

Mailed:

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

August 31, 2004
Paper No. 11
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Bermark Inc.**

Serial No. 76406106

Myron Amer of Myron Amer, P.C. for **Bermark Inc.**

Ann K. Linnehan, Trademark Examining Attorney, Law Office 114
(K. Margaret Le, Managing Attorney).

Before **Seeherman, Hohein** and **Rogers**, Administrative Trademark
Judges.

Opinion by **Hohein**, Administrative Trademark Judge:

Bermark Inc. has filed an application to register the
mark "SILK TREND RUGS OF NORTH AMERICA" as a trademark for
"rugs".¹

Registration has been finally refused under Sections 1,
2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127,
on the ground that "the proposed mark is used solely as a trade
name, and not as a trademark," for applicant's goods.

¹ Ser. No. 76406106, filed on May 8, 2002, which is based on an
allegation of a date of first use anywhere and in commerce of November
1, 2000. The word "SILK" and the phrase "RUGS OF NORTH AMERICA" are
disclaimed.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

As indicated in, for example, *In re Univar Corp.*, 20 USPQ2d 1865, 1866 (TTAB 1991):

It is well settled that, in appropriate circumstances, a name may function as both a trade name and as a trademark The question of whether a name used as a trade name ... also performs the function of a trademark ... is one of fact and is determined from the manner in which the name is used and the probable impact thereof upon purchasers and prospective customers. See, e.g., *In re Walker Process Equipment Inc.*, 233 F.2d 329, 110 USPQ 41, 43 (CCPA 1956); *In re Unclaimed Salvage & Freight Co., Inc.*, 192 USPQ 165, 167 (TTAB 1976); and *In re Lytle Engineering & Mfg. Co.*, 125 USPQ 308 (TTAB 1960).

Applicant, while acknowledging such in its initial brief, stresses, however, that as formerly set forth in "TMEP 1202.02," the "[f]actors to be considered in determining this issue may include the presence of an entity designator in a name sought to be registered and the proximity of an address."² Applicant argues, in view thereof, that even if the specimen of record, which is a label affixed to applicant's goods and is the sole

² The Examining Attorney correctly points out in her brief, however, that the section cited by applicant "is from an outdated version of the Trademark Manual of Examining Procedure". The section which, instead, currently deals with the "Refusal of Matter Used Solely as a Trade Name" is TMEP Section 1202.01 (3d ed. 2d rev. 2003). That section provides, *inter alia*, that "[t]he presence of an entity designator in a name sought to be registered and the proximity of an address are both factors to be considered in determining whether a proposed mark is merely a trade name." Other factors, as indicated therein, which are nonetheless to be considered in determining whether a name "independently projects a separate commercial impression," and thus functions as a trademark, include a name's "presentation in a distinctively bolder, larger and different type of lettering and, in some instances, its additional use in a contrasting color."

evidence of its manner of use of "SILK TREND RUGS OF NORTH AMERICA," arguably shows the use thereof as a trade name identifying applicant's business, such name also functions as a trademark identifying and distinguishing applicant's goods because the name contains no entity designator and is not used in proximity to an address. Consequently, given that such name "at the very least ... serves a double function of a trademark and of a trade name," applicant maintains that the name is registrable as a mark.³

We agree with the Examining Attorney, however, that the specimen of record evidences only trade name use of the name "SILK TREND RUGS OF NORTH AMERICA." As the Examining Attorney correctly notes, while Section 45 of the Trademark Act, 15 U.S.C. §1127, defines a "trademark" as "any word, name, symbol, or device, or any combination thereof," which serves "to identify and distinguish [a person's] ... goods ... from those

³ Applicant also contends in its initial brief that, in light of the assertedly "inconsistent positions that have been taken by the examining attorney in the examination of this application," the name "SILK TREND RUGS OF NORTH AMERICA" should be found to be registrable inasmuch as such would not be perceived as merely a trade name. Specifically, applicant urges that it is "most significant" that the Examining Attorney required a disclaimer of the word "SILK" and the phrase "RUGS OF NORTH AMERICA" "because the public would perceive the words involved (except the word [']Trend') as being descriptive of the goods," yet "in her final refusal [she] argues that the words are a trade name that do not convey source-identification of the goods." While the Examining Attorney, in her brief, simply contends that "[s]uch an argument houses little merit given that the applicant was invited to submit a substitute specimen showing proper use of the proposed mark as a trademark to overcome the substantive refusal to register the proposed mark," suffice it to say that we see no inconsistency in the Examining Attorney's finding that, when considered in its entirety, the name which applicant seeks to register is used solely as a trade name and her further finding that, if considered to be a trademark, portions thereof are descriptive and must therefore be disclaimed.

manufactured or sold by others and to indicate the source of the goods, even if that source is unknown," such section also defines "trade name" as meaning "any name used by a person to identify his or her business or vocation." Here, the label submitted as applicant's specimen of use contains two displays of the name "SILK TREND RUGS OF NORTH AMERICA." In one instance, such name is displayed horizontally, at the top of the label, and in the same size and style of capitalized lettering, as a portion of an informational statement which appears in the following context:

MADE IN BELGIUM
IMPORTED BY SILK TREND RUGS OF NORTH AMERICA
PILE: 65% POLYESTER + 35% VISCOSE

In the second manner of display, the name is again part of an informational statement, but is set forth vertically, on the left hand side of the label, and is shown in essentially the same size and style of print, although certain words are capitalized as indicated below:

Imported by Silk Trend Rugs of North America
Made in Belgium by n.v. Weverij Bulckaert

As the Examining Attorney persuasively observes in her brief, "[t]he manner of use of applicant's mark ... is not such that potential purchasers would readily perceive the subject matter as identifying and distinguishing the applicant's goods and indicating their source." In particular, she accurately observes that, based on the uses shown by the specimen of record:

In each place the proposed mark immediately follows the terms "imported by." The proximity of these terms indicates that the proposed mark is the name of an entity that

imports the product (the rugs). Additionally, the style of the lettering for the proposed mark is not distinctively different from the lettering surrounding each depiction of the proposed mark on the specimen. Nor is the lettering used to depict the proposed mark bolder or larger. The proposed mark [thus] fails to project a separate commercial impression.

The manner of use of applicant's [proposed] mark on the specimens is not such that potential purchasers would readily perceive the subject matter as identifying and distinguishing the applicant's goods and indicating their source. See Section 45 of the Trademark Act

With respect to applicant's contention that controlling weight should be given to the fact that, as used, "its proposed mark does not include an entity designator (such as 'Inc.' or 'Co.')

and is not in close proximity to an address," the Examining Attorney maintains that:

These factors are not and should not be the only factors to be considered in determining this issue. Indeed, the use of terms such as "imported by" and the lack of distinct lettering should not be altogether dismissed in analyzing the function of the proposed mark in this instance.

Applicant, in its reply brief, nevertheless reiterates that the mere absence of an entity designator in the name "SILK TREND RUGS OF NORTH AMERICA," together with the lack of proximity of such name to an address on the specimen of use, compels a finding that the name performs the source-identifying function of a trademark. Applicant also contends that the Examining Attorney has failed "to state why the absence of [such] circumstances ... warranted reaching a conclusion in variance with TMEP Section 1202.01." Applicant's assertions, however, are simply unfounded. The cited

section of the TMEP, as noted previously, not only sets forth several factors, in addition to the presence or absence of an entity designator in a name and the proximity of the name to an address, which are to be considered in determining whether matter is used solely as a trade name, but provides that the determination thereof "requires consideration of the way the mark is used, as evidenced by the specimens."

Here, it is clear that the Examining Attorney considered the relevant factors and, as explained in her brief, found that the absence of an entity designator and a business address was outweighed, in the context in which the name "SILK TREND RUGS OF NORTH AMERICA" appears on the specimen, by the presence of the phrase "imported by," which immediately precedes such name, and the absence of any distinguishing manner of stylization, which would serve to set the name apart from the other informational matter appearing on the specimen. The Examining Attorney, therefore, properly concluded that the name "SILK TREND RUGS OF NORTH AMERICA" functions only as a trade name used by applicant in the marketing of its rugs and does not also serve a trademark function. See, e.g., In re Diamond Hill Farms, 32 USPQ2d 1383, 1384 (TTAB 1994) ["[b]ecause of the way DIAMOND HILL FARMS is depicted on the specimen ..., the commercial impression is that it is informational, i.e., the name of the producer of the goods, and is part of the other informational material, such as ... the weight of the potatoes"; consequently, "DIAMOND HILL FARMS would be perceived by purchasers and prospective purchasers as a trade name serving to identify

Ser. No. 76406106

applicant as a business entity rather than a mark which identifies and distinguishes applicant's [raw potatoes] ... from those of others"].

Decision: The refusal under Sections 1, 2 and 45 is affirmed.