

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

Mailed: January 30, 2004
Paper No. 9
PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Taylor-Listug, Inc.

Serial No. 76357740

Peter K. Hahn of Luce, Forward, Hamilton & Scripps for
Taylor-Listug, Inc.

David H. Stine, Trademark Examining Attorney, Law Office
114 (Margaret Le, Managing Attorney).

Before Cissel, Hairston and Bucher, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register
of the mark SIGNATURE, in typed form, for "musical
instruments, namely guitars."¹

The Trademark Examining Attorney has finally refused

¹ Application Serial No. 76357740, filed January 10, 2002, and
alleging first use anywhere and first use in commerce at least as
early as January 15, 1986.

registration under Section 2(e)(1) of the Trademark Act, on the ground that the mark is merely descriptive of applicant's identified goods. In addition, the Examining Attorney has issued a final requirement that applicant submit a substitute specimen.

Applicant has appealed. Briefs have been filed², but an oral hearing was not requested.

We turn first to the mere descriptiveness refusal under Section 2(e)(1). A term is deemed to be merely descriptive of goods or services, within the meaning of Trademark Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services.

² Applicant submitted with its appeal brief a list of third-party registrations of the mark SIGNATURE for various goods and services, including certain musical instruments. The Board does not take judicial notice of registrations which reside in the U.S. Patent and Trademark Office and the submission of a mere list of third-party registrations is insufficient to make them properly of record. Rather, plain copies of the registrations themselves or the electronic equivalent thereof must be submitted. Moreover, under Trademark Rule 2.142(d), evidence submitted for the first time with a brief on appeal is normally considered by the Board to be untimely and therefore given no consideration. In view thereof, we will not consider the third-party registrations listed in applicant's brief in reaching our decision. We hasten to add that even if we had considered these registrations, our decision herein would be the same. The Board is not bound by prior decisions of Trademark Examining Attorneys to register particular marks, and each case must be decided on its own merits, on the basis of the record therein. See *In re Nett Designs Inc.*, 23 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ["Even if some prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the Board or this court."].

In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describe one significant attribute, feature or property of the goods or services. Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979).

It is the Examining Attorney's position that the mark SIGNATURE is merely descriptive of applicant's guitars because it immediately describes a significant feature thereof, namely that the guitars bear the signature of a celebrity or noted musician. In support of the mere descriptiveness refusal, the Examining Attorney submitted the following excerpts from the NEXIS database which include the term **signature** (highlighted) in connection with guitars:

Barry Zito is, as usual, unplugged. He's on a

stool, strumming a **signature** Dave Matthews guitar in the dining room of his San Francisco Marina flat - right where the martini will be once his pet renovation project is ...
(USA Today; October 4, 2002);

There's also a Black Sabbath costume contest for a chance at winning a Tony Iommi **Signature** SG guitar. Tickets are free, available only At Quonset Hut or The Exchange locations.
(The Plain Dealer; October 18, 2002);

Chomping a permanent piece of Dentyne, he modeled a **signature** Dale Earnhart Budweiser guitar, sloshed beer on his roadie's shirt for comical effect, and after being handed items including homemade CD's and ...
(Chicago Daily Herald; October 21, 2002);

In response to the number of women guitarists around these days, many traditional guitar companies are marketing **signature** guitar lines for women artists.
(Chicago Tribune; October 30, 2002); and

Eric Johnson solos note-for-note. She's also the star of a series of MVP instructional videos (mvphomevideo.com), and she has her own **signature** model from Zion Guitar Technology.
(Guitar Player; November 1, 2002).

According to the Examining Attorney, "these excerpts clearly show it is not uncommon within the relevant trade for manufacturers [of guitars] to offer models which bear the signature of a well known musician or other celebrity... ." (First Office Action, p. 2). In addition, the Examining Attorney argues that because the applicant owns a prior registration for the mark DAN CRARY SIGNATURE MODEL (Registration No. 2,252,080) for guitars wherein

"SIGNATURE MODEL" is disclaimed, this is further evidence that the term SIGNATURE is merely descriptive of guitars.

Applicant, in urging reversal of the refusal to register, argues that purchasers and prospective purchasers of guitars, upon seeing the mark SIGNATURE thereon, would not immediately believe that there was a signature on the guitars. In particular, applicant maintains:

Many times an item can be seen as an individual's signature item. Artists and musicians are often known for signature items - none of which bear the written signature. Examples include Clint Black's black hat and the musician Pink's signature pink hair. In view of this, Applicant submits the mark SIGNATURE would simply be suggestive that guitars in the signature series would be of a type that could be someone's signature item. (emphasis in original) (Brief, pp. 2-3).

After careful consideration of the evidence of record and the arguments of applicant and the Examining Attorney, we find that the term SIGNATURE is merely descriptive of a feature or characteristic of applicant's guitars. Specifically, it immediately and directly informs purchasers that applicant's guitars bear the signatures of musicians.

Applicant does not dispute that each label affixed to its guitars bears the signature of a musician. In point of fact, applicant's label specimen, which is reproduced *infra*, bears the signature of the well-known musician Jewel

Kilcher. When purchasers of guitars encounter the term SIGNATURE, especially as used on a label affixed to a guitar which bears the signature of a musician, we have no doubt that the mark immediately informs them of a significant feature of the guitar, namely, that the guitar is a signature model, that is, it bears the signature of a musician.

Accordingly, applicant's mark, when applied to applicant's goods, is merely descriptive of them within the meaning of Section 2(e)(1) of the Trademark Act. Whether the term SIGNATURE may have another meaning in relation to different goods or in other contexts is not relevant to our inquiry.

We turn next to the requirement that applicant submit a substitute specimen. In his final office action at page 2, the Examining Attorney states:

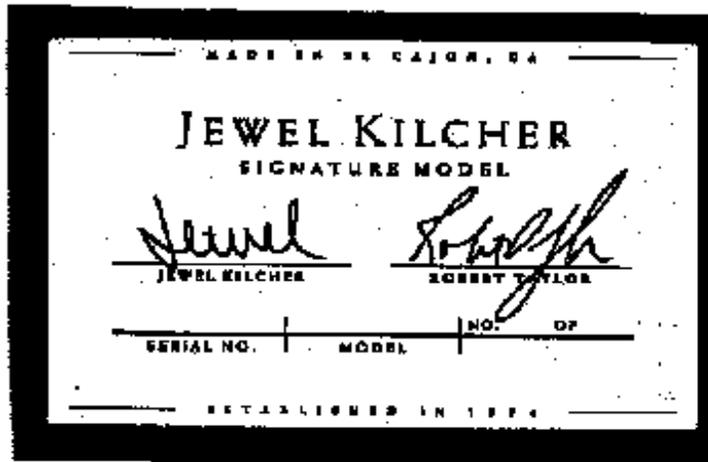
... the drawing displays the mark as SIGNATURE. However, this differs from the display of the mark on the specimen, where it appears as SIGNATURE MODEL. The applicant cannot amend the drawing to conform to the display on the specimen because the character of the mark would be materially altered.

...

Therefore, the applicant must submit a substitute specimen that shows actual trademark use of the specific mark [SIGNATURE] as it appears on the drawing. (citations omitted).

It is applicant's position, however, that the term SIGNATURE makes a separate and distinct commercial impression from the descriptive term "model," and that therefore applicant's specimen is acceptable.

Trademark Rule 2.51(a) provides, in part, that "the drawing of the trademark shall be a substantially exact representation of the mark as used on or in connection with the good[s]." Moreover, it is well settled that an applicant may apply to register any element of a composite mark if that element, as shown in the record, presents a separate and distinct commercial impression which indicates the source of applicant's goods and distinguishes applicant's goods from those of others. See, e.g., *In re Chemical Dynamics Inc.*, 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988); and *Institut National des Appellations D'Origine v. Vintners International Co., Inc.*, 954 F.2d 1574, 22 USPQ2d 1190 (Fed. Cir. 1992), citing *In re Servel, Inc.*, 181 F.2d 192, 85 USPQ 257 (CCPA 1950); *In re Berg Electronics, Inc.*, 163 USPQ 487 (TTAB 1969). See also, Trademark Manual of Examining Procedure, sections 807.14(a) and (b) and cases cited therein. Applicant's label specimen is reproduced below:



In this case, we agree with the Examining Attorney that the term SIGNATURE does not create a separate and distinct commercial impression. As we have found, the term SIGNATURE is merely descriptive of applicant's guitars. The term model is also merely descriptive, if not generic, of guitars. The two-word combination SIGNATURE MODEL connotes a kind of guitar, i.e., a "signature model." This is different from the connotation of SIGNATURE alone. Thus, the Examining Attorney's requirement for a substitute specimen was proper.

Decision: The refusal to register under Section 2(e)(1) is affirmed; and the requirement for a substitute specimen is affirmed.