

**UNITED STATES
PATENT AND TRADEMARK OFFICE**





Overview of common failure-to-function refusals

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UNITED STATES
PATENT AND TRADEMARK OFFICE ®

Discussion topics

- Failure-to-function overview
- Failure-to-function refusals
- USPTO resources

Discussion topic

Failure-to-function overview

Failure-to-function overview

- What is the function of a trademark?
 - “A proposed trademark is registrable only if it functions as an identifier of the source of the applicant’s goods or services.”

DRINK MORE BEER





Failure-to-function overview

- What if a trademark fails to function?
 - Principal Register
 - It will be refused registration under Sections 1, 2, and 45 of the Trademark Act.
 - Supplemental Register
 - It will be refused registration under Sections 23(c) and 45 of the Trademark Act.





Failure-to-function overview

- How can we tell if it fails to function?
 - Review:
 - Specimens
 - Evidence of record
 - Mark drawing
 - Mark description



Failure-to-function overview

- Common failure-to-function refusals
 - Ornamentation
 - Title of a single work
 - Name of artist or author
 - Not goods in trade/services for others

Discussion topic

Failure-to-function refusal: Ornamentation

Ornamentation

- Concept
 - Cannot register **decorative features** that don't identify the source of the goods
 - Words
 - Slogans
 - Designs
 - Trade dress

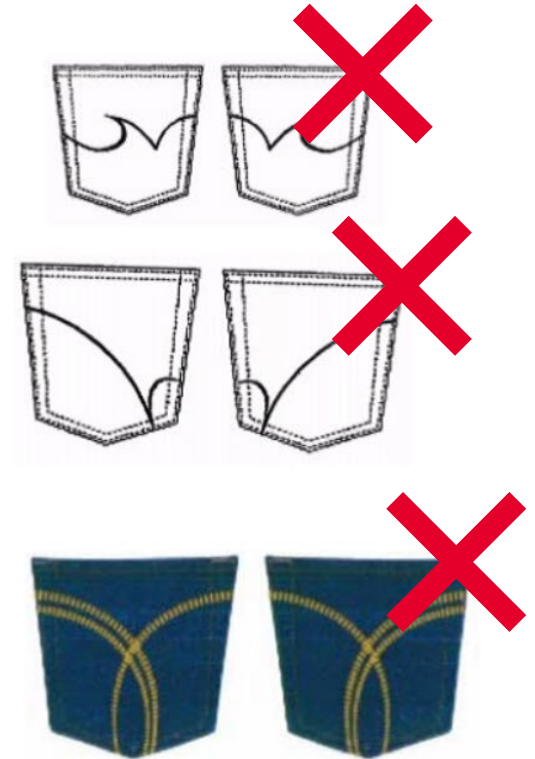


Ornamentation

- Factors determining registrability
 - Commercial impression
 - Practices of the trade
 - Secondary source
 - Evidence of distinctiveness

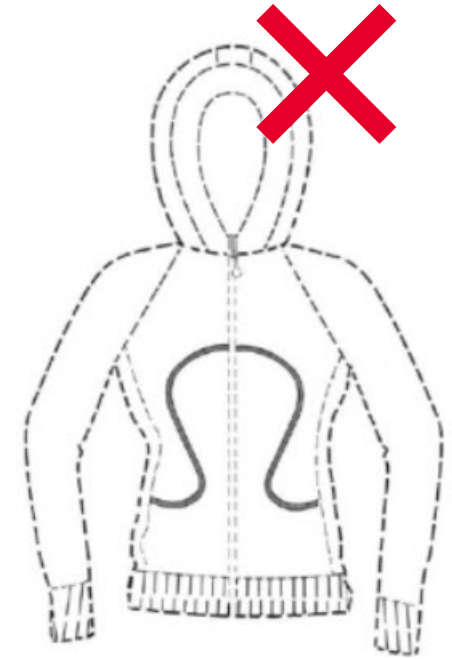
Ornamentation refusal example

- Stitching designs on the back pocket of a pair of jeans
 - Mere refinement of a common practice in the industry
 - Size of design
 - Dominance of design
 - Mirror image of design



Ornamentation refusal example

- Large display of logo on the front of the garment
 - Commercial impression
 - Simple piping
 - Practices of the trade
 - Size of design
 - Dominance and location of design



Ornamentation refusal example

- Phrase comprising the goods
 - Commercial impression
 - Term of endearment
 - Common practice in the trade
 - Many examples in the record of third parties using the phrase on bracelets and jewelry



Ornamentation response options

- Ways to overcome the refusal
 - Submit a different specimen.
 - Claim acquired distinctiveness.
 - Amend to Supplemental Register.
 - Submit secondary source evidence.
 - Amend filing basis to §1(b) intent-to-use basis.



Ornamentation takeaways

- Pro tips
 - Consider third-party use of the trademark.
 - Research whether consumers are accustomed to seeing similar ornamental displays.
 - For secondary source, ensure acceptable use on other goods and services, not just ornamental use on a series of items.



Knowledge check

- Is this acceptable trademark use?

Drawing

YOU ARE
SPECIAL TODAY

Specimen



uspto®

Discussion topic

**Failure-to-function refusal:
Title of a single work**



Title of a single work

- Concept
 - Cannot register the **title** of a single creative work
 - Cannot register a **portion of the title** of a single creative work



Title of a single work

- Factors determining registrability
 - Complete title of a single work
 - The content does not change significantly
 - Is not used on a series of works
 - Is not considered a single work



Title of a single work

- Single creative work
 - Book
 - Serialized writing
 - Sound recording
 - Downloadable song
 - Downloadable ringtone
 - Film
 - Single radio program
 - Single television program
 - Scripted theatrical performance

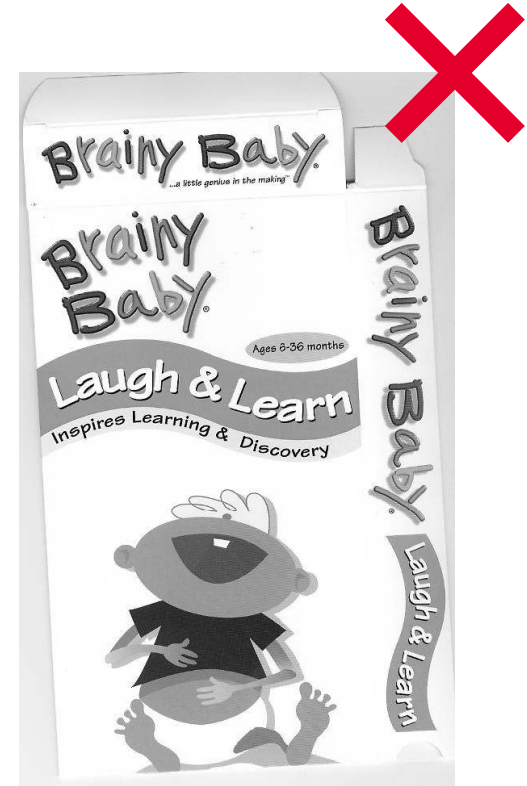


Title of a single work

- Not considered a single creative work
 - Magazines
 - Newsletters
 - Comic books
 - Guide books
 - Printed classroom materials
 - Computer software
 - Computer games
 - Coloring books
 - Activity books
 - Live musical performances

Single work refusal example

- Title of prerecorded audio-visual materials
 - No evidence of series of LAUGH & LEARN videos
 - Content on DVD and VHS tape was essentially the same work delivered into two formats



Single work refusal example

- Title of music instruction book
 - No evidence of series of INSTANT KEYBOARD books
 - Use of mark on specimen
 - Appears on cover of book
 - Appears on spine of book
 - Appears on first page of book





Title of a single work

- Factors determining registrability
 - Portion of a title of a single work
 - Creates a separate commercial impression apart from the complete title;
 - Is used on a series of works; and
 - Is promoted or recognized as a mark for the series.

Single work refusal example

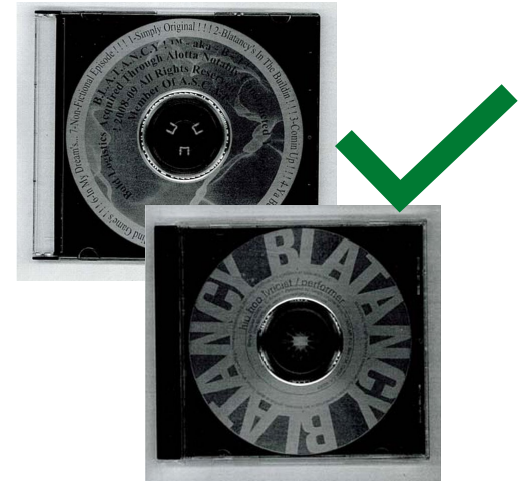
- Portion of title of series of books
 - THE MAGIC SCHOOL BUS creates a separate commercial impression from each title
 - Evidence of series of books
 - Evidence applicant promotes THE MAGIC SCHOOL BUS as a series title



Single work response options

- Ways to overcome the refusal

- Submit evidence of a series.
- Submit evidence the goods are not a single creative work.
- Delete the refused goods or services from the identification.
- Amend filing basis to §1(b) intent-to-use basis.



Single work takeaways

- Pro tips
 - Remember trademarks provide protection for brands, not creative works.
 - Cannot amend to Supplemental Register.
 - Cannot claim §2(f) acquired distinctiveness.

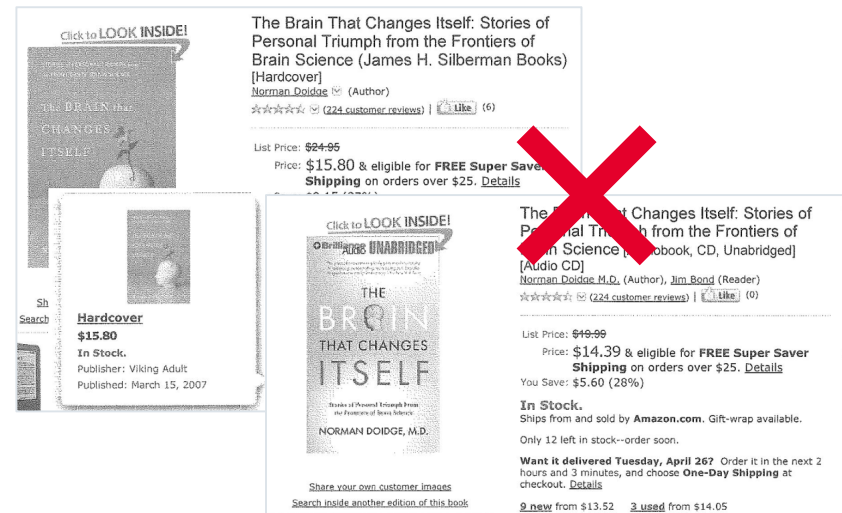
Knowledge check

- Is this acceptable trademark use?

Drawing

THE BRAIN THAT
CHANGES ITSELF

Specimen



Discussion topic

Failure-to-function refusal: Names of artists and authors

Artists and authors

- Concept
 - Cannot register the **name of an author** on a written work if it is used solely to identify the author
 - Cannot register the **name of a performing artist** on a sound recording if it is used solely to identify the artist

Artists and authors

- Factors determining registrability
 - Evidence of a series of works; and
 - Evidence name identifies the source of the series
 - Promotion and recognition of the name; or
 - Control over the nature and quality of the goods

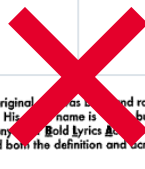
Name of artist refusal example

- Name of artist

- Evidence of a series of musical recordings

- No evidence BLATANCY

- Controls the nature and quality of the goods
 - Promoted and recognized as the source of the goods



'SIMPLY ORIGINAL' ©2008
J. Arnold
Publisher: Simply Original Music™ (ASCAP)

Producer: **BLATANCY™**, for Simply Original Music (ASCAP)
Production /Distribution: J. Arnold for Simply Original Music (ASCAP)
Mixtape: Nebula
Management: Coming Up Records/ jta@cominguprecords.com
Inspiration: Chris 'Black Swann' Swann, Donna Wolf
Photography: www.resolusean.com
Eyewear: Exalt Cycle

BLATANCY™
Official Website: www.blatancy.net
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WARNING: All rights reserved. Unauth performance/broadcasting prohibited.
Produced in the USA.

BLATANCY™ is simply original music raised on the West Coast of 'Calif' in San Diego. His name is but his performance name, **BLATANCY™**, is an acronym for **B**old **L**yrics **A**nd **T**hrough **A**lotta **N**otably **C**onstructed **Y**ears, and both the definition and acronym influences his lyrics.

"Music is my life. After being hit by a car as a young boy and suffering a brain injury - I thank God for all he has given me that is good. The pain and the joy blended together over the years lead me to music as an outlet. First, lessons presented melodically. Then, I started writing lyrics as a way to process the pain, and out of that joy was created...and it's all good. I am who I am today because of this."

The encouragement, guidance and support I have received from Kevin 'D.J. Battlecat' Gilliam and Chris 'Black Swann' Swann, can only be repaid when I can 'pay it forward' encouraging others. You are a blessing and role models for all of us, in music, and as men. To: Ice-T, DMC, and other ASCAP brothers and sisters pushing me to follow my dreams, you have been a gift that is also much appreciated. I won't let you down!

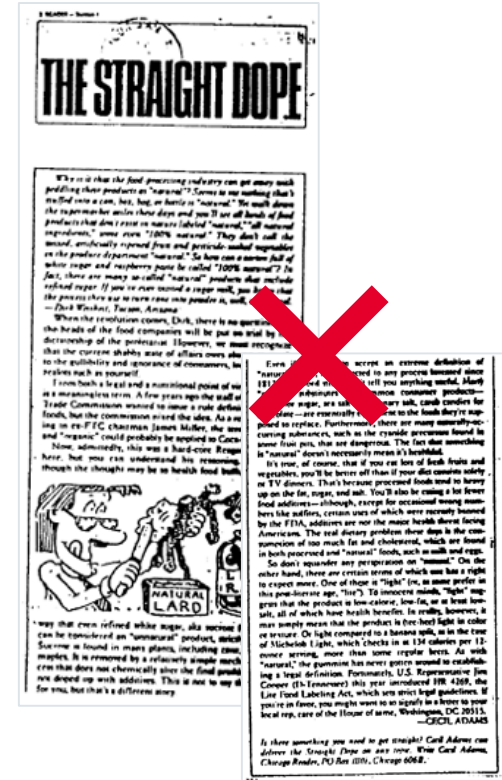
This wouldn't be possible without my family, always there for me, my grandparents whose own lives revolved around music, my many friends, and those fans who listen to my music.

"This be my futuristic flow, to let you know that I am...
Simply Original!™ ©2009

BLATANCY™ aka 'B-1'

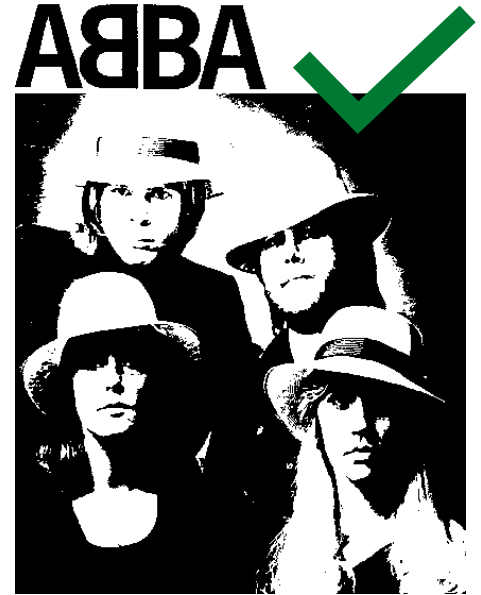
Name of author refusal example

- Name of author
 - Evidence of a series of writings
 - No evidence CECIL ADAMS
 - Controls the nature and quality of the goods
 - Promoted and recognized as the source of the goods



Author/artist response options

- Ways to overcome the refusal
 - Submit evidence that
 - Series of works; and
 - Name identifies source.
 - Amend filing basis to §1(b) intent-to-use basis.
 - Amend to Supplemental Register.





Name of author/artist takeaways

- Pro tips
 - Refusal applies to pseudonyms.
 - Refusal does not apply to services.
 - Refusal does not apply to names of artists used on original works of art.
 - Cannot claim §2(f) acquired distinctiveness.

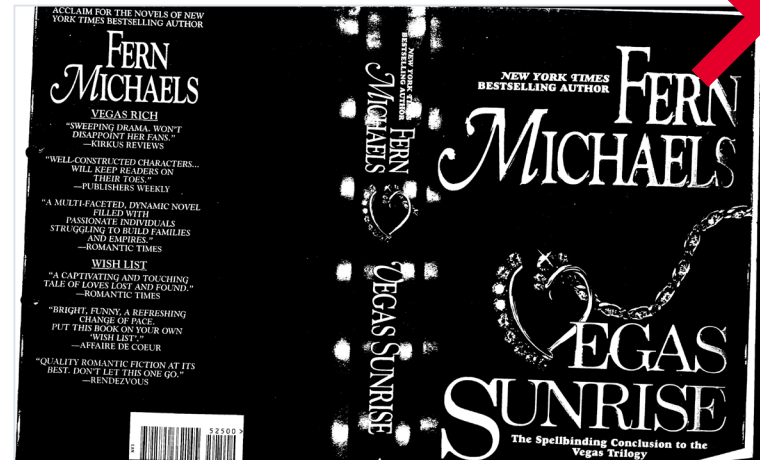
Knowledge check

- Is this acceptable trademark use?

Drawing

FERN MICHAELS

Specimen



Discussion topic

Failure-to-function refusal: Goods in trade/services for others



Goods in trade/services for others

- Concept
 - Cannot register a trademark if it is not used with **goods in trade**
 - Cannot register a service mark if it is not used with **activities performed for others**



Goods in trade

- Factors determining registrability
 - Goods must have utility to others:
 - Cannot exist only to help customers obtain applicant's primary goods or services
 - Cannot be so inextricably tied to the primary goods or services that they have no existence otherwise
 - Sold separately or have independent value apart from applicant's primary goods and services





Goods in trade

- Not goods in trade

- Letterhead

- Invoices

- Reports

- Boxes

- Business forms

- Checkbooks

- Brochures

- Pamphlets

- Mockups

- Holiday greeting cards



Services for others

- Factors determining registrability
 - Services must:
 - Be a real activity
 - Be performed for the benefit of others; and
 - Be sufficiently distinct from the applicant's principal activity



Services for others

- Not services for others

- Concept or idea

- System

- Process

- Method

- Intranet website

- Soliciting investors

- Advertising and promoting own goods

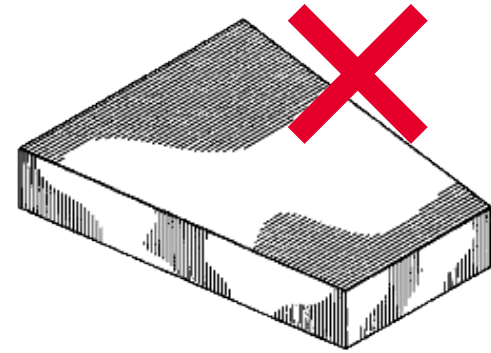
- Performing clinical trials for own goods

- Publishing own periodical



Goods in trade refusal example

- Not goods in trade
 - Boxes are point-of-sale containers for the toys, games, and playthings
 - Boxes are incidental to applicant's primary goods.
 - Not separately marketed as carrying cases



Services for others refusal example

- Not services for others
 - Creating a social media account does not equal “creating an online community for users”
 - Using a social media account to advertise and promote your business is not a service provided for others



Goods/services response options

- Ways to overcome the refusal

- Delete the goods or services.

- Submit evidence:

- Goods have utility apart from promotional use

- Services are real, performed for others, and sufficiently distinct.

- Amend filing basis to §1(b) intent-to-use basis.



Goods/services takeaways

- Pro tips
 - Think about it from the customer's point of view.
 - What are the primary goods or services provided by the applicant?
 - Cannot amend to Supplemental Register.
 - Cannot claim §2(f) acquired distinctiveness.

Knowledge check

- Is this acceptable trademark use?

Drawing

Specimen



RX GUARDIAN

Test Performed	Lab Result (ng/mL)	Assay Cutoff (ng/mL)	Normalized Value	Expected Range: Low	Expected Range: High	Range Comparison	Medication Comparison
OPIATES							
Oxycodone (A)	1972	50	1810	110	351	Above Range	
Codone (MS)	Negative	100					Consistent
Morphine (MS)	Negative	100					Consistent
Hydrocodone (MS)	1312	100					INCONSISTENT
Hydroxycodone (MS)	214	100					INCONSISTENT
RESULTS EXPLANATION							
The presence of both Hydrocodone and Hydroxycodone has been confirmed. This is evidence of using a hydrocodone medication. Hydroxycodone is a metabolite of hydrocodone as well as a prescription drug. Possible sources include (but are not limited to) Loraxil, Loraxil or Vicodin. Detection time for these drugs is 2-3 days.							
Oxycodone/Oxycodone (A)	Positive	100					
Oxycodone (MS)	1897	100					Consistent
Oxycodone (MS)	2000	100					Consistent
SYNTHETIC OPIOIDS							
Methadone							
ESDA (A)	Positive	100					Consistent
Methadone (A)	1742	150	150	53	209	In Range	
Buprenorphine							
Proprietary (A)	Negative	180					
SEDATIVE/HYPNOTICS							
Benzodiazepines							
Benzodiazepines (A)	115	100	100	103	381	In Range	
Norflazepam (MS)	109	75					Consistent
Oxazolam (MS)	1253	75					Consistent
Lorazepam (MS)	Negative	75					Consistent
Alprazolam (MS)	Negative	75					Consistent
Alprazolam/Alprazolam (MS)	Negative	75					Consistent
Barbiturates							
Barbiturates (A)	Negative	200					
STIMULANTS							
Amphetamines							
Amphetamines (A)	Negative	800					

Discussion topic

USPTO resources



USPTO resources

- Website
 - www.uspto.gov
- Trademark videos
 - www.uspto.gov/TMvideos
- Trademark Manual of Examining Procedure
 - www.uspto.gov/TMEP



USPTO resources

The screenshot shows the USPTO website interface. At the top, there is a dark header with the USPTO logo and the text 'UNITED STATES PATENT AND TRADEMARK OFFICE'. To the right of the logo are links for 'About Us', 'Jobs', 'Contact Us', and 'MyUSPTO'. Below the header is a search bar with the text 'Search uspto.gov' and a magnifying glass icon. A navigation bar below the search bar contains links for 'Patents', 'Trademarks', 'IP Policy', and 'Learning and Resources', along with a 'Find It Fast' button. Below the navigation bar is a blue banner with the breadcrumb 'Home > Trademarks > Maintain > Responding to office actions' and 'Share' and 'Print' icons. The main content area has a left sidebar with a list of links: 'Application process', 'Searching trademarks', 'Apply online', 'Disclosure of public information', 'Checking application status & viewing documents', 'Responding to Office actions' (highlighted), 'Abandoned applications', 'Ordering certified documents', and 'Trademark Trial and Appeal Board'. The main content area features the title 'Responding to office actions' and a paragraph: 'The United States Patent and Trademark Office (USPTO) may issue several different types of office actions about your trademark application. This page focuses on office actions that trademark examining attorneys send during the application process.' Below the paragraph are links for 'Expand all' and 'Collapse all', followed by a list of six expandable sections: 'What is an office action?', 'Deadline for filing a timely response', 'How to file a response', 'File a complete response', 'Who to contact with questions about your office action', and 'Responding to common refusals or requirements'.

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Application process

Searching trademarks

Apply online

Disclosure of public information

Checking application status & viewing documents

Responding to Office actions

Abandoned applications

Ordering certified documents

Trademark Trial and Appeal Board

Responding to office actions

The United States Patent and Trademark Office (USPTO) may issue several different types of office actions about your trademark application. This page focuses on office actions that trademark examining attorneys send during the application process.

[Expand all](#) | [Collapse all](#)

- > What is an office action?
- > Deadline for filing a timely response
- > How to file a response
- > File a complete response
- > Who to contact with questions about your office action
- > Responding to common refusals or requirements

USPTO resources

- Presentation refusals
 - Ornamentation: [TMEP §1202.03](#)
 - Title of single creative work: [TMEP §1202.08](#)
 - Name of author or artist: [TMEP §1202.09](#)
 - Goods in trade: [TMEP §1202.06](#)
 - Services for others: [TMEP §1301.01](#)

USPTO resources

- Additional references
 - Names of columns and sections of publications: [TMEP §1202.07](#)
 - Names and designs of characters in creative works: [TMEP §1202.10](#)
 - Names of characters or personal names as service marks: [TMEP §1301.02\(b\)](#)



Questions?



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