

UNITED STATES PATENT AND TRADEMARK OFFICE

sw

SERIAL NO: 76/357740

SEP 9 2003

APPLICANT: Taylor-Listug, Inc.

CORRESPONDENT ADDRESS:

PETER K. HAHN
LUCE, FORWARD, HAMILTON & SCRIPPS LLP
600 WEST BROADWAY
SUITE 2600
SAN DIEGO, CALIFORNIA 92101

RETURN ADDRESS:

Commissioner for
Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514
ecom114@uspto.gov

MARK: SIGNATURE

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

Please provide in all
correspondence:

CORRESPONDENT EMAIL ADDRESS:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

RE: Serial Number 76/357740

09/10/2002 11:45

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Taylor-Listug, Inc. : **BEFORE THE**
Trademark: SIGNATURE : **TRADEMARK TRIAL**
Serial No: 76/357740 : **AND**
Attorney: Peter K. Hahn : **APPEAL BOARD**
Address: Luce, Forward, Hamilton & : **ON APPEAL**
Scripps, LLC
600 West Broadway
Suite 2600
San Diego, CA 92101

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed from the Trademark Examining Attorney's final refusal, pursuant to Section 2(e)(1) of the Trademark Act, to register the mark "SIGNATURE" on the ground that the mark is merely descriptive. Applicant has also appealed the final requirement for acceptable specimens indicating actual trademark use of the particular mark appearing in the drawing.

FACTS

Applicant has applied for registration of the mark "SIGNATURE" for "musical instruments, namely guitars." Since it appeared from the record developed during prosecution that a salient feature of the goods is their display of the signature(s) of well-known musicians or other celebrities, and since the evidence of record clearly established that similar items are commonly referred to as "signature" items within the relevant trade, final refusal of registration was issued on November 14, 2002, pursuant to Section 2(e)(1) of the Trademark Act.

Applicant has traversed the refusal by arguing essentially that the mark does not describe any salient characteristic of the goods with particularity and is, therefore, only suggestive as applied to the product.

The requirement for acceptable specimens evidencing actual trademark use of the term "Signature" was made final in the November 14, 2002 Office Action as well. Applicant has traversed this requirement by asserting that the original specimens are acceptable.

ARGUMENT

I. The mark "SIGNATURE" is merely descriptive as applied to the goods – guitars which bear the signature(s) of celebrities.

A mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP section 1209.01(b). Moreover, and apparently contrary to applicant's position, the question of whether a mark is merely descriptive must be determined in relation to the identified goods, not in the abstract. *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985).

Within the relevant context, it is respectfully submitted that the term "SIGNATURE" aptly describes both the specific nature and a salient characteristic of the applicant's goods, namely that they bear the signature of well-known musicians.

It is respectfully submitted that the various excerpts from recent periodicals made of record during publication clearly indicate that it is not uncommon within the relevant trade for manufacturers to offer models which bear the signature of a known musician or other celebrity, and that such items are referred to generically as "signature" models, due to the fact that they bear or display the signature. Thus, contrary to applicant's assertion, the term "signature" does far more than suggest that a particular model may be a "signature" type used by that person in the sense that he or she is known to regularly utilize the same or similar model, it directly states a salient characteristic of the goods – the display of a celebrity signature.

It is also noted that, based on the specimens of record, applicant's goods do, in fact display the signatures of musicians Jewel Kilcher and Robert Taylor. Accordingly, applicant's goods are, in fact, "signature" models, just as those mentioned in the periodical references cited earlier.

II. Applicant's arguments in support of registrability are unpersuasive.

Applicant has argued that the mark should be considered only suggestive as applied to the goods since the term "SIGNATURE" would not allow a potential purchaser to understand from the mark what the specific characteristics of the goods are. Applicant then cites an alternative significance of the term "signature" which it asserts dilutes the clearly descriptive significance of this term as applied to goods bearing a signature. This argument is unpersuasive and plainly ignores established precepts pertaining to the determination of descriptiveness.

The determination must be made from the viewpoint of the relevant public and must be made in specifically in relation to the identified goods, not in the abstract. *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (C.C.P.A. 1978); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985); *In re American Greetings Corp.*, 226 USPQ 365 (TTAB 1985). TMEP §1209.01(b). The fact that a term may have different meanings in another context is not controlling on the question of descriptiveness. *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). TMEP §1209.03(e).

Furthermore, it is not necessary that a term describe all of the purposes, functions, characteristics or features of the goods to be merely descriptive. It is enough if the term describes one attribute of the goods. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). Here, the proposed mark clearly denotes that the goods bear the signature(s) of a celebrity, in this case, musicians. It is also noted, in this regard, that applicant itself has recognized the known descriptive significance of the term "signature model" (in fact the specific wording which actually appears on the unacceptable specimens of record) within the relevant trade by disclaiming this terminology in its prior registration RN 2,252,080 "DAN CRARY SIGNATURE MODEL" (disclaiming "signature model") fo the same goods covered by the instant application, guitars. See: *In re Interco Inc.*, 29 USPQ 2d 2037 (TTAB 1993).

Applicant has suggested that the evidence of record is ambiguous in that it may be viewed as consistent with applicant's alternative definition of "signature" models which are of a type for which a given musician is noted. While it is noted that there is no basis for this suggestion, other than wishful thinking, it is further noted that one of the cited stories refers to a Dale Earnhardt Budweiser Signature guitar. Since this is an obvious reference to race driver Earnhardt and his Budweiser-sponsored car, it is respectfully suggested that applicant's alternative significance of a "signature" guitar model does not apply. Mr. Earnhardt is noted for his racing activities, rather than for a specific type of guitar. The term "signature" is clearly used here, and, it is respectfully urged, in the other references as well, to denote that the guitar bears the signature of a celebrity. This argument is deemed wholly unpersuasive.

Finally, applicant has also argued in favor of the alleged registrability of the term by referencing a list of third-party applications and registrations covering the term "signature". This listing was submitted for the first time in applicant's Appeal Brief. Initially, it is noted that the evidence is untimely under Trademark Rule 2.142(d). Moreover, even if the submission had been timely, the application/registrations have not been made properly of record through submission of copies of the registrations/application. It is well-established that the TTAB does not take judicial notice of third-party applications and registrations and applications residing in the PTO. See: *In re Smith and Mehaffey*, 31 USPQ 2d 1531 (TTAB 1994); *In re Duofold, Inc.*, 184 USPQ 638 (TTAB 1974). Accordingly, and since it is also clear that this type of evidence is of very limited value, even when properly submitted, since each case of descriptiveness must be determined on its own merits, this evidence, and any argument pertaining thereto, has been excluded from any consideration in the determination of registrability. See: *In re Nett Designs Inc.*, 57 USPQ 2d 1564 (Fed. Cir. 2001). It is respectfully requested that this evidence/argument also be excluded from the Board's consideration for the reasons noted above.

III. The Final requirement for substitute specimens is appropriate.

For a trademark application under §1(a) of the Trademark Act, the specimen must show the mark as used on or in connection with the goods in commerce. 37 C.F.R. §2.56(b)(1). In an application filed under §1(a) of the Trademark Act, the drawing of the mark must be a substantially

exact representation of the mark as used on or in connection with the goods or services, as shown by the specimens. 37 C.F.R. §§2.51(a)(1) and 2.51(b)(1).

In this case, the originally-filed specimens display the proposed mark only as part of the unitary, and merely informational, designation "signature model", which is deemed to present an overall different commercial impression, despite the fact, acknowledged by applicant, that the term "model" is informational, generic material, which may not be considered part of the mark. It is noted that informational matter, such as net weight and volume statements, lists of contents, addresses and similar matter, may ordinarily be deleted from a mark drawing. However, if it is truly part of a composite mark and the removal of this matter would alter the overall commercial impression such that its removal would change the commercial impression of the mark or make it unlikely to be recognized, the matter should remain on the drawing and be disclaimed. *See*: TMEP § 807.14 and 1213.03(b). However, as noted previously, the drawing may not be amended since a change to depict the mark as "Signature Model" was deemed to be a material alteration. Accordingly, it is respectfully suggested that the alternative requirement for submission of acceptable specimens evidencing actual trademark use of the term "Signature" alone was appropriate.

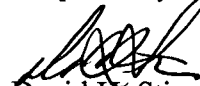
Moreover, even if it should ultimately be determined that the addition of "model" would not be a material alteration of the mark, and that a drawing amendment/disclaimer of "model" would be acceptable, it was further noted, in response to applicant's arguments, that the original specimen was also regarded unacceptable since it uses the entire designation "signature model" as a merely informational model designation. This issue was not formally raised as a basis for requiring the substitute specimens for two reasons: 1.) The application presented the mark as "Signature", rather than "Signature Model", and 2.) A formal holding that the specimen was unacceptable as failing to evidence actual trademark use was deemed moot in view of the fact that the specimen did not actually show use of the specific mark being applied for. However, should the Board consider permitting a drawing amendment in response to applicant's alternative arguments, it is respectfully requested that this issue be considered as well. It is clear that a specimen is not acceptable, despite being in the physical nature of a proper specimen, if the proposed mark, as displayed, therein is merely used, for example, as a trade name, an informational disclosure or otherwise not as a trademark. *See: Bookbinder's Sea Food House, Inc. v. Bookbinder's Restaurant, Inc.*, 118 USPQ

318 (Comm'r Pats. 1958); *I. & B. Cohen Bomzon & Co., Inc. v. Biltmore Industries, Inc.*, 22 USPQ 257 (Comm'r Pats. 1934). See TMEP §1202.01 regarding trade name refusals.

CONCLUSION

For the foregoing reasons, it is respectfully urged that the refusal to register the mark "SIGNATURE" on the ground that, as applied to applicant's goods, the term is merely descriptive thereof under Section 2(e)(1) of the Trademark Act, is proper and should be affirmed. It is also respectfully urged that the requirement for substitute specimens on the ground that those filed originally filed fail to evidence use of the specific mark being applied for is proper and should be affirmed.

Respectfully submitted,



David H. Stine

Trademark Attorney

Law Office 114 (703)308-9114 x154

Margaret Le

Managing Attorney