

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: June 25, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board

—
In re World Trade Centers Association, Inc.

—
Remand

—
Serial Nos. 85473613
85473617
85474746
85474748
85527008
85527029
85527100
85527119

—
Sandra Edelman of Dorsey & Whitney LLP for World Trade Centers Association,
Inc.

Evin Kozak, Trademark Examining Attorney, Law Office 116 (Michael W. Baird,
Managing Attorney).

—
Before Kuhlke, Wolfson, and Lykos,
Administrative Trademark Judges.

By the Board:

These consolidated appeals came to the Board on appeal from the Examining Attorney's refusal of registration under Sections 1, 2 and 45, 15 U.S.C. §§ 1051-52, 1127. The Examining Attorney argues that neither of the involved marks (WTC and WORLD TRADE CENTER) is capable of identifying a single source for the

identified goods. During oral argument, an issue arose regarding the identifications in the applications and nature of the goods as items sold in commerce and in ways that would draw a connection in the minds of consumers with Applicant's previously registered WORLD TRADE CENTER¹ and WTC² marks for "association services; namely, fostering and promoting world trade and international business relationships." It is this subject on which the Board would like clarification through further discussion and examination. *See* **TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE** ("TBMP") § 1209.01 (2014) ("Remand – Upon Board's Own Initiative"). Accordingly, the Board *sua sponte* remands these applications for consideration of the following possible amendment, shown in bold, to the identification of goods in each application, the extent to which the amendment associates the goods with Applicant's services,³ and the impact such amendment may have on the Examining Attorney's view of registrability:

Application Serial No. 85473613

Backpacks, book bags, sports bags, bum bags, handbags, duffel bags, fanny packs, garment bags for travel, gym bags, handbags, leather cases, tote bags, 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

¹ Registration No. 1469489 registered on December 15, 1987, renewed 2008.

² Registration No. 1749086 registered on January 26, 1993, renewed 2013.

³ *See e.g.*, **TRADEMARK MANUAL OF EXAMINING PROCEDURE** ("TMEP") § 1202.03(c) (January 2015) ("Secondary Source" wherein ornamental use of a mark on goods serves to indicate the source of a service or a "secondary source").

packs, wristlet bags, umbrellas, **all of the foregoing sold in connection with world trade and international business association services** (International Class 18);

* * *

Application Serial No. 85473617

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, stickers, **all of the foregoing sold in connection with world trade and international business association services** (International Class 16);

* * *

Application Serial No. 85474746

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, stickers, **all of the foregoing sold in connection with world trade and international business association services** (International Class 16);

* * *

Application Serial No. 85474748

Backpacks, book bags, sports bags, bum bags, handbags, duffel bags, fanny packs, garment bags for travel, gym bags, handbags, leather cases, tote bags, 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, umbrellas, **all of the foregoing sold in connection with world trade and international business association services** (International Class 18)

* * *

Application Serial No. 85527008

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 players, **all of the foregoing sold in connection with world trade and international business association services** (International Class 9)

* * *

Application Serial No. 85527029

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 players, **all of the foregoing sold in connection with world trade and international business association services** (International Class 9)

* * *

Application Serial No. 85527100

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, watches, **all of the foregoing sold in connection with world trade and international business association services** (International Class 14);

* * *

Application Serial No. 85527119

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, watches, **all of the foregoing sold in connection with world trade and international business association services** (International Class 14).

In view thereof, the Board hereby suspends action on these consolidated appeals, and the applications are remanded to the Trademark Examining Attorney for further action consistent with this order. Examination must be completed within thirty (30) days from the date of remand, or within an extension of time sought and

obtained for that purpose. In the event that registrability is found on the basis of the amendments, the consolidated appeals will be moot and the Board should be so informed. In the event refusal is maintained, either because the Examining Attorney determines the amendment or any similar amendment to the identification does not obviate the refusal or Applicant does not accept the amendment, and because of the late stage of the appeal, the Examining Attorney should advise the Board by way of a supplemental brief. Applicant may, within forty-five (45) days of the mailing date of the Examining Attorney's supplemental brief, file a supplemental reply brief solely directed to the arguments in the Examining Attorney's supplemental brief. The remand is solely for consideration of possible amendment to the identification of goods.

In view of the above, the appeals are suspended.

* * *