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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85527029 MARK: WTC	
CORRESPONDENT ADDRESS: SANDRA EDELMAN DORSEY & WHITNEY LLP 51 WEST 52ND STREET NEW YORK, NY 10019-6119	GENERAL TRADEMARK INFORMATION: http://www.uspto.gov/trademarks/index.jsp TTAB INFORMATION: http://www.uspto.gov/trademarks/process/appeal/index.jsp
APPLICANT: World Trade Centers Association, Inc.	
CORRESPONDENT'S REFERENCE/DOCKET NO: N/A CORRESPONDENT E-MAIL ADDRESS: ny.trademark@dorsey.com	

EXAMINING ATTORNEY'S APPEAL BRIEF

The proposed marks WORLD TRADE CENTER and WTC for a variety of goods in Class 9, 14, 16, 18 have been refused registration under Trademark Act Sections 1, 2 and 45 because the terms are incapable of functioning as trademarks for the enumerated goods. 15 U.S.C. §§1051-1052, 1127. Applicant appealed the Trademark Examining Attorney's final refusals to register.

I. FACTS

In eight applications filed on November 18, 2011, November 19, 2011 and/or January 31, 2012, Applicant applied for registration on the Principal Register of the standard character marks WORLD TRADE CENTER and WTC for the following goods:

CLASS 9: binoculars, cameras, blank USB flash drives, chains for eye glasses, electronic personal organizer, eyeglass cases, eyeglasses, hard hats, light pens, magnets, mouse pads, cell phone cases, sunglasses, viewing devices, namely, digital photograph viewers, 3D digital photograph viewers, LCD displays, enclosures for LCD displays and enclosures for video players¹

CLASS 14: bracelets, charms, clocks, commemorative coins and medals, cuff links, earrings, jewelry pins for use on hats, holiday ornaments of precious metals, jewelry, key rings of precious metals, lapel pins, necklaces, ornamental pins, statuettes of precious metals and their alloys, watches²

CLASS 16: address books and diaries, architectural models, art prints comprised of digital illustrations originating from photographs, atlases, binders, bookends, booklets in the fields of business, bumper stickers, calendars, cards not magnetically coded for use in business transactions, coasters, commemorative books and coffee table books featuring history of the World Trade Centers Association, day planner, decals, dictionaries, books featuring finance and international trade, globes, graphic art prints and reproductions, greeting cards, maps, directories featuring photographs and information regarding members of the World Trade Centers Association, mounted and unmounted photographs, paper name badges, passport holders, pens, pencils, photograph albums, posters, postcards and picture postcards, publications namely, news bulletins, newsletters, newspapers, brochures, pamphlets and magazines in the fields of business, finance and international trade, stickers³

CLASS 18: backpacks, book bags, sports bags, bum bags, handbags, duffel bags, fanny packs, garment bags for travel, gym bags, handbags, leather cases, tote bags,

¹ Serial Nos. 85527029 (“WTC”) and 85527008 (“WORLD TRADE CENTER”)

² Serial Nos. 85527119 (“WTC”) and 85527100 (“WORLD TRADE CENTER”)

³ Serial Nos. 85473617 (“WTC”) and 85474746 (“WORLD TRADE CENTER”)

shoulder bags, clutch bags, roll bags, briefcases, purses, coin purses, cosmetic bags sold empty, cosmetic carrying cases sold empty, cosmetic cases sold empty, suitcases, luggage, luggage tags, luggage tag holders, straps for carrying cases, toiletry bags and cases sold empty, wallets including card holders/with card compartments, waist packs, wristlet bags, umbrellas⁴

In the first Office actions issued on February 10, 2012, registration of the applied-for wording was refused under Sections 1, 2 and 45 based on a failure to function as a trademark. Applicant was also required to amend its identification of goods and to claim ownership of prior registrations.

Applicant traversed the refusals and complied with the requirements, and the Examining Attorney issued final Office actions with regard to the refusals based on an inability to function as a trademark under Sections 1, 2 and 45. Applicant filed requests for reconsideration on March 4, 2013, in which applicant presented arguments in response to the refusals under Sections 1, 2 and 45 and, in the alternative, proffered evidence in support a claim of acquired distinctiveness under Section 2(f). The Examining Attorney denied applicant's requests for reconsideration on April 11, 2013.

The instant applications were consolidated on May 1, 2013, and applicant filed briefs on July 1, 2013 with the Trademark Trial and Appeal Board (hereafter "the Board") appealing the failure to function refusal under Sections 1, 2 and 45 of the Trademark Act.

On September 10, 2013, the applications were transferred to the undersigned Examining Attorney. Upon review of the application files, the Examining Attorney filed a motion to remand for purposes of supplementing the evidentiary record. The remand was granted and, on October 15, 2013, a subsequent final refusal issued under Trademark Act Sections 1, 2 and 45 for failure to function as a trademark.

On November 29, 2013, proceedings resumed at the Board.

On December 5, 2013, applicant filed a request for extension of time to file its Supplemental Brief and, subsequently, applicant filed a request for remand on March 14, 2014, for purposes of submitting

⁴ Serial Nos. 85473613 ("WTC") and 85474748 ("WORLD TRADE CENTER")

additional evidence for consideration. The files were remanded, applicant's request for reconsideration was denied on April 24, and proceedings at the Board resumed April 25, 2014.

Applicant filed a second request for remand and reconsideration on May 28, 2014, for purposes of submitting responsive evidence. The files were again remanded, the request for reconsideration was denied, and proceedings at the Board resumed on June 27, 2014.

Applicant filed a supplemental brief on August 25, 2014.

II. ISSUE

The issue before the Board is whether the wording WORLD TRADE CENTER and WTC is capable of functioning as a trademark under Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051-1052, 1127 for the above-referenced goods.

III. ARGUMENT

APPLICANT'S MARKS ARE INCAPABLE OF FUNCTIONING AS TRADEMARKS BECAUSE THEY CANNOT SERVE AS INDICATORS OF SOURCE.

The crux of a refusal under Sections 1, 2 and 45 for failure to function is basic: is the matter presented capable of functioning a trademark? It is well-established that, "before there can be registration, there must be a trademark." *In re Bose Corp.*, 192 USPQ 213, 215 (C.C.P.A. 1976). Accordingly, inasmuch as applicant seeks registration of the wording WORLD TRADE CENTER and WTC, the starting point for analysis is Section 45 of the Trademark Act, as amended, where "trademark" is defined as "any word, name, symbol, or device" used by a manufacturer or merchant "to identify his goods and distinguish them from those manufactured by others." See 15 U.S.C. §1127. A registrable trademark "must serve as an indicator of the source of the goods, identifying and distinguishing them from those of others." See 15 U.S.C. §1127; TMEP §§1202, 1202.17(c).

The USPTO will not register a designation unless purchasers would be likely to regard it as a source-indicator for the goods. *In re Manco, Inc.*, 24 USPQ2d 1938 (TTAB 1992); TMEP §1202.

A. The evidence of record shows that the applied-for wording cannot identify and distinguish the applied-for goods from the goods of others and, therefore, does not function as a trademark.

The USPTO will not register a mark unless it functions as a mark. See 15 U.S.C. §§1051, 1052, 1053, 1127; *In re Int'l Spike, Inc.*, 196 USPQ 447, 449 (TTAB 1977) (“Registration presupposes the existence of a trademark to be registered.”); TMEP §1202. That is, the mark must serve as an indicator of the source of the goods, identifying and distinguishing them from those of others. See 15 U.S.C. §1127; TMEP §1202. Not every designation that a party places on goods or packaging necessarily performs these source-indicating functions, regardless of the party’s intentions when adopting the designation. *In re Eagle Crest, Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010); *In re Vertex Grp., LLC*, 89 USPQ2d 1694, 1701 (TTAB 2009) (“As is the case with any trademark, mere intent that a word, name, symbol or device function as a trademark or service mark is not enough in and of itself.”). Some designations can never serve as a source indicator. See *In re Eagle Crest, Inc.*, 96 USPQ2d at 1229; *Am. Velcro, Inc. v. Charles Mayer Studios, Inc.*, 177 USPQ 149, 154 (TTAB 1973).

The critical inquiry in determining whether a term functions as a trademark is how the proposed mark would be perceived by the relevant public. *In re Eagle Crest, Inc.* 96 USPQ 2d 1227, 1229-30 (TTAB 2010) (holding ONCE A MARINE, ALWAYS A MARINE to be an “old and familiar Marine expression...that should remain free for all to use”). The more commonly a phrase is used in everyday parlance, the less likely the public will use it to identify only one source and the less likely the phrase will be recognized by purchasers as a trademark. *In re Eagle Crest*, 96 USPQ2d at 1229-30 (noting that “[a]s a matter of competitive policy, it should be close to impossible for one competitor to achieve exclusive rights’ in common phrases or slogans.” (quoting J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §7.23 (4th ed. 2010))). Because the function of a trademark is to identify a single commercial source for particular goods, if consumers are accustomed to seeing wording used in connection with goods from many different sources, it is likely that consumers would not view the wording as a source identifier for such goods. *Id.* at 1230.

In this case, the evidence of record firmly establishes that the wording WORLD TRADE CENTER and WTC used in connection with the applied-for goods is perceived as an effort to remember the events of September 11, 2001. Specifically, the representative sampling of third parties currently using the wording WORLD TRADE CENTER and WTC shows that consumers are accustomed to seeing this wording used by a variety of sources in connection with the applied-for goods in an effort to remember the

events of September 11 and, therefore, consumers would not view the wording as source-identifying for these goods.

The evidence of record, including website screenshots from *Collins Online Dictionary*,⁵ *Dictionary.com*,⁶ *NYC.gov*,⁷ *You Tube*,⁸ *Tribute WTC*,⁹ *The September 11th Education Trust*,¹⁰ *9-11 Research*,¹¹ *WTC – 9/11*,¹² *WTC Run to Remember*,¹³ *Remember WTC 9/11*,¹⁴ *History.com*,¹⁵ *About.com*,¹⁶ *ABC News*,¹⁷ *PANYNJ.gov*,¹⁸ *StoryCorps*,¹⁹ *United States Environmental Protection Agency*,²⁰ *Vocabulary.com*,²¹ *Britannica Online*,²² *Britannica Kids*,²³ *911 Memorial*,²⁴ *Kids.Net*,²⁵ *The Telegraph*,²⁶ *Reuters*²⁷ and the “official” *WORLD TRADE CENTER Facebook* page,²⁸ shows that the terms WTC and WORLD TRADE CENTER are currently used to call to mind the terrorist attacks of 2001.

This evidence is significant because it establishes that the events of September 11, 2001 and the wording “WORLD TRADE CENTER” and “WTC” remain integrally intertwined in common parlance. Moreover, use on the particular goods claimed by applicant cannot be distinctive because widespread third-party usage referring to this event in connection with these goods has rendered the applied-for wording incapable of functioning as a source-indicator in connection therewith.

⁵ *Initial Office action dated 2/10/2012* at pages 6-7.

⁶ *Initial Office action dated 2/10/2012* at pages 2-3, 8-9.

⁷ *Final Office action dated 09/06/2012* at pages 2-3.

⁸ *Final Office action dated 09/06/2012* at pages 4-6.

⁹ *Final Office action dated 09/06/2012* at pages 7-8.

¹⁰ *Final Office action dated 09/06/2012* at pages 9-11.

¹¹ *Final Office action dated 09/06/2012* at pages 12-13.

¹² *Final Office action dated 09/06/2012* at pages 14-15.

¹³ *Final Office action dated 09/06/2012* at pages 16-17.

¹⁴ *Final Office action dated 09/06/2012* at pages 18-21.

¹⁵ *Final Office action dated 09/06/2012* at pages 22-25.

¹⁶ *Final Office action dated 09/06/2012* at pages 26-28.

¹⁷ *Final Office action dated 09/06/2012* at pages 29-30.

¹⁸ *Final Office action dated 09/06/2012* at pages 31-35.

¹⁹ *Final Office action dated 09/06/2012* at pages 36-40.

²⁰ *Final Office action dated 09/06/2012* at pages 41-42.

²¹ *Final Office action dated 09/06/2012* at page 60.

²² *Final Office action dated 10/15/2013* at page 6: “World Trade Center...was the site of the deadliest terrorist attack in American history. (See September 11 attacks).”

²³ *Final Office action dated 10/15/2013* at page 2.

²⁴ *Final Office action dated 10/15/2013* at pages 3-4.

²⁵ *Final Office action dated 10/15/2013* at page 5.

²⁶ *Final Office action dated 09/06/2012* at pages 43-48.

²⁷ *Final Office action dated 09/06/2012* at pages 49-53.

²⁸ *Final Office action dated 10/15/2013* at page 7: “the World Trade Center was a complex with seven buildings featuring landmark twin towers New York City, NY. The complex opened on April 4, 1973, and was destroyed in 2001 in the September 11 attacks.” Accordingly, even official representations on behalf of the World Trade Center appear to recognize that the wording “WORLD TRADE CENTER” and “the September 11 attacks” are fundamentally linked.

For example, with regard to the applied-for goods in Class 9, third party website evidence from:

- *Cafe Press Online* shows “WORLD TRADE CENTER” used in connection with mouse pads featuring the wording “Don’t ever forget! September 11, 2001”²⁹ and a variety of cell phone cases commemorating and memorializing 9/11.³⁰
- *CowCow.com* shows “WORLD TRADE CENTER” used in connection with mouse pads bearing the wording “September 11th Never Forget”³¹ and netbook cases.³²
- *ESS Online* shows “WORLD TRADE CENTER” used in connection with the sale of sunglasses and related efforts to “remember 9.11.”³³
- *Unified Veterans Worldwide Gifts* features WORLD TRADE CENTER cell phone cases,³⁴ mouse pads,³⁵ enclosures for LCD displays and enclosures for video players emblazoned with the wording “9-11-01 never forget.”³⁶
- *Zazzle* advertises WORLD TRADE CENTER Tribute in Light mouse pads “in remembrance of the events of Sept. 11, 2001”³⁷ and mouse pads invoking consumers to “remember WORLD TRADE CENTER,”³⁸ as well as WORLD TRADE CENTER magnets described as a “great memento for the 10th anniversary of the terror attacks of September 11 2001”³⁹ and WORLD TRADE CENTER phone cases bearing the wording “in memory of those who perished” and “we will never forget.”⁴⁰

Third party evidence also shows the wording WTC commonly used in connection with applicant’s goods in Class 9. For example:

- *Cafe Press Online* advertises WTC enclosures for LCD displays and video players,⁴¹ mouse pads,⁴² including a “WTC Memorial Flag Mousepad,”⁴³ memorial magnets⁴⁴ and cell phone cases.⁴⁵

²⁹ *Final Office action dated 10/15/2013 at pages 168-173.*

³⁰ *Final Office action dated 10/15/2013 at pages 94, 117-118, 143.*

³¹ *Final Office action dated 10/15/2013 at pages 37 and 47.*

³² *Final Office action dated 10/15/2013 at page 48.*

³³ *Final Office action dated 10/15/2013 at page 71.*

³⁴ *Final Office action dated 10/15/2013 at pages 125-127.*

³⁵ *Final Office action dated 10/15/2013 at pages 122 and 135.*

³⁶ *Final Office action dated 10/15/2013 at pages 128-131.*

³⁷ *Final Office action dated 10/15/2013 at page 112.*

³⁸ *Final Office action dated 10/15/2013 at page 113.*

³⁹ *Final Office action dated 10/15/2013 at page 114.*

⁴⁰ *Final Office action dated 10/15/2013 at page 115.*

⁴¹ *Final Office action dated 10/15/2013 at page 138.*

⁴² *Final Office action dated 10/15/2013 at pages 119 and 141.*

⁴³ *Final Office action dated 10/15/2013 at page 24.*

⁴⁴ *Final Office action dated 10/15/2013 at page 23.*

⁴⁵ *Final Office action dated 10/15/2013 at pages 144-145.*

- *CowCow.com* shows the wording “WTC” used in connection with 9/11 tribute USB flash drives,⁴⁶ “Tuesday, September 11th” netbook cases,⁴⁷ WTC “Wall of Honor” memorial netbook cases,⁴⁸ WTC mouse pads,⁴⁹ including those acknowledging heroes of 9/11,⁵⁰ and WTC 911 tribute magnets.⁵¹
- *Etsy* features 9/11 WTC memorial phone cases and covers.⁵²
- *Red Bubble Online* markets “tribute in light WTC 9/11” cell phone cases.⁵³
- *Zazzle Online* shows the wording “WTC” in connection with tribute mouse pads.⁵⁴

With regard to the applied-for goods in Class 14:

- *Amazon Online* shows “WORLD TRADE CENTER” featured on jewelry, including charms,⁵⁵ and in connection with wall clocks.⁵⁶
- *Cafe Press Online* shows the wording “WORLD TRADE CENTER” used in connection with the sale of commemorative clocks⁵⁷ and a variety of jewelry, including earrings⁵⁸ and necklaces.⁵⁹
- *The Castle* advertises WORLD TRADE CENTER jewelry to “remember those who lost and sacrificed during one of the hardest times America has ever faced with this wonderfully detailed 9-11-01 pendant.”⁶⁰
- *The Charm Factory* features WORLD TRADE CENTER charms to “memorialize 911.”⁶¹
- *CowCow.com* markets WORLD TRADE CENTER key rings,⁶² clocks⁶³ and a variety of jewelry, including watches⁶⁴ and earrings bearing the wording “September 11th Never Forget.”⁶⁵
- *Cuff Links Depot Online* features memorial WORLD TRADE CENTER cuff links to “never let you forget what happened on 9-11-01.”⁶⁶
- *Ebay* features memorial WORLD TRADE CENTER pins and other jewelry.⁶⁷

⁴⁶ *Final Office action dated 10/15/2013 at pages 38, 40, 52.*

⁴⁷ *Final Office action dated 10/15/2013 at page 48.*

⁴⁸ *Final Office action dated 10/15/2013 at page 155.*

⁴⁹ *Final Office action dated 10/15/2013 at page 49.*

⁵⁰ *Final Office action dated 10/15/2013 at page 59.*

⁵¹ *Final Office action dated 10/15/2013 at pages 44 and 46.*

⁵² *Final Office action dated 10/15/2013 at page 192.*

⁵³ *Final Office action dated 10/15/2013 at page 111.*

⁵⁴ *Final Office action dated 10/15/2013 at page 113.*

⁵⁵ *Final Office action dated 10/15/2013 at page 10.*

⁵⁶ *Final Office action dated 10/15/2013 at page 11.*

⁵⁷ *Final Office action dated 10/15/2013 at pages 20, 181.*

⁵⁸ *Final Office action dated 10/15/2013 at pages 21-22.*

⁵⁹ *Final Office action dated 10/15/2013 at page 149.*

⁶⁰ *Final Office action dated 10/15/2013 at page 26.*

⁶¹ *Final Office action dated 10/15/2013 at page 27.*

⁶² *Final Office action dated 10/15/2013 at pages 42-43.*

⁶³ *Final Office action dated 10/15/2013 at pages 32, 157.*

⁶⁴ *Final Office action dated 10/15/2013 at pages 42-43, 158-159.*

⁶⁵ *Final Office action dated 10/15/2013 at page 39.*

⁶⁶ *Final Office action dated 10/15/2013 at page 56.*

⁶⁷ *Final Office action dated 10/15/2013 at pages 61-70, 152.*

- *Etsy* features “WORLD TRADE CENTER” memorial and commemorative key rings,⁶⁸ medals⁶⁹ and jewelry, including necklaces,⁷⁰ beads,⁷¹ rings,⁷² charms⁷³ and bracelets.⁷⁴
- *Memorial Bracelets.com* features memorial bracelets alongside the wording WORLD TRADE CENTER.⁷⁵
- *NYC Webstore* markets WORLD TRADE CENTER lapel pins and statuettes in conjunction with 9/11 remembrance efforts.⁷⁶
- *Pieces of History Online* features a “9/11 WORLD TRADE CENTER commemorative key ring.”⁷⁷
- *Unified Veterans Worldwide Gifts* features WORLD TRADE CENTER clocks emblazoned with the wording “9-11-01 never forget.”⁷⁸
- *Zazzle Online* features WORLD TRADE CENTER ornaments bearing the wording “never forgotten 9/11.”⁷⁹

Similarly, third party evidence shows the wording “WTC” used commonly in connection with the applied-for goods in Class 14. For example:

- *AMS Inc.* shows the wording “WTC” on a magnetic bracelet and in connection with remembering the heroic efforts of F.D.N.Y. 343 on 9/11.⁸⁰
- *Ayaka Nishi* advertises “WTC 9/11 Memorial” lapel pins.⁸¹
- *Beads and Charms Online* features a “WTC 9/11/01 pewter pin.”⁸²
- *Cafe Press Online* features a variety of WTC jewelry, including necklaces⁸³ and bracelets,⁸⁴ WTC key rings bearing the wording “9-11-01 never forget”⁸⁵ and wall clocks featuring the wording “WTC – Tragedy & Determination,”⁸⁶ “never forget”⁸⁷ and “9-11-01 Never Forget.”⁸⁸
- *The City Design Group* markets “911 WTC” memorial earrings.⁸⁹

⁶⁸ *Final Office action dated 10/15/2013 at page 77.*

⁶⁹ *Final Office action dated 10/15/2013 at page 78.*

⁷⁰ *Final Office action dated 10/15/2013 at pages 79, 187.*

⁷¹ *Final Office action dated 10/15/2013 at pages 72-73.*

⁷² *Final Office action dated 10/15/2013 at pages 81-82.*

⁷³ *Final Office action dated 10/15/2013 at page 75.*

⁷⁴ *Final Office action dated 10/15/2013 at pages 57-58, 74.*

⁷⁵ *Final Office action dated 10/15/2013 at page 83.*

⁷⁶ *Final Office action dated 10/15/2013 at page 90.*

⁷⁷ *Final Office action dated 10/15/2013 at page 95.*

⁷⁸ *Final Office action dated 10/15/2013 at pages 132, 134.*

⁷⁹ *Final Office action dated 10/15/2013 at page 110.*

⁸⁰ *Final Office action dated 10/15/2013 at page 13.*

⁸¹ *Final Office action dated 10/15/2013 at page 14.*

⁸² *Final Office action dated 10/15/2013 at page 17.*

⁸³ *Final Office action dated 10/15/2013 at page 149.*

⁸⁴ *Final Office action dated 10/15/2013 at page 149.*

⁸⁵ *Final Office action dated 10/15/2013 at page 140.*

⁸⁶ *Final Office action dated 10/15/2013 at page 174.*

⁸⁷ *Final Office action dated 10/15/2013 at page 104.*

⁸⁸ *Final Office action dated 10/15/2013 at page 137.*

⁸⁹ *Final Office action dated 10/15/2013 at page 28.*

- *CowCow.com* features WTC tribute watches,⁹⁰ including those bearing the wording “never forget,”⁹¹ and WTC 911 tribute earrings.⁹²
- *Ebay* features memorial WTC jewelry, including pins⁹³ and “WTC 911” bracelets.⁹⁴
- *Etsy* features WTC memorial charm bracelets.⁹⁵
- *Memorial Bracelets.com* features WTC memorial bracelets.⁹⁶
- *NYC Firestore Online* features a variety of WTC pins honoring the anniversary of 9/11/01.⁹⁷
- *NYFirePolice.Com* markets a “9-11 Memorial Pin” bearing the wording “WTC.”⁹⁸
- *Tribute Center* features commemorative coins featuring the wording “tribute WTC”⁹⁹ and tribute lapel pins bearing the wording “WTC 9/11.”¹⁰⁰

With regard to the applied-for goods in Class 16, the website evidence of record includes “WORLD TRADE CENTER” used commonly by third parties. For example:

- *911 Memorial Online* shows “WORLD TRADE CENTER” used in connection with the sale of a variety of historical accounts of the World Trade Center.¹⁰¹
- *9/11 Tribute Center* shows “WORLD TRADE CENTER” used in connection with the sale of a variety of historical accounts of the World Trade Center.¹⁰²
- *Amazon Online* shows “WORLD TRADE CENTER” used in connection with the sale of a variety of historical accounts of the World Trade Center,¹⁰³ decals bearing the wording “9-11-01 remember” and “we will never forget.”¹⁰⁴
- *Barnes & Noble Online* shows the wording “WORLD TRADE CENTER” used in connection with a variety of commemorative and memorial books.¹⁰⁵
- *Cafe Press Online* shows “WORLD TRADE CENTER” used in connection with 9/11 memorial stickers,¹⁰⁶ greeting cards,¹⁰⁷ posters,¹⁰⁸ bumper stickers¹⁰⁹ and 9/11 tribute calendars.¹¹⁰

⁹⁰ *Final Office action dated 10/15/2013 at pages 53, 55.*

⁹¹ *Final Office action dated 10/15/2013 at page 53.*

⁹² *Final Office action dated 10/15/2013 at page 54.*

⁹³ *Final Office action dated 10/15/2013 at pages 63-70, 152-153.*

⁹⁴ *Final Office action dated 10/15/2013 at page 60.*

⁹⁵ *Final Office action dated 10/15/2013 at pages 57-58.*

⁹⁶ *Final Office action dated 10/15/2013 at page 83.*

⁹⁷ *Final Office action dated 10/15/2013 at pages 184, 193-196.*

⁹⁸ *Final Office action dated 10/15/2013 at page 93.*

⁹⁹ *Final Office action dated 10/15/2013 at pages 99-100.*

¹⁰⁰ *Final Office action dated 10/15/2013 at page 101.*

¹⁰¹ *Final Office action dated 10/15/2013 at pages 160-163.*

¹⁰² *Final Office action dated 10/15/2013 at page 190.*

¹⁰³ *Final Office action dated 10/15/2013 at pages 9, 12.*

¹⁰⁴ *Final Office action dated 10/15/2013 at pages 97-98.*

¹⁰⁵ *Final Office action dated 10/15/2013 at pages 15, 84-89.*

¹⁰⁶ *Final Office action dated 10/15/2013 at pages 116, 120, 164, 191.*

¹⁰⁷ *Final Office action dated 10/15/2013 at page 175.*

¹⁰⁸ *Final Office action dated 10/15/2013 at pages 151, 167.*

¹⁰⁹ *Final Office action dated 10/15/2013 at page 178.*

- *CowCow.com* shows the wording “WORLD TRADE CENTER” used in connection with “Tuesday, September 11th Greeting Cards,”¹¹¹ tribute greeting cards honoring 9/11 rescue efforts¹¹² and 9/11 remembrance coasters.¹¹³
- *Etsy* features WORLD TRADE CENTER prints¹¹⁴ and decals honoring 9/11 and featuring the wording “never forget.”¹¹⁵
- *lcograda* features a “WORLD TRADE CENTER” poster “in commemoration of the September 11 World Trade Centre tragedy.”¹¹⁶
- *NYC Webstore* features WORLD TRADE CENTER art prints alongside the wording “never forget.”¹¹⁷
- *Unified Veterans Worldwide Gifts* features WORLD TRADE CENTER decals and stickers emblazoned with the wording “9-11-01 never forget.”¹¹⁸
- *Zazzle Online* features WORLD TRADE CENTER tribute binders.¹¹⁹

The evidence also shows “WTC” commonly used in connection with applicant’s Class 16 goods. For example:

- *Cafe Press Online* shows “WTC” used in connection with 9/11 memorial stickers,¹²⁰ notecards,¹²¹ posters,¹²² bumper stickers,¹²³ and journals¹²⁴ and features “WTC memorial flag postcards,”¹²⁵ and WTC 9/11 tribute calendars.¹²⁶
- *CowCow.com* shows the wording “WTC” used in connection with “Tuesday, September 11th Greeting Cards,”¹²⁷ WTC 911 tribute greeting cards,¹²⁸ WTC 911 tribute stickers,¹²⁹ coasters,¹³⁰ and WTC 911 tribute postcards.¹³¹
- *Ebay* features WTC memorial and commemorative stickers, including those featuring the wording “9-11” and “we will never forget.”¹³²

¹¹⁰ Final Office action dated 10/15/2013 at page 177.

¹¹¹ Final Office action dated 10/15/2013 at page 31.

¹¹² Final Office action dated 10/15/2013 at page 156.

¹¹³ Final Office action dated 10/15/2013 at page 33.

¹¹⁴ Final Office action dated 10/15/2013 at pages 80, 105-106.

¹¹⁵ Final Office action dated 10/15/2013 at page 76.

¹¹⁶ Final Office action dated 10/15/2013 at page 189.

¹¹⁷ Final Office action dated 10/15/2013 at page 91.

¹¹⁸ Final Office action dated 10/15/2013 at pages 123-124.

¹¹⁹ Final Office action dated 10/15/2013 at pages 18, 188.

¹²⁰ Final Office action dated 10/15/2013 at pages 25, 116.

¹²¹ Final Office action dated 10/15/2013 at pages 176, 179.

¹²² Final Office action dated 10/15/2013 at page 151.

¹²³ Final Office action dated 10/15/2013 at page 178.

¹²⁴ Final Office action dated 10/15/2013 at pages 121, 150.

¹²⁵ Final Office action dated 10/15/2013 at page 165.

¹²⁶ Final Office action dated 10/15/2013 at page 180.

¹²⁷ Final Office action dated 10/15/2013 at page 31.

¹²⁸ Final Office action dated 10/15/2013 at page 41.

¹²⁹ Final Office action dated 10/15/2013 at page 51.

¹³⁰ Final Office action dated 10/15/2013 at page 33.

¹³¹ Final Office action dated 10/15/2013 at page 50.

¹³² Final Office action dated 10/15/2013 at page 154.

- *Etsy* features WTC 9/11 tribute photos and prints.¹³³
- *NYC Firestore* shows WTC used in connection with memorial decals.¹³⁴

Finally, regarding the applied-for goods in Class 18, third party website evidence of record shows:

- *CowCow.com* shows the wording WORLD TRADE CENTER used in connection with a variety of bags,¹³⁵ coin purses,¹³⁶ empty cosmetic bags¹³⁷ and leather cases.¹³⁸
- *Distinctive Umbrellas* features WORLD TRADE CENTER memorial umbrellas.¹³⁹
- *Zazzle Online* features “never forget WORLD TRADE CENTER” luggage tags, including those bearing the wording “never forget WTC incident 11 Sep 2001 rest in peace to all the victims,”¹⁴⁰ and shoulder bags.¹⁴¹

Similarly, with regard to the wording “WTC” used in connection with applicant’s Class 18 goods, the evidence of record includes:

- *9/11 Tribute Center* features tote bags bearing the wording “tribute WTC 9/11.”¹⁴²
- *Amazon Online* features “WTC luggage tags,” which feature the wording “September 11, 2001” and “we will never forget.”¹⁴³
- *Cafe Press Online* shows the wording “WTC” used in connection with a variety of memorial and tribute bags,¹⁴⁴ including tote bags,¹⁴⁵ empty toiletry bags,¹⁴⁶ duffle bags,¹⁴⁷ handbags,¹⁴⁸ shoulder bags¹⁴⁹ and sports bags.¹⁵⁰
- *Zazzle Online* features WTC luggage tags, including those bearing the wording “September 11, 2001” and “we will never forget.”¹⁵¹

¹³³ *Final Office action dated 10/15/2013 at page 80.*

¹³⁴ *Final Office action dated 10/15/2013 at pages 182-183, 185.*

¹³⁵ *Final Office action dated 10/15/2013 at pages 29-30.*

¹³⁶ *Final Office action dated 10/15/2013 at pages 34, 36.*

¹³⁷ *Final Office action dated 10/15/2013 at pages 35, 45.*

¹³⁸ *Final Office action dated 10/15/2013 at page 133.*

¹³⁹ *Final Office action dated 10/15/2013 at page 103.*

¹⁴⁰ *Final Office action dated 10/15/2013 at page 109.*

¹⁴¹ *Final Office action dated 10/15/2013 at pages 107-108.*

¹⁴² *Final Office action dated 10/15/2013 at page 102.*

¹⁴³ *Final Office action dated 10/15/2013 at page 96.*

¹⁴⁴ *Final Office action dated 10/15/2013 at pages 19, 136, 146-147.*

¹⁴⁵ *Final Office action dated 10/15/2013 at pages 19, 136, 146-148.*

¹⁴⁶ *Final Office action dated 10/15/2013 at pages 19, 139.*

¹⁴⁷ *Final Office action dated 10/15/2013 at page 19.*

¹⁴⁸ *Final Office action dated 10/15/2013 at page 19.*

¹⁴⁹ *Final Office action dated 10/15/2013 at page 19.*

¹⁵⁰ *Final Office action dated 10/15/2013 at pages 19, 148.*

¹⁵¹ *Final Office action dated 10/15/2013 at pages 96, 109.*

This evidence together illustrates that widespread third-party usage has rendered the applied-for wording incapable of functioning as a trademark for the applied-for goods because, rather than indicating the source of these goods, WORLD TRADE CENTER and WTC are used in common parlance to call to mind the events of September 11. Because consumers are accustomed to seeing “WORLD TRADE CENTER” and “WTC” used in connection with the applied-for goods in an effort to remember the events that transpired and lives that were lost on September 11, 2001, without any indication and/or reason in truth or conjecture to believe that a single entity is the source of those goods, the wording cannot distinguish applicant’s goods from others and, therefore, cannot be source-indicating.

Applicant’s suggestion that the wording WORLD TRADE CENTER and WTC can or must “‘only’ signify the terrorist attack”¹⁵² in order for this refusal to be applicable is not well-taken, as the evidence of record is clear that the wording certainly signifies more.¹⁵³ Furthermore, the standard is not that the wording must only signify non-trademark use but rather, to be registrable, the applied-for wording must point to a single source, which the substantial evidence of record directly contradicts.

Applicant’s position that the instant case is akin to either of *Lucasfilm Ltd v. High Frontier*,¹⁵⁴ *The Munters Corp. v. Matsui America, Inc.*,¹⁵⁵ and/or *Visa Int’l Servs. Ass’n v. JSL Corp.*¹⁵⁶ is misguided. Specifically, both *Munters* and *Visa* involve infringement and descriptive wording, neither of which is at issue here. Furthermore, each of these cases involves wording that functions both as a distinctive trademark and separately as a term in common parlance.¹⁵⁷ Conversely, applicant and the events of September 11 are historically intertwined, and third-party usage of the terms WORLD TRADE CENTER and WTC in connection with the applied-for goods does not call to mind a secondary and/or distinct meaning, but rather a shared history.

Applicant’s assertion that *In re Paramount Pictures Corp.*¹⁵⁸ “is more directly relevant”¹⁵⁹ is inapposite because the instant case does not involve ornamentation.¹⁶⁰ The issue does not turn on applicant’s

¹⁵² Applicant Supplemental Brief at page 15.

¹⁵³ Applicant’s reliance on *In re Thomas Jefferson Foundation*, Serial No. 77967242 (TTAB June 29, 2012) to bolster this point is off-topic. Specifically, *In re Thomas Jefferson Foundation* assessed whether registrant’s use of its mark MONTICELLO to describe a paint color functions as a trademark. It does not assess common parlance by third parties.

¹⁵⁴ 227 USPQ 967 (D.D.C. 1985).

¹⁵⁵ 14 USPQ2d 1993 (N.D. Ill. 1989).

¹⁵⁶ 95 USPQ2d 1571 (9th Cir. 2010).

¹⁵⁷ See, e.g., *Lucasfilm Ltd v. High Frontier*, 227 USPQ 967 (D.D.C. 1985), wherein plaintiff and defendant were not using the contested wording to refer to similar, or even related, events or subject matters – plaintiff being involved in entertainment services and defendant being involved in the political and/or scientific industries – and use of the contested wording was different – plaintiff using the wording to call to mind a fictional intergalactic battle and defendant using the wording to call to mind unrelated real-world defense strategy and international politics.

¹⁵⁸ 213 USPQ 1111 (TTAB 1982), which relies on *In re Olin Corp.*, 181 USPQ 182 (TTAB 1973) (stylized “O” design registrable for T-shirts, where applicant had previously registered the “O” design for skis) and *In re Expo*

placement or method of use of the applied-for wording but rather on the wording itself. To the contrary, the substantial evidence of record shows that the applied-for wording is incapable of functioning as a trademark in connection with the identified goods because consumers are accustomed to seeing *a variety of sources market these goods bearing this wording* in an effort to remember the events of September 11, 2001. Third party use of the wording in connection with the identified goods is commonplace and, therefore, not source-indicating. As such, the wording is not registrable as a trademark. *In re Eagle Crest*, 96 USPQ2d at 1229-30 (noting that “[a]s a matter of competitive policy, it should be close to impossible for one competitor to achieve exclusive rights’ in common phrases or slogans.” (quoting J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §7.23 (4th ed. 2010))).

B. Wording that fails to function as a trademark cannot be registered and, even if the mark is ultimately deemed capable of functioning, applicant has not sufficiently established acquired distinctiveness in connection with the applied-for goods.

The applicant cannot overcome a refusal of trademark registration issued on the ground that the matter is merely informational by attempting to amend the application to seek registration on the Supplemental Register or pursuant to §2(f). *See In re Eagle Crest*, 96 USPQ2d at 1230 (noting because consumers would be accustomed to seeing the phrase ONCE A MARINE, ALWAYS A MARINE “displayed on clothing items from many different sources, they could not view the slogan as a trademark indicating source of the clothing only in applicant”); TMEP § 1202.04.

Nevertheless, the examining attorney must review the evidence and make a separate, alternative, determination as to whether, if the proposed mark is ultimately determined to be capable, the applicant’s evidence is sufficient to establish acquired distinctiveness. The examining attorney must also consider whether the applicant’s evidence has any bearing on the underlying refusal. TMEP §1212.02(i).

An intent-to-use applicant who has used the same mark on related goods and/or services may file a claim of acquired distinctiveness under Trademark Act Section 2(f) before filing an allegation of use if applicant can establish that, as a result of applicant’s use of the mark on other goods and/or services, the mark has become distinctive of the goods and/or services in the intent-to-use application, and that this previously created distinctiveness will transfer to the goods and/or services in the intent-to-use

’74, 189 USPQ 48 (TTAB 1975) (reversing the refusal and holding EXPO ‘74 registrable for handkerchiefs and T-shirts, since applicant, organizer of the 1974 World’s Fair, had previously registered EXPO ‘74 for other goods and services).

¹⁵⁹ *Applicant Supplemental Brief* at page 4.

¹⁶⁰ *See, e.g., In re Expo ‘74*, 189 USPQ 48, 49 (TTAB 1975): “the Examiner’s holding is that ‘EXPO ‘74,’ as displayed across the front of applicant’s goods, does not constitute trademark use thereof.”

application when use in commerce begins. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1347, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001); *In re Nielsen Bus. Media, Inc.*, 93 USPQ2d 1545, 1547 (TTAB 2010); *In re Binion*, 93 USPQ2d 1531, 1538 (TTAB 2009); TMEP §1212.09(a).

However, if there is sufficient evidence to indicate that consumers are accustomed to seeing a slogan or term used in connection with the relevant goods/services from many different sources, registration should be refused in §1(b), §44, and §66(a) applications because the slogan or term would not be perceived as a mark. *See In re Eagle Crest*, 96 USPQ2d at 1230 (holding that because the function of a trademark is to identify a single commercial source for particular goods/services, if consumers are accustomed to seeing a slogan used in connection with goods/services from many different sources, it is likely that consumers would not view the slogan as a source identifier for such goods/services); TMEP §1202.04.

To support a claim of acquired distinctiveness, applicant points to its prior registrations for association services, a report by George Mantis on the results of a consumer perception survey, and a report by Dr. Erich Joachimsthaler on the creation and growth of applicant's brand identity.

Applicant's prior registrations for the wording WORLD TRADE CENTER and WTC in connection with association services¹⁶¹ cannot support applicant's claim of acquired distinctiveness in the instant case because applicant has not established that its association services and applied-for goods are sufficiently related such that distinctiveness will transfer to the goods in the application. Applicant must establish, through submission of relevant evidence rather than mere conjecture, a sufficient relationship between the services in connection with which the mark has acquired distinctiveness and the goods recited in the intent-to-use application to warrant the conclusion that the previously created distinctiveness will transfer to the goods in the application upon use. *In re Rogers*, 53 USPQ2d 1741, 1744 (TTAB 1999); TMEP §1212.09(a).

Applicant's argument in this regard is based primarily on registrations owned by third parties for both association services and the goods at issue.¹⁶² However, the burden of proving that a mark has acquired

¹⁶¹ U.S. Registration Nos. 1469489 and 1749086.

¹⁶² *Applicant's Response dated 03/04/2013* at Exhibits 4 and 5. Applicant also suggests that renewal of applicant's prior registrations for the applied-for wording in connection with association services since 9/11/01 "is evidence that the Mark functions as a strong trademark in the minds of consumers, not just in connection with the services covered by Applicant's registrations, but generally and in connection with the goods covered by the subject application." *See Response to Office Action dated 03/04/2013*. However, applicant's assertion that its prior registrations encompass more than those services enumerated in the claimed registrations is impermissible. It is well-established that the nature and scope of a party's services must be determined on the basis of the services recited in the registration. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1370, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012);

distinctiveness is on the applicant. *Yamaha Int'l Corp. v. Yoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988); *In re Meyer & Wenthe, Inc.*, 267 F.2d 945, 122 USPQ 372 (C.C.P.A. 1959); TMEP §1212.01. An applicant must establish that the purchasing public has come to view the proposed mark as an indicator of origin. Using this standard, it is unclear how the acquired distinctiveness garnered by others has any bearing on whether the purchasing public currently views the wording WORLD TRADE CENTER and WTC as indicating origin in connection with the applied-for goods.¹⁶³ Specifically, a claim of acquired distinctiveness is not a theoretical analogy but rather a finding based on fact. See *In re Loew's Theatres, Inc.*, 769 F.2d 764, 769-70, 226 USPQ 865, 869 (Fed. Cir. 1985); TMEP §1212.01.

Applicant submits a report by George Mantis on the results of a consumer perception survey in an attempt to show acquired distinctiveness of the wording WORLD TRADE CENTER in connection with “backpacks, fanny packs and tote bags.”¹⁶⁴ However, this evidence is not persuasive.

A threshold matter in assessing survey evidence is that the survey must be sound.¹⁶⁵ In this case, the survey submitted is described as *Teflon*-style study. This survey style is generally informative in connection with genericness,¹⁶⁶ but it remains unclear why it is relevant here. Specifically, while all generic wording is incapable of functioning as a trademark,¹⁶⁷ not all matter that fails to function is generic.¹⁶⁸

Hewlett-Packard Co. v. Packard Press Inc., 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1463, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991); *Octocom Sys., Inc. v. Houston Computer Servs., Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1493, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); *Paula Payne Prods. Co. v. Johnson Publ'g Co.*, 473 F.2d 901, 902, 177 USPQ 76, 77 (C.C.P.A. 1973); *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1500 (TTAB 2010); TMEP §1207.01(a)(iii).

¹⁶³ Applicant also argues that this wording is registrable because many of applicant's licensees identify the mark WORLD TRADE CENTER with applicant's services. Applicant submitted several sworn statements attesting to their licensees' recognition of WTC and WORLD TRADE CENTER marks used in conjunction with building a global marketplace for international trade. See *Response to Office Action dated 8/9/2012* at Exhibit 10. However, although each of these affidavits support recognition of the applied-for mark as source-indicating for association services, for which applicant owns live registrations, none supports recognition of the applied-for mark in connection with the goods in the instant application.

¹⁶⁴ *Applicant Request for Remand dated 03/14/2014* Exhibit C, Report of George Mantis at pages 4-5.

¹⁶⁵ See *In re Country Music Association Inc.*, 100 U.S.P.Q.2D 1824, 1832 (TTAB Oct. 25, 2011): “As a threshold matter, we find that the methodology used in Dr. Ford's survey to be sound.”

¹⁶⁶ See J. Thomas McCarthy, *McCarthy on Trademarks* §12:14 (4th ed., vol. 2, 2013): “[t]wo preferred models of surveys to test for genericness have been approved by the courts: the Thermos Model and the Teflon model.”

¹⁶⁷ See TMEP §1209.01(c).

¹⁶⁸ See, e.g., TMEP §1202.17(c).

Teflon-style studies generally involve a primer explaining the difference between generic and brand names and participants are then asked to classify different terms, including the disputed name, as one of these two types.¹⁶⁹ In this case, the “introduction” received by participants is not provided for the record nor is it clear whether respondents were capable of distinguishing between brand names and common names.¹⁷⁰ While applicant’s brief indicates that Mr. Mantis did not present the standard *Teflon* introductory primer on the difference between generic words and trademarks, applicant provides no information regarding the primer that Mr. Mantis *did* present.¹⁷¹

Furthermore, the survey questions and answer choices are poorly worded because they do not directly ask whether a term constitutes a “brand” or “proprietary” name.¹⁷² For example, applicant maintains that Questions 1 and 4 are relevant because they reflect different forms of single source identification. However, applicant provides no information regarding how single source identification was explained to participants and/or whether respondents were capable of distinguishing between words functioning as trademarks and those that do not. Equally problematic, respondents were not eliminated if they failed to understand the distinction between wording that functions as a trademark and wording that is not source-indicating.¹⁷³ Moreover, it is unclear whether participants equated single source identification with being a brand or proprietary name, and this duplicative questioning may have affected respondents’ answers, understanding and/or bias in participating. Specifically, Question 4 was only

¹⁶⁹ *McCarthy on Trademarks and Unfair Competition* explains, “a ‘Teflon Survey’ is essentially a mini-course in the generic versus trademark distinction, followed by a test.” J. Thomas McCarthy, *McCarthy on Trademarks* §12:16 (4th ed., vol. 2, 2013). In *Schwan’s IP, LLC v. Kraft Pizza Co.*, which also assesses a *Teflon*-style study administered by George Mantis, the Court explains that “respondents are first instructed on the definition of common names and brand names, pre-tested on their understanding of common names and brand names, and then asked to categorize certain test and control phrases or words as brand names or common names.” 379 F. Supp. 2d 1016, 1024 (D. Minn. 2005).

¹⁷⁰ *Applicant Request for Remand dated 03/14/2014*, Exhibit C, Report of George Mantis, Section IV(A); *See In re Shuffle Master, Inc.*, Serial No. 77394063 (TTAB Dec. 8, 2011), distinguishing *In re Country Music Association Inc.*, 100 U.S.P.Q.2D 1824 (TTAB Oct. 25, 2011): “By contrast, in the Board’s recently decided case of *In re Country Music Ass’n, Inc.*, Application Serial Nos. 78906900 and 78901341, 100 USPQ2d 1824 (TTAB October 25, 2011), respondents were screened in the following manner to ensure their understanding of this conceptual distinction: The interviewer explained to the qualified survey respondents the conceptual distinction between a “brand or proprietary name” and “common name” using the following example: “By brand or proprietary name, I mean a name like ‘Bank of America’ which is used by one company or organization; by a ‘common name’ I mean a name like ‘safe deposit box’ which is used by a number of different companies or organizations. Ford Declaration, P 14. Respondents were then asked two questions to test their ability to distinguish brand or proprietary names from common names: (1) Do you understand the name “National Football League” to be a brand or proprietary name or common term? (2) Do you understand the name “high school football” to be a brand or proprietary name or common term? One hundred persons were deemed qualified and interviewed after completion of the screening process. These qualified respondents were then given a list of terms and asked whether they were brand or common names.”

¹⁷¹ *See Applicant Supplemental Brief* at page 11; *See also Applicant Request for Remand dated 03/14/2014*, Exhibit C, Report of George Mantis, Section IV(A). Notably, although Mr. Mantis indicates in footnote 1 of his report that “the screener and questionnaire are attached as Exhibit A,” Exhibit A does not include an explanation of proprietary trademark principles or an examination of respondents’ understanding.

¹⁷² *See In re Shuffle Master, Inc.*, Serial No. 77394063 (TTAB Dec. 8, 2011), distinguishing *In re Country Music Association Inc.*, 100 U.S.P.Q.2D 1824 (TTAB Oct. 25, 2011).

¹⁷³ *See In re Shuffle Master, Inc.*, Serial No. 77394063 (TTAB Dec. 8, 2011): “Equally problematic, respondents were not eliminated if they failed to understand the distinction.”

asked to respondents who indicated “more than one company” or “don’t you know or have an opinion” to Question 1.¹⁷⁴ And, for example, although Mr. Mantis includes respondent ID numbers 64 and 68 in the tabulation of those who recognize applicant as the source of the goods, both of these respondents indicate that they don’t think of the wording as a brand.¹⁷⁵

It is unclear how participants were “recruited;”¹⁷⁶ in particular, whether participants self-selected, whether the survey needed to be completed online, what account credit “points” correspond to and/or can be redeemed for,¹⁷⁷ whether any participant has had any connection to applicant, and/or whether the participants are United States consumers.¹⁷⁸ The overall sample size is also problematic; a generous assessment supports that a total of 19 respondents identify applicant as the source of the applied-for goods.¹⁷⁹

It is important to note that only use of the applied-for wording WORLD TRADE CENTER in connection with select goods in Class 18 is included.¹⁸⁰ Accordingly, it is unclear how the results generalize to the applied-for WTC mark, to the remainder of the Class 18 goods and/or to the applied-for goods in Classes 9, 14 and 16. While applicant presumes that the results can be generalized, it appears that applicant gathered evidence corroborating this point yet declined to include it.¹⁸¹ This is in stark contrast to the substantial evidence of record firmly establishing that the applied-for wording fails to function as a source-indicator in connection with a panoply of the identified goods.

¹⁷⁴ *Applicant Request for Remand dated 03/14/2014*, Exhibit C, Report of George Mantis, Section IV(C).

¹⁷⁵ *Applicant Request for Remand dated 03/14/2014*, Exhibit C, Report of George Mantis, Section V, Table 2. In fact, of the 51 respondents purportedly identifying a single source as the originator for the questioned goods, a liberal assessment reveals that only 16 (respondent ID numbers 5, 16, 31, 23, 35, 38, 46, 47, 97, 115, 131, 133, 141, 153, 171, 178) arguably provide a response to Question 4 that indicates they believe the identified goods originate with a single source and do not point more generally to the events and aftermath of September 11, 2001.

¹⁷⁶ *Applicant Request for Remand dated 03/14/2014*, Exhibit C, Report of George Mantis, Section A; *See also In re Country Music Association Inc.*, 100 U.S.P.Q.2D 1824, 1831 (TTAB Oct. 25, 2011): “survey sample was based on a random digit probability sample of computer-generated phone numbers derived from all working telephones in the continental United States and based on a representative sample of the U.S. population. Using a double-blind protocol, the interviewers screened for qualified survey respondents who consisted of males and females at least 18 years of age who listened to country western music.”

¹⁷⁷ *Applicant Request for Remand dated 03/14/2014*, Exhibit C, Report of George Mantis, Exhibit A.

¹⁷⁸ Applicant takes issue with the Examining Attorney’s inquiry as to whether the participants were United States consumers. *See Applicant’s Supplemental Brief* at page 7, footnote 2. However, it is well-established that “we are only concerned with the perception of consumers in the United States.” *In re Eagle Crest, Inc.* 96 USPQ2d 1227, 1230 (TTAB 2010).

¹⁷⁹ Only 204 people participated. Website evidence from *Central Intelligence Agency* establishes that recent estimates place the U.S. population level at approximately 318,892,103. Accordingly, and at best, approximately .0000064% of the U.S. population participated in Mr. Mantis’ study. Out of the total U.S. population, this number seems entirely insignificant.

¹⁸⁰ *Applicant Request for Remand dated 03/14/2014*, Exhibit C, Report of George Mantis, Section I.

¹⁸¹ *Applicant Request for Remand dated 03/14/2014*, Exhibit C, Report of George Mantis, Exhibit A, S5-S6. In addition, although the screening questions ask participants to provide the main topic of this survey “for quality-control purposes,” this information has not been provided. *See Applicant Request for Remand dated 03/14/2014*, Exhibit C, Report of George Mantis, Exhibit A.

In addition, the submitted results are problematic. For example, while Table 1 purportedly shows “the compilation of one company/organization responses to Questions 1 and 4,”¹⁸² Table 2 only provides respondents’ answers to Questions 3, 4, 5 and 6.¹⁸³ As such, it is impossible to assess participant’s answers to questions 1 and 2 and whether responses “reasonably confirmed they were thinking of whomever owns the marks for the complex of buildings destroyed on 9/11,” “whether I could reasonably determine which particular entity the respondents had in mind, even though they may have described that entity in different ways” and related conclusions.¹⁸⁴ Although applicant indicates that the above assessment is not well-taken¹⁸⁵ and suggests that the survey results are transparent and complete, the record simply does not support this interpretation. For example, contrary to applicant’s suggestion that “the Mantis Report includes the verbatim responses for all of the open-ended Questions 2,”¹⁸⁶ only a single verbatim response for Question 2 is included.¹⁸⁷

Based on the foregoing, the examining attorney has established that the submitted survey methodology is fundamentally flawed and, therefore, the probative value is considerably marginalized. Accordingly, the results do not carry applicant’s burden of establishing secondary meaning for WORLD TRADE CENTER and WTC in connection with the identified goods, particularly in light of the considerable evidence of record illustrating common third party use.

Applicant also submits the report of Dr. Erich Joachimsthaler to provide insight into applicant’s larger brand.¹⁸⁸ However, the value of affidavits or declarations depends on the statements made and the identity of the affiant or declarant. *See In re Chem. Dynamics Inc.*, 839 F.2d 1569, 1571, 5 USPQ2d 1828, 1830 (Fed. Cir. 1988); TMEP § 1212.06(c). In this case, the statements of Dr. Joachimsthaler are of limited value because they are speculative and because he was retained for the purposes of this assessment. Dr. Joachimsthaler also bases much of his analysis on material provided by applicant, including the above-referenced and questionable survey.¹⁸⁹

¹⁸² *Applicant Request for Remand dated 03/14/2014*, Exhibit C, Report of George Mantis, Section V.

¹⁸³ *Id.*

¹⁸⁴ *Applicant Request for Remand dated 03/14/2014*, Exhibit C, Report of George Mantis, Section V.

¹⁸⁵ *Applicant Supplemental Brief* at page 9, footnote 3.

¹⁸⁶ *Applicant Supplemental Brief* at page 9, footnote 3.

¹⁸⁷ *Applicant Request for Remand dated 03/14/2014*, Exhibit C, Report of George Mantis, “Louisiana State University” respondent ID number 86.

¹⁸⁸ Specifically, this report purportedly assesses “how the future sale of the Merchandise is part of a well-established method for expanding the reach and value of the brand.” *Applicant Request for Remand dated 03/14/2014*, Exhibit D, Report of Dr. Erich Joachimsthaler, Paragraph 10; *See also Applicant Supplemental Brief* at page 14.

¹⁸⁹ *Applicant Request for Remand dated 03/14/2014*, Exhibit D, Report of Dr. Erich Joachimsthaler, Para. 11(d).

Furthermore, allegations of sales and advertising expenditures do not per se establish that a term has acquired significance as a mark. An applicant must also provide the actual advertising material so that the examining attorney can determine how the term is used, the commercial impression created by such use, and the significance the term would have to prospective purchasers. TMEP §1212.06(b); see *In re Boston Beer Co.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999); *In re Packaging Specialists, Inc.*, 221 USPQ 917, 920 (TTAB 1984). And while background regarding brand development and related licensing is perhaps educational, it is not relevant to trademark registrability at issue here. Specifically, trademark and service mark registrations are for particular goods and services, not for “brands” generally. See TMEP §1402.01. Despite applicant’s supposed “substantial marketing efforts and investment...poured into this branding effort by WTCA”¹⁹⁰ and “the role that the Merchandise will play in furthering the strength of the WORLD TRADE CENTER and WTC,”¹⁹¹ it is well-established that “the ultimate test in determining whether a designation has acquired distinctiveness is applicant’s success, rather than its efforts, in educating the public to associate the proposed mark with a single source.” See TMEP §1212.06(b).

The notion that applicant is “like other unfortunate brand owners who have suffered tragedy”¹⁹² fails to account for the fact that the events of September 11 are unprecedented and the magnitude unparalleled. As such, the analogies drawn by applicant are misplaced because of the greater scope and impact of the September 11 tragedy. Moreover, unlike, e.g., U.S. Registration No. 1832708 (BOSTON MARATHON for a variety of merchandise), applicant does not and has never owned trademark registrations for the goods at issue here and, therefore, the terrorist events of September 11 could not have destroyed them. Rather, applicant owns registrations for association services, none of which are at issue here.

IV. CONCLUSION

It is well-established that trademark rights are not static, and eligibility for registration must be determined on the basis of the facts and evidence in the record at the time registration is sought, which includes during examination and any related appeal. *In re Chippendales USA Inc.*, 622 F.3d 1346, 1354, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010); *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1344, 213

¹⁹⁰ *Applicant Request for Remand dated 03/14/2014*, Exhibit D, Report of Dr. Erich Joachimsthaler, Para. 12(b).

¹⁹¹ *Applicant Request for Remand dated 03/14/2014*, Exhibit D, Report of Dr. Erich Joachimsthaler, Paragraph 17. Dr. Joachimsthaler writes that “the WTCA wishes to leverage the WORLD TRADE CENTER and WTC brand by using branded merchandise.” *Applicant Request for Remand dated 03/14/2014*, Exhibit D, Report of Dr. Erich Joachimsthaler, Paragraph 55.

¹⁹² See *Applicant Supplemental Brief* at page 17; see also *Applicant Request for Remand dated 03/14/2014*, Section III(B) “like other unfortunate brand owners before it who have suffered crises affecting their brands,”; see also *Applicant Request for Remand dated 03/14/2014*, Exhibit D, Report of Dr. Erich Joachimsthaler at Paragraph 65: “in the field of branding and marketing, it is not uncommon for an unfortunate or tragic event to occur.”

USPQ 9, 18 (C.C.P.A. 1982); *In re Thunderbird Prods. Corp.*, 406 F.2d 1389, 1391, 160 USPQ 730, 732 (C.C.P.A. 1969). In this case, the Examining Attorney has demonstrated that the applied-for wording cannot function as a trademark to identify and distinguish the particular goods at issue from those of others and to indicate the source of the applied-for goods. Rather, the primary function of the familiar wording WORLD TRADE CENTER and WTC in connection with the applied-for goods as shown by the evidence of third party use is to convey information, that is, to remember the events of September 11. The more commonly a phrase is used in everyday parlance, the less likely the public will use it to identify only one source and the less likely the phrase will be recognized by purchasers as a trademark. *In re Eagle Crest*, 96 USPQ2d at 1229-30 (noting that “[a]s a matter of competitive policy, it should be close to impossible for one competitor to achieve exclusive rights’ in common phrases or slogans.” (quoting J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §7.23 (4th ed. 2010))). Matter that fails to function as a mark is unregistrable and a claim that the matter has acquired distinctiveness under §2(f) as applied to the applicant’s goods does not overcome the refusal.” *See, e.g., Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33, 58 USPQ2d 1001, 1007 (2001); TMEP § 1212.02(i).

For the forgoing reasons, the refusal to register the marks should be affirmed.

Respectfully submitted,

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