ESTTA Tracking number: **ESTTA316850**
Filing date: **11/13/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91173105
Party	Plaintiff Honda Motor Co., Ltd.
Correspondence Address	Dyan Finguerra-DuCharme, Esq. Wilmer Cutler Pickering Hale and Dorr LLP 399 Park Avenue New York, NY 10022 UNITED STATES Dyan.Finguerra-DuCharme@wilmerhale.com
Submission	Brief on Merits for Plaintiff
Filer's Name	Dyan Finguerra-DuCharme
Filer's e-mail	dyan.finguerra@wilmerhale.com, lizette.shea@wilmerhale.com
Signature	/dyan finguerra-ducharme/
Date	11/13/2009
Attachments	trial brief.PDF (95 pages)(10795786 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 78/339,571
Published in the Official Gazette of May 30, 2006 at TM 674
Mark: DEALERDASHBOARD

----------x

Honda Motor Co., Ltd.,

Opposition No. 91/173,105

Opposer,

v.

Michael Dalton,

Applicant.

----------x

HONDA MOTOR CO., LTD.'S TRIAL BRIEF

WILMER CUTLER PICKERING
HALE AND DORR LLP
399 Park Avenue
New York, New York 10022

TABLE OF CONTENTS

DESCRIPTION OF THE RECORD 1

STATEMENT OF THE ISSUES 3

FACTS 4
- I. The Meaning of the Term "Dealer" 4
- II. The Meaning of the Term "Dashboard" in Today's Computer Age 4
- III. Honda's Use of the Term "Dealer Dashboard" 6
- IV. Applicant's DEALERDASHBOARD Trademark Application and Use of the Term 8
- V. Third Parties Use of the Term Dealer Dashboard to Describe Their Services 10

ARGUMENT 15
- I. Honda Motor Co., Ltd. Has Standing 15
- II. Registration Should Be Refused on the Grounds that the Term "Dealerdashboard" Is Descriptive of the Identified Services 16
- III. Registration Should Be Refused on the Grounds that The Term Dealerdashboard is Generic for the Identified Services 23
  - A. Car Dealership Managers and the General Public Are the Relevant Public for Applicant's Services 23
  - B. The Category of Services Are Computer-Based Dashboards 24
  - C. The Relevant Public Understands DEALERDASHBOARD To Refer to the Genus of the Services 24
- IV. Registration Should Be Denied Because Applicant Committed Fraud On The PTO, Or In The Alternative, Registration Should be Denied Because Applicant Does Not Satisfy The Lanahan Act's Use In Commerce Requirement 29

OPPOSER'S OBJECTIONS TO APPLICANT'S EVIDENCE 31
- I. Applicant's Evidence Improperly Submitted During His Testimony Deposition and After the Close of Discovery Must Be Excluded 31
- II. The Board Should Afford No Weight to Third Party Registrations 33
- III. Applicant's Testimony and Email Exhibits Are Hearsay 34
- IV. Applicant's Internet Printouts Are Not Printed Publications 34
- V. Printouts from the "Way Back Machine" Are Not Official Records 35

CONCLUSION 36

TABLE OF AUTHORITIES

Federal Cases

Allied Mills, Inc. v. Kal Kan Foods, Inc.,
203 U.S.P.Q. 390 (TTAB 1979) 33

British-American Tobacco Co. v. Philip Morris Inc.,
55 U.S.P.Q.2d 1585 (TTAB 2000) 16

Buti v. Perosa, S.R.L.,
132 F.3d 98 (2d Cir. 1998) 30

Chamilia LLC v. Pandora Jewelry LLC,
85 U.S.P.Q.2d 1169 (S.D.N.Y. 2007) 35

Dial-A-Mattress Operating Corp.,
57 U.S.P.Q.2d 1807, (Fed. Cir. 2001) 22

Gravel Cologne, Inc. v. Lawrence Palmer, Inc.,
176 U.S.P.Q. 123 (C.C.P.A. 1972) 34

Greyhound Corp. v. Armour Life Insurance. Co.,
214 U.S.P.Q. 473 (TTAB 1982) 29

H. Marvin Ginn Corpo. v. International Association of Fire Chiefs, Inc.,
228 U.S.P.Q. 528 (Fed. Cir. 1986) 23

H.D. Lee Co. v. Maidenform Inc.,
87 U.S.P.Q.2d 1715 (TTAB 2008) 32

Hiraga v. Arena,
90 U.S.P.Q.2d 1102 (TTAB 2009) 35

Hovnanian Enters., Inc. v. Covered Bridge Estates, Inc.,
195 U.S.P.Q. 658 (TTAB 1977) 16

In re Active Ankle Sys., Inc.,
83 U.S.P.Q.2d 1532 (TTAB 2007) 25

In re Bayer Aktiengesellschaft,
82 U.S.P.Q.2d 1828 (Fed. Cir. 1986) 17

In re Bose,
91 U.S.P.Q.2d 1938 (Fed. Cir. 2009) 28

In re Copytele, Inc.,
31 U.S.P.Q2d 1540 (TTAB 1994) 19

In re Dial-A-Mattress Operating Corp.,
57 U.S.P.Q.2d 1807 (Fed. Cir. 2001) 22

In re Finisair Corp.,
78 U.S.P.Q.2d 1618 (TTAB 2006) 33

In re IP Carrier Consulting Group,
84 U.S.P.Q.2d 1028 (TTAB 2007) 10

In re Lens.com, Inc.,
83 U.S.P.Q.2d 1444 (TTAB 2007) 28

In re Litehouse, Inc.,
82 U.S.P.Q.2d 1471 (TTAB 2007) 10

In re Merrill Lynch, Pierce, Fenner and Smith Inc.,
4 U.S.P.Q.2d 1141 (Fed. Cir. 1987) 23

In re Nett Designs Inc.,
57 U.S.P.Q.2d 1564 (Fed. Cir. 200)1 33

In re Putnam Publishing Co.,
39 U.S.P.Q.2d 2021 (TTAB 1996) 18

In re Rodale Inc.,
80 U.S.P.Q.2d 1696 (TTAB 2006) 33

In Re Rosemount, Inc.,
86 U.S.P.Q.2d 1436 (TTAB 2008) 28

In re Sun Microsystems, Inc.,
59 U.S.P.Q.2d 1084 (TTAB 2001) 19

In re Tires, Tires, Tires,
Serial No. 77/091,459 (TTAB 2009) 25

In re Tower Tech Inc.,
64 U.S.P.Q.2d 1314 (TTAB 2002) 17

In re Venture Landing Assoc.,
226 U.S.P.Q. 285 (TTAB 1985) 17

In re Wilson,
57 U.S.P.Q.2d 1863 (TTAB 2001) 33

Nat'l Aeronautics & Space Admin. v. Bully Hill Vineyards, Inc.,
3 U.S.P.Q.2d 1671 (TTAB 1987) 31

Novak v. Tucows Inc.,
No. 06-CV-1909, 2007 U.S. Dist. LEXIS 21269 (E.D.N.Y. Mar. 26, 2007)
No. 07-2211-cv, 2009 U.S. App. LEXIS 9786 (2d Cir. May 6, 2009) 35

Paris Glove of Can. Ltd. v. SBC/Sporto Corp.,
84 U.S.P.Q.2d 1856 (TTAB 2007) 34, 35

Plyboo Am. Inc. v. Smith & Fong Co.,
51 U.S.P.Q.2d 1633 (TTAB 1999) 34

Raccioppi v. Apogee Inc.,
47 U.S.P.Q.2d 1368 (TTAB 1998) 34

Shoe Factory Supplies Co. v. Thermal Engineering Co.,
207 U.S.P.Q. 517 (TTAB 1980) 31

Super Valu Stores Inc. v. Exxon Corp.,
11 U.S.P.Q.2d 1539 (TTAB 1989) 32

Tanner's Council of Am., Inc. v. Gary Industries Inc.,
440 F.2d 1404 (CCPA 1971) 15

Target Brands Inc. v. Hughes,
85 U.S.P.Q.2d 1676 (TTAB 2007) 16

Universal Oil Prods. Co. v. Rexall Drug & Chem. Co.,
174 U.S.P.Q. 458 (CCPA 1972 16

Visual Information Institute, Inc. v. Vicon Industries Inc.,
209 U.S.P.Q. 179 (TTAB 1980) 32

Federal Rules

Fed. R. Evid. 602 34
Fed. R. Evid 802 33

Federal Regulations

37 C.F.R. § 2.123(k) ..... passim
37 C.F.R. § 2.122(e) 34, 35

Pursuant to 37 C.F.R. § 2.128, Opposer Honda Motor Co., Ltd. ("Opposer" or "Honda") submits this Trial Brief in Support of its Notice of Opposition to the registration by Applicant Michael Dalton ("Applicant" or "Dalton") of the mark DEALERDASHBOARD (Serial No. 78/339,571).

DESCRIPTION OF THE RECORD

The Record consists of the following: the testimony deposition of Cynthia Mangham (American Honda Motor Co., Ltd's Manager of the Interactive Network Marketing and Rollout); the testimony deposition of Tracy Chu (third party investigator); the testimony and discovery depositions of Michael Dalton (the Applicant); the exhibits presented during the depositions; Applicant's Responses to Opposer's First Set of Interrogatories; Opposer's Request for Admissions to Applicant; copy of an article written by Calvin Kam & Martin Fischer entitled *Capitalizing on Early Project Decision-Making Opportunities to Improve Facility Design, Construction and Life-Cycle Performance*, 13 EACONS 1, 53-56 (2004); copy of an article written by Thomas Erickson et. al entitled *Seeing is Believing: Designing Visualizations for Managing Risk and Compliance,* 46 IBM Systems Journal 205 (April 2007 – June 2007); copy of an article written by Judith Lamont entitled *Data-driven Decisions: The View from THE* Dashboard, 16 KM World 14 (March 2007); copy of an article written by John Goff entitled *See It Now*, CFO Magazine (December 2003); copy of an article written by Scott Wallace entitled *Everybody's System*, Information Week (August 12, 1991); copy of a dictionary entry located in The American Heritage College Dictionary, 3d ed. (1997); copy of a dictionary entry located in Webster's Third New International Dictionary (2002); copies of the official records archived in the TESS system of registered marks containing the term DASHBOARD; copies of the official records archived in the TESS system of registered marks containing the term DEALER; copies of the official record archived in the NetworkSolutions whois directory; copies of the official

record archived in the TESS system regarding opposition 91163349; copies of the wayback machine archived at http://www.archive.org; copy of the website harley-davidson.com archived at http://www.harley-davidson.com/CO/CAR/en/JobDescription.asp?/locale= en_US&bmLocale-EN; copy of a print out of a PDF slide show for Harley-Davidson available at the website address: http://www.google.com/url?q=https://www.sdn.sap.com/irj/boc/index%3Frid%3D/library/uuid/d03abe46-6843-2b10-d5al-e17e69dd81ef%overridelayout%3Dtrue&ei= WLxvSqvyFoznlAetq6DMBQ&sa=X&oi=spellmeleon_result&resnum=1&ct=result&usg=AFQjCNELvugZOJI135KOe_jxJh_PiBoTmA; copies of the Nielsen Company archived on the website server: http://nielsenmedia.com; copies of the Wiki Encyclopedia archived on the website: http://en.wikipedia.org/wiki/Sample_size; copies of the official search results on the search term HONDA as provided by the websites Yahoo.com, AOL.com, and Google.com; copies of the official records of Network Solutions whois search archived at networksolutions.com; copies of the official record of Circa.ca whois search archived at circa.ca; copies of the official record of the 10dollar.ca whois search archived at 10dollar.ca; copy of the screen-shot of dealerdashboard.ca; and Honda Motor Co., Ltd.'s Form 20-F filed with the United States Security Exchange Commission.

STATEMENT OF THE ISSUES

This Opposition has three issues:

1. Whether the term DEALERDASHBOARD is descriptive of the services identified in Serial No. 78/339,571, namely "providing automotive dealerships managerial information concerning their Sales, Service, and Parts departments key financial indicators of how their dealership is performing via the Internet; and providing a web site featuring information about automobile dealerships, automobiles, automotive parts and accessories, at which users can link to the retail or wholesale web sites of others."

2. Whether the term DEALERDASHBOARD is generic for the services identified in Serial No. 78/339,571, namely "providing automotive dealerships managerial information concerning their Sales, Service, and Parts departments key financial indicators of how their dealership is performing via the Internet; and providing a web site featuring information about automobile dealerships, automobiles, automotive parts and accessories, at which users can link to the retail or wholesale web sites of others."

3. Whether Applicant engaged in fraud on the Patent and Trademark Office when he filed his declaration of use for the DEALERDASHBOARD application, or in the alternative, whether the Applicant did not use the mark in commerce as required by 15 U.S.C. § 1127 such that the application is defective.

FACTS

I. The Meaning of the Term "Dealer"

Applicant admits that he did not coin the term "dealer". (Dalton Disc. Dep. at 42:15-18.[1]) The definition of "dealer" is undisputed. Applicant defines "dealer" as "someone who's in the marketing for automobiles, parts, service, sales." (*Id.* at 42:24-25.) Similarly, the *American Heritage College Dictionary* defines "dealer" as "one engaged in buying and selling" (H-001524),[2] and *Webster's Third New International Dictionary* defines "dealer" as "one that divides, distributes or delivers." (H-001527)

II. The Meaning of the Term "Dashboard" in Today's Computer Age

The traditional definition of dashboard relates to the instrument panel of a car. (Dalton Disc. Dep. at 43:1 to 44:1.) In recent years, however, "dashboard" has developed a new meaning with respect to a computerized visual interface that provides an overview of a business's key performance indicators in real time. (Mangham Dep. at 10:4 to 11:16.) Like a dashboard on a car, a business dashboard provides a "quick snapshot of what you need to know ... to run your business." (*Id.* at 10:23 to 11:2.)

A "dashboard" is "typically graphical in nature, providing visualizations that help focus attention on key trends, comparisons, and exceptions." *Excel 2007 Dashboards & Reports for Dummies* at H-000026. Dashboards are designed around a set of measures or "key performance indicators," which are indicators "of the performance of a task deemed to be essential to daily operations or processes." *Id.* at 13. Easy access to a company's key performance indicators is critical for successful management. *Performance Dashboards* at H-000596. The reliance on "business intelligence" in corporate America manifests itself in different ways including "in the

---

1 Applicant's discovery deposition was made of the Record by Opposer's Notice of Reliance at Tab A.

2 Opposer's Notice of Reliance entered 11 printed publications into the Record at Tab C. Hereinafter, these publications will be referred to by title and specific page numbers will be cited by production number.

form of dashboard fever." *Excel 2007 Dashboards & Reports for Dummies* at H-000016. Thus, "dashboards provide summary data from business intelligence (BI) systems so that CEOs, managers and employees can get an instant reading of key performance indicators for their organization's activities." *Data-Driven Decisions: The VIEW From THE Dashboard* at H-001511.

Examples of dashboards are as follows:

- Quicken Loans' managers use Kanban-style dashboards to track the performance of their team and know when to lend assistance or provide additional training. The Kanban dashboard is a color-coded chart consisting of a dozen or so key performance indicators (KPIs) that are updated every 10 minutes. ... The KPIs are simple counts with thresholds applied so that managers can quickly see which consultants are on track to meet goals and which are not, by the color-coding of the cells." *Performance Dashboards* at H-000737-738.

- Hewlett Packard TSG's strategic dashboard uses a methodology that "focuses the energy of an organization into achieving strategic goals and objectives that are represented by key performance indicators (KPIs) customized to every group in the company." Performance Dashboards at H-000769.

"One of the few characteristics that most vendors seem to agree on is that for something to be called a dashboard it must include graphical display mechanisms such as traffic lights and a variety of gauges and meters, many similar to the fuel gauges and speedometers found in automobiles." *Information Dashboard Design* at H-000952; *see also Marketing by the Dashboard Light* at H-000365 (drawing a metaphor to a car dashboard). The other commonality between dashboards is that they provide "an overview of something that's currently going on in the business." *Information Dashboard Design* at H-000952; *see also Marketing by the Dashboard Light* at H-000373-H000374 (explaining the key benefits for using a marketing dashboard). Thus, "key performance indicators and dashboards appear to be synonymous." *Information Dashboard Design* at H-000928.

The use of dashboards by corporate America is growing. In a 2003 survey, nearly 50% of respondents indicated an intention to use a dashboard. *See It Now* at H-001514. This definition of "dashboard" (as described above), spans all business sectors, not just the automotive industry. (Mangham Dep. 12:14-19.)

III. Honda's Use of the Term "Dealer Dashboard"

American Honda Motor Co., Inc. is a wholly-owned subsidiary of Honda Motor Co., Ltd., a Japanese corporation. (H-001701) Honda Motor Co., Ltd. is a publicly traded company and is listed on the New York Stock Exchange and the Tokyo Stock Exchange, among others. (H-001674) In this Brief, "Opposer" and "Honda" refer to the two entities in combination.

One way in which Honda communicates with its dealers is through its interactive network. (Mangham Dep. 13:3-13.) On the interactive network, dealers can post and respond to issues on an electronic bulletin board and can search for available parts and vehicles. (*Id.* at 13:21 to 14:14.) In response to requests from dealers for access to more information, Honda introduced a dashboard accessible through the interactive network. (*Id.* at 14:17-24; 17:4-6; 19:13-15.) Honda created the "dealer dashboard" in 2004. (*Id.* 16:11-17:6.)

Honda's dealer dashboard provides dealer principals with key operating indicators and critical information about the dealership to assist performance. (*Id.* at 16:6-10.) Examples of the key indicators available on Honda's dealer dashboard include retail delivery, sales inventory and customer satisfaction. (*Id.* at 17:1-3.) The purpose of the dealer dashboard is "to provide a summary of information to the dealer principal." (*Id.* at 17:9-10.) Dealer principals are automatically given access to the dashboard and the dealer can also assign access to others at the dealership. (*Id.* 19:8-12.)

When a dealer logs into the interactive network, the first thing it sees is the dashboard. (*Id.* at 14:19-24; 15:5-12.) When it was first created, Honda's dealer dashboard consisted of

three electronic tabs that reflected the departments in the dealership – sales, service and parts. (*Id.* at 18:18-20.) Honda later added a fourth tab. (*Id.* at 18:18.) Each tab contains electronic reports or links to an application that elaborates on the report. (*Id.* at 18:21 to 19:5.) When the dashboard first opens, the dealer sees various snapshot figures on the page for the sales area. (*Id.* at 19:20-25.)

Honda chose the name "dealer dashboard" to describe the dashboard available to dealers on its interactive network because it was descriptive of the product features thereby making it easier for dealers to remember. As the Manager of the Interactive Network Marketing and Rollout explained:

> Q: What made Honda choose the term dealer dashboard to describe its product?
>
> A: Prior to our group existing, the technical group was responsible for naming the applications on [the interactive network]. And they had a tendency to come up with clever marketing types of names, and it was difficult for dealerships to find applications. And based -- that was based on research. We went out and asked dealers about their opinion on the interactive network. And based on that, my group was directed by me -- and in this case, this was my product -- to name applications as -- for what they are as opposed to coming up with marketing terms, since this is really a utility site. It's not something we are trying to sell the dealers.
>
> Q: And when you say that it was -- in this case, you wanted to come up with a name for an application as for what they are as opposed to a marketing term, what do you mean by that?
>
> A: So in this case, it's a dashboard. And it's a dashboard for dealers, so it's called dealer dashboard. And we knew in the future that we might have a dashboard for, for example, sales managers. So it would be called sales manager dashboard or service manager dashboard. And basically, the dealer is the audience and dashboard is what it is.

(*Id.* at 17:11 to 18:11.) Thus, Honda chose the name "dealer dashboard" precisely because of its descriptive and generic nature.

Applicant sent a cease and desist letter to Honda and demanded that it cease using the term "dealer dashboard" to describe the dashboard on its internal network for dealers. (*See* Answer ¶ 4; Applicant's Interrog. Response No. 23; Dalton Disc. Dep. 203:6-14.)

IV. Applicant's DEALERDASHBOARD Trademark Application and Use of the Term

On December 11, 2003, Michael Dalton ("Applicant") filed U.S. Trademark Application Serial No. 78/339,571 for DEALERDASHBOARD in Class 25 for goods described as "automotive related goods and services." (Dalton Disc. Dep. Ex. 2.) After responding to a series of office actions, Applicant amended his description of services to the following:

> providing automotive dealerships managerial information concerning their Sales, Service, and Parts departments key financial indicators of how their dealership is performing via the Internet; and providing a web site featuring information about automobile dealerships, automobiles, automotive parts and accessories, at which users can link to the retail or wholesale web sites of others.

(Dalton Disc. Dep. Ex. 11.) In his February 14, 2006 office action response, Applicant changed the filing basis for the application from Section 1(b) to Section 1(a) and declared that the DEALERDASHBOARD mark was first used in commerce on the services listed in the application at least as early as October 5, 1999. (Dalton Disc. Dep. Ex. 11.)

At deposition, Applicant admitted that while he has offered to provide "dealerships managerial information concerning their Sales, Service and Parts departments key financial indicators of how their dealership is performing," he has not rendered these services in commerce:

> Q: Okay. And when did you say that you began using the mark for -- on the goods that are described here, which is "First Use Anywhere Date?"
>
> A: 10/5/99.

Q: Okay. And your new description included "providing automotive dealerships managerial information concerning their Sales, Service, and Parts departments key financial indicators of how their dealership is performing via the Internet," right?

A: Uh-huh.

Q: And you were -- you were doing that as of October 5th of '99?

A: Correct.

Q: Okay. But you didn't -- nobody was actually signed up to use those services at that time?

A: Correct.

(Dalton Disc. Dep. 84:25 to 86:17.)

Q: Okay. Now, just to -- just to be clear then, if -- and I know you had mentioned before that so far a dealership has not signed on yet for this service. If they did, they would get on their screen, their computer screen, all of this type of information?

A: Correct.

(Dalton Disc. Dep. 192:3-9.)

Q: Okay. Page 1434 of Exhibit 44. What dealer is currently using this document?

A: I don't have that answer, because there's several dealerships who have access to that document, as far as DealerDashboard there are none.

Q: There are none, okay. So --

A: Services are available, but they are not currently being utilized.

Q: Okay. What I would like to know is on what date did you first obtain a customer who actually used your dealership services?

MR. DALTON: Objection. Irrelevant, immaterial.

A: I have not secured any customers, I believe I testified to that in the deposition.

Q: Okay. So, right now -- I'm sorry, strike that. As of 10/5/1999, is it true that you had no customer to whom you were providing automotive dealership managerial information?

A: I can't -- I don't -- I don't know.

Q: Okay.

A: I do know that I was offering services since 1/1/99.

Q: But no one was actually using them as far as you know?

MR. DALTON: Objection. Irrelevant, immaterial.

A: That's correct.

(Dalton Test. Dep. at 50:19 to 51:21.)

In 1999, Dalton formed dealerdashboard.com, a sole proprietorship. (Dalton Disc. Dep. 19:1-9.) Through the sole proprietorship, Dalton operates a website located at <dealerdashboard.com> at which he offers his services. (*Id.* at 19:10 to 20:7.)

V. Third Parties Use of the Term Dealer Dashboard to Describe Their Services

Honda has entered into the record dozens of examples of third parties who use the term "dealer dashboard" to describe their services.[3] (Mangham Tr. at Exs. 1-24; Chu Tr. at Exs. 1-44) The Record includes the following (among others):

> Karastan: "Just like a car dashboard delivers critical information to the driver (i.e. speed, gear, lights, gas temperatures etc.) Each dealer Dashboard delivers all the current and important information at a glance (i.e. newest documents, announcements, calendars, links etc.) (Mangham Tr. at Ex. 5 (hereinafter H-001208-10))
>
> Diversified Financial Services: From its privacy policy statement: "With respect to cookies: On Dealer Logins, we set a cookie that

[3] Honda does not offer any of the Internet printouts reflecting third parties' use of the term "dealer dashboard" for the truth of the matter asserted therein. Rather, these exhibits are offered to show that third parties are using the term on the Internet to describe their services. Whether or not the services are actually provided as described is irrelevant to the case at hand. *See In re Litehouse, Inc.*, 82 U.S.P.Q.2d 1471, 1473 (TTAB 2007) (affirming refusal to register based in part on Internet printouts reflecting use of term by third parties); *In re IP Carrier Consulting Group,* 84 U.S.P.Q.2d 1028, 1032 (TTAB 2007) (noting that "Internet evidence is generally admissible and may be considered for purposes of evaluating a trademark"); *see also Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, Opp. No. 91/161,403 (TTAB 2008) (sustaining opposition with consideration of third party use). All Internet printouts of third party websites were authenticated during the depositions of Cynthia Mangham and Tracy Chu. (Mangham Dep. Tr. at 20:16 to 45:19; Chu Dep. Tr. at 7:6 to 51:15.)

helps us determine on the Dealer Dashboard pages your unique dealer identification number." (Mangham Tr. at Ex. 18 (hereinafter H-001224-25))

Siebel: "Using Siebel Dealer Dashboards (Dealer)" (Mangham Tr. at Ex. 17 (hereinafter H-001226-27)

Enterprise-Dashboard.com: depicts "a screenshot of PFW Systems Corp's IntelliDealer Dashboard." (Mangham Tr. at Ex. 3 (hereinafter H-001162-72))

Denon: "The Dealer Dashboard is the easiest way for Denon dealers to get the latest information on Denon products, events, company information and more. As a Denon dealer, the Dashboard provides you with all kinds of product related items such as downloads, images, sell sheets and more." (Mangham Tr. at Ex. 14 (hereinafter H-001228))

Marantz: "Welcome to the Marantz Dealer Dashboard! The Dealer Dashboard is the easiest way for Marantz dealers to get the latest information on Marantz products, events, company information and more. As a Marantz dealer, the Dashboard provides you with all kinds of product related items such as high resolution images, sell sheets and corporate identity images." (Mangham Tr. at Ex. 16 (hereinafter H-001230))

McIntosh: "WELCOME TO THE MCINTOSH DEALER DASHBOARD" (Mangham Tr. at Ex. 13 (hereinafter H-001231-32))

Furnishweb: "On the Dealer Dashboard there are two new pieces of information; Collections Year-To-Date (YTD) and Top Sellers YTD. The Collections pie chart displays the collections a dealer has purchased most in the current year. The Top Sellers lists the top 10 products the dealer purchased this year. … There is also a new link on the Dealer Dashboard to Sales Tools. Sales Tools is deceptively simple but this link conceals some real power! Sales Tools is an interactive, sortable summary of sales information. Sales history can be summarized by product, collection, type, family, class, and finish … each column is sortable providing the ability to find the Best Sellers in each category." (Chu Tr. at Ex. 7 (hereinafter H-001554-57))

GoalLine Solutions: Internet printout depicts a portal to a "Dealer Dashboard." (Mangham Tr. at Ex. 4 (hereinafter H-001173-74))

Moore and Scarry: Internet printout depicts a portal to a "Dealer Dashboard." (Chu Tr. at Ex. 4 (hereinafter H-001551))

Mayline Group: "Mayline Releases New Dealer Dashboard. We have simplified dealer access to Mayline information. The Mayline Group has made it easier than ever for dealers to obtain proprietary information on a host of topics via a new link on the Mayline website. Called the "Dealer Dashboard," this intranet site allows dealers to obtain up-to-the hour information on Inventory Availability, Order Tracking, Promotions, Factory Closeouts and more. We have made it simple to access information 24-hours a day and also avoid possible delays versus calling into customer service." (Chu Tr. at Ex. 8 (hereinafter H-001558-59))

Rockford Corporation: Internet printout depicts a portal to a "Dealer Dashboard." (Chu Tr. at Ex. 10 (hereinafter H-001561))

ProfitFocus – Deloitte Motor Industry Services: "ProfitFocus Dealer Dashboard ... Our Dealer Dashboard provides this functionality – when your monthly data is uploaded to our website reports are automatically generated for your viewing." (Chu Tr. at Ex. 11 (hereinafter H-001562-63))

Arctic Spas: Internet printout depicts a portal to a "Dealer Dashboard." (Chu Tr. at Ex. 15 (hereinafter H-001569))

Harley-Davidson, Inc.: describing Harley-Davidson's "Dealer Dashboard Coordinator" job position (Chu Tr. at Ex. 20 (hereinafter H-001577-81))

Fujitsugeneral: "Dealer Dashboard for Contractors. Your car has a dashboard that helps you know what's happening while you drive. Wouldn't you want to know more about your customers and what's happening with your business? Fujitsu has a Dealer Dashboard! A Fujitsu dealer has access to their customer's registration information. You can also see what comments they have about the work your people have done in their home and you can choose to have those comments listed on our dealer ranking site with your company's name. The better the work you do, the better you will look to prospective buyers!" (Chu Tr. at Ex. 6 (hereinafter H-001553))

Little Giant Ladder Systems: Internet printout depicts a portal to a "Dealer Dashboard." (Chu Tr. at Ex. 12 (hereinafter H-001564-65))

TheDealerDashboard.com: "Here is a great new tool to help you track your entire e-commerce department's initiatives. Monitor in real time all spending and performance. Are you putting your ad dollars where you are getting the best results?

TheDealerDashboard.com will tell you." (Chu Tr. at Ex. 16 (hereinafter H-001570))

Simply Hired: "Average Dealer Dashboard Support Salaries." (Chu Tr. at Ex. 17 (hereinafter H-001571-72))

Glass-Net: "From here you'll be taken back to My Stock. The unqualified vehicle has been added to your stock. You can access it using the "Unqualified" icon in the "Dealer Dashboard"...". (Chu Tr. at Ex. 22 (hereinafter H-001585-95))

GM Canada Dealer Websites: "Key business reporting tools in our Dealer Dashboard help real-time for optimal results." (Chu Tr. at Ex. 23 (hereinafter H-001596-1600))

Courtesy Car Manager C²Man Finance Dealer: "C²Man Finance Dealer Dashboard by Period. C²Man provides a dealer by month spreadsheet report for any selected period (month, quarter or year) with the current (partial) month as the default. All information is 100% up to date as a complete and correct online definition of all important statistics and measurable management criteria." (Chu Tr. at Ex. 24 (hereinafter H-001601-02))

RiderRescue Motorcycle & Scooter Roadside Assistance: Internet printout depicts a portal to a "Dealer Login." (Chu Tr. at Ex. 25 (hereinafter H-001607))

Worldsview: Internet printout depicts a portal to a "Dealer Dashboard." (Chu Tr. at Ex. 27 (hereinafter H-001612))

Alfa Romeo: "Alfa Romeo Dealer dashboard Information Architecture." (Chu Tr. at Ex. 29 (hereinafter H-001616))

Automotive News: "Manheim Auctions' Dealer Dashboard showed auction first-time conversion rates stood at 65% for retail stock and 74% for part-exchanges in July 2008." (Chu Tr. at Ex. 30 (hereinafter H-001617-19))

AutoLoanDaily: "The AutoLoanDaily Dealer Dashboard. AutoLoanDaily lets dealers control the leads they receive based on their ideal market areas and available inventory. Dealers can choose leads from specific zip codes or any mile radius. Lead volumes can also be adjusted to fit sales resources and goals." (Chu Tr. at Ex. 31 (hereinafter H-001620-21))

AutomoBids.com: "The AutomoBids.com system is managed via a Dealer Dashboard, which is the interface for uploading inventory, creating advertisements, monitoring the electronic

negotiation and managing the transaction process. ...Using the Dashboard, dealers can quickly and easily upload their inventory from their Dealer Management System (DMS) and enter information that includes a 'Buy Now' price and a hidden floor price. ...The Dealer Dashboard also connects dealers to a variety of online advertising options, including search engine ad placements, which help reduce advertising costs per vehicle significantly." (Chu Tr. at Ex. 33 (hereinafter H-001624-30))

Gbase.com: "NEXT PAGE – DEALER DASHBOARD (dealers only) This is when you log into your Dealer account. Dashboard – This lists your store, email contact, anniversary date of joining Gbase plus your store statistics. It also contains your subscription information, billing history and billing information. MOST IMPORTANT – this is also where you'll find the site search report. It will provide you with an on-going Top-10 list of searches, Top-10 list of Keywords and Top-10 Makes and Models sought by and created by visitors on Gbase." (Chu Tr. at Ex. 34 (hereinafter H-001631-39))

DealerIgnition: "Dealer data is posted on the dealer dashboard. This is where dealers can administer their accounts, review claims status, benchmark their performance against "like" dealers. Company promotions are posted here along with the dealer's claims status and other system information." (Chu Tr. at Ex. 35 (hereinafter H-001640-44))

Republic Windows & Doors: "Dealer Dashboard™- Real-Time Sales, Shipping, and Accounting Data. Get the information you need when you need it – fast. With Dealer Dashboard you can see up-to-the-minute statistics that enable you to analyze your company's performance. Whether you prefer spreadsheets or charting numbers through graphs and bar charts, Dealer Dashboard lets you see your numbers the way you want. ...Knowledge is power – the more you use Dealer Dashboard, the more ways you will find to evaluate your business and use your information to be more efficient." (Chu Tr. at Ex. 36 (hereinafter H-001645))

AirGenerate: "AirGenerate, makers of AirTap™, announced they have launched a radio campaign with popular radio and TV star Glenn Beck. The campaign coincides with the launch of a state-of-the-art dealer dashboard and lead management system on AirGenerate's website. ...We had more than 150 dealers sign up within a week of the launch, and we continue to add new dealers everyday." (Chu Tr. at Ex. 40 (hereinafter H-001651-52))

> Autogate Pro: "The Dealer Dashboard provides a real time snapshot of the performance of your business by measuring: Incoming leads, Average response time in business hours, % of cars displayed with photos, % of customers contacted. ...The dealer dashboard will measure this for you and will be your benchmark for ongoing improvement." (Chu Tr. at Ex. 42 (hereinafter H-001656-57))

The Record further reflects that these third parties are not related to or affiliated with Applicant's dealerdashboard.com business. (*See, e.g.,* Dalton Disc. Dep. at 131:16-135:18; 141:1-142:23; 144:2-145:17; 146:20-147:14; 148:15-149:3; 149:7-150:4; 151:1-152:6; 152:22-153:21; 154:10-155:11; 156:4-157:9; 164:19-166:5; 169:9-170:13; 170:18-171:21; 176:25-178:8; 178:18-179:11; (Dalton Test. Tr. at 62:18-23; 64:14-19; 66:10-17; 67:14-23; 68:16-25; 69:22-70:7; 71:7-16; 73:17-74:1; 75:3-12; 76:9-18; 77:13-23; 79:9-19; 80:25-81:5.)

ARGUMENT

I. Honda Motor Co., Ltd. Has Standing

In an opposition based on Section 2(e), "standing to oppose is presumed when the mark sought to be registered is allegedly descriptive of the goods and the opposer is one who has a sufficient interest in using the descriptive term in his business." Thus, the proper test is whether the opposer establishes a real interest in the proceeding. *Tanner's Council of Am., Inc. v. Gary Industries Inc.*, 440 F.2d 1404, 1406-07 (CCPA 1971). Here, American Honda Motor Co. Inc. has a real interest in using the descriptive term dealer dashboard to identify the dashboard that resides on its interactive network for dealers. Offering access to a dealer dashboard allows American Honda dealers to easily obtain information critical to their performance. (Mangham Dep. at 16:6-10.) Using the descriptive term "dealer dashboard" to identify the dashboard also allows dealers to easily find the dashboard on the interactive network. (*Id.* at 17:11 to 18:11.) Moreover, Applicant sent a cease and desist letter to Honda and demanded that it cease using the term "dealer dashboard" to describe the dashboard on its internal network for dealers. (*See*

Answer ¶ 4; Dalton Disc. Dep. 203:6-14.) Thus, American Honda has a real interest in whether the Applicant can register DEALER DASHBOARD and thereby exclude others from using the descriptive term.

It is well-settled that a parent company may file an opposition on behalf of its wholly-owned subsidiary because the entities are in privity and any damage to the subsidiary will naturally damage the parent. *3 Oil Prods. Co. v. Rexall Drug & Chem. Co.*, 174 U.S.P.Q. 458 (CCPA 1972) (finding parent has standing to oppose mark on behalf of subsidiary); *see also Target Brands Inc. v. Hughes*, 85 U.S.P.Q.2d 1676, 1679 (TTAB 2007) (finding wholly-owned subsidiary has standing to oppose registration on behalf of parent); *British-American Tobacco Co. v. Philip Morris Inc.,* 55 U.S.P.Q.2d 1585, 1591 (TTAB 2000) (denying motion to dismiss finding that parent company may seek to cancel mark to protect wholly-owned subsidiaries commercial interests); *Hovnanian Enters., Inc. v. Covered Bridge Estates, Inc.*, 195 U.S.P.Q. 658, 660-61 (TTAB 1977) (finding parent has standing to oppose on subsidiary's behalf). Thus, Honda Motor Co., Ltd. has standing to oppose registration of DEALERDASHBOARD because such registration will harm American Honda Motor Co., Ltd., its wholly-owned subsidiary.

II. Registration Should Be Refused on the Grounds that the Term "Dealerdashboard" Is Descriptive of the Identified Services

Registration should be refused because the term "dealerdashboard" describes the services identified in Serial No. 78/339,571, namely "providing automotive dealerships managerial information concerning their Sales, Service, and Parts departments key financial indicators of how their dealership is performing via the Internet; and providing a web site featuring information about automobile dealerships, automobiles, automotive parts and accessories, at which users can link to the retail or wholesale web sites of others." In particular, the services are directed at dealers and the identified services describe a typical dashboard.

In order to determine whether a mark is merely descriptive, the Board examines whether it "immediately conveys knowledge concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used." *In re Bayer Aktiengesellschaft*, 82 U.S.P.Q.2d 1828, 1831 (Fed. Cir. 2007) (internal citations omitted). The mark need not describe every feature of the goods or services; instead, the Board will find that a mark is descriptive even where it only describes a "single, significant quality, feature, function, etc." *In re Venture Landing Assoc.,* 226 U.S.P.Q. 285, 286 (TTAB 1985) (internal citations omitted). Finally, the Board considers the mark "in relation to the particular goods for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use or intended use." *In re Bayer*, 82 U.S.P.Q.2d at 1831 (internal citations omitted). It is well-settled that "the question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods are services are will understand the mark to convey information about them." *In re Tower Tech Inc.*, 64 U.S.P.Q.2d 1314, 1316-17 (TTAB 2002).

The Board should find that the individual terms DEALER and DASHBOARD have descriptive significance when used in connection with Applicant's identified services, and that the combined phrase DEALERDASHBOARD is equally descriptive. Specifically, someone familiar with dashboards will understand DEALERDASHBOARD to mean the services described in Serial No. 78/339,571 as "providing automotive dealerships managerial information concerning their Sales, Service, and Parts departments key financial indicators of how their dealership is performing via the Internet."

Simply put, the proposed mark consists of terms that are used in their ordinary meaning to describe the identified services. The dictionary defines the term "dealer" as "one engaged in buying and selling." (H-001524) Applicant himself defines the term "dealer" as "someone who's in the marketing for automobiles, parts, service, sales." (Dalton Disc. Dep. at 42:24-23.) Under either definition, there is no dispute that the term DEALER is used in a descriptive manner in DEALERDASHBOARD.

Likewise, the Record contains several books and journal articles that discuss the meaning of the term DASHBOARD in the context that it is used in the applied-for mark. For example, the evidence shows that "dashboards" are designed around a set of measures or "key performance indicators." *Excel 2007 Dashboards & Reports for Dummies* at H-000028; *see also Information Dashboard Design* at H-000596 ("Key performance indicators and dashboards appear to be synonymous.") Thus, the term DEALERDASHBOARD immediately conveys information concerning the feature of the following identified services: "providing automotive dealerships managerial information concerning their Sales, Service, and Parts departments key financial indicators of how their dealership is performing via the Internet."

That Applicant presents the two terms as a combined term is irrelevant to the Board's analysis. When two or more descriptive terms are combined, whether the composite mark also has descriptive significance depends upon whether the combined term evokes a new and unique commercial impression. *In re Putnam Publ'g Co.*, 39 U.S.P.Q.2d 2021 (TTAB 1996). Here, they do not. Instead, each component retains its descriptive significance in relation to the services thereby creating a composite term that is also descriptive. *See, e.g., Tower Tech, Inc.*, 64 U.S.P.Q.2d at 1316-17 (holding SMARTTOWER merely descriptive of commercial and industrial cooling towers); *In re Sun Microsystems, Inc.*, 59 U.S.P.Q.2d 1084 (TTAB 2001)

(holding AGENTBEANS merely descriptive of computer programs for use in development and deployment of application programs); *In re Copytele, Inc.*, 31 U.S.P.Q2d 1540 (TTAB 1994)(holding SCREEN FAX PHONE merely descriptive of facsimile terminals employing electropheric displays).

Indeed, the evidence clearly shows that the term "dealer dashboard" is used descriptively by third parties to refer to a computerized interface that provides dealers with key performance indicators:

> Karastan: "Just like a car dashboard delivers critical information to the driver (i.e. speed, gear, lights, gas temperatures etc.) Each dealer Dashboard delivers all the current and important information at a glance (i.e. newest documents, announcements, calendars, links etc.) (H-001208-10)
>
> Denon: "The Dealer Dashboard is the easiest way for Denon dealers to get the latest information on Denon products, events, company information and more. As a Denon dealer, the Dashboard provides you with all kinds of product related items such as downloads, images, sell sheets and more." (H-001228)
>
> Marantz: "Welcome to the Marantz Dealer Dashboard! The Dealer Dashboard is the easiest way for Marantz dealers to get the latest information on Marantz products, events, company information and more. As a Marantz dealer, the Dashboard provides you with all kinds of product related items such as high resolution images, sell sheets and corporate identity images." (H-001230)
>
> Furnishweb: "On the Dealer Dashboard there are two new pieces of information; Collections Year-To-Date (YTD) and Top Sellers YTD. The Collections pie chart displays the collections a dealer has purchased most in the current year. The Top Sellers lists the top 10 products the dealer purchased this year. … There is also a new link on the Dealer Dashboard to Sales Tools. Sales Tools is deceptively simple but this link conceals some real power! Sales Tools is an interactive, sortable summary of sales information. Sales history can be summarized by product, collection, type, family, class, and finish … each column is sortable providing the ability to find the Best Sellers in each category." (H-001554-57)

Mayline Group: "Mayline Releases New "Dealer Dashboard". We have simplified dealer access to Mayline information. The Mayline Group has made it easier than ever for dealers to obtain proprietary information on a host of topics via a new link on the Mayline website. Called the "Dealer Dashboard," this intranet site allows dealers to obtain up-to-the hour information on Inventory Availability, Order Tracking, Promotions, Factory Closeouts and more. We have made it simple to access information 24-hours a day and also avoid possible delays versus calling into customer service." (H-001558-59)

ProfitFocus – Deloitte Motor Industry Services: "ProfitFocus Dealer Dashboard … Our Dealer Dashboard provides this functionality – when your monthly data is uploaded to our website reports are automatically generated for your viewing." (H-001562-63)

Fujitsugeneral: "Dealer Dashboard for Contractors. Your car has a dashboard that helps you know what's happening while you drive. Wouldn't you want to know more about your customers and what's happening with your business? Fujitsu has a Dealer Dashboard! A Fujitsu dealer has access to their customer's registration information. You can also see what comments they have about the work your people have done in their home and you can choose to have those comments listed on our dealer ranking site with your company's name. The better the work you do, the better you will look to prospective buyers!" (H-001553)

Little Giant Ladder Systems: Internet printout depicts a portal to a "Dealer Dashboard." (H-001564)

TheDealerDashboard.com: "Here is a great new tool to help you track your entire e-commerce department's initiatives. Monitor in real time all spending and performance. Are you putting your ad dollars where you are getting the best results? TheDealerDashboard.com will tell you." (H-001570)

Dashboard Dealership Enterprises: "Dashboard is the market leader in Web Management solutions for auto dealers, including analytics & exception based reporting. Dashboard rapidly develops high quality system products and related services to satisfy the current and emerging needs of our customers. Our mission is to exceed customer expectations for service, quality, speed of implementation, ease of use and…" (H-001575)

Glass-Net: "From here you'll be taken back to My Stock. The unqualified vehicle has been added to your stock. You can access

it using the "Unqualified" icon in the "Dealer Dashboard"…". (H-001585-95)

GM Canada Dealer Websites: "Key business reporting tools in our Dealer Dashboard help real-time for optimal results." (H-001596-1600)

Courtesy Car Manager C²Man Finance Dealer: "C²Man Finance Dealer Dasbhoard by Period. C²Man Finance Dealer Dasbhoard by Period. C²Man provides a dealer by month spreadsheet report for any selected period (month, quarter or year) with the current (partial) month as the default. All information is 100% up to date as a complete and correct online definition of all important statistics and measurable management criteria." (H-001601)

AutoLoanDaily: "The AutoLoanDaily Dealer Dashboard. AutoLoanDaily lets dealers control the leads they receive based on their ideal market areas and available inventory. Dealers can choose leads from specific zip codes or any mile radius. Lead volumes can also be adjusted to fit sales resources and goals." (H-001620-21)

AutomoBids.com: "The AutomoBids.com system is managed via a Dealer Dashboard, which is the interface for uploading inventory, creating advertisements, monitoring the electronic negotiation and managing the transaction process. …Using the Dashboard, dealers can quickly and easily upload their inventory from their Dealer Management System (DMS) and enter information that includes a 'Buy Now' price and a hidden floor price. …The Dealer Dashboard also connects dealers to a variety of online advertising options, including search engine ad placements, which help reduce advertising costs per vehicle significantly." (H-001624-30)

Gbase.com: "NEXT PAGE – DEALER DASHBOARD (dealers only) This is when you log into your Dealer account. Dashboard – This lists your store, email contact, anniversary date of joining Gbase plus your store statistics. It also contains your subscription information, billing history and billing information. MOST IMPORTANT – this is also where you'll find the site search report. It will provide you with an on-going Top-10 list of searches, Top-10 list of Keywords and Top-10 Makes and Models sought by and created by visitors on Gbase." (H-001631-39)

DealerIgnition: "Dealer data is posted on the dealer dashboard. This is where dealers can administer their accounts, review claims status, benchmark their performance against "like" dealers.

> Company promotions are posted here along with the dealer's claims status and other system information." (H-001640-44)
>
> Republic Windows & Doors: "Dealer Dashboard™- Real-Time Sales, Shipping, and Accounting Data. Get the information you need when you need it – fast. With Dealer Dashboard you can see up-to-the-minute statistics that enable you to analyze your company's performance. Whether you prefer spreadsheets or charting numbers through graphs and bar charts, Dealer Dashboard lets you see your numbers the way you want. ...Knowledge is power – the more you use Dealer Dashboard, the more ways you will find to evaluate your business and use your information to be more efficient." (H-001645)
>
> Autogate Pro: "The Dealer Dashboard provides a real time snapshot of the performance of your business by measuring: incoming leads, Average response time in business hours, % of cars displayed with photos, % of customers contacted. ...The dealer dashboard will measure this for you and will be your benchmark for ongoing improvement." (H-001656-57)

These third parties use the term "dealer dashboard" to describe services that are identical to, or substantially similar to, those identified in Serial No. 78/339,571, namely "providing automotive dealerships managerial information concerning their Sales, Service, and Parts departments key financial indicators of how their dealership is performing via the Internet." It is worth noting that since Opposer investigated third party use of the term dealer dashboard during the testimony period (August 2008), twenty-eight additional third party uses of the term were found during the rebuttal period one year later. (*See* Chu Ex. 4, 6, 8, 10, 11, 12, 13, 15, 16, 17, 19, 22, 23, 25, 27, 29, 31, 33, 34, 35, 36, 37, 38, 39, 40, 43.) Applicant simply does not have the right to exclude others from using this term to describe their similar services especially given the ever-growing prevalence in the marketplace of third party use of the term. For these reasons, the Board should sustain the opposition and refuse registration.

III. Registration Should Be Refused on the Grounds that The Term Dealerdashboard is Generic for the Identified Services

The Board should find the term dealerdashboard is generic and therefore not entitled to registration. Generic terms are those that the relevant purchasing public understands primarily as the common or class name for particular goods or services. *In re Dial-A-Mattress Operating Corp.*, 57 U.S.P.Q.2d 1807, 1810 (Fed. Cir. 2001). Because generic terms are incapable of serving as a source identifier, they cannot be registered because if they were, they "would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are." *In re Merrill Lynch, Pierce, Fenner, and Smith Inc.*, 4 U.S.P.Q.2d 1141, 1142 (Fed. Cir. 1987).

The Board analyzes the mark's "primary significance to the relevant public" by applying the following two-part "*Ginn* test:" "[f]irst, what is the category or class of the goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?" *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 228 U.S.P.Q. 528, 530 (Fed. Cir. 1986). The *Ginn* test is clearly met here.

A. Car Dealership Managers and the General Public Are the Relevant Public for Applicant's Services

Applicant's description of services makes clear that the services are directed to car dealership managers and the public at large:

> providing ***automotive dealerships*** managerial information concerning ***their*** Sales, Service, and Parts departments key financial indicators of how their dealership is performing via the Internet; and providing ***a web site*** featuring information about automobile dealerships, automobiles, automotive parts and accessories, ***at which users*** can link to the retail or wholesale web sites of others.

Given this description of goods, the Board should find that the services will be provided to car dealers and members of the general public who are interested in information about dealerships, automobiles, parts and accessories. Thus, the "relevant public" for the purposes of the *Ginn* test should be car dealership managers and the general public.

B. The Category of Services Are Computer-Based Dashboards

With respect to the first part of the *Ginn* test, according to the description of goods, the category of services provided under the DEALERDASHBOARD designation is "information concerning [car dealerships] Sales, Service, and Parts departments key financial indicators of how their dealership is performing." (*See also* Dalton Disc. Dep. Tr. 20:8-24 (describing how participating dealers can "go online [and] view their inventory")). Consumers are also able to access information regarding "research in the automotive industry." (Dalton Disc. Dep. Tr. 19:10-24.) The services offered to both dealers and consumers are provided via the Internet. Thus, the category of services provided consists of a computer-based interface that provides key financial indicators to dealers and research information about automobiles to consumers.

C. The Relevant Public Understands DEALERDASHBOARD To Refer to the Genus of the Services

The Record demonstrates that the relevant public understands the term DEALERDASHBOARD to refer to the category of services identified in the subject application. As noted above, the relevant public consists of car dealership managers and the public at-large. At a minimum, the evidence shows that the relevant public would ascribe the ordinary meaning to the term "dealerdashboard" and understand that the phrase is generic for a computer-based visual interface that provides managers with key performance indicators regarding the dealership.

Applicant acknowledges that the "dealer dashboard" term has changed in meaning since he first began to use it:

> The applicant wishes to note that opposers claim that dashboard is generic in nature: Was not the case when applicant selected the term DealerDashboard and further states that DealerDashboard may have been a contributing factor for, not as a result of, any alleged evolution in the term dashboard.

(Applicant's Interrog. Resp. No. 8.) At deposition, Applicant further stated that the "computer industry has slang" when it refers to a "dashboard," and the term has evolved so that it is now prevalent to refer to a graphical user interface as a "dashboard." (Dalton Disc. Dep. at 183:7 to 185:9.)

Evidence of the relevant public's understanding of a term may be obtained from any competent source including dictionary definitions, trade journals, newspapers and other publications. *See Dial-A-Mattress*, 57 U.S.P.Q.2d at 1810. The dictionary excerpts in the Record show that the term "dealer" is used in its ordinary sense. (H-001524; H-001527) Likewise, the books and publications entered into the Record demonstrate that the term "dashboard" is also used in its ordinary sense in the applied-for mark. (H-000001-3046; H000585-907; H000347-584; H-000908-1133; H001481-1495; H-0001496-1510; H-001511-1513; H001514-1517.) When these two terms are combined to form DEALERDASHBOARD, the term as a whole is also generic for the category of services. In other words, the "entire formulation does not add any meaning to the otherwise generic mark." *In re 1800Mattress.com*, Serial No. 78/976,682, slip. op. at 5-6 (Fed. Cir. Nov. 6, 2009);[4] *see also In re Tires, Tires, Tires*, Serial No. 77/091,459 (TTAB Nov. 4, 2009); *In re Active Ankle Sys., Inc.*, 83 U.S.P.Q.2d 1532, 1537 (TTAB 2007). There simply is nothing in the generic composite DEALERDASHBOARD that changes the meaning of the individual terms in any manner.

---

[4] All slip opinions are attached hereto as Exhibit A.

The Record also includes numerous Internet printouts of examples of the term "dealer dashboard" used as the common, generic name for services that are similar to, if not identical, to those offered by Applicant:

> Karastan: "Just like a car dashboard delivers critical information to the driver (i.e. speed, gear, lights, gas temperatures etc.) Each dealer Dashboard delivers all the current and important information at a glance (i.e. newest documents, announcements, calendars, links etc.) (H-001208-210)
>
> Denon: "The Dealer Dashboard is the easiest way for Denon dealers to get the latest information on Denon products, events, company information and more. As a Denon dealer, the Dashboard provides you with all kinds of product related items such as downloads, images, sell sheets and more." (H-001228)
>
> Marantz: "Welcome to the Marantz Dealer Dashboard! The Dealer Dashboard is the easiest way for Marantz dealers to get the latest information on Marantz products, events, company information and more. As a Marantz dealer, the Dashboard provides you with all kinds of product related items such as high resolution images, sell sheets and corporate identity images." (H-001230)
>
> Furnishweb: "On the Dealer Dashboard there are two new pieces of information; Collections Year-To-Date (YTD) and Top Sellers YTD. The Collections pie chart displays the collections a dealer has purchased most in the current year. The Top Sellers lists the top 10 products the dealer purchased this year. ... There is also a new link on the Dealer Dashboard to Sales Tools. Sales Tools is deceptively simple but this link conceals some real power! Sales Tools is an interactive, sortable summary of sales information. Sales history can be summarized by product, collection, type, family, class, and finish ... each column is sortable providing the ability to find the Best Sellers in each category." (H-001554-57)
>
> Mayline Group: "Mayline Releases New Dealer Dashboard. We have simplified dealer access to Mayline information. The Mayline Group has made it easier than ever for dealers to obtain proprietary information on a host of topics via a new link on the Mayline website. Called the "Dealer Dashboard," this intranet site allows dealers to obtain up-to-the hour information on Inventory Availability, Order Tracking, Promotions, Factory Closeouts and more. We have made it simple to access information 24-hours a

day and also avoid possible delays versus calling into customer service." (H-0001558-59)

Fujitsugeneral: "Dealer Dashboard for Contractors. Your car has a dashboard that helps you know what's happening while you drive. Wouldn't you want to know more about your customers and what's happening with your business? Fujitsu has a Dealer Dashboard! A Fujitsu dealer has access to their customer's registration information. You can also see what comments they have about the work your people have done in their home and you can choose to have those comments listed on our dealer ranking site with your company's name. The better the work you do, the better you will look to prospective buyers!" (H-001553)

TheDealerDashboard.com: "Here is a great new tool to help you track your entire e-commerce department's initiatives. Monitor in real time all spending and performance. Are you putting your ad dollars where you are getting the best results? TheDealerDashboard.com will tell you." (H-001570)

Dashboard Dealership Enterprises: "Dashboard is the market leader in Web Management solutions for auto dealers, including analytics & exception based reporting. Dashboard rapidly develops high quality system products and related services to satisfy the current and emerging needs of our customers. Our mission is to exceed customer expectations for service, quality, speed of implementation, ease of use and..." (H-001575)

GM Canada Dealer Websites: "Key business reporting tools in our Dealer Dashboard help real-time for optimal results." (H-001596-600)

Courtesy Car Manager C²Man Finance Dealer: C²Man provides a dealer by month spreadsheet report for any selected period (month, quarter or year) with the current (partial) month as the default. All information is 100% up to date as a complete and correct online definition of all important statistics and measurable management criteria." (H-001601-02)

AutomoBids.com: "The AutomoBids.com system is managed via a Dealer Dashboard, which is the interface for uploading inventory, creating advertisements, monitoring the electronic negotiation and managing the transaction process. ...Using the Dashboard, dealers can quickly and easily upload their inventory from their Dealer Management System (DMS) and enter information that includes a 'Buy Now' price and a hidden floor price. ...The Dealer Dashboard also connects dealers to a variety

> of online advertising options, including search engine ad placements, which help reduce advertising costs per vehicle significantly." (H-001624-30)
>
> DealerIgnition: "Dealer data is posted on the dealer dashboard. This is where dealers can administer their accounts, review claims status, benchmark their performance against "like" dealers. Company promotions are posted here along with the dealer's claims status and other system information." (H-001640-44)
>
> Republic Windows & Doors: "Dealer Dashboard™- Real-Time Sales, Shipping, and Accounting Data. Get the information you need when you need it – fast. With Dealer Dashboard you can see up-to-the-minute statistics that enable you to analyze your company's performance. Whether you prefer spreadsheets or charting numbers through graphs and bar charts, Dealer Dashboard lets you see your numbers the way you want. ...Knowledge is power – the more you use Dealer Dashboard, the more ways you will find to evaluate your business and use your information to be more efficient." (H-001645)
>
> Autogate Pro: "The Dealer Dashboard provides a real time snapshot of the performance of your business by measuring: Incoming leads, Average response time in business hours, % of cars displayed with photos, % of customers contacted. ...The dealer dashboard will measure this for you and will be your benchmark for ongoing improvement." (H-001656-57)

Thus, the proposed mark is a common designation understood by the relevant public to identify a computer-based interface that provides dealers with key performance indicators. The designation DEALERDASHBOARD is generic, which does not, and could not, function as a service mark to distinguish Applicant's services from those of other entities who provide dashboards to dealers. Lacking the ability to serve as a source identifier, Applicant should not be granted exclusive appropriation by registration, but the term should instead remain available for others to use in connection with their dashboard services. *See In re Lens.com, Inc.*, 83 U.S.P.Q.2d 1444, 1445 (TTAB 2007) (denying registration of LENS for "retail store services featuring contact eyewear products rendered via a global computer network"); *In Re Rosemount,*

Inc., 86 U.S.P.Q.2d 1436 (TTAB 2008) (denying registration of REDUCER and DOUBLE REDUCER for "flow meters used for measuring flow through pipes; vortex flow meters").

IV. Registration Should Be Denied Because Applicant Committed Fraud On The PTO, Or In The Alternative, Registration Should be Denied Because Applicant Does Not Satisfy The Lanham Act's Use In Commerce Requirement

Applicant did not follow the tenets of The Lanahan Act when he filed his dealership of use. According to the Federal Circuit, "a trademark is obtained fraudulently under the Lanham Act only if the applicant or registrant knowingly makes a false, material representation with the intent to deceive the PTO." *In re Bose*, 91 U.S.P.Q.2d 1938, 1941 (Fed. Cir. 2009). Given that subjective intent may be difficult to prove, an opposer may show intent to deceive through circumstantial evidence and inferences. *Id.* This standard is met here.

In response to an office action, Applicant amended his description of goods and changed his filing basis from intent-to-use to use-based. (Dalton Disc. Dep. Ex. 11.) In doing so, Applicant signed a declaration stating that "the mark was in use in commerce on or in connection with the goods or services listed in the application as of the application filing date." (*Id.*) The Record shows that at the time Applicant signed this declaration, he knew that he was not using the mark on all of the services identified in the application. In particular, Applicant admitted that while he has offered to provide "dealerships managerial information concerning their sales, service and parts departments key financial indicators of how their dealership is performing," he has not rendered these services in commerce Indeed, Applicant has never had a single customer. (*Id.*)

As the testimony reflects, Applicant was fully aware at the time that he signed the declaration that he had no customers and was therefore not rendering the services in commerce (Dalton Disc. Dep. 84:25 to 86:17; 192:3-9; Dalton Test. Dep. at 50:19 to 51:21.). The Record

further reflects that he arbitrarily changed the intent-to-use basis to use-based even though he knew that he was not using the mark in connection with all the identified services. Stating that he was rendering the services in commerce was a false representation of material fact. Moreover, it is reasonable for the Board to infer from the Record that this false representation was made with the intent to deceive. For these reasons, registration should be denied on the grounds of fraud.

In the alternative, registration should be denied because the Applicant cannot satisfy the requirement for "use in commerce" under 15 U.S.C. § 1127. In particular, as reflected in his testimony, Applicant admits that he has not has not rendered the identified services in commerce. (Dalton Disc. Dep. 84:25 to 86:17; 192:3-9; Dalton Test. Dep. at 50:19 to 51:21.). While Applicant may have advertised his services on his website, he admits that he never actually rendered these services. Accordingly, the "use in commerce" requirement is not met and registration should, therefore, be denied. *See Greyhound Corp. v. Armour Life Ins. Co.*, 214 U.S.P.Q. 473, 474 (TTAB 1982) ("[A]dvertising of a service, without performance of a service, will not support registration."); *Buti v. Perosa, S.R.L.,* 139 F.3d 98 (2d Cir. 1998) (holding that mere advertising or promotion of mark in United States is insufficient to constitute "use" of the mark "in commerce," within meaning of Lanham Act, where that advertising or promotion is unaccompanied by any actual rendering in United States or in commerce which may lawfully be regulated by Congress, of services in connection with which the mark is employed).

OPPOSER'S OBJECTIONS TO APPLICANT'S EVIDENCE

Opposer hereby objects, pursuant to 37 C.F.R. 2.123(k), to Applicant's testimony and exhibits sought to be relied upon by Applicant as stated in his Notice of Reliance filed on July 31, 2009. The grounds for Opposer's objections are set forth below.

I. Applicant's Evidence Improperly Submitted During His Testimony Deposition and After the Close of Discovery Must Be Excluded

Applicant should not be allowed to introduce Ex. 43, 46, 47, 49, 51-54, 56, 58, 59, 61, 64-69, and 89-92 offered into evidence during Applicant's testimony, because they were not produced during the discovery period. Furthermore, Ex. BB-LL of Applicant's Notice of Reliance should also be excluded because they were not produced during the discovery period. It is well-established that the Board does not consider evidence that was not made available to the opposing party during the discovery period. *Shoe Factory Supplies Co. v. Thermal Eng'g Co.*, 207 U.S.P.Q. 517, 519 n. 1 (TTAB 1980) (excluding evidence offered by applicant during trial testimony of its witness that was not previously made available to opposer); *Nat'l Aeronautics & Space Admin. v. Bully Hill Vineyards, Inc.*, 3 U.S.P.Q.2d 1671, 1672 n.3 (TTAB 1987) (excluding party's exhibits from evidence where the exhibits were requested by adverse party and not produced during discovery). Here, Applicant failed to produce Ex. 43, 46, 47, 49, 51-54, 56, 58, 59, 61, 64-69, 89-92, and BB-LL during the discovery phase although they were clearly responsive to specific requests.

In particular, Opposer's Requests for Production No. 27 called for "[a]ll exhibits that Applicant will introduce during any witness's deposition or testimony" and No. 28 sought "[a]ll exhibits that Applicant will rely on, refer to, or introduce during the testimony period in this

proceeding."[5] In his response, Applicant directed Opposer to "Exhibits (A) – (T) and at http://DealerDashboard.com." Ex. 43, 46, 47, 49, 51-54, 56, 58, 59, 61, 64-69, 89-92, and BB-LL were not included in these documents. Instead, Applicant impermissibly presented them to Opposer for the first time during his testimony deposition. The Board should, therefore, strike these exhibits from the Record.

As the Board has noted, permitting a party to introduce evidence during the trial period after failing to do so in response to an adverse party's discovery request "would defeat the purpose of the discovery process." *Super Valu Stores Inc. v. Exxon Corp.*, 11 U.S.P.Q.2d 1539, 1543 (TTAB 1989); *cf. H.D. Lee Co. v. Maidenform Inc.*, 87 U.S.P.Q.2d 1715 (TTAB 2008) (overruling applicant's objections to evidence introduced by opposer during trial period because opposer never provided discovery responses for applicant to rely upon in the first place and applicant failed to move to compel such responses). Here, Opposer was denied the opportunity to examine and test the evidence during the discovery period as contemplated by the Federal Rules of Civil Procedure and such exhibits should not now be made of the Record. *See Visual Info. Inst., Inc. v. Vicon Indus. Inc.*, 209 U.S.P.Q. 179, 182 (TTAB 1980) ("To condone a practice such as this would serve only to thwart the purpose and intent of the discovery practice outlined in the Federal Rules of Civil Procedure designed to provide an expeditious procedure for the acquisition of information necessary to prepare a party for trial."). Likewise, Opposer was unable to properly prepare for cross-examination because the documents were not provided prior to the time they were introduced during the Applicant's testimony.

[5] In addition, Ex. 43, 46, 47, 49, 51-54, 56, 58, 59, 61, 64-69, 89-92, and BB-LL were each responsive to at least one of Opposer's Requests for Documents: Nos. 1-3, 5-10, 15, 18, and 26-28.

As Applicant failed to produce these documents during the discovery phase, failed to later supplement his production, the Board should strike Ex. 43, 46, 47, 49, 51-54, 56, 58, 59, 61, 64-69, 89-92, and BB-LL from the Record.

II. The Board Should Afford No Weight to Third Party Registrations

The Board should disregard the third party registrations submitted by Applicant. (*See* Applicant's Notice of Reliance Ex. BB.) While uniformity in the registration of marks is aspirational, the Board assesses "each mark on the record of public perception submitted with the application" and therefore places little persuasive value on third party registrations. *In re Nett Designs Inc.*, 57 U.S.P.Q.2d 1564, 1566 (Fed. Cir. 2001); *see also In re Rodale Inc.*, 80 U.S.P.Q.2d 1696, 1700 (TTAB 2006) ("Although consistency in examination is a goal of the Office, the decisions of previous Trademark Examining Attorneys are not binding on us, and we must decide each case based on the evidence presented in the record before us"); *In re Finisair Corp.*, 78 U.S.P.Q.2d 1618, 1621 (TTAB 2006) ("While uniform treatment is a goal, our task is to determine based on the record before us, whether applicant's mark is merely descriptive"); *In re Wilson*, 57 U.S.P.Q.2d 1863 (TTAB 2001) (administrative law doctrine of "reasoned decisionmaking" does not require consistent treatment of applications to register marks; each application for registration must be considered on its own record and merits").

Likewise, the third party registration histories are also "of very little probative value." TBMP § 704.03(b)(1)(B) (citing *Allied Mills, Inc. v. Kal Kan Foods, Inc.*, 203 U.S.P.Q. 390, 397 n.11 (TTAB 1979) (specimens from third-party registration files are not evidence of the fact that the specimens filed in the underlying applications or even with section 8 affidavits are in use today or that such specimens have ever been used to the extent that they have made an impression on the public)). Because third party registrations offer little persuasive value, the

Board should place no weight on these registrations in its assessment of the descriptiveness of the mark at issue.

III. Applicant's Testimony and Email Exhibits Are Hearsay

During his testimony, Applicant read into the Record purported emails between himself and third parties regarding their use of the dealer dashboard term. (Dalton Test. Dep. at 35:18 to 45:6). Applicant also attempted to introduce these purported emails into the Record. (*See* Dalton Test. Dep. Exs. 54, 56, 58, 59, 61, 64-66). Both the exhibits and testimony given were the subject of timely objections by Opposer as hearsay under Rule 802 the Federal Rules of Evidence. (Dalton Test. Dep. at 49:12-17). Applicant's testimony, as well as the purported emails themselves, are impermissible hearsay because they are out-of-court statements made by third-parties introduced for the truth of the matter stated. *See Gravel Cologne, Inc. v. Lawrence Palmer, Inc.*, 176 U.S.P.Q. 123 (C.C.P.A. 1972). Accordingly, Applicant's testimony and Exhibits 54, 56, 58, 59, 61, and 64-66 should be struck from the Record.

IV. Applicant's Internet Printouts Are Not Printed Publications

Applicant mistakenly asserts that Internet printouts are "printed publications" and wrongly seeks to introduce these documents into the Record pursuant to 37 C.F.R. § 2.122(e). (*See* Applicant's Notice of Reliance, Ex. GG-KK.) The TBMP explicitly provides that Internet printouts that are not self-authenticating do not qualify as printed publications:

> The element of self-authentication cannot be presumed to be capable of being satisfied by information obtained and printed out from the Internet. Internet postings are transitory in nature as they may be modified or deleted at any time without notice and thus are not "subject to the safeguard that the party against whom the evidence is offered is readily able to corroborate or refute the authenticity of what is proffered."

TBMP § 704.08 (internal citations omitted)). Furthermore, the Board has ruled time and again that web pages do not satisfy the requirements for a "printed publication" under 37 C.F.R. §

2.122(e) and are therefore not admissible by way of a Notice of Reliance. *See Plyboo Am. Inc. v. Smith & Fong Co.*, 51 U.S.P.Q.2d 1633, 1634 n.3 (TTAB 1999) (nothing that printout website page is not proper subject matter for a notice of reliance); *see also Paris Glove of Can. Ltd. v. SBC/Sporto Corp.*, 84 U.S.P.Q.2d 1856, 1858-59 (TTAB 2007); *Raccioppi v. Apogee Inc.*, 47 U.S.P.Q.2d 1368 (TTAB 1998). Moreover, Applicant failed to authenticate any of the website printouts he seeks to offer as evidence during his testimony period, and Opposer made several objections during Applicant's testimony regarding Applicant's failure to lay a foundation for evidence. (Dalton Test. Dep. at 25:11-12; 29:18-20; 30:1-3; 30:9-16.); Fed. R. Evid. 602. Accordingly, the Board should strike from the Record Applicant's Notice of Reliance, Exhibits GG through KK.

V. Printouts from the "Way Back Machine" Are Not Official Records

A printout from the Way Back Machine does not qualify as an official record pursuant to 37 C.F.R. § 2.122(e) nor is it a self-authenticating document. Indeed, the Board has expressly rejected printouts from the Wayback Machine as "generally unacceptabl[e]" because the "database itself is not self-authenticating and there is no reason to treat its existence as authenticating the pages in its historical record." *See Hiraga v. Arena*, 90 U.S.P.Q.2d 1102, 1106 (TTAB 2009); *Paris Glove of Can., Ltd. v. SBC/Sporto Corp.*, 84 U.S.P.Q.2d 1856, 1858–59 (TTAB 2007); *see also Chamilia LLC v. Pandora Jewelry LLC*, 85 U.S.P.Q.2d 1169 (S.D.N.Y. 2007); *Novak v. Tucows Inc.*, No. 06-CV-1909, 2007 U.S. Dist. LEXIS 21269 (E.D.N.Y. Mar. 26, 2007) (order granting motion to bar evidence), aff'd, No. 07-2211-cv, 2009 U.S. App. LEXIS 9786 (2d Cir. May 6, 2009). Therefore, Applicant's evidence of printouts from the Wayback Machine must be excluded from the Record.

CONCLUSION

For the reasons stated above, Applicant is not entitled to exclude others from using the descriptive and/or generic term "dealer dashboard". Registration should therefore be denied with prejudice.

Dated: November 13, 2009

WILMER CUTLER PICKERING
HALE AND DORR LLP

By: _____
Dyan Finguerra-DuCharme
399 Park Avenue
New York, NY 10022

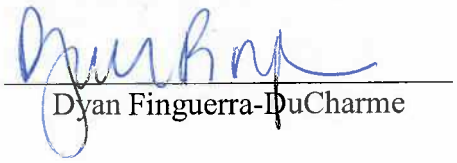
Mark G. Matuschak
60 State Street
Boston, MA 02109

Attorneys for Opposer Honda Motor Co., Ltd.

Certificate of Service

I hereby certify that a true and complete copy of the foregoing Honda Motor Co., Ltd.'s Trial Brief has been served by First Class Mail to:

Michael Dalton
Box 18137
670 Northland Blvd.
Cincinnati, OH 45218-0137



Dyan Finguerra-DuCharme

EXHIBIT A

Dial-A-Mattress Operating Corp.,
57 U.S.P.Q.2d 1807, (Fed. Cir. 2001)

United States Court of Appeals for the Federal Circuit

2009-1188
(Serial No. 78/976,682)

IN RE 1800MATTRESS.COM IP, LLC
(substituted for Dial-A-Mattress Operating Corporation)

Francis J. Duffin, Wiggin and Dana LLP, of New Haven, Connecticut, for appellant.

Raymond T. Chen, Solicitor, Office of the Solicitor, United States Patent and Trademark Office, of Alexandria, Virginia, for the Director of the United States Patent and Trademark Office. With him on the brief were Christina J. Hieber and Janet A. Gongola, Associate Solicitors.

Appealed from: United States Patent and Trademark Office
Trademark Trial and Appeal Board

United States Court of Appeals for the Federal Circuit

2009-1188
(Serial No. 78/976,682)

IN RE 1800MATTRESS.COM IP, LLC (substituted for Dial-A-Mattress Operating Corporation)

Appeal from the United States Patent and Trademark Office, Trademark Trial and Appeal Board.

DECIDED: November 6, 2009

Before LOURIE, FRIEDMAN, and PROST, Circuit Judges.

LOURIE, Circuit Judge.

1800Mattress.com IP, LLC ("1800Mattress.com"), substituted as appellant for Dial-A-Mattress Operating Corp. ("Dial-A-Mattress"), appeals from the final decision of the United States Patent and Trademark Office Trademark Trial and Appeal Board (the "Board") refusing registration of the mark "MATTRESS.COM." In re Dial-A-Mattress Operating Corp., Serial No. 78976682, 2008 TTAB Lexis 437 (T.T.A.B. Nov. 13, 2008). Because the Board's decision finding "MATTRESS.COM" generic in relation to the recited services was supported by substantial evidence, we affirm.

BACKGROUND

On December 9, 2005, Dial-A-Mattress filed U.S. Trademark Application Serial No. 78/976,682, seeking to register the mark MATTRESS.COM (in standard character format) for services identified as "online retail store services in the field of mattresses,

beds, and bedding." On February 14, 2008, the trademark examiner finally refused registration of the mark on the basis that it is generic under Section 23(c) of the Trademark Act, 15 U.S.C. § 1091(c).

Dial-A-Mattress appealed to the Board, which affirmed the examiner's refusal to register the mark. The Board reasoned that the genus of services offered by Dial-A-Mattress was online retail store services in the field of mattresses, beds, and bedding. In re Dial-A-Mattress, 2008 TTAB Lexis 437, at *3–4. The Board then found that, given the genus of services offered, the term MATTRESS.COM would be understood by the relevant public primarily to refer to that genus. According to the Board, Dial-A-Mattress's services focused on mattresses. Thus, because "mattress" identified such a key aspect of Dial-A-Mattress's services, the Board found the term generic for Dial-A-Mattress's services. Id. at *4–6.

The Board then reasoned that the addition of the top level domain extension ".com" did not affect the term's genericness. According to the Board, several third party websites that were also online retail store services featuring mattresses and/or bedding had internet addresses ending in "mattress.com" or containing "mattress" and ".com." Thus, the Board found that consumers would see MATTRESS.COM and would immediately recognize it as a term that denotes a commercial website rendering retail services featuring mattresses. Id. at *8–10. In other words, the addition of ".com" did not affect registrability in this case because it did not create any additional meaning. Id. at *10–12. The Board rejected Dial-A-Mattress's argument that "com" somehow evoked the words "comfort" or "comfortable" and rejected the idea that the mark served as a

mnemonic. Id. at *13–16. Thus, the Board found MATTRESS.COM generic and affirmed the refusal to register Dial-A-Mattress's mark.

Dial-A-Mattress timely appealed to this court. We have jurisdiction pursuant to 28 U.S.C. § 1295(a)(4)(B).

DISCUSSION

We review the Board's legal conclusions de novo and the Board's factual findings for substantial evidence. In re Pacer Tech., 338 F.3d 1348, 1349 (Fed. Cir. 2003). "Substantial evidence is 'more than a mere scintilla' and 'such relevant evidence as a reasonable mind would accept as adequate' to support a conclusion." Id. (quoting Consol. Edison v. NLRB, 305 U.S. 197, 229 (1938)). Whether an asserted mark is generic is a factual determination made by the Board. In re Pennington Seed, Inc., 466 F.3d 1053, 1056 (Fed. Cir. 2006).

Dial-A-Mattress* argues that the Board's conclusion of genericness was not supported by substantial evidence. According to Dial-A-Mattress, the only generic term that is supported by the evidence for online retail store services in the field of mattresses, beds, and bedding is "online mattress stores." Thus, Dial-A-Mattress argues, the U.S. Patent and Trademark Office ("PTO") did not show, by clear evidence, that the relevant public refers to the class of services by the mark MATTRESS.COM. Dial-A-Mattress further asserts that the Board ignored record evidence that businesses outside the genus of online retail store services, such as stores that only sell mattresses

* While the case was on appeal, we granted a motion to substitute 1800Mattress.com for Dial-A-Mattress as appellant. However, because the briefs were filed with Dial-A-Mattress as the named appellant, we refer to the appellant as Dial-A-Mattress throughout this discussion.

in person, use "mattress.com" as a component of their domain names. According to Dial-A-Mattress, the Board also erroneously looked to the component parts of the mark MATTRESS.COM to find it generic, rather than looking at the mark as a whole. Finally, Dial-A-Mattress argues that the Board should not have disregarded the nature of the mark MATTRESS.COM as a mnemonic and as being capable of evoking the quality of comfort in mattresses.

The PTO responds that substantial evidence establishes that the relevant public would understand MATTRESS.COM to refer to a commercial website for selling mattresses, the key focus of the services. According to the PTO, the Board's conclusion of genericness was supported by clear and substantial evidence, including dictionary definitions, use by Dial-A-Mattress, and use of the identical term "mattress.com" to denote the websites of competitors offering the same services as Dial-A-Mattress. The PTO argues that the term "mattress" is indisputably generic, and, absent exceptional circumstances, the addition of the top level domain ".com," identifying a commercial website, to an otherwise unregistrable term will not transform the term into a registrable mark. Further, according to the PTO, there are no exceptional circumstances, as the separate terms "mattress" and ".com" in combination have a meaning identical to the common meaning of the separate components. The PTO adds that, even if "online mattress store" is a generic term, that does not prevent MATTRESS.COM from also being a generic term for the same services. The PTO also argues that, even if the term "mattress.com" might have significance for a different set of services, such as a brick and mortar store, that is irrelevant to whether the term is perceived by the public as naming the genus of services for which registration is sought,

i.e., online mattress stores. Additionally, according to the PTO, such brick and mortar stores all have an online component to their mattress stores. Finally, the PTO asserts that Dial-A-Mattress presented no evidence that MATTRESS.COM is a double entendre evoking a quality of comfort, and it is not a mnemonic.

We agree with the PTO that substantial evidence supported the Board's conclusion that the mark MATTRESS.COM is generic. We have held that "[t]he critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question." H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc., 782 F.2d 987, 989–90 (Fed. Cir. 1986). Thus, we have laid out "a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?" Id. at 990. In this case, the parties agree that the genus of services is "online retail store services in the field of mattresses, beds, and bedding." Accordingly, the mark is generic if the relevant public understands MATTRESS.COM to refer to such online retailers.

"An inquiry into the public's understanding of a mark requires consideration of the mark as a whole. Even if each of the constituent words in a combination mark is generic, the combination is not generic unless the entire formulation does not add any meaning to the otherwise generic mark." In re Steelbuilding.com, 415 F.3d 1293, 1297 (Fed. Cir. 2005); see In re Am. Fertility Soc'y, 188 F.3d 1341, 1347 (Fed. Cir. 1999) ("[I]f the compound word would plainly have no different meaning from its constituent words, and dictionaries, or other evidentiary sources, establish the meaning of those words to

be generic, then the compound word too has been proved generic. No additional proof of the genericness of the compound word is required."). In this case, the Board considered each of the constituent words, "mattress" and ".com," and determined that they were both generic. The Board found "mattress" to refer to the same mattresses referenced by the genus. It found ".com" to refer to an abbreviation designating a commercial organization in internet addresses. Neither party disputes the genericness of either component.

The Board then considered the mark as a whole and determined that the combination added no new meaning, relying on the prevalence of the term "mattress.com" in the website addresses of several online mattress retailers that provide the same services as Dial-A-Mattress. Such reliance is permissible to illuminate what services the relevant public would understand a website operating under the term "mattress.com" to provide. In re Reed Elsevier Props. Inc., 482 F.3d 1376, 1380 (Fed. Cir. 2007) (holding that the Board properly considered websites containing "lawyer.com" or "lawyers.com" in their domain names to determine what the relevant public would understand LAWYERS.COM to mean); see also In re Hotels.com, 573 F.3d 1300, 1306–06 (Fed. Cir. 2009) (same for the mark HOTELS.COM). Because websites operate under the term "mattress.com" to provide mattresses, and they provide them online, the Board properly concluded that the relevant public understands the mark MATTRESS.COM to be no more than the sum of its constituent parts, viz., an online provider of mattresses. Indeed, the Board's reasoning tracked our later reasoning in In re Hotels.com. In that case, we addressed the Board's rejection of the mark HOTELS.COM for hotel reservation services. In re Hotels.com, 573 F.3d at 1301.

There, as here, the Board had addressed the genericness of each of the constituent words and then had used the prevalence of "hotel.com" or "hotels.com" in hotel reservation service websites to find the combination generic. We affirmed the Board's giving "controlling weight to the large number of similar uses of 'hotels' with a dot-com suffix, as well as the common meaning and dictionary definition of 'hotels' and the standard usage of '.com' to show a commercial internet domain." Id. at 1306. Similarly, here, the Board permissibly gave controlling weight to the large number of similar uses of "mattress.com" as well as the common meanings of "mattress" and ".com."

Furthermore, even if, as Dial-A-Mattress asserts, some of the websites containing "mattress.com" in their domain names do not actually sell mattresses online, the fact that many of the websites do sell mattresses online supports the Board's conclusion that the term "mattress.com" is primarily used to identify services in the same genus as Dial-A-Mattress's services. In re Dial-A-Mattress, 2008 TTAB Lexis 437 at *9–10. We therefore find substantial evidence to support the Board's conclusion that "[c]onsumers would see MATTRESS.COM and would immediately recognize it as a term that denotes a commercial website rendering retail services featuring mattresses."

We further disagree with Dial-A-Mattress's assertion that the mark MATTRESS.COM is not generic because the relevant public would not use the term "mattress.com" to refer to online mattress retailers. The test is not only whether the relevant public would itself use the term to describe the genus, but also whether the relevant public would understand the term to be generic. See H. Marvin Ginn, 782 F.2d at 990 (describing the test as whether the term is "understood by the relevant public primarily to refer to [the appropriate] genus of goods or services"). Thus, it is irrelevant

whether the relevant public refers to online mattress retailers as "mattress.com." Instead, as the Board properly determined, the correct inquiry is whether the relevant public would understand, when hearing the term "mattress.com," that it refers to online mattress stores. We also disagree with Dial-A-Mattress's assertion that there can only be one generic term, which is "online mattress stores." Instead, any term that the relevant public understands to refer to the genus of "online retail store services in the field of mattresses, beds, and bedding" is generic.

Finally, we agree with the PTO that substantial evidence supports the Board's finding that the ".com" tail in MATTRESS.COM does not evoke the quality of comfort in mattresses and that the mark is not a mnemonic. As the PTO points out, Dial-A-Mattress presented no evidence that the relevant public finds such a double entendre in the term MATTRESS.COM. We have stated that "[o]nly in rare instances will the addition of a [top level domain] indicator to a descriptive term operate to create a distinctive mark." In re Steelbuilding.com, 415 F.3d at 1297. Similarly, here, because Dial-A-Mattress presented no evidence that ".com" evoked anything but a commercial internet domain, this is not a case in which the addition of ".com" affects the genericness of the mark. Furthermore, because Dial-A-Mattress presented no evidence that the mark MATTRESS.COM acts a mnemonic, substantial evidence supports the Board's finding in that regard.

We have considered Dial-A-Mattress's remaining arguments and find them unpersuasive.

CONCLUSION

Accordingly, we affirm the Board's decision.

AFFIRMED

Novak v. Tucows Inc.,
No. 06-CV-1909, 2007 U.S. Dist. LEXIS 21269 (E.D.N.Y. Mar. 26, 2007)
No. 07-2211-cv, 2009 U.S. App. LEXIS 9786 (2d Cir. May 6, 2009)

H

United States District Court,
E.D. New York.
Robert **NOVAK** d/b/a Petswarehouse.Com,
Plaintiff,
v.
TUCOWS, INC., Opensrs and Nitin Networks, Inc., Defendants.
No. 06-CV-1909(JFB)(ARL).

March 26, 2007.

Plaintiff appears pro se.

Glenn Matthew Mitchell, Esq., Schwimmer Mitchell Law Firm, Mount Kisco, New York, for Defendant Tucows.

Gary Adelman, Esq., Adelman & Lavania, New York, NY, for Defendant Nitin.

MEMORANDUM AND ORDER

JOSEPH F. BIANCO, District Judge.

*1 *Pro se* plaintiff Robert Novak ("Novak") brings the present action against defendants Tucows, Inc. and its subsidiary, OpenSRS [FN1] (collectively, "Tucows") and Nitin Networks, Inc. ("Nitin") (collectively, "defendants"), alleging that defendants' transfer of his internet domain name, "petswarehouse.com," constituted trademark infringement and trademark dilution in violation of the Lanham Act, 15 U.S.C. § 1114, 1117, 1125(a) & 1125(c). Plaintiff also brings pendent state claims, including: conversion, negligence, bailee breach of duty, bailee breach of trust, negligent misrepresentation, breach of contract, tortious interference and intentional infliction of emotional distress.

FN1. Tucows, Inc. does business under the name OpenSRS; however, there is no legal entity by the name of OpenSRS that is connected with Tucows. (Lazare Decl., ¶ 3; Tucows' Br., at 6 n. 6.) Therefore, this Court shall consider Tucows, Inc. and OpenSRS as a single entity.

Presently before the court are defendants' motions to dismiss the complaint pursuant to Fed.R.Civ.P. 12(b)(3), on the basis of improper venue, or, in the alternative, under Fed.R.Civ.P. 12(b)(6) and 12(b)(1), on the grounds that plaintiff fails to state a federal claim upon which relief may be granted and, absent any federal question, this Court lacks jurisdiction due to an absence of complete diversity between the parties. Plaintiff cross-moves to strike certain of both defendants' declarations and exhibits, and defendant Tucows moves to strike certain of plaintiff's exhibits.

For the reasons that follow, plaintiff's motion to strike is granted in part and denied in part. Defendant Tucows' motion to strike is granted, and both defendants' motions to dismiss are granted on the basis of improper venue.

I. BACKGROUND

A. The Facts

The following facts are taken from the amended complaint.

In approximately November 1997, Novak registered for and obtained the Internet domain name "petswarehouse.com" through "Bulkregister.com," an internet domain name registration company. (Am.Compl.¶¶ 36, 38.) He then commenced selling pet supplies and livestock via his website.(*Id.* ¶ 124.) According to Novak, his website was the fourth most-visited pet-supply-related site in the United States during 1999. (*Id.* ¶ 5.) On July 30, 2001, Novak trademarked the domain name

© 2009 Thomson Reuters. No Claim to Orig. US Gov. Works.

"petswarehouse.com" and was awarded trademark number 2,600,670. (*Id.* ¶ 36.)

On February 11, 2003, in the Circuit Court of Colbert County, Alabama, an individual named John Benn obtained a default judgment against Novak in the amount of $50,000. (*Id.* ¶ 37.) Faced with the prospect of litigation in Alabama, Novak, a New York resident, opted to transfer the domain name "petswarehouse.com" from "Bulkregister.com," which was based in Maryland, to another company, Nitin, which was located in New York. (*Id.* ¶¶ 38-39 .) On March 21, 2003, Novak contacted Nitin by telephone in order to initiate the transfer of his domain name. (*Id.* ¶ 39.) A little over one month later, on May 1, 2003, Benn applied for a writ of execution to obtain Novak's domain name "petswarehouse.com" in an effort to enforce the default judgment that he had been awarded against Novak. (*Id.* ¶ 41.) Novak asserts that it was only as a result of the May 1, 2003 writ of execution that he became aware that his domain name was actually being held by Tucows, a Canadian registration company, rather than the New York-based Nitin. (*Id.* ¶ 42.) Novak contacted Nitin on May 2, 2003, and demanded that Nitin transfer registration of "petswarehouse.com" from Tucows back to Nitin. (*Id.*) Novak was told by Nitin that such a transfer was not possible. (*Id.*)

*2 The Alabama trial court's May 1, 2003 writ of execution required Tucows to suspend domain name hosting of "petswarehouse.com" and to turn over the domain name to the Colbert County Sheriff's Department for public auction. (*Id.* ¶ 45; Ex. C.) On May 23, 2003, Tucows transferred control over the domain name to the Alabama court pursuant to the court's order, and access to Novak's servers through the "petswarehouse.com" web address was suspended. (*Id.* ¶ 47, 124; Ex. D.) Internet users accessing "petswarehouse.com" were directed to a web page providing notice of the Colbert County Sheriff's Sale of the domain name pursuant to the Alabama trial court's writ of execution. (*Id.* ¶ 68; Ex. E .) On July 28, 2003, Benn purchased "petswarehouse.com" in a public auction held by the Colbert County Sheriff, in which Benn was the only bidder. (*Id.* ¶ 54.) On September 16, 2003, Tucows transferred the domain name to Benn pursuant to the Alabama trial court's order. (*Id.* ¶ 55.)

Novak challenged the Alabama trial court's decision, and on April 2, 2004, the Alabama Court of Civil Appeals reversed Benn's default judgment and writ of execution against Novak on the basis that the judgment had been entered without personal jurisdiction over Novak. (*Id.* ¶ 71.) Armed with the state appellate court decision, Novak demanded that Tucows return control of "petswarehouse.com" to him. (*Id.* ¶ 72.) On October 1, 2004, after Benn was denied rehearing by the Alabama Court of Civil Appeals and the Alabama Supreme Court, Tucows returned the domain name to Novak. (*Id.* ¶ 72-73.)

Plaintiff alleges that the transfer of his domain name out of his control between May 1, 2003 and October 1, 2004 destroyed his pet-supply business. Prior to May 23, 2003, Novak had received approximately 12,000 daily visitors to "petswarehouse.com." (*Id.* ¶ 134.) Following transfer of the domain name, visitors to the website were directed to the sheriff's notice of sale, and Novak was unable to process any pet-supply orders. (*Id.*) According to Novak, Tucows and Nitin's transfer of the domain name out of his control diluted the "petswarehouse.com" trademark in violation of the Lanham Act, 15 U.S.C. § 1125(c). Novak also asserts that the transfer deceptively and misleadingly represented Tucows and Nitin's association with "petswarehouse.com," and constituted unfair competition and cyberpiracy under 15 U.S.C. §§ 1114, 1117 & 1125(a).

B. Procedural History

On April 25, 2006, Novak, proceeding *pro se*, filed the instant complaint against defendants Tucows, Inc. and OpenSRS. By letter dated May 11, 2006, defendant Tucows indicated its intention to move for dismissal on the basis of improper venue. Upon

© 2009 Thomson Reuters. No Claim to Orig. US Gov. Works.

learning of defendants' proposed motion to dismiss, plaintiff modified his claims, adding Nitin as a defendant, and filed an amended complaint on May 16, 2006. On July 10, 2006, defendants Nitin and Tucows moved to dismiss the complaint on the basis of improper venue, or, in the alternative, failure to state a claim and lack of subject-matter jurisdiction. Plaintiff cross-moved to strike the declarations and exhibits submitted by defendants in support of their motions to dismiss, and defendants moved to strike certain of plaintiff's exhibits. Oral argument and an evidentiary hearing were held on December 22, 2006, January 25, 2007 and February 9, 2007.

II. EVIDENTIARY OBJECTIONS

A. Plaintiff's Motion to Strike

1. General Objections to Admissibility of Foreign Declarations

*3 According to Novak, the declarations of two of defendant Tucows' employees in Canada are inadmissible under Fed.R.Evid. 902(12). Rule 902(12) permits foreign documents to be submitted into evidence as self-authenticating business records if accompanied by a declaration signed "in a manner that, if falsely made, would subject the maker to criminal penalty under the laws of the country where the declaration is signed." Fed.R.Evid. 902(12). Novak argues that, in order to meet this requirement, a "jurat including penalty of perjury" under Canadian law should have been provided by defendants with regard to the declarations submitted by Brenda Lazare ("Lazare"), Tucows' Secretary and General Counsel, and Evgeniy Pirogov ("Pirogov"), Team Leader of the OpenSRS Development Team. (Pl.'s Br., at 25-26.) However, where a matter must be supported by a sworn declaration, a declaration written outside of the United States may be supported "with like force and effect" by a statement in writing that "I declare (or certify, verify, or state) under penalty of perjury under the laws of the United States of America, that the foregoing is true and correct. Executed on (date)." 28 U.S.C. § 1746. In this instance, both the Lazare and Pirogov declarations contain the requisite statement, and are therefore admissible. (*See* Lazare Decl., at 9; Pirogov Decl., at 6.)

2. Objections to the Lazare Declaration

According to plaintiff, the Lazare declaration is also defective in failing to authenticate the attached Exhibits J-L as business records. The contested exhibits include: Exhibit J, excerpts from the registrar's agreement between Tucows and ICANN, the non-profit corporation that administers the internet domain name and internet protocol number system; Exhibit K, excerpts from Tucows' registrar license and the registry-registrar agreement between Tucows and Network Solutions, Inc. a/k/a Verisign, Inc. ("Verisign"), a registry that operates and maintains ".com" top-level domain names; and Exhibit L, excerpts from Nitin's reseller application and the reseller agreement between Tucows and Nitin. (Lazare Decl., Ex. J-L.) In the declaration, Lazare, as Secretary and General Counsel of Tucows, clearly sets forth her personal knowledge of the facts stated therein, explaining that she has held her current position overseeing management of the regulatory compliance and disputes department of Tucows since June 2000. (Lazare Decl., ¶ 1-2.) Specifically, Lazare details Tucows' relationship with ICANN, Verisign and Nitin, and clearly sets forth how the related exhibits were created and maintained in the course of "regularly conducted business activity," pursuant to Fed.R.Evid. 803(6). Therefore, the Court finds that Exhibits J-L are properly authenticated by the Lazare declaration and, moreover, are admissible as business records.

Plaintiff further asserts that the Lazare Declaration should be held inadmissible on the basis that it contains legal argument. The Court finds that the first 26 paragraphs of the declaration contain factual descriptions of the domain name registration and

© 2009 Thomson Reuters. No Claim to Orig. US Gov. Works.

transfer processes. (*Id.* ¶¶ 1-26.) However, paragraphs 27-31 of the declaration present legal argument regarding the applicability of the forum selection clause at issue in this case, and as such, those paragraphs shall be disregarded. (*Id.* ¶¶ 27-31.) *See, e.g ., Kamen v. Am. Tel. & Tel. Co.*, 791 F.2d 1006, 1011 (2d Cir.1986) (holding that it was improper for district court to consider "conclusory and hearsay" statements in an attorney affidavit where the statements were not based upon personal knowledge).

3. Objections to the Pirogov Declaration

*4 Novak argues that the Pirogov Declaration lacks personal knowledge, expresses "expert opinion" testimony, and includes hearsay. Pirogov, Team Leader of the OpenSRS Development Team since October 2003, asserts in his declaration that his duties include "supervision of the software development that allows Tucows to process transfers, and maintenance of the logs that archive prior transfers." (Pirogov Decl., ¶¶ 1-4.) Based upon Pirogov's position and his statements, the Court finds that he has sufficient personal knowledge to describe Tucows' domain name transfer process, and to authenticate the exhibits demonstrating that process. Furthermore, the Court finds no basis in the declaration for Novak's assertion that it includes "expert opinion" testimony or hearsay.

In addition, plaintiff objects to the admissibility of Exhibits B-I, authenticated therein, on the basis that they have been newly created for0 purposes of this litigation, and were not kept in the ordinary course of business. The Court disagrees. First, the Court finds that these exhibits have been authenticated by Pirogov pursuant to Rule 901(b)(9), which permits the admission of "[e]vidence describing a process or system used to produce a result and showing that the process or system produces an accurate result." Fed.R.Evid. 901(b)(9). Furthermore, to the extent that Exhibits B-I are submitted merely as a demonstrative aid, the Court finds that the hearsay rule is not applicable. "[T]here is no requirement that demonstrative evidence be shown to be totally accurate. Rather, alleged inaccuracies go to the weight and not the admissibility of the evidence." 5-900 *Weinstein's Federal Evidence* § 900.07 (2006); *see, e.g., Datskow v. Teledyne Cont 'l Motors Aircraft Prod.*, 826 F.Supp. 677, 686 (W.D.N.Y.1993) (admitting computer-generated animation used to show theory of how accident occurred). Thus, the Court shall consider Exhibits B-I to the extent that they demonstrate the process of transferring domain names, rather than to show the transfer steps specific to "petswarehouse.com." FN2

FN2. At the evidentiary hearing, Eliot Noss, CEO of Tucows, testified regarding a series of additional exhibits that recreate the steps taken during Novak's transfer of the domain name "petswarehouse.com" based upon information stored in Tucows' databases. This Court ruled that such exhibits were, in fact, admissible for purposes of showing the transfer steps specific to the transaction in question:

> There are a few documents in which the witness testified the computer took data and put it in the form of how it would have appeared on the page at the time to show where the information would have been inputted on the forms as they currently existed at the time of the transaction. I find that that is also admissible.... [T]he witness properly laid the foundation for the[m] having retained the data, and for what forms they used at the time, and it was clear to point out that this was not created at the time, but it was recreated to show, based upon what data they stored, where it would have been inputted on their existing forms. So I think it is admissible under the rules of evidence.... I think, based upon [Noss'] testimony, they have laid the proper foundation for the admissibility of the docu-

© 2009 Thomson Reuters. No Claim to Orig. US Gov. Works.

> ments. So I am admitting Defense Exhibits T 1 through 10.
>
> (Transcript of December 22, 2006 Hearing (hereinafter "Dec. 22, 2006 Tr.," at 125-26.)

4. Objections to the Agarwal Declaration

Novak argues that the declaration submitted by Nitin Agarwal ("Agarwal"), CEO and founder of Nitin, contains impermissible hearsay and is not based on personal knowledge. The Court finds, based upon Agarwal's position, that he had personal knowledge of the events relating to Nitin's handling of the transfer of Novak's domain name. Moreover, any potential defects in Agarwal's declaration were subsequently cured by his testimony at the evidentiary hearing, in which he set forth a clear basis for his personal knowledge of Novak's interactions with Nitin in transferring "petswarehouse.com."

Plaintiff also asserts that the Agarwal Declaration contains the false statement that "[a]t the time of the transfer [March 21, 2003], Nitin Networks was not registering any domain names as a registrar, and was exclusively using Defendant Tucows for all of its registrations and transfers." FN3 (Agarwal Decl., ¶ 4.) According to plaintiff, this statement conflicts with evidence that Nitin Networks was, in fact, registering domain names. However, plaintiff's objection does not go to the admissibility of the Agarwal Declaration, but to its credibility and weight.

> FN3. During the evidentiary hearing, plaintiff cross-examined Agarwal regarding paragraph 4 of his declaration, and Agarwal affirmed "I stand by the full sentence of the statement." (Jan. 25, 2007 Tr. 87.)

B. Defendants' Motion to Strike

***5** Defendants contend that plaintiff's Exhibits B, J, K, O-R, U and V, which are printouts of internet pages, constitute inadmissible hearsay and do not fall within any acknowledged exception to the hearsay rule. FN4 At the evidentiary hearing, defendants objected to Plaintiff's Exhibit 1, as well as to Plaintiff's Exhibits N-R. (Jan. 25, 2007 Tr. 125-31.) Plaintiff's Exhibit 1 is a printout from "RegisterSite.com," Nitin's website, as it purportedly appeared in 2003. (Pl.'s Ex. 1.) According to plaintiff, he obtained the printout through a website called the Internet Archive, which provides access to a digital library of Internet sites. (Novak Decl., ¶ 2.) The Internet Archive operates a service called the "Wayback Machine," which purports to allow a user to obtain an archived web page as it appeared at a particular moment in time. (*See id.* ¶¶ 3-5.) The other contested exhibits include: Exhibit B, an online summary of plaintiff's past and pending lawsuits, obtained via the Wayback Machine; Exhibit J, printouts of comments on a web message board by Pirogov; Exhibit K, a news article from the Poughkeepsie Journal website featuring Agarwal; Exhibit N, Novak's declaration regarding the authenticity of pages printed from the Wayback Machine; Exhibit O, pages printed from the Internet Archive website; Exhibit P, pages printed from the Wayback Machine website; Exhibits Q, R and U, all of which constitute pages printed from RegisterSite.com via the Wayback Machine; and Exhibit V, a news article from "The Register," a British website, regarding Tucows. (Pl.'s Exs. B, J, K, N-R, U & V.) Where postings from internet websites are not statements made by declarants testifying at trial and are offered to prove the truth of the matter asserted, such postings generally constitute hearsay under Fed.R.Evid. 801. *United States v. Jackson,* 208 F.3d 633, 638 (7th Cir.2000) (declining to admit web postings where defendant was unable to show that the postings were authentic, and holding that even if such documents qualified under a hearsay exception, they are "inadmissible if the source of information or the method or circumstances of preparation indicate a lack of trustworthiness") (quoting *United States v. Croft,* 750 F.2d 1354, 1367 (7th Cir.1984)); *see also St. Clair v. Johnny's Oyster & Shrimp, Inc.,* 76

© 2009 Thomson Reuters. No Claim to Orig. US Gov. Works.

F.Supp.2d 773, 775 (S.D.Tex.1999) ("[A]ny evidence procured off the Internet is adequate for almost nothing, even under the most liberal interpretation of the hearsay exception rules.").

FN4. During the evidentiary hearing, defendant Tucows also objected to the admission of plaintiff's Exhibit S, a document titled "OpenSRS Quickstart Instructions," and dated January 2001, on the basis that the exhibit had not been authenticated by Tucows. (Jan. 25, 2007 Tr. 46-50.) By letter dated January 30, 2007, Tucows withdrew its objection based upon the authenticity of Exhibit S. (Tucows' January 30, 2007 Letter, at 2.) However, Tucows "reserve[d] the right to argue the immateriality of the document, based both on its contents and the relevance of the 2001 document to events that took place in 2003." (*Id.*)

Furthermore, in this case, such documents have not been properly authenticated pursuant to Fed.R.Evid. 901. While plaintiff's declaration purports to cure his inability to authenticate the documents printed from the internet, he in fact lacks the personal knowledge required to set forth with any certainty that the documents obtained via third-party websites are, in fact, what he proclaims them to be. This problem is even more acute in the case of documents procured through the Wayback Machine. Plaintiff states that the web pages archived within the Wayback Machine are based upon "data from third parties who compile the data by using software programs known as crawlers," who then "donate" such data to the Internet Archive, which "preserves and provides access to it ." (Novak Decl. ¶ 4.) Based upon Novak's assertions, it is clear that the information posted on the Wayback Machine is only as valid as the third-party donating the page decides to make it-the authorized owners and managers of the archived websites play no role in ensuring that the material posted in the Wayback Machine accurately represents what was posted on their official websites at the relevant time. As Novak proffers neither testimony nor sworn statements attesting to the authenticity of the contested web page exhibits by any employee of the companies hosting the sites from which plaintiff printed the pages, such exhibits cannot be authenticated as required under the Rules of Evidence. *See, e.g. Costa v. Keppel Singmarine Dockyard PTE, Ltd.*, No. 01-CV-11015 MMM (Ex), 2003 U.S. Dist. LEXIS 16295, at *29 n. 74 (C.D.Cal. Apr. 25, 2003) (declining to consider evidence downloaded from corporation's website in the absence of testimony from the corporation authenticating such documents) (citing Jackson, 208 F.3d at 638, and St. Clair, 76 F.Supp.2d at 775 ("Anyone can put anything on the internet. No web-site is monitored for accuracy and nothing contained therein is under oath or even subject to independent verification absent underlying documentation.")). Therefore, in the absence of any authentication of plaintiff's internet printouts, combined with the lack of any assertion that such printouts fall under a viable exception to the hearsay rule, defendants' motion to strike Exhibits B, J, K, N-R, U and V is granted.[FN5]

FN5. The Court notes that, even if all of plaintiff's exhibits were admissible, they would not impact the Court's analysis or conclusions on the substantive issues in the instant case.

III. STANDARD OF REVIEW

***6** Defendants challenge venue in this case pursuant to Federal Rule of Civil Procedure 12(b)(3). However, the Court must first address the question of whether a motion to dismiss based upon a forum selection clause is properly brought under Rule 12(b)(3) as a challenge to venue, rather than under Rule 12(b)(6) for failure to state a claim or Rule 12(b)(1) for lack of subject-matter jurisdiction.

In *New Moon Shipping Co., Ltd. v. Man B & W Diesel A.G.*, the Second Circuit acknowledged the absence of consensus among the courts regarding

© 2009 Thomson Reuters. No Claim to Orig. US Gov. Works.

the correct procedural mechanism for dismissal of a suit pursuant to a valid forum selection clause. 121 F.3d 24, 28 (2d Cir.1997) (comparing *AVC Nederland B.V. v. Atrium Inv. P'ship,* 740 F.2d 148, 152 (2d Cir.1984) (applying Fed.R.Civ.P. 12(b)(1) to a motion to dismiss based upon a forum selection clause), with *Paterson, Zochonis (U.K.) Ltd. v. Compania United Arrows, S.A.,* 493 F.Supp. 626, 629 (S.D.N.Y.1980) (applying Fed.R.Civ.P. 12(b)(3))); *see also Rainforest Café, Inc. v. EklecCo, L.L.C.,* 340 F.3d 544, 546 n. 5 (8th Cir.2003) (recognizing controversy between whether to apply Fed.R.Civ.P. 12(b)(3) or Fed.R.Civ.P. 12(b)(6) to a motion to dismiss based on forum selection clause). In this instance, defendants have framed the forum-selection clause issue as a motion to dismiss pursuant to Rule 12(b)(3), and in the absence of any objection to this framework by plaintiff, the Court shall consider the jurisdictional issue pursuant to this rule. *See, e.g., Person v. Google, Inc.,* 456 F.Supp.2d 488, 492-93 (S.D.N.Y.2006) ("Here, the issue will be considered under Fed. Civ. P. Rule 12(b)(3) because that is how it was framed by the parties.") (citing *J.B. Harris, Inc. v. Razei Bar Indus., Inc.,* 37 F.Supp.2d 186, 189 (E.D.N.Y.1998) ("The Court does not decide whether this issue might more properly have been raised by way of Rule 12(b)(6), as the issue is squarely framed by Defendants under Rule 12(b)(3) and Plaintiff does not argue that this is an improper procedural mechanism.") (internal citation omitted)).

Without resolving the question of whether to treat the motion to dismiss as a 12(b)(1) or 12(b)(3) motion, the Second Circuit held in *New Moon Shipping* that "at the initial stage of litigation, a party seeking to establish jurisdiction need only make a *prima facie* showing by alleging facts which, if true, would support the court's exercise of jurisdiction." 121 F.3d at 29 (citing *Marine Midland Bank, N.A. v. Miller,* 664 F.2d 899,904 (2d Cir.1981)); *Gulf Ins. Co. v. Glasbrenner,* 417 F.3d 353, 355 (2d Cir.2005) ("If the court chooses to rely on pleadings and affidavits, the plaintiff need only make a *prima facie* showing of [venue].") (quoting *CutCo Indus. v. Naughton,* 806 F.2d 361, 364-65 (2d Cir.1986) and citing *Sunward Elecs. v. McDonald,* 362 F.3d 17, 22 (2d Cir.2004)). "After limited discovery on the jurisdictional issue, the matter might be appropriate for resolution on motion supported by affidavits, or, if a genuine dispute of material fact exists, the Court may conduct a hearing limited to Article III standing." *Alliance for Envtl. Renewal, Inc. v. Pyramid Crossgates Co.,* 436 F.3d 82, 87-88 (2d Cir.2006) (citations omitted). Disputed facts may be resolved against the non-moving party only after an evidentiary hearing, where the plaintiff must demonstrate venue by a preponderance of the evidence. *New Moon Shipping,* 121 F.3d at 29 ("A disputed fact may be resolved in a manner adverse to the plaintiff only after an evidentiary hearing.... [A] party seeking to avoid enforcement of such a contractual clause is also entitled to have the facts viewed in the light most favorable to it, and no disputed fact should be resolved against that party until it has had an opportunity to be heard.") (citations omitted); *Gulf Ins. Co.,* 417 F.3d at 355 ("[I]f the court holds an evidentiary hearing ... the plaintiff must demonstrate [venue] by a preponderance of the evidence.") (quoting *CutCo Indus.,* 806 F.2d at 364-65) (additional citation omitted); *Murphy v. Schneider Nat'l, Inc.,* 362 F.3d 1133, 1139 (9th Cir.2004) ("To resolve such motions when genuine factual issues are raised, it may be appropriate for the district court to hold a Rule 12(b)(3) motion in abeyance until the district court holds an evidentiary hearing on the disputed facts. Whether to hold a hearing on disputed facts and the scope and method of the hearing is within the sound discretion of the district court.") (citations omitted).

*7 In this case, the Court conducted an evidentiary hearing to resolve a disputed material fact as to whether venue is proper in this Court: specifically, whether plaintiff consented to an agreement with defendant Tucows that contained a forum selection clause mandating litigation of all related disputes in Ontario, Canada. At the evidentiary hearing, all parties presented evidence bearing on the question

© 2009 Thomson Reuters. No Claim to Orig. US Gov. Works.

of whether Novak agreed to transfer his domain name to Tucows by clicking his assent to a Domain Name Transfer Agreement ("DNTA") on a website. The DNTA in question contained the following forum selection clause at paragraph 27:

> GOVERNING LAW. This agreement shall be governed by and interpreted and enforced in accordance with the laws of [sic] Province of Ontario and the federal laws of Canada applicable therein without reference to rules governing choice of laws. *Any action relating to this agreement must be brought in Ontario* and you irrevocably consent to the jurisdiction of such courts.

(Pirogov Decl., Ex. H.) The legal effect of a forum selection clause depends upon "whether its existence was reasonably communicated to the plaintiff." *Effron v. Sun Line Cruises, Inc.*, 67 F.3d 7, 9 (2d Cir.1995) (citations omitted). "A forum selection clause stated in clear and unambiguous language ... is considered reasonably communicated to the plaintiff in determining its enforceability." *Vitricon, Inc. v. Midwest Elastomers, Inc.*, 148 F.Supp.2d 245, 247 (E.D.N.Y.2001) (*citing Efron,* 67 F.3d at 9). As there is no question that the language of the forum-selection clause at issue is clear and unambiguous, should this Court find that Novak did, in fact, "click-through" the Tucows DNTA, the Court may fairly conclude that the clause was "reasonably communicated" to the plaintiff. *Id.*

IV. THE EVIDENTIARY HEARING

The Court conducted an evidentiary hearing, over several days, to determine whether Novak in fact "clicked-through" his assent to Tucows' DNTA. Based upon the testimony and exhibits presented at the hearing, the Court finds that there is overwhelming evidence that the plaintiff consented to the DNTA with Tucows. Although it is unclear whether plaintiff actually read the agreement, the evidence unequivocally demonstrates that he was required to "click-through" his assent to Tucows' DNTA in order to complete the successful transfer of "petswarehouse.com."

The plaintiff argues that he never agreed to the forum-selection clause, and, further, that he never agreed to enter into any agreement whatsoever with defendant Tucows. According to Novak, when he transferred the domain name "petswarehouse.com" from its original registrar, "Bulkregister.com," he did so solely by phone agreement with Nitin, whose online transfer system was not operational at the time. (Jan. 25, 2007 Tr. 117.) Novak explained that he was not aware that Nitin was actually a reseller, rather than a registrar, of domain names, nor that Tucows was the actual registrar of "petswarehouse.com" until over a month after the transfer, when Benn issued a writ of execution to obtain the domain name from Tucows. (Jan. 25, 2007 Tr. 112, 117; Feb. 9, 2007 Tr. 49.) Novak argues that, in fact, his intent in transferring the domain name from "Bulkregister.com" to Nitin was to bring the domain name under the control of a New York-based registrar. (Jan. 25, 2007 Tr. 110-11; Feb. 9, 2007 Tr. 66-67.) According to Novak, had he received a DNTA from Tucows, a Canadian registrar, he "would have declined the transfer, first because [he] would have felt deceived in seeing another company being involved in this transaction, and moreover a company based not only outside New York, but Canada." (Feb. 9, 2007 Tr. 63.)

***8** In response, defendants argue that plaintiff could not possibly have executed transfer of his domain name to Tucows solely by oral agreement by phone with Nitin. According to Tucows, "[p]laintiff's assertion that he transferred the petswarehouse.com domain name orally through Nitin Networks is demonstrably and necessarily false, as the domain name registration system does not permit transfers without the safeguard of an electronic confirmation." (Tucows' Br., at 5.) Contrary to Novak's assertion that he never entered into any agreement with Tucows, Noss testified that such agreements are "necessary" to the domain name transfer process, and that "[t]hey are overwhelmingly-in fact,

© 2009 Thomson Reuters. No Claim to Orig. US Gov. Works.

in our case, almost without exception, they are click-through agreements, ones that are subscribed to on a web page." (Dec. 22, 2007 Tr. 14.) Tucows asserts that, after plaintiff communicated with Nitin by phone, he received notification by email from Tucows that he would have to execute further electronic authorization of the transfer. (Tucows' Br., at 5.) According to Tucows, in the confirmation email, plaintiff was instructed to click on a link directing him to Tucows' website, where he was required to submit a "Transfer Confirmation Form,"affirming that he had "both read and understood the Domain Transfer and Registration Contract," and that he "fully accepts the terms of the Domain Name Transfer and Registration Contract." FN6 (Tucows' Br., at 4.) A hyperlink to the DNTA was provided on the Transfer Confirmation Form. (Tucows' Br., at 4.) However, Novak categorically asserts that he "never received the e-mail. If I would have, I would have immediately canceled and gone to another registrar in New York." (Feb. 9, 2007 Tr. 66.)

FN6. In addition, Tucows argues that it was clear from the electronic confirmation form that plaintiff would be entering into a contract with Tucows (rather than with Nitin) by language on the form stating that "[t]he domain listed above will be transferred to Registersite.com (An authorized reseller of Tucows)." (Tucows' Br., at 4.)

During the evidentiary hearing, Noss, Tucows' CEO, testified, based upon a review of Tucows' records, that the plaintiff had, in fact, engaged in each of the above steps:

I can say with certainty that, first, the request for transfer was received by Tucows, that we sent a confirmatory e-mail to bob@petswarehouse.com. We have the IP address, in other words, the specific address of the computer that was connected to the internet that received that e-mail. I can say with certainty that that e-mail, coming from IP address, had a link in it which was clicked on. And that email contained a unique password generated solely for the purpose of confirming this transfer. That password was then entered into the web page that resulted from clicking on the link. And I can also say with certainty that on the resulting pages, that the box that says, in effect, I agree with the terms and conditions, was ticked.

(Dec. 22, 2006 Tr. 21-22.) Noss' testimony is fully corroborated by exhibits introduced at the hearing, which are printouts from Tucows' computer database that reflect data generated contemporaneously with Novak's domain name transfer. On March 31, 2003, at 12:28 p.m. and 43 seconds Eastern Standard Time, Tucows received a transfer request. (Dec. 22, 2006 Tr. 30; Defs.' Ex. T2.) Three seconds later, Tucows sent a confirmation email to "bob @petswarehouse.com," Novak's email address. FN7 (Dec. 22, 2006 Tr. 30; Defs.' Ex. T2.) On the same day, at 5:07 p.m. and 26 seconds, a hyperlink within the email was clicked by the recipient. (Dec. 22, 2006 Tr. at 58-59; Defs.' Ex. T6.) Less than one minute later, at 5:08 p.m. and 15 seconds, the email recipient typed the required domain name and transfer key into the Tucows website. (Dec. 22, 2006 Tr. at 59; Defs.' Ex. T6.) Finally, at 5:14 pm and 51 seconds, the contract on the website was assented to and the request was submitted. (Dec. 22, 2006 Tr. at 59; Defs.' Ex. T6.) Noss explained that, if Novak had not entered the proper information during each of these steps, or if he had simply ignored the confirmation email from Tucows, the transfer would have failed. (Dec. 22, 2006 Tr. at 60.)

FN7. Novak concedes that he is the sole user of the email address "bob@petswarehouse.com," and that the address is not case-sensitive." (Feb. 9, 2007 Tr. 27, 28.)

***9** In response, Novak counters that he never engaged in the required steps, and that it was actually Agarwal, CEO of Nitin, who "went directly into the Tucows database, changed the contact info to himself, received the confirmation e-mails, and clicked them off to force the transfer to go through. Altern-

© 2009 Thomson Reuters. No Claim to Orig. US Gov. Works.

atively, he modified the database to indicate that that had occurred." (Feb. 9, 2007 Tr. 66 .) However, the Court finds Novak's theory that Agarwal manually input false data in order to effect the domain name transfer to be incredible. Based upon the overwhelming evidence that Novak did, in fact, assent to the DNTA, and that a transfer of his domain name to Tucows would not have been possible without such assent, the Court finds, despite Novak's blanket denials and conspiracy theories, that he did enter into such an agreement with Tucows and therefore is subject to the forum-selection clause contained therein, unless there is some ground for the clause to be found invalid. It is the latter issue to which the Court now turns.

V. VALIDITY OF FORUM SELECTION CLAUSE

A. Standard

Under the standard set forth by the Supreme Court in *The Bremen v. Zapata Off-Shore Company,* forum selection clauses are *prima-facie* valid and should control questions of venue absent a "strong showing" that enforcement would be "unreasonable and unjust, or that the clause was invalid for such reasons as fraud or overreaching." 407 U.S. 1, 15, 16 (1972). A forum selection clause can bind the parties even where the agreement in question is a form consumer contract that is not subject to negotiation. *Carnival Cruise Lines, Inc. v. Shute,* 499 U.S. 585, 589-95 (1991). Such clauses will be enforced only if found to be exclusive or mandatory. *John Boutari and Son, Wines and Spirits, S.A., v. Attiki Imp. and Distrib., Inc.,* 22 F.3d 51, 52-53 (2d Cir.1994). It is clear that the choice of forum is mandatory in this instance, as specific language regarding venue has been included in the clause, specifying that "any action relating to this agreement must be brought in Ontario." *See, e.g., John Boutari and Son, Wines and Spirits, S.A.,* 22 F.3d at 53; *Docksider, Ltd. v. Sea Tech., Ltd.,* 875 F.2d 762, 763-64 (9th Cir.1989); *Cent. Nat'lGottesman, Inc. v. M.V. "Gertrude Oldendorff,"* 204 F.Supp.2d 675, 678 (S.D.N.Y.2002) ("For a forum selection clause to be deemed mandatory, jurisdiction and venue must be specified with mandatory or exclusive language.") (citation omitted).

As the forum selection clause at issue is mandatory, it is enforceable, provided that enforcement would not be unreasonable. A clause is unreasonable: (1) if their incorporation into the agreement was the result of fraud or overreaching; (2) if the complaining party will be deprived of his day in court due to the grave inconvenience or unfairness of the selected forum; (3) if the fundamental unfairness of the chosen law may deprive the plaintiff of a remedy; or (4) if the clauses contravene a strong public policy of the forum state. *Roby v. Corp. of Lloyd's,* 996 F.2d 1353, 1363 (2d Cir.1993) (citing *The Bremen,* 407 U.S. at 10, 15, 18, and *Carnival Cruise Lines, Inc.,* 499 U.S. at 595-96); *S.K.I. Beer Corp. v. Baltika Brewery,* 443 F.Supp.2d 313, 316 (E.D.N.Y.2006) (same) (citations omitted). In his moving papers, plaintiff alleges neither that he will be deprived of his day in court due to the inconvenience of litigating this dispute in Ontario,[FN8] nor that Canadian law is fundamentally unfair and would deprive him of a remedy.[FN9]

FN8. In his supplemental reply brief, dated February 21, 2007, Novak asserts for the first time that he is not able to litigate this dispute in Canada for health reasons. In support of this claim, Novak submits a letter from his treating neurologist, Dr. Candice Perkins, M.D., stating that Novak sustained a carotid occulsion and stroke in August 2000 and continues to suffer from a persistent blockage of blood flow to his brain. (Pl.'s Supp. Br., Ex. A.) According to Dr. Perkins, "as a result prolonged travel out of the country (without close contact of [Novak's] medical team) is ill advised." (*Id.*) In fact, while Novak may very well suffer from illnesses that restrict his ability

© 2009 Thomson Reuters. No Claim to Orig. US Gov. Works.

to travel, such impairments did not prevent him from driving cross-country over a two-week span from January 1 to 14, 2007. (Dec. 22, 2006 Tr. 127.) Novak has given no indication that engaging in litigation in Toronto would be more taxing on his health than his recent travel across the United States; therefore, the Court rejects his argument that "[b]ased on [Dr. Perkins'] opinion and my families [sic] concerns I would have to abandon the thought of any cause of action in Canada against Tucows." (Pl.'s Supp. Br., at 2.) Even if Novak were unable to personally attend proceedings in Canada, such deprivation does not necessarily constitute a denial of his day in court. This Circuit has held that "[t]he right to a day in court means not the actual presentation of the case, but the right to be duly cited to appear and to be afforded an opportunity to be heard." *Effron,* 67 F.3d at 11 (quoting *Olsen v. Muskegon Piston Ring Co.,* 117 F.2d 163, 165 (6th Cir.1941)). "A plaintiff may have his 'day in court' without ever setting foot in a courtroom." *Id.* (citation omitted). While Novak may prefer to bring his case against Tucows in a familiar forum, he consented to bring any such claims in Ontario; in the absence of any showing that plaintiff's health concerns will actually deprive him of his day in court, this Court declines to find that plaintiff should be permitted to evade his contractual obligations.

FN9. In his supplemental brief, Novak also raises for the first time the argument that he could be deprived of a remedy under Canadian law because he "doubt[s] very much that court would have jurisdiction over Nitin but more importantly Canada would have no jurisdiction over John Benn as a witness residing in Alabama" and "there is an issue of the statute of limitation in re-commencing this action in Canada." (Pl.'s Supp. Br., at 2, 3.)

First, a "statute of limitations bar is not a basis for invalidating [a foreign] forum selection clause." *Asoma Corp. v. M/V. Southgate,* 98-CV-7407 (CSH), 1999 U.S. Dist. LEXIS 18974, at *9-* 12 (S.D.N.Y. Dec. 7, 1999) (collecting cases); *see also Street, Sound Around Elec., Inc. v. M/V Royal Container,* 30 F.Supp.2d 661, 663 (S.D.N.Y.1999) ("By bringing suit here and not in Germany, plaintiffs have effectively chosen to ignore the forum selection clause that they previously agreed to; plaintiffs will not be heard now to complain of any potential timeliness problems that this choice may have created.") (citations omitted); *see also New Moon Shipping,* 121 F.3d at 33 ("[C]onsideration of a statute of limitations would create a large loophole for the party seeking to avoid enforcement of the forum selection clause. That party could simply postpone its cause of action until the statute of limitations has run in the chosen forum and then file its action in a more convenient forum.").

Second, while it is unclear whether Agarwal and Benn could be compelled to appear before a court in Ontario, the Court is not persuaded that this factor suggests the "fundamental unfairness" of litigating the instant dispute in Canada. At least in the context of transfers of lawsuits pursuant to 28 U.S.C. § 1404(a) , courts have held that the availability of witnesses does not "tip the balance" with regard to the choice of a forum, particularly where the testimony of such witnesses may be obtained by videotape or deposition. *Dealtime.com Ltd. v. McNulty,* 123 F.Supp.2d 750, 757 (S.D.N.Y.2000); (citing Fed.R.Evid.

© 2009 Thomson Reuters. No Claim to Orig. US Gov. Works.

804(a)(5) and *Citigroup Inc. v. City Holding Co.*, 97 F.Supp.2d 549, 561-62 (S.D.N.Y.2000) ("[T]he unavailability of process over third-party witnesses does not compel transfer when the practical alternative of offering videotaped or deposition testimony of a given witness exists.") (citations omitted). There is no reason to believe that such alternatives to live testimony are not available to Novak in this case.

***10** Plaintiff's contends: (1) th at the "petswarehouse.com" domain name was fraudulently transferred from Nitin to Tucows without his permission, and that holding him to the DNTA would therefore be unconscionable under New York state law because he did not consent to the contract terms, and (2) that the forum selection clause contravenes the public policy of New York state, which protects resident consumers against deceptive business acts and practices under New York General Business Law § 349.

B. FRAUD

Plaintiff alleges, first, that Nitin misled him by falsely representing that Novak would only be interacting with a New York company when he transferred his domain name to Nitin. Plaintiff claims that Nitin concealed the fact that he was merely a reseller of domain names, and that Tucows, a Canadian company, would be the actual registrar. In other words, according to plaintiff, he was lured into transacting with Nitin on the basis of false information and misrepresentation. Plaintiff also alleges that his domain name was fraudulently transferred without his permission from Nitin, with whom he contracted by phone, to Tucows, with whom he did not contract at all. However, even if plaintiff were able to establish valid fraud claims based on these assertions, which he likely cannot, given his "click-through" assent to the Tucows DNTA, such allegations are insufficient to void a forum selection clause on the basis of fraud.

Actions capable of overcoming the presumption of validity of a forum selection clause "must be *directly related to that clause*, not the contract more generally." *Person*, 456 F.Supp.2d at 494 (citations omitted). The Supreme Court has held that, where a party attempting to defeat a forum-selection clause alleges fraud, courts must look to whether the inclusion of the clause itself was fraudulent:

> In *The Bremen* we noted that forum-selection clauses "should be given full effect" when "a freely negotiated private international agreement [is] unaffected by fraud ..." This qualification does not mean that any time a dispute arising out of a transaction is based upon an allegation of fraud, as in this case, the clause is unenforceable. Rather, it means that an arbitration or forum-selection clause in a contract is not enforceable if *the inclusion of that clause in the contract* was the product of fraud or coercion.

Scherk v. Alberto-Culver Co., 417 U.S. 506, 519 n. 14 (1974) (internal citation omitted) (emphasis in original). In this case, Novak fails to allege any fraud specifically relating to the forum-selection clause in question. Further, there is no indication that the clause was added to the DNTA in bad faith, or by coercion. Plaintiff therefore has not established grounds for rejecting the clause on the basis of fraud.

C. UNCONSCIONABILITY

Plaintiff also argues that the DNTA is unconscionable under New York law because he was never provided with an opportunity to view the contract or to consent to its terms. According to plaintiff, he was denied any"meaningful choice" with regard to the selection of Tucows as a registrar, thus demonstrating the contract's unconscionability. (Pl.'s Br., at 40.) However, plaintiff does not actually identify any particular terms of the contract that are substantively unconscionable; instead, he merely reiterates his assertion that he was never given an opportunity to read the contract, a factor that speaks

© 2009 Thomson Reuters. No Claim to Orig. US Gov. Works.

to the agreement's *procedural* unconscionability.

*11 "Procedural unconscionability involves 'the lack of meaningful choice,' which considers all the circumstances surrounding the contract, including whether each party had a reasonable opportunity to understand the terms of the contract, whether deceptive tactics were employed, the use of fine print, and disparities in education, experience and bargaining power." *Gill v. World Inspection Network Int'l, Inc.*, No. 06-CV-3187 (JFB)(CLO), 2006 U.S. Dist. LEXIS 52426, at *19 (E.D.N.Y. Jul. 31, 2006) (citing *Nelson v. McGoldrick*, 896 P.2d 1258, 1262 (Wash.1995), and *Gillman v. Chase Manhattan Bank, N.A.*, 534 N.E.2d 824, 828 (N.Y.1988)). While plaintiff maintains that he neither read nor assented to any agreement with Tucows, this Court has found that plaintiff did, in fact, "click-through" his assent to the DNTA. As a result, even if plaintiff failed to read the terms of the contract, he is nevertheless bound by the forum-selection clause."[I]t is a fundamental principle of contract law that a person who signs a contract is presumed to know its terms and consents to be bound by them." *Paper Express, Ltd. v. Pfankuch Maschinen GMBH*, 972 F.2d 753, 757 (7th Cir.1992) (enforcing forum-selection clause where plaintiff had not read the clause prior to signing the contract) (citing 3 Arthur L. Corbin, *Corbin on Contracts* 607 (1989), and 13 Samuel Williston, *Williston on Contracts* 1577 (1988)); *see also Ainsley Skin Care of N.Y., Inc. v. Elizabeth Grady Face First, Inc.*, No. 97-CV-6716 (LAP)(AJP), 1997 U.S. Dist. LEXIS 19102, at *11 (S.D.N.Y. Dec. 2, 1997) ("[A] businessman acting in a commercial context, is held to have understood the consequences of his having signed [contracts], which designate [a particular forum] as the appropriate forum for any action arising thereunder. If [the complaining party] did not read them or hire counsel to do so, he is the victim of his own lack of diligence, not [the opposing party's] misconduct.") (quoting *Elite Parfums, Ltd. v. Rivera*, 872 F.Supp. 1269, 1273 (S.D.N.Y.1995) (internal citation and additional citations omitted)); *Weingrad v. Telepathy, Inc.*, No. 05-CV-2024 (MBM), 2005 U.S. Dist. LEXIS 26952, at *11 (S.D.N.Y. Nov. 7, 2005) ("He is bound by the terms of the forum selection clause even if he did not take the time to read it because 'a signatory to a contract is presumed to have read, understood and agreed to be bound by all terms, including the forum selection clauses, in the documents he or she signed.' ") (quoting *Sun Forest Corp. v. Shvili*, 152 F.Supp.2d 367, 382 (S.D.N.Y.2001) (internal citation omitted)).

In addition, although the DNTA is a standard form contract offered to all of Tucows' domain name transfer customers, the forum-selection clause may not be defeated for procedural unconscionability on this basis. The Supreme Court has recognized that where a company conducts business in several states, as in the case of Tucows, a non-negotiated forum-selection clause may be enforced even where it was not the subject of bargaining.[FN10] *Carnival Cruise Lines, Inc.*, 499 U.S. at 593-595; *Rosenfeld v. Port Auth. of N.Y. and N.J.*, 108 F.Supp.2d 156, 164 (E.D.N.Y.2000) (noting that an agreement "cannot be considered procedurally unconscionable, or a contract of adhesion, simply because it is a form contract").

FN10. Novak contends that Tucows should be subject to jurisdiction before this Court because in an unrelated case, *Bennett v. America Online, Inc.*, No. 06-CV-13221, 2007 WL 241318 (E.D.Mich. Jan. 23, 2007), "Tucows had acquiesed to the jurisdiction of the United States Courts not with standing their forum selection clause." (Pl .'s Supp. Br., at 2.) In *Bennett*, which involved a copyright dispute against defendants America Online, Inc. ("AOL") and Tucows, the Eastern District of Michigan considered whether to transfer the plaintiff's case to Virginia pursuant to 28 U.S.C. § 1404(a), based upon AOL's forum-selection clause. *Bennett*, 2007 WL 241318, at *1. While not subject to any agreement with the plaintiff in that

© 2009 Thomson Reuters. No Claim to Orig. US Gov. Works.

case, Tucows nevertheless consented to personal jurisdiction in Virginia. *Id.* at *6. However, *Bennett* has absolutely no bearing on the instant case, in which the plaintiff directly entered into a DNTA with Tucows, the plaintiff is clearly subject to the forum-selection clause contained within the agreement, and neither defendant has consented to jurisdiction before this Court.

***12** Finally, the Court cannot find that Novak was so vulnerable or that there was such unequal bargaining power that the contract was procedurally unconscionable, given (1) plaintiff's sophistication in attempting to choose a registrar that would allow him to respond more easily to pending litigation (Am.Compl.¶ 39), (2) his extensive internet and business experience as owner of an extremely popular web company (Am.Compl.¶ 134), and (3) plaintiff's broad computer expertise, acquired over the past thirty years (Novak Decl. ¶ 8).

Therefore, this Court cannot find that the forum selection clause at issue should not be enforced on the basis that Tucows' DNTA was either substantively or procedurally unconscionable.

D. PUBLIC POLICY

In *The Bremen,* the Supreme Court stated that forum selection clauses should not be enforced if "enforcement would contravene a strong public policy of the forum in which suit is brought." 407 U .S. at 18 (citing *Boyd v. Grand Trunk W.R. Co.,* 338 U.S. 263 (1949)). Plaintiff alleges that enforcement of the forum selection clause in Tucows' DNTA counters New York state's public policy as expressed in New York General Business Law § 349. Section 349 allows the state attorney general to bring civil actions on behalf of the people of New York state in order to enjoin unlawful deceptive acts or practices. N.Y. Gen. Bus. Law § 349. In addition, subsection (h) of the statute provides for an individual cause of action on the basis of such acts or practices. N.Y. Gen. Bus. Law § 349(h). Plaintiff curiously relies upon this Court's decision in *Gill v. World Inspection Network Int'l, Inc.,* which directly counters his position, in support of the proposition that litigating his case in a foreign forum would contravene Section 349. In *Gill,* the plaintiff argued that enforcement of an arbitral forum selection clause against franchisees contravened sections of the New York General Business Law that protect franchisees from fraudulent and unlawful practices by franchisors. 2006 U.S. Dist. LEXIS 52426, at *34-36. This Court held that "New York public policy does not operate to undermine the presumptive validity of the arbitral forum selection clause under the preemptive effect of the [Federal Arbitration Act]." *Id.* at * 35. Likewise, there is nothing in Section 349 that undermines the presumptive validity of forum selection clauses as articulated by the Supreme Court and by this Circuit in *The Bremen, Shute,* and *Roby. See Person,* 456 F.Supp.2d at 497 ("It is clear, from Second Circuit precedent, however, that far from being against public policy in this Court's jurisdiction, forum selection clauses are considered 'presumptively valid.' ") (citing *Roby,* 996 F.3d at 1363). In fact, New York courts have consistently upheld forum selection clauses in which New York residents would be forced to litigate in another state or country on the basis that such clauses prevent confusion and costly litigation regarding where suits relating to the contract should be brought and defended, and reduce costs to the consumer by limiting the number of fora in which a case may be brought. *See, e.g., Effron,* 67 F.3d at 10 (finding it reasonable for cruise line to select a single venue for passenger suits) (quoting *Shute,* 499 U .S. at 593-94); *Hellex Car Rental Sys., Inc. v. Dollar Sys., Inc.,* No. 04-CV5580, 2005 U.S. Dist. LEXIS 33858, at *16 (E.D.N.Y. Nov. 9, 2005) ("It is entirely reasonable for [defendant] to require that its franchisees agree to litigate disputes arising from the franchise relationship in Oklahoma, where its corporate headquarters are housed, rather than be required to defend suits in every state where its franchises may be located.") (citing *Carnival Cruise Lines, Inc.,*

© 2009 Thomson Reuters. No Claim to Orig. US Gov. Works.

499 U.S. at 593). As plaintiff is unable to show that enforcement of the forum selection clause in question would contravene New York public policy, the Court rejects his contention.

E. APPLICABILITY OF FORUM-SELECTION CLAUSE TO NITIN

***13** Novak also contends that only his claims against Tucows are subject to dismissal pursuant to the forum-selection clause, and thus the case would be severed upon granting a motion to dismiss on this basis. However, this Court has discretion to dismiss the entire lawsuit for improper venue. While it serves only as persuasive authority, this Court finds it notable that the "Third, Seventh and Ninth Circuits have determined that, in certain circumstances, a non-signatory to a contract may be bound by a forum-selection clause found therein." *Hay Acquisition Co., I, Inc. v. Schneider,* No. 04-CV-1236, 2005 U.S. Dist. LEXIS 24490, at *25 (E.D.Pa. Apr. 29, 2005) (collecting cases). Further, at least two courts within this Circuit have held that "[i]t is well established that a 'range of transaction participants, parties and non-parties, should benefit from and be subject to forum selection clauses.' " *Weingrad,* 2005 U.S. Dist. LEXIS 26952, at *15-16 (quoting *Int'l Private Satellite Partners, L.P. v. Lucky Cat Ltd.,* 975 F.Supp. 483, 485-86 (W.D.N.Y.1997) (internal citation omitted)). A non-party to an agreement may be bound by a forum selection clause where the party is " 'closely related' to the dispute such that it becomes 'forseeable' that it will be bound." *Hugel v. Corp. of Lloyd's,* 999 F.2d 206, 209 (7th Cir.1993) (citing *Manetti-Farrow, Inc. v. Gucci Am., Inc.,* 858 F.2d 509, 514 n. 5 (9th Cir.1988), and *Coastal Steel Corp. v. Tilghman Wheelabrator, Ltd.,* 709 F.2d 190, 203 (3d Cir.1983)); *see also Weingrad,* 2005 U.S. Dist. LEXIS 26952, at *15-16 ("A non-party is 'closely related' to a dispute if its interests are 'completely derivative' of and 'directly related to, if not predicated upon' the signatory party's interests or conduct.") (quoting *Lipcon v. Underwriters at Lloyd's,* 148 F.3d 1285, 1299 (11th Cir.1998) (internal citation omitted)). In this instance, plaintiff's claims against Nitin are nearly identical to those against Tucows. Furthermore, all of plaintiff's claims arise out of Novak's single transfer of his domain name, which was effected through both defendants in tandem. It was certainly foreseeable that any claims Novak might raise against Nitin in relation to the transfer could be subject to the terms contained in his agreement with Tucows.[FN11] Novak's attempt to evade the effect of the forum-selection clause merely by joining Nitin, a non-signatory to the DNTA, therefore fails. *See, e.g., Hodgson v. Gilmartin,* No. 06-CV-1944, 2006 U.S. Dist. LEXIS 73063, at *45 n. 14 (E.D.Pa. Sept. 18, 2006) ("Plaintiff should ... be prevented from avoiding the impact of a valid forum selection clause by suing [parties] who were not signatories to the Customer Agreement."); *Am. Patriot Ins. Agency, Inc. v. Mutual Risk Mgt., Ltd.,* 248 F.Supp.2d 779, 785 (N.D.Ill.2003) ("[W]e also reject Plaintiffs' argument that enforcement of the forum selection clause is precluded by the fact that certain Defendants are not parties to the Agreement. Plaintiffs cannot escape their contractual obligations simply by joining parties who did not sign the contract and then claiming that the forum selection clause does not apply.") (citations omitted), *rev'd on other grounds,* 364 F.3d 884, 889 (7th Cir.2004).

FN11. Moreover, as a third-party beneficiary of the DNTA, Nitin is, "by definition," "closely related" to the dispute at issue and "forseeably" bound by the forum-selection clause. *Hugel,* 999 F.2d at 209-10 n. 7 ("While it may be true that third-party beneficiaries of a contract would, by definition, satisfy the 'closely related' and 'foreseeability' requirements, *see e.g., Coastal Steel,* 709 F.2d at 203 (refusing to absolve a third-party beneficiary from the strictures of a forum selection clause which was foreseeable); *Clinton v. Janger,* 583 F.Supp. 284, 290 (N.D.Ill.1984), a third-party beneficiary status is not re-

© 2009 Thomson Reuters. No Claim to Orig. US Gov. Works.

quired."); *see also* Defs.' Ex. T1, at ¶ 1 ("'Services' refers to the domain name registration provided by us as offered through ... the Registration Service Provider [Reseller]"); Defs' Ex. T1, at ¶ 3 ("As consideration for the Services, you agree to pay the RSP the applicable service(s) fees.").

***14** In sum, the Court finds that plaintiff has not demonstrated that enforcement of the forum-selection clause in this case would be unjust or unreasonable. Therefore, the Court finds that plaintiff has failed to demonstrate venue by a preponderance of the evidence, and grants defendants' motion to dismiss for improper venue.[FN12]

FN12. Even if the burden to prove venue rested with defendants, rather than plaintiff, that burden would be easily met given the record in this case.

VI. LANHAM ACT CLAIMS AND PENDENT STATE CLAIMS

Defendants also contend that plaintiff's Lanham Act claims of trademark infringement, trademark dilution and cybersquatting are fatally defective since it cannot be shown that Nitin or Tucows used Novak's alleged trademark, "petswarehouse," "in commerce." According to defendants, because use of "petswarehouse" "in commerce" is a required element of any potential claim that Novak could assert under the Lanham Act, such claims must be dismissed pursuant to Fed.R.Civ.P. 12(b)(6). (Nitin's Br., at 1-4 (citing *Savin Corp. v. Savin Group,* 391 F.3d 439 (2d Cir.2004) (requiring "commercial use of the mark in commerce" to establish a trademark dilution claim)); Tucows' Br., at 11-15 (citing *Bosley Medical Institute v. Kremer,* 403 F.3d 672, 678-79 (9th Cir.2005) (use of domain name incorporating plaintiff's mark in website critical of plaintiff does not constitute use in commerce), *Lockheed Martin Corp. v. Network Solutions, Inc.,* 194 F.3d 980, 984-85 (9th Cir.1999) (registrar not liable for contributory infringement by issuing registration of potentially infringing domain names to third parties), and 15 U.S.C. § 1125(d) (requiring "bad faith intent to profit" from a mark to establish civil liability for cybersquatting under the Lanham Act).) Having concluded that venue is improper before this Court, the Court need not address defendants' motion to dismiss the Lanham Act claims or pendent state claims for failure to state a cause of action.

VII. CONCLUSION

For the foregoing reasons, it is hereby ordered that plaintiff's motion to strike is GRANTED in part and DENIED in part. Defendant Tucows' motion to strike is GRANTED.

It is further ordered that both defendants' motions to dismiss on the basis of improper venue are GRANTED in their entirety.

SO ORDERED.

E.D.N.Y.,2007.
Novak v. Tucows, Inc.
Not Reported in F.Supp.2d, 2007 WL 922306 (E.D.N.Y.), 73 Fed. R. Evid. Serv. 331

END OF DOCUMENT

© 2009 Thomson Reuters. No Claim to Orig. US Gov. Works.

H

This case was not selected for publication in the Federal Reporter.

United States Court of Appeals,
Second Circuit.
Robert **NOVAK**, doing business as PetsWarehouse.com, Plaintiff-Appellant,
v.
TUCOWS INC., OpenSRS, and Nitin Networks Inc., Defendants-Appellees.FN**

FN** The Clerk of Court is directed to amend the official caption in this case to conform to the listing of the parties above.

No. 07-2211-cv.

May 6, 2009.

Background: Domain name registrant filed action against transferee alleging that transfer of "petswarehouse.com" domain name diluted that trademark. The United States District Court for the Eastern District of New York, Joseph Frank Bianco , J., 2007 WL 922306, dismissed on basis of improper venue. Registrant appealed.

Holdings: The Court of Appeals held that:
(1) affidavits that had been executed in Canada were admissible into evidence and
(2) forum selection clause was enforceable.

Affirmed.

West Headnotes

[1] Federal Courts 170B ⚷96

170B Federal Courts
170BII Venue
170BII(A) In General
170Bk96 k. Affidavits and Other Evidence. Most Cited Cases
Affidavits that had been executed in Canada were admissible into evidence on motion to dismiss on basis of improper venue in action brought by domain name registrant against transferee alleging that transfer of "petswarehouse.com" domain name diluted that trademark. Fed.Rules Civ.Proc.Rule 12(b)(3), 28 U.S.C.A.

[2] Contracts 95 ⚷127(4)

95 Contracts
95I Requisites and Validity
95I(F) Legality of Object and of Consideration
95k127 Ousting Jurisdiction or Limiting Powers of Court
95k127(4) k. Agreement as to Place of Bringing Suit; Forum Selection Clauses. Most Cited Cases
Forum selection clause was enforceable that reasonably had been communicated to party, required parties to bring dispute to designated forum, and applied to claims at issue in action brought by domain name registrant against transferee alleging that transfer of "petswarehouse.com" domain name diluted that trademark, where presumption of enforceability had not been rebutted.

Trademarks 382T ⚷1800

382T Trademarks
382TXI Trademarks and Trade Names Adjudicated
382Tk1800 k. Alphabetical Listing. Most Cited Cases
petswarehouse.com.

***204** Appeal from a judgment of the United States District Court for the Eastern District of New York (Joseph Frank Bianco, Judge).
UPON CONSIDERATION WHEREOF, IT IS HEREBY ORDERED, ADJUDGED, AND DECREED that the judgment of the District Court is **AFFIRMED.**Robert Novak, pro se, Copiague, NY.

John D'Ercole (Gary Adelman, of counsel), Robin-

© 2009 Thomson Reuters. No Claim to Orig. US Gov. Works.

son Brog Leinwand Greene Genovese & Gluck P.C., New York, NY, for Defendant-Appellee Nitin Networks Inc.

Glenn Mitchell, Mount Vernon, NY, for Defendants-Appellees Tucows Inc. and OpenSRS.

PRESENT: WILFRED FEINBERG, JOSÉ A. CABRANES, Circuit Judges, J. GARVAN MURTHA, District Judge.[FN*]

FN* The Honorable J. Garvan Murtha, of the United States District Court for the District of Vermont, sitting by designation.

SUMMARY ORDER

1 Plaintiff Robert Novak appeals *pro se* from a March 26, 2007 judgment entered in the United States District Court for the ***205 Eastern District of New York, which granted the motion to dismiss pursuant to Federal Rule of Civil Procedure 12(b)(3) of defendants Tucows Inc., OpenSRS, and Nitin Networks Inc. (collectively "defendants"), *see Novak v. Tucows, Inc.*, No. 06-1909, 2007 WL 922306 (E.D.N.Y. Mar.26, 2007). Novak appeals as well from the District Court's April 20, 2007 Order, which denied his motion for reconsideration. We assume the parties' familiarity with the factual and procedural history of the case, though we revisit key portions of that history here.

In November 1997, Novak obtained the internet domain name "petswarehouse.com" through an internet domain name registration company. In July 2001, Novak trademarked his domain name. In February 2003, a default judgment was obtained against Novak in an Alabama state court in an unrelated action, in the amount of $50,000. It appears that in an effort to affect the venue of future litigation, Novak, who is a New York resident, transferred his domain name from the original registration company, which is based in Maryland, to Nitin Networks Inc. ("Nitin"), which is based in New York. Soon after, Nitin transferred the domain name to Tucows Inc. ("Tucows"), a Canadian-based company. In May 2003, the Alabama trial court issued a writ of execution, which required Tucows to suspend its domain name hosting of "petswarehouse.com" and to turn over the name to the local sheriff's department for public auction, to be used to pay the default judgment. Tucows complied with the court order. Novak challenged the trial court's decision and, in April 2004, the Alabama Court of Civil Appeals reversed the default judgment and the writ of execution. In October 2004, Tucows returned the domain name to Novak.

In April 2006, Novak filed a complaint against defendants in the instant action, alleging that the transfer of "petswarehouse.com" out of his control between May 2003 and October 2004 harmed his business. Specifically, he alleged that the transfer diluted the "petswarehouse.com" trademark in violation of 15 U.S.C. § 1125(c) of the Lanham Act, and that the transfer deceptively and misleadingly represented defendants' association with the domain name, which constituted unfair competition and cyberpiracy under 15 U.S.C. §§ 1114, 1117 & 1125(a).[FN1] In July 2006, defendants separately moved to dismiss the complaint on the basis of improper venue in light of a forum selection clause in their contract (which dictated that the appropriate forum would be Ontario, Canada). Novak then cross-moved to strike the declarations and exhibits submitted by defendants in support of their motion to dismiss, and Tucows moved to strike some of Novak's exhibits.

FN1. The complaint also raised pendent state law claims-including conversion, negligence, bailee breach of duty, bailee breach of trust, negligent misrepresentation, breach of contract, tortious interference, and intentional infliction of emotional distress-which we need not address.

**2 On March 26, 2007, the District Court issued a

© 2009 Thomson Reuters. No Claim to Orig. US Gov. Works.

Memorandum and Order, in which it granted in part and denied in part Novak's motion to strike, granted Tucows' motion to strike, and granted defendants' motions to dismiss on the basis of improper venue. *See Novak,* 2007 WL 922306. Specifically, the District Court found that the forum selection clause was fully enforceable, and that Novak had failed to demonstrate venue in the Eastern District of New York by a preponderance of the evidence, thereby warranting the dismissal of his complaint. *Id.* On April 5, 2007, Novak filed a motion for reconsideration ***206** under Federal Rule of Civil Procedure 59(e), which the District Court denied in an Order of April 20, 2007. Novak filed a timely appeal.

[1] Before this Court, Novak principally argues that the District Court erred in (1) admitting into evidence the defendants' affidavits, which were executed in Canada; (2) denying the admission of his exhibits, which were printouts from various internet pages; (3) finding that he had assented to the forum selection clause; (4) determining that the forum selection clause was enforceable; and (5) denying his motion for reconsideration. We consider each argument in turn.

Beginning with Novak's arguments concerning the District Court's evidentiary rulings, we note that "[w]e review a district court's evidentiary rulings for abuse of discretion, reversing only when (1) the district court's decision rests on an error of law (such as application of the wrong legal principle) or a clearly erroneous factual finding, or (2) its decision-though not necessarily the product of a legal error or a clearly erroneous factual finding-cannot be located within the range of permissible decisions." *In re Terrorist Bombings of U.S. Embassies in East Africa,* 552 F.3d 93, 135 (2d Cir.2008) (internal quotation marks omitted). Upon a review of the record, we conclude that the District Court did not err, much less abuse its discretion, in admitting into evidence certain of defendants' affidavits, and in denying the admission of certain of Novak's exhibits. Accordingly, we reject Novak's first two arguments.

[2] Regarding Novak's arguments concerning the forum selection clause, we note that "[w]here the district court has relied on pleadings and affidavits to grant a Rule 12(b)(3) motion to dismiss on the basis of a forum selection clause, our review is *de novo.*" *Phillips v. Audio Active Ltd.,* 494 F.3d 378, 384 (2d Cir.2007). "Determining whether to dismiss a claim based on a forum selection clause involves a four-part analysis" which includes determining first "whether the clause was reasonably communicated to the party resisting enforcement"; second, "whether the parties are required to bring any dispute to the designated forum"; and third, "whether the claims and parties involved in the suit are subject to the forum selection clause." *Id.* at 383 (internal citations omitted). If the first three inquires are answered affirmatively, then the forum clause is presumptively enforceable. *Id.* "The fourth, and final, step is to ascertain whether the resisting party has rebutted the presumption of enforceability by making a sufficiently strong showing that enforcement would be unreasonable or unjust, or that the clause was invalid for such reasons as fraud or overreaching." *Id.* (internal citations and quotation marks omitted). For substantially the reasons stated in the District Court's careful and thorough Memorandum and Order of March 26, 2007, *see Novak,* 2007 WL 922306, we conclude that the clause (1) was reasonably communicated to Novak, (2) required the parties to bring a dispute to the designated forum, and (3) applied to the claims at issue in the present litigation, and that (4) Novak failed to rebut the presumption of enforceability. Accordingly, we find Novak's arguments to be without merit.

****3** With respect to Novak's motion for reconsideration, we note that we review a District Court's ruling on a Rule 59(e) motion for abuse of discretion. *See Gordon v. Matthew Bender & Co., Inc.,* 186 F.3d 183, 185 (2d Cir.1999). Because we conclude that the District Court properly dismissed Novak's claims for improper venue, we also conclude that the District Court did not err in denying Novak's motion for reconsideration.

© 2009 Thomson Reuters. No Claim to Orig. US Gov. Works.

***207** Finally, we note that we have considered all of Novak's remaining claims and have determined that they are also without merit.

CONCLUSION

For the reasons stated above, the judgment of the District Court is **AFFIRMED.**

C.A.2 (N.Y.),2009.
Novak v. Tucows, Inc.
330 Fed.Appx. 204, 2009 WL 1262947 (C.A.2 (N.Y.))

END OF DOCUMENT

© 2009 Thomson Reuters. No Claim to Orig. US Gov. Works.

In re Tires, Tires, Tires, Inc. ., Serial No. 77/091,459
(TTAB Nov. 4, 2009)

Hearing:
August 5, 2009

THIS OPINION IS A PRECEDENT OF THE T.T.A.B.

Mailed:
November 4, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Tires, Tires, Tires, Inc.

Serial No. 77091459

Janet E. Phipps Burkhead of McKee, Voorhees & Sease, P.L.C. for Tires, Tires, Tires, Inc.

Timothy J. Finnegan, Trademark Examining Attorney, Law Office 104 (Chris Doninger, Managing Attorney).

Before Rogers, Drost and Zervas, Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Tires, Tires, Tires, Inc. has applied to register the designation TIRES TIRES TIRES (in standard character form) for services identified as "retail tire store[s]" in International Class 35.[1]

Registration was first refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis

---

[1] Application Serial No. 77091459, filed January 25, 2007, claiming first use anywhere and first use in commerce on October 28, 1986.

that applicant's proposed mark is merely descriptive of applicant's services. In its response to the initial Office action, applicant amended its application to seek registration under the provisions of Trademark Act § 2(f), 15 U.S.C. § 1052(f), and submitted a declaration attesting to use of its proposed mark in commerce for at least the five years immediately before the date of the declaration. The examining attorney was not persuaded by applicant's showing of acquired distinctiveness, even when applicant supplemented its initial showing based on the declaration, eventually finding TIRES TIRES TIRES generic and incapable of serving as a source-identifier. In his final Office action, the examining attorney refused registration under Section 2(e)(1) maintaining either (a) TIRES TIRES TIRES is generic,[2] or (b) TIRES TIRES TIRES is merely descriptive and applicant's Section 2(f) showing is insufficient.

Applicant has appealed the examining attorney's final refusal to the Board. Both applicant and the examining attorney have filed briefs and the Board conducted a hearing on August 5, 2009. We affirm the refusal to register on both grounds.

---

[2] Even though the refusal is under Section 2(e)(1), genericness is an issue in this case because applicant has amended its application to seek registration under Section 2(f) and the examining attorney has raised the issue of genericness. See TMEP § 1209.02.

Genericness

The Court of Appeals for the Federal Circuit, our primary reviewing court, has stated that "[t]he critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question." *H. Marvin Ginn Corp. v. Int'l Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). *Ginn* explains that:

> Determining whether a mark is generic … involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?

Id. In an appeal, the Office bears the burden of establishing genericness based on clear evidence of generic use. *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999).

Genus of applicant's services

Applicant's services are identified as "retail tire stores." We accept this identification as identifying the genus of services, which is the genus advocated by applicant. See brief pp. 5 - 6.

The relevant public for applicant's services

The specimen of use states "YOUR FAMILY CAR CARE CENTER." (Underlining and capitalization in original.) The services are suited to the public at large. We therefore conclude that the relevant public for applicant's services is substantially composed of members of the general public who own vehicles.

The meaning of TIRES TIRES TIRES to the relevant public

We now consider whether members of the relevant public would understand TIRES TIRES TIRES to refer to the genus of the services. *Marvin Ginn*, 228 USPQ at 530. Evidence of the relevant public's understanding of a term may be obtained from any competent source including consumer surveys, dictionary definitions, newspapers and other publications. See *In re Reed Elsevier Properties Inc.*, 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007). We have considered, as we must, all the evidence of record including the evidence applicant has submitted in support of its claim of acquired distinctiveness. See *In re Recorded Books Inc.*, 42 USPQ2d 1275 (TTAB 1997).

One preliminary issue raised by applicant, however, warrants our consideration. Applicant maintains that TIRES TIRES TIRES is a unitary phrase and that the examining attorney must provide evidence of use of TIRES TIRES TIRES

as a whole. Applicant cites to *American Fertility* where the Federal Circuit stated that in the context of a mark consisting of a phrase, "[t]he Board must … apply the *Marvin Ginn* test to the phrase as a whole, and not focus only on the individual terms." *American Fertility*, 51 USPQ2d at 1837. As further explained in *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001):

> [W]here the proposed mark is a phrase (such as "Society for Reproductive Medicine"), the board "cannot simply cite definitions and generic uses of the constituent terms of a mark"; it must conduct an inquiry into "the meaning of the disputed phrase as a whole."

Thus, says applicant, because the examining attorney has only offered web pages showing use of the singular term "tires," and evidence that words considered individually may be generic is not sufficient to prove that a phrase is generic, the examining attorney has not demonstrated that the phrase "tires tires tires" has been used in a generic sense.

The examining attorney disagrees and maintains that the Office's burden is only to demonstrate that "tires" is generic for applicant's services. According to the examining attorney, the "repetition of a merely descriptive or generic word does not negate the mere descriptiveness of

the mark as a whole." Brief at unnumbered pp. 4 - 5. The examining attorney cites to two Board decisions which found that repeated wording is unregistrable as a whole under Section 2(e)(1). One decision is *In re Litehouse Inc.*, 82 USPQ2d 1471 (TTAB 2007), where the Board found CAESAR!CAESAR! for salad dressing not unitary, and stated that "neither the mere repetition of the word CAESAR in applicant's mark, nor the presence of the exclamation points in the mark, nor both of these features combined, suffices to negate the mere descriptiveness of the mark as a whole as applied to salad dressings." *Id.* at 1474. The other decision is *In re Disc Jockeys, Inc.*, 23 USPQ2d 1715 (TTAB 1992), where the Board found DJDJ to be merely descriptive of disc jockey services, and explained that "the combinations of these words [DJ] would not, simply because of their repetition, be rendered something more than descriptive." *Id.* at 1716. The Board noted that "[n]othing new or different is imparted by the simple repetition of the descriptive expression DJ"; and commented that:

> There is nothing in the composite which changes the meaning of the letters in any manner which would give them a different meaning. If one were to express the view that milk was "creamy creamy" or that a red bicycle was "red red" or that a razor was "sharp sharp," the repetition of the words "creamy," "red" and "sharp" would be

> understood as emphasis and the combinations of these words would not, simply because of their repetition, be rendered something more than descriptive.

Id.

We too disagree with applicant's argument that the examining attorney must establish that TIRES TIRES TIRES per se has been used by others in order to find the designation generic. Applicant's argument implies that a generic term would be rendered non-generic simply by repeating the term. There is no valid reason to require an examining attorney to demonstrate that a designation composed solely of a repeating word has been used by others, when the examining attorney has demonstrated that the repeated term is generic and that the repetition does not result in a designation with a different meaning. Here, "tires" and "tires tires tires" have the same meaning. So does "tires tires" as well as "tires tires tires tires." There is no "additional meaning" in "tires tires tires" that separates the designation from "tires" or even other designations solely comprising a repetition of "tires." See *American Fertility*, 51 USPQ2d at 1837 ("[t]he PTO here failed to provide any evidence that the phrase as a whole, SOCIETY FOR REPRODUCTIVE MEDICINE, has acquired no additional meaning to the relevant public than the terms

'society' and 'reproductive medicine' have individually.") Additionally, the Board has already made clear in *In re Litehouse* and *In re Disc Jockeys* that the simple repetition of a merely descriptive term does not imbue the composite with the distinctiveness of a mark. Further, Professor J. Thomas McCarthy, in his treatise, has considered the issue we now face:

> ***Repetition of a Generic Term.*** Repeating a generic name does not turn an otherwise invalid designation into a protectable trademark. The Trademark Board observed: "It is settled that a mark's mere repetition of a merely descriptive word does not negate the mere descriptiveness of the marks as a whole." The same principle should apply to a generic name. For example, merely repeating a generic name such as CHAIRS! CHAIRS! CHAIRS! in connection with the sale of chairs will not create a protectable mark.

McCarthy on Trademarks and Unfair Competition, § 12:39 (4th ed. updated September 2009). Professor McCarthy's CHAIRS! CHAIRS! CHAIRS! example addresses the same issue raised in this case, the repetition of a term for retail sales of goods identified by that term. Finally, the composition of TIRES TIRES TIRES, through its repetition of a single word, is different from the composition of other marks which have been found to be "phrases." See, e.g., *In re Active Ankle Systems Inc.*, 83 USPQ2d 1532, 1534 (TTAB 2007) ("DORSAL NIGHT SPLINT is a phrase. … In the present case, 'dorsal,' 'night,' and 'splint' are multiple words joined together as

a phrase."); *In re Outdoor Recreation Group*, 81 USPQ2d 1392, 1397 (TTAB 2006) ("OUTDOOR PRODUCTS is somewhat more analogous to the phrase considered by the court in *American Fertility*"); and *In re Rodale Inc.*, 80 USPQ2d 1696 (TTAB 2006) (NUTRITION BULLETIN is a phrase). The number of terms in the designation does not determine whether the designation constitutes a unitary phrase or merely a repeating word, for, as shown above, even two words have been held to constitute a unitary phrase. Rather, the critical factor is that the two or more words serve to modify each other and enhance the meaning of the composite, which is something that does not occur merely by repeating a word.

With the foregoing in mind, we consider whether the examining attorney has established that "tires" is generic for the retail sale of tires.

The examining attorney has made of record a definition of "tire" taken from the *Encarta* online dictionary, namely, a "rubber edging for wheel: a hollow band of rubber, often reinforced with fibers of other material, fitted around the outer edge of a vehicle's wheel and filled with compressed air." Such items are the subject of applicant's retail store services, and are featured in applicant's yellow pages advertisement for its retail tire services submitted

as a specimen of use. The advertisement states, "When we need tires we just look for the huge tire man," "Siouxland's #1 Tire & Auto Repair Center" and "FREE ALIGNMENT with every 4 tires purchased," and appears under the heading "Tire Dealers."

Further, the examining attorney has submitted webpages from retail tire stores showing the following uses of "tires" by other retailers of tires. See, for example:

tiresplus.com - stating "Shop for Tires" and "The online place to shop for tires";

1010tires.com - stating "buy tires" and including a link to "tires" as a product category;

toyo.com - stating "tire basics," "tire recommender" and "tire registration," and depicting tires;

merchantstire.com - including a link to "tires" as a product category;

tiresunlimited.com - stating "We specialize in many types of tires, including Motorcycle tires, ATV tires, and Specialty Tires" and "Just enter the weight of the tires you plan on ordering";

tirerack.com - listing "tires" as a product category and identifying as links "tires by size" and "Tires by Brand";

kauffmantire.com - including a link to "tires" as a product category and stating "Search for your tires on the left," "Reserve your tires & schedule your appointment" and "Search Tires for Vehicle";

vulcantire.com - including a link to "search tires" and including "tires" as a product category; and

> parishtire.com - stating "In 1946, J.H. Parish founded Parish Tire Company as a one location retail and commercial tire store in Winston Salem N.C."

The record also includes other advertisements under the caption "Tire Dealers" adjacent to applicant's yellow pages advertisement that use the word "tire" or "tires" to identify the items the advertisers sell. See (a) Ben Fish Tire Co., offering "New & Used Tires & Wheels Special Order High Performance Tires" and "Great Deals on Tires & Wheels"; and (b) Fremont Tire Inc., offering "24 Hour Truck Tire Service." Evidence of competitors' use of a term as the name of their goods and services is persuasive evidence that the relevant consumers perceive the term as generic. *Continental Airlines Inc. v. United Airlines Inc.*, 53 USPQ2d 1385 (TTAB 1999).

Because the term "tires" identifies a key aspect of applicant's services, i.e., the goods sold in applicant's retail store, and the recitation of services specifically uses the term "tires" to name the subject matter of applicant's retail services, the term is generic for the retail sales of tires. A term that names the central focus or subject matter of the services is generic for the services themselves. *See In re Candy Bouquet International, Inc.*, 73 USPQ2d 1883 (TTAB 2004) (because

CANDY BOUQUET is generic for gift packages of candy, it also is generic for applicant's retail, mail and computer ordering services therefor); *In re A La Vielle Russie, Inc.*, 60 USPQ2d 1895 (TTAB 2001) (RUSSIANART generic for particular field or type of art and also for dealership services directed to that field); *In re Log Cabin Homes Ltd.*, 52 USPQ2d 1206 (TTAB 1999) (LOG CABIN HOMES generic for type of building and also for architectural design services directed to that type of building and for retail outlets featuring kits for construction of that type building); *In re Web Communications*, 49 USPQ2d 1478 (TTAB 1998) (WEB COMMUNICATIONS generic for publication and communication via the World Wide Web, and also for consulting services directed to assisting customers in setting up their own Web sites for such publication and communication); and *In re Harcourt Brace Jovanovich, Inc.*, 222 USPQ 820 (TTAB 1984) (LAW & BUSINESS incapable of distinguishing applicant's services of arranging and conducting seminars in the field of business law). Also, because "tires" is generic for retail sales of tires, and because TIRES has the same meaning as TIRES TIRES TIRES, we find that the examining attorney has met his substantial burden of establishing that TIRES TIRES TIRES is generic

for, and hence incapable of identifying and distinguishing the source of, the identified services.

Descriptiveness and Acquired Distinctiveness

Although we have concluded on the record before us, that TIRES TIRES TIRES is generic for applicant services, should this conclusion be found in error in any appeal that may follow, we now consider whether applicant's proffered evidence of acquired distinctiveness is sufficient to support registration under Section 2(f).[3]

It is applicant's burden to establish a prima facie case of acquired distinctiveness. See *Yamaha International Corp. v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988). In determining whether secondary meaning has been acquired, the Board may examine copying, advertising expenditures, sales success, length and exclusivity of use, unsolicited media coverage, and consumer studies (linking the name to a source). *Cicena Ltd. v. Columbia Telecomms Group*, 900 F.2d 1546, 14 USPQ2d 1401 (Fed. Cir. 1990). On this list, no single factor is determinative. The amount and character of evidence required to establish acquired distinctiveness depends on

[3] "[B]y seeking registration under Section 2(f), applicant has conceded lack of inherent distinctiveness and must prove acquired distinctiveness." *In re MGA Entertainment, Inc.*, 84 USPQ2d 1743, 1747 (TTAB 2007).

the facts of each case and particularly on the nature of the mark sought to be registered. *See Roux Laboratories, Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34 (CCPA 1970); *In re Hehr Mfg. Co.*, 279 F.2d 526, 126 USPQ 381 (CCPA 1960); and *In re Gammon Reel, Inc.*, 227 USPQ 729 (TTAB 1985). Typically, more evidence is required where a mark is so highly descriptive that purchasers seeing the matter in relation to the named goods or services would be unlikely to believe that it indicates source in any one entity. *See, e.g., In re Bongrain Int'l Corp.*, 894 F.2d 1316, 13 USPQ2d 1727, 1727 n. 4 (Fed. Cir. 1990), citing *Yamaha Int'l*, 6 USPQ2d at 1008 ("the greater the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning").

Applicant initially claimed acquired distinctiveness based on the declaration of Daniel J. Northdurft, applicant's President, who stated that TIRES TIRES TIRES had become distinctive of the services through applicant's substantially exclusive and continuous use in commerce for at least five years; that applicant has been using "TIRES, TIRES, TIRES" in commerce for a period of over twenty years; and that consumers associate "TIRES, TIRES, TIRES"

with applicant.[4] After the examining attorney found applicant's claim insufficient to establish acquired distinctiveness, applicant supplemented its claim with three additional declarations, which state as follows in relevant part:

Supplemental Declaration of Mr. Northdurft

- Applicant's business comprises three service centers in two different cities; and

- Applicant has spent between $106,000 and $122,000 annually in 2002 - 2006, and approximately $231,000 in 2007 "promoting the trademark 'TIRES, TIRES, TIRES.'"

Declaration of Mary Ann Johnson

- Ms. Johnson is the General Sales Manager for a CBS affiliate in Sioux City, Iowa;

- Applicant "has spent over $75,000 with [two television stations] advertising its 'TIRES, TIRES, TIRES' trademark"; and

- Ms. Johnson and the public associate the designation as a symbol identifying the services of applicant.

Declaration of Dennis J. Bullock

- Mr. Bullock is the General Manager of a broadcasting company that owns and operates several radio stations in Sioux City, Iowa and the surrounding area;

- Applicant "has achieved substantial brand recognition for its business due to its

[4] Though the Northdurft declaration refers to use of TIRES, TIRES, TIRES, i.e., a designation employing commas, we accept the declaration as support for applicant's claim of acquired distinctiveness of TIRES TIRES TIRES without commas.

> substantial investment of approximately $1 million for advertising its 'TIRES, TIRES, TIRES' mark, and further due to the diverse forms of media though which the trademark is advertised, including through print, outdoor, electronic, and direct mail"; and
>
> • "the public associates 'TIRES, TIRES, TIRES' as a symbol identifying the services of [applicant] only, and not of any other company in the field."

It has long been held that the fact that an applicant has used its mark for a long time does not necessarily establish that the mark has acquired distinctiveness. *In re The Interstate Folding Box Co.*, 167 USPQ 241, 245 (TTAB 1970) ("We are not persuaded by this record that the term 'INNER-LINED' has become distinctive of applicant's goods and does in fact serve as an indication of origin for such goods. It may well be that applicant, by reason of its long and continuous use, has acquired a de facto secondary meaning in the term 'INNER-LINED' in the sense that some or even many people have come to associate 'INNER-LINED' with applicant; but this falls far short of establishing a propriety or a legal or dejure right therein necessary to support registration"). Because at best applicant's mark is highly descriptive, the facts asserted in Mr. Northdurft's original declaration are not persuasive. *In re Gray Inc.*, 3 USPQ2d 1558, 1559 (TTAB 1987) ("[T]o support registration of PROTECTIVE EQUIPMENT [for burglar

and fire alarms and burglar and fire alarm surveillance services] on the Principal Register a showing considerably stronger than a prima facie statement of five years' substantially exclusive use is required").

Even applicant's supplemental showing, combined with its original showing, does not establish the acquired distinctiveness of applicant's proposed mark. First, applicant's advertising and the fact that it now has three service centers in two different cities are not persuasive because we cannot determine from the record whether the advertising and the increase in the number of service centers have had any impact on the recognition of TIRES TIRES TIRES as a source indicator by an appreciable number of purchasers. See *In re Kwik Lok Corp.*, 217 USPQ 1245 (TTAB 1983). As the court said in *In re Andes Candies Inc.*, 478 F.2d 1264, 178 USPQ 156, 158 (CCPA 1973), "[b]ecause of long use, large sales and advertising, it may be assumed that some persons might recognize a mark as designating origin, but that alone is not enough." Second, the fact that applicant has three service centers, without any context in the trade, is not so impressive as to elevate applicant's designation to the status of a distinctive mark. *See Target Brands Inc. v. Hughes*, 85 USPQ2d 1676 (TTAB 2007). Third, Mr. Bullock does not

provide any specifics regarding applicant's advertising "through print, outdoor, electronic and direct mail," such as the quantity, frequency and scope of such advertising. Fourth, because applicant provides services other than retail tire store services, we are not able to determine from Mr. Bullock's and Ms. Johnson's general statements how much applicant has spent in advertising the specific services identified in the identification of services. (According to applicant's original specimen, applicant provides other services in addition to the retail sales of tires.) Fifth, Mr. Bullock's and Ms. Johnson's statements regarding customer recognition of the designation as the source of applicant's services are not particularly probative because they do not indicate how they know that the public associates the designation as identifying applicant's services.

Thus, even if the designation TIRES TIRES TIRES were found to be not generic, but only merely descriptive, given the highly descriptive nature of the designation TIRES TIRES TIRES, we would need substantially more evidence (especially in the form of direct evidence from customers) than what applicant has submitted in order to find that the designation has become distinctive of applicant's services. *In re Lens.com Inc.*, 83 USPQ2d 1444 (TTAB 2007).

Decision: The refusal under Section 2(e)(1) of the Trademark Act on the ground that the proposed mark is generic, and the refusal based on the examining attorney's finding that the Section 2(f) showing is insufficient, are both affirmed.