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Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re California Costume Collections, Inc.

Serial No. 76/053,913

Scott R. Miller and Diane M. Lambillotte of Riordan &
McKinzie for California Costume Collections, Inc.

Angela M. Micheli, Trademark Examining Attorney, Law Office
108 (David E. Shallant, Managing Attorney).

Before Simms, Hanak and Bottorff, Administrative Trademark
Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register
of the mark CALIFORNIA COSTUME COLLECTIONS (in typed form)
for goods identified in the application, as amended, as
"Halloween costumes; Halloween costumes and accessories

sold as a unit," in Class 25.¹ Applicant has asserted a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. §1052(f),² and has disclaimed COSTUME apart from the mark as shown.

The Trademark Examining Attorney has accepted the Section 2(f) claim³ but, finding applicant's disclaimer of COSTUME to be insufficient, has made final her refusal to register the mark absent a disclaimer of what she contends is the generic designation COSTUME COLLECTIONS.⁴ See Trademark Act Section 6, 15 U.S.C. §1056. That is, the

¹ Serial No. 76/053,913, filed May 22, 2000. The application is based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. §1051(a). In the application, applicant alleges February 1986 as the date of first use of the mark anywhere and September 1986 as the date of first use of the mark in commerce.

² Applicant made its Section 2(f) claim (at the Trademark Examining Attorney's suggestion) to overcome the Trademark Examining Attorney's initial refusal to register applicant's mark on the ground that it is primarily geographically descriptive. See Trademark Act Section 2(e)(2), 15 U.S.C. §1052(e)(2).

³ Actually, in her final Office action, the Trademark Examining Attorney did not expressly acknowledge or accept applicant's Section 2(f) claim, but neither did she continue or make any reference to her earlier Section 2(e)(2) refusal. Review of the Office's automated records shows that applicant's Section 2(f) claim has been entered. In view thereof, we deem the Section 2(e)(2) refusal to have been withdrawn/obviated by applicant's Section 2(f) claim.

⁴ In her first and subsequent Office actions, the Trademark Examining Attorney required applicant to disclaim COSTUME COLLECTION, in the singular, notwithstanding that applicant's mark is CALIFORNIA COSTUME COLLECTIONS. In their briefs on appeal, however, both applicant and the Trademark Examining Attorney have treated the requirement at issue on appeal as a requirement to disclaim COSTUME COLLECTIONS. We shall do likewise.

Trademark Examining Attorney contends that applicant must disclaim COSTUME COLLECTIONS, not merely COSTUME.

Applicant has appealed the requirement for a disclaimer of COSTUME COLLECTIONS, arguing that its disclaimer of COSTUME is sufficient. The appeal is fully briefed, but no oral hearing was requested.

After careful consideration of the evidence of record and the arguments of counsel, we find that although COSTUME is generic for applicant's goods and therefore is properly disclaimed, the evidence of record fails to support the Trademark Examining Attorney's requirement for a disclaimer of the phrase COSTUME COLLECTIONS.

The issue on appeal is whether COSTUME COLLECTIONS is generic for applicant's goods.⁵ The Trademark Examining

⁵ Two comments are in order on this point. First, applicant's claim under Section 2(f) that the mark has acquired distinctiveness constitutes an implicit admission by applicant that the wording in the mark is not inherently distinctive, i.e., that the phrase COSTUME COLLECTIONS is merely descriptive. See, e.g., *In re American Institute of Certified Public Accountants*, 65 USPQ2d 1972, 1980 (TTAB 2003); *In re Cabot Corp.*, 15 USPQ2d 1224 (TTAB 1990). Thus, applicant's argument that COSTUME COLLECTION is inherently distinctive is misplaced and unavailing; the issue on appeal is whether the term is generic.

Second, the dissent argues that even if this wording is not generic, it should be disclaimed because it is "highly descriptive" and applicant's Section 2(f) evidence (a statutory claim of five years' use) is insufficient to establish acquired distinctiveness. However, the issue of the sufficiency of applicant's Section 2(f) showing is not before us on appeal. The Trademark Examining Attorney's refusal and disclaimer requirement have always been based solely on genericness; she never refused registration on the alternative basis that, even if the term is not generic, it is highly descriptive and applicant's Section

Attorney may require an applicant to disclaim generic matter in a mark sought to be registered on the Principal Register under Section 2(f). See, e.g., *In re Creative Goldsmiths of Washington, Inc.*, 229 USPQ 766 (TTAB 1986). The determination of whether a term is generic "involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered understood by the relevant public primarily to refer to that genus of goods or services?" *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). Evidence of the public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers and other publications. See *In re Merrill Lynch, Pierce, Fenner and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987), and *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985). The Trademark Examining

2(f) evidence therefore is insufficient. If she had, then applicant would have had the opportunity to present additional evidence of acquired distinctiveness in response to that alternative basis for refusal. In short, the Trademark Examining Attorney never raised the issue of the sufficiency of the Section 2(f) evidence prior to appeal, and neither she nor applicant has presented any argument as to that issue on appeal. The only issue on appeal is genericness, and we therefore can affirm the disclaimer requirement only if the evidence of record establishes genericness.

Attorney bears the burden of proving that a term is generic by clear evidence. *In re Merrill Lynch, supra*.

Under the first part of the *Ginn* genericness test, we find that the genus of goods at issue in this case is the goods identified in the application, i.e., "Halloween costumes; Halloween costumes and accessories sold as a unit." See *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) ("Thus, a proper genericness inquiry focuses on the description of services [or goods] set forth in the certificate of registration [or application for registration]").

Having identified the genus of goods as "Halloween costumes; Halloween costumes and accessories sold as a unit," we next must determine (under the second *Ginn* factor) whether there is clear evidence in the record which shows that relevant purchasing public understands COSTUME COLLECTIONS to refer to that genus of goods. We find that there is not.

The Trademark Examining Attorney has made of record dictionary definitions of the words "costume" and "collection,"⁶ but there is no evidence of an entry in any

⁶ These definitions, from the online edition of Merriam-Webster's Collegiate Dictionary (accessed via the "yourdictionary.com" website), are as follows:

dictionary for the phrase "costume collection." To prove that a phrase, like COSTUME COLLECTIONS, is generic, the Trademark Examining Attorney must do more than show that each of the words in the phrase is generic;⁷ generic usage of the phrase itself must be shown. *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999). Therefore, the Trademark Examining Attorney's dictionary evidence fails to establish that COSTUME COLLECTIONS is generic for applicant's goods.

The Trademark Examining Attorney also has submitted excerpts of eighteen articles obtained from the Nexis database which, she contends, show use of the phrase COSTUME COLLECTION "as the name of a category of goods, a

costume: n 1: the prevailing fashion in coiffure, jewelry, and apparel of a period, country, or class 2: an outfit worn to create the appearance characteristic of a particular period, person, place, or thing 3: a person's ensemble of outer garments; especially : a woman's ensemble of dress with coat or jacket

collection: n 1: the act or process of collecting 2 a: something collected; especially : an accumulation of objects gathered for study, comparison, or exhibition or as a hobby b: group, aggregate c: a set of apparel designed for sale usually in a particular season

⁷ Moreover, we are not persuaded that the evidence in the record establishes that "collection," per se, is generic as applied to applicant's goods. There is no basis in the record for concluding that Halloween costumes typically are gathered or kept in collections, or sold in or as part of collections, within the meaning of any of the above-quoted dictionary definitions of that word.

costume collection."⁸ These articles show generic use of "costume collection" in reference to collections of historic, folkloric, or theatrical costumes which are gathered, kept and/or exhibited, as collections, by museums, cultural centers, universities and the like.⁹ The

⁸ The Trademark Examining Attorney's search for "costume collection" in the NEWS library, ALLNWS file of the Nexis database retrieved 1,327 stories.

⁹ For example:

Suen's project was to organize, label, photograph and catalog more than 1,000 pieces in the costume collection at the Chinese Cultural Center in Houston. (The Houston Chronicle, Oct. 4, 2001);

Items for the "moda y Musica" exhibit came from the museum's Latino entertainment and costume collections. (Corpus Christi Caller-Times, Sept. 24, 2001);

Rogers' friendship with Charles James, the Rodin of American haute couture, resulted in blouses, dresses, suits and gowns that form the backbone of the Brooklyn Museum of Art's costume collection. (The New York Times, Aug. 19, 2001);

A trip to this charming little show - displayed in a glass case several steps away from the municipality's courtroom - is a viable alternative to hopping a plane to Mexico City and taking in the indigenous costume collection at the Banco Serfin on Madero Street... (Phoenix New Times, Aug. 16, 2001);

...according to Bella Veksler, curator of Drexel University's historical costume collection. (The Morning Call (Allentown), July 13, 2001);

The young adult performers also will be able to study folkloric dance with master teachers and dance ethnologists from Croatian companies and to visit the costume collections in Etnografski Museum in Zagreb. (The Columbus Dispatch, Aug. 7, 2001); and

When Debbie Reynolds asked her daughter to bring a household name to an exhibition of her costume collection,

evidence also shows generic use of "costume collection" in the context of theatrical costumes worn by actors in movies and on stage and kept as "wardrobe"¹⁰ by movie and theatrical companies.¹¹

However, the genus of goods in this case is not historic, folkloric or theatrical costumes, or collections thereof. The genus of goods here is Halloween costumes, normal consumer items which, on this record, do not appear to be gathered, kept, exhibited or sold in or as part of "collections." The Trademark Examining Attorney's Nexis evidence shows that "costume collection" indeed may be

Carrie Fisher arrived with Rushdie. (Los Angeles Times, Sept. 4, 2001);

¹⁰ We take judicial notice that "wardrobe" is defined, *inter alia*, as "a collection of stage costumes and accessories." Webster's Ninth New Collegiate Dictionary (1990) at page 1328. The Board may take judicial notice of dictionary definitions. See, e.g., *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); see also TBMP §712.01.

¹¹ For example:

He knows a good stage costume collection when he sees one, and thinks he might someday try directing. (The Providence Journal-Bulletin, July 5, 2001); and

HEADLINE: Fabric into fantasy; Moritz's costumes transport audiences to storybook worlds

BODY: She studied fashion design for three years at Central High School and learned all she could from James Lewis Casaday, the drama director for South Bend schools who amassed a huge costume collection. (South Bend Tribune, June 17, 2001).

generic in the context of historical, folkloric or theatrical costumes and/or the institutions or entities that "collect" and use such costumes, but it does not follow therefrom that the phrase is generic for the quite different and commercially distinct genus of goods at issue here, i.e., Halloween costumes. See *Magic Wand Inc. v. RDB Inc.*, *supra* (fact that evidence shows BRUSHLESS to be generic for car wash equipment sold to owners of commercial car wash businesses does not establish that term is generic for commercial car wash services marketed to retail consumers); *cf. In re The Stroh Brewery Co.*, 34 USPQ2d 1796 (TTAB 1995)(fact that "virgin" is merely descriptive of one class of beverages does not establish that it is merely descriptive of different but related class of beverages).

In summary, we find that the Trademark Examining Attorney has failed to carry her burden of establishing, by clear evidence, that COSTUME COLLECTIONS is generic for the goods identified in the application, i.e., "Halloween costumes; Halloween costumes and accessories sold as a unit." We therefore find that applicant's disclaimer of COSTUME is sufficient, and that the phrase COSTUME COLLECTIONS need not be disclaimed.

Decision: The requirement for a disclaimer of COSTUME COLLECTIONS is reversed.

Simms, Administrative Trademark Judge, dissenting:

I disagree with the majority's decision that applicant need not submit a disclaimer of the words "COSTUME COLLECTIONS" in applicant's mark CALIFORNIA COSTUME COLLECTIONS. The words "COSTUME COLLECTIONS" are either generic or highly descriptive words as to which applicant has not shown sufficient evidence of acquired distinctiveness to warrant registration without a disclaimer.¹²

First, as to the distinction between a generic and a merely descriptive term, the Supreme Court has stated:

The provisions of the Lanham Act concerning registration and incontestability distinguish a mark that is "the common descriptive name of an article or

¹² While the majority has correctly characterized the issue on appeal, applicant maintains in its briefs that neither the word "COLLECTIONS" nor the expression "COSTUME COLLECTIONS" is merely descriptive. See appeal brief, 3 ("In this instance, the Examining Attorney has not met her burden of establishing that the portion of the mark required to be disclaimed—COSTUME COLLECTION—is descriptive when applied to the goods in the application."), and reply brief, 1, 3 and 4. Indeed, applicant claims to have submitted a disclaimer of the word "COSTUME" because it is descriptive. Reply brief, 2. As the majority has noted, however, applicant's Section 2(f) claim is an admission that these words are, at the very least, merely descriptive.

Also, Reg. No. 1,490,703, registered May 31, 1988 (cancelled under Sec. 8), which applicant claimed in its original application, issued on the Supplemental Register for the same mark for masquerade and Halloween costumes. Marks are placed on the Supplemental Register which are not registrable on the Principal Register (as, for example, primarily geographically descriptive and merely descriptive terms) but are nevertheless capable of distinguishing applicant's goods from those of others. See Section 23 of the Act, 15 USC §1091.

substance," from a mark that is "merely descriptive." § § 2(e), 14(c), 14(c), 15 U.S.C. § § 1052(e), 1064(c). Marks that constitute a common descriptive name are referred to as generic. A generic term is one that refers to the genus of which the particular product is a species. [Citation omitted.] Generic terms are not registrable, and a registered mark may be cancelled at any time on the grounds that it has become generic. See § § 2, 14(c), 15 U.S.C. § § 1052, 1064(c). A "merely descriptive" mark, in contrast, describes the qualities or characteristics of a good or service, and this type of mark may be registered only if the registrant shows that it has acquired secondary meaning, i.e., it "has become distinctive of the applicant's goods in commerce." § § 2(e), (f), 15 U.S.C. § § 1052(e), (f).

Park 'N Fly v. Dollar Park and Fly, Inc., 469 U.S. 189, 224 USPQ 327, 329 (1985). Section 14(3) of the Trademark Act, 15 USC §1064(3), was later amended to provide that "The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it is has been used." Thus, according to the statutory test, a mark is generic if its primary significance to the relevant public is a name of the product or service rather than an indicator of source.¹³ See also *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 23 USPQ2d 1081, 1083 (1992)("[G]eneric marks -- those

¹³ Applicant does not dispute that the test is the primary significance of the words in question to the relevant public. See appeal brief, 3.

that 'refe[r] to the genus of which the particular product is a species,'... are not registrable as trademarks.").

In the mark CALIFORNIA COSTUME COLLECTIONS, the word "COSTUME" is used as an adjective that qualifies or modifies the noun "COLLECTIONS." However, despite the use of "COSTUME" as an adjective in applicant's mark, the majority, while concluding that this word is generic, holds that the noun "COLLECTIONS," which it obviously qualifies, is only descriptive and not generic. I do not believe that the majority's analysis is correct, nor do I believe that the average or ordinary purchaser of a Halloween costume would analyze the phrase "COSTUME COLLECTIONS" in the manner that the majority has. That is to say, even if the average purchaser of applicant's Halloween costumes were to contemplate the words "COSTUME COLLECTIONS" in the mark, and assuming that person were aware of the ordinary uses of the word "collection" as reflected by this record, I do not believe that that average purchaser would view the term "COLLECTIONS" (or the expression "COSTUME COLLECTIONS") in applicant's mark in any different manner than those generic uses. In fact, as the majority has noted, the word "collection" is alternately defined as "a set of apparel

designed for sale usually in a particular season."¹⁴ It is apparently the majority's opinion, therefore, that while such words as "FALL COLLECTION" in the hypothetical mark CALIFORNIA FALL COLLECTION would be generic, the words "COSTUME COLLECTIONS" in the mark CALIFORNIA COSTUME COLLECTIONS would not be. I do not believe that the ordinary purchaser would make the subtle distinction that the majority is making.

Further, it must be remembered that the majority considers the words "COSTUME COLLECTIONS" in applicant's mark to be, at the very least, merely descriptive. Of course, it is well settled that for a term to be considered merely descriptive, within the meaning of Section 2(e)(1) of the Trademark Act, it must immediately describe a quality, characteristic or feature of the goods or directly convey information regarding the nature, function, purpose or use of the goods. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). Also, whether a term is merely descriptive is determined, not in the abstract, but in relation to the goods for which registration is sought. *In re Bright-Crest, Ltd.*, 204 USPQ

¹⁴ Webster's Third New International Dictionary Unabridged (1993) also defines the word "collection" as "2 a number of objects or persons or a quantity of a substance that has been collected or has collected often according to some unifying principle or orderly arrangement..."

591, 593 (TTAB 1979). Therefore, the words "COSTUME COLLECTIONS," even according to the majority, immediately describe a characteristic or feature of applicant's goods or directly convey information concerning the nature, purpose or use of applicant's goods. If that is the case, then it is difficult to understand why such a term, which has such immediate significance, somehow lacks the immediacy to be considered a generic noun in the phrase "COSTUME COLLECTIONS" in applicant's mark. Indeed, applicant has acknowledged that its "costumes run the gamut [sic] from animals to pirates and genies to Santa Claus." See appeal brief, 5-6, Request for Reconsideration, 3-4 and reproduction below.

CALIFORNIA COSTUME COLLECTIONS

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ADULT
VIPER
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JUMBO AFRO WIG
RAIN BOW
1951900795



GYPSY LADY WIG
1951960142



CHILD
GALAXY DANCER
1951900663



CHILD
GHOST
1951900265



CHILD
REVENGE OF THE NINJA
1951900172

In other words, applicant's goods would seem to be a wide variety of Halloween costumes, all of which may be exposed to the purchasing public at the same time. This is all the more reason that the average purchaser would not attribute any source indication to the expression "COSTUME COLLECTION" in applicant's mark, but would view this term as naming a category of goods--a collection of Halloween costumes. Certainly, if the statutory test is the primary significance of these words to the relevant purchasers, I

believe that this would be the significance given to these words, and that they would not be seen as a source indicator of applicant's goods.

However, even if one were to conclude that the word "COLLECTIONS" in applicant's mark is for some reason not a part of the generic expression "COSTUME COLLECTIONS," this word is certainly highly descriptive and, thus, unregistrable without an adequate showing of acquired distinctiveness. The Examining Attorney has shown numerous instances of the use of the expression "costume collection" as a generic one from excerpts in a number of printed publications, and there are numerous third-party registrations of record for a variety of goods containing the word "COLLECTION." These include such marks as BATH COLLECTION for towels, WELLNESS COLLECTION for nutritional supplements, CARVER'S COLLECTION for processed meats, THE TOWNSEND COLLECTION for lamps and lamp shades, PREMIUM CUP COLLECTION for coffee, THE MILLENIUM COLLECTION OF STATEHOOD TEDDY BEARS for stuffed toy animals, KAREN LYN'S COLLECTION for ceramic mugs, PAINTER'S COLLECTION for brushes, rollers, and roller pans, TRAVELER'S COLLECTION for travel newsletters and THE IRISH COLLECTION for retail store and mail order catalog services featuring a variety of goods such as jewelry, china, crystal, wearing apparel,

art, etc. all of Irish origin.¹⁵ Third-party registrations, while not evidence of use of those registered marks, may, of course, be considered in the same manner as dictionary definitions to help determine the significance of a term or expression to the general public. We may look at the use of the term "COLLECTION" in these registrations as some evidence of the significance of what it may have to the relevant purchasers. They are some evidence that marks containing this word are attractive to many businesses in a number of fields, are adopted to convey a meaning, and that such marks often co-exist and are distinguished because of the other terms used in conjunction with this word. See *Henry Siegel Co. v. M & R Mfg. Co.*, 4 USPQ2d 1154, 1161 n. 11 (TTAB 1987) and *Bost Bakery, Inc. v. Roland Industries, Inc.*, 216 USPQ 799, 801 n. 6 (TTAB 1982). See also *In re Save Venice New York, Inc.*, 259 F.3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001)(Court affirmed a determination that a mark which was dominated by THE VENICE COLLECTION was primarily

¹⁵ These third-party registrations were submitted by applicant to show registrations approved by this Office where the term "COLLECTION" was not disclaimed. Although she has not done so, the Examining Attorney undoubtedly could have submitted an equal or greater number of third-party registrations containing disclaimers of the word "COLLECTION." In any event, to the extent that others have registered this very term in connection with goods sold in retail stores to the general public, whether with a disclaimer or not, this evidence tends to show how the term may be perceived by the relevant purchasers.

geographically deceptively misdescriptive for a wide variety of goods including potpourri, tableware made of precious and nonprecious metals, lamps, clocks, art prints, paper products, residential furniture, dinnerware, glassware, bedding and carpets). These third-party registrations containing the word "COLLECTION," outside of the context of a "collection" maintained by a museum, cultural center or other institution, tend to demonstrate that the word "COLLECTION" (or "COLLECTIONS") will be perceived by the general public as having some significance outside of the significance which the majority attributes to this term--something which may be gathered or exhibited by museums, cultural centers, etc. In other words, these registrations and other uses show that the word "COLLECTION" is being used by various entities to identify an accumulation, group or set of goods and services that are available in stores or other commercial settings, not just in museums, cultural centers, universities, etc.

Further, applicant's submission of alleged distinctiveness consists only of a declaration attesting to the substantially exclusive and continuous use of applicant's mark for over five years. There is nothing in that declaration, however, which relates specifically to the word "COLLECTIONS" in the mark. The declaration only

indicates the belief of applicant's president that the entire mark has acquired distinctiveness. I do not believe that this declaration is sufficient to demonstrate acquired distinctiveness of the (at the very least) highly descriptive word "COLLECTIONS" or the expression "COSTUME COLLECTIONS" in the mark CALIFORNIA COSTUME COLLECTIONS. Of course, the level of distinctiveness that must be shown increases with the degree of descriptiveness that inheres in the mark. See *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988)["[T]he greater the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning"]. Nor does this record contain any evidence of the extent of sales or promotion of the mark here sought to be registered--only that applicant's mark has been the subject of substantially exclusive and continuous use for over five years. Therefore, it is highly unlikely in my opinion that the average purchaser of applicant's Halloween costumes would attribute any source indication to the word "COLLECTIONS" or the expression "COSTUME COLLECTIONS" apart from the mark CALIFORNIA COSTUME COLLECTIONS as a whole.

I would affirm the requirement under Section 6 for a disclaimer of the word "COLLECTIONS," in the expression

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"COSTUME COLLECTIONS" in applicant's mark, and refuse registration without a disclaimer of both words. Applicant should be given time in which to submit the required disclaimer.