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Subject: U.S. TRADEMARK APPLICATION NO. 76293326 - SHIMMERING BALLERINAS & DANCERS - N/A - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 76293326

MARK: SHIMMERING BALLERINAS & DANCERS

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GENERAL TRADEMARK INFORMATION:

http://www.uspto.gov/trademarks/index.jsp

TTAB INFORMATION:

http://www.uspto.gov/trademarks/process/appeal/index.jsp

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EXAMINING ATTORNEY'S CONSOLIDATED APPEAL BRIEF

STATEMENT OF THE CASE

The applicant has appealed a final refusal to register the applied-for marks, which for sake of brevity will be referred to as the SHIMMERING BALLERINAS and the SHIMMERING RAINFOREST marks.[1] Registration was refused in each application under Trademark Act Sections 1, 2 and 45 because the applied-for mark, as used on the specimens of record, does not function as a trademark to identify and distinguish applicant's goods from those of others and to indicate the source of applicant's goods. 15 U.S.C. §§1051-1052, 1127. In addition, registration was also refused in each application on the ground that applicant's multiple proposed amendments to the original mark drawing constitute material alterations of the original mark drawing submitted with the initial application. *See* 37 C.F.R. §2.72. It is respectfully requested that these refusals be affirmed for each application.

FACTS

The procedural history of each application spans twelve years, two examining attorneys, more than eighty-five TICRS/TSDR entries and more than ninety TTABVUE entries. Since the applications were filed on July 31, 2001, they have been the subject of numerous Office actions, responses to Office actions, final refusals, requests for reconsideration, abandonments and petitions to revive. Applicant filed a notice of appeal for each application on August 8, 2005 and applicant and the previous examining attorney submitted appeal briefs.[2] Since the appeals were instituted, there have been numerous requests to extend by the applicant, several requests for remand and/or reconsideration by applicant and various remand orders by the Board.

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[1] Application Ser. Nos. 76293326 (SHIMMERING BALLERINAS) and 76293327 (SHIMMERING RAINFOREST) are the subject of a consolidated appeal proceeding pursuant to an order of the Trademark Trial and Appeal Board dated November 9, 2010. The Board's order dated June 12, 2013 also advises that the examining attorney may file a consolidated brief. Therefore, both cases are being presented on the same brief. *See* TBMP §1214.

[2] The Board stated in an order dated April 5, 2013 that these previously filed briefs will be given no consideration.

At the time the applications were reassigned to the current examining attorney on April 2, 2012, they were on remand from the Board pursuant to an order dated August 8, 2011, in which the Board required the examining attorney to issue, for each application, a non-final Office action that clearly delineated the outstanding issues.[3] Although the previous examining attorney had already issued a non-final action on September 29, 2011, as a courtesy to applicant and in order to clearly delineate the remaining issues, the current examining attorney issued another non-final Office action for each application dated May 26, 2012. In this non-final action, a refusal on the basis that the original mark drawing displayed "multiple marks" was withdrawn[4] and refusals on the basis the applied-for mark does not function as a trademark and that applicant's separate requests to amend the original mark drawing are unacceptable because they constitute material alterations of the original mark were maintained.

On May 29, 2012, applicant filed non-responsive communications. On June 11, 2012, the examining attorney issued a Notice of Non-Responsive Communication for each application advising applicant that she must file responses within the time remaining in the six-month period for responding to the May 26, 2012 Office actions. Applicant filed late responses on November 27, 2012 and as the examining attorney is without discretion to extend the deadline for response,[5] the applications were abandoned on November 28, 2012. Applicant filed petitions to revive for the applications on January 28, 2013. The petition to revive for Ser. No. 76293326 was granted on February 1, 2013 and the petition to revive for Ser. No 76293327 was granted on March 8, 2013, after applicant paid the petition fee for the latter application. After considering the various arguments and evidence submitted by applicant with her

[3] See Board's August 8, 2011 order at pp. 4-5.
[4] Please see the May 26, 2012 Office action for a full explanation of why the "multiple marks" refusal was withdrawn.
[5] *See* TMEP §718.02.

petitions to revive and communications filed on February 5, 6 and 7, 2013, the examining attorney issued subsequent final Office actions on March 9, 2013. Applicant filed requests for remand on March 28, 2013, which were denied on April 4, 2013. Applicant filed appeal briefs on June 4, 2013. Applicant subsequently filed exhibits and corrections to her appeal briefs on June 11, 12, 21 and 22, 2013.

PROCEDURAL MATTERS

I. Applicant's Submission of New Drawings, Specimens and Other Evidence with and Subsequent to Applicant's Appeal Brief is Untimely

Applicant submitted multiple exhibits referenced in her appeal brief via separate filings made after the filing of her appeal brief. These exhibits include proposed amended drawings, specimens and other evidence. Some of these exhibits were previously made of record prior to resumption of the appeal proceeding on April 5, 2013. The examining attorney does not object to any of the duplicative exhibits that were already made of record.[6] *See In re City of Houston*, 101 USPQ2d 1534, 1536 (TTAB 2012); TBMP §1203.01 n. 2. However, the examining attorney objects to the introduction of those exhibits that were not previously made part of the application record prior to resumption of the appeal proceeding on April 5, 2013.[7] The record in an application should be complete prior to the filing of an appeal. 37 C.F.R. §2.142(d); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c). Applicant had ample opportunity to build the application record prior to resumption of the appeal. Because applicant's new evidence was untimely submitted during an appeal, the trademark examining attorney requests that the Board

[6] To the extent that the drawings reflected in Exhibits A-D of applicant's appeal brief are identical to drawings already in the record, no objection is made to applicant's resubmission of the drawings. However, to the extent that any of these amended drawings differ from the drawings made of record prior to resumption of the appeal on April 5, 2013, they are untimely and have not been considered by the examining attorney.

[7] These include the unverified substitute specimens comprising Exhibits J, L and N, and the accompanying textual descriptions of these specimens comprising Exhibits K, M and O, which were not made of record prior to resumption of the appeal on April 5, 2013. Note that the unverified four-page substitute specimen comprising Exhibit J differs from the single-page "mock-up" submitted by applicant for Ser. No. 76293326 in a voluntary amendment dated February 6, 2013.

disregard this evidence. *See In re Luxuria s.r.o.*, 100 USPQ2d 1146, 1147-48 (TTAB 2011); *In re Giovanni Food Co*., 97 USPQ2d 1990, 1990-91 (TTAB 2011); *In re Van Valkenburgh*, 97 USPQ2d 1757, 1768 n.32, 1769 (TTAB 2011); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c).

II. Other Procedural Matters

The applicant's appeal brief devotes considerable space to several other procedural matters. Although some of these matters are administrative in nature and not within the purview of the Board or this appeal proceeding, [8] for sake of completeness and for the benefit of applicant, the examining attorney will very briefly address these issues. [9]

A. The Subsequent Final Office Action Issued on March 9, 2013 Was Procedurally Proper

Applicant maintains that the unacceptable proposed amendment to the mark drawing filed with applicant's combined January 28, 2013 petition to revive/response to Office action raised a new issue requiring a non-final Office action by the examining attorney. See Applicant's brief at pp.6-7.[10] Based on the TMEP, applicant is incorrect. An unacceptable amendment to the drawing necessitates a new non-final Office action "unless the examining attorney had previously required that the drawing be amended." *See* TMEP §714.05(a). In this case, the examining attorney had previously raised issues regarding other drawing amendments proposed by applicant and required applicant to adopt a mark drawing that is not a material alteration of the original mark drawing. Therefore, applicant's most

[8] For example, the Board will not consider a matter that is appropriate only for petition. TBMP §1201.05.
[9] The examining attorney does not object to applicant's introduction of communications between applicant and various attorneys and other staff members of the Office of the Commissioner for Trademarks comprising Exhibits E-H.
[10] Unless otherwise specified, all references to Applicant's brief refer to the brief filed for Ser. No. 76293326.

recent unacceptable proposed amendment to the mark drawing does not raise a new issue because the amendment of the mark drawing was already at issue.

B. Reflection of the Literal Elements in the Mark in the USPTO's Electronic Record

Applicant's appeal briefs include a list of additional typographical errors applicant has discovered regarding the matter in the "literal element" field of the USPTO's electronic record relating to the original mark drawings. See applicant's briefs for each application at p. 9. The examining attorney has made corrections pursuant to these lists, to the extent applicant's proposed corrections are consistent with the literal elements shown in the original mark drawings.[11] Applicant's request to list each character name on a separate line in the "literal element" field or to place semi-colons between the character names cannot be accommodated.[12]

C. The Correct Design Code Has Been Assigned in Each Application

In her appeal brief, applicant asserts, for the first time, that the design code assigned to her applications is incorrect. Applicant's brief at p. 12. For administrative purposes, design codes are assigned to special form marks that feature one or more design elements. These design codes assist, for example, in searches of the USPTO's database for confusingly similar marks under Trademark Act Section 2(d). While applicant may subjectively perceive the display of the wording inside the rectangle as "flag," the

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[11] The USPTO strives for complete accuracy of the electronic record and the examining attorney regrets any inconsistency between the original mark drawing and the matter set forth in the "literal element" field.

[12] Due to the significant number of characters in the mark, it is simply not possible to display each character name on a separate line in the "literal element" field. It would be improper to separate character names with semi-colons in the "literal element" field because the original mark drawing does not include semi-colons between the names. The purpose of the "literal element" field is merely to set forth the exact literal elements featured in the mark, without regard to their manner of the display on the mark drawing. It is the original mark drawing, not the "literal element" field, which controls for purposes of determining what constitutes the applied-for mark. *See* TMEP §807.01.

original mark drawing filed in each application does not actually feature a flag design. The original mark drawings consist only of literal elements (*e.g.,* words and punctuation) inside a plain rectangular carrier. As such, the design code assigned in each application, 26.11.02 (plain single line rectangles), is the only appropriate design code for the administrative purposes of the USPTO.

D. Display of Documents and Images in TSDR/TICRS

Applicant expresses concern regarding the uploading of particular documents into TSDR. Applicant's brief at p. 17-18. The USPTO's Trademark Electronic Application System (TEAS) experienced a problem with converting PDF documents attached to certain TEAS communications on approximately February 5-6, 2013.[13] Once the problem was resolved, the TEAS Support Team ensured that the affected responses and attachments were uploaded again to TSDR and TICRS so that the PDF documents would be properly converted and legible.[14] The examining attorney was able to fully review applicant's communications by reviewing the properly converted version of the communications.

E. Requirement for a Separate Petition to Revive Fee for Each Application is Proper

Applicant maintains that because the two applications are the subject of a consolidated appeal, she should have been allowed to file a single petition to revive (and single fee) covering both applications following their abandonment on November 28, 2012. Applicant is mistaken. The Board's order consolidates the two appeals for the purposes of briefing, oral hearing and/or final decision. *See* TBMP §1214. At the time the applications were abandoned, they were on remand from the Board and were

[13] This issue affected not only applicant's responses filed during the relevant period, but responses filed by other applicants during the same period.

[14] The original, improperly converted documents remain in the record because it is USPTO policy to not remove such documents from the record.

the subject of further examination. As such, in order to continue prosecuting each application, applicant was required to file a separate petition to revive for each application, just as applicant has been required to file separate responses to Office actions and other communications for each application since the applications were originally filed. Even if the substance of applicant's petitions was the same for each application, she was still required to file a petition for each application in order to make the petition of record in each application. A petition must be accompanied by the fee required by 37 C.F.R. §2.6; any petition that is not accompanied by the required fee is incomplete. TMEP §1705.02. Thus, in order to revive both applications, applicant filed two petitions to revive (one for each application) and therefore it was proper to require two petition fees (one for each petition).

ISSUES TO BE DECIDED ON APPEAL

The issues to be decided on appeal for each application are (1) whether applicant's mark, as used on the specimens of record, functions as a trademark to identify and distinguish applicant's goods from those of others and to indicate the source of applicant's goods, and (2) whether several proposed amendments to the original mark drawing constitute material alterations of the original applied-for mark.

ARGUMENT

I. The Applied-For Marks Fail to Function as Trademarks to Identify the Source of Applicant's Goods

The applied-for marks consist of (1) the wording "SHIMMERING BALLERINAS & DANCERS CHARACTER COLLECTION" and a list of more than ninety character names in columnar form inside a rectangular

carrier [Ser. No. 76293326] and (2) the wording "SHIMMERING RAINFOREST CHARACTER COLLECTION" and a list of more than 125 character names in columnar form inside a rectangular carrier [Ser. No. 76293327]. The identified goods consist of various types of printed matter in International Class 16, including cartoon prints, cartoon strips, illustrations, leaflets, booklets, storybooks and playbooks for children. The specimens made of record prior to resumption of the appeal appear to consist of printed matter in the nature of cartoon prints, leaflets containing stories and poems, and playbooks for children.

The applied-for marks do not function as trademarks for the identified goods because they would be perceived by the relevant purchasing public solely as informational lists of fictional names to which applicant's printed matter pertains and not as source indicators for the printed matter itself.[15] Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051-1052, 1127; *see In re Remington Prods., Inc*., 3 USPQ2d 1714 (TTAB 1987); TMEP §§904.07(b); 1202 *et seq*.

The specimens, along with any other relevant evidence of record, are reviewed to determine whether an applied-for mark is being used as a trademark. *In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213 (C.C.P.A. 1976); *In re Volvo Cars of N. Am., Inc.*, 46 USPQ2d 1455 (TTAB 1998). Not every word, design, symbol or slogan used in the sale or advertising of goods and/or services functions as a mark, even though an individual may have adopted it with the intent to do so. The USPTO will not register a designation unless purchasers would be likely to regard it as a source-indicator for the goods. *In re Manco, Inc.*, 24 USPQ2d 1938 (TTAB 1992); TMEP §1202

[15] Note that this refusal differs from a refusal on the basis that the mark merely identifies a character in a creative work. *See In re Scholastic Inc*., 223 USPQ 431, 431 (TTAB 1984); TMEP §1202.10.

A. The Number of Literal Elements Contained Within the Applied-For Marks Suggests That They Would Not Be Perceived as Trademarks

The SHIMMERING BALLERINAS mark comprises approximately 667 words, which include a listing of more than ninety character names in three vertical columns. The SHIMMERING RAINFOREST mark comprises approximately 577 words, including a listing of more than 125 character names in three vertical columns. While there is no absolute requirement that the mark be a certain length, the length of the matter presented for registration is a factor in determining whether the written matter functions as a trademark. "The fewer words, the more the creation is capable of trademark protection, assuming it is used as a mark." McCarthy on Trademarks and Unfair Competition, §6.17.50 (4th edition, 2012). In this case, the long length of the applied-for marks, at approximately 667 and 577 words, respectively, indicates that they are less likely to be perceived trademarks than a mark comprised of significantly fewer words.

B. The Visual Display of the Matter Comprising the Applied-For Marks Suggests That They Would Not Be Perceived as Trademarks

The visual display of the applied-for marks themselves suggests that they will not be perceived as source indicators for the identified goods. In particular, the marks contain the wording "SHIMMERING BALLERINAS & DANCERS CHARACTER COLLECTION" or "SHIMMERING RAINFOREST CHARACTER COLLECTION" in a larger font, with the remaining words appearing in three long vertical columns[16] in smaller, block text. The presentation of the mark in columnar form with a larger "heading" is a common

[16] A "column" is defined as "[o]ne of two or more vertical sections of typed lines lying side by side on a page and separated by a rule or a blank space." Please see the entry from the American Heritage Dictionary at Attachment 1 to the May 26, 2012 Office action.

manner of presenting information[17] but is not a common manner for displaying a trademark. The impression that the applied-for marks present information is reinforced by the wording "CHARACTER COLLECTION" in larger font in each mark. This wording indicates that the three columns of names comprise information in the nature of a listing of characters. Therefore, consumers are likely to perceive the applied-for marks solely as informational lists of fictional names, and not as source indicators for the goods themselves.

C. The Use of the Applied-For Marks on the Specimens Suggests That They Would Not Be Perceived as Trademarks

(1) Ser. No. 76293326 SHIMMERING BALLERINAS

With respect to the SHIMMERING BALLERINAS mark, the applied-for mark appears on the July 9, 2001[18] Specimens in TICRS at pages 2, 8, 14 and 20 below a similarly presented list of names called the "Shimmering Breezes Character Collection." Likewise, on page 3 of the playbook specimen (Specimens in TICRS dated February 10, 2004, numbered 1-82), the applied-for mark appears below a similarly presented list of names called the "Shimmering Rainforest Character Collection." The fact that the

[17] Newspapers and dictionaries commonly present information in columnar form. See Attachment 2 to the May 26, 2012 Office action, comprised of an image of the front page of The New York Times accessed on May 26, 2012 via http://www.nytimes.com/pages/todayspaper/index.html#nytfrontpage, as well as photographs taken by the examining attorney of the cover, title page and inside pages of Webster's New World College Dictionary and the Larousse Concise Spanish-English English-Spanish Dictionary

[18] The official filing date of the applications is July 31, 2001. It is understood that applicant originally sought to file her applications on July 9, 2001, but they were not accepted at that time due to insufficient filing fees. The Application, Drawing and Specimens categories in TICRS for both applications still list the original application, drawing and specimens filed with the applications using a July 9, 2001 date. At this point, it would be confusing to correct the date to July 31, 2001 because previous Office actions reference these documents using the July 9, 2001 date. Therefore, the July 9, 2001 date remains in the electronic record for each application and is used to refer to the relevant documents bearing this date.

applied-for mark is displayed on the specimens of record as one of several lists of fictional names suggests that it would not be perceived as a trademark that indicates the source of applicant's goods.[19]

In response to the failure to function refusal that was maintained in the May 26, 2012 Office action, applicant submitted a verified substitute specimen on February 6, 2013, which was described as "a 4-page color leaflet." The substitute specimen fails to overcome the failure to function refusal under Trademark Act Sections 1, 2 and 45 for several reasons.

The substitute specimen does not show use of the applied-for mark shown in the original mark drawing filed with the application, which remains the operative mark drawing. Instead, the substitute specimen shows use of applicant's proposed amended drawing of January 28, 2013, which, as explained *infra*, is a material alteration of the original drawing.

Second, the substitute specimen appears to be a printer's proof or a mock-up of a leaflet, as shown by the printer's lines and the notation "[Center Spread (below)]." Indeed, applicant admits in her appeal brief that this document is not an actual leaflet in use in commerce but is instead a mockup. See applicant's brief at p. 7 (stating "Applicant created a rectangle for the four pages of the leaflet, especially for this TEAS filing" and "The format in which they were filed was simply for the purpose of showing the relationship between the pages"). Because the substitute specimen is merely a mock-up of a leaflet, it fails to show use of the applied-for mark on the actual goods and is not acceptable evidence

[19] The Office action dated May 26, 2012 discusses in detail the nature of the Specimens in TICRS dated July 9, 2001, February 10, 2004 and December 16, 2008 and on which pages the applied-for mark appears.

of trademark use. *See In re The Signal Cos*., 228 USPQ 956, 957-58 n.4 (TTAB 1986); TMEP §§904.04(a), 904.07(a).

Third, although applicant has verified that the substitute specimen was in use in commerce at least as early as the filing date of the application, this statement is inconsistent with the copyright information displayed directly on each portion of the substitute specimen, which indicates a copyright date of 2004. Moreover, applicant indicates that she created the mock-up substitute specimen specifically for the TEAS response to Office action, which suggests that the document was not in use in commerce as of the July 31, 2001 application filing date.

Finally, this amended version of the "mark" is used on the back cover of a leaflet similar to the manner in which the applied-for mark is used on other specimens already in the record. As is the case with applicant's other specimens, consumers will perceive the "mark" only as a list of fictional names to which applicant's leaflets pertain and not as a source indicator for the leaflets themselves. The statement below the "mark" on the leaflet, which advises consumers to "Be sure to look for this unique Shimmering Ballerinas & Dancers Trademark, above," is of no moment. Consumers that read this statement are likely to perceive applicant's reference to the "Trademark" as referring to the actual "Shimmering Ballerinas & Dancers" wording that is referenced in the statement and shown in the "mark" in a larger, stylized font directly next to a "TM" symbol. They are unlikely to view the entire list of names shown as being the referenced "Trademark."

(2) Ser. No. 76293327 SHIMMERING RAINFOREST

With respect to Ser. No. 76293327 (SHIMMERING RAINFOREST), the applied-for mark appears on the July 9, 2001 Specimens in TICRS at Pages 2 and 8 above a similarly presented list of names called the "Shimmering Ballerinas & Dancers Character Collection" or below a similarly presented list of names called the "Shimmering Breezes Character Collection." Likewise, on page 40 of the playbook specimen (Specimens in TICRS dated February 10, 2004, numbered 1-81), the applied-for mark appears above the list of names in the "Shimmering Ballerinas & Dancers Character Collection." The fact that the applied-for mark is displayed on the specimens of record as one of several lists of fictional names suggests that it would not be perceived as a trademark that indicates the source of applicant's goods.

In response to the failure to function refusal that was maintained in the May 26, 2012 Office action, applicant submitted an unverified substitute specimen on March 4, 2013, which was described as "a 4-page color leaflet." This substitute specimen is unacceptable because it was not verified with an affidavit or signed declaration under 37 C.F.R. §2.20. 37 C.F.R. §2.59(a); TMEP §904.05; *see* 37 C.F.R. §2.193(e)(1). The substitute specimen also fails to overcome the failure to function refusal under Trademark Act Sections 1, 2 and 45 for same reasons enumerated above concerning the February 6, 2013 substitute specimen submitted for Ser. No. 76293326, namely, that the substitute specimen shows a materially different mark than the mark depicted on the original mark drawing, that the substitute specimen comprises a mock-up of a leaflet created by applicant and not an actual leaflet in use in commerce, that information in the record indicates that the substitute specimen was not in use in commerce as of the July 31, 2001 application filing date, and that the display of the applied-for mark on the substitute specimen would be perceived as an informational list of names and not as a source indicator.

D. Applicant's Claim of Acquired Distinctiveness Pursuant to Trademark Act Section 2(f) Fails to Overcome the Failure to Function Refusal

Applicant argues, in the alternative, that applicant's mark has acquired distinctiveness under 15 U.S.C. §1052(f) based upon her verified claim that the mark has been in "substantially exclusive and continuous use in commerce, for several years preceding her original application in 2001, through to the present day." See applicant's January 28, 2013 petition to revive/response to Office action at pp. 8-9. This alternative claim of acquired distinctiveness was originally made in a request for reconsideration filed on December 15, 2009.[20]

When asserting a Trademark Act Section 2(f) claim, the burden of proving that a mark has acquired distinctiveness is on the applicant. *Yamaha Int'l Corp. v. Yoshino Gakki Co.*, 840 F.2d 1572, 1578-79, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988); *In re Meyer & Wenthe, Inc.*, 267 F.2d 945, 948, 122 USPQ 372, 375 (C.C.P.A. 1959); TMEP §1212.01. Thus, applicant must establish that the purchasing public has come to view the proposed mark as an indicator of origin.

In the present case, the issue is whether the applied-for mark functions as a trademark on the specimens of record. A determination as to whether the matter for which registration is sought functions as a trademark is based upon all evidence of record in the application. *See In re Safariland Hunting Corp.*, 24 USPQ2d 1380, 1381 (TTAB 1992) (examining attorney should look primarily to the specimen to determine whether a designation would be perceived as a source indicator, but may also

[20] The Section 2(f) claim is contained in a PDF attachment to the December 15, 2009 request for reconsideration in TICRS for Ser. No. 76293327, but the PDF attachment was missing from the corresponding December 15, 2009 request for reconsideration in TICRS for Ser. No. 76293326. Applicant subsequently submitted a PDF attachment discussing the Section 2(f) claim for Ser. No. 76293326 in the June 6, 2011 request for reconsideration that appears in TTABVUE.

consider other evidence, if there is other evidence of record). Not everything that is recognized or associated with a party is necessarily a registrable trademark. TMEP §1202.

Applicant's claim of acquired distinctiveness is essentially based upon a verified statement of substantially exclusive and continuous use of the mark in commerce for at least five years.[21] However, length of use alone does not demonstrate that the applied-for marks, which are merely informational lists of names, have come to be perceived as trademarks. Because the failure to function refusal is predicated in significant part on the manner in which the applied-for marks are used on the specimens, concrete evidence that the proposed marks are perceived as a mark for the relevant goods is required to establish distinctiveness. *See, e.g., In re Owens-Corning Fiberglas Corp*., 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985). This evidence must demonstrate that the purchasing public has come to identify the applied-for marks with the source of the goods.

Applicant has not submitted any extrinsic evidence demonstrating that the marks function as source indicators for the identified goods. Applicant has not made of record specific dollar sales under the marks, advertising figures, samples of advertising, consumer or dealer statements of recognition of the marks as source identifiers, or affidavits from consumers. *See* 37 C.F.R. §2.41(a); *In re Ideal Indus., Inc.*, 508 F.2d 1336, 184 USPQ 487 (C.C.P.A. 1975); *In re Instant Transactions Corp.*, 201 USPQ 957 (TTAB 1979); TMEP §§1212.06 *et seq.*

[21] Although applicant refers to the specimens of record in support of her Section 2(f) claim, applicant has submitted a claim of acquired distinctiveness in the alternative precisely because the applied-for marks fail to function as source indicators for the goods as used on the specimens. Moreover, some of the specimens, such as the February 6, 2013 and March 4, 2013 specimens submitted in support of Ser. No. 76293326 and Ser. No. 76293327, respectively, are mock-ups that do not even show actual use of the mark in commerce. Those specimens thus have little, if any, probative value in determining acquired distinctiveness.

Therefore, applicant has failed to provide the requisite evidence demonstrating that consumers have come to view the applied-for marks as source indicators for the goods.

II. Applicant's Proposed Amendments to the Original Mark Drawings Constitute Material Alterations of the Original Mark Drawings

Over the course of prosecuting the applications, applicant has submitted three different proposed amendments to the original mark drawing for each application.

A. Proposed Amended Drawings for Ser. No. 76293326 (SHIMMERING BALLERINAS)

The original drawing filed with the application shows the mark with the wording "SHIMMERING BALLERINAS & DANCERS CHARACTER COLLECTION" in large, stylized font in the upper left corner of the mark, with a list of more than ninety character names appearing below and to the right of the mark in vertical columns in small block text, all inside a rectangular carrier (hereinafter, Original Columnar Drawing).[22] On March 6, 2003, applicant sought to amend the drawing to the wording "SHIMMERING BALLERINAS & DANCERS" in large, stylized font in the center of the mark with more than ninety character names radiating from the center "SHIMMERING BALLERINAS & DANCERS" wording (hereinafter, Radial Design Drawing).[23] On December 16, 2008, applicant sought to amend the mark drawing to the wording "SHIMMERING BALLERINAS & DANCERS CHARACTER COLLECTION" and the list of over ninety character names in standard character format without claim to any particular font, style,

[22] See drawing at TICRS Application dated July 9, 2001 at p 1. The official filing date of the application is July 31, 2001, as discussed in footnote 18 *supra*.
[23] See drawing at TICRS Incoming dated March 6, 2003 at pp. 27-28.

size or color (hereinafter, Standard Character Drawing).[24] Finally, on January 28, 2013, applicant sought to amend the drawing to a different version of a columnar drawing in color that adds, deletes and/or changes various arbitrary literal elements in the mark and that also contains additional design elements in the form of stars and rays of light (hereinafter, Color Drawing).[25]

B. Proposed Amended Drawings for Ser. No. 76293327 (SHIMMERING RAINFOREST)

The original drawing filed with the application shows the mark with the wording "SHIMMERING RAINFOREST CHARACTER COLLECTION" in large, stylized font in the upper left corner of the mark, with a list of more than 125 character names appearing below and to the right of the mark in vertical columns in small block text, all inside a rectangular carrier (hereinafter, Original Columnar Drawing).[26] On March 6, 2003, applicant sought to amend the drawing to the wording "SHIMMERING RAINFOREST" in large, stylized font in the center of the mark with more than 125 character names radiating from the center "SHIMMERING RAINFOREST" wording (hereinafter, Radial Design Drawing).[27] On December 16, 2008, applicant sought to amend the mark drawing to the wording "SHIMMERING RAINFOREST CHARACTER COLLECTION" and the list of over 125 character names in standard character format without claim to any particular font, style, size or color (hereinafter, Standard Character Drawing).[28] Finally, on January 28, 2013, applicant sought to amend the drawing to a different version of a columnar drawing in color that adds, deletes and/or changes various arbitrary literal elements in the mark and that also contains additional design elements in the form of stars and rays of light (hereinafter, Color Drawing).[29]

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[24] See drawing at TICRS Incoming dated December 16, 2008 at p. 2.
[25] See drawing at TICRS Incoming dated January 28, 2013 at p.11.
[26] See drawing at TICRS Application dated July 9, 2001 at p 1. The official filing date of the application is July 31, 2001, as discussed in footnote 18 *supra*.
[27] See drawing at TICRS Incoming dated March 6, 2003 at pp. 31-32.
[28] See drawing at TICRS Incoming dated December 16, 2008 at p. 2.
[29] See drawing at TICRS Incoming dated January 28, 2013 at p.12.

C. Each of the Proposed Amendments Materially Alters the Original Columnar Drawing

Each of the three proposed amendments to the Original Columnar Drawing in each application was refused because it would result in a material alteration of the mark depicted in the original application. 37 C.F.R. §2.72; TMEP §807.14. Determining whether a proposed amendment materially alters a mark involves comparing the proposed amended mark with the mark in the drawing filed with the original application. 37 C.F.R. §2.72; TMEP §807.14(d).

The test for material alteration is whether the modified mark retains what is the essence of the original mark; that is, whether the new and old forms create the impression of being essentially the same mark. *In re Hacot-Columbier*, 105 F.3d 616, 620, 41 USPQ2d 1523, 1526 (Fed. Cir. 1997) (quoting *Visa Int'l Serv. Ass'n v. Life Code Sys., Inc.*, 220 USPQ 740, 743 (TTAB 1983)); *see In re Nationwide Indus. Inc.*, 6 USPQ2d 1882, 1885 (TTAB 1988); TMEP §807.14. For example, if republication of the amended mark would be necessary in order to provide proper notice of the mark to third parties for opposition purposes, then the mark has been materially altered and the amendment is not permitted. *In re Hacot-Columbier*, 105 F.3d at 620, 41 USPQ2d at 1526 (quoting *Visa Int'l Serv. Ass'n v. Life Code Sys., Inc.*, 220 USPQ at 743-44). Also, the addition of an element that would require a further search may be a factor in determining material alteration. *In re Guitar Straps Online, LLC*, 103 USPQ2d 1745, 1747 (TTAB 2012); *In re Who? Vision Sys. Inc.*, 57 USPQ2d 1211, 1218 (TTAB 2000).

In the present case, each of the proposed amended drawings, *i.e.,* the Radial Design Drawing, Standard Character Drawing and Color Drawing, constitutes a material alteration of the Original Columnar Drawing set forth in the initial applications. TMEP §807.17; *see* 37 C.F.R. §2.72; *In re Who? Vision Sys., Inc.*, 57 USPQ2d 1211 (holding proposed amendment from "TACILESENSE" to "TACTILESENSE" to be

material alteration due to the difference in meaning or connotation between the marks); *In re CTB Inc.*, 52 USPQ2d 1471 (TTAB 1999) (holding proposed amendment of TURBO and design to the typed word TURBO to be a material alteration due to the design being distinctive matter).

The Radial Design Drawings first proposed on March 6, 2003 are a material alteration of the Original Columnar Drawings because unlike the original drawings, which show the mark appearing in three columns, the Radial Design Drawings present the marks themselves as a design that suggests a sun, starburst or flower. The Radial Design Drawings thus present a different overall commercial impression from the Original Columnar Drawings. In addition, the Radial Design Drawings would have required a search of different design codes, such as 01.01.06 (stars with rays or radiating lines) and 27.01.04 (letters forming representations of objects).

The Standard Character Drawings first proposed on December 16, 2008 are also a material alteration of the Original Columnar Drawings because applicant could display the marks without utilizing the columnar display used in the Original Columnar Drawings. In addition, the wording "SHIMMERING BALLERINAS & DANCERS CHARACTER COLLECTION" or "SHIMMERING RAINFOREST CHARACTER COLLECTION" appears in a much larger, stylized font at the top of the Original Columnar Drawings. However, when using the proposed Standard Character marks in commerce, applicant could deemphasize the wording "SHIMMERING BALLERINAS & DANCERS CHARACTER COLLECTION" or "SHIMMERING RAINFOREST CHARACTER COLLECTION" by displaying this wording in a very small, simple font and instead emphasize one or more character names by displaying the names in a larger, stylized font. Such display would be supported by a standard character drawing but would result in marks with a very different appearance and overall commercial impression from the Original Columnar Drawings.

The Color Drawings[30] first proposed on January 28, 2013 are a material alteration of the Original Columnar Drawings because these Color Drawings include design elements in the form of stars and rays of light that are not present in the Original Columnar Drawings. These design elements create the appearance of a sun with rays and scattered stars, which significantly alters the appearance of the Original Columnar Drawings. These elements would have required a search of additional design codes, such as 01.01.12 (more than one star with four points) and 01.15.25 (light rays). In addition, the proposed Color Drawings add, delete and/or alter arbitrary terms from the Original Columnar Drawings. For example, the proposed Color Drawing for SHIMMERING BALLERINAS changes LIMINOSA DE LUZ to <u>LUMINOSA</u> DE LUZ, <u>ESPERE LA LUZ DANCER OF LIGHT</u> and deletes LACEY, THE CASCADES OF LACE BALLERINA. The proposed Color Drawing for SHIMMERING RAINFOREST proposes deleting an entry for GLORIOUS GLORIETTA GLISSANDO and replacing it with a new entry for <u>ADORIOUS ADORIETTA</u> GLISSANDO. These proposed changes to the design and literal elements significantly alter the appearance, sound and connotation of the marks. In addition, these proposed changes would require an additional search because applicant has added design elements and modified the literal elements of the marks. The addition of an element that would require a further search is one factor in determining material alteration. *In re Guitar Straps Online, LLC*, 103 USPQ2d 1745, 1747 (TTAB 2012); *In re Who? Vision Sys. Inc*., 57 USPQ2d 1211, 1218 (TTAB 2000). Deletion of matter from the mark can also result in a material alteration. *See In re Dillard Department Stores, Inc.*, 33 USPQ2d 1052 (Comm'r Pats. 1993); TMEP §807.14(a).

[30] The fact that these proposed amended drawings are displayed in color is not one of the reasons the marks have been deemed material alterations of the Original Columnar Drawings. *See* TMEP §807.14(e)(ii). They are referred to as herein as "Color Drawings" simply because it is an easy way to distinguish them from the Original Columnar Drawings and other proposed amended drawings.

CONCLUSION

The applied-for marks, SHIMMERING BALLERINAS and SHIMMERING RAINFOREST, fail to function as trademarks for the identified goods to identify and distinguish applicant's goods from those of others and to indicate the source of applicant's goods. Therefore, it is respectfully requested that the refusal under Trademark Act Sections 1, 2 and 45 be affirmed. In addition, the three drawing amendments proposed by applicant in each application constitute material alterations of the original applied-for marks under 37 C.F.R. §2.72. It is respectfully requested that the refusal to accept these proposed drawing amendments also be affirmed.

Respectfully submitted,

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