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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Watercraft Superstore, Inc.

Serial No. 86369831

Zachary D. Messa of Johnson, Pope, Bokor, Ruppel & Burns, LLP for Watercraft Superstore, Inc.

Angela Micheli, Trademark Examining Attorney, Law Office 101 (Ronald R. Sussman, Managing Attorney).

Before Kuhlke, Mermelstein, and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Watercraft Superstore, Inc. (“Applicant”) filed an application for registration on the Principal Register of the mark WATERCRAFT SUPERSTORE in standard characters for “Online retail stores services featuring personal watercraft parts and accessories.”¹ Applicant requested registration under Section 2(f), 15 U.S.C. § 1052(f), stating that “The mark has become distinctive of the goods/services

¹ Application Serial No. 86369831 was filed on August 18, 2014 under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), stating November 28, 2008 as the date of first use and first use in commerce.

through the applicant's substantially exclusive and continuous use in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement." Applicant has disclaimed the exclusive right to use SUPERSTORE apart from the mark as shown.

The Examining Attorney refused registration on the ground that Applicant's mark is merely descriptive of Applicant's services, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), and that Applicant had not shown that the mark had acquired distinctiveness. When the refusal was made final, Applicant appealed to this Board. The case is fully briefed.

1. Refusal under Section 2(e)(1).

Where, as here, an applicant requests registration based on acquired distinctiveness under Section 2(f), the examining attorney need not prove that the mark is merely descriptive. Rather, the mark's "lack of inherent distinctiveness [is] an established fact." *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988). The question of inherent distinctiveness "is a nonissue" under Section 2(f), and the only remaining issue is acquired distinctiveness. *Id.*

Acquired distinctiveness is generally understood to mean an acquired "mental association in buyers' minds between the alleged mark and a single source of the product." 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 15:5 (4th ed. June 2016 update). "It is only necessary that a 'substantial part' of the buying class make such an association." *Id.* §15:45. The Trademark Act is silent as to the

quantum of evidence that is necessary to establish acquired distinctiveness, except for the provision of Section 2(f) that states, “The Director *may* accept as *prima facie* evidence that the mark has become distinctive ... proof of substantially exclusive and continuous use” of the mark in commerce for the immediately preceding five years. 15 U.S.C. § 1052(f) (emphasis added). We determine whether Applicant’s mark has acquired distinctiveness based on the entire record, keeping in mind that Applicant has the “ultimate burden of persuasion” as to acquired distinctiveness. See *Yamaha v. Hoshino Gakki*, 6 USPQ2d at 1004. The amount and character of evidence required to establish acquired distinctiveness depends on the facts of each case and the nature of the mark sought to be registered. See *Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 829, 166 USPQ 34, 39 (CCPA 1970); *In re Hehr Mfg. Co.*, 279 F.2d 526, 528, 126 USPQ 381, 383 (CCPA 1960). Typically, more evidence is required where a mark is so highly descriptive that purchasers seeing the matter in relation to the offered services would be less likely to believe that it indicates source in any one party. See *In re Bongrain Int'l Corp.*, 894 F.2d 1316, 1318, 13 USPQ2d 1727, 1729 (Fed. Cir. 1990).

The Examining Attorney has shown that a “superstore” is “a very large retail store offering a very wide selection of merchandise.”² She has also shown that “watercraft” means “any vehicle ordinarily used for water transportation.”³ It is, moreover, manifest from Applicant’s recitation of services that Applicant’s store

² Definition from <collinsdictionary.com> American English Dictionary, Office Action of December 11, 2014 at 4. The usage example provided in the definition of “superstore” is “*a computer superstore*.”

³ *Id.* at 6.

features parts and accessories for “personal watercraft.” Clearly, Applicant’s mark, as a whole, is very highly descriptive. The Examining Attorney argues that, because of this high degree of descriptiveness, “the applicant has the burden to show a high level of secondary meaning.”⁴

Applicant has submitted the declaration of its general manager, John Salvatore, which states that Applicant has operated its online store “continuously, and upon information and belief, substantially exclusively” under its mark since November, 2008.⁵ Applicant’s declarant stated that during the years 2009 through 2014, the number of orders it took increased steadily from approximately 15,000 to 26,000 per year;⁶ its advertising expenditures in 2011 through 2014 ranged between \$201,000 and \$376,000 per year (averaging \$281,842);⁷ that in 2011 through 2014, it distributed 477,376 copies of its catalogue (averaging 119,344 copies per year);⁸ and that its website registered over 80,000 “unique user impressions” per year in 2009 through 2012 and over 119,000 per year in 2013 and 2014.⁹ Applicant’s declarant listed 12 tradeshows and events at which it has advertised its services under the mark.¹⁰

⁴ Examining Attorney’s brief at 6.

⁵ Declaration of John Salvatore, ¶¶ 3-4, Applicant’s response of July 7, 2015 at 1.

⁶ *Id.* at 3-4, ¶ 12.

⁷ *Id.* at 3, ¶ 11.

⁸ *Id.*, ¶ 10.

⁹ *Id.* at 1-2, ¶ 5.

¹⁰ *Id.* at 3, ¶ 9.

The Examining Attorney argues that the probative value of Applicant's sales and advertising figures is lessened because they are offered "with no context to show whether [A]pplicant's sales are significant in relation to others who provide similar services"; and argues that Applicant's sales and advertising figures "are insufficient to show its success in educating the public to associate the proposed mark with a single source."¹¹ Such context would improve the nature of the evidence. However, the evidence does show that Applicant has meaningful, *bona fide* and ongoing operations, even though it would likely be characterized as a small business. Of course, even if Applicant's sales and advertising figures were much greater, they would not be direct evidence of "success in educating the public." As we discuss below, Applicant has taken a different approach to demonstrating actual market recognition.

Since 2009, Applicant has operated an online forum for the discussion of personal watercraft, called PWC Today.¹² Applicant has made of record many pages of postings by users of that forum,¹³ many of which clearly recognize WATERCRAFT SUPERSTORE as the source indicator for Applicant's online retail store. According to Applicant's tabulation,¹⁴ users from 21 States have shown such recognition. Notable examples follow (the names of the posters and their given locations are in parentheses):

¹¹ Examining Attorney's brief, 9 TTABVUE 7.

¹² Salvatore declaration, ¶ 7, Applicant's response of July 7, 2015 at 2.

¹³ Salvatore declaration, Exhibit 7, Applicant's response of June 10, 2015 at 86-154.

¹⁴ *Id.* at 84-85.

Does anyone know if the gasket / O ring are supplied when purchasing a block off plate from Watercraft superstore? (needforspeed, New Jersey)¹⁵

I bought a new set of traction mats from The Watercraft Superstore on black Friday for half price. ... Watercraft SS sent me the mat without the hole for the visibility as per my request ... (TC Dave, South Carolina)¹⁶

Does anybody know of any Vendor Black Friday Sales This Year? Post any known sales. I know Watercraft Superstore Usually runs 50% off BlackTip Jetsports, hopefully that deal is still in order this year! (Mcarp6, New Jersey)¹⁷

I ordered a rebuild kit from Watercraft Superstore (SBT branded kit, with China bearings... failed bearings were Korean. But I found this pump (900 ZXI) did not exactly match any of the several manuals I have ... (OldGuy, Minnesota)¹⁸

Just weird that both of the cylinders o-ring was the same. Also, I looked at Watercraft Superstore and they had the piston rings and o-rings all for around \$70 plus shipping. That partsland.com showed that just one set of rings was gonna be \$70! (mallen14, Dalton, Georgia)¹⁹

I was wondering where to order a new fuel pump since I could not find one at SBT or watercraft superstore. (chuckrock77, Branson, Missouri)²⁰

I ordered a new fuel tank cover and hinge from watercraft superstore and I can't figure out how it goes on ... A new lock is like 80 bucks from wcs ... I really don't want to

¹⁵ *Id.* at 91.

¹⁶ *Id.* at 94.

¹⁷ *Id.* at 95.

¹⁸ *Id.* at 96.

¹⁹ *Id.* at 100.

²⁰ *Id.* at 103.

spend \$80 on just a lock for this 24 year old ski, haha.
(rafaelbachman, Grass Valley, California)²¹

Could someone please tell me a good place to purchase a complete winch assembly? (J_M_G_S_D, Edmond, Oklahoma)

I got mine from Watercraft Superstore and I love it. ...
(coolcam_6, Colorado Springs, Colorado)

I looked there, I a could find [sic] is the winch. I need the completed setup, the winch stand and the winch.
(J_M_G_S_G, Edmond Oklahoma)²²

The record includes over fifty postings, similar to those quoted above, in which it is clear from context that the consumer recognizes WATERCRAFT SUPERSTORE as Applicant's source indicator. We note also that several users of the forum use the abbreviations WCSS, WCS, and Watercraft SS in the apparent expectation that other readers will understand them as references to Applicant.

The Examining Attorney says of the evidence from PWC Today that "The applicant's forum appears on applicant's website, so consumers who use the forum know on what site they are posting"²³ This statement is not entirely accurate and fails to convince. Although Applicant operates and advertises on the PWC Today website at <pwctoday.com>, the site is separate from Applicant's retail store website at <watercraftsuperstore.net>. We see nothing on the website that clearly indicates that it is a website of Applicant, although some of the users of the website acknowledge that Applicant "sponsors" the site or is "tied to" the website.

²¹ *Id.* at 108.

²² *Id.* at 126.

²³ Examining Attorney's brief, 9 TTABVUE 8.

In order to demonstrate the weakness of Applicant's mark and that Applicant has not made exclusive use of its mark, the Examining Attorney points to Google search results that include references to third parties that may be using the terms "watercraft" and "superstore" together.²⁴ We note the following references:

Sea-Doo Watercraft from PARCS Superstore
Personal Watercraft Products – Got Gear Superstore
Personal Watercraft Covers at Tarp & Cover Superstore
Watercraft parts – TDR and Banshee Superstore
Personal Watercraft and Jetski Superstore
Powersport Superstore WaterCraft Accessories
Aquamoto Watercraft Superstore

Evidence that third parties in an applicant's field use the same or substantially the same wording as the alleged mark tends to indicate that the mark has not acquired distinctiveness. *In re White Jasmine LLC*, 106 USPQ2d 1385, 1395 (TTAB 2013). However, the evidence described above does not show such third-party use. The only reference that uses the words "watercraft superstore" together is "Aquamoto Watercraft Superstore."²⁵ However, this reference appears to be a long list of the sponsors of the 2015 Daytona Freeride event,²⁶ on which Applicant happens to be identified immediately after the sponsor identified as "Aquamoto." The other references demonstrate not that others in the watercraft industry have used marks

²⁴ Salvatore declaration, Exhibit 4, Applicant's response of June 10, 2015 at 30-42.

²⁵ *Id.* at 37.

²⁶ Applicant's declarant stated that Applicant has participated in the Daytona Freeride event. Salvatore declaration ¶ 9, Applicant's response of July 7, 2015 at 3.

similar to Applicant's mark, but rather that they have used different marks, such as "PARCS Superstore," "Got Gear Superstore," and "Tarp & Cover Superstore." Accordingly, this evidence does not demonstrate that Applicant's use of WATERCRAFT SUPERSTORE has not been substantially exclusive.

The Examining Attorney argues that, because Applicant's mark is so highly descriptive, recognition of Applicant's asserted trademark rights in the mark would "put [A]pplicant at an unfair advantage over competitors."²⁷ However, the Trademark Act and the common law contemplate that a business may fairly and legitimately acquire rights in a descriptive term that has acquired distinctiveness as an indicator of source. The Examining Attorney does not contend that Applicant's mark is generic and therefore incapable of acquiring distinctiveness for Applicant's services.

Applicant has shown that it has established, over the course of seven years, a substantial business and has vigorously promoted its services under the mark WATERCRAFT SUPERSTORE in such a way as to have created, among its customers, an association between its mark and its services. Applicant has demonstrated actual market recognition of its mark as a source-indicator with evidence of spontaneous comments of relevant customers and potential customers. We note that the large amount of public commentary offered by Applicant appears to be devoid of examples suggesting that customers would spontaneously refer to the stores of others as "watercraft superstores." The evidence submitted by the

²⁷ Examining Attorney's brief, 9 TTABVUE 7.

Examining Attorney does not show such uses by the relevant public; nor does it show third-party merchants using “watercraft superstore” to identify or describe their services. In any *ex parte* proceeding we do not have the benefit of the types of information about the marketplace that could be presented by an interested third party. However, on this record, Applicant has demonstrated that it has developed the type of good will in its mark and business that, under appropriate circumstances, is protectable under the trademark laws. We find, therefore, that Applicant’s mark WATERCRAFT SUPERSTORE has become distinctive of Applicant’s services within the meaning of Section 2(f) and is accordingly entitled to registration on the Principal Register.

Decision: The refusal to register Applicant’s mark is REVERSED.