

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB MAY 5, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Simoniz USA, Inc.

Serial No. 75/240,400

John C. Linderman and Daniel M. Barbieri of McCormick, Paulding & Huber LLP for applicant.

Michael S. Levy, Senior Attorney, Law Office 110
(Chris A.F. Pedersen, Managing Attorney).

Before Hanak, Hairston and McLeod, Administrative Trademark Judges.

Opinion by McLeod, Administrative Trademark Judge:

An application has been filed by Simoniz USA, Inc. to register the mark DR. SIMO for "providing extended warranty protection programs for the interior and exterior surfaces of automotive vehicles."¹

Registration was refused under Sections 1, 2, 3 and 45 of the Trademark Act, 15 U.S.C. Sections 1051, 1052, 1053 and 1127, on the ground that applicant's proposed mark does not function as a service mark to identify and distinguish applicant's

¹ Application Serial No. 75/240,400, filed February 12, 1997, alleging dates of first use of November 20, 1996.

services from those of others.² When the refusal was made final, applicant appealed. An oral hearing was not requested.

The Senior Attorney argues that the applied-for mark does not function as a service mark as shown on the specimens of record.³ According to the Senior Attorney, the proposed mark only identifies the character of Dr. Simo. While the name of a character may be registered as a service mark, the Senior Attorney contends that the specimens of use filed with the application do not demonstrate proper service mark use. The Senior Attorney maintains, among other things, that the words DR. SIMO are no more prominent than other wording on the specimens, and that there is no reason for consumers to "pluck" DR. SIMO from the specimens and recognize that element as a service mark.

Applicant takes the opposite position. According to applicant, the DR. SIMO name functions as a service mark as shown on the specimens of record. In addition to the words "SIMONIZ EP3," applicant maintains that the DR. SIMO name is the only other prominent term used on the specimens. Applicant submits that the words DR. SIMO are a bright feature in contrast

² The Senior Attorney's final refusal also required specimens which show acceptable use of the mark in commerce under 37 C.F.R. Section 2.56. It is the view of the Board that this requirement is encompassed within the statutory refusal in this case.

³ The Senior Attorney objects to untimely evidence submitted by applicant with its appeal brief. The objection is sustained and the evidence has been given no consideration. See Trademark Rule 2.142(d).

to darker background colors on the specimens. Applicant also argues, among other things, that the DR. SIMO name is similar to applicant's SIMONIZ mark, and that DR. SIMO was selected for the specific purpose of creating brand identity.⁴

The name of a living or fictitious person may be registered as a service mark if the name is used in the sale or advertising of services to identify and distinguish the services from those of others. However, the mere appearance of a personal or fictitious name in an advertisement for a particular service does not necessarily create a direct association between the name and the services offered. *In re Hechinger Investment Co. of Delaware, Inc.*, 24 U.S.P.Q.2d 1057 (T.T.A.B. 1991) and cases cited therein. The critical question is whether the applied-for mark, as used on the specimens, will be recognized in itself as an indication of origin for the particular service. That is, does the name create a commercial impression separate and apart from the other material appearing on the advertisement. *In re Morganroth*, 208 U.S.P.Q. 284, 287 (T.T.A.B. 1980). The commercial impression as a service mark must be readily apparent from the use of the name. It must not blend in with other matter so well that it is difficult or impossible to discern

⁴ Applicant submits that its application for registration of the Dr. Simo character was approved for publication without any objection from the Senior Attorney. However, the Board is not bound to the position taken by the Senior Attorney with respect to that application, and our decision is based on the particular record before us. *In re John Harvey & Sons Ltd.*, 32 U.S.P.Q.2d 1451 (T.T.A.B. 1994).

which element is supposed to constitute a service mark. *In re McDonald's Corp.*, 229 U.S.P.Q. 555, 556 (T.T.A.B. 1985).

After careful review of the specimens of record and the arguments presented, we find that the applied-for mark does not function as a service mark. The mere fact that applicant selected the DR. SIMO name to function as a service mark is unpersuasive if there is no acceptable service mark use in advertising or promotional materials. *See McDonald's, supra.* In this case, the DR. SIMO name appears in small print on the character's nametag, and directly underneath or adjacent to an illustration of the character.⁵ We agree with the Senior Attorney that the commercial impression created by the specimens is solely that of the name of a character, rather than an indication of origin for applicant's warranty services. That is, the position, size and location of the words DR. SIMO in close proximity to the character call attention to the character alone, rather than conveying service mark significance.

While the applied-for mark also appears within the text of written promotional materials, the DR. SIMO name is less prominent than other items appearing on the specimens. It is unlikely that consumers will even notice the DR. SIMO name

⁵ Applicant relies, in part, upon a folder insert entitled "The Company History," which displays the DR. SIMO name within quotation marks ("DR. SIMO"). However, this specimen technically does not agree with the application drawing as required under Section 1 of the Trademark Act, 15 U.S.C. Section 1051. *See* TMEP Section 807.14.

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within the text, let alone attribute service mark significance. In this regard, the Senior Attorney is correct in his observation that consumers are more likely to attribute service mark significance to the prominent words "SIMONIZ EP3" or "SIMONIZ" shown on the specimens. Similarly, applicant's contention that the ellipses and quotes appearing on the specimens create an association between the applied-for mark and services is unpersuasive. To the contrary, the quotes lead consumers to the large character illustration on the posterboard, or to the prominent "SIMONIZ EP3" service mark shown on the specimens.

DECISION

Accordingly, the refusal to register is affirmed.

E. W. Hanak

P. T. Hairston

L. K. McLeod
Administrative Trademark
Judges, Trademark
Trial and Appeal Board

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