

Mailed: July 10, 2013

**UNITED STATES PATENT AND TRADEMARK OFFICE**  
**Trademark Trial and Appeal Board**

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*In re Nortech Investments Ltd.*

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Application No. 85080867  
Filed: July 8, 2010

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Steven A. Gibson, Dickinson Wright PLLC, for applicant.

Linda Lavache, Trademark Examining Attorney, Law Office 106, Mary I. Sparrow,  
Managing Attorney.

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**Before Kuhlke, Cataldo, and Mermelstein, Administrative Trademark  
Judges.**

**Opinion by Mermelstein, Administrative Trademark Judge:**

Applicant seeks registration on the Principal Register of CASINO INFO (in  
standard characters) for the following services:

Provision of casino games on and through a global com-  
puter network wherein there are no actual monetary wa-  
gers; provision of contests and sweepstakes on and  
through a global computer network; providing a web site  
on and through a global computer network featuring in-  
formation in the fields of gaming, athletic competition and  
entertainment.

International Class 41.<sup>1</sup>

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<sup>1</sup> Filed based on an allegation of first use and use in commerce at least as early as Decem-  
ber 1, 1999. The application as originally filed includes a claim that the mark has acquired  
distinctiveness pursuant to Trademark Act § 2(f), and a claim of ownership of Registration  
Nos. 2728336 and 2860739.

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Applicant appeals from the examining attorney's final refusal of registration on the ground that CASINO INFO is merely descriptive of applicant's identified services, and that it has not acquired distinctiveness. Trademark Act § 2(e)(1).

We affirm the refusal to register.

### **I. Issues**

The statutory ground for the examining attorney's refusal to register is that applicant's mark is merely descriptive of the identified services. Trademark Act § 2(e)(1). Nonetheless, we must start from the assumption that applicant's mark is (at least) merely descriptive of the identified goods as a matter of law. Applicant has claimed the benefit of Trademark Act § 2(f), and such a claim is an admission that the mark not inherently distinctive. *Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 ("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."). Despite the mark's descriptiveness, applicant asserts that it is nonetheless entitled to registration under Trademark Act § 2(f). As originally filed, the application made two such claims:

The mark has become distinctive of the goods/services as evidenced by the ownership on the Principal Register for the same mark for related goods or services of U.S. Registration No(s). 2860739.

and

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 imme-

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diately before the date of this statement.

And under the heading of “Prior Registrations,” applicant inserted the following statement:

The applicant claims ownership of U.S. Registration Number(s) 2728336 and 2860739.

Application (Jul. 8, 2010). Applicant further argued during examination that its proposed mark has become distinctive of its services as a result of its actual use of CASINO INFO, *i.e.*, that the relevant consumers have come to consider the mark to be an indication of the source of applicant’s services, rather than a descriptive term.

The examining attorney disagrees. Although there may have been some earlier confusion, the final two Office actions make clear that the examining attorney does not accept applicant’s claim of acquired distinctiveness (1) because the mark is generic as used in connection with the identified services; and (2) because even if the mark is not generic, applicant has not met its burden to show that it has acquired distinctiveness. We consider both arguments,<sup>2</sup> albeit in reverse order.

## **II. Sufficiency of Evidence of Distinctiveness**

### **A. Legal Standard**

A mark which is merely descriptive of the identified goods may nonetheless be registered if it has “acquired” distinctiveness. Trademark Act § 2(f). “To establish acquired distinctiveness, applicant must show that the primary significance of the [mark] in the minds of consumers is not the product but the producer.” *In re Ennco*

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<sup>2</sup> To be clear, either of the examining attorney’s arguments would be sufficient to refuse registration in itself.

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*Display Sys. Inc.*, 56 USPQ2d 1279, 1284 (TTAB 2000). Applicant bears the burden of demonstrating that its mark has acquired distinctiveness. *In re Hollywood Brands, Inc.*, 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954) (“there is no doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant”).

Acquired distinctiveness may be shown by direct or circumstantial evidence. Direct evidence includes actual testimony, declarations or surveys of consumers as to their state of mind. Circumstantial evidence is evidence from which consumer association might be inferred, such as years of use, extensive amounts of sales and advertising, and any similar evidence showing wide exposure of the mark to relevant consumers. We determine whether a mark has acquired distinctiveness on the basis of all competent evidence, including “advertising expenditures, sales success, length and exclusivity of use, unsolicited media coverage, and consumer studies (linking the name to a source).” *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005).

There is no fixed rule for the amount of proof necessary to demonstrate acquired distinctiveness; the evidence required is in proportion to the degree of non-distinctiveness of the mark at issue. *Yamaha Int. Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988). Thus, even long periods of substantially exclusive use may not be sufficient to demonstrate acquired distinctiveness when the term in question is highly descriptive. Moreover, the burden is particularly heavy when that use has not been exclusive. *In re Gibson Guitar Corp.*,

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61 USPQ2d 1948, 1952 (TTAB 2001) (66 years of use not sufficient given similarity of configuration to other guitars); *Flowers Indus. Inc. v. Interstate Brands Corp.*, 5 USPQ2d 1580, 1588–89 (TTAB 1987) (“long and continuous use alone is insufficient to show secondary meaning where the use is not substantially exclusive”). We consider the evidence from the perspective of the consumers for services of the type identified in the application.

### **B. Discussion**

Applicant has submitted evidence and argument that its mark has acquired distinctiveness. Applicant’s evidence of acquired distinctiveness consists of the statements and declaration submitted with its original application, as well as the declaration of Gerencio Masula, several registrations owned by applicant and third parties, and the results of two Google searches. In urging us to find that its mark has acquired distinctiveness, applicant advances several arguments, which we consider in turn.

#### **1. Declaration of Five Years’ Use**

With its original application, applicant included a statement that its mark has become distinctive “through the applicant’s substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement.” Application (June 8, 2010). Applicant argues that its declaration “creates a presumption of acquired distinctiveness.” App. Br. at 16–17; Reply Br. at 7.

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To the extent applicant argues that we are required to presume<sup>3</sup> its mark distinctive based on its declaration of five years of use, it is plainly mistaken. The statute provides that

[t]he 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(f) (emphasis added). Importantly, the statute does not say that a declaration of five years' use *must* be considered *prima facie* evidence of distinctiveness; the statute explicitly invests the USPTO with the discretion to accept or reject such a declaration as *prima facie* evidence of distinctiveness. And in practice, a mere claim of five years' use will often be insufficient proof that a descriptive mark has acquired distinctiveness. See TRADEMARK MANUAL OF EXAMINING PROCEDURE

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<sup>3</sup> Applicant goes so far as to argue that the examining attorney was *required* to rebut the "presumption" of distinctiveness supposedly established by applicant's declaration of five years' use, and that she failed to do so. App. Br. at 17 ("the Examining Attorney must produce evidence rebutting such presumption"). To the contrary, there is no presumption which the examining attorney must rebut; it is *applicant's* burden to establish acquired distinctiveness, not the examining attorney's burden to disprove it. *Hollywood Brands*, 102 USPQ at 295.

As a practical matter, neither the declaration of five years' use nor the claim of ownership of a prior registration (discussed below) function as a "presumption" in the way applicant urges. The general rule is that an applicant claiming the benefit of acquired distinctiveness must prove that the relevant consumers regard applicant's mark as a distinctive indicator of source. Both the five years' use and the prior registration provisions provide some flexibility to the USPTO to grant § 2(f) status to an applied-for mark when under the circumstances it appears unnecessary to require more rigorous evidence of *actual* consumer perception. These provisions are essentially shortcuts that can be accepted at the discretion of the USPTO. While the examining attorney's discretion is not unlimited, neither clause is a requirement that five years' use or a prior registration *must* be accepted by the Office as *prima facie* evidence of acquired distinctiveness.

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(TMEP) § 1212.05 (April 2013) (“The USPTO may, at its option, require additional evidence of distinctiveness.”). Whether a declaration of five years’ use is sufficient depends on the descriptiveness of the mark; “the greater the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning.” *In re Bongrain Int’l Corp.*, 894 F.2d 1316, 13 USPQ2d 1727, 1728 n.4 (Fed. Cir. 1990) (citing *Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988)).

In this case, the examining attorney determined that applicant’s declaration of five years’ use was insufficient to establish a *prima facie* showing of distinctiveness, and we agree. Applicant’s mark is CASINO INFO for, among other things, “providing a web site on and through a global computer network featuring information in the fields of gaming, athletic competition and entertainment.”<sup>4</sup> The examining attorney’s dictionary evidence demonstrates that “gaming” means “gambling, especially casino gambling.” YAHOO! EDUCATION (online dictionary) *gaming* (<http://education.yahoo.com/reference/dictionary/entry/gaming> (Apr. 14, 2012)). And in case there was any doubt, “info” means “information.” MCMILLAN NEW WORLD COLLEGE DICTIONARY *info* (2010) (<http://www.yourdictionary.com/info> (Nov. 1, 2010)). Thus the relevant consumers—including those seeking information in the field of gaming—would immediately understand CASINO INFO, *i.e.*, information about casin-

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<sup>4</sup> Applicant has identified other services, as well, but for our purposes, it is sufficient to focus on applicant’s “providing a web site....” “A descriptiveness refusal is proper ‘if the mark is descriptive of any of the [services] for which registration is sought.’” *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (quoting *In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005)).

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nos, to describe “a web site ... featuring information in the field[] of gaming...” As to such services, applicant’s mark is not in the least bit distinctive, but is in fact, at least highly descriptive.

In addition, the examining attorney submitted evidence from web pages and other media, demonstrating significant use of the term CASINO INFO (or variants of that term) by others in connection with providing information on casinos and gambling, both online and in other media (emphasis added):

- [www.vegascasinoinfo.com](http://www.vegascasinoinfo.com) (visited April 14, 2012):

**Welcome to VegasCasinoInfo.com**  
The Complete Guide to Las Vegas Hotels & Casinos

- [www.mobilecasinoinfo.com](http://www.mobilecasinoinfo.com) (visited April 14, 2012):

**Mobile Casino Info**  
This site has been constructed to assist casino players looking for general mobile phone casino information and playing options, including apple [sic] iPhone.

- [www.thepokerforum.com/casinoinfo/links.htm/](http://www.thepokerforum.com/casinoinfo/links.htm/) (visited April 14, 2012):

**THE POKER FORUM.com**  
Your Poker Information Source!  
Casino Info Links

- [www.michigangaming.com/tribalcasinos](http://www.michigangaming.com/tribalcasinos) (visited April 14, 2012):

**Michigan Native American Casinos**  
**Contact Information**  
...  
**Soaring Eagle Casino & Resort**  
...  
Casino Info: 1-888-7EAGLE7

- [www.renocasinoinfo.com/](http://www.renocasinoinfo.com/) (visited April 14, 2012):



**Reno** **Casino Information**  
Your Reno **Casino Information** Source

- <http://372.us/category/online-casino-info> (visited April 14, 2012):

**BEST GAMBLING RESOURCES**  
**BEST CASINOS FOR GAMBLING**  
Archive for the 'Online **Casino Info**' Category

- [http://www.lansingfourthward.com/casino\\_info](http://www.lansingfourthward.com/casino_info) (visited April 14, 2012):

**Lansing's Fourth Ward**  
Jessica Yorko 4th Ward Representative, Lansing City Counsel  
**Casino Info**  
Additional Information Prepared by Councilmember Yorko....

- <http://www.attheheartofit.com/free-bingo-casino.html> (visited April 14, 2012):

**Free Bingo** **Casino Info**  
Bingo is one of the top casino games, ....

- <http://www.aboutcasinopayout.com/highest-payout-casino.html> (visited April 14, 2012):

**Highest Payout** **Casino Info**  
Are you looking for the highest payout casino? ....

- Sun-Sentinel (Fort Lauderdale, Florida) (July 1, 2011):

**July 4 Holiday Promotions for South Florida Casinos**  
Some **casino info** for July 4 weekend activity-seekers:

...  
The Isle Casino & Racing poker room has a "cash explosion" weekend that started today....

- Detroit Free Press (Michigan) (Sept. 27, 2007):

**The Sky's the Limit; New MGM Grand is Detroit's Palace of Dreams**

...  
Hotel reservations 888-646-3387; **casino info**: 877-888-2121

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- The Star-Ledger (Newark, New Jersey) (May 22, 2005):

### **West bound, Detroit**

...

The city has appeal beyond its stick-shift lure. ... After dark visitors can ... go gaming at a casino (see accompanying story for [casino info](#)).

- The Sunday Oregonian (April 7, 2002):

### **Know Before You Go**

Chinook Winds Gaming and Convention Center Box office: 888-624-6248 Bus reservations: 877-594-4627 [Casino info](#): 888-244-6665

- Hartford Courant (Connecticut) (March 21, 2001):

### **Town News Briefing**

Casino Night to Aid Children's Center

...

For tickets or information, call the [Casino Info](#) Line at 860-246-7825.

- The Boston Herald (May 19, 1995):

### **AG wants more [casino info](#) from Wampanoags**

Attorney General Scott Harshbarger yesterday called on the Wampanoag Indians of Gay Head to release more complete information about their casino plans.

- Detroit Free Press (Sept. 2, 1999):

### **[Casino Info](#): State Shouldn't Be Keeping Public in the Dark**

...

In fact, Michigan will be one of the most "primitive" states in terms of sharing information about casinos, according to an expert from the University of Nevada at Reno, who should know.

- Editor & Publisher Magazine (Aug. 13, 1994):

### **N.J. paper gets [casino info](#)**

NEW JERSEY CASINO regulators have agreed to a newspaper's request to release information about their investigations into alleged members of Asian organized crime syndicates.

This evidence shows that CASINO INFO is at least highly descriptive with re-

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spect to “providing a web site on and through a global computer network featuring information in the fields of gaming, athletic competition and entertainment.” Given the highly descriptive nature of applicant’s mark, it would not be appropriate to accept applicant’s declaration of five years’ use as *prima facie* evidence of distinctiveness in this case. *In re Gray Inc.*, 3 USPQ2d 1558, 1559 (TTAB 1987) (“[T]o support registration of PROTECTIVE EQUIPMENT [for burglar and fire alarms and burglar and fire alarm surveillance services] on the Principal Register a showing considerably stronger than a *prima facie* statement of five years’ substantially exclusive use is required.”).

### 2. Prior Registrations

Also included with the original application was applicant’s claim of distinctiveness based on its ownership of prior registrations.<sup>5</sup> The Trademark Rules provide that “[i]n appropriate cases, ownership of one or more prior registrations on the Principal Register ... of the same mark may be accepted as *prima facie* evidence of distinctiveness.” Trademark Rule 2.41(b). Similar to the statutory provision regarding declarations of five years’ use, Rule 2.41 is neither automatic or mandatory; it is to be used “in appropriate cases,” and the examining attorney has the discretion to require additional evidence of distinctiveness if she deems it appropriate. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1347, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001); *In re Loew’s Theatres, Inc.*, 769 F.2d 764, 769, 226 USPQ 865, 869 (Fed. Cir.

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<sup>5</sup> Although applicant claimed ownership of two registrations, its actual claim of distinctiveness related only to the ’739 (Principal) Registration. Nonetheless, applicant discusses both registrations in its briefs, and we consider them both for the sake of completeness.

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1985). With respect to applicant's prior registrations, the examining attorney again rejected applicant's claim of acquired distinctiveness based on its registrations, and again we think she was correct to do so.

The first — Registration No. 2728336 for CASINO INFO — is not an appropriate basis for an assertion of distinctiveness because it appears on the Supplemental Register. By its terms, Trademark Rule 2.41(b) applies only to registrations on the Principal Register. Accordingly, the '336 Registration is ineligible for consideration under the cited rule.

Applicant's second Registration — No. 2860739 — is for the following word and design mark:



for “broadcasting and netcasting services on and through a global computer network featuring sports events, contests, sweepstakes, casino events, athletic events and entertainment events,” in International Class 38. Although this mark is on the Principal Register, it is critical to note that applicant disclaimed the exclusive right to use CASINO INFO apart from the mark as shown. If a term was disclaimed in a prior registration, that registration may not be used to establish the distinctiveness of the disclaimed term in a subsequent application. *Kellogg Co. v. Gen. Mills, Inc.*, 82 USPQ2d 1766, 1771 n.5 (TTAB 2007); *In re Candy Bouquet Int’l, Inc.*, 73 USPQ2d 1883, 1889–90 (TTAB 2004).

Moreover, to be considered *prima facie* evidence of distinctiveness, a prior regis-

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tration must be for “the same mark.” Trademark Rule 2.41(b). It is patently obvious that applicant’s ’739 Registration is not for the same mark. Although it comprises the term applicant now seeks to register, it also includes a distinctive design. *In re Brouwerij Bosteels*, 96 USPQ2d 1414, 1423 (TTAB 2010) (“To meet the legal equivalents test, the marks must be indistinguishable from one another or create the same continuing commercial impression such that the consumer would consider both as the same mark.”).

Finally, we note that the International Class 38 services in applicant’s ’739 Registration differ from the International Class 41 services at issue in this application. The ownership of a Principal registration for one service is not necessarily evidence of the distinctiveness of the mark used in connection with different services. *See Bausch & Lomb Inc. v. Leupold & Stevens Inc.*, 6 USPQ2d 1475, 1478 (TTAB 1988). On this record, applicant has not carried its burden to establish that the services identified in its ’739 Registration are sufficiently similar to the services in this application such that any distinctiveness in the former would apply to the latter. As was the case with applicant’s Supplemental Registration, applicant’s ’739 Registration does not support its position that the mark in the subject application has acquired distinctiveness with respect to the identified services under Trademark Rule 2.41(b).

### **3. Use in Commerce**

Applicant also argues that its actual use of the mark—or such use in combination with its prior registrations and statutory claim of five years’ use—establish

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the acquired distinctiveness of CASINO INFO.

As noted at the outset, in considering whether a mark is distinctive by virtue of its use, a variety of direct or circumstantial evidence may be considered, including actual evidence of consumer perception (customer affidavits, surveys, *etc.*), the length of time the mark has been in use by applicant, how the applied-for mark is used, the nature and extent of advertising using the mark (advertising volume, expenditures, market penetration, *etc.*), the success of goods or services associated with the mark (units sold, sales figures, market share, *etc.*), and the degree to which applicant's use of the mark has been exclusive. We reiterate that the burden of showing distinctiveness is proportional to the degree to which the mark is descriptive. For a mark which is close to the suggestive end of the descriptiveness continuum, relatively little evidence may suffice. But the closer a mark is to genericness, the higher the applicant's burden to show that distinctiveness has been acquired. (And of course, if the mark is generic, no amount of evidence is sufficient to show distinctiveness.) In this case, we have concluded that applicant's mark is at least highly descriptive.

The original application includes the statement that applicant's mark has been in use "for at least the five years immediately before the date of this statement." Moreover, applicant argued throughout prosecution and in its briefs that its mark has been in use for a considerably longer period. According to the declaration of Gerencio Masula, applicant's Vice President, "CASINO INFO was first used in commerce on December 1, 1999." Masula Dec. ¶ 5 (Oct. 29, 2010) (Req. for Recon.

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Exh. 8 (Oct. 31, 2010)). We thus consider applicant's mark to have been used for more than 13 years.

Length of use is an important factor in determining whether a descriptive term has acquired distinctiveness. Consumers long exposed to a descriptive term used exclusively by one party may eventually come to view the term as an indication that the associated goods or services originate with that party. Nonetheless, the mere declaration that one has used a proposed mark for more than thirteen years tells us little about *how* it was used and the resulting impression of the mark upon the prospective user of the services. Such evidence is important, because use in a purely descriptive manner, use which is non-exclusive, or use in small volume will not usually give rise to trademark rights in a descriptive term, despite long use. *See, e.g., In re Noon Hour Food Prods., Inc.*, 88 USPQ2d 1172, 1181 (TTAB 2008) (use for nearly one hundred years insufficient).

This record reveals little about applicant's use of the mark for the past thirteen years, and accordingly little about the likely consumer perception of it. The specimen filed with the application is a copy of applicant's web page, <http://www.casino-info.com/> (March 17, 2010), and appears to be the only example of applicant's use of the mark in the record. Applicant's specimen depicts CASINO INFO as it appears in applicant's '739 Registration—in stylized lettering with the word “casino” in an oval carrier against a background of playing-card spades. The web page includes links to information on a variety of topics germane to casino gaming, including links to “Casino Tips” and “Featured Casinos.” As we noted previously, applicant's mark

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is highly descriptive for “a web site ... featuring information in the field[] of gaming...” Use of the mark as depicted on applicant’s specimen is unlikely to be construed by consumers as an indication of source because it merely reinforces the mark’s descriptiveness. To the extent that the mark used on applicant’s specimen of record has any distinctiveness (acquired or inherent) it is likely due to the particular stylization and design in which the mark is used, rather than the purely descriptive wording used to indicate the contents of the page.

Moreover, although applicant has used its mark for approximately 13 years, it is unclear whether such use has come to the attention of a significant number of the relevant consumers. Applicant notes that in 2011 its website received 28,570 unique visitors, and 17,615 visitors for the period January–September 2012. While these numbers indicate some modest interest during the one-and-three-quarters years reported, there is nothing in the record to put that number in context, *i.e.*, to indicate applicant’s market share or the proportion of relevant consumers exposed to applicant’s mark, nor is there any indication of whether the website received a similar number of visitors for any of the other years of applicant’s use. Although applicant characterizes its internet presence as “extensive,” App. Br. at 18, we cannot tell from this record whether 28,570 hits on its website in a year represents anything more than some passing interest in the content of applicant’s website, as opposed to wide recognition of the words CASINO INFO as an indication of source.

Applicant also argues that its placement (first) on a Google search result listing, Req. for Recon. Exh. 7 (Oct. 31, 2012), resulting from a search for “casino info” is ev-



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idence that its mark has acquired distinctiveness. We disagree. First, we are not privy to the algorithm by which Google selects and displays the results of a search, and we cannot simply presume that its placement on applicant's search results has trademark significance. Second, as the examining attorney points out, Ex. Att. Br. at 19, it should come as no surprise that Google found applicant's web site in a search for "casino info" because CASINO INFO is the mark itself, and the words "casino" and "info" are used in applicant's URL, "http://www.casino-info.com/." We can infer nothing about the perception of applicant's mark from such evidence.

Applicant again asserts that its '336 Supplemental registration "has led to the mark's recognition as an identifier of source," App. Br. at 15, and that it "provide[s] constructive notice of the registration, *id.* at 18. Applicant is incorrect. As noted above, a mark on the Supplemental Register is not appropriate for acceptance as *prima facie* evidence of distinctiveness under Trademark Rule 2.41(b); the rule itself precludes such treatment. But aside from Trademark Rule 2.41, it is not appropriate to consider a mark on the Supplemental Register as evidence of distinctiveness *at all*. Acquired distinctiveness is a question of consumer perception of a mark, and applicant's theory depends on relevant purchasers being aware of the '336 registration. But this theory also fails, because registrations on the Supplemental Register are not entitled to the presumptions set out in Trademark Act § 7(b)–(c), including the presumptions that the mark and its registration are valid, and that the mark was in use at least as early as the filing date of the application. Moreover, contrary to applicant's assertion, App. Br. at 18, a registration on the Supplemental Register

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is *not* constructive notice of it. Trademark Act § 22 (providing that registration of a mark on the Principal Register is constructive notice of the registrant’s claim of ownership) does not apply to marks on the Supplemental Register.<sup>6</sup> Trademark Act § 26. Again, applicant’s ownership of the ’336 Registration does nothing to establish the distinctiveness of the proposed mark.

Applicant also argues that the USPTO has registered marks similar to CASINO INFO on the Principal Register. App. Br. at 19–20 (citing GREYHOUNDRACING.COM as an example). Nonetheless, we are not privy to the evidence and argument adduced in these other registrations and—as applicant recognizes—although the USPTO strives for consistency, each application must be examined on its own. Neither the examining attorney nor the Board is bound to register applicant’s mark based on the registration of other marks for other goods or services, based upon another evidentiary record. *In re Boulevard Entm’t Inc.*, 334 F.3d 1336, 67 USPQ2d 1475, 1480 (Fed. Cir. 2003) (“the PTO must decide each ap-

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<sup>6</sup> Although registration on the Principal Register *is* considered constructive notice of the registration, Trademark Act § 22, applicant’s ’739 (Principal) registration is of no help in considering whether CASINO INFO has acquired distinctiveness in the mind of the relevant customer. First, as noted above, applicant explicitly *disclaimed* any exclusive right to use CASINO INFO in the ’739 Registration. As such, anyone with notice—constructive or actual—of this registration would also be aware that applicant denied any exclusive right to use CASINO INFO, apart from that mark as a whole.

Second, as we have already noted, this registration is ineligible for consideration under Trademark Rule 2.41(b). The issue now under discussion is not whether applicant’s mark can be registered under the Rule 2.41(b) provision, but whether applicant has demonstrated that consumers in fact perceive the mark to have become distinctive. In other words, the question is what the relevant purchasers *actually* think (or what they are likely to think in the absence of direct evidence). While constructive notice is a consequence of registration on the Principal Register, constructive—as opposed to actual—notice cannot change consumers’ perception of the mark.

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plication on its own merits, and decisions regarding other registrations do not bind either the agency or this court” (citing *In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)).

Finally, we note the examining attorney’s evidence that others are using CASINO INFO in connection with similar services. As noted above, the examining attorney has submitted excerpts from websites and the media, showing use by others of the term CASINO INFO. As the Court of Appeals for the Federal Circuit has explained, evidence of the use of a proposed mark by others is highly significant:

In respect of registration, there must be a trademark, *i.e.*, purchasers in the marketplace must be able to recognize that a term or device has or has acquired such distinctiveness that it may be relied on as indicating one source of quality control and thus one quality standard. 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.

*Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939, 940–41 (Fed. Cir. 1984).

The examining attorney’s evidence indicates that others use the term “CASINO INFO” in a manner similar to applicant’s own use, *i.e.*, on “a web site ... featuring information in the field[] of gaming....” This evidence indicates that others have the need to use CASINO INFO to describe their own services both on the internet and in other media, but more importantly, it demonstrates that CASINO INFO does not identify applicant as the sole source of a “CASINO INFO” brand of services. To the

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contrary, it is clear that the term is used by others to describe the very services for which applicant seeks to register the term.

### **III. Genericness**

In addition to arguing that applicant has not shown that the proposed mark has acquired distinctiveness, the examining attorney also maintains that applicant's mark is generic.

#### **A. Legal Standard**

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 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. *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 227

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USPQ 961, 963 (Fed. Cir. 1985).

### B. Discussion

#### 1. What is the Relevant Genus?

The first task in a genericness inquiry is to identify the genus of applicant's services. 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 find no need to deviate from our usual course in this case. Accordingly, we find it appropriate to consider the relevant genus to be defined by the services set out in the subject application. And because the subject application recites several different services, we will treat each of the delineated services as a genus. In doing so, we again note that applicant's services include "providing a web site on and

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through a global computer network featuring information in the fields of gaming, athletic competition and entertainment,” and that we must refuse registration if we find that applicant’s mark is generic with respect to this or any of applicant’s services.

### **2. Does the Mark Pertain Primarily to the Genus?**

Applicant’s mark consists of the term CASINO INFO, without stylization or design for, among other services, “a web site ... featuring information in the field[] of gaming....” As discussed above, the term “info” in applicant’s mark means “information, and a “casino” is defined as “a place where people gamble.” These definitions reflect the ordinary meaning of CASINO and INFO, and there is no reason to suspect that they would not be readily understood by prospective consumers of applicant’s services. This evidence suggests that the applied-for mark would be readily understood to refer to information in the field of gaming (remember that “gaming” and “gambling” are essentially synonyms).

The only distinction between applicant’s mark and these services is the fact that applicant identifies services to be provided through a web site, a fact which is not directly reflected in applicant’s mark. But this is a distinction without a difference. The fact that applicant’s services are being provided over the internet does not change in any way the fact that the subject application recites (and it appears applicant is in fact providing) CASINO INFO[rmation]. There is nothing special about providing such information online. A term which is generic for a good or service in the “brick and mortar” realm is likewise generic when the same good or service is

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provided online. See *In re Lens.com Inc.*, 83 USPQ2d 1444, 1447 (TTAB 2007) (“Because ‘lens’ is a name for the contact eyewear which comprises the subject matter of applicant’s services, the term is likewise a generic name for the retail Internet store services themselves.”); *In re Candy Bouquet Int’l, Inc.*, 73 USPQ2d 1883, 1887–88 (TTAB 2004) (because CANDY BOUQUET is generic for gift packages of candy, it also is generic for applicant’s retail, mail and computer ordering services for such goods).

It is important to note that the examining attorney does not rely solely on dictionary definitions to support her case. “The correct legal test for genericness of phrases ... requires evidence of the understanding by the general public that the mark refers primarily to ‘that genus of goods or services.’” *In re Am. Fertility Soc’y*, 188 F.3d 1341, 51 USPQ2d 1832, 1837 (Fed. Cir. 1999). As discussed above, the examining attorney has submitted a number of web pages demonstrating the generic use by others of the term CASINO INFO in connection with the provision of information about casinos and gambling. Thus, consumers of applicant’s services would immediately understand the term CASINO INFO, used in connection with the identified services, to refer primarily to those services, *i.e.*, the genus.

### **3. Applicant’s Arguments**

Applicant makes a number of arguments in support of registration, a few of which bear mention:

With respect to genericness, applicant again notes its registration of CASINO INFO on the Supplemental Register. Because a generic term is not eligible for regis-

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tration on the Supplemental Register, applicant argues that refusal of its current application on the ground of genericness is inconsistent with its prior registration. App. Br. at 13–15. Nonetheless, whether a mark is generic must be determined with respect to the goods or services identified in the application, and not in the abstract. As we have noted, applicant’s prior Supplemental registration is for different services than those at issue in the subject application, so a determination that CASINO INFO is generic with respect to the services in this application is not inconsistent with the previous grant of a Supplemental registration of the same mark for use on different services.<sup>7</sup>

Applicant also complains that it “provides a more precise specification of services in comparison to that provided by the Examining Attorney’s general definitions.” App. Br. at 5. While the examining attorney has proffered dictionary definitions of CASINO and INFO that support her position, our understanding of the meaning of the proposed mark as a whole is informed primarily by the examining attorney’s evidence of that term’s use in providing the same or similar services. Although it is true that the examining attorney’s web and media references to use of the term CASINO INFO do not include an exact definition of that term as used by the author of each article or web site, it is simply unrealistic to expect such evidence. As the Court of Appeals for the Federal Circuit has prescribed, the examin-

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<sup>7</sup> And again, we note that there is no statutory presumption that a registration on the Supplemental Register is valid. Trademark Act § 26. We must determine the registrability of the subject application based on the evidence in this record, regardless of applicant’s prior Supplemental registration.



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ing attorney has provided evidence of how the term CASINO INFO is actually used in commerce, thus reflecting the public perception of the phrase. *Am. Fertility Soc’y*, 51 USPQ2d at 1837 (internal quotation marks omitted). This evidence is not useful because the articles and web pages contain definitions of the term CASINO INFO, but because of how the term is used in them. Indeed, this evidence demonstrates that CASINO INFO is a term that is immediately understandable to the relevant audience, even *without* an explicit definition. Applicant’s services include “providing a web site on and through a global computer network featuring information in the field[] of gaming....” The examining attorney’s evidence clearly demonstrates that CASINO INFO is widely used for exactly the same purposes as applicant—providing online information in the field of gaming—just as it is used for the provision of such information in other media.

Applicant further argues that “the identification of ... services is not ‘CASINO INFO.’ ‘CASINO INFO’ is not generic for ‘web sites.’” App. Br. at 9. Nonetheless, there is no rule that genericness may be found only when the proposed mark is used in the applicant’s recitation of goods or services. The fact that the words CASINO and INFO are not used in the description of services in the subject application does not change the meaning of CASINO INFO with respect to the online provision of information in the field of gaming. Likewise, the fact that applicant’s mark may not be generic for all of applicant’s services, *see* App. Br. at 9–10; Reply Br. at 3–4, is of no help to applicant here; registration must be refused if the proposed mark is generic for *any* of the services encompassed in applicant’s recitation of services. *In re*

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*Eddie Z's Blinds and Drapery Inc.*, 74 USPQ2d 1037, 1042 (TTAB 2005).

**IV. Decision**

After careful consideration of all of the evidence and argument of record (including any arguments or evidence we have not mentioned), we conclude that applicant's mark is ineligible for registration first, because the proposed mark is (at least) descriptive of "a web site ... featuring information in the field[] of gaming..." and applicant has not borne its burden to show that it has acquired distinctiveness. Second, we conclude that the examining attorney has met her burden to show by clear evidence that applicant's mark is a generic name for such services, and is thus unregistrable.

**Decision:** The refusal to register under Trademark Act § 2(e)(1) is affirmed, and registration to applicant is refused.