of likelihood of confusion as to the source of Gourmet's goods, under no circumstances could there be a false association." Because we have already found that there is no

variously described the statue, which they refer to throughout their testimony as BIG TEX, as the symbol and icon of the State Fair, and have said that it represents the fair and all that is involved with the fair.

In **University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.**, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), the Court of Appeals for the Federal Circuit stated that to succeed on a Section 2(a) false suggestion of a connection ground, the plaintiff must demonstrate that the name or equivalent thereof claimed to be appropriated by another must be unmistakably associated with a particular personality or "persona" and must point uniquely to the plaintiff. The Board, in **Buffett v. Chi-Chi's, Inc.**, 226 USPQ 428 (TTAB 1985), in accordance with the principles set forth in Notre Dame, required that a plaintiff asserting a claim of a false suggestion of a connection demonstrate

- 1) that the defendant's mark is the same or a close approximation of plaintiff's previously used name or identity;
- 2) that the mark would be recognized as such;
- 3) that the plaintiff is not connected with the activities performed by the defendant under the mark; and
- 4) that the plaintiff's name or identity is of sufficient fame or reputation that when the defendant's mark is used on its

likelihood of confusion, we will not further consider this line of argument.

goods or services, a connection with the plaintiff would be presumed.

We find that plaintiff has failed to establish the elements for succeeding on a false suggestion of a connection claim. Although plaintiff's witnesses have used the term "icon" or "symbol" in connection with the BIG TEX statue, it is not clear to us that the words BIG TEX would be perceived as the name or identity, i.e., an alter ego of the State Fair of Texas. The fair is not referred to as BIG TEX, as a nickname might be used as an alternative for a person's name. We agree that the BIG TEX statue is a prominent element of opposer's fair, both in terms of its size and its role in the fair, and that both the statue and the words BIG TEX have been promoted as part of the fair. However, we cannot say that the words BIG TEX per se--and not the statue--are the equivalent of "State Fair of Texas."

The strongest evidence that BIG TEX has been used as an alter ego for the State Fair is Exhibit NN, the 1960 advertisement in "Billboard Magazine." However, because this publication is a trade magazine, it does not show that the public would view BIG TEX as an alternative name for the State Fair. Moreover, that advertisement is from 1960, and certainly does not show that this is the current public perception. For similar reasons, exhibits FF, the official guide of the 1965 state fair, and OO, the visitors guide to

Opposition No. 121,897

the 1959 state fair, do not indicate how the term would be perceived today.

Many other, and more recent, documents, do not particularly highlight BIG TEX or the statue. For example, the 1990 map/calendar which was distributed at Exxon stations (exhibit I) primarily advertises the auto show sponsored by Exxon. The map does show the statue of Big Tex, with the words "BIG TEX" next to it, but it is merely a location, and is displayed no more prominently than the words "Truck Exhibits" or "Vietnam Veterans Memorial," or the picture of the music hall or the Ferris wheel. In the 1994 Visitor's Guide, a 32-page brochure, the words "BIG TEX" are only on page 5, and it appears in the same manner as the listings of other attractions such as the petting farm, exhibit buildings and Texas Star Ferris wheel.

The materials which do refer to BIG TEX as a symbol or icon all appear to refer to the statue itself, not the words BIG TEX. For example, opposer's plastic glasses and souvenir mugs bear a large picture of a cowboy, along with the words BIG TEX and "The Official Symbol of the State Fair of Texas." That slogan, referring to a symbol, indicates that it is the statue itself, rather than the words BIG TEX, that is the icon. Similarly, the article in the "Dallas Morning News" (Exhibit V), captions a photograph of the statue's head, "A worker finishes up a face-to-face meeting

with Big Tex, testing the State Fair icon's parts in Fair Park. As a result, even if the statue could be considered the symbol for the fair, the words BIG TEX, separate from the statue, would not have the same significance.

Opposer asserts that the term BIG TEX is legally equivalent to the statue of the cowboy character, relying on a case that held that the name of an object and its image are legal equivalents. However, the fact that opposer has named its cowboy statue BIG TEX does not mean that the word and the image are legal equivalents. The case cited by opposer, **Thistle Class Association v. Douglass & McLeod, Inc.**, 198 USPQ 504 (TTAB 1978), would apply if the question were whether the word COWBOY and the image of a cowboy were legal equivalents, not to the instant situation.

Even if we were to find that opposer uses the words BIG TEX as its persona or alter ego, the public would not recognize the words BIG TEX per se, seen outside of the context of the statue, to be opposer's name or identity. As Mr. Rucker testified, "Tex" is a nickname commonly given to people from Texas. "It's just a standard name for Texans, by other people usually." p. 31. And, as Ms. Voltz testified, everything from Texas is supposed to be big.

The third-party registrations for BIG TEX, for goods ranging from food products like hamburger sandwiches (Reg. 1,226,815) and citrus juices (Reg. 1,314,909) to solvent

Opposition No. 121,897

cleaner (Reg. 935,783) and trailers (Reg. 2,105,020) indicate the suggestiveness of this term. Further, there is evidence of third-party uses of the term BIG TEX, specifically BIG TEX for peanut brittle in the shape of the state of Texas and BIG TEX citrus juices. In addition, the listings in the Yahoo Yellow Pages for "Big Tex" companies, while not evidence of the use of the marks, indicate that "Big Tex" is an apt term for a company located in Texas. Moreover, anyone in the Dallas area who did associate BIG TEX with opposer, and who looked up this name in a telephone directory, would encounter the various third-party listings.

Accordingly, we cannot say that the term BIG TEX points uniquely to opposer.

Opposer's claim of a false suggestion of a connection also fails with respect to the fourth factor set forth in Buffett, that the plaintiff's name or identity is of sufficient fame or reputation that, when the defendant's mark is used on its goods or services, a connection with the plaintiff would be presumed. As we said in our discussion of the factor of fame, opposer's use of the name and mark BIG TEX is known primarily within opposer's marketing area, which is a 100-mile radius of Dallas. Therefore, there is no evidence that, outside of opposer's general "draw" area, the identity of plaintiff as BIG TEX would be known. As for opposer's primary marketing area, because BIG TEX is an

Opposition No. 121,897

appropriate name for a company located in Texas, consumers in this area will not assume a connection between applicant's use of BIG TEX for jelly beans and opposer.

The Court in Notre Dame noted that, even if there are uses of the involved term by third parties, a mark may still be found to point uniquely to the plaintiff's identity if the evidence showed that the defendant intended to identify the plaintiff. We find no evidence of such intent in this case. Applicant's explanation for its adoption of the mark--that the candy comes from Texas, and the jelly beans are larger than normal size--is perfectly credible. Moreover, there is nothing in applicant's packaging or advertising or other promotional materials that even suggests a connection with opposer, e.g., there are no pictures of cowboys or of anything that one normally associates with a fair.

Therefore, we find that opposer has not established that applicant's use of the mark BIG TEX for jelly beans will falsely suggest a connection with opposer.

Decision: The opposition is dismissed as to both the Section 2(d) ground of likelihood of confusion and the Section 2(a) ground of a false suggestion of a connection.