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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re A.D. 1619 Company

Serial No. 75/660,891

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Lawrence & Haug LLP for A.D. 1619 Company.

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113 (Odette Bonnet, Acting Managing Attorney).

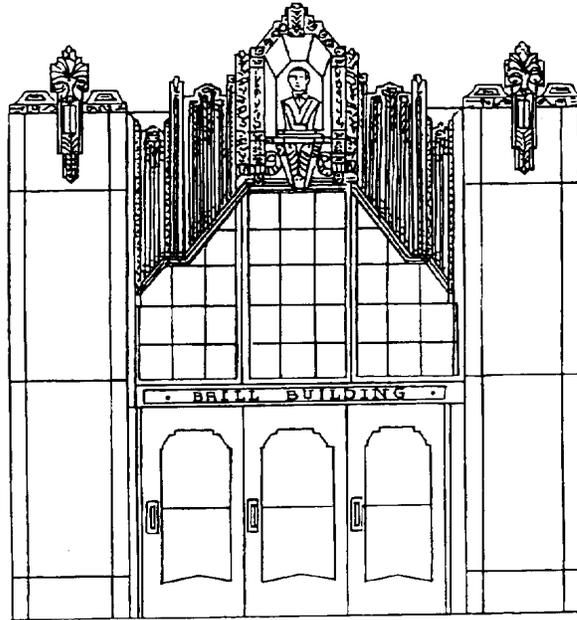
Before Simms, Hohein and Chapman, Administrative Trademark
Judges.

Opinion by Simms, Administrative Trademark Judge:

A.D. 1619 Company (applicant), a New York partnership,
has appealed from the final refusal of the Trademark
Examining Attorney to register the "Entryway of building"
design shown below for the following services: real estate
agency services, leasing office space to tenants,
management of real estate, real estate investment, and real
estate brokerage services, in Class 36; and entertainment
services, namely, provision of background, backdrops, and

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visual settings for motion pictures, television broadcasts, and video and sound recordings, in Class 41.¹



Pursuant to request of the Examining Attorney, applicant submitted a description of the mark as follows:

The mark consists of a representation of The Brill Building's Broadway street front entryway, which entryway consists of an ornate bronze and glass transom configuration that is described as resembling a raised curtain and proscenium with a bust of Mr. Alan E. Lefcourt in a niche center stage. Under the transom are three bronze and glass doors which lead to the vestibule and lobby.

The Examining Attorney refused registration on the ground that applicant's building entryway does not function

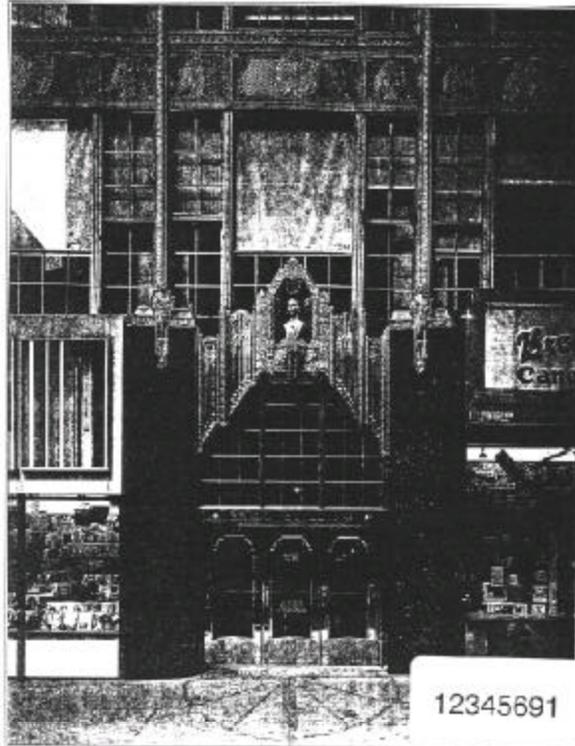
¹Application Serial No. 75/660,891, filed March 15, 1999, based upon allegations of use and use in commerce since March 1931.

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as a service mark (Sections 1, 2, 3 and 45 of the Trademark Act, 15 USC §§1051, 1052, 1053 and 1127), and because applicant's specimens do not show use in commerce of the asserted mark for applicant's services. Applicant and the Examining Attorney have submitted briefs but no oral hearing was requested.

We affirm on both grounds.

The Examining Attorney has refused registration because applicant's building entryway design does not function as a service mark for applicant's real estate and entertainment services inasmuch as it does not identify and distinguish applicant's services from those of others. The Examining Attorney contends that, in order to function as a mark, applicant's building façade or entryway must be used in a manner that clearly projects to purchasers the source of applicant's services so as to be perceived as a mark identifying those services. The original specimens of record (a copy of which is reproduced below) are photographs of the building entryway which, according to the Examining Attorney, show no more than a part of the facade of the building.



This photograph of the front of applicant's building is not sufficient, the Examining Attorney contends, to show use of the building entryway as a service mark for applicant's real estate and entertainment services because it shows no more than the building in which applicant's services may be performed. The photographs do not indicate that applicant provides real estate and entertainment services, according to the Examining Attorney.

The Examining Attorney also maintains that the record contains no evidence showing the promotion of the building entryway as a service mark. Accordingly, consumers are not likely to associate applicant's building entryway with

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applicant's services, the Examining Attorney argues. The Examining Attorney has also made of record photographs of allegedly similar ornate building facades in support of her argument that such facades (including applicant's) are not commonly perceived as service marks but are simply photographs of buildings.

With respect to the specimens, the Examining Attorney contends that they must show a direct association between the mark (building entryway) and applicant's services, but that in this case they do not show use of the asserted mark in connection with the sale or advertising of applicant's services. Neither the original nor the additional specimens (promotional and informational flyers and brochures about applicant's building) show use of building entryway in a manner that would be perceived as identifying applicant as the source of its services. In other words, the Examining Attorney contends that the specimens do not show use of the mark to identify the specified real estate and entertainment services. Accordingly, the Examining Attorney requested that applicant submit specimens showing use of the asserted mark in connection with the sale or advertising of applicant's real estate and entertainment services. The Examining Attorney advised that specimens such as signs, brochures, letterhead or stationery used in

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the sale or advertising of applicant's services should be submitted to show use of the asserted mark as a service mark.

Applicant then submitted stationery showing the asserted mark next to the wording "THE BRILL BUILDING REALTY GROUP LTD MANAGING AGENT." At the bottom of the stationery, in addition to applicant's address, is the additional wording "PROPERTY MANAGEMENT DEVELOPMENT AND SALES." The Examining Attorney advised that this letterhead would be an acceptable specimen of use of the mark for applicant's Class 36 real estate services, because it shows that applicant is providing real estate services under the mark, but required a verification that such specimen was in use in commerce at least as early as the filing date of the application. See Trademark Rule 2.59(a). Applicant did not submit such a verified statement supporting these substitute specimens.²

Accordingly, we must evaluate this case on the basis of the original specimens and the other material, described above, which were supported by a verification of use as of the filing date. The Examining Attorney contends that the supported specimens of record do not show that consumers

² Applicant's attorney acknowledged in his reply brief, footnote 1, that no verified statement was submitted in support of the otherwise acceptable letterhead specimens.

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are likely to associate the building entryway with applicant's real estate and entertainment services.

Applicant, on the other hand, maintains that applicant's building entryway is used in the promotion of applicant's real estate and entertainment services. Applicant argues that it has promoted the building design in connection with its services such that applicant has developed recognition by third parties of applicant's building design as identifying the source of applicant's services. It is applicant's position that the original specimens (photographs of the building entryway) along with the additional advertising and promotional materials distributed to prospective tenants and potential customers of applicant's services show use and promotion of applicant's building entryway as a service mark in the sale or advertising of applicant's services, including the offering to tenants of various real estate and entertainment support services, such as a screening room providing customers with state-of-the-art film and video technology.³

In addition, applicant submitted a declaration from its manager stating that applicant has promoted and used

³ We note that such screening room services are not within the amended description of the entertainment services listed in the application--

its entryway design in connection with the offering of its real estate and entertainment services, and attesting to the fact that applicant has "developed recognition by third parties" (i.e., New York City Transit) of its building design as identifying the source of applicant's services in that the building entryway has become, in the opinion of applicant's manager, a distinctive indicator of the source of applicant's services. In sum, applicant argues that the specimens demonstrate in the mind of tenants and other customers an association between the building entryway and applicant's services.

Applicant has made of record a copy of a letter from New York City Transit, seeking permission to use the image of the façade of applicant's building on MetroCard fare cards, the pertinent portions of which are quoted below:

...NYC Transit is planning a series of special, commemorative MetroCards that will focus on the musical landmarks of New York-- a dozen or so still-existing places within the city that have been important to the development of music in this country.

Because it is regarded [as] *the* center for music publishing in New York City, we hope to include the Brill Building in this series.

Other musical landmarks that we expect to include are Trinity Church, the Brooklyn

the provision of background, backdrops, and visual settings for motion pictures, television broadcasts, and video and sound recordings.

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Academy of Music, Carnegie Hall, the Juilliard School, Steinway & Sons and Lincoln Center.

The additional specimens of record also contain information concerning applicant's building and its tenants. For example, on a sheet entitled "THE BRILL BUILDING PROPERTY DESCRIPTION," the following information is given about applicant's building:

The façade is divided into three sections--a typical ground-floor aluminum and glass storefronts [sic], a two-story mid-section in which terra-cotta pilasters frame large plate glass picture & double-hung metal windows with metal surrounds, and a [sic] eight-story brick-faced upper section with central base having terra-cotta panels. The exterior walls of the building are brick veneer on masonry-backup. On the Broadway side of the building is an ornate bronze and marble main entry. Above the entrée, on the penthouse parapet is a limestone bust...

...The building front entrance way is ornate bronze & glass configuration that has been said to resemble a raised curtain and proscenium with a bust in a niche.

A service mark is "any word, name, symbol, or device, or any combination thereof," which serves "to identify and distinguish the services of one person...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, 15 USC §1127. It is well settled, however, that not all words, designs or symbols used in the sale or advertising

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of goods or services function as trademarks or service marks, regardless of an applicant's intent. 1 J. McCarthy, McCarthy on Trademarks and Unfair Competition, Section 3:3 (4th ed. 2002). Rather, in order to be protected as a valid mark, a designation must create "a separate and distinct commercial impression, which ... performs the trademark function of identifying the source of the [services] to the customers." *In re Chemical Dynamics, Inc.*, 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988). A term or design does not function as a trademark or service mark unless it is used in a manner which projects to purchasers a single source of the goods or services. *In re Morganroth*, 208 USPQ 284 (TTAB 1980).

Even if it is clear that the activities recited are services in connection with which a mark may be registered (and we have doubt about whether applicant's provision of its building as a backdrop or background for movies and broadcasts is a service in connection with which applicant may register a mark) and that the applicant provides the recited services, the record must show that the asserted mark actually identifies and distinguishes the recited services and indicates their source. See *In re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456 (CCPA 1973), aff'g 167 USPQ 245 (TTAB 1970). In this regard, it is the

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perception of the ordinary customer which determines whether the asserted mark functions as a service mark, not the applicant's intent, hope or expectation that it do so. See *In re Standard Oil Co.*, 275 F.2d 945, 125 USPQ 227 (CCPA 1960).

Whether a mark is being used to identify a particular service is a question of fact to be determined on the basis of the specimens as well as other evidence of record. *In re Advertising and Marketing Development Inc.*, 821 F.2d 614, 2 USPQ2d 2010 (Fed. Cir. 1987); *In re Signal Companies, Inc.*, 228 USPQ 956 (TTAB 1986); and *In re Admark, Inc.*, 214 USPQ 302 (TTAB 1982).

Subject matter presented for registration as a service mark may be unregistrable because it does not in fact function as a service mark. For example, the three-dimensional configuration of a building is registrable only if it is used in such a way that it is or could be readily perceived as a mark identifying the source of the services. *In re Adair*, 45 USPQ2d 1211, 1214 (TTAB 1997). See also TMEP Section 1301.02(c). The mark must be used on the specimens in such a way as to show that there is a direct association between the asserted mark and the services. Evidence of such use might include letterhead stationery and the like which show promotion of the building's design

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as a mark. See *In re Lean-To Barbecue, Inc.*, 172 USPQ 151 (TTAB 1971); and *In re Master Kleens of America, Inc.*, 171 USPQ 438 (TTAB 1971).

While photographs may be appropriate specimens of use for a three-dimensional mark, we agree with the Examining Attorney that photographs of applicant's building alone are not sufficient to demonstrate use of the building entryway as a mark for the services performed near or in the building, if they show no more than the building near or in which the services are performed.

Here, applicant's building entryway on the original specimens of record as well as on the additional specimens is not directly associated with the sale or advertising of any services, let alone applicant's specified real estate and entertainment services. The entryway is not being used in the manner of a service mark to identify applicant's services and would not be recognized or perceived by potential purchasers of applicant's real estate and entertainment services as a service mark. Also, when NYC Transit asked permission to use an image of applicant's building on MetroCard fare cards, it stated that applicant's building was a prominent building in New York music publishing history. This does not show recognition by the relevant purchasers and potential purchasers that

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the entryway itself functions as a mark to identify applicant's various real estate services or its entertainment services in the nature of the provision of the building as a background, backdrop or visual setting for motion pictures, television broadcasts and video and sound recordings. We cannot find fault with what the Examining Attorney stated in her brief, pp. 6-7:

...Nowhere in the package of specimens submitted by the applicant is the applicant's building entryway or representation of the building entryway used in a manner that would be perceived as a service mark in conjunction with [the] real estate and entertainment services provided. In fact, the only depictions of the exterior of the applicant's building entryway are pictures of the building similar to the applicant's original specimen, but taken from different angles, most of which do not even remotely resemble the mark as it appears on the drawing page. These specimens consisting of photographs of the exterior of the applicant's building entryway fail to show use of the mark in the sale and advertising of the applicant's services for the same reasons as the specimens originally submitted.

See also *Rock and Roll Hall of Fame and Museum Inc. v. Gentile Productions*, 134 F.2d 749, 45 USPQ2d 1412, 1416-18 (6th Cir. 1998) (despite court's finding that plaintiff's building design was unique and distinctive, "...[W]hen we view the photograph [of the museum] in [defendant's]

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poster, we do not readily recognize the design of the Museum's building as an indicator of source or sponsorship. What we see, rather, is a photograph of an accessible, well-known, public landmark. Stated somewhat differently, in [defendant's] poster, the Museum's building strikes us not as a separate and distinct mark *on the good*, but, rather, as the good itself... [W]e are not persuaded that the Museum uses its building design as a trademark. Even if we accept that consumers recognize the various drawings and pictures of the Museum's building design as being drawings and pictures of the Museum, the Museum's argument would still fall short. Such recognition is not the equivalent of the recognition that these *various* drawings or photographs indicate a *single* source of the goods on which they appear.")

Finally, we note that it is not clear from this record and applicant's arguments whether applicant is seeking registration under the provisions of Section 2(f) of the Trademark Act, 15 USC §1052(f), on the basis that the asserted mark has acquired distinctiveness, and even if it were clear, that claim must be rejected. While applicant submitted a declaration indicating that the building had "developed recognition" by a "third party," applicant did not mention this declaration in its main brief, or

otherwise claim that its entryway has acquired distinctiveness or secondary meaning. Therefore, even if we were to consider the issue of acquired distinctiveness as having been raised by applicant (and that is by no means clear), the failure to raise this issue in its brief is considered a waiver of any claim of acquired distinctiveness or request for registration under the provisions of Section 2(f). Also, in applicant's reply brief, applicant indicated that it agreed with the statement of issues set forth in the Examining Attorney's brief (which did not mention the issue of acquired distinctiveness) but applicant did refer to the declaration of its manager. However, even if this mention is considered sufficient to again raise the issue, mentioning it in a reply brief comes too late in this proceeding for us to consider the issue, because the Examining Attorney did not have an opportunity to review and discuss it. In any event, even if the issue of acquired distinctiveness were squarely before us, we would find that applicant's evidence that a "third party" (New York City Transit) regards the building as a prominent one in New York City music publishing history is insufficient to show that the entryway design itself has become distinctive among the

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relevant purchasers and users of applicant's specified real estate services and entertainment services.

Decision: The refusals of registration (that applicant's building entryway does not function as a service mark and that the specimens do not show use of the asserted mark as a service mark) are affirmed in both classes.