

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Mailed:
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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Harte-Hanks, Inc.

Serial No. 77017666

Stacey C. Friends of Ruberto Israel & Weiner, P.C. for
Harte-Hanks, Inc.

Janice L. McMorrow, Trademark Examining Attorney, Law Office
115 (Tomas V. Vlcek, Managing Attorney).

Before Quinn, Bucher and Ritchie, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Harte-Hanks, Inc. seeks registration of the term **THE
FLYER** (*in standard character format*) for services recited in
the application, as amended, as follows:

"advertising services, namely, providing
advertising space in advertising publications in
the nature of a shopper; providing advertising
space in online publications in the nature of an
online shopper; and distributing advertising
publications in the nature of a shopper" in
International Class 35.¹

¹ Application Serial No. 77017666 was filed on the Principal Register on October 10, 2006 based upon claims of first use anywhere and first use in commerce at least as early as November 30, 1977. In its original application papers, applicant claimed that its "mark has become distinctive of the goods/services through the applicant's substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement."

The Trademark Examining Attorney finally refused registration on the ground that the applied-for term is generic when used in connection with applicant's advertising services.

Applicant requested reconsideration by the Trademark Examining Attorney on October 9, 2008, while also appealing to this Board the Office's final refusal to register. On December 8, 2008, the Trademark Examining Attorney denied applicant's request for reconsideration. On March 20, 2009, the Trademark Examining Attorney filed a request for remand that the Board granted. Then, on April 14, 2009, the Trademark Examining Attorney issued another Office action, having attached to it what she characterized as additional evidence of genericness. On November 11, 2009, the Trademark Examining Attorney reinstated the Final refusal to register, and on January 8, 2010 applicant filed a supplemental brief including six exhibits (Exhibits A - F). In her brief of March 8, 2010, the Trademark Examining Attorney has clarified that in the event we should find the applied-for term to be capable of distinguishing the named services, applicant's evidence of acquired distinctiveness is sufficient to support a registration on the Principal Register under Section 2(f) of the Act. Accordingly, the issue of genericness is the only issue before us.

For the reasons discussed below, we reverse the refusal to register.

The Trademark Examining Attorney argues that the genus of the applicant's services is advertising flyer services, and that the evidence of record shows that the term "flyer" is understood by the relevant public primarily to refer to this very type of advertising circular.

By contrast, applicant argues that the evidence of record supports its conclusion that a "flyer" and a "shopper" are two different things and the two words should not be used interchangeably; that applicant publishes a weekly shopper newspaper, not an advertising flyer; that applicant's **THE FLYER** is the only shopper so-named; and that applicant's shopper newspaper is never referred to in a generic sense as a "flyer" by members of the public or journalists, nor is it so used by applicant's competitors to refer to their own shopper newspapers or related services.

Preliminary matter

Before addressing the merits of this appeal, we consider the Trademark Examining Attorney's objection to Exhibits A, C, D, E and F as an attempt by applicant to introduce new evidence. This evidence was submitted for the first time with applicant's appeal brief. The

objection is well taken, the materials do not form part of the appeal record and hence, they have not been considered in reaching our decision. Trademark Rule 2.142(d).

Genericness

As noted by the Trademark Examining Attorney, the test for determining whether an applied-for term is generic is a two-part inquiry. First, we ask, what is the class or genus of the services? Second, is the applied-for term understood by the relevant public primarily to refer to that genus of services? See *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986).

The present application recites the relevant services as "advertising services, namely, providing advertising space in advertising publications in the nature of a shopper; providing advertising space in online publications in the nature of an online shopper; and distributing advertising publications in the nature of a shopper."

Throughout the prosecution of this application, applicant has argued at length that an advertising flyer has far fewer pages than does an advertising shopper. To counter that position, the Trademark Examining Attorney points out that that the dictionary definitions she

proffered provide no page limitations in defining an advertising "flyer."

The Trademark Examining Attorney submitted several dictionary definitions for the word "flyer":

flyer

variant of FLIER ²

fli-er

Variant(s): also **fly-er** \ˈflī(-ə)r\

Function: *noun*

Date: 15th century

1 : one that flies; *specifically* : AIRMAN

2 : a reckless or speculative venture —usually used in the phrase *take a flier*

3 : usually flyer : an advertising circular ³

flyer or flier

Noun

1. A small advertising leaflet
2. a person or thing that flies or moves very fast
3. *Old Fashioned*, an aircraft pilot

Thesaurus

Noun 1. flyer - an advertisement (usually printed on a page or in a leaflet) intended for wide distribution; "he mailed the circular to all subscribers"

broadsheet, broadside, circular, handbill, throwaway, flier, bill ⁴

² <http://www.merriam-webster.com/dictionary/flyer>, Merriam-Webster Online Dictionary, 2008. While applicant's mark is spelled with a "y," the variant spellings will often be used interchangeably and have no legal significance in this case.

³ <http://www.merriam-webster.com/dictionary/flier>, Merriam-Webster Online Dictionary, 2008.

⁴ <http://www.thefreedictionary.com/flyer>

Applicant notes that these definitions do not come close to describing the forty- to seventy-page newspapers filled with hundreds of classified and display advertisements that applicant prints and circulates. To further provide a contrast, applicant also submitted for the record further listings of definitions for "flyer":

Overview of noun flyer

Sense 1: circular, handbill, bill, broadside, broadsheet, flier, **flyer**, throwaway - [an advertisement (usually printed on a page or in a leaflet) intended for wide distribution: "he mailed the circular to all subscribers"]

- stuffer -- (an advertising circular that is enclosed with other material and (usually) sent by mail)
- ad, advertisement, advertising, advert -- (a public promotion of some product or service)
- direct mail -- (advertising sent directly to prospective customers via the mail)
- mailer -- (an advertisement that is sent by mail)

⁵

flyer

See: [flier](#).

flier

An inexpensive, widely distributed handbill or circular of small size (usually 8½ x 11 inches), used

⁵ WordNet 3.0 Vocabulary Helper, Personalized Online Electronic Text Services, Kyoro Notre Dame University, <http://poets.notredame.ac.jp/cgi-bin/wn>

flat or folded for advertising and announcements. Also spelled *flyer*. Synonymous in the UK with *leaflet*.⁶

Definition

flier (INFORMATION) (US usually **flyer**)

noun [C]

a small piece of paper with information on it about a product or event⁷

flyer *noun*

fly· er, flier

1 a small sheet of paper advertising something:

People were giving out flyers advertising the event.

...

WORD FOCUS: advertisement ↓

poster on a wall, often with a picture on it

junk mail unwanted letters in the post, advertising things

flyer a sheet of paper with an advertisement on it, given to you in the street or pushed through your door

→ See also **ADVERTISEMENT**

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Flyer

Definition: One-page printed advertisement.⁹

Define Flyer

flyer. A single-sheet, printed advertisement.¹⁰

⁶ ODLIS – Online Dictionary for Library and Information Science, from Libraries Unlimited
http://lu.com/odlis/odlis_f.cfm#flier

⁷ Cambridge Advanced Learner's Dictionary,
http://dictionary.cambridge.org/dictionary/british/flier_1

⁸ Longman's Dictionary of Contemporary English,
<http://www.ldoceonline.com/Advertising+and+Marketing-topic/flyer>

⁹ MoneyGlossary.com Financial Glossary,
<http://www.moneyglossary.com/?w=Flyer>

¹⁰ The Travel Industry Dictionary, <http://www.travel-industry-dictionary.com/flyer.html>

Flyer (pamphlet)

A **flyer** (or **flier**) is a single page leaflet advertising a nightclub, event, service, or other activity. Flyers are typically used by individuals or small business and are a small scale, community communication.

Flyers are handed out on the street, posted on bulletin boards, or given away at events. Bulletin boards are found on college campuses, in cafes, community meeting houses, Laundromats and small markets.

Flyers, along with postcards, pamphlets and small posters, are vital and free forms of communication for people who want to engage the public but do not have the money or desire to take out classified advertising in a local newspaper. Their widespread use intensified with the spread of desktop publishing systems. In recent years, the production of flyers through traditional printing services has been supplanted by Internet services; customers may send designs and receive final products by mail. Flyers range in tone from humorous to irreverent or absurd. ¹¹

Redirected from flyer

flier

[Dictionary:](#)

fli·er fly·er (flī·ər) 

n.

1. One, such as an insect or bird, that flies with wings.
2. The pilot of an aircraft.
3. A passenger in an aircraft: *special fares for business fliers.*
4. **A pamphlet or circular for mass distribution.**
5. A step in a straight stairway.
6. *Informal.* A daring venture.
7. often flyer *Australian.* An exceptionally swift kangaroo.

[Barron's Marketing Dictionary:](#) **flier**

Advertising medium that is usually a single, standard-size (8 ½" x 11") page printed on one or both sides with an advertising message; also, *flyer*. Fliers are most often used in direct-mail advertising and as handbills given to customers by local retailers. In direct mail, they often accompany a formal letter to expand information in the letter. For the local retailer, fliers offer market coverage at low cost with little waste and good flexibility. However, fliers have a high throwaway rate. ¹²

¹¹ *Wikipedia - the Free Encyclopedia,*
[http://en.wikipedia.org/wiki/Flyer_\(pamphlet\)](http://en.wikipedia.org/wiki/Flyer_(pamphlet))

¹² <http://www.answers.com/topic/flyer>

We agree with applicant that these various, detailed dictionary entries for the word "flyer" (or "flier") fairly consistently refer to an advertising flyer as something "small" or "one-page" in length.¹³

The Trademark Examining Attorney points to references in the popular media to advertising flyers/fliers put out by individual retailers:

HEADLINE: *Shoppers Turn to Artisans for Gifts*
"... [T]oy stores' advertising fliers have been taunting children for weeks..."¹⁴

HEADLINE: *A Lowe's Moment*
"... [A] Lowe's spokesperson pointed out that the retailer did refer to them as Christmas trees in all of its television and magazine ads and in its advertising fliers."¹⁵

HEADLINE: *7-Eleven Adds Three New Healthy Snacks to its Stores*
"... Under the program ... the Boston Public Health Commission posted advertising flyers in the stores that encouraged schoolchildren to trade soft drinks for 100 percent fruit juice, low-fat milk, and plain water..."¹⁶

Applicant contends that consistent with the dictionary entries it has proffered, these articles refer to

¹³ Applicant also included references to Wordsmyth, Infoplease, Online Etymology Dictionary, Ultralingua Online Dictionary, Allwords.com, Compact Oxford English Dictionary, Dict.org, and Heinle's Newbury House Dictionary of American English.

¹⁴ *The Charlotte Observer*, November 25, 2007, at 6Y.

¹⁵ *Multichannel Merchant*, December 1, 2007, at 5.

¹⁶ *CSN at the Show*, January 22, 2008.

advertising flyers that are one-page advertisements emanating from one source - not a shopper publication of forty to seventy pages containing advertisements from hundreds (or even thousands) of different advertisers. Similarly, the 7-Eleven article is a reference to a leaflet inasmuch as one clearly could not "post" something having the heft of applicant's publication.

Applicant notes that the full text of the following article chosen by the Trademark Examining Attorney makes clear distinctions among a newspaper, a magazine, and an advertising flyer:

HEADLINE: *Readers, and Writers, Lament Loss of Vermont Sunday Magazine*

"... And the tabloid's shape made it hard for some readers to locate the magazine amidst the advertising flyers inserted in the Sunday paper..."¹⁷

The Trademark Examining Attorney's evidence included a long discussion of "Advertising Flyers" from an online advertisement for a printing business called "Color Printing Wholesale."¹⁸ However, a careful reading of this site (and other websites proffered by the Trademark Examining

¹⁷ *Seven Days* (Burlington, VT), January 30 - February 6, 2008, at 14A.

¹⁸ <http://www.colorprintingwholesale.com/Advertising-Flyer.html>

Attorney¹⁹) shows the limited printing options offered for publications that are clearly one-page flyers. Unlike the complexities of printing a newspaper, these flyers are easily designed by a sole proprietor for her own business. They are printed on a limited number of sizes of cardstock or heavy paper, foldable into two, three or four panels, printable on one side or both sides, etc. They are generally advertisements for a single business, and are variously referred to as brochures, circulars, handbills, leaflets, etc. This is nothing like the publication that applicant provides, namely, a forty- to seventy-page publication filled with pages and pages of classified and display advertising from hundreds of advertisers, possibly along with other news or editorial content.

From copies of other websites placed into the record, we find additional corroboration for the conclusion that in the field of printing, a flyer is generally a single sheet:

GotPrint.com

Options for the two-sided flyers could be in four single sheet sizes²⁰

¹⁹ <http://www.printplace.com/printing/advertising-flyers.aspx>, http://advertising.about.com/cs/agencies/ht/Create_Flyer.htm, <http://flyer.wegmans.com/>
<http://flyer.wegmans.com/wgm/index.html?z=PM&s=Potomac&n=55&ad=7th2008dhu7r9nkmb4ngr&d=12/7/2008>

²⁰ <http://gotprint.net/g/uploadFlyer.do>



Advertises that its *FULL PAGE* flyer with 14pt ultra thick stock features full color on both sides. ²¹



In category of "Print Portfolio," along with catalogues, brochures and banners is an example of a "flyer" for Miken Technologies, which is a single page publication.²²

The record also contains actual examples of single page, two-sided advertising flyers printed on cardstock and originating with enterprises as varied as See's Candies, Bed, Bath & Beyond, Verizon, MediWeightLoss, Harvard University, and Parker River National Wildlife Refuge.

In order to provide a stark contrast with the term "flyer," applicant has placed into the record a number of definitions of the word "shopper":

shop·per (shŏp'ər)

n.

1. One who visits stores in search of merchandise or bargains.
2. A commercial agent who compares the merchandise and prices of competing merchants.
3. A commercial employee who fills mail or telephone orders.
4. A newspaper containing advertisements and some local news, usually distributed free. ²³

²¹ <http://www.nextdayflyers.com/>

²² <http://studio2108.com/print-portfolio/>

²³ *The American Heritage® Dictionary of the English Language, Fourth Edition.*

shop·per [*shop-er*]

–noun

1. a person who shops.
2. See comparison shopper.
3. a retail buyer for another person or a business concern.
4. a locally distributed newspaper of retail advertisements ²⁴

shopper

Dictionary: shop·per (shŏp·er) 

n.

1. One who visits stores in search of merchandise or bargains.
2. A commercial agent who compares the merchandise and prices of competing merchants.
3. A commercial employee who fills mail or telephone orders.
4. A newspaper containing advertisements and some local news, usually distributed free.

Barron's Marketing Dictionary: **shopper**

Locally distributed newspaper, usually free-of-charge, that advertises local stores, restaurants, and shopping centers; also called *shopping newspaper*. Shoppers usually include sale announcements and discount coupons for local stores. ²⁵

Noun

shopper (*plural shoppers*)

1. A person who shops.
2. A free local newspaper containing advertisements for local shops etc; sometimes includes discount coupons. ²⁶

shop·per

n.

1. One who visits stores in search of merchandise or bargains.
2. A commercial agent who compares the merchandise and prices of competing merchants.
3. A commercial employee who fills mail or telephone orders.
4. A newspaper containing advertisements and some local news, usually distributed free. ²⁷

²⁴ *The Random House Dictionary, 1997.*

²⁵ <http://www.answers.com/topic/shopper>

²⁶ <http://en.wiktionary.org/wiki/shopper>

²⁷ *The American Heritage® Dictionary of the English Language, Fourth Edition, 2000.*

Each of these definitions makes clear that an advertising "shopper" is a "newspaper." This is consistent with the actual uses in articles and in Internet search results that applicant has placed into the record. A search for the term, "Shopper Newspapers" results in many references to various free, family newspapers and shoppers similar to applicant's **THE FLYER**.

Finally, the Trademark Examining Attorney submitted for the record a number of third-party registrations, of which the following are typical:

ARMY FLIER	for "newspaper devoted to information of interest to the Fort Rucker community" in International Class 16; ²⁸
FLIER FOR HIRE	for "promoting the goods and services of others by distributing advertising materials through a variety of methods" in International Class 35; ²⁹
MAGIC FLYER	for, <i>inter alia</i> , "direct mail advertising" in International Class 35; ³⁰

Of course, as to the **ARMY FLIER** mark, inasmuch as this newspaper is for the U.S. Army Aviation Center at Fort Rucker, AL, this use of the word "Flier" refers to the first

²⁸ Registration No. 1686354 issued on May 12, 1992; renewed.

²⁹ Registration No. 2894757 issued on October 19, 2004. Registered under Section 2(f).

³⁰ Registration No. 3254699 issued to Magic Flyer S.A.S. on June 26, 2007. No claim is made to the exclusive right to use the term "Flyer" apart from the mark as shown.

Merriam-Webster dictionary definition, namely "airman," and does not support the position of the Trademark Examining Attorney. Applicant also argues that a Section 2(f) claim as to the composite mark [**FLIER FOR HIRE**] merely shows that this entire term was originally deemed to be merely descriptive, and the fact that another applicant agreed to a disclaimer of the word "Flyer" [**MAGIC FLYER**] merely shows that the Trademark Examining Attorney asserted that the term was merely descriptive of the involved services. Applicant also argues from its search of the Trademark Register for marks including the word "Shopper" for newspapers and "Flier"/"Flyer" for advertising publications, that past practice in the United States Patent and Trademark Office reveals that the term "Flyer" is, at worst, merely descriptive of some publications and related services, but definitely not generic for shopper newspapers. Based on the entirety of this record, we concur with applicant that past Office practice as it relates to treatment of the terms "Flyer" and "Shopper," seem to comport with applicant's position herein. Of course, we are not privy to the records in these third-party registrations and, in any event, the determination of registrability of particular marks by the Office cannot control the result in another

case. See *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

Accordingly, in answering the first question of the *Marvin Ginn* test focused on naming the class or genus of applicant's services, we could go with any number of ever-more narrow names, including "creating advertising publications," "providing direct mail advertising," "publishing free family/community newspapers," or even just "publishing shoppers."

Turning then to the second *Marvin Ginn* question as to whether the applied-for term, "Flyer" (or **THE FLYER**) is understood by the relevant public primarily to refer to this genus of services, we agree with applicant that the answer is "no." Rather, we find that even the evidence placed into the record by the Trademark Examining Attorney consistently describes publications that are named "flyers/fliers" as relatively simple, small leaflets, often handed-out, posted or inserted into a newspaper. By contrast, applicant is involved in providing direct mail advertising by publishing a much more complicated but free publication in the nature of a community newspaper containing substantially all advertisements with some limited news or editorial content - a publication known generically in the trade as a "shopper."

Decision: Based upon this record, in its entirety, we reverse the refusal of the Trademark Examining Attorney. This mark will issue on the Principal Register under the provisions of Section 2(f) of the Lanham Act.