

11/15/01

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 34
HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Larry Harmon Pictures Corporation

Serial No. 74/468,324

J. Allison Strickland of Fross Zelnick Lehrman & Zissu,
P.C. for Larry Harmon Pictures Corporation.

Elizabeth J. Winter, Trademark Examining Attorney, Law
Office 113 (Meryl L. Hershkowitz, Managing Attorney).

Before Hanak, Wendel and Bottorff, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Larry Harmon Pictures Corporation has filed an
application to register ANOTHER FINE MESS for "T-shirts."¹

¹ Serial No. 74/468,324, filed December 10, 1993. The application was filed as an intent-to-use application and originally encompassed goods in Classes 21, 24 and 25. By amendment goods in Class 16 were added. A notice of allowance issued for these goods on December 19, 1995. After several extensions of time, a statement of use was filed December 3, 1998. The goods at this point were restricted to T-shirts. The dates of use provided by applicant were at least as early as October 1998. The refusal of registration issued after submission of the statement of use and the accompanying specimens.

Registration has been finally refused under Sections 1, 2, and 45 on the ground that the proposed mark is ornamental, as used on the goods, and does not function as an indicator of the source of the goods.

The refusal has been appealed and both applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

The specimens of record show the mark being used on T-shirts in the following manner:



Applicant argues that the ornamentation refusal is improper because "the mark is recognized as an indicator of secondary source or sponsorship for the goods because the term 'another fine mess' is considered the 'trademark' saying of Oliver Hardy of the comic duo Laurel and Hardy."

(Brief p. 3). Applicant is in fact the owner of the right of publicity associated with Laurel and Hardy and owns registrations for the mark LAUREL AND HARDY. Applicant contends that persons who know the characters of Laurel and Hardy would be the main purchasers of applicant's T-shirts; that these persons would be well aware of the practice of the merchandising use of marks on T-shirts which are primarily used to identify other goods or services, especially in the field of entertainment; that these persons would associate applicant's use of the mark ANOTHER FINE MESS with the "trademark" phrase of Hardy; and that because the mark would be recognized as referring to Laurel and Hardy, the mark serves a source-identifying function as well as an ornamental function.

Applicant has submitted evidence to support its contention that an association would be made by the relevant public of the phrase "another fine mess" with the Hardy character of the Laurel and Hardy team. While a substantial amount of this material cannot be taken into consideration because it is either from unidentified sources, such as the newspaper articles in Exhibit A, or from foreign sources, such as several of the excerpts

retrieved from the Nexis database in Exhibit D,² the following evidence is acceptable for review:

While it was, naturally enough, Stan's idea to make the film, he was unhappy with the result and remade it in 1930 as *Another Fine Mess*. Then it was made with sound, including what was to become the most quoted fade-out line in movie history from Ollie to Stan: "Here's another fine mess you've gotten us into!"

F. L. Guiles, *Stan: The Life of Stan Laurel*;

The sketch became the foundation for the later Laurel & Hardy short subjects *Duck Soup* 1927 and *Another Fine Mess* 1930 - the latter version introducing Ollie's memorable lament.

W. D. Gehring, *Laurel & Hardy*;

Headline: Another fine mess Saturday

Let's see. How many people can remember the line "That's another fine mess you got me into" from the Stan Laurel and Oliver Hardy movies?

The Fresno Bee (September 21, 2000);

Headline: Laurel & Hardy followers yuk it up

Unfortunately, Laurel and Hardy, both long deceased... could not be at the event to enjoy the follies. But had they been, fans bet Hardy would have looked at them and said "Another fine mess."

The News Tribune (July 22, 2000);

Headline: Yet Another Fine Mess

Remember that inevitable scene in Laurel and Hardy films when Ollie would turn to Stan and say: "Well, here's another fine mess you've gotten me into!"?

Direct (March 1, 2000);

Then we shake our heads, point fingers at each other and, like Ollie in so many of the Laurel and Hardy classics, say, "Here's another fine mess you've gotten me into."

Anchorage Daily News (December 2, 1999);

² The issue being the perception of the mark by the public in the United States, the relevant material is that which has been in circulation in the United States.

The first thing that comes to mind as I see President Clinton bumbling into foreign policy is the old Laurel and Hardy plaint, "Well, here's another fine mess you've gotten us into."
The Cincinnati Enquirer (April 10, 1999).

Applicant argues that this evidence establishes that ANOTHER FINE MESS is the "signature phrase" associated with Laurel and Hardy and thus serves a source-indicating function. Applicant further points to the evidence of record showing that it has licensed the mark to Kenneth Cole for use in its advertising in the variation "That's another fine mess shoe've gotten us into" as a reflection of the fame of the phrase and of the advertiser's confidence that the public would make the association with Laurel and Hardy, despite the slight variation.

The Examining Attorney maintains that the proposed mark, as used on the specimen of record, is part of the aesthetic ornamentation of the goods. She notes that the phrase is shown at the top of a picture of Laurel and Hardy and considers the phrase to function merely as a caption or subtitle for the scene portrayed on the T-shirt. As such, she argues that the wording is simply "part of the thematic whole of the ornamentation of applicant's T-shirts and does not evoke the commercial impression of a source indicator." (Brief p.3). She maintains that in order to show that the

proposed mark serves as an identifier of a secondary source, applicant must provide evidence to show that proposed mark would be recognized as a mark through its use with other goods or services. But, according to the Examining Attorney, applicant has failed to provide any evidence that the wording ANOTHER FINE MESS has been used with other goods or services such that it would be perceived as a trademark or service mark or as an identifier of a secondary source. Applicant's evidence is said to show at best the use of the phrase in connection with Laurel and Hardy.

The Examining Attorney argues that a "signature phrase", as ANOTHER FINE MESS is argued to be, is not necessarily the equivalent of a trademark. In the first place, she refers to the evidence made of record consisting of excerpts of stories retrieved from the Nexis database in which the phrase "Another fine mess" is shown to have been used in various contexts without any reference to Laurel and Hardy. Second, even if recognized as a signature phrase of Laurel and Hardy, she insists that this is not the same as a trademark which is used to identify and distinguish a person's goods and that while the phrase has been used as the title of a single film, this is excluded from the scope of potentially registrable subject

matter. Finally, she argues that there is no evidence of record that purchasers would recognize the phrase as a trademark or that it has been promoted as a mark. In addition, she questions whether purchasers would make the association of the phrase with Laurel and Hardy when used alone, as it is sought to be registered, and not in conjunction with the photographs of the duo and/or the mark LAUREL AND HARDY.

It is well settled that matter which serves as part of the aesthetic ornamentation of goods, such as T-shirts, may nevertheless be registered as a trademark for such goods, if it also serves a source-indicating function. In *re Pro-Line Corp.*, 28 USPQ2d 1141 (TTAB 1993); In *re Dimitri's Inc.*, 9 USPQ2d 1666 (TTAB 1988). Such ornamental matter may be found to additionally serve a source-indicating function, and hence to be registrable, if, for example, it names the secondary source of the goods or if, at the time of its first use as ornamentation, it was already a recognized trademark of applicant for services or other goods. In *re Astro-Gods Inc.*, 223 USPQ 621 (TTAB 1984); In *re Paramount Pictures Corp.*, 213 USPQ 1111 (TTAB 1982) and In *re Olin Corp.*, 181 USPQ 182 (TTAB 1973).

As the Board stated in the *Olin Corp.* case at pages 182-183:

It is a matter of common knowledge that T-shirts are "ornamented" with various insignia, including college insignias, or "ornamented" with various sayings such as "Swallow Your Leader." In that sense what is sought to be registered could be construed to be ornamental. If such ornamentation is without any meaning other than as mere ornamentation it is apparent that the ornamentation could not and would not serve as an indicia of source. Thus, to use our own example, "Swallow Your leader" probably would not be considered as an indication of source.

The "ornamentation" of a T-shirt can be of a special nature which inherently tells the purchasing public the source of the T-shirt, not the source of manufacture but the secondary source. Thus, the name "New York University" and an illustration of the Hall of Fame, albeit it will serve as ornamentation on a T-shirt will also advise the purchaser that the university is the secondary source of that shirt. It is not imaginable that Columbia University will be the source of an N.Y.U. T-shirt. Where the shirt is distributed by other than the university the university's name on the shirt will indicate the sponsorship or authorization by the university. In the case before us, the T-shirt is ornamented with applicant's trademarks, and considering the nature of T-shirts, that particular ornamentation can serve as an indication of a secondary source of origin. The matter sought to be registered is an arbitrary symbol and can and does function as a trademark. As used on the T-shirts, we conclude that the mark serves as an identifier of a secondary source and as such is registrable.

Thus, in the *Olin Corp.* case, an arbitrary design which was applied to the face of the T-shirts was found registrable on the basis that the design had previously been registered as a trademark by the applicant for skis. It was this association which caused the mark, as used on the T-shirts, to function as an identifier of a secondary source.

In Paramount Pictures Corp., *supra*, the MORK & MINDY mark was held registrable for decalcomanias, on the basis primarily of its significance as a indicator of source or origin in the proprietor of the Mork & Mindy television series, although it was also noted to have already been registered as a trademark for various collateral products. The Board stated that while the names MORK & MINDY were certainly part of the ornamentation of the decals, they also indicated source in the same manner as the design in the *Olin Corp.* case.

In Watkins Glen International, Inc, 227 USPQ 727 (TTAB 1985), a flag design was found registrable for various clothing items on the basis that the design comprised the dominant portion of the applicant's prior registered service mark for organizing and conducting vehicular racing contests and thus was likely to be perceived not only as an attractive ornamental design but also as an indication of origin. Once again the similarity to the *Olin Corp.* case was noted, in that public association of the design with the applicant with respect to its auto racing services would cause the design to function as an indicator of source when used on collateral clothing items.

By comparison, in *In re Astro-Gods Inc.*, *supra*, the designation ASTRO GODS and design, sought to be registered

for T-shirts, was found to be nothing more than part of the thematic whole of the ornamentation of the applicant's shirts. The Board pointed out that the designation was not a recognized mark of applicant at the time it was first used ornamentally on T-shirts nor had it since been promoted in such a manner to create recognition of it as a trademark. Although applicant in some instances used a copyright notice containing applicant's trade name Astro Gods on the bottom of the T-shirts, the Board was not persuaded that purchasers would make an association between the designation and applicant's name in the copyright notice such that ASTRO GODS would be viewed as an indication of origin.

Similarly, in *In re Dimitri's Inc, supra*, the designation SUMO was found to be nothing other than part of the thematic whole of the ornamentation of the applicant's hats and T-shirts. The Board noted that the designation SUMO was always used in connection with stylized representations of sumo wrestlers and as such had a highly suggestive significance in relation to the rest of the ornamental matter on the goods. The statements of a relatively small number of customers with respect to an association of SUMO with applicant were found insufficient

to conclude that that designation functioned as a trademark for the goods.

As shown to be true in these prior cases, where an alleged mark serves as part of the aesthetic ornamentation of the goods, the size, location, dominance and significance of the alleged mark as applied to the goods are all factors which figure in the determination of whether this matter also serves as an indication of source. See *In re Dimitri's*, *supra*. Applying these factors to applicant's proposed mark, ANOTHER FINE MESS, and its use on T-shirts, it would appear at first blush that the phrase functions simply as a title or caption for the scene illustrated on the shirts. As such, the situation would be no different from the latter cases discussed above. The phrase would serve as no more than part of the thematic whole of the ornamentation on the shirt, as argued by the Examining Attorney.

We cannot ignore, however, applicant's contentions that ANOTHER FINE MESS, as used on these shirts, has a significance beyond that of merely captioning the scene portrayed on the goods. We find the evidence submitted by applicant sufficient to establish that "another fine mess" was the signature phrase of the comic duo of Laurel and Hardy. While the Examining Attorney has introduced

evidence of the use of the phrase by persons without making any reference to Laurel and Hardy, applicant's evidence is sufficient to convince us that many persons would be so familiar with the phrase that they would be prone to using it in connection with every day occurrences, without giving credit to the source of the phrase. Moreover, we agree with applicant that the purchasers of applicant's T-shirts would be likely to be persons who are familiar with Laurel and Hardy and that these purchasers would be apt to make the association between the phrase and the Hardy character of the Laurel and Hardy team.

The question which remains is whether the presence of this signature phrase serves to perform the function of identifying a secondary source for the goods. It is true that the phrase does not directly name any secondary source for the goods. Moreover, there is no evidence of record that the phrase already is a recognized trademark of applicant for any services or other goods, as in the *Olin Corp.* and *Watkins Glen* cases. The designation LAUREL AND HARDY would appear to fall within these categories, but not ANOTHER FINE MESS.

We do not believe, however, that the qualifications for serving as an indicator of a secondary source are so limited. As we quoted from the *Olin Corp.* case:

The ornamentation of a T-shirt can be of a special nature which *inherently* tells the purchasing public the source of the T-shirt, not the source of manufacture but the secondary source. [Emphasis added].

Here we have convincing evidence that the phrase ANOTHER FINE MESS points uniquely to the comic duo of Laurel and Hardy. The relevant purchasing public would make the association between the signature phrase and the performers. Furthermore, this public would certainly be familiar with the merchandising practice of using images or the names of entertainment persons or the characters they portray as the indication of secondary source on collateral items such as T-shirts, decals and the like. It was on this basis that the names MORK & MINDY, the characters in a television series, were found to function as an indicator of secondary source in the *Paramount Pictures* case.

While the use of a signature phrase is one step removed from the use of character names or images, we do not think the identification of source is any less positive. The phrase ANOTHER FINE MESS points distinctively to the comic team of Laurel and Hardy and thus inherently tells the public the secondary source of the T-shirts, just as clearly as would the names LAUREL AND HARDY. See *Lone Ranger, Inc. v. Cox*, 124 F.2d 650, 52 USPQ 146 (4th Cir. 1942)(Distinctive call "Hi, yo Silver"

associated by public with radio program Lone Ranger). Moreover, we find the evidence of record sufficient to establish that this association of ANOTHER FINE MESS and Laurel and Hardy would be so strong that persons would perceive the phrase as an indicator of secondary source of the goods, even when used alone, as the phrase is sought to be registered. ANOTHER FINE MESS functions as a mark for applicant's T-shirts, since although it may be part of the aesthetic ornamentation of the goods, it also serves a source-indicating function.

In making our determination of the registrability of this signature phrase, we have been guided by the general principle set forth in Paramount Pictures Corp., *supra* at 1113, that

while not every sign used on a product, or on its label, package, etc., functions as an indication of source of the product on which it is used - e.g., some are merely part of the aesthetic ornamentation - the broad and liberal interpretation of our law is that, where such a sign also serves a source indicating function, it should be regarded as acceptable subject matter for registration. [Citations omitted].

Decision: The refusal to register under Sections 1, 2 and 45 is reversed.