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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re David J. Gungner

Serial No. 78093634

David J. Gungner, *pro se*.

Cynthia Sloan, Trademark Examining Attorney, Law Office 116
(Michael W. Baird, Managing Attorney).

Before Quinn, Holtzman and Mermelstein, Administrative
Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

David J. Gungner filed, on November 15, 2001, an
intent-to-use application to register the mark MISSING A
RIB, XY INSTEAD OF XX for goods ultimately identified as
"books, brochures, facsimile transmission paper,
newsletters, pamphlets featuring content regarding
scientific creationism and/or biblical inerrancy as
interpreted via virtue of methodologies from the topic of
computer science."

After the mark was published and a notice of allowance issued, applicant filed a statement of use alleging first use anywhere on December 31, 2000, and first use in commerce on January 5, 2001. The statement of use was accompanied by a specimen showing the proposed mark as actually used by applicant on "facsimile transmission paper."

The trademark examining attorney refused registration on two grounds, namely (1) that the proposed mark fails to function as a trademark under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051-1052, and 1127; and (2) that applicant's identified goods to which the proposed mark is applied are not "goods in trade" as contemplated by the same sections of the statute.

This application, filed almost seven years ago, evidences a long and tortured prosecution history. Even compliance with the most basic requirement, a signature for the application declaration, required several responses. Be that as it may, a final refusal eventually issued, followed by a request for reconsideration. The request was denied and applicant filed a notice of appeal. Applicant filed an appeal brief and, on no less than three separate occasions before the examining attorney filed her brief, applicant filed identical papers captioned "supplemental

legal brief." The examining attorney filed an appeal brief and applicant filed a reply brief. Although applicant originally requested an oral hearing, applicant later withdrew the request.

Failure to Function as a Mark

As has been frequently stated, "[b]efore there can be registration, there must be a trademark." *In re Bose Corporation, d/b/a Interaudio Systems*, 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1978). The starting point for our analysis is Section 45 of the Trademark Act, as amended, where "trademark" is defined 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." 15 U.S.C. §1127. This section further provides that a mark shall be deemed to be in use in commerce on goods when "it is placed in any manner on the goods or their containers...or on the tags or labels affixed thereto...and the goods are sold or transported in commerce." Thus, the mark must be used in such a manner that it would readily be perceived as identifying the specified goods and distinguishing a single source or origin for the goods. *In re Aerospace Optics, Inc.*, 78

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USPQ2d 1861 (TTAB 2006); and *In re Safariland Hunting Corp.*, 24 USPQ2d 1380 (TTAB 1992). The mere fact that a designation appears on the specimen, or that applicant intends the designation to be a source indicator, does not make it a trademark. *In re Manco Inc.*, 24 USPQ2d 1938 (TTAB 1992).

A critical element in determining whether matter sought to be registered is a trademark is the impression the matter makes on the relevant public. Thus, in a case such as this, the critical inquiry is whether the asserted mark would be perceived as a source indicator. See *In re Brass-Craft Mfg. Co.*, 49 USPQ2d 1849 (TTAB 1998); and *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455 (TTAB 1998). To be a mark, the designation must be used in a manner calculated to project to purchasers or potential purchasers a single source or origin of the goods. We determine whether this has been achieved by examining the specimens of use along with any other relevant material submitted by applicant during prosecution of the application. *In re Walker Research, Inc.*, 228 USPQ 691 (TTAB 1986). Here, we look to the specimens ("facsimile transmission paper"), both the one originally submitted with the statement of use (left image shown below), and an additional "facsimile transmission paper" (right image

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shown below) that is part of an actual facsimile transmitted to the USPTO as a response.



missing a rib, XY instead of XX ® GenesIs 2:20-23



missing a rib, XY instead of XX™ GenesIs 2:20-23

United States Sixteenth President Abraham Lincoln (birth: February 12, 1809 Ford's Theater; April 14, 1865) Exodus 12:29

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Serial enumeration: 78/093634
mark: MISSING A RIB, XY INSTEAD OF XX
applicant's name: david j gungner
2. earthCalendarDate of this Office Action: Friday, March 26 2004
3. Examining Attorney's name: Cynthia M. Sloan
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Attorney Cynthia M. Sloan <RECEPIENT> david gungner <SENDER>
 United States Patent and Trademark Office <RECEPIENT CORPORATION> homo sapien <SENDER CORPORATION>
 1 703 746 8116 <RECEPIENT FACSIMILE> +1 (818) 994-3980,,#1 <SENDER FACSIMILE>
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PAGE 1/7 * RCVD AT 3/28/2004 12:19:54 AM [Eastern Standard Time] * EVE:USPTO-EF3RF-20 * DNS:7488118 * CSD: * DURATION (min-ss):03-28

We find that applicant's designation MISSING A RIB, XY INSTEAD OF XX, as used on the specimens of record, fails to function as a mark for its identified goods. The designation sought to be registered would be perceived merely as part of the ornamentation of the "letterhead" of a facsimile transmission cover sheet. As such, consumers would not view the designation as a source indicator for the paper itself.

Accordingly, applicant's designation, as it appears on the cover sheet of a facsimile transmission, fails to

function as a mark under Trademark Act Sections 1, 2 and 45 as used in connection with applicant's identified goods.

Good in Trade

As indicated above, applicant submitted as specimens facsimile transmission papers. We now turn to consider whether these papers are "goods in trade" as contemplated by the statute.

The Board has held that collateral products which serve the purpose of promoting a party's primary goods and which have more than a mere incidental function in relation to the primary goods may constitute goods in trade. See, e.g., *In re Snap-On Tools Corp.*, 159 USPQ 254 (TTAB 1968).

On the other hand, in *Ex parte Bank of America National Trust and Savings Association*, 118 USPQ 165 (Comm'r Pats. 1958), it was held that a mark was not registrable for bank passbooks, checks and other printed forms, where such materials were used only as necessary tools in the performance of banking services, and the applicant was not engaged in printing or selling forms as commodities in trade. Further, in *In re Douglas Aircraft Co., Inc.*, 123 USPQ 272 (TTAB 1959), the Board held that pamphlets, booklets, brochures, bulletins, and letterheads which serve only to advertise, explain and publicize the goods in which an applicant deals do not constitute goods

of such applicant. In *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768 (TTAB 1994), the Board found that an applicant's purported game that was not clearly labeled as a game and consisted merely of three photocopied pages, stapled together without any packaging, served only to promote applicant's band and other products, and was not a bona fide game but rather an advertising flier for applicant's band.

In the present case there is no evidence that applicant is a manufacturer of facsimile transmission paper or that applicant is engaged in selling transmission facsimile paper as a commodity in trade. As argued by the examining attorney, "such goods...are items that are commonly used to run a business on a daily basis, i.e., sending messages via facsimile transmission. Incidental items used to conduct daily business (such as letterhead, invoices and business forms) are not 'goods in trade' because they are not items sold or transported in commerce for use by others." (Brief, p. 5). See, e.g., *In re Shareholders Data Corp.*, 495 F.2d 1360, 181 USPQ 722 (CCPA 1974). We believe that consumers would view the papers as nothing more than facsimile transmission cover sheets. Further, the record does not include any evidence that the other identified products qualify as "goods in trade."

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Accordingly, we are not persuaded that the facsimile transmission paper has additional utility such that it constitutes "goods in trade."

Decision: The refusals to register are affirmed.