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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Epic Games, Inc.

Serial No. 88233723

Christopher M. Thomas of Parker Poe
Adams & Bernstein LLP, for Epic Games, Inc.

Leslie L. Richards, Trademark Examining Attorney, Law Office 106,
Mary I. Sparrow, Managing Attorney.

Before Zervas, Wellington and English,
Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Epic Games, Inc. ("Applicant") seeks registration on the Principal Register of the proposed mark[1]

[1] For convenience, we refer to this proposed mark as "the llama," as does Applicant in its briefs.

for (i) "downloadable video game software" in International Class 9 pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming first use and first use in commerce at least as early as July 18, 2017; and (ii) "entertainment services, namely, providing online video games" in International Class 41 pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), claiming a bona fide intent to use the proposed mark in commerce.[2] The instant appeal, as discussed below, involves only the Class 9 goods.

[2] Application Serial No. 88233723 was filed on December 18, 2018. Color is not claimed as a feature of the mark. The description of the mark in the application provides that "[t]he mark consists of a fanciful cartoonish image of a llama with the design of a treasure chest on the side portion of its saddle."

Page references to the application record are to the downloadable .pdf version of the USPTO's Trademark Status & Document Retrieval (TSDR) system. References to the briefs and orders on appeal are to the Board's TTABVUE docket system.

I. Prosecution History

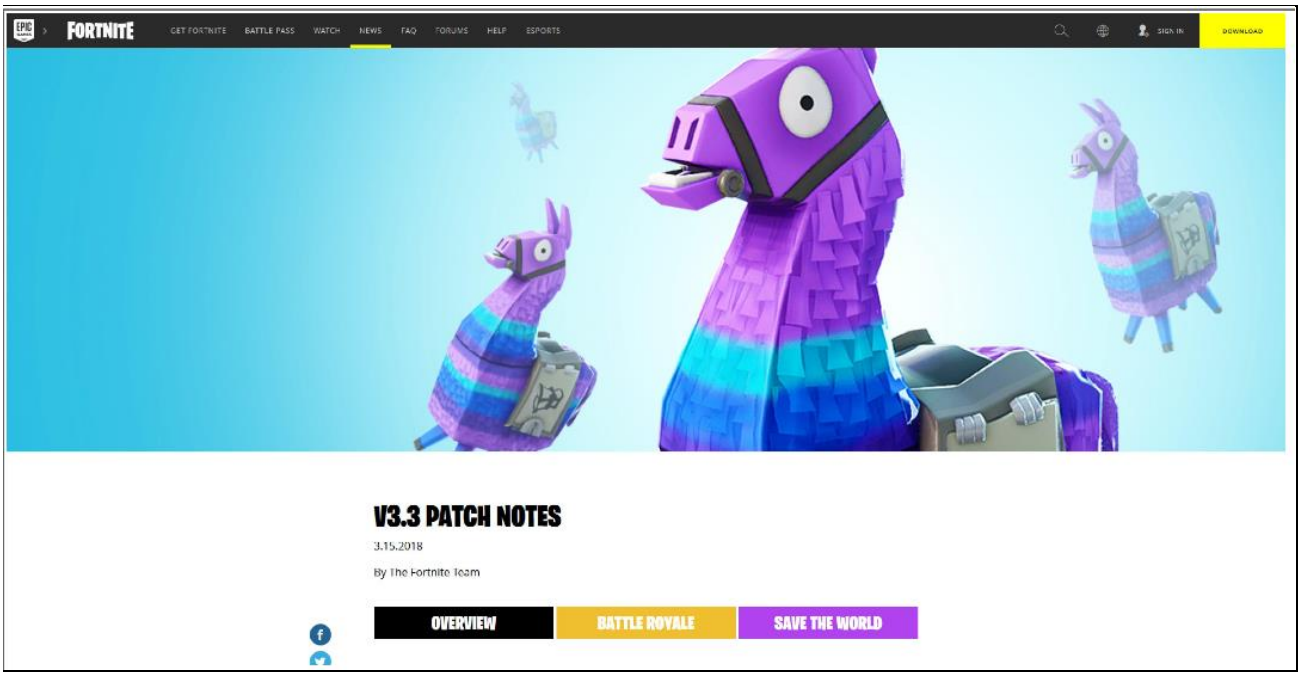
Applicant originally filed its application based on Section 1(a) only and identified the goods and services as:

> "stands for personal digital electronic devices, namely, cell phones" and "video game software" in International Class 9; and
>
> "entertainment services, namely, providing online video games" in International Class 41.

Applicant submitted numerous "image[s] showing use of the mark"[3] as specimens but did not identify the nature of the specimens in its original application. Only one image, which Applicant identified as a webpage printout in its February 5, 2020 Response (TSDR 9), shows the mark intact and in its entirety (hereinafter "V3.3 Patch Notes"):[4]

[3] Application, TSDR 1.

[4] Specimen, December 18, 2018, TSDR 1



Our focus in our decision hence is on the V3.3 Patch Notes image.

The Examining Attorney issued a first Office Action which, inter alia, (i) refused registration pursuant to Trademark Act Sections 1 and 45, 15 U.S.C. §§ 1051, 1127 and 37 C.F.R. §§ 2.34(a)(1)(iv), 2.56(a), on the ground the specimens do not show use of the applied-for mark for the International Class 41 services; (ii) refused registration for the International Class 41 services pursuant to Trademark Act Sections 1 and 45 and 37 C.F.R. §§ 2.34(a)(1)(iv), 2.56(a), on the ground the mark shown on the drawing does not match the mark shown on the specimens; and (iii) refused registration for the goods and services in both International Classes 9 and 41 on the ground that Applicant's applied-for mark fails to function as a mark and merely identifies a character under Trademark Act Sections 1, 2, 3 and 45, 15 U.S.C. §§ 1051-1052, 1127.

In its Response to the first Office Action, Applicant, inter alia, amended the application to seek registration under Section 1(b) for the International Class 41 services, obviating the first and second grounds for refusal listed above.[5]

After further prosecution, the Examining Attorney issued a Final Office Action which contained a single refusal under Trademark Act Sections 1, 2 and 45 "because the applied-for mark, as used on the specimen of record, identifies only a particular character in a creative work; it does not function as a trademark to identify and distinguish applicant's goods from those of others and to indicate the source of applicant's goods."[6] The Final Office Action does not mention the International Class 41 services and does not cite to Section 3 of the Trademark Act pertaining to services, but the Examining Attorney never explicitly withdrew the failure to function refusal for the International Class 41 services. When the Examining Attorney first refused registration of the International Class 41 services, Applicant sought registration of its mark for such services pursuant to Section 1(a). We find that in view of the prosecution record, and because the Examining Attorney only references the goods in the application in discussing the failure to function refusal in her brief,[7] the final refusal is not directed to the International Class 41 services, but only to the International Class 9 goods.[8]

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[5] September 11, 2019 Response, TSDR 1.

[6] March 10, 2020 Final Office Action, TSDR 1.

[7] Applicant's brief at p. 1, 8 TTABVUE 4.

[8] In this regard, we note TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 2012 (Oct. 2018) which states:

Applicant then filed a request for reconsideration which raised for the first time an alternative claim of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), stating, "assuming *arguendo* that the Llama is a 'character' and subject to refusal on that ground, Applicant respectfully submits **in the alternative** that the Llama has acquired distinctiveness under Section 2(f) of the Trademark Act …."[9] (emphasis in original). Applicant submitted evidence in support of its claim. Because we construe the failure to function refusal as pertaining only to the International Class 9 goods, we construe the alternative claim of acquired distinctiveness as limited to the International Class 9 goods.

The Examining Attorney was not persuaded by the request for reconsideration and maintained the refusal, stating:

> Applicant has argued that in the alternative the llama has acquired distinctiveness under Section 2(f) based on

> The issue of whether a designation functions as a mark usually is tied to the use of the mark, as evidenced by the specimen. Therefore, unless the drawing and description of the mark are dispositive of the failure to function without the need to consider a specimen, generally, no refusal on this basis will be issued in an intent-to-use application under §1(b) of the Trademark Act, 15 U.S.C. §1051(b), until the applicant has submitted a specimen(s) with an allegation of use (i.e., either an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d)). However, in a §1(b) application for which no specimen has been submitted, if the examining attorney anticipates that a refusal will be made on the ground that the matter presented for registration does not function as a mark, the potential refusal should be brought to the applicant's attention in the first Office action. This is done strictly as a courtesy. If information regarding this possible ground for refusal is not provided to the applicant before the allegation of use is filed, the USPTO is not precluded from refusing registration on this basis.

[9] May 1, 2020 Req. for Recon., TTABVUE 2.

> evidence submitted by applicant. However, this is not a proper response to the refusal. The name or illustration of a character is registrable as a trademark only where the record shows that it is used in a manner that would be perceived by consumers as identifying the source of the goods in addition to identifying the character.[10]

Applicant next appealed the failure to function refusal to this Board. The appeal is fully briefed. We affirm the refusal to register for the International Class 9 goods.

II. Background

Applicant's video game which is the subject of its specimens is described as follows in the Declaration of Christopher M. Thomas, Applicant's attorney:

1. On July 25, 2017, what is now known as *Fortnite: Save the World* was broadly released as the first game mode of Fortnite. It is a player-versus-environment (PvE) game in which players may band together to rebuild towns left vacant in the wake of "the Storm" and defend them from the monsters that populate this world.

2. On September 26, 2017, the free-to-play Fortnite "Battle Royale" game mode was broadly released to the public. Like other games in this genre, *Fortnite Battle Royale* involves dropping a limited number of players into a large map. *Fortnite Battle Royale* combines building skills and destructible environments, with intense player-versus-player (PvP) combat. When players land on the island, they gather various items - e.g., weapons and consumables such as ammunition, shield potion, bandages, medical kits, and building materials - they will need to survive and outlast the other players on the island.

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8. Applicant introduced the Llama item into Fortnite on or about March 15, 2018.[11] While moving about the map, a player may find a Llama item and open it to find weapons and consumables that the player may then pick up.

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[10] May 30, 2020 Denial of Req. for Recon., TSDR 1.

[11] Applicant does not identify the video game in which "the Llama item" appears. Wikipedia.org explains:

> V-Bucks in Save the World can be used to buy piñatas shaped like llamas to gain a random selection of items. In "Battle Royale", V-Bucks can be used to buy cosmetic items like

9. The Llama item is known to players, streamers, and fans as the "Loot Llama," "Supply Llama," or just "the Llama." In gameplay, the Llama item serves a function familiar to many players (e.g., a resource cache), but is portrayed in a unique and unusual way.

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11. A player opens the Llama item by pressing on the hand symbol hovering over the Llama item, as shown in the first screenshot above.

12. When opened, the Llama item disappears completely and the objects within fall to the ground, along with confetti ….[12]

III. Evidence

A. Evidence submitted by the Examining Attorney

● A definition of "character" from MERRIAM-WEBSTER DICTIONARY, including "one of the persons of a drama or novel."[13]

● Webpages regarding Applicant and third-party websites referring to "characters" in video games, for example:

> • Fortnite.fandom.com - "The Loot Llama's location is in random places inside of the safe zone"; "The Loot Llama is called Fred"; and "the Loot Llama is a cartoon-like piñata in the shape of a llama."
>
> • Gamedesigning.org – "Our 50 Favorite Video Game Characters" listing the proposed mark.[14]

> character models or the like or can also be used to purchase the game's Battle Pass, a tiered progression of customization rewards for gaining experience and completing certain objectives during the course of a "Battle Royale" season.

March 10, 2020 Final Office Action, TSDR 15.

[12] Declaration of Christopher M. Thomas, February 5, 2020 Response, TSDR 24-27.

[13] March 10, 2020 Final Office Action, TSDR 2.

[14] May 30, 2020 Denial of Req. for Recon., TSDR 22-25.

B. Evidence submitted by Applicant

● A dictionary entry for "character" from THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (5th ed. 2019), including "[a] person portrayed in an artistic piece, such as a drama or novel," and "[a] person or animal portrayed with a personality in a comics or animation: *a cartoon character*."[15]

● Mr. Thomas' Declaration, which also states:

> 3. Since its broad release, Fortnite has garnered over 250 million registered accounts. During regular gameplay, Fortnite has had concurrent player counts of over 8.3 million, and higher than that during special event gameplay.
>
> 4. Fortnite gameplay is streamed and broadcasted on platforms such as YouTube, Twitter, and Twitch, and is viewed by millions. Fortnite is reportedly one of the most watched video games on such platforms.
>
> 5. Fortnite is also a popular e-sport. The Fortnite World Cup was held in July 2019 in New York City at Arthur Ashe Stadium in front of a sold-out crowd of 19,000 fans and millions more online. The Fortnite World Cup was the most-watched competitive gaming event of all time outside of China.[16]

● On-line articles about Applicant and its video game, some of which mention the llama, from nbcnews.com, nymag.com, forbes.com, usatoday.com, variety.com, popsugar.com, yahoo.com, cnn.com, intelligerncer.com, businessinsider.com, trendhunter.com, cnbc.com, and theguardian.com.[17]

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[15] February 5, 2020 Response, TSDR 110.

[16] February 5, 2020 Response, TSDR 25.

[17] May 1, 2020 Req. for Recon. Exhs. A-E, J-R, TSDR 14-30; 60-109; Feb 5, 2020 Response, TSDR 41-85.

● Search results for "fortnite llama" and "fortnite and llama" on google.com and walmart.com.[18]

● Webpages from walmart.com offering a "Fortnite 7″ "Llama Loot Plush," a "Fortnite Llama Loot Pinata," a "Fortnite Jumbo Llama Loot Pinata" and an "8 Ft Light-Up Loot Llama Inflatable Decoration – Fortnite."[19]

● Webpages from retailers (Journeys, Kohl's and Spencer's) offering goods such as knapsacks, bedding and cups bearing the proposed mark, or only the llama's head, as designs on the goods.[20]

● Articles discussing the llama in Applicant's game, for example:

• Newsweek article dated February 22, 2019 titled "Toy Fair 2019: 'Fortnite' Makes Llamas the Industry's Hot New Trend." The article states:

> Whether it is an unspoken consciousness among toy companies or a secret plot by Big Llama, the llama has come to take over the 2019 toy market.
>
> ***
>
> But where has all this llama attention come from? Has the llama always been popular? All the people we talked to had one response: Fortnite, the popular video game whose primary mascot is a llama in pixilate form. The Fortnite llama is found in the battle royal game in the form of a loot box. Find one randomly and the treasure within can be yours. Fortnite has become so popular that numerous toy companies are vying for the hot license.[21]

[18] Feb 5, 2020 Response, TSDR at 86-89.

[19] *Id*. at 90-97.

[20] *Id*. at 105-108.

[21] May 1, 2020 Req. for Recon. Exh. F, TSDR 40-44.

• CNET article titled "Blame Fortnite for making llamas the hottest toy this year," stating:

> Llama tell ya, Fortnite is a big influence on toys.
>
> The popular battle royale game made its mark at this year's Toy Fair in New York.
>
> ***
>
> And then there are llamas. So many llamas. Llama board games. Llama collectible figurines. Spitting llamas. Twerking llamas. Rainbow unicorn llamas. Experts point the finger at the game Fortnite, when a loot-filled llama piñata became an informal mascot of sorts.[22]

The article includes:

This piñata made the toy world go llama crazy.
Mark Licea/CNET

[23]

• Games Radar article titled "Where are the best Fortnite llama locations?"

> "If you've had any sort of interaction with the world of Fortnite, then you should instantly recognize the iconic

[22] May 1, 2020 Req. for Recon. Exh. G, TSDR 46-47.

[23] May 1, 2020 Req. for Recon. Exh. G, TSDR 46.

> colourful piniatas that are Fortnite llamas and have become a well[-]known symbol of the game."[24]

IV. Arguments by Applicant and the Examining Attorney

The Examining Attorney argues that a "design of a character is registrable as a trademark only where the record shows that it is used in a manner that would be perceived by consumers as identifying the goods in addition to identifying the character,"[25] and:

> [T]he specimen(s) shows the applied-for mark used only to identify a character and not as a trademark for applicant's goods because it merely shows use of the proposed mark as a character that appears while consumers are playing applicant's games. As shown on applicant's specimens of use submitted with the application, the proposed [mark] merely appears as a character in the games or is used in advertising applicant's games and frequently appears as only a portion of the proposed mark.[26]

The Examining Attorney adds that "[t]he only specimen showing the entire proposed mark appears to be under the 'NEWS' tab on applicant's website, which appears to provide information or news about applicant's goods. On that specimen, the mark merely floats around the background of the screen multiple times as a character appearing in the game."[27]

Applicant disagrees that the llama is a character in its game. It argues that "character" is defined in relevant part as a "person or animal portrayed with a

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[24] *Id.*, Exh. H, TSDR 49. Although this article uses British spelling, an icon at the top of the webpage indicates that it is the "US Edition."

[25] Examining Attorney's brief, 8 TTABVUE 5.

[26] *Id.*

[27] *Id.*

personality in comics or animation: a cartoon character"; and that "[t]he Llama does not move, speak, or otherwise interact in any way with players or other objects. The Llama has no personality because it is an inanimate object within Fortnite. **Lacking any personality, Applicant's Llama simply does not meet the definition of the word 'character.'"**[28] (emphasis in original.) Applicant concludes, "because the Llama has no personality, it cannot be a 'character' and therefore it cannot, as the Examining Attorney claims, identify 'a particular character in a creative work.' For this reason, Applicant respectfully requests that the refusal be reversed."[29]

V. Analysis

"[A] proposed trademark is registrable only if it functions as an identifier of the source of the applicant's goods or services." *In re DePorter*, 129 USPQ2d 1298, 1299 (TTAB 2019) (citing 15 U.S.C. §§ 1051-1052, and 1127). The critical question in determining whether a proposed mark is capable of functioning as a trademark is the commercial impression it makes on the relevant public, i.e., whether the term sought to be registered would be perceived as a mark identifying the source of the goods or something else. *See In re Aerospace Optics, Inc.*, 78 USPQ2d 1861, 1862 (TTAB 2006) ("the mark must be used in such a manner that it would be readily perceived as identifying the specified goods. ... A critical element in determining whether matter sought to be registered as a trademark is the impression the matter makes on the relevant public." (citations omitted)); *In re Volvo Cars of N. Am. Inc.*, 46 USPQ2d

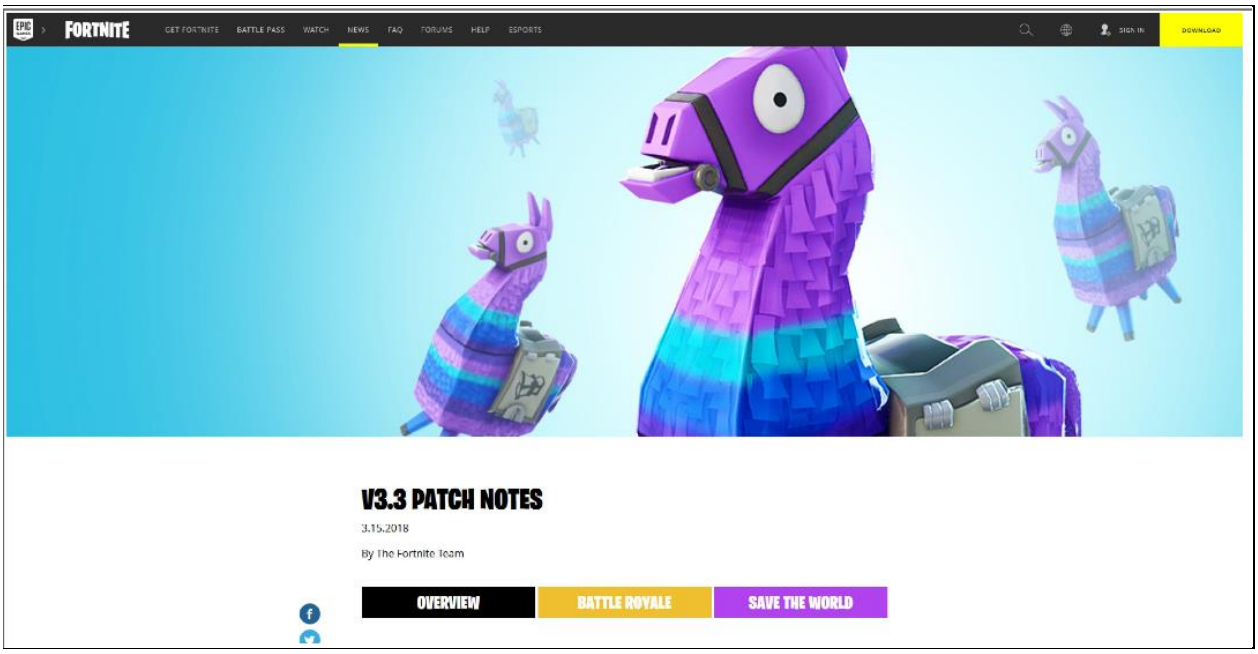
[28] Reply brief at pp. 3-4, 9 TTABVUE 4-5.

[29] Reply brief at p. 6, 9 TTABVUE 7.

1455, 1459 (TTAB 1998); *In re Remington Prods. Inc.*, 3 USPQ2d 1714, 1715 (TTAB 1987); *In re Morganroth*, 208 USPQ 284, 287 (TTAB 1980).

"The mere fact that a designation appears on the specimens of record does not make it a trademark." *In re Aerospace Optics*, 78 USPQ2d at 1862 (citing *In re Safariland Hunting Corp.*, 24 USPQ2d 1380 (TTAB 1992)). For Applicant's design to function as a mark, the design must be displayed on the specimens in a manner in which customers will recognize it as a mark. *See In re Morganroth*, 208 USPQ at 288 ("This necessitates a determination as to whether it is used and provided in such a manner so as both to make it known to purchasers and to have such individuals associate it with the goods as an identification symbol."); *see also In re Osterberg*, 83 USPQ2d 1220, 1223 (TTAB 2007) (finding that CONDOMTOY CONDOM was not displayed so prominently on web page specimen that consumers would recognize it as a trademark for condoms). "We determine whether this has been achieved by examining the specimens of use along with any other relevant material submitted by applicant during prosecution of the application." *In re Aerospace Optics*, 78 USPQ2d at 1862 (citation omitted).

As noted earlier in this decision, only the V3.3 Patch Notes webpage shows the mark intact and in its entirety. "In an application under section 1(a) of the Act, the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods and/or services." Trademark Rule 2.51(a), 37 C.F.R. § 2.51(a). The V3.3 Patch Notes webpage is duplicated again below for convenience:



The entire llama is displayed twice in muted colors, once in the near background on the right and again in the distant background on the left. The images of the entire llama are not the most prominent images on the webpage – portions of the llama are depicted twice in the foreground in colors which are far more vivid than the colors used on the proposed mark, thereby giving additional prominence to those designs. The repetition of the llama on the specimen in varying sizes, portions and vividity detracts from Applicant's claim that the single llama depicted in its drawing would be recognized as its mark. In addition, consumers considering the source of the webpage can look to the term FORTNITE which appears at the top left portion of the specimen. We thus find that the applied-for mark displayed on the V3.3 Patch Notes webpage is not used in a manner showing trademark use and does not function as a mark.

Applicant sought to demonstrate through evidence of acquired distinctiveness "that Fortnite is an immensely-popular cultural phenomenon and that the Llama is widely recognized as a symbol/mascot of Fortnite."[30] However, as the Examining Attorney explained, the issue here is whether the Applicant uses the design in a manner that it will be perceived as a trademark use, and not merely that of a character or game piece in the software game. Thus evidence showing other uses to establish acquired distinctiveness are off the mark. If it is used in such a manner as to be perceived as a trademark, then a showing of acquired distinctiveness is unnecessary. Conversely, if it is not used in a manner that it may be perceived as a trademark, evidence of use to establish acquired distinctiveness is unavailing. *See In re The Ride, Inc.*, 2020 USPQ2d 39644, at *33 (TTAB 2020) ("no amount of evidence of acquired distinctiveness can overcome a failure to function refusal [of tap dancing man]"); TMEP § 1212.02(i) ("[W]here the examining attorney has determined that matter sought to be registered is not registrable because it is not a mark within the meaning of the Trademark Act, a claim that the matter has acquired distinctiveness under § 2(f) as applied to the applicant's goods or services does not overcome the refusal."). Because we have concluded that the llama design as displayed on Applicant's V3.3 Patch Notes webpage fails to function as a mark, Applicant's claim of acquired distinctiveness in the alternative does not overcome that refusal.

We cannot ignore Applicant's evidence, however, and must consider the entire record in determining whether Applicant's proposed mark as displayed on its

[30] Applicant's brief at p. 8, 6 TTABVUE 9.

specimens will be perceived as a mark serving to indicate source rather than simply displaying part of the product, in this case a character or game piece in the software game. *See In re Aerospace Optics*, 78 USPQ2d at 1864 ("We determine whether this has been achieved by examining the specimens of use along with any other relevant material submitted by applicant during prosecution of the application." (citation omitted));[31] *In re Safariland Hunting*, 254 USPQ2d at 1381 ("However, we may also consider other evidence bearing on the question of what impact applicant's use is likely to have on purchasers and potential purchasers."). We look primarily, however, at Applicant's specimen. *Id.* ("Since the specimens of record show how the applied-for mark is actually used in commerce, we must primarily look to the specimens to see if the designation would be perceived as a source indicator." (citations omitted)).[32]

Much of Applicant's evidence concerns the number of players of Applicant's video games and comments in the press about Applicant, some of which mention the llama.

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[31] Of course, Applicant's argument that the Examining Attorney conceded that Applicant's proposed mark has acquired distinctiveness because the Examining Attorney did not further discuss the issue of acquired distinctiveness is meritless. Applicant's citation to *In re Rolf Dietrich*, 91 USPQ2d 1622 (TTAB 2009), for support is misplaced. In that case, one issue was whether the configuration therein would be registrable with an appropriate Section 2(f) showing. In this case, acquired distinctiveness is not an issue in connection with the failure to function refusal. *Rolf Dietrich* is clearly inapposite.

[32] Altman, Louis, CALLMANN ON UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES § 17A:3, fn.1 (4th ed. Dec. 2020 update) explains:

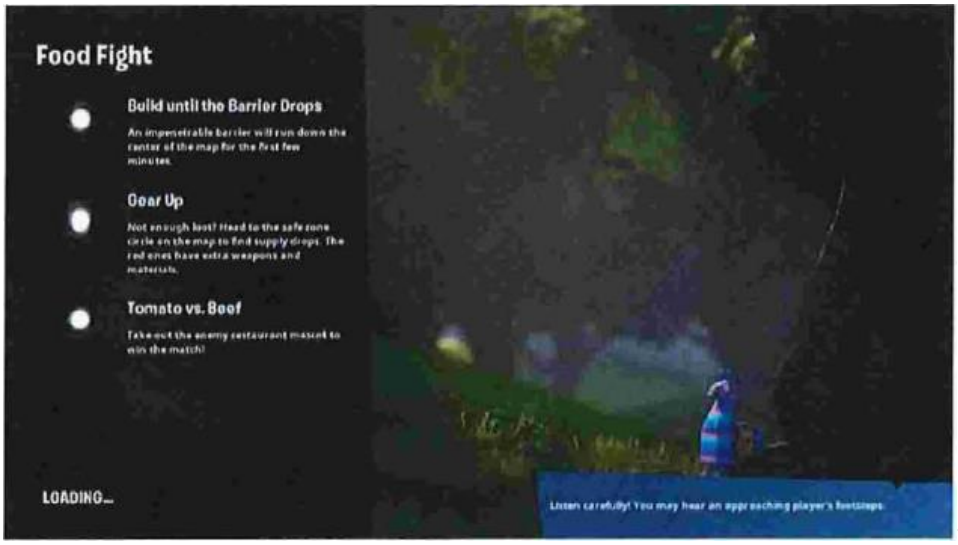
> For federal registration purposes, however, non-trademark use in the specimens which are submitted with the registration application may be supplemented by other examples of use of the mark, to establish that the mark would be perceived as a trademark for the goods, even though such other uses are not sufficient in themselves to support registration because they are on documents which are not affixed to or associated with the goods.

This is not helpful in demonstrating the central issue before us, whether Applicant's llama design as used on the V3.3 Patch Notes functions as a source indicator. Neither is the numerous plush llama toy animals or llama piñatas available through retailers such as Walmart and Amazon, because these do show use on Applicant's video games.

Turning to the Declaration, Mr. Thomas describes how the llama design appears when a player begins to play Applicant's video game:

> 17. … Upon opening Applicant's free-to-play version of Fortnite, a home screen appears. The Llama item is prominently displayed at the bottom of the home page under the option to begin gameplay by clicking on the "PLAY" button:

> 18. After pressing the "PLAY" button on the home screen, players may see a loading screen before gameplay begins. Such loading screen also displays the Llama item:



[33]

Our precedent requires us to consider non-specimen uses of a proposed mark. In *Safariland Hunting*, the Board considered whether the term SAFARILAND in the phrase or slogan "Made by the Good Ole Boys at Safariland!" on specimens functioned as a mark. *In re Safariland Hunting*, 254 USPQ2d at 1381. In addition to the specimens, the Board considered a product catalog which included (i) a listing of "Contents" on the inside cover with "Tink's Safariland" as the first listing; and (ii) a back cover with the statements, "A Greatly Expanded Magazine ad schedule cements the Tink's Safariland & Ben Lee names in the hunter's mind" and "Hunters everywhere will be seeing Tink's Safariland & Ben Lee ads in popular hunting publications through its greatly increased advertising schedule." *Id.* at 1382. The Board concluded:

[33] February 5, 2020 Response to Office Action, TSDR 29-30.

> Such uses of SAFARILAND in applicant's catalog enhance the use on applicant's containers that is to say, the catalog convinces us that purchasers, when seeing SAFARILAND on the containers, would perceive the designation as indicating source or origin. We think that SAFARILAND, as shown by the record taken as a whole, functions as a trademark and will be recognized in itself as an indication of origin for animal scents.

Id.

Mr. Thomas' testimony and the screenshots displayed in his Declaration do not persuade us that consumers encountering the applied-for llama design on Applicant's V3.3 Patch Notes specimen would perceive it as an indicator of source. First, the applied-for design is not depicted in the first image; the saddlebag on the home screen differs from that on the drawing page. Second, the llama in the loading screen appears in what seems to be a scene from the video game and is not used in a manner to indicate source. Third, there is no claim of trademark rights through the designation "TM." *See In re Sones*, 590 F.3d 1282, 93 USPQ2d 1118, 1124 (Fed. Cir. 2009) ("Though not dispositive, the 'use of the designation 'TM' … lends a degree of visual prominence to the term.'" (quoting *In re Dell Inc.*, 71 USPQ2d 1725, 1729) (TTAB 2004)).

Applicant also argues:

> It makes no sense to refuse a mark on the academic ground that it fails to function as a mark when the undisputed evidence demonstrates that it in fact does function as (and therefore is) a trademark. Indeed, this principle is consistent with that which the Office and the courts apply with respect to the registration of product design; it is impossible to use the shape of a product itself as a trademark, yet an applicant asserting rights in product design may avail itself of Section 2(f) to prove that, in fact, the product design has acquired distinctiveness in the

> minds of consumers and should be registered as a trademark.[34]

Applicant's argument ignores that a specimen must be submitted demonstrating use of the applied-for mark as a trademark or service mark. *See* Trademark Act § 1(a)(1); Trademark Rules 2.34(a)(1)(iv), 2.56(a), 37 C.F.R. §§ 2.34(a)(1)(iv), 2.56(a); *see also* TMEP §§ 904.03(e) (i), 904.07, 1202.10. As explained in *In re Caserta*, 46 USPQ2d 1088, 1090 (TTAB 1998):

> There is no question that the name of a fictitious character may be registrable as a trademark or a service mark if that name is used on or in association with the goods in such a manner as to identify the goods and distinguish them from those of others, and the goods are sold or transported in commerce. Likewise, as applicant correctly notes, a finding that the fictitious character's name is well-known is not a prerequisite to the registrability of that name as a trademark. Rather, the sole issue is whether the name of the fictitious character is used in such a manner that it is likely to be perceived as a trademark in connection with the identified goods. This is quite distinct from a finding that a mark is well known, which involves consideration of the renown of the mark among relevant consumers.

Applicant submitted a webpage as a specimen of use for "downloadable video game software," and hence must meet the requirements for demonstrating that the webpage demonstrates use of the proposed mark as a source indicator for such goods. Its specimens of use do not show use of the llama as a mark to demonstrate that it functions as a source indicator for such goods.

[34] Applicant's brief at p. 13, 6 TTABVUE 14.

VI. Conclusion

As used on Applicant's specimens, the proposed mark fails to function as a mark under Trademark Act Sections 1, 2 and 45 for "downloadable video game software" in International Class 9.

Decision: The refusal to register the proposed mark is affirmed for the goods in International Class 9 because it fails to function as a mark.

The application will otherwise proceed to await the filing of a statement of use for the International Class 41 services.