

THIS OPINION IS A NOT  
A PRECEDENT OF THE  
TTAB

Oral Hearing: September 30, 2008

Mailed: November 13, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Dial-A-Mattress Operating Corp.

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Serial No. 78976682

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Robert E. Rosenthal of Plevy, Howard & Darcy, PC for Dial-A-Mattress Operating Corp.

Steven M. Perez, Trademark Examining Attorney, Law Office 101 (Ronald R. Sussman, Managing Attorney).

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Before Rogers, Walsh and Wellington, Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Applicant, Dial-A-Mattress Operating Corp., filed an application, as amended, to register the mark MATTRESS.COM (in standard character format) on the Supplemental Register for services identified as "online retail store services in the field of mattresses, beds and bedding" in International Class 35.<sup>1</sup>

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<sup>1</sup> In response to an Office action refusing registration, applicant filed a request to divide. The application involved in this appeal is the "child" application (Serial No. 78976682). The "parent" application (Serial No. 78511054) for "telephone shop-at-home retail services, and retail store services in the field of mattresses, beds and bedding" was also appealed, but was remanded to the examining

The trademark examining attorney finally refused registration of applicant's mark on the Supplemental Register on the basis that applicant's mark is generic under Section 23(c) of the Trademark Act, 15 U.S.C. § 1091(c).<sup>2</sup>

Applicant appealed, both applicant and the examining attorney filed briefs, and both participated in oral arguments. The sole issue on appeal is whether the mark is generic in relation to the recited services.

The test for determining whether a mark is generic involves a two-step inquiry. First, what is the genus (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 genus (category or class) of goods or services? See *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986).

The Office has the burden of proving genericness by "clear evidence" of the public's understanding thereof. *In re Merrill*

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attorney at his request. The application is currently under a non-final Office action (issued May 6, 2008) refusing registration.

<sup>2</sup> The examining attorney initially refused registration of the mark on the Principal Register under Section 2(e)(1) of the Trademark Act on the ground that the mark is merely descriptive of the services, and that applicant's evidence of acquired distinctiveness under Section 2(f) of the Act was insufficient. Applicant then filed this appeal and an amendment of the application to seek registration on the Supplemental Register. The application was remanded by the Board to the examining attorney to reconsider the refusal in light of applicant's amendment. The examining attorney then issued a final Office action refusing registration on the genericness ground.

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*Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987).

*The genus (category or class) of services at issue*

Applicant and the examining attorney disagree as to the genus of applicant's services. The examining attorney contends that the genus of services "may reasonably be regarded as 'mattress, bed and bedding stores.'" Brief, (unnumbered) p. 5. Applicant argues that the genus is not so broad as to include "brick and mortar" (physical) stores, but should only include "online retail sales of mattresses, beds and bedding, as recited in the application." Brief, p. 6.

We conclude that that applicant's recitation properly sets forth the genus of services - that is, online retail store services in the field of mattresses, beds and bedding. This obviously does not include "brick and mortar" stores, but does include online stores selling the same goods, i.e., mattresses, beds and bedding, as stores selling such goods from a physical location.

*The meaning of MATTRESS.COM to the relevant public*

Evidence of the relevant public's understanding of a term may be obtained from any competent source including consumer surveys, dictionary definitions, newspapers and other publications. *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985). We have considered

all the evidence of record bearing on purchaser perception of MATTRESS.COM, including the evidence applicant has submitted in support of its claim of acquired distinctiveness. See *In re Recorded Books Inc.*, 42 USPQ2d 1275 (TTAB 1997); and *In re The Paint Products Co.*, 8 USPQ2d 1863 (TTAB 1988).

The examining attorney has submitted a dictionary entry defining "mattress" as "a fabric case filled with resilient material (as cotton, hair, feathers, foam rubber, or an arrangement of coiled springs) used either alone as a bed or on a bedstead."<sup>3</sup>

The record also includes advertisements for applicant's services as well as printouts from applicant's website.<sup>4</sup> Together, these demonstrate that mattresses are the focus, or a key focus, of applicant's online retail store services. A wide variety of mattresses are advertised by applicant for sale to consumers. Because the term "mattress" identifies such a key aspect of applicant's services, i.e., applicant's online retail store services feature mattresses, the term is generic, for applicant's services. Certainly, if the mark comprised this term alone, we would have little trouble concluding that it would be perceived as merely a generic term. See *In re Candy*

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<sup>3</sup> Merriam-Webster's Online Dictionary, printout attached to Office action dated June 13, 2007.

<sup>4</sup> Applicant's advertisements attached to applicant's response filed December 12, 2005. Printouts from applicant's website (www.mattress.com) attached by the examining attorney to Office action dated June 13, 2007.

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*Bouquet International, Inc.*, 73 USPQ2d 1883 (TTAB 2004) [because CANDY BOUQUET is generic for gift packages of candy, it also is generic for applicant's retail, mail and computer ordering services therefor]; *In re A La Vieille Russie Inc.*, 60 USPQ2d 1895 (TTAB 2001) [RUSSIANART 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].

Applicant, instead, places great emphasis on the fact that its mark is not MATTRESS, but is MATTRESS.COM, and argues that because "[t]here is no evidence of record that the mark...is the name for a product or service," registration of applicant's mark "would not deprive competitors of the name of the service." Brief, p. 8. Relying heavily on the Federal Circuit's decision in *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999), applicant argues that the examining attorney "bears the burden of showing that the mark as a whole, and not its component parts, are the common name of the service." Brief, p. 11. In short, applicant argues against any attempt by the examining attorney to rely on evidence only of

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the genericness of the component parts, as in *In re Gould Paper Corp.*, 835 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) (SCREENWIPE held generic).

In response, the examining attorney argues that ".com" is merely an internet address top level domain (TLD) extension and the addition of this TLD to "mattress" does not alter the generic nature of the term "mattress" and result in creation of a mark. In this regard, he relies on a dictionary entry defining ".com" as an abbreviation designating a "commercial organization (in Internet addresses)."<sup>5</sup> He also submitted printouts of various pages from several third-party websites with internet addresses ending in "mattress.com" (or containing "mattress" and ".com") which he argues is an indication that "consumers are not unaccustomed to the combination [of these terms] in internet addresses."<sup>6</sup> Brief, p. (unnumbered) 12. It is also evident from these printouts that the owners of these websites render the same services as applicant, i.e., online retail store services featuring mattresses and/or bedding. Excerpts from these websites include:<sup>7</sup>

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<sup>5</sup> The American Heritage Dictionary of the English Language (Fourth Edition 2000), attached to Office action dated February 2, 2006). A second definition was also made of record: .COM: INTERNET ABBREVIATION FOR company; used in some Internet addresses which belong to companies or businesses. Cambridge Advanced Learner's Dictionary.

<sup>6</sup> Attached to Office action dated February 14, 2008.

<sup>7</sup> Other website addresses for which the examining attorney attached printouts are: [www.acmemattress.com](http://www.acmemattress.com), [www.antiquemattress.com](http://www.antiquemattress.com), [www.alternatingpressuremattress.com](http://www.alternatingpressuremattress.com), [www.brandnamemattress.com](http://www.brandnamemattress.com),

**www.emattress.com**

"Leading the World in Memory Foam Mattress Technology"  
[alongside a picture of mattress and bed]; "Price Quote"  
tab;

**www.bestmattress.com**

"...carries a complete line of national brands such as...";  
"The best prices on the Internet"; "Specializing in  
teaching customers how to select the perfect mattress"  
[accompanied by pictures of mattresses];

**www.futonmattress.com**

"The Best selection of Futon Mattresses Online!"; "shop by  
mattresses"; "part of CSN/Stores";

**www.nationwidemattress.com**

"It's time to treat yourself to a new mattress!"; "Click  
here for [brand name] pricing";

**www.sofa-bed-mattress.com**

Menus include "Sofa Bed Mattresses" and "Other Mattresses";  
purchasing options include credit cards and PayPal next to  
a "View Cart" tab;

**www.us-mattress.com**

Under a drop-down menu for "mattresses" are a variety of  
brand names; sale information on selected Sealy mattresses  
and other "shopping options"; "Free Delivery"; "How to  
Shop" tab.

This evidence demonstrates that domain names incorporating the compound term "mattress.com" are used by others to identify websites and services in the same genus as applicant's services. Consumers would see MATTRESS.COM and would immediately recognize it as a term that denotes a commercial website rendering retail services featuring mattresses.

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www.michigandiscountmattress.com, www.mrmattress.com,  
www.dreammattressandbedding.com, www.mattressbarn.com,  
www.mattressdirectcartersville.com, www.mattresskingdfw.com,  
www.mattressstore.com, and www.themattressstoreonline.com.

Based on the record before us, we find the examining attorney has met his burden of establishing, *prima facie*, that the primary meaning of MATTRESS.COM is generic for the involved services and applicant has not rebutted this showing. Compare *In re Reed Elsevier Properties Inc.*, 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007) (Federal Circuit affirmed refusal to register LAWYERS.COM as generic for services involving "an online interactive database featuring information exchange in the fields of law, legal news, and legal services," where record included eight websites besides the applicant's containing lawyer.com or lawyers.com) with *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420 (Fed. Cir. 2005) (Federal Circuit reversed Board finding that STEELBUILDING.COM is generic for "computerized on-line retail services in the field of pre-engineered metal buildings and roofing systems" where record included evidence of competitive use of "steel building" and "steel buildings" but did not "address directly the composite term STEELBUILDING").

This Board has acknowledged that, "there is no bright-line rule that appending a top-level domain name such as '.com' to an otherwise generic term will never affect registrability." *In re Hotels.com L.P.*, 87 USPQ2d 1100, 1105 (TTAB 2008), citing *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004). Here, however, applicant's coupling of the TLD ".COM"

with MATTRESS, merely signifies that the user of the domain name is a commercial entity retailing its mattresses via an internet website, as do the other online mattress retailers, discussed *supra*. The instant case is unlike the *Steelbuilding.com* case, on which applicant heavily relies, for two significant reasons. First, the record here shows use by competitors of the composite mattress.com, whereas there was little evidence in *Steelbuilding.com* of use of the composite "Steelbuilding." Second, in this case the addition of the ".com" TLD does not create any additional meaning, which the Federal Circuit found created by the addition in *Steelbuilding.com*.

In addition, applicant's reliance on the Federal Circuit's decision in *American Fertility Society* is misplaced for several reasons. In that decision, the Federal Circuit found that the phrase SOCIETY FOR REPRODUCITIVE MEDICINE was not generic and pointed specifically to the absence of "any evidence that the phrase as a whole, SOCIETY FOR REPRODUCTIVE MEDICINE, has acquired no additional meaning to the relevant public than the terms 'society' and 'reproductive medicine' have individually." *American Fertility Society*, 51 USPQ2d at 1837. Here, we have the compound term, MATTRESS.COM, and not a phrase, and "if the compound word would plainly have no different meaning from its constituent words, and dictionaries, or other evidentiary sources, establish the meaning of those words to be generic,

then the compound word too has been proved generic." *Id.* at 1836. See also, *Hotels.com*, 87 USPQ2d at 1105. In any event, the examining attorney herein has provided evidence, as discussed above, that mattress.com is being used by others in their domain names in connection with the same type of services as those recited in the subject application. Thus, unlike the record in *American Fertility Society*, we have ample evidence in this case on which to conclude that the proposed mark MATTRESS.COM, as a whole, has a clear meaning to the relevant public when considered in relation to genus of applicant's services, specifically, an online retailer of mattresses. See *Reed Elsevier*, 82 USPQ2d 1380-81 ("With respect to the board's determination of what services the relevant public would understand LAWYERS.COM to identify, Reed does not take issue with its finding that the relevant public 'would readily understand the term to identify a commercial web site providing access to and information about lawyers.'"), and *Hotels.com*, 87 USPQ2d at 1105 ("It can be seen from the web pages and even from the more abbreviated excerpts in the search summaries that the term 'hotel.com' or 'hotels.com' is frequently used as part of the domain names of others to denote websites that provide hotel information and/or hotel reservation services, i.e., the services provided by applicant's website.").

We also disagree with applicant's arguments that the "com" part of MATTRESS.COM somehow "evokes the words 'comfort,' and 'comfortable'" (brief, p. 16) or that the mark connotes an online source of information about sleep. Simply put, the evidence of record is not persuasive on either proposition. In particular, applicant has presented no evidence or cogent argument supporting a conclusion that purchasers will perceive MATTRESS.COM (or the TLD ".com", by itself) as evoking or being an abbreviated expression of "comfort" or "comfortable," or have the connotation of a website involving general information about sleep. Here, there is no dispute that the genus of services does not encompass providing information services about sleep or sleeping. Rather, applicant itself has stated that the genus of services is online retail sales of mattresses, beds and bedding. There is no plausible explanation of how the .COM top-level domain can be construed as expanding the stated genus of services to include sleep information services. MATTRESS.COM, unlike STEELBUILDING.COM, does not lend itself to any multiple meanings. Despite the fact that applicant may provide sleep information on its website, we do not see how this detracts from the genericness of the mark MATTRESS.COM, when the mark is considered in connection with the genus of services, that is, the services identified in the application. Ultimately, there is nothing in the combination of MATTRESS and .COM that results

in any new or incongruous meaning, or a different commercial impression. Each of the terms MATTRESS and .COM has a clear and readily understood meaning and the combination of the terms, i.e., applicant's proposed mark, communicates just as clearly and directly that applicant operates a commercial website involving the sale of mattresses.

Finally, applicant also argues that its mark operates as a mnemonic, "represent[ing] a convenient and memorable approach to reaching the desired web page, much as a word representing a portion of a phone number represents a convenient and memorable sequence of reaching the desired phone number." Reply brief, p. 8. We agree with the examining attorney that "nothing in the proposed mark clearly suggests such [mnemonic] significance and applicant provides no additional information by which [this] conclusory statement may be judged." Brief, (unnumbered) p. 14. In other words, the mark is not a mnemonic; rather, consumers will perceive the mark as merely a generic reference to a website selling mattresses. The Board has addressed this argument before:

...mnemonics representing telephone numbers correspond to unique ten-digit numbers that can be used by only a single entity, whereas the precise generic term and TLD combination employed by applicant can be incorporated into other domain names. A "blinds and drapery" concern should not be precluded from combining its name with the generic compound term BLINDSANDDRAPERY.COM to create thereby a different domain name from that of applicant. *CyberFinancial*, 65 USPQ2d at 1793.

*In re Eddie Z's Blinds & Drapery Inc.*, 74 USPQ2d 1037, 1042 (TTAB 2005) (finding BLINDSANDDRAPERY.COM to be generic for online retail services featuring blinds and draperies), citing to *In re CyberFinancial.Net, Inc.*, 65 USPQ2d 1789 (TTAB 2002).

While we acknowledge, as applicant points out, that any doubt on the question of genericness must be resolved in favor of publishing the mark for opposition, we disagree with applicant that its evidence is sufficient to raise any such doubt about the genericness of MATTRESS.COM, which we find to be generic.

**Decision:** The refusal to register applicant's mark on the Supplemental Register under Section 23(c) is affirmed.