UNITED STATES: TTAB Gives Thumbs Up to Trek’s THUMBDRIVE Mark

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The Trademark Trial and Appeal Board (TTAB) reversed the examining attorney’s refusal to register the mark THUMBDRIVE on the ground that it was generic for portable digital storage devices. *In re Trek 2000 International Ltd.*, Serial No. 77099785 (T.T.A.B. Nov. 30, 2010) (precedential).

Trek 2000 International Ltd. (Trek) filed an application to register the THUMBDRIVE mark in standard characters for such devices based on acquired distinctiveness under Section 2(f). After the examining attorney issued a final refusal, claiming genericness, Trek appealed to the TTAB.

The examining attorney produced evidence in the form of various Internet advertisements, articles and other materials that used the term “thumb drive” generically for portable digital storage devices. Trek argued that it owned a Supplemental Registration for the mark, produced an excerpt from a Wikipedia entry identifying THUMBDRIVE as a Trek brand and demonstrated that Trek’s principal competitors used the term “flash drive,” not “thumb drive,” as the generic name of their products. Trek also submitted evidence that it polices unauthorized generic uses of its mark.

The TTAB noted that the policy of denying protection for generic terms is to prevent competitive harm by giving one party a monopoly in a term that others need to compete effectively. It concluded that “flash drive” is the commonly used generic term for portable digital storage devices and that competitors need not use the term “thumb drive.”

In addition, the TTAB noted that when complete eradication of an applicant’s commercial rights in a mark is at stake, the evidentiary burden is heavy and the examining attorney must prove genericness by “clear evidence.” Where the record shows both trademark and generic uses, evidence of a lack of use by competitors creates doubt, and any doubt should be resolved in favor of the applicant. The TTAB found the examining attorney failed to meet the burden to establish genericness by clear evidence. Accordingly, it reversed the examining attorney’s refusal, and THUMBDRIVE proceeded to registration.

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