

# UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/420605

APPLICANT: First Draft, Inc.

**\*76420605\***

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Please provide in all correspondence:

CORRESPONDENT EMAIL ADDRESS:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

## OFFICE ACTION

Serial Number 76/420605

Applicant is requesting reconsideration of a final refusal dated November 20, 2003.

The applicant's request includes TARR printouts and file wrappers for seven registrations. The examining attorney has carefully reviewed the request for reconsideration and has determined that no new facts or reasons have been presented that are significant or compelling with regard to the point at issue. Accordingly, the final action is maintained and the request for reconsideration is *denied*. 37 C.F.R. §2.64(b); TMEP §715.03(c).

The TARR print-outs and file wrappers submitted by the applicant show current registrations for seven marks composed of a name and used on a series of books. Prior decisions and actions of other trademark examining attorneys in registering different marks are without evidentiary value and are not binding upon the Office. Each case is decided on its own facts, and each mark stands on its own merits. *AMF Inc. v. American Leisure Products, Inc.*, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re International Taste, Inc.*, 53 USPQ2d 1604 (TTAB 2000); *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 641 (TTAB 1984); *In re Consolidated Foods Corp.*, 200 USPQ 477 (TTAB 1978); *In re Scholastic Testing Service, Inc.*, 196 USPQ 517 (TTAB 1977).

Even so, it is worth noting that several of the registrations presented in support of the applicant's argument show use of the mark that is considerably different from the use in the instant application. For instance, Registration No. 2,609,471 for the mark SYDNEY OMARR'S, shows the mark used as the portion of the title of several books. Registration No. 2,698,054 for the mark DR. SUESS and Registration No. 2,231,032 for the mark AGATHA CHRISTI, show use of the mark in advertising and

promotional material in addition to the books. Registration No. 2,630,156 features a word mark combined with a design which is used on the spine of the books.

The examining attorney maintains that in the instant application the proposed mark merely functions as the name of the author of the books. Generally, subject matter used solely as an author's name, even on multiple books, does not function as a trademark. *See In re Chicago Reader Inc.*, 12 USPQ2d 1079 (TTAB 1989) (CECIL ADAMS as used on the specimens merely identifies the author and is not used as a trademark); *Cf. In re Wood*, 217 USPQ 1345 (TTAB 1983) (artist's pseudonym YSABELLA, affixed to an original work of art, functioned as a trademark). TMEP §1202.09.

Returning to the applicant's argument that this case should be controlled by the reasoning of *In re Wood*, 217 USPQ 1345 (TTAB 1983), the examining attorney points out that in that case, the Board clearly limited its decision to an artist's name affixed to an original work of art:

“Lest we be accused of painting with too broad a brush, we hold only that an artist's name affixed to an original work of art may be registered as a mark and that here applicant's name, as evidenced by some of the specimens of record, functions as a trademark for the goods set forth in the application.”

Therefore, the final refusal is maintained.

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