

**THIS OPINION
IS NOT A PRECEDENT OF
THE TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Bliss Publications, LLC

Serial No. 77779284

Daniel J. Holmander of Barlow, Josephs & Holmes Ltd. for applicant.

Doritt Carroll, Trademark Examining Attorney, Law Office 116 (Michael W. Baird, Managing Attorney).

Before Kuhlke, Ritchie, and Shaw, Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

Bliss Publications, LLC has appealed from the final refusal to register BABY GUIDE, in standard characters, for "Printed guides for new or expectant parents featuring a directory of third-party retailers and entities offering products or services related to pregnancy and parenting" and "Hosting an online website for new or expectant parents featuring a directory of third-party retailers and entities

offering products or services related to pregnancy and parenting.”¹

Registration was initially refused pursuant to Section 2(e)(1) of the Trademark Act of 1946, 15 U.S.C. § 1052(e)(1), on the ground that the mark is merely descriptive of applicant's services. In response, applicant amended its application to include a claim of acquired distinctiveness under Section 2(f) based on substantially exclusive and continuous use in commerce for at least 5 years. Applicant also submitted a disclaimer of the term “guide.” The examining attorney then issued a new refusal on the ground that the mark is generic for applicant's services. Applicant responded arguing against the refusal and withdrawing the disclaimer of “guide.” The examining attorney issued a final refusal to register the mark on the ground that the mark is generic for applicant's services under Section 2(e)(1). Applicant appealed and the case is fully briefed.

The only issue on appeal is whether the mark is generic. Descriptiveness is not an issue in this case, where applicant has already acknowledged, by seeking

¹ Application Serial No. 77779284, filed July 13, 2009 under Section 1(a) of the Trademark Act, alleging a date of first use of the mark in commerce and anywhere as of December 18, 2002.

registration under Section 2(f), that its mark is not inherently distinctive. Nor is the sufficiency of applicant's Section 2(f) showing an issue in this case. The Examining Attorney failed to address the sufficiency of the 2(f) evidence in this case, effectively conceding that, assuming the mark is not generic, applicant's claim of at least 5 years substantially exclusive and continuous use is sufficient to establish that the mark has acquired distinctiveness. To the extent that the examining attorney attempted to refuse registration on this basis for the first time in her appeal brief, the refusal is untimely and cannot be considered.²

Preliminary Evidentiary Issue

Before turning to the substantive grounds for refusal, we note that applicant submitted several exhibits with its briefs. These exhibits consist of evidence regarding priority of use, including printouts from Network Solutions, the internet domain name registrar, as well as third party registrations and applications for marks including the terms "baby" and/or "guide." Most of these exhibits were not previously submitted during prosecution

²As stated in TMEP section 1209.02(b), "[i]f the examining attorney fails to separately address the sufficiency of the § 2(f) evidence, this may be treated as a concession that the evidence would be sufficient to establish distinctiveness if the mark is ultimately found not to be generic."

of the involved applications. The Examining Attorney did not object to the evidence and she discussed the third-party registrations and applications in her brief. She did not discuss the evidence regarding priority of use.

Trademark Rule 2.142(d) addresses the submission of evidence submitted after an appeal is filed: "The record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the Examining Attorney after the appeal is filed." Evidence submitted after appeal, without a granted request to suspend and remand for additional evidence, *see* TBMP § 1207.02 (3d ed. 2011), may be considered by the Board, despite its untimeliness, if the nonoffering party (1) does not object to the new evidence, and (2) discusses the new evidence or otherwise affirmatively treats it as being of record. TBMP § 1207.03. The Examining Attorney did not object to the late-filed evidence and discussed the third-party registrations and applications or otherwise treated them as being of record. Accordingly, the third-party registrations and applications submitted with the applicant's brief have been considered. The evidence

regarding priority of use, however, was not discussed by the examining attorney and we have not considered it.³

Genericness Refusal

Whether a particular term is generic, and therefore cannot be a trademark or service mark, is a question of fact. *In re Hotels.com LP*, 573 F.3d 1300, 91 USPQ2d 1532, 1533 (Fed. Cir. 2009). When a proposed mark is refused registration as generic, the examining attorney has the burden of proving genericness by "clear evidence" thereof. *Id.* See also *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987); and *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1111 (Fed. Cir. 1987).

The critical issue is to determine whether the record shows that members of the relevant public primarily use or understand the term sought to be registered to refer to the category or class of goods or services in question.

H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986); and *In re Women's Publishing Co. Inc.*, 23 USPQ2d 1876, 1877 (TTAB 1992). Making this determination "involves a two-step inquiry: First, what is the genus of goods or services at

³We further note, priority of use is not relevant in the context of an ex parte proceeding.

issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?" *Marvin Ginn*, 228 USPQ at 530. Evidence of the public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers and other publications. See *Merrill Lynch*, 4 USPQ2d at 1143, and *In re Northland Aluminum Prods, Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985).

1. Definition of the Genus of the Goods and Services

We begin by determining the appropriate genus of the goods and services at issue in this case. The genus proposed by the examining attorney, i.e., a "baby guide," is overbroad because it does not include any information regarding the subject of the guides and website as recited in the application. The genus proposed by applicant, "printed guides and websites for new or expectant parents featuring products or services related to pregnancy and parenting," is better but omits the language indicating that the guides and website provide "a directory of third-party retailers and entities" of the identified products and services.

Rather, we find that the genus is appropriately defined by the description of goods and services recited in the application, as follows:

Printed guides for new or expectant parents featuring a directory of third-party retailers and entities offering products or services related to pregnancy and parenting, and

Hosting an online website for new or expectant parents featuring a directory of third-party retailers and entities offering products or services related to pregnancy and parenting.

Magic Wand Inc. v. RDB Inc., 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) (“[A] proper genericness inquiry focuses on the description of [goods or] services set forth the in the [application or] certificate of registration.”).

The record supports the appropriateness of this genus. Applicant’s website specimen includes the wording “WELCOME TO THE NEW BABY GUIDE WEBSITE, A COMPLIMENT [sic] TO THE BABY GUIDE MAGAZINE, YOUR GUIDE FOR EVERYTHING BABY IN SOUTHERN NEW ENGLAND.” The website also includes links to a “RESOURCE DIRECTORY” and a “SHOP” page, as well as links to recommended retailers selling items intended to interest new parents. Similarly, the specimen for the printed guides includes a reference to a “coupon section” presumably offering discount coupons for baby items. Accordingly, we find that the description of goods and

services recited in the application is the appropriate genus.

2. Primary Significance to the Relevant Public

Next, we must determine whether the primary significance of applicant's BABY GUIDE mark is understood by the relevant public primarily to refer to that genus of goods and services. *Marvin Ginn*, 228 USPQ at 530. The "relevant public" for goods sold in the marketplace is limited to actual or potential purchasers of the goods and services. *Magic Wand*, 19 USPQ2d at 1552-53.

Neither the examining attorney nor applicant has defined the relevant public. Based on the evidence in the record, as well as the identification of goods and services, the relevant public consists of new or expectant parents seeking products or services related to pregnancy and parenting.

We now turn to the evidence of record to determine the relevant public's understanding of "BABY GUIDE" as used with the applied-for services.

The examining attorney submitted the following dictionary definitions of "baby" and "guide" from the Merriam-Webster online dictionary:

Baby: 1 a (1): an extremely young child; especially: infant; and

Guide: 1 a: one that leads or directs another's way, b: a person who exhibits and explains points of interest, c: **something that provides a person with guiding information** (emphasis added).

Examining Attorney's Office action of May 5, 2010.

Based on the dictionary definitions which establish that a "guide" is "something that provides a person with guiding information" and a "baby" is "an extremely young child" or an "infant," BABY GUIDE merely refers to something that provides a person with guiding information about babies. *Gould*, 5 USPQ2d at 1112 (dictionary definitions support genericness refusal); *In re Wm B. Coleman Co.*, 93 USPQ2d 2019, 2025 (TTAB 2010) (space between generic terms does not disqualify proposed mark from *Gould* analysis).

The examining attorney also submitted evidence from a number of third-party web sites showing use of the term "baby guide" in connection with online and printed guides. Below is a representative sampling:

- **greenbabyguide.com** (a web site entitled The Green Baby Guide providing information and links for new parents including "down to earth ways to save time, money, and the planet");
- **The Eco-nomical Baby Guide** (a companion book to the Green Baby Guide web site);
- **utahbabyguide.com** (featuring the *Utah Baby Guide*, a regional digital "free magazine for new and expecting parents");

- **littlebabyguide.com** (a web site with baby information and recommendations on baby accessories via articles such as a "baby car seat guide" and a "baby diaper guide");
- **ibabyguide.com** (a web site featuring a page entitled "Baby Guide" with a "comprehensive baby shopping guide to help you make a buying decision on baby needs and infant products");
- **organicbabyguide.net** (a web site offering "Everything Organic For You and Your Baby" including links to purchase organic baby products such as clothing and cribs);
- **thethriftycouple.com** (a web site featuring ways for consumers to save money and including a page entitled "Baby Guide" featuring ways to save money while raising children);
- **parenthood.com** (an "online parenting resource" including a page entitled "Baby Guide - Spotlight Resources" featuring a listing of baby furniture retailers);
- **littlebabebigcity.com** (featuring a link to the "New York City Baby Guide" and the "Seattle Baby Guide" which both provide information on local baby stores, pediatricians, kid-friendly restaurants, and "all things hip and baby in your hood");
- **northernvirginiamag.com** (a regional online magazine including a "baby guide" web page featuring a directory of "child-friendly eateries");
- **gvparent.com** (a regional online magazine featuring the "Rochester Baby Guide 2010" for "new or expecting parents, grandparents, family members or friends" and providing links to baby product retailers and "a wealth of information from national and local experts");
- **tulasakids.com** (a web page announcing a "2010 Baby Guide" claiming to be "all things pregnancy and baby related");
- **creativechild.com** (a web site "helping parents nurture their child's creativity" including a "Baby Guide" featuring an extensive listing of baby product retailers);

- **perfectbabyguide.com** (a web site with links to information on baby health, baby food, baby safety, baby products); and
- **nashvilleparent.com** (featuring a page entitled "The Baby Guide" providing information on babies, including "Hot New Products").

The examining attorney argues that these examples demonstrate that "the wording 'baby guide' is used to identify printed or online publications that contain lists or directories of goods and services for babies" and further, that "the public has had significant exposure to the wording 'baby guide' and would understand 'baby guide' as the name for the applicant's type of goods and services, and not as a trademark for them." Examining Attorney's Br. at 4-5.

In addition to the dictionary definitions, this internet evidence amply demonstrates that the term "baby guide" is commonly used, not only by consumers but also by competitors, to refer to printed or electronic publications or directories containing information for new and expectant parents about babies and products for babies. Some of the web sites such as the ibabyguide.com web site or the creativechild.com web site simply provide a web page entitled "baby guide" with baby information and a directory of retailers offering baby products. Other web sites such as the "Utah Baby Guide," perfectbabyguide.com, or the

"Green Baby Guide" offer more specialized baby guides by focusing on geographic regions or particular lifestyles but these uses nevertheless demonstrate that "baby guide" refers to the same genus of goods and services provided by applicant. In short, most, if not all of these "baby guides" provide precisely the same type of articles about babies and directories of baby products for expectant parents as applicant via its printed guides and web site.

Applicant primarily argues that all of these uses by third parties were "long after the Applicant began the usage of the mark BABY GUIDE in the marketplace in 2002." Applicant's Br. at 12. This argument is unavailing. First, in this case, the dictionary definitions alone are sufficient to find the term generic. *Gould*, 5 USPQ2d at 1112. However, even assuming, arguendo, that the mark was at one time entitled to registration, it is well settled that registrability must be determined at the time registration is sought and a term that was once suggestive may later become merely descriptive or even generic. See *In re Thunderbird Prods. Corp.*, 406 F.2d 1389, 160 USPQ 730, 732 (CCPA 1969). Thus, the issue before us is whether the consuming public now regards "BABY GUIDE" as merely referring to the genus of goods and services encompassed by applicant's identification. We find that it does.

Applicant next argues that "BABY GUIDE" is a double entendre because "while the terms separately identify a baby and a guide, when [] considered in connection with these goods, the term does not suggest products which may only be used by a baby." Applicant's Br. at 18. We disagree. The evidence of record is both clear and substantial and demonstrates that the term BABY GUIDE has a commonly understood meaning to the relevant public as referring to guides for expectant parents including information on purchasing baby products. There is simply no support in the record for a different meaning or double entendre.

Applicant also argues that a number of third-party marks including the terms BABY and/or GUIDE have registered or been approved for publication and, therefore, "it follows that the mark BABY GUIDE should also be registered." Applicant's Br. at 19.

As an initial matter, third-party registrations are not conclusive on the issue of registrability. Each case must stand on its own merits, and a mark that is merely descriptive or generic must not be registered on the Principal Register simply because other marks with common terms appear on the register. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("Even

if some prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the board or this court.").

Moreover, each of the marks cited by applicant can be distinguished from applicant's mark in some critical way. For example, the mark APARTMENT GUIDE is registered for significantly different services as compared to applicant's goods and services. Similarly, the other marks have no evidentiary value as they are either cancelled registrations, pending applications, or disclaim the term "baby guide" in its entirety. See *Action Temp. Servs. Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) ("[A] cancelled registration does not provide constructive notice of anything"); and *Interpayment Servs. Ltd. v. Docters & Thiede*, 66 USPQ2d 1463 (TTAB 2003) (applications show only that they have been filed).

We have considered the remainder of applicant's arguments but find them unpersuasive. Based upon consideration of all the evidence of record, we conclude that BABY GUIDE is generic for the identified goods and services.

Decision: The refusal of registration is affirmed.