

Oral Hearing Held:  
January 18, 2005

**THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF  
THE TTAB**

*Mailing Date:*  
*June 22, 2005*  
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re CT Realty Corporation

Serial No. 75841424

Jonathan Hyman and Jeffrey L. Van Hoosear of Knobbe, Martens,  
Olson & Bear LLP for CT Realty Corporation.

Fred M. Mandir, Trademark Examining Attorney, Law Office 105  
(Thomas G. Howell, Managing Attorney).

Before Hohein, Bucher and Drost, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

CT Realty Corporation has filed an application to register on the Supplemental Register the term "STORAGE OUTLET" as a service mark for "providing self-service storage facilities for general consumer and business use" in International Class 39.<sup>1</sup>

Registration has been finally refused under Section 23 of the Trademark Act, 15 U.S.C. §1091, on the ground that the

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<sup>1</sup> Ser. No. 75841424, filed on the Principal Register on November 5, 1999, based on an allegation of a bona fide intention to use such term in commerce; amended, by an amendment to allege use filed on September 4, 2001, to set forth a date of first use anywhere of March 1, 2000 and a date of first use in commerce of January 1, 2001; and further amended, by a paper received on March 4, 2003, to the Supplemental Register.

term "STORAGE OUTLET" is generic and hence is incapable of distinguishing applicant's services.

Applicant has appealed. Briefs have been filed and an oral hearing was held. We affirm the refusal to register.

It is well settled that a term must be capable of serving as an indicator of source in order for it to be registrable on the Supplemental Register. Whether a term has the capacity necessary for registration on the Supplemental Register is determined by considering, among other things, the meaning thereof as applied to the goods or services identified in the application, the context in which it is used on any specimens filed with the application, and the likely reaction to the term by the average customer upon encountering such term in the marketplace. See, e.g., *In re Cosmetic Factory, Inc.*, 208 USPQ 443, 447 (TTAB 1980). "The test is not whether the mark is already distinctive of the applicant's goods [or services], but whether it is capable of becoming so." *In re Bush Brothers & Co.*, 884 F.2d 569, 12 USPQ2d 1058, 1059 (Fed. Cir. 1989). However, as noted in *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 728 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986), if a term is generic, it is incapable of registration on the Supplemental Register.

Moreover, in the case of a term asserted to be incapable because it is generic, the burden is on the U.S. Patent and Trademark Office to show the genericness of the term by "clear evidence" thereof. *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987).

See also *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832, 1835-36 (Fed. Cir. 1999). In particular, as stated in *American Fertility Society*, 51 USPQ2d at 1836: "Aptness is insufficient to prove genericness"; instead, "the correct legal test, as set forth in *Marvin Ginn*, requires evidence of 'the genus of goods or services at issue' and the understanding by the general public that the mark refers primarily to 'that genus of goods or services.'" Specifically, as our principal reviewing court held in *Marvin Ginn*, 228 USPQ at 530:

Determining whether a mark is generic [and thus is incapable of distinguishing an applicant's goods or services] ... 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?

Such test, as further noted in *American Fertility Society*, 51 USPQ2d at 1837, "is to be applied to a mark, or disputed phrase thereof, as a whole, for the whole may be greater than the sum of its parts." In addition, in applying such standard, evidence of the relevant public's understanding of a term or disputed phrase may be obtained from any competent source, including newspapers, magazines, dictionaries, catalogs and other publications, as well as the Internet. See, e.g., *In re Northland Aluminum Products, Inc.*, 777 F.2d 1566, 227 USPQ 961, 963 (Fed. Cir. 1985); and *In re Leatherman Tool Group Inc.*, 32 USPQ2d 1443, 1449 (TTAB 1994).

Both applicant and the Examining Attorney agree, and we concur, that as to the first prong of the test for genericness, the class or category of services at issue herein is that which is set forth in the recitation of applicant's services, namely,

"providing self-service storage facilities for general consumer and business use." However, as to whether, under the second prong of the genericness test, the relevant public understands the term at issue herein primarily to refer to such class or category of services, applicant maintains in its initial brief that the evidence of record demonstrates that "consumers do not understand the mark STORAGE OUTLET primarily to refer to self-service storage facilities for general consumer and business use." Applicant asserts, with respect thereto, that "the words 'storage' and 'outlet,' either individually or combined, are not generic terms for Applicant's services," arguing that (underlining in original):

The word "storage" has several definitions previously made of record. Among these are: (1a) the act of storing goods or the state of being stored; (1b) a space for storing goods; (1c) the price charged for keeping goods stored; (2) the charging or regenerating of a storage battery or (3) the part of a computer that stores information for subsequent retrieval. *The American Heritage Dictionary of the English Language*, Fourth Edition. Likewise, the word OUTLET also has several definitions. Among these are: (1a) a passage for escape or exit; a vent; (1b) [a] means of release or gratification, as for energies, drives, or desires; (2) a stream that flows out of a lake or pond; (3) a store that sells the goods of a particular manufacturer or wholesaler; (4) a receptacle that is connected to a power supply and equipped with a socket for a plug. *Id.* Typically, consumers hearing the word OUTLET would think of an electrical socket or a discount shopping mall. Applicant submits that the words STORAGE and OUTLET are commonly used and understood to refer to any of these possible meanings. In light of these other commonplace definitions for the words STORAGE and OUTLET, Applicant submits that consumers would not primarily associate the words

"storage" and "outlet" primarily with Applicant's self-service storage facilities.

As additional support for its position, applicant points out that it made of record, by a response it filed on November 13, 2003, "printouts from websites of ... third[-]party companies in the self-storage industry."<sup>2</sup> Such companies, applicant insists, "advertise storage services ... which are nearly identical to Applicant's services, but [they] refer to these services as 'self-storage facilities,' 'self-storage [mini] warehouses,' and simply 'self-storage.'" Examples thereof, applicant notes, are as follows (emphasis added):

"National Self Storage (NSS) is a leading provider of clean, safe, flexible and affordable **self-storage mini warehouses**. We bring superior quality and value to every facet of the **self storage** business, making your rental experience simple! In an effort to maintain our commitment to excellence, our convenient new on-line services make renting storage space easier than ever! Customers can now make their payments and check for availability and pricing of mini-storage space on line at any of the NSS properties nationwide!

There IS a Difference!

National Self Storage has been developing and operating **self-storage facilities** from the beginning of the **self storage industry**." -- [www.nationalself-storage.com](http://www.nationalself-storage.com); and

"Eliminate clutter in your home, store or office. Don't miss a good buy on business or personal items because you lack storage space. A Storage Depot will rent you just the amount of space for the time when you need it ....

....

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<sup>2</sup> Whether any of the websites were in use prior to applicant's alleged first use of the term "STORAGE OUTLET" is not apparent, however.

**Self Storage Facility** Locations [and]  
**Self Storage Unit** Dimensions" -- [www-membrane.com/philanet/mkee/storage.html](http://www-membrane.com/philanet/mkee/storage.html).

Similarly, applicant notes that with its November 13, 2003 response it also submitted "printouts from websites which provide directories to assist consumers in comparing and finding storage facilities." Two examples of such, applicant observes, are as follows (emphasis added):

**"Self Storage: Public, Mini and Self Storage Facilities**

All-Moving.com makes it easy to find and compare **self storage facilities including mini storage and public storage.**" -- [www.all-moving.com/storage\\_quotes.html](http://www.all-moving.com/storage_quotes.html);

**"Self Storage California**

A California **Self Storage** Directory

....

Ineedstorage.com is a Free Directory of **Self Storage Facilities** in California" -- [www.ineedstorage.com](http://www.ineedstorage.com); and

"selfstorage.com

The Internet's Premier **Self Storage** Website

Renters Click Here to Find a **Self Storage Facility** Near You Now ....

....

ARGUS Self Storage Sales Network The easy way to buy and sell **Self Storage facilities.**" -- [www.selfstorage.com](http://www.selfstorage.com).

A third example, although not mentioned by applicant, is entitled "GUIDE TO SELF-STORAGE" and provides, *inter alia*, as follows (emphasis added):

"So, just what is **self-storage**? **Self-storage** offers both personal and business users a storage solution that they can basically control themselves. As with more traditional storage methods, self-storage allows you to rent storage space where you can keep goods and belongings in specialist facilities. .... With the advent of **self-**

**storage**, we've been given a lot more choice: It's 'Do It Yourself' storage.

Recognizing that many consumers and businesses need more control over what, where, when and how they store the **self-storage industry** has evolved into a cost-effective, flexible and secure storage alternative. The **self-storage space** you rent will be self-contained and fully enclosed and can vary in size according to your specific needs - you could be looking at as small a space as a closet through to a unit big enough to store your boat, the entire contents of your house or extensive business archives.

This is an incredibly flexible storage alternative. .... In many cases you can simply drive up to your **self-storage unit** and park outside. .... And, unlike traditional storage methods, you'll know that your **self-storage unit** will stay where it is and your stuff won't be moved around by the storage provider without your permission.

If your looking to use **self-storage** the first difference you'll notice is that it's your responsibility to get your stuff to the **self-storage facility**. ....

....  
As the **self-storage industry** has evolved so has the range of services on offer. Larger **self-storage facilities** have started to offer business services such as office space, administrative services, meeting areas and toilet/shower rooms." -- [www.self-storage-facilities.com](http://www.self-storage-facilities.com).

Applicant contends, in view thereof, that it is "[e]vident from these examples ... that 'OUTLET' is not synonymous with the words 'facilities,' 'warehouses,' or 'units.[']" In addition, with respect to the "SSA SELF STORAGE ASSOCIATION" logo appearing in the above-referenced excerpt from the "[www.nationalselfstorage.com](http://www.nationalselfstorage.com)" website, applicant asserts-- although notably without any evidentiary support--that:

[T]he trade association that serves the self-storage industry is known as the "SSA Self Storage Association." Based on the

website of the SSA, the SSA is "the only trade association serving those in the self storage industry across the U.S. and around the globe." Applicant notes that this sole trade association, which supports and strives to enhance business practices in the industry, and which would certainly want a name representative of the industry, is known as "Self Storage Association," not as "Storage Outlet Association."

Thus, according to applicant:

The usage[s] by those in the relevant industry demonstrate that the terms "storage outlet" are not used generically to refer to Applicant's services. If the words "storage outlet" were understand [sic] to be the primary designation for Applicant's services, then the other descriptors that are used, "facilities," "warehouses," etc., would be generically replaced with "storage outlet." But this is not the case.

As to certain other evidence which it has made of record, applicant points out that:

Applicant also submitted two articles in its November 13, 2003 Response, one [of] which appeared in the *Los Angeles Times* and the other in *California Real Estate Journal*, [which are] about the self-storage industry. These articles discuss the industry generally and mention Applicant, as well as other companies in the industry. Applicant directs the Board's attention to the fact that both articles consistently refer to Applicant's class of services in the self-storage industry as "self-storage centers," "storage facilities" and "self-storage facilities." Not once does either staff writer refer generically to these services as "storage outlets." Applicant submits that the usage of terms and phrases by these staff writers are reflective of the usage of the purchasing public. The Examining Attorney must agree since his evidence supporting his conclusion is also composed of news articles written by staff writers. From these articles, it is clear that the consuming public and those not directly involved in the relevant trade generically refer to Applicant's services as

"self-storage centers" and "storage facilities," but not "storage outlets."

Representative portions of the above-noted articles are reproduced below (emphasis added):

"People stick all kinds of junk into **self-storage centers**. Now, many centers are becoming junk themselves.

In an example straight out of Economics 101, supply is not outstripping demand in the **self-storage industry**, dragging down a business that once seemed practically recession-proof.

....  
Across the country, the number of **storage facilities** has shot up by more than 60% in the last decade .... There are about 6,000 **storage centers** statewide, with more than half of them in Southern California.

....  
'We are going to play conservatively,' said Lance Watkins, head of **Storage Outlet**, which operates a small chain in Southern California." -- Los Angeles Times, September 26, 2002; and

"Some people who are looking for stable real estate investments are putting their trust into storage--**self storage**, that is. Though far from glamorous, the **self-storage business** is proving attractive to investors and is one of the few sectors driving development in Southern California.

CT Realty Corp. ... is a case in point. CT ... has launched two **self-storage** investment funds since late 2000 and is making plans to for a third fund.

According to President Robert T. Campbell, most of CT's **self-storage facilities** are in urban markets that have had little new development of such product.

....  
Lots of small businesses ... warehouse their extra inventory in **self-storage spaces**  
....

Records storage also represents a tidy customer base for **self-storage firms**. Many law firms and medical practices would rather archive their files in **storage facilities** than in high-rent office space, for example.

....  
CT brands its **self-storage facilities** under the name **Storage Outlet**. The company opened its first Storage Outlet last year

....  
The majority of CT's storage tenants are individuals, although it does have some facilities with a high percentage of commercial clients. The trade area for **self-storage facilities** is confined to a fairly tight, three-mile radius.

....  
Additionally, while cities view **self-storage** as an industrial use, the properties function more like a retail business, with heavy requirements in terms of marketing and onsite management." -- California Real Estate Journal, August 19, 2002.

With respect to "[f]urther evidence that consumers do not understand Applicant's mark to generically refer to its services," applicant points to "the fact that there is no category for 'storage outlet' or 'storage outlets' in the yellow pages." Specifically, applicant notes that:

Applicant submitted with its Response of November 13, 2003 copies of the relevant pages from several local [California] yellow pages and Internet nationwide yellow pages which show the absence of a category of services known as "storage outlet." There is simply no such class of services. There is, however, a category known as "STORAGE-SELF SERVICE" which consistently appears in yellow pages.

Applicant urges, in view thereof, that "if Applicant's mark was understood to generically designate Applicant's services, a category known as 'storage outlets' instead of 'storage-self service' would exist in yellow pages because consumers would refer to such a category to find providers of storage services, like Applicant's services."

Applicant insists, moreover, that its "position is further strengthened by the fact that 'storage outlet' is commonly used to refer to specific things other than Applicant's type of services," pointing out that:

Applicant has submitted Internet evidence with its Responses filed on February 28, 2003 and November 13, 2003 to demonstrate that 'storage outlet' does refer to drainage associated with water, something of an outflow accumulation of water. For example, in these printouts, "storage outlet" refers to: (1) a passage for stored water, (2) drainage of excess stormwater, (3) release of water from water storage structures, and (4) discharge of sewer wastewater. Other Internet printouts in Applicant's Responses demonstrate that, among other things, "storage outlet" is used to refer to storm drain pipes and gas containers.

Applicant contends, in view of the fact that "[i]n none of these Internet printouts are the words 'storage outlet' used to refer to a class of self-service storage facilities," that "its mark STORAGE OUTLET is not a generic designation for its services and is capable of functioning as a trademark to distinguish Applicant's services."

Finally, as to the evidence of genericness offered by the Examining Attorney (which is specifically discussed later in this opinion), applicant maintains that the Examining Attorney has failed to meet his burden of showing that "the consuming public primarily considers the mark STORAGE OUTLET to refer to Applicant's type of services." In particular, applicant contends that:

[M]ore than half of the ... evidence upon which the Examining Attorney relies is immaterial. In the Office Action mailed March 6, 2001, the Examining Attorney relied

upon seventeen "stories" from the Lexis/Nexis database which allegedly support the Examining Attorney's position. Of these seventeen stories, nine of the references refer to a "self-storage outlet," not a "storage outlet." There is also a reference to a "cold-storage outlet" among these seventeen articles. More than half of the evidence in the ... Office Action did not support the Examining Attorney's finding.

In the Office Action mailed September 3, 2002, the Examining Attorney included three additional printouts from the Internet as evidence of the descriptive nature of Applicant's mark. Of these three printouts, two refer to "self-storage outlets" and "self storage outlets." As Applicant's mark is neither SELF-STORAGE OUTLET nor COLD-STORAGE OUTLET, Applicant's submits that this evidence is inapplicable.

In the final Office Action concerning genericness, issued January 30, 2004, the Examining Attorney attached dictionary definitions for "storage" and "outlet" and specifically referenced the definition ... "showing that 'outlet' is defined as: 'a commercial market for goods or services' or a 'market for services or goods.'" Applicant respectfully submits that the Examining Attorney's reference to "a commercial market for goods or services" is completely inapposite. The definition for outlet to which the Examining Attorney refers is clearly that of a shopping mall outlet, a huge conglomeration of typically high-end stores offering their goods at discounted prices, often times located in remote areas. Even the specific example for "market for services or goods" identified in the Examining Attorney's dictionary printout is "retail outlets." Applicant's services are not retail outlets and [it] do[es] not commercially market any goods or services, or provide a market for the sale of goods or services. And yet, by this definition, the Examining Attorney states that "[t]he evidence of record and applicant's identification of services show that the services Applicant provides are storage outlet services."

In addition, applicant argues with respect to the ten or so "'stories' from ALLNEWS" included with the final Office Action issued January 30, 2004 that, in the case of "the first story listed, the use of 'storage outlet' does not refer to self-storage facilities" and, instead, "actually discusses storage outlets for natural gas liquid." Similarly, applicant insists, the "fourth story ... uses the term 'storage outlet' to refer to something other than Applicant's class of services." In particular, applicant notes, such "article discusses a 'funky, retro-inspired ottoman [that] ... can double as a storage outlet.'" Applicant also observes that:

Of the remaining 8 stories, four are from foreign news articles, 2 from Australia, 1 from New Zealand and one concerning Sharjah in the Gulf. Applicant submits that the issue of genericness should be proven by evidence from the United States and not from international sources. Although the Board has ... held that it "is reasonable to assume that professionals in medicine, engineering, computers, telecommunications and many other field are likely to utilize all available resources, regardless of country of origin or medium," ... the mark and services at issue here do not involve sophisticated technology in the scientific fields which could benefit from foreign sources of research. *In re Remacle*, 66 USPQ2d 1222, 1224 n.5 (TTAB 2002). U.S. consumers in need of Applicant's services are not likely to refer to foreign news articles in a way that would influence their understanding of Applicant's mark.

Because, "[a]s mentioned above, the Examining Attorney's foreign articles should carry no weight on whether U.S. consumers would find the term 'storage outlet' to be generic for Applicant's services," applicant further contends that:

As a result, the Examining Attorney has only four U.S. articles which remain to

support his finding. Applicant submits that this evidence falls short of meeting the Examining Attorney's burden. .... The Examining Attorney has offered no argument to discredit Applicant's evidence that ["]storage outlet["] is not used by the industry or consumers to generically refer to Applicant's services, and that it can refer to other things. Nor does the totality of the Examining Attorney's evidence amount to a clear and substantial showing to meet the rigorous evidentiary burden of genericness.

Applicant, citing *In re Bel Paese Sales Co.*, 1 USPQ2d 1233, 1236 additionally points out that "[d]oubts are resolved in favor of the applicant when the generic status of a term is in doubt."

Applicant concludes, in view of the above, that "its mark has the capability of distinguishing its services" and is therefore registrable on the Supplemental Register. Applicant stresses, in particular, that:

Applicant's competitors recognize Applicant and its services by the mark STORAGE OUTLET, [as] evidenced by the fact that Applicant's competitors do not refer to themselves as a storage outlet. The consuming public, and those who write for the consumer public, also recognizes [sic] the mark STORAGE OUTLET as referring to Applicant's services.

The Examining Attorney, on the other hand, maintains in his brief that (emphasis in original):

The evidence of record viewed in conjunction with applicant's identification of services shows that Applicant provides storage outlet services. The proposed mark "STORAGE OUTLET," is generic as applied to applicant's services, because applicant's services **encompass** the service of "providing self-service **storage outlet** facilities. Applicant's services are identified as "providing self-service storage facilities for general consumer and business use." When the well known term "storage outlet" is applied to applicant's services, it merely

identifies the **type** of self-service storage facilities provided by applicant, as self-services **storage outlet** facilities.

In support of his position, the Examining Attorney insists that the record contains "numerous stories obtained from the Lexis/Nexis ALLNEWS database, and promotional matter obtained from an on-line search, which show generic usage of the term 'storage outlet' in [the] field of providing self-service storage outlet facilities."

Examples of the above evidence, which are specifically mentioned by the Examining Attorney, are as follows (emphasis added) :

"Sick of storage facilities that don't measure up[?] Many self **storage outlets** [that] adequately cater for residential tenants overlook the special needs of removalists.

At The Storage Factory however, we have recognized these special needs and have designed our facility to make life easier for removalists. Saving you ... time and money." -- [www.thestoragefactory.com.au/removalist-.com](http://www.thestoragefactory.com.au/removalist-.com), August 8, 2002;

"Katz will exclusively handle national and regional real estate transactions for Storage Mall. Storage Mall redevelops space for self-storage, thereby creating a new source of revenue from otherwise unused space. ... Storage Mall will take awkward or poorly located space[s] that are not appropriate for other retail or commercial uses to turn into **self-storage outlets**." -- [www.katzassociates.com/June2000.html](http://www.katzassociates.com/June2000.html), August 8, 2000;<sup>3</sup>

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<sup>3</sup> Likewise, while not referred to by the Examining Attorney, we observe that the record contains an excerpt from an article which, in relevant part, reports that (emphasis added):

"[Storage Mall] will take awkward or poorly located spaces that are not appropriate for other retail or commercial uses to turn into **self-storage outlets**." -- [Real Estate Weekly](#), June 21, 2000.

"[Cinergy] Corp., has won a contract to provide utility cost reduction services to Storage USA, a chain of 485 **self-storage outlets** in 31 states." -- Cincinnati Enquirer, February 5, 1999; and

"'One of the greatest attributes of public warehousing is an ability to offer flexible **storage outlets** for inventory and let a company maneuver its goods to meet the present demand,' said Jerry Latham ...." -- St. Louis Post-Dispatch, July 9, 1990 (article headlined: "SITTING PRETTY: WAREHOUSES FILL THE GAP FOR BUSINESS").

Other pertinent examples of record, we note, include the following (emphasis added):

"You might put it in a storage locker. The FBI has thought of that, and has been flashing Johnson's mug at **self-storage outlets** between Florida and North Carolina." -- Charleston Daily Mail, July 28, 1997, and Palm Beach Post, July 28, 1997;

"[He] slowly built on the modest air-conditioning business his father started in a nondescript building amid the **self-storage outlets** and muffler shops in western Orange County." -- Palm Beach Post, November 9, 1996;

"Thomas said the **self-storage outlet** has 24-hour surveillance cameras monitoring more than 8,000 square feet of climate-controlled storage space." -- Times-Picayune (New Orleans), October 29, 1995;

"The same day, detectives searched a compartment at a Granada Hills **storage outlet** from which they had witnessed Voorhees remove a package in October. There they found hundreds of more boxes and bottles of steroids." -- Los Angeles Times, March 19, 1992;

"The chase started after deputies saw a man acting suspiciously outside a **self-storage outlet** in Spring Valley, Morse said."

-- San Diego Union-Tribune, March 7, 1988;  
and

"In 1979 there were only about 3,500 miniwarehouses. Today there are an estimated 18,000 **self-storage outlets**, with over 900 million square feet of space and gross revenues of about \$4 billion." -- Forbes, June 15, 1987.

In addition, we observe that the Examining Attorney has made of record the following definitions from The American Heritage Dictionary of the English Language (3d ed. 1992). Specifically, "storage" is defined in relevant part as "**1. a.** The act of storing goods or the state of being stored. **b.** A space for storing goods" and "outlet" is listed as meaning, in pertinent part, "**3. a.** A commercial market for goods or services. **b.** A store that sells the goods of a particular manufacturer or wholesaler." Based thereon and the other evidence which he has made of record, the Examining Attorney concludes that, contrary to applicant's assertions:

Consumers will easily understand the generic meaning of the proposed mark as applied to applicant's services. *In re Polo International Inc.*, 51 USPQ2d 1061 (TTAB 1999) (Board found that DOC in DOC-CONTROL would be understood to refer to the "documents" managed by applicant's software, not "doctor" as [applicant contended]).

Applicant, in reply, reiterates its criticism of the evidence provided by the Examining Attorney, arguing among other things that "the Examining Attorney has failed to demonstrate by a substantial showing of evidence that the consuming public primarily considers the mark STORAGE OUTLET to refer to

Applicant's type of services." Specifically, applicant notes that (underlining in original):<sup>4</sup>

In the Examining Attorney's brief, he states that there are "numerous stories" of record which show generic usage of the term "storage outlet" as applied to Applicant's services. To support his determination of genericness, the Examining Attorney has provided a total of 30 Lexis/Nexis news stories. However, as Applicant demonstrated in its principal brief, more than half of these stories are irrelevant. As a result, the Examining Attorney is left with less than 15 total articles to support his position of genericness.

The standard most often applied to determine whether a mark is generic is not whether it has "some" significance to the public as the name of the services at issue, but whether it is the mark's principal significance. ....

Although the evidence of record is not a direct consumer survey of the public, Applicant submits that the evidence of record (stories from the media and third[-]party uses), is akin to a survey of the public's understanding of Applicant's mark. Applying

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<sup>4</sup> We observe, however, that while applicant also states in its reply brief that the term "'storage outlet' does not appear in the [*Acceptable Identification of Goods and Services*] Manual, and there is not one single registered mark which lists 'storage outlet' as its description of services," such statement is simply unsupported argument inasmuch as the record contains no evidence which pertains thereto and the Board does not take judicial notice of third-party registrations. See, e.g., *In re Duofold Inc.*, 184 USPQ 638, 640 (TTAB 1974). Moreover, while it is settled that the Board may properly take judicial notice of standard reference works, see, e.g., *In re Hartop & Brandes*, 311 F.2d 249, 135 USPQ 419, 423 n. 6 (CCPA 1962); *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 860 n. 7 (TTAB 1981), we note that even if we were to take judicial notice of the fact that the term "storage outlet" apparently does not appear in the electronic version of what is officially known as the Trademark Acceptable Identification of Goods and Services Manual, it is interesting that such manual does list, as an acceptable recitation of services, the following entry: "Retail outlets featuring {indicate specific type or field}."

the "majority controls" standard to the Examining Attorney's already limited evidence, certainly the Examining Attorney has not demonstrated that a majority of the public regards Applicant's mark as the generic term for Applicant's services.

Applicant's services are not unique, and in fact are very commonplace. If Applicant's mark were truly a generic term for Applicant's services, one would expect there to be a plethora of evidence to support the Examining Attorney's finding. However, the Examining Attorney's evidence of record is very, very scant. At least, it seems that the Examining Attorney could have shown that "storage outlet" is used by the U.S. Trademark Office in the *Acceptable Identification of Good[s] and Services Manual*, or by third[-]party registrants in their description of services to refer to Applicant's type of services. ....

The Examining Attorney has not met his burden of proving genericness. Therefore, any doubt should be resolved in favor of Applicant. In re Volvo White Truck Corp., 16 USPQ2d 1417, 1421 (TTAB 1990).

Furthermore, applicant repeats its assertion that "much of the Examining Attorney's evidence is not relevant to Applicant's services of 'providing self-service storage facilities for general consumer and business use.'" In particular, although evidentiary support for its argument has notably not been provided, applicant insists with respect to "an article from the St. Louis Post-Dispatch" that (underlining in original):

Applicant retrieved the full text of this article and discovered that the "flexible storage outlets" referred to in the article are not Applicant's type of "self-service storage facilities." Instead[,] the article actually discusses a type of public warehousing service that serves as the extended warehouse for a retail store or the distribution arm for a company. Unlike

Applicant's public self-storage facilities where consumers simply rent space, retain a key and lock up their goods for storage, the public warehouses discussed in this article operate as extensions of retail businesses. .... Typically, contract warehouses are single warehouses working for single companies. However, the public warehouses discussed in the Examining Attorney's article act as giant consolidated contract warehouses with building space and dedicated employees that can operate for numerous businesses. Instead of businesses operating their own private warehouse for inventory pick-up and distribution, business[es] can outsource their private warehousing needs to those public warehouses that can monitor inventory, receive shipments and distribute products .... Clearly, these public warehousing services discussed in the Examining Attorney's "evidence" are not the type of services offered by Applicant. Again, the Examining Attorney has not applied the rule that the determination of whether a mark is generic is considered in relation to the identified services.

Upon consideration of the arguments and relevant evidence presented, we find that the record contains clear and sufficient evidence that the term "STORAGE OUTLET" is generic and, hence, is incapable of distinguishing the category or class of applicant's services at issue herein--namely, "providing self-service storage facilities for general consumer and business use." In particular, as to the second and dispositive step of the inquiry required by *Marvin Ginn*, which is whether the relevant public understands the term "STORAGE OUTLET" to refer primarily to the category or class of services at issue, we find that such term would be so understood. Contrary to applicant's assertion that the words "storage" and "outlet" individually "are not generic terms for Applicant's services," it is obvious in light of just the dictionary definitions thereof that the former

names a category or type of self-service storage facilities for general consumer and business use while the latter designates a category or type with respect to how such facilities are provided to the relevant public in the market for storage facilities. Plainly, in the context of applicant's services, the term "storage" would be immediately perceived as meaning "[a] space for storing goods" and the term "outlet" would likewise be understood as signifying, in general, "[a] commercial market for goods or services" or, more specifically, "[a] store that sells the goods of a particular manufacturer or wholesaler."<sup>5</sup> Here, notwithstanding applicant's protestation in its initial brief that its "services are not retail outlets and [it] do[es] not commercially market any goods or services, or provide a market for the sale of goods or services," it is clear from the evidence of record that applicant's services consist essentially of the retailing of storage space.

Specifically, the various self-storage facilities which applicant commercially develops are basically utilized by applicant to sell, at the retail level, to general consumers and businesses through leasing arrangements, its own "goods," which consist of storage spaces or units in the self-service storage facilities which it provides as part of its services. As stated

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<sup>5</sup> We judicially notice, in this regard, that Webster's Third New International Dictionary (1993) at 1602 defines "outlet" in relevant part as "**3 a** : a market for a commodity ... **b** : a retail store <chain ~s> <discount ~s> <mass ~s> <goods usually bought on impulse are located at high traffic points within the ~ ...>." Similarly, as a further example, The Random House Dictionary of the English Language (2d ed. 1987) at 1375 lists "outlet" as meaning in pertinent part "**5**. a store, merchant or agency selling the goods of a particular wholesaler or manufacturer."

in the advertising literature which applicant made of record (emphasis in original):

Storage Outlet is a division of CT Realty Corporation, based in Newport Beach, Calif. The company has developed more than 5,000 storage units since its inception in 1999 and is well on the way to reaching its business goal of opening **20 self-storage facilities by 2005.**

The Storage Outlet facilities are developed on either leased land or free land. Property types range from new construction to conversions of existing structures into self-storage facilities. Storage Outlets run the gamut from modular storage units to two- and three-story constructed facilities.

The storage facilities depicted in such advertising show, in each instance, what appears to be a rental office through which consumers may obtain a lease to a self-storage unit. Moreover, as noted in the excerpt from California Real Estate Journal reproduced earlier herein, "while cities view self-storage as an industrial use, the properties function more like a retail business, with heavy requirements in terms of marketing and onsite management." Thus, given the manner in which services such as those provided by applicant are typically rendered, general consumers and business customers, who obviously constitute the relevant purchasing public for applicant's self-storage facilities, would regard such facilities as outlets which sell or provide storage spaces or units. The term "STORAGE OUTLET" thus plainly designates a category or class of self-service storage facility services and, as explained below, the relevant examples of third-party use of such designation are

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sufficient to confirm that its primary significance to the purchasing public is that of a generic term.

Contrary to the thrust of applicant's arguments, the Examining Attorney need not establish that "STORAGE OUTLET" is the sole or most frequently used generic term for applicant's services; rather, he need only show that such term is a generic term. It is settled in this regard that (*italics in original*):

[A] product [or service] may have more than one generically descriptive name. .... All of the generic names for a product [or service] belong in the public domain.

In re Sun Oil Co., 426 F.2d 401, 165 USPQ 718, 719 (CCPA 1970) (Rich, J., concurring). See also Roselux Chemical Co., Inc. v. Parsons Ammonia Co., Inc., 299 F.2d 855, 132 USPQ 627, 632 (CCPA 1962) ("there is no legal foundation ... that a product has only one [generic or] common descriptive name"); In re Eddie Z's Blinds & Drapery Inc., 74 USPQ2d 1037, 1042 (TTAB 2005) ("that there may be other generic terms that are functionally equivalent to [the term at issue] ... does not make that term any less generic"); Continental Airlines Inc. v. United Air Lines Inc., 53 USPQ2d 1385, 1394 (TTAB 1999) ("[i]t is important to note that there is usually no one, single and exclusive generic name for a product or service. Any product or service may have many generic designations"); and In re Recorded Books Inc., 42 USPQ2d 1275, 1281 (TTAB 1997) ("[i]n indeed, a product may have more than one generic name"). Thus, instead of demonstrating that the term "STORAGE OUTLET" is not generic for the services of "providing self-service storage facilities for general consumer and business use," applicant's examples of third-party usage of such terms as

"self-storage facilities," "self-storage mini warehouses," "self-storage centers," "self-storage unit," "self-storage space" and just "self-storage" simply confirm that there are a multiplicity of terms which generically designate services of the kind offered by applicant and identified in the application for registration.

Moreover, in view thereof, the absence from the limited number of yellow page directories submitted by applicant of a class or category of services listed under the term "STORAGE OUTLET" is not persuasive evidence that such term is not generic for applicant's services. The fact that, as applicant has observed, the record shows only "a category known as 'STORAGE-SELF SERVICE' which consistently appears in yellow pages" simply does not mean that no other term is generic for the services of providing self-service storage facilities for general consumer and business use. If such were not the case, then applicant's evidence of the absence of a listing of any terms other than "STORAGE-SELF SERVICE" would mean that the primary significance of such terms as "self-storage facilities" or "self-storage centers," which applicant admits are generic for its services, are not in fact understood by the relevant purchasing public as naming the category or class of services marketed by applicant. Similarly, if the record contained evidence showing, as contended by applicant, that the sole trade association for the self-storage industry is known by the name "Self Storage Association," such evidence would not serve to eliminate the possibility of there being another term or even several other terms which the

relevant purchasing public would consider to be generic for services of the kind offered by applicant.

Moreover, having considered applicant's argument that the particular examples, as set forth above, of various terms which it made of record are relevant to the issue of genericness, we likewise have considered the Examining Attorney's evidence of third-party usage of the term "self-storage outlet" (along with such usage of the term "storage outlet") for services of the type set forth in the application and provided by applicant.<sup>6</sup> The issue herein is whether or not the term "STORAGE OUTLET" has been shown by clear and sufficient evidence to be generic for applicant's services. Therefore, if, as applicant contends, usage of various terms consisting of "self-storage" (or "self storage") followed by what applicant concedes are generic designations (e.g., "facilities," "mini warehouses," "centers," "unit" or "space") for services of the kind which it renders is evidence that the designation "STORAGE OUTLET" is not generic, then it necessarily is also the case that usage of the term "self-storage outlet" (like "self storage outlet") is evidence that such designation is generic for applicant's services, since the latter term plainly designates "storage outlet" services which can be utilized by one's self.

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<sup>6</sup> While the record reveals that, when used in print, it is not uncommon for the term "self-storage" to be hyphenated, we find that the presence or absence of a hyphen therein has no bearing on whether the usage thereof in connection with another word would be considered generic by customers for self-service storage facility services.

In a similar vein, while applicant insists that the examples which it made of record showing usage of the term "storage outlet" in contexts other than that of providing self-service storage facility services constitute additional relevant evidence that the term "STORAGE OUTLET" is not generic for the services recited in its application, applicant criticizes as irrelevant the two instances in which the Examining Attorney made of record excerpts which mention such term in the contexts of, respectively, natural gas liquid and a piece of furniture. Suffice it to say that although, as argued in applicant's initial brief, such evidence of usage in other contexts "bolsters Applicant's argument that 'storage outlet' can refer to many things other than Applicant's services," the fact that such term may also be descriptive, if not generic, with respect to other goods and/or services does not foreclose its being generic in the context of applicant's self-service storage facility services. Accordingly, while we have given no weight to such evidence in the case of the two excerpts furnished by the Examining Attorney, we have given only very limited probative value to the similar evidence submitted by applicant.

We fully agree with applicant, however, that in this case the several excerpts from foreign sources which the Examining Attorney included in the of record are without probative value with respect to whether "STORAGE OUTLET" is a generic term for applicant's services. Although the Board has recently, as applicant correctly points out, liberalized its practice and currently considers articles from foreign websites

and publications to have a bearing on issues of descriptiveness and genericness where the term at issue concerns fields such as medicine, engineering, computers, telecommunications and other highly sophisticated scientific or technical specialties which commonly make research reference to foreign sources of information pertaining thereto, this case plainly does not involve such circumstances. Compare In re Cell Therapeutics Inc., 67 USPQ2d 1795, 1797-98 (TTAB 2003) and In re Remacle, supra, with In re Men's International Professional Tennis Council, 1 USPQ2d 1917, 1919-20 (TTAB 1986) and in In re Bel Paese Sales Co., supra at 1235. Moreover, the record indicates, as set forth in the previously noted excerpt from California Real Estate Journal, that "the trade area for self-storage facilities is confined to a fairly tight, three mile radius." Because services of the kind rendered by applicant are so extremely localized in terms of their customer base, it is highly unlikely that consumers would refer to articles about such services which are from foreign sources. Due to the lack of relevance thereof to customers in the United States, we consequently have given no consideration to those excerpts made of record by the Examining Attorney which are from foreign publications.

Nonetheless, we disagree with applicant's contention that the Examining Attorney has failed to meet his burden of showing genericness. While, like applicant, we would not characterize the number of "NEXIS" and Internet excerpts offered by the Examining Attorney to be "numerous," we find that the record contains sufficient examples of third-party usage of the

term "STORAGE OUTLET" which clearly evidence that the primary significance of such term to the relevant purchasing public for applicant's services is to refer to a category or type of services which involve providing self-service storage facilities for general consumer and business use.<sup>7</sup> Specifically, the "NEXIS" and Internet excerpts sufficiently make plain that a "STORAGE OUTLET" would be understood by customers as a generic name for a facility which sells self-service storage space. The relevant excerpts furnished by the Examining Attorney are unambiguous in their manner of usage of such term as a reference to a kind of self-service storage facility, with most of the articles notably predating not only the dates of first use claimed by applicant but also the filing date of the application. Of the other evidence in the record, only two excerpts, along with the several examples of applicant's advertising, utilize the term "STORAGE OUTLET" in a service mark manner and such instances all appear to be subsequent to both applicant's claimed dates of first use and the filing date of the application.

This record, therefore, does not present the "mixture of usages" of the type which precluded a finding of genericness

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<sup>7</sup> We have considered, in this regard, the St. Louis Post-Dispatch excerpt since, notwithstanding applicant's unsubstantiated assertion that such excerpt is irrelevant because the "public warehousing" and "flexible storage outlets" referred to therein are not the type of self-service storage facilities which applicant actually operates, it appears from the context of the article that the services mentioned therein fall within the recitation of applicant's services, namely, "providing self-service storage facilities for general consumer and business use." Nevertheless, even if such excerpt were to be excluded from consideration, it would not alter our conclusion that the Examining Attorney has provided evidence adequate to clearly demonstrate genericness.

in *Merrill Lynch*, 4 USPQ2d at 1143. Instead, the record shows clear evidence of third-party usage of the term "STORAGE OUTLET" as a generic name for providing self-service storage facilities for general public and business use. Such usage, as applicant concedes, "is akin to a survey of the public's understanding of Applicant's mark" and suffices to prove, as required by *American Fertility Society*, 54 USPQ2d at 1837, that the term "STORAGE OUTLET" "as a whole ... has acquired no additional meaning to the relevant public than," as shown by the pertinent dictionary definitions thereof, the terms "storage" and "outlet" would "have individually." Because the primary significance of the term "STORAGE OUTLET" would accordingly be understood by the relevant public to refer to a category of class of providing self-service storage facilities for general consumer and business use, such term is a generic term for applicant's services and is therefore incapable of registration on the Supplemental Register.

**Decision:** The refusal under Section 23 is affirmed.