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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Methodist Healthcare System of San Antonio, Ltd.

Serial No. 78595687

Linda W. Browning of Kammer Browning PLLC for Methodist
Healthcare System of San Antonio, Ltd.

Doritt Carroll, Trademark Examining Attorney, Law Office 116
(Michael W. Baird, Managing Attorney).

Before Holtzman, Walsh and Cataldo, Administrative Trademark
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Applicant, Methodist Healthcare System of San Antonio, Ltd.
has filed an application to register the mark DOTTIE (in standard
character form) on the Principal Register for "educational
services, namely, providing programs of instruction for children
in health care, nutrition and fitness" in Class 41.¹

¹ Application Serial No. 78595687, filed March 26, 2005, alleging a
date of first use and first use in commerce of December 1994.

The trademark examining attorney has refused registration under Sections 1, 3 and 45 of the Trademark Act on the ground that the term DOTTIE does not function as a mark to identify and distinguish applicant's services.²

When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs.

Section 45 of the Trademark Act provides, in part, that a service mark is used in commerce "when it is used or displayed in the sale or advertising of services and the services are rendered in commerce...." It is well settled that not every word, design or symbol used in the sale or advertising of a service functions as a mark for the service. A character name, like any other designation, may function as a mark if it is used in the manner of a mark to identify the services and distinguish them from those of others. See *In re McDonald's Corp.*, 229 USPQ 555 (TTAB 1985); and *In re Hechinger Investment Co. of Delaware Inc.*, 24 USPQ2d 1057 (TTAB 1991). The determination of whether a designation is used in the manner of a mark is made based upon the specimens and other evidence of record. *Id.*

² The examining attorney also initially refused registration under Section 2(d) of the Trademark Act. That refusal was subsequently withdrawn.

We agree with the examining attorney that based on the specimens and other evidence of record in this case, the term DOTTIE is not used in the manner of a mark.

The specimen submitted with the original application is shown below.



Click on the Young Heroes' Club® Friend below who you'd like to know more about. Everyone has his or her own page with some pictures for you to print and color yourself. There's a color picture to guide you, but you can color them any way you want! What do you think Well Waldo Wallaby would look like as a pink polka-dotted Wallaby?

 Dottie's real nice, and pretty too!	 Drew has a great picture just for you!	 Harriet's good at climbing trees, and careful too!	
 Recess is our artist. You can be too!	 Thrash loves his skateboard! Careful, Thrash!	 Waldo is our Club President! WOW!	 Zapper loves video games! Do you?


Here are some more pictures for you to color!

[what we do](#) [our motto](#) [sign up & join](#)
[recipes](#) [just 4 fun](#)

<http://vbc.shealth.com/meet.asp>

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This specimen consists of a page from applicant's website, yhc.sahealth.com. The wording "meet the group" appears at the top of the page followed by "YOUNG HEROES CLUB." The middle of the page depicts two rows of fanciful animal characters. Below each image is a caption with the name and a little information about the character. The caption below the first character, which appears to be a spotted cat, reads, "Dottie's real nice, and pretty too!" The instructions above the character display invite children to click on a character they would like to print out and color or know more about.

In order to be used in the manner of a mark and therefore be perceived as a mark identifying the services, the specimens must show a direct association between the services and the mark sought to be registered. See *In re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456, 457 (CCPA 1973). See also *In re Advertising & Marketing Development*, 821 F.2d 614, 2 USPQ2d 2010 (Fed. Cir. 1987). There must be at least some reference to the services in order to create the association. See *In re Monograms America Inc.*, 51 USPQ2d 1317 (TTAB 1999). Applicant is seeking registration for educational services, but nowhere are the educational services even mentioned on the web page, much less identified by the term DOTTIE. Thus, the required direct association between the asserted mark and the recited services cannot be made. The term DOTTIE as used on this specimen would

be perceived simply as the name of the "nice" and "pretty" member of the group of characters belonging to the "Young Heroes Club."

Applicant contends that this "advertising" presents the mark "in clear association with the services." Brief, p. 3. Pointing to the URL of applicant's website, yhc.sahealth.com, which appears on the web page, applicant argues that "[w]hen the consumer views the trademark DOTTIE on these web pages, they know that the Methodist Healthcare System is the source of the goods and services being described." Brief, p. 5. First, the URL does not contain a reference to an educational service, or to any service for that matter. Further, even assuming the URL did refer to a service, this information, appearing in small print at the bottom edge of the web page, is barely noticeable. Any connection between the asserted mark and the service would be vague and indirect at best.³ See *Peopleware Systems, Inc. v. Peopleware, Inc.*, 226 USPQ 320, 323 (TTAB 1985) ("No direct association is demonstrated by the insignificant use of "Peopleware" in the sentence at the bottom of the card.").

Applicant also argues that the web page shows that DOTTIE is used "in the promotional program" to promote the educational services applicant offers to children, and that the mark is

³ Applicant states on p. 5 of its brief that the wording "Brought to you by your friends at Methodist Healthcare" appears on the web page. We see no such statement on the record copy of the specimen. However, even if this wording did appear on the specimen, if anything, it would identify healthcare or hospital services, not educational services.

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presented on the web page "with information regarding how consumers can gain access to these services." Brief, p. 3. The only information on the web page of record is the instruction for printing and coloring the characters and for getting more information about them. Applicant may be providing a "promotional program," that is, applicant may be engaged in promoting awareness of health and fitness to children, but applicant is not seeking registration for "promotional" services. Again, there is no reference to any educational service on this specimen or to the promotion of any educational service, or even any explanation by applicant as to how the asserted mark is used to promote the educational services. A designation must not only be used in the advertising or promotion of the services but it also must be used in a manner which conveys a commercial impression as a mark for the services. *In re Hechinger Investment Co.*, supra at 1059 (commercial impression created by... 'TWOBATOR' is clearly and simply that of the name of a fanciful dog character which appears in certain illustrations in applicant's advertisements"); *In re Whataburger Systems, Inc.*, 209 USPQ 429, 430 (TTAB 1980) (nothing of record to show promotion of applicant's various cartoon-like animals in a manner that would create purchaser recognition of any individual animal as an indicator of the source of applicant's restaurant services as distinguished from "a promotional gambit"). The only

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commercial impression created by "Dottie" is that of the name of a particular character who is one of the members of applicant's club.

Furthermore, while a mark need not be displayed in any particular size or degree of prominence, the question is whether, when it is noticed, it will be understood as indicating origin of the services. See *In re Singer Mfg. Co.*, 118 USPQ 310, 312 (CCPA 1958). In this specimen, the DOTTIE character is displayed as one of a group of characters, and it is used no differently than any other character in the group. The name DOTTIE, like all the other character names, is used informationally to describe the character itself - "Dottie's real nice, and pretty too!" - in the same size and font as the rest of the wording. Used in this manner, the term does not create an impression apart from its informational context and it would not be understood by consumers as a term identifying a service. See *In re Metrotech*, 33 USPQ2d 1049, 1052 (Com'r Pats. 1993) (mark must be used in such a manner that it would be "readily" perceived as identifying source). See, e.g., *In re Chemical Dynamics, Inc.*, 839 F.2d 1569, 5 USPQ2d 1828, 1829-30 (Fed. Cir. 1988) (a designation must create "a separate and distinct commercial impression, which thereby performs the trademark function of identifying the source of the goods to the customers.").

The second specimen submitted by applicant is a coloring book. Below the heading "YOUNG HEROES' CLUB" is the wording "from the Methodist Children's Hospital." The coloring book includes a narrative story entitled "Dottie Changes Her Spots," and the main character of the story is Dottie who becomes ill and visits the doctor.

Applicant argues that the coloring book "serve[s] as further promotional material (material that promoted involvement in the educational services program)..." and that by this coloring book "children are taught various ways to be healthier." Brief, p. 3, 4. Applicant states that "it is in the business of providing educational materials to children, such as the use of the DOTTIE trademark in both the promotion and presentation of these materials" and that "[t]he public, upon viewing this coloring book, would identify its source as [applicant.]" Brief, pp. 4, 5.

First, applicant is seeking registration for educational services, not educational materials. As stated by the Federal Circuit in *In re Canadian Pacific Ltd.*, 754 F.2d 992, 224 USPQ 971, 973 (Fed. Cir. 1985), a service is "the performance of labor for the benefit of another." The issue before us is not whether applicant is in fact performing an educational service. We will presume that it is. The question is whether the specimen shows use of the mark for the service. This specimen is a coloring

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book, not an advertisement for educational services and it makes no reference to an educational service. It shows no courses, no classes, no "performance of labor" of any kind relating to educational services.

Applicant appears to argue that the educational service is rendered through the distribution of the coloring book or through the storyline in the coloring book. The story does convey an educational message, for example, instructing children that "You can get sick if you don't wash your hands before you eat" and "You can get sick if you drink out of the same glass as a friend who is sick." However, applicant's argument is unpersuasive. The book itself is not a service, and simply providing children with coloring books or other educational materials is not in itself an educational service. See *In re Landmark Communications, Inc.* 204 USPQ 692 (TTAB 1979) (newspaper publisher is not rendering educational or information services merely by publishing a newspaper section with educational content).

While the specimen may show that source of the coloring book is applicant, or the source of healthcare or hospital services is applicant, or even that the source of the character name is applicant, it shows neither that applicant is providing an educational service nor that DOTTIE identifies any such service. See *In re Republic of Austria Spanische Reitschule*, 197 USPQ 494,

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499 (TTAB 1977) ("[although a designation] may be demonstrably associated with an applicant, nevertheless it is not registrable unless it is recognizably used as a mark, i.e., to identify and distinguish the goods or services of the applicant.").

Furthermore, while the coloring book may be distributed as part of applicant's efforts to promote health and nutrition to children, as we pointed out earlier, applicant is not seeking registration for a promotional service.

Moreover, the name DOTTIE is not used on this specimen in a manner that would indicate the source of any service. In this specimen as in the first one, DOTTIE is used in a purely informational sense, solely to identify and refer to the character in the story; for example, "When Dottie got to her doctor's office, there were lots of other children there - including her special friends Drew and Recess." This manner of use reinforces consumers' perception of DOTTIE simply as a character name.

Finally, we note applicant's contention that the names of its other characters as well as a variation of the mark in this application have been registered as service marks for the same services. However, as the examining attorney correctly points out, our determination of whether DOTTIE functions as a mark must be based on the record before us. See *McDonald's Corp.*, supra; and *Hechinger Investment Co.*, supra. Based on this record,

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DOTTIE is used to identify, not any educational services, but rather the name of the character itself, and it would be perceived in that manner by the public.

Decision: The refusal to register is affirmed.