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UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICANT: Electric Art, Inc.

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**BEFORE THE
TRADEMARK TRIAL
AND APPEAL BOARD
ON APPEAL**

MARK: ELECTRIC ART

CORRESPONDENT'S REFERENCE/DOCKET NO: 35580-190632

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

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.

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the Trademark Examining Attorney's final refusal to register the mark ELECTRIC ART on the grounds that the mark is merely descriptive when used on the identified goods and in connection with the identified services under Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052 (e)(1).

I. FACTS

On July 30, 2004, the applicant filed the present application seeking to register the mark ELECTRIC ART for "Graphic art prints and reproductions," and "On-line retailing and wholesale distributorship services, catalog mail order services and

telephone order services, all in the field of graphic art prints and reproductions and sculptures.” In the Office action dated March 13, 2005, the examining attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052 (e)(1), because the mark was merely descriptive of the goods and services. On May 11, 2005, the examining attorney made the refusal under Section 2(e)(1) final. On October 26, 2005, the examining attorney denied the applicant’s request for reconsideration. Thus, this appeal concerns the examining attorney’s final refusal under Section 2(e)(1).

II. ARGUMENTS

THE APPLICANT’S MARK IS MERELY DESCRIPTIVE WITHIN THE MEANING OF SECTION 2(e)(1) OF THE TRADEMARK ACT, 15 U.S.C. SECTION 1052 (e)(1).

A mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods or services. *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). The question of whether or not a mark is merely descriptive must be determined not in the abstract, but rather in relation to the goods or services for which registration is sought, the context in which the mark is used in connection with those goods or services, and the possible significance which the mark would have, because of the context in which it is used, to the average purchaser of the goods or services in the market place. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Broco*, 225 USPQ 227 (TTAB 1984). It is not necessary that a term describe all of the purposes, functions, characteristics or features of the goods or services to be merely descriptive. It is enough

if the term describes one attribute of the goods or services. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

In the present case, the applicant seeks to register the mark ELECTRIC ART for “Graphic art prints and reproductions,” and “On-line retailing and wholesale distributorship services, catalog mail order services and telephone order services, all in the field of graphic art prints and reproductions and sculptures.”

The proposed mark ELECTRIC ART merely describes the nature and characteristics of the applicant’s goods and services, i.e., art that is operated by electricity and retail and wholesale ordering and distributing services that feature art operated by electricity. The term ELECTRIC is defined as “Of, relating to, or operated by electricity: electric current; an electrical appliance.” The term ART is defined “2. a. The conscious production or arrangement of sounds, colors, forms, movements, or other elements in a manner that affects the sense of beauty, specifically the production of the beautiful in a graphic or plastic medium. b. The study of these activities. c. The product of these activities; human works of beauty considered as a group.” Office action dated March 13, 2005, at p. 1.

The term ART merely names the applicant’s goods and the primary type of goods featured by the applicant’s services. As such, it is generic and incapable of functioning as an indicator of source. A term that is generic for goods and identifies the primary articles of a store or distributorship service, is generic for services featuring those goods. *In re A La Vieille Russie, Inc.*, 60 USPQ2d 1895 (TTAB 2001) (RUSSIANART generic for dealership services in the field of fine art, antiques, furniture and jewelry); *In re Log Cabin Homes Ltd.*, 52 USPQ2d 1206 (TTAB 1999) (LOG CABIN HOMES

generic for retail outlets selling kits for building log homes); *In re Bonni Keller Collections Ltd.*, 6 USPQ2d 1224 (TTAB 1987) (LA LINGERIE held generic for retail stores specializing in the sale of lingerie); *In re Wickerware, Inc.*, 227 USPQ 970 (TTAB 1985) (WICKERWARE generic for mail order and distributorship services in the field of products made of wicker); *In re Half Price Books, Records, Magazines, Inc.*, 225 USPQ 219 (TTAB 1984) (HALF PRICE BOOKS RECORDS MAGAZINES generic for retail book and record store services). In fact, the applicant concedes the descriptive nature of the term ART and has disclaimed the term apart from the mark as shown. Application filed July 30, 2004, at p. 4.

Furthermore, the applicant does not dispute the fact that its art is electric. See Applicant's Appeal Brief. Internet web pages from the applicant's web site indicate that the applicant's graphic art prints and reproductions are "accented with special lighting effects including Fiber Optics, L.E.D.s, Neon and Mini Light Bulbs." See attachment to Office Action Denying Request for Reconsideration dated October 26, 2005, at p. 1. As such, the term ELECTRIC merely describes the applicant's art that is powered by electricity. Despite this fact, the applicant argues that the term ELECTRIC conveys a double meaning rendering the proposed mark unitary and "at most suggestive" of the identified goods and services. Applicant's Appeal Brief at pp. 4-7. The examining attorney respectfully disagrees.

Contrary to the applicant's assertion, the use of the term ELECTRIC in the mark ELECTRIC ART does not create a double meaning as applied to art that features electric components and is powered by electricity. A "double entendre" is a word or expression capable of more than one interpretation. The multiple interpretations

that make an expression a "double entendre" must be associations that the public would make fairly readily. *In re The Place, Inc.*, 76 USPQ2d 1467, 1470 (TTAB 2005); *In re Wells Fargo & Co.*, 231 USPQ 95 (TTAB 1986). The applicant correctly notes that a mark that comprises a "double entendre" will not be refused registration as merely descriptive if one of its meanings is not merely descriptive in relation to the goods or services. TMEP 1213.05(c). However, for trademark purposes, a "double entendre" is an expression that has a double connotation or significance as applied to the goods or services. *Id.*

Relying on the second meaning listed in the dictionary definition provided by the examining attorney that defines ELECTRIC as “emotionally exciting; thrilling, gave an electric reading of the play. b. Exceptionally tense; highly charged with emotion: an atmosphere electric with suspicion,” the applicant asserts that the term conveys a meaning “of art that is fun, exciting or even whimsical.” Applicant’s Appeal Brief at p. 5. The applicant urges that the term ELECTRIC when combined with other terms may create an impression other than “operated by electricity” and states:

For example, when the term ELECTRIC is combined with a common term for a line dance, the SLIDE, the combination ELECTRIC SLIDE does not immediately call to mind something operated by electricity. Rather, the impression is of fun and excitement. To be sure, as stated in the ELECTRIC SLIDE by the artist Grandmaster Slice, "You can't see it, It's electric!, You gotta feel it, It's electric!, Ooh, it's shakin' It's electric!"

Applicant’s Appeal Brief at p. 7.

However, the applicant offers nothing more than its own conjecture that the term would be understood in this manner. The applicant has offered no evidence showing the term ELECTRIC used in reference to art that is not electrically powered.

Rather, all of the evidence of record shows the term ELECTRIC used to describe art that features electric lighting components. Further, while use of the term ELECTRIC in connection with a line dance that is not actually powered by electricity may show the term used in the metaphorical sense to convey the idea of highly charged excitement, in the instant application, the term ELECTRIC is used in connection with goods that are, in fact, electric and the standard meaning clearly applies. Thus, in the relevant context, the natural and obvious meaning of the term ELECTRIC as applied to art that features electric lighting elements, is of art that is operated by electricity. The mark immediately informs consumers that the applicant's art is electric. For this reason, the term ELECTRIC has not been shown to have a separable nondescriptive connotation or significance as applied to the applicant's goods and services, and the mark ELECTRIC ART does not create a double meaning.

In support of the refusal to register, the examining attorney has made numerous Lexis-Nexis® and Internet web pages of record showing the term ELECTRIC used in reference to art. A Lexis-Nexis® search query for “electric w/2 art and (neon or light!)” produced the following five story excerpts showing the term ELECTRIC used in connection with the term ART:

American Gallery, 6600 Sylvania Ave., Sylvania, presents Dream in Neon, an exhibition presenting the new work of Philip Hazard. On display will be electric pop art, neon, and mixed-media collage painting. The exhibit is scheduled to open tomorrow with a reception from 6-8 p.m., and will be on view through July 7. Gallery hours: 10 a.m. to 5 p.m. ...

...In the '30s Malina, like many socially conscious intellectuals, had flirted with communism. The FBI had a file on him. In the early 1950s Malina began to harness his

engineering expertise in the service of "kinetic art," incorporating electric lights and motion into his paintings.

Kevin said: "They are very realistic and scary. They are appealing to the age bracket which grew up with the original series." Also good sellers are electric light art pictures which plug into mains sockets and feature LED displays and neon tubing...

Instead of canvas and paint, Dan Flavin created art with fluorescent light tubes, a technique that made him an important figure in the experimental art world of the later 20th century... It was another three years before he had a show of art made with electric lights, and then there were two shows in the same year. In 1976 there were eight one-man exhibits of his work, from Portland, Ore., to Cologne, Germany. Critics call Flavin a "minimalist," not a fashionable style today but still praised for its innovations. His work has remained prized. One 12-foot piece using fluorescent light brought \$679,500 at a New York auction last May.

Artists have been illuminating churches since medieval times, of course, though never quite like this. The nave and aisles hum and flicker with the astringent light of neon installations. Ancient stained glass competes with its modern, high-wattage equivalent. Artists have been toying with the possibilities of artificial light ever since it became possible to plug in. The Dutch-American artist Thomas Wilfred tried to get his "Lumia" movement off the ground in the early 1900s, but it was as a branch of minimalism that electric art really came into its own, typified by Dan Flavin's buzzing grids of fluorescent tubes.

See story excerpts nos. 40, 71, 98, 110, and 121 attached to Office Action Denying

Request for Reconsideration dated October 26, 2005. [Emphasis added.]

Similarly, a Lexis-Nexis® search query for "electric art" produced the following three story excerpts:

...Neon signs weren't invented in Los Angeles (Paris gets credit), but in the 1920s and '30s they were embraced here as if they had been. The small but fun Museum of Neon

Art pays tribute to neon and other electric art, both historic and contemporary.

...Resort Superstore is holding its grand opening at 2500 Vista Way from 11 a.m. to 6 p.m. today. The store carries game tables, billiards, spas, barbecue islands, waterfalls, patio furniture and electric art.

Distinctive neon wall clocks (from \$89.99). And framed "electric art" featuring vintage American scenes with neon and LED lighting effects accents. (from \$99.50)

See story excerpts nos. 37, 38 and 48 attached to the Final Office Action dated May 11, 2005. [Emphasis added.]

The applicant argues that three story excerpts should be disregarded as originating with publications from the United Kingdom that may include words such as "pants" that may have different meanings due regional differences in English usage. Applicant's Appeal Brief at pp. 9, 12-13. However, materials obtained through computerized text searching are competent evidence to show the descriptive use of terms under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1). *In re National Data Corp.*, 222 USPQ 515, 517 n.3 (TTAB 1984); TMEP §710.01(a). More importantly, the applicant fails to point to a single term within the excerpted text that it believes to be misleading due to such usage variations. The Lexis-Nexis® story excerpts clearly reference art that comprises electrical lighting features.

The examining attorney has also made of record web pages that offer "electric art" and web pages that refer to art that is electrically powered. See attachments to Final Office Action dated May 11, 2005, at pp. 2-9 and attachments to Office Action Denying Request for Reconsideration dated October 26, 2005, at pp. 3-9. Of particular note is the web page from www.artcom.com describing the Museum of Neon Art as "a

non-profit, cultural and educational organization which exhibits, documents and preserves contemporary fine art in electric media and outstanding examples of neon signs” with highlights and collections that include “Neon, electric and kinetic fine art” and a “permanent collection of historic neon signs and fine art in electric media.” See attachments to Office Action Denying Request for Reconsideration dated October 26, 2005, at pp. 6-8. [Emphasis added.] The museum’s own web page states:

The Museum of Neon Art (MONA) was founded to document, preserve, restore and collect outstanding examples of neon signs; and to educate the public about the cultural, historical, aesthetic and technical aspects of electric art.

Id., at p. 9. [Emphasis added.]

Finally, the applicant argues that five of the attached story excerpts and web pages do not demonstrate descriptive use of the proposed mark because they may refer to the applicant. Applicant’s Appeal Brief at pp. 9-13. Even assuming the applicant to be correct, the fact that an applicant may be the first and sole user of a merely descriptive or generic designation does not justify registration where the evidence shows that the term is merely descriptive of the identified goods and services. *In re Acuson*, 225 USPQ 790 (TTAB 1985) (COMPUTED SONOGRAPHY descriptive of ultrasonic imaging instruments); *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983) (SHOOTING, HUNTING, OUTDOOR TRADE SHOW AND CONFERENCE held apt descriptive name for conducting and arranging trade shows in the hunting, shooting and outdoor sports products field); TMEP §1209.03(c).

Descriptiveness is considered in relation to the relevant goods and services. In the present case, the mark immediately serves to inform consumers of a

feature or characteristic of the applicant's goods and services. The applicant's goods comprise art that features electric lighting effects. The applicant's services feature these same goods. Accordingly, the mark ELECTRIC ART merely describes the applicant's goods and services comprising art that is electric.

III. CONCLUSION

For the foregoing reasons, the refusal to registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052 (e)(1), should be affirmed.

Respectfully submitted,

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