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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Edmunds.com, Inc.

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Serial No. 78540254

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Elisabeth A. Evert of Hitchcock Evert LLP for Edmunds.com,  
Inc.

Michael G. Lewis, Trademark Examining Attorney, Law Office  
111 (Craig D. Taylor, Managing Attorney).

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Before Bucher, Grendel and Walsh, Administrative Trademark  
Judges.

Opinion by Walsh, Administrative Trademark Judge:

On December 30, 2004, Edmunds.com, Inc. (applicant)  
applied to register the mark TRUE MARKET VALUE in standard-  
character form on the Principal Register for services  
identified as "computer services, namely providing online,  
interactive database which provides an evaluation of the  
market value of a vehicle based on criteria entered by the  
database user" in International Class 35. Applicant claims  
both first use of the mark anywhere and first use of the

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mark in commerce on June 15, 2000. Applicant also submitted a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), with its application.

The Examining Attorney has finally refused registration under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), on the grounds that the mark is not only merely descriptive but generic, that is, "incapable of serving as a source-identifier for applicant's goods and/or services." Final Action at 1. The Examining Attorney also rejected applicant's evidence of acquired distinctiveness as insufficient "in light of the highly descriptive nature of the mark." *Id.* at 3.

Applicant appealed. Applicant and the Examining Attorney have filed briefs. We reverse the genericness refusal and affirm the refusal on the grounds that applicant's evidence of acquired distinctiveness is insufficient.

Our decision must address two distinct issues: (1) whether the Examining Attorney has established that TRUE MARKET VALUE is generic for "computer services, namely providing online, interactive database which provides an evaluation of the market value of a vehicle based on criteria entered by the database user"; and, if he has not,

(2) whether applicant has established that TRUE MARKET VALUE has acquired distinctiveness for the identified services.

Applicant also argues, somewhat obliquely, that TRUE MARKET VALUE is suggestive, that is, that TRUE MARKET VALUE is inherently distinctive, in spite of the fact that applicant filed a claim of acquired distinctiveness with the application. We will address this issue, to the extent necessary, in our discussion of whether or not TRUE MARKET VALUE is generic.

I. The Genericness Issue

A term is generic if it identifies the class, genus or category of services at issue. *See In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001), citing *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986).

The Court of Appeal for the Federal Circuit provided a framework for the consideration of whether or not a term is generic in the *Fire Chief* case. Specifically, the Court dictated 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." *H. Marvin Ginn Corp. v. International Assn. of Fire Chiefs, Inc.*, 228 USPQ at 530.

Thus, the ultimate test for determining whether a term is generic is its primary significance to the relevant public. See Section 14(3) of the Act. See also *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999) and *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991). The Examining Attorney has the burden of establishing by clear evidence that the term is generic. See *In re Merrill Lynch, Pierce, Fenner and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). Evidence of the relevant public's understanding of a term may come from any competent source, including direct testimony of consumers, consumer surveys, newspapers, magazines, dictionaries, trade journals, catalogs, and other publications. See *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985).

As to the first question *Fire Chief* mandates, the genus question, applicant and the Examining Attorney have taken different positions. The Examining Attorney consistently refers to the relevant genus as including valuation services generally. By so defining the genus the Examining Attorney seeks to rely on evidence of the use of

TRUE MARKET VALUE for valuations in fields other than vehicles. Citing the *Merriam-Webster's Online Dictionary* (10<sup>th</sup> ed.) the Examining Attorney argues, "Genus is defined as 'a class, kind or group marked by common characteristics.' In this particular instance valuation services are the genus because it describes the class through which the Applicant's services must be grouped." Examining Attorney's Brief at 5-6. The Examining Attorney argues further, "Applicant's narrow classification is more akin to species classification in the biological classification system instead of the genus classification and thus is improper based on the facts of this case." *Id.* at 6.

On the other hand applicant argues that we should look to the identification of services in the application to determine the genus, that is, "computer services, namely providing online, interactive database which provides an evaluation of the market value of a vehicle based on criteria entered by the database user."

We agree with applicant. In fact, the Examining Attorney's arguments simply beg the question; the dictionary definition and the analogy to biology are not helpful here. In the *Fire Chief* case, the Court, in fact, looked to the identification of services in the

registration at issue, that is, "a magazine directed to the field of fire fighting," noted that there are other publications directed to that field and concluded, "The class of magazines at issue is, therefore, those directed to the field of firefighting." *H. Marvin Ginn Corp. v. International Assn. of Fire Chiefs, Inc.*, 228 USPQ at 532. In this case we see no reason to depart from the Court's approach in *Fire Chief*. We have no evidence that those engaged in valuations in such diverse fields as vehicles, real estate, jewelry or business records are part of a "group marked by common characteristics." The potential "common characteristic" of interest here is terminology, whether descriptive, generic or otherwise. We have no evidence that those performing valuation in these diverse fields and those using their services employ the same terminology and understand terminology in the same way.

Therefore, for the purpose of our consideration of whether or not TRUE MARKET VALUE is generic we will consider only the evidence relating to the field of vehicle valuations. We hasten to add that the Examining Attorney has overstated the volume of evidence of record in other fields, and that we would not reach a different conclusion here if we had considered all of the Examining Attorney's evidence without regard to the valuation field.

We now turn to the second question *Fire Chief* poses - Is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services.

In addressing this question we must first consider a threshold issue applicant and the Examining Attorney have not directly addressed, that is, whether TRUE MARKET VALUE is a phrase or a compound term. We conclude that TRUE MARKET VALUE is a phrase and should be analyzed as such.

In *In re Dial-A-Mattress Operating Corp.*, the Court considered the mark "1-888-M-A-T-R-E-S-S" for "telephone shop-at-home retail services in the field of mattresses" and stated:

... where the proposed mark is a phrase (such as "Society for Reproductive Medicine"), the board "cannot simply cite definitions and generic uses of the constituent terms of a mark"; it must conduct an inquiry into "the meaning of the disputed phrase as a whole." *In re The Am. Fertility Soc'y*, 188 F.3d at 1347, 51 USPQ2d at 1836.

*In re Dial-A-Mattress Operating Corp.*, 57 USPQ2d at 1387. The court concluded that "1-888-M-A-T-R-E-S-S" bears closer conceptual resemblance to a phrase than a compound word, and the court reiterated that the PTO must produce evidence of the meaning the relevant purchasing public ascribes to the mark "as a whole."

*Id. at 1387.* The Court concluded that 1-888-M-A-T-R-E-S-S was generic and added that the term is not literally a genus or class name for the service at issue. Accordingly, we conclude that TRUE MARKET VALUE is a phrase and will analyze it as such.

Next we consider whether the Examining Attorney's evidence establishes that TRUE MARKET VALUE is a phrase which defines the class of vehicle valuation services. Applicant argues that the evidence is lacking and summarizes the evidence as follows:

By Applicant's count, the Examining Attorney submitted 12 articles in conjunctions with his final action in an attempt to demonstrate a generic nature. Of these articles five are outside the automotive field, and one refers to boats... This leaves only six articles discussing TRUE MARKET VALUE in the vehicle field. Of these, one is from the U.K..

...in his denial of request for reconsideration mailed January 5, 2007, the Examining Attorney provides an additional 13 Internet references that attempt to portray "true market value" as a generic term. Of these three are outside the scope of Applicant's services, one is a reference in the United Kingdom, and two are from the same website.

Applicant's Brief at 4. The Examining Attorney also provided examples with his First Action, but those examples appear to be duplicated in the evidence applicant discusses here.

Later applicant also points out and documents that, in the case of the one "boat" example at usedboats.com, the use of TRUE MARKET VALUE ceased. Applicant also provided a full copy of the article from the *Orange County Register* which the Examining Attorney had provided a brief excerpt from to show that, in fact, the article refers to applicant. *Id.* at 6. In addition applicant notes that the example from newcars.com appears to be infringing because it also uses a registered mark owned by applicant, TMV, along with TRUE MARKET VALUE. *Id.* at 7.

On the other hand the Examining Attorney argues that this same evidence is sufficient to conclude that TRUE MARKET VALUE is generic.

We conclude that the evidence of the use of TRUE MARKET VALUE is insufficient in both quantity and quality to establish that TRUE MARKET VALUE is generic. Applicant's characterization and criticisms of the Examining Attorney's evidence are well-taken. In the end we have about ten to fifteen examples of the use of FAIR MARKET VALUE in relation to vehicles, and only a few more in other fields. The examples are generally in the text of articles, typically in the form of passing references to valuations. Also,

conspicuous by their absence are clear uses by competitors. In sum, we conclude that the evidence here is insufficient to meet the clear evidence standard and that, on this record, the Examining Attorney has failed to establish that TRUE MARKET VALUE is a genus or class name for "computer services, namely providing online, interactive database which provides an evaluation of the market value of a vehicle based on criteria entered by the database user."

However, the evidence of record does show that the phrase TRUE MARKET VALUE is highly descriptive of the identified services. We reject applicant's arguments that TRUE MARKET VALUE is suggestive of these services.

When we view TRUE MARKET VALUE in the context of the identified services, as we must, the conclusion that it is highly descriptive of a feature or characteristic of the services is inescapable. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978); *In re H.U.D.D.L.E.*, 216 USPQ 358, 359 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338, 339 (TTAB 1973). The point of the service is to provide a measure of market value of a vehicle, and the addition of the highly

descriptive, laudatory adjective TRUE is hardly sufficient to transform the phrase into an inherently distinctive mark. See *In re Best Software Inc.*, 63 USPQ2d 1109 (TTAB 2002); *In re Wileswood, Inc.*, 201 USPQ 400 (TTAB 1978).

## II. Acquired Distinctiveness

In view of our finding that the Examining Attorney has established that TRUE MARKET VALUE is highly descriptive, but not generic, we must consider whether applicant has established that its highly descriptive phrase has acquired distinctiveness. Section 2(f) contemplates that, in the case of a mark found to be merely descriptive under Section 2(e)(1), but not generic, an applicant may nonetheless establish that the mark is entitled to registration by showing that the mark has acquired distinctiveness. 15 U.S.C. § 1052(f). The applicant bears the burden of establishing acquired distinctiveness. *Yamaha Intl. Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004-1008 (Fed. Cir. 1988).

Section 2(f) provides, in part, "The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the

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applicant in commerce for the five years before the date on which the claim of distinctiveness is made." 15 U.S.C. § 1052(f).

In considering a claim of acquired distinctiveness, the Examining Attorney must determine, based on the degree of descriptiveness of the mark in question, whether a five-year claim or other evidence proffered is adequate to establish acquired distinctiveness. See *In re America Online Inc.*, 77 USPQ2d 1618 (TTAB 2006); *In re Mine Safety Appliances Co.*, 66 USPQ2d 1694 (TTAB 2002); *In re Garcia*, 175 USPQ 732 (TTAB 1972).

In support of its claim of acquired distinctiveness, in its brief applicant first refers the length of time it has used TRUE MARKET VALUE, that is, since June 15, 2000 as alleged in the application. Although applicant appears to invoke the five-year provision of Section 2(f), applicant has not submitted the verified statement with all of the essential allegations, including a claim of "*substantially exclusive* and continuous use" for five years (emphasis provided). Accordingly, we will consider applicant's claim of long use apart from the five-year provision of Section 2(f). For the record, we note that a proper five-year claim under Section 2(f) would, by itself, be insufficient to show acquired distinctiveness in this case due to the

highly descriptive nature of the mark. Likewise we reject the claim of long use as insufficient, by itself, or for that matter, in combination with applicant's other evidence in this case, to establish acquired distinctiveness. See *In re Lens.com Inc.*, 83 USPQ2d 1444, 1448 (TTAB 2007) and cases cited therein.

Applicant also relies on other evidence in its attempt to show that TRUE MARKET VALUE has acquired distinctiveness. Applicant provides that evidence principally with an affidavit from Kenneth H. Levin, applicant's Executive Vice President and General Counsel filed with the application. The additional evidence includes: (1) three articles in which its service is discussed and TRUE MARKET VALUE is mentioned, two very brief items from *The New York Times* and the article referenced above from *The Orange County Register*; (2) uses of TRUE MARKET VALUE "by the press and trade and industry groups" consisting of examples of uses appearing on three websites; and (3) uses of TRUE MARKET VALUE on "third party websites in the trade and industry..." consisting of examples from three additional web sites. Levin Aff. at 3.

The Levin affidavit itself consists largely of conclusory statements. For example, Mr. Levin states, "The subject mark has been extensively used, promoted and

advertised by Applicant in interstate commerce throughout the United States and on the global computer information network known as the Internet." Levin Aff. at 2. Mr. Levin also asserts, "Recognition by the public and the trade of the distinctiveness of the subject mark as used in connection with the services has consistently increased and this mark has been a significant feature in increasing sales and total business growth." *Id.*

Mr. Levin does provide the following information:

... Applicant makes extensive use of the mark at its website [www.edmunds.com](http://www.edmunds.com). By way of example and not limitation, visitors to Applicant's home page totaled approximately 250,000 per day for the months of October and November of 2004. As such annualized impressions of the mark total over 90 million per year.

... Additionally, visitors to Applicant's "Options Results" page within its [www.edmunds.com](http://www.edmunds.com) site total approximately 2 million per month. Annualized impressions total 24 million per year.

... Applicant has expended tens of thousands of dollars in advertising and promotion expenditures in connection with the mark in an effort to achieve consumer recognition of the mark... Moreover, Applicant has devoted countless person-hours to the promotion, advertising and offering of its goods and services under the mark.

*Id.* at 3.

Under the circumstances of this case, the examples of references to TRUE MARKET VALUE in the press and on websites is not impressive in either quantity or quality.

With regard to the evidence about applicant's own website, it is possible, if not probable, that many of those who viewed the home page also viewed the "Options Results" page. More importantly, even if we assume these totals represent different individuals, and further assume applicant's extrapolations from this limited data to apply over the history of its use of TRUE MARKET VALUE, we find this evidence unimpressive. Likewise with regard to the rather vague evidence concerning advertising expenditures and activities, we find that evidence unpersuasive.

Conspicuous by its absence is any evidence showing the promotion of TRUE MARKET VALUE specifically as a mark. In sum, we find applicant's evidence far short of what would be required to show acquired distinctiveness in this case. Due to the highly descriptive nature of TRUE MARKET VALUE, mere evidence of applicant's use of TRUE MARKET VALUE and evidence of applicant's general promotion of its service, however extensive, is not sufficient. Likewise, the limited references by third parties to TRUE MARKET VALUE in the context of applicant's services is insufficient.

Rather, again, due to the highly descriptive nature of TRUE MARKET VALUE, evidence of the promotion of TRUE MARKET VALUE specifically as a mark and evidence of the impact of applicant's use and promotion of TRUE MARKET VALUE is

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necessary to establish that TRUE MARKET VALUE has acquired distinctiveness. That is, in a case such as this, we need direct evidence that relevant consumers have come to associate TRUE MARKET VALUE with applicant. Direct evidence could take the form of consumer testimony or consumer surveys, or other similar evidence. In the absence of any direct evidence, on this record we conclude that applicant has failed to establish that TRUE MARKET VALUE has acquired distinctiveness.

Finally, we note that in its main brief applicant for the first time refers to two prior registrations it owns in an apparent attempt to bolster its claim of acquired distinctiveness. Specifically, applicant refers to Registration No. 2498032 for the mark EDMUNDS.COM TRUE MARKET VALUE and Registration No. 2484937 for the mark TMV. The services identified in both applications are the same as the services identified in the application at issue here. Applicant also points out that the registration for EDMUNDS.COM TRUE MARKET VALUE does not include a disclaimer.

The Board does not take judicial notice of USPTO records. To make registrations of record, applicant must submit a copy of the registration or a printout from the USPTO's electronic database. *In re Duofold, Inc.*, 184 USPQ

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638, 640 (TTAB 1974) (“[T]he submission of a list of registrations is insufficient to make them of record.”). However, the Examining Attorney has not objected to this listing of registrations. Nor has the Examining Attorney objected to the late submission of this evidence. See Trademark Rule 2.142, 37 C.F.R. § 2.142(d), which states, “The record in the application should be complete prior to the filing of an appeal.” In fact, the Examining Attorney has not only failed to object to this evidence on either ground, but he has discussed this evidence in his brief. Accordingly, we have considered the registrations, but only to the extent of the information provided.

The second registration for TMV mark is not relevant because it does not include the words TRUE MARKET VALUE. Therefore, we find all arguments based on this registration unconvincing.

As to the first registration, in the absence of any official record, we accept applicant’s characterization of the mark as including spaces between each of the terms, EDMUNDS.COM, TRUE, MARKET, and VALUE. We also accept applicant’s representation that the registration does not include any disclaimer. Likewise, we accept application’s representation that the services identified in the

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registration are the same as the services identified in the TRUE MARKET VALUE application we are considering here.

Nonetheless, we reject applicant's argument that it is entitled to register TRUE MARKET VALUE alone based on its prior registration for EDMUNDS.COM TRUE MARKET VALUE. The difference in the marks is critical. See *In re Best Software Inc.*, 63 USPQ2d at 1112-1113 and cases cited therein. We reject applicant's arguments that TRUE MARKET VALUE is the truly distinctive element in the composite registered mark and that EDMUNDS.COM is not significant. In fact, the opposite would appear to be the case.

Furthermore, because we have no evidence that applicant's prior registration has achieved incontestable status under Trademark Act Section 15, 15 U.S.C. § 1065, applicant would be barred from basing its entitlement to registration on this prior registration even if it were otherwise proper. See *In re American Sail Training Assn.*, 230 USPQ 879, 880 (TTAB 1986).

This is a case where we have the discretion to accord the claim of ownership of the prior registration appropriate weight in our consideration of acquired distinctiveness. We find that it is entitled to little, if any weight. In the end we must consider this case on its own merits based on the full record before us. *In re Nett*

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*Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). Based on this record we conclude that applicant has failed to meet its burden in establishing that the highly descriptive phrase TRUE MARKET VALUE has acquired distinctiveness.

**Decision:** We reverse the refusal to register the mark under Trademark Act Section 2(e)(1) on the ground that the mark is generic, and we affirm the refusal to register the mark under Trademark Act Section 2(e)(1) on the ground that the mark is merely descriptive and applicant has failed to establish that the mark has acquired distinctiveness under Trademark Act Section 2(f). Registration is refused.