Mattress.com Mark Upheld as Generic

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In re 1800Mattress.com IP, LLC (substituted for Dial-A-Mattress Operating Corp.), 586 F.3d 1359 US Court of Appeals for the Federal Circuit, 6 November 2009

Abstract

The refusal of the US TTAB to register Mattress.com as a trade mark was upheld on the ground that the mark was generic.

Legal context

Many businesses have obtained domain names that describe a product or service being offered for sale (eg www. mattress.com, www.lawyers.com, and www.hotels.com) and also wish to obtain trade mark protection for these domain names to prevent others from using these same marks to offer their products. *In re 1800Mattress.com IP, LLC*, 586 F.3d 1359 (Fed. Cir. 2009) presents a framework for the type of analysis the US Patent and Trademark Office ('USPTO') must follow to determine whether such marks may be registered.

Facts

Dial-A-Mattress Operating Corp. (the predecessor in interest of appellant 1800Mattress.com IP, LLC, collectively 'Dial- A-Mattress') applied to register the mark MATTRESS.COM in standard format for services described as 'online retail store services in the field of mattresses, beds, and bedding'. The trade mark examiner refused to register the mark on the basis that it was generic under 15 USC § 1091(c).

On appeal to the Trademark Trial and Appeal Board of the USPTO, the Board affirmed the examiner's refusal to register the mark. *In re Dial-A-Mattress Operating Corp.*, Serial No. 78976682, 2008 TTAB LEXIS 437 (TTAB 13 November 2008).

First, the Board found that the genus of services offered under the mark was online retail store services in the field of mattresses, beds, and bedding (id. at *3–*4). Next, it found that the term MATTRESS.COM would be understood by the relevant public primarily to refer to that genus. To support this conclusion, the Board focused on the word 'mattress' as identifying a key aspect of the offered services, and that it was thus generic for the offered services (id. at *4–*6). The Board also found that the addition of the top level domain extension '.com' did not affect the term's genericness (id. at *8–*12). The Board supported this conclusion by referencing several third party websites that were also online retail store services featuring

mattresses and/or bedding that had internet addresses ending in ‘mattress.com’ or contained ‘mattress’ and ‘.com’. Based on this evidence, the Board concluded that consumers would see MATTRESS.COM and would immediately recognize it as a term that denotes a commercial website rendering retail services featuring mattresses.

The Board also rejected other arguments that the addition of ‘.com’ evoked the words ‘comfort’ or ‘comfortable’ (id. at *13–*16).

The applicant appealed to the US Court of Appeals for the Federal Circuit. After the briefs on appeal were submitted, 1800Mattress.com IP LLC substituted for Dial-A-Mattress Operating Corp. as appellant.

Analysis

The Federal Circuit upheld the Board’s decision to refuse to register to the MATTRESS.COM mark as generic. In reaching this decision, the Federal Circuit reviewed the Board’s legal conclusions de novo, and its factual findings for ‘support by substantial evidence’. The determination of whether a particular mark is generic is a factual finding that is reviewed to assess whether it is supported by substantial evidence.

Since the Board’s decision was based on a finding that the mark in question was generic, the Federal Circuit began by stating that ‘[t]he critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question’, (In re 1800 Mattress. com, F.3d at 1362–63, quoting *H. Marvin Ginn Corp. v Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 989–990 (Fed. Cir. 1986)).

The Federal Circuit broke this issue into a ‘two-step inquiry’ as follows:

1. What is the genus of goods or services at issue?

2. Is the term sought to be registered or retained on the register understood by the relevant public primarily to referto that genus of goods or services?

Under this inquiry, it was undisputed that the genus of services was ‘online retail store services in the field of mattresses, beds, and bedding’. Thus, the issue addressed was whether the relevant public understands MATTRESS.COM to refer to online retailer store services in the field of mattresses, beds, and bedding.

In addressing this issue, the court noted that the mark must be considered as a whole. ‘Even if each of the constituent words in a combination mark is generic, the combination is not generic unless the entire formulation does not add any meaning to the otherwise generic mark’ (id. at 1363, quoting In re Steelbuilding.com, 415 F.3d 1293, 1297 (Fed. Cir. 2005)). Dial-A-Mattress took issue with the Board’s analysis as ‘erroneously look[ing] to the component parts of the mark MATTRESS.COM to find it generic, rather than looking at the mark as a whole’ (id. at

1362). The Federal Circuit rejected this contention. Although the Federal Circuit agreed that 'the Board considered each of the constituent words, "mattress" and ".com," and determined that they were both generic' (a finding not in dispute), nonetheless, '[t]he Board then considered the mark as a whole and determined that the combination added no new meaning, relying on the prevalence of the term "mattress.com" ... ' (id. at 1363). The Federal Circuit also found it appropriate for the Board to consider 'the prevalence of the term "mattress.com" in the website addresses of several online mattress retailers that provide the same services', concluding that, '[b]ecause websites operate under the term "mattress.com" to provide mattresses, and they provide them online, the Board properly concluded that the relevant public understands the mark MATTRESS.COM to be no more than the sum of its constituent parts, viz., an online provider of mattresses' (id.).

The Federal Circuit also rejected Dial-A-Mattress' argument that 'some of the websites containing "mattress.com" in their domain names do not actually sell mattresses online' as irrelevant since 'the fact that many of the websites do sell mattresses online supports the Board's conclusion that the term "mattress.com" is primarily used to identify services in the same genus as Dial-A-Mattress's services' (id. at 1364).

The Federal Circuit then rejected Dial-A-Mattress's argument that 'the mark MATTRESS.COM is not generic because the relevant public would not use the term "mattress.com" to refer to online mattress retailers' (id.). In response, the Federal Circuit explained that '[t]he test is not only whether the relevant public would itself use the term to describe the genus, but also whether the relevant public would understand the term to be generic' (emphasis in original) (id.).

Finally, the Federal Circuit rejected Dial-A-Mattress's argument that '.com' evoked a meaning of 'comfort' or 'comfortable' or that it is a mnemonic, since Dial-A-Mattress provided the Board with no evidence that would support the contention that the Board erred in this finding.

Practical Significance

The role that the internet plays in modern society and commerce cannot be understated. The value of a good domain name also cannot be understated. Trade mark law in the USA and elsewhere is meant to avoid confusion over sources of goods and services. Prohibiting any one competitor from obtaining a monopoly over any specific generic term is one check that is put in place to keep the marketplace playing field level. *In re 1800Mattress.com* sets forth a framework to assist trade mark lawyers in analysing whether this check is being appropriately applied.

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