

This Opinion is not a
Precedent of the TTAB

Hearing: June 21, 2016

Mailed: October 11, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Jeanette K. Daniels

v.

TGN Services, LLC
—

Opposition No. 91204462
to Serial No. 85331574
—

Jeanette K. Daniels, pro se

Jordan A. LaVine and Alexis K. Arena of Flaster/Greenberg, P.C.
for TGN Services, LLC.

—

Before Cataldo, Adlin and Heasley,
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

Applicant TGN Services, LLC applied to register the proposed mark PROGENEALOGISTS (in standard characters) on the Principal Register in connection with the following services:

publishing of narratives in electronic manuscript and electronic book forms in the field of genealogical historical data, family history data, census data, birth, marriage and death records; providing online publications in the nature of newsletters, reports and magazines in the field

genealogical historical data, family history data, census data, birth, marriage and death records; publishing of books, reports, charts, magazines, newsletters and guides in the field [of] genealogical historical data, family history data, census data, birth, marriage and death records in International Class 41;

and

providing research services in the field of genealogical historical data, family history data, census data, birth, marriage and death records; consulting and advisory services in the field of genealogical historical data, family history data, census data, birth, marriage and death records in International Class 45.¹

Opposer Jeanette Daniels, a professional genealogist, opposes registration of the PROGENEALOGISTS mark on the ground that it is generic or highly descriptive of Applicant's genealogical services, and has failed to acquire distinctiveness. The matter is fully briefed and the parties appeared at an oral hearing.² For the reasons that follow, we sustain the opposition.

I. Background

Applicant's predecessor-in-interest, ProGenealogists, Inc., was founded in 1999

¹ Application Serial No. 85331574 was filed on May 26, 2011, based on Applicant's claim of first use anywhere since November 30, 1998 and use in commerce since at least as early as January 31, 1999.

² After the parties filed their main briefs, *pro se* Opposer filed a Reply brief, 268 TTABVUE, followed the next day by a second, corrected substitute Reply brief, containing such improvements as a table of contents, a table of authorities, blanks in the prior version filled in, increased footnoting, page numbers, and a certificate of service. 269 TTABVUE. Several days later, after the time to file a reply brief had passed, Opposer filed a third version of her Reply brief, with a motion seeking an extension of time to file based on excusable neglect. 271 TTABVUE, 272 TTABVUE. Applicant has opposed this motion. 273 TTABVUE. The second, substitute Reply brief at 269 TTABVUE is timely, and has been considered. The third, untimely Reply brief will be given no consideration. 37 CFR § 2.128(a)(1); TBMP § 801.02(c). We hasten to note that this makes no difference to the outcome of this proceeding.

and incorporated in Utah in the next year.³ In October 2004 ProGenealogists, Inc. applied to register PROGENEALOGISTS as a mark on the Principal Register for genealogical research services.⁴ In 2006, when its application was refused as merely descriptive, it consented to an Examiner's amendment to seek registration of the mark on the Supplemental Register.⁵ In 2010, ProGenealogists, Inc. was acquired by Applicant, which is a subsidiary of Ancestry.com, Inc.⁶ The next year, 2011, Applicant filed the subject application, claiming that the PROGENEALOGISTS mark had become distinctive of Applicant's services through substantially exclusive and continuous use in commerce.⁷ 15 U.S.C. § 1052(f).

Opposer, in her amended Notice of Opposition, avers that she is a professional genealogist whose "genealogy college" educates its students to become professional genealogists; she further avers that Applicant's mark is generic or merely descriptive and without acquired distinctiveness, and that "There is a competitive need for Opposer, as well as other competitors in the genealogical industry, to use the informational term 'pro genealogist,' 'progenealogist,' and 'pro genealogists' and other similar words in relation to common goods or services or other attributes associated

³ Cottrill Dep. 4:18-21, 263 TTABVUE 117.

⁴ Application Serial No. 78500167, filed on October 14, 2004, based on Applicant's claim of first use anywhere since November 30, 1998 and use in commerce since at least as early as January 31, 1999. *See* Applicant's First Notice of Reliance, 259 TTABVUE 7.

⁵ Refusal, 52 TTABVUE 45, 232 TTABVUE 5; amendment, 52 TTABVUE 66-67, 234 TTABVUE 6-7; Reg. No. 3051870, issued on the Supplemental Register on January 24, 2006.

⁶ Meyerink Dep. 8:2-9, 263 TTABVUE 45; Applicant's Answer to Amended Notice of Opposition ¶ 2, 22 TTABVUE 2.

⁷ Applicant's First Notice of Reliance, 259 TTABVUE 14, 16.

with all aspects of genealogy.”⁸ For these reasons, Opposer claims that she would be damaged by registration of the mark on the Principal Register.⁹

In its Answer, Applicant admits its ownership of Supplemental Registration No. 3051870 for PROGENEALOGISTS and its existence as a corporate subsidiary of Ancestry.com, Inc., but denies Opposer’s other salient allegations.¹⁰

II. Standing

The Board found earlier, on consideration of Applicant’s motion for summary judgment, that Opposer has standing.¹¹ As an accredited professional genealogist, as the head of a college that trains students to become professional genealogists, and as president of the Salt Lake City, Utah chapter of the Association of Professional Genealogists, Opposer clearly has an interest in using the words “pro,” “professional,” and “genealogists,” or combinations or variations thereof for genealogy services.¹² She also has a reasonable apprehension that Applicant will assert rights in the subject PROGENEALOGISTS mark against her.¹³ She thus has a real interest in this opposition proceeding, and a reasonable basis in fact for believing that she would

⁸ Amended Notice of Opposition, 21 TTABVUE 2-5, ¶¶ 1, 3, 5, 8, 9.

⁹ *Id.* 21 TTABVUE 5.

¹⁰ Applicant’s Answer to Amended Notice of Opposition, 22 TTABVUE.

¹¹ Board ruling on motion for summary judgment: “In view of the foregoing, we find that there are no genuine disputes of material fact as to the issue of standing, and that Opposer has standing as a matter of law. Therefore, Opposer’s standing will be treated as established in the case.” 90 TTABVUE 5.

¹² Daniels Dep. 42:1-6, 44:2-4, 56:3-4, 65:1-7, 65:25-66:3, Applicant’s Third Notice of Reliance, 259 TTABVUE 58, 61, 64.

¹³ Daniels Dep. 37:14-22, 120:4-10, Applicant’s Third Notice of Reliance, 259 TTABVUE 57, 77, 82-83. *See* copy of cease and desist letter at 259 TTABVUE 82-83.

suffer damage if the mark is registered. *Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727 (Fed. Cir. 2012).

Accordingly, Opposer has standing. See *Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1760-61 (TTAB 2013) *aff'd per curiam* 565 Fed. Appx. 900 (Fed. Cir. 2014) (petitioner established standing based on use of descriptive term “Annapolis Tours”) (citing *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 190 (CCPA 1982) (one basis for standing includes “descriptive use of term in registered mark”); *Stuart Spector Designs Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 1553 (TTAB 2009) (competitors have standing to oppose registration based on alleged genericness and lack of distinctiveness of product configuration); *Ipcor Corp. v. Blessings Corp.*, 5 USPQ2d 1974, 1976-77 (TTAB 1988) (cease and desist letter sent by applicant found sufficient to demonstrate opposer's standing)).

III. The Record

Applicant's record evidence consists of:

A first notice of reliance upon the subject application and its file history. The file of the subject application is automatically of record. 37 CFR § 2.122(b)(1); TBMP § 704.03.

A second notice of reliance upon Opposer's written responses to Applicant's discovery requests, specifically, written responses to requests for production of documents, responses to requests for admission, and answers to interrogatories.

A third notice of reliance upon the transcript of Opposer's discovery deposition.

A fourth notice of reliance upon exhibits I through K from Applicant's motion for summary judgment, which were also identified as exhibits during Opposer's discovery deposition, specifically: the June 5, 2014 cease and desist letter

Applicant's counsel sent to Opposer's fellow genealogists James and Mary Petty, and web pages from the Pettys' HEIRLINES genealogy website.¹⁴

A fifth notice of reliance upon printouts of news articles demonstrating unsolicited mention of Applicant's mark.¹⁵

The trial testimony of Natalie Cottrill, founder of ProGenealogists, Inc.

The trial testimony of Kory Meyerink, co-founder of ProGenealogists, Inc.

The trial testimony of Antonia Sears, senior director of AncestryProGenealogists (directing ProGenealogists' operations under Ancestry.com).

The trial testimony of Brian Hansen, vice president of emerging businesses at Ancestry.com, with exhibits.¹⁶

Opposer's evidence of record consists of her notices of reliance, submitted on:

August 28, 2014, 35 TTABVUE through 54 TTABVUE;

October 12, 2014, 72 TTABVUE through 86 TTABVUE;

June 3-4, 2015, 96 TTABVUE through 260 TTABVUE.

Opposer's evidence, often duplicative, includes dictionary definitions of "pro" and "genealogist," among other terms; numerous Internet sites using the terms "pro," "professional" and "genealogist" together; Internet pages from Applicant's website, ProGenealogists.com; website metatags used by Applicant, such as "professional genealogist" and "genealogists"; readers' comments and postings on Applicant's website and other genealogical websites; pages from Ancestry.com's website referring to Applicant; Applicant's written responses to discovery requests; genealogical and

¹⁴ Although these items of correspondence may not ordinarily be introduced via a notice of reliance, *see* 37 CFR § 2.122(e), they are admissible as exhibits to Opposer's discovery deposition, and Opposer has interposed no objection to their introduction.

¹⁵ 259 TTABVUE 92 *et seq.*

¹⁶ 259 TTABVUE 4, 263 TTABVUE.

historical narratives that Opposer has published since 1980; Opposer's certificates of accreditation; materials relating to Opposer's genealogical college courses; Applicant's cease and desist letters to professional genealogists James and Mary Petty; the Pettys' HEIRLINES website pages; USPTO file records relating to Applicant's subject and prior application and supplemental registration; materials concerning the Association of Professional Genealogists. This summary is illustrative, not exhaustive.

IV. Applicant's Objections

Applicant objects that Opposer, during her rebuttal period, did not submit additional evidence in rebuttal, but instead filed a "Rebuttal Brief."¹⁷ This "Rebuttal Brief" lists eight of Applicant's arguments and offers Opposer's rebuttal arguments, citing evidence already of record, much like a reply brief.¹⁸ Applicant cites the Trademark Trial and Appeal Board Manual of Procedure ("TBMP") for the propositions that evidence may not be introduced by attachment to a party's brief, and statements in a brief have no evidentiary value, unless supported by evidence that has been properly introduced at trial.¹⁹ TBMP §§ 704.05(b), 704.06(b). Although these citations are not entirely on point, neither is Opposer's "Rebuttal Brief." Simply put, Opposer's filing amounts to a premature brief on the merits of the case. *See* Trademark Rule 2.128(a)(1), 37 C.F.R. § 2.128(a)(1). *See also* TBMP § 801.02(c). We

¹⁷ "Plaintiff's Rebuttal Brief," 261 TTABVUE.

¹⁸ *Id.*

¹⁹ Applicant's brief, 266 TTABVUE 7-8.

will accordingly give no consideration to the statements made in this filing.

Applicant objects that Opposer's numerous notices of reliance function not as "cover sheet[s] for the materials sought to be introduced," as provided in TBMP § 704.02, but as unverified declarations containing factual allegations.²⁰ We recognize that notices of reliance merely serve to introduce the documentary evidence attached thereto, and to indicate their relevance, and will accord them no greater import than that to which they are entitled under the applicable rules.

Applicant next argues that "Opposer has failed to designate in her Notices of Reliance the documents that are relevant to this proceeding. The Notices attach approximately 1,000 pages of documents..."²¹ Applicant contends that Opposer had the duty to designate the relevant documents specifically, and that her notices should be stricken on this basis, *citing FUJIFILM Sonosite, Inc. v. Sonoscape Co., Ltd.*, 111 USPQ2d 1234, 1237 (TTAB 2014). This argument is not well taken, for two reasons. First, the sole issues in this case are whether Applicant's mark is generic or descriptive without acquired distinctiveness, so determining how Opposer's evidence is relevant to those issues is fairly straightforward. *See Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d 1811, 1813 (TTAB 2005) (general statement of relevance sufficient for a collection of materials), *rev'd on other grounds*, 2008 WL 6862402 (D.D.C. 2008). Second, an objection that a notice of reliance fails to identify the relevance of attached evidence raises a procedural deficiency that could have been

²⁰ *Id.* 266 TTABVUE 8-9.

²¹ Applicant's brief, 266 TTABVUE 9.

cured if the objection had been timely raised. *Corporacion Habanos SA v. Guantanamera Cigars Co.*, 102 USPQ2d 1085, 1093 (TTAB 2012); TBMP §§ 704.08(b), 707.04. This objection is therefore overruled.

Applicant next asserts broadly that “Any documents that do not fall within a category permissible under 37 CFR § 2.122(e), such as correspondence, portions of agreements, documents from an unidentifiable source, portions of manuals or advertising materials, and documents that do not appear to be publicly-available, must be stricken. These documents are also attached to Opposer’s Notices, but are improper, unauthenticated, and contain statements made by witnesses who were not subject to cross-examination.”²² Applicant’s broadly-worded motion, however, does not specify the documents to which it refers or indicate with particularity how each document is inadmissible via notice of reliance. The Board encountered a similarly overbroad objection in *Starbucks U.S. Brands LLC v. Ruben*, 78 USPQ2d 1741 (TTAB 2006):

Applicant's brief fails to identify the specific documents that he claims should be stricken from the record or the discovery requests to which such documents were allegedly responsive. The Board will not cull through each deposition and exhibit in order to identify each separate objection.

Id. at 1747.

The bulk of Opposer’s documents consist of Internet printouts showing the dates accessed and URL information, which are therefore admissible. *See Alcatraz Media*, 107 USPQ2d at 1759 (citing *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031,

²² Applicant’s brief, 266 TTABVUE 9.

1039 (TTAB 2010)); TBMP § 704.08(b). Applicant nevertheless objects that Opposer's Internet printouts are unduly voluminous, that many come from "unspecified" or "anonymous" sources that could not be verified online, that many were "outdated," and that they cannot be used to demonstrate the truth of what has been printed.²³ Under *Safer*, the documents cannot establish the truth of the matters asserted therein, but Applicant's objections are otherwise baseless. Furthermore, most of these printouts were offered not for the truth of the matter asserted, but because they show on their face third party or media generic or descriptive use of the terms "pro" and "genealogists." See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859, 1860 (Fed. Cir. 1987) (electronic excerpts are not hearsay because articles were not used to support the truth of the statements therein but to show descriptive usage of term). In short, Applicant's vague objections go more to the weight than the admissibility of this evidence and are accordingly overruled.

Ultimately, the Board is capable of weighing the relevance and strength or weakness of the objected-to testimony and evidence, including any inherent limitations, and this precludes the need to strike the testimony and evidence. ... As necessary and appropriate, we will point out in this decision any limitations applied to the evidence or otherwise note that the evidence cannot be relied upon in the manner sought. While we have considered all the evidence and arguments of the parties, we do not rely on evidence not discussed herein.

Inter IKEA Sys. B.V. v. Akea, LLC, 110 USPQ2d 1734, 1737 (TTAB 2014).

²³ Applicant's brief, 266 TTABVUE 10.

V. Analysis

A. Descriptiveness

The Lanham Act precludes registration of a term that is merely descriptive of an Applicant's services. 15 USC §§ 1052(e)(1), 1053. A mark is merely descriptive "if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used." *Coach Services v. Triumph*, 101 USPQ2d at 1728 (quoting *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828 (Fed. Cir. 2007)).

Registration of the mark PROGENEALOGISTS on the Supplemental Register is *prima facie* evidence of descriptiveness. *In re Highlights for Children, Inc.*, 118 USPQ2d 1268, 1272-73 (TTAB 2016). Where, as here, "an applicant seeks registration on the basis of Section 2(f), the mark's descriptiveness is a nonissue; an applicant's reliance on Section 2(f) during prosecution presumes that the mark is descriptive." *Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009). The statute "accepts a lack of inherent distinctiveness as an established fact." *Yamaha Int'l Corp. v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988). The sole remaining issue is whether the applied-for mark has acquired distinctiveness. *Id.* See also *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1233 (TTAB 2014), *aff'd* 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016).

B. Acquired Distinctiveness

Under Section 2(f), 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); *Cold War Museum*, 92 USPQ2d at 1629; *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). "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." *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1480 (TTAB 2016) (quoting *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1422 (Fed.Cir. 2005)). Although the Opposer must put on *prima facie* evidence of lack of acquired distinctiveness, "the ultimate burden of persuasion is on the applicant to prove acquired distinctiveness in the mark sought to be registered." *Yamaha v. Hoshino*, 6 USPQ2d at 1010. There is no fixed rule for the amount of proof necessary to demonstrate acquired distinctiveness; the evidence required is in proportion to the degree of nondistinctiveness of the proposed mark. *Nextel Comm'ns, Inc. v. Motorola, Inc.*, 91 USPQ2d 1393, 1401 (TTAB 2009). "[T]he more descriptive the term, the greater the evidentiary burden to establish acquired distinctiveness." *In re Country Music Ass'n Inc.*, 100 USPQ2d 1824, 1834 (TTAB 2011).

Here, there is little doubt that PROGENEALOGISTS is highly descriptive. The proposed mark directly and immediately conveys to consumers that Applicant's professional genealogists provide genealogical services. The word "pro" in Applicant's mark implies that its services are provided by professionals. In fact, "pro" is defined

as “1. *Informal* A professional, especially in sports. 2. An expert in a field of endeavor.”²⁴ See *Sunbeam Corp. v. Conair Corp.*, 220 USPQ 748, 751 (TTAB 1983) (“It is quite clear (and applicant admits) that ‘pro,’ standing by itself, is an accepted abbreviation of the word ‘professional.’”). A “genealogist” is “a person who traces or studies the descent of persons or families.”²⁵ The plural “s” merely informs prospective purchasers that Applicant offers the services of more than one professional genealogist.

In fact, the evidence demonstrates that Applicant adopted its proposed mark largely because of its descriptiveness. The founder of ProGenealogists, Inc., Natalie Cottrill, testified:

[W]e decided to depersonalize the name and come up with a new invented name for the company that simultaneously described what we did, and then just -- you know, it wasn't in the dictionary. It was just kind of a made up name. So we registered the name ProGenealogists.com as a domain name, and we started calling the company that and the general partnership, and in October of 2000 we officially incorporated in the State of Utah As ProGenealogists, Incorporated.²⁶

²⁴ American Heritage Dictionary of the English Language (4th ed. 2000), 52 TTABVUE 50-51. The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Cordua Rests. LP*, 110 USPQ2d at 1229n.4, *aff'd* 118 USPQ2d 1632 (Fed. Cir. 2016); *In re Hodgdon Powder Co.*, 119 USPQ2d 1254, 1256n.5 (TTAB 2016).

²⁵ Merriam-Webster Online Dictionary, 52 TTABVUE 52.

²⁶ Cottrill Dep. 263 TTABVUE 118, 7:6-16 (emphasis added).

She continued: “[O]ur name ProGenealogists, we did expert genealogists. ... It said what we did for a living and what we felt we were good at, but it's not in the dictionary.”²⁷

Brian Hansen, vice president of emerging businesses at Ancestry.com, testified about his conversation with Ms. Cottrill after ProGenealogists, Inc. was acquired:

But I did ask her about it, and she felt like, you know, that -- she said that she felt like it was a good name, and certainly -- and the description seemed to fit what we do. It's very descriptive. And we are the ProGenealogists business, and that's how people already knew the business.²⁸

He continued:

But when people hear the word “progenealogist,” if they've never heard that word before, I think they would assume from it that oh, there are probably some genealogists that work there that are professionals at what they do.

To use a technical term in branding, it's a synthetic brand, you know. We took a couple words and smashed them together to make a brand.²⁹

The descriptiveness of PRO and GENEALOGISTS is not obviated by “smashing them together” to form the compound PROGNEALOGISTS. *See Minnesota Mining*

²⁷ Cottrill Dep. 263 TTABVUE 119, 10:15-17, 263 TTABVUE 121, 18:23-25.

²⁸ Hansen Dep. 263 TTABVUE 32, 10:8-25 (emphasis added).

²⁹ Hansen Dep. 263 TTABVUE 32,11:9-15, 12:1-8.

& Mfg. Co. v. Addressograph-Multigraph Corp., 155 USPQ 470, 472 (TTAB 1967) (“It is almost too well established to cite cases for the proposition that an otherwise merely descriptive term is not made any less so by merely omitting spaces between the words....”); *In re Petroglyph Games Inc.*, 91 USPQ2d 1332, 1341 (TTAB 2009) (“[B]ecause the combination of the terms does not result in a composite that alters the meaning of either of the elements, refusal on the ground of descriptiveness is appropriate”); *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1125 (TTAB 2015).

Applicant relies on *Firestone Tire & Rubber Co. v. The Goodyear Tire & Rubber Co.*, 189 USPQ 348 (CCPA 1976), which found that the telescoped term BIASTEEL was not descriptive. The Court found that the term did not appear in the dictionary, and further stated:

The record is also devoid of any evidence that the mark BIASTEEL connotes a particular tire or class of tires or that the purchasing public would associate the terms “bias” and “steel” with a particular type of tire. In absence of evidence to the contrary, we cannot assume that members of the public at large would attribute the terms “bias” and “steel” to a particular tire construction.

Id. at 350.³⁰

Firestone, however, is distinguishable on its facts, as the Board noted in *In re Cox Ent. Inc.*, 82 USPQ2d 1040 (TTAB 2007): “The finding [in *Firestone*]... was based on the lack of evidence of descriptive use of the two words together to describe the particular goods, not whether there was use of the combined terms in the exact form in which they were presented. The marks ... happened to be presented as a single

³⁰ Applicant’s brief, 266 TTABVUE 28.

term but the presence or absence of a space between the two words was not a factor....” *Id.* at 1044.

Applicant’s proposed mark is thus highly descriptive. “Highly descriptive terms ... 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.” *Alcatraz Media*, 107 USPQ2d at 1767, *aff’d per curiam* 565 Fed. Appx. 900 (Fed. Cir. 2014). *Accord In re Cordua Rests.*, 110 USPQ2d at 1233-34, *aff’d on other grounds*, 118 USPQ2d 1632 (Fed. Cir. 2016).

The evidence that may establish acquired distinctiveness

...includes evidence of the trademark owner's method of using the mark, supplemented by evidence of the effectiveness of such use to cause the purchasing public to identify the mark with the source of the product. The courts have provided further guidance, stating that in determining acquired distinctiveness, relevant factors may include “copying, advertising expenditures, sales success, length and exclusivity of use, [and] unsolicited media coverage....

In re Koninklijke Philips Elecs. N.V., 112 USPQ2d 1177, 1180 (TTAB 2014) (citing 37 CFR § 2.41(a)). In this case, Applicant adduces evidence that the PROGENEALOGISTS business has enjoyed strong growth. After Ms. Cottrill founded ProGenealogists, Inc. in 1999 with fellow genealogist Kory Myerink, the company built a significant Internet presence through its website at ProGenealogists.com.³¹ Although the quantification of its annual growth has been designated as confidential, it is fair to say that the company grew significantly year

³¹ Cottrill Dep. 263 TTABVUE 118, 6:19-20; Myerink Dep. 263 TTABVUE 45, 7:21-8:2.

by year.³² When Applicant acquired the company in August 2010,³³ Ancestry.com decided to retain the PROGENEALOGIST mark because it believed the brand had equity and value.³⁴ Since then, Ancestry.com has marketed ProGenealogists to its user base by means including a monthly email newsletter and a link from the Ancestry.com website.³⁵ Ancestry.com has expended substantial funds developing the ProGenealogists website, and Applicant expends thousands of dollars every month for online advertising through Google and Bing.³⁶ Genealogists on Applicant's staff also provided credited research assistance to the television show "Who Do you Think You Are?", which explores the family history of a celebrity in each episode.³⁷ After the acquisition, business under the PROGENEALOGISTS brand more than tripled in size, and sales have increased nearly five-fold.³⁸ The sales, advertising and website view figures have all been designated as confidential, but they are significant.³⁹

Applicant is unaware of other businesses using PROGENEALOGISTS as a brand

³² Applicant's confidential testimony is at 264 TTABVUE; its non-confidential testimony, with redactions of the confidential portions, is at 263 TTABVUE. *See* Cottrill Dep. 263 TTABVUE 118, 7:22-25.

³³ Cottrill Dep. 12:5-6, 263 TTABVUE 119.

³⁴ *See* Applicant's brief, 266 TTABVUE 30. Applicant's brief with confidential information redacted is at 266 TTABVUE; its brief with the confidential information included is at 267 TTABVUE.

³⁵ Deposition of Antonia Sears, senior director of AncestryProGenealogists' operations, 17:8-23, 263 TTABVUE 8.

³⁶ Hansen Dep., 7:2-25, 263 TTABVUE 31; Meyerink Dep. 14:19-15:10, 263 TTABVUE 47; Applicant's brief, 266 TTABVUE 17.

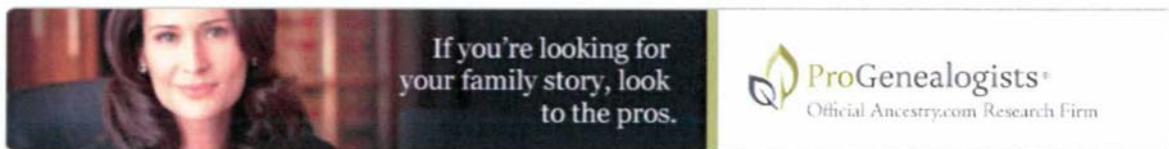
³⁷ Cottrill Dep. Exhibit 4, 263 TTABVUE 180 et seq., 36-38 TTABVUE.

³⁸ Meyerink Dep. 263 TTABVUE 46, 13:8-15; Cottrill Dep. 53:1-11, 263 TTABVUE 130.

³⁹ Hansen Dep. Exhibit 1, 263 TTABVUE 43; Applicant's brief, 266 TTABVUE 6, 14, 18, 29-30.

name⁴⁰ apart from “a few instances of infringement”--such as the use of the term on the HEIRLINES website--which Applicant resolved via trademark enforcement.⁴¹ Applicant claims that this “intentional” copying of the mark by HEIRLINES is evidence of consumer recognition and the value of the mark.⁴² Aside from those few instances, Applicant claims over fifteen years of substantially exclusive use of the PROGENEALOGISTS brand.⁴³ Although it has no consumer studies or surveys directly evidencing secondary meaning, it points to anecdotal evidence of consumers recognizing the name, as well as unsolicited media coverage in over 45 publications.⁴⁴

Despite Applicant’s success in sales and growth, it is, in fact, using the proposed mark in a descriptive matter, which undercuts its attempts to show the mark has acquired distinctiveness. Applicant and Ancestry.com continue to use the words “pro” and “genealogists” in their descriptive sense—witness its online banner ads, such as this:



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⁴⁰ Sears Dep. 16:23-25, 263 TTABVUE 7; Hansen Dep. 14:21-23, 263 TTABVUE 33; Meyerink Dep. 14:15-18, 263 TTABVUE 47; Cottrill Dep. 18:17-23, 263 TTABVUE 120.

⁴¹ Applicant’s brief, 266 TTABVUE 32; Meyerink Dep. 11:14-12:11, 263 TTABVUE 46; Cottrill Dep. 20:3-21, 22:9-20, 263 TTABVUE 121-122.

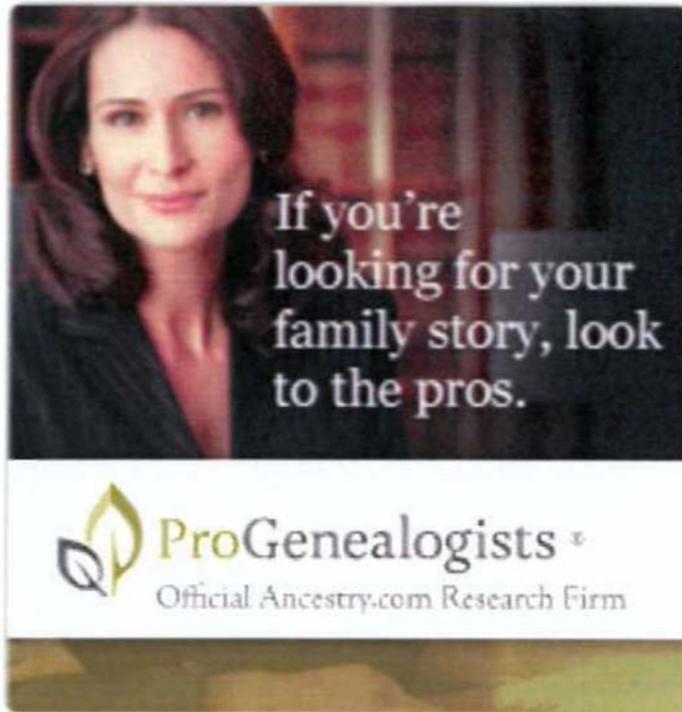
⁴² *Id.*

⁴³ Applicant’s brief, 266 TTABVUE 30-32.

⁴⁴ Applicant’s Fifth notice of reliance, 259 TTABVUE 93-125.

⁴⁵ Sears Dep. Exhibit 7, 263 TTABVUE 24.

Or this:



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As one of the founding partners of ProGenealogists testified:

“The demand on our services is a direct result of being a part of Ancestry. They advertise us as the vendor of choice, for lack of a better word, for professional genealogical services on their website.”⁴⁷ ...

“So I do recognize that ad. It says: “If you're looking for your family story, look to the pros.” And the advertisement is one that they've used several times on their websites.”⁴⁸

⁴⁶ Sears Dep. Exhibit 6, 263 TTABVUE 23.

⁴⁷ Meyerink Dep. 263 TTABVUE 47, 13:15-19.

⁴⁸ Meyerink Dep. 263 TTABVUE 50, 28:2-12.

The same witness admitted, "...we are still referred to as pro genealogists, as individuals, when we speak at conferences and such...."⁴⁹

Applicant has used the following image:



Its advertising on Ancestry.com follows suit:

Meet The ProGenealogists
Posted by Pam Velazquez on October 11, 2013 in Expert Connect, Family History Month, Research

When you think of genealogists, do you think of The Jimmy Kimmel Show?



As recognized experts in the field of genealogy, the professionals at ProGenealogists have authored books and articles, spoken at conferences in several countries, and made several TV appearances on Who Do You Think You Are?, CBS This Morning, CNN's Starting Point and, yes, the Jimmy Kimmel Show. The experts at ProGenealogists have dedicated their careers to researching the families of clients who come to them looking to connect with their past and learn their stories. Many of the ProGenealogists researchers became fascinated by family history at a very young age, and their interest grew into careers.

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Applicant's website has represented to the public that:

- "ProGenealogists® is a consortium of professional genealogists who specialize in genealogical, forensic, and family history research."⁵²

⁴⁹ Meyerink Dep. 263 TTABVUE 47, 13:25-14:2.

⁵⁰ Applicant's Response to Request for Admission no. 3, 54 TTABVUE 13, 250 TTABVUE 6.

⁵¹ Ancestry.com site, Cottrill Dep., 263 TTABVUE 156.

⁵² 39 TTABVUE 37.

- “ProGenealogists is pleased to be the place to go on the Internet for professional genealogists!”⁵³
- “ProGenealogists represents a group of professional genealogists who specialize in Genealogy and family history research”⁵⁴
- “ProGenealogists® is the official research firm of Ancestry.com. Our staff consists of professional genealogists with extensive research and genealogical experience....”⁵⁵
- “ProGenealogists.com is a subsidiary of Ancestry.com consisting of professional genealogists who specialize in genealogy and family history research.”⁵⁶

The ProGenealogists.com domain name is itself highly descriptive. As the Board has noted:

It is generally known and not subject to reasonable dispute that adoption and use of website domain names that impart a clear indication of the products or services offered on the website is quite common, for the obvious reason that those searching the Internet will utilize such terms in searching for products or services. There is no evidence of record suggesting petitioner adopted its domain name for any other reason.

Alcatraz Media, 107 USPQ2d at 1767, *aff’d per curiam* 565 Fed. Appx. 900 (Fed. Cir. 2014). Indeed, Applicant attracts visitors to its website by using key words and metatags such as “professional genealogists.”⁵⁷

Even though Applicant’s proposed mark PROGENEALOGISTS mark is in standard characters, which may be depicted in any number of fonts, colors, and sizes, it has chosen to capitalize “Pro” and “Genealogists,” to depict these terms in different

⁵³ 100 TTABVUE 5.

⁵⁴ 127 TTABVUE 7, 11.

⁵⁵ 129 TTABVUE 10.

⁵⁶ www.LinkedIn.com, 239 TTABVUE 4.

⁵⁷ Cottrill Dep. 10:11-20, 263 TTABVUE 119; Sears Dep. 6:14-22, 263 TTABVUE 5; 35 TTABVUE 5, 15-19.

colors, and to refer to its staff as “pro” or professional” genealogists—all of which emphasizes the descriptive meaning of the terms. So while we recognize that, based on the record evidence, Applicant’s growth in sales, advertising, and website views is impressive, those raw numbers do not necessarily mean that consumers have come to recognize its proposed mark as a source indicator. *See Mini Melts*, 118 USPQ2d at 1480-81. “[S]heer numbers alone are not necessarily enough to prove secondary meaning.” *In re Cordua Rests.*, 110 USPQ2d at 1234, *aff’d on other grounds* 118 USPQ2d 1632 (Fed. Cir. 2016).

Applicant’s decision to retain the brand after it acquired ProGenealogists, Inc., merely perpetuated its descriptive use of the terms “Pro” and “Genealogists.” As noted above, Applicant’s compression of the terms into PROGENEALOGISTS does not alter their common descriptive meaning. *See In re Aquamar*, 115 USPQ2d at 1125. It does nothing more than shorten the term, which the public would tend to do anyway. *See In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 219 (CCPA 1978) (Rich, J., concurring: “the users of language have a universal habit of shortening full names -- from haste or laziness or just economy of words”).

In view of the high degree of descriptiveness of Applicant’s proposed mark, its fifteen years of use and advertising and sales figures are simply insufficient to establish distinctiveness. *See Mag Instruments Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701, 1723-24 (TTAB 2010) (twenty-seven years of use “simply insufficient” to show distinctiveness either alone or in connection with “substantial sales and advertising”) *cited in AS Holdings, Inc. v. H & C Milcor, Inc.*, 107 USPQ2d 1829, 1838 (TTAB 2013).

Moreover, the evidence shows that these terms are ubiquitous in the field. The Association of Professional Genealogists, a national organization, has been in existence since 1979.⁵⁸ Opposer, a member of that organization, has adduced numerous examples of the public and genealogists using the terms “pro genealogist” or variations thereof, e.g.:

- “How to become a pro genealogist,”⁵⁹
- “Pro genealogist Elizabeth Show Mills is taking questions on research,”⁶⁰
- “I am a pro genealogist and you can check out my website....”⁶¹
- “PRO GENEALOGIST” sleuth search,”⁶²
- “Betty Darnell, a pro at genealogy”⁶³
- “Genealogy pro helps amateur researchers at Redmond Senior Center”⁶⁴
- “Genealogist Pro’s Present in Plymouth”⁶⁵
- “[L]ay the foundation for a pro genealogist to dig deeper for you...”⁶⁶
- “botsford was a pro genealogist...”⁶⁷

⁵⁸ 83 TTABVUE 2; Cottrill Dep. 53:24-54:1, 263 TTABVUE 130; Daniels Dep. 46:20-24, Applicant’s Third Notice of Reliance, 259 TTABVUE 59.

⁵⁹ News.Rootsweb.com, 42 TTABVUE 37, 153 TTABVUE 6.

⁶⁰ Twitter.com/FamilySearch, 42 TTABVUE 33, 152 TTABVUE 10.

⁶¹ Boards.Ancestry.com, 42 TTABVUE 35, 153 TTABVUE 3.

⁶² Claudia’sGenealogyBlog.blogspot.com, 40 TTABVUE 50, 140 TTABVUE 2.

⁶³ Courier-Journal.com, 41 TTABVUE 53, 147 TTABVUE 3.

⁶⁴ Redmond-Reporter.com, 42 TTABVUE 7, 149 TTABVUE 7.

⁶⁵ PolishNews.com, 42 TTABVUE 15, 150 TTABVUE 8.

⁶⁶ Indes.net, 44 TTABVUE 25, 169 TTABVUE 4.

⁶⁷ Boards.RootsWeb.com, 42 TTABVUE 46, 154 TTABVUE 9

“When the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term or device, an application for registration under Section 2(f) cannot be successful, for distinctiveness on which purchasers may rely is lacking under such circumstances.” *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939, 940-41 (Fed. Cir. 1984).

Even though Applicant has shown some evidence of unsolicited media attention, as well as anecdotal evidence of scattered recognition, “a good deal more evidence than that offered here would be necessary to establish the distinctiveness of such a term.” *In re The Paint Products Co.*, 8 USPQ2d 1863, 1867 (TTAB 1988). *See Sheetz of Del., Inc. v. Doctor’s Assocs. Inc.*, 108 USPQ2d 1341, 1370 (TTAB 2013) (“The media coverage does not demonstrate that the term ‘Footlong’ has acquired distinctiveness because the news articles use the term ‘Footlong’ generically, not as a trademark”).

As for Applicant’s contention that other professional genealogists intentionally copied its mark on the HEIRLINES website, “[c]opying is only evidence of secondary meaning if the defendant's intent in copying is to confuse consumers and pass off his [services] as the plaintiff's.” *Stuart Spector v. Fender*, 94 USPQ2d at 1575 quoted in *In re Koninklijke Philips*, 112 USPQ2d at 1187. Here, the professional genealogists Applicant accuses of copying were merely using common descriptive terms in their descriptive sense. According to the Federal Circuit, “merchants act at their peril in attempting, by advertising, to convert common descriptive names, which belong to the public, to their own exclusive use.” *In re Pennington Seed, Inc.*, 466 F.3d 1053, 80 USPQ2d 1758, 1762 (Fed. Cir. 2006) (generic use). To allow registration of Applicant’s

proposed mark would inhibit legitimate competition by in effect granting a monopoly to what is essentially very common terminology in the genealogy trade, which Applicant's competitors have an equal right to use. *Cf. In re Mars, Inc.*, 105 USPQ2d 1859, 1866 (TTAB 2013).

In short, "[G]iven the highly descriptive nature of such designation, we would need to see a greater quantity of probative evidence than what applicant has submitted in order to find that the designation has become distinctive of applicant's services. As noted above, the greater the degree of descriptiveness, the greater the evidentiary burden on the user to establish acquired distinctiveness." *In re Tennis Ind. Ass'n*, 102 USPQ2d 1671, 1682 (TTAB 2013).

VI. Conclusion

We find by a preponderance of the evidence that Applicant's mark is highly descriptive, and has not acquired distinctiveness. In view of this finding, which is sufficient to sustain the opposition, we do not reach Opposer's claim of genericness.

Decision: The opposition to Applicant's mark PROGENEALOGISTS is sustained and registration to Applicant is refused.