

ESTTA Tracking number: **ESTTA42439**

Filing date: **08/17/2005**

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	The Reinalt-Thomas Corporation
Granted to Date of previous extension	08/17/2005
Address	20225 North Scottsdale Road Scottsdale, AZ 85255 UNITED STATES

Attorney information	Donna H. Catalfo Gallagher & Kennedy, P.A. 2575 East Camelback Road Phoenix, AZ 85016 UNITED STATES dhc@gknet.com Phone:(602) 530-8208
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Applicant Information

Application No	78431784	Publication date	04/19/2005
Opposition Filing Date	08/17/2005	Opposition Period Ends	08/17/2005
Applicant	Repair One Automotive Concepts, LLC 501 Old Dunlawton Avenue Port Orange, FL 32129		

UNITED STATES

Goods/Services Affected by Opposition

Class 035.

All goods and services in the class are opposed, namely: Retail tire store services and online retail tire store services

Related Proceedings

The Reinalt-Thomas Corporation has also separately filed a Notice of Opposition to application serial Nos. 78/431,577 and 78/431,802.

Attachments

784.pdf (6 pages)

Signature

/dhc/

Name

Donna H. Catalfo

Date

08/17/2005

Mark: JUST SAY "TIREUS"

Serial No.: 78/431,784

Notice of Opposition

was granted an additional 60-day extension to file this Notice of Opposition until August 17, 2005.

The grounds for opposition are as follows:

1. Opposer is a Michigan corporation doing business as Discount Tire Company ("Discount Tire"). Opposer is the nation's largest independent dealer of tires, wheels and related accessories for automobiles, light trucks and sports utility vehicles. In addition to sales of tires, wheels and accessories, Discount Tire provides related installation and repair services.

2. Over the past several years, at least since 1996, Opposer has extensively and continuously used the mark TIRES.COM to promote a wide range of on-line services, including the purchase of tires, wheels and related accessories; the ability to obtain a price quote for tires, wheels and related accessories that must be honored by a Discount Tire store; and information related to repair, maintenance and performance of tires and wheels.

3. Opposer utilizes extensive national advertising to promote its services in conjunction with the TIRES.COM mark, including advertising, marketing material, marketing devices within each Discount Tire location, signage, billboards, newspaper advertisements, invoice reference, and prominent trademark use on Discount Tire's "www.tires.com" web page, which receives approximately one million hits per day.

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4. As a result of such active use, advertisement and promotion by Opposer of its TIRES.COM mark, Opposer has developed recognition in the public regarding the origin of the mark and its accompanying services. Opposer has valuable goodwill in the TIRES.COM mark.

5. Opposer has filed an application for registration of its TIRES.COM mark for "automobile and light truck tires and wheels," in International Class 12 and 35 (Serial Number 78/519,465). Opposer's first use of the TIRES.COM mark in interstate commerce, in relation to that application, was on December 3, 1996, and the mark has been in continuous use ever since.

6. In a first office action, the Patent and Trademark Office initially refused registration of Opposer's TIRES.COM mark on the grounds that the mark is generic. Opposer intends to respond to this office action and illustrate that the mark is not generic under the standards for registration articulated by the Patent and Trademark Office and the federal courts, including the Federal Circuit.

7. Applicant filed an Intent to Use Application, Serial Number 78/431,784, on June 8, 2004, for the mark JUST SAY "TIREUS" for "retail tire store services and online retail tire store services," in International Class 35. The application was published in the *Official Gazette* for opposition on April 19, 2005.

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8. Applicant's services recited in the application are intended to be offered to the public through similar channels of commerce and to the same class of purchasers as Opposer's services.

9. Opposer will be damaged by registration of Applicant's mark, because the mark sought to be registered by Applicant, when used on or in connection with the services recited in the application, so resembles the mark that Opposer uses in providing similar services under Opposer's TIRES.COM mark, as to be likely to cause confusion, or cause mistake or to deceive.

10. Likelihood of confusion is the keystone of both common law and statutory infringement. Infringement is governed by whether the use of the mark is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection or association of the user (Applicant) with the senior user (Opposer). Opposer, using the TIRES.COM mark, has, since 1996, provided a broad range of on-line services related to tires, wheels and accessories. Opposer's services include the same description of services alleged by Applicant. There is a strong likelihood that a purchaser of Applicant's services would believe that such services are in some way affiliated with, or originate from, Opposer. Applicant should not be allowed to trade off the goodwill established in Opposer's TIRES.COM mark.

11. While Opposer believes that its mark TIRES.COM is registrable, if the

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Patent and Trademark Office ultimately concludes that Opposer's mark is generic or merely descriptive, such a finding would be wholly inconsistent with a finding that Applicant's mark, for nearly identical services, is registrable, given that Applicant's mark includes only one additional letter denoting the geographical scope of Applicant's services (without the ".com" designation) and a descriptive slogan. Opposer will be harmed by such inconsistent findings.

12. Moreover, if Opposer's TIRES.COM mark is found to be generic or descriptive, Opposer asserts that application of those same standards requires a finding that Applicant's almost identical mark for nearly identical services is generic or descriptive. Registration of such a generic or descriptive mark will harm Opposer and similar competitors by giving Applicant the *prima facie* right to use the generic or descriptive mark and similar variations thereof to the exclusion of all others, including Opposer, who offer similar services.

WHEREFORE, Opposer prays for an Order sustaining this Opposition and refusing registration of the mark that is the subject of the above-captioned application, and for such other relief as may be proper.

Please deduct the fee payment in the amount of \$300 and any additional fees or deficiency from our deposit account number 07-0135.

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Respectfully submitted,

Dated: August 17, 2005

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