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PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pet Relocation LLC

Serial No. 77849966

Monica Emilienburg of Richards Rodriguez & Skeith LLP, for
Pet Relocation, LLC.

Toby E. Bulloff, Trademark Examining Attorney, Law Office
117 (Brett Golden, Managing Attorney).

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

Opinion by Ritchie, Administrative Trademark Judge:

Pet Relocation LLC ("applicant") has filed an
application to register PET RELOCATION in standard
characters on the Principal Register for "arranging for
pickup, delivery, storage and transportation of documents,
packages, freight and parcels, specifically animals and
domesticated pets, via ground and air carriers,"¹ in

¹ Serial No. 77849966, filed on October 15, 2009, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging first use and first use in commerce on January 1, 2004, and claiming Section 2(f) acquired distinctiveness. Applicant originally also included goods in IC 16 but deleted them in an amendment on March

International Class 35.

Initially, the examining attorney issued a refusal based on mere descriptiveness. Applicant responded by seeking to register the mark pursuant to Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), based upon "substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement." (February 16, 2010 amendment). The examining attorney then issued a new refusal on the grounds that (1) the proposed mark is generic for the applied-for services; and (2) the term "pet relocation" is so highly descriptive of applicant's services that the allegation of five years of use is insufficient to establish acquired distinctiveness. Applicant then submitted actual evidence purporting to establish acquired distinctiveness. (September 7, 2010 Office Action Response). However, as noted below in the "Acquired Distinctiveness" section, the final Office Action, dated April 1, 2011, addressed the refusal based on genericness only and did not address the sufficiency of applicant's actual evidence of acquired distinctiveness.

9, 2011, after receiving specimen and Section 2(e) refusals which found the assertions regarding the Section 2(f) claim to be insufficient.

Applicant filed a timely appeal solely on the issue of genericness. Both applicant and the examining attorney have filed briefs, and applicant has filed a reply brief.

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) ("Ginn"); *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 USPQ2d 1110, 1111 (Fed. Cir. 1987); *In re Wm. B. Coleman Co.*, 93 USPQ2d 2019 (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, and *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985).

Turning to the first inquiry, there does not appear to be any dispute that that the genus is properly defined as the recital of services set forth in the application, "arranging for pickup, delivery, storage and transportation of documents, packages, freight and parcels, specifically animals and domesticated pets, via ground and air carriers," (examiner's brief at unnumbered 5 of 13) (reply brief at unnumbered 2 of 3). *See Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991). *See also In re Country Music Association Inc.*, 100 USPQ2d 1828 (TTAB 2011).

Next we must determine how the relevant public understands this genus. Applicant maintains that "pet relocation" is a phrase or term of art that cannot be defined simply from the dictionary definitions of the two component words. (appl's brief at 4). See *In re Dial-A-Mattress*, 57 USPQ2d at 1810, citing *In re American Fertility Soc'y*, 188 F.3d 1341, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999). "[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.'" We agree, and hence consider "PET RELOCATION" to be a phrase and apply the analysis set forth in *Am. Fertility Soc'y* for marks which may be considered as a phrase.

That said, we look to the record for uses of the term "pet relocation" as a phrase in the context of the genus as we have defined it, based on applicant's own recital of services. Applicant's services are presumably described in its specimen, submitted on October 15, 2009. We note in this regard that applicant states in that specimen, as shown below: "Every pet is different, and so is every **pet relocation**." In so stating, applicant itself describes its

Serial No. 77849966

genus of service as "pet relocation." *Specimen submitted, October 15, 2009, p.4.*

This is more fully set forth in the following image:



The examining attorney also submitted evidence from third parties that use the term "pet relocation" to refer to the genus of services as described in applicant's recitation of services. Some examples include the following:

How does the **pet relocation** process work?
Pet relocation companies boast the ability to serve the entire world. The practice itself is fairly straightforward: pets are typically picked up at the transferee's residence, checked in at the departure airport, then cleared through customs upon arrival and delivered to their owner's new residence. **Pet relocation** specialists are also usually responsible for selecting appropriate flight arrangements, carefully reviewing the import and export documents, and counseling the transferee on the intricate details of their pet's move. . . . Most reputable **pet relocation** companies are members of a group called the Independent Pet and Animal Transportation Association International, Inc. (IPATA). *dogtime.com. Attached to April 1, 2011 Office Action, p8.*

Learn more about Royal Paws™ Pet Move Taxi Shipping Services: Preferred **pet relocation** for many corporations; Ground travel is with climate controlled luxury SUVs; Airport pet cargo pick-up and home delivery service.
Local and long distance dog and cat shipping.
Safe door to door transportation and **pet relocation**. *royalpaws.com. Attached to April 1, 2011 Office Action, p3.*

Happy Tails Travel, Inc.: At Happy Tails Travel we love to work with military families. We find them to be respectful, friendly, patient, flexible and organized, especially with the involved process of an international **pet relocation**. . . . Because the military doesn't always reimburse for military **pet relocation** services, and as a way of saying "Thank you," we offer a discount to members of the armed forces that have orders to move.
www.happytailstravel.com. Attached to September 13, 2010 Office Action, p4.

Animal Land Pet Movers: With offices on 5 continents, Animal Land specializes in coordinating **pet relocation** to anywhere in world [sic]. Of course we also handle domestic **pet relocations** as well. Our specialty is handling

your complete pet travel needs, wherever and whenever the need arises. . . . Seeking the expertise of a **pet relocation** professional can assure you peace of mind. petmovers.com. Attached to April 1, 2011 Office Action, p10.

TLC-PET TRANSPORT provides private ground transportation throughout the entire USA. We specialize in moving "one family at a time" to provide you and your pet family the safest **pet relocation** service possible. www.tlcpettransport.com. Attached to April 1, 2011 Office Action, p12.

Airborne Animals-Specialists in pet transportation: **Pet relocation** services are available to individuals as well as corporations. Pet moving services are not necessarily for those people who want to take a pet on vacation, but are more geared for the family moving to a new location. www.airborneanimals.com. Attached to April 1, 2011 Office Action, p16.

Pets on Board Transport, LLC: At Pets On Board Transport we realize that your pet is a valued member of the family. When choosing a **pet relocation** company we know you want the safest, most reliable pet transport available. Whether you're traveling locally to a dog event or moving your household and your pets from one coast to the other, the staff at Pets on Board Transport will treat your pets like family. www.petsonboard.com. Attached to April 1, 2011 Office Action, p18.

PAC Pet Air Carrier: Pet Air Carrier, LLC provides complete door-to-door **pet relocation** services. We specialize in International pet transportation requiring *complex documentation and permits* for rabies free countries such as England, Ireland, Scotland, Wales, Australia and New Zealand. . . . member of IPATA THE PET SHIPPING EXPERTS. www.petaircarrier.com. Attached to April 1, 2011 Office Action, p20.

Meanwhile, in its own evidence submitted for the purpose of showing acquired distinctiveness, applicant submitted a news article about its president, using the term "pet relocation" to describe the genus of services performed by applicant, both in the text and in the title of the article:

Austin Couple sells one business to grow **pet relocation** services online: "I'm trying to be the best pet relocater in Tokyo as much as I am in Stockholm," Kevin said. Kevin O'Brien said the innovation of their business was staying ahead of the trend in bringing services to the Web. He spends as much time developing and modifying the company's Web site as he does on the **pet relocation** part of the business.

AustinBusinessJournal January 29, 2010, Attached to September 7, 2010 Response to Office Action, p11.

As applicant notes, the test is not whether the mark would be perceived as generic to "some portion" of the public" but rather whether its "primary significance" to the relevant public is that of genericness. (appl's brief at 2). Here the examining attorney has put forth numerous clear examples of generic use of the term "pet relocation," used together as a phrase, to mean "arranging for pickup, delivery, storage and transportation of documents, packages, freight and parcels, specifically animals and domesticated pets, via ground and air carriers," as

explained above.² Applicant, as well, uses the term "pet relocation" to describe the genus of its services in its submitted specimen, as it is also used in at least one of the articles submitted by applicant into the record.

Accordingly, we have no doubt that, the examining attorney has presented clear and convincing evidence that the relevant public will understand the phrase "pet relocation" to refer primarily to the genus defined as "arranging for pickup, delivery, storage and transportation of documents, packages, freight and parcels, specifically animals and domesticated pets, via ground and air carriers," which is applicant's recitation of services. See *Am. Fertility Soc'y*, 51 USPQ2d at 1837. We find the applied-for mark to be generic for the services for which applicant seeks registration.

² We note that the term is sometimes used in the articles as an adjective, for example to say "pet relocation services." Use as an adjective is no less generic, since it conveys the same concept. See *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628 (TTAB 1998), citing J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, § 12:10 (4th Ed. 1997) ("A rule of thumb sometimes forwarded as distinguishing a generic name from a descriptive name is that generic names are nouns and descriptive terms are adjectives. However, this 'part of speech' test does not accurately describe the case law results.").

ACQUIRED DISTINCTIVENESS

As noted at the outset, the final Office Action, which issued on April 1, 2011, addressed only the genericness refusal. Accordingly, applicant likewise only addressed the genericness refusal in its appeal brief. However, the examining attorney for the first time addressed not only the genericness issue but also disputed the sufficiency of applicant's 2(f) evidence. This was improper since if the examining attorney had wanted to dispute the sufficiency of the 2(f) evidence, the time to do so was during prosecution of the involved application and by explicitly issuing a final refusal of the application based on that issue. *Cf. In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, n.8 (Fed. Cir. 2010) (if applicant asserts mark is inherently distinctive and asserts acquired distinctiveness in the alternative, and if examining attorney accepts claim of acquired distinctiveness, examining attorney must give applicant option to either appeal refusal of inherent distinctiveness or accept registration under Section 2(f).) See also TMEP § 1212.02(i). Nevertheless, applicant in turn responded to the examining attorney's assertion regarding the sufficiency of its showing of acquired distinctiveness via its reply brief. Accordingly, for completeness, and also because applicant and the examining

attorney have addressed this issue on appeal, we exercise our discretion not to treat this as a concession by the examining attorney but rather to consider both the examining attorney's and applicant's arguments presented in this section.

Since applicant has applied to register its mark under Section 2(f), the descriptiveness of the mark is conceded. *See The Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009) ("where an applicant seeks registration on the basis of Section 2(f), the mark's descriptiveness is a nonissue; an applicant's reliance on Section 2(f) during prosecution presumes that the mark is descriptive.") It is applicant's burden to prove acquired distinctiveness. *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"). The higher the level of descriptiveness, the greater the proportionate showing of acquired distinctiveness need be. *E.g.*, *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1424 (Fed. Cir. 2007). For the reasons discussed in

the "Genericness" section, the evidence amply shows that "pet relocation" would be highly descriptive (if not generic) of the applied-for services.

Accordingly, we look to the record to see if there is sufficient evidence that "PET RELOCATION" has acquired distinctiveness so that consumers associate it not primarily with the services for which applicant seeks registration, but rather with a single source for those services. *E.g., In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d at 1422. The evidence necessary to establish acquired distinctiveness depends on the facts of the case, but may include such factors as the length of use of the mark, advertising expenditures, sales, survey evidence, and affidavits asserting source-indicating recognition. *See, e.g., id.* at 1424.

In addition to its claim of five years of "substantially exclusive and continuous use," applicant submitted actual evidence of what it refers to as "unsolicited media coverage" in its September 7, 2010 Response to Office Action.³ This included the following:

Relocating Americans are relocating their pets, too. So <http://www.petrelocation.com> was founded to provide custom moving services as well as consumer information to those who will be moving on with their four cats, Newfoundland or 16

³ This characterization is from applicant's reply brief.

parakeets. And yes, the group will help you move your turtle to Tallahassee, and it will make sure it's legal to do so. *The Washington Post*, October 22, 2009. Attached to September 7, 2010 Response to Office Action, p3.

Travelling with Fluffy or Fido? Be Prepared: Kevin O'Brien of **PetRelocation.com**, which specializes in pet transport, said, "Sedation is by far the worst possible thing you can do to your pet before their long flight. Sedation, mixed with altitude, creates a dangerous cocktail that prevents the animals from using their natural ability to regulate their body temperature and to control their own stress. We suggest the human take the pill, as the pet will have a better experience than most humans when flying with commercial airlines." *The New York Times*, July 1, 2007. Attached to September 7, 2010 Response to Office Action, p.4.

In Depth: Eight Million-Dollar Businesses You've Never Heard Of: **PetRelocation.com**, Austin, Texas; Entrepreneur: Kevin O'Brien, 34 and Angie O'Brien, 34; Product/Service: Pet travel; Start Date: 2004; Start-up Costs: \$97,000; Revenue in 2008: \$2.5 million. *Forbes.com* [no date listed]. Attached to September 7, 2010 Response to Office Action, p.7.

How to Travel Safely with Fido and Fluffy: If you do decide to transport your pet in the cargo hold, take steps to keep your pet as comfortable as possible. Rachel Farris, director of PR and new media for **PetRelocation.com**, a company that helps owners move their pets across the country, recommends that travelers get their pets accustomed to their crates before they leave home. [no URL; web page states "This article originally appeared on Bing Travel in June, 2010"]. Attached to September 7, 2010 Response to Office Action, p.8.

Two wolf hybrids take a flight from Oregon to Texas: Wolves on a plane may seem frightening, but with the Pet Relocation staff on board, everything went as planned. **Pet Relocation** is an

Austin-based company that offers one-on-one, full-service arrangements using pet-friendly airlines for domestic and international travel. News8Austin.com, June 17, 2010. *Attached to September 7, 2010 Response to Office Action, p.15.*

Majority of Pet Owners Take Pets on Vacation: A member of the Independent Pet and Animal Transportation Association International (IPATA), **PetRelocation.com** released its first annual Summer Pet Travel Survey of more than 6,000 pet owners worldwide, which found that most pet owners travel at least once a year with their pets. PR Log Free Press Release, August 2, 2010. *Attached to March 9, 2011 Response to Office Action, p.6.*

Austin Couple sells one business to grow **pet relocation** services online: "I'm trying to be the best pet relocater in Tokyo as much as I am in Stockholm," Kevin said. Kevin O'Brien said the innovation of their business was staying ahead of the trend in bringing services to the Web. He spends as much time developing and modifying the company's Web site as he does on the **pet relocation** part of the business.⁴

For the O'Briens, no move is too great nor animal too exotic for their team and network of animal movers and caretakers. **PetRelocation.com** handles everything from paperwork to international quarantine laws. *AustinBusinessJournal January 29, 2010, Attached to September 7, 2010 Response to Office Action, p.11.*

⁴ This excerpt was also included in the "Genericness" section, above, to show applicant's submission of a third-party article that uses the term "pet relocation" in a generic manner in relation to the applied-for services. In this section, it is included for the purpose submitted by applicant, to show acquired distinctiveness of the mark.

Applicant also submitted for the preceding five years, annual revenues and advertising expenditures:⁵

Evidence of Acquired Distinctiveness: (1)
Applicant's Annual Revenue from Sales: 2006-
\$1,125,111.00 2007-\$1,643,989.00 2008-
\$2,460,000.00 2009-\$2,800,000.00 2010-
\$4,500,000.00 (Projected)
(2) Applicant's Advertising Expenses: 2006-
\$18,209.00 2007-\$63,342.00 2008-\$36,000.00 2009-
\$37,600.00 2010-\$60,000.00 (Projected).
September 7, 2010 Response to Office Action.

However, we find this evidence to be of limited probative value because applicant provided no context for how these numbers compare in the relevant industry (neither did applicant confirm which portion, if any, of the income and advertising may be ascribed to the "PET RELOCATION" mark for the applied-for services). Accordingly, with such little information, we can make no informed assessment as to how these numbers would affect the acquisition of any distinctiveness of the mark in becoming associated with a single source and not merely with the services for which applicant seeks registration.

⁵ Applicant submitted this information via the "Arguments" section of its September 7, 2010 Response to Office Action. The examining attorney did not object to the method of submission, and treated the assertions as though they are of record. Accordingly any objection is waived. *See In re Franklin County Historical Society*, 104 USPQ2d 1085, ftnt 3. (TTAB 2012); TBMP § 1208 (3rd ed. rev. 1 2012) ("It is the better practice to provide evidence as to sales figures and the like by affidavit or declaration. However, representations by the applicant's counsel may, in certain circumstances, be accepted".)

We do take note that applicant attested to "at least" five years of "substantially exclusive and continuous use" of the mark, and did provide at least half a dozen instances of media coverage. However, we find that as set forth in the "Genericness" section above, in fact applicant's use is not "substantially exclusive and continuous," but rather that third parties use the term "pet relocation" to describe this type or genus of service. *Nextel Communications Inc. v. Motorola Inc.*, 91 USPQ2d 1393, 1408 (TTAB 2009); *Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972). Accordingly, we find that applicant has not made a sufficient showing of Section 2(f) acquired distinctiveness.

Decision: The refusal based on genericness is affirmed. The refusal based on mere descriptiveness with failure to establish Section 2(f) acquired distinctiveness is also affirmed.