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1201 Ownership of Mark

Under §1(a)(1) of the Trademark Act, 15 U.S.C. §1051(a)(1), an application based on use in commerce must be filed by the owner of the mark. A §1(a) application must include a verified statement that the applicant believes it is the owner of the mark sought to be registered. 15 U.S.C. §1051(a)(3)(A); 37 C.F.R. §2.33(b)(1). An application that is not filed by the owner is void. *See* **TMEP §1201.02(b).**

An application under §1(b) or §44 of the Act, 15 U.S.C. §1051(b) or §1126, must be filed by a party who is entitled to use the mark in commerce, and must include a verified statement that the applicant is entitled to use the mark in commerce and that the applicant has a bona fide intention to use the mark in commerce as of the application filing date. 15 U.S.C. §§1051(b)(3), 1126(d)(2), and 1126(e); 37 C.F.R. §2.33(b)(2). When the person designated as the applicant is not the person with a bona fide intention to use the mark in commerce, the application is void. *See* **TMEP §1201.02(b).**

In a §1(b) application, before the mark can be registered, the applicant must file an amendment to allege use under 15 U.S.C. §1051(c) (*see* **TMEP §§1104** *et seq.*) or a statement of use under 15 U.S.C. §1051(d) (*see* **TMEP §§1109** *et seq.*) which states that the applicant is the owner of the mark. 15 U.S.C. §§1051(b)(3)(A) and (B); 37 C.F.R. §§2.76(b)(1) and 2.88(b)(1).

In a §44 application, the applicant must be the owner of the foreign application or registration on which the United States application is based as of the filing date of the United States application. *See* **TMEP §1005.**

An application under §66(a) of the Trademark Act (i.e., a request for extension of protection of an international registration to the United States under the Madrid Protocol), must be filed by the holder of the international registration. 15 U.S.C. §1141e(a). The application must include a verified statement that the applicant has a bona fide intention to use the mark in commerce. 15 U.S.C. §1141(5). The verified statement in a §66(a) application is part of the international registration on file at the International Bureau of the World Intellectual Property Organization ("IB"). The IB will have established that the international registration includes this verified statement before it sends the request for extension of protection to the United States Patent and Trademark Office ("USPTO"). *See* **TMEP §804.05.** The request for extension of protection remains part of the international registration, and ownership is determined by the IB. *See* **TMEP §501.07** regarding assignment of §66(a) applications.

1201.01 Claim of Ownership May Be Based on Use By Related Companies

In an application under §1 of the Trademark Act, an applicant may base its claim of ownership of a trademark or a service mark on:

(1) its own exclusive use of the mark;

(2) use of the mark solely by a related company whose use inures to the applicant's benefit (*see* **TMEP §§1201.03** *et seq*.); or

(3) use of the mark both by the applicant and by a related company whose use inures to the applicant's benefit (*see* **TMEP §1201.05).**

Where the mark is used by a related company, the owner is the party who controls the nature and quality of the goods sold or services rendered under the mark. The owner is the only proper party to apply for registration. 15 U.S.C. §1051. *See* **TMEP §§1201.03** *et seq*. for additional information about use by related companies.

The examining attorney should accept the applicant's statement regarding ownership of the mark unless it is clearly contradicted by information in the record. *In re Los Angeles Police Revolver and Athletic Club, Inc.*, 69 USPQ2d 1630 (TTAB 2003).

The USPTO does not inquire about the relationship between the applicant and other parties named on the specimen or elsewhere in the record, except when the reference to another party clearly contradicts the applicant's verified statement that it is the owner of the mark or entitled to use the mark. Moreover, where the application states that use of the mark is by a related company or companies, the examining attorney should not require any explanation of how the applicant controls such use.

The provisions discussed above also apply to service marks, collective marks, and certification marks, except that, by definition, collective marks and certification marks are not used by the owner of the mark, but are used by others under the control of the owner. 15 U.S.C. §§1053 and 1054. *See* **TMEP §§1303.01**, **1304.03,** and **1306.01(a).**

See **TMEP §1201.04** for information about when an examining attorney should issue an inquiry or refusal with respect to ownership.

1201.02 Identifying the Applicant in the Application

1201.02(a) Identifying the Applicant Properly

The applicant may be any person or entity capable of suing and being sued in a court of law. *See* **TMEP §§803** *et seq*. for the appropriate format for identifying the applicant and setting forth the relevant legal entity. *See* **TMEP §1201.03(a)** regarding the form for indicating that the mark is used solely by a related company.

1201.02(b) Application Void if Wrong Party Identified as the Applicant

An application must be filed by the party who is the owner of (or is entitled to use) the mark as of the application filing date. *See* **TMEP §1201.**

An application based on use in commerce under 15 U.S.C. §1051(a) must be filed by the party who owns the mark on the application filing date. If the applicant does not own the mark on the application filing date, the application is *void*. 37 C.F.R. §2.71(d). *Huang v. Tzu Wei Chen Food Co. Ltd.,* 849 F.2d 1458, 7 USPQ2d 1335 (Fed. Cir. 1988); *Great Seats, Ltd. v. Great Seats, Inc.*, 84 USPQ2d 1235 (TTAB 2007).

If the record indicates that the applicant is not the owner of the mark, the examining attorney should refuse registration on that ground. The statutory basis for this refusal is §1 of the Trademark Act, 15 U.S.C. §1051, and, where related company issues are relevant, §§5 and 45 of the Act, 15 U.S.C. §§1055 and 1127. The examining attorney should not have the filing date cancelled or refund the application filing fee.

In an application under §1(b) or §44 of the Trademark Act, 15 U.S.C. §1051(b) or §1126, the applicant must be entitled to use the mark in commerce on the application filing date, and the application must include a verified statement that the applicant has a bona fide intention to use the mark in commerce. 15 U.S.C. §§1051(b)(3)(A), 1051(b)(3)(B), 1126(d)(2), and 1126(e). When the person designated as the applicant was not the person with a bona fide intention to use the mark in commerce at the time the application was filed, the application is void. *AmericanForests v. Sanders*, 54 USPQ2d 1860 (TTAB 1999), *aff'd,* 232 F.3d 907 (Fed. Cir. 2000) (intent-to-use application filed by an individual held void, where the entity that had a bona fide intention to use the mark in commerce on the application filing date was a partnership composed of the individual applicant and her husband). However, the examining attorney will not inquire into the bona fides, or good faith, of an applicant's asserted intention to use a mark in commerce during ex parte examination, unless there is evidence in the record clearly indicating that the applicant does not have a bona fide intention to use the mark in commerce. *See* **TMEP §1101.**

When an application is filed in the name of the wrong party, this defect cannot be cured by amendment or assignment. 37 C.F.R. §2.71(d); **TMEP §803.06.** However, if the application was filed by the owner, but there was a mistake in the manner in which the applicant's name was set forth in the application, this may be corrected. *See* **TMEP §1201.02(c)** for examples of correctable and non-correctable errors.

See **TMEP §1201** regarding ownership of a §66(a) application.

1201.02(c) Correcting Errors in How the Applicant Is Identified

If the party applying to register the mark is, in fact, the owner of the mark, but there is a mistake in the manner in which the name of the applicant is set out in the application, the mistake may be corrected by amendment. *U.S. Pioneer Electronics Corp. v. Evans Marketing, Inc.*, 183 USPQ 613 (Comm'r Pats. 1974). However, the application may *not* be amended to designate another entity as the applicant. 37 C.F.R. §2.71(d); **TMEP §803.06.** An application filed in the name of the wrong party is void and cannot be corrected by amendment. *Huang v. Tzu Wei Chen Food Co. Ltd.,* 849 F.2d 1458, 7 USPQ2d 1335 (Fed. Cir. 1988); *Great Seats, Ltd. v. Great Seats, Inc.*, 84 USPQ2d 1235 (TTAB 2007); *In re Tong Yang Cement Corp*., 19 USPQ2d 1689 (TTAB 1991).

Correctable Errors. The following are examples of correctable errors in identifying the applicant:

(1) *Trade Name Set Forth As Applicant*. If the applicant identifies itself by a name under which it does business, which is not a legal entity, then amendment to state the applicant's correct legal name is permitted. *Cf. In re Atlanta Blue Print Co.,* 19 USPQ2d 1078 (Comm'r Pats 1990) (Post Registration staff erred in refusing to allow amendment of affidavit under 15 U.S.C. §1058 to show registrant's corporate name rather than registrant's trade name).

(2) *Operating Division Identified as Applicant*. If the applicant mistakenly names an operating division, which by definition is not a legal entity, as the owner, then the applicant's name may be amended. *See* **TMEP §1201.02(d).**

(3) *Minor Clerical Error*. Minor clerical errors such as the mistaken addition or omission of "The" or "Inc." in the applicant's name may be corrected by amendment, as long as this does not result in a change of entity. However, change of a significant portion of the applicant's name is not considered a minor clerical error.

(4) *Inconsistency in Original Application as to Owner Name or Entity*. If the original application reflects an inconsistency between the owner name and the entity type, e.g., an individual and a corporation are each identified as the owner in different places in the application, the application may be amended to clarify the inconsistency.

Example: Inconsistency Between Owner Section and Entity Section of TEAS Form: If the information in the "owner section" of a TEAS application form is inconsistent with the information in the "entity section" of the form, the inconsistency can be corrected, e.g., if an individual is identified as the owner and a corporation is listed as the entity, the application may be amended to indicate the proper applicant name/entity.

Signature of Verification By Different Entity Does Not Create Inconsistency. In view of the broad definition of a "person properly authorized to sign on behalf of the applicant" in 37 C.F.R. §2.193(e)(1) (*see* **TMEP §611.03(a))**, if the person signing an application refers to a different entity, the USPTO will presume that the person signing is an authorized signatory who meets the requirements of 37 C.F.R. §2.193(e)(1), and will not issue an inquiry regarding the inconsistency or question the signatory's authority to sign. If the applicant later requests correction to identify the party who signed the verification as the owner, the USPTO will not allow the amendment. For example, if the application is filed in the name of "John Jones, individual U.S. citizen," the verification is signed by "John Jones, President of ABC Corporation," and the applicant later proposes to amend the application to show ABC Corporation as the owner, the USPTO will not allow the amendment, because there was no inconsistency in the original application as to the owner name/entity.

(5) *Change of Name*. If the owner of a mark legally changed its name before filing an application, but mistakenly lists its former name on the application, the error may be corrected, because the correct party filed, but merely identified itself incorrectly. *In re Techsonic Industries, Inc.,* 216 USPQ 619 (TTAB 1982).

(6) *Partners Doing Business as Partnership*. If an applicant has been identified as "A and B, doing business as The AB Company, a partnership," and the true owner is a partnership organized under the name The AB Company and composed of A and B, the applicant's name should be amended to "The AB Company, a partnership composed of A and B."

(7) *Non-Existent Entity.* If the party listed as the applicant did not exist on the application filing date, the application may be amended to correct the applicant's name. *See Accu Personnel Inc. v. Accustaff Inc.*, 38 USPQ2d 1443 (TTAB 1996) (application was not void ab initio where corporation named as applicant technically did not exist on filing date, since four companies who later merged acted as a single commercial enterprise when filing the application); *Argo & Co. Inc.*

v. Springer, 198 USPQ 626 (TTAB 1978) (application may be amended to name three individuals as joint applicants in place of an originally named corporate applicant which was never legally incorporated, because the individuals and non-existent corporation were found to be the same, single commercial enterprise); *U.S. Pioneer Electronics Corp. v. Evans Marketing, Inc.*, 183 USPQ 613 (Comm'r Pats. 1974) (applicant's name may be corrected where the application was mistakenly filed in the name of a fictitious and non-existent party).

Example 1: If the applicant is identified as ABC Company, a Delaware partnership, and the true owner is ABC LLC, a Delaware limited liability company, the application may be amended to correct the applicant's name and entity if the applicant states on the record that "ABC Company, a Delaware partnership, did not exist as a legal entity on the application filing date."

Example 2: If an applicant has been identified as "ABC Corporation, formerly known as XYZ, Inc.," and the correct entity is "XYZ, Inc.," the applicant's name may be amended to "XYZ, Inc.," as long as "ABC Corporation, formerly known as XYZ, Inc." was not a different *existing* legal entity. *Cf. Custom Computer Services Inc. v. Paychex Properties Inc.*, 337 F.3d 1334, 1337, 67 USPQ2d 1638, 1640 (Fed. Cir. 2003).

To correct an obvious mistake of this nature, a verification or declaration is not normally necessary.

Non-Correctable Errors. The following are examples of non-correctable errors in identifying the applicant:

(1) *President of Corporation Files as Individual*. If the president of a corporation is identified as the owner of the mark when in fact the corporation owns the mark, and there is no inconsistency in the original application between the owner name and the entity type (such as a reference to a corporation in the entity section of the application), the application is void as filed because the applicant is not the owner of the mark.

(2) *Predecessor in Interest*. If an application is filed in the name of entity A, when the mark was assigned to entity B before the application filing date, the application is void as filed because the applicant was not the owner of the mark at the time of filing. *Cf. Huang v. Tzu Wei Chen Food Co., supra* (application filed by an individual two days after ownership of the mark was transferred to a newly formed corporation held void).

(3) *Joint Venturer Files*. If the application is filed in the name of a joint venturer when the mark is owned by the joint venture, and there is no inconsistency in the original application between the owner name and the entity type (such as a reference to a joint venture in the entity section of the application), the applicant's name cannot be amended. *In re Tong Yang Cement Corp*., *supra*.

(4) *Sister Corporation*. If an application is filed in the name of corporation A and a sister corporation (corporation B) owns the mark, the application is void as filed, because the applicant is not the owner of the mark. *Great Seats, supra* (§1(a) application held void where the sole use and advertising of the mark was made by a sister corporation who shared the same president, controlling shareholder, and premises as the applicant).

(5) *Parent/Subsidiary*. If an application is filed in the name of corporation A, a wholly owned subsidiary, and the parent corporation (corporation B) owns the mark, the application is void as filed because the applicant is not the owner of the mark. *See* **TMEP §1201.03(c)** regarding wholly owned related companies.

1201.02(d) Operating Divisions

An operating division that is not a legal entity that can sue and be sued does not have standing to own a mark or to file an application to register a mark. The application must be filed in the name of the company of which the division is a part. *In re Cambridge Digital Systems,* 1 USPQ2d 1659, 1660 n.1 (TTAB 1986). An operating division's use is considered to be use by the applicant and not use by a related company; therefore, reference to related-company use is permissible but not necessary.

1201.02(e) Changes in Ownership After Application Is Filed

See **TMEP Chapter 500** regarding changes of ownership and changes of name subsequent to filing an application for registration, and **TMEP §§502.02** *et seq*. regarding the procedure for requesting that a certificate of registration be issued in the name of an assignee or in an applicant's new name.

1201.03 Use by Related Companies

Section 5 of the Trademark Act, 15 U.S.C. §1055, states, in part, as follows:

> Where a registered mark or a mark sought to be registered is or may be used legitimately by related companies, such use shall inure to the benefit of the registrant or applicant for registration, and such use shall not affect the validity of such mark or of its registration, provided such mark is not used in such manner as to deceive the public.

Section 45 of the Act, 15 U.S.C. §1127, defines "related company" as follows:

> The term "related company" means any person whose use of a mark is controlled by the owner of the mark with respect to the nature and quality of the goods or services on or in connection with which the mark is used.

Thus, §5 of the Act permits applicants to rely on use of the mark by related companies. Either a natural person or a juristic person may be a related company. 15 U.S.C. §1127.

The essence of related-company use is the control exercised over the nature and quality of the goods or services on or in connection with which the mark is used. When a mark is used by a related company, use of the mark inures to the benefit of the party who controls the nature and quality of the goods or services. This party is the owner of the mark and, therefore, the only party who may apply to register the mark. *Smith Int'l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981).

Reliance on related-company use requires, *inter alia*, that the related company use the mark in connection with the same goods or services recited in the application. *In re Admark, Inc.,* 214 USPQ 302 (TTAB 1982) (related company use not at issue where the applicant sought registration of a mark for advertising agency services and the purported related company used the mark for retail store services).

A related company is different from a successor in interest who is in privity with the predecessor in interest for purposes of determining the right to register. *Wells Cargo, Inc. v. Wells Cargo, Inc.*, 197 USPQ 569 (TTAB 1977), *aff'd,* 606 F.2d 961, 203 USPQ 564 (C.C.P.A. 1979).

See **TMEP §1201.03(c)** regarding wholly owned related companies, **§1201.03(d)** regarding corporations with common stockholders, directors, or officers, **§1201.03(e)** regarding sister corporations, and **§1201.03(f)** regarding license and franchise situations.

1201.03(a) Use Solely by Related Company Must be Disclosed

If the mark is not being used by the applicant but is being used by one or more related companies whose use inures to the benefit of the applicant under §5 of the Act, then these facts must be disclosed in the application. 37 C.F.R. §2.38(b). *See Pease Woodwork Co., Inc. v. Ready Hung Door Co., Inc.,* 103 USPQ 240 (Comm'r Pats. 1954); *Industrial Abrasives, Inc. v. Strong*, 101 USPQ 420 (Comm'r Pats. 1954). Use that inures to the applicant's benefit is a proper and sufficient support for an application and satisfies the requirement of 37 C.F.R. §2.33(b)(1) that a §1(a) application specify that the *applicant* has adopted and is using the mark.

The party who controls the nature and quality of the goods or services on or in connection with which the mark is used should be set forth as the applicant. In an application under §1(a) of the Trademark Act, the applicant should state in the body of the application that the applicant has adopted and is using the mark *through its related company* (or equivalent explanatory wording). In a §1(b) application, the statement that the applicant is using the mark through a related company should be included in the amendment to allege use under 15 U.S.C. §1051(c) (*see* **TMEP §§1104** *et seq.*) or statement of use under 15 U.S.C. §1051(d) (*see* **TMEP §§1109** *et seq.*).

The applicant is not required to give the name of the related-company user, unless it is necessary to explain information in the record that clearly contradicts the applicant's verified claim of ownership of the mark.

The applicant may claim the benefit of use by a related company in an amendment to the application. *Greyhound Corp. v. Armour Life Insurance Co.*, 214 USPQ 473, 475 (TTAB 1982).

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If the applicant and a related company both use the mark, and it is the applicant's own use of the mark that is relied on in the application, then the applicant does not have to include a reference to use by a related company in the application. *See* **TMEP §1201.05.**

1201.03(b) No Explanation of Applicant's Control Over Use of Mark by Related Companies Required

Where the application states that use of the mark is by a related company or companies, the USPTO does not require an explanation of how the applicant controls the use of the mark.

Similarly, the USPTO does not inquire about the relationship between the applicant and other parties named on the specimen or elsewhere in the record, except when the reference to another party clearly contradicts the applicant's verified statement that it is the owner of the mark or entitled to use the mark. *See* **TMEP §1201.04.**

1201.03(c) Wholly Owned Related Companies

Related-company use includes situations where a wholly owned related company of the applicant uses the mark, or where the applicant is wholly owned by a related company that uses the mark.

Frequently, related companies comprise parent and wholly owned subsidiary corporations. Either a parent corporation or a subsidiary corporation may be the proper applicant, depending on the facts concerning ownership of the mark. The USPTO will consider the filing of the application in the name of either the parent or the subsidiary to be the expression of the intention of the parties as to ownership in accord with the arrangements between them. However, once the application has been filed in the name of either the parent or the wholly owned subsidiary, the USPTO will not permit an amendment of the applicant's name to specify the other party as the owner. The applicant's name can be changed only by assignment.

Furthermore, once an application has been filed in the name of either the parent or the wholly owned subsidiary, the USPTO will not consider documents (e.g., statements of use under 15 U.S.C. §1051(d) or affidavits of continued use or excusable nonuse under 15 U.S.C. §1058) filed in the name of the other party to have been filed by the owner. *See In re Media Central IP Corp.,* 65 USPQ2d 1637 (Dir USPTO 2002) (§8 affidavit filed in the name of a subsidiary and predecessor in interest of the current owner held unacceptable); *In re ACE III Communications, Inc.*, 62 USPQ2d 1049 (Dir USPTO 2001) (§8 affidavit unacceptable where the owner of the registration was a corporation, and the affidavit was filed in the name of an individual who asserted that she was the owner of the corporation; the registrant corporation and the individual owner are separate legal entities).

Either an individual or a juristic entity may own a mark that is used by a wholly owned related company. *See In re Hand*, 231 USPQ 487 (TTAB 1986).

1201.03(d) Common Stockholders, Directors, or Officers

Corporations are not "related companies" within the meaning of §5 of the Trademark Act, 15 U.S.C. §1055, merely because they have the same stockholders, directors, or officers, or because they occupy the same premises. *Great Seats, Ltd. v. Great Seats, Inc.*, 84 USPQ2d 1235 (TTAB 2007) (the facts that both the applicant corporation and the corporate user of the mark have the same president and controlling stockholder, and share the same premises, does not make them related companies); *In re Raven Marine, Inc.*, 217 USPQ 68, 69 (TTAB 1983) (statement that both the applicant corporation and the corporate user of the mark have the same principal stockholder and officer held insufficient to show that the user is a related company).

If an individual applicant is not the sole owner of the corporation that is using the mark, the question of whether the corporation is a "related company" depends on whether the applicant maintains control over the nature and quality of the goods or services such that use of the mark inures to the applicant's benefit. A formal written licensing agreement between the parties is not necessary, nor is its existence sufficient to establish ownership rights. The critical question is whether the applicant sufficiently controls the nature and quality of the goods or services with which the mark is used. *See Pneutek, Inc. v. Scherr,* 211 USPQ 824 (TTAB 1981) (detailed written agreement and substantial evidence in the record indicating that the applicant, an individual, exercised control over the nature and quality of the goods sold under the mark by the user corporation held sufficient to show that the corporation was a related company).

Similarly, where an individual applicant is not the sole owner of the corporation that is using the mark, the fact that the individual applicant is a stockholder, director, or officer in the corporation is insufficient in itself to establish that the corporation is a related company. The question depends on whether the applicant maintains control over the nature and quality of the goods or services.

See **TMEP §1201.03(c)** regarding use by wholly owned related companies.

1201.03(e) Sister Corporations

The fact that two sister corporations are controlled by a single parent corporation does not mean that they are related companies. Where two corporations are wholly owned subsidiaries of a common parent, use by one sister corporation is not considered to inure to the benefit of the other, unless the applicant sister corporation exercises appropriate control over the nature and quality of the goods or services on or in connection with which the mark is used. *Great Seats, Ltd. v. Great Seats, Inc.*, 84 USPQ2d 1235 (TTAB 2007); *In re Pharmacia Inc.*, 2 USPQ2d 1883 (TTAB 1987); *Greyhound Corp. v. Armour Life Insurance Co.*, 214 USPQ 473 (TTAB 1982).

See **TMEP §1201.03(c)** regarding use by wholly owned related companies.

1201.03(f) License and Franchise Situations

The USPTO accepts applications by parties who claim to be owners of marks through use by controlled licensees, pursuant to a contract or agreement. *Pneutek, Inc. v. Scherr,* 211 USPQ 824, 833 (TTAB 1981).

A controlled licensing agreement may be recognized whether oral or in writing. *In re Raven Marine, Inc.*, 217 USPQ 68, 69 (TTAB 1983).

If the application indicates that use of the mark is pursuant to a license or franchise agreement, and the record contains nothing that contradicts the assertion of ownership by the applicant (i.e., the licensor or franchisor), the examining attorney will not inquire about the relationship between the applicant and the related company (i.e., the licensee or franchisee).

Ownership rights in a trademark or service mark may be acquired and maintained through the use of the mark by a controlled licensee even when the only use of the mark has been made, and is being made, by the licensee. *Turner v. HMH Publishing Co., Inc.*, 380 F.2d 224, 229, 154 USPQ 330, 334 (5th Cir. 1967), *cert. denied*, 389 U.S. 1006, 156 USPQ 720 (1967); *Ballet Tech Foundation, Inc. v. The Joyce Theater Foundation, Inc.*, 89 USPQ2d 1262 (TTAB 2008) (Board found petitioner to be the owner of the marks even though respondent had been the only user because of an implied license between the parties); *Central Fidelity Banks, Inc. v. First Bankers Corp. of Florida*, 225 USPQ 438, 440 (TTAB 1984) (use of the mark by petitioner's affiliated banks considered to inure to the benefit of petitioner bank holding company, even though the bank holding company could not legally render banking services and, thus, could not use the mark).

Joint applicants enjoy rights of ownership to the same extent as any other "person" who has a proprietary interest in a mark. Therefore, joint applicants may license others to use a mark and, by exercising sufficient control and supervision of the nature and quality of the goods or services to which the mark is applied, the joint applicants/licensors may claim the benefits of the use by the related company/licensee. *In re Diamond Walnut Growers, Inc. and Sunsweet Growers Inc.*, 204 USPQ 507 (TTAB 1979).

Stores that are operating under franchise agreements from another party are considered "related companies" of that party, and use of the mark by the franchisee/store inures to the benefit of the franchisor. *Mr. Rooter Corp. v. Morris*, 188 USPQ 392, 394 (E.D. La. 1975); *Southland Corp. v. Schubert*, 297 F. Supp. 477, 160 USPQ 375, 381 (C.D. Cal. 1968).

In all franchise and license situations, the key to ownership is the nature and extent of the control by the applicant over the goods or services to which the mark is applied. A trademark owner who fails to exercise sufficient control over licensees or franchisees may be found to have abandoned its rights in the mark. *See Hurricane Fence Co. v. A-1 Hurricane Fence Co. Inc.,* 468 F. Supp. 975, 986-989; 208 USPQ 314, 325-27 (S.D. Ala. 1979).

In general, where the application states that a mark is used by a licensee or franchisee, the USPTO does not require an explanation of how the applicant controls the use.

1201.04 Inquiry Regarding Parties Named on Specimens or Elsewhere in Record

The USPTO does not inquire about the relationship between the applicant and other parties named on the specimen or elsewhere in the record, except when the reference to another party clearly contradicts the applicant's verified statement that it is the owner of the mark or entitled to use the mark.

The examining attorney should inquire about another party if the record specifically states that another party is the owner of the mark, or if the record specifically identifies the applicant in a manner that contradicts the claim of ownership, for example, as a licensee. In these circumstances, registration should be refused under §1 of the Trademark Act, on the ground that the applicant is not the owner of the mark. Similarly, when the record indicates that the applicant is a United States distributor, importer, or other distributing agent for a foreign manufacturer, the examining attorney should require the applicant to establish its ownership rights in the United States in accordance with **TMEP §1201.06(a).**

Where the specimen of use indicates that the goods are manufactured in a country other than the applicant's home country, the examining attorney normally should not inquire whether the mark is used by a foreign manufacturer. *See* **TMEP §1201.06(b).** Also, where the application states that use of the mark is by related companies, an explanation of how the applicant controls use of the mark by the related companies is not required. *See* **TMEP §1201.03(b).**

1201.05 Acceptable Claim of Ownership Based on Applicant's Own Use

An applicant's claim of ownership of a mark may be based on the applicant's own use of the mark, even though there is also use by a related company. The applicant is the owner by virtue of the applicant's own use, and the application does not have to refer to use by a related company.

An applicant may claim ownership of a mark when the mark is applied on the applicant's instruction. For example, if the applicant contracts with another party to have goods produced for the applicant and instructs the party to place the mark on the goods, that is considered the equivalent of the applicant itself placing the mark on its own goods and reference to related-company use is not necessary.

1201.06 Special Situations Pertaining to Ownership

1201.06(a) Applicant Is Merely Distributor or Importer

A distributor, importer, or other distributing agent of the goods of a manufacturer or producer does not acquire a right of ownership in the manufacturer's or producer's mark merely because it moves the goods in trade. *In re Bee Pollen from England Ltd.*, 219 USPQ 163 (TTAB 1983); *Audioson Vertriebs - GmbH v. Kirksaeter Audiosonics, Inc.*, 196 USPQ 453 (TTAB 1977); *Jean D'Albret v. Henkel-Khasana G.m.b.H.*, 185 USPQ 317 (TTAB 1975); *In re Lettmann,* 183 USPQ 369 (TTAB 1974); *Bakker v. Steel Nurse of America Inc.*, 176 USPQ 447 (TTAB 1972). A party that merely distributes goods bearing the mark of a manufacturer or producer is neither the owner nor a related-company user of the mark.

If the applicant merely distributes or imports goods for the owner of the mark, registration must be refused under §1 of the Trademark Act, *except* in the following situations:

(1) If a parent and wholly owned subsidiary relationship exists between the distributor and the manufacturer, then the applicant's statement that such a relationship exists disposes of an ownership issue. *See* **TMEP §1201.03(c).**

(2) If an applicant is the United States importer or distribution agent for a foreign manufacturer, then the applicant can register the foreign manufacturer's mark in the United States, if the applicant submits one of the following:

(a) written consent from the owner of the mark to registration in the applicant's name, or

(b) written agreement or acknowledgment between the parties that the importer or distributor is the owner of the mark in the United States, or

(c) an assignment (or true copy) to the applicant of the owner's rights in the mark as to the United States together with the business and good will appurtenant thereto.

See In re Pharmacia Inc., 2 USPQ2d 1883 (TTAB 1987); *In re Geo. J. Ball, Inc.,* 153 USPQ 426 (TTAB 1967).

1201.06(b) Goods Manufactured in a Country Other than Where Applicant Is Located

Where a specimen indicates that the goods are manufactured in a country other than the applicant's home country, the examining attorney normally should not inquire whether the mark is used by a foreign manufacturer. If, however, information in the record clearly contradicts the applicant's verified claim of ownership (e.g., a statement in the record that the mark is owned by the foreign manufacturer and that the applicant is only an importer or distributor), then registration must be refused under §1, 15 U.S.C. §1051, unless registration in the United States by the applicant is supported by the applicant's submission of one of the documents listed in **TMEP §1201.06(a).**

1201.07 Related Companies and Likelihood of Confusion

1201.07(a) "Single Source" – "Unity of Control"

Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), requires that the examining attorney refuse registration when an applicant's mark, as applied to the specified goods or services, so resembles a registered mark as to be likely to cause confusion. In general, registration of confusingly similar marks to separate legal entities is barred by §2(d). *See, e.g., In re Citibank, N.A.*, 225 USPQ 612 (TTAB 1985); *In re Champion Int'l Corp.*, 220 USPQ 478 (TTAB 1982); *In re Air Products, Inc.,* 124 USPQ 81 (TTAB 1960). However, the Court of Appeals for the Federal Circuit has held that, where the applicant is related in ownership to a company that owns a registered mark that would otherwise give rise to a likelihood of confusion, the examining attorney must consider whether, in view of all the circumstances, use of the mark by the applicant is likely to confuse the public about the source of the applicant's goods because of the resemblance of the applicant's mark to the mark of the other company. The Court stated that:

> The question is whether, despite the similarity of the marks and the goods on which they are used, the public is likely to be confused about the source of the hair straightening products carrying the trademark "WELLASTRATE." In other words, is the public likely to believe that the source of the product is Wella U.S. rather than the German company or the Wella organization.

In re Wella A.G., 787 F.2d 1549, 1552, 229 USPQ 274, 276 (Fed. Cir. 1986). The Court remanded the case to the Board for consideration of the likelihood of confusion issue.

In ruling on that issue, the Board concluded that there was no likelihood of confusion, stating as follows:

> [A] determination must be made as to whether there exists a likelihood of confusion as to *source*, that is, whether purchasers would believe that particular goods or services emanate from a single source, when in fact those goods or services emanate from more than a single source. Clearly, the Court views the concept of "source" as encompassing more than "legal entity." Thus, in this case, we are required to determine whether Wella A.G. and Wella U.S. are the same source or different sources....

> The existence of a related company relationship between Wella U.S. and Wella A.G. is not, in itself, a basis for finding that any "WELLA" product emanating from either of the two companies emanates from the same source. Besides the existence of a legal relationship, there must also be a unity of control over the use of the trademarks. "Control" and "source" are inextricably linked. If, notwithstanding the legal relationship between entities, each entity exclusively controls the nature and quality of the goods to which it applies one or more of the various "WELLA" trademarks, the two entities are in fact separate sources. Wella A.G. has made of record a declaration of the executive vice president of Wella U.S., which declaration states that Wella A.G. owns substantially all the outstanding stock of Wella U.S. and "thus controls the activities and operations of Wella U.S., including the selection, adoption and use of the trademarks." While the declaration contains no details of how this control is exercised, the declaration is sufficient, absent contradictory evidence in the record, to establish that control over the use of all the "WELLA" trademarks in the United States resides in a single source.

In re Wella A.G., 5 USPQ2d 1359, 1361 (TTAB 1987) (emphasis in original), *rev'd on other grounds,* 858 F.2d 725, 8 USPQ2d 1365 (Fed. Cir. 1988).

Therefore, in some limited circumstances, the close relationship between related companies will obviate any likelihood of confusion in the public mind because the related companies constitute a single source. *See* **TMEP §§1201.07(b)** *et seq*. for further information.

1201.07(b) Appropriate Action with Respect to Assertion of Unity of Control

First, it is important to note that analysis under *Wella* is not triggered until an applicant affirmatively asserts that a §2(d) refusal is inappropriate because the applicant and the registrant, though separate legal entities, constitute a single source, or the applicant raises an equivalent argument. Examining attorneys should issue §2(d) refusals in any case where an analysis of the marks and the goods or services of the respective parties indicates a bar to registration under §2(d). The examining attorney should not attempt to analyze the relationship between an applicant and registrant until an applicant, in some form, relies on the nature of the relationship to obviate a refusal under §2(d).

Once an applicant has made this assertion, the question is whether the specific relationship is such that the two entities constitute a "single source," so that there is no likelihood of confusion. The following guidelines may assist the examining attorney in resolving questions of likelihood of confusion when the marks are owned by related companies and the applicant asserts unity of control. (Of course, in many of these situations, the applicant may choose to attempt to overcome the §2(d) refusal by submitting a consent agreement or other conventional evidence to establish no likelihood of confusion. *See In re Sumitomo Electric Industries, Ltd.*, 184 USPQ 365 (TTAB 1974). Another way to overcome a §2(d) refusal is to assign all relevant registrations to the same party.)

1201.07(b)(i) When Either Applicant or Registrant Owns All of the Other Entity

If the applicant or the applicant's attorney represents that *either* the applicant or the registrant owns *all* of the other entity, and there is no contradictory evidence, then the examining attorney should conclude that there is unity of control, a single source, and no likelihood of confusion. This would apply to an individual who owns all the stock of a corporation, and to a corporation and a wholly owned subsidiary. In this circumstance, additional representations or declarations should generally *not* be required, absent contradictory evidence.

1201.07(b)(ii) Joint Ownership or Ownership of Substantially All of the Other Entity

Either Applicant or Registrant Owns Substantially All of the Other Entity. In *Wella*, the applicant provided a declaration stating that the applicant owned *substantially all* of the stock of the registrant and that the applicant thus controlled the activities of the registrant, including the selection, adoption, and use of trademarks. The Board concluded that this declaration alone, absent contradictory evidence, established unity of control, a single source, and no likelihood of confusion. Therefore, if *either* the applicant or the registrant owns substantially all of the other entity and asserts control over the activities of the other entity, including its trademarks, and there is no contradictory evidence, the examining attorney should conclude that unity of control is present, that the entities constitute a single source, and that there is no likelihood of confusion under §2(d). In such a case, the applicant should generally provide these assertions in the form of an affidavit or declaration under 37 C.F.R. §2.20.

Joint Ownership. The examining attorney may also accept an applicant's assertion of unity of control when the applicant is shown in USPTO records as a joint owner of the cited registration, or the owner of the registration is listed as a joint owner of the application, and the applicant submits a written statement asserting control over the use of the mark by virtue of joint ownership, if there is no contradictory evidence.

1201.07(b)(iii) When the Record Does Not Support a Presumption of Unity of Control

If neither the applicant nor the registrant owns all or substantially all of the other entity, and USPTO records do not show their joint ownership of the application or cited registration (*see* **TMEP §1201.07(b)(ii))**, the applicant bears a more substantial burden to establish that unity of control is present. For instance, if both the applicant and the registrant are wholly owned by a third common parent, the applicant would have to provide detailed evidence to establish how one sister corporation controlled the trademark activities of the other to establish unity of control to support the contention that the sister corporations constitute a single source. *See In re Pharmacia Inc.*, 2 USPQ2d 1883 (TTAB 1987); *Greyhound Corp. v. Armour Life Ins. Co.*, 214 USPQ 473 (TTAB 1982). Likewise, where an applicant and registrant have certain stockholders, directors, or officers in common, the applicant must demonstrate with detailed evidence or explanation how those relationships establish unity of control. *See Pneutek, Inc. v. Scherr,* 211 USPQ 824 (TTAB 1981). The applicant's evidence or explanation should generally be supported by an affidavit or a declaration under 37 C.F.R. §2.20.

1201.07(b)(iv) When the Record Contradicts an Assertion of Unity of Control

In contrast to those circumstances where the relationship between the parties may support a presumption of unity of control or at least afford an applicant the opportunity to demonstrate unity of control, some relationships, by their very nature, contradict any claim that unity of control is present. For instance, if the relationship between the parties is that of licensor and licensee, unity of control will ordinarily not be present. The licensing relationship suggests ownership in one party and control by that one party over only the use of a specific mark or marks, but not over the operations or activities of the licensee generally. Thus, there is no unity of control and no basis for concluding that the two parties form a single source. Precisely because unity of control is absent, a licensing agreement is necessary. The licensing agreement enables the licensor/owner to control specific activities to protect its interests as the sole source or sponsor of the goods or services provided under the mark. Therefore, in these situations, it is most unlikely that an applicant could establish unity of control to overcome a §2(d) refusal.

1202 Use of Subject Matter as Trademark

In an application under §1 of the Act, the examining attorney must determine whether the subject matter for which registration is sought is used as a trademark by reviewing all evidence (e.g., the specimen and any promotional material) of record in the application. *See In re Safariland Hunting Corp*., 24 USPQ2d 1380 (TTAB 1992) (examining attorney should look primarily to the specimen to determine whether a designation would be perceived as a source indicator, but may also consider other evidence, if there is other evidence of record).

Not everything that a party adopts and uses with the intent that it function as a trademark necessarily achieves this goal or is legally capable of doing so, and not everything that is recognized or associated with a party is necessarily a registrable trademark. As the Court of Customs and Patent Appeals observed in *In re Standard Oil Co.,* 275 F.2d 945, 947, 125 USPQ 227, 229 (C.C.P.A. 1960):

> The Trademark Act is not an act to register words but to register trademarks. Before there can be registrability, there must be a trademark (or a service mark) and, unless words have been so used, they cannot qualify for registration. Words are not registrable merely because they do not happen to be descriptive of the goods or services with which they are associated.

Sections 1 and 2 of the Trademark Act, 15 U.S.C. §§1051 and 1052, require that the subject matter presented for registration be a "trademark." Section 45 of the Act, 15 U.S.C. §1127, defines that term as follows:

> The term "trademark" includes any word, name, symbol, or device, or any combination thereof–
>
> (1) used by a person, or
>
> (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act,
>
> to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

Thus, §§1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127, provide the statutory basis for refusal to register on the Principal Register subject matter that, due to its inherent nature or the manner in which it is used, does not function as a mark to identify and distinguish the applicant's goods. The statutory basis for refusal of registration on the Supplemental Register of matter that does not function as a trademark because it does not fit within the statutory definition of a trademark is §§23 and 45, 15 U.S.C. §§1091 and 1127.

When the examining attorney refuses registration on the ground that the subject matter is not used as a trademark, the examining attorney should explain the specific reason for the conclusion that the subject matter is not used as a trademark. *See* **TMEP §§1202.01** *et seq*. for a discussion of situations in which it may be appropriate, depending on the circumstances, for the

examining attorney to refuse registration on the ground that the proposed mark does not function as a trademark, *e.g.,* **TMEP §§1202.01** (trade names), **1202.02(a)** *et seq*. (functionality), **1202.03** (ornamentation), **1202.04** (informational matter), **1202.05** (color marks), **1202.06** (goods in trade), **1202.07** (columns or sections of publications), **1202.08** (title of single creative work), **1202.09** *et seq*. (names of artists and authors), **1202.16** (model or grade designations), **1202.11** (background designs and shapes), and **1202.12** (varietal and cultivar names).

The presence of the letters "SM" or "TM" cannot transform an otherwise unregistrable designation into a mark. *In re Remington Products Inc*., 3 USPQ2d 1714 (TTAB 1987); *In re Anchor Hocking Corp*., 223 USPQ 85 (TTAB 1984); *In re Minnetonka, Inc*., 212 USPQ 772 (TTAB 1981).

The issue of whether a designation functions as a mark usually is tied to 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 action issued by the USPTO. 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.

In an application under §44 or §66(a), where a specimen of use is not required prior to registration, it is appropriate for examining attorneys to issue a failure to function refusal where the mark on its face, as shown in the drawing and described in the description, reflects a failure to function. *See In re Right-On Co.,* 87 USPQ2d 1152, 1156-57 (TTAB 2008) (noting the propriety of and affirming an ornamentation refusal in a §66(a) application).

See **TMEP §§1301.02** *et seq*. regarding use of subject matter as a service mark; **TMEP §§1302** through **1304** *et seq*. regarding use of subject matter as a collective mark; and **TMEP §§1306** *et seq*. regarding use of subject matter as a certification mark.

1202.01 Refusal of Matter Used Solely as a Trade Name

The name of a business or company is a trade name. The Trademark Act distinguishes trade names from trademarks by definition. While a trademark is used to identify and distinguish the trademark owner's goods from those manufactured or sold by others and to indicate the source of the goods, "trade name" and "commercial name" are defined in §45 of the Act, 15 U.S.C. §1127, as follows:

> The terms "trade name" and "commercial name" mean any name used by a person to identify his or her business or vocation.

The Trademark Act does not provide for registration of trade names. *See In re Letica Corp.*, 226 USPQ 276, 277 (TTAB 1985) ("[T]here was a clear intention by the Congress to draw a line between indicia which perform only trade name functions and indicia which perform or also perform the function of trademarks or service marks.").

If the examining attorney determines that matter for which registration is requested is merely a trade name, registration must be refused both on the Principal Register and on the Supplemental Register. The statutory basis for refusal of trademark registration on the ground that the matter is used merely as a trade name is §§1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127, and, in the case of matter sought to be registered for services, §§1, 2, 3, and 45, 15 U.S.C. §§1051, 1052, 1053, and 1127.

A designation may function as both a trade name and a trademark or service mark. *See In re Walker Process Equipment Inc.*, 233 F.2d 329, 332, 110 USPQ 41, 43 (C.C.P.A. 1956), *aff'g* 102 USPQ 443 (Comm'r Pats. 1954).

If subject matter presented for registration in an application is a trade name or part of a trade name, the examining attorney must determine whether it is also used as a trademark or service mark, by examining the specimen and other evidence of record in the application file. *See In re Diamond Hill Farms*, 32 USPQ2d 1383 (TTAB 1994) (DIAMOND HILL FARMS, as used on containers for goods, found to be a trade name that identifies applicant as a business entity rather than a mark that identifies applicant's goods and distinguishes them from those of others).

Whether matter that is a trade name (or a portion thereof) also performs the function of a trademark depends on the manner of its use and the probable impact of the use on customers. *See In re Supply Guys, Inc.*, 86 USPQ2d 1488 (TTAB 2008) (use of trade name in "Ship From" section of Federal Express label where it serves as a return address does not demonstrate trademark use as the term appears where customers would look for the name of the party shipping the package); *In re Unclaimed Salvage & Freight Co., Inc.*, 192 USPQ 165, 168 (TTAB 1976) ("It is our opinion that the foregoing material reflects use by applicant of the notation 'UNCLAIMED SALVAGE & FREIGHT CO.' merely as a commercial, business, or trade name

serving to identify applicant as a viable business entity; and that this is or would be the general and likely impact of such use upon the average person encountering this material under normal circumstances and conditions surrounding the distribution thereof."); *In re Lytle Engineering & Mfg. Co.*, 125 USPQ 308 (TTAB 1960) ("'LYTLE' is applied to the container for applicant's goods in a style of lettering distinctly different from the other portion of the trade name and is of such nature and prominence that it creates a separate and independent impression.")

The presence of an entity designator in a name sought to be registered and the proximity of an address are both factors to be considered in determining whether a proposed mark is merely a trade name. *In re Univar Corp.*, 20 USPQ2d 1865, 1869 (TTAB 1991) ("[T]he mark "UNIVAR" independently projects a separate commercial impression, due to its presentation in a distinctively bolder, larger and different type of lettering and, in some instances, its additional use in a contrasting color, and thus does more than merely convey information about a corporate relationship.") *See also Book Craft, Inc. v. BookCrafters USA, Inc.*, 222 USPQ 724, 727 (TTAB 1984) ("That the invoices ... plainly show ... service mark use is apparent from the fact that, not only do the words 'BookCrafters, Inc.' appear in larger letters and a different style of print than the address, but they are accompanied by a design feature (the circularly enclosed ends of two books).").

A determination of whether matter serves solely as a trade name rather than as a mark requires consideration of the way the mark is used, as evidenced by the specimen. Therefore, no refusal on that ground will be issued in an intent-to-use application until the applicant has submitted specimen(s) of use in conjunction with an allegation of use under 15 U.S.C. §1051(c) or 15 U.S.C. §1051(d)).

1202.02 Registration of Trade Dress

Trade dress constitutes a "symbol" or "device" within the meaning of §2 of the Trademark Act, 15 U.S.C. §1052. *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 209-210 (2000). Trade dress originally included only the packaging or "dressing" of a product, but in recent years has been expanded to encompass the design of a product. It is usually defined as the "total image and overall appearance" of a product, or the totality of the elements, and "may include features such as size, shape, color or color combinations, texture, graphics." *Two Pesos, Inc. v. Taco Cabana, Inc.,* 505 U.S. 763, 764 n.1 (1992).

Thus, trade dress includes the design of a product (i.e., the product shape or configuration), the packaging in which the product is sold (i.e., the "dressing" of a product), the color of the product or of the packaging in which the product is sold, and the flavor of the product. *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205 (2000); *Two Pesos,* 505 U.S. 763; *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159 (1995); *In re N.V. Organon*, 79 USPQ2d 1639 (TTAB 2006). However, this is not an exhaustive list, because "almost anything at all that is capable of carrying meaning" may be used as a "symbol" or "device" and constitute trade dress that identifies the source or origin of a product. *Qualitex,* 514 U.S. at 162. When it is difficult to determine whether the proposed mark is product packaging or product design, such "ambiguous" trade dress is treated as product design. *Wal-Mart Stores,* 529 U.S. 205. Trade dress marks may be used in connection with goods and services.

In some cases, the nature of a potential trade dress mark may not be readily apparent. A determination whether the mark constitutes trade dress must be informed by the application content, including the drawing, the description of the mark, the identification of goods or services, and the specimen, if any. If it remains unclear whether the proposed mark constitutes trade dress, the examining attorney may call or e-mail the applicant to clarify the nature of the mark, or issue an Office action requiring information regarding the nature of the mark, as well as any other necessary clarifications, such as a clear drawing and an accurate description of the mark. 37 C.F.R. §61(b). The applicant's response would then confirm whether the proposed mark is trade dress.

When an applicant applies to register a product design, product packaging, color, or other trade dress for goods or services, the examining attorney must separately consider two substantive issues: (1) functionality; and (2) distinctiveness. *See TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 28-29, 58 USPQ2d 1001, 1004-1005 (2001); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 775, 23 USPQ2d 1081, 1086 (1992) (only nonfunctional distinctive trade dress is protected). *See* **TMEP §§1202.02(a)** *et seq.* regarding functionality and **TMEP §§1202.02(b)** and **1212** *et seq.* regarding distinctiveness. In many cases, a refusal of registration may be necessary on both grounds. In any application where a product design is refused because it is functional, registration must also be refused on the ground that the proposed mark is nondistinctive since product design is never inherently distinctive. However, since product packaging may be inherently distinctive, in an application where product packaging is refused as functional, registration should also be refused on the ground that the proposed mark is nondistinctive. Even if it is ultimately determined that the product packaging is not functional, the alternative basis for refusal may stand.

If the proposed trade dress mark is ultimately determined to be functional, claims and evidence that the mark has acquired distinctiveness or secondary meaning are irrelevant and registration will be refused. *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 33, 58 USPQ2d 1001, 1007 (2001).

With respect to the functionality and distinctiveness issues in the specific context of color as a mark, *see* **TMEP §§1202.05(a)** and **1202.05(b).**

Old Edition

1202.02(a) Functionality of Trade Dress

In general terms, trade dress is functional, and cannot serve as a trademark, if a feature of that trade dress is essential to the use or purpose of the article or if it affects the cost or quality of the article. *Qualitex Co. v. Jacobson Products Co., Inc*., 514 U.S. 159, 165, 34 USPQ2d 1161, 1163-1164 (1995) (quoting *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 850, n.10, 214 USPQ 1, 4 n.10 (1982)).

1202.02(a)(i) Statutory Basis for Functionality Refusal

Before October 30, 1998, there was no specific statutory reference to functionality as a ground for refusal, and functionality refusals were thus issued as failure-to-function refusals under §§1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127.

Effective October 30, 1998, the Technical Corrections to Trademark Act of 1946, Pub. L. No. 105-330, §201, 112 Stat. 3064, 3069, amended the Trademark Act to expressly prohibit registration on either the Principal or Supplemental Register of functional matter:

- Section 2(e)(5) of the Trademark Act, 15 U.S.C. §1052(e)(5), prohibits registration on the Principal Register of “matter that, as a whole, is functional.”
- Section 2(f) of the Act, 15 U.S.C. §1052(f), provides that matter that, as a whole, is functional may not be registered even on a showing that it has become distinctive.
- Section 23(c) of the Act, 15 U.S.C. §1091(c), provides that a mark that, as a whole, is functional may not be registered on the Supplemental Register.
- Section 14(3) of the Act, 15 U.S.C. §1064(3), lists functionality as a ground that can be raised in a cancellation proceeding more than five years after the date of registration.
- Section 33(b)(8) of the Act, 15 U.S.C. §1115(b)(8), lists functionality as a statutory defense to infringement in a suit involving an incontestable registration.

These amendments codified case law and the longstanding USPTO practice of refusing registration of functional matter.

1202.02(a)(ii) Purpose of Functionality Doctrine

The functionality doctrine, which prohibits registration of functional product features, is intended to encourage legitimate competition by maintaining the proper balance between trademark law and patent law. As the Supreme Court explained, in *Qualitex Co. v. Jacobson Products Co., Inc.,* 514 U.S. 159, 164-165, 34 USPQ2d 1161, 1163 (1995):

> The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm’s reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature. It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time, 35 U.S.C. §§154, 173, after which competitors are free to use the innovation. If a product’s functional features could be used as trademarks, however, a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever (because trademarks may be renewed in perpetuity).

In other words, the functionality doctrine ensures that protection for utilitarian product features be properly sought through a limited-duration utility patent, and not through the potentially unlimited protection of a trademark registration. Upon expiration of a utility patent, the invention covered by the patent enters the public domain, and the functional features disclosed in the patent may then be copied by others – thus encouraging advances in product design and manufacture. In *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 34-35, 58 USPQ2d 1001, 1007 (2001), the Supreme Court reiterated this rationale, also noting that the functionality doctrine is not affected by evidence of acquired distinctiveness.

Thus, even where the evidence establishes that consumers have come to associate a functional product feature with a single source, trademark protection will not be granted in light of the public policy reasons stated. *Id.*

1202.02(a)(iii) Background and Definitions

1202.02(a)(iii)(A) Functionality

Functional matter cannot be protected as a trademark. 15 U.S.C. §§1052(e)(5) and (f), 1091(c), 1064(3), and 1115(b). A feature is functional as a matter of law if it is "essential to the use or purpose of the product or if it affects the cost or quality of the device." *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 33, 58 USPQ2d 1001, 1006 (2001); *Qualitex Co. v. Jacobson Products Co., Inc.,* 514 U.S. 159, 165, 34 USPQ2d 1161, 1163-64 (1995); *Inwood Laboratories, Inc. v. Ives Laboratories, Inc*., 456 U.S. 844, 850 n.10, 214 USPQ 1, 4 n.10 (1982).

While some courts had developed a definition of functionality that focused solely on "competitive need" – thus finding a particular product feature functional only if competitors needed to copy that design in order to compete effectively – the Supreme Court held that this "was incorrect as a comprehensive definition" of functionality. *TrafFix*, 532 U.S. at 33, 58 USPQ2d at 1006. The Court emphasized that where a product feature meets the traditional functionality definition – that is, it is essential to the use or purpose of the product or affects its cost or quality – then the feature is functional, regardless of the availability to competitors of other alternatives. *Id*.; *see also Valu Engineering, Inc. v. Rexnord Corp*., 278 F.3d 1268, 1276, 61 USPQ2d 1422, 1427 (Fed. Cir. 2002) ("Rather, we conclude that the [*TrafFix*] Court merely noted that once a product feature is found functional based on other considerations there is no need to consider the availability of alternative designs, because the feature cannot be given trade dress protection merely because there are alternative designs available" (footnote omitted).)

However, since the preservation of competition is an important policy underlying the functionality doctrine, competitive need, although not determinative, remains a significant consideration in functionality determinations. *Valu Engineering,* 278 F.3d at 1276, 61 USPQ2d at 1427.

The determination that a proposed mark is functional constitutes, for public policy reasons, an absolute bar to registration on either the Principal Register or the Supplemental Register, regardless of evidence showing that the proposed mark has acquired distinctiveness. *TrafFix*, 532 U.S. at 29-33, 58 USPQ2d at 1005-1007. *See also In re Controls Corp. of America,* 46 USPQ2d 1308, 1311 (TTAB 1998). Thus, if an applicant responds to a functionality refusal under §2(e)(5), 15 U.S.C. §1052(e)(5), by submitting an amendment seeking registration on the Supplemental Register, such an amendment does not introduce a new issue warranting a nonfinal Office action. *See* **TMEP §714.05(a)(i).** Instead, the §2(e)(5) refusal should be maintained and made final, if appropriate.

See **TMEP §§1202.02(a)(v)** *et seq*. regarding evidentiary considerations pertaining to functionality refusals.

1202.02(a)(iii)(B) "*De Jure*" and "*De Facto*" Functionality

Prior to 2002, the USPTO used the terms "*de facto*" and "*de jure*" in assessing whether "subject matter" (usually a product feature or the configuration of the goods) presented for registration was functional. This distinction originated with the Court of Customs and Patent Appeals' *Morton-Norwich* decision, which was discussed by the Federal Circuit in *Valu Engineering, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1274, 61 USPQ2d 1422, 1425 (Fed. Cir. 2002):

> Our decisions distinguish *de facto* functional features, which may be entitled to trademark protection, from *de jure* functional features, which are not. 'In essence, *de facto* functional means that the design of a product has a function, i.e., a bottle of any design holds fluid.' *In re R.M. Smith, Inc.,* 734 F.2d 1482, 1484, 222 USPQ 1, 3 (Fed. Cir. 1984). *De facto* functionality does not necessarily defeat registrability. *Morton-Norwich*, 671 F.2d [1332] at 1337, 213 USPQ [9] at 13 [(C.C.P.A. 1982)] (A design that is *de facto* functional, i.e., 'functional' in the lay sense ... *may* be legally recognized as an indication of source.'). *De jure* functionality means that the product has a particular shape 'because it works better in this shape.' *Smith*, 734 F.2d at 1484, 222 USPQ at 3.

However, in three Supreme Court decisions involving functionality – *Qualitex Co. v. Jacobson Products Co., Inc.,* 514 U.S. 159, 34 USPQ2d 1161 (1995)*, Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 54 USPQ2d 1065 (2000), and *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001 (2001) – the Court did not use the "*de facto/de jure*" distinction. Nor were these terms used when the Trademark Act was amended to expressly prohibit registration of matter that is "functional." Technical Corrections to Trademark Act of 1946, Pub. L. No. 105-330, §201, 112 Stat. 3064, 3069 (1998). Accordingly, in general, examining attorneys no longer make this distinction in Office actions that refuse registration based on functionality.

De facto functionality is not a ground for refusal. *In re Ennco Display Systems Inc.*, 56 USPQ2d 1279, 1282 (TTAB 2000); *In re Parkway Machine Corp*., 52 USPQ2d 1628, 1631 n.4 (TTAB 1999).

1202.02(a)(iv) Burden of Proof in Functionality Determinations

The examining attorney must establish a prima facie case that the proposed trade dress mark sought to be registered is functional in order to make and maintain the §2(e)(5) functionality refusal. To do so, the examining attorney must not only examine the application content (i.e., the drawing, the description of the mark, the identification of goods or services, and the specimen, if any), but also conduct independent research to obtain evidentiary support for the refusal. In applications where

there is reason to believe that the proposed mark may be functional, but the evidence is lacking to issue the §2(e)(5) refusal in the first Office action, a request for information pursuant to 37 C.F.R. §2.61(b) must be issued to obtain information from the applicant so that an informed decision about the validity of the functionality refusal can be made.

The burden then shifts to the applicant to present sufficient evidence to rebut the examining attorney's prima facie case of functionality. *Textron, Inc. v. U.S. Int'l Trade Comm'n,* 753 F.2d 1019, 1025, 224 USPQ 625, 629 (Fed. Cir. 1985); *In re R.M. Smith, Inc.*, 734 F.2d 1482, 1484, 222 USPQ 1, 3 (Fed. Cir. 1984); *In re Bio-Medicus Inc.*, 31 USPQ2d 1254, 1257 n.5 (TTAB 1993).

The functionality determination is a question of fact, and depends on the totality of the evidence presented in each particular case. *Valu Engineering, Inc. v. Rexnord Corp*., 278 F.3d 1268, 1273, 61 USPQ2d 1422, 1424 (Fed. Cir. 2002); *In re UDOR U.S.A., Inc.*, 89 USPQ2d 1978, 1979 (TTAB 2009); *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1339 (TTAB 1997). While there is no set amount of evidence that an examining attorney must present to establish a prima facie case of functionality, it is clear that there must be evidentiary support for the refusal in the record. *See, e.g., In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 1342, 213 USPQ 9, 16-17 (C.C.P.A. 1982) (admonishing both the examining attorney and the Board for failing to support the functionality determination with even "one iota of evidence").

If the design sought to be registered as a mark is the subject of a utility patent that discloses the feature's utilitarian advantages, then the applicant bears an especially "heavy burden of overcoming the strong evidentiary inference of functionality." *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 30, 58 USPQ2d 1001, 1005 (2001); *UDOR U.S.A., Inc.*, 89 USPQ2d at 1979-80; *see* **TMEP §1202.02(a)(v)(A).**

1202.02(a)(v) Evidence and Considerations Regarding Functionality Determinations

A determination of functionality normally involves consideration of one or more of the following factors, commonly known as the "*Morton-Norwich* factors":

(1) the existence of a utility patent that discloses the utilitarian advantages of the design sought to be registered;

(2) advertising by the applicant that touts the utilitarian advantages of the design;

(3) facts pertaining to the availability of alternative designs; and

(4) facts pertaining to whether the design results from a comparatively simple or inexpensive method of manufacture.

In re Morton-Norwich Products, Inc., 671 F.2d 1332, 1340-1341, 213 USPQ 9, 15-16 (C.C.P.A. 1982).

Since relevant technical information is often more readily available to an applicant, the applicant will often be the source of most of the evidence relied upon by the examining attorney in establishing a prima facie case of functionality in an ex parte case. *In re Teledyne Industries Inc.*, 696 F.2d 968, 971, 217 USPQ 9, 11 (Fed. Cir. 1982); *In re Witco Corp*., 14 USPQ2d 1557, 1560 (TTAB 1990). Therefore, in an application for a trade dress mark, when there is reason to believe that the proposed mark may be functional, the examining attorney must perform a search for evidence to support the *Morton-Norwich* factors. In applications where there is reason to believe that the proposed mark may be functional, the first Office action must include a request for information under 37 C.F.R. §2.61(b), requiring the applicant to provide information necessary to permit an informed determination concerning the functionality of the proposed mark. *See In re Babies Beat Inc.*, 13 USPQ2d 1729, 1731 (TTAB 1990) (registration properly refused where applicant failed to comply with examining attorney's request for copies of patent applications and other patent information). Such a request should be issued for most product design marks.

Accordingly, the examining attorney's request for information should pertain to the *Morton-Norwich* factors and: (1) ask the applicant to provide copies of any patent(s) or any pending or abandoned patent application(s); (2) ask the applicant to provide any available advertising, promotional, or explanatory material concerning the goods/services, particularly any material specifically related to the features embodied in the proposed mark; (3) inquire of the applicant whether alternative designs are available; and (4) inquire whether the feature makes the product easier or cheaper to manufacture. The examining attorney should examine the specimen(s) for information relevant to the *Morton-Norwich* factors, and conduct independent research of applicant's and competitors' websites, industry practice and standards, and legal databases such as Lexis/Nexis®. The examining attorney may also consult USPTO patent records.

It is not necessary to consider all the *Morton-Norwich* factors in every case. The Supreme Court held that "[w]here the design is functional under the *Inwood* formulation there is no need to proceed further to consider if there is a competitive necessity for the feature." *TrafFix Devices, Inc. v. Marketing Displays, Inc.,* 532 U.S. 23, 33, 58 USPQ2d 1001, 1006 (2001). Moreover, there is no requirement that all four of the *Morton-Norwich* factors weigh in favor of functionality to support a refusal. *See Valu Engineering,* 278 F.3d at 1276, 61 USPQ2d at 1427 ("once a product feature is found functional based on other considerations there is no need to consider the availability of alternative designs"); *In re UDOR U.S.A., Inc*., 89 USPQ2d 1978 (TTAB 2009)

(affirming a functionality refusal of "a round disk head on a sprayer nozzle" where the third and fourth factors showed that applicant's competitors manufactured and marketed spray nozzles with similar features, the shape was preferred in the industry, and it appeared efficient, economical, and advantageous, even though applicant's utility patent and advertising did not weigh in favor of functionality); *In re N.V. Organon,* 79 USPQ2d 1639 (TTAB 2006) (orange flavor found functional based on applicant's touting of the utilitarian advantages of the flavor and the lack of evidence of acceptable alternatives, even though the mark was not the subject of a patent or patent application and there was no evidence that the flavor affected the cost of the product); *In re Gibson Guitar Corp.,* 61 USPQ2d 1948 (TTAB 2001) (where there was no utility patent, and no evidence that applicant's guitar configuration resulted from a simpler or cheaper method of manufacture, these factors did not weigh in Board's decision).

Evidence that the proposed mark is the subject of a utility patent that discloses the utilitarian advantages of the configuration at issue can be sufficient in itself to support a functionality refusal. *TrafFix*, 532 U.S. at 33, 58 USPQ2d at 1007 ("There is no need, furthermore, to engage ... in speculation about other design possibilities"); *In re Howard Leight Industries, LLC*, 80 USPQ2d 1507, 1515 (TTAB 2006) ("[W]e find that applicant's expired utility patent, which specifically discloses and claims the utilitarian advantages of applicant's earplug configuration and which clearly shows that the shape at issue 'affects the . . . quality of the device,' is a sufficient basis in itself for finding that the configuration is functional, given the strong weight to be accorded such patent evidence under *TrafFix*."). *See* **TMEP §1202.02(a)(v)(A)** for further discussion of utility patents.

It is important that the functionality inquiry focus on the utility of the feature or combination of features claimed as protectable trade dress. *Morton-Norwich,* 671 F.2d at 1338, 213 USPQ at 13. Generally, dissecting the design into its individual features and analyzing the utility of each separate feature does not establish that the overall design is functional. *See* 15 U.S.C. §1052(e)(5); *Teledyne Industries Inc.*, 696 F.2d at 971, 217 USPQ at 11. However, it is sometimes helpful to analyze the design from the standpoint of its various features. *See Elmer v. ICC Fabricating Inc.*, 67 F.3d 1571, 1579-80, 36 USPQ2d 1417, 1422-23 (Fed. Cir. 1995) (rejecting the argument that the combination of individually functional features in the configuration resulted in an overall nonfunctional product design); *In re R.M. Smith, Inc.*, 734 F.2d 1482-1484, 222 USPQ 1, 2 (Fed. Cir. 1984) (affirming the functionality determination, where the Board had initially considered the six individual features of the design, and then had concluded that the design as a whole was functional); *American Flange & Mfg. Co., Inc. v. Rieke Corp*., 80 USPQ2d 1397 (TTAB 2006*)* (Board held that applicant's marks were functional overall where only one of the two features claimed was found to be functional); *In re Controls Corp. of America,* 46 USPQ2d 1308, 1312 (TTAB 1998) (finding the entire configuration at issue functional because it consisted of several individual features, each of which was functional in nature).

Where the evidence shows that the overall design is functional, the inclusion of a few arbitrary or otherwise nonfunctional features in the design will not change the result. *See Textron, Inc. v. U.S. Int'l Trade Commission*, 753 F.2d 1019, 1025, 224 USPQ 625, 628-29 (Fed. Cir. 1985); *In re Vico Products Mfg. Co., Inc.*, 229 USPQ 364, 368 (TTAB 1985).

In the limited circumstances where a proposed trade dress mark is not functional overall, but contains insignificant elements that are functional, the examining attorney must issue a requirement for an amended drawing and allow applicant to dot out the functional elements. *See* **TMEP §1202.02(c)(i)** regarding drawings in trade dress applications.

The question of whether a product feature is "functional" should not be confused with whether that product feature performs a "function" (i.e., it is *de facto* functional) or "fails to function" as a trademark. *See* **TMEP §1202.02(a)(iii)(B)** regarding *de facto* functionality. Usually, most objects perform a function, for example, a bottle holds liquid and a lamp provides light. However, only certain configurations are functional under §2(e)(5) based on the *Morton-Norwich* factors. *Morton-Norwich,* 671 F.2d at 1338, 213 USPQ at 13-14. Similarly, a product feature that is deemed not functional under §2(e)(5) may lack distinctiveness such that it fails to function as a trademark under §§1, 2, and 45. *See* **TMEP §§1202.02(b)** *et seq.* for distinctiveness of trade dress.

1202.02(a)(v)(A) Utility Patents and Design Patents

Utility Patents

Utility patents cover the invention or discovery of a new and useful process, machine, article of manufacture, or composition of matter, or any new and useful improvement thereof. 35 U.S.C. §101.

In *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 29-30, 58 USPQ2d 1001, 1005 (2001), the Supreme Court resolved a circuit split regarding the proper weight to be afforded a utility patent in the functionality determination, stating:

> A utility patent is strong evidence that the features claimed therein are functional. If trade dress protection is sought for those features the strong evidence of functionality based on the previous patent adds great weight to the statutory presumption that features are deemed functional until proved otherwise by the party seeking trade dress protection. Where the expired patent claimed the features in question, one who seeks to establish trade dress protection must

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> carry the heavy burden of showing that the feature is not functional, for instance by showing that it is merely an ornamental, incidental, or arbitrary aspect of the device.

See also In re Bose Corp., 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985); *In re Dietrich,* 91 USPQ2d 1622 (TTAB 2009); *In re UDOR U.S.A., Inc.*, 89 USPQ2d 1978 (TTAB 2009); *In re Visual Communications Co., Inc.,* 51 USPQ2d 1141 (TTAB 1999); *In re Edward Ski Products, Inc.,* 49 USPQ2d 2001 (TTAB 1999); *In re Caterpillar Inc.,* 43 USPQ2d 1335 (TTAB 1997).

The Court in *TrafFix* went on to hold that where the evidence includes a utility patent that claims the product features at issue, it is unnecessary to consider evidence relating to the availability of alternative designs:

> There is no need, furthermore, to engage, as did the Court of Appeals, in speculation about other design possibilities, such as using three or four springs which might serve the same purpose. Here, the functionality of the spring design means that competitors need not explore whether other spring juxtapositions might be used. The dual-spring design is not an arbitrary flourish in the configuration of MDI's product; it is the reason the device works. Other designs need not be attempted.

TrafFix, 532 U.S. at 23, 33-34, 58 USPQ2d at 1007 (citation omitted).

Therefore, when the examining attorney is presented with facts similar to those in *TrafFix* (i.e., where there is a utility patent establishing the utilitarian nature of the product design at issue), the examining attorney may properly issue a final functionality refusal based primarily on the utility patent. *In re Howard Leight Industries, LLC*, 80 USPQ2d 1507 (TTAB 2006). Where functionality appears to be an issue, in the first Office action, the examining attorney should ask the applicant to provide copies of any active, pending, or expired patent(s), and any pending or abandoned patent application(s). 37 C.F.R. §2.61(b). *See Valu Engineering,* 278 F.3d at 1279, 61 USPQ2d at 1429 (Fed. Cir. 2002) ("We agree with the Board that an abandoned patent application should be considered under the first Morton-Norwich factor, because an applied-for utility patent that never issued has evidentiary significance for the statements and claims made in the patent application concerning the utilitarian advantages, just as an issued patent has evidentiary significance.").

It is not necessary that the utility patent be owned by the applicant; a third-party utility patent is also relevant to the functionality determination, if the patent claims the features in the product design sought to be registered. *See Dietrich, supra*; *In re Virshup,* 42 USPQ2d 1403 (TTAB 1997); *In re American Nat'l Can Co.*, 41 USPQ2d 1841 (TTAB 1997); *In re Cabot Corp.*, 15 USPQ2d 1224 (TTAB 1990). Therefore, the examining attorney may also consult patent databases, including the USPTO's patent records, to see if utility patents owned by applicant's competitors disclose the functional advantages of the product design that the applicant seeks to register.

It is important to read the patent to determine whether the patent actually claims the features presented in the proposed mark. If it does, the utility patent is strong evidence that the particular product features claimed as trade dress are functional. If it does not, or if the features are referenced in the patent, but only as arbitrary or incidental features, then the probative value of the patent as evidence of functionality is substantially diminished or negated entirely. *TrafFix*, 532 U.S. at 34, 58 USPQ2d at 1007 (where a manufacturer seeks to protect arbitrary, incidental or ornamental aspects or features of a product found in the patent claims, such as arbitrary curves in the legs or an ornamental pattern painted on the springs, functionality will not be established if the manufacturer can prove that those aspects do not serve a purpose within the terms of utility patent); *In re UDOR U.S.A., Inc.*, 89 USPQ2d at 1980-82 (where a review of the patent's language and a detailed comparison between the identified features of the patent drawing with the visible features of the trademark drawing established that the patent claims involved components neither shown nor described in the trademark design, the Board determined that the utility patent did not support a finding of functionality); *see also Black & Decker Inc. v. Hoover Service Ctr*., 886 F.2d 1285, 12 USPQ2d 1250 (Fed. Cir. 1989); *In re Zippo Mfg. Co.*, 50 USPQ2d 1852 (TTAB 1999); *In re Weber-Stephen Products Co.*, 3 USPQ2d 1659 (TTAB 1987). Where a utility patent claims more than what is sought to be registered, this fact does not establish the non-functionality of the product design, if the patent shows that the part claimed as a trademark is an essential or integral part of the invention and has utilitarian advantages. *Cf. TrafFix,* 532 U.S. at 31, 58 USPQ2d at 1006.

The examining attorney should consider both the numbered claims and the disclosures in the written description, drawings, and abstract of the patent. In *Leight*, the Board found functionality based on both the claims and the disclosure. The Board rejected the applicant's argument that the examining attorney erred in looking to the claims made in applicant's patent, noting that the Supreme Court in *TrafFix* repeatedly referred to a patent's claims as evidence of functionality.

Statements regarding utilitarian advantages of the design made in the course of the prosecution of the patent application can also be very strong evidence of functionality. *TrafFix,* 532 U.S. at 32, 58 USPQ2d at 1006 ("These statements [regarding specific functional advantages of the product design] made in the patent applications and in the course of procuring the patents demonstrate the functionality of the design. MDI does not assert that any of these representations are mistaken or inaccurate, and this is further strong evidence of the functionality of the dual-spring design."); *M-5 Steel Mfg., Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086, 1096 (TTAB 2001).

The fact that the proposed mark is *not* the subject of a utility patent does not establish that the product feature is nonfunctional. *TrafFix,* 532 U.S. at 32, 58 USPQ2d at 1006; *In re Gibson Guitar Corp.,* 61 USPQ2d 1948, 1950 n.3, (TTAB 2001).

Design Patents

Design patents cover the invention of a new, original, and ornamental design for an article of manufacture. 35 U.S.C. §171. A design patent is a factor that weighs against a finding of functionality, because design patents by definition protect only ornamental and nonfunctional features. However, ownership of a design patent does not in itself establish that a product feature is nonfunctional, and can be outweighed by other evidence supporting the functionality determination. *In re R.M. Smith, Inc.*, 734 F.2d 1482, 1485, 222 USPQ 1, 3 (Fed. Cir. 1984); *Caterpillar Inc.*, 43 USPQ2d at 1339; *American Nat'l Can Co.*, 41 USPQ2d at 1843; *In re Witco Corp.*, 14 USPQ2d 1557, 1559 (TTAB 1989).

1202.02(a)(v)(B) Advertising, Promotional, or Explanatory Material in Functionality Determinations

The applicant's own advertising touting the utilitarian aspects of its product design or product packaging is often strong evidence supporting a functionality refusal. *See, e.g., In re N.V. Organon,* 79 USPQ2d 1639, 1645 (TTAB 2006) ("applicant's promotional materials touting the utilitarian advantages of the orange flavor, is particularly significant in assessing functionality in this case"); *American Flange & Mfg. Co., Inc. v. Rieke Corp*., 80 USPQ2d 1397 (TTAB 2006); *In re Gibson Guitar Corp.*, 61 USPQ2d 1948 (TTAB 2001); *M-5 Steel Mfg., Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086 (TTAB 2001); *In re Visual Communications Co., Inc.*, 51 USPQ2d 1141 (TTAB 1999); *In re Edward Ski Products, Inc.,* 49 USPQ2d 2001 (TTAB 1999); *In re Caterpillar Inc.,* 43 USPQ2d 1335 (TTAB 1997); *In re Bio-Medicus Inc.,* 31 USPQ2d 1254 (TTAB 1993); *In re Witco Corp.*, 14 USPQ2d 1557 (TTAB 1989).

An applicant will often assert that statements in its promotional materials touting the utilitarian advantages of the product feature are mere "puffery" and, thus, entitled to little weight in the functionality analysis. However, where the advertising statements clearly emphasize specific utilitarian features of the design claimed as a mark, the Board will reject such assertions of "puffing." *See, e.g., In re Gibson Guitar Corp., supra*; *Goodyear Tire and Rubber Co. v. Interco Tire Corp.*, 49 USPQ2d 1705, 1716-17 (TTAB 1998); *In re Bio-Medicus Inc.*, 31 USPQ2d 1254, 1260 (TTAB 1993); *In re Witco Corp.*, 14 USPQ2d 1557, 1559-61 (TTAB 1989).

In *Gibson Guitar*, the Board found the design of a guitar body to be functional, noting that applicant's literature clearly indicated that the shape of applicant's guitar produced a better musical sound. Applicant's advertisements stated that "[t]his unique body shape creates a sound which is much more balanced and less 'muddy' than other ordinary dreadnought acoustics." 61 USPQ2d at 1951.

Where functionality appears to be an issue, in the first Office action, the examining attorney should ask the applicant to provide any available advertising, promotional, or explanatory material concerning the goods/services, particularly any material specifically related to the features embodied in the proposed mark. 37 C.F.R. §2.61(b). The examining attorney should also examine the specimen(s), and check to see if the applicant has a website on which the product is advertised or described.

The examining attorney may also check the websites of applicant's competitors as well as industry and trade publications and computer databases to determine whether others offer similar designs and features or have written about the applicant's design and its functional features or characteristics. In *Gibson Guitar*, the record included an advertisement obtained from the website of a competitor whose guitar appeared to be identical in shape to applicant's configuration, touting the acoustical advantages of the shape of the guitar.

1202.02(a)(v)(C) Availability of Alternative Designs in Functionality Determinations

An applicant attempting to rebut a prima facie case of functionality will often submit evidence of alternative designs to demonstrate that there is no "competitive need" in the industry for the applicant's particular product design. *See* **TMEP §1202.02(a)(iii)(A).** In order to be probative, the alternative design evidence must pertain to the same category of goods as the applicant's goods. *See, e.g., In re Zippo Mfg. Co.*, 50 USPQ2d 1852, 1854 (TTAB 1999); *In re EBSCO Industries Inc.*, 41 USPQ2d 1917, 1920 (TTAB 1997).

However, in *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001 (2001), the Supreme Court clearly indicated that if the record shows that a design is essential to the use or purpose of a product, or if it affects the cost or quality of the product, it is unnecessary to consider whether there is a competitive need for the product feature. The Court explained:

> [W]e have said "in general terms, a product feature is functional, and cannot serve as a trademark, if it is essential to the use or purpose of the article or if it affects the cost or quality of the article." Expanding upon the meaning of this phrase, we have observed that a functional feature is one the "exclusive use of [which] would put competitors at a significant non-reputation-related disadvantage." The Court of Appeals in the instant case seemed to interpret this

> language to mean that a necessary test for functionality is "whether the particular product configuration is a competitive necessity." . . . This was incorrect as a comprehensive definition. As explained in *Qualitex*, *supra*, and *Inwood*, *supra*, a feature is also functional when it is essential to the use or purpose of the device or when it affects the cost or quality of the device . . . *Where the design is functional under the Inwood formulation there is no need to proceed further to consider if there is a competitive necessity for the feature*.
>
> * * *
>
> *There is no need, furthermore, to engage, as did the Court of Appeals, in speculation about other design possibilities*, such as using three or four springs which might serve the same purpose. Here, the functionality of the spring design means that *competitors need not explore whether other spring juxtapositions might be used*. The dual-spring design is not an arbitrary flourish in the configuration of MDI's product; it is the reason the device works. *Other designs need not be attempted* (emphasis added).

TrafFix, 532 U.S. at 32-34, 58 USPQ2d at 1006-1007 (citations and additional internal quotations omitted).

Nonetheless, since the preservation of competition is an important policy underlying the functionality doctrine, competitive need generally remains an important factor in a functionality determination. *See Valu Engineering, Inc. v. Rexnord Corp*., 278 F.3d 1268, 1277, 61 USPQ2d 1422, 1428 (Fed. Cir. 2002) ("[I]n determining 'functionality,' the Board must assess the effect registration of a mark would have on competition.").

Accordingly, examining attorneys should request information about alternative designs in the initial Office action, pursuant to 37 C.F.R. §2.61(b), i.e., inquire whether alternative designs are available for the feature embodied in the proposed mark, and whether the alternatives are more costly to produce.

Where the evidence indicates that the applicant's configuration is the best or one of a few superior designs available, this evidence will strongly support a finding of functionality. *See, e.g., In re Dietrich,* 91 USPQ2d 1622, 1636 (TTAB 2009); ("[T]he question is not whether there are alternative designs that perform the same basic function, but whether the available designs work 'equally well.'") (citation omitted); *In re N.V. Organon,* 79 USPQ2d 1639, 1645 (TTAB 2006); *In re Gibson Guitar Corp.,* 61 USPQ2d 1948 (TTAB 2001) (Board found that the applicant had not shown that there were alternative guitar shapes that could produce the same sound as applicant's configuration, noting that the record contained an advertisement obtained from the website of a competitor whose guitar appeared to be identical in shape to applicant's configuration, stating that the shape of the guitar produces a better sound).

A configuration of a product or its packaging that embodies a superior design feature and provides a competitive advantage to the user is functional. In *N.V. Organon,* 79 USPQ2d at 1649, the Board found that by masking the unpleasant taste of the medicinal ingredients in pharmaceuticals, "flavor performs a utilitarian function that cannot be monopolized without hindering competition in the pharmaceutical trade. To allow registration of 'an orange flavor' as a trademark would give applicant potentially perpetual protection for this flavor, resulting in hindrance of competition."

Functionality may be established by a single competitively significant application in the recited identification of goods, even if there is no anticompetitive effect in other areas of use, since competitors in that single area could be adversely affected. *Valu Engineering,* 278 F.3d at 1278, 61 USPQ2d at 1428 ("[I]f the Board identifies any competitively significant single use in the recited identification of goods for which the mark as a whole is functional, the Board should deny registration.").

If evidence shows the existence of a number of functionally equivalent alternative designs that work "equally well," such that competitors do not need applicant's design to compete effectively, this factor may not support functionality. *Dietrich*, 91 USPQ2d at 1636, citing *Valu Engineering,* 278 F.3d at 1276, 61 USPQ2d at 1428. However, once deemed functional under other *Morton-Norwich* factors, the claimed trade dress cannot be registered merely because there are functionally equivalent alternative designs. Existence of comparable alternative designs does not transform a functional design into a nonfunctional design. *Valu Engineering,* 278 F.3d at 1276, 61 USPQ2d at 1427.

1202.02(a)(v)(D) Ease or Economy of Manufacture in Functionality Determinations

A product feature is functional if it is essential to the use or purpose of the product *or if it affects the cost or quality of the product*. *Inwood Laboratories, Inc. v. Ives Laboratories, Inc*., 456 U.S. 844, 850 n.10, 214 USPQ 1, 4 n.10 (1982). Therefore, a showing that a product design or product packaging results from a comparatively simple or inexpensive method of manufacture will support a finding that the claimed trade dress is functional.

In many cases, there is little or no evidence pertaining to this factor. However, the examining attorney should still ask the applicant for information as to whether the subject design makes the product simpler or less costly to manufacture, since evidence on this issue weighs strongly in favor of a finding of functionality. 37 C.F.R. §2.61(b). *See, e.g., TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001 (2001); *In re Virshup,* 42 USPQ2d 1403 (TTAB 1997). Statements

pertaining to the cost or ease of manufacture may sometimes also be found in informational or advertising materials. *See M-5 Steel Mfg., Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086, 1097 (TTAB 2001) (statements in promotional material that applicant's design results in reduced installation costs found to be evidence of the functionality of applicant's configurations of metal ventilating ducts and vents for tile or concrete roofs).

While evidence showing that the product feature results from a comparatively simple or inexpensive method of manufacture supports a finding that the design is functional, the opposite is not necessarily the case. That is, assertions by the applicant that its design is more expensive or more difficult to make, or that the design does not affect the cost, will not establish that the configuration is not functional. *In re Dietrich,* 91 USPQ2d 1622, 1637 (TTAB 2009) ("Even at a higher manufacturing cost, applicant would have a competitive advantage for what is essentially, as claimed in the patents, a superior quality wheel."); *In re N.V. Organon,* 79 USPQ2d 1639 (TTAB 2006). Designs that work better or serve a more useful purpose may, indeed, be more expensive and difficult to produce.

1202.02(a)(vi) Aesthetic Functionality

"Aesthetic functionality" refers to situations where the feature may not provide a truly utilitarian advantage in terms of product performance, but provides other competitive advantages. For example, in *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994), *cert. denied,* 514 U.S. 1050 (1995), the Federal Circuit affirmed the Board's determination that the color black for outboard motors was functional because, while it had no utilitarian effect on the mechanical working of the engines, it nevertheless provided other identifiable competitive advantages – i.e., ease of coordination with a variety of boat colors and reduction in the apparent size of the engines.

The concept of "aesthetic functionality" (as opposed to "utilitarian functionality") has for many years been the subject of much confusion. While the Court of Customs and Patent Appeals (the predecessor to the Court of Appeals for the Federal Circuit) appeared to reject the doctrine of aesthetic functionality in *In re DC Comics, Inc.*, 689 F.2d 1042, 1047-1050, 215 USPQ 394, 399-401 (C.C.P.A. 1982), the Supreme Court later referred to aesthetic functionality as a valid legal concept in *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001 (2001). The confusion regarding aesthetic functionality stems in part from widespread misuse of the term "aesthetic functionality" in cases involving ornamentation issues, with some courts having mistakenly expanded the category of "functional" marks to include matter that is solely ornamental, essentially on the theory that such matter serves an "aesthetic function" or "ornamentation function." It is this incorrect use of the term "aesthetic functionality" in connection with ornamentation cases that was rejected by the Court of Customs and Patent Appeals. *See In re DC Comics, Inc.*, 689 F.2d 1042, 1047-1050, 215 USPQ 394, 397, 399-401 (C.C.P.A. 1982) (majority opinion and Rich, J., concurring) (holding, in a case involving features of toy dolls, that the Board had improperly "intermingled the concepts of utilitarian functionality and what has been termed 'aesthetic functionality;'" and rejecting the concept of aesthetic functionality where it is used as a substitute for "the more traditional source identification principles of trademark law," such as the ornamentation and functionality doctrines).

Where the issue presented is whether the proposed mark is ornamental in nature, it is improper to refer to "aesthetic functionality," because the doctrine of "functionality" is inapplicable to such cases. The proper refusal is that the matter is ornamental and, thus, does not function as a mark under §§1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127. *See* **TMEP §§1202.03** *et seq*. regarding ornamentation.

The Supreme Court's use of the term "aesthetic functionality" in the *TrafFix* case appears limited to cases where the issue is one of actual functionality, but where the nature of the proposed mark makes it difficult to evaluate the functionality issue from a purely utilitarian standpoint. This is the case with color marks and product features that enhance the attractiveness of the product. The color or feature does not normally give the product a truly utilitarian advantage (in terms of making the product actually perform better), but may still be found to be functional because it provides other real and significant competitive advantages and, thus, should remain in the public domain. *See Qualitex Co. v. Jacobson Products Co., Inc.,* 514 U.S. 159, 165, 34 USPQ2d 1161, 1163-1164 (1995) (stating that a product color might be considered functional if its exclusive use "would put competitors at a significant non-reputation-related disadvantage," even where the color was not functional in the utilitarian sense).

In *M-5 Steel Mfg., Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086 (TTAB 2001), the Board considered the proper use of the aesthetic functionality doctrine in connection with product designs for metal ventilating ducts and vents for tile or concrete roofs:

> This case seems to involve elements of both utilitarian and aesthetic functionality. Here, for example, there is evidence of utility in applicant's patent application, as well as statements touting the superiority of applicant's design in applicant's promotional literature, and statements that applicant's design results in reduced costs of installation. On the other hand, there is no question that applicant's roof designs which match the appearance of surrounding roof tiles are more pleasing in appearance because the venting tiles in each case are unobtrusive.

M-5 Steel, 61 USPQ2d at 1096. Citing extensively from the *TrafFix*, *Qualitex,* and *Brunswick* cases, the Board concluded that

the product designs were functional for a combination of utilitarian and aesthetic reasons. *M-5 Steel,* 61 USPQ2d at 1097.

Note that this type of functionality determination – while employed in connection with a normally "aesthetic" feature such as color – is a proper use of the functionality doctrine, necessitating a §2(e)(5) refusal where the evidence establishes that a color or other matter at issue provides identifiable competitive advantages and, thus, should remain in the public domain. This is the opposite of an ornamentation refusal, where the matter at issue serves no identifiable purpose other than that of pure decoration.

Generally speaking, examining attorneys should exercise caution in the use of the term "aesthetic functionality," in light of the confusion that historically has surrounded this issue. In most situations, reference to aesthetic functionality will be unnecessary, since a determination that the matter sought to be registered is purely ornamental in nature will result in an ornamentation refusal under §§1, 2, and 45, and a determination that the matter sought to be registered is functional will result in a functionality refusal under §2(e)(5). Use of the term "aesthetic functionality" may be appropriate in limited circumstances where the proposed mark presents issues similar to those involved in the *M-5 Steel* and *Brunswick* cases, *supra* – i.e., where the issue is one of true functionality under §2(e)(5), but where the nature of the mark makes the functionality determination turn on evidence of particular competitive advantages that are not necessarily categorized as "utilitarian" in nature. Any such use of the term "aesthetic functionality" should be closely tied to a discussion of specific competitive advantages resulting from use of the proposed mark at issue, so that it is clear that the refusal is properly based on the functionality doctrine and not on an incorrect use of "aesthetic functionality" to mean ornamentation.

See **TMEP §§1202.05** and **1202.05(b)** for additional discussion and case references regarding the functionality issue in connection with color marks.

1202.02(a)(vii) Functionality and Service Marks

Although rare in the context of service mark applications, examining attorneys are not foreclosed from refusing registration based on functionality. In *Duramax Marine, LLC v. R.W. Fernstrum & Co.*, 80 USPQ2d 1780 (TTAB 2006), the Board held that a two-dimensional design of a marine heat exchanger (commonly known as a "keel cooler"), was not functional for "manufacture of marine heat exchangers to the order and specification of others." It found "a significant difference between an application to register trade dress in the nature of product design as a mark for the product itself ... and an application to register a two-dimensional drawing that may look very much like such a product, but is used on labels, catalogs, brochures, and in various other ways as a mark for services;" and stated that "[t]he inquiry regarding functionality may need to be decidedly different" in cases involving a service mark.

The record showed that the keel cooler depicted in the proposed mark was "identical, or nearly so" to the depiction of a keel cooler in applicant's expired patent; that opposer and at least one other party had been marketing keel coolers very similar to the proposed mark; and that the design sought to be registered appeared in applicant's catalog of pre-manufactured keel coolers. The Board framed the question at issue as "whether any manufacturer of the formerly patented item should be free to utilize, in advertising its goods for sale, a realistic depiction of the item," and stated that:

> [W]e must balance against opposer's argument for the extension of existing case law on functionality [to] what is shown by the record to be long use of the keel cooler depiction by applicant in the manner of a logo. Further, opposer has not discussed whether, when custom manufacturing services are involved, we should still apply the *TrafFix* test for functionality (a three-dimensional product design is functional if it is "essential to the use or purpose of the product or if it affects the cost or quality of the product") to the product that results from purchasing the services, or whether the test should be adapted and focus on whether use of the two-dimensional design to be registered is essential to anyone who would provide the same service, or would, if unavailable, affect the cost or quality of the service.

80 USPQ2d at 1794, citing *TrafFix Devices, Inc. v. Marketing Displays, Inc.,* 532 U.S. 23, 58 USPQ2d 1001 (2001).

The Board held that opposer had failed to justify an extension of existing law to cover the circumstances of this case, but stated that its decision "does not foreclose the extension of *TrafFix* to service marks if circumstances in a future case warrant such an extension." *Id.* at 1794.

1202.02(a)(viii) Functionality and Non-Traditional Marks

In addition to product design and product packaging, the functionality doctrine has been applied to other non-traditional proposed marks, such as sound, color, and flavor, and the same *Morton-Norwich* analysis, discussed above, applies to these marks. *See, e.g., Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 1532, 32 USPQ2d 1120, 1123 (Fed. Cir. 1994), *cert. denied,* 514 U.S. 1050 (1995) (the color black for outboard motors deemed functional because it provided competitive advantages such as ease of coordination with a variety of boat colors and reduction in the apparent size of the engines); *In re Vertex Group LLC*, 89 USPQ2d 1694 (TTAB 2009) (affirming the refusal to register an alarm sound emitted by personal

security alarms in the normal course of operation); *Saint-Gobain Corp. v. 3M Co.*, 90 USPQ2d 1425, 1447 (TTAB 2007) (deep purple shade for coated abrasives held functional, the Board finding that coated abrasive manufacturers have a competitive need to be able to use various shades of purple, include applicant's shade; and that "[i]n the field of coated abrasives, color serves a myriad of functions, including color coding, and the need to color code lends support for the basic finding that color, including purple, is functional in the field of coated abrasives having paper or cloth backing."); *In re N.V. Organon,* 79 USPQ2d 1639, 1645 (TTAB 2006) (the flavor orange deemed functional for pharmaceuticals, where the evidence showed that the flavor served to mask the otherwise unpleasant taste of the medicine flavor); *see also Qualitex Co. v. Jacobson Products Co., Inc.,* 514 U.S. 159, 165, 34 USPQ2d 1161, 1163-1164 (1995) (stating that a product color might be considered functional if its exclusive use "would put competitors at a significant non-reputation-related disadvantage," even where the color was not functional in the utilitarian sense); **TMEP §1202.02(a)(vi)** (regarding aesthetic functionality and color marks).

Examining attorneys should also consider the functionality doctrine in relation to other types of non-traditional marks, such as scent. For example, an application to register scent for an air freshener or an application to register the sound of a ring tone for downloadable ring tones must be refused as functional, as the proposed marks is essential to the use or purpose of the goods. *Cf. Vertex Group*, 89 USPQ2d at 1703 (the Board found that the "ability of applicant's [security alarms] to emit a loud, pulsing sound is essential to their use or purpose" because the evidence showed that use of a loud sound as an alarm is important and that alternating sound pulses and silence is a "more effective way to use sound as an alarm than is a steady sound").

1202.02(b) Distinctiveness of Trade Dress

Regardless of whether a proposed trade dress mark is refused as functional under §2(e)(5), the examining attorney must also examine the mark for distinctiveness. Trade dress that is not inherently distinctive and that has not acquired distinctiveness under §2(f) must be refused registration. The statutory basis for the refusal of registration on the Principal Register on the ground that the trade dress is nondistinctive is 15 U.S.C. §§1051, 1052, and 1127.

In *Wal-Mart Stores, Inc. v Samara Bros., Inc*., 529 U.S. 205, 215, 54 USPQ2d 1065, 1069 (2000), the Supreme Court distinguished between two types of trade dress – product design and product packaging. If the trade dress falls within the category of "product design," it can never be inherently distinctive. *Id*. 529 U.S. at 212, 54 USPQ 1068 ("It seems to us that design, like color, is not inherently distinctive."). Moreover, the Court held that in close cases in which it is difficult to determine whether the trade dress at issue is product packaging or product design, "courts should err on the side of caution and classify ambiguous trade dress as product design, thereby requiring secondary meaning." *Id.* 529 U.S. at 215, 54 USPQ2d at 1070. *See In re Slokevage*, 441 F.3d 957, 78 USPQ2d 1395 (Fed. Cir. 2006). (*Note*: If the trade dress is functional, it cannot be registered despite acquired distinctiveness. *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 34, 58 USPQ2d 1001, 1007 (2001)).

A claim of acquired distinctiveness under §2(f) will not overcome a functionality refusal, but may overcome a nondistinctiveness refusal. For example, if the examining attorney issues a refusal on the basis that a product packaging mark is functional and, in the alternative, is nondistinctive, and the applicant asserts acquired distinctiveness in response, the examining attorney must maintain the previously issued functionality refusal, if appropriate, and determine whether the applicant's evidence would be sufficient to overcome the nondistinctiveness refusal, if the functionality refusal is ultimately reversed.

If the examining attorney fails to separately address the sufficiency of the applicant's evidence of acquired distinctiveness, this may be treated as a concession that the evidence would be sufficient to establish distinctiveness, if the mark is ultimately found not to be functional. *See In re Dietrich,* 91 USPQ2d 1622, 1625 (TTAB 2009), in which the Board held that an examining attorney had "effectively conceded that, assuming the mark is not functional, applicant's evidence is sufficient to establish that the mark had acquired distinctiveness," where the examining attorney rejected the applicant's §2(f) claim on the ground that applicant's bicycle wheel configuration was functional and thus unregistrable even under §2(f), but did not specifically address the sufficiency of the §2(f) evidence or the question of whether the mark would be registrable under §2(f), if it were ultimately found to be non-functional.

1202.02(b)(i) Distinctiveness and Product Design Trade Dress

A mark that consists of product design trade dress is never inherently distinctive and is not registrable on the Principal Register unless the applicant establishes that the mark has acquired distinctiveness under §2(f). *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210, 54 USPQ2d 1065, 1067 (2000). Features of a product's design can never be inherently distinctive and are registrable only upon a showing of secondary meaning. *Id.* at 213–14, 54 USPQ2d at 1069. The Supreme Court noted that product design almost invariably serves purposes other than source identification, and that consumers are aware that even the most unusual product design (such as a cocktail shaker shaped like a penguin) is intended not to identify the source, but to render the product itself more useful or appealing. *Id.*

In *all* applications seeking registration of a product design, the examining attorney must refuse registration on the ground that the proposed mark is not inherently distinctive unless the applicant claims that the mark has acquired distinctiveness under

§2(f) and includes sufficient evidence to show that the mark has acquired distinctiveness. The ground for refusal is that the proposed mark consists of a nondistinctive product design, and, thus, does not function as a mark under §§1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127. If the product design is not functional, the mark may be registered on the Supplemental Register, or, if the applicant shows that the product design has acquired distinctiveness, on the Principal Register under §2(f). *See* **TMEP §1202.02(a)** regarding functionality, **TMEP §§815** and **816** *et seq.* regarding the Supplemental Register, and **TMEP §§1212** *et seq*. regarding acquired distinctiveness.

In distinguishing between product packaging and product design trade dress, *Wal-Mart* instructs that in "close cases" courts should classify the trade dress as product design. *Id.*, 529 U.S. at 215, 54 USPQ2d at 1070. In addition, product design can consist of design features that are incorporated in the product and need not implicate the entire product. *See Wal-Mart*, 529 U.S. at 207, 213, 54 USPQ2d at 1066, 1069 (a "cocktail shaker shaped like a penguin" is product design, as is "a line of spring/summer one-piece seersucker outfits decorated with appliqués of hearts, flowers, fruits, and the like"); *In re Slokevage*, 441 F.3d 957, 78 USPQ2d 1395 (Fed. Cir. 2006) (trade dress for clothing consisting of a label with the words "FLASH DARE!" in a V-shaped background and cut-out areas located on each side of the label with the cut-out areas consisting of a hole in a garment and a flap attached to the garment with a closure device, held to be product design).

Applicants face a heavy burden in establishing distinctiveness in an application to register trade dress. *See Stuart Spector Designs,Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549 (TTAB 2009). A mere statement of five years' use is generally not sufficient. *In re Ennco Display Systems Inc.,* 56 USPQ2d 1279, 1284 (TTAB 2000). Further, a product design may become generic and, thus, cannot be registered regardless of an applicant's claim of acquired distinctiveness. *See Stuart Spector Designs*, 94 USPQ2d at 1555 (noting that "genericness may be found where the design is, at a minimum, so common in the industry that it cannot be said to identify a particular source."). *See* **TMEP §1212.02(i)** regarding acquired distinctiveness with respect to incapable matter.

For applications based on §1(b) of the Trademark Act, 15 U.S.C. §1051(b), the examining attorney must issue the nondistinctiveness refusal even if the applicant has not filed an allegation of use. *See* **TMEP §1202.02(d)** regarding intent-to-use applications.

1202.02(b)(ii) Distinctiveness and Product Packaging Trade Dress

Product packaging may be inherently distinctive but, if it is not, the examining attorney must refuse registration on the Principal Register on the ground that the proposed mark is nondistinctive trade dress under §§1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127, for trademark applications, or under §§1, 2, 3, and 45 of the Act, 15 U.S.C. §§1051, 1052, 1053, and 1127, for service mark applications.

In *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 54 USPQ2d 1065 (2000), the Supreme Court discussed the distinction between the trade dress at issue in *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 23 USPQ2d 1081 (1992), and the product design trade dress (designs for children's clothing) under consideration in *Wal-Mart*:

> *Two Pesos* unquestionably establishes the legal principle that trade dress can be inherently distinctive, but it does not establish that *product design* trade dress can be. *Two Pesos* is inapposite to our holding here because the trade dress at issue, the decor of a restaurant, seems to us not to constitute product *design*. It was either product packaging – which, as we have discussed, normally is taken by the consumer to indicate origin – or else some *tertium quid* that is akin to product packaging....

Wal-Mart, 529 U.S. at 215, 54 USPQ2d at 1069.

Thus, unlike product design trade dress, trade dress constituting product packaging may be inherently distinctive for goods or services and registrable on the Principal Register without a showing of acquired distinctiveness. However, the examining attorney should be mindful of the Supreme Court's admonishment that where there are close cases, trade dress should be classified as product design for which secondary meaning is always required. *Id*., 529 U.S. at 215, 54 USPQ2d at 1070.

"[A] mark is inherently distinctive if '[its] intrinsic nature serves to identify a particular source.'" *Id.* at 210, 54 USPQ2d at 1068 (citing *Two Pesos, Inc. v. Taco Cabana, Inc*., 505 U.S. 763, 768, 23 USPQ2d 1081, 1083 (1992)). The test for determining inherent distinctiveness set forth in *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 1344, 196 USPQ 289, 291 (C.C.P.A. 1977), although not applicable to product design trade dress, is still viable in the examination of product packaging trade dress. The examining attorney should consider the following *Seabrook* factors – whether the proposed mark is:

(1) a "common" basic shape or design;

(2) unique or unusual in the field in which it is used;

(3) a mere refinement of a commonly adopted and well-known form of ornamentation for a particular class of goods viewed

by the public as a dress or ornamentation for the goods;

(4) capable of creating a commercial impression distinct from the accompanying words.

Id. See also Yankee Candle Co. v. Bridgewater Candle Co., LLC, 259 F.3d 25, 59 USPQ2d 1720 (1st Cir. 2001) (trade dress for common elements of candle labels was nondistinctive product packaging for which insufficient evidence of acquired distinctiveness was shown; and evidence of acquired distinctiveness for trade dress comprised of label elements, candle holders, display systems, and candle containers was deemed insufficient); *Tone Bros., Inc. v. Sysco Corp.*, 28 F.3d 1192, 1205, 31 USPQ2d 1321, 1331 (Fed. Cir. 1994) (citing *Seabrook*); *In re Hudson News Co.*, 39 USPQ2d 1915, 1923 (TTAB 1996), *aff'd per curiam,* 114 F.3d 1207 (Fed. Cir. 1997) ("[f]or the 'blue motif' of a retail store to be registrable on the Principal Register without resort to Section 2(f), the trade dress would have to be immediately recognizable as a distinctive way of identifying the source of the store services."); *In re Brouwerij Bosteels*, __ USPQ2d ____, Ser. No. 77357895 (TTAB August 26, 2010) (product packaging trade dress in the nature of a beer glass and stand with wording and scrollwork would be perceived as a mere refinement of a commonly known glass and stand rather than an inherently distinctive indicator of source for the goods);*In re File*, 48 USPQ2d 1363, 1367 (TTAB 1998) (novel tubular lights used in connection with bowling alley services would be perceived by customers as "simply a refinement of the commonplace decorative or ornamental lighting ... and would not be inherently regarded as a source indicator."); *In re J. Kinderman & Sons Inc.*, 46 USPQ2d 1253, 1255 (TTAB 1998) ("... while the designs applicant seeks to register [the packaging for electric lights for Christmas trees] may be unique in the sense that we have no evidence that anyone else is using designs which are identical to them, they are nonetheless not inherently distinctive.").

For applications based on §1(b) of the Trademark Act, 15 U.S.C. §1051(b), unless the drawing, the description of the mark, and the examining attorney's search results are dispositive of the lack of distinctiveness without the need to consider a specimen, applications for product packaging trade dress generally will not be refused registration on the ground of nondistinctiveness until the applicant has filed an allegation of use. *See* **TMEP §1202.02(d).**

Regardless of the bases for filing, if a proposed product packaging mark is inherently distinctive, it may be registered on the Principal Register. *See In re Creative Beauty Innovations, Inc.*, 56 USPQ2d 1203 (TTAB 2000) (bottle configuration found inherently distinctive); *In re Fre-Mar Industries, Inc.*, 158 USPQ 364, 367 (TTAB 1968) ("[A]lthough the particular shape is a commonplace one for flashlights, it is nevertheless so unique and arbitrary as a container in the tire repair field that it may be inherently distinctive and, therefore, by reason of its shape alone, serve to identify applicant's goods and distinguish them from like goods of others."); *In re International Playtex Corp.*, 153 USPQ 377 (TTAB 1967) (container configuration having the appearance of an ice cream cone found inherently distinctive as a trademark for baby pants).

If a proposed product packaging mark is *not* inherently distinctive, the mark may be registered on either the Principal Register under §2(f), upon proof that the mark has acquired distinctiveness or secondary meaning, or on the Supplemental Register. Secondary meaning is acquired when the public views the primary significance of the product packaging as identifying the source of the product rather than the product itself. *Wal-Mart*, 529 U.S. at 211, 54 USPQ2d at 1068. In the following cases, the applicant's evidence was found to be sufficient to support a claim of acquired distinctiveness: *In re World's Finest Chocolate, Inc.*, 474 F.2d 1012, 177 USPQ 205 (C.C.P.A. 1973) (package design found to identify applicant's candy bars and distinguish them from those of others); *Ex parte Haig & Haig Ltd.*, 118 USPQ 229, 230 (Comm'r Pats. 1958) ("[The decree] recited that because of the original, distinctive and peculiar appearance of the 'Pinched Decanter' the brand of whiskey in such bottles had come to be known and recognized by the public, by dealers and by consumers; and that the whiskey contained in such bottles had come to be identified with the 'Pinched Decanter' in the minds of the public generally.").

The examining attorney must establish a prima facie case that the product packaging trade dress is not inherently distinctive. To meet this burden, the examining attorney must at a minimum, set forth a "'reasonable predicate' for its position of no inherent distinctiveness," for example, by introducing evidence that competitors use similar basic shapes and designs. The USPTO is an agency of limited resources, and as such, it cannot be expected to shoulder the burden of conducting market research. *In re Pacer Technology*, 338 F.3d 1348, 1351-1352, 67 USPQ2d 1629, 1632 (Fed. Cir. 2003) (design patents showing other adhesive container cap designs found sufficient to establish prima facie case that applicant's adhesive container cap was not inherently distinctive).

See **TMEP §§1212** *et seq*. regarding acquired distinctiveness and **TMEP §§815** and **816** *et seq*. regarding the Supplemental Register. In *In re Usher, S.A.*, 219 USPQ 920, 921 (TTAB 1983), the evidence of secondary meaning was insufficient. (The configuration of a package for mint candies was not functional but the package design was not shown to possess secondary meaning.).*See also In re Brouwerij Bosteels*, __ USPQ2d ____, Ser. No. 77357895 (TTAB August 26, 2010) (evidence of acquired distinctiveness for product packaging trade dress in the nature of a beer glass and stand was insufficient).

1202.02(c) Drawing and Description of Mark in Trade Dress Applications

Applicants often submit drawings and descriptions of marks depicting trade dress and containing matter that is: (1) not part of

the mark; (2) functional; (3) non-distinctive but capable; (4) inherently distinctive; or (5) any combination of these factors. To ensure proper examination, drawings and descriptions of these marks must accurately depict the mark the applicant intends to register.

If the drawing does not meet the requirements of 37 C.F.R. §2.52, the examining attorney must require the applicant to submit a substitute drawing and a substitute description of the mark. The examining attorney may require the applicant to provide additional information such as pictures of the goods, samples, or other relevant materials pursuant to 37 C.F.R. §2.61(b) to assist in assessing the accuracy and completeness of the drawing and in crafting a comprehensive description of the mark.

1202.02(c)(i) Drawings in Trade Dress Applications

Drawings of trade dress marks, including three-dimensional product design and product packaging, may not contain elements that are not a part of the mark. If the mark comprises the design of only a portion of a product or container, solid lines must be used in the drawing to show the elements of the product or container that are claimed as part of the mark, and broken or dotted lines must be used to indicate that portion of the product or container that is not claimed as part of the mark. 37 C.F.R. §2.52(b)(4); *see In re Water Gremlin Co.*, 635 F.2d 841, 208 USPQ 89 (C.C.P.A. 1980) (Court affirmed the functionality of a circular-shaped container for the goods and the requirement for an amended drawing to either delete the representation of the container from the drawing or show it in dotted lines); **TMEP §807.08.**

Additionally, broken or dotted lines must be used to indicate elements that are functional or that are included in the drawing merely to show the position of the claimed portion of the mark. The removal or deletion of functional matter that is claimed as a part of the mark is permitted and generally does not constitute a material alteration of the mark, regardless of the filing basis, if the functional matter is separable from the other elements in the mark. Since functional features are never capable of acquiring trademark significance and are unregistrable, much like informational matter, they are not part of the mark and generally may be removed or deleted from the drawing by showing them in broken or dotted lines. Doing so constitutes an amendment of the drawing rather than an amendment of the mark.

In the limited circumstance where a proposed trade dress mark is not functional overall, but contains insignificant elements that are functional, the examining attorney must issue a requirement for an amended drawing and allow the applicant to dot out the functional elements. *See* **TMEP §1202.02(a)(v)** regarding evidence and considerations regarding functionality determinations. The Office action must also indicate that *pending receipt of a proper amended drawing and mark description,* registration is refused because the applied-for mark includes elements that are functional. The statutory basis for refusal is 15 U.S.C. §1052(e)(5).

In such a case, disclaimer of the functional elements is not appropriate because they do not form a part of the mark and are not capable of functioning as a trademark. *See In re Famous Foods*, 217 USPQ 177 (TTAB 1983). A disclaimer states that the applicant does not claim exclusive rights to matter in the mark apart from the mark as a whole. This means that the applicant maintains rights in the disclaimed matter as part of its own mark. Therefore, with respect to three-dimensional trade dress marks, matter that is functional or intended to show placement only is not part of the mark and should not be disclaimed. Representations of certain non-distinctive but capable features of a mark may be disclaimed in the limited circumstance discussed below.

Since elements in the drawing shown in broken or dotted lines are not part of the mark, they are excluded from the examining attorney's consideration during any §2(d) (likelihood of confusion) analysis. *See In re Homeland Vinyl Products, Inc.*, 81 USPQ2d 1378, 1382 (TTAB 2006).

In rare instances where it is impractical to render certain elements of a mark in dotted or broken lines - for example, if those elements are proportionally so small as to render dotted lines illegible, or if dotted lines would result in an unclear depiction of the mark, then the applicant may use solid lines. However, the applicant must insert a statement into the description of the mark identifying these elements and declaring that these elements are not a part of the mark, and that they serve only to show the position of the mark on the goods, as appropriate.

Elements of the mark such as features of non-functional product packaging or product design or configuration that have acquired distinctiveness may appear in solid lines in the drawing as part of the mark. Such elements may be removed from the mark only if the removal thereof does not result in material alteration.

A photograph of the applied-for trade dress is acceptable as a drawing if it otherwise meets the drawing requirements (e.g., it does not contain extraneous, purely informational matter such as net weight, contents, or business addresses) and it fairly represents the mark. Note that, although the mark in a §66(a) application cannot be amended, the applicant must comply with the United States requirements regarding drawings of the mark, and an amendment of the drawing for the purpose of compliance with United States law will be accepted. **TMEP §1904.02(h).** Therefore, in §66(a) applications, amendments to delete extraneous matter from photographs, or amendments of drawings from photographs to illustrated renderings showing elements of the mark in dotted or broken lines, will be accepted and will not be considered a material alteration.

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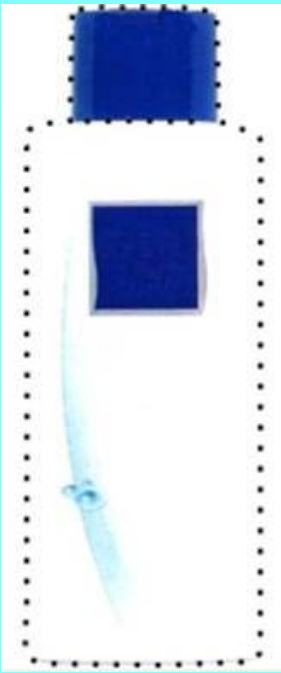
1202.02(c)(ii) Descriptions of Trade Dress Marks Required

Trade dress applications must include an accurate description of the mark. *See* 37 C.F.R. §2.37. If an acceptable statement describing the mark is not in the record, the examining attorney must require the applicant to submit a description to clarify what the applicant seeks to register. The description must adequately describe the mark, with unnecessary matter kept to a minimum. The description must clearly indicate that the mark is "three-dimensional" and constitutes a "design" or "configuration" of the goods themselves or "packaging" or "container" in which the goods are sold or the services offered. If applicable, the description must specify which elements in the drawing constitute the mark and are claimed as part of the mark and which are not. The description of the mark must make clear what any dotted or broken lines represent and include a statement that the matter shown in dotted or broken lines is not part of the mark. *See* 37 C.F.R. §2.52(b)(4); **TMEP §§808** *et seq*. The description must also avoid use of disclaimer-type language, such as "no claim is made to the …," because of the different legal significance of using broken lines versus submitting a disclaimer. *See* **TMEP §1202.02(c)(iii)** regarding disclaimers of unregistrable elements of trade dress marks.

During the prosecution of a trade dress application, if the applicant is required to submit an amended drawing (e.g., to delete functional matter by depicting it in broken or dotted lines), the examining attorney must also require a corresponding amended description.

Examples of acceptable language for this purpose are: "The broken lines depicting [describe elements] indicate placement of the mark on the goods and are not part of the mark" or "The dotted lines outlining [the goods] are intended to show the position of the mark on the goods and are not part of the mark."

For example, for the mark below,



an appropriate description (and color claim) of the mark could read:

> The colors white, blue, light blue, and silver are claimed as a feature of the mark. The mark consists of the color blue applied to the cap of the container of the goods, a white background applied to the rest of the container, a blue rectangle with a silver border, a light blue curving band, and three light blue droplets. The dotted lines outlining the container and its cap indicate placement of the mark on the goods and are not part of the mark.

For the mark below,

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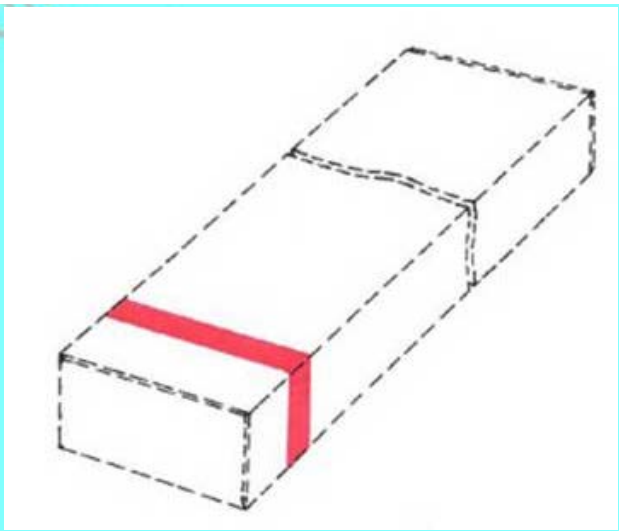

an appropriate description (and color claim) of the mark would read:

> The color red is claimed as a feature of the mark. The mark consists of a single transverse red stripe applied adjacent to one end of the elongated packaging for the goods. The dotted outline of the packaging is intended to show the position of the mark and is not part of the mark.

And for the mark below,

an appropriate description of the mark would read:

> The mark consists of a three-dimensional configuration of a stringed musical instrument body. The neck, peghead, and other instrument parts shown in broken lines serve to show positioning of the mark and form no part of the mark.

The examining attorney must ensure that the description statement has been entered into the Trademark Reporting and Monitoring ("TRAM") database, so that it will be printed in the *Official Gazette* and on the certificate of registration. *See* **TMEP §817.**

See **TMEP §§1202.05(d)(i)** and **(d)(ii)** regarding drawings in applications for color marks consisting solely of one or more colors.

1202.02(c)(iii) Disclaimers of Unregistrable Elements of Trade Dress Marks

Where the trade dress as a whole is registrable but contains elements that are not inherently distinctive (i.e., they are either capable of registration upon proof of acquired distinctiveness or incapable of acquiring trademark significance because, for example, they are generic), these elements generally must be disclaimed. *See* 15 U.S.C. §1056; **TMEP §1213** regarding disclaimers. Trade dress marks generally are not considered unitary, as each of the elements normally creates a separate commercial impression. As stated in the Federal Circuit decision *In re Slokevage*, 441 F.3d 957, 963, 78 USPQ2d 1395, 1400 (Fed. Cir. 2006), "[m]oreover, trade dress, by its nature, contains distinct elements and is characterized as the combination of various elements to create an overall impression." Although each element is combined with others to form one composite mark, each element retains its separate commercial impression.

If the mark consists of inherently distinctive elements combined with elements that are not inherently distinctive but are capable, and the applicant indicates that the capable matter is claimed as a part of the mark, then a disclaimer is appropriate.

See **TMEP §1212.02(e)** regarding disclaimers of unregistrable components in applications to register marks on the Principal Register under §2(f). *See also In re Creative Goldsmiths of Washington, Inc.*, 229 USPQ 766, 768 (TTAB 1986) ("[I]t is within the discretion of an Examining Attorney to require the disclaimer of an unregistrable component (such as a common descriptive, or generic, name) of a composite mark sought to be registered on the Principal Register under the provisions of Section 2(f).").

A disclaimer is not an appropriate means of addressing functional matter in a trade dress mark. Instead, an amendment of the drawing to depict the functional elements in broken or dotted lines should be required since functional matter is not part of the mark and is never capable of acquiring trademark significance. *See* **TMEP §1202.02(c)(i).**

Regarding disclaimers of unregistrable components in applications to register marks on the Supplemental Register, *see In re Water Gremlin Co.*, 635 F.2d 841, 845 n.6, 208 USPQ 89, 91 n.6 (C.C.P.A. 1980) ("Section 6 is equally applicable to the Supplemental Register."); *In re Wella Corp.*, 565 F.2d 143, 196 USPQ 7 (C.C.P.A. 1977) (mark comprising stylized lettering of BALSAM, with disclaimer of "BALSAM," found registrable on Supplemental Register for hair conditioner and hair shampoo); *In re Carolyn's Candies, Inc.*, 206 USPQ 356, 360 (TTAB 1980) ("Section 6 of the Trademark Act of 1946, which provides for the disclaimer of 'unregistrable matter', does not limit the disclaimer practice to marks upon the Principal Register.").

1202.02(c)(iv) Three-Dimensional Marks

In an application to register a mark with three-dimensional features, the applicant must submit a drawing that depicts the mark in a single rendition. 37 C.F.R. §2.52(b)(2). *See* **TMEP §807.10.** In order to accurately reflect the exact nature of the applied-for mark, the mark description must state that the mark is three-dimensional in nature. This feature of the mark must be shown in the supporting specimens of use for the drawing to comprise a substantially exact representation of the mark as actually used. Conversely, a three-dimensional specimen would not be acceptable to show use for a mark that is described or depicted as a two-dimensional mark. If the applicant believes it cannot adequately display its mark in a single rendition, it may petition the Director to waive the requirement and accept a drawing featuring multiple views of the mark. 37 C.F.R. §2.146(a)(5).

1202.02(d) Trade Dress in §1(b) Applications

Distinctiveness and Product Design

A product design trade dress mark can never be inherently distinctive and is registrable only upon a showing of secondary meaning. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 212, 54 USPQ2d 1065, 1068 (2000); *In re Slokevage*, 441 F.3d 957, 78 USPQ2d 1395 (Fed. Cir. 2006); **TMEP §1202.02(b)(i).** Therefore, if the mark is comprised of a product design, the examining attorney will refuse registration on the Principal Register on the ground that the proposed mark consists of a nondistinctive product design under §§1, 2, and 45 of the Trademark Act. 15 U.S.C. §§1051, 1052, and 1127. The examining attorney must make this refusal even in an intent-to-use application under 15 U.S.C. §1051(b) for which no allegation of use has been filed.

Distinctiveness and Product Packaging

If the mark comprises product packaging trade dress for goods or services, the examining attorney must determine whether the mark is inherently distinctive. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 54 USPQ2d 1065 (2000); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 23 USPQ2d 1081 (1992). This usually requires consideration of the context in which the mark is used and the impression it would make on purchasers. Generally, no refusal based on lack of inherent distinctiveness will be issued in an intent-to-use application under 15 U.S.C. §1051(b) until the applicant has submitted specimen(s) with an allegation of use. However, if appropriate, the examining attorney has discretion to issue this refusal before a specimen is submitted.

Functionality

To determine whether a proposed product design or product packaging trade dress mark is functional, the examining attorney must consider how the asserted mark is used. Generally, in a §1(b) application, the examining attorney will not issue a refusal on the ground that the mark is functional until the applicant has filed an allegation of use under §1(c) or §1(d), 15 U.S.C. §1051(c) or (d).

In a §1(b) application for which no specimen has been submitted, if the examining attorney's research indicates that a refusal based on functionality or nondistinctive trade dress will be made, the potential refusal should be brought to the applicant's attention in the first Office action issued by the USPTO. 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. If the functional nature of the mark is clearly apparent from the drawing, description of the mark, and research conducted by the examining attorney, without the need to await consideration of the specimen, a refusal based on functionality or nondistinctive trade dress may issue prior to the filing of the allegation of use.

1202.02(e) Trade Dress in §44 and §66(a) Applications

Distinctiveness and Product Design

A product design trade dress mark can never be inherently distinctive and is registrable only upon a showing of secondary meaning. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 212-213, 54 USPQ2d 1065, 1068-1069 (2000); *In re Slokevage*, 441 F.3d 957, 78 USPQ2d 1395 (Fed. Cir. 2006); **TMEP §1202.02(b)(i).** Therefore, if the proposed mark is comprised of a product design, the examining attorney must refuse registration on the Principal Register on the ground that the proposed mark consists of a nondistinctive product design under 15 U.S.C. §§1051, 1052, and 1127.

Distinctiveness and Product Packaging

If the mark comprises product packaging trade dress for goods or services, the examining attorney must determine whether the mark is inherently distinctive. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 54 USPQ2d 1065 (2000); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 23 USPQ2d 1081 (1992). *See* **TMEP §§1202.02(b)** *et seq*. regarding distinctiveness of trade dress. Because a specimen of use is not required prior to registration in these cases, it is appropriate for examining attorneys to issue the refusal where the mark on its face, as shown in the drawing and described in the description, reflects a lack of distinctiveness. *Cf. In re Right-On Co.*, 87 USPQ2d 1152, 1156-57 (TTAB 2008) (noting the propriety of and affirming an ornamentation refusal in a §66(a) application despite the lack of a specimen).

Functionality

If the application itself (i.e., the drawing, the description of the mark, and identification of goods/services) and/or the evidence uncovered during an independent search support that the proposed mark is functional, the examining attorney must issue a refusal of registration on the Principal Register under §2(e)(5). *See* **TMEP §§1202.02(a)** *et seq*. regarding functionality.

1202.03 Refusal on Basis of Ornamentation

Subject matter that is merely a decorative feature does not identify and distinguish the applicant's goods and, thus, does not function as a trademark. A decorative feature may include words, designs, slogans, or other trade dress. This matter should be refused registration because it is merely ornamentation and, therefore, does not function as a trademark as required by §§1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127.

Generally, the ornamentation refusal applies only to trademarks, not to service marks. *See* **TMEP §§1301.02** *et seq.* regarding matter that does not function as a service mark.

Matter that serves primarily as a source indicator, either inherently or as a result of acquired distinctiveness, and that is only incidentally ornamental or decorative, can be registered as a trademark. *In re Paramount Pictures Corp.*, 213 USPQ 1111 (TTAB 1982).

With regard to registrability, ornamental matter may be categorized along a continuum ranging from ornamental matter that is registrable on the Principal Register, to purely ornamental matter that is incapable of trademark significance and unregistrable under any circumstances, as follows:

(1) Ornamental matter that serves as an identifier of a "secondary source" is registrable on the Principal Register. For example, ornamental matter on a T-shirt (e.g., the designation "NEW YORK UNIVERSITY") can convey to the purchasing public the "secondary source" of the T-shirt (rather than the manufacturing source). Thus, even where the T-shirt is distributed by a party other than that identified by the designation, sponsorship, or authorization by the identified party is indicated. *See* **TMEP §1202.03(c).**

(2) Ornamental matter that is neither inherently distinctive nor a secondary source indicator may be registered on the Principal Register under §2(f), if the applicant establishes that the subject matter has acquired distinctiveness as a mark in relation to the goods. *See* **TMEP §1202.03(d).**

(3) Ornamental matter that is neither inherently distinctive nor an indicator of secondary source, and has not acquired distinctiveness, but is capable of attaining trademark significance, may be registered on the Supplemental Register in an application under §1 or §44 of the Trademark Act.

(4) Some matter is determined to be purely ornamental and, thus, incapable of trademark significance and unregistrable on either the Principal Register or the Supplemental Register. *See* **TMEP §1202.03(a).**

The examining attorney should consider the following factors to determine whether ornamental matter can be registered: (1) the commercial impression of the proposed mark; (2) the relevant practices of the trade; (3) secondary source, if applicable; and (4) evidence of distinctiveness. These factors are discussed in the following sections.

1202.03(a) Commercial Impression

The examining attorney must determine whether the overall commercial impression of the proposed mark is that of a trademark. Matter that is purely ornamental or decorative does not function as a trademark and is unregistrable on either the Principal Register or the Supplemental Register.

The significance of the proposed mark is a factor to consider when determining whether ornamental matter serves a trademark function. Common expressions and symbols (e.g., the peace symbol, “smiley face,” or the phrase “Have a Nice Day”) are normally not perceived as marks.

The examining attorney must also consider the size, location, and dominance of the proposed mark, as applied to the goods, to determine whether ornamental matter serves a trademark function. *In re Dimitri’s Inc.*, 9 USPQ2d 1666, 1667 (TTAB 1988); *In re Astro-Gods Inc.*, 223 USPQ 621, 623 (TTAB 1984). A small, neat, and discrete word or design feature (e.g., small design of animal over pocket or breast portion of shirt) may be likely to create the commercial impression of a trademark, whereas a larger rendition of the same matter emblazoned across the front of a garment (or a tote bag, or the like) may be likely to be perceived merely as a decorative or ornamental feature of the goods. However, a small, neat, and discrete word or design feature will not necessarily be perceived as a mark in all cases.

1202.03(b) Practices of the Trade

In determining whether a proposed mark is inherently distinctive, factors to be considered include whether the subject matter is unique or unusual in a particular field, as opposed to a mere refinement of a commonly adopted and well-known form of ornamentation for a particular class of goods that would be viewed by the public as a dress or ornamentation for the goods. *See, e.g., In re General Tire & Rubber Co.*, 404 F.2d 1396, 160 USPQ 415 (C.C.P.A. 1969) (three narrow white concentric rings of approximately equal width applied to the outer surface of a dark sidewall tire); *In re Chung, Jeanne & Kim Co., Inc.*, 226 USPQ 938 (TTAB 1985) (stripe design applied to sides of sport shoes).

Even if a proposed mark is not inherently distinctive, it may be registered on the Principal Register if it has become distinctive of the applicant’s goods in commerce. *See* **TMEP §1202.03(d).** The practices of the trade may be relevant in assessing the applicant’s burden of proving that the proposed mark has become distinctive. Typically, more evidence is required if the proposed mark is a type of ornamental matter used so frequently in the relevant industry that consumers would be less apt to discern a source-indicating significance from its use. *See Anchor Hocking Glass Corp. v. Corning Glass Works*, 162 USPQ 288 (TTAB 1969) (cornflower design recognized as a trademark for coffee percolators and culinary vessels and utensils). *Cf. In re Villeroy & Boch S.A.R.L.*, 5 USPQ2d 1451, 1454 (TTAB 1987) (affirming refusal to register design of morning glories and leaves for tableware, the Board noting that the design “has not been shown to be other than another decorative pattern without trademark significance....”).

If the applicant cannot show that the proposed mark has acquired distinctiveness, the mark in an application under §1 or §44 of the Trademark Act may be registered on the Supplemental Register if it is capable of distinguishing the applicant’s goods or services. 15 U.S.C. §1091. The practices of the trade may be relevant in determining whether a proposed mark is capable of distinguishing the goods or services. If the practices of the trade suggest that certain matter performs the function of a trademark by signifying to purchasers and prospective purchasers the goods of a particular entity and distinguishing them from the goods of others, the matter is assumed to be capable of distinguishing the applicant’s goods and, therefore, may be registered on the Supplemental Register. *See In re Todd Co., Inc.*, 290 F.2d 597, 129 USPQ 408 (C.C.P.A. 1961) (repeating pattern of green lines, used to cover the entire back surface of safety paper products (e.g., checks), held registrable on the Supplemental Register for safety paper products, where the record showed that it had long been the practice in the industry to use distinctive overall surface designs to indicate origin of the products).

1202.03(c) “Secondary Source”

To show that a proposed mark that is used on the goods in a decorative or ornamental manner also serves a source-indicating function, the applicant may submit evidence that the proposed mark would be recognized as a mark through its use with goods or services other than those being refused as ornamental. To show secondary source, the applicant may show: (1) ownership of a U.S. registration on the Principal Register of the same mark for other goods or services based on use in commerce under §1 of the Trademark Act; (2) non-ornamental use of the mark in commerce on other goods or services; or (3) ownership of a pending use-based application for the same mark, used in a non-ornamental manner, for other goods or services. Ownership of an intent-to-use application for which no allegation of use has been filed is not sufficient to show secondary source. If the applicant establishes that the proposed mark serves as an identifier of a secondary source, the matter is registrable on the Principal Register.

See In re Paramount Pictures Corp., 213 USPQ 1111 (TTAB 1982), in which MORK & MINDY was held registrable for decals, because applicant had a television series of that name and had previously registered MORK & MINDY for various goods and services. The Board found that the *primary* significance of the term MORK & MINDY to a prospective purchaser of decals was

to indicate the television series and the principal characters of the television series. *Id.* at 1112. The Board held that the case was controlled by its decision in *In re Olin Corp.*, 181 USPQ 182 (TTAB 1973) (stylized "O" design registrable for T-shirts, where applicant had previously registered the "O" design for skis), in which that Board had stated:

> It is a matter of common knowledge that T-shirts are "ornamented" with various insignia ... or … various sayings such as "Swallow Your Leader." In that sense what is sought to be registered could be construed to be ornamental. If such ornamentation is without any meaning other than as mere ornamentation it is apparent that the ornamentation could not and would not serve as an indicia of source. Thus, to use our own example, "Swallow Your Leader" probably would not be considered as an indication of source.
>
> The "ornamentation" of a T-shirt can be of a special nature which inherently tells the purchasing public the source of the T-shirt, not the source of manufacture but the secondary source....

181 USPQ at 182.

In *Paramount*, applying the test set forth in *Olin*, the Board found that "the paired names 'MORK & MINDY,' while certainly part of the ornamentation of the decal, also indicate source or origin in the proprietor of the Mork & Mindy television series in the same sense as the stylized 'O' in Olin." 213 USPQ at 1113. The Board noted that "while purchasers may be accustomed to seeing characters' names and images as part of the ornamentation of decals, T-shirts and the like, they are also accustomed to seeing characters' names and images used as trademarks to indicate source ...." *Id.* at 1114.

See also In re Watkins Glen Int'l, Inc., 227 USPQ 727 (TTAB 1985) (stylized checkered flag design registrable for patches and clothing items, where applicant had previously registered WATKINS GLEN and checkered flag design (with "WATKINS GLEN" disclaimed) for services); *In re Expo '74*, 189 USPQ 48 (TTAB 1975) (EXPO '74 registrable for handkerchiefs and T-shirts, where applicant, organizer of the 1974 World's Fair, had previously registered EXPO '74 for other goods and services).

A series of ornamental uses of the subject matter on various items will not establish that the subject matter functions as an indicator of secondary source; use as a trademark for the other goods or services must be shown. *See In re Astro-Gods Inc.*, 223 USPQ 621 (TTAB 1984) (refusal to register ASTRO GODS and design for T-shirts affirmed, despite applicant's ornamental use of the proposed mark on other goods and appearance of applicant's trade name "Astro Gods Inc." on the T-shirt as part of a copyright notice).

1202.03(d) Evidence of Distinctiveness

As noted above, even if a proposed mark is not inherently distinctive, it may nevertheless be registered on the Principal Register under §2(f), 15 U.S.C. §1052(f), if it becomes distinctive of the applicant's goods in commerce. *See* **TMEP §§1212** *et seq*. regarding acquired distinctiveness.

Generally, evidence of five years' use alone is not sufficient to show acquired distinctiveness of a mark that is mere ornamentation. Concrete evidence that the mark is perceived as a mark for the relevant goods or services is required to establish distinctiveness. *See In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985).

1202.03(e) Ornamentation with Respect to §1(b), §44, and §66(a) Applications

Generally, the issue of ornamentation is tied to the use of the mark as evidenced by the specimen. Therefore, unless the ornamental nature of the mark is clearly apparent from the drawing and description of the mark, no ornamentation refusal will be issued in an intent-to-use application until the applicant has submitted specimen(s) of use with an allegation of use under §1(c) or §1(d), 15 U.S.C. §1051(c) or (d).

In an application under §44 or §66(a), where a specimen of use is not required prior to registration, it is appropriate for examining attorneys to issue an ornamentation refusal where the mark on its face, as shown in the drawing and described in the description, reflects a failure to function. *In re Right-On Co.*, 87 USPQ2d 1152, 1156-57 (TTAB 2008) (noting the propriety of and affirming an ornamentation refusal in a §66(a) application).

1202.03(f) Ornamentation: Case References

The following cases show the various ways in which ornamental matter was found not to function as a mark.

1202.03(f)(i) Slogans or Words Used on the Goods

Slogans or phrases used on items such as t-shirts and sweatshirts, jewelry, and ceramic plates have been refused registration as ornamentation that purchasers will perceive as conveying a message rather than indicating the source of the goods. *See Damn I'm Good Inc. v. Sakowitz, Inc.*, 514 F. Supp. 1357, 212 USPQ 684 (S.D.N.Y. 1981) ("DAMN I'M GOOD," inscribed in large letters on bracelets and used on hang tags affixed to the goods, found to be without any source-indicating significance);

In re Pro-Line Corp., 28 USPQ2d 1141 (TTAB 1993) (BLACKER THE COLLEGE SWEETER THE KNOWLEDGE primarily ornamental slogan that is not likely to be perceived as source indicator); *In re Dimitri's Inc.*, 9 USPQ2d 1666 (TTAB 1988) ("SUMO," as used in connection with stylized representations of sumo wrestlers on applicant's T-shirts and baseball-style caps serves merely as an ornamental feature of applicant's goods); *In re Astro-Gods Inc.*, 223 USPQ 621, 624 (TTAB 1984) ("[T]he designation 'ASTRO GODS' and design is not likely to be perceived as anything other than part of the thematic whole of the ornamentation of applicant's shirts."); *In re Original Red Plate Co.*, 223 USPQ 836 (TTAB 1984) ("YOU ARE SPECIAL TODAY" for ceramic plates found to be without any source-indicating significance).

See also **TMEP §1202.04** regarding informational matter.

1202.03(f)(ii) Designs Used on the Goods

See In re General Tire & Rubber Co., 404 F.2d 1396, 160 USPQ 415 (C.C.P.A. 1969) (three narrow white concentric rings of approximately equal width applied to the outer surface of a dark sidewall tire considered just a refinement of a general ornamental concept rather than a trademark); *In re David Crystal, Inc.*, 296 F.2d 771, 132 USPQ 1 (C.C.P.A. 1961) (two parallel colored bands at the top of the sock, the upper band red, and the lower band blue, for men's ribbed socks held merely ornamental absent convincing evidence that the purchasing public recognized the design as a trademark); *In re Sunburst Products, Inc.,* 51 USPQ2d 1843 (TTAB 1999) (combination of matching color of watch bezel and watch band and contrasting colors of watch case and watch bezel for sports watches found to be nothing more than a mere refinement of a common or basic color scheme for sports watches and, therefore, would not immediately be recognized or perceived as a source indicator); *In re Villeroy & Boch S.A.R.L.*, 5 USPQ2d 1451 (TTAB 1987) (floral pattern design of morning glories and leaves for tableware not distinctive and not shown to be other than decorative pattern without trademark significance).

1202.03(f)(iii) Trade Dress on the Containers for the Goods

See In re J. Kinderman & Sons Inc., 46 USPQ2d 1253 (TTAB 1998) (design of container for Christmas decorations that resembles a wrapped Christmas gift not inherently distinctive); *In re F.C.F. Inc.,* 30 USPQ2d 1825 (TTAB 1994) (rose design used on cosmetics packaging is essentially ornamental or decorative background and does not function as mark); *In re Petersen Mfg. Co.*, 2 USPQ2d 2032 (TTAB 1987) (design representing the rear panel of a container for hand tools held unregistrable as merely ornamental, notwithstanding §2(f) claim).

1202.03(g) Ornamentation Cases and Acquired Distinctiveness

In the following cases, subject matter sought to be registered was found to have acquired distinctiveness as a trademark: *In re Jockey Int'l, Inc*., 192 USPQ 579 (TTAB 1976) (inverted Y design used on underwear found to have acquired distinctiveness, where evidence showed extensive use on packaging and in advertising in a manner calculated to draw the attention of prospective purchasers to the design and for them to look at the design as a badge of origin); *Anchor Hocking Glass Corp. v. Corning Glass Works*, 162 USPQ 288 (TTAB 1969) (blue cornflower design for coffee percolators and culinary vessels and utensils found to have acquired distinctiveness, where evidence showed extensive and prominent use of the design in advertising, use of the design on pins and aprons worn by sales promotion representatives in the course of their duties, and surveys and statements of purchasers indicating that they recognized the design as indicating origin in applicant).

1202.04 Informational Matter

Slogans and other terms that are considered to be merely informational in nature, or to be common laudatory phrases or statements that would ordinarily be used in business or in the particular trade or industry, are not registrable. *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (THE BEST BEER IN AMERICA so highly laudatory and descriptive as applied to beer and ale that it is incapable of acquiring distinctiveness); *In re T.S. Designs, Inc.,* 95 USPQ2d 1669 (TTAB 2010) ((holding CLOTHING FACTS informational based on the likely consumer perception of the phrase, when used on a clothing label, in connection with manufacturing information); *In re Aerospace Optics, Inc.*, 78 USPQ2d 1861 (TTAB 2006) (SPECTRUM fails to function as a mark for illuminated pushbutton switches, where the mark is used in a manner that merely informs the potential purchaser of the multiple color feature of the goods, and the coloring and font in which the proposed mark is displayed are not sufficient to imbue the term with source-identifying significance or to set it apart from other informational wording); *In re Volvo Cars of North America Inc.,* 46 USPQ2d 1455 (TTAB 1998) (DRIVE SAFELY perceived as an everyday, commonplace safety admonition that does not function as mark); *In re Manco Inc.*, 24 USPQ2d 1938, 1942 (TTAB 1992) (THINK GREEN and design found unregistrable for weatherstripping and paper products, the Board stating, "[R]ather than being regarded as an indicator of source, the term 'THINK GREEN' would be regarded simply as a slogan of environmental awareness and/or ecological consciousness ...."); *In re Southbrook Entertainment Corp.,* 8 USPQ2d 1166 (TTAB 1988) (HI-YO-SILVER for videotapes and cassettes held to be a well known expression closely linked to a character that did not function as a trademark for the goods); *In re Remington Products Inc.*, 3 USPQ2d 1714 (TTAB 1987) (PROUDLY MADE IN USA, for electric shavers, held incapable of functioning as a mark, notwithstanding use of letters "TM" in connection with prominent display of slogan on packages for the goods and claim of acquired distinctiveness); *In re Tilcon Warren, Inc.*, 221 USPQ 86 (TTAB 1984)

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(WATCH THAT CHILD held not to function as a mark for construction material notwithstanding long use, where the only use was on the bumpers of construction vehicles in which the goods were transported); *In re Schwauss,* 217 USPQ 361 (TTAB 1983) (FRAGILE used on labels and bumper stickers does not function as a mark).

A slogan can function as a trademark if it is not merely descriptive or informational. *See e.g., Roux Laboratories, Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34 (C.C.P.A. 1970) (affirming the Board's dismissal of an opposition to the registration of HAIR COLOR SO NATURAL ONLY HER HAIRDRESSER KNOWS FOR SURE for a hair coloring preparation); *In re The Hallicrafters Co.*, 153 USPQ 376 (TTAB 1967) (QUALITY THROUGH CRAFTSMANSHIP found registrable for radio equipment). *See* **TMEP §1202.03(f)(i)** regarding ornamental slogans used on goods.

See **TMEP §1301.02(a)** regarding informational matter that does not function as a service mark.

1202.05 Color as a Mark

Color marks are marks that consist *solely* of one or more colors used on particular objects. For marks used in connection with goods, the color may be used on the entire surface of the goods, on a portion of the goods, or on all or part of the packaging for the goods. For example, a color trademark might consist of purple used on a salad bowl, pink used on the handle of a shovel, or a blue background and a pink circle used on all or part of a product package. *See Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 34 USPQ2d 1161 (1995) (green-gold used on dry cleaning press pads held to be a protectible trademark, where the color had acquired secondary meaning); *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985) (the color pink as applied to fibrous glass residential insulation registrable where the evidence showed the color had acquired secondary meaning). Similarly, service marks may consist of color used on all or part of materials used in the advertising and rendering of the services.

The registrability of a color mark depends on the manner in which the proposed mark is used. *Owens-Corning,* 774 F.2d at 1120, 227 USPQ at 419. A color(s) takes on the characteristics of the object or surface to which it is applied, and the commercial impression of a color will change accordingly. *See In re Thrifty, Inc.,* 274 F.3d 1349, 1353, 61 USPQ2d 1121, 1124 (Fed. Cir. 2001) ("a word mark retains its same appearance when used on different objects, but color is not immediately distinguishable as a service mark when used in similar circumstances").

Color marks are never inherently distinctive, and cannot be registered on the Principal Register without a showing of acquired distinctiveness under §2(f) of the Trademark Act, 15 U.S.C. §1052(f). *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 211-212, 54 USPQ2d 1065, 1068 (2000). *See* **TMEP §1202.05(a)** and cases cited therein.

Color, whether a single overall color or multiple colors applied in a specific and arbitrary fashion, is usually perceived as an ornamental feature of the goods or services. *Owens-Corning,* 774 F.2d at 1124, 227 USPQ at 422; *In re Hudson News Co.*, 39 USPQ2d 1915, 1923 (TTAB 1996), *aff'd per curiam,* 114 F.3d 1207 (Fed. Cir. 1997) ("blue motif" used in retail stores would likely be perceived by prospective purchasers as "nothing more than interior decoration" that "could be found in any number of retail establishments. Undoubtedly such features are usually perceived as interior decoration or ornamentation.") However, color can function as a mark if it is used in the manner of a trademark/service mark and if it is perceived by the purchasing public to identify and distinguish the goods or services on or in connection with which it is used and to indicate their source. The United States Supreme Court has held that color alone may, sometimes, meet the basic legal requirements for a trademark. When it does, there is no rule that prevents color from serving as a mark. *Qualitex,* 514 U.S. at 161, 34 USPQ2d at 1162. If a color is not functional and is shown to have acquired distinctiveness on or in connection with the applicant's goods or services, it is registrable as a mark.

Functional color marks are not registrable. *See* **TMEP §1202.05(b)** and cases cited therein.

1202.05(a) Color Marks Never Inherently Distinctive

Color marks are never inherently distinctive. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 211-212, 54 USPQ2d 1065, 1068 (2000) (citing *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 162-163, 34 USPQ2d 1161, 1162-1163 (1995)); *In re Thrifty, Inc.,* 274 F.3d 1349, 1353, 61 USPQ2d 1121, 1124 (Fed. Cir. 2001). Therefore, the examining attorney must refuse to register a color mark on the Principal Register, unless the applicant establishes that the mark has acquired distinctiveness under §2(f). The examining attorney must issue this refusal in *all* color mark applications where acquired distinctiveness has not been shown, regardless of the filing basis of the application. The ground for refusal is that the color is not inherently distinctive and, thus, does not function as a trademark under §§1, 2, and 45, or does not function as a service mark under §§1, 2, 3, and 45.

If the proposed color mark is not functional, it may be registrable on the Principal Register if it is shown to have acquired distinctiveness under §2(f). If it is not distinctive, it is registrable only on the Supplemental Register. *See In re Hudson News Co.*, 39 USPQ2d 1915 (TTAB 1996), *aff'd per curiam,* 114 F.3d 1207 (Fed. Cir. 1997) ("blue motif" applied to retail store services not registrable on Principal Register without resort to Section 2(f)); *Edward Weck Inc. v. IM Inc.*, 17 USPQ2d 1142

(TTAB 1990) (the color green, as uniformly applied to medical instruments, not barred from registration on the basis of functionality; however, evidence failed to establish that the color had become distinctive of the goods); *In re Deere & Co.*, 7 USPQ2d 1401 (TTAB 1988) (the colors green and yellow, as applied to the body and wheels of machines, respectively, not barred from registration on the basis of functionality; evidence held to establish that the colors had become distinctive of the goods).

The burden of proving that a color mark has acquired distinctiveness is substantial. *See In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985) (the color pink, as uniformly applied to fibrous glass residential insulation, shown to have acquired distinctiveness as a trademark for the goods); *In re Benetton Group S.p.A.,* 48 USPQ2d 1214 (TTAB 1998) (evidence insufficient to establish that green rectangular background design had acquired distinctiveness as applied to clothing and footwear); *In re American Home Products Corp.*, 226 USPQ 327 (TTAB 1985) (tri-colored, three-dimensional, circular-shaped design found to have become distinctive of analgesic and muscle relaxant tablets); *In re Star Pharmaceuticals, Inc.*, 225 USPQ 209 (TTAB 1985) (evidence found insufficient to establish that two-colored drug capsules and multi-colored seeds or granules contained therein had become distinctive of methyltestosterone). A mere statement of long use is not sufficient. The applicant must demonstrate that the color has acquired source-indicating significance in the minds of consumers.

As noted above, the commercial impression of a color may change depending on the object to which it is applied. Therefore, evidence submitted to demonstrate acquired distinctiveness of a color may show consumer recognition with respect to certain objects, but not for other objects. *See Thrifty,* 61 USPQ2d at 1124. *Cf. Qualitex*, 514 U.S. at 163, 34 USPQ2d at 1162-1163 ("The imaginary word 'Suntost,' or the words 'Suntost Marmalade,' on a jar of orange jam immediately would signal a brand or a product 'source'; the jam's orange color does not do so. But, over time, customers may come to treat a particular color on a product or its packaging (say, a color that in context seems unusual, such as pink on a firm's insulating material or red on the head of a large industrial bolt) as signifying a brand. And, if so, that color would have come to identify and distinguish the goods – *i. e.*, 'to indicate' their 'source...'").

1202.05(b) Functional Color Marks Not Registrable

A color mark is not registrable on the Principal Register under §2(f), or the Supplemental Register, if the color is functional. *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994), *cert. denied,* 514 U.S. 1050 (1995); *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985). A color may be functional if it yields a utilitarian or functional advantage, for example, yellow or orange for safety signs. *Saint-Gobain Corp. v. 3M Co.*, 90 USPQ2d 1425, 1447 (TTAB 2007) (deep purple shade for coated abrasives held functional, the Board finding that opposer had established a prima facie case that coated abrasive manufacturers have a competitive need to be able to use various shades of purple, include applicant's shade, which applicant had failed to rebut; and that "[i]n the field of coated abrasives, color serves a myriad of functions, including color coding, and the need to color code lends support for the basic finding that color, including purple, is functional in the field of coated abrasives having paper or cloth backing."); *Brunswick Corp. v. British Seagull, supra* (holding the color black functional for outboard motors because while the color did not provide utilitarian advantages in terms of making the engines work better, it nevertheless provided recognizable competitive advantages in terms of being compatible with a wide variety of boat colors and making the engines appear smaller); *In re Ferris Corp.,* 59 USPQ2d 1587 (TTAB 2000) (color pink used on surgical wound dressings is functional because the actual color of the goods closely resembles Caucasian human skin); *In re Orange Communications, Inc.*, 41 USPQ2d 1036 (TTAB 1996) (colors yellow and orange held to be functional for public telephones and telephone booths, since they are more visible under all lighting conditions in the event of an emergency); *In re Howard S. Leight & Associates Inc.*, 39 USPQ2d 1058 (TTAB 1996) (color coral held to be functional for earplugs, because it is more visible during safety checks). A color may also be functional if it is more economical to manufacture or use. For example, a color may be a natural by-product of the manufacturing process for the goods. In such a case, appropriation of the color by a single party would place others at a competitive disadvantage by requiring them to alter the manufacturing process.

See also In re Pollak Steel Co., 314 F.2d 566, 136 USPQ 651 (C.C.P.A. 1963) (reflective color on fence found to be functional); *R.L. Winston Rod Co. v. Sage Mfg. Co.,* 838 F. Supp. 1396, 29 USPQ2d 1779 (D. Mont. 1993) (color green used on graphite fishing rods found to be functional); *Russell Harrington Cutlery Inc. v. Zivi Hercules Inc.,* 25 USPQ2d 1965 (D. Mass. 1992) (color white used on cutlery handles found to be functional); *Kasco Corp. v. Southern Saw Service Inc.*, 27 USPQ2d 1501 (TTAB 1993) (color green used as wrapper for saw blades is functional when the color is one of the six colors used in a color-coding system to identify the type of blade).

The doctrine of "aesthetic functionality" may apply in some cases where the evidence indicates that the color at issue provides specific competitive advantages that, while not necessarily categorized as purely "utilitarian" in nature, nevertheless dictate that the color remains in the public domain. *Brunswick Corp. v. British Seagull, supra*. *See also TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 33, 58 USPQ2d 1001, 1006 (2001) (in which the Supreme Court discussed aesthetic functionality, distinguishing *Qualitex*, *supra*, as a case where "aesthetic functionality was the central question…"). *See* **TMEP §1202.02(a)(vi).**

1202.05(c) Color as a Separable Element

As with all trademarks, a color mark may contain only those elements that make a separable commercial impression. *See* **TMEP §807.12(d).** Accordingly, an applicant may not seek to register the color of the wording or design apart from the words or designs themselves if the color does not create a separate commercial impression. However, the applicant may register the color of the background material on which the words or design appear apart from the words or design. *See* **TMEP §1202.11.**

The commercial impression of a color may change depending on the object to which it is applied. *In re Thrifty, Inc*., 274 F.3d 1349, 1353, 61 USPQ2d 1121, 1124 (Fed. Cir. 2001); *In re Hayes*, 62 USPQ2d 1443 (TTAB 2002). An application seeking registration of color in the abstract, without considering the manner or context in which the color is used, would be contrary to law and public policy, because it would result in an unlimited number of marks being claimed in a single application. *Cf. In re International Flavors & Fragrances Inc.*, 183 F.3d 1361, 1368, 51 USPQ2d 1513, 1517-18 (Fed. Cir. 1999) (mark with changeable or "phantom" element unregistrable because it would "encompass too many combinations and permutations to make a thorough and effective search possible," and, therefore, would not provide adequate notice to the public); *In re Upper Deck Co.*, 59 USPQ2d 1688 (TTAB 2001) (hologram used on trading cards in varying shapes, sizes, contents, and positions constitutes more than one "device" as contemplated by §45 of the Trademark Act). Only one mark can be registered in a single application. **TMEP §807.01.**

1202.05(d) Drawings of Color Marks Required

All marks, other than sound and scent marks, require a drawing. **TMEP §807.** An application for a color mark that is filed without a drawing will be denied a filing date. 37 C.F.R. §2.21(a)(3). Similarly, an application for a color mark with a proposed drawing page that states "no drawing," or sets forth only a written description of the mark, will be denied a filing date. The drawing provides notice of the nature of the mark sought to be registered. Only marks that are not capable of representation in a drawing, such as sound or scent marks, are excluded from the requirement for a drawing. Color marks are visual, and should be depicted in a color drawing, accompanied by: (1) a color claim naming the color(s) that are a feature of the mark; and (2) a separate statement describing where the color(s) appear and how they are used on the mark. 37 C.F.R. §2.52(b)(1); **TMEP §§807.07(a)** *et seq*.

1202.05(d)(i) Drawings of Color Marks in Trademark Applications

In most cases, the drawing will consist of a representation of the product or product package. The drawing of the mark must be a substantially exact representation of the mark as used or intended to be used on the goods. 37 C.F.R. §2.51. A depiction of the object on which the color is used is needed to meet this requirement.

The object depicted on the drawing should appear in broken lines. The broken lines inform the viewer where and how color is used on the product or package, while at the same time making it clear that the shape of the product, or the shape of the package, is not claimed as part of the mark. 37 C.F.R. §2.52(b)(4); **TMEP §807.08.** In the absence of a broken-line drawing, the USPTO will assume that the mark is a composite mark consisting of the product shape, or the packaging shape, in a particular color.

Color used on multiple goods

If the mark is used on multiple goods, the drawing required will depend on the nature of the goods. The drawing of the mark must be a substantially exact representation of the mark as used or intended to be used on the goods. 37 C.F.R. §2.51. A drawing consisting of a depiction of only one of the goods will be accepted if the goods, or the portions of the goods on which color appears, are similar in form and function so that a depiction of only one of the products is still a substantially exact representation of the mark as used on all of the products. For example, if the mark is the color purple used on refrigerators and freezers, a drawing of a freezer (in broken lines, with a description of the mark indicating that the color purple is used on the mark) would be sufficient. Or, if the mark is the color pink used on the handles of rakes, shovels, and hoes, a drawing of any of those items (in dotted lines with a description of the mark stating that the handle is pink) would be sufficient. Or, if the mark consists of packaging for various food items that is always blue with a pink circle, a drawing of any one of the packages (in dotted lines with a description of the colors) would be sufficient.

If the mark is used on multiple goods that are dissimilar or unrelated, or if color is used in different ways on different goods, so that a depiction of one of the goods is not a substantially exact representation of the mark as used on all goods (e.g., the color purple used on microscopes and vending machines), a separate application must be submitted for each item.

Color used on liquids or powders

Sometimes a color mark consists of color(s) used on liquids or powders. For example, the mark might consist of fuchsia body oil or red, white, and blue granular washing machine detergent. In these cases, the nature of the drawing will depend on the

manner of use of the liquid or powder. If the liquid or powder is visible through the product package, then the drawing should consist of the shape of the product package in broken lines, with the description of the mark identifying the color of the liquid or powder.

1202.05(d)(ii) Drawings of Color Marks in Service Mark Applications

It is difficult to anticipate all of the issues that may arise, because there are a myriad of ways that color can be used in connection with services. However, the following general guidelines will be used to determine the sufficiency of drawings in these cases:

- The purpose of a drawing is to provide notice to the public of the nature of the mark. As with color used on goods, a color service mark does not consist of color in the abstract. Rather, the mark consists of color used in a particular manner, and the context in which the color is used is critical to provide notice of the nature of the mark sought to be registered. Therefore, as with color marks used on goods, a drawing, supplemented with a written description, is required.
- The drawing must display the manner in which the mark is used in connection with the services. As with any application, only one mark can be registered in a single application. **TMEP §807.01.** The mark depicted on the drawing must, as used on the specimen, make a separate and distinct commercial impression to be considered one mark. *See In re Thrifty, Inc.*, 274 F.3d 1349, 61 USPQ2d 1121 (Fed. Cir. 2001); *In re Chemical Dynamics Inc*., 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988). *See* **TMEP §1202.05(c)** regarding color as a separable element.
- If color is used in a variety of ways, but in a setting that makes a single commercial impression, such as a retail outlet with various color features, a broken-line drawing of the setting must be submitted, with a detailed description of the color(s).
- If an applicant seeks to register a single color as a service mark used on a variety of items not viewed simultaneously by purchasers, e.g., stationery, uniforms, pens, signs, shuttle buses, the store awning, and the walls of the store, the drawing must display a solid-colored square with a dotted peripheral outline and include a detailed description of the mark. *Thrifty*, 274 F.3d at 1353, 61 USPQ2d at 1124. Applicant will receive a filing date for its application. However, as yet, the issues raised by the use of this type of drawing, e.g., sufficient notice and phantom marks, have not yet been decided by the USPTO. *Cf. In re International Flavors & Fragrances Inc*., 183 F.3d 1361, 1368, 51 USPQ2d 1513, 1517-18 (Fed. Cir. 1999). *See* **TMEP §1202.05(c).**
- The commercial impression of a color may change depending on the object on which it is applied. *See Thrifty*, 61 USPQ2d at 1124.

1202.05(d)(iii) Amendment of Drawings of Color Marks

Because color marks are comprised solely of the color as applied to the object or substance, in the manner depicted and described, amending the color of the mark would always change the commercial impression of the mark. Thus, the amendment of any color in a color mark is a prohibited material alteration. Similarly, the amendment of the color mark to show the same color on a different object is also generally a material alteration, e.g., an amendment of a drawing of a blue hammer to a blue saw would be a material alteration.

1202.05(d)(iv) Drawings for Marks Including Both Color and Words or Design

Sometimes, a product or advertisement for a service will include both color and words or a design. For example, the surface of a toaster might be green, with the trademark “ABC” and design displayed on the toaster. In this situation, the applicant must decide whether to seek registration for the color green used on toasters, the letters “ABC” with or without the design, the design, or some combination of those elements. If applicant only seeks registration for the use of the color, no word or design elements should appear on the drawing.

1202.05(e) Written Explanation of a Color Mark

The drawing of a color mark must be supplemented with: (1) a claim that the color(s) is a feature of the mark; and (2) a statement in the “Description of the Mark” field naming the color(s) and describing where the color(s) appear(s) on the mark. 37 C.F.R. §2.52(b)(1); **TMEP §§807.07(a)** *et seq*.

The description of the mark must be clear and specific, use ordinary language, and identify the mark as consisting of the particular color as applied to the goods or services. If the color is applied only to a portion of the goods, the description must indicate the specific portion. Similarly, if the mark includes gradations of color, the description should so indicate. If the applicant is claiming a shade of color, the shade must be described in ordinary language, for example, “maroon,” “turquoise,” “navy blue,” “reddish orange.” This is required even if the applicant also describes the color using a commercial coloring

system.

The applicant may not amend the description of the mark if the amendment is a material alteration of the mark on the drawing filed with the original application. 37 C.F.R. §2.72. *See In re Thrifty, Inc.,* 274 F.3d 1349, 61 USPQ2d 1121 (Fed. Cir. 2001); *cf. In re Hacot-Colombier,* 105 F.3d 616, 41 USPQ2d 1523 (Fed. Cir. 1997). *See* **TMEP §§807.14** *et seq*. regarding material alteration.

The description of a color mark must be limited to a single mark, because only one mark can be registered in a single application. *See In re International Flavors & Fragrances Inc.,* 183 F.3d 1361, 51 USPQ2d 1513 (Fed. Cir. 1999); *In re Hayes*, 62 USPQ2d 1443 (TTAB 2002). *See* **TMEP §1202.05(c)** regarding color as a separable element. *Cf.* **TMEP §807.01** (drawing must be limited to a single mark).

1202.05(f) Specimens for Color Marks

An application under §1 of the Trademark Act must be supported by a specimen that shows use of the mark depicted in the drawing. Therefore, an applicant who applies to register a color mark must submit a specimen showing use of color, either with a §1(a) application or with an allegation of use in a §1(b) application. If a black-and-white specimen is submitted, the examining attorney will require a substitute specimen. *See* **TMEP §904.02(c)(ii).**

See **TMEP §§904.03** *et seq*. regarding trademark specimens and **TMEP §§1301.04** *et seq*. regarding service mark specimens.

1202.05(g) Special Considerations for Service Mark Applications

Although the applicant in *In re Thrifty, Inc.,* 274 F.3d 1349, 61 USPQ2d 1121 (Fed. Cir. 2001) argued that it applied for the color blue *per se* as a service mark, the Court determined that the drawing controlled, such that the application was for the color blue applied to a building. Although the Court did not reach the issue of color *per se* as a service mark, the Court acknowledged the special evidentiary problem associated with showing acquired distinctiveness in this context. *Thrifty*, 274 F.3d at 1353, 61 USPQ2d at 1124 (". . . [E]vidence submitted to demonstrate acquired distinctiveness of a color may show consumer recognition with respect to certain objects (e.g., blue vehicle rental centers), but not for other objects (e.g., blue rental cars)"). Accordingly, any claim to color *per se* must be specific as to use and include evidence of acquired distinctiveness for each claimed use.

1202.05(h) Applications for Color Marks Based on §1(b)

A color mark can never be inherently distinctive. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 211-212, 54 USPQ2d 1065, 1068 (2000) (citing *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 162-163, 34 USPQ2d 1161, 1162-1163 (1995)); **TMEP §1202.05(a).** Therefore, the examining attorney must refuse to register a color mark on the Principal Register unless the applicant establishes that the mark has acquired distinctiveness under §2(f). The ground for refusal is that the color is not inherently distinctive and, thus, does not function as a trademark under §§1, 2, and 45, 15 U.S.C. §§1051, 1052, and 1127, or does not function as a service mark under §§1, 2, 3, and 45, 15 U.S.C. §§1051, 1052, 1053, and 1127.

The issue of whether the proposed mark is functional requires consideration of the manner in which the mark is used. Generally, no refusal on these grounds will be issued in a §1(b) application until the applicant has submitted specimen(s) of use with an amendment to allege use or statement of use. *See* **TMEP §§1102.01**, **1202.02(d),** and **1202.03(e).** The specimen(s) provide a better record upon which to determine the registrability of the mark. In appropriate cases, the examining attorney will bring the potential refusal to the applicant's attention in the initial 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.

1202.05(i) Applications for Color Marks Based on §44 or §66(a)

A color mark can never be inherently distinctive. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.,* 529 U.S. 205, 211-212, 54 USPQ2d 1065, 1068 (2000) (citing *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 162-163, 34 USPQ2d 1161, 1162-1163 (1995)); **TMEP §1202.05(a).** Therefore, the examining attorney must refuse to register a proposed color mark on the Principal Register unless the applicant establishes that the mark has acquired distinctiveness under §2(f). The ground for refusal is that the color is not inherently distinctive and, thus, does not function as a trademark under §§1, 2, and 45, 15 U.S.C. §§1051, 1052, and 1127, or does not function as a service mark under §§1, 2, 3, and 45, 15 U.S.C. §§1051, 1052, 1053, and 1127.

If the record indicates that the proposed mark is functional, the examining attorney should issue a refusal of registration on the Principal Register under §2(f), or on the Supplemental Register. *See* **TMEP §1202.05(b).** *NOTE: A mark in a §66(a) application cannot be registered on the Supplemental Register under any circumstances. 15 U.S.C. §1141h(a)(4); 37 C.F.R. §§2.47(c) and 2.75(c).*

1202.06 Goods in Trade

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Section 45 of the Trademark Act, 15 U.S.C. §1127, defines a "trademark" as a "word, name, symbol, or device, or any combination thereof" that is used or intended to be used in commerce "to *identify and distinguish his or her goods* (emphasis added)." Before rights in a term as a trademark can be established, the subject matter to which the term is applied must be "goods in trade." Incidental items that an applicant uses in conducting its business (such as letterhead, invoices, and business forms), as opposed to items sold or transported in commerce for use by others, are not "goods in trade." *See In re Shareholders Data Corp*., 495 F.2d 1360, 181 USPQ 722 (C.C.P.A. 1974) (reports not goods in trade, where applicant is not engaged in the sale of reports, but solely in furnishing financial reporting services, and reports are merely conduit through which services are rendered); *In re MGA Entertainment, Inc.*, 84 USPQ2d 1743 (TTAB 2007) (applicant's trapezoidal cardboard boxes for toys, games, and playthings held to be merely point of sale containers for applicant's primary goods and not separate goods in trade, where there was no evidence that applicant is a manufacturer of boxes or that applicant is engaged in selling boxes as commodities in trade); *In re Compute-Her-Look, Inc.,* 176 USPQ 445 (TTAB 1972) (reports and printouts not goods in trade, where they are merely the means by which the results of a beauty analysis service is transmitted and have no viable existence separate and apart from the service); *Ex parte Bank of America Nat'l Trust and Savings Ass'n*, 118 USPQ 165 (Comm'r Pats. 1958) (mark not registrable for passbooks, checks, and other printed forms, where forms are used only as necessary tools in the performance of banking services, and the applicant is not engaged in printing or selling forms as commodities in trade).

1202.06(a) Goods Must Have Utility to Others

Affixing a mark to an item that is transported in commerce does not in and of itself establish that the mark is used on "goods." While a formal sale is not always necessary, items sold or transported in commerce are not "goods in trade" unless they have utility to others as the type of product named in the application.

> *Example*: Holiday greeting cards sent by a law firm to its clients are not "goods," where applicant is merely sending its own cards through the mail as a holiday greeting, and the cards are not suitable for use by the recipients as a greeting card.

See Gay Toys, Inc. v. McDonald's Corp., 585 F.2d 1067, 199 USPQ 722 (C.C.P.A. 1978) (plaster mockup of toy truck not goods in trade, where there is no evidence the mockup is actually used as a toy); *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768 (TTAB 1994), *aff'd,* 108 F.3d 1392 (Fed. Cir. 1997) (mark not registrable for games, where purported games are advertising flyers used to promote applicant's services and have no real utilitarian function or purpose as games); *In re Douglas Aircraft Co., Inc.,* 123 USPQ 271 (TTAB 1959) (books, pamphlets, and brochures that serve only to explain and advertise the goods in which applicant deals are not "goods"). *Cf. In re Snap-On Tools Corp*., 159 USPQ 254 (TTAB 1968) (ball point pens used to promote applicant's tools are goods in trade, where they have a utilitarian function and purpose, and have been sold to applicant's franchised dealers and transported in commerce under mark); *In re United Merchants & Manufacturers, Inc.*, 154 USPQ 625 (TTAB 1967) (calendar used to promote applicant's plastic film constitutes goods in trade, where calendar has a utilitarian function and purpose in and of itself, and has been regularly distributed in commerce for several years).

In *In re MGA Entertainment, Inc.*, 84 USPQ2d 1743, 1746 (TTAB 2007) (applicant's trapezoidal cardboard boxes for toys, games, and playthings found to be merely point of sale containers for applicant's primary goods and not separate goods in trade), the Board rejected applicant's argument that boxes for puzzles and laptop play units have use beyond holding the goods at point of sale, in that the box functions as an ongoing carrying case for applicant's laptop play unit, and the puzzle box may be used to store puzzle pieces when not in use, finding that "the mere fact that original boxes or packaging may be used to store products does not infuse such boxes or packaging with additional utility such that they constitute goods in trade;" and that there is no indication that the laptop computer boxes are labeled as a carrying case nor any evidence that applicant promotes the boxes as carrying cases or that children actually use them as carrying cases.

1202.06(b) Registration Must Be Refused if Trademark Not Used on Goods in Trade

If the specimen, identification of goods, or other evidence in the record indicate that the applicant uses the mark only on items incidental to conducting its own business, as opposed to items intended to be used by others, the examining attorney should refuse registration on the Principal Register under §§1, 2, and 45 of the Trademark Act; 15 U.S.C. §§1051, 1052, and 1127, on the ground that the mark is not used on "goods in trade."

If a mark is not used on "goods in trade," it is not registrable on the Principal Register under §2(f) of the Trademark Act, 15 U.S.C. §1052(f), or on the Supplemental Register.

If some but not all of the items listed in the identification of goods are found not to be "goods in trade," it is not necessary to refuse registration of the entire application, but the examining attorney should require that these items be deleted from the identification of goods.

1202.06(c) "Goods in Trade" in §1(b), §44, and §66(a) Applications

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In an intent-to-use application under §1(b) of the Trademark Act, the question of whether a mark is used on goods in trade usually does not arise until the applicant files an allegation of use under §1(c) or §1(d) of the Act, because this issue is based on the manner in which the mark is used. However, if the identification of goods in an intent-to-use application includes items that do not appear to be goods in trade, the potential refusal should be brought to the applicant's attention in the first action issued by the USPTO. 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. If the record indicates that the mark will not be used on goods in trade, without the need to await consideration of the specimen, the examining attorney may issue the refusal prior to the filing of the allegation of use.

In an application under §44 or §66(a), where a specimen of use is not required prior to registration, it is appropriate for examining attorneys to issue a refusal based on the lack of use on goods in trade where the record clearly indicates that the mark will not be used on goods in trade. *Cf. In re Right-On Co.,* 87 USPQ2d 1152, 1156-57 (TTAB 2008) (noting the propriety of and affirming an ornamentation refusal, which is otherwise typically specimen-based, in a §66(a) application).

1202.07 Marks That Identify Columns or Sections of Publications

1202.07(a) Marks That Identify Columns or Sections of Printed Publications

A column, section, or supplement of a printed publication is normally not considered to be separate "goods" or "goods in trade," unless it is sold, syndicated, or offered for syndication separate and apart from the larger publication in which it appears. *In re Broadcasting Publications, Inc.*, 135 USPQ 374 (TTAB 1962); *Ex parte Meredith Publishing Co.,* 109 USPQ 426 (Comm'r Pats. 1956). This is true even of a removable or separable "pullout" section of a newspaper or other publication. In *Meredith*, the issue was analyzed as follows:

> The basic question is whether or not, under the circumstances of use, the section title is a name adopted and used by the publisher to identify his goods and distinguish them from those of others. The "goods" actually are magazines-not sections of magazines. When the magazine is purchased, the purchaser receives the sections whether he wants them or not, and it is doubtful that magazine readers *ordinarily* purchase a magazine merely to receive a section of it, or think of a magazine merely in terms of a section title. Sections of magazines are not in and of themselves articles of commerce other than as a part of an integrated whole; and we must therefore be concerned with whether a section title actually identifies and distinguishes, and if so, what it distinguishes. Under these circumstances it becomes necessary to ask: Was the mark adopted to identify a section of applicant's magazine and distinguish it from sections of other publishers' magazines, or was it adopted to distinguish one section of applicant's magazine from the other sections of its magazine? *Ordinarily*, it is the latter (emphasis in original).

109 USPQ at 426.

The examining attorney may accept the statement of the applicant or applicant's attorney that the column is syndicated. It is not necessary to set this forth in the identification of goods.

1202.07(a)(i) Syndicated Columns and Sections

Columns or sections that are separately sold, syndicated, or offered for syndication do constitute goods in trade. A mark that identifies a column or section that is separately syndicated or offered for syndication is registrable on the Principal Register without resort to §2(f) of the Trademark Act, 15 U.S.C. §1052(f), if registration is not barred by other sections of the Act.

1202.07(a)(ii) Non-Syndicated Columns and Sections

A column or section of a printed publication that is not separately sold, syndicated, or offered for syndication is not, in and of itself, considered to be separate goods in trade. Therefore, where the specimen, identification of goods, or other evidence in the record indicates that the mark identifies a column or section of a printed publication that is not separately sold, syndicated, or offered for syndication, the examining attorney should refuse registration on the Principal Register under §§1, 2, and 45 of the Trademark Act; 15 U.S.C. §§1051, 1052, and 1127, on the ground that the mark is not used on separate goods in trade.

Marks that identify non-syndicated columns or sections of printed publications are registrable on the Principal Register under §2(f) of the Trademark Act, 15 U.S.C. §1052(f), if the column or section is shown to have acquired separate recognition and distinctiveness. An applicant who seeks registration on the Principal Register bears the burden of establishing, through evidence of promotion, long use, advertising expenditures, and breadth of distribution or sales figures, that the public has come to recognize the proposed mark as an indicator of source.

The evidence of acquired distinctiveness must show that the column or section title is used and promoted to distinguish applicant's column or section from the columns or sections of other publishers' publications, rather than merely to distinguish

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applicant's column or section from other columns or sections of applicant's publication. *Metro Publishing v. San Jose Mercury News*, 987 F.2d 637, 25 USPQ2d 2049 (9th Cir. 1993); *In re Broadcasting Publications, Inc.,* 135 USPQ 374 (TTAB 1962).

The amount of evidence needed to establish distinctiveness must be evaluated by the examining attorney on a case-by-case basis, in light of the type of column or supplement. If the mark identifies a removable or pull-out section, a lesser degree of evidence might be required to establish distinctiveness. Of course, the amount of evidence needed to establish distinctiveness in any particular case will also vary depending on the strength or weakness of the mark. **TMEP §1212.04(a).**

Marks that identify non-syndicated columns or sections of printed publications, but have not yet acquired distinctiveness under §2(f) of the Act, are registrable on the Supplemental Register in applications under §1 or §44 of the Trademark Act, if registration is not barred by other sections of the Act. *Ex parte Meredith Publishing Co.,* 109 USPQ 426 (Comm'r Pats. 1956).

1202.07(a)(iii) Marks That Identify Columns and Sections of Printed Publications in §1(b), §44, and §66(a) Applications

Since a refusal to register a mark that identifies a column or section of a printed publication is based on whether the column or section is separately sold or syndicated, the issue ordinarily does not arise in an intent-to-use application under §1(b) of the Trademark Act, 15 U.S.C. §1051(b), until the applicant has filed an allegation of use under §1(c) or §1(d) of the Trademark Act, 15 U.S.C. §§1051(c) or (d). However, if the identification of goods suggests that the mark is intended to be used to identify a column or section of a printed publication that is not separately sold or syndicated, the potential refusal on the ground that the proposed mark is not used on separate goods in trade 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 prior to the filing of the allegation of use, the USPTO is not precluded from refusing registration on this basis. In cases where the record indicates that the mark will identify a column or section of a printed publication that is not separately sold or syndicated, the examining attorney may make the refusal prior to the filing of the allegation of use.

In an application under §44 or §66(a), where a specimen of use is not required prior to registration, it is appropriate for examining attorneys to refuse registration because the mark is not used on goods in trade where the record indicates that the mark will identify a column or section of a printed publication that is not separately sold or syndicated. *Cf. In re Right-On Co.,* 87 USPQ2d 1152, 1156-57 (TTAB 2008) (noting the propriety of and affirming an ornamentation refusal, which is otherwise typically specimen-based, in a §66(a) application).

1202.07(b) Marks That Identify Columns and Sections of Online Publications

An online publication is considered a service rather than a product. Therefore, refusal of registration on the ground that the proposed mark is not used on goods in trade is inappropriate. Unlike a printed column or section, an online column or section can be accessed directly and can exist independent of any single publication. *See Ludden v. Metro Weekly*, 8 F. Supp. 2d 7, 14, 47 USPQ2d 1087, 1093 (D.D.C. 1998). Therefore, a mark that identifies an online column is registrable on the Principal Register without resort to §2(f) of the Trademark Act, 15 U.S.C. §1052(f), if registration is not barred by other sections of the Act.

1202.08 Title of a Single Creative Work

The title, or a portion of a title, of a single creative work must be refused registration under §§1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127, unless the title has been used on a series of creative works. The title of a single creative work is not registrable on either the Principal or Supplemental Register. *Herbko Int'l, Inc. v. Kappa Books, Inc*., 308 F.3d 1156, 1162, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002) ("the title of a single book cannot serve as a source identifier"); *In re Cooper,* 254 F.2d 611, 615-16, 117 USPQ 396, 400 (C.C.P.A. 1958), *cert. denied*, 358 U.S. 840, 119 USPQ 501 (1958) ("A book title ... identifies a specific literary work ... and is not associated in the public mind with the publisher, printer or bookseller...."); *In re Posthuma*, 45 USPQ2d 2011 (TTAB 1998) (title of a live theater production held unregistrable); *In re Hal Leonard Publishing Corp*., 15 USPQ2d 1574 (TTAB 1990) (INSTANT KEYBOARD, as used on music instruction books, found unregistrable as the title of a single work); *In re Appleby*, 159 USPQ 126 (TTAB 1968) (title of single phonograph record, as distinguished from a series, does not function as mark).

See **TMEP §1301.02(d)** regarding the titles of radio and television programs.

1202.08(a) What Constitutes a Single Creative Work

Single creative works include works in which the content does not change, whether that work is in printed, recorded, or electronic form. Materials such as books, sound recordings, downloadable songs, downloadable ring tones, videocassettes, DVDs, audio CDs, and films are usually single creative works. Creative works that are serialized, i.e., the mark identifies the entire work but the work is issued in sections or chapters, are still considered single creative works. A theatrical performance is also a single creative work, because the content of the play, musical, opera, or similar production does not significantly change from one performance to another. *In re Posthuma*, 45 USPQ2d 2011 (TTAB 1998). A cornerstone was considered a single

creative work in an application for registration of FREEDOM STONE for “building stones used as landmarks or cornerstones,” where the record showed that the proposed mark would identify only one building stone used as a landmark or cornerstone, to serve as the cornerstone for the Freedom Tower that is to be erected at the World Trade Center site in New York City. *In re Innovative Companies, LLC.,* 88 USPQ2d 1095 (TTAB 2008).

1202.08(b) What Does Not Constitute a Single Creative Work

Generally, any creative work will not be considered a single creative work if evidence exists that it is part of a series (e.g., the work is labeled “volume 1,” “part 1,” or “book 1”) or is a type of work in which the content changes with each issue or performance. For example, single creative works do not include periodically issued publications, such as magazines, newsletters, comic books, comic strips, guide books, and printed classroom materials, because the content of these works changes with each issue.

A book with a second or subsequent edition in which the content changes *significantly* is not regarded as a single creative work. For example, a statement on the jacket cover that a cookbook is a “new and revised” version would indicate that it includes significant revisions. However, a new edition issued to correct typographical errors or that makes only minor changes is not considered to be a new work. Live performances by musical bands, television and radio series, and educational seminars are presumed to change with each presentation and, therefore, are not single creative works.

Computer software, computer games, coloring books, puzzle books, and activity books are not treated as single creative works.

The examining attorney must determine whether changes in content are significant based on any evidence in the application or record. The examining attorney may conduct additional research using the applicant’s website, Internet search engines, or Nexis® databases (with a Note to the File if appropriate). In addition, the examining attorney may issue a request for information under 37 C.F.R. §2.61(b).

1202.08(c) Complete Title of the Work – Evidence of a Series

The name of a series of books or other creative works may be registrable if it serves to identify and distinguish the source of the goods. An applicant must submit evidence that the title is used on at least two different creative works. A series is not established when only the format of the work is changed, i.e., the same title used on a printed version of a book and a recorded version does not establish a series. Likewise, use of the title on unabridged and abridged versions of the same work, or on collateral goods such as posters, mugs, bags, or t-shirts does not establish a series.

For example, if an application for the mark HOW TO RETIRE EARLY for “books” is refused because the specimen shows the mark used on a single creative work, the applicant may submit copies of other book covers showing use of the mark HOW TO RETIRE EARLY and any additional evidence to establish that the book is published each year with different content. It is not necessary, however, to show that the mark was used on the series prior to filing the application or the allegation of use. Evidence that the applicant intends to use the mark on a series is insufficient.

1202.08(d) Portion of a Title of the Work

A portion of the title of any single creative work is registrable only if the applicant can show that the portion of the title meets the following criteria:

(1) It creates a separate commercial impression apart from the complete title;

(2) It is used on series of works; and

(3) It is promoted or recognized as a mark for the series.

1202.08(d)(i) Mark Must Create a Separate Commercial Impression

When registration is sought for a portion of a title, the mark must be used as a separable element on the specimen. The examining attorney should consider the size, type font, color, and any separation between the mark and the rest of the title when making this determination. *In re Scholastic Inc.*, 23 USPQ2d 1774 (TTAB 1992) (the words THE MAGIC SCHOOL BUS are prominently displayed on the books' covers, and are in a larger, bolder style of type and different color from the remainder of each title. Moreover, the words appear on a separate line above the remainder of each title). If the portion of the title sought to be registered is not separable, the examining attorney should refuse registration on the ground that the mark is not a substantially exact representation of the mark as it appears on the specimen. *See* **TMEP §807.12(d).**

1202.08(d)(ii) Establishing a Series When the Mark is a Portion of the Title

An applicant may establish that the portion of the title of a creative work is used on a series by submitting more than one book

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cover or CD cover with the mark used in all the titles. For example, if the mark on the drawing is “THE LITTLE ENGINE” and on the book it appears as “THE LITTLE ENGINE THAT WENT TO THE FAIR,” registration should be refused because the mark is a portion of a title of a single work. To establish use on a series, the applicant may submit additional book covers showing use of, e.g., “THE LITTLE ENGINE GOES TO SCHOOL,” and “THE LITTLE ENGINE AND THE BIG RED CABOOSE.”

1202.08(d)(iii) Evidence that the Portion of the Title is Promoted or Recognized as a Mark

When a mark is used merely as a *portion of the title* of a creative work, the applicant has a heavier burden in establishing that the portion for which registration is sought serves as a trademark for the goods. *The mere use of the same words in more than one book title is insufficient to establish the words as a mark for a series*. The applicant must show that the public perceives the portion sought to be registered as a mark for the series. *In re Scholastic Inc.*, 23 USPQ2d 1774 (TTAB 1992) (THE MAGIC SCHOOL BUS used as a portion of the book titles in “THE MAGIC SCHOOL BUS AT THE WATERWORKS” and “THE MAGIC SCHOOL BUS INSIDE THE EARTH,” held to function as a mark for a series, because the record contained evidence of repeated use of the designation displayed prominently on book covers, as well as evidence that applicant promoted THE MAGIC SCHOOL BUS as a series title, that others used the designation in book reviews to refer to a series of books, and that purchasers recognized the designation as indicating the source of a series of books).

1202.08(e) Identification of Goods/Services

Identification Need Not Reflect Use on a Series. The identification of goods/services need not reflect that the applicant is using the title on a series of works (either written or recorded). It is sufficient that the record contains the evidence of a series.

Creative Works in a List of Goods or Services. A refusal of registration on the ground that the mark merely identifies the title of a single creative work can be made regardless of whether the creative work is the sole item in the identification of goods/services or is listed with other items. If the record contains information, or if the examining attorney learns from another source, that the mark identifies the title of a single creative work, the examining attorney must issue a partial refusal as to the relevant goods/services. A partial refusal is a refusal that applies only to certain goods/services, or to certain classes. *See* **TMEP §718.02(a).**

> *Example*: An application for “newspapers, books in the field of finance, pencils, and coloring books” would be partially refused if the examining attorney determined, either from the application or from another source, that the mark identified the title of the “books in the field of finance.” The use of the same mark on other non-creative matter such as the pencils and coloring books does not overcome the refusal.

1202.08(f) Title of a Single Work in §1(b), §44, and §66(a) Applications

The issue of whether a proposed mark is the title of a single creative work usually is tied to use of the mark, as evidenced by the specimen. Therefore, generally, no refusal 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 with an allegation of use under §1(c) or §1(d) of the Act, 15 U.S.C. §1051(c) or (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 proposed mark is the title of a single creative work, the potential refusal should be brought to the applicant’s attention in the first action issued by the USPTO. 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. In cases where the record indicates that the mark constitutes the title of a single work, the examining attorney may make the refusal prior to the filing of the allegation of use.

In an application under §44 or §66(a), where a specimen of use is not required prior to registration, it is appropriate for examining attorneys to issue the refusal where the record indicates that the mark will identify the title of a single work. *Cf. In re Right-On Co.,* 87 USPQ2d 1152, 1156-57 (TTAB 2008) (noting the propriety of and affirming an ornamentation refusal, which is otherwise typically specimen-based, in a §66(a) application).

1202.09 Names of Artists and Authors

1202.09(a) Names and Pseudonyms of Authors and Performing Artists

Any mark consisting of the name of an author used on a written work, or the name of a performing artist on a sound recording, must be refused registration under §§1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127, if the mark is used solely to identify the writer or the artist. *In re Polar Music Int’l AB*, 714 F.2d 1567, 221 USPQ 315 (Fed. Cir. 1983); *In re First Draft*, *Inc.* 76 USPQ2d 1183 (TTAB 2005); *In re Peter Spirer*, 225 USPQ 693 (TTAB 1985). Written works include books or columns, and may be presented in print, recorded, or electronic form. Likewise, sound recordings may be presented in recorded or electronic form.

However, the name of the author or performer may be registered if:

(1) It is used on a series of written or recorded works; and

(2) The application contains sufficient evidence that the name identifies the source of the series and not merely the writer of the written work or the name of the performing artist.

If the applicant cannot show a series, or can show that there is a series but cannot show that the name identifies the source of the series, the mark may be registered on the Supplemental Register in an application under §1 or §44 of the Trademark Act. These types of marks may not be registered on the Principal Register under §2(f).

See also **TMEP §1301.02(b)** regarding personal names as service marks.

1202.09(a)(i) Author or Performer's Name – Evidence of a Series

In an application seeking registration of an author's or performer's name, the applicant must provide evidence that the mark appears on at least two different works. Such evidence could include copies of multiple book covers or multiple CD covers that show the name sought to be registered. A showing of the same work available in different media, i.e., the same work in both printed and/or recorded or downloadable format, does not establish a series.

The identification of goods need not reflect that the applicant is using the name on a series of works (either written or recorded). It is sufficient that the record contains the evidence of a series.

1202.09(a)(ii) Evidence that the Name is a Source Identifier

The use of the author's or performer's name on a series of works does not, in itself, establish that the name functions as a mark. The record must also show that the name serves as more than a designation of the writer or performer, i.e., that it also serves to identify the source of the series. *See In re First Draft,* 76 USPQ2d 1183, 1191 (TTAB 2005) (pseudonym FERN MICHAELS identified only the author and did not function as a mark to identify and distinguish a series of fictional books because the "evidence of promotion was scant," despite applicant's showing that the name had been used as an author's name for 30 years; that 67 separate books had been published under the name, and approximately 6 million copies had been sold; that the book jackets listed the titles of other works by Fern Michaels and promoted her as a bestselling author; that the author had been inducted into the New Jersey Literary Hall of Fame; and that there was a www.fernmichaels.com website); *In re Chicago Reader Inc.,* 12 USPQ2d 1079 (TTAB 1989) (CECIL ADAMS, used on the specimen as a byline and as part of the author's address appearing at the end of a column, merely identifies the author and does not function as a trademark for a newspaper column).

A showing that the name functions as a source identifier may be made by submitting evidence of either: (1) promotion and recognition of the name as a source indicator for the series (*see* **TMEP §1202.09(a)(ii)(A)**); or (2) the author's or performer's control over the name and quality of his or her works in the series (*see* **TMEP §1202.09(a)(ii)(B)).**

1202.09(a)(ii)(A) Promotion and Recognition of the Name

To show that the name of an author or performing artist has been promoted and is recognized as indicating the source of a series of written works, the applicant could submit copies of advertising that promotes the name as the source of a series, copies of third-party reviews showing others' use of the name to refer to a series of works, or evidence showing the name used on a display associated with the series of works. *See In re First Draft*, 76 USPQ2d 1183 (TTAB 2005), citing *In re Scholastic Inc.*, 23 USPQ2d 1774 (TTAB 1992) (THE MAGIC SCHOOL BUS held to function as a mark for a series of books, where the record contained evidence of use of the designation displayed prominently on many different book covers, as well as evidence that applicant promoted the term as a series title, that others used the designation in book reviews to refer to a series of books, and that purchasers recognized the designation as indicating the source of a series of books).

1202.09(a)(ii)(B) Control over the Nature and Quality of the Goods

Alternatively, an applicant may show that the name of an author or performing artist functions as a source indicator by submitting documentary evidence that the author/performer controls the quality of his or her distributed works and controls the use of his or her name. Such evidence would include license agreements and other documentary or contractual evidence. In *In re Polar Music Int'l AB*, 714 F.2d 1567, 221 USPQ 315 (Fed. Cir. 1983) (the name of the musical group ABBA held to function as a mark for sound recordings where a license agreement showed that the owner of the mark, ABBA, controlled the quality of the goods, and other contractual evidence showed that the owner also controlled the use of the name of the group).

In *In re First Draft*, 76 USPQ2d 1183, 1191 (TTAB 2005), the Board found that the applicant failed to meet the *Polar Music* test,

noting that:

> [W]e have neither any evidence bearing on [the question of applicant's control over the quality of the goods] nor even any representations by counsel regarding such matters. This is in stark contrast to *Polar Music*, wherein there was detailed information and documentary (i.e., contractual) evidence regarding the relationship between the performing group ABBA and its "corporate entity," as well as evidence of the control such corporation maintained in dealings with a manufacturer and seller of its recordings in the United States.

If the applicant maintains control over the quality of the goods because the goods are published or recorded directly under the applicant's control, the applicant may submit a verified statement that "the applicant publishes or produces the goods and controls their quality."

1202.09(a)(iii) Names of Authors and Performing Artists in §1(b), §44, and §66(a) Applications

The issue of whether a proposed mark identifies only an author or performing artist is usually tied to use of the mark, as evidenced by the specimen. Therefore, generally, no refusal 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 specimen(s) with an allegation of use under §1(c) or §1(d) of the Trademark Act, 15 U.S.C. §1051(c) or (d).

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 proposed mark identifies only an author or performing artist, the potential refusal should be brought to the applicant's attention in the first action issued by the USPTO. 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. In cases where the record indicates that the mark identifies only an author or performing artist, the examining attorney may make the refusal prior to the filing of the allegation of use.

In an application under §44 or §66(a), where a specimen of use is not required prior to registration, it is appropriate for examining attorneys to issue the refusal where the record, even without a specimen, reflects that the proposed mark identifies only an author or performing artist. *Cf. In re Right-On Co.,* 87 USPQ2d 1152, 1156-57 (TTAB 2008) (noting the propriety of and affirming an ornamentation refusal, which is otherwise typically specimen-based, in a §66(a) application).

1202.09(b) Names of Artists Used on Original Works of Art

An artist's name or pseudonym affixed to an original work of art may be registered on the Principal Register without a showing that the name identifies a series. Original works of art includes paintings, murals, sculptures, statues, jewelry, and like works that the artist personally creates. In *In re Wood,* 217 USPQ 1345, 1350 (TTAB 1983), the Board held that the pseudonym YSABELLA affixed to an original work of art functioned as a mark. The Board has expressly limited this holding to cases involving original works of art, stating in *Wood* that "[l]est we be accused of painting with too broad a brush, we hold only that an artist's name affixed to an original work of art may be registered as a mark and that here applicant's name, as evidenced by some of the specimens of record [the signature of the artist on a work of art], functions as a trademark for the goods set forth in the application." In *In re First Draft*, 76 USPQ2d 1183, 1190 (TTAB 2005), the Board again stated that "*Wood* is limited in its application to cases involving original works of art and there is nothing to indicate that the panel deciding that case considered novels to be encompassed by the phrase original works of art."

1202.10 Names and Designs of Characters in Creative Works

Marks that merely identify a character in a creative work, *whether used in a series or in a single work*, are not registrable. *In re Scholastic Inc.,* 223 USPQ 431 (TTAB 1984) (THE LITTLES, used in the title of each book in a series of children's books, does not function as a mark where it merely identifies the main characters in the books). *Cf. In re Caserta*, 46 USPQ2d 1088 (TTAB 1998) (FURR-BALL FURCANIA, used as the principal character in a single children's book, held not to function as a mark even though the character's name appeared on the cover and every page of the story); *In re Frederick Warne & Co. Inc*., 218 USPQ 345 (TTAB 1983) (an illustration of a frog used on the cover of a single book served only to depict the main character in the book and did not function as a trademark).

To overcome a refusal of registration on the ground that the proposed mark merely identifies a character in a creative work, the applicant may submit evidence that the character name does not merely identify the character in the work. For example, the applicant may submit evidence showing use of the character name as a mark on the spine of the book, or on displays associated with the goods, in a manner that would be perceived as a mark.

A refusal of registration on the ground that the mark merely identifies a character in a creative work can be made regardless of whether the creative work is the sole item in the identification of goods/services or is listed with other items. If the record contains information or if the examining attorney learns from another source that the mark identifies a character in a creative work, the examining attorney should issue a partial refusal as to the relevant goods/services. A partial refusal is a refusal that

applies only to certain goods/services, or to certain classes. *See* **TMEP §718.02(a).**

Example: An application for "children's books, pencils, and coloring books" would be partially refused if the examining attorney determined, either from the application or from another source, that the mark identified a character in the books. The use of the same mark on other non-creative matter such as the pencils and coloring books does not overcome the refusal.

1202.10(a) Names and Designs of Characters in Creative Works in §1(b), §44, or §66(a) Applications

The issue of whether a proposed mark identifies only the name or design of a particular character is tied to use of the mark, as evidenced by the specimen. Therefore, unless the record, even without a specimen, reflects that the proposed mark identifies only the name or design of a character, generally no refusal 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 specimen(s) with an allegation of use under §1(c) or §1(d) of the Trademark Act, 15 U.S.C. §1051(c) or (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 proposed mark identifies only a particular character, the potential refusal should be brought to the applicant's attention in the first action issued by the USPTO. 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. In cases where the record indicates that the mark identifies only the name or design of a character, the examining attorney may make the refusal prior to the filing of the allegation of use.

In an application under §44 or §66(a), where a specimen of use is not required prior to registration, it is appropriate for examining attorneys to issue the refusal where the record indicates that the mark will identify only the name or design of a particular character. *Cf. In re Right-On Co.,* 87 USPQ2d 1152, 1156-57 (TTAB 2008) (noting the propriety of and affirming an ornamentation refusal, which is otherwise typically specimen-based, in a §66(a) application).

See **TMEP §1301.02(b)** regarding names of characters or personal names as service marks.

1202.11 Background Designs and Shapes

Common geometric shapes, when used separately as vehicles for the display of word marks, are not regarded as indicators of origin absent evidence of distinctiveness of the design alone. As stated in *In re Chemical Dynamics, Inc*., 839 F.2d 1569, 1570-1571, 5 USPQ2d 1828, 1829 (Fed. Cir. 1988), "[a] background design which is always used in connection with word marks must create a commercial impression on buyers separate and apart from the word marks for the design to be protectible as a separate mark. In deciding whether the design background of a word mark may be separately registered, the essential question is whether or not the background material is or is not inherently distinctive…. If the background portion is inherently distinctive, no proof of secondary meaning need be introduced; if not, such proof is essential (citations omitted)."

Additionally, the Supreme Court stated in *Wal-Mart Stores, Inc. v. Samara Bros., Inc.,* 529 U.S. 205, 211-212, 54 USPQ2d 1065, 1068 (2000) that color can never be inherently distinctive.

An applicant may respond to a refusal to register an application for a common geometric shape or background design by submitting evidence that the subject matter has acquired distinctiveness under §2(f) of the Trademark Act, 15 U.S.C. §1052(f). The examining attorney should scrutinize any submission that asserts distinctiveness solely on the basis of a statement of substantially exclusive and continuous use for five years to determine whether it truly establishes that the subject matter is perceived as a trademark by the purchasing public. The examining attorney may continue to refuse registration if he or she believes that the applicant's assertion does not establish that the matter is perceived as a trademark. The applicant may submit additional evidence to establish distinctiveness. *See* **TMEP §§1212** *et seq*.

In the following cases, the evidence of distinctiveness was insufficient: *In re Benetton Group S.p.A.,* 48 USPQ2d 1214 (TTAB 1998) (green rectangular background design not inherently distinctive; evidence of acquired distinctiveness found insufficient); *In re Anton/Bauer Inc.*, 7 USPQ2d 1380 (TTAB 1988) (parallelogram designs used as background for word marks found not inherently distinctive; evidence of record held insufficient to establish acquired distinctiveness pursuant to §2(f)); *In re Kerr-McGee Corp.*, 190 USPQ 204 (TTAB 1976) (affirming refusals to register escutcheon design used as a frame or border for words, under §2(f)).

In the following cases, the evidence of distinctiveness was sufficient: *In re Schenectady Varnish Co.*, *Inc.,* 280 F.2d 169, 126 USPQ 395 (C.C.P.A. 1960) (where use of applicant's design of a cloud and a lightning flash was always used as a background for the word "SCHENECTADY," evidence of record found sufficient to show acquired distinctiveness of the design alone as a trademark for synthetic resins); *In re Raytheon Co.*, 202 USPQ 317 (TTAB 1979) (light-colored oval within black rectangular carrier considered not inherently distinctive; evidence of record found sufficient to establish acquired distinctiveness).

1202.12 Varietal and Cultivar Names (Examination of Applications for Seeds and Plants)

Varietal or cultivar names are designations given to cultivated varieties or subspecies of live plants or agricultural seeds. They amount to the generic name of the plant or seed by which such variety is known to the public. These names can consist of a numeric or alphanumeric code or can be a "fancy" (arbitrary) name. The terms "varietal" and "cultivar" may have slight semantic differences but pose indistinguishable issues and are treated identically for trademark purposes.

Subspecies are types of a particular species of plant or seed that are members of a particular genus. For example, all maple trees are in the genus *Acer*. The sugar maple species is known as *Acer saccharum*, while the red maple species is called *Acer rubrum*. In turn, these species have been subdivided into various cultivated varieties that are developed commercially and given varietal or cultivar names that are known to the public.

A varietal or cultivar name is used in a plant patent to identify the variety. Thus, even if the name was originally arbitrary, it "describe[s] to the public a [plant] of a particular sort, not a [plant] from a particular [source]." *Dixie Rose*, 131 F.2d at 447, 55 USPQ at 316. It is against public policy for any one supplier to retain exclusivity in a patented variety of plant, or the name of a variety, once its patent expires. *Id.*

Market realities and lack of laws concerning the registration of varietal and cultivar names have created a number of problems in this area. Some varietal names are not attractive or easy to remember by the public. As a result, many arbitrary terms are used as varietal names. Problems arise when trademark registration is sought for varietal names, when arbitrary varietal names are thought of as being trademarks by the public, and when terms intended as trademarks by plant breeders become generic through public use. These problems make this a difficult area for the examining attorney in terms of gathering credible evidence and knowing when to make refusals.

Whenever an application is filed to register a mark containing wording for live plants, agricultural seeds, fresh fruits, or fresh vegetables, the examining attorney must inquire of the applicant whether the term has ever been used as a varietal name, and whether such name has been used in connection with a plant patent, a utility patent, or a certificate for plant variety protection. *See* 37 C.F.R. §2.61(b). The examining attorney should also undertake an independent investigation of any evidence that would support a refusal to register, using sources of evidence that are appropriate for the particular goods specified in the application (e.g., laboratories and repositories of the United States Department of Agriculture, plant patent information from the USPTO, a variety name search of plants certified under the Plant Variety Protection Act listed at **www.ars-grin.gov/npgs/searchgrin.html**).

If the examining attorney determines that wording sought to be registered as a mark for live plants, agricultural seeds, fresh fruits, or fresh vegetables comprises a varietal or cultivar name, then the examining attorney must refuse registration, or require a disclaimer, on the ground that the matter is the varietal name of the goods and does not function as a trademark under §§1, 2, and 45 of the Trademark Act, 15 U.S.C.§§1051, 1052, and 1127. *See In re Pennington Seed, Inc.*, 466 F.3d 1053, 80 USPQ2d 1758 (Fed. Cir. 2006) (upholding the USPTO's long-standing precedent and policy of treating varietal names as generic, and affirming refusal to register REBEL for grass seed because it is the varietal name for the grass seed as evidenced by its designation as the varietal name in applicant's plant variety protection certificate); *Dixie Rose Nursery v. Coe*, 131 F.2d 446, 55 USPQ 315 (D.C. Cir. 1942), *cert. denied* 318 U.S. 782, 57 USPQ 568 (1943); *In re Hilltop Orchards & Nurseries, Inc.*, 206 USPQ 1034 (TTAB 1979); *In re Farmer Seed & Nursery Co.*, 137 USPQ 231 (TTAB 1963); *In re Cohn Bodger & Sons Co.*, 122 USPQ 345 (TTAB 1959).

Likewise, if the mark identifies the prominent portion of a varietal name, it must be refused. *In re Delta and Pine Land Co.,* 26 USPQ2d 1157 (TTAB 1993) (Board affirmed refusal to register DELTAPINE, which was a portion of the varietal names Deltapine 50, Deltapine 20, Deltapine 105 and Deltapine 506).

1202.13 Scent, Fragrance, or Flavor

Scent. The scent of a product may be registrable if it is used in a nonfunctional manner. *See In re Clarke*, 17 USPQ2d 1238 (TTAB 1990) (Trademark Trial and Appeal Board held that a scent functioned as a mark for "sewing thread and embroidery yarn)." Scents that serve a utilitarian purpose, such as the scent of perfume or an air freshener, would be functional and not registrable. *See* **TMEP §§1202.02(a)** *et seq*. regarding functionality. When a scent is not functional, it may be registered on the Principal Register under §2(f), or on the Supplemental Register if appropriate. The amount of evidence required to establish that a scent or fragrance functions as a mark is substantial. *Cf. In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985).

Flavor. Just as with a scent or fragrance, a flavor can never be inherently distinctive. *In re N.V. Organon,* 79 USPQ2d 1639 (TTAB 2006) (affirming refusal to register "an orange flavor" for "pharmaceuticals for human use, namely, antidepressants in quick-dissolving tablets and pills," on the grounds that the proposed mark was functional under §2(e)(5) and failed to function as a mark within the meaning of §§1, 2, and 45 of the Trademark Act.). The Board has observed that it is unclear how a flavor could function as a source indicator because flavor or taste generally performs a utilitarian function and consumers generally have no access to a product's flavor or taste prior to purchase. *Id.* Thus, an application to register a flavor "requires a substantial showing of acquired distinctiveness." *Id.*

Detailed Description of the Mark Required. The requirement for a drawing does not apply to non-visual marks. For these types of marks, the applicant must submit a detailed written description of the mark that clearly explains the sound, scent, or other non-visual matter. 37 C.F.R. §2.52(e). In a TEAS application, the required description of the mark should be set forth in the "Description of the Mark" field. *See* **TMEP §807.09** regarding validating and submitting electronic applications for non-visual marks.

1202.14 Holograms

A hologram used in varying forms does not function as a mark in the absence of evidence that consumers would perceive it as a trademark. *See In re Upper Deck Co.*, 59 USPQ2d 1688 (TTAB 2001), where the Board held that a hologram used on trading cards in varying shapes, sizes, and positions did not function as a mark, because the record showed that other companies used holograms on trading cards and other products as anti-counterfeiting devices, and there was no evidence that the public would perceive applicant's hologram as an indicator of source. The Board noted that "the common use of holograms for non-trademark purposes means that consumers would be less likely to perceive applicant's uses of holograms as trademarks." 59 USPQ2d at 1693.

Therefore, in the absence of evidence of consumer recognition as a mark, the examining attorney should refuse registration on the ground that the hologram does not function as a mark, under §§1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127.

Generally, if a hologram has two or more views, the examining attorney should also refuse registration under §§1 and 45 of the Trademark Act, 15 U.S.C. §§1051 and 1127, on the ground that the application seeks registration of more than one mark. *In re Upper Deck, supra. See* **TMEP §807.01.**

1202.15 Sound Marks

A sound mark identifies and distinguishes a product or service through audio rather than visual means. Sound marks function as source indicators when they "assume a definitive shape or arrangement" and "create in the hearer's mind an association of the sound" with a good or service. *In re General Electric Broadcasting Co., Inc.,* 199 USPQ 560, 563 (TTAB 1978). Thus, sounds may be registered on the Principal Register when they are "arbitrary, unique, or distinctive and can be used in a manner so as to attach to the mind of the listener and be awakened on later hearing in a way that would indicate for the listener that a particular product or service was coming from a particular, even if anonymous, source." *In re Vertex Group LLC*, 89 USPQ2d 1694, 1700 (TTAB 2009). Examples of sound marks include: (1) a series of tones or musical notes, with or without words; and (2) wording accompanied by music.

There is, however, a difference between unique, different, or distinctive sounds and those that resemble or imitate "commonplace" sounds or those to which listeners have been exposed under different circumstances, which must be shown to have acquired distinctiveness. *In re General Electric Broadcasting Co., Inc.,* 199 USPQ 560, 563 (TTAB 1978). An example of this type of mark is a sound for goods that make the sound in their normal course of operation (e.g., alarm clocks, appliances that include audible alarms or signals, telephones, and personal security alarms). Therefore, sound marks for goods that make the sound in their normal course of operation can be registered only on a showing of acquired distinctiveness under §2(f). *Nextel Communications, Inc. v. Motorola, Inc.,* 91 USPQ2d 1393 (TTAB 2009) (cellular telephones that emit a "chirp" sound fall into the category of goods that make the sound in their normal course of operation); *Vertex,* 89 USPQ2d at 1700, 1702.

Detailed Description of the Mark Required. The requirement for a drawing does not apply to sound marks. Instead, the applicant must submit a detailed description of the mark. 37 C.F.R. §2.52(e). If the sound mark includes words or lyrics, they should be included in the description. *See* **TMEP §807.09.**

Audio or Video Reproduction of the Mark. To supplement and clarify the description, the applicant should also submit an audio or video reproduction of any sound mark sought to be registered. 37 C.F.R. §2.61(b). This reproduction should contain only the mark itself; it is not meant to be a specimen.

For paper filings, reproductions of sound marks must be submitted on compact discs ("CDs"), digital video discs ("DVDs"), audiotapes, or videotapes. *See* **TMEP §904.03(d).** The applicant should clearly and explicitly indicate that the reproduction of the mark contained on the disc or tape is meant to supplement the mark description and that it should be placed in the paper file jacket and not be discarded.

For TEAS filings, the reproductions must be in an electronic file, in .wav, .wmv, .wma, .mp3, .mpg, or .avi format. However, TEAS does not permit direct attachment of these types of electronic files. Therefore, the electronic reproduction must be sent after the TEAS document is transmitted, as an attachment to an e-mail message directed to **TEAS@uspto.gov**, with clear instructions that the electronic reproduction should be associated with "the application filed under Serial No. <specify>" as a supplement to the mark description.

Specimen. The specimen is not the same as the reproduction required to supplement and clarify the description of the mark. *See* **TMEP §807.09.** To show that the sound mark actually identifies and distinguishes the goods/services and indicates their source, the specimen should contain a sufficient portion of the audio or video content to show how the mark is used on or in connection with the goods/services.

For paper filings, specimens for sound marks must be submitted on audio CDs, DVDs, audiotapes, or videotapes. 37 C.F.R. §2.56(d)(3). The applicant should clearly and explicitly indicate that the CD, DVD, audiotape, or videotape is a specimen for a sound mark, and that it should be forwarded to the examining attorney and not be discarded.

For TEAS filings, the specimen must be in an electronic file, in .wav, wmv, .wma, .mp3, .mpg, or .avi format. When filing an application, allegation of use, response to an Office action, or §8 affidavit through TEAS, an audio or video reproduction file cannot be sent as an attachment. Therefore, the USPTO has developed a special procedure for handling these files. The electronic specimen must be sent after the TEAS document is transmitted, as an attachment to an e-mail message directed to **TEAS@uspto.gov**, with clear instructions that the electronic specimen should be associated with "the application/registration filed under Serial No./Registration No. <specify>."

For any filing where a specimen is required, the TEAS form only validates if there is an attachment in the "Specimen" field. Therefore, in conjunction with the workaround identified above, the applicant should create a .jpg or .pdf file that states that an electronic specimen will be sent to **TEAS@uspto.gov**, and attach the .jpg or .pdf file to the TEAS document in the "Specimen" field.

If the mark comprises music or words set to music, the applicant may also be required to submit the musical score sheet music to supplement and clarify the description of the mark. *See* **TMEP §807.09.**

Checklist. To expedite examination, when filing a sound mark application, the applicant should submit:

- An indication that the application is for a "NON-VISUAL MARK." *See* **TMEP §807.09**;
- A detailed description of the mark, including any words or lyrics;
- An audio or video reproduction of the mark, to supplement the description. For paper files, include explicit instructions that the reproduction be placed in the paper file and not discarded. *See* **TMEP §807.09**;
- In an application under §1, a separate audio or video reproduction, as a specimen, showing how the mark is used on or in connection with the goods/services. In a §1(b) application, the specimen must be submitted with the allegation of use. In either case, for paper files, include explicit instructions that the CD, DVD, audiotape, or videotape be placed in the paper file and not discarded. *See* **TMEP §904.03(f)**; and
- If the mark comprises music or words set to music, the applicant should generally submit the musical score sheet music. *See* **TMEP §807.09.**

1202.16 Model or Grade Designations

Subject matter used solely as a model, style, or grade designation within a product line does not function as a trademark. *In re Dana Corp.*, 12 USPQ2d 1748 (TTAB 1989) (alphanumeric designations, such as "5-469X," held unregistrable for universal joint couplings; evidence insufficient to establish distinctiveness and recognition as a mark). *Cf. In re Clairol Inc.*, 457 F.2d 509, 173 USPQ 355 (C.C.P.A. 1972) (SWEDISH CRYSTAL found to be a registrable trademark, not merely a color designation, for a hair coloring preparation, the Court relying on the arbitrariness of the mark, its manner of use and the fact that it was always used in addition to a shade designation); *In re Petersen Mfg. Co., Inc.,* 229 USPQ 466, 468 (TTAB 1986) (letter-number combinations found registrable for locking hand tools, the Board stating, "[T]here is no question that such model designations can, through use and promotion, be perceived as marks indicating origin in addition to functioning as model designations.").

1203 Refusal on Basis of Immoral or Scandalous Matter; Deceptive Matter; Matter which May Disparage, Falsely Suggest a Connection, or Bring into Contempt or Disrepute

Extract from 15 U.S.C. §1052. No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it–

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 2(9) of the Uruguay Round Agreements Act) enters into force with respect to the United States.

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The provisions of 15 U.S.C. §1052(a) apply to both the Principal Register and the Supplemental Register.

1203.01 Immoral or Scandalous Matter

Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), is an absolute bar to the registration of immoral or scandalous matter on either the Principal Register or the Supplemental Register.

Although the words "immoral" and "scandalous" may have somewhat different connotations, case law has included immoral matter in the same category as scandalous matter. *See In re McGinley*, 660 F.2d 481, 484 n.6, 211 USPQ 668, 672 n.6 (C.C.P.A. 1981), *aff'g* 206 USPQ 753 (TTAB 1979) ("Because of our holding, *infra*, that appellant's mark is 'scandalous,' it is unnecessary to consider whether appellant's mark is 'immoral.' We note the dearth of reported trademark decisions in which the term 'immoral' has been directly applied.")

The prohibition against the registration of marks that consist of or comprise immoral or scandalous matter was originally enacted as §5(a) of the Trademark Act of 1905, and was reenacted as part of §2(a) of the Act of 1946. There is little legislative history concerning the intent of Congress with regard to the provision; therefore, the term "scandalous" is interpreted by looking to "its ordinary and common meaning." *In re Riverbank Canning Co.*, 95 F.2d 327, 328, 37 USPQ 268, 269 (C.C.P.A. 1938). This may be established by referring to court decisions, decisions of the Trademark Trial and Appeal Board and dictionary definitions. *McGinley*, 660 F.2d at 485, 211 USPQ at 673.

In affirming a refusal to register a mark as scandalous under §2(a), the Court of Customs and Patent Appeals noted dictionary entries that defined "scandalous" as, *inter alia*, shocking to the sense of propriety, offensive to the conscience or moral feelings or calling out for condemnation. *McGinley*, 660 F.2d at 486, 211 USPQ at 673 (mark comprising a photograph of a nude, reclining man and woman, kissing and embracing, for a "newsletter devoted to social and interpersonal relationship topics" and for "social club services," held scandalous). The statutory language "scandalous" has also been considered to encompass matter that is "vulgar," defined as "lacking in taste, indelicate, morally crude." *In re Runsdorf,* 171 USPQ 443, 444 (TTAB 1971).

The meaning imparted by a mark must be determined in the context of the current attitudes of the day. *See In re Mavety Media Group Ltd.*, 33 F.3d 1367, 31 USPQ2d 1923 (Fed. Cir. 1994) (evidence found insufficient to establish that BLACK TAIL used on adult entertainment magazines comprises scandalous matter; court noted that there were both vulgar and non-vulgar definitions of "tail," and that the record was devoid of evidence demonstrating which of these definitions a substantial composite of the general public would choose in the context of the relevant marketplace); *In re Old Glory Condom Corp.*, 26 USPQ2d 1216 (TTAB 1993) (OLD GLORY CONDOM CORP and design comprising the representation of a condom decorated with stars and stripes in a manner to suggest the American flag held not to be scandalous); *In re Thomas Laboratories, Inc*., 189 USPQ 50, 52 (TTAB 1975) ("[I]t is imperative that fullest consideration be given to the moral values and conduct which contemporary society has deemed to be appropriate and acceptable.")

The determination of whether a mark is scandalous must be made in the context of the relevant marketplace for the goods or services identified in the application, and must be ascertained from the standpoint of not necessarily a majority, but a "substantial composite of the general public." *McGinley*, 660 F.2d at 485, 211 USPQ at 673 ("[T]he Lanham Act does not require, under the rubric of 'scandalous,' any inquiry into the specific goods or services not shown in the application itself."); *In re Wilcher Corp.*, 40 USPQ2d 1929 (TTAB 1996) (mark for restaurant and bar services consisting of words DICK HEADS positioned directly underneath caricature of a human head composed primarily of graphic and readily recognizable representation of male genitalia held scandalous, as it would be considered offensive by a substantial portion of the public); *Greyhound Corp. v. Both Worlds Inc.*, 6 USPQ2d 1635, 1639 (TTAB 1988) (graphic design of a dog defecating, as applied to polo shirts and T-shirts, held scandalous, given the broad potential audience that may view applicant's mark in sales establishments and "virtually all public places"); *In re Hepperle,* 175 USPQ 512 (TTAB 1972) (while the words might be a reference to marijuana, ACAPULCO GOLD found not scandalous when used as a mark for suntan lotion).

Therefore, to support a refusal on the ground that a proposed mark is immoral or scandalous, the examining attorney must provide evidence that a substantial portion of the general public would consider the mark to be scandalous in the context of contemporary attitudes and the relevant marketplace. *Mavety Media,* 33 F.3d at 1371-1372, 31 USPQ2d at 1925. This evidence could include dictionary definitions, newspaper articles, and magazine articles. The examining attorney should not rely solely on an earlier decision holding a term to be scandalous in support of a refusal. The Trademark Trial and Appeal Board has held that an earlier decision is insufficient to warrant the same finding in a future case. *In re Red Bull GmbH,* 78 USPQ2d 1375 (TTAB 2006) (rejecting examining attorney's argument that the Board's 1981 decision in *In re Tinseltown, Inc.,* 212 USPQ 863 (TTAB 1981) finding BULLSHIT to be scandalous is sufficient to warrant the same finding in a later case). Rather, the facts underlying the earlier decision must be looked at to determine, first, whether it has any relevance to the present case, and, if so, whether that earlier finding is equally applicable today, for example, by looking at other evidence such as recent dictionary definitions. *Red Bull* at 1381.

Dictionary definitions alone may be sufficient to establish that a proposed mark comprises scandalous matter, where multiple dictionaries, including at least one standard dictionary, all indicate that a word is vulgar, and the applicant's use of the word is limited to the vulgar meaning of the word. *In re Boulevard Entertainment, Inc.,* 334 F.3d 1336, 67 USPQ2d 1475 (Fed. Cir. 2003) (1-800-JACK-OFF and JACK OFF held scandalous, where all dictionary definitions of "jack-off" were considered vulgar); *Boston Red Sox Baseball Club Limited Partnership v. Sherman*, 88 USPQ2d 1581 (TTAB 2008) (Board sustained opposition finding that SEX ROD was immoral and scandalous under §2(a) based on dictionary definitions designating the term "ROD" as being vulgar, and applicant's admission that SEX ROD had a sexual connotation); *Red Bull, supra* (multiple dictionary definitions indicating BULLSHIT is "obscene," "vulgar," "usually vulgar," "vulgar slang," or "rude slang" constitute a prima facie showing that the term is offensive to the conscience of a substantial composite of the general public).

It has been noted that the threshold is lower for what can be described as "scandalous" than for "obscene." Refusal to register immoral or scandalous matter has been found not to abridge First Amendment rights, because no conduct is proscribed and no tangible form of expression is suppressed. Also, the term "scandalous" has been held sufficiently precise to satisfy due process requirements under the Fifth Amendment. *McGinley*, 660 F.2d at 484-85, 211 USPQ at 672.

The prohibition in §2(a) of the Act against the registration of scandalous matter pertains only to *marks* that are scandalous. The authority of the Act does not extend to goods that may be scandalous. *See In re Madsen*, 180 USPQ 334, 335 (TTAB 1973) (WEEK-END SEX for magazines held not scandalous, the Board observing that whether the magazine contents may be pornographic was not an issue before the Board).

The examining attorney may look to the specimen(s) or other aspects of the record to determine how the mark will be seen in the marketplace. *See McGinley,* 660 F.2d at 482 n.3, 211 USPQ at 670 n.3 (containing excerpts from appellant's newsletters pertaining to their subject matter); *In re Hershey*, 6 USPQ2d 1470, 1472 (TTAB 1988) (BIG PECKER BRAND for T-shirts found not scandalous, the Board considering the labels that were submitted as specimens in determining the question of how the mark might be perceived. "[T]he inclusion of the bird design would make it less likely that purchasers would attribute any vulgar connotation to the word mark and we note that it is proper to look to the specimens of record to determine connotation or meaning of a mark.")

To ensure consistency in examination with respect to immoral or scandalous matter, when an examining attorney believes, for whatever reason, that a mark may be considered to comprise such matter, the examining attorney must consult with his or her supervisor.

1203.02 Deceptive Matter

Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), is an absolute bar to the registration of deceptive matter on either the Principal Register or the Supplemental Register. Neither a disclaimer of the deceptive matter nor a claim that it has acquired distinctiveness under §2(f) can obviate a refusal under §2(a) on the ground that the mark consists of or comprises deceptive matter. *See American Speech-Language-Hearing Ass'n v. National Hearing Aid Society*, 224 USPQ 798, 808 (TTAB 1984); *In re Charles S. Loeb Pipes, Inc.*, 190 USPQ 238, 241 (TTAB 1975).

1203.02(a) Types of Deceptive Marks

A deceptive mark may be comprised of: (1) a single deceptive term; (2) a deceptive term embedded in a composite mark that includes additional non-deceptive wording and/or design elements; (3) a term or a portion of a term that alludes to a deceptive quality, characteristic, function, composition, or use (*see American Speech-Language-Hearing Ass'n v. National Hearing Aid Society*, 224 USPQ 798, 808 (TTAB 1984)); (4) the phonetic equivalent of a deceptive term (*see In re Organik Technologies, Inc*., 41 USPQ2d 1690 (TTAB 1997); *Tanners' Council of America, Inc. v. Samsonite Corp*., 204 USPQ 150 (TTAB 1979); or (5) the foreign equivalent of any of the above (*see, e.g., Palm Bay Imps., v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1377, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005). Although there is no published Board or Federal Circuit decision regarding whether a mark consisting solely of a design can be deceptive, if there is evidence to support such a refusal, it should be issued.

Deceptive marks may include marks that falsely describe the material content of a product (*see In re Intex Plastics Corp.,* 215 USPQ 1045 (TTAB 1982)) and marks that are geographically deceptive (*see Stabilisierungsfonds fur Wein v. Peter Meyer Winery GmbH*, 9 USPQ2d 1073 (TTAB 1988); *In re House of Windsor, Inc.*, 221 USPQ 53 (TTAB 1983), *recon. denied*, 223 USPQ 191 (TTAB 1984)). *See* **TMEP §§1210.05** *et seq.* regarding geographically deceptive marks.

However, marks containing a term identifying a material, ingredient, or feature should not be refused registration under §2(a) if the mark in its entirety would not be perceived as indicating that the goods contained that material or ingredient. For example, the mark COPY CALF was found not deceptive for wallets and billfolds of synthetic and plastic material made to simulate leather, because it was an obvious play on the expression "copy cat" and suggested to purchasers that the goods were imitations of items made of calf skin. *See A. F. Gallun & Sons Corp. v. Aristocrat Leather Products, Inc* ., 135 USPQ 459 (TTAB

1962). Note, however, the difference with such marks as TEXHYDE and SOFTHIDE, which were held deceptive as applied to synthetic fabric and imitation leather material, respectively. *See Intex Plastics*, *supra*; *Tanners' Council of Am* ., *supra*.

In addition, formatives and other grammatical variations of a term may not necessarily be deceptive in relation to the relevant goods. For example, "silky" is defined, *inter alia*, as "resembling silk." Thus, a mark containing the term SILKY would not be considered deceptive (but might be unregistrable under §2(e)(1)). Dictionary definitions of such terms should be carefully reviewed to determine the significance the term would have to prospective purchasers. For example, although the term GOLD would be considered deceptive for jewelry not made of gold, the term GOLDEN would not be deceptive.

1203.02(b) Elements of a §2(a) Deceptiveness Refusal

The Court of Appeals for the Federal Circuit has articulated the following test for whether a mark consists of or comprises deceptive matter:

(1) Is the term misdescriptive of the character, quality, function, composition or use of the goods?

(2) If so, are prospective purchasers likely to believe that the misdescription actually describes the goods?

(3) If so, is the misdescription likely to affect a significant portion of the relevant consumers' decision to purchase?

In re Spirits Int'l, N.V., 563 F.3d 1347, 90 USPQ2d 1589 (Fed. Cir. 2009); *In re Budge Mfg. Co. Inc.*, 857 F.2d 773, 775, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988), *aff'g* 8 USPQ2d 1790 (TTAB 1987).

1203.02(c) Distinction between Marks Comprising Deceptive Matter (§2(a)) and Deceptively Misdescriptive Marks (§2(e)(1))

If the first two inquiries set forth by the Federal Circuit in *In re Budge Mfg. Co. Inc.*, 857 F.2d 773, 775, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988) (i.e., whether a mark is misdescriptive of the goods/services and whether prospective purchasers are likely to believe the misdescription) are answered affirmatively, the mark is deceptively misdescriptive of the goods/services under §2(e)(1). *See* **TMEP §1209.04** regarding deceptively misdescriptive marks.

The third inquiry, whether the misdescription is likely to affect the decision to purchase, distinguishes marks that are deceptive under §2(a) from marks that are deceptively misdescriptive under §2(e)(1). To be deceptively misdescriptive under §2(e)(1), the misdescription must concern a feature that would be relevant to the decision to purchase the goods or use the services. If the misdescription is more than simply a relevant factor that may be considered in purchasing decisions, but is a material factor, the mark would be deceptive under §2(a) of the Trademark Act, 15 U.S.C. §1052(a). *See In re Shniberg*, 79 USPQ2d 1309 (TTAB 2006). *See* **TMEP §1209.04** regarding establishing deceptive misdescriptiveness and **TMEP §1203.02(d)** regarding determining materiality.

If it is difficult to determine whether misdescriptive matter would materially affect a decision to purchase, the examining attorney should refuse registration under both §§2(a) and 2(e)(1). *See, e.g., Gold Seal Co. v. Weeks*, 129 F. Supp. 928, 105 USPQ 407 (D.D.C. 1955), *aff'd sub nom. S. C. Johnson & Son, Inc. v. Gold Seal Co.*, 230 F.2d 832, 108 USPQ 400 (D.C. Cir. 1956) (per curiam), *cert. denied,* 352 U.S. 829, 111 USPQ 467 (1956), *superseded by statute on other grounds as stated in Aktieselskabet AF 21. November 2001 v. Fame Jeans Inc.,* 525 F.3d 8, 86 USPQ2d 1527, 1532 (D.C. Cir. 2008). *See also R. Neumann & Co. v. Overseas Shipments, Inc.*, 326 F.2d 786, 140 USPQ 276 (C.C.P.A. 1964), and *Stabilisierungsfonds fur Wein v. Peter Meyer Winery GmbH*, 9 USPQ2d 1073 (TTAB 1988), in which third parties filed oppositions based on both statutory sections. *See* **TMEP §1203.02(e)** regarding procedures for issuing deceptiveness refusals under §2(a).

Marks that are deceptive under §2(a) are unregistrable on either the Principal Register or the Supplemental Register, whereas marks that are deceptively misdescriptive under §2(e)(1) may be registrable on the Principal Register with a showing of acquired distinctiveness under §2(f), 15 U.S.C. §1052(f), or on the Supplemental Register, if appropriate.

See **TMEP §1210.05(c)** regarding the distinction between marks comprising deceptive matter under §2(a) and matter that is primarily geographically deceptively misdescriptive under §2(e)(3).

1203.02(d) Determining Materiality

To establish a prima facie case of deceptiveness, the examining attorney must provide sufficient evidence that the misdescriptive quality or characteristic would be a material factor in the purchasing decision of a significant portion of the relevant consumers. To do so, the examining attorney must provide evidence that the misdescriptive quality or characteristic would make the product or service more appealing or desirable to prospective purchasers. *In re Juleigh Jeans Sportswear Inc*., 24 USPQ2d 1694 (TTAB 1992). A product or service is usually more desirable because of objective standards or criteria that provide an objective inducement to purchase the goods and/or services beyond that of mere personal preference.

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1203.02(d)(i) Objective Criteria

In assessing whether a misdescription would affect the decision to purchase, the following are examples (not a comprehensive list) of the type of objective criteria that should be used to analyze whether a term is a material factor. The evidence may often point to more than one characteristic, thereby strengthening the examining attorney's prima facie case. For example, the evidence may show that goods deemed "organic" because they are produced in compliance with objective criteria can also be more costly, provide health benefits, and satisfy a social policy of reducing the impact on the environment by utilizing chemical-free growing practices. The evidence also must suffice to indicate that the misdescriptive quality or characteristic would affect the purchasing decision of a significant portion of the relevant consumers. *In re Spirits Int'l, N.V.*, 563 F.3d 1347, 90 USPQ2d 1489 (Fed. Cir. 2009). Generally, evidence of the objective inducement to purchase supports a presumption that a significant portion of the relevant consumers would likely be deceived.

Superior Quality - The evidence must support a finding that goods or services that contain or feature the misdescriptive term are superior in quality to similar goods and/or services that do not. For example, silk can be shown to be a more luxurious and expensive material because of the difficulty in making silk, its unique feel, and its breathability. Similarly, cedar wood can be shown to have superior durability and resistance to decay.

Enhanced Performance or Function - The evidence must support a finding that goods possessing the characteristic or feature at issue are superior to those that do not. For example, certain wood species are naturally resistant to termite attack or may be more durable than others. There might also be evidence of an increasing interest in reducing the potential leaching of chemicals from treated wood into the environment.

Difference in Price - Evidence of a price differential between items that do and those that do not possess the feature or characteristic described by the misdescriptive term may be enough to support a §2(a) refusal, depending upon the nature of the goods or services. It is also important to remember that because a difference in price is relative to the goods and/or services in a particular industry, a particular term may be deceptive for goods and services that are not typically thought of as luxury items.

Health Benefit - The evidence must establish a belief that the feature or characteristic provides a health benefit.

Religious Practice or Social Policy - The evidence must show that the religious practice or social policy has definable recognized criteria for compliance in order to support a finding of deceptiveness when the criteria are not adhered to by the applicant. For example, a body of Jewish law deals with what foods can and cannot be eaten and how those foods must be prepared and eaten. The term "kosher" refers to food prepared in accordance with these standards as well as to the selling or serving of such food. *See The American Heritage® Dictionary of the English Language: Fourth Ed*. 2000. Another example is the term "vegan," which is defined as someone who eats plant products only and who uses no products derived from animals, such as fur or leather . *Id.*

The evidence necessary to establish deceptiveness can come from the same sources used to show that the term is misdescriptive. Internet searches that combine the deceptive term with terms such as "desirable," "superior," "premium," "better quality," "sought after," "more expensive," or "established standards" may be useful in seeking evidence to support the second and third prongs of the test.

Applicant's own advertising - in the form of specimens, brochures, web pages, press releases, or product and service information sheets - may provide the best evidence of deceptiveness. Moreover, the examining attorney should make of record any instances where the applicant attempts to benefit from the potentially deceptive term and where the advertising includes false assertions related to the deceptive wording. Although not a requirement for a deceptive refusal, proof of an actual intent to deceive may be considered strong evidence of deceptiveness.

1203.02(d)(ii) Mere Personal Preference

The types of objective criteria discussed above can be contrasted with mere personal preferences for which the requisite evidentiary support generally cannot be found to establish materiality. For example, SPEARMINT for gum, LAVENDER for dish soap, and BLUE for bicycles refer to flavor, scent, and color features that, in those contexts, most likely reflect mere personal preferences which would not be considered material for purposes of a deceptiveness refusal.

Similarly, personal preferences regarding types of cuisine served at restaurants (e.g., SEAFOOD or PIZZA) generally do not establish materiality absent evidence that the type of cuisine meets some objective criteria more in line with those listed above, such as for VEGAN or KOSHER.

Whether the requisite evidentiary support can be found to establish that the use of such terms in connection with goods/services that do not contain or feature the characteristic is deceptively misdescriptive under §2(e)(1) must be determined on a case-by-case basis.

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1203.02(e) Procedures for Issuing §2(a) Deceptive Refusals

1203.02(e)(i) When the Mark is Clearly Misdescriptive

If there is evidence in the record clearly indicating that the mark or a term(s) in the mark is misdescriptive (e.g., the specimen or language in the identification indicates that the goods/services do not have the relevant feature or characteristic), the examining attorney must determine whether the misdescription is believable and material and do the following:

- If the misdescription would not be believable, no refusal under either §2(a) or §2(e)(1) should be made. If the application is otherwise in condition for publication, approve the mark for publication. Otherwise, issue an Office action containing all other relevant refusals and/or requirements.
- If the misdescription would be believable, but would not be material, issue a refusal under §2(e)(1) as deceptively misdescriptive (or disclaimer requirement if appropriate, i.e., if the term at issue is not part of a unitary expression), with supporting evidence, and all other relevant refusals and/or requirements.
- If the misdescription would be believable and material, issue a deceptiveness refusal under §2(a) with supporting evidence, an alternative refusal under §2(e)(1) as deceptively misdescriptive (or disclaimer requirement if appropriate), and all other relevant refusals and/or requirements.

1203.02(e)(ii) When It is Not Clear Whether the Mark is Misdescriptive

When a mark comprises or contains descriptive wording, but it is not clear whether the goods/services possess the relevant feature or characteristic, the examining attorney must first determine whether such feature or characteristic would be believable and material to the decision to purchase.

If the goods possess the relevant feature or characteristic and the feature or characteristic referenced by the mark would be believable and material, the identification must include the feature or characteristic in order to resolve the ambiguity between the mark and the identification of goods/services. The identification must be amended even if the record indicates elsewhere that the goods/services contain the feature or characteristic. Therefore, if the application could otherwise be put in condition for approval for publication by an examiner's amendment (*see* **TMEP §707)**, to expedite prosecution, the examining attorney should:

- Attempt to contact the applicant to obtain authorization for a disclaimer and an amendment to the identification to include the feature or characteristic, and for any other amendments that would put the application in condition for approval for publication.
- If the applicant states that the goods/services do not possess the feature or characteristic, the examining attorney must so indicate in a note in the "Notes-to-the-File" section of the record, and must then issue a refusal under §2(e)(1) as deceptively misdescriptive (if believable but not material), or disclaimer requirement if appropriate, or a refusal under §2(a) as deceptive (if believable and material) and an alternative refusal under §2(e)(1), or disclaimer requirement if appropriate, as deceptively misdescriptive, and make all other relevant requirements.
- To ensure the completeness of the record in the event of an appeal, any Office action issued must also include an information request under 37 C.F.R. §2.61(b), asking whether the goods/services possess the feature or characteristic.

If the examining attorney is unable to reach the applicant or cannot obtain authorization for an examiner's amendment, or if an Office action is otherwise necessary to make substantive refusals or requirements that cannot be satisfied by examiner's amendment, the examining attorney must:

- Issue a refusal under §2(e)(1) as descriptive (or a requirement for a disclaimer, if appropriate), based on the presumption that the goods/services possess the feature or characteristic, and a requirement that the applicant amend the identification to include the feature or characteristic, if accurate; and
- If the misdescription would be believable and material, issue an alternative refusal under §2(a) as deceptive, based on the presumption that the goods/services do not possess the relevant feature or characteristic, and supported by evidence; and
- Issue an alternative refusal under §2(e)(1) as deceptively misdescriptive, or disclaimer requirement if appropriate, based on the presumption that the goods/services do not possess the relevant feature or characteristic (the presumption is made even if the record indicates that the goods/services contain the feature because the identification does not include the feature); and

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- Issue any other relevant refusals and requirements; and
- Issue an information request under 37 C.F.R. §2.61(b), asking whether the goods/services possess the feature or characteristic. This written request is made to ensure the completeness of the record in the event of an appeal.

See, e.g., In re Cheezwhse.com, Inc., 85 USPQ2d 1917 (TTAB 2008) (NORMANDIE CAMEMBERT held primarily geographically descriptive or, in the alternative, primarily geographically deceptively misdescriptive for cheese; the applicant failed to respond to a 37 C.F.R. §2.61(b) information request as to the origin of the goods).

1203.02(f) Responding to a §2(a) Deceptiveness Refusal

1203.02(f)(i) Amending the Identification of Goods or Services

If the applicant amends the identification to include the potentially deceptive term, the USPTO will rely on the presumption that the goods contain a sufficient amount of the material to obviate deceptiveness; there is no requirement to substantiate the amount or percentage of the material or feature in the goods. Thus, the applicant may amend “ties” to “silk ties,” “milk and cheese” to “organic milk and cheese,” and “jewelry” to “gold jewelry” or to “jewelry made in whole or significant part of gold.”

Amending an identification of services to add “featuring” or “including” a material term (e.g., “restaurants featuring organic cuisine” and “retail furniture stores including leather furniture”) generally is sufficient to obviate deceptiveness. For example, as long as the identification indicates that the restaurant provides organic cuisine, or the furniture store sells leather furniture, there is no deception even if other types of food or furniture are also available.

1203.02(f)(ii) Other Arguments

Applicants may attempt to overcome a §2(a) refusal by providing evidence that applicant’s advertising, or other means, would make consumers aware of the misdescription. Neither evidence regarding advertising, labeling, or extent of use, nor information found on the specimens, can negate the misdescriptiveness with regard to use of the mark in relation to the goods or services. In addition, an applicant’s anecdotal or past practices and “explanatory statements in advertising or on labels which purchasers may or may not note and which may or may not always be provided” are of little value in the deceptiveness analysis. *See In re Budge Mfg. Co. Inc.,* 857 F.2d 773, 775-776, 8 USPQ2d 1259, 1261 (Fed. Cir. 1988).

However, in some cases, the applicant may be able to provide credible evidence that consumers would not expect goods sold under a certain mark to actually consist of or contain the feature or characteristic named in the mark. *See, e.g., In re Robert Simmons, Inc.,* 192 USPQ 331 (TTAB 1976)(holding that WHITE SABLE is not deceptive on artist's paint brushes).

The argument that there is no deception because consumers will immediately discern the true nature of the goods and/or services when they encounter them is not persuasive. Deception can attach prior to seeing or encountering the goods or services, for example, based on advertising over the radio or Internet or via word of mouth. *See In re ALP of South Beach, Inc.,* 79 USPQ2d 1009, 1014 (TTAB 2006).

As noted above, marks that are deceptive under §2(a) are never registrable on either the Principal Register, even under §2(f) or the Supplemental Register. However, applicants may present evidence of a similar nature to what is often submitted for acquired distinctiveness, such as declarations regarding how the mark is perceived by consumers, as rebuttal evidence to the prima facie case, in an effort to overcome one or all of the prongs of the §2(a) test. *See In re Woolrich Woolen Mills Inc.,* 13 USPQ2d 1235, 1238 (TTAB 1989). Note that merely relying on the length of use, without providing other information or evidence, would never be sufficient to overcome a §2(a) refusal.

The fact that only those knowledgeable in the relevant trade, and not average purchasers, would be deceived does not preclude a finding that a mark comprises deceptive matter. *In re House of Windsor, Inc.*, 223 USPQ 191, 192 (TTAB 1984).

1203.02(g) Deceptive Matter: Case References

In the following cases, proposed marks were determined to be deceptive, under §2(a): *In re Budge Mfg. Co. Inc.,* 857 F.2d 773, 8 USPQ2d 1259 (Fed. Cir. 1988), *aff’g* 8 USPQ2d 1790 (TTAB 1987) (LOVEE LAMB held deceptive for seat covers not made of lambskin); *In re ALP of South Beach Inc*., 79 USPQ2d 1009 (TTAB 2006) (CAFETERIA (stylized) held deceptive as used in connection with “restaurants providing full service to sit-down patrons, excluding cafeteria-style restaurants”); *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047 (TTAB 2002) (SUPER SILK held deceptive for “clothing, namely dress shirts and sport shirts made of silk-like fabric”); *In re Organik Technologies, Inc.,* 41 USPQ2d 1690 (TTAB 1997) (ORGANIK deceptive for clothing and textiles made from cotton that is neither from an organically grown plant nor free of chemical processing or treatment, notwithstanding applicant’s assertions that the goods are manufactured by a process that avoids the use of chemical bleaches, because the identification of goods was broad enough to include textiles and clothing manufactured with chemical processes or dyes); *In re Juleigh Jeans Sportswear Inc*., 24 USPQ2d 1694 (TTAB 1992) (LONDON LONDON held deceptive for clothing

having no connection with London); *In re Perry Mfg. Co.,* 12 USPQ2d 1751 (TTAB 1989) (PERRY NEW YORK and design of New York City skyline held deceptive for clothing originating in North Carolina, in view of the renown of New York City in the apparel industry); *Stabilisierungsfonds fur Wein v. Peter Meyer Winery GmbH*, 9 USPQ2d 1073, 1075 (TTAB 1988) (GOLDENER TROPFEN held deceptive for wines, in view of evidence of the international renown of the Goldtropfchen vineyard of West Germany, the Board finding that the purchasing public would be likely to think, mistakenly, that applicant's wines were produced from grapes grown there in accordance with German wine laws and regulations); *Bureau Nat'l Interprofessionnel Du Cognac v. International Better Drinks Corp.*, 6 USPQ2d 1610 (TTAB 1988) (COLAGNAC held deceptive for cola-flavored liqueur containing Spanish brandy, the Board concluding that purchasers were likely to believe that applicant's goods contained COGNAC brandy); *In re Shapely, Inc.*, 231 USPQ 72 (TTAB 1986) (SILKEASE held deceptive as applied to clothing not made of silk); *In re House of Windsor, Inc.*, 221 USPQ 53 (TTAB 1983), *recon. denied,* 223 USPQ 191 (TTAB 1984) (BAHIA held deceptive as applied to cigars having no connection with the Bahia province of Brazil, the record indicating that tobacco and cigars are important products in the Bahia region); *Evans Products Co. v. Boise Cascade Corp.*, 218 USPQ 160 (TTAB 1983) (CEDAR RIDGE held deceptive for embossed hardboard siding not made of cedar); *In re Intex Plastics Corp.*, 215 USPQ 1045 (TTAB 1982) (TEXHYDE held deceptive as applied to synthetic fabric for use in the manufacture of furniture, upholstery, luggage, and the like); *Tanners' Council of America, Inc. v. Samsonite Corp.*, 204 USPQ 150 (TTAB 1979) (SOFTHIDE held deceptive for imitation leather material); *In re Salem China Co.*, 157 USPQ 600 (TTAB 1968) (AMERICAN LIMOGES, used on dinnerware that was neither made in Limoges, France, nor made from Limoges clay, held deceptive because of the association of Limoges with fine quality china); *Company of Cutlers of Hallamshire in the County of York v. Regent-Sheffield, Ltd*., 155 USPQ 597 (TTAB 1967) (SHEFFIELD, used on cutlery not made in Sheffield, England, held deceptive because of the renowned status of Sheffield in relation to cutlery); *In re U.S. Plywood Corp.*, 138 USPQ 403 (TTAB 1963) (IVORY WOOD, for lumber and timber products, held deceptive since the goods were not made of ivorywood nor did they contain an ivorywood pattern).

Marks were found not to be deceptive in the following cases: *Philip Morris Inc. v. Reemtsma Cigarettenfabriken GmbH*, 14 USPQ2d 1487 (TTAB 1990) (PARK AVENUE held neither deceptive nor geographically deceptively misdescriptive as applied to applicant's cigarettes and smoking tobacco, the Board finding no goods/place association between Park Avenue in New York City, on which opposer's world headquarters was located, and tobacco products); *In re Woolrich Woolen Mills Inc*., 13 USPQ2d 1235 (TTAB 1989) (WOOLRICH for clothing not made of wool found not to be deceptive under §2(a)); *In re Fortune Star Products Corp.*, 217 USPQ 277 (TTAB 1982) (NIPPON, for radios, televisions, and the like, found not deceptive in relation to the goods because, although the applicant was an American firm, the goods were actually made in Japan); *In re Sweden Freezer Mfg. Co.*, 159 USPQ 246, 249 (TTAB 1968) (SWEDEN and design, for which registration was sought under §2(f) for external artificial kidney units, held not deceptive, the Board finding the case to be in the category "where a geographical trademark may involve a degree of untruth but the deception may be perfectly innocent, harmless or negligible"); *A. F. Gallun & Sons Corp. v. Aristocrat Leather Products, Inc.*, 135 USPQ 459 (TTAB 1962) (COPY CALF, for wallets and billfolds of synthetic and plastic material made to simulate leather, found not deceptive, the Board noting that the mark, as an obvious play on the expression "copy cat," suggested to purchasers that the goods were imitations of items made of calf skin).

1203.03 Matter which May Disparage, Falsely Suggest a Connection, or Bring into Contempt or Disrepute

Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), bars the registration on either the Principal or the Supplemental Register of a designation that consists of or comprises matter which, with regard to persons, institutions, beliefs, or national symbols, does any of the following: (1) disparages them; (2) falsely suggests a connection with them; (3) brings them into contempt; or (4) brings them into disrepute.

Section 2(a) is distinctly different from §2(d), 15 U.S.C. §1052(d), for which the relevant test is likelihood of confusion. In *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.,* 703 F.2d 1372, 1375-76, 217 USPQ 505, 508-09 (Fed. Cir. 1983), *aff'g* 213 USPQ 594 (TTAB 1982), the Court of Appeals for the Federal Circuit noted as follows:

> A reading of the legislative history with respect to what became §2(a) shows that the drafters were concerned with protecting the name of an individual or institution which was not a technical "trademark" or "trade name" upon which an objection could be made under §2(d)....
>
> Although not articulated as such, it appears that the drafters sought by §2(a) to embrace concepts of the right to privacy, an area of the law then in an embryonic state (footnote omitted). Our review of case law discloses that the elements of a claim of invasion of one's privacy have emerged as distinctly different from those of trademark or trade name infringement. There may be no likelihood of such confusion as to the source of goods even under a theory of "sponsorship" or "endorsement," and, nevertheless, one's right of privacy, or the related right of publicity, may be violated.

The right to privacy protects a party's control over the use of its identity or "persona." A party acquires a protectible interest in a name or equivalent designation under §2(a) where the name or designation is unmistakably associated with, and points uniquely to, that party's personality or "persona." A party's interest in a name or designation does not depend upon adoption

and use as a technical trademark or trade name. *University of Notre Dame du Lac,* 703 F.2d at 1376-77, 217 USPQ at 509; *Buffett v. Chi-Chi's, Inc.,* 226 USPQ 428, 429 (TTAB 1985). Section 2(a) protection is intended to prevent the unauthorized use of the persona of a person or institution and not to protect the public. *In re MC MC S.r.l.*, 88 USPQ2d 1378 (TTAB 2008).

See **TMEP §§1203.03(c)** and **1203.03(d)** regarding disparagement, bringing into contempt, and bringing into disrepute, and **TMEP §§1203.03(e)** and **1203.03(f)** regarding false suggestion of a connection.

See Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831, 218 USPQ 1 (6th Cir. 1983), concerning the various forms of identity which have been protected under the rights of privacy and publicity.

1203.03(a) "Persons" Defined

Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), protects, *inter alia*, "persons, living or dead."

Section 45 of the Act, 15 U.S.C. §1127, defines "person" and "juristic person" as follows:

> The term "person" and any other word or term used to designate the applicant or other entitled to a benefit or privilege or rendered liable under the provisions of this Act includes a juristic person as well as a natural person. The term "juristic person" includes a firm, corporation, union, association, or other organization capable of suing and being sued in a court of law.
>
> The term "person" also includes the United States, any agency or instrumentality thereof, or any individual, firm, or corporation acting for the United States and with the authorization and consent of the United States. The United States, any agency or instrumentality thereof, and any individual, firm, or corporation acting for the United States and with the authorization and consent of the United States, shall be subject to the provisions of this Act in the same manner and to the same extent as any nongovernmental entity.
>
> The term "person" also includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this Act in the same manner and to the same extent as any non-governmental entity.

The term "persons" in §2(a) refers to real persons, not fictitious characters. In addition to natural persons, it includes juristic persons, i.e., legally created entities such as firms, corporations, unions, associations, or any other organizations capable of suing and being sued in a court of law. *See Morehouse Mfg. Corp. v. J. Strickland & Co.,* 407 F.2d 881, 160 USPQ 715 (C.C.P.A. 1969); *Popular Merchandise Co. v. "21" Club, Inc.,* 343 F.2d 1011, 145 USPQ 203 (C.C.P.A. 1965); *John Walker & Sons, Ltd. v. American Tobacco Co.,* 110 USPQ 249 (Comm'r Pats. 1956); *Copacabana, Inc. v. Breslauer,* 101 USPQ 467 (Comm'r Pats. 1954).

With respect to natural persons, they may be living or dead. However, §2(a) may not be applicable with regard to a deceased person when there is no longer anyone entitled to assert a proprietary right or right of privacy. *Lucien Piccard Watch Corp. v. Since 1868 Crescent Corp.,* 314 F. Supp. 329, 165 USPQ 459 (S.D.N.Y. 1970) (DA VINCI held not to falsely suggest connection with deceased artist Leonardo Da Vinci); *In re MC MC S.r.l.*, 88 USPQ2d 1378 (TTAB 2008 (MARIA CALLAS did not falsely suggest a connection with deceased opera singer Maria Callas).

A juristic person's rights under §2(a) are extinguished when the juristic person ceases to exist. *In re Wielinski*, 49 USPQ2d 1754, 1758 (TTAB 1998) (*overruled on other grounds, In re WNBA Enterprise, LLC*, 70 USPQ2d 1153 (TTAB 2003)).

Juristic persons or institutions do not have to be well known to be protected from the registration of a mark that falsely suggests a connection with or disparages them, or brings them into contempt or disrepute. *Gavel Club v. Toastmasters Int'l*, 127 USPQ 88, 94 (TTAB 1960).

It is well settled that the United States Government is a juristic person. *See NASA v. Record Chemical Co. Inc.*, 185 USPQ 563, 566 (TTAB 1975), and cases cited therein.

A mark does not have to comprise a person's full or correct name to be unregistrable; a nickname or other designation by which a person is known by the public may be unregistrable under this provision of the Act. *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428, 430 (TTAB 1985) (evidence of record "sufficient to raise a genuine issue of material fact as to whether the term 'MARGARITAVILLE' is so uniquely and unmistakably associated with opposer as to constitute opposer's name or identity such that when applicant's mark is used in connection with its [restaurant] services, a connection with opposer would be assumed").

1203.03(b) "National Symbols" Defined

A "national symbol" is subject matter of unique and special significance that, because of its meaning, appearance, and/or

sound, immediately suggests or refers to the country for which it stands. *In re Consolidated Foods Corp.*, 187 USPQ 63 (TTAB 1975) (noted national symbols include the bald eagle, Statue of Liberty, American flag, Presidential symbol, designation "Uncle Sam" and the unique human representation thereof, and the heraldry and shield designs used in governmental offices). National symbols include the symbols of foreign countries as well as those of the United States. *In re Anti-Communist World Freedom Congress, Inc.*, 161 USPQ 304 (TTAB 1969).

The Trademark Act does not prohibit registration of marks comprising national symbols; it only prohibits registration of matter that may disparage national symbols, falsely suggest a connection with them, or hold them up to contempt or disrepute. *Liberty Mutual Insurance Co. v. Liberty Insurance Co. of Texas,* 185 F. Supp. 895, 908, 127 USPQ 312, 323 (E.D. Ark. 1960) (marks comprising portion of the Statue of Liberty found not to disparage, bring into contempt or disrepute, or falsely suggest a connection with the Statue of Liberty or the United States government, the Court "[a]ssuming without deciding" that the statue is a national symbol).

Designations have been held to be national symbols within the meaning of §2(a) in the following cases: *In re Anti-Communist World Freedom Congress, Inc.,* 161 USPQ 304 (TTAB 1969) (representation of a hammer and sickle held to be a national symbol of the Union of Soviet Socialist Republics (U.S.S.R.)); *In re National Collection & Credit Control, Inc.,* 152 USPQ 200, 201 n.2 (TTAB 1966) ("The American or bald eagle with wings extended is a well-known national symbol or emblem of the United States"); *In re Teasdale Packing Co., Inc.*, 137 USPQ 482 (TTAB 1963) (U. S. AQUA and design held unregistrable under §2(a) on the ground that purchasers of applicant's canned drinking water would be misled into assuming approval or sponsorship by the United States government in view of the nature of the mark, including a red, white, and blue shield design, and the nature of the goods, the Board noting a program for stocking emergency supplies of water in fallout shelters and the setting of standards for drinking water by United States government agencies).

Designations have been held not to be national symbols in the following cases: *W. H. Snyder and Sons, Inc. v. Ladd*, 227 F. Supp. 185, 140 USPQ 647 (D.D.C. 1964) (HOUSE OF WINDSOR held not to be a national symbol of England, but merely the name of its present reigning family); *NASA v. Bully Hill Vineyards, Inc.*, 3 USPQ2d 1671 (TTAB 1987) (SPACE SHUTTLE found not to constitute a national symbol on the evidence of record, the Board also finding "shuttle" to be a generic term for a space vehicle or system); *Jacobs v. International Multifoods Corp.*, 211 USPQ 165, 170-71 (TTAB 1981), *aff'd on other grounds*, 668 F.2d 1234, 212 USPQ 641 (C.C.P.A. 1982) ("[H]istorical events such as the 'BOSTON TEA PARTY'..., although undoubtedly associated with the American heritage, do not take on that unique and special significance of a 'national symbol' designed to be equated with and associated with a particular country."); *In re General Mills, Inc.*, 169 USPQ 244 (TTAB 1971) (UNION JACK, which applicant was using on packages of frozen fish marked "English cut cod" and in its restaurant near representations of the British national flag, found not to suggest a particular country, the Board noting that it could consider only the matter for which registration was sought); *In re Horwitt*, 125 USPQ 145, 146 (TTAB 1960) (U. S. HEALTH CLUB found registrable for vitamin tablets. "Considering both the nature of the mark and the goods, it is concluded that the purchasing public would not be likely to mistakenly assume that the United States Government is operating a health club, that it is distributing vitamins, or that it has approved applicant's goods.").

The name of a country is not a national symbol within the meaning of §2(a) of the Trademark Act, *In re Sweden Freezer Mfg. Co.*, 159 USPQ 246, 248-249 (TTAB 1968), nor does use of the name of a country as a mark, by itself, amount to deception, disparagement, or a "false connection" under §2(a). *In re Fortune Star Products Corp.*, 217 USPQ 277 (TTAB 1982).

The acronyms for, and names of, government agencies and bureaus are not considered to be national symbols. *Consolidated Foods Corp.*, 187 USPQ at 64 (OSS, acronym for the Office of Strategic Services, held not to be a national symbol, but merely to designate a particular (and long defunct) government agency, the Board contrasting national symbols with names and acronyms of government agencies: "'National symbols' ... are more enduring in time, ... and immediately conjure up the image of the country as a whole. Symbols of a country take on a special meaning and significance and are not so numerous as to dilute the special meaning and significance that each has.")

"National symbols" cannot be equated with the "insignia" of nations. As noted in *Liberty Mutual Insurance Co.,* 185 F. Supp. at 908, 127 USPQ at 323:

> The Act ... does not put national symbols on a par with the flag, coat of arms, or other insignia of the United States, which may not in any event be made the subject matter of a trade or service mark. With regard to national symbols the statute provides merely that they shall not be disparaged or held up to contempt or disrepute, and shall not be used as falsely to suggest a connection between the holder of the mark and the symbol.

See **TMEP §1204** regarding insignia.

While the prohibition of §2(a) against the registration of matter that may disparage or falsely suggest a connection with national symbols, or bring them into contempt or disrepute, may not be applicable to a particular designation, many names, acronyms, titles, terms, and symbols are protected by other statutes or rules. *See* **TMEP §1205.01.**

Old Edition

1203.03(c) Disparagement, Bringing into Contempt, and Bringing into Disrepute

Section 2(a) prohibits the registration of a mark that consists of or comprises matter that may disparage, or bring into contempt or disrepute, persons, institutions, beliefs, or national symbols. *See* **TMEP §1203.03(a)** regarding persons, and **TMEP §1203.03(b)** regarding national symbols.

In sustaining an opposition on this ground, the Trademark Trial and Appeal Board stated as follows:

> Disparagement is essentially a violation of one's right of privacy – the right to be "let alone" from contempt or ridicule. *See*, *Carson v. Here's Johnny Portable Toilets, Inc*., 698 F.2d 831, 218 USPQ 1 (6th Cir. 1983). It has been defined as the publication of a statement which the publisher intends to be understood, or which the recipient reasonably should understand, as tending "to cast doubt upon the quality of another's land, chattels, or intangible things." Restatement (Second) of Torts §629 (1977).

Greyhound Corp. v. Both Worlds Inc., 6 USPQ2d 1635, 1639 (TTAB 1988).

The Board applies a two-part test in determining whether a proposed mark is disparaging:

(1) What is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services; and

(2) If that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.

See In re Lebanese Arak Corp., 94 USPQ2d 1215 (TTAB 2010); *In re Squaw Valley Development Co*., 80 USPQ2d 1264 (TTAB 2006); *Order Sons of Italy in America v. The Memphis Mafia, Inc.*, 52 USPQ2d 1364 (TTAB 1999); *Harjo v. Pro-Football Inc.*, 50 USPQ2d 1705 (TTAB 1999), *rev'd on other grounds*, 284 F. Supp. 2d 96, 68 USPQ2d 1225 (D.D.C. 2003), *remanded*, 415 F.3d 44, 75 USPQ2d 1525 (D.C. Cir. 2005).

The question of disparagement must be considered in relation to the goods or services identified in the application. In *Squaw Valley*, the terms SQUAW and SQUAW ONE were found to be disparaging when used in connection with clothing in Class 25 and retail store services in the field of sporting goods and equipment and clothing in Class 35, because the likely meaning of "Squaw" is an American Indian woman or wife, and the examining attorney's evidence established prima facie that a substantial composite of Native Americans would consider the term to be offensive. However, these terms were found not to be disparaging when used in connection with ski-related equipment in Class 28, because the likely meaning of "Squaw" in relation to these goods was deemed to be applicant's Squaw Valley ski resort.

In an ex parte case, the examining attorney must make a prima facie showing that a substantial composite of the *referenced group* would find the proposed mark, as used on or in connection with the relevant goods or services, to be disparaging. *Lebanese Arak,* 94 USPQ2d at 1218, citing *In re Heeb Media LLC,* 89 USPQ2d 1071, 1074 (TTAB 2008). *In Lebanese Arak,* the Board clarified that when the application of a mark to a product would offend the sensibilities of an ethnic or religious group, the proper ground for refusal is that the matter is disparaging to the members of that group. *Lebanese Arak,* 94 USPQ2d at 1217. Moreover, when religious beliefs or tenets are involved, the proper focus is on the group of persons that adhere to those beliefs or tenets. *Id.* The prima facie showing shifts the burden to applicant for rebuttal. *Squaw Valley,* 80 USPQ2d at 1270.

1203.03(d) Disparagement, Bringing into Contempt, and Bringing into Disrepute: Case References

See In re Lebanese Arak Corp., 94 USPQ2d 1215 (TTAB 2010) (KHORAN for wines found to be disparaging because the public, in general, and Muslim Americans, in particular, would regard the mark as referring to the holy text of Islam, and given that Islamic authorities view alcohol as a prohibited substance, Muslims would find KHORAN used for wine as disparaging to themselves, their religion, and their beliefs); *In re Heeb Media LLC*, 89 USPQ2d 1071 (TTAB 2008) (HEEB for clothing and entertainment services found to be disparaging since HEEB means a Jewish person, dictionary definitions unanimously support the derogatory nature of HEEB, evidence of record supports that a substantial composite of the referenced group, i.e., the Jewish community, will perceive HEEB as disparaging, and HEEB has no other meaning in relation to clothing or entertainment services); *Boston Red Sox Baseball Club Limited Partnership v. Sherman*, 88 USPQ2d 1581 (TTAB 2008) (SEX ROD held to be disparaging because it is sexually vulgar and offensive and the public will associate it with opposer's mark RED SOX); *In re Squaw Valley Development Co*., 80 USPQ2d 1264 (TTAB 2006) (SQUAW and SQUAW ONE found to be disparaging when used in connection with clothing in Class 25 and retail store services in the field of sporting goods and equipment and clothing in Class 35, because the likely meaning of "Squaw" in relation to these goods/services is an American Indian woman or wife, and the examining attorney's evidence established prima facie that a substantial composite of Native Americans would consider the term to be offensive; however, these terms were found not to be disparaging when used in connection with ski-related equipment in Class 28, because the likely meaning of "Squaw" in relation to these goods was deemed to be applicant's Squaw

Valley ski resort); *Boswell v. Mavety Media Group Ltd.*, 52 USPQ2d 1600 (TTAB 1999) (BLACK TAIL used on adult entertainment magazines, found not to be disparaging of women in general, or African-American women in particular, nor to bring those groups into contempt or disrepute); *Order Sons of Italy in America v. Memphis Mafia Inc.*, 52 USPQ2d 1364 (TTAB 1999) (THE MEMPHIS MAFIA for entertainment services found not to be matter that disparages Italian-Americans or bring them into contempt or disrepute); *In re In Over Our Heads Inc.,* 16 USPQ2d 1653, 1654 (TTAB 1990) (MOONIES and design incorporating a "buttocks caricature," for dolls whose pants can be dropped, held not to be disparaging matter that is unregistrable under §2(a), the Board finding that the mark "would, when used on a doll, most likely be perceived as indicating that the doll 'moons,' and would not be perceived as referencing members of The Unification Church."); *Greyhound Corp. v. Both Worlds Inc.*, 6 USPQ2d 1635, 1639-40 (TTAB 1988) (design of dog defecating, for clothing, held to disparage, and bring into contempt or disrepute, opposer's running dog symbol, the Board finding the evidence of record "sufficient to show prima facie that this design [the running dog symbol] is, in effect, an alter ego of opposer which points uniquely and unmistakably to opposer's persona."); *In re Anti-Communist World Freedom Congress, Inc.,* 161 USPQ 304 (TTAB 1969) (design of an "X" superimposed over a hammer and sickle held to disparage, and hold in contempt and disrepute, a national symbol of the U.S.S.R.).

1203.03(e) False Suggestion of a Connection

Section 2(a) prohibits the registration of a mark that consists of or comprises matter that may falsely suggest a connection with persons, institutions, beliefs, or national symbols. *See* **TMEP §1203.03(a)** regarding persons, **TMEP §1203.03(b)** regarding national symbols, and **TMEP §1203.03** for information about the legislative history of §2(a).

To establish that a proposed mark falsely suggests a connection with a person or an institution, it must be shown that: (1) the mark is the same as, or a close approximation of, the name or identity previously used by another person or institution; (2) the mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution; (3) the person or institution named by the mark is not connected with the activities performed by the applicant under the mark; and (4) the fame or reputation of the person or institution is such that, when the mark is used with the applicant's goods or services, a connection with the person or institution would be presumed. *In re Peter S. Herrick, P.A.*, 91 USPQ2d 1505 (TTAB 2009); *In re MC MC S.r.l.*, 88 USPQ2d 1378 (TTAB 2008); *Association Pour La Defense et la Promotion de L'Oeuvre de Marc Chagall dite Comite Marc Chagall v. Bondarchuk*, 82 USPQ2d 1838 (TTAB 2007); *In re White*, 80 USPQ2d 1654 (TTAB 2006); *In re White*, 73 USPQ2d 1713 (TTAB 2004); *In re Nuclear Research Corp.*, 16 USPQ2d 1316, 1317 (TTAB 1990); *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428, 429 (TTAB 1985); *In re Cotter & Co.*, 228 USPQ 202, 204 (TTAB 1985).

The term "institution" has been broadly construed. *See In re Shinnecock Smoke Shop*, 571 F.3d 1171, 91 USPQ2d 1218, 1219 (Fed. Cir. 2009) ("[T]he ordinary meaning of 'institution' suggests the term is broad enough to include a self-governing Indian nation," quoting *Black's Law Dictionary* 813, 1133 (8th ed. 2004), which defines "institution" as "[a]n established organization," and defines "organization" as a "body of persons ... formed for a common purpose"); *In re White*, 73 USPQ2d 1713, 1718 (TTAB 2004) ("each federally recognized Apache tribe is necessarily either a juristic person or an institution"); *In re Urbano*, 51 USPQ2d 1776, 1779 (TTAB 1999) ("[T]he entire organization which comprises the Olympic Games, as a whole, qualifies as an 'institution' within the meaning of Section 2(a) of the Trademark Act"); *In re North American Free Trade Ass'n,* 43 USPQ2d 1282, 1285-1286 (TTAB 1997) (finding that the "NAFTA is an institution, in the same way that the United Nations is an institution," the Board noted that the "legislative history ... indicates that the reference to an 'institution' in Section 2(a) was designed to have an expansive scope.")

The requirement that the proposed mark would be recognized as pointing uniquely and unmistakably to the person or institution does not mean that the term itself must be unique. Rather, the question is whether, as used on the goods or services in question, consumers would view the mark as pointing uniquely to petitioner, or whether they would perceive it to have a different meaning. *Hornby v. TJX Companies, Inc*., 87 USPQ2d 1411 (TTAB 2008) (in granting the petition to cancel registration of the mark TWIGGY, Board found that, at the time of registration in 2000, the mark TWIGGY on children's clothing would be recognized as pointing uniquely and unmistakably to petitioner, who was recognized as a famous British model, and that consumers would presume an association with petitioner; Board also found that evidence of third-party registrations showing registration of the term "TWIGGY" for goods unrelated to children's clothing to have "no probative value").

In the case of a mark comprising the name of a deceased natural person, the "right to the use of a designation which points uniquely to his or her persona may not be protected under §2(a) after his or her death unless heirs or other successors are entitled to assert that right…. In order to possess rights, such person, or someone to whom those rights have been transferred, must exist." *In re MC MC S.r.l.*, 88 USPQ2d 1378, 1380 (TTAB 2008) (quoting *In re Wielinski*, 49 USPQ2d 1754, 1758 (TTAB 1998) (*overruled on other grounds by In re WNBA Enterprise, LLC*, 70 USPQ2d 1153 (TTAB 2003)). A key consideration is "whether or not there is someone (this may be a natural person, estate, or juristic entity) with rights in the name." *Id*. Any doubt regarding the existence of heirs or successors with such rights must be resolved in favor of the applicant. *MC MC S.r.l.*, 88 USPQ2d at 1380.

In *In re Sloppy Joe's Int'l Inc.,* 43 USPQ2d 1350, 1353-34 (TTAB 1997), the Trademark Trial and Appeal Board held that Ernest

Hemingway's friendship with the original owner of applicant's bar, his frequenting the bar, and his use of the back room as an office is not the kind of "connection" contemplated by §2(a). Rather, a commercial connection, such as an ownership interest or commercial endorsement or sponsorship of applicant's services would be necessary to entitle the applicant to registration. *White*, 80 USPQ2d at 1660-61 ("there must be a specific endorsement, sponsorship or the like of the particular goods and services, whether written or implied").

If it is unclear whether the person or institution is connected with the goods sold or services performed by the applicant, the examining attorney should make an explicit inquiry under 37 C.F.R. §2.61(b).

A refusal on this basis requires, by implication, that the person or institution with which a connection is falsely suggested must be the prior user. *Nuclear Research Corp.,* 16 USPQ2d at 1317; *In re Mohawk Air Services Inc.,* 196 USPQ 851, 854-55 (TTAB 1977).

Intent to identify a party or trade on its goodwill is not a required element of a §2(a) claim of false suggestion of an association with such party. *S & L Acquisition Co. v. Helene Arpels, Inc.*, 9 USPQ2d 1221, 1224 (TTAB 1987); *Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd.*, 228 USPQ 752, 754 (TTAB 1985). However, evidence of such an intent could be highly persuasive that the public would make the intended false association. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.,* 703 F.2d 1372, 1377, 217 USPQ 505, 509 (Fed. Cir. 1983), *aff'g* 213 USPQ 594 (TTAB 1982).

1203.03(f) False Suggestion of a Connection: Case References

See University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc., 703 F.2d 1372, 1377, 217 USPQ 505, 509 (Fed. Cir. 1983), *aff'g* 213 USPQ 594 (TTAB 1982) (NOTRE DAME and design, for cheese, held not to falsely suggest a connection with the University of Notre Dame. "As the board noted, 'Notre Dame' is not a name solely associated with the University. It serves to identify a famous and sacred religious figure and is used in the names of churches dedicated to Notre Dame, such as the Cathedral of Notre Dame in Paris, France. Thus it cannot be said that the only 'person' which the name possibly identifies is the University and that the mere use of NOTRE DAME by another appropriates its identity."); *In re Sauer,* 27 USPQ2d 1073 (TTAB 1993), *aff'd per curiam,* 26 F.3d 140 (Fed. Cir. 1994) (registration of BO BALL for oblong shaped leather ball with white stitching properly refused under §2(a), since use of "Bo" would be recognized by purchasers as reference to football and baseball player Bo Jackson, and there was no connection between Jackson and applicant); *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 91 USPQ2d 1218 (Fed. Cir. 2009) (SHINNECOCK BRAND FULL FLAVOR and SHINNECOCK BRAND LIGHTS, both for cigarettes, falsely suggest a connection with the Shinnecock Indian Nation); *In re Peter S. Herrick, P.A.*, 91 USPQ2d 1505 (TTAB 2009) (Board affirmed §2(a) refusal, finding that "U.S. CUSTOMS SERVICE" is a close approximation of the former name of the government agency, United States Customs Service, which is now known as the United States Customs and Border Protection but which is still referred to as the U.S. Customs Service by the public and the agency itself, that the seal design in the proposed mark is nearly identical to the seal used by the former United Stated Customs Service, that the only meaning the "U.S. Customs Service" has is to identify the government agency, and that a connection between applicant's "attorney services" and the activities performed by the United States Customs and Border Protection would be presumed); *In re MC MC S.r.l.*, 88 USPQ2d 1378, 1381 (TTAB 2008) (Board reversed §2(a) refusal of MARIA CALLAS for jewelry and other goods, because the record contained contradictory evidence as to the existence of anyone currently possessing rights in the name "Maria Callas," and resolving doubt in favor of applicant "removes the possibility that we might be denying registration to an applicant based on non-existent rights," and because a person or entity claiming rights in a name or persona has recourse since §2(a) is not time barred); *Hornby v. TJX Companies, Inc.*, 87 USPQ2d 1411 (TTAB 2008) (Board affirmed refusal of registration of TWIGGY for children's clothing, on the ground that it would falsely suggest a connection with the internationally known British model and actress who was a major celebrity in the late 1960s, finding that she retained a sufficient degree of fame or reputation that a connection would still be presumed by consumers seeing the mark TWIGGY on children's clothing as of the date on which respondent's registration issued in 2000); *In re White*, 80 USPQ2d 1654 (TTAB 2006) (Board affirmed refusal of MOHAWK for cigarettes under §2(a), on the ground that it would falsely suggest a connection with the federally recognized tribe the St. Regis Band of Mohawk Indians of New York); *In re White*, 73 USPQ2d 1713 (TTAB 2004) (APACHE, for cigarettes, falsely suggests a connection with the nine federally recognized Apache tribes); *In re Los Angeles Police Revolver and Athletic Club, Inc.*, 69 USPQ2d 1630 (TTAB 2004) (slogan TO PROTECT AND TO SERVE, used by applicant Los Angeles Police Revolver and Athletic Club, Inc., does not *falsely* suggest a connection with the Los Angeles Police Department, where evidence showed an actual longstanding commercial connection, publicly acknowledged and endorsed by both parties); *In re Urbano*, 51 USPQ2d 1776 (TTAB 1999) (SYDNEY 2000, used for advertising and business services and communication services, falsely suggests connection with Olympic Games, since general public would recognize phrase as referring unambiguously to Olympic Games to be held in Sydney, Australia, in 2000; entire organization that comprises Olympic games qualifies as "institution."); *In re North American Free Trade Ass'n,* 43 USPQ2d 1282 (TTAB 1997) (NAFTA, used on "promotion of trade and investment" services, falsely suggests connection with North American Free Trade Agreement; NAFTA qualifies as institution because it encompasses treaty, supplemental agreements, and various commissions, committees and offices created by those documents); *In re Sloppy Joe's Int'l Inc.,* 43 USPQ2d 1350 (TTAB 1997) (use of mark SLOPPY JOE'S, with design that includes portrait of Ernest Hemingway, falsely suggests connection with deceased writer); *Internet Inc. v.*

Corporation for Nat'l Research Initiatives, 38 USPQ2d 1435 (TTAB 1996) (cancellation petitioners failed to state claim for relief where they have not alleged, and cannot reasonably allege, that the term INTERNET points uniquely and unmistakably to their own identity or persona); *Ritz Hotel Ltd. v. Ritz Closet Seat Corp.*, 17 USPQ2d 1466, 1471 (TTAB 1990) (RIT-Z in stylized form, for toilet seats, held not to falsely suggest a connection with opposer, the Board observing that there was "no evidence of record directed to showing a connection of applicant's mark with opposer corporation, The Ritz Hotel Limited"); *In re Nuclear Research Corp.,* 16 USPQ2d 1316 (TTAB 1990) (NRC and design, for radiation and chemical agent monitors, electronic testers, and nuclear gauges, held not to falsely suggest a connection with the U.S. Nuclear Regulatory Commission in view of applicant's use of NRC long prior to the inception of that agency); *NASA v. Bully Hill Vineyards, Inc.,* 3 USPQ2d 1671, 1676 (TTAB 1987) (opposition to the registration of SPACE SHUTTLE for wines dismissed, the Board finding "shuttle" to be a generic term for a space vehicle or system. "Where a name claimed to be appropriated does not point uniquely and unmistakably to that party's personality or 'persona,' there can be no false suggestion."); *Board of Trustees of University of Alabama v. BAMA-Werke Curt Baumann,* 231 USPQ 408 (TTAB 1986) (petition to cancel registration of BAMA, for shoes, slippers, stockings, socks, and insoles, granted, the Board finding that the evidence of record indicated that BAMA points uniquely to the University of Alabama and thus falsely suggests a connection with the University); *In re Cotter & Co.*, 228 USPQ 202 (TTAB 1985) (WESTPOINT, for shotguns and rifles, held to falsely suggest a connection with an institution, the United States Military Academy). For examples of findings of false suggestion of a connection prior to the decision of the Court of Appeals for the Federal Circuit in *Notre Dame, supra, see In re U.S. Bicentennial Society,* 197 USPQ 905 (TTAB 1978) (U.S. BICENTENNIAL SOCIETY, for ceremonial swords, held to falsely suggest a connection with the American Revolution Bicentennial Commission and the United States government); *In re National Intelligence Academy*, 190 USPQ 570 (TTAB 1976) (NATIONAL INTELLIGENCE ACADEMY, for educational and instructional services in intelligence gathering for law enforcement officers, held to falsely suggest a connection with the United States government).

1204 Refusal on Basis of Flag, Coat of Arms, or Other Insignia of United States, State or Municipality, or Foreign Nation

Extract from 15 U.S.C. §1052. No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it ... (b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

Section 2(b) of the Trademark Act, 15 U.S.C. §1052(b), bars the registration on either the Principal Register or the Supplemental Register of marks that consist of or comprise (whether consisting solely of, or having incorporated in them) the flag, coat of arms, or other insignia of the United States, of any state or municipality, or of any foreign nation. Section 2(b) also bars the registration of marks that consist of or comprise any simulation of such symbols.

"Simulation" refers to "something that gives the appearance or effect or has the characteristics of an original item." Whether a mark comprises a simulation must be determined from a visual comparison of the proposed mark vis-à-vis replicas of the flag, coat of arms, or other insignia in question. *In re Waltham Watch Co.*, 179 USPQ 59, 60 (TTAB 1973). Focus must be on the general recollection of the flag or insignia by purchasers, "without a careful analysis and side-by-side comparison." *In re Advance Industrial Security, Inc.*, 194 USPQ 344, 346 (TTAB 1977).

The incorporation in a mark of individual or distorted features that are merely suggestive of flags, coats of arms, or other insignia does not bar registration under §2(b). *See Knorr-Nahrmittel A.G. v. Havland Int'l, Inc.*, 206 USPQ 827, 833 (TTAB 1980) (flag designs incorporated in the proposed mark NOR-KING and design not recognizable as the flags of Denmark, Norway, and Sweden, the Board finding that "[a]ll that the record reflects is that the mark contains a representation of certain flags, but not the flag or flags of any particular nation"); *Advance Industrial Security,* 194 USPQ at 347 (proposed mark comprising a gold and brown triangular shield design with the words "ADVANCE SECURITY" predominately displayed in the upper central portion of the mark "creates an overall commercial impression distinctly different from the Coat of Arms"); *Waltham Watch Co.*, 179 USPQ at 60 (mark comprising wording with the design of a globe and flags held not to be a simulation of the flags of Switzerland and Great Britain, the Board stating that "although the flags depicted in applicant's mark incorporate common elements of flag designs such as horizontal or vertical lines, crosses or stars, they are readily distinguishable from any of the flags of the nations alluded to by the examiner.").

Section 2(b) differs from the provision of §2(a) regarding national symbols (*see* **TMEP §1203.03(b))** in that §2(b) requires no additional element, such as disparagement or a false suggestion of a connection, to preclude registration.

1204.01 Flags and Simulations of Flags

1204.01(a) Flags and Simulations of Flags are Refused

Registration must be refused under §2(b) if the design sought to be registered includes a true representation of the flag of the United States, any state, municipality, or foreign nation, or is a simulation thereof. A refusal must be issued if the design would be perceived by the public as a flag, regardless of whether other matter appears with or on the flag. The examining attorney

should consider the following factors, in regard to both color drawings and black-and-white drawings, to determine whether the design is perceived as a flag: (1) color; (2) presentation of the mark; (3) words or other designs on the drawing; and (4) use of the mark on the specimen(s).

Generally, a refusal should be made where a black-and-white drawing contains unmistakable features of the flag, contains features of the flag along with indicia of a nation, or is shown on the specimen in the appropriate colors of that national flag. For example, merely amending a "red, white, and blue" American flag to a black-and-white American flag will not overcome a §2(b) refusal. However, black-and-white drawings of flags that consist only of common geometric shapes should not be refused unless there are other indicia of the country on the drawing or on the specimens. For example, a black-and-white drawing showing three horizontal rectangles would not be refused as the Italian or French flag unless there is something else on the drawing or on the specimen that supports the refusal.

Examples of Situations Where Registration Should be Refused. The following are examples of situations where registration should be refused, because all significant features of the flag are present or a simulation of the flag is used with state or national indicia:

The wording "That's Italian" emphasizes that the banner design is a simulation of a flag.

This design is refused because the word SWISS emphasizes that the design is intended to be a simulation of the Swiss flag.

This black-and-white mark is refused because the word Texas emphasizes that the design is intended to be the state flag of Texas.

1204.01(b) Stylized Flag Designs are not Refused under §2(b)

Marks containing elements of flags in a stylized or incomplete form are not refused under §2(b). The mere presence of some significant elements of flags, such as stars and stripes (U.S. flag) or a maple leaf (Canadian flag), does not necessarily warrant a refusal.

If the flag design fits one of the following scenarios, the examining attorney should not refuse registration under §2(b):

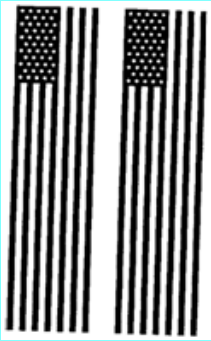
- The flag design is used to form a letter, number, or design.
- The flag is substantially obscured by words or designs.
- The design is not in a shape normally seen in flags.
- The flag design appears in a color different from that normally used in the national flag.
- A significant feature is missing or changed.

Examples. The following are examples of stylized designs that are registrable under §2(b):

Flag Forms Another Design, Number, or Letter - No §2(b) Refusal

Flag Is Substantially Obscured By Other Matter - No §2(b) Refusal

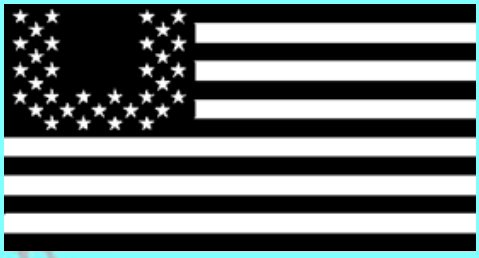
Flag Design Is Not In the Normal Flag Shape - No §2(b) Refusal



Significant Feature of the Flag Is In a Different Color - No §2(b) Refusal

NOTE: Stripes in flag are red, white, and green.

Significant Feature Is Changed - No §2(b) Refusal



1204.01(c) Caselaw Interpreting "Simulation of Flag"

The Trademark Trial and Appeal Board found that no simulation of a flag existed in the following cases: *In re American Red Magen David for Israel*, 222 USPQ 266, 267 (TTAB 1984) ("As to the State of Israel, it is noted that the flag of that nation consists essentially of a light blue Star of David on a white background. In the absence of any evidence that the State of Israel is identified by a six-pointed star in any other color, we conclude that only a light blue six-pointed star would be recognized as the insignia thereof."); *In re Health Maintenance Orgs., Inc*., 188 USPQ 473 (TTAB 1975) (Dark cross, with legs of equal length, having a caduceus symmetrically imposed thereon held sufficiently distinctive from Greek red cross and flag of Swiss Confederation).

1204.01(d) Description of the Mark

The description of the mark should make it clear that the design is a stylized version of the national flag, if accurate. For example, a statement that "the mark consists of the stylized American flag" or "the mark consists of the stylized American flag in the shape of the letters USA" are acceptable descriptions.

1204.01(e) Flags Not Presently Used as National Flags

Flags of former countries, states, or municipalities are not refused under §2(b). For example, the flags of now non-existent countries such as the German Democratic Republic (East Germany) or Yugoslavia are not refused. However, former flags of existing countries, states, or municipalities are refused under §2(b). For example, the original flag of the United States representing the 13 colonies should be refused.

1204.02 Government Insignia

1204.02(a) Designs that are Insignia Under §2(b) Must Be Refused

Flags and coats of arms are specific designs formally adopted to serve as emblems of governmental authority. The wording "other insignia" should not be interpreted broadly, but should be considered to include only those emblems and devices that also represent governmental authority and that are of the same general class and character as flags and coats of arms.

The following are insignia of the United States for purposes of §2(b):

- Great Seal of the United States
- Presidential Seal
- Seals of Government Agencies

The Trademark Trial and Appeal Board has construed the statutory language as follows:

> [T]he wording “or other insignia of the United States” must be restricted in its application to insignia of the same general class as “the flag or coats of arms” of the United States. Since both the flag and coat of arms are emblems of national authority it seems evident that other insignia of national authority such as the Great Seal of the United States, the Presidential Seal, and seals of government departments would be equally prohibited registration under Section 2(b). On the other hand, it appears equally evident that department insignia which are merely used to identify a service or facility of the Government are not insignia of national authority and that they therefore do not fall within the general prohibitions of this section of the Statute.

In re U.S. Department of the Interior, 142 USPQ 506, 507 (TTAB 1964) (logo comprising the words “NATIONAL PARK SERVICE” and “Department of the Interior,” with depiction of trees, mountains, and a buffalo, surrounded by an arrowhead design, held not to be an insignia of the United States). The Trademark Trial and Appeal Board recently reaffirmed this interpretation in *In re Peter S. Herrick, P.A.*, 91 USPQ2d 1505 (TTAB June 26, 2009), by affirming the §2(b) refusal since applicant’s seal design was virtually identical to the seal used by the United States Department of the Treasury.

1204.02(b) Examples of Insignia That Should Be Refused

Examples: The following are examples of insignia that should be refused under §2(b):

Great Seal of the United States

Seal of The President of The United States

The Official Seal of a Government Agency

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1204.02(c) Examples of Designs That Should Not Be Refused

Designs that do not rise to the level of being "emblems of national authority" should not be refused. The following are examples of designs that are not barred from registration under §2(b):

Designs That Identify Governmental Departments - No §2(b) Refusal

Monuments, Statues, Buildings - No §2(b) Refusal

Objects Used By The Government - No §2(b) Refusal

Words or Initials that Identify People or Departments in The Government - No §2(b) Refusal

- U.S. Park Ranger
- U.S. Department of Transportation
- DOD - Department of Defense

1204.02(d) Caselaw Interpreting Insignia Under §2(b)

The following cases provide examples of matter that was held *not* to be government insignia under §2(b):

(1) *Department insignia that shows a service or facility of a federal department* are not refused registration under §2(b). *See In re United States Department of the Interior*, 142 USPQ 506, 507 (TTAB 1964) (insignia of the National Park Service registrable).

(2) *Monuments, statues, or buildings associated with the United States such as the White House, Washington Monument, and Statue of Liberty,* are not refused registration under §2(b). *See Liberty Mutual Insurance Co. v. Liberty Insurance Co. of Texas*, 185 F. Supp. 895, 908, 127 USPQ 312, 323 (E.D. Ark. 1960) ("That the Statue of Liberty is not a part of the 'insignia of the United States' is too clear to require discussion.").

(3) *Designs of objects used by the U.S. government* are not refused registration under §2(b). *See In re Brumberger Co., Inc*., 200 USPQ 475 (TTAB 1978) (representation of the U.S. mailbox was held not to be an insignia of the United States. However, the Board affirmed a refusal to register the mark under §2(a) because of a false connection with the United States Postal Service).

(4) *Initials or words that identify people or departments of a government agency*. Letters that merely identify people and things associated with a particular agency or department of the United States government, instead of representing the authority of the government or the nation as a whole, are generally not considered to be "insignia of the United States" within the meaning of §2(b). *See U.S. Navy v. United States Mfg. Co*., 2 USPQ2d 1254 (TTAB 1987) (USMC, the initials of the Marine Corps, which is part of the Navy, which itself is within the Department of Defense, cannot be construed as an "other insignia of the United States" under Section 2(b) of the Lanham Act). Note: As a result of the enactment of Public Law 98 525 on October 19, 1984, the initials, seal, and emblem of the United States Marine Corps are "deemed to be insignia of the United States," under 10 U.S.C. §7881, pertaining to unauthorized use of Marine Corps insignia. However, "USMC" was not so protected when the applicant began using its stylized version of those letters as a mark. In view of the provision in Public Law 98-525 that the amendments adding Chapter 663 (10 U.S.C. §7881) shall not affect rights that vested before the date of its enactment, the majority of the Board found that enactment of the law did not adversely affect the mark's registrability, stating that "opposer has not shown that applicant's mark was an insignia of the United States prior to the law making it one, or that the law effectively bars registration to applicant." Id. at 1260.

1204.03 Other Refusals May be Appropriate

Marks that are not barred by §2(b) may be refused if prohibited by other sections of the Trademark Act. For example, a design may not be an insignia under §2(b) but may be refused under §2(a). *See, e.g., In re Brumberger Co., Inc*., 200 USPQ 475 (TTAB 1978) (representation of the U.S. mailbox was not an insignia under §2(b) but was properly refused under §2(a) because it falsely suggested a connection with the United States Postal Service). Likewise, §2(d) may be a bar to registering a stylized flag that is not prohibited under §2(b).

See also **TMEP §1205.01** and **TMEP Appendix C** regarding subject matter that is protected by statute.

1204.04 Responding to §2(b) Refusal

1204.04(a) Absolute Bar to Registration

Because §2(b) provides an absolute bar to registration, a disclaimer of the prohibited flag or insignia or an amendment to seek registration under §2(f) or on the Supplemental Register will not overcome a refusal.

The statute does not list any exceptions that would allow for countries, states, or municipalities to register their own flags or insignia. Applications for marks that contain flags, coats of arms, or government insignia, even if filed by the relevant state, country, or municipality, must be refused.

1204.04(b) Deletion of §2(b) Matter

Section 1 Applications. The deletion of the unregistrable §2(b) matter, which no party can have trademark rights in, will not be considered a material alteration if the matter is separable from the other elements in the mark, e.g., if the flag design is spatially separated from other matter in the mark or is used as a background for other words or designs. If the flag is deleted from the drawing, the specimen that shows the flag is still acceptable. The examining attorney must ensure that the design search codes are corrected whenever a change is made to the drawing.

No deletion is allowed if the flag design is integrated into the overall mark in such a way that deletion would significantly change the commercial impression of the mark.

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An amendment to the drawing showing the outline of the flag design absent the interior material is not permitted. Amending the mark from a national, state, or municipal flag to a blank flag changes the commercial impression of how the mark is used, or intended to be used, in commerce.

Section 44 Applications. Amendments to the drawing to delete §2(b) matter are not permitted because the drawing must be a substantially exact representation of the mark as registered in the foreign country. **TMEP §1011.01.**

Section 66(a) Applications. Amendments to the drawing to delete the §2(b) matter are not permitted because the Madrid Protocol does not permit the amendment of a mark in an international registration. **TMEP §807.13(b).**

1204.04(b)(i) Examples of Matter That May and May Not Be Deleted

The Flag Design May Be Deleted If It Is A Separable Element:

The Flag May Not Be Deleted If It Is Integrated Into the Overall Design:

1204.05 Resources

Internet Evidence

Many useful websites present images of national and state flags, government insignia, and coats of arms:

Flags of Foreign Nations:

- **http://www.crwflags.com/fotw/flags/**
- **http://en.wikipedia.org/wiki/Gallery_of_sovereign_state_flags**
- **http://www.wave.net/upg/immigration/flags.html**

United States, State, and Territory Flags:

- **http://www.law.ou.edu/hist/flags/**
- **http://www.50states.com/flag/**

Insignia:

- Great Seal of the United States **http://www.greatseal.com**/

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- Seal of the President of the United States **http://www.whitehouse.gov/history/eeobtour/images/seal-presidential-color.html**
- Seals of Government departments - see specific agency website

Coat of Arms - Gallery of Coats of Arms:

- **http://en.wikipedia.org/wiki/Coat_of_arms**

Non Registration Data: X-Search and TESS

Article 6*ter* of the Paris Convention provides for the notification of flags, coats of arms, and national insignia of member countries. When the USPTO receives notification under Article 6*ter* from the IB, they are assigned serial numbers in the "89" series code, i.e., serial numbers beginning with the digits "89," and are sometimes referred to as "non-registrations." These designs may indicate whether the matter presented for registration in the application under review is a flag, coat of arms, or insignia of a foreign government. *See* **TMEP §1205.02.**

1205 Refusal on Basis of Matter Protected by Statute or Convention

1205.01 Statutory Protection

Various federal statutes and regulations prohibit or restrict the use of certain words, names, symbols, terms, initials, marks, emblems, seals, insignia, badges, decorations, medals, and characters adopted by the United States government or particular national and international organizations. These designations are reserved for the specific purposes prescribed in the relevant statute and must be free for use in the prescribed manner. *See* the listings of citations to sections of the United States Code and the Code of Federal Regulations in **Appendix C** of this Manual.

For example, Congress has created statutes that grant exclusive rights to use certain designations to federally created private corporations and organizations. Violation of some of these statutes may be a criminal offense, *e.g*., 18 U.S.C. §§705 (regarding badges, medals, emblems, or other insignia of veterans' organizations); 706 ("Red Cross," "Geneva Cross," and emblem of Greek red cross); 707 (4-H Club); 708 (coat of arms of the Swiss Confederation); 711 ("Smokey Bear"); and 711a ("Woodsy Owl" and slogan, "Give a Hoot, Don't Pollute"). Other statutes provide for civil enforcement, *e.g.*, 36 U.S.C. §§153104 (National Society of the Daughters of the American Revolution); 30905 (Boy Scouts); 80305 (Girl Scouts); 130506 (Little League); and 21904 (The American National Theater and Academy).

The following are examples of the protection of words and symbols by statute.

(1) The Copyright Act of 1976 includes provisions regarding the use of appropriate notices of copyright. These include provisions concerning the use of the letter "C" in a circle – ©, the word "Copyright" and the abbreviation "Copr." to identify visually perceptible copies (17 U.S.C. §401); the use of the letter "P" in a circle to indicate phonorecords of sound recordings (17 U.S.C. §402); and the use of the words "mask work," the symbol *M* and the letter "M" in a circle to designate mask works (17 U.S.C. §909). The Copyright Act designates these symbols to indicate that the user of the symbol is asserting specific statutory rights.

(2) Use of the Greek red cross other than by the American National Red Cross, and by sanitary and hospital authorities of the armed forces of the United States, is proscribed by statute. There is an exception for use of any such emblem, sign, insignia, or words that were lawfully used on or before June 25, 1948. 18 U.S.C. §706. Use of the coat of arms of the Swiss Confederation for trade or commercial purposes is proscribed by statute. 18 U.S.C. §708. *See In re Health Maintenance Orgs., Inc.*, 188 USPQ 473 (TTAB 1975) (mark comprising a dark cross with legs of equal length on which a caduceus is symmetrically imposed (representation of caduceus disclaimed) held registrable, the Board finding the mark readily distinguishable from the Greek red cross (on white background) and the Swiss confederation coat of arms (white cross on red background)).

(3) False advertising or misuse of names to indicate a federal agency is proscribed by 18 U.S.C. §709. For example, this provision prohibits knowing use, without written permission of the Director of the Federal Bureau of Investigation, of the words "Federal Bureau of Investigation," the initials "F.B.I." or any colorable imitation, in various formats "in a manner reasonably calculated to convey the impression that such advertisement, ... publication, ... broadcast, telecast, or other production, is approved, endorsed, or authorized by the Federal Bureau of Investigation." Thus, an examining attorney must refuse to register such matter, pursuant to 18 U.S.C. §709, if its use is reasonably calculated to convey an approval, endorsement, or authorization by the Federal Bureau of Investigation.

(4) Section 110 of the Amateur Sports Act of 1978, 36 U.S.C. §220506, protects various designations associated with the Olympics. Under 36 U.S.C. §220506(a), the United States Olympic Committee has the exclusive right to use the name "United States Olympic Committee," its symbol and emblem, and the words "Olympic," "Olympiad," "Citius Altius

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Fortius," "Pan American," "Paralympiad," "America Espirito Sport Fraternite," or any combination thereof. The United States Supreme Court has held that the grant by Congress to the United States Olympic Committee of the exclusive right to use the word "Olympic" does not violate the First Amendment. *San Francisco Arts & Athletics, Inc. v. U.S. Olympic Committee*, 483 U.S. 522, 3 USPQ2d 1145 (1987) (concerning petitioner's use of "Gay Olympic Games"). Under 36 U.S.C. §220506(c), a person is subject to suit in a civil action by the Committee if such person, without the Committee's consent, uses for the purpose of trade, to induce the sale of goods or services, or to promote any theatrical exhibition, athletic performance, or competition, a designation noted above (listed in §220506(a)) or "any trademark, trade name, sign, symbol, or insignia falsely representing association with, or authorization by, the International Olympic Committee or ... [the United States Olympic Committee]" or any simulation of the words "Olympic," "Olympiad," or "Citius Altius Fortius" "tending to cause confusion, to cause mistake, to deceive, or to falsely suggest a connection with ... [the United States Olympic Committee] or any Olympic activity."

See U.S. Olympic Committee v. Toy Truck Lines Inc., 237 F.3d 1331, 57 USPQ2d 1380 (Fed. Cir. 2001); *O-M Bread, Inc. v. U.S. Olympic Committee*, 65 F.3d 933, 36 USPQ2d 1041(Fed. Cir. 1995); *U.S. Olympic Committee v. Intelicense Corp., S.A.*, 737 F. 2d 263, 222 USPQ 766 (2d Cir. 1984), *cert. denied* 469 U.S. 982 (1984); *U.S. Olympic Committee v. Union Sport Apparel*, 220 USPQ 526 (E.D. Va. 1983); *U.S. Olympic Committee v. International Federation of Body Builders*, 219 USPQ 353 (D.D.C. 1982); *Stop the Olympic Prison v. U.S. Olympic Committee*, 489 F. Supp. 1112, 207 USPQ 237 (S.D.N.Y. 1980).

(5) In chartering the Blinded Veterans Association, Congress granted it the sole right to use its name and such seals, emblems, and badges as it may lawfully adopt. 36 U.S.C. §30306. This protection of its exclusive right to use "Blinded Veterans Association" does not extend to the term "blinded veterans," which has been found generic. *Blinded Veterans Ass'n v. Blinded American Veterans Foundation*, 872 F.2d 1035, 10 USPQ2d 1432 (D.C. Cir. 1989).

(6) *Red Crescent Emblem, Third Protocol Emblem, or the designations "Red Crescent" and "Third Protocol Emblem*." Under 18 U.S.C. §706a, the use of the distinctive emblems the Red Crystal and the Red Crescent, as well as the designations "Third Protocol Emblem" and "Red Crescent," or any imitation thereof, is prohibited, except by those authorized to wear, display, or use them under the provisions of the Geneva Conventions. The statute carves out an exception for use of any emblem, sign, insignia, or words which were lawfully used on or before December 8, 2005, if use of these would not appear in time of armed conflict to confer the protections of the Geneva Conventions of August 12, 1949. *See* **TMEP §§1205.01(a)** *et seq*. for further information.

Usually, the statute will define the appropriate use of a designation and will prescribe criminal penalties or civil remedies for improper use. However, the statutes themselves do not provide the basis for refusal of trademark registration. To determine whether registration should be refused in a particular application, the examining attorney should consult the relevant statute to determine the function of the designation and its appropriate use. If a statute provides that a specific party or government agency has the exclusive right to use a designation, and a party other than that specified in the statute has applied to register the designation, the examining attorney must refuse registration on the ground that the mark is not in lawful use in commerce, citing §§1 and 45 of the Trademark Act, 15 U.S.C. §§1051 and 1127, in addition to the relevant statute.

Depending on the nature and use of the mark, other sections of the Trademark Act may also bar registration and must be cited where appropriate. For example, it may be appropriate for the examining attorney to refuse registration under §2(a) of the Trademark Act, 15 U.S.C. §1052(a), on the ground that the mark comprises matter that may falsely suggest a connection with a national symbol, institution, or person specified in the statute (e.g., the United States Olympic Committee). *See* **TMEP §1203.03(e).** Other §2(a) bases for refusal could also apply. *See* **TMEP §§1203** *et seq*. It may be appropriate to refuse registration under §2(b), 15 U.S.C. §1052(b), for matter that comprises a flag, coat of arms, or other similar insignia. *See* **TMEP §1204.** It may be appropriate to refuse registration under §2(d), 15 U.S.C. §1052(d), if the party specified in the statute owns a registration for a mark that is the same or similar. *Cf. U.S. Olympic Committee v. Olymp-Herrenwaschefabriken Bezner GmbH & Co.*, 224 USPQ 497 (TTAB 1984) (opposition to the registration of OLYMP sustained on ground of likelihood of confusion with opposer's registered mark OLYMPIC under §2(d), the Board finding that the evidence of record did not show that OLYMP falsely suggests a connection with opposer under §2(a), and that the remedies provided in 36 U.S.C. §220506(c) for misuse of Olympic designations are not pertinent to opposition proceedings).

In some instances, it may be appropriate for the examining attorney to refuse registration pursuant to §§1, 2 (preamble), and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127, on the ground that the subject matter would not be perceived as a trademark. For service mark applications, §3 of the Act, 15 U.S.C. §1053, should also be cited as a basis for refusal.

To determine what action is appropriate, the examining attorney should look to the particular use of a symbol or term by the applicant. For example, where it is evident that the applicant has merely included a copyright symbol in the drawing of the mark inadvertently, and the symbol is not a material portion of the mark, the examining attorney should indicate that the symbol is not part of the mark and require that the applicant amend the drawing to remove the symbol, instead of issuing statutory refusals of the types noted above.

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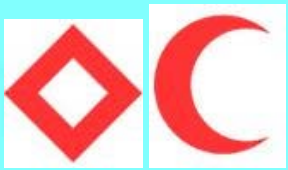
Examining attorneys should also consider whether registration of matter comprised in whole or in part of designations notified pursuant to Article 6*ter* of the Paris Convention and entered into the USPTO's search records may be prohibited by §§2(a) and 2(b) of the Trademark Act, 15 U.S.C. §§1052(a) and 1052(b). *See* **TMEP §1205.02.**

1205.01(a) Examination Procedures for Marks Comprising a Red Crystal or Red Crescent on a White Background, or the Phrases "Red Crescent" or "Third Protocol Emblem"

On December 8, 2005, the United States signed the Third Protocol Additional to the 1949 Geneva Conventions relating to the Adoption of an Additional Distinctive Emblem (the "Protocol"). The Protocol creates two new distinctive emblems: (1) the Third Protocol Emblem, composed of a red diamond on a white background (shown below); and (2) the Red Crescent, composed of a red crescent on a white background (shown below).



Effective January 12, 2007, Public Law 109-481, 120 Stat. 3666, created a new criminal statutory provision, 18 U.S.C. §706a, to prohibit the use of the distinctive emblems the Red Crystal and the Red Crescent, or any imitation thereof, as well as the designations "Third Protocol Emblem" and "Red Crescent," except by those authorized to wear, display, or use them under the provisions of the Geneva Conventions. The statute carves out an exception for use of any such emblem, sign, insignia, or words that were lawfully used on or before December 8, 2005, if use of these would not appear in time of armed conflict to confer the protections of the Geneva Conventions of August 12, 1949. The provisions of 18 U.S.C. §706a closely mirror the existing provision in 18 U.S.C. §706 for the American National Red Cross (*see* **TMEP §1205.01).**

1205.01(a)(i) First Use After December 8, 2005

If a party other than an authorized party (*see* **TMEP §1205.01(a)(vi)** for definition of authorized party) applies to register the Red Crescent, the Third Protocol Emblem, or the designation "Red Crescent" or "Third Protocol Emblem," and claims a date of first use in commerce after December 8, 2005, the examining attorney must refuse registration under §2(a) of the Trademark Act, 15 U.S.C. §1052(a), on the ground that the mark comprises matter that may falsely suggest a connection with the International Federation of Red Cross and Red Crescent Societies and/or other authorized parties under the statute. *See* 18 U.S.C. 706a; **TMEP §1203.03(e).** The examining attorney must provide appropriate supporting evidence for the refusal. In addition, a refusal must also be made on the ground that the mark is not in lawful use in commerce, citing §§1 and 45 of the Trademark Act, 15 U.S.C. §§1051 and 1127.

When examining specimens of use for such designations, the examining attorney should also consider issuing a refusal under §§1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127, on the ground that the subject matter would not be perceived as a trademark or, in the case of services, §§1, 2, 3, and 45 of the Act, 15 U.S.C. §§1051, 1052, 1053, and 1127, as appropriate. *See* **TMEP §§1202** and **1204.**

1205.01(a)(ii) First Use On or Before December 8, 2005 – Grandfather Clause

Registration of the Red Crescent, the Third Protocol Emblem, or the designation "Red Crescent" or "Third Protocol Emblem" need not be refused where, in an application under §1 of the Trademark Act, 15 U.S.C. §1051, the applicant claims a date of first use in commerce on or before December 8, 2005, if the goods and services would not appear in time of armed conflict to confer the protections of the Geneva Conventions. However, registration should be refused under §2(a) and §§1 and 45 of the Act if the goods or services are of a type typically offered as emergency relief or assistance in times of armed conflict. Such services may include, but are not limited to, medical assistance, religious, and charitable services. For example, applications for clothing, food items, or first-aid services must be refused under §2(a) and §§1 and 45 of the Trademark Act. The refusals can be withdrawn if the applicant amends the identification to indicate that the goods/services are not offered as emergency relief or assistance in time of armed conflict.

When examining specimens of use for such designations, the examining attorney should also consider issuing a refusal under §§1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127, on the ground that the subject matter would not be perceived as a trademark or, in the case of services, §§1, 2, 3, and 45 of the Act, 15 U.S.C. §§1051, 1052, 1053, and 1127, as appropriate. *See* **TMEP §§1202** and **1204.**

1205.01(a)(iii) Date of First Use Not Specified

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For applications filed under §1(b), §44, or §66(a) of the Trademark Act, 15 U.S.C. §1051(b), §1126, or §1141f(a), or for applications filed under §1(a) of the Trademark Act, 15 U.S.C. §1051(a), where the application fails to indicate the applicant's date of first use of the mark in commerce, the examining attorney should presume that the date of first use in commerce is or will be after December 8, 2005, unless the application record indicates otherwise.

A refusal of registration because the mark is not in lawful use in commerce cannot be issued in a §1(b) application unless the applicant files an allegation of use. However, a refusal under §2(a), and any other applicable refusals discovered in the normal course of examination, should be issued during initial examination.

1205.01(a)(iv) Nature of the Mark

Design elements

The statute prohibiting use of the Red Crystal and Red Crescent symbols by unauthorized parties applies to "any sign or insignia made or colored in imitation thereof." If the mark includes a design element where the color red is claimed, and the design would be likely to be perceived as the Red Crystal symbol or the Red Crescent symbol, the examining attorney must refuse registration under §2(a) and, if applicable (*see* **TMEP §§1205.01(a)** and **1205.01(a)(i))**, under §§1 and 45.

A mark that includes a design element will generally be considered registrable, and will not be refused under §2(a), if the applicant does not claim color as a feature of the mark. In such cases, a statement that the mark is not used in the color red is unnecessary, and if submitted, should not be printed on the registration certificate. Registration will be refused, however, if the applicant does not claim color as a feature of the mark, but the specimen shows use of the mark in the color red. In such cases, the examining attorney must refuse registration under §§1 and 45 of the Trademark Act, because the mark is not in lawful use in commerce. The refusal will be withdrawn if the applicant submits a proper substitute specimen showing use of the mark in a color other than red. A photocopy of the original specimen is not an acceptable substitute specimen.

Word Elements

Regarding the phrases "Red Crescent" and "Third Protocol Emblem," the statute prohibiting use of these designations does not apply to variations or modifications of these words. Only marks that include the exact wording RED CRESCENT or THIRD PROTOCOL EMBLEM, with or without additional wording, must be refused under §2(a) and §§1 and 45.

For example, REDCRESCENTS would not be refused registration, but RED CRESCENT DONOR could be refused registration if the date of first use is after December 8, 2005, or the application otherwise fails to qualify for the grandfather clause described in **TMEP §1205.01(a)(ii).**

1205.01(a)(v) Amendments to Disclaim, Delete, or Amend the Unregistrable Symbol or Designation

If the mark is unregistrable because it includes the Red Crescent or Third Protocol symbols or words, a disclaimer of the unregistrable matter will not render the mark registrable. Similarly, disclaimer of the color red is inappropriate, and will not obviate a refusal of registration.

On the other hand, if the unregistrable symbol or designation is deleted from the mark sought to be registered, the examining attorney should withdraw the refusal(s) based on the unregistrable symbol or designation, and, if necessary, refuse registration because the amendment to the mark is material. Deletions of matter determined to be unregistrable under §2(a) of the Act are sometimes permissible. *See* **TMEP §807.14(a).**

The examining attorney may also permit an amendment from a color drawing to a black-and-white drawing, to eliminate the claim of the color red, if such an amendment would not constitute a material alteration of the mark, and the amendment is supported by a proper specimen. *See* **TMEP §§807.14(e)** *et seq*. regarding amendments to color features of marks, and **TMEP §1205.01(a)(iv)** regarding the situation where the applicant does not claim color as a feature of the mark, but the specimen shows use of the mark in red.

1205.01(a)(vi) Parties Authorized to use the Red Crescent and Third Protocol Emblem

Under 18 U.S.C. §706a, the following parties are authorized to use the Red Crescent symbol and the Third Protocol Emblem on a white background and the designations "Red Crescent" and "Third Protocol Emblem:"

(1) authorized national societies that are members of the International Federation of Red Cross and Red Crescent Societies, and their duly authorized employees and agents;

(2) the International Committee of the Red Cross, and its duly authorized employees and agents;

(3) the International Federation of Red Cross and Red Crescent Societies, and its duly authorized employees and agents;

and

(4) the sanitary and hospital authorities of the armed forces of State Parties to the Geneva Conventions of August 12, 1949.

If the applicant is not clearly authorized to use an emblem or designation, the examining attorney must refuse registration. The refusal may be withdrawn if the applicant or the applicant's attorney submits a statement that the applicant is an authorized party, and indicates the reason why the applicant is authorized (e.g., applicant is an authorized agent of the International Federal of Red Cross and Red Crescent Societies).

1205.02 Article 6*ter* of the Paris Convention

The United States is a member of the Paris Convention for the Protection of Industrial Property, as revised at Stockholm on July 14, 1967, the members of which constitute a Union for the protection of industrial property.

Under Article 6*ter* of the Paris Convention, the contracting countries have agreed to refuse or to invalidate the registration, and to prohibit the unauthorized use as trademarks or as elements of trademarks, of armorial bearings, flags, and other State emblems of the member countries, official signs and hallmarks indicating control and warranty adopted by member countries, and any imitation from a heraldic point of view. The provision applies equally to armorial bearings, flags, other emblems, abbreviations, and names of international intergovernmental organizations of which one or more countries of the Union are members, except for those that are already the subject of international agreements in force, intended to ensure their protection (e.g., "Red Cross" and emblems protected by the Geneva Convention of August 12, 1949).

Under Article 6*ter,* each member country or international intergovernmental organization (IGO) may communicate armorial bearings, emblems, official signs and hallmarks indicating warranty and control, and names and abbreviations of IGOs to the IB, who will transmit the communications to the other member countries. Within twelve months from receipt of the notification, a member country may transmit its objections, through the IB.

When the USPTO receives notifications from the IB under Article 6*ter*, the USPTO searches its records for conflicting marks, although the requests are not subjected to a full examination by an examining attorney or published for opposition. If the USPTO determines that a designation should be entered into the USPTO search records to assist USPTO examining attorneys, the designation is assigned a serial number in the "89" series code (i.e., serial numbers beginning with the digits "89," sometimes referred to as "non-registrations"). Information about the designation should be discovered in an examining attorney's search.

Refusal of Marks Notified Under Article 6ter

Depending on the nature and use of the mark, §§2(a) and 2(b) of the Trademark Act, 15 U.S.C. §§1052(a) and 1052(b), may bar registration of marks comprised in whole or in part of designations notified pursuant to Article 6*ter* and to which the United States has transmitted no objections. A refusal under §2(d) of the Trademark Act is ***not*** appropriate. The issue is not whether the marks are confusingly similar, but whether registration of the mark would violate §§2(a) or 2(b) of the Trademark Act.

For example, it may be appropriate for the examining attorney to refuse registration under §2(a) of the Act on the ground that the mark comprises matter that may falsely suggest a connection with a national symbol of a member country or an international intergovernmental organization. *See* **TMEP §1203.03(e).** Other §2(a) bases for refusal could also apply. *See* **TMEP §§1203** *et seq*. It may be appropriate to refuse registration under §2(b) of the Act if the proposed mark comprises a flag, coat of arms, or other similar insignia. *See* **TMEP §1204.** In some instances, it may be appropriate to refuse registration under §§1, 2 (preamble), and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127, on the ground that the subject matter would not be perceived as a trademark. For service mark applications, §3 of the Act, 15 U.S.C. §1053, should also be cited as a basis for refusal.

1206 Refusal on Basis of Name, Portrait, or Signature of Particular Living Individual or Deceased U.S. President Without Consent

Extract from 15 U.S.C. §1052. No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it ... (c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

Section 2(c) of the Trademark Act, 15 U.S.C. §1052(c), bars the registration of a mark that consists of or comprises (whether consisting solely of, or having incorporated in the mark) a name, portrait, or signature that identifies a particular living individual, or a deceased United States president during the life of his widow, except by the written consent of the individual or the

president's widow.

Section 2(c) absolutely bars the registration of these marks on either the Principal Register or the Supplemental Register.

The purpose of requiring the consent of a living individual to the registration of his or her name, signature, or portrait is to protect rights of privacy and publicity that living persons have in the designations that identify them. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 1376, 217 USPQ 505, 509 (Fed. Cir. 1983), *aff'g* 213 USPQ 594 (TTAB 1982); *Canovas v. Venezia 80 S.R.L.,* 220 USPQ 660, 661 (TTAB 1983). *See* **TMEP §1203.03** for a discussion of the right to control the use of one's identity, which underlies part of §2(a) as well as §2(c).

Section 2(c) does not apply to marks that comprise matter that identifies deceased persons, except for a deceased president of the United States during the life of the president's widow. *See McGraw-Edison Co. v. Thomas Edison Life Insurance Co.*, 160 USPQ 685 (TTAB 1969), *vacated on other grounds*, 162 USPQ 372 (N.D. Ill. 1969) (opposition to the registration of THOMAS EDISON dismissed, the Board finding §2(c) inapplicable, as the particular individual whom the name identifies is deceased); *In re Masucci*, 179 USPQ 829 (TTAB 1973) (affirming refusal to register mark consisting of the name EISENHOWER, a portrait of President Dwight D. Eisenhower and the words PRESIDENT EISENHOWER REGISTERED PLATINUM MEDALLION #13, for greeting cards, on the ground that the mark comprises the name, signature, or portrait of a deceased United States president without the written consent of his widow, under §2(c)).

Whether consent to registration is required depends on whether the public would recognize and understand the mark as identifying a particular living individual. There generally must be a connection between the individual and the relevant goods or services. A consent is required only if the individual will be associated with the goods or services, because the person is publicly connected with the business in which the mark is used, is well known in the field relating to the relevant goods or services, or is so well known that the public would reasonably assume a connection. *See* **TMEP §1206.02** for further information.

See **TMEP §1206.03** regarding when it is necessary for an examining attorney to inquire of the applicant as to whether a name, signature, or portrait in a mark identifies a particular living individual, and **TMEP §§813.01** *et seq*. regarding the entry of pertinent statements in the record for printing in the *Official Gazette* and on a registration certificate.

1206.01 Name, Portrait, or Signature of Particular Living Individual

Section 2(c) explicitly pertains to any name, portrait, or signature that identifies a particular living individual, or a deceased president of the United States during the life of the president's widow.

Does Not Have to Be Full Name. A "name" does not have to be the full name of an individual. Section 2(c) also applies to a first name, surname, pseudonym, stage name, title, or nickname, if there is evidence that the name identifies a specific living individual who is generally known or well known in the relevant field, or is publicly connected with the goods or services. *See Ross v. Analytical Technology Inc.*, 51 USPQ2d 1269 (TTAB 1999) (registration of opposer's surname without consent prohibited by §2(c), where the record showed that because of opposer's reputation as an inventor in the field of electrochemical analysis, the relevant public would associate the goods so marked with opposer); *In re Sauer,* 27 USPQ2d 1073 (TTAB 1993), *aff'd per curiam,* 26 F.3d 140 (Fed. Cir. 1994) (BO, the recognized nickname of professional football and baseball star Bo Jackson, found to be so well known by the general public that use of the name BO in connection with sports balls would lead to the assumption that he was in some way associated with the goods or with applicant's business); *In re Steak and Ale Restaurants of America, Inc.*, 185 USPQ 447 (TTAB 1975) (PRINCE CHARLES found to identify a particular living individual whose consent was not of record); *Laub v. Industrial Development Laboratories, Inc.*, 121 USPQ 595 (TTAB 1959) (LAUB, for flowmeters, found to identify the holder of a patent for flowmeters, whose written consent was not of record); *Reed v. Bakers Engineering & Equipment Co.*, 100 USPQ 196 (PTO 1954) (registration of REED REEL OVEN, for ovens, held to be barred by §2(c) without written consent of the designer and builder of the ovens, Paul N. Reed). *Cf. Société Civile Des Domaines Dourthe Frères v. S.A. Consortium Vinicole De Bordeaux Et De La Gironde*, 6 USPQ2d 1205, 1209 (TTAB 1988) ("Section 2(c) does not apply to surnames except in those cases where a particular individual is known by a surname alone.")

Name Could Refer to More Than One Person. The fact that a name appearing in a mark may be the name of more than one person does not negate the requirement for a written consent to registration, if the mark identifies, to the relevant public, a particular living individual who is well known or is publicly connected with the goods or services, or a deceased United States president whose spouse is living. *See Steak and Ale Restaurants,* 185 USPQ at 447 (affirming refusal to register PRINCE CHARLES, for meat, in the absence of consent to register by Prince Charles, a member of the English royal family. "Even accepting the existence of more than one living 'Prince Charles,' it does not follow that each is not a particular living individual.").

Portraits. Cases involving portraits include *In re McKee Baking Co.*, 218 USPQ 287 (TTAB 1983) (mark comprising a sign on which the portrait of a young girl appears below the words LITTLE DEBBIE); *In re Masucci*, 179 USPQ 829 (TTAB 1973) (mark comprising name and portrait of a deceased president of the United States, President Eisenhower); *Garden v. Parfumerie*

Rigaud, Inc., 34 USPQ 30 (Comm'r Pats. 1937) (marks comprising name and portrait of Mary Garden).

1206.02 Connection With Goods or Services

Whether consent to registration is required depends on whether the public would recognize and understand the mark as identifying a particular living individual. A consent is required only if the individual will be associated with the goods or services, either because: (1) the person is generally known or so well known in the field relating to the goods or services that the public would reasonably assume a connection; or (2) the individual is publicly connected with the business in which the mark is used. *Krause v. Krause Publications, Inc.,* 76 USPQ2d 1904 (TTAB 2005), *aff'd per curiam*, No. 2007-1364, 2007 U.S. App. LEXIS 28399 (Fed. Cir. Dec. 7, 2007).

The Trademark Trial and Appeal Board noted as follows in *Martin v. Carter Hawley Hale Stores, Inc.*, 206 USPQ 931, 933 (TTAB 1979):

> [Section] 2(c) was not designed to protect every person from having a name which is similar or identical to his or her name registered as a trademark. Such a scope of protection would practically preclude the registration of a trademark consisting of a name since in most cases there would be someone somewhere who is known by the name and who might be expected to protest its registration. Rather, the Statute was intended to protect one who, for valid reasons, could expect to suffer damage from another's trademark use of his name. That is, it is more than likely that any trademark which is comprised of a given name and surname will, in fact, be the name of a real person. But that coincidence, in and of itself, does not give rise to damage to that individual in the absence of other factors from which it may be determined that the particular individual bearing the name in question will be associated with the mark as used on the goods, either because that person is so well known that the public would reasonably assume the connection or because the individual is publicly connected with the business in which the mark is used.

If the record shows that the name or likeness in the mark is that of a living individual who is actually connected with the applicant, then the individual is publicly connected with the business in which the mark is used, and the examining attorney must require consent.

If no one by the name of the person identified in the mark is connected with the applicant, and no person by the name in the mark is generally known or well known in the field relating to the relevant goods or services, the mark generally would not be deemed to identify a particular person under §2(c), and consent would not be required.

In *Martin*, the Board held that §2(c) did not prohibit registration of NEIL MARTIN for men's shirts, where the individual, although well known in his own professional and social circles, failed to establish that he was so famous as to be recognized by the public in general, or that he is or ever was publicly connected or associated with the clothing field.

In *Krause,* evidence was found sufficient to establish that the cancellation petitioner was publicly connected with the fields of numismatics, car collecting, and publishing, such that a connection between petitioner and the mark KRAUSE PUBLICATIONS would be presumed by people who have an interest in these fields. Thus, the mark was unregistrable for magazines featuring antique automobiles and numismatics, conducting trade shows and award programs featuring coins, and other related goods and services. However, the mark was found registrable for "entertainment services in the nature of competitions and awards in the field of cutlery," because petitioner had not demonstrated that he was publicly connected with the field of cutlery, or that he is so well known by the general public that a connection between petitioner and the mark would be presumed with respect to these services. *See also Ross v. Analytical Technology Inc*., 51 USPQ2d 1269 (TTAB 1999) (evidence found sufficient to establish that opposer Dr. James Ross was publicly connected with the electrochemical analysis equipment field and that use of the name ROSS in connection with equipment in that field would lead to the assumption that opposer was in some way associated with the goods); *In re Sauer,* 27 USPQ2d 1073 (TTAB 1993), *aff'd per curiam,* 26 F.3d 140 (Fed. Cir. 1994) (BO, the recognized nickname of professional football and baseball star Bo Jackson, found to be so well known by the general public that use of the name BO in connection with sports balls would lead to the assumption that he was in some way associated with the goods or with applicant's business); *Fanta v. Coca-Cola Co.*, 140 USPQ 674 (TTAB 1964) (dismissing a petition to cancel registrations of FANTA for soft drinks and syrup concentrate, the Board noting no use by the petitioner, Robert D. Fanta, of his name in connection with the sale of soft drinks, nor any indication that petitioner had attained recognition in that field); *Brand v. Fairchester Packing Co.*, 84 USPQ 97 (Comm'r Pats. 1950) (affirming dismissal of a petition to cancel the registration of ARNOLD BRAND, for fresh tomatoes, the Commissioner finding nothing in the record to indicate that the mark identified the petitioner, Arnold Brand, an attorney specializing in patent and trademark matters, with the tomato business, or that use of the mark would lead the public to make such a connection).

To support a refusal under §2(c) as to a particular class in an application, it is not necessary to demonstrate that the individual is publicly connected with all the goods or services listed in the class. It is enough to show that the individual is publicly connected with at least some of the goods/services in the class. *Krause, supra*.

1206.03 When Inquiry is Required

Old Edition

If a mark comprises a name or likeness that could *reasonably* be perceived as identifying a particular living individual, and the applicant does not state whether the name or likeness does in fact identify a living individual, the examining attorney must inquire whether the name or likeness is that of a specific living individual and advise the applicant that, if so, the individual's written consent to register the name or likeness must be submitted.

Full Name. Generally, if a mark comprises a full name, e.g., a first name and surname, the examining attorney must issue an inquiry as to whether the mark comprises the name of a living individual, unless it is clear from the record that the name is not that of a living individual. It is not necessary to establish that the individual is well known in the relevant field before making the inquiry.

> *Example:* The mark is STEVEN JONES, and the application is silent as to whether this name identifies a living individual. The examining attorney must inquire whether the name is that of a specific living individual and advise the applicant that, if so, the individual's written consent to register the name must be submitted.

Portrait or Likeness. Generally, if the mark comprises a portrait, or a likeness that could *reasonably* be perceived as that of a particular living individual, the examining attorney must issue an inquiry as to whether the mark comprises the likeness of living individual, unless it is clear from the record that the likeness is not that of a living individual. It is not necessary to establish that the individual is well known in the relevant field before making the inquiry.

Fictitious Character. The examining attorney should not make an inquiry if it is clear from the record, or from the examining attorney's research, that the matter identifies a fictitious character. For example, no inquiry is necessary as to whether "Alfred E. Neuman," "Betty Crocker," or "Aunt Jemima" is the name of a particular living individual; and no inquiry is necessary as to a design that is obviously that of a cartoon character.

First Name, Pseudonym, Stage Name, Surname, Nickname, or Title. If the mark comprises a first name, pseudonym, stage name, nickname, surname, or title (e.g., "Mrs. Johnson" or "Aunt Sally"), the examining attorney must determine whether there is evidence that the name identifies an individual who is well known in the field relating to the relevant goods or services. *See* **TMEP §1206.02.** This may be done through an Internet search. If there is no evidence that the name identifies a living individual who is generally known or well known in the relevant field, the examining attorney should not issue an inquiry.

> *Example:* The mark is DOCTOR JONES, and the application is silent as to whether this name identifies a living individual. If there is evidence that the name identifies an individual who is generally known or well known in the relevant field, the examining attorney must issue an inquiry and require the individual's written consent to register the name. If there is no evidence that the name identifies an individual who is generally known or well known in the relevant field, the examining attorney should not inquire or require consent.

> *Example:* The mark is JOE for cookies, and the application is silent as to whether this name identifies a living individual. Unless there is evidence that the name is generally known or well known in the relevant field, the examining attorney should not inquire or require consent.

> *Example:* The mark is LYNCH'S LIGHTING for lamps, and the application is silent as to whether this name identifies a living individual. Unless there is evidence that the name is generally known or well known in the relevant field, the examining attorney should not inquire or require consent.

Famous Deceased Person or Historical Character. When it appears that the mark comprises the name or likeness of a famous deceased person or historical character, the examining attorney must issue an Office action requiring confirmation from the applicant that the person is in fact deceased, and require that the applicant submit a statement that the name or likeness shown in the mark does not identify a living individual. It is not necessary to print the statement.

Statement of Record in Prior Registration. If the applicant claims ownership of a valid registration for a mark comprised in whole or in part of the same name, portrait, or signature for any goods or services, and the prior registration includes a statement that the name, portrait, or signature is not that of a living individual, the examining attorney may enter the same statement in the record, even if applicant does not resubmit or reference the statement. It is not necessary to issue an inquiry in this situation. *See* **TMEP §§813.01(b)** and **1206.05.**

1206.04 Consent of Individual or President's Widow

1206.04(a) Consent Statement Must Be Written Consent to Registration

Must Be Personally Signed. When a name, portrait, or signature in a mark identifies a particular living individual, or a deceased president of the United States during the life of his widow, the mark can be registered only with the written consent of the individual, or of the president's widow. The consent must be a written consent to the registration of the identifying matter as a mark, and must be personally signed by the individual whose name or likeness appears in the mark.

Consent to Use is Not Consent to Registration. Consent to use of a mark does not constitute consent to register. *Krause v. Krause Publications, Inc.,* 76 USPQ2d 1904 (TTAB 2005), *aff'd per curiam*, No. 2007-1364, 2007 U.S. App. LEXIS 28399 (Fed. Cir. Dec. 7, 2007); *Reed v. Bakers Engineering & Equipment Co.*, 100 USPQ 196, 199 (PTO 1954); *Garden v. Parfumerie Rigaud, Inc.*, 34 USPQ 30, 31 (Comm'r Pats. 1937) (granting petition to cancel registrations of marks that named and portrayed the petitioner, Mary Garden, who, although she had consented to the use of her name and portrait in connection with a particular perfume, had not given written consent to register the marks for perfumes and other cosmetic items. "Permission to use one's name and portrait in connection with a specified item of merchandise falls far short of consent to register one's name and portrait as a trade mark for such merchandise generally.") Consent to *register* a mark that makes no reference to consent to *use* is acceptable; the USPTO has no authority to regulate use of a mark.

Minors. If the record indicates that the person whose name or likeness appears in the mark is a minor, the question of who should sign the consent depends on state law. If the minor can validly enter into binding legal obligations, and can sue or be sued, in the state in which he or she is domiciled, then the minor may sign the consent. Otherwise, the consent should be signed by a parent or legal guardian, clearly setting forth his or her status as a parent or legal guardian. If the record indicates that person whose name or likeness appears in the mark is a minor, the examining attorney must inquire as to whether the person can validly enter into binding legal obligations under the law of the state in which he or she is domiciled. If the minor cannot enter into binding legal obligations, the examining attorney must require consent by the parent or guardian. *See* **TMEP §803.01** regarding the filing of an application in the name of a minor.

1206.04(b) Consent May Be Presumed From Signature of Application

When a particular individual identified in a mark is also the person who signed the application, his or her consent to registration will be presumed. *Alford Mfg. Co. v. Alfred Electronics*, 137 USPQ 250 (TTAB 1963), *aff'd,* 333 F.2d 912, 142 USPQ 168 (C.C.P.A. 1964) ("The written consent to the registration of the mark 'ALFORD' by Andrew Alford, the individual, is manifested by the fact that said person executed the application...."); *Ex parte Dallioux*, 83 USPQ 262, 263 (Comm'r Pats. 1949) ("By signing the application, the applicant here obviously consents...."). Consent may be presumed whenever the person identified has signed the application, even if the applicant is not an individual.

Name of Signatory. Consent to register is presumed if the application is personally signed by the individual whose name appears in the mark, e.g., if the mark is JOHN SMITH, and the application is personally signed by John Smith. The examining attorney should not make an inquiry or require a written consent. The examining attorney must ensure that the consent statement (*see* **TMEP §813.01(a))** is entered into the TRAM database. The consent statement must be printed even if the name that appears in the mark is that of the applicant.

Names Must Match. Consent may be presumed only where the name in the mark matches the name of the signatory. If the names do not match, the examining attorney must issue an inquiry. For example, if the name in the mark is J.C. Jones, and the application is signed by John Jones, the examining attorney must inquire whether J.C. Jones is John Jones. If applicant states that J.C. Jones is John Jones, consent is presumed. The statement that J.C. Jones is John Jones may be entered by examiner's amendment, if appropriate.

Likeness of Signatory. Consent may also be presumed when the mark comprises the portrait or likeness of the person who personally signs the application. When the mark comprises a portrait, or a likeness that could *reasonably* be perceived as that of a particular living individual, the examining attorney must make an inquiry, unless the record indicates that the likeness is that of the person who signed the application. If the applicant responds by stating that the likeness is that of the person who signed the application, consent is presumed. No written consent is required, but the examining attorney must ensure that the consent statement (*see* **TMEP §813.01(a))** is entered into the TRAM database.

Application Must be Personally Signed. Consent may be presumed only where the individual whose name or likeness appears in the mark *personally* signs the application. If the application is signed by an authorized signatory, consent to register the name or likeness must be obtained from the individual. This is true even where the name or likeness that appears in the mark is that of the individual applicant.

Section 66(a) Applications. In a §66(a) application, the signed verification is part of the international registration on file at the IB and is not included with the request for extension of protection sent to the USPTO. 37 C.F.R. §2.33(e); **TMEP §1904.01(c).** The examining attorney is thus unable to determine who signed the verified statement. Therefore, the examining attorney must require a written consent to register, even where the name that appears in the mark is that of the applicant. If the verified statement in support of the request for extension of protection to the United States was personally signed by the individual whose name or likeness appears in the mark, the applicant may satisfy the requirement for a written consent to registration by submitting a copy of the verified statement that is on file with the IB.

1206.04(c) New Consent Not Required if Consent is of Record in Valid Registration Owned by Applicant

An applicant does not have to submit a new consent if a consent to register is already part of the record in the file of a valid

registration for a mark comprised in whole or in part of the same name, portrait, or signature for the same goods or services. In this situation, the applicant only has to: (1) claim ownership of that existing registration; and (2) advise the examining attorney that the consent is of record therein. If the applicant provides the information that the consent is of record in the claimed registration by telephone, the examining attorney must make an appropriate note in the "Notes-to-the-File" section of the record. The examining attorney must ensure that the consent statement is entered into the TRAM database (*see* **TMEP §813.01(a)).**

If an applicant has submitted a consent to register in an application that has not matured to registration, a new consent is not required for pertinent co-pending applications, but the applicant must submit a copy of the consent for each pending application. *In re McKee Baking Co.*, 218 USPQ 287 (TTAB 1983) (applicant's claim of ownership of a prior registration that includes a consent to register in the record held sufficient for purposes of complying with the consent requirement of the Act); 37 C.F.R. §2.193(g).

See **TMEP §§813.01(b)** and **1206.05** regarding statements that a name or likeness that could reasonably be perceived as that of a living individual is *not* that of a specific living individual.

1206.04(d) Implicit Consent

Consent may sometimes be inferred from the actions of the individual. *In re D.B. Kaplan Delicatessen*, 225 USPQ 342, 344 (TTAB 1985) (consent to the use and registration of the mark D. B. KAPLAN'S DELICATESSEN, for restaurant services, found to be implicit in the terms of a "buy-out" agreement that relinquished all property rights in the name and forbade its use by the named party in any subsequent business). However, the mere incorporation of a business or consent to the business's use of the mark does not constitute implied consent to the *registration* of the mark. *Krause v. Krause Publications, Inc.,* 76 USPQ2d 1904 (TTAB 2005), *aff'd per curiam*, No. 2007-1364, 2007 U.S. App. LEXIS 28399 (Fed. Cir. Dec. 7, 2007) (cancellation petitioner did not give implied consent to register when he incorporated a business, sold his stock in the business, and pledged his assets to finance expansion and acquisitions, and acquiesced in the corporation's use of the mark for 50 years, where there was no evidence that the individual expressly stated that the mark was the property of the corporation, or agreed to refrain from use of the name in any subsequent business); *In re New John Nissen Mannequins*, 227 USPQ 569 (TTAB 1985) (consent to register not implied from appearance of the name "John Nissen" in a deed of incorporation of applicant's predecessor, nor from existence of foreign registrations incorporating the name).

1206.05 Names and Likenesses That Do Not Identify a Particular Living Individual

If it appears that a name, portrait, or signature in a mark may identify a particular living individual but, in fact, the applicant devised the matter as fanciful, or believes it to be fanciful, the applicant may be required to submit a statement to that effect. *See* **TMEP §813.01(b)** for further information as to when a statement that a name or likeness is not that of a living individual should be printed, and **TMEP §1206.03** for information as to when an examining attorney should inquire as to whether a name or likeness is that of an individual.

The applicant should explain any additional relevant circumstances. For example, if the matter identifies a certain character in literature, or a deceased historical person, then a statement of these facts in the record may be helpful; however, this information will not be printed in the *Official Gazette* or on the registration certificate.

No statement should be printed unless the name or portrait might *reasonably* be perceived as that of a specific living individual. This is true even if the applicant submits an unsolicited statement that a particular name or portrait does not identify a living individual.

Generally, if the name or likeness is such that an inquiry would have been required as to whether it identifies a living individual (*see* **TMEP §1206.03)**, and the applicant states that the mark does not identify a living individual, then the statement that the name or likeness does not identify a living individual should be printed.

If the applicant owns a valid registration for a mark comprised in whole or in part of the same name, portrait, or signature for any goods or services, and the record for the registration contains a statement that the name or likeness is *not* that of a living individual, the applicant should claim ownership of the registration and advise the examining attorney that the statement is of record therein. The examining attorney may then enter the same statement in the record for the application, even if applicant does not resubmit or reference the statement. It is not necessary to issue an inquiry in this situation.

1207 Refusal on Basis of Likelihood of Confusion, Mistake, or Deception

Extract from 15 U.S.C. §1052. No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it ... (d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the

applicant, to cause confusion, or to cause mistake, or to deceive....

Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), is the statutory basis for a refusal to register due to likelihood of confusion with another mark. Section 2(d) applies to both the Principal and the Supplemental Registers.

1207.01 Likelihood of Confusion

In the ex parte examination of a trademark application, a refusal under §2(d) is normally based on the examining attorney's conclusion that the applicant's mark, as used on or in connection with the specified goods or services, so resembles a *registered* mark as to be likely to cause confusion. (*See* **TMEP §1207.02** concerning §2(d) refusals to register marks that so resemble another mark as to be likely to deceive, and **TMEP §1207.03** concerning §2(d) refusals based on unregistered marks. *Note:* Refusals based on unregistered marks are not issued in ex parte examination.)

The examining attorney must conduct a search of USPTO records to determine whether the applicant's mark so resembles any registered mark(s) as to be likely to cause confusion or mistake, when used on or in connection with the goods or services identified in the application. The examining attorney also searches pending applications for conflicting marks with earlier effective filing dates. *See* **TMEP §§1208** *et seq*. regarding conflicting marks. The examining attorney must place a copy of the search strategy in the record.

If the examining attorney determines that there is a likelihood of confusion between applicant's mark and a previously registered mark, the examining attorney refuses registration under §2(d). Before citing a registration, the examining attorney must check the automated records of the USPTO to confirm that any registration that is the basis for a §2(d) refusal is an active registration. *See* **TMEP §716.02(e)** regarding suspension pending cancellation of a cited registration under §8 of the Act or expiration of a cited registration for failure to renew under §9 of the Act.

Also, if USPTO records indicate that an assignment of the conflicting registration has been recorded, the examining attorney should check the automated records of the Assignment Services Branch of the USPTO to determine whether the conflicting mark has been assigned to applicant.

In *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), the Court of Customs and Patent Appeals discussed the factors relevant to a determination of likelihood of confusion. In ex parte examination, the issue of likelihood of confusion typically revolves around the similarity or dissimilarity of the marks and the relatedness of the goods or services. The other factors listed in *du Pont* may be considered only if relevant evidence is contained in the record. *See In re Majestic Distilling Co.,* 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003) ("Not all of the *DuPont* factors may be relevant or of equal weight in a given case, and 'any one of the factors may control a particular case,'" quoting *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 1406-07, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)); *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 640 (TTAB 1984). In an ex parte case, the following factors are usually the most relevant:

- The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
- The relatedness of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
- The similarity or dissimilarity of established, likely-to-continue trade channels.
- The conditions under which and buyers to whom sales are made, i.e., "impulse" vs. careful, sophisticated purchasing.
- The number and nature of similar marks in use on similar goods.
- A valid consent agreement between the applicant and the owner of the previously registered mark.

The Court of Appeals for the Federal Circuit has provided the following guidance with regard to determining and articulating likelihood of confusion:

> The basic principle in determining confusion between marks is that marks must be compared in their entireties and must be considered in connection with the particular goods or services for which they are used (citations omitted). It follows from that principle that likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark (footnote omitted). On the other hand, in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties (footnote omitted). Indeed, this type of analysis appears to be unavoidable.

In re National Data Corp., 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985).

There is no mechanical test for determining likelihood of confusion. The issue is not whether the actual goods are likely to be confused but, rather, whether there is a likelihood of confusion as to the *source* of the goods. *In re Shell Oil Co.,* 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993), and cases cited therein. Each case must be decided on its own facts.

The determination of likelihood of confusion under §2(d) in an intent-to-use application under §1(b) of the Trademark Act does not differ from the determination in any other type of application.

1207.01(a) Relatedness of the Goods or Services

In assessing the relatedness of the goods and/or services, the more similar the marks at issue, the less similar the goods or services need to be to cause a likelihood of confusion. *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993). If the marks of the respective parties are identical, the relationship between the goods or services need not be as close to support a finding of likelihood of confusion as would be required in a case where there are differences between the marks. *Amcor, Inc. v. Amcor Industries, Inc.*, 210 USPQ 70, 78 (TTAB 1981).

In some instances, because of established marketing practices, the use of identical marks on seemingly unrelated goods and services could result in a likelihood of confusion. *See In re Phillips-Van Heusen Corp.*, 228 USPQ 949, 951 (TTAB 1986) ("The licensing of commercial trademarks for use on 'collateral' products (such as clothing, glassware, linens, etc.), that are unrelated in nature to those goods or services on which the marks are normally used, has become a common practice in recent years.")

1207.01(a)(i) Goods or Services Need Not Be Identical

The goods or services do not have to be identical or even competitive in order to determine that there is a likelihood of confusion. The inquiry is whether the goods are related, not identical. The issue is not whether the goods will be confused with each other, but rather whether the public will be confused about their source. *See Safety-Kleen Corp. v. Dresser Indus., Inc*., 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975). It is sufficient that the goods or services of the applicant and the registrant are so related that the circumstances surrounding their marketing are such that they are likely to be encountered by the same persons under circumstances that would give rise to the mistaken belief that they originate from the same source. *See, e.g., On-line Careline Inc. v. America Online Inc.,* 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000) (ON-LINE TODAY for Internet connection services held likely to be confused with ONLINE TODAY for Internet content); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984) (MARTIN'S for wheat bran and honey bread held likely to be confused with MARTIN'S for cheese); *In re Toshiba Medical Systems Corp.,* 91 USPQ2d 1266 (TTAB 2009) (VANTAGE TITAN for MRI diagnostic equipment held likely to be confused with TITAN for medical ultrasound device); *L.C. Licensing, Inc. v. Berman*, 86 USPQ2d 1883 (TTAB 2008) (ENYCE for custom automotive accessories held likely to be confused with ENYCE for various clothing items and accessories directed to the urban lifestyle market); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM for a buffered solution equilibrated to yield predetermined dissolved gas values in a blood gas analyzer held likely to be confused with CONFIRMCELLS for diagnostic blood reagents for laboratory use); *In re Jeep Corp.*, 222 USPQ 333 (TTAB 1984) (LAREDO for land vehicles and structural parts therefor held likely to be confused with LAREDO for pneumatic tires).

Conversely, if the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely. *See, e.g., Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER and design for advertising services, namely the formulation and preparation of advertising copy and literature in the plumbing field); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cable held not confusingly similar to QR for various products (e.g., lamps, tubes) related to the photocopying field).

1207.01(a)(ii) Goods May Be Related to Services

It is well recognized that confusion is likely to occur from the use of the same or similar marks for goods, on the one hand, and for services involving those goods, on the other. *See, e.g., In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (BIGG'S (stylized) for retail grocery and general merchandise store services held likely to be confused with BIGGS and design for furniture); *In re H.J. Seiler Co.,* 289 F.2d 674, 129 USPQ 347 (C.C.P.A. 1961) (SEILER's for catering services held likely to be confused with SEILER'S for smoked and cured meats); *In re United Service Distributors, Inc.*, 229 USPQ 237 (TTAB 1986) (design for distributorship services in the field of health and beauty aids held likely to be confused with design for skin cream); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB for various items of men's, boys', girls', and women's clothing held likely to be confused with THE "21" CLUB (stylized) for restaurant services and towels); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE (stylized) for retail women's clothing store services and

clothing held likely to be confused with CREST CAREER IMAGES (stylized) for uniforms); *Steelcase Inc. v. Steelcare Inc*., 219 USPQ 433 (TTAB 1983) (STEELCARE INC. for refinishing of furniture, office furniture, and machinery held likely to be confused with STEELCASE for office furniture and accessories); *Corinthian Broadcasting Corp. v. Nippon Electric Co., Ltd.,* 219 USPQ 733 (TTAB 1983) (TVS for transmitters and receivers of still television pictures held likely to be confused with TVS for television broadcasting services); *In re Industrial Expositions, Inc*., 194 USPQ 456 (TTAB 1977) (POLLUTION ENGINEERING EXPOSITION for programming and conducting of industrial trade shows held likely to be confused with POLLUTION ENGINEERING for a periodical magazine).

1207.01(a)(ii)(A) Food and Beverage Products Versus Restaurant Services

While likelihood of confusion has often been found in situations where similar marks are used in connection with both food or beverage products and restaurant services, there is no per se rule to this effect. To establish likelihood of confusion, a party must show "something more than that similar or even identical marks are used for food products and for restaurant services." *In re Coors Brewing Co.,* 343 F.3d 1340, 1345, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003) (no likelihood of confusion between applicant's BLUE MOON and design for beer and the registered mark BLUE MOON and design for restaurant services); *Jacobs v. International Multifoods Corp.*, 668 F.2d 1234, 1236, 212 USPQ 641, 642 (C.C.P.A. 1982) (no likelihood of confusion between BOSTON SEA PARTY for restaurant services and BOSTON TEA PARTY for tea).

The determination of the relatedness of the goods and services is based on the evidence provided by the applicant and the examining attorney. In *Coors*, the examining attorney introduced evidence from several sources discussing the practice of some restaurants to offer private label or house brands of beer; evidence that brewpubs who brew their own beer often feature restaurant services; and copies of third-party registrations showing that a single mark had been registered for beer and restaurants services. However, applicant countered with evidence that while there are about 1,450 brewpubs and microbreweries in the United States, there are over 800,000 restaurants, which means that brewpubs and microbreweries account for only about 18 one-hundredths of one percent of all restaurants. Noting that "[t]here was no contrary evidence introduced on those points," the court found that:

> While there was evidence that some restaurants sell private label beer, that evidence did not suggest that such restaurants are numerous. And although the Board had before it a few registrations for both restaurant services and beer, the very small number of such dual use registrations does nothing to counter Coors' showing that only a very small percentage of restaurants actually brew their own beer or sell house brands of beer; instead, the small number of such registrations suggests that it is quite uncommon for restaurants and beer to share the same trademark. Thus, the evidence before the Board indicates not that there is a substantial overlap between restaurant services and beer with respect to source, but rather that the degree of overlap between the sources of restaurant services and the sources of beer is *de minimis*. We therefore disagree with the Board's legal conclusion that Coors' beer and the registrant's restaurant services are sufficiently related to support a finding of a likelihood of confusion.

343 F.3d at 1346, 68 USPQ2d at 1063-1064.

See also Lloyd's Food Products, Inc. v. Eli's, Inc., 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993) (Board erred in failing to consider evidence of third party use of service marks in telephone directories); *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001) (likelihood of confusion between OPUS ONE used on both wine and restaurant services, where the evidence showed that it is common in the industry for restaurants to offer and sell private label wines named after the restaurant, and that registrant's wines were actually served at applicant's restaurant); *In re Comexa Ltda.,* 60 USPQ2d 1118, 1123 (TTAB 2001) (likelihood of confusion found between AMAZON for restaurant services and AMAZON and design for chili sauce and pepper sauce, where 50 third-party registrations (48 based on use) showing registration of the same mark for sauces and restaurant services were probative to the extent that they served to suggest that the goods and services were of a kind that may emanate from a single source); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209, 1211 (TTAB 1999) (AZTECA MEXICAN RESTAURANT for restaurant services held likely to be confused with AZTECA for tortillas, taco shells, and salsa, where the evidence indicated that the goods at issue were "Mexican food items" of a type that were "often principal items of entrees served by … Mexican restaurants"); *In re Golden Griddle Pancake House Ltd.*, 17 USPQ2d 1074 (TTAB 1990) (likelihood of confusion between GOLDEN GRIDDLE for table syrup and GOLDEN GRIDDLE PANCAKE HOUSE for restaurant that serves pancakes and syrup); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1469 (TTAB 1988), *aff'd,* 864 F.2d 149 (Fed. Cir. 1988) (likelihood of confusion between MUCKY DUCK and duck design for mustard and THE MUCKY DUCK and duck design for restaurant services, the Board finding that "[a]lthough these goods and services obviously differ, mustard is … a condiment which is commonly utilized in restaurants by their patrons, especially in such restaurants as delicatessens, fast food houses, steak houses, taverns, inns, and the like, and we think it is common knowledge that restaurants sometimes market their house specialties, including items such as salad dressings, through retail outlets"); *Steve's Ice Cream v. Steve's Famous Hot Dogs*, 3 USPQ2d 1477, 1478 (TTAB 1987) (no likelihood of confusion between STEVE'S for ice cream and STEVE'S for restaurant featuring hot dogs, where the marks differed and "there [was] no evidence in the record before us that applicant makes or sells ice cream, or that any one business makes and sells ice cream under the same mark in connection with which it renders

restaurant services").

1207.01(a)(iii) Reliance on Identification of Goods/Services in Registration and Application

The nature and scope of a party's goods or services must be determined on the basis of the goods or services recited in the application or registration. *See, e.g., Hewlett-Packard Co. v. Packard Press Inc.,* 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *In re Shell Oil Co.,* 992 F.2d 1204, 1208 n.4, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); *J & J Snack Foods Corp. v. McDonald's Corp*., 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (C.C.P.A. 1973).

If the cited registration describes goods or services broadly, and there is no limitation as to the nature, type, channels of trade, or class of purchasers, it is presumed that the registration encompasses all goods or services of the type described, that they move in all normal channels of trade, and that they are available to all classes of purchasers. *See, e.g., In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1638 (TTAB 2009) ("We have no authority to read any restrictions or limitations into the registrant's description of goods."); *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006). Therefore, if the cited registration has a broad identification of goods or services, an applicant does not avoid likelihood of confusion merely by more narrowly identifying its related goods. *See, e.g., In re Linkvest S.A.,* 24 USPQ2d 1716 (TTAB 1992) (where a registrant's goods are broadly identified as "computer programs recorded on magnetic disks," without any limitation as to the kind of programs or the field of use, it is necessary to assume that the registrant's goods encompass all such computer programs, and that they travel in the same channels of trade and are available to all classes of prospective purchasers of those goods); *In re Diet Center Inc.*, 4 USPQ2d 1975 (TTAB 1987) (VEGETABLE SVELTES for wheat crackers sold through franchised outlets offering weight reduction services held likely to be confused with SVELTE for low-calorie frozen dessert); *In re Uncle Sam Chemical Co., Inc.*, 229 USPQ 233 (TTAB 1986) (SPRAYZON for cleaning preparations and degreasers for industrial and institutional use held likely to be confused with SPRA-ON and design for preparation for cleaning woodwork and furniture). Similarly, there is a likelihood of confusion if an applicant identifies its goods or services so broadly that the identification encompasses the goods or services identified in the registration of a similar mark. *See, e.g., In re Americor Health Services*, 1 USPQ2d 1670 (TTAB 1986) (RESOLVE for corporate employee assistance services, namely, providing confidential mental health counseling services, held likely to be confused with RESOLVE for counseling services in the field of infertility); *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986) (RESPONSE for banking services held likely to be confused with RESPONSE CARD for banking services rendered through 24-hour teller machines).

An applicant may not restrict the scope of its goods and/or the scope of the goods covered in the registration by extrinsic argument or evidence, for example, as to the quality or price of the goods. *See, e.g., In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986).

Where the terminology in the identification is unclear, the Trademark Trial and Appeal Board has permitted an applicant to provide extrinsic evidence to show that the registrant's identification has a specific meaning to members of the trade. The Board noted that in light of such evidence it is improper to consider the identification in a vacuum and attach all possible interpretations to it. *In re Trackmobile Inc.*, 15 USPQ2d 1152, 1154 (TTAB 1990).

1207.01(a)(iv) No "Per Se" Rule

The facts in each case vary and the weight to be given each factor may be different in light of the varying circumstances; therefore, there can be no rule that certain goods or services are *per se* related, such that there must be a likelihood of confusion from the use of similar marks in relation thereto. *See, e.g., In re White Rock Distilleries Inc.,* 92 USPQ2d 1282 (TTAB 2009) (regarding alcoholic beverages); *Information Resources Inc. v. X*Press Information Services*, 6 USPQ2d 1034, 1038 (TTAB 1988) (regarding computer hardware and software); *Hi-Country Foods Corp. v. Hi Country Beef Jerky*, 4 USPQ2d 1169, 1171 (TTAB 1987) (regarding food products); *In re Quadram Corp.*, 228 USPQ 863, 865 (TTAB 1985) (regarding computer hardware and software); *In re British Bulldog, Ltd.*, 224 USPQ 854, 855-56 (TTAB 1984), and cases cited therein (regarding clothing). *See also M2 Software, Inc. v. M2 Communications, Inc.,* 450 F.3d 1378, 1383, 78 USPQ2d 1944, 1947-1948 (Fed. Cir. 2006) (relatedness between software-related goods may not be presumed on the mere basis that the goods are delivered in the same media format; rather, a subject-matter-based mode of analysis of the relatedness of the fields of use is the appropriate analysis).

1207.01(a)(v) Expansion-of-Trade Doctrine

The expansion-of-trade doctrine has limited application in ex parte proceedings, and the Trademark Trial and Appeal Board has indicated that "[i]t is not necessary, . . . in the context of an ex parte proceeding, for the Office to show that the owner of the particular registration that has been cited against the application has expanded or will expand its goods or services." *In re 1st*

USA Realty Prof'ls, 84 USPQ2d 1581, 1584 n.4 (TTAB 2007).

The doctrine is typically applied in inter partes proceedings where an opposer claims that its priority of use of a mark with respect to its goods/services should be extended to include applicant's goods/services because they are in the natural scope of expansion of opposer's goods/services. *See id.* at 1584. However, in the ex parte context, the normal relatedness analysis is applied:

> [W]e look at the question of the relatedness of the services identified in applicant's application and those in the cited registration based on whether consumers are likely to believe that the services emanate from a single source, rather than whether the Examining Attorney has shown that the registrant herein has or is likely to expand its particular business to include the services of applicant.

Id.

To the extent the expansion-of-trade doctrine does apply in ex parte cases, it "is considered through a traditional relatedness of goods and services approach." *Id.* at 1584 n.4.

1207.01(a)(vi) Evidence Showing Relatedness of Goods or Services

The examining attorney must provide evidence showing that the goods and services are related to support a finding of likelihood of confusion. *See In re White Rock Distilleries Inc.,* 92 USPQ2d 1282 (TTAB 2009) (VOLTA for vodka infused with caffeine held not likely to be confused with TERZA VOLTA and design for wines in that there was no evidence that vodka and wine emanate from a single source, under a single mark, or that the goods were complementary products that would be bought and used together). Evidence of relatedness might include news articles and/or evidence from computer databases showing that the relevant goods/services are used together or used by the same purchasers; advertisements showing that the relevant goods/services are advertised together or sold by the same manufacturer or dealer; or copies of prior use-based registrations of the same mark for both applicant's goods/services and the goods/services listed in the cited registration. *See* **TMEP §1207.01(d)(iii)** and cases cited therein regarding the probative value of third-party registrations.

The identification of goods/services in the subject application and in the cited registration(s) may in itself constitute evidence of the relatedness of the goods or services. *Hewlett-Packard Co. v. Packard Press Inc*., 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (Board erred in finding that there was insufficient evidence of relatedness, "because the Board did not consider the important evidence already before it, namely the ITU application and [opposer's multiple] registrations").

1207.01(b) Similarity of the Marks

If it appears that confusion may be likely as a result of the contemporaneous use of similar marks by the registrant and the applicant with the identified goods or services, the next step is to evaluate the marks themselves, in relation to the goods and services. Under *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973), the first factor requires examination of "the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression." The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison, but whether the marks are sufficiently similar that there is a likelihood of confusion as to the source of the goods or services. When considering the similarity of the marks, "[a]ll relevant facts pertaining to appearance, sound, and connotation must be considered before similarity as to one or more of those factors may be sufficient to support a finding that the marks are similar or dissimilar." *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000). In evaluating the similarities between marks, the emphasis must be on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Where the goods are identical, "the degree of similarity [between the marks] necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), *cert. denied* 506 U.S. 1034 (1992); *Starbucks U.S. Brands, LLC v. Ruben*, 78 USPQ2d 1741, 1752 (TTAB 2006) (quoting this language from *Century 21* and finding LESSBUCKS COFFEE similar in appearance, sound, and overall commercial impression to STARBUCKS and STARBUCKS COFFEE); *ECI Division of E-Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443 (TTAB 1980).

1207.01(b)(i) Word Marks

The points of comparison for a word mark are appearance, sound, meaning, and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005), citing *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Similarity of the marks in one respect – sight, sound, or meaning – will not automatically result in a finding of likelihood of confusion even if the goods are identical or closely related. Rather, the rule is that taking into account all of the relevant facts of a particular case, similarity as to

one factor alone *may* be sufficient to support a holding that the marks are confusingly similar. *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987).

1207.01(b)(ii) Similarity In Appearance

Similarity in appearance is one factor in determining whether there is a likelihood of confusion between marks. Marks may be confusingly similar in appearance despite the addition, deletion, or substitution of letters or words. *See, e.g., Weiss Associates Inc. v. HRL Associates*, *Inc.,* 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (TMM held confusingly similar to TMS, both for systems software); *Canadian Imperial Bank of Commerce*, *N.A.*, *v. Wells Fargo Bank,* 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH held likely to be confused with COMMUNICASH, both for banking services); *Ava Enterprises, Inc. v. Audio Boss USA, Inc.*, 77 USPQ2d 1783 (TTAB 2006) (AUDIO BSS USA and design for car power amplifiers, car speakers, car stereos, and home theater speakers held likely to be confused with BOSS AUDIO SYSTEMS and design for automobile audio components); *In re Lamson Oil Co.*, 6 USPQ2d 1041 (TTAB 1987) (TRUCOOL for synthetic coolant held likely to be confused with TURCOOL for cutting oil); *In re Curtice-Burns, Inc.*, 231 USPQ 990 (TTAB 1986) (MCKENZIE'S (stylized) for processed frozen fruits and vegetables held likely to be confused with MCKENZIE for canned fruits and vegetables); *In re Pix of America, Inc.*, 225 USPQ 691 (TTAB 1985) (NEWPORTS for women's shoes held likely to be confused with NEWPORT for outer shirts); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON for microprocessor used in commercial laundry machines held likely to be confused with MILLTRONICS (stylized) for electronic control devices for machinery); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL for resinous chemicals used in dyeing textiles held likely to be confused with LUTEX for non-resinous chemicals used in the textile industry).

1207.01(b)(iii) Comparing Marks That Contain Additional Matter

It is a general rule that likelihood of confusion is not avoided between otherwise confusingly similar marks merely by adding or deleting a house mark or matter that is descriptive or suggestive of the named goods or services. Sometimes, the rule is expressed in terms of the dominance of the common term. Therefore, if the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral differences. *See, e.g.,In re Mighty Leaf Tea,* 601 F.3d 1342, 94 USPQ2d 1257 (Fed. Cir. 2010) (ML likely to be perceived as a shortened version of ML MARK LEES when used on the same or closely related skin-care products); *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005) (VEUVE ROYALE for sparkling wine found likely to be confused with VEUVE CLICQUOT and VEUVE CLICQUOT PONSARDIN for champagne, noting that the presence of the "strong distinctive term [VEUVE] as the first word in both parties' marks renders the marks similar, especially in light of the largely laudatory (and hence non-source identifying) significance of the word ROYALE"); *In re Chatam Int'l Inc.*, 380 F.3d 1340, 1343, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) ("Viewed in their entireties with non-dominant features appropriately discounted, the marks [GASPAR'S ALE for beer and ale and JOSE GASPAR GOLD for tequila] become nearly identical"); *Hewlett-Packard Co. v. Packard Press Inc*., 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002) (even though applicant's mark PACKARD TECHNOLOGIES (with "TECHNOLOGIES" disclaimed) does not incorporate every feature of opposer's HEWLETT PACKARD marks, similar overall commercial impression is created); *In re Max Capital Group Ltd.,* 93 USPQ2d 1243 (TTAB 2010) (MAX (and pillar design) held likely to be confused with MAX in typed form and MAX (and dot design) for legally identical insurance services); *In re Toshiba Medical Systems Corp.,* 91 USPQ2d 1266 (TTAB 2009) (VANTAGE TITAN for MRI diagnostic equipment held likely to be confused with TITAN for medical ultrasound device, noting that the marks are more similar than they are different and that the addition of applicant's "product mark" to the registered mark would not avoid confusion); *In re SL&E Training Stable, Inc.,* 88 USPQ2d 1216 (TTAB 2008) (Board found likelihood of confusion between SAM EDELMAN and EDELMAN both for wallets and various types of bags noting that the marks are similar because they share the same surname, and it is the practice in the fashion industry to refer to surnames alone); *In re Chica*, 84 USPQ2d 1845 (TTAB 2007) (Board found likelihood of confusion between CORAZON and design and CORAZON BY CHICA and design, both for jewelry); *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988) (MACHO COMBOS (with "COMBOS" disclaimed) held likely to be confused with MACHO (stylized), both for food items as a part of restaurant services); *In re Computer Systems Center Inc.*, 5 USPQ2d 1378 (TTAB 1987) (CSC ADVANCED BUSINESS SYSTEMS for retail computer stores held likely to be confused with CSC for computer time sharing and computer programming services); *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986) (RESPONSE held likely to be confused with RESPONSE CARD (with "CARD" disclaimed), both for banking services); *In re Apparel Ventures, Inc.*, 229 USPQ 225 (TTAB 1986) (SPARKS BY SASSAFRAS (stylized) for clothing held likely to be confused with SPARKS (stylized) for footwear); *In re The U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE (stylized) for clothing held likely to be confused with CREST CAREER IMAGES (stylized) for uniforms); *In re Corning Glass Works,* 229 USPQ 65 (TTAB 1985) (CONFIRM for a buffered solution equilibrated to yield predetermined dissolved gas values in a blood-gas analyzer held likely to be confused with CONFIRMCELLS for diagnostic blood reagents for laboratory use); *In re Energy Images, Inc.*, 227 USPQ 572 (TTAB 1985) (SMART-SCAN (stylized) for optical line recognition and digitizing processors held likely to be confused with SMART for remote-data gathering and control systems); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (RICHARD PETTY'S ACCU TUNE and design for automotive service stations held likely to be confused with ACCUTUNE for automotive testing equipment); *In re Denisi*, 225 USPQ 624 (TTAB 1985) (PERRY'S PIZZA held likely to be confused with PERRY'S, both for

restaurant services); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and design (with "CALIFORNIA" disclaimed) held likely to be confused with COLLEGIENNE, both for items of clothing); *In re Pierre Fabre S.A.*, 188 USPQ 691 (TTAB 1975) (PEDI-RELAX for foot cream held likely to be confused with RELAX for antiperspirant).

Exceptions to the above-stated general rule regarding additions or deletions to marks may arise if: (1) the marks in their entireties convey significantly different commercial impressions; or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted. *See, e.g., Shen Mfg. Co. v. Ritz Hotel Ltd.,* 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (RITZ and THE RITZ KIDS create different commercial impressions); *Citigroup Inc. v. Capital City Bank Group, Inc.,* 94 USPQ2d 1645 (TTAB 2010) (CAPITAL CITY BANK held not likely to be confused with CITIBANK, the Board finding that frequent third-party use of the wording "City Bank" suggests that the word "Bank" is used as a generic designation for banking services and the word "City" is used as part of a geographic name); (*Safer, Inc. v. OMS Inv., Inc.,* 94 USPQ2d 1031 (TTAB 2010) (DEER-B-GON for animal repellant held not likely to be confused with DEER AWAY and DEER AWAY PROFESSIONAL for deer repellant); *Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844 (TTAB 2008) (Board found no likelihood of confusion between the word and design marks BASS PRO SHOPS SPORTMAN'S WAREHOUSE (with SPORTSMAN'S WAREHOUSE disclaimed) and SPORTSMAN'S WAREHOUSE (with all wording disclaimed) for essentially the same retail store services); *In re Farm Fresh Catfish Co.*, 231 USPQ 495 (TTAB 1986) (CATFISH BOBBERS (with "CATFISH" disclaimed) for fish held not likely to be confused with BOBBER for restaurant services); *In re Shawnee Milling Co.*, 225 USPQ 747 (TTAB 1985) (GOLDEN CRUST for flour held not likely to be confused with ADOLPH'S GOLD'N CRUST and design (with "GOLD'N CRUST" disclaimed) for coating and seasoning for food items); *In re S.D. Fabrics, Inc.*, 223 USPQ 54 (TTAB 1984) (DESIGNERS/FABRIC (stylized) for retail fabric store services held not likely to be confused with DAN RIVER DESIGNER FABRICS and design for textile fabrics).

1207.01(b)(iv) Similarity in Sound – Phonetic Equivalents

Similarity in sound is one factor in determining whether there is a likelihood of confusion between marks. There is no "correct" pronunciation of a trademark because it is impossible to predict how the public will pronounce a particular mark. Therefore, "correct" pronunciation cannot be relied on to avoid a likelihood of confusion. *See, e.g., Centraz Industries Inc. v. Spartan Chemical Co. Inc.,* 77 USPQ2d 1698, 1701 (TTAB 2006) (acknowledging that "there is no correct pronunciation of a trademark" and finding ISHINE (stylized) likely to be confused with ICE SHINE, both for floor-finishing preparations); *Kabushiki Kaisha Hattori Tokeiten v. Scuotto*, 228 USPQ 461 (TTAB 1985) (SEYCOS and design for watches held likely to be confused with SEIKO for watches and clocks); *In re Great Lakes Canning, Inc.*, 227 USPQ 483 (TTAB 1985) (CAYNA (stylized) for soft drinks held likely to be confused with CANA for, *inter alia*, canned and frozen fruit and vegetable juices); *In re Energy Telecommunications & Electrical Ass'n*, 222 USPQ 350 (TTAB 1983) (ENTELEC and design for association services in the telecommunication and energy industries held likely to be confused with INTELECT for conducting expositions for the electrical industry); *In re Cresco Mfg. Co.*, 138 USPQ 401 (TTAB 1963) (CRESCO and design for leather jackets held likely to be confused with KRESSCO for hosiery).

1207.01(b)(v) Similarity in Meaning

Similarity in meaning or connotation is another factor in determining whether there is a likelihood of confusion between marks. The focus is on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *See, e.g., In re M. Serman & Co., Inc.,* 223 USPQ 52 (TTAB 1984) (CITY WOMAN held likely to be confused with CITY GIRL, both for clothing); *Gastown Inc., of Delaware v. Gas City, Ltd.*, 187 USPQ 760 (TTAB 1975) (GAS CITY ("GAS" disclaimed) held likely to be confused with GASTOWN, both for gasoline); *Watercare Corp. v. Midwesco-Enterprise, Inc.*, 171 USPQ 696 (TTAB 1971) (AQUA-CARE (stylized) held likely to be confused with WATERCARE (stylized), both for water-conditioning products).

The meaning or connotation of a mark must be determined in relation to the named goods or services. Even marks that are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective parties' goods or services so that there is no likelihood of confusion. *See, e.g., In re Sears, Roebuck and Co.*, 2 USPQ2d 1312 (TTAB 1987) (CROSS-OVER for bras held not likely to be confused with CROSSOVER for ladies' sportswear, the Board finding that the term was suggestive of the construction of applicant's bras, but was likely to be perceived by purchasers either as an entirely arbitrary designation or as being suggestive of sportswear that "crosses over" the line between informal and more formal wear when applied to ladies' sportswear); *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984) (PLAYERS for men's underwear held not likely to be confused with PLAYERS for shoes, the Board finding that the term PLAYERS implies a fit, style, color, and durability adapted to outdoor activities when applied to shoes, but "implies something else, primarily indoors in nature" when applied to men's underwear); *In re Sydel Lingerie Co., Inc.*, 197 USPQ 629 (TTAB 1977) (BOTTOMS UP for ladies' and children's underwear held not likely to be confused with BOTTOMS UP for men's clothing, the Board finding that the term connotes the drinking phrase "Drink Up" when applied to men's suits, coats, and trousers, but does not have this connotation when applied to ladies' and children's underwear).

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1207.01(b)(vi) Doctrine of Foreign Equivalents

Under the doctrine of foreign equivalents, a foreign word (from a language familiar to an appreciable segment of American consumers) and the English equivalent may be held to be confusingly similar. *See, e.g., Continental Nut Co. v. Cordon Bleu, Ltee*, 494 F.2d 1397, 181 USPQ 647 (C.C.P.A. 1974); *In re Thomas,* 79 USPQ2d 1021 (TTAB 2006) (MARCHE NOIR for jewelry held likely to be confused with BLACK MARKET MINERALS for retail jewelry store services); *In re American Safety Razor Co.*, 2 USPQ2d 1459 (TTAB 1987) (BUENOS DIAS for soap held likely to be confused with GOOD MORNING and design for latherless shaving cream); *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983) (EL SOL for clothing and footwear held likely to be confused with SUN and design for footwear).

Whether an examining attorney should apply the doctrine of foreign equivalents turns upon the significance of the foreign mark to the relevant purchasers, which is based on an analysis of the evidence of record, including, for example, dictionary, Internet, and LexisNexis® evidence. If the evidence shows that the relevant English translation is literal and direct, and no contradictory evidence of shades of meaning or other relevant meanings exists, the doctrine generally should be applied by the examining attorney. *See, e.g., In re Ithaca Indus., Inc.*, 230 USPQ 702 (TTAB 1986) (holding the Italian language mark LUPO for men's and boys' underwear, which translates to mean "wolf," likely to be confused with WOLF and design for various clothing items, because LUPO had a literal and direct English translation such that the doctrine was applied).

If an examining attorney determines that the doctrine is applicable, the examining attorney must also apply the relevant *du Pont* factors to assess whether there is a likelihood of confusion between the marks. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); *In re L'Oreal S.A.*, 222 USPQ 925, 926 (TTAB 1984) (noting that "similarity in connotation [of the marks] must be viewed as but a single factor in the overall evaluation of likelihood of confusion").

1207.01(b)(vi)(A) Background

With respect to likelihood of confusion, "[i]t is well established that foreign words or terms are not entitled to be registered if the English language equivalent has been previously used on or registered for products which might reasonably be assumed to come from the same source." *Mary Kay Cosmetics, Inc. v. Dorian Fragrances, Ltd.*, 180 USPQ 406, 407 (TTAB 1973).

Although words from modern languages are generally translated into English, the doctrine of foreign equivalents has evolved into a guideline, not an absolute rule, and is applied only when the "ordinary American purchaser" would "stop and translate" the foreign wording in a mark. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772,* 396 F.3d 1369, 1377, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005) (reversing finding of likelihood of confusion between VEUVE ROYALE – the French equivalent of "Royal Widow" – and THE WIDOW, both for sparkling wine, deeming it improbable that American purchasers would be aware that "Veuve" means "widow"). The "ordinary American purchaser" includes "all American purchasers, including those proficient in a non-English language who would ordinarily be expected to translate words into English." *In re Spirits Int'l, N.V.*, 563 F.3d 1347, 1352, 90 USPQ2d 1489, 1492 (Fed. Cir. 2009).

With respect to likelihood of confusion, the doctrine has been applied generally in the situation where the wording in one mark is entirely in English and the wording in the other mark or marks is entirely in a foreign language. *See, e.g., In re Perez*, 21 USPQ2d 1075 (TTAB 1991); *In re Am. Safety Razor Co.*, 2 USPQ2d 1459 (TTAB 1987); *In re Hub Distrib., Inc.*, 218 USPQ 284 (TTAB 1983). This is the most common scenario in the case law.

The Board, however, has applied the doctrine where the wording in both marks being compared is in the same foreign language. *See In re Lar Mor Int'l, Inc.*, 221 USPQ 180, 181-83 (TTAB 1983) (stating that "[i]t seems to us that the fact that both marks may be comprised of foreign words should not mean that we can disregard their meanings. Indeed, we believe that many members of the American public, even those who have only a rudimentary acquaintance with the French language, are likely to understand the significance of the respective terms;" the Board applied the doctrine to the French marks BIEN JOLIE, which means "quite pretty," and TRES JOLIE, which means "very pretty," even though it did not find a likelihood of confusion between the marks because of the marks' highly suggestive nature). In the *Lar Mor* case, the marks in question consisted of common French terms and, thus, it was perhaps more likely that the ordinary American purchaser would stop and translate such terms. *But see Palm Bay*, 396 F.3d at 1369, 1377, 73 USPQ2d at 1689, 1696 (finding the doctrine inapplicable to applicant's French mark VEUVE ROYALE and opposer's French marks VEUVE CLICQUOT PONSARDIN and VEUVE CLICQUOT, but upholding the Board's likelihood of confusion determination for such marks for other reasons); *Brown Shoe Co., Inc. v. Robbins*, 90 USPQ2d 1752 (TTAB 2009) (Board did not think circumstances in case warranted application of the doctrine, but found a likelihood of confusion between applicant's Spanish mark PALOMITA and opposer's Spanish mark PALOMA).

The Board has also applied the doctrine where the wording in one of the marks is in a foreign language and the wording in the other mark or marks is in a different foreign language. *See Miguel Torres S.A. v. Casa Vinicola Gerardo Cesari S.R.L.*, 49 USPQ2d 2018 (TTAB 1998) (applying the doctrine and finding a likelihood of confusion between the Italian language mark DUE

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TORRI for wines, which means “two towers,” and the Spanish language marks TORRES for wines and brandy and TRES TORRES for brandy, which mean “towers” and “three towers,” respectively). However, comparing marks in different foreign languages appears to be a rare occurrence. It seems less likely that the ordinary American purchaser would be fluent in two or more foreign languages. *See Safeway Stores Inc. v. Bel Canto Fancy Foods Ltd.*, 5 USPQ2d 1980, 1982 (TTAB 1987) (“[T]his Board does not think it proper to take the French expression ‘bel air’ and the Italian expression ‘bel aria’ and then convert both into English and compare the English translations....”). Thus, the doctrine may not be as relevant, and certainly not the sole determinative factor, in a situation such as the *Miguel Torres* case where the marks were found confusingly similar because they were similar in both sound and meaning.

However, the Board has yet to apply the doctrine in a published decision where the wording in one or more of the marks being compared consists of a combination of English and foreign-language words or terms. In such a case, the issue will likely remain whether the ordinary American purchaser would stop and translate these combined-language marks. The sufficiency of the translation evidence, the nature of the foreign and English combined-wording (i.e., whether the wording is arbitrary, suggestive, generic, etc.), and any other relevant facts and evidence should be considered in these cases.

1207.01(b)(vi)(B) When an Ordinary American Purchaser Would “Stop and Translate”

Issues regarding the doctrine of foreign equivalents arise early in examination, that is, at the time of conducting a search for confusingly similar marks. The search of foreign words in an applied-for mark must include a search of their English translation to ensure that all possible conflicting registrations and prior-filed applications have been identified in the event that the doctrine applies. *See* **TMEP §§809** *et seq*. for information regarding how to ascertain the meaning of non-English wording in a mark.

After conducting a complete search, an examining attorney must then assess whether a refusal under §2(d) may be warranted. If so, the examining attorney should research the English translation further using available resources, such as dictionaries, the Internet, and LexisNexis®, to ascertain whether there is sufficient evidence to support applying the doctrine.

As discussed below, if the evidence shows that the English translation is “literal and direct,” with no contradictory evidence of other relevant meanings or shades of meaning, then the doctrine should be applied, barring unusual circumstances. Further, if in its response to the application of the doctrine applicant argues that the foreign language is rare, obscure, or dead, then the examining attorney will need to provide evidence that the foreign language is a common, modern language.

English Translations – Literal and Direct

The English translation evidence is a critical factor for the courts and the Board when determining whether to apply the doctrine. If the translation evidence shows that the English translation is unambiguously literal and direct, with no other relevant connotations or variations in meaning, the doctrine has generally been applied, and, therefore, should be applied by the examining attorney. *See La Peregrina*, 86 USPQ2d 1645, 1648-1650 (holding the Spanish language mark LA PEREGRINA for jewelry, pearl jewelry, and precious stones, which translates to mean “the pilgrim,” likely to be confused with PILGRIM for jewelry where the two terms were equivalent in meaning and there was no dictionary evidence to the contrary); *In re Thomas,* 79 USPQ2d 1021 (TTAB 2006) (holding the French language mark MARCHE NOIR for jewelry, which is the exact French equivalent of the English idiom “Black Market,” likely to be confused with the cited mark BLACK MARKET MINERALS for retail jewelry and mineral store services because the addition of MINERALS did not serve to distinguish the marks); *In re Ithaca Indus., Inc.*, 230 USPQ 702 (TTAB 1986) (holding the Italian language mark LUPO for men’s and boys’ underwear, which translates to mean “wolf,” likely to be confused with WOLF and design for various clothing items); *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983) (holding the Spanish language mark EL SOL for clothing likely to be confused with its English language equivalent SUN for footwear where EL SOL was determined to be the “direct foreign language equivalent” of the term SUN); *see also Ex parte Odol-Werke Wien Gesellschaft M.B.H.*, 111 USPQ 286, 286 (Comm’r Pats. 1956) (holding the French language mark CHAT NOIR and its English language equivalent BLACK CAT confusingly similar because they have the same meaning).

When determining the appropriate English translation of the foreign wording in the mark, an examining attorney should view the translations in the context of any significant features in the mark such as design or wording elements, the identified goods and/or services in the application, the relevant marketplace, and the specimen. *See Perez*, 21 USPQ2d at 1075 (holding the Spanish language mark EL GALLO for fresh vegetables, which translates to mean “rooster,” likely to be confused with ROOSTER for fresh citrus fruit where the English translation was the first definition listed in the Spanish-English language dictionary, GALLO was the only listed Spanish translation for the English wording ROOSTER, and the design of a rooster on the specimen reinforced the translation of GALLO even though this word had other meanings).

Specifically, the Federal Circuit has stated that “[t]he test to be applied to a foreign word vis-à-vis an English word with respect to equivalency is not less stringent than that applicable to two English words.” *In re Sarkli*, *Ltd.*, 721 F.2d 353, 354, 220 USPQ 111, 113 (Fed. Cir. 1983).

In contrast, the doctrine has generally not been applied where the evidence shows that the English translation is not exact, literal, or direct. *See Sarkli*, 721 F.2d at 353, 220 USPQ at 111 (finding REPECHAGE for various skin-care products not to be the French equivalent of SECOND CHANCE for face creams and other toiletries because the translation dictionary evidence showed they were not direct foreign equivalents); *see also In re Buckner Enters. Corp.*, 6 USPQ2d 1316 (TTAB 1987) (finding the Spanish language mark PALOMA, which translates primarily into English to mean "pigeon, dove," has a different connotation from the cited registration DOVE, and, thus the doctrine was not applied). Thus, several translation dictionaries showing variations in the English meaning constitute evidence that the foreign word or term may not have a literal and direct translation, and the doctrine should not be applied.

Further, when comparing two different foreign-language marks, the same strict standard regarding equivalency in translation would also apply.

Common, Modern Foreign Languages

The doctrine applies to words or terms from common, modern languages, which encompasses all but dead, obscure, or unusual languages. An applicant may respond to the application of the doctrine by arguing that the foreign language is obscure, or not commonly spoken in the United States, and thus the doctrine is inapplicable. If this or a similar argument is set forth, or if the foreign language appears to be obscure or unusual, an examining attorney should provide evidence to show that the foreign language is a common, modern language. The type of evidence will vary depending on the particular facts of the case but, if available, the examining attorney should provide evidence of the percentage or number of United States consumers who speak the language in question. For example:

- Census evidence provided by applicant to show that only 0.6% of the population speak French "very well" or "well" was used by the Board against the applicant to show that, of the foreign languages with the greatest number of speakers in the United States, French was second only to Spanish. *Thomas*, 79 USPQ2d at 1024.
- Evidence showing that 706,000 Russian-speakers live in the United States was persuasive evidence to establish that a "significant portion of consumers" would understand the English meaning of the Russian mark for Russian vodka. *In re Joint Stock Co. "Baik,"* 80 USPQ2d 1305, 1310 (TTAB 2006).

Census evidence identifying the number of people who speak various foreign languages in the United States can be found at **http://www.census.gov/population/cen2000/phc-t20/tab05.pdf**.

If such evidence is unavailable or unpersuasive, the examining attorney may instead provide other evidence that the language in question is a common, modern language by establishing, for example, that the foreign country(ies) where the language is spoken is a prominent trading partner of the United States or that the foreign language is spoken by a sizeable world population. Such evidence should be obtained from the USPTO's Translations Branch, as well as the Internet, LexisNexis®, and any other relevant electronic or print resources. *See In re Savisa (Pty.) Ltd.*, Ser. No. 78154196, 2005 TTAB LEXIS 91, at *6-12 (Feb. 24, 2005) (finding Afrikaans to be a common, modern, and not-obscure language and applying the doctrine even though the applicant submitted evidence that only .096% of Americans spoke Afrikaans where the examining attorney submitted a report from the USPTO translator stating that Afrikaans is a well-established language recognized by all of the advanced and developed nations, it is a form of old Dutch and is a European language that is familiar in the United States, and it is one of the principal Germanic languages spoken by more than twenty million people; the Board took judicial notice of the following sources: *World Almanac and Book of Facts 2004* (W. McGeveren, editorial dir.) which states that six million people speak the language, with significant numbers in ten countries; *Facts About the World's Languages: An Encyclopedia of the World's Major Languages, Past and Present* (J. Garry & C. Rubino eds., 2001), which states that Afrikaans is the home language of 6.2 million people in South Africa (out of a total population of 44 million people); and the language was spoken as a second or third language by an indeterminate but very large number of Black South Africans (who speak Bantu languages), Asians, and English-speaking Whites).

Common, modern languages have been found to include Spanish, French, Italian, German, Chinese, Japanese, Russian, Polish, Hungarian, Serbian, and Yiddish. *See, e.g., Weiss Noodle Co. v. Golden Cracknel & Specialty Co.*, 290 F.2d 845, 129 USPQ 411 (C.C.P.A. 1961) (Hungarian); *La Peregrina*, 86 USPQ2d at 1648 (Spanish); *Joint-Stock Co. "Baik,"* 80 USPQ2d at 1305 (Russian); *Perez*, 21 USPQ2d at 1075 (Spanish); *In re Oriental Daily News, Ltd.*, 230 USPQ 637 (TTAB 1986) (Chinese); *Ithaca Indus.*, 230 USPQ at 702 (Italian); *In re Jos. Schlitz Brewing Co.*, 223 USPQ 45 (TTAB 1983) (German); *In re Westbrae Natural Foods, Inc.*, 211 USPQ 642 (TTAB 1981) (Japanese); *In re Optica Int'l*, 196 USPQ 775 (TTAB 1977) (French); *In re Bagel Nosh, Inc.*, 193 USPQ 316 (TTAB 1976) (Yiddish); *In re Hag Aktiengesellschaft*, 155 USPQ 598 (TTAB 1967) (Serbian); *In re New Yorker Cheese Co.*, 130 USPQ 120 (TTAB 1961) (Polish).

If evidence shows that the language at issue is highly obscure or a dead language, the doctrine will generally not be applied. *See Enrique Bernat F. S.A. v. Guadalajara Inc*., 210 F.3d 439, 54 USPQ2d 1497 (5th Cir. 2000), *reh'g denied* 218 F.3d 745 (2000). The determination of whether a language is "dead" must be made on a case-by-case basis, based upon the meaning

the word or term would have to the relevant purchasing public. For example, Latin is generally considered a dead language. However, if evidence shows that a Latin term is still in use by the relevant purchasing public (i.e., if the term appears in current dictionaries or news articles), then this Latin term would not be considered dead. The same analysis is applied to other words or terms from uncommon or obscure languages.

Other Considerations: Alternate Meaning of Mark and Marketplace Circumstances of the Commercial Setting in Which the Mark is Used

The Board, generally, will also review the evidence of record to determine the following:

(1) Whether the foreign wording has a meaning in the relevant marketplace that differs from the translated meaning in English; and

(2) Whether it is more or less likely that the foreign expression will be translated by purchasers because of the manner in which the term is encountered in the marketing environment as used in connection with the goods and/or services.

See Thomas, 79 USPQ2d at 1025-26; *see also Jos. Schlitz Brewing Co.*, 223 USPQ at 45; *Optica Int'l*, 196 USPQ at 777. In making such determinations, the Board has generally reviewed such evidence as dictionary definitions, declarations, and specimens.

Typically, the doctrine will not be applied where the foreign wording has developed an alternate meaning in the relevant marketplace that is different from the translated meaning in English, and the evidence shows that the alternate meaning would be understood by the relevant purchasing public. *See Cont'l Nut Co. v. Le Cordon Bleu S.A.R.L.*, 494 F.2d 1395, 1396-97, 181 USPQ 646, 647 (C.C.P.A. 1974) (finding that the French language mark CORDON BLEU, which translates to mean "blue ribbon," would not be translated by or have the same significance to an American purchaser because of the adoption of the wording CORDON BLEU into English, as evidenced by American dictionary entries indicating that such wording refers to a cook of great skill); *cf. La Peregrina*, 86 USPQ2d at 1649 (finding that if sufficient evidence had been provided to show that the Spanish-language mark LA PEREGRINA, which translates to mean "the pilgrim," for goods including pearls and pearl jewelry, was viewed by the relevant purchasing public as the "name of a very famous and unique pearl," such would be a situation "where purchasers would not translate the name").

The doctrine also typically will not be applied where the record indicates that it is unlikely purchasers would translate the mark because of "marketplace circumstances or the commercial setting in which the mark is used." *La Peregrina*, 86 USPQ2d at 1648; *Thomas*, 79 USPQ2d at 1026. For example, the doctrine may not be applied where it is unlikely that purchasers will translate the foreign expression because of the manner in which the foreign term is used on the specimen. *See In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976) (finding that the Spanish language mark LA POSADA for lodging and restaurant services, which translates to mean "the inn," would not likely be translated by American purchasers because of the manner of use of the mark on applicant's specimens, in which applicant used the mark in advertising brochures and on a sign mounted in front of its motor hotel with the words "motor hotel" appearing directly under the notation LA POSADA). Further, the doctrine may not be applied due to marketplace circumstances, which include differing channels of trade for the relevant goods and/or services. *See In re Tia Maria, Inc.*, 188 USPQ 524, 525-26 (TTAB 1975) (finding that the Spanish language mark TIA MARIA for restaurant services, which translates to mean "Aunt Mary," when compared with the registered mark AUNT MARY'S for canned fruits and vegetables, would not likely be translated by American purchasers because a person who had purchased Aunt Mary's canned fruits and vegetables from a supermarket would, upon dining at the TIA MARIA restaurant surrounded by its Mexican décor and serving Mexican food, not likely translate TIA MARIA into AUNT MARY).

1207.01(b)(vi)(C) Likelihood of Confusion Factors Still Apply When Assessing Whether Marks are Confusingly Similar

If the examining attorney has sufficient evidence to show that the foreign wording has a relevant, literal, and direct English translation such that the foreign wording has an English language equivalent, then the doctrine generally should be applied to the foreign wording in a mark or marks. However, applying the doctrine is only part of the process of determining whether the marks being compared are confusingly similar. Appearance, sound, meaning, and commercial impression are also factors to be considered when comparing marks. *See Palm Bay*, 396 F.3d at 1371, 73 USPQ2d at 1691 (citing *E.I. du Pont*, 476 F.2d at 1361, 177 USPQ at 567).

Similarity of the marks in one respect – sight, sound, or meaning – does not automatically result in a finding of likelihood of confusion even if the goods are identical or closely related. Rather, the rule is that, taking into account all of the relevant facts of a particular case, similarity as to one factor alone may be sufficient to support a holding that the marks are confusingly similar. *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); **TMEP §1207.01(b)(i).**

For example, if the English and foreign marks being compared are weak or highly suggestive, or have additional wording or matter that serves to distinguish the marks, then regardless of application of the doctrine and similarity in meaning, the marks may not be considered confusingly similar. *See In re Ness & Co.*, 18 USPQ2d 1815 (TTAB 1991) (finding no likelihood of

confusion between the French mark LABONTE, which means "the goodness," and the mark GOOD-NESS for the same goods because of the laudatory nature of the marks, the dissimilarity in sight and sound, the slight differences in meaning, and the connotation of the mark GOOD-NESS in relation to applicant's company name "Ness & Co."); *L'Oreal*, 222 USPQ at 925 (applying the doctrine to the French mark HAUTE MODE, which means "high fashion," but finding no likelihood of confusion between the mark and HI-FASHION SAMPLER because of the suggestive nature of the marks and because of the differences in the marks due to the addition of the term SAMPLER in the English-language mark).

If both marks being compared are in a foreign language, and application of the doctrine shows that these marks have the same or a very similar meaning, the following factors should also be assessed: (1) whether the English meaning of the marks is weak or highly suggestive with respect to the goods and/or services; and (2) whether the marks being compared are similar in sound and/or appearance in addition to having the same or similar meaning. If the marks are not weak or highly suggestive and are similar in meaning and sound, such marks have been found confusingly similar. *See Miguel Torres S.A.*, 49 USPQ2d at 2018 (applying the doctrine and holding the Italian language mark DUE TORRI for wines, which means "two towers," likely to be confused with the Spanish language mark TORRES for wines and brandy and TRES TORRES for brandy, which mean "tower" and "three towers," respectively, because the marks were similar in sound and connotation); *Lar Mor*, 221 USPQ at 180 (applying the doctrine to the French marks BIEN JOLIE, which means "quite pretty," and TRES JOLIE, which means "very pretty," but holding no likelihood of confusion between the marks, even though the goods were related clothing products, because of the highly laudatory or suggestive nature of the marks' English translations and because of the marks' differences in sound and appearance).

In addition, when comparing only foreign marks, even if it is determined that the doctrine does not apply, the marks may still be found confusingly similar for other reasons, such as similarity in sound and/or appearance. *See Palm Bay*, 396 F.3d 1369, 73 USPQ2d 1689 (finding the doctrine inapplicable to applicant's French mark VEUVE ROYALE and opposer's French marks VEUVE CLICQUOT PONSARDIN and VEUVE CLICQUOT, but upholding the Board's likelihood of confusion determination for such marks for other reasons).

See also **TMEP §§1209.03(g)**, **1210.05(b)**, **1210.10** and **1211.01(a)(vii)** regarding the doctrine of foreign equivalents.

1207.01(b)(vii) Transposition of Terms

Where the primary difference between marks is the transposition of the elements that compose the marks, and where this transposition does not change the overall commercial impression, there may be a likelihood of confusion. *See, e.g., In re Wine Society of America Inc.*, 12 USPQ2d 1139 (TTAB 1989) (THE WINE SOCIETY OF AMERICA and design, for "wine club membership services including the supplying of printed materials, sale of wines to members, conducting wine tasting sessions and recommending specific restaurants offering wines sold by applicant," held likely to be confused with AMERICAN WINE SOCIETY 1967 and design, for a newsletter, bulletin, and journal of interest to members of the registrant); *In re Nationwide Industries Inc.*, 6 USPQ2d 1882 (TTAB 1988) (RUST BUSTER (with "RUST" disclaimed) for rust-penetrating spray lubricant held likely to be confused with BUST RUST for penetrating oil); *In re General Tire & Rubber Co.*, 213 USPQ 870 (TTAB 1982) (SPRINT STEEL RADIAL (with "STEEL" and "RADIAL" disclaimed) for tires held likely to be confused with RADIAL SPRINT (with "RADIAL" disclaimed) for tires).

However, if the transposed mark creates a distinctly different commercial impression, then confusion is not likely. *See, e.g., In re Best Products Co., Inc.*, 231 USPQ 988 (TTAB 1986) (BEST JEWELRY and design (with "JEWELRY" disclaimed) for retail jewelry store services held not likely to be confused with JEWELERS' BEST for jewelry).

1207.01(b)(viii) Marks Consisting of Multiple Words

When assessing the likelihood of confusion between compound word marks, one must determine whether a portion of the word mark is dominant in terms of creating the commercial impression. Although there is no mechanical test to select a "dominant" element of a compound word mark, consumers would be more likely to perceive a fanciful or arbitrary term, rather than a descriptive or generic term, as the source-indicating feature of the mark. Accordingly, if two marks for related goods or services share the same dominant feature and the marks, when viewed in their entireties, create similar overall commercial impressions, then confusion is likely. *See In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987) (JM ORIGINALS (with "ORIGINALS" disclaimed) for various items of apparel held likely to be confused with JM COLLECTABLES for "knitwear – namely, sport shirts").

If the common element of two marks is "weak" in that it is generic, descriptive, or highly suggestive of the named goods or services, consumers typically will be able to avoid confusion unless the overall combinations have other commonality. *See, e.g., In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986) (BED & BREAKFAST REGISTRY for making lodging reservations for others in private homes held not likely to be confused with BED & BREAKFAST INTERNATIONAL for room booking agency services); *The U.S. Shoe Corp. v. Chapman*, 229 USPQ 74 (TTAB 1985) (COBBLER'S OUTLET for shoes held not likely to be confused with CALIFORNIA COBBLERS (stylized) for shoes); *In re*

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Istituto Sieroterapico E Vaccinogeno, Toscano "SCLAVO" S.p.A., 226 USPQ 1035 (TTAB 1985) (ASO QUANTUM (with "ASO" disclaimed) for diagnostic laboratory reagents held not likely to be confused with QUANTUM I for laboratory instrument for analyzing body fluids). *See also* **TMEP §1207.01(b)(ix).**

In a sense, the public can be said to rely more on the nondescriptive portions of each mark. On the other hand, this does not mean that the public looks only at the differences, or that the descriptive words play no role in creating confusion. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985) (THE CASH MANAGEMENT EXCHANGE (with "CASH MANAGEMENT" disclaimed) for computerized cash management services held likely to be confused with CASH MANAGEMENT ACCOUNT for various financial services).

1207.01(b)(ix) Weak or Descriptive Marks

The Trademark Trial and Appeal Board and the courts have recognized that merely descriptive and weak designations may be entitled to a narrower scope of protection than an entirely arbitrary or coined word. *Benjamin J. Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020 (TTAB 2009); *In re Box Solutions Corp.*, 79 USPQ2d 1953 (TTAB 2006); *In re Central Soya Co., Inc*., 220 USPQ 914 (TTAB 1984). However, even a weak mark is entitled to protection against the registration of a similar mark for closely related goods or services. *King Candy Co. v. Eunice King's Kitchen, Inc.,* 496 F.2d 1400, 182 USPQ 108 (C.C.P.A. 1974).

In *In re Hunke & Jochheim*, 185 USPQ 188, 189 (TTAB 1975), the Board stated:

> [R]egistration on the Supplemental Register may be considered to establish prima facie that, at least at the time of registration, the registered mark possessed a merely descriptive significance. (citation omitted.) This is significant because it is well established that the scope of protection afforded a merely descriptive or even a highly suggestive term is less than that accorded an arbitrary or coined mark. That is, terms falling within the former category have been generally categorized as "weak" marks, and the scope of protection extended to these marks has been limited to the substantially identical notation and/or to the subsequent use and registration thereof for substantially similar goods.

However, even marks that are registered on the Supplemental Register may be cited under §2(d). *In re Clorox Co.*, 578 F.2d 305, 198 USPQ 337 (C.C.P.A. 1978).

1207.01(b)(x) Parody Marks

Parody is not a defense to a likelihood of confusion refusal. There are confusing parodies and non-confusing parodies. *See* J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §31.153 (4th ed. 2006). A true parody actually decreases the likelihood of confusion because the effect of the parody is to create a distinction in the viewer's mind between the actual product and the joke. While a parody must call to mind the actual product to be successful, the same success also necessarily distinguishes the parody from the actual product. *Mutual of Omaha Insurance Co. v. Novak*, 648 F. Supp. 905, 231 USPQ 963 (D. Neb. 1986), *aff'd,* 836 F.2d 397, 5 USPQ2d 1314 (8th Cir. 1987), *cert. denied,* 488 U.S. 933 (1988).

Another example of parody can be found in *Columbia Pictures Industries Inc., v. Miller,* 211 USPQ 816 (TTAB 1981) (CLOTHES ENCOUNTERS held likely to be confused with CLOSE ENCOUNTERS OF THE THIRD KIND, for men's and women's clothing); *see also Starbucks U.S. Brands, LLC v. Ruben,* 78 USPQ2d 1741 (TTAB 2006) (LESSBUCKS COFFEE held not likely to be perceived as a parody of the mark STARBUCKS and, therefore, likely to be confused with STARBUCKS COFFEE for coffee and retail store services featuring coffee); c*f. Jordache Enterprises, Inc. v. Hogg Wyld, Inc.,* 828 F.2d 1482, 4 USPQ2d 1216 (10th Cir. 1987) (LARDASHE for pants was not an infringement of the JORDACHE mark).

1207.01(c) Design Marks

When the marks at issue are both design marks, the similarity of the marks must be decided primarily on the basis of visual similarity. In this situation, consideration must be given to the fact that a purchaser's recollection of design marks is often of a general and hazy nature. *See, e.g., Red Carpet Corp. v. Johnstown American Enterprises Inc.*, 7 USPQ2d 1404 (TTAB 1988) (stylized house design for "management of real estate properties for others" held not likely to be confused with stylized house design for real estate brokerage services); *In re United Service Distributors, Inc.,* 229 USPQ 237 (TTAB 1986) (silhouette of two profiles facing right within a teardrop background for "distributorship services in the field of health and beauty aids" held likely to be confused with silhouette of two profiles facing left within an oval background for skin cream); *Ocean Spray Cranberries, Inc. v. Ocean Garden Products, Inc.*, 223 USPQ 1027 (TTAB 1984) (abstract circular design mark for seafood held not likely to be confused with oval breaking wave design for various food items including juices and fruits); *In re Steury Corp.*, 189 USPQ 353 (TTAB 1975) (design comprised of three generally horizontal bars for boats and camper trailers held likely to be confused with design comprised of two generally horizontal bars for boats and campers); *Matsushita Electric Industrial Co., Ltd. v. Sanders Associates, Inc.*, 177 USPQ 720 (TTAB 1973) (triangular arrow design within a square border for various items of electrical and

electronic equipment held likely to be confused with triangular arrow design for various items of electrical and electronic components and equipment).

1207.01(c)(i) Legal Equivalents – Comparison of Words and Their Equivalent Designs

Under the doctrine of legal equivalents, a pictorial representation and its literal equivalent may be found to be confusingly similar. This doctrine is based on a recognition that a pictorial depiction and equivalent wording are likely to impress the same mental image on purchasers. *See, e.g., In re Rolf Nilsson AB*, 230 USPQ 141 (TTAB 1986) (design comprising the silhouette of the head of a lion and the letter "L" for shoes held likely to be confused with LION for shoes); *Puma-Sportschuhfabriken Rudolf Dassler KG v. Garan, Inc.*, 224 USPQ 1064 (TTAB 1984) (designs of mountain lion, for shirts and tops, held confusingly similar to PUMA, for items of clothing; the design of a puma, for items of sporting goods and clothing; and PUMA and design, for T-shirts); *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974) (design of eagle lined for the color gold, for various items of sports apparel, held likely to be confused with GOLDEN EAGLE and design of an eagle, for various items of clothing).

1207.01(c)(ii) Composite Marks Consisting of Both Words and Designs

Often, the examining attorney must determine whether a likelihood of confusion exists between composite marks that consist of a design element as well as words and/or letters. Frequently, the marks at issue are similar in only one element. Although it is not proper to dissect a mark, if one feature of a mark is more significant than another feature, greater weight may be given to the dominant feature for purposes of determining likelihood of confusion. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). However, the fundamental rule in this situation is that the marks must be considered in their entireties. *See Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272 (C.C.P.A. 1974).

If a mark comprises both a word and a design, greater weight is often given to the word, because it is the word that purchasers would use to refer to or request the goods or services. *In re Appetito Provisions Co. Inc.,* 3 USPQ2d 1553, 1554 (TTAB 1987) (APPETITO and design of two broad stripes lined for the colors red and green, for Italian sausage, held likely to be confused with A APPETITO'S and design and A APPETITO'S INC. and design of a sandwich (with "INC." and sandwich design disclaimed), both for restaurant services). The Court of Appeals for the Federal Circuit has cautioned, however, that "[t]here is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue." *In re Electrolyte Laboratories Inc.,* 929 F.2d 645, 647, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (K+ and design for dietary potassium supplement held not likely to be confused with K+EFF (stylized) for dietary potassium supplement).

The comparison of composite marks must be done on a case-by-case basis, without reliance on mechanical rules of construction. *See, e.g., Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984) (finding a likelihood of confusion between SPICE VALLEY and SPICE ISLANDS, both for tea); *Spice Islands, Inc. v. The Frank Tea & Spice Co.*, 505 F.2d 1293, 184 USPQ 35 (C.C.P.A. 1974) (SPICE TREE and tree design held not confusingly similar to SPICE ISLANDS and tree design, both for spices); *In re White Rock Distilleries Inc.,* 92 USPQ2d 1282 (TTAB 2009) (VOLTA for vodka infused with caffeine held not likely to be confused with TERZA VOLTA and design for wines); *In re Sun Supermarkets, Inc.*, 228 USPQ 693 (TTAB 1986) (SUN SUPERMARKETS and design of sun held likely to be confused with SUNSHINE and design of sun and SUNRISE and design of sun, all for retail grocery store services).

1207.01(c)(iii) Comparison of Standard Character Marks and Special Form Marks

If a mark (in either an application or a registration) is presented in standard characters, the owner of the mark is not limited to any particular depiction. The rights associated with a mark in standard characters reside in the wording (or other literal element, e.g., letters, numerals, punctuation) and not in any particular display. Therefore, an applicant cannot, by presenting its mark in special form, avoid likelihood of confusion with a mark that is registered in standard characters because the registered mark presumably could be used in the same manner of display. *See, e.g., In re RSI Systems, LLC*, 88 USPQ2d 1445 (TTAB 2008); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988); *Sunnen Products Co. v. Sunex Int'l Inc.*, 1 USPQ2d 1744, 1751 (TTAB 1987); *In re Hester Industries, Inc.*, 231 USPQ 881, 883, n.6 (TTAB 1986).

1207.01(c)(iv) Matter Depicted in Broken Lines

In some cases, where the position of the mark on the goods (or on a label or container for the goods) is a feature of the mark, the applicant will submit a drawing that shows the placement of the mark by surrounding the mark with a proportionately accurate broken-line representation of the particular goods, packaging, or advertising on which the mark appears. 37 C.F.R. §2.52(b)(4); **TMEP §807.08.**

The matter depicted in broken lines is not part of the mark and should not be considered in determining likelihood of confusion.

In re Homeland Vinyl Products, Inc., 81 USPQ2d 1378 (TTAB 2006).

1207.01(d) Miscellaneous Considerations

1207.01(d)(i) Doubt Resolved in Favor of Registrant

If there is any doubt as to whether there is a likelihood of confusion, that doubt must be resolved in favor of the prior registrant. *In re Shell Oil Co.,* 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Hyper Shoppes (Ohio), Inc.,* 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

1207.01(d)(ii) Absence of Actual Confusion

It is well settled that the relevant test is *likelihood of confusion*, not actual confusion. It is unnecessary to show actual confusion to establish likelihood of confusion. *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990), and cases cited therein.

1207.01(d)(iii) Third-Party Registrations and Evidence of Third-Party Use

Generally, the existence of third-party registrations cannot justify the registration of another mark that is so similar to a previously registered mark as to create a likelihood of confusion, or to cause mistake, or to deceive. Third-party registrations may be relevant to show that the mark or a portion of the mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services. *See, e.g., AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269-70 (C.C.P.A. 1973); *Plus Products v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983). Properly used in this limited manner, third-party registrations are similar to dictionaries showing how language is generally used. *See, e.g., Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 675, 223 USPQ 1281, 1285 (Fed. Cir. 1984); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917, 189 USPQ 693, 694-95 (C.C.P.A. 1976); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Dayco Products-Eaglemotive Inc.*, 9 USPQ2d 1910, 1911 (TTAB 1988); *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *United Foods Inc. v. J.R. Simplot Co.*, 4 USPQ2d 1172, 1174 (TTAB 1987).

Third-party registrations that cover a number of different goods or services have some probative value to the extent that they may serve to suggest that goods or services are of a type that may emanate from a single source, if the registrations are based on use in commerce. However, registrations issued under 15 U.S.C. §1126(e), based on a foreign registration, have very little, if any, persuasive value. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988), *aff'd,* 864 F.2d 149 (Fed. Cir. 1988).

A list of registrations or a copy of a search report is not proper evidence of third-party registrations. To make registrations of record, soft copies of the registrations or the electronic equivalent thereof (i.e., printouts or electronic copies of the registrations taken from the electronic search records of the USPTO) must be submitted. *Racciopp i v. Apogee Inc.,* 47 USPQ2d 1368 (TTAB 1998); *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 n.3 (TTAB 1994); *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992); *In re Hub Distributing, Inc*., 218 USPQ 284 (TTAB 1983). *See* **TMEP §710.03.**

Evidence of third-party use falls under the sixth *du Pont* factor – the "number and nature of similar marks in use on similar goods." *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, this evidence "is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1373, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005).

1207.01(d)(iv) Collateral Attack on Registration Improper in Ex Parte Proceeding

Section 7(b) of the Trademark Act, 15 U.S.C. §1057(b), provides that a certificate of registration on the Principal Register shall be prima facie evidence of the validity of the registration, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the mark in commerce in connection with the goods or services specified in the certificate. During ex parte prosecution, an applicant will not be heard on matters that constitute a collateral attack on the cited registration (e.g., a registrant's nonuse of the mark). *See In re Dixie Restaurants,* 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *Cosmetically Yours, Inc. v. Clairol Inc.*, 424 F.2d 1385, 1387, 165 USPQ 515, 517 (C.C.P.A. 1970); *In re Peebles Inc.* 23 USPQ2d 1795, 1797 n.5 (TTAB 1992); *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2014-15 (TTAB 1988).

It is also inappropriate for the applicant to place the burden of showing a likelihood of confusion on the owner of the cited registration. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1318, 65 USPQ2d 1201, 1206 (Fed. Cir. 2003) ("[I]t is the duty of the PTO and this court to determine whether there is a likelihood of confusion between two marks.... [I]t is no answer for the applicant to ask that the application be passed to publication to see whether the owner of the cited mark will oppose the

registration," quoting *Dixie Restaurants,* 105 F.3d at 1408, 41 USPQ2d at 1535.).

1207.01(d)(v) Classification of Goods/Services

The classification of goods and services has no bearing on the question of likelihood of confusion. Rather, it is the manner in which the applicant and/or registrant have identified their goods or services that is controlling. *Jean Patou Inc. v. Theon Inc*., 9 F.3d 971, 29 USPQ2d 1771 (Fed. Cir. 1993); *National Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212, 1216 n.5 (TTAB 1990).

1207.01(d)(vi) Prior Decisions of Examining Attorneys

Each case must be decided on its own merits. Previous decisions by examining attorneys in approving other marks are without evidentiary value and are not binding on the agency or the Board. *In re Sunmarks Inc.,* 32 USPQ2d 1470 (TTAB 1994); *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 641 (TTAB 1984).

1207.01(d)(vii) Sophisticated Purchasers

The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are immune from source confusion. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.,* 221 USPQ 558 (TTAB 1983). However, circumstances suggesting care in purchasing may tend to minimize likelihood of confusion.

1207.01(d)(viii) Consent Agreements

The term "consent agreement" generally refers to an agreement in which a party (e.g., a prior registrant) consents to the registration of a mark by another party (e.g., an applicant for registration of the same mark or a similar mark), or in which each party consents to the registration of the same mark or a similar mark by the other party.

A consent agreement may be submitted by the applicant to overcome a refusal of registration under §2(d) of the Act, or in anticipation of a refusal to register. When a consent agreement is submitted, the examining attorney will consider the agreement, and all other evidence in the record, to determine likelihood of confusion. The examining attorney may not solicit a consent agreement.

Consents come in different forms and under circumstances in infinite variety. They are, however, but one factor to be taken into account with all of the other relevant circumstances bearing on the likelihood of confusion referred to in §2(d). *In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969 (Fed. Cir. 1985).

A consent agreement must be signed by each party to the agreement, (e.g., the owner of the application and registration) or by someone with legal authority to bind each party (e.g., a corporate officer or general partner of a partnership).

In *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1363, 177 USPQ 563, 568 (C.C.P.A. 1973), the Court of Customs and Patent Appeals stated as follows:

> [W]hen those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted. It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won't. A mere *assumption* that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not.

A consent agreement that is not merely a "naked" consent typically details reasons why no likelihood of confusion exists and/or arrangements undertaken by the parties to avoid confusing the public. *In re Permagrain Products, Inc*., 223 USPQ 147 (TTAB 1984) (consent agreement found to be "naked" because the agreement did not restrict the markets in such a way as to avoid confusion).

The Court of Appeals for the Federal Circuit has made it clear that consent agreements should be given great weight, and that the USPTO should not substitute its judgment concerning likelihood of confusion for the judgment of the real parties in interest without good reason, that is, unless the other factors clearly dictate a finding of likelihood of confusion. *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank,* 842 F.2d 1270, 6 USPQ2d 1305 (Fed. Cir. 1988); *Bongrain Int'l (American) Corp. v. Delice de France Inc.*, 811 F.2d 1479, 1 USPQ2d 1775 (Fed. Cir. 1987); and *In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969 (Fed. Cir. 1985).

Compare In re Mastic Inc., 829 F.2d 1114, 4 USPQ2d 1292 (Fed. Cir. 1987) (refusal to register affirmed even with a consent to register, where applicant had not used the mark in commerce and the consent agreement contained contradictory statements).

The examining attorney should give great weight to a proper consent agreement. The examining attorney should not interpose

his or her own judgment concerning likelihood of confusion when an applicant and registrant have entered into a *credible* consent agreement and, *on balance*, the other factors do not dictate a finding of likelihood of confusion.

A consent agreement is not the same as a "concurrent use" agreement. The term "concurrent use" is a term of art that refers to a geographical restriction on the registration. *See* **TMEP §§1207.04** *et seq*. regarding concurrent use.

1207.01(d)(ix) Fame of Mark

The fame of a registered mark is a factor to be considered in determining likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Famous marks enjoy a wide latitude of legal protection because they are more likely to be remembered and associated in the public mind than a weaker mark. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1374, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005); *Bose Corp. v. QSC Audio Products Inc*., 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002) (Trademark Trial and Appeal Board erred in discounting the fame of opposer's marks ACOUSTIC WAVE and WAVE); *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1327, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000) (Board erred in limiting the weight accorded to the fame of opposer's FRITO-LAY mark); *Kenner Parker Toys Inc. v. Rose Art Industries, Inc*., 963 F.2d 350, 352-353, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992), *cert. denied,* 506 U.S. 862 (1992) (Board erred in discounting the fame of opposer's mark PLAY-DOH). The Court of Appeals for the Federal Circuit has stated:

> [A] mark with extensive public recognition and renown deserves and receives more legal protection than an obscure or weak mark.
>
> Achieving fame for a mark in a marketplace where countless symbols clamor for public attention often requires a very distinct mark, enormous advertising investments, and a product of lasting value. After earning fame, a mark benefits not only its owner, but the consumers who rely on the symbols to identify the source of a desired product. Both the mark's fame and the consumer's trust in that symbol, however, are subject to exploitation by free riders.

Kenner Parker Toys, 963 F.2d at 353, 22 USPQ2d at 1456.

When present, the fame of the mark is "a dominant factor in the likelihood of confusion analysis for a famous mark, independent of the consideration of the relatedness of the goods." *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1328, 54 USPQ2d 1894, 1898. *Starbucks U.S. Brands, LLC v. Ruben,* 78 USPQ2d 1741, 1750 (TTAB 2006) ("As the fame of a mark increases, the degree of similarity between the marks necessary to support a conclusion of likely confusion declines."). However, like the other *du Pont* factors, the fame of a mark may be considered only if there is relevant evidence of record. *See* **TMEP §1207.01** and cases cited therein.

In view of the wide latitude of legal protection afforded to a famous mark, and the dominant role fame plays in the likelihood of confusion analysis, a party who asserts that its mark is famous must clearly establish that its mark is viewed by relevant purchasers as a famous mark. *Blue Man Productions, Inc. v. Tarmann*, 75 USPQ2d 1811 (TTAB 2005) (Board rejected opposer's argument that its mark was famous, noting that there was no evidence regarding the nature and extent of opposer's promotion of its mark, no figures as to volume of sales or advertising expenditures, and no evidence showing recognition of the name by relevant purchasers as a famous mark; while the evidence showed that the opposer's mark had appeared in printed publications, on the Internet, and in recorded broadcasts and as a result had achieved a degree of recognition as a strong and distinctive mark for entertainment services, the evidence was insufficient to show that consumers had been so exposed to the mark that it would be considered a famous mark).

It is not necessary to show recognition by every segment of the population. When determining likelihood of confusion, fame is measured with regard to "the class of customers and potential customers of a product or service, and not the general public." *Palm Bay Imports*, 396 F.3d at 1375, 73 USPQ2d at 1695. Thus, the Federal Circuit affirmed the finding that VEUVE CLICQUOT had achieved fame among purchasers of champagne and sparkling wine, where the record showed that sales volume and advertising expenditures over a 15-year period were "substantial;" that VEUVE CLICQUOT was the second leading brand sold in the United States, sold in 8,000 restaurants nationwide, and in liquor stores, wine shops, and other establishments; that the product was advertised in general interest and wine specialty magazines, on the radio, on the Internet, and through point-of-sale displays, wine tastings, and sponsorship of events; and that the product had been featured in articles and reviews in both specialized and general interest magazines. *Id. See also ProQuest Information and Learning Co. v. Island*, 83 USPQ2d 1351 (TTAB 2007) (Board found that PROQUEST, though not famous to members of the general public at large, had achieved "niche market fame" within the academic, research, and education fields, i.e., had achieved such a level of fame that nearly everyone in those fields recognizes the mark.)

Direct evidence of consumer recognition of a mark is not necessary. The "fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident." *See Bose*, 293 F.3d at 1371, 63 USPQ2d at 1305, and cases cited therein. It is important to consider the context of how the proposed mark is presented in sales and advertising materials. In

Bose, the Court found that evidence of extensive sales and advertising expenses established the fame of opposer's WAVE and ACOUSTIC WAVE marks, noting that opposer's sales literature, advertisements, and promotional materials included frequent and prominent references to the marked product separate and apart from the house mark BOSE. In *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983), the court found that the mark GIANT FOOD was famous based on 45 years of use, sales in excess of $1 billion per year, extensive media exposure, and prominent display on the facade of supermarkets. However, in *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004), the court found that evidence of more than $5 million annual sales of products bearing the mark, over 100 years of use, and advertising expenditure of hundreds of thousands of dollars per year was insufficient to establish that RITZ had achieved the extensive public recognition of a famous mark.

In *Tiffany & Broadway v. Commissioner*, 167 F. Supp. 2d 949 (S.D. Tex. 2001), the fame of four registered marks cited against the applicant was a significant factor in finding a likelihood of confusion between applicant's TIFFANY for ladies' dress shoes and registrant's TIFFANY and TIFFANY & CO. for a variety of goods, including jewelry, china, silverware, glassware, leather goods, belt buckles, ties, scarves, clocks, watches, brushes, and lamps, and for retail store services specializing in the sale of jewelry, watches, clocks, and gift items. The record included excerpts from 18 news articles where the registrant Tiffany & Company was identified as a famous business; citations to three published decisions in which the fame of the TIFFANY mark had been judicially recognized; and evidence that the registrant's goods were sold at over 60 Tiffany locations worldwide – including 34 in the United States – and through independently owned retail stores and mail-order outlets.

Fame for likelihood of confusion purposes and fame for dilution purposes, 15 U.S.C. §1125(c), are distinct concepts. Fame for dilution purposes is an either/or proposition, whereas the "fame" factor in the likelihood of confusion analysis varies along a spectrum from very strong to very weak. *Palm Bay Imports*, 396 F.3d at 1374-75, 73 USPQ2d at 1694.

In an ex parte proceeding, the Board normally does not expect the examining attorney to submit evidence as to the fame of the cited mark. Therefore, in an analysis of the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) for determining likelihood of confusion (*see* **TMEP §1207.01)**, the "fame of the mark" factor is normally treated as neutral. *In re Thomas,* 79 USPQ2d 1021, 1027 n.11 (TTAB 2006).

1207.01(d)(x) Conflicting Marks Owned by Different Parties

During the examination of an application, the examining attorney should consider separately each registration found in a search of the marks registered in the USPTO that may bar registration of the applicant's mark under §2(d). If the examining attorney finds registrations that appear to be owned by more than one registrant, he or she should consider the extent to which dilution may indicate that there is no likelihood of confusion. However, the examining attorney must cite all the marks that are considered to be a bar to registration of the mark presented in the application, even if they are owned by different parties. The examining attorney should always explain the reason that the mark in each cited registration is grounds for refusal under §2(d).

1207.01(d)(xi) Family of Marks

A family of marks is defined as a group of marks sharing a common element. The common element may be a term, a phrase, or a component in the nature of a prefix or suffix. The family of marks doctrine may be invoked by a plaintiff in inter partes proceedings relating to likelihood of confusion, but is not available to a defendant as a defense against an opposer's or applicant's intervening rights. *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048 (TTAB 1992). Moreover, a family of marks argument is not available to an applicant seeking to overcome a likelihood of confusion refusal in an ex parte appeal. In an ex parte case, the focus of the likelihood of confusion analysis must be on the mark applicant seeks to register, not other marks applicant may have used or registered. *In re Cynosure, Inc.,* 90 USPQ2d 1644 (TTAB 2009); *In re Lar Mor Int'l, Inc.*, 221 USPQ 180 (TTAB 1983); *In re Ald, Inc*., 148 USPQ 520 (TTAB 1965).

It has also been noted that, in ex parte proceedings, examining attorneys do not have access to the evidence and information needed to establish whether a family of marks exists. *In re Mobay Chemical Co.*, 166 USPQ 218 (TTAB 1970). Therefore, examining attorneys should refrain from invoking the family of marks doctrine or from referring to a family of marks in a likelihood of confusion analysis. *Id*.

The Federal Circuit states that "[a] family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner." *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1462 (Fed. Cir. 1991) (the Federal Circuit affirmed Board's refusal to register MCPRETZEL and MCDUGAL MCPRETZEL because of likelihood of confusion with the MC and MAC family of marks which include the marks EGG MCMUFFIN, CHICKEN MCNUGGETS, and MCPIZZA); *Black and Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1490 (TTAB 2007) (Board sustained opposition to register DIRT HAWG and WATER HAWG because these marks are likely to cause consumer confusion with opposer's family of HOG marks, such as HEDGE HOG, EDGE HOG, GRASS HOG, LAWN HOG, LEAF HOG, and LOG HOG).

Merely using or registering a series of marks containing a common characteristic is insufficient to establish a family of marks. "There must be recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods." *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1462 (Fed. Cir. 1991). *See also Eveready Battery Co., Inc. v. Green Planet, Inc.*, 91 USPQ2d 1511 (TTAB 2009) (Board ruled that owning and using a number of marks sharing a common feature is insufficient to demonstrate that there is a family of marks in absence of evidence that the owner advertises or promotes the various marks in a way that creates a common exposure and common recognition that the marks come from the same owner). That is, consumers must see that marks with a shared element originate from the same source. Consumers must also recognize that the common characteristic in a family of marks is itself a trademark and distinct on its own. *White Heather Distiller, Ltd. V. American Distilling Co.*, 200 USPQ 466, 470 (TTAB 1978). Public perception and recognition of the family is crucial for establishing a family of marks. When comparing marks, the focus is not on whether an applicant's mark is the same as, or similar to, an opposer's individual marks; rather, the focus is on whether an applicant's mark may be viewed as a member of an opposer's family of marks. *Black and Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1491 (TTAB 2007).

The determination of whether a family of marks exists is a question of fact, taking into consideration the distinctiveness of the common characteristic shared by the family of marks, and the competency of the evidence establishing the nature of the use, advertising, and promotion of the family of marks as well as joint advertising and promotion of the family of marks as a unit to create an association of common origin of all marks. *AM General Corp. v. DaimlerChrysler Corp.*, 65 USPQ2d 1001, 1013 (7th Cir. 2002). As in any determination of a likelihood of confusion, the more distinctive or arbitrary the common characteristic is, the more weight it will be given in determining likelihood of confusion. *See* **TMEP §1207.01(b)(ix).** Alternatively, the more descriptive or generic the common characteristic is, the less weight it will be accorded in determining likelihood of confusion. *American Standard, Inc. v. Scott & Fetzer Co.*, 200 USPQ 457 (TTAB 1978) (no AQUA family of marks for faucets); *Champion Int'l Corp. v. Plexowood, Inc.*, 191 USPQ 160 (TTAB 1976) (no FLEX family of marks for flexible sheet material); *Cambridge Filter Corp. v. Servodyne Corp.*, 189 USPQ 99 (TTAB 1975) (no CAP or FLO family of marks for air filters); *Ft. Howard Paper Co. v. Nice-Pak Products, Inc.*, 127 USPQ 431, 433 (TTAB 1960) (no NAP family of marks for napkins since NAP is derived from "napkin").

1207.02 Marks That Are Likely to Deceive

In addition to referring to a mark that so resembles another mark as to be likely to cause confusion or mistake, §2(d) refers to a mark being likely "to deceive." As a practical matter, this provision is rarely applied in examination, because deceptiveness involves intent and would be difficult to prove in an ex parte proceeding.

1207.03 Marks Previously Used in United States but Not Registered

As a basis for refusal, §2(d) refers not only to registered marks but also to "a mark or trade name previously used in the United States by another and not abandoned." Refusal on the basis of an unregistered mark or trade name has, sometimes, been referred to as refusal on the basis of a "known mark." This provision is not applied in ex parte examination because of the practical difficulties with which an examining attorney is faced in locating "previously used" marks, and determining whether anyone has rights in them and whether they are "not abandoned."

1207.04 Concurrent Use Registration

1207.04(a) Concurrent Use – In General

Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), contains a proviso under which an eligible applicant may request issuance of a registration concurrent with the registration of a conflicting mark.

In a concurrent use application, the applicant normally requests a geographically restricted registration. The applicant seeks registration for a specified geographical area of the United States and lists one or more parties who concededly have rights in the mark in other geographical areas of the United States. These other parties may own applications or registrations, or they may have common law rights in a mark, but no application or registration. "Incontestable" registrations (i.e., where the registrant's right to use the mark has become incontestable pursuant to 15 U.S.C. §1065) are subject to concurrent use registration proceedings. *See Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630 (C.C.P.A. 1976); *Thriftimart, Inc. v. Scot Lad Foods, Inc.*, 207 USPQ 330 (TTAB 1980).

Registrations and applications to register on the Supplemental Register and registrations under the Act of 1920 (*see* **TMEP §1601.05)** are not subject to concurrent use registration proceedings. 37 C.F.R. §2.99(g).

Concurrent use registration is requested by the applicant; it should not be suggested or initiated by the examining attorney.

1207.04(b) Filing Basis of Application Seeking Concurrent Use

In an application based on use in commerce under 15 U.S.C. §1051(a), the applicant may seek concurrent use registration at the time the application is filed or in a subsequent amendment. *See* 37 C.F.R. §2.73.

In an application based on a bona fide intent to use the mark in commerce under 15 U.S.C. §1051(b), the applicant may not amend to seek concurrent use registration until the applicant files an acceptable allegation of use. 37 C.F.R. §§2.73 and 2.99(g).

Applications based solely on §44 or §66(a) of the Trademark Act are not subject to concurrent use registration proceedings. 37 C.F.R. §2.99(g). *See* notice at **73 FR 67759** (Nov. 17, 2008).

1207.04(c) Basis for Concurrent Use Registration

If an applicant requests a concurrent use registration, the examining attorney must first determine the basis for seeking such a registration. An application for registration as a concurrent user is either: (1) subject to a concurrent use registration proceeding before the Trademark Trial and Appeal Board; or (2) pursuant to the final determination by a court of competent jurisdiction of the concurrent rights of the parties to use the same or similar marks in commerce. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.99.

1207.04(d) Determining Eligibility for Concurrent Use

An applicant is eligible to request a registration subject to concurrent use if it meets one or more of the following criteria:

(1) The concurrent use request is sought pursuant to a decree of a court of competent jurisdiction reflecting its final determination of the rights of the concurrent user;

(2) The owner of the registration consents to the grant of a concurrent use registration to the applicant; or

(3) The applicant's date of first use in commerce is before the *filing date* of the pending applications or of any registrations issued under the Trademark Act of 1946. When a party specified as an excepted user does not own an application or registration, the applicant's date of first use in commerce is before the filing date of any application to register the mark that may be filed by the excepted user.

15 U.S.C. §1052(d). The applicant has the burden of proving that it is entitled to a concurrent use registration. 37 C.F.R. §2.99(e).

1207.04(d)(i) Requirements for All Concurrent Use Applications

An application for registration as a lawful concurrent user is generally examined in the same manner as any other application for registration. 37 C.F.R. §2.99(a). The examining attorney must examine the application to determine whether it complies with the relevant requirements for a non-restricted application. Additionally, the applicant must comply with the following requirements in a concurrent use application:

(1) The applicant must specify the goods and the geographic area for which the applicant seeks registration of the mark. 15 U.S.C. §1051(a)(3)(D); 37 C.F.R. §2.42. The applicant must also set forth the mode of use. 15 U.S.C. §1052(d); 37 C.F.R. §2.42.

(2) The applicant must specify, to the extent of its knowledge, the exceptions to its claim of exclusive use, listing any concurrent use by others and the relevant goods, geographic areas, and periods of this use. 15 U.S.C. §1051(a)(3)(D); 37 C.F.R. §2.42.

(3) The applicant must also list the names and addresses of the concurrent users, the registrations issued to or applications filed by them (if any), and the mode of such use. 37 C.F.R. §2.42.

(4) The verification for concurrent use should be modified to indicate an exception, that no one else *except as specified in the application* has the right to use the mark. 15 U.S.C. §1051(a)(3)(D). *See* **TMEP §804.02.**

The applicant does not have to insert the stated exceptions in the verification or declaration; the exceptions may be set forth anywhere in the application.

In addition to the requirements noted above, which apply to all applications for concurrent use registration, concurrent use applications must meet other conditions, depending on whether the application is subject to a concurrent use proceeding before the Board (*see* **TMEP §§1207.04(e)** *et seq*.) or pursuant to the decree of a court (*see* **TMEP §§1207.04(f)** *et seq*.).

1207.04(e) Applications Subject to Concurrent Use Proceeding Before the Trademark Trial and Appeal Board

If an application for concurrent use registration complies with the requirements listed above and it appears that the applicant is

entitled to registration but for the question of concurrent rights, the examining attorney will approve the application for publication subject to a concurrent use registration proceeding. 15 U.S.C. §1062(a).

Ordinarily, the examining attorney should not require an applicant for concurrent use registration to submit evidence in support of its claim to concurrent rights. However, the examining attorney should refuse registration under §2(d) if the applicant has requested a concurrent use registration and information in the record suggests that the applicant has not met the basic requirements for concurrent use registration (e.g., if the application indicates that the applicant adopted and used the mark with knowledge of the rights of a person specified as an excepted user, or that actual confusion has resulted from the concurrent use of the marks of the parties in their respective geographic areas). *See In re Place for Vision, Inc.*, 196 USPQ 267, 269-70 (TTAB 1977). *Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306 (Fed. Cir. 1987), *aff'g* 229 USPQ 474 (TTAB 1986).

1207.04(e)(i) Preparing the Record for Publication

When the examining attorney determines that the mark in an application that is subject to a concurrent use proceeding is ready for publication, the examining attorney should prepare the record as follows:

(1) The application must contain a concurrent use statement that will be printed in the *Official Gazette*. The statement may be submitted by the applicant or prepared by the examining attorney. The statement must be in the following form:

Subject to Concurrent Use Proceeding with _____ [specifying the application serial number(s) or registration number(s), if any, of each other party; otherwise, the name and address of each other party].

Applicant claims the exclusive right to use the mark in the area comprising _____ [specifying the area for which the applicant seeks registration].

(2) To aid in the preparation of the record by the Legal Instruments Examiner ("LIE"), the examining attorney should prepare a brief summary of the relevant concurrent use information. The information on the summary page should be set forth in the following manner:

CONCURRENT USE SUMMARY

Applicant:

Address:

Mark:

Goods or services:

Other Reg. or Serial Nos.:

Dates of use:

Areas of use:

EXCEPTIONS TO EXCLUSIVE USE

Name:

Address:

Mark:

Goods or Services:

Reg. or Serial No.:

Dates of Use:

Area of use:

After publication, if no opposition is filed, or if any opposition that is filed is dismissed or withdrawn, the Trademark Trial and Appeal Board will institute the concurrent use proceeding. The Board will consider and determine concurrent use rights only in the context of a concurrent use registration proceeding. 37 C.F.R. §2.99(h). *See* 37 C.F.R. §2.99; **TMEP §1506.**

See, generally, ***Trademark Trial and Appeal Board Manual of Procedure*** ("TBMP") Chapter 1100.

1207.04(f) Application for Concurrent Use Registration Pursuant to Court Decree

Under the last two sentences of §2(d), the USPTO may issue a concurrent use registration pursuant to the final determination of a court of competent jurisdiction that more than one person is entitled to use the same or similar marks in commerce. An applicant who seeks a concurrent use registration on the basis of a court determination does not have to claim use in commerce prior to the specified dates or obtain the consent of the owner of the involved mark, and the registration may be issued notwithstanding the possibility of public confusion. *See Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630 (C.C.P.A. 1976). *Cf. Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc.*, 293 F.2d 685, 130 USPQ 412 (C.C.P.A. 1961), *cert. denied*, 369 U.S. 864, 133 USPQ 702 (1962).

When examining an application for concurrent use registration pursuant to the decree of a court, the examining attorney must determine whether the application complies with the specific requirements for concurrent use applications (*see* **TMEP §§1207.04(d)** and **(d)(i))** and the requirements that would apply to an unrestricted application.

In addition, under 37 C.F.R. §2.99(f), all of the following conditions must be met, or a concurrent use proceeding before the Board must be prepared and instituted:

(1) The applicant is entitled to registration subject only to the concurrent lawful use of a party to the court proceeding;

(2) The court decree specifies the rights of the parties;

(3) A true copy of the court decree is submitted to the examining attorney;

(4) The concurrent use application complies fully and exactly with the court decree; and

(5) The excepted use specified in the concurrent use application does not involve a registration, or any involved registration has been restricted by the Director in accordance with the court decree.

If any of the conditions listed above are *not* satisfied, the examining attorney will approve the application for publication subject to a concurrent use registration proceeding before the Board (*see* **TMEP §§1207.04(e)** and **(e)(i))**, rather than pursuant to the court decree. 37 C.F.R. §2.99(f).

1207.04(f)(i) Preparing the Record for Publication

If the application complies with all the conditions listed in **TMEP §1207.04(f)** and all other relevant requirements, and is otherwise entitled to registration, the examining attorney will approve the application for publication of the mark. The examining attorney should prepare the record as follows:

The application must contain a concurrent use statement to be printed in the *Official Gazette*. The statement may be submitted by the applicant or prepared by the examining attorney. The statement will delineate the concurrent rights of the parties as determined by the court, in the following form:

Registration limited to the area comprising _____ [specifying the area granted to the applicant by the court and any other restriction designated by the court] pursuant to the decree of _____ [specifying the name of the court, proceeding number and date of the decree].

Concurrent registration with _____ [specifying the application serial number(s) or registration number(s), if any, of each other party; otherwise, the name and address of each other party].

After publication, if no opposition is filed, or if any opposition that is filed is dismissed or withdrawn, the application will mature into a registration.

1208 Conflicting Marks in Pending Applications

37 C.F.R. §2.83. Conflicting marks.

(a) Whenever an application is made for registration of a mark which so resembles another mark or marks pending registration as to be likely to cause confusion or mistake or to deceive, the mark with the earliest effective filing date will be published in the "Official Gazette" for opposition if eligible for the Principal Register, or issued a certificate of registration if eligible for the Supplemental Register.

(b) In situations in which conflicting applications have the same effective filing date, the application with the earliest date of execution will be published in the "Official Gazette" for opposition or issued on the Supplemental Register.

(c) Action on the conflicting application which is not published in the Official Gazette for opposition or not issued on the Supplemental Register will be suspended by the Examiner of Trademarks until the published or issued application is registered

or abandoned.

1208.01 Priority for Publication or Issue Based on Effective Filing Date

In ex parte examination, priority among conflicting pending applications is determined based on the effective filing dates of the applications, without regard to whether the dates of use in a later-filed application are earlier than the filing date or dates of use of an earlier-filed application, whether the applicant in a later-filed application owns a registration of a mark that would be considered a bar to registration of the earlier-filed application, or whether an application was filed on the basis of use of the mark in commerce or a bona fide intent to use the mark in commerce.

When two or more applications contain marks that are conflicting, the mark in the application that has the *earliest effective filing date* will be published for opposition if it is eligible for registration on the Principal Register, or will be registered if it is eligible for registration on the Supplemental Register. 37 C.F.R. §2.83(a). *See* **TMEP §§206** *et seq*. regarding effective filing dates.

The examining attorney cannot refuse registration under §2(d) of the Trademark Act based on an earlier-filed application for a conflicting mark until the mark registers. Therefore, when the examining attorney has examined the later-filed application and determined that it is in condition to be approved for publication or issue or in condition for a final refusal, but for the conflict between the marks, the examining attorney will *suspend* action on the later-filed application until the earlier-filed application matures into a registration or is abandoned. 37 C.F.R. §2.83(c); **TMEP §§716.02(c)** and **1208.02(c).**

1208.01(a) What Constitutes Conflict Between Pending Applications

Marks in applications filed by different parties are in conflict when the registration of one of the marks would be a bar to the registration of the other under §2(d) of the Trademark Act, 15 U.S.C. §1052(d). Therefore, the term “conflicting application” refers to an application to register a mark that so resembles the mark in another application as to be likely to cause confusion. *See* **TMEP §702.03(b).** *See* **TMEP §§1207** *et seq*. regarding likelihood of confusion. There may be several conflicting pending applications.

1208.01(b) What Constitutes Effective Filing Date

The *filing date* of an application under §1 or §44 of the Trademark Act is the date when all the elements designated in 37 C.F.R. §2.21(a) are received at the USPTO. In an application under §66(a) of the Trademark Act, 15 U.S.C. §1141f(a), the filing date is: (1) the international registration date, if the request for extension of protection to the United States is made in an international application; or (2) the date that the subsequent designation was recorded by the IB, if the request for extension of protection to the United States is made in a subsequent designation. **TMEP §201.**

While this is generally the *effective filing date* for purposes of determining priority among conflicting applications, in certain situations another date is treated as the effective filing date. *See* **TMEP §§206** *et seq*. For example, in an application claiming priority under §44(d) or §67 of the Trademark Act based on a foreign application, the effective filing date is the date of filing the foreign application. **TMEP §206.02.** In a §1(b) application that is amended to the Supplemental Register on the filing of an acceptable allegation of use, the effective filing date is the date of filing the allegation of use. **TMEP §206.01.** However, the USPTO does not alter the original filing date in its automated records.

If two or more applications conflict, the application with the earliest effective filing date will be approved for publication for opposition or for issuance of a registration on the Supplemental Register, as appropriate. 37 C.F.R. §2.83(a); **TMEP §1208.01.**

If conflicting applications have the same effective filing date, the application with the earliest date of execution will be published for opposition or issued on the Supplemental Register. 37 C.F.R. §2.83(b). An application that is unexecuted will be treated as having a later date of execution.

Occasionally, conflicting applications will have the same date of filing and execution. If this situation occurs, the application with the lowest serial number will have priority for publication or issuance. When determining which serial number is the lowest, the examining attorney should disregard the series code (e.g., “76,” “77,” “78,” or “79”) and look only to the six-digit serial number.

1208.01(c) Change in Effective Filing Date During Examination

If the effective filing date in an application containing a conflicting mark changes, the examining attorney should review all the application(s) involved to determine which application has the earliest effective filing date as a result of the change, and notify the examining attorney assigned to the application with the earliest effective filing date.

The examining attorney should conduct a new search of the mark whenever the effective filing date of an application changes to a date that is later than the original filing date. *See* **TMEP §206.04.**

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1208.01(d) Examination of Conflicting Marks After Reinstatement or Revival

When an abandoned application is revived or reinstated (*see* **TMEP §§1712.01**, **1713,** and **1714** *et seq*.), the examining attorney must conduct a new search to determine whether any later-filed applications for conflicting marks have been approved for publication or registration, and place the search strategy in the record.

If a later-filed application has been approved, the examining attorney should inform the examining attorney who approved the later-filed application that the earlier-filed application has been revived, if necessary. If the later-filed application has been published, the examining attorney handling that application should request jurisdiction (*see* **TMEP §1504.04(a))** and suspend the application pending disposition of the earlier-filed application that was revived or reinstated.

If a later-filed application for a conflicting mark has matured into registration, the examining attorney must refuse registration of the revived or reinstated application under §2(d), even though the application for the registered mark was filed after the revived or reinstated application. The USPTO does not have the authority to cancel the registration.

1208.02 Conflicting Applications Examination Procedure

1208.02(a) Examination of Application with Earliest Effective Filing Date

When the application with the earliest effective filing date is first reviewed for action, the examining attorney should approve the application for publication or for issuance of a registration on the Supplemental Register, if appropriate. 37 C.F.R. §2.83(a).

If the application with the earliest effective filing date is not in condition for publication or issue, the examining attorney should issue an Office action that includes all relevant refusals and requirements.

The USPTO does not notify applicants of potentially conflicting later-filed applications.

See **TMEP §§206** *et seq*. and **1208.01(b)** regarding what constitutes an effective filing date.

1208.02(b) Action on Later-Filed Application: Giving Notice of the Earlier Application or Applications

If, when the later-filed conflicting application is first reviewed for action, it is not in condition for publication or issue, the examining attorney should, in addition to treating other matters, send with the Office action an electronic copy or a printout from the USPTO's automated search system of the information for the mark in each earlier-filed application. The examining attorney's letter should also advise the applicant that the earlier application, if and when it matures into a registration, may be cited against the applicant's later-filed application. The applicant should be notified of all conflicting applications with earlier effective filing dates.

See **TMEP §1208.02(c)** regarding suspension of later-filed conflicting applications that are otherwise in condition to be approved for publication or issue.

1208.02(c) Suspension of Later-Filed Application

When the later-filed application is in condition for publication or issue except for the conflicting mark in an earlier-filed application, either because no action was necessary on the application as filed or because examination on other matters has been brought to a conclusion, the examining attorney should suspend the later-filed application until the mark in the earlier-filed application is registered or the earlier-filed application is abandoned. 37 C.F.R. §2.83(c). *In re Direct Access Communications (M.C.G.) Inc.*, 30 USPQ2d 1393 (Comm'r Pats. 1993). If the examining attorney discovers that a previously filed pending application was abandoned, but that a petition to revive is pending, the examining attorney should suspend the later-filed application pending disposition of the petition to revive.

Action on the later-filed application should also be suspended when the application is in condition for a final action but for the conflict with the earlier-filed application. The letter of suspension should repeat any outstanding issues, but these issues should not be made final. *See* **TMEP §716.02(c)** for further information about suspension and removal from suspension in this situation.

If the Office action informing the applicant of the suspension is the first action in the case, the examining attorney should include an electronic copy or a printout from the USPTO's automated search system of the information for the mark in each earlier-filed conflicting application.

1208.02(d) Action on Later-Filed Application upon Disposition of the Earlier Application or Applications

If all conflicting earlier-filed applications have either matured into registrations or become abandoned, and there are no other grounds for suspension, the examining attorney should remove the later-filed application from suspension and take appropriate action as follows.

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The examining attorney should cite the registration or registrations that issued from the earlier-filed conflicting application or applications, if there is a likelihood of confusion. This will be a first refusal under §2(d) of the Trademark Act, 15 U.S.C. §1052(d). Any other outstanding issues should be repeated at this time.

If all earlier-filed applications have become abandoned, the examining attorney should either approve the later-filed application for publication or issue, or repeat and make final any remaining issues, as appropriate.

If some, but not all of the earlier-filed conflicting applications have matured into registrations, the examining attorney will normally not issue a refusal of registration until the remaining conflicting application(s) are registered or abandoned, in order to avoid issuing piecemeal refusals. **TMEP §716.02(c).**

1208.02(e) Applicant's Argument on Issues of Conflict

If an applicant with a later-filed application files a request to remove the later-filed application from suspension (*see* **TMEP §716.03)**, arguing that there is no conflict in relation to the application with the earlier effective filing date, the examining attorney should consider the merits of that argument and determine whether or not the earlier-filed application constitutes a potential bar to registration under §2(d) of the Act.

If the examining attorney concludes that the earlier-filed application is not a potential bar, the examining attorney should remove the application from suspension and take appropriate action on any other outstanding issues.

However, if the examining attorney concludes that the earlier-filed application is a potential bar, the examining attorney should issue an action for the later-filed application (e.g., a new letter of suspension if there are no other issues that are not in condition for final action), in which the examining attorney explains why the applicant's argument is not persuasive.

1208.02(f) Conflicting Mark Mistakenly Published or Approved for Issuance on the Supplemental Register

If a later-filed conflicting mark is mistakenly published for opposition, it may be necessary for the assigned examining attorney to obtain jurisdiction of the application to take appropriate action. *See* **TMEP §§1504** *et seq*. concerning obtaining jurisdiction of an application after publication.

The examining attorney does not lose jurisdiction of an application forwarded for issuance on the Supplemental Register until the day of issuance of the registration.

1208.03 Procedure Relating to Possibility of Interference

An interference will not be declared except upon petition to the Director. The Director will declare an interference only upon a showing of extraordinary circumstances that would result in a party being unduly prejudiced without an interference. These cases are extremely rare. In ordinary circumstances, the availability of an opposition or cancellation proceeding is deemed to remove any undue prejudice. 37 C.F.R. §2.91(a). Interferences are generally limited to situations where a party would otherwise be required to engage in a series of opposition or cancellation proceedings, and where the issues are substantially the same. *See* **TMEP §1208.03(b).** The potential need to file two notices of opposition that could be consolidated if the issues were sufficiently similar, is not considered an extraordinary circumstance that will unduly prejudice a petitioner without an interference.

All petitions, or requests for interference should be forwarded to the Office of the Deputy Commissioner for Trademark Examination Policy for decision. The examining attorney does not make a determination on a request for interference.

See TBMP Chapter 1000.

1208.03(a) Procedures on Request for Interference

The request for interference should be in a separate document in the form of a petition, and should be captioned as a petition. The petition fee indicated in 37 C.F.R. §2.6 should accompany the request. A petition to declare an interference should not be filed before the application has been examined and the mark has been found to be registrable but for the existence of one or more conflicting pending applications.

A request for interference does not make an application "special" or alter the normal order of examination.

See TBMP Chapter 1000.

1208.03(b) Decision on Request for Interference

Section 16 of the Trademark Act, 15 U.S.C. §1066, states that, upon petition showing extraordinary circumstances, the Director may declare that an interference exists when application is made for the registration of a mark that so resembles a mark

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previously registered by another, or for the registration of which another has previously applied, as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion or mistake or to deceive. No interference shall be declared between an application and a registration that has become incontestable.

The Director will declare an interference only upon a showing of extraordinary circumstances that would result in a party being unduly prejudiced in the absence of an interference. 37 C.F.R. §2.91(a). The availability of opposition and cancellation procedures provides a remedy and ordinarily precludes the possibility of undue prejudice to a party. The request for interference must show that there is some extraordinary circumstance that would make the remedy of opposition or cancellation inadequate or prejudicial to the party's rights. *See In re Family Inns of America, Inc.*, 180 USPQ 332 (Comm'r Pats. 1974).

The fact that an earlier-filed application based on §1(b), §44, or §66(a) has been cited against a later-filed application based on use in commerce under §1(a) is not an extraordinary circumstance that warrants declaration of an interference. An opposition proceeding is the proper forum for determining priority between an applicant and another party. Priority for purposes of examination of an application is determined by filing date. 37 C.F.R. §2.83(a); **TMEP §1208.02(a).**

Although §16 of the Act permits the declaration of an interference between an application and a registration, the practice of declaring an interference in these cases has been discontinued because the applicant cannot obtain a registration if the interfering registration remains on the register. Therefore, even if the applicant prevailed in the interference, the applicant would still have to petition to cancel the interfering registration. *See In re Kimbell Foods, Inc.*, 184 USPQ 172 (Comm'r Pats. 1974); *Ex parte H. Wittur & Co.*, 153 USPQ 362 (Comm'r Pats. 1966); 37 C.F.R. §2.96.

See TBMP Chapter 1000.

1208.03(c) Procedure When Interference Is to be Declared

If the Director grants a petition requesting an interference, the examining attorney must determine that each mark is registrable but for the interfering mark before the interference will be instituted. 37 C.F.R. §2.92.

All marks must be published for opposition before interference proceedings are instituted; if possible, the marks should be published simultaneously.

Each application that is to be the subject of an interference must contain the following statement to be printed in the *Official Gazette*:

> This application is being published subject to declaration of interference with:
>
> Serial No.:
> Filed:
> Applicant:
> (Address, if there is no attorney)
> Attorney and Address:
> Mark:

The examining attorney should prepare the statement.

If an application that is published subject to interference is opposed by a party other than the applicant(s) in the interfering application(s), the opposition will be determined first. If still necessary and appropriate, the interference will be instituted. If an opposition is filed by the applicant in the interfering application, the rights of the parties will be determined in the opposition proceeding, and the interference proceeding will not be instituted.

If, during the pendency of an interference, another application appears involving substantially the same registrable subject matter, the examining attorney may request suspension of the interference for the purpose of adding that application. If the application is not added, the examining attorney should suspend further action on the application pending termination of the interference proceeding. 37 C.F.R. §2.98.

See TBMP Chapter 1000.

1209 Refusal on Basis of Descriptiveness

Extract from 15 U.S.C. §1052. No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it .... (e) Consists of a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them....

Matter that "merely describes" the goods or services on or in connection with which it is used is not registrable on the Principal

Register. As noted in *In re Abcor Development Corp.,* 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978):

> The major reasons for not protecting such marks are: (1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods; and (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.

1209.01 Distinctiveness/Descriptiveness Continuum

With regard to trademark significance, matter may be categorized along a continuum, ranging from marks that are highly distinctive to matter that is a generic name for the goods or services. The degree of distinctiveness – or, on the other hand, descriptiveness – of a designation can be determined only by considering it in relation to the specific goods or services. *Remington Products, Inc. v. North American Philips Corp*., 892 F.2d 1576, 1580, 13 USPQ2d 1444, 1448 (Fed. Cir. 1990) (the mark must be considered in context, i.e., in connection with the goods).

At one extreme are marks that, when used in relation to the goods or services, are completely arbitrary or fanciful. Next on the continuum are suggestive marks, followed by merely descriptive matter. Finally, generic terms for the goods or services are at the opposite end of the continuum from arbitrary or fanciful marks. As stated in *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 989, 228 USPQ 528, 530 (Fed. Cir. 1986), *quoting Weiss Noodle Co. v. Golden Cracknel & Specialty Co*., 290 F.2d 845, 847, 129 USPQ 411, 413 (C.C.P.A. 1961), "[t]he generic name of a thing is in fact the ultimate in descriptiveness."

Fanciful, arbitrary, and suggestive marks, often referred to as "inherently distinctive" marks, are registrable on the Principal Register without proof of acquired distinctiveness. *See* **TMEP §1209.01(a).**

Marks that are merely descriptive of the goods or services may not be registered on the Principal Register absent a showing of acquired distinctiveness under 15 U.S.C. §1052(f). *See* **TMEP §1209.01(b)** regarding merely descriptive marks, and **TMEP §§1212** *et seq*. regarding acquired distinctiveness. Merely descriptive marks may be registrable on the Supplemental Register in applications under §1 or §44 of the Trademark Act. 15 U.S.C. §1091.

Matter that is generic for the goods or services is not registrable on either the Principal or the Supplemental Register under any circumstances. *See* **TMEP §§1209.01(c)** *et seq*.

1209.01(a) Fanciful, Arbitrary, and Suggestive Marks

Fanciful marks comprise terms that have been invented for the sole purpose of functioning as a trademark or service mark. Such marks comprise words that are either unknown in the language (e.g., PEPSI, KODAK, and EXXON) or are completely out of common usage (e.g., FLIVVER).

Arbitrary marks comprise words that are in common linguistic use but, when used to identify particular goods or services, do not suggest or describe a significant ingredient, quality, or characteristic of the goods or services (e.g., APPLE for computers; OLD CROW for whiskey). *See, e.g., Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (VEUVE – meaning WIDOW in English – held to be "an arbitrary term as applied to champagne and sparkling wine, and thus conceptually strong as a trademark"); *Nautilus Group, Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 1340, 71 USPQ2d 1173, 1180 (Fed. Cir. 2004) (defining an arbitrary mark as "a known word used in an unexpected or uncommon way").

Suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought, or perception to reach a conclusion as to the nature of those goods or services. Thus, a suggestive term differs from a descriptive term, which immediately tells something about the goods or services. *See In re George Weston Ltd.,* 228 USPQ 57 (TTAB 1985) (SPEEDI BAKE for frozen dough found to fall within the category of suggestive marks because it only vaguely suggests a desirable characteristic of frozen dough, namely, that it quickly and easily may be baked into bread); *In re The Noble Co.,* 225 USPQ 749 (TTAB 1985) (NOBURST for liquid antifreeze and rust inhibitor for hot-water-heating systems found to suggest a desired result of using the product rather than immediately informing the purchasing public of a characteristic, feature, function, or attribute); *In re Pennwalt Corp.*, 173 USPQ 317 (TTAB 1972) (DRI-FOOT held suggestive of anti-perspirant deodorant for feet in part because, in the singular, it is not the usual or normal manner in which the purpose of an anti-perspirant and deodorant for the feet would be described)

Incongruity is a strong indication that a mark is suggestive rather than merely descriptive. *In re Tennis in the Round Inc.,* 199 USPQ 496, 498 (TTAB 1978) (TENNIS IN THE ROUND held not merely descriptive for providing tennis facilities, the Board finding that the association of applicant's marks with the phrase "theater-in-the-round" created an incongruity because applicant's tennis facilities are not at all analogous to those used in a "theater-in-the-round"). The Board has described incongruity in a mark as "one of the accepted guideposts in the evolved set of legal principles for discriminating the suggestive

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from the descriptive mark," and has noted that the concept of mere descriptiveness "should not penalize coinage of hitherto unused and somewhat incongruous word combinations whose import would not be grasped without some measure of imagination and 'mental pause.'" *In re Shutts*, 217 USPQ 363, 365 (TTAB 1983) (SNO-RAKE held not merely descriptive of a snow-removal hand tool); *see In re Vienna Sausage Mfg. Co.,* 156 USPQ 155, 156 (TTAB 1967) (FRANKWURST held not merely descriptive for wieners, the Board finding that although "frank" may be synonymous with "wiener," and "wurst" is synonymous with "sausage," the combination of the terms is incongruous and results in a mark that is no more than suggestive of the nature of the goods); *In re John H. Breck, Inc.,* 150 USPQ 397, 398 (TTAB 1966) (TINT TONE held suggestive for hair coloring, the Board finding that the words overlap in significance and their combination is somewhat incongruous or redundant and does not immediately convey the nature of the product); *cf. In re Getz Found.*, 227 USPQ 571, 572 (TTAB 1985) (MOUSE HOUSE held fanciful for museum services featuring mice figurines made up to appear as human beings, the Board finding that the only conceivable meaning of "mouse house," i.e., a building at a zoo in which live and/or stuffed mice are displayed, is incongruous).

Suggestive marks, like fanciful and arbitrary marks, are registrable on the Principal Register without proof of secondary meaning. Therefore, a designation does not have to be devoid of all meaning in relation to the goods/services to be registrable.

1209.01(b) Merely Descriptive Marks

To be refused registration on the Principal Register under §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), a mark must be merely descriptive or deceptively misdescriptive of the goods or services to which it relates. A mark is considered merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of the specified goods or services. *See In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) (APPLE PIE held merely descriptive of potpourri); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986) (BED & BREAKFAST REGISTRY held merely descriptive of lodging reservations services); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984) (MALE-P.A.P. TEST held merely descriptive of clinical pathological immunoassay testing services for detecting and monitoring prostatic cancer); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979) (COASTER-CARDS held merely descriptive of a coaster suitable for direct mailing).

The determination of whether a mark is merely descriptive must be made in relation to the goods or services for which registration is sought, not in the abstract. This requires consideration of the context in which the mark is used or intended to be used in connection with those goods/services, and the possible significance that the mark would have to the average purchaser of the goods or services in the marketplace. *See In re Omaha Nat'l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (C.C.P.A. 1978); *In re Venture Lending Associates,* 226 USPQ 285 (TTAB 1985). The mark need not describe all the goods and services identified, as long as it merely describes one of them. *See In re Stereotaxis Inc.*, 429 F.3d 1039, 1041, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005) ("[T]he Trademark Office may require a disclaimer as a condition of registration if the mark is merely descriptive for at least one of the products or services involved.")

It is not necessary that a term describe all of the purposes, functions, characteristics, or features of a product to be considered merely descriptive; it is enough if the term describes one significant function, attribute, or property. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) ("A mark may be merely descriptive even if it does not describe the 'full scope and extent' of the applicant's goods or services," citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); *Gyulay*, 820 F.2d at 1218, 3 USPQ2d at 1010; *In re Cox Enterprises Inc.*, 82 USPQ2d 1040 (TTAB 2007).

The great variation in facts from case to case prevents the formulation of specific rules for specific fact situations. Each case must be decided on its own merits. *See In re Ampco Foods, Inc.*, 227 USPQ 331 (TTAB 1985); *In re Venturi, Inc.,* 197 USPQ 714 (TTAB 1977).

See **TMEP §§1209.03** *et seq*. regarding factors that often arise in determining whether a mark is merely descriptive or generic.

See also **TMEP §§1213** *et seq.* concerning disclaimer of merely descriptive matter within a mark.

1209.01(c) Generic Terms

Generic terms are terms that the relevant purchasing public understands primarily as the common or class name for the goods or services. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1811 (Fed. Cir. 2001); *In re American Fertility Society*, 188 F.3d 1341, 1346, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999). These terms are incapable of functioning as registrable trademarks denoting source, and are not registrable on the Principal Register under §2(f) or on the Supplemental Register.

When a mark is comprised entirely of generic wording and some or all of the wording in the mark is the phonetic equivalent of the generic wording, the entire mark may not be disclaimed, even in the proper spelling, and approved for registration on the Supplemental Register. The disclaimer does not render an otherwise unregistrable generic mark registrable. *See* **TMEP §§1213.06** and **1213.08(c).**

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1209.01(c)(i) Test

There is a two-part test used to determine whether a designation is generic: (1) What is the class of goods or services at issue? and (2) Does the relevant public understand the designation primarily to refer to that class of goods or services? *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 990, 228 USPQ 528, 530 (Fed. Cir. 1986). The test turns upon the primary significance that the term would have to the relevant public.

The examining attorney has the burden of proving that a term is generic by clear evidence. *In re Merrill Lynch, Pierce, Fenner & Smith Inc.,* 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). Evidence of the public's understanding of a term can be obtained from any competent source, including dictionary definitions, research databases, newspapers, and other publications. *See In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985) (BUNDT, a term that designates a type of cake, held generic for ring cake mix); *In re Analog Devices Inc.*, 6 USPQ2d 1808 (TTAB 1988), *aff'd,* 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989) (ANALOG DEVICES held generic for devices having analog capabilities). Applicant's website and the websites of others are also proper sources of evidence as to the meaning of the proposed mark and the manner in which it is used in relation to the goods/services. *In re Reed Elsevier Properties Inc.,* 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007) (In holding LAWYERS.COM generic for "providing an online interactive database featuring information exchange in the fields of law, legal news and legal services," the Board properly considered applicant's website and eight other websites containing "lawyer.com" or "lawyers.com to determine the meaning of applicant's "information exchange about legal services.")

It is not necessary to show that the relevant public *uses* the term to refer to the genus. The correct inquiry is whether the relevant public would *understand* the term to be generic. *In re 1800MATTRESS.COM IP LLC,* 586 F.3d 1359, 92 USPQ2d 1682, 1685 (Fed. Cir. 2009).

There can be more than one generic term for a particular genus of goods or services. Any term that the relevant public understands to refer to the genus is generic. *1800Mattress.com,* 586 F.3d at 1364, 92 USPQ2d at 1685.

When a term is a compound word, the examining attorney may establish that a term is generic by producing evidence that each of the constituent words is generic, and that the separate words retain their generic significance when joined to form a compound that has "a meaning identical to the meaning common usage would ascribe to those words as a compound." *In re Gould Paper Corp.,* 834 F.2d 1017, 1018, 5 USPQ2d 1110, 1111-1112 (Fed. Cir. 1987) (SCREENWIPE held generic as applied to premoistened antistatic cloths for cleaning computer and television screens) *In re Wm. B. Coleman Co., Inc.,* 93 USPQ2d 2019 (TTAB 2010) (Board held that ELECTRIC CANDLE COMPANY is the combination of two generic terms joined to create a compound).

However, the Court of Appeals for the Federal Circuit has expressly limited the holding in *Gould* to "compound terms formed by the union of words" where the public understands the individual terms to be generic for a genus of goods or services, and the joining of the individual terms into one compound word lends "no additional meaning to the term." *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001) (citing *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832, 1837 (Fed. Cir. 1999)). Where the mark is a phrase, the examining attorney cannot simply cite definitions and generic uses of the individual components of the mark, but must provide evidence of the meaning of the composite mark as a whole. In *Coleman*, however, the Board stated that *American Fertility Society* cannot be read to suggest that an applicant can create a trademark by adding a clearly generic term to a non-source-identifying word, even in the absence of proof that others have used the composite. 93 USPQ 2d 2019 at 2025.

In *American Fertility Society*, the court held that evidence that the components "Society" and "Reproductive Medicine" were generic was not enough to establish that the composite phrase SOCIETY FOR REPRODUCTIVE MEDICINE was generic for association services in the field of reproductive medicine. The court held that the examining attorney must show: (1) the genus of services that the applicant provides; and (2) that the relevant public understands the proposed composite mark to primarily refer to that genus of services. 51 USPQ2d at 1836-37.

In *Dial-A-Mattress*, the court held that an alphanumeric telephone number "bears closer conceptual resemblance to a phrase than a compound word." 57 USPQ2d at 1811. The court found that 1-888-M-A-T-R-E-S-S was not generic as applied to "telephone shop-at-home retail services in the field of mattresses," because there was no evidence of record that the public understood the term to refer to shop-at-home telephone mattress retailers. Therefore, to establish that a mnemonic telephone number is generic, the examining attorney must show that the relevant public would understand the mark as a whole to have generic significance.

With respect to Internet domain names, even if the evidence shows that the individual components that make up the proposed mark are generic, one must determine whether joining the individual terms creates a composite that is itself generic. In very rare instances, the addition of a top-level domain indicator ("TLD") to an otherwise generic term may operate to create a distinctive mark. In *In re Steelbuilding.com,* 415 F.3d 1293, 1299, 75 USPQ2d 1420, 1423 (Fed. Cir. 2005), the Federal Circuit reversed the Board's determination that STEELBUILDING.COM is generic for "computerized on-line retail services in the field of pre-

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engineered metal buildings and roofing systems." The Court criticized the Board for considering STEELBUILDING and .COM separately, stating that "[i]n this unusual case, the addition of the TLD indicator expanded the meaning of the mark to include goods and services beyond the mere sale of steel buildings. Specifically, the TLD expanded the mark to include internet services that include 'building' or designing steel structures on the website and then calculating an appropriate price before ordering the unique structure."

The Court also criticized the Board for relying only on evidence that the separate terms "steel building" or "steel buildings" are generic, where the terms were joined together in the subject mark:

> The record does not contain any examination of dictionary definitions or other sources that might have indicated that joining the separate words "steel" and "building" would create a word that, in context, would be generic. The Board merely cited evidence that showed that when customers or competitors talked about a steel building, they used the phrase "steel building." That evidence shows that "steel building" is generic, but does not address directly the composite term STEELBUILDING.

415 F.3d at 1298-1299, 75 USPQ2d at 1423.

Thus, to establish that a proposed mark comprising an Internet domain name is generic, the examining attorney must show that the relevant public would understand the mark as a whole to have generic significance. *See 1800Mattress.com,* 586 F.3d at 1363, 92 USPQ2d at 1684 (affirming Board's conclusion that MATTRESS.COM was generic for "online retail store services in the field of mattresses, beds, and bedding," where the Board considered each of the constituent words, "mattress" and ".com" and determined that they were both generic, then considered the mark as a whole and determined that the combination added no new meaning, relying on the prevalence of the term "mattress.com" in the website addresses of several online mattress retailers who provide the same services as the applicant); *In re Hotels.com, L.P.,* 573 F.3d 1300, 91 USPQ2d 1532 (Fed. Cir. 2009) (HOTELS.COM is generic for "providing information for others about temporary lodging; [and] travel agency services, namely, making reservations and bookings for temporary lodging for others by means of telephone and the global computer network," based on various definitions of "hotel," printouts from hotel reservation search websites showing 'hotels" as the equivalent of or included within "temporary lodging," as well as evidence from applicant's website); *In re DNI Holdings Ltd.*, 77 USPQ2d 1435 (TTAB 2005) (SPORTSBETTING.COM held generic for "provision of casino games on and through a global computer network wherein there are no actual monetary wagers; provision of contests and sweepstakes on and through a global computer network; providing a website on and through a global computer network featuring information in the fields of gaming, athletic competition and entertainment...," where the record included multiple examples of use of the terms "sports betting" as well as the jointed terms "sportsbetting" by both applicant and its competitors to refer to both sports wagering and providing information about sports wagering, and there was no indication of a realistic alternative connotation of the compound term. *See also* **TMEP §§1209.03(m)** and **1215.05** regarding domain names comprising generic matter.)

1209.01(c)(ii) Terminology

As specifically amended by the Trademark Law Revision Act of 1988, §14 of the Trademark Act provides for the cancellation of a registration of a mark at any time if the mark "becomes the generic name for the goods or services, or a portion thereof, for which it is registered...." 15 U.S.C. §1064(3). Previously, that provision had pertained to a mark that "becomes the common descriptive name of an article or substance...." Cases previously distinguished between generic names and "apt or common descriptive names," which referred to matter that, while not characterized as "generic," had become so associated with the product that it was recognized in the applicable trade as another name for the product, serving as a term of art for all goods of that description offered by different manufacturers rather than identifying the goods of any one producer. *See Questor Corp. v. Dan Robbins & Associates, Inc.,* 199 USPQ 358, 364 (TTAB 1978), *aff'd,* 599 F.2d 1009, 202 USPQ 100 (C.C.P.A. 1979). In addition, the Trademark Law Revision Act of 1988 amended §15 of the Trademark Act to adopt the term "generic name" to refer to generic designations. 15 U.S.C. §1065(4). In view of the amendment of §§14 and 15, a distinction between "generic" names and "apt or common descriptive" names should not be made. Rather, the terminology of the Act should be consistently used, e.g., in refusals to register matter that is a generic name for the goods or services, or a portion thereof. *See In re K-T Zoe Furniture Inc.*, 16 F.3d 390, 29 USPQ2d 1787 (Fed. Cir. 1994).

Similarly, cases have distinguished between "generic" terms and terms that were deemed "so highly descriptive as to be incapable of exclusive appropriation as a trademark." *See In re Harcourt Brace Jovanovich, Inc.,* 222 USPQ 820 (TTAB 1984) (LAW & BUSINESS held so highly descriptive as to be incapable of distinguishing applicant's services of arranging and conducting seminars in the field of business law); *In re Industrial Relations Counselors, Inc.*, 224 USPQ 309 (TTAB 1984) (INDUSTRIAL RELATIONS COUNSELORS, INC. held an apt name or so highly descriptive of educational services in the industrial relations field that it is incapable of exclusive appropriation and registration, notwithstanding *de facto* source recognition capacity). Regarding current practice for refusing registration of such matter, the Trademark Trial and Appeal Board noted as follows in In *re Women's Publishing Co. Inc.*, 23 USPQ2d 1876, 1877 n.2 (TTAB 1992):

> The Examining Attorney's refusal that applicant's mark is "so highly descriptive that it is incapable of acting as a

> trademark" is not technically a statutory ground of refusal. Where an applicant seeks registration on the Principal Register, the Examining Attorney may refuse registration under Section 2(e)(1) of the Act, 15 USC 1052(e)(1), on the basis that the mark sought to be registered is generic (citations omitted). Alternatively, an Examining Attorney may refuse registration under the same section if he or she believes that the mark is merely descriptive and that applicant's showing of acquired distinctiveness is unpersuasive of registrability.

In essence, the Board was merely emphasizing the need to use precise statutory language in stating grounds for refusal. While the decision does not explicitly bar the use of the terminology "so highly descriptive that it is incapable of acting as a trademark" under all circumstances, the case illustrates that the use of this terminology may lead to confusion and should be avoided. It is particularly important in this context to use the precise statutory language to avoid doctrinal confusion. *See generally* McLeod, *The Status of So Highly Descriptive and Acquired Distinctiveness*, 82 Trademark Rep. 607 (1992). Therefore, examining attorneys should not state that a mark is "so highly descriptive that it is incapable of acting as a trademark" in issuing refusals. Rather, in view of the amendments of the Trademark Act noted above, the terminology "generic name for the goods or services" should be used in appropriate refusals, and use of the terminology "so highly descriptive" should be discontinued when referring to incapable matter.

This does not mean that designations that might formerly have been categorized as "so highly descriptive" should not be regarded as incapable. The Court of Appeals for the Federal Circuit has specifically stated that "a phrase or slogan can be so highly laudatory and descriptive as to be incapable of acquiring distinctiveness as a trademark." *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 1373, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999) (THE BEST BEER IN AMERICA for beer and ale held to be "so highly laudatory and descriptive of the qualities of [applicant's] product that the slogan does not and could not function as a trademark to distinguish Boston Beer's goods and serve as a indication of origin").

The Court of Appeals for the Federal Circuit has also stated that "[t]he critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be registered to refer to the genus of goods or services in question." *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989-990, 228 USPQ 528, 530 (Fed. Cir. 1986). Also, note that it is entirely appropriate to consider whether a particular designation is "highly descriptive" in evaluating registrability under §2(f), or in similar circumstances.

The expression "generic name for the goods or services" is not limited to noun forms but also includes "generic adjectives," that is, adjectives that refer to a genus, species, category, or class of goods or services. *In re Reckitt & Colman, North America Inc.*, 18 USPQ2d 1389 (TTAB 1991) (PERMA PRESS generic for soil and stain removers for use on permanent press products).

1209.01(c)(iii) Generic Matter: Case References

Marks Held Generic

In the following cases, the matter sought to be registered was found generic: *In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 92 USPQ2d 1682 (Fed. Cir. 2009) (MATTRESS.COM generic for "online retail store services in the field of mattresses, beds, and bedding"); *In re Hotels.com, L.P.,* 573 F.3d 1300, 91 USPQ2d 1532 (Fed. Cir. 2009) (HOTELS.COM generic for "providing information for others about temporary lodging; [and] travel agency services, namely, making reservations and bookings for temporary lodging for others by means of telephone and the global computer network"); *In re Reed Elsevier Properties Inc.*, 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007) (LAWYERS.COM generic for "providing an online interactive database featuring information exchange in the fields of law, legal news and legal services"); *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999) (THE BEST BEER IN AMERICA for beer and ale held to be "so highly laudatory and descriptive of the qualities of [applicant's] product that the slogan does not and could not function as a trademark to distinguish Boston Beer's goods and serve as an indication of origin"); *In re Gould Paper Corp.,* 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) (SCREENWIPE held generic as applied to premoistened antistatic cloths for cleaning computer and television screens); *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985) (BUNDT, a term that designates a type of cake, held generic for ring cake mix); *In re Wm. B. Coleman Co., Inc.,* 93 USPQ2d 2019 (TTAB 2010) (ELECTRIC CANDLE COMPANY held generic for "light bulbs; lighting accessories, namely, candle sleeves; lighting fixtures"); *In re Tires, Tires, Tires, Inc*., 94 USPQ2d 1153 (TTAB 2009).(TIRES TIRES TIRES held generic for retail tire store services); *Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549 (TTAB 2009) (product design configurations of "the body portion of a guitar" held generic for "guitar bodies"); *In re Noon Hour Food Products, Inc.*, 88 USPQ2d 1172 (TTAB 2008) (BOND-OST held generic for cheese); *In re Rosemount, Inc.*, 86 USPQ2d 1436 (TTAB 2008) (REDUCER generic for "flow meters used for measuring flow through pipes; vortex flow meters"); *In re Lens.com, Inc.*, 83 USPQ2d 1444 (TTAB 2007) (LENS held generic for "retail store services featuring contact eyewear products rendered via a global computer network"); *In re Active Ankle Systems, Inc.*, 83 USPQ2d 1532 (TTAB 2007) (DORSAL NIGHT SPLINT generic for "orthopedic splints for the foot and ankle"); *In re International Business Machines Corp*., 81 USPQ2d 1677 (TTAB 2006) (ESERVER generic for "computer network access products, namely, computer hardware and operating software therefor that allow connectivity to and the administration of public and proprietary computer networks and the processing of information contained thereon"); *In re The Outdoor Recreation Group*, 81 USPQ2d 1392 (TTAB 2006) (OUTDOOR PRODUCTS generic for a class of goods worn and

used by persons engaged in outdoor activities); *In re Rodale Inc.*, 80 USPQ2d 1696 (TTAB 2006) (NUTRITION BULLETIN held generic for "providing information in the field of health and diet via a web site on the Internet"); *In re DNI Holdings Ltd.*, 77 USPQ2d 1435 (TTAB 2005) (SPORTSBETTING.COM held generic for "provision of casino games on and through a global computer network wherein there are no actual monetary wagers; provision of contests and sweepstakes on and through a global computer network; [and] providing a web site on and through a global computer network featuring information in the fields of gaming, athletic competition and entertainment"); *In re Eddie Z's Blinds and Drapery, Inc.*, 74 USPQ2d 1037 (TTAB 2005) (BLINDSANDDRAPERY.COM generic for retail store services featuring blinds, draperies, and other wall coverings, conducted via the Internet); *In re Candy Bouquet Int'l, Inc.*, 73 USPQ2d 1883 (TTAB 2004) (CANDY BOUQUET generic for "retail, mail, and computer order services in the field of gift packages of candy"); *In re Cell Therapeutics Inc.*, 67 USPQ2d 1795 (TTAB 2003) (CELL THERAPEUTICS INC. generic for pharmaceutical preparations and laboratory research and development services); *In re American Institute of Certified Public Accountants*, 65 USPQ2d 1972 (TTAB 2003) (CPA EXAMINATION held generic for "printed matter, namely, practice accounting examinations; accounting exams; accounting exam information booklets; and prior accounting examination questions and answers"); *In re American Academy of Facial Plastic and Reconstructive Surgery*, 64 USPQ2d 1748 (TTAB 2002) (FACIAL PLASTIC SURGERY held generic for training, association, and collective membership services, where evidence showed that the phrase "facial plastic surgery" is a recognized field of surgical specialization); *In re A La Vieille Russie, Inc.*, 60 USPQ2d 1895 (TTAB 2001) (RUSSIANART generic for dealership services in the field of fine art, antiques, furniture, and jewelry); *Continental Airlines Inc. v. United Airlines Inc*., 53 USPQ2d 1385 (TTAB 1999) (E-TICKET generic for computerized reservation and ticketing of transportation services); *In re Log Cabin Homes Ltd.*, 52 USPQ2d 1206 (TTAB 1999) (LOG CABIN HOMES generic for architectural design of buildings and retail outlets selling kits for building log homes); *In re Web Communications*, 49 USPQ2d 1478 (TTAB 1998) (WEB COMMUNICATIONS generic for consulting services to businesses seeking to establish sites on a global computer network); *In re Central Sprinkler Co.,* 49 USPQ2d 1194 (TTAB 1998) (ATTIC generic for sprinklers installed primarily in attics); *In re Stanbel Inc.*, 16 USPQ2d 1469 (TTAB 1990), *aff'd,* 20 USPQ2d 1319 (Fed. Cir. 1991) (ICE PAK for reusable ice substitute for use in food and beverage coolers held generic; even assuming a contrary holding, evidence submitted by applicant deemed insufficient to establish acquired distinctiveness); *In re The Paint Products Co.*, 8 USPQ2d 1863 (TTAB 1988) (PAINT PRODUCTS CO. for "interior and exterior paints and coatings, namely, alkyd, oil, latex, urethane and epoxy based paints and coatings" held so highly descriptive as to be incapable of becoming distinctive; even assuming the term could function as a mark, applicant's evidence deemed insufficient to establish acquired distinctiveness); *In re Analog Devices Inc.*, 6 USPQ2d 1808 (TTAB 1988), *aff'd,* 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989) (ANALOG DEVICES held generic for devices having analog capabilities); *In re Mortgage Bankers Ass'n of America*, 226 USPQ 954 (TTAB 1985) (CERTIFIED MORTGAGE BANKER ("MORTGAGE BANKER" disclaimed) for "educational services, namely providing qualifying examinations, testing and grading in the field of real estate finance" held so highly descriptive as to be incapable of functioning as a mark notwithstanding evidence of acquired distinctiveness); *In re Half Price Books, Records, Magazines, Inc.*, 225 USPQ 219, 222 (TTAB 1984) (HALF PRICE BOOKS RECORDS MAGAZINES for retail book and record store services "is incapable of designating origin and any evidence of secondary meaning can only be viewed as 'de facto' in import and incapable of altering the inability of the subject matter for registration to function as a service mark").

Marks Held Not Generic

In the following cases, the matter sought to be registered was found not to be generic: *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420 (Fed. Cir. 2005) (STEELBUILDING.COM not generic for "computerized on line retail services in the field of pre-engineered metal buildings and roofing systems," but evidence submitted by applicant insufficient to establish acquired distinctiveness under §2(f)); *In re Dial-A-Mattress Operating Corp.,* 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001) (1-888-M-A-T-R-E-S-S not generic for "telephone shop-at-home retail services in the field of mattresses"); *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999) (SOCIETY FOR REPRODUCTIVE MEDICINE not generic for association services in the field of reproductive medicine); *In re Merrill Lynch, Pierce, Fenner & Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987) (CASH MANAGEMENT ACCOUNT for "stock brokerage services, administration of money market fund services, and providing loans against securities services" held merely descriptive, rather than generic, and remanded to Board to consider sufficiency of §2(f) evidence); *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc*., 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986) (FIRE CHIEF not generic for publications); *In re America Online, Inc.,* 77 USPQ2d 1618 (TTAB 2006) (INSTANT MESSENGER not generic for telecommunications services and computer services related to providing real time text messages; evidence submitted by applicant held sufficient to demonstrate acquired distinctiveness under §2(f)); *Zimmerman v. National Ass'n of Realtors,* 70 USPQ2d 1425 (TTAB 2004) (collective service marks REALTOR and REALTORS held not generic for real estate brokerage, management, appraisal, and planning services); *In re Federated Dept. Stores Inc.*, 3 USPQ2d 1541 (TTAB 1987) (THE CHILDREN'S OUTLET ("OUTLET" disclaimed), while merely descriptive of applicant's "retail children's clothing store services," held capable of functioning as a mark, with evidence submitted by applicant sufficient to establish acquired distinctiveness pursuant to §2(f)); *Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d 1996 (TTAB 1986) (SYSTEMS USER for periodic trade journal held merely descriptive, rather than generic, and applicant's evidence held sufficient to establish acquired distinctiveness pursuant to §2(f)); *In re Failure Analysis Associates*, 1 USPQ2d 1144 (TTAB 1986) (FAILURE ANALYSIS ASSOCIATES, for "consulting services in the field of

mechanical, structural, metallurgical, and metal failures, fires and explosions; engineering services in the field of mechanical design and risk analysis" and "consulting engineering services in the metallurgical field," found to be merely descriptive of applicant's services rather than incapable of distinguishing them from those of others; evidence submitted by applicant held sufficient to demonstrate acquired distinctiveness under §2(f)).

1209.02 Procedure for Descriptiveness and/or Genericness Refusal

The examining attorney must consider the evidence of record to determine whether a mark is merely descriptive or whether it is suggestive or arbitrary. *See In re Noble Co.*, 225 USPQ 749, 750 (TTAB 1985). The examining attorney may request that the applicant submit additional explanation or materials to clarify the nature of the goods or services. 37 C.F.R. §2.61(b); **TMEP §814.** The examining attorney should also do any necessary research to determine the nature of the use of the designation in the marketplace. To the fullest extent possible, the examining attorney will examine §1(b) applications for registrability under §2(e)(1) according to the same procedures and standards that apply to any other application. *See In re American Psychological Ass'n*, 39 USPQ2d 1467 (Comm'r Pats. 1996); **TMEP §§1102** and **1102.01.** "[T]he fact that applicant has filed an intent-to-use application does not limit the examining attorney's evidentiary options, nor does it shield an applicant from producing evidence that it may have in its possession." *In re Promo Ink*, 78 USPQ2d 1301, 1303 (TTAB 2006). If the examining attorney refuses registration, he or she should support the refusal with appropriate evidence. *See also In re Stereotaxis Inc.,* 429 F.3d 1039, 77 USPQ2d 1087 (Fed. Cir. 2005), involving an intent-to-use application where the Federal Circuit found a press release cited by the examining attorney relevant to show the public's perception of the goods.

In all cases, the examining attorney should try to make the Office action as complete as possible, so that the applicant may respond appropriately.

1209.02(a) Descriptive Marks – Advisory Statement That Mark Appears to Be Generic

A designation that is merely descriptive must be refused registration under §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1). The examining attorney must not initially issue a refusal in an application for registration on the Principal Register on the ground that a mark is a generic name for the goods or services, unless the applicant asserts that the mark has acquired distinctiveness under §2(f) in the application itself. *See* **TMEP §1209.02(b).** Even if it appears that the mark is generic, the proper basis for the initial refusal is §2(e)(1) descriptiveness. If there is strong evidence that the proposed mark is generic, a statement that the subject matter appears to be a generic name for the goods or services should be included in conjunction with the refusal on the ground that the matter is merely descriptive. It has been said that a generic term is "the ultimate in descriptiveness." *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989, 228 USPQ 528, 530 (Fed. Cir. 1986), quoting *Weiss Noodle Co. v. Golden Cracknel & Specialty Co*., 290 F.2d 845, 847, 129 USPQ 411, 413 (C.C.P.A. 1961).

If, on the other hand, the mark appears to be capable, the examining attorney should provide appropriate advice concerning a possible amendment to the Supplemental Register or assertion of a claim of acquired distinctiveness. *See* **TMEP §1102.03** concerning ineligibility of the proposed mark in a §1(b) application for the Supplemental Register prior to filing an acceptable amendment to allege use under 15 U.S.C. §1051(c) or statement of use under 15 U.S.C. §1051(d). The examining attorney should also advise the applicant regarding any incapable portion of the mark for which a disclaimer would be required in connection with an amendment to the Supplemental Register or assertion of a claim of acquired distinctiveness. If the applicant responds by amending to the Supplemental Register or asserting acquired distinctiveness, but does not submit the disclaimer, the examining attorney must issue a non-final Office action. Prior to the applicant's amendment, information regarding the disclaimer requirement is merely advisory. Failure to submit the disclaimer thus would constitute a new issue requiring a non-final Office action.

If the record is unclear as to whether the designation is capable of functioning as a mark, the examining attorney should refrain from giving any advisory statement. In general, the examining attorney should make every effort to apprise applicants as early as possible of the prospects for registration through appropriate amendments, if feasible. *NOTE: A mark in a §66(a) application cannot be registered on the Supplemental Register under any circumstances. 15 U.S.C. §1141h(a)(4); 37 C.F.R. §§2.47(c) and 2.75(c).*

If, in response to a first-action refusal under §2(e)(1), the applicant merely argues that the mark is registrable on the Principal Register without claiming acquired distinctiveness or amending to the Supplemental Register, the examining attorney should issue a final refusal under §2(e)(1), on the ground that the proposed mark is merely descriptive, if he or she is not persuaded by the applicant's arguments.

1209.02(a)(i) Amendment to Supplemental Register in Response to Office Action

If the applicant responds to a §2(e)(1) descriptiveness refusal by amending its application to the Supplemental Register, this amendment presents a new issue requiring consideration by the examining attorney (unless the amendment is irrelevant to the

outstanding refusal—*see* **TMEP §714.05(a)(i)).** If the examining attorney determines that the designation is a generic name for the applicant's goods or services, the examining attorney should then issue a nonfinal action refusing registration on the Supplemental Register. The statutory basis for such a refusal is §23 of the Trademark Act, 15 U.S.C. §1091. *See* **TMEP §§815** *et seq*. and **816** *et seq*. concerning applications for registration on the Supplemental Register.

1209.02(a)(ii) Assertion of §2(f) in Response to Office Action

If the applicant responds to a §2(e)(1) descriptiveness refusal by amending its application to assert acquired distinctiveness under §2(f), this also raises a new issue. *See* **TMEP §1212.02(h).** If the examining attorney determines that the designation is a generic name for the applicant's goods or services, the examining attorney must issue a new nonfinal action refusing registration under §2(e)(1) on the basis that the mark is generic and stating that the claim of acquired distinctiveness is insufficient to overcome the refusal. The examining attorney must also maintain and continue, in the alternative, the refusal under §2(e)(1) that the mark is merely descriptive and must separately explain why the showing of acquired distinctiveness is insufficient to overcome the descriptiveness refusal even if the mark is ultimately deemed not to be generic. As the Trademark Trial and Appeal Board noted in In *re Women's Publishing Co. Inc.*, 23 USPQ2d 1876, 1877 n.2 (TTAB 1992):

> The Examining Attorney's refusal that applicant's mark is "so highly descriptive that it is incapable of acting as a trademark" is not technically a statutory ground of refusal. Where an applicant seeks registration on the Principal Register, the Examining Attorney may refuse registration under Section 2(e)(1) of the Act, 15 USC 1052(e)(1), on the basis that the mark sought to be registered is generic. *See, e.g., In re Northland Aluminum Products Inc*., 777 F.2d 1556, 227 USPQ 961, 962 (Fed. Cir. 1985), *Weiss Noodle Co. v. Golden Cracknel and Specialty Co*., 290 F.2d 845, 129 USPQ 411, 413 (C.C.P.A. 1961), *In re Deutsche Airbus GmbH*, 224 USPQ 611 (TTAB 1984) and *Conde Nast Publications Inc. v. Redbook Publishing Co*., 217 USPQ 356, 360 (TTAB 1983). Alternatively, an Examining Attorney may refuse registration under the same section if he or she believes that the mark is merely descriptive and that applicant's showing of acquired distinctiveness is unpersuasive of registrability.

If the examining attorney fails to separately address the sufficiency of the §2(f) evidence, this may be treated as a concession that the evidence would be sufficient to establish distinctiveness if the mark is ultimately found not to be generic. *Cf. In re Dietrich,* 91 USPQ2d 1622, 1625 (TTAB 2009), in which the Board held that an examining attorney had "effectively conceded that, assuming the mark is not functional, applicant's evidence is sufficient to establish that the mark had acquired distinctiveness," where the examining attorney rejected the applicant's §2(f) claim on the ground that applicant's bicycle wheel configuration was functional and thus unregistrable even under §2(f), but did not specifically address the sufficiency of the §2(f) evidence or the question of whether the mark would be registrable under §2(f) if it were ultimately found to be non-functional.

Therefore, the descriptiveness refusal must be maintained, in the alternative, in the event that the mark is ultimately determined not to be generic. *See* **TMEP §§1212** *et seq.* regarding distinctiveness under §2(f), and **TMEP §1212.02(i)** regarding assertion of §2(f) claims with respect to generic matter.

See, e.g., In re Candy Bouquet Int'l Inc., 73 USPQ2d 1883 (TTAB 2004); *In re American Academy of Facial Plastic and Reconstructive Surgery,* 64 USPQ2d 1748 (TTAB 2002); *In re A La Vieille Russie Inc.,* 60 USPQ2d 1895 (TTAB 2001).

1209.02(b) Descriptive and Possibly Generic Marks – Assertion of §2(f) in Application

If the applicant asserts acquired distinctiveness under §2(f) in the original application and the examining attorney determines that the applied-for mark is a generic name for the applicant's goods or services, the examining attorney must issue a nonfinal action refusing registration under §2(e)(1) on the basis that the mark is generic and stating that the claim of acquired distinctiveness is insufficient to overcome the refusal. The examining attorney must also refuse registration under §2(e)(1), in the alternative, as merely descriptive and must separately explain why the showing of acquired distinctiveness is insufficient to overcome the descriptiveness refusal even if the mark is ultimately deemed not to be generic.

If the examining attorney ultimately issues a final refusal under §2(e)(1) on the ground that the mark is generic, the descriptiveness refusal, including an explanation of the insufficiency of any §2(f) evidence, must also be made final, in the alternative, in case the mark is ultimately determined not to be generic. *See, e.g., In re Candy Bouquet Int'l,* I73 USPQ2d 1883 (TTAB 2004); *In re American Academy of Facial Plastic and Reconstructive Surgery,* 64 USPQ2d 1748 (TTAB 2002); *In re A La Vieille Russie Inc.,* 60 USPQ2d 1895 (TTAB 2001).

If the examining attorney fails to separately address the sufficiency of the §2(f) evidence, this may be treated as a concession that the evidence would be sufficient to establish distinctiveness if the mark is ultimately found not to be generic. *Cf. In re Dietrich,* 91 USPQ2d 1622, 1625 (TTAB 2009), in which the Board held that an examining attorney had "effectively conceded that, assuming the mark is not functional, applicant's evidence is sufficient to establish that the mark had acquired distinctiveness," where the examining attorney rejected the applicant's §2(f) claim on the ground that applicant's bicycle wheel configuration was functional and thus unregistrable even under §2(f), but did not specifically address the sufficiency of the §2(f)

evidence or the question of whether the mark would be registrable under §2(f) issue of whether the would be registrable under 2(f) if it were ultimately found to be non-functional.

See **TMEP §§1212** *et seq*. regarding distinctiveness under §2(f), and **TMEP §1212.02(i)** regarding assertion of §2(f) claims with respect to generic matter.

1209.03 Considerations Relevant to Determination of Descriptiveness or Genericness

The following sections discuss factors and situations that often arise during a determination of whether a mark is descriptive or generic.

1209.03(a) Third-Party Registrations

Third-party registrations are not conclusive on the question of descriptiveness. Each case must stand on its own merits, and a mark that is merely descriptive should not be registered on the Principal Register simply because other such marks appear on the register. *In re Scholastic Testing Service, Inc.*, 196 USPQ 517 (TTAB 1977) (SCHOLASTIC held merely descriptive of devising, scoring, and validating tests for others). The question of whether a mark is merely descriptive must be determined based on the evidence of record at the time registration is sought. *See In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) (AGENTBEANS held merely descriptive of computer software for use in development and deployment of application programs on a global computer network).

1209.03(b) No Dictionary Listing

The fact that a term is not found in a dictionary is not controlling on the question of registrability if the examining attorney can show that the term has a well understood and recognized meaning. *See In re Orleans Wines, Ltd.*, 196 USPQ 516 (TTAB 1977) (BREADSPRED held merely descriptive of jellies and jams).

1209.03(c) First or Only User

The fact that an applicant may be the first and only user of a merely descriptive or generic designation does not justify registration if the only significance conveyed by the term is merely descriptive. *See In re National Shooting Sports Foundation, Inc.,* 219 USPQ 1018 (TTAB 1983) (SHOOTING, HUNTING, OUTDOOR TRADE SHOW AND CONFERENCE held apt descriptive name for conducting and arranging trade shows in the hunting, shooting, and outdoor sports products field). *See also* **TMEP §1212.06(e)(i)** and cases cited therein.

1209.03(d) Combined Terms

When two descriptive terms are combined, the determination of whether the composite mark also has a descriptive significance turns upon the question of whether the combination of terms evokes a new and unique commercial impression. If each component retains its descriptive significance in relation to the goods or services, the combination results in a composite that is itself descriptive. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004) (PATENTS.COM merely descriptive of computer software for managing a database of records that could include patents and for tracking the status of the records by means of the Internet); *In re Gould Paper Corp.,* 834 F.2d 1017, 1018, 5 USPQ2d 1110, 1111-1112 (Fed. Cir. 1987) (SCREENWIPE held generic as applied to premoistened antistatic cloths for cleaning computer and television screens); *In re Petroglyph Games, Inc.,* 91 USPQ2d 1332 (TTAB 2009) (BATTLECAM merely descriptive for computer game software); *In re Carlson*, 91 USPQ2d 1198 (TTAB 2009) (URBANHOUZING merely descriptive of real estate brokerage, real estate consultation and real estate listing services); *In re Leonhardt*, ___ USPQ2d ___, Ser. No. 78666879 (TTAB November 13, 2008) (BOBBLE POPS held merely descriptive for “candy,” which the record showed was a lollipop candy featuring a bobble head device); *In re Cox Enterprises Inc.,* 82 USPQ2d 1040 (TTAB 2007) (THEATL – a compressed version of the term “THE ATL,” a recognized nickname for the city of Atlanta – held merely descriptive of printed matter of interest to residents of and tourists and visitors to Atlanta, Georgia); *In re King Koil Licensing Co. Inc.*, 79 USPQ2d 1048 (TTAB 2006) (THE BREATHABLE MATTRESS held merely descriptive of “beds, mattresses, box springs and pillows,” based on dictionary definitions of “breathable” and “mattress,” and excerpts of web pages that refer to “breathable mattresses” and “breathable bedding”); *In re Finisar Corp.*, 78 USPQ2d 1618 (TTAB 2006), *aff'd per curiam*, No. 2006-1463, 2007 U.S. App. LEXIS 11535 (Fed. Cir. May 3, 2007) (SMARTSFP held merely descriptive of optical transceivers); *In re Tower Tech, Inc.*, 64 USPQ2d 1314 (TTAB 2002) (SMARTTOWER merely descriptive of “commercial and industrial cooling towers and accessories therefor, sold as a unit”); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) (AGENTBEANS merely descriptive of computer software for use in development and deployment of application programs on global computer network); *In re Putman Publishing Co.,* 39 USPQ2d 2021 (TTAB 1996) (FOOD & BEVERAGE ONLINE merely descriptive of news and information service for the food processing industry); *In re Copytele Inc.*, 31 USPQ2d 1540 (TTAB 1994) (SCREEN FAX PHONE merely descriptive of “facsimile terminals employing electrophoretic displays”); *In re Entenmann's Inc*., 15 USPQ2d 1750 (TTAB 1990), *aff'd per curiam,* 928 F.2d 411 (Fed. Cir. 1991) (OATNUT be merely descriptive of bread containing oats and hazelnuts); *In re Serv-A-Portion Inc.,* 1 USPQ2d 1915 (TTAB 1986) (SQUEEZE N SERV merely descriptive of ketchup and thus subject to disclaimer); *In re Wells Fargo & Co*.,

231 USPQ 95 (TTAB 1986) (EXPRESSERVICE merely descriptive of banking and trust services); *In re Uniroyal, Inc.,* 215 USPQ 716 (TTAB 1982) (STEELGLAS BELTED RADIAL merely descriptive of vehicle tires containing steel and glass belts); *In re Bright-Crest, Ltd.,* 204 USPQ 591 (TTAB 1979) (COASTER-CARDS merely descriptive of coasters suitable for direct mailing).

However, a mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a unique, nondescriptive meaning, or if the composite has a bizarre or incongruous meaning as applied to the goods. *See In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968) (SUGAR & SPICE held not merely descriptive of bakery products); *In re Shutts,* 217 USPQ 363 (TTAB 1983) (SNO-RAKE held not merely descriptive of a snow removal hand tool).

When there is evidence that the composite mark itself has been used together to form a phrase that is descriptive of the goods or services, it is unnecessary to engage in an analysis of each individual component. *In re Shiva Corp.,* 48 USPQ2d 1957 (TTAB 1998) (TARIFF MANAGEMENT merely descriptive of computer hardware and computer programs to control, reduce, and render more efficient wide area network usage).

The Trademark Trial and Appeal Board has held that the addition of the prefix “e” does not change the merely descriptive significance of a term in relation to goods or services sold or rendered electronically, where the record showed that the “e” prefix has become commonly recognized as a designation for goods or services sold or delivered electronically. *In re International Business Machines Corp*., 81 USPQ2d 1677, 1679 (TTAB 2006) (“We see no difference in the meaning or connotation of ‘e-server’ and ‘eserver,’ and consider them both to be an abbreviated form of ‘electronic server.’”); *In re SPX Corp.,* 63 USPQ2d 1592 (TTAB 2002) (E-AUTODIAGNOSTICS merely descriptive of an “electronic engine analysis system comprised of a hand-held computer and related computer software”); *In re Styleclick.com Inc.*, 57 USPQ2d 1445 (TTAB 2000) (E FASHION merely descriptive of software used to obtain beauty and fashion information, and for electronic retailing services); *Continental Airlines Inc. v. United Airlines Inc*., 53 USPQ2d 1385 (TTAB 1999) (E-TICKET generic for computerized reservation and ticketing of transportation services). Similarly, with appropriate evidence, the prefix “i” or “I” was held to be understood by purchasers to signify Internet, when used in relation to Internet-related products or services. *See In re Zanova, Inc.*, 59 USPQ2d 1300 (TTAB 2000) (ITOOL merely descriptive of computer software for use in creating web pages, and custom design of websites for others). In these situations, the examining attorney should provide evidence of use of the prefix “e” or “i” in relation to the goods or services.

The addition of an entity designator (e.g., Corporation, Corp., Co., Inc., Ltd., etc.) to a descriptive term does not alter the term’s descriptive significance, because an entity designation has no source-indicating capacity. *See Goodyear’s India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598, 602 (1888) (“The addition of the word ‘Company’ [to an otherwise generic mark] only indicates that parties have formed an association or partnership to deal in such goods . . . .” and does not render the generic mark registrable);**”** *In re Cell Therapeutics Inc.*, 67 USPQ2d 1795 (TTAB 2003) (CELL THERAPEUTICS INC. generic for pharmaceutical preparations and laboratory research and development services); *In re Taylor & Francis [Publishers] Inc.*, 55 USPQ2d 1213, 1215 (TTAB 2000) (“PRESS,” as applied to a printing or publishing establishment, “is in the nature of a generic entity designation which is incapable of serving a source-indicating function”); *In re Patent & Trademark Services Inc.,* 49 USPQ2d 1537 (TTAB 1998) (PATENT & TRADEMARK SERVICES INC. is merely descriptive of legal services in the field of intellectual property; the term “INC.” merely indicates the type of entity that performs the services, and has no significance as a mark); *In re The Paint Products Co*., 8 USPQ2d 1863, 1866 (TTAB 1988) (“‘PAINT PRODUCTS CO.’ is no more registrable for goods emanating from a company that sells paint products than it would be as a service mark for the retail paint store services offered by such a company.”); *In re Packaging Specialists, Inc.*, 221 USPQ 917, 919 (TTAB 1984) (the element “INC.” [in PACKAGING SPECIALISTS, INC.] has “no source indication or distinguishing capacity”). *See* **TMEP §1213.03(d)** regarding disclaimer of entity designators.

1209.03(e) More Than One Meaning

Descriptiveness must be determined in relation to the goods or services for which registration is sought. Therefore, the fact that a term may have a different meaning(s) in a different context is not controlling. *See In re Chopper Industries*, 222 USPQ 258 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); *In re Champion Int’l Corp.,* 183 USPQ 318 (TTAB 1974). If a term has a primary significance that is descriptive in relation to at least one of the recited goods/services, and does not create any double entendre or incongruity, then the term is merely descriptive.

See **TMEP §1213.05(c)** regarding wording that constitutes a “double entendre.”

1209.03(f) Picture or Illustration

A visual representation that consists merely of an illustration of the goods, or of an article that is an important feature or characteristic of the goods or services, is merely descriptive under §2(e)(1) of the Act. *See In re Society for Private and Commercial Earth Stations*, 226 USPQ 436 (TTAB 1985) (representation of satellite dish held merely descriptive of services of

an association promoting the interests of members of the earth station industry); *In re Underwater Connections, Inc.,* 221 USPQ 95 (TTAB 1983) (pictorial representation of a compressed air gas tank held merely descriptive of travel tour services involving underwater diving). *But see In re LRC Products Ltd.*, 223 USPQ 1250 (TTAB 1984) (stylized hand design found not merely an illustration of the goods, i.e., gloves; thus not merely descriptive).

1209.03(g) Foreign Equivalents

The foreign equivalent of a merely descriptive English word is no more registrable than the English word itself. Words from modern languages are generally translated into English to determine descriptiveness or genericness. *In re N. Paper Mills*, 64 F.2d 998, 17 USPQ 492 (C.C.P.A. 1933). *See In re Tokutake Indus. Co.,* 87 USPQ2d 1697 (TTAB 2008) (AYUMI and its Japanese-character equivalent held merely descriptive for footwear where the evidence, including applicant's own admissions, indicated that the primary meaning of applicant's mark is “walking”); *In re Oriental Daily News, Inc*., 230 USPQ 637 (TTAB 1986) (Chinese characters that mean ORIENTAL DAILY NEWS held merely descriptive of newspapers); *In re Geo. A. Hormel & Co.,* 227 USPQ 813 (TTAB 1985) (SAPORITO, an Italian word meaning “tasty,” held merely descriptive because it describes a desirable characteristic of applicant’s dry sausage).

Although words from modern languages are generally translated into English, the doctrine of foreign equivalents is not an absolute rule, but merely a guideline. The doctrine should be applied only when it is likely that the ordinary American purchaser would stop and translate the foreign word into its English equivalent. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772,* 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The “ordinary American purchaser” includes “all American purchasers, including those proficient in a non-English language who would ordinarily be expected to translate words into English.” *In re Spirits Int’l, N.V.*, 563 F.3d 1347, 1352, 90 USPQ2d 1489, 1492 (Fed. Cir. 2009).

While foreign words are generally translated into English for purposes of determining descriptiveness, foreign words from dead or obscure languages may be so unfamiliar to the American buying public that they should not be translated into English for descriptiveness purposes. *See Enrique Bernat F. S.A. v. Guadalajara Inc*., 210 F.3d 439, 54 USPQ2d 1497 (5th Cir. 2000), *reh’g denied* 218 F.3d 745 (2000); *cf. Gen. Cigar Co. v. G.D.M. Inc*., 988 F. Supp. 647, 45 USPQ2d 1481 (S.D.N.Y. 1997). The determination of whether a language is “dead” must be made on a case-by-case basis, based upon the meaning that the term would have to the relevant purchasing public.

> *Example:* Latin is generally considered a dead language. However, if evidence exists that the relevant purchasing public still uses a Latin term (e.g., if the term appears in current dictionaries or news articles), then that Latin term is not considered dead. The same analysis should be applied to other uncommon languages.

Note that marks comprised of a term from a foreign language used with an English term may be found registrable if the commercial impression created by the combination differs from that which would be created by two English words. *See In re Johanna Farms Inc.,* 8 USPQ2d 1408 (TTAB 1988) (LA YOGURT for yogurt registrable on Principal Register with a disclaimer of “YOGURT”); *In re Sweet Victory, Inc.,* 228 USPQ 959 (TTAB 1986) (GLACE LITE held not descriptive for ice creams, sherbets, frozen yogurts, and nondairy frozen desserts); *In re Universal Package Corp.*, 222 USPQ 344 (TTAB 1984) (LE CASE not merely descriptive of jewelry boxes and gift boxes and, therefore, registrable with a disclaimer of “CASE”).

See **TMEP §§809** *et seq*. for information regarding how to determine the meaning of non-English wording in a mark. See also **TMEP §§1207.01(b)(vi)** *et seq.*, **1210.10**, and **1211.01(a)(vii)** regarding the doctrine of foreign equivalents.

1209.03(h) Acronyms

As a general rule, an acronym or initialism cannot be considered descriptive unless the wording it stands for is merely descriptive of the goods or services, and the acronym or initialism is readily understood by relevant purchasers to be "substantially synonymous" with the merely descriptive wording it represents. *Modern Optics Inc. v. The Univis Lens Co.,* 234 F. 2d 504, 110 USPQ 293 (C.C.P.A. 1956). Thus, without additional evidence, an applicant’s proprietary use of an acronym is not sufficient to establish that the acronym is readily understood to be substantially synonymous with the descriptive wording it represents. *Id.* (finding the record unconvincing that CV is a generally recognized term for multifocal lenses and lens blanks). *See also In re BetaBatt Inc.,* 89 USPQ2d 1152 (TTAB 2008) (DEC found to be routinely used as an abbreviation for “direct energy conversion”); *Capital Project Mgmt. Inc. v. IMDISI Inc.,* 70 USPQ2d 1172 (TTAB 2003) (TIA found to be substantially synonymous with “time impact analysis”); *In re The Yacht Exch., Inc.,* 214 USPQ 406 (TTAB 1982) (MLS held descriptive for multiple listing services for yachts and boats); *cf. In re Harco Corp.,* 220 USPQ 1075 (TTAB 1984) (record insufficient to establish that CPL would be commonly understood as no more than an abbreviation of “computerized potential log”).

1209.03(i) Intended Users

A term that identifies a group to whom the applicant directs its goods or services is merely descriptive. *See In re Planalytics, Inc.,* 70 USPQ2d 1453 (TTAB 2004) (GASBUYER merely descriptive of risk management services in the field of pricing and purchasing natural gas); *Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d 1996 (TTAB 1986) (SYSTEMS USER

found merely descriptive of a trade journal directed toward users of large data processing systems; evidence sufficient to establish distinctiveness under §2(f)); *In re Camel Mfg. Co., Inc.,* 222 USPQ 1031 (TTAB 1984) (MOUNTAIN CAMPER held merely descriptive of retail mail-order services in the field of outdoor equipment and apparel).

1209.03(j) Phonetic Equivalent

A slight misspelling of a word will not turn a descriptive or generic word into a non-descriptive mark. *See C-Thru Ruler Co. v. Needleman*, 190 USPQ 93 (E.D. Pa. 1976) (C-THRU held to be the equivalent of "see-through" and, therefore, merely descriptive of transparent rulers and drafting aids); *In re Carlson*, 91 USPQ2d 1198 (TTAB 2009) (URBANHOUZING, in standard character form, would be perceived by consumers as the equivalent of the descriptive term URBAN HOUSING, rather than as including the separate word ZING); *In re Ginc UK Ltd.*, 90 USPQ2d 1472 (TTAB 2007) (generic meaning of "togs" not overcome by the misspelling of the term as TOGGS); *In re Hubbard Milling Co*., 6 USPQ2d 1239 (TTAB 1987) (MINERAL-LYX held generic for mineral licks for feeding livestock).

1209.03(k) Laudatory Terms

Laudatory terms, those that attribute quality or excellence to goods or services, are merely descriptive under §2(e)(1). *See In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001) (THE ULTIMATE BIKE RACK found to be merely descriptive and, therefore, subject to disclaimer); *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (THE BEST BEER IN AMERICA so highly laudatory and descriptive as applied to beer and ale that it is incapable of acquiring distinctiveness); *In re Best Software Inc.,* 58 USPQ2d 1314 (TTAB 2001) (the words BEST and PREMIER in mark BEST! SUPPORTPLUS PREMIER merely descriptive of computer consultation and support services and thus subject to disclaimer); *In re Dos Padres Inc.*, 49 USPQ2d 1860 (TTAB 1998) (QUESO QUESADILLA SUPREME merely descriptive of cheese); *In re Consolidated Cigar Co.,* 35 USPQ2d 1290 (TTAB 1995) (SUPER BUY merely descriptive of tobacco products); *General Foods Corp. v. Ralston Purina Co.,* 220 USPQ 990 (TTAB 1984) (ORIGINAL BLEND merely descriptive of cat food).

1209.03(l) Telephone Numbers

If an applicant applies to register a designation that consists of a merely descriptive term with numerals in the form of an alphanumeric telephone number (e.g., 800, 888, or 900 followed by a word), the examining attorney should refuse registration under §2(e)(1). *See In re Page*, 51 USPQ2d 1660 (TTAB 1999) (888 PATENTS merely descriptive of patent-related legal services). The fact that a designation is in the form of a telephone number is insufficient, by itself, to render it distinctive.

If the relevant term is merely descriptive, but not generic, the mark may be registered on the Principal Register with a proper showing of acquired distinctiveness under §2(f), or on the Supplemental Register, if appropriate. *See Express Mortgage Brokers Inc. v. Simpson Mortgage Inc.,* 31 USPQ2d 1371 (E.D. Mich. 1994) (369-CASH held merely descriptive but shown to have acquired distinctiveness as applied to mortgage brokering and mortgage-related services). Of course, the designation must also be used in the manner of a mark. *See* **TMEP §§1202** *et seq*. regarding use as a mark.

If the proposed mark is generic, the designation is unregistrable on either the Principal or the Supplemental Register. However, to support a refusal of registration on the ground that a telephone number is generic, the Court of Appeals for the Federal Circuit has held that it is not enough to show that the telephone number consists of a non-source-indicating area code and a generic term. The examining attorney must show evidence of the meaning the relevant purchasing public accords the proposed alphanumeric mark as a whole. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1811 (Fed. Cir. 2001). *See also Dial-A-Mattress Franchise Corp. v. Page*, 880 F.2d 675, 11 USPQ2d 1644 (2d Cir. 1989) (use of confusingly similar telephone number enjoined). *But see Dranoff-Perlstein Associates v. Sklar*, 967 F.2d 852, 857, 23 USPQ2d 1174, 1178 (3d Cir. 1992) ("[W]e decline to adopt the position espoused by the Second Circuit that telephone numbers which correlate to generic terms may be protectible as trademarks.... If telephone numbers that correlate to generic terms were granted protection, the first firm in a given market to obtain such a telephone number would, merely by winning the race to the telephone company, gain an unfair advantage over its competitors.") (footnotes omitted); *800 Spirits Inc. v. Liquor By Wire, Inc.*, 14 F. Supp. 2d 675 (D.N.J. 1998) (800 SPIRITS generic for "gift delivery service of alcohol beverages").

1209.03(m) Domain Names

A mark comprised of an Internet domain name is registrable as a trademark or service mark only if it functions as an identifier of the source of goods or services. Portions of the uniform resource locator ("URL"), including the beginning, ("http://www.") and the top-level Internet domain name ("TLD") (e.g., ".com," ".org," ".edu,") function to indicate an address on the World Wide Web, and, therefore, generally serve no source-indicating function. *See* **TMEP §§1215** *et seq*. for further information.

The TLD typically signifies the type of entity using the domain name. For example, the TLD ".com" signifies to the public that the user of the domain name constitutes a commercial entity, ".edu" signifies an educational institution, ".biz" signifies a business, and ".org" signifies a non-commercial organization. TLDs designated for types of entities using the TLDs should be treated as non-source-indicating. As the number of available TLDs is increased by the Internet Corporation for Assigned

Names and Numbers ("ICANN"), or if the nature of new TLDs changes, the examining attorney must consider any potential source-indicating function of the TLD and introduce evidence as to the significance of the TLD. *See* www.icann.org for information about TLDs.

Because TLDs generally serve no source-indicating function, their addition to an otherwise unregistrable mark typically cannot render it registrable. *In re 1800MATTRESS.COM IP LLC,* 586 F.3d 1359, 92 USPQ2d 1682 (Fed. Cir. 2009) (MATTRESS.COM generic for "online retail store services in the field of mattresses, beds, and bedding"); *In re Hotels.com, L.P.,* 573 F.3d 1300, 91 USPQ2d 1532 (Fed. Cir. 2009) (HOTELS.COM generic for "providing information for others about temporary lodging; [and] travel agency services, namely, making reservations and bookings for temporary lodging for others by means of telephone and the global computer network"); *In re Reed Elsevier Properties Inc.,* 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007) (LAWYERS.COM generic for "providing an online interactive database featuring information exchange in the fields of law, legal news and legal services"); *In re Oppedahl & Larson LLP,* 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004) (PATENTS.COM merely descriptive of computer software for managing a database of records and for tracking the status of the records by means of the Internet); *In re Eddie Z's Blinds and Drapery, Inc.*, 74 USPQ2d 1037 (TTAB 2005) (BLINDSANDDRAPERY.COM generic for retail store services featuring blinds, draperies and other wall coverings, sold via the Internet); *In re Microsoft Corp.,* 68 USPQ2d 1195, 1203 (TTAB 2003) ("The combination of the specific term and TLD at issue, i.e., OFFICE and .NET, does not create any double entendre, incongruity, or any other basis upon which we can find the composite any more registrable than its separate elements. The combination immediately informs prospective purchasers that the software includes 'office suite' type software and is from an Internet business, i.e., a '.net' type business."); *In re CyberFinancial.Net, Inc*., 65 USPQ2d 1789, 1792 (TTAB 2002) ("Applicant seeks to register the generic term 'bonds,' which has no source-identifying significance in connection with applicant's services, in combination with the top level domain indicator ".com," which also has no source-identifying significance. And combining the two terms does not create a term capable of identifying and distinguishing applicant's services."); *In re Martin Container, Inc.*, 65 USPQ2d 1058, 1061 (TTAB 2002) ("[N]either the generic term nor the domain indicator has the capability of functioning as an indication of source, and combining the two does not result in a compound term that has somehow acquired this capability.").

Only in rare instances will the addition of a TLD indicator to a descriptive term operate to create a distinctive mark. There is no bright-line, per se rule that the addition of a TLD to an otherwise descriptive mark will never, under any circumstances, operate to create a registrable mark. If the TLD is capable of indicating a source, the addition of the source-indicating TLD to an otherwise unregistrable mark may render it registrable.

> *Example*: The addition of the TLD ".PETER" to CLOTHES to form the mark CLOTHES.PETER *would* create a registrable mark.

Additionally, the Federal Circuit has cautioned that in rare, exceptional circumstances, a term that is not distinctive by itself may acquire some additional meaning from the addition of a non-source-indicating TLD such as ".com" or ".net." *In re Steelbuilding.com,* 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005) (STEELBUILDING.COM for "computerized on line retail services in the field of pre-engineered metal buildings and roofing systems" held highly descriptive, but not generic), citing *Oppedahl & Larson,* 373 F.3d at 1175-1176, 71 USPQ2d at 1373.

Thus, when examining domain name marks, it is important to evaluate the commercial impression of the mark as a whole to determine whether the composite mark conveys any distinctive source-identifying impression apart from its individual components. The examining attorney should introduce evidence as to the significance of the individual components, including the TLD, but must also consider the significance of the composite to determine whether the addition of a TLD has resulted in a mark that conveys a source-identifying impression. *See In re 1800Mattress.com, supra* (affirming Board's conclusion that MATTRESS.COM was generic, where the Board considered each of the constituent words "mattress" and ".com" and determined that they were both generic, then considered the mark as a whole and determined that the combination added no new meaning, relying on the prevalence of the term "mattress.com" in the website addresses of several online mattress retailers who provide the same services as the applicant); *In re Hotels.com, supra* (HOTELS.COM found generic, where the record contained various definitions of "hotel," printouts from hotel reservation search websites showing 'hotels" as the equivalent of or included within "temporary lodging," as well as evidence from applicant's website); *In re DNI Holdings Ltd.*, 77 USPQ2d 1435 (TTAB 2005) (SPORTSBETTING.COM held generic for "provision of casino games on and through a global computer network wherein there are no actual monetary wagers; provision of contests and sweepstakes on and through a global computer network; [and] providing a web site on and through a global computer network featuring information in the fields of gaming, athletic competition and entertainment....").

See **TMEP §§1215.04** and **1215.05** for further discussion of TLDs combined with descriptive or generic terminology.

1209.03(n) "America" or "American"

If "AMERICA" or "AMERICAN" appears in a phrase or slogan, the examining attorney must evaluate the entire mark to determine whether it is merely descriptive as laudatory or even incapable. *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53

USPQ2d 1056 (Fed. Cir. 1999) (THE BEST BEER IN AMERICA so highly laudatory and descriptive as applied to beer and ale that it is incapable of acquiring distinctiveness); *In re Carvel Corp.*, 223 USPQ 65 (TTAB 1984) (AMERICA'S FRESHEST ICE CREAM held incapable); *In re Wileswood, Inc.*, 201 USPQ 400 (TTAB 1978) (AMERICA'S FAVORITE POPCORN held merely descriptive). Typically, these marks primarily extol the quality or popularity of the goods or services and secondarily denote geographic origin. The examining attorney must look at each mark to determine whether it is capable, considering all relevant circumstances and case law.

See **TMEP §1210.02(b)(iv)** and cases cited therein regarding use of terms such as "AMERICA," "AMERICAN," and "USA" in a way that is primarily geographically descriptive under 15 U.S.C. §1052(e)(2), primarily geographically deceptively misdescriptive under 15 U.S.C. §1052(e)(3), or deceptive under 15 U.S.C. §1052(a).

1209.03(o) "National," "International," "Global," and "Worldwide"

The terms "NATIONAL" and "INTERNATIONAL" have been held to be merely descriptive of services that are nationwide or international in scope. *See Jefferson Bankshares Inc. v. Jefferson Savings Bank*, 14 USPQ2d 1443 (W.D. Va. 1989) (NATIONAL BANK merely descriptive of banking services); *National Automobile Club v. National Auto Club, Inc*., 365 F. Supp. 879, 180 USPQ 777 (S.D.N.Y. 1973), *aff'd,* 502 F.2d 1162 (2d Cir. 1974) (NATIONAL merely descriptive of auto club services); *In re Institutional Investor, Inc*., 229 USPQ 614 (TTAB 1986) (INTERNATIONAL BANKING INSTITUTE for organizing seminars for bank leaders of major countries held incapable); *In re Billfish Int'l Corp*., 229 USPQ 152 (TTAB 1986) (BILLFISH INTERNATIONAL CORPORATION merely descriptive of corporation involved with billfish on an international scale); *In re National Rent A Fence, Inc*., 220 USPQ 479 (TTAB 1983) (NATIONAL RENT A FENCE merely descriptive of nationwide fence rental services); *BankAmerica Corp. v. International Travelers Cheque Co*., 205 USPQ 1233 (TTAB 1979) (INTERNATIONAL TRAVELERS CHEQUE merely descriptive of financial consulting services that are international in scope); *National Fidelity Life Insurance v. National Insurance Trust*, 199 USPQ 691 (TTAB 1978) (NATIONAL INSURANCE TRUST merely descriptive of services of handling administrative matters in locating suitable insurance coverage for attorneys).

The terms "GLOBAL" and "WORLDWIDE" are also considered to be merely descriptive of services that are global or worldwide in scope.

1209.03(p) Function or Purpose

Terms that identify the function or purpose of a product or service may be merely descriptive under 15 U.S.C. §1052(e)(1) or generic. *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) (SCREENWIPE held generic for an anti-static cloth used for cleaning computer and television screens); *In re Box Solutions Corp.*, 79 USPQ2d 1953 (TTAB 2006) (SOLUTIONS merely descriptive of the purpose of applicant's computer hardware – to resolve a problem – and must be disclaimed); *In re Hunter Fan Co.,* 78 USPQ2d 1474 (TTAB 2006) (ERGONOMIC held merely descriptive of ceiling fans); *In re Central Sprinkler Co.,* 49 USPQ2d 1194 (TTAB 1998) (ATTIC generic for sprinklers installed primarily in attics); *In re Reckitt & Colman, North America Inc.*, 18 USPQ2d 1389 (TTAB 1991) (PERMA PRESS generic for soil and stain removers for use on permanent press products); *In re Wallyball, Inc*., 222 USPQ 87 (TTAB 1984) (WALLYBALL held descriptive of sports clothing and game equipment); *In re National Presto Industries, Inc.,* 197 USPQ 188 (TTAB 1977) (BURGER held merely descriptive of cooking utensils); *In re Orleans Wines, Ltd*., 196 USPQ 516 (TTAB 1977) (BREADSPRED held merely descriptive of jams and jellies).

1209.03(q) Source or Provider of Goods or Services

Terms that identify the source or provider of a product or service may be merely descriptive under 15 U.S.C. §1052(e)(1) or generic. *In re Major League Umpires,* 60 USPQ2d 1059 (TTAB 2001) (MAJOR LEAGUE UMPIRE merely descriptive of clothing, face masks, chest protectors, and skin guards); *In re Taylor & Francis [Publishers] Inc.*, 55 USPQ2d 1213 (TTAB 2000) (PSYCHOLOGY PRESS merely descriptive of books in the field of psychology); *In re The Paint Products Co.,* 8 USPQ2d 1863 (TTAB 1988) (PAINT PRODUCTS COMPANY incapable for paint); *In re The Phone Co., Inc.,* 218 USPQ 1027 (TTAB 1983) (THE PHONE COMPANY merely descriptive of telephones).

1209.03(r) Retail Store and Distributorship Services

A term that is generic for goods is descriptive of retail store services featuring those goods, when the goods are not a significant item typically sold in the type of store in question. *In re Pencils Inc.,* 9 USPQ2d 1410 (TTAB 1988) (PENCILS held merely descriptive of office supply store services). However, where the matter sought to be registered identifies the primary articles of a store or distributorship service, the term is considered generic. *In re Tires, Tires, Tires, Inc*., 94 USPQ2d 1153, (TTAB 2009) (TIRES TIRES TIRES generic for retail tire store services); *In re Lens.com, Inc.*, 83 USPQ2d 1444 (TTAB 2007) (LENS generic for "retail store services featuring contact eyewear products rendered via a global computer network"); *In re Eddie Z's Blinds and Drapery, Inc.*, 74 USPQ2d 1037 (TTAB 2005) (BLINDSANDDRAPERY.COM generic for retail store services featuring blinds, draperies, and other wall coverings, conducted via the Internet); *In re Candy Bouquet Int'l, Inc.*, 73

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USPQ2d 1883 (TTAB 2004) (CANDY BOUQUET generic for "retail, mail, and computer order services in the field of gift packages of candy"); *In re A La Vieille Russie, Inc.*, 60 USPQ2d 1895 (TTAB 2001) (RUSSIANART generic for dealership services in the field of fine art, antiques, furniture, and jewelry); *In re Log Cabin Homes Ltd.*, 52 USPQ2d 1206 (TTAB 1999) (LOG CABIN HOMES generic for retail outlets selling kits for building log homes); *In re Bonni Keller Collections Ltd.,* 6 USPQ2d 1224 (TTAB 1987) (LA LINGERIE generic for retail stores specializing in the sale of lingerie); *In re Wickerware, Inc*., 227 USPQ 970 (TTAB 1985) (WICKERWARE generic for mail order and distributorship services in the field of products made of wicker); *In re Half Price Books, Records, Magazines, Inc.*, 225 USPQ 219 (TTAB 1984) (HALF PRICE BOOKS RECORDS MAGAZINES generic for retail book and record store services).

The examining attorney, therefore, must analyze the term in relation to the services recited, the context in which it is used and the possible significance it would have to the recipient of the services. *Pencils,* 9 USPQ2d at 1411.

1209.03(s) Slogans

Slogans that are considered to be merely informational in nature, or to be common laudatory phrases or statements that would ordinarily be used in business or in the particular trade or industry, are not registrable. *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (THE BEST BEER IN AMERICA so highly laudatory and descriptive as applied to beer and ale that it is incapable of acquiring distinctiveness). *See* **TMEP §1202.04** and cases cited therein.

1209.03(t) Repetition of Descriptive or Generic Term

The mere repetition of a merely descriptive term does not negate the mere descriptiveness of the mark as a whole, unless the combination is such as to create a new and different commercial impression from that which is engendered by the separate components. *See In re Litehouse, Inc.*, 82 USPQ2d 1471 (TTAB 2007) (CAESAR! CAESAR! merely descriptive of salad dressing); *In re Disc Jockeys, Inc*., 23 USPQ2d 1715 (TTAB 1992) (DJDJ merely descriptive of disc jockey services).

Likewise, a generic term may not be rendered non-generic simply by repeating the term. In finding TIRES TIRES TIRES generic for retail tire store services, the Board held that "[t] here is no valid reason to require an examining attorney to demonstrate that a designation composed solely of a repeating word has been used by others, when the examining attorney has demonstrated that the repeated term is generic and that the repetition does not result in a designation with a different meaning." *In re Tires, Tires, Tires, Inc*., 94 USPQ2d 1153 (TTAB 2009).

1209.03(u) Punctuation

The use of a common punctuation mark is not sufficient to negate the mere descriptiveness of a term. *See In re Litehouse, Inc.*, 82 USPQ2d 1471 (TTAB 2007) (CAESAR! CAESAR! merely descriptive of salad dressing); *In re Vanilla Gorilla, L.P.*, 80 USPQ2d 1637 (TTAB 2006) (presence of punctuation mark (a hyphen) in the mark "3-0's" does not negate mere descriptiveness of mark for automobile wheel rims); *In re Promo Ink*, 78 USPQ2d 1301 (TTAB 2006) (PARTY AT A DISCOUNT! merely descriptive of preparation and dissemination for others of advertising and promotional matter via global computer communications networks in the field of shopping for goods and services); *In re S.D. Fabrics, Inc.*, 223 USPQ 54 (TTAB 1984) (presence of slash in the mark "designers/fabric" does not negate mere descriptiveness of mark for retail store services in field of fabrics); *In re Brock Residence Inns, Inc.*, 222 USPQ 920 (TTAB 1984) (FOR A DAY, A WEEK, A MONTH OR MORE! merely descriptive of hotel services); *In re Wileswood, Inc.*, 201 USPQ 400 (TTAB 1978) (AMERICA'S BEST POPCORN! and AMERICA'S FAVORITE POPCORN! merely descriptive of unpopped popcorn); *In re Samuel Moore & Co.*, 195 USPQ 237 (TTAB 1977) (SUPERHOSE! merely descriptive of hydraulic hose made of synthetic resinous material).

1209.04 Deceptively Misdescriptive Marks

Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), also prohibits registration of designations that are deceptively misdescriptive of the goods or services to which they are applied. The examining attorney must consider the mark in relation to the applicant's goods or services to determine whether a mark is deceptively misdescriptive.

The examining attorney must first determine whether a term is misdescriptive as applied to the goods or services. A term that conveys an immediate idea of an ingredient, quality, characteristic, function, or feature of the goods or services with which it is used is merely descriptive. *See* **TMEP §1209.01(b).** If a term immediately conveys such an idea but the idea is false, although plausible, then the term is deceptively misdescriptive and is unregistrable under §2(e)(1). *See In re Woodward & Lothrop Inc.*, 4 USPQ2d 1412 (TTAB 1987) (CAMEO deceptively misdescriptive of jewelry); *In re Ox-Yoke Originals, Inc.*, 222 USPQ 352 (TTAB 1983) (G.I. deceptively misdescriptive of gun cleaning patches, rods, brushes, solvents, and oils).

The Trademark Act does not prohibit the registration of misdescriptive terms unless they are deceptively misdescriptive, that is, unless persons who encounter the mark, as used on or in connection with the goods or services in question, are likely to believe the misrepresentation. *See Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003 (TTAB 1984) (LIQUID CRAYON held neither common descriptive name, nor merely descriptive, nor deceptively misdescriptive of coloring kits or

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markers).

As explained in the case of *In re Quady Winery Inc.*, 221 USPQ 1213, 1214 (TTAB 1984):

> The test for deceptive misdescriptiveness has two parts. First we must determine if the matter sought to be registered misdescribes the goods. If so, then we must ask if it is also deceptive, that is, if anyone is likely to believe the misrepresentation. *Gold Seal Co. v. Weeks,* 129 F. Supp. 928 (D.D.C. 1955), *aff'd sub nom. S.C. Johnson & Son v. Gold Seal Co.*, 230 F.2d 832 (D.C. Cir.) (*per curiam*), *cert. denied*, 352 U.S. 829 (1956), *superseded by statute on other grounds as stated in Aktieselskabet AF 21. November 2001 v. Fame Jeans Inc.,* 525 F.3d 8, 86 USPQ2d 1527, 1532 (D.C. Cir. 2008). A third question, used to distinguish between marks that are deceptive under Section 2(a) and marks that are deceptively misdescriptive under Section 2(e)(1), is whether the misrepresentation would materially affect the decision to purchase the goods. *Cf. In re House of Windsor, Inc.*, 221 USPQ 53 (TTAB 1983).

Thus, if the identification of goods/services does not include the wording in the mark, the examining attorney must make of record evidence demonstrating why the mark is misdescriptive. Specifically, the record should show the meaning of the wording at issue and that the identification indicates that the applicant's goods/services lack the feature or characteristic. Examples of such evidence are dictionary definitions, LexisNexis® articles, Internet websites, advertising material, product information sheets, hang tags, point-of-purchase displays, and trade journals. The applicant's admission regarding its goods/services may also satisfy the first prong of the test.

The examining attorney must then prove that the description conveyed by the mark is plausible by demonstrating that consumers regularly encounter goods or services that contain the features or characteristics in the mark. For example, to support the believability element as to the mark LOVEE LAMB for seat covers that were not made of lambskin, the examining attorney provided evidence that seat covers can be and are made from lambskin. *See In re Budge Mfg. Co. Inc.,* 857 F.2d 773, 775, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988). Excerpts from a LexisNexis® search for the phrases "organic clothing," "organic fabric," "organically grown cotton," and "organic cotton" were used to prove that consumers were familiar with clothing and textiles from organically grown plants or plants free of chemical processing or treatment. *See In re Organik Technologies, Inc.,* 41 USPQ2d 1690 (TTAB 1997). Applicant's own hang tags, labels, advertising, and product information may also provide evidence of the believability of the misdescription. *See In re Shapely, Inc.,* 231 USPQ 72, 75 (TTAB 1986); *Evans Products Co. v. Boise Cascade Corp.,* 218 USPQ 160, 165 (TTAB 1983).

If the misdescription represented by the mark is material to the decision to purchase the goods or use the services, then the mark should be refused registration under §2(a) of the Trademark Act, 15 U.S.C. §1052(a). *See* **TMEP §1203.02** regarding deceptive marks, **TMEP §1203.02(c)** regarding the distinction between deceptive marks and deceptively misdescriptive marks, and **TMEP §§1203.02(d)** *et seq*. regarding determining materiality.

The examining attorney should consider and make of record, or require the applicant to make of record, all available information that shows the presence or absence, and the materiality, of a misrepresentation. *See Glendale Int'l Corp. v. United States Patent and Trademark Office*, *374 F. Supp. 2d 479*, 75 USPQ2d 1139 (E.D. VA 2005) (TITANIUM deceptively misdescriptive of recreational vehicles that do not contain titanium, where the examining attorney made of record articles which showed that titanium is a lightweight metal, and discussed the use or potential use of titanium in the automotive industry).

The mere fact that the true nature of the goods or services is revealed by other matter on the labels, advertisements, or other materials to which the mark is applied does not preclude a determination that a mark is deceptively misdescriptive. *See R. Neumann & Co. v. Overseas Shipments, Inc.*, 326 F.2d 786, 140 USPQ 276 (C.C.P.A. 1964) (DURA-HYDE held deceptive and deceptively misdescriptive of plastic material of leather-like appearance made into shoes); *In re Shniberg*, 79 USPQ2d 1309 (TTAB 2006) (SEPTEMBER 11, 2001 held deceptively misdescriptive of books and entertainment services which did not in any way cover the terrorist attacks of September 11, 2001; the fact that the nature of the misdescription would become known after consumers studied applicant's books and entertainment services does not prevent the mark from being deceptively misdescriptive).

See also Northwestern Golf Co. v. Acushnet Co., 226 USPQ 240 (TTAB 1985); *R.J. Reynolds Tobacco Co. v. Brown & Williamson Tobacco Corp.*, 226 USPQ 169 (TTAB 1985); and *American Speech-Language-Hearing Ass'n v. National Hearing Aid Society*, 224 USPQ 798 (TTAB 1984) regarding the issue of deceptive misdescriptiveness.

Marks that have been refused registration pursuant to §2(e)(1) on the ground of deceptive misdescriptiveness may be registrable under §2(f) upon a showing of acquired distinctiveness, or on the Supplemental Register if appropriate. 15 U.S.C. §§1052(f) and 1091. Marks that are deceptive under §2(a) are not registrable on either the Principal Register or the Supplemental Register under any circumstances.

1210 Refusal on Basis of Geographic Significance

> *Extract from 15 U.S.C. §1052. No trademark by which the goods of the applicant may be distinguished from the goods of*

others shall be refused registration on the principal register on account of its nature unless it–

(a) Consists of or comprises ... deceptive ... matter;… or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after [January 1, 1996].

...

(e) Consists of a mark which ... (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 4, (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them....

Section 2(e)(2) of the Trademark Act, 15 U.S.C. §1052(e)(2), prohibits registration on the Principal Register of a mark that is primarily geographically descriptive of the goods or services named in the application. *See* **TMEP §1210.01(a).**

Section 2(e)(3) of the Trademark Act, 15 U.S.C. §1052(e)(3), prohibits registration of a mark that is primarily geographically deceptively misdescriptive of the goods or services named in the application. *See* **TMEP §1210.01(b).** Prior to the amendment of the Trademark Act on January 1, 1994, by the North American Free Trade Agreement ("NAFTA") Implementation Act, Public Law 103-182, 107 Stat. 2057, the statutory basis for refusal to register primarily geographically deceptively misdescriptive marks was §2(e)(2).

Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), prohibits registration of a designation that consists of or comprises deceptive matter, as well as geographical indications which, when used on or in connection with wines or spirits, identify a place other than the origin of the goods. *See* **TMEP §§1210.01(c)** and **1210.08.**

See **TMEP §1210.05(c)** regarding the distinction between marks that are primarily geographically deceptively misdescriptive under §2(e)(3) and marks that are deceptive under §2(a).

1210.01 Elements

1210.01(a) Geographically Descriptive Marks – Test

To establish a prima facie case for refusal to register a mark as primarily geographically descriptive, the examining attorney must show that:

(1) the primary significance of the mark is a generally known geographic location (*see* **TMEP §§1210.02** *et seq*.);

(2) the goods or services originate in the place identified in the mark (*see* **TMEP §1210.03)**; and

(3) purchasers would be likely to believe that the goods or services originate in the geographic place identified in the mark (*see* **TMEP §§1210.04** *et seq.*). *Note*: If the mark is remote or obscure, the public is unlikely to make a goods/place or services/place association (*see* **TMEP §1210.04(c)).**

1210.01(b) Geographically Deceptively Misdescriptive Marks – Test

To support a refusal to register a mark as primarily geographically deceptively misdescriptive, the examining attorney must show that:

(1) the primary significance of the mark is a generally known geographic location (*see* **TMEP §§1210.02** *et seq*.);

(2) the goods or services do not originate in the place identified in the mark (*see* **TMEP §1210.03)**;

(3) purchasers would be likely to believe that the goods or services originate in the geographic place identified in the mark (*see* **TMEP §§1210.04** *et seq*.). *Note*: If the mark is remote or obscure, the public is unlikely to make a goods/place or services/place association (*see* **TMEP §1210.04(c))**; and

(4) the misrepresentation is a material factor in a significant portion of the relevant consumer's decision to buy the goods or use the services (*see* **TMEP §§1210.05(c)** *et seq*.).

In re Spirits Int'l, N.V., 563 F.3d 1347, 90 USPQ2d 1489, 1495 (Fed. Cir. 2009); *In re Les Halles De Paris J.V.,* 334 F.3d 1371, 67 USPQ2d 1539 (Fed. Cir. 2003); *In re California Innovations Inc.,* 329 F.3d 1334, 66 USPQ2d 1853 (Fed. Cir. 2003), *reh'g denied*, 2003 U.S. App. LEXIS 18883 (Fed. Cir. Aug. 20, 2003).

Prior to the amendment of the Trademark Act by the NAFTA Implementation Act, it was not necessary to show that the misrepresentation was likely to be a material factor in the consumer's decision to buy the goods or use the services in order to establish that a mark was primarily geographically deceptively misdescriptive. However, in *California Innovations,* the Court of

Appeals for the Federal Circuit held that in view of the NAFTA amendments, a showing of public deception is required to establish that a mark is unregistrable under §2(e)(3).

See **TMEP §1210.05(c)** for further information regarding the distinction between marks comprising deceptive matter under §2(a) and marks comprising primarily geographically deceptively misdescriptive matter under §2(e)(3), and **TMEP §§1210.05(c)** *et seq*. regarding the showing that a misrepresentation of the origin of the goods or services is likely to affect the purchaser's decision to buy the goods or use the services.

1210.01(c) Geographically Deceptive Marks – Test

As noted in **TMEP §1210.05(a)**, the test for determining whether a mark is primarily geographically deceptively misdescriptive under §2(e)(3) is the same as the test for determining whether a mark is deceptive under §2(a). To support a refusal of registration on the ground that a geographic term is deceptive under §2(a), the examining attorney must show that:

(1) the primary significance of the mark is a generally known geographic location (*see* **TMEP §§1210.02** *et seq*.);

(2) the goods or services do not originate in the place named in the mark (*see* **TMEP §1210.03)**;

(3) purchasers would be likely to believe that the goods or services originate in the geographic place identified in the mark (*see* **TMEP §§1210.04** *et seq*.). *Note*: If the mark is remote or obscure, the public is unlikely to make a goods/place or services/place association (*see* **TMEP §1210.04(c))**; and

(4) the misrepresentation is a material factor in a significant portion of the relevant consumer's decision to buy the goods or use the services (*see* **TMEP §§1210.05(c)** *et seq*.).

In re Spirits Int'l, N.V., 563 F.3d 1347, 90 USPQ2d 1489, 1495 (Fed. Cir. 2009); *Institut Nat'l des Appellations D'Origine v. Vintners Int'l Co., Inc.*, 958 F.2d 1574, 1580, 22 USPQ2d 1190, 1195 (Fed. Cir. 1992); *In re House of Windsor, Inc.*, 221 USPQ 53 (TTAB 1983), *recon. denied*, 223 USPQ 191 (TTAB 1984). *See also In re California Innovations Inc.,* 329 F.3d 1334, 66 USPQ2d 1853 (Fed. Cir. 2003), *reh'g denied,* 2003 U.S. App. LEXIS 18883 (Fed. Cir. Aug. 20, 2003).

See **TMEP §1210.05(a)** for further information regarding the distinction between marks comprising deceptive matter under §2(a) and marks comprising primarily geographically deceptively misdescriptive matter under §2(e)(3), and **TMEP §§1210.05(c)** *et seq*. regarding the showing that a misrepresentation of the origin of the goods or services is likely to affect the purchaser's decision to buy the goods or use the services.

1210.02 Primarily Geographic Significance

A mark is primarily geographic if it identifies a real and significant geographic location, and the primary meaning of the mark is the geographic meaning.

1210.02(a) Geographic Locations

A geographic location may be any term identifying a country, city, state, continent, locality, region, area, or street.

Region. A particular, identifiable region (e.g., "Midwest" or "Mid-Atlantic") is a geographic location. *In re Pan-O-Gold Baking Co.,* 20 USPQ2d 1761 (TTAB 1991) (primary significance of "New England" is geographic). On the other hand, vague geographic terms (e.g., "Global," "National," "International," or "World") are *not* considered to be primarily geographic, though they may be merely descriptive or deceptively misdescriptive under §2(e)(1). *See* **TMEP §1209.03(o).**

Nicknames. A geographic nickname (e.g., "Big Apple" or "Motown"), or an abbreviation or other variant of the name of a geographic location, is treated the same as the actual name of the geographic location, if it is likely to be perceived as such by the purchasing public. *See In re Spirits of New Merced, LLC*, 85 USPQ2d 1614 (TTAB 2007) (Board found that "Yosemite" - a well recognized and frequently used shorthand reference to Yosemite National Park and the Yosemite region in general - conveys a readily recognizable geographic significance); *In re Carolina Apparel,* 48 USPQ2d 1542 (TTAB 1998) (CAROLINA APPAREL primarily geographically descriptive of retail clothing store services, where the evidence showed that "Carolina" is used to indicate either the state of North Carolina or the state of South Carolina). *Cf. In re Trans Continental Records, Inc.*, 62 USPQ2d 1541 (TTAB 2002) (O-TOWN found to be a "relatively obscure term" that would *not* be perceived by a significant portion of the purchasing public as a geographic reference to Orlando, Florida).

Adjectives. The adjectival form of the name of a geographic location is considered primarily geographic if it is likely to be perceived as such by the purchasing public. *See In re Joint-Stock Co. "Baik,"* 80 USPQ2d 1305 (TTAB 2006) (BAIKALSKAYA – the Russian equivalent of "from Baikal" or "Baikal's" – held primarily geographically descriptive of vodka); *In re Jack's Hi-Grade Foods, Inc.*, 226 USPQ 1028 (TTAB 1985) (NEAPOLITAN held primarily geographically deceptively misdescriptive of sausage emanating from the United States, where the term is defined as "of or pertaining to Naples in Italy"); *American Paper & Plastic Products, Inc. v. American Automatic Vending Corp.*, 152 USPQ 117 (TTAB 1966) (AMERICAN AUTOMATIC VENDING held

primarily geographically descriptive).

Maps. A map or outline of a geographic area is also treated the same as the actual name of the geographic location if it is likely to be perceived as such. *See In re Canada Dry Ginger Ale, Inc.*, 86 F.2d 830, 32 USPQ 49 (C.C.P.A. 1936) (map of Canada held to be the equivalent of the word "Canada"). *Cf. In re Texsun Tire and Battery Stores, Inc.*, 229 USPQ 227 (TTAB 1986) (indicating that if the depiction of a map is fanciful or so integrated with other elements of a mark that it forms a unitary whole, then the map should not be considered primarily geographically descriptive).

Coined Locations. The mere fact that a term may be the name of a place that has a physical location does not necessarily make that term geographic under §2(e)(2). For example, names of amusement parks, residential communities, and business complexes which are coined by the applicant, should not be refused. *In re Pebble Beach Co*., 19 USPQ2d 1687 (TTAB 1991) (17 MILE DRIVE not a geographic term, where it refers to a specific location wholly owned by applicant, and was coined by applicant to refer both to applicant's services and the place where the services were performed).

1210.02(b) Primary Significance

To support a refusal to register geographic matter, the Trademark Act requires that the mark be *primarily* geographic, that is, that its primary significance be that of a geographic location. 15 U.S.C. §§1052(e)(2) and (3). *See, e.g., In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999) (primary significance of NEW YORK held to be geographic; Court was not persuaded by assertions that the composite NEW YORK WAYS GALLERY evokes a gallery that features New York "ways" or "styles"); *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987) (evidence insufficient to establish that public in United States would perceive VITTEL as the name of a place where cosmetic products originate; Vittel, France found to be obscure); *In re Cheezwhse.com, Inc.*, 85 USPQ2d 1917 (TTAB 2008) (NORMANDIE CAMEMBERT ("CAMEMBERT" disclaimed) held primarily geographically descriptive of cheese because NORMANDIE is the French spelling for Normandy, consumers would recognize NORMANDIE as the equivalent of Normandy, the primary significance of Normandy is a known geographic place in France, and CAMEMBERT is generic for applicant's goods; Board was not persuaded that the primary significance of NORMANDIE was the ocean liner SS Normandie); *In re Cotter & Co.*, 228 USPQ 202 (TTAB 1985) (the primary significance of WESTPOINT is as the name of the United States Military Academy rather than the town in New York).

The fact that the proposed mark has meaning or usage other than as a geographic term does not necessarily alter its primarily geographic significance. *See* **TMEP §§1210.02(b)(i)** *et seq*.

When a geographic term is combined with additional matter (e.g., wording and/or a design element), the examining attorney must determine the primary significance of the composite. *See* **TMEP §§1210.02(c)** *et seq*.

See **TMEP §1210.04(c)** regarding obscure or remote geographic marks.

1210.02(b)(i) Other Meanings

The fact that the mark has meaning or usage other than as a geographic term does not necessarily alter its primarily geographic significance. Thus, if a geographic term has another meaning, the examining attorney must determine whether the *primary* significance is geographic. If so, registration should be refused under §2(e)(2), §2(e)(3), or §2(a). *See, e.g., In re Opryland USA Inc.*, 1 USPQ2d 1409 (TTAB 1986) (THE NASHVILLE NETWORK held primarily geographically descriptive of television program production and distribution services, the Board finding that the primary significance of the term was Nashville, Tennessee, and not that of a style of music); *In re Cookie Kitchen, Inc.*, 228 USPQ 873, 874 (TTAB 1986) (the fact that MANHATTAN identifies an alcoholic cocktail does not alter the primary significance of that term as a borough of New York City); *In re Jack's Hi-Grade Foods, Inc.*, 226 USPQ 1028, 1029 (TTAB 1985) (the fact that NEAPOLITAN identifies, among other things, a type of ice cream, does not alter the primary significance of that term as meaning "of or pertaining to Naples in Italy").

However, if the most prominent meaning or significance of the mark is not geographic, or if the mark creates a separate readily understood meaning that is not geographic, registration should not be refused under §2(e)(2), §2(e)(3), or §2(a). *See Hyde Park Clothes, Inc. v. Hyde Park Fashions, Inc.*, 93 USPQ 250 (S.D.N.Y. 1951), *aff'd,* 204 F.2d 223, 97 USPQ 246 (2d Cir. 1953), *cert. denied*, 346 U.S. 827, 99 USPQ 491 (1953) (primary significance of HYDE PARK for men's suits is to suggest that the product is stylish or of high quality rather than to provide information about geographic origin); *In re International Taste Inc.*, 53 USPQ2d 1604, 1605-06 (TTAB 2000) (because of other prominent, significant meaning of HOLLYWOOD as referring to the entertainment industry in general, doubt about the primary significance of HOLLYWOOD was resolved in favor of the applicant); *In re Urbano*, 51 USPQ2d 1776, 1780 (TTAB 1999) (primary significance of SYDNEY 2000, used for advertising and business services and communication services, is as a reference to the Olympic Games, not to the name of a place); *In re Municipal Capital Markets Corp.,* 51 USPQ2d 1369, 1371 (TTAB 1999) (primary significance of COOPERSTOWN is that of "an institution, namely, the Baseball Hall of Fame" rather than a geographic location); *In re Jim Crockett Promotions Inc.*, 5 USPQ2d 1455 (TTAB 1987) (primary significance of THE GREAT AMERICAN BASH for promoting, producing, and presenting

professional wrestling matches, is to suggest something of desirable quality or excellence rather than to describe the geographic origin of the services); *In re Dixie Insurance Co.,* 223 USPQ 514, 516 (TTAB 1984) (DIXIE held not primarily geographically descriptive of property and casualty underwriting services, where the examining attorney provided no evidence to show that the geographical significance of DIXIE was its primary significance).

1210.02(b)(i)(A) Surname Significance

A term's geographic significance may not be its primary significance if the term also has surname significance. *Cf. In re Hamilton Pharmaceuticals Ltd.*, 27 USPQ2d 1939, 1943 (TTAB 1993) (HAMILTON held primarily merely a surname, even though the term had some geographical connotations); *In re Colt Industries Operating Corp.*, 195 USPQ 75 (TTAB 1977) (FAIRBANKS held not primarily merely a surname because the geographical significance of the mark was determined to be just as dominant as its surname significance).

1210.02(b)(ii) More Than One Geographic Location With Same Name

The fact that the mark identifies more than one geographic location does not necessarily detract from the term's primary geographic significance. *See, e.g., In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) (DURANGO held primarily geographically deceptively misdescriptive of chewing tobacco not grown in Durango, Mexico, where the evidence of record showed that tobacco is a crop produced and marketed in that area, even though there is more than one place named Durango); *In re Cambridge Digital Systems,* 1 USPQ2d 1659, 1662 (TTAB 1986) (CAMBRIDGE DIGITAL and design held primarily geographically descriptive of computer systems and parts thereof, where applicant's place of business is Cambridge, Massachusetts, even though there is more than one Cambridge).

1210.02(b)(iii) Non-Geographic Characteristics of Goods or Services

Geographic matter may serve to designate a kind or type of goods or services, or to indicate a style or design that is a feature of the goods or services, rather than to indicate their geographic origin. For example, the geographic components in terms such as "dotted swiss," "Boston baked beans," "Swiss cheese," "Early American design," and "Italian spaghetti" are not understood as indicating the geographic origin of the goods but, rather, a particular type or style of product (regardless of where the product is produced). *See Forschner Group Inc. v. Arrow Trading Co. Inc.*, 30 F.3d 348, 31 USPQ2d 1614 (2d Cir. 1994), *aff'd,* 124 F.3d 402, 43 USPQ2d 1942 (2d Cir. 1997) (SWISS ARMY KNIFE); *Institut Nat'l des Appellations D'Origine v. Vintners Int'l Co., Inc.*, 958 F.2d 1574, 1580, 22 USPQ2d 1190, 1195 (Fed. Cir. 1992) (evidence showing that Chablis is the name of a region in France insufficient to establish that CHABLIS WITH A TWIST is geographically deceptive of wine under §2(a), where evidence showed that the term "Chablis" would be perceived by consumers in the United States as the generic name for a type of wine with the general characteristics of French chablis); *Hyde Park Clothes, Inc. v. Hyde Park Fashions, Inc.*, 93 USPQ 250 (S.D.N.Y. 1951), *aff'd,* 204 F.2d 223, 97 USPQ 246 (2d Cir. 1953), *cert. denied*, 346 U.S. 827, 99 USPQ 491 (1953) (primary significance of HYDE PARK for men's suits is to suggest that the product is stylish or of high quality rather than to provide information about geographic origin).

When geographic terms are used in circumstances in which it is clear that they are meant to convey some meaning other than geographic origin, registration should not be refused on the basis of geographical descriptiveness or misdescriptiveness. However, there may be some other basis for refusal; for example, the terms may be merely descriptive or deceptively misdescriptive of the goods or services under §2(e)(1) of the Act, 15 U.S.C. §1052(e)(1). *In re MBNA America Bank, N.A*., 340 F.3d 1328, 67 USPQ2d 1778 (Fed. Cir. 2003), *reh'g denied,* 2004 U.S. App. LEXIS 2187 (Fed. Cir. Jan. 12, 2004) (MONTANA SERIES and PHILADELPHIA SERIES are merely descriptive of "credit card services featuring credit cards depicting scenes or subject matter of, or relating to" the places named in the marks); *In re Cox Enterprises Inc.*, 82 USPQ2d 1040 (TTAB 2007) (applicant's mark, THEATL, is simply a compressed version of the term "THE ATL," which is a nickname for the city of Atlanta, and is merely descriptive of the subject matter of applicant's publications); *In re Busch Entertainment Corp.*, 60 USPQ2d 1130 (TTAB 2000) (EGYPT merely descriptive of subject matter or motif of amusement park services). *See* **TMEP §§1209** *et seq*. regarding marks that are merely descriptive or deceptively misdescriptive under §2(e)(1).

In rare circumstances, it may be unclear whether the primary significance of the term is geographic or merely descriptive or deceptively misdescriptive. In such cases, the examining attorney may refuse registration on both grounds, in the alternative.

1210.02(b)(iv) "America" or "American" and Similar Terms in Marks

When terms such as "AMERICA," "AMERICAN," and "USA" appear in marks, determining whether the term or the entire mark should be considered geographic can be particularly difficult. There is no simple or mechanical answer to the question of how to treat "AMERICA" or "AMERICAN" in a mark. The examining attorney must evaluate each mark on a case-by-case basis. The examining attorney must consider the entire context, the type of goods or services at issue, the geographic origin of the goods or services and, most importantly, the overall commercial impression engendered by the mark at issue. The following

principles, developed in the case law, should provide guidance in reaching a judgment in a given case.

(1) If "AMERICA" or "AMERICAN" is used in a way that primarily denotes the United States origin of the goods or services, then the term is primarily geographically descriptive. *See, e.g., American Diabetes Ass'n, Inc. v. National Diabetes Ass'n*, 533 F. Supp. 16, 214 USPQ 231 (E.D. Pa. 1981), *aff'd,* 681 F.2d 804 (3d Cir. 1982) (AMERICAN DIABETES ASSOCIATION held primarily geographically descriptive); *In re Monograms America, Inc.,* 51 USPQ2d 1317 (TTAB 1999) (MONOGRAMS AMERICA primarily geographically descriptive of consultation services for owners of monogramming shops); *In re BankAmerica Corp.,* 231 USPQ 873 (TTAB 1986) (BANK OF AMERICA held primarily geographically descriptive); *American Paper & Plastic Products, Inc. v. American Automatic Vending Corp.*, 152 USPQ 117 (TTAB 1966) (AMERICAN AUTOMATIC VENDING held primarily geographically descriptive).

One commentator refers to such marks as exhibiting an "unadorned" use of "AMERICA" or "AMERICAN." J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §14:11 (4th ed. 2006). Many service marks (e.g., association-type marks) fall squarely into this category. *See also In re U.S. Cargo, Inc.*, 49 USPQ2d 1702 (TTAB 1998) (U.S. CARGO primarily geographically descriptive of towable trailers carrying cargo and vehicles).

(2) If a composite mark does not primarily convey geographic significance overall, or if "AMERICA" or "AMERICAN" is used in a nebulous or suggestive manner, then it is inappropriate to treat "AMERICA" or "AMERICAN" as primarily geographically descriptive. *See, e.g., Hamilton-Brown Shoe Co. v. Wolf Bros. & Co.*, 240 U.S. 251 (1916) (THE AMERICAN GIRL held not primarily geographically descriptive for shoes); *American Plan Corp. v. State Loan & Finance Corp.*, 365 F.2d 635, 150 USPQ 767 (3d Cir. 1966), *cert. denied*, 385 U.S. 1011, 152 USPQ 844 (1967) (AMERICAN PLAN CORPORATION held not primarily geographically descriptive); *Wilco Co. v. Automatic Radio Mfg. Co., Inc.,* 255 F. Supp. 625, 151 USPQ 24 (D. Mass. 1966) (ALL AMERICAN held not primarily geographically descriptive); *In re Jim Crockett Promotions Inc.*, 5 USPQ2d 1455 (TTAB 1987) (THE GREAT AMERICAN BASH held not primarily geographically descriptive of wrestling exhibitions).

The introduction of a nuance, even a subtle one, may remove a mark from the primarily geographically descriptive category. This area calls for the most difficult analysis. The examining attorney must determine whether the overall commercial impression is something other than primarily geographic – for example, due to double meanings or shades of suggestive meanings.

(3) If "AMERICA" or "AMERICAN" is used in virtually any manner with goods or services that are not from the United States, then the examining attorney should determine whether the term is primarily geographically deceptively misdescriptive under §2(e)(3) and/or deceptive under §2(a). *See, e.g., Singer Mfg. Co. v. Birginal-Bigsby Corp.*, 319 F.2d 273, 138 USPQ 63 (C.C.P.A. 1963) (AMERICAN BEAUTY held primarily geographically deceptively misdescriptive when used on Japanese-made sewing machines); *In re Biesseci S.p.A.*, 12 USPQ2d 1149 (TTAB 1989) (AMERICAN SYSTEM and design ("AMERICAN" disclaimed) held deceptive for clothing manufactured in Italy). *Cf. In re Salem China Co.*, 157 USPQ 600 (TTAB 1968) (AMERICAN LIMOGES held deceptive under §2(a) when used on china not made in Limoges, France). In this situation, even marks that arguably convey a non-geographic commercial impression must be viewed with great skepticism.

(4) If "AMERICA" or "AMERICAN" appears in a phrase or slogan, the examining attorney must evaluate the entire mark to determine whether it is merely descriptive as laudatory, or even incapable. *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (THE BEST BEER IN AMERICA so highly laudatory and descriptive as applied to beer and ale that it is incapable of acquiring distinctiveness); *In re Carvel Corp.*, 223 USPQ 65 (TTAB 1984) (AMERICA'S FRESHEST ICE CREAM held incapable); *In re Wileswood, Inc.*, 201 USPQ 400 (TTAB 1978) (AMERICA'S FAVORITE POPCORN held merely descriptive); *Kotzin v. Levi Strauss & Co.*, 111 USPQ 161 (Comm'r Pats. 1956) (AMERICA'S FINEST JEANS and AMERICA'S FINEST for overalls held not confusingly similar and incapable by inference).

Typically these marks primarily extol the quality or popularity of the goods or services and secondarily denote geographic origin. *See* **TMEP §1209.03(n)** regarding use of terms such as "AMERICA" and "AMERICAN" in a way that is merely descriptive or generic.

1210.02(c) Geographic Terms Combined With Additional Matter

A geographic composite mark is one composed of geographic matter coupled with additional matter (e.g., wording and/or a design element). When examining such a mark, the examining attorney must determine the primary significance of the composite. *See In re Save Venice New York Inc.*, 259 F.3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001) (THE VENICE COLLECTION and SAVE VENICE INC. with an image of the winged Lion of St. Mark, for various goods, held primarily geographically deceptively misdescriptive of products that do not originate in Venice, Italy); *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999) (NEW YORK WAYS GALLERY ("NEW YORK" disclaimed) held primarily geographically

deceptively misdescriptive of backpacks, handbags, purses, and similar items); *In re Bacardi & Co. Ltd.,* 48 USPQ2d 1031 (TTAB 1997) (HAVANA SELECT, HAVANA CLASICO, OLD HAVANA, HAVANA PRIMO, and HAVANA CLIPPER primarily geographically deceptively misdescriptive of rum); *In re Perry Mfg. Co.*, 12 USPQ2d 1751 (TTAB 1989) (PERRY NEW YORK and design ("NEW YORK" disclaimed) held deceptive for various items of clothing that originate in North Carolina, and have no connection with New York, because of the renown of New York in the apparel industry); *In re Biesseci S.p.A.*, 12 USPQ2d 1149 (TTAB 1989) (AMERICAN SYSTEM and design of running man, for clothing manufactured in Italy, held deceptive).

See **TMEP §§1210.06** *et seq*. regarding the procedure for examining geographic composites.

1210.02(c)(i) Two Geographic Terms Combined<

When two geographic terms are combined in the same mark, the primary significance of the composite may still be geographic, if purchasers would believe that the goods/services originate from or are rendered in both of the locations named in the mark. *See In re Narada Productions, Inc.*, 57 USPQ2d 1801, 1803 (TTAB 2001) (CUBA L.A. primarily geographically deceptively misdescriptive of musical recordings and live musical performances that do not originate in Cuba or Los Angeles, the Board finding that purchasers would understand the composite as a reference to the two places named rather than to "some mythical place called 'Cuba L.A.'"); *In re London & Edinburgh Insurance Group Ltd.,* 36 USPQ2d 1367 (TTAB 1995) (LONDON & EDINBURGH INSURANCE primarily geographically descriptive of insurance and underwriting services that are rendered or originate in the cities of London and Edinburgh).

Repeating a geographical term does not alter the geographical significance of that term. *In re Juleigh Jeans Sportswear Inc*., 24 USPQ2d 1694 (TTAB 1992) (LONDON LONDON held deceptive for clothing having no connection with London, given the renown of London as a center for contemporary as well as traditional fashions).

1210.02(c)(ii) Geographic Terms Combined With Descriptive or Generic Matter<

Generally, the addition of a highly descriptive or generic term to the name of a geographic place does not alter its primarily geographic significance. *In re Cheezwhse.com, Inc.*, 85 USPQ2d 1917 (TTAB 2008) (NORMANDIE CAMEMBERT ("CAMEMBERT" disclaimed) held primarily geographically descriptive of cheese because Normandy, France was famous for cheese and the Board presumed that the goods would originate there since applicant failed to submit information about the origin of the goods); *In re JT Tobacconists*, 59 USPQ2d 1080 (TTAB 2001) (MINNESOTA CIGAR COMPANY primarily geographically descriptive of cigars); *In re Carolina Apparel,* 48 USPQ2d 1542 (TTAB 1998) (CAROLINA APPAREL primarily geographically descriptive of retail clothing store services); *In re Chalk's Int'l Airlines Inc.*, 21 USPQ2d 1637 (TTAB 1991) (PARADISE ISLAND AIRLINES held primarily geographically descriptive of the transportation of passengers and goods by air); *In re Wine Society of America Inc.*, 12 USPQ2d 1139 (TTAB 1989) (THE WINE SOCIETY OF AMERICA held primarily geographically descriptive of wine club membership services); *In re California Pizza Kitchen Inc.,* 10 USPQ2d 1704 (TTAB 1988) (CALIFORNIA PIZZA KITCHEN ("PIZZA KITCHEN" disclaimed) held primarily geographically descriptive of restaurant services); *In re Cambridge Digital Systems,* 1 USPQ2d 1659 (TTAB 1986) (CAMBRIDGE DIGITAL and design ("DIGITAL" disclaimed) held primarily geographically descriptive of computer systems and parts thereof).

1210.02(c)(iii) Arbitrary, Fanciful, or Suggestive Composites<

If, when viewed as a whole, a composite mark would not be likely to be perceived as identifying the geographic origin of the goods or services (i.e., the mark as a whole is not primarily geographically descriptive, primarily geographically deceptively misdescriptive, or deceptive), then the mark is regarded as arbitrary, fanciful, or suggestive. *See In re Sharky's Drygoods Co.*, 23 USPQ2d 1061 (TTAB 1992) (PARIS BEACH CLUB, applied to T-shirts and sweatshirts, not deceptive under §2(a), the Board reasoning that because Paris is not located on an ocean or lake, and does not have a beach, the juxtaposition of "Paris" with "Beach Club" results in an incongruous phrase which purchasers would view as a humorous mark, a take off on the fact that Paris is known for haute couture. Thus, purchasers would not expect T-shirts and sweatshirts to originate in the city of Paris).

1210.03 Geographic Origin of the Goods or Services<

The question of whether a term is primarily geographically descriptive under §2(e)(2), primarily geographically deceptively misdescriptive under §2(e)(3), or geographically deceptive under §2(a) depends on whether the mark identifies the place from which the goods or services originate. Goods or services may be said to "originate" from a geographic location if, for example, they are manufactured, produced, or sold there. *See Fred Hayman Beverly Hills Inc. v. Jacques Bernier Inc*., 38 USPQ2d 1691 (TTAB 1996) (RODEO DRIVE held primarily geographically deceptively misdescriptive of perfume, where opposer's evidence showed that a significant number of Rodeo Drive retailers sell "prestige" fragrances, and that the public would be likely to make the requisite goods/place association between perfume and Rodeo Drive). *Cf. In re Jacques Bernier Inc.*, 894 F.2d 389, 13 USPQ2d 1725 (Fed. Cir. 1990) (RODEO DRIVE held not primarily geographically deceptively misdescriptive of perfume because of the lack of persuasive evidence of a goods/place association in the ex parte record).

A geographic designation for a large city (e.g., Washington, D.C., Boston, San Francisco) may include locations in the metropolitan area.

A wide variety of factors must be considered in determining the origin of a product or service. For example, a product might be found to originate from a place if the main component or ingredient is made in that place. *See In re Joint-Stock Co. "Baik,"* 80 USPQ2d 1305 (TTAB 2006) (BAIKALSKAYA – the Russian equivalent of "from Baikal" or "Baikal's" – held primarily geographically descriptive of vodka, where the record showed that applicant was located in Irkutsk, Russia, a city near Lake Baikal, and that applicant's vodka is made from the water of Lake Baikal).

Goods and services do not always originate in the applicant's place of business. *See In re Mankovitz*, 90 USPQ2d 1246 (TTAB 2009) (THE MONTECITO DIET held *not* primarily geographically descriptive of printed publications, on-line journals, or information services in the fields of health, nutrition, illness prevention, detoxification, and diet and lifestyle choices, the Board finding that there was "no connection between Montecito and applicant's goods and services other than applicant's address"); *In re John Harvey & Sons Ltd.,* 32 USPQ2d 1451, 1455 (TTAB 1994) (HARVEYS BRISTOL CREAM not primarily geographically descriptive of cakes flavored with sherry wine, the Board finding that neither applicant's sherry wines nor applicant's cakes come from Bristol, England, where "the only connection appears to be that applicant's headquarters are located there and that applicant's sherry wine was bottled there at one time"); *In re Nantucket Allserve Inc.*, 28 USPQ2d 1144 (TTAB 1993) (NANTUCKET NECTARS held primarily geographically descriptive of soft drinks, even though the goods were manufactured elsewhere, where the record showed that applicant's headquarters and research and development division were on Nantucket; the distributor of the goods was located on Nantucket; the goods were sold in the applicant's store on Nantucket; and the specimens were labels that bore a picture of Nantucket, stated that the goods were "born" or "created" on Nantucket, and mentioned no other geographic location); *In re Chalk's Int'l Airlines Inc.*, 21 USPQ2d 1637 (TTAB 1991) (PARADISE ISLAND AIRLINES held primarily geographically descriptive of the transportation of passengers and goods by air, because the applicant's services included flights to and from Paradise Island, Bahamas, even though the flights were not based there); *In re Fortune Star Products Corp.*, 217 USPQ 277 (TTAB 1982) (NIPPON held not deceptive of, *inter alia*, radios and televisions because, although the applicant is an American corporation, the goods are made in Japan.)

When the goods or services may be said to originate both in the geographic place named in the mark and outside that place, registration will normally be refused on the ground that the mark is primarily geographically descriptive under §2(e)(2) of the Trademark Act. *In re California Pizza Kitchen Inc.*, 10 USPQ2d 1704, 1706 n.2 (TTAB 1988) (CALIFORNIA PIZZA KITCHEN for restaurant services held primarily geographically descriptive, where the services were rendered both in California and elsewhere).

If it is unclear where the goods/services originate or will originate, the examining attorney may refuse registration under both §§2(e)(2) and 2(e)(3), in the alternative. The examining attorney must inquire where the goods/services originate or will originate, pursuant to 37 C.F.R. §2.61(b) (*see* **TMEP §814).** *See In re Cheezwhse.com, Inc.*, 85 USPQ2d 1917, 1919 (TTAB 2008), (Board affirmed alternative refusals of NORMANDIE CAMEMBERT for cheese under both §§2(e)(2) and 2(e)(3), as well as a refusal based on the applicant's failure to comply with the examining attorney's requirement for information as to the geographic origin of the goods under 37 C.F.R. §2.61(b). The Board stated that "our findings with respect to the substantive Section 2(e)(2) refusal include a presumption, unfavorable to applicant, that applicant's goods in fact originate or will originate in or from the place named in the mark. Similarly with respect to the alternative Section 2(e)(3) refusal, we alternatively presume, unfavorably to applicant, that applicant's goods do not or will not originate in or from the place named in the mark").

1210.04 Goods/Place or Services/Place Association

Refusal of registration under §2(e)(2), §2(e)(3), or §2(a) requires that there be a goods/place or services/place association such that the public is likely to believe that the goods or services originate in the place identified in the mark.

To show that there is a goods/place or services/place association, the examining attorney may provide such evidence as excerpts from telephone directories, gazetteers, encyclopedias, geographic dictionaries, the LexisNexis® database, or the results of an Internet search.

The examining attorney should also examine the specimen(s) and any other evidence in the record that shows the context in which the applicant's mark is used. *See In re Broyhill Furniture Industries, Inc.* line'>, 60 USPQ2d 1511, 1517 (TTAB 2001), where the Board noted that applicant's point of purchase display catalogs "foster a goods/place association between its furniture and Tuscany by referring to 'Europe's Mediterranean coast' and 'European sensibility;'" and *In re Nantucket Allserve Inc.*, 28 USPQ2d 1144 (TTAB 1993), where the Board noted that the applicant's product labels bore a picture of Nantucket, stated that the goods were "born" or "created" on Nantucket and "[embody] the wholesome quality of the Island whose name they bear," and mentioned no other geographic location).

When the geographic significance of a term is its primary significance and the geographic place is neither obscure nor remote, for purposes of §2(e)(2), the goods/place or services/place association may ordinarily be presumed from the fact that the

applicant's goods or services originate (*see* **TMEP §1210.03)** in or near the place named in the mark. *In re Spirits of New Merced, LLC*, 85 USPQ2d 1614 (TTAB 2007) (YOSEMITE BEER held geographically descriptive of beer produced and sold in a brewpub in Merced, California, the Board stating that "[s]ince the goods originate at or near [Yosemite National Park], we can presume an association of applicant's beer with the park."); *In re Joint-Stock Co. "Baik,"* 80 USPQ2d 1305 (TTAB 2006) (BAIKALSKAYA – the Russian equivalent of from Baikal" or "Baikal's" – held primarily geographically descriptive of vodka made from water piped from Lake Baikal, the Board presuming a goods/place association "because applicant is located near Lake Baikal, in the city of Irkutsk."); *In re JT Tobacconists*, 59 USPQ2d 1080 (TTAB 2001) (MINNESOTA CIGAR COMPANY primarily geographically descriptive of cigars); *In re U.S. Cargo, Inc.*, 49 USPQ2d 1702 (TTAB 1998) (U.S. CARGO primarily geographically descriptive of towable trailers carrying cargo and vehicles); *In re Carolina Apparel,* 48 USPQ2d 1542 (TTAB 1998) (CAROLINA APPAREL primarily geographically descriptive of retail clothing store services); *In re Chalk's Int'l Airlines Inc.*, 21 USPQ2d 1637 (TTAB 1991) (PARADISE ISLAND AIRLINES held primarily geographically descriptive of the transportation of passengers and goods by air); *In re California Pizza Kitchen Inc.,* 10 USPQ2d 1704 (TTAB 1988) (CALIFORNIA PIZZA KITCHEN held primarily geographically descriptive of restaurant services that originate in California); *In re Handler Fenton Westerns, Inc.*, 214 USPQ 848, 849-50 (TTAB 1982) (DENVER WESTERNS held primarily geographically descriptive of western-style shirts originating in Denver).

This presumption is rebuttable. *See* **TMEP §1210.04(c)** regarding obscure or remote places, and **TMEP §§1210.02** *et seq*. regarding the primary significance of a geographic term.

It is more difficult to establish a services/place association than a goods/place association when making a refusal under §§2(e)(3) and 2(a). *In re Les Halles De Paris J.V.,* 334 F.3d 1371, 67 USPQ2d 1539 (Fed. Cir. 2003). *See* **TMEP §1210.04(a)** regarding establishment of a goods/place association, and **TMEP §1210.04(b)** regarding establishment of a services/place association.

1210.04(a) Establishing Goods/Place Association

To establish a goods/place association, it is not necessary to show that the place identified in the mark is well known or noted for the goods. *In re Les Halles De Paris J.V.,* 334 F.3d 1371, 1374, 67 USPQ2d 1539, 1541 (Fed. Cir. 2003) ("[T]he goods-place association often requires little more than a showing that the consumer identifies the place as a known source of the product."). *See In re Save Venice New York Inc.*, 259 F.3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001) (THE VENICE COLLECTION and design held primarily geographically deceptively misdescriptive of products that do not originate in Venice, Italy, where an encyclopedia and a gazetteer showed that Venice was a large metropolitan area where fine art objects, glassware, and decorative items had been made and sold for centuries, and a popular tourist destination); *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999) (NEW YORK WAYS GALLERY held primarily geographically deceptively misdescriptive where manufacturing listings and Nexis® excerpts showed that handbags and luggage are designed and manufactured in New York); *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) (evidence from a gazeteer and dictionary showing that tobacco is a crop produced and marketed in Durango, Mexico held sufficient to establish a prima facie goods/place association); *In re Joint-Stock Co. "Baik,"* 80 USPQ2d 1305 (TTAB 2006) (BAIKALSKAYA held primarily geographically descriptive of vodka where record the showed that applicant is located in Irkutsk, Russia, a city near Lake Baikal and one of the main export regions of Russian vodka, applicant's vodka is made from water piped directly from Lake Baikal, Lake Baikal is the world's largest fresh water lake, and there are numerous references to "Baikal" in publications from various cities throughout the United States and in national publications); *In re Broyhill Furniture Industries, Inc.,* 60 USPQ2d 1511 (TTAB 2001) (evidence that Tuscany, Italy is an important industrial center that produces a variety of products including furniture, and that several businesses advertise the sale of furniture from Tuscany on the Internet, held sufficient to establish a goods/place association between Tuscany and furniture, even though Tuscany is not famous for its furniture); *In re Boyd Gaming Corp.*, 57 USPQ2d 1944 (TTAB 2000) (HAVANA RESORT & CASINO and ROYAL HAVANA RESORT & CASINO held primarily geographically deceptively misdescriptive of wearing apparel, beauty products and perfume that do not come from Havana, Cuba, where the record showed that Havana produces a variety of goods, including clothing and cosmetic items); *In re Bacardi & Co. Ltd.,* 48 USPQ2d 1031 (TTAB 1997) (HAVANA SELECT, HAVANA CLASICO, OLD HAVANA, HAVANA PRIMO, and HAVANA CLIPPER all held primarily geographically deceptively misdescriptive of rum that does not originate in Havana, Cuba, where the evidence showed that Havana is a major city and rum is a significant product).

In *Save Venice,* the court noted that in the modern marketing context, geographic regions that are noted for certain products or services are likely to expand from their traditional goods or services into related goods or services, and that this would be expected by consumers. Accordingly, the court held that "the registrability of a geographic mark may be measured against the public's association of that region with both its traditional goods and any related goods or services that the public is likely to believe originate there." 259 F.3d at 1355, 59 USPQ2d at 1784.

However, a showing that the geographic place is known to the public and could be the source of the goods or services may not be enough in itself to establish a goods/place or services/place association in all cases. *See In re Mankovitz*, 90 USPQ2d 1246 (TTAB 2009) (THE MONTECITO DIET held *not* primarily geographically descriptive and the evidence of a goods/place or services/place association, consisting only of the fact that the applicant lived in Montecito, found insufficient, the Board stating

that "it would be speculation on our part to reach the conclusion that the goods or services originate there or that the public would understand that there is a goods/place relationship"); *In re John Harvey & Sons Ltd.,* 32 USPQ2d 1451 (TTAB 1994) (HARVEYS BRISTOL CREAM not primarily geographically descriptive of cakes flavored with sherry wine, the Board finding evidence that applicant's headquarters are located in Bristol, England and that applicant's sherry wine was once bottled there insufficient to show that American consumers are likely to think that "Bristol" refers to a place from which the goods originate); *In re Gale Hayman Inc.*, 15 USPQ2d 1478 (TTAB 1990) (SUNSET BOULEVARD held not primarily geographically descriptive of perfume and cologne, the Board holding that the mere fact that applicant's principal offices are in Century City, close to Sunset Boulevard does not mandate a finding that a goods/place association should be presumed, determining that the public would not make a goods/place association, and noting that there was no evidence that any perfume or cologne is manufactured or produced on Sunset Boulevard or that applicant's goods are sold there); *Philip Morris Inc. v. Reemtsma Cigarettenfabriken GmbH*, 14 USPQ2d 1487 (TTAB 1990) (PARK AVENUE held neither deceptive nor geographically deceptively misdescriptive as applied to cigarettes and smoking tobacco, the Board finding no goods/place association between tobacco products and Park Avenue in New York City, on which opposer's world headquarters was located); *In re Venice Maid Co., Inc.*, 222 USPQ 618, 619 (TTAB 1984) (VENICE MAID held *not* primarily geographically deceptively misdescriptive of canned foods, including, *inter alia*, lasagna and spaghetti, where the evidence of a goods/place association was found insufficient, the Board stating that "we are unwilling to sustain the refusal to register in this case simply on the basis that Venice is a large Italian city that could, conceivably, be the source of a wide range of goods, including canned foods").

The question of whether there is a goods/place association is determined on a case-by-case basis, based on the evidence in the record. *Compare Fred Hayman Beverly Hills Inc. v. Jacques Bernier Inc*., 38 USPQ2d 1691 (TTAB 1996) (RODEO DRIVE held primarily geographically deceptively misdescriptive of perfume, where opposer's evidence showed that a significant number of Rodeo Drive retailers sell "prestige" fragrances, and that the public would be likely to make the requisite goods/place association between perfume and Rodeo Drive) *with In re Jacques Bernier Inc.*, 894 F.2d 389, 13 USPQ2d 1725 (Fed. Cir. 1990) (RODEO DRIVE held not primarily geographically deceptively misdescriptive of perfume because of the lack of persuasive evidence of a goods/place association in the ex parte record).

1210.04(b) Establishing Services/Place Association

It is more difficult, with respect to refusals under §§2(a) and 2(e)(3), to establish a services/place association than a goods/place association. The Court of Appeals for the Federal Circuit has provided the following guidance for refusals under §2(e)(3):

> Application of the second prong of this test – the services-place association – requires some consideration. A customer typically receives services, particularly in the restaurant business, at the location of the business. Having chosen to come to that place for the services, the customer is well aware of the geographic location of the service. This choice necessarily implies that the customer is less likely to associate the services with the geographic location invoked by the mark rather than the geographic location of the service, such as a restaurant. In this case, the customer is less likely to identify the services with a region of Paris when sitting in a restaurant in New York.
>
> [T]he services-place association operates somewhat differently than a goods-place association…. In a case involving goods, the goods-place association often requires little more than a showing that the consumer identifies the place as a known source of the product [citations omitted]. Thus, to make a goods-place association, the case law permits an inference that the consumer associates the product with the geographic location in the mark because that place is known for producing the product…. In the case of a services-place association, however, a mere showing that the geographic location in the mark is known for performing the service is not sufficient. Rather the second prong of the test requires some additional reason for the consumer to associate the services with the geographic location invoked by the mark. *See In re Municipal Capital Markets, Corp.,* 51 USPQ2d 1369, 1370-71 (TTAB 1999) ("Examining Attorney must present evidence that does something more than merely establish that services as ubiquitous as restaurant services are offered in the pertinent geographic location."). Thus, a services-place association in a case dealing with restaurant services … requires a showing that the patrons of the restaurant are likely to believe the restaurant services have their origin in the location indicated by the mark. In other words, to refuse registration under section 2(e)(3), the PTO must show that patrons will likely be misled to make some meaningful connection between the restaurant (the service) and the relevant place.
>
> For example, the PTO might find a services-place association if the record shows that patrons, though sitting in New York, would believe the food served by the restaurant was imported from Paris, or that the chefs in New York received specialized training in the region in Paris, or that the New York menu is identical to a known Parisian menu, or some other heightened association between the services and the relevant place….

In re Les Halles De Paris J.V., 334 F.3d 1371, 1373-74, 67 USPQ2d 1539, 1541-42 (Fed. Cir. 2003) (LE MARAIS held not primarily geographically deceptively misdescriptive of restaurant services. Evidence that "Le Marais" was a fashionable Jewish area in Paris was insufficient to establish that the public would believe that "Le Marais" was the source of New York restaurant

services featuring a kosher cuisine).

What constitutes a "heightened association" between the services and the place will vary depending on the nature of the services. There may be situations where the fact that the geographic location is known or famous for performing the service would be sufficient to establish a services/place association (e.g., "Texas" for cattle breeding services).

The burden is greater for restaurant services, due to their ubiquitous nature. In *In re Consolidated Specialty Restaurants, Inc.,* 71 USPQ2d 1921 (TTAB 2004) (COLORADO STEAKHOUSE and design held primarily geographically deceptively misdescriptive of restaurant services), the Board found that the examining attorney had established an "additional reason" why purchasers would mistakenly believe that the food served in the restaurant was from Colorado, where the record contained the following evidence: gazetteer and dictionary definitions of "Colorado" and "steakhouse;" a United States Department of Agriculture report on cattle inventory; stories excerpted from the LexisNexis® database; and Internet excerpts showing that Colorado was one of the 11 top cattle states in the United States, that Colorado was known for its steaks, that "Colorado steaks" are featured food items in restaurants outside the state, and that politicians from Colorado use "Colorado steaks" as the basis for wagers on sporting events.

1210.04(c) Obscure or Remote Geographic Marks

Geographic matter may be so obscure or remote that it would not be recognized as an indication of the geographic source of the goods or services. In such a case, the mark is treated as an arbitrary designation because its geographic meaning is likely to be lost on consumers. Thus, consumers will not perceive the geographic significance of the term as its primary significance and will not make a goods/place or services/place association. *See In re Brouwerij Nacional Balashi NV*, 80 USPQ2d 1820 (TTAB 2006) (Balashi, Aruba deemed to be so obscure or remote that purchasers in the United States would not recognize it as indicating the geographical source of applicant's beer); *ConAgra Inc. v. Saavedra*, 4 USPQ2d 1245 (TTAB 1987) (TAPATIO held not primarily geographically deceptively misdescriptive of meatless hot sauce, despite the fact that the mark is a Spanish term meaning "of or pertaining to Guadalajara, Mexico" and the goods did not originate from Guadalajara, the Board finding that the significance of the term is lost on the public because of its obscurity); *In re Bavaria St. Pauli Brauerei AG,* 222 USPQ 926 (TTAB 1984) (reversing examining attorney's requirement for disclaimer of "JEVER" in application to register JEVER and design for beer originating in Jever, West Germany, where the sole evidence of a goods/place association was an entry from a 32-year-old geographic index); *In re Brauerei Aying Franz Inselkammer KG*, 217 USPQ 73 (TTAB 1983) (AYINGER BIER ("BIER" disclaimed) held not primarily geographically descriptive of beer emanating from Aying, West Germany, a hamlet of 500 inhabitants, where the examining attorney's only evidence of a goods/place association was the specimen label identifying Aying as the place of origin).

Remoteness or obscurity is determined from the perspective of the average American consumer. *See In re Societe Generale des Eaux Minerales de Vittel, S.A.,* 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987) (VITTEL and design held not primarily geographically descriptive of cosmetic products because of lack of goods/place association between the goods and the applicant's place of business in Vittel, France). However, the examining attorney does not necessarily have to show that the nationwide general public would associate the mark with the place. The significance of the term is determined not in the abstract, but from the point of view of the consumers of the particular goods or services identified in the application. *In re MCO Properties Inc.*, 38 USPQ2d 1154 (TTAB 1995) (FOUNTAIN HILLS held primarily geographically descriptive of real estate development services rendered in Fountain Hills, Arizona, where the record showed that Fountain Hills was the name of the town where the applicant was located and rendered its services, and that the purchasers who came in contact with the mark would associate that place with the services).

1210.04(d) Arbitrary Use of Geographic Terms

The name of a geographic location that has no significant relation to commercial activities or the production of the relevant goods or services, such as ALASKA for bananas, is treated as an arbitrary mark because it is unlikely that consumers would believe that the mark identifies the place from which the goods originate.

Often, names of mountains or rivers are arbitrary for goods because no commercial activity is performed there. For example, "Colorado River" for candy bars or "Mount Rushmore" for automobiles would be arbitrary. *See In re Nantucket, Inc.*, 677 F.2d 95, 105, 213 USPQ 889, 897 (C.C.P.A. 1982) (Nies, J., concurring) ("Thus, the names of places devoid of commercial activity are arbitrary usage. In this category are names of places such as ANTARCTICA, MOUNT EVEREST, or GALAPAGOS, at least when used for ordinary commercial products, such as beer and shoes. Names such as SUN, WORLD, GLOBE, MARS, or MILKY WAY are also arbitrary, not informational; competitors do not need to use the terms to compete effectively.").

1210.05 Geographically Deceptive Marks

1210.05(a) Basis for Refusal

Past Practice. Prior to the amendment of the Trademark Act by the NAFTA Implementation Act, the test for determining

whether a mark was primarily geographically deceptively misdescriptive under §2(e)(3) of the Trademark Act differed from the test for determining whether a mark was deceptive under §2(a) of the Act, 15 U.S.C. §1052(a). To establish that a mark was primarily geographically deceptively misdescriptive under §2(e)(3), the examining attorney had to show that the primary significance of the mark was geographic, that purchasers would be likely to believe that the goods or services originated in the place named in the mark, and that the goods or services did not originate in that place. *In re Nantucket, Inc.*, 677 F.2d 95, 213 USPQ 889 (C.C.P.A. 1982). An additional showing of "materiality" was required to establish that a mark was deceptive under §2(a), i.e., a showing that a goods/place or services/place association made by purchasers was "material" to the decision to purchase the goods or services. *Bureau Nat'l Interprofessionnel Du Cognac v. International Better Drinks Corp.*, 6 USPQ2d 1610 (TTAB 1988); *In re House of Windsor, Inc.*, 221 USPQ 53 (TTAB 1983), *recon. denied*, 223 USPQ 191 (TTAB 1984).

Current Practice. The Court of Appeals for the Federal Circuit has held that with the NAFTA amendments, §2 of the Act "no longer treats geographically deceptively misdescriptive marks differently from geographically deceptive marks," and that a showing of public deception is required to establish that a mark is unregistrable under §2(e)(3). *In re California Innovations Inc.,* 329 F.3d 1334, 1339, 66 USPQ2d 1853, 1856 (Fed. Cir. 2003), *reh'g denied*, 2003 U.S. App. LEXIS 18883 (Fed. Cir. Aug. 20, 2003). Thus, the test for determining whether, post-NAFTA, a mark is primarily geographically deceptively misdescriptive under §2(e)(3) is now the same as the test for determining whether a mark is deceptive under §2(a). *Id.,* 329 F.3d at 1340, 66 USPQ2d at 1857.

1210.05(b) Elements of a §2(e)(3) Refusal

Accordingly, the elements of a refusal under Trademark Act §2(e)(3) are as follows:

(1) The primary significance of the mark is a generally known geographic location;

(2) The goods or services do not originate in the place identified in the mark;

(3) Purchasers would be likely to believe that the goods or services originate in the geographic place identified in the mark; and

(4) The misrepresentation would be a material factor in a significant portion of the relevant consumers' decision to buy the goods or use the services.

See In re Spirits Int'l, N.V., 563 F.3d 1347, 90 USPQ2d 1489, 1495 (Fed. Cir. 2009); *California Innovations,* 329 F.3d at 1341; 66 USPQ 2d at 1858.

Often, the record is clear that neither the applicant nor the goods/services originate from the place named in the mark. In other cases, although the applicant may not come from the place named, it is not clear whether the goods/service originate in that place. In either situation, after determining that the primary significance of the mark is a generally known geographic location, and that there is a goods/place or services/place association such that the public is likely to believe that the goods or services originate in the place identified in the mark, the examining attorney must then determine whether a geographically deceptively misdescriptive refusal would be warranted. At this point, the assessment turns on materiality – that is, whether a known or possible misdescription in the mark would affect a substantial portion of the relevant consumers' decision to purchase the goods/services.

In cases under the doctrine of foreign equivalents, where the place name in the mark appears in a foreign language, the requirement that a substantial portion of the relevant consuming public would likely be deceived raises special issues. To make a determination about "a substantial portion" in such cases, the examining attorney must consider whether the foreign language place name would be recognizable as such to consumers who do not speak the foreign language, and/or whether consumers who speak the foreign language could constitute a substantial portion of the relevant consumers (e.g., because they are the "target audience"). *Spirits,* 563 F.3d at 1353, 90 USPQ2d at 1495.

1210.05(c) Determining Materiality

To establish that a geographic term is primarily geographically deceptively misdescriptive under 15 U.S.C. §1052(e)(3) or deceptive under §2(a), it must be shown that the goods/place or services/place association made by a consumer is material to the consumer's decision to purchase those goods/services. *In re California Innovations Inc.,* 329 F.3d 1334, 1340, 66 USPQ2d 1853, 1856 (Fed. Cir. 2003), *reh'g denied*, 2003 U.S. App. LEXIS 18883 (Fed. Cir. Aug. 20, 2003).

1210.05(c)(i) Materiality In Cases Involving Goods

In determining "materiality," the Board has stated that it looks to evidence regarding the probable reaction of purchasers to a particular geographical term when it is applied to particular goods. *See In re House of Windsor, Inc* ., 221 USPQ 53 (TTAB 1983). If the evidence shows that the geographical area named in the mark is sufficiently known to lead purchasers to make a

goods/place association, but the record does not show that the relevant goods are a principal product of that geographical area, the deception will most likely be found not to be material. If, however, there is evidence that the relevant goods, or related goods, are a principal product of the geographical area named by the mark, then the deception will most likely be found to be material.

Furthermore, evidence that a place is famous as a source of the goods at issue raises an inference in favor of materiality. *See In re Les Halles De Paris J.V.*, 334 F.3d 1371, 1374, 67 USPQ2d 1539, 1542 (Fed. Cir. 2003). Such evidence supports a presumption that a substantial portion of the relevant consumers is likely to be deceived.

Thus, to establish the materiality element for goods, the evidence should show that:

- The place named in the mark is famous as a source of the goods at issue;
- The goods in question are a principal product of the place named in the mark; or
- The goods are, or are related to, the traditional products of the place named in the mark, or are an expansion of the traditional products of the place named in the mark.

See California Innovations, 329 F.3d at 1340, 66 USPQ2d at 1857; *In re Save Venice N.Y., Inc*., 259 F.3d 1346, 1355, 59 USPQ2d 1778, 1784 (Fed. Cir. 2001); *House of Windsor*, 221 USPQ at 57.

Searches that combine the place name with the name of the goods and terms such as “famous,” “renowned,” “well-known,” “noted for,” “principal,” or “traditional” may be useful to establish materiality.

Note that in *U.S. Playing Card Co. v. Harbro, LLC*, 81 USPQ2d 1537, 1542 (TTAB 2006), the Board held that the mark VEGAS was *not* primarily geographically deceptively misdescriptive of playing cards that do not originate in Las Vegas, finding that the opposer failed to establish that the misleading goods/place association would be a material factor in the customer’s decision to purchase the goods. The Board rejected opposer’s argument that it had met the materiality factor by proving that there is a market for cancelled casino cards from Las Vegas casinos, stating that “[a]lthough the evidence demonstrates that consumers are interested in obtaining cards that were used in casinos, the evidence does not establish that they are interested in purchasing playing cards that were manufactured or used in Las Vegas.” The Board also disagreed with opposer’s contention that the goods/place association between Las Vegas and playing cards was so strong that materiality could be presumed.

1210.05(c)(ii) Materiality In Cases Involving Services

In a case involving services, a showing that the geographic location in the mark is known for performing the service is not sufficient, unless it rises to the level of fame. This is especially true for restaurant services because, having chosen a particular restaurant, a customer is aware of the geographic location of the service and is less likely to associate the services with the place named in the mark (e.g., a customer is less likely to identify restaurant services with a region of Paris when sitting in a restaurant in New York).

Therefore, before addressing materiality, the examining attorney must satisfy the services/place association prong by providing evidence of an additional reason for the consumer to associate the services with the geographic location invoked by the mark. For example, the examiner could provide evidence that a customer sitting in a restaurant in one location would believe that:

- The food came from the place named in the mark; or
- The chef received specialized training in the place identified in the mark; or
- The menu is identical to a known menu from the geographic location named in the mark.

See In re Les Halles De Paris J.V., 334 F.3d 1371, 1374, 67 USPQ2d 1539, 1541-1542 (Fed. Cir. 2003); *In re Consolidated Specialty Restaurants, Inc.*, 71 USPQ2d 1921, 1927 (TTAB 2004).

This heightened association between the services and geographic place named in the mark raises an inference of deception or materiality for a service mark. The Court of Appeals for the Federal Circuit has provided the following guidance regarding additional evidence that would be sufficient to satisfy the materiality element:

> In any event, the record might show that customers would patronize the restaurant because they believed the food was imported from, or the chef was trained in, the place identified by the restaurant’s mark. The importation of food and culinary training are only examples, not exclusive methods of analysis….

Les Halles De Paris J.V., 334 F.3d 1371, 1375, 67 USPQ2d 1539, 1542.

In *In re Consolidated Specialty Restaurants, Inc.*, 71 USPQ2d 1921 (TTAB 2004) (COLORADO STEAKHOUSE and design

held primarily geographically deceptively misdescriptive of restaurant services), the Board found that a mistaken belief that the steaks served in applicant's restaurant were from Colorado would be material to the customer's decision to patronize the restaurant, where the record contained the following evidence: gazetteer and dictionary definitions of "Colorado" and "steakhouse;" a United States Department of Agriculture report on cattle inventory; stories excerpted from the LexisNexis® database; and Internet excerpts showing that Colorado was one of the 11 top cattle states in the United States, that Colorado was known for its steaks, that "Colorado steaks" are featured food items in restaurants outside the state, and that politicians from Colorado use "Colorado steaks" as the basis for wagers on sporting events. The Board stated that "an inference of materiality arises where there is a showing of a 'heightened association' between the services and the geographic place or, in other words, a showing of 'a very strong services-place association.'" *Id*. at 1928.

See also **TMEP §§1203.02** *et seq.* regarding deceptive marks, and **TMEP §1210.08** regarding geographical designations used on or in connection with wines or spirits that identify a place other than the origin of the goods.

1210.05(d) Procedures for Issuing Geographically Deceptive Refusals

Although the test for determining whether a mark is primarily geographically deceptively misdescriptive under §2(e)(3) is now the same as the test for determining whether a mark is deceptive under §2(a), the statutory provisions with respect to registrability on the Supplemental Register and on the Principal Register under §2(f) are different:

- Under §23(a) of the Trademark Act, a mark that is primarily geographically deceptively misdescriptive may be registered on the Supplemental Register if the mark has been in lawful use in commerce since before December 8, 1993 (the date of enactment of the NAFTA Implementation Act), while a mark that is deceptive may not be registered on the Supplemental Register; and
- Under §2(f) of the Trademark Act, a mark that is primarily geographically deceptively misdescriptive may be registered if the mark became distinctive of the goods or services in commerce before December 8, 1993, while a mark that is deceptive may not be registered on the Principal Register even upon a showing of acquired distinctiveness.

Accordingly, because the statute expressly prohibits registration of deceptive marks on the Supplemental Register or on the Principal Register under §2(f), the examining attorney will proceed as follows.

1210.05(d)(i) Neither Applicant Nor Goods/Services Come from the Place Named

To ensure that no geographically deceptively misdescriptive marks claiming use or acquired distinctiveness prior to December 8, 1993 are registered on the Supplemental Register or under §2(f) when it is clear that neither the applicant nor the goods/services come from the place named in the mark, the examining attorney must determine whether the misdescription would be material and follow the procedures outlined below:

- If the examining attorney determines that the misdescription would not be material to the decision to purchase, no refusal should be made. If the application is otherwise in condition for publication, the examining attorney should approve the mark for publication.
- If the examining attorney determines that the misdescription would be material to the decision to purchase, and the application does not claim use prior to December 8, 1993, the examining attorney must issue nonfinal refusals under §§2(e)(3) and 2(a), supported by appropriate evidence.

Depending upon the applicant's response, the examining attorney will ultimately issue a final refusal under either §2(e)(3) or §2(a):

- If the applicant's response does not claim use or acquired distinctiveness prior to December 8, 1993, the examining attorney must withdraw the §2(a) refusal and issue a final refusal under §2(e)(3), if otherwise appropriate.
- In the rare circumstance that the applicant responds by claiming use prior to December 8, 1993 and amends to the Supplemental Register, or establishes that the mark acquired distinctiveness under §2(f) prior to December 8, 1993, to ensure that a geographically deceptively misdescriptive mark will not be allowed to register, the examining attorney must withdraw the §2(e)(3) refusal and issue a final refusal under §2(a), if otherwise appropriate.

In re South Park Cigar, Inc., 82 USPQ2d 1507, 1509, n.3 (TTAB 2007). *See also Corporacion Habanos, S.A. v. Guantanamera Cigars Co.*, 86 USPQ2d 1473 (TTAB 2008) (Board considered only the §2(e)(3) claim in opposition based on both §§2(a) and 2(e)(3)); *In re Beaverton Foods, Inc*., 84 USPQ2d 1253, 1257 (TTAB 2007) ("[W]here an applicant is seeking registration for a mark with a geographic term on the Principal Register under Section 2(f) based on a claim that the mark had acquired distinctiveness prior to December 8, 1993, a geographically deceptive mark is properly refused registration under Section 2(a). Nothing in the statute or legislative history dictates otherwise. Moreover, this analysis is consistent with the practice of the

USPTO.”).

1210.05(d)(ii) It is Not Clear Whether the Goods/Services Originate From the Place Named

If the applicant does not come from the place named in the mark, and the record does not indicate whether the goods/services originate in that place (*see* **TMEP §1210.03)**, the examining attorney must do the following:

(1) If (a) the entire mark would not be geographically descriptive (making disclaimer an option), (b) there are no other substantive refusals (making an examiner’s amendment an option), and (c) the application could be put into condition for publication by examiner’s amendment (*see* **TMEP §707)**, to expedite prosecution, the examining attorney should:

- Attempt to contact the applicant to determine whether the goods/services originate in the place named and, if so, to obtain authorization for a disclaimer and for any other amendments that would put the application in condition for approval for publication.
- If the applicant states that the goods/services do not originate in the place named, the examining attorney must so indicate in a note in a “Notes-to-the-File” section of TICRS. The examining attorney must then follow the appropriate procedure in **TMEP §1210.05(d)(i).**
- To ensure the completeness of the record in the event of an appeal, any Office action must also include an information request under 37 C.F.R. §2.61(b), asking whether the goods/services originate in the place named.

(2) If the examining attorney is unable to reach the applicant or cannot obtain authorization for an examiner’s amendment, or if the applicant indicates that they do not know where the goods/services will originate, or if an Office action is otherwise necessary to make substantive refusals or requirements that cannot be satisfied by examiner’s amendment, the examining attorney must proceed as follows:

- Issue a refusal under §2(e)(2) as geographically descriptive (or a requirement for a disclaimer, if appropriate), based on the presumption that the goods/services come from the place named in the mark; and
- If the misdescription would be material, issue alternative refusals, supported by evidence, under §§2(a) and 2(e)(3) as geographically deceptively misdescriptive, based on the alternative presumption that the goods do not come from the place named; and
- Issue any other relevant refusals and requirements; and
- Issue an information request under 37 C.F.R. §2.61(b), asking where the goods/services originate. This written request is made to ensure the completeness of the record in the event of an appeal.

See In re Cheezwhse.com, Inc., 85 USPQ2d 1917 (TTAB 2008).

1210.05(e) Geographically Deceptive Matter: Case References

In re Spirits Int’l, N.V., 563 F.3d 1347, 90 USPQ2d 1489 (Fed. Cir. 2009) (Remanding case to Trademark Trial and Appeal Board to determine whether a substantial portion of the relevant consumers would translate and be materially deceived by the Russian term Moskovskaya for vodka); *In re Les Halles De Paris J.V*., 334 F.3d 1371, 67 USPQ2d 1539 (Fed. Cir. 2003) (Court found that the record did not show that a diner at the restaurant in question would identify the region in Paris named in the mark as a source of the restaurant services or that a material reason for the choice of the restaurant was its identity with the region in Paris); *In re California Innovations Inc.,* 329 F.3d 1334, 66 USPQ2d 1853 (Fed. Cir. 2003), *reh’g denied*, 2003 U.S. App. LEXIS 18883 (Fed. Cir. Aug. 20, 2003); *In re Save Venice New York Inc.,* 259 F.3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001) (THE VENICE COLLECTION and design held primarily geographically deceptively misdescriptive of products that do not originate in Venice, Italy, where an encyclopedia and a gazetteer showed that Venice was a well known center for the manufacture of glass, lace, art objects, jewelry, cotton, and silk textiles); *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999) (NEW YORK WAYS GALLERY held primarily geographically deceptively misdescriptive where manufacturing listings and Nexis® excerpts showed that New York was well known as a place where leather goods and handbags are designed and manufactured); *Corporacion Habanos, S.A. v. Anncas, Inc.*, 88 USPQ2d 1785 (TTAB 2008) (HAVANA CLUB found primarily geographically deceptively misdescriptive of cigars made from Cuban seed tobacco since Havana is world renowned for cigars and consumers would believe that the cigars originate in Havana when, in fact, they do not); *Corporacion Habanos, S.A. v. Guantanamera Cigars Co.*, 86 USPQ2d 1473 (TTAB 2008) (opposition to registration of GUANTANAMERA sustained for cigars and smokers’ articles as being primarily geographically deceptively misdescriptive where the primary significance of the term was “of or from Guantanamo, Cuba” or “a female from Guantanamo” and Cuba was renowned for tobacco and cigars); *In re Cheezwhse.com, Inc.*, 85 USPQ2d 1917 (TTAB 2008) (NORMANDIE CAMEMBERT held primarily geographically descriptive

of cheese because Normandy, France was famous for cheese and the Board presumed that the goods would originate there, and, in the alternative, primarily geographically deceptively misdescriptive for cheese, based on the presumption that the goods would not originate there, since applicant failed to submit information about the origin of the goods); *In re Beaverton Foods, Inc*., 84 USPQ2d 1253 (TTAB 2007) (NAPA VALLEY MUSTARD CO. for mustard that did not originate in Napa Valley, California held deceptive, where the record contained printouts from various websites showing use of NAPA VALLEY in relation to mustard by third parties, evidence of a widely advertised annual Napa Valley Mustard Festival, evidence of the connection of Napa Valley to wineries and gourmet food, and copies of advertisements for applicant's goods which imply that the mustard originates in Napa Valley); *In re South Park Cigar, Inc.*, 82 USPQ2d 1507 (TTAB 2007) (YBOR GOLD held primarily geographically deceptively misdescriptive of cigars and tobacco that do not come from the Ybor City area of Tampa, Florida, given the prominence of Ybor City as a current and historical source of cigars); *In re Consolidated Specialty Restaurants, Inc.*, 71 USPQ2d 1921 (TTAB 2004) (Board found that patrons of applicant's restaurants, COLORADO STEAKHOUSE, would believe the steaks that were served would come from Colorado); *In re Juleigh Jeans Sportswear Inc*., 24 USPQ2d 1694 (TTAB 1992) (LONDON LONDON held deceptive for clothing having no connection with London, given the renown of London as a center for contemporary as well as traditional fashions); *In re Sharky's Drygoods Co.,* 23 USPQ2d 1061 (TTAB 1992) (juxtaposition of "Paris" with "Beach Club" results in incongruous phrase, and purchasers, thus, will view PARIS BEACH CLUB as humorous mark in which "Paris" is used facetiously rather than as geographic reference); *In re Perry Mfg. Co.,* 12 USPQ2d 1751 (TTAB 1989) (PERRY NEW YORK and design ("NEW YORK" disclaimed) held deceptive for various items of clothing that originate in North Carolina, and have no connection with New York, because of the renown of New York in the apparel industry); *In re House of Windsor, Inc.*, 221 USPQ 53 (TTAB 1983), *recon. denied*, 223 USPQ 191 (TTAB 1984) (BAHIA held deceptive of cigars that do not originate in the Bahia province of Brazil, where the evidence of record was "unequivocal" that tobacco and cigars are important products in the Bahia region).

1210.06 Procedure for Examining Geographic Composite Marks

A geographic composite mark is one composed of geographic matter coupled with additional matter (e.g., wording and/or a design element). When examining such a mark, the examining attorney must first determine the primary significance of the composite. *See* **TMEP §§1210.02(c)** *et seq*.

Composite marks present unique issues in regard to both geographically descriptive and misdescriptive refusals. When evaluating whether the mark's primary significance is a generally known geographic location, a composite mark must be evaluated as a whole. *See In re Save Venice New York Inc.,* 259 F.3d 1346,1352, 59 USPQ2d 1778, 1782 (Fed. Cir. 2001). In order to do so, the examiner may also consider the significance of each element within the mark. *Id.*

For example, the mark PARIS BEACH CLUB, for clothing, was held not to be perceived as primarily geographic. *In re Sharky's Drygoods Co.,* 23 USPQ2d 1061 (TTAB 1992). Because Paris is known for haute couture, is not located on an ocean or lake and does not have a beach, the Board found that the juxtaposition of PARIS with BEACH CLUB resulted in an incongruous phrase and that the word PARIS would be viewed as a facetious rather than a geographic reference. The mark NEW YORK WAYS GALLERY, however, was found to be geographically deceptive. *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999). The Board determined that (1) NEW YORK was not an obscure geographical term; (2) NEW YORK was known as a place where the goods at issue were designed, manufactured, and sold; and (3) the primary geographic significance was not lost by the addition of WAYS GALLERY to NEW YORK. Likewise, in the YBOR GOLD case, the Board held that the mere addition of the word GOLD to the geographic designation YBOR did not result in an arbitrary, fanciful, or suggestive composite. *In re South Park Cigar, Inc.*, 82 USPQ2d 1507 (TTAB 2007). The Board determined that GOLD connoted the high quality of the goods and thus did not detract from the geographic significance of YBOR or negate the primarily geographic significance of the mark as a whole.

Depending on the primary significance of the composite, the examining attorney will handle the geographic issue in a geographic composite mark in one of the following ways:

(1) If the examining attorney finds that the mark, when viewed as a whole, is arbitrary, fanciful, or suggestive, he or she will approve the mark for publication without evidence that the mark has acquired distinctiveness under §2(f). However, examining attorneys must consult their senior or managing attorney before going forward when they have made a preliminary determination that the primary significance of the mark as a whole is *not* geographic. The senior or managing attorney will make the final determination or may seek guidance from the Office of Legal Policy, within the Office of the Deputy Commissioner for Trademark Examination Policy;

(2) If the examining attorney finds that the mark is primarily geographically descriptive under §2(e)(2) without a showing of acquired distinctiveness, primarily geographically deceptively misdescriptive under §2(e)(3), or deceptive under §2(a), he or she will refuse registration of the mark as a whole; or

(3) If the examining attorney finds that the geographic matter is a separable part of the mark, the examining attorney's action will depend on whether the matter is primarily geographically descriptive, primarily geographically deceptively

misdescriptive, or deceptive. *See* **TMEP §1210.06(a)** regarding primarily geographically descriptive composites, and **TMEP §1210.06(b)** regarding primarily geographically deceptively misdescriptive and deceptive composites.

1210.06(a) Marks That Include Primarily Geographically Descriptive Terms Combined With Additional Matter

If a composite mark comprises a geographic term that is primarily geographically descriptive of the goods or services under §2(e)(2), and the mark as a whole would be likely to be perceived as indicating the geographic origin of the goods or services, then the examining attorney must consider: (1) whether the geographic term is a separable element in the mark; and (2) the nature of the additional matter that makes up the composite mark.

If the geographic term is not a separable element or if none of the additional matter that makes up the composite mark is inherently distinctive (e.g., it is merely descriptive or incapable), then the examining attorney should refuse registration of the entire mark on the Principal Register pursuant to §2(e)(2).

If the geographic term is a separable element and the additional matter making up the mark is inherently distinctive as applied to the goods or services (i.e., coined, arbitrary, fanciful, or suggestive), the applicant may either: (1) register the mark on the Principal Register with a disclaimer of the geographic term; or (2) establish that the geographic term has acquired distinctiveness under §2(f).

A disclaimer is appropriate where the geographic component is a separable feature of the mark, and the composite mark includes an inherently distinctive, non-disclaimed component (e.g., coined, arbitrary, fanciful, or suggestive wording or design). The composite mark must include a non-disclaimed component because a mark cannot be registered if all the components have been disclaimed. *See* **TMEP §§1213** *et seq*. regarding disclaimer.

When the examining attorney requires a disclaimer of primarily geographically descriptive matter, the applicant may seek to overcome the disclaimer requirement by submitting a showing that the geographic term has become distinctive under §2(f). *See* **TMEP §§1210.07(b)** and **1212.02(f)** regarding §2(f) claims as to a portion of the mark.

A term that is primarily geographically descriptive of the goods or services under §2(e)(2) may be registered on the Supplemental Register in an application under §1 or §44 of the Trademark Act, if it is not barred by other section(s) of the Act. *See* **TMEP §1210.07(a).**

To help ensure that determinations concerning the primary significance of composite marks are handled consistently, examining attorneys must consult their senior or managing attorney before going forward when they have made a preliminary determination that the primary significance of the mark as a whole is *not* geographic. The senior or managing attorney will make the final determination or may seek guidance from the Office of Legal Policy regarding such marks.

1210.06(b) Marks That Include Primarily Geographically Deceptively Misdescriptive and Deceptive Terms Combined With Additional Matter

If a composite mark includes matter that is primarily geographically deceptively misdescriptive within the meaning of §2(e)(3) or deceptive under §2(a), and the mark as a whole would be likely to be perceived as indicating the geographic origin of the goods or services, the examining attorney must follow the procedures outlined above for refusing registration. *See* **TMEP §1210.05(d).**

A composite mark that is deceptive under §2(a) cannot be registered, even with a disclaimer of the geographic component. *In re Perry Mfg. Co.*, 12 USPQ2d 1751, 1751-52 (TTAB 1989).

A disclaimer of the geographic matter will not overcome a §2(e)(3) refusal, even if the mark was in use prior to December 8, 1993. *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539,1542 (Fed. Cir. 1999).

See **TMEP §1210.05(a)** regarding the basis for refusal of marks that are primarily geographically deceptively misdescriptive, and **TMEP §1210.05(d)** for procedures for issuing such refusals.

To help ensure that determinations concerning the primary significance of composite marks are handled consistently, examining attorneys must consult their senior or managing attorney before going forward when they have made a preliminary determination that the primary significance of the mark as a whole is *not* geographic. The senior or managing attorney will make the final determination or may seek guidance from the Office of Legal Policy regarding such marks.

1210.07 Supplemental Register and Section 2(f)

1210.07(a) Registrability of Geographic Terms on the Supplemental Register

Primarily Geographically Descriptive Marks. A term that is primarily geographically descriptive of the goods/services under §2(e)(2) may be registered on the Supplemental Register, if it is not barred by other section(s) of the Act. However, in certain circumstances, a primarily geographically descriptive mark may be considered incapable. *See In re Bee Pollen from England*

Ltd., 219 USPQ 163, 166 (TTAB 1983) (BEE POLLEN FROM ENGLAND found incapable of distinguishing bee pollen from England); *Mineco, Inc. vs. Lone Mountain Turqoise Mine*, 217 USPQ 466, 468 (TTAB 1983) (LONE MOUNTAIN found incapable of distinguishing turquoise from the Lone Mountain Mine).

Primarily Geographically Deceptively Misdescriptive Marks. A mark that is found to be primarily geographically deceptively misdescriptive under §2(e)(3) may not be registered on the Supplemental Register unless the mark has been in lawful use in commerce since before December 8, 1993, the date of enactment of the NAFTA Implementation Act. Section 23(a) of the Trademark Act; 15 U.S.C. §1091(a). If the applicant claims use prior to December 8, 1993 and seeks registration on the Supplemental Register, or amends to the Supplemental Register, the examining attorney must refuse registration under §2(a). *See* **TMEP §1210.05(d)(i).**

Geographically Deceptive Marks. A mark that is deceptive under §2(a) may not be registered on the Supplemental Register. *In re Juleigh Jeans Sportswear Inc*., 24 USPQ2d 1694 (TTAB 1992).

NOTE: A mark in a §66(a) application cannot be registered on the Supplemental Register under any circumstances. 15 U.S.C. §1141h(a)(4); 37 C.F.R. §§2.47(c) and 2.75(c).

1210.07(b) Registrability of Geographic Terms Under Section 2(f)

Primarily Geographically Descriptive Marks. A term that is primarily geographically descriptive of the goods/services under §2(e)(2) may be registered on the Principal Register if it is shown to have acquired distinctiveness under §2(f). *See* **TMEP §§1212** *et seq.* regarding §2(f).

Primarily Geographically Deceptively Misdescriptive Marks. A mark that is primarily geographically deceptively misdescriptive under §2(e)(3) may not be registered under §2(f) unless the mark became distinctive of the goods or services in commerce before December 8, 1993, the date of enactment of the NAFTA Implementation Act. *See In re Boyd Gaming Corp*., 57 USPQ2d 1944 (TTAB 2000); *Fred Hayman Beverly Hills Inc. v. Jacques Bernier Inc*., 38 USPQ2d 1691 (TTAB 1996).

If the applicant claims that the mark acquired distinctiveness prior to December 8, 1993, the examining attorney must refuse registration under §2(a). *See* **TMEP §1210.05(d)(i).**

Geographically Deceptive Marks. A mark that is deceptive under §2(a) may not be registered on the Principal Register even under §2(f).

Section 2(f) in Part. An applicant may claim that a geographic component of a mark has acquired distinctiveness under §2(f). *See* **TMEP §1212.02(f)** regarding claims of acquired distinctiveness as to a portion of a mark. Thus, if the examining attorney requires a disclaimer of matter that is primarily geographically descriptive under §2(e)(2), the applicant may seek to overcome the disclaimer requirement by submitting a showing that the geographic component has acquired distinctiveness under §2(f). If the applicant is able to establish to the satisfaction of the examining attorney that the geographic component has acquired distinctiveness, the examining attorney will approve the mark for publication with a notation that there is a claim of distinctiveness under §2(f) as to the geographic component, if appropriate.

1210.08 Geographical Indications Used on Wines and Spirits

Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), prohibits the registration of a designation that consists of or comprises "a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after [January 1, 1996]." This provision was added by the Uruguay Round Agreements Act, implementing the Trade-Related Intellectual Property ("TRIPs") portions of the General Agreement on Tariffs and Trade ("GATT"). This provision does not apply to geographic indications that were first used in commerce on or in connection with wines or spirits prior to January 1, 1996.

The term "spirits" refers to "a strong distilled alcoholic liquor" (e.g., gin, rum, vodka, whiskey, or brandy). *Random House Webster's Unabridged Dictionary* 1839 (2nd ed. 1998). This provision does not apply to designations used on or in connection with beer, nor does it apply to goods that are not wines or spirits, but are partially composed of wines or spirits (e.g., wine vinegar, wine sauces, wine jelly, rum balls, bourbon chicken).

This provision of §2(a) applies if the applicant's identification of goods: (1) specifically includes wines or spirits; or (2) describes the goods using broad terms that could include wines or spirits (e.g., alcoholic beverages).

Section 2(a) is an absolute bar to the registration of these geographical designations on either the Principal Register or the Supplemental Register. Neither a disclaimer of the geographical designation nor a claim that it has acquired distinctiveness under §2(f) can obviate a §2(a) refusal if the mark consists of or comprises a geographical indication that identifies a place other than the origin of the wines or spirits.

See **TMEP §1210.08(a)** regarding geographical indications used on wines and spirits that do not originate in the named place, **TMEP §1210.08(b)** regarding geographical indications used on wines and spirits that originate in the named place, and **TMEP §1210.08(c)** regarding geographical indications that are generic for wines and spirits.

1210.08(a) Geographical Indications Used on Wines and Spirits That Do Not Originate in the Named Place

In implementing the TRIPs Agreement through the Uruguay Round Agreements Act ("URAA"), Pub. L. 103-465, 103 Stat. 4809, Congress approved a Statement of Administrative Action ("SAA") which provides, in part, that:

> "Geographical indications" are defined in TRIPs Article 22.1 as "indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin." The Administration expects that this definition will be applied in the context of trademark registration and that a "geographical indication" as used in this provision will be interpreted to comprise only those areas which have a reputation for being associated with the specific goods at issue. *Obscure areas or those that do not have a reputation or other characteristics generally associated with wines or spirits should not be prohibited from registration* (emphasis added).

Statement of Administrative Action, Agreement on Trade-Related Aspects of Intellectual Property Rights, H. Doc. 103-316, Vol. 1, 103rd Cong., 2d Sess. 1000, 1994 WL 761796, §B.1.e (Sept. 27, 1994). 19 U.S.C. §§3511(a)(2) and 3512(d).

A designation is considered a *geographical indication* under §2(a) if it identifies the applicant's wines or spirits as originating in a territory known for a given quality, reputation, or other characteristic associated with wines or spirits. A mark for wines or spirits that includes a geographical indication is unregistrable if: (1) purchasers would erroneously believe that the goods originate in the relevant geographic location; and (2) the quality, reputation, or characteristic associated with wines or spirits from that location would materially affect the purchaser's decision to buy the goods.

To establish a prima facie case for refusal to register a mark under the "wines and spirits" provision of §2(a), the following is required:

(1) The primary significance of the relevant term or design is geographic, e.g., a place name, abbreviation, nickname, or symbol; or an outline or map of a geographic area (*see* **TMEP §§1210.02(a)** and **1210.02(b)** *et seq*.);

(2) Purchasers would be likely to think that the goods originate in the geographic place identified in the mark, i.e., purchasers would make a goods/place association (*see* **TMEP §§1210.04** *et seq*.);

(3) The goods do not originate in the place identified in the mark (*see* **TMEP §1210.03)**;

(4) A purchaser's erroneous belief as to the geographic origin of the goods would materially affect the purchaser's decision to buy the goods (*see* **TMEP §§1210.05(c)** *et seq*.); and

(5) The mark was first used in commerce by the applicant on or after January 1, 1996.

Section 2(a) is an absolute bar to the registration of false geographical indications used on wines or spirits on either the Principal Register or the Supplemental Register. Neither a disclaimer of the geographic term or design nor a claim that it has acquired distinctiveness under §2(f) of the Trademark Act, 15 U.S.C. §1052(f), can obviate a §2(a) refusal if the mark consists of or includes a geographical indication that identifies a place other than the true origin of the wines or spirits.

Requirement for First Use On or After January 1, 1996

For all applications filed under §1(b), §44, or §66(a) of the Trademark Act, 15 U.S.C. §1051(b), §1126, or §1141f(a), or for applications filed under §1(a) of the Trademark Act, 15 U.S.C. §1051(a), where the application fails to indicate the applicant's date of first use of the mark in commerce, the examining attorney should presume that the applicant's first use of the mark in commerce is or will be on or after January 1, 1996, unless the application record indicates otherwise.

If the examining attorney determines that a mark featuring a false geographical indication was in use *prior* to January 1, 1996, the examining attorney should refuse registration because the mark is primarily geographically deceptively misdescriptive under §2(e)(3) of the Trademark Act, 15 U.S.C. §1052(e)(3), and deceptive under §2(a). *See* **TMEP §1210.05(a).**

1210.08(b) Geographical Indications Used on Wines and Spirits That Originate in the Named Place

If the wines or spirits originate in the identified place, and the primary significance of the mark is a generally known geographic location, the examining attorney should presume the requisite goods/place association, and refuse the mark under §2(e)(2) as geographically descriptive, or require disclaimer of the geographic term, as appropriate. *See* **TMEP §§1210.01(a)** and **1210.06(a)**.

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Sometimes, a geographic term is used to certify the geographic origin of wines or spirits. If the proposed mark is used to certify the goods, the applicant may convert the application to one for a certification mark of regional origin under §4 of the Trademark Act, 15 U.S.C. §1054. *See* **TMEP §1306.06(f)(vi)** regarding amendment to a different type of mark, and **TMEP §§1210.09** and **1306.02** *et seq*. regarding geographic certification marks.

1210.08(c) Geographical Indications That Are Generic for Wines and Spirits

When a geographic term or design in the mark is generic for a type of wine or spirit, the examining attorney must refuse registration under §2(e)(1) on the Principal Register or §23 on the Supplemental Register, as appropriate, because the term or design is generic. *See* **TMEP §§1209.02** *et seq*. Or, if appropriate, the examining attorney must require a disclaimer of the generic term or design. *See* **TMEP §§1213** *et seq.* regarding disclaimer.

A geographic term or design is considered generic if United States consumers view it as designating the genus of the goods, rather than their geographic origin. *See* **TMEP §§1209.01(c)** *et seq.* If a geographic term or design is used in connection with wines or spirits, the examining attorney may submit a search request to the Trademark Law Library to determine whether there is evidence indicating that the term or design is generic for the applicant's goods.

1210.09 Geographic Certification Marks

Under certain circumstances, the name of the place from which goods or services originate may function as a certification mark. When geographic terms are used to certify regional origin (e.g., "Idaho" used to certify that potatoes are grown in Idaho), registration of certification marks should not be refused and, in applications to register composite certification marks, disclaimers of these geographic terms should *not* be required on the ground of geographical descriptiveness. *See* **TMEP §§1306.02** *et seq*. concerning procedures for registration of certification marks that certify regional origin.

When a geographical term used in a composite certification mark is not used to certify regional origin (e.g., "California" used to certify that fruit is organically grown), appropriate refusals pursuant to §§2(e)(2), 2(e)(3), or 2(a) should be made.

1210.10 Doctrine of Foreign Equivalents

Under the doctrine of foreign equivalents, foreign words from common, modern languages are translated into English to determine their geographic significance. Although the doctrine arises more often in cases involving likelihood of confusion, descriptiveness, and genericness, the doctrine also applies to issues involving geographic marks. *See*, *e.g*., *In re Spirits Int'l, N.V.*, 563 F.3d 1347, 90 USPQ2d 1489 (Fed. Cir. 2009) (doctrine applied in determining whether MOSKOVSKAYA, a Russian word meaning "of or from Moscow," was primarily geographically deceptively misdescriptive for vodka not from Moscow); *In re Joint Stock Co. "Baik"*, 80 USPQ2d 1305 (TTAB 2006) (BAIKALSKAYA, a Russian word meaning "from Baikal" held primarily geographically descriptive of vodka from Lake Baikal).

Although words from modern languages are generally translated into English, the doctrine of foreign equivalents is not an absolute rule, but merely a guideline. The doctrine should be applied only when it is likely that the ordinary American purchaser would stop and translate the foreign word into its English equivalent. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772,* 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The "ordinary American purchaser" includes "all American purchasers, including those proficient in a non-English language who would ordinarily be expected to translate words into English." *Spirits Int'l,* 563 F.3d 1347, 1352, 90 USPQ2d at 1492 (Fed. Cir. 2009).

While foreign words are generally translated into English for purposes of determining geographic significance, foreign words from dead or obscure languages may be so unfamiliar to the American buying public that they should not be translated into English for descriptiveness purposes. *See Enrique Bernat F. S.A. v. Guadalajara Inc*., 210 F.3d 439, 54 USPQ2d 1497 (5th Cir. 2000), *reh'g denied* 218 F.3d 745 (2000); *cf. General Cigar Co. Inc. v. G.D.M. Inc*., 988 F. Supp. 647, 45 USPQ2d 1481 (S.D.N.Y. 1997). The determination of whether a language is "dead" must be made on a case-by-case basis, based upon the meaning that the term would have to the relevant purchasing public.

> *Example:* Latin is generally considered a dead language. However, if there is evidence that a Latin term is still in use by the relevant purchasing public (e.g., if the term appears in current dictionaries or news articles), then that Latin term is not considered dead. The same analysis should be applied to other uncommon languages.

See **TMEP §§809** *et seq*. for information regarding how to ascertain the meaning of non-English wording in a mark. *See also* **TMEP §§1207.01(b)(vi)** *et seq.*, **1209.03(g)**, and **1211.01(a)(vii)** regarding the doctrine of foreign equivalents.

1211 Refusal on Basis of Surname

Extract from 15 U.S.C. §1052. No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it ... (e) Consists of a mark which ... (4) is primarily merely a surname.

Under §2(e)(4) of the Trademark Act, 15 U.S.C. §1052(e)(4), a mark that is primarily merely a surname is not registrable on the Principal Register absent a showing of acquired distinctiveness under §2(f), 15 U.S.C. §1052(f). *See* **TMEP §§1212** *et seq*. regarding acquired distinctiveness. Formerly §2(e)(3) of the Act, this section was designated §2(e)(4) when the NAFTA Implementation Act took effect on January 1, 1994. A mark that is primarily merely a surname may be registrable on the Supplemental Register in an application under §1 or §44 of the Trademark Act.

The Trademark Act, in §2(e)(4), reflects the common law that exclusive rights in a surname *per se* cannot be established without evidence of long and exclusive use that changes its significance to the public from that of a surname to that of a mark for particular goods or services. The common law also recognizes that surnames are shared by more than one individual, each of whom may have an interest in using his surname in business; and, by the requirement for evidence of distinctiveness, the law, in effect, delays appropriation of exclusive rights in the name. *In re Etablissements Darty et Fils,* 759 F.2d 15, 17, 225 USPQ 652, 653 (Fed. Cir. 1985).

The question of whether a mark is primarily merely a surname depends on the mark's *primary* significance to the purchasing public. *See, e.g., Ex parte Rivera Watch Corp.*, 106 USPQ 145, 149 (Comm'r Pats. 1955). Each case must be decided on its own facts, based upon the evidence in the record.

The legislative history of the Trademark Act of 1946 indicates that th

1211.01 "Primarily Merely a Surname"

e word "primarily" was added to the existing statutory language "merely" with the intent to exclude registration of names such as "Johnson" or "Jones," but not registration of names such as "Cotton" or "King" which, while surnames, have a primary significance other than as a surname. *See Sears, Roebuck & Co. v. Watson*, 204 F.2d 32, 33-34, 96 USPQ 360, 362 (D.C. Cir. 1953), *cert. denied,* 346 U.S. 829, 99 USPQ 491 (1953); *Ex parte Rivera Watch Corp.*, 106 USPQ 145, 149 (Comm'r Pats. 1955).

The question of whether a term is primarily merely a surname depends on the primary, not the secondary, significance to the purchasing public. The Trademark Trial and Appeal Board has identified five factors to be considered in making this determination:

(1) whether the surname is rare (*see* **TMEP §1211.01(a)(v))**;

(2) whether the term is the surname of anyone connected with the applicant;

(3) whether the term has any recognized meaning other than as a surname (*see* **TMEP §§1211.01(a)** *et seq*.);

(4) whether it has the "look and feel" of a surname (*see* **TMEP §1211.01(a)(vi))**; and

(5) whether the stylization of lettering is distinctive enough to create a separate commercial impression (*see* **TMEP §1211.01(b)(ii).**

In re Benthin Management GmbH, 37 USPQ2d 1332, 1333-1334 (TTAB 1995). Where the mark is in standard characters, it is unnecessary to consider the fifth factor. *In re Yeley*, 85 USPQ2d 1150 (TTAB 2007).

If there is any doubt as to whether a term is primarily merely a surname, the Board will resolve the doubt in favor of the applicant. *Yeley, supra; Benthin, supra.*

1211.01(a) Non-Surname Significance

Often a word will have a meaning or significance in addition to its significance as a surname. The examining attorney must determine the primary meaning of the term to the public.

1211.01(a)(i) Ordinary Language Meaning

If there is a readily recognized meaning of a term, apart from its surname significance, such that the primary significance of the term is not that of a surname, registration should be granted on the Principal Register without evidence of acquired distinctiveness. *See In re Isabella Fiore, LLC,* 75 USPQ2d 1564 (TTAB 2005) (FIORE is not primarily merely a surname where it is also the Italian translation of the English word "flower" and the non-surname meaning is not obscure); *In re United Distillers plc*, 56 USPQ2d 1220 (TTAB 2000) (the relatively rare surname HACKLER held not primarily merely a surname, in light of dictionary meaning); *Fisher Radio Corp. v. Bird Electronic Corp.*, 162 USPQ 265 (TTAB 1969) (BIRD held not primarily merely a surname despite surname significance); *In re Hunt Electronics Co.*, 155 USPQ 606 (TTAB 1967) (HUNT held not primarily merely a surname despite surname significance). However, this does not mean that an applicant only has to uncover a non-

surname meaning of the proposed mark to obviate a refusal under §2(e)(4). *See In re Nelson Souto Major Piquet*, 5 USPQ2d 1367, 1368 (TTAB 1987) (N. PIQUET (stylized) held primarily merely a surname despite significance of the term "piquet" as "the name of a relatively obscure card game").

1211.01(a)(ii) Phonetic Equivalent of Term With Ordinary Language Meaning

A term may be primarily merely a surname even if it is the phonetic equivalent of a word that has an ordinary meaning (e.g., Byrne/burn; Knott/not or knot; Chappell/chapel). *See In re Pickett Hotel Co.*, 229 USPQ 760 (TTAB 1986) (PICKETT SUITE HOTEL held primarily merely a surname despite applicant's argument that PICKETT is the phonetic equivalent of the word "picket"). *Cf. In re Monotype Corp. PLC*, 14 USPQ2d 1070, 1071 (TTAB 1989) (CALISTO held not primarily merely a surname, the Board characterizing the telephone directory evidence of surname significance as "minimal" and in noting the mythological significance of the name "Callisto," stating that it is common knowledge that there are variations in the rendering of mythological names transliterated from the Greek alphabet (distinguishing *In re Pickett Hotel Co., supra*)). Similarly, the fact that a word that has surname significance is also a hybrid or derivative of another word having ordinary language meaning is insufficient to overcome the surname significance, unless the perception of non-surname significance would displace the primary surname import of the word. *See In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985) (DARTY held primarily merely a surname despite applicant's argument that the mark is a play on the word "dart"); *In re Petrin Corp*., 231 USPQ 902 (TTAB 1986) (PETRIN held primarily merely a surname despite applicant's argument that the mark represents an abbreviation of "petroleum" and "insulation").

1211.01(a)(iii) Geographical Significance

A term with surname significance may not be primarily merely a surname if that term also has a well-known geographical meaning. *In re Colt Industries Operating Corp.*, 195 USPQ 75 (TTAB 1977) (FAIRBANKS held not primarily merely a surname because the geographical significance of the mark was determined to be just as dominant as its surname significance). However, the fact that a term is shown to have some minor significance as a geographical term will not dissipate its primary significance as a surname. *In re Hamilton Pharmaceuticals Ltd.*, 27 USPQ2d 1939, 1943 (TTAB 1993) (HAMILTON held primarily merely a surname).

1211.01(a)(iv) Historical Place or Person

A term with surname significance may not be primarily merely a surname if that term also identifies a historical place or person. *See Lucien Piccard Watch Corp. v. Since 1868 Crescent Corp.*, 314 F. Supp. 329, 165 USPQ 459 (S.D.N.Y. 1970) (DA VINCI not primarily merely a surname because it primarily connotes Leonardo Da Vinci); *In re Pyro-Spectaculars, Inc.*, 63 USPQ2d 2022, 2024 (TTAB 2002) (SOUSA for fireworks and production of events and shows featuring pyrotechnics not primarily merely a surname, where the evidence showed present-day recognition and continuing fame of John Philip Sousa as a composer of patriotic music, and the applicant's goods and services were of a nature that "would be associated by potential purchasers with patriotic events such as the Fourth of July, patriotic figures, and patriotic music"); *Michael S. Sachs Inc. v. Cordon Art B.V.*, 56 USPQ2d 1132 (TTAB 2000) (primary significance of M. C. ESCHER is that of famous deceased Dutch artist). *Cf. In re Pickett Hotel Co.*, 229 USPQ 760 (TTAB 1986) (PICKETT SUITE HOTEL held primarily merely a surname despite applicant's evidence that PICKETT was the name of a famous Civil War general); *In re Champion Int'l Corp.*, 229 USPQ 550 (TTAB 1985) (McKINLEY held primarily merely a surname despite being the name of a deceased president).

Evidence that an individual is famous in a particular field does not necessarily establish that he or she is a historical figure. *In re Binion*, 93 USPQ2d 1531 (TTAB 2009) (BINION and BINION'S primarily merely a surname; although there was evidence that applicant had played a significant role in the gaming industry in Las Vegas, his notoriety was not deemed so remarkable or so significant that he is a historical figure); *In re Thermo LabSystems Inc*., 85 USPQ2d 1285 (TTAB 2007) (WATSON held primarily merely a surname). Furthermore, the Board has held that a surname that would be evocative of numerous individuals, rather than one particular historical individual, does not qualify as a historical name and is merely a surname of numerous individuals with varying degree of historical significance. *Id.*

1211.01(a)(v) Rare Surnames

The rarity of a surname is an important factor to be considered in determining whether a term is primarily merely a surname. *In re Joint-Stock Co. "Baik,"* 84 USPQ2d 1921 (TTAB 2007) (finding that extreme rarity of BAIK weighed against surname refusal); *In re Benthin Management GmbH*, 37 USPQ2d 1332 (TTAB 1995) (the fact that BENTHIN was a rare surname found to be a factor weighing against a finding that the term would be perceived as primarily merely a surname); *In re Sava Research Corp*., 32 USPQ2d 1380 (TTAB 1994) (SAVA not primarily merely a surname, where there was evidence that the term had other meaning, no evidence that the term was the surname of anyone connected with applicant, and the term's use as a surname was very rare); *In re Garan Inc.,* 3 USPQ2d 1537 (TTAB 1987) (GARAN held not primarily merely a surname). However, the fact that a surname is rare does not *per se* preclude a finding that a term is primarily merely a surname. Even a rare surname

may be held primarily merely a surname if its primary significance to purchasers is that of a surname. *See In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985) (DARTY held primarily merely a surname); *In re Rebo High Definition Studio Inc.,* 15 USPQ2d 1314 (TTAB 1990) (REBO held primarily merely a surname); *In re Pohang Iron & Steel Co., Ltd.*, 230 USPQ 79 (TTAB 1986) (POSTEN held primarily merely a surname). Regardless of the rarity of the surname, the test is whether the primary significance of the term to the purchasing public is that of a surname.

An issue to be considered in determining how rarely a term is used is the media attention or publicity accorded to public personalities who have the surname. A surname rarely appearing in birth records may nonetheless appear more routinely in news reports, so as to be broadly exposed to the general public. *In re Gregory*, 70 USPQ2d 1792 (TTAB 2004).

1211.01(a)(vi) "Look And Feel" of a Surname

Some names, by their very nature, have only surname significance even though they are rare surnames. *See In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564, 1566 (TTAB 1988), *aff'd,* 883 F.2d 1026 (Fed. Cir. 1989) (PIRELLI held primarily merely a surname, the Board stating that "certain rare surnames look like surnames and certain rare surnames do not and ... 'PIRELLI' falls into the former category...."); *In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986) (PETRIN held primarily merely a surname). Conversely, certain surnames are so rare that they do not even have the appearance of surnames. In such cases, even in the absence of non-surname significance, a reasonable application of the "primary significance to the purchasing public" test could result in a finding that the surname, when used as a mark, would be perceived as arbitrary or fanciful. *In re United Distillers plc*, 56 USPQ2d 1220 (TTAB 2000) (HACKLER does not have the look and feel of a surname); *see also In re Joint-Stock Co. "Baik,"* 84 USPQ2d 1921 (TTAB 2007) (lack of other recognized meaning does not in itself imbue a mark with the "look and feel" of a surname).

1211.01(a)(vii) Doctrine of Foreign Equivalents

In determining whether a term is primarily merely a surname, the examining attorney must consider whether the term has any meaning in a foreign language. This determination is made from the point of view of American buyers familiar with the foreign language. *In re Isabella Fiore, LLC,* 75 USPQ2d 1564 (TTAB 2005) (FIORE – the Italian equivalent of "Flower" – not primarily merely a surname).

The doctrine of foreign equivalents is not an absolute rule, but merely a guideline, which should be applied only when it is likely that the ordinary American purchaser would stop and translate the foreign word into its English equivalent. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772,* 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The "ordinary American purchaser" includes "all American purchasers, including those proficient in a non-English language who would ordinarily be expected to translate words into English." *In re Spirits Int'l, N.V.*, 563 F.3d 1347, 1352, 90 USPQ2d 1489, 1492 (Fed. Cir. 2009). To support a refusal under §2(e)(4), the record must show that the surname significance is the *primary* significance. *See In re Picone,* 221 USPQ 93 (TTAB 1984) (evidence that "PICON" is the name of a town and a mountain in Spain and that "piccone" is an Italian word meaning "pick" or "pickax" insufficient to overcome a refusal on the ground that PICONE is *primarily* merely a surname).

In *Fiore*, the Board noted that applicant had produced evidence that Italian is a popular language in the United States, such that the meaning of the term would be recognized by a wide variety of people; that "Fiore" is "listed as the only translation of the common English word "flower;" that Italian is a major, modern language, not an obscure language; and that the non-surname meaning of the term in Italian is not obscure. The Board found that FIORE "is the type of term that potential customers would stop and translate," and that "there is no question of whether the term would be recognized in its current form as the Italian word for 'Flower.'" 75 USPQ2d at 1569.

The fact that a term has no meaning in a foreign language may also be relevant to a determination of whether a term is primarily merely a surname. In holding that PIRELLI was primarily merely a surname, the Board noted that the term "has no ordinary meaning in the Italian language, as the Italian dictionary excerpt, made of record by the Examining Attorney, shows." *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564, 1566 (TTAB 1988), *aff'd,* 883 F.2d 1026 (Fed. Cir. 1989).

See **TMEP §§809** *et seq*. for information regarding how to ascertain the meaning of non-English wording in a mark.

See also **TMEP §§1207.01(b)(vi)** *et seq*., **1209.03(g)**, and **1210.10** regarding the doctrine of foreign equivalents.

1211.01(b) Surname Combined with Additional Matter

Often a mark will be comprised of a word that, standing by itself, would be primarily merely a surname, coupled with additional matter (e.g., letters, words, or designs). The question remains whether the mark sought to be registered would be perceived by the public primarily merely as a surname. *In re Hutchinson Technology Inc.,* 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988). *See* **TMEP §§1211.01(b)(i)** *et seq*. for additional information about surnames combined with additional matter.

1211.01(b)(i) Double Surnames

A combination of two surnames is not primarily merely a surname, within the meaning of §2(e)(4), unless there is evidence of record showing that the combination would be perceived by the public primarily merely as a surname. *See In re Standard Elektrik Lorenz A.G.*, 371 F.2d 870, 152 USPQ 563 (C.C.P.A. 1967) (SCHAUB-LORENZ held not primarily merely a surname, the Court noting that there was no evidence submitted that the mark sought to be registered was primarily merely a surname; that the only evidence of surname significance related to the individual "SCHAUB" and "LORENZ" portions of the mark; and that the mark must be considered in its entirety rather than dissected).

1211.01(b)(ii) Stylization or Design Elements

A mark comprised of a word that, standing by itself, would be considered primarily merely a surname, but which is coupled with a distinctive stylization or design element, is not considered primarily merely a surname. *In re Benthin Management GmbH*, 37 USPQ2d 1332 (TTAB 1995) (stylized display of term BENTHIN found to be a factor weighing against a finding that the term would be perceived as primarily merely a surname). However, the addition of a nondistinctive design element or stylization to a term that, standing by itself, is primarily merely a surname does not remove the term from that category. The primary significance of the mark, in its entirety, would be merely that of a surname. *See In re Pickett Hotel Co.*, 229 USPQ 760, 763 (TTAB 1986) (PICKETT SUITE HOTEL held primarily merely a surname despite the stylization of the lettering, which was considered "insignificant, in that it is clearly not so distinctive as to create any separate commercial impression in the minds of purchasers of appellant's services").

The display of a term in lower-case lettering does not detract from its surname significance. *In re Directional Marketing Corp.*, 204 USPQ 675 (TTAB 1979).

1211.01(b)(iii) Surname Combined with Initials

A mark that consists of two or more initials preceding a surname will typically convey the commercial impression of a personal name and thus generally will not be primarily merely a surname. *In re P.J. Fitzpatrick,* 95 USPQ2d 1412, (TTAB 2010) (Board held that the initials P.J. coupled with surname Fitzpatrick would be perceived as a given name and thus comprises an entire personal name, not merely a surname); *see In re Yeley*, 85 USPQ2d 1150 (TTAB 2007) (Board held that the proposed mark J.J. YELEY was recognized as the full name of the well known NASCAR race driver and as such was perceived as a reference to a particular person and not primarily merely a surname)*; Michael S. Sachs Inc. v. Cordon Art B.V.*, 56 USPQ2d 1132, 1136 (TTAB 2000) (Board found that the primary significance of M.C. ESCHER was that of a famous deceased Dutch artist, commenting that "[t]he mark M.C. ESCHER would no more be perceived as primarily merely a surname than the personal names P.T. Barnum, T.S. Eliot, O.J. Simpson, I.M. Pei and Y.A. Tittle.").

Although marks consisting of a single initial preceding a surname have been held to be primarily merely a surname, *In re I. Lewis Cigar Mfg. Co.*, 205 F.2d 204, 98 USPQ 265 (C.C.P.A. 1953), the Board has noted that no per se rule exists that a single initial preceding a surname must be deemed primarily merely a surname. *P.J. Fitzpatrick*, 95 USPQ2d at 1413. The Board further opined that such a mark would not be perceived as primarily merely a surname where the record shows that the addition of a single initial to a surname creates the commercial impression of a personal name. *Id*. Therefore, applicants may attempt to overcome a surname refusal as to a mark consisting of a single initial preceding a surname by submitting evidence that the mark would likely be perceived as a personal name. For example, an applicant may provide evidence that consumers in general perceive a single initial preceding a surname as a personal name. Or, an applicant may show that such a mark is the name of an individual, such as the applicant or a signatory of the applicant, and evidence shows it would be recognized as such by the consuming public. In addition, if the applicant indicates that the name in the mark is that of a particular living individual, the applicant must provide written consent to register the mark from this individual. *See* **TMEP §§813**, **813.01(a)** and **1206.04(a).** However, when the name in the mark is identical to the name of the applicant or of a signer of the application (e.g., the mark is A. JONES and the applicant's name or signatory is A. Jones), consent would not be necessary. In such cases, consent is presumed, but the examining attorney must ensure that a consent statement is entered into the TRAM database. *See id*.

1211.01(b)(iv) Surname Combined with Title

A title, such as "Mr.," "Mrs.," "Mlle.," "Dr.," or "MD," does not diminish the surname significance of a term; rather, it may enhance the surname significance of a term. *In re Rath*, 402 F.3d 1207, 74 USPQ2d 1174 (Fed. Cir. 2005) (Federal Circuit affirmed Board decision holding that DR. RATH was primarily merely a surname); *In re Giger*, 78 USPQ2d 1405 (TTAB 2006) (GIGER MD primarily merely a surname); *In re Revillon*, 154 USPQ 494 (TTAB 1967) (MLLE. REVILLON primarily merely a surname). *Cf. In re Hilton Hotels Corp.*, 166 USPQ 216 (TTAB 1970) (LADY HILTON held not primarily merely a surname because it suggests a person or lady of nobility).

1211.01(b)(v) Surname in Plural or Possessive Form

The surname significance of a term is not diminished by the fact that the term is presented in its plural or possessive form. *See In re Binion*, 93 USPQ2d 1531 (TTAB 2009); *In re Woolley's Petite Suites*, 18 USPQ2d 1810 (TTAB 1991) (WOOLLEY'S PETITE SUITES for hotel and motel services held primarily merely a surname); *In re McDonald's Corp.*, 230 USPQ 304, 306 (TTAB 1986) (MCDONALD'S held primarily merely a surname based on a showing of surname significance of "McDonald," the Board noting that "it is clear that people use their surnames in possessive and plural forms to identify their businesses or trades"); *In re Luis Caballero, S.A.*, 223 USPQ 355 (TTAB 1984) (BURDONS held primarily merely a surname based in part on telephone listings showing surname significance of "Burdon"); *In re Directional Marketing Corp.*, 204 USPQ 675 (TTAB 1979) (DRUMMONDS held primarily merely a surname based on a showing of surname significance of "Drummond").

1211.01(b)(vi) Surname Combined with Wording

The treatment of marks that include wording in addition to a term that, standing by itself, is primarily merely a surname, depends on the significance of the non-surname wording.

If the wording combined with the surname is incapable of functioning as a mark (i.e., a generic name for the goods or services), the examining attorney should refuse registration on the ground that the entire mark is primarily merely a surname under §2(e)(4). If the policy were otherwise, one could evade §2(e)(4) by the easy expedient of adding the generic name of the goods or services to a word that is primarily merely a surname. *In re Hamilton Pharmaceuticals Ltd.*, 27 USPQ2d 1939 (TTAB 1993) (HAMILTON PHARMACEUTICALS for pharmaceutical products held primarily merely a surname); *In re Cazes*, 21 USPQ2d 1796, 1797 (TTAB 1991) (BRASSERIE LIPP held primarily merely a surname where "'brasserie' is a generic term for applicant's restaurant services"); *In re Woolley's Petite Suites*, 18 USPQ2d 1810 (TTAB 1991) (WOOLLEY'S PETITE SUITES for hotel and motel services held primarily merely a surname); *In re Possis Medical, Inc.*, 230 USPQ 72, 73 (TTAB 1986) (POSSIS PERFUSION CUP held primarily merely a surname, the Board finding that "[a]pplicant's argument that PERFUSION CUP is not a generic name for its goods ... is contradicted by the evidence the Examining Attorney has pointed to"); *In re E. Martinoni Co.*, 189 USPQ 589, 590-91 (TTAB 1975) (LIQUORE MARTINONI (stylized) for liqueur held primarily merely a surname, with "liquore" being the Italian word for "liqueur").

If the wording combined with the surname is capable of functioning as a mark (i.e., matter that is arbitrary, suggestive, or merely descriptive of the goods or services), the mark is not considered to be primarily merely a surname under §2(e)(4). However, if the additional wording is merely descriptive or the equivalent, and a disclaimer is otherwise proper, the examining attorney should require a disclaimer of the additional wording. *See In re Hutchinson Technology Inc.,* 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988) (HUTCHINSON TECHNOLOGY for computer components held not primarily merely a surname when the mark is considered as a whole, the Court remanding the case for entry of a disclaimer of "TECHNOLOGY" before publication).

Some wording may enhance rather than diminish the surname significance of the mark. *See In re Piano Factory Group Inc.,* 85 USPQ2d 1522 (TTAB 2007) (the addition of "& SONS" to the surname VOSE "serves only to emphasize or reinforce that 'VOSE' is the surname of the sons' parents."), and cases cited therein. *See also* **TMEP §1211.01(b)(iv)** regarding surnames combined with titles, **TMEP §1211.01(b)(iii)** regarding surnames combined with initials, and **TMEP §1211.01(b)(viii)** regarding surnames combined with legal or familial business entity designations.

1211.01(b)(vii) Surname Combined With Domain Name

A surname combined with a non-source-identifying top-level domain name (e.g., JOHNSON.COM) is primarily merely a surname under §2(e)(4). *See* **TMEP §1215.03.**

1211.01(b)(viii) – Surname Combined With Legal or Familial Entity Designation

The addition of wording that merely indicates the legal entity of an applicant, such as "Corporation," "Inc.," "Ltd.," "Company," or "Co.," or the family business structure of an applicant, such as "& Sons" or "Bros.," does not diminish the surname significance of a term that is otherwise primarily merely a surname. *See In re Piano Factory Group, Inc*., 85 USPQ2d 1522 (TTAB 2006) (holding VOSE & SONS primarily merely a surname), *In re I. Lewis Cigar Mfg. Co*., 205 F.2d 204, 98 USPQ 265 (C.C.P.A. 1953) (holding S. SEIDENBERG & CO'S. primarily merely a surname). In fact, adding the familial entity designation "& SONS" to a surname was found to emphasize or reinforce the surname significance of the mark. *Piano Factory Group, Inc*., 85 USPQ2d at 1527.

1211.02 Evidence Relating to Surname Refusal

1211.02(a) Evidentiary Burden – Generally

The burden is initially on the examining attorney to establish a prima facie case that a mark is primarily merely a surname. The

burden then shifts to the applicant to rebut this showing. *In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986). The evidence submitted by the examining attorney was found insufficient to establish a prima facie case in the following decisions: *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 184 USPQ 421 (C.C.P.A. 1975); *In re BDH Two Inc.*, 26 USPQ2d 1556 (TTAB 1993); *In re Raivico*, 9 USPQ2d 2006 (TTAB 1988); *In re Garan Inc.*, 3 USPQ2d 1537 (TTAB 1987).

There is no rule as to the kind or amount of evidence necessary to make out a prima facie showing that a term is primarily merely a surname. This question must be resolved on a case-by-case basis. *See, e.g., In re Monotype Corp. PLC*, 14 USPQ2d 1070 (TTAB 1989); *In re Pohang Iron & Steel Co., Ltd.*, 230 USPQ 79 (TTAB 1986). The entire record is examined to determine the surname significance of a term. The following are examples of evidence that may be relevant: telephone directory listings; excerpted articles from computerized research databases; evidence in the record that the term is a surname; the manner of use on the specimen; dictionary definitions of the term and evidence from dictionaries showing no definition of the term. The quantum of evidence that is persuasive in finding surname significance in one case may be insufficient in another because of the differences in the names themselves. *See In re Etablissements Darty et Fils*, 759 F.2d 15, 17, 225 USPQ 652, 653 (Fed. Cir. 1985).

See **TMEP §§710** *et seq*. and **1211.02(b)** *et seq*. for additional information about evidence.

1211.02(b) Evidentiary Considerations

In appropriate cases, the examining attorney may present evidence that may appear contrary to his or her position, with an appropriate explanation as to why, in view of other evidence presented, this evidence was not considered controlling. In some cases, this may foreclose objections from an applicant and present a more complete picture in the event of an appeal.

See **TMEP §§1211.02(b)(i)** *et seq*. regarding types of evidence that may be relevant to a refusal of registration under §2(e)(4).

1211.02(b)(i) Telephone Directory Listings

Telephone directory listings from telephone books or electronic databases are one type of credible evidence of the surname significance of a term. The Trademark Trial and Appeal Board has declined to hold that a minimum number of listings in telephone directories must be found to establish a prima facie showing that the mark is primarily merely a surname. *See, e.g., In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986); *In re Wickuler-Kupper-Brauerei KGaA*, 221 USPQ 469 (TTAB 1983).

It is the American public's perception of a term that is determinative. Therefore, foreign telephone directory listings are not probative of the significance of a term to the purchasing public in the United States, regardless of whether the applicant is of foreign origin. *See, e.g., Société Civile Des Domaines Dourthe Frères v. S.A. Consortium Vinicole De Bordeaux Et De La Gironde,* 6 USPQ2d 1205 (TTAB 1988); *In re Stromsholmens Mekaniska Verkstad AB*, 228 USPQ 968 (TTAB 1986); *In re Wickuler-Kupper-Brauerei, supra*.

1211.02(b)(ii) LexisNexis® Research Database Evidence

Excerpted articles from the LexisNexis® research database are one type of credible evidence of the surname significance of a term. There is no requirement that the examining attorney make of record every story found in a LexisNexis® search. However, the examining attorney is presumed to make the best case possible. *See In re Federated Department Stores Inc.*, 3 USPQ2d 1541, 1542 n.2 (TTAB 1987). *See also In re Monotype Corp. PLC*, 14 USPQ2d 1070, 1071 (TTAB 1989) ("We must conclude that, because the Examining Attorney is presumed to have made the best case possible, the 46 stories not made of record [the search yielded 48 stories] do not support the position that CALISTO is a surname and, indeed, show that CALISTO has non surname meanings.") An Office action that includes any evidence obtained from a research database should include a citation to the research service and a clear record of the specific search that was conducted, indicating the libraries or files that were searched and the date of the search (e.g., LexisNexis®, News and Business, All News, Aug. 5, 2007). The electronic record or printout summarizing the search should be made a part of the record. Relevant information not included on the summary, such as the number of documents viewed, should be stated in narrative in the Office action. *See* **TMEP §710.01(a).**

See **TMEP §710.01(b)** regarding evidence originating in foreign publications.

1211.02(b)(iii) U.S. Census Database Evidence

The Census Bureau (http://www.census.gov/genealogy/www/freqnames2k.html) has a database of surnames taken from the most recent decennial census. The surnames are ordered by rank, and the database lists the number of individuals in the country having each surname. Because the database reflects the number of individuals, rather than the number of households, with a particular name, search results from this database may be more persuasive evidence of surname frequency than results from telephone directory listings.

1211.02(b)(iv) Surname of Person Associated with Applicant

The fact that a term is the surname of an individual associated with the applicant (e.g., an officer or founder) is evidence of the surname significance of the term. *See In re Etablissements Darty et Fils,* 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985); *In re Rebo High Definition Studio Inc.,* 15 USPQ2d 1314 (TTAB 1990); *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564 (TTAB 1988), *aff'd,* 883 F.2d 1026 (Fed. Cir. 1989); *In re Taverniti, SARL,* 225 USPQ 1263 (TTAB 1985), *recon. denied,* 228 USPQ 975 (TTAB 1985).

1211.02(b)(v) Specimens Confirming Surname Significance of Term

The fact that a term appears on the specimen of record in a manner that confirms its surname significance is evidence of the surname significance of a term. *See Société Civile Des Domaines Dourthe Frères v. S.A. Consortium Vinicole De Bordeaux Et De La Gironde,* 6 USPQ2d 1205, 1208 (TTAB 1988) (DOURTHE found primarily merely a surname, the Board noting applicant's references to "Dourthe" as the name of a particular family and finding the surname significance of the term to be reinforced by the appearance on applicant's wine labels of the name and/or signature of an individual named Pierre Dourthe); *In re Taverniti, SARL,* 225 USPQ 1263, 1264 (TTAB 1985), *recon. denied,* 228 USPQ 975 (TTAB 1985) (J. TAVERNITI held primarily merely a surname, the Board considering, among other factors, the presentation of the mark on the specimen in signature form); *In re Luis Caballero, S.A.*, 223 USPQ 355, 356-57 (TTAB 1984) (BURDONS held primarily merely a surname, the Board weighting heavily the applicant's use of "Burdon" on the specimen as a surname, albeit of a fictitious character ("John William Burdon")).

1211.02(b)(vi) Negative Dictionary Evidence

Negative dictionary evidence (i.e., evidence that a term is absent from dictionaries or atlases) may demonstrate the lack of non-surname significance of a term. *See In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986).

1211.02(b)(vii) Evidence of Fame of a Mark

Evidence of the fame of a mark (e.g., evidence of consumer recognition of a mark, or expenditures made in promoting or advertising a mark) is not relevant unless registration is sought under §2(f). *In re McDonald's Corp.*, 230 USPQ 304, 307 (TTAB 1986) (Mc DONALD'S held primarily merely a surname in spite of strong secondary meaning, with the Board stating that "the word 'primarily' refers to the primary significance of the term, that is, the ordinary meaning of the word, and not to the term's strength as a trademark due to widespread advertising and promotion of the term as a mark to identify goods and/or services.") *See also In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564 (TTAB 1988), *aff'd,* 883 F.2d 1026 (Fed. Cir. 1989); *In re Nelson Souto Major Piquet*, 5 USPQ2d 1367 (TTAB 1987).

1212 Acquired Distinctiveness or Secondary Meaning

15 U.S.C. §1052(f). Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before the date of the enactment of the North American Free Trade Agreement Implementation Act.

If a proposed mark is not inherently distinctive, it may be registered on the Principal Register only upon proof of acquired distinctiveness, or "secondary meaning," that is, proof that it has become distinctive as applied to the applicant's goods or services in commerce. If the applicant establishes, to the satisfaction of the examining attorney, that the matter in question has acquired distinctiveness as a mark in relation to the named goods or services, then the mark is registrable on the Principal Register under §2(f) of the Trademark Act, 15 U.S.C. §1052(f).

Within the context of the Trademark Act, §2(f) may be described as follows:

> [U]nlike the first five sections of 15 U.S.C. §1052 which define the grounds upon which a trademark registration is to be refused, Section 2(f) serves as an exception to a rejection under the provisions of one of the other sections, Section 2(e) (citation omitted). Section 2(f) permits registration of marks that, despite not qualifying for registration in light of Section 2(e), have nevertheless "become distinctive of the applicant's goods in commerce." Thus, "Section 2(f) is not a provision on which registration can be refused," ... but is a provision under which an applicant has a chance to prove that he is entitled to a federal trademark registration which would otherwise be refused.

Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd., 840 F.2d 1572, 1580, 6 USPQ2d 1001, 1007 (Fed. Cir. 1988), quoting *In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 917 n.2 (TTAB 1983).

The purpose and significance of secondary meaning may be described as follows:

> A term which is descriptive ... may, through usage by one producer with reference to his product, acquire a special significance so that to the consuming public the word has come to mean that the product is produced by that particular manufacturer. 1 Nims, *Unfair Competition and Trademarks* at §37 (1947). This is what is known as secondary meaning.
>
> The crux of the secondary meaning doctrine is that the mark comes to identify not only the goods but the source of those goods. To establish secondary meaning, it must be shown that the *primary* significance of the term in the minds of the consuming public is not the product but the producer (citations omitted). This may be an anonymous producer, since consumers often buy goods without knowing the personal identity or actual name of the manufacturer.

Ralston Purina Co. v. Thomas J. Lipton, Inc., 341 F. Supp. 129, 133, 173 USPQ 820, 823 (S.D.N.Y. 1972).

Three basic types of evidence may be used to establish acquired distinctiveness under §2(f):

(1) A claim of ownership of one or more prior registrations on the Principal Register of the same mark for goods or services that are the same as or related to those named in the pending application (*see* 37 C.F.R. §2.41(b); **TMEP §§1212.04** *et seq.*);

(2) A statement verified by the applicant that the mark has become distinctive of the applicant's goods or services by reason of substantially exclusive and continuous use in commerce by the applicant for the five years before the date when the claim of distinctiveness is made (*see* 37 C.F.R. §2.41(b); **TMEP §§1212.05** *et seq*.); and

(3) Actual evidence of acquired distinctiveness (*see* 37 C.F.R. §2.41(a); **TMEP §§1212.06** *et seq*.).

The applicant may submit one or any combination of these types of evidence, which are discussed below. Depending on the nature of the mark and the facts in the record, the examining attorney may determine that a claim of ownership of a prior registration(s) or a claim of five years' substantially exclusive and continuous use in commerce is insufficient to establish a prima facie case of acquired distinctiveness. The applicant may then submit actual evidence of acquired distinctiveness.

1212.01 General Evidentiary Matters

Whether acquired distinctiveness has been established is a question of fact. *See In re Loew's Theatres, Inc.*, 769 F.2d 764, 769, 226 USPQ 865, 869 (Fed. Cir. 1985), and cases cited therein. The record must contain facts or evidence of acquired distinctiveness.

The burden of proving that a mark has acquired distinctiveness is on the applicant. *See Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 1578-79, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988); *In re Meyer & Wenthe, Inc*., 267 F.2d 945, 122 USPQ 372 (C.C.P.A. 1959).

The applicant may present any competent evidence to establish that a mark has acquired distinctiveness. Actual evidence of acquired distinctiveness may be submitted regardless of the length of time the mark has been used. *Ex parte Fox River Paper Corp.*, 99 USPQ 173 (Comm'r Pats. 1953).

The amount and character of evidence required to establish acquired distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered. *See Roux Laboratories, Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34 (C.C.P.A. 1970); *In re Hehr Mfg. Co.*, 279 F.2d 526, 126 USPQ 381 (C.C.P.A. 1960); *In re Gammon Reel, Inc.*, 227 USPQ 729 (TTAB 1985).

Typically, more evidence is required where a mark is so highly descriptive that purchasers seeing the matter in relation to the named goods or services would be less likely to believe that it indicates source in any one party. *See, e.g., In re Bongrain Int'l Corp.*, 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990); *In re Seaman & Associates, Inc.*, 1 USPQ2d 1657 (TTAB 1986); *In re Packaging Specialists, Inc.*, 221 USPQ 917 (TTAB 1984). Research showing that third parties in applicant's field or closely related fields use the same or substantially the same wording as the mark, or very similar wording as the mark, tends to indicate the mark is at least highly descriptive.

Facts based on events that occurred subsequent to the filing date of the application may be considered. Whether acquired distinctiveness has been established is determined in view of the facts that exist at the time registrability is being considered. *McCormick & Co., Inc. v. Summers*, 354 F.2d 668, 148 USPQ 272 (C.C.P.A. 1966); *General Foods Corp. v. MGD Partners,* 224 USPQ 479 (TTAB 1984); *Kaiser Aluminum & Chemical Corp. v. American Meter Co.*, 153 USPQ 419 (TTAB 1967); *In re Hoffman House Sauce Co.*, 137 USPQ 486 (TTAB 1963).

1212.02 General Procedural Matters

1212.02(a) Situations in which a Claim of Distinctiveness under §2(f) Is Appropriate

A claim of distinctiveness by the applicant under §2(f) is usually made either in response to a statutory refusal to register or in anticipation of such a refusal. A claim of distinctiveness is appropriately made in response to, or in anticipation of, only certain statutory refusals to register. For example, it is inappropriate to assert acquired distinctiveness to contravene a refusal under §2(a), (b), (c), (d), or (e)(5), 15 U.S.C. §§1052(a), (b), (c), (d), or (e)(5). Furthermore, acquired distinctiveness may not be asserted to contravene a refusal under §2(e)(3), 15 U.S.C. §1052(e)(3), unless the mark became distinctive of the applicant's goods in commerce before December 8, 1993, the date of enactment of the NAFTA Implementation Act (*see* **TMEP §1210.07(b)).** *See* **TMEP §1210.05(d)** *et seq.* regarding procedures for refusing registration under §2(a) in response to a claim that a geographically deceptive mark acquired distinctiveness prior to December 8, 1993.

In *In re Soccer Sport Supply Co., Inc.*, 507 F.2d 1400, 1403 n.3, 184 USPQ 345, 347 n.3 (C.C.P.A. 1975), the Court of Customs and Patent Appeals noted as follows:

> [T]he judicially developed concept of "secondary meaning," codified by section 2(f) (15 U.S.C. 1052(f)), relates to descriptive, geographically descriptive, or surname marks which earlier had a primary meaning which did not indicate a single source and were, therefore, unregistrable because of section 2(e) (citation omitted). Additionally, section 2(f) has been applied to permit registration of a mark consisting solely of a design and, therefore, not within the purview of section 2(e).

1212.02(b) Section 2(f) Claim Is, for Procedural Purposes, a Concession that Matter Is Not Inherently Distinctive

For procedural purposes, a claim of distinctiveness under §2(f), whether made in the application as filed or in a subsequent amendment, may be construed as conceding that the matter to which it pertains is not inherently distinctive and, thus, not registrable on the Principal Register absent proof of acquired distinctiveness. Once an applicant has claimed that matter has acquired distinctiveness under §2(f), the issue to be determined is not whether the matter is inherently distinctive but, rather, whether it has acquired distinctiveness. *See, e.g., Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 1577, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988); *In re Cabot Corp*., 15 USPQ2d 1224, 1229 (TTAB 1990); *In re Professional Learning Centers, Inc.*, 230 USPQ 70, 71 (TTAB 1986); *In re Chopper Industries*, 222 USPQ 258, 259 (TTAB 1984). However, claiming distinctiveness in the alternative is *not* an admission that the proposed mark is not inherently distinctive. **TMEP §1212.02(c).**

For the purposes of establishing that the subject matter is not inherently distinctive, the examining attorney should not rely on this concession alone, but should provide other appropriate evidence.

See **TMEP §1212.02(d)** regarding unnecessary §2(f) claims.

1212.02(c) Claiming §2(f) Distinctiveness in the Alternative

An applicant may argue the merits of an examining attorney's refusal and, in the alternative, claim that the matter sought to be registered has acquired distinctiveness under §2(f). Unlike the situation in which an applicant initially seeks registration under §2(f) or amends its application without objection, the alternative claim does not constitute a concession that the matter sought to be registered is not inherently distinctive. *See In re E S Robbins Corp.,* 30 USPQ2d 1540 (TTAB 1992); *In re Professional Learning Centers, Inc.*, 230 USPQ 70, 71 n.2 (TTAB 1986).

When an applicant claims acquired distinctiveness in the alternative, the examining attorney should treat separately the questions of: (1) the underlying basis of refusal; and (2) assuming the matter is determined to be registrable, whether acquired distinctiveness has been established. In the event of an appeal, the Board will use the same analysis, provided the evidence supporting the §2(f) claim is in the record and the alternative grounds have been considered and finally decided by the examining attorney. *In re Harrington*, 219 USPQ 854, 855 n.1 (TTAB 1983).

If the examining attorney accepts the §2(f) evidence, the applicant should be given the option of publication under §2(f) or going forward with the appeal on the underlying refusal. This should be done by telephone or e-mail, with a note in the "Notes-to-the-File" section of the record, wherever possible. If the applicant wants to appeal, or if the examining attorney is unable to reach the applicant by telephone or e-mail, the examining attorney must issue a written action continuing the underlying refusal and noting that the §2(f) evidence is deemed acceptable and will not be an issue on appeal.

In *In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 918 (TTAB 1983), the Board outlined its procedure in situations where the applicant maintains the position that the underlying refusal is improper and, alternatively, seeks registration pursuant to §2(f) in the interest of advancing the prosecution of the application:

> If we decide that the mark as applied to the services is arbitrary or suggestive of the services, as applicant claims, we

> must reverse the refusal of registration under Section 2(e)(1) and we need not consider any of the affidavits or other material made of record by applicant in support of its Section 2(f) claim of distinctiveness. If, on the other hand, we find the mark to be merely descriptive of the services and, in fact, so highly descriptive of them that no amount of evidence could persuade us that the mark has become distinctive, we must affirm the refusal of registration. Similarly, in this situation, we need not consider any of the affidavits or other material made of record by applicant in its Section 2(f) claim of distinctiveness. If we find that the mark is merely descriptive of the goods for purposes of Section 2(e)(1), but not so highly descriptive as to be incapable of functioning as a service mark to identify applicant's services and distinguish them from like services of others, we must determine whether the evidence in support of applicant's claim of distinctiveness is sufficient to warrant registration under the provisions of Section 2(f) of the Trademark Act.

Similarly, in an application under §1 or §44 of the Trademark Act, the applicant may seek registration on the Principal Register under §2(f) and, in the alternative, on the Supplemental Register. Depending on the facts of the case, this approach may have limited practical application. If the examining attorney finds that the matter sought to be registered is not a mark within the meaning of §§1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127 (e.g., is generic or purely ornamental), the examining attorney will refuse registration on both registers.

However, if the issues are framed in the alternative (i.e., whether the matter sought to be registered has acquired distinctiveness under §2(f) or, in the alternative, whether it is capable of registration on the Supplemental Register), and it is ultimately determined that the matter is a mark within the meaning of the Act (e.g., that the matter is merely descriptive rather than generic), then the evidence of secondary meaning will be considered. If it is determined that the applicant's evidence is sufficient to establish that the mark has acquired distinctiveness, the application will be approved for publication on the Principal Register under §2(f). If the evidence is determined to be insufficient, the mark may be registered on the Supplemental Register in an application under §1 or §44 of the Trademark Act.

Accordingly, the applicant may submit an amendment to the Supplemental Register, and continue to argue entitlement to registration on the Principal Register in an appeal.

If the applicant files a notice of appeal in such a case, the Board will institute the appeal, suspend action on the appeal and remand the application to the examining attorney to determine registrability on the Supplemental Register.

If the examining attorney determines that the applicant is entitled to registration on the Supplemental Register, the examining attorney should send a letter notifying the applicant of the acceptance of the amendment and telling the applicant that the application is being referred to the Board for resumption of the appeal. If the examining attorney determines that the applicant is not entitled to registration on the Supplemental Register, the examining attorney will issue a nonfinal action refusing registration on the Supplemental Register. If the applicant fails to overcome the refusal, the examining attorney will issue a final action, and refer the application to the Board to resume action on the appeal with respect to entitlement to registration on either the Principal or the Supplemental Register.

Rather than framing the issues in the alternative (i.e., whether the matter has acquired distinctiveness pursuant to §2(f) or, in the alternative, whether it is capable of registration on the Supplemental Register), the applicant may amend its application between the Principal and Supplemental Registers. 37 C.F.R. §2.75. *See generally In re Educational Communications, Inc.,* 231 USPQ 787 (TTAB 1986); *In re Broco*, 225 USPQ 227 (TTAB 1984).

See **TMEP §§816** *et seq*. and **1102.03** regarding amending a §1(b) application to the Supplemental Register, and TBMP §1215 regarding alternative positions on appeal.

1212.02(d) Unnecessary §2(f) Claims

If the applicant specifically requests registration under §2(f), but the examining attorney considers the entire mark to be inherently distinctive and the claim of acquired distinctiveness to be unnecessary, the examining attorney should so inform the applicant and inquire whether the applicant wishes to delete the statement or to rely on it.

In this situation, if it is necessary to issue an Office action about another matter, the examining attorney should state in the Office action that the §2(f) claim appears to be unnecessary, and inquire as to whether the applicant wants to withdraw it. If it is otherwise unnecessary to communicate with the applicant, the inquiry may be made by telephone or e-mail. If the applicant wants to delete the §2(f) claim, this may be done by examiner's amendment. If the applicant does not respond promptly to the telephone or e-mail message (applicant should be given at least a week), the examining attorney should enter a note in the "Notes-to-the-File" section of the record and approve the application for publication without deleting the §2(f) claim.

If the applicant specifically requests registration of the entire mark under §2(f), but the examining attorney believes that part of the mark is inherently distinctive, the examining attorney should give the applicant the option of limiting the §2(f) claim to the matter that is not inherently distinctive. *See* **TMEP §1212.02(f)** regarding claims of §2(f) distinctiveness as to a portion of a mark. However, if the applicant wishes, a claim of acquired distinctiveness under §2(f) may be made as to an entire mark or

phrase that contains both inherently distinctive matter and matter that is not inherently distinctive. *In re Del E. Webb Corp*., 16 USPQ2d 1232, 1234 (TTAB 1990).

If the application contains statements that seem to relate to acquired distinctiveness or §2(f) but do not actually amount to a request for registration under §2(f), and the examining attorney does not believe that resort to §2(f) is necessary, the examining attorney may treat the statements as surplusage. If it is necessary to communicate with the applicant about another matter, the examining attorney should inform the applicant that the statements are being treated as surplusage. If it is otherwise unnecessary to communicate with the applicant, the examining attorney may delete the statements from the TRAM database, enter a note in the "Notes-to-the-File" section of the record that this has been done, and approve the application for publication. The documents containing the surplusage will remain in the record, but a §2(f) claim will not be printed in the *Official Gazette* or on the certificate of registration. *See* **TMEP §817** regarding preparation of applications for publication or issuance.

1212.02(e) Disclaimers in Applications Claiming Distinctiveness under §2(f)

Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), states, in part, "The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable." *See In re Creative Goldsmiths of Washington, Inc.*, 229 USPQ 766, 768 (TTAB 1986) ("[W]e conclude that it is within the discretion of an Examining Attorney to require the disclaimer of an unregistrable component (such as a common descriptive, or generic, name) of a composite mark sought to be registered on the Principal Register under the provisions of Section 2(f).").

1212.02(f) Section 2(f) Claim in Part

1212.02(f)(i) Standards for Establishing Acquired Distinctiveness for Claims of Section 2(f) in Part

A claim of acquired distinctiveness may apply to a portion of a mark (a claim of §2(f) "in part"). The standards for establishing acquired distinctiveness are the same whether a claim of distinctiveness pertains to the entire mark or a portion of it. However, the examining attorney must focus his/her review of the evidence submitted on the portion of the mark for which acquired distinctiveness is claimed, rather than on the entire mark.

Three basic types of evidence may be used to establish acquired distinctiveness for claims of §2(f) in part:

(1) A claim of ownership of one or more prior registrations on the Principal Register of the *relevant portion of the mark* for goods or services that are the same as or related to those named in the pending application (*see* 37 C.F.R. §2.41(b); **TMEP §§1212.04** *et seq.*);

(2) A statement verified by the applicant that the *relevant portion of the mark* has become distinctive of the applicant's goods or services by reason of substantially exclusive and continuous use in commerce by the applicant for the five years before the date when the claim of distinctiveness is made (*see* 37 C.F.R. §2.41(b); **TMEP §§1212.05** *et seq*.); or

(3) Actual evidence of acquired distinctiveness of the *relevant portion of the mark* (*see* 37 C.F.R. §2.41(a); **TMEP §§1212.06** *et seq*.).

As with all claims of acquired distinctiveness, the amount and character of evidence required depends on the facts of each case and the nature of the mark sought to be registered. *See Roux Laboratories, Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34 (C.C.P.A. 1970); *In re Hehr Mfg. Co.*, 279 F.2d 526, 126 USPQ 381 (C.C.P.A. 1960); *In re Gammon Reel, Inc.*, 227 USPQ 729 (TTAB 1985); **TMEP §1212.01.** Moreover, a determination regarding the acceptability of a §2(f) claim depends on the nature of the mark and/or the evidence provided by the applicant. *See* **TMEP §§1212.04(a)**, **1212.05(a)** and **1212.06.**

1212.02(f)(ii) Appropriate/Inappropriate Situations for Claiming Section 2(f) in Part

When a claim of acquired distinctiveness applies to a portion of a mark, the applicant must clearly identify the portion of the mark for which distinctiveness is claimed.

Generally, the element that is the subject of the §2(f) claim must present a separate and distinct commercial impression apart from the other elements of the mark. That is, it must be a separable element in order for the applicant to assert that it has acquired distinctiveness as a mark. Consequently, if a mark is unitary for purposes of avoiding a disclaimer, a claim of §2(f) in part would generally not be appropriate since the elements are so merged together that they cannot be regarded as separable. If appropriate, the applicant can claim §2(f) as to the entire unitary mark.

See **TMEP §1212.09(b)** regarding claims of §2(f) in part in §1(b) applications, and **TMEP §1212.08** regarding claims of §2(f) in part in §44 and §66a applications.

See also **§1212.10** for information on printing §2(f) in part notations and limitation statements.

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1212.02(f)(ii)(A) Appropriate Situations for Claiming Section 2(f) in Part

Descriptive Matter Combined with an Inherently Distinctive Element

Claiming §2(f) in part should generally be reserved for those situations where descriptive matter is combined with an inherently distinctive element, such as arbitrary words or a design element, and where the descriptive matter presents a separate and distinct commercial impression apart from the other matter in the mark.

For example, if the mark is TASTY SNACKERS for potato chips and the applicant can show acquired distinctiveness as to the descriptive word TASTY, the applicant must limit the claim under §2(f) to the word TASTY (i.e., "2(f) in part as to TASTY") since the term SNACKERS is inherently distinctive.

Similarly, if the mark is TASTY SNACKERS POTATO CHIPS for potato chips and the applicant can show acquired distinctiveness as to TASTY, the applicant must limit the claim under §2(f) to the word TASTY (i.e., "2(f) in part as to TASTY") since the term SNACKERS is inherently distinctive. The applicant must also disclaim the generic wording POTATO CHIPS.

If the mark is TASTY POTATO CHIPS combined with an inherently distinctive design for potato chips and the applicant can show acquired distinctiveness as to the wording TASTY POTATO CHIPS, the applicant must limit the claim under §2(f) to the wording TASTY POTATO CHIPS (i.e., "2(f) in part as to TASTY POTATO CHIPS"). The applicant must also disclaim the generic wording POTATO CHIPS.

Alternatively, if the mark is TASTY POTATO CHIPS combined with an inherently distinctive design for potato chips and the applicant can only show acquired distinctiveness as to TASTY (e.g., because the applicant had not previously used the entire wording TASTY POTATO CHIPS), the applicant must limit the claim under §2(f) to the word TASTY (i.e., "2(f) in part as to TASTY"). The applicant must also disclaim the generic wording POTATO CHIPS.

Geographically Descriptive Matter Combined with an Inherently Distinctive Element

Claims of §2(f) in part are also appropriate when a mark is comprised of geographically descriptive matter combined with an inherently distinctive element, and the geographically descriptive matter presents a separate and distinct commercial impression apart from the other matter in the mark.

For example, if the mark is CALIFORNIA GOLD for car-cleaning preparations and the applicant, who is based in California, can show acquired distinctiveness as to CALIFORNIA, the applicant must limit the claim under §2(f) to the word CALIFORNIA (i.e., "2(f) in part as to CALIFORNIA") since the term GOLD is inherently distinctive.

Similarly, if the mark is CALIFORNIA combined with an inherently distinctive design element for car-cleaning preparations and the applicant, who is from California, can show acquired distinctiveness as to the wording in the mark, the applicant must limit the §2(f) claim to CALIFORNIA (i.e., "2(f) in part as to CALIFORNIA").

See **TMEP §1210.07(b)** for further information regarding the registrability of geographic terms under §2(f) in part.

Surname Combined with Generic Wording

Applicants may also claim §2(f) in part for marks comprised of a surname combined with generic wording, when the applicant can show acquired distinctiveness only as to the surname.

For example, if the mark is JONES JEANS for pants and the applicant can only show acquired distinctiveness as to JONES (because the applicant had not previously used the entire wording JONES JEANS, for example), the applicant must limit the claim under §2(f) to the surname JONES only (i.e., "2(f) in part as to JONES"). The applicant must also disclaim the generic wording JEANS. However, this situation is rare, and the record must clearly reflect that the applicant can only show acquired distinctiveness as to the claimed portion of the mark. Note, by contrast, that if the applicant's prior use is of the entire mark, JONES JEANS, a claim of §2(f) in part would be incorrect because the claim of acquired distinctiveness should apply to the entire mark. That is, in this example, the proper claim would be §2(f) as to JONES JEANS with a separate disclaimer of JEANS.

As an Alternative to a Disclaimer

A claim of §2(f) in part may be offered as an alternative to a disclaimer requirement, if it appears that the applicant can establish acquired distinctiveness in the relevant portion of the mark.

For example, if the mark is MOIST MORSELS combined with an inherently distinctive design for various food items, the applicant would be required to enter a disclaimer of MOIST MORSELS or, if appropriate, a claim of §2(f) in part as to MOIST MORSELS.

Examining attorneys are not required to offer the applicant the option of claiming § 2(f) in part when issuing a disclaimer

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requirement. However, it is not uncommon for an applicant to respond to a disclaimer requirement with a claim of § 2(f) in part instead of the required disclaimer, and this option may be offered in the first Office action, if appropriate.

1212.02(f)(ii)(B) Inappropriate Situations for Claiming Section 2(f) in Part

Claim Applies to Entire Mark

When a mark is comprised of merely descriptive matter, geographically descriptive matter, or a surname combined with generic matter, and the applicant has made a prima facie case of acquired distinctiveness, the applicant's §2(f) claim should generally refer to the entire mark as used, with a separate disclaimer of any generic term(s).

For example, if the mark is NATIONAL CAR RENTAL for car-rental services and the applicant can show acquired distinctiveness as to the entire mark, the proper claim is §2(f) as to NATIONAL CAR RENTAL with a separate disclaimer of the generic wording CAR RENTAL. Similarly, if the mark is NATIONAL CAR RENTAL combined with an inherently distinctive design element, and the applicant can show acquired distinctiveness as to the entire wording, the proper §2(f) statement is §2(f) in part as to the wording NATIONAL CAR RENTAL with a separate disclaimer of CAR RENTAL. In these examples, it would be improper to limit the §2(f) statement to the word NATIONAL because the applicant is not claiming acquired distinctiveness as to NATIONAL, but rather as to the wording NATIONAL CAR RENTAL.

However, if the applicant can show acquired distinctiveness only as to the word NATIONAL (e.g., because the applicant had not previously used the entire wording NATIONAL CAR RENTAL), the applicant may claim §2(f) in part as to NATIONAL and must separately disclaim CAR RENTAL. Similarly, if the mark is NATIONAL CAR RENTAL combined with an inherently distinctive design element, and the applicant can show acquired distinctiveness only as to the word NATIONAL, the proper §2(f) statement is §2(f) in part as to the word NATIONAL with a separate disclaimer of CAR RENTAL. As noted above, this situation is rare, and the record must clearly reflect that the applicant can show acquired distinctiveness only as to the claimed portion of the mark.

If a §2(f) in part claim is improperly provided by the applicant when the record reflects that the §2(f) claim should apply to the entire mark, the examining attorney must issue a new requirement to correct the §2(f) claim.

Inappropriate Alternative to a Disclaimer

In some situations, §2(f) in part is not an acceptable alternative to a disclaimer requirement. Specifically, if an applicant's claim of distinctiveness applies to only part of a mark and the examining attorney determines that (1) the claimed portion of the mark is unregistrable (e.g., generic) and therefore the §2(f) claim is of no avail or (2) although the claimed portion is registrable, the applicant has failed to establish acquired distinctiveness, the examining attorney may require a disclaimer of that portion of the mark, assuming a disclaimer is otherwise appropriate. *See In re Lillian Vernon Corp.,* 225 USPQ 213 (TTAB 1985) (requirement for disclaimer of PROVENDER affirmed in application to register PROVENDER and design for "mail order services in the gourmet, bath and gift item field," "provender" meaning "food" (claim of §2(f) distinctiveness in part held unacceptable))*; cf. In re Chopper Industries,* 222 USPQ 258 (TTAB 1984) (requirement for disclaimer of CHOPPER reversed in application to register CHOPPER 1 and design for wood log splitting axes (claim of §2(f) distinctiveness in part held acceptable)).

Relying on a Claim of Ownership of a Prior Registration

In certain cases, an applicant may not rely on ownership of one or more prior registrations on the Principal Register of the relevant portion of the mark, for goods or services that are the same as or related to those named in the pending application, to support a claim of §2(f) in part.

First, if the term for which the applicant seeks to prove distinctiveness was disclaimed in the prior registration, the registration may not be accepted as prima facie evidence of acquired distinctiveness. *See Kellogg Co. v. General Mills, Inc.*, 82 USPQ2d 1766 (TTAB 2007); *In re Candy Bouquet Int'l, Inc.*, 73 USPQ2d 1883 (TTAB 2004); **TMEP §1212.04(a).** For example, for the mark TASTY SNACKERS for potato chips, if the applicant attempts to support its claim of acquired distinctiveness as to the descriptive word with a prior registration for the mark TASTY combined with an inherently distinctive design, with TASTY disclaimed, such evidence would not be acceptable in view of the disclaimer. Absent additional evidence to show acquired distinctiveness as to TASTY, the examining attorney must require the applicant to delete the claim of §2(f) in part and to provide a disclaimer of the term TASTY.

Second, when an applicant is claiming §2(f) in part, the mark in the claimed prior registration must be the same as or the legal equivalent of the portion of the mark for which the applicant is claiming acquired distinctiveness. A mark is the legal equivalent of a portion of another mark if it creates the same, continuing commercial impression such that the consumer would consider the mark to be the same as the portion of the other mark. *See* **TMEP §1212.04(b)** and cases cited therein.

§2(f) in Part versus §2(f) Claim Restricted to Particular Goods, Services, or Classes

A claim of §2(f) in part should not be confused with a §2(f) claim restricted to certain classes in a multi-class application or to a portion of the goods/services within a single class. Such a restriction can be made *regardless* of whether the applicant is claiming §2(f) for the entire mark or §2(f) in part for a portion of the mark. *See* **TMEP §1212.02(j).**

1212.02(g) Examining Attorney's Role in Suggesting §2(f) or Appropriate Kind/Amount of Evidence

In a first action refusing registration, the examining attorney should suggest, where appropriate, that the applicant amend its application to seek registration under §2(f). For example, this should be done as a matter of course, if otherwise appropriate, in cases where registration is refused under §2(e)(4) on the ground that the mark is primarily merely a surname, and the applicant has recited dates of use that indicate that the mark has been in use in commerce for at least five years.

If the examining attorney determines that an applicant's evidence is insufficient to establish that the mark has acquired distinctiveness, the examining attorney should suggest, where appropriate, that the applicant submit additional evidence. *See In re Half Price Books, Records, Magazines, Inc.*, 225 USPQ 219, 220 n.2 (TTAB 1984) (Noting that applicant was specifically invited to seek registration pursuant to §2(f) but, after amending its application to do so, was refused registration on the ground that the mark was incapable of acquiring distinctiveness, the Board stated that, in fairness to applicant, this practice should be avoided where possible).

The examining attorney should not "require" that the applicant submit evidence of secondary meaning. There would be no practical standard for a proper response to this requirement, nor would there be a sound basis for appeal from the requirement. *See In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 917 n.2 (TTAB 1983) ("Section 2(f) is not a provision on which registration can be refused.").

The examining attorney should not specify the kind or the amount of evidence sufficient to establish that a mark has acquired distinctiveness. It is the responsibility of the applicant to submit evidence to establish that the mark has acquired distinctiveness. *See* **TMEP §1212.01.** However, the examining attorney may make a suggestion as to a course of action, if the examining attorney believes this would further the prosecution of the application.

1212.02(h) Nonfinal and Final Refusals

If an application is filed under §2(f) of the Trademark Act and the examining attorney determines that (1) the mark is not inherently distinctive, and (2) the applicant's evidence of secondary meaning is insufficient to establish that the mark has acquired distinctiveness, the examining attorney will issue a nonfinal action refusing registration on the Principal Register pursuant to the appropriate section of the Trademark Act (e.g., §2(e)(1)), and will separately explain why the applicant's evidence of secondary meaning is insufficient to overcome the underlying statutory basis for refusal. The examining attorney should suggest, where appropriate, that the applicant submit additional evidence. *See* **TMEP §1212.02(g)** concerning the examining attorney's role in suggesting a claim of distinctiveness under §2(f).

If an application is not filed under §2(f) and the examining attorney determines that the mark is not inherently distinctive, the examining attorney should issue a nonfinal action refusing registration on the Principal Register under the appropriate section of the Act (e.g., §2(e)(1)). The examining attorney should suggest, where appropriate, that the applicant amend its application to claim distinctiveness under §2(f).

Thereafter, if the applicant amends its application to seek registration under §2(f), a new issue is raised as to the sufficiency of the applicant's evidence of secondary meaning (*see* **TMEP §714.05(a)(i)).** The underlying statutory basis for refusal remains the same (e.g., §2(e)(1)), but the issue changes from whether the underlying refusal is warranted to whether the matter has acquired distinctiveness. If the examining attorney is persuaded that a prima facie case of acquired distinctiveness has been established, the examining attorney will approve the application for publication under §2(f). If the examining attorney determines that the applicant's evidence is insufficient to establish that the matter has acquired distinctiveness, the examining attorney will issue a second nonfinal action repeating the underlying statutory basis for refusal (e.g., §2(e)(1)), and explaining why the applicant's evidence is insufficient to overcome the stated refusal.

The examining attorney cannot issue a final refusal on the underlying statutory basis of the original refusal, upon an applicant's initial assertion of a §2(f) claim. The mere assertion of distinctiveness under §2(f) raises a new issue. *See In re Educational Communications, Inc.,* 231 USPQ 787, 787 n.2 (TTAB 1986). Even if the applicant has submitted, in support of the §2(f) claim, a statement of five years' use that is technically defective (e.g., not verified or comprising incorrect language), the assertion of §2(f) distinctiveness still constitutes a new issue.

> *Exception:* The examining attorney may issue a final refusal upon an applicant's initial assertion of a §2(f) claim if the amendment is irrelevant to the outstanding refusal. *See* **TMEP §714.05(a)(i).** *See also* **TMEP §§1212.02(a)** and **1212.02(i)** regarding situations where it is and is not appropriate to submit a claim of acquired distinctiveness to overcome a refusal.

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After the examining attorney has issued a nonfinal action refusing registration on the Principal Register with a finding that the applicant's evidence of secondary meaning is insufficient to overcome the stated refusal, the applicant may elect to submit additional arguments and/or evidence regarding secondary meaning. If, after considering this submission, the examining attorney is persuaded that the applicant has established a prima facie case of acquired distinctiveness, the examining attorney will approve the application for publication under §2(f). If the examining attorney is not persuaded that the applicant has established a prima facie case of acquired distinctiveness, and the application is otherwise in condition for final refusal, the examining attorney will issue a final refusal pursuant to the appropriate section of the Act (e.g., §2(e)(1)), with a finding that the applicant's evidence of acquired distinctiveness is insufficient to overcome the stated refusal. *See In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 917 n.2 (TTAB 1983).

In any action in which the examining attorney indicates that the evidence of record is insufficient to establish that the mark has acquired distinctiveness, the examining attorney must specify the reasons for this determination. *See In re Interstate Folding Box Co.,* 167 USPQ 241, 242 (TTAB 1970); *In re H. A. Friend & Co., Inc.,* 158 USPQ 609 (TTAB 1968).

1212.02(i) Section 2(f) Claim with Respect to Incapable Matter

If matter is generic, functional, or purely ornamental, or otherwise fails to function as a mark, the matter is unregistrable. *See, e.g., In re Bongrain Int'l Corp.,* 894 F.2d 1316, 1317 n.4, 13 USPQ2d 1727, 1728 n.4 (Fed. Cir. 1990) ("If a mark is generic, incapable of serving as a means 'by which the goods of the applicant may be distinguished from the goods of others' ... it is not a trademark and can not be registered under the Lanham Act."); *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.,* 782 F.2d 987, 989, 228 USPQ 528, 530 (Fed. Cir. 1986), and cases cited therein ("A generic term ... can never be registered as a trademark because such a term is 'merely descriptive' within the meaning of §2(e)(1) and is incapable of acquiring *de jure* distinctiveness under §2(f). The generic name of a thing is in fact the ultimate in descriptiveness."). *See also In re Melville Corp.*, 228 USPQ 970, 972 (TTAB 1986) (BRAND NAMES FOR LESS, for retail store services in the clothing field, "should remain available for other persons or firms to use to describe the nature of their competitive services.").

An underlying basis of refusal common in each of the situations referred to above is the failure of the matter to function as a mark within the meaning of the Trademark Act (15 U.S.C. §§1051, 1052, and 1127). *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985).

It is axiomatic that matter may not be registered unless it is used as a mark, namely, "in a manner calculated to project to purchasers or potential purchasers a single source or origin for the goods in question." *In re Remington Products Inc.,* 3 USPQ2d 1714, 1715 (TTAB 1987). *See, e.g., In re Melville Corp.*, 228 USPQ 970, 970 n.2 (TTAB 1986) ("If matter proposed for registration does not function as a mark, it is not registrable in accordance with Sections 1 and 2 of the Act because the preambles of those sections limit registration to subject matter within the definition of a trademark."); *In re Whataburger Systems, Inc.,* 209 USPQ 429, 430 (TTAB 1980) ("[A] designation may not be registered either as a trademark or as a service mark unless it is used as a mark, in such a manner that its function as an indication of origin may be readily perceived by persons encountering the goods or services in connection with which it is used.").

Therefore, where 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. *See, e.g., TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 33, 58 USPQ2d 1001, 1007 (2001) ("Functionality having been established, whether MDI'S dual spring design has acquired secondary meaning need not be considered."); *In re R.M. Smith, Inc.*, 734 F.2d 1482, 1484-85, 222 USPQ 1, 3 (Fed. Cir. 1984) ("Evidence of distinctiveness is of no avail to counter a de jure functionality rejection."); *Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549 (TTAB 2009) (stating that a product design may become generic and, thus, cannot be registered, regardless of applicant's claim of acquired distinctiveness); *In re Tilcon Warren, Inc.,* 221 USPQ 86, 88 (TTAB 1984) ("Long use of a slogan which is not a trademark and would not be so perceived does not, of course, transform the slogan into a trademark."); *In re Mancino,* 219 USPQ 1047, 1048 (TTAB 1983) ("Since the refusal ... was based on applicant's failure to demonstrate technical service mark use, the claim of distinctiveness under Section 2(f) was of no relevance to the issue in the case.").

As discussed above, evidence of acquired distinctiveness will not alter the determination that matter is unregistrable. However, the examining attorney must review the evidence and make a separate, alternative, determination as to whether, if the proposed mark is ultimately determined to be capable, the applicant's evidence is sufficient to establish acquired distinctiveness. This will provide a more complete record in the event that the applicant appeals and prevails on the underlying refusal. The examining attorney should also consider whether the applicant's evidence has any bearing on the underlying refusal. *See* **TMEP §§1209.02** *et seq.* regarding the procedure for descriptiveness and/or generic refusals.

If the examining attorney fails to separately address the sufficiency of the §2(f) evidence, this may be treated as a concession that the evidence would be sufficient to establish distinctiveness if the mark is ultimately found to be capable. *Cf. In re Dietrich,* 91 USPQ2d 1622, 1625 (TTAB 2009), in which the Board held that an examining attorney had "effectively conceded that,

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assuming the mark is not functional, applicant's evidence is sufficient to establish that the mark had acquired distinctiveness," where the examining attorney rejected the applicant's §2(f) claim on the ground that applicant's bicycle wheel configuration was functional and thus unregistrable even under §2(f), but did not specifically address the sufficiency of the §2(f) evidence or the question of whether the mark would be registrable under §2(f) issue of whether the would be registrable under 2(f) if it were ultimately found to be non-functional.

See also In re Wakefern Food Corp., 222 USPQ 76, 79 (TTAB 1984) (the Board, while finding applicant's evidence relating to public perception of WHY PAY MORE! entitled to relatively little weight, noting that the evidence is relevant to the issue of whether the slogan functions as a mark for applicant's supermarket services).

1212.02(j) Section 2(f) Claim Restricted to Particular Goods/Services/Classes

An applicant may claim acquired distinctiveness as to certain classes in a multiple-class application, or as to only a portion of the goods/services within a single class. The applicant must clearly identify the goods/services/classes for which distinctiveness is claimed. The standards for establishing acquired distinctiveness are the same whether the claim of distinctiveness pertains to all or to only a portion of the goods/services.

If the examining attorney determines that the claim of distinctiveness as to a portion of the goods/services/classes is appropriate, the examining attorney must ensure that the "§2(f)" field in the TRAM database indicates that the §2(f) claim is restricted to certain goods/services/classes, and that those goods/services/classes are clearly identified in the restriction statement of record in the USPTO database. See the following example, where the applicant is claiming §2(f) for the entire mark, but only as to a portion of the goods/services:

MISCELLANEOUS INFORMATION

SECTION 2F: YES	**SECTION 2(f) IN PART:** NO
Section 2F Restriction Statement:	The §2(f) claim is restricted to class(es) <specify classes> as to the <specify goods/services>.

See also the following example, where the applicant is claiming §2(f) in part (not as to the entire mark), restricted to a portion of the goods/services:

MISCELLANEOUS INFORMATION

SECTION 2F: NO	**SECTION 2F IN PART:** YES
Section 2F Restriction Statement:	The §2(f) in part claim is restricted to class(es) <specify classes> as to the <specify goods/services>; and to <specify which part of the mark>.

1212.03 Evidence of Distinctiveness Under §2(f)

37 C.F.R. §2.41. Proof of distinctiveness under section 2(f).

(a) When registration is sought of a mark which would be unregistrable by reason of section 2(e) of the Act but which is said by applicant to have become distinctive in commerce of the goods or services set forth in the application, applicant may, in support of registrability, submit with the application, or in response to a request for evidence or to a refusal to register, affidavits, or declarations in accordance with §2.20, depositions, or other appropriate evidence showing duration, extent and nature of use in commerce and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and affidavits, or declarations in accordance with §2.20, letters or statements from the trade or public, or both, or other appropriate evidence tending to show that the mark distinguishes such goods or services.

(b) In appropriate cases, ownership of one or more prior registrations on the Principal Register or under the Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness. Also, if the mark is said to have become distinctive of applicant's goods by reason of substantially exclusive and continuous use in commerce thereof by applicant for the five years before the date on which the claim of distinctiveness is made, a showing by way of statements which are verified or which include declarations in accordance with §2.20, in the application may, in appropriate cases, be accepted as prima facie evidence of distinctiveness. In each of these situations, however, further evidence may be required.

"To establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself." *Inwood Laboratories, Inc. v. Ives Laboratories, Inc*., 456 U.S. 844, 851 n.11, 214 USPQ 1, 4 n.11 (1982).

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1212.04 Prior Registrations as Proof of Distinctiveness

Trademark Rule 2.41(b), 37 C.F.R. §2.41(b), provides that the examining attorney may accept, as prima facie evidence of acquired distinctiveness, ownership by the applicant of one or more prior registrations of the same mark on the Principal Register or under the Act of 1905. *See* **TMEP §1212.04(b)** as to what constitutes the "same mark," and **TMEP §§1212.09** *et seq*. concerning §1(b) applications.

The rule states that ownership of existing registrations to establish acquired distinctiveness "may" be considered acceptable in "appropriate cases," and that the USPTO may, at its option, require additional evidence of distinctiveness. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001); *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985).

The following are general guidelines regarding claiming ownership of prior registrations as a method of establishing acquired distinctiveness.

1212.04(a) Sufficiency of Claim vis-à-vis Nature of the Mark

The examining attorney has the discretion to determine whether the nature of the mark sought to be registered is such that a claim of ownership of a prior registration for the same or similar goods or services is enough to establish acquired distinctiveness. For example, if the mark sought to be registered is deemed to be highly descriptive or misdescriptive of the goods or services named in the application, the examining attorney may require additional evidence of acquired distinctiveness. *See In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) (claim of ownership of a prior registration held insufficient to establish acquired distinctiveness where registration was refused as primarily geographically deceptively misdescriptive); *In re Kerr-McGee Corp.*, 190 USPQ 204 (TTAB 1976) (claim of ownership of prior registrations held insufficient to establish acquired distinctiveness where registration was refused on ground that the subject matter was merely an ornamental border or "carrier" for words and symbols appearing within).

If the term for which the applicant seeks to prove distinctiveness was disclaimed in the prior registration, the prior registration may not be accepted as prima facie evidence of acquired distinctiveness. *Kellogg Co. v. General Mills, Inc.,* 82 USPQ2d 1766 (TTAB 2007); *In re Candy Bouquet Int'l, Inc.*, 73 USPQ2d 1883 (TTAB 2004).

1212.04(b) "Same Mark"

A proposed mark is the "same mark as a previously registered mark for the purpose of 37 C.F.R. §2.41(b)" if it is the "legal equivalent" of such a mark. A mark is the legal equivalent of another if it creates the same, continuing commercial impression such that the consumer would consider them both the same mark. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1347, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001). *See also In re Brouwerij Bosteels*, __ USPQ2d ____, Ser. No. 77357895 (TTAB August 26, 2010) (three-dimensional product packaging trade dress mark is not the legal equivalent of a two-dimensional design logo); *In re Nielsen Business Media, Inc.,* 93 USPQ2d 1545 (TTAB 2010) (THE BOLLYWOOD REPORTER is not the legal equivalent of the registered marks THE HOLLYWOOD REPORTER, THEHOLLYWOODREPORTER.COM, and THE HOLLYWOOD REPORTER STUDIO BLU-BOOK); *In re Binion*, 93 USPQ2d 1531 (TTAB 2009) (BINION and BINION'S are not the legal equivalents of the registered marks JACK BINION and JACK BINION'S); *Bausch & Lomb Inc. v. Leupold & Stevens Inc.*, 6 USPQ2d 1475, 1477 (TTAB 1988) ("The words GOLDEN RING, while they are used to describe the device, are by no means identical to or substantially identical to the gold ring device trademark."); *In re Best Products Co., Inc.*, 231 USPQ 988, 989 n.6 (TTAB 1986) ("[W]e infer in the instant case that the differences between the marks BEST & Des. and BEST JEWELRY & Des., and between the identifications of services in their respective registrations, were deemed to be immaterial differences."); *In re Loew's Theatres, Inc.*, 223 USPQ 513, 514 n.5 (TTAB 1984), *aff'd,* 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) ("We do not, however, agree with the Examining Attorney that a minor difference in the marks (i.e., here, merely that the mark of the existing registration is in plural form) is a proper basis for excluding any consideration of this evidence under the rule."); *In re Flex-O-Glass, Inc.*, 194 USPQ 203, 205-06 (TTAB 1977) ("[P]ersons exposed to applicant's registered mark ... would, upon encountering [applicant's yellow rectangle and red circle design] ..., be likely to accept it as the same mark or as an inconsequential modification or modernization thereof.... [A]pplicant may 'tack on' to its use of the mark in question, the use of the registered mark ... and therefore may properly rely upon its registration in support of its claim of distinctiveness herein.").

See, e.g., Van Dyne-Crotty, Inc. v. Wear-Guard Corp., 926 F.2d 1156, 17 USPQ2d 1866 (Fed. Cir. 1991) regarding the concept of "tacking" with reference to prior use of a legally equivalent mark.

When an applicant is claiming §2(f) in part as to only a portion of its mark, then the previously registered mark must be the legal equivalent of the portion for which the applicant is claiming acquired distinctiveness.

1212.04(c) Relatedness of Goods or Services

The examining attorney should determine whether the goods or services named in the application are sufficiently similar to the

goods or services named in the prior registration(s). If the relatedness is self-evident, the examining attorney can generally accept the §2(f) claim without additional evidence. This is most likely to occur with ordinary consumer goods or services where the nature of the goods or services is commonly known and readily apparent (e.g., a prior registration for hair shampoo and new application for hair conditioner). However if the relatedness is not self-evident, the examining attorney must not accept the §2(f) claim without evidence and an explanation demonstrating the purported relatedness between the goods or services. This is especially likely to occur with industrial goods or services where there may in fact be a high degree of relatedness, but it would not be obvious to someone who is not an expert in the field. *See Bausch & Lomb Inc. v. Leupold & Stevens Inc.*, 6 USPQ2d 1475, 1478 (TTAB 1988) ("Applicant's almost total reliance on the distinctiveness which its gold ring device has achieved vis-à-vis rifle scopes and handgun scopes is simply not sufficient by itself to establish that the same gold ring device has become distinctive vis-à-vis binoculars and spotting scopes."); *In re Best Products Co., Inc.*, 231 USPQ 988, 989 n.6 (TTAB 1986) ("[W]e infer in the instant case that the differences between the marks BEST & Des. and BEST JEWELRY & Des., and between the identifications of services in their respective registrations ['mail order and catalog showroom services' and 'retail jewelry store services'], were deemed to be immaterial differences."); *In re Owens-Illinois Glass Co.*, 143 USPQ 431, 432 (TTAB 1964) (applicant's ownership of prior registration of LIBBEY for cut-glass articles held acceptable as prima facie evidence of distinctiveness of identical mark for plastic tableware, the Board stating, "Cut-glass and plastic articles of tableware are customarily sold in the same retail outlets, and purchasers of one kind of tableware might well be prospective purchasers of the other."); *In re Lytle Engineering & Mfg. Co.*, 125 USPQ 308, 309 (TTAB 1960) (applicant's ownership of prior registration of LYTLE for various services, including the planning, preparation, and production of technical publications, held acceptable as prima facie evidence of distinctiveness of identical mark for brochures, catalogs, and bulletins).

1212.04(d) Registration Must Be in Full Force and Effect and on Principal Register or under Act of 1905

Trademark Rule 2.41(b), 37 C.F.R. §2.41(b), states that ownership of a prior registration "on the Principal Register or under the Act of 1905" may be accepted as prima facie evidence of distinctiveness. Therefore, claims of acquired distinctiveness under §2(f) cannot be based on ownership of registrations on the Supplemental Register. *See In re Canron, Inc.*, 219 USPQ 820 (TTAB 1983).

Moreover, a claim of acquired distinctiveness cannot be based on a registration that is cancelled or expired. *See In re BankAmerica Corp.*, 229 USPQ 852, 853 (TTAB 1986). When an examining attorney considers a §2(f) claim based on ownership of one or more prior registrations, the examining attorney must confirm, in the records of the USPTO, that the claimed registrations were issued on the Principal Register or under the Act of 1905 and that they are in full force and effect.

1212.04(e) Form of §2(f) Claim Based on Ownership of Prior Registrations

The following language may be used to claim distinctiveness under §2(f) on the basis of ownership of one or more prior registrations:

> The mark has become distinctive of the goods (or services) as evidenced by ownership of U.S. Registration No(s). _____ on the Principal Register for the same mark for the same or related goods or services.

37 C.F.R. §2.41(b).

If the applicant is relying solely on its ownership of one or more prior registrations as proof of acquired distinctiveness, the §2(f) claim does not have to be verified. Therefore, an applicant or an applicant's attorney may authorize amendment of an application to add such a claim through an examiner's amendment, if otherwise appropriate.

1212.05 Five Years of Use as Proof of Distinctiveness

Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f), provides that "proof of substantially exclusive and continuous use" of a designation "as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made" may be accepted as prima facie evidence that the mark has acquired distinctiveness as used with the applicant's goods or services in commerce. *See also* 37 C.F.R. §2.41(b).

The Trademark Act previously required that the relevant five-year period precede the filing date of the application. The Trademark Law Revision Act of 1988, Public Law 100-667, 102 Stat. 3935, revised §2(f) of the Act to provide for a prima facie showing of acquired distinctiveness based on five years' use running up to the date the claim is made. Under the revised provision, any five-year claim submitted on or after November 16, 1989, is subject to the new time period. This applies even if the application was filed prior to that date.

Section 2(f) of the Act and 37 C.F.R. §2.41(b) state that reliance on a claim of five years' use to establish acquired distinctiveness "may" be acceptable in "appropriate cases." The USPTO may, at its option, require additional evidence of distinctiveness. Whether a claim of five years' use will be deemed acceptable to establish that the mark has acquired distinctiveness depends largely on the nature of the mark in relation to the specified goods or services.

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The following are general guidelines regarding the statutorily suggested proof of five years' use as a method of establishing acquired distinctiveness.

1212.05(a) Sufficiency of Claim Vis-à-Vis Nature of the Mark

For most surnames, the statement of five years' use will be sufficient to establish acquired distinctiveness.

The amount of evidence necessary to establish secondary meaning varies – "the greater the degree of description a term has, the heavier the burden to prove it has attained secondary meaning." *In re Bongrain Int'l Corp.*, 894 F.2d 1316, 1317 n.4, 13 USPQ2d 1727, 1728 n.4 (Fed. Cir. 1990); *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 1581, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988).

Accordingly, for marks refused under §2(e)(1) or §2(e)(2), whether the statement of five years' use is sufficient in and of itself to establish acquired distinctiveness depends on the degree to which the mark is descriptive or misdescriptive. If the mark is highly descriptive or misdescriptive of the goods or services named in the application, the statement of five years' use alone will be deemed insufficient to establish acquired distinctiveness. *See In re Noon Hour Food Products, Inc.*, 88 USPQ2d 1172 (TTAB 2008) (despite applicant's claim of use in commerce for almost one hundred years, as well as an "inadvertently cancelled" seventy-year old registration for the mark BOND-OST for cheese, the Board deemed current evidence clearly showed the mark was generic for the goods, and assuming arguendo that BOND-OST is not generic, that applicant had failed to establish acquired distinctiveness of the highly descriptive mark); *In re Crystal Geyser Water Co.*, 85 USPQ2d 1374 (TTAB 2007) (applicant's evidence of acquired distinctiveness included a claim of use since 1990, sales of more than 7,650,000,000 units of its goods, extensive display of its mark CRYSTAL GEYSER ALPINE SPRING WATER on advertising and delivery trucks and promotional paraphernalia, held insufficient to establish that the highly descriptive phrase ALPINE SPRING WATER had acquired distinctiveness for applicant's bottled spring water); *In re Kalmbach Publishing Co.*, 14 USPQ2d 1490 (TTAB 1989) (applicant's sole evidence of acquired distinctiveness, a claim of use since 1975, held insufficient to establish that the highly descriptive, if not generic, designation RADIO CONTROL BUYERS GUIDE had become distinctive of applicant's magazines); *In re Gray Inc.*, 3 USPQ2d 1558, 1559 (TTAB 1987) ("[T]o support registration of PROTECTIVE EQUIPMENT [for burglar and fire alarms and burglar and fire alarm surveillance services] on the Principal Register a showing considerably stronger than a prima facie statement of five years' substantially exclusive use is required."). *Cf. In re Synergistics Research Corp.,* 218 USPQ 165 (TTAB 1983) (applicant's declaration of five years' use held sufficient to support registrability under §2(f) of BALL DARTS for equipment sold as a unit for playing a target game, in view of lack of evidence that the term is highly descriptive (e.g., no dictionary evidence of any meaning of BALL DARTS and no evidence of use of the term by competitors or the public)).

For matter that is not inherently distinctive because of its nature (e.g., nondistinctive product container shapes, overall color of a product, mere ornamentation, and sounds for goods that make the sound in their normal course of operation), evidence of five years' use is not sufficient to show acquired distinctiveness. In such a case, actual evidence that the mark is perceived as a mark for the relevant goods or services would be required to establish distinctiveness. *See generally In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985) (color pink as uniformly applied to applicant's fibrous glass residential insulation); *In re R.M. Smith, Inc.*, 734 F.2d 1482, 222 USPQ 1 (Fed. Cir. 1984) (configuration of pistol grip water nozzle for water nozzles); *Nextel Communications, Inc. v. Motorola, Inc.,* 91 USPQ2d 1393, 1401 (TTAB 2009) (the Board noting that "the evidence required is in proportion to the degree of nondistinctiveness of the mark at issue" in relation to a sound mark emitted by cellular telephones in their normal course of operation); *In re ic! berlin brillen GmbH*, 85 USPQ2d 2021 (TTAB 2008) (configuration of an earpiece for frames for sunglasses and spectacles comprised of three "fingers" near the hinge); *In re The Black & Decker Corp.*, 81 USPQ2d 1841 (TTAB 2006) (applicant successfully established acquired distinctiveness for the design of a key head for key blanks and various metal door hardware, where evidence submitted in support thereof included over eleven years of use in commerce and significant evidence regarding industry practice, such that the evidence showed that "it is common for manufacturers of door hardware to use key head designs as source indicators…"); *Edward Weck Inc. v. IM Inc.*, 17 USPQ2d 1142 (TTAB 1990) (color green for medical instruments); *In re Cabot Corp.*, 15 USPQ2d 1224 (TTAB 1990) (configuration of a pillow-pack container for ear plugs and configuration of a pillow-pack container with trade dress (white circle surrounded by blue border) for ear plugs); *In re Star Pharmaceuticals, Inc.*, 225 USPQ 209 (TTAB 1985) (color combination of drug capsule and seeds therein for methyltestosterone); *In re Craigmyle*, 224 USPQ 791 (TTAB 1984) (configuration of halter square for horse halters).

1212.05(b) "Substantially Exclusive and Continuous"

The five years of use does not have to be exclusive, but may be "substantially" exclusive. This makes allowance for use by others that may be inconsequential or infringing, which does not necessarily invalidate the applicant's claim. *L.D. Kichler Co. v. Davoil, Inc.*, 192 F.3d 1349, 52 USPQ2d 1307 (Fed. Cir. 1999).

The existence of other applications to register the same mark, or other known uses of the mark, does not automatically eliminate the possibility of using this method of proof, but the examining attorney should inquire as to the nature of such use

and be satisfied that it is not substantial or does not nullify the claim of distinctiveness. *See Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 1403, 222 USPQ 939, 940-41 (Fed. Cir. 1984) ("When the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term or device, an application for registration under Section 2(f) cannot be successful, for distinctiveness on which purchasers may rely is lacking under such circumstances."); *Nextel Communications, Inc. v. Motorola, Inc.,* 91 USPQ2d 1393 (TTAB 2009) (opposer's contemporaneous use of the mark in connection with services closely related to applicant's goods rose to the level necessary to rebut applicant's contention of substantially exclusive use); *Target Brands, Inc. v. Hughes*, 85 USPQ2d 1676, 1682-83 (TTAB 2007) (Substantial use of mark by opposer's parent company and additional use of mark by numerous third parties "seriously undercuts if not nullifies applicant's claim of acquired distinctiveness."); *Marshall Field & Co. v. Mrs. Fields Cookies,* 11 USPQ2d 1355, 1357-58 (TTAB 1989) ("[T]he existence of numerous third party users of a mark, even if junior, might well have a material impact on the Examiner's decision to accept a party's claim of distinctiveness."); *Flowers Industries Inc. v. Interstate Brands Corp.*, 5 USPQ2d 1580, 1588-89 (TTAB 1987) ("[L]ong and continuous use alone is insufficient to show secondary meaning where the use is not substantially exclusive.").

The use of the mark during the five years must be continuous, without a period of "nonuse" or suspension of trade in the goods or services in connection with which the mark is used.

1212.05(c) Use "as a Mark"

The substantially exclusive and continuous use must be "as a mark." 15 U.S.C. §1052(f). *See In re Craigmyle*, 224 USPQ 791 (TTAB 1984) (registrability under §2(f) not established by sales over a long period of time where there was no evidence that the subject matter had been used as a mark); *In re Kwik Lok Corp.*, 217 USPQ 1245, 1248 (TTAB 1983) (declarations as to sales volume and advertising expenditures held insufficient to establish acquired distinctiveness. "The significant missing element in appellant's case is evidence persuasive of the fact that the subject matter has been used *as a mark*.").

1212.05(d) Form of the Proof of Five Years' Use

If the applicant chooses to seek registration under §2(f), 15 U.S.C. §1052(f), by using the statutory suggestion of five years of use as proof of distinctiveness, the applicant should submit a claim of distinctiveness that reads as follows, if accurate:

> The mark has become distinctive of the goods (or services) through the applicant's substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement.

The claim of five years of use is generally required to be supported by an affidavit or declaration under 37 C.F.R. §2.20, signed by the applicant. *See* 37 C.F.R. §2.41(b). The affidavit or declaration can be signed by a person properly authorized to sign on behalf of applicant under 37 C.F.R. §2.193(e)(1). *See* **TMEP §611.03(a).**

The following are guidelines regarding the form and language appropriate for a claim of five years of use:

(1) Use of the precise statutory wording is desirable, but variations may be accepted if they do not affect the essential allegations.

(2) The wording "substantially exclusive and continuous use in commerce" is essential.

(3) It must be clear from the record that the five years of use has been in commerce that may lawfully be regulated by Congress. *See Blanchard & Co., Inc. v. Charles Gilman & Son, Inc.*, 145 USPQ 62 (D. Mass. 1965), *aff'd,* 353 F.2d 400, 147 USPQ 263 (1st Cir. 1965), *cert. denied* 383 U.S. 968, 149 USPQ 905 (1966).

(4) The use of the mark must cover the five years before the date of the statement of five years' use. Thus, wording that indicates that the use referred to is before the date of the statement is essential. Its omission can only be excused if the facts in the record clearly show that the use includes the five years before the date of the statement.

(5) The affidavit or declaration should include a statement that the mark has become distinctive or that the applicant believes that the mark has become distinctive, but absence of this statement is not fatal. *See* **TMEP §1212.07** for examples of various ways in which an applicant may assert a §2(f) claim.

(6) The affidavit or declaration should contain a reference to distinctiveness as applied to the applicant's goods or services, or to use with the applicant's goods or services, because the distinctiveness created by the five years' use must relate to the goods or services specified in the application. If there is doubt that the distinctiveness pertains to either all or any of the goods or services specified in the application, the examining attorney should inquire regarding that issue. While a clarifying response does not have to be verified, a substitute statement must be verified, i.e., supported by an affidavit or a declaration under 37 C.F.R. §2.20, signed by the applicant.

1212.06 Establishing Distinctiveness by Actual Evidence

Under Trademark Rule 2.41(a), 37 C.F.R. §2.41(a), an applicant may submit affidavits, declarations under 37 C.F.R. §2.20, depositions, or other appropriate evidence showing the duration, extent, and nature of the applicant's use of a mark in commerce that may lawfully be regulated by Congress, advertising expenditures in connection with such use, letters, or statements from the trade and/or public, or other appropriate evidence tending to show that the mark distinguishes the goods or services.

Establishing acquired distinctiveness by actual evidence was explained as follows in *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1125, 227 USPQ 417, 422 (Fed. Cir. 1985):

> An evidentiary showing of secondary meaning, adequate to show that a mark has acquired distinctiveness indicating the origin of the goods, includes evidence of the trademark owner's method of using the mark, supplemented by evidence of the effectiveness of such use to cause the purchasing public to identify the mark with the source of the product.

The kind and amount of evidence necessary to establish that a mark has acquired distinctiveness in relation to goods or services depends on the nature of the mark and the circumstances surrounding the use of the mark in each case. *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988); *Roux Laboratories, Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34 (C.C.P.A. 1970); *In re Hehr Mfg. Co.*, 279 F.2d 526, 126 USPQ 381 (C.C.P.A. 1960); *In re Capital Formation Counselors, Inc.,* 219 USPQ 916 (TTAB 1983).

In considering a claim of acquired distinctiveness, the issue is whether acquired distinctiveness of the mark in relation to the goods or services has in fact been established in the minds of the purchasing public, not whether the mark is capable of becoming distinctive. *Nextel Communications, Inc. v. Motorola, Inc.,* 91 USPQ2d 1393 (TTAB 2009); *In re Redken Laboratories, Inc.*, 170 USPQ 526 (TTAB 1971); *In re Fleet-Wing Corp.,* 122 USPQ 335 (TTAB 1959).

The following sections provide examples of different types of evidence that have been used, alone or in combination, to establish acquired distinctiveness. No single evidentiary factor is determinative. The value of a specific type of evidence and the amount necessary to establish acquired distinctiveness will vary according to the facts of the specific case.

1212.06(a) Long Use of the Mark in Commerce

Long use of the mark in commerce is one relevant factor to consider in determining whether a mark has acquired distinctiveness. *See In re Uncle Sam Chemical Co., Inc.,* 229 USPQ 233 (TTAB 1986) (§2(f) claim of acquired distinctiveness of SPRAYZON for "cleaning preparations and degreasers for industrial and institutional use" found persuasive where applicant had submitted declaration of its president supporting sales figures and attesting to over eighteen years of substantially exclusive and continuous use); *In re Packaging Specialists, Inc.*, 221 USPQ 917, 920 (TTAB 1984) (evidence submitted by applicant held insufficient to establish acquired distinctiveness of PACKAGING SPECIALISTS, INC., for contract packaging services, notwithstanding, *inter alia*, continuous and substantially exclusive use for sixteen years, deemed "a substantial period but not necessarily conclusive or persuasive").

To support a §2(f) claim, use of the mark must be use in commerce, as defined in 15 U.S.C. §1127. *See* **TMEP §§901** *et seq*. as to what constitutes use in commerce.

1212.06(b) Advertising Expenditures

Large-scale expenditures in promoting and advertising goods and services under a particular mark are significant to indicate the extent to which a mark has been used. However, proof of an expensive and successful advertising campaign is not in itself enough to prove secondary meaning. *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (claim based on annual sales under the mark of approximately eighty-five million dollars, and annual advertising expenditures in excess of ten million dollars – two million of which were spent on promotions and promotional items which included the phrase THE BEST BEER IN AMERICA – found insufficient to establish distinctiveness, in view of the highly descriptive nature of the proposed mark); *Mattel, Inc. v. Azrak-Hamway Int'l, Inc.,* 724 F.2d 357, 361, 221 USPQ 302, 305 n.2 (2d Cir. 1983).

The ultimate test in determining whether a designation has acquired distinctiveness is applicant's success, rather than its efforts, in educating the public to associate the proposed mark with a single source. The examining attorney must examine the advertising material to determine how the term is being used, the commercial impression created by such use, and what the use would mean to purchasers. *Nextel Communications, Inc. v. Motorola, Inc.,* 91 USPQ2d 1393 (TTAB 2009) (opposition sustained on the ground that sound mark had not acquired distinctiveness in part because applicant failed to provide evidence corroborating that the mark was used in advertisements in such a way that it would be recognized as a source identifier for cellular telephones); *In re Redken Laboratories, Inc.*, 170 USPQ 526, 529 (TTAB 1971) (evidence adduced by applicant pursuant to §2(f) held insufficient to establish acquired distinctiveness of THE SCIENTIFIC APPROACH, for lectures concerning hair and skin treatment, notwithstanding ten years of use, over $500,000 in promotion and sponsorship expenses, and the staging of over 300 shows per year). *See also In re ic! berlin brillen GmbH*, 85 USPQ2d 2021, 2023 (TTAB 2008)

(refusal to register product configuration for spectacles and sunglasses affirmed as the applicant had failed to prove acquired distinctiveness chiefly because of the "absence of evidence of the advertising and/or promotion by the applicant of the earpiece design as a trademark"); *In re E.I. Kane, Inc.*, 221 USPQ 1203, 1206 (TTAB 1984) (refusal to register OFFICE MOVERS, INC., for moving services, affirmed notwithstanding §2(f) claim based on, *inter alia*, evidence of substantial advertising expenditures. "There is no evidence that any of the advertising activity was directed to creating secondary meaning in applicant's highly descriptive trade name."); *In re Kwik Lok Corp.,* 217 USPQ 1245 (TTAB 1983) (evidence held insufficient to establish acquired distinctiveness for configuration of bag closures made of plastic, notwithstanding applicant's statement that advertising of the closures involved several hundred thousands of dollars, where there was no evidence that the advertising had any impact on purchasers in perceiving the configuration as a mark). *Cf. In re Haggar Co.*, 217 USPQ 81, 84 (TTAB 1982) (background design of a black swatch held registrable pursuant to §2(f) for clothing where applicant had submitted, *inter alia*, evidence of "very substantial advertising and sales," the Board finding the design to be, "because of its serrated left edge, something more than a common geometric shape or design").

If the applicant prefers not to specify the extent of its expenditures in promoting and advertising goods and services under the mark because this information is confidential, the applicant may indicate the types of media through which the goods and services have been advertised (e.g., national television) and how frequently the advertisements have appeared.

1212.06(c) Affidavits or Declarations Asserting Recognition of Mark as Source Indicator

Affidavits or declarations that assert recognition of the mark as a source indicator are relevant in establishing acquired distinctiveness. However, the value of the affidavits or declarations depends on the statements made and the identity of the affiant or declarant. *In re Chemical Dynamics Inc.*, 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988) (conclusionary declaration from applicant's vice-president held insufficient without the factual basis for the declarant's belief that the design had become distinctive). Proof of distinctiveness also requires more than proof of the existence of a relatively small number of people who associate a mark with the applicant. *In re The Paint Products Co.*, 8 USPQ2d 1863, 1866 (TTAB 1988) ("Because these affidavits were sought and collected by applicant from ten customers who have dealt with applicant for many years, the evidence is not altogether persuasive on the issue of how the average customer for paints perceives the words 'PAINT PRODUCTS CO.' in conjunction with paints and coatings."). *See also In re Gray Inc.*, 3 USPQ2d 1558, 1560 (TTAB 1987) (affidavit of applicant's counsel expressing his belief that the mark has acquired secondary meaning accorded "no probative value whatsoever" because, among other reasons, the statement is subject to bias); *In re Petersen Mfg. Co.*, 2 USPQ2d 2032 (TTAB 1987) (declarations from customers which stated that designs used by applicant indicate to the declarant that the applicant is the source of the goods, but which did not refer to or identify the designs with any specificity, not considered persuasive); *In re Bose Corp.*, 216 USPQ 1001, 1005 (TTAB 1983), *aff'd,* 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985) (retailer's statement that he has been in contact with many purchasers of loudspeaker systems of whom a substantial number would recognize depicted design as originating with applicant deemed competent evidence of secondary meaning); *In re Flex-O-Glass, Inc.,* 194 USPQ 203, 206 (TTAB 1977) ("[T]he fact that the affidavits may be similar in format and expression is of no particular significance ... since the affiants have sworn to the statements contained therein.").

1212.06(d) Survey Evidence, Market Research and Consumer Reaction Studies

Survey evidence, market research, and consumer reaction studies are relevant in establishing acquired distinctiveness and secondary meaning. *Yankee Candle Co., Inc. v. Bridgewater Candle Co.*, *LLC,* 259 F.3d 25, 37, 59 USPQ2d 1720, 1730 (1st Cir. 2001) ("Although survey evidence is not required, 'it is a valuable method of showing secondary meaning,'" citing *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 42, 49 USPQ2d 1225, 1235 (1st Cir. 1998)).

To show secondary meaning, the survey must show that the public views the proposed mark as an indication of the source of the product or service. *Boston Beer Co. L.P. v. Slesar Bros. Brewing Co., Inc.*, 9 F.3d 175, 28 USPQ2d 1778 (1st Cir. 1993) (survey found insufficient to establish acquired distinctiveness where survey demonstrates product-place association rather than product-source association); *Nextel Communications, Inc. v. Motorola, Inc.,* 91 USPQ2d 1393 (TTAB 2009). The applicant must document the procedural and statistical accuracy of this type of evidence and carefully frame the questions contained therein. *See In re Steelbuilding.com,* 415 F.3d 1293, 1300, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005) (applicant's Internet poll on name recognition deemed unreliable, where the poll did not attempt to prevent visitors from voting more than once or to prevent interested parties such as friends or associates or employees of the applicant from voting multiple times, and the poll results did not indicate the number of actual participants); *In re E.I. Kane, Inc.*, 221 USPQ 1203, 1206 (TTAB 1984) ("[T]he survey asked the wrong question. The issue is not whether the term 'Office Movers' identifies a specific company. Rather, it is whether the term 'OFFICE MOVERS, INC.' identifies services which emanate from a single source."); *General Foods Corp. v. Ralston Purina Co.*, 220 USPQ 990, 994 n.7 (TTAB 1984) ("[W]here ... [reports of market research, consumer reaction studies] have been conducted for marketing reasons rather than directly to assist in resolving the issues in proceedings before us, their value will almost always depend on interpretations of their significance by witnesses or other evidence."); *Specialty Brands, Inc. v. Spiceseas, Inc.*, 220 USPQ 73, 74 n.4 (TTAB 1983) (testimony concerning survey results, unsupported by documentation, considered unreliable hearsay).

1212.06(e) Miscellaneous Considerations Regarding Evidence Submitted to Establish Distinctiveness

1212.06(e)(i) First or Only User

When the applicant is the only source of the goods or services, use alone does not automatically represent trademark recognition and acquired distinctiveness. *See, e.g.*, *J. Kohnstam, Ltd. v. Louis Marx & Co., Inc.*, 280 F.2d 437, 126 USPQ 362 (C.C.P.A. 1960); *In re Mortgage Bankers Ass'n of America*, 226 USPQ 954 (TTAB 1985); *In re National Shooting Sports Foundation, Inc.,* 219 USPQ 1018 (TTAB 1983); *In re Meier's Wine Cellars, Inc.*, 150 USPQ 475 (TTAB 1966); *In re G. D. Searle & Co.*, 143 USPQ 220 (TTAB 1964), *aff'd,* 360 F.2d 650, 149 USPQ 619 (C.C.P.A. 1966).

1212.06(e)(ii) State Trademark Registrations

State trademark registrations are of relatively little probative value. *See*, *e.g.*, *In re Vico Products Mfg. Co., Inc.*, 229 USPQ 364, 370 (TTAB 1985), *recon. denied*, 229 USPQ 716 (TTAB 1986) ("While applicant's design may be registrable under the provisions of California trademark law, it is the federal trademark statute and the cases interpreting it by which we must evaluate the registrability of applicant's asserted mark."); *In re Craigmyle*, 224 USPQ 791, 794 (TTAB 1984).

1212.06(e)(iii) Design Patent

The fact that a device is the subject of a design patent does not, without more, mean that it functions as a mark or has acquired distinctiveness. *See*, *e.g.*, *In re Vico Products Mfg. Co., Inc.*, 229 USPQ 364, 370 (TTAB 1985), *recon. denied*, 229 USPQ 716 (TTAB 1986).

1212.06(e)(iv) Acquiescence to Demands of Competitors

Acquiescence to demands of competitors to cease use of a term can be equally viewed as simply a desire to avoid litigation. *See*, *e.g.*, *In re Wella Corp.*, 565 F.2d 143, 144 n.2, 196 USPQ 7, 8 n.2 (C.C.P.A. 1977); *In re Consolidated Cigar Corp.*, 13 USPQ2d 1481 (TTAB 1989).

1212.07 Form of Application Asserting Distinctiveness

To base a registration on acquired distinctiveness under §2(f), 15 U.S.C. §1052(f), an applicant must indicate its intent to do so.

The indication of the applicant's intent to rely on §2(f) can take a variety of forms, for example, a statement that registration is requested under §2(f); a statement that the mark has become distinctive, or that the applicant believes the mark has become distinctive of the goods or services in commerce; the statement relating to five years' use in commerce as suggested in §2(f); or a statement that evidence is being submitted in support of acquired distinctiveness.

If it is unclear from the application whether a claim of distinctiveness under §2(f) has been made, the examining attorney should inquire whether the applicant is seeking registration under §2(f). *See* **TMEP §1212.02(d)** concerning unnecessary §2(f) claims.

If the statement requesting registration under §2(f) and the evidence submitted to establish acquired distinctiveness are in the application when filed, the §2(f) statement and proof are supported by the verification of the application.

If a claim of distinctiveness pursuant to §2(f) is submitted as an amendment, or if additional evidence is added in an amendment, the nature of the proof submitted to establish acquired distinctiveness determines whether a verification is necessary.

A claim of ownership of one or more prior registrations as proof of distinctiveness does not have to be verified. *See* **TMEP §1212.04(e).**

If the applicant claims that the mark has become distinctive of the applicant's goods/services through substantially exclusive and continuous use of the mark in commerce by the applicant for the five years before the date on which the claim of distinctiveness is made, the applicant must submit this claim in the form of an affidavit, or a declaration in accordance with 37 C.F.R. §2.20, signed by the applicant. 15 U.S.C. §1052(f); 37 C.F.R. §2.41(b); **TMEP §1212.05(d).** *See* 37 C.F.R. §2.193(e)(1) and **TMEP §611.03(a)** regarding persons properly authorized to sign on behalf of applicant.

If an application is amended to add a §2(f) claim relying on other types of evidence, there may be considerable flexibility as to form. While statements by the applicant regarding advertising or sales figures or other facts that may show acquired distinctiveness would normally be presented in the form of affidavits, or declarations under 37 C.F.R. §2.20, signed by the applicant, verification may not be required for other types of evidence. The examining attorney will determine whether the evidence relied on is of a nature that requires that it be verified by the applicant.

1212.08 Section 44 and §66(a) Applications and Distinctiveness

In applications based on §44(d), §44(e), or §66(a) of the Trademark Act, registration may be sought under §2(f) as to the entire mark upon showing that the mark has acquired distinctiveness in commerce that may lawfully be regulated by Congress. *See In re Etablissements Darty et Fils*, 759 F.2d 15, 18, 225 USPQ 652, 654 (Fed. Cir. 1985). Similarly, registration may be sought under §2(f) in part upon showing that the *relevant part of the mark* has acquired distinctiveness in commerce that may lawfully be regulated by Congress. *Id*. The same standards for establishing acquired distinctiveness apply whether the application is based on §1(a), §44, or §66(a). Although dates of first use are not required in applications based solely on §44 or §66(a), reference to length of use in commerce or information as to specific dates of use in commerce, presented in support of the claim of acquired distinctiveness, is clearly relevant to a determination of the acceptability of the claim.

The applicant may not rely on use other than use in commerce that may be regulated by the United States Congress in establishing acquired distinctiveness. Evidence of use solely in a foreign country, or between two foreign countries, is not evidence of acquired distinctiveness in the United States. *In re Rogers*, 53 USPQ2d 1741 (TTAB 1999).

1212.09 Section 1(b) Applications and Distinctiveness

1212.09(a) Section 2(f) Claim Requires Prior Use

Section 2(f), 15 U.S.C. §1052(f), is limited by its terms to "a mark used by the applicant." A claim of distinctiveness under §2(f) is normally not filed in a §1(b) application before the applicant files an amendment to allege use or a statement of use, because a claim of acquired distinctiveness, by definition, requires prior use.

However, an intent-to-use applicant who has used the mark on related goods or services may file a claim of acquired distinctiveness under §2(f) before filing an amendment to allege use or statement of use, if the applicant can establish that, as a result of the applicant's use of the mark on other goods or services, the mark has become distinctive of the goods or services in the intent-to-use application, and that this previously created distinctiveness will transfer to the goods and services in the intent-to-use application when use in commerce begins. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1347, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001).

The Trademark Trial and Appeal Board has set forth the requirements for showing that a mark in an intent-to-use application has acquired distinctiveness:

> The required showing is essentially twofold. First, applicant must establish, through the appropriate submission, the acquired distinctiveness of the same mark in connection with specified other goods and/or services in connection with which the mark is in use in commerce. All of the rules and legal precedent pertaining to such a showing in a use-based application are equally applicable in this context.... Second, applicant must establish, through submission of relevant evidence rather than mere conjecture, a sufficient relationship between the goods or services in connection with which the mark has acquired distinctiveness and the goods or services recited in the intent-to-use application to warrant the conclusion that the previously created distinctiveness will transfer to the goods or services in the application upon use.

In re Rogers, 53 USPQ2d 1741, 1744 (TTAB 1999).

To satisfy the first element, the applicant must establish acquired distinctiveness as to the other goods or services by appropriate evidence, such as ownership of a prior registration for the same mark for related goods or services (*see* **TMEP §§1212.04** *et seq*.), a prima facie showing of acquired distinctiveness based on five years' use of the same mark with related goods or services (*see* **TMEP §§1212.05** *et seq*.), or actual evidence of acquired distinctiveness for the same mark with respect to the other goods or services (*see* **TMEP §§1212.06** *et seq*.). *See In re Nielsen Business Media, Inc.,* 93 USPQ2d 1545 (TTAB 2010) (applicant failed to meet the first requirement, because the intent-to-use mark THE BOLLYWOOD REPORTER was not deemed to be the "same" mark as the previously registered marks THE HOLLYWOOD REPORTER, THEHOLLYWOODREPORTER.COM, and THE HOLLYWOOD REPORTER STUDIO BLU-BOOK); *In re Binion*, 93 USPQ2d 1531 (TTAB 2009) (applicant failed to meet the first requirement, because the intent-to-use marks BINION and BINION'S were not deemed to be the "same" marks as the previously registered marks JACK BINION and JACK BINION'S).

To satisfy the second element, applicant must show "the extent to which the goods or services in the intent-to-use application are related to the goods or services in connection with which the mark is distinctive, and that there is a strong likelihood that the mark's established trademark function will transfer to the related goods or services when use in commerce occurs." *Rogers,* 53 USPQ2d at 1745.

The showing necessary to establish relatedness will vary from case to case, depending on the nature of the goods or services involved and the language used to identify them. There is no absolute rule that applicant must submit extrinsic evidence to support its contention that the goods are related in every case. *Kellogg Co. v. General Mills, Inc.,* 82 USPQ2d 1766 (TTAB

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2007) (close relationship between cereal and food bars derived from cereal deemed "self evident from the respective identifications of goods").

The fact that a mark is famous in connection with certain goods or services does *not* necessarily lead to the conclusion that, upon use, distinctiveness will transfer to use of the mark in connection with unrelated goods or services in an intent-to-use application. In *Rogers,* the Board stated that:

> The owner of a famous mark must still establish a strong likelihood of transference of the trademark function to the goods or services identified in the intent-to-use application. This factually-based determination will still involve establishing some degree of relationship between the goods or services for which the mark is famous and the goods or services in the intent-to-use application.

53 USPQ2d at 1745-1746.

An applicant whose application is based on use in commerce under 15 U.S.C. §1051(a) may also base a claim of acquired distinctiveness under §2(f) on long use of the mark on related goods or services, if the applicant meets the requirements set forth above.

1212.09(b) Claim of §2(f) "in Part" in §1(b) Applications

An intent-to-use applicant may assert a claim of acquired distinctiveness under §2(f) of the Trademark Act as to part of a mark prior to filing an acceptable amendment to allege use or statement of use. The claim must indicate that the applicant has already used the relevant part of the mark in commerce on or in connection with the specified goods or services, or related goods or services as discussed above. *See* **TMEP §1212.02(f)** regarding claims of §2(f) distinctiveness "in part."

The requirements to support such a claim are twofold. First, the applicant must establish acquired distinctiveness through the same methods required in a use-based application. *See* **TMEP §1212.02(f)(i).** Evidence in support of such a claim may consist of: (1) ownership of a prior registration on the Principal Register covering the relevant portion of the mark and the same or related goods or services (*see* **TMEP §§1212.04** *et seq*.); (2) a prima facie showing of distinctiveness based on five years' use of the relevant portion of the mark with the same or related goods or services (*see* **TMEP §§1212.05** *et seq*.); or (3) actual evidence of acquired distinctiveness of the relevant portion of the mark with respect to the same or related goods or services (*see* **TMEP §§1212.06** *et seq*.).

Second, if the relevant portion of the mark has been used with related, as opposed to identical, goods or services, the applicant must additionally show "the extent to which the goods or services in the intent-to-use application are related to the goods or services in connection with which the mark is distinctive, and that there is a strong likelihood that the mark's established trademark function will transfer to the related goods or services when use in commerce occurs." *In re Rogers*, 53 USPQ2d 1741, 1745 (TTAB 1999); *see* **TMEP §1212.09(a).**

If the examining attorney determines that the applicant has established acquired distinctiveness as to the relevant portion of the mark, the examining attorney should withdraw any refusal related to the nondistinctive character of that part of the mark.

1212.10 Printing §2(f) Notations, §2(f) in Part Notations, and Limitation Statements

Currently, when a mark is registered under §2(f), the USPTO prints a "2(f)" notation in the *Official Gazette* and on the certificate of registration. The examining attorney must ensure that the §2(f) claim has been entered into the TRAM database, so that it will be printed in the *Official Gazette* and on the certificate of registration. Similarly, when a claim of §2(f) in part is appropriate, the examining attorney must ensure that the record reflects that the §2(f) claim applies only to a portion of the mark and that the relevant portion is correctly identified in the limitation statement. *See* **TMEP §817** regarding preparation of an application for publication or issuance. For example, if the mark is SOFTSOAP for liquid soap and the applicant has successfully shown acquired distinctiveness, the examining attorney must ensure that the "§2(f)" field in the TRAM database reads as follows before approving the mark for publication:

MISCELLANEOUS INFORMATION

SECTION 2F: YES **SECTION 2F IN PART:** NO

Similarly, if the mark is SOFTSOAP combined with an inherently distinctive design for liquid soap and the applicant has successfully shown acquired distinctiveness as to the wording in the mark, the examining attorney must ensure that the "§2(f)" field in the TRAM database reads as follows before approving the mark for publication:

MISCELLANEOUS INFORMATION

SECTION 2F: NO **SECTION 2F IN PART:** YES

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2F Limitation Statement: as to "SOFTSOAP"

In the past, the USPTO did not print §2(f) notations. Therefore, the absence of a "§2(f)" notation on an older registration does not necessarily mean that the mark was registered without resort to §2(f).

1213 Disclaimer of Elements in Marks

15 U.S.C. §1056. Disclaimers.

(a) The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable. An applicant may voluntarily disclaim a component of a mark sought to be registered.

(b) No disclaimer, including those made under subsection (e) of section 7 of this Act, shall prejudice or affect the applicant's or registrant's rights then existing or thereafter arising in the disclaimed matter, or his right of registration on another application if the disclaimed matter be or shall have become distinctive of his goods or services.

A disclaimer is a statement that the applicant or registrant does not claim the exclusive right to use a specified element or elements of the mark in a trademark application or registration. A disclaimer may be included in an application as filed or may be added by amendment, e.g., to comply with a requirement by the examining attorney.

The purpose of a disclaimer is to permit the registration of a mark that is registrable as a whole but contains matter that would not be registrable standing alone, without creating a false impression of the extent of the registrant's right with respect to certain elements in the mark. As stated in *Horlick's Malted Milk Co. v. Borden Co.*, 295 F. 232, 234, 1924 C.D. 197, 199 (D.C. Cir. 1924):

> [T]he fact that a mark contains descriptive words is not enough to warrant a refusal to register it. Unless it consists only of such words, it may not be refused a place on the registry of the Patent Office.

The significance of a disclaimer is conveyed in the following statement:

> As used in trade mark registrations, a disclaimer of a component of a composite mark amounts merely to a statement that, in so far as that particular registration is concerned, no rights are being asserted in the disclaimed component standing alone, but rights are asserted in the composite; and the particular registration represents only such rights as flow from the use of the composite mark.

Sprague Electric Co. v. Erie Resistor Corp., 101 USPQ 486, 486-87 (Comm'r Pats. 1954).

A disclaimer may be limited to pertain to only certain classes, or to only certain goods or services.

1213.01 History of Disclaimer Practice

There was no statutory authority for disclaimer prior to 1946. As various court decisions were rendered, USPTO practice fluctuated from, first, registering the composite mark without a qualifying statement; later, requiring a statement in the application disclaiming the unregistrable matter in the mark; and, finally, requiring removal of the unregistrable matter from the mark on the drawing. This fluctuation ended with the decision of *Estate of P.D. Beckwith v. Comm'r of Pats.*, 252 U.S. 538, 1920 C.D. 471 (1920), in which the United States Supreme Court held that to require the removal of descriptive matter from a composite mark was erroneous, and commended the practice of a statement of disclaimer. Thus, the practice of disclaimer was established officially in the USPTO, although still without statutory support.

The Trademark Act of 1946 created a statutory basis for the practice of disclaimer in §6, 15 U.S.C. §1056.

1213.01(a) Discretion in Requiring Disclaimer

When first incorporated in the Trademark Act in 1946, §6 stated that the Director *shall* require unregistrable matter to be disclaimed. Under the impetus of the mandatory word "shall," it became customary to require a disclaimer for every occurrence, in any type of combination, of every term or symbol which by itself might be refused registration in the first instance under the 1946 Act.

In 1962, §6 was amended to state that the Director *may* require the applicant to disclaim an unregistrable component of a mark otherwise registrable. The change from "shall" to "may" justifies the exercise of greater discretion by examining attorneys in determining whether a disclaimer is necessary.

Examining attorneys should keep in mind the basic purpose of disclaimers, which is to indicate in the record that a significant element of a composite mark is not being appropriated apart from the composite. The examining attorney should not require that an element of a mark be disclaimed when a disclaimer would be unnecessary, e.g., when the form or degree of integration

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of an element in the composite makes it obvious that no claim is being made in any element apart from the composite.

1213.01(b) Refusal to Register Because of Failure to Disclaim

Failure to comply with a requirement to disclaim was held to be a basis for refusal to register before the Act of 1946. *See In re American Cyanamid & Chemical Corp.,* 99 F.2d 964, 39 USPQ 445 (C.C.P.A. 1938). Failure to comply with a requirement to disclaim also was held to justify a refusal after the 1946 Act. *See In re Hercules Fasteners, Inc.*, 203 F.2d 753, 97 USPQ 355 (C.C.P.A. 1953). Even after amendment of the pertinent language of §6 of the 1946 Act to the discretionary wording "may require the applicant to disclaim," registration may be refused if an applicant does not comply with a requirement for a disclaimer made by the examining attorney. *See In re Slokevage*, 441 F.3d 957, 78 USPQ2d 1395 (Fed. Cir. 2006); *In re Stereotaxis Inc., 429 F.3d 1039, 77 USPQ2d 1087 (Fed. Cir. 2005); In re Omaha Nat'l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Richardson Ink Co.,* 511 F.2d 559, 185 USPQ 46 (C.C.P.A. 1975); *In re National Presto Industries, Inc.*, 197 USPQ 188 (TTAB 1977); *In re Pendleton Tool Industries, Inc.*, 157 USPQ 114 (TTAB 1968).

If an applicant fails to comply with the examining attorney's requirement for a disclaimer, the examining attorney should make the requirement final if the application is otherwise in condition for a final action.

1213.01(c) Voluntary Disclaimer of Registrable or Unregistrable Matter

Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), was amended in 1962 to add the sentence, "An applicant may voluntarily disclaim a component of a mark sought to be registered." Disclaimers volunteered by applicants generally should conform to the guidelines set forth in this Manual. *See* **TMEP §§1213.08** *et seq.*

In *In re MCI Communications Corp.*, 21 USPQ2d 1534 (Comm'r Pats. 1991), the Commissioner held that §6 of the Act permits an applicant to disclaim matter voluntarily, regardless of whether the matter is registrable or unregistrable. The Commissioner specifically overruled all previous USPTO authority holding otherwise. (Previous practice prohibited the entry of disclaimers of registrable components of marks.) Therefore, if an applicant offers a disclaimer of any matter in a mark, the USPTO will accept the disclaimer.

The *MCI* decision states emphatically that the entry of a voluntary disclaimer does *not* render registrable a mark that is otherwise unregistrable under relevant sections of the Trademark Act, such as §2(d) or §2(e). *See In re RSI Systems, LLC*, 88 USPQ2d 1445, 1448 (TTAB 2008) (voluntary disclaimer of "RSI" has no legal effect on the issue of likelihood of confusion because it is not a weak term). The examining attorney must evaluate the entire mark, including any disclaimed matter, to determine registrability. Furthermore, the decision states that the applicant may not disclaim the entire mark. *See* **TMEP §1213.06.**

An applicant may volunteer a disclaimer in the mistaken belief that a disclaimer would be required when, in fact, USPTO policy would not require a disclaimer. If this appears to be the case, the examining attorney should offer the applicant the opportunity to withdraw the disclaimer. If it is necessary to communicate with the applicant about another matter, the examining attorney should state in the Office action that the disclaimer appears to be unnecessary, and inquire as to whether the applicant wants to withdraw the disclaimer. If it is otherwise unnecessary to communicate with the applicant, the inquiry may be made by telephone or e-mail. If the applicant wants to delete the disclaimer, this may be done by examiner's amendment. If the applicant does not respond promptly to the telephone or e-mail message (applicant should be given at least a week), the examining attorney should enter a note in the "Notes-to-the-File" section of the record and approve the application for publication for opposition or registration on the Supplemental Register without deleting the disclaimer.

1213.02 "Composite" Marks

A "composite" mark may consist of a word or words combined with a design or designs; it may consist solely of words, when there are separable word elements; or it may consist solely of separable design elements. An unregistrable component of a composite mark is subject to disclaimer. However, if a composite mark (or portion thereof) is "unitary," an individual component of the mark (or of the unitary portion) that would otherwise be unregistrable need not be disclaimed. *See* **TMEP §§1213.05** *et seq*.

The same principles apply to disclaimer of an unregistrable component of a composite mark, whether the mark is a combination of wording and designs or consists entirely of wording or entirely of designs.

1213.03 Disclaimer of Unregistrable Components of Marks

1213.03(a) "Unregistrable Components" in General

Estate of P.D. Beckwith v. Comm'r of Pats., 252 U.S. 538, 1920 C.D. 471 (1920), and other disclaimer decisions before the Trademark Act of 1946 dealt with disclaiming descriptive or generic matter. Section 6 of the Act referred initially to "unregistrable matter" and, since the 1962 amendment, now refers to "an unregistrable component."

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Typically, an unregistrable component of a registrable mark is the name of the goods or services, other matter that does not indicate source, matter that is merely descriptive or deceptively misdescriptive of the goods or services, or matter that is primarily geographically descriptive of the goods or services.

Office practice does not require disclaimer of a surname. *Ex parte Norquist Products, Inc.*, 109 USPQ 399 (Comm'r Pats. 1956) (disclaimer of "NORQUIST" found unnecessary in application to register mark comprising "NORQUIST CORONET" on an oval background featuring a coronet, for tables and chairs). In that decision, the Commissioner stated as follows:

> Section [2(e)(4)] of the statute does not contemplate the dissection of a composite mark to determine whether a word which constitutes an integral part of the mark is primarily merely a surname. Rather, it contemplates an examination of the mark in its entirety and an evaluation of the commercial impression created by the entire mark. A word which is primarily merely a surname may lose that significance when it appears in a distinctive composite.

Id., at 400. The addition of other registrable matter creates a composite mark with an overall impression that is not primarily merely that of a surname. If the additional matter is minimal or unregistrable, then the mark is primarily merely a surname and refusal under §2(e)(4) of the Act, 15 U.S.C. §1052(e)(4) (formerly §2(e)(3), 15 U.S.C. §1052(e)(3)), should be made. *See In re E. Martinoni Co.*, 189 USPQ 589 (TTAB 1975). *See* **TMEP §§1211.01(b)** *et seq*. regarding the combination of a surname with additional matter.

In cases where registration of a mark is barred under the Trademark Act (e.g., under §§2(a), 2(b), 2(c), 2(d), and 2(e)(3)), a disclaimer of an unregistrable component will not render the mark registrable. *See, e.g., American Speech-Language-Hearing Ass'n v. National Hearing Aid Society,* 224 USPQ 798, 808 (TTAB 1984) ("While the disclaimer is appropriate to indicate that respondent claims no proprietary right in the disclaimed words, the disclaimer does not affect the question of whether the disclaimed matter deceives the public, since one cannot avoid the Section 2(a) deceptiveness prohibition by disclaiming deceptive matter apart from the mark as a whole."). *See* **TMEP §1213.10** concerning disclaimers with regard to likelihood of confusion, and **TMEP §§1210.06(a)** and **(b)** regarding disclaimer of geographic terms in composite marks.

1213.03(b) Generic Matter and Matter Which Does Not Function as a Mark

If a mark is comprised in part of matter that, as applied to the goods/services, is generic or does not function as a mark, the matter must be disclaimed to permit registration on the Principal Register (including registration under §2(f) of the Act) or on the Supplemental Register. If, however, matter that would otherwise be generic or would not function as a mark is part of a unitary mark or part of a separable unitary element of a mark, the examining attorney should not require a disclaimer of the matter. *See* **TMEP §1213.05.**

See **TMEP §1212.02(e)** regarding disclaimers of unregistrable components in applications to register marks on the Principal Register under §2(f). *See also In re Creative Goldsmiths of Washington, Inc.*, 229 USPQ 766, 768 (TTAB 1986) ("[I]t is within the discretion of an Examining Attorney to require the disclaimer of an unregistrable component (such as a common descriptive, or generic, name) of a composite mark sought to be registered on the Principal Register under the provisions of Section 2(f).").

Regarding disclaimers of unregistrable components in applications to register marks on the Supplemental Register, *see In re Water Gremlin Co.*, 635 F.2d 841, 845 n.6, 208 USPQ 89, 91 n.6 (C.C.P.A. 1980) ("Section 6 is equally applicable to the Supplemental Register."); *In re Wella Corp.*, 565 F.2d 143, 196 USPQ 7 (C.C.P.A. 1977) (mark comprising stylized lettering of BALSAM, with disclaimer of "BALSAM," found registrable on Supplemental Register for hair conditioner and hair shampoo); *In re Carolyn's Candies, Inc.*, 206 USPQ 356, 360 (TTAB 1980) ("Section 6 of the Trademark Act of 1946, which provides for the disclaimer of 'unregistrable matter', does not limit the disclaimer practice to marks upon the Principal Register.").

1213.03(c) Pictorial Representations of Descriptive Matter

An accurate pictorial representation of descriptive matter is equivalent to the written expression and, therefore, must be disclaimed pursuant to the same rules applicable to merely descriptive wording. *See Thistle Class Ass'n v. Douglass & McLeod, Inc.*, 198 USPQ 504 (TTAB 1978) (thistle design found synonymous to the word "thistle," which is used in a descriptive sense to designate a class of sailboats).

A properly worded disclaimer would read as follows:

> No claim is made to the exclusive right to use the design of "____" apart from the mark as shown.

No disclaimer of highly stylized pictorial representations of descriptive matter should be required because the design element creates a distinct commercial impression. *See In re LRC Products Ltd.*, 223 USPQ 1250, 1252 (TTAB 1984) (outline of two gloved hands held arbitrary and fanciful), and cases cited therein.

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1213.03(d) Entity Designations

Words or abbreviations in a trade name designating the legal character of an entity (e.g., Corporation, Corp., Co., Inc., Ltd., etc.) or the familial business structure of an entity (e.g., "& Sons" or "Bros.") must be disclaimed because an entity designation has no source-indicating capacity. *In re Piano Factory Group, Inc*., 85 USPQ2d 1522 (TTAB 2006) (holding VOSE & SONS primarily merely a surname); *In re Taylor & Francis [Publishers] Inc.*, 55 USPQ2d 1213, 1215 (TTAB 2000) ("PRESS," as applied to a printing or publishing establishment, "is in the nature of a generic entity designation which is incapable of serving a source-indicating function"); *In re The Paint Products Co*., 8 USPQ2d 1863, 1866 (TTAB 1988) ("'PAINT PRODUCTS CO.' is no more registrable for goods emanating from a company that sells paint products than it would be as a service mark for the retail paint store services offered by such a company"); *In re Packaging Specialists, Inc.*, 221 USPQ 917, 919 (TTAB 1984) ("the element 'INC.' [in PACKAGING SPECIALISTS, INC.] being recognized, in trademark evaluation, to have no source indication or distinguishing capacity"); Further, such designations must also be disclaimed in marks seeking registration on the Principal Register under §2(f) or on the Supplemental Register.

The only exception to this practice is where the entity designation is used in an arbitrary manner (e.g., "THE LTD." or "KIDS INC." for clothing or CHUCKLE BROS. for a comic strip). In this case, the term has trademark significance and a disclaimer should not be required.

1213.04 Trade Names

Unregistrable components of trade names or company names shall be disclaimed pursuant to the same rules that apply generally to trademarks. *See In re Martin's Famous Pastry Shoppe, Inc.*, 221 USPQ 364 (TTAB 1984), *aff'd on other grounds*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

1213.05 "Unitary" Marks

A mark or portion of a mark is considered "unitary" when it creates a commercial impression separate and apart from any unregistrable component. That is, the elements are so merged together that they cannot be divided to be regarded as separable elements. If the matter that comprises the mark or relevant portion of the mark is unitary, no disclaimer of an element, whether descriptive, generic, or otherwise, is required.

The examining attorney must consider a number of factors in determining whether matter is part of a single or unitary mark: whether it is physically connected by lines or other design features; the relative location of the respective elements; and the meaning of the terminology as used on or in connection with the goods or services. *Dena Corp. v. Belvedere Int'l Inc.*, 950 F.2d 1555, 1561, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991).

For example, a descriptive word can be combined with nondescriptive wording in such a way that the descriptive significance of the word in relation to the goods is lost and the combination functions as a unit. This happens when the combination itself has a new meaning. An example is the term "Black Magic," which has a distinct meaning of its own as a whole. The word "black" is not intended to have color significance in relation to the goods, and should not be disclaimed even if the mark is applied to goods that are black in color.

In the following cases, marks were considered unitary: *B. Kuppenheimer & Co., Inc. v. Kayser-Roth Corp.*, 326 F.2d 820, 822, 140 USPQ 262, 263 (C.C.P.A. 1964) (KUPPENHEIMER and SUP-PANTS combined so that they shared the double "P," making "an indivisible symbol rather than two divisible words"); *In re Hampshire-Designers, Inc.*, 199 USPQ 383 (TTAB 1978) (DESIGNERS PLUS+ for sweaters held unitary; thus, no disclaimer of "DESIGNERS" deemed necessary); *In re J.R. Carlson Laboratories, Inc.*, 183 USPQ 509 (TTAB 1974) (E GEM for bath oil containing vitamin E held unitary; thus, no disclaimer of "E").

In the following cases, marks were found *not* to be unitary: *In re Slokevage*, 441 F.3d 957, 78 USPQ2d 1395 (Fed. Cir. 2006) (trade dress for clothing consisting of a label with the words "FLASH DARE!" in a V-shaped background and cut-out areas located on each side of the label, with the cut-out areas consisting of a hole in a garment and a flap attached to the garment with a closure device held not unitary); *In re Ginc UK Ltd.*, 90 USPQ2d 1472 (TTAB 2007) (ZOGGS TOGGS for clothing not unitary; requirement for disclaimer of "TOGGS" affirmed); *In re Brown-Forman Corp.*, 81 USPQ2d 1284 (TTAB 2006) (GALA ROUGE for wine not unitary; requirement for disclaimer of "ROUGE" affirmed); *Dena Corp., supra* (EUROPEAN FORMULA above a circular design on a dark square or background considered not unitary); *In re Lean Line, Inc.*, 229 USPQ 781 (TTAB 1986) (LEAN LINE for low calorie foods considered not unitary; requirement for disclaimer of "LEAN" held proper); *In re IBP, Inc.*, 228 USPQ 303 (TTAB 1985) (IBP SELECT TRIM for pork considered not unitary; refusal of registration in the absence of a disclaimer of "SELECT TRIM" affirmed); *In re Uniroyal, Inc.*, 215 USPQ 716 (TTAB 1982) (UNIROYAL STEEL/GLAS for vehicle tires considered not unitary; requirement for disclaimer of "STEEL/GLAS" deemed appropriate); *In re EBS Data Processing, Inc.*, 212 USPQ 964, 966 (TTAB 1981) (PHACTS POCKET PROFILE, for personal medication history summary and record forms, considered not unitary; refusal to register in the absence of a disclaimer of "POCKET PROFILE" affirmed. "A disclaimer of a descriptive portion of a composite mark is unnecessary only where the form or degree of integration of that

element in the composite makes it obvious that no claim other than of the composite would be involved. That is, if the elements are so merged together that they cannot be regarded as separable elements, the mark is a single unitary mark and not a composite mark and no disclaimer is necessary."); *In re National Presto Industries, Inc.,* 197 USPQ 188 (TTAB 1977) (PRESTO BURGER for electrical cooking utensils not unitary; requirement for disclaimer of "BURGER" affirmed).

The examining attorney must exercise discretion in determining whether a mark or portion of a mark is unitary, in which case a disclaimer of a nondistinctive component should not be required. It is not always easy to articulate why matter is unitary. However, if one cannot spell out exactly why a mark is unitary, then the mark is probably not unitary and nondistinctive elements within the mark must be disclaimed. In general, a mark is unitary if the whole is something more than the sum of its parts.

See **TMEP §§1213.05(a)-(g)** for examples of different types of unitary marks.

1213.05(a) Compound Word Marks

A compound word mark is comprised of two or more distinct words (or words and syllables) that are represented as one word (e.g., BOOKCHOICE, PROSHOT, MAXIMACHINE, and PULSAIR).

If a compound word mark consists of an unregistrable component and a registrable component combined into a single word, no disclaimer of the unregistrable component of the compound word will be required.

If a composite mark consists of a compound word combined with arbitrary matter, and the compound word is unregistrable, a disclaimer of the compound word may be required. The form of the disclaimer of the compound word – i.e., whether the disclaimed portion of the mark appears as one compound word or as two or more distinct words – should be consistent with the evidence of descriptiveness. If the compound word itself (with no spaces) is used descriptively, it should be disclaimed in that form. Otherwise, the disclaimed portion should appear as two or more distinct words, separated by spaces. *See* **TMEP §1213.08(c)** regarding disclaimer of misspelled words.

See **TMEP §807.12(e)** regarding drawings of compound word marks.

1213.05(a)(i) Telescoped Words

A telescoped mark is one that comprises two or more words that share letters (e.g., HAMERICAN, ORDERECORDER, SUPERINSE, VITAMINSURANCE, and POLLENERGY). *See* **TMEP §807.12(e)** regarding drawings for telescoped marks.

A telescoped word is considered unitary. Therefore, no disclaimer of an individual portion of a telescoped word is required, regardless of whether the mark is shown in a standard character or special form drawing.

However, if a telescoped word is itself unregistrable, a disclaimer of the telescoped word may be required. *See In re Omaha Nat'l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987) (affirming refusal to register FIRSTIER and design for banking services in the absence of a disclaimer of "FIRST TIER," in view of evidence that the term describes a class of banks). *See* **TMEP §1213.08(c)** regarding disclaimers of misspelled words, in general.

1213.05(a)(ii) Compound Words Formed with Hyphen or Other Punctuation

When a compound word is formed by hyphenating two words or terms, one of which would be unregistrable alone, no disclaimer is necessary. *"X" Laboratories, Inc. v. Odorite Sanitation Service of Baltimore, Inc.*, 106 USPQ 327, 329 (Comm'r Pats. 1955) (requirement for a disclaimer of "TIRE" deemed unnecessary in application to register TIRE-X for a tire cleaner).

Word marks consisting of two terms joined by an asterisk (e.g., RIB*TYPE), a slash (e.g., RIB/TYPE) or a raised period (e.g., RIB°TYPE) are analogous to hyphenated words. Therefore, no disclaimer of portions of marks formed by asterisks, slashes, or raised periods is necessary.

If a hyphenated term comprising part of a mark is unregistrable, then a disclaimer of the hyphenated term may be required. *See* **TMEP §1209.03(d)** regarding determinations of whether a composite comprising two descriptive terms is itself descriptive. In this situation, the examining attorney should require a disclaimer of the words in the correct spelling. *Cf.* **TMEP §1213.08(c)** regarding disclaimer of misspelled words.

> *Example 1:* If the mark *includes* the term SOFT-TOYS for stuffed animals, the applicant must disclaim the two separate words "SOFT TOYS" apart from the mark as shown.
>
> *Example 2:* If the mark *includes* the term OVER-COAT for winter coats, the applicant must disclaim the compound word "OVERCOAT," because this is how the term is commonly spelled.

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1213.05(b) Slogans

A registrable slogan is one that is used in a trademark sense. A registrable slogan is considered unitary and should not be broken up for purposes of requiring a disclaimer.

If an unregistrable slogan is a component of a registrable mark, then the examining attorney should require that the slogan be disclaimed.

If a mark consists entirely of a slogan that is merely descriptive or that is not being used as a mark, then registration should be refused. *See In re Carvel Corp.*, 223 USPQ 65 (TTAB 1984) (AMERICA'S FRESHEST ICE CREAM for flavored ices, etc., held incapable of distinguishing applicant's goods and unregistrable on the Supplemental Register); *In re Wakefern Food Corp.*, 222 USPQ 76 (TTAB 1984) (WHY PAY MORE! held to be an unregistrable common commercial phrase).

1213.05(c) "Double Entendre"

A "double entendre" is a word or expression capable of more than one interpretation. For trademark purposes, a "double entendre" is an expression that has a double connotation or significance *as applied to the goods or services*. The mark that comprises the "double entendre" will not be refused registration as merely descriptive if one of its meanings is not merely descriptive in relation to the goods or services.

A true "double entendre" is unitary by definition. An expression that is a "double entendre" should not be broken up for purposes of requiring a disclaimer. *See In re Kraft, Inc.*, 218 USPQ 571, 573 (TTAB 1983), where the Board found inappropriate a requirement for a disclaimer of "LIGHT" apart from the mark "LIGHT N' LIVELY" for reduced calorie mayonnaise, stating as follows:

> The mark "LIGHT N' LIVELY" as a whole has a suggestive significance which is distinctly different from the merely descriptive significance of the term "LIGHT" per se. That is, the merely descriptive significance of the term "LIGHT" is lost in the mark as a whole. Moreover, the expression as a whole has an alliterative lilting cadence which encourages persons encountering it to perceive it as a whole.

See also In re Symbra'ette, Inc., 189 USPQ 448 (TTAB 1975) (SHEER ELEGANCE for panty hose held to be a registrable unitary expression; thus, no disclaimer of "SHEER" considered necessary).

The multiple interpretations that make an expression a "double entendre" must be associations that the public would make fairly readily, and *must be readily apparent from the mark itself*. *See In re The Place, Inc.,* 76 USPQ2d 1467, 1470 (TTAB 2005) (THE GREATEST BAR held laudatory and merely descriptive of restaurant and bar services; the Board stating that "[i]f the alleged second meaning of the mark is apparent to purchasers only after they view the mark in the context of the applicant's trade dress, advertising materials or other matter, then the mark is not a double entendre"); *In re Wells Fargo & Co.*, 231 USPQ 95 (TTAB 1986) (EXPRESSERVICE held merely descriptive for banking services, despite applicant's argument that the term also connotes the Pony Express, the Board finding that, in the relevant context, the public would not make that association). *See also In re Ethnic Home Lifestyles Corp.*, 70 USPQ2d 1156 (TTAB 2003) (ETHNIC ACCENTS held merely descriptive of "entertainment in the nature of television programs in the field of home décor," because the meaning in the context of the services is home furnishings or decorations which reflect or evoke particular ethnic traditions or themes, which identifies a significant feature of applicant's programs; viewers of applicant's programs deemed unlikely to discern a double entendre referring to a person who speaks with a foreign accent).

If all meanings of a "double entendre" are merely descriptive in relation to the goods, then the mark comprising the "double entendre" should be refused registration as merely descriptive.

The following cases illustrate situations where marks were considered to be "double entendres" and, therefore, registrable unitary marks: *In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968) (SUGAR & SPICE for bakery products); *In re Tea and Sympathy, Inc.*, 88 USPQ2d 1062 (TTAB 2008) (THE FARMACY held registrable for retail store services featuring natural herbs and organic products and related health and information services relating to dietary supplements and nutrition); *In re Simmons Co.*, 189 USPQ 352 (TTAB 1976) (THE HARD LINE for mattresses and bed springs); *In re Delaware Punch Co.*, 186 USPQ 63 (TTAB 1975) (THE SOFT PUNCH for noncarbonated soft drink); *In re National Tea Co.*, 144 USPQ 286 (TTAB 1965) (NO BONES ABOUT IT for fresh pre-cooked ham).

1213.05(d) Incongruity

If two or more terms are combined in a mark to create an incongruity (e.g., URBAN SAFARI, MR. MICROWAVE, and DR. GRAMMAR), the mark is unitary and no disclaimer of nondistinctive individual elements is necessary.

1213.05(e) Sound Patterns

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At times, a mark will form a unitary whole through a rhyming pattern, use of alliteration or some other use of sound that creates a distinctive impression. In such a case, the mark is regarded as unitary and individual elements should not be disclaimed. *See In re Kraft, Inc.*, 218 USPQ 571, 573 (TTAB 1983) (LIGHT N' LIVELY found to be a unitary term not subject to disclaimer, because the mark as a whole "has a suggestive significance which is distinctly different from the merely descriptive significance of the term 'LIGHT' per se" and that "the merely descriptive significance of the term 'LIGHT' is lost in the mark as a whole."). However, alliterative or repeated wording does not in itself make a mark unitary. *In re Ginc UK Ltd.*, 90 USPQ2d 1472, 1477 (TTAB 2007) (the rhyming quality of the words ZOGGS TOGGS "does not infuse TOGGS with any separate and distinct meaning apart from its generic meaning"); *In re Lean Line, Inc*., 229 USPQ 781, 782 (TTAB 1986) (LEAN LINE *not* considered unitary; "there is nothing in the record to suggest that the mere fact that both words which form the mark begin with the letter 'L' would cause purchasers to miss the merely descriptive significance of the term 'LEAN' or consider the entire mark to be a unitary expression.")

1213.05(f) Display of Mark

The visual presentation of a mark may be such that the words and/or designs form a unitary whole. In such a case, disclaimer of individual nondistinctive elements is unnecessary. *See, e.g., In re Texsun Tire and Battery Stores, Inc.*, 229 USPQ 227, 229 (TTAB 1986) ("[T]he portion of the outline of the map of Texas encircled as it is with the representation of a tire and surrounded by a rectangular border results in a unitary composite mark which is unique and fanciful."); *cf. In re Slokevage*, 441 F.3d 957, 78 USPQ2d 1395 (Fed. Cir. 2006) (trade dress configuration of product design consisting of a label with the words "FLASH DARE!" in a V-shaped background, and cut-out areas located on each side of the label, with the cut-out areas consisting of a hole in a garment and a flap attached to the garment with a closure device held not to be unitary where applicant owned separate registrations for some of the elements and in view of the separate locations of the words and design elements).

1213.05(g) Marks with Design Elements Replacing Letters

Generally, when a design element replaces one or more letters (or a portion of a letter or letters) in a word that is merely descriptive, generic, or geographically descriptive, this combination of word and design element does not create a "unitary mark" if the word remains recognizable. Accordingly, the examining attorney must require a disclaimer of the merely descriptive, generic, or geographically descriptive word in such cases. *In re Clutter Control, Inc.,* 231 USPQ 588 (TTAB 1986).

If the wording to be disclaimed is otherwise registrable (i.e., not generic), applicant may submit a claim of acquired distinctiveness as to that portion of the mark under Trademark Act §2(f). The examining attorney must always separately determine whether an applicant has adequately shown acquired distinctiveness. *In re Venturi, Inc.,* 197 USPQ 714 (TTAB 1977).

The examining attorney must also assess whether the proposed mark might be unitary for other reasons (such as a compound or telescoped mark).

1213.05(g)(i) Marks with a Distinctive Design Replacing a Letter in Descriptive or Generic Wording

Marks with a distinctive design that replaces a letter or part of a letter are registrable on the Principal Register with a disclaimer of the merely descriptive, generic, or primarily geographically descriptive wording. For example:

Principal Register – Disclaimer of INC. and ANIMAL FOOD

Principal Register – Disclaimer of WOOL

Principal Register – Disclaimer of CLOTHING CO.

Principal Register – Disclaimer of PARIS

Principal Register – Disclaimer of FISH

Principal Register – Disclaimer of NUTRITION

Principal Register – Disclaimer of DOGGIE

Principal Register – Disclaimer of PONY

Principal Register – Disclaimer of TOWELS

Principal Register – Disclaimer of KIDS

1213.05(g)(ii) Marks with Merely Descriptive or Primarily Geographically Descriptive Designs Replacing Letters within Descriptive or Primarily Geographically Descriptive Wording

If the design that replaces a letter within descriptive or primarily geographically descriptive wording is itself merely descriptive or primarily geographically descriptive, or is otherwise non-distinctive, the examining attorney must require the applicant to amend to the Supplemental Register or seek registration on the Principal Register under §2(f) and to disclaim any generic wording. For example:

Disclaim "BANKERS ASSOCIATION" on Principal Register under Section 2(f) or on Supplemental Register

Disclaim "BUILDERS ASSOCIATION" on Principal Register under Section 2(f) or on Supplemental Register

Disclaim CHECK CASHERS on Principal Register under Section 2(f) or on Supplemental Register

1213.05(g)(iii) Marks with Accurate Pictorial Representations Replacing Letters in Merely Descriptive and Primarily Geographically Descriptive Marks

If the mark is otherwise merely descriptive or primarily geographically descriptive, and the design replacing a letter is an accurate pictorial representation of generic, merely descriptive, or geographically descriptive matter, the examining attorney should require the applicant to amend to the Supplemental Register or seek registration on the Principal Register under Trademark Act §2(f). The applicant must disclaim any generic wording or any accurate pictorial representation of generic matter. For example:

Disclaim “SOCCER BALLS” and the pictorial representation of the soccer ball on the Principal Register under Section 2(f) or on the Supplemental Register

Disclaim “LEMONS” and the pictorial representation of the lemon on the Principal Register under Section 2(f) or the Supplemental Register

1213.05(g)(iv) Unitary Marks with Design Elements Replacing Letters in Descriptive or Generic Wording

If literal and design elements in a mark are so merged together that they cannot be divided or regarded as separable elements, these elements may be considered unitary. For example, where the design element replacing a letter is merely one part of a larger design, the mark may be unitary, and no disclaimer of the descriptive or generic wording is required:

1213.06 Entire Mark May Not Be Disclaimed

An entire mark may not be disclaimed. If a mark is not registrable as a whole, a disclaimer will not make it registrable. There must be something in the combination of elements in the mark, or something of sufficient substance or distinctiveness over and above the matter being disclaimed, that would make the composite registrable. *See In re Carlson*, 91 USPQ2d 1198 (TTAB 2009); *In re Anchor Hocking Corp.*, 223 USPQ 85 (TTAB 1984); *Ex parte Ste. Pierre Smirnoff Fls, Inc.*, 102 USPQ 415 (Comm’r Pats. 1954). This includes marks that are comprised entirely of generic wording, and either the entire mark or some of the terms are the phonetic equivalent of the generic wording. Such marks cannot be disclaimed, even in the proper spelling, and approved for registration on the Supplemental Register. *See* **TMEP §1209.01(c).**

In Dena Corp. v. Belvedere Int’l Inc., 950 F.2d 1555, 1560, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991), the Court of Appeals for the Federal Circuit stated as follows:

> [U]nder traditional disclaimer practice, an applicant could not disclaim all elements of a composite mark. Section 1056(a) codified this policy. A mark which must be entirely disclaimed has no ‘unregistrable component,’ but is instead entirely nonregistrable. In other words, a mark which must be entirely disclaimed has no ‘otherwise registrable’ parts. Therefore, such marks do not qualify as composite marks for which the Commissioner may require a disclaimer.

1213.07 Removal Rather than Disclaimer

When it is not clear that matter forms part of a mark, the examining attorney must consider whether it is appropriate for the applicant to amend the drawing of the mark to remove the matter, rather than to disclaim it. *See* **TMEP §807.14(a)** regarding deletion of matter from the mark on a drawing. An applicant may not amend the drawing if the amendment would constitute a material alteration of the mark. 37 C.F.R. §2.72; **TMEP §§807.14** *et seq*.

There are circumstances under which the applicant may omit or remove matter from the mark shown in the drawing, if the overall commercial impression is not altered. *See Institut Nat'l Des Appellations D'Origine v. Vintners Int'l Co. Inc.*, 958 F.2d 1574, 1582, 22 USPQ2d 1190, 1197 (Fed. Cir. 1992); *In re Servel, Inc.*, 181 F.2d 192, 85 USPQ 257 (C.C.P.A. 1950). However, matter may not be omitted from the drawing if the omission would result in an incomplete representation of the mark, sometimes referred to as "mutilation." *See* **TMEP §807.12(d).** In other words, the matter presented for registration must convey a single distinct commercial impression. If a mark is not unitary in this sense, it cannot be registered. *Dena Corp. v. Belvedere Int'l Inc.*, 950 F.2d 1555, 21 USPQ2d 1047 (Fed. Cir. 1991).

1213.08 Form of Disclaimers

1213.08(a) Wording of Disclaimer

1213.08(a)(i) Standardized Printing Format for Disclaimer

Since November 9, 1982, disclaimers for marks published for opposition and those registered on the Supplemental Register are printed in a standardized form in the *Official Gazette*, regardless of the text submitted. Disclaimers are in the standardized format in certificates of registration on the Supplemental Register issued as of that date. Disclaimers are in the standardized format in certificates of registration on the Principal Register issued as of February 1, 1983. The disclaimed matter is taken from the disclaimer of record and inserted into the standardized disclaimer format for printing and database purposes. The standardized disclaimer text is as follows:

> No claim is made to the exclusive right to use _____, apart from the mark as shown.

See notice at 1022 TMOG 44 (September 28, 1982). *See also In re Owatonna Tool Co.*, 231 USPQ 493, 495 (Comm'r Pats. 1983) ("[T]he use of the standardized form is solely for the purpose of printing and database purposes, not for the limitation of registrant's rights.").

For the record only, examining attorneys will accept disclaimers with additional statements pertaining to reservation of common law rights, although §6 of the Trademark Act of 1946 states that no disclaimer shall prejudice or affect the applicant's or registrant's rights then existing or thereafter arising in the disclaimed matter. Disclaimers with these additional statements can be entered by examiner's amendment. The examining attorney must inform the applicant or attorney who authorizes the amendment that the disclaimer will be printed in the standardized format.

Where non-adjacent components of a mark, or adjacent components that do not form a grammatically or otherwise unitary expression must be disclaimed, the following format is suggested:

> No claim is made to the exclusive right to use _____ or _____, apart from the mark as shown.

While the "or" connector is preferred, the USPTO will also accept a statement that "no claim is made to the exclusive right to use _____ and _____ apart from the mark as shown."

See **TMEP §1213.08(b)** regarding the disclaimer of unregistrable matter in its entirety.

1213.08(a)(ii) Unacceptable Wording for Disclaimer

Wording that claims matter, rather than disclaims it, is not acceptable. A disclaimer should be no more than a statement that identifies matter to which the applicant may not have exclusive rights apart from what is shown on the drawing.

Therefore, statements that the applicant "claims" certain matter in the association shown are not acceptable. The examining attorney must require correction of this wording and of variations that amount to the same thing. Likewise, a statement that the mark is "not claimed except in the association shown," or similar wording, is not acceptable, and the examining attorney must require correction. *See Textron Inc. v. Pilling Chain Co., Inc.,* 175 USPQ 621, 622 (TTAB 1972), concerning an application which included the statement, "The mark is not to be claimed except in the setting presented." The Board found this wording unacceptable, noting, "The alleged disclaimer filed by applicant is in such vague terms that it actually disclaims nothing."

1213.08(b) Disclaimer of Unregistrable Matter in Its Entirety

Unregistrable matter must be disclaimed in its entirety. For example, when requiring a disclaimer of terms that form a grammatically or otherwise unitary expression (e.g., "SHOE FACTORY, INC."), the examining attorney must require that they

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be disclaimed in their entirety. *See, e.g., In re Medical Disposables Co.*, 25 USPQ2d 1801 (TTAB 1992) (MEDICAL DISPOSABLES is a unitary expression that must be disclaimed as a composite); *In re Wanstrath*, 7 USPQ2d 1412, 1413 (Comm'r Pats. 1987) (denying petitioner's request to substitute separate disclaimers of "GLASS" and "TECHNOLOGY" for the disclaimer of "GLASS TECHNOLOGY" in its registration of GT GLASS TECHNOLOGY in stylized form, the Commissioner finding "GLASS TECHNOLOGY" to be a unitary expression and noting, "Disclaimers of individual components of complete descriptive phrases are improper."); *American Speech-Language-Hearing Ass'n v. National Hearing Aid Society*, 224 USPQ 798, 804 n.3 (TTAB 1984) ("CERTIFIED HEARING AID AUDIOLOGIST" found to be "a unitary expression that should be disclaimed in its entirety"); *In re Surelock Mfg. Co., Inc.,* 125 USPQ 23, 24 (TTAB 1960) (proposed disclaimer of "THE" and "RED" and "CUP" held unacceptable to comply with requirement for disclaimer of "THE RED CUP," the Board concluding, "A disclaimer of the individual components of the term 'THE RED CUP,' under the circumstances, is meaningless and improper").

However, separate disclaimers of adjacent components of a mark may be accepted where they do not form a grammatically or otherwise unitary expression, and each component retains its separate descriptive significance. *In re Grass GmbH*, 79 USPQ2d 1600 (TTAB 2006) (Board reversed requirement for unitary disclaimer of "SNAP ON 3000," and accepted separate disclaimers of "SNAP ON" and "3000.")

1213.08(c) Disclaimer of Misspelled Words

Marks often comprise words that may be characterized as "misspelled." For example, marks may comprise terms that are "telescoped" (*see* **TMEP §1213.05(a)(i)**) or terms that are phonetic equivalents of particular words but spelled in a manner that varies from the ordinary spelling of such words.

If a mark comprises a word or words that are misspelled but nonetheless must be disclaimed, the examining attorney should require disclaimer of the word or words in the correct spelling. *See In re Omaha Nat'l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Carlson*, 91 USPQ2d 1198 (TTAB 2009); *In re Newport Fastener Co. Inc.*, 5 USPQ2d 1064, 1067 n.4 (TTAB 1987). However, the entry of a disclaimer does not render registrable a mark that is otherwise unregistrable. For example, if a mark is comprised entirely of generic wording and some or all of the wording in the mark is the phonetic equivalent of the generic wording, the entire mark may not be disclaimed, even in the proper spelling, and approved for registration on the Supplemental Register. *See* **TMEP §1209.01(c).**

If the examining attorney has not required any disclaimer of misspelled wording because a disclaimer is not necessary under USPTO policy, the applicant may provide a disclaimer of the wording as spelled in the mark or in its correct spelling voluntarily. In such a case, the examining attorney should accept the disclaimer. Again, the disclaimer does not necessarily render an otherwise unregistrable mark registrable. The examining attorney must consider the entire mark, including the disclaimed matter, to determine whether the entire mark is registrable.

1213.08(d) Disclaimer of Non-English Words

Non-English wording that comprises an unregistrable component of a mark is subject to disclaimer. *See Bausch & Lomb Optical Co. v. Overseas Finance & Trading Co. Inc.*, 112 USPQ 6, 8 (Comm'r Pats. 1956) (noting that "Kogaku," the transliteration of the Japanese word for "optical," was properly disclaimed).

If translated non-English wording must be disclaimed, the actual non-English wording should be disclaimed, not the English translation. The applicant must disclaim the wording that actually appears in the mark, not the translated version. For non-Latin characters, the following format is suggested:

> No claim is made to the exclusive right to use the non-Latin characters that transliterate to "[specify Latin character transliteration]" apart from the mark as shown.

See **TMEP §§809** *et seq*. regarding translation of non-English wording in marks.

1213.09 Mark of Another May Not Be Registered with Disclaimer

Normally, a mark that includes a mark registered by another person must be refused registration under 15 U.S.C. §1052(d) based on likelihood of confusion. A refusal of registration under §2(d) may not be avoided by disclaiming the mark of another. *Cf. In re Franklin Press, Inc.*, 597 F.2d 270, 201 USPQ 662 (C.C.P.A. 1979) (permitting disclaimer of informational phrase indicating that applicant's employees are represented by certain labor organizations). *See* **TMEP §1213.10** regarding disclaimer in relation to likelihood of confusion.

1213.10 Disclaimer in Relation to Likelihood of Confusion

A disclaimer does not remove the disclaimed matter from the mark. The mark must still be regarded as a whole, including the disclaimed matter, in evaluating similarity to other marks. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 672, 223 USPQ 1281, 1282 (Fed. Cir. 1984);

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Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 1570, 218 USPQ 390, 395 (Fed. Cir. 1983); *Schwarzkopf v. John H. Breck, Inc.,* 340 F.2d 978, 144 USPQ 433 (C.C.P.A. 1965); *In re MCI Communications Corp.*, 21 USPQ2d 1534, 1538-39 (Comm'r Pats. 1991).

Typically, disclaimed matter will not be regarded as the dominant, or most significant, feature of a mark. However, since the Trademark Act permits an applicant to voluntarily disclaim registrable matter (*see* **TMEP §1213.01(c)**), disclaimed matter may be dominant or significant in some cases. As noted in *MCI Communications Corp.*, 21 USPQ2d at 1539, "Examining Attorneys will continue to consider the question of likelihood of confusion, under Section 2(d) of the statute, in relation to the marks as a whole, including any voluntarily disclaimed matter."

1213.11 Acquiring Rights in Disclaimed Matter

In *Estate of P.D. Beckwith v. Comm'r of Pats.*, 252 U.S. 538, 545, 1920 C.D. 471, 477 (1920), the United States Supreme Court stated, regarding registration of a mark with a disclaimer, that "the registrant would be precluded by his disclaimer from setting up in the future any exclusive right to the disclaimed part of it." Subsequently, that principle was applied literally; registrants were prohibited from asserting that disclaimed matter had acquired secondary meaning. *See Shaler Co. v. Rite-Way Products, Inc.*, 43 USPQ 425 (6th Cir. 1939).

The situation was changed by the Trademark Act of 1946, which provided that "disclaimer shall not prejudice or affect the applicant's or owner's rights then existing or thereafter arising in the disclaimed matter, nor shall such disclaimer prejudice or affect the applicant's or owner's rights of registration on another application of later date if the disclaimed matter has become distinctive of the applicant's or owner's goods or services." In 1962, the statutory provision was amended to read, "No disclaimer ... shall prejudice or affect the applicant's or registrant's rights then existing or thereafter arising in the disclaimed matter, or his right of registration on another application if the disclaimed matter be or shall have become distinctive of his goods or services." 15 U.S.C. §1056(b).

It is now clear that, aside from generic matter, disclaimed matter is not forever barred from registration, and it can subsequently be considered for registration on either the Principal Register or the Supplemental Register. When an application is filed seeking registration of matter previously disclaimed, it should be examined in the same manner as other applications. *See Quaker Oil Corp. v. Quaker State Oil Refining Corp.*, 161 USPQ 547 (TTAB 1969), *aff'd,* 453 F.2d 1296, 172 USPQ 361 (C.C.P.A. 1972); *Victor Tool & Machine Corp. v. Sun Control Awnings, Inc.*, 299 F. Supp. 868, 162 USPQ 389 (E.D. Mich. 1968), *aff'd,* 411 F.2d 792, 162 USPQ 387 (6th. Cir. 1969).

Whether or not previously disclaimed matter has become eligible for registration depends on the circumstances and the evidence adduced in the examination process. *Helena Rubinstein, Inc. v. Ladd*, 219 F. Supp. 259, 138 USPQ 106 (D.D.C. 1963), *aff'd,* 141 USPQ 623 (D.C. Cir. 1964); *Roux Distributing Co., Inc. v. Duart Mfg. Co. Ltd.*, 114 USPQ 511 (Comm'r Pats. 1957).

1214 "Phantom" Elements in Marks

In some applications, the applicant seeks to register a "phantom" element (i.e., a word, alpha-numeric designation, or other component that is subject to change) as part of a mark. The applicant represents the changeable or "phantom" element by inserting a blank, or by using dots, dashes, underlining, or a designation such as "XXXX."

Examples include marks incorporating a date (usually a year), a geographic location, or a model number that is subject to change. While these are some of the most common examples of the types of elements involved, there are many variations.

1214.01 Single Application May Seek Registration of Only One Mark

Where an applicant seeks registration of a mark with a changeable or "phantom" element, the examining attorney should refuse registration under §§1 and 45 of the Trademark Act, 15 U.S.C. §§1051 and 1127, on the ground that the application seeks registration of more than one mark. *See In re International Flavors & Fragrances Inc.*, 183 F.3d 1361, 51 USPQ2d 1513 (Fed. Cir. 1999); *In re Primo Water Corp.*, 87 USPQ2d 1376 (TTAB 2008); *Cineplex Odeon Corp. v. Fred Wehrenberg Circuit of Theatres Inc.,* 56 USPQ2d 1538 (TTAB 2000).

In *International Flavors,* the applicant filed three applications to register the designations "LIVING xxxx," "LIVING xxxx FLAVOR," and "LIVING xxxx FLAVORS," for essential oils, flavor substances, and fragrances. Each application included a statement that "[t]he meaning of 'xxxx' is for a specific herb, fruit, plant or vegetable." In upholding the refusal of registration, the Federal Circuit noted that under §22 of the Trademark Act, 15 U.S.C. §1072, registration serves as constructive notice to the public of the registrant's ownership of the mark and, therefore, precludes another user from claiming innocent misappropriation as a trademark infringement defense. To make this constructive notice meaningful, the mark as registered must accurately reflect the mark that is used in commerce, so that someone who searches the register for a similar mark will locate the registration. The court stated that "phantom marks" with missing elements "encompass too many combinations and

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permutations to make a thorough and effective search possible" and, therefore, the registration of these marks does not provide adequate notice to competitors and the public. *International Flavors,* 51 USPQ2d at 1517-18.

In *Primo Water,* the Board affirmed a refusal of registration of a mark comprising the "placement and orientation of identical spaced indicia" on either side of the handle of a water bottle in inverted orientation, where the description of the mark indicated that the "indicia" can be "text, graphics or a combination of both." The Board noted that the varying indicia must be viewed by consumers before they can perceive the repetition and inversion elements of the mark, and that marks with changeable or "phantom" elements do not provide proper notice to other trademark users. The Board also noted that the only issue on appeal was whether applicant seeks to register more than one mark, and that this issue is separate from the question of whether the proposed mark is distinctive and functions as a mark.

See also In re Upper Deck Co., 59 USPQ2d 1688 (TTAB 2001) (hologram used on trading cards in varying shapes, sizes, contents, and positions constitutes more than one "device" as contemplated by §45 of the Trademark Act).

See also **TMEP §807.01** regarding the requirement that an application be limited to one mark.

1214.02 Agreement of Mark on Drawing With Mark on Specimens or Foreign Registration

Where an applicant seeks registration of a "phantom mark," the examining attorney should also consider whether the mark on the drawing is a substantially exact representation of the mark as used on the specimen in a use-based application, or the mark in the home country registration in an application based on Trademark Act §44, 15 U.S.C. §1126. *See* **TMEP §§807.12** *et seq*.

The applicant may amend the mark to overcome a refusal on the ground that the mark on the drawing does not agree with the mark as used on the specimen, or with the mark in the foreign registration, if the amendment is not a material alteration of the mark. *See* **TMEP §§807.14** *et seq*. regarding material alteration.

1214.03 "Phantom Marks" in §1(b) Applications

In an intent-to-use application for which no allegation of use has been filed, it may be unclear whether the applicant is seeking registration of a mark with a changeable element. If an intent-to-use application indicates that the applicant is seeking registration of a "phantom mark" (e.g., if the application includes a statement that "the blank line represents a date that is subject to change"), the examining attorney should issue a refusal of registration under §§1 and 45 of the Trademark Act, 15 U.S.C. §§1051 and 1127, on the ground that the application seeks registration of more than one mark, as discussed above. If it is unclear whether an applicant is seeking registration of a "phantom" mark, the examining attorney should advise the applicant that if the specimen filed with an amendment to allege use under §1(c) of the Trademark Act, 15 U.S.C. §1051(c), or a statement of use under §1(d) of the Act, 15 U.S.C. §1051(d), shows that applicant is seeking registration of a mark with a changeable element, registration will be refused on the ground that the application seeks registration of more than one mark. This is done strictly as a courtesy. If information regarding this possible ground for refusal is not provided before the applicant files an allegation of use, the USPTO is not precluded from refusing registration on this basis.

1214.04 "Phantom Marks" in §44 and §66(a) Applications

The refusal should be made in applications under §§44 and 66(a) as well as §1 of the Trademark Act.

1215 Marks Composed, in Whole or in Part, of Domain Names

1215.01 Background

A domain name is part of a Uniform Resource Locator ("URL"), which is the address of a site or document on the Internet. In general, a domain name is comprised of a second-level domain, a "dot," and a top-level domain ("TLD"). The wording to the left of the "dot" is the second-level domain, and the wording to the right of the "dot" is the TLD.

Example: If the domain name is "ABC**.**com," the term "ABC" is a second-level domain and the term "com" is a TLD.

A domain name is usually preceded in a URL by "http://www." The "http://" refers to the protocol used to transfer information, and the "www" refers to World Wide Web, a graphical hypermedia interface for viewing and exchanging information.

Generic TLDs. The following are examples of generic TLDs that are designated for use by the public:

.com	commercial, for-profit organizations
.edu	4-year, degree-granting colleges/universities
.gov	U.S. federal government agencies

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.int	international organizations
.mil	U.S. military organizations, even if located outside the U.S.
.net	network infrastructure machines and organizations
.org	miscellaneous, usually non-profit organizations and individuals

Each of the above TLDs is intended for use by a certain type of organization. For example, the TLD ".com" is for use by commercial, for-profit organizations. However, the administrator of the .com, .net, .org, and .edu TLDs does not check the requests of parties seeking domain names to ensure that such parties are a type of organization that should be using those TLDs. On the other hand, .mil, .gov, and .int TLD applications are checked, and only the U.S. military, the U.S. government, or international organizations are allowed in the respective domain space.

Country Code TLDs. Country code TLDs are for use by each individual country. For example, the TLD ".ca" is for use by Canada, and the TLD ".jp" is for use by Japan. Each country determines who may use their code. For example, some countries require that users of their code be citizens or have some association with the country, while other countries do not.

See **www.icann.org** for additional information about other generic TLDs and **TMEP §1209.03(m).**

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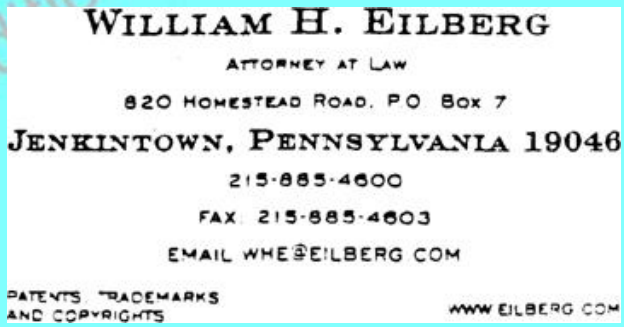
1215.02 Use as a Mark

Generally, when a trademark, service mark, collective mark, or certification mark is composed, in whole or in part, of a domain name, neither the beginning of the URL ("http://www.") nor the TLD have any source-indicating significance. Instead, those designations are merely devices that every Internet site provider must use as part of its address. Advertisements for all types of products and services routinely include a URL for the website of the advertiser, and the average person familiar with the Internet recognizes the format for a domain name and understands that "http," "www," and a TLD are a part of every URL.

1215.02(a) Use Applications

A mark composed of a domain name is registrable as a trademark or service mark only if it functions as a source identifier. The mark as depicted on the specimen must be presented in a manner that will be perceived by potential purchasers to indicate source and not as merely an informational indication of the domain name address used to access a website . *See In re Roberts*, 87 USPQ2d 1474 (TTAB 2008) (**irestmycase** does not function as mark for legal services, where it is used only as part of an address by means of which one may reach applicant's website, or along with applicant's other contact information on letterhead); *In re Eilberg,* 49 USPQ2d 1955 (TTAB 1998).

In *Eilberg,* the Trademark Trial and Appeal Board held that a term that only serves to identify the applicant's domain name or the location on the Internet where the applicant's website appears, and does not separately identify applicant's services, does not function as a service mark. The applicant's proposed mark was WWW.EILBERG.COM, and the specimen showed that the mark was used on letterhead and business cards in the following manner:



(The specimen submitted was the business card of William H. Eilberg, Attorney at Law, 820 Homestead Road, P.O. Box 7, Jenkintown, Pennsylvania 19046, 215-855-4600, email whe@eilberg.com.)

The Board affirmed the examining attorney's refusal of registration on the ground that the matter presented for registration did not function as a mark, stating that:

> [T]he asserted mark, as displayed on applicant's letterhead, does not function as a service mark identifying and

> distinguishing applicant's legal services and, as presented, is not capable of doing so. As shown, the asserted mark identifies applicant's Internet domain name, by use of which one can access applicant's Web site. In other words, the asserted mark WWW.EILBERG.COM merely indicates the location on the Internet where applicant's Web site appears. It does not separately identify applicant's legal services as such. *Cf. In re The Signal Companies, Inc*., 228 USPQ 956 (TTAB 1986).
>
> This is not to say that, if used appropriately, the asserted mark or portions thereof may not be trademarks or [service marks]. For example, if applicant's law firm name were, say, EILBERG.COM and were presented prominently on applicant's letterheads and business cards as the name under which applicant was rendering its legal services, then that mark may well be registrable.

49 USPQ2d at 1957.

The examining attorney must review the specimen in order to determine how the proposed mark is actually used. It is the perception of the ordinary customer that determines whether the asserted mark functions as a mark, not the applicant's intent, hope, or expectation that it does so. *See In re Standard Oil Co.,* 275 F.2d 945, 125 USPQ 227 (C.C.P.A. 1960).

If the proposed mark is used in a way that would be perceived as nothing more than an Internet address where the applicant can be contacted, registration must be refused. Examples of a domain name used only as an Internet address include a domain name used in close proximity to language referring to the domain name as an address, or a domain name displayed merely as part of the information on how to contact the applicant.

> *Example*: The mark is WWW.ABC.COM for online ordering services in the field of clothing. A specimen consisting of an advertisement that states "visit us on the web at www.ABC.com" does not show service mark use of the proposed mark.
>
> *Example*: The mark is ABC**.**COM for financial consulting services. A specimen consisting of a business card that refers to the service and lists a telephone number, fax number, and the domain name sought to be registered does not show service mark use of the proposed mark.

If the specimen fails to show use of the domain name as a mark and the applicant seeks registration on the Principal Register, the examining attorney must refuse registration on the ground that the matter presented for registration does not function as a mark. The statutory bases for the refusals are §§1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127, for trademarks; and §§1, 2, 3, and 45 of the Act, 15 U.S.C. §§1051, 1052, 1053, and 1127, for service marks.

If the applicant seeks registration on the Supplemental Register, the examining attorney must refuse registration under Trademark Act §23, 15 U.S.C. §1091.

1215.02(b) Advertising One's Own Products or Services on the Internet is not a Service

Advertising one's own products or services is not a service. *In re Reichhold Chemicals, Inc.,* 167 USPQ 376 (TTAB 1970). *See* **TMEP §§1301.01(a)(ii)** and **1301.01(b)(i).** Therefore, businesses that create a website for the sole purpose of advertising their own products or services cannot register a domain name used to identify that activity. In examination, the issue usually arises when the applicant describes the activity as a registrable service, e.g., "providing information about [a particular field]," but the specimen of use makes it clear that the website merely advertises the applicant's own products or services. In this situation, the examining attorney must refuse registration because the mark is used to identify an activity that does not constitute a "service" within the meaning of the Trademark Act. Trademark Act §§1, 2, 3, and 45, 15 U.S.C. §§1051, 1052, 1053, and 1127.

1215.02(c) Agreement of Mark on Drawing with Mark on Specimens of Use

In viewing a domain name mark (e.g., ABC**.**COM or HTTP://WWW.ABC.COM), consumers look to the second-level domain name for source identification, not to the top-level domain (TLD) or the terms "http://www." or "www." Therefore, it is usually acceptable to depict only the second-level domain name on the drawing page, even if the specimen shows a mark that includes the TLD or the terms "http://www." or "www." *Cf. Institut Nat'l des Appellations D'Origine v. Vintners Int'l Co., Inc.*, 958 F.2d 1574, 22 USPQ2d 1190 (Fed. Cir. 1992) (CHABLIS WITH A TWIST held to be registrable separately from CALIFORNIA CHABLIS WITH A TWIST as shown on labels); *In re Raychem Corp.*, 12 USPQ2d 1399 (TTAB 1989) (refusal to register TINEL-LOCK based on specimen showing "TRO6AI-TINEL-LOCK-RING" reversed). *See also* 37 C.F.R. §§2.51(a) and (b), and **TMEP §§807.12** *et seq.*

> *Example*: The specimen shows the mark HTTP://WWW**.**ABC**.**COM. The applicant may elect to depict only the term "ABC" on the drawing.

Sometimes the specimen fails to show the entire mark sought to be registered (e.g., the drawing of the mark is HTTP://WWW.ABC.COM, but the specimens only show ABC). If the drawing of the mark includes a TLD, or the terms

"http://www.," or "www.," the specimen must also show the mark used with those terms. Trademark Act §1(a)(3)(C), 15 U.S.C. §1051(a)(3)(C).

Example: If the drawing of the mark is ABC**.**COM, a specimen that only shows the term ABC is unacceptable.

See **TMEP §§807.14** *et seq*. and **1215.08** *et seq*. regarding material alteration.

1215.02(d) Marks Comprised Solely of TLDs for Domain Name Registry Services

If a mark is composed solely of a TLD for "domain name registry services" (e.g., the services of registering .com domain names), registration should be refused under Trademark Act §§1, 2, 3, and 45, 15 U.S.C. §§1051, 1052, 1053, and 1127, on the ground that the TLD would not be perceived as a mark. The examining attorney should include evidence from the LexisNexis® database, the Internet, or other sources to show that the proposed mark is currently used as a TLD or is under consideration as a new TLD.

If the TLD merely describes the subject or user of the domain space, registration should be refused under Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1), on the ground that the TLD is merely descriptive of the registry services.

1215.02(e) Section 1(b) Applications

A refusal of registration on the ground that the matter presented for registration does not function as a mark relates to the manner in which the asserted mark is used. Generally, in an intent-to-use application, a mark that includes a domain name will not be refused on this ground until the applicant has submitted specimen(s) of use with an allegation of use under §1(c) or §1(d) of the Act, 15 U.S.C. §1051(c) or (d). The specimen provides a better record upon which to determine the registrability of the mark. However, the examining attorney should include an advisory note in the first Office action that registration may be refused if the proposed mark, as used on the specimen, identifies only an Internet address. This is done strictly as a courtesy. If information regarding this possible ground for refusal is not provided to the applicant prior to the filing of the allegation of use, the USPTO is not precluded from refusing registration on this basis.

1215.02(f) Section 44 and §66(a) Applications

If the record indicates that the proposed mark would be perceived as merely an informational indication of the domain name address used to access a website rather than an indicator of source, the examining attorney should refuse registration in an application under §44 or §66(a) of the Trademark Act, on the ground that the subject matter does not function as a mark.

1215.03 Surnames

If a mark is composed of a surname and a non-source-identifying TLD, the examining attorney must refuse registration because the mark is primarily merely a surname under Trademark Act §2(e)(4), 15 U.S.C. §1052(e)(4), absent a showing of acquired distinctiveness under Trademark Act §2(f), 15 U.S.C. §1052(f). If the TLD has no trademark significance, and the primary significance of a term is that of a surname, adding the TLD to the surname does not alter the primary significance of the mark as a surname. *Cf. In re I. Lewis Cigar Mfg. Co.*, 205 F.2d 204, 98 USPQ 265 (C.C.P.A. 1953) (S. SEIDENBERG & CO'S. held primarily merely a surname); *In re Hamilton Pharmaceuticals Ltd.*, 27 USPQ2d 1939 (TTAB 1993) (HAMILTON PHARMACEUTICALS for pharmaceutical products held primarily merely a surname); *In re Cazes,* 21 USPQ2d 1796 (TTAB 1991) (BRASSERIE LIPP held primarily merely a surname where "brasserie" is a generic term for applicant's restaurant services). *See also* **TMEP §1211.01(b)(vi)** regarding surnames combined with additional wording.

1215.04 Descriptiveness

If a proposed mark is composed of a merely descriptive term(s) combined with a non-source-identifying TLD, in general, the examining attorney should refuse registration under Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1), on the ground that the mark is merely descriptive. This applies to trademarks, service marks, collective marks, and certification marks.

The TLD will be perceived as part of an Internet address, and typically does not add source-identifying significance to the composite mark. *In re 1800MATTRESS.COM IP LLC,* 586 F.3d 1359, 1364, 92 USPQ2d 1682, 1685 (Fed. Cir. 2009) (MATTRESS.COM generic for "online retail store services in the field of mattresses, beds, and bedding"); *In re Hotels.com, L.P.,* 573 F.3d 1300, 91 USPQ2d 1532 (Fed. Cir. 2009) (HOTELS.COM generic for "providing information for others about temporary lodging; [and] travel agency services, namely, making reservations and bookings for temporary lodging for others by means of telephone and the global computer network"); *In re Reed Elsevier Properties Inc.*, 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007) (LAWYERS.COM generic for "providing an online interactive database featuring information exchange in the fields of law, legal news and legal services"); *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1177, 71 USPQ2d 1370, 1374 (Fed. Cir. 2004) (PATENTS.COM merely descriptive of "computer software for managing a database of records and for tracking the status of the records by means of the Internet"); *In re DNI Holdings Ltd.*, 77 USPQ2d 1435 (TTAB 2005) (SPORTSBETTING.COM held generic for "provision of casino games on and through a global computer network wherein there

are no actual monetary wagers; provision of contests and sweepstakes on and through a global computer network; providing a web site on and through a global computer network featuring information in the fields of gaming, athletic competition and entertainment..."); *In re Eddie Z's Blinds and Drapery, Inc.*, 74 USPQ2d 1037 (TTAB 2005) (BLINDSANDDRAPERY.COM generic for retail store services featuring blinds, draperies, and other wall coverings, sold via the Internet); *In re Microsoft Corp.,* 68 USPQ2d 1195, 1203 (TTAB 2003) ("The combination of the specific term and TLD at issue, i.e., OFFICE and .NET, does not create any double entendre, incongruity, or any other basis upon which we can find the composite any more registrable than its separate elements. The combination immediately informs prospective purchasers that the software includes 'office suite' type software and is from an Internet business, i.e., a '.net' type business"); *In re CyberFinancial.Net, Inc*., 65 USPQ2d 1789, 1792 (TTAB 2002) ("The public would not understand BONDS.COM to have any meaning apart from the meaning of the individual terms combined"); *In re Martin Container, Inc.*, 65 USPQ2d 1058, 1060 (TTAB 2002) ("[T]o the average customer seeking to buy or rent containers, "CONTAINER.COM" would immediately indicate a commercial web site on the Internet which provides containers.").

However, there is no bright-line, per se rule that the addition of a non-source-identifying TLD to an otherwise descriptive mark will never under any circumstances operate to create a registrable mark. The Federal Circuit has cautioned that in rare, exceptional circumstances, a term that is not distinctive by itself may acquire some additional meaning from the addition of a TLD such as ".com" or ".net." *In re Steelbuilding.com,* 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005) (STEELBUILDING.COM highly descriptive, but not generic, for "computerized on-line retail services in the field of pre-engineered metal buildings and roofing systems"), citing *Oppedahl & Larson*, 373 F.3d at 1175-1176, 71 USPQ2d at 1373.

Thus, when examining domain name marks, it is important to evaluate the commercial impression of the mark as a whole to determine whether the composite mark conveys any distinctive source-identifying impression apart from its individual components. The examining attorney should introduce evidence as to the significance of the individual components, including the TLD, but must also consider the significance of the composite term (e.g., "Sportsbetting" in the mark SPORTSBETTING.COM), to determine whether the addition of a TLD has resulted in a mark that conveys a source-identifying impression.

See also **TMEP §§1209.01(m)** and **1215.05**.

1215.05 Generic Refusals

Generally, a mark comprised of a generic term(s) combined with a non-source-identifying TLD is itself generic and without trademark significance. *In re 1800MATTRESS.COM IP LLC,* 586 F.3d 1359, 1364, 92 USPQ2d 1682, 1685 (Fed. Cir. 2009) (MATTRESS.COM generic for "online retail store services in the field of mattresses, beds, and bedding"); *In re Hotels.com, L.P.,* 573 F.3d 1300, 91 USPQ2d 1532 (Fed. Cir. 2009) (HOTELS.COM generic for "providing information for others about temporary lodging; [and] travel agency services, namely, making reservations and bookings for temporary lodging for others by means of telephone and the global computer network").

Only in rare instances will the addition of a TLD indicator to a descriptive term operate to create a distinctive mark. *In re 1800MATTRESS.COM IP LLC,* 586 F.3d at 1364, 92 USPQ2d at 1685. However, there is no per se rule that the addition of a non-source-identifying TLD to an otherwise generic term can never under any circumstances operate to create a registrable mark. The Court of Appeals for the Federal Circuit has held that in rare, exceptional circumstances, a term that is not distinctive by itself may acquire some additional meaning from the addition of a TLD such as ".com" or ".net" that will render it "sufficiently distinctive for trademark registration." *In re Steelbuilding.com,* 415 F.3d 1293, 1299, 75 USPQ2d 1420, 1423 (Fed. Cir. 2005), citing *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1177, 71 USPQ2d 1370, 1373 (Fed. Cir. 2004). In *Steelbuilding,* vacating the Board's determination that STEELBUILDING.COM was generic for "computerized on-line retail services in the field of pre-engineered metal buildings and roofing systems," the Court criticized the Board for considering STEELBUILDING and .COM separately, holding that "[i]n this unusual case, the addition of the TLD indicator expanded the meaning of the mark to include goods and services beyond the mere sale of steel buildings. Specifically, the TLD expanded the mark to include internet services that include 'building' or designing steel structures on the web site and then calculating an appropriate price before ordering the unique structure." 415 F.3d at 1299, 75 USPQ2d at 1423. The Court also criticized the Board for relying on evidence that "steel building" or "steel buildings" is generic, where there was an alternative meaning of the composite term STEELBUILDING as denoting the act of building steel structures. However, the Court held that the term STEELBULDING.COM was highly descriptive and unregistrable on the Principal Register under §2(e)(1), absent "a concomitantly high level of secondary meaning." 415 F.3d at 1301, 75 USPQ2d at 1424.

Thus, to establish that a mark comprising a generic term with a non-source-identifying TLD is generic, the examining attorney must show that the relevant public would understand the mark as a whole to have generic significance. *See 1800Mattress.com,* 586 F.3d at 1364, 92 USPQ2d at 1684 (Board properly concluded that MATTRESS.COM was generic for "online retail store services in the field of mattresses, beds, and bedding," where the Board considered each of the constituent words, "mattress" and ".com" and determined that they were both generic, then considered the mark as a whole and determined that the combination added no new meaning, relying on the prevalence of the term "mattress.com" in the website addresses of several

online mattress retailers who provide the same services as the applicant); *In re Hotels.com, L.P.,* 573 F.3d at 1303, 91 USPQ2d at 1535 (Fed. Cir. 2009) (HOTELS.COM is generic for "providing information for others about temporary lodging; [and] travel agency services, namely, making reservations and bookings for temporary lodging for others by means of telephone and the global computer network, " based on various definitions of "hotel," printouts from hotel reservation search websites showing 'hotels" as the equivalent of or included within "temporary lodging," as well as evidence from applicant's website); *In re Reed Elsevier Properties Inc.,* 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007) (LAWYERS.COM held generic for "providing an online interactive database featuring information exchange in the fields of law, legal news and legal services," where the record included pages from applicant's website showing that applicant's services include providing information about lawyers and assistance in selecting a lawyer, and pages from eight other websites containing "lawyer.com" or "lawyers.com"); *In re DNI Holdings Ltd.*, 77 USPQ2d 1435 (TTAB 2005) (SPORTSBETTING.COM held generic for "provision of casino games on and through a global computer network wherein there are no actual monetary wagers; provision of contests and sweepstakes on and through a global computer network; providing a website on and through a global computer network featuring information in the fields of gaming, athletic competition and entertainment...," where the record included multiple examples of use of the terms "sports betting" and "sportsbetting," by both applicant and its competitors, to refer to both sports wagering and providing information about sports wagering, and there was no indication of a realistic alternative connotation of the compound term.). *See also In re Eddie Z's Blinds and Drapery, Inc.*, 74 USPQ2d 1037 (TTAB 2005) (BLINDSANDDRAPERY.COM generic for retail store services featuring blinds, draperies, and other wall coverings, sold via the Internet); *In re CyberFinancial.Net, Inc*., 65 USPQ2d 1789 (TTAB 2002) (BONDS.COM held generic for providing information regarding financial products and services and electronic commerce services rendered via the Internet, where bonds was the name of one of the financial products offered under the mark); *In re Martin Container, Inc.*, 65 USPQ2d 1058 (TTAB 2002) (CONTAINER.COM held generic for "retail store services and retail services offered via telephone featuring metal shipping containers" and "rental of metal shipping containers").

It is not necessary to show that the relevant public *uses* the term to refer to the genus. The correct inquiry is whether the relevant public would *understand* the term to be generic. *In re 1800MATTRESS.COM IP LLC,* 586 F.3d 1359 at 1362, 92 USPQ2d at 1685.

Marks comprised of generic terms combined with TLDs are not eligible for registration on the Supplemental Register, or on the Principal Register under Trademark Act §2(f), 15 U.S.C. §1052(f). This applies to trademarks, service marks, collective marks, and certification marks. However, the examining attorney generally should not issue a refusal in an application for registration on the Principal Register on the ground that a mark is a generic name for the goods or services, unless the applicant asserts that the mark has acquired distinctiveness under §2(f) of the Trademark Act, 15 U.S.C. §1052(f). Absent a claim of acquired distinctiveness, the examining attorney should issue a refusal on the ground that the mark is merely descriptive of the goods or services under §2(e)(1), 15 U.S.C. §1052(e)(1), and provide an advisory statement that the matter sought to be registered appears to be a generic name for the goods/services. *See* **TMEP §§1209.02** *et seq*.

See **TMEP §1209.01(c)(i)** regarding the test for establishing that a term is generic. *See also* **TMEP §§1209.01(m)** and **1215.04.**

1215.06 Marks Containing Geographical Matter

The examining attorney should examine marks containing geographic matter in the same manner that any mark containing geographic matter is examined. *See generally* **TMEP §§1210** *et seq*. Depending on the manner in which it is used on or in connection with the goods or services, a proposed domain name mark containing a geographic term may be primarily geographically descriptive under §2(e)(2) of the Trademark Act, 15 U.S.C. §1052(e)(2), primarily geographically deceptively misdescriptive under §2(e)(3) of the Trademark Act, 15 U.S.C. §1052(e)(3), deceptive under §2(a) of the Trademark Act, 15 U.S.C. §1052(a), and/or merely descriptive or deceptively misdescriptive under §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

When a geographic term is used as a mark for services that are provided on the Internet, the geographic term sometimes describes the subject of the service rather than the geographic origin of the service. Usually this occurs when the mark is composed of a geographic term that describes the subject matter of information services (e.g., NEW ORLEANS.COM for "providing vacation planning information about New Orleans, Louisiana by means of the global computer network"). In these cases, the examining attorney should refuse registration under §2(e)(1) because the mark is merely descriptive of the services. *See* **TMEP §1210.02(b)(iii).**

1215.07 Disclaimers

Trademark Act §6(a), 15 U.S.C. §1056(a), provides for the disclaimer of "an unregistrable component of a mark otherwise registrable." The guidelines on disclaimer discussed in **TMEP §§1213** *et seq.* apply to domain name mark applications.

If a composite mark includes a domain name composed of unregistrable matter (e.g., a merely descriptive or generic term and a non-source-identifying TLD), disclaimer is required.

If a disclaimer is required and the domain name includes a misspelled or telescoped word, the correct spelling must be disclaimed. *See* **TMEP §§1213.05(a)(i)** and **1213.08(c).**

A compound term composed of arbitrary or suggestive matter combined with a "dot" and a non-source-identifying TLD is considered unitary, and, therefore, no disclaimer of the TLD is required. *See* examples below and **TMEP §§1213.05** *et seq*. regarding unitary marks.

Mark	Disclaimer
ABC BANK.COM	BANK.COM
ABC FEDERALBANK.COM	FEDERAL BANK.COM
ABC GROCERI STOR.COM	GROCERY STORE.COM
ABC.COM	no disclaimer
ABC.BANK.COM	no disclaimer
ABCBANK.COM	no disclaimer

1215.08 Material Alteration

Amendments may not be made to the drawing of the mark if the character of the mark is materially altered. 37 C.F.R. §2.72. In determining whether an amendment is a material alteration, the controlling question is always whether the new and old forms of the mark create essentially the same commercial impression. *See* **TMEP §§807.14** *et seq*. *In re Yale Sportswear Corp*., 88 USPQ2d 1121 (TTAB 2008) (the mark on the specimen ("UPPER 90°") was not a substantially exact representation of the mark on the drawing ("UPPER 90"); *In re Innovative Companies,* LLC, 88 USPQ2d 1095 (TTAB 2008) (the proposed amendment of the drawing from FREEDOMSTONE to FREEDOM STONE not material alteration of the mark); *Paris Glove of Canada, LTD, v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1862 (TTAB 2007) (in an application to renew a registration, the old and new specimens were deemed to be substantially the same because "mere changes in background or styling, or modernization, are not ordinarily considered to be material changes in the mark.").

1215.08(a) Adding or Deleting TLDs in Domain Name Marks

Generally, an applicant may add or delete a non-source-identifying TLD to/from the drawing of a domain name mark (e.g., COOPER amended to COPPER.COM, or COOPER.COM amended to COOPER) without materially altering the mark. Although a mark that includes a TLD will be perceived by the public as a domain name, while a mark without a TLD will not, if the TLD merely indicates the type of entity using the domain name, the essence of the mark is created by the second-level domain name, not the TLD. Thus, the commercial impression created by the second-level domain name usually remains the same whether the TLD is present or not. If the TLD does function as a source indicator, its deletion from the domain name mark may constitute a material alteration of the mark.

> *Example*: Amending a mark from PETER to PETER**.**COM would *not* materially change the mark because the essence of both marks is still PETER, a person's name.
>
> *Example* : Amending a mark from ABC.PETER to ABC *would* materially change the mark because the essence of the original mark is created by both the second-level domain and the TLD.

Similarly, substituting one non-source-identifying TLD for another in a domain name mark, or adding or deleting a "dot" or "http://www." or "www." to a domain name mark is generally permitted.

> *Example*: Amending a mark from ABC**.**ORG to ABC**.**COM would *not* materially change the mark because the essence of both marks is still ABC.
>
> *Example*: Amending a mark from ABC.COM to ABC.PETER *would* materially change the mark because the essence of the mark original mark was ABC and the proposed mark now includes a source-identifying TLD.

1215.08(b) Adding or Deleting TLDs in Other Marks

Old Edition

If a mark that is not used as an Internet domain name includes a TLD, adding or deleting the TLD may be a material alteration.

Example : Deleting the term **.**COM from the mark "**.**COM ☼" used on sports magazines would materially change the mark.

1215.09 Likelihood of Confusion

When analyzing whether a domain name mark is likely to cause confusion with another pending or registered mark, the examining attorney must consider the marks as a whole, but generally should accord little weight to a non-source-identifying TLD portion of the mark. *Apple Computer v. TVNET.net, Inc*., 90 USPQ2d 1393 (TTAB 2007). *See* **TMEP §1207.01(b)(iii).**

1215.10 Marks Containing the Phonetic Equivalent of a Top-Level Domain

Marks that contain the phonetic equivalent of a non-source-identifying TLD (e.g., ABC DOTCOM) are treated in the same manner as marks composed of the TLD itself. If a disclaimer is necessary, the disclaimer must be in the form of the TLD and not the phonetic equivalent. *See* **TMEP §1213.08(c)** regarding disclaimer of misspelled words.

Example: The mark is INEXPENSIVE RESTAURANTS DOT COM for providing information about restaurants by means of a global computer network. Registration should be refused because the mark is merely descriptive of the services under 15 U.S.C. §1052(e)(1).

Example: The mark is ABC DOTCOM. The applicant must disclaim the TLD ".COM" rather than the phonetic equivalent "DOTCOM."

1216 Effect of Applicant's Prior Registrations

1216.01 Decisions Involving Prior Registrations Not Controlling

Trademark rights are not static, and eligibility for registration must be determined on the basis of the facts and evidence of record that exist at the time registration is sought. *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 1344, 213 USPQ 9, 18 (C.C.P.A. 1982); *In re Thunderbird Products Corp.*, 406 F.2d 1389, 160 USPQ 730 (C.C.P.A. 1969); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001); *In re Styleclick.com Inc.,* 58 USPQ2d 1523 (TTAB 2001); *In re Styleclick.com Inc.*, 57 USPQ2d 1445 (TTAB 2000).

Each case must be decided on its own facts. The USPTO is not bound by the decisions of the examiners who examined the applications for the applicant's previously registered marks, based on different records. *See In re Omega SA,* 494 F.3d 1362, 83 USPQ2d 1541 (Fed. Cir. 2007) (Examining attorney's requirement for amendment of the term "chronographs" in the identification of goods upheld, notwithstanding applicant's ownership of several registrations in which this term appears without further qualification in the identification); *In re Merrill Lynch, Pierce, Fenner & Smith Inc.,* 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987) (incontestable registration of CASH MANAGEMENT ACCOUNT for credit card services did not automatically entitle applicant to registration of the same mark for broader financial services); *In re Loew's Theatres, Inc*., 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) (examining attorney could properly refuse registration on ground that mark DURANGO for chewing tobacco is primarily geographically deceptively misdescriptive, even though applicant owned incontestable registration of same mark for cigars); *In re Rodale Inc.*, 80 USPQ2d 1696 (TTAB 2006) (NUTRITION BULLETIN held generic for "providing information in the field of health and diet via a web site on the Internet," notwithstanding applicant's claims of ownership of six prior registrations on the Supplemental Register that included the term "bulletin" in the mark for related goods and services (e.g., "Weight-Loss Bulletin," "Sex Bulletin," "Muscle Bulletin," and "Nutrition Bulletin")); *In re Best Software Inc.,* 58 USPQ2d 1314 (TTAB 2001) (applicant's ownership of registration for the mark BEST! did not preclude the examining attorney from requiring a disclaimer of "Best" in applications seeking registration of BEST! SUPPORT PLUS and BEST! SUPPORT PLUS PREMIER for the same services plus additional services); *In re Sunmarks Inc*., 32 USPQ2d 1470 (TTAB 1994) (examining attorney not precluded from refusing registration of ULTRA for "gasoline, motor oil, automotive grease, general purpose grease, machine grease and gear oil," even though applicant owned registrations of same mark for "motor oil" and "gasoline for use as automotive fuel, sold only in applicant's automotive service stations"); *In re Medical Disposables Co.*, 25 USPQ2d 1801 (TTAB 1992) (disclaimer of the unitary term "MEDICAL DISPOSABLES" required, notwithstanding applicant's ownership of a prior registration in which a piecemeal disclaimer of the words "MEDICAL" and "DISPOSABLES" was permitted); *In re Perez*, 21 USPQ2d 1075 (TTAB 1991) (likelihood of confusion between applicant's EL GALLO for fresh tomatoes and peppers and the previously registered mark ROOSTER for fresh citrus fruit, notwithstanding applicant's ownership of an expired registration of the same mark for the same goods); *In re Lean Line, Inc*., 229 USPQ 781 (TTAB 1986) (LEAN found merely descriptive of low-calorie foods, even though applicant had registered the term for other goods and services and a third party had registered the term "LEAN CUISINE" with no disclaimer); *In re McDonald's Corp*., 229 USPQ 555 (TTAB 1985) (Board not bound to allow registration of APPLE PIE TREE for restaurant services merely because applicant had succeeded in registering the character and name as trademarks and the character as a service mark); *In re Harcourt Brace Jovanovich, Inc.*, 222 USPQ 820 (TTAB 1984) (LAW & BUSINESS incapable of distinguishing the services of arranging and conducting seminars in the field of business

law, notwithstanding applicant's ownership of a registration on the Supplemental Register for the same mark for books, pamphlets, and monographs); *In re Local Trademarks, Inc*., 220 USPQ 728 (TTAB 1983) (refusal of registration on the ground that WHEN IT'S TIME TO ACT did not identify advertising services upheld; Board not bound to allow registration simply because applicant owned registrations bearing similar recitations of services); *In re Pilon*, 195 USPQ 178 (TTAB 1977) (title of chapter or section of book not registrable, even though applicant owned prior registrations of marks comprising chapter titles). *See also In re Wilson,* 57 USPQ2d 1863 (TTAB 2001) ("Reasoned decisionmaking" doctrine, which prohibits a federal agency from creating conflicting lines of precedent governing identical situations, did not entitle applicant to registration of PINE CONE BRAND for packaged fresh citrus fruit, even though USPTO issued registration for similar PINE CONE mark in 1933 despite then-existing registration for PINE CONE mark that was cited against applicant).

1216.02 Effect of "Incontestability" in Ex Parte Examination

Section 15 of the Trademark Act, 15 U.S.C. §1065, provides a procedure by which a registrant's exclusive right to use a mark in commerce on or in connection with the goods or services covered by the registration can become incontestable. *See* **TMEP §§1605** *et seq.* for information about the requirements for filing an affidavit of incontestability under §15.

In *Park 'N Fly v. Dollar Park & Fly, Inc*., 469 U.S. 189, 224 USPQ 327 (1985), the Supreme Court held that the owner of a registered mark may rely on incontestability to enjoin infringement, and that an incontestable registration, therefore, cannot be challenged on the ground that the mark is merely descriptive.

In *In re American Sail Training Ass'n,* 230 USPQ 879 (TTAB 1986), the Trademark Trial and Appeal Board held that an examining attorney could not require a disclaimer of "TALL SHIPS" in an application for registration of the mark RETURN OF THE TALL SHIPS, where the applicant owned an incontestable registration for the mark TALL SHIPS for the identical services. This would be a collateral attack on an incontestable registration. However, this applies only where both the marks and the goods or services are identical. In *American Sail Training*, the Board noted that the matter required to be disclaimed was "identical to the subject matter of applicant's incontestable registration," and that "the services described in applicant's application are identical to those recited in the prior incontestable registration." 230 USPQ at 880.

For determining likelihood of confusion, the fact that a federally registered trademark has achieved incontestable status means that it is conclusively considered to be valid, but it does not dictate that the mark is "strong." *Safer, Inc. v. OMS Investments, Inc.,* 94 USPQ2d 1031 (TTAB 2010).

Ownership of an incontestable registration does *not* give the applicant a right to register the same mark for different goods or services, even if they are closely related to the goods or services in the incontestable registration. *See In re Save Venice New York Inc.,* 259 F.3d 1346, 59 USPQ2d 1778, 1782 (Fed. Cir. 2001) (applicant's ownership of incontestable registration of the word mark SAVE VENICE for newsletters, brochures, and fundraising services did not preclude examining attorney from refusing registration of a composite mark consisting of the phrases THE VENICE COLLECTION and SAVE VENICE INC. with an image of the winged Lion of St. Mark for different goods; "[a] registered mark is incontestable only in the form registered and for the goods or services claimed.") ; *In re Merrill Lynch, Pierce, Fenner & Smith Inc.,* 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987) (incontestable registration of CASH MANAGEMENT ACCOUNT for credit card services did not automatically entitle applicant to registration of the same mark for broader financial services); *In re Bose Corp.*, 772 F.2d 866, 873 n.5, 227 USPQ 1, 7 n.5 (Fed. Cir. 1985) (incontestable status of registration for one speaker design did not establish non-functionality of another speaker design with shared feature); *In re Loew's Theatres, Inc*., 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) (examining attorney could properly refuse registration on ground that mark DURANGO for chewing tobacco is primarily geographically deceptively misdescriptive, even though applicant owned incontestable registration of same mark for cigars); *In re Best Software Inc.,* 63 USPQ2d 1109, 1113 (TTAB 2002) (applicant's ownership of incontestable registration for the mark BEST! did not preclude the examining attorney from requiring a disclaimer of "BEST" in applications seeking registration of BEST! IMPERATIV HRMS "for goods which, although similar, are nevertheless somewhat different"); *In re Best Software Inc.*, 58 USPQ2d 1314 (TTAB 2001) (applicant's ownership of incontestable registration for the mark BEST! did not preclude the examining attorney from requiring a disclaimer of "BEST" in applications seeking registration of BEST! SUPPORT PLUS and BEST! SUPPORT PLUS PREMIER for the same services plus additional services); *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564 (TTAB 1988), *aff'd,* 883 F.2d 1026 (Fed. Cir. 1989) (examining attorney could properly refuse registration on the ground that a mark is primarily merely a surname even if applicant owned incontestable registration of same mark for unrelated goods); *In re BankAmerica Corp.,* 231 USPQ 873 (TTAB 1986) (examining attorney could refuse registration of the mark BANK OF AMERICA for computerized financial data processing services under §§2(e)(1) and 2(e)(2), despite applicant's ownership of incontestable registrations of the same mark for related services).

1217 Res Judicata, Collateral Estoppel, and Stare Decisis

A prior adjudication against an applicant may be dispositive of a later application for registration of the same mark on the basis of the same facts and issues, under the doctrine of res judicata, collateral estoppel, or stare decisis. Prior adjudications include decisions of the Trademark Trial and Appeal Board or any of the reviewing courts.

Res Judicata. Res judicata, or claim preclusion, protects against relitigation of a previously adjudicated claim between the same parties or their privies based on the same cause of action. *In re Bose Corp*., 476 F.3d 1331, 81 USPQ2d 1748 (Fed. Cir. 2007) (application for registration of speaker design barred by the Federal Circuit's 1985 decision affirming refusal of registration of the same mark for the same goods on the ground that the proposed mark was functional). A plaintiff is barred by res judicata from bringing a second action if: (1) there is identity of parties (or their privies); (2) there has been an earlier final judgment on the merits of a claim; and (3) the second claim is based on the same set of transactional facts as the first. *Sharp Kabushiki Kaisha v. ThinkSharp, Inc.*, 448 F.3d 1368, 1370, 79 USPQ2d 1376, 1378 (Fed. Cir. 2006); *Mayer/Berkshire Corp. v. Berkshire Fashions, Inc.,* 424 F.3d 1229, 1232, 76 USPQ2d 1310, 1312 (Fed. Cir. 2005); *Jet, Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 1362, 55 USPQ2d 1854, 1856 (Fed. Cir. 2000). A defendant in an earlier proceeding is precluded from bringing a later action if: (1) the claim or defense asserted in the second action was a compulsory counterclaim that the defendant failed to assert; or (2) the claim or defense represents what is essentially a collateral attack on the first judgment. *Nasalok Coating Corp. v. Nylok Corp*., 522 F.3d 1320, 1324, 86 USPQ2d 1369, 1372 (Fed. Cir. 2008) (cancellation petitioner was barred from challenging the validity of the subject registration where the petitioner could have asserted, but did not assert, a claim of invalidity in an earlier infringement action, the Court finding that the cancellation petition amounted to an attack on the district court's judgment).

Identity of Parties. The examining attorney should not invoke res judicata based on an inter partes case or a federal court proceeding involving the applicant, since there is no identity of parties. In this situation, the examining attorney may rely on stare decisis. *In re Alfred Dunhill Ltd.,* 224 USPQ 501, 503 n.7 (TTAB 1984); *In re Multivox Corp. of America,* 209 USPQ 627 (TTAB 1981); *In re Bordo Products Co.,* 188 USPQ 512 (TTAB 1975). Collateral estoppel may be invoked even where identity of parties is lacking, if the other prerequisites for applying the doctrine are met.

Same Set of Transactional Facts. Even when there is an identity of parties, a claim for trademark infringement is not the same as an inter partes claim for opposition or cancellation of the registration of a mark. The Court of Appeals for the Federal Circuit has warned that the USPTO should use caution in applying res judicata based on an infringement action, because infringement actions and Board proceedings are "different causes of action [that] may involve different sets of transactional facts, different proofs, different burdens and different public policies. Registrability is not at issue in infringement litigation, and although the likelihood of confusion analysis presents a 'superficial similarity,' differences in transactional facts will generally avoid preclusion." *Mayer/Berkshire*, 424 F.3d at 1232, 76 USPQ2d at 1313, citing *Jet,* 223 F.3d at 1364-65, 55 USPQ2d at 1857. *See also Nasalok*, 522 F.3d at 1324, 86 USPQ2d at 1372.

Collateral Estoppel. In the absence of res judicata, the related principle of collateral estoppel or issue preclusion can also bar relitigation of the same issue in a second action. Collateral estoppel applies where: (1) there was an identical issue in a prior proceeding; (2) the issue was actually litigated; (3) determination of the issue was necessary to the judgment in the prior proceeding; and (4) the party defending against preclusion had a full and fair opportunity to litigate the issue in the prior proceeding. *Mayer/Berkshire*, 424 F.3d at 1232, 76 USPQ2d at 1313; *Jet, Inc. v. Sewage Aeration Systems*, 223 F.3d at 1366, 55 USPQ2d at 1859 . In *Lukens Inc. v. Vesper Corp.,* 1 USPQ2d 1299, 1301 (TTAB 1986), *aff'd unpub. opin.*, 831 F.2d 306 (Fed. Cir. 1987), the Board applied collateral estoppel in an opposition proceeding based on a prior judgment in an ex parte proceeding in 1957, because the applicant had appealed the decision to federal district court and as such had the opportunity to introduce new evidence and had a "full and fair opportunity" to litigate the issue of functionality. On the other hand, in *Flowers Industries, Inc. v. Interstate Brands Corp.,* 5 USPQ2d 1580, 1584 (TTAB 1987), the Board refused to apply collateral estoppel, distinguishing *Lukens* and noting that "the absence of a prior resort to [trial de novo in federal court] in the present case weighs heavily against the application of issue preclusion." In *Nextel Communications, Inc. v. Motorola, Inc.,* 91 USPQ2d 1393 (TTAB 2009), the Board found issue preclusion and entered judgment in favor of opposer on the issue of whether applicant's 911 Hz chirp sound functioned as a mark for applicant's two-way radios, based on an earlier opposition proceeding involving the same parties and nearly the same proposed mark, but found issue preclusion inapplicable as to other goods that were not at issue in the earlier proceeding. In *Daimler Chrysler Corp. v. Maydak*, 86 USPQ2d 1945 (TTAB 2008), the Board held that it did not need to decide a collateral estoppel claim where a permanent injunction issued during civil litigation between the parties prohibits the applicant from using or registering the mark for any products or services, therefore making its registration by the applicant "a legal impossibility."

Stare Decisis. Stare decisis provides that when a court has once laid down a principle of law as applicable to a certain set of facts, it will adhere to that principle, and apply it to all future cases, where the facts are substantially the same, regardless of whether the parties and properties are the same. *In re Johanna Farms Inc.*, 8 USPQ2d 1408 (TTAB 1988).

Changed Circumstances. All these doctrines are discretionary and will not be applied where circumstances relating to trademark use and consumer recognition have changed since the prior judgment was rendered. *See In re Honeywell Inc.*, 8 USPQ2d 1600 (TTAB 1988) (res judicata did not preclude application for registration of a configuration of a circular thermostat cover based on prior decisions holding the design functional, where the marks were somewhat different, and the applicant presented evidence that conditions in the marketplace had changed in the seventeen years since the record in its prior application closed); *In re Johanna Farms, supra* (stare decisis did not preclude registration of LA YOGURT for yogurt under

§2(f) based on a prior decision holding the mark unregistrable on the Supplemental Register, where applicant submitted additional evidence in the nature of a survey and consumer letters dealing with the question of how purchasers perceive the proposed mark); *Flowers Industries, supra* (application for registration of HONEY WHEAT for bread under §2(f) not precluded by a forty-year old Commissioner's decision affirming a refusal of registration of the same mark on the same grounds, because the applicant had now used the proposed mark for more than fifty years, whereas its predecessor had used it for only ten years at the time of the earlier decision); *Bordo, supra* (Board held that application for registration of BORDO for pitted dates was not precluded by decision in an opposition by the owner of the cited registration against applicant's earlier application for the same mark for the same goods, finding changed circumstances based on affidavits that the goods move through different channels of trade, evidence of contemporaneous use for over fifty years with no known actual confusion, and the failure of the owner of the cited registration to take steps to enjoin applicant from using the mark).

In *Bose*, *supra*, the applicant argued that facts and circumstances had changed since the prior decision in that: (1) the Court did not explicitly consider the "curved front edge" of the design in the prior decision; (2) there had been a change in the legal standard for functionality, in view of the Supreme Court's decision in *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001 (2001); and (3) applicant had presented "additional evidence, such as the absence of promotional material that 'touts' the utilitarian aspects of the mark." The Court rejected these arguments, noting that it had acknowledged in the prior decision that the design includes a "bowed front edge," and "bowed" is simply another term for "curved;" that *TrafFix* does not affect the prior functionality analysis and provides further support for finding that Bose's design is functional; and that the focus on advertising materials which do not promote the utilitarian aspects of the curved front edge is not relevant, because the proposed mark was an entire pentagonal-shaped design and not merely the curved front edge, and the promotional advertisements submitted in the earlier case "did clearly promote the functional reason for the overall design."

Slight differences in a mark or in an identification of goods/services will not avoid application of these doctrines. *In re Orion Research Inc.*, 669 F.2d 689, 205 USPQ 688 (C.C.P.A. 1980); *Miller Brewing Co. v. Coy Int'l Corp.*, 230 USPQ 675 (TTAB 1986).

See also MasterCard Int'l Inc. v. American Express Co., 14 USPQ2d 1551 (TTAB 1990) (applicant barred by collateral estoppel from litigating the issue of descriptiveness or genericness of the proposed mark as used on the services that were the subject of the prior proceeding, but may go forward with respect to use of the mark on other services).

Final Decision Required. These doctrines should be invoked only after the time for further court review has expired and no such review has been sought or, if sought, the review action has been terminated. If a proceeding is pending, the examining attorney may suspend action on the application pending termination, once all other matters are in condition for publication or final refusal. *See* **TMEP §716.02(d)** regarding suspension.

Examining Attorney Should Issue Appropriate Refusals. The examining attorney should issue refusals based on res judicata, collateral estoppel, or stare decisis, as appropriate, but should not rely exclusively on such doctrines. Even if the examining attorney believes that registration is barred by one of these doctrines, he or she must also issue and provide full evidentiary support for any relevant substantive refusals.

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