

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: December 18, 2020

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board**

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In re Pacific Whale Foundation
—————

Serial Nos. 87891322, 87891333, 87891351, and 87891363
—————

Rebecca O. Filipović and Shannon S. Sheldon of McKeon Sheldon Mehling LLC,
for Pacific Whale Foundation.

John T. Billings, Trademark Examining Attorney, Law Office 113,
Myriah Habeeb, Managing Attorney.

—————
Before Cataldo, Bergsman, and Pologeorgis,
Administrative Trademark Judges.

Opinion by Pologeorgis, Administrative Trademark Judge:

Pacific Whale Foundation (“Applicant”) seeks registration on the Principal
Register of the following marks:

1. PACIFIC WHALE FOUNDATION (in standard characters; FOUNDATION
disclaimed);¹

¹ Application Serial No. 87891322, filed on April 24, 2018, based on an allegation of use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. 1051(a), claiming December 9, 1980 as both the date of first use and the date of first use in commerce for all the identified classes of services.



2. (FOUNDATION disclaimed);²



3. (FOUNDATION disclaimed);³ and



4. (FOUNDATION disclaimed)⁴.

Each of Applicant's applications identify the following services:

Promoting the public awareness of the need for marine wildlife conservation; charitable services, namely, organizing and developing projects to promote awareness of ocean and marine wildlife conservation; promoting public awareness of environmental protection,

² Application Serial No. 87891333, filed on April 24, 2018, based on an allegation of use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. 1051(a), claiming August 26, 2016 as both the date of first use and the date of first use in commerce for all the identified classes of services. The description of the mark reads as follows: "The mark consists of a stylized image of a whale tail behind which is a solid square with curved edges all above the literal element 'PACIFIC', which is directly above the literal element 'WHALE', which is directly above a horizontal line separating the literal elements 'PACIFIC WHALE' from the literal element 'FOUNDATION', all equally justified." Color is not claimed as a feature of the mark.

³ Application Serial No. 87891351, filed on April 24, 2018, based on an allegation of use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. 1051(a), claiming December 31, 2010 as both the date of first use and the date of first use in commerce for all the identified classes of services. The description of the mark reads as follows: "The mark consists of a stylized image of a whale tail, behind which is a solid square with curved edges, all of which is to the left of the literal element 'PACIFIC WHALE' situated above a horizontal line and the literal element 'FOUNDATION' below said horizontal line." Color is not claimed as a feature of the mark.

⁴ Application Serial No. 87891363, filed on April 24, 2018, based on an allegation of use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. 1051(a), claiming August 26, 2016 as both the date of first use and the date of first use in commerce for all the identified classes of services. The description of the mark reads as follows: "The mark consists of a stylized image of a whale tail behind which is a solid square with curved edges followed by the literal element 'PACIFIC WHALE FOUNDATION'." Color is not claimed as a feature of the mark.

ocean conservation and marine wildlife conservation; promoting public interest and awareness of ocean and marine wildlife conservation and protection, ocean and marine environmental sustainability practices, and of the need for and benefits of education, science and research relating to ocean and marine ecosystems; retail store services featuring souvenirs, gifts, educational materials and toys relating to ocean and marine wildlife conservation, in International Class 35;

Charitable fundraising services by means of organizing and conducting projects to promote awareness of whale and ocean conservation, in International Class 36;

Conducting education exhibitions in the field of ocean and marine wildlife conservation; education services, namely, providing classes, seminars and workshops in the field of environmental protection, ocean and marine wildlife conservation and marine biology; educational services, namely, providing symposiums and conferences in the field of the conservation and preservation of the environment and of nature; organization of educational symposiums and conferences on the topic of environmental conservation and preservation; production of videos featuring environmental preservation and conservation issues; photography; ocean photography; marine wildlife photography, in International Class 41; and

Scientific research and consultation services in the field of marine wildlife conservation; scientific consulting services concerning conservation of reefs and development of man-made marine habitat; scientific research and consultation in the field of marine life environment; scientific research in the fields of whale and ocean conservation; scientific research relating to environmental protection; scientific research in the field of environmental conservation and preservation and preparing related expert reports and evaluations; providing scientific information and online scientific information about environmental conservation and preservation, in International Class 42.

For each application, Applicant claims acquired distinctiveness under Section 2(f) of the Trademark Act as to the wording “PACIFIC WHALE FOUNDATION” in its entirety.

The Trademark Examining Attorney refused registration of each of Applicant’s marks under Section 6(a) of the Trademark Act, 15 U.S.C. § 1056(a), based on

Applicant's failure to comply with the requirement to disclaim WHALE FOUNDATION because it is purportedly generic of Applicant's identified services within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), and is thus an unregistrable component of the mark.

When the Examining Attorney made the refusals final, Applicant appealed. The appeals are fully briefed. After Applicant submitted its appeal briefs, the Board granted Applicant's motion to consolidate the appeals.⁵ We therefore decide all four appeals in a single opinion. For the reasons explained below, we reverse the refusals to register.⁶

I. Disclaimer Requirement - Applicable Law

An examining attorney may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. Trademark Act Section 6(a), 15 U.S.C. § 1056(a). A "disclaimer" is a statement that an applicant does not claim exclusive rights to an unregistrable component of a mark:

[A] disclaimer of a component of a composite mark amounts merely to a statement that, in so far as that particular registration is concerned, no rights are being asserted in the disclaimed component standing alone, but rights are asserted in the composite; and the particular registration represents only such rights as flow from the use of the composite mark.

⁵ 4 TTABVUE in application Serial No. 87891322; 5 TTABVUE in application Serial No. 87891322.

⁶ Unless otherwise specified, all TTABVUE and Trademark Status and Document Retrieval ("TSDR") citations reference the docket and electronic file database for application Serial No. 87891322. All citations to the TSDR database are to the .pdf version of the documents.

Sprague Elec. Co. v. Erie Resistor Corp., 101 USPQ 486, 486-87 (Comm’r Pats. 1954). Merely descriptive or generic terms are unregistrable under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), and therefore are subject to disclaimer if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is grounds for refusal of registration. *In re Omaha Nat’l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46 (CCPA 1975); *In re National Presto Indus. Inc.*, 197 USPQ 188 (TTAB 1977); and *In re Pendleton Tool Indus. Inc.*, 157 USPQ 114 (TTAB 1968).

II. Genericness

A generic term “is the common descriptive name of a class of goods or services.” *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 114 USPQ2d 1827, 1830 (Fed. Cir. 2015) (citing *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986)). There is a two-part test used to determine whether a designation is generic: (1) what is the genus (class or category) of goods or services at issue?; and (2) does the relevant public understand the designation primarily to refer to that genus of goods or services? *Princeton Vanguard*, 114 USPQ2d at 1803 (citing *Marvin Ginn*, 228 USPQ at 530); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1462 (TTAB 2014). “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.” *Marvin Ginn*, 228 USPQ at 530. The USPTO must demonstrate a term is generic by “clear evidence” of generic use. *See In re Hotels.com*

LP, 573 F.3d 1300, 91 USPQ2d 1532, 1533 (Fed. Cir. 2009); *In re Merrill Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987).

Any term that the relevant public uses or understands to refer to the genus of services, or a key aspect or subcategory of the genus, is generic. *Royal Crown Co., Inc. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1046-47 (Fed. Cir. 2018). “[A] term is generic if the relevant public understands the term to refer to part of the claimed genus of goods or services, even if the public does not understand the term to refer to the broad genus as a whole.” *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632, 1638 (Fed. Cir. 2016) (holding CHURRASCOS, a word that is generic for a type of grilled meat, to be generic for restaurant services because it referred to a key aspect of those services); *see also In re Nordic Naturals, Inc.*, 755 F.3d 1340, 111 USPQ2d 1495 (Fed. Cir. 2014) (CHILDREN’S DHA generic for DHA supplements for children); *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985) (BUNDT generic for ring cake mixes, *i.e.*, the subcategory “bundt cakes.”).

“Evidence of the public’s understanding of the term may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers and other publications.” *Royal Crown*, 127 USPQ2d at 1046 (quoting *Merrill Lynch*, 4 USPQ2d at 1143); *see also Cordua*, 118 USPQ2d at 1634; *Princeton Vanguard*, 114 USPQ2d at 1830; *In re Reed Elsevier Props. Inc.*, 482 F.3d 1376, 82 USPQ2d 1378, 1380 (Fed. Cir. 2007) (finding third-

party websites competent sources for determining what the relevant public understands mark to mean).

A. What is the Genus of the Services at Issue?

Our first task is to determine the proper genus. In defining the genus, we commonly look to the identification of goods or services in the application. *See Reed Elsevier*, 82 USPQ2d at 1380; *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) (a proper genericness inquiry focuses on the identification set forth in the application or certificate of registration); *In re Serial Podcast, LLC*, 126 USPQ2d 1061, 1063 (TTAB 2018) (proper genus generally is “set forth by the recitation of services in each subject application.”). The Examining Attorney argues that the genus of Applicant’s services is promoting awareness in the field of “ocean and marine wildlife conservation” and “ocean and marine ecosystems”, charitable fundraising in the field of “whales and ocean conservation”, educational programs in the field of “environmental protection, ocean and marine wildlife conservation, and marine biology” and scientific research and consultation in the fields of “whale and ocean conservation,” “marine wildlife conservation,” and “environmental protection.”⁷ Applicant argues that the relevant genus is “ocean and marine wildlife conservation, research, and education”, not “whale conservation, research, and education” because the subject matter of Applicant’s services relates to “ocean and marine wildlife as a

⁷ Examining Attorney’s Brief, p. 7; 8 TTABVUE 8.

holistic and all-encompassing environmental endeavor” and because the services do not relate “solely or even specifically to whales.”⁸

We agree with Applicant’s broader definition of the genus of Applicant’s identified services. Accordingly, we find that the appropriate genus of services at issue is the promotion of ocean and marine wildlife conservation and the scientific research and consultation, educational, and charitable fundraising services associated therewith. However, as properly noted by the Examining Attorney, a designation may nonetheless be deemed generic if the relevant public understands the designation to refer to a subcategory or key aspect of a good or service. *Royal Crown Co.*, 127 USPQ2d at 1046-47; *Cordua*, 118 USPQ2d at 1638.

We add that, inasmuch as neither the Examining Attorney nor Applicant raised arguments specifically attributed to the different classes in each application, we will not separately address each class of services but rather refer to them collectively as identified above. In doing so, we nevertheless base our analysis and conclusion as to each of the classes on the services as identified.

B. Who are the Relevant Purchasers?

The second part of the test is whether the relevant public understands the designation Applicant seeks to register primarily refers to that genus of goods or services at issue. “The relevant public for a genericness determination is the purchasing or consuming public for the identified goods [or services].” *Frito-Lay N. Am., Inc. v. Princeton Vanguard LLC*, 124 USPQ2d 1184, 1187 (TTAB 2017) (citing

⁸ Applicant’s Appeal Brief, p. 11; 6 TTABVUE 12.

Magic Wand, 19 USPQ2d at 1552); *Sheetz of Del., Inc. v. Doctor's Assocs. Inc.*, 108 USPQ2d 1341, 1351 (TTAB 2013). Because there are no restrictions or limitations to the channels of trade or classes of consumers for Applicant's identified services, the relevant consuming public consists of the public at large, namely, ordinary consumers who are interested in ocean and marine wildlife conservation, as well as those customers interested in charitable fundraising, educational services, and scientific research and consultation services provided in association with the promotion of ocean and marine wildlife conservation.

C. How does the Relevant Public Perceive the Designation WHALE FOUNDATION?

The Examining Attorney argues that the designation WHALE FOUNDATION is the generic name of a specific subcategory of Applicant's identified services, namely, the "conservation, research, and education on whales."⁹ In support of his argument, the Examining Attorney submitted the evidence summarized below:

1. Dictionary Definitions

The constituent elements of the wording WHALE FOUNDATION are defined as follows:¹⁰

- "whale" is defined as "any of various marine mammals of the order Cetacea;" and
- "foundation" is defined as "an institution established with an endowment, for example a research body or charity."

⁹ Examining Attorney's Brief, p. 7, 14 TTABVUE 8.

¹⁰ December 12, 2016 Office Action, TSDR pp. 11-15 and 19-20 (www.merriam-webster.com).

2. Plain Copies of Third-Party Registrations¹¹

The Examining Attorney submitted nine live, third-party registrations, all issued on the Supplemental Register, where a qualifying term(s) preceding the term FOUNDATION has/have been disclaimed along with the word FOUNDATION. All nine registered marks are in standard character form. The third-party registrations are identified below:¹²

- FAMILY FUNERALHOME FOUNDATION (Reg. No. 2523554) (FUNERALHOME FOUNDATION disclaimed) for, among other things, “educational services, namely, providing conferences, seminars and workshops in the fields of estate settlement, funeral services, and bereavement care”;
- NATIONAL BREAST CANCER FOUNDATION, INC. (Reg. No. 2576826) (BREAST CANCER FOUNDATION, INC. disclaimed) for, among other things, “Promoting public awareness of the need for prevention, detection and elimination of cancer by encouraging women to perform self-examinations of their breasts, obtain clinical examinations, and mammographies”;
- THE LEXINGTON CANCER FOUNDATION, INC. (Reg. No. 4270118) (CANCER FOUNDATION, INC. disclaimed) for “Charitable fundraising to support the fight against cancer and improving the quality of healthcare for cancer patients”;
- INTERNATIONAL ANTI-POACHING FOUNDATION (Reg. No. 4787607) (ANTI-POACHING FOUNDATION disclaimed) for “Charitable fundraising in aid of animal wildlife conservation”;
- BAINUM FAMILY FOUNDATION (Reg. No. 5083936) (FAMILY FOUNDATION disclaimed) for, among other things, “Research in

¹¹ October 15, 2019 Final Office Action, TSDR pp. 24-49.

¹² In its Appeal Brief, Applicant refers to various office actions purportedly issued during the prosecution of some of the underlying applications of the third-party registrations submitted by the Examining Attorney. *See* Applicant’s Brief, p. 20; 6 TTABVUE 21. Applicant, however, did not submit copies of these purported office actions prior to appeal. Thus, we give no consideration to any arguments presented by Applicant based on these purported office actions.

the fields of medical and health-related services, including nutrition services, health and medical services, mental health counseling services, and developmental and behavioral health services for at-risk and indigent individuals”;

- TEXAS WINE FOUNDATION (Reg. No. 5352308) (WINE FOUNDATION disclaimed) for “Charitable foundation services, namely, providing fundraising activities and financial support for the Texas wine and grape industry”;
- AMERICAN VETERANS FOUNDATION (Reg. No. 5273101) (VETERANS FOUNDATION disclaimed) for, among other things, “Promoting public awareness of veterans and veterans issues” and “Charitable foundation services, namely, providing financial support to veterans for payment of housing bills, food bills, clothing bills and medical bills”;
- MICHIGAN ANIMAL WELFARE FOUNDATION (Reg. No. 5619342) (ANIMAL WELFARE FOUNDATION disclaimed) for “Charitable fundraising services, by means of organizing and conducting events to benefit animal rescue organizations”; and
- LAMPIDIS CANCER FOUNDATION (Reg. No. 5735744) (CANCER FOUNDATION disclaimed) for “Providing a website featuring information in the field of cancer research”.

3. Internet Articles and Blogs

- The Ocean Update: whalesandmarinefauna.wordpress.com (“Scuba Junkie Marine Beach Resort marine biologist Ric Owen said experts from universities and **whale foundations** believed the mammal could be breeding in deep waters bear Semporna”);¹³
- Whales Need Saving: www.whalesneedsaving.weebly.com/, (“With the money we will donate to other **whale foundations** and we will adopt whales and help them.”);¹⁴
- Redbubble: www.redbubble.com, an online retailer (50% of all proceeds go to **whale foundations**);¹⁵

¹³ March 12, 2019 Office Action, TSDR p. 5.

¹⁴ *Id.*, TSDR p. 6.

¹⁵ *Id.*, TSDR pp. 7-8.

- TripAdvisor: www.tripadvisor.com/Attraction_Review-g60942-d108756-Reviews-Pu_ukohola_Heiau-Kawaihae_Island_of_Hawaii_Hawaii.html (“When we stopped in, a **whale foundation** has set up shop with binoculars so we could see the whales breaching off the coast.”);¹⁶
- Cruise Critic blog entry – www.boards.cruisecritic.com (“But if we do have to be at the **whale foundation** 45 minutes early, we won’t have time for much but lunch before whale watching.”);¹⁷
- Flock Call: www.flockcall.com (“I always loved animals as a youngster, and I even wrote to and sponsored **whale foundations**, but I found my passion for parrots when I was 18 years old, after bringing a Green-cheeked Conure into my home — and soon after, an African grey.”);¹⁸
- Gyuha Bau’s Blog: www.ghb0219.blogspot.com (“Recently, whales are in danger. Thoughtless whaling is threatening whales and it is causing the extinction of many whale species. You can donate money to help these whales. There are many **whale foundations** you can donate to.”);¹⁹
- MavicPilots: www.mavicpilots.com (“There seems to be a fuzzy line on drones and whale watching and I didn’t want to be scrutinized by anyone by posting any of those. Btw, I was on the beach next to **the whale foundation** located here.”);²⁰
- Gramho: www.gramho.com (“Also, “fantastic to know that all money from excursions goes to **whale foundations**”);²¹
- Sailing Anarchy, www.forums.sailinganarchy.com (These environmentalists and **whale foundations** saw us as the anti-christ. Funny thing is, one of the more well known **whale**

¹⁶ *Id.*, TSDR pp. 9-10.

¹⁷ *Id.*, TSDR p. 14.

¹⁸ *Id.*, TSDR p. 15.

¹⁹ *Id.*, TSDR pp. 16-17.

²⁰ *Id.*, TSDR pp. 11-12.

²¹ October 15, 2019 Final Office Action, TSDR p. 21.

foundations hit 3 whales in '09 on their whale watching vessels.”);²²
and

- The Associated Press State & Local Wire: An article titled “**Whale foundation** opposes carbon dioxide experiment off Kauai” (The Pacific Whale Foundation is protesting a proposed experiment off Kauai that would involve pumping 20 metric tons of pressurized carbon dioxide gas into the depths of the Pacific Ocean over a two-week period. According to Dwayne Meadows, director of research at the **whale foundation**, the public also spoke against the proposed dumping of carbon dioxide off Keahole Point on the Big Island in 1999).²³

4. Excerpts from Applicant’s website²⁴

In addition to the foregoing evidence, the Examining Attorney maintains that Applicant’s own website demonstrates that Applicant consistently uses the term WHALE to identify a central feature and key aspect of its identified services. The Examining Attorney relies on the following excerpts from Applicant’s website to support his argument:

Founded by Greg Kaufman in 1980 as a 501(c)(3) nonprofit organization **dedicated to saving the world’s whales from extinction**, PWF has now grown into a social enterprise that offers fee-based programs and services through PacWhale Eco-Adventures to help fund its non-profit work”; “Though our efforts, millions have **learned about whales** and other marine life, like dolphins, Hawaiian monk seals, sea turtles, and the endangered Hawaiian population of false killer whales.

²² *Id.*, TSDR pp. 17-18.

²³ *Id.*, TSDR pp. 22-23. The Examining Attorney also submitted excerpts from the websites www.countryscapesart.com and www.legalrollercoaster.com which display the wording “save the whale foundations” and “killer whale foundations,” respectively. *See id.*, TSDR pp. 15-16 and 19-20. Because these two excerpts do not use the designation “whale foundation” standing alone, we do not find them probative in our analysis and, therefore, we have given them no consideration.

²⁴ *Id.*, TSDR pp. 12-14.

Our vision to be the people’s environmental organization for the protection of the world’s **whales**, dolphins, and other marine animals living wild in their natural habitat.

Discussing the founding of applicant’s foundation being specifically related to whales; “He committed his new organization to educating the public, from a scientific perspective, **about whales and their ocean habitat.**”

Discussing Applicant’s studies, all of which relate to the study of whales specifically; “Pacific Whale Foundation (PWF) is a pioneer in the use of non-invasive scientific techniques **to gather data about humpback whales.**”

The Examining Attorney therefore concludes that when the term WHALE is used in association with the word FOUNDATION, consumers will immediately perceive the term WHALE as identifying a key aspect and central feature of Applicant’s identified services.

Based on all the evidence he has submitted, the Examining Attorney maintains that he has established by clear evidence that the designation WHALE FOUNDATION is the generic name of Applicant’s identified services.

In challenging the refusals, Applicant argues that the Examining Attorney cites to no evidence of any instance in which Applicant has used its mark or the term WHALE FOUNDATION in a generic manner.²⁵ Additionally, Applicant maintains that the Examining Attorney ignored the evidence submitted by Applicant during the prosecution of its applications that purportedly demonstrates that the wording “pacific whale” in its involved marks has acquired distinctiveness.²⁶ Moreover, Applicant submitted countervailing third-party

²⁵ Applicant’s Appeal Brief, p. 9; 5 TTABVUE 10.

²⁶ *Id.* at pp. 8-10; 5 TTABVUE 9-11.

registrations for marks that use descriptive terms preceding the word FOUNDATION where the Office found only the term FOUNDATION to be generic, despite the preceding descriptive term being a subcategory or even directly relating to the services listed in the registrations. The registrations are as follows:²⁷

- AMERICAN HORSE FOUNDATION (Reg. No. 2215594 – Supplemental Register) (FOUNDATION disclaimed) for, among other things, “association services, namely, promoting equine related interests;”
- INTERNATIONAL CRANE FOUNDATION (Reg. No. 1843274 – Principal Register) (Section 2(f) as to INTERNATIONAL RHINO FOUNDATION; FOUNDATION disclaimed) for “promoting the public awareness and interest in the field of crane preservation; research in the field of crane preservation; preservation of cranes by such means as crane habitat conservation and restoration.”
- INTERNATIONAL RHINO FOUNDATION and design (Reg. No. 4719554 – Principal Register) (Section 2(f) as to “INTERNATIONAL RHINO FOUNDATION; FOUNDATION disclaimed) for, among other things, “promoting public awareness of the problems affecting the survivability of all species of rhinoceros and conservation efforts related thereto” in Class 35 and “charitable fundraising services,

²⁷ September 11, 2019 Response to Office Action, TSDR pp. 20-38. Applicant also submitted a copy of Reg. No. 5521486 issued on the Supplemental Register for the mark OREGON WILDLIFE FOUNDATION (OREGON disclaimed) for “promoting public interest and awareness in the fields of conservation and management of fish, wildlife, plants, and other natural resources.” Because this registration includes a disclaimer of OREGON, we find that it is not probative in our analysis and, therefore, we have given it no consideration.

Also, for the first time in its appeal brief, Applicant referenced additional registrations for the marks THE OCEAN FOUNDATION, THE GEORGIA SEA TURTLE CENTER, and REEF CHECK and identified the corresponding services, as well as the registration numbers, for these purported registered marks. *See* Applicant’s Appeal Brief, p. 13 n. 3; 6 TTABVue 14. Normally, a reference to or list of registrations submitted with an appeal brief would not be considered. Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d). However, the Examining Attorney did not object to this untimely evidence in his brief. Therefore, we will consider Applicant’s referenced registrations although the probative weight to be given to these referenced registrations without underlying copies of the registrations themselves is quite limited.

namely, fundraising for groups and programs promoting the preservation and conservation of rhinos” in Class 36.

- NATIONAL FISH AND WILDLIFE FOUNDATION and design (Reg. No. 4522682 – Principal Register) (Section 2(f) as to NATIONAL FISH AND WILDLIFE; FOUNDATION disclaimed) for, among other things, “promoting public interest and awareness in the fields of conservation and management of fish, wildlife, plants, and other natural resources.”
- CEDAR TREE FOUNDATION (Reg. No. 3258483 – Principal Register) (FOUNDATION disclaimed) for “providing grants to non-profit organizations in the fields of sustainable agriculture, environmental education, and environmental health; providing fellowships in environmental conservation and biodiversity research.”
- FIRST RESPONDER CHILDREN’S FOUNDATION (Reg. No. 5515859 – Supplemental Register) (FOUNDATION disclaimed) for “charitable foundation services, namely, providing fundraising activities, fundraising events in the nature of holiday celebration events, cinema events, and live theater events, funding, scholarships, grants and/or financial assistance for the support and education of children and families of first responders killed or permanently disabled in the line of duty as well as facilitating educational activities and programs created and operated by first responders and their affiliates which benefit the education and safety of children in their communities.”
- HOMEOWNERSHIP PRESERVATION FOUNDATION (Reg. No. 5564326 - Principal Register) (Section 2(f) as to HOMEOWNERSHIP PRESERVATION FOUNDATION; FOUNDATION disclaimed) for “providing counseling services in the field of mortgage debt management, and debt and credit counseling to consumers facing foreclosure that results in promoting, preserving and expanding homeownership.”
- REINING HORSE SPORTS FOUNDATION (Reg. No. 3741953 – Principal Register) (Section 2(f) as to REINING HORSE SPORTS FOUNDATION; FOUNDATION disclaimed) for, among other things, “promoting public awareness of the history of the sport of reining; association services, namely, promoting the interests of reining horse enthusiasts; Advertising services, namely, promoting the sport of reining.”

- THE HEART FOUNDATION (Reg. No. 5362591 – Principal Register) (Section 2(f) as to THE HEART FOUNDATION; FOUNDATION disclaimed) for, among other things, “charitable fundraising services for promoting research, education and other activities relating to the prevention, detection, treatment, and causes of heart disease; Charitable fundraising services to support the prevention, detection, treatment, and causes of heart disease.”

Based on the foregoing third-party registration evidence, Applicant submits that the designation WHALE FOUNDATION is not generic for its identified services and should not be disclaimed.²⁸

In an attempt to rebut the Examining Attorney’s argument that, based on Applicant’s own website, consumers will immediately perceive the term WHALE as identifying a key aspect and central feature of Applicant’s identified services, Applicant counters the argument by noting that the Examining Attorney ignored other important details on its website that explains its services more fully. Specifically, Applicant points to the following language on its website:²⁹

As leaders in the development of whale watching, Pacific Whale Foundation has been acutely aware of the ever-changing nature of the relationship between humans and marine mammals and **has developed a broad, holistic approach to marine tourism.**

For the past 40 years, our researchers have conducted studies and collected data to better understand **marine life** and how to best protect it...

We take pride in knowing that we have been at the forefront of educating the public, from a scientific perspective, **about marine life** and the world in which we live.

²⁸ Applicant’s Appeal Brief, p. 14; 5 TTABVUE 15.

²⁹ *Id.* at pp. 15-16; 6 TTABVUE 16-17 (emphasis added by Applicant).

These are just a few of the ways our operations help to fulfill **our mission to protect the ocean and inspire environmental stewardship.**

(emphasis by Applicant).

Finally, Applicant argues that the Internet evidence submitted by the Examining Attorney that references use of the designation “whale foundation” is “woefully inadequate to support a finding of genericness.”³⁰

We address each of Applicant’s arguments in turn. First, Applicant’s argument regarding the failure of the Examining Attorney to submit evidence demonstrating that Applicant uses the designation “whale foundation” generically for its identified services is unpersuasive. The fact that Applicant itself does not employ the phrase “whale foundation,” standing alone, in its advertising material is not fatal in the determination of whether the phrase is generic for Applicant’s identified services. As noted above, evidence of the public’s understanding of the term may be obtained from **any** competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers and other publications.

Second, Applicant’s argument that the Examining Attorney ignored Applicant’s submission of evidence demonstrating that the wording “pacific whale” in Applicant’s marks has acquired distinctiveness is unavailing. Applicant did not submit any evidence during the prosecution of its applications that would demonstrate that the wording “pacific whale,” standing alone, has acquired distinctiveness. Instead, Applicant’s Section 2(f) claim was made as to the wording PACIFIC WHALE

³⁰ *Id.* at p. 19; 6 TTABVUE 20.

FOUNDATION as a whole,³¹ which was accepted by the Examining Attorney.³² Thus, any reliance by Applicant that the wording “pacific whale” has acquired distinctiveness is misplaced.

Third, the fact that Applicant has submitted other portions of its website to provide a fuller description of the services provided under its involved mark does not detract from the fact that Applicant’s services include, among other things, the promotion of the awareness of whale conservation. This especially holds true since the service of promoting whale conservation is set forth in Applicant’s recitation of services.

Finally, we turn to Applicant’s argument that the evidence submitted by the Examining Attorney is inadequate to support a finding of genericness. We once again note that it is beyond dispute that “the burden of showing that a proposed trademark [or service mark] is generic remains with the Patent and Trademark Office.” *Merrill Lynch*, 4 USPQ2d at 1143. Moreover, it is incumbent upon the Examining Attorney to make a “substantial showing ... that the matter is in fact generic.” *Id.* Indeed, this substantial showing “must be based on clear evidence of generic use.” *Id.* Thus, “a strong showing is required when the Office seeks to establish that a term is generic.” *In re K-T Zoe Furniture Inc.*, 16 F.3d 390, 29 USPQ2d 1787, 1788 (Fed. Cir. 1994).

In this case, the Examining Attorney submitted excerpts from only 11 online articles and blogs we may consider, one of which refers specifically to Applicant. We

³¹ February 21, 2019 Response to Office Action, Declaration of Kristie Wrigglesworth, Acting Executive Director of Applicant; TSDR pp. 15-18.

³² March 12, 2019 Office Action; TSDR p. 2.

have said before that it is not necessary that an Examining Attorney submit all stories found, especially where there are a large number of them. However, a sufficient number of them should be made available to enable a determination to be made as to the meaning of the term in question to the relevant public. There was no indication from the Examining Attorney that the submitted articles or blog postings constitute a representative sample of the search results or the entirety of the search results. In view thereof, we presume the Internet evidence submitted by the Examining Attorney represents the entirety of the search results that supports the refusals to register.

We find that these 11 articles/blog postings showing limited generic use of the designation “whale foundation” are insufficient to demonstrate that the designation is the generic name of Applicant’s identified services. *See, e.g., Magic Wand v. RDB, Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1553 (Fed. Cir. 1991) (affirming dismissal of petition to cancel registration of TOUCHLESS for automobile washing services, based on Board’s finding that “the evidence demonstrates limited generic use of the term ‘touchless’ before members of the relevant purchasing public”); *In re Homes & Land Publishing Corp.*, 24 USPQ2d 1717, 1718 (TTAB 1992) (finding RENTAL GUIDE not generic for a real estate listing magazine for rental properties, where the Examining Attorney submitted only dictionary definitions of “rental” and “guide” and three articles using the term, one of which referred to applicant). We further note that Applicant’s website itself does not employ the wording “whale foundation,”

standing alone.³³ Finally, the countervailing third-party registration evidence submitted by Applicant diminishes the probative value of the third-party registration evidence submitted by the Examining Attorney.

Quite simply, based on this record, we find that the Examining Attorney has not met his difficult burden of making the substantial or strong showing required to establish by clear evidence that the designation WHALE FOUNDATION is generic for Applicant's identified services. At a minimum, we have doubts, on this limited record, as to whether relevant consumers would perceive the designation WHALE FOUNDATION as the generic name of Applicant's identified services, and such doubts on the issue of genericness should be resolved in Applicant's favor. *In re DNI Holdings Ltd.*, 77 USPQ2d 1435, 1437 (TTAB 2005); *In re Waverly Inc.*, 27 USPQ2d 1620, 1624 (TTAB 1993).

Decision: The refusals to register Applicant's involved marks based on the requirement, made under Trademark Act § 6(a), for a disclaimer of the wording WHALE FOUNDATION are reversed. Applicant's application Serial Nos. 87891322,

³³ Even though, as noted above, Applicant improperly argues that the wording "pacific whale," standing alone has acquired distinctiveness, it would be reasonable to conclude that relevant consumers, upon viewing Applicant's involved mark, would perceive the wording "pacific whale" as a unitary element of the mark, particularly since in two of the involved marks the wording PACIFIC WHALE appears above the term FOUNDATION separated by a horizontal line. In other words, consumers, who know the services offered under Applicant's mark, may view Applicant's marks as conveying that Applicant is a foundation which provides services, in part, that concern Pacific whales specifically and not whales in general. Such a reasonable perception appears to undermine the Examining Attorney's position that "whale foundation" is the generic name of Applicant's identified services.

Serial Nos. 87891322, 87891333, 87891351, and 87891363

87891333, 87891351, and 87891363 will proceed forward with the already disclaimed term FOUNDATION in each application.