

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: December 13, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Prema Jyothi Light

Serial No. 76293326

Prema Jyothi Light, *pro se*.

Linda Lavache, Trademark Examining Attorney, Law Office 106
(Mary I. Sparrow, Managing Attorney).

Before Seeherman, Wellington and Lykos, Administrative
Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Over 12 years ago, on July 9, 2001, Prema Jyothi
Light, an individual (and hereinafter referred to as
"applicant"), filed an application¹ to register the
following matter on the Principal Register:

¹ Application Serial No. 76293326, filed on July 31, 2001, is
based on an allegation of first use on May 31, 1991, and first
used in commerce on August 31, 2000.

Shimmering Ballerinas & Dancers Character Collection

SHIMMERING WIND-HARP BUTTERFLIES
JALINDA, JALISA, JAH, JAJA, JELANI & JUMA,
THE SHIMMERING WIND-HARP BUTTERFLIES
ADORINA, THE ADORING BALLERINA & DANCER
AMETHYST DIAMOND SPARKLE, THE DANCER OF
SPARKLING JEWELS
AMORINA, THE LOVING BALLERINA & DANCER
BONNIE THE BOUNDLESSLY BOUNDING
BALLERINA & DANCER
BREEZARINA, THE BREEZEY BALLERINA & DANCER
CELESTINA, THE CELESTIAL BALLERINA & DANCER
CLARISSA, THE AIRY BALLERINA & DANCER
CLARISSA THE DEFINITE MAYBE BALLERINA
CRYSTALINA THE CRYSTAL BALLERINA & DANCER
DELIA THE DELIGHTFULLY FLOWERY BALLERINA
DESTINA, THE INTERNATIONAL PEACE BALLERINA
DIAMOND SPARKLE, THE SPARKLING DIAMOND
BALLERINA & DANCER
ELEGANCIA THE ELEGANT BALLERINA & DANCER
EMERALD SPARKLEFLOW, THE DANCER OF
SPARKLING EMERALDS
FARELINA, THE FAIRY BALLERINA & DANCER
FLOUNCY THE BOUNCY CLOWN BALLERINA
FLOWERYARINA THE FLOWERS EVERYWHERE
BALLERINA & DANCER
GLIMMERINA THE GLIMMERING BALLERINA
GLITTERINA THE GLITTERING BALLERINA
GLORIOUS GLORITTA THE GLORIOUSLY
GLORIOUS BALLERINA & DANCER
GLOWING JEWEL-SPARKLED BALLERINAS
GRACEFULINA, THE GRACEFUL FLOWERS ON THE
WIND BALLERINA & DANCER
IMAGINA, THE IMAGINATIVE STORYBOOK
TELL-ME-A-STORY BALLERINA & DANCER
JAMILLIA, THE DANCER IN ALL THE FRAGRANT
BLOSSOMS OF SPRING
JEWELINA, THE BEJEWELLED BALLERINA & THE
DANCER SPARKLING WITH JEWELS
KATHLINA, THE KINDHEARTED BALLERINA
KATERINA SKATERINA, THE SKATING BALLERINA
RUFFLINA, THE RUFFLY BALLERINA
LACEY, THE CASCADES OF LACE BALLERINA

MUSIC SHIMMERINA, THE SHIMMERING MUSIC
BALLERINA & DANCER
SILVER SHIMMERINA, THE SHIMMERING SILVERY
BALLERINA & DANCER
GOLDEN SHIMMERINA, THE SHIMMERING
GOLDEN BALLERINA & DANCER
COPPER SHIMMERINA, THE SHIMMERING
COPPERY BALLERINA & DANCER
MOONLIGHT SHIMMERINA, THE SHIMMERING
MOONLIGHT BALLERINA & DANCER
RAINY SPARKLE SHIMMERINA, THE SHIMMER OF
SPARKLING RAIN BALLERINA & DANCER
STARLIGHT GLOW SHIMMERINA, THE SHIMMERING
GLOW OF STARLIGHT BALLERINA & DANCER
CARESSINA SHIMMERINA, THE CARESS OF
SHIMMERING WINDS BALLERINA & DANCER
SPARKLING SNOW SHIMMERINA, THE SHIMMER
OF SPARKLING SNOW BALLERINA & DANCER
SPLASHERINA SHIMMERINA, THE SHIMMER OF
SPLASHING WATERFALLS BALLERINA DANCER
BREEZY SHIMMERINA, THE SHIMMERING
BREEZES BALLERINA & DANCER
MISTI SHIMMERINA THE SHIMMERING MIST
BALLERINA & DANCER
LAUGHING SHIMMERINA, THE SHIMMERING
LAUGHTER BALLERINA & DANCER
SPARKLING RAINFALL SHIMMERINA THE
SHIMMERING RAINDROPS BALLERINA
RUSHING RIVER SHIMMERINA, THE SHIMMERING
RIVERS BALLERINA
SPARKLINGLAKE SHIMMERINA, THE
SHIMMERING LAKES BALLERINA
LIGHTERINA, THE DANCING LIGHTLY
LIGHT-HEARTED DANCER
LACEY LACERINA, THE CASCADES OF LACE
BALLERINA & DANCER
LUMINESSA, THE DANCER OF LUMINOUS LIGHT
LIMINOSA DE LUZ
MARINA, THE REFLECTING BALLERINA
MELODY (OR MELODINA), THE MELODIOUS
BALLERINA & DANCER OF A THOUSAND
MELODIES

PEONYARINA, THE PEONY BALLERINA &
DANCER OF BLOSSOMING PEONIES
PETALIA, THE PETALSHOWER BALLERINA
PETALINA, DANCER IN A SHOWER OF PETALS
ROSALIA, THE FRAGRANT ROSES
BALLERINA & DANCER
RAINSHOWERINA, THE AFTER-THE-RAIN
RAINBOW BALLERINA & DANCER
RUBY SPARKLE, THE DANCER OF
FLASHING JEWELS
SAPPHIRINA, THE EVENING SKY BALLERINA
SERENA, THE SERENE BALLERINA
SIERRA, THE SPORTSARINA (SPORTSARENA)
BALLERINA & DANCER
SPARKLING SNOW, THE SKING BALLERINA
SPRING BLOSSOMS, THE BLOSSOMING
BALLERINA & DANCER
SUMMERWINDSARINA, THE BLOSSOMS IN THE
BREEZE LIGHTHEARTED BALLERINA
STAR-SPANGLED NIGHT SKY DANCERS
(ALSO MORNING SKY OR TWILIGHT SKY)
STOMPERINA, THE COUNTRY QUEENA
SUMMERINA, THE SUMMERY BALLERINA
SUMMERINALINA, THE GOLDEN SUNSHINY
BALLERINA & DANCER
SUNSHINESSA, THE SUNSHINY LIGHTHEARTED
BALLERINA & DANCER
THE TWO DIZZY DAMES BALLERINAS:
SWIRLINA THE SWIRLING BALLERINA
TWIRLINA THE TWIRLING BALLERINA
TESSIE LOU TOLDALOO, THE BALLERINA
FROM TIMBUKTOO
TOPAZ GOLDEN SKY THE SUN-COMING-UP
IN THE MORNING SKY BALLERINA
TOPAZARINA, THE FLOATING THROUGH THE
AIR MORNING SKY BALLERINA
LIGHTWINDS, THE DANCER ON WINDS
OF LIGHT
TOPAZ SPARKLE, THE JEWEL-BRIGHT DANCER
TOVA THE CANDLELIGHT DANCER
TULIPETALINA THE TULIP PETAL BALLERINA
ZAHRA, THE DAZZLING BALLERINA
ZAHRA, THE LILTINGLY LOVELY BALLERINA
SILVERINA THE SILVERY SHIMMERGLLOWING
BALLERINA
SPARKLES'N' SPANGLES, THE SUN-SPANGLED
BALLERINA & DANCER
SPARKLINA THE SPARKLING BALLERINA &
SPARKLINARINA, THE DANCER IN A SHOWER
OF SPARKLES
STREAMERINA, THE STREAMING BALLERINA
VALENTINA, THE OVERFLOWING WITH
FLOWERS AND LOVE VALENTINE BALLERINA
VELVET THE SOFTLY SWIRLING FOLDS OF
VELVET BALLERINA
SPARKLESHINE, THE SILVER-SPANGLED SNOW
DANCER & SNOW BALLERINA
WINTERINA, THE BEAUTY OF SNOWY WINTER
BALLERINA

Because the clarity of the drawing page in the USPTO office database may be insufficient for some readers, we point out that the mark contains the larger, stylized wording SHIMMERING BALLERINAS & DANCERS CHARACTER COLLECTION on the top left and is surrounded by columns of the following terms (in a smaller font) that appear to identify names of a variety of characters:

SHIMMERING WIND-HARP BUTTERFLIES JALINDA, JALISA, JAHA, JAJA, JELANI & JUMM, THE SHIMMERING WIND-HARP BUTTERFLIES ADORINA, THE ADORING BALLERINA & DANCER AMETHYST DIAMOND SPARKLE, THE DANCER OF SPARKLING JEWELS AMORINA, THE LOVING BALLERINA & DANCER BONNIE THE BOUNDLESSLY BOUNDING BALLERINA & DANCER BREEZARINA, THE BREEZY BALLERINA & DANCER CELESTINA, THE CELESTIAL BALLERINA & DANCER CLARISSINA, THE AIRY BALLERINA & DANCER CLARISSA THE DEFINITE MAYBE BALLERINA CRYSTALINA THE CRYSTAL BALLERINA & DANCER DELIA THE DELIGHTFULLY FLOWERY BALLERINA DESTINA THE INTERNATIONAL PEACE BALLERINA DIAMOND SPARKLE, THE SPARKLING DIAMOND BALLERINA & DANCER ELEGANCIA THE ELEGANT BALLERINA & DANCER EMERALD SPARKLEGLOW, THE DANCER OF SPARKLING EMERALDS FAIRELINA, THE FAIRY BALLERINA & DANCER FLOUNCY THE BOUNCY CLOWN BALLERINA FLOWERYARINA THE FLOWERS EVERYWHERE BALLERINA & DANCER GLIMMERINA THE GLIMMERING BALLERINA GLITTERINA THE GLITTERING BALLERINA GLORIOUS GLORETTA THE GLORIOUSLY GLORIOUS BALLERINA & DANCER GLOWING JEWEL-SPARKLED BALLERINAS GRACEFULINA, THE GRACEFUL FLOWERS ON THE WIND BALLERINA & DANCER IMAGINA, THE IMAGINATIVE STORYBOOK TELL-ME-A-STORY BALLERINA & DANCER JAMILLIA, THE DANCER IN ALL THE FRAGRANT BLOSSOMS OF SPRING JEWELINA, THE BEJEWELLED BALLERINA & THE DANCER SPARKLING WITH JEWELS KATHLINA, THE KINDHEARTED BALLERINA KATERINA SKATERINA, THE SKATING BALLERINA RUFFLINA, THE RUFFLY BALLERINA LACEY, THE CASCADES OF LACE BALLERINA MUSIC SHIMMERINA, THE SHIMMERING MUSIC BALLERINA & DANCER SILVER SHIMMERINA, THE SHIMMERING SILVERY BALLERINA & DANCER GOLDEN SHIMMERINA, THE SHIMMERING GOLDEN BALLERINA & DANCER COPPER BALLERINA, THE SHIMMERING COPPERY BALLERINA & DANCER MOONLIGHT

SHIMMERINA, THE SHIMMERING MOONLIGHT BALLERINA & DANCER RAINY SPARKLE SHIMMERINA, THE SHIMMER OF SPARKLING RAIN BALLERINA & DANCER STARLIGHT GLOW SHIMMERINA, THE SHIMMERING GLOW OF STARLIGHT BALLERING & DANCER CARESSINA SHIMMERINA, THE CARESS OF SHIMMEING WINDS BALLERINA & DANCER SPARKLING SNOW SHIMMERINA, THE SHIMMER OF SPARKLING SNOW BALLERINA & DANCER SPLASHERINA SHIMMERINA, THE SHIMMER OF SPLASHING WATERFALLS BALLERINA DANCER BREEZY SHIMMERINA, THE SHIMMERING BREEZES BALLERINA & DANCER MISTI SHIMMERING THE SHIMMERING MIST BALLERINA & DANCER LAUGHING SHIMMERINA, THE SHIMMERING LAUGHTER BALLERINA & DANCER SPARKLING RAINFALL SHIMMERINA THE SHIMMERING RAINDROPS BALLERINA RUSHING RIVER SHIMMERINA, THE SHIMMERING RIVERS BALLERINA RUSHING RIVER SHIMMERINA, THE SHIMMERING RIVERS BALLERINA SPARKLINGLAKE SHIMMERINA, THE SHIMMERING LAKES BALLERINA LIGHTERINA, THE DANCING LIGHTLY LIGHT-HEARTED DANCER LACEY LACERINA, THE CASCADES OF LACE BALLERINA & DANCER LUMINESSA, THE DANCER OF LIMINOUS LIGHT LIMINOSA DE LUZ MARINA, THE REFLECTING BALLERINA MELODY (OR MELODINA) THE MELODIOUS BALLERINA & DANCER OF A THOUSAND MELODIES SHIMMER SHIMMERINA, THE SHIMMERING BALLERINA & DANCE OF SHIMMERING LOVE WITH FLOWERS THE SHIMMERINGLY, SERIOUSLY GOURGEOUS & COOL BALLERINAS & DANCERS THE SHIMMERINGLY SHIMMERING DANCERS THE LIGHT SHIMMERING ON WATER DANCE ACADEMY, SOMETIMES KNOWN AS THE LIGHT SPARKLING ON WATER DANCE ACADEMY GLORIOUSLY BRIGHT FAITH LIGHT PEONYARINA, THE PEONY BALLERINA & DANCER OF BLOSSOMING PEONIES PETALIA, THE PETALSHOWER BALLERINA PETALLINA DANCER IN A SHOWERSOF PETALS ROSALIA, THE FRAGRANT ROSES BALLERINA & DANCER RAINSHOWERINA, THE AFTER-THE-RAIN RANBOW BALLERINA & DANCER RUBY SPARKLE, THE DANCER OF FLASHING JEWELS SAPPHIRINA, THE EVENING SKY BALLERINA SERINA, THE SERENE BALLERINA SIERRA, THE SPORTSARINA (SPORTSARENA) BALLERINA & DANCER SPARKLING SNOW, THE SKIING BALLERINA SPRING BLOSSOMS, THE BLOSSOMING BALLERINA & DANCER SUMMERWINDSARINA, THE BLOSSOMS IN THE BREEZE LIGHTHEARTED BALLERINA STAR-SPANGLED NIGHT SKY DANCERS (ALSO MORNING SKY OR TWILIGHT SKY) STOMPERINA, THE COUNTRY QUEENA SUMMERINA, THE SUMMERY BALLERINA SUMMERINALINA, THE GOLDEN SUNSHINY BALLERINA & DANCER SUNSHINESSA, THE SUNSHINY LIGHTHEARTED BALLERINA & DANCER THE TWO DIZZY DAMES BALLERINAS SWIRLINA THE SWIRLING BALLERINA TWIRLINA THE TWIRLING BALLERINA TESSIE LOU TOUDALOO, THE BALLERINA FROM TIMBUKTOO

TOPAZ GOLDEN SKY THE SUN-COMING-UP IN THE MORNING SKY
BALLERINA TOPAZARINA, THE FLOATING THROUGH THE AIR
MORNING SKY BALLERINA LIGHTWINDS, THE DANCER ON WINDS
OF LIGHT TOPAZ SPARKLE, THE JEWEL-BRIGHT DANCER TOVA
THE CANDLELIGHT DANCER TULIPETALINA THE TULIP PETAL
BALLERINA ZAHRALINA, THE DAZZLING BALLERINA ZAHRA, THE
LILTINGLY LOVELY BALLERINA SILVERINA THE SILVERY
SHIMMERGLOWING BALLERINA SPARKLES'N'SPANGLES, THE SUN-
SPANGLED BALLERINA & DANCER SPARKLINA THE SPARKLING
BALLERINA & SPARKLINARINA, THE DANCER IN A SHOWER OF
SPARKLES STREAMERINA, THE STREAMING BALLERINA
VALENTINA, THE OVERFLOWING WITH FLOWERS AND LOVE
VALENTINE BALLERINA VELVET THE SOFTLY SWIRLING FOLDS
OF VELVET BALLERINA SPARKLESHINE, THE SILVER-SPANGLED
SNOW DANCER & SNOW BALLERINA WINTERINA, THE BEAUTY OF
SNOWY WINTER BALLERINA

Applicant seeks to register the proposed mark for the
following goods:

Cartoon prints, cartoon strips, cartoons to be
submitted for publication by publishers and
periodicals, and illustrations, which may include text
with visual art, or just the visual art; leaflets and
series of booklets of printed text materials,
specifically, stories and poems; leaflets, series of
booklets, storybooks, and playbooks for children,
which contain any or all of these-- paper dolls,
coloring book pages, stories, poems, illustrations,
games, connect-the-dots pictures, snowflake cutting
patterns, suggestions for children's activities, and
patterns for toys, pillows, and decals for T-shirts,
pajamas, and mugs.

Applicant has amended the application to include a
claim that the proposed mark has acquired distinctiveness
under Section 2(f) of the Act.²

² Asserted in applicant's "request for reconsideration" that was
purportedly filed on December 15, 2009, a copy of which was
attached to applicant's "request for remand and amendment," filed
with the Board on February 8, 2010.

The examining attorney has refused registration on the ground that the applied-for matter fails to function as a mark under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052 and 1127. The examining attorney has also refused to accept applicant's proposed amendments to the drawing because they each constitute a material alteration of the proposed mark shown in the original drawing.

Appeal briefs have been filed.³

Issues on Appeal

The application was filed in 2001 and the prosecution history comprises many Office actions, responses and other filings by applicant. Applicant's appeal was instituted in

³ There had been earlier briefing of the appeal. However, because of the subsequent developments, including a remand by the Board for the examining attorney to consider whether an additional ground for refusal should be raised, the Board determined that it would be more helpful for applicant and the examining attorney to file new, as opposed to supplemental briefs. As a result, the Board, on April 5, 2013, advised that the earlier filed briefs would be given no consideration, and applicant and the examining attorney were given time to file new briefs. Our references to briefs therefore are to these latter-filed briefs, including applicant's reply brief, and we have not considered the earlier briefs in reaching our decision in this appeal.

The examining attorney's objection to materials attached to applicant's appeal brief on the basis that they were not made of record during prosecution of the involved application is sustained. See Trademark Rule 2.142(d). See also *In re Volvo Cars of North America, Inc.*, 46 USPQ2d 1455, 1456 n.2 (TTAB 1998); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1372 (TTAB 2006); and *In re District of Columbia*, 101 USPQ2d 1588, 1591 (TTAB 2012). Accordingly, these materials have not been considered.

2005 and, since then, the Board TTABVUE database reflects there have been over 100 entries. We make no attempt herein to recount all events and filings leading up to the appeal but note only those that are relevant to our decision.

In spite of any confusion created by the extensive amount of time the prosecution of this application and the subsequent appeal have taken, and notwithstanding the numerous papers filed, the March 9, 2013 Office action sets forth, succinctly and accurately, the issues now ready for decision on appeal. Specifically, as a result of the most recent remand, and at the behest of the Board, the examining attorney outlined the following "Summary of Outstanding Issues" on appeal:

1. Trademark Act Sections 1, 2 and 45 Refusal - Applied-For Mark Fails to Function as a Trademark on the Specimens and the Claim of Acquired Distinctiveness is Insufficient.
2. Applicant's Three Separate Requests to Amend the Drawing are Not Acceptable Because the Proposed [Amended] Marks Constitute Material Alterations of the Mark Shown in the Original Drawing (Trademark Rule 2.72(b)(2)).

Based on our review of the prosecution and appeal history, we agree that these are the appropriate issues on appeal. We further note that the examining attorney articulated her reasoning for the refusals in the same

Office action and this was the last Office action issued prior to applicant's filing of her appeal brief. Thus, any argument by applicant that she is unaware of or in disagreement with the statement of the issues on appeal is not well taken. Arguments and materials submitted by applicant that are irrelevant to the issues before us or are untimely have been disregarded. We now address the issues on appeal.

Applicant's Proposed Mark Fails to Function as a Trademark

Sections 1, 2, and 45 of the Trademark Act provide the statutory basis for refusal to register subject matter on the Principal Register on the basis the proposed mark fails to function as a trademark. 15 U.S.C. §§ 1051, 1052 and 1127. Specifically, Sections 1 and 2 provide, *inter alia*, for the application and registration on the Principal Register of trademarks "by which the goods of the applicant may be distinguished from the goods of others" and Section 45 defines a "trademark," in pertinent part, as "any word, name, symbol, or device, or any combination thereof used by a person ... to identify and distinguish his or her goods ... from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown." Accordingly, the Office is statutorily

constrained to register matter on the Principal Register only if it functions as a trademark.

"[N]ot every designation adopted with the intention that it performs a trademark function and even labeled as a trademark necessarily accomplishes that purpose...."

American Velcro, Inc. v. Charles Mayer Studios, Inc., 177 USPQ 149, 154 (TTAB 1973).

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 1227, 1229 (TTAB 2010) (citations omitted).

Thus, the critical question in determining whether applicant's proposed mark functions as a trademark 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 goods).

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."

(citations omitted)); *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455, 1459 (TTAB 1998); *In re Remington Products Inc.*, 3 USPQ2d 1714, 1715 (TTAB 1987); *In re Morganroth*, 208 USPQ 284, 287 (TTAB 1980).

Based on our 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 trademark. We further agree with the examining attorney's contention that because of the sheer number and visual display of the words in the applied-for matter, it faces a significantly more difficult task in being perceived as a unitary trademark. We note, in this regard, the decision in *In re McDonald's Corporation*, 199 USPQ 490 (TTAB 1978), involving an application to register TWOALLBEEFPATTIESSPECIALSAUCE-LETTUCECHEESEPICKLESONIONSONASESAMESEEDBUN as a mark for restaurant services. In that case, the proposed mark initially was refused for not being used in the nature of a mark, *id.* at n.2, and ultimately was refused, despite applicant's claim of acquired distinctiveness, as a mere display of a list of unregistrable terms, specifically, a list of the ingredients of a special sandwich, where the

display did not create a commercial impression apart from the terms themselves. *Id.* at 491. While the applicant in the *McDonald's* case was able to provide evidence sufficient to overcome the refusal, we do not, in this case, have the same type of persuasive evidence that would allow us to reverse the examining attorney's refusal. We also find that the much greater number of words in applicant's proposed mark, as compared to the list of ingredients in the *McDonald's* case, presents an even higher hurdle for applicant to overcome when trying to establish that her proposed mark would be perceived as such. In short, the quantity of information in the proposed mark is simply too great to be a useful means for consumers to differentiate one source from another.

The original specimens submitted with the instant application depict the applied-for mark on pages from what applicant stated are "playbooks."⁴ The proposed mark appears on a few pages below a similarly presented list of names called "Shimmering Breezes Character Collection" or "Shimmering Rainforest Character Collection" in such a manner that it will not be perceived as a trademark or as indicating the source of applicant's identified goods.

Rather, the proposed mark merely identifies what appears to be a title (of a story, e.g.) and a list of fanciful, fictional names for dancers.

Likewise, the substitute specimens fail to show the proposed mark in a manner such that consumers would perceive it as an indicator of source for any of the identified goods. In particular, on February 10, 2004, applicant submitted specimens showing the proposed mark on a page alongside an "introduction" to a self-described "playbook" that includes stories and activities, e.g., coloring, cut-outs, etc., for children.⁵ The introduction describes "Shimmering Ballerinas & Dancers" as a "spin off from the sympathetic dance academy and dance troupes" in a corresponding story. Thus, upon reading this description, and viewing the proposed mark either alongside it or elsewhere, readers and users of the playbook will understand the applied-for matter as simply identifying a title or theme for the playbook, as well as a corresponding list of character names in the playbook.

⁴ The specimens appear in USPTO TSDR database, July 9, 2001, "specimen" entry (pp. 1-31). For sake of brevity, the specimen images are not reproduced in this decision.

⁵ The specimens appear in USPTO TSDR database, February 10, 2004, "specimen" entries. For sake of brevity, the specimen images are not reproduced in this decision.

In addition, applicant submitted specimens in support of her proposed amended renditions of the original applied-for mark. As discussed later, the proposed amendments to the mark are unacceptable because each would constitute a material alteration. Nevertheless, for sake of completeness, we find that even if any of applicant's amendments were accepted, the specimens of use do not show that the applied-for matter, in any of the proposed forms, functions as a trademark. For example, the specimens submitted on February 6, 2013, show the proposed amended mark in the following manner:



Be sure to look for this unique Shimmering Ballerinas & Dancers Trademark, above,
to assure you that you have publications & products with the genuine, original
Shimmering Ballerinas & Dancers Characters,
rather than knock-offs or plagiarized versions of them!

This beautiful family of characters appears in leaflets, booklets, books and a wide variety
of popular publications, to delight you, entertain you, inform you, and inspire you!

We are happy to have the privilege of serving you!

May God bless you and peace be with you!

Om Shanthi, Om Peace!

-- Prema Jyothi Light

This page is described as the "back cover" of a "4-page leaflet."⁶ Although this purported specimen of use directs the reader to "look for this unique SHIMMERING BALLERINAS & DANCERS TRADEMARK, ABOVE," and inserts a "TM" alongside "SHIMMERING BALLERINAS," we do not believe that persons reading this will then view the entire proposed mark, *i.e.*, SHIMMERING BALLERINAS & DANCERS CHARACTER COLLECTION and the entire list of characters, as a single trademark. Rather, we agree with the examining attorney that "[c]onsumers that read this statement are likely to perceive applicant's reference to the 'Trademark' as referring to the actual 'SHIMMERING BALLERINAS & DANCERS' wording that is referenced in the statement and shown in the 'mark' in a larger, stylized font directly next to the 'TM' symbol." Brief, p. 13. In other words, at best consumers would perceive SHIMMERING BALLERINAS & DANCERS as being the intended trademark while the CHARACTER COLLECTION (followed by a long list of character names) portion will merely be perceived as informational. Applicant's

⁶ Although not an issue on appeal, we note the examining attorney also objected to this specimen because it was not verified with an affidavit or signed declaration in accordance with Trademark Rule 2.20. The examining attorney also contends that applicant has admitted that the purported specimen is in actuality a "mock-up" of a leaflet and notes there is a copyright notice date of 2004 in the bottom right corner of the page; the examining attorney concludes that this substitute specimen cannot be

insertion of "TM" in this specimen does not help because it appears immediately after SHIMMERING RAINFOREST and would not be understood as intended for the entire applied-for matter. In any event, use of the "TM" symbol does not automatically confer trademark rights or otherwise obviate a failure to function refusal. *In re Aerospace Optics Inc.*, 78 USPQ2d at 1864; *In re Brass-Craft Mfg. Co.*, 49 USPQ2d 1849, 1853 (TTAB 1998). Accordingly, these specimens fail to show that the proposed mark, in its entirety, is actually functioning as a single trademark.

Upon consideration of the entire record, we agree with the examining attorney that the applied-for matter as it is being used is merely informational, and will be perceived as such. As the examining attorney has pointed out, the actual layout of the proposed mark, viewed by itself or in connection with all specimen pages, creates an appearance such that viewers, whether they be prospective consumers or not, would not believe that this matter is a trademark. Rather, they will understand the matter as identifying the title and fictional characters of a story which may form the basis or theme for children's play materials.

considered an example of use in commerce as of the application's filing date.

Finally, we note that applicant has asserted a claim that the applied-for mark has acquired distinctiveness pursuant to Trademark Act Section 2(f), 15 U.S.C. § 1052(f). Applicant's claim of acquired distinctiveness appears to rest essentially on her alleged years of use of the applied-for mark in the manner shown in the previously-discussed specimens. As explained, the specimens do not demonstrate trademark use and, without more, such as evidence that the matter has been promoted as a trademark, *see McDonald's*, 199 USPQ at 491, we cannot find that the applied-for mark has acquired distinctiveness regardless of the time the applied-for mark has been used in this manner. *See, e.g., In re Ennco Display Systems Inc.*, 56 USPQ2d 1279, 1286 (TTAB 2000) (applicant's years of use of product designs insufficient to bestow acquired distinctiveness).

In summary, the evidence of record does not support a conclusion that the applied-for matter functions as a trademark or otherwise is distinctive for purposes of acting as a source identifier for the identified goods.

Material Alterations to Mark

In the initial Office action and prior to the failure to function refusal being raised, the then-examining attorney offered applicant the option to submit a new drawing and to "delete the words 'character collection' and

all the words in the columns" because this portion is "informational and not part of the mark."⁷ The examining attorney went on to state that "[p]eople would not perceive all the names on the drawing as a single mark for the goods." Later during the prosecution and after the failure to function refusal was raised, the examining attorney again offered applicant the option to "submit a drawing containing only the words SHIMMERING BALLERINAS & DANCERS without any other elements" and, the examining attorney advised, this would "overcome the [failure to function] refusal."⁸ In what was apparently in response to, but not in compliance with, the examining attorney's suggestions, applicant submitted several proposed amendments to the drawing. Each attempt has been refused by the examining attorney because it materially alters the original applied-for mark.

Trademark Rule 2.72(a)(2), which governs applications filed pursuant to Section 1(a) (use in commerce), provides that an applicant may amend the drawing of the mark if "[t]he proposed amendment does not materially alter the mark. The Office will determine whether a proposed amendment materially alters a mark by comparing the

⁷ See TSDR database entry dated June 26, 2002 ("priority action").

proposed amendment with the description or drawing of the mark filed with the original application." The test for determining whether a proposed amendment is a material alteration has been articulated as follows:

The modified mark must contain what is the essence of the original mark, and the new form must create the impression of being essentially the same mark. The general test of whether an alteration is material is whether the mark would have to be republished after the alteration in order to fairly present the mark for purposes of opposition. If one mark is sufficiently different from another mark as to require republication, it would be tantamount to a new mark appropriate for a new application.

In re Hacot-Colombier, 105 F.3d 616, 620, 41 USPQ2d 1523, 1526 (Fed. Cir. 1997), quoting *Visa Int'l Service Ass'n v. Life-Code Systems, Inc.*, 220 USPQ 740, 743-44 (TTAB 1983). Also, as has often been stated, the addition of any element that would require a further search generally will constitute a material alteration. *In re Pierce Foods Corp.*, 230 USPQ 307 (TTAB 1986). The crucial questions are whether the proposed amendment retains "the essence of the original mark" and whether it creates "the impression of being essentially the same mark." *In re Who? Vision Systems, Inc.*, 57 USPQ2d 1211, 1218 (TTAB 2000). That is, "the new and old forms of the mark must create essentially the same commercial impression." *Id.*, quoting *In re*

⁸ See TSDR database entry dated June 14, 2008 ("Office action

Nationwide Industries Inc., 6 USPQ2d 1882, 1885 (TTAB 1988). See also, *In Re Guitar Straps Online*, 103 USPQ2d 1745 (TTAB 2012).

With the above in mind and after careful consideration, we find that each of the three different attempts by applicant to amend the proposed mark, as originally filed, constitutes a material alteration. First, with respect to applicant's proposed amended drawing submitted on March 6, 2003, this alters the original proposed mark by removing the columns of character names and displaying the character names in a radial or "starburst" manner (surrounding the stylized literal portion SHIMMERING BALLERINAS & DANCERS).⁹ As the examining attorney correctly notes, the new design incorporating the names of the characters creates a new commercial impression that would necessarily involve a new search by the examining attorney to determine if there is a conflict with any registration or prior-filed application with a similar configuration or display of character names or terms, even if different from the character names in applicant's proposed mark.

outgoing").

⁹ See TSDR March 7, 2003 entry at p. 2.

As to the second proposed amended drawing, filed on December 16, 2008, applicant specifically states that this new proposed mark is in "standard character format without any claim to any particular font style, size or color."¹⁰ As the examining attorney argued in her appeal brief, converting the proposed stylized mark, including the columns of character names, to a single standard character mark "would result in [a mark] with a very different appearance and commercial impression from the [original proposed mark]." Brief, p. 20. In other words, should the amendment be allowed, the wording SHIMMERING BALLERINAS & DANCERS which appears prominently in the original proposed mark could possibly appear on equal footing, *i.e.*, the same font style and size, as the remaining literal elements consisting of character names, and thus lose its status as an element most likely to garner attention. Likewise, the column design could be deleted. We agree with the examining attorney's determination in this regard and find this proposed amendment constitutes a material alteration. See TMEP § 807.03(d) (Changing From Special Form Elements to Standard Characters).

¹⁰ See TSDR database entry dated December 16, 2008 ("response to Office action") at p. 2 for applicant's statement and drawing showing the proposed mark.

Finally, applicant's third attempt to amend the mark was filed on January 28, 2013, and depicts the same matter shown in the original drawing with the addition of a colorful background, stars, and rays of light emanating from the top left corner.¹¹ The additional elements constitute a material alteration inasmuch as they would clearly require an additional conflicting mark search by the examining attorney.

Accordingly, applicant's attempts to amend the drawing all would result in material alterations to the proposed mark, as originally filed, and thus are prohibited under Trademark Rule 2.72.

Decision: The examining attorney's refusal under Sections 1, 2 and 45 to register the proposed mark is affirmed; and the examining attorney's refusal to accept the various proposed amendments to the mark as applied-for also are affirmed.

¹¹ See TSDR database entry dated January 28, 2013 ("amended drawing").