

**This Opinion Is Not a  
Precedent of the TTAB**

Hearing: September 28, 2022

Mailed: July 28, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Nike, Inc.*  
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Serial No. 88781464  
Serial No. 88781470  
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Helen Hill Minsker and Michael J. Harris of Arnold & Porter Kaye Scholer LLP  
for Nike, Inc.

Mark Sparacino, Trademark Examining Attorney, Law Office 103,  
Stacy Wahlberg, Managing Attorney  
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Before Cataldo, Goodman and Lebow,  
Administrative Trademark Judges.

Opinion by Lebow, Administrative Trademark Judge:

I. Background

Applicant, Nike, Inc., filed applications to register on the Principal Register the term SNKRS (1) in standard characters (the “word mark”), and (2) in the stylized form  (the “composite mark”), for the following services, as amended during prosecution:

Downloadable computer application software for mobile phones and personal digital devices, namely, software for posting articles, commenting on products, articles, viewing images, checking the availability of products, receiving notifications on events, upcoming product releases and order update information, and searching product inventory; downloadable computer application software for mobile phones, namely, software for social networking, receipt and transmission of data, shopping, identifying and tracking product, in International Class 9;


Footwear, in International class 25;

Operating an online marketplace featuring footwear and clothing; on-line retail store services featuring footwear and clothing; retail store services featuring clothing and apparel; pop-up retail store services featuring clothing and footwear; providing consumer product information and related news in the field of sneakers, in International Class 35; and

Providing information, news and commentary in the field of entertainment, popular culture and sports; providing recognition and incentives by the way of awards and contests to demonstrate excellence in the field of fashion and sneaker collection, in International Class 41.<sup>1</sup>

The Trademark Examining Attorney assigned to the applications initially refused registration of the word mark on the ground that SNKRS is merely descriptive of Applicant's services under Section 2(e)(1) of the Trademark, 15 U.S.C. § 1052(e)(1), and he required a disclaimer of "sneakers" for the composite mark under Section 6(a) of the Trademark Act, 15 U.S.C. § 1056(a).<sup>2</sup> The Examining Attorney also advised

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<sup>1</sup> Application Serial Nos. 88781470 (SNKRS) and 88781464 () were filed on January 31, 2020, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming a date of first use anywhere and in commerce of February 2015. The composite mark "consists of the literal element 'SNKRS' located below a stylized curved line design." Color is not claimed.

<sup>2</sup> April 20, 2020 Office action (both applications). Citations to the applications' records are to downloadable .pdf versions of the documents in the Trademark Status and Document Retrieval (TSDR) database of the United States Patent and Trademark Office (USPTO). Citations to the appeal record are from the publicly available documents in TTABVue, the Board's electronic docketing system. *See, e.g., Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473,

Applicant in its application for the word mark that “[i]n addition to being merely descriptive, the applied-for mark appears to be generic” for the goods/services in Classes 25 and 35.<sup>3</sup> Applicant responded by amending both applications to assert claims of acquired distinctiveness in the term SNKRS under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), based on an allegation of more than five years of continuous and substantially exclusive use of SNKRS in commerce and other evidence.<sup>4</sup>

Thereafter, in a new *non-final* Office action issued for the composite mark, the Examining Attorney accepted Applicant’s claim of acquired distinctiveness for the goods in Class 9 and the services recited as “providing information, news and commentary in the field of entertainment, popular culture and sports” in Class 41, but rejected it as to the remaining services in this class. In addition, he maintained the requirement for a disclaimer of SNKRS in Classes 25, 35 and 41 in part, this time on the ground of genericness, though he maintained descriptiveness as an alternative ground for the requirement.<sup>5</sup>

And in a new *final* Office action issued for the proposed word mark, the Examining Attorney similarly accepted Applicant’s claim of acquired distinctiveness for the goods in Class 9 and the services recited as “providing information, news and

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1476 n.6 (TTAB 2014). The number preceding “TTABVUE” corresponds to the docket entry number; the number(s) following “TTABVUE” refer to the page number(s) of that particular docket entry, if applicable.

<sup>3</sup> *Id.* at 2-3.

<sup>4</sup> October 20, 2020 Response to Office action, TSDR 44-76 (both applications).

<sup>5</sup> November 9, 2020 Office action, TSDR 1-4 (Serial No. 88781464).

commentary in the field of entertainment, popular culture and sports” in Class 41, but rejected it as to the remaining services in this class.<sup>6</sup> However, the Office action should not have been marked “final” because Applicant’s claim of acquired distinctiveness raised a new issue, so he issued a new non-final action three days later that superseded the prematurely issued one, but which made the same requirements.<sup>7</sup>

In addition to the genericness refusal (for the word mark) and the requirement of a disclaimer of SNKRS (for the composite mark) in Classes 25, 35 and 41, the Examining Attorney maintained, in the alternative, that if SNKRS is determined not to be generic but is instead merely descriptive, that Applicant’s claim of acquired distinctiveness under Section 2(f) is insufficient.<sup>8</sup>

Applicant then filed requests to divide out the Class 9 goods, and the Class 41 services of “providing information, news and commentary in the field of entertainment, popular culture and sports – the goods and services that the Examining Attorney determined could be satisfied by Applicant’s 2(f) claim and thus avoid his refusals – into new “child” applications, which were granted.<sup>9</sup> Thereafter, Applicant responded to the pending Office actions by deleting its Class 25 goods in

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<sup>6</sup> November 9, 2020 Office action, TSDR 1-4 (Serial No. 88781470).

<sup>7</sup> November 12, 2020 Office action, TSDR (Serial No. 88781470).

<sup>8</sup> November 9, 2020 Office action, TSDR 3 (Serial No. 88781464); November 12, 2020 Office action, TSDR 3 (Serial No. 88781470).

<sup>9</sup> April 28, 2021 Request to Divide (both applications); May 26, 2021 Request to Divide Application Completed (both applications). The child applications for the divided-out goods and services in Classes 9 and 41 subsequently registered under Reg. Nos. 6505204 (word mark) and 6489215 (composite mark) and are no longer at issue in these appeals.

both applications, providing further evidence in support of its 2(f) claim, and arguing against the refusals for the services that remained. Unpersuaded by the responses, the Examining Attorney issued further Office actions making the refusal/requirement “final” for the following services that remained in the applications:

Operating an online marketplace featuring footwear and clothing; on-line retail store services featuring footwear and clothing; retail store services featuring clothing and apparel; pop-up retail store services featuring clothing and footwear; providing consumer product information and related news in the field of sneakers, in International Class 35; and

Providing recognition and incentives by the way of awards and contests to demonstrate excellence in the field of fashion and sneaker collection, in International Class 41.<sup>10</sup>

Applicant filed notices of appeal and requests for reconsideration of the refusals in each application.<sup>11</sup> In the requests, Applicant amended its 2(f) claims to add claims of ownership of the marks in the child applications which had since registered, as well as another registration for the mark SNKSTR for “online retail store services featuring sneakers” that was assigned to Applicant during the course of its prosecution of the applications.<sup>12</sup> Applicant also introduced a Teflon-style survey in support of its arguments against the genericness refusal and the disclaimer

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<sup>10</sup> June 11, 2021 Final Office action (both applications).

<sup>11</sup> 1 TTABVUE (both applications); December 9, 2021 Request for Reconsideration (both applications).

<sup>12</sup> December 9, 2021 Request for Reconsideration, TSDR 36-42, 47-50, 190-243 (Exhibits 10-12, both applications). *See also* note 8 *supra*. Applicant made of record the USPTO file history from its TSDR database. *Id.*

requirement.<sup>13</sup> However, the Examining Attorney denied the requests, maintained the refusals, and the appeals resumed.<sup>14</sup>

Both Applicant and the Examining Attorney filed briefs and an oral hearing was held by the Board. Because these appeals involve common questions of law and fact and the records are substantially similar, we consolidate and decide both appeals in this single decision. *See In re Binion*, 93 USPQ2d 1531, 1533 (TTAB 2009); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1214 (2023).<sup>15</sup>

For the reasons discussed below, we reverse the refusals in each application.

## II. Genericness – Applicable Law

“A generic mark, being the ‘ultimate in descriptiveness,’ cannot acquire distinctiveness, and is not entitled to registration on either the Principal or Supplemental Register under any circumstances.” *In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262, 1264 (Fed. Cir. 2015) (quoting *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986)). A term is generic if it refers to the class or category of goods or services on which it is used. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001) (citing *Marvin Ginn*, 228 USPQ at 528).

The test for determining whether a proposed mark is generic is its primary

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<sup>13</sup> *Id.* at 28-35, 51-84 (Exhibit 1, both applications).

<sup>14</sup> Examining Attorney’s February 11, 2022 Reconsideration Letter (both applications).

<sup>15</sup> Unless otherwise stated, when referring to the same evidence in both applications, we will simply cite to the record in the composite mark application (Serial No. 88781464).

significance to the relevant public. *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1553-54 (Fed. Cir. 1991); *Marvin Ginn*, 228 USPQ at 530. Making this determination “involves a two-step inquiry: First, what is the genus of goods ... 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.*

Any term that the relevant public uses or understands to refer to the genus of goods, or a key aspect or subcategory of the genus, is generic. *Royal Crown Co., Inc. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1046-47 (Fed. Cir. 2018). “[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.” *In re Cordua Rests., Inc.*, 823 F.3d 59, 118 USPQ2d 1632, 1638 (Fed. Cir. 2016) (holding CHURRASCOS, a word that is generic for a type of grilled meat, to be generic for restaurant services because it referred to a key aspect of those services); *see also In re Nordic Nat., Inc.*, 755 F.3d 1340, 111 USPQ2d 1495 (Fed. Cir. 2014) (CHILDREN'S DHA generic for DHA supplements for children); *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985) (BUNDT generic for ring cake mixes, i.e., the subcategory “bundt cakes.”).

“Evidence of the public’s understanding of [SNKRS] may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers, and other publications.” *Royal Crown*, 127 USPQ2d at 1046 (quoting *In re Merrill Lynch, Pierce, Fenner & Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987)); *see also USPTO v. Booking.com B.V.*,

591 U.S. \_\_\_, 140 S. Ct. 2298, 2020 USPQ2d 10729, at \*7 n.6 (2020) (“Evidence informing [a genericness] inquiry can include not only consumer surveys, but also dictionaries, usage by consumers and competitors, and any other source of evidence bearing on how consumers perceive a term’s meaning.”). We may also consider how Applicant itself uses the mark. *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978) (“Evidence of the context in which a mark is used . . . in advertising material directed to the goods is probative of the reaction of prospective purchasers to the mark.”).

However, if the evidence of record, when viewed in its totality, constitutes a mixed use of a term as both the generic name of the goods or services and as a source indicator for such goods or services, then such evidence would not demonstrate that the primary significance of the term is the generic name of the goods or services. *See Merrill Lynch*, 4 USPQ2d at 1143 (“The mixture of usages unearthed by the NEXIS computerized retrieval service does not show ... that the financial community views and uses the term CASH MANAGEMENT ACCOUNT as a generic, common descriptive term for the brokerage services to which Merrill Lynch first applied the term”); *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1765 (TTAB 2013) (“However, when considered in conjunction with the testimony of respondent’s competitors, these uses result in at best a mixed record of use of the phrase both generically and as part of what appear to be trademarks or trade names. This ambiguous evidence thus fails to establish that the primary significance of ANNAPOLIS TOURS to the relevant public is guided tour services of cities, rather



than a guided tour service of cities provided by a particular entity.”); *In re America Online*, 77 USPQ2d 1618, 1623 (TTAB 2006) (“the evidence of generic use is offset by Applicant’s evidence that shows not only a significant amount of proper trademark use but also trademark recognition [by third parties]”).

A. The Genus

Addressing the first part of the *Marvin Ginn* genericness inquiry, the Examining Attorney asserts,<sup>16</sup> and we agree, that the identification of services adequately defines the “genus” of services:

CLASS 35: Operating an online marketplace featuring footwear and clothing; on-line retail store services featuring footwear and clothing; retail store services featuring clothing and apparel; Pop-up retail store services featuring clothing and footwear; providing consumer product information and related news in the field of sneakers.

CLASS 41: Providing recognition and incentives by the way of awards and contests to demonstrate excellence in the field of fashion and sneaker collection.

*See Cordua Rests.*, 118 USPQ2d at 1636 (“[A] proper genericness inquiry focuses on the description of services set forth in the [application or] certificate of registration.”) (quoting *Magic Wand*, 19 USPQ2d at 1552); *In re Reed Elsevier Props. Inc.*, 482 F.3d 1376, 82 USPQ2d 1378, 1380 (Fed. Cir. 2007).

Applicant does not disagree with the Examining Attorney’s assessment that identification of services, in its entirety, represents the genus in this case. Nevertheless, as part of an argument asserting that

the Examining Attorney’s focus on the term “sneaker” is too narrow and defies the precedent from *Booking.com* that for a mark to be generic, it

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<sup>16</sup> 10 TTABVUE 6 (Examining Attorney’s Brief).

must name the entire ‘class of goods and services, rather than any feature or exemplification of the class[.]’

citing *Booking.com*, 2020 USPQ2d 10729, at \*10, Applicant refers to the same services – without their specified features (e.g., “operating an online marketplace,” rather than “operating an online marketplace featuring footwear and clothing) as its “core genus.”<sup>17</sup> Applicant presents no authority suggesting that we should distinguish between a “core” genus and an entire genus, so we make no such distinction in our analysis. Further, to the extent Applicant contends that the Supreme Court in *Booking.com* set forth a new rule regarding the determination of a genus in genericness cases, we reject it. The Court was simply distinguishing between generic terms and merely descriptive terms.

#### B. The Relevant Public

Because there are no restrictions or limitations to the channels of trade or classes for consumers for Applicant services, we find that the relevant public for those services are ordinary consumers interested in purchasing clothing and footwear, including sneakers, as well as incentives provided through awards and contests in the field of fashion and sneaker collection. See *Remington Prods., Inc. v. N. Am. Philips Corp.*, 892 F.2d 1576, 13 USPQ2d 1444, 1448 (Fed. Cir. 1990) (the mark must be considered in context, i.e., in connection with the goods and services); *Magic Wand*, 19 USPQ2d at 1553-54 (the description of services in respondent’s registration defines the relevant public).

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<sup>17</sup> 6 TTABVue 17-18 (Applicant’s Brief).

C. The Relevant Public's Perception of SNKRS

1. The Examining Attorney's Evidence and Argument

The Examining Attorney's argument about the perception of SNKRS can be boiled down to the following: Because SNKRS is the phonetic equivalent of "sneakers," a term that is generic for the proposed services or at least a key aspect, central focus or feature, or main characteristic of them, the relevant public will perceive the term SNKRS as the equivalent of that generic term, and SNKRS is also generic.<sup>18</sup>

a. Evidence That "Sneakers" Is Generic for Retail Stores and Marketplaces Featuring "Sneakers"

To show that "sneakers" is a generic term for Applicant's proposed retail-related services in Class 35, the Examining Attorney provides a definition from the MERRIAM-WEBSTER dictionary, which defines "sneaker" as "a sports shoe with a pliable rubber sole,"<sup>19</sup> as well as printouts from third-party websites that refer to "sneaker stores" including:

- a Yelp (yelp.com) search for "sneaker stores" on June 11, 2021 provides a list of the "Best Sneaker Stores in Jersey City, NJ";<sup>20</sup>
- an article on LiveAbout (liveabout.com) titled "Sneaker Stores in Chicago" (published January 14, 2020) provides a list of "sneaker stores" in Chicago that "have managed to withstand the test of time and demand";<sup>21</sup>
- an article on Dmarge (dmarge.com) titled "Best Online Sneaker Stores For Scoring The Latest Kicks" (published February 11, 2021) includes Applicant in its listing as one of "the world's best online sneaker stores";<sup>22</sup>

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<sup>18</sup> 10 TTABVUE 7-13 (Examining Attorney's Brief).

<sup>19</sup> April 20, 2020 Office action, TSDR 5.

<sup>20</sup> June 11, 2021 Final Office action, TSDR 113-19.

<sup>21</sup> *Id.* at 121-29.

<sup>22</sup> *Id.* at 130-42.

- a page from Complex (complex.com) provides a listing of various articles about sneaker stores under the heading, “Latest in Sneaker-Stores.” They include articles titled “Sneaker-Stores”; “How Sneaker Stores Are Getting Through the COVID-19 Pandemic”; “Help This Sneaker Store Recover from the Nashville Tornado”; “James Whitner Is the Sneaker Store Owner That Michael Jordan Treats Like Family”; “Did Soulja Boy Try to Leave a Sneaker Store Without Paying?”; “Rappers Start Beef With Sneaker Store on Social Media”; “The Highs and Los of Owning a Sneaker Store”; “Sneaker Store Owners and Managers Tell Their Wildest Release Day Stories”; and “Michael Jordan’s Son Announced the Opening of His Sneaker Store”;<sup>23</sup>
- an undated page from Sneaker News (sneakernews.com) titled “SNEAKER STORES IN BOSTON” provides its list of sneaker stores in Boston;<sup>24</sup>
- an article from Nice (nicekicks.com) titled “A List of Sneaker Stores You Can Support During coronavirus” (published March 18, 2020);<sup>25</sup>
- an article from Shoerazzi (shoerazzi.com) titled “8 Online Sneaker Stores” (published May 12, 2021) explains that “[a]n online sneaker store is a site that sells sneakers from various brands”;<sup>26</sup> and
- an article from Well+Good (wellandgood.com) titled “11 Places Sneakerheads Actually Shop at in New York City” (published December 11, 2018) lists “the most-hyped and the under-the-radar sneaker stores that NYC streetwear fanatics and gym rats alike have on their radar (or should).”<sup>27</sup>

To show that “sneakers” is a generic term for Applicant’s proposed sneaker award services in Class 41, the Examining Attorney provided printouts from third-party websites and their sneaker awards, including:

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<sup>23</sup> *Id.* at 143-49.

<sup>24</sup> *Id.* at 150-53.

<sup>25</sup> *Id.* at 163-67.

<sup>26</sup> *Id.* at 168-77.

<sup>27</sup> *Id.* at 178-85.

- an article from Shape (shape.com) titled “The 2021 Shape Sneaker Awards Will Help You Pick the Best Pair for Any Workout”;<sup>28</sup>
- an article from Women’s Health (womenshealthmag.com) titled “Women’s Health 2021 Sneaker Awards” discusses the magazine’s testing of various new sneakers “to bring you the best shoes for every type of sweat”;<sup>29</sup>
- a page from Self (self.com) promotes the magazine’s “SELF’s Sneaker Awards” and seeks entries from companies that sell sneakers to be considered for award;<sup>30</sup>
- an article from Sole Savy (solesavy.com) titled “SoleSavy’s Sneaker Awards of 2020” “hands out a few year-end awards” for the picks of the best sneakers of 2020;<sup>31</sup>
- an article from Snobette (snobette.com) titled “Snobette Sneaker Awards Top 10 Sneakers 2020” provides a listing of its picks of the top ten sneakers of 2020;<sup>32</sup> and
- an article titled “NBA Sneaker Awards 2018-2019: MVP, Kicks of the Year and More,” by “The Crossover” on the website of Sports Illustrated (si.com) “hand[s] out some sneaker awards.”<sup>33</sup>

Applicant argues that the above evidence “is not relevant to the genericness issue. The Examining Attorney specifically searched for the phrases ‘sneaker stores’ and ‘sneaker awards,’ thereby including descriptive signifiers in his search criteria that are not present in [Applicant’s] mark.”<sup>34</sup> Applicant emphasizes that not a single one of the [Examining Attorney’s] results “mention the term

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<sup>28</sup> *Id.* at 11-17.

<sup>29</sup> *Id.* at 19-27.

<sup>30</sup> *Id.* at 28-31.

<sup>31</sup> *Id.* at 34-42.

<sup>32</sup> *Id.* at 43-52.

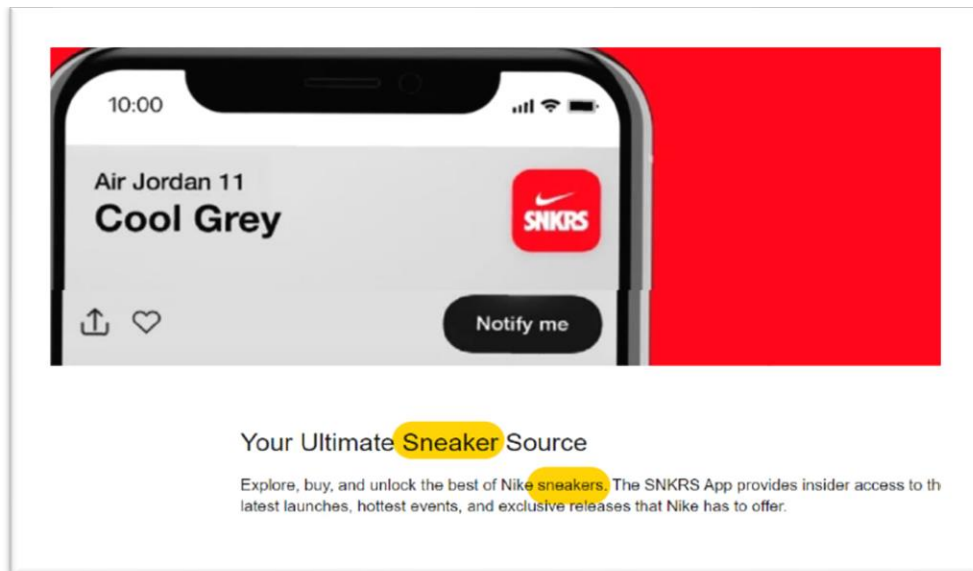
<sup>33</sup> *Id.* at 53-61.

<sup>34</sup> 6 TTABVUE 11 (Applicant’s Brief).

‘SNKRS’.”<sup>35</sup>

b. Applicant’s Use of SNKRS

The Examining Attorney points to Applicant’s own use to argue that “Applicant’s use of SNKRS is clearly intended as the phonetic equivalent of the generic term ‘sneakers.’”<sup>36</sup> The first, a page from Applicant’s website pertaining to the App, shows Applicant’s composite mark embedded within an image for the App, followed by the wording “Your Ultimate Sneaker Source” and “Explore, buy, and unlock the best of Nike’s Sneakers”:



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The second, which comes from a page in Applicant’s specimen of use submitted with the Application consisting of a “screen shot of [the] mark in use in mobile application store, is a page from the Apple App Store and is an “App Store Preview”

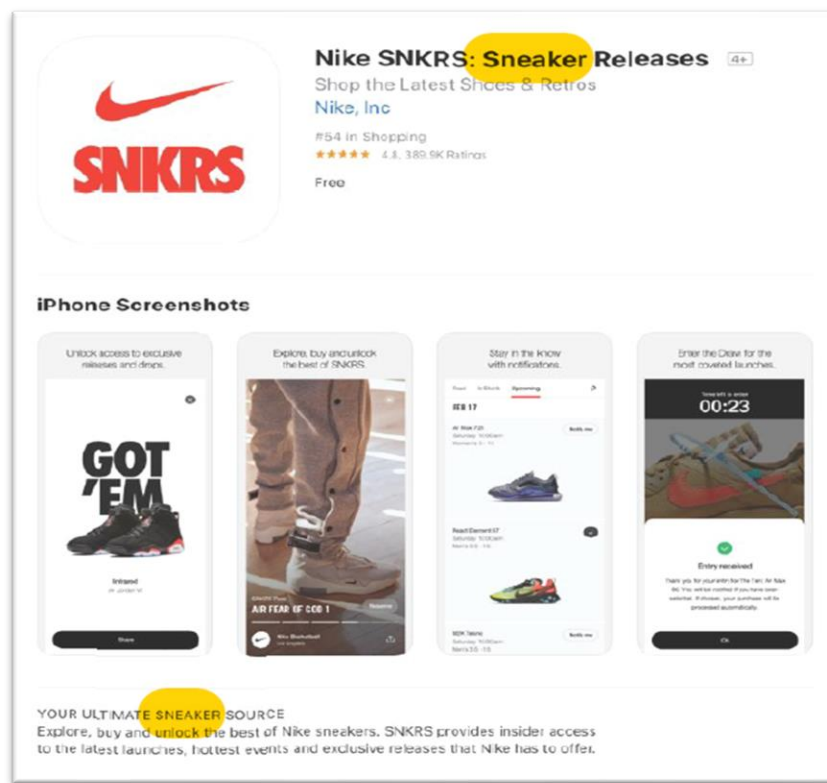
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<sup>35</sup> *Id.*

<sup>36</sup> 10 TTABVUE 12 (Examining Attorney’s Brief).

<sup>37</sup> February 11, 2022 Reconsideration Letter, TSDR 4.

of Applicant’s App.<sup>38</sup> As shown in the excerpt therefrom reproduced below, it presents Applicant’s proposed SNKRS composite mark, followed by the wording “Nike SNKRS: Sneaker Releases,” below which is the same wording shown in the website example, namely, to “Explore, buy and unlock the best of Nike sneakers. SNKRS provides insider access to the latest launches, hottest events and exclusive releases that Nike has to offer”:



The Examining Attorney argues that this evidence “shows that Applicant uses SNKRS in connection with advertising software for sneakers in a way that is clear that SNKRS is the phonetic equivalent of ‘sneakers.’”<sup>39</sup>

<sup>38</sup> January 31, 2020 Application, TSDR 9.

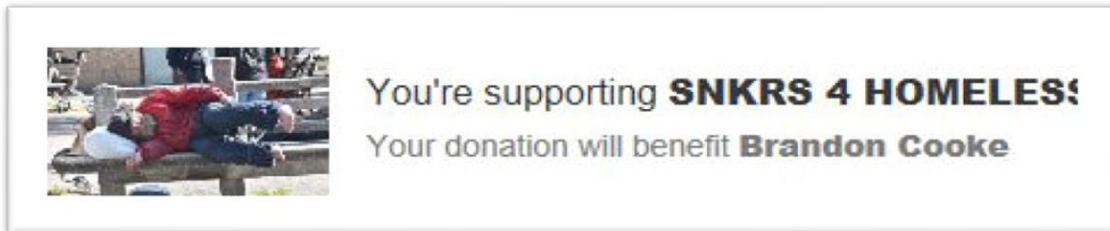
<sup>39</sup> 10 TTABVUE 12 (Examining Attorney’s Brief).

Applicant argues that the Examining Attorney “misconstrues” this evidence. According to Applicant, “[t]he [Examining Attorney’s] citations actually show that [Applicant] does not use ‘SNKRS’ and ‘sneakers’ interchangeably, but rather makes a clear distinction between its SNKRS trademark and the term ‘sneakers’ when referring to footwear.”<sup>40</sup>

c. Evidence that “SNKR”/“SNKRS” Is Used as an Abbreviation for “Sneaker”/“Sneakers”

To show that “snkrs’ and/or ‘snkr’ is a common abbreviation for “sneakers” or “sneaker,” the Examining Attorney provides printouts from nine third-party websites that use ‘SNKRS’ or ‘SNKR’ in place of, or in addition to, the word “sneakers”:

- The crowdfunding platform, GoFundMe (gofundme.com) has a page, “SNKRS 4 HOMELESS” created by a person named Brandon Cooke on June 29, 2020, seeking donations:



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- A page from the website of Terry de Havilland (terrydehavilland.com), undated but printed on June 11, 2021, offers the sale of a TDH-branded sneaker under the heading “SNKRS WHITE(1)”:

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<sup>40</sup> 11 TTABVUE 5-6 (Applicant’s Reply Brief).

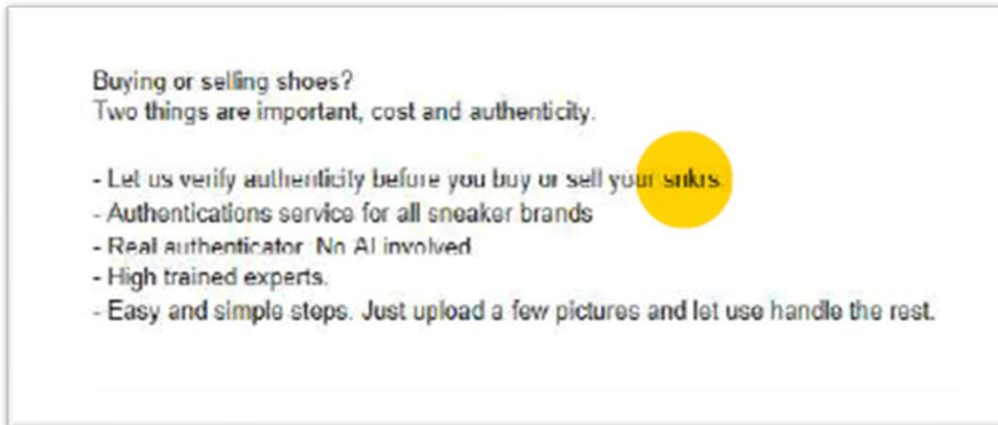
<sup>41</sup> June 11, 2021 Final Office action, TSDR 77-78.





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- The Apple App store has an App Store Preview from Grandeur france of its iPhone app, “Legit Snkrs – Legit Check” by Grandeur France: “Let us verify authenticity before you buy or sell your snkrs”:



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- “Kicks and Comics,” a podcast that began in October 2019, celebrates its one-year anniversary on the website bgmediagp.com with a post titled “1 Year Anniversary w/ The Snkr Truck” (published January 21, 2021) highlights its interview with “[t]he guys from The SNKR Truck a 501(c)(3) non profit organization based in the Austin area [that] are helping the less fortunate one pair of shoes at a time....”<sup>44</sup>

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<sup>42</sup> *Id.* at 82-94,

<sup>43</sup> *Id.* at 85-87.

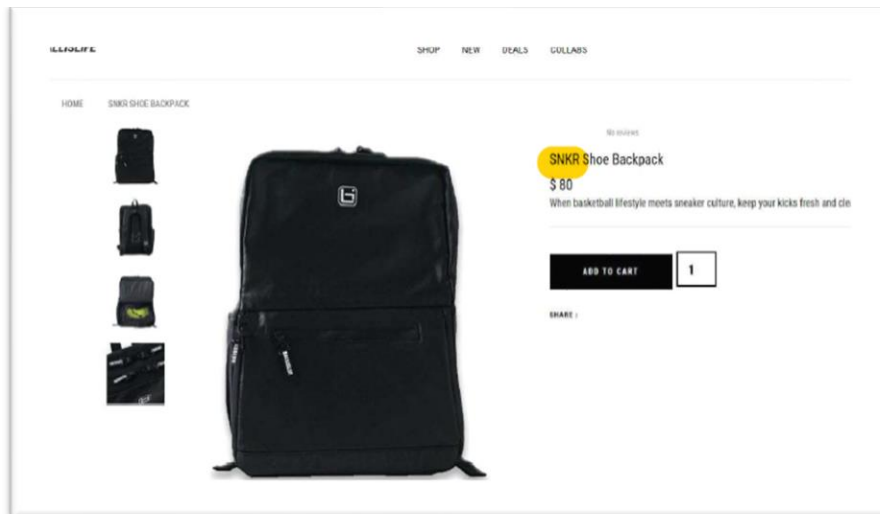
<sup>44</sup> *Id.* at 79-81.

- Another page on GoFundMe seeks donations under the heading “The SNKR Foundation Startup Costs,” which was created on February 10, 2021 by “The SNKR Foundation, a group of resellers looking to make a change in the world” and whose purported “mission is to help those who are less fortunate by hosting sneaker related charity events.”<sup>45</sup>
- “The “SNKR Project” (snkrproject.com) emphasizes on its Returns & Exchanges page that it “want[s] you to love your sneakers”:



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- Ballislife (ballislife.com) offers a sneaker backpack called a “SNKR Shoe Backpack,” suggesting “When Basketball Lifestyle Meets Sneaker Culture, Keep Your Kicks Fresh and Clean!”:



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<sup>45</sup> *Id.* at 101-05.



<sup>46</sup> *Id.* at 88-89.

<sup>47</sup> *Id.* at 90-95.

**SNKR Shoe Backpack**

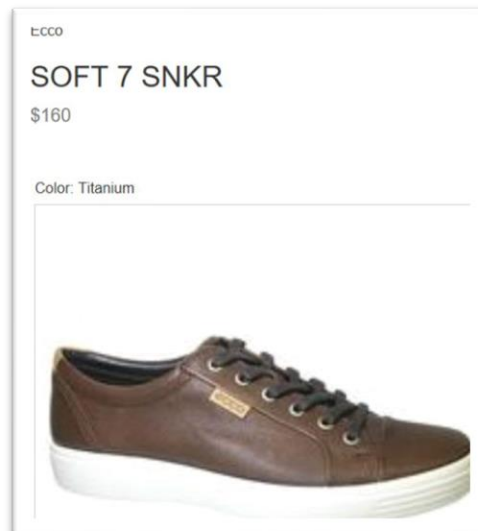
**When Basketball Lifestyle Meets Sneaker Culture, Keep Your Kicks Fresh And Clean!**

- **Durable** | Made of a high quality water-resistant fabric, double-stitched bonded seams for increased durability giving the backpack a stronger, more modern feel. **Careful** | Extra back padding for additional support and a haul handle for easy transport when you're not carrying it on your back.
- **Functional** | Two main top-loading compartments perfect for a weekend's worth of clothes and essentials, additional pockets in each compartment, hidden interior pocket, padded laptop sleeve and tablet sleeve to secure your personal items.
- **Ventilated sneaker compartment** | Built-in drawstring bag to keep your pair of sneakers fresh from everything else. Fits shoe sizes up to Men's US 12.
- **Spacious** | 20-liter capacity (Dimensions: 19L x 14W x 5.5D).



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- Harry's Shoes ([harrys-shoes.com](http://harrys-shoes.com)) sells a sneaker that is referred to as a "SOFT 7 SNKR" sneaker:



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- An article on the website of WWD ([wwd.com](http://wwd.com)) titled "Shoppable Video Platform DroppTV Launches Dollar Snkr Club" (published November 4, 2019) discusses DroppTV's launch of "the Dollar Snkr Club and its first sneaker raffle with Urban Necessities." According to DroppTV's CEO, "[w]e couldn't be happier with the success of our first Dollar Snkr raffle."<sup>50</sup>

<sup>48</sup> *Id.*

<sup>49</sup> *Id.* at 96-100.

<sup>50</sup> *Id.* at 106-09.

Applicant asserts that this evidence shows “only a handful of website pages that reference the term ‘Snkrs’ and/or ‘snkr’, most of which appear to have been created within the last 18 months.”<sup>51</sup> Applicant submits that “these few examples may be copycats trying to trade off[f] the fame and reputation of [Applicant’s] SNKRS mark,” and that “[t]he Examining Attorney’s sparse website evidence pales in comparison to the 1,150,000,000 visits to the SNKRS Platform since 2015 and fails to establish there is widespread consumer use and recognition of SNKRS as a generic terms for the ... Services.”<sup>52</sup>

d. Third-Party Registrations

Finally, to show that “a registration for SNKRS would clearly hinder competition and would hinder the ability of third-parties to register a trademark that includes SNKR,” the Examining Attorney provides TSDR printouts of pending applications and third-party registrations, including:

- Reg. No. 5124550 for SNKRBST (standard characters) for “providing online journals, namely, blogs featuring footwear, fashion, sports and entertainment; online digital video, audio and multimedia entertainment publishing services; online digital publishing of the text and graphic works of others,” in Class 41;
- Reg. No. 5227440 for SNKR PROJECT (“sneaker” disclaimed) for “Athletic shoes; basketball sneakers; footwear; footwear for men and women; footwear for women; footwear made of vinyl; running shoes; tennis shoes; shoe uppers,” in Class 25;
- Serial No. 88450844 for SNKR SKR (which has since registered under Reg. No. 6404096) for “operating on-line marketplaces featuring a platform that allows users to buy, sell and trade footwear online and in safe space” in Class 35; and

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<sup>51</sup> 11 TTABVUE 5 (Applicant’s Reply Brief).

<sup>52</sup> *Id.*

- Serial No. 90512567 for SNKRHOLIC for “all purpose portable household containers; boot trees; brushes for footwear; buckets made of woven fabrics; ceramic sculptures, vases, vessels, bowls, plates and pots; cleaning sponges; containers for household or kitchen use not of precious metal; containers of plastic for storage of feminine products for household or domestic use; cooking utensils, namely, grills; dryer balls sold empty used to disperse disinfectants to articles in a dryer; microfiber cloths for cleaning; plastic containers, namely, cake boxes for household use; shoe shine cloths; shoe trees, in Class 21.<sup>53</sup>

## 2. Applicant’s Argument and Evidence

Applicant argues that the “sum total” of the evidence introduced by the Examining attorney – consisting of “19 web results for the search,” “9 webpage examples of the term ‘SNKRS’ used for various goods and services (at least 7 of which began *after* [Applicant] introduced its mark”); and several “third-party registrations for marks that include the term ‘SNKRS’ ([some] of which are registered in different international classes” or “inconsistent disclaimer requirements for the term ‘SNKRS’)” – is “limited and weak ‘affirmative evidence’” to support the refusals.<sup>54</sup>

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<sup>53</sup> June 11, 2021 Final Office Action, TSDR 7, 187-96. The application for the first registration listed (Reg. No. 5124550 for the mark SNKRBRST) was filed in 2013, before Applicant’s application was filed; the remaining were filed afterward. The last listing above, a pending application, is only evidence that the application was filed on a certain date. *See Nike Inc. v. WNBA Enters. LLC*, 85 USPQ2d 1187, 1193 n.8 (TTAB 2007); *Olin Corp. v. Hydrotreat, Inc.*, 210 USPQ 63, 65 n.5 (TTAB 1981) (“Introduction of the record of a pending application is competent to prove only the filing thereof.”). The Examining Attorney also provided evidence of applications and registrations that have been abandoned or cancelled. Their probative value is similarly limited to the fact that the applications had been filed and/or registered. *See e.g., Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1403 n.4 (TTAB 2010) (quoting *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1049 n.4 (TTAB 2002)) (abandoned applications have “no probative value other than as evidence that the applications [were] filed.”); *Action Temp. Servs. Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) (“a cancelled registration does not provide constructive notice of anything.”).

<sup>54</sup> 6 TTABVUE 9 (Examining Attorney’s Brief).

“Equally important in the genericness evaluation,” contends Applicant, “are the categories of evidence the Examining did not provide: “dictionary definitions (including popular slang dictionaries) defining ‘SNKRS’ as either footwear or sneakers, and “objective evidence of consumer perception that ‘SNKRS’ is the phonetic equivalent of ‘sneakers’ or that consumers only perceive ‘SNKRS’ as a generic term for footwear or sneakers.”<sup>55</sup> Applicant argues that its “case against genericness is made even stronger when the Examining Attorney’s evidence is contrasted with the strong evidence [Applicant] proffered to demonstrate that ‘SNKRS’ is not generic.”<sup>56</sup>

a. Unsolicited Media Attention

To show that “‘SNKRS’ is recognized as [Applicant’s] trademark” by the relevant consumers, Applicant provided, from the Internet, “over 20 unsolicited media articles from major publications and websites focused on the sneaker trade and culture, all of which refer to the SNKRS Platform using ‘SNKRS’ as a brand name, and use the term ‘sneakers’ when referring to footwear,” including but not? limited to:

- An article from Sole Collector titled “Nike’s SNKRS App Helps You Buy Exclusive Sneaker Releases” (published February 11, 2015) discusses Applicant’s launching, later that week, of “the SNKRS app, a new platform for purchasing what the brand is calling ‘the most premium sneakers.’”<sup>57</sup>
- An article from Handelscraft titled “Best Practice: SNKRS – content commerce perfectly staged” (published March 27, 2015) explains that “[e]ven shoes which aren’t on the market yet can be followed so you can get early information like the release date” and “[w]ith SNKRS, Nike gives us the feeling of always being a step ahead.” “Admittedly,” the article states,

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<sup>55</sup> *Id.* at 10.

<sup>56</sup> 6 TTABVUE 10 (Examining Attorney’s Brief).

<sup>57</sup> October 20, 2020 Office action response, TSDR 81-85 (Ex. 3).

“SNKRS probably only address a very specific target group,” “[b]ut Sneakerheads will be satisfied with the app.... The connection of content and mobile commerce with Nike’s SNKRS is exemplary.”<sup>58</sup>

- A follow-up article from Sole Collector titled “Test Driving the Nike SNKRS App” (published May 22, 2015) discusses how to use the app, including how to purchase sneakers: “We tested out the Nike SNKRS app on the KD 7 ‘Floral’ drop” and “the app offered a much smoother checkout process than what’s been on Nikestore.”<sup>59</sup>
- An article from The Wall Street Journal titled “How Nike Is Reinventing the Great Sneaker Scavenger Hunt” (published November 27, 2017) describes how Applicant provided a unique way to purchase a particular sneaker called the “Momofuku’ Dunk,” “a shoe designed collaboratively” by the owner of the restaurant “Fuku” and Applicant. “The only way fans could get their hands on this specific sneaker was to come to Fuku, open Nike’s SNKRS app on their iPhones, hold up the camera to Fuku’s coded paper menus and through the magic of augmented reality (AR) make a sneaker digitally materialize on screen.”<sup>60</sup>
- An article from Sneaker News titled “Nike Launches SNKRS App” (published February 11, 2015), also discusses the launch of Applicant’s “SNKR APP,” “a one-stop shop that grants mobile access to some of the most coveted sneakers out there,” and provides information how to access the app at the Nike Zoom City SNKRS Station, on Twitter, and on Applicant’s website.<sup>61</sup>
- An article from NBC Sports titled “Nike introduced SNKRS app at pop-up shop during All-Star weekend in NYC” (published February 13, 2015) asserts that “[t]he SNKRS pop-up shop located at 348 Bowery and only here for the weekend, might be the brand’s most eye-catching space.” It adds that “Nike SNKRS will launch later this spring for iOS, with an Android version launching soon afterward. Fans in NYC can get early access to the iOS version by visiting the? SNKRS shop this weekend.”<sup>62</sup>
- An article from Fox Business titled “Why Investors Should Pay Attention to Nike’s SNKRS App” (published March 16, 2016) discusses the success of

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<sup>58</sup> *Id.* at 154-56 (Ex. 12).

<sup>59</sup> *Id.* at 88-91 (Ex. 4).

<sup>60</sup> *Id.* at 94-101 (Ex. 5).

<sup>61</sup> *Id.* at 104-11 (Ex. 6).

<sup>62</sup> *Id.* at 122-124 (Ex. 8).

Applicant's app since it was launched in 2015. Among other things, the article asserts that "SNKRS is more than an online shoe store," and advises users to "Watch what Nike does with SNKRS."<sup>63</sup>

- An article from CNN Business titled "Nike's digital reboot is working" (published July 12, 2018) discusses a slowdown Applicant faced that year due to increased competition, causing Applicant to lay off "2% of its workforce." Though things slowed down that year, the author noted that Applicant's "SNKRS app" had "become "an essential tool for sneaker collectors," and quoted Applicant's CEO Mark Parker as stating that "[t]he SNKRS app is creating incredible demand...."<sup>64</sup>
- Another article from Sole Collector titled "The Nike Team That's Quietly Shaping the Future of Its Online Business – Inside the brand's push to reinvent sneaker culture" (published October 25, 2017) discusses, among other things, how "Nike's SNKRS app" "has evolved from its launch in 2016 to include more interactive experiences" by "dropping clues for would-be sneaker buyers a requiring them to be in a specific place in a specific time to unlock a limited release, a function Nike calls the SNKRS Stash."
- An article from Retail Dive titled "Nike opens pop-up store based on its SNKRS app" (published February 5, 2019) discusses Applicant's opening of a SNKRS pop-up store in Atlanta and quotes Applicant as describing the store as "the physical manifestation of the SNKRS app" that "will house a vending machine containing SNKRS-related items that store shoppers can access by scanning a pass in their SNKRS app." According to the author, "SNKRS has been viewed by industry analysts as an important cog in Nike's growth engine, and a key path to keep sneakerheads engaged with the brand."<sup>65</sup>
- An article on Mobile ID World titled "Nike SNKRS App Enables Biometric Checkout" (dated July 4, 2016 but reposted from another website, FindBiometrics) notes that "[t]he app is enabling fingerprint verification for mobile purchasers" and concludes that "[w]ith the new feature, SNKRS becomes just the latest Android app to embrace" native fingerprint biometrics.<sup>66</sup>

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<sup>63</sup> *Id.* at 114-19 (Ex. 7).

<sup>64</sup> *Id.* at 126-28 (Ex. 9).

<sup>65</sup> October 20, 2020 Office action response, TSDR 77-78 (Ex. 2).

<sup>66</sup> May 10, 2021 Office action response, TSDR 34-35 (Ex. 2).



- An article from The Retro Insider titled “The Best Ways To Cop The Sacai x Nike Blazer Mids Manually For Retail” (published October 10, 2019) explains that “[a]s with most hyped releases, the Nike SNKRS app is one option you have to look into when trying to snag a pair of Nike’s limited offerings.”<sup>67</sup>
- An article titled “We’re going digital – Diving into Nike’s new digital strategy and more” (published November 22, 2019), volume 14 in a series of articles from The Kicks You Wear discusses how Applicant is “doubling down on the SNKRS experience” and asks readers to “[i]magine a world where SNKRS, Instagram and your local Nike store are all smashed together in one space,” and tells them they “won’t have to imagine that for much longer” because “Nike’s digital team ... is developing a new digital strategy that takes the experience sneaker heads have on the SNKRS app and replicates it for customers in the company’s phylums.”<sup>68</sup>
- An article from USA Today titled “Just Did It: My long road to redemption on Nike’s SNKRS app” (published February 12, 2020) discusses the author’s experience when using the app. “On December 20 of last year I woke up a few hours before work and went for my phone ... opened Nike’s SNKRS app – a sneaker lottery app that gives lucky fanatics a chance to buy limited-edition shoes and scrolled to make sure my entries were in for the Off-White Nike Dunks being released that day.” Although he was “0-for-37 on the app” since he downloaded it in 2017, he finally won. He discusses other customers that have had fared better, such as a resident of Washington Sneakerhead who “says his SNKRS record is 5-12. If you’re an NFL team that’s awful. For sneaker lovers? GOAT status.”<sup>69</sup>
- An article from StockX News titled “Best SNKRS Releases In 2020” (published June 19, 2020) provides its list of what it considers Applicant’s best sneakers released through the app in 2020 to that point. Since Applicant launched the app in 2015, the article notes, “SNKRS is the one place that anyone can have a chance to purchase exclusive sneakers regardless of their location.”<sup>70</sup>
- Another article from Snobette titled “A Tutorial on How To Enter Nike SNKRS Reservation or Draw Launches” (updated December 11, 2020) provides a tutorial “designed to help first-time U.S.-based Nike sneaker

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<sup>67</sup> *Id.* at 37-40 (Ex. 3).

<sup>68</sup> October 20, 2020 Office action response, TSDR 160-62 (Ex. 13).

<sup>69</sup> *Id.* at 164-75 (Ex. 14).

<sup>70</sup> *Id.* at 136-48 (Ex. 11).

lovers who are attempting to cop a shoe via a SNKRS, but have no idea how either works. SNKRS is used to sell Nike shoes and more recently apparel, but also Nike Brands Converse ... and Jordan....”<sup>71</sup>

The Examining Attorney argues that “this evidence only shows that applicant intends SNKRS to be a trademark rather than that the public does not believe that SNKRS is the phonetic equivalent of a generic term.”<sup>72</sup> Continuing, he asserts that:

Merely displaying “SNKRS” in capital letters does not make “SNKRS” a non-generic term any more than displaying the correct spelling “SNEAKERS” in capital letters makes “SNEAKERS” a non-generic term. The evidence submitted by applicant includes use of SNKRS in connection with advertising that applicant specializes in “sneakers.” Therefore, in the context of applicant’s services and applicant’s own advertising, consumers would clearly understand that SNKRS is the phonetic equivalent of the generic term “sneakers.”<sup>73</sup>

b. Evidence Provided Via Applicant’s Declarations

As noted above, Applicant has claimed acquired distinctiveness in the term SNKRS based on its allegation of more than five years of continuous and substantially exclusive use of SNKRS in commerce and other evidence. That other evidence comes in the form of three declarations signed by Applicant’s Vice President (of Applicant’s SNKRS Launch and 23NYC & NHBD divisions) Ron Faris made of record over the course of prosecution of the application. Among other things, Mr. Faris testified that:

- Applicant “has continuously used its SNKRS Mark in interstate commerce in connection with its goods/services since at least as early as February 2015”;<sup>74</sup>

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<sup>71</sup> October 20, 2020 Office action response, TSDR 62-71 (Ex. 6).

<sup>72</sup> 10 TTABVUE 14 (Examining Attorney’s Brief).

<sup>73</sup> *Id.*

<sup>74</sup> October 20, 2020 Office action response, TDSR 45 (First Declaration of Faris ¶ 6).

- As of May 12, 2021, Applicant’s SNKR Platform “ha[d] garnered more than 11,500,000 active users and more than 1,150,000,000 visits”;<sup>75</sup>
- As of 2015, “millions of orders have been placed through the SNKRS Platform online marketplace;<sup>76</sup>
- “[S]ales made through the online marketplace of the SNKRS Platform have increased every year” and “[s]ince 2018, sales made through the SNKRS Platform online marketplace have steadily increased at an average of +43% year over year, and since 2019, over 10,000,000 orders have been placed through the SNKRS Platform online marketplace in North America. ... [I]n just the last Quarter of 2021, the SNKRS Platform grew over 90% in demand and saw nearly 80% growth in monthly active users.”<sup>77</sup>
- “[A] third-party generated metrics report that analyzes hashtag use shows that as of April 29, 2021, a search for the #SNKRS hashtag on the Instagram Platform’s search engine resulted in a total of 872,075 posts featuring #SNKRS hashtag, only 3 of which were not related to Applicant”;<sup>78</sup>
- “[A] third-party generated metrics report discloses that as of April 29, 2021, a search for the #SNKRS hashtag on the TikTok Platform’s search engine resulted in a total of 360.9 million views of #SNKRS” that are “almost exclusively ... made by third parties that are consumers of [Applicant]”;<sup>79</sup>
- On Twitter, “there were 4,500 tweets including the #SNKRS hashtag ... resulting in 13.9 million digital views of #SNKRS” in a sample time period spanning April 20, 2021 through April 30, 2022,” the vast majority being “from individuals commenting on the [Applicant’s] SNKRS “Draws....”<sup>80</sup>
- Applicant uses the term “SNKRS Platform” as incorporating “the full range of digital goods and services provided under the SNKRS Mark, including the ability of users to purchase products through the online marketplace,

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<sup>75</sup> May 14, 2021 Voluntary Amendment, 12 (Second Declaration of Faris ¶ 10).

<sup>76</sup> *Id.*

<sup>77</sup> December 9, 2021 Request for Reconsideration, TSDR 92 (Third Declaration of Ron Faris, ¶ 17).

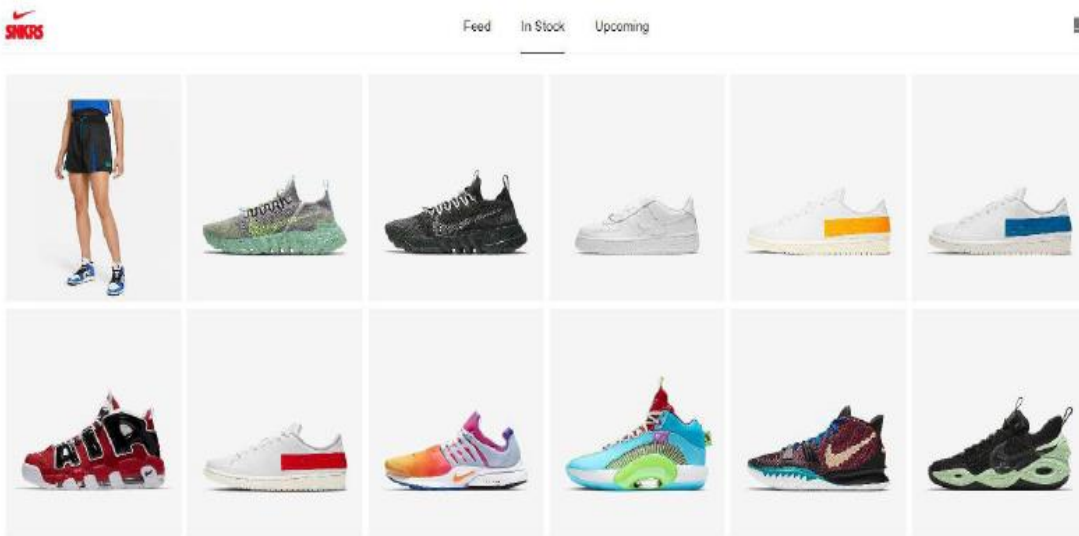
<sup>78</sup> May 14, 2021 Voluntary Amendment, TSDR 14 (Second Declaration of Ron Faris ¶ 13).

<sup>79</sup> *Id.* at 14-15 (¶14).

<sup>80</sup> *Id.* at 15 (¶ 15).

earn points, and win raffles/contests. When a user creates a profile through the SNKRS app, that same profile can be accessed through the SNKRS.com PORTAL, and vice versa.”<sup>81</sup>

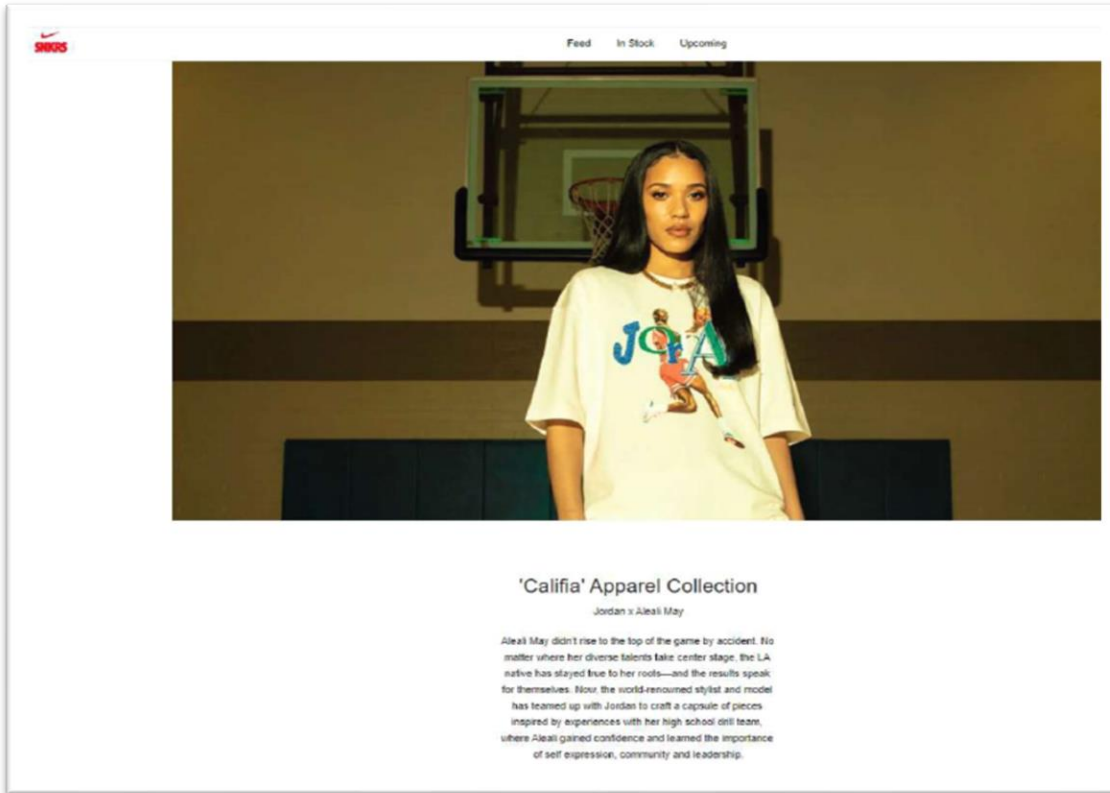
- “Applicant drives downloads of the SNKRS App through public digital platforms such as Apple Search Ads, Facebook, Instagram, Snapchat, Google, YouTube, and Twitter.”<sup>82</sup>
- “When the SNKRS Platform is accessed through SNKRS, users are directed to the SNKRS homepage, which features pages to buy from the current inventory of [Applicant’s] products as well as information regarding upcoming launches” and “[t]he SNKRS Mark remains on each page the user accesses,” for example:



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<sup>81</sup> *Id.* at 8-9 (¶ 7).

<sup>82</sup> *Id.* at 13 (¶ 11).



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- “Since its launch in 2016 during NBA All Star Week, the SNKRS Mark has continued to be used by [Applicant] prominently in conjunction with high profile events,” such as when Applicant opened a pop-up store in Atlanta for Superbowl week in 2019 as depicted in the following images from that event:

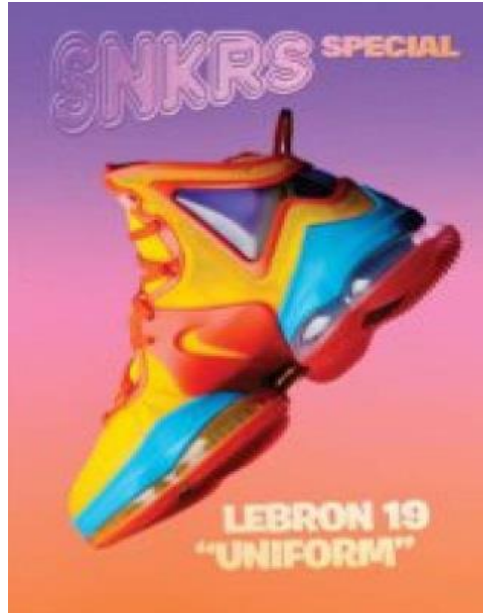


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<sup>83</sup> May 14, 2021 Voluntary Amendment, TSDR 9-10 (Second Declaration of Ron Faris, ¶ 8).

<sup>84</sup> October 20, 2020 Office action response, TSDR 53, 55 (First Declaration of Ron Faris, ¶ 14).

- “The SNKRS mark is also advertised on the Fortnite game, in conjunction with Applicant’s promotional relationship with basketball star Lebron James, as shown below:



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- Applicant “continues to offer its users highly coveted and anticipated launch experience....” For example, Applicant promoted its goods and services on “Air Max Day,” an event that “included creative workshops, panel discussion, and collection tours” and “was celebrated in the virtual space, with selective live, undisclosed programming held in Los Angeles, Shanghai, New York, Istanbul and other cities” and included “six different livestream events that gave SNKRS Live its highest viewership ever.”<sup>86</sup>

The Examining Attorney argues that this evidence “is insufficient to show acquired distinctiveness because the applied-for mark is highly descriptive of Applicant’s goods and/or services.”<sup>87</sup> In any event, he asserts, “[m]uch of [this] evidence relates to applicant’s software platform rather than retail store services or

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<sup>85</sup> December 9, 2021 Request for Reconsideration, TSDR 91-92 (Third Declaration of Ron Faris ¶ 16).

<sup>86</sup> *Id.* at 90 (¶ 13).

<sup>87</sup> 10 TTABVUE 18 (Examining Attorney’s Brief).

award services.” “However, a software platform,” he asserts, “is different than retail store services and award services, which is why they are not classified in the same International Class of goods and services.”<sup>88</sup>

c. Survey Evidence

Applicant also provided evidence in the form of a survey. Specifically, Applicant retained Hal Poret, a marketing and survey professional, “to design and conduct a survey to determine if the term SNKRS is perceived by relevant consumers to be generic for online and retail store and retail store services featuring footwear,” which he did, using a *Teflon*-style format, which he details in his report made of record by Applicant.<sup>89</sup> As explained by Mr. Poret in his report:

A total of 300 respondents participated in this online survey among individuals who shop at online retail stores or retail stores that feature footwear.

The survey employed the well-accepted *Teflon* format for assessing whether a term is generic. Following the *Teflon* format, respondents in the survey were shown a series of terms (including SNKRS) one at a time and for each term they were asked if they believe the term is a brand name (i.e., trademark) or a common name (i.e., generic), if they know.

Although the applications for SNKRS cover services pertaining to a wider variety of products than just footwear, I designed the survey to focus on retail stores featuring footwear to be conservative in accessing perception of SNKRS in connection with the sale of the types of products most closely with sneakers.

To focus the survey on the specific context of the terms for online retail stores or retail stores, all respondents were initially instructed:

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<sup>88</sup> *Id.*

<sup>89</sup> December 9, 2021 Request for Reconsideration, TSDR 54-84 (Exhibit 1, “Expert Report of Hal Poret Regarding Survey to Access Whether the SNKRS Mark is Generic for Online Retail Stores or Retail Stores Featuring Footwear”).

In a few moments you will be shown some terms that you may or may not have seen in connection with online retail stores or retail stores.

For each term, please consider that term as if you were seeing it in connection with an online retail store or retail store that features the type of products described below the term.<sup>90</sup>

Before proceeding with the actual survey, participants were given an explanation and a mini test to make sure they understood the difference between brand names and common names.<sup>91</sup> Specifically, they were asked if they understood the difference based on explanations provided (that terms like “GENERAL MILLS, TOYOTA, NATURE MADE, and IPHONE” are brand names, whereas terms like “BREAKFAST CEREAL, CAR, VITAMINS, and SMARTPHONE” are common names). If they indicated that they understood, participants were permitted to proceed to the next question. They were then asked if the terms “PEPSI” and “COLA” are brand names or common names. If they answered correctly (indicating PEPSI as a brand, and COLA as a common term), they were presented with final questions to see if they understood that the term “BEST BUY” is a brand name, and “ELECTRONICS STORE” is a common name. If they answered correctly, they were permitted to take the actual survey. As Poret explains in his report:

All respondents were then shown various terms along with a description of products. ...

To control for response-order bias, two versions of the survey were administered, and each was taken by half of all respondents. Version 1

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<sup>90</sup> *Id.* at 58.

<sup>91</sup> *Id.* at 60-63.



of the survey first presented the concept of a “brand name,” followed by the concept of a “common name.” Meanwhile, Version 2 first presented the concept of a “common name,” followed by a “brand name.”

As a standard for the *Teflon* format, all respondents were also shown and asked about other terms. Since one of the key issues here relates to the question of whether the term SNKRS is essentially an abbreviated (or “disemvoweled”) version of “sneakers” that would be perceived generically for footwear, the survey was carefully designed to include other terms to account for and quantify any bias in how respondents might classify other terms that could be perceived to consist of abbreviations or disemvoweled version of generic terms.<sup>92</sup>

The “other terms” included in the survey were “MXD” for “canned alcoholic cocktails” and “SCRIBD” for “e-books and audiobooks,” which Poret selected because they are “examples of terms that are used in the marketplace as brands/trademarks”; “PICS” for “digital photos” and “JRNL” for “publications,” which Poret selected because they are “abbreviated or disemvoweled terms ... that are used generically to identify types of products”; and “PETSMART” for “animal products,” a “brand term for an online retail store or retail store....”<sup>93</sup>

According to Mr. Poret’s “Summary of Key Findings,” “62.0% of respondents (186 of 300) identified SNKRS as a brand name, compared to 26.0% that answer it is a common name (78 of 300).”<sup>94</sup> He then provided his opinion based on those results: “[I]t is my opinion that the term SNKRS is primarily perceived as a brand name of an online retail or retail store in the context of footwear, and is not perceived to be a

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<sup>92</sup> *Id.* at 68-59.

<sup>93</sup> *Id.* at 59-60, 66.

<sup>94</sup> *Id.* at 72.

generic term in that context.”<sup>95</sup>

The Examining Attorney argues that this evidence is not persuasive because (a) “the survey did not ask whether or not SNKRS is a brand name for ‘sneakers,’ and the term “[f]ootwear’ includes goods that are not sneakers, such as work boots, ski boots, slippers, etc.”; (b) [t]he survey did not ask whether or not SNKRS would be recognized as an alternate spelling of ‘sneakers’”; and (c) the survey did not ask “whether or not SNKRS would be recognized as a trademark for ‘sneakers.’”<sup>96</sup> He concludes, therefore, that “it is not clear from the survey whether or not respondents believed that SNKRS is a generic term for ‘sneakers’ because respondents were not directly asked that question.”<sup>97</sup>

d. Articles Discussing “Disemvoweling”

To show that “[c]onsumers are privy” to the trend of dropping letters from words, and understand such marks to be brand names rather than generic terms,”<sup>98</sup> Applicant provides two articles. The first, an article from the website HowStuffWorks (howstuffworks.com) titled “Flickr, Tumblr, Scribd: Why Dropping Vowels From Brand Names is So Popular” (undated) states, among other things, that:

- “the ‘er’ — called a syllabic consonant — in words like ‘flicker’ or ‘grinder’ doesn’t make the vowel sound you associate with words like ‘ear’ or ‘are.’ Instead, they’re just ‘r’ sounds. The letters ‘l,’ ‘m’ and ‘n’ can also form consonant sounds that function as vowels in a syllable, as in the word ‘bottle’”;

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<sup>95</sup> *Id.*

<sup>96</sup> 10 TTABVUE 13 (Examining Attorney’s Brief).

<sup>97</sup> *Id.*

<sup>98</sup> 6 TTABVUE 15 n.55 (Applicant’s Brief).

- “the occurrence of these brand names is due to the ‘er’ suffix being so common that even without the ‘e,’ readers know exactly how to pronounce the word,’ Riebold writes in an email.” “The pronunciation of this suffix is always the same, and features a syllabic ‘r,’ ... [so] the spelling makes intuitive sense.”
- “while grouping your brand into the new, hip ‘e’-less market may make you look cooler, it also seems less likely to have become a trend if the words hadn’t been so easy for us to recognize, spell and pronounce. (Case in point: the wedding website BHLDN, pronounced “beholden.” Not exactly intuitive, but perhaps to be expected from an American company that spells its name Anthropologie”; and
- “It’s not just businesses that are trying to drop vowels. It’s babies too. ... Aleksandr, Harpr, Braydn — are also all syllabic consonants. While we can gasp at them, the truth is we probably don’t have any trouble recognizing or understanding them.”<sup>99</sup>

The second is a piece from the New York Times titled “Where Have All the Vowels Gone? Consider the muumuu.”<sup>100</sup> According to the author of this article:

The first step in the next stage of language’s inevitable evolution — or devolution — may have already happened.

... Where have all the vowels gone?

But vowels, up until now, have not been actually without value. Their purpose has been clearly defined and accepted. When we announce we’re going to suss something out, for instance, they keep us from just hissing like a snake.

What we might call the Modern Vowel Massacre seems to have begun sometime in the early aughts, when the band MGMT found some indie-rock fame. In 2009, in *People* magazine, the band informed us that the proper way to pronounce its name was to simply say the individual letters: M-G-M-T. “The confusion may lie,” the magazine said, “in the fact that the band’s original name was ‘The Management,’ which they shortened to MGMT after discovering that another artist had the rights to it.”

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<sup>99</sup> October 20, 2020 Office action response, TSDR 199-201 (Ex. 16).

<sup>100</sup> *Id.* at 204-08 (Ex. 17).

Around the same time, tech companies like Tumblr and Flickr arrived on the scene, dropping e's both for distinctiveness and because the altered names made it easier to trademark, claim domain names on the internet and conduct other practical business.

Now it seems I can't go a week without seeing a handful of consonant-mad brands, like MNDFL, a meditation studio with a branch in my Brooklyn neighborhood; or WTHN, which offers "a brand-new acupuncture experience"; or MDRN., a "vertically-integrated real estate & lifestyle brand" whose very modernness [sic], it seems, is suggested by its abbreviated logo.

Then there are the friends who sign their (ever-briefer) correspondence "Yrs" and the rampant contractions on Twitter, with its 280-character limit.

Vowels are the distinctive thing now. The lack of them is routine.  
...

... Columbia professor and prolific author John McWhorter ... assured me I wasn't crazy to suggest an uptick in this trend.

"There is a fashion in American language culture right now to be playful in a way that is often childlike," Mr. McWhorter said. "This business of leaving out the vowels and leaving you to wonder how to pronounce something, it channels the kid-ness in a way – like saying 'because science,' or the way we're using -y, when we say something like, 'well, it got a little yell-y.'"

McWhorter acknowledges that the more often vowels are dropped, the more people get used to it and make adjustments to rapidly understand implied meanings. .... But he doesn't see disemvowelling creeping into more formal areas, and expects the trend won't move 'beyond the realm of that which is ironic or iconic.'<sup>101</sup>

e. Third-Party Registrations of "Disemvoweled" Marks

To show that "the USPTO has been flexible in its approach to disemvoweled marks, registering such marks on the Principal Register where the 'voweled' term arguably is a product or service covered by the registration," Applicant provided

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<sup>101</sup> *Id.*

printouts of registration certificates from the USPTO's TSDR database for the marks FLICKR, TUMBLR, GRINDR, HLMT, and LISNR for various goods and service.<sup>102</sup>

Applicant also made of record the file history for its registration for the mark SNKSTR for “online retail stores services featuring sneakers,” which was assigned to it during prosecution of the subject applications.<sup>103</sup> “Arguably,” asserts Applicant, “if one follows the Examining Attorney’s view of pronunciation, this mark should be understood as “Sneak Store” for one should be SNKSTR for “online retail store services featuring sneakers.’ And yet, the Examining Attorney did not raise an acquired distinctiveness objection.”<sup>104</sup>

Applicant further contends that its class “9/41 Registrations,” namely, Reg. Nos. 6505204 (word mark) and 6489215 (composite mark) for the divided out child applications for downloadable software goods (Class 9) and the services of “providing information, news and commentary in the field of entertainment, popular culture and sports” (Class 41) should have been accepted by the Examining Attorney as evidence in support of Applicant’s claim of acquired distinctiveness because “[t]he [class] 9 goods covered by [Applicant’s class] 41 Registrations are ... sufficiently similar to the subject [class] 35 services because both identifications refer to [Applicant’s] digital SNKRS Platform.”<sup>105</sup>

For example, activity a user generates on the SNKRS App, such as their profile information, payment information, and shipping information is

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<sup>102</sup> December 9, 2021 Request for Reconsideration, TSDR 140-56 (Ex. 8).

<sup>103</sup> *Id.* at 228-272 (Ex. 12).

<sup>104</sup> 6 TTABVUE 15 n. 51 (Applicant’s Brief).

<sup>105</sup> *Id.* at 19.

saved to their user account and may be accessed identically through the SNKRS.com portal. The user experience within the SNKRS Platform is also substantially the same regardless of whether access is made through the SNKRS application or SNKRS.com portal. For example, both the SNKRS App and the SNKRS.com portal feature three main tabs labeled “Feed”, “In Stock”, and “Upcoming”. The content presented in these tabs is also typically identical regardless of whether it is accessed through the SNKRS App or SNKRS.com portal. This steady overlap of content presented in a nearly identical manner further demonstrates the sufficient similarity of the [class] 9 goods, notably covering “downloadable computer application software for mobile phones, namely, software for shopping”, and [class] 35 services to support the 2(f) Claim based on ownership of prior registrations.<sup>106</sup>

Applicant also made of record “23 examples of third-party registrations on the Principal Register which covered [class] 9 goods and [class] 35 services similar to those at issue here to [further] demonstrate that the services are sufficiently similar to support the 2(f) claims.”<sup>107</sup> Applicant highlights one of those registrations, Reg. No. 6004299 for the mark NTWRK on the Supplemental Register, as an example in its brief: “This registration suggests that such disemvoweled marks are capable of acquiring secondary meaning and becoming source identifiers, even when registered for services that may refer to a non-disemvoweled term. At best, such marks are suggestive, not descriptive. For these reasons, the Examining Attorney’s attempts to distinguish the CL 9 and CL 35 goods and services falls short.”<sup>108</sup>

The point of Applicant’s argument above is unclear. Applicant seems to be arguing that it makes no sense for the Examining Attorney to have accepted Applicant’s 2(f)

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<sup>106</sup> *Id.*

<sup>107</sup> 6 TTABVUE 20 (Applicant’s Brief); December 9, 2021 Request for Reconsideration, TSDR 158-89 (Ex. 8).

<sup>108</sup> 6 TTABVUE 20 (Applicant’s Brief).

claims for its divided-out Class 9 and 41 services, while refusing to accept its claim as to the retail stores services, because there is no real difference between the goods and services.

The Examining Attorney responds to this argument in a manner that is also somewhat unclear:

Consumers may believe that SNKRS is a source indicator for applicant's software, but at the same time believe that SNKRS is just the phonetic equivalent of the generic term for the sneakers that they are buying. "Sneakers" is not recognized by consumers as a common term for a type of software, but "sneakers" is recognized by consumers as a common term for a type of store and a type of award. Therefore, evidence that is sufficient to show acquired distinctiveness for SNKRS for software is not sufficient to show acquired distinctiveness for a sneaker store or a sneaker award.<sup>109</sup>

#### D. Analysis

We have carefully reviewed all of the evidence presented by the Examining Attorney and the Applicant in this case (the majority of which is highlighted above), as well as their arguments corresponding to that evidence. Some of it is persuasive, some of it is not.

We find that the Examining Attorney has presented sufficient evidence to establish that "sneaker(s)" is generic for retail services featuring sneakers because it is a term that the relevant public uses or understands to refer to a key aspect or subcategory of the genus, which Applicant does not dispute. *See Royal Crown*, 127 USPQ2d at 1046-47; *Cordua Rests.*, 118 USPQ2d at 1638. We further find that SNKRS would be perceived as a phonetic equivalent of the word "sneakers" when it

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<sup>109</sup> 10 TTABVue 19 (Examining Attorney's Brief).

is used in connection with retail stores services, or award services, featuring sneakers. Simply put, there is no reasonable pronunciation of SNKRS other than as “sneakers’ in the context of providing retail store or award services for “sneakers,” nor does Applicant suggest that there is, such as by proposing, for example, that consumers would spell out the term as S-N-K-R-S, versus pronouncing as the evidence suggests it would be pronounced in the context of sneakers.

These findings, however, do not resolve the issue of whether the **primary** significance of SNKRS is the generic term to which it relates (“sneakers”), or is, instead, that it is perceived as an indicator of Applicant as the source of the services provided thereunder, particularly in view of the numerous articles Applicant produced showing that the relevant public appears to view Applicant’s use of SNKRS as a trademark. Contrary to the Examining Attorney’s contention that such evidence “only shows that applicant intends SNKRS to be a trademark,”<sup>110</sup> it is clear that the authors of those articles, many of which come from widely followed sources, e.g., The Wall Street Journal, NBC Sports, The New York Times, Fox Business, CNN Business, as USA Today, as well as specialized magazines directed to “sneakerheads,”<sup>111</sup> carefully distinguish between their use of SNKRS as a trademark representing Applicant’s goods and services and their identification of those goods and services featuring “sneakers”; they do not confuse the two.

The Examining Attorney appears to have given short shrift to this evidence,

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<sup>110</sup> *Id.* at 14.

<sup>111</sup> *See* notes 55-70 and their accompanying text *supra*.



having already determined that SNKRS is generic.<sup>112</sup> While it is true that under the Trademark Act, “generic marks ... are not registrable as trademarks,” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 112 S. Ct. 2753, 23 USPQ2d 1081, 1083 (1993), and that “[e]ven proof of secondary meaning, by virtue of which some ‘merely descriptive’ terms may be registered, cannot transform a generic term into a subject mark ... no matter how much money and effort the user of a generic term has poured into promoting the sale of its merchandise and what success it has achieved in securing public identification,” thereby depriving competing manufacturers or providers of the similar goods/services to call the goods/services by their name, *In re Am. Acad. of Facial Plastic & Reconstructive Surgery*, 64 USPQ2d 1748, \* (TTAB 2002), we must consider that evidence, as well as other evidence presented by Applicant, in determining whether Applicant’s proposed mark SNKRS is generic in the first place.

Although the Examining Attorney cites several cases for the general proposition that “[a] novel spelling or an intentional misspelling that is the phonetic equivalent of a generic term is also generic if purchasers would perceive the different spelling as the equivalent of the generic term,” including *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1631 (TTAB 1998) (holding MASSFLO generic for mass flowmeters) and *In re ING Direct Bancorp*, 100 USPQ2d 1681, 1690 (TTAB 2011) (holding PERSON2PERSON PAYMENT generic for direct electronic funds transfers including electronic payment services between individuals), as well as TRADEMARK

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<sup>112</sup> 10 TTABVUE 14-15 (Examining Attorney’s Brief).

MANUAL OF EXAMINING PROCEDURE (TMPEP) §1209.03(j), we agree with Applicant that the “case law on the issue of phonetic equivalents” cannot be applied “as a *per se* rule, without regard to consumer perception.”<sup>113</sup> In other words, irrespective of the fact that the relevant consumers are likely to recognize Applicant’s selection of SNKRS as a play on “sneakers,” a word they may understand as generic for a key aspect of Applicant’s proposed services in each application, we must balance that recognition against further evidence showing that the same consumers also view it as a source identifier for Applicant. Here, that evidence derives substantially from Applicant’s impressive showing, through various articles in wide circulation, showing that consumers do regard SNKRS as a trademark.

Applicant suggests that the evidence in this case presents a mixed record, citing the Board’s decision in *In re Trek 2000 Int’l Ltd.*, 97 USPQ2d 1105, 1108-14, to argue that “[i]f the evidence as to genericness is mixed, then the Examining Attorney has not met its burden.”<sup>114</sup> In *Trek 2000*, the Board found that “the evidence of generic use [was] offset by [the] applicant’s evidence that show[ed] not only a significant amount of proper trademark use but also trademark recognition’ by third parties,” quoting *In re Am. Online Inc.*, 77 USPQ2d 1618, 1623 (TTAB 2006), which cited *Merrill Lynch*, 4 USPQ2d at 1143. The Board, in *Am. Online*, similarly found that the applicant’s Internet evidence of use of use of the term INSTANT MESSENGER was impressive, noting that “in virtually all instances” Applicant was “specifically

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<sup>113</sup> 6 TTABVUE 16 (Applicant’s Brief).

<sup>114</sup> *Id.* at 9.

identif[ied] as the source of the services offered under the mark.” *Am. Online*, 77 USPQ2d at 1622.

And in *Merrill Lynch*, a Federal Circuit decision that recognized, for the first time, that a mixed record may have impact our determination of whether a term is generic, the Court found that “[t]he mixture of usages unearthed” by the Examining Attorney in that case “[did] not show, by clear evidence, that the financial community views and uses the term CASH MANAGEMENT ACCOUNT as a generic, common descriptive term for the brokerage services to which [the applicant] Merrill Lynch first applied the term.” *Merrill Lynch*, 4 USPQ2d at 1143. Rather, it found that “[t]he evidence before the Board showed recognition in a substantial number of publications that the source of the CASH MANAGEMENT ACCOUNT was [Merrill Lynch,]” and that evidence “[did] not clearly place [Merrill Lynch’s] mark in the category of a generic or common descriptive terms[,] thereby leading it to the conclusion that “that the USPTO had “failed to sustain its burden of showing” that the proposed mark was generic. *Id.* at 1143-44.<sup>115</sup>

As noted above, Applicant provided a substantial number of articles in widespread circulation evidencing the use of Applicant’s proposed mark by third-parties **as a trademark**. There is no showing therein that the proposed mark SNKRS, and the

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<sup>115</sup> We are not persuaded by the Examining Attorney’s argument that “much of applicant’s evidence relates to applicant’s software platform rather than applicant’s retail services or award services” because we find they pertain to both. The retail store and award services that Applicant provides through its “SNKRS Platform” (including its SNKRS App and the SNKRS.com portal) are, by their very nature, tied to Applicant’s software. Consequently, it is difficult to describe those services without also discussing the software that enables their provision.

generic term “sneakers,” are used interchangeably by those publications, and the Examining Attorney was apparently unable to produce any countering evidence related to third parties that use SNKRS generically when discussing Applicant’s goods or services. Rather, the writers of those publications appear to purposefully distinguish the terms, referring to SNKRS when discussing Applicant’s “brand,” and “sneakers” when referring to the goods/services provided thereunder.

Further, although Applicant’s Vice President (of certain divisions of Applicant) testified about the tremendous reception its proposed SNKRS mark and services received on the Twitter (“more than 11,500,000 active users”), TikTok (“360.9 views of #SNKRS” “almost exclusively” by “consumers that are customers of [Applicant],” and Instagram (“a search for the #SNKRS hashtag on the Instagram Platform’s search engine resulted in a total of 872,075 posts featuring #SNKRS hashtag, only 3 of which were not related to Applicant”), the Examining Attorney was unable to provide any evidence that users on any of those platforms referred to SNKRS in a generic manner.

The Examining Attorney did, as outlined above, present a modicum of evidence showing that SNKRS has, in fact, been used by third-parties in a generic fashion (i.e., the company Terry de Havilland’s offering of a TDH-branded sneaker under the heading “SNKRS WHITE(1)” and Harry’s Shoes’ offering of a sneaker referred to as a “SOFT 7 SNKR” sneaker),<sup>116</sup> though some of his evidence shows use by third parties as a mark or trade name, rather than in a generic fashion (i.e., “The Snkr Truck,”

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<sup>116</sup> See notes 40 and 47 supra and their accompanying text.

“The Snkr Foundation,” and “The SNKR Project”).<sup>117</sup>

As noted above, Applicant argues that “at least 7” of the purported uses of SNKR and/or SNKRS presented by the Examining Attorney “began *after* [Applicant] introduced its mark.” In fact, we are unable to determine from the Examining Attorney’s submission whether any of the uses occurred before Applicant commenced its use of SNKRS. While this is not determinative, since “first use” “does not substantiate the exclusion of others from using [a] designation if it is or has become the generic name of the goods [or services],” *see e.g., KP Permanent Make-Up, Inc. v. Lasting Impressions I, Inc.*, 543 U.S. 111, 125 S. Ct. 542, 78 USPQ2d 1833, 1838 (2004) (the law does not permit “anyone to obtain a complete monopoly on use of a descriptive [or generic] term simply by grabbing it first” (citation omitted), it seems probable that at least some of the users in the Examining Attorney’s evidence may have gotten the idea from Applicant in the first place.

We find that the Applicant’s evidence showing that third parties perceive Applicant’s use of SNKRS as a mark results in a mix usage record that raises doubt that consumers, in fact, perceive its primary meaning as signifying the generic term it is intended to connote, and not as a source-identifier. In *ex parte* appeals, “the Board resolves reasonable doubt as to whether an applied-for mark is generic based on the record evidence in favor of the applicant ‘on the theory that any person who believes that he [or she] would be damaged by the registration will have an opportunity ... to oppose the registration of the mark and to present evidence, usually

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<sup>117</sup> See notes 42-44 *supra* and their accompanying text.

not present in the ex parte application, to that effect.” *Int’l Dairy Foods Assoc. v. Interprofession du Gruyère*, 2020 USPQ2d 10892, at \*81 (TTAB 20202) (citation omitted).

As to Applicant’s survey evidence, we find that it has some problems that limit its probative value. For example, we find it rather odd and potentially misleading to ask participants of the survey whether they viewed each term presented in the survey as either “a common name identifying a type of product” on the one hand, or as “the brand name of an online retail store or retail store” on the other hand.<sup>118</sup> It is almost apples-to-oranges. The survey should have asked, instead, either (1) whether the term is a common name **or** a brand name for a type of product, or (2) whether the term is a common name **or** a brand name for an online retail store. The survey also did not give participants an opportunity to indicate that they did not know the answer or considered a term to be both. Moreover, the survey did not address certain services in each of class of the applications, such as “providing consumer product information and related news in the field of sneakers” in Class 35, or Applicant’s sneaker award services in Class 41. We find that regardless of the weight we give to the survey evidence, it does not change our view of the evidence as a whole, which is that the Examining Attorney’s evidence fails to establish by a preponderance of the evidence that SNKRS is generic for the identified services.

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<sup>118</sup> Italics omitted.

#### E. Conclusion on Genericness

Genericness is a fact-intensive determination, and the Board's conclusion must be governed by the record that is presented to it. Although we understand the Examining Attorney's concerns, it is the record evidence bearing on purchasers' perceptions that controls the determination, not general legal rules or subjective opinions. We find that the Office has not met its substantial burden of establishing that SNKRS is generic for the identified services.

### III. Acquired Distinctiveness Under Section 2(f) – Applicable Law

We now address the Examining Attorney's alternative ground for refusing to register SNKRS in the word mark application, and requiring a disclaimer of that term in the composite mark application – that, if SNKRS is not generic, it nonetheless is merely descriptive and has not acquired distinctiveness.

In the absence of acquired distinctiveness, Section 2(e)(1) of the Trademark Act precludes registration of a mark on the Principal Register that, when used in connection with an applicant's goods, is merely descriptive of them. 15 U.S.C. § 1052(e)(1). “A mark is merely descriptive if it immediately conveys information concerning a feature, quality, or characteristic of the goods or services for which registration is sought.” *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1373 (Fed. Cir. 2018) (quoting *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017)).

Because Applicant has claimed acquired distinctiveness of SNKRS in both applications, there is no dispute that SNKRS is merely descriptive of the identified

services. *Cold War Museum, Inc. V. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009) (“Where an applicant seeks registration on the basis of Section 2(f), the mark’s descriptiveness is a nonissue; an applicant’s reliance on Section 2(f) during prosecution presumes that the mark is descriptive.”). *See also* TMEP § 1212.02(b) (“a claim of distinctiveness under §2(f), whether made in the application as filed or in a subsequent amendment, may be construed as a concession that the matter to which it pertains is not inherently distinctive and, thus, not registrable on the Principal Register absent proof of acquired distinctiveness.”).

As we found in our genericness discussion, the term “sneakers” is generic term for Applicant’s services because it identifies a key aspect of those services, and that the relevant consumers would recognize SNKRS as an abbreviation of “sneakers” regardless of whether they also viewed it as an indicator of source. The resemblance between SNKRS and the word “sneakers” is so evident that the relevant consumer will automatically equate SNKRS and the word “sneakers” and know, without multi-step reasoning, that the services relate to sneakers. We thus find that SNKRS is highly descriptive of Applicant’s services featuring sneakers. And because we find it highly descriptive, Applicant’s burden of establishing acquired distinctiveness under Section 2(f) is commensurately high. *See In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1429, 1424 (Fed. Cir. 2005); *In re Bongrain Int’l Corp.*, 894 F.2d 1316, 13 USPQ2d 1727, 1729 (Fed. Cir. 1990); *In re Greenliant Sys. Ltd.*, 97 USPQ2d, 1078, 1085 (TTAB 2010).



To establish acquired distinctiveness, Applicant must demonstrate that relevant consumers perceive the proposed mark at issue as identifying the producer or source of the product. *See Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 120 S. Ct. 1339, 146 L. Ed. 2d 182, 54 USPQ2d 1065, 1068 (2000) (acquired distinctiveness exists “when, in the minds of the public, the primary significance of a [proposed mark] is to identify the source of the product rather than the product itself”) (citation and internal quotation marks omitted); *Stuart Spector Designs Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 1554 (TTAB 2009) (“An applicant must show that the primary significance of the product configuration in the minds of consumers is not the product but the source of that product in order to establish acquired distinctiveness.”).

Applicants may show acquired distinctiveness by direct or circumstantial evidence. *Schlafly v. Saint Louis Brewery, LLC*, 909 F.3d 420, 128 USPQ2d 1739, 1743 (Fed. Cir. 2018) (“The Board and courts have recognized that both direct and circumstantial evidence may show secondary meaning.”) (citation omitted); *In re Ennco Display Sys.*, 56 USPQ2d 1279, 1283 (TTAB 2000). Direct evidence includes testimony, declarations or surveys of consumers as to their state of mind. *Ennco Display Sys.*, 56 USPQ2d at 1283. Circumstantial evidence, on the other hand, is evidence from which we may infer a consumer association, such as years of use, prior registrations, extensive sales and advertising, unsolicited media coverage, and any similar evidence showing wide exposure of the mark to consumers. *Id.*; *see also Tone Bros. v. Sysco Corp.*, 28 F.3d 1192, 31 USPQ2d 1321 (Fed. Cir. 1994) (listing, as

examples of circumstantial evidence, advertising, sales figures, and intentional copying by competitors).

In particular, the Federal Circuit set out factors to consider in assessing whether a mark has acquired distinctiveness, stating as follows:

[T]he considerations to be assessed in determining whether a mark has acquired secondary meaning can be described by the following six factors: (1) association of the trade[mark] with a particular source by actual purchasers (typically measured by customer surveys); (2) length, degree, and exclusivity of use; (3) amount and manner of advertising; (4) amount of sales and number of customers; (5) intentional copying; and (6) unsolicited media coverage of the product embodying the mark.

*Converse, Inc. v. Int'l Trade Comm'n*, 909 F.3d 1110, 128 USPQ2d 1538, 1546 (Fed. Cir. 2018). *See also In re SnoWizard, Inc.*, 129 USPQ2d 1001, 1004-05 (TTAB 2018). On this list, no single factor is determinative; “[a]ll six factors are to be weighed together in determining the existence of secondary meaning.” *In re Guaranteed Rate, Inc.*, 2020 USPQ2d 10869, at \*3 (TTAB 2020) (quoting *Converse*, 128 USPQ2d at 1546); *In re Tires, Tires, Tires Inc.*, 94 USPQ2d 1153, 1157 (TTAB 2009).

A. Association of SNKRS with a Particular Source by Actual Purchasers

Applicant argues that “Converse factor (1) is supported by the Poret Survey” which “showed that 62.0% of respondents identified the term ‘SNKRS’ as a brand name compared to only 26.0% that answered it is a common name.”<sup>119</sup> As noted earlier, the Examining Attorney argues that Applicant’s survey evidence asked the wrong questions and therefore is not persuasive.<sup>120</sup>

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<sup>119</sup> 6 TTABVUE 21 (Applicant’s Brief).

<sup>120</sup> 10 TTABVUE 13-14 (Examining Attorney’s Brief).

Although we gave limited weight to Applicant's *Teflon*-style survey in our genericness analysis, we find, nevertheless, that it has some probative value in showing that consumers perceive Applicant's use of SNKRS as indicating source.

B. Length Degree, and Exclusivity of Use

As noted earlier, Applicant's vice president Ron Faris declared in one of his declarations that Applicant "has continuously used its SNKRS Mark in interstate commerce in connection with its goods/services since at least as early as February 2015."<sup>121</sup> As we also noted, the Examining Attorney has provided evidence of several third-parties that appear to be using the term as a mark.<sup>122</sup>

However, one's use need not be exclusive to prove acquired distinctiveness. *Nestle Co, Inc. v. Joyva Corp.*, 227 USPQ 477, 479 (TTAB 1985). Applicant's use must be "substantially exclusive," which makes an allowance for inconsequential use by others. *See L.D. Kichler Co. v. Davoil, Inc.*, 192 F.3d 1349, 52 USPQ2d 1307, 1309 (Fed. Cir. 1999). Because there are only a few other uses, little indication of when those uses began, and no evidence of the extent of those uses, we find the third-party use inconsequential. Consequently, we further find that Applicant has made substantially exclusive use of SNKRS since February 2015.

C. Amount and Manner of Advertising

As noted earlier, Mr. Faris testified that Applicant uses the term "SNKRS Platform" as incorporating "the full range of digital goods and services provided under

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<sup>121</sup> See note 73.

<sup>122</sup> See note 188.

the SNKRS Mark, including the ability of users to purchase products through the online marketplace, earn points, and win raffles/contests”; that “[t]he SNKRS Mark has been consistently and extensively used in connection with an online marketplace and online retail services on the SNKRS platform, through which users can make purchases of [Applicant’s] apparel and sneakers...”; and that “Applicant drives downloads of the SNKRS App through digital platforms such as Apple Search Ads, Facebook, Instagram, Snapchat, Google, YouTube, and Twitter.”<sup>123</sup> The evidence also supports Applicant’s contention that it has promoted its SNKRS mark through various events and third-party partnerships such as its promotion on Air Max Day, on the Fortnite and NBA2K gaming platforms, as well as through a partnership with basketball star LeBron James.<sup>124</sup>

Applicant’s extensive advertising supports a finding that SNKRS has acquired distinctiveness.

#### D. Amount of Sales and Number of Customers

As noted above, Mr. Faris testified that as of 2015, “millions of orders have been placed through the SNKRS Platform online marketplace;<sup>125</sup> that sales made through Applicant’s “online marketplace” (the “SNKRS Platform”) have increased every year”; that “[s]ince 2018, sales made through the SNKRS Platform online marketplace have

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<sup>123</sup> May 14, 2021 Voluntary Amendment, TSDR 8-9, 13 (Second Declaration of Ron Faris ¶¶ 7-8, 11).

<sup>124</sup> December 9, 2021 Request for Reconsideration, TSDR 90-92 (Third Declaration of Ron Faris ¶¶ 13-16).

<sup>125</sup> *Id.* at 92 (¶ 17).

steadily increased at an average of +43% year over year, and since 2019, over 10,000,000 orders have been placed through the SNKRS Platform online marketplace in North America; and that “in just the last Quarter of 2021, the SNKRS Platform grew over 90% in demand and saw nearly 80% growth in monthly active users.”<sup>126</sup>

Applicant’s sales support a finding that SNKRS has acquired distinctiveness.

E. Intentional Copying.

There is no evidence of intentional copying.

F. Unsolicited Media Coverage of the Services Embodying the Mark

As noted above, unsolicited media coverage of Applicant’s mark has been substantial since Applicant first introduced the mark.<sup>127</sup> That evidence supports a finding that SNKRS has acquired distinctiveness.

G. Conclusion on Acquired Distinctiveness

After considering all of the factors for which there is evidence in determining whether Applicant’s mark has acquired distinctiveness, we find that Applicant has met its burden in proving it.

**Decision:** The refusal to register SNKRS in Application Serial No. 88781470 on the ground that is generic for the identified services, or in the alternative that it is merely descriptive of them and has not acquired distinctiveness is reversed. The

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<sup>126</sup> December 9, 2021 Request for Reconsideration, TSDR 92 (Third Declaration of Ron Faris, ¶ 17).

<sup>127</sup> See notes 56-70 supra and their accompanying text.

refusal to register SNKRS and Design in Application Serial No. 88781464 on the ground that Applicant has not disclaimed SNKRS because it is generic for the identified services, or in the alternative that it is merely descriptive of them and has not acquired distinctiveness, is also reversed. Both applications will proceed to publication.