

This Opinion is Not a
Precedent of the TTAB

Mailed: November 21, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board

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In re Imaginif, Inc.

—
Serial No. 86803751

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John S. Zanghi of Fay Sharpe LLP
for Imaginif, Inc.

Khanh M. Le, Trademark Examining Attorney, Law Office 116,
Christine Cooper, Managing Attorney.

—
Before Thurmon, Deputy Chief Administrative Trademark Judge, and Adlin and
Lynch, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Applicant Imaginif, Inc. seeks registration of the mark HICCUP, in standard
characters, for:

Live theatrical presentations; entertainment services in the nature
of live theater performances; entertainment services, namely,
providing nondownloadable prerecorded online theatrical
presentations; entertainment services, namely, live television
appearances by an entertainer; photography services; digital
imaging services; portrait photography; children's theatrical
services, namely, presentation of live show performances;
presentation of live show performances directed to children;
entertainment in the nature of theater productions, in
International Class 41.¹

¹ Application Serial No. 86803751, filed October 29, 2015 under Section 1(b) of the Trademark
Act, based on alleged intent to use the mark in commerce.

The Examining Attorney refused registration under Sections 1 and 45 of the Trademark Act on the ground that the specimens submitted in support of Applicant's Statement of Use do not show use of the mark in commerce. Specifically, the Examining Attorney found that the mark shown in the specimens does not "match" the mark shown in the application's drawing.² After the refusal became final, Applicant appealed and Applicant and the Examining Attorney filed briefs. We reverse.

I. The Specimens

Applicant submitted two specimens with its Statement of Use, the relevant portions of which are displayed below:



² The Examining Attorney originally issued, but later withdrew, two additional refusals: (1) HICCUP merely identifies character names and does not function as a service mark; and (2) the specimens do not show a "direct association" between the mark HICCUP and the identified services.

Mr. Kringle & Company

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The Hiccup Family

Surprise & delight guests with special appearances from the Hiccup family! Choose whether you'd like Rhubarb Hiccup, Sylvester Hiccup, Razberry Hiccup, Boyzenberry Hiccup or the whole Hiccup clan at your next event!



The perfect addition to any celebration:

- TV/Film/Radio Appearances
- Business/Store Promotions
- Community Happenings
- Live Performances
- Photography Shoots

Statement of Use filed November 3, 2017.

II. Arguments on Appeal

The Examining Attorney argues that the mark in Applicant's drawing, HICCUP in standard characters, is not a "substantially exact representation of the mark as used" in commerce as shown by the specimens, in violation of Trademark Rule 2.51(a). 6 TTABVUE 4. Specifically, in the first specimen, the term appears in a compound term ("Meet members of Kringle's® family in the **Hiccup Hangout**™."). *Id.* In the second specimen, the term appears in additional compound terms ("The Hiccup Family" and "the whole Hiccup clan"), and in character names ("Surprise and delight guests with special appearances from the Hiccup family! Choose whether you'd like Rhubarb Hiccup, Sylvestor Hiccup, Razberry Hiccup, Boyzenberry Hiccup or the whole Hiccup clan at your next event!"). *Id.* According to the Examining Attorney, in both specimens "[t]he mark 'hiccup' does not create a separate and distinct commercial impression from the words 'hangout,' 'family,' 'rhubarb,' 'Sylvestor,' 'Razberry,' 'Boyzenberry' or 'clan,'" *Id.* at 5. The Examining Attorney points out that in both specimens, HICCUP "is not physically or visually separated from these other words," and that it is also "conceptually integrated with these other words," in that it "conveys the meaning of a last name rather than its normal dictionary meaning." *Id.*

Applicant argues that the term HICCUP has a "separate and distinct commercial impression" apart from the other parts of the compound terms in which it appears, and that the term HICCUP is what distinguishes Applicant's services from those of

others. 4 TTABVUE 5-6. According to Applicant, the specimens reveal that HICCUP is used in a “variety of different ways” to identify different aspects of Applicant’s services, including meeting “members of Kringle’s® family in the **Hiccup Hangout™**,” where the Hiccup family spends time, and meeting the Hiccup family (or “clan”) itself, which consists of Rhubarb, Sylvestor, Razberry and Boyzenberry Hiccup. *Id.* at 5-7.

III. Analysis

The drawing of Applicant’s mark “must be a substantially exact representation of the mark as used on or in connection with the goods and/or services,” as shown by the specimens. Trademark Rule 2.51(a), 37 C.F.R. § 2.51(a). At the same time, however, because Applicant seeks registration under Section 1 of the Act, it “has some latitude in selecting the mark it wants to register,” and “may seek to register any portion of a composite mark if that portion presents a separate and distinct commercial impression which indicates the source of applicant’s goods or services and distinguishes applicant’s goods or services from those of others.” *In re 1175856 Ontario Ltd.*, 81 USPQ2d 1446, 1448 (TTAB 2006); *see also In re Chemical Dynamics Inc.*, 839 F.2d 1569, 5 USPQ2d 1828, 1830 (Fed. Cir. 1988) (in context of an attempt to register the “background portion” of a mark, holding that the applicant “must show that the portion sought to be registered creates a separate and distinct commercial impression, which thereby performs the trademark function of identifying the source of the merchandise to consumers”). Indeed, in appropriate cases we “may recognize the right to registration of one part of an owner’s mark consisting of two parts.” *In re Servel, Inc.*, 181 F.2d 192, 85 USPQ 257, 260 (CCPA 1950).

Here, we agree with Applicant that HICCUP in standard characters, the mark in the application's drawing, is a "substantially exact representation" of the mark as used on the specimens in connection with Applicant's entertainment and other services. In fact, while the specimens do not depict HICCUP alone, the terms with which the mark is used serve to highlight that the source-identifier in the specimens is the term HICCUP alone, notwithstanding that HICCUP appears with other terms.

For example, the term "hangout" in the composite HICCUP HANGOUT™ refers to the place where the HICCUP family spends time. 4 TTABVUE 10 (dictionary definition of "hangout" attached to Applicant's Appeal Brief); 6 TTABVUE 8 (different but substantively similar dictionary definition of "hangout" attached to Examining Attorney's Appeal Brief).³ Similarly, the term "family" in the composite HICCUP FAMILY refers to what HICCUP identifies, a family or "clan" named HICCUP. Finally, and in the same way, the terms "Rhubarb," "Sylvestor," "Razberry" and "Boyzenberry" merely identify by personal name individual members of the HICCUP clan.

We find that consumers encountering HICCUP as it is used in the specimens would view HICCUP as presenting a "separate and distinct commercial impression

³ Both Applicant and the Examining Attorney requested that we take judicial notice of dictionary definitions of "hangout," which indicate that when used as a noun, the term means a place where one spends time. We have done so. The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff'd*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *Threshold TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1038 n.14 (TTAB 2010).

which indicates the source of” Applicant’s services. In each instance, the specimens reveal that Applicant’s services are provided by the HICCUP family/clan or its members, whether the services are provided in the HICCUP HANGOUT or elsewhere, and whether the services are provided by Rhubarb, Sylvestor, Razberry and Boyzenberry HICCUP all together, individually, or in some other combination. As the second specimen proclaims: “Choose whether you’d like Rhubarb Hiccup, Sylvestor Hiccup, Razberry Hiccup, Boyzenberry Hiccup or the whole Hiccup clan at your next event!” Thus, a consumer encountering the specimens would recognize HICCUP, used in a number of ways, as making its own commercial impression as a source indicator.

Our decision here is consistent with a number of analogous cases. *Institut National Des Appellations D’Origine v. Vintners Int’l Co.*, 958 F.2d 1574, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992) (affirming Board’s finding that CHABLIS WITH A TWIST is not a mutilation of the mark that was actually used, CALIFORNIA CHABLIS WITH A TWIST); *In re Royal BodyCare, Inc.*, 83 USPQ2d 1564 (TTAB 2007) (reversing refusal to register NANOCEUTICAL where specimen displayed term “embedded in the phrase RBC’S NANOCEUTICAL”); *In re Raychem Corp.*, 12 USPQ2d 1399 (TTAB 1989) (reversing refusal to register TINEL-LOCK for metal rings for attaching a cable shield to an adapter where mark as used on the specimens was TRO6AI-TINEL-LOCK-RING); *In re Berg Elecs., Inc.*, 163 USPQ 487 (TTAB 1969) (reversing refusal to register GRIPLET where specimen showed use of BERG GRIPLET); *In re Emco, Inc.*, 158 USPQ 622, 623 (TTAB 1968) (reversing refusal to

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register RESPONSER where specimen depicted use of MEYER RESPONSER, where “Meyer” was the name of the applicant’s president and inventor of the devices for which the mark was used); *In re Dempster Brothers, Inc.*, 132 USPQ 300 (TTAB 1961) (reversing refusal to register DUMPMMASTER based on specimen depicting mark as DEMPSTER DUMPMMASTER in stylized form).

IV. Conclusion

Because HICCUP creates a separate and distinct commercial impression as used in Applicant’s specimens, it identifies the source of Applicant’s services to consumers, and the specimens are therefore acceptable.

Decision: The refusal to register Applicant’s mark because the specimens do not show use of HICCUP in commerce as a mark for Applicant’s services is reversed.