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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re A.D. 1619 Company

Serial No. 75/626,354

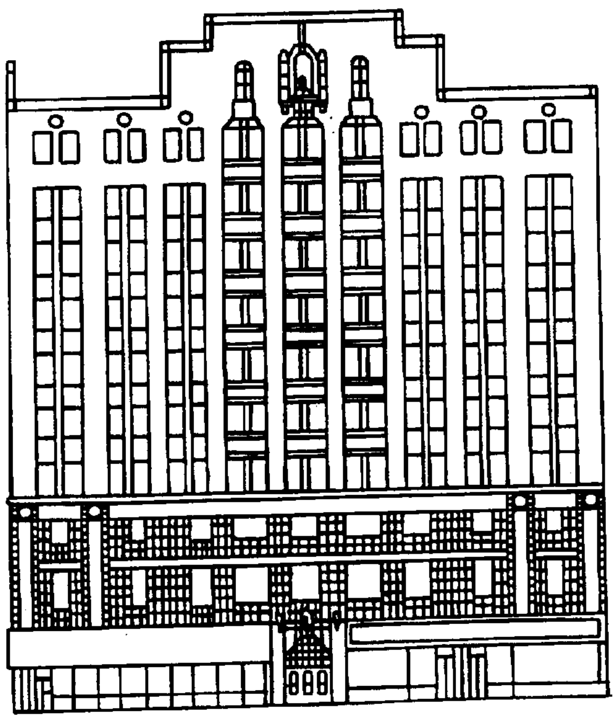
William S. Frommer of Frommer Lawrence & Haug LLP for A.D. 1619 Company.

Stacy B. Wahlberg, Trademark Examining Attorney, Law Office 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 design mark 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 visual settings for motion pictures, television broadcasts, and video and sound recordings, in Class 41.[1]



Applicant has described its mark as follows: “The mark consists of a ten story plus penthouse building façade, which at the penthouse parapet exterior, incorporates a bust of Mr. Abraham E. Lefcourt surrounded by ornamentation, and which, at the ground floor bronze

[1] Application Ser. No. 75/626,354, filed January 26, 1999, based upon allegations of use in commerce since March 1931.

doorway transom, at the Broadway entrance, incorporates a bust of Mr. Alan E. Lefcourt surrounded by ornamentation."

The Examining Attorney has refused registration on the grounds that applicant's building façade does not function 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.

It is the Examining Attorney's position that applicant's building façade does not function as a service mark for applicant's real estate and entertainment services because 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 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. The original specimens of record (a copy of which is reproduced below), are photographs of the building façade which, according to the Examining Attorney, show no more than the facade of the building.

This photograph is not sufficient, the Examining Attorney contends, to show use of the building façade 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 Examining Attorney also maintains that the record contains no promotion of the building façade as a service mark.

Accordingly, consumers are not likely to associate applicant's building façade with applicant's services, the Examining Attorney argues. The Examining Attorney has also made of record photographs of allegedly similar building facades in support of her argument that applicant's façade would not be perceived as a service mark.

With respect to the specimens, the Examining Attorney contends that they must show a direct association between the mark (building façade) 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 façade 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 various real estate and entertainment services. Accordingly, the Examining Attorney has requested that applicant submit specimens showing use of the asserted mark in connection with applicant's real estate and entertainment services.

Applicant, on the other hand, maintains that the building façade functions as a service mark for applicant's services. Applicant argues that it has extensively 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 façade) along with the additional specimens distributed to prospective tenants and customers show promotion of applicant's building façade as a service mark for applicant's services, including the offering of various real estate and entertainment support services, such as a screening room providing state-of-the-art film and video technology.[2] With its request for reconsideration, applicant has submitted a declaration from its manager attesting to the fact that applicant has "developed recognition by third parties" (New York City Transit) of its building design as identifying the source of applicant's services and that the building façade has become, in the opinion of applicant's manager, a distinctive indicator of source of applicant's services. In sum, applicant argues that the specimens demonstrate in

[2] We note that such screening room services are not within the amended description of the entertainment services listed in the application--the provision of background, backdrops, and visual settings for motion pictures, television broadcasts, and video and sound recordings.

the buyer's mind an association between the building façade and applicant's services.

Applicant has made of record a copy of a letter from New York City Transit, 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 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 "<u>THE BRILL BUILDING</u> 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 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. 1997). 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 use 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 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 perceived as a mark. See TMEP Section 1301.02(c). Evidence of such use might include letterhead stationery and the like which show promotion of the building's design 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 façade 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. See TMEP Section 1301.02(c). Here, applicant's building façade 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 various real estate and entertainment services. The facade 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 MetroCards, it stated that applicant’s building was a prominent building in New York music publishing history. This is not recognition by the relevant purchasers and potential purchasers that the façade 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, p. 6:

> Nowhere in the package of specimens submitted by the applicant is the applicant’s building façade used in a manner that would be perceived as a service mark in connection with [the] real estate and entertainment services provided. In fact, the only depictions of the exterior of the applicant’s building are pictures of the building similar to the applicant’s original specimen, but taken from a different angle, and a floor plan of the applicant’s building indicating where

> each of the applicant's tenants are [sic] housed. The specimens consisting of photographs of the exterior of applicant's building fail to show use of the mark in the sale and advertising of the applicant's services for the same reasons as the specimen originally submitted. The floor plan is unacceptable to show service mark usage of the applicant's building façade because it is merely informational matter about the applicant's building and the tenants housed there. The building layout is merely informational matter and does not function as a source identifier for the listed services.

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] 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 with its request for reconsideration 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 façade had acquired distinctiveness or secondary meaning. Therefore, even if one were to consider the issue of acquired distinctiveness as having been raised in applicant’s request for reconsideration (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 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 façade design itself has become distinctive among the relevant purchasers and users of applicant's various real estate services and its entertainment services.

Decision: The refusals of registration (that applicant's building façade 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.