

Mailed:

**THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT  
OF THE TTAB**

April 16, 2004  
Paper No. 24  
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **The Playtone Company**

Serial No. 75980911

**Anthony M. Keats** of Keats McFarland & Wilson LLP for **The Playtone Company**.

**Hanna Fisher**, Trademark Examining Attorney, Law Office 111 (Craig Taylor, Managing Attorney).

Before **Hohein, Walters and Holtzman**, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

**The Playtone Company** has filed an application to register the term "PLAYTONE" as a trademark for "printed matter, namely, posters."<sup>1</sup>

<sup>1</sup> Ser. No. 75980911, filed on June 22, 1998 as, initially, a part of Ser. No. 75506099, in which registration was sought on the basis of an allegation of a bona fide intention to use such term in commerce. Following issuance of a notice of allowance in connection with the parent application on September 28, 1999, applicant on June 1, 2000 submitted a petition to revive, a request for an extension of time to file a statement of use, and a request to divide, each of which was subsequently granted, and a statement of use setting forth June 1, 1999 as the date of first use anywhere and in commerce with respect to the goods in the child application, namely, posters. Thereafter, with the submission of a substitute specimen of use, applicant filed a verified amendment setting forth February 2002 as the date of first use anywhere and in commerce for such goods.

Registration has been finally refused, apparently under Sections 1(d)(1) and 45 of the Trademark Act, 15 U.S.C. §§ 1051(d)(1) and 1127, on the ground that as used on the specimens, the term "PLAYTONE" designates services and therefore does not function as a trademark for applicant's goods. Registration has also been finally refused under Section 1(d)(1) of the Trademark Act, 15 U.S.C. § 1051(d)(1), on the basis that such term had not been used in commerce by the time the statement of use was due.<sup>2</sup>

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

The various specimens filed in connection with the application appear to be photocopier reproductions of facsimiles of posters used to advertise various movies. Each of the first two of such specimens, however, were found to be "unacceptable as evidence of actual trademark use because it is indistinct and the mark cannot be seen." The two photographs submitted in response to the Examining Attorney's requirement for substitute specimens were found unacceptable because the posters shown therein display the designation "IMAGEMOVERS/PLAYTONE" instead of the term "PLAYTONE." In response to the continued requirement for substitute specimens, copies of the facsimile reproduced below,

---

<sup>2</sup> The grounds are succinctly stated in the final refusal as follows:

The requirements for acceptable specimens and use dates are made FINAL for the reasons set forth in earlier correspondence. Applicant apparently continues to file posters advertising its movie production services. The wording sought to be registered, PLAYTONE, designates services rather than posters.

which constitute the substitute specimens at issue herein, were furnished:



Although perhaps difficult to discern in the above, the term "PLAYTONE" appears as part of the phrase "A PLAYTONE PICTURE" on

the right-hand portion of the first of the six lines of text at the bottom of the "MY BIG FAT GREEK WEDDING" movie poster.<sup>3</sup>

Applicant, while conceding in its brief that it "could find no case presenting exactly the same facts as presented in this application," nonetheless argues that "controlling law has held that under analogous circumstances [an] Applicant's marks should be approved for registration." Specifically, citing and principally relying on *In re Polar Music International AB*, 714 F.2d 1567, 221 USPQ 315 (Fed. Cir. 1983),<sup>4</sup> as well as referring to *In re Cooper*, 254 F.2d 611, 117 USPQ 396 (CCPA 1958)<sup>5</sup> and *In*

---

<sup>3</sup> While such poster also shows, on the left-hand side of the fifth line from the bottom and just above the expression "YAHOO!," the words "PLAY" and "TONE" depicted within a circle and separated by a dot or a dash, the sole use of the term "PLAYTONE" is as part of the phrase "A PLAYTONE PRODUCTION" as noted above.

<sup>4</sup> Among other things, such case held in a two-to-one decision that the name of the musical group "ABBA" was registrable as a trademark for sound recordings containing musical performances by the group because the evidence established that the term "ABBA" indicated not just the source of the performances but a source of the records and tapes and the sound recorded thereon. 221 USPQ at 318. The court stated, in this regard, that while "just showing the name of the recording group on a record will not by itself enable that name to be registered as a trademark," in instances "[w]here, however, the owner of the mark controls the quality of the goods, and where the name of that recording group has been used numerous times on different records and has therefore come to represent an assurance of quality to the public, the name may be registered as a trademark since it functions as one." Id.

<sup>5</sup> The court therein held that the title of a single book, even if arbitrary, is not registrable as a trademark for books because, in essence, a book's title is considered to be nothing more than the name by which the book may be identified and thus is "descriptive" thereof in much the same way that other items of merchandise are identified. 117 USPQ at 398-400. Nonetheless, in dictum, the court also noted that the title of a series of books may be registrable as a trademark therefor where "[t]he name of the series is not descriptive of any one book and each book has its individual name or title." 117 USPQ at 400.

re First National City Bank, 168 USPQ 180 (TTAB 1970),<sup>6</sup> applicant maintains that while the poster for the movie "MY BIG FAT GREEK WEDDING" "is also used as a point of purchase display in order to advertise Applicant's goods in video rental stores," "such posters are sold separately as collector's items and the poster image is identical to the image on video disks and soundtrack CDs." In view thereof, and further asserting that, because the "mark PLAYTONE does not stand for any of the actors' names or the title of any film Applicant has produced," the "mark is arbitrary and is properly being used as a trademark to indicate Applicant as the source of origin of its films and posters advertising such films," applicant contends that (footnote omitted):

[J]ust as the Federal Circuit [in Polar Music] held that the ABBA mark was not simply being used to identify "the artist performing on the record rather than the source or origin of the goods," Applicant's mark PLAYTONE is being used to indicate Applicant as the source of origin of the goods rather than simply advertising the film or the artists performing in the film.

In addition, applicant urges that (emphasis by the court):<sup>7</sup>

---

<sup>6</sup> The Board in such case held that the title of a series of annually distributed record albums may be registered as a trademark for the series. 168 USPQ at 181.

<sup>7</sup> Applicant also insists that its "position is further analogous to Polar Music because Applicant exercises control over the quality of its products and ... has the right to exercise control over the quality of posters bearing Applicant's mark." With respect thereto, applicant contends that it "releases its films in the United States via distribution agreements with film studios" and "maintains licensing agreements with distribution companies and poster producers to ensure the quality of the posters bearing Applicant's PLAYTONE trademark." It is noted, however, that unlike the present appeal, the record in Polar Music contained a portion of an agreement licensing the mark at issue to a record company and requiring "appellant to produce and deliver ... master recordings embodying the performances" of the musical group. 221 USPQ at 316. The court, in particular,

[I]n Polar Music the Federal Circuit found that because the applicant [therein] had used the ABBA mark in connection with a series of musical titles, such use was "determinative that 'ABBA' functions as a trademark and is not just an identification of the singers ... [given that] the title to a series of records or books is able to function as and be registered as a trademark." Polar Music , ... [221 U.S.P.Q. at 318] (citing In re Cooper, ... 117 U.S.P.Q. 396, 400 (1958); [and] In re First Nat'l City Bank, 168 U.S.P.Q. 180 (TTAB 1970)). ... Applicant is similarly using its PLAYTONE mark to indicate itself as the source of ... its series of films "My Big Fat Greek Wedding," "Cast Away," and "Catch Me if You Can," and its Home Box Office miniseries "From Earth to the Moon." Therefore, Applicant's use is analogous to Polar Music and should be approved for registration.

We concur with the Examining Attorney, however, that as stated in her brief, "the record does not demonstrate that PLAYTONE would be perceived by readers as designating the source of posters." Clearly, as shown by the specimen reproduced previously, applicant is not analogously using the term "PLAYTONE" as either the title of a series of motion picture posters or as the name of a group of actors who perform in the various movies that its posters advertise, such that consumers would regard applicant's goods as "PLAYTONE" posters. Rather, as

---

pointed out that, "[b]y express provisions of the license, appellant controls the nature and quality of the goods"; that the recording company "recognizes appellant's ownership" of appellant's mark; and that, under the agreement, the appellant "is solely responsible for all recording costs incurred in the production of the masters, and is solely responsible for paying the artists and all others in respect of sales of recordings derived from the masters." Id. By contrast, there simply is no support in the record for applicant's insistence that it "has thoughtfully and properly exercised control over the nature and quality of Applicant's good and services through licensing agreements, production contracts and Applicant's direct supervision."

the Examining Attorney accurately observes with respect to the "My Big Fat Greek Wedding" poster:

The first line of text at the lower edge ... reads: Gold Circle Films presents in association with Home Box Office and MPH Entertainment a Playtone Picture "My Big Fat Greek Wedding". The next three lines contain the names of actors and actresses. ....

Section 45 of the Trademark Act, 15 U.S.C. §1127, defines a "trademark" as "any word, name, symbol, or device, or any combination thereof," which serves "to identify and distinguish [a person's] ... goods ... from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown." It is well settled, however, that not all words, designs or symbols used in the sale or advertising of goods function as trademarks, regardless of an applicant's intent that they do so. 1 J. McCarthy, McCarthy on Trademarks & Unfair Competition, Section 3:3 (4th ed. 2004). Rather, in order to be protected as a valid mark, a designation must create "a separate and distinct commercial impression, which thereby performs the trademark function of identifying the source of the goods to the customers." In re Chemical Dynamics, Inc., 839 F.2d 1569, 5 USPQ2d 1828, 1829-30 (Fed. Cir. 1988). A term or name does not function as a trademark unless it is used in a manner which projects to purchasers a single source of the goods. In re Morganroth, 208 USPQ 284, 287 (TTAB 1980). Thus, as set forth in In re Bose Corp., 546 F.2d 893, 192 USPQ 213, 215-16 (CCPA 1976) (*italics in original; citations and footnote omitted*):

The Trademark Act is not an act to register mere words, but rather to register trademarks. Before there can be

registration, there must be a trademark, and unless words have been so used they cannot qualify. ....

An important function of specimens in a trademark application is ... to enable the PTO to verify the statements made in the application regarding trademark use. In this regard, the manner in which an applicant has employed the asserted mark, as evidenced by the specimens of record, must be carefully considered in determining whether the asserted mark has been used as a *trademark* with respect to the goods named in the application. ....

As used on the specimen at issue herein, the term "PLAYTONE" does not create a separate and distinct commercial impression which performs the trademark function of identifying the source of applicant's posters. Aside from the fact that such term is buried within a line of text at the bottom portion of the poster shown by the specimen and thus is not used in a manner calculated to project to consumers and prospective purchasers of posters an indication of the source or origin of such goods, it is also the case that, even if noticed, the term "PLAYTONE" still does not function as a mark which identifies and distinguishes the source or origin of applicant's posters. The reason therefor is that such term, as noted previously, appears in the specimen as part of the phrase "A PLAYTONE PICTURE." As so used, the term "PLAYTONE" plainly refers to the name of an entity which acted as the producer of the motion picture "MY BIG FAT GREEK WEDDING" which is being advertised in the poster rather than serving as an indicator of a single source or origin of the poster itself. Accordingly, because the term "PLAYTONE" is not used in the specimen in a manner which projects to consumers and prospective

purchasers a single source of the goods for which registration is sought, it does not function as a trademark for posters.

Turning to the refusal on the ground that the term "PLAYTONE" had not been used in commerce by the time the statement of use was due, TMEP Section 1109.09(a) (3d ed. 2d rev. May 2003) provides in relevant part that:

The dates of use can be supplied after expiration of the statutory filing period; however, the applicant must make valid use of the mark in commerce on or in connection with all the goods/services in the application before the expiration of the time for filing the statement of use. 37 C.F.R. §2.71(c)(2). If the applicant attempts to amend the dates of use to state a date of first use in commerce that is later than the time permitted for filing the statement of use, the examining attorney must refuse registration because the applicant failed to make use within the time permitted, and hold the application abandoned. ....

Since, in the present case, a notice of allowance issued in connection with applicant's parent application on September 28, 1999, applicant had until September 28, 2000 to submit a statement of use in connection with the instant application, which is its child application, given that applicant requested and was granted with respect to the latter a six-month extension of time for filing its statement of use. Consequently, while applicant timely filed a statement of use on June 1, 2000 which set forth June 1, 1999 as the date of first use anywhere and in commerce with respect to the goods, namely, posters, in its child application, it subsequently filed, with the submission of a substitute specimen of use, a verified amendment on or about

March 5, 2002<sup>8</sup> setting forth February 2002 as the date of first use anywhere and in commerce for such goods. Registration was accordingly refused inasmuch as applicant's verified amended date of first use of February 2002 is plainly later than the date by which applicant was required to make valid use of the term "PLAYTONE" as a mark in commerce on or in connection with posters, which was the September 28, 2000 expiration date for filing the statement of use. See Trademark Rule 2.71(c)(2).

Applicant, in its brief, asserts that it "respectfully disagrees with the merit of" the Examining Attorney's argument, which it insists "is likely the result of a procedural error," that it had not made use of the term "PLAYTONE" as a mark in commerce for its posters prior to the time for filing its statement of use in connection therewith. However, rather than filing a verified amendment to set forth a date of first use anywhere and in commerce, such as the June 1, 1999 date set forth in the statement of use it filed on June 1, 2000, which is clearly on or before September 28, 2000, applicant merely submitted a copy of such statement of use. Moreover, despite the fact that the specimen submitted with the statement of use when originally filed was indistinct and the term "PLAYTONE" could not be seen, thereby prompting a requirement that applicant submit a substitute specimen (which, as noted earlier, was also found to be unacceptable), applicant insists that submitting a copy of its statement of use as originally filed establishes that:

---

<sup>8</sup> While the supporting declaration and accompanying response are both dated March 5, 2002, the certificate of mailing by Express Mail which is attached to the latter is dated March 4, 2002.

Applicant has used the PLAYTONE mark in commerce in connection with the goods at issue at least as early as June 1, 1999, which is prior to the date on which the statement of use was filed. Therefore, Applicant has properly verified its bona fide use of its mark in commerce during the period in question.

We concur with the Examining Attorney, however, that the refusal is well taken. As the Examining Attorney correctly points out, the declaration submitted by applicant on or about March 5, 2002 in support of its use of the substitute specimen which is for a poster for the movie "MY BIG FAT GREEK WEDDING" contains a date of first use anywhere and in commerce of February 2002, which is "well after applicant filed its June 1, 2002 SOU" (i.e., statement of use). In particular, the response filed by applicant on or about March 5, 2002 states that (underlining in original): "Applicant amends its Statement of Use as follows: Use of the mark anywhere: February 2002[;] Use of the mark in commerce: February 2002." Likewise, its supporting declaration for the substitute specimen recites that: "The correct dates of first use as stated in Applicant's Amendment are: Date of first use anywhere: February 2002 and Date of first use in commerce: February 2002." Thus, as the Examining Attorney properly notes, "[e]ffectively, the declaration states that the mark [PLAYTONE] was not in use in commerce ... when applicant filed its SOU" and the refusal, in view thereof, "must be maintained."<sup>9</sup> See Trademark Rule 2.71(c)(2).

---

<sup>9</sup> We note, moreover, that applicant has not further amended the dates of first use set forth in its statement of use. While the Examining Attorney adds that "[a] possible solution may be for applicant to submit a new declaration with use dates before June 1, 2000 or

Ser. No. 75980911

**Decision:** The refusals to register are affirmed.

---

September 28, 2000," such may not be possible if, as it would seem, the posters (and other promotional materials) for applicant's "MY BIG FAT GREEK WEDDING" motion picture were not in actual use until sometime shortly before the theatrical release of such movie in early 2002.