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

Proceeding	77091459
Applicant	Tires, Tires, Tires, Inc.
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Submission	Reply Brief
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Date	03/31/2009

TRADEMARK

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

IN RE: Tires, Tires, Tires, Inc.	)	
SERIAL NO: 77/091,459	)	Appeal No. _____
MARK: TIRES TIRES TIRES	)	
FILED: January 27, 2007	)	
LAW OFFICE: 104	)	

Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

REPLY BRIEF

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STATUTES

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Dear Sir:

I. INTRODUCTION

Please enter the following Reply Brief into the record. It responds to the Examining Attorney's request to affirm the refusal of registration of the above-stated mark. The refusal to register Appellant's mark should be reversed as Appellant's mark is not generic and Appellant has more than sufficiently shown that Appellant's mark has acquired distinctiveness.

II. IMPERMISSIBLE NARROWING OF DEFINITION OF GENUS

The Examining Attorney continues to hinge the refusal to register, in part, on impermissibly narrowing the genus of services to "tires." Examining Attorney's Appeal Brief, page 4. The Examining Attorney supports the narrowing of the genus with web pages from a search of the single word "tires." *Id.* Nowhere does the Examining Attorney offer evidence of a search for the phrase "tires tires tires." It is uncertain whether the Examining Attorney chose just to narrowly search for "tires" to support his argument or if he did not offer any evidence of any search for "tires tires tires" because he could, not find any evidence to support his argument. If no search was conducted for "tires tires tires" the Examining Attorneys conclusory statement the "no new or different commercial impression results from the repetition" is wholly unsupported. *Id.* at 5.

The specified and accepted identification of services for Appellant's mark is "retail tire store." A retail tire store goes beyond tires. It also suggests ancillary items such as wheel rims, automotive repair, alignments, brakes, etc. The identification of services is sufficiently definite to serve as the name of the genus of Appellant's services for purposes of the genericness analysis in the instant matter; therefore, there is no support for the Examining Attorney's argument to define the genus of services more narrowly than the identification of services itself. *See In re American*

Institute of Certified Public Accountants, 65 U.S.P.Q.2d 1972, 1981 (T.T.A.B. 2003) (holding that the identification of goods [services] should not be ignored). Thus, the genus is correctly identified as stated in Appellant's application – "retail tire store."

III. THE PHRASE TIRES TIRES TIRES IS NOT GENERIC

The Examining Attorney acknowledges that the correct legal test for TIRES TIRES TIRES is as a phrase as a whole. Examining Attorney's Appeal Brief, page 5. However, the Examining Attorney contends that because he believes the single term "tires" is generic, the phrase TIRES TIRES TIRES is therefore generic as well. *Id.* at pgs. 5-6. "The burden of showing that a proposed trademark [or service mark] is generic remains with the Patent and Trademark Office." *In re American Fertility Society*, 188 F.3d 1341, 51 U.S.P.Q.2d 1832, 1834 (Fed. Cir. 1999) (citing *American Fertility*, slip op. at 9 (Hanek, J., dissenting)). As in *American Fertility*, the Examining Attorney here has not demonstrated that the <u>unitary phrase</u> – "tires tires tires" – has been used in a generic sense. The Examining Attorney only offers web pages from the search of the singular term "tires." Evidence that words considered individually may be generic is not sufficient to prove that a <u>phrase</u> is generic. *Id.* at 1836; *see In re Disc Jockeys Inc.*, 23 U.S.P.Q.2d 1715, 1716 (T.T.A.B. 1992) (It is insufficient that the Examining Attorney simply cite definitions and generic uses of the single term of the mark in lieu of conducting an inquiry into the phrase as a whole. *Id.* Since the Examining Attorney offered no other evidence than from the search for the singular term "tires," he has not met the required burden of showing that the <u>phrase</u> is generic.

IV. APPELLANT'S SHOWING OF ACQUIRED DISTINCTIVENESS IS SUFFICIENT

The Examining Attorney argues that Appellant's evidence as to acquired distinctiveness is insufficient. Examining Attorney's Appeal Brief, page 7. The amount and character of

evidence needed to establish acquired distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered. *Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 166 U.S.P.Q. 34, 39 (C.C.P.A. 1970). Appellant's evidence taken as a whole is sufficient to show acquired distinctiveness. In this case, Appellant has attested that the applied for mark has been in use in commerce for a time period of over twenty (20) years, or since at least as early as October 28, 1986. Appellant's Appeal Brief, Exhibit B, ¶ 2. Appellant has expanded its presence from one service center to three service centers in two different cities. *Id.* at ¶ 3. Appellant's advertising expenditures to promote its mark TIRES TIRES TIRES and the associated services is projected to exceed $1,000,000 for the past seven years. *Id.* at ¶ 7. These advertising expenditures are substantial for Sioux City, Iowa. In addition, Appellant has submitted declarations attesting to customer recognition that the mark TIRES TIRES TIRES is distinctive of a single source. The Examining Attorney states that "[i]t is more likely that the customer recognize the wording "TIRES TIRES TIRES" as a generic repetitive informational slogan referring to tires. Examining Attorney's Appeal Brief, page 8. The Examining Attorney's statement is absolute conjecture; offering no basis, factual or otherwise, for his supposition. Further, the Examining Attorney discounts the submitted declarations as "conclusory and self-serving." Examining Attorney's Appeal Brief, page 10. The declarations speak for themselves. *See e.g., In re Data Packaging Corp.*, 453 F.2d 1300, 172 U.S.P.Q. 396, 399 (C.C.P.A. 1972) (fact that affidavits were drafted by applicant's attorney and practical identical does not detract from the probative value of the affidavits). The persons signing the declarations are attesting to the recognition of the mark and, therefore, the declarations are of probative value with respect to a showing of acquired distinctiveness, in combination with the other evidence presented by Appellant.

III. CONCLUSION

For the above-stated reasons, as well as Appellant's comments in its Appeal Brief, Appellant respectfully requests that the Examining Attorney's final refusal to register Appellant's mark TIRES TIRES TIRES be reversed and Appellant's mark be forwarded for publication in light of the evidence of acquired distinctiveness under Section 2(f) of the Trademark Act.

Respectfully submitted,

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