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**UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451**

MBA

Mailed: January 29, 2009

Opposition No. 91157178

Opposition No. 91158299

International Star Registry  
of Illinois, Ltd.

v.

Tonya S. Vaughan

**Before Walters, Walsh and Ritchie, Administrative Trademark  
Judges**

**By the Board:**

This is the second time this case has come up for consideration of whether applicant's marks are generic, and, if not, whether they have acquired distinctiveness under 15 U.S.C. § 1052(f). The Board first considered the issue when Tonya S. Vaughan ("applicant") moved for summary judgment in her favor on the ground that her marks NAME A STAR<sup>1</sup>, and NAME A STAR and Design, as shown below,

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<sup>1</sup> Serial No. 76448314, filed September 10, 2002, alleging first use in commerce on December 25, 1978, for: (a) "printed publications, namely, certificates of registration, charts, printed sheets and registers all identifying celestial stars as named by persons dedicating a celestial star as a personal gift, charts and printed sheets identifying celestial bodies, and essays regarding celestial bodies and astronomy," in International Class 16; and (b) "novelty gift registry services, namely, registering celestial stars with names selected by customers and providing personalized certificates of registration



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are not generic for printed publications and novelty gift registry services, and have become distinctive of applicant's goods and services. The Board denied applicant's motion in its order of November 16, 2007 (the "Prior Order"), and in doing so stated that "NAME A STAR may very well be generic." Prior Order p. 16.

This case now comes up for consideration of essentially the same issues, this time on International Star Registry of Illinois, Ltd.'s ("opposer") motion, filed August 20, 2008, for summary judgment in its favor on the ground that NAME A STAR "is generic, or so highly descriptive, and could not have possibly acquired distinctiveness for 'name a star' or star naming services and products ...." The motion is fully briefed, and is based primarily on the same evidence and arguments as applicant's earlier motion for summary judgment. While each

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as gifts," in International Class 35. The application includes a claim of acquired distinctiveness under Section 2(f).

<sup>2</sup> Serial No. 76448315, filed September 10, 2002, alleging first use in commerce on October 7, 1999, for essentially the same goods and services as those identified in Serial No. 76448314. The application includes a claim of acquired distinctiveness under Section 2(f) as to the phrase NAME A STAR.

party has introduced a limited amount of new evidence, this new evidence is for the most part cumulative.

The Parties' Contentions

The relevant facts and primary arguments are discussed in detail in the Prior Order, and for the most part need not be repeated here. Opposer summarizes its argument as follows:

The phrase 'name a star' is not exclusive to Applicant, and has been more prominently used for decades by Opposer than by Applicant to such an extent that Applicant's claimed own use of the phrase has been de minimus or pales in comparison to the Opposer's usage. A multitude of third party competitors have long used the phrase 'name a star' to identify ... their star naming services and products. The media has extensively long used the term 'name a star' generically. Even Applicant's own materials have demonstrated long spread generic or descriptive uses by the Applicant herself.

In her response to opposer's motion, applicant claims that her mark is "whimsical and incongruent, of star registration goods and services," and that it "acquired secondary meaning long ago, and prior to any but sporadic infringements by Opposer and third-parties." In addition, "the fact that the word sequence of 'name a star' exists in the literature outside of Applicant's mark does not detract from the Name A Star mark's capability as a trademark and service mark," and, in any event, "[o]pposer ... and the primary third-party infringers ... have been warned in writing, that

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their infringements will be dealt with upon the registration of Applicant's Name A Star mark."

In its reply brief, opposer primarily restates its original arguments, and claims that "[a]pplicant never points to an affidavit from anyone that it ever once stopped even one single use [of 'name a star'] by others."

#### Decision

As explained in the Prior Order, summary judgment is only appropriate where there are no genuine issues of material fact in dispute, thus allowing the case to be resolved as a matter of law. Fed. R. Civ. P. 56(c). Opposer, as the movant seeking summary judgment, bears the initial burden of demonstrating the absence of any genuine issue of material fact. See, Celotex Corp. v. Catrett, 477 U.S. 317, 323 (1986); Sweats Fashions, Inc. v. Pannill Knitting Co. Inc., 833 F.2d 1560, 1563, 4 USPQ2d 1793, 1796 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. See, Opryland USA Inc. v. Great American Music Show Inc., 970 F.2d 847, 850, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); Olde Tyme Foods, Inc. v. Roundy's, Inc., 961 F.2d 200, 202, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

The evidence on summary judgment must be viewed in a light most favorable to the non-movant, in this case

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applicant, and all justifiable inferences are to be drawn in applicant's favor. Lloyd's Food Products, Inc. v. Eli's, Inc., 987 F.2d 766, 767, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); Opryland USA, supra. The Board may not resolve issues of material fact; it may only ascertain whether issues of material fact exist. See, Lloyd's Food Products, 987 F.2d at 766, 25 USPQ2d at 2029; Olde Tyme Foods, 961 F.2d at 200, 22 USPQ2d at 1542.

#### Standing

There is no genuine issue that opposer and applicant are competitors in the field of "registering" names of stars, using "dedication names" chosen by customers. Applicant's Answer to Notice of Opposition ¶¶ 3-5. As a result, there is no genuine issue that opposer has standing to oppose registration of applicant's marks. Plyboo America Inc. v. Smith & Fong Co., 51 USPQ2d 1633, 1634 (TTAB 1999).<sup>3</sup>

#### Genericness

As set forth in the Prior Order, a mark is a generic name if it refers to the class, genus or category of goods and/or services on or in connection with which it is used. In re Dial-A-Mattress Operating Corp., 240 F.3d 1341, 57

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<sup>3</sup> In related Opposition No. 91163697, applicant herein is challenging opposer herein's application Serial No. 76415083, for registration of INTERNATIONAL STAR REGISTRY NAME A STAR & Design, with NAME A STAR disclaimed. In that proceeding, applicant alleges, among other things, that she has priority of use and that opposer's mark is likely to be confused with applicant's alleged mark NAME A STAR.

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USPQ2d 1807 (Fed. Cir. 2001), citing H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986); see also, In re Outdoor Recreation Group, 81 USPQ2d 1392, 1397 (TTAB 2006). The test for determining whether a mark is generic is its primary significance to the relevant public. Section 14(3) of the Act; In re American Fertility Society, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); Magic Wand Inc. v. RDB Inc., 940 F.2d 638, 19 USPQ2d 1551, 1553 (Fed. Cir. 1991). Opposer bears the burden of establishing that applicant's mark is generic. Magic Wand, 940 F.2d 638, 19 USPQ2d at 1554; Tea Board of India v. Republic of Tea Inc., 80 USPQ2d 1881, 1887 (TTAB 2006). Evidence of the relevant public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers, and other publications. In re Northland Aluminum Products, Inc., 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985). "[E]vidence of competitors' use of particular words as the name of their goods or services is, of course, persuasive evidence that those words would be perceived by purchasers as a generic designation for the goods and services." Continental Airlines Inc. v. United Air Lines Inc., 53 USPQ2d 1385, 1395 (TTAB 1999).

In this case, applicant seeks registration of her mark for both "gift registry services" and "printed

publications." While the identification of goods and services is extremely broad and could encompass many fields, the evidence clearly establishes, i.e. there is no genuine issue of material fact, that with respect at least to the subset of star-naming and registration publications and services, these goods and services are inextricably intertwined. Indeed, applicant, opposer and the numerous third parties shown herein to be involved in the business of "star-registration" or "star-naming" offer essentially the same thing: the "service" of "registering" a star, part and parcel of which are the "goods" or fulfillment materials like registration certificates and books about stars that star-registration customers receive. For example:

- applicant's Web site states "Our Standard Name a Star™ Package includes a certificate of star registration ..." and "When you buy a star name from Name a Star™ you can place your own unique personalized tribute on your Name a Star™ certificate of registration"; Opposer's DA-1 and DA-2;
- opposer's radio advertisement states "we will name a star after your sweetheart and send a beautiful gift package; Opposer's Ex. F-1;
- the "starnamer.net" website states "Name a star with us and enjoy these unique advantages ... in addition to the star chart ... is a free

Star Map software CD ...;  
Opposer's Ex. G-1;

- the "freenameastar.com" website states "Other sites charge \$50 or more to name a star. With FreeNameAStar.com you can name a star for free. You print your own certificates on your own printer;" Opposer's Ex. G-5; and
- the "buyastar.net" website states "\$39.95 Standard Name a Star Package includes: Name a Star Certificate without Wooden Plaque ... Star Foundation Signature Lapel Pin ...;" Opposer's Ex. G-17.

See also, Opposer's Ex. CA-42, CA-44. Unsolicited media reports also make clear that printed publications are generally part and parcel of "star-registration" services.

For example:

- a January 24, 2006 article in New River Journal states "they sell you the opportunity to name a star ... Several successful outfits ... will gladly sell you a bit of prime celestial real estate ... This gets you an official-looking certificate ...;" Opposer's Ex. H-1;
- an article printed from the "forbes.com" web site states "At least half a dozen companies will sell you the rights to name a star, along with a handsome 'official' certificate ...;" Opposer's Ex. H-2;

- A March 6, 2003 article in the Christian Science Monitor states "There are several companies who, for a fee, will name a star after you. Apparently, you get a nice certificate and a star map showing the location of your very own star;" Opposer's Ex. H-14.

Applicant herself states that "the star-registration, or star-naming, concept/format" includes both "registration" services and associated printed products. Applicant's Response to Motion for Summary Judgment at pp. 3-4. Therefore, and as we pointed out in the Prior Order, the evidence establishes that if NAME A STAR is generic for applicant's services, it is also generic for her goods, and vice versa. Prior Order at p. 13; see, In re Candy Bouquet International Inc., 73 USPQ2d 1883, 1888 (TTAB 2004); In re A La Vielle Russie Inc., 60 USPQ2d 1895, 1900 (TTAB 2001); In re Log Cabin Homes Ltd., 52 USPQ2d 1206 (TTAB 1999).

The evidence establishes the following additional facts:

(1) The evidence shows that applicant often uses the phrase "name a star" in a non-trademark manner, in particular she offers her customers the ability to "name a star" and obtain a registration certificate and other printed publications pertaining to the naming of the star and registration of that name.

For example, in her opposition to opposer's motion, applicant makes the following statement:

The Name A Star business originated the star-registration, or star-naming, concept/format of: (a) registering dedication names selected by customers together with a specific star assigned to the dedication name, (b) providing personalized Certificates of Registration in a portfolio together with star charts and other printed material about the assigned star, and stars and celestial bodies, (c) providing compilations of the star dedications in registers.

Response to Opposer's Motion pp. 3-4 (emphasis supplied).

While applicant claims that her alleged mark is "only marginally descriptive," id. at p. 10, she also admits that "star-registration or star-naming goods/services involve stars and (assigned) names." Id. p. 8.

Applicant's own advertising uses the phrase "name a star" to indicate the specific activity of "naming a star." For example, one of applicant's advertisements stated "Name a Star to Honor Someone Special" and another was headlined "Name A Star After Someone You Love." Opposer's Ex. D-11, D-15; Applicant's Ex. 1. Similarly, applicant's website previously stated "How to Name a Star™," "Name a Star™ in the heavens today for that special occasion or person you know!" and "Click here to Name a Star!." Opposer's Ex. D-2, D-3, D-6. Despite the use of the "TM" following certain uses of "Name a Star," the phrase is an integral part of a

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larger sentence and it denotes the nature of applicant's services.

(2) Opposer uses "name a star" in a non-trademark manner to describe star registration services and related goods, including through television, radio and national print advertisements spanning the past 25 years. Prior Order at pp. 13-14 (identifying relevant evidence filed in response to applicant's motion for summary judgment in 2005).

(3) Opposer uses the mark INTERNATIONAL STAR REGISTRY NAME A STAR & Design to identify its own goods and services, which are essentially the same as applicant's goods and services. See, e.g., Opposer's Ex. A-63 through A-66.

(4) From 2003-2007, opposer spent on average approximately \$2,000,000 per year on radio advertising alone. Evidence of opposer's advertising, its significant promotional activities and traffic on its website demonstrate opposer's use of "name a star" in a non-trademark manner to describe the nature of its goods and services. Second Supplemental Affidavit of Peter "Rocky" Mosele ¶ 22; see also, Second Supplemental Affidavit of Michael Hazelrigg ¶¶ 2, 16; cf. Applicant's Response to Opposer's Motion at 5-6 (quantifying applicant's use of NAME A STAR).

(5) Numerous third parties have also used "name a star" to denote their own star-naming goods and services. Prior Order at pp. 14-15 (identifying relevant evidence).<sup>4</sup> Opposer's supplemental evidence submitted in support of its motion for summary judgment establishes that these non-trademark third-party uses of "name a star" have, for the most part, continued to the present. Opposer's Ex. G-1 through G-5, G-7, G-8, and G-12 through G-18.

(6) The phrase "name a star" is used extensively to indicate various entities' star-naming and registration goods and services in unsolicited media reports about such products and services. Prior Order at pp. 15-16 (identifying relevant evidence). Opposer's supplemental evidence establishes additional and continued media uses of "name a star" to denote the discussed goods and services. Opposer's Ex. H-1, H-2, H-13, H-14 and H-16 through H-18.

The aforementioned factual findings clearly establish, i.e., there is no genuine issue of material fact, that the genus of applicant's services is the naming and registration of stars and the genus of the goods is star-naming certificates and publications. "Name a star" is merely the rearrangement of this genus of goods and services to the

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<sup>4</sup> While applicant points out that the "dedicateastar.com" web site is no longer active, Supplemental Declaration of Tonya S. Vaughan ¶ 9, applicant does not dispute that the other third party uses of "name a star" identified in the Prior Order continue.

declarative form and it is, thus, legally equivalent to the identified genus of applicant's goods and services.

Additionally, the aforementioned factual findings clearly establish, i.e., there is no genuine issue of material fact, that "the relevant public understands" NAME A STAR "to primarily refer to that genus" of goods and services. In re American Fertility Society, supra.

While applicant claims that there may be more than one name for these goods and services, that does not detract from the finding that "name a star" is one of the generic names for these goods and services. Continental Airlines, 53 USPQ2d at 1394. Furthermore, while applicant and perhaps others at times use "name a star"<sup>5</sup> in the manner of a trademark, that does not mean that the phrase is not generic, or that genuine issues of material fact remain about whether the term is generic. Id. at 1394-95.

Finally, while applicant asserts that her competitors' and the media's uses of "name a star" have been infringing or improper, and that she intends to challenge their uses if and when she obtains a federal registration of NAME A STAR, the fact remains that her competitors' and the media's

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<sup>5</sup> Applicant claims that certain third parties use "name a star" as a source identifier, but at least some of the uses upon which applicant relies are in fact non-trademark uses of the phrase. Furthermore, even if applicant was correct that all of the third party uses upon which she relies were of "name a star" as a source identifier, these uses are less extensive than the non-trademark uses cited herein.

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widespread uses of "name a star" in a non-trademark manner continue, and are more extensive than the uses by applicant.

For all of these reasons, opposer's motion for summary judgment that applicant's marks are generic in connection with the identified goods and services is hereby **GRANTED**.<sup>6</sup> The opposition is therefore sustained.

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<sup>6</sup> Should applicant ultimately prevail on the issue of genericness in any appeal, we find that the evidence of widespread generic use of "name a star" by opposer, third parties and the media establish that there are no genuine issues of material fact that "name a star" has not acquired distinctiveness as a mark in connection with applicant's goods and services. See, Continental Airlines, 53 USPQ2d at 1395; see also, In re Candy Bouquet, 73 USPQ2d at 1889.