Paper No. 19
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THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB APRIL 4, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Mount Roberts Tramway Limited Partnership

Serial No. 74/714,642 and 74/714,643

P. Jay Hines of Oblon, Spivak, McClelland, Maier & Neustadt, P.C. for Mount Roberts Tramway Limited Partnership

Barbara Brown, Trademark Examining Attorney, Law Office 102 (Thomas Shaw, Managing Attorney)

Before Simms, Hairston and Wendel, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Mount Roberts Tramway Limited Partnership has filed applications to register the designs depicted below (hereinafter referred to as the HAND design[1] and the EYE

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[1] Serial No. 74/714,642, filed August 14, 1995, based on an allegation of a bona fide intention to use the mark in commerce.

design[2]) for "retail souvenir store services, featuring novelty, gift and souvenir items."

HAND design EYE design

After passing the first examination stage, both intent-to-use applications were published for opposition and notices of allowance were subsequently issued. Statements of use accompanied by specimens were filed and actions were issued by the Office based on deficiencies in the specimens. Registration has now been finally refused in both applications on the ground that the specimens of record are unacceptable as evidence of actual service mark use of the marks sought to be registered in connection with the services identified in the applications.

The Board, on July 1, 1999, granted applicant's motion to consolidate the cases for purposes of appeal. Accordingly, both applicant and the Examining Attorney have

[2] Serial No. 74/714,643, filed August 14, 1995, based on an allegation of a bona fide intention to use the mark in commerce.

filed consolidated briefs. No oral hearing was requested. This one opinion is being issued for the both appeals.

The specimens which have been submitted for the HAND design consist of postcards showing the Mount Roberts tramway car with the HAND design appearing on one end of the car. One of the specimens for the EYE design consists of a similar postcard of the tramway car but with the EYE design at the visible end of the car together with the words MT. ROBERTS TRAMWAY and JUNEAU, ALASKA. The remaining two specimens consist of a shopping bag and a hang tag, both of which are imprinted with a depiction of the tramway car with what appears to be the EYE design at one end of the car.[3]

The Examining Attorney maintains that the postcard specimens are unacceptable as evidence of use of either the HAND design or the EYE design in connection with the recited retail souvenir store services. She argues that there is nothing on the postcards or the tramway car shown thereon which would cause consumers to make a direct association between the HAND or EYE design and applicant's retail souvenir store services. She points out that there

[3] We are in complete agreement with the Examining Attorney that the EYE design is a very small and faint portion of the tramway car depiction.

is no reference or advertising anywhere in these specimens with respect to applicant's recited services.

Applicant argues that, to the contrary, these specimens are directly associated with applicant's retail souvenir store services, the tram cars acting as billboards and the postcards as direct mail advertisements for the services. Applicant also contends that consideration must be given to the circumstances under which customers encounter the marks; that visitors to Mount Roberts taking the tram ride would identify the HAND and EYE designs on the cars as indicators of origin for applicant's services; and that the repeated encounter of these designs or symbols on not only the tramway cars but also on shopping bags, hand tags, and postcards dictates recognition of the symbols as indicators of source for all the major services being offered by applicant, including retail souvenir store stores. With respect to the HAND design, applicant points to the supplemental material which it has submitted, which includes a photograph showing use of the central HAND symbol alone on a sign outside a theater at the site and a newsletter published by applicant containing references to the Tlingit designs[4] used on the tram cars and a film shown

[4] It is learned from the newsletter that the HAND and EYE designs on the ends of the tram car, as well as central and larger birds'

at the visitor center celebrating the Tlingit culture, as additional evidence to be considered in determining consumer association of the design with applicant's services.

A "service mark' is defined, in pertinent part, as "any word, name, symbol, or device, or any combination thereof...used by a person...to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown." Section 45 of the Trademark Act. As has frequently been stated, it is implicit from this definition that there be a direct association between the mark and the services, i.e., that the mark be used in such a manner that it would be readily perceived as identifying the source of the services. See In re Advertising & Marketing Development, Inc., 821 F.2d 614, 2 USPQ2d 2010 (Fed. Cir. 1987); In re Adair, 45 USPQ2d 1211 (TTAB 1997); In re Duratech Industries Inc., 13 USPQ2d 2052 (TTAB 1989). Whether a mark has been used "to identify" the service identified in the application is a question of fact to be determined on the basis of the specimens and any additional material made of record.

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heads design on the side of the car, are all Tlingit (native Alaskan Indian) symbols.

We are in total agreement with the Examining Attorney that there is nothing in the postcards submitted as specimens that would lead to a direct association between the HAND or EYE design located on the tramway car and applicant's retail souvenir store services. The postcards show no more than use of the Tlingit designs on the tramway car; there is no reference anywhere on the tramway cars or on the postcards themselves to applicant's souvenir store services as might lead the public to regard the designs as service marks for these services. The only reference on either is to the Mount Roberts Tramway per se.

We fail to see how the tramway cars can be considered "billboards" for applicant's souvenir store services, when there is no mention of the stores on the cars. Similarly, there is no wording on the postcards associating any particular design on the tramway car shown on the front of the postcards with the store in which presumably, but not necessarily, the postcards were purchased. Applicant's claim that the postcards serve as "direct mail advertisements" featuring the designs as service marks for the retail souvenir store services which applicant offers at the tramway site is clearly without foundation.

Applicant insists that consideration must be given to the fact visitors to Mount Roberts repeatedly encounter

these designs being used in connection with applicant's services as a whole. We still find no reason, however, for the public to associate the HAND and EYE designs, in the event the designs are actually perceived as marks, with the particular services involved here. The HAND design displayed outside a theater at the site is not only different from the design sought to be registered, but it is being directly used in connection with the Chilkat Theater. The only specific reference to a souvenir store in the newsletter is to the store known as "Raven-Eagle Gifts." A photograph in the newsletter of one of the tram cars is accompanied by a description of the car as being "adorned with Tlingit designs." This is a far cry from evidence of use of the designs in such a manner that they would be viewed as service marks, much less for souvenir store services offered by applicant as one of its auxiliary services at the tramway.

Accordingly, the *Duratech* case relied upon by the Examining Attorney is in point. In that case, the Board found no association between the design sought to be registered, which covered the face of the bumper stickers submitted as specimens, and the recited services of the organization which provided these bumper stickers. There being no reference on the bumper stickers to the services,

there was nothing to lead the public to regard the design of the bumper stickers as a service mark for the organization. Here there is no reference to applicant's souvenir store services on the tramway cars, the only place in which the HAND and EYE designs sought to be registered have been shown to be encountered by the public. Moreover, even when consideration is given to the supplemental materials submitted by applicant, there is nothing which creates a specific association between these particular designs or symbols and the souvenir store services of applicant. If the HAND and EYE designs located on the tramway cars are perceived as marks by the public at all, any association would be likely to be between the designs and applicant's tramway transportation services per se.

Accordingly, the postcard specimens are unacceptable as specimens of service mark use of either the HAND or the EYE design. There are, however, two additional specimens in the EYE design application, one a photograph of a shopping bag and the other a hang tag, both containing references to a souvenir shop. The Examining Attorney found these two specimens unacceptable, in that the only design serving as a mark on the bag and tag is that of a tramway car, with the EYE design which appears at the end of the car being an integral part of that mark. She argues

that the EYE design does not project a separable and distinct commercial impression from the remaining elements of the tramway car design. Thus, she maintains that the specimens are not acceptable for the EYE design sought to be registered as a separate mark.

While applicant argues that the HAND and EYE designs make separate commercial impressions as viewed on the actual tramway cars, that is not the issue here. Instead the question is whether the EYE design makes a separate commercial impression when used as part of a tramway car design which is imprinted on shopping bags and hang tags. In this instance, we find the EYE design to be but a minute portion of the tramway car design. This is not a photograph of an actual tramway car, as on the postcards, but rather an artistic rendition of the same. Here, the EYE design, if noticed at all, would certainly not create a separate commercial impression. See In re Chemical Dynamics Inc., 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988). While the entire tramway car design as imprinted on the shopping bag and hang tag would appear to serve as a service mark for applicant’s retail souvenir store services, the EYE design is simply an integral part of this tramway car design. Thus, the shopping bag and hang tag

are not acceptable specimens of use of the EYE design alone, the mark sought to be registered.

Decision: The refusal to register on the ground that the specimens of record are unacceptable is affirmed.

R. L. Simms

P. T. Hairston

H. R. Wendel
Administrative Trademark Judges,
Trademark Trial and Appeal Board