

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing: October 28, 2014

Mailed: November 20, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re PC Laptops LLC

Serial No. 77780768 and 77780823

Craig J. Madson of Madson IP, P.C., for PC Laptops LLC.

Kyle Christopher Peete, Trademark Examining Attorney, Law Office 112
(Angela Wilson, Managing Attorney).

Before Cataldo, Ritchie, and Lykos, Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

On July 14, 2009, PC Laptops LLC (“Applicant”) filed an application to register PC LAPTOPS¹ in standard character format on the Principal Register for, as amended,² “computers, laptops, and portable computers” in International Class 9. After Applicant added a claim of acquired

¹ Application Serial No. 77780768, filed under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a), alleging January 1, 1998 as the date of first use and first use in commerce.

² As part of the prosecution, Applicant requested to divide out goods that were not subject to the refusal. Those goods were made subject to Application Serial No. 77982696, which issued on July 10, 2012 as Registration No. 4169656 with a claim of acquired distinctiveness on the Principal Register.

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distinctiveness in the alternative under Section 2(f), 15 U.S.C. § 1052(f), in response to an Office Action refusing registration on the ground of mere descriptiveness, the Examining Attorney made final a refusal on the ground that the mark was generic pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), and that in the alternative, that Applicant's mark is merely descriptive and the evidence of acquired distinctiveness is insufficient. This appeal followed. The Examining Attorney acknowledged that the final Office Action was premature and requested remand. Further Office Actions followed and when the refusal was again made final, the appeal was resumed.

On July 14, 2009, Applicant also filed an application to register PC LAPTOPS³ in standard character format on the Principal Register for "retail store services in the field of computer hardware and software," in International Class 42. This application shared a similar prosecution history to the other, and when the Examining Attorney requested remand, he also requested consolidation of the cases. In both cases, the issue before us on appeal pursuant to the final refusal of the Examining Attorney is whether the mark in each application is generic and if merely descriptive whether Applicant has submitted sufficient evidence of acquired distinctiveness.

³ Application Serial No. 77780823, filed under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a), alleging January 1, 1998 as the date of first use and first use in commerce.

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Applicant and the Examining Attorney have filed briefs in both cases, and Applicant has filed a reply brief for both. On October 28, 2014, the Board held a hearing at the request of Applicant. The hearing was presided over by this panel and included a discussion of both applications. Since both applications deal with common questions of law and fact, we consolidate the appeals and issue one decision. TBMP § 1214 (June 2014). Where appropriate, we have taken into account relevant factual differences in the cases.

GENERICNESS REFUSAL

We first address the question of genericness. Generic terms are terms that the relevant purchasing public understands primarily as the common or class name for the goods and/or services. *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986); *In re Women's Publishing Co. Inc.*, 23 USPQ2d 1876, 1877 (TTAB 1992). 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.” *See In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987).

When a proposed mark is refused registration as generic, the Examining Attorney has the burden of proving genericness by “clear evidence.” *Merrill Lynch*, 4 USPQ2d at 1143; *see also In re Gould Paper Corp.*, 834 F.2d 1017, 5

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USPQ2d 1110, 1111 (Fed. Cir. 1987); *In re Wm. B. Coleman Co.*, 93 USPQ2d 2019, 2021 (TTAB 2010). 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. *Ginn*, 228 USPQ at 530. Making this determination “involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?” *Id.* 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. *Merrill Lynch*, 4 USPQ2d at 1143, *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985).

The Examining Attorney, therefore, must "analyze the term in relation to the services recited in the application, the context in which it is used and the possible significance it would have to the recipient of the services." *Ginn*, 228 USPQ at 530.

A. The genus of goods and services at issue.

We find that the category of goods and services here is adequately defined by Applicant’s identification of goods in the one application, “computers, laptops, and portable computers” and services in the other, “retail store services in the field of computer hardware and software.” *See Magic Wand*

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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 in the [application or] certificate of registration.”).

B. The relevant public.

Next we consider whether the relevant public understands the designation primarily to refer to that class of goods and services. The relevant public for a genericness determination is the purchasing or consuming public for the identified goods and services. *Magic Wand*, 19 USPQ2d at 1553. Because there are no restrictions or limitations to the channels of trade or classes of consumers in Applicant’s identification of goods and services, the relevant consuming public comprises ordinary consumers who purchase at retail stores computer hardware and software and who use computers, laptops, and portable computers.

C. Public perception

To determine the public perception of the term “PC LAPTOPS” as it applies to the identified goods and services, we first must decide how to analyze the term. In cases where the proposed mark is a compound term (in other words a combination of two or more terms), the evidence of record must show that each of the constituent words is generic, and that each word retains its generic meaning when combined such that the composite formed is generic and does not create a different, non-generic meaning. *See In re Gould Paper Corp.*, 5 USPQ2d at 1111-12; *see also Frito-Lay North America, Inc. v.*

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Princeton Vanguard, LLC, 109 USPQ2d 1949, 1952 (TTAB 2014). By contrast, “[W]here the proposed mark is a phrase (such as ‘Society for Reproductive Medicine’), the board ‘cannot simply cite definitions and generic uses of the constituent terms of a mark’; it must conduct an inquiry into ‘the meaning of the disputed phrase as a whole.’” *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001) (citing *In re The Am. Fertility Soc’y*, 188 F.3d 1341, 1347, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999)); see also *In re Country Music Assc’n, Inc.*, 100 USPQ2d 1824, 1828 (TTAB 2011). Applicant argues that “PC LAPTOPS” does not have a combined dictionary definition, but rather is a phrase comprised of two adjectives. (Reply at 3). Thus, we must decide whether the term “PC LAPTOPS,” when applied to the identified goods and services, is a unified term having a meaning beyond the sum of its parts as argued by Applicant, or rather maintains the meaning of its constituent terms as argued by the Examining Attorney.

In analyzing the term, we find no additional meaning added to “PC LAPTOPS” in relation to “computers, laptops, and portable computers” in the one application, or to “retail store services in the field of computer hardware and software” in the other, when the individual terms are combined. As noted, compound words that do not add new meaning may be analyzed by their constituent terms. See *In re 1800Mattress.com IP LLC*, 586 F.3d 1359, 92 USPQ2d 1682, 1684 (Fed. Cir. 2009) (citing *In re Am. Fertility Soc’y*, 188

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F.3d 1341, 1347, 51 USPQ2d 1832 (Fed. Cir. 1999) (“[I]f the compound word would plainly have no different meaning from its constituent words, and dictionaries, or other evidentiary sources, establish the meaning of those words to be generic, then the compound word too has been proved generic. No additional proof of the genericness of the compound word is required.”). We therefore analyze the term as a compound term, using the ordinary grammatical construction.

In undertaking our analysis, we keep in mind that while we look to the “primary significance” of the term, we look to the applied-for mark in relation to the identified goods and services, and we note that all possible generic names for a product must reside in the public domain. *See* J. Thomas McCarthy, 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 12:9 (4th ed. 2013) (“Any product may have many generic designations. Any one of those is incapable of trademark significance.”).

1. Dictionary Definitions:

Applicant and the Examining Attorney submitted the following definitions of the term “PC”:

From Applicant:

PC: 1. Peace Corp 2. Politically correct;
MSN Encarta; <http://encarta.msn.com> (2009).

From the Examining Attorney:

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PC: 1. COMPUT; same as personal computer 2. Compatible computer: a computer compatible with IBM™ personal computers and DOS [Abbreviation of personal computer]

MSN Encarta; *http://encarta.msn.com* (2009).

We take judicial notice of the dictionary definition for “laptop”:⁴

Laptop: n. A portable computer with a display screen hinged to a keyboard, small enough to use on one’s lap.

The American Heritage Dictionary of the English Language (5th Ed. 2014) *Ahdictionary.com*.

2. Use by media

The Examining Attorney submitted evidence of media references to “PC LAPTOPS” to name or identify “computers, laptops, or portable computers,” and “retail store services in the field of computer hardware and software,” including the following:

Should I buy a mac or PC laptop? Which is actually a better machine? Attached to June 7, 2010 Office Action, p. 19. *Yedda.com*.

A modest proposal: Détente between Mac and PC laptop fans: In the spirit of the holiday season, we have a proposal for peace between PC and Mac laptop users – or at least finding some middle ground . . . Attached to June 7, 2010 Office Action, p. 19. *Cnet.com*.

Before You Select a Laptop PC: Many systems are even now being marketed as replacements for desktop systems but few can perform at the same level as a desktop system particularly when it comes to graphics. This guide will help you to look at some of the key items you want to look at before your next PC

⁴ See, e.g., *In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.23 (TTAB 2013) (Board may take judicial notice of online dictionaries that exist in printed format or have regular fixed editions).

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laptop system. Attached to June 7, 2010 Office Action, p.2.
About.com.

Laptop Buyer's Guide: Thinking of buying a laptop? Make sure you know what you're getting. Below, you'll find our recommendations to keep in mind when buying a PC laptop. Click on any of the main components for a detailed explanation. Also, check our PC Laptop Buyer FAQ and the Lowest Laptop Prices. Attached to March 8, 2011 Denial of Request for Reconsideration, p. 2. *Geek.com.*

Retina Macbook vs. PC Laptops: Battle Begins: Apple took a big leap ahead of competing PC makers Monday introducing a new 15-inch MacBook Pro with Retina display that borrows from the design concepts of the MacBook Air. . . . That said, can Apple's new Retina MacBook Pro rain on the PC laptop or Intel's Ultrabook parade? Or will Apple, once again, inspire another flood of PC clones . . . Attached to September 17, 2012 Request for Remand, at p. 2. *PCworld.com.*

USA Today: 8/16/12 When it's best to hold off buying the latest gadget: if you're determined to own cutting edge tech gadgets, it can drive you to the poor house. Every year, there is a flood of new "must have" Apple gadgets and Macs, Android smartphones and tablets and a plethora of PC laptops and desktops. Attached to September 17, 2012 Request for Remand, at p. 19.
Usatoday.com.

Barron's: Tech Trader Daily: August 29, 2012: Ultrabooks Up Against High Prices, Raft of Alternatives, Says Sterne Agee: Sterne Agee semiconductor analyst Vijay Rakesh today offers his thoughts on the state of play, if you will, for the 'ultrabook' laptop category of light and thin notebook computers that Intel (INTC) has been promoting heavily, and that are in some senses very similar to Apple's (AAPL) successful 'Macbook Air' laptops. Rakesh finds that overall, ultrabooks are still limited as a percentage of all PC laptops, and they are still relatively high in price. Attached to September 17, 2012 Request for Remand, at p. 25. <http://blogs.barrons.com/techtraderdaily>.

Best Tools to Stop Gadget Thieves: Tracking Programs: Just as Lojack can track stolen cars, there are tracking programs for laptops. In fact, Lojack makes a tracking program for laptops, as does a company called GadgetTrak. These services cost about

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\$40 a year. But if you want the budget option, Find My iPhone offers free tracking services for iPhones, iPods, iPads, Macs and PC laptops. Lookout provides a free tracking program for Android devices. Attached to September 17, 2012 Request for Remand, at p. 42. <http://news.yahoo.com>.

IT News Online: Safeguard Back-to-school Electronics with Waterfield's Protective, Stylish Cases: "Laptops and iPads are integral gear for students headed back to school. Running around campus, they need a reliable way to carry and protect their laptop, iPad and other too-expensive-to-damage electronics," noted Waterfield Designs owner, Gary Waterfield. "Waterfield offers options so that students can find a case to meet their functionality and protection needs and still match their own personal style." Custom-sizing available any Mac or PC laptop on the market. Attached to September 17, 2012 Request for Remand, at p. 55. [Itnewsonline.com](http://itnewsonline.com).

3. Use by public

The Examining Attorney further submitted evidence of references by the general public for "PC LAPTOPS" to name or identify "computers, laptops, or portable computers," and "retail store services in the field of computer hardware and software," including the following:

Mac Repairs/iPad LCD Repair: Need Mac repair or Ipad LCD repair service? Go online now. . . Mac Laptop Repairs. PC Laptop Repairs. iPhone Repairs & Parts. iPod Repairs & Parts . . . Attached to June 7, 2010 Office Action, p. 20. Techrestore.com.

The Mac Versus PC Debate Has Never Been Clearer: Windows? The hardware is rather irrelevant considering I can run Windows on my MAC. I did buy a PC laptop for one reason, and one reason only . . . Price . . . Attached to June 7, 2010 Office Action, p. 20. Techcrunch.com.

Laptop buying advice forum: 17" PC Laptop: Does anyone know of a 17" PC laptop that has a centered touchpad? I know the

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macbook pro has it centered, but I have a bunch of expensive PC software, so I have to stick w/ a PC. Attached to March 8, 2011 Denial of Request for Reconsideration, p. 12. *Cnet.com*.

Southwestern Medical Center: Library News: New PC laptops available for South Campus (main) Library check-out: Posted on Aug 31, 2012: The Library has acquired a new group of PC laptops for in-library checkout at the South Campus (main) Library. All new laptops are equipped with: Windows 7 and Microsoft Office; CD-Rom/DVD Drive; Faster Processors than previous models. Attached to September 17, 2012 Request for Remand, p. 17.

<http://libraryblogs.utsouthwestern.edu>.

Teacher acceptance: Even more important than a school's IT department feeling comfortable about the iPad is the question of how comfortable teachers are with the device. Teachers need to feel comfortable planning lessons, delivering content, and designing class projects around whatever device students are using – Macbooks, PC laptops, iPads, or other tablets. Attached to September 17, 2012 Request for Remand, p. 45.

Cultofmac.com.

4. Policing by Applicant

Applicant argues, in response to the evidence noted above, that it polices unlicensed third-party use of its mark “PC LAPTOPS” when used in a generic or descriptive manner to name or identify “computers, laptops, or portable computers,” and “retail store services in the field of computer hardware and software.” With its September 30, 2013 Response to Office Action, Applicant submitted evidence that it had sent out a letter protesting use of the term “PC LAPTOPS” as shown in the evidence submitted by the Examining Attorney. Applicant noted: “For example, Attachment 1 includes an exemplary response sent to the editors of publications where Applicant’s

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mark appears to have been used incorrectly. Attachment 1 includes a copy of a letter sent to the Editor-in-Chief of CNET dated August 9, 2013 and an email response from a CBS Designated Agent dated August 29, 2013.” The article referred to by Applicant includes the following usage of the term “PC LAPTOPS”:

TechCrunch, August 19, 2012

By Alex Williams Disney Adds A Bit of Nonsensical Anti-Open Source FUD to Kid’s Sitcom: The intent is what’s worst about this. It raises suspicions with kids about open source even though the premise for the question is absurd. If it is open-source then what are the chances it would have a hidden virus? Of course, the geeky kid is using a PC laptop, arguably loaded with Microsoft software. Hmm – safe, huh?

Techcrunch.com

As stated in the Response to Office Action, Applicant included with its Response its letter protesting the use. However, the response received did not acknowledge that the usage had been incorrect. Quite to the contrary, the response, from counsel for AOL, states as follows:

Rather, the term ‘PC laptop’ is used in this context to identify a common type of product.

5. Competitive Use

Applicant further argues that none of the evidence submitted by the Examining Attorney includes a generic use by a competitor but only, if at all, by the media and by the public. Accordingly, Applicant argues, there is no competitive need to use the term “PC LAPTOPS” for “computers, laptops, or

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portable computers,” and “retail store services in the field of computer hardware and software.”

Discussion

Based on the evidence properly before us, we find that the Examining Attorney has met his burden of showing that “PC LAPTOPS,” in the two applications, would be understood by the relevant public to refer to “computers, laptops, or portable computers,” or to “retail store services in the field of computer hardware and software,” respectively.

Although there is no dictionary definition for “PC LAPTOPS” together, that is by no means dispositive, where both are found to be generic in a combined term. *See In re Gould Paper Corp.*, 5 USPQ2d at 1111 (SCREENWIPE held generic even though there was no dictionary definition of the compound term); *Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 109 USPQ2d at 1959 (PRETZEL CRISPS found generic for “pretzel crackers” although no dictionary definition exists for the combined term); *In re Dairimetics, Ltd.*, 169 USPQ 572, 573 (TTAB 1971) (ROSE MILK refused registration on the Supplemental Register even though there was no dictionary definition of ROSE MILK). It is clear from the record that both the media and the public understand the term “PC LAPTOPS” to refer to a type of laptop computer. As discussed further below, that the term “PC” may have other definitions in other contexts is inapposite. *See In re Petroglyph Games*

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Inc., 91 USPQ2d 1332 (TTAB 2009). Regarding Applicant's arguments of policing, we find them to be insufficient to overcome the strong evidence that the public understands the term "PC LAPTOPS" to refer to the types of goods and services in Applicant's applications. In particular, there are numerous instances of third parties, both the general public as well as the media, using the term PC LAPTOPS to refer to the goods or services for which applicant seeks registration. It is clear from this evidence that the relevant public understands the term PC LAPTOPS to be a generic term for these goods and services. *See Sheetz of Del., Inc. v. Doctor's Assocs. Inc.*, 108 USPQ2d 1341 (TTAB 2013) (finding FOOTLONG for "sandwiches, excluding hot dogs" generic based on dictionary definitions, third-party uses and declarations, despite survey report, definitions, and declarations from applicant); *In re Hotels.com*, 87 USPQ2d 1100 (TTAB 2008), *aff'd*, 573 F.3d. 1300, 91 USPQ2d 1532 (Fed. Cir. 2009) (finding Hotels.com generic for various agency and reservation booking services based on dictionary definitions and third-party uses, despite declarations and survey report by applicant to the contrary). Finally, we are not concerned that the record does not contain instances of direct competitors using the term in a generic fashion since the relevant inquiry is as to the understanding of the public. *Ginn*, 228 USPQ at 530.

We note that a term that is generic for goods is descriptive of retail store services featuring those goods, when the goods are not a significant item typically sold in the type of store in question. *In re Pencils Inc.*, 9 USPQ2d

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1410 (TTAB 1988) (PENCILS held merely descriptive of office supply store services). However, where the matter sought to be registered identifies the primary articles of a store or distributorship service, the term is considered generic. *See, e.g., In re Tires, Tires, Tires, Inc.*, 94 USPQ2d 1153 (TTAB 2009) (TIRES TIRES TIRES generic for retail tire store services); *In re Lens.com, Inc.*, 83 USPQ2d 1444 (TTAB 2007) (LENS generic for “retail store services featuring contact eyewear products rendered via a global computer network”); *In re Eddie Z’s Blinds & Drapery, Inc.*, 74 USPQ2d 1037 (TTAB 2005) (BLINDSANDDRAPERY.COM generic for retail store services featuring blinds, draperies, and other wall coverings, conducted via the Internet); *In re Candy Bouquet Int’l, Inc.*, 73 USPQ2d 1883 (TTAB 2004) (CANDY BOUQUET generic for “retail, mail, and computer order services in the field of gift packages of candy”); *In re A La Vieille Russie, Inc.*, 60 USPQ2d 1895 (TTAB 2001) (RUSSIANART generic for dealership services in the field of fine art, antiques, furniture, and jewelry); *In re Log Cabin Homes Ltd.*, 52 USPQ2d 1206 (TTAB 1999) (LOG CABIN HOMES generic for retail outlets selling kits for building log homes); *In re Bonni Keller Collections Ltd.*, 6 USPQ2d 1224 (TTAB 1987) (LA LINGERIE generic for retail stores specializing in the sale of lingerie); *In re Wickerware, Inc.*, 227 USPQ 970 (TTAB 1985) (WICKERWARE generic for mail order and distributorship services in the field of products made of wicker); *In re Half Price Books, Records, Magazines, Inc.*, 225 USPQ 219 (TTAB 1984) (HALF PRICE BOOKS

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RECORDS MAGAZINES generic for retail book and record store services).

Because we have found the term PC LAPTOPS to be generic for the goods in the application, it is likewise generic for the services. In addition, the record provides clear evidence of both.

We note that in finding the term “PC LAPTOPS” as a whole to be generic, we have analyzed it as a combined term, but were we to analyze it as a phrase, on this record, our conclusion would be the same, as the words strung together as a unified phrase also create a meaning that we find to be understood by the relevant public as generic for the applied-for goods and services. In this case, the evidence of record includes uses of PC LAPTOPS as a generic term for the goods and services recited in the involved applications. As a result, even if we analyze the term as a phrase and do not consider the record evidence of the genericness of the constituent terms “PC” and “LAPTOP,” per *In re The Am. Fertility Soc’y*, 51 USPQ2d at 1836, we find that the Examining Attorney has met his burden of showing that the phrase PC LAPTOPS is a generic term as applied to Applicant’s goods and services. See *In re Wm. B. Coleman Co.*, 93 USPQ2d at 2025.

MERE DESCRIPTIVENESS AND ACQUIRED DISTINCTIVENESS

Although we have found the applied-for mark to be generic, we consider, in the alternative, the issue of mere descriptiveness and Applicant’s Section 2(f) claim of acquired distinctiveness. Applicant makes this claim in the

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alternative, asserting that in fact the mark is an inherently distinctive “double entendre.” We consider first this argument.

Applicant argues that the term “PC LAPTOPS” may be understood as a double entendre since the term “PC” is defined not only as “personal computer” but also as “politically correct.” Applicant states: “The abbreviation ‘PC’ carries at least two well-known meanings, namely ‘Politically Correct’ and ‘Personal Computer.’” (Appl’s brief at 19). Applicant included with its December 3, 2010 Request for Reconsideration the following definition of “politically correct”:

Politically correct: deliberately avoiding offense; relating to or supporting the use of language or conduct that deliberately avoids giving offense, e.g., on the basis of ethnic origin or sexual orientation.

http://encarta.msn.com (2009)

Our case law dictates that a double entendre must be recognizable from the mark itself, in relation to the goods or services in the identification. *See In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1287 (TTAB 2006) (finding GALA ROUGE for “wines” is not unitary, and has no pre-existing well-recognized significance with regard to applied-for goods); *In re The Place, Inc.*, 76 USPQ2d 1467, 1470 (TTAB 2005) (finding THE GREATEST BAR for “restaurant and bar services” is not a double entendre; “A mark is thus deemed to be a double entendre only if both meanings are readily apparent from the mark itself.” [emphasis in original]); *In re Ethnic Home Lifestyles Corp.*, 70 USPQ2d 1156, 1158-59 (TTAB 2003) (finding ETHNIC ACCENTS

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for TV programs in the field of home décor merely descriptive and noting, “To have a double entendre, both meanings must be readily apparent, but the meaning suggested by applicant is not apparent upon seeing the mark in connection with the services.”); *In re Polo Int’l Inc.* 51 USPQ2d 1061, 1063 (TTAB 1999) (finding in context DOC in DOC-CONTROL would be understood to refer to the “documents” managed by applicant’s software, not “doctor” as shown by dictionary definition); *cf. In re Grand Metropolitan Foodservice Inc.*, 30 USPQ2d 1974, 1976 (TTAB 1994) (finding MUFFUNS, and design as a double entendre and not merely descriptive of baked mini muffins), *citing In re Colonial Stores, Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (finding SUGAR & SPICE not merely descriptive for various bakery products).

Despite Applicant’s argument, there is nothing in the record that would lead us to believe that consumers would associate the concept of “political correctness” with computers or the sale thereof. Accordingly, we cannot imagine that anyone would expect that the applied-for mark “PC LAPTOPS” for “computers, laptops, or portable computers,” and “retail store services in the field of computer hardware and software” refers to “Politically Correct Laptops.” Rather, we find it quite clear that consumers will understand it immediately as “Personal Computer Laptops,” which we have found to be generic for Applicant’s goods and services and therefore not to be inherently distinctive.

Turning to Applicant's Section 2(f) claim, it is Applicant's burden to prove acquired distinctiveness of a mark that is not inherently distinctive. *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988); *In re Cabot Corp.*, 15 USPQ2d 1224, 1229 (TTAB 1990); *In re Hollywood Brands, Inc.*, 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954) ("[T]here is no doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant"). Evidence of acquired distinctiveness can include the length of use of the mark, advertising expenditures, sales, survey evidence, and affidavits asserting source-indicating recognition. It is the Examining Attorney's position that "PC LAPTOPS" is so highly descriptive that Applicant's evidence is not sufficient to establish acquired distinctiveness. Based on the evidence of record, we agree with the Examining Attorney's determination that "PC LAPTOPS," when used in connection with "computers, laptops, or portable computers," and "retail store services in the field of computer hardware and software," is at least highly descriptive, and that Applicant has a heavier burden in showing acquired distinctiveness.

Applicant argues that by its use of "PC LAPTOPS" in connection with "computers, laptops, or portable computers," and "retail store services in the field of computer hardware and software," the term has acquired distinctiveness through length of time of substantially exclusive use,

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extensive advertising, consumer recognition and recognition by the industry and media.

Applicant submitted the declaration of Dan Young, its CEO and President, dated April 12, 2010. The declaration attests that Applicant or its predecessor in interest has used the mark “PC LAPTOPS” in commerce “substantially exclusively and continuously” since “at least as early as 1997.” (Young decl. at para. 4 and 6). The declaration further attests to advertising under the mark, specifically consisting of television ads “extensively over at least the last eight (8) years” consisting of over “160 television advertisements,” “and “radio advertisements extensively for at least the last ten (10) years” consisting of advertisements airing on “as many as sixteen (16) radio stations, typically one to two thousand times per month.” *Id.* at para. 5. Applicant did not, however, provide any expenditures for the advertising, nor any context for comparison with the industry. Neither did Applicant provide any sales volume or context of such volume in the industry.

Applicant also provided with its evidence a survey undertaken by Citadel Broadcasting Company of the Salt Lake City Area in April 2009. The survey is labeled “Retail Consumer Survey.” It includes several pages of questions and answers, including the following:



BRAND THE BRAIN
Share of Mind = Share of Business

ii

Salt Lake City Area - April 2009

Branding Habits

Of the businesses that came to mind first, how likely would you be to use those businesses if you wanted or needed to make a purchase?

Likely:	98.1%
Not Likely:	1.9%

If you saw a large ad in the newspaper or yellow pages of a business you have never heard of, and a smaller ad of a business you have heard of, which one would you be more likely to call?

Business I have heard of with small ad:	69.9%
Business I have not heard of with large ad:	6.2%
Don't know:	15.6%
Don't use yellow pages:	9.2%

When you need a phone number or more information on a business are you more likely to use a search engine on line or the yellow pages?

Search on line	75.6%
Yellow Pages	24.4%

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Branding Habits (cont)

When you last used the yellow pages, did you use them to decide which business to call, or to look up a number of a business you already had in mind?

Already had business in mind:	66.7%
To find a business:	22.2%
Don't know:	1.9%
Don't use yellow pages:	9.2%

In the past year, how many times did you use the yellow pages?

0 - 5 times	48.2%
6 - 10 times	25.3%
11 - 20 times	13.6%
20 plus times	12.8%

Salt Lake City Area - April 2009

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BRAND THE BRAIN
Share of Mind = Share of Business

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Computer Stores

1 PC Laptop	27.4%
2 Best Buy	22.0%
3 Dell	5.9%
4 Apple Store	5.4%
5 Circuit City	2.0%
6 Mac Stores	1.2%
Others	12.4%
<i>Couldn't Name a Business</i>	23.7%
Total	100.0%

Salt Lake City Area - April 2009

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It appears from the latter pages that consumers may have been asked a question about “computer stores.” However, we are unable to determine from

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the information given what that question may have been and we can only speculate. Furthermore, no methodology is provided for the survey. Thus, we have no information as to what was asked, nor as to how it was asked. As a result, there is nothing in the record to provide a basis for the results provided, or even what those results are intended to signify. Without those missing pieces, we can only give the survey such limited probative value as it may provide.

Finally, Applicant provided evidence that it has been recognized by the media and by the industry with awards and other recognition. Some examples provided by Applicant include the following news excerpts describing Applicant and its PC LAPTOPS products and services:

ChannelWeb: Business Strategy: Focus on What Sets You Apart:
May 20, 2004

David Politis, principal and found of Politis Communications, a Salt Lake City-based marketing, consulting and corporate communications company, advised XChange attendees to zero in on what makes them uniquely different. He shared, for example, experiences gleaned from his work with one client, PC Laptops of Salt Lake City. . . PC Laptops took off when the company focused on late night television advertising.

Crn.com

Inc. 500: No. 4,646 PC Laptops, South Jordan, UT: PC Laptops sells custom desktop and laptop computers in Utah and Nevada, as well as online.

Inc.com

New.com Tech News First: CNET News.com: November 18, 2002:

PC Laptops, based in Sandy, Utah, is going for the notebook speed record. It announced the whopping 9.6 pound E-Pro Max 585. The laptop follows a growing trend among manufacturers,

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who have started to shoehorn desktop Pentium 4 chips into their notebooks.

Pclaptops.com/news/our_news (11/18/02)

NetworkWorldFusion: 12/4/02 PCLaptops recently launched its *E-Pro Max 585* portable computer, a laptop that includes a 2.8GHz Pentium 4 processor. The company said it will sell the laptop for less than \$3,000. PCLaptops currently has six models of its E-Pro line of portable computer.

Networkworld.com

TMCnews: BusinessWire: April 28, 2004; PC Laptops today introduced the Annihilator 897 high-end portable computer, an industry-leading laptop computer featuring a 3.2 Gigahertz (GHz) Pentium 4 processor, a 17-inch WXGA active matrix display and the popular ATI Mobility Radeon 9700 Pro graphics card.

Tmcnet.com

EMediaLive.com: April 30, 2004: PC Laptops has introduced the Annihilator 897 high-end portable computer, a laptop computer featuring 3.2 GHz Pentium 4 processor, a 17-inch WXGA active matrix display, and an ATI Mobility Radeon 9700 Pro graphics card. . . . Like all PC Laptops models, the Annihilator 897 is fully customizable beyond the standard configuration to fit a customer's exact needs . . .

Emedialive.com

Applicant also provided the following excerpts regarding awards received by Applicant or its CEO and President Dan Young. None of these were attested to in the Young declaration or otherwise. Thus, we cannot accept them for the truth of the matter, but rather for public perception or effect on the listener.⁵ Fed.R.Civ.Proc., Rule 801, *et seq.*

Utah100: The Utah100 Program was first conceived by the MountainWest Venture Group in 1993 as Utah' [sic] only

⁵ In this regard, we also note that several of the excerpts submitted by Applicant appear to have been printed from Applicant's own website, and it is thus impossible to determine the extent of public exposure.

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business growth recognition program. This premier award identifies and recognized [sic] Utah's top 100 fastest growing companies, 15 revenue growth companies, and 15 "Emerging Elite" companies each year. . . . To be eligible, companies had to be Utah-based U.S. organizations with a minimum of \$50,000 in sales in 1997 and sustain a nearly 200 percent growth rate for the past five years.

Elite Systems/PC Laptops (3 times), Sandy,
www.PCLaptops.com. (#46).

PCLaptops.com/news/our_news (1/11/10)

Press Release: For Immediate Release: PC Laptops President and Founder Dan "The Laptop Man" Young Honored by Salt Lake Community College as 2009 Distinguished Alumnus: Young was selected by the alumni council for his entrepreneurial spirit and the example he has set of perseverance and success for all SLCC students and graduates. . . . Since overcoming the challenges of his youth in south Los Angeles, Young has now driven PC Laptops to several listings in the Utah 100, an annual ranking of the fastest growing companies in the state, and PC Laptops was recently named the No. 1 Computer Store in the Salt Lake Region in a Citadel Broadcasting Survey. PC Laptops has also been listed among the fastest growing companies in America by Inc. magazine two years running.

May 18, 2009

PCLaptops.com/news/our_news (5/19/09)

Local Social media receives honors: 11/9/09

On Nov. 6, the Social Media Club of Salt Lake City presented its first set of awards to technologically savvy Utah companies and bloggers.

Awards: The best use of Twitter, podcasts, blogs awarded:

Best Facebook Fan Page: PC Laptops:

Facebook.com/PCLaptops.

PC Laptops: Sandy, Utah, April 12, 2004 – PC Laptops today announced it was named the Top Integrator of Intel Centrino Mobile Technology among resellers for all of North America at this year's Intel® Solutions Summit. . . .

Intel, the world's largest chip maker, recognized PC Laptops as the 2004 Intel Premier Provider of Intel Centrino Mobile Technology during the 2004 Intel Solutions Summit held in Las Vegas, Nevada in March.

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PCLaptops.com/news/our_news (5/5/04)

PC Laptops: Intel Channel Partner Program Appoints PC Laptops President and Founder to Premier Board of Advisors: July 7, 2008, South Jordan, Utah, PC Laptops today announced its President and Founder Dan “The Laptop Man” Young, has been appointed to the Intel Channel Partner Program Premier Board of Advisors.
Businesswire.com

Applicant also introduced evidence of “Google Trends” showing that Utah, where Applicant is based, has the highest number of hits for the search term “PC LAPTOPS” over the years covered by the report, mid-2007 through 2010. It is not clear what that tells us other than that consumers in Utah search for the term “PC LAPTOPS” more often than do consumers in other states.

In sum, we find that Applicant has failed to meet the heavy burden of showing acquired distinctiveness of this highly descriptive term. There is no context given for the advertising, nor any expenditures noted. The survey is unclear. Applicant did not provide any sales figures. Finally, we find that Applicant has failed to show that in fact its use is substantially exclusive. As noted in the prior section, there are multiple uses by third-parties in a descriptive or generic manner, which belies Applicant’s claim of exclusivity. *See Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972); *In re Franklin Historical Society*, 104 USPQ2d 1085 (TTAB 2012); *Nextel Communications Inc. v. Motorola Inc.*, 91 USPQ2d 1393, 1408 (TTAB 2009).

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Accordingly, we find, in the alternative, that Applicant's applied-for mark is at least highly descriptive, and that Applicant has failed to demonstrate that its applied-for mark has acquired distinctiveness for the goods and services identified in its applications.

Decision: The refusal to register is affirmed on the grounds of genericness and also on the alternative ground that the applied-for mark is merely descriptive and that Applicant has failed to show acquired distinctiveness under Section 2(f).