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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Parham

Serial No. 76/199,487

Jill M. Pietrini of Manatt, Phelps & Phillips, LLP for Toikeon Parham.

Nicholas K. D. Altree, Trademark Examining Attorney, Law Office 109 (Ronald R. Sussman, Managing Attorney).

Before Hohein, Hairston and Walters, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Toikeon Parham has filed an application to register the term "MS. TOI" as a service mark for her "entertainment services in the nature of live musical performances."¹

Registration has been finally refused on the ground that the specimens of record are unacceptable because they fail to show service mark use of the term "MS. TOI" for entertainment

¹ Ser. No. 76/199,487, filed on January 24, 2001, which alleges a date of first use anywhere and in commerce of 1995.

services in the nature of live musical performances. Sections 1(a), 3 and 45 of the Trademark Act, 15 U.S.C. §§ 1051(a), 1053 and 1127; and Trademark Rule 2.56.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

According to her initial brief, applicant "is a famous musical artist in the rap genre." Applicant, in such brief, also states that the specimens of use originally filed with her application consist of "copies of magazine articles on the subject of Applicant." As accurately noted by the Examining Attorney in his brief, of the two specimens originally submitted, one "consists of a page from a magazine featuring a transcript of an interview conducted with the applicant," while the other (which seems to be a portion of an advertisement rather than an excerpt from a magazine article) "consists of a [representation of a] woman lying down surrounded by what appears to be pieces of fried chicken, along with the wording "on the menu ... ms. toi."² The former, which appears on page

² Although applicant asserts, in her initial brief, that "[t]he articles feature photographs of MS. TOI with a microphone and with other rap artists," and further contends, in her reply brief, that one such photograph "is featured in *The Source* magazine, and ... appears on the first page of the article submitted, page 98," the Examining Attorney is correct that the record does not contain any photographs or articles picturing applicant with a microphone.

100 of the June 1998 issue of *The Source*, sets forth the following pertinent excerpt (bold in original):

Ms. Toi, you did a lot of the singing, but had very little real mic time rapping. Why not?

MS. TOI: I was in Chicago when they finished the album, a member of my family passed. I came back and did the singing so I could be placed on the album. The guys handled they [sic?] business, and when I came back, I just vibed on hooks.

What will your role in the group [Militia] be?

MS. TOI: I hold things together with the femininity.

The latter specimen, underneath the words "finga lookin' good," lists the names of various individuals apparently responsible for "photography by," "art direction by," "fashion by," "hair by," "makeup/grooming by" and "chef/food styling by." Such credits are followed by, at the bottom, the names of "saafir," "terry dexter" and, as noted above "ms. toi," as being "on the menu."

Applicant, while continuing to maintain that the specimens originally filed evidence service mark use of the term "MS. TOI," submitted as an additional specimen "a photocopy of a label for a 'demo' videotape containing a live musical performance by Applicant."³ Such label reads as follows:

³ Although referred to by applicant as a "substitute" specimen, it is clear from her arguments that she relies on all three of the specimens of record as supporting her position.

ICE CUBE Featuring MACK 10 &
MS. TOI
Contact: DAN STUART, Esq.
Office: (310) 859-5227
Mobile: (310) 740-1080

Citing *In re Advertising and Marketing Development Inc.*, 821 F.2d 614, 2 USPQ2d 2010, 2014 (Fed. Cir. 1987), for the proposition that a specimen should be accepted as showing service mark use if the specimen shows a direct association between the mark sought to be registered and the identified services, applicant insists in her initial brief that:

Here, both sets of specimens show use of the mark for live musical performances. Specifically, the magazine article is one of the most effective forms of advertising for live musical performances, while the videotape is a "demo tape," used to market Applicant's live musical performances to promoters, record companies, and the like.

Applicant, in her reply brief, asserts that because "[m]usical artists grant interviews to promote their services, ... the articles that result are promotional material" and hence, in this case, the references to "MS. TOI" in the excerpt from the magazine article demonstrates service mark use thereof for live musical performances.

With respect to the videotape, applicant urges (for the first time in the prosecution of her application) that the case of *In re Ames*, 160 USPQ 214 (TTAB 1968), "is analogous to the facts of this appeal." In such case, the Board, supra at

215, held in connection with an application to register "NEAL FORD & THE FANATICS" as a service mark for "entertainment services rendered by a record[ing] and instrumental group" that specimens consisting of advertisements of phonograph records made by the group and which "[p]rominently featured ... a picture of the group ... beneath [which] ... there appears the wording 'booked by the Acuff-Rose Corporation', followed by the address and telephone number of said corporation," served to promote the entertainment services of the group in addition to the group's phonograph records. Similarly, applicant contends that (*italics in original*):

In this case, Applicant's specimens do much more than simply serve to promote Applicant's services. In fact, they offer an even stronger "direct connection" between Applicant's mark and her entertainment services than the samples accepted by the Board in *Ames*. Applicant's demo tape features footage of Applicant actually performing live--clearly showing Applicant's services--as opposed to the still photo of the musical group in *Ames*. As was the case in *Ames*, Applicant's demo tape is labeled with the booking contact for Applicant's live musical performances, namely Dan Stuart, along with his contact information. In addition, while the acceptable specimen in *Ames* was actually an advertisement for records, rather than live musical performances, Applicant's demo tape is promotional material for live musical performances. Applicant's demo tape specimen offers a direct association between Applicant's mark and her entertainment services, an association that is significantly more direct than the specimens

the Board held were acceptable in *Ames*.
Therefore, the Board should accept
Applicant's specimens.

As stated by the Board in *In re Mancino*, 219 USPQ 1047, 1048 (TTAB 1983), while "an individual's name may function to identify both the individual and the goods sold or services rendered by that individual," such a name "may be registrable as a trademark or service mark only if the specimens of use filed with the application demonstrate trademark or service mark use of the individual's name." If, however, the specimens of use demonstrate that an individual's name is used "merely to identify the particular individual who endorses the goods or performs the services set forth in the application," then the individual's name is not registrable as a trademark or service mark. *In re Lee Trevino Enterprises, Inc.*, 182 USPQ 253, 253 (TTAB 1974). Thus, the issue in this appeal is whether the specimens submitted in connection with the application evidence use of "MS. TOI" as a service mark to identify her entertainment services in the nature of live musical performances or whether they simply identify a particular musical performer named "MS. TOI."

We agree with the Examining Attorney that none of the specimens submitted by applicant shows service mark use of the term "MS. TOI" for entertainment services in the nature of live

musical performances. In particular, as the Examining Attorney accurately points out in his brief (*italics in original*):

[T]he magazine article submitted by the applicant shows nothing more than a transcript of an interview with the applicant, in which her name MS. TOI is used solely to identify her *as an individual*. In other words, nowhere in this magazine article is the wording MS. TOI used ... to identify the source of ... live musical performance services and to indicate their origin.

Likewise, with respect to the other originally filed specimen (which, we again note, seems to be a portion of an advertisement rather than an excerpt from a magazine article), it merely sets forth "ms. toi," along with two other individuals ("saafir" and "terry dexter") as the names of performers, just as such specimen variously credits the names of other individuals responsible for photography, art direction, fashions, hair styling, makeup and grooming, and food preparation. Similarly, as to the additional specimen, the use of the term "MS. TOI" on the label of a demo tape featuring footage of a live musical performance by applicant is solely that of naming one of the individual musical performers on such tape and not as a service mark for applicant's live musical performance.

We find, therefore, that this appeal is most analogous to the case of *In re Generation Gap Products, Inc.*, 179 USPQ 423 (TTAB 1971), in which an application for registration of

"GORDON ROSE" as a service mark for "singing group entertainment services" was refused "on the ground that the specimens filed show the designation 'GORDON ROSE' used to identify an individual who will perform the services claimed rather than as a mark used to identify and distinguish services rendered by applicant corporation." The Board affirmed the refusal, finding that the specimens of use, which consisted of record labels, flyers, newspaper advertisements and a letter circulated by the applicant corporation, failed to show use of "GORDON ROSE" as a service mark for singing group entertainment services. Such specimens, among other things, showed use of "GORDON ROSE" in the following contexts: "GORDON ROSE and the GENERATION GAP"; "newest singing personality ... GORDON ROSE"; "GORDON ROSE sings blues & ballads ... --Most exciting new artist of 1967!"; and "Gordon Rose is a total entertainer ... with a uniquely versatile singing style ranging from ballads and blues to folk-rock and pop." Id. The Board also noted in its decision that, as to "the advertisements in the trade newspaper, 'Variety', a name other than applicant or its predecessor is listed for persons desiring to secure the services of Gordon Rose, the individual." Id.

Based upon such specimens, the Board in *Generation Gap* held that:

It is our opinion ... that the designation "GORDON ROSE" is used merely to identify a particular individual of that name engaged in the entertainment world. Such use cannot be considered use of "GORDON ROSE" by applicant or its predecessor as a service mark to identify services that they may be rendering.

Id. at 423-24. In re Ames, supra, the case relied upon by the applicant therein and which, as mentioned previously, is also relied upon by the applicant herein, was distinguished by the Board as follows:

In that case, an individual, Richard C. Ames was seeking to register "NEAL FORD & THE FANATICS" for entertainment services rendered by a recording and instrumental group. Registration was refused on the ground that the specimens which comprised advertisements of records made by the group merely advertised the records and did not evidence use of the mark in the advertising of their services. The Board reversed[,] holding that the advertisements, which also contained pictures of the group and booking information, served to advertise the entertainment services of the group as well as the records. It is thus apparent that the basic issue in that proceeding was distinctly different from that involved herein and that the decision serves to reaffirm the proposition that each case must be resolved on the particular record adduced therein

The same is likewise true in this case. "MS. TOI," as stated previously, is used on the specimens solely as the name of a musical performer and not as a service mark for entertainment services in the nature of live musical

performances. In particular, while the demo tape is represented to contain a recording of a live musical performance by applicant, the label on such tape--which is the only indication of use of the term "MS. TOI"--evidences use thereof solely to identify the name of one of three performers (the others being "ICE CUBE" and "MACK 10"). Thus, notwithstanding the contact information which is also provided on the demo tape label, such specimen does not evidence service mark use of "MS. TOI" for applicant's services. In the same vein, neither of the originally filed specimens, as explained above, evidences use of "MS. TOI" as a service mark for applicant's services; instead, in each instance, such term is used to identify only the name of an individual musical performer and nothing more.

Decision: The refusal to register is affirmed.