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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re 1800Diapers, Inc.

Serial No. 77141701

Marshall J. Nelson of Davis Wright Tremaine LLP for
1800Diapers, Inc.

Robert J. Struck, Trademark Examining Attorney, Law Office
109 (Dan Vavonese, Managing Attorney).

Before Hairston, Drost and Cataldo, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

1800Diapers, Inc. has filed an application to register
the designation DIAPERS.COM (in standard character form) on
the Supplemental Register for "on-line retail store
services featuring baby-care products and accessories" in
International Class 35.¹

¹ Serial No. 77141701, filed March 27, 2007, alleging dates of
first use of at least as early as March 21, 2007.

The trademark examining attorney has refused registration under Section 23 of the Trademark Act on the ground that the designation sought to be registered is generic for applicant's on-line retail store services featuring baby-care products and accessories and, therefore, is incapable of distinguishing applicant's services from those of others.

When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs.

Before turning to the substantive issue in this case, we must address an evidentiary matter. Applicant, for the first time with its appeal brief, submitted a printout of its Internet homepage downloaded July 22, 2008; a printout from the Internet website "www.babyshoe.com;" and copies of six third-party registrations of marks that include the term ".COM." (Exhibits A-C). The examining attorney has objected to these exhibits as untimely. Trademark Rule 2.142(d) provides that the record in an application should be complete prior to the filing of an appeal, and the Board will ordinarily not consider additional evidence filed by the applicant or the examining attorney after the appeal is filed. In view thereof, we find the examining attorney's objection to be well-taken, and the exhibits submitted with applicant's appeal brief will not be considered. We note

that even if we had considered these exhibits in our determination of the issue on appeal, the result would be the same.

We turn then to the issue on appeal, namely, whether the designation DIAPERS.COM is generic for applicant's on-line retail store services featuring baby-care products and accessories. The examining attorney contends that the word "diapers" is generic for applicant's on-line retail store services because diapers are one of the principal products applicant sells on-line; that the top-level domain (TLD) ".com" has no source-indicating significance; and, therefore, the combined term DIAPERS.COM is generic for applicant's services. In support of the refusal, the examining attorney submitted several dictionary definitions of the word "diaper;" the following is representative: "*a piece of cloth or other absorbent material folded and worn as underpants by a baby not yet toilet-trained.*" Random House Unabridged Dictionary (1997). In addition, the examining attorney submitted a printout of applicant's Internet homepage downloaded December 17, 2007.

Applicant, in urging reversal of the refusal to register, maintains that diapers are but one of many baby-care products that it sells on-line; that the examining attorney has not demonstrated that the public primarily

understands DIAPERS.COM as the name of an on-line retailer of baby care products and accessories; and that the addition of ".COM" to "DIAPERS" creates a mark that is capable of distinguishing applicant's services from those of others. In addition, applicant argues that the examining attorney has failed to present any evidence of generic use of DIAPERS.COM and, therefore, this designation is not generic.

Section 23 of the Trademark Act provides that a mark is registrable on the Supplemental Register if it is capable of distinguishing the applicant's goods or services. Generic terms are common names that the relevant purchasing public understands primarily as describing the class of goods or services being sold. In re Merrill Lynch Pierce, Fenner & Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). They are by definition incapable of indicating a particular source of the goods or services, and cannot be registered as trademarks. In re Dial-A-Mattress Operating Corp., 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001). The Office bears the burden of proving that a term is generic. In re The American Fertility Society, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999).

Determining whether a term is generic involves a two-step inquiry. First, what is the genus of goods or

services at issue? Second, is the term sought to be registered understood by the relevant public primarily to refer to that genus of goods or services? *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986).

With respect to the first part of the genericness inquiry, the genus of services at issue here is that of on-line retail store services featuring baby-care products and accessories, including diapers.

We next turn to the second step of the genericness inquiry, that is, whether the relevant public understands the term DIAPERS.COM to refer to the category of services at issue, namely, on-line retail store services featuring baby-care products and accessories, including diapers. We find that the term is so understood. Obviously, diapers are a type of baby-care product, and applicant acknowledges that it sells diapers on-line. Indeed, the printout of applicant's homepage submitted by the examining attorney shows "Baby Diapers" as the first category of products listed, along with a photograph of two diaper brand boxes and the wording "THE BEST DEAL ON DIAPERS & MORE." In addition, the homepage displays applicant's toll free telephone number which is "1-800-Diapers." (underlining

added). It is clear that diapers are one of applicant's featured products.

The Board has held in the past that a term which is the generic name of a particular category of goods is likewise generic for any services which are directed to or focused on that class of goods. See *In re Lens.com Inc.*, 83 USPQ2d 1444 (TTAB 2007) [LENS generic for contact eyewear and also for on-line retail store services featuring contact eyewear products]; *In re A La Vielle Russie Inc.*, 60 USPQ2d 1895 (TTAB 2001) [RUSSIAN ART generic for particular field or type of art and also for dealership services directed to that field]; and *In re Log Cabin Homes Ltd.*, 52 USPQ2d 1206 (TTAB 1999) [because LOG CABIN HOMES is generic for a particular type of building, it is also generic for architectural design services directed to that type of building, and for retail outlets featuring kits for construction of that type of building].

The term DIAPERS is generic for a type of baby-care product, namely diapers. The term is also generic for applicant's on-line retail store services featuring baby-care products and accessories, including diapers. We recognize that in the present case the recitation of services does not specifically use the word "diapers." However, as indicated, applicant sells diapers on-line.

More importantly, the identified "baby-care products and accessories" in the present application encompasses the more specific term "diapers." And, if applicant's mark DIAPERS.COM is generic as to part of the services applicant offers under its mark, the mark is unregistrable. In re Analog Devices Inc., 6 USPQ2d 1808 (TTAB), aff'd without pub. op., 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989); and In re Allen Electric and Equipment Co., 458 F.2d 1404, 173 USPQ 689 (CCPA 1972) [genericness is determined on the basis of the goods and/or services identified in the involved application].

Insofar as the TLD ".com" is concerned, it merely indicates an Internet address for use by commercial, for-profit organizations² and, typically, does not add source-indicating significance. See In re Oppedahl & Larson LLP, 373 F.3d 1171, 17 USPQ2d 1370 (Fed. Cir. 2004). Although the Oppedahl decision also indicates that in rare circumstances, the addition of a TLD such as ".com" may render an otherwise descriptive or generic term sufficiently distinctive for trademark registration, this

² In this regard, we judicially notice that the term ".com" is defined as: *abbr. commercial organization (in Internet addresses)*. The American Heritage Dictionary of the English Language (4th ed. 2006). The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J.C. Gourmet Foods Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), aff'd 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

is not such a case. Here, the addition of ".COM" to the word "DIAPERS" does not transform a generic designation into a mark which indicates source. No double entendres or multiple connotations are created by the composite DIAPERS.COM in the context of applicant services. To consumers seeking to buy diapers, DIAPERS.COM would immediately indicate a commercial website on the Internet which sells diapers.

We find this case to be akin to *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789 (TTAB 2002) [BONDS.COM generic for providing information regarding financial products and services via a global computer network] and *In re Martin Container, Inc.*, 65 USPQ2d 1058 (TTAB 2002) [CONTAINER.COM generic for retail store services and retail services offered via telephone featuring metal shipping containers and rental of metal shipping containers]. In each of those cases, the Board held that the TLD ".com" had no source-indicating significance, and did not turn an otherwise unregistrable designation into a distinctive registrable mark.

In finding that the designation DIAPERS.COM is generic, we recognize that the examining attorney has presented no evidence of generic use of this designation. It has been held that compound words may be refused as

generic when definitions of the individual terms that are joined to create the compound show that such terms are generic. In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987). Generic terms coupled with a TLD are considered compound words. See CyberFinancial.Net and Martin Container, supra. In this case, therefore, we have a compound formed by joining the generic term "diapers" and the generic TLD ".com." Thus, under Gould, the evidence of the genericness of "diapers" and ".com" is sufficient to demonstrate that the compound term DIAPERS.COM is generic. In other words, the absence of evidence of generic use of DIAPERS.COM does not compel a different result herein.

For the foregoing reasons, we find that the designation DIAPERS.COM is generic for applicant's on-line retail store services featuring baby-care products and accessories. Thus, DIAPERS.COM is incapable of distinguishing applicant's services, and it is not registrable on the Supplemental Register.

Decision: The refusal to register is affirmed.