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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

STK LLC
v.
Backrack, Inc.

Cancellation No. 92049332

John M. Adams of Price Adams PC for STK LLC.

Paul J. Kennedy of Pepper Hamilton for Backrack, Inc.

Before Kuhlke, Bergsman and Kuczma, Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

STK LLC ("petitioner") filed a petition to cancel Registration No. 3014986 for the mark "BACKRACK," in standard character form, registered by Backrack, Inc. ("respondent"), for "pick-up truck racks, namely, headache racks designed to protect the cab and mount a variety of accessories, namely, light, antenna and toolbox brackets" in Class 12.¹

As grounds for cancellation, petitioner alleges that respondent's mark is generic. In support of its genericness

¹ Issued November 15, 2005; § 8 Declaration of use accepted on November 21, 2011.

claim, petitioner contends that respondent has used its mark in a generic manner in promotional materials and product installation instructions, and that third parties have used respondent's mark in a generic manner not only to refer to respondent's goods, but also to refer to similar products made by other parties.

Respondent denied the salient allegations in the petition for cancellation and the parties have submitted their respective evidence and trial briefs.

I. The Record

By rule, the record includes respondent's registration file. Trademark Rule 2.122(b), 37 CFR § 2.122(b). It also includes the petition for cancellation and respondent's answer to the petition. In addition, the parties introduced the following evidence:

A. Petitioner's evidence:

1. April 22, 2009 discovery deposition of Adrian Jayne, President of Registrant (with Exhibits) submitted pursuant to parties' Stipulation² (Docket ## 43, 44);
2. Notice of Reliance for Petitioner's Exhibit Nos. 118-125 (Docket #45) namely:

² See November 29, 2010 Board Order approving Stipulation regarding use of Jayne Discovery Deposition as testimony evidence. (Docket # 63).

a) Registrant's Objections and Answers to Petitioner's First Set of Interrogatories to Registrant dated November 6, 2008 (STK Exhibit 118) (Docket # 45);

b) Registrant's First Supplemental Objections and Answers to Petitioner's First Set of Interrogatories to Registrant dated April 17, 2009 (STK Exhibit 119) (Docket # 45);

c) Registrant's Objections and Responses to Petitioner's Second Set of Interrogatories to Registrant (along with copies of the exhibits referenced therein) dated June 4, 2009 (STK Exhibit 120) (Docket # 45);

d) Registrant's Answers to Petitioner's Requests for Admission (along with copies of the exhibits referenced therein) dated November 5, 2008 (STK Exhibit 121) (Docket ## 45-46);

e) Registrant's Responses to Petitioner's Second Set of Requests for Admissions directed to Registrant (along with copies of the exhibits referenced therein) dated June 4, 2009; (STK Exhibit 122) (Docket # 46);

f) Registrant's Amended Answers to Petitioner's Request for Admission Pursuant to Order of the Trademark Trial and Appeal Board dated February 24, 2009 and Supplemental Responses to Requests for Admission Nos. 9, 49, 92-93, 126-127, 166, 317, 332-333, 340-341, and 348-352 dated March 26, 2009 (STK Exhibit 123) (Docket # 46);

g) A copy of the definition of the word "back" from *Merriam Webster's New International Dictionary*, Second Edition, Unabridged (STK Exhibit 124) (Docket # 46); and

h) A copy of the definition of the word "rack" from *Merriam Webster's New International Dictionary*, Second Edition, Unabridged (STK Exhibit 125) (Docket # 46).

3. September 3, 2010 testimony deposition of Michael McGuire, owner of Creston Hydraulics, New Jersey (with Exhibits) (Docket # 47);

4. September 8, 2008³ testimony deposition of Paul Edward Bridges, Jr., owner of Pocono Four Wheel Drive Center, Stroud Township, Pennsylvania (with Exhibits) (Docket # 47);

5. June 23, 2010 testimony deposition of David Diassi owner of Cap Connection, Lebanon, New Jersey, (with Exhibits) (Docket ## 47-48);

6. September 10, 2010 testimony deposition of Robert Craig, owner and d/b/a Z&R Auto Salon, Middlesex, New Jersey (with Exhibits) (Docket # 49);

³ The September 8, 2008 date indicated on the title page of the Deposition of Paul Edward Bridges, Jr. submitted under Docket # 47 appears to be in error. The court reporter's Certificate at p. 57 is dated September 17, 2010, the notarized copy of the witness' Errata sheet is dated October 7, 2010, and some of the deposition Exhibits are dated after September, 2008. Accordingly, we assume that the deposition took place on September 8, 2010 during Petitioner's testimony period.

7. June 24, 2010 testimony deposition of Howard Lichtman, president of Cyclevan Unlimited Incorporated of South River, New Jersey (with Exhibits) (Docket # 49);

8. June 23, 2010 testimony deposition of Richard A. Ackley, Jr., Director of Sales and Marketing for Armor Deck, (with Exhibits) (Docket # 51);

9. June 23, 2010, testimony deposition of Kenneth C. Laube, Inside Sales Rep for Armor Deck, (with Exhibits) (Docket # 51);

10. June 23, 2010, testimony deposition of Stephen Podesta, Inside Sales Rep for Armor Deck, (with Exhibits) (Docket ## 51-52); and,

11. June 24, 2010, testimony deposition of Steve Setteducati, president of Armor Deck which owns 75% of petitioner (with Exhibits). Mr. Setteducati's deposition on June 24, 2010, was transcribed by two different court reporters utilizing the same pagination. To avoid confusion, citations to his testimony shall contain an "I" (referring to the volume of his deposition transcript commencing at 11:22 a.m.) (Docket ## 53-54) or an "II" (referring to the volume of his testimony commencing at 6:38 p.m.) (Docket # 55).

B. Respondent's evidence:

1. October 27, 2010, testimony deposition of Adrian Jayne, president of respondent (with Exhibits⁴) (Docket ## 56-58);

2. Notice of Reliance for Respondent's Exhibits A-P (Docket ## 59-62) namely:

a) Copies of internet search results for the term "Backrack" and copies of printouts from internet websites of identified "Sponsored Links" dated June 24, 2009, (Respondent's Exhibits A1 through A34) (Docket # 59);

b) Copies of articles obtained via a *LexisNexis* search for the terms "backrack" and "back rack" submitted as printed publications (Respondent's Exhibits B1 through B41) (Docket ## 59-60);

c) Copies of articles obtained via a *LexisNexis* search for the terms "headache rack" and "cab guard" submitted as printed publications (Respondent's Exhibits C1 through C38) (Docket ## 60-61);

d) Petitioner's Answers to Respondent's First Set of Interrogatories and Requests for Production of

⁴ Docket entry # 57 contains two document sets identified as Exhibit 50 (found at pages 220-237 and 255-300). Although the contents of these Exhibits differ, some of the pages are the same. However, the content of neither set fully corresponds to the identification of Exhibit 50 found at Jayne Test. Dep. p. 34.

Documents Addressed to Petitioner (Respondent's Exhibit D) (Docket # 61);

e) First Supplemental Response to Petitioner's Answers to Respondent's First Set of Interrogatories and Requests for Production of Documents Addressed to Petitioner (Respondent's Exhibit E) (Docket # 61);

f) Petitioner's Answers to Respondent's Second Set of Interrogatories and Requests for Production of Documents Addressed to Petitioner (Respondent's Exhibit F) (Docket # 61);

g) Registrant's First Set of Requests for Admission Addressed to Petitioner (including Exhibits thereto) (Respondent's Exhibit G) (Docket # 61);

h) Petitioner's Answers to Respondent's First Set of Requests for Admission Addressed to Petitioner (without Exhibits) (Respondent's Exhibit H) (Docket ## 61, 62);

i) Second Supplemental Response to Petitioner's Answers to Respondent's First Set of Interrogatories and Requests for Production of Documents Addressed to Petitioner (Respondent's Exhibit I) (Docket # 62);

j) Copies of TARR printouts and associated certificates of registration and application for BACKRACK or BACK RACK marks (Respondent's Exhibits J1 through J4) (Docket # 62):

J1. Registration No. 3285848 for BACKRACK,
J2. Serial No. 78015866 for BACKRACK
(abandoned),
J3. Registration No. 2307561 (cancelled),
J4. Registration No. 2082364 for BACK RACK
(cancelled);

k) Copies of communications relating to cease and
desist letter concerning topautoteam.com produced by
petitioner under document production numbers 00366-
00375 (Respondent's Exhibit K) (Docket # 62);⁵

l) Copies of webpages from third-party websites
produced by respondent under document production
numbers BR00811-BR00825⁶ (Respondent's Exhibit L)
(Docket # 62);

⁵ It is well settled that a party that has received documents produced by another party in response to a request for production of documents may not make such documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under Trademark Rule 2.122(e); 37 C.F.R. § 2.122(e). The foregoing documents do not fall within the category of printed publications as contemplated under Rule 2.122(e). However, because petitioner did not object to the submission of these documents, the Board may consider the documents. See, TBMP § 704.11 (3rd ed. 2011); also see, *Jeanne-Marc, Inc. v. Cluett, Peabody & Co., Inc.*, 221 USPQ 58, 59 (TTAB 1984); *Autac Incorporated v. Viking Industries, Inc.*, 199 USPQ 367, 369, n.2 (TTAB 1978) (neither party objected to other's offering of Fed. R. Civ. P. 34 documents via notice of reliance).

⁶ Pursuant to Rule 2.122(e), 37 CFR § 2.122(e), only document numbers BR00811-BR00825 are admissible as internet evidence. Document number BR00826 was produced by respondent and is not admissible under Rule 2.122 or as internet evidence under *Safer Inc. v. OMS Investments Inc.*, 94 USPQ 1031, 1039 (TTAB 2010) and therefore, must be introduced via witness testimony. See TBMP §§ 704.02, 704.08(b) and 704.11 (3rd edition).

m) Copies of webpages from third-party websites produced by respondent under document production numbers BR00529-BR00535 (Respondent's Exhibit M) (Docket # 62);

n) Copies of webpages from whoisdomaintools.com produced by Respondent under document production numbers BR00703-BR00712 (Respondent's Exhibit N) (Docket # 62); and,

o) Copies of webpages from third party websites dated October 26, November 10 and November 11, 2010 (Respondent's Exhibit O) (Docket # 62); (Exhibit O1 bears document production numbers BR00804-BR00810 and is also marked as Backrack Deposition Exhibit 139);

p) Copy of parties' Stipulation for the Introduction of Evidence regarding discovery deposition of Respondent's president, Adrian Jayne⁷ (Respondent's Exhibit P) (Docket # 62);

3. Depositions of Adrian Jayne, Steve Setteducati, Richard Ackley, Kenneth Laube, Stephen Podesta, Michael McGuire, Paul Bridges, David Diassi⁸ and Howard Lichtman (copies of these deposition were

⁷ See footnote 2, *supra*.

⁸ The list of testimonial depositions on which Respondent intends to rely identified two depositions of David Diassi, see Docket # 59, p. 13. However, only one deposition of Mr. Diassi has been filed and accordingly, we assume that the second reference to his deposition is duplicative.

filed by petitioner and are located at the Docket numbers indicated above).

II. Standing

The party seeking cancellation must prove two elements: (1) that it has standing; and (2) that there are valid grounds for canceling the registration. *See International Order of Job's Daughters v. Lindeburg & Co.*, 727 F.2d 1087, 1091, 220 USPQ 1017, 1019 (Fed. Cir. 1984). To establish standing, petitioner must show both "a real interest" in the proceedings as well as a "reasonable" basis for its belief of damage. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025, 1027 (Fed. Cir. 1999).

Here, the parties are direct competitors in the sale of aftermarket automotive accessories namely, racks for pickup trucks.⁹ Accordingly, petitioner has a "real interest" in this proceeding seeking to cancel respondent's registration covering such products. *See DeWalt, Inc. v. Magna Power Tool Corp.*, 289 F.2d 656, 129 USPQ 275, 280 (CCPA 1961) (damage presumed when mark sought to be registered is descriptive of the goods and opposer has a sufficient interest in using the descriptive term); *Stuart Spector Designs Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 1553 (TTAB 2009) (competitors have standing to oppose

⁹ See Jayne Test. Dep. pp. 14, 68-69, 172 (Docket # 56); Lichtman Dep. p. 66 (Docket # 49); and Setteducati Dep. II pp. 30-31, 35 (Docket # 55).

registration based on alleged genericness and lack of distinctiveness of product configuration); *Plyboo America Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633, 1634 (TTAB 1999) (direct competitor has standing to oppose).

III. Whether respondent's BACKRACK mark is generic?

The sole issue to be determined is whether respondent's BACKRACK mark is generic, i.e., a common name that the relevant purchasing public understands primarily as describing the genus of goods or services being sold. See *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987). Such terms are incapable of indicating a particular source of the goods or services, and cannot be registered as trademarks; doing so "would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are." *Merrill Lynch*, 4 USPQ2d at 1142 citing to *CES Publishing Corp. v. St. Regis Publications, Inc.*, 531 F.2d 11, 188 USPQ 612, 615 (2d Cir. 1975).

The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question. *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). 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? *Ginn*, 228 USPQ at 530.

A. Definition of the Genus

The Lanham Act permits cancellation when a "registered mark becomes the generic name for the goods or services . . . for which it is registered" 15 U.S.C. § 1064(3). Thus, the necessary inquiry focuses on the description of goods set forth in the certificate of registration. *Magic Wand, Inc. v. RDB, Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991); and *Octocom Systems, Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

In view of the foregoing, we first examine the identification of goods in respondent's Registration which covers:

pick-up truck racks, namely, headache racks designed to protect the cab and mount a variety of accessories, namely, light, antenna and toolbox brackets.

A "headache rack" is an accessory for pickup trucks that protects the rear window of the cab. The headache rack is located on the front of the truck bed behind the cab. Most commonly, the rack has vertical and horizontal bars with the vertical bars being mounted on the floor of the truck bed and extending upwards. The bars protect the cab window by

preventing anything in the truck bed from lunging forward to break through the window. Some versions of the rack contain a wire mesh that performs the same function of protecting the rear window.¹⁰ Certain accessories such as lights, antennas and toolbox brackets can be attached to the headache racks.¹¹

Respondent's products, as well as competitive products, have been listed in distributors' catalogs under the headings "multi-purpose headache racks";¹² and "headache racks" (with no listing in the catalog indices for "back racks").¹³ Such products have also been listed in industry guides under the categories "Headache Racks"¹⁴ and "Cab Protectors"¹⁵ (with no product category for "backrack"), and in online catalogs under the headings "Truck Equipment" and "Cab Guards."¹⁶

¹⁰ Jayne Disc. Dep. pp. 66, 68 (Docket # 43); Jayne Test. Dep. pp. 8, 149 (Docket # 56); McGuire Dep. pp. 9, 17-18, 53 (Docket # 47); Bridges Dep. p. 53 (Docket # 47); Diassi Dep. pp. 11-12, 16, 20-21 (Docket ## 47-48); Craig Dep. pp. 16-17 (Docket # 49); Lichtman Dep. pp. 10, 13-14, 16 (Docket # 49); Laube Dep. p. 20 (Docket # 51); Setteducati Dep. I pp. 18-19, 37 (Docket # 53).

¹¹ Jayne Disc. Dep. pp. 26-30 (Docket # 43).

¹² Jayne Test. Dep. p. 27 (Docket # 56); Backrack Exhibit 119, No. 39 (Docket # 57).

¹³ Jayne Test. Dep. pp. 79, 81-84 (Docket # 56); Backrack Exhibit 138 (Docket # 58).

¹⁴ December 1993 issue of Trucking Times, Setteducati Dep. II pp. 47-48, 51 (Docket # 55), STK Exhibit 66 (Docket # 53); Truck Max 2004-05 catalog for Premium Brand Accessories for Pickups and SUVs, Jayne Disc. Dep. pp. 187-188 (Docket # 43), Petitioner's Exhibit 29 (Docket # 44).

¹⁵ Trailer Body Builders 1996 Buyer's Guide issue, Jayne Disc. Dep. pp. 185-186 (Docket # 43); Petitioner's Exhibit 28 (Docket # 44).

¹⁶ See usworkvan.com, Jayne Test. Dep. 22 (Docket # 56); Backrack Exhibit 119, No. 28 (Docket # 57).

The evidence and testimony by the parties and others in the industry establishes that racks having the same or similar purpose to respondent's BACKRACK racks are known and commonly referred to as: headache guards, cab guards, window guards, cab protectors, cab racks, truck racks, and cab protection.¹⁷

In view of the foregoing, the genus of respondent's goods is construed to include the recitation of goods set forth in its Registration and synonymous product names identified by the evidence, namely:

pick-up truck racks, namely, headache racks (also known as headache guards, cab guards, window guards, cab protectors, cab racks, truck racks, and cab protection) designed to protect the cab and mount a variety of accessories, namely, light, antenna and toolbox brackets.

B. Primary Significance to Relevant Public

Having defined the genus, we proceed to determine whether the primary significance of respondent's BACKRACK

¹⁷ Jayne Disc. Dep. p. 16 (Docket # 43); Jayne Test. Dep. pp. 17, 28-30, 117-118, 164-166 (Docket # 56); Backrack Exhibit 119, No. 40 (BR00267, 269, 343, 345, 347) (Docket # 57); McGuire Dep. p. 53 (Docket # 47); Craig Dep. p. 26 (Docket # 49); Lichtman Dep. pp. 26-27, 34-36 (Docket # 49); Laube Dep. pp. 20, 54-58 (Docket # 51); Podesta Dep. pp. 10-11 (Docket # 51); Setteducati Dep. I pp. 18-19, 33-34, 101, 103, 178 (Docket # 53); Setteducati Dep. II. pp. 36-37, 159-161 (Docket # 55); light racks and ladder racks are related to but not the same as headache racks, as both can be used to support ladders and lights respectively, Jayne Test. Dep. pp. 137-141 (docket # 56); McGuire Dep. pp. 54-55 (Docket # 47); Craig Dep. pp. 26-28 (Docket # 49); Podesta Dep. p. 10-11 (Docket # 51); and Setteducati Dep. I p. 35 (Docket # 53).

mark is understood by the relevant public primarily to refer to that genus of goods. *Ginn*, 228 USPQ at 530.

1. **The Relevant Public**

The "relevant public" for goods sold in the marketplace is limited to actual or potential purchasers of the goods. *Magic Wand*, 19 USPQ2d at 1552-1553. When dealing with ordinary consumer goods, the test for genericness is the term's meaning to consumers, not necessarily the professionals in the trade. *Zimmerman v. National Assoc. of Realtors*, 70 USPQ2d 1425, 1429 (TTAB 2004). Here, however, we are not dealing with ordinary consumer products. Respondent sells the headache racks it manufactures to distributors or wholesalers, and commercial users such as construction companies.¹⁸ The distributors, in turn, sell to commercial customers, including contractors, jobbers (i.e., resellers such as auto parts stores, who sell to end users), municipalities, craftsmen, roofers, carpenters, plumbers, landscapers, automotive dealerships, and body shops. Distributors and jobbers also sell such products at retail to commercial and non-commercial end users.¹⁹ In view of the foregoing, the relevant public includes

¹⁸ Jayne Disc. Dep. pp. 21, 89, 163-164 (Docket # 43).

¹⁹ McGuire Dep. pp. 10, 22 (Docket # 47); Bridges Dep. pp. 8-9 (Docket # 47); Diassi Dep. pp. 8-10 (Docket # 47); Craig Dep. pp. 10-15 (Docket # 49); Lichtman Dep. p. 12 (Docket # 49); Ackley pp. 42-43 (Docket # 51); Laube Dep. pp. 14-17 (Docket # 51); Podesta Dep. pp. 9-10, 65 (Docket ## 51-52); Setteducati Dep. I

distributors, retailers/jobbers, and commercial and non-commercial end-users.

2. **Armor Deck's Relationships with the Parties**

Since its formation in 2007, petitioner has contracted the manufacture of headache racks that it then sells in competition with respondent's products. Petitioner's products are distributed by Armor Deck, a supplier to the automotive aftermarket. Armor Deck previously distributed respondent's products until its relationship with respondent soured in 2007 and respondent ceased selling product to Armor Deck.²⁰ Petitioner, which is 75% owned by Armor Deck, was formed around the time of the falling out between respondent and Armor Deck, to make headache racks that compete with respondent's products. Armor Deck continues to sell its inventory of respondent's BACKRACK products, and sometimes purchases respondent's products from an alternate source.²¹

The president and sole owner of Armor Deck, Steve Setteducati, is an advisor to the managing partner of petitioner and testified on behalf of petitioner.²² In view

pp. 13-14 (Docket # 53); Jayne Test. Dep. pp. 111-112 (Docket # 56).

²⁰ During this time, respondent filed suit against Armor Deck for nonpayment of invoices and Armor Deck filed a counterclaim for breach of contract. The suit was settled prior to trial. Setteducati Dep. I pp. 6-7, 27, 29-30 (Docket # 53).

²¹ Setteducati Dep. I pp. 16-17 (Docket # 53).

²² Setteducati Dep. I pp. 12-17, 193, 195 (Docket # 53); Setteducati Dep. II p. 20, 31-32, 35 (Docket # 55).

of the foregoing, there are close and overlapping ties between petitioner and Armor Deck. Accordingly, petitioner has a depth of knowledge about the industry and products at issue that transcends its relatively recent entry into the marketplace.

3. Primary Significance of BACKRACK

In assessing the relevant public's understanding or perception of the BACKRACK mark, evidence may be considered from any competent source such as consumer surveys, purchaser testimony, catalogs, and listings in dictionaries, trade journals, magazines, newspapers and other publications. *See Merrill Lynch*, 4 USPQ2d at 1143; *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985); and *Dan Robbins & Associates, Inc. v. Questor Corp.*, 599 F.2d 1009, 202 USPQ 100, 105 (CCPA 1979).

The evidence offered by the parties to show the public's understanding of the BACKRACK mark falls into several categories which we review below.

a) Meaning of Mark

Any inquiry into the public's understanding of the BACKRACK mark requires consideration of the mark as a whole, not from its elements separated and considered in detail. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1811 (Fed. Cir. 2001) citing *Estate of P.D.*

Beckwith, Inc. v. Comm'r of Patents, 252 U.S. 538, 545-46, (1920). In the absence of any evidence that "backrack" is a word in the English language, petitioner selects a single definition for each of the words "back" and "rack," arguing these words are generic terms for describing the position (i.e., in the back of the cab of the pickup truck) and function (i.e., a rack or frame for a pickup truck) of a headache rack.²³ 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, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005), citing to *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832, 1836 (Fed Cir. 1999).

Quoting from a discussion of the *Gould* case in *American Fertility Society*, 51 USPQ2d at 1836, petitioner concludes that the compound word BACKRACK has no different meaning from the definitions it provided for the constituent words "back" and "rack," and therefore, no additional proof of the genericness of the compound word is required.²⁴ For several reasons, *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987), does not dictate a finding of genericness based on the selected definitions offered by petitioner.

²³ Pet. Brief p.18; and STK Exhibits 124 and 125 (Docket # 46).

Petitioner's evidence shows a multitude of definitions for the words "back" and "rack," with only one definition of each being asserted by petitioner to be pertinent to features of headache racks. Additionally, as distinguished from the "Screenwipe" mark in *Gould*, the BACKRACK mark is a "catchy name" that "rolls off the tongue" as "two words that rhyme together."²⁵ The nuanced ambiguity resulting from the compound rhymed term BACKRACK is further supported by the several registrations and uses of the term "backrack" or "back rack" for goods that are completely unrelated to headache racks.²⁶ As noted by our primary reviewing court, the existence of "the ambiguities and multiple meanings in the mark," and in this case, the catchiness of the mark, cannot be discounted in the genericness determination. *Steelbuilding.com*, 75 USPQ2d at 1423.

Beginning in 1989 with the issuance of respondent's U.S. Patent No. 4,867,497 which referred to its headache rack as "a rack for attaching to the box of a pickup truck" and not as a "back rack," there is no evidence that respondent used the component portions of its mark to

²⁴ Pet. Brief pp. 21-22.

²⁵ Jayne Test. Dep. pp. 150-51 (Docket # 56).

²⁶ See Resp. Exhibits J1 (Registration No. 3285848 for BACKRACK for orthopedic supports); J3 Registration No. 2307561 for BACK RACK for bike and ski racks for vehicles, cancelled under § 8 on October 14, 2006); and J4 (Registration No. 2082364 for BACK RACK for massage apparatus, cancelled under § 8 April 24, 2004) (Docket # 62); and Exhibit M (Jemrack Step-Back Rack for interior van racks; Back Rack sling for surfboards; Back Rack bike rack;

describe its product.²⁷ Thus, this case is very different from *Gould* where evidence of the meaning of the term "Screenwipe" was supported by Gould's own description of its product on packaging as "a . . . wipe . . . for . . . screens," *Gould*, 5 USPQ2d at 1112, which left nothing for speculation or conjecture.

b) Respondent's Use of "Backrack"

The manner of use of a term directly impacts its significance so we begin by reviewing respondent's use of the term BACKRACK. In 1988, one of respondent's founders coined the BACKRACK trademark and since 1989, respondent has continuously exported headache racks to the U.S. under the BACKRACK mark.²⁸ From the early 1990's, respondent has frequently used BACKRACK as a noun in its promotional materials and installation instructions.²⁹ Indeed, it has continued to do so in its most recent promotional materials which include references such as "The strength of a BACKRACK begins with" and "Securing cargo to your BACKRACK. .

Backrack spine rack; BACK RACK Hitch Mounted SUV Racks for skis, snowboards, and bicycles) (Docket #62).

²⁷ Jayne Test. Dep. pp. 13, 93-94 (Docket # 56); Backrack Exhibit 119, No. 1 (Docket # 56).

²⁸ Jayne Disc. Dep. pp. 326-328 (Docket # 44); Jayne Test. Dep. pp. 9, 150-151 (Docket # 56).

²⁹ Setteducati Dep. I pp. 93-95 (Docket # 53), STK Exhibit 99E (Docket # 54); Jayne Disc. Dep. pp. 72, 168 (" . . . and the end user was installing the product themselves, they would see this. In many cases our product is installed by the retailer and hence, the retailer would see this. And in many cases the retailer would already know how to install a BACKRACK brand headache rack and wouldn't refer to these instructions at all.") (Docket # 43); Petitioner's Exhibits 5, 22, 24, 25, 31 (Docket # 44).

. ."³⁰ There are also several instances where respondent's promotional materials refer to its product as "BACKRACKs" or "BACKRACK's" which respondent acknowledges as "poor grammar,"³¹ and its website contains similar uses including the statement: "BACKRACKS are available at select dealers across North America. . . ."³² At the top of each webpage, however, the BACKRACK trademark appears in bold print with the ™ symbol.

In every instance where respondent used BACKRACK as a noun, it has been used as a proper noun, i.e., it is shown either in all uppercase letters or with an initial capital letter "B," thereby indicating that it is not a generic term. *See In re Country Music Association, Inc.*, 100 USPQ2d 1824, 1831 (TTAB 2011) (initial capitalization of a term or phrase is generally used to designate a brand name, as opposed to a generic term). Petitioner argues that respondent's capitalization of BACKRACK is without significance because respondent uses similar capitalization schemes, i.e., bold type and font sizes, for various generic words mentioned in respondent's promotional materials.³³ However, the additional indicators respondent utilizes in

³⁰ Jayne Disc. Dep. pp. 189-198 (Docket # 43); Petitioner's Exhibit 30 (Docket # 44).

³¹ Jayne Disc. Dep. pp. 123, 132 (Docket # 43); Petitioner's Exhibits 14-17 (Docket # 44).

³² Jayne Disc. Dep. p. 227 (Docket # 43); Petitioner's Exhibit 33 (Docket # 44). This webpage also has a masthead with BACKRACK™

connection with BACKRACK convey that BACKRACK is not a generic term. For example, in most instances where the BACKRACK mark is used in promotional pieces, the mark is shown with the ™ symbol at least once to indicate that BACKRACK is a brand name³⁴ and BACKRACK is frequently shown in all uppercase letters.³⁵ In addition, various promotional pieces also bear the legend: "Backrack is a Trademark of Backrack Inc."³⁶

Some of respondent's materials have explicitly identified its BACKRACK product as a pickup truck rack. For example, respondent's product information sheet from 1994 contains the following language: **"Today's pickup trucks look great, so why destroy their good looks with an awkward full frame rack? BACKRACK combines"** Similarly, the text of a promotional piece from 2000-2001 begins with the line: **Today's pickup trucks look great, so why destroy their looks with a full frame rack?**³⁷ Other references to the fact that respondent's product is a truck rack are also found in its materials: **"From this standpoint, the**

in bold letters and an image of a headache rack bearing the BACKRACK decal.

³³ Petitioner's Brief p. 25.

³⁴ Jayne Disc. Dep. pp. 122-123, 162 (Docket # 43); Petitioner's Exhibits 5, 14-19, 22, 23, 27, 30, 31 (Docket # 44); Backrack Exhibit 119, Nos. 12, 23 (Docket # 57).

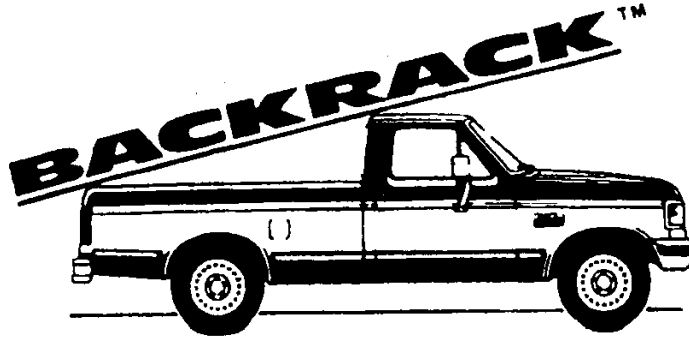
³⁵ Jayne Disc. Dep. p. 123 (Docket # 43); Petitioner's Exhibits 5, 8, 9, 11, 13, 14, 19, 22, 23 (Docket # 44).

³⁶ See Petitioner's Exhibits 5, 8, 11, 22 (Docket # 44).

³⁷ Jayne Disc. Dep. pp. 95-97 (Docket # 43); Petitioner's Exhibit 9 (Docket # 44).

BACKRACK™ is the most safety conscious rack in the market."³⁸

Additionally, respondent's advertising and promotional materials have displayed the following Logo showing use of the ™ symbol in close proximity to the BACKRACK mark:



As acknowledged by petitioner, respondent's use of this Logo where the BACKRACK mark assumes the position of a ladder carried on a pickup truck followed by the ™ symbol, reinforces the trademark significance of the term BACKRACK.³⁹

Respondent directly promoted BACKRACK as its "brand name" by using language such as "THE BRAND NAME YOU TRUST" in some of its promotional materials, including in point of purchase materials and its product guide published in mid-2007:

³⁸ Petitioner's Exhibit 14 (Docket # 44).

³⁹ Setteducati Dep. II p. 126, 152 (Docket # 55); Petitioner's Exhibits 5, 6, 8, 27, 30 (Docket # 44); Backrack Exhibit No. 119, No. 12 (Docket # 57).

BACKRACK™
FUNCTION AND STYLE FOR TODAY'S TRUCKS

WHY SETTLE FOR LESS? We're not satisfied with universal mounting systems that require drilling holes, and neither should you be. Whenever possible, we engineer our products to fasten onto your truck without drilling holes. This is what separates BACKRACK from our competitors.

WITH AMERICAN MADE QUALITY

Every BACKRACK product is engineered, manufactured, powder coated and packaged in our Oakville, Ontario plant. To build a consistent quality product, you need constant supervision of all processes. Outsourcing our manufacturing is simply not an option. Our steel is bought direct from North American manufacturers to ensure quality. Abandoning the North American worker to make a quick profit is not part of BACKRACK's culture.

THE BRAND NAME YOU TRUST

Twenty years ago, we made our first BACKRACK. Twenty years later, the same man still owns the company and, on occasion, still gets his hands dirty in the shop. When a business owner is personally invested and involved in the day-to-day operation of a business, the result is a quality product created by caring employees. Our manufacturing processes are modern; our commitment to quality is old school.

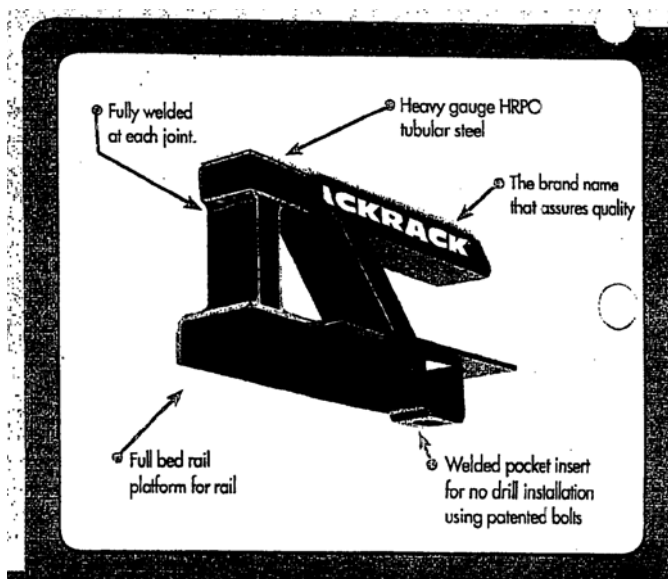
BACKRACK

TOUGH CONSTRUCTION: The strength of a BACKRACK begins with rigid materials. Heavy gauge 2" tubing is robotically welded at each intersection, and all tube ends are robotically welded then polished for a finished look. All tubes, flat bar and flat steel are scale free Pickled & Oiled material for minimal corrosion.

DURABLE POWDER COAT FINISH: All BACKRACK products are powder coated in our factory using our state-of-the-art powder coat line. The live-stage pre-treatment process prepares a flawless surface on which to apply the powder. Our digitally controlled automatic application equipment provides a smooth and consistent application of powder for a durable, consistent and attractive finish.

ADAPTABLE TO YOUR BUSINESS: Securing cargo to your BACKRACK is safe and easy. The open design allows for hooks, straps and rope to be easily affixed to the frame. Our accessories simply roll on to customize your BACKRACK to whatever you need it to be. For example, the REAR BAR makes your BACKRACK an inexpensive and flexible ladder Rack. Our LIGHT BRACKETS allow you to mount travel size bins of light without drilling holes in your truck. See the

and also utilized the following graphic image to emphasize the brand name significance of the term BACKRACK:⁴⁰



When viewing THE BRAND NAME YOU TRUST language in respondent's promotional material, the owner of a business

⁴⁰ Petitioner's Exhibits 18, 22, 23, 30, 31 (p. BR00358) (Docket # 44); Jayne Disc. Dep. pp. 141-145, 158, 216-217 (Docket # 43).

that sells headache racks understood the reference to BRAND NAME to mean "name recognition":

Q. What is your understanding of brand name, Mr. McGuire?

A. Name recognition.

Q. Name recognition in -- in what context?

A. For the -- quality of a product. I mean, it's like DeWalt drills, Ryobi drills, you have many flavors in the same exact thing, you know.

* * *

Q. In the paragraph opposite the heading, The Brand Name You Trust, do you see a brand name in that paragraph?

A. Yes.

Q. What is the brand name, Mr. McGuire?

A. Backrack.⁴¹

In addition to the foregoing, the headache racks sold by respondent have been prominently labeled with the BACKRACK trademark in the form of a decal that is visible when viewing the rear of a pickup truck having a mounted BACKRACK headache rack:⁴²

⁴¹ McGuire Dep. p 29 (Docket # 47).

⁴² The decal of the BACKRACK mark initially displayed the mark as a single word. Due to legal regulations calling for a third brake light on vehicles, the decal had to be modified to insert a space between BACK and RACK to avoid obstruction of the third brake light located at the top center of the truck cab. Jayne Disc. Dep. pp. 92-93 (Docket # 43); Petitioner's Exhibit 22 (Docket #43).



Most of respondent's promotional materials feature similar images of the BACKRACK headache rack mounted on a pickup truck with the BACKRACK decal shown on the rack. The use of BACKRACK™ in connection with images such as that shown above conveys to viewers that they are looking at a product produced by "Backrack."⁴³

There is little room for respondent to argue that it has not been sloppy in its use of the BACKRACK mark.⁴⁴ As

⁴³ Setteducati Dep. II p. 85 (Docket # 55); STK Exhibit 99F (Docket # 54).

⁴⁴ Petitioner has also been careless in the use of its PRO RACK and PRO GUARD trademarks, using them improperly as nouns and in plural form in promotional material and on its website. Setteducati Dep. II pp. 157-58 (Docket # 55); Backrack Exhibits

recognized by petitioner, such misuses of a mark can jeopardize its trademark significance.⁴⁵ See e.g., *Turtle Wax, Inc. v. Blue Coral, Inc.*, 2 USPQ2d 1534, 1536, (TTAB 1987) and *In re Bausch & Lomb, Inc.*, 206 USPQ 534, 537 (TTAB 1979). However, when viewed in their entire context, respondent's promotional materials convey that respondent's product is a pickup truck rack that is sold under the BACKRACK brand. Given the steps taken by respondent to acknowledge and promote BACKRACK as its brand name, its misuses of the mark have diminished, but not destroyed, the trademark significance of BACKRACK. Therefore, based on the manner in which respondent has marketed its products, it is more likely than not that the relevant public recognizes BACKRACK as a brand name.

c) Use of Mark by Competitors

A competitor's use of a term is evidence of the genericness of that term. See e.g., *Remington Products, Inc. v. North American Philips Corp.*, 892 F.2d 1576, 13 USPQ2d 1444, 1446, 1449 (Fed. Cir. 1990) (use of "Travel Care" in the trade as category designation significant factor in finding term generic) and *BellSouth Corp. v. DataNational Corp.*, 60 F.3d 1565, 35 USPQ2d 1554, 1558 (Fed. Cir. 1995). The availability of other words for competitors

116 (Docket # 55), 119 Nos. 5-7, 27 (Docket # 57); Jayne Test. Dep. pp. 67-75 (Docket # 56); Backrack Exhibit 135 (Docket # 58).

⁴⁵ Petitioner's Brief p. 27.

to use does not, by itself, transform a generic term into capable matter. *Blinded Veterans Ass'n v. Blinded American Veterans Foundation*, 872 F.2d 1035, 10 USPQ2d 1432, 1437 (D.C. Cir. 1989). However, where the evidence does not show competitors use the designation at issue, this can create doubt, depending on the totality of the record, as to whether a term primarily refers to a genus of goods such that "sellers of competing brands cannot compete effectively without using the name to designate the product they are selling." *Ty Inc. v. Softbelly's Inc.*, 353 F.3d 528, 69 USPQ2d 1213, 1215 (7th Cir. 2003).

Petitioner and respondent are direct competitors in the manufacture and sale of headache racks. Therefore, we look to the manner in which petitioner identifies its products to see whether it utilizes the term "backrack." The most telling evidence of the trademark significance of BACKRACK is petitioner's testimony explaining the reason why neither petitioner nor its distributor Armor Deck, who distributed respondent's BACKRACK products from 1994 through 2007, have ever used BACKRACK in a generic sense ". . . because it's a trademark."⁴⁶

The new product announcement for petitioner's competing ProRack and ProGuard racks identifies these products as

⁴⁶ Setteducati Dep. I p. 16 (Docket # 53); Setteducati Dep. II pp. 159, 162, 164-165 (Docket # 55).

"truck racks."⁴⁷ Similarly, one of petitioner's early promotional pieces for its Pro Rack and Pro Guard headache racks, which have been called "imitations" of respondent's racks, also identified the products as "truck racks."⁴⁸ This is consistent with petitioner's website which contains a link entitled "Cab Guards" that a viewer clicks on to see the Pro Rack and Pro Guard products which are referred to as "truck racks."⁴⁹

There are several other brands of headache racks: Better Built, Big Tex, Camo Rack, Cross Tread, Daws Manufacturing, Go Industries, Highway Products, Husky, Rhino STK, US Rack, Vanguard, Weather Guard, Willmore, and Winbo.⁵⁰ Some of these products have been advertised and offered for sale as "racks," "cab protectors," "cab racks," and "cab guards."⁵¹ "Back rack" is not a term that is commonly used by other headache rack manufacturers to describe their products.⁵²

One of the foregoing competitors, Highway Products, began referring to its "Leopard" rack as "our new open back

⁴⁷ Jayne Test. Dep. p. 14 (Docket # 56); Backrack Exhibit No. 119, Nos. 3, 4 (Docket # 57).

⁴⁸ Setteducati Dep. II pp. 157-158, Backrack Exhibit 116 (Docket # 55); Jayne Test. Dep. p. 14 (Docket # 56).

⁴⁹ Jayne Test. Dep. pp. 75-77 (Docket # 56), Backrack Exhibit 136 (Docket # 58); Setteducati Dep. II pp. 159-161, Backrack Exhibit 136 (Docket # 55).

⁵⁰ Bridges Dep. pp. 41-42 (Docket # 47); Diassi Dep. pp. 14-16, 35 (Docket # 47-48); Setteducati Dep. II pp. 141-142 (Docket # 55).

⁵¹ Jayne Test. Dep. p. 28-30 (Docket # 56); Backrack Exhibit 119, No. 40 (see BR00267, 269, 343, 345, 347) (Docket # 57).

⁵² Lichtman Dep. pp. 54-55 (Docket # 49).

rack." However, on several other pages in its catalog, it referred to its products, including the "Leopard" headache rack, as "truck racks."⁵³ Respondent considered this use to be an infringement of its trademark rights and issued a cease and desist letter.⁵⁴

While another headache rack seller, Westcan Manufacturing Ltd. of British Columbia also utilized the term "Back Rack" in its catalog,⁵⁵ respondent subsequently sent it a cease and desist letter and Westcan promptly agreed to cease use of the term "Back Rack."⁵⁶

In view of the foregoing, there are a number of synonymous terms for headache racks, other than "backrack," being widely used by competitors. Thus, the evidence does not show a competitive need for others to use the term "backrack" to identify their headache racks.

d) Third-Party Use of BACKRACK

Use of BACKRACK by those involved in the industry, i.e., distributors, resellers and end-user customers is inconclusive. The evidence shows both proper use of BACKRACK as a trademark for respondent's products, as well

⁵³ Setteducati Dep. I p. 173 (Docket # 53), STK Exhibit 101, pp. 7-9, 14 (Docket # 54).

⁵⁴ Jayne Test. Dep. pp. 64-66 (Docket # 56); Backrack Exhibit 133 (Docket # 58).

⁵⁵ Setteducati Dep. I pp. 176-178 (Docket # 53), STK Exhibit 102 (Docket # 54).

⁵⁶ Jayne Disc. Dep. pp. 303, 308-309 (Docket # 43), Petitioner's Exhibit 58 (Docket # 44).

as generic use of the term referring to any type of headache rack, with neither scenario being predominant.

Respondent's BACKRACK mark has been utilized with the ⁵⁷ symbol in distributors' catalogs⁵⁷ and promoted as "The Brand Name You Trust" in such catalogs.⁵⁸ Petitioner's affiliated distributor from 1994 until 2007,⁵⁹ Armor Deck, acknowledged the validity of the BACKRACK trademark in its promotional materials. Of the six dealer sites that are linked to respondent's website, three of them advertise the BACKRACK product utilizing nouns such as "rail mount ladder rack," "headache rack," and "window guard."⁶⁰

A distributor's catalog and internet retailer's website that offer a variety of products show no category for "backracks." Instead, there are categories for "cab guards" and "headache racks" that reference the catalog pages displaying respondent's BACKRACK headache racks;⁶¹ and respondent's products are found on the website under the subcategories "Cab Guards" and "Headache Racks" under the "Truck Cab Guard Protection" link.⁶²

⁵⁷ Jayne Disc. Dep. pp. 228-233, 279 (Docket # 43); Petitioner's Exhibits 34 and 51 (pages from Keystone catalog) (Docket # 44).

⁵⁸ Jayne Disc. Dep. pp. 279-280 (Docket # 43); Petitioner's Exhibit 51 (Docket # 44).

⁵⁹ Jayne Test. Dep. p. 114 (Docket # 56).

⁶⁰ Setteducati Dep. I pp. 98-101 (Docket # 53); STK Exhibit 99F (Docket # 54).

⁶¹ Jayne Disc. Dep. p. 279 (Docket # 43); Jayne Test. Dep. pp. 34-36 (Docket # 56); Petitioner's Exhibit 51 (Docket # 44), Backrack Exhibit 119, No. 51 (Docket # 57).

⁶² Jayne Test. Dep. pp. 77-79 (Docket # 56); Backrack Exhibit 137 (Docket # 58).

Respondent's products are clearly identified on the Armor Deck website as BACKRACK™ truck racks and cab guards where the trademark is used properly.⁶³ Armor Deck's website lists "Contractor-Industrial" product categories which include the subcategories "Cab Guards" and "Ladder Rack" where respondent's products are found.⁶⁴ Tellingly, there is no "Back Rack" category. Competitive products, including the parties' products, are identified as "truck racks," "ladder racks," and "cab guards."⁶⁵ This is consistent with the indexes contained in Armor Deck's 1994-95, 1996, 1998-99, 2000-01, 2002-03, 2003-04, 2005-06, 2006-07 catalogs which identify product categories for "headache racks" and "cab guards," but not "back racks."⁶⁶

Over the years, Armor Deck's layout and design for BACKRACK headache racks has varied, but has typically referred to BACKRACK as a proper noun.⁶⁷ In 2007, Armor Deck learned that a trademark should be used as an adjective to describe a product, not as a noun.⁶⁸ Thus, Armor Deck's improper use of the BACKRACK trademark may stem from its

⁶³ Jayne Test. Dep. pp. 67-75 (Docket # 56); Backrack Exhibit 135 (Docket # 58); Setteducati Dep. II p. 151, Backrack Exhibit 114 (Docket # 55).

⁶⁴ Setteducati Dep. II pp. 148-152, Backrack Exhibit 114 (Docket # 55).

⁶⁵ Jayne Test. Dep. pp. 67-75 (Docket # 56); Backrack Exhibit 135 (Docket # 58).

⁶⁶ Setteducati Dep. II pp. 53-61, 65 (Docket # 55), Backrack Exhibits 106-113 (Docket # 54).

⁶⁷ Setteducati Dep. I pp. 60-61 (Docket # 53).

⁶⁸ Setteducati Dep. I pp. 63-64 (Docket # 53).

unfamiliarity with proper trademark usage, rather than indicating the genericness of the term BACKRACK.⁶⁹

Indeed, in every Armor Deck catalog, the BACKRACK mark appears on the top of the page in prominent lettering followed by the ™ symbol. As early as 1996, Armor Deck's catalogs advertised respondent's products with the statement: **"Today's Pickups look great, so why destroy their good looks with an awkward full frame rack?"** in larger lettering directly underneath the BACKRACK™ trademark shown at the top of the catalog page and in connection with an image of a headache rack mounted on a pickup truck bearing the BACKRACK decal; the bottom of the catalog page bearing a legend reminding readers that **"BACKRACK is an attractive and versatile alternative to conventional truck racks or window and cab guards!"**⁷⁰ Since May 2008, Armor Deck's website advertised BACKRACK™ products, referring to them as "Backrack™ Truck Racks and Cab Guards."⁷¹

⁶⁹ Despite learning about the appropriate use of a trademark, petitioner has also been careless in the use of its PRO RACK and PRO GUARD trademarks, using them improperly in promotional material and on its website, as nouns and in plural form. Setteducati Dep. II pp. 157-58; Backrack Exhibits 116, 119 Nos. 5-7, 27 (Docket # 55); Jayne Test. Dep. pp. 67-75 (Docket # 56); Backrack Exhibit 135 (Docket # 58).

⁷⁰ Setteducati Dep. I p. 43, STK Exhibit No. 98A,C-E (Docket # 53); Jayne Disc. Dep. pp. 262-264 (Docket # 56), Petitioner Exhibit 46 (Docket # 44); Jayne Test. Dep. pp. 22, 171-173 (Docket # 56); Backrack Exhibit 119, No. 27 (Docket # 57).

⁷¹ Jayne Test. Dep. pp. 22, 171-173 (Docket # 56); Backrack Exhibit 119, No. 27 (Docket # 57); Setteducati Dep. II pp. 148-150, Backrack Exhibit 114 (Docket # 55).

Internet retailers refer to respondent's BACKRACK headache racks in various manners, including as Backrack Pickup Truck Headache Racks/Headache Racks (see bigboys-customtoys.com, 4wheelonline.com, pickupspecialties.com, truckchamp.com, rackwarehouse.com, ok4wd.com, quadratedec.com); BACKRACK Cab Guards/Cab Protector (see anythingtruck.com, usworkvan.com, mutualwheelco.com, rackwarehouse.com); Backrack Truck Racks (see etrucktoys.com, cargogear.com); and in bold lettering and/or with the [™] symbol (see pickupspecialties.com, cargogear.com).⁷² Although some of the online advertisements referring to respondent's products listed by sellers who did not purchase directly from respondent and did not have respondent's authorization, also show use of "Backrack" as a noun by itself or in the plural form,⁷³ they show BACKRACK in prominent bold lettering at the top, and with capital letters in the text, and sometimes with the [™] symbol. Thus, it is clear that many in the industry have recognized and used BACKRACK as a trademark.

Comparing the instances of correct use of BACKRACK as a trademark versus the improper use of BACKRACK as a generic

⁷² Jayne Disc. Dep. pp. 283-285, 289-298 (Docket # 43); Petitioner's Exhibits 52, 53, 55, 56 (Docket # 44); Jayne Test. Dep. pp. 23-26 (Docket # 56); Backrack Exhibit 119, Nos. 29, 32, 34, 35, 36, 37 (Docket # 57).

⁷³ See Petitioner's Exhibits 35, 36, 41, 55 (Docket # 44); notably, Petitioner's Exhibits 37-40 show use of the descriptive

term leads to the conclusion that neither scenario is dominant. Under these circumstances, we cannot conclude that the misuse of the term is so widespread and of such duration that it has caused BACKRACK to lose all significance as a trademark. *Tea Board of India v. Republic of Tea, Inc.*, 80 USPQ2d 1881, 1893 (TTAB 2006).

e) Customer's Understanding of BACKRACK

Although sellers and suppliers of headache racks testified that "back rack" is a term used to identify a type of rack, they also recognize that BACKRACK is a trade name or a brand name.⁷⁴ However, the term "backrack" is sometimes used by customers and retailers/jobbers as a term for a headache rack.⁷⁵ The record contains several listings on craigslist.org and plowsite.com that advertise a "Backrack" for sale, with the product pictured in the listing being something other than a BACKRACK brand product.⁷⁶ A distributor who sold only BACKRACK brand headache racks received several calls for a "Backrack" with

term headache racks in connection with the BACKRACK trademark, Jayne Disc. Dep. pp. 233-255 (Docket # 43).

⁷⁴ Bridges Dep. pp. 12, 14 (Docket # 47); Diassi Dep. p. 17 (Docket # 47); Lichtman Dep. pp. 25-26 (Docket # 49); Ackley pp. 14, 18-19, 45 (Docket # 51); Podesta Dep. p. 15 (Docket # 51).

⁷⁵ Craig Dep. pp. 34-35 (Docket # 49); Lichtman Dep. pp. 26-27, 29, 34-37 (Docket # 49); Ackley Dep. pp. 29-30 (Docket # 51); Laube Dep. p. 34 (Docket # 51); Podesta Dep. pp. 15, 20 (Docket # 51).

⁷⁶ Podesta Dep. pp. 24-62 (Docket ## 51-52), STK Exhibit Nos. 69-75, 77-79, 81-86, 88 (Exhibits 76, 87 and 89 are of little probative value as they lack sufficient information to ascertain whether the references made to "BackRack" are to something other

a mesh despite the fact that respondent was not manufacturing a mesh style rack at the time.⁷⁷ Customers come into stores or call suppliers requesting a "back rack."⁷⁸ According to one seller of headache racks, about 50% of the time, people come in asking for a "backrack."⁷⁹

On occasion, customers that come in requesting a "back rack" after being shown a picture of a BACKRACK headache rack, indicate that is not what they are looking for. Sometimes, customers' use of term "back rack" is to refer to a type of product.⁸⁰ Due to this phenomenon, when customers come in and request a "backrack," sellers and retailers show the customer pictures, displays or catalogs of the BACKRACK brand product to confirm whether that is the product sought by the customer.⁸¹

Customers have ordered "Backrack" products from Armor Deck and when they received the product, it was not the product they were interested in. As a result, Armor Deck adjusted its sales practices to solicit additional information from customers in order to "overcome the

than BACKRACK brand headache racks; Exhibit 80 is duplicative of Exhibit 73) (Docket # 52).

⁷⁷ Ackley Dep. pp. 22-23 (Docket # 51).

⁷⁸ McGuire Dep. pp. 63-66 (docket # 47); Bridges Dep. p. 38 (Docket # 47); Diassi Dep. pp. 17, 23-24, 55 (Docket ## 47-48); Ackley Dep. p. 16 (Docket # 51); Laube Dep. pp. 23-24, 29 (Docket # 51).

⁷⁹ McGuire Dep. p. 32 (Docket # 47).

⁸⁰ Bridges pp. 42-43, 51 (Docket # 47).

⁸¹ Bridges Dep. pp. 12, 15-16, 30 (Docket # 47); Diassi Dep. p. 30 (Docket # 48); Craig Dep. pp. 31, 33-34 (Docket # 49); Lichtman Dep. pp. 38, 60 (Docket # 49); Ackley Dep. p. 48 (Docket # 51).

confusion that seems to exist regarding Backrack" and ensure the customer receives the product they want.⁸²

Some of the customers that come in requesting a "Backrack" do in fact purchase a BACKRACK brand headache rack.⁸³ The testimony provided by the sellers of headache racks concurred that when customers "walk out of their store" after purchasing a headache rack, they know exactly which brand of headache rack they have purchased.⁸⁴

Respondent's success in the marketplace and strategic labeling of its headache racks appears to explain any confusion on the part of purchasers. As observed by several headache rack sellers:

(testimony by witness McGuire):

A. Well, they'll come in, they're looking for a rack on the back of their truck, but they won't know what it's called. Some may refer to it as headache rack or a cab protector.

I mean, its - sometimes - 50 percent of the time it probably is referred to as a Backrack. Because people usually see the name on the back of the things going down the road, and they will remember what the name is. But it's - it's all the same thing.⁸⁵

⁸² Ackley Dep. pp. 39-41, 46 (Docket # 51).

⁸³ McGuire Dep. pp. 65-66 (Docket # 47); Bridges Dep. p. 13 (Docket # 47); Diassi Dep. pp. 23-24, 52, 55-56 (Docket ## 47-48; Ackley Dep. pp. 41-42 (Docket # 51); Laube Dep. pp. 62-64 (Docket # 51).

⁸⁴ McGuire Dep. pp. 79-81 (Docket # 47); Bridges Dep. p. 51 (Docket # 47); and Ackley Dep. p. 55 (Docket # 51).

⁸⁵ McGuire Dep. p. 32 (Docket # 47).

(testimony by witness Diassi):

Q. Over the years that you have been in this industry and operating Cap Connection, David, do you have any opinion on why this practice has developed of identifying headache racks by the term Backrack?

* * *

A. It's because the name is out there. They see it on the racks all the time. You don't see headache rack printed on any of the product out there. They have seen it, you know, in a trucking magazine or something like that and just assume it's called a Backrack.⁸⁶

* * *

A. . . . Backrack is probably one of the heaviest advertised headache racks out there. You don't see may of them really advertised all that much.⁸⁷

(testimony by witness Craig):

Q. And when you say "generic," what do you mean by that?

A. I would just say the public is more aware of the Backrack name than the others.⁸⁸

All end-users may not understand the significance of the term BACKRACK as a trademark or brand name, however, it is clear that sellers of headache racks recognize the BACKRACK brand name:

Q. What is your understanding of a brand name?

A. Backrack is a brand name, but it's very common. Everybody asks for a back rack, but they don't

⁸⁶ Diassi Dep. p. 37 (Docket # 48).

⁸⁷ Diassi Dep. p. 32 (Docket # 48).

⁸⁸ Craig Dep. pp. 34-35 (Docket # 49).

understand when they do, you ask
them are you looking for the brand
or the rack.⁸⁹

While the testimony of suppliers and retailers indicates some end-customers use the term "backrack" when expressing an interest in ordering a headache rack, there is no evidence which establishes how end-customers are using this term, i.e., what they mean or understand when using the term "backrack."⁹⁰ Two facts stand out from the testimony. First, sellers take "extra steps" to solicit additional information from customers who indicate they wish to order "Backrack" products. That sellers have adjusted their practices to solicit this additional information indicates the term "back rack" has more than one meaning, otherwise the extra steps would not be necessary. Second, a fair number of customers that express an interest in purchasing a "backrack" do in fact purchase a BACKRACK brand headache rack. When viewed together, these facts strongly suggest that although "Backrack" may have more than one meaning, one of the meanings refers to the BACKRACK brand headache rack.

f) Petitioner's Survey Evidence

Petitioner conducted a "homemade" survey of 18 of its customers ("a small cross-section of [petitioner's] customer base") that sell headache racks.⁹¹ Based on their answers

⁸⁹ Diassi Dep. pp. 17, 25 (Docket ## 47-48).

⁹⁰ Craig Dep. p. 74 (Docket # 49).

⁹¹ Setteducati Dep. I pp. 114-116, 118-120 (Docket # 53).

to two questions, petitioner concludes that an overwhelming majority of these 18 survey respondents recognize that their customers (i.e., the end user), generally use the term "Backrack" as the name of any headache rack or cab guard as opposed to an identifier as the source of a product.⁹²

Respondent objects to petitioner's survey evidence on the grounds that petitioner failed to disclose the survey during discovery, and that the survey constitutes inadmissible hearsay. Whether the survey is designated as a scientific survey⁹³ or simply additional evidence of the significance of the BACKRACK mark, it is not probative on the issue of genericness.

Survey evidence is subject to review for its probative value, based on factors including the design of the survey, the questions asked, and the experience of the surveyor. *In re Hotels.com LP*, 573 F.3d 1300, 91 USPQ2d 1532, 1536 (Fed. Cir. 2009). While all surveys are necessarily based on some degree of hearsay, petitioner's survey is replete with fatal defects, including a double layer of hearsay. That is, the survey does not solicit opinions directly from the true subjects of the survey. Rather, the survey respondents simply serve as conduits to relay feedback they supposedly

⁹² Petitioner's Brief. pp. 12, 31.

⁹³ In fact the survey is not a scientific survey; the survey designer readily admitted that he is inexperienced and not an expert with respect to surveys. *Setteducati Dep. I* p. 120 (Docket # 53); *Setteducati Dep. II* p. 117 (Docket # 55).

received from their customers, i.e., the end users, who are the true subjects.⁹⁴

Putting aside the fatal defects pertaining to the small number of respondents surveyed and the fact that the survey was not administered to the end users who comprise a significant portion of the relevant public, the design of the survey did not test for genericness of the BACKRACK mark. Rather than ascertaining the term used by the relevant public to identify a headache rack, the survey asked what name was used by customers to identify a "BackRack truck rack."⁹⁵ The designer of the survey, Steve Setteducati, President of Armor Deck, testified that he was looking to establish whether consumers were improperly using the term "Backrack" as a noun.⁹⁶ Whether customers refer to the rack as a "Backrack," (i.e., use the term as a noun), "Backrack truck rack" or a "BackRack cab guard" sheds no light on the genericness issue. Customers looking for a BACKRACK brand product will undoubtedly use the term "Backrack" as a noun:

The fact that buyers or users often call for or order a product by a term does not necessarily prove that a term is a "generic name." The person

⁹⁴ Setteducati Dep. I p. 113 (Docket # 53); Setteducati Dep. II pp. 111, 113 (Docket # 55).

⁹⁵ Survey question No. 1: When customers come into your store or call you on the phone looking to buy a BackRack truck rack, do they most often ask for a "BackRack" or do they most often ask for a "BackRack truck rack" or "BackRack cab guard?" Setteducati Dep. I p. 118 (Docket # 53); STK Exhibit 68A-R (Docket #54).

⁹⁶ Setteducati Dep. I pp. 114, 195 (Docket # 53).

who orders for lunch a "BIG MAC and a COKE" undoubtedly has brand knowledge and brand loyalty. The generic names "hamburger" and "cola" are understood by all precisely because BIG MAC and COKE are such strong trademarks identifying source. Since everyone knows the generic names, they are dropped in ordinary usage.

J. Thomas McCarthy, 2 *McCarthy on Trademarks and Unfair Competition* § 12:27 (4th ed.).

The second survey question is so ambiguous and speculative that it precludes the possibility of drawing any conclusions.⁹⁷ Neither survey question elicited responses that could provide insight into whether consumers understand the term BACKRACK to mean a product brand or source, or a product genus. Additionally, whether respondents are capable of distinguishing between brand and common names is an important feature of a genericness survey, and petitioner's survey was not designed to detect this capability. *Cf. Country Music Ass'n*, 100 USPQ2d at 1832. In view of the foregoing, petitioner's imprecise and non-scientific survey is not probative of the significance of the term BACKRACK to the relevant public. *See Magic Wand*, 19 USPQ2d at 1554.

⁹⁷ Survey question No. 2: Has there ever been instances, even if only on occasion, that customers have come into your store or call you asking for a "BackRack" when they really don't actually want a "BackRack" at all; rather they want another type of truck rack? For instance, this could mean a different type of cab guard or a full truck rack? *Setteducati Dep. I* p. 118 (Docket # 53); *STK 68A-R* (Docket # 54).

Based on the foregoing, there is a lack of probative evidence in this record as to the primary significance of the term BACKRACK to end users which make up a significant portion of the relevant purchasing public.

g) Uses of BACKRACK in Printed Publications

In assessing genericness, evidence of use of the term in the media, including books, magazines, newspapers, etc. may shed light on the significance of the term. Evidence of this type shows that the term "back rack" is not commonly used as a generic term for headache racks or cab guards. None of the 41 references located in respondent's *LexisNexis* search for the terms "backrack/back rack" demonstrated a generic use of either term for headache racks.⁹⁸ Similarly, the printouts from respondent's internet searches do not show use of BACKRACK as a generic term.⁹⁹

h) Respondent's Efforts to Police Mark

⁹⁸ See Exhibits B1-B41 to Notice of Reliance for Respondent's Exhibits A-P (Docket ## 59-60). Only 4 of the 41 references in Exhibit B refer to pickup truck racks: Exhibits B1-B3 refer to respondent's product and Exhibit B29 does not contain sufficient information to ascertain whether the product mentioned in the Canadian publication was respondent's product. If a document obtained from the internet identifies its date of publication or date that it was accessed and printed, and its source (e.g., the URL), it may be admitted into evidence pursuant to a notice of reliance in the same manner as a printed publication in general circulation in accordance with Trademark Rule 2.122(e). *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010).

⁹⁹ Exhibits A1-A34 to Notice of Reliance for Respondent's Exhibits A-P (Docket # 59). Although these Exhibits are dated June 24, 2009, well after the filing of this proceeding, they corroborate the non-generic use of BACKRACK as shown in other Exhibits that are dated prior in time.

A term may become generic over time through common usage if it is not policed as a trademark and it is commonly used to describe a type of product. *Bellsouth*, 35 USPQ2d at 1557.

i) **Unauthorized Use by Third Parties**

Although respondent approved the advertisements published in Armor Deck's 1994-95, 1996, 1998-99, 2000-01, 2002-03, 2003-04, 2005-06, 2006-07 catalogs,¹⁰⁰ until recently, respondent did not require that it approve or review promotional materials published by its distributors. Instead, respondent provided its distributors with authorized images, templates and layouts for ad copy. Since 2008, authorized images and text are available for download from respondent's website upon entry of a password.¹⁰¹

As early as 2006, respondent instructed its attorney to keep "an eye out" for infringement of its mark.¹⁰² In July 2006, respondent's counsel sent a cease and desist letter to AWATEC Industries Inc. of Quebec regarding its use of the term BACKRACK in Canada and the U.S. AWATEC subsequently agreed to change its website to remove reference to the BACKRACK trademark.¹⁰³

¹⁰⁰ Setteducati Dep. I. p. 205 (Docket # 53); STK Exhibit 98A-L, paragraph 22 (Docket ## 53-54).

¹⁰¹ Jayne Disc. Dep. pp. 142-143, 213-216; 229-231; 260-261; 264-265; 278; 293-298 (Docket # 43).

¹⁰² Jayne Test. Dep. p. 206 (Docket # 56).

¹⁰³ Jayne Test. Dep. pp. 38, 185-196 (Docket # 56); Backrack Exhibits 119 No. 42 (Docket # 57), 120 (Docket # 58).

Respondent's website bears the following notice which was published on the site in early 2007:¹⁰⁴

DON'T BE FOOLED BY IMITATION KNOCKOFF's

Please be aware that a low cost imitation knock off version of the Backrack and Safety Rack has surfaced on certain websites. These websites may claim that Backrack is the manufacturer of this copy, may claim that Backrack products are compatible with their products, or attempt to substitute the knock off for a Backrack. Only Backrack products say BACKRACK or SAFETY RACK. Authorized web dealers are listed on this site. If you have any question about the authenticity of a product you recieved or have questions please contact us.

In January 2008, respondent filed a Notice of Claimed Infringement with eBay concerning a person who welded his own racks and offered them for sale under the name "Backrack." The person subsequently agreed to change the text of his listing.¹⁰⁵ During that same month, respondent also was successful in getting internet retailer *BigBoys-Custom Toys* to agree to cease its use of BACKRACK and Back Rack.¹⁰⁶

A few months later in May, 2008, respondent's attorney sent a letter to Westcan Manufacturing Ltd. of British Columbia requesting that it cease use of the term Back Rack on its website. Westcan entered into a written undertaking

¹⁰⁴ Petitioner's Exhibit 19 (Docket # 44); Jayne Disc. Dep. p. 149 (Docket # 43).

¹⁰⁵ Jayne Disc. Dep. pp. 314-316 (Docket # 43); Petitioner's Exhibit 60 (Docket # 44).

¹⁰⁶ Jayne Disc. Dep. pp. 317-320 (Docket # 43); Petitioner's Exhibit 61 (Docket # 44).

to remove all references from its website and to destroy offending print materials.¹⁰⁷

In January 2009, respondent's counsel sent letters to Domains By Proxy, Inc. regarding the improper use of the term BACK RACK on the automotivemart.net, commze.com, topautoteam.com, shiponsite.com, askyouropinion.com websites. Subsequent checks indicated that all but one of the references were removed.¹⁰⁸

In July 2009, respondent's counsel sent a cease and desist letter to BuyAutoTruckAccessories.com regarding its use of BACKRACK on its website. It followed up with a September 2009 letter to AT&T WorldNet Services regarding the use of BACKRACK on the buyautotruckaccessories.com website.¹⁰⁹

In June and July 2010, respondent sent Notices of Claimed Infringement to eBay regarding use of "Back Racks" in connection with headache racks of Highway Products and

¹⁰⁷ Jayne Disc. Dep. pp. 303-309 (Docket # 43), Petitioner's Exhibit 58 (Docket # 44); Jayne Test. Dep. pp. 197-200 (Docket # 56), Backrack Exhibit 119 No. 43 (Docket # 57).

¹⁰⁸ The references on the commze.com and shiponsite.com sites were not found, technorati.com agreed to remove the blog postings from commze.com and topautoteam.com, and askyouropinion.com agreed to remove the reference to "back rack;" there is no indication of compliance with respondent's request for removal from automotivemcar.net. Jayne Test. Dep. pp. 41-47, 51-55, 58-59 (Docket # 56); Backrack Exhibits 122, 123, 125, 126, 127, 129 (Docket # 58).

¹⁰⁹ Jayne Test. Dep. pp. 48-51 (Docket # 56); Backrack Exhibit 124 (Docket # 58).

others; eBay sent confirmations that offending listings were removed.¹¹⁰

When questioned about the timing of the flurry of letters sent to various third parties complaining about their improper use of the BACKRACK trademark since 2009, i.e., the letters were sent after this proceeding was instituted in May 2008, respondent's president testified that the misuses of its mark came to its attention in connection with this cancellation proceeding¹¹¹ and that within the last year [i.e., from April, 2009], respondent's attorney began to monitor third party websites on behalf of respondent.¹¹²

Even if respondent did not maintain control and misuse of its mark occurred, it must be shown that the misuse was of such significance to permit an inference that the mark is generic. *Tea Board of India*, 80 USPQ2d at 1887 citing *Formica Corporation v. The Newnan Corp.*, 149 USPQ 585, 587 (TTAB 1966) ("It is well settled that a party asserting that an otherwise arbitrary trademark for an article has become a common descriptive name for the article has the burden of showing not only that the mark has been misused in the manner stated but that the misuse thereof has been so widespread and of such duration that there can be no doubt

¹¹⁰ Jayne Test. Dep. pp. 60-64 (Docket # 56), Backrack Exhibits 130-132 (Docket # 58).

¹¹¹ Jayne Test. Dep. pp. 203-204 (Docket # 56).

that to the trade and/or to the public generally the mark identifies the article as to kind rather than as to source"), *rev'd on other grounds*, 396 F.2d 486, 158 USPQ 104 (CCPA 1968).

Although the timing of respondent's more recent policing efforts in 2009 diminishes their impact on the significance of the mark, respondent took steps to enforce its trademark rights even prior to the institution of this proceeding and the fact that many of the recipients complied with respondent's request to cease use of the BACKRACK trademark supports their recognition of BACKRACK as a trademark rather than a generic term.

ii) Failure to Police Keyword Purchases

According to petitioner, respondent's failure to police use of the term "backrack" in connection with certain internet activities, namely, third parties' purchase of the keyword "backrack" and use of the "backrack" term on eBay, contributes to the genericness of the BACKRACK mark.¹¹³ In support for this position, petitioner cites to *Rescuecom Corp. v. Google, Inc.*, 562 F.3d 123, 90 USPQ2d 1287 (2d Cir. 2009) and *Hearts on Fire Co., LLC v. Blue Nile, Inc.*, 2009 U.S. Dist. LEXIS 25968 (D. Mass. 2009).

As explained in *Rescuecom*, internet search engines such as Google, allow third parties to purchase terms (known as

¹¹² Jayne Disc. Dep. pp. 237-238 (Docket # 43).

"keywords"). When entered as a search term, the keyword triggers the appearance of the advertiser's ad and link to its website. Thus, by purchasing "backrack" as a keyword, sellers of headache racks can cause Google search results to display their ads and links whenever a user of Google launches a search based on the search term "backrack." *Rescuecom*, 90 USPQ2d at 1289.

While respondent admitted that it never investigated whether others use the BACKRACK trademark to attract purchasers to their site such as by purchasing "backrack" as a keyword,¹¹⁴ petitioner's argument is not compelling for several reasons. First, the *Rescuecom* and *Hearts on Fire* cases cited by petitioner were decided in 2009, well after this cancellation proceeding was instituted. Second, the state of the law in this area is far from clear. Only recently has a federal court of appeals provided a plaintiff trademark owner with the opportunity to show that Google's keyword program creates a likelihood of confusion. And its decision stopped short of determining whether the plaintiff is likely to succeed in proving that the sale of trademarks as keywords infringes its trademark rights. See *Rosetta Stone Ltd. v. Google, Inc.*, 676 F.3d 144, 102 USPQ2d 1473, (4th Cir. 2012). In view of the evolving status of the case law in this area, respondent's failure to pursue purchasers

¹¹³ Petitioner's Brief pp. 11-12, 29-30.

of "backrack" as a keyword is not evidence of failure to police its mark.

Moreover, the fact that other parties purchase "backrack" as a keyword is not probative of the significance of the term without evidence of why they purchased it as a keyword. If parties purchase "backrack" as a keyword due to its trademark significance, i.e., its association with respondent's products, this undermines the alleged genericness of the mark.

Interestingly, it appears that competitors and distributors have purchased "backrack" as a keyword. When "backrack" is entered into an internet search, websites other than respondent's site are identified in the search results. Clicking through to these websites reveals that they identify competitive products as truck racks, cab racks, truck headache racks, headache racks, but not as "back racks."¹¹⁵ This is consistent with other evidence discussed above that shows sellers of headache racks do not use the term BACKRACK as the generic term for headache racks in their promotional materials.

In an effort to protect its BACKRACK trademark, respondent has recovered domain name registrations that include the term "backrack" from third parties, redirecting

¹¹⁴ Jayne Disc. Dep. P. 302 (Docket # 43).

¹¹⁵ Setteducati Dep. I. pp. 78-80, 83-89, 102-111 (Docket # 53), STK Exhibit 99A-C, G (Docket # 54).

such domains to its own website, and maintains at least 13 different domain name registrations that include its BACKRACK trademark to ensure they are not registered to others:¹¹⁶

backrack.biz
backrack.bz
backrack.ca
backrack.cc
backrack.com
backrack.de
backrack.info
backrack.mobi
backrack.org
backrack.tv
backrack.us
backrack.us.com
backrack4trucks.com.

Petitioner points to consumers' alleged use of "backrack" as a noun on various internet sources such as eBay, plowsite.com, craigslist.org and blogs, arguing this evidences that "backrack" has become a generic term for a headache rack.¹¹⁷ A review of this evidence reveals that the vast majority of it is so ambiguous that is impossible to draw any reliable conclusions. For example, of the 23 exhibits in STK Exhibit 100, four specifically refer to respondent's product, six show the term "Backrack" with a capital letter "B" indicating possible trademark

¹¹⁶ Jayne Test. Dep. pp. 21-22 (Docket # 56); Backrack Exhibit 119, No. 26 (Docket # 57); STK Exhibit 118 Registrant's Objections and Answers to Petitioner's First Set of Interrogatories to Registrant Nos. 8 and 13 (Docket # 45).

¹¹⁷ Petitioner's Brief pp. 11, 29-30; Setteducati Dep. I pp. 128-169 (Docket # 53), Exhibit 100A-W (Docket # 54). Petitioner did not contact any of the persons placing the listings and does not

significance, and eleven others are inconclusive in that it is not possible to ascertain whether the "backrack" product referred to in the listing is an actual BACKRACK brand product. Thus, of the 23 listings, 10 support the trademark significance of BACKRACK and 11 are inconclusive. The remaining two exhibits in STK Exhibit 100 are copies of postings from internet chat forums selected by petitioner to show misuse of the BACKRACK trademark. Although a number of the postings appear to utilize the term "backrack" as a noun ("where is the cheapest place to get a backrack," "I plan on getting a backrack . . .") they lack critical information such as whether the person was referring to a BACKRACK brand product, and are therefore not probative. Similarly, in an eBay search identifying 44 results for "back rack," only 5 of those listings have accompanying images that do not feature the BACKRACK brand product.¹¹⁸

The foregoing evidence does not show either that the public uses, or understands, the term "backrack" to be generic and therefore does not support the genericness of the mark. See *In re 1800Mattress.com IP LLC*, 586 F.3d 1359, 92 USPQ2d 1682, 1685 (Fed. Cir. 2009).

know if what is shown in the images corresponds to the listings. Setteducati Dep. II pp. 121-122 (Docket # 55).

¹¹⁸ It is noted that 3 of these 5 listings appear to be on behalf of Highway Products and thus do not constitute additional uses by a third party. Setteducati Dep. I. pp. 181-189 (Docket # 53), STK Exhibit 103 (Docket # 54).

C. Summary

Petitioner has the burden of overcoming the registration's presumption of validity and showing by a preponderance of the evidence that the term BACKRACK is used or understood by the relevant public primarily to refer to headache racks rather than a particular headache rack manufactured and sold by respondent. *Magic Wand*, 19 USPQ2d at 1554; *Dan Robbins & Assoc.*, 202 USPQ at 105.

As revealed by the foregoing discussion, there is a mixed record in this case. However, this does not preclude us from holding that BACKRACK has not become a generic term for headache racks. See *In re America Online, Inc.*, 77 USPQ2d 1618, 1623 (TTAB 2006). The determination of genericness is heavily dependent on the factual circumstances. The cases on which petitioner relies are distinguishable from the present case. Unlike the circumstances in this case, several of the cases cited by petitioner found the term at issue to be generic due to the lack of use of another term that described the product at issue. See, *Colt Defense LLC v. Bushmaster Firearms Inc.*, 486 F.3d 701, 82 USPQ2d 1759 (1st Cir. 2007) (Colt did not identify any term that described the characteristics of its type of gun; articles written for consumers utilized term in generic sense; term used generically by several competitors in their advertising); *Pilates Inc. v. Current Concepts*

Inc., 120 F.Supp2d 286, 57 USPQ2d 1174 (S.D. N.Y. 2000) (evidence established that no other word was used to describe the products and services based on the Pilates method, PILATES is necessary to describe the exercises and teachings that comprise the Pilates method); *Bayer Co., Inc. v. United Drug Co.*, 272 F. 505 (S.D.N.Y. 1921) (consumers only knew product as "Aspirin"); *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938) (competitor entitled to use name by which product generally known "Shredded Wheat"); *In re Sports Tigers*, 213 USPQ 670, 671 (TTAB 1982) (HOCKER used as apt and only name for athletic game), and in other cases, the trademark owner failed to take steps to identify the mark as a trademark, see *Birtcher Electro Medical Systems Inc. v. Beacon Laboratories Inc.*, 738 F.Supp. 417, 16 USPQ2d 1411 (D. Colo. 1990) (none of the publicly disseminated literature designated the term as a trademark by using the ™ symbol; application for registration of the term claimed as a trademark was never made).

We find that the evidence of generic use of respondent's BACKRACK mark is offset by evidence of the overall context of respondent's trademark use of the term BACKRACK, a less than rigorous but sufficient level of policing and control over use of the mark by others, recognition of the trademark significance of the mark by competitors and sellers, and a lack of evidence that the

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primary understanding of the term BACKRACK to end-purchasers of headache racks is as a generic term.

Decision: The petition for cancellation of Registration No. 3014986 is dismissed with prejudice.