

THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Hearing:
May 5, 2005

Mailed: 6/30/2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Peabody Management, Inc.

Serial No. 76068295

Belinda J. Scrimenti and Matthew A. Griffin of Pattishall, McAuliffe, Newbury, Hilliard and Geraldson for applicant.

Teresa Rupp, Trademark Examining Attorney, Law Office 106 (Mary Sparrow, Managing Attorney).

Before Quinn, Hairston and Chapman, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Peabody Management, Inc. to register the matter shown below (hereinafter primarily referred to as "THE LEGEND") for "providing facilities for business meetings" (in International Class 35); and "providing facilities for banquets; hotel services; hotel catering and concierge services" (in International Class 42).¹

¹ Application Serial No. 76068295, filed June 12, 2000, alleging dates of first use in each class of 1981.

THE LEGEND OF THE DUCKS HOW DID THE TRADITION OF THE DUCKS IN THE PEABODY FOUNTAIN BEGIN? BACK IN THE 1930'S FRANK SHUTT, GENERAL MANAGER OF THE PEABODY, AND A FRIEND, CHIP BARWICK, RETURNED FROM A WEEKEND HUNTING TRIP TO ARKANSAS. THE MEN HAD A LITTLE TOO MUCH TENNESSEE SIPPIN' WHISKEY, AND THOUGHT IT WOULD BE FUNNY TO PLACE SOME OF THEIR LIVE DUCK DECOYS (IT WAS LEGAL THEN FOR HUNTERS TO USE LIVE DECOYS) IN THE BEAUTIFUL PEABODY FOUNTAIN. THREE SMALL ENGLISH CALL DUCKS WERE SELECTED AS "GUINEA PIGS," AND THE REACTION WAS NOTHING SHORT OF ENTHUSIASTIC. THUS BEGAN A PEABODY TRADITION WHICH WAS TO BECOME INTERNATIONALLY FAMOUS. THE ORIGINAL DUCKS HAVE LONG SINCE GONE, BUT AFTER MORE THAN 60 YEARS, THE MARBLE FOUNTAIN IN THE HOTEL LOBBY IS STILL GRACED WITH DUCKS. TODAY, THE MALLARDS ARE RAISED BY A LOCAL FARMER AND FRIEND OF THE HOTEL. THE DUCKS LIVE IN THE FOUNTAIN UNTIL THEY ARE FULL GROWN AND, ON RETIREMENT FROM THEIR PEABODY DUTIES, ARE RETURNED TO THE WILD. THE PEABODY DUCKS MARCH AT 11:00 AM AND 5:00 PM DAILY.

The trademark examining attorney refused registration under Sections 1, 2, 3 and 45 of the Trademark Act on the ground that the matter sought to be registered does not function as a service mark for the recited services.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs. An oral hearing was held before this panel of the Board.

Applicant operates The Peabody Hotels that are, according to applicant, "famous for the Peabody Duck

March." Applicant describes the event as follows (Brief, p. 1):

The Peabody Ducks march daily in the morning from their "Penthouse Palace" with the "Duckmaster" down a carpet to great fanfare to the Hotel lobbies' fountains, where they spend the day swimming. At the day's end, they repeat the March, in reverse, back from the fountain. The Duck March is the centerpiece of the Hotels' promotions. As part of that marketing, The Peabody Hotels promote the Duck March by wide use of the so-called "LEGEND"--the promotional, embellished marketing version of a tale about how the Duck March tradition began.

Applicant's website includes the following information:

"For all its history and grand tradition, nothing is more symbolic of The Peabody than its world-famous ducks, who spend part of every day swimming in the Grand Lobby fountain." Applicant indicates that its hotels are imbued with a duck theme and that its hotels make extensive use of "all things Duck," with registered duck word marks (including THE LEGEND OF THE DUCKS) and registered design marks.² The duck design mark is set forth below.

² Applicant also asserts that it owns a registration of a "motion" mark; however, that registration number was never made part of the record by applicant.



Applicant asserts that the matter it now seeks to register "has become a part of the Hotel lore itself"; that the "use of this unusual Mark must be considered in context of the already famous association of The Peabody Hotels with Ducks"; and that nothing in the Trademark Act limits service mark registrations to a set maximum number of words. Moreover, applicant argues, its proposed mark is no different than a variety of non-traditional marks that have been registered, including trade dress, building designs, colors, sounds, costumes and a fragrance. Applicant also points to eight third-party lengthy word marks that the Office has registered or for which notices of allowance have issued.

Applicant recognizes that its proposed mark is not a traditional one, but, according to applicant, that in itself is what makes its mark inherently distinctive and recognizable to its patrons. In this case, the matter sought to be registered not only serves to provide background to a unique event, the Duck March, but it is also used, applicant contends, in a commercial manner in

promotional and ancillary materials to indicate the source of applicant's services. These materials include concierge brochures, napkins, and presentation literature provided to travel and meeting planners. Applicant points out that it is not seeking registration of THE LEGEND as a trademark for the underlying story itself in connection with books, educational materials and the like, but rather it seeks registration as a service mark to distinguish applicant's hotel and related services. Applicant goes on to argue that "[t]hus, while the story of the Legend of the Ducks cannot function as a trademark for the story itself, it is capable of achieving service mark significance through its use in connection with the promotion of Applicant's hotel and related services." (Reply Brief, p. 4).

Applicant distinguishes THE LEGEND from historical stories about other hotels because applicant's THE LEGEND is a "creative, engaging, and very specific, embellished version of historical information." Id. Applicant also distinguishes its actual use from the way other hotels use historical information in that applicant's proposed mark is used on a variety of promotional materials and items that are distributed directly in connection with its services.

In support of its position, applicant submitted the declarations of one of its officers, and three of its

customers, all with related exhibits.³ Portions of applicant's website are also of record.

The examining attorney contends that while there is no absolute requirement that a mark be a certain number of words and/or designs, the length of the matter sought to be registered, 182 words, is a factor in determining whether the matter should be granted trademark protection or, rather, copyright protection. Although a slogan may be a candidate for both trademark and copyright protection, a longer collection of words, the examining attorney argues, is more likely a proper subject for a copyright, and not a trademark. According to the examining attorney, hotels commonly use long narratives about their history. In this connection, the examining attorney submitted materials distributed by other hotels that tell the history or folklore of the particular hotel in a story-like fashion. The examining attorney maintains that applicant is using the 182 words as a story about its hotels, and not as a service mark for its services.

The term "service mark" is defined, in pertinent part,

³ There was some discussion in the briefs about whether the examining attorney had considered all of this evidence. Both in her brief and at the oral hearing, the examining attorney indicated that all of the declarations, and the related exhibits (in color), were considered. Thus, applicant's request for remand is denied as moot.

in Section 45 of the Trademark Act, as "any word, name, symbol, or device, or any combination thereof (1) used by a person....to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown." Implicit in this statutory definition is a requirement that there be a direct association between the mark sought to be registered and the services specified in the application, that is, that it be used in such a manner that it would be readily perceived as identifying such services. See *In re Advertising & Marketing Development*, 821 F.2d 614, 2 USPQ2d 2010 (Fed. Cir. 1987); and *In re Whataburger Systems, Inc.*, 209 USPQ 428 (TTAB 1980).

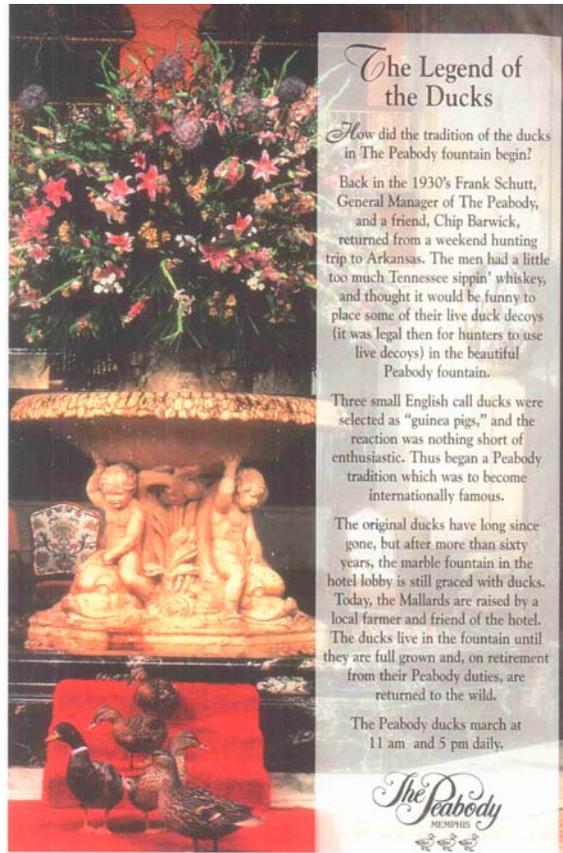
In this regard, the Court of Customs and Patent Appeals, a predecessor to the Court of Appeals for the Federal Circuit, stated the following: "The Trademark Act is not an act to register mere words, but rather to register trademarks. Before there can be registration, there must be a trademark, and unless words have been so used they cannot qualify." *In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1976), citing *In re Standard Oil Co.*, 275 F.2d 945, 125 USPQ 227 (CCPA 1960). Mere intent that a designation function as a trademark or service mark

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is not enough in and of itself. In re Morganroth, 208 USPQ 284 (TTAB 1980) ["Wishing does not make a trademark or service mark be."].

Whether a designation sought to be registered has been used as a mark for the goods or services recited in an application must be determined by examining the specimens and other evidence of use of record. In re Volvo Cars of North America Inc., 46 USPQ2d 1455 (TTAB 1998). A critical element in determining whether a designation is a trademark or service mark is the impression the designation makes on the relevant public. Accordingly, in this case, the critical inquiry becomes: Would THE LEGEND mark sought to be registered be perceived as a source indicator or merely an informational story? In re Remington Products Inc., 3 USPQ2d 1714 (TTAB 1987).

The specimen is a color photocopy of a glossy brochure featuring THE LEGEND. The record shows that the brochure is available in the public areas of applicant's hotels, including the concierge desk, for patrons to pick up and keep. The brochure is also included in some promotional packets sent to prospective meeting planners and other potential customers of applicant's services. The brochure from The Peabody Memphis is reproduced below.



A smaller version of the brochure may be found at The Peabody Orlando; that brochure reflects an abbreviated version of THE LEGEND. The record also includes a photocopy of a small napkin whereon an abbreviated version of THE LEGEND appears. Portions of applicant's website on the Internet depict the Duck March and set forth a historical narrative of the Duck March that incorporates much of THE LEGEND.

Of record are two declarations of Merilyn G. Mangum, applicant's assistant secretary and general counsel. Ms. Mangum states, in pertinent part, the following:

THE LEGEND OF THE DUCKS, in its entirety, strongly serves to identify The Peabody Hotels as a source of hotel and related services of not only high quality, but of truly unique stature.

Applicant respectfully submits that THE LEGEND OF THE DUCKS, by virtue of both its inherent distinctive nature and its use on numerous materials within the hotel functions as a service mark to identify The Peabody Hotels. First, a glossy brochure featuring THE LEGEND OF THE DUCKS is distributed at our Peabody Hotels in connection with the various services listed in the identification. For example, the brochure sits in public areas of the hotel, available for patrons present in the hotel facilities (who are partaking of any or all of our services), to pick up and keep. Additionally, the brochure is available at the concierge desk. The brochure is also included in promotional packets sent to prospective meeting planners and other potential customers of our business meeting services, hospitality services for major events, and catering services.

In addition to this brochure, THE LEGEND OF THE DUCKS is published in abbreviated form on napkins. These napkins are used in various contexts in the hotel, including at business meetings for use under water glasses and in connection with banquet and catering events. In short, patrons of The Peabody Hotels are exposed frequently during their visit to THE LEGEND OF THE DUCKS in connection with

the Hotels' services, just as they would see "THE PEABODY" mark, "THE PEABODY (Stylized)" logo mark, and our "THREE DUCKS" logo mark.

In addition to these items, THE LEGEND OF THE DUCKS is published on the Hotels' web sites. Each Hotel's website outlines the history of The Duck March and sets forth The LEGEND OF THE DUCKS. Indeed, THE LEGEND OF THE DUCKS is part of the lore of The Peabody Hotels, and its recitation by Hotel staff and through distribution of materials in connection with our services is part of the distinctiveness of The Peabody Hotels. Hence, it is respectfully submitted that, not only does THE LEGEND OF THE DUCKS perform a service mark function, but it is a very strong service mark that readily distinguishes and identifies our Hotels as a source of hotel and related services.

Also of record are three declarations of customers of applicant's services. The declarants are William C. Peeper, president of the Orlando/Orange County Convention and Visitors Bureau, Inc.; Patti Giles, owner of CLT Meetings International, Inc. (Ms. Giles arranges clients' conventions and business meetings, and acts as a travel agent for personal travel); and Debbie Brown, chief executive officer for Florida Chiropractic Association, Inc. (Ms. Brown arranges clients' conventions and business meetings, and acts as a travel agent for personal travel). The declarations are identically worded when referring to

the facts surrounding applicant's activities and to the declarants' view that the matter sought to be registered functions as a service mark for applicant's services. The declarations read, in pertinent part, as follows:

I am familiar with the hotels operated by Peabody Management, Inc. ("The Peabody Hotels"), which are well known, not only as hotels of high quality, but also for the unique nature of The Peabody Duck March, in which ducks march to and from the Hotels' lobby fountains daily, and spend the day swimming in The Peabody Hotels' fountains.

I perceive a strong association between The Peabody Hotels and a number of Duck associated marks used by The Peabody Hotels. These include the Three-Duck Logo, The Peabody Duck March itself, and the "story" of how The Peabody Duck March developed, known as THE LEGEND OF THE DUCKS.

I am aware of Peabody Hotels' continuous use of this Mark in promotional materials sent to meeting planners and others in the travel trade since [the specific date that the declarant first became aware of THE LEGEND OF THE DUCKS Mark].

Anytime I see use of ducks in connection with fine hotel and hospitality services, I think of the Peabody Hotels. Moreover, having been provided on multiple occasions with promotional materials such as that depicted in Exhibit 1 featuring THE LEGEND OF THE DUCKS Mark, which tells a specific, embellished recitation of the historical information, I recognize this particular recitation of the story

as promotional "lore" and "Legend" of The Peabody Hotels that is used as a mark for marketing purposes.

I do not perceive The Peabody Hotels' use of THE LEGEND OF THE DUCKS Mark as mere advertising copy or strict historical fact, but rather, as part of The Peabody Hotels' official trademark indicia which is associated with the Hotels themselves as the origin. Whenever I see the story of THE LEGEND OF THE DUCKS Mark I think of Peabody Hotels as the source of this engaging tale.

Once at the Peabody Hotel guests at The Peabody Hotel are repeatedly exposed to the various Duck marks, including uses of THE LEGEND OF THE DUCKS Mark. These items are distributed at the concierge desks, and a portion of the story is featured on cocktail napkins.

In sum, I perceive Peabody Hotels' use of THE LEGEND OF THE DUCKS Mark as a mark that indicates The Peabody Hotels as the source of the hotel and related hospitality services.

It is well settled that when matter imparts an impression of conveying advertising or promotional information rather than of distinguishing or identifying the source of the goods or services, it cannot function as a trademark or service mark. In re Niagara Frontier Services Inc., 221 USPQ 284, 285-85 (TTAB 1983). We find that the length of applicant's purported mark, although not dispositive, is a factor to be considered herein. See Smith v. M & B Sales and Manufacturing, 13 USPQ2d 2002,

2010 (N.D. Cal. 1990). Although the matter sought to be registered is not a "slogan," the situation is analogous.

As Professor McCarthy has stated:

[T]he longer the slogan, the less the probability that it functions as a trademark, and the greater the probability that the slogan is merely advertising copy--protectable, if at all, by copyright law.

Sometimes, advertising slogans are not in fact used as trademarks. Slogans often appear in such a context that they do not identify and distinguish the source of the goods or services. In such cases, they are neither protectable nor registrable as trademarks.

While slogans are capable of serving as trademarks, often they serve a subsidiary role to the main marks or house marks.

1 J.T. McCarthy, McCarthy on Trademarks and Unfair Competition § 7:20 (4th ed. Rev. 2005) Further, Professor McCarthy states that "[t]he most that can be generalized about this line between trademark and copyright is that the more words, the more the creation is in the realm of copyright. The fewer words, the more the creation is capable of trademark protection, assuming it is used as a mark." Id. at § 6:17.1. We find that these views pertaining to slogans are applicable to the matter involved herein.

In the present case, however, it is more than just the 182-word length of THE LEGEND that drives our determination. As used by applicant, THE LEGEND simply would not be viewed as a service mark for applicant's services. Rather, consumers likely would perceive THE LEGEND as advertising or promotional information about an event at applicant's hotels rather than as a source identifier for applicant's services of "providing facilities for business meetings" and "providing facilities for banquets" and for "hotel services; and hotel catering and concierge services." That is to say, applicant's specimen does not show use of THE LEGEND to identify the services for which applicant seeks registration; to the contrary, THE LEGEND conveys history and current information in the nature of an advertisement for the Duck March. We particularly note that THE LEGEND even sets forth the time of day of the Duck March ("11:00 AM AND 5:00 PM DAILY").

As shown by the examining attorney's evidence, particular stories and folklore may be associated with a hotel. The examining attorney submitted five examples of promotional efforts of third-party hotels. The advertisements include historical facts or, in the case of one establishment, a whimsical story about the hotel's cats

that greet guests. That a story is associated with a hotel does not mean, however, that the story functions as a source identifier for hotel and related services. THE LEGEND in no way serves to function as a service mark to identify and distinguish applicant's services. See *In re Moody's Investors Service, Inc.*, 13 USPQ2d 2043 (TTAB 1989) ["Aaa" for "providing ratings of fixed interest rate obligations" is used in the specimens to identify and distinguish not applicant's rating services, but rather the ratings themselves]. Simply put, THE LEGEND will not be recognized in and of itself as an indicator of origin for applicant's identified services, but rather will be perceived as historical and promotional information. See *In re National Geographic Society*, 83 USPQ 260 (Comm'r 1949) [For a designation to become a trademark, "it must be used in such a manner that its nature and function [as a trademark] are readily apparent and recognizable without extended analysis or research and certainly without legal opinion."]. See also 1 McCarthy on Trademarks and Unfair Competition, supra at § 3:3 ["In other words, if it takes extended analysis and legalistic argument to attempt to prove that a designation has been used in a trademark sense, then it has not. In the ordinary course of shopping, customers do not spend long periods of time

examining labels and advertising copy with a magnifying glass. Usually, if when viewed in context, it is not immediately obvious that a certain designation is being used as an indication of origin, then it probably is not. In that case, it is not a trademark."].

We are not persuaded by the declarations to reach a different result. What the declarations do tend to suggest is that at least three individuals recognize THE LEGEND and associate it with applicant. Although THE LEGEND may be associated with applicant's hotel, we cannot conclude, based on the present record, that the matter sought to be registered functions as a service mark.

As noted earlier, not every word, name, symbol, design, etc. that is associated with an applicant necessarily functions as a trademark or service mark. To function as a mark, and hence be registrable, the designation must be used as a mark to identify the applicant's goods or services. As stated by the Court of Customs and Patent Appeals: "Trademarks enable one to determine the existence of common source; but not everything that enables one to determine source is a trademark. A trademark distinguishes one man's goods from the goods of others; but not everything that enables goods to be distinguished will be protected as a trademark." In

re Deister Concentrator Co., Inc., 289 F.2d 496, 129 USPQ 314, 320 (CCPA 1961). Given the nature of how THE LEGEND is actually used, some level of recognition by only three individuals is hardly sufficient to make unregistrable matter into a service mark.

In urging that its applied-for mark be registered, applicant relies on three third-party applications and five third-party registrations.⁴ Applicant contends that these third-party marks are "comparable" to its own mark, and that "[t]hese lengthy marks reflect that a narrative of text can indeed serve as a mark, particularly where the text, such as THE LEGEND, has distinctive appeal and readily distinguishes the services by offering a captivating and memorable tale." (Brief, pp. 16-17).

The third-party application/registration evidence is entitled to little probative value. As to the applications, they are evidence of nothing more than that they were filed on particular dates. Although applicant indicates that a notice of allowance was issued in each of the three applications, an update of Office records shows that the three intent-to-use applications were abandoned

⁴ Although copies of the applications and registrations were not filed, the examining attorney treated them as if properly submitted. See TBMP § 1208.02 (2d ed. rev. 2004). Accordingly, we have considered this evidence in making our decision.

for failure to file a statement of use.⁵ Further, as pointed out by the examining attorney, the issue of whether an applied-for mark functions as a mark is normally not raised until specimens of actual use are filed with a statement of use. Insofar as the registrations are concerned, as the examining attorney highlights, only one of the marks covers services, and three of the other marks are labels. Such use is qualitatively different from the manner of applicant's actual use. In addition, while uniform treatment under the statute is an administrative goal, our task in this appeal is to determine, based on the record before us, whether applicant's particular matter sought to be registered functions as a service mark. See *In re Best Software Inc.*, 58 USPQ2d 1314 (TTAB 2001). Simply put, the third-party registrations do not compel a different result herein. In *re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ["Even if prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the Board or this court."].

⁵ The Board may take judicial notice of any changes to an official record that is introduced into the record. See *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650 (TTAB 2002); TBMP §704.03(b)(1) (2d ed. rev. 2004).

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For the foregoing reasons, we conclude, on this record, that the matter sought to be registered does not function as a service mark for the services identified in the application.

Decision: The refusal to register is affirmed as to both classes of services.