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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Allwall Technologies, Inc.[1]

Serial No. 75/879,693

A. Jose Cortina of Kilpatrick Stockton for Allwall Technologies, Inc.

Richard S. Donnell, Trademark Examining Attorney, Law Office 106 (Mary Sparrow, Managing Attorney).

Before Hanak, Walters and Drost, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Allwall Technologies, Inc. filed an application to register on the Principal Register the mark ART.COM for, as amended, "retail services in the field of art; art gallery services offered via computer networks and global communications networks; computerized on-line ordering,

[1] The application was originally filed by Getty Images, Inc. The application was assigned to Allwall Technologies, Inc. on June 8, 2001, and the assignement was recorded at the USPTO on August 15, 2001.

consulting, and advisory services in the field of framing materials for works of art and works of art, namely, original and reproduced paintings, color prints, pictures, printed art reproductions, limited edition prints, lithographs, lithographic prints, photographs, pictorial prints, cartoons, color pictures, art prints, art etchings, drawings, and posters thereof; sculptures and decorative objects and framing parts thereof, namely, matting dimensions and glass; electronic greeting cards; providing on-line information concerning the field of works of art, namely, art, art prices, art sources, art prints, art publishers and individual artists," in International Class 35.[2]

The Trademark Examining Attorney initially refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's proposed mark is merely descriptive when used in connection with its services. After the final refusal was issued, applicant filed, on August 15, 2001, a notice of appeal and request for reconsideration, which included an amendment of its application to seek registration on the Supplemental Register. The Board remanded the application to the Examining Attorney, who accepted the amendment, withdrew the

[2] Serial No. 75/879,693, filed December 23, 1999, based on use of the mark in commerce, alleging first use as of November 12, 1998 and use in commerce as of November 13, 1998.

refusal based on mere descriptiveness, and issued a refusal to register, which was ultimately made final, under Section 23 of the Trademark Act, 15 U.S.C. 1091, on the ground that the alleged mark is generic in connection with the identified services.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs,[3] but an oral hearing was not requested. We affirm the refusal to register.

With respect to genericness, the Office has the burden of proving genericness by "clear evidence" thereof. *In re Merrill, Lynch, Pierce, Fenner & Smith, Inc.,* 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be registered to refer to the category or class of goods or services in question. *In re Women's Publishing Co. Inc*., 23 USPQ2d 1876, 1877 (TTAB 1992). Our primary reviewing court has set forth a two-step inquiry to determine whether a mark is generic: First, what is the category or class of goods or services at issue? Second, is the term sought to be registered understood by the relevant public primarily to refer to that category or class of goods or services? *H.*

[3] With its brief, applicant submitted a dictionary definition that was previously made of record by the Examining Attorney and an excerpt from a magazine article. Although the magazine article is untimely, the Examining Attorney expressly stated in his brief that he does not object to this evidence and, thus, the article has been considered as part of the record.

Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986).

The Examining Attorney contends that the genus of the involved services is "retail services featuring various types of art"; and that the ART portion of applicant's mark is the generic name for the class of goods that applicant's online retail services offer for sale. He submitted several dictionary definitions of "art," one of which is, in part, "[c]onscious arrangement or production of sounds, colors, forms, movements, or other elements in a way that affects the aesthetic sense" and "the product of these activities."[4] The Examining Attorney refers to the excerpts in the record from applicant's website as evidence of the "art" products offered for retail sale thereon.[5]

The Examining Attorney contends that the second portion of applicant's mark, .COM, is a top level Internet domain name that does not serve in a source-identifying role; it merely serves to show that applicant is a commercial entity doing business on the Internet. He concludes that the mark in its entirety, ART.COM, is a generic term for the class of

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[4] *Webster's II New Riverside University Dictionary*, 1984.

[5] The Examining Attorney also submitted copies of third-party registrations on the Principal Register containing disclaimers of the term "art." Several of the registrations contain claims under Section 2(f) of the Act. Because the issue in this case is whether the alleged mark is generic, only those few registrations with Section 2(f) claims and disclaimers are relevant.

art and art-related products that applicant sells via its retails services on Internet, and that consumers would immediately recognize it as such. The Examining Attorney characterizes the alleged mark as "akin to a compound word consisting of a generic term combined with the top-level domain indicator .COM." [Brief, pg. 11.]

Applicant admits that "the term 'ART' in the context of applicant's mark, ART.COM, may be generic for the genus of products known as 'art.'" [Brief, pg. 2.] Applicant further states the following [brief, pg. 3]:

> In all cases, the term "art" applies to products or goods and not services. While it is acknowledged that a term can be generic as applied to services dealing with the class of goods to which services are applied, this is not the case in this application. "Art" is also a first name.

We begin our analysis by noting the definition made of record by the Examining Attorney of ".com" as "[a] top-level domain name used for commercial Internet sites in the United States."[6] We find that this case is analogous to the decision of the Board in *In re Martin Container, Inc.*, 65 USPQ2d 1058 (TTAB 2002), wherein the Board found the proposed mark CONTAINER.COM to be generic in connection with retail sales and rental of containers. In that case, the Board stated the following:

> In the case before us, contrary to *Dial-A-Mattress* [*In re Dial-A-Mattress Operating Corp.*, 24 F.3d

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[6] *High-Tech Dictionary*, www.computeruser.com, September 10, 2002.

> 1341, 57 USPQ2d 1807 (Fed. Cir. 2001)], the mark cannot be characterized as a mnemonic phrase. It is instead a compound word, a generic term combined with the top level domain indicator, ".COM." In proving genericness, the Office may satisfy its burden by showing that these separate generic words have a meaning identical to the meaning common usage would ascribe to those words as a compound. *In re Gould Paper Corp*., 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987). In a similar sense, neither the generic term nor the domain indicator has the capability of functioning as an indication of source, and combining the two does not result in a compound term that has somehow acquired this capability.

See also *In re CyberFinancial.Net, Inc*., 65 USPQ2d 1789 (TTAB 2002).

As in *In re Martin Container, Inc*., the matter for which registration is sought herein, ART.COM, is a compund term that is incapable of identifying the source of applicant's services. The evidence clearly establishes that "art" refers to a class of products that encompass the goods offered via applicant's Internet web site. As stated in *In re Martin Container, Inc., supra*, the term ".COM" is merely a top-level domain indicator (TLD), which is a necessary part of an address on the Internet. As with business entity designations such as "INC." or "CO.," it has no source indicating significance to the purchasing public, and cannot serve any service mark purpose. *See In re Paint Products Co*., 8 USPQ2d 1863 (TTAB 1988), ["PAINT PRODUCTS CO" held incapable of identifying and distinguishing paints], and *In re E.I. Kane*, Inc., 221 USPQ 1203 (TTAB 1984), ["OFFICE

MOVERS, INC." held incapable of identifying and distinguishing office facilities moving services]. *See also*: 1 J. McCarthy, *McCarthy on Trademarks & Unfair Competition*, Section 7:17.1 (4th ed. 2002) at 7-28.1 {"a top level domain ('TLD') indicator (such as '.com') has no source indicating significance and cannot serve any trademark (or service mark) purpose [and] the same is true of other non-distinctive modifiers used in domain names, such as 'http://www' and 'html'; [thus, because] the TLD '.com' functions in the world of cyberspace much like the generic indicators 'Inc.,' 'Co.,' or 'LTD.' placed after the name of a company, [a] top level domain indicator like '.com' does not turn an otherwise unregistrable designation into a distinctive, registrable trademark (or service mark)"}.

We find that the individual words making up the term ART.COM have the same meaning that common usage would ascribe to them as a compound and, thus, ART.COM, used in connection with the identified services is incapable of registration on the Supplemental Register. See *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987). This conclusion is consistent with applicant's admissions; and applicant's arguments to the contrary are unpersuasive.

Decision: The refusal under Section 23 of the Act on the ground that the subject matter of this application is generic is affirmed.