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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Thomas Jefferson Foundation, Inc.

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Serial No. 77967242
Filed on March 24, 2010

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Mary Daton Baril of McGuire Woods LLP for Thomas Jefferson Foundation, Inc.

Judy M. Helfman, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

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Before Kuhlke, Wellington and Greenbaum, Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Thomas Jefferson Foundation, Inc. filed an application to register MONTICELLO (in standard characters) as a trademark on the Principal Register for "house paint" in International Class 2.

The examining attorney has refused registration of applicant's mark under the provisions of Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052 and 1127, on the ground that the mark, "as used on the specimens of

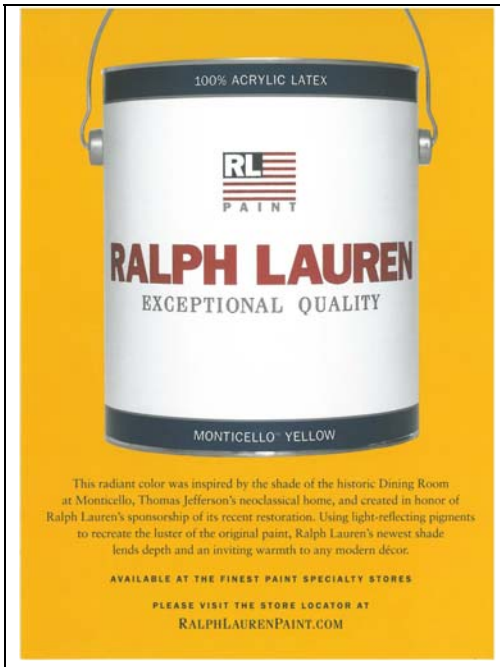
record, serves solely as a color designation and does not serve a trademark function." Brief, p. 1. In addition, the examining attorney rejects applicant's argument that its mark functions as a trademark because it has secondary source significance.

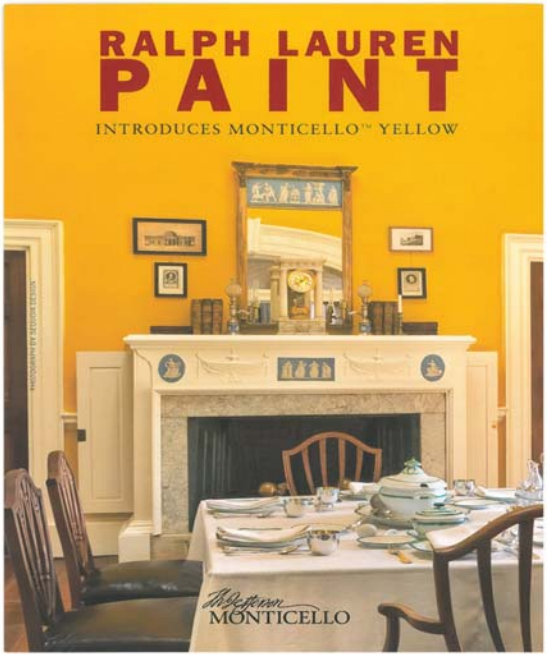
The application was originally filed based on applicant's intent to use in commerce and it was approved by the Office for publication in the Official Gazette for opposition. Upon expiration of the opposition period and without any opposition having been filed, the Office issued a Notice of Allowance. Applicant then filed its Statement of Use (SOU), alleging a date of first use in commerce and providing the following specimen of use:

Applicant describes the specimen in the SOU as the "front and back of the paint card found at point of purchase display" and that the mark "is being used pursuant to a license from applicant to Ralph Lauren."

The applied-for mark was then refused registration by the examining attorney who asserted that the mark is merely a color designation and does not function as a trademark. In particular, she stated that the proposed mark is "used to denote one color of paint and to distinguish it from other colors of paints" and the "impression that MONTICELLO makes on the relevant public would be solely connected to a specific shade of yellow paint, and not as a trademark denoting origin of the identified goods." Office action (January 5, 2011).

In response to the refusal to register, applicant filed the following additional specimens of use:





Applicant states that the additional specimens comprise "a point of purchase placard that shows a photo of the product with the mark on it." Applicant also goes on to argue that its mark "is functioning to identify a secondary source" because "[t]he word Monticello used in connection with paint can signify that Monticello authorizes or licenses the sale of the paint by Ralph Lauren, which is in fact a licensee of the mark Monticello for use with paint." Applicant attached copies of printouts from the Ralph Lauren Home website explaining the relationship between it and applicant, including a brief history of the actual paint colors used in Thomas Jefferson's home, Monticello.

The examining attorney was not convinced by the additional specimens and, in the July 25, 2011 Office action, made the refusal "final," maintaining that "no specimen of record demonstrates trademark use of the proposed mark for the identified goods."

Applicant has appealed and both applicant and the examining attorney filed briefs. For the reasons explained below, we reverse the refusal to registration.

Although we disagree with the examining attorney's ultimate conclusion, we note that she has correctly set forth in her brief the statutes and cases governing our review of this matter given the particular refusal to register the applied-for mark. In particular, for determining whether applicant's MONTICELLO functions as a trademark, we keep in mind that in order to be registrable, the term must be perceived by the purchasing public as identifying and distinguishing the source of the goods. Section 2 of the Act, 15 U.S.C. § 1052. "The Trademark Act is not an act to register mere words, but rather to register trademarks. Before there can be registration, there must be a trademark, and unless words have been so used they cannot qualify." *In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1976), *citing In re Standard Oil Co.*, 275 F.2d 945, 125 USPQ 227 (CCPA 1960). "A critical

element in determining whether a term or phrase is a trademark is the impression the term or phrase makes on the relevant public." *In re Volvo Cars of North America, Inc.*, 46 USPQ2d 1455, 1458 (TTAB 1998). "The question whether the subject matter of an application for registration functions as a mark is determined by examining the specimens along with any other relevant material submitted by applicant during prosecution of the application." *In re The Signal Companies, Inc.*, 228 USPQ 956, 957 (TTAB 1986).

> An important function of specimens in a trademark application is, manifestly, to enable the PTO to verify the statements made in the application regarding trademark use. In this regard, the manner in which an applicant has employed the asserted mark, as evidenced by the specimens of record, must be carefully considered in determining whether the asserted mark has been used as a trademark with respect to the goods named in the application.

Bose, 192 USPQ at 216 (footnote omitted).

With regard to color designations, the Board has long held that the use of a proposed mark to identify one particular style or color shade for the goods, *e.g.*, lipstick, paints, etc., does not necessarily render the term unable to function as a trademark.

> The fact that a term may be used as a color or style designation to identify one particular style or color of a product and distinguish it from the other colors or styles of the same type of merchandise does not necessarily mean that it likewise cannot function as a trademark to identify such goods from like goods of others... [T]he criteria for registration of a term

> such as that involved herein are that the term be an arbitrary designation which does not in itself have a connotation of color as used on and in connection with the goods in question and that it is applied in the manner of a trademark to the product. In the instant case, there is no question but that the mark "BLANCO" is used in the manner of a trademark on labels affixed to the plywood panels.

In re Champion International Corporation, 183 USPQ 318 (TTAB 1974), citing to *In re Clairol Inc.*, 173 USPQ 355, 457 F.2d 509 (CCPA 1972), (other internal citations omitted). In *Champion,* the Board noted that applicant was applying its proposed mark "in the manner of a trademark on labels affixed to the [goods]," but ultimately refused registration because the term BLANCO (meaning "white") was merely descriptive of the identified goods. In the *Clairol* decision, the predecessor of our primary reviewing court reversed the Board and found SWEDISH CRYSTAL for hair color products registrable because it was a "coined and completely arbitrary term" and was used as a trademark despite also being a color designation and always followed by wording, "light muted ash." The *Clairol* court instructed that a proper inquiry involves looking beyond any intent by applicant to use the mark as a color designation:

> ...a mark may be used for both a trademark purpose and a non-trademark purpose and still be a valid trademark. (Internal citation omitted). We are of the opinion that the facts in this case-including the

> manner in which the mark is used, the fact that it is always used in addition to a shade designation and the arbitrariness of the mark-evidence a clear intent to use the mark to indicate the source of the goods. The cases cited by the board are not controlling on these facts. The arbitrariness of the mark further tends to establish that the ordinary purchaser would consider that the mark indicates origin.

Clairol, 173 USPQ at 355-356.

The facts and evidence, in particular the specimens of use, demonstrate that applicant's use of MONTICELLO is akin to that of the applicant in the *Clairol* decision. Like "Swedish Crystal," the term "Monticello" has no meaning or suggestive connotation with respect to a color. That is, unlike, *e.g.*, "lemon" or "banana," it is not a term that would describe or even suggest a shade of yellow. Moreover and more importantly, applicant's manner of use of "Monticello" in connection with the identified goods rises to a level where consumers would view the term as more than merely being a color designation. To be clear, we point out that we share the same concerns as the examining attorney with regard to the original specimen of use, comprising a paint swatch card merely bearing the wording "Monticello Yellow" on one side and the color swatch on the other side. That swatch card alone does not constitute trademark use because, as shown by the evidence submitted by the examining attorney, a paint manufacturer such as

applicant's licensee may assign terms to various colors and shades of paint without any intention of using said terms to identify or distinguish the source of the paint. However, the additional specimen submitted by applicant, viewed in its entirety, does constitute proper trademark use on the identified goods. The point-of-purchase placard was presumably prepared by applicant's licensee, Ralph Lauren, and shows the wording "Monticello ™ Yellow" on a can of paint. On the adjoining page, the wording "Ralph Lauren Introduces Monticello ™ Yellow" appears prominently at the top.[1] The term "Monticello" is also used on both pages in reference to the historic home of Thomas Jefferson, and discusses how the home inspired the paint. We find that consumers who receive this point-of-sale placard will perceive applicant's use, through its licensee, of the term "Monticello" as a term used uniquely by applicant to identify and distinguish applicant as the source of that particular paint.

We acknowledge the record indicates that applicant uses "Monticello" to designate a single shade of yellow paint, rather than to identify a line of various paints in different colors. Indeed, the record reflects that names

[1] The fact that the trademark symbol or superscript ™ is employed in the specimens should not be viewed, by itself, as elevating

of other historic homes, such as Biltmore and Mount Vernon, are used by others as source identifiers on a series of various styles or colors of paints. Nevertheless, the fact that applicant may use Monticello as identifying one particular color or shade does not prohibit the term from also being used by applicant in a trademark manner. Again, "a mark may be used for both a trademark purpose and a non-trademark purpose and still be a valid trademark." *Clairol* at 355. Simply put, so long as applicant has submitted a specimen showing proper trademark use of the term MONTICELLO, and it has, then the mark may be registered.

Because we find that applicant's mark, MONTICELLO, is capable of functioning as a trademark and the substitute specimen of use is acceptable and reflects such trademark use, we need not discuss the alternative issue of whether applicant's mark functions as trademark as a result of any secondary source attributions.[2]

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applicant's use of the term "Monticello" to trademark use.

[2] We would be remiss, however, if we did not point out that applicant's argument that secondary source meaning as a result of applicant's use of the term MONTICELLO on other goods is not supported by the evidence. The record does not establish that applicant has used the term MONTICELLO on any other goods. Rather, in its June 22, 2011 response to an Office action, applicant merely states that it licenses use of the term to others for use on goods and applicant references its "retail website" (providing a URL). Printouts from the website showing use of the mark on other goods were not submitted.

Decision: The refusal to register MONTICELLO on the ground that it fails to function as a mark is reversed.