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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application of: Taylor-Listug, Inc.
Mark: SIGNATURE
Serial Number: 76/357,740
Filed: January 10, 2002
Notice of Appeal Filed: May 7, 2003
Appellant's Brief Due: July 6, 2003



06-30-2003
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Commissioner of Trademarks
Box TTAB
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BRIEF FOR APPELLANT

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Dated: June 30, 2003

Theresa A. Nanzer

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§ 11:18 at page 481 (2d. Ed. 1984) 2

1 **I. INTRODUCTION**

2 Applicant hereby appeals from the Examining Attorney's refusal to register the above-
3 identified mark as was set forth in Final Office Action dated November 14, 2002, and respectfully
4 requests that the Trademark Trial Appeal Board reverse the Examining Attorney's decision. This
5 Brief is submitted in triplicate.

6
7 **II. MARK SOUGHT TO BE REGISTERED**

8 Applicant seeks registration on the Principal Register of its mark:

9 **SIGNATURE**

10 for musical instruments, namely, guitars in International Class 15.

11
12 **III. REJECTION**

13 The Examining Attorney, in the Office Action dated November 14, 2002, finally rejected
14 the present application arguing that: (I) the term "SIGNATURE" is merely descriptive of the
15 goods; (ii) that the specimens do not match the drawing page; and (iii) that the drawing cannot be
16 amended.

17
18 **IV. ISSUE**

- 19 1. Whether the mark SIGNATURE is merely descriptive of the goods.
20 2. Whether the specimen matches the drawing.
21 3. Whether the drawing could be amended to match the specimens.

22
23 **V. DESCRIPTIVENESS ARGUMENT**

24 **A. The Test for Descriptiveness**

25 A mark can be considered primarily merely descriptive "only" if considered in its entirety,
26 the mark conveys to the average member of the purchasing public an immediate impression of the
27 goods or services associated with the mark. Moreover, "[if] the mark clearly does not tell the
28 potential customer "only" what the goods [or services] are, their function, characteristics, use or

1 ingredients, then the mark is not "merely descriptive". In re Intelligent Medical Systems, Inc.,
2 5 USPQ2d 1674 1675 (TTAB 1987), citing McCarthy, Trademarks and Unfair Competition,
3 § 11:18 at page 481 (2d. Ed. 1984).

4 In order to be considered merely descriptive, the mark must convey an immediate
5 impression of the identified goods in the minds of consumers in the market in which those goods
6 are sold. In re Bright-Crest, Ltd., 204 U.S.P.Q. 591 (TTAB 1979). "If imagination or perception
7 is required for one to reach a conclusion about the nature of goods or services, the mark may be
8 suggestive but it is not descriptive." Manpower, Inc. v. Driving Force, Inc., 212 U.S.P.Q. 961, 963
9 (TTAB 1981). Hence, in order to establish that the Mark is descriptive, it must be established to
10 be more likely than not that the Mark conveys an immediate impression of the nature of
11 Applicant's goods or services to relevant consumers.

12 When a term is broad and includes many categories of goods or services, the term does not
13 convey an immediate impression of the "ingredients, qualities or characteristics" of the services or
14 goods in which it is used, and as such cannot be merely descriptive. In re Hutchinson
15 Technology, 7USPQ2d 1490, 1493 (Fed. Cir. 1988).

16 In deciding whether a mark is suggestive or merely descriptive, "doubt is resolved in favor
17 of Applicant in holding the term merely suggestive of Applicant's goods." In re Aid Labs., Inc.,
18 221 U.S.P.Q. 1215, 1216 (TTAB 1983).

19
20 B. The Mark "SIGNATURE" Does not Immediately Call to Mind the Applicant's
21 Guitars or a characteristic of the Guitars.

22 In the Office Action, the Examining Attorney suggests that the mark is descriptive because
23 the descriptive significance of the term "signature" as applied to guitars is indisputable noting that
24 the guitars might include a signature. The fact that the guitars might include a signature is not
25 dispositive. The question is whether seeing the mark SIGNATURE, the consuming public would
26 immediately believe there was a signature on the guitars. Applicant respectfully submits this
27 would not be the case.

28 Many times an item can be seen as an individual's signature item. Artists and musicians

1 are often known for signature items—none of which bear the written signature. Examples include
2 Clint Black's *signature* black hat and the musician Pink's *signature* pink hair. In view of this,
3 Applicant submits the mark SIGNATURE would simply be suggestive that the guitars in the
4 SIGNATURE series would be of a type that could be someone's *signature* item. There is no
5 evidence in the record that any consumers think that SIGNATURE series guitars have signatures
6 or that they are bought because they might have a signature.

7 The Examining Attorney also conducted a search through Nexis/Lexis' News database to
8 find if there were any stories having the word "signature" within 5 words of "guitars". This
9 analysis is inconclusive. From the excerpts it is impossible to determine why the guitars are
10 *signature* guitars. While they might have signatures, they just as easily could be a guitar someone
11 is known for or known to use—i.e., their *signature* item.

12 In order to be considered merely descriptive, the mark must convey a single immediate
13 impression of the identified goods in the minds of consumers in the market in which those goods
14 are sold. In re Bright-Crest, Ltd., 204 U.S.P.Q. 591 (TTAB 1979). Here, what is the single,
15 immediate impression. That it is someone's *signature* item? That it includes a signature? That it
16 is a signature that is being sold? The answer is that it is unclear. Any of these might be the case.
17 On the other hand, there is not a single thing that might come to mind. In this situation, it cannot
18 be said that there is evidence that there is a single immediate impression. Thus the term
19 SIGNATURE is not merely descriptive of guitars.

20 Moreover, to the extent "signature" suggests certain characteristics that Applicant's goods
21 possess, it does not do so with the requisite degree of particularity. See In re Warner Elec. Brake
22 and Clutch Co., 154 U.S.P.Q. 328,329 (TTAB 1967). Significant mental gymnastics are required
23 to make a connection between "signature" and the Applicant's guitars—thus a finding of
24 descriptiveness is inappropriate. Manpower, Inc. v. Driving Force, Inc., 212 U.S.P.Q. 961, 963
25 (TTAB 1981) ("If imagination or perception is required for one to reach a conclusion about the
26 nature of goods or services, the mark may be suggestive, but it is not descriptive.").

27 There is no question that there would be no immediate association between the mark and
28 the goods—effort would clearly be required. At a minimum, consumers would need to discard

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Dear Sir or Madam:

Enclosed for filing with the appeal papers for the above-referenced application are three copies of the Brief for Appellant. So that we may have a timely record of this filing, please date-stamp the enclosed stamped, self-addressed postcard and deposit it in the U.S. mail.

If there are any questions regarding the enclosed, please contact the undersigned attorney for the applicant.

Sincerely,

Peter K. Hahn
of
LUCE, FORWARD, HAMILTON & SCRIPPS LLP

PKH/tan
Enclosures

cc: Mr. Gary Correia (with enclosures)

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