

To: ANGELO J BUFALINO(abufalino@vedderprice.com)
Subject: U.S. Trademark Application Serial No. 87906630 - PARKING.COM - 38117020068 - Examiner Brief
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Attachments

United States Patent and Trademark Office (USPTO)

U.S. Application Serial No. 87906630

Mark: PARKING.COM

Correspondence Address:

ANGELO J BUFALINO
VEDDER PRICE PC
222 NORTH LASALLE ST 24TH FL
CHICAGO IL 60601 UNITED STATES

Applicant: SP Plus Corporation

Reference/Docket No. 38117020068

Correspondence Email Address: abufalino@vedderprice.com

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant, SP Plus Corporation, has appealed the trademark examining attorney's refusal to register the mark PARKING.COM for "Website providing information regarding parking availability."

Registration is refused on the Supplemental Register because the applied-for mark is generic and thus incapable of distinguishing applicant's services. Trademark Act Sections 23(c) and 45, 15 U.S.C. §§1091(c), 1127; *see* TMEP §§1209.01(c) *et seq.*

In the alternative, registration is refused on the Principal Register because the applied-for mark merely describes a feature of applicant's services, and applicant's evidence of acquired distinctiveness is

insufficient to overcome the refusal. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

ISSUES

The issue on appeal is whether the applicant's mark, PARKING.COM, is generic or, in the alternative, merely descriptive of the services, "Website providing information regarding parking availability." Trademark Act Sections 23(c) and 45, 15 U.S.C. §§1091(c), 1127; *see* TMEP §§1209.01(c) *et seq.* and Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

STATEMENT OF THE FACTS

On May 3, 2018, applicant applied to register PARKING.COM for "Website providing information regarding parking availability." On September 4, 2018, the Office issued an action refusing registration based on mere descriptiveness. On January 29, 2019, applicant responded with an amendment to the Supplemental Register and an amendment to allege use. On March 11, 2019, the Office issued an action refusing registration based on genericness. On September 11, 2019, applicant responded with arguments against genericness. On October 5, 2019, the Office accepted the amendment to allege use. On October 9, 2019, the Office responded with a request for information, while maintaining the refusal based on genericness. On April 9, 2020, applicant responded with arguments against refusal and provided the requested information. On June 11, 2020, the Office issued a final refusal based on genericness. On December 11, 2020, applicant responded with a request for reconsideration and an appeal to the board. On February 11, 2021, the Office rejected applicant's request for reconsideration. On April 18, 2021, applicant submitted an appeal brief in support of registration. On June 17, 2021, the board remanded the case back to the examiner for further consideration of a claim of acquired distinctiveness. On July 15, 2021, the Office maintained the generic refusal and rejected the sufficiency of applicant's claim of acquired distinctiveness. On January 18, 2022, applicant responded with arguments against refusal and additional evidence. On May 12, 2022, the Office issued a subsequent final based on genericness.

This resumed appeal followed.

ARGUMENT

Registration is refused on the Supplemental Register because the applied-for mark is generic and thus incapable of distinguishing applicant's services. Trademark Act Sections 23(c) and 45, 15 U.S.C. §§1091(c), 1127; *see* TMEP §§1209.01(c) *et seq.*

In the alternative, registration is refused on the Principal Register because the applied-for mark merely describes a function or feature of applicant's services and applicant has provided insufficient evidence of acquired distinctiveness. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

A term is generic if its primary significance to the relevant public is the class or category of goods or services with which it is used. *See USPTO v. Booking.com B.V.*, 140 S. Ct. 2298, 2304, 2020 USPQ2d 10729, at *5 (2020); *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 965, 114 USPQ2d 1827, 1830 (Fed. Cir. 2015); TMEP §1209.01(c)(i). “[A] term [also] 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.” *Royal Crown Co., Inc. v. Coca-Cola Co.*, 892 F.3d 1358, 1367-68, 127 USPQ2d 1041, 1046-47 (Fed. Cir. 2018).

Generic terms do not meet the statutory definition of a trademark because they are incapable of indicating a particular source of services and thus cannot be registered. *USPTO v. Booking.com B.V.*, 140 S. Ct. 2303, 2020 USPQ2d 10729, at *3-4; *In re Cordua Rests., Inc.*, 823 F.3d at 599, 118 USPQ2d at 1634; TMEP §1209.01(c).

Applicant's alternative claim of acquired distinctiveness on the principal register is insufficient because the mark is generic, and a claim of acquired distinctiveness cannot render generic matter registrable. *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 1370, 127 USPQ2d 1041, 1048 (Fed. Cir. 2018); *see* TMEP §1212.02(i).

Therefore, registration is refused because the applied-for mark merely describes the genus of applicant's services, and applicant's evidence of acquired distinctiveness is insufficient to show that the mark is not generic. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

In the alternative, registration is refused because the applied-for mark merely describes a feature of applicant's services, and applicant's evidence of acquired distinctiveness is insufficient to overcome the refusal. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

I. APPLICANT'S MARK IS GENERIC BECAUSE IT IDENTIFIES A GENUS OF INFORMATION AND A MODE OF DELIVERY THAT THE CONSUMING PUBLIC WOULD NOT RECOGNIZE AS SIGNIFYING THE SOURCE OF SERVICES

The test for determining whether an applied-for mark is generic is its primary significance to the relevant public. *See USPTO v. Booking.com B.V.*, 140 S. Ct. 2298, 2304, 2020 USPQ2d 10729, at *5 (2020); TMEP §1209.01(c)(i). Making this determination involves a two-step inquiry:

- (1) What is the genus of services at issue?
- (2) Does the relevant public understand the designation primarily to refer to that genus of services?

In re Cordua Rests., Inc., 823 F.3d 594, 599, 118 USPQ2d 1632, 1634 (Fed. Cir. 2016); TMEP §1209.01(c)(i).

What is the genus of services at issue?

Regarding the first part of the inquiry, the genus of the services is defined by an applicant's identification of services. *See In re Cordua Rests., Inc.*, 823 F.3d at 602, 118 USPQ2d at 1636. In the present case, the application identifies the services as a "[w]ebsite providing information regarding parking availability,"

The evidence from the *American Heritage Dictionary* attached to the Office action issued September 4, 2018 shows that the term PARKING means "[s]pace in which to park vehicles or a vehicle: *ample parking behind the building.*"^[1] In addition, applicant's EXHIBIT A submitted in its Response to Office Action date January 18, 2022, shows the use of the terms "park," "parking," "parker," "parking rates," "find parking at," "event parking," and others to describe its parking services.^[2]

The non-source-identifying generic top-level domain (gTLD) .COM merely indicates an Internet address for use by commercial, for-profit organizations. *See, e.g., Booking.com B.V. v. USPTO*, 915 F.3d 171, 185 (4th Cir. 2019), *aff'd*, 140 S. Ct. 2298, 2304, 2020 USPQ2d 10729, at *2 (2020) ("Where the proposed mark is a composite that includes .com, we clarify thatcom does not itself have source-identifying significance when added to [a second-level domain] like booking."); *In re 1800Mattress.com IP LLC*, 586 F.3d 1359, 1364, 92 USPQ2d 1682, 1685 (Fed. Cir. 2009); *In re Oppedahl & Larsen LLP*, 373 F.3d 1171, 1175-77, 71 USPQ2d 1370, 1373-74 (Fed. Cir. 2004); *see also* TMEP §§1209.03(m), 1215.01. *Also see* evidence from *The American Heritage Dictionary* defining .COM as an abbreviation for "commercial organization (in internet addresses),"^[3] and evidence from *Wikipedia* and *Verisign* attached to the Office action issued September 4, 2018 further showing that .COM is a general-purpose, generic top-level domain that originated in 1985 as one of the first top-level domains.^[4]

When these two generic terms are combined, they create a generic phrase that indicates a website offering parking information, or a commercial parking website.

Does the relevant public understand the designation primarily to refer to that genus of services?

Regarding the second part of the inquiry, the relevant public is the purchasing or consuming public for

the identified services. *Loglan Inst. Inc. v. Logical Language Grp., Inc.*, 962 F.2d 1038, 1041, 22 USPQ2d 1531, 1533 (Fed. Cir. 1992). In this case, the relevant public comprises vehicle drivers who need parking. The evidence from the Office action dated March, 11, 2019 shows evidence from 11 providers who provide parking websites similar to the applicant's for providing information for vehicle drivers who need parking.^[5] In addition, the evidence attached to the Office actions dated February 11, 2021 and May 12, 2022 shows webpages from at least 30 providers offering services similar to the applicant's, all accessed via website addresses ending with PARKING.COM. These include:

<https://www.365-PARKING.COM/>

<https://lazPARKING.COM/>

<https://www.americanPARKING.COM>

<https://www.allentownPARKING.COM/>

<http://www.dailytruckPARKING.COM/>

<https://www.annapolisPARKING.COM/>

<https://parkwayPARKING.COM/>

<https://www.cheapairportPARKING.ORG/>

<https://www.pmi-PARKING.COM/>

<https://citiPARKING.COM/>

<https://www.snap-PARKING.COM/>

<https://federalPARKING.COM/>

<http://www.studentPARKING.COM/>

<https://www.fortworthPARKING.COM/>

<https://www.thriftyPARKING.COM/>

<https://www.offcampusPARKING.COM/>

<https://www.bestPARKING.COM/>

<https://www.premiumPARKING.COM/>

<https://hartfordPARKING.COM/>

<https://www.stlouisPARKING.COM/>

<https://www.citycenterPARKING.COM/>

<https://usairportPARKING.COM/>

<https://www.preferredPARKING.COM/>

<https://www.vegas-airport-PARKING.COM/>

Emphasis added. In addition to the above third-party use of applicant's mark in URLs, the following providers for the same or similar services use formative PARKING.COM as trademarks:

<https://airportPARKING.COM/>

<https://www.baltimorePARKING.COM/>

<https://eauclairePARKING.COM/>

<https://www.ezcruisePARKING.COM/>

<https://www.memorialairportPARKING.COM/>

Emphasis added.^[6]

This evidence shows that parking websites are ubiquitous and that many providers use the phrase PARKING.COM to convey the genus of information that users can expect to find on the providers' respective websites. The name of an ingredient, a key aspect, a central focus or feature, or a main characteristic of services may be generic for those services. *See In re Cordua Rests., Inc.*, 823 F.3d 594, 604, 118 USPQ2d 1632, 1637-38 (Fed. Cir. 2016) (affirming the Trademark Trial and Appeal Board's holding of CHURRASCOS (a type of grilled meat) generic for restaurant services); *In re Hikari Sales USA, Inc.*, 2019 USPQ2d 111514, at *13 (TTAB 2019) (holding ALGAE WAFERS generic for fish food); TMEP §1209.03(v). Thus, a term does not need to be the name of a specific service to be found generic. Any term that the relevant public understands to refer to the genus can be generic. *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 1367, 127 USPQ2d 1041, 1046 (Fed. Cir. 2018) (quoting *In re Cordua Rests., Inc.*, 823 F.3d at 603, 118 USPQ2d at 1637 (Fed. Cir. 2016)). The fact that so many providers choose to incorporate the applicant's mark, PARKING.COM, into their URLs offering parking information shows that the term describes the genus of the information provided and the genus of the mode of delivery for that information.

Accordingly, and contrary to applicant's assertion, the examining attorney *has* established that applicant's use of the word PARKING refers to the genus of applicant's services and the addition of the gTLD .COM refers to the genus of the mode of access. "An inquiry into the public's understanding of a mark requires consideration of the mark as a whole." *In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 1363, 92 USPQ2d 1682, 1684 (Fed. Cir. 2009). However, a compound of generic elements is also generic "if the combination yields no additional meaning to consumers capable of distinguishing the goods [and/]or services." *USPTO v. Booking.com B.V.*, 140 S. Ct. 2298, 2306, 2020 USPQ2d 10729, at *7 (2020) (emphasis omitted). Specifically, if each of the constituent words in a proposed mark is generic, the combination is generic when the entire formulation does not add any meaning to the

otherwise generic mark. *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 967, 114 USPQ2d 1827, 1831 (Fed. Cir. 2015); TMEP §1209.01(c)(i).

Applicant's assertion that the ruling in BOOKING.COM changes the analysis in this case is unpersuasive. *See* Applicant's Brief p. 5. In that case the Supreme Court noted that the Court did not “embrace a rule automatically classifying such terms as nongeneric.” *USPTO v. Booking.com B.V.*, 140 S. Ct. 2298, 2307. Indeed, the Court clearly stated that, “[w]hether any given 'generic.com' term is generic, we hold, 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.” *Id.* The Court further elaborated on types of evidence that can determine when a generic term and a generic top level domain name would be found generic, including “surveys, dictionaries, usage by consumers and competitors, and any other source of evidence bearing on how consumers perceive a term’s meaning.” *Id.* at 2308. In the present case, the examining attorney does *not* rely on prior policy to determine that applicant's mark is generic. Instead, the examining attorney relies on evidence from dictionaries and other reference materials, evidence of competitors' usage, and evidence of applicant's own usage consistent with the BOOKING.COM decision—

In summary, the evidence submitted by the examining attorney shows that .COM is a ubiquitous and recognized gTLD. When combined with the word PARKING, the only impression created is that applicant's information about parking will be provided online. There is no double entendre created. There is no special meaning conveyed. This analysis is consistent with law prior to BOOKING.COM and after BOOKING.COM. Further, applicant's evidence of sales and advertising falls short of the evidence in BOOKING.COM consisting of consumer surveys, and, therefore, fails to show a change in consumer perception of the term PARKING.COM from that of a generic term for a commercial parking website.

Therefore, taken as a whole, applicant's mark is generic for applicant's services.

II. APPLICANT'S ARGUMENTS AGAINST THE GENERIC REFUSAL ARE UNPERSUASIVE

Applicant argues that the STEELBUILDING.COM case indicates that the addition of .COM necessarily expands the “meaning of the mark to include goods and services beyond the mere [identified services].” *See* Applicant's Brief p. 7. However, this quote is offered without the context of the case. In fact, if applicant's interpretation were accurate, the addition of .COM would make all marks non-generic. Instead, the court in STEELBUILDING.COM relied heavily on the evidence of record and other factors. In concluding its analysis, the court stated:

In sum, the Board erroneously: (1) construed the genus of applicant's services and goods too narrowly; (2) discounted the ambiguities and multiple meanings in the mark; and (3) dismissed the addition of the TLD indicator despite its expansion of the meaning of "STEELBUILDING.COM."

In re Steelbuilding.com, 415 F.3d 1293, 1301. In the present case, applicant's identification of services is consistent with the genus of a parking website, and the examiner has not dismissed the addition of the gTLD, but instead provided evidence and arguments for why the gTLD does not change the generic nature of the mark.

Applicant also argues that its mark is source identifying because it consists of a URL that only one user

can hold. Applicant's Brief pp. 7,8. However, this misunderstands the nature of URL ownership. Applicant has only been using the mark and URL for a short period of time, just over 4 years. See Applicant's Brief p. 14. This suggests that the URL was owned by a prior user. It also means that applicant may someday lose control of the URL while keeping control of the trademark or vice versa. A domain name registrar is not required to hand over domain names to trademark registrants and the USPTO is not obligated to hand over a registration to URL registrants. These two pieces of intellectual property, outside extenuating circumstances, remain separate from one another. Accordingly, the use of a GENERIC.COM trademark does not show that the applicant uses or owns the corresponding URL and, therefore, does not show evidence that consumers can assume a single source.

Applicant next argues that the examining attorney's evidence of third-party use fails to show that the mark is generic, in part because most users do not use the mark as a trademark. Applicant's Brief pp.8-11. This line of argument misunderstands the nature of generic marks. Contrary to the applicant's conclusion, the fact that so many other users incorporate applicant's mark without using it in a trademark manner indicates that the many other users of PARKING.COM see the URL as a generic informational indicator, not as a source identifier.

Applicant also incorrectly suggests that TMEP §1212.06(d) indicates that "survey evidence is not required to show nongenericness." Applicant's Brief pp. 11-12. However, TMEP §1212.06(d) concerns acquired distinctiveness and secondary meaning, which are concepts related to the principal register:

If a proposed trademark or service mark is not inherently distinctive, it may be registered on the Principal Register only upon proof of acquired distinctiveness, or "secondary meaning," that is, proof that it has become distinctive as applied to the applicant's goods or services in commerce. If the applicant establishes, to the satisfaction of the examining attorney, that the matter in question has acquired distinctiveness as a mark in relation to the named goods or services, then the mark is registrable on the Principal Register under §2(f)

of the Trademark Act, 15 U.S.C. §1052(f).

TMEP §1212. These concepts do not neatly transfer to genericness analysis. In the case of generic terms, some kind of direct evidence must be provided to overcome a generic refusal. A successful seller of hamburgers could spend millions of dollars promoting its mark HAMBURGER, but this would not be evidence that the word HAMBURGER is no longer generic for hamburgers. In this case, applicant has provided little to no evidence that consumers recognize that PARKING.COM refers to a specific provider of services.

Applicant also argues that its mark could only be generic if people refer to parking websites as PARKING.COMs. Applicant's Brief p. 12. Although applicant relies on an example in BOOKING.COM, this concept, as discussed above, is explicitly rejected by the same case. *See USPTO v. Booking.com B.V.*, 140 S. Ct. 2298, 2307. There is no evidence of record to show that anyone refers to any genus of services or goods as a GENERIC.COM. If genericness relied on this premise, then adding a gTLD to any mark would make it non-generic, which is inconsistent with the ruling in BOOKING.COM.

Applicant next argues that its length, degree, and exclusivity of use of its mark shows that its mark is not generic. *See* Applicant's Brief p. 14. This argument is unpersuasive. Applicant has only used its mark for a short time, and it has not used it exclusively as the evidence attached to the Office actions dated February 11, 2021 and May 12, 2022 shows.^[7] In fact, as discussed above, parking websites use PARKING.COM regularly to provide the same services as the applicant because the term PARKING.COM clearly conveys the genus of the services.

Finally, applicant argues that other registrants have received registration for similar marks. *See* Applicant's Brief pp. 16-17. This argument is unpersuasive because prior decisions and actions of other trademark examining attorneys in applications for marks have little evidentiary value and are not

binding upon the USPTO or the Trademark Trial and Appeal Board. TMEP §1207.01(d)(vi); *see In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1793 n.10 (TTAB 2017). Each case is decided on its own facts, and each mark stands on its own merits. *In re Cordua Rests., Inc.*, 823 F.3d 594, 600, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016). Using other cases as evidence of acceptability on the register would lead to endless relitigation of registrations that were decided by different examiners, over many years, relying on different case law and policy.

Therefore, applicant's arguments against the generic refusal are unpersuasive.

III. APPLICANT'S EVIDENCE IS INSUFFICIENT TO SHOW THAT ITS MARK IS NOT GENERIC

Applicant has provided evidence of the resources it has expended promoting its website and services and also provided evidence of the income from the same.^[8] However, applicant cannot overcome this refusal by submitting a claim of acquired distinctiveness under Trademark Act Section 2(f). *See* 15 U.S.C. §1052(f). Such a claim would be insufficient because “generic terms cannot be rescued by proof of distinctiveness or secondary meaning no matter how voluminous the proffered evidence may be.” *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 1370, 127 USPQ2d 1041, 1048 (Fed. Cir. 2018); *see* TMEP §1212.02(i).

Notably, applicant provided virtually no direct evidence that consumers see its mark as source indicating. It has produced evidence of its attempt to convince consumers of this, but no matter how much money and advertising applicant puts into this pursuit, capturing a generic term for one's self is an arduous task that cannot be verified without direct evidence of the fact. *Id.* In this case, the lack of direct evidence of consumers regarding applicant's mark as source indicating is particularly damning because so many third-party users use applicant's mark. The fact that applicant can generate so much

revenue by securing a generic URL is not surprising. This is why generic website names are so useful for companies to reserve because users can more easily remember the generic name of a service than one that requires distinct memory or imagination.

Therefore, applicant's submission of additional evidence does not obviate the generic refusal.

IV. APPLICANT'S MARK IS HIGHLY DESCRIPTIVE AND THE CLAIM OF ACQUIRED DISTINCTIVENESS AND EVIDENCE IN SUPPORT OF ITS CLAIM IS INSUFFICIENT TO OVERCOME THE DESCRIPTIVE REFUSAL

Applicant has asserted, in the alternative, that its mark has acquired distinctiveness and should be allowed on the Principal Register. See Applicant's Brief pp.17-20. However, as explained above, no amount of evidence can turn a generic mark into a non-generic mark. *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 1370, 127 USPQ2d 1041, 1048 (Fed. Cir. 2018); *see* TMEP §1212.02(i).

However, if the mark is determined *not* to be generic, registration is refused because the applied-for mark merely describes a function or feature of applicant's services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

Applicant's claim of acquired distinctiveness is concession that the mark sought to be registered is merely descriptive of applicant's services. *In re Virtual Indep. Paralegals, LLC*, 2019 USPQ2d 1626, 16291 (Fed. Cir. 2009). Further, the above discussed evidence demonstrates that the applied-for mark is highly descriptive of applicant's services. *See In re MetPath Inc.*, 1 USPQ2d 1750, 1751-52 (TTAB 1986); TMEP §1212.06.

The amount and character of evidence required to establish acquired distinctiveness under Trademark Act Section 2(f) depends on the facts of each case and particularly on the nature of the mark sought to

be registered. *In re Gen. Mills IP Holdings II, LLC*, 124 USPQ2d 1016, 1018 (TTAB 2017); TMEP §1212.01. An applicant's evidentiary burden of showing acquired distinctiveness increases with the level of descriptiveness of the mark sought to be registered; a more descriptive term requires more evidence. *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 1365, 127 USPQ2d 1041, 1045 (Fed. Cir. 2018). Thus, if an applicant's proposed mark is highly descriptive of applicants services, as has been shown in the present case, then the applicant's burden of establishing acquired distinctiveness under Section 2(f) is commensurately high. *See In re GJ & AM, LLC*, 2021 USPQ2d 617, at *37-38 (TTAB 2021).

In this case, applicant primarily provided sales and advertising expenditures for its services to support its claim that the applied-for mark has acquired distinctiveness under Trademark Act Section 2(f).^[9] However, this evidence is not dispositive of that claim. *See* 15 U.S.C. §1052(f). Applicant's sales and promotion figures may demonstrate the commercial success of applicant's services, but not that relevant consumers view the matter as a mark for these services. *See In re Boston Beer Co.*, 198 F.3d 1370, 1371-73. Advertising expenditures are merely indicative of efforts to develop distinctiveness; not evidence that the mark has acquired distinctiveness. *See In re Pennzoil Prods. Co.*, 20 USPQ2d 1753, 1757-58 (TTAB 1991).

Furthermore, applicant's evidence is provided without the context of market data. Applicant states, without evidence, that it is "the leading provider of professional parking management services throughout North America."^[10] But, without information describing the marketplace, including the income and expenditures of competitors or actual market share data, applicant's numbers have little meaning and applicant's claim amounts to mere puffery.

Without additional evidence showing how applicant is educating the public to associate the proposed mark with a single source, this evidence is not probative. TMEP §1212.06(b) (citing *In re Redken Labs., Inc.*, 170 USPQ 526, 529 (TTAB 1971) (holding Section 2(f) evidence insufficient to establish acquired distinctiveness notwithstanding long use of the mark and significant promotion and sponsorship expenses, where advertising and promotional material showed only descriptive usage of applied-for mark)); *see In re OEP Enters., Inc.*, 2019 USPQ2d 309323, at *25 (TTAB 2019) (holding

Section 2(f) evidence including significant sales and advertising figures deficient in part because “[a]pplicant’s consumer facing advertisements, like its ones to the trade, do little more than show the products, and they do not establish that consumers associate the features of the applied-for trade dress mark with [a]pplicant”).

Therefore, applicant's claim of acquired distinctiveness is insufficient.

CONCLUSION

Applicant's mark, “PARKING.COM,” is generic for or, in the alternative, merely descriptive of the services, "Website providing information regarding parking availability" with insufficient evidence of acquired distinctiveness. For the foregoing reasons, the examining attorney respectfully requests that the refusal of registration be affirmed. Trademark Act Sections 23(c) and 45, 15 U.S.C. §§1091(c), 1127; *see* TMEP §§1209.01(c) *et seq.* and Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

Respectfully submitted,

/DETJr/
David Tooley
Trademark Examining Attorney
Law Office 125
(571) 272-8206
david.tooley@uspto.gov

/Heather Biddulph/
Managing Attorney
Law Office 125

End Notes

1. September 4, 2018 Office action in TSDR at pp. 2-3.
2. January 18, 2022 Response to Office action in TSDR at pp. 26-59.
3. Examining attorney respectfully requests that the Board take judicial notice of the following definition: ".com." *The American Heritage® Dictionary of the English Language, Fifth Edition.*

Retrieved October 5, 2022, from <https://www.ahdictionary.com/word/search.html?q=.com>.

4. September 4, 2018 Office action in TSDR at pp. 4-11
5. March 11, 2019 Office action pp. 2-50.
6. February 11, 2021 Reconsideration letter pp. 2-59 and May 12, 2022 Office action pp. 2-38.
7. February 11, 2021 Reconsideration letter pp. 2-59 and May 12, 2022 Office action pp.2-38.
8. January 18, 2022 Response to Office action.
9. January 18, 2022 Response to Office action.
10. January 18, 2022 Response to Office action p. 18

United States Patent and Trademark Office (USPTO)

USPTO OFFICIAL NOTICE

Examining attorney's appeal brief has issued
on October 11, 2022 for
U.S. Trademark Application Serial No. 87906630

A USPTO examining attorney has issued an appeal brief. Follow the steps below.

- (1) **[Read the appeal brief](#)**. This email is NOT the appeal brief.
- (2) **Submit reply brief within 20 days of October 11, 2022**, if you wish to do so. If submitted, a reply brief must be submitted using the [Electronic System for Trademark Trials and Appeals \(ESTTA\)](#) and received by the USPTO on or before 11:59 p.m. **Eastern Time** of the last day of the reply period.
- (3) **Direct questions** about the appeal proceeding to the Trademark Trial and Appeal Board at 571-272-8500 or TTABInfo@uspto.gov.