

This Opinion is Not a
Precedent of the TTAB

Oral Hearing: June 4, 2019

Mailed: June 17, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re The Artsmiths, LLC

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Serial No. 87151770

Byran H. Opalko of Buchanan, Ingersoll & Rooney PC,
for The Artsmiths, LLC.

April Reeves, Trademark Examining Attorney, Law Office 124,
Lydia Belzer, Managing Attorney.

—
Before Cataldo, Wellington, and Dunn,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

The Artsmiths, LLC (“Applicant”) seeks registration on the Principal Register of
the following, proposed stylized mark:



for “retail store services featuring handmade artisan products in the nature of
original artwork in a wide variety of mediums; online retail store services featuring

handmade artisan products in the nature of artwork in a wide variety of mediums,” in International Class 35.¹

The Trademark Examining Attorney has refused registration of Applicant’s proposed mark on the ground that it fails to function as a mark for the services identified in the application, pursuant to Sections 1, 2, 3, and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052, 1053, and 1127.

When the Examining Attorney made the refusal final, Applicant appealed. Applicant and the Examining Attorney filed briefs and both sides presented oral argument during a hearing held on June 4, 2019. We affirm the refusal to register.

I. Failure to Function as a Mark

It is axiomatic that an applied-for mark will be refused registration if it does not function as a source-identifier because “[b]efore there can be registration, there must be a trademark.” *In re Roberts*, 87 USPQ2d 1474, 1478 (TTAB 2008) (quoting *In re Bose Corp.*, 546 F.2d 893 , 192 USPQ 213, 215 (CCPA 1976)); *see also D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d 1710, 1716 (TTAB 2016).

¹ Application Serial No. 87151770 was filed on August 26, 2016 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), on the basis of Applicant’s claim of a bona fide intent to use of the proposed mark in commerce. The proposed mark was published for opposition and Applicant filed its Statement of Use (SOU), under Section 1(d) of the Trademark Act, 15 U.S.C. § 1051(d), on the basis of Applicant’s claim of a first use of the proposed mark anywhere and in commerce on August 1, 2016. The refusal to register the mark for failure to function as a mark was raised after the filing of the SOU. See Trademark Manual of Examining Procedure § 1202 (2018) (“TMEP”) (“Therefore, unless the drawing and description of the mark are dispositive of the failure to function without the need to consider a specimen, generally, no refusal on this basis will be issued in an intent-to-use application under §1(b) of the Trademark Act, 15 U.S.C. §1051(b), until the applicant has submitted a specimen(s) with an allegation of use (i.e., either an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d)).”).

A "service mark" is defined as any word, name, symbol, or device, or any combination thereof—

(1) used by a person ...

(2) to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown. ...

Section 45 of the Trademark Act, 15 U.S.C. § 1127.

Section 2 of the Trademark Act, 15 U.S.C. § 1052 provides that, absent a specified prohibition within the section, any “trademark” may be registered on the Principal Register so long as it functions as a trademark, i.e., it indicates source:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless ...

With the above in mind, it is clear that not every word or symbol which appears in connection with an entity's services functions as a service mark. *In re Safariland Hunting Corp.*, 24 USPQ2d 1380, 1381 (TTAB 1992); *In re Remington Prods. Inc.*, 3 USPQ2d 1714, 1715 (TTAB 1987). Rather, as we explained in a recent decision:

. . . a threshold issue in some cases (like this one) is whether the phrase in question in fact functions to identify the source of the services recited in the application and distinguish them from the services of others or, instead, would be perceived merely as communicating the ordinary meaning of the words to consumers.

In re Wal-Mart Stores, Inc., 129 USPQ2d 1148, 1152 (TTAB 2019). In *Wal-Mart*, the Board held that the phrase INVESTING IN AMERICAN JOBS would be perceived by consumers as “merely an informational statement” because it is one that “would ordinarily be used in business or industry, or by certain segments of the public

generally, to convey support for American-made goods.” *Id.*; see also *In re Remington Prods., Inc.* , 3 USPQ2d 1714, 1715-16 (TTAB 1987) (holding PROUDLY MADE IN USA not registrable for electric shavers because the mark would be perceived merely as a common message encouraging the purchase of domestic- made products).

The Examining Attorney, here, asserts that “because consumers are accustomed to seeing ‘I [heart] PGH’ and ‘PGH ART’ (and minor variations) commonly used in everyday speech by many different sources, consumers would not perceive [the proposed mark] as a mark identifying the source of applicant’s services,” and thus consumers will view the mark as “as only conveying an informational message, specifically, a message of enthusiasm or support for artists and the arts scene in Pittsburgh.”² In support, she submitted evidence showing various third parties using the expression “I [a heart shape] PGH,” as well as evidence that the city of Pittsburgh has a known arts scene.³ Some examples include:

² 6 TTABVUE 8.

³ Attached to Office Actions issued on September 10, 2017 and April 10, 2018.

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I (HEART) PITTSBURGH - BLACK

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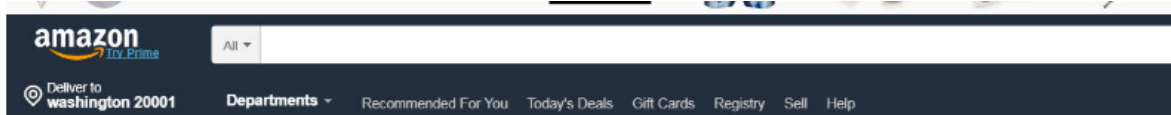
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⁴ Office Action issued on September 10, 2017, at TSDR p. 3.

⁵ Office Action issue on April 10, 2018, at TSDR pp. 73.



The record clearly shows that use of “I [heart-shaped designed] PGH” will be clearly understood as an expression of support for the city of Pittsburgh. Indeed, a website called “I[heart]PGH” (www.iheartpgh.com) exists and describes itself as a blog that “was started as a way to share all of the great stuff happening here in Pittsburgh.”⁷

The evidence also reflects that the city of Pittsburgh has a known, thriving arts community. An article “Study looks at Pgh’s arts ‘ecosystem,’” from the Pittsburgh Courier discusses the “state of the arts in Allegheny County” and Pittsburgh region;⁸ and a website expressing the opinion that when it comes to “sports, art, food or music,

⁶ Id., TSDR p. 84.

⁷ Id., TSDR p. 61.

⁸ Id., TSDR p. 17-20.

Pittsburgh has so much to offer.”⁹ Third-parties use the term “PGH Art(s)” as a reference to the Pittsburgh arts community.¹⁰

Applicant acknowledges the aforementioned evidence of third-party use of “I [heart] PGH” and “I [heart] Pittsburgh,” as well as that of “Pgh Art” and “Pittsburgh Art,” in various formatives.¹¹ However, Applicant points out that the Examining Attorney “found absolutely no use” of “I [heart] PGH ART” or “I [heart] Pittsburgh Art.”¹² Applicant concludes that this “proves that Applicant’s mark ... is not only not in common use, but it is not used at all in any formative, let alone the specific stylized logo form applied for by Applicant.”¹³

The fact that there is no evidence of third-party use of Applicant’s proposed mark is not determinative as to how the public will perceive the phrase. The evidence shows that “I [heart] PGH” is a fairly common phrase that will be immediately understood as merely expressing an affinity for the city of Pittsburgh. The addition of ART to this phrase merely extends or narrows this expression of support to the Pittsburgh art scene. The evidence also shows Pittsburgh has a celebrated arts community that is sometimes referred to as “PGH ART(S)” – thus the phrase “I [heart] PGH ART” will be perceived as a pronouncement of admiration for that community. In the context of Applicant’s retail store services featuring the sale of handmade artwork that includes

⁹ Id., TSDR p. 69.

¹⁰ See, *e.g.*, Id., TSDR p. 39.

¹¹ 7 TTABVUE 4.

¹² Id.

¹³ Id.

works from artisans of Pittsburgh, consumers' previous exposure to "I [heart] PGH" and "PGH ART(S)" will predispose them to viewing the proposed mark "I [heart] PGH ARTS" as merely an expression of the store's support for the Pittsburgh arts community.

Applicant asserts that it displays its "logo" in a "conspicuous location where it is readily noticed by consumers ... as a source identifier of Applicant's retail store services."¹⁴ Applicant's proposed mark appears in the bottom left corner of the specimen (described as a "brochure" in Applicant's statement of use):

¹⁴ 7 TTABVUE 3.



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However, we agree with the Examining Attorney’s analysis that the “placement [of “I [heart] PGH ART”] on the specimen enhances the perception of the applied-for mark as informational because the mark is removed from the description of applicant’s retail services, and more closely associated with written matter that gives information about the arts and cultural center as a whole.”¹⁶ That is, consumers viewing the proposed mark and the adjoining wording (“Shop local. Shop Pittsburgh. Shop Handmade.”) in conjunction with the entirety of specimen are likely to “see the

¹⁵ Specimen filed with Statement of Use on July 25, 2017.

¹⁶ 6 TTABVue 9.

applied-for mark as an additional element of informational matter about the arts and cultural center, namely, as a message of enthusiasm or support for the Pittsburgh art and Pittsburgh artists featured in the center.”¹⁷

Finally, we note Applicant’s reliance on 29 third-party registrations that it submitted showing registration of marks comprising “I [heart]” and additional matter.¹⁸ Over half these registrations involve the mark “I [heart] NY” and are owned by the New York State Department of Economic Development, a state governmental agency, and a small number of those registrations are based on acquired distinctiveness. We further note that many of the other registrations contain additional matter, e.g., a design of a hot dog, a design of a pretzel, a fanciful chef, etc., that could help distinguish those marks from being viewed as merely informational slogans of support. In contrast, we hasten to point out that the font or style of lettering employed in Applicant’s proposed mark is hardly unique, not particularly distinctive, and certainly does not create a separate commercial impression. In any event, as the Examining Attorney pointed out, we have long held and it is well settled that each case must be decided on its own facts and record; when it comes to questions of fact, the Board cannot be bound by prior decisions that involved different records. *See In re Nett Designs, Inc.*, 236 F. 3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); *In re Datapipe, Inc.*, 111 USPQ2d 1330, 1336 (TTAB 2014).

¹⁷ Id.

¹⁸ Attached to Applicant’s response filed

Ultimately, based on the record in this case, Applicant's proposed mark fails to function as a service mark; it will not act to indicate the source of Applicant's retail store services and distinguish them from those of others. Rather, it will be perceived by customers as a merely a slight variation of common phrase expressing support that, more specifically, indicates an affinity for the city of Pittsburgh arts community.

Decision: The refusal to register is affirmed.