Hearing:
September 22, 2004

This Opinion is Not Citable as Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re WMAC, Inc. dba Working Mother Media

Serial No. 76407344

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Before Hohein, Rogers and Drost,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

WMAC, Inc., dba Working Mother Media, has applied to register ROLE MODEL on the Principal Register as a mark for "printed publications, namely magazines containing articles of interest to women." The application states that applicant has a bona fide intention to use the proposed mark in commerce and "presently intends to use the mark by imprinting [it] on covers for the magazines."

The examining attorney has refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), asserting that the proposed mark, when used, would be merely descriptive of the content of the publications. When the refusal of registration was made final, applicant appealed. Applicant and the examining attorney have filed briefs and oral arguments were presented.

The record on appeal includes a definition from an on-line dictionary (www.britannica.com/dictionary), which states that "role model" means "a person whose behavior in a particular role is imitated by others." (Submitted by applicant with its response to the initial refusal of registration.) Also in the record are two article excerpts retrieved by the examining attorney from the LEXIS/NEXIS database, and reprints of various web pages retrieved from the Internet by the examining attorney. (These were offered in support of the final refusal of registration.)

Of the two article excerpts retrieved from the LEXIS/NEXIS database, one is from a wire service and there is no evidence establishing that it actually appeared in a printed publication or on a web site. Accordingly, its probative value is not as great as the other excerpt, which actually appeared in a newspaper. In re Remacle, 66 USPQ2d

1222, 1224 n.5 (TTAB 2002)(with the advent of the Internet, newswire stories have more value than in years past, though not as much value as stories appearing in newspapers and magazines). The other excerpt is derived from an article that appeared in the St. Louis Post-Dispatch (May 20, 2003) and discusses the types of role models that young women can find appearing in various television programs.

Turning to the web page evidence, the examining attorney has put in the record a page discussing how to find and highlight female role models who have chosen nontraditional jobs (www.work4women.org/about/rolemodels); a page from the Role Model Project for Girls, which features a Role Model Registry (www.womenswork.org/girls); a page entitled "Dynamic Women Role Models," posted by students from a college computer class and featuring women "who have made significant strides in the field of engineering" (www.engr.psu.edu/wep/dynwomen); a page from the Family Education Network entitled "5 Women Role Models Are Front Page News" (www.familyeducation.com); a page from Discover the Outdoors featuring "Women Outdoors – Role Models" (www.dto.com/women/rolemodels); a page posting of a news release on a new book about women in aviation entitled "Leaders and Role Models for the 21st Century" (www.prweb.com/releases); a page from the YouthResource web

site on the difficulty lesbians have finding role models (www.youthresource.com/ourlives/womenzine); a page from the OutProud Community Role Models archive (www.transproud.com/community); and a page from the Harvard-Smithsonian Center for Astrophysics, announcing the center's participation in the "Eyes to the Future" mentoring program that "links middle-school girls of all abilities with female high-school role models and with women scientists" (www.Harvard.edu/newtop).

In its response to the initial refusal of registration, applicant explained that its publications would "comprise articles on a wide variety of topics of interest to women. As women try to balance careers and families, they often seek role models, an elusive concept relating to the 'right' choices, career plans and the like. Women can be role models, follow role models or both. Role models can be an individual, a group, or a combination. The mark ROLE MODEL only suggests something desirable to women in their pursuits of success of different types. It does not describe the contents of Applicant's publications."

Citing In re D.C. Comics, Inc., 689 F.2d 1042, 215 USPQ 394, 396 (CCPA 1982), applicant also argued that a mark may convey information about a characteristic of goods

and still function as a mark. In its request for reconsideration, applicant asserted that none of the examining attorney's evidence "support the Trademark Attorney's apparent position that a magazine with articles of interest to women is a role model, or someone who others seek to emulate, or, indeed, is about, or for, role models."

The examining attorney argues that "the wording, 'role model', which applicant seeks to register, merely describes, at least partially, the subject matter" of applicant's publication and it is not necessary that the wording describe all the contents of the publication for it to be held descriptive. Brief, unnumbered p. 2. In addition, the examining attorney asserts that the evidence of record shows that the relevant purchasing public for applicant's publications will readily understand the meaning of the wording "role model" and would be interested in publications with articles about the choices of other women, because "role models are among those topics of interest to women." Brief, unnumbered p. 3. Finally, the examining attorney contends that there is nothing incongruous about the wording "role model" as proposed for use by applicant and that the wording will lead prospective

purchasers or readers to make assumptions about the content of applicant's publications. Id.

Applicant, in briefing the appeal, argues that it has not conceded that its magazine will contain articles about role models but only that its magazine will contain articles of interest to women. Brief, pp. 4 & 5. Applicant asserts that "[t]here is no proof in the record that Applicant's mark would be construed by the average purchaser as identifying publications containing articles about people whose behavior in a particular role is imitated by others" and that "application of the term 'role model,' which in the English language denotes a person, to an inanimate object, namely a periodical, is incongruous." Brief, pp. 5-6. Applicant charges that the examining attorney is simply making unfounded assumptions about the likely content of applicant's publications and "[t]here is no proof that Applicant's magazines are about 'role models.'" Reply brief, p. 2.

Titles for publications such as newspapers and magazines often present perplexing problems, because of the tendency of their publishers to use the titles to convey some idea of the content of their publications. *See* H. Marvin Ginn Corp. v. Int'l Assn. Of Fire Chiefs, 782 F.2d 987, 228 USPQ 528, 530-31 (Fed. Cir. 1986). As a result of

this tendency toward revelation of content, most reported cases dealing with titles of publications deal with the question whether they are descriptive or generic, not descriptive or suggestive. *See* Technical Publishing Co. v. Lebhar-Friedman, Inc., 729 F.2d 1136, 222 USPQ 839, 841 (7th Cir. 1984); *see also* Scholastic, Inc. v. MacMillan, Inc., 650 F.Supp. 866, 2 USPQ2d 1191 (S.D.N.Y. 1987). As was the case for the *Scholastic* court, however, "the difficulty of discerning between descriptive and generic" need not concern us; applicant argues that its mark is not even descriptive but is only suggestive.

The analysis to be applied for distinguishing between what is descriptive and what is suggestive is articulated in In re Abcor Development Corporation, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978) ("A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of the goods. A term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods," *citing* Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 189 USPQ 759, 765 (2nd Cir. 1976).) In *Abcor*, the court also explained that the determination is to be made from the perspective of the average prospective purchaser. *Abcor*, 200 USPQ at 218.

Of course, applicant is correct in arguing that there is no "proof" in this record, i.e., no physical evidence, establishing the content of applicant's magazine, but that is of no surprise, because the application is based on applicant's stated *intention* to use the mark in commerce by imprinting it on magazines. On the other hand, applicant has identified the goods on which it intends to use its mark as "magazines containing articles of interest to women" and has stated that it will put the mark on the cover of the magazines. Moreover, applicant has indicated that women "often seek role models," and "can be role models, follow role models or both." The LEXIS/NEXIS article and web pages introduced by the examining attorney aptly illustrate this point.

It follows quite logically that "articles of interest to women" would include articles on women who are perceived as role models and articles on how women can find appropriate role models to emulate. Notwithstanding applicant's argument that the record bears no physical proof that its magazine will contain such articles, we must consider that it may, because such articles fall within the scope of the identified content for applicant's magazines. When ROLE MODEL is used on the cover of a magazine containing such articles, it provides the prospective

purchaser or reader with an immediate idea of the content; there would be no need to cogitate or ponder the possible meaning of ROLE MODEL.

Applicant argues that the determination of who may be a good role model for a woman is an "elusive" matter so that it is impossible to say who would be a suitable role model for any particular woman. It is not necessary, however, that a prospective purchaser or reader of applicant's magazine know, upon seeing a magazine titled ROLE MODEL, what types of role models might be featured in the magazine, or what types of strategies for finding role models may be outlined in the magazine. It is sufficient that ROLE MODEL would be perceived as identifying generally some of the content of the magazine. The possibility that one prospective purchaser or reader might think the magazine would contain articles about role models while another prospective purchaser or reader might think the magazine would contain articles about finding a suitable role model, does not render the term suggestive rather than descriptive, for neither individual would have to engage in elaborate reasoning to conclude that the magazine would discuss role models. *See* In re Vehicle Information Network Inc., 32 USPQ2d 1542, 1544 (TTAB 1994); *cf.* In re Bed & Breakfast Registry, 791 F.2d 157, 160, 229 USPQ 818 (Fed.

Cir. 1986) (Board did not err in finding BED & BREAKFAST REGISTRY descriptive on alternate theories that phrase would be understood to describe a register of bed and breakfast lodgings “and may convey the related thought of registering at a bed and breakfast lodging”.)

We find unpersuasive applicant’s arguments that the examining attorney has made unwarranted assumptions about the likely content of applicant's magazines. To a certain extent, this is required when an application for a mark to be used as a magazine title is based on an applicant's stated intention to use the mark. *See* In re American Psychological Association, 39 USPQ2d 1467 (Comm'r Pat. 1996) (Examining attorneys required to assess the descriptiveness vel non of a proposed mark for a publication even when application based on intention to use).

More importantly, the record shows that "role model" is a term whose meaning would be readily understood by prospective purchasers or readers of applicant's magazine, that the identified content of applicant's magazine must be read to encompass articles about the general subject of role models, and that use of ROLE MODEL on the cover of such a magazine would not require any thought or reasoning by a prospective purchaser or reader to determine something

definite about the magazine's content. Also unpersuasive is applicant's argument that ROLE MODEL cannot be a descriptive designation for a magazine, which is an inanimate object and per se, cannot be a role model. See *Marvin Ginn*, 228 USPQ 528, wherein FIRE CHIEF was determined to be not generic but descriptive, and which also involved use of that term on an inanimate object, specifically magazines.

Decision: The refusal to register under Section 2(e)(1) is affirmed.