

**THIS OPINION IS NOT A  
PRECEDENT OF  
THE T.T.A.B.**

Mailed:  
January 11, 2007

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

Center For Documentary Arts  
v.  
Documentary Arts, Inc.

Opposition No. 91154077  
to application Serial No. 76335434  
filed on November 8, 2001

Todd E. Zenger of Kirton & McConkie for Center For  
Documentary Arts.

Ross Spencer Garsson of Winstead Sechrest & Minick for  
Documentary Arts, Inc.

Before Hairston, Holtzman, and Bergsman, Administrative  
Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Documentary Arts, Inc. seeks registration for the mark  
DOCUMENTARY ARTS on the Principal Register under the  
provisions of Section 2(f) of the Lanham Act for the  
following goods and services:<sup>1</sup>

Sound recordings, namely, prerecorded audio  
cassettes and compact discs and DVD-ROMs featuring

<sup>1</sup> Application Serial No. 76335434 filed November 8, 2001.  
Applicant disclaimed the exclusive right to use the word  
"Documentary."

music, poetry, drama, musical and dramatic performances, narration, cultural, folk and traditional artistic expressions, and the spoken word; prerecorded video cassettes, video discs and laser discs featuring music, poetry, drama, text, narration, musical and dramatic performances, dance, cultural, folk and traditional artistic expressions, films, moving and not moving film and digital images, cultural and folk history; entertainment, educational and documentary motion picture films featuring music, poetry, drama, narration, musical and dramatic performances, dances, cultural, folk and traditional artistic expressions, cultural and folk history, and history; computer software featuring interactive multimedia entertainment, namely interactive visual programming of moving and not moving film and digital images, and interactive sound recording with or without visual images; all in the fields of entertainment, education, music, dance, living art and culture, folk and traditional arts, cultural and folk history, and history, in Class 9;

Printed matter, namely books, sample booklets, pamphlets, brochures, catalogs, finding aids, educational guides and print collections relating to contemporary, archival, vintage and historic photographs and prints featuring living art and culture, historical art and culture, folk and traditional arts, living and historical artists, cultural and folk history, and history, in Class 16; and,

Educational and entertainment services, namely, compiling, collecting, organizing, exhibiting and providing information concerning the artistic expression of different cultures, in the nature of educational programs, cultural awareness programs, lectures, museum, school and other public exhibitions, research archives, radio programs, books, sound recordings, videos, films, and interactive media presentations, and exhibitions; production services, namely production of motion pictures, videos and multimedia products such as CD-ROMs and DVDs and DVD-ROMs, audio programs with and without visual images, contemporary, archival, vintage and historic photographs and ephemera, textual and photographic material for books, and interactive media programs featuring photographs,

**Opposition No. 91154077**

videos, music, dance, and spoken or textual information, for distribution in written publications, over television, cable, satellite, audio and video media, the on-line and global computer network, and through exhibitions, lectures, cultural awareness programs and educational programs; all concerning the artistic expression of different cultures, in Class 41.

Applicant claims first use of the mark anywhere in connection with the goods and services in Classes 9 and 41 on November 27, 1985, and first use in commerce in connection with those goods and services on December 12, 1985. With respect to the goods listed in Class 16, applicant claims first use of the mark anywhere in 1985, and first use in commerce in 1987.

For its claim of acquired distinctiveness, applicant asserts that "The mark has become distinctive of the goods/services through the applicant's substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement."

Center For Documentary Arts has opposed the registration of applicant's mark. In the amended notice of opposition, opposer alleges as its ground for opposition that DOCUMENTARY ARTS is merely descriptive and has not acquired secondary meaning.

Applicant denied the salient allegations in the amended notice of opposition.

Both parties have fully briefed the issues before us.

**Evidentiary Issues**

- A. The Board did not consider the exhibits attached to opposer's brief on the case.

Opposer filed a trial brief with exhibits. However, the facts and argument presented in a brief must be based on the evidence offered at trial. A brief may not be used as a vehicle for the introduction of evidence. TBMP §801.01 (2d ed. rev. 2004). The exhibits attached to opposer's brief will be given consideration only to the extent that such testimony and other evidentiary materials were properly introduced into evidence during the time for taking testimony. TBMP §704.05(b) (2d ed. rev. 2004).

- B. The Board considered the exhibits referenced in the testimony depositions of Leslie Kelen and Kent Miles.

During its testimony period, opposer filed a notice of reliance. There were ten categories of documents. Item No. 10 of the notice of reliance was proffered as copies of printed publications in accordance with 37 C.F.R. §2.122(e). On April 19, 2005, applicant filed a motion to strike *inter alia* Item No. 10 of opposer's notice of reliance on the ground that "these materials are inappropriate for tendering as evidence under a notice of reliance." Opposer failed to file a brief in opposition to applicant's motion. In its September 1, 2005 Order, the Board granted applicant's motion to strike as conceded.

Subsequently, during the testimony depositions of its witnesses Leslie Kelen and Kent Miles,<sup>2</sup> opposer presented the witnesses with its notice of reliance. The witnesses identified many of the previously stricken publications originally offered in opposer's notice of reliance presumably to properly introduce the documents into evidence. The documents referenced in the depositions are Introduction To The Art Of The Movies (a book), printouts from websites, opposer's CDA Center for Documentary Arts brochure, Showing Reality (a book), Documentary Expression And Thirties America (a book), Documentary Photograph (a book), and Bystander: A History of Street Photography (a book).<sup>3</sup> Opposer, however, did not mark the exhibits for identification, did not formally proffer the documents into

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<sup>2</sup> The testimony depositions were taken shortly after applicant filed its motion to strike opposer's notice of reliance.

<sup>3</sup> Opposer also authenticated two letters from Ian McCluskey, Executive Director of NW Documentary Arts & Media, and Joel Meyerowitz, a private photographer, originally proffered as Item No. 9 of opposer's notice of reliance and subsequently stricken by the Board. The contents of letters constitute inadmissible hearsay and have not been considered.

Opposer's witnesses did not subsequently reference the "excerpts from published newspapers" in its depositions. These excerpts are a "hit list" from a search of an unidentified database, by an unidentified person at an unidentified time. Since these documents were stricken pursuant to the Board's September 1, 2005 Order they have been given no further consideration. However, we hasten to add that even if those documents had been considered, they would not have changed our decision.

**Opposition No. 91154077**

evidence, and did not attach a copy of those documents to the testimony depositions.

On February 15, 2006, applicant filed a motion to strike the documents referenced, but not formally made of record, during the opposer's testimony depositions. Applicant argues, in essence, that at no time during the testimony depositions were the exhibits marked for identification or offered into evidence and that, therefore, applicant has been precluded from objecting to the evidence on procedural and substantive grounds.

Applicant's motion to strike the documents referenced, but not formally offered into evidence, is denied. First, a formal proffer of the evidence is not necessary. 37 C.F.R. §2.123(e)(2). Second, the Board has the discretion under 37 C.F.R. 2.123(j) whether to consider unmarked exhibits. *Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845, 847 (TTAB 1984). Finally, under the circumstances of this case, applicant should have known that opposer's witnesses were discussing the subject documents with the intent of making them of record. Opposer had previously filed a notice of reliance proffering those documents to which applicant had filed a motion to strike. When opposer had its witnesses identify and discuss those very same documents during the deposition, it was incumbent upon applicant to raise the procedural objection that opposer had not marked the exhibits for

identification and had not formally offered them into evidence. Such an objection would have clarified opposer's intent. On the other hand, if applicant was somehow under the impression opposer did not intend to make the documents of record, then applicant should have inquired why opposer was eliciting testimony regarding documents on which it was not going to rely or objected to the testimony on relevancy grounds.<sup>4</sup>

Because applicant has received the exhibits, as part of opposer's notice of reliance, and because they were discussed in the depositions, applicant will not be unduly prejudiced by their admission into evidence.

C. Objections raised in opposer's reply brief were not considered.

Opposer, in its main brief, is silent as to any objections to applicant's testimony or evidence that it might have raised. In its reply brief, however, opposer raised objections, on the basis of lack of foundation, to a number of applicant's exhibits introduced during the testimony deposition of applicant's witness Alan Govenar. Because opposer did not raise its objections in its main

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<sup>4</sup> The Board's ruling should not be interpreted as condoning, or in any way approving, opposer's prosecution of the opposition. The manner in which opposer presented its evidence, particularly through its notices of reliance and testimony depositions, made reviewing the record unnecessarily difficult and it prompted needless motion practice.

brief on the case, we deem the objections to be waived.<sup>5</sup> Opposer cannot be allowed to wait until its reply brief to raise objections. Such a tactic effectively forecloses applicant from responding to the objection.<sup>6</sup>

D. Applicant's motion to strike opposer's supplemental notice of reliance is denied.

During its rebuttal testimony period, opposer filed a notice of reliance proffering printed publications pursuant to 37 C.F.R. §2.122(e), which it characterized as a "Supplemental Notice of Reliance". The documents in the notice of reliance were filed to prove the descriptive nature of the term "Documentary Arts." Applicant filed a motion to strike the exhibits to the supplemental notice of reliance. Applicant argued *inter alia* that opposer is precluded from supplementing those portions of the notice of reliance that were previously stricken by the Board. In other words, according to applicant, opposer cannot supplement that which was stricken because there is nothing to supplement. In the Board's December 16, 2005 Order, we deferred deciding whether opposer may supplement the original notice of reliance, but considered whether the

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<sup>5</sup> Moreover, the objections go to the probative value of the evidence, rather than their admissibility, and even if we were to exclude the evidence it would not affect our decision.

<sup>6</sup> As we have deemed the objections waived, we need not consider Applicant's Combined (A) Objections to Opposer's Rebuttal Brief, (B) Response to Opposer's Objections to Applicant's Trial Brief,

exhibits were procedurally proper. In that regard, the Board denied the motion to strike the excerpt from the book Interview with History and the Lexis-Nexis and WestLaw printouts but granted the motion to strike the Internet printouts.

Despite opposer's characterization of its second notice of reliance as a "supplemental notice of reliance," we construe the second notice of reliance as rebuttal because it was filed during opposer's rebuttal testimony period. Nevertheless, the evidence in that notice of reliance properly forms part of opposer's case-in-chief rather than rebuttal. However, because applicant has not objected to the supplemental notice of reliance as improper rebuttal or that it is otherwise untimely, we have considered the evidence as if it were properly and timely filed.

E. Summary of Admissible Evidence

In addition to the application file, the admissible evidence in this case includes the following:

1. Opposer's testimony and evidence.
  - a. Opposer's notice of reliance comprising the following documents:
    1. Applicant's responses to opposer's first set of interrogatories;

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And (C) Reply To Applicant's Objections to Opposer's Trial Brief and Motion to Strike.

2. Applicant's responses to opposer's first set of requests for admission;
  3. Applicant's document No. DA 000102; and,
  4. Exhibit U to the Declaration of Dr. Alan Govenar (in support of Applicant's Reply to its Motion to Dismiss and Opposition to Opposer's Motion to Amend its Notice of Opposition).
- b. Opposer's "Supplemental Notice of Reliance" comprising the following documents:
1. Oriana Fallaci: Interview with History;
  2. Seven LexisNexis articles *circa* 1980-2001; and,
  3. "NY Times critic discusses photography as an art form", *Cornell Chronicle* (October 9, 1997).
- c. Testimony deposition of Leslie Kelen; and
- d. Testimony deposition of Kent Miles.

The following documents are considered as exhibits to the Kelen and Miles depositions:

1. Introduction To The Art Of The Movies;
  2. Printouts from websites;
  3. CDA Center for Documentary Arts brochure;
  4. Showing Reality;
  5. Documentary Expression And Thirties America;
  6. Documentary Photograph; and,
  7. Bystander: A History of Street Photography.
2. Applicant's evidence

Applicant's evidence comprises the testimony deposition of Alan Govenar and the exhibits attached thereto.

**Acquired Distinctiveness**

Opposer argues that because applicant's mark DOCUMENTARY ARTS is used in connection with documentaries, it is merely descriptive and, therefore, not registrable. Moreover, opposer asserts that there is no evidence that applicant's mark DOCUMENTARY ARTS has acquired distinctiveness (e.g., no survey, no evidence of consumer perception, no use of a superscript <sup>™</sup> or <sup>SM</sup> to indicate trademark use). Specifically, opposer contends that applicant has used DOCUMENTARY ARTS as a trade name, rather than as a trademark or service mark, and that applicant's failure to present evidence of trademark use precludes applicant's claim of acquired distinctiveness. In addition, opposer asserts that its use of the term "Documentary Arts" precludes acquired distinctiveness on behalf of applicant.

According to opposer, "The term Documentary Arts . . . suggests . . . the multitude of innovative documentary projects . . . by American writers, photographers, journalists, oral historians, filmmakers, radio documentarians, installation artists, illustrators, visual artists, curators, composers, and historians." (Miles Dep., p. 27, quoting the CDA Center for Documentary Arts

brochure).<sup>7</sup> Leslie Kelen testified that "documentary arts" are the "tools that are used by artists to tell the stories of our community . . . using very broadly the documentary, the tools of documentary work." (Kelen Dep., p. 8).

The evidence introduced by opposer in support of its claim demonstrates that the term "Documentary Arts" is merely descriptive. For example, four of the LexisNexis articles use the term "documentary art" to describe documentaries as an art form.<sup>8</sup>

United Press International, November 17, 1980:

"Macpherson's editorial cartoons are a true manifestation of 20th century documentary art," Dominion Archivist Wilfred I. Smith said Monday.

PR Newswire Association, Inc., February 24, 1982:

Patti Blue's documentary on "Carrie" (Life), the story of a woman's struggle against multiple sclerosis, covered all the criteria of photo-documentary art: a photograph which needed "neither words nor continuity to tell its story."

*New York Times*, February 10, 1985:

For 10 years, he produced the "National Geographic Specials." He has been acclaimed for his 1960 documentary, "The Race for Space," "The Rise and Fall of the Third Reich," "The Making of the President, 1960," and scores of films that have largely defined the documentary art for others.

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<sup>7</sup> The CDA Center for Documentary Arts brochure states that "Documentary studies", not "Documentary Arts", are being taught in high schools and universities. Opposer also uses the terms "Documentary Tradition," "documentary expression," and "documentary works" as synonyms for "Documentary Arts."

<sup>8</sup> The other three articles and the Cornell Chronicle article do not reference the term "documentary art."

*Chicago Tribune*, March 15, 1985:

Surrealism, and the images it inevitably raises of Salvador Dali paintings with all those melting clocks, seems totally at odds with the documentary art form of photography.

Six websites reference the U.S. Air Force Documentary Arts Program, one website references a "body of documentary art", and two websites reference individuals as documentary artists.

The remainder of opposer's evidence is used to prove that documentaries may be considered an art form, but there is no other use of the term "Documentary Arts" referring to documentaries or making documentaries.

We initially note that "where, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the *statute* accepts a lack of inherent distinctiveness as an established fact." *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1571, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) (Emphasis in the original). In other words, the mark at issue is considered to be merely descriptive and the only remaining issue is whether the mark has acquired distinctiveness. *Id.* Thus, opposer was not required to advance evidence that DOCUMENTARY ARTS was merely descriptive, but rather was required to make a *prima facie* case that DOCUMENTARY ARTS had not acquired distinctiveness. As explained in *Yamaha*

*International Corp. v. Hoshino Gakki Co. Ltd.*, when matter proposed for registration under Section 2(f) is approved for publication, there is a presumption that the examining attorney found a *prima facie* case of acquired distinctiveness. *Id.*, 6 USPQ2d at 1004. In an *inter partes* proceeding, the plaintiff has the initial burden to establish a *prima facie* case that the applicant did not satisfy the acquired distinctiveness requirement of Section 2(f). *Id.*, 6 USPQ2d at 1005; *Omnicom Inc. v. Open Systems*, 19 USPQ2d 1876, 1878 (TTAB 1989). As further explained in *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, “[I]f the opposer does present its *prima facie* case challenging the sufficiency of applicant’s proof of acquired distinctiveness, the applicant may then find it necessary to present additional evidence and argument to rebut or overcome the opposer’s showing and to establish that the mark has acquired distinctiveness.” *Id.*

While opposer presented documentary evidence and testimony that DOCUMENTARY ARTS is merely descriptive, it simply did not carry its initial burden of establishing that applicant did not satisfy the acquired distinctiveness requirement of Section 2(f). Specifically, opposer has not shown that DOCUMENTARY ARTS is so highly descriptive or in such common use that applicant’s claim of five years substantially exclusive and continuous use is an

**Opposition No. 91154077**

insufficient basis upon which to base its claim of acquired distinctiveness. Opposer attacked applicant's claim of acquired distinctiveness by referencing applicant's testimony and exhibits and fashioning legal and factual arguments based on several false premises.

Contrary to opposer's contention, applicant may rely on trade name use in determining registrability of a mark under the provisions of Section 2(f). The use required to establish rights in a trademark is not limited to technical trademark use. An open and public use of a term as a trade name in connection with a viable business entity may be sufficient so long as such use creates an association of the term with the product or a single source. *Liqwacon Corp. v. Browning-Ferris Industries, Inc.*, 202 USPQ 305, 308 (TTAB 1979); *In re Texaco Inc.*, 143 USPQ 364, 366 (TTAB 1964) (THE TEXAS COMPANY has become distinctive of applicant's goods in view of its continuous and extensive use as a trade name and a trademark). *See also, Floss Aid Corp. v. John O. Butler Co.*, 205 USPQ 274, 284 (TTAB 1979) (trade name use considered in establishing acquired distinctiveness).

Also, opposer's "bright line" distinction between trademarks and trade names does not exist.<sup>9</sup> A designation

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<sup>9</sup> Opposer's reliance on *In re Pennsylvania Fashion Factory, Inc.*, 588 F.2d 1343, 200 USPQ 140 (CCPA 1978) is misplaced. In that case, applicant applied to register a stylized version of THE FASHION FACTORY for clothing supported by specimens comprising paper bags. The Court held that this usage of the mark

may be used as both a trademark and a trade name. The critical question vis-à-vis registrability is whether the designation is used to identify and distinguish products and services as distinguished from or in addition to identifying the corporate entity. *Liqwacon Corp. v. Browning-Ferris Industries, Inc.*, *supra* at 318; *In re Walker Process Equipment, Inc.*, 233 F.2d 329, 332, 110 USPQ 41, 43 (CCPA 1956), *aff'g* 102 USPQ 443.

The fact that applicant did not use a superscript <sup>TM</sup> or <sup>SM</sup> is not determinative. *In re Remington Products Inc.*, 3 USPQ2d 1714, 1715 (TTAB 1987). *Cf. In re Morganroth*, 208 USPQ 284, 287 (TTAB 1980) ("the use of the "TM" does not, ipso facto, make a trademark or service mark out of the term or expression in connection with which it is used"); *In re Plymouth Cordage Co.*, 122 USPQ 336 (TTAB 1959) (the fact that applicant's shipping tags refer to a notation as a trademark does not make it a trademark). Whether a term performs the function of a trademark depends upon its manner of use and the probable impact of that use on customers. *In re Morganroth, supra*; *In re Moody's Investors Service Inc.*, 13 USPQ2d 2043, 2047 (TTAB 1989).

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identified the store and, therefore, constituted trade name usage. Had applicant sought to register the mark for retail store services or submitted labels as specimens instead of bags, the result would have been different. The Court did not hold that a trade name could never be a trademark. This case stands for the proposition that it is the manner of use that determines whether a designation is a trademark, trade name, or both.

Likewise, the fact that applicant did not introduce a secondary meaning survey is not determinative. Direct consumer perception evidence in the nature of surveys or dealer or customer testimony is not a prerequisite for establishing acquired distinctiveness. *Yamaha International Corp. v. Hoshino Gakki Co., Ltd.*, 231 USPQ 926, 934 (TTAB 1986), *aff'd*, 6 USPQ2d 1001, 1010 (Fed. Cir. 1988) (the Court noted that there was no direct consumer perception evidence that the mark had not acquired distinctiveness).

With regard to opposer's argument that its use of the term should preclude the registration of DOCUMENTARY ARTS to applicant, applicant's use of the mark does not have to be exclusive, but may be "substantially" exclusive. This makes allowance for use by others that may be inconsequential or infringing and which, therefore, does not necessarily invalidate the applicant's claim. *L.D. Kichler Co. v. Daviol Inc.*, 192 F.3d 1349, 52 USPQ2d 1307, 1309 (Fed. Cir. 1999); *Yamaha International Corp. v. Hoshino Gakki Co., Ltd.*, *supra* 6 USPQ2d at 1010 (affirming Board's rejection of section 2(f) trade dress opposition, in spite of evidence that four other companies made similar products prior to registration).

In this case, opposer began its operations in 1983 as the Oral History Institute. (Kelen Dep., p. 40). In 2000, opposer changed its name to the Center for Documentary Arts.

(Miles Dep., pp. 42-43; Kelen Dep., pp. 43-44). Through 2001, when opposer first learned of applicant, opposer was in the process of converting from the Oral History Institute to the Center for Documentary Arts. (Kelen Dep., pp. 44-45). There is no other evidence of third-party use of "Documentary Arts."<sup>10</sup> Accordingly, because opposer was in the process of changing its corporate image to The Center for Documentary Arts from the Oral History Institute shortly before applicant filed its application, such use is not sufficient to invalidate applicant's claim of acquired distinctiveness.

Finally, to the extent that opposer argues that applicant has not made technical trademark use of DOCUMENTARY ARTS, opposer's argument in this regard is not well taken. Applicant has introduced extensive evidence of its use of the DOCUMENTARY ARTS trademark. Representative examples of applicant's technical trademark use of DOCUMENTARY ARTS include the following:

<b>Govenar Exhibit No.</b>	<b>Identification</b>	<b>Date</b>
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<sup>10</sup> We are aware that the internet printouts reference the U.S. Air Force Documentary Arts Program. However, internet evidence is admissible for what it shows on its face. *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1371 (TTAB 1998). There is no independent evidence or testimony regarding the Air Force program, when it started, whether it is still in existence, or the extent of its advertising or promotion. Therefore, the internet evidence has very little probative value regarding the use of the term "Documentary Arts" vis-à-vis the U.S. Air Force Documentary Arts Program.

19	"Then and Now" audio cassette tape	1989
22 & 23	"Black on White, White on Black" video cassette	1990
35	"Masters of Traditional Music" video cassette	1991
<b>Govenar Exhibit No.</b>	<b>Identification</b>	<b>Date</b>
36	"A Selection of Contemporary Prints from the Collaboration of Artists and Printers" catalog for an exhibition	1992
38	Promotional postcard for the "Accordion Kings" folk music festival	1993
47	Promotional postcard for the "Portraits of Community" African American photography in Texas	1994
54	"Black Cowboy Blues and Church Songs" CD-ROM	1994
65	"The Music of the Hmong People of Laos" CD-ROM	1995
61	"The Shipwreck of La Belle" video cassette	1998
66	"Masters of Traditional Arts" CD-ROM	2000

In this case, opposer failed to prove that the term "Documentary Arts" is so highly descriptive that applicant's claim of five years substantially exclusive and continuous use is not a sufficient claim of acquired distinctiveness. Therefore, we find that opposer failed to make its *prima facie* case and that applicant was under no burden to rebut opposer's showing.

Decision: The opposition is dismissed.