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Mailed: May 15, 2003
Paper No. 14
PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re *Catalog.com, Inc.*

Serial No. 75/588,068

Mary M. Lee of the Law Office of Mary M. Lee, P.C. for
Catalog.com, Inc.

Barbara Brown, Trademark Examining Attorney, Law Office 116
(*Meryl Hershkowitz*, Managing Attorney).

Before *Hairston, Chapman* and Bucher, Administrative
Trademark Judges.

Opinion by *Hairston*, Administrative Trademark Judge:

On November 13, 1998 *Catalog.com* filed an application
to register the mark CATALOG.COM for "Internet goods and
services."¹

The Trademark Examining Attorney issued a first office
action that, inter alia, refused registration of

¹ Serial No. 75/588,068 asserting first use anywhere and first
use in commerce at least as early as 1994.

applicant's mark on the ground of mere descriptiveness, and held the identification of goods and services to be unacceptable.

In response to the refusal, applicant argued that the mark is not merely descriptive, but in the alternative, amended the application to seek registration under the provisions of Section 2(f) of the Trademark Act based on applicant's declaration of five years substantially exclusive and continuous use. In addition, applicant offered a proposed amendment to the identification of goods and services.

The Examining Attorney, in her second office action, refused registration of applicant's mark on the ground that it is generic and stated, in relevant part:

Where the examining attorney has determined that matter sought to be registered is not registrable because it is not a mark within the meaning of the Trademark Act, a claim that the matter has acquired distinctiveness under §2(f) as applied to the goods or services is of no avail. It would be logically inconsistent to find otherwise.

Further, the Examining Attorney held applicant's proposed amendment to the identification of goods and services to be unacceptable.

Applicant, in response, argued against the genericness refusal and offered a further amendment to the identification of goods and services. The Examining

Attorney, in her third office action, accepted the amendment to the identification of goods and services which now reads as follows:

providing computerized online web pages featuring user-defined information which includes search engines and online web links to other web sites; registration of domain names for identification of users on a global computer network, and hosting the web sites of others on a computer server for a global computer network.

The Examining Attorney was not persuaded by applicant's arguments that the mark is not generic of the identified services, and finally refused to register the mark on this ground.

Applicant then filed an appeal. Both applicant and the Examining Attorney filed briefs; no oral hearing was requested.

At the outset, it is important to make clear that in the Examining Attorney's third and final office action, genericness was the only ground for refusal of registration of applicant's mark. The Examining Attorney made no mention of mere descriptiveness beyond the first office action and never addressed the sufficiency of applicant's

showing of acquired distinctiveness.² Thus, the only issue before us on appeal is that of genericness.

In support of her contention that CATALOG.COM is the generic term for applicant's services, the Examining Attorney argues, at page 2 of her final office action, as follows:

The applicant has applied to register CATALOG.COM for "providing computerized on-line web pages featuring user-defined information which includes search engines and online web links to other web sites; registration of domain names for identification of users on a global computer network; and hosting the web sites of others on a computer server for a global computer network." The class of services at issue is creating and hosting of online catalogs. See attached printout from the applicant's web site, www.catalog.com. The relevant public understands the mark to refer to catalogs provided online that are accessible through the applicant's web site, CATALOG.COM, because the mark is simply the generic name for the information featured on the applicant's web site combined with the generic top-level domain designation .COM.

The Examining Attorney made of record an excerpt from The American Heritage Dictionary of the English Language (Third edition, 1992) wherein "**catalog**" is defined as, inter alia, "[a] list or itemized display, as of titles, course

² Indeed, applicant made note of this in its appeal brief. Thus, if it was the Examining Attorney's intent to finally refuse registration also on the ground of mere descriptiveness and an insufficient showing of acquired distinctiveness, it seems to us that, at that point, she would have requested remand of the application for that purpose.

offerings, or articles for exhibition or sale, usually including descriptive information or illustrations"; excerpts of stories from the NEXIS database which make reference to "online catalogs"; and a printout of a page from applicant's web site which contains the following statement: "Your source for Domains, Online Catalogs and Free Web Hosting Forever."

Applicant, in urging reversal of the refusal to register, argues that the Examining Attorney has not established that CATALOG.COM is generic for applicant's identified services. According to applicant, it does not offer online catalogs as a service, but rather offers assistance to its merchant customers in creating websites that include searchable online catalogs. Applicant contends that the Examining Attorney has misunderstood the statement quoted from applicant's website. Applicant states that this statement is directed to potential online merchants who may wish to register a domain name, acquire website hosting services, and/or seek assistance with the creation of a commercial website with an online catalog.

In determining whether an applied-for mark is generic, our primary reviewing court, in *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986), has stated:

The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question. Determining whether a mark is generic therefore involves a two-step inquiry. First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services? (citations omitted)

Further, the "burden of showing that a proposed trademark is generic remains with the Patent and Trademark Office." *In re Merrill Lynch*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). Moreover, it is incumbent upon the Examining Attorney to make a "substantial showing ... that the matter is in fact generic." *Merrill Lynch*, 4 USPQ2d at 1143.

The genus of services involved in this case are website development and support services; domain name registration; and website hosting. The relevant public for such services are individuals and businesses.

As previously indicated, it is the Office's burden to establish that the applied-for mark is generic. Although the genus of services involved in this case is website development and support services; domain name registration; and website hosting, essentially all of the Examining Attorney's evidence pertains to goods, i.e., printed or online catalogs. Such evidence is not probative of whether

CATALOG.COM is generic for the services recited in applicant's application. See *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) ("Thus, a proper genericness inquiry focuses on the description of services set forth in the [application]"). Moreover, this is not a case in which we would apply the principle that a mark which is the generic name of a particular category of goods is likewise generic for any services that are directed to or focused on that class of goods. The services recited in applicant's application are not directed to or focused on printed or online catalogs. Cf. *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789 (TTAB 2002) [BONDS.COM is generic term for information and electronic commerce services regarding financial products provided via the Internet since bonds is one of the financial products that comprise subject matter of the services].

Thus, in this case, we agree with applicant that the Examining Attorney's evidence fails to establish that CATALOG.COM is understood by the relevant public primarily to refer to the genus of services recited in applicant's application.

Decision: The refusal to register is reversed. The application will proceed to publication with no Section 2(f) claim.