

## Brand Protection Alert

March 2021

# TTAB Rejects Law Firm Application for '.com' Mark

*In re Sausser Summers, PC*, USPTO Application Serial No. 88626569, U.S. Patent and Trademark Office Trademark Trial and Appeal Board, Feb. 16, 2021

In its first decision on the registrability of "highlydescriptive.com" or "generic.com" marks since the U.S. Supreme Court's decision last summer in *U.S. Patent & Trademark Office v. Booking.com B.V.* (read our alert on *Booking.com* [here](#)), the Trademark Trial and Appeal Board tipped its hand, showing that it is likely to be hostile to the registration of these domains as marks, at least until a higher court instructs it differently. Specifically, the Board affirmed in a non-precedential decision the Examining Attorney's refusal to register ONLINETRADEMARKATTORNEYS.COM for "legal services," finding insufficient the inherent trait of any "highlydescriptive.com" or "generic.com" domain name to identify only one entity at a time and finding the purported mark "highly descriptive" of "legal services" (the applied-for services) and that the applicant law firm had not met the commensurately high threshold of evidence needed to show acquired distinctiveness.

### Key Takeaways:

- Absent supporting empirical evidence, public recognition of the fact that a domain name is owned by a single person or entity will not yet function as a proxy for secondary meaning.
- Significant questions will remain regarding the registrability of "highlydescriptive.com" or "generic.com" marks because both "Booking.com" and "Onlinetrademarkattorneys.com" were poor test cases.
- Acquired distinctiveness claims based on five years of substantially exclusive and continuous use are likely to fall short.

- The fact the Board identified the decision as non-precedential may signal that it is not confident the decision will stand.
- A post-decision statement by the applicant law firm strongly suggests that it will not appeal the Board's decision.

Law firm applicant Sausser Summers, PC, provides trademark-related legal services online. It began to use ONLINETRADEMARKATTORNEYS.COM in 2013 and applied to register it on the Principal Register in 2019 on the basis of acquired distinctiveness. The Examining Attorney rejected the application, finding the mark highly descriptive and the applicant's evidence of acquired (or secondary) meaning inadequate. The applicant appealed to the Board.

In affirming the Examining Attorney's refusal, the Board primarily focused on whether the applicant had demonstrated secondary meaning. The most notable portion of the decision, however, is the Board's treatment of the potential of ".com" (or any generic top-level domain) to generate secondary meaning by the mere fact that a domain name identifies only one entity at a

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time. The Board noted the Supreme Court’s observations in *Booking.com* that “only one entity can occupy a particular Internet domain at a time” and, given that, “consumers could understand a given ‘generic.com’ term to describe the corresponding website or to identify the website’s proprietor.” But it then dismissed the issue by conspicuously leaving the gTLD out of its discussion.

Specifically, the Board stated:

*But that holding does not answer the question of whether a particular mark, as a whole, is generic or, in this case, merely descriptive without secondary meaning. The fact that some consumers may recognize that the .com TLD in Applicant’s mark can identify only one entity at any one time has little probative value regarding the exclusivity of Applicant’s use of the mark as a whole, particularly in the face of the record evidence that multiple third parties describe their legal services as being provided by “online trademark attorneys.*

Beyond this, the Board looked at dictionary definitions of “online,” “trademark” and “attorneys”; eight third-party descriptive or generic uses of “online trademark attorneys” or similar terms by other law firms; and the applicant’s own touting of its online business model. It concluded that “on the scale ranging from generic to merely descriptive, ... ‘onlinetrademarkattorneys’ is much closer to being generic than merely descriptive, making it is [sic] highly descriptive of [applicant’s] ‘legal services.’” Given this conclusion, the Board opined that a commensurately high level of proof would be necessary to support a secondary meaning finding. Each element within the center aligned DIV inherits the center aligned style.

The Board then endorsed the Examining Attorney’s decision not to accept the applicant’s Lanham Act Section 2(f) claim that its mark had acquired distinctiveness through more than five years of substantially exclusive and continuous use. It also found that the applicant’s evidence supporting the acquisition of secondary

meaning was weak, flawed and, in one case, not credible. The disparaged evidence included unsworn testimonials that, almost uniformly, failed to mention the mark at issue; claims of “vast” advertising, prodigious sales and an extensive customer base that were largely unsupported by hard evidence and/or were unaccompanied by proof that they had led to consumer recognition of the mark; alleged intentional copying that appeared to be legitimate third-party descriptive use; and alleged unsolicited media coverage that either didn’t appear to be unsolicited or appeared to have originated with the applicant.

Several practical lessons emerge from this decision. First, claiming acquired distinctness based on five years of substantially exclusive and continuous use is highly likely to fall short. Applicants may still argue that, viewed in conjunction with the Supreme Court’s *Booking.com* decision, the public’s essentially universal knowledge of domain names’ technical fidelity to one master is a proxy for secondary meaning. However, since embracing this conclusion will be antithetical to decades of trademark policy and jurisprudence, applicants will have to support this argument with substantial empirical evidence. Finally, marketplace secondary meaning evidence must be robust and show how it has resulted in the mark’s actual acquisition of secondary meaning. This strongly counsels in favor of offering survey evidence.

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