

THIS DECISION IS NOT A
PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board

In re Madetoorder, Inc.

Serial No. 77861639
Filed October 30, 2009

Raymond E. Roberts, Patent Venture Group, for applicant.

Michael W. Baird, Managing Attorney, Law Office 116.¹

**Before Seeherman, Mermelstein, and Ritchie, Administrative
Trademark Judges.**

Opinion by Mermelstein, Administrative Trademark Judge:

Madetoorder, Inc. seeks registration of MADETOORDER
(in standard characters)² for "on-line design services for
others in the field of personalized and custom design
transfers, namely, text, pictures and graphics for

¹ The managing attorney was assigned to this case on appeal, after the retirement of Cynthia Sloan, the originally-assigned examining attorney. To simplify matters, we refer to the managing attorney and examining attorney collectively as the "examining attorney" or "he."

² The drawing in the application depicts the mark as "MadeToOrder." Because a standard-character mark covers the wording in any font style, size, or color, *Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1258-59 (Fed. Cir. 2011), including any capitalization scheme, we use our standard convention of printing the mark in all capital letters in this opinion, as applicant itself has done in its brief.

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imprinting on apparel," in International Class 42.³

Applicant claimed the benefit of Trademark Act section 2(f) in its application as originally filed.

The examining attorney issued a final refusal to register on the ground that applicant's mark is merely descriptive pursuant to Trademark Act Section 2(e)(1), and that applicant's claim of acquired distinctiveness under Trademark Act Section 2(f) is unacceptable because the mark is generic, and in the alternative, because the evidence is insufficient to show that the mark has acquired distinctiveness.

We affirm the refusal to register.

I. Applicable Law

To the extent relevant here, the Trademark Act provides as follows:

No trademark by which the goods^[4] of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it -

...

(e) Consists of a mark which, (1) when used on or in connection with the goods of the

³ Based on use in commerce, and claiming first use and use in commerce as of August 9, 1999.

⁴ References in Trademark Act Section 2 to trademarks used on goods are construed to apply to service marks used in connection with services. Trademark Act § 3.

applicant is merely descriptive ... of them....

- (f) Except as expressly excluded ... nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. ...

Trademark Act § 2; 15 U.S.C. § 1052.

The ultimate issue before us is whether applicant's mark "has become distinctive of applicant's [services] in commerce." Trademark Act § 2(f). "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."⁵ *Cold War Museum, Inc. v. Cold War Air*

⁵ A claim to registrability under Trademark Act Section 2(f) is essentially an admission of nondistinctiveness, usually (as here) because the mark is merely descriptive of the identified goods or services. "An applicant can avoid the admission that its mark is not inherently distinctive if it makes the claim of acquired distinctiveness in the alternative and files an appeal of the refusal on the basis that the mark is not inherently distinctive (e.g., the mark is merely descriptive)." *In re Thomas Nelson Inc.*, 97 USPQ2d 1712, 1713 (TTAB 2011).

In the subject application, the claim of acquired distinctiveness was made in the application as originally filed without reservation, and applicant has not made or preserved an alternative claim that its mark is inherently distinctive.

Museum, Inc., 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009) (citing *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988)). To this extent, Trademark Act Section 2(f) is remedial in nature; it permits registration of some marks which would otherwise be found unregistrable – usually under Sections 2(e)(1), (2), and (4) – provided the applicant can show that its mark has acquired distinctiveness. See *Two Pesos v. Taco Cabana, Inc.*, 505 U.S. 763, 23 USPQ2d 1081, 1083-84 (1992). Unlike the other provisions of Trademark Act Section 2, Section 2(f) is not itself a ground for refusal of registration, so a refusal to accept a showing of acquired distinctiveness under Section 2(f) in mitigation of a refusal to register results in maintenance of the appropriate underlying refusal under Section 2(e) (or other relevant provision of the Trademark Act).

In this case, the examining attorney declined to accept applicant's Section 2(f) claim for two reasons: First, the mark is asserted to be generic. Although genericness is not mentioned in Trademark Act Section 2(f), generic terms cannot, by definition, "become distinctive of

Indeed, applicant concedes in its brief that the applied-for mark is "at least descriptive" of its services. App. Br. at 7. Accordingly, we begin with the presumption that applicant's mark is descriptive.

the applicant's goods in commerce," Trademark Act § 2(f), and such terms are categorically excluded from registration under Section 2(f) or any other provision. *In re Northland Aluminum Prods.*, 777 F.2d 1556, 227 USPQ 961, 964 (Fed. Cir. 1985) ("Having affirmed the Board's conclusion that BUNDT is a [generic] name, ... evidence of secondary meaning can not change the result."); *In re Noon Hour Food Prods. Inc.*, 88 USPQ2d 1172, 1181 (TTAB 2008) ("a generic term cannot be appropriated exclusively as a trademark irrespective of the length of use or level of promotional efforts"); J. Thomas McCarthy, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION*, § 12:1 (4th ed. rev. 2012) ("The terms 'generic' and 'trademark' are mutually exclusive"). Second, the examining attorney contends that if the term is not generic, applicant's Section 2(f) evidence is insufficient to demonstrate that it "has become distinctive of applicant's goods...." In other words, the examining attorney objected to the quantity or quality of applicant's evidence as not being sufficient to demonstrate the mark's distinctiveness.⁶

⁶ Thus, while the examining attorney (properly) sets out two separate arguments as to registrability, the statutory basis underlying both is that the mark is merely descriptive under Trademark Act Section 2(e)(1): The examining attorney rejects applicant's Section 2(f) claim, arguing that the mark is generic

A. Trademark Act Section 2(f)

Under Trademark Act Section 2(f), a mark which is merely descriptive may nonetheless be registered on the Principal Register if it has acquired distinctiveness or "secondary meaning":

A term which is descriptive . . . may, through usage by one producer with reference to his product, acquire a special significance so that to the consuming public the word has come to mean that the product is produced by that particular manufacturer. This is what is known as secondary meaning.

The crux of the secondary meaning doctrine is that the mark comes to identify not only the goods but the source of those goods. To establish secondary meaning, it must be shown that the primary significance of the term in the minds of the consuming public is not the product but the producer. This may be an anonymous producer, since consumers often buy goods without knowing the personal identity or actual name of the manufacturer.

TRADEMARK MANUAL OF EXAMINING PROCEDURE ("TMEP"), § 1212 (8th ed. 2011) (quoting *Ralston Purina Co. v. Thomas J. Lipton, Inc.*, 341 F. Supp. 129, 133, 173 USPQ 820, 823 (SDNY 1972) (citations omitted)); see also *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 214 USPQ 1, 4 n.11 (1982) ("To establish secondary meaning, a manufacturer must show that,

and *cannot* become distinctive, and even if the mark *could* become distinctive, applicant has not shown that it is. In either case, the basis of the refusal to register is that the mark is merely descriptive under Trademark Act Section 2(e)(1). See *In re Women's Publ'g Co. Inc.*, 23 USPQ2d 1876, 1877 n.2 (TTAB 1992).

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in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself.").

The determination of whether a mark has acquired distinctiveness is a question of fact, *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1729 (Fed. Cir. 2012) (citing *Yamaha Int'l*, 1581 USPQ2d at 1008), which applicant bears the burden of proving. "There is no doubt that Congress intended that the burden of proof [under Trademark Act Section 2(f)] should rest upon the applicant for registration." *In re Hollywood Brands, Inc.*, 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954). That burden "increases with the level of descriptiveness; a more descriptive term requires more evidence of secondary meaning." *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005) (citing *In re Bongrain Intern. (Am.) Corp.*, 894 F.2d 1316, 1317, 13 USPQ2d 1727, 1727 n.4 (Fed. Cir. 1990)).

The examining attorney may consider several categories of evidence in assessing secondary meaning, including (1) ownership of one or more prior registrations on the Principal Register of the same mark for the same or related services, Trademark Rule 2.41(b); (2) a verified statement that the mark has become distinctive of the applicant's

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services by virtue of applicant's "substantially exclusive and continuous use" of the mark in commerce for five years next preceding the claim, Trademark Act Section 2(f); Trademark Rule 2.41(b); and (3) evidence of the public perception of the mark, which may consist of direct evidence (such as consumer surveys), or indirect evidence from which distinctiveness may be inferred, such as "copying, advertising expenditures, sales success, length and exclusivity of use, [and] unsolicited media coverage." *Steelbuilding.com*, 75 USPQ2d at 1424. "On this list, no single factor is determinative. A showing of secondary meaning need not consider each of these elements. Rather, the determination examines all of the circumstances involving the use of the mark." *Id.*

B. Genericness

A mark is a generic name if it refers primarily to the class, genus or category of services in connection with which it is used. See *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001) (citing *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986)). In determining whether a mark is generic, the appropriate focus is its primary significance to the relevant public. Trademark Act § 14(3); *Magic Wand Inc. v. RDB Inc.*, 940

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F.2d 638, 19 USPQ2d 1551, 1552-53 (Fed. Cir. 1991); *H. Marvin Ginn Corp.*, 228 USPQ at 530. Whether a mark is generic is a question of fact, *In re Hotels.com LP*, 573 F.3d 1300, 91 USPQ2d 1532, 1533-34 (Fed. Cir. 2009), and the examining attorney has the burden of establishing by clear evidence that a mark is generic and thus unregistrable. *In re Merrill Lynch, Pierce, Fenner and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). Evidence of the relevant public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers, and other publications. See *In re Northland Aluminum Prods., Inc.*, 227 USPQ at 963.

II. Discussion

A. Genericness

1. What is the Relevant Genus of Services?

The first task in a genericness inquiry is to identify the genus of applicant's services. The examining attorney suggests that the appropriate genus is "the most fundamental aspect of the services claimed by applicant, a *custom design service*." Ex. Att. Br. at 5. By contrast, applicant urges that the appropriate genus in this case is its recitation of services, namely, "on-line design services for others in the field of personalized and custom

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design transfers, namely, text, pictures and graphics for imprinting on apparel." App. Br. at 3.

In considering the genus, the Federal Circuit has noted that

[t]he description in the registration certificate identifies the services in connection with which the registrant uses the mark. The Lanham Act permits cancellation when a "registered mark becomes the generic name for the goods or services ... for which it is registered...." 15 U.S.C. § 1064(3). Thus, a proper genericness inquiry focuses on the description of services set forth in the certificate of registration. *Octocom Sys., Inc. v. Houston Computers Servs., Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Magic Wand Inc. v. RDB Inc., 19 USPQ2d at 1552. Although it is not always the case, the Board has often found that the relevant genus is defined by the recitation of services in the application or registration at issue. *In re Tennis Indus. Ass'n*, 102 USPQ2d 1671, 1675 (TTAB 2012) (citing *In re Trek 2000 Int'l Ltd.*, 97 USPQ2d 1106, 1112 (TTAB 2010) ("the genus of goods at issue in this case is adequately defined by applicant's identification of goods")); *In re Greenliant Sys. Ltd.*, 97 USPQ2d 1078, 1081-82 (TTAB 2010).

We agree with applicant that in this case the appropriate genus is defined by applicant's recitation of services.

2. Does Applicant's Mark Refer Primarily to the Relevant Genus?

Applicant's mark consists of the term MADETOORDER, without stylization or design. The examining attorney submitted a definition of "made-to-order," as meaning (in the first sense) "[m]ade in accordance with particular instructions or requirements," www.answers.com/topic/made-to-order (Apr. 12, 2010), see *Ofc. Action*, Apr. 12, 2010, or "made according to the specific requests of a particular person," *MACMILLAN DICTIONARY* (online), www.macmillandictionary.com/dictionary/american/made-to-order (Nov. 3, 2010), see *Ofc. Action* Nov. 3, 2011. Applicant explicitly agreed with the first definition and did not take issue with the second. *App. Resp.* Oct. 11, 2011.

We find that the subject mark would be readily perceived by potential purchasers of applicant's services as essentially equivalent to the phrase "made to order" (or "made-to-order"). *Cf. Minn. Mining & Mfg. Co. v. Addressograph-Multigraph Corp.*, 155 USPQ 470, 472 (TTAB 1967) ("It is almost too well established to cite cases for the proposition that an otherwise merely descriptive term is not made any less so by merely omitting spaces between the words. . . .") (citations omitted). And we join

applicant in accepting the examining attorney's definition as the likely meaning of the term. "Made to order" in this context refers to something that is not "off the shelf," but is instead made specially for the customer, often to the customer's particular specifications.

The examining attorney also submitted numerous examples of websites using the term "made to order," many in connection with the offering of goods and services similar to those offered by applicant, further supporting the likely public perception of the mark. A few examples follow:

- thefancyattic.com – a website offering a variety of "unique accessories and gifts," including aprons, bouquets, Christmas stockings, games, jewelry, ornaments, quilts, and wedding party favors. The list concludes with the notation "(Made to order, design services available)."

- Dazzling Designs & Apparel Inc.:

Dazzling Designs and Apparel uses the latest technology turning any logo or image into a stunning crystal or rhinestone heat transfer....

By manufacturing your hotfix heat transfers on site with our robotic equipment, we are able to produce and ship your designs in days – not weeks.

. . .

Browse our design Catalog to view just some of our stock hotfix transfers. We have one of the largest online design catalogs on the web. All designs are made to order and completely customizable. Pick and choose your colors and element. If you don't find exactly what you are looking for, give us a call. Our customer

service staff works closely with our art department to ensure your designs are just what you're looking for.

- www.photo-coffee-mug.com:

Here at photo coffee mug, we can take any photo, logo, image, picture, or text. [sic] Put it onto any of our novelty gifts. We never charge extra for scanning or sizing photographs. All of our products are listed on the left and all the extra transfers for these products are on the bottom on [sic] the page. . . .

. . . .

Personalized Clip Boards. Full Color, key chains, luggage tags, golf tags and more custom made to order using your graphics Plastic sublimation.

- www.ioffer.com:

YOU CAN DO IT WITH . . .
Iron-On Heat Transfers

. . . .

RETURNS

All of our items are "made to order" and are unique to the buyer. Therefore we do not offer a return policy. All sales are final. See our feedback for ease of use, great communication and so much more.

Ofc. Action Apr. 12, 2010 (all websites visited April 12, 2010).⁷

It is abundantly clear that this evidence would be sufficient to show that MADETOORDER is *descriptive* of an aspect of applicant's "on-line design services for others

⁷ More such websites – particularly concentrating on "made to order" services – were attached to this Office action, the final Office action of November 3, 2010, and the response to applicant's request for reconsideration of March 17, 2011.

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in the field of personalized and custom design transfers, namely, text, pictures and graphics for imprinting on apparel," in that applicant's on-line services include the design of transfers to the order and specification of its customers (although as explained, descriptiveness is presumed in this application even without this evidence). But while descriptiveness will be found if the mark immediately conveys information about a significant feature, function, or characteristic of the identified services, a finding of *genericness* requires that the mark be understood primarily to refer to the genus (which in this case is the identified services). See *In re Dial-A-Mattress Operating Corp.*, 57 USPQ2d at 1810 (citing *H. Marvin Ginn Corp.*, 228 USPQ at 530).

Although the line between descriptiveness and genericness is not always clear, the distinction is critical here. Generic terms are often a common noun or "name" for the goods or services at issue, see e.g., *In re ING Direct Bancorp*, 100 USPQ2d 1681 (TTAB 2011) (PERSON2PERSON PAYMENT generic for "electronic funds transfers"); *In re Active Ankle Systems Inc.*, 83 USPQ2d 1532 (TTAB 2007) (DORSAL NIGHT SPLINT generic for "orthopedic splints for the foot and ankle"), but that is not always the case. We have found, for instance, that

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ATTIC is generic for "automatic sprinklers for fire protection," where the goods included sprinklers specifically for use in attics (and applicant's actual sprinklers were in fact intended for such use). *In re Central Sprinkler Co.*, 49 USPQ2d 1194, 1199 (TTAB 1998) ("In this case, because the term ATTIC directly names the most important or central aspect or purpose of applicant's goods, that is, that the sprinklers are used in attics, this term is generic and should be freely available for use by competitors."). See also *In re Pennzoil Prods. Co.*, 20 USPQ2d 1753, 1758-60 (TTAB 1991) ("MULTI-VIS" generic for multiple viscosity motor oil); *Miller Brewing Co. v. G. Heileman Brewing Co., Inc.*, 561 F.2d 75, 195 USPQ 281, 285 (7th Cir. 1977) ("The fact that 'light' is an adjective does not preclude it from being a generic or common descriptive word" as applied to beer). Indeed, while it has sometimes been said that "generic names are nouns and descriptive names are adjectives," such a rule is not consistent with the Board's precedent or that of many courts; genericness cannot be determined simply by applying prescriptivist rules based on parts of speech. J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 12:10 (4th ed. rev. May 2012).

Applicant argues that MADETOORDER is not generic for

the identified services because

[w]hile the phrase "make to order" is proper English grammar to describe a service, the phrase "made to order" is proper English grammar to describe goods. The term "made" is the past tense or past participle of "make" (thus, "[a] verb form indicating past or completed action or time that is used as a verbal adjective in phrases..." see e.g., <http://www.answers.com/topic/past-participle>.... Accordingly, essentially as a matter of definition in the English language, Applicant submits that the mark MADETOORDER is not descriptive^[8] of providing a service or services.

App. Br. at 3. See also App. Br. at 4 ("Services are not made, they are provided, and here Applicant provides on-line services for others to design personalized and custom design transfers. . . .").

We need not examine applicant's grammatical arguments in depth. A dictionary definition of a term at issue can be helpful, but it is not controlling. As discussed, genericness does not depend on grammatical constructs, but on the primary significance of the applied-for mark to the relevant public. As Judge Learned Hand famously asked, "[w]hat do the buyers understand by the word for whose use the parties are contending?" *Bayer Co., Inc. v. United Drug Co.*, 272 F. 505, 509 (SDNY 1921). Here, the examining

⁸ We assume applicant meant to say that the mark "is not *generic for providing a service or services*," as it elsewhere concedes, both directly and implicitly by seeking registration pursuant to Section 2(f), that MADETOORDER is at least descriptive.

attorney has provided evidence indicating that others with services similar to applicant's do in fact use the term "made to order" in connection with their *services*. Whether that is proper grammatical usage or not is beside the point; we are concerned here with how the relevant public actually uses and understands these words in the relevant market or industry. A dictionary is useful to the extent it sheds light on the usage of a term by the public. But the relevant question remains the public perception of the mark, not what a dictionary or the rules of grammar say is proper usage, so to the extent that they differ, evidence of actual usage of the term in question in the relevant field is much more probative than a general dictionary entry.⁹

In light of the evidence of record, we conclude that services such as applicant's can be "made to order." But all that establishes is that applicant's mark is at least merely descriptive of the identified services – the presumption with which we started.

While we reject applicant's arguments that its mark

⁹ That is not to say that we would necessarily be swayed by a small number of odd, non-standard usages of a term. Given the resources of the internet, it is possible to find all sorts of mis-uses, mistakes, and idiosyncratic uses of language. But the examining attorney's evidence convinces us that the uses here are not mere outliers or unusual errors.

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cannot be generic, we are likewise unconvinced by the examining attorney's evidence and argument that it *is* generic. The mark clearly does not comprise the *name* of a service – there is no evidence that applicant's customers or the purchasers of similar services call or search for the identified services as "made to order" or "made to order services." And while attributes of goods or services (such as ATTIC for sprinklers, LITE for beer) have been held generic, that is usually the case only when the attribute "directly names the most important or central aspect or purpose of applicant's goods." *Central Sprinkler*, 49 USPQ2d at 1199. While MADETOORDER clearly names a feature or characteristic of applicant's services, *i.e.*, that they are "performed on a custom basis," Ex. Att. Br. at 8, the mark does not describe a key or essential aspect of the services. Rather, it describes *how* the services are rendered or performed, while providing no information as to *what* the services are, namely the provision of "design transfers . . . for imprinting on apparel." In other words, the mark does not refer primarily to the genus to which the services belong.

Although we acknowledge that the distinction between descriptive and generic terms is not always an easy one to draw, the Office bears the burden of establishing by clear

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evidence that a mark is generic. *Merrill Lynch*, 4 USPQ2d at 1143. This is a high standard, and we cannot say that it has been met in this case.

B. Acquired Distinctiveness

Having concluded that applicant's mark is not generic for the identified services, we consider whether applicant's evidence is sufficient to establish that its mark has, in fact, acquired distinctiveness. In support of its Section 2(f) claim, applicant relies on ownership of a prior registration and a declaration of five years' use.

1. Prior Registration

On November 28, 2000, the USPTO issued Registration No. 2408618 to applicant for the following mark:



(".COM" disclaimed) on the Principal Register for use in connection with the same services as are identified in the current application.

As noted above, "in appropriate cases," a prior registration "may be accepted as prima facie evidence of distinctiveness." Trademark Rule 2.41. However, notwithstanding any other arguments made by applicant, we need not consider at length whether this registration is

sufficient (by itself or in combination with other evidence) to establish acquired distinctiveness. This is because – as the examining attorney points out in his brief, Ex. Att. Br. at 12 – this registration was cancelled and it expired for failure to file the required affidavit of continued use and application for renewal, see Trademark Act §§ 8-9, and a cancelled or expired registration cannot be relied upon as evidence of distinctiveness.¹⁰ See *In re BankAmerica Corp.*, 229 USPQ 852, 853-54 (TTAB 1986); *Anderson, Clayton & Co. v. Krier*, 478 F.2d 1246, 178 USPQ

¹⁰ The '618 Registration issued November 28, 2000, making applicant's Section 8 & 9 filings due November 28, 2010, or upon payment of a surcharge, within a six-month grace period after that, i.e., by May 28, 2011, at the very latest. If the required filings are not received by the due date, the Post-Registration Division defers processing cancellations for a short time further to ensure that any timely-mailed correspondence would have been received and matched with the file. In this case, applicant's prior registration was not listed in the USPTO's records as cancelled/expired until July 1, 2011, after applicant filed its notice of appeal and shortly before its brief was filed. While the examining attorney was thus unable to point out the cancellation prior to appeal, it has long been our practice that once evidence of a registration is properly submitted, we will take notice of any relevant changes in its status prior to decision. E.g., *Kellogg Co. v. Western Family Foods, Inc.*, 209 USPQ 440, 441-42 (TTAB 1980); *Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co., Inc.*, 204 USPQ 76, 80 n.3 (TTAB 1979).

While we are mindful that the cancellation of applicant's prior registration was not raised during examination, there is no unfairness or undue surprise in our consideration of it on appeal, as we must assume applicant was aware of the status of its own registration. In any event, as a matter of law, a dead registration cannot be used as evidence of distinctiveness, so any evidence or argument applicant might have submitted on this issue would have been futile. (We note that applicant did not opt to file a reply brief responding or objecting to the examining attorney's brief on this subject.)

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46, 47 (CCPA 1973) ("Whatever benefits a registration conferred upon appellee were lost by him when he negligently allowed his registration to become canceled."); *Sunnen Prods. Co. v. Sunex Int'l Inc.*, 1 USPQ2d 1744, 1747 (TTAB 1987) (a dead registration is evidence of nothing but the fact that it once issued). Accordingly, we conclude that applicant's prior, now-cancelled registration cannot be considered as evidence of acquired distinctiveness.

2. Declaration of Five Years' Use

The only other evidence applicant has submitted in support of its claim of acquired distinctiveness is the following declaration, included in the application as originally filed:

The mark has become distinctive of the goods/ services through the applicant's substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement.

As noted, the USPTO "may accept as prima facie evidence that the mark has become distinctive . . . proof of substantially exclusive and continuous use . . . as a mark by the applicant . . . for the five years before the date on which the claim of distinctiveness is made."

Trademark Act § 2(f); see Trademark Rule 2.41(b).

Applicant's statement of five years' use is worded consistently with Section 2(f) and Rule 2.41(b), and is

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thus acceptable in form. Nonetheless, the acceptance of such a declaration as *sufficient* evidence of distinctiveness is discretionary, see Trademark Act § 2(f) (“[t]he Director *may* accept. . .”); *In re Deister Concentrator Co., Inc.*, 289 F.2d 496, 129 USPQ 314, 320 (CCPA 1961) (USPTO not required to accept five years’ use as evidence of distinctiveness), and the analysis depends significantly on the nature of the mark and the refusal to register. In this case, the mark is descriptive, and we must consider its degree of descriptiveness in determining the sufficiency of applicant’s declaration as evidence of acquired distinctiveness. See *Bongrain*, 13 USPQ2d at 1727 n.4 (“the greater the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning”). The weight to be accorded a declaration of five years’ use “depends on the facts and circumstances of the particular case.” *In re ic! berlin brillen GmbH*, 85 USPQ2d 2021, 2024 (TTAB 2008). We have not hesitated to reject a declaration of five years’ – or even much more – use as insufficient to demonstrate acquired distinctiveness when the mark in question is significantly descriptive. *In re Noon Hour Food Prods. Inc.*, 88 USPQ2d at 1181 (showing of “nearly a hundred years of use in commerce” held insufficient, absent specific

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evidence of sales, advertising, market share, and the like).

In this case, we find applicant's declaration of five years' use insufficient to show that MADETOORDER has become distinctive of the identified goods. Although we do not find the mark to be generic, we nonetheless conclude that it is highly descriptive of applicant's services in that it clearly conveys to the prospective purchaser that the "personalized and custom design transfers" which are the subject of applicant's services are "made to order," i.e., made by applicant to the order and specification of its customers.

Considered in this context, a bare statement of five years' use is insufficient for us to conclude that the public has come to perceive applicant's highly descriptive mark as an indication of source, rather than as a mere description of a feature or characteristic of the services. The record does not reveal, for instance, the nature and extent of any advertising or promotional efforts applicant has made using the mark, the level of applicant's sales under the mark, or applicant's market share. Nor is there evidence of copying, media recognition of applicant's mark,

or its exclusivity of use.¹¹ See *Steelbuilding.com*, 75 USPQ2d at 1424. Indeed, while we assume based on applicant's declaration that its mark has been in use for at least five years, it cannot be discerned from this record whether applicant provides its services to more than a small number of customers on an infrequent basis. We conclude that given the descriptiveness of applicant's mark, a bare declaration of five years' use – without more – does not satisfy applicant's burden to show that its mark has acquired distinctiveness.

III. Conclusion

We have carefully considered all of the argument and evidence of record, including that which is not specifically discussed here. We conclude that although applicant's mark has not been shown to be generic, applicant's evidence is insufficient to establish that its mark has acquired distinctiveness under Trademark Act

¹¹ Applicant's declaration states that its use of the mark has been "substantially exclusive" for the five-year period in question. Nonetheless, the examining attorney's evidence demonstrates that others have used the term "made to order" in connection with the same or similar services, casting doubt on the exclusivity of applicant's use. See *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939, 940-41 (Fed. Cir. 1984) ("When the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term or device, an application for registration under Section 2(f) cannot be successful, for distinctiveness on which purchasers may rely is lacking under such circumstances.").

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Section 2(f).

Decision: The refusal to register under Trademark Act

Section 2(e)(1) is AFFIRMED.