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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/091459

MARK: TIRES TIRES TIRES

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APPLICANT: Tires, Tires, Tires, Inc.



GENERAL TRADEMARK INFORMATION:

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CORRESPONDENT'S REFERENCE/DOCKET NO:

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the Trademark Examining Attorney's final refusal to register the trademark "TIRES TIRES TIRES" for "retail tire store" in International Class

035 on the ground that it is generic within the meaning of § 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1).

FACTS

Applicant applied for registration on the Principal Register of the proposed trademark “TIRES TIRES TIRES” for services originally identified as “retail tire store” in International Class 035. *See* Applicant’s original application. In his first office action, the Examining Attorney refused registration under § 2(e)(1) of the Trademark Act because the proposed mark for which registration is sought is merely descriptive of the identified services. In response, Applicant claimed that the mark has become distinctive of the services through the Applicant's substantially exclusive and continuous use in commerce for at least the five years and amended the application to pursue registration under § 2(f) of the Trademark Act, 15 U.S.C. §1052(f).

The Examining Attorney found the Applicant’s § 2(f) claim insufficient to prove the mark had acquired distinctiveness, since the evidence of record indicates the proposed mark is highly descriptive for the Applicant’s services. Applicant responded by submitting more evidence to support the § 2(f) claim.

Upon further review the Examining Attorney refused the Applicant’s specimen because it failed to show the applied for mark used in connection with the services specified in the application under Trademark Act § 1 & 45, 15 U.S.C. §§1051, 1127. Also, Applicant’s specimen differed from its drawing. Applicant responded by submitting an acceptable substitute specimen and drawing.

After further review of Applicant’s § 2(f) claim and its supporting evidence, the Examining Attorney refused registration under § 2(e)(1) generic notwithstanding a § 2(f)

claim and submitted evidence supporting the refusal. Applicant responded by arguing against the refusal. Examining Attorney responded by making a final refusal and submitting additional evidence. This appeal follows Examining Attorney's final refusal.

ARGUMENT

THE APPLIED-FOR MARK IS GENERIC AND INCAPABLE OF SERVING AS A SOURCE –IDENTIFIER FOR APPLICANT'S SERVICES UNDER SECTION 2(e)(1) OF THE TRADEMARK ACT.

Generic terms are terms that the relevant purchasing public understands primarily as the common or class name for the goods and/or services. See *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1344, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001).

Generic terms are by definition incapable of indicating a particular source of the goods and/or services, and cannot be registered as trademarks and/or service marks; doing so “would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are.” *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 1569, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987).

A two-part test is used to determine whether a designation is generic: (1) What is the class or genus of services at issue? and (2) Does the relevant public understand the designation primarily to refer to that class or genus of services? See *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 990, 228 USPQ 528, 530 (Fed. Cir.

1986). Here, the genus of the services at issue is “tires” and “retail tire stores.”¹ In his 6/15/2008 and 10/02/2008 Office actions, the Examining Attorney attached several images from the Internet showing the generic quality of the word “tire” when used by retail tire stores. A selection of this evidence follows:

- www.discounttire.com -- DISCOUNT TIRE AMERICA’S TIRE AMERICA’S LARGEST INDEPENDENT TIRE DEALER...SHOP FOR TIRES...TIRE SEARCH...WINTER TIRES
- www.tiresplus.com --TIRES PLUS THINKING TIRES? THINKING TIRES PLUS SHOP FOR TIRES THE ONLINE PLACE TO SHOP FOR TIRES...TIRES PLUS IS YOUR COMPLETE SOURCE FOR NEW TIRES FOR YOUR CAR, TRUCK, OR SUV. WHETHER YOU ARE LOOKING FOR A HIGH PERFORMANCE TIRE OR SNOW TIRE
- www.1010tires.com -- 1010 TIRES THE COMPLETE WINTER TIRES GUIDE...BUY TIRES...FALKEN TIRES CUSTOMER TIRE RATINGS AND REVIEWS...READ TIRE REVIEWS...RATE TIRES...SEARCH TIRES BY VEHICLES
- www.toyo.com -- TOYO TIRES...TIRES...TIRE RECOMMENDATIONS...TIRE BASICS...TIRE RECOMMENDER
- www.tiresunlimited.com -- TIRES UNLIMITED...ONE OF THE NATION’S LARGEST RETAILERS OF DISCOUNT MOTORCYCLE TIRES ATV TIRES & SPECIALTY TIRES...CAR & TRUCK TIRES TOO...WELCOME TO TIRES UNLIMITED WHERE WE CURE BALDNESS.

It is clear, therefore, that the genus of goods or services for “tires” and retail “tire” stores is “tires.” The relevant public would understand that the mark “TIRES TIRES TIRES” would primarily refer to that genus of goods and services. Applicant contends that the Examining Attorney failed to meet his evidentiary burden in not providing evidence of the string “TIRES TIRES TIRES” in actual use. *See Applicant’s brief* at page 6. The repetition of a merely descriptive or generic word does not negate the mere

¹ “Tire” is defined as “rubber edging for wheel: a hollow band of rubber, often reinforced with fibers of other material, fitted around the outer edge of a vehicle's wheel and filled with compressed air.” [add source] *See* 10/02/2008 Office action.

descriptiveness of the mark as a whole. See *In re Disc Jockey's, Inc.*, 23 USPQ2d 1715. Further, a mark comprised of a repeated descriptive term is merely descriptive where no new or different commercial impression results from the repetition. See *In re Litehouse, Inc.*, 82 USPQ2d 1471, 1474-75 (TTAB 2007) (holding CAESAR! CAESAR! merely descriptive for salad dressing) It follows that the mere repetition of a generic term, "TIRES", does not negate the generic quality of the mark "TIRES TIRES TIRES." As is shown in the evidence above, the repetitive use of the wording "tire" or "tires" by tire retailers does not change the meaning of the word. Applicant's use of "TIRES TIRES TIRES" does not make the mark or its individual terms distinctive and creates no duty on the part of the Examining Attorney to provide evidence of the same generic string in commerce.

Applicant also claims that the genus for its services is not "tires", but "retail tire stores." *Applicant's brief at page 6.* A term that is generic for a type of goods is also generic for the service of selling primarily those goods. See *In re A La Vieille Russie, Inc.*, 60 USPQ2d 1895 (TTAB 2001) (holding RUSSIANART generic for art dealership services in the field of Russian art). Here the term "tires" for a type of good is also generic for the service of selling those goods in a retail tire store.

Applicant contends the refusal to register is based upon on an incorrect legal test. "Appellant's mark TIRES TIRES TIRES is not made up of one or more compound terms but rather a phrase consisting of multiple terms. See *e.g., American Fertility*, 188 F.3d at 1837. Thus, the correct legal test, is as a phrase as a whole, for the whole may be greater than the sum of the parts." *Applicant's brief at page 5.* However, there is nothing in the generic composite "TIRES TIRES TIRES" which changes the meaning of the letters in

any manner that would give them a different meaning. *Disc Jockey's* at 1716. In fact, the Applicant offers no alternative meaning in her brief which would counter the generic meaning of the phrase.

IN THE ALTERNATIVE, APPLICANT'S PROPOSED TRADEMARK IS MERELY DESCRIPTIVE OF THE IDENTIFIED SERVICES SUCH THAT REGISTRATION IS REFUSED UNDER § 2(E)(1) OF THE TRADEMARK ACT.

A mark is merely descriptive under § 2(e)(1) if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods and/or services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). The determination of whether a mark is merely descriptive is considered in relation to the identified services, not in the abstract. *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (CCPA 1978). As will be shown below, the mark describes a feature of Applicant's services.

Applicant applied to register the proposed trademark "TIRES TIRES TIRES" for "retail tire store" in International Class 035. It is undisputed that the Applicant's services are providing retail store services for *tires*. Given the ordinary dictionary definition of the term "TIRES" in the proposed mark, the phrase "TIRES TIRES TIRES" merely describes a feature of Applicant's services, namely providing tires for sale and therefore the mark is merely descriptive under § 2(e)(1).

THE APPLICANT'S SUPPORTING EVIDENCE IS INSUFFICIENT TO ESTABLISH THAT THE PROPOSED TRADEMARK HAS ACQUIRED DISTINCTIVENESS UNDER § 2(F).

Applicant's Showing of Acquired Distinctiveness is Insufficient

A claim of distinctiveness under §2(f), whether made in the application as filed or in a subsequent amendment, may be construed as conceding that the matter to which it pertains is not inherently distinctive (and thus not registrable on the Principal Register absent proof of acquired distinctiveness). *See, e.g., Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 1577, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988). Applicant has asserted acquired distinctiveness based on twenty years' use in commerce. However, because the applied-for mark is generic or so very highly descriptive of Applicant's services, the allegation of twenty years' use is insufficient to show acquired distinctiveness. *In re Kalmbach Publ'g Co.*, 14 USPQ2d 1490 (TTAB 1989); TMEP §1212.05(a).

It is well established that the burden of demonstrating acquired distinctiveness rests with applicant. It is a question of fact. *In re Loew's Theatre's, Inc.* 769 F.2d 764. 769, 226 USPQ 865, 869 (Fed. Cir. 1985). The kind and amount of evidence necessary to establish that the mark has acquired distinctiveness in relation to the goods or services necessarily depends on the nature of the mark and the circumstances surrounding the use of the mark in each case. *Roux Laboratories, Inc. v. Clairol, Inc.*, 427 F.2d 823, 166 USPQ 34 (C.C.P.A. 1970).

Applicant has submitted the following evidence in support of its § 2(f) claim:

- Declaration of President of TIRES TIRES TIRES, attesting to 20 years of use of the mark and the expansion of business to three service centers in two cities
- Declaration of general manager of Powell Broadcasting of Sioux City, Iowa, stating that applicant has spent over \$1,000,000.00 in advertising TIRES TIRES TIRES and therefore has achieved substantial brand recognition.
- Declaration of General Sales Manager for KMEG14 that Applicant has successfully branded its trademark.

Applicant concludes “[b]ased upon the evidence of record of over 20 years of contemporaneous use of the mark in commerce, testimony of advertising experts in the field vouching for the brand recognition accumulated through extensive advertising of Applicant’s mark, and the expenditures for advertising of the mark for at least the last six years, Applicant asserts it has demonstrated that its mark has acquired distinctiveness and consumers associate the TIRES TIRES TIRES mark exclusively with Applicant.”

Applicant’s brief at page 9.

From the evidence presented it is obvious that the Applicant has built a successful retail tire business. It does not follow, however, that customers have come to recognize the words “TIRES TIRES TIRES” as a trademark. It is more likely that the customers recognize the wording “TIRES TIRES TIRES” as a generic repetitive informational slogan referring to tires. Applicant has accrued significant advertising expenses. Standing alone, the advertising expenses may demonstrate the success of the Applicant’s services, but not that the relevant consumers have come to view the proposed mark as Applicant’s mark for such services. The Applicant’s statements and exhibits merely tend to show that the Applicant has undertaken external promotions to advertise its core

business of retail tire sales. See *In re Busch Entertainment Corp.*, 60 USPQ2d 1130 (TTAB 2000). Finally, advertising cannot convert something unregistrable, such as a common descriptive term, into a registrable mark. *Roux* at 39.

As with establishing acquired distinctiveness by either of the other methods discussed above, the question to be resolved is not whether the mark is capable of becoming distinctive (though given the nature of the mark that possibility seems doubtful) but whether the acquired distinctiveness of the mark in relation to the goods or services has in fact been established in the minds of the purchasing public. *In re Redken Laboratories, Inc.* 170 USPQ 526 (TTAB 1971). In this instance, the Applicant has failed to meet its burden. Applicant has provided a relatively small number of declarations. The proof of distinctiveness requires more than proof of the existence of a relatively small number of people who associate the mark with the applicant. *In re Paint Products Co.*, 8 USPQ2d 1863, 1866 (TTAB 1988). In the *Paint Products* case, ten affidavits from customers were considered insufficient. The three declarations submitted by the Applicant, therefore, are likewise insufficient to establish that the mark has acquired distinctiveness. The value of the affidavits or declarations depends on the statements made therein and the identity of the affiant or declarant. *Ibid.* The number of declarations is less important than competent evidence of consumer recognition. *In re The Black & Decker Corporation*, (TTAB 2006 LEXIS 489). The declarants, although potentially competent to present evidence as to the perception of the mark by its consumers, instead present totals of advertising dollars spent and unsupported assertions that therefore the mark has achieved brand recognition. The declarations fail to show any evidence of secondary meaning in the form of affidavits, testimonials, or surveys from

the relevant group of consumers as the proposed 'mark' in question. The declarations are conclusory and self-serving. See *In re Gray Inc.*, 3 USPQ2d 1558, 1560 (TTAB 1987).

Finally, the Applicant's advertising and sales expenditures are insufficient. Large expenditures cannot *per se* establish that a mark identifies or distinguishes goods or services of an applicant. It is necessary to examine the advertising material to see what the commercial impression is created by the mark's use and what it means to the purchasers. *Redken* at 529. In the *Redken* case, ten years of use, \$500,000.00 in promotion, and the staging of 300 demonstrations a year were held insufficient as Section 2(f) evidence. Although the Applicant has spent a considerable sum, there is no direct evidence submitted as to kind of advertising made or commercial impression imparted to the relevant consumers regarding the actual proposed 'mark'. More generally, no amount of purported proof that a generic term has acquired secondary meaning can transform that term into a registrable trademark. Such a designation cannot become a trademark under any circumstances. See *In re Bongrain*, 894 F.2d at 1317 n.4, 13 USPQ2d at 1728 n.4.

CONCLUSION

The proposed trademark is generic with regard to the identified services under § 2(e)(1), 15 U.S.C. § 1052(e)(1). Furthermore, the proposed trademark is not capable of acquiring distinctiveness. In the alternative, the proposed trademark is merely descriptive of the identified goods under § 2(e)(1), 15 U.S.C. § 1052(e)(1). However, even if the proposed trademark were capable of acquiring distinctiveness, the Applicant's supporting evidence is insufficient to support such a claim. For the foregoing reasons, the refusal to registration under § 2(e)(1) of the Trademark Act should be affirmed.

Respectfully submitted,

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