

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

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Greater Anchorage, Inc.

Serial No. 77561929

James C. Wray for Greater Anchorage, Inc.

Jennifer M. Martin, Trademark Examining Attorney, Law
Office 116 (Michael W. Baird, Managing Attorney).

Before Quinn, Bergsman, and Wolfson, Administrative
Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Greater Anchorage, Inc. ("applicant") has filed a use-
based application for the mark depicted below (the "Fur
Rondy design") for "jewelry, namely, pins, lapel pins and
pendant pins." Applicant disclaimed the exclusive right to
use the terms "74th," "Anchorage 2009," and "Alaska's 50th."



Applicant described the mark as a "pin consisting of eskimo (sic) with red snowsuit and peach face, yellow circle, and blue flag with yellow stars." Pursuant to a requirement by the examining attorney, applicant submitted a more detailed description of the mark¹ and a claim of the colors "yellow, red, blue, black and white" as a feature of the mark. For purposes of this appeal, the relevant point is the color claim. The original specimen is identified as a "photograph of pin on web page."

The examining attorney has made final a refusal to register the mark on the basis that the mark as used in the specimen of record is merely ornamental, and does not function as an indication of source. Sections 1, 2 and 45, 15 U.S.C. §§ 1051, 1052 and 1127. As the examining attorney noted, "the applied-for mark, as shown on the specimen, is merely ornamental because it is merely a decorative pin. The proposed mark would not be perceived as a source indicator, but rather it would be seen as an

¹ The revised description is: "The mark consists of a figure wearing red mittens and a red snowsuit with yellow piping design, a black zipper and boots. The fur around the hood and sleeves are in white. The figure's face is peach with black eyes, mouth and hair. The figure appears on top of a yellow circle design with the 74th Fur Rondy, Anchorage, 2009 in black appearing around the circle. Inside the yellow circles is white with the words Alaska's 50th in black. The blanket design is blue with yellow stars."

ornamental feature of the goods." Final Office Action, May 26, 2009.

In addition, the examining attorney refused registration on the ground that the specimens of record do not show the mark as used on the goods and do not show the mark in color as required under 37 CFR §§ 2.51 and 2.72(a)(1). The substitute specimens were also refused for not being properly verified, 37 CFR § 2.59(a).

The appeal has been fully briefed.

The Specimen Requirement

In a trademark application, if color is claimed as a feature of the mark, the specimen and the drawing of the mark must match and the specimen must show use of the color. 37 C.F.R. §§ 2.51 and 2.72(a)(1); see TMEP §§ 807.12(a) and 904.02(c)(ii) (7th ed. 2010). Applicant claimed color as a feature of the mark, but has failed to submit a specimen showing the mark in color. The specimen filed with the application was a black-and-white copy of a web page from applicant's website. The relevant portion of the web page is shown below.



The Rondy Shop is
Now Open for Business!

Click here to PREORDER
Your 2009
Rondy Merchandise!

Downloadable Order forms:

2009 Rondy Merchandise Pre-Order Form

2009 Corporate Membership Form

2009 Individual Membership Form

2009 Miss Fur Rendezvous Royalty Contest!

The specimen submitted with applicant's response to the first Office action was a black-and-white copy of two pins, two pendants and a spoon bearing embodiments of the design.² The specimen submitted in response to the second Office action was a duplicate of a previously submitted specimen. The final specimen submitted did not show a depiction of the mark but merely relayed background information about the Anchorage "Fur Rendezvous" event sponsored by applicant.

Since none of the specimens bearing the mark was in color, and since the specimens that are in color do not

² Two other specimens were attached to applicant's response to the first Office action, neither of which showed the mark being used on the goods. One did not show the mark at all, and the other (an article about the artist who created the design) bore a photograph of the artist and a rendition of the design. See TMEP § 904.04(a) (specimen may not be a "picture" of the mark, such as an artist's drawing that merely illustrates what the mark looks like; specimen must show the mark actually used on or in connection with the goods in commerce).

display the mark, the requirement that applicant submit a specimen showing the mark in color was not fulfilled.³ We note applicant's statement that the colors of the jewelry pieces "are shown in the attached card,"⁴ and applicant's attorney's statement that "of my own knowledge the pins and spoon in the previous specimen are in the colors shown in the attached specimen."⁵ However, statements made in response to an Office action do not substitute for a proper specimen showing the mark in color.⁶

The refusal based on the requirement that applicant submit a proper specimen is affirmed.

The Ornamentation Refusal

A decorative design may be both ornamental and a trademark when the design serves to advise the purchaser that the products or services identified by the design emanate from a single source. *In re E. J. Brach & Sons*, 256 F.2d 325, 118 USPQ 308, 309 (CCPA 1958); see *In re*

³ In addition to being in color, for a web page to be acceptable as a specimen, the mark must appear "in a manner in which the mark is associated with the goods" and there must be a means for online ordering of the goods. TMEP § 904.03(i). Here, it is unclear whether the web page displayed the goods and as noted, it is not in color.

⁴ Response to Office Action, February 11, 2009.

⁵ Response, April 29, 2009.

⁶ We further note that none of the substitute specimens has been properly verified under 37 CFR § 2.20. They are not acceptable for this additional reason. See 37 CFR § 2.59(a) (Filing Substitute Specimens); TMEP § 904.05 (applicant must verify that the new specimen was in use in commerce as of the application filing date).

Dimitri's Inc., 9 USPQ2d 1666, 1667 (TTAB 1988) ("matter which serves as part of the aesthetic ornamentation of goods, such as T-shirts, may nevertheless be registered as a trademark for such goods if it also serves a source-indicating function"). Whether a design is merely ornamental or functions as a trademark is a matter of public perception. 1 *McCarthy On Trademarks and Unfair Competition* §7:24 (4th ed. 2006) ("If customers perceive a design only as pleasing ornamentation, then the design is not a trademark. If customers perceive a design as not only attractive, but as an indicator of source, then it is a trademark").

When deciding whether a proposed mark is mere ornamentation, "the size, location, dominance and significance of the alleged mark as applied to the goods are all factors which figure prominently in the determination of whether it also serves as an indication of origin." *In re Pro-Line*, 28 USPQ2d 1141, 1142 (TTAB 1993). The larger the display relative to the size of the goods, the more likely it is that consumers will not view the ornamental matter as a mark. See, e.g., *In re Dimitri's Inc.*, 9 USPQ2d at 1667 (SUMO merely ornamental in part because the wording "appears in large lettering across the top-center portion of the T-shirts and caps"); *In re Astro-*

Gods Inc., 223 USPQ 621, 623 (TTAB 1984) ("ASTRO GODS" and design unregistrable as merely one of "several prominent legends").

Here, applicant's proposed mark is the entire product itself; the pins and pendants shown in the specimen of record are in the form of three-dimensional embodiments of the mark. The impression likely to govern a prospective purchaser is that the design is a piece of artwork that may be worn as a symbol of attendance at applicant's "Fur Rondy" festival or as a way of showing allegiance to the event, and not as a trademark designating goods which emanate solely from applicant. See *International Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912, 208 USPQ 718 (9th Cir. 1980), cert. denied, 452 U.S. 941, 69 L.Ed. 2d 956, 101 S.Ct. 3086, 213 USPQ 1056 (1981) (jewelry purchased "for its intrinsic functional use and aesthetic appeal"); *cf.*, *In re Eagle Crest Inc.*, 96 USPQ2d 1227 (TTAB 2010) (ONCE A MARINE, ALWAYS A MARINE - informational message); *In re F.C.F. Inc.*, 30 USPQ2d 1825, 1827 (TTAB 1994) (rose design packaging for cosmetics not inherently distinctive because it is simply a refinement of a basic, common, and well-known form of decoration or ornamentation for cosmetic packaging).

An otherwise merely ornamental design may "be found to be registrable if applicant submits other evidence (such as evidence of promotion of the matter as a mark, survey evidence demonstrating purchaser perception of the matter as a mark, etc.) showing that purchasers recognize that matter as an indication of the source of the goods." *In re Pro-Line*, 28 USPQ2d at 1142. Likewise, a prior registration for the mark for other goods or services can provide a basis for registration of the mark for the applied-for goods or services. See *In re Paramount Pictures Corp.*, 217 USPQ 292 (TTAB 1982) (in view of applicant's registration of STAR TREK for a number of other goods, refusal to register mark for towels, sheets, pillow cases and comforters reversed); *In re Olin Corp.*, 181 USPQ 182 (TTAB 1973) (stylized "O" design, previously registered as a trademark for skis, held registrable for t-shirts as identifier of secondary source).

Here, there is no evidence that applicant's Fur Rondy design has been used as a trademark for any other goods or services, that the design has been promoted in connection with applicant's jewelry in such a manner and to such an extent as to create purchaser recognition of the Fur Rondy design as a trademark, or that applicant holds a registration for the Fur Rondy design (apart from its

registration for the words "Fur Rondy") such that the distinctiveness of the design carries over to applicant's use on jewelry as a secondary source indicator. See *In re Penthouse International Ltd.*, 565 F.2d 679, 195 USPQ 698 (CCPA 1977) (applicant sought to register its established mark as a jewelry design which, in light of the record, functioned as a mark for jewelry).

Decision: The refusal to register the "Fur Rondy" design for "jewelry, namely, pins, lapel pins and pendant pins" on the ground that none of the specimens of record shows use of the mark in color is affirmed.

The refusal to register the Fur Rondy design for "jewelry, namely, pins, lapel pins and pendant pins" on the ground that the proposed mark does not function as a trademark pursuant to Sections 1, 2, 3 and 45 of the Lanham Act is affirmed.