

This Opinion is a  
Precedent of the TTAB

Mailed: February 3, 2020

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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*In re The Ride, LLC*

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Serial No. 86845550

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Bryan W. Bockhop of Bockhop Intellectual Property Law LLC  
for The Ride, LLC.

Barney L. Charlon, Trademark Examining Attorney, Law Office 104  
(Zachary Cromer, Managing Attorney).

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Before Cataldo, Bergsman and Ritchie,  
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

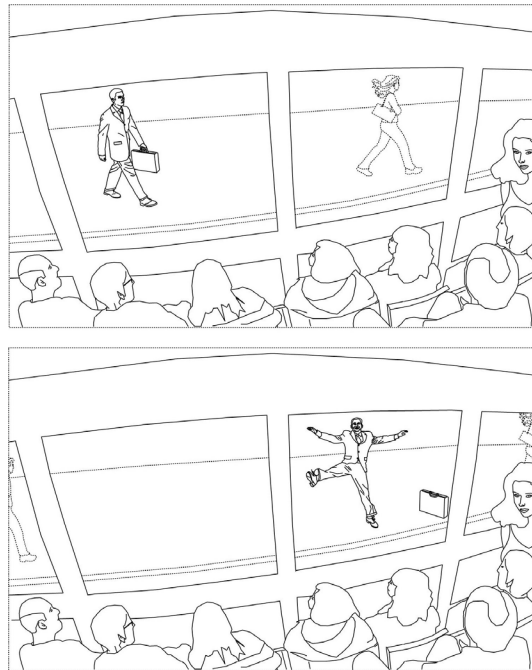
Applicant, The Ride, LLC, filed an application, amended during prosecution to seek registration of the image shown as Figure 1 below on the Principal Register as a mark for “conducting sightseeing travel tours by bus” in International Class 39.<sup>1</sup>

**Figure 1:**

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<sup>1</sup> Application Serial No. 86845550 was filed on December 10, 2015 pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming dates of first use anywhere and first use in commerce as of September 30, 2010. Color is not claimed as a feature of the mark.

Page references to the application record are to the downloadable .pdf version of the USPTO’s Trademark Status & Document Retrieval (TSDR) system. References to the briefs and orders on appeal are to the Board’s TTABVUE docket system.



During prosecution, Applicant submitted a claim in the alternative that the proposed mark has acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f).<sup>2</sup>

The Trademark Examining Attorney finally refused registration on the following grounds:

- (1) under Sections 1, 2, 3, and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052, 1053, and 1127, on the ground that the subject matter sought to be registered “fails to function as a service mark

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<sup>2</sup> In its brief, Applicant makes the following statement: “While Applicant asserts that the Mark is distinctive, Applicant argues in the alternative that the Mark has acquired secondary meaning and has submitted substantial evidence in support thereof.” 13 TTABVue 13. Applicant’s original claim of acquired distinctiveness did not include any indicia that it was intended to be submitted in the alternative. October 4, 2016 Response to Office Action at TSDR 5, 8, 17-22. However, in its subsequent communications, Applicant indicated that its claim of acquired distinctiveness was made in the alternative. July 5, 2017 Response to Office Action at TSDR 6; February 2, 2018 first Request for Reconsideration at TSDR 6. Accordingly, we so construe it.

notwithstanding applicant's claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f);<sup>3</sup>

(2) under Sections 1 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1127, on the basis that all of the specimens of record are unacceptable because they fail to show the proposed mark in use in commerce; and

(3) under Trademark Rule 2.37; 37 C.F.R. § 2.37, on the ground that "the description of the applied-for motion mark is incomplete."<sup>4</sup>

Applicant then appealed. The appeal is fully briefed.

### **I. Evidence of Record**

In support of their positions, Applicant and the Examining Attorney introduced evidence, of which the following excerpts are most probative of the issues before us.<sup>5</sup>

The Examining Attorney submitted, inter alia, multiple images from Applicant's website displaying various performers, including a rapper, break dancer, saxophonist, singer and contortionist, in addition to a tap dancing individual wearing a business suit. (Exhibit A)<sup>6</sup>

Applicant submitted two surveys conducted by Robert T. Kaiser<sup>7</sup> ("Kaiser Surveys") (Exhibit B) and Mr. Kaiser's supporting declarations<sup>8</sup> purporting to

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<sup>3</sup> Examining Attorney's brief, 15 TTABVue 3. Because Section 2(f) does not provide a basis for refusal of registration, we construe the arguments and evidence presented by Applicant and the Examining Attorney as addressing whether the applied-for matter will be perceived as a mark, based upon inherent or acquired distinctiveness.

<sup>4</sup> 15 TTABVue 3.

<sup>5</sup> Representative samples of the most probative evidence discussed but not reproduced in the body of this decision are included as exhibits in an appendix hereto.

<sup>6</sup> March 1, 2008 Office Action at 4-24; April 13, 2018 Office Action at TSDR 4-22.

<sup>7</sup> October 4, 2016 Response to Office Action at TSDR 33-60.

<sup>8</sup> October 4, 2016 Response to Office Action at TSDR 29-32.

demonstrate “the degree to which two groups of individuals associate The Ride, LLC [Applicant] with the live visual and motion elements of the trade dress...”<sup>9</sup> Applicant further introduced into the record screenshots from videos posted to social media of television news shows discussing Applicant and its services (Exhibit C) and the videos themselves. (Exhibit D)<sup>10</sup> Applicant also introduced into the record copies of five third-party registrations for non-traditional marks, all issued on the Principal Register, along with photographs of the specimens submitted therewith. (Exhibit E)<sup>11</sup> In addition, Applicant submitted screenshots from its website advertising its services. (Exhibit F)<sup>12</sup> Finally, Applicant submitted the declaration of its Chief Executive Officer, Mr. Richard Humphrey. (Exhibit G)<sup>13</sup>

## II. Discussion

### A. *Sufficiency of the Description of the Applied-for Motion Mark*

We begin with the Examining Attorney’s refusal of registration on the ground that “the description of the applied-for motion mark is incomplete,”<sup>14</sup> Trademark Rule 2.37, 37 C.F.R. §2.37, provides as follows:

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<sup>9</sup> October 4, 2016 Response to Office Action at TSDR 29-30.

<sup>10</sup> October 4, 2016 Response to Office Action at TSDR 61-64; February 2, 2018 Response to Office Action, submitted as separate attachments.

<sup>11</sup> October 4, 2016 Response to Office Action at TSDR 65-67; July 5, 2017 Response to Office Action at TSDR 18-27; February 2, 2018 Response to Office Action at TSDR 23-24. In addition, with its February 2, 2018 Response, Applicant submitted a second supporting declaration of its CEO, Mr. Richard Humphrey at TSDR 20-22.

<sup>12</sup> Applicant’s February 2, 2018 Request for Reconsideration at TSDR 26; Applicant’s March 20, 2018 Second Request for Reconsideration at TSDR 4-5.

<sup>13</sup> Applicant’s July 5, 2017 Response to Office Action at 16-17.

<sup>14</sup> 15 TTABVue 3.

A description of the mark must be included if the mark is not in standard characters. In an application where the mark is in standard characters, a description may be included and must be included if required by the trademark examining attorney.

Trademark Rule 2.52(b)(3), 37 C.F.R. § 2.52(b)(3), provides that the requirement for a description of the mark applies to motion marks. *See also* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 807.11. TMEP § 808.02 provides the following additional guidance (citations omitted):

If a description of a mark is placed in the record, the description should state clearly and accurately what the mark comprises, and should not create a misleading impression by either positive statement or omission. Statements regarding how a mark is used (e.g., that the mark is not used in a particular color) are not appropriate and, if submitted, must not be printed on the registration certificate.

The description should describe all *significant* aspects of the mark, including both literal elements and design elements. Insignificant features need not be included in a description.

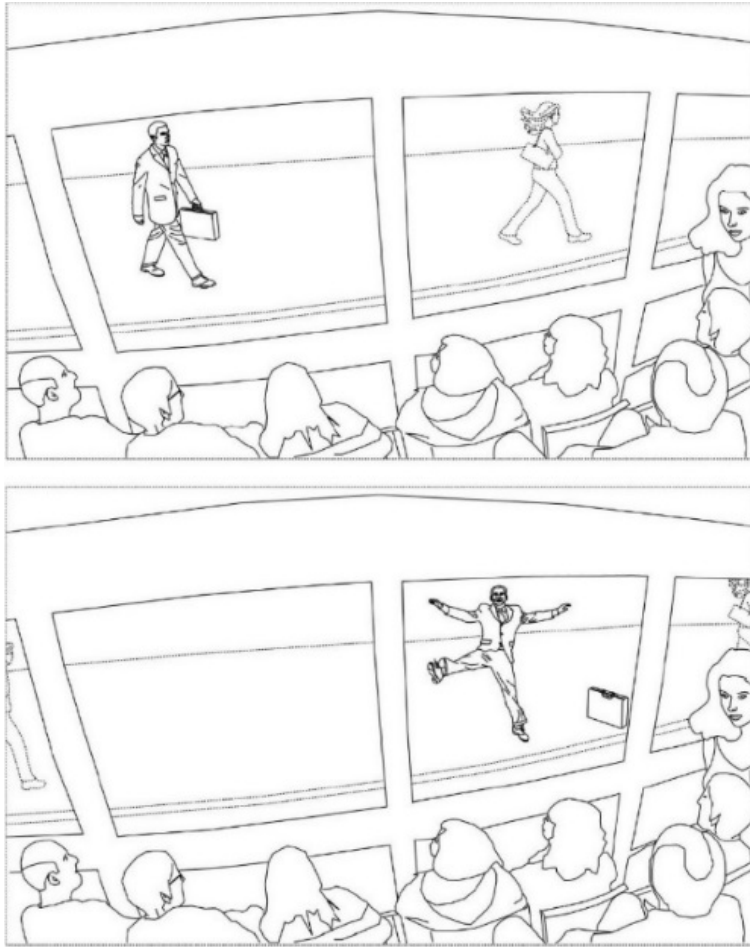
With regard to trade dress marks, TMEP § 1202.02(c)(ii) provides the following guidance (citations omitted):

The description must clearly indicate that the mark is “three-dimensional” and constitutes “product design” or “configuration” of the goods themselves or product “packaging” or a “container” in which the goods are sold, or that the trade dress is for services offered (e.g., interior of a restaurant, exterior of a retail establishment, or point-of-sale-display such as a costume used in connection with the services).

...

In cases where the drawing depicts a two-dimensional mark that could be interpreted as three-dimensional in nature, an applicant may clarify that the mark is two-dimensional in the mark description.

Applicant describes its proposed mark:



in the involved application as

follows:

The mark consists of the live visual and motion elements of the trade dress of a guided bus tour in which as the bus approaches at least one predetermined location on the tour an entertainer who is dressed as a banker walks normally along the street and then performs a tap dance routine dancing act when the bus stops at the predetermined location as viewed from inside of the bus. The drawing shows two sequential freeze-frames of the mark, in which the top frame shows an entertainer dressed as a banker walking along the street on the side of the bus and in which the bottom frame shows the entertainer performing a tap dance routine at the predetermined location. Dotted lines in the drawing show placement of the mark and are not part of the mark.

The drawing of the proposed mark appears to depict, in the first panel, an individual walking along a street or sidewalk while wearing a suit and carrying a

briefcase who, in the second panel, is engaged in what Applicant describes as a tap dancing routine. In both panels, the individual is being viewed by an audience through bus windows that face the street. However, Applicant's description of the mark does not describe the bus windows. In that regard, it is not clear from the description what elements displayed in the drawing are claimed as Applicant's proposed mark beyond the image of the suited individual and his briefcase. The individual further is described as being "dressed as a banker." We recognize Applicant's intention to depict an individual wearing a business suit and carrying a briefcase as a "banker." Nonetheless, the description of the mark must reflect what is displayed in Applicant's drawing, namely, an individual with a briefcase wearing a suit. We find, therefore, that the description fails to completely and accurately describe the proposed mark, as required by TMEP §§ 807.11 and 808.02.

In addition, Applicant describes its proposed mark as "the live visual and motion elements of the trade dress of a guided bus tour." Applicant's description fails to indicate that the trade dress is three-dimensional or whether, in the alternative, the trade dress is a two dimensional mark that could be interpreted as three-dimensional. We find, as a result, that the description fails to comply with the requirements of TMEP § 1202.02(c)(ii) for a proposed mark consisting of trade dress.

### ***B. Sufficiency of Applicant's Specimens***

We turn to the Examining Attorney's refusal of registration on the basis that the specimens of record are unacceptable because they fail to show the mark in the drawing in use in commerce in connection with the identified services.

Specifically, the video specimen displays the proposed motion mark as a man in a suit seen through portions of bus windows shown in a wide variety of stationary and dancing poses; however, the drawing displays the applied-for motion mark as depicting a man in a suit seen through two full bus windows -- which appear in solid lines and thus constitute claimed matter in the drawing -- with his arms at his sides in the first frame and with his arms and one leg extended in the second frame.<sup>15</sup>

The Trademark Act “provides for registration of a mark based on use of the mark in commerce.” *In re Siny*, 920 F.3d 1331, 2019 USPQ2d 11362, \*2 (Fed. Cir. 2019).<sup>16</sup>

A service mark is “any word, name, symbol, or device, or any combination thereof ... [used] to identify and distinguish the services of one person ... from the services of others and to indicate the source of the services, even if that source is unknown.”

15 U.S.C. § 1127. The USPTO “requires an applicant to submit a specimen of use ‘showing the mark as used on or in connection with the goods [or services].’” *In re Siny Corp.*, 2019 USPQ2d 11362, \*2 (quoting *In re Sones*, 590 F.3d 1282, 93 USPQ2d 1118, 1120 (Fed. Cir. 2009)). The specimen of use, which is required by Section 1 of the Lanham Act and Trademark Rule 2.56, 37 C.F.R. § 2.56, must display the applied-for mark and show an association between the mark and the services. As the TMEP states:

To be acceptable, a service-mark specimen must show the mark sought to be registered used in a manner that demonstrates a direct association between the mark and the services. Essentially, the mark must be shown in a manner that would be

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<sup>15</sup> Examining Attorney’s brief, 15 TTABVue 17.

<sup>16</sup> The Federal Circuit originally issued this opinion as nonprecedential on January 14, 2019, but subsequently granted the USPTO’s motion to reissue it as a precedential opinion. The precedential opinion was reissued on April 10, 2019.



perceived by potential purchasers as identifying the applicant's services and indicating their source.

TMEP § 1301.04(f) (October 2018) (citations and internal quotation marks omitted). *See also In re Universal Oil Prods. Co.*, 476 F.2d 653, 177 USPQ 456, 457 (CCPA 1973) (“The minimum requirement is some direct association between the offer of services and the mark sought to be registered therefor.”). We have stated that a service mark must be “used in such a manner that it would be readily perceived as identifying” the services, which is “determined by examining the specimens of record in the application.” *In re Keep A Breast Foundation*, 123 USPQ2d 1869, 1876 (TTAB 2017), (quoting *In re Moody's Investors Svc. Inc.*, 13 USPQ2d 2043, 2047 (TTAB 1989)); *accord In re Osmotica Holdings Corp.*, 95 USPQ2d 1666, 1668 (TTAB 2010) (“At a minimum, the specimen must show a direct association between the services and the mark sought to be registered.”). “A specimen that shows only the mark with no reference to, or association with, the services does not show service mark usage.” *In re DSM Pharm., Inc.*, 87 USPQ2d 1623, 1624 (TTAB 2008).

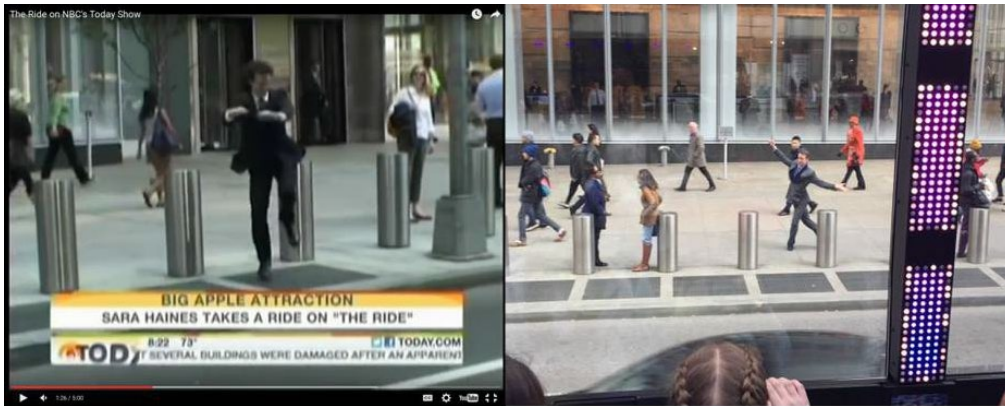
Applicant initially submitted four specimens with the application. These are reproduced below as Figure 2:<sup>17</sup>

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<sup>17</sup> In the original application, Applicant describes the specimens as follows: “Four specimens are provided, in which: the first specimen includes a photograph of an entertainer dressed as an ordinary person on street performing a song, as seen from outside of the bus; the second specimen includes two photographs of an entertainer dressed as a parcel delivery person initially walking with a package and then performing a break dance routine, as seen from inside the bus; the third specimen includes two photographs of an entertainer dressed as banker performing tap dance routine on a street, as seen from inside the bus; the fourth specimen is a photograph showing a tour guide talking to customers inside the bus.”

Figure 2:





None of the four screenshots or photographs submitted as specimens displays the proposed mark as it appears in the drawing. The third specimen displays two images of a tap dancing individual wearing a suit, but neither matches the drawing. The remaining three specimens do not display the proposed mark at all. As a result, the screenshots and photographs comprising the original four specimens of record all are unacceptable because they fail to show the proposed mark in use in commerce with Applicant's services. Furthermore, because the specimens do not even display the applied for mark, they cannot show the required association with Applicant's services.

As a substitute specimen, Applicant first submitted a .wmv video file purportedly showing the subject matter sought to be registered.<sup>18</sup> However, this first substitute specimen fails to show the proposed mark in a manner such that consumers would perceive it as an indicator of source for the identified services. First, we note that this specimen does not display either of the freeze frames comprising the drawing, as required by Trademark Rule 2.51, 37 C.F.R. § 2.51(a) (“the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods and/or services”). “[A]n acceptable specimen should show the entire repetitive motion in order to depict the commercial impression conveyed by the mark.” TMEP § 904.03(l). Applicant’s first substitute specimen displays a tap dancing routine viewed from the interior of a vehicle but does not display the commercial impression of a repetitive motion sought to be conveyed by Applicant’s drawing. Further, the audio commentary accompanying the video suggests that the tap dancing routine may change depending on the performance, e.g., the number of “leapfrog” movements varies depending on the performance. The specimen thus suggests a lack of uniformity in its attempt to display the proposed mark. Because the specimen fails to depict “a substantially exact representation of the mark,” *see* Trademark Rule 2.51, or, for that matter, any display of the images in the drawing,

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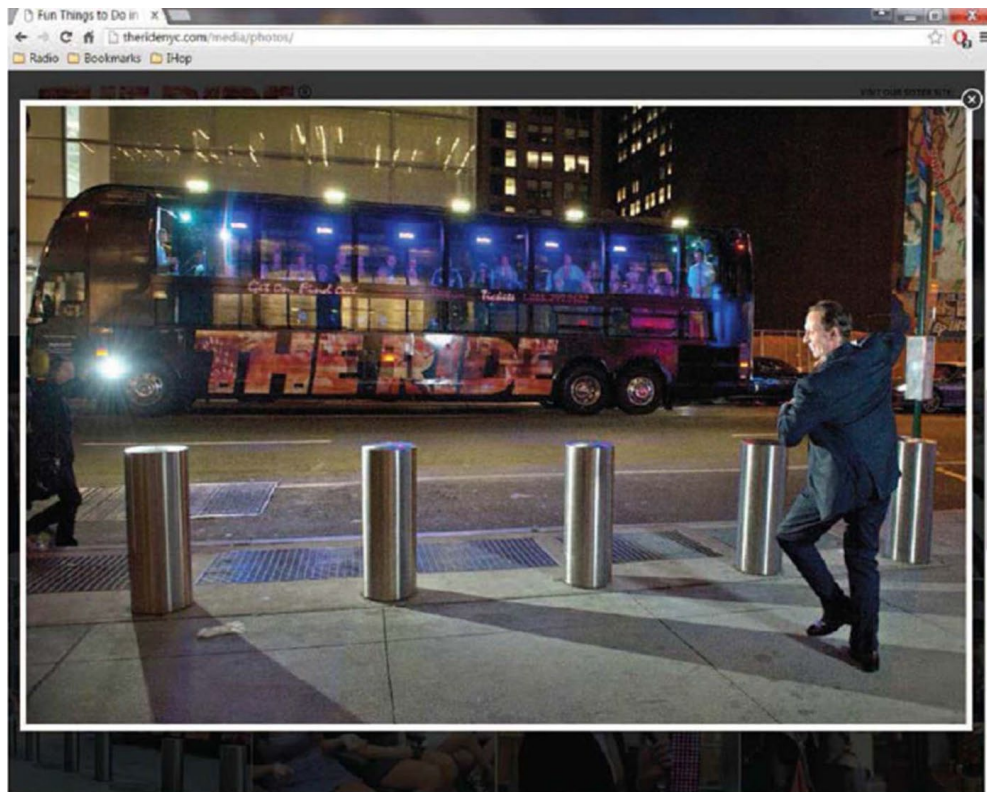
<sup>18</sup> The video file may be viewed in the prosecution history as a separate attachment in TSDR to Applicant’s October 4, 2016 Response to Office Action. Applicant describes the substitute specimen as a “.wmv video file showing the mark.”



it fails to associate the proposed mark depicted in the application with Applicant as a source of any of the recited services.

Applicant submitted a second substitute specimen, reproduced as Figure 3 below, with its February 2, 2018 Response to Office Action:<sup>19</sup>

**Figure 3:**



Photograph in interior of web site

The still photograph from Applicant's website comprising the second substitute specimen displays a man in a suit, apparently performing a dance routine, with a bus

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<sup>19</sup> Submitted on February 2, 2018 as a separate attachment in TSDR. Applicant describes the substitute specimen as a "Digital photograph showing live motion elements of the Mark."

displaying Applicant's trade name "The Ride" in the background. As with the original and first substitute specimens, this still image fails to display the proposed mark.

Applicant argues that the USPTO has accepted similar specimens of use in registrations displayed as Exhibit E to the Appendix. However, the file histories of these registrations are not in the record and we are not privy to the circumstances resulting in the approval of the underlying applications for registration. Further, we are not bound by the prior decisions of examining attorneys in cases involving unrelated marks. The Board must make its own findings of fact, and need not adopt the conclusions reached by an examining attorney in an unrelated case. *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("Even if some prior registrations had some characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind the Board or this court."); *In re Sunmarks, Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994); *In re BankAmerica Corp.*, 231 USPQ 873, 876 (TTAB 1986). "It has been said many times that each case must be decided on its own facts." *In re Eagle Crest Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010) (internal citation omitted).

In sum, we conclude that neither the original nor the substitute specimens displays the proposed motion mark depicted in the drawing.<sup>20</sup> As a result, none of

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<sup>20</sup> We found above that Applicant's description fails to completely and accurately describe its proposed motion mark or trade dress. With regard to Applicant's specimens of use, TMEP § 904.03(l) provides:

To show that a motion mark actually identifies and distinguishes the goods/services and indicates their source, an applicant must submit a specimen that depicts the motion sufficiently to show how the mark is used on or in

Applicant's proffered specimens are sufficient to support use of the proposed mark to identify the source of Applicant's services.

***C. Failure to Function as a Service Mark Under Sections 1, 2, 3, & 45***

We next turn to the substantive refusal, under Sections 1, 2, 3, and 45 of the Lanham Act, 15 U.S.C. §§ 1051, 1052, 1053 and 1127, that the applied-for mark does not serve to “identify and distinguish the services of one person . . . and to indicate the source of the services.”<sup>21</sup> 15 U.S.C. § 1127 (definition of “service mark”). “[A] proposed trademark is registrable only if it functions as an identifier of the source of the applicant's goods or services.” *In re DePorter*, 129 USPQ2d 1298, 1299 (TTAB 2019) (citing 15 U.S.C. §§ 1051, 1052, and 1127). “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 [or other designations] have been so used they cannot qualify.” *Id.* (quoting *In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1976)); *see also In re Yarnell Ice Cream, LLC*, 2019

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connection with the goods/services, and that matches the required description of the mark. Although the drawing for a motion mark may depict a single point in the movement, or up to five freeze frames showing various points in the movement, an acceptable specimen should show the entire repetitive motion in order to depict the commercial impression conveyed by the mark (e.g., a video clip, a series of still photos, or a series of screen shots).

In addition to failing to display its proposed mark, Applicant's original and substitute specimens also fail to match the description thereof.

<sup>21</sup> As discussed above, Applicant describes its proposed mark as “the live visual and motion elements of the trade dress of a guided bus tour...” We observe that Applicant's characterization of the applied-for matter as trade dress is inaccurate and, even if the proposed mark were considered to be trade dress, it would not change the outcome herein for the various reasons explained in this decision.

USPQ2d 265039 [\*16] (TTAB 2019); *In re Int'l Spike, Inc.*, 196 USPQ 447, 449 (TTAB 1977) (law pronounced in the *Bose* case is just as applicable to pictures and illustrations as it is to words: Trademark Act is for the registration, not the creation, of trademarks); *In re Ratcliff Hoist Co., Inc.*, 157 USPQ 118, 119 (TTAB 1968) (mere representation of an article of applicant's merchandise fails to function as a trademark for its goods). There are many reasons a proposed mark may fail to function as one. *See generally* TMEP § 1202.

Sections 1, 2, 3, and 45 of the Trademark Act provide the statutory basis for refusal to register subject matter that fails to function as a service mark. 15 U.S.C. §§ 1051, 1052, 1053, and 1127. Specifically, Sections 1, 2, and 3 provide, inter alia, for the application and registration on the Principal Register of trademarks “by which the goods [or services] of the applicant may be distinguished from the goods [or services] of others” and Section 45 defines a “service mark,” in pertinent part, as “any word, name, symbol, or device, or any combination thereof used by a person ... to identify and distinguish the services of one person ... from the services of others and to indicate the source of the services, even if that source is unknown.” Accordingly, the Office is statutorily constrained to register matter on the Principal Register if and only if it functions as a mark.

“[N]ot every designation adopted with the intention that it performs a trademark function and even labeled as a trademark necessarily accomplishes that purpose....” *Am. Velcro, Inc. v. Charles Mayer Studios, Inc.*, 177 USPQ 149, 154 (TTAB 1973); *see also Roux Labs., Inc. v. Clairol, Inc.*, 427 F.2d 823, 166 USPQ 34, 39 (CCPA 1970).



The critical inquiry in determining whether a designation functions as a mark is how the designation would be perceived by the relevant public. To make this determination we look to the specimens and other evidence of record showing how the designation is actually used in the marketplace.

*In re Eagle Crest Inc.*, 96 USPQ2d at 1229.

Thus, the central question in determining whether Applicant's proposed mark functions as a service mark is the commercial impression it makes on the relevant public (e.g., whether the term sought to be registered would be perceived as a mark identifying the source of the services). *In re Aerospace Optico, Inc.*, 78 USPQ2d 1861, 1862 (TTAB 2006) ("the mark must be used in such a manner that it would be readily perceived as identifying the specified goods [or services]. ... The mere fact that a designation appears on the specimen of record does not make it a trademark. ... A critical element in determining whether matter sought to be registered as a trademark is the impression the matter makes on the relevant public."<sup>22</sup> (citations omitted)). *See also In re Volvo Cars of N. Am. Inc.*, 46 USPQ2d 1455, 1459 (TTAB 1998); *In re Remington Prods. Inc.*, 3 USPQ2d 1714, 1715 (TTAB 1987); *In re Morganroth*, 208 USPQ 284, 287 (TTAB 1980).

In support of its position that the proposed mark is perceived as a source identifier, Applicant submitted two surveys with supporting declarations conducted by Mr.

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<sup>22</sup> In this case, Applicant's proposed mark does not appear on its specimens of record, further calling into question the extent to which the applied-for matter would be perceived as a source indicator.

Robert T. Kaiser (Kaiser surveys).<sup>23</sup> To the extent we may consider a properly-conducted survey as evidence of consumer perception, we note that Mr. Kaiser does not appear to have conducted any sort of “mini-course” that would include a test of the understanding of the survey participants as to whether something functions as a mark. Given the non-traditional nature of Applicant’s proposed motion mark, a survey intended to test consumer perception may warrant a unique survey methodology, but the methodology would have been aided by a mini-course. For example, while the issue of genericness is not before us, we observe Mr. Kaiser’s surveys are not analogous to “Teflon surveys,” described by Professor McCarthy as “essentially a mini-course in the generic versus trademark distinction, followed by a test.”<sup>24</sup> In a case involving a genericness determination, the Board “noted that we can give ‘little weight’ to a survey where a mini-test was not performed and we do not know whether survey participants actually understood what they were being asked.” *Frito-Lay N. Am., Inc. v. Princeton Vanguard, LLC*, 124 USPQ2d 1184, 1198-99 (TTAB 2017), (quoting *Sheetz of Del., Inc. v. Doctor’s Assocs. Inc.*, 108 USPQ2d 1341, 1361-62 (TTAB 2013)), (citing *Jacob Zimmerman v. Nat’l Ass’n of Realtors*, 70 USPQ2d 1425, 1436-36 n. 15 (TTAB 2004)) (flaws in the design and administration

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<sup>23</sup> October 4, 2016 Response to Office Action at TSDR 29-60. (Relevant portions reproduced in Exhibit B to Appendix). Mr. Kaiser identifies himself as “the President of StrateSci Inc., a seven-member marketing research and analysis firm” and “an expert in the design, execution and analysis of surveys that quantitatively measure how those making purchasing decisions perceive the trademarks owned by my clients.” *Id.* at TSDR 29.

<sup>24</sup> J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION 12:16 (5th ed.).

of the survey, including the mini-test, resulted in the survey having limited probative value). In this case, Mr. Kaiser did not conduct any sort of mini-test or other evaluation of the participants' ability to recognize an indicator of source, and we cannot determine whether the survey respondents understand or can identify a mark. As a result of this apparent flaw in Mr. Kaiser's methodology, we discount the value of his surveys based upon the lack of proper foundation for their introduction. We nonetheless consider his methodology and results for whatever probative value they may have.

Mr. Kaiser surveyed the following groups:

- Consumers who had experienced The Ride any time from 2013 to 2016, pulled from The Ride ticket system.
- Travel professionals (travel agents, tour operators, group sales agents, and hotel concierges) who book tourism packages in New York City.<sup>25</sup>

With regard to recognition of tour bus companies, Mr. Kaiser asked the following:<sup>26</sup>

## Recognition of Tour Bus Companies

### Questions Asked

- Which Tour Bus Company do you associate with this drawing?
  - The Ride
  - Gray Line
  - CitySights
  - Big Bus

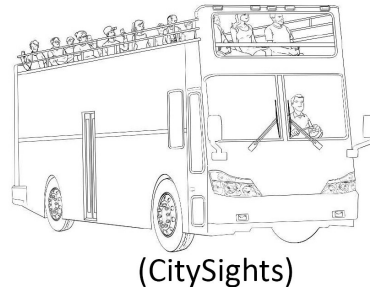
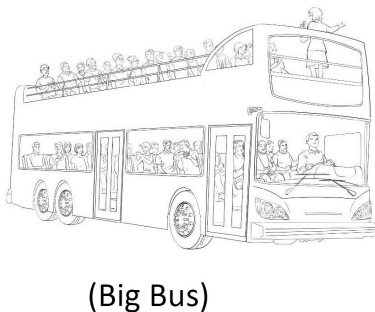
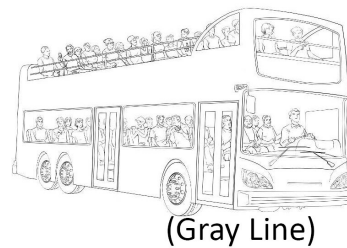
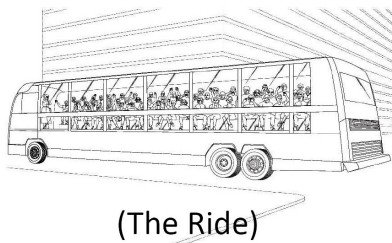
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<sup>25</sup> October 4, 2016 Response to Office Action at TSDR 37.

<sup>26</sup> *Id.* at TSDR 39-42.

- Circle Line
- Other (specify) \_\_\_\_\_
- Don't know

### Tested Drawings



Note: The labels are shown here only for reference, the respondents did not see labels with the images.  
May 2016 The Ride Tour Bus Study

From the results of this query, Mr. Kaiser concluded that 96% of consumers “identified The Ride from its drawing, and do not think any other images are The Ride.”<sup>27</sup> Mr. Kaiser further concluded that 74% of “Travel professionals strongly recognized The RIDE.”<sup>28</sup>

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<sup>27</sup> *Id.* at TSDR 42.

<sup>28</sup> *Id.* at TSDR 43.

With regard to association with street performances, Mr. Kaiser asked the following of consumers who had previously experienced The Ride and travel professionals:<sup>29</sup>

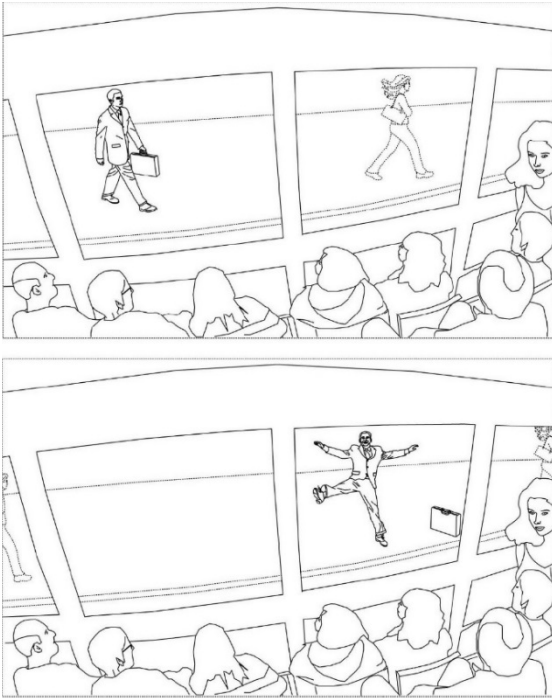
Question Asked

- Tour Buses may include random street performances by actors placed on the street. Which Tour Bus Company do you associate with seeing random street performances such as depicted in these drawings?
- The Ride
- Gray Line
- CitySights
- Big Bus
- Circle Line
- Other (specify)\_\_\_\_\_
- Don't know

The order of the answer choices were randomly rotated to control for order bias.

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<sup>29</sup> *Id.* at TSDR 44-46.



From the results of this query, Mr. Kaiser concluded that 98% of consumers or “Essentially all of the Consumers associated the depiction of the Street Performance with The Ride.”<sup>30</sup> Mr. Kaiser further concluded that 73% of “Travel professionals strongly recognized The Ride with street performances as depicted in the drawing. One in five could not make any association.”<sup>31</sup>

In addition, 95% of consumers and 68% of travel professionals also associated a parody of a tour bus on the television show *The Simpsons* with The Ride,<sup>32</sup> and one in seven consumers indicated that they chose The Ride based upon seeing the bus in the street.<sup>33</sup>

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<sup>30</sup> *Id.* at TSDR 42.

<sup>31</sup> *Id.* at TSDR 48.

<sup>32</sup> *Id.* at TSDR 49-53.

<sup>33</sup> *Id.* at TSDR 54-56.

The Kaiser surveys purport to establish three main points, according to Applicant: First, a very high percentage of consumers, all of whom previously utilized Applicant's services, as well as a high percentage of travel professionals who book tourism packages in New York City, associated The Ride with a photograph of its tour bus; second, a very high percentage of the same consumers and a high percentage of travel professionals associated random street performances by actors with The Ride, assertedly prompted by the drawing of Applicant's proposed mark; third, a very high percentage of consumers and a greater than average percentage of travel professionals associated a spoof on The Simpsons with The Ride.

Based upon the results of these surveys, Mr. Kaiser concludes:<sup>34</sup>

18. Therefore, in my expert opinion, the Mark has secondary meaning as designating The Ride as a single source of tour bus services both in the minds of ordinary purchasers of tour bus services and travel professionals who are in the business of booking tour bus packages.

19. Based on my extensive experience in conducting and analyzing these types of surveys, I conclude, in my expert opinion, that the Mark, as shown in the drawing presented above, is both distinctive and has secondary meaning as designating The Ride as a source of tour bus services in the minds of both ordinary purchasers of tour bus services and travel professionals.

There are several problems with Mr. Kaiser's interpretation of the results of his surveys. First, the universe of respondents is biased and underinclusive, as it specifically includes consumers who have already utilized Applicant's services, rather than the relevant consumers who may have in the recent past engaged or will engage

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<sup>34</sup> *Id.* at TSDR 32.

the services of **any** tour bus company. Furthermore, the questions are phrased in a biased and leading manner, and do not include the option for a consumer to indicate a perceived association with “none” of the listed companies in particular, inasmuch as there may be an association, if any, with more than one. In addition, the questions ask about perceived association with a drawing and with a concept of “random street performances by actors.” The question fails to capture the actual and exact motion mark or trade dress that Applicant seeks to register.

A further problem with Mr. Kaiser’s interpretation of the results of his surveys is that there is no indication in any of the queries or responses that consumers or travel professionals recognize the proposed mark **as an indicator of source** for Applicant’s services, identified as “conducting sightseeing travel tours by bus.” The results establish a high degree of association among both surveyed groups between Applicant’s tour bus, random street performers, and a Simpsons parody with Applicant’s trade name, The Ride. The results further establish a high degree of association between Applicant and the unique shape and design of its bus. These associations are irrelevant to the question of whether the surveyed group associates Applicant with the proposed mark it seeks to register. Mr. Kaiser’s surveys queried “Which Tour Bus Company do you associate with seeing random street performances such as depicted in these drawings [of the applied-for mark]?<sup>35</sup> Neither this question, nor any of the other questions offered in the surveys, queried whether the consumers

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<sup>35</sup> *Id.* at 45.



or travel professionals associated the proposed mark with Applicant as a source of origin of the identified services. Similarly, there was no option to associate the proposed mark as an answer to any of the survey questions.

Measuring mere association of something with a particular source is insufficient. To show that that “something” serves as a source-indicator, the questions and responses must demonstrate that the “primary significance” of the stimulus is as a brand identifier, not just a type of service or a feature of a service.<sup>36</sup> See, e.g., *Sturgis Motorcycle Rally, Inc. v. Rushmore Photo & Gifts, Inc.*, 908 F.3d 313, 330, 335, 128 USPQ2d 1575, 1590, 1593-94 (8th Cir. 2018); *Vornado Air Circulation Sys., Inc. v. Duracraft Corp.*, 58 F.3d 1498, 35 USPQ2d 1332, 1334 n.7 (10th Cir. 1995).

The drawing of the proposed mark is used in the surveys to query whether survey participants associate tour buses featuring random street performances by actors with Applicant’s trade name, The Ride. Nowhere in the surveys are the participants asked whether they associate the use of street performances as a mark for Applicant’s services. Because Mr. Kaiser did not perform a mini-test to determine whether survey participants understand or can identify a trademark, we cannot determine whether

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<sup>36</sup> We observe that the applied-for motion mark may not be the type of designation intended to be registered by the Lanham Act in that it appears to be a pictorial representation of an aspect of Applicant’s recited services, namely, guided bus tours rendered with various performers on sidewalks and other locations. Just as the name of a process is not registrable as a service mark, see *In re Universal Oil Prods. Co.*, 476 F.2d 653, 177 USPQ 456 (CCPA 1973), the pictorial representation of that process or method itself should likewise not be registrable. See *In re Singer Mfg. Co.*, 255 F.2d 939, 118 USPQ 310, 311-12 (CCPA 1958) (“It is, of course, true that a design consisting merely or essentially of a pictorial representation of the goods on which it is used is descriptive, and is not a valid trademark.”) (citation omitted).

participants even perceived the intended nature or purpose of the applied-for motion mark.

Similarly, participants were not given the opportunity to respond in such a manner that associates the proposed mark with the services. Simply put, even if we accept Mr. Kaiser's methodology, his surveys suggest a strong to very strong association of Applicant's trade name The Ride with the questions put to the participants, but are not probative of the association of the applied-for mark with Applicant as the source of origin of Applicant's services. We therefore find no basis for Mr. Kaiser's conclusion that his surveys support a finding that the proposed mark is inherently distinctive or has acquired secondary meaning. *Cf. Frito-Lay*, 124 USPQ2d at 1195-1201 (survey results entitled to only limited probative weight due, inter alia, to flaws in methodology).

In his declaration, Applicant's Chief Executive Officer, Mr. Richard Humphrey, discusses Applicant's exclusive use of the applied-for designation since 2010, its efforts to associate the proposed mark with Applicant as a source of its services, the unique nature of the tap dancing performance among tour bus services, and the extent of exposure of consumers and potential consumers to its applied-for mark.<sup>37</sup>

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<sup>37</sup> Applicant submitted this declaration in support of its claim of acquired distinctiveness. Nonetheless, we consider this evidence in support of Applicant's position that the applied-for designation is registrable as an indicator of source. *Cf. In re The Hallicrafters Co.*, 153 USPQ 376 (TTAB 1967) (reversing refusal to register QUALITY THROUGH CRAFTSMANSHIP for radio equipment, finding that the wording functioned as a mark as a result of applicant's extensive advertisement of the slogan, use of the slogan in the manner of a trademark on the goods).

However, as discussed above evidence shows that Applicant displays various images of a tap dancer among other performers along with other potential identifiers, principally, The Ride and TheRideNYC.com. We cannot infer from Applicant's advertising and other efforts that consumers will perceive the proposed mark, amid these other more traditional designations, as a source indicator. *See, e.g., In re Bongrain Int'l (Am.) Corp.*, 894 F.2d 1316, 3 USPQ2d 1727, 1729 (Fed. Cir. 1990) (sales and advertising figures alone may not suffice where other marks were featured with the mark at issue or the growth could be attributed to the product's popularity).

Based on our above review of the specimens of use submitted by Applicant as well as all other evidence of record, we agree with the Examining Attorney that Applicant's proposed mark fails to function as a service mark. As discussed above, the original specimen, and the first and second substitute specimens, all fail to display the proposed mark or associate the proposed mark with the recited services, thus making it unlikely that the relevant consumers will perceive the proposed mark as indicating source. If anything, the applied-for mark appears to be part of one of several street performances offered during sightseeing bus tours under Applicant's trade name, "The Ride." The Kaiser surveys similarly suggest that consumers of Applicant's services and travel professionals associate Applicant's services with "The Ride," and fail to provide support for Applicant's argument that the proposed mark functions as an indicator of source. Rather, the Kaiser surveys and other evidence appear to establish that consumers view THE RIDE as Applicant's mark.

As further stated on Applicant's website, "The Ride is hosted by two professional comedians/actors. You will see 5-7 surprise acts on the city streets!"<sup>38</sup> These acts include a hip-hop dancer, a belter, a tap dancer, a saxophonist, a rapper, a ballet dancer, and an individual celebrating New Year's Eve.<sup>39</sup> It is not clear whether the tap dancer is always featured among the "5-7 surprise acts" during the bus tour. This evidence suggests the tap dancing routine that is the subject of Applicant's proposed mark is simply one of several performances that may be viewed during Applicant's bus tours and thus serves as a feature or aspect – as opposed to indicating the source – of Applicant's services. Additional screenshots from Applicant's website merely display an individual performing a tap dance viewed by people inside a bus.<sup>40</sup> Nothing in these images suggests the viewers of the tap dance perceive it as an indicator of source for the bus tour services. Similarly, still images and video clips from NBC's Today Show, My Fox 5, and Japanese and Spanish language television shows display different men performing tap dancing routines as part of Applicant's services under its trade name "The Ride."<sup>41</sup> In that regard, the Today Show segment is entitled "Sara Haines Takes a Ride on 'The Ride.'"<sup>42</sup> Nothing in these clips supports Applicant's contention that consumers view a particular tap dancing routine either as displayed

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<sup>38</sup> Applicant's February 2, 2018 Request for Reconsideration at TSDR 26. (Exhibit F to Appendix)

<sup>39</sup> *Id.*

<sup>40</sup> Applicant's March 20, 2018 Second Request for Reconsideration at TSDR 4-5.

<sup>41</sup> October 4, 2016 Response to Office Action at TSDR 61-64.

<sup>42</sup> *Id.* at TSDR 61.

in the proposed mark or in any of the images thereof in the record as an indicator of the source of Applicant's services. The proposed mark is not Applicant's main identifier of the source of its services (THE RIDE is), and it represents a tap dancing routine that varies<sup>43</sup> rather than a repetitive motion mark that is always the same, and consumers would not be pre-disposed to view the tap dance as a mark.

Upon consideration of the entire record, the applied-for matter as it is being used displays two still images from a tap dancing performance that may occur along with several other performances during the course of Applicant's sightseeing bus tours. As such, the evidence shows that the tap dance will be perceived as part of the services rather than as a mark designating the source of the services.

***D. Acquired Distinctiveness Under Section 2(f)***

As discussed above, the applied-for matter fails to function as a mark. As a consequence, no amount of evidence of acquired distinctiveness can overcome a failure to function refusal. "It is the source-distinguishing ability of a mark — not its ontological status as color, shape, fragrance, word, or sign — that permits it to serve" as a trademark. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1163 (1995). *See also* TMEP § 1212.02(i) ("[W]here the examining attorney has determined that matter sought to be registered is not registrable because it is not a

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<sup>43</sup> We note once more that the various images and video clips of tap dancing routines pictured in Applicant's specimens and evidence differ from one another. This apparent lack of uniformity further undercuts Applicant's ability to transform the various images of a performer tap dancing while dressed in a suit into reliable evidence that such individualized performances and performers serve as an indicator of source.

mark within the meaning of the Trademark Act, a claim that the matter has acquired distinctiveness under §2(f) as applied to the applicant's goods or services does not overcome the refusal."). In view thereof, Applicant's claim of acquired distinctiveness will be given no consideration.

**III. Decision:**

(1) the refusal to register pursuant to Sections 1, 2, 3 and 45 of the Trademark Act on the ground that the applied-for designation fails to function as a service mark is affirmed;

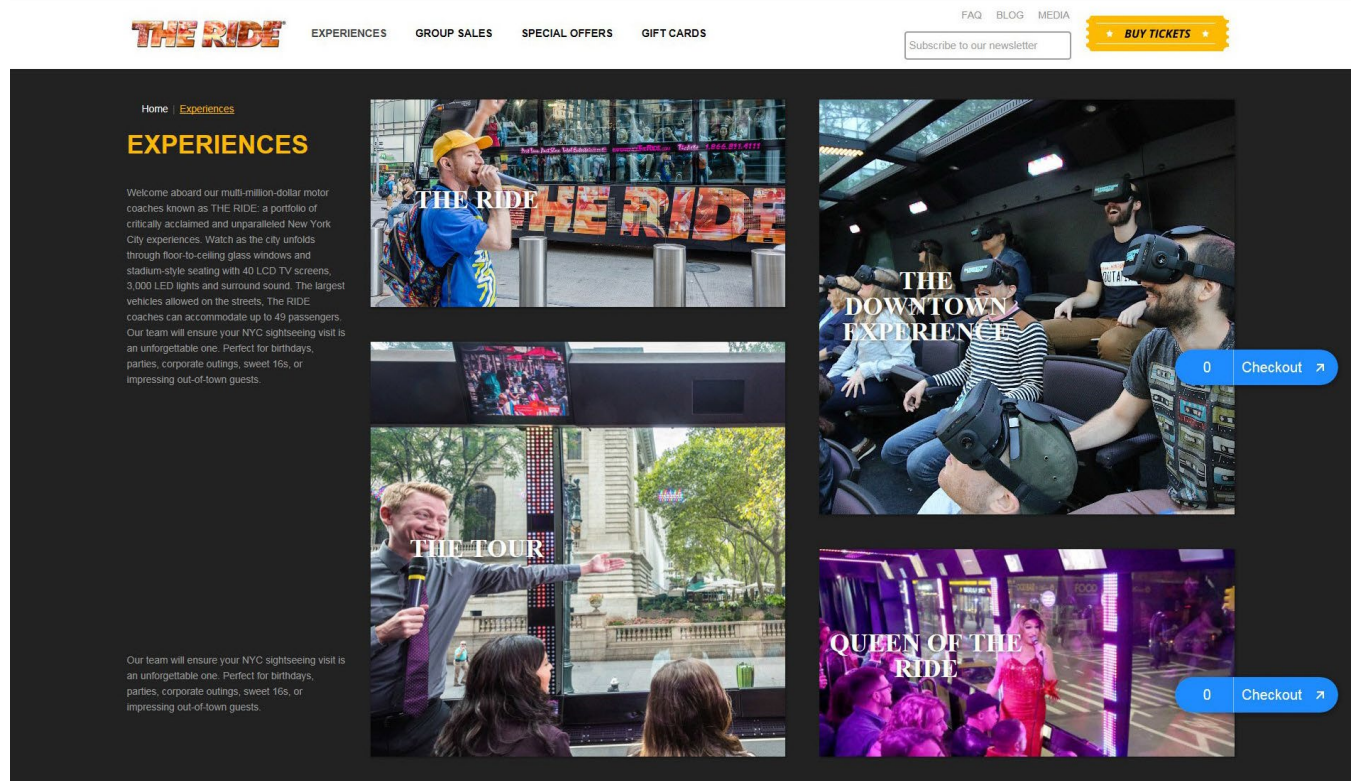
(2) the refusal to register the applied-for matter pursuant to Sections 1 and 45 of the Trademark Act, and related rules, on the ground that the original specimens, as well as the first and second substitute specimens, do not display the applied-for mark in connection with the services specified in the application, is affirmed; and

(3) the refusal to register under Trademark Rule 2.37 on the ground that the description of the applied-for motion mark is incomplete is affirmed.

## Evidentiary Appendix

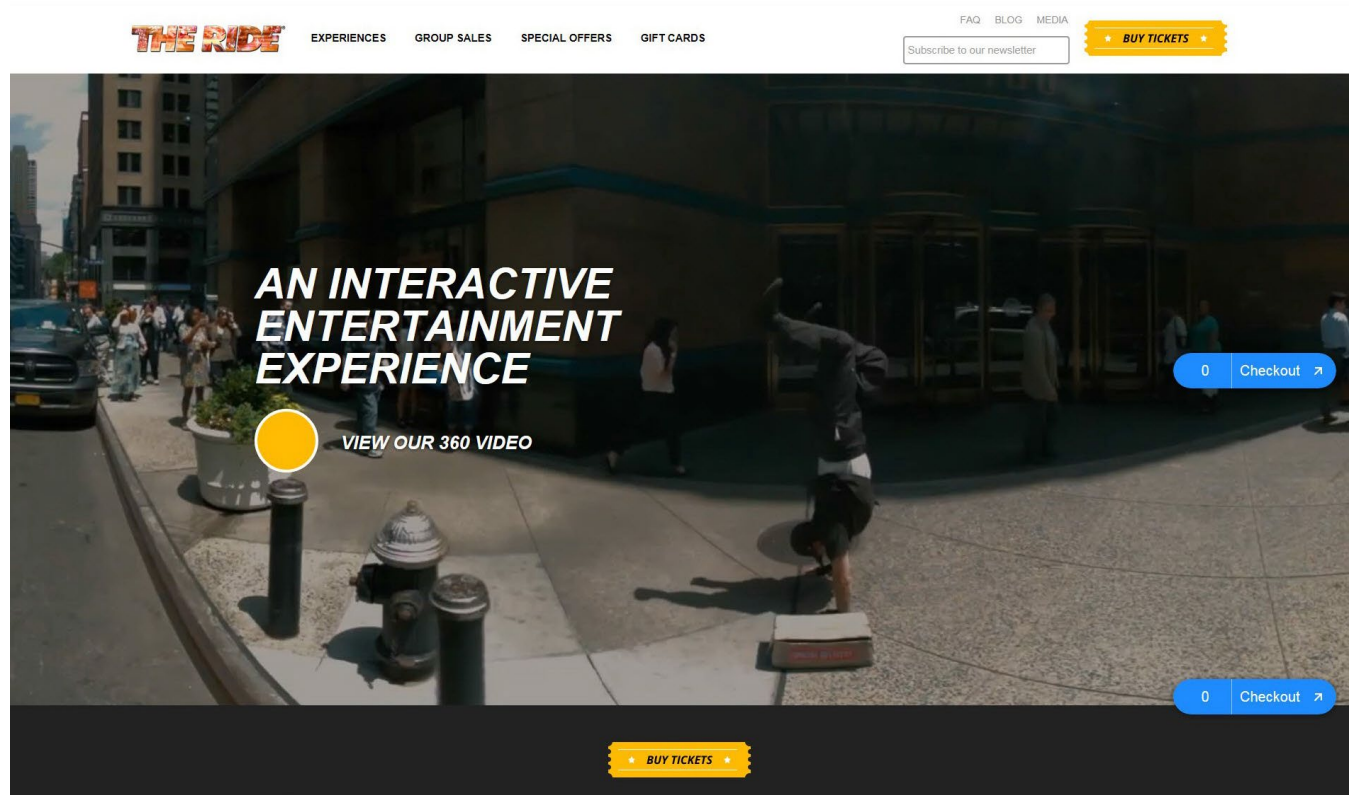
### Exhibit A – Screenshot Images from Applicant’s Website<sup>44</sup>

<https://experiencetheride.com/sightseeing-attractions/> 03/01/2018 02:34:58 PM



<sup>44</sup> March 1, 2008 Office Action at 4-24; April 13, 2018 Office Action at 4-22.

<https://experiencetheride.com/sightseeing-attractions/the-ridenyc/> 04/12/2018 06:39:09 PM



## Exhibit B – Kaiser Surveys<sup>45</sup>

### Methodology

- Surveys were taken online through email invitations to two groups:
  - Consumers who had experienced The Ride any time from 2013 to 2016 pulled from The Ride ticket system.
  - Travel professionals (travel agents, tour operators, group sales agents, and hotel concierges) who book tourism packages in New York City.
  - Email addresses of individuals surveyed were provided to the researchers from The Ride, LLC.
  - Respondents were blind to the sponsor of this survey.
- The survey was fielded between April 29 and May 3, 2016
- A total of 165 responses were compiled among Consumers

<sup>45</sup> October 4, 2016 Response to Office Action at .33-60.



- Emails sent = 27,800
- Opened email = 495
- Completed survey = 165 (33.3%)
- A total of 62 responses were compiled among travel professionals
  - Emails sent = 3,400
  - Opened email = 230
  - Completed survey = 62 (27.0%)

## Sample Validity

The data provide highly valid estimates of the degree of recognition of The Ride.

For consumers, 96% of respondents recognized The Ride correctly from its drawing. With a sample size of 165, the margin of error \* around this estimate is +/- 3.0% at the 95% level of confidence. This means that with 95% confidence, we are certain that the true recognition of The Ride would be between 93.0% and 99.0% for this population of respondents.

For the travel professionals, 74% of respondents recognized The Ride correctly. With a sample size of 62, the margin of error around this estimate is +/- 10.8% at the 95% level of confidence. This means that if you took an infinite number of samples of 62 from the population, 95% of the time the correct recognition of The Ride would be between 63.2% and 84.8%.

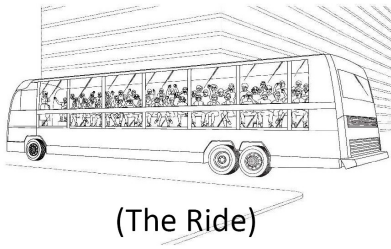
## Recognition of Tour Bus Companies

### Questions Asked

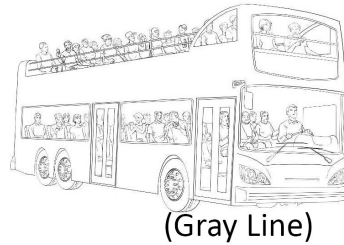
- Which Tour Bus Company do you associate with this drawing?
  - The Ride
  - Gray Line
  - CitySights
  - Big Bus
  - Circle Line
  - Other (specify)\_\_\_\_\_

- Don't know
- The order of the presentation of the drawings and the order of the answer choices were randomly rotated to control for order bias.

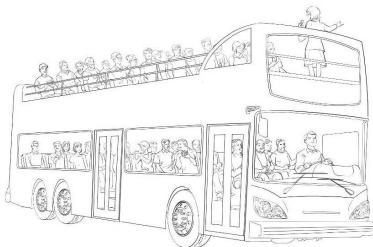
### Tested Drawings



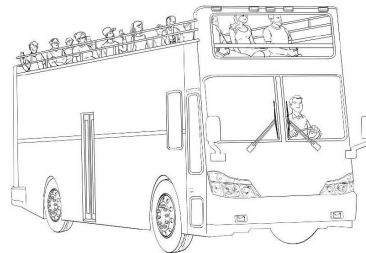
(The Ride)



(Gray Line)



(Big Bus)

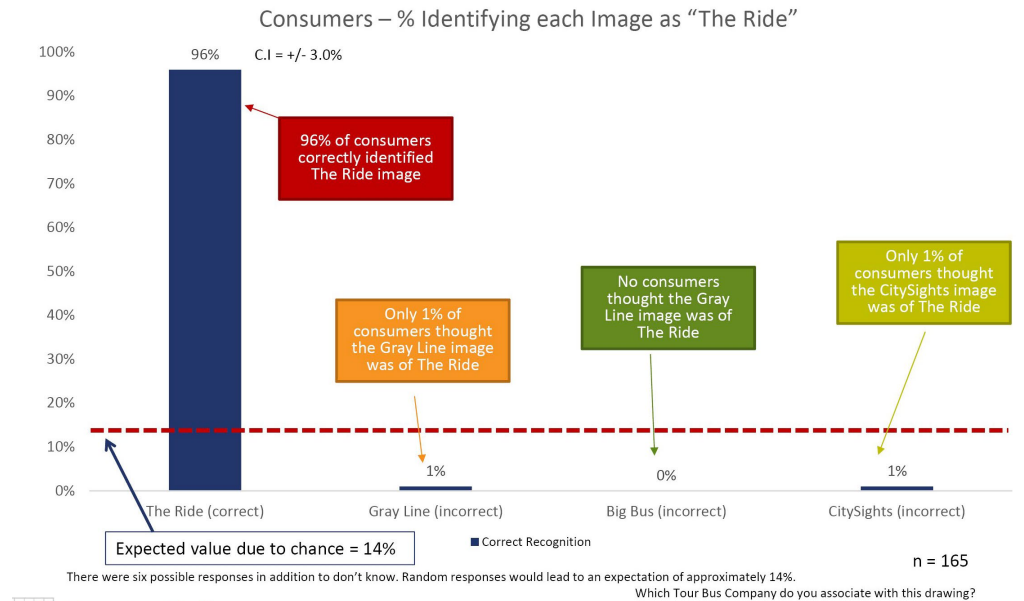


(CitySights)

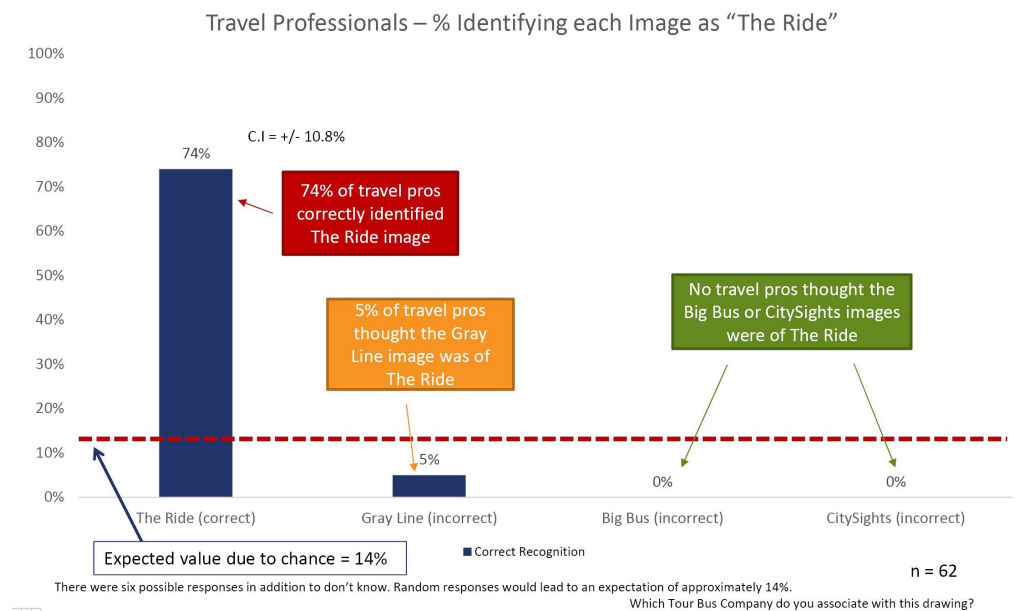


Note: The labels are shown here only for reference, the respondents did not see labels with the images.  
May 2016 The Ride Tour Bus Study

**Consumers overwhelmingly correctly identified The Ride from its drawing, and do not think any other images are The Ride.**



**Travel professionals strongly recognized The RIDE. The probability of this outcome occurring by chance alone is less than 1 in 1,000,000,000.**

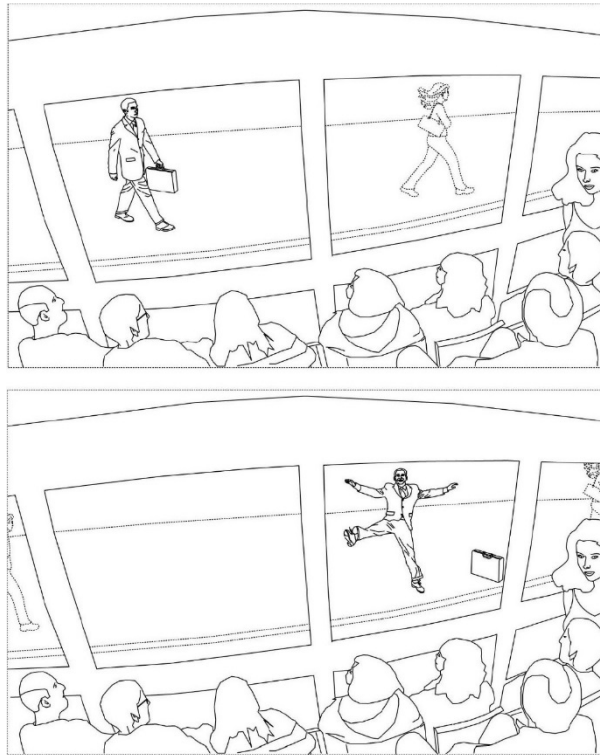


**Association with Street Performances**

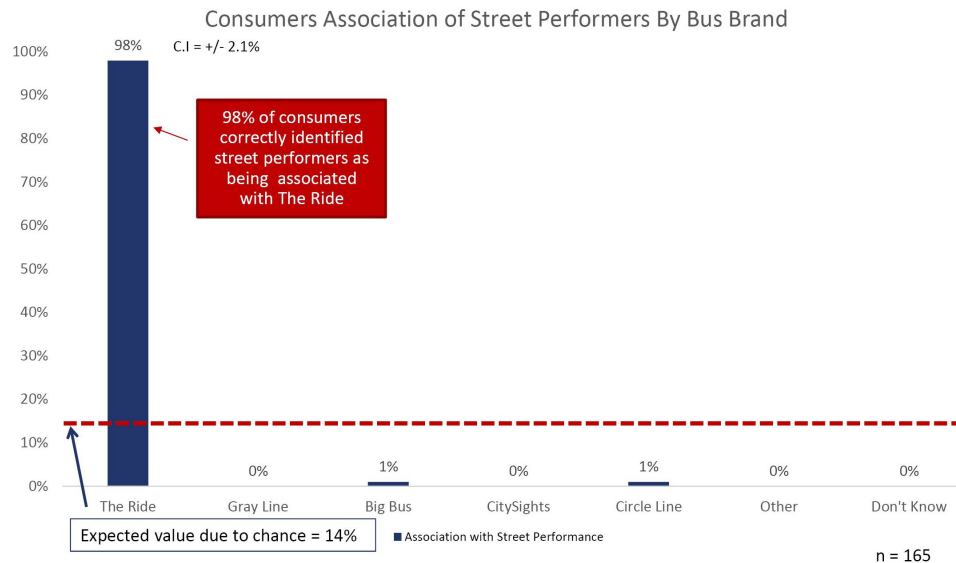
Question Asked

- Tour Buses may include random street performances by actors placed on the street. Which Tour Bus Company do you associate with seeing random street performances such as depicted in these drawings?
- The Ride
- Gray Line
- CitySights
- Big Bus
- Circle Line
- Other (specify)\_\_\_\_\_
- Don't know
- The order of the answer choices were randomly rotated to control for order bias.

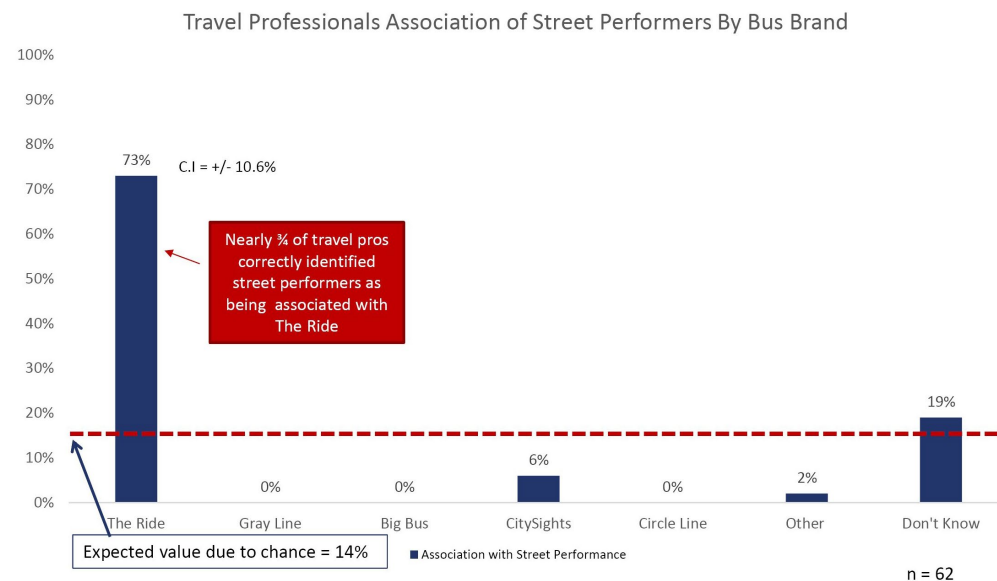
### Tested Street Performance Depiction



## Essentially all of the Consumers associated the depiction of the Street Performance with The Ride.



## Travel professionals strongly associate The Ride with street performances as depicted by the drawing. One in five could not make any association.



## Association with The Simpsons Parody

### Question Asked

- Recently, on an episode of The Simpsons television show, a tour bus was used as a spoof. Below you will see four screen shots from the TV Show. Which Tour Bus Company, if any, do you associate with The Simpson Show spoof?
  - The Ride
  - Gray Line
  - CitySights
  - Big Bus
  - Circle Line
  - Other (specify)\_\_\_\_\_
  - Don't know
- 
- The order of the answer choices were randomly rotated to control for order bias.

**Screenshots of the Simpsons Show that parodied Tour Buses were shown to respondents with descriptive captions.**



Two tour guides, stadium-style seating, floor-to-ceiling glass windows, panels of LED lights, and TV screens.



Tour guide says, "He might look like an ordinary hot dog vendor, but he's part of the show!"

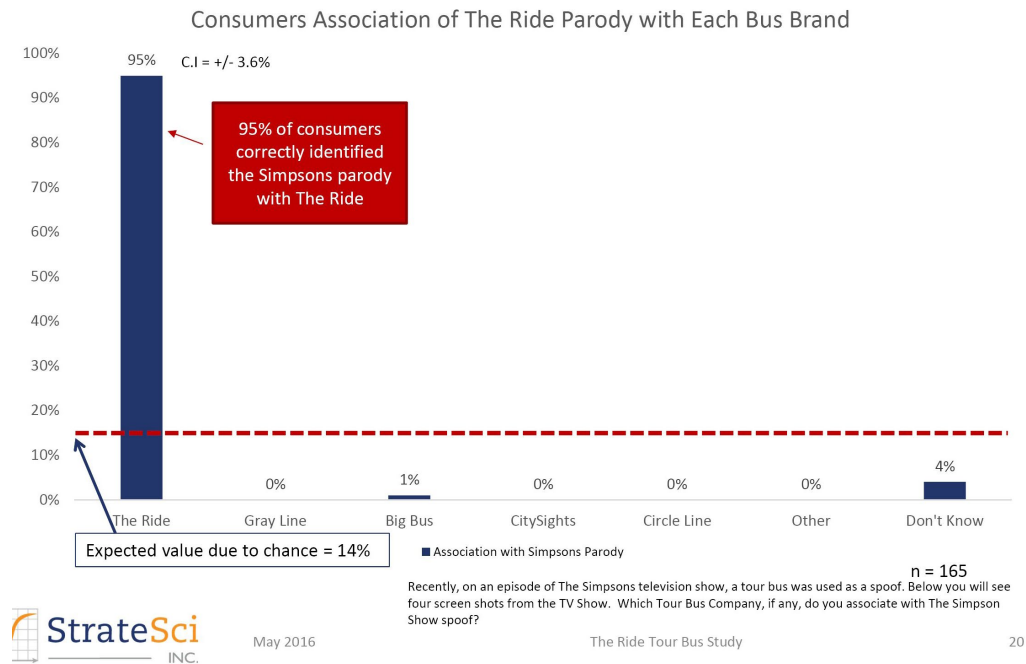


A side facing wall of glass featuring LED lights and TV screens.



Floor-to-ceiling glass windows make for great photo ops!

## Nearly all of the consumers recognized The Ride as the subject of the Simpsons parody.



## Two-thirds of the travel professionals associate the Simpsons parody with The Ride.



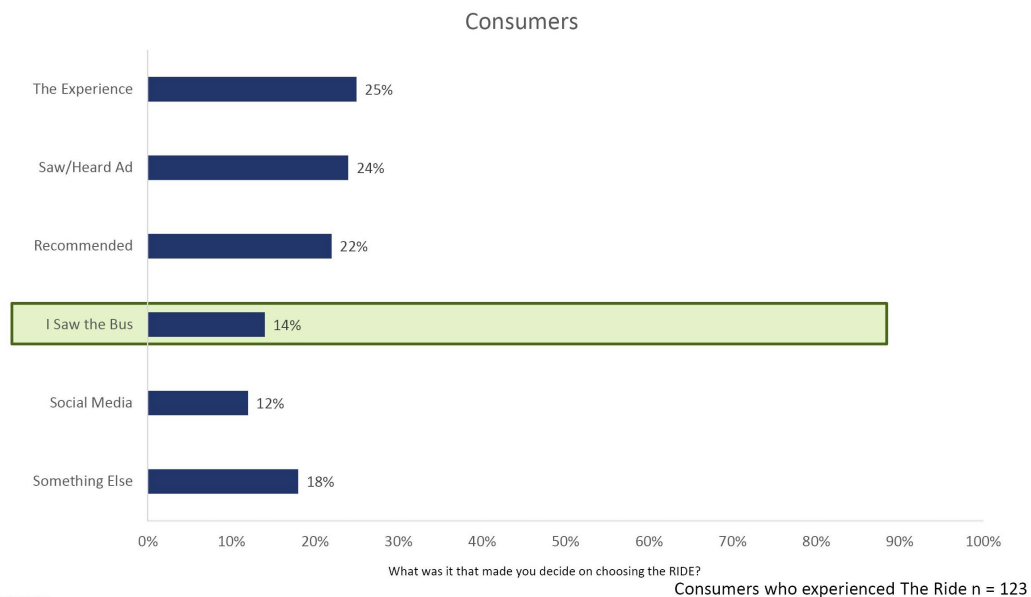
## Impact on Tour Bus Choices



### Question Asked

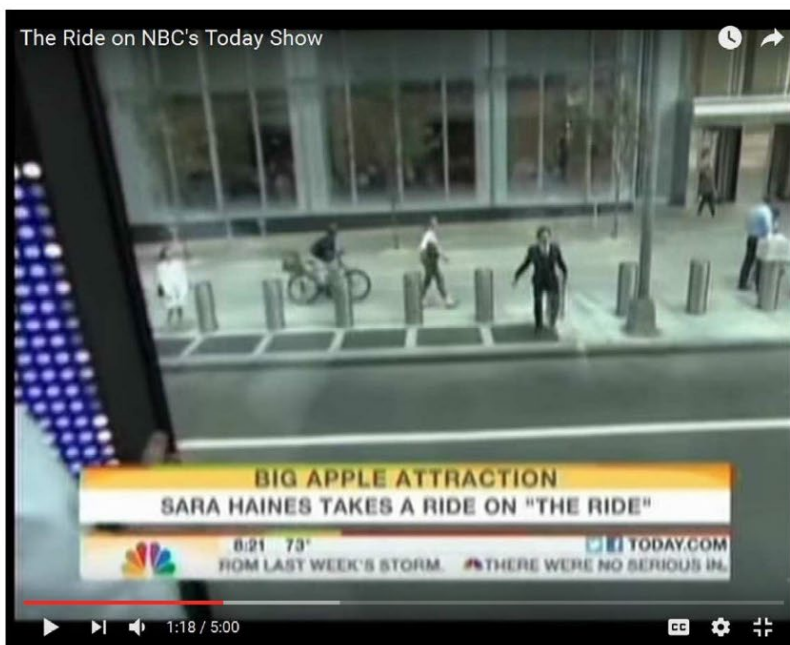
- What was it that made you decide on choosing the Ride?
  - I saw the bus
  - I saw or heard an ad
  - I saw it on Social Media
  - It was recommended to me
  - The experience
  - Something else (Specify)\_\_\_\_\_
- The order of the answer choices were randomly rotated to control for order bias and respondents could choose all the answers that applied.

**One in seven Consumers say they chose to take The Ride based on seeing the bus on the street.**





**Exhibit C – Example of Screenshots from videos depicting and discussing Applicant and its services:<sup>46</sup>**



NBC's "Today Show"; 09/28/2011  
( <https://www.youtube.com/watch?v=vD0DnAiw7hQ> )

**Exhibit D – Videos depicting and discussing Applicant and its services:<sup>47</sup>**

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<sup>46</sup> October 4, 2016 Response to Office Action at 61-64.

<sup>47</sup> February 2, 2018 Response to Office Action, submitted as separate attachments.



86845550 Exhibit Q Feb 2 2018.wmv



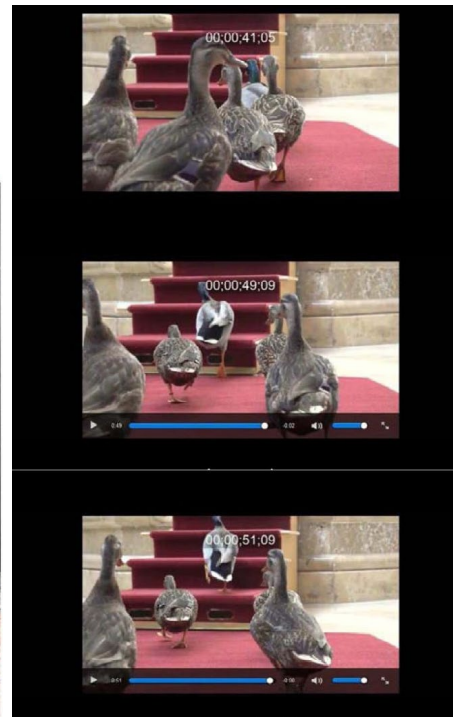
86845550 Exhibit R Feb 2 2018.wmv

### Exhibit E – Third-Party Registrations<sup>48</sup>

Reg. No. 2710415 for the mark displayed below, identifying “providing facilities of business meetings” in Class 35 and “providing facilities for banquets; hotel services; hotel catering and concierge services” in Class 42.



Reg. No. 2710415:  
Originally-filed Specimen



Reg. No. 2710415:  
§§8 and 9 Specimen, filed 08/05/2013

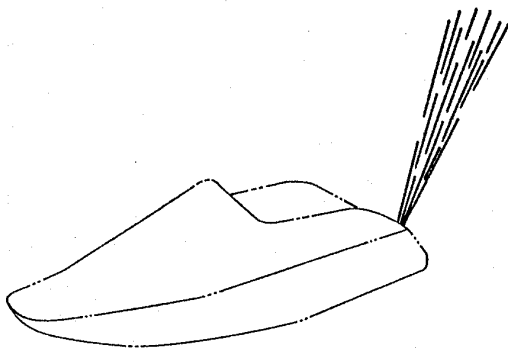
<sup>48</sup> October 4, 2016 Response to Office Action at 65-67; July 5, 2017 Response to Office Action at 18-27; February 2, 2018 Response to Office Action at 23-24. In addition, with its February 2, 2018 Response, Applicant submitted a second supporting declaration of its CEO, Mr. Richard Humphrey at 20-22. The third-party registrations included in this appendix are representative samples of the five submitted by Applicant.

**Serial No. 86845550**

The mark consists of the live visual and motion elements of the The Peabody Duck March as performed at The Peabody Hotels, only one segment of which is depicted in line art in the drawing. The motion elements include the red carpet being rolled out, the appearance of the ducks and uniformed Duckmaster at the elevator door, and the march of the ducks down the red carpet, up the steps, and into the fountain where they begin swimming. The mark also includes the fanfare in reverse sequence.

Reg. No. 1946170 (2f) for the mark displayed below, identifying “jet propelled water vehicles” in Class 12

The mark is comprised of a three dimensional spray of water issuing from the rear of a jet propelled watercraft and is generated during the operation of the watercraft.



Reg. No. 1946170: Specimen



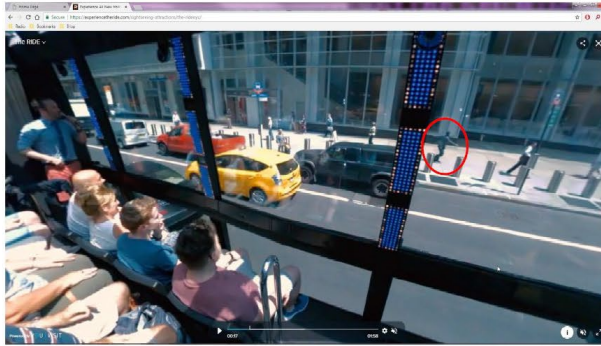
Exhibit F – Screenshots from Applicant's Website<sup>49</sup>



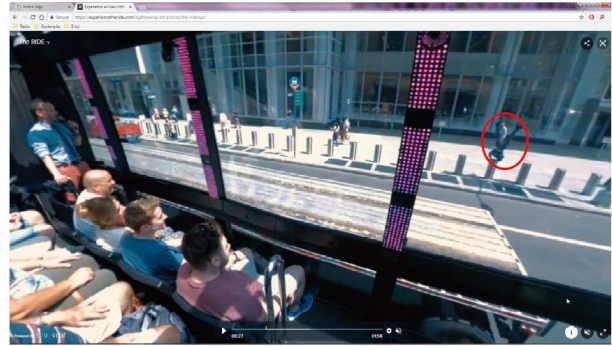
<sup>49</sup> Applicant's February 2, 2018 Request for Reconsideration at 26; Applicant's March 20, 2018 Second Request for Reconsideration at 4-5.



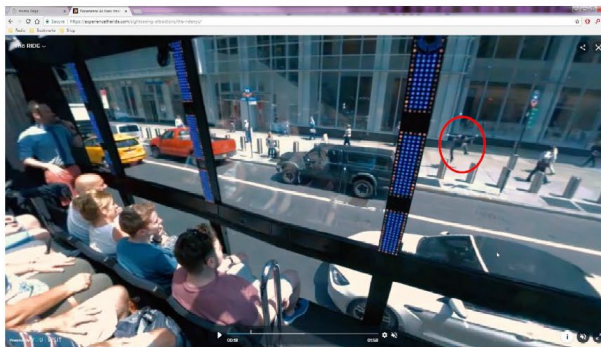
Seens from "360 VIDEO" accessed at <https://experiencetheride.com/sightseeing-attractions/the-ridenyc/>



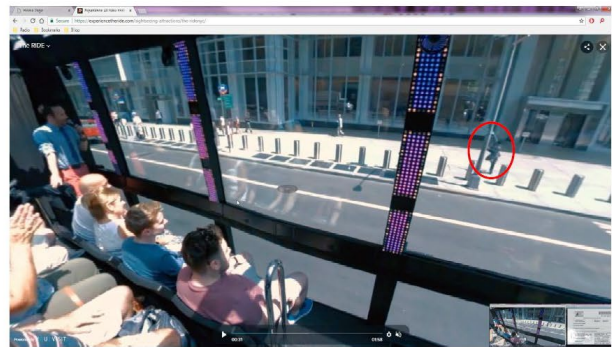
Time of frame = 00:17



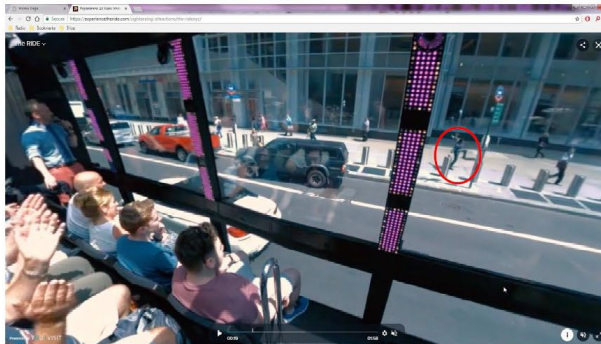
Time of frame = 00:27



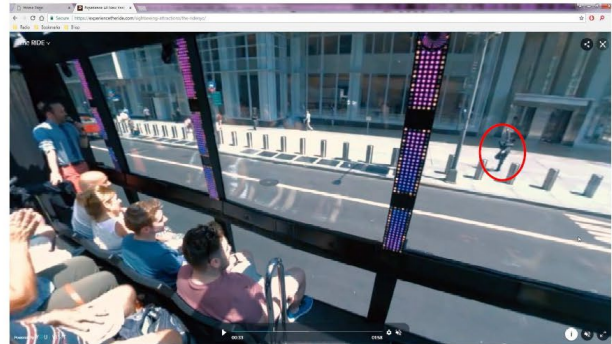
Time of frame = 00:18



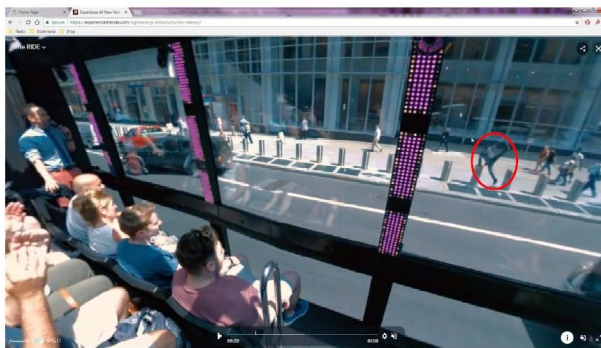
Time of frame = 00:31



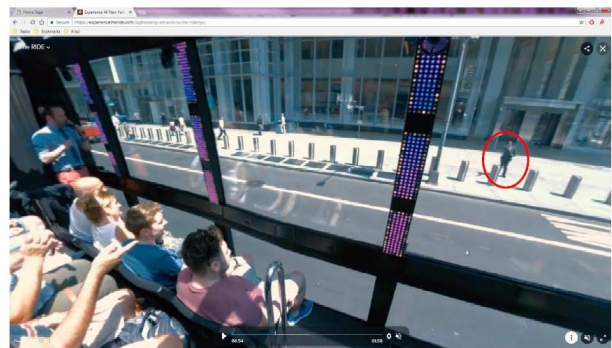
Time of frame = 00:19



Time of frame = 00:33



Time of frame = 00:22



Time of frame = 00:34

**Exhibit G – Declaration of Applicant’s CEO<sup>50</sup>**

Applicant submitted the declaration of Richard Humphrey, its Chief Executive Officer, in support of its claim of acquired distinctiveness:

The Ride, LLC has exercised substantially exclusive and continuous use of the above styled mark in commerce since at least September 30, 2010 and continues to exercise substantially exclusive and continuous use of the above-styled mark in commerce.

This use has been in commerce that may lawfully be regulated by the U.S. Congress.

As a result of this exclusive and continuous use for more than five years before the date of this Declaration, the mark has become distinctive of Applicant’s services of conducting sightseeing travel tours by bus.

The Ride, LLC expends substantial amounts of money, time and effort building an association between the Mark and The Ride as the single source of its tour bus-related services in the minds of potential purchasers. The Ride, LLC works extremely hard to educate the public regarding the association between the Mark and The Ride because the live visual and motion elements of the trade dress in which an individual appearing to be a banker performing a tap dance routine in front of a bus are so different from all other tour bus services that when potential customers of The Ride who have been educated to make this association see The Ride’s bus on the street, they become highly likely to purchase The Ride’s tour bus services. The Ride, LLC spends \$600,000 per year on marketing. Of that, over \$250,000 is spent on print advertisements, brochures and video presentations, all of which prominently display photographs of the Mark in association with The Ride. Thus, during the almost six years that The Ride, LLC has employed the Mark, it has spent over \$1,500,000 on these advertising materials. As a result of these advertising expenditures, The Ride, LLC has successfully educated, and continues to educate the public to associate the Mark directly with The Ride, LLC as a single source for its tour bus-related services.

As a result of the direct exposure to tens of millions of people each year for more than five years and the above-mentioned advertising exposure, the Mark has become widely associated with The Ride as a single source among purchasers of tour bus-related services in the relevant New York City

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<sup>50</sup> Applicant’s July 5, 2017 Response to Office Action at 16-17.

marketplace and throughout America, and therefore the mark has secondary meaning in the minds of such purchasers.