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Paper No. 22
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Publishing Group of America, Inc.

Serial No. 75/578,828

Donald L. Zachary of Bass, Berry & Sims, PLC for Publishing Group of America, Inc.

Michael Levy, Trademark Examining Attorney, Law Office 110
(Chris A.F. Pedersen, Managing Attorney).

Before Simms, Bucher and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Publishing Group of America, Inc. has applied to register AMERICAN PROFILE as a trademark for goods identified as "newspaper supplements in the field of lifestyles of rural America," in International Class 16.¹ The Examining Attorney has refused registration under Section 2(e)(1) of the Lanham

¹ Serial No. 75/578,828 was filed as an intent-to-use application seeking registration for goods and services in two classes. It subsequently was amended to delete the services class and, still later, was amended to assert use in commerce for the remaining goods class.

Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark is merely descriptive of the goods.

When the refusal of registration was made final, applicant appealed. The issue on appeal has been thoroughly briefed and both applicant's counsel and the Examining Attorney presented oral arguments to the Board.²

We affirm the refusal of registration.

The record on appeal includes dictionary definitions of the words "American" and "profile," five registrations for marks including the word "profiles," and two declarations with exhibits from L. Daniel Hammond, president and CEO of applicant. In its reply brief, applicant argues that the Examining Attorney has ignored registered marks "cited on Page 16 of PGA's Appeal Brief" and which include either the term "American" or "profile." We note, however, that while the Examining Attorney made of record copies of the five

² The application was examined by former Examining Attorney James Menker, who issued a final refusal of registration for the one class of goods, based on both Sections 2(d) and Section 2(e)(1) of the Lanham Act. Senior Attorney Michael Levy assumed responsibility for the application during the appeal and filed the Office's appeal brief. In that brief, he withdrew the final refusal based on Section 2(d). At approximately the same time that Mr. Levy filed the Office's brief, applicant filed its statement of use and a request to supplement the record with additional evidence, so that these respective submissions crossed in the mail. Shortly thereafter, applicant filed its reply brief, in response to Mr. Levy's brief.

Mr. Levy addressed applicant's additional evidence, clarified the issue on appeal, introduced countervailing evidence, and responded to the arguments in applicant's reply brief. Finally, applicant was permitted to file a supplemental reply brief.

registrations he discussed in his office action, applicant never made of record copies of any of the registrations it cited. As a result, the registrations cited by applicant have little, if any, probative value.³ The declarations and associated exhibits of Mr. Hammond were offered primarily in response to the refusal of registration under Section 2(d). Nonetheless, we have considered them for what probative value they hold in regard to the Section 2(e)(1) refusal. In conjunction with the last Office action, issued after the applicant supplemented the record during the pendency of the appeal, Senior Attorney Levy added to the record excerpts of articles retrieved from the NEXIS database, to show that the term "profile" is "commonly used in referring to magazine features."

The theory supporting the Office's refusal of registration changed somewhat, although not significantly, as a result of the change from Examining Attorney Menker to

³ Without copies, there is no indication whether each of the registrations includes a disclaimer, is based on a claim of acquired distinctiveness, or is on the Supplemental Register. To illustrate the difficulty of assessing registrations that are cited by list alone, we note information from Office records regarding just two of the registrations cited by applicant. First, registration no. 2,224,024 for AMERICAN PROFILE for various items of wearing apparel, includes a disclaimer of "American." Second, registration no. 2,268,532 for PEOPLE POP PROFILES for "conducting public opinion surveys in relation to celebrities, television programs and cultural phenomena," includes a disclaimer of "Profiles."

Senior Attorney Levy. In the initial office action, the Examining Attorney argued that a "profile" is defined as "a biographical essay presenting the subject's most noteworthy characteristics and achievements," that profiles are "a type of newspaper supplement," that "American" is a primarily geographical term and "is descriptive of the nationality of the people likely to be portrayed in 'profiles' in newspaper supplements," and the composite AMERICAN PROFILE merely describes the subject matter of applicant's newspaper supplements. In the final refusal, the Examining Attorney acknowledged applicant's argument that "profile" has various definitions but argued that, as used in conjunction with applicant's goods, the term would most readily be taken to mean a biographical essay-type of profile; and the Examining Attorney relied on the existence of registrations of marks including the term profiles "in connection with goods similar to applicant['s]" to support his argument that the PROFILE portion of applicant's mark is descriptive.⁴ Finally, in his denial of applicant's request for reconsideration, the

⁴ NORTH AMERICA PROFILES and INTERNATIONAL PROFILES are registered under Section 2(f) of the Lanham Act for travel books; SPORTS PROFILES, in stylized script, also is registered under Section 2(f), for magazines relating to athletics and physical fitness; PLANT PROFILES is registered on the Supplemental Register for a business information service providing plant information to industry; PROFILES and design for a "column in a weekly publication" also is registered on the Supplemental Register.

Examining Attorney argued that "[a]s stated in Exhibit 8 of the applicant's Request for Reconsideration[,] the applicant's newspaper supplement[s] feature 'hometown profiles' and are [']for and about millions of Americans who cherish hometown life.'... Thus, a significant feature of the applicant's newspaper supplements are the 'profiles' of 'American' people and 'American' communities."⁵

In briefing this appeal, the Senior Attorney introduced new dictionary definitions of "American" and "profile" and argued that "the dictionary definitions show that the mark describes an analysis of an American subject i.e. an AMERICAN PROFILE." The Senior Attorney also argued that "the mark clearly describes that the supplements contain a profile [sic] of American subjects, in particular, lifestyles of rural America." He supported the argument by referencing exhibits submitted with applicant's request for

⁵ The Examining Attorney also asserted that applicant had essentially conceded that AMERICAN PROFILE is not particularly distinctive and is weak. We do not, however, see the statements by applicant as such a concession. They were made in the context of applicant's attempt to show that the registered mark AMERICAN PROFILE, which was then still cited under Section 2(d) as a bar to its application, was weak and entitled to only a narrow scope of protection. There is nothing improper about an applicant's arguing, on the one hand, that a mark registered under Section 2(f) should be considered weak and unlikely to create a likelihood of confusion with the same mark proposed for registration for different goods or services and, on the other hand, that the mark, as proposed for registration by the applicant, would not be merely descriptive.

reconsideration, which exhibits (1) promote the supplements as containing articles with a regional focus on "local celebrities, unforgettable characters, and hometown heroes"⁶ and (2) note that a "special editorial feature" of each supplement will be its "profile of one of America's great hometowns." The Senior Attorney argued that there was no incongruity created by applicant's combination of AMERICAN and PROFILE, and that the existence of other meanings for "profile" is inapposite, since applicant's proposed mark must be considered in the context of its use, not in the abstract. Finally, he relied on the third-party registrations, previously made of record by the Examining Attorney, for marks containing the term "profiles," as evidence of the descriptiveness of the PROFILE portion of applicant's proposed mark and that the instant refusal was "consistent with Office practice."

Applicant, arguing against the initial refusal, asserted only that one hearing the proposed mark would not necessarily believe that it "describes just a newspaper supplement" and could conclude that it referred to "silhouettes, credit repots, intelligence reports and the like." In its request for reconsideration of the final refusal, applicant argued

⁶ Also touted in applicant's exhibit are the supplement's "personality profiles" of national celebrities.

that, in its proposed mark, AMERICAN is not used in a geographic sense but, rather, in an arbitrary or suggestive sense, because "[i]t does not signify the inserts are printed in America or sold in America, and would describe almost any product." Applicant also argued that the significance of the term PROFILE must be viewed from the perspective of the prospective purchasers of applicant's goods, i.e., publishers of newspapers and advertising executives, and that they "could not possibly reach a conclusion about the nature of [applicant's] product solely by viewing the proposed mark" and "would have to use... imagination extensively to determine what [applicant's] supplements contain." Further, applicant argued that in view of the multitude of possible definitions for the term PROFILE, and the Hammond declaration establishing that applicant's supplements cover a multitude of subjects, could at most suggest some idea of the contents. Finally, applicant argued that the composite AMERICAN PROFILE cannot be refused as descriptive because it does not describe an "essential quality of the newspaper supplement" and "merely suggests possible subjects that the supplement might contain, that is, profiles of 'something,' but what those 'somethings' might be is left totally to the imagination."

In briefing the appeal, applicant essentially reiterated the arguments made during prosecution of the application. In

addition, to counter the Examining Attorney's contention that PROFILE would be understood to refer to a biographical sketch of a subject's noteworthy characteristics and achievements, applicant argued that submitted copies of its supplements are evidence that they do "not contain ...discussions of persons or people that includes [sic] their most noteworthy characteristics and achievements." It also argued that, because of the plethora of definitions of both AMERICAN and PROFILE, and the possible combinations thereof, "purchasers of AMERICAN PROFILE cannot tell, simply from the title, what will be contained in the magazine."

Titles for publications such as newspapers and magazines often present perplexing problems, because of the tendency of their publishers to use the titles to convey some idea of the content of their publications. See H. Marvin Ginn Corp. v. Int'l Assn. Of Fire Chiefs, 782 F.2d 987, 990, 228 USPQ 528, 530-31 (Fed. Cir. 1986). As a result of the tendency toward revelation of content, most reported cases dealing with titles of publications deal with the question whether they are descriptive or generic, not descriptive or suggestive. See Technical Publishing Co. v. Lebhar-Friedman, Inc., 729 F.2d 1136, 1140, 222 USPQ 839, 841 (7th Cir. 1984); see also Scholastic, Inc. v. MacMillan, Inc., 650 F.Supp. 866, 2 USPQ2D 1191 (S.D.N.Y. 1987). As was the case for the

Scholastic court, however, "the difficulty of discerning between descriptive and generic" need not concern us; applicant argues that its mark is not descriptive but suggestive.

The analysis to be applied by the Board for distinguishing between what is descriptive and what is suggestive is articulated in In re Abcor Development Corporation, 588 F.2d 811, 814, 200 USPQ 215, 218 (CCPA 1978) ("A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of the goods. A term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods." *Citing Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 11, 189 USPQ 759, 765 (2nd Cir. 1976).) In *Abcor*, the court also reminded that determination is to be made from the perspective of the average prospective purchaser. *Abcor, supra*, 200 USPQ at 218.

Applicant pointedly argues that we must consider the relevant class of purchasers of applicant's goods to be newspaper publishers who would buy applicant's supplements for distribution with their newspapers, and advertising executives who would buy space for ads in the supplements. We do not agree that advertising executives who place ads in

applicant's supplements are relevant purchasers. They are more appropriately considered purchasers of a service from applicant. Moreover, we do not think the perspective of readers of applicant's supplements should be ignored. They are the ultimate purchasers of the newspapers containing the supplements. In any event, there appears little practical benefit in applicant's drawing a distinction between newspaper publishers and newspaper readers. As applicant's president asserted in a declaration: "As one can see, despite where they live, rural Americans are not rubes." Applicant does not articulate any difference in sophistication of newspaper publishers and newspaper readers. More importantly, applicant has provided no direct evidence of the perspective of either publishers or readers. There is no testimonial evidence; there is no survey evidence. In essence, we are left with the dictionary definitions of record, the NEXIS article excerpts of record, the third-party registrations the Examining Attorney made of record, and the copies of applicant's supplements that are of record.

On this record, we have no doubt that the title of applicant's newspaper supplement "forthwith conveys an immediate idea" about a significant feature thereof. Each supplement profiles at least one American, whether a "local

unsung hero" or a celebrity "with small-town roots."⁷

Moreover, each supplement prominently features a profile of an American "hometown." Another possible alternative would be for publishers and readers to consider applicant's supplement as a continuing profile of rural Americans and rural American towns. The possibility that, among these possible interpretations of AMERICAN PROFILE, particular individuals might seize on one or another does not render the term suggestive rather than descriptive, for none involve elaborate reasoning. See In re Vehicle Information Network Inc., 32 USPQ2d 1542, 1544 (TTAB 1994); Cf. In re Bed & Breakfast Registry, 791 F.2d 157, 160, 229 USPQ 818 (Fed. Cir. 1986) (Board did not err in finding BED & BREAKFAST REGISTRY descriptive on alternate theories that phrase would be understood to describe a register of bed and breakfast lodgings "and may convey the related thought of registering at a bed and breakfast lodging".)

We find unpersuasive applicant's arguments that these profiles of people and places are insignificant features of its supplements, such that the association between the term AMERICAN PROFILE and these features would be difficult to

⁷ In this regard, it was practically frivolous for applicant's counsel to argue that applicant's supplements do "not contain ...discussions of persons or people that includes [sic] their most noteworthy characteristics and achievements."

draw. Nor do we find persuasive applicant's argument that there are so many other features in its supplement that publishers and readers would be unable to draw an immediate association between AMERICAN PROFILE and the profiles of Americans and American towns. Finally, we see no sound basis for applicant's argument that AMERICAN would, in the context in which it is used, be perceived as arbitrary, or for its argument that PROFILE would be thought of as a reference to silhouettes, credit reports or items other than brief, written sketches on the profiled people or places, for the meaning ascribed to terms is derived from the nature of the goods with which they are associated.

Decision: The refusal to register is affirmed.