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Subject: U.S. TRADEMARK APPLICATION NO. 86629630 - 008709-60818 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86629630

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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: No Show Productions, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

008709-60818

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant, No Show Productions, LLC, seeks to register the design mark described as a photo realistic image of George Jones (application serial number 86629630) for "Distilled Spirits." The examining attorney refused registration of the Applicant's mark because the applied-for mark, as used on the specimen of record, (1) is merely a decorative or ornamental feature of the packaging for the goods; and (2) does not function as a trademark to indicate the source of applicant's goods and to

identify and distinguish them from others pursuant to §§1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127.

FACTS

The Sections 1, 2, and 45 Refusal was first issued in an Office action dated June 4, 2015, which also required that applicant show evidence that it has authorization from the estate of George Jones to register the mark. Applicant satisfied the authorization requirement in a response to the Office action dated July 1, 2015. On September 10, 2015, the examining attorney issued a Final Refusal based on Sections 1, 2, and 45. Applicant responded on December 3, 2015, by submitting a Request for Reconsideration that included a substitute specimen. This appeal of the Sections 1, 2, and 45 Refusal follows the examining attorney's Denial of Request for Reconsideration issued on February 17, 2016.

The sole issue on appeal is whether the applicant's mark functions as a trademark under Trademark Act Sections 1, 2, and 45.

OBJECTION TO NEW EVIDENCE

Applicant has submitted new evidence with its appeal brief. Applicant's "Exhibit B" includes a new digital image not previously made of record, specifically, the image labeled "George jones museum – Google Search." (May 3, 2016 Applicant's Brief, TSDR p. 3.) Applicant also references "application Reg. No. 4885165" in its brief, which was not previously submitted in the record nor otherwise attached to the Applicant's brief.

The record in an application should be complete prior to the filing of an appeal. 37 C.F.R. §2.142(d); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c). Because Applicant's new evidence was untimely submitted during an appeal, the trademark examining attorney objects to this evidence and requests that the Board disregard it. *See In re Fiat Grp. Mktg. & Corp. Commc'ns S.p.A*, 109 USPQ2d

1593, 1596 (TTAB 2014); *In re Pedersen*, 109 USPQ2d 1185, 1188 (TTAB 2013); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c).

ARGUMENT

APPLICANT'S MARK, AS USED ON THE SPECIMEN OF RECORD, FAILS TO FUNCTION AS A TRADEMARK TO IDENTIFY AND DISTINGUISH APPLICANT'S GOODS BECAUSE IT IS MERELY DECORATIVE OR ORNAMENTAL

The applied-for mark, as used on the specimen of record, is merely a decorative or ornamental feature of the packaging for the goods and, thus, does not function as a trademark to indicate the source of Applicant's goods and to identify and distinguish them from others. Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127; see *In re Villeroy & Boch S.A.R.L.*, 5 USPQ2d 1451, 1454 (TTAB 1987); TMEP §§904.07(b), 1202.03 *et seq.*

Section 45 of the Act defines a trademark as follows:

The term "trademark" includes any word, name, symbol, or device, or any combination thereof—

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act,

to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and *to indicate the source of the goods*, even if that source is unknown.

Trademark Act §45, 15 U.S.C. §1127 (emphasis added).

Mere intent that a word, design, symbol, or slogan function as a trademark, or the fact that such designation appears on the specimen, is not enough in and of itself to make it a trademark. A designation will not be registered unless purchasers would be likely to regard it as a source-indicator for the goods. See *In re Manco, Inc.*, 24 USPQ2d at 1941 (citing *In re Remington Prods. Inc.*, 3 USPQ2d at

1715); TMEP §1202. A device that is merely ornamentation does not function as a mark “to indicate the source of the goods” because it is merely a decorative feature on the face of the goods and, as such, does not function to identify the source of the goods. Here, the applicant’s use of the proposed mark is an ornament on applicant’s packaging for its distilled spirits, specifically, the mark is rendered on the front bottom half of the applicant’s vodka bottle.

A. THE LARGE SIZE AND PROMINENT LOCATION OF THE MARK ON THE SPECIMEN SHOWS MERELY ORNAMENTAL USE

The applied-for mark, as used on the specimen of record, would be perceived as merely a decorative or ornamental feature of the packaging for the goods because of the large size and location on a majority of the front half of the bottle¹. When evaluating a mark that appears to be ornamental, the size, location, dominance, and significance of the alleged mark as applied to the goods are all relevant factors in determining the commercial impression of the applied-for mark. *See, e.g., In re Hulting*, 107 USPQ2d 1175, 1177-79 (TTAB 2013); TMEP §1202.03(a). A small, neat, and discrete design feature may be likely to create the commercial impression of a trademark, whereas a larger rendition of the same matter emblazoned across the front of goods may be perceived merely as a decorative or ornamental feature. *In re Lululemon Athletica Can. Inc.*, 105 USPQ2d at 1689.

Although there is no prescribed method or place for affixation of a mark to goods or to the packaging of the goods, the location of a mark on the goods “is part of the environment in which the [mark] is perceived by the public and . . . may influence how the [mark] is perceived.” *In re Tilcon Warren Inc.*, 221 USPQ 86, 88 (TTAB 1984); *see In re Paramount Pictures Corp.*, 213 USPQ 1111, 1115

¹ Here, consideration is given to the applicant’s original specimen, as well as the substantially similar substitute specimen represented by the first two images on applicant’s December 3, 2015 Request for Reconsideration. (May 14, 2015, New Application Serial No. 86629630 TSDR p. 3; December 3, 2015 Request for Reconsideration, TSDR pp. 2-3, 7-8.) However, consideration is not given to the specimens displaying marks that do not match applicant’s drawing, which were also included in Applicant’s Request for Reconsideration. (December 3, 2015 Request for Reconsideration, TSDR pp. 4-6, 9-11.) These marks, included on pages 4-6 and 9-11 of applicant’s Request for Reconsideration, do not match because they exclude most of the shirt shown in applicant’s drawing, and they feature a hand, watch, and cigarette, all of which are not part of the applicant’s drawing. *See* 37 C.F.R. §2.51(a); TMEP §807.12(a).

(TTAB 1982). Thus, where consumers have been conditioned to recognize trademarks in a certain location, ornamental matter placed in a different location is less likely to be perceived as an indicator of source. See TMEP §1202.03(a), (b).

The evidence of record, summarized in detail below, shows decorative or ornamental use of portraits and similar designs placed broadly across the center front of bottles containing distilled spirits and other beverages. (September 2, 2015 Office action, TSDR pp. 2-54.) In these instances, as well as here, the designs or pictures are being used aesthetically as opposed to being indicators of the source of the goods.

In a representative sample from bonappetit.com, an image of the deceased well-known entertainer Elvis Presley is displayed broadly across the center front of a vodka bottle. (June 4, 2015 Office action, TSDR pp. 16-17; September 2, 2015 Office action, TSDR pp. 49-51.) As is the case with the bottles shown in applicant's specimen of record, the distilled spirit bottle here features a well-known deceased singer known for musical talent, rather than in association with developing or manufacturing distilled spirits. See also the evidence from nytimes.com recounting the life of George Jones. (June 4, 2015 Office action, TSDR pp. 18-27.) As suggested in the article from *Bon Appetit*, the point of purchasing the vodka product featuring an "appealing" image of Mr. Presley was obtaining the bottle itself, rather than the "questionably flavored spirit" inside of the bottle. (June 4, 2015 Office action, TSDR pp. 16-17; September 2, 2015 Office action, TSDR pp. 50-51.) As the author notes, Elvis Presley did not drink alcohol and there appears to be no clear connection between the "appealing" image of Mr. Presley on the bottle and the bottle's contents beyond, perhaps, the manufacturer's effort to "honor" the celebrity. (June 4, 2015 Office action, TSDR pp. 16-17; September 2, 2015 Office action, TSDR pp. 49-51.) (*Id.*) Similarly, the image of George Jones displayed on the applicant's specimen may be seen as a tribute to the late country singer, but bears no clear connection to the distilled spirits inside of the bottle and thus it would not be seen by consumers as identifying the source of the spirits.

Additional evidence shows similar portraits and designs displayed broadly across the center front of a bottle of alcohol. (September 2, 2015 Office action, TSDR pp. 2-54.) Particularly, with respect to evidence showing bottles featuring images of well-known people and celebrities that consumers recognize to be deceased, such as Marilyn Monroe, John Wayne, Paul Newman, William Shakespeare, and Elvis Presley, consumers will understand that these images do not show individuals who are developing or manufacturing new distilled spirits. (*See id.*) Instead, consumers seeing images displayed broadly across the front of a bottle will be likely to view the depictions as an aesthetic tribute or homage to the celebrity rather than as an identifier of source of the goods contained therein.

B. EVEN IF VIEWED AS INCIDENTALLY ORNAMENTAL, THE MARK FAILS TO FUNCTION BECAUSE IT LACKS DISTINCTIVENESS

Even if the mark, as used on the specimen of record, were considered to be only incidentally ornamental rather than merely ornamental, it still fails to function as a trademark because it is not inherently distinctive and lacks acquired distinctiveness. Matter that serves primarily as a source indicator, either inherently or as a result of acquired distinctiveness, and that is only incidentally ornamental or decorative, can be registered as a trademark. *In re Paramount Pictures Corp.*, 213 USPQ 1111, 1114 (TTAB 1982). However, in this case, applicant has made no claim of acquired distinctiveness and the mark, as used on the specimen of record, is not inherently distinctive.

In determining whether a proposed mark is inherently distinctive, the following factors are considered: [1] whether it is a common basic design, [2] whether it is not unique or unusual in the particular field, [3] whether it is a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods, or [4] whether it was capable of creating a commercial impression distinct from the accompanying words. *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 196 USPQ 289 (C.C.P.A. 1977). Although more commonly applied to product packaging trade dress applications, the

factors set forth in *Seabrook Foods* are applicable for design marks used on packaging. *See, e.g., In re F.C.F. Inc.*, 30 USPQ2d 1825 (TTAB 1994) (applying the *Seabrook* factors to find that a rose design used on cosmetic product packaging is not inherently distinctive). Further, if a mark satisfies any of the first three tests, it is not inherently distinctive. *In r Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681 (Fed. Cir. 2010) *citing* J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 8:13 (4th ed. 2008).

In the instant case, the evidence of record shows that the applicant's design, as shown on the specimen of record, is not unique or unusual as applied to distilled spirits, but instead represents a mere refinement of the commonly adopted and well-known form of ornamentation for distilled spirit bottles. As shown by the following table of evidence, celebrity portraits are commonly displayed across the center front of liquor bottles and are intended to show endorsement of the goods by that individual or to pay homage to the individual. Applicant's mere refinement includes a portrait of George Jones similarly displayed across the center front portion of the applicant's distilled spirit bottle. Because the subject matter shown in the applicant's specimen is not unusual, but rather a mere refinement of a commonly adopted and well-known form of ornamentation for a distilled spirits, consumers would not view the mark as a source indicator.

The following evidence of record shows that placement of celebrities on the front of liquor bottles is a well-known form of ornamentation:

1. Evidence from bonappetit.com (June 4, 2015 Office action, TSDR pp. 16-17; September 2, 2015 Office action, TSDR pp. 49-51) shows a vodka bottle featuring an image of Elvis Presley displayed broadly across the center front of the bottle. This evidence is particularly noteworthy in that, as is the case with the bottles shown in applicant's specimen of record, the distilled spirit bottle here also features a deceased well-known singer known for musical talent and not known for

being a source of distilled spirits. See also the evidence from nytimes.com recounting the life of George Jones. (June 4, 2015 Office action, TSDR pp. 18-27.)

2. Evidence from broudys.com (September 2, 2015 Office action, TSDR pp. 23-24) shows a bottle of vodka featuring a design of the celebrity Marilyn Monroe displayed broadly across the center front of the bottle.
3. Evidence from qualityliquorstore.com (September 2, 2015 Office action, TSDR pp. 6-7) shows a bottle of whiskey featuring a design of the celebrity John Wayne displayed broadly across the center front of the bottle.
4. Evidence from newmansownwines.com (September 2, 2015 Office action, TSDR pp. 16-17) shows wine bottles featuring the design of celebrity Paul Newman's face displayed broadly across the center front of the bottles.
5. Evidence from shakespeare-vodka.com (September 2, 2015 Office action, TSDR pp. 2-3) shows a bottle of vodka with a depiction of Shakespeare broadly displayed across the center front of the bottle.
6. Evidence from nbclatino.com (September 2, 2015 Office action, TSDR pp. 30-32) shows a bottle of tequila featuring a design of the deceased celebrity Jenni Rivera displayed broadly across the center front of the bottle.
7. Evidence from facebook.com (September 2, 2015 Office action, TSDR pp. 18-22) shows bottles of vodka featuring the design of a Pablo Escobar's face displayed broadly across the center front of the bottles.

8. Evidence from rondejeremy.com (September 2, 2015 Office action, TSDR p. 11-12) shows bottles of rum featuring designs of the face of celebrity Ron Jeremy displayed broadly across the center front of the bottle.

Beyond images of celebrities, ornamentation in the form of a variety of designs displayed broadly across the center front of bottles of distilled spirits is a common practice. As shown by the various additional examples below, not everything on the face of a bottle of distilled spirits is intended to indicate the source of the goods. In fact, a variety of ornamentation exists on liquor bottles, including artistic designs, scenic designs and comical images. (See September 2, 2015 Office action, TSDR pp. 9-10, 13, 26, 35-36, 38-39, 41-48.) Particularly, consumers commonly view images of celebrities and deceased celebrities on product packaging and view these images as indicating an endorsement of the product by the celebrity or as an homage or tribute to the celebrity. These consumers do not see these images as indicating the source of the identified goods because consumers are aware that these celebrities do not manufacture or distribute spirits or other types of alcohol.

The following evidence of record shows that placement of portraits and similar designs broadly on the front of liquor bottles is a well-known form of ornamentation:

1. Evidence from hotpenguin.com (September 2, 2015 Office action, TSDR pp. 26) shows bottles of vodka featuring designs of a woman's face displayed broadly across the center front of the bottles.
2. Evidence from bittersoldmen.com (September 2, 2015 Office action, TSDR p. 13) shows a beverage bottle featuring the design of a man's face displayed broadly across the front of the bottle.

3. Evidence from qualityliquorstore.com (June 4, 2015 Office action, TSDR pp. 2-4; September 2, 2015 Office action, TSDR pp. 35-36) shows a variety of distilled spirit bottles featuring ornamental use of portraits and similar designs placed broadly across the center front of the bottle. For example, the High West Vodka bottle features an image of a mountain scene broadly displayed across the center front of the bottle. (*Id.* p. 4.)
4. Evidence from liquorama.com (June 4, 2015 Office action, TSDR pp. 5-6; September 2, 2015 Office action, TSDR pp. 38-39) shows a variety of distilled spirit bottles featuring ornamental use of portraits and similar designs placed broadly across the center front of the bottle. For example, multiple Absolut Vodka bottles shown on the website feature artistic patterns and/or designs displayed broadly across the center front of the bottle. Further evidence from liquorama.com (September 2, 2015 Office action, TSDR pp. 9-10) shows bottles of distilled spirits featuring designs of women displayed broadly across the center front of the bottles.
5. Evidence from bestbuyliquors.com (June 4, 2015 Office action, TSDR pp. 7-14; September 2, 2015 Office action, TSDR pp. 41-48) shows a variety of bottles containing distilled spirits and featuring ornamental use of portraits and similar designs placed broadly across the center front of the bottle. For example, multiple Pinnacle Vodka bottles shown on the website feature artistic patterns and/or designs displayed broadly across the center front of the bottle. (June 4, 2015 Office action, TSDR pp. 11-14.)

The above-referenced evidence confirms that the proposed mark, as displayed on the specimen of record, fails to satisfy the *Seabrook* test for inherent distinctiveness. *See Seabrook Foods*, 568 F.2d 1342 (C.C.P.A. 1977). The evidence reveals that the display of celebrity portraits and other designs broadly across the center front of distilled spirit bottles is common, rather than unique, in the field of distilled

spirits. Further, the strong similarities between the examples shown in the record and applicant's use of the proposed mark indicates that the mark displayed on the specimen of record represents a mere refinement of a commonly adopted and well-known form of ornamentation for distilled spirits. Finally, given the common use of the picture or portrait of celebrities and deceased celebrities used on packaging for spirits, the use of the photograph of George Jones is not capable of identifying the source of the goods apart from the wording that accompanies it on the packaging for the goods. *See id.* Accordingly, the proposed mark, as displayed on the specimen of record, serves only as an ornamental and aesthetic embellishment of the goods in the form of a tribute to a popular entertainer, and not as a source indicator.

APPLICANT'S ALTERNATIVE POSITION

Applicant argues that the proposed mark "identifies a secondary source for services not set forth in this application." (May 3, 2016 Applicant's Brief, TSDR p. 4.)

To show that a proposed mark that is used on the goods in a decorative or ornamental manner also serves a source-indicating function, the applicant may submit evidence that the proposed mark would be recognized as a mark through its use with goods or services other than those being refused as ornamental. To show secondary source, the applicant may show: (1) ownership of a U.S. registration on the Principal Register of the same mark for other goods or services based on use in commerce under §1 of the Trademark Act; (2) ownership of a U.S. registration on the Principal Register of the same mark for other goods or services based on a foreign registration under §44(e) or §66(a) of the Trademark Act for which an affidavit or declaration of use in commerce under §8 or §71 has been accepted; (3) non-ornamental use of the mark in commerce on other goods or services; or (4) ownership of a pending use-based application for the same mark, used in a non-ornamental manner, for other goods or services. If

the applicant establishes that the proposed mark serves as an identifier of secondary source, the matter is registrable on the Principal Register.

The record, however, includes no such evidence to support applicant's secondary source claim. To the contrary, applicant has made no ownership claim with respect to a U.S. registration or pending application for the same mark. Further, the only relevant evidence of record showing applicant's use of portraits of George Jones on goods or services other than the identified "distilled spirits" was submitted by the examining attorney and reveals various different images of Mr. Jones in poses that are substantially dissimilar to the image shown in the applied-for mark. (February 17, 2016 Denial of Request for Reconsideration, TSDR pp. 2-5) For example, applicant's website shows a design of Mr. Jones on holiday ornaments where, unlike in the portrayal in the drawing, Mr. Jones is looking to the right, not wearing sunglasses, has short-cut hair, and is wearing a suit and holding a guitar. (*Id.* p. 2.) A second ornament for sale on applicant's website also substantially varies from the portrayal of Mr. Jones in the drawing, in part because he is wearing a white t-shirt and a jacket rather than a collared shirt, is smiling, and looking forward rather than to the left. (*Id.* p. 3.) Unlike the mark in the drawing, a t-shirt featured on applicant's websites shows Mr. Jones at a side-angle, without sunglasses, and holding a guitar. (*Id.* p. 4.) Further, a star-shaped ornament sold by the applicant displays an image of Mr. Jones that is significantly different from the image in the drawing in that it is a side-view of Mr. Jones riding a lawnmower. (*Id.* p. 5.)

All of these goods feature a design including George Jones displayed broadly across the front center of the goods. Therefore, these designs are ornamental as used and, even if they did match the mark shown on Applicant's drawing, they would not establish that the proposed mark functions as an indicator of secondary source. *See In re Astro-Gods Inc.*, 223 USPQ 621 (TTAB 1984). Accordingly, as no evidence of record supports applicant's position, the claim of secondary source should be rejected by the Board.

Further, applicant requests amendment to the Supplemental Register should the Board determine that the applied-for mark is not entitled to registration on the Principal Register. (May 3, 2016 Applicant's Brief, TSDR p. 4.) Should the applicant file a request to amend the application accordingly, the examining attorney agrees that the proposed mark should be allowed on the Supplemental Register.

CONCLUSION

The evidence of record shows that applicant's mark, as used on the specimen of record, is merely ornamental and, therefore, fails to function as a trademark to indicate the source of the identified goods. For the foregoing reasons, the refusal to register on the basis of §§1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127, should be affirmed.

Respectfully submitted,

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