

THIS OPINION
IS NOT A PRECEDENT OF
THE T.T.A.B.

Hearing:
May 5, 2009

Mailed:
June 18, 2009
jtw

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sayah

Serial No. 76486273

Ali Kamarei, Esq. and Alexander Chen, Esq. of InHouse IP
Counsel for Kathy Sayah.

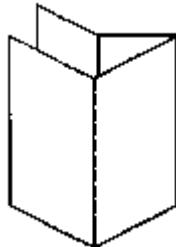
Linda Mickleburgh, Trademark Examining Attorney, Law Office
106 (Mary I. Sparrow, Managing Attorney).

Before Quinn, Hairston and Walsh, Administrative Trademark
Judges.

Opinion by Walsh, Administrative Trademark Judge:

On January 30, 2003, Kathy Sayah (Applicant) applied to register the subject matter shown below on the Principal Register for services now identified as "advertising agency namely, promoting the services of the travel, entertainment, and restaurant industry through the distribution of printed promotional materials, rendering sales promotion advice, and dissemination of advertising matter" in International Class 35 and "printing services"

in International Class 40. Applicant asserts that she first used the mark anywhere and first used the mark in commerce in September 1994 as to both classes.



Applicant also made the following statements in the application:

Color is not claimed as a feature of the mark.

and

The design consists of the size and shape of folded printed materials finished to a size of approximately 2 inches by 4 inches; the location of a business name or picture on the front cover; the location of a map and a border of approximately one sixteenth of an inch on the back cover; the location of a product or a price list between the front and back cover. The name of the business and the map are not part (sic) of the design.

On the basis of this description, for convenience, we will refer to Applicant's mark as "the Folded Printed Material Design." The application also includes a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f).

The Examining Attorney has issued a final refusal on the grounds that the Folded Printed Material Design Applicant seeks to register does not function as a service mark under Trademark Act Sections 1, 2, 3 and 45, 15 U.S.C. §§ 1051, 1052, 1053 and 1127. The Examining Attorney explains, "In this case the consumer will not perceive the design in the drawing as a service mark designation for applicant's services." Examining Attorney Final Action of September 26, 2007, at 2.

Applicant has appealed. Both Applicant and the Examining Attorney have filed briefs, and both also took part in an oral hearing on May 5, 2009. We affirm.

At the time of appeal the Examining Attorney had also refused registration on the grounds that the mark as used in the specimens did not conform to the mark as shown in the drawing. In the course of the oral argument the Examining Attorney withdrew that ground for refusal. At the hearing Applicant explained that the specimens Applicant submitted electronically were examples of the folded printed material depicted in the drawing in a flattened, opened-out form.

The prosecution history for this application is lengthy and far from a model of effective communication. The Examining Attorney issued eight Office actions over the

course of nearly six years and Applicant responded to each. From the outset Applicant had difficulty identifying both her mark and her services. For example, Applicant offered the following explanation of her application early in the prosecution, "The drawings and specimens submitted are not what Applicant seeks to trademark, they were submitted purely in order to proffer evidence of the trade dress sought. Applicant seeks to trademark, in the form of a trade dress, the services they offer." Applicant's Response of January 30, 2004, at page 7. Late in the prosecution Applicant states, "Here, as indicated by the specimens that were submitted on 12/27/2004, the design was used to represent services. Specially, (sic) the specimens clearly indicate that the service, as offered and associated with the design, include (sic) menu editing, menu printing and menu updating." Applicant's Response of May 30, 2007, at 2.

The eight Office actions, though adequate for the purpose of stating the ultimate ground for refusal, failed to alleviate Applicant's confusion. Perhaps one or more phone calls to Applicant would have been more effective in this regard.

In our consideration of the refusal, of course, we are bound by the mark and the services as identified in the

application recited above. The identification of the mark and the identification of the services are broad to say the least.

Though it is not immediately apparent from the wording in the application, the record indicates that Applicant is in the business of producing pocket-sized printed restaurant menus. See Specimens Submitted with the Application at Filing. The menus consist of four, two-sided panels which fold to pocket size. The front panel of the menu features the name of the restaurant and/or logos and/or photos related to the particular restaurant. The "inside" panels include a list of the menu items offered by the restaurant, and the back panel features a small map showing the location of the restaurant. Along with the pocket-sized menus, applicant provides small display boxes which the restaurant may use to make the menus available to customers when they enter or leave the restaurant. The obvious purpose of the pocket-sized menu is to promote the restaurant and to facilitate future visits or orders. During the oral hearing, Applicant confirmed that she was not attempting to register the Folded Printed Material Design for the menus, as such, but for the identified advertising agency and printing services.

To clarify the issue before us, while the development and printing of the menus certainly falls within the broad identification of services in both classes covered by the application, the identified services are far broader.

Applicant's services include "advertising agency namely, promoting the services of the travel, entertainment, and restaurant industry through the distribution of printed promotional materials, rendering sales promotion advice, and dissemination of advertising matter" and "printing services." Obviously, these services extend well beyond the narrow field of producing pocket-sized, promotional restaurant menus.

Turning to the arguments, Applicant first argues:

Despite an explicit finding in the Examiner's March 15, 2006, office action, based upon those same specimens, that the mark had acquired secondary meaning, the Examiner claims that the mark neither distinguishes the services of the application (sic) from those of others nor indicates the source. No where (sic) in the Examiner's response to Applicant's request for reconsideration is there an explanation of what led the trademark office to a finding of "secondary meaning" or an explanation of what caused the Examiner to change her mind.

Applicant's Brief at 8.

Through this argument, Applicant appears to assert (1) that the Examining Attorney made an explicit finding that the Folded Printed Material Design had acquired

distinctiveness and was entitled to registration on the Principal Register, and (2) that the Examining Attorney was bound to adhere to that finding thereafter. We find no support in the record or the law for either proposition.

First, in the March 15, 2006 Office action the Examining Attorney stated, "The applicant has shown evidence that the product configuration has acquired secondary meaning, therefore, the Examining Attorney sets out the following section 2(f) information." Next, the Office action provides what appears to be a boiler-plate explanation of the law governing product configurations and showings of acquired distinctiveness in such cases. The letter then states, "If the applicant wishes to register its (sic) mark on the Principal Register under Section 2(f), it (sic) should make such a statement in its (sic) response."

We find the Office action both curious and confusing in view of the fact that Applicant had filed the application with a claim of acquired distinctiveness. However, we find no basis in the letter to conclude that the Examining Attorney had determined either that the Applicant had made a sufficient showing that the Folded Printed Material Design had acquired distinctiveness or that the Folded Printed Material Design was entitled to

registration as a mark on the Principal Register.

Furthermore, even if we were to construe the Office action as Applicant urges, that is, as a finding that the Folded Printed Material Design was distinctive and registrable on the Principal Register, all subsequent actions by the Examining Attorney make it abundantly clear that the Examining Attorney had determined that the Folded Printed Material Design did not function as a mark and that it was not registrable on the Principal Register. That determination necessarily includes a determination that the Folded Printed Material Design had not acquired distinctiveness as a mark.

The Examining Attorney had initially refused registration based on a determination that the Folded Printed Material Design was functional. Based on Applicant's submissions, and after further consideration, the Examining Attorney determined that the Folded Printed Material Design did not function as a mark and issued the refusal on that basis. The Examining Attorney acted properly in refining the basis for refusal. It is that basis for refusal which is properly before us in this appeal, and which we will now proceed to consider.

In sum, we reject all of Applicant's arguments based on the proposition that the Examining Attorney had accepted

Applicant's showing of acquired distinctiveness and that any such action would be irrevocable in the prosecution process. Although Applicant has not explicitly argued so, we will consider whether the Folded Printed Material Design is either inherently distinctive or has acquired distinctiveness, and whether the Examining Attorney's determination that Folded Printed Material Design does not function as a mark is in error.

The Examining Attorney argues that the Folded Printed Material Design does not function as a mark, stating: "The differing forms [specimens] show no consistent service mark usage. Their placement in the brochures in various forms and in informational sections does not rise to service mark usage. Their use, in other words, would not be viewed by a potential customer as indicating a source of the folded menus." Examining Attorney's Brief at unnumbered page 2.

Later the Examining Attorney argues further:

The applied-for mark, as shown on the specimen and representing the ultimate goods purchased through applicant's services, does not function as a service mark because it is not used in a consistent manner in the form that appears on the drawing page of record such that a purchaser, viewing the various forms of the goods, drawn or photographed, would perceive them as a single source indicator for the applicant's "advertising agency namely, promoting the services of the travel, entertainment, and restaurant industry through the distribution of printed promotional materials, rendering sales promotion advice, and

dissemination of advertising matter" in International Class 35 and "printing services" in International Class 40.

Id. at unnumbered page 7.

Before addressing the refusal, as such, we wish to address applicant's specimens to confirm that they are the appropriate type of specimens to show service mark use for the identified services. Trademark Act Section 1(a) requires that an applicant submit "specimens or facsimiles of the mark as used" as part of the application. 15 U.S.C. § 1051(a)(1). Trademark Act Section 45 provides further that a mark is "in use in commerce . . . on services when it is used or displayed in the sale or advertising of the services." 15 U.S.C. § 1127. The Trademark Rules likewise specify, "A service mark specimen must show the mark as actually used in the sale or advertising of the services." 37 C.F.R. § 2.56(b)(2).

A specimen used in the rendering of the services may suffice to show service mark use. *In re Eagle Fence Rentals, Inc.*, 231 USPQ 228, 231 (TTAB 1986). In this case, the folded menus qualify as specimens showing use of the Folded Printed Material Design in the rendering of both

the advertising agency services and the printing services.¹

Of course, whether the Folded Printed Material Design functions as a mark is an entirely different question.

Turning to the question as to whether the Folded Printed Material Design functions as a mark, we conclude that Applicant has failed to show that the Folded Printed Material Design is either an inherently distinctive mark or a mark which has acquired distinctiveness.

In *Two Pesos*, an infringement case arising under Trademark Act Section 43(a), 15 U.S.C. § 1125(a), the Supreme Court held that trade dress employed in the rendering of restaurant services could be, and in that case was, inherently distinctive. *Two Pesos Inc. v. Taco Cabana Inc.*, 505 U.S. 763, 23 USPQ2d 1081 (1992). While trade dress used with services *may be* inherently distinctive, not all such trade dress *is* inherently distinctive. The facts of each case dictate that determination. *In re File*, 48 USPQ2d 1363 (TTAB 1998) (trade dress for bowling alley services consisting of "tubular lights running lengthwise down bowling lanes projecting over the gutters" held not inherently distinctive because "... customers for bowling

¹ For the record, Applicant has also provided specimens consisting of its own advertising brochures promoting its menu program which employs the general format of the Folded Printed Material Design, but without a map, as well as advertising where the menus in the Folded Printed Material Design are depicted.

alley entertainment services would regard applicant's trade dress simply as an element of interior decoration and would not, therefore, immediately perceive such trade dress as a source indicator"), See also *In re Hudson News Co.*, 39 USPQ2d 1915 (TTAB 1996), aff'd per curiam, 114 F.3d 1207 (Fed. Cir. 1997).

In another trade dress case, the Supreme Court recognized that there are cases where it is not reasonable to assume that relevant consumers are predisposed to view certain types of trade dress as source indicators.

Wal-Mart Stores v. Samara Bros., 529 U.S. 205, 54 USPQ2d 1065, 1068 (2000). This "predisposition" is key in determining whether or not particular trade dress is inherently distinctive.

In this case we conclude, without hesitation, that Applicant's Folded Printed Material Design is not the type of trade dress which relevant consumers are predisposed to view as a source indicator. See, e.g., *In re Hudson News Co.*, 39 USPQ2d at 1923. We likewise conclude, without hesitation, that the Folded Printed Material Design is not inherently distinctive.

The elements Applicant identifies as her mark are extremely common elements in use in the advertising or rendering of both advertising agency and printing services.

This is true whether we view the elements alone or in combination. Applicant describes her mark as follows:

The design consists of the size and shape of folded printed materials finished to a size of approximately 2 inches by 4 inches; the location of a business name or picture on the front cover; the location of a map and a border of approximately one sixteenth of an inch on the back cover; the location of a product or a price list between the front and back cover. The name of the business and the map are not party (sic) of the design.

First, applicant identifies the size as an element of her mark, a common size for printed material suitable for carrying in a pocket. At the same time Applicant specifies that the printed material can be folded. These mundane characteristics fail to define anything which is remotely distinctive.

Next, Applicant specifies that there is a business name or picture on the cover - again, a common feature of printed material used in advertising or printing. This element is so open-ended as to be meaningless for the purpose of defining anything distinctive. Cf. *In re International Flavors & Fragrances Inc.*, 183 F.3d 1361, 51 USPQ2d 1513 (Fed. Cir. 1999).

Next, Applicant specifies that the mark includes a map with a border which appears on the back cover of the folded printed material. This element is also a common

characteristic of printed material used in advertising or printing. We also note here that Applicant's menu specimens are not consistent in the display of a border with the maps.

Lastly, applicant identifies a product or price list in the inside of the printed material as an element of her mark. This would describe virtually any piece of printed advertising material. Here again, this element is so open-ended as to be meaningless for the purpose of defining a mark. *Id.*

These elements, whether viewed individually or together, are characteristics of many, if not most, advertisements or other printed material used by businesses in the travel, entertainment, and restaurant industry, or elsewhere. To be charitable, the proposition that potential purchasers of Applicant's advertising agency or printing services will view the Folded Printed Material Design as an inherently distinctive source indicator is not credible.

In arguing that the Folded Printed Material Design is inherently distinctive, Applicant places great reliance on the opinion in *Computer Care v. Service Systems Enterprises Inc.*, 982 F.2d 1063, 25 USPQ2d 1020 (7th Cir. 1992). In that trade dress infringement case, the plaintiff claimed

trade dress rights in the design of its reminder letters, brochures and monthly reports which it provided as part of a program for auto dealerships and repair shops to generate auto-servicing business. In analyzing the potential distinctiveness of the trade dress the Court states:

Computer Care's trade dress, as embodied in its sales brochure, reminder letters and monthly reports, is neither generic nor descriptive. Of course, some of its elements, such as the use of a window envelope to send out reminder letters, are arguably generic, see *Roulo*, 886 F.2d at 936; others, for example the illustrations in its sales brochure and the titles of its monthly reports, are arguably descriptive. But Computer Care's trade dress also contains elements that are at least suggestive, such as the blue right-angled design on the reminder letters and envelopes... And it has many features that appear to be arbitrary, including the three "Win or Lose" pairs on the first page of the brochure; the layout of the brochure; the division of the monthly dealer information into three reports, with particular columns of information in a particular order; and the use of a certain shade of blue for the right-angled design and the manufacturer's logo on the reminder letters.

...

Where the plaintiff's overall trade dress is distinctive, the fact that it uses descriptive (or generic) elements does not render it nonprotectable. *Taco Cabana*, 932 F.2d at 1120; *Roulo*, 886 F.2d at 936.

Id. at 1024. The Court ultimately concluded that the overall trade dress is inherently distinctive.

In contrast, the elements Applicant here describes as comprising her mark are all highly descriptive or generic.

Unlike the trade dress in the *Computer Care* case, there are no suggestive or arbitrary elements which render the Folded Printed Material Design inherently distinctive overall. In fact, the elements of the Folded Printed Material Design are so common that Applicant faces a substantial, if not insurmountable burden, in establishing that the Folded Printed Material Design has acquired distinctiveness, a question we will now address.

The Application asserts use of the Folded Printed Material Design in commerce since September 1994. Also, Applicant has provided an affidavit in support of her claim that the Folded Printed Material Design has acquired distinctiveness. The affidavit states that over 58,000,000 menus and brochures employing the Folded Printed Material Design have been distributed in the United States, and that over 170,000 sales brochures and leaflets bearing the Folded Printed Material Design have been distributed. Applicant also states that the Folded Printed Material Design has been displayed in the lobbies of over 500 hotels and motels throughout the United States, that the relevant market and consumers, including 4,300 restaurants, have been exposed to the mark. Applicant also estimates that over 27,000 hotel staff and over 50 million tourists and visitors are exposed to the Folded Printed Material Design

annually. Finally, Applicant states that she has spent \$540,000 on advertising activities, such as, brochures, direct mailings, gift packs, sales calls, website development and other activities to promote the Folded Printed Material Design. Applicant's Affidavit, dated December 14, 2004.

Absent from the record is any evidence which would show what impact that these various activities have had on relevant consumers. That is, we have no evidence, and certainly no direct evidence, that anyone perceives the Folded Printed Material Design as a source indicator for Applicant's services. This is especially important in a case, such as this one, where the alleged mark is so broadly and even vaguely defined. Accordingly, we find Applicant's evidence of acquired distinctiveness wholly insufficient under the circumstances of this case.

The reference to the large number of menus distributed appears to relate to sales volume. However, high sales are of little probative value in a case such as this; high sales do not necessarily translate into recognition of trade dress as a mark. *Braun Inc. v. Dynamics Corp. of America*, 975 F.2d 815, 24 USPQ2d 1121, 1133 (Fed. Cir. 1992); *Pingel Enterprise Inc.*, 46 USPQ2d 1811, 1822 (TTAB 1998).

With regard to Applicant's claim of use since 1994, a mere statement of at least five years use is not generally accepted in applications to register trade dress; applicants face a heavy burden in such cases. See *In re Ennco Display Systems Inc.*, 56 USPQ2d 1279, 1284 (TTAB 2000) and cases cited therein. Under the circumstances of this case, where applicant asserts use for about fifteen years, the claim of long use has little probative value. *Stuart Spector Designs Ltd. et al. v. Fender Musical instruments Corp.*, __ USPQ2d __, Opposition No. 91161403 et al., Slip Opinion at 60 (TTAB, March 25, 2009) (fifty years use held insufficient to show guitar design mark had acquired distinctiveness). As we noted, the burden for the purpose of showing acquired distinctiveness is especially high in this case due to the broad description of Applicant's Folded Printed Material Design. Applicant's evidence falls far short of meeting that burden.

Accordingly, we conclude that Applicant has failed to show that the Folded Printed Material Design is either inherently distinctive or that it has achieved acquired distinctiveness.

Decision: As to both classes, we affirm the refusal to register the asserted mark under Trademark Act Sections

Serial No. 76486273

1, 2, 3 and 45, on the grounds that the Folded Printed
Material Design does not function as a mark.