

This Opinion is not a
Precedent of the TTAB

Mailed: November 9, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Yousef Saleh Alreshidi
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Serial No. 86457267
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Jungjin Lee of Lee Lee & Associates PC
for Yousef Saleh Alreshidi.

Caitlin Watts-FitzGerald, Trademark Examining Attorney, Law Office 111,
Robert L. Lorenzo, Managing Attorney.

—
Before Seeherman, Kuhlke and Adlin,
Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Yousef Saleh Alreshidi (“Applicant”), a citizen of Saudi Arabia, has appealed from the final refusal of the Trademark Examining Attorney to register the mark shown below for “classified advertising services” in Class 35.¹ The mark is described as consisting of “Arabic script which transliterates to HARAJ,” and the application’s translation statement is: “The English translation of ‘HARAJ’ in the mark is ‘AUCTION’ or ‘SALE’.”

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¹ Application Serial No. 86457267 was filed on November 18, 2014, asserting first use anywhere and first use in commerce as early as January 8, 2007.



Registration was refused pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the grounds that Applicant's proposed mark is generic or, in the alternative, that it is merely descriptive, and Applicant's evidence is insufficient to show that it has acquired distinctiveness.

We affirm the refusal to register.

I. Preliminary Matters

A. The Mark

Throughout both Applicant's and the Examining Attorney's submissions they have variously referred to Applicant's mark as being in Persian or Farsi or Arabic characters. The explanation for this appears in the Official translation provided by the USPTO's Scientific and Technical Information Center, which states that the mark is in Arabic letters which is the alphabet used in Iran for Persian, which is also known as "farsi." This translation statement also certifies that the letters transliterate to "haraj" which means "auction" or "sale" in English when translated from "Modern Persian (farsi)."² Because "farsi" is another term for "Persian," we will refer to Applicant's mark as a Persian word, and refer to the letters as being Arabic characters, which is the way Applicant has referred to them in the description of his mark in the application.

² Office action mailed February 12, 2016, p. 58-59.

B. Inherent/Acquired Distinctiveness

On June 15, 2015, in response to the refusal that Applicant's proposed mark is generic and, alternatively, is merely descriptive, Applicant amended his application to seek registration under Section 2(f), stating that "the mark has become distinctive of the goods/services through the applicant's substantially exclusive and continuous use in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement." In his response filed on July 21, 2015, he reiterated his claim of registrability under Section 2(f), although this time he asserted that the mark has acquired distinctiveness on the basis of his ownership of a Principal Register registration for the same mark for similar goods/services. In neither response did Applicant state that the amendment to register under Section 2(f) was in the alternative, which would have preserved his right to also assert that his mark is inherently distinctive; indeed, in neither of these responses did he make any argument at all that the mark is not merely descriptive.

However, in his request for reconsideration, filed on January 27, 2016, Applicant argued that his mark is suggestive and not merely descriptive. Although Applicant did not specifically state that he was now making his Section 2(f) claim in the alternative, that was clearly the import of his filing, and the Examining Attorney treated it as such. In her recital of the history of the prosecution of the application, she stated that in the request for reconsideration Applicant "argued against genericness and, in the alternative, against the descriptiveness refusal under Section 2(e)(1). ... Finally, Applicant noted that the mark has acquired distinctiveness in the

alternative....” Brief, 7 TTABVUE 4-5. The Examining Attorney did not rely on Applicant’s claim of acquired distinctiveness as a concession that the mark is merely descriptive. In his brief Applicant continues to argue, *inter alia*, that his mark is suggestive rather than descriptive (“the mark creates a unique impression that leads consumers to engage in additional thought and imagination to garner the meaning of the mark”). *Id.* at 8.

In view of the foregoing, we will treat Applicant’s claim of acquired distinctiveness as being made in the alternative, and therefore the claim does not act as a concession that his mark is not inherently distinctive. *See In re Binion*, 93 USPQ2d 1531, 1538 (TTAB 2009) (although applicant did not couch his Trademark Act §2(f) claim in the alternative, because applicant and examining attorney treated the claim as an alternative one Board did as well); *See also* TBMP §1215 (2016) regarding alternative positions.

C. Supplemental Register

Applicant also stated in his brief, at 5 TTABVUE 2, that “to the extent that Applicant’s mark is deemed ‘merely descriptive’ Applicant asks that this matter be remanded to allow Applicant to amend its [sic] application for registration on the Supplemental Register.” He repeated this request as the last paragraph of the Conclusion of his brief. *Id.* at 10. The Board, noting this, issued an order on September 6, 2016, 9 TTABVUE, advising Applicant that once the Board issues a decision on appeal, an application will not be reopened except for entry of a disclaimer or upon order of the Director, and therefore that Applicant could not wait until the

Board issued its decision in the appeal before amending his application to the Supplemental Register. *See In re Eximius Coffee, LLC*, 120 USPQ2d 1276 (TTAB 2016) (application remanded for consideration of amendment in the alternative to the Supplemental Register). *But see In re Integrated Embedded*, ___ USPQ2d ___, Serial No. 86140341 (September 27, 2016) (applicant advised of option to amend to Supplemental Register during prosecution of application but did not do so; reservation of a right does not constitute an amendment in the alternative). The Board allowed Applicant ten days to file a request for remand so that he could file an amendment to the Supplemental Register in the alternative.³ Applicant did not do so, and therefore proceedings in the appeal resumed, and we issue this decision.

Accordingly, there are three issues on appeal: whether Applicant's proposed mark is generic and, if it is not, whether it is merely descriptive and, if it is, whether Applicant has shown that it has acquired distinctiveness.

³ The Board also explained that the better practice for an applicant in such a situation is to file a request for remand in a separately captioned paper, rather than including it as a paragraph within the body of a brief and, to preserve its right to amend the application to the Supplemental Register if the Board affirms the refusal under Section 2(e)(1), state that the amendment to the Supplemental Register is in the alternative. That way if, upon remand, the Examining Attorney approves the alternative amendment to the Supplemental Register, and the Board subsequently affirms the refusal on the ground that the mark is merely descriptive, the application can proceed to registration on the Supplemental Register, since the Examining Attorney would have already examined the acceptability of the mark for registration on that register.

II. Analysis

A. Doctrine of Foreign Equivalents

As noted, Applicant's mark is in a foreign language. The Examining Attorney has made of record an excerpt from a Persian-English dictionary showing that this word, which appears in the dictionary depiction to be identical to the mark shown in Applicant's drawing, means "auction" or "sale."⁴ Applicant has stated in his application that the mark consists of "Arabic script which transliterates to HARAJ," and that "the English translation of 'HARAJ' in the mark is 'AUCTION' or 'SALE'."⁵ Applicant also acknowledges in his brief that "the symbols [comprising his mark] represent characters from the Farsi Alphabet, which in turn, transliterates to 'haraj' in the Latin alphabet." 5 TTABVUE 8. Therefore, we must consider whether the doctrine of foreign equivalents applies.

Under the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine genericness, descriptiveness, and similarity of connotation in order to ascertain confusing similarity with English word marks. *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005). Although words from modern languages are generally translated into English, the doctrine of foreign equivalents

⁴ March 10, 2015 Office action, p. 2.

⁵ We note that in both his request for reconsideration filed January 27, 2016 and in his brief Applicant states, "Thus, even assuming without conceding that Applicant's design mark transliterates to the word 'haraj', and the English equivalent put forth by the Examining Attorney is 'sale' or 'auction'..." Brief, 5 TTABVUE 5. Applicant has, in fact, acknowledged that the mark transliterates to "haraj" and that this word means "sale" or "auction," as set forth in the description of the mark and translation he provided in his application.

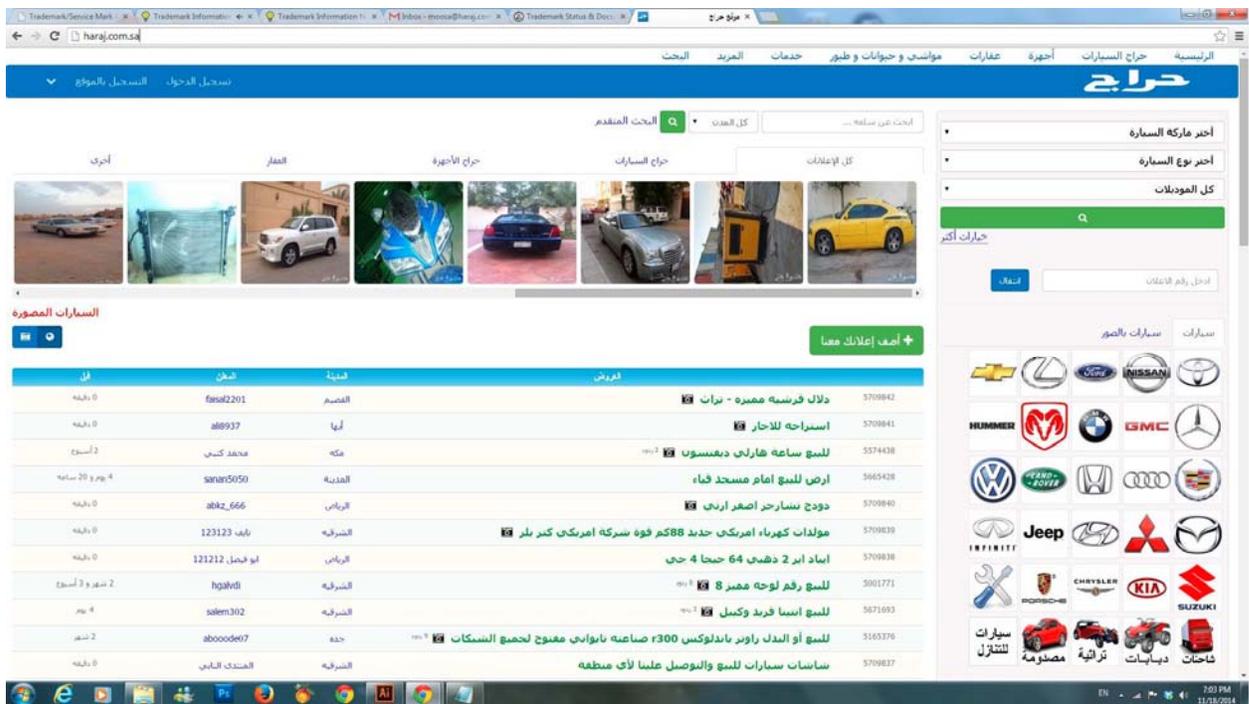
is not an absolute rule. The doctrine is applied only when it is likely that the ordinary American purchaser would “stop and translate” the word into its English equivalent. *Id.* It is not applicable when even those American purchasers who are proficient in the language would ordinarily not translate the mark. For example, the term CORDON BLEU has such a well-established alternative meaning that the literal translation is irrelevant because even French speakers would not translate the mark. *Cont'l Nut Co. v. Cordon Bleu*, 494 F.2d 1397, 181 USPQ 647 (CCPA 1974). *See also*, *In re Tia Maria, Inc.*, 188 USPQ 524 (TTAB 1975) (no likelihood of confusion between TIA MARIA for a Mexican restaurant and AUNT MARY'S for canned vegetable); *In re Pan Tex Hotel Corp.*, 190 USPQ 109 (TTAB 1976) (because LA POSADA is used directly above “motor hotel” in signage and advertising, purchasers would not stop and translate it into its English equivalent).

Applicant argues that the doctrine is not applicable here because Persian is “an obscure language and therefore not likely to be translated by the ordinary American purchaser.” Brief, 5 TTABVUE 7.⁶ Applicant points to a publication by the U.S. Census Bureau entitled “Language Use in the United States: 2011,” American Community Survey Reports, which states that of the 60.6 million people who speak

⁶ Applicant, apparently referencing the cases which refer to whether a consumer would “stop and translate” a mark in a foreign language, has argued that because Persian is an obscure language it is not likely to be translated by the ordinary American purchaser. However, as the examples discussed above show, that is not what the courts and Board mean when addressing whether a term would be translated.

a language other than English at home, only .7% speak Persian.⁷ As a result, Applicant contends that Persian is an obscure language.

However, the Examining Attorney has submitted a 2006 article from “The Trademark Reporter” which concludes, “Languages once thought to be obscure, such as Farsi and Arabic, are now in common use in American society, especially in urban areas.”⁸ More importantly, Applicant’s own specimen, depicted below, shows that his services are advertised in Arabic characters; in fact, except for some user names of the people who are advertising their goods, the entire website appears in Arabic script.



⁷ Request for reconsideration filed January 27, 2016, pp. 17-32.

⁸ E. J. Rest, “Lost in Translation: A Critical Examination of Conflicting Decisions Applying the Doctrine of Foreign Equivalents,” 96 TMR 1211 (Nov.-Dec. 2006), February 12, 2016 Office action, p. 57.

This specimen was submitted to show use of Applicant's mark in the United States, and therefore we must assume that the audience for the services would understand the mark. In response to the Examining Attorney's assertion that "Applicant is inherently assuming enough people will speak and read [Persian] to keep Applicant in business, and to attract enough consumers," February 12, 2016 Office action, p. 1, Applicant states:

However, even if true, this analysis is irrelevant to whether the "ordinary American purchaser would stop and translate the foreign word into its English equivalent." The Applicant's determination that offering its [sic] services in commerce in the United States is a worthwhile business venture, does not negate the fact that the ordinary American consumer is not likely to see Applicant's mark, immediately transliterate the mark to its phonetic equivalent, and then subsequently link that mark to the English word "sale" or "auction." The Examining Attorney's assumptions about Applicant's business decisions are therefore not relevant to the legal issues present in this matter.

Brief, 5 TTABVUE 8.

To the extent that Applicant is contending that most American consumers are not familiar with the Persian language, that argument is not persuasive. Applicant's own specimens show that consumers of classified advertising services include people who are able to read Persian, and that Applicant's services, in particular, are directed to such consumers. Therefore, we find that in connection with the services at issue herein Persian is not an obscure language.

Accordingly, we find that the doctrine of foreign equivalents applies to Applicant's mark, and that the mark is the equivalent of "sale" or "auction." Henceforth, we will use the English language terms in determining the issues of genericness and descriptiveness.

B. Generic Refusal

A generic term “is the common descriptive name of a class of goods or services.” *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). “The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question.” *Id.* To determine whether a term is generic requires a two-stop 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.* A term can be generic for a genus of goods or services if the relevant public understands the term to refer to a key aspect of that genus—e.g., a key good that characterizes a particular genus of retail services. *In re Cordua Rests, Inc.* 823 F.3d 594, 118 USPQ2d 1632, 1637 (Fed. Cir. 2016).

Because the determination of genericness must focus on the description of services as set forth in the application, *see In re Cordua Rests. LP*, 118 USPQ2d at 1636, the identification of goods or services is often viewed as the genus. We see no reason to deviate from that approach in this case. Certainly neither Applicant nor the Examining Attorney has suggested that the identification should not be treated as the genus. To the contrary, in the Office action mailed July 17, 2015, the Examining Attorney stated: “the application identifies the good and/or services as ‘Classified advertising services,’ which adequately defines the genus at issue.” Applicant states

that “the genus of [his] services is: ‘*Classified advertising services*.’” Brief, 5 TTABVUE 5.⁹ The genus, then, is “classified advertising services.”

The second question is whether the proposed mark is understood by the relevant public primarily to refer to that genus. In support of her contention that SALE or AUCTION will be understood to refer to “classified advertising services,” the Examining Attorney has submitted definitions and a Wikipedia entry for “classified advertising” and excerpts from websites showing classified advertising in which people offer items for sale or auction.

Because the evidence is critical to an assessment of the public’s understanding, we review it in detail.

Office action mailed July 17, 2015:

KSL.com Classifieds: These webpages list goods and services grouped (classified) by category, e.g., “Announcements,” “Appliances,” “Baby,” “Home and Garden.” pp. 2-8. There is no category called “Auction” or “Sale.” The only reference we found to either “auction” or “sale” is a listing for “Auctions” under the heading “Announcements,” along with, *inter alia*, “Bands Seeking Members,” “Grand Openings” and “School Events.”

TraderOnline, p. 9, which has the slogan “Your One Stop Source for millions of classifieds,” allows one to click on “Sell It” and “Research It.”

The Washington Free Classifieds website, pp. 10-13, has such headings as “Events,” “Community,” “Real Estate,” “Vehicles For Sale” and “For Sale.” There is a listing under the “Events” heading for “Auction,” along with, *inter alia*, “Comedy,” “Fundraising,” “Garage/Yard Sale,” “Music” and “Social.”

⁹ At one point in his brief Applicant asserts that “the Examining Attorney misidentified the class or genus of services at issue,” 5 TTABVUE 5, but since the Examining Attorney identified the genus to be the same as Applicant did, we give no consideration to this assertion.

Q-C Online Auction and Free Classifieds, pp. 14-16, makes a distinction between Classifieds and Auctions. The headings for its listings include “Stuff for sale,” “Services,” “Transportation,” “Places to live” and “Sales.” The category heading of “Sales,” as opposed to other category headings which have listings of items under them, appears as only the single word at the bottom of a column. Under the heading of “Employment” is the term “Sales,” but since it appears along with “Part-time,” “Full-time” and “Jobs wanted,” it is clear that this describes a job in sales, rather than a category of classified advertising.

Office action mailed February 12, 2016:

The ebay website, pp. 4-9, informs readers that they may advertise with classified ads on eBay and eBay Classifieds, and that “Classified ads are a great way to list items, services, or properties for sale without creating an auction-style or fixed price listing.” There is no category information on the pages submitted by the Examining Attorney that would indicate that “Auction” is a type or subset of classified advertising.

The Brookhaven National Laboratory Classified Ads pages, pp. 10-11, provides information about its classified advertisement policies. Although the word “Sales” appears at certain points in the policy statement, it is in the nature of the general policy rather than as a category, e.g.: “Sales’ shall constitute all ads submitted and listed under the following headings: Motor Vehicles & Supplies, Boats & Marine Supplies, Furnishings & Appliances, Tools, House & Garden, Sports, Hobbies & Pets (limited to animals available for U.S. commercial sale) Audio, Video & Computers, Miscellaneous, Yard & Garage Sales.” With respect to real estate, the statement reads that “Real Estate’ shall constitute all ads submitted and listed under the following headings: ·For Sale ·For Rent.”

The Brass Bands website, pp. 12-13, has a page headed “Classified Ads” followed by links listed as “For Sale” and “Wanted.” There are subheadings of “Brass Band Instruments For Sale” and “Brass Band Instruments Wanted.”

There is what appears to be an Archive listing from motorsportmagazine, pp. 14-18, from May 1946 and states that “After this issue the Readers’ Sales and Wants advertisements will be discontinued.” Given the indication that such use was discontinued in 1946, it has little probative value in terms of showing how people would refer to classified advertising services today.

The Financial News and Daily Record website, pp. 19-22, lists, under “Classified Advertising,” various categories for classified ads, including “Attorneys,” “Business Opportunities,” “Condominiums,” “Employment,” “For Sale,” “Office Space,” “Rentals,” and “Sporting Goods.”

The website for North Carolina Woodworker, pp. 23-24, lists, under its “Classified Ads Policy,” that advertisements “must be placed in an appropriate category and are limited to woodworking-related items or services that are **For Sale**, or **Wanted** or are offered **Free** to fellow members.” (emphasis in original). It is not clear whether the terms in bold are meant to be or would be viewed as the names of the categories, as many of the words in this policy section appear to be in bold type for emphasis.

There are two pages from the website of the SunSentinel, pp. 25-26, that were made of record. The first page is headed “Auction” and has the text “Ideal For Promoting a public auction” and “What you get · Full run print ad in Sun Sentinel · Online ad on sunsentinel.com · Design enhancements available.” There is also a “button” marked “Buy Now.” The second page lists “Deadlines” for submission of ads, and a separate section on that page is headed “Classifieds.SunSentinel.com” and says “Classifieds SunSentinel.com is the online home to all classified advertisements that are featured in print. Classifieds SunSentinel.com offers a place for consumers to view merchandise for sale, announcements, service directory listings and more.” It is not clear from the submitted pages how “Auction” relates to classified advertising services.

The website www.reptilering.com, pp. 27-28, has the title “Reptile Ring,” below which are the words “Buy – Sell – Auction,” and states that it “is a coalition of the best breeders coming together to offer top quality, captive-bred reptiles in an exciting reptile auction format.” It makes a distinction between auctions and classified ads, in that the site “allows auctions, from the exciting, fast paced, overtime no reserve auctions to the more traditional reserve auctions and classified advertisements.”

The Los Angeles Post website, pp. 29-34 has the main heading “Classified Advertisements,” with such sub-headings as “Auctions,” “Auto,” “Domain Names/Internet,” “Fitness/Health,” “Insurance” and “Motorcycle Gear.”

A close examination of this evidence shows that there are very few instances in which “sales” or “auction” could be considered generic terms for classified advertising services. In fact, the word “Sale” does not appear at all in the excerpts as a category of classified services. Rather, it is used as part of a phrase, such as “Stuff for Sale” or “For Sale” for the variation “Sell It.” As noted above, there is a single use of “Sales” in the Q-C Auction excerpt that might be a category listing, but it is not clear because, as opposed to the other category headings, there are no items listed under “Sales.” In any event, this single use of “Sales” is insufficient to show that “Sale” or “Sales” is commonly understood by consumers primarily to refer to the genus of classified advertising services. As for the term “auction,” as noted, many of these sites make a distinction between auctions and classified ads, thereby indicating that auctions, and sales by auction, are different from a classified advertising platform for offering goods or services. The KSL.com and Washington Free Classified excerpts list “auctions” under the category subheadings “Announcements” and “Events,” but the manner in which this term appears, with such other terms as “Bands Seeking Members,” “Grand Openings,” “Comedy” and “Social,” makes it unlikely that consumers would view “auctions” as referring to the genus of classified advertising services. In fact, only the Los Angeles Post excerpt uses “Auction” in the traditional manner of a category for classified advertisements, and this single example is insufficient to demonstrate that “Auction” is commonly understood as the term for this genus of services.

Accordingly, the evidence submitted by the Office falls short of showing that SALE or AUCTION is a generic term for classified advertising, or classified advertising

services. The limited amount of evidence that AUCTION or SALES has been used as category names for classified ads is simply insufficient for us to find that the Office has demonstrated that SALE or AUCTION is understood by the consuming public to primarily refer to classified advertising services. *See In re Merrill Lynch, Pierce, Fenner & Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987).

C. Descriptiveness Refusal

A term is merely descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the goods or services it identifies. *See, e.g., In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered to be merely descriptive; rather, it is sufficient that the term describes one significant attribute, function or property of the goods or services. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). Moreover, if the mark is descriptive of any of the goods or services for which registration is sought, it is proper to refuse registration as to the entire class. *In re Analog Devices Inc.*, 6 USPQ2d 1808 (TTAB 1988), *aff'd* without pub. op., 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989). Descriptiveness determinations are made in relation to an applicant's identified goods and/or services, the context in which the mark is being used, and the possible significance the mark would have to the average purchaser because of the manner of its use or intended use. *See In re Chamber of Commerce of*

the U.S., 102 USPQ2d at 1219 (citing *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963-64, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)). Descriptiveness is not considered in the abstract. *In re Bayer Aktiengesellschaft*, 82 USPQ2d at 1831. In other words, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them. *DuoProSS Meditech Corp. v. Inviro Medical Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012).

The evidence submitted by the Examining Attorney as well as Applicant's specimen show that SALE describes a major characteristic of classified advertising services, namely, these terms immediately tell potential buyers that the purpose of the classified advertising services is to sell their goods or services, and the mark also immediately tells consumers of the classified advertising services that goods or services are being offered for sale. As a result, Applicant's mark is merely descriptive of the services. We note Applicant's statement that his mark is "at most, suggestive of only one type of classified advertisement that Applicant's consumers may publish via Applicant's services in connection with the relevant mark." Brief, 5 TTABVUE 5. However, as stated above, a term need not describe every feature of the applicant's goods or services to be found merely descriptive; if a mark is descriptive of any of the goods or services for which registration is sought, it is proper to refuse registration as to the entire class. There is no question that "sales" are one of the features of Applicant's services. Thus, Applicant's mark immediately tells consumers that a

primary characteristic of his classified advertising services is to sell goods and services.

Applicant also argues that “a mental process involving imagination, thought, and perception is required to associate Applicant’s mark with features of Applicant’s goods services [sic].” Brief, 5 TTABVUE 9. It appears to be Applicant’s contention that his mark is suggestive because it would take mental steps for consumers to first understand that the “design” is a word in Arabic characters, then transliterate the characters to “haraj,” then translate “haraj” to “sale” or “auction,” and then connect the word to a function or feature of Applicant’s services. *See* request for reconsideration filed January 27, 2016, p. 10. We are not persuaded by this argument. Someone who can read and understand Persian will immediately understand that the mark is the Persian word for “sale” or “auction,” and that the mark, as used for classified advertising services, directly describes a primary characteristic of the services, namely, that Applicant’s identified classified advertising services are for the sale or auction of goods and services. Thus, we find that Applicant’s mark is merely descriptive.

D. Acquired Distinctiveness

Applicant asserts in his brief that, even if his mark is found to be merely descriptive, it has acquired distinctiveness because “Applicant has used the same or similar mark in commerce for at least 5 years.” Brief, 5 TTABVUE 5. Applicant also notes that the date of first use of his mark in commerce, as claimed in his application, is January 2007. As previously discussed, during prosecution Applicant’s claims of

acquired distinctiveness were limited to the statement in his June 15, 2015 response that “The mark has become distinctive of the goods/services through the applicant’s substantially exclusive and continuous use in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement,” and the statement in his July 21, 2015 response that “The mark has become distinctive of the goods/services as evidenced by the ownership on the Principal Register for the same mark for sufficiently similar goods/services of active U.S. Registration No(s). 4361307.” Applicant has not provided any further information about his use of the mark, such as any efforts made in advertising his services and any money spent for such efforts, or the number of consumers who have used his services, any revenue from the use of his services or exposure to his mark. Applicant apparently no longer relies on acquired distinctiveness based on his registration, as he did not refer to the registration in his appeal brief, presumably because the Examining Attorney had previously questioned the probative value of that registration.¹⁰

It is Applicant’s burden to prove that his mark has acquired distinctiveness. Moreover, the greater the degree of descriptiveness a term has, the heavier the burden to prove it has attained secondary meaning. *See Yamaha Int’l Corp. v.*

¹⁰ In the denial of Applicant’s request for reconsideration, mailed February 12, 2016, p. 1, the Examining Attorney asserted that in seeking his prior registration Applicant claimed HARAJ had no meaning, and that “the evidentiary and factual basis for such a registration is therefore inaccurate” and “such a registration does not have bearing here where the mark is different and competent evidence indicates HARAJ *does* have a relevant translation.” (emphasis in original). Applicant made no further claim of acquired distinctiveness based on the registration.

Hoshino Gakki Co. Ltd., 6 USPQ2d at 1008. Although we do not accept the dissent's position that SALE is generic for these services, the evidence shows that Applicant's mark is highly descriptive indeed. As noted, "For Sale" is included as a category by several offerors of classified advertising services, and it is hard to imagine that "Sale" per se would be capable of acquiring distinctiveness. Certainly a mere statement of five years of substantially exclusive and continuous use of the mark is not sufficient for us to find that Applicant's mark has acquired distinctiveness.

Accordingly, we find that Applicant has not shown that his applied-for mark has acquired distinctiveness as a trademark for classified advertising services.

III. Conclusion

We find that Applicant's proposed mark is not generic, and reverse the refusal of registration on that ground. However, we find that the mark is merely descriptive of Applicant's identified services, and that Applicant has not shown that it has acquired distinctiveness. Accordingly, we affirm the refusal on the ground of mere descriptiveness.

Decision: The refusal to register Applicant's mark under Section 2(e)(1) of the Trademark Act on the ground that it is merely descriptive is affirmed.

Opinion by Adlin, Administrative Trademark Judge, dissenting in part:

While I concur with the majority's decision to apply the doctrine of foreign equivalents, and its affirmance of the refusal to register because Applicant's mark is merely descriptive and without secondary meaning, I would affirm the genericness

refusal, and therefore respectfully dissent. The record leaves no doubt that “classified advertising services” encompass sales and auctions (**حراج** in Persian), or that sales and auctions are among the most prominent and popular classifications of the ads Applicant and his competitors provide.

Indeed, the Wikipedia entry for “classified advertising” indicates that classified “advertisements are grouped into categories or *classes* such as ‘**for sale**—telephones’ ... hence the term ‘classified.’ Classified ads generally fall into two types: individuals **advertising sales** of their personal goods, and advertisements by local businesses.” Denial of Request for Reconsideration, Feb. 12, 2016 (bold highlighting added, italics in original). The entry goes on to explain that classified ads are becoming increasingly specialized, “with sites providing advertising platforms for niche **markets of buyers and sellers.**” *Id.* (emphasis added).

The following classified ads and related materials of record, with highlighting added, are illustrative:

<http://www.motorsportmagazine.com/archive/article/may-1946/23/readers-sales-and-wanted-advertisements>
02/07/2016 11:37:36 AM

Related articles

Page 16, August 1937

Have you a Used Car for Sale? Then why not Advertise it?

Have you a **Used Car for Sale?** Then why not Advertise it? TURN TO OUR **CLASSIFIED ADVERTISEMENT SECTION** A 2 inch Single Column will cost you only 1 per insertion.

KSL TV • KSL Newsradio • KSL Live! • KSL Shows • Witness • Mobile

KSL.com » Classifieds

Utah Page Two U.S. World Sports Weather Traffic Biz Pics & Fix Outdoors Latino

Classifieds Cars Homes Jobs

Keyword: _____ Zip: _____ Miles From: _____ Price: _____ Seller: _____ All: _____ Submit

Announcements	Total Ads	General	Total Ads
Auctions	61	Antiques	2,494
Bands Seeking Members	120	Arts & Crafts	1,401
Boutiques	57	Barber Shop	513
Charity	101	Beauty & Nutritional Products	1,194
Garage, Estate, & Yard Sales	2,561	Business: Established Business For Sale	168
Grand Openings	41	Business: For Sale	290
Legal Notices	20	Business: Franchises	29
Lost & Found	218	Ceramics/Porcelain/Glass/Pottery	682
Pageants/Talent Shows/Auditions	28	Coins & Stamps	251
Performances & Gigs	144	Collectibles	2,402
Reunions	21	Coupon Books	62
School Events	24	DJ Equipment	177
		Entertainers	541
Appliances	8,855	Hair Salon	513
Post an Ad to this section >	Total Ads	Handcrafted Goods	389
Appliance Repair	163	Junk For Sale	445
Dishwashers	377	Junk Removal	400
Fireplaces/Wood Burning Stoves	242	Medical Equipment	1,036
Microwaves	430	Music Instruction	619

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Classified Advertising

REACHING THE TARGETED BUSINESS AUDIENCE YOU NEED TO GET RESULTS IS EASY!

The classified section is the perfect place to promote your product or service to customers who are actually looking to buy, sell or trade. Choose the classification that helps your advertisement reach its target market.

- Announcements/Notices
- Financial Investments
- Attorneys
- Automobiles/Boats/Motorcycles
- Business Opportunities
- Condominiums
- Employment
- For Sale
- Office Space
- Real Estate
- Rentals
- Services
- Sporting Goods
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- ClassicCars.com Classic Cars

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RESEARCH IT

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http://washingtondc.freeclassifieds.com/default.aspx 07/17/2015 02:46:03 PM

http://qconlineauction.com/ 07/17/2015 02:46:55 PM

The screenshot shows the North Carolina Woodworker website. At the top left is the logo for North Carolina Woodworker. Below it is a navigation menu with links for Home, Articles, Forum, Blogs, Gallery, Classifieds, What's New?, and Policy. A search bar is located at the top right. Below the navigation menu is a banner for West Penn Hardwoods, Inc., advertising a large selection of fine exotic and domestic lumber and turning stock. The main content area displays the 'Classified Ads Policy' page, which includes a welcome message, a notice about registration requirements, and the full text of the classified ads policy. The policy states that members with 'User' privilege level can place ads, but they must be woodworker-related and cannot include links to off-site auction sites or public sales websites. It also mentions that ads are limited to one-time sale of woodworker items and that members should consider reducing prices before renewing ads.



Classified Ad Policy & FAQ

Who may place an Ad?

Active and retired employees of Brookhaven National Laboratory, on-site employees of Brookhaven Science Associates (BSA), and the U.S. Department of Energy, and permanent employees of service organizations on site may place classified advertisements.

Is the content of ads reviewed for approval/acceptability?

Yes, BSA reserves the right to edit or reject any classified advertisement that is not up to standards or deemed suitable. Examples of unsuitable ads may include, but not be limited to, the solicitation of signatures for a petition or funds for political and/or charitable causes, or the sale of firearms or alcohol. However, such review or approval does not constitute an endorsement by BSA. BSA is not responsible for agreements or transactions executed in part or in full based on classified advertisements. Services are neither screened nor recommended by BSA.

How many ads can I place?

Employees may enter several advertisements in any or all categories.

What is the process?

Fill out each form completely, checking the appropriate boxes and providing all the information requested. Ads are typically reviewed one time per day on regular business days.

What happens when an ad is approved?

- ▶ Each advertisement will appear on the classified ad site for seven days from the time it is reviewed and approved for posting after which it will be automatically removed.
- ▶ If an employee would no longer like the ad to be posted, the employee can remove the ad.
- ▶ Each advertisement is run only once and must be resubmitted by the employee to be repeated.

Please note the following rules per type of ad

1. Sales and Notices:

- ▶ "Sales" shall constitute all ads submitted and listed under the following headings: Motor Vehicles & Supplies, Boats & Marine Supplies, Furnishings & Appliances, Tools, House & Garden, Sports, Hobbies & Pets (limited to animals available for U.S. commercial sale), Audio, Video & Computers, Miscellaneous, Yard & Garage Sales.
- ▶ "Notices," including Lost & Found, Free, Community Involvement, Car Pools, Wanted, Farewell Gatherings, Happenings, and In Appreciation, are subject to review and approval by BSA. In the Community Involvement category, employees, retirees, and visiting facility-users may advertise community, charity, and club events and sales in which they are involved. Any proceeds from these sales must go to that nonprofit entity.
- ▶ Items offered for sale or mentioned within notices must be owned by the employee who is advertising

The screenshot shows the eBay website's help section. At the top, there are navigation links for 'Hit Sign in Or register', 'Daily Deals', 'Gift Cards', 'Sell', and 'Help & Contact'. The eBay logo is on the left, and a search bar is in the center. Below the search bar, there are links for 'Home', 'Help', 'Selling & seller fees', 'Selling basics', and 'Advertising with classified ads on eBay and eBay Classifieds'. The main heading is 'Help'. On the left, there is a 'Browse help' sidebar with categories like 'Searching & researching', 'Bidding & buying', 'Selling & seller fees', 'Payment & shipping', 'Feedback', and 'Membership & account'. The main content area is titled 'Advertising with classified ads on eBay and eBay Classifieds'. It includes a search bar for help pages, a list of 'In this article' topics, and a paragraph explaining that classified ads are a great way to list items, services, or properties for sale without creating an auction-style or fixed price listing. A table titled 'Choosing eBay.com or eBay Classifieds' is partially visible at the bottom. On the right, there are sections for 'Contact us', 'Ask eBay members', and 'Related help topics'.

As I see it, this evidence establishes that:

One category or classification¹¹ used by those who provide
 “classified advertising services” is “Sale” or “For Sale.”¹²

¹¹ Whether “For Sale” or the equivalent is a major heading/category/classification or a subheading/subcategory/subclassification is not particularly relevant. The point is that the relevant public understands “Sale,” “Sell,” “For Sale” and equivalent terms as classifications of classified ads (and related services).

¹² The majority’s clear suggestion that the “for sale” and “stuff for sale” classifications used by certain providers of classified advertising services are not evidence of genericness, because the word “sale” is preceded by the word “for,” is dubious. The suggestion is unsupported by any evidence, entirely unexplained and belied by the way American English is typically used to describe goods or services offered to be sold (i.e. “for sale”). In the context of classified advertising services, the term “sale” is generic for ads offering goods or services for sale, whether the word “for” precedes the word “sale” or not.

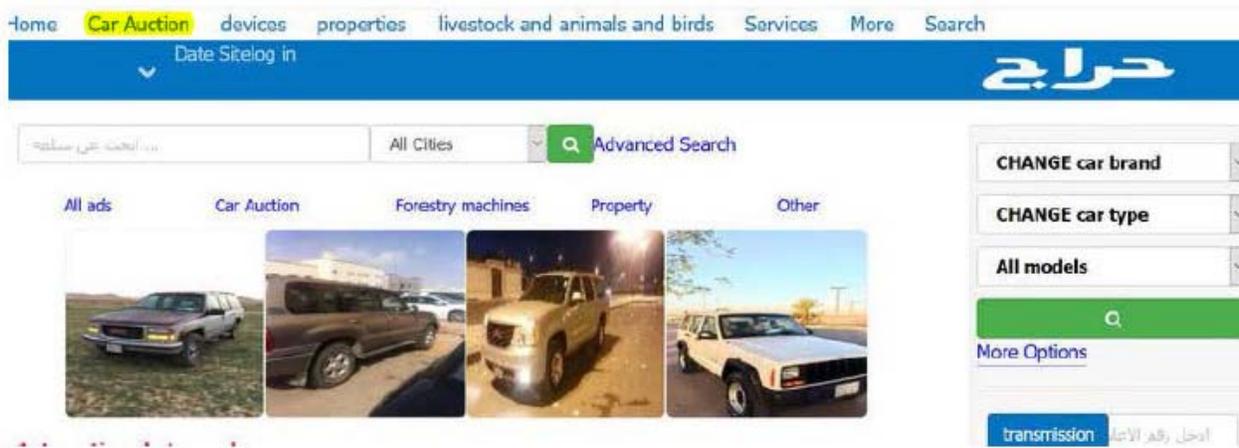
Sales are a major and perhaps even the most prominent classification of a number of classified ad listings, so much so that even though it features non-sale categories such as “Announcements,” the ksl.com classified ads feature at the very top of the page a search tool allowing users to search by “price” and “seller,” and similarly even though the “freeclassified.com” ads have non-sales categories, the site’s slogan, at the top of its page, is “sell anything ... and sell it for FREE.”

“Auctions” are a related classification of and method of selling via classified ads, with the “qconlineauction.com” site classifying two methods of selling “stuff” – via “classifieds,” or via “auctions” (which are themselves a category of the classified ads). Ebay.com identifies sales via classified ads as an alternative to “auction-style listings” (an alternative classification of ads).

Many classified ads not appearing under the heading “For Sale” or the equivalent are nonetheless classified ads offering goods or services for sale, such as the subheading “Houses for Sale” under the major heading “Real Estate” in “freeclassifieds.com,” and as explained on the Brookhaven National Laboratory Classified Ads site (“Sales’ shall constitute all ads submitted and listed under the following headings: Motor Vehicles & Supplies, Boats & Marine Supplies, Furnishings & Appliances ...”).

Applicant’s translated specimens reveal that Applicant himself uses the Persian word for “auction” generically as a category of his customers’ classified ads

(highlighting added):



It is also at least somewhat relevant that some of Applicant’s customers’ ads use the Persian word for “sale” generically to classify their ads:



Applicant’s and third parties’ use of the terms “sale” and “auction” in the context of classified advertising establishes that sales and auctions are an important, and sales are perhaps even the most important, category and feature of classified advertising services. “The Board has often held that a term that names the ‘central focus’ or ‘key aspect’ of a service is generic for the service itself, and the Board’s principal reviewing court has approved this approach.” *In re Meridian Rack & Pinion*,

114 USPQ2d 1462, 1464 (TTAB 2015). *See also In re Hotels.com LP*, 87 USPQ2d 1100 (TTAB 2008), *aff'd*, 573 F.3d 1300, 91 USPQ2d 1532 (Fed. Cir. 2009) (hotels.com generic for “providing information for others about temporary lodging; travel agency services, namely, making reservations and bookings for temporary lodging for others by means of telephone and the global computer network”); *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985) (BUNDT generic for ring cake mix); *In re CyberFinancial.Net, Inc.*, 65 USPQ2d 1789 (TTAB 2002) (BONDS.COM generic for “providing information regarding financial products and services via a global computer network”); *In re A La Vielle Russie Inc.*, 60 USPQ2d 1895 (TTAB 2001) (RUSSIANART generic for “dealership services in the field of fine art, antiques, furniture and jewelry”); *In re Central Sprinkler Co.*, 49 USPQ2d 1194, 1197 (TTAB 1998) (“The broad general category of goods involved here is sprinklers for fire protection. However, a product may be in more than one category, and here applicant’s goods also fall within the narrower category of sprinklers for fire protection of attics. We find that the term ‘attic’ would be understood by the relevant public as referring to that category of goods.”); *In re Hask Toiletries, Inc.*, 223 USPQ 1254, 1255 (TTAB 1984) (HENNA ‘N’ PLACENTA generic for hair conditioner, because “that designation accurately describes the two key elements of the product to which applied”). Moreover, Applicant’s competitors have a need to use the terms “sale,” “for sale,” “auction,” etc. to the extent they offer the ability to sell or auction goods or services via classified ads. *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999); *see also In re Cordua Rests., Inc.*, 823 F.3d 594, 118

USPQ2d 1632, 1639 (Fed. Cir. 2016) (affirming refusal to register CHURRASCOS for restaurant services in part because registration “would give Cordua rights that it could enforce against all others providing restaurant services, including operators of traditional Latin American churrascarias (churrasco restaurants) that specialize in meat grilled in the churrasco style”).

The majority appropriately cites *Cordua* for the proposition that “a term can be generic for a genus of goods or services if the relevant public ... understands the term to refer to a key aspect of that genus” *In re Cordua Rests.*, 118 USPQ2d at 1637. But the majority does not apply this holding, apparently believing either that the terms “sales” and “auction” do not refer to a key aspect of classified advertising services, or that these terms are too amorphous or general to be generic for Applicant’s services. This is where I part ways – the evidence of record makes clear that sales and auctions are key aspects of classified advertising services, and that they fall squarely within the broad genus Applicant chose for his identification of services.

Cordua argues that even if “churrascos” is generic as to “churrasco restaurants” (also known as “churrascarias”), it is not generic as to all restaurant services. But a term is generic if the relevant public understands the term to refer to part of the claimed genus of goods or services, even if the public does not understand the term to refer to the broad genus as a whole. Thus, the term “pizzeria” would be generic for restaurant services, even though the public understands the term to refer to a particular sub-group or type of restaurant rather than to all restaurants ... We do not, of course, suggest that the term “churrascos” is necessarily generic as to any and all restaurant services. Had another applicant applied for registration of the mark CHURRASCOS in connection not with the entire broad

genus of restaurant services but instead with a narrower sub-genre of restaurant at which grilled meat is not a key aspect of the service provided – for example vegetarian or sushi restaurants – the result could well have been different.

Id. at 1638-39.

Here, Applicant seeks registration for the “broad genus” of “classified advertising services,” without qualification or limitation, and “the question of genericness must be evaluated accordingly.” *Id.* at 1639. Because the record establishes that the relevant public understands “sales” and “auctions” to refer to sub-groups, and in fact “key aspects,” of “classified advertising services,” his mark is generic and the refusal to register on that basis should be affirmed.