

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 14
PTH

11/2/00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re John Wawrzonek

Serial No. 75/459,582

Charles Hieken of Fish & Richardson P.C. for John Wawrzonek.

Steven R. Foster, Trademark Examining Attorney, Law Office 107 (Thomas Lamone, Managing Attorney).

Before Cissel, Hairston and Chapman, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

On March 30, 1998 John Wawrzonek filed an application to register the phrase THE HIDDEN WORLD OF THE NEARBY as a trademark for "art prints."¹ The application includes the statement that "[t]he mark is used by applying it to the goods and three facsimiles showing the mark as actually used are enclosed herewith." Reproduced below in reduced

¹ Serial No. 75/459,582, filed March 30, 1998, alleging dates of first use at least as early as 1987.

Ser No. 75/459,582

size is the specimen which accompanied the application.

The Trademark Examining Attorney, in a priority office action issued November 4, 1998, states that on October 6, 1998 he had a telephone conversation with applicant's attorney, who described the specimens as photocopies of

flyers which applicant sends to potential customers to advertise the availability of the goods. The Examining Attorney indicated that the specimens are unacceptable because they are mere advertisements and requested acceptable specimens. In addition, the Examining Attorney refused registration under Sections 1, 2, and 45 of the Trademark Act on the ground that the matter sought to be registered, as shown on the specimens, does not function as a mark.

In response to the priority office action, applicant argued that the flyers constitute displays associated with the goods, citing *Lands' End Inc. v. Manbeck*, 24 USPQ2d 1314 (E.D. Va. 1992). According to applicant:

Manifestly, the specimen includes a picture of the relevant goods, which in this case may be regarded as the goods themselves because nearly 1/3 the area of the specimen is an art print, and the specimen includes the mark sufficiently near the art print to associate the mark with the goods. The specimen is sent with information necessary to order the goods.

The Examining Attorney was not persuaded by applicant's arguments and finally refused registration on the ground that the matter sought to be registered, as shown on the specimens, does not function as a mark. The Examining Attorney also required that applicant submit substitute specimens.

Applicant appealed. Both applicant and the Examining Attorney filed briefs on the case, but no oral hearing was requested.

In this case, we agree with the Examining Attorney that the matter sought to be registered, as shown on the specimens, does not function as a mark for art prints. Notwithstanding applicant's use of "TM" after THE HIDDEN WORLD OF THE NEARBY, we do not believe prospective purchasers would perceive this phrase as a trademark for applicant's art prints. Rather, it is likely that prospective purchasers would perceive THE HIDDEN WORLD OF THE NEARBY as the title of the art print or even the title of a series of publications featuring art prints, particularly inasmuch as the words "Volume II On The Path To Walden" appear thereunder. At best, the use of THE HIDDEN WORLD OF THE NEARBY on the specimens is ambiguous and it is not clear that prospective purchasers would regard this phrase as the indication of origin of art prints.

We turn next to the question of whether, assuming the matter sought to be registered functions as a mark on the specimens, the specimens are acceptable. In particular, we must determine whether the specimens constitute displays associated with the goods, as applicant argues.

TMEP Section 905.06(a) states that:

In accordance with [the Lands' End] decision, examining attorneys should accept any catalog or similar specimen as a display associated with the goods, provided that (1) it includes a picture of the relevant goods, (2) it includes the mark sufficiently near the picture of the goods to associate the mark with the goods, and (3) it includes information necessary to order the goods. Any form of advertising which satisfies these criteria should be construed as a display associated with the goods.

As pointed out by the Examining Attorney, the flyers are not catalogs, nor are they similar to catalogs. Further, they do not include information necessary to order the goods. There is no information regarding the price of applicant's art prints or how to order the art prints. While we note the statement of applicant's attorney that the flyers "are furnished to potential purchasers with sufficient information to order the goods," this representation does not satisfy the requirement that the ordering information must appear on the specimens. It is simply not enough that applicant's attorney represents that the ordering information is furnished. In the absence of information necessary to order the goods, the flyers are nothing more than normal advertising and thus, are not acceptable specimens. See e.g., *In re MediaShare Corp.*, 43 USPQ2d 1304 (TTAB 1997).

Decision: The refusal to register on the ground that the matter sought to be registered, as shown on the specimens, does not function as a mark for art prints is affirmed. The requirement for acceptable specimens is also affirmed.

R. F. Cissel

P. T. Hairston

B. A. Chapman
Administrative Trademark Judges
Trademark Trial and Appeal Board

Ser No. 75/459,582