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

Ex Parte Appeal - Serial No.	87906630
Appellant	SP Plus Corporation
Applied for mark	PARKING.COM
Correspondence address	ANGELO J BUFALINO VEDDER PRICE PC 222 NORTH LASALLE ST 24TH FL CHICAGO, IL 60601 UNITED STATES Primary email: abufalino@vedderprice.com Secondary email(s): hmiller@vedderprice.com, ipdocket@vedderprice.com 312-609-7850
Submission	Appeal brief
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Appealed class	Class 039. First Use: Jul 31, 2018 First Use In Commerce: Jul 31, 2018 All goods and services in the class are appealed, namely: Website providing information regarding parking availability
Filer's name	Angelo J. Bufalino
Filer's email	abufalino@vedderprice.com, jburke@vedderprice.com, jgrant@vedderprice.com, hmiller@vedderprice.com, ipdocket@vedderprice.com
Signature	/Angelo J. Bufalino/
Date	08/08/2022

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(s):

Teague Avent  
Law Office: 125

Nicole Passman  
Law Office: 125

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**APPLICANT'S APPEAL BRIEF**

Applicant/Appellant, SP Plus Corporation (“Applicant” or “SP”), submits its appeal brief (this “Brief”) pursuant to its notice of appeal filed under 37 C.F.R. §§ 2.141 and 2.142.<sup>1</sup> Applicant disputes the Examining Attorney’s (the “Examiner”) 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.

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<sup>1</sup> Per the Board’s order of June 9, 2022, this Brief is due by August 8, 2022. (16 TTABVUE 1.) Accordingly, this Brief is timely.

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## **DESCRIPTION OF THE RECORD/EVIDENCE**

The prosecution history of U.S. Application Serial No. 87/906,630 (the "Application") is extensive and is briefly summarized as follows:

On May 3, 2018, Applicant filed 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").<sup>2</sup> On September 4, 2018, 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. With its January 29, 2019 response to the First Office Action, Applicant (i) filed an amendment to allege use under Section 1(c) of the Lanham Act, (ii) submitted evidence and arguments against the Section 2(e)(1) rejection, including arguments that Applicant's Mark acquired distinctiveness, and (iii) amended the Application to seek registration on the Supplemental Register.

On March 11, 2019 and October 9, 2019, the Examiner issued second and third non-final office actions (the "Second Office Action" and "Third Office Action" respectively). The Examiner maintained the Section 2(e)(1) refusal and refused the Application to seek registration on the Supplemental Register on the grounds of genericness under Sections 23(c) and 45 of the Lanham Act.<sup>3</sup> In its September 11, 2019 and April 9, 2020 responses to the Second and Third Office Actions, Applicant submitted (i) arguments that Applicant's Mark is not generic, (ii) numerous "generic.com" trademarks permitted registration by the

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<sup>2</sup> 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.").

<sup>3</sup> The Third Office Action maintained the rejections of the Second Office Action and asked for information regarding Applicant's Services and wording in Applicant's Mark.

U.S.P.T.O. (the "Trademark Office"), (iii) arguments that amendment to seek registration on the Supplemental Register is sufficient to overcome the Section 2(e)(1) rejection, and (iv) 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 rejections and citing to websites that allegedly use the phrase PARKING in the URL. In its December 11, 2020 response to the Fourth Office Action, Applicant timely filed a request for reconsideration and notice of appeal. Applicant 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 after *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"). On April 18, 2021, Applicant timely filed an appeal brief. On June 17, 2021, The Trademark Trial and Appeal Board ("T.T.A.B." or the "Board") suspended the appeal and remanded the Application to the Examiner on the grounds that Applicant allegedly proposed amendments in its appeal brief. On July 15, 2021, the Examiner issued a nonfinal office action (the "Sixth Office Action") maintaining the generic refusal and rejecting Applicant's alternative claim of acquired distinctiveness. On January 18, 2022, Applicant reiterated its arguments that Applicant's Mark is not generic and submitted additional evidence of acquired distinctiveness along with a signed declaration on behalf of Applicant. On May 12, 2022, the Examiner issued a final office action (the "Seventh Office Action") maintaining the generic refusal and refusal of Applicant's alternative claim of acquired distinctiveness.

**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 No. 3-20”) now confirms,<sup>4</sup> 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 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 at 1 (emphasis added).) In order to establish a *prima facie* case of genericness and maintain a rejection of a mark as generic, the Trademark Office is expressly required to provide “sufficient evidence to support a ‘reasonable predicate’ (i.e., reasonable basis) for finding the mark generic under the applicable legal standard.”<sup>5</sup>

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<sup>4</sup> See Examination Guide No. 3-20, at 2.

<sup>5</sup> See Trademark Office’s Examination Guide No. 1-22, *Clarification of Examination Evidentiary Standard for Marks Refused as Generic*, May 2022 at 1 (hereinafter “Examination Guide No. 1-22”) (“The standard for an examining attorney to establish a *prima facie* case of genericness is the same as for other substantive refusals.”).

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). 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 at 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 No. 3-20, at \*4.

In the Reconsideration Letter, the Examining Attorney relied 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. In its Sixth and Seventh Office Actions, the Examining Attorney did not offer any additional support in favor of its refusal on the grounds of genericness.

***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 Examiner's reliance on the dictionary definition of "parking" shows that the Examiner continues to fail to consider the mark as a whole. The dictionary definition fails 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 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, i.e., designing a steel structure on the website and calculating a price. *Id.*

The same logic applies in the present case. In the Fourth 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. Additionally, Applicant is using the mark PARKING.COM, not merely “parking” with .com on the end. (See January 18, 2022 Response to Office Action, TSDR at 17–76.) Finally, the Supreme Court found in *Booking.com*, only one entity can occupy a particular domain name, so “a consumer who is familiar with that aspect of the domain name system can infer that BOOKING.COM refers to some specific entity.” *Booking.com*, 140 S. Ct. at 2307. The same is true of PARKING.COM. Therefore, PARKING.COM is not generic and the genericness rejection should be withdrawn.


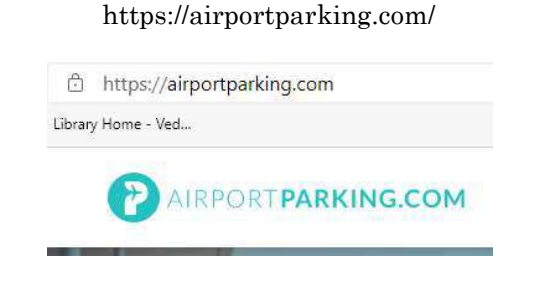

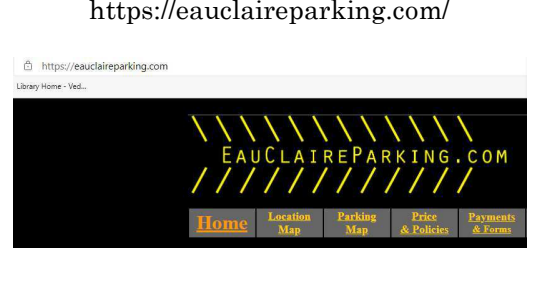

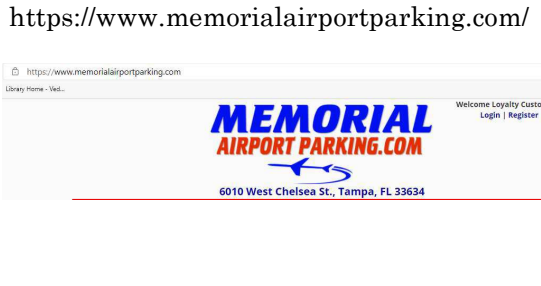

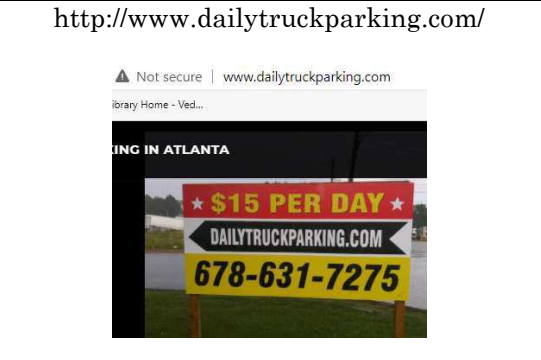
**2. Examiner's citations to other uses of *Parking.com* fail to show generic third-party use of the phrase.**

With regard to the third-party use of "parking" in 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>, or <https://www.thriftyparking.com>, nor any other of the third parties that Examiner cites in the Reconsideration Letter and Office Actions. It is the burden of the Examiner to prove that PARKING.COM is generic by "providing a reasonable predicate (or basis) that the relevant purchasing public would primarily use or understand the matter sought to be registered to refer to the genus of goods or services in question." 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: "[E]ven 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." Respt's Br. at 24, *Booking.com B.V.*, 591 U.S. (2020) (No. 19-46), 2020 WL 833244, at \*12 (citations omitted) (emphasis added).

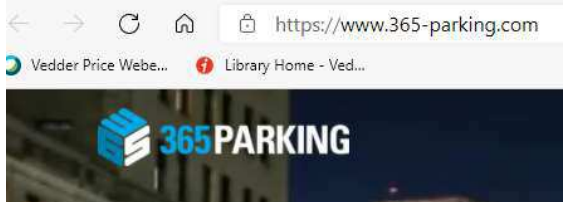
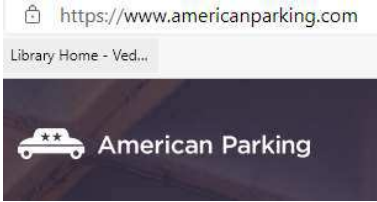





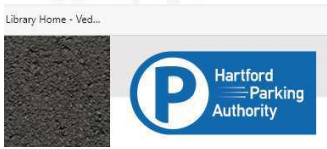
The Supreme Court did not uphold the Examiner's rejection on this basis and instead held that since only one entity can occupy a particular domain name, an ordinary consumer could infer that a domain refers to a specific entity. *Booking.com*, 140 S. Ct. at 2306. Because ordinary consumers can infer 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 instead show trademark use of "parking.com" as a composite mark.

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 Action,<sup>6</sup> wherein the website uses its unique domain name as a mark on its respective website:

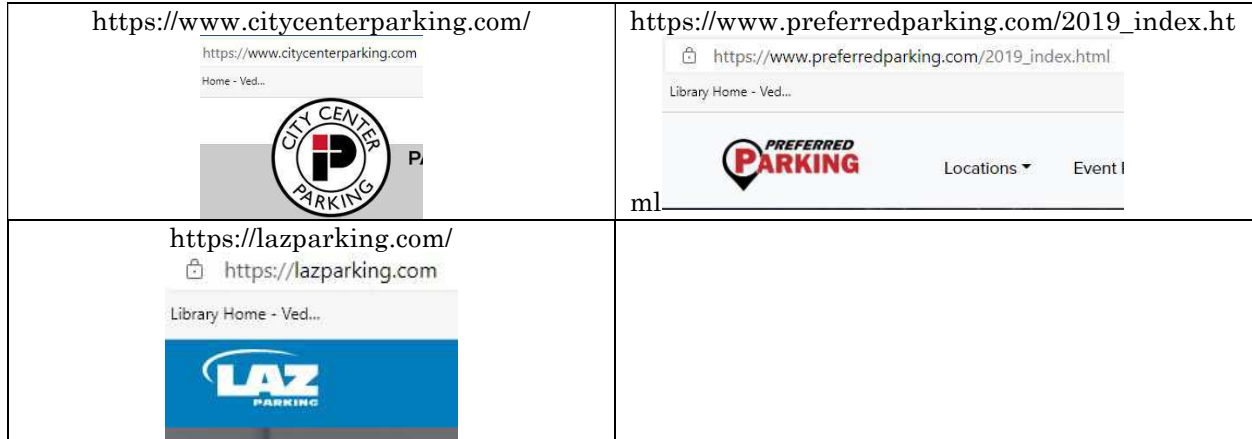
<u><b>Domains Cited by Examiner</b></u>	
<a href="https://www.thriftyparking.com">https://www.thriftyparking.com</a>	<a href="https://airportparking.com/">https://airportparking.com/</a>
	
<a href="https://www.baltimoreparking.com/">https://www.baltimoreparking.com/</a>	<a href="https://eauclaireparking.com/">https://eauclaireparking.com/</a>
	
<a href="https://www.ezcruiseparking.com/">https://www.ezcruiseparking.com/</a>	<a href="https://www.memorialairportparking.com/">https://www.memorialairportparking.com/</a>
	
<a href="http://www.phl-parking.com/">http://www.phl-parking.com/</a>	<a href="http://www.dailytruckparking.com/">http://www.dailytruckparking.com/</a>
	

<sup>6</sup> (See February 11, 2021 Reconsideration Letter, TSDR at 1.)

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 Action<sup>7</sup> 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 part of a composite trademark as shown in the table below:

<u><b>Domains Cited by Examiner</b></u>	
<a href="https://www.365-parking.com/">https://www.365-parking.com/</a> 	<a href="https://www.americanparking.com/">https://www.americanparking.com/</a> 
<a href="https://parkwayparking.com/">https://parkwayparking.com/</a> 	<a href="https://www.pmi-parking.com/">https://www.pmi-parking.com/</a> 
<a href="https://www.snap-parking.com/">https://www.snap-parking.com/</a> 	<a href="http://www.studentparking.com/">http://www.studentparking.com/</a> 
<a href="https://www.bestparking.com/">https://www.bestparking.com/</a> 	<a href="https://hartfordparking.com/">https://hartfordparking.com/</a> 

<sup>7</sup> (February 11, 2021 Reconsideration Letter, TSDR at 1)



“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 portion of their respective marks, 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, 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 at least 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 at least 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. In fact, consumers encounter the mark as PARKING.COM not "parking" and as one brand amongst many other competing brands such as SPOTHERO, PARK CHICAGO, and BESTPARKING.

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. *See also In re GJ & AM, LLC*, 2021 U.S.P.Q.2d 617 (T.T.A.B. 2021) (“To assess Applicant’s use, we look to Applicant’s own mobile application and website, as well as other evidence in the record showing the ways in which Applicant promotes recognition of its goods among consumers.”); *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 U.S.P.Q. 215, 218 (C.C.P.A. 1978) (“Evidence of the context in which a mark is used . . . in advertising material directed to the goods is probative of the reaction of prospective purchasers to the mark.”). In view of the above, Applicant submits that the Board should consider the same evidence which is often used to show acquired distinctiveness in its consideration of the genericness question.

Under the precedent of the Board and Federal Circuit, acquired distinctiveness can be shown by a variety of evidence, including but not limited to (i) the length, degree, and exclusivity of use, (ii) actual association of the mark with a particular source by actual purchasers through use and advertising, (iii) the amount and manner of advertising of the mark, (iv) the amount of sales and number of customers of goods and services offered under the mark, and (v) unsolicited media coverage. *See Converse, Inc. v. ITC*, 909 F.3d 1110, 1120 (Fed. Cir. 2018). Circumstantial evidence of acquired distinctiveness can also take the form of (i) evidence of the size of the seller, (ii) the number of actual sales made under the mark, (iii) the scope of publicity given the mark, and (iv) any similar evidence showing wide exposure of prospective customers to the mark in question. *See 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* § 15:30 (5th ed.) (setting forth the “McCarthy criteria” for showing secondary meaning); *Am. Sci. Chem., Inc. v. Am. Hosp. Supply Corp.*, 690 F.2d 791, 216 U.S.P.Q. 1080 (9th Cir. 1982) (approving the “McCarthy criteria” for proof of secondary meaning); *Echo Travel, Inc. v. Travel Assocs., Inc.*, 870 F.2d 1264, 10 U.S.P.Q.2d 1368, 1370-71 (7th Cir. 1989) (same).

No single factor is determinative, and all evidence of record must be considered holistically in making a determination as to whether the purchasing public has come (or may come) to identify the mark with the source of the product. TMEP § 1212.06.

**1. Length, Degree, and Exclusivity of Use.**

As Applicant has previously demonstrated to the Examiner,<sup>8</sup> Applicant's Mark has been in use continuously since 2018. In particular, Applicant has submitted evidence that Applicant's Mark has acquired distinctiveness during that time. Additionally, Applicant is the leading provider of professional parking management services throughout North America and Applicant's Mark has been a key aspect of Applicant's marketing activities throughout the United States. (January 18, 2022 Response to Office Action, TSDR at 18.)

Applicant's use of its mark is substantially exclusive, as no other entity uses the phrase PARKING.COM as its trademark. Similarly, Applicant has used its mark extensively, including but not limited to (i) prominently on Applicant's website, where it has received more than one million page views from users since 2021 and more than six million page views from U.S. users from 2018 to 2021; (ii) prominently on Applicant's mobile application, through which customers made over one million transactions in 2021 alone; (iii) in Applicant's email advertisements, which reach more than 500,000 customers each month; (iv) on printed parking facility access tickets, over 100 million of which has been distributed from 2019 to 2021; and (v) on prominent signage and posters at over 2,000 locations across the United States. (*Id.* at 19–25.)

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<sup>8</sup> (*See generally* January 29, 2019 Response to Office Action, TSDR; September 11, 2019 Response to Office Action, TSDR; April 9, 2020 Response to Office Action, TSDR; December 11, 2020 Response to Official Action, TSDR; January 18, 2022 Response to Office Action, TSDR.)

While this evidence was deemed insufficient to prove secondary meaning in a prior office action,<sup>9</sup> 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.<sup>10</sup>

**2. Recognition of Applicant's Mark by consumers and third parties.**

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.<sup>11</sup> These 6,000 customer reviews show that Applicant's advertising and marketing has been effective in educating the public to associate the PARKING.COM mark with a single source.

In addition, in its affidavit and marketing evidence, Applicant has presented evidence of third party recognition of Applicant's Mark as an identifier of source. (See January 18, 2022 Response to Office Action, TSDR.) In *In re GJ & AM, LLC*, 2021 U.S.P.Q.2d 617 (T.T.A.B. 2021), the applicant heavily relied on evidence of third party use of the term *Cookingpellets.com* as a brand name as evidence that its mark was not generic. In the present case, Applicant has partnered with several third party entities to provide its goods and services to consumers. These third parties recognize the term PARKING.COM as a brand name. (January 18, 2022 Response to Office Action, TSDR at 22-23.)

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<sup>9</sup> (See generally October 9, 2019 Official Action, TSDR; March 11, 2019 Official Action, TSDR; June 11, 2020 Official Action, TSDR; July 15, 2021 Official Action, TSDR; May 12, 2022 Official Action, TSDR.)

<sup>10</sup> For instance, in *In re GJ & AM, LLC*, 2021 U.S.P.Q.2d 617 (T.T.A.B. 2021), Applicant relied in part on 27,875 followers of its Facebook page and other social media channels.

<sup>11</sup> (December 11, 2020 TEAS Request Reconsideration after FOA, TSDR at 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).)

**3. Amount and Manner of Advertising.**

According to the TMEP, “[l]arge-scale expenditures in promoting and advertising goods and services under a particular mark are significant to indicate the extent to which a mark has been used.” TMEP § 1212.06; *In re Hagger Co.*, 217 U.S.P.Q. 81, 84 (T.T.A.B. 1982) (holding that the background design of a black swatch was registrable where the applicant had submitted “very special advertising and sales”). During the period of 2018–2021, Applicant spent as least \$500,000 per year on digital marketing and advertising prominently featuring Applicant’s Mark. (See January 18, 2022 Response to Office Action, TSDR at 23.) This is evidence of the widespread exposure of the public to Applicant’s Mark used as a trademark. Additionally, Applicant has widely used Applicant’s Mark in advertising across a wide variety of channels receiving a significant number of impressions, including Applicant’s website, mobile application, signage at over 2,000 physical locations in the United States, on printed parking tickets, on social media, and other targeted advertisements. (*Id.* at 19.)

**4. Amount of Sales, Number of Customers, and Applicant’s Size.**

The size of a company and its sales figures are relevant evidence from which to infer the existence of secondary meaning. *Turner v. HMH Pub. Co.*, 380 F.2d 224, 228, 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. The trade and service marks ‘Playboy,’ ‘Playboy Club’ and ‘Playmate’ have, through extensive use and promotion of plaintiffs, acquired a secondary meaning of sufficient strength to justify enjoining infringement by defendants.”).

Applicant has presented evidence as to Applicant’s company size and sales figures, which includes, at least, generation of more than ***four hundred million dollars***

(\$400,000,000) in parking sales from use of the Applicant's Mark in year 2020 alone. (See January 28, 2022 Response to Office Action, TSDR at 24.)

**5. The USPTO has allowed similar trademarks to register.**

Applicant has submitted evidence that the Trademark Office has allowed similar .COM marks to register. At least 384 .COM/.EDU/.ORG marks registered within five months from the Booking.com decision, some of which had faced genericness rejections.<sup>12</sup> In particular, the following marks<sup>13</sup> previously faced a genericness 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, entertainment in the nature of a bounce house and magic shows	Nov. 17, 2020

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

<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

<sup>12</sup> (December 11, 2020 TEAS Request Reconsider after FOA, TSDR at 9.)

<sup>13</sup> Registration certificates can be found in December 11, 2020 TEAS Request Reconsider after FOA, TSDR pp. 85–88. and April 6, 2020 Response to Office Action, TSDR pp. 27 and 65. JEWISH.COM was since cancelled on April 24, 2020.

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 as 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.

Even if the Board finds that this is a close case, the Board should resolve its doubts in favor of Applicant. See e.g., *In re Waverly Inc.*, 27 U.S.P.Q.2d 1620, 1624 (TTAB 1993) ("Although the record herein presents a close case, any doubt on the matter should be resolve in applicant's favor and the mark should be published for the purposes of opposition.").

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 Examination Guide No. 3-20, 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 **four hundred million dollars (\$400,000,000)** in the year 2020 alone. 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. HMH 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 . . ."). 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 Indus., 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 as a source indicator. Applicant has used Applicant’s Mark extensively, including but not limited to (i) prominently on Applicant’s website, which received over **one million page views** from U.S. users in 2021 and more than **six million page views** from U.S. users from 2018-2021; (ii) prominently on Applicant’s mobile application, through which customers made over **one million transactions** in 2021; (iii) in Applicant’s email advertisements, which have 800,000 subscribers and reach more than 500,000 customers **each month**; (iv) on printed parking facility access tickets, over **100 million** of which have been distributed from 2019 to 2021; and (v) on prominent signage and posters at **over 2,000** locations across the United States. (See January 18, 2022 Response to Office Action, TSDR at 19–24.) Moreover, Applicant prominently displays Applicant’s Mark as a key component of its advertising and marketing strategy, and has spent substantial amount of money in marketing and advertising. In particular, during the period of 2018 to 2021, Applicant spent **at least \$500,000 per year** on digital marketing and advertising prominently feature Applicant’s Mark. (See *id.*) In total, Applicant spent **over two million dollars** on such advertising—a significant amount for a four year period. (See *id.*) Based on its digital advertising, marketing and website, Applicant estimates that Applicant’s Mark makes **more than two million impressions per year**.

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.<sup>14</sup> 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 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.

Angelo J. Bufalino  
Vedder Price P.C.  
222 North LaSalle Street  
Chicago, Illinois 60601  
T: +1 (312) 609 7500

Respectfully submitted,

VEDDER PRICE P.C.  
By:           / Angelo J. Bufalino /            
Angelo J. Bufalino

Dated: August 8, 2022

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<sup>14</sup> (December 11, 2020 TEAS Request Reconsideration after FOA, at 54–83.)