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

Proceeding	87906630
Applicant	SP Plus Corporation
Applied for Mark	PARKING.COM
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application of:

SP Plus Corporation

Serial No.: 87/906,630

Filed: May 3, 2018

Mark: PARKING.COM

Trademark Examining Attorney:
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Law Office: 125

Commissioner for Trademarks
P.O. Box 1451
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APPLICANT'S APPEAL BRIEF

Applicant/Appellant, SP Plus Corporation (“Applicant” or “SP”), submits this Brief pursuant to its notice of appeal filed under 37 C.F.R. §§ 2.141 and 2.142.¹ Applicant disputes the Examining Attorney’s refusal to permit amendment of the instant application to the supplemental register. Applicant requests that this Board reverse the refusal, permit amendment of this application to seek registration on the Supplemental Register, and pass this mark to registration. To the extent the Examiner has maintained the 2(e) rejection, Applicant argues in the alternative that Applicant’s Mark has acquired distinctiveness.

¹ Per the Board’s order of March 29, 2021, this Brief is due by April 18, 2021. (11 T.T.A.B. VUE 1.) Accordingly, this Brief is timely.

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DESCRIPTION OF THE RECORD/EVIDENCE

On May 3, 2018, Applicant filed U.S. Application Serial No. 87/906,630 (the “Application”) seeking registration of the mark PARKING.COM (“Applicant’s Mark”) on the Principal Register for use with a “[w]ebsite providing information regarding parking availability” in International Class 039 (“Applicant’s Services”).²

On September 4, 2018, Examining Attorney Teague Avent (the “Examiner”) issued a first non-final office action (the “First Office Action”) refusing registration of Applicant’s Mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1) as allegedly being merely descriptive of a characteristic of Applicant’s Services.

On January 29, 2019, in response to the First Office Action, Applicant (i) filed an amendment to allege use under Section 1(c) of the Lanham Act and (ii) presented evidence and arguments against the Section 2(e)(1) rejection, including that Applicant’s Mark has acquired distinctiveness in the marketplace.

On March 11, 2018, the Examiner issued a second non-final office action (the “Second Office Action”) maintaining the refusal of registration under Section 2(e)(1) of the Lanham Act and refusing to permit amendment of the application to seek registration on the Supplemental Register because Applicant’s Mark was allegedly generic under Sections 23(c) and 45 of the Lanham Act.

² The entire prosecution record for U.S. Serial No. 87/906,630 is *de facto* of record in this Appeal as evidence. *See, e.g.*, 37 C.F.R. § 2.142(b)(3) (“Citation to evidence in briefs should be to the documents in the electronic application record by date, the name of the paper under which the evidence was submitted, and the page number in the electronic record.”)

On September 11, 2019, in response to the Second Office Action, Applicant presented (i) arguments that Applicant's Mark, as a whole, is not generic for the Applicant's Services; (ii) cited to numerous "generic.com" trademarks permitted registration by the U.S. Patent and Trademark Office (the "Trademark Office"); and (iii) noted that if permitted, amendment to seek registration on the Supplemental Register would be sufficient to overcome the Section 2(e)(1) rejection.

On October 9, 2019, the Examiner issued a third non-final office action (the "Third Office Action") maintaining the Section 2(e)(1) rejection and refusal to permit amendment of the application to seek registration on the Supplemental Register and requesting information regarding Applicant's Services and wording appearing in Applicant's Mark.

On April 9, 2020, in response to the Third Office Action, Applicant presented further arguments and evidence in support of registration of Applicant's Mark and responded to the Examiner's request for information.

On June 11, 2020, the Examiner issued a final office action (the "Fourth Office Action") maintaining the Section 2(e)(1) rejection and refusal to permit amendment of the application to seek registration on the Supplemental Register and citing to websites that allegedly use the phrase PARKING in the URL.

On December 11, 2020, in response to the Fourth Office Action, Applicant timely filed a request for reconsideration (the "Request for Reconsideration") and notice of appeal. In the Request for Reconsideration, Applicant once again argued that the mark, as a whole, is not generic for the relevant services in light of the

Supreme Court's holding in *Booking.com*. Applicant also presented evidence of numerous “.com,” “.edu,” and “.org” trademarks that the Trademark Office initially rejected as being generic, but subsequently permitted to register following the Supreme Court's decision in *United States Patent and Trademark Office, et al. v. Booking.com B. V.*, 591 U.S. ___, 140 S. Ct. 2298 (2020).

On **February 11, 2021**, the Examiner issued a reconsideration letter which denied Applicant's request for reconsideration after final action (the “Fifth Office Action”).

THE ISSUES ON APPEAL

1. Has the Examiner met the burden of proving a prima facie case that the mark PARKING.COM is generic for a “[w]ebsite providing information regarding parking availability,” such that the refusal to permit amendment to seek registration of Applicant’s Mark on the Supplemental Register was proper?

Is a dictionary definition of “parking,” third party use of the phrase parking.com, and a lack of survey evidence sufficient for an Examiner to prove a *prima facie* case of genericness for a mark?

2. If so, is the evidence submitted by Applicant sufficient to rebut the *prima facie* case?

Is evidence as to size and sales figures of a company, use of the mark on a website, and forum posts by customers identifying parking.com as the source of services sufficient to rebut a prima facie case of genericness?

3. Has Applicant’s Mark acquired distinctiveness?

Has the Examiner met the burden of proving a *prima facie* case that the mark PARKING.COM is merely descriptive for Applicant’s Services, and if so, has Applicant sufficiently demonstrated that Applicant’s Mark has acquired distinctiveness?

ARGUMENT

a. Legal Framework

Generic terms are those that the relevant purchasing public understands primarily as the common or class name for particular goods or services. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 U.S.P.Q.2d 1807, 1811 (Fed. Cir. 2001). The Supreme Court recently held that a proposed mark comprising a generic term combined with a generic top-level domain (e.g., “.com”) is not automatically generic. *Booking.com*, 140 S. Ct. at 2305. Therefore, as the Trademark Office’s Examination Guide No. 3-20, *Generic.com Terms after USPTO v. Booking.com*, October 2020 (hereinafter “Examination Guide”) now confirms,³ an examining attorney faced with a such a proposed mark must evaluate all of the available evidence to determine whether consumers would perceive the proposed mark as (1) the generic name of a class of goods and/or services (in which case it would not be registrable) or (2) capable of serving as a source indicator (in which case the proposed mark is not generic). *See also In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 1364, 92 U.S.P.Q.2d 1685 (Fed. Cir. 2009).

As correctly noted in the Fourth Official Action, “[a] term is generic if *the relevant public* understands the term as *referring to the category or genus of the services* in question.” June 11, 2020 Office Action, TSDR p.1 (emphasis added). In order to maintain a rejection of a mark as generic, the Trademark Office is expressly required to prove by *clear evidence* that the “*primary significance*” of the mark among

³ *See* Trademark Office’s Examination Guide No. 3-20, *Generic.com Terms after USPTO v. Booking.com*, October 2020 at 2.

actual consumers is as a generic name for the general type of services being offered under the mark. *See, e.g., Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 118 (1938).

The Trademark Office “always bears the burden” of establishing that a proposed mark is generic in the first instance. *In re Cordua Rests., Inc.*, 823 F.3d 594, 600, 118 U.S.P.Q.2d 1632 (Fed. Cir. 2016); *In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 1571, 4 U.S.P.Q.2d 1141 (Fed. Cir. 1987) (the burden of proving genericness “remains with” the Trademark Office) (emphasis added). Where the Trademark Office cannot meet its burden, a genericness rejection is improper.

The Supreme Court has confirmed that the Lanham Act forecloses any *per se* rule that a generic term coupled with “Company,” “Inc.,” “.com,” or similar suffixes can never be trademarked. *Booking.com*, 140 S. Ct. at 2305.

b. Finding I: Examiner failed to meet the burden of establishing the mark PARKING.COM is generic.

The Examiner’s Fourth Official Action on June 11, 2020 relied on the Federal Circuit’s since-rejected general rule that “the addition of a gTLD to otherwise unregistrable wording (i.e., merely descriptive or generic) does not add source-indicating significance except in “unique” or “exceptional” circumstances.” June 11, 2020 Official Action, TSDR p.1 (citing *In re Oppedahl & Larsen LLP*, 373 F.3d 1171, 1175–77, 71 U.S.P.Q.2d 1370, 1372–74 (Fed. Cir. 2004) (explaining that circumstances where the addition of the gTLD creates a “witty double entendre” could satisfy the “unique” or “exceptional” requirement.)). However, this rule has been

expressly rejected by the Supreme Court, which explained in *Booking.com* that it has “decline[d] to adopt a rule essentially excluding registration of ‘generic.com’ marks.” *Booking.com*, 140 S. Ct. at 2305. Rather, the Supreme Court held that “[w]hether any given ‘generic.com’ term is generic . . . depends on whether consumers in fact perceive that term as the name of a class or, instead, as a term capable of distinguishing among members of the class.” *Booking.com*, 140 S. Ct. at 2307. As such, to the extent the Examiner still relies on *Oppedahl* to support the refusal to register, the refusal is no longer based on good law and must be withdrawn.

The Examiner continues to find that PARKING.COM is generic in light of the Trademark Office’s guidance regarding evidence of genericness, i.e., “a combination of dictionary excerpts defining the component elements of the generic.com term; significant evidence of generic usage of those elements or the combined term by consumers or competitors in the relevant marketplace; evidence of the ‘generic.com’ term used by third parties as part of their domain names (e.g., ‘[adjective]generic.com’) in connection with the same or similar goods and/or services; or evidence of the applicant’s own use of the generic.com term.” See Trademark Office’s Examination Guide, at *4.

In the Reconsideration Letter, the Examining Attorney relies on the dictionary definition of PARKING, third-party use of PARKING in domain names, and lack of survey evidence as sufficient to find that the mark is generic.

1. A dictionary definition of only one portion of a composite mark is not sufficient to support a finding of genericness for the entire mark.

The dictionary definition of PARKING is not sufficient to support a finding that PARKING.COM is generic for the relevant services. Like the mark in *Booking.com*, PARKING.COM conveys to consumers an association with a particular website owned by Applicant. PARKING.COM is not merely a generic composite, but rather a mark capable of signaling the particular source of Applicant's services. A "generic.com" term is a generic name for a class of goods or services *only* if the term has is generic to consumers. *Booking.com*, 140 S. Ct. at 2305-06. PARKING.COM has no such generic meaning to consumers, and there is no evidence in the record to indicate that it does.

Additionally, "when examining domain name marks, it is important to evaluate the commercial impression of the mark as a whole to determine whether the composite mark conveys any distinctive source identifying impression apart from its individual components." TMEP 1215.04. Therefore, even if the term PARKING is generic, the addition of the top level domain indicator ("TLD.com") may operate to create a distinctive composite mark. *In re Steelbuilding.com*, 415 F.3d 1293, 1301, 75 U.S.P.Q.2d 1420 (Fed. Cir. 2005). In *Steelbuilding.com*, the Federal Circuit reversed in part the Board's determination that STEELBUILDING.COM was generic for "computerized on-line retail services in the field of pre-engineered metal buildings and roofing systems." The Federal Circuit held that the TLD indicator expanded the "meaning of the mark to include goods and services beyond the mere sale of steel buildings." *Id.* at 1299. In particular, .COM expanded the mark to include Internet

services such as designing a steel structure on the website and calculating a price.
Id.

The same logic applies in the present case. In the Final Office Action, the Examiner relied on the dictionary definition of PARKING, i.e., “(a) space in which to park vehicles or a vehicle,” in order to find Applicant’s Mark to be generic. The addition of .COM to the term PARKING expands the meaning of the mark to include services beyond providing parking spaces. In particular .COM expands the mark to create a coined term that functions as a mark. Therefore, PARKING.COM is not generic for the relevant and the genericness rejection should be withdrawn.

2. Examiner’s citations to other uses of Parking.com fail to show generic third-party use of the phrase.



With regard to the third-party use of PARKING in the domain names, Applicant submits that the only mark it seeks to register is PARKING.COM. Applicant does not claim rights to <https://airportparking.com>; <https://lazparking.com>; <https://www.thriftyparking.com>; nor any other of the third parties that Examiner cites in the Reconsideration Letter. It is the burden of the Examiner to prove that PARKING.COM is generic by clear evidence. TMEP 1209.01(c)(i).

In the trademark prosecution of Booking.com, the Trademark Office also cited to third-party uses of the term “booking.com” that included other wording in domain names. In Respondent’s Brief, counsel for Booking.com stated: “even if ‘booking’ and ‘.com’ were generic terms in isolation, consumers would not necessarily understand Booking.com to refer to all hotel-reservation services. And just because ‘booking.com’ appears within terms like ‘dubaitravelbookin.com’ does not show that consumers

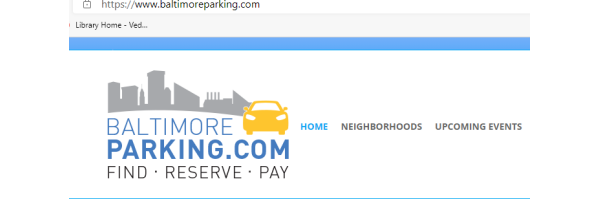
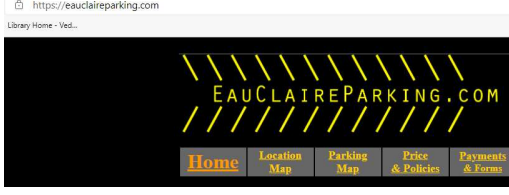




consider Booking.com to mean *all* hotel-reservation services.” Brief for Respondent at 24, *Booking.com B.V.*, 591 U.S. (2020) (No. 19-46), 2020 WL 833244, at *12 (citations omitted) (emphasis added).

The Supreme Court did not uphold the Examiner’s rejection on this basis and instead held that since only one entity can occupy a particular domain name, an ordinary consumer could infer that a domain refers to a specific entity. *Booking.com*, 140 S. Ct. at 2306. Because ordinary consumers can infer that a domain refers to a specific entity, the Examiner’s citations to the various domains which use PARKING.COM do not show mere generic uses of the phrase “parking.com,” but are instead uses as a mark of other words.

For instance, the Examiner cites to the domain <https://www.thriftyparking.com>. However, this domain uses the wording thriftyparking.com as a composite trademark. Below is a table which includes cited domains by the Examiner in the Fifth Office Action⁴, wherein the website uses the domain name as a mark:

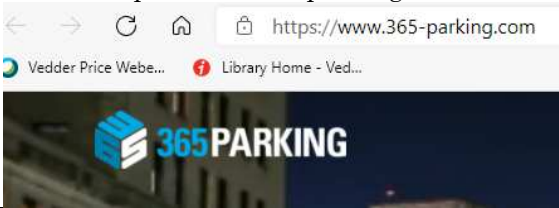
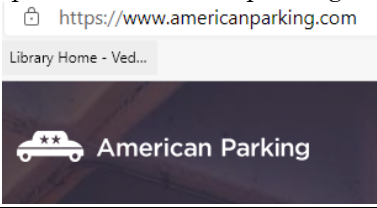









<u>Domain Cited by Examiner</u>	<u>Use as a Mark</u>
<p data-bbox="337 1421 724 1451">https://www.thriftyparking.com</p>  <p>The screenshot shows the website for Thrifty Parking. At the top, the URL https://www.thriftyparking.com is displayed in the browser's address bar. Below the address bar, the text "Library Home - Ved..." is visible. The main content area features a logo for "Thrifty Parking" which includes a car icon and the text "Thrifty parking.com". A blue navigation bar at the bottom contains links for Home, Locations, Deals, Services, Corporate, Rewards, FAQ's, Contact Us, and About.</p>	<p data-bbox="984 1421 1317 1451">https://airportparking.com/</p>  <p>The screenshot shows the website for Airport Parking. At the top, the URL https://airportparking.com/ is displayed in the browser's address bar. Below the address bar, the text "Library Home - Ved..." is visible. The main content area features a logo for "AIRPORT PARKING.COM" which includes a circular icon with a question mark and the text "AIRPORT PARKING.COM".</p>
<p data-bbox="313 1715 748 1745">https://www.baltimoreparking.com/</p>	<p data-bbox="971 1715 1333 1745">https://eauclairparking.com/</p>

⁴ See February 11, 2021 Reconsideration Letter, TSDR p. 1.

 <p>https://www.baltimoreparking.com</p> <p>BALTIMORE PARKING.COM FIND · RESERVE · PAY</p>	 <p>EAUCLAIREPARKING.COM</p> <p>Home Location Map Parking Map Price & Policies Payments & Forms</p>
<p>https://www.ezcruiseparking.com/</p>  <p>409.939.0648 GET DIRECTIONS</p> <p>EZCruiseParking.com PARKING SERVICES CRUISES SERVED</p>	<p>https://www.memorialairportparking.com/</p>  <p>MEMORIAL AIRPORT PARKING.COM</p> <p>6010 West Chelsea St., Tampa, FL 33634</p>
<p>http://www.phl-parking.com/</p>  <p>PHL Airport Parking \$6.48* Per Day</p> <p>HOME ABOUT</p>	<p>http://www.dailytruckparking.com/</p>  <p>DAILYTRUCKPARKING.COM</p> <p>\$15 PER DAY</p> <p>678-631-7275</p>

Therefore, instead of being evidence that the phrase PARKING.COM is generic, these websites are instead evidence that other entities use trademarks that include PARKING.COM. These websites are using the phrase “parking.com” as part of their trademarks and thus these citations are not examples that the phrase PARKING.COM is generic. The remaining citations in the Fifth Office Action⁵ all include “parking.com” in the domain name, but these are not generic uses of PARKING.COM. For each of these websites, the term PARKING is used as a trademark as shown in the table below:

⁵ February 11, 2021 Reconsideration Letter, TS DR p. 1

<u>Domain Cited by Examiner</u>	<u>Use as a Mark</u>
<p>https://www.365-parking.com/</p> 	<p>https://www.americanparking.com/</p> 
<p>https://parkwayparking.com/</p> 	<p>https://www.pmi-parking.com/</p>  <p>Parking Management Inc. (website is temporarily down)</p>
<p>https://www.snap-parking.com/</p> 	<p>http://www.studentparking.com/</p> 
<p>https://www.bestparking.com/</p> 	<p>https://hartfordparking.com/</p> 
<p>https://www.citycenterparking.com/</p> 	<p>https://www.preferredparking.com/2019_index.html</p> 
<p>https://lazparking.com/</p> 	

“Parking” is incorporated into each of the above trademarks. Therefore, these websites are only using “.com” in their domain name and not as a mark or a generic phrase. None of the domains cited by the Examiner are evidence that third parties are using PARKING.COM generically. Some of these third parties use the phrase PARKING.COM explicitly as a mark, and the others use PARKING explicitly as part of a mark. None are using PARKING.COM generically. Therefore, Examiner’s citations are not evidence that PARKING.COM fails to create an impression of source identification among customers.

3. *The Examiner cannot rely on the lack of survey evidence to support a finding that Parking.com is generic.*

Finally, while Applicant presents no survey evidence, it should be noted that survey evidence is not required to show non-genericness or evidence of secondary meaning. TMEP 1212.06(d). Therefore, the Examiner may not rely on the lack of survey evidence to find that PARKING.COM is a generic mark. Instead, the Examiner must independently make a prima facie case regardless of what evidence is submitted by Applicant. In light of the evidence presented by Applicant, a consumer would understand that PARKING.COM differs from the third-party uses and is not generic.

For at least these reasons, Applicant’s Mark is not generic and is eligible for registration on the Supplemental Register. Applicant respectfully requests that the Official Action’s refusal to permit Applicant to seek registration of Applicant’s Mark on the Supplemental Register be withdrawn.

c. *Finding II: Applicant has presented rebuttal evidence that shows PARKING.COM is capable of identifying source.*

Even if the Examiner established a *prima facie* case of genericness, Applicant has submitted sufficient evidence that PARKING.COM is capable of identifying source and is thus registrable on the Supplemental Register.

In view of the Supreme Court's ruling in *Booking.com*, whether PARKING.COM is generic "turns on whether that term, taken as a whole, signifies to consumers the class of [parking availability information] services." *Booking.com*, 140 S. Ct. at 2304 ("Thus, if "Booking.com" were generic, we might expect consumers to understand Travelocity—another such service—to be a "Booking.com." We might similarly expect that a consumer, searching for a trusted source of online hotel-reservation services, could ask a frequent traveler to name her favorite "Booking.com" provider.")

The *Booking.com* rationale is precisely applicable here: there is nothing to suggest that the public perceives Applicant's Mark as signifying the class of websites providing information regarding parking availability. For example, the Examiner did not cite any evidence that the public refers to similar service providers (such as SpotHero) as being a "Parking.com." And, similarly to the case of *Booking.com*, no one would ask which "Parking.com" is their favorite parking availability services provider.

Evidence showing customer perception of the mark "can include not only consumer surveys, but also dictionaries, usage by consumers and competitors, and any other source of evidence bearing on how consumers perceive a term's meaning." *Booking.com*, 140 S. Ct. at 2307 n.6. As Applicant has previously demonstrated to

the Examiner,⁶ Applicant's Mark has been in use since 2018. In particular, Applicant has submitted evidence that Applicant's Mark has acquired distinctiveness during that time. While this evidence was deemed insufficient to prove secondary meaning in a prior office action,⁷ it remains probative of how the public views Applicant's Mark. Even assuming for the sake of argument that Applicant's Mark has not acquired distinctiveness, this evidence is sufficient to establish that Applicant's Mark is not generic.

First, Applicant has presented evidence as to Applicant's company size and sales figures, which includes, at least, generation of over a million dollars in parking sales from use of the Applicant's Mark within a five-month period. *See* January 29, 2019 Response to Official Action, TSDR p. 4-6. Second, Applicant has been using Applicant's Mark on its website www.parking.com since July 31, 2018.⁸ Third, Applicant has submitted forum posts and over 6,000 customer reviews as evidence that consumers use Applicant's Mark to specifically identify Applicant as the source of Applicant's parking availability information services.⁹

⁶ *See, generally* January 29, 2019 Response to Official Action, TSDR; September 11, 2019 Response to Official Action, TSDR; April 9, 2020 Response to Official Action TSDR; and December 11, 2020 Response to Official Action, TSDR.

⁷ *See, generally* October 9, 2019 Official Action, TSDR; March 11, 2019 Official Action, TSDR; June 11, 2020 Official Action, TSDR.

⁸ *See* January 29, 2019 Amendment to Allege Use, TSDR p. 1.

⁹ December 11, 2020 TEAS Request Reconsideration after FOA, TSDR p. 54-83 (providing a copy of a search result yielding over 6,800 consumer reviews for Applicant's services available at trustpilot.com; a copy of a consumer review available at yelp.com; copies of various forum posts showing consumers using Applicant's Mark to indicate Applicant as the source of Applicant's parking availability information services).

Third, Applicant has submitted evidence that the Trademark Office has allowed similar .COM marks to register. As shown below,¹⁰ at least 384 .COM/.EDU/.ORG marks registered within five months from the Booking.com decision, some of which had faced genericness rejections:



In particular, the following marks¹¹ each previously faced a rejection that the mark was generic for the services but was allowed to register in light of the Supreme Court's holding in *Booking.com*:

<u>MARK</u>	<u>GOODS/SERVICES</u>	<u>REG. DATE</u>
WEBTHEME.COM Reg. No. 6,207,712	Class 42: Providing a website featuring non-downloadable software for creating and accessing classifieds, exchanging messages within a virtual community, social networking, and for listing themes and applications for website and software developers	Nov. 24, 2020
CLOWNS.COM Reg. No. 6,202,433	Class 41: Children's entertainment in the nature of a bounce house and magic shows; providing a website that features information about children's entertainment, namely,	Nov. 17, 2020

¹⁰ December 11, 2020 TEAS Request Reconsider after FOA, TSDR p. 9.

¹¹ For registration certificates for WEBTHEME.COM and CLOWNS.COM, see December 11, 2020 TEAS Request Reconsider after FOA, TSDR p. 85-88. For registration certificates for JEWISH.COM and HOTELS.COM, see April 6, 2020 Response to Office Action, TSDR p. 27 & 65. JEWISH.COM was since cancelled on April 24, 2020.

<u>MARK</u>	<u>GOODS/SERVICES</u>	<u>REG. DATE</u>
	entertainment in the nature of a bounce house and magic shows	

Additionally, Applicant specifically argued to the Examiner that the USPTO has historically allowed other similar .COM marks to register as well, such as:

<u>MARK</u>	<u>GOODS/SERVICES</u>	<u>REG. DATE</u>
JEWISH.COM Reg. No. 2,080,381	Class 42: Information on issues of interest to the Jewish community via a global computer network	July 15, 1997
HOTELS.COM Reg. No. 3,015,723	Class 39: Providing information for others about transportation; travel agency services, namely, making reservations and bookings for transportation for others by means of telephone and the global computer network	Nov. 15, 2005

As evidenced by the registration of the above trademarks, and the similar trademarks previously submitted with Applicant's responses to the Official Actions dated September 4, 2018, March 11, 2019, and October 9, 2019, the Trademark Office has allowed comparable marks to register. The Trademark Office's long practice of registering similar marks is evidence that PARKING.COM is not generic for the goods and services. In particular, the above marks for Jewish.com and Hotels.com as well as PARKING.COM all include a single and generic term before .COM. The goods and services are all similar as well. All three marks provide online information to consumers. As such, Applicant submits that Applicant's Mark is entitled to registration and the Official Action's rejection should be withdrawn.

As shown above, the Examiner failed to meet the burden of showing that Applicant's Mark is generic for the relevant services, and even if the Board finds that

Examiner has established a *prima facie* case of genericness, which Applicant does not concede, Applicant has established that the mark PARKING.COM is capable of distinguishing source, is therefore not generic, and is capable of registration on the supplemental register. *See* Trademark Office's Examination Guide, at *4 ("If the examining attorney determines that the available evidence establishes that the proposed generic.com term is at least capable of indicating source but is insufficient to show that the term has acquired distinctiveness, the examining attorney may allow registration on the Supplemental Register, if otherwise appropriate.")

d. Finding III: Has Applicant's Mark acquired distinctiveness?

Applicant has maintained that Applicant's Mark has acquired distinctiveness throughout prosecution of PARKING.COM. Applicant merely sought registration of Applicant's Mark on the Supplemental Register in an effort to expedite registration of the applied-for mark. In the preceding section Applicant provided sufficient evidence to show not only that PARKING.COM is capable of source, but also that PARKING.COM has acquired distinctiveness. Under TMEP 109.02(a)(ii), the Examiner must "maintain and continue, in the alternative, the refusal under 2(e)(1) that the mark is merely descriptive and must separately explain why the showing of acquired distinctiveness is insufficient to overcome the descriptiveness refusal even if the mark is ultimately deemed not to be generic." To the extent that the Examiner may have failed to continue this refusal throughout prosecution, the Board should treat the evidence presented as sufficient to establish distinctiveness of the mark if it is ultimately found not to be generic. *Id.*

First, Applicant presented evidence as to Applicant's company size and sales figures, which includes, at least, generation of over a million dollars in parking sales from use of the Applicant's Mark within a five-month period (see Applicant's response to the Official Action dated September 4, 2018). The larger a company, the greater its sales, and thus the greater number of people who may associate a mark with a company. *Turner v. HMM Pub. Co.*, 154 U.S.P.Q. 330 (5th Cir. 1967) ("Plaintiffs have built a national and international business reputation and have extensively publicized and promoted their trade and service marks at the cost of millions of dollars . . . and acquired a secondary meaning of sufficient strength to justify enjoining infringement by defendants."). See *Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 24 U.S.P.Q.2d 1161, 1166 (2d Cir. 1992) ("Among the factors that we have found relevant to this inquiry in the past are . . . sales success . . .").

Between July 31, 2018 and December 19, 2018, Applicant generated a total greater than one million dollars of revenue from use of the Applicant's Mark. Applicant's sales figures generated from using the mark PARKING.COM provide a sufficient basis to support a finding that the mark PARKING.COM has acquired distinctiveness by creating a secondary meaning in the minds of consumers. *Exquisite Form Industries, Inc. v. Exquisite Fabrics of London*, 183 U.S.P.Q. 666 (S.D.N.Y. 1974) ("A secondary meaning exists when a party through advertising, massive exposure, or the distinctive quality of its product has established its mark in the minds of consumers as an indication of origin from one particular source.").

Second, Applicant has been using Applicant's Mark on its website www.parking.com since July 31, 2018. Thus, Applicant has been advertising and generating sales from the use of its mark PARKING.COM. In combination with Applicant's sales data, Applicant's use of PARKING.COM on its website creates a secondary meaning in the minds of consumers. *Beneficial Corp. v. Beneficial Capital Corp.*, 213 U.S.P.Q. 1091 (S.D.N.Y. 1982) ("Advertising is the primary means by which the connection between a name and a company is established in the public mind and sales figures are at least some indication that the advertising may have succeeded."). Additionally, when consumers use the website to search for parking availability, they see the Applicant's Mark and make a connection between the services offered and the mark.

Third, Applicant has submitted forum posts and over 6,000 customer reviews as evidence that consumers use Applicant's Mark to specifically identify Applicant as the source of Applicant's parking availability information services.¹² To ascertain the public's understanding of a term, courts may look to "purchaser testimony, consumer surveys, listings, and dictionaries, trade journals, newspapers, and other publications." *Glover v. Ampak, Inc.*, 74 F.3d 57, 59, 37 U.S.P.Q.2d 1602 (4th Cir. 1996). The reviews show that consumers view Applicant's Mark as a source identifier

¹² December 11, 2020 TEAS Request Reconsideration after FOA, p. 54-83 (providing a copy of a search result yielding over 6,800 consumer reviews for Applicant's services available at trustpilot.com; a copy of a consumer review available at yelp.com; copies of various forum posts showing consumers using Applicant's Mark to indicate Applicant as the source of Applicant's parking availability information services).

for parking information services. For at least these reasons, Applicant's Mark has acquired distinctiveness and is eligible for registration on the Primary Register.

CONCLUSION

In light of Findings I , II, and III above, the Examiner has not met his burden of showing through sufficiency of evidence that PARKING.COM is generic or merely descriptive for the relevant services.

Giving proper weight to the Applicant's evidence shows that the PARKING.COM Mark is at the very least non-generic and is eligible for amendment to the supplemental register. Further, the Examiner's rejections do not provide a proper basis to deny PARKING.COM from amendment to the supplemental register. For at least these reasons the Examiner's rejection must be reversed. To the extent the Examiner has maintained the 2(e) rejection, Applicant's evidence shows that PARKING.COM has acquired distinctiveness.

Respectfully submitted,

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