

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

14-1598

In re: PREMA JYOTHI LIGHT,
Appellant

Appeal from the United States Patent and Trademark Office, Trademark Trial and Appeal Board in No.
76/293,327.

MANDATE

In accordance with the judgment of this Court, entered October 7, 2016, and pursuant to Rule 41(a) of the Federal Rules of Appellate Procedure, the formal mandate is hereby issued.

FOR THE COURT

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court

cc: Thomas L. Casagrande
Christina Hieber
Thomas W. Krause
Prema Jyothi Light
United States Patent and Trademark Office
Mary Beth Walker

NOTE: This disposition is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

IN RE: PREMA JYOTHI LIGHT,
Appellant

2014-1597

Appeal from the United States Patent and Trademark
Office, Trademark Trial and Appeal Board in No.
76/293,326.

IN RE: PREMA JYOTHI LIGHT,
Appellant

2014-1598

Appeal from the United States Patent and Trademark
Office, Trademark Trial and Appeal Board in No.
76/293,327.

Decided: October 7, 2016

PREMA JYOTHI LIGHT, Aurora, CO, pro se.

THOMAS W. KRAUSE, Office of the Solicitor, United States Patent and Trademark Office, Alexandria, VA, for appellee Michelle K. Lee. Also represented by CHRISTINA HIEBER, THOMAS L. CASAGRANDE, MARY BETH WALKER.

Before LOURIE, DYK, and O'MALLEY, Circuit Judges.

LOURIE, Circuit Judge.

Prema Jyothi Light ("Light") appeals from two related U.S. Patent and Trademark Office ("USPTO") Trademark Trial and Appeal Board ("Board") decisions. In the first, Light appeals from the Board's rejection of her application to register the matter shown below as a trademark. *In re Light*, No. 76293326, 2013 WL 6858009, at *6-8 (T.T.A.B. Dec. 13, 2013) ("*Decision I*").



In the second, Light appeals from the Board's rejection of her application to register the matter shown below as a trademark. *In re Light*, No. 76293327, 2013 WL 6858010, at *5-7 (T.T.A.B. Dec. 13, 2012) ("*Decision II*").

IN RE: LIGHT

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For the reasons that follow, we affirm both decisions.

BACKGROUND

On July 9, 2001, Light filed two applications to register the above-pictured matter as trademarks for use on, *inter alia*, cartoon prints, paper dolls, and coloring books. *Decision I* at *2; *Decision II* at *1. The first proposed mark contains stylized wording in the top left-hand corner, "SHIMMERING BALLERINAS & DANCERS CHARACTER COLLECTION," surrounded by three columns of terms "that appear to identify names of a variety of characters." *Decision I* at *1. Examples of the character names include: "SHIMMERING WIND-HARP BUTTERFLIES JALINDA, JALISA, JAHA, JAJA, JELANI, & JUM" and "THE AIRY BALLERINA & DANCER CLARISSA." *Id.* The entire proposed mark has approximately 660 words and identifies more than ninety character names. *See id.*

The second proposed mark similarly contains stylized wording in the top left-hand corner, "SHIMMERING RAINFOREST CHARACTER COLLECTION," surrounded by columns of "an extremely long list of terms (in

smaller font) identifying names of fictional characters.” *Decision II* at *1. The character list includes: “JALINDA THE WIND HARP BUTTERFLY” and “HARRY & HARRIETA, THE HAIRY RAINFOREST SUSPENDER SPIDERS.” *Id.* The entire proposed mark has approximately 570 words and identifies more than 125 character names. *See id.*

The examining attorney rejected Light’s applications, reasoning that each sought to register multiple marks. In response, Light filed proposed amendments to her marks. The examining attorney rejected the amendments, however, finding that the proposed changes effected material alterations of the subject matter. Light appealed to the Board, but because the appeals were not timely filed, the applications were abandoned.

Light later successfully petitioned to revive her applications, and the Board reinstated the original appeals. In 2008, the Board remanded the applications to the examining attorney to consider whether the proposed marks constituted registrable subject matter, a different potential basis for rejection. The examining attorney issued Office Actions refusing to register the proposed marks because they “fail to function” as trademarks, and are thus not registrable subject matter. In the Office Actions, however, the examining attorney noted that Light could overcome the failure-to-function rejections by amending the proposed marks to only seek registration of the stylized wording in the top left-hand corners: either the “SHIMMERING BALLERINAS & DANCERS” or the “SHIMMERING RAINFOREST.” *Decision I* at *1; *Decision II* at *1.

Light failed to timely respond to those Office Actions, however, and her applications were yet again abandoned. Light again successfully petitioned to revive her applications, and the examining attorney considered Light’s responses to the Office Actions. Because Light still

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