

3/27/02

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Paper No. 18
DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Promotional Partners Group, Ltd.

Serial No. 75/575,487

Brian M. Ozog and Stephen P. Carponelli of Carponelli & Krug for Promotional Partners Group, Ltd.

Linda E. Blohm, Trademark Examining Attorney, Law Office 110 (Chris A.F. Pedersen, Managing Attorney).

Before Simms, Bucher and Bottorff, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Promotional Partners Group, Ltd., a Hong Kong corporation, has appealed from the final refusal to register the mark shown below:



as used in connection with services recited, as amended,
as:

"advertising services, namely, promoting the goods and services of others by developing, creating, preparing and placing advertisements; developing executing and evaluation of promotional campaigns for business; business consultation services, namely negotiation the licensing of property for promotion; business management supervision and monitoring of product manufacturing; strategic business marketing consultation; business merchandising display services; cartoon character licensing; character licensing," in International Class 35; and,
"creative graphic art design services," in International Class 42.¹

The Trademark Examining Attorney has gone final on her refusal to approve this mark for publication absent applicant's complying with her requirement for a disclaimer of the descriptive wording, PROMOTIONAL PARTNERS WORLDWIDE.

Both the Trademark Examining Attorney and applicant have fully briefed their respective cases on appeal. Applicant did not request an oral hearing before the Board. We affirm the Examining Attorney's requirement for a disclaimer of the entire wording, PROMOTIONAL PARTNERS WORLDWIDE under Section 6 of the Lanham Act.²

¹ Application Serial No. was filed on October 26, 1998, based upon applicant's allegations of use of the mark in commerce with the United States at least as early as April 11, 1997.

² The actual language of Section 6(a) of the Act (15 U.S.C. 1056(a)), as amended, reads as follows, in relevant part:
(a) The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable...

Applicant argues that this entire composite (i.e., the design feature and the wording) is a unitary mark, and hence fits an exception to the requirement for a disclaimer of individual components.³ Applicant also argues, in the alternative, that it will disclaim the word "Promotional," while continuing to argue that the words "Partners" and "Worldwide" need not be disclaimed because they are suggestive at worst.⁴

Much of the discussion between the Trademark Examining Attorney and applicant had to do with whether this entire composite mark - the literal elements and the design feature together - must be considered a unitary mark. As stated clearly by our principal reviewing Court: "A unitary mark simply has no 'unregistrable component,' but is instead an inseparable whole." See Dena Corp. v.

³ See, *inter alia*, TMEP §1213.06(b)(v), "Display of Mark" creating a unitary mark. See also, In re Texsun Tire and Battery Stores, Inc., 229 USPQ 227 (TTAB 1986).

⁴ On page 4 of applicant's response of December 2, 1999, applicant argued, as it has throughout the instant prosecution, that the term "Promotional Partners Worldwide" is unitary and, hence, that no disclaimer is required. However, applicant also took the following position:

"In the event that the Examiner disagrees with Applicant's position that the mark is unitary in nature and in an effort to expedite the prosecution process, the applicant submits the arguments enumerated below, paragraphs 2-4, in the alternative."

Then in the following paragraph, applicant agreed to disclaim the word PROMOTIONAL apart from the mark as shown. Again in its reply brief, applicant argues this is not a concession against unitariness, but merely an argument in the alternative. We accept it as such.

Belvedere International Inc., 950 F.2d 1555, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991).

The Court, in Belvedere International Inc., *supra*, reviews the practice of the United States Patent and Trademark Office and the statutory history of the policy of exempting unitary marks from the disclaimer requirement. Because a unitary mark does not fit the language of 15 U.S.C. §1056(a) quoted above, the Director cannot require a disclaimer in such a case.

The mark at issue in Belvedere International Inc., was shown as follows:



The Federal Circuit discussed the lack of unitariness in the EUROPEAN FORMULA mark as follows:

A unitary mark has certain observable characteristics. Specifically, its elements are inseparable. In a unitary mark, these observable characteristics must combine to show that the mark has a distinct meaning of its own independent of the meaning of its constituent

elements. In other words, a unitary mark must create a single and distinct commercial impression...

... An examination of the mark discloses that its elements are not so merged together that they cannot be regarded as separate (citation omitted). The words EUROPEAN FORMULA are separate from the circular design. These two elements are not connected by any lines or design features.

Nothing melds EUROPEAN FORMULA with the circular design to create a single indivisible symbol.

In addition, no particular meaning in the words EUROPEAN FORMULA or the circular design links these detached features... The observable characteristics of Belvedere's mark show that its elements are not 'so merged together that they cannot be regarded as separable elements.' (citation omitted).

The mere proximity of EUROPEAN FORMULA to the unrelated design feature does not endow the whole with a single, integrated, and distinct commercial impression. No evidence suggests that a potential purchaser would perceive this mark to convey a single inseparable impression. In the absence of such evidence, EUROPEAN FORMULA in large type appears to stand out and convey a meaning wholly unrelated to the circular design.

Applicant describes the visual presentation of this composite in detail, and then argues, *inter alia*, that the words provide meaning for the triple loop design:

... [U]nlike Belvedere Int'l Inc., the design portion of [applicant's] mark, utilizing three loops, and the word portion, utilizing three words, is presented in such a way to connote images of fellowship, harmony, and unity between the different elements of the mark, as well as between Applicant and its clients.

Notwithstanding the variations used within and between the different elements of the mark, the text portion presents itself as a single rectangular unit with defined borders, similar to the In re Texsun Tire mark. The word portion of the mark, read from right to left (sic) and top to bottom, enhances the vertical and horizontal dimensions of the rectangle. The argument that the mark is unitary is further strengthened by the incorporation of the triple loop design with an identical vertical dimension, continuing the single rectangular impression of the whole mark.

(applicant's appeal brief, p. 5).

In spite of applicant's creative arguments, we find that the constituent elements of this composite (design and wording) do not combine to form a distinct new meaning for the composite mark, independent of the meaning of its constituent elements. To paraphrase the Court in Belvedere, "Nothing melds PROMOTIONAL PARTNERS WORLDWIDE with the triple loop design to create a single indivisible symbol." There is no evidence that prospective clients, upon seeing this composite mark, would get a single commercial impression of "fellowship, harmony, and unity" - whether between the different elements of the mark or between applicant and its clients.

Accordingly, we agree with the Trademark Examining Attorney that the wording herein ("PROMOTIONAL PARTNERS WORLDWIDE") and the design feature ("three intertwining loops") are separable elements. Whether the looping design

feature is used to the left of the wording, as reproduced above and shown on the drawing and specimens herein, or above the wording, as used elsewhere by applicant --



-- we find that the design and word elements are not so merged together that they cannot be regarded as separable elements.

We turn then to consider, in light of the recited services, whether the words making up the literal portion of the mark are merely descriptive, as argued by the Trademark Examining Attorney.

Applicant is engaged in special sales promotions for its clients. As stated in the recital of services, applicant is involved in "promoting the goods and services of others ... developing executing and evaluation of promotional campaigns" Applicant's specialized sub-grouping of marketing or advertising services are best described as "sales promotional" services, and it is clear

in this context that the word "promotional" is merely descriptive of the enumerated services.

We turn then to the words "PROMOTIONAL PARTNERS." We do understand that applicant is legally a corporation, and not a partnership. We also note that the recital of services nowhere explicitly lists "partnering" as a component of applicant's services.

However, our focus must be on whether as presented within this mark and used in connection with applicant's promotional activities for others, the words "promotional partners" serves as a significant feature, characteristic or component of these services provided for the benefit of its clients.

The recital of services and applicant's letterhead both point to applicant's expertise with the premium sales promotions often associated with packaged food manufacturers or purveyors of fast food products. In order to ensure that such promotional efforts are successful, the marketing manager for the fast food franchise or consumer goods manufacturer needs to find "a promotional partner." A successful sales promotional campaign will be made easier if the business approaches the working relationship as one characterized by partnering with applicant - its "promotional partner."

Actually, we find that in the vernacular, these two words ("promotional" and "partner") go well together as a phrase describing alliances or partnerships even broader than applicant's sales promotional campaigns for its clients. Within the larger community of interest, where the "partnership" is even more informal than would be the case with applicant's contracts with its clients, the designation "promotional partners" is readily understandable in the context of educational, entertainment or cultural event. Irrespective of the details of the particular event of interest, the specific businesses or sponsors listed under a heading of "promotional partners" are understood to be helping to coordinate or fund the event or activity.

Finally, we turn to consider the word, WORLDWIDE. The Trademark Examining Attorney has included a dictionary definition for "worldwide":

"world-wide adjective Involving or extending throughout the entire world; universal: a *worldwide* epidemic." The American Heritage Dictionary of the English Language, Third Edition (1992).

Moreover, the record shows that applicant has offices that span the globe. Whether the term WORLDWIDE is separated by a horizontal line from the words "PROMOTIONAL PARTNERS," or merely presented in a smaller font, the final word in this

three-word phrase, "worldwide," connotes that applicant enjoys a presence around the world, in places such as Hong Kong, London, the United States, New Zealand, China and Australia. Hence, we find that the word "WORLDWIDE" is also descriptive of applicant's recited services.

When the term "PROMOTIONAL PARTNERS" is placed in front of "WORLDWIDE," no novel or incongruous meaning will be ascribed to this three-word phrase. Accordingly, we agree with the Trademark Examining Attorney that in the context of these services, the wording PROMOTIONAL PARTNERS WORLDWIDE is merely descriptive and must be disclaimed apart from the mark as shown.

Decision: The requirement for a disclaimer of the PROMOTIONAL PARTNERS WORLDWIDE portion of the mark herein on the ground that this phrase is merely descriptive in connection with the identified services is affirmed.

However, in accordance with Trademark Rule 2.142(g), this decision will be set aside and this application will be returned to the Trademark Examining Attorney to place in condition for publication for opposition, if applicant, no more than thirty days from the mailing date of this decision, submits an appropriate disclaimer of PROMOTIONAL PARTNERS WORLDWIDE.

Bottorff, Administrative Trademark Judge, dissenting in part:

I agree with the majority's conclusions that (a) applicant's mark, considered in its entirety (i.e., the words and design), is not a unitary mark, and that (b) the words PROMOTIONAL and WORLDWIDE are merely descriptive of applicant's services and must be disclaimed apart from the mark as shown. However, the evidence of record does not persuade me that PARTNERS merely describes applicant's recited services. I therefore would reverse the Trademark Examining Attorney's requirement for a disclaimer of PARTNERS, and I dissent from the majority's opinion to that extent.

The evidence of record with respect to the mere descriptiveness of PARTNERS consists solely of a dictionary definition of the word "partner," i.e., "one that is united or associated with another or others in an activity or a sphere of common interest, especially: a. a member of a business partnership,"⁵ and a third-party Principal Register registration of the mark VISION PARTNERS (PARTNERS disclaimed) for "business management and consultation services, namely, strategic planning and business problem

⁵ From The American Heritage® Dictionary of the English Language (3d ed. 1992).

solving services."⁶ This evidence, which is not mentioned or discussed in the majority's opinion,⁷ does not persuade me that the word PARTNERS directly and immediately describes the advertising agency services recited in applicant's application. At most, the term appears to suggest, in a general way, that applicant cooperates and works with its clients in developing and implementing the clients' promotional and marketing strategies. The evidence of record simply does not establish that the term PARTNERS, or even "partnering," is generally understood or used in the advertising industry (or in any other industry) to directly describe the nature of the commercial relationship between the service provider and its clients

⁶ Registration No. 2,244,151, issued May 11, 1999.

⁷ Instead, the majority summarily concludes, *supra* at page 8, that

[i]n order to ensure that such promotional efforts are successful, the marketing manager for the fast food franchise or consumer goods manufacturer needs to find "a promotional partner." A successful sales promotional campaign will be made easier if the business approaches the working relationship as one characterized by partnering with applicant - its "promotional partner."

The evidentiary basis for these findings is not identified or apparent. Moreover, the majority's discussion, *supra* at page 9, of what the term might be understood to mean in another, specifically different context, i.e., in relation to the sponsorship, funding or coordination of educational, entertainment and cultural events, is likewise unsupported by the record and in any event appears to be factually and legally irrelevant to the issue before us on appeal, i.e., whether the term is merely descriptive of applicant's services as recited in the application.

or any other feature or characteristic of applicant's recited services.

In the absence of such evidence, I would find that the word PARTNERS, as applied to applicant's recited services, is sufficiently indefinite and amorphous to preclude a finding of mere descriptiveness. At the very least, reasonable doubts as to the mere descriptiveness of PARTNERS must be resolved in applicant's favor. See *In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). I accordingly would reverse the requirement for a disclaimer of PARTNERS.