

THIS DISPOSITION IS NOT CITABLE AS
PRECEDENT OF THE TTAB

JULY 1, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Taylor Corporation
v.
Barbara Schaffer

Opposition No. 98,357
to application Serial No. 74/483,306
filed on January 27, 1994

Laura J. Hein of Gray, Plant, Mooty, Mooty & Bennett for
opposer

Robert H. Ware of Ware, Fressola, Van Der Sluys & Adolphson
for applicant

Before Rice, Simms and Walters Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Taylor Corporation filed its opposition to the
application of Barbara Schaffer to register the "angel
cartoon character design" shown below for "printed
publications, namely greeting cards, cartoon books and
illustrated children's books."¹

¹ Application Serial No. 74/483,306, filed January 27, 1994, in
International Class 16, based on an allegation of use in commerce in



As grounds for opposition, opposer asserts that it and its predecessors in interest have for many years "been in the business of creating, manufacturing and selling greeting cards and related social stationery, all in original designs"; that applicant "was a full-time employee of opposer [or its predecessors in interest] for twenty years, from approximately 1974 until approximately April 1, 1994"; that "in the course of performing her duties as opposer's employee, applicant created numerous original greeting card designs" used by opposer in its lines of greeting cards; that "Applicant created for and on behalf of opposer in the course of her employment" a series of Christmas card designs featuring "little angels"; that cards bearing these designs have been sold by opposer under the mark JOY; that the JOY line of cards "[is] among opposer's most popular product lines and [has], for many years, represented a significant portion of opposer's sales"; that opposer is the owner of all of the designs created by applicant during the course of

connection with the identified goods, alleging dates of first use and use in commerce as of 1968.

her employment by opposer, including the applied-for angel cartoon character design.

Opposer alleges, further, that the industry and public have come to recognize these designs "as the property and trademark of Opposer" by virtue of opposer's "long and exclusive use" thereof on its products;² and that applicant's mark, when applied to applicant's goods, "if any," so resembles opposer's marks, as to be likely to cause confusion under Section 2(d) of the Trademark Act.

Applicant, in its answer, denies the salient allegations of opposer's claims and asserts that the "little angel" character "is the exclusive property of Applicant"; and that "by publishing particular cartoons [designed by applicant] as greeting cards or Christmas cards, opposer and its predecessor acquired no title or ownership interest in Applicant's original cartoon character."

In addition, applicant affirmatively asserts that, although she was a full-time employee of David Forer & Company, which published many of her designs, David Forer "never claimed title or ownership rights in [applicant's] original Little Angel character per se, and never requested, received or asserted any trademark rights therein" (emphasis in original); that opposer's predecessors in interest have

² Opposer claims that it "is the owner of numerous other trademarks and federal trademark registrations, including the marks MASTERPIECE STUDIOS (Registration No. 956,528), THE FORERS (Registration No. 1,249,802), and BRETT-FORER (Registration No. 1,220818)." However, opposer has not made any of its claimed registrations of record in this proceeding, and we have not considered them herein.

not "claimed or displayed as a trademark" applicant's designs other than "one cherub carrying a JOY placard" in connection with Forer or Brett-Forer cards; and that applicant's designs are recognized "as a cartoon character trademark for Applicant's drawings." Applicant concedes that in August, 1994, applicant and opposer entered into a "free-lance commission agreement" for "eleven different greeting card artwork designs, all or most for Christmas cards, by which applicant assigned the artwork, and its copyrights and reproduction rights to opposer for use as greeting cards or catalogs therefor." Applicant alleges, however, that under the terms of the agreement applicant "expressly retained 'all rights to copyright, use, display and publish derivative artwork and reproductions thereof for non-greeting card products'"³; and that by this agreement, opposer "has clearly waived any rights it might otherwise have claimed in Applicant's cartoon character trademark."⁴ Applicant also alleges "unclean hands and predatory misconduct" on the part of opposer.

The record consists of the pleadings; the file of the involved application; the testimony depositions of applicant, Barbara Schaffer, as taken by each party; the

³ We note that some of the arguments and evidence of both parties concern the ownership of a copyright in the "little angel" designs. The question before us concerns the registrability of the applied-for design and, thus, we have not considered the issue of copyright in our determination.

⁴ In her brief, applicant argues that she licensed use of the mark at issue to opposer. Since applicant failed to offer any evidence in support of this argument we have not considered it.

testimony deposition of Jay Stein, executive vice president of Butterick, Inc., a predecessor in interest to opposer; the testimony depositions of David Forer and Margery Forer, former principals of D. Forer & Company, also a predecessor in interest to opposer; and opposer's and applicant's exhibits in connection with the aforementioned testimony.⁵ Both parties filed briefs on the case but an oral hearing was not held.

The evidence in this case establishes that opposer is the successor in interest to the business of D. Forer & Company (Forer), an independent company that designed, produced and sold greeting cards. Forer was founded in 1949 and operated by David and Margery Forer, both of whom remained with the business until they retired during 1991 or 1992. In December, 1986, Butterick, Inc. (Butterick) purchased all of the assets of Forer, except the manufacturing facility. Butterick, through its wholly-owned subsidiary, Masterpiece Studios, continued to operate the business, which apparently was known as both D. Forer & Company and Brett-Forer Greetings, Inc. Elise Falkinberg, of Butterick, eventually took over operation of Forer from David and Margery Forer. In December, 1993, Forer was purchased by opposer, Taylor Corporation, as part of an agreement to acquire Masterpiece Studios by Chicago

⁵ Opposer made a number of objections during the course of applicant's testimony deposition. However, while applicant argued against these objections in her brief, the objections were not renewed by opposer in its brief. Thus, we consider these objections to have been waived.

Holdings, a company formed by Taylor Corporation to make this acquisition.

The record establishes, also, that applicant began designing greeting cards for various companies in approximately 1961; and that she created a series of designs she denominated as "little angel" designs which consisted of drawings of stylized angels with consistent characteristics that were portrayed in various poses and scenes. In 1966, applicant was hired by Forer to design greeting cards and she eventually became Forer's art director. Applicant worked for Forer and its successors in interest as a salaried employee until 1994, with the exception of a one-year period, from 1983 to 1984, during which applicant worked on a free-lance basis designing greeting cards for Forer and, during the same time period, pursued other business unrelated to the design or sale of greeting cards. Following the termination of her employment by opposer, applicant continued to design greeting cards for opposer on a free-lance basis through 1994. At various times throughout her long period of employment for opposer and its predecessors in interest, applicant did free-lance design work for other companies or individuals for use on greeting cards and other products; however, she made her "little angel" designs only for the greeting cards of opposer and its predecessors in interest.

Forer developed and offered several lines of greeting cards, each line having distinct characteristics and these

product lines were continued by Forer's successors in interest. Applicant designed cards primarily for opposer's and its predecessors' Joy line, comprising informal and often humorous designs. Applicant's "little angel" designs appeared as the front page design of a significant part of the Joy line of cards for many years. The trademark JOY is used in connection with the Joy line of greeting cards on the backs of the cards and in catalogs. The evidence establishes that for about six years during the 1980's, the JOY trademark was featured on the backs of the Joy line of cards as follows.

Following the purchase of Forer by Butterick, and its operation by Masterpiece Studios, the trademark JOY appeared on the backs of the Joy line of cards as follows.

We note that the applied-for design is not the same as the JOY trademark featuring the angel and placard design, which was used as a trademark during the 1980's in

connection with Forer's greeting cards.⁶ Similarly the applied-for design is not the same as the designs depicted on the fronts of the several cards submitted as specimens and as evidence in this case, although all of the angels are similar stylistically. The angel depicted in the applied-for design is the same as the angel depicted in part of the design on the front of one of opposer's cards. However, such design on the front of the cards is different from the particular design comprising the applied-for design and it is not a trademark. Rather, the evidence of record shows the applied-for design used only as part of one ornamental cover for greeting cards.

There is no question that applicant is the creator of the "little angel" designs, which include the applied-for design. Not only do the parties not dispute this fact, but the greeting card catalogs of opposer and its predecessors tout this fact. Applicant testified that the applied-for design, as well as all the "little angel" designs, have been used as cover designs on greeting cards produced and sold by opposer or its predecessors in interest; and that, outside of her employment for opposer and its predecessors, she has not produced or sold greeting cards using the aforementioned designs. Applicant testified, further, that, except for a small number of figurines sold at crafts fairs during the

⁶ It is not relevant to the issues before us to determine the ownership

1980s, she has not used any "little angel" design, including the applied-for design, as a trademark or in any other manner in connection with any of the goods identified in the application.

There is also no question, and the parties do not dispute, that applicant created the "little angel" designs for greeting cards in the context of her employment for opposer and its predecessors⁷; and that the "little angel" designs were and are used by opposer and its predecessors on greeting cards as cover designs.

Opposer argues, essentially, that, because applicant has not used the applied-for design in connection with greeting cards outside the scope of her employment for opposer and its predecessors, or in connection with the other identified goods at all, any trademark rights arising in the applied-for design in connection with greeting cards inure to opposer's benefit. Opposer concludes that, therefore, any use by applicant of the applied-for design in connection with any of the identified goods will result in a likelihood of confusion, under Section 2(d) of the Act, with opposer's use of the same mark in connection with greeting cards.

The term "trademark," as defined in the relevant part

of this mark as it is clearly not the mark applied for herein.

⁷ While applicant may have conceived and drawn little angels prior to her employment by Forer, there is no evidence that, prior to her employment by Forer, she either created or used the specific designs

Opposition No. 98,357

of Section 45 of the Trademark Act, means "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." Clearly, not every word, combination of words, or design which appears on an entity's goods functions as a trademark. *In re Remington Products Inc.*, 3 USPQ2d 1714 (TTAB 1987). Thus, the mere fact that the applied-for design may appear on the cover of greeting cards does not make it a trademark. 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 for the goods. Mere intent that a designation function as a trademark is not enough in and of itself to make that designation a trademark. *id.*

A critical element in determining whether a term is a trademark is the impression the term makes on the relevant public. In the case before us, the inquiry is whether the design sought to be registered would be perceived as a source indicator or, rather, as merely an ornamental design in connection with the identified goods. We find nothing in the record to indicate that either party adopted or used the design which is the subject matter of this application as a

appearing on opposer's and its predecessors' greeting cards.

trademark in connection with greeting cards or the other identified goods. Thus, opposer's case must fail because opposer has not established it owns a proprietary interest in the applied-for design as a trademark in connection with greeting cards.

The evidence concerning applicant's salaried and free-lance work for opposer and its predecessors is silent on the trademark significance of the "little angel" designs, in general, and the applied-for design, in particular. Because the evidence has not established that the applied-for design is a trademark, it is irrelevant that the 1994 free-lance agreement between opposer and applicant addresses ownership of trademarks. Similarly, it is irrelevant that portions of asset purchase agreements purportedly transferring the Forer business first to Butterick and later to opposer appear to convey trademark rights as part of the predecessor's assets without specific mention of the applied-for design or the little angel designs.⁸

In conclusion, opposer has not established that it is the owner of trademark rights in the applied-for design in connection with greeting cards. Nor has opposer established

⁸ While, in view of our decision, it is unnecessary to consider the substance of the agreements made of record, we note that the incomplete nature of the purported asset purchase agreement submitted as Stein Exhibit No. 2 renders it of little probative value for any purpose. In particular, the portion of the agreement submitted does not indicate the parties to it and Mr. Stein's testimony in this regard is not entirely clear as to what parties are involved. Further, the portion of the agreement submitted does not include a copy of Schedule 12 which

ownership of any mark or marks in connection with greeting cards for which there is a likelihood of confusion with the applied-for design as it may be used in connection with the identified goods.⁹

Because we have determined that applicant has not used the applied-for design in connection with any of the goods identified in the application and, further, that any use that may have been made of the subject matter of this application appears to have been merely as part of an ornamental design on greeting cards, we hereby remand the application to the Examining Attorney to refuse registration on the ground that the applied-for design is not used as a trademark. Trademark Rule 2.131.

purports to identify the trademarks involved in the transfer.

⁹ The only trademark involving an angel design shown in this record is the trademark of the angel holding a placard with the word JOY thereon, which the evidence shows was used only during the 1980's. In the absence of evidence of continuing use of this mark, we presume this mark is abandoned. Therefore, we do not consider the question of likelihood of confusion of this mark with the applied-for design, in the event that such design could be shown to be a trademark owned by applicant.

Opposition No. 98,357

Decision: The opposition is dismissed. The application is remanded to the Examining Attorney to refuse registration, consistent with the facts found herein, on the ground that the subject matter of the application is not used as a trademark.

J. E. Rice

R. L. Simms

C. E. Walters
Administrative Trademark
Judges, Trademark Trial and
Appeal Board