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Subject: TRADEMARK APPLICATION NO. 78093634 - MISSING A RIB, XY
INSTEAD OF XX - N/A

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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/093634

APPLICANT: Gungner, David J.

CORRESPONDENT ADDRESS:

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

MARK: MISSING A RIB, XY INSTEAD OF XX

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

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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

Applicant has appealed the examining attorney's final refusal to register the mark MISSING

A RIB, XY INSTEAD OF XX for "books, brochures, facsimile transmission paper, newsletters,

pamphlets featuring content regarding scientific creationism and/or biblical inerrancy as interpreted

via virtue of methodologies from the topic of computer science." Registration was refused on the

Principal Register because the proposed mark does not function as a trademark as used on the

specimen of record. Registration was also refused because the identified goods to which the

proposed mark is applied are not “goods in trade.” In addition, applicant failed to submit a

declaration under 37 C.F.R. §2.20 or notarized affidavit with a supporting statement for a substitute specimen. It is respectfully requested that these refusals be affirmed. Trademark Act

Sections 1, 2 and 45, 15 U.S.C. §§1051, 1052 and 1127.

FACTS

On November 15, 2001, applicant filed for registration on the Principal Register of the mark

MISSING A RIB, XY INSTEAD OF XX for “book, brochure, electronic book, facsimile cover

file/page, internet world wide web file/page, letter-header-footer, newsletter, nurb data file,

pamphlet, pdf file, pixel data file.” Applicant based the application on intent-to-use in commerce.

The examining attorney refused registration on March 7, 2002 because applicant failed to sign the

application declaration and because the identification of goods was indefinite.

Applicant filed a statement of use on January 15, 2004 and the examining attorney refused

registration on March 26, 2004 because the specimen did not show use of the mark with the

specified goods. The examining attorney issued a final refusal on July 16, 2004. Applicant

requested reconsideration on July 28, 2004 and filed an appeal on January 17, 2005. On March 17,

2005, jurisdiction was restored to the examining attorney, and a new non-final action issued on

March 30, 2006. Registration was refused because the mark does not function as a trademark, the

identified goods are not “goods in trade” and applicant failed to submit a declaration under 37

C.F.R. §2.20 or notarized affidavit with a supporting statement for a substitute specimen.

Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051, 1052 and 1127. Applicant responded on

September 30, 2006 and a final refusal was issued on November 16, 2006 and the appeal was

resumed.

ISSUES

The issues on appeal are 1) whether the proposed mark fails to function as a trademark as used

on the specimen of record; and 2) whether the identified goods to which the proposed mark is

applied are goods in trade.

ARGUMENTS

I. APPLICANT’S MARK, AS USED ON THE SPECIMEN, DOES NOT FUNCTION AS A TRADEMARK TO INDICATE THE SOURCE OF THE IDENTIFIED GOODS.

The proposed mark, as used on the specimen of record, does not function as a trademark to

identify and distinguish applicant’s goods from those of others and to indicate their source.

Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051-1052 and 1127; *In re Remington Prods.*,

Inc., 3 USPQ2d 1714 (TTAB 1987); TMEP §§1202 *et seq.*

The specimen of record, along with any other relevant evidence submitted with the application, is reviewed and analyzed in order to determine whether a term is being properly used

as a trademark. *In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213 (C.C.P.A. 1976); *In re Volvo Cars*

of North America, 46 USPQ2d 1455 (TTAB 1998). Not all words, designs, symbols or slogans

used in the sale or advertising of goods or services function as marks, even if they may have been

adopted with the intent to do so. A designation cannot be registered unless ordinary purchasers

would regard it as a source-indicator for the goods. *In re Manco, Inc.*, 24 USPQ2d 1938 (TTAB

1992); TMEP §§1202 *et seq.*

Applicant's specimen consists of a printout of a five-dollar bill and the wording "missing a

rib, XY instead of XX TM GenesIs 2:20-23, United States Sixteenth President Abraham Lincoln

(birth: February 12, 1809 Ford's Theater: April 14, 1865) Exodus 12:29." A box enclosing the

wording "facsimile message information" with the subject line "Re: TRADEMARK

APPLICATION NO. 78093634..." and other miscellaneous information such as the filing date of

the application, the examining attorney's name as recipient and a telephone number appears

directly under wording. See specimen submitted with applicant's July 28, 2004 response.

Applicant's specimen is merely a facsimile transmission and not "facsimile transmission

paper" as listed in the identification of goods. The proposed mark does not function as a trademark

used on a facsimile transmission sent as a response to an Office action. As such, an ordinary

purchaser would not regard the mark as an indicator of the source of facsimile paper or any of the

other identified goods. Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051-1052 and 1127; *In*

re Remington Prods., Inc., 3 USPQ2d 1714 (TTAB 1987); TMEP §§1202 *et seq.*

II. APPLICANT'S IDENTIFIED GOODS TO WHICH THE PROPOSED MARK IS APPLIED ARE NOT "GOODS IN TRADE."

The proposed mark is not being used to identify goods that are sold or transported in commerce or that have utility to others. Trademark Act Sections 1, 2 and 45; 15 U.S.C. §§1051-1052 and 1127.

Applicant's specimen merely consists of a facsimile transmission containing a printout of a

five-dollar bill and the wording "missing a rib, XY instead of XX TM GenesIs 2:20-23, United

States Sixteenth President Abraham Lincoln (birth: February 12, 1809 Ford's Theater: April 14,

1865) Exodus 12:29." A box enclosing the wording "facsimile message information" with the

subject line “Re: TRADEMARK APPLICATION NO. 78093634...” and other miscellaneous

information such as the filing date of the application, the examining attorney’s name as recipient

and a telephone number appears directly under wording. See specimen submitted with applicant’s

July 28, 2004 response. The proposed mark, as shown on the specimen, is not being used on

“facsimile transmission paper” as goods that travel in commerce, but rather on a facsimile transmission sent in response to an Office action.

The application lists “facsimile transmission paper” as the subject matter to which the

proposed mark will be applied. Such goods, submitted as applicant’s specimen, are items that are

commonly used to run a business on a daily basis, i.e., sending messages via facsimile

transmission. Incidental items used to conduct daily business (such as letterhead, invoices and

business forms) are not “goods in trade” because they are not items sold or transported in

commerce for use by others. *See, e.g., In re S’holders Data Corp.*, 495 F.2d 1360, 181 USPQ 722

(C.C.P.A. 1974) (reports not goods in trade where applicant is not engaged in the sale of reports

but solely in furnishing financial reporting services, and reports are merely conduit through which

services are rendered); *Ex parte Bank of Am. Nat’l Trust and Sav. Ass’n*, 118 USPQ 165 (Comm’r

Pats. 1958) (mark not registrable for passbooks, checks and other printed forms, where forms are

used only in the performance of banking services and applicant does not print or sell forms as

commodities in trade); *see* TMEP §§1202.06 *et seq.*

In addition to being sold or transported in commerce for use by others, such items must

provide a use or utility *to others* “on a commercial scale” to be “goods in trade.” *E.g., Paramount*

Pictures Corp. v. White, 31 USPQ2d 1768, 1775 (TTAB 1994), (mark not registrable for games

where purported games are only advertising flyers used to promote applicant’s services and have

no real utilitarian function or purpose as games); *In re Douglas Aircraft Co.*, 123 USPQ 271

(TTAB 1959) (books, pamphlets, and brochures that serve only to explain and advertise applicant’s

goods are not “goods”); TMEP §1202.06(a). Applicant’s specimen does not provide a use or

utility to others and is not used “on a commercial scale” because it is merely a facsimile message

sent in response to an Office action.

CONCLUSION

For the foregoing reasons, applicant’s mark, MISSING A RIB, XY INSTEAD OF XX, as

used on the specimen, does not function as a trademark to indicate the source of the identified

goods; applicant's identified goods to which the proposed mark is applied are not "goods in

trade;" and applicant failed to submit a declaration under 37 C.F.R. §2.20 or notarized affidavit

with a supporting statement for a substitute specimen.. Trademark Act Sections 1, 2 and 45; 15

U.S.C. §§1051-1052 and 1127. The refusal to register the mark on the Principal Register under

Section 1, 2 and 45 should be affirmed.

Respectfully submitted,

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