

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB MAY 31, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Michael Russell

Serial No. 74/411,812

J.W. Gipple of Gipple & Hale for Michael Russell.

Katherine Bush, Trademark Examining Attorney, Law Office
112 (Janice O'Lear, Managing Attorney).

Before Simms, Wendel and Bucher, Administrative Trademark
Judges.

Opinion by Simms, Administrative Trademark Judge:

Michael Russell (applicant) has appealed from the
final refusal of the Trademark Examining Attorney to
register the asserted mark DEWIE, DICKUM & HOWE for paper,
paper articles, printed matter, namely, stationery and

Ser. No. 74/411,812

business cards.¹ The Examining Attorney has refused registration on the ground that the asserted mark does not function as a trademark to identify and distinguish applicant's goods (Sections 1, 2 and 45 of the Act, 15 USC §§1051, 1052 and 1127). Applicant and the Examining Attorney have submitted briefs but no oral hearing was requested.

We affirm.

Some of the specimens of record, a business card and a letterhead, are reproduced below.

¹ Application Serial No. 74/411,812, filed July 13, 1993, based upon applicant's bona fide intention to use the mark in commerce. After a Notice of Allowance was issued, applicant filed a Statement of Use on November 28, 1997, based upon use and use in commerce since February 1997. It appears that the delay in the prosecution of this application was occasioned by the loss of the original file and the need to reconstruct a new one.

It is the Examining Attorney's position that, considering the commercial impression of applicant's asserted mark and the significance of that mark, it would be perceived as a humorous play on words on a fictitious business card or stationery and not as a trademark indicating origin of the goods. The Examining Attorney notes that the asserted mark is displayed prominently in the center of business cards and at the top of the sample piece of stationery. The Examining Attorney contends that business cards typically convey information such as the name of a firm or person, title, address, telephone number, etc. Here, the Examining Attorney argues that the asserted mark is not on an ordinary business card but as a humorous novelty item and that the asserted mark would therefore not be perceived as a trademark but rather as an "ornamental feature" of the goods.

Applicant, on the other, contends that the asserted mark functions as a trademark to indicate the source of the goods and distinguishes those goods from the products of others. Applicant argues that the asserted mark is not an informational or instructional slogan, as was the situation in some of the cases cited by the Examining Attorney.² See

² Applicant also contends that this Office has made a prior determination that his service mark is registrable and that this

Ser. No. 74/411,812

In re Remington Products, Inc., 3 USPQ2d 1714 (TTAB 1987) (PROUDLY MADE IN THE USA used in connection with electric shavers does not function as a trademark) and In re Tilcon Warren, Inc., 221 USPQ 86 (TTAB 1984) (WATCH THAT CHILD on a bumper sticker attached to construction vehicles does not function as a mark for construction material).

We agree with the Examining Attorney that the asserted mark is not likely to be perceived as a trademark indicating source or origin of business cards and stationery. As has often been stated, not all words, designs, symbols or slogans used in the sale or advertising of goods or services function as trademarks or service marks for those goods or services. Here, the specimens themselves indicate that the asserted mark is the name of a fictitious law office. Purchasers, therefore, are likely to view the asserted mark as simply the humorous "off-color" name of a law firm and not as an indication of origin of the business cards or stationery on which they appear. Even for those who do not understand the nature of the message conveyed by the asserted mark, we believe that

determination is entitled to a presumption of validity. In this regard, the Examining Attorney's explanation, on page 8 of her brief, concerning the examination of intent-to-use applications and the subsequent examination of specimens filed with amendments to allege use and statements of use, is well taken. See also TMEP §905 *et seq.*

Ser. No. 74/411,812

these words would not function as a mark indicating origin of the goods. Business cards which present the name of a law firm, for example, serve to demonstrate use of that law firm's name as a service mark used in connection with the performance of legal services but do not generally act as a vehicle to identify the company that is the source of the paper products themselves.

Decision: The refusal of registration is affirmed.

R. L. Simms

H. R. Wendel

D. E. Bucher
Administrative Trademark
Judges, Trademark Trial and
Appeal