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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Fetal Fotos, Inc.

Serial Nos. 75825851 and 75825852

Peter M. de Jonge and Nathan S. Winesett of Thorpe North & Western, LLP for Fetal Fotos, Inc.

Paula B. Mays, Trademark Examining Attorney, Law Office 102 (Thomas Shaw, Managing Attorney).

Before Chapman, Bucher and Holtzman, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Fetal Fotos, Inc. seeks registration on the Supplemental Register of the mark FETAL FOTOS for goods identified, as amended, as "pre-recorded videocassettes featuring photographic images of a fetus" in International Class 9 and

"photographic prints of images of a fetus"[1] in International Class 16, as well as services recited as "providing visual images of a fetus through ultrasound,"[2] in International Class 42.

Inasmuch as both of these applications involve common questions of law and fact, and each has been treated in substantially the same manner by the applicant and by the Trademark Examining Attorney, we have consolidated these two appeals by issuing a single decision.

The Trademark Examining Attorney issued final refusals to register in both applications, under Section 23 of the Trademark Act, 15 U.S.C. §1091, on the ground that applicant's mark is incapable of identifying and distinguishing its goods and services, *i.e.,* that FETAL FOTOS is a generic name for the identified goods and recited services.

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[1] Application Serial No. 75825851, a combined class application for these two classes of goods, was filed on October 18, 1999 for registration on the Principal Register, based upon applicant's allegation of use anywhere at least as early as February 21, 1994 and use in commerce at least as early as March 29, 1994. On April 19, 2001, applicant amended its application to seek registration on the Supplemental Register.

[2] Application Serial No. 75825852 was filed on October 18, 1999 for registration on the Principal Register, based upon applicant's allegation of use anywhere at least as early as February 21, 1994 and use in commerce at least as early as March 29, 1994. On April 19, 2001, applicant amended its application to seek registration on the Supplemental Register.

Applicant has appealed in both applications. Both applicant and the Examining Attorney have filed briefs and both appeared at an oral hearing held before the Board.

We affirm the refusals to register.

As a preliminary matter, we note that applicant has amended both applications to seek registrations on the Supplemental Register. Accordingly, while the briefs of applicant and of the Trademark Examining Attorney continue to argue the issue of mere descriptiveness and the factual question of acquired distinctiveness, we find that the sole issue before us is whether this term is generic, and hence incapable of registration on the Supplemental Register.

With respect to the question of genericness, applicant is correct in pointing out that the Office has the burden of proving genericness by "clear evidence" thereof. *In re Merrill, Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be registered to refer to the category or class of goods or services in question. *In re Women's Publishing Co. Inc.*, 23 USPQ2d 1876, 1877 (TTAB 1992). Our primary reviewing court has set forth a two-step inquiry to determine whether a mark is generic: First, what is the category or class of goods at issue?

Second, is the term sought to be registered understood by the relevant public primarily to refer to that category or class of goods or services? *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986).

Addressing the first part of the *Ginn* genericness inquiry, we find that the genus of goods or services at issue in this case is the picture or photo of a fetus created by ultrasound imaging (or sonography). Clearly, there may be more than one "name" for a product or service. Accordingly, the instant record shows, and applicant does not dispute, that there are many permutations of these words, all of which may serve as generic designations for these keepsake products and the service that provides them (e.g., ultrasound image, ultrasound picture, sonogram picture, fetal image, fetus photo, fetal picture, etc.).

We turn next to the second part of the *Ginn* genericness inquiry: whether the matter applicant seeks to register, FETAL FOTOS, is understood by the relevant public primarily to refer to the genus of goods and services at issue, i.e., videocassettes and photographic prints of images of a fetus and the service of providing these visual images through ultrasound.

The Trademark Examining Attorney contends that “[i]n the present case, the class of services herein are [sic] exactly what the proposed mark indicates, photographs of fetus [sic].” The Trademark Examining Attorney argues, further, that “fotos” is phonetically identical to “photos” and, thus, applicant’s mark is essentially identical to “fetal photos”; and that “fetal photos” is the generic name for a category or genus of goods and services which includes applicant’s photographic prints and videocassettes featuring photographic images of a fetus as well as providing visual images of a fetus through ultrasound.

By contrast, applicant argues that the Trademark Examining Attorney has not sustained her burden of proof. Applicant contends that the evidence does not show any generic use of its specific mark, FETAL FOTOS; that the dictionary definitions do not show a common understanding of applicant’s goods and services as recited; and that contrary to the contentions of the Trademark Examining Attorney, this record proves that its claimed mark would be perceived as a source identifier.

In support of her position, the Trademark Examining Attorney submitted dictionary definitions, excerpts from Internet websites, as well as excerpts from articles found in

the LEXIS/NEXIS database.[3] These hits included use of the term "fetal photo" and "fetus photo," such as the following:

> HEADLINE: "Baby Pictures: A ***Fetal Photo***, or a Little Home Movie of Baby Within the Womb?"
> *The State* (Columbia, SC), March 4, 2001.
>
> .oOo.
>
> HEADLINE: "Technology gives 'baby pictures' a 3-D image"
>
> > Atlanta Perinatal purchased its first machine in 1999, and began advertising its ***fetal photo*** service late last year. For about $200 the practice offers any pregnant woman – whether a patient of the practice or …
>
> *The Atlanta Journal and Constitution*, May 30, 2001.
>
> .oOo.
>
> HEADLINE: "'9 Months,' The birth of a publication for moms-to-be"
>
> > … nine-months-pregnant beauty revels in one sequence of photos and Lennart Nilsson's justly famous 1965 developing ***fetus photos*** are reprinted. While the text seems alive to the mysteries of birth and renewal, the tone is refreshingly subdued…
>
> *USA Today*, December 14, 1989.
>
> .oOo.
>
> HEADLINE: "Artist's style catches eyes at arts council show"
>
> > … Lezlie Culberson invites viewers to journey back to the womb in her three-

[3] It is true that many of the LEXIS/NEXIS excerpts refer to the use of unsettling pictures of aborted fetuses used by anti-abortion protestors – not the products of the fetal keepsake photography and video industry. However, the fact that the technology and purpose behind these reported incidents are far removed from applicant's goods and services does not defeat the value of the remaining usages that are clearly germane to applicant's commercial enterprise.

> dimensional panels veneered with textural ***fetus photographs***….
>
> *The Virginian-Pilot* (Norfolk, VA), May 4, 1997.

.oOo.

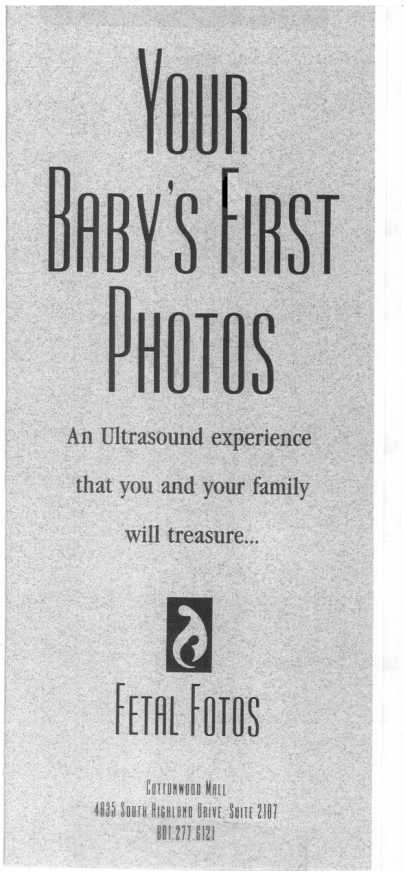
> HEADLINE: "Mountain Bikes, Microbrews and Baby Clues"
>
> One truly bright spot is the use of the famous ***fetus photos*** from Lennart Nilsson's book, "A Child is Born," wherein an obstetrician appears in utero to point out fascinating fetal …
>
> *The San Francisco Chronicle*, July 9, 1995.

Yet, throughout the prosecution of these applications, applicant has repeatedly argued that "fetal photos" has not been shown to be a term used to describe its goods and services. However, in addition to the LEXIS/NEXIS excerpts reproduced above, according to an article that appeared as a source document in several different webpages placed into the record by the Trademark Examining Attorney, it appears that in the world of photography, the term "fetal photography" is now a term of art. *See e.g.*, "Shooting the Mother: Fetal Photography and the Politics of Disappearance," *Camera Obscura* 28, Winter 1993, Duke University Press.[4]

Applicant argues that a photograph is not the equivalent of ultrasound imaging. However, the application listing goods

[4] This is a U.S. publication cited in several different webpages, including that of http://www.arts.ualberta.ca/%7Ejwilliam/wom&photo.htm.

herein uses the terms “photographic images” and “photographic prints” in the identifications of goods. Moreover, applicant uses the terminology in the specimens of record in these applications. In its brochure (reduced in size as reproduced below), applicant describes the “30 minute ultrasound session” as an experience that provides the expectant mother the opportunity to take home four still *photographs* of her unborn child – her “Baby’s First Photos”:



However, applicant argues that the website and specimens of record do not support the conclusions drawn by the

Trademark Examining Attorney, and that "Your Baby's First Photos" is itself used as a trademark:

> The Examining Attorney also attempts to use phrases produced from Applicant's website to show generic usage. The phrase, "Fetal Fotos offers expectant parents a chance to record an ultrasound picture of their unborn child," uses the phrase "ultrasound picture." This term has no bearing on the issue of genericness for Applicant's mark. An ultrasound picture is indeed a generic term. A picture is not necessarily a photograph, since it is not limited to images created by photography. The phrase, "Your baby's first photos," is indeed used as a trademark. No one actually thinks Applicant is providing a photograph of a living fetus. Rather, the phrase is suggestive of Applicant's goods and services because it requires the imagination, thought, and perception for consumers to reach a conclusion as to the nature of Applicant's services [cite omitted].

(Applicant's reply brief, p. 6)

The Trademark Examining Attorney has placed a variety of articles in the record that discuss the underlying technology. These excerpts show that ultrasound imaging is a common medical diagnostic procedure that uses high-frequency sound waves to produce dynamic images (sonograms). In medical settings, prenatal ultrasound examinations are performed by trained professionals, such as sonographers, radiologists or obstetricians. For example, obstetricians use ultrasound at a very low power level to check the size, location, number, and age of fetuses, the presence of some types of birth defects,

fetal movement, breathing, and heartbeat. The procedure involves using a transducer, which sends a stream of high-frequency sound waves[5] into the body and detects their echoes as they bounce off internal structures. The sound waves are then converted to electric impulses, which are processed to form an image displayed on a computer or video monitor. In applicant's brochure, it refers to a "large 19 inch television screen." It is from these images that computer printouts, videos and portraits are made.

While applicant's underlying 3-D sonography is quite similar to that performed by a radiologist or obstetrician, applicant's goods and services represent the extension of fetal imaging technology from the field of diagnostic medicine to the keepsake industry:

> An ultrasound is generally used as a diagnostic tool in the practice of medicine to determine the health of a fetus. However, applicant provides the services of using this diagnostic tool to present the consumer with a memorable ultrasound image of the unborn baby, which the consumer can preserve as a keepsake. In order for a consumer to determine the nature of Applicant's goods and services, the consumer must perceive the common use of photographs to preserve as a keepsake a memorable picture of a person to view on future occasions. Then, the

[5] In answering the question of "What is ultrasound?," applicant's brochure says these are "low frequency sound waves." The rest of the record suggests that applicant would be more accurate in its attempts to reassure potential customers by touting these goods and services as involving *low*-levels of *high*-frequency sound waves.

> consumer must imagine preserving an ultrasound image for the same purpose, even though ultrasound images are typically diagnostic tools. The consumer must also imagine the ultrasound image being framed for display in a similar fashion as photographs. In other words, Applicant's mark suggests to consumers another purpose of an ultrasound image besides use as a diagnostic tool. It suggests that Applicant provides goods and services related to providing decorative keepsakes for preserving an image of an unborn child.

(Applicant's reply brief, p. 9)

Applicant argues that given the definitions of a "photo" placed into the record, its images cannot be seen as photos:

> … [T]he definition provided by the Examining Attorney clearly defines a photo and a photograph as an "image that has been produced on photosensitive film or paper by the process of photography." Ultrasound images, however, are produced by ultrasonic sound waves and are not produced on photosensitive film or paper by the process of photography. Accordingly, ultrasound images are not "photos."

(Applicant's reply brief, p. 3)

We find this particular argument disingenuous. While the sound waves are converted to electric impulses, which are in turn processed to form an image on an ultrasound monitor, a picture quality printout of this image will be perceived by consumers as a "photo" as surely as would other graphic images printed out from any such peripheral device.[6] *See* LEXIS/NEXIS

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[6] In its appeal brief, applicant has offered to amend the identifications of goods in application Serial No. 75825851 to

(this note is continued on the next page)

stories submitted by the Trademark Examining Attorney, for example, "A Mother's Day Sampler – Expectant mothers' new show and tell: ultrasound snapshot," *St. Petersburg Times*, May 10, 1987.

Applicant concedes that the word "photos" is suggestive or, at worst, merely descriptive, of applicant's goods and services but contends that it is not their generic designation. However, as we have seen, applicant's brochure uses the word "photo" repeatedly, as does applicant's own webpage (e.g., "… the best still 3-D ***photo*** results come when baby is asleep or still." www.fetalfotosusa.com/faq.html (***emphasis supplied***).

We find that applicant is in the business of obtaining and providing fetal portraits or videos. Applicant's brochure and webpages are consistent with the evidence the Trademark Examining Attorney has placed into the record that a photograph is often the result of an ultrasound examination of

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replace the word "photographic" with the term "ultrasonographic." Consistent with our understanding of the underlying technology and the most precise terminology for the identifications of goods herein, it may well be accurate to do this in the International Class 9 identification (so that it would be "pre-recorded videocassettes featuring ultrasonographic images of a fetus") but not with the International Class 16 identification where the word "photographic" correctly modifies the resulting paper product – not the source image. In any case, this proposed amendment was not timely proffered, and even if it had been timely offered and accepted by the Trademark Examining Attorney, it would not change the result herein.

an unborn child in utero – and especially when this technology is used for entertainment.[7]

Alternatively, applicant argued in its brief and at the oral hearing that even if we should determine that the term "fetal photos" is generic for applicant's goods and services, it does not follow that applicant's mark FETAL FOTOS is similarly generic. Applicant argues that the Trademark Examining Attorney has failed to show that members of the relevant public will perceive this misspelled term as the generic equivalent of "Fetal Photos." Furthermore, as to the impact of applicant's adopting as its mark this misspelled term, applicant argues that it is most relevant that fifty-three of its customers executed declarations evidencing the distinctiveness of the FETAL FOTOS term. Applicant argues that the Trademark Examining Attorney has not countered this evidence and that she has failed "to show that the relevant consuming public principally perceives the mark FETAL FOTOS as

[7] "Journey to birth – Second Trimester; weighing the risks, benefits, of testing," *Star Tribune* (Minneapolis, MN), June 11, 2001; "Health passes from Mom to Child," *Albuquerque Journal*, May 13, 2001; "Baby Pictures: A Fetal Photo, or a Little Home Movie of Baby Within the Womb?" *The State* (Columbia, SC), March 4, 2001; "Baby's First Picture," *The Macon Telegraph*, December 4, 2000; "Women buy Sonograms when Insurers Won't," *The Dayton Daily News*, January 6, 1994.

the generic equivalent of ‘fetal photos’ ….” (Applicant’s reply brief, p. 7)

However, the Trademark Examining Attorney is neither equipped nor compelled to conduct a survey to demonstrate how the relevant consuming public principally perceives this particular term. Under our precedent, we note that applicant’s use of a misspelling does not require a contrary conclusion. That is, applicant should not be able to obtain a registration for a generic term merely by using a misspelling. *See*, J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §12:38 (4th ed. June 2001).

In conclusion, we find that FETAL FOTOS names applicant’s identified goods and services and is, therefore, generic and incapable of registration on the Supplemental Register.

Decision: The refusals to register under Section 23 of the Act are hereby affirmed.