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Paper No. 13
Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re *The Children's Museum of Indianapolis, Inc.*

Serial No. 76269506

Joseph D. Lewis of Barnes & Thornburgh for *The Children's Museum of Indianapolis, Inc.*

Catherine Pace Cain, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Chapman, Bottorff and Rogers, Administrative Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

On June 11, 2001, applicant filed the above-captioned application seeking registration on the Principal Register of the mark **Y-?** (in typed form) for goods identified in the application as "publications, namely, a newspaper column consisting of articles of general interest by children, teenagers and young adults," in Class 16. The application is based on applicant's allegation of use of the mark in

commerce, under Trademark Act Section 1(a), 15 U.S.C. §1051(a), and January 2000 is alleged in the application as the date of first use of the mark anywhere and the first use of the mark in commerce.

At issue in this appeal is the Trademark Examining Attorney's final refusal to register the mark absent applicant's submission of an acceptable specimen showing use of the mark on the goods identified in the application. See Trademark Act Section 1(a)(1), 15 U.S.C. §1051(a)(1), and Trademark Rule 2.56, 37 C.F.R. §2.56.¹ The appeal has been fully briefed, and an oral hearing was held on March 9, 2004 at which applicant's attorney and the Trademark Examining Attorney presented arguments. We affirm the refusal to register.

The specimen of use submitted by applicant and at issue on appeal is reproduced below:

¹ Trademark Act Section 1(a)(1), in pertinent part, provides that an application to register a trademark must be accompanied by "such number of specimens or facsimiles of the mark as used as may be required by the Director." Trademark Rule 2.56(a), in pertinent part, requires that an application under Section 1(a) of the Act must include "one specimen showing the mark as used on or in connection with the goods."

Brooke's Place is named for Brooke Wright, whose father died in a plane crash six years ago. Brooke had benefited from some of the short-term support groups after her father's death, but she told Wright, who was a family friend, that she wished there was more help.

"She kept asking the question, 'Well, what can I do now? I need to talk more and I need more help,'" Wright recalled.

Brooke's Place offers support groups for young people ages 3 to 22 (and their parents or guardians) who have lost a loved one. Participants meet twice a month for pizza and cake at St. Luke's United Methodist Church on the Far Northside, and they can come back to Brooke's Place as long as they need to.

Grieving can be unpredictable and uncontrollable. Researchers



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than adults do. They don't always show how sad they are. They'll be thinking about it, but they might not be talking about it," Wright said.

Kids go to Brooke's Place to share their feelings with trusted people of their own age and older. Y-Press recently spoke with two girls there.

Sabrina Wernicke, 12, and Patience Busche, 10, lost their mothers to cancer. "I felt really, really sad and kind of lost," recalled Sabrina, who was 6 at the time. "I remember her being funny and not much else because I was



Sabrina Wernicke



Pam Wright

of Sabrina's mother's. "She's a pretty good second to my mom," she said.

Patience's family is going through some adjustments. "My brothers aren't always as nice anymore, and they're acting weird because nobody's stopping them from being mean," she said. And her dad "doesn't really do the same stuff that he did when she was around. And he doesn't really take us out to places much."

Teachers and school administrators can be a source of support for grieving children, Wright said. Both girls said their relationships with teachers and friends have remained the same.

"It really didn't change that much. People kept on apologizing and trying not to talk about her a lot, but I didn't feel left out," Patience said.

"School was pretty much the same, except that everyone was like apologizing for something that they couldn't help," Sabrina said.

As time passes, it may appear that the pain has gone away or that children are over the death, but it is always with them. Sabrina said, "I feel a real sense of loss because most of my friends have their moms to talk to. I've been missing her a lot."

She continued: "Brooke's Place has helped, and I'm sure it will help a lot more because I can say anything there about how I feel, and I can trust that no one will tell it or they won't laugh at me."

Brooke's Place can be reached at (317) 255-2442. Information about programs can be found on its Web site (www.brookesplace.org).

REPORTERS: Rebecca Salois, 11; Lauren Slemenda, 12; Sarah Wenzel, 11; and Alicia Strong, 13.



Who we are

Y-Press is a nonprofit news organization located in The Children's Museum of Indianapolis. Stories are researched, reported and written by teams of young people ages 10 to 18. For more information, call (317) 334-4125 or send an e-mail to ypress@in.net.



Go online for more

Kids' religious beliefs: If you want to read more about this topic from a child's perspective, check out www.ypress.org. Y-Press also invites students' response to a poll question and wants your comments about kid-written movie and book reviews.

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Applicant has asserted that the specimen is a photocopy of a page from The Indianapolis Star, the newspaper in which applicant's column appears. (Applicant's April 4, 2002 response to October 22, 2001 Office action.)² As an initial matter, we note that the specimen photocopy does not depict the entire column, but only the bottom portion of it.³ At page 1 of its appeal brief, applicant asserts that "[a]t the top of the column appears Y-PRESS." Applicant's counsel repeated this assertion at the oral hearing. However, the manner in which Y-PRESS appears (e.g., the style and size of type) cannot be determined on this record.⁴

² In the same response, applicant also stated that applicant is not the publisher of The Indianapolis Star newspaper, and that the newspaper is not the source of applicant's column. Based on this statement, the Trademark Examining Attorney withdrew her previously-issued refusal to register the mark under Trademark Act Sections 1, 2 and 45 on the ground that the column constituted only a portion of applicant's publication and thus did not constitute separate goods in trade.

³ This is apparent from the discontinuous nature of the text appearing at the bottom of the first column vis-à-vis the top of the second column, and from the fact that the top of the photocopy depicts what appears to be only the bottom portion of a photograph captioned "Sabrina Wernicke."

⁴ Given the nature of the refusal at issue in this case, i.e., a specimen refusal, it obviously would have been helpful to us and to the Trademark Examining Attorney if applicant had submitted a specimen which depicted the column in its entirety. Likewise, it would have been helpful if the Trademark Examining Attorney had required submission of such a complete copy of the column, pursuant to Trademark Rule 2.61(b), 37 C.F.R. §2.61(b). See generally *In re DTI Partnership LLP*, 67 USPQ2d 1699 at n.3 (TTAB 2003). As it is, we have only applicant's counsel's description

We begin our analysis with the definition of "trademark" found in Section 45 of the Act, 15 U.S.C. §1127. That Section, in pertinent part, defines "trademark" as "any word, name, symbol, or device, or any combination thereof ... used by a person ... 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." As the Board has noted previously:

Implicit in this definition is a requirement that there be a direct association between the mark sought to be registered and the goods specified in the application, that is, that the mark is used in such a manner that it would be readily perceived as identifying the specified goods and as distinguishing a single source or origin for the goods.

In re Safariland Hunting Corp., 24 USPQ2d 1380, 1381 (TTAB 1992). It is settled that "[t]he Trademark Act is not an act to register mere words, but rather to register trademarks. Before there can be registration, there must be a trademark, and unless words have been so used they cannot qualify." *In re Bose Corporation, d/b/a Interaudio*

of the appearance of the entire column, i.e., that the designation Y-PRESS appears at the top of the column. Although we have no doubt as to the accuracy of counsel's statement, a more complete specimen would have enabled us to assess for ourselves the mark's commercial impression as it appears in the context of the entire column.

Systems, 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1976). See also *In re International Spike, Inc.*, 196 USPQ 447, 449 (TTAB 1977)(the court's statement in *In re Bose* regarding registrability of words as trademarks applies equally to registrability of designs). Thus, "[n]ot all words, designs and symbols used in connection with goods or services function as trademarks." *In re Chicago Reader Inc.*, 12 USPQ2d 1079, 1080 (TTAB 1989).

"To determine whether the term sought to be registered would be recognized by prospective purchasers as a trademark or service mark, the specimens of record must be considered." *Id.* As the court has stated:

An important function of specimens in a trademark application is, manifestly, to enable the PTO to verify the statements made in the application regarding trademark use. In this regard, the manner in which an applicant has employed the asserted mark, as evidenced by the specimens of record, must be carefully considered in determining whether the asserted mark has been used as a *trademark* with respect to the goods named in the application.

(Emphasis in original.) *In re Bose, supra*, 192 USPQ at 216. Thus, "[t]he mere fact that a designation appears on the specimens of record does not make it a trademark." *In re Safariland Hunting Corp., supra*.

Review of applicant's specimen in the present case shows that the only place thereon in which the mark sought to be registered appears is at the bottom of the page, underneath a horizontal line which separates the column proper (including the identification of the reporters) from what can only be considered to be merely informational matter below the line. The **Y-?** logo appears immediately to the left of text which is captioned (in bold letters) "Who we are," and which reads as follows:

Y-Press is a nonprofit news organization located in The Children's Museum of Indianapolis. Stories are researched, reported and written by teams of young people ages 10 to 18. For more information, call (317)334-4125 or send an e-mail to ypress@in.net.

Immediately below the **Y-?** logo is a depiction of a computer keyboard key with the "@" symbol, which itself appears immediately to the left of the following additional merely informational text under the heading "Go online for more":

Kids' religious beliefs: If you want to read more about this topic from a child's perspective, check out www.ypress.org. Y-Press also invites students' response to a poll question and wants your comments about kid-written movie and book reviews.

We find that the facts of this case are very similar to those at issue in the case of *In re Chicago Reader Inc.*,

supra. The applicant in that case sought to register CECIL ADAMS as a trademark for a newspaper column. The specimen submitted with the application was a photocopy of applicant's column, which bore at its top the title "THE STRAIGHT DOPE." CECIL ADAMS, the mark sought to be registered, appeared at the bottom of the column in the manner of a byline. The Board found that, as used on the specimen of record, CECIL ADAMS "merely serves to identify the author of the article and is not used nor would be recognized as a trademark identifying and distinguishing applicant's column." 12 USPQ2d at 1080. The Board went on to state as follows:

Moreover, the impression that "Cecil Adams" is a byline is reinforced by additional information contained at the bottom of applicant's columns:

Is there something you need to get straight? Cecil Adams can deliver the Straight Dope on any topic. Write Cecil Adams, Chicago Reader, PO Box 11101, Chicago 60611

"Cecil Adams" appears to be the name of an individual, albeit fictitious, and is not used in the manner of a trademark.

Id.

Similarly in the present case, on the column specimen submitted by applicant, the designation sought to be

registered appears only at the bottom of the column, in direct conjunction with information about applicant as an entity. Although it does not look like a byline, as was the case in *Chicago Reader*, the logo applicant seeks to register, appearing as it does directly adjacent to the informational text captioned "Who we are," clearly would be understood as identifying and referring to applicant as an entity, i.e., Y-Press. Just as CECIL ADAMS identified the author of the column rather than the column itself, applicant's logo identifies applicant's Y-PRESS entity rather than identifying the column *per se*, and it therefore does not function as a mark as used on this specimen.

Applicant argues that "[t]here is no requirement that a trademark for a newspaper column appear in a particular place in the column. It could be at the beginning, the middle, the end, or somewhere in-between, as long as it has source-indicating significance, as does Applicant's mark has [sic] here." (Brief at 3.) As we noted above, however, "[t]he mere fact that a designation appears on the specimens of record does not make it a trademark." *In re Safariland Hunting Corp.*, *supra*, 24 USPQ2d at 1381.

Moreover, there is no evidence in the record which shows that trademarks for newspaper columns typically, or ever, appear at the bottom of the column, much less that

they ever appear in the manner in which applicant's logo appears, i.e., separated from the text of the column by a horizontal line, and as part of, or in close proximity to, informational matter such as that which appears next to applicant's logo. Thus, this is not a case like *In re National Training Center of Lie Detection, Inc.*, 226 USPQ 798 (TTAB 1985), in which a slogan appearing in the masthead of applicant's publication ("separate and apart from the title" of the publication) was held to function as a trademark for the publication. The Board found that because others in the publishing field utilized such masthead slogans as marks for their publications (notably, the slogan ALL THE NEWS THAT'S FIT TO PRINT which appears on the masthead of The New York Times), purchasers were more likely to view the applicant's masthead slogan as a mark as well. There is no such trade practice evidence in this case, i.e., evidence that the purchaser (i.e., the newspaper reader) would be accustomed to looking for, or finding, a trademark for the column at the bottom of the column, displayed in the manner in which applicant's logo

is displayed, next to purely informational matter.⁵ As discussed above, applicant's logo, as it appears on the specimen column, would be understood to identify and refer to applicant as an entity, and would not be perceived as a trademark for the column.

At pp. 2-3 of its brief, applicant argues as follows:

The mark Applicant is seeking to register is used by the applicant through an entity known as Y-Press. The newspaper column clearly refers to "Y-Press" as one indicator of the source of the column ("Y-Press recently spoke with two girls there."). Obviously, the logo of the mark Y-? is another identifier of Y-Press, as the Examining Attorney indicates. Therefore, it is another indicator of the source of the column.

Applicant has chosen to place Y-? at the bottom of its column and has further provided an explanation of "Who We Are." That's precisely the purpose of a trademark - to identify who its proprietor is. It would be hard to find a device that more clearly serves to identify source as a logo that is accompanied by additional explanatory language.

However, in arguing that its logo is "another indicator of the source of the column," and "[t]hat's precisely the purpose of a trademark - to identify who its

⁵ Cf. *In re Dun-Donnelley Publishing Corporation*, 205 USPQ 575 (TTAB 1979), *recon. denied*, 208 USPQ 946 (TTAB 1980)(ENGINEERING CONSTRUCTION WORLD not used as mark for publication, where it appeared only as part of merely informational matter in the masthead); *accord*, *American Photographic Publishing Co. v. Ziff-Davis Publishing Co.*, 53 USPQ 373 (CCPA 1942).

proprietor is," applicant has it half-right. A trademark must identify not only the source of the goods but also must be used in such a way as to identify the goods specified in the application. The statutory definition of "trademark" (see *supra*) is phrased in the conjunctive: a trademark is a word, name, symbol etc. which is "used by a person ... 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." (Emphasis added.) Trademark Act Section 45, 15 U.S.C. §1127. As discussed above, the Board previously has noted that

[i]mplicit in this definition is a requirement that there be a direct association between the mark sought to be registered and the goods specified in the application, that is, that the mark is used in such a manner that it would be readily perceived as identifying the specified goods and as distinguishing a single source or origin for the goods.

(Emphasis added.) *In re Safariland Hunting Corp., supra*, 24 USPQ2d at 1381. Thus, not only must a mark identify the source of the goods, but there also must be "a direct association between the mark sought to be registered and the goods specified in the application." *Id.* As the court stated in *In re Bose, supra*, the issue is "whether the

asserted mark has been used as a trademark with respect to the goods named in the application. (Italics emphasis in original; underline emphasis added.) 192 USPQ at 216.⁶

Clearly, in the *Chicago Reader* case, the designation CECIL ADAMS identified the source of the newspaper column, and the informational matter accompanying the designation on the specimens further reinforced the impression that CECIL ADAMS was the source of the column. But because the designation as it appeared on the specimens identified only the source of the column, and did not also identify the column itself, the Board found that it did not function as a trademark for the column. The same is true here. Even assuming that applicant's **Y-?** logo identifies applicant's Y-PRESS entity as the source of the column, it fails to

⁶ Examples of cases in which it was held that the matter sought to be registered failed to function as a trademark or service mark because, as it was used on the specimens, it failed to identify the goods or services specified in the application, are: *In re Bose Corporation, supra* (SYNCOM failed to function as a trademark for "loudspeaker systems for high-fidelity music reproduction" because, as it appeared on the specimens, it did not identify the loudspeakers specified in the application, but rather identified a "speaker testing computer" used to test the speakers during their manufacture); *In re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456 (CCPA 1973)(term not registrable as service mark where the specimens show use of the term only as the name of a process, even though applicant is in the business of rendering services generally and the services are advertised in the same specimen brochure in which the name of the process is used); and *In re Walker Research, Inc.*, 228 USPQ 691 (TTAB 1986)(term that merely identifies computer program used in rendering services does not function as mark to identify market analysis services).

function as a mark (at least on these specimens) because it identifies only the source of the column, and not the goods specified in the application, i.e., the column itself.⁷

Finally, applicant argues that we should reverse the Trademark Examining Attorney's specimen requirement because, in the case of *In re Drilco Industrial Inc.*, 15 USPQ2d 1671, 1672 (TTAB 1990), the Board noted that it "has been liberal in assessing the acceptability of materials which have been submitted as specimens of use." However, *Drilco* stands for the proposition that the Board will be liberal in assessing whether the type of materials submitted as specimens (e.g., displays, instruction manuals or trade show exhibits) are acceptable as specimens. Here, there is no question that the type of material applicant has submitted as a specimen, i.e., a photocopy of the column itself, is an acceptable type of specimen. Thus, *Drilco* is inapposite. Neither *Drilco*, nor any other

⁷ Applicant's argument, i.e., that a designation need only serve to identify the source of the goods in order to function as a trademark for the goods, is further belied by the well-settled rule in trade name cases. Clearly, use of a trade name on the goods identifies the source of the goods, but it does not *ipso facto* function as a trademark for the goods merely by virtue of its performance of such source-identifying function. See, e.g., *In re Diamond Hill Farms*, 32 USPQ2d 1383 (TTAB 1994)(DIAMOND HILL FARMS, as used on containers for goods, found to be a trade name that identifies applicant as a business entity rather than a mark that identifies applicant's goods and distinguishes them from those of others).

authority applicant has cited, supports what apparently is applicant's real contention, i.e., that we should be liberal in determining whether the specimen submitted with the application adequately evidences applicant's compliance with the statutory requirement that the matter sought to be registered in fact is used as a trademark for the goods identified in the application.

In summary, for the reasons discussed above, we find that the specimen applicant has submitted fails to evidence use of the designation **Y-?** as a trademark for the goods identified in the application, and that registration of the mark accordingly must be refused. We have carefully considered all of applicant's arguments to the contrary (including any arguments not specifically addressed in this opinion), but are not persuaded of a different result.⁸

Decision: The refusal to register is affirmed.

⁸ Cf. *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 23 USPQ2d 1839, 1847 (Fed. Cir. 1992).