Maria, Maia, and the importance of public perception in trademark registration

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03 October 2023

UNITED STATES OF AMERICA
Legal updates: case law analysis and intelligence

- **The case involved an application to register a design consisting of the face of a video game character in Class 9**
- **The examiner found that consumer perception of the design would be only as showing a game character, and not as any indicator of source**
- **The TTAB agreed that the design was not being used in a way that would be perceived as a trademark indicating the source of the goods**

In ***In re Stallard*** (Serial No 97115036, 28 August 2023) (precedential), the Trademark Trial and Appeal Board (TTAB) has found that a game character's face not displayed at download sites was not a registrable trademark because it would not have been perceived as a source indicator.

Background

Joseph A Stallard d/b/a Osgoode Media ('Stallard') applied to register the below design in Class 9 (downloadable computer, electronic and video games, programs and software):

In essential part, Stallard described that the design "consists of a woman video game character named Maria". As a specimen of use, Stallard submitted an excerpted portion from an 'Itch.io' webpage ('the specimen'), which depicted and described Maria and provided links to Amazon or Google Play (ie, a 'marketplace' or 'store') where the subject game could be downloaded.

The examining attorney ('examiner') made of record the complete version of the same Itch.io webpage, which, beyond what was contained in the specimen, described the game itself and included images and a description of another character named Maia. The examiner noted that the full 'Itch.io' webpage portrayed Maia as the primary character and displayed Maia six times in five different poses, but showed Maria three times in the same single pose.

The examiner also made of record 'Google.com' and 'Amazon.com' webpages from which the game could be downloaded (online points of 'sale' or 'installation'), and highlighted how they depicted several images of Maia, did not prominently show Maria, and had no display of the applied-for design.

Registration was refused on the grounds of failure to function as a mark, for fear that consumer perception of the design would be only as showing a game character, and not as any indicator of source. The final office action suggested submitting a different specimen of use or amending the application's filing basis to intent to use. Stallard appealed *pro se*.

Decision

The TTAB affirmed the refusal. It relied on established precedent that a mark is federally registrable in the United States only if, regardless of an applicant's intent, the consuming public would perceive the mark as an indicator of the source of the applicant's associated goods/services, where said consumer perception must be assessed based upon the way the mark is actually used in commerce.

A mark may simultaneously be an integral or necessary component of a good or service. However, it then must serve dual purpose - namely, such a mark still needs to be perceived as a source indicator (which, again, is assessed from the way the mark is actually used in commerce, and irrespective of an applicant's intent).

The TTAB detailed examples of unsuccessful registration in the context of creative works, where the name of some character(s) therein (at least without more) would not have been seen as indicating their source (See *In re Scholastic Inc* (223 USPQ 431, TTAB 1984) and *In re Caserta* (46 USPQ2d 1088, TTAB 1998)). The character names were deemed to not indicate source even when, for example, the name also appeared in the title of every book in a series (THE LITTLES), or on the cover and even each page of a story (FURR-BALL FURCANIA). Similarly, a drawing of a creative work's character (on the cover of the book) was not viewed as a source indicator (see *In re Frederick Warne & Co* (218 USPQ 345, TTAB 1983)).

The TTAB also cited an example alluding to how a registration could be successful, *In re DC Comics Inc* (215 USPQ 394, CCPA 1982)), clarifying that there is no inherent legal prohibition to a picture of a product also functioning as the trademark for that product.

Ultimately, the TTAB agreed with the examiner's view of the commercial impression highlighted in the webpages made of record - and since the applied-for design was not being used in a way that would be perceived by consumers as a trademark indicating the source of the goods, it was not registrable.

Comment

An interesting exercise is to try thinking of potential usages where the applied-for design could have been perceived as a source indicator and trademark. Arguably, this might be achieved by placing the design where one could typically expect to see a corporate logo or symbol. For example, the image may be on the spine of a compact disc case, preferably at the edge (assuming the good to be sold were to be the game or program encoded in physical format); or the image might be depicted for a short time in the centre of a screen display during the beginning of a user's start-up or 'turning on' of the game, preferably flashed sequentially before or in-between other indicia or marks of entities that may have contributed to the game (or any audiovisual work).

Further, consider that the applied-for design was of a face, conceivably the visual feature most likely to be used to represent a non-corporate identity. Consider also that Maria was a fictional woman. If the public sees a human-appearing or even anthropomorphised being, they might understand it as showing a personality, and not necessarily as being a commercial source indicator. Consider if the focus is on an individual's face or avatar, or if the depiction is an image or photograph of a non-fictional person. Arguably, these are among the unique considerations that accompany asserting a creative work's character or some element(s) thereof as a trademark.

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