

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: December 13, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Prema Jyothi Light*

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Serial No. 76293327

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Prema Jyothi Light, *pro se*.

Linda Lavache, Trademark Examining Attorney, Law Office 106  
(Mary I. Sparrow, Managing Attorney).

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Before Seeherman, Wellington and Lykos, Administrative  
Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Over 12 years ago, on July 9, 2001, Prema Jyothi  
Light, an individual (and hereinafter referred to as  
"applicant"), filed an application<sup>1</sup> to register the  
following matter on the Principal Register:

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<sup>1</sup> Application Serial No. 76293327, filed on July 31, 2001, is  
based on an allegation of first use on May 31, 1991, and first  
used in commerce on August 31, 2000.



Because the reproduction quality of the drawing page in the USPTO office database may be insufficient for readers, we point out that the mark contains the larger, stylized wording SHIMMERING RAINFOREST CHARACTER COLLECTION on the top left, surrounded by three columns of an extremely long list of terms (in a smaller font) identifying names of fictional characters, e.g., JALINDA THE WIND-HARP BUTTERFLY; JALISA THE WIND-HARP BUTTERFLY; HARRY & HARRIETTA, THE HAIRY RAINFOREST SUSPENDER SPIDERS, etc. In all, the proposed mark comprises approximately 575 terms.

Applicant seeks to register the proposed mark for the following goods:

Cartoon prints, cartoon strips, cartoons to be submitted for publication by publishers and periodicals, and illustrations, which may include text with visual art, or just the visual art; leaflets and series of booklets of printed text materials, specifically, stories and poems; leaflets, series of booklets, storybooks, and playbooks for children, which contain any or all of these-- paper dolls, coloring book pages, stories, poems, illustrations, games, connect-the-dots pictures, snowflake cutting patterns, suggestions for children's activities, and patterns for toys, pillows, and decals for T-shirts, pajamas, and mugs.

Applicant has disclaimed the wording RAINFOREST CHARACTER COLLECTION and amended the application to include

a claim that the proposed mark has acquired distinctiveness under Section 2(f) of the Act.<sup>2</sup>

The examining attorney has refused registration on the ground that the applied-for matter fails to function as a mark under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052 and 1127. The examining attorney has also refused to accept applicant's proposed amendments to the drawing because each one constitutes a material alteration of the proposed mark shown in the original drawing.

Appeal briefs have been filed.<sup>3</sup>

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<sup>2</sup> An initial disclaimer of the single term RAINFOREST was submitted by applicant on March 6, 2003. The disclaimer of RAINFOREST CHARACTER COLLECTION is reflected in an amendment to the application dated March 30, 2012. Applicant's Section 2(f) acquired distinctiveness claim was made in her "request for reconsideration," filed on December 15, 2009.

<sup>3</sup> There had been earlier briefing of the appeal. However, because of the subsequent developments, including a remand by the Board for the examining attorney to consider whether an additional ground for refusal should be raised, the Board determined that it would be more helpful for applicant and the examining attorney to file new, as opposed to supplemental briefs. As a result, the Board, on April 5, 2013, advised that the earlier filed briefs would be given no consideration, and applicant and the examining attorney were given time to file new briefs. Our references to briefs therefore are to these latter-filed briefs, including applicant's reply brief, and we have not considered the earlier briefs in reaching our decision in this appeal.

The examining attorney's objection to materials attached to applicant's appeal brief on the basis that they were not made of record during prosecution of the involved application is sustained. See Trademark Rule 2.142(d). See also *In re Volvo Cars of North America, Inc.*, 46 USPQ2d 1455, 1456 n.2 (TTAB 1998); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1372 (TTAB 2006);

*Issues on Appeal*

The application was filed in 2001 and the prosecution history comprises many Office actions, responses and other filings by applicant. Applicant's appeal was instituted in 2005 and, since then, the Board TTABVUE database reflects there have been over 100 entries. We make no attempt herein to recount all events and filings leading up to the appeal but note only those that are relevant to our decision.

In spite of any confusion created by the extensive amount of time the prosecution of this application and the subsequent appeal have taken, and notwithstanding the numerous papers filed, the March 9, 2013 Office action sets forth, succinctly and accurately, the issues now ready for decision on appeal. Specifically, as a result of the most recent remand, and at the behest of the Board, the examining attorney outlined the following "Summary of Outstanding Issues" on appeal:

1. Trademark Act Sections 1, 2 and 45 Refusal - Applied-For Mark Fails to Function as a Trademark on the Specimens and the Claim of Acquired Distinctiveness is Insufficient.

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and *In re District of Columbia*, 101 USPQ2d 1588, 1591 (TTAB 2012). Accordingly, these materials have not been considered.

2. Applicant's Three Separate Requests to Amend the Drawing are Not Acceptable Because the Proposed [Amended] Marks Constitute Material Alterations of the Mark Shown in the Original Drawing (Trademark Rule 2.72(b)(2)).

Based on our review of the prosecution and appeal history, we agree that these are the appropriate issues on appeal. We further note that the examining attorney articulated her reasoning for the refusals in the same Office action and this was the last Office action issued prior to applicant's filing of her appeal brief. Thus, any argument by applicant that she is unaware of or in disagreement with the statement of the issues on appeal is not well taken. Arguments and materials submitted by applicant that are irrelevant to the issues before us or are untimely have been disregarded. We now address the issues on appeal.

Applicant's Proposed Mark Fails to Function as a Trademark

Sections 1, 2 and 45 of the Trademark Act provide the statutory basis for refusal to register subject matter on the Principal Register on the basis the proposed mark fails to function as a trademark. 15 U.S.C. §§ 1051, 1052 and 1127. Specifically, Sections 1 and 2 provide, *inter alia*, for the application and registration on the Principal Register of trademarks "by which the goods of the applicant may be distinguished from the goods of others" and Section

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45 defines a "trademark," in pertinent part, as "any word, name, symbol, or device, or any combination thereof used by a person ... to identify and distinguish his or her goods ... from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown." Accordingly, the Office is statutorily constrained to register matter on the Principal Register only if it functions as a trademark.

"[N]ot every designation adopted with the intention that it performs a trademark function and even labeled as a trademark necessarily accomplishes that purpose...."

*American Velcro, Inc. v. Charles Mayer Studios, Inc.*, 177 USPQ 149, 154 (TTAB 1973).

The critical inquiry in determining whether a designation functions as a mark is how the designation would be perceived by the relevant public. To make this determination we look to the specimens and other evidence of record showing how the designation is actually used in the marketplace.

*In re Eagle Crest Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010)  
(citations omitted).

Thus, the critical question in determining whether applicant's proposed mark functions as a trademark is the commercial impression it makes on the relevant public (e.g., whether the term sought to be registered would be perceived as a mark identifying the source of the goods).

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*In re Aerospace Optico, Inc.*, 78 USPQ2d 1861, 1862 (TTAB 2006) ("the mark must be used in such a manner that it would be readily perceived as identifying the specified goods [or services]. ... The mere fact that a designation appears on the specimen of record does not make it a trademark. ... A critical element in determining whether matter sought to be registered as a trademark is the impression the matter makes on the relevant public." (citations omitted)); *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455, 1459 (TTAB 1998); *In re Remington Products Inc.*, 3 USPQ2d 1714, 1715 (TTAB 1987); *In re Morganroth*, 208 USPQ 284, 287 (TTAB 1980).

Based on our review of the specimens of use submitted by applicant as well as all other evidence of record, we agree with the examining attorney that applicant's proposed mark fails to function as a trademark. We further agree with the examining attorney's contention that because of the sheer number and visual display of the words in the applied-for matter, it faces a significantly more difficult task in being perceived as a unitary trademark. We note, in this regard, the decision in *In re McDonald's Corporation*, 199 USPQ 490 (TTAB 1978), involving an application to register TWOALLBEEFPATTIESSPECIALSAUCE-LETTUCECHEESEPICKLESONIONSONASESAMESEEDBUN as a mark for

restaurant services. In that case, the proposed mark initially was refused for not being used in the nature of a mark, *id.* at n.2, and ultimately was refused, despite applicant's claim of acquired distinctiveness, as a mere display of a list of unregistrable terms, specifically, a list of the ingredients of a special sandwich, where the display did not create a commercial impression apart from the terms themselves. *Id.* at 491. While the applicant in the *McDonald's* case was able to provide evidence sufficient to overcome the refusal, we do not, in this case, have the same type of persuasive evidence that would allow us to reverse the examining attorney's refusal. We also find that the much greater number of words in applicant's proposed mark, as compared to the list of ingredients in the *McDonald's* case, presents an even higher hurdle for applicant to overcome when trying to establish that her proposed mark would be perceived as such. In short, the quantity of information in the proposed mark is simply too great to be a useful means for consumers to differentiate one source from another.

The original specimens submitted with the instant application depict the applied-for mark on the second page of a "Shimmering Rainforest Character Collection..."

Cartoons, Illustrations, Stories & Scripts.”<sup>4</sup> Specifically, the proposed mark appears on a page above a similarly presented list of names called “Shimmering Ballerinas & Dancers Character Collection” in such a manner that it will not be perceived as a trademark or as indicating the source of applicant’s identified goods. Rather, the proposed mark merely identifies what appears to be a title (of a story, e.g.) and a list of fanciful, fictional names for characters.

Likewise, the substitute specimens fail to show the proposed mark in a manner such that consumers would perceive it as an indicator of source for any of the identified goods. In particular, on February 10, 2004, applicant submitted specimens showing the proposed mark in roughly the same manner as the original specimens, *i.e.*, above a similar “Shimmering Breezes Character Collection” list of fictional character names. The preceding page appears to be the cover page and is captioned “The Triple Shimmering...Shimmering Rainforest...Shimmering Ballerinas & Dancers...And Shimmering Breezes...Storybook Stories &

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<sup>4</sup> The specimens appear in USPTO TSDR database, July 9, 2001, “specimen” entry (pp. 1-19). For sake of brevity, the specimen images are not reproduced in this decision.

Poetry Collection by Prema Jyothi Light [applicant].”<sup>5</sup> The proposed mark also appears on a different page alongside an “introduction” for a “playbook” and describes “Shimmering Rainforest” as “hav[ing] a save-the-rainforest theme.” Thus, upon reading this description, and viewing the proposed mark either alongside it or elsewhere, readers and users of these specimens will understand the applied-for matter as simply identifying a title or theme for the playbook, as well as a corresponding list of character names in the playbook.

In addition, applicant submitted specimens in support of her proposed amended renditions of the original applied-for mark. As discussed later, the proposed amendments to the mark are unacceptable because each would constitute a material alteration. Nevertheless, for sake of completeness, we find that even if any of applicant’s amendments were accepted, the specimens of use do not show that the applied-for matter, in any of the proposed forms, functions as a trademark. For example, the specimens submitted on March 4, 2013, show the proposed amended mark in the following manner:

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<sup>5</sup> The specimens appear in USPTO TSDR database, February 10, 2004, “specimen” entries. For sake of brevity, the specimen images are not reproduced in this decision.



This page is described as the "back cover" of a "4-page leaflet."<sup>6</sup> Although this purported specimen of use directs the reader to "look for this unique SHIMMERING RAINFOREST TRADEMARK, ABOVE," and inserts a "TM" after "SHIMMERING RAINFOREST," we do not believe that persons reading this will then view the entire proposed mark, i.e., SHIMMERING RAINFOREST CHARACTER COLLECTION and the entire list of characters, as a single trademark. Rather, we agree with the examining attorney that "[c]onsumers that read this statement are likely to perceive applicant's reference to the 'Trademark' as referring to the actual [SHIMMERING RAINFOREST] wording that is referenced in the statement and shown in the 'mark' in a larger, stylized font directly next to the 'TM' symbol." Brief, p. 13. In other words, at best consumers would perceive SHIMMERING RAINFOREST as being the intended trademark while the CHARACTER COLLECTION (followed by a long list of character names) portion will merely be perceived as informational.

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<sup>6</sup> Although not an issue on appeal, we note the examining attorney also objected to this specimen because it was not verified with an affidavit or signed declaration in accordance with Trademark Rule 2.20. The examining attorney also contends that applicant has admitted this purported specimen is in actuality a "mock-up" of a leaflet and notes there is a copyright notice date of 2004 in the bottom right corner of the page; thus the examining attorney concludes that this substitute specimen cannot be considered an example of use in commerce as of the application's filing date.

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Applicant's insertion of "TM" in this specimen does not help because it appears immediately after SHIMMERING RAINFOREST and would not be understood as intended for the entire applied-for matter. In any event, use of the "TM" symbol does not automatically confer trademark rights or otherwise obviate a failure to function refusal. *In re Aerospace Optics Inc.*, 78 USPQ2d at 1864; *In re Brass-Craft Mfg. Co.*, 49 USPQ2d 1849, 1853 (TTAB 1998). Accordingly, these specimens fail to show that the proposed mark, in its entirety, is actually functioning as a single trademark.

Upon consideration of the entire record, we agree with the examining attorney that the applied-for matter as it is being used is merely informational, and will be perceived as such. As the examining attorney has pointed out, the actual layout of the proposed mark, viewed by itself or in connection with all the specimen pages, creates an appearance such that viewers, whether they be prospective consumers or not, would not believe that this matter is a trademark. Rather, they will understand the matter as identifying the title and fictional characters of a story which may form the basis or theme for children's play materials.

Finally, we note that applicant has asserted a claim that the applied-for mark has acquired distinctiveness

pursuant to Trademark Act Section 2(f), 15 U.S.C. § 1052(f). Applicant's claim of acquired distinctiveness appears to rest essentially on her alleged years of use of the applied-for mark in the manner shown in the previously-discussed specimens. As explained, the specimens do not demonstrate trademark use and, without more, such as evidence that the matter has been promoted as a trademark, *see McDonald's*, 199 USPQ at 491, we cannot find that the applied-for mark has acquired distinctiveness regardless of the time the applied-for mark has been used in this manner. *See, e.g., In re Ennco Display Systems Inc.*, 56 USPQ2d 1279, 1286 (TTAB 2000) (applicant's years of use of product designs insufficient to bestow acquired distinctiveness).

In summary, the evidence of record does not support a conclusion that the applied-for matter functions as a trademark or otherwise is distinctive for purposes of acting as a source identifier for the identified goods.

Material Alterations to Mark

In the initial Office action and prior to the failure to function refusal being raised, the then-examining attorney offered applicant the option to submit a new drawing and to "delete the words 'character collection' and all the words in the columns" because this portion is

"informational and not part of the mark."<sup>7</sup> The examining attorney went on to state that "[p]eople would not perceive all the names on the drawing as a single mark for the goods." Later during the prosecution and after the failure to function refusal was raised, the examining attorney again offered applicant the option to "submit a new drawing containing only the words SHIMMERING RAINFOREST without any other elements" and, the examining attorney advised, this would "overcome the [failure to function] refusal."<sup>8</sup> In what was apparently in response to, but not in compliance with, the examining attorney's suggestions, applicant submitted several proposed amendments to the drawing. Each attempt has been refused by the examining attorney because it materially alters the original applied-for mark.

Trademark Rule 2.72(a)(2), which governs applications filed pursuant to Section 1(a) (use in commerce), provides that an applicant may amend the drawing of the mark if "[t]he proposed amendment does not materially alter the mark. The Office will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the description or drawing of the

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<sup>7</sup> See TSDR database entry dated June 26, 2002 ("priority action").

<sup>8</sup> See TSDR database entry dated June 14, 2008 ("Office action outgoing").

mark filed with the original application." The test for determining whether a proposed amendment is a material alteration has been articulated as follows:

The modified mark must contain what is the essence of the original mark, and the new form must create the impression of being essentially the same mark. The general test of whether an alteration is material is whether the mark would have to be republished after the alteration in order to fairly present the mark for purposes of opposition. If one mark is sufficiently different from another mark as to require republication, it would be tantamount to a new mark appropriate for a new application.

*In re Hacot-Colombier*, 105 F.3d 616, 620, 41 USPQ2d 1523, 1526 (Fed. Cir. 1997), quoting *Visa Int'l Service Ass'n v. Life-Code Systems, Inc.*, 220 USPQ 740, 743-44 (TTAB 1983). Also, as has often been stated, the addition of any element that would require a further search generally will constitute a material alteration. *In re Pierce Foods Corp.*, 230 USPQ 307 (TTAB 1986). The crucial questions are whether the proposed amendment retains "the essence of the original mark" and whether it creates "the impression of being essentially the same mark." *In re Who? Vision Systems, Inc.*, 57 USPQ2d 1211, 1218 (TTAB 2000). That is, "the new and old forms of the mark must create essentially the same commercial impression." *Id.*, quoting *In re Nationwide Industries Inc.*, 6 USPQ2d 1882, 1885 (TTAB

1988). See also, *In Re Guitar Straps Online*, 103 USPQ2d 1745 (TTAB 2012).

With the above in mind and after careful consideration, we find that each of the three different attempts by applicant to amend the proposed mark, as originally filed, constitutes a material alteration. First, with respect to applicant's proposed amended drawing submitted on March 7, 2003,<sup>9</sup> this alters the original proposed mark by removing the columns of character names and displaying the character names in a radial or "starburst" manner (surrounding the stylized literal portion SHIMMERING RAINFOREST).<sup>10</sup> As the examining attorney correctly notes, the new design incorporating the names of the characters creates a new commercial impression that would necessarily involve a new search by the examining attorney to determine if there is a conflict with any registration or prior-filed application with a similar configuration or display of character names or terms, even if the names or terms are different.

As to the second proposed amended drawing, filed on December 16, 2008, applicant specifically states that this

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<sup>9</sup> The same proposed amended drawing was again filed on February 9, 2004.

<sup>10</sup> See TSDR March 7, 2003 entry at p. 2.

new proposed mark is in "standard character format without any claim to any particular font style, size or color."<sup>11</sup> As the examining attorney argued in her appeal brief, converting the proposed stylized mark, including the columns of character names, to a single standard character mark "would result in [a mark] with a very different appearance and commercial impression from the [original proposed mark]." Brief, p. 20. In other words, should the amendment be allowed, the wording SHIMMERING RAINFOREST which appears prominently in the original proposed mark could possibly appear on equal footing, *i.e.*, the same font style and size, as the remaining literal elements consisting of character names, and thus lose its status as an element most likely to garner attention. Likewise, the column design could be deleted. We agree with the examining attorney's determination in this regard and find this proposed amendment constitutes a material alteration. See TMEP § 807.03(d) (Changing From Special Form Elements to Standard Characters).

Finally, applicant's third attempt to amend the mark was filed on January 28, 2013, and depicts the same matter

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<sup>11</sup> See TSDR database entry dated December 16, 2008 ("response to Office action") at p. 2 for applicant's statement and drawing showing the proposed mark.

shown in the original drawing with the addition of a colorful background, stars, and rays of light emanating from the top left corner.<sup>12</sup> The additional elements constitute a material alteration inasmuch as they would clearly require an additional conflicting mark search by the examining attorney.

Accordingly, applicant's attempts to amend the drawing all would result in material alterations to the proposed mark, as originally filed, and thus are prohibited under Trademark Rule 2.72.

**Decision:** The examining attorney's refusal under Sections 1, 2 and 45 to register the proposed mark is affirmed; and the examining attorney's refusal to accept the various proposed amendments to the mark as applied-for also are affirmed.

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<sup>12</sup> See TSDR database entry dated January 28, 2013 ("Petition to Revive Abandoned Application") at p. 12.