

This Opinion is Not a
Precedent of the TTAB

Hearing: July 12, 2022

Mailed: September 30, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re ResponsiveAds, Inc.
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Serial No. 88453313
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Joel N. Bock, Dentons US LLP, for ResponsiveAds, Inc.

Christina M. Riepel, Trademark Examining Attorney, Law Office 124,
Lydia Belzer, Managing Attorney.

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Before Taylor, Coggins, and Johnson,
Administrative Trademark Judges.

Opinion by Johnson, Administrative Trademark Judge:

ResponsiveAds, Inc. (“Applicant”) seeks registration on the Principal Register of the proposed mark RESPONSIVEADS,¹ in standard characters, for services (“Applicant’s Services”) identified as:

Advertising, marketing and promotional services relating to structuring, formatting, layout, generation, and distribution of advertising content and creatives material, namely, creative marketing design services and

¹ Application Serial No. 88453313 was filed on May 30, 2019 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant’s claim of first use anywhere and first use in commerce since at least as early as August 28, 2012.

distribution of advertising materials; creative marketing design assistance in structuring, formatting, layout, generation, and distribution of marketing, promotional and advertising materials and content; content management services, namely, database management; creative design and ideation services in the fields of promotion, marketing and advertising; ad serving, namely, placing advertisements on websites for others using specialized computer software, in International Class 35; and

Providing online non-downloadable software accessible via a browser that provides software tools for structuring, formatting, layout, generation, and delivery of content and advertising creative material; providing online non-downloadable software accessible via a browser that provides assistance in structuring, formatting, layout, generation, and delivery of marketing, promotional and advertising materials and content; providing online non-downloadable software accessible via a browser that provides software tools for managing content and advertising creative material; application service provider, namely, hosting, managing, developing, analyzing, and maintaining applications, and software of others in the fields of advertising and marketing; advertising, marketing and promotional services relating to structuring, formatting, and layout of content, namely, graphic design of marketing materials; graphic design assistance in structuring, formatting, and layout of marketing, promotional and advertising materials and content, in International Class 42.

The Trademark Examining Attorney refused registration on the ground that the proposed mark is generic for the identified services under Sections 1, 2, 3, and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052, 1053, and 1127; and in the alternative, if not generic, the proposed mark is merely descriptive of the services under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), without having acquired distinctiveness under Section 2(f), 15 U.S.C. § 1052(f).

When the refusals were made final, Applicant appealed. The appeal has been briefed.² We affirm the refusals to register.

I. Refusal of Registration under Trademark Act Sections 1, 2, 3, and 45

The Examining Attorney contends that RESPONSIVEADS is incapable of distinguishing Applicant’s Services because it is generic for them. “Generally, where the matter sought to be registered identifies [services] that are a primary or central focus of the [business], we have considered the term to be generic.” *In re Cordua Rests. LP*, 100 USPQ2d 1227, 1231 (TTAB 2014) (citations omitted) (bracketed words in original), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016).

The United States Court of Appeals for the Federal Circuit has set forth a two-step inquiry to determine whether a mark is generic:

- First, what is the genus (category or class) of goods or services at issue? *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). The genus, in appropriate circumstances, may be defined by the services identified in the application. *See, e.g., Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) (“a proper genericness inquiry focuses on the identification set forth in the application or

² Citations to the appeal record are from the publicly available documents in TTABVUE, the Board’s electronic docketing system. *See, e.g., Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). The number preceding “TTABVUE” corresponds to the docket entry number; the number(s) following “TTABVUE” refer to the page number(s) of that particular docket entry, if applicable.

Citations to the application record are to downloadable .pdf versions of the documents in the Trademark Status and Document Retrieval (TSDR) database of the United States Patent and Trademark Office (USPTO).

certificate of registration”); *In re Reed Elsevier Props. Inc.*, 77 USPQ2d 1649, 1653 (TTAB 2005) (quoting *Magic Wand*, 19 USPQ2d at 1552), *aff'd*, 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007).

- Second, is the term sought to be registered understood by the relevant public primarily to refer to that genus of goods or services? *Marvin Ginn*, 228 USPQ at 530; *see also Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 114 USPQ2d 1827, 1833 (Fed. Cir. 2015) (the relevant public’s perception is the principal consideration in determining whether a term is generic). The relevant public encompasses “actual [and] potential purchasers of . . . goods or services” identified in the application. *Loglan Inst. Inc. v. Logical Language Grp. Inc.*, 962 F.2d 1038, 22 USPQ2d 1531, 1533 (Fed. Cir. 1992) (quoting *Magic Wand*, 19 USPQ2d at 1553); *see Sheetz of Del., Inc. v. Doctor’s Assocs. Inc.*, 108 USPQ2d 1341, 1351 (TTAB 2013) (citing *Magic Wand*, 19 USPQ2d at 1553).

“An inquiry into the public’s understanding of a mark requires consideration of the mark as a whole.” *Princeton Vanguard*, 114 USPQ2d at 1831 (quoting *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005)). “Even if each of the constituent words in a combination mark is generic, the combination is not generic unless the entire formulation does not add any meaning to the otherwise generic [term].” *In re 1800Mattress.com IP LLC*, 586 F.3d 1359, 92 USPQ2d 1682, 1684 (Fed. Cir. 2009) (quoting *In re Steelbuilding.com*, 75 USPQ2d at 1421); *see also Princeton Vanguard*, 114 USPQ2d at 1832.

Evidence of the relevant public's understanding of a term may be obtained from "any competent source, such as consumer surveys, dictionaries, newspapers and other publications." *Princeton Vanguard*, 114 USPQ2d at 1830 (quoting *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985)).

A. Whether RESPONSIVEADS is Generic for the Recited Services

We look to the evidence of record to determine whether RESPONSIVEADS is generic for the services recited in the application.

1. Defining the Genus of RESPONSIVEADS

Here, the genus of RESPONSIVEADS is adequately defined by the services recited in the application. If the proposed mark is generic for any one of the services in the identification, registration is appropriately refused for that entire class of services. *In re Katch, LLC*, 2019 USPQ2d 233842, at *10 (TTAB 2019).

2. The Relevant Public for the Services

Applicant describes the relevant public for its services not as ordinary consumers or purchasers, but as "highly sophisticated business purchasers who would not use or understand [the proposed mark] in a generic or descriptive manner relative to Applicant's services," (6 TTABVUE 8; *see also* Mar. 30, 2021 Response to Office Action at p. 2). The Examining Attorney contends the relevant public for Applicant's Services "includes all consumers who seek to advertise or market a product or service, including both non-professionals in the field of advertising and marketing, as well as advertising and marketing professionals." (*See* Examining Attorney's Brief,

8 TTABVUE 7-8). But “[t]he critical issue in genericness cases is whether members of the relevant public primarily use or understand the term to be protected to refer to the genus of goods or services in question.” *Marvin Ginn*, 228 USPQ at 530.

“[T]he determination of whether a mark is generic must be made in relation to the goods or services for which registration is sought, not in the abstract.” *In re Virtual Independent Paralegals, LLC*, 2019 USPQ2d 111512, at *2 (TTAB 2019). Since there are no restrictions or limitations to the channels of trade or classes of consumers for Applicant’s Services, those services and the relevant purchasers for them may not be limited by extrinsic argument or evidence. *See Remington Prods., Inc. v. N. Am. Philips Corp.*, 892 F.2d 1576, 13 USPQ2d 1444, 1448 (Fed. Cir. 1990) (the mark must be considered in context, i.e., in connection with the goods); *Magic Wand*, 19 USPQ2d at 1553-54 (“By the words ‘relevant public’ for a product sold in the marketplace, [the Trademark Clarification Act of 1984] means the relevant public which does or may purchase the goods or services in the marketplace.”); *see also Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1463 (TTAB 2014) (“The question of registrability must be determined, in proceedings before the Board, on the basis of the services as set forth in the registrations, rather than in reference to the precise nature of the services on or in connection with which the marks are actually used or intended to be used.”). Based on the services recited in the application, we find that the relevant public for RESPONSIVEADS are consumers who seek to advertise or market a product or

service, including both non-professionals as well as advertising and marketing professionals.

3. Does the Relevant Public Understand RESPONSIVE ADS Primarily to Refer to the Genus of Services?

Next we consider whether the relevant public understands the term RESPONSIVE ADS, when used in connection with Applicant's Services, to refer to the genus of services.

A key aspect, central focus or feature, or main characteristic of a service may be generic for that service. *In re Cordua Rests.*, 118 USPQ2d at 1637-38 (CHURRASCOS held generic for restaurant services where term referred to a key aspect of a class of restaurants called "churrasco restaurants" that served churrasco steak as the signature dish). "Responsive" is an adjective defined as "quick to respond or react appropriately or sympathetically: sensitive."³ "Ads" is the plural form of the noun "ad," which is defined as "advertisement."⁴ The Google Ads Help glossary describes "responsive ads" as follows (emphasis added):

- Google Ads Help(<https://support.google.com/google-ads/answer/7009645?hl=en>) (emphasis in original):⁵

Responsive ads: Definition

Responsive ads automatically adjust their size, appearance, and format to fit available ad spaces. So a

³ Mar. 6, 2020 Response to Office Action at p. 12 (MERRIAM-WEBSTER DICTIONARY).

⁴ MERRIAM-WEBSTER DICTIONARY (2022) (<https://www.merriam-webster.com/dictionary/ads>) (last visited Sept. 26, 2022). The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *In re tapio GmbH*, 2020 USPQ2d 11387, at *3 n.10 (TTAB 2020).

⁵ Sept. 6, 2019 Office Action at p. 8; Sept. 30, 2020 Office Action at p. 41. *See also* Sept. 30, 2020 Office Action at p. 47 ("Responsive ad requirements").

single responsive ad may appear as a small text ad in one place and a large image ad in another.

Responsive ads fit just about any ad space across the Display Network, and can take on native formatting to match the tone and feel of the websites they show on.

Consistent therewith, the record includes webpages, news articles, blog posts, and documents that use the term “responsive” to describe a key aspect of Applicant’s Services, which include, inter alia, “advertising, marketing, and promotional services relating to structuring, formatting, layout, generation, and distribution of advertising content and creatives material, namely, creative marketing design services and distribution of advertising materials,” and “graphic design assistance in structuring, formatting, and layout of marketing, promotional and advertising materials and content.”

As to the relevant public’s understanding of the term “responsive ads,” the record also demonstrates the following uses⁶ of “responsive ad(s)”⁷ for, inter alia, “advertising, marketing, and promotional services relating to structuring, formatting, layout, generation, and distribution of advertising content and creatives

⁶ Applicant argues that many of the third-party uses the Examining Attorney cites are “junior infringing uses,” and therefore, are not relevant. See Applicant’s Reply Brief, 9 TTABVUE 4, 8. This argument is unavailing, inasmuch as likelihood of confusion is not in issue.

⁷ The presence of a space between “responsive” and “ad(s)” does not alter the probative value of this evidence. Applicant’s proposed mark, RESPONSIVEADS, is the combination of two generic terms joined to create a compound word mark that has “a meaning identical to the meaning common usage would ascribe to those words as a compound.” *In re Wm. B. Coleman Co., Inc.*, 93 USPQ2d 2019, 2025 (TTAB 2010) (quoting *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1111-12 (Fed. Cir. 1987)).

material, namely, creative marketing design services and distribution of advertising materials,” and “graphic design assistance in structuring, formatting, and layout of marketing, promotional and advertising materials and content”:

- Marc Thomas, *Making Advertising Work in a Responsive World*, SMASHING MAGAZINE (Nov. 29, 2012), www.smashingmagazine.com/2012/11/making-advertising-work-in-a-responsive-world/ (emphasis added):⁸

In his article, Josh presents very good points on advertising that are similar to Trent’s idea of **responsive ads**...

If some ad servers accommodate **responsive ads** and others don’t, then some publishers will be left out in the cold.

In a sense, **responsive ads** is the easy part – it’s our thing after all. Without the rest (almost all) of the advertising industry on board we are merely piddling into the wind.

- Allison Otting, *What You to Know About Google’s New AdWords Responsive Ads*, DISRUPTIVE ADVERTISING (Dec. 9, 2016), www.disruptiveadvertising.com/adwords/adwords-gdn-responsive-ads (emphasis added):⁹

As soon as the recent **responsive ads** announcement came out, I remember account strategists immediately approaching me wanting to know what they were and how soon we can get them implemented.

With that in mind, I’ve put together a layman’s explanation of Google’s Display Network (GDN) **Responsive Ads** so you know what they are and how they can affect you.

What are GDN Responsive Ads?

⁸ Sept. 6, 2019 Office Action at pp. 9-34.

⁹ *Id.* at pp. 37-45.

As a designer, I had two immediate impressions when I heard the name of this new format. I figured “responsive” must mean one of two things:

1. The ability to resize and reposition content in relation to the size of a window (e.g. a site that still appears acceptably on tablet and mobile).
2. The ability to be interactive and respond to manipulation by the user by being built in HTML 5 (e.g. an expand view, tabs of contents, etc).

It turns out the GDN **Responsive Ads** is more like the 1st definition of responsive and are not exclusive at all.

Responsive ads use the same information to build ads that can look vastly different depending on their location (as you can see above).

Here are the four elements **responsive ads** are made of.

- A headline(25 characters or less)
- Two description lines (each 35 characters or less)
- One large image
- One logo image

What are the Advantages of GDN Responsive Ads?

There are a few advantages to building GDN **responsive ads**. Let’s take a look at a few of them... .

For companies without designer bandwidth (or a designer at all), GDN **responsive ads** give you a nice option for great, easy-to-build display ads.

So, Who are GDN Responsive Ads For?

Everyone, GDN **Responsive ads** give you a great way to build ads in every size in 2 minutes.

By the way, if you have any more questions about **responsive ads** and the Google Display Network, let me know here or in the comments!

What do you think of the GDN **responsive ads**? Are you excited? Do you think they will be useful?

- Ashley Aptt, *3 Reasons You Need Responsive Ads*, MARIN SOFTWARE MARKETING INSIGHTS BLOG (Mar. 28, 2017), <http://insights.marinsoftware.com/publishers/google-publishers/3-reasons-why-you-need-responsive-ads/> (emphasis added):¹⁰

Responsive ads have been available for a while, but many advertisers have yet to take advantage of this ad format and its powerful features.

If you're currently running standard text ads on the GDN, you should definitely start implementing **responsive ads**.

Here are three key reasons why you should incorporate **responsive ads** in your account.

Responsive ads automatically adjust to various sizes to fit available ad space across the GDN.

Responsive ads can have the appearance of text ads, image ads, and even native ads. They'll even adjust to different devices, which can greatly increase your reach given mobile's popularity.

¹⁰ *Id.* at pp. 46-48.

Responsive ads solve this problem! With **responsive ads**, designers only need to supply a couple images and AdWords will automatically adjust the size, appearance, and format to fit available ad spaces.

Setting up **responsive ads** is a quick and easy process that takes place directly in the AdWords UI.

To create a **responsive ad**, you'll need a headline, description, images, logo, and landing page. Note that **responsive ads** don't support animated images, and images can't contain more than 20% text. Here's what the **responsive ad** builder looks like within AdWords... .

For instance, sometimes Google creates a **responsive ad** that doesn't include the image.

Upgrading to **responsive ads** is easy to implement and provides several added benefits to GDN campaigns.

Start testing **responsive ads** in your account to expand reach to your targeted audience, but be sure to monitor performance and watch for invalid clicks to avoid hurting your conversion rate.

- Bannersnack, www.bannersnack.com/mobile-ads.html (emphasis added): ¹¹

Responsive ads

Keeping track of all the different screen sizes can be a pain. Create **responsive ads** that adjust in size based on the screen size.

¹¹ *Id.* at p. 54.

- ALAN CHARLESWORTH, *DIGITAL MARKETING A PRACTICAL APPROACH* (3rd ed.) (emphasis added):¹²

I even have some control over how the ads appear on my pages by selecting from a range offered by Google. As described by Google, these are ...

- **responsive ads** – allow you to control the size of the ads on your page, in line with how you control the layout of the rest of your page across devices.
- Michelle Courtright, *Responsive Ads + You = Better Leads*, ENVISION CREATIVE BLOG (Nov. 13, 2018), www.envision-creative.com/responsive-ads-you-better-leads/ (emphasis added):¹³

Google has introduced an ad type called **Responsive Ads**. These **responsive ads** (working on Google's Display Network or GDN) come with a host of powerful features that can be modified to meet the specific needs of your business. Let's dive deeper into the who, what, where, and why of **responsive ads** on Google.

Defining **Responsive Ads**

Responsive ads are a newer breed of online advertisements powered by Google.

Responsive ads adapt to different sizes and placements on web pages to make them more agile and adaptive. ... **Responsive ads** are designed to maintain their appearance across many different types of media ad formats.

The long story made short: **Responsive ads** provide you with more control over your messaging technique while providing more room for content to be displayed.

Benefits of **Responsive Ads**

¹² *Id.* at pp. 56-57.

¹³ *Id.* at pp. 58-62.

Responsive ads can benefit your business in many different ways-so let's take a look at some of the top benefits so you're in the know.

Responsive ads are designed to automatically adjust to various sizes across the Google Display Network. ... **Responsive ads** can adapt to fit specific devices, increasing your customer outreach

Responsive ads are essentially an intelligent form of advertising.

In previous ad iterations, you would need to create and optimize each advertisement to reach an intended audience. If you had a campaign with multiple sized ads you wanted to run you would need to create an ad for each banner size, screen size, and platform where the ad would be displayed. ... But thanks to **responsive ads**, you only need to provide a few images and logos.

Setting up **responsive ads** is easy as ABC.

- Firestride Media, <https://firestride.com/services/rich-media-and-banners-advertising/> (emphasis added):¹⁴

Internet Ad Services

Types of Ads Developed

There are tons of different variations of ads that can be developed. A short list of popular builds include video ads, expandables, mobile ads, **responsive ads**, dynamic banners, and standard builds.

¹⁴ *Id.* at pp. 63-64.

- Homendo, <https://homendo.com/ads> (emphasis added):¹⁵

Responsive Ads

Homendo HTML5 **Responsive Ads** technology brings your banners everywhere: desktop, tablets and smartphones.

- *Sizmek Launches Single-Tag Responsive Feature to Ad Builder for HTML5; New Feature Enables Marketers to Customize Ads to Any Device for Seamless Cross-Screen Campaigns*, GLOBE NEWSWIRE, Oct. 29, 2015, LexisNexis (emphasis added):¹⁶

With the acquisition of mobile DSP StrikeAd earlier this year, companies that use Sizmek can not only easily build **responsive ads**, but also plan, optimize and deliver their inventory as part of a cross-screen campaign.

Now that Flash is falling out of favor, developers need tools that enable them to create HTML5 ads effortlessly, and adding the single-tag responsive feature to Ad Builder affords developers the ability to create **responsive ads** rapidly and without code, to deliver a great ad experience, no matter the screen.

- Haley Hinkle, *Techstar grads shine on Demo Day; Some firms already have funding deals or revenue in hand*, CHICAGO TRIBUNE, Oct. 16, 2015, at Business, Zone C, p. 2, LexisNexis (emphasis added):¹⁷

Specless, which helps advertising publishers create **responsive ads** without reformatting for various digital platforms, has seen 1,000 percent growth since June, said CEO Steve Corby.

¹⁵ Sept. 6, 2019 Office Action at pp. 65-67.

¹⁶ *Id.* at pp. 68-69.

¹⁷ *Id.* at p. 71; Sept. 30, 2020 Office Action at p. 17.

The company has supported **responsive ads** for major brands including Netflix, Paramount, Keds and LG, he said.

- Nicole Piering, *Let the Algorithm Do the Work: Introducing Responsive Ads*, SPARK451 BLOG (May 22, 2019), www.spark451.com/blog/introducing-responsive-ads (emphasis added):¹⁸

Now, with the introduction of **responsive ads**, the Google platform is changing the way we test different ad variations within its advertising network. Simply, **responsive ads** allow the advertiser to upload multiple versions of copy and images, which Google then mixes and matches base on machine learning. Here, we'll tell you what **responsive ads** are, how they work, and how your digital marketing campaigns can benefit from them.

What Are **Responsive Ads**?

Responsive ads are a newer ad format offered by Google. ... Currently, there are two kinds of **responsive ads**: responsive display ads, which feature both text and image components, and responsive search ads, which feature only text.

What are the Benefits of **Responsive Ads**?

How Can Spark451 Help You Use **Responsive Ads** in Your Campaigns?

Although **responsive ads** are delivered by Google's algorithm, its important to mention that the assets still need to be created, manages, and optimized by a reliable and experienced account team.

While your dedicated team will work to ensure you have the best assets and targeting, Google's **responsive ad**

¹⁸ Sept. 6, 2019 Office Action at pp. 72-77.

format gives us the flexibility to test and optimize more than would be humanly possible.

Responsive Ads and the Future of Digital Advertising

While Google was the first platform to roll out **responsive ads**, we expect them to become commonplace across every digital media platform. For example, Facebook recently introduced its take on **responsive ads**, calling them Dynamic Creative ads instead. While the name may be different, the concept and desired goal are the same.

Interested in trying out **responsive ads** on your next enrollment marketing campaign?

- Zurb, zurb.com/playground/responsive-ads (emphasis added):¹⁹

Responsive Ads

Our prototype **responsive ads** allow you to design one ad for every screen

We've prototyped an implementation of **responsive ads** that's completely fluid, lightweight, and built using web standards.

- Dan Wachowski, *Testing the Effectiveness of Responsive Ads*, LEVER INTERACTIVE, www.leverinteractive.com/testing-the-effectiveness-of-responsive-ads/ (emphasis added):²⁰

Responsive ads are relatively new in Google Display, so the Lever Interactive media team developed a study to test the effectiveness of **responsive ads** in comparison to traditional image ads.

Since **responsive ads** can show in many different formats, the media team hypothesized that **responsive ads** would

¹⁹ *Id.* at pp. 78-82.

²⁰ Apr. 9, 2020 Final Office Action at pp. 6-10.

lead to increased traffic and better click-through rates for both verticals.

The different image ad sizes also allowed for similar placements to be in market alongside the **responsive ads**. The teams used only one **responsive ad** per ad group.

In reviewing the retail vertical results, the media team concluded that the **responsive ads** did drive more traffic, but did not lead to a better click through rate.

Even though the **responsive ads** performance differed by vertical from the hypothesis, **responsive ads** did lead to a higher conversion rate and a lower cost/conv. than image ads. This indicates that people who clicked on the **responsive ads** were more likely to convert, classifying this ad type as more cost effective for driving conversions.

The best way to find out if **responsive ads** are the best ad type for you is by testing. With that being said, our take is that **responsive ads** allow advertisers to get more valuable, efficient traffic in the Display Network through the many different sizes, especially if the campaign objective is to drive brand awareness.

- Akhil S., *Everything You Need to Know About Responsive Display Ads*, TECHWYSE INTERNET MARKETING BLOG (Feb. 20, 2020), www.techwyse.com/blog/pay-per-click-marketing/responsive-display-ads/ (emphasis added):²¹

Imagine an ad that can adjust itself to fit any ad space on a website. Cool, right? That's the flexibility **Responsive Ads** can offer you.

Announced in Sep 2017, **Responsive Ads** have now become the default ad type on Google Display Network.

²¹ *Id.* at pp. 11-17.

Many of us forget the fact that **Responsive Ads** are being resized into a number of smaller ad dimensions on display networks.

The **Responsive Ads** interface also allows you to scan your website

- Will Gray, *New ad format revealed: Google responsive ads & best practices*, WEBMECHANIX BLOG (Sept. 10, 2018), www.webmechanix.com/responsive-ads (emphasis added):²²

Google recently launched a new **responsive ad** format specifically for search; it's currently ~~in beta and not~~ available to all advertisers.

In this article, I'll explain what these **responsive ads** are, show how you create them, discuss some **responsive ads** best practices, and look at how to decrease CPC in AdWords by optimizing these ads.

What are Google **responsive ads**, and how do they work?

Google **responsive ads** examples

How to create **responsive ads**

Follow these three **responsive ads** best practices to get the most value out of your ads

Responsive ad reporting is still in its infancy

²² *Id.* at pp. 18-31.

Delving a bit deeper, I observed my **responsive ads** performed well in some campaigns and poorly in others.

- Vamsee Jasti, *Increase ad competition with multi-size & fluid ads in AMP*, MEDIUM: AMPFUEL (Sep. 19, 2018), <https://medium.com/ampfuel/increase-ad-cometition-with-multi-size-fluid-ads-in-amp-9cff90066c16> (emphasis added):²³

“Fluid” ads

“Fluid” means that a primary ad size isn’t required at request time. The returned **responsive ad** will take up the entire width of the viewport and adjust it’s [sic] height according to the desired aspect ratio.

- Quinn Dolan, *Facebook Rolls Out Responsive Ads, Dubbed “Multiple Text Options,”* PERFECTSEARCH BLOG (Feb. 19, 2020), www.perfectsearchmedia.com/blog/facebook-rolls-out-responsive-ads-dubbed-multiple-text-options (emphasis added).²⁴
- Chris Shuptrine, *Responsive Ad Design: What It Is And Why Publishers Should Care*, AD.PRODUCT BLOG (Apr. 16, 2020), <https://adzerk.com/blog/responsive-ads> (emphasis added):²⁵

To ensure you’re providing good ad experiences, you’ll want to lock down your **responsive ad** design strategy.

This article dives into what **responsive ad** design is and ideas for implementing it.

What is **Responsive Ad** Design?

To paraphrase Smashing Magazine’s definition of “responsive web design,” **responsive ad** design refers to developing ad experiences that respond to a user’s behavior and environment, based on device type, screen size, platform, and orientation.

²³ *Id.* at pp. 36-44.

²⁴ *Id.* at pp. 45-48.

²⁵ Sept. 30, 2020 Office Action at pp. 6-12.

Responsive ad design is a must for ensuring good ad experiences no matter how a user is viewing your content.

Without a **responsive ad** strategy, you could be left with situations like below, where the ad doesn't dynamically adjust as the browser size is reduced, resulting in an ad experience neither the user nor the advertiser would be happy about (in this situation, the standard content is responsive, but not the ad).

In other words, without a **responsive ad** design strategy, you are bound to have poor ad experiences and broken ads.

How can I create **responsive ad** experiences?

- Andreas Rekdal, *This 6-person startup is taking on Google in the adtech space*, BUILT IN CHICAGO (June 22, 2016), www.builtinchicago.org/2016/06/21/specless-responsive-ad-campaigns (emphasis added):²⁶

Specless is working to do something about that. Founded three years ago, the company's web-based tool lets advertisers design a single **responsive ad** campaign that will display properly on any device.

- Mashable, <https://mashable.com/advertise/desktop> (emphasis added):²⁷

Responsive Ads

Our **Responsive Ad** solution provides a gorgeous ad experience on every screen.

- Eleven Brand Studio, www.elevenbrandstud.io/instagram-ads (emphasis added):²⁸

100% Responsive ads

²⁶ *Id.* at pp. 13-15.

²⁷ *Id.* at pp. 20-25.

²⁸ *Id.* at pp. 26-33.

A successful campaign relies heavily on the pulling-power of advertising copy, but also on the chosen ad strategy and analysis. Knowing which ad type to use is essential. Is it brand awareness? Is it quality leads? Or is it just driving sales? We create strategic-oriented ads.

- Hamish McKenzie, *Publishers are charging forward with responsive design—now it's time for advertisers to catch up*, PANDODAILY (June 4, 2013), <https://pando.com/2013/06/04/publishers-are-charging-forward-with-responsive-design-now-its-time-for-advertisers-to-catch-up/> (emphasis added):²⁹

Undertown co-founder Eric Franchi says the ad industry is just at the beginning of the responsive era. ... “The solutions don’t exist,” says Franchi. “There hasn’t been a reason for them to develop **responsive ads**.”

Google is said to be working on **responsive ad** units, too.

Once Google is in the market, you can expect that **responsive ads** will fast become an industry standard.

- Katie Ingram, *Improve Mobile Ad Impact with Responsive Design*, CMS WIRE (July 16, 2013), www.cmswire.com/cms/customer-experience/improve-mobile-ad-impact-with-responsive-design-021300.php (emphasis added):³⁰

Another company that has released a **responsive ad** product is Undertone with Screenshift.

“**Responsive ads** make life a lot easier in a mobile world....”

Responsive ads are also seen as way [sic] to improve the customer-business relationship across a platform of different devices.

²⁹ *Id.* at pp. 34-35.

³⁰ *Id.* at pp. 36-40.

Responsive-ad creative might help publishers monetize their mobile traffic more successfully than they're currently managing, to, by enabling them to more easily sell cross-platform packages as opposed device-specific media... .”

- WPEka Club, *WPAdCenter: Ads Manager, Banner Ads, Amazon, Google Adsense*, WORDPRESS.ORG PLUGINS WP ADCENTER, <https://wordpress.org/plugins/wpadcenter> (emphasis added):³¹

Features

- Display **responsive ads** anywhere on your WordPress website using a Gutenberg block and simple shortcodes.
- Jackie Jackson, *Create responsive Amazon ads*, JACQUO, <http://jaquo.com/create-responsive-amazon-ads/> (emphasis added):³²

You can see on the left of the above screenshot that I have clicked the “advanced settings” link to display the options. By default, the option is for **responsive ads** which you’ll more than likely leave because they will automatically resize for cellphones, tablets etc.

- Amazon Associates, <https://affiliate-program.amazon.com/home/ads> (emphasis added):³³

Introducing Native Shopping Ads

Seamlessly integrate highly relevant recommendations in a **responsive ad** unit to earn more.

Native Shopping Ads - Overview

Native Shopping Ads provide highly relevant and dynamic product recommendations in a stylishly designed and **responsive ad** unit that can be placed at the end of content or within the content to create a more compelling visitor experience and shopping opportunity.

³¹ *Id.* at pp. 44-46.

³² Sept. 30, 2020 Office Action at pp. 48-51.

³³ *Id.* at p. 53.

RESPONSIVEADS is generic if ordinary consumers and businesses understand the term RESPONSIVEADS to refer to a genus, or category, of services when the term is used in connection with Applicant's Services. In making this determination, we assess RESPONSIVEADS as a whole, taking into account the meaning of the terms that comprise it:

“An inquiry into the public's understanding of a mark requires consideration of the mark as a whole. Even if each of the constituent words in a combination mark is generic, the combination is not generic unless the entire formulation does not add any meaning to the otherwise generic mark.” *In re Steelbuilding.com*, [75 USPQ2d at 1421]; see *In re Am. Fertility Soc'y*, 188 F.3d 1341, 1347 [51 USPQ2d 1832, 1837] (Fed. Cir. 1999) (“[I]f the compound word would plainly have no different meaning from its constituent words, and dictionaries, or other evidentiary sources, establish the meaning of those words to be generic, then the compound word too has been proved generic. No additional proof of the genericness of the compound word is required.”).

In re 1800Mattress.com, 92 USPQ2d at 1684.

As previously discussed, “responsive” means “quick to respond or react appropriately or sympathetically: sensitive.” “Ads” is the plural form of “ad,” which is defined as “advertisement.” A combination of the terms does not reveal any additional or changed meaning: RESPONSIVEADS are services relating to, inter alia, advertisements that respond, or adjust, quickly to the unique format or layout of the screen on which the advertisement is displayed. See, e.g., *U.S. Pat. and Trademark Off. v. Booking.com B.V.*, 591 U.S. ___, 140 S.Ct. 2298, 2020 USPQ2d 10729, at *7 (2020) (“A compound of generic elements is generic if the combination yields no additional meaning to **consumers** capable of distinguishing the goods or services.”)

(emphasis in original); *In re Gould Paper*, 5 USPQ2d at 1112 (SCREENWIPE found generic for wipes for cleaning computer and television screens).

Competitors in the marketing and advertising field use the term “responsive” to describe a key feature of their own services that cause advertisements to respond, or adjust, quickly to the unique formats or layouts of the screens on which the advertisements are displayed. For example, Marin Software, Bannersnack, Firestride Media, Homendo, Sizmek, Specless, Mashable, Zurb, Eleven Brand Studio, WordPress, and Amazon all offer “responsive ads” in which sensitivity and swift responsiveness to various screen dimensions are the key aspects of the services.³⁴ Use by competitors in the field — and here, what appears to be use as a term of art by competitors in the field — is strong evidence of genericness. *See, e.g., Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1048 (Fed. Cir. 2018) (“zero” used by competitors generally for soft drinks, sport drinks, and energy drinks with zero or near zero calories); *BellSouth Corp. v. DataNational Corp.*, 60 F.3d 1565, 35 USPQ2d 1554, 1558 (Fed. Cir. 1995) (“Walking Fingers” logo, used by many competing telephone companies and directory publishers, found informational for Yellow Pages); *In re Thunderbird Prods.*, 406 F.2d 1389, 160 USPQ 730, 732 (CCPA 1969) (“cathedral hull” used generally and by at least one competitor to describe specific type of boat hull). *Cf. In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1144 (Fed. Cir. 1987) (genericness refusal of

³⁴ Sept. 6, 2019 Office Action at pp. 46-48, 54, 63-69, 71, 78-82; Sept. 30, 2020 Office Action at pp. 13-15, 17, 20-33, 44-46, 48-51, 53.

CASH MANAGEMENT ACCOUNT reversed where evidence “showed recognition in a substantial number of publications” that appellant was the source of the CASH MANAGEMENT ACCOUNT).

The record also includes articles and posts that discuss “responsive ads” since at least 2012 in publications such as *Smashing Magazine*, *Disruptive Magazine*, *Globe Newswire*, the *Chicago Tribune*, *Pando Daily*, *CMS Wire*, industry blogs, and an e-book. We find that individual consumers as well as advertising and marketing professionals — here, the relevant public — would read these types of publications and understand that the term RESPONSIVEADS involves advertisements that respond, or adjust, quickly to the unique formats or layouts of the screens on which the advertisements are displayed.

Applicant argues that RESPONSIVEADS is not generic because: (i) its “collective suite of offerings” is “inherently diverse,” and “there is no evidence in the record that the relevant public uses, or understands, the term ‘responsive ads’ as a generic synonym” for any of Applicant’s Services (6 TTABVUE 10); (ii) “a ‘responsive ad’ is an outcome, not the service or tool creating that outcome,” and “Applicant cannot create responsive ads for its customers without the customers’ content” (6 TTABVUE 11); (iii) the Examining Attorney has not “asserted, or provided any affirmative evidence, that Applicant is in the business of selling ‘responsive ads’ as a standalone good” (6 TTABVUE 12); and (iv) “‘responsive ad’ is not the exclusive industry term for this particular product.” (6 TTABVUE 10 n.1).

Applicant's arguments are without merit. As previously discussed, if the proposed mark is generic for any one of the services in the identification, registration is appropriately refused for that entire class of services. *In re Katch*, 2019 USPQ2d 233842, at *10. Being a "generic synonym" or an "outcome" is not dispositive of whether a term is generic, particularly where, as here, the evidence of record demonstrates that Applicant's competitors offer "responsive ads," and that the term "responsive" is widely used to identify a key aspect of a specific type of advertisement.

In addition, since there can be more than one generic term for a particular genus of goods or services, we are also unpersuaded that RESPONSIVEADS is not generic simply because others in the marketing and advertising field may use terms such as "responsive display ads" or "responsive web design" to describe similar marketing and advertising services.³⁵ See *In re Empire Tech. Dev. LLC*, 123 USPQ2d 1544, 1551 ("It is well established that the availability of other words for competitors to use does not, by itself, transform a generic term into capable matter.") (quoting *In re Trek 2000 Int'l Ltd.*, 97 USPQ2d 1106, 1109 (TTAB 2010)). Any term that the relevant public understands to refer to the genus is generic. See *In re 1800Mattress.com*, 92 USPQ2d at 1685 ("We ... disagree with Dial- A- Mattress's assertion that there can only be one generic term, which is 'online mattress stores.' Instead, any term that the relevant public understands to refer to the genus of 'online retail store services in the field of mattresses, beds, and bedding' is generic.");

³⁵ See, e.g., Sept. 6, 2019 Office Action at pp. 35-36, 72 ("responsive web design"); Apr. 9, 2020 Final Office Action at pp. 11-17 ("responsive display ads").

Roselux Chem. Co. v. Parsons Ammonia Co., 299 F.2d 855, 132 USPQ 627, 632 (CCPA 1962) (“[I]n considering whether ‘sudsy ammonia’ is a common descriptive name of the product we cannot fail to take into consideration the class of people who will commonly be using it and what they will commonly call it.”); *Clairol, Inc. v. Roux Distrib. Co.*, 280 F.2d 863, 126 USPQ 397, 398 (CCPA 1960) (“The same merchandise may, and often does, have more than one generic name.”).

Overall, we find the record demonstrates that the term RESPONSIVEADS refers to a key aspect of Applicant’s Services, which include, inter alia, “advertising, marketing, and promotional services relating to structuring, formatting, layout, generation, and distribution of advertising content and creatives material, namely, creative marketing and design services and distribution of advertising materials,” and “graphic design assistance in structuring, formatting, and layout of marketing, promotional and advertising materials and content.” Hence, RESPONSIVEADS is a generic term for Applicant’s Services. *See In re Cordua Rests.*, 100 USPQ2d at 1231 (“Generally, where the matter sought to be registered identifies [services] that are a primary or central focus of the [business], we have considered the term to be generic.” (bracketed words in original)).

Consequently, we affirm the refusal of registration of Applicant’s proposed mark in International Classes 35 and 42 on the ground of genericness.

II. Is RESPONSIVEADS Merely Descriptive for the Recited Services?

We also consider the Examining Attorney’s alternative refusal that RESPONSIVEADS is merely descriptive of Applicant’s Services. Implicit in our

holding, discussed above, that RESPONSIVEADS is generic, is our finding that RESPONSIVEADS is not only merely descriptive of Applicant's Services, but is highly descriptive of them under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 2(e)(1). "The generic name of a thing is in fact the ultimate in descriptiveness." *BellSouth*, 35 USPQ2d at 1557 (quoting *Marvin Ginn*, 228 USPQ at 530); *Weiss Noodle Co. v. Golden Cracknel and Specialty Co.*, 290 F.2d 845, 129 USPQ 411, 413 (CCPA 1961) ("The name of a thing is the ultimate in descriptiveness."). *See also In re Automated Mktg. Sys., Inc.*, 873 F.2d 1451, 11 USPQ2d 1319, 1320 (Fed. Cir. 1989) (after finding SALES FOLLOW-UP for soliciting repeat and referral business for automobile dealership services generic, "the highly descriptive nature of 'SALES FOLLOW-UP' outweighed [applicant's] evidence of acquired distinctiveness."); *In re Waverly Inc.*, 27 USPQ2d 1620, 1623 (TTAB 1993) (finding MEDICINE not generic, but a highly descriptive term that had acquired distinctiveness for medical journals).

Nevertheless, Applicant contends RESPONSIVEADS is suggestive of its services, not merely descriptive:

[E]ven assuming, *arguendo*, that the term "responsive ads" may be used to a certain extent in connection with an advertising *product*, this is again inconsistent with it being descriptive of the *services* offered by Applicant. To the extent an advertising product might be described as having "responsive" features, it may be generated by and through any number of advertising services, including – but certainly not limited to – those offered by Applicant. ... But nothing about the term "responsive ads" *describes* those services or technologies, whether as offered by Applicant or any other industry provider The term may *suggest* a possible product that may be created using Applicant's

services. It also may not... . Regardless, the term “responsive ads” does nothing to describe the nature of Applicant’s core service categories themselves.

Applicant’s Brief, 6 TTABVue 13-14 (italics in original).

For completeness, we therefore determine whether RESPONSIVEADS is merely descriptive.

In the absence of acquired distinctiveness, Section 2(e)(1) of the Trademark Act precludes registration of a mark on the Principal Register that, when used in connection with an applicant’s services, is merely descriptive of them. “A mark is merely descriptive if it immediately conveys information concerning a feature, quality, or characteristic of the goods or services for which registration is sought.” *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1373 (Fed. Cir. 2018) (quoting *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017)). Also, “a mark may be merely descriptive even if it does not describe the ‘full scope and extent’ of the applicant’s services.” *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)).

We “must consider the mark as a whole and do so **in the context of the goods or services at issue.**” *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (emphasis added); see *In re Calphalon Corp.*, 122 USPQ2d 1153, 1162 (TTAB 2017) (citing *DuoProSS*, 103 USPQ2d at 1757). “Whether consumers could guess what the product is from consideration of the mark alone is not the test.” *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985). “Rather, the question is whether someone who

knows what the goods and services are will understand the mark to convey information about them.” *DuoProSS*, 103 USPQ2d at 1757 (quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002)).

The evidence discussed in our analysis of whether RESPONSIVEADS is generic for Applicant’s Services also confirms that RESPONSIVEADS is merely descriptive when used in connection with them. The evidence of third-party use plainly shows that RESPONSIVEADS has a normally understood and recognized descriptive meaning. See *Specialty Brands, Inc. v. Coffee Bean Distrib., Inc.*, 748 F.2d 669, 223 USPQ 1281, 1285 (Fed. Cir. 1984) (“Third-party usage can demonstrate the ordinary dictionary meaning of a term or the meaning of a term to those in the trade.”) (citing *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976)); *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978) (“Evidence of the context in which a mark is used on labels, packages, or in advertising material directed to the goods is probative of the reaction of prospective purchasers to the mark.”). Cf. *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015) (third-party use and registration of a term may be an indication that a term has a suggestive or descriptive connotation in a specific industry); *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ 1030, 1036 (TTAB 2016) (evidence of third-party use in the relevant context may show that a term “may have a normally understood and well- recognized descriptive or suggestive meaning”).

We find that relevant consumers use RESPONSIVEADS to describe key features of Applicant's Services specifically relating to advertisements that respond, or adjust, quickly to the unique formats or layouts of the screens on which the advertisements are displayed, as well as graphic design assistance in the structuring, formatting, and layout of marketing and advertising materials and content. Therefore, RESPONSIVEADS is not only merely descriptive, but as discussed below, it is also highly descriptive of such services.

III. Has RESPONSIVEADS Acquired Distinctiveness?

Under Section 2(f) of the Trademark Act, matter that is merely descriptive under Section 2(e)(1) may nonetheless be registered on the Principal Register if it "has become distinctive of the applicant's goods [or services] in commerce." 15 U.S.C. § 1052(f). Therefore, if Applicant proves that the merely descriptive matter has acquired distinctiveness as used in commerce in connection with Applicant's Services, the proposed mark may be registered on the Principal Register. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1728-30 (Fed. Cir. 2012). Acquired distinctiveness, or "secondary meaning," is generally understood as a "mental association in buyers' minds between the alleged mark and a single source of the ... [service]." *Apollo Med. Extrusion Techs., Inc. v. Med. Extrusion Techs., Inc.*, 123 USPQ2d 1844, 1848 (TTAB 2017) (quoting J. THOMAS MCCARTHY, 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 15:5 (4th ed., June 2017 Update)). We have already considered all of the evidence regarding the public perception of RESPONSIVEADS in our genericness analysis in Part I, above.

An applicant seeking registration of a mark under Section 2(f) bears the ultimate burden of establishing acquired distinctiveness. *In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262, 1264 (Fed. Cir. 2015). Here, Applicant posits, incorrectly, “[e]ven if the Mark is determined to be generic, registration is nonetheless warranted under Trademark Act Section 2(f) based on its acquired distinctiveness through use in commerce with Applicant’s services for at least five years,” (6 TTABVUE 14), and that it “correctly made its Section 2(f) acquired distinctiveness claims in the alternative.” (9 TTABVUE 8). The Examining Attorney asserts that during prosecution, Applicant waived its claim of acquired distinctiveness in the alternative when it did not use language clearly indicating that the acquired distinctiveness of RESPONSIVEADS was being asserted in the alternative. (*See* 8 TTABVUE 16-17).

A. Applicant’s Alleged Claim of Acquired Distinctiveness in the Alternative

A claim of acquired distinctiveness is a concession that the mark sought to be registered is merely descriptive of the mark’s goods or services. *In re Virtual Independent Paralegals*, 2019 USPQ2d 111512, at *9. However, making an alternative claim of acquired distinctiveness is not tantamount to a concession that the mark is not inherently distinctive. *In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1713 (TTAB 2011); *In re E S Robbins Corp.*, 30 USPQ2d 1540, 1542 (TTAB 1992); *In re Prof’l Learning Ctrs.*, 230 USPQ 70, 71 n.2 (TTAB 1986). It is the applicant’s responsibility to use clear language when making its claim of acquired distinctiveness provisionally, or in the alternative. *In re A La Vieille Russie Inc.*,

60 USPQ2d 1895, 1897 n.2 (TTAB 2001) (applicant did not assert Trademark Act § 2(f) claim in the alternative); *see also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1215 (2022).

Applicant first asserted that RESPONSIVEADS had acquired distinctiveness in its September 2, 2020 Request for Reconsideration (“Therefore, Applicant requests that the RESPONSIVEADS application be amended to include a claim of acquired distinctiveness under Trademark Act Section 2(f).”)³⁶ Applicant did not use any language indicating that its claim was made in the alternative, but earlier in the request, Applicant asserted that the mark “is not merely descriptive of the foregoing services. ... [T]here are further reasons why the applied for mark is not descriptive.”³⁷

Again, in the March 30, 2021 Office Action response, Applicant’s assertion of acquired distinctiveness was not made in the alternative, but Applicant also appeared to argue that the mark was not descriptive in the body of the response, as well as in its conclusion:

Accordingly, Applicant respectfully puts forth that even if the Examiner finds Applicant’s mark close to the line between “generic” and “merely descriptive,” then precedence dictates that the Examiner should resolve any doubt in Applicant’s favor, finding that **while perhaps descriptive**, Applicant’s mark is (a) certainly not generic and (b) has acquired distinctiveness, and approving the mark for publication.

³⁶ Sept. 2, 2020 Request for Reconsideration after Final Action at pp. 2-3.

³⁷ *Id.* at p. 2.

Mar. 30, 2021 Response to Office Action at p. 3 (emphasis added). In its reply brief, Applicant argues that its claim of acquired distinctiveness was made in the alternative.³⁸

It is Applicant's responsibility to use concise language when making a claim of acquired distinctiveness in the alternative. However, because Applicant continued to argue against the Section 2(e)(1) refusal in the office action response and request for reconsideration discussed above, we do not treat Applicant's amendment to seek registration under Section 2(f) as a concession regarding the issue of descriptiveness; rather, we consider the amendment as being made in the alternative. *In re Eng'g Sys. Corp.*, 2 USPQ2d 1075, 1076 (TTAB 1976). *Cf. In re The Ride, LLC*, 2020 USPQ2d 39644, at *1 n.2 (TTAB 2020) (construing Section 2(f) claim in response to a failure-to-function refusal as being "in the alternative," despite original claim not have been so conditioned); *In re Binion*, 93 USPQ2d 1531, 1538 (TTAB 2009) (construing 2(f) claim in response to surname refusal as "made in the alternative" based on the applicant's continued arguments against the refusal). In any event, our decision is the same.

B. Degree of Descriptiveness of RESPONSIVEADS

In our acquired distinctiveness analysis of RESPONSIVEADS, first we consider the degree of descriptiveness of that term as it is used in connection with Applicant's Services. "[T]he Board must make an express finding regarding the

³⁸ See 9 TTABVUE 8-10.

degree of the mark's descriptiveness on the scale ranging from generic to merely descriptive, and it must explain how its assessment of the evidentiary record reflects that finding." *Royal Crown*, 127 USPQ2d at 1048. "[A]pplicant's burden of showing acquired distinctiveness increases with the level of descriptiveness; a more descriptive term requires more evidence of secondary meaning."

In re Steelbuilding.com, 75 USPQ2d at 1424. As the Board has explained:

[T]he greater the degree of descriptiveness, the greater the evidentiary burden on the user to establish acquired distinctiveness. The sufficiency of the evidence offered to prove acquired distinctiveness should be evaluated in light of the nature of the designation. Highly descriptive terms, for example, are less likely to be perceived as trademarks and more likely to be useful to competing sellers than are less descriptive terms. More substantial evidence of acquired distinctiveness thus will ordinarily be required to establish that such terms truly function as source-indicators.

In re Greenliant Sys. Ltd., 97 USPQ2d 1078, 1085 (TTAB 2010) (internal citations omitted) (emphasis added). *See also In re La. Fish Fry Prods.*, 116 USPQ2d at 1265 (Board has discretion not to accept an applicant's allegation of five years of substantially exclusive and continuous use as prima facie evidence of acquired distinctiveness when the proposed mark is "highly descriptive"); *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999) ("[C]onsidering the highly descriptive nature of the proposed mark, [Applicant] has not met its burden to show that the proposed mark has acquired secondary meaning.").

Based on the evidence previously discussed in connection with the Examining Attorney's genericness refusal, we find each of the terms comprising the proposed mark, "responsive" and "ads," to be descriptive of Applicant's Services. When

combined, the proposed mark RESPONSIVEADS is also highly descriptive of those services since nothing additional is created by the combination of the two terms. *See, e.g., Real Foods*, 128 USPQ2d at 1374 (CORN THINS and RICE THINS held highly descriptive for the respective goods; neither mark had acquired secondary meaning); *In re La. Fish Fry Prods.*, 116 USPQ2d at 1265 (applicant failed to meet evidentiary burden of proof that FISH FRY PRODUCTS had acquired distinctiveness); *Apollo Med. Extrusion Techs.*, 123 USPQ2d at 1851 (MEDICAL EXTRUSION TECHNOLOGIES held highly descriptive of “polyurethanes in the form of sheets, films, pellets, granules, and tubes for use in the manufacture of medical devices, medical diagnostic devices, artificial vascular grafts, stents, pacemaker leads, artificial heart pump diaphragms, catheters, drug delivery devices, orthopedic and spinal implants, blood glucose monitors, and blood gas analyzers”); *In re Positec Grp. Ltd.*, 108 USPQ2d 1161, 1173 (TTAB 2013) (SUPERJAWS held merely descriptive of tools).

Here, no thought or imagination is required to immediately understand that the services rendered under the mark RESPONSIVEADS involve advertisements that respond, or adjust, quickly to the unique formats or layouts of the screens on which the advertisements are displayed, as well as graphic design assistance in the structuring, formatting, and layout of marketing and advertising materials and content. Accordingly, Applicant’s proposed mark, RESPONSIVEADS, is highly descriptive of Applicant’s Services under Section 2(e)(1) of the Trademark Act.

C. Acquired Distinctiveness

Since we find the term RESPONSIVEADS to be highly descriptive of Applicant's Services, Applicant's burden of establishing acquired distinctiveness under Section 2(f) is commensurately high. *See In re Steelbuilding.com*, 75 USPQ2d at 1424 (applicant's burden of showing acquired distinctiveness increases with the level of descriptiveness; "a more descriptive term requires more evidence of secondary meaning") (citing *In re Bongrain Int'l (Am.) Corp.*, 894 F.2d 1316, 13 USPQ2d 1727, 1729 (Fed. Cir. 1990)); *In re LC Trademarks, Inc.*, 121 USPQ2d 1197, 1199 (TTAB 2016) (same); *In re Greenliant Sys.*, 97 USPQ2d at 1085 (same).

"To show that a mark has acquired distinctiveness, an applicant must demonstrate that the relevant public understands the primary significance of the mark as identifying the source of a product or service rather than the product or service itself." *In re Steelbuilding.com*, 75 USPQ2d at 1422 (citing *Qualitex Co. v. Jacobson Prods. Inc.*, 514 U.S. 159, 34 USPQ2d 1161, 1163 (1995)). Our ultimate Section 2(f) analysis and determination in this case is based on all of the evidence considered as a whole:

The considerations to be assessed in determining whether a mark has acquired secondary meaning can be described by the following six factors: (1) association of the trade[mark] with a particular source by actual purchasers (typically measured by customer surveys); (2) length, degree, and exclusivity of use; (3) amount and manner of advertising; (4) amount of sales and number of customers; (5) intentional copying; and (6) unsolicited media coverage of the product embodying the mark. ... All six factors are to be weighed together in determining the existence of secondary meaning.

In re SnoWizard, Inc., 129 USPQ2d 1001, 1005 (TTAB 2018) (quoting *Converse, Inc. v. Int'l Trade Comm'n*, 909 F.3d 1110, 128 USPQ2d 1538, 1546 (Fed. Cir. 2018)). See also *In re Steelbuilding.com*, 75 USPQ2d at 1424; *Cicena Ltd. v. Columbia Telecomms. Grp.*, 900 F.2d 1546, 14 USPQ2d 1401, 1406 (Fed. Cir. 1990). No single factor is determinative; “[t]he amount and character of evidence required to establish acquired distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered.” *In re Tires, Tires, Tires Inc.*, 94 USPQ2d 1153, 1157 (TTAB 2009) (citations omitted). See also *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988) (weight of evidence required under an acquired distinctiveness inquiry varies; exact kind and amount of evidence depends on the circumstances of the particular case).

Applicant claims RESPONSIVEADS has acquired distinctiveness, emphasizing Applicant’s “longstanding and substantially exclusive use” of RESPONSIVEADS for at least five years. (6 TTABVUE 14-15). However, the record does not support Applicant’s claim and we exercise our discretion not to accept Applicant’s allegation of at least five years of substantially exclusive and continuous use of the proposed mark. *La. Fish Fry Prods.*, 116 USPQ2d at 1265 (“Although Section 2(f) of the Lanham Act . . . provides that the PTO may accept five years of ‘substantially exclusive and continuous’ use as prima facie evidence of acquired distinctiveness, the statute does not require the [US]PTO to do so.”). The record lacks declarations, evidence of intentional copying, or any advertising, sales, or customer data to support

a finding of acquired distinctiveness. Furthermore, as discussed previously, competitors in the field use the term “responsive ads” to describe their own advertising services, and the unsolicited media coverage of record focuses on “responsive ads” generally, and not on Applicant’s use of RESPONSIVEADS to identify the source of its services.³⁹ In short, Applicant has not met its burden of persuasion. Considering the record in its entirety and the highly descriptive nature of the proposed mark, we find overall that the term RESPONSIVEADS has not acquired distinctiveness for Applicant’s Services.

IV. Public Policy Does Not Favor Granting Registration.

Finally, we address Applicant’s argument that this appeal raises “unique public policy considerations that weigh in favor of granting registration.” (6 TTABVUE 16). Applicant contends, without properly citing any supporting evidence⁴⁰ or any case law, that the Examining Attorney should not have relied on evidence “directly or indirectly attributable to Google,” because of Google’s alleged market power and

³⁹ See *supra* pp. 25-26 (discussing media and industry coverage in *Smashing Magazine*, *Disruptive Magazine*, *Globe Newswire*, the *Chicago Tribune*, *Pando Daily*, *CMS Wire*, blogs, and an e-book).

⁴⁰ On page fourteen of its brief, Applicant cites a Statcounter Global Stats webpage in support of its market power argument and includes a deep link pointing to the webpage. See 6 TTABVUE 16. However, providing only a deep link, hyperlink, or web address without the material attached is not sufficient to introduce the material into the record, because the information displayed at a deep link, hyperlink, or web address is not permanent. See *TV Azteca, S.A.B. de C.V. v. Martin*, 128 USPQ2d 1786, 1789 n.15 (TTAB 2018). Moreover, even if Applicant had submitted the webpage, it would be untimely as it was not made of record prior to appeal. “The record should be complete prior to the filing of an appeal. Evidence should not be filed with the Board after the filing of a notice of appeal.” Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d); see also TBMP § 1203.02(e) (“Material Submitted with Briefs”). Without supporting evidence, Applicant’s argument is entitled to little probative weight.

alleged misappropriation of the term “responsive ads.” (6 TTABVUE 16-17). The crux of Applicant’s public policy argument is that Google drives the value and strength of trademark rights, because “when Google introduces a new phrase into the digital lexicon, that phrase will necessarily be far more likely to be quickly and widely repeated, and potentially adopted, than if similarly introduced by a smaller digital services provider.” (6 TTABVUE 16).

We are unpersuaded by Applicant’s public policy argument. Even without the evidence that refers to Google’s “responsive ads” service, the remaining evidence of record, discussed above in Section I.A.3., clearly shows the widespread adoption and use of the term “responsive ads” by the relevant public for the same types of services rendered by Applicant, including, inter alia, “advertising, marketing, and promotional services relating to structuring, formatting, layout, generation, and distribution of advertising content and creatives material, namely, creative marketing design services and distribution of advertising materials,” and “graphic design assistance in structuring, formatting, and layout of marketing, promotional and advertising materials and content.” Applicant’s public policy argument is without merit.

V. Conclusion

We conclude that the term RESPONSIVEADS is generic for Applicant’s Services and, alternatively, it is merely descriptive and without acquired distinctiveness.

Decision: The refusal to register RESPONSIVEADS in International Classes 35 and 42, on the ground that it is generic, is affirmed. The alternative refusal to register

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RESPONSIVEADS on the ground that it is merely descriptive under Section 2(e)(1) of the Trademark Act, and has not acquired distinctiveness, also is affirmed.