Chapter 1200 Substantive Examination of Applications

1201 **Ownership of Mark**
1201.01 Claim of Ownership May Be Based on Use By Related Companies
1201.02 Identifying the Applicant in the Application
1201.02(a) Identifying the Applicant Properly
1201.02(b) Application Void if Wrong Party Identified as the Applicant
1201.02(c) Correcting Errors in How the Applicant Is Identified
1201.02(d) Operating Divisions
1201.02(e) Changes in Ownership After Application Is Filed
1201.03 Use by Related Companies
1201.03(a) No Explanation of Use of Mark by Related Companies or Applicant's Control Over Use of Mark by Related Companies Required
1201.03(b) Wholly Owned Related Companies
1201.03(c) Common Stockholders, Directors, or Officers
1201.03(d) Sister Corporations
1201.03(e) License and Franchise Situations
1201.04 Inquiry Regarding Parties Named on Specimens or Elsewhere in Record
1201.05 Acceptable Claim of Ownership Based on Applicant's Own Use
1201.06 Special Situations Pertaining to Ownership
1201.06(a) Applicant Is Merely Distributor or Importer
1201.06(b) Goods Manufactured in a Country Other than Where Applicant Is Located
1201.06(c) Applicant Using Designation of a U.S. Government Agency or Instrumentality
1201.07 Related Companies and Likelihood of Confusion
1201.07(a) "Single Source" – "Unity of Control"
1201.07(b) Appropriate Action with Respect to Assertion of Unity of Control
1201.07(b)(i) When Either Applicant or Registrant Owns All of the Other Entity
1201.07(b)(ii) Joint Ownership or Ownership of Substantially All of the Other Entity
1201.07(b)(iii) When the Record Does Not Support a Presumption of Unity of Control
1201.07(b)(iv) When the Record Contradicts an Assertion of Unity of Control
1202 **Use of Subject Matter as Trademark**
1202.01 Refusal of Matter Used Solely as a Trade Name
1202.02 Registration of Trade Dress
1202.02(a) Functionality of Trade Dress
1202.02(a)(i) Statutory Basis for Functionality Refusal
1202.02(a)(ii) Purpose of Functionality Doctrine
1202.02(a)(iii) Background and Definitions
1202.02(a)(iii)(A) Functionality
1202.02(a)(iii)(B) "De Jure" and "De Facto" Functionality
1202.02(a)(iv) Burden of Proof in Functionality Determinations
1202.02(a)(v) Evidence and Considerations Regarding Functionality Determinations
1202.02(a)(v)(A) Utility Patents and Design Patents
1202.02(a)(v)(B) Advertising, Promotional, or Explanatory Material in Functionality Determinations
1202.02(a)(v)(C) Availability of Alternative Designs in Functionality Determinations
1202.02(a)(v)(D) Ease or Economy of Manufacture in Functionality Determinations
1202.02(a)(vi) Aesthetic Functionality
1202.02(a)(vii) Functionality and Service Marks
1202.02(a)(viii) Functionality and Non-Traditional Marks
1202.02(b) Distinctiveness of Trade Dress
1202.02(b)(i) Distinctiveness and Product Design Trade Dress
1202.02(b)(ii) Distinctiveness and Product Packaging Trade Dress
1202.02(c) Drawings, Descriptions, and Disclaimers in Trade Dress Applications

1202.02(c)(i) Drawings of Trade Dress Marks
1202.02(c)(i)(A) Functional Matter
1202.02(c)(i)(B) Nondistinctive Matter
1202.02(c)(i)(C) Drawings in §44 and §66(a) Applications
1202.02(c)(ii) Descriptions of Trade Dress Marks Required
1202.02(c)(iii) Disclaimers of Unregistrable Elements of Trade Dress Marks
1202.02(c)(iii)(A) Functional Matter
1202.02(c)(iii)(B) Nondistinctive Matter
1202.02(c)(iv) Three-Dimensional Marks
1202.02(d) Trade Dress in §1(b) Applications
1202.02(e) Trade Dress in §44 and §66(a) Applications
1202.02(f) Identification of Goods/Services in Trade Dress Applications
1202.02(f)(i) Product Design
1202.02(f)(ii) Product Packaging
1202.03 Refusal on Basis of Ornamentation
1202.03(a) Commercial Impression
1202.03(b) Practices of the Trade
1202.03(c) "Secondary Source"
1202.03(d) Evidence of Distinctiveness
1202.03(e) Ornamentation with Respect to §1(b), §44, and §66(a) Applications
1202.03(f) Ornamentation: Case References
1202.03(f)(i) Slogans or Words Used on the Goods
1202.03(f)(ii) Designs Used on the Goods
1202.03(f)(iii) Trade Dress on the Containers for the Goods
1202.03(g) Ornamentation Cases and Acquired Distinctiveness
1202.04 Informational Matter
1202.04(a) General Information About the Goods or Services
1202.04(b) Widely Used Messages
1202.04(c) Matter from Religious Texts
1202.04(d) Response Options
1202.05 Color as a Mark
1202.05(a) Color Marks Never Inherently Distinctive
1202.05(b) Functional Color Marks Not Registrable
1202.05(c) Color as a Separable Element
1202.05(d) Drawings of Color Marks Required
1202.05(d)(i) Drawings of Color Marks in Trademark Applications
1202.05(d)(ii) Drawings of Color Marks in Service Mark Applications
1202.05(d)(iii) Amendment of Drawings of Color Marks
1202.05(d)(iv) Drawings for Marks Including Both Color and Words or Design
1202.05(e) Written Descriptions of Color Marks
1202.05(f) Specimens for Color Marks
1202.05(g) Special Considerations for Service Mark Applications
1202.05(h) Color Marks in §1(b) Applications
1202.05(i) Color Marks in §44 or §66(a) Applications
1202.06 Goods in Trade
1202.06(a) Goods Must Have Utility to Others
1202.06(b) Registration Must Be Refused if Trademark Not Used on Goods in Trade
1202.06(c) Goods in Trade in §1(b), §44, and §66(a) Applications
1202.07 Marks That Identify Columns, Sections, and Supplements of Publications
1202.07(a) Marks That Identify Columns, Sections, and Supplements of Printed, Downloadable, or Recorded Publications in §1(a) Applications

1202.07(a)(i) Syndicated Columns and Sections in §1(a) Applications
1202.07(a)(ii) Non-Syndicated Columns and Sections in §1(a) Applications
1202.07(a)(iii) Marks That Identify Columns and Sections of Printed, Downloadable, or Recorded Publications in §1(b), §44, and §66(a) Applications
1202.07(b) Marks That Identify Columns and Sections of Online Publications
1202.08 Title of a Single Creative Work
1202.08(a) What Constitutes a Single Creative Work
1202.08(b) What Does Not Constitute a Single Creative Work
1202.08(c) Complete Title of the Work – Evidence of a Series
1202.08(d) Portion of a Title of the Work
1202.08(d)(i) Mark Must Create a Separate Commercial Impression
1202.08(d)(ii) Establishing a Series When the Mark is a Portion of the Title
1202.08(d)(iii) Evidence that the Portion of the Title is Promoted or Recognized as a Mark
1202.08(e) Identification of Goods/Services
1202.08(f) Title of a Single Work in §1(b), §44, and §66(a) Applications
1202.09 Names of Artists and Authors
1202.09(a) Names and Pseudonyms of Authors and Performing Artists
1202.09(a)(i) Author or Performer's Name – Evidence of a Series
1202.09(a)(ii) Evidence that the Name is a Source Identifier
1202.09(a)(ii)(A) Promotion and Recognition of the Name
1202.09(a)(ii)(B) Control over the Nature and Quality of the Goods
1202.09(a)(iii) Names of Authors and Performing Artists in §1(b), §44, and §66(a) Applications
1202.09(b) Names of Artists Used on Original Works of Art
1202.10 Names and Designs of Characters in Creative Works
1202.10(a) Names and Designs of Characters in Creative Works in §1(b), §44, or §66(a) Applications
1202.11 Background Designs and Shapes
1202.12 Varietal and Cultivar Names (Examination of Applications for Seeds and Plants)
1202.13 Scent, Fragrance, or Flavor
1202.14 Holograms
1202.15 Sound Marks
1202.16 Model or Grade Designations
1202.16(a) Examination of Marks with Model and Grade Designations
1202.16(b) Identifying Model and Grade Designations in Marks
1202.16(b)(i) Model Designations
1202.16(b)(i)(A) Stylization of Display
1202.16(b)(i)(B) Size of Proposed Mark
1202.16(b)(i)(C) Physical Location
1202.16(b)(ii) Grade Designations
1202.16(c) Procedures for Handling Marks with Model and Grade Designations
1202.16(c)(i) Evidentiary Considerations when Issuing Model or Grade Designation Refusals
1202.16(c)(i)(A) Model Designations
1202.16(c)(i)(B) Grade Designations
1202.16(c)(ii) Entire Mark Consists of Model or Grade Designation in §1(a) Applications
1202.16(c)(iii) Composite Mark with Model or Grade Designation in §1(a) Applications
1202.16(c)(iii)(A) Model or Grade Designations with Arbitrary and/or Suggestive Matter
1202.16(c)(iii)(B) Model or Grade Designations with Descriptive, Generic, and/or Informational Matter
1202.16(c)(iv) Drawing and Specimen Agreement Issues in §1(a) Applications

1202.16(c)(v) Model or Grade Designation in §1(b), §44, or §66(a) Applications
1202.16(c)(v)(A) Model Designations
1202.16(c)(v)(B) Grade Designations
1202.17 Universal Symbols in Marks
1202.17(a) Relevance of Universal Symbols to Examination
1202.17(b) Reviewing Marks Containing Symbols
1202.17(b)(i) Identifying Universal Symbols in Marks
1202.17(b)(ii) Marks Displaying an Unusual Depiction of a Universal Symbol
1202.17(b)(iii) Marks Displaying an Accurate Depiction of a Universal Symbol
1202.17(c) Failure to Function
1202.17(c)(i) Determining Whether a Universal Symbol Functions as a Source Indicator
1202.17(c)(i)(A) Informational Universal Symbols
1202.17(c)(i)(B) Ornamental Universal Symbols
1202.17(c)(ii) Mark Consists Entirely of a Universal Symbol that Fails to Function
1202.17(c)(ii)(A) Applications Based on Sections 1(b), 44, or 66(a)
1202.17(c)(ii)(B) Applicant's Response to Refusal
1202.17(c)(iii) Mark Includes a Universal Symbol that Fails to Function
1202.17(d) Other Relevant Refusals
1202.17(d)(i) Merely Descriptive
1202.17(d)(ii) Deceptive or Deceptively Misdescriptive
1202.17(e) Universal Symbols Commonly Appearing in Marks
1202.17(e)(i) Awareness Ribbon Symbols
1202.17(e)(ii) Recycling Symbol
1202.17(e)(iii) Caduceus, Rod of Asclepius, and Prescription Symbol
1202.17(e)(iv) Religious Symbols
1202.17(e)(v) Currency Symbols
1202.17(e)(vi) Universal Prohibition Symbol
1202.18 Hashtag Marks
1202.18(a) Disclaiming HASHTAG or Hash Symbol
1202.18(b) Marks Consisting Solely of HASHTAG or Hash Symbol
1202.19 Repeating-Pattern Marks
1202.19(a) Drawing Requirements for Repeating-Pattern Marks
1202.19(a)(i) Mark Used on a Single Item
1202.19(a)(ii) Mark Used in a Similar Manner on Similar Items
1202.19(a)(iii) Mark Used in Various Ways or on Various Items Swatch-Type Drawings
1202.19(a)(iv) Drawings for Service Marks
1202.19(b) Mark Descriptions for Repeating-Pattern Marks
1202.19(c) Material Alteration of Repeating-Pattern Marks
1202.19(c)(i) Amending the Drawing to Depict a Different Object
1202.19(c)(ii) Amending a Swatch-Type Drawing to Show an Object and Vice Versa
1202.19(c)(iii) Amending the Drawing to Depict a Different Placement of the Repeating Pattern
1202.19(c)(iv) Amending Descriptions of Repeating-Pattern Marks
1202.19(c)(v) Amendments in Applications Based on Section 44 or Section 66(a)
1202.19(d) Specimens for Repeating-Pattern Marks
1202.19(e) Failure-to-Function Refusal – Mark Not Inherently Distinctive
1202.19(e)(i) Inherent Distinctiveness Determination
1202.19(e)(i)(A) Common or Widely Used Pattern
1202.19(e)(i)(B) Pattern Creates a Distinct Commercial Impression Apart from Other Matter
1202.19(e)(i)(C) Nature of Elements in the Repeating Pattern

1202.19(e)(i)(D) Industry Practice
1202.19(e)(i)(E) Type of Product
1202.19(e)(ii) Statutory Basis for Refusal
1202.19(e)(iii) Response Options
1202.19(f) Failure-to-Function Refusal – Inconsistent Goods or Services
1202.19(f)(i) Statutory Basis for Refusal
1202.19(f)(ii) Response Options
1202.19(g) Refusal – Application Seeks Registration of More than One Mark
1202.19(g)(i) Statutory Basis for Refusal
1202.19(g)(ii) Response Options
1202.19(h) Refusals in Applications Based on Section 1(b), Section 44, or Section 66(a)
1202.19(i) Functional Repeating Patterns
1202.19(j) Random Patterns
1202.19(k) Examples of Repeating-Pattern Marks
1203 **Refusal on Basis of Deceptive Matter and Matter which May Falsely Suggest a Connection**
1203.01 Other Refusals Under 15 U.S.C. §1052(a) No Longer Valid
1203.02 Deceptive Matter
1203.02(a) Types of Deceptive Marks
1203.02(b) Elements of a §2(a) Deceptiveness Refusal
1203.02(c) Distinction Between Marks Comprising Deceptive Matter (§2(a)) and Deceptively Misdescriptive Marks (§2(e)(1))
1203.02(d) Determining Materiality
1203.02(d)(i) Objective Criteria
1203.02(d)(ii) Mere Personal Preference
1203.02(e) Procedures for Issuing §2(a) Deceptive Refusals
1203.02(e)(i) When the Mark is Clearly Misdescriptive
1203.02(e)(ii) When It is Not Clear Whether the Mark is Misdescriptive
1203.02(f) Responding to a §2(a) Deceptiveness Refusal
1203.02(f)(i) Amending the Identification of Goods or Services
1203.02(f)(ii) Other Arguments
1203.02(g) Deceptive Matter: Case References
1203.03 Matter That May Falsely Suggest a Connection
1203.03(a) Definitions
1203.03(a)(i) "Persons"
1203.03(a)(ii) "Institutions"
1203.03(a)(iii) "National Symbols"
1203.03(b) False Suggestion of a Connection
1203.03(b)(i) Elements of a §2(a) False Suggestion of a Connection Refusal
1203.03(b)(ii) Government Agencies and Instrumentalities
1203.03(b)(iii) False Suggestion of a Connection: Case References
1204 **Refusal on Basis of Flag, Coat of Arms, or Other Insignia of United States, State or Municipality, or Foreign Nation**
1204.01 Flags and Simulations of Flags
1204.01(a) Flags and Simulations of Flags Are Refused
1204.01(b) Stylized Flag Designs Are Not Refused Under §2(b)
1204.01(c) Case Law Finding No Simulation of a Flag
1204.01(d) Description of the Mark
1204.01(e) Flags Not Presently Used as National Flags
1204.02 Government Insignia
1204.02(a) Designs that are Insignia Under §2(b) Must Be Refused

1204.02(b) Examples of Insignia That Should Be Refused Under §2(b)
1204.02(c) Examples of Designs That Should Not Be Refused Under §2(b)
1204.02(d) Case Law Interpreting Insignia Under §2(b)
1204.03 Other Refusals May be Appropriate
1204.04 Responding to §2(b) Refusal
1204.04(a) Absolute Bar to Registration
1204.04(b) Deletion of §2(b) Matter
1204.04(b)(i) Examples of Matter That May and May Not Be Deleted
1204.05 Resources
1205 Refusal on Basis of Matter Protected by Statute or Convention
1205.01 Statutory Protection
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"
1205.01(a)(i) First Use After December 8, 2005
1205.01(a)(ii) First Use On or Before December 8, 2005 – Grandfather Clause
1205.01(a)(iii) Date of First Use Not Specified
1205.01(a)(iv) Applicable Refusals
1205.01(a)(v) Amendments to Disclaim, Delete, or Amend the Unregistrable Symbol or Designation
1205.01(a)(vi) Parties Authorized to use the Red Crescent and Third Protocol Emblem
1205.01(b) Examination Procedures for Marks Comprising Matter Related to the United States Olympic Committee or the Olympics
1205.01(b)(i) Nature of the Mark
1205.01(b)(ii) Issuing Other Substantive Refusals
1205.01(b)(iii) Amendments to Disclaim, Delete, or Amend the Unregistrable Wording or Symbol
1205.01(b)(iv) Consent to Register
1205.01(b)(v) First Use On or After September 21, 1950
1205.01(b)(vi) First Use Before September 21, 1950 – Grandfather Clause
1205.01(b)(vii) Date of First Use Not Specified
1205.01(b)(viii) Geographic-Reference Exception
1205.01(c) Examination Procedures for Marks Containing Greek Red Cross or the Phrases "Red Cross" or "Geneva Cross"
1205.01(c)(i) Date of First Use is Before or After June 25, 1948
1205.01(c)(ii) Date of First Use Not Specified
1205.01(c)(iii) Applicable Refusals
1205.01(c)(iv) Amendments to Disclaim, Delete, or Amend the Unregistrable Symbol or Designation
1205.01(d) Examination Procedures for Marks Containing the Swiss Confederation Coat of Arms or Flag
1205.01(d)(i) Refusal Under Sections 1 and 45: Swiss Coat of Arms Not in Lawful Use
1205.01(d)(i)(A) When a Refusal Under Sections 1 and 45 Must Be Issued
1205.01(d)(i)(B) When an Advisory Should Be Provided
1205.01(d)(i)(C) When a Refusal Under Sections 1 and 45 Should Not Be Issued
1205.01(d)(i)(D) Applicant's Response to Refusal
1205.01(d)(i)(E) Refusals Based on Extrinsic Evidence
1205.01(d)(ii) Refusal Under §2(b): Swiss Flag or Swiss Coat of Arms
1205.01(d)(ii)(A) When a Refusal Under §2(b) Must Be Issued
1205.01(d)(ii)(B) When an Advisory Should Be Provided
1205.01(d)(ii)(C) When a Refusal Under §2(b) Should Not Be Issued

1205.01(d)(ii)(D) Applicant's Response to Refusal
1205.01(d)(iii) Other Refusals
1205.01(d)(iv) Examples
1205.02 Article 6ter of the Paris Convention
1205.03 Native American Tribal Insignia
1206 Refusal on Basis of Name, Portrait, or Signature of Particular Living Individual or Deceased U.S. President Without Consent
1206.01 Name, Portrait, or Signature of Particular Living Individual
1206.02 Connection with Goods or Services
1206.03 When Inquiry is Required
1206.04 Consent of Individual or President's Widow
1206.04(a) Consent Statement Must Be Written Consent to Registration
1206.04(b) Consent May Be Presumed From Signature of Application
1206.04(c) New Consent Not Required if Consent is of Record in Valid Registration Owned by Applicant
1206.04(d) Implicit Consent
1206.05 Names and Likenesses That Do Not Identify a Particular Living Individual
1207 Refusal on Basis of Likelihood of Confusion, Mistake, or Deception
1207.01 Likelihood of Confusion
1207.01(a) Relatedness of the Goods or Services
1207.01(a)(i) Goods or Services Need Not Be Identical
1207.01(a)(ii) Establishing Relatedness of Goods to Services
1207.01(a)(ii)(A) Food and Beverage Products Versus Restaurant Services
1207.01(a)(iii) Reliance on Identification of Goods/Services in Registration and Application
1207.01(a)(iv) No "Per Se" Rule
1207.01(a)(v) Expansion-of-Trade Doctrine
1207.01(a)(vi) Evidence Showing Relatedness of Goods or Services
1207.01(b) Similarity of the Marks
1207.01(b)(i) Word Marks
1207.01(b)(ii) Similarity In Appearance
1207.01(b)(iii) Comparing Marks that Contain Additional Matter
1207.01(b)(iv) Similarity in Sound – Phonetic Equivalents
1207.01(b)(v) Similarity in Meaning
1207.01(b)(vi) Doctrine of Foreign Equivalents
1207.01(b)(vi)(A) Background
1207.01(b)(vi)(B) When an Ordinary American Purchaser Would "Stop and Translate"
1207.01(b)(vi)(C) Likelihood of Confusion Factors Still Apply When Assessing Whether Marks are Confusingly Similar
1207.01(b)(vii) Transposition of Terms
1207.01(b)(viii) Marks Consisting of Multiple Words
1207.01(b)(ix) Weak or Descriptive Marks
1207.01(b)(x) Parody Marks
1207.01(b)(xi) Color Marks
1207.01(c) Design Marks
1207.01(c)(i) Legal Equivalents – Comparison of Words and Their Equivalent Designs
1207.01(c)(ii) Composite Marks Consisting of Both Words and Designs
1207.01(c)(iii) Comparison of Standard Character Marks and Special Form Marks
1207.01(c)(iv) Matter Depicted in Broken Lines
1207.01(d) Miscellaneous Considerations
1207.01(d)(i) Doubt Resolved in Favor of Registrant

1207.01(d)(ii) Absence of Actual Confusion
1207.01(d)(iii) Third-Party Registrations and Evidence of Third-Party Use
1207.01(d)(iv) Collateral Attack on Registration Improper in Ex Parte Proceeding
1207.01(d)(v) Classification of Goods/Services
1207.01(d)(vi) Prior Decisions of Examining Attorneys
1207.01(d)(vii) Sophisticated Purchasers
1207.01(d)(viii) Consent Agreements
1207.01(d)(ix) Fame of the Prior Registered Mark
1207.01(d)(x) Conflicting Marks Owned by Different Parties
1207.01(d)(xi) Family of Marks
1207.01(d)(xii) Pharmaceuticals or Medicinal Products
1207.02 Marks That Are Likely to Deceive
1207.03 Marks Previously Used in United States but Not Registered
1207.04 Concurrent Use Registration
1207.04(a) Concurrent Use – In General
1207.04(b) Filing Basis of Application Seeking Concurrent Use Registration
1207.04(c) Criteria for Requesting Concurrent Use Registration
1207.04(d) Requirements for All Concurrent Use Applications
1207.04(d)(i) Concurrent Use Application for a Trademark or Service Mark
1207.04(d)(ii) Concurrent Use Application for a Collective or Certification Mark
1207.04(e) Applications Subject to Concurrent Use Proceeding Before the Trademark Trial and Appeal Board
1207.04(e)(i) Preparing the Record for Publication
1207.04(f) Application for Concurrent Use Registration Pursuant to Court Decree
1207.04(f)(i) Preparing the Record for Publication
1207.04(g) Application for Concurrent Use Registration Based on Final Board Decision in Prior Concurrent Use Proceeding
1207.04(g)(i) Preparing the Record for Publication
1208 **Conflicting Marks in Pending Applications**
1208.01 Priority for Publication or Issue Based on Effective Filing Date
1208.01(a) What Constitutes Conflict Between Pending Applications
1208.01(b) What Constitutes Effective Filing Date
1208.01(c) Change in Effective Filing Date During Examination
1208.01(d) Examination of Conflicting Marks After Reinstatement or Revival
1208.02 Conflicting Applications Examination Procedure
1208.02(a) Examination of Application with Earliest Effective Filing Date
1208.02(b) Action on Later-Filed Application: Giving Notice of the Earlier Application or Applications
1208.02(c) Suspension of Later-Filed Application
1208.02(d) Action on Later-Filed Application upon Disposition of the Earlier Application or Applications
1208.02(e) Applicant's Argument on Issues of Conflict
1208.02(f) Conflicting Mark Mistakenly Published or Approved for Issuance on the Supplemental Register
1208.03 Procedure Relating to Possibility of Interference
1208.03(a) Procedures on Request for Interference
1208.03(b) Decision on Request for Interference
1208.03(c) Procedure When Interference Is to be Declared
1209 **Refusal on Basis of Descriptiveness**
1209.01 Distinctiveness/Descriptiveness Continuum
1209.01(a) Fanciful, Arbitrary, and Suggestive Marks

1209.01(b) Merely Descriptive Marks
1209.01(c) Generic Terms
1209.01(c)(i) Test
1209.01(c)(ii) Terminology
1209.01(c)(iii) Generic Matter: Case References
1209.02 Procedure for Descriptiveness and/or Genericness Refusal
1209.02(a) Descriptive Marks – Advisory Statement that Mark Appears to Be Generic
1209.02(a)(i) Amendment to Supplemental Register in Response to Office Action
1209.02(a)(ii) Assertion of §2(f) in Response to Office Action
1209.02(b) Descriptive and Possibly Generic Marks – Assertion of §2(f) in Application
1209.03 Considerations Relevant to Determination of Descriptiveness or Genericness
1209.03(a) Third-Party Registrations
1209.03(b) Dictionary Listing
1209.03(c) First or Only User
1209.03(d) Combined Terms
1209.03(e) More than One Meaning
1209.03(f) Picture or Illustration
1209.03(g) Foreign Equivalents
1209.03(h) Acronyms
1209.03(i) Intended Users
1209.03(j) Phonetic Equivalent
1209.03(k) Laudatory Terms
1209.03(l) Telephone Numbers
1209.03(m) Domain Names
1209.03(n) "America" or "American"
1209.03(o) "National," "International," "Global," and "Worldwide"
1209.03(p) Function or Purpose
1209.03(q) Source or Provider of Goods or Services
1209.03(r) Retail Store and Distributorship Services
1209.03(s) Slogans
1209.03(t) Repetition of Descriptive or Generic Term
1209.03(u) Punctuation
1209.03(v) Key Aspect or Subcategory of Goods or Services
1209.03(w) Stylization
1209.03(x) Historical Figure Names and Fictional Character Names
1209.03(y) Marks Including Geographic Wording that Does Not Indicate Geographic Origin of Cheeses and Processed Meats
1209.04 Deceptively Misdescriptive Marks
1210 **Refusal on Basis of Geographic Significance**
1210.01 Elements
1210.01(a) Geographically Descriptive Marks – Test
1210.01(b) Geographically Deceptively Misdescriptive Marks – Test
1210.01(c) Geographically Deceptive Marks – Test
1210.02 Primarily Geographic Significance
1210.02(a) Geographic Locations
1210.02(b) Primary Significance
1210.02(b)(i) Other Meanings
1210.02(b)(i)(A) Surname Significance
1210.02(b)(ii) More Than One Geographic Location With Same Name
1210.02(b)(iii) Non-Geographic Characteristics of Goods or Services
1210.02(b)(iv) "America" or "American" and Similar Terms in Marks

1210.02(c) Geographic Terms Combined With Additional Matter
1210.02(c)(i) Two Geographic Terms Combined
1210.02(c)(ii) Geographic Terms Combined With Descriptive or Generic Matter
1210.02(c)(iii) Arbitrary, Fanciful, or Suggestive Composites
1210.03 Geographic Origin of the Goods or Services
1210.04 Goods/Place or Services/Place Association
1210.04(a) Establishing Goods/Place Association
1210.04(b) Establishing Services/Place Association
1210.04(c) Obscure or Remote Geographic Marks
1210.04(d) Arbitrary Use of Geographic Terms
1210.05 Geographically Deceptive Marks
1210.05(a) Basis for Refusal
1210.05(b) Elements of a §2(e)(3) Refusal
1210.05(c) Determining Materiality
1210.05(c)(i) Materiality In Cases Involving Goods
1210.05(c)(ii) Materiality In Cases Involving Services
1210.05(d) Procedures for Issuing Geographically Deceptive Refusals
1210.05(d)(i) Neither Applicant Nor Goods/Services Come from the Place Named
1210.05(d)(ii) It is Not Clear Whether the Goods/Services Originate From the Place Named
1210.05(e) Geographically Deceptive Matter: Case References
1210.06 Procedure for Examining Geographic Composite Marks
1210.06(a) Marks That Include Primarily Geographically Descriptive Terms Combined With Additional Matter
1210.06(b) Marks That Include Primarily Geographically Deceptively Misdescriptive and Deceptive Terms Combined With Additional Matter
1210.07 Supplemental Register and §2(f)
1210.07(a) Registrability of Geographic Terms on the Supplemental Register
1210.07(b) Registrability of Geographic Terms under §2(f)
1210.08 Geographical Indications Used on Wines and Spirits
1210.08(a) Geographical Indications Used on Wines and Spirits That Do Not Originate in the Named Place
1210.08(b) Geographical Indications Used on Wines and Spirits That Originate in the Named Place
1210.08(c) Geographical Indications That Are Generic for Wines and Spirits
1210.09 Geographic Certification Marks
1210.10 Doctrine of Foreign Equivalents
1211 **Refusal on Basis of Surname**
1211.01 "Primarily Merely a Surname"
1211.01(a) Non-Surname Significance
1211.01(a)(i) Ordinary Language Meaning
1211.01(a)(ii) Phonetic Equivalent of Term with Ordinary Language Meaning
1211.01(a)(iii) Geographical Significance
1211.01(a)(iv) Historical Place or Person
1211.01(a)(v) Rare Surnames
1211.01(a)(vi) "Structure and Pronunciation" of a Surname
1211.01(a)(vii) Doctrine of Foreign Equivalents
1211.01(b) Surname Combined with Additional Matter
1211.01(b)(i) Double Surnames
1211.01(b)(ii) Stylization or Design Elements
1211.01(b)(iii) Surname Combined with Initials

1211.01(b)(iv) Surname Combined with Title
1211.01(b)(v) Surname in Plural or Possessive Form
1211.01(b)(vi) Surname Combined with Additional Wording
1211.01(b)(vii) Surname Combined with Domain Name
1211.01(b)(viii) Surname Combined with Legal or Familial Entity Designation
1211.02 Evidence Relating to Surname Refusal
1211.02(a) Evidentiary Burden – Generally
1211.02(b) Evidentiary Considerations
1211.02(b)(i) Telephone Directory Listings
1211.02(b)(ii) LexisNexis® Research Database Evidence
1211.02(b)(iii) U.S. Census Database Evidence
1211.02(b)(iv) Surname of Person Associated with Applicant
1211.02(b)(v) Specimens Confirming Surname Significance of Term
1211.02(b)(vi) Negative Dictionary Evidence
1211.02(b)(vii) Evidence of Fame of a Mark
1212 **Acquired Distinctiveness or Secondary Meaning**
1212.01 General Evidentiary Matters
1212.02 General Procedural Matters
1212.02(a) Situations in Which a Claim of Distinctiveness Under §2(f) Is Appropriate
1212.02(b) Section 2(f) Claim Is, for Procedural Purposes, a Concession that Matter Is Not Inherently Distinctive
1212.02(c) Claiming §2(f) Distinctiveness in the Alternative
1212.02(d) Unnecessary §2(f) Claims
1212.02(e) Disclaimers in Applications Claiming Distinctiveness under §2(f)
1212.02(f) Section 2(f) Claim in Part
1212.02(f)(i) Standards for Establishing Acquired Distinctiveness for Claims of §2(f) in Part
1212.02(f)(ii) Appropriate/Inappropriate Situations for Claiming §2(f) in Part
1212.02(f)(ii)(A) Appropriate Situations for Claiming §2(f) in Part
1212.02(f)(ii)(B) Inappropriate Situations for Claiming §2(f) in Part
1212.02(g) Examining Attorney's Role in Suggesting §2(f) or Appropriate Kind/Amount of Evidence
1212.02(h) Nonfinal and Final Refusals
1212.02(i) Section 2(f) Claim with Respect to Incapable Matter
1212.02(j) Section 2(f) Claim Restricted to Particular Goods/Services/Classes
1212.03 Three Types of Evidence of Distinctiveness under §2(f)
1212.04 Prior Registrations as Proof of Distinctiveness
1212.04(a) Sufficiency of Claim Vis-à-Vis Nature of the Mark
1212.04(b) "Same Mark"
1212.04(c) Goods or Services Must be "Sufficiently Similar"
1212.04(d) Registration Must Be in Full Force and Effect and on Principal Register or under Act of 1905
1212.04(e) Form of §2(f) Claim Based on Ownership of Prior Registrations
1212.05 Five Years of Use as Proof of Distinctiveness
1212.05(a) Sufficiency of Claim Vis-à-Vis Nature of the Mark
1212.05(b) "Substantially Exclusive and Continuous"
1212.05(c) Use "as a Mark"
1212.05(d) Form of the Proof of Five Years' Use
1212.06 Establishing Distinctiveness by Actual Evidence
1212.06(a) Long Use of the Mark in Commerce
1212.06(b) Advertising Expenditures

1212.06(c) Affidavits or Declarations Asserting Recognition of Mark as Source Indicator
1212.06(d) Survey Evidence, Market Research and Consumer Reaction Studies
1212.06(e) Miscellaneous Considerations Regarding Evidence Submitted to Establish Distinctiveness
1212.06(e)(i) First or Only User
1212.06(e)(ii) State Trademark Registrations
1212.06(e)(iii) Design Patent
1212.06(e)(iv) Acquiescence to Demands of Competitors
1212.06(e)(v) Family of Marks
1212.06(e)(vi) Parodies and Copies
1212.07 Form of Application Asserting Distinctiveness
1212.08 Section 44 and §66(a) Applications and Distinctiveness
1212.09 Section 1(b) Applications and Distinctiveness
1212.09(a) Section 2(f) Claim Requires Prior Use
1212.09(b) Claim of §2(f) "in Part" in §1(b) Applications
1212.10 Printing §2(f) Notations, §2(f)-in-Part Notations, and Limitation Statements
1213 Disclaimer of Elements in Marks
1213.01 History of Disclaimer Practice
1213.01(a) Discretion in Requiring Disclaimer
1213.01(b) Refusal to Register Because of Failure to Disclaim
1213.01(c) Voluntary Disclaimer of Registrable or Unregistrable Matter
1213.01(d) Disclaimer Offered in the Alternative
1213.02 "Composite" Marks
1213.03 Disclaimer of Unregistrable Components of Marks
1213.03(a) "Unregistrable Components" in General
1213.03(b) Generic Matter and Matter That Does Not Function as a Mark
1213.03(c) Pictorial Representations of Descriptive Matter
1213.03(d) Entity Designations
1213.04 Trade Names
1213.05 Unitary Marks
1213.05(a) Compound Word Marks
1213.05(a)(i) Telescoped Words
1213.05(a)(ii) Compound Words Formed with Hyphen or Other Punctuation
1213.05(b) Unitary Phrases
1213.05(b)(i) Slogans
1213.05(b)(ii) Grammar and Punctuation
1213.05(b)(ii)(A) Verbs
1213.05(b)(ii)(B) Prepositional Phrases
1213.05(b)(ii)(C) Punctuation
1213.05(b)(ii)(D) Possessives
1213.05(b)(iii) Other Considerations
1213.05(b)(iv) Unregistrable Unitary Phrases or Slogans
1213.05(c) Double Entendre
1213.05(d) Incongruity
1213.05(e) Sound Patterns
1213.05(f) Display of Mark
1213.05(g) Marks with Design Elements Replacing Letters
1213.05(g)(i) Marks with a Distinctive Design Replacing a Letter in Descriptive or Generic Wording

1213.05(g)(ii) Marks with Merely Descriptive or Primarily Geographically Descriptive Designs Replacing Letters within Descriptive or Primarily Geographically Descriptive Wording
1213.05(g)(iii) Marks with Accurate Pictorial Representations Replacing Letters in Merely Descriptive and Primarily Geographically Descriptive Marks
1213.05(g)(iv) Unitary Marks with Design Elements Replacing Letters in Descriptive or Generic Wording
1213.05(h) Unitary Marks: Case References
1213.06 Entire Mark May Not Be Disclaimed
1213.07 Removal Rather Than Disclaimer
1213.08 Form of Disclaimers
1213.08(a) Wording of Disclaimer
1213.08(a)(i) Standardized Printing Format for Disclaimer
1213.08(a)(ii) Unacceptable Wording for Disclaimer
1213.08(a)(iii) Unacceptable Statements in Disclaimers
1213.08(b) Disclaimer of Unregistrable Matter in Its Entirety
1213.08(c) Disclaimer of Misspelled Words
1213.08(d) Disclaimer of Non-English Words
1213.09 Mark of Another May Not Be Registered with Disclaimer
1213.10 Disclaimer in Relation to Likelihood of Confusion
1213.11 Acquiring Rights in Disclaimed Matter
1214 “Phantom” Elements in Marks
1214.01 Single Application May Seek Registration of Only One Mark
1214.02 Agreement of Mark on Drawing with Mark on Specimens or Foreign Registration
1214.03 “Phantom Marks” in §1(b) Applications
1214.04 “Phantom Marks” in §44 and §66(a) Applications
1215 Marks Composed, in Whole or in Part, of Domain Names
1215.01 Background
1215.02 Use as a Mark
1215.02(a) Use Applications
1215.02(b) Advertising One’s Own Products or Services on the Internet is not a Service
1215.02(c) Agreement of Mark on Drawing with Mark on Specimens of Use
1215.02(d) Marks Comprised Solely of gTLDs for Domain Registry Operator and Domain Name Registrar Services
1215.02(d)(i) Prior Registration(s) of the Same Mark for Goods or Services in the Same Field of Use
1215.02(d)(ii) Additional Proof that the Mark Used as a gTLD Will Be Perceived as a Mark
1215.02(d)(iii) Registry Agreement/ICANN Contract
1215.02(d)(iv) Legitimate Service for the Benefit of Others
1215.02(e) Section 1(b) Applications
1215.02(f) Section 44 and §66(a) Applications
1215.03 Surnames
1215.04 Descriptiveness
1215.05 Generic Refusals
1215.05(a) Genericness Analysis and Relevant Evidence
1215.05(b) Procedures for Refusals
1215.05(b)(i) Claim of Acquired Distinctiveness
1215.05(b)(ii) Supplemental Register
1215.05(c) Generic.com Terms Combined with Other Matter
1215.05(d) Failure to Function

1215.05(e) Section 2(d) Considerations
1215.06 Marks Containing Geographical Matter
1215.07 Disclaimers
1215.08 Material Alteration
1215.08(a) Adding or Deleting TLDs in Domain Name Marks
1215.08(b) Adding or Deleting gTLDs in Other Marks
1215.08(c) Adding or Deleting "." in Marks for Domain Registry Operator or Domain Name Registrar Services
1215.09 Likelihood of Confusion
1215.10 Marks Containing the Phonetic Equivalent of a Generic Top-Level Domain
1216 **Effect of Applicant's Prior Registrations**
1216.01 Decisions Involving Prior Registrations Not Controlling
1216.02 Effect of "Incontestability" in Ex Parte Examination
1217 **Res Judicata, Collateral Estoppel, and Stare Decisis**

1201 Ownership of Mark

Under §1(a)(1) of the Trademark Act, 15 U.S.C. §1051(a)(1), a trademark or service mark 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 the applicant 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).

A trademark or service mark application under §1(b) or §44 of the Act, 15 U.S.C. §§1051(b), 1126, must be filed by a party who has a bona fide intention to use the mark in commerce as of the application filing date and include a verified statement to that effect. 15 U.S.C §§1051(b)(1), (b)(3)(B), 1126(d)(2), (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 §§1008, 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 §§1104-1104.11) or a statement of use under 15 U.S.C. §1051(d) (*see* TMEP §§1109-1109.18) which states that the applicant is the owner of the mark. 15 U.S.C. §1051(b); 37 C.F.R. §§2.76(b)(1)(i), 2.88(b)(1)(i). See TMEP §1104.10(b)(i) regarding ownership issues for an amendment to allege use and §1109.10 regarding ownership issues for a statement of use.

In a §44 application, the applicant must be the owner of the foreign application or registration on which the U.S. application is based as of the filing date of the U.S. 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); 37 C.F.R. §7.25. 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(f)(a); 37 C.F.R. §2.33(e)(1). The verified statement in a §66(a) application for a trademark or service mark 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 U.S. 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.

The provisions discussed above also apply to collective and certification marks with the caveat that the owner of such marks does not use the mark or have a bona fide intention to do so, but rather exercises control over its use by members/authorized users or has a bona fide intention, and is entitled, to exercise such control over the use by members/authorized users. *See*15 U.S.C. §§1053, 1054; TMEP §§1303.02(a), 1304.03(a), 1306.01(a).

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

In an application under §1 of the Trademark Act, 15 U.S.C §1051, an applicant may base its claim of ownership of a 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 §§1201.03–1201.03(e)); 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. *See*15 U.S.C §1055. The owner is the only proper party to apply for registration. *See*15 U.S.C. §1051(a); *Moreno v. Pro Boxing Supplies, Inc.*, 124 USPQ2d 1028, 1036 (TTAB 2017) (finding that a mere licensee cannot rely on licensor's use to prove priority). See TMEP §§1201.03–1201.03(e) 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 L. A. Police Revolver & Athletic Club, Inc.*, 69 USPQ2d 1630, 1634 (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 collective and certification marks, except that, by definition, collective and certification marks are not used by the owner of the mark, but rather the marks are used by its members/authorized users under the control of the owner. *See* 15 U.S.C. §§1053, 1054; TMEP §§1303.02(a), 1304.03(a), 1306.01(a). In addition, an application for registration of a collective mark must specify the nature of the applicant's control over use of the mark. 37 C.F.R. §2.44(a)(4)(i)(A); TMEP §1303.01(a)(i)(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 §§803-803.03(k) for the appropriate format for identifying the applicant and setting forth the relevant legal entity.

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 has a bona fide intention to use in commerce) the mark on the application filing date. *See* TMEP §1201. 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 §2.7(d); TMEP §803.06.

If the application was filed by the party who is the owner or has a bona fide intention to use the mark in commerce, but there was a mistake in the manner in which the applicant's name was set forth in the application, this may be corrected. 37 C.F.R §2.7(d); TMEP §803.06. *See*TMEP §1201.02(c) for examples of correctable and non-correctable errors.

Trademark Act Section 1(a) applications . 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. 15 U.S.C §1051(a)(1). If the applicant does not own the mark on the application filing date, the application is *void* . 37 C.F.R. §2.71(d); *Lyons v. Am. Coll. of Veterinary Sports Med. & Rehab.*, 859 F.3d 1023, 1027, 123 USPQ2d 1024, 1027 (Fed. Cir. 2017); *Fuji Med. Instruments Mfg. Co. v. Am. Crocodile Int'l Grp., Inc.*, 2021 USPQ2d 831, at *25 (TTAB 2021) (citing *Huang v. Tzu Wei Chen Food Co.*, 849 F.2d 1458, 1460, 7 USPQ2d 1335, 1336 (Fed. Cir. 1988)); *Conolty v. Conolty O'Connor NYC LLC*, 111 USPQ2d 1302, 1309 (TTAB 2014); *see Sock It To Me, Inc. v. Aiping Fan*, 2020 USPQ2d 10611, at *2 (TTAB 2020).

See TMEP §1104.10(b)(i) regarding ownership issues for an amendment to allege use and §1109.10 regarding ownership issues for a statement of use.

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, 1127. The examining attorney should not have the filing date cancelled or refund the application filing fee.

Trademark Act Section 1(b) and/or 44 applications . In an application under §1(b) or §44 of the Trademark Act, 15 U.S.C. §§1051(b), 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)(1), (b)(3)(B), 1126(d)(2), (e); 37 C.F.R §2.33(b)(2). 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. *Hole In 1 Drinks, Inc. v. Lajtay*, 2020 USPQ2d 10020, at *9-10 (TTAB 2020); *Norris v. PAVE: Promoting Awareness, Victim Empowerment*, 2019 USPQ2d 370880, at *4-5 (TTAB 2019); *Am. Forests v. Sanders*, 54 USPQ2d 1860, 1864 (TTAB 1999) (holding a §1(b) filed by an individual to be 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), *aff'd*, 232 F.3d 907 (Fed. Cir. 2000); *see also M.Z. Berger & Co. v. Swatch AG*, 787 F.3d 1368, 1375, 114 USPQ2d 1892, 1898 (Fed. Cir. 2015). 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.

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 Elec. Corp. v. Evans Mktg., 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. 37 C.F.R. §2.71(d); *see Huang v. Tzu Wei Chen Food Co.*, 849 F.2d 1458, 7 USPQ2d 1335 (Fed. Cir. 1988); *Great Seats, Ltd. v. Great Seats, Inc.*, 84 USPQ2d 1235, 1244 (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 Atl. Blue Print Co.*, 19 USPQ2d 1078 (Comm'r Pats 1990) (finding that 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, for example, 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, for example, 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 Indus., 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 Pers. Inc. v. Accustaff Inc.*, 38 USPQ2d 1443 (TTAB 1996) (holding application 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. v. Springer*, 198 USPQ 626, 635 (TTAB 1978) (holding that 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); *Pioneer Elec.*, 183 USPQ 613 (holding that 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 is 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 Serv. Inc. v. Paychex Prop. Inc.*, 337 F.3d 1334, 1337, 67 USPQ2d 1638, 1640 (Fed. Cir. 2003) (holding that the term "mistake," within the context of the rule regarding the misidentification of the person in whose name an extension of time to file an opposition was requested, means a mistake in the form of the potential opposer's name or its entity type and does not encompass the recitation of a different existing legal entity that is not in privity with the party that should have been named).

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*, 849 F.2d at 1458, 7 USPQ2d at 1335 (holding as void an application filed by an individual two days after ownership of the mark was transferred to a newly formed corporation).

(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. *Tong Yang Cement*, 19 USPQ2d at 1689.

(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*, 84 USPQ2d at 1244 (holding §1(a) application 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(b) regarding wholly owned related companies.

(6) *Joint Applicants*. If an application owned by joint applicants is filed in the name of one of the owners and another party who is not the joint owner, the application is void as filed because the listed parties did not own the mark as joint applicants. *Cf. Am. Forests v. Sanders*, 54 USPQ2d 1860 (TTAB 1999) (application filed in the name of an individual, when it was actually owned by a partnership composed of the individual and her husband, was void ab initio).

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 Sys.*, 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 §§502.02–502.02(b) 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. *Sock It To Me, Inc. v. Aiping Fan*, 2020 USPQ2d 10611, at *3 (TTAB 2020) (quoting *Noble House Home Furnishings, LLC v. Floorco Enters., LLC*, 118 USPQ2d 1413, 1421 (TTAB 2016)). Either a natural person or a juristic person may be a related company. *See*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." *Sock It To Me, Inc.*, 2020 USPQ2d 10611, at *3 (quoting *Noble House Home Furnishings*, 118 USPQ2d at 1421). This party, who controls the nature and quality of the goods or services, is the owner of the mark and, therefore, the only party who may apply to register the mark. *SeeSmith Int'l. Inc. v. Olin Corp.*, 209 USPQ 1033, 1044-45 (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, 303 (TTAB 1982) (finding that related-company use was 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. *SeeWells Cargo, Inc. v. Wells Cargo, Inc.*, 197 USPQ 569, 570 (TTAB 1977), *aff'd*,606 F.2d 961, 203 USPQ 564 (C.C.P.A. 1979).

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

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

The USPTO does not require an application to specify if the applied-for 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. Moreover, 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.

Additionally, 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 has a bona fide intention to use the mark in commerce. *See* TMEP §1201.04. In such cases, the USPTO may require such details concerning the nature of the relationship and such proofs as may be necessary and appropriate for the purpose of showing that the use by related companies inures to the benefit of the applicant and does not affect the validity of the mark. 37 C.F.R. §2.38(b).

1201.03(b) Wholly Owned Related Companies

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 Cent. IP Corp.*, 65 USPQ2d 1637 (Dir USPTO 2002) (holding §8 affidavit filed in the name of a subsidiary and predecessor in interest of the current owner unacceptable); *In re ACE III Commc'ns, Inc.*, 62 USPQ2d 1049 (Dir USPTO 2001) (holding §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).

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

1201.03(c) 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, 1243 (TTAB 2007) (holding that the fact 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) (holding statement that both the applicant corporation and the corporate user of the mark have the same principal stockholder and officer 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, 833 (TTAB 1981) (holding that the applicant, an individual, exercised sufficient control over the nature and quality of the goods sold under the mark by the licensee that the license agreement vested ownership of the mark in the applicant).

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(b) regarding use by wholly owned related companies.

1201.03(d) 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, 1242 (TTAB 2007); *In re Pharmacia Inc.*, 2 USPQ2d 1883, 1884 (TTAB 1987); *Greyhound Corp. v. Armour Life Ins. Co.*, 214 USPQ 473, 475 (TTAB 1982).

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

1201.03(e) 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) (citing *Basic Inc. v. Rex*, 167 USPQ 696, 697 (TTAB 1970)); *see Sock It To Me, Inc. v. Aiping Fan*, 2020 USPQ2d 10611, at *3-4 (TTAB 2020) (citing *Woodstock's Enters. Inc. (Cal.) v. Woodstock's Enters. Inc. (Or.)*, 43 USPQ2d 1440, 1447 (TTAB 1997); *Univ. Book Store v. Univ. of Wis. Bd. of Regents*, 33 USPQ2d 1385, 1396 (TTAB 1994)) ("Even if there is no formal written agreement, a license can be implied.").

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 Publ'g Co.*, 380 F.2d 224, 229, 154 USPQ 330, 334 (5th Cir. 1967), *cert. denied*, 389 U.S. 1006, 156 USPQ 720 (1967); *Cent. Fid. Banks, Inc. v. First Bankers Corp. of Fla.*, 225 USPQ 438, 440 (TTAB 1984) (holding that 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). However, a mere licensee cannot rely on use of the mark by the licensor, whether through the license or otherwise, to establish priority. *Moreno v. Pro Boxing Supplies, Inc.*, 124 USPQ2d 1028, 1036 (TTAB 2017).

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. & Sunsweet Growers Inc.*, 204 USPQ 507, 510 (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 nature and quality of the goods or services with which the mark is used. *See Sock It To Me*, 2020 USPQ2d 10611, at *4 (quoting *In re Jos. Bancroft & Sons*, 120 USPQ 329, 330-31 (TTAB 1961)). Control over all of the related company's affairs is not required. *See Sock It To Me*, 2020 USPQ2d 10611, at *4 (citing 3 J. Thomas McCarthy, McCarthy on Trademarks & Unfair Competition §18:58 (5th ed. Nov. 2019 update)). However, 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.*, 468 F. Supp. 975, 986; 208 USPQ 314, 325 (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 has a bona fide intention to use the mark in commerce.

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(a).

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. *See In re Bee Pollen from Eng. 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 Am. 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(b).

(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 Fuji Med. Instruments Mfg. Co. v. Am. Crocodile Int'l Grp., Inc., 2021 USPQ2d 831, at *24 (TTAB 2021); *In re Pharmacia Inc.*, 2 USPQ2d 1883 (TTAB 1987).

The Board has also found that a mere licensee cannot rely on the licensor's use to prove priority. *Moreno v. Pro Boxing Supplies, Inc.*, 124 USPQ2d 1028, 1036 (TTAB 2017).

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).

1201.06(c) Applicant Using Designation of a U.S. Government Agency or Instrumentality

For a mark that would otherwise be subject to a refusal under §2(a) because it falsely suggests a connection with a designation of a U.S. government agency, instrumentality, or program, such as names, acronyms, titles, terms, and symbols, but the record demonstrates that the applicant has some affiliation with the agency or program, the examining attorney must issue an information request under 37 C.F.R. §2.61(b) requiring further information as to ownership of the designation and authorization to register. If it appears that the applicant lacks authorization to register the designation in the mark, the examining attorney may refuse to register under §1 of the Trademark Act because the applicant is not the owner of the governmental designation in the mark. The mark may also be refused under §2(a) for false suggestion of a connection and under §§1 and 45 when such marks are the subject of statutory protection. See TMEP §1203.03(b)(ii) for refusals under false association for Government Agencies and Instrumentalities, TMEP §1205.01 for information about statutorily protected matter, and **Appendix C** for a non-exhaustive list of U.S. statutes protecting designations of certain government agencies and instrumentalities.

Disclaiming the name of, or acronym for, the U.S. government agency or instrumentality to which the mark refers generally will not overcome the refusal under §§1 and 45. See TMEP §1213.03(a) regarding unregistrable components of marks.

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*TMEP §§1207–1207.01(d)(xi). 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); *cf. In re Wacker Neuson SE*,97 USPQ2d 1408 (TTAB 2010) (finding that the record made clear that the parties were related and that the goods and services were provided by the applicant).

The *Wella* 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)-1201.07(b)(iv) 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. (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* TMEP §1207.01(d). 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 or a subsidiary of 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. *In re Wella A.G.*, 5 USPQ2d 1359, 1361 (TTAB 1987) , rev'd on other grounds, 858 F.2d 725, 8 USPQ2d 1365 (Fed. Cir. 1988). The Board concluded that this declaration alone, absent contradictory evidence, established unity of control, a single source, and no likelihood of confusion. *Id.* 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 Trademark Act, the examining attorney must determine whether the subject matter for which registration is sought is used as a trademark by reviewing the specimens and any other evidence of record showing how the designation is used in the marketplace. *See In re Maugus Mfg., Inc.*, 2021 USPQ2d 1100, at *6 (TTAB 2021) (citing *In re Hulting*, 107 USPQ2d 1175, 1177 (TTAB 2013)); *In re Tex. With Love, LLC*, 2020 USPQ2d 11290, at *2 (TTAB 2020) (quoting *In re Eagle Crest Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010)).

"[A] proposed trademark is registrable only if it functions as an identifier of the source of the applicant's goods or services." *In re Maugus Mfg., Inc.*, 2021 USPQ2d 1100, at *6 (quoting *In re DePorter*, 129 USPQ2d 1298, 1299 (TTAB 2019)). 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. *DeVivo v. Ortiz*, 2020 USPQ2d 10153, at *7 (TTAB 2020) (quoting *In re Ill. Bronze Powder & Paint Co.*, 188 USPQ 459, 462 (TTAB 1975)); *see In re Maugus Mfg., Inc.*, 2021 USPQ2d 1100, at *7 (citing *In re Water Gremlin Co.*, 635 F.2d 841, 843-44, 208 USPQ 89, 90 (C.C.P.A. 1980); *In re Manco, Inc.*, 24 USPQ2d 1938, 1941 (TTAB 1992)). As the Court of Customs and Patent Appeals observed in *In re Standard Oil Company*, 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 Act, 15 U.S.C. §§1051, 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,

(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 Act, 15 U.S.C. §§1051, 1052, 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 is §§23(c) and 45 of the Act, 15 U.S.C. §§1091(c), 1127.

When the examining attorney refuses registration on the ground that the subject matter is not used as a trademark, the examining attorney must explain the specific reason for the conclusion that the subject matter is not used as a trademark. See TMEP §§1202.01–1202.19 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)–(a)(viii) (functionality), §§1202.03–1202.03(g) (ornamentation), §1202.04 (informational matter), §§1202.05–1202.05(i) (color marks), §§1202.06–1202.06(c) (goods in trade), §§1202.07–1202.07(b) (columns or sections of publications), §1202.08–1202.08(f) (title of single creative work), §§1202.09–1202.09(b) (names of artists and authors), §§1202.11 (background designs and shapes), §1202.12 (varietal and cultivar names), §1202.16 (model or grade designations), §1202.17 (universal symbols), §1202.18 (hashtags), and §1202.19 (repeating patterns).

The presence of the "TM" or "SM" symbol next to the mark on the specimen cannot transform an unregistrable designation into a registrable mark. *Univ. of Ky. v. 40-0, LLC*, 2021 USPQ2d 253, at *32-33 (TTAB 2021) (citing *In re Eagle Crest, Inc.*, 96 USPQ2d at 1231); TMEP §1301.02; *see In re Remington Prods. Inc.*, 3 USPQ2d 1714, 1715 (TTAB 1987); *In re Anchor Hocking Corp.*, 223 USPQ 85, 88 (TTAB 1984); *In re Minnetonka, Inc.*, 212 USPQ 772, 779 n.12 (TTAB 1981).

The issue of whether a designation functions as a mark usually is tied to the 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 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 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.

In an application under §44 or §66(a) of the Act, 15 U.S.C. §§1126, 1141f(a), where a specimen of use is not required prior to registration, it is appropriate for the examining attorney to issue a failure to function refusal where the mark on its face, as shown on the drawing and described in the description, reflects a failure to function. *See In re AC Webconnecting Holding B.V.*, 2020 USPQ2d 11048, at *7 (TTAB 2020) (holding an application for registration filed pursuant to §44(e) subject to the requirement that the applied-for mark function as a mark); *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 §§1301.02–1301.02(f) regarding use of subject matter as a service mark; §§1302-1305 regarding use of subject matter as a collective mark; and §§1306-1306.06(c) 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 and service marks 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 Equip. 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, 1384 (TTAB 1994) (holding that DIAMOND HILL FARMS, as used on containers for goods, is 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, 1491 (TTAB 2008) (finding that the 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.*, 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 Eng'g & 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(s). Therefore, no refusal on that ground will be issued in an intent-to-use application under §1(b) 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 Bros.*, 529 U.S. 205, 209-10, 54 USPQ2d 1065, 1065-66 (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, 23 USPQ2d 1081, 1082 n.1 (1992).

Thus, trade dress includes the design of a product (i.e., the product shape or configuration), the packaging in which a product is sold (i.e., the "dressing" of a product), the color of a product or of the packaging in which a product is sold, and the flavor of a product. *Wal-Mart*, 529 U.S. at 205, 54 USPQ2d at 1065 (design of children's outfits constituted product design); *Two Pesos*, 505 U.S. at 763, 23 USPQ2d at 1081 (interior of a restaurant was akin to product packaging); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161 (1995) (color alone would be protectible); *In re N.V. Organon*, 79 USPQ2d 1639 (TTAB 2006) (flavor was analogous to product design and may be protectible unless it is functional). 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, 34 USPQ2d at 1162. 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*, 529 U.S. at 215, 54 USPQ2d at 1066. 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 of 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 email 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. §2.61(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. Mktg.Displays, Inc.*, 532 U.S. 23, 28-29, 58 USPQ2d 1001, 1004-05 (2001); *Two Pesos*, 505 U.S. at 775, 23 USPQ2d at 1086; *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1343, 213 USPQ 9, 17 (C.C.P.A. 1982) . See TMEP §§1202.02(a)–(a)(viii) regarding functionality and §§1202.02(b)–(b)(ii) and §§1212–1212.10 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 because 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 a 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* , 532 U.S. at 33, 58 USPQ2d at 1007.

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

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." *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 32, 58 USPQ2d 1001, 1006 (2001) (citing *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165, 34 USPQ2d 1161, 1163-64 (1995)); *Inwood Labs., Inc. v. Ives Labs., 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 a proper balance between trademark law and patent law. As the Supreme Court explained, in *Qualitex Co. v. Jacobson Prods. Co.*, 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. Sections 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. Mktg. 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 when 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), (f), 1064(3), 1091(c), 1115(b). A feature is functional as a matter of law if it is "essential to the use or purpose of the article or if it affects the cost or quality of the article." *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 32, 58 USPQ2d 1001, 1006 (2001) (citing *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165, 34 USPQ2d 1161, 1163-64 (1995)); *Inwood Labs., Inc. v. Ives Labs., 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 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 Eng'g, 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 Eng'g, Inc.*, 278 F.3d at 1278, 61 USPQ2d at 1428.

The determination that a proposed mark is functional constitutes, for public policy reasons, an absolute bar to registration on either the Principal or the Supplemental Register, regardless of evidence showing that the proposed mark has acquired distinctiveness. *See TrafFix*, 532 U.S. at 29-33, 58 USPQ2d at 1005-07; *In re MK Diamond Prods., Inc.*, 2020 USPQ2d 10882, at *18-19 (TTAB 2020) (quoting *In re Honeywell, Inc.*, 187 USPQ 576, 578 (TTAB 1975)); *see also In re Controls Corp. of Am.*, 46 USPQ2d 1308, 1312 (TTAB 1998) (rejecting applicant's claim that "registration on the Supplemental Register of a de jure functional configuration is permissible if the design is 'capable' of distinguishing applicant's goods"). Thus, if an applicant responds to a functionality refusal under §2(e)(5) of the Trademark Act, 15 U.S.C. §1052(e)(5), by submitting an amendment seeking registration on the Supplemental Register that is not made in the alternative, such an amendment does not introduce a new issue warranting a nonfinal Office action. *See*TMEP §714.05(a)(i). Instead, the functionality refusal must be maintained and made final, if appropriate, under §23(c) and §45 of the Act, 15 U.S.C. §§1091(c), 1127, as that is the statutory authority governing a functionality refusal on the Supplemental Register. Additionally, for functionality refusals, the associated nondistinctiveness refusal must be withdrawn. *See In re Heatcon, Inc.*, 116 USPQ2d 1366, 1370 (TTAB 2015) .

See TMEP §§1202.02(a)(v)–(a)(v)(D) 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' decision in *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 213 USPQ 9 (C.C.P.A. 1982), which was discussed by the Federal Circuit in *Valu Eng'g, 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 at 1337, 213 USPQ at 13 (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 – *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001 (2001), *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 54 USPQ2d 1065 (2000), and *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161 (1995) – 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 Sys. Inc.*, 56 USPQ2d 1279, 1282 (TTAB 2000) ; *In re Parkway Mach. 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 to make and maintain the §2(e)(5) functionality refusal. *See In re Becton, Dickinson & Co.* , 675 F.3d 1368, 1374, 102 USPQ2d 1372, 1376 (Fed. Cir. 2012) (citing *In re Teledyne Indus., Inc.* , 696 F.2d 968, 971, 217 USPQ 9, 11 (Fed. Cir. 1982)); *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). 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 "competent evidence" to rebut the examining attorney's prima facie case of functionality. *See In re Becton, Dickinson & Co.*, 675 F.3d at 1374, 102 USPQ2d at 1376 (citing *In re Teledyne Indus., Inc.*, 696 F.2d at 971, 217 USPQ at 11); *Textron, Inc. v. U.S. Int'l Trade Comm'n*, 753 F.2d at 1025, 224 USPQ at 629; *In re R.M. Smith, Inc.*, 734 F.2d at 1484, 222 USPQ at 3. The competent evidence standard requires proof by a preponderance of the evidence. *In re Becton, Dickinson & Co.*, 675 F.3d at 1374, 102 USPQ2d at 1376–77 (citing *Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 1356, 92 USPQ2d 1626, 1628 (Fed. Cir. 2009); *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1579, 6 USPQ2d 1001, 1006-07 (Fed. Cir. 1988)).

The functionality determination is a question of fact, and depends on the totality of the evidence presented in each particular case. *In re Becton, Dickinson & Co*., 675 F.3d at 1372, 102 USPQ2d at 1375 (citing *In re Bose Corp.*, 476 F.3d 1331, 1334, 81 USPQ2d 1748, 1751 (Fed. Cir. 2007); *Valu Eng'g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1273, 61 USPQ2d 1422, 1424 (Fed. Cir. 2002); *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1340, 213 USPQ 9, 15 (C.C.P.A. 1982)); *In re MK Diamond Prods., Inc.*, 2020 USPQ2d 10882, at *5 (TTAB 2020). 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 Prods., Inc.*, 671 F.2d 1332,at 1342, 213 USPQ 9, at 16-17 (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, the applicant bears an especially "heavy burden of showing that the feature is not functional" and " overcoming the strong evidentiary inference of functionality." *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 30, 58 USPQ2d 1001, 1005 (2001); *In re MK Diamond Prods., Inc.*, 2020 USPQ2d 10882, at *5; *In re Udor U.S.A., Inc.*, 89 USPQ2d 1978, 1979-80 (TTAB 2009); *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 Becton, Dickinson & Co., 675 F.3d 1368, 1374-75, 102 USPQ2d 1372, 1377 (Fed. Cir. 2012) (citing *Valu Eng'g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1274, 61 USPQ2d 1422, 1426 (Fed. Cir. 2002)); *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1340-41, 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 Indus. Inc.* , 696 F.2d 968, 971, 217 USPQ 9, 11 (Fed. Cir. 1982); *In re Witco Corp.*, 14 USPQ2d 1557, 1560 (TTAB 1989) . 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) (holding that registration was 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 features sought to be registered make 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 LexisNexis®. The examining attorney may also consult USPTO patent records.

It is not necessary to consider all the *Morton-Norwich* factors in every case. The United States 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. Mktg. Displays, Inc.*, 532 U.S. 23, 29, 58 USPQ2d 1001, 1006 (2001); *see also In re Becton, Dickinson & Co.*, 675 F.3d at 1376, 102 USPQ2d at 1378 (stating that "since the patent and advertising evidence established functionality, the Board did not need to analyze whether alternative designs exist[ed]"); *In re MK Diamond Prods., Inc.*, 2020 USPQ2d 10882, at *17 (TTAB 2020) ("Having found the applied-for mark [was] functional under *Inwood*, *TrafFix*, and their progeny without reliance upon the other factors discussed in *Morton-Norwich*, and because 'there [was] no requirement that all of the categories of evidence identified in *Morton-Norwich* appear in every case in order to' find functionality, . . .[the Board did] not address the evidence in those other categories." (internal citation omitted)); *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1499-1500 (TTAB 2017) (holding the mark as a whole primarily functional because the overall appearance of applicant's engine configuration was essential to the use or purpose of the engine and affect[ed] its quality and the totality of the record showed the functional features outweighed the decorative and non-functional aspects); *In re Loggerhead Tools, LLC*, 119 USPQ2d 1429, 1434 (TTAB 2016)(finding that the first two Morton-Norwich factors established that applicant's applied-for mark is functional, before considering the remaining factors). Moreover, there is no requirement that all four of the *Morton-Norwich* factors weigh in favor of functionality to support a refusal. *See Valu Eng'g, Inc.*, 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 Pohl-Boskamp GmbH & Co.*, 106 USPQ2d 1042 (TTAB 2013) (holding the flavor peppermint functional for nitroglycerin lingual spray based on evidence that peppermint oil, which impart[ed] a flavor of peppermint, [could] improve the effectiveness of sublingual nitroglycerin spray); *In re Udor U.S.A., Inc.*, 89 USPQ2d 1978 (TTAB 2009) (affirming the 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) (holding orange flavor for pharmaceuticals to be 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) (finding that since 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 is strong evidence that the features claimed are functional and can be sufficient in itself to support a functionality refusal. *E.g.*, *TrafFix*, 532 U.S. at 33, 58 USPQ2d at 1005 ("A utility patent is strong evidence that the features therein claimed are functional."); *Poly-America, L.P. v. Ill. Tool Works Inc.*, 124 USPQ2d 1508, 1519 (TTAB 2017) ("The issue is whether anything in the patent, its specification, or statements made in prosecution disclose the functionality of the marks. Here, they clearly do."); *In re Howard Leight Indus., 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) regarding utility and design 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*, 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); *In re OEP Enters., Inc.*, 2019 USPQ2d 309323, at *15 (TTAB 2019) (holding the entire product configuration functional based on the functional role of different components); *In re Change Wind Corp.*, 123 USPQ2d 1453, 1456-61 (TTAB 2017) (holding product configuration functional based on the functional role of the components claimed in applicant's drawing of the mark).

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 In re Becton, Dickinson & Co.*, 675 F.3d at 1374, 102 USPQ2d at 1376 (*citing Textron, Inc. v. U.S. Int'l Trade Comm'n*, 753 F.2d 1019, 1026-27, 224 USPQ 625, 630 (Fed. Cir. 1985)); *In re Vico Prods. Mfg. Co.*, 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 remove or delete the functional elements from the drawing or depict them in broken or dotted lines to indicate that they are not features of the mark. 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 that allow an object to work better are functional under §2(e)(5). As the *Morton-Norwich* court noted, "it is the 'utilitarian' *design* of a 'utilitarian' *object* with which we are concerned." 671 F.2d at 1338, 213 USPQ at 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 of the Trademark Act, 15 U.S.C §§1051, 1052, 1127. See TMEP §§1202.02(b)–(b)(ii) 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 United States 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 therein claimed 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 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 In re Becton, Dickinson & Co., 675 F.3d 1368, 1375, 102 USPQ2d 1372, 1377 (Fed. Cir. 2012) (utility patent supported finding that closure cap for blood-collection tubes was functional); *In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985) (shape of loudspeaker system enclosure held functional per patent disclosure containing evidence of functionality); *McGowen Precision Barrels, LLC v. Proof Rsch., Inc.*, 2021 USPQ2d 559, at *40-41 (TTAB 2021) (utility patent disclosed functional rifle barrel design that resulted from barrel manufacturing process); *In re MK Diamond Prods., Inc.*, 2020 USPQ2d 10882, at *10-11 (TTAB 2020) (utility patents disclosed functional role of perimeter cut-outs or slots in applicant's circular saw blade configuration); *In re OEP Enters., Inc.*, 2019 USPQ2d 309323, at *9-10 (TTAB 2019) (utility patent disclosed functional umbrella canopy design); *In re Change Wind Corp.*, 123 USPQ2d 1453, 1459-60 (TTAB 2017) (utility patent disclosed functional role of components claimed in configuration of wind turbines); *In re Dietrich*, 91 USPQ2d 1622 (TTAB 2009) (patent evidence supported bicycle wheel configuration was functional); *In re Udor U.S.A., Inc.*, 89 USPQ2d 1978 (TTAB 2009) (patent claims did not support finding spray nozzle head to be functional).

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.

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

Therefore, when 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 Indus., LLC* , 80 USPQ2d 1507, 1515 (TTAB 2006). Where functionality appears to be an issue, in the first Office action, the examining attorney must issue a request for information under 37 C.F.R §2.61(b), requiring the applicant to provide copies of any active, pending, or expired patent(s), and any pending or abandoned patent application(s). *See also Valu Eng'g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1279, 61 USPQ2d 1422, 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 In re MK Diamond Prods., Inc.*, 2020 USPQ2d 10882, at *5 (citing *In re Pohl-Boskamp GmbH & Co.*, 106 USPQ2d 1042, 1046 n.22 (TTAB 2013); *In re Mars, Inc.*, 105 USPQ2d 1859, 1861 (TTAB 2013); *In re Virshup*, 42 USPQ2d 1403, 1405 (TTAB 1997)); *AS Holdings, Inc. v. H & C Milcor, Inc.*, 107 USPQ2d 1829, 1834-35 (TTAB 2013); *In re Virshup*, 42 USPQ2d 1403, 1405 (TTAB 1997); *In re Cabot Corp.*, 15 USPQ2d 1224 (TTAB 1990). In addition, a third-party patent may include other evidence directly related to the functionality of a proposed mark. In *In re Pohl-Boskamp GmbH & Co.*, the applicant sought to register the flavor of peppermint for use in connection with pharmaceutical preparations of nitroglycerin in the form of a lingual spray. 106 USPQ2d at 1043. The examining attorney made of record a third-party patent that described the results of two studies demonstrating that peppermint oil had therapeutic properties in the applicant's field of goods. *Id.* at 1046-48. 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. But the specification and/or drawings in the patent may also provide strong evidence, even if the feature is not explicitly claimed as part of the invention. *See, e.g., In re Becton, Dickinson and Co.*, 675 F.3d at 1375, 102 USPQ2d at 1377 (there is no requirement "that a patent claim the exact configuration for which trademark protection is sought in order to undermine an applicant's assertion that an applied-for mark is not de jure functional. Indeed, . . . statements in a patent's specification illuminating the purpose served by a design may constitute equally strong evidence of functionality."); *In re MK Diamond Prods., Inc.*, 2020 USPQ2d 10882, at *9-10 ("the Court in [*TrafFix*] explained that statements in a patent can show that another party's particular design is functional because it is similar in shape to similar functional features disclosed in the patent"). In contrast, 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 (noting that where a manufacturer sought to protect arbitrary, incidental, or ornamental 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 would not be established if the manufacturer could prove that those aspects did not serve a purpose within the terms of the utility patent); *Grote Indus., Inc. v. Truck-Lite Co.*, 126 USPQ2d 1197, 1206 (TTAB 2018) (finding that utility patent did not show that the six-diode design of vehicle lights was essential to their use or purpose); *In re Udor U.S.A., Inc.*, 89 USPQ2d 1978, 1980-82 (TTAB 2009) (finding that where 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 utility patent did not support a holding of functionality). Where a utility patent claims more than what is sought to be registered, this fact does not establish the nonfunctionality of the product design, if the patent shows that the feature 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 1006-07 (nothing in the applied-for dual-spring traffic sign design pointed to arbitrary features).

The examining attorney should consider both the numbered claims and the disclosures in the written description, drawings, and abstract of the patent. *See McGowen Precision Barrels, LLC v. Proof Rsch., Inc.*, 2021 USPQ2d 559, at *40 (citing *In re Becton, Dickinson & Co.*, 675 F.3d at 1375, 102 USPQ2d at 1377; *In re Howard Leight Indus., LLC*, 80 USPQ2d at 1511). The Board has found functionality based on both the claims and/or disclosures. *See In re OEP Enters., Inc.*, 2019 USPQ2d 309323, at *10; *Leight*, 80 USPQ2d at 1510-11. In *In re Howard Leight Industries, LLC*, 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. 80 USPQ2d at 1510-11.

The examining attorney should also consider other evidence described in a patent that is relevant to the functionality of the mark at issue. *In re Pohl-Boskamp GmbH & Co.*, 106 USPQ2d at 1046-47; *see alsoIn re Becton, Dickinson & Co.*, 675 F. 3d at 1375, 102 USPQ2d at 1377 ("[S]tatements in a patent's specification illuminating the purpose served by a design may constitute equally strong evidence of functionality."); *In re Loggerhead Tools, LLC*, 119 USPQ2d 1429, 1431-32 (TTAB 2016) (indicating that evidence of functionality in a patent was not limited to language in the claims themselves).

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 a feature of the proposed mark is nonfunctional. *TrafFix*, 532 U.S. at 32, 35, 58 USPQ2d at 1006-07; *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. *See In re Becton, Dickinson & Co.*, 675 F.3d at 1375, 102 USPQ2d at 1377; *In re R.M. Smith, Inc.*, 734 F.2d 1482, 1485, 222 USPQ 1, 3 (Fed. Cir. 1984); *In re OEP Enters., Inc.*, 2019 USPQ2d 309323, at *6-7; *In re Caterpillar Inc.*, 43 USPQ2d 1335, 1339 (TTAB 1997); *In re Am. Nat'l Can Co.*, 41 USPQ2d 1841, 1843 (TTAB 1997); *see alsoIn re Loggerhead Tools, LLC*, 119 USPQ2d 1429, 1432-33 (TTAB 2016) ("[a]bsent identity between the design patent and proposed mark, . . . , 'similar' design patents lack sufficient evidentiary value" to overcome other evidence showing that the proposed mark was functional, especially in view of a utility patent that disclosed the utilitarian advantages of the claimed feature (quoting *In re Becton, Dickinson & Co.*, 675 F. 3d at 1375, 102 USPQ2d at 1377)).

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. *In re OEP Enters., Inc.*, 2019 USPQ2d 309323, at *11 (TTAB 2019) (citing *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1502 (TTAB 2017)); *AS Holdings, Inc. v. H & C Milcor, Inc.*, 107 USPQ2d 1829, 1836 (TTAB 2013) (citing *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 1375-76, 102 USPQ2d 1372, 1377-78 (Fed. Cir. 2012); *Kistner Concrete Prods., Inc. v. Contech Arch Techs., Inc.*, 97 USPQ2d 1912 (TTAB 2011); *Mag Instrument, Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701 (TTAB 2010); *In re N.V. Organon*, 79 USPQ2d 1639 (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 Commc'ns Co.*, 51 USPQ2d 1141 (TTAB 1999); *In re Edward Ski Prods., 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 OEP Enters., Inc.*, 2019 USPQ2d 309323, at *12; *In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1951 (TTAB 2001); *Goodyear Tire & Rubber Co. v. Interco Tire Corp.*, 49 USPQ2d 1705, 1716-17 (TTAB 1998); *In re Bio-Medicus Inc.*, 31 USPQ2d 1254, 1260 (TTAB 1993); *Witco*, 14 USPQ2d at 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. 61 USPQ2d at 1951. 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." *Id.*

Where functionality appears to be an issue, in the first Office action, the examining attorney must require the applicant under 37 C.F.R. §2.61(b) to provide any available advertising, promotional, or explanatory material concerning the goods or services, particularly any material specifically related to the features embodied in the proposed mark. 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.

In addition, the examining attorney may check the websites of applicant's competitors for evidence of functionality. *See In re MK Diamond Prods., Inc.*, 2020 USPQ2d 10882, at *14 (TTAB 2020) (citing *In re Becton, Dickinson & Co.*, 675 F.3d at 1376, 102 USPQ2d at 1378); *In re Van Valkenburgh*, 97 USPQ2d 1757, 1762-63 (TTAB 2011); *Gibson Guitar*, 61 USPQ2d at 1951. Industry and trade publications and computer databases may also be consulted to determine whether others offer similar designs and features or have written about the applicant's design and its functional features or characteristics. *See In re MK Diamond Prods., Inc.*, 2020 USPQ2d 10882, at *11-14. 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. 61 USPQ2d at 1951.

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 Indus. Inc.*, 41 USPQ2d 1917, 1920 (TTAB 1997) .

However, in *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001 (2001), the United States 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* and *Inwood* 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*.

TrafFix, 532 U.S. at 32-34, 58 USPQ2d at 1006-07 (emphasis added) (citations and additional internal quotations omitted); *see also In re Becton, Dickinson & Co.*, 675 F.3d 1368, 1376, 102 USPQ2d 1372, 1378 (Fed. Cir. 2012) ("[I]f functionality is found 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.'") (quoting *Valu Eng'g Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1276, 61 USPQ2d 1422, 1427 (Fed. Cir. 2002)).

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 Eng'g, Inc.*, 278 F.3d at 1277, 61 USPQ2d at 1428 ("[I]n determining 'functionality,' the Board must assess the effect registration of a mark would have on competition.").

Accordingly, the examining attorney must issue a request for information under 37 C.F.R. §2.61(b) about alternative designs in the initial Office action, 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 OEP Enters., Inc.*, 2019 USPQ2d 309323, at *14-15 (TTAB 2019) (noting that applicant made no showing that either lower canopies of cutouts, no material at all, and other types of air transmissible materials worked equally as well as the lower mesh canopy in the patented umbrella design, which supported the Board's determination that the proposed umbrella design was functional); *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.'") (quoting *Valu Eng'g*, 278 F.3d at 1276, 61 USPQ2d at 1427)); *In re N.V. Organon*, 79 USPQ2d 1639, 1645-46 (TTAB 2006) (concluding that, since the record showed that orange flavor was one of the most popular flavors for medicine, it could not be said that there were true or significant number of alternatives); *In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1951 (TTAB 2001) (finding that applicant had not shown there were alternative guitar shapes that could produce the same sound as applicant's configuration, and 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, which stated that the shape of the guitar produced 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 1648-49, 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 Eng'g*, 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 Eng'g*, 278 F.3d at 1276, 61 USPQ2d at 1427). However, once deemed functional under other *Morton-Norwich* factors, the claimed trade dress cannot be registered merely because there are functionally equivalent alternative designs. *Valu Eng'g*, 278 F.3d at 1276, 61 USPQ2d at 1427 (citing *TrafFix*, 532 U.S. at 33-34, 58 USPQ2d at 1007). Existence of comparable alternative designs does not transform a functional design into a nonfunctional design. *Id.*

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]*.'" *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 32, 58 USPQ2d 1001, 1006 (2001) (emphasis added) (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165, 34 USPQ2d 1161, 1163-64 (1995)); *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850 n.10, 214 USPQ 1, 4 n.10 (1982) (citing *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 232, 140 USPQ 524, 528 (1964); *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 122, 39 USPQ 296, 300 (1938)). 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 must still issue a requirement under 37 C.F.R. §2.61(b) for information as to whether the proposed design makes the product simpler or less costly to manufacture, since evidence on this issue weighs strongly in favor of a finding of functionality. *See, e.g.*, *TrafFix*, 532 U.S. at 32, 58 USPQ2d at 1006; *In re Virshup*, 42 USPQ2d 1403, 1407 (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 supported finding that applicant's configurations of metal ventilating ducts and vents for tile or concrete roofs were functional).

While evidence showing that a product feature results from a comparatively simple or inexpensive method of manufacture supports a determination 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, fails to 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, 1646 (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, 1531, 1533, 32 USPQ2d 1120, 1122, 1124 (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. Mktg. Displays, Inc.*, 532 U.S. 23, 33, 58 USPQ2d 1001, 1006 (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 §§1202.03-1202.03(g) 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 Prods. Co.*, 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, 1096 (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.

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. *Id*. 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. In *In re Florists' Transworld Delivery Inc*., 106 USPQ2d 1784 (TTAB 2013) , for example, the record included evidence reflecting that, in the floral industry, color has significance and communicates particular messages (e.g., elegance, bereavement, Halloween), which extend to floral packaging. The Board found, therefore, that the examining attorney had demonstrated a competitive need for others in the industry to use black in connection with floral arrangements and packaging therefor and concluded that the proposed mark was functional under §2(e)(5). 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 of the Trademark Act, 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 *Florists' Transworld Delivery*, *M-5 Steel*, and *Brunswick* cases discussed above – 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, 1793 (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. *Id*. at 1786. 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 [Devices, Inc. v. Mktg. Displays, Inc., 532 U.S. 23, 32, 58 USPQ2d 1001, 1006 (2001)]* 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 focused 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.

Id. at 1794.

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." *Duramax*, 80 USPQ2d 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) (finding the color black for outboard motors 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 Florists' Transworld Delivery Inc*., 106 USPQ2d 1784, 1791 (TTAB 2013) (finding the color black for floral packaging functional because there was a competitive need for others in the industry to use black in connection with floral arrangements and flowers in order to communicate a desired sentiment or occasion such as elegance, bereavement, or Halloween); *In re Pohl-Boskamp GmbH & Co*., 106 USPQ2d 1042 (TTAB 2013) (finding the flavor peppermint functional for nitroglycerin lingual spray based on evidence that peppermint oil, which imparts a flavor of peppermint, can improve the effectiveness of sublingual nitroglycerin spray); *In re Vertex Grp. LLC*, 89 USPQ2d 1694, 1700 (TTAB 2009) (affirming the refusal to register an alarm sound emitted by personal security alarms in the normal course of operation without showing of acquired distinctiveness); *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 use various shades of purple, including 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, 1645-46 (TTAB 2006) (finding the flavor orange functional for pharmaceuticals where the evidence showed the flavor served to mask the otherwise unpleasant taste of the medicine flavor); *see also Qualitex Co. v. Jacobson Prods. Co.*, 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) and 1202.05(b) (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 are essential to the use or purpose of the goods. *Cf. Vertex*, 89 USPQ2d at 1703 (finding 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 §§1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127, for trademark applications, or §§1, 2, 3, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, 1053, and 1127, for service mark applications.

In *Wal-Mart Stores, Inc. v Samara Bros.*, 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.* at 212, 54 USPQ at 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.* 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. Mktg. Displays, Inc.*, 532 U.S. 23, 33, 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) (holding that an examining attorney had "effectively conceded that, assuming the mark is not functional, applicant's evidence is sufficient to establish that the mark has 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 nonfunctional). See TMEP §§1209.02(a)(ii) and 1212.02(i) regarding assertion of acquired distinctiveness in response to an Office action and claiming acquired distinctiveness with respect to incapable matter.

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) of the Trademark Act. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 213-16, 54 USPQ2d 1065, 1069-70 (2000). Therefore, as a matter of law, product design cannot be considered inherently distinctive

and cannot be registered without a showing of secondary meaning. *Id*. at 213–14, 54 USPQ2d at 1069. The United States Supreme Court noted that product design almost invariably serves purposes other than source identification, and that "[c]onsumers are aware . . . that, almost invariably, even the most unusual of product designs -- 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 applications seeking registration of marks comprising 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 provides sufficient evidence to show that the mark has acquired distinctiveness. The ground for the refusal is that the proposed mark consists of 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, 1127. Because product design cannot be inherently distinctive as a matter of law, per *Wal-Mart*, if the applicant has not claimed acquired distinctiveness, supporting evidence for the refusal is unnecessary. 529 U.S. at 213-16, 54 USPQ2d at 1069-70. 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 §§815–816.05 regarding the Supplemental Register, §§1202.02(a)–(a)(viii) regarding functionality, §§1202.02(b)–(b)(ii) regarding distinctiveness, and §§1212–1212.10 regarding acquired distinctiveness. A refusal on the ground that the entire proposed mark is not inherently distinctive generally is not appropriate if the mark includes additional distinctive matter beyond just the product design, such as words and/or images. In such situations, the applicant may be required to disclaim or claim acquired distinctiveness in part as to any non-inherently distinctive elements.

For applications based on §1(b) of the Trademark Act, 15 U.S.C. §1051(b), the examining attorney must issue the nondistinctiveness refusal for a product design mark even if the applicant has not filed an allegation of use. See TMEP §1202.02(d) regarding trade dress in intent-to-use applications. For applications based on §44 or §66(a), even though the applicant does not need to show use in commerce, the same standards regarding product design apply and the examining attorney must issue the nondistinctiveness refusal, assuming acquired distinctiveness has not been established. See TMEP §1010 regarding §44 applications and TMEP §1212.08 regarding distinctiveness in §44 or §66(a) applications.

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 and, thus, require proof of secondary meaning. 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 id.* at 207, 213, 54 USPQ2d at 1066, 1069 (holding 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, 961, 78 USPQ2d 1395, 1398 (Fed. Cir. 2006) (holding the mark to be product design trade dress where the mark was for clothing and consisted 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).

Applicants face a heavy burden in establishing distinctiveness in an application to register trade dress. *See In re Jasmin Larian, LLC*, 2022 USPQ2d 290, at *38 (TTAB 2022); *In re MK Diamond Prods., Inc.*, 2020 USPQ2d 10882, at *19 (TTAB 2020); *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1504 (TTAB 2017); *In re Udor U.S.A. Inc.*, 89 USPQ2d 1978, 1986 (TTAB 2009); *In re Ennco Display Sys. Inc.*, 56 USPQ2d 1279, 1283-84 (TTAB 2000); *In re OEP Enters., Inc.*, 2019 USPQ2d 309323, at *16 (TTAB 2019); *see also Duraco Prods., Inc. v. Joy Plastic Enters., Ltd.*, 40 F.3d 1431, 1453, 32 USPQ2d 1724, 1742 (3d Cir. 1994) ("secondary meaning in a product configuration case will generally not be easy to establish"). A mere statement of five years' use is generally not sufficient. *See, e.g., In re Ennco Display*

Sys. Inc., 56 USPQ2d at 1284, 1286 (noting the statutory language regarding acquired distinctiveness "is permissive, and the weight to be accorded [evidence of five years of substantially exclusive use] depends on the facts and circumstances of the particular case," and finding evidence of seven to seventeen years of use insufficient to support a claim of acquired distinctiveness). Generalized sales and advertising figures by themselves will usually be insufficient proof of secondary meaning where the promotional material does not use the design alone but instead with other marks. *See In re Soccer Sport Supply Co.*, 507 F.2d 1400, 1403, 184 USPQ 345, 348 (C.C.P.A. 1975) (advertising displaying the design at issue along with word marks lacked the "nexus" that would tie together use of the design and the public's perception of the design as an indicator of source); *In re Mogen David Wine Corp.*, 372 F.2d 539, 542, 152 USPQ 593, 595 (C.C.P.A. 1967) (where a container design appeared with a word mark, any alleged association of the design with the company "was predicated upon the impression imparted by the [word] mark . . . rather than by any distinctive characteristic of the container per se."); *Grote Indus. Inc. v. Truck-Lite Co.*, 126 USPQ2d 1197, 1213 (TTAB 2018) (where advertising prominently used word mark, consumers were more likely to associate the word mark rather than the design with the source of the goods), *judgment rev'd and vacated by consent decree*, No. 1:18-cv-00599 (W.D.N.Y. June 8, 2022). "[I]n the context of product design marks, it is imperative that the evidence of acquired distinctiveness 'relate to the promotion and recognition of the specific configuration embodied in the applied-for mark and not to the goods in general.'" *In re Jasmin Larian, LLC*, 2022 USPQ2d 290, at *39 (quoting *In re Change Wind Corp.*, 123 USPQ2d 1453, 1467 (TTAB 2017)); *see In re SnoWizard, Inc.*, 129 USPQ2d 1001, 1004-5 (TTAB 2018) (citing *Wal-Mart Stores Inc. v. Samara Bros.*, 529 U.S. at 211-13, 54 USPQ2d at 1068-69).

A product design may become generic and thus incapable of functioning as an indicator of source because it is basic or common in an industry or is a mere refinement of a product design commonly used for the relevant goods. *In re Jasmin Larian, LLC*, 2022 USPQ2d 290, at *5-6 (noting that a design may be deemed incapable of registration where "it is so common in the industry that it cannot be said to identify a particular source" (citing *Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 1555 (TTAB 2009))). These common or basic shapes are not registrable on the Principal Register under §2(f), 15 U.S.C. §1052(f), or on the Supplemental Register under §23(c), 15 U.S.C. §1091(c).

For these incapable product designs, registration on the Principal Register must be refused on the ground that the proposed mark fails to function as a mark, citing Trademark Act §§1, 2, and 45 for trademarks, and §§1, 2, 3, and 45 for service marks. *See*15 U.S.C. §§1051, 1052, 1053, 1127. The ground for refusal on the Supplemental Register is that the mark is incapable of functioning as a mark under §§23(c) and 45. *See*15 U.S.C. §§1091(c), 1127. A two-step generic inquiry should be applied to product design trade dress under these refusals to determine: (1) "the genus of the goods or services at issue," and (2) "whether the consuming public primarily regards the matter sought to be registered as a category or type of trade dress for the genus of goods or services." *In re Jasmin Larian, LLC*, 2022 USPQ2d 290, at *6 (citing *In re Odd Sox LLC*, 2019 USPQ2d 370879, at *6 (TTAB 2019)). See TMEP §1209.01(c)(i) for more information regarding the two-step test for determining whether a proposed mark is generic and the evidence needed to support such refusal.

See TMEP §1212.02(i) regarding acquired distinctiveness with respect to incapable matter.

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

Product packaging trade dress may be inherently distinctive. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 212-13, 54 USPQ2d 1065, 1068 (2000) ("The attribution of inherent distinctiveness to certain . . . product packaging derives from the fact that the very purpose of . . . encasing [a product] in a distinctive packaging, is most often to identify the source of the product").

Therefore, in applications seeking registration of marks comprising product packaging, the examining attorney must assess inherent distinctiveness. If it is lacking, registration must be refused 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, 1127, for trademark applications, or under §§1, 2, 3, and 45, 15 U.S.C. §§1051, 1052, 1053, 1127, for service mark applications.

In *Wal-Mart Stores, Inc. v. Samara Bros.*, the United States 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) considered 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 . . . .

529 U.S. at 215, 54 USPQ2d at 1069 (citation omitted).

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*. 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.*, 505 U.S. at 768, 23 USPQ2d at 1083). 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 a particular field;
(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; or
(4) capable of creating a commercial impression distinct from the accompanying words.

Id.; *see, e.g.*, *In re Chippendales USA, Inc.*, 622 F.3d 1346, 1351, 96 USPQ2d 1681, 1684 (Fed. Cir. 2010) (stating that an abbreviated tuxedo costume consisting of wrist cuffs and a bowtie collar without a shirt "constitute[d] 'trade dress' because it was part of the 'packaging'" for exotic dancing services); *Tone Bros., Inc. v. Sysco Corp.*, 28 F.3d 1192, 1205-07, 31 USPQ2d 1321, 1330-32 (Fed. Cir. 1994) (citing *Seabrook*, 568 F.2d at 1344, 196 USPQ at 291) (reversing lower court's summary judgment decision that the shape and appearance of the spice container at issue was not inherently distinctive); *In re Odd Sox LLC*, 2019 USPQ2d 370879, at *9 (TTAB 2019) (finding rectangular sock packaging that displayed socks side-by-side to be a common shape in the socks industry that was not unique or unusual in the field of socks, and "a mere refinement of the attributes of the existing packaging in the record" that did not create a separate impression from wording on the packaging) (quoting *In re Chevron Intell. Prop. Grp. LLC*, 96 USPQ2d 2026, 2029 (TTAB 2010));*In re Frankish Enters. Ltd.*, 113 USPQ2d 1964, 1973 (TTAB 2015) (finding three-dimensional monster truck design, used in connection with monster truck exhibition services, to be analogous to product packaging for the services and unique in the monster truck field); *In re Mars, Inc.*, 105 USPQ2d 1859, 1869-71 (TTAB 2013) (finding packaging configuration for pet food, resembling many cans used in the pet

food field, to be a common basic shape, even though it was inverted, and a mere refinement of existing trade dress within the field); *In re Chevron Intell. Prop. Grp. LLC,* 96 USPQ2d at 2029 (holding "'three-dimensional, six-sided beveled shape' [pole spanner design used to promote services] was a mere refinement of a commonly used form of a gasoline pump ornamentation rather than an inherently distinctive service mark for automobile service station services."); *In re Brouwerij Bosteels*, 96 USPQ2d 1414, 1421-22 (TTAB 2010) (holding that 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) (stating that 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 [of packaging for electric lights for Christmas trees that] applicant seeks to register 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."); *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."); *Yankee Candle Co. v. Bridgewater Candle Co., LLC*, 259 F.3d 25, 42-45, 59 USPQ2d 1720, 1730-32 (1st Cir. 2001) (finding trade dress for common elements of candle labels to be nondistinctive product packaging for which insufficient evidence of acquired distinctiveness had been shown).

Any one of the *Seabrook* factors, by itself, may be determinative as to whether the mark is inherently distinctive. *See Chippendales*, 622 F.3d at 1355, 96 USPQ2d at 1687; *Chevron*, 96 USPQ2d at 2028.

Where the proposed product packaging trade dress is not inherently distinctive, based on the analysis of the *Seabrook* factors and supporting evidence, and acquired distinctiveness has not been established, registration must be refused. *Chippendales*, 622 F.3d at 1351-52, 96 USPQ2d at 1684. The examining attorney must establish a prima facie case that the product packaging is not inherently distinctive. *Id*. at 1350, 96 USPQ2d at 1684. To meet this burden, the examining attorney must, at a minimum, set forth a "'reasonable predicate' for [the] position of no inherent distinctiveness," for example, by introducing evidence regarding the first *Seabrook* factor that competitors use similar basic shapes and designs. *In re Pacer Tech.*, 338 F.3d 1348, 1352, 67 USPQ2d 1629, 1632 (Fed. Cir. 2003) (finding evidence of design patents showing other adhesive container cap designs sufficient to establish prima facie case that applicant's adhesive container cap was not inherently distinctive). The USPTO is an agency of limited resources, and as such, it cannot be expected to shoulder the burden of conducting market research. *Id.*

For applications based on §1(b) of the 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). For §44 and §66(a) applications, for which no allegation of use is required, a nondistinctiveness refusal may be issued, if appropriate, based on a review of the drawing, the description of the mark, and any evidence obtained from the examining attorney's search results. *See*TMEP §1202.02(e).

Regardless of the basis for filing, if a proposed product packaging mark is inherently distinctive, it may be registered on the Principal Register. *SeeIn re Procter & Gamble Co*., 105 USPQ2d 1119, 1123, 1126 (TTAB 2012) (holding the overall shape of a container with a cap, and the shape of the cap by itself, inherently distinctive for mouthwash); *In re Creative Beauty Innovations, Inc*., 56 USPQ2d 1203, 1208 (TTAB 2000) (holding bottle configuration inherently distinctive); *In re Fre-Mar Indus., 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 Int'l Playtex Corp.*, 153 USPQ 377, 378 (TTAB 1967) (holding container configuration having the appearance of an ice cream cone inherently distinctive packaging 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. Distinctiveness or 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. Whether five years' use is sufficient depends on the degree to which the mark's elements are unique or common in the field. This is determined by comparing the specific features comprising the mark with the evidence of competitors' use of similar features for the identified goods or services. The more unique or unusual the features, the more likely that five years' use may suffice, but the more common or basic the features, the less likely that five years' use would suffice. See TMEP §1212 regarding claiming acquired distinctiveness and §1212.05 regarding claiming five years of use as proof of distinctiveness.

In certain cases, the applicant's evidence was found sufficient to support a claim of acquired distinctiveness. *See In re World's Finest Chocolate, Inc.*, 474 F.2d 1012, 1015, 177 USPQ 205, 207 (C.C.P.A. 1973) (package design held 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.").

See TMEP §§1212-1212.10 regarding acquired distinctiveness and §§815-816.05 regarding the Supplemental Register.

In certain cases, the applicant's evidence was found insufficient to support a claim of acquired distinctiveness. *SeeIn re Usher, S.A.*, 219 USPQ 920, 921 (TTAB 1983)(holding that the configuration of a package for mint candies was not functional but the package design was not shown to possess secondary meaning); *see also Brouwerij Bosteels*, 96 USPQ2d at 1424 (holding evidence of acquired distinctiveness for product packaging trade dress in the nature of a beer glass and stand was insufficient).

In certain cases, product packaging may be incapable of functioning as an indicator of source. "[T]rade dress that cannot serve as an indicator of source is generic and unprotectable." *Sunrise Jewelry Mfg. Corp. v. Fred S.A.*, 175 F.3d 1322, 1326, 50 USPQ2d 1532, 1535 (Fed. Cir. 1999). For example, packaging that is common or basic in an industry or that is a mere refinement of packaging commonly used on the relevant goods will not be perceived as indicating source and is not registrable on the Principal Register under §2(f) or on the Supplemental Register. *See In re Odd Sox LLC*, 2019 USPQ2d 370879, at *6 (holding that the same standard used to determine whether product design trade dress was generic "applies equally to product packaging" trade dress); *Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 1555 (TTAB 2009) (noting that a product design may be deemed incapable where it is, "at a minimum, so common in the industry that it cannot be said to identify a particular source."); *see also Nora Beverages Inc. v. Perrier Grp. of Am. Inc.*, 269 F.3d 114, 120, 60 USPQ2d 1038, 1041 (2d Cir. 2001) (affirming the district court's holding that the water bottle manufactured and sold by Nora was generic because "it was used, with minor variations, throughout the entire market of similar products"); *Paddington Corp. v. Attiki Imps. & Distribs., Inc.*, 996 F.2d 577, 583-84, 27 USP2d 1189, 1193 (2d Cir. 1993) ("[W]here it is the

custom of an industry to package products in a particular manner, a trade dress in that style would be generic and therefore not inherently distinctive.”).

The ground for refusal on the Principal Register is that the proposed mark fails to function as a mark under §§1, 2, and 45 of the Act for trademarks, and under §§1, 2, 3, and 45 of the Act for service marks. *See*15 U.S.C. §§1051, 1052, 1053, 1127. The ground for refusal on the Supplemental Register is that the mark is incapable of functioning as a mark under §§23(c) and 45 of the Act, 15 U.S.C. §§1091(c), 1127. A two-step generic inquiry should be applied to product packaging trade dress under these refusals to determine: (1) “the genus of goods or services at issue,” and (2) “whether the consuming public primarily regards the matter sought to be registered as a category or type of trade dress for the genus of goods or services.” *In re Odd Sox LLC*, 2019 USPQ2d 370879, at *6 (citing *Sunrise Jewelry Mfg. Corp.*, 175 F.3d at 1326-27, 50 USPQ2d at 1536; *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 990, 228 USPQ 528, 530 (Fed. Cir. 1986)). See TMEP §1209.01(c)(i) for more information regarding the two-step test for determining whether a mark is generic and the evidence needed to support such refusal.

See TMEP §815.04 regarding refusal of incapable matter and TMEP §1212.02(i) regarding acquired distinctiveness with respect to incapable matter.

1202.02(c) Drawings, Descriptions, and Disclaimers 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) nondistinctive and incapable; (4) nondistinctive and capable; (5) inherently distinctive; or (6) a combination of these factors. To ensure proper examination, the drawing and description of such a mark must accurately depict the mark the applicant intends to register. For example, both the drawing and the description of the mark must clearly indicate those portions that are claimed as part of the mark and those that are not.

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 of Trade Dress Marks

Drawings of three-dimensional product design and product packaging trade dress marks may not contain elements that are not part of the mark (i.e., matter that is functional or incapable of trademark significance). If the mark comprises only a portion of product design or product packaging, solid lines must be used on the drawing to show the elements of the product design or product packaging that are claimed as part of the mark, and broken or dotted lines must be used to indicate the portions that are not claimed as part of the mark. 37 C.F.R. §2.52(b)(4); *In re OEP Enters., Inc.*, 2019 USPQ2d 309323, at *2 (TTAB 2019) (citing *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1488 (TTAB 2017)) (finding drawing of umbrella design trade dress had no broken lines and therefore was claiming all features of the umbrella, including the mesh lower canopy of a double canopy umbrella);*see In re Water Gremlin Co.*, 635 F.2d 841, 844, 208 USPQ 89, 91 (C.C.P.A. 1980) (affirming 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.

Since elements on the drawing shown in broken or dotted lines are not part of the mark, they are generally excluded from the examining attorney's consideration during any §2(d) (likelihood of confusion) analysis. *See In re Homeland Vinyl Prods., 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, the applicant may use solid lines. However, the applicant must insert a statement in the description of the mark identifying these elements and declaring that these elements are not part of the mark and that they serve only to show the position of the mark on the goods, as appropriate.

Usually, a drawing of a trade dress mark is depicted in a three-dimensional manner that gives the appearance of height, width, and depth to the mark. Generally, the drawing shows an illustrated rendering of the product design or product packaging, but a photograph of the product design or product packaging is also acceptable. Drawings consisting of either illustrated renderings or photographs of the proposed trade dress will both be subject to the same drawing requirements and must fairly represent the mark (e.g., the drawing shows matter not claimed as part of the mark in broken or dotted lines and it does not contain extraneous, purely informational matter such as net weight, contents, or business addresses).

If the nature of the mark remains unclear from the record, an examining attorney may clarify whether the mark is three-dimensional trade dress by calling or emailing the applicant, or issuing an Office action containing requirements about the nature of the mark under 37 C.F.R. §2.61(b), for a clear drawing, or for a revised description. Where appropriate, any relevant trade-dress-related refusals (e.g., mark is functional, mark is not inherently distinctive) may also be included in the Office action.

In cases where the drawing depicts a two-dimensional mark that could be interpreted as three-dimensional in nature and the record is unclear, the examining attorney may suggest that the applicant clarify that the mark is two-dimensional in the mark description. See TMEP §808.02. If the mark is two-dimensional in nature, the mark should not be characterized as three-dimensional (e.g., that the mark " *appears* three-dimensional").

If the applicant is required to submit an amended drawing, the mark description must also be amended accordingly. See TMEP §1202.02(c)(ii) regarding description requirements for trade dress marks.

1202.02(c)(i)(A) Functional Matter

Functional elements of a trade dress mark are never capable of acquiring trademark significance and are unregistrable, much like informational matter. 15 U.S.C. §1052(e)(5); *Qualitex Co. v. Jacobson Prods. Co* ., 514 U.S. 159, 34 USPQ2d 1161 (1995). Therefore, to show that they are not part of the mark, functional elements must be depicted in broken or dotted lines on the drawing to show the position or placement of the claimed portion of the mark. *See* 37 C.F.R. §2.52(b)(4); *In re Water Gremlin Co.*, 635 F.2d 841, 844, 208 USPQ 89, 91 (C.C.P.A. 1980); *In re Famous Foods, Inc*., 217 USPQ 177, 177 (TTAB 1983) . A requirement to amend the drawing to depict functional matter in broken or dotted lines is permitted and generally does not constitute material alteration of the mark, regardless of the filing basis. *See*TMEP §807.14(a). Such an amendment is permissible even in an application under §66(a) because it is not considered an amendment to the mark itself, but rather a change in the manner in which the mark is depicted on the drawing, in order to comply with United States drawing requirements, where functional elements are not considered part of the mark. See TMEP §807.14 regarding material alteration and TMEP §§1904.02(j)-(k) regarding drawings in §66(a) applications.

A functionality refusal must issue in cases where the trade dress mark is overall functional. The statutory basis for the refusal is §2(e)(5) of the Trademark Act, 15 U.S.C. §1052(e)(5). When a trade dress mark is not overall functional, but contains minor or insignificant elements that are functional, the examining attorney must require an amended drawing showing the functional elements in broken or dotted lines rather than in solid lines. *See* 37 C.F.R. §2.52(b)(4); *Water Gremlin*, 635 F.2d at 844, 208 USPQ at 91; *Famous Foods*, 217 USPQ at 177. The Office action must explain that, because the mark includes functional elements, an amended drawing is required showing the functional elements in broken or dotted lines, and a corresponding amended mark description is required indicating the functional elements depicted in broken or dotted lines are not claimed as part of the mark. The applicant must provide the amended drawing regardless of whether the remaining portions of the mark are determined to be registrable. See TMEP §1202.02(a)(v) regarding evidence and considerations regarding functionality determinations and TMEP §1202.02(c)(ii) regarding descriptions of trade dress marks.

Functional matter cannot be disclaimed. *See Water Gremlin*, 635 F.2d at 844, 208 USPQ at 91 ("The examiner's requirement to delete the [functional] design (or show it in dotted lines) was entirely in order."); *Famous Foods*, 217 USPQ at 177 (stating that functional "[f]eatures which are not being claimed as part of applicant's asserted [trade dress] mark should be shown in dotted lines"). A disclaimer states that the applicant does not claim exclusive rights to matter in the mark apart from the mark as a whole and allows the applicant to maintain rights in the disclaimed matter as part of its own mark. Therefore, with respect to three-dimensional trade dress marks, elements that are functional, or intended to show position or placement only, must be shown in broken or dotted lines on the drawing. See TMEP §1202.02(c)(iii) regarding disclaiming unregistrable portions of trade dress marks.

1202.02(c)(i)(B) Nondistinctive Matter

Nonfunctional elements of a product design or product packaging trade dress mark that are inherently distinctive, that have acquired distinctiveness, or that are capable but for which acquired distinctiveness has not yet been established, may appear in solid lines on the drawing as part of the mark. Nonfunctional, nondistinctive elements that are capable of trademark significance but for which acquired distinctiveness has not been established must be disclaimed. A disclaimer is appropriate because, while these elements are not source indicators, they may still remain part of the mark. *See*15 U.S.C. §§1051-1052, 1056(a), 1127. The disclaimer must be provided regardless of whether the remaining portions of the mark are determined to be registrable.

Occasionally, a trade dress mark may include elements that are nonfunctional, yet incapable of trademark significance, such as a common or basic shape of a product itself or the packaging in which a product is sold. These elements must be depicted in broken or dotted lines on the drawing because such elements cannot be considered part of the mark. *Cf. Traffix Devices v. Mktg. Displays* , 532 U.S. 23, 32, 58 USPQ2d 1001, 1006 (2001) (noting that functional features of product design cannot serve as trademarks); *In re Famous Foods, Inc*., 217 USPQ 177, 177 (TTAB 1983) (noting that functional features of product packaging should be shown in dotted lines). Usually, amendments of drawings to depict incapable elements in broken or dotted lines do not materially alter the mark because the incapable elements are, by definition, not source indicating. *See* 37 C.F.R. §2.52(b)(4); *In re Water Gremlin Co*., 635 F.2d 841, 844, 208 USPQ 89, 91 (C.C.P.A. 1980). Therefore, the examining attorney must issue a requirement for an amended drawing that depicts the incapable elements in broken or dotted lines, and a corresponding amended mark description to reflect that the incapable elements shown in broken or dotted lines are not claimed as part of the mark. *See* 37 C.F.R. §2.52(b)(4). The applicant must provide the amended drawing regardless of whether the remaining portions of the mark are determined to be registrable.

See TMEP §807.14 regarding material alteration, TMEP §1202.02(c)(ii) regarding descriptions of trade dress marks, TMEP §1011.03 regarding amendment of marks in §44 applications, and TMEP §§1904.02(j)-(k) regarding amendment of marks in §66(a) applications.

1202.02(c)(i)(C) Drawings in §44 and §66(a) Applications

For trade dress marks in §44 and §66(a) applications, an amendment of the drawing to depict functional or incapable matter in broken or dotted lines is permitted and generally not a material alteration of the mark. *See*TMEP §§807.08 and 1904.02(k). Although the mark in a §44 or §66(a) application cannot be amended, a change in the manner in which the mark is depicted may be permitted, in order to comply with the United States drawing requirements. See TMEP §1011.03 regarding amendment of marks in §44 applications and §1904.02(j)-(k) regarding amendment of marks in §66(a) applications. For instance, since functional matter is not considered source indicating and is never part of the mark, displaying it in broken or dotted lines shows placement of the functional matter in relation to the registrable portions of the mark.

Similarly, in §44 or §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 of the mark.

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

An application for a trade dress mark 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 "product design" or "configuration" of the goods themselves or product "packaging" or a "container" in which the goods are sold, or that the trade dress is for services offered (e.g., interior of a restaurant, exterior of a retail establishment, or point-of-sale-display such as a costume used in connection with the services).

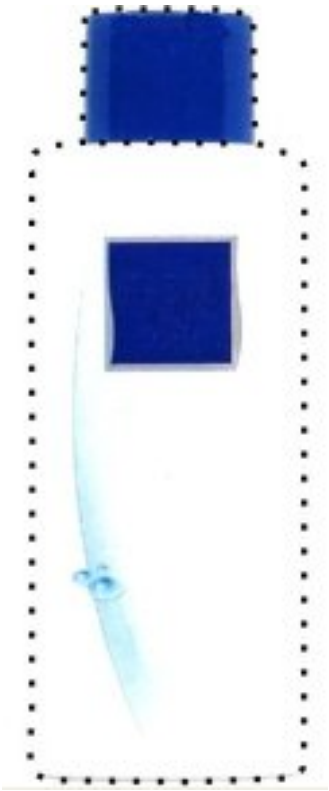
If applicable, the description must specify which elements on the drawing constitute the mark and are claimed as part of the mark and which are not. The description of the mark must make clear what any broken or dotted lines represent and include a statement that the matter shown in broken or dotted lines is not claimed as part of the mark. *See* 37 C.F.R. §2.52(b)(4); TMEP §§808-808.03(f). This information must be included in the description. Statements only in a response to an Office action or elsewhere in the record are insufficient. 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.

In cases where the drawing depicts a two-dimensional mark that could be interpreted as three-dimensional in nature, an applicant may clarify that the mark is two-dimensional in the mark description. *See*TMEP §808.02. If the mark is two-dimensional in nature, the applicant should not characterize the mark as three-dimensional (e.g., that the mark " *appears* three-dimensional").

During the prosecution of a trade dress application, if the applicant is required to submit an amended drawing (e.g., showing broken or dotted lines to depict functional matter, to indicate nondistinctive and incapable matter, or to depict matter otherwise not claimed as part of the mark), 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.”

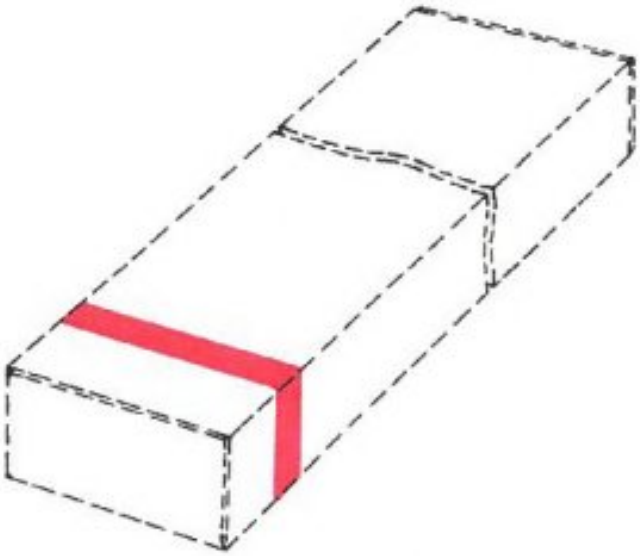
For example, for the mark below,



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.

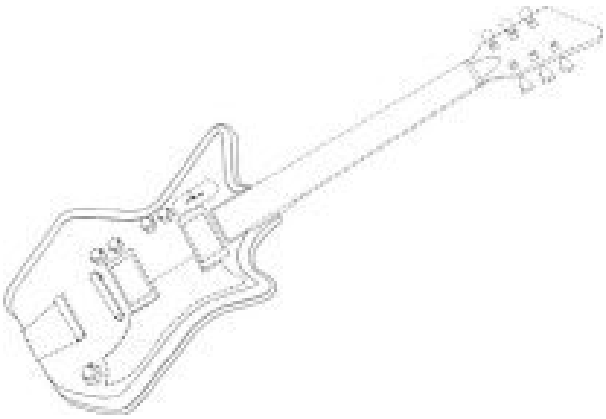
For the mark below,



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 three-dimensional 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 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

A disclaimer states that the applicant does not claim exclusive rights to matter in the mark apart from the mark as a whole. TMEP §1213. The applicant maintains rights in the disclaimed matter only as part of its mark. Thus, except in the rare case when a trade dress mark is unitary, unregistrable elements must be either depicted in broken or dotted lines on the drawing or disclaimed, as appropriate. Specifically, elements that are functional or otherwise incapable of trademark significance must be depicted in broken or dotted lines on the drawing. Elements that are nonfunctional but capable of acquiring trademark significance, but for which acquired distinctiveness has not been established, must be disclaimed. See TMEP §§1202.02(c)(iii)(A)–(B) regarding functional and nondistinctive matter that cannot be disclaimed.

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), "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 such that the mark as a whole is typically not unitary. Therefore, when a mark contains a combination of trade dress and word/design elements, each element should be examined separately for distinctiveness, except in the rare instance where it is shown that the mark as a whole is unitary. If only one element is inherently distinctive, this is not enough to transform the entire mark into an inherently distinctive, unitary mark. See TMEP §§1213.05-1213.05(h) regarding unitary marks.

1202.02(c)(iii)(A) Functional Matter

Since functional elements of a trade dress mark are unregistrable as a matter of law and cannot form part of the mark, a disclaimer is not an appropriate means of addressing functional matter in a trade dress mark. *See In re Water Gremlin Co.*, 635 F.2d 841, 844, 208 USPQ 89, 91 (C.C.P.A. 1980) ("The examiner's requirement to delete the [functional] design (or show it in dotted lines) was entirely in order."); *In re Famous Foods, Inc.*, 217 USPQ 177, 177 (TTAB 1983) (stating that functional "[f]eatures which are not being claimed as part of applicant's asserted [trade dress] mark should be shown in dotted lines"). Instead, if the mark is not overall functional, an amendment of the drawing must be required to depict any minor or insignificant functional elements in broken or dotted lines. *Id.*; *see* TMEP §1202.02(c)(i). However, if the mark is overall functional, registration must be refused under §2(e)(5) of the Trademark Act, 15 U.S.C. §1052(e)(5).

1202.02(c)(iii)(B) Nondistinctive Matter

Sometimes, a trade dress mark, as a whole, is registrable but contains elements that are nondistinctive but capable. *See* TMEP §1202.02(c)(i)(B). In this situation, if acquired distinctiveness has not been established, the capable elements must be disclaimed because, while they are not source indicators, they are still part of the mark. *See* 15 U.S.C §§1051-1052, 1056(a), 1127. The disclaimer must be provided regardless of whether the remaining portions of the mark are determined to be registrable. However, where the nondistinctive elements are incapable of acquiring distinctiveness, for example, common or basic shapes of product design or product packaging, such elements are not part of the mark and, therefore, must be depicted in broken or dotted lines rather than disclaimed. *See* 37 C.F.R. §2.52(b)(4); *cf. Traffix Devices v. Mktg. Displays*, 532 U.S. 23, 32, 58 USPQ2d 1001, 1006 (2001) (noting that functional features of product design cannot serve as trademarks); *In re Famous Foods, Inc*., 217 USPQ 177, 177 (TTAB 1983) (noting that functional features of product packaging should be shown in dotted lines).

See TMEP §1212.02(e) regarding disclaimers of unregistrable components in applications to register marks on the Principal Register under §2(f), TMEP §1212.02(i) regarding acquired distinctiveness with respect to incapable matter, and TMEP §§1213.03–1213.03(d) regarding disclaimers of unregistrable components of marks. *See also In re Creative Goldsmiths of Wash., 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, 144, 196 USPQ 7, 8 (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. To accurately reflect the exact nature of the mark, the mark description must state that the mark is three-dimensional in nature. This three-dimensional feature of the mark must be shown in the supporting specimens of use, in order for the drawing to comprise a substantially exact representation of the mark as actually used. Conversely, a specimen depicting a three-dimensional representation of a mark 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.*, 529 U.S. 205, 212, 54 USPQ2d 1065, 1068

(2000); *In re Slokevage*, 441 F.3d 957, 962, 78 USPQ2d 1395, 1399 (Fed. Cir. 2006); TMEP §1202.02(b)(i). See TMEP §§1202.02(b) and 1202.02(b)(i) regarding distinctiveness of product design trade dress. 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.*, 529 U.S. 205, 212-13, 54 USPQ2d 1065, 1068-69 (2000); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 773-75, 23 USPQ2d 1081, 1085-86 (1992). See TMEP §§1202.02(b) and 1202.02(b)(ii) regarding distinctiveness of product packaging trade dress. 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 under §1(c) or §1(d) of the Trademark Act, 15 U.S.C. §§1051(c) or (d). However, if appropriate, the examining attorney has discretion to issue this refusal before a specimen is submitted. *SeeIn re Mars, Inc*., 105 USPQ2d 1859 (TTAB 2013).

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) 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'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. 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. *See In re Mars, Inc*., 105 USPQ2d 1859.

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.*, 529 U.S. 205, 212-213, 54 USPQ2d 1065, 1068-1069 (2000); *In re Slokevage*, 441 F.3d 957, 962, 78 USPQ2d 1395, 1399 (Fed. Cir. 2006); TMEP §1202.02(b)(i). See TMEP §§1202.02(b) and 1202.02(b)(i) regarding distinctiveness of product design trade dress. 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 §§1, 2, and 45 of the Trademark Act. 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.*, 529 U.S. 205, 212-13, 54 USPQ2d 1065, 1068-69 (2000); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 773-75, 23 USPQ2d 1081, 1085-86 (1992). See TMEP §§1202.02(b) and 1202.02(b)(ii) regarding distinctiveness of product packaging trade dress. Because a specimen of use is not required prior to registration in these cases, it is appropriate for the examining attorney to issue the refusal where the mark on its face, as shown on the drawing and described in the description of the mark, 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)–1202.02(a)(viii) regarding functionality.

1202.02(f) Identification of Goods/Services in Trade Dress Applications

1202.02(f)(i) Product Design

Trade dress includes the three-dimensional design or configuration of the product itself. In such cases, the drawing usually depicts the item listed in the identification of goods (e.g., the drawing shows a three-dimensional design of a guitar and the goods are "guitars"). However, sometimes the identification of goods/services in a product-design application includes different or unrelated products or services that are, on their face, inconsistent with the product design depicted on the drawing (e.g., the drawing shows a three-dimensional design of a guitar and the identification includes "drums and pianos" or "retail music stores"). This presents an issue of "inconsistent goods." In rare cases, slight variations are acceptable if the products have a "consistent overall look" such that the changes do not alter the distinctive characteristics and the trade dress conveys a "single and continuing" commercial impression. *Cf. Rose Art Indus., Inc. v. Swanson*, 235 F.3d 165, 173, 57 USPQ2d 1125, 1131 (3d Cir. 2000) (quoting *Rose Art Indus., Inc. v. Raymond Geddes & Co.*, 31 F. Supp. 2d 367, 373, 49 USPQ2d 1180, 1184 (D.N.J. 1998), *rev'd on other grounds sub nom. Rose Art Indus., Inc. v. Swanson*, 235 F.3d 165, 57 USPQ2d 1125 (3d Cir. 2000)) (stating that trade dress protection for a series or line of products or packaging depends on them having a consistent overall look and remanding for proper application of the standard); *The Walt Disney Co. v. GoodTimes Home Video Corp.*, 830 F. Supp. 762, 766, 29 USPQ2d 1047, 1050 (S.D.N.Y. 1993) (setting forth the "consistent overall look" standard and applying it to a claim of protection for a line of packaging trade dress). For example, the drawing of a three-dimensional design of a guitar might reasonably reflect the consistent overall look of both guitars and ukuleles, which can share a very similar shape and appearance.

Section 1(a) Applications: Where the identification of goods/services, the description of the mark, or other evidence of record indicate that not all of the goods/services in the identification are represented in the three-dimensional mark depicted on the drawing, the examining attorney must refuse registration on the ground that the mark fails to function as a mark for the inconsistent goods/services. The statutory bases for the refusal 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, 15 U.S.C. §§1051, 1052, 1053, and 1127, for service marks.

The examining attorney must specify the inconsistent goods/services subject to refusal and request evidence and/or additional specimens to substantiate use of the mark in connection with the inconsistent goods/services. 37 C.F.R. §2.61(b). The applicant may overcome the refusal by providing (1) additional specimens showing the inconsistent goods in the shape of the design depicted on the drawing or (2) sufficient evidence that the three-dimensional product design or configuration mark functions as a source indicator in connection with the inconsistent goods/services listed in the identification. The applicant may also delete the inconsistent goods/services.

The examining attorney must also examine the drawing and the specimen to determine whether the specific three-dimensional product design mark depicted on the drawing is a substantially exact representation of the mark shown on the specimen. TMEP §807.12(a).

Section 1(b) Applications: In a §1(b) application for which no specimen has been submitted, if the examining attorney anticipates that the applicant may not be able to show proper trademark use of the product design mark for the inconsistent goods/services, the potential refusal should be brought to the applicant's attention in the first action issued by the USPTO. This advisory is given strictly as a courtesy. If information regarding the 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 after submission of the use allegation. When the record indicates that the product design would not be perceived as a mark for the inconsistent goods/services, the examining attorney may make the failure to function as a mark refusal prior to the filing of the allegation of use.

When an amendment to allege use under 15 U.S.C. §1051(c), or a statement of use under 15 U.S.C. §1051(d), is submitted in connection with a §1(b) application, the examining attorney should follow the procedures discussed above for product-design trade dress in §1(a) applications.

Section 44 and Section 66(a) Applications: A specimen is not required in a §44 or §66(a) application to show use of the proposed mark in commerce in connection with the identified goods/services. However, since these applications are otherwise examined under the same standards as applications under §1, it is appropriate for the examining attorney to refuse registration on the ground that the mark fails to function as a mark for the inconsistent goods/services where the drawing, the description of the mark, the identification of goods/services, or other evidence indicates that the identification includes goods/services that are, on their face, inconsistent with the specific three-dimensional product design depicted on the drawing (e.g., a three-dimensional toy car product design for "toy boats"). The statutory bases for the refusal 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, 15 U.S.C. §§1051, 1052, 1053, and 1127, for service marks. *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). The examining attorney must also request evidence to substantiate that the proposed mark could function as a source indicator in connection with the inconsistent goods/services.37 C.F.R. §2.61(b). This is not a requirement for specimens. To overcome the refusal, the applicant must provide evidence showing that the three-dimensional product design or configuration mark functions as a source indicator in connection with the inconsistent goods/services listed in the identification. Absent such a showing, the identification of goods/services must be amended to delete the inconsistent goods/services.

1202.02(f)(ii) Product Packaging

The three-dimensional packaging or wrapping in which a product is sold also constitutes trade dress. While a product-design drawing typically depicts the shape or configuration of the product listed in the identification of goods, product packaging can be in any shape or form that serves as packaging for the listed goods. For example, if the drawing depicts a three-dimensional computer mouse, the description of the mark states that

the trade dress is product *packaging*, and the identified goods are "cosmetics and hair brushes," it is conceivable that the goods could be sold in packaging shaped like a computer mouse, and it does not mean that the goods themselves must be in the shape of a computer mouse. However, where the drawing depicts a three-dimensional computer mouse, the description of the mark states that the trade dress is product *design or configuration*, the identified goods are "cosmetics and hair brushes," and the goods are not in the shape of a computer mouse, this presents a potential issue of "inconsistent goods." *See*TMEP §1202.02(f)(i).

In most cases, the specific three-dimensional product packaging depicted on the drawing houses the product being sold (e.g., the drawing shows a three-dimensional bottle and the goods are "wine"). However, in rare cases, the identification of goods may include products (or services) that appear, on their face, to be inconsistent with the type of packaging design depicted on the drawing (e.g., a drawing showing a three-dimensional bottle design for "automobiles" or other "inconsistent goods" that are not likely to be sold in bottles). In such cases, where the drawing, the description of the mark, the specimen, or any other evidence of record does not support that the three-dimensional product packaging depicted on the drawing would serve as packaging for the goods, the applicant must provide sufficient evidence that the proposed trade dress serves as the actual shape of the packaging for the inconsistent goods or has a "consistent overall look" across all the goods listed in the identification. *Cf. Rose Art Indus., Inc. v. Swanson*, 235 F.3d 165, 173, 57 USPQ2d 1125, 1131 (3d Cir. 2000) (quoting *Rose Art Indus., Inc. v. Raymond Geddes & Co.*, 31 F. Supp. 2d 367, 373, 49 USPQ2d 1180, 1184 (D.N.J. 1998), *rev'd on other grounds sub nom. Rose Art Indus., Inc. v. Swanson*, 235 F.3d 165, 57 USPQ2d 1125 (3d Cir. 2000)) (stating that trade dress protection for a series or line of products or packaging depends on them having a consistent overall look and remanding for proper application of the standard); *The Walt Disney Co. v. GoodTimes Home Video Corp.*, 830 F. Supp. 762, 766, 29 USPQ2d 1047, 1050 (S.D.N.Y. 1993) (setting forth the "consistent overall look" standard and applying it to a claim of protection for a line of packaging trade dress). In this situation, the same analysis, refusal, and requirements that apply to product design also apply to product packaging. *See*TMEP §1202.02(f)(i).

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 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.

For a mark for services, if the applied-for matter would be perceived only as decoration or ornamentation when used in connection with the identified services, a refusal as nondistinctive trade dress must issue under Trademark Act §§1, 2, 3, and 45, 15 U.S.C. §§1051, 1052, 1053, and 1127. See TMEP §§1202.02 and 1202.02(b)-1202.02(b)(ii) regarding trade dress and TMEP §§1301.02–1301.02(f) 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, 1114 (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. *See, e.g.*, *In re Peace Love World Live, LLC*, 127 USPQ2d 1400, 1403 (TTAB 2018) ("The phrase 'I LOVE YOU' conveys a term of endearment comprising the bracelet and, thus, it is ornamental. It does not identify and distinguish the source of the bracelet, especially where there is so much jewelry decorated with the term I LOVE YOU in the marketplace.").

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 Hulting*, 107 USPQ2d 1175, 1177-79 (TTAB 2013) ; *In re Lululemon Athletica Can. Inc*., 105 USPQ2d 1684, 1687 (TTAB 2013) (quoting *In re Right-On Co*., 87 USPQ2d 1152, 1156 (TTAB 2008)); *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 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. Moreover, the size of the mark on clothing is only one consideration in determining the registrability of a mark. *In re Lululemon Athletica Can. Inc.*, 105 USPQ2d at 1689.

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 Peace Love World Live, LLC*, 127 USPQ2d 1400, 1403-04 (TTAB 2018) ("The ornamental nature of the proposed mark [I LOVE YOU] is corroborated by the third-party use of that phrase on bracelets and other jewelry demonstrating that consumers are accustomed to seeing similar, ornamental displays of I LOVE YOU on bracelets and other jewelry from different sources."); *In re General Tire & Rubber Co.*, 404 F.2d 1396, 1398, 160 USPQ 415, 417 (C.C.P.A. 1969) (affirming the ornamentation refusal of a mark comprising three narrow white concentric rings of approximately equal width applied to the outer surface of a dark sidewall tire; mark was a refinement of the practice, which consumers were familiar with, of whitewalls as decoration on tires); *In re Chung, Jeanne & Kim Co.*, 226 USPQ 938, 941-42 (TTAB 1985) (finding that stripe design applied to sides of sport shoes was mere refinement of the common and well-known form of ornamentation in the field of sports 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, 292-99 (TTAB 1969) (extensive evidence of record supported that cornflower design was recognized as a trademark for coffee percolators, 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.*, 290 F.2d 597, 599-600, 129 USPQ 408, 410 (C.C.P.A. 1961) (holding that repeating pattern of green lines, used to cover the entire back surface of safety paper products (e.g., checks), was 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) ownership of a U.S. registration on the Principal Register of the same mark for other goods or services based on a foreign registration under §44(e) or §66(a) of the Trademark Act for which an affidavit or declaration

of use in commerce under §8 or §71 has been accepted; (3) non-ornamental use of the mark in commerce on other goods or services; or (4) 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 under §1(c) or §1(d) of the Trademark Act, 15 U.S.C. §§1051(c) or (d), has been filed is not sufficient to show secondary source. If the applicant establishes that the proposed mark serves as an identifier of secondary source, the matter is registrable on the Principal Register.

In *In re Paramount Pictures Corp.*, 213 USPQ 1111, 1112 (TTAB 1982), the Board held that MORK & MINDY was registrable for decals because the applicant had a television series of that name and had previously registered MORK & MINDY for various goods and services, and 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. 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.

Id. at 182.

In *Paramount*, the Board stated that "[t]he 'ornamentation' of a T-shirt can be of a special nature which is [sic] inherently tells the purchasing public the source of the T-shirt, not the source of manufacture but the secondary source." 213 USPQ at 1112. 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." *Id.* 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 of origin." *Id.* at 1114.

See also In re Watkins Glen Int'l, Inc., 227 USPQ 727, 729 (TTAB 1985) (reversing the refusal and finding 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, 50 (TTAB 1975) (reversing the refusal and holding EXPO '74 registrable for handkerchiefs and T-shirts, since 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 proposed mark on various items will not establish that the proposed mark 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) (affirming the refusal to register ASTRO GODS and design for T-shirts, 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 §§1212–1212.10 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 proposed 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 proposed 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) of the Trademark Act, 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 the examining attorney to issue an ornamentation refusal where the proposed mark on its face, as shown on 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 for a mark comprising pocket-stitching design for clothing).

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 In re Peace Love World Live, LLC*, 127 USPQ2d 1400, 1403 (TTAB 2018) ("The phrase 'I LOVE YOU' conveys a term of endearment comprising the bracelet and, thus, it is ornamental. It does not identify and distinguish the source of the bracelet, especially where there is so much jewelry decorated with the term I LOVE YOU in the marketplace."); *D.C. One Wholesaler, Inc. v. Chien* , 120 USPQ2d 1710, 1716 (TTAB 2016) (finding that customers purchase products with the phrase I DC specifically because they are ornamented with the phrase in an informational manner and that, given the phrase's "significance as an expression of enthusiasm, it does not create the commercial impression of a source indicator, even when displayed on a hangtag or label"); *In re Hulting*, 107 USPQ2d 1175, 1181 (TTAB 2013) (finding that proposed mark NO MORE RINOS! conveys a political slogan devoid of source-identifying 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 Original Red Plate Co.*, 223 USPQ 836 (TTAB 1984) (YOU ARE SPECIAL TODAY for ceramic plates found to be without any source-indicating significance); *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."); *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).

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 Prods., 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, 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

Merely informational matter fails to function as a mark to indicate source and thus is not registrable because consumers would perceive such matter as merely conveying general information about the goods or services or an informational message, and not as a means to identify and distinguish the applicant's goods or services

from those of others. *See, e.g.*, *In re Brunetti*, 2022 USPQ2d 764, at *1-4 (TTAB 2022) (FUCK for various carrying cases; jewelry; sports and other carrying bags; and various retail, marketing, and advertising services for such consumer goods), *appeal docketed*, No. 23-1539 (Fed. Cir. Feb. 27, 2023); *In re Greenwood*, 2020 USPQ2d 11439 (TTAB 2020) (GOD BLESS THE USA for accent pillows, decorative centerpieces of wood, and decorative non-textile wall hangings); *D.C. One Wholesaler, Inc. v. Chien* , 120 USPQ2d 1710 (TTAB 2016)(I DC for bags, clothing, plush toys);*In re AOP LLC*, 107 USPQ2d 1644, 1655 (TTAB 2013) (AOP for wine); *In re Eagle Crest, Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010) (ONCE A MARINE, ALWAYS A MARINE for clothing); *In re Aerospace Optics, Inc.*, 78 USPQ2d 1861 (TTAB 2006) (SPECTRUM for illuminated pushbutton switches); *In re Volvo Cars of N. Am., Inc.*, 46 USPQ2d 1455 (TTAB 1998) (DRIVE SAFELY for automobiles); *In re Manco Inc.*, 24 USPQ2d 1938, 1942 (TTAB 1992) (THINK GREEN and design for weatherstripping and paper products); *In re Remington Prods., Inc.*, 3 USPQ2d 1714 (TTAB 1987) (PROUDLY MADE IN USA for electric shavers); *In re Tilcon Warren, Inc.*, 221 USPQ 86 (TTAB 1984) (WATCH THAT CHILD for construction material); *In re Schwauss*, 217 USPQ 361, 362 (TTAB 1983) (FRAGILE for labels and bumper stickers).

Matter may be merely informational and fail to function as a source indicator for various reasons, including one or more of the following:

The matter merely conveys general **information about the goods or services** (*see*TMEP §1202.04(a)).

The matter is a **common phrase or message** that would ordinarily be used in advertising or in the relevant industry, or that consumers are accustomed to seeing used in everyday speech by a variety of sources (*see*TMEP §1202.04(b)).

The matter is a **direct quotation, passage, or citation from a religious text** used to communicate affiliation with, support for, or endorsement of, the ideals conveyed by the religious text (*see*TMEP §1202.04(c)).

Because the function of a trademark is to identify a single commercial source for particular goods or services, if consumers are accustomed to seeing a term or phrase used in connection with goods or services from many different sources, it is likely that consumers would not view the matter as a source indicator for the goods or services. *See In re Mayweather Promotions, LLC*, 2020 USPQ2d 11298, at *1 (TTAB 2020) (citing *D.C. One Wholesaler, Inc.*, 120 USPQ2d at 1716); *In re Wal-Mart Stores, Inc.*, 129 USPQ2d 1148, 1150 (TTAB 2019). Furthermore, the presence of the "TM" or "SM" symbol on the specimen cannot transform an unregistrable designation into a registrable mark. *Univ. of Ky. v. 40-0, LLC*, 2021 USPQ2d 253, at *32-33 (TTAB 2021) (citing *In re Eagle Crest, Inc.*, 96 USPQ2d at 1231); *In re Volvo Cars of N. Am. Inc.*, 46 USPQ2d at 1461.

The critical inquiry in determining whether matter functions as a trademark or service mark is how the proposed mark would be perceived by the relevant public. *In re Vox Populi Registry Ltd.*, 25 F.4th 1348, 1351, 2022 USPQ2d 115, at *2 (Fed. Cir. 2022) ("In analyzing whether a proposed mark functions as a source identifier, the Board focuses on consumer perception." (citing *In re AC Webconnecting Holding B.V.*, 2020 USPQ2d 11048, at *3 (TTAB 2020))); *Univ . of Ky. v. 40-0, LLC*, 2021 USPQ2d 253, at *25 (citing *In re Greenwood*, 2020 USPQ2d 11439, at *2); *In re DePorter*, 129 USPQ2d 1298, 1303 (TTAB 2019) (quoting *In re Eagle Crest, Inc.*, 96 USPQ2d at 1229)); *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1827 (TTAB 2012) (noting that the critical inquiry in determining whether a mark functions as a trademark is the "commercial impression it makes on the relevant public (e.g., whether the term sought to be registered would be perceived as a mark identifying the source of the goods or merely as an informational phrase)"); *In re Remington Prods., Inc.*, 3 USPQ2d at 1715.

If there are no limitations on the goods or services in the application, the relevant consuming public comprises all potential purchasers of the goods or services. *In re Team Jesus LLC*, 2020 USPQ2d 11489, at *3 (TTAB 2020) (citing *In re Yarnell Ice Cream, LLC*, 2019 USPQ2d 265039, at *5 (TTAB 2019)); *see Univ. of Ky. v. 40-0*, LLC, 2021 USPQ2d 253, at *25 (citing *In re Mayweather Promotions, LLC*, 2020 USPQ2d 11298, at *3).

Additionally, designs that would be perceived as the equivalent of a word generally are not legally distinguishable from the word. *In re Tex. With Love, LLC*, 2020 USPQ2d 11290, at *3 (TTAB 2020) (citing *Shunk Mfg. Co. v. Tarrant Mfg. Co.*, 318 F.2d 328, 331, 137 USPQ 881, 883 (C.C.P.A. 1963); *In re Eight Ball, Inc.*, 217 USPQ 1183, 1184 (TTAB 1983)) (finding LOVE with a depiction of the Texas flag or a map of TEXAS was well-recognized as the wording TEXAS LOVE or LOVE TEXAS and would only be perceived by consumers as conveying the same widely recognized sentiment of showing pride and love for Texas). In informational matter cases, the form in which the term appears is "much less significant than the impression it conveys." *Id.* at *5 (citing *D.C. One Wholesaler, Inc.*, 120 USPQ2d at 1716; *In re Melville Corp.*, 228 USPQ 970, 971 (TTAB 1986)). Furthermore, the Trademark Trial and Appeal Board has held that an accurate pictorial representation of a word can be informational and incapable of identifying the source of an applicant's goods. *See In re Ocean Tech., Inc.*, 2019 USPQ2d 450686, at *5-6 (TTAB 2019) (holding an accurate pictorial representation of a crab simply informed prospective consumers that applicant's product was crabmeat and reinforced the informational nature of the wording surrounding the image).

If a proposed mark is merely informational, an examining attorney must issue a failure-to-function refusal. If registration is sought on the Principal Register, the statutory basis for this refusal is §§1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051–1052, 1127, for trademarks, and §§1, 2, 3, and 45, 15 U.S.C. §§1051–1053, 1127, for service marks. If registration is sought on the Supplemental Register, the statutory basis is §§23 and 45, 15 U.S.C. §§1091, 1127. In this case, an applicant cannot overcome the failure-to-function refusal on the ground that the matter is merely informational by attempting to amend the application to seek registration on the Supplemental Register or pursuant to §2(f). See TMEP §1202.04(d) regarding amending to the Supplemental Register or claiming §2(f) in response to a merely informational failure-to-function refusal.

If a proposed mark contains registrable matter, an examining attorney must require a disclaimer of the merely informational matter, unless the mark is unitary. See Trademark Act Section 6(a), 15 U.S.C. §1056(a); TMEP §§1213, 1213.01(b), 1213.02, 1213.03(a), 1213.05. Merely informational matter may be deleted from the drawing if: (1) the deletion does not result in material alteration of the mark and does not change the mark's overall commercial impression; (2) the matter to be deleted is separable from the other elements; and (3) the mark contains other registrable source-indicating matter. *See*TMEP §§807.14–807.14(a).

In support of the refusal or disclaimer requirement, the examining attorney must explain the basis for the refusal and provide evidence showing that the matter would not be perceived as a trademark or service mark that indicates a particular source of goods or services. This support may include evidence of decorative or informational use by applicant or other manufacturers with goods or services of a similar nature, or evidence of frequent use by others in connection with the sale of their own goods or services. *See*, *e.g.*, *In re Tex. With Love, LLC*, 2020 USPQ2d 11290, at *3 (noting that "the record includes many examples of third-party uses for goods that are the same as or similar to Applicant's identified goods" such that "[i]t is clear from how the term is used by multiple third parties that TEXAS LOVE merely conveys a well-recognized concept or sentiment, specifically love for or from Texas; the term does not identify the source of Applicant's goods"); *In re Team Jesus LLC*, 2020 USPQ2d 11489, at *5-6 (noting "the nature and ubiquity of the phrase TEAM JESUS, including on apparel from many sources . . . 'does not create the commercial impression of a source indicator'"; rather the "evidence as a whole shows that TEAM JESUS is a commonplace message of Christian affiliation"); *In re Wal-Mart Stores, Inc.*, 129 USPQ2d at 1153-56 (noting third-party usage in several

industries, such as in connection with products offered for sale and titles and texts of media and news articles, of the phrase INVESTING IN AMERICAN JOBS showed the public would perceive the phrase to "function not as a mark but instead as a merely informational expression of support for Amercian workers"); *D.C. One Wholesaler, Inc.*, 120 USPQ2d at 1716 (noting that "the marketplace is awash in products that display the term I DC as a prominent ornamental feature of such goods, in such a way that the display itself is an important component of the product and customers purchase the product precisely because it is ornamented with a display of the term in an informational manner, not associated with a particular source"); *In re Eagle Crest, Inc.*, 96 USPQ2d at 1230 (noting that, because consumers would be accustomed to seeing the phrase ONCE A MARINE, ALWAYS A MARINE "displayed on clothing items from many different sources, they could not view the slogan as a trademark indicating source of the clothing only in applicant"); *In re Wakefern Food Corp.*, 222 USPQ 76, 78 (TTAB 1984) (finding WHY PAY MORE! to be a common advertising slogan across a wide variety of goods and services and thus it failed to function as a service mark for supermarket services, relying on specimens that showed use of the slogan in phrases such as "Why pay more for groceries?" and "More meat for less. Why Pay More?").

However, evidence of third-party use does not need to show use of the proposed mark with goods or services to be probative of consumer perception. *In re DePorter*, 129 USPQ2d at 1302 (finding social media tweets and posts probative to show widespread non-trademark use of #MAGICNUMBER108 to identify affiliation with the Chicago Cubs' baseball team and their 2016 World Series win 108 years after their last one). As the critical focus of the refusal or disclaimer requirement is consumer perception, any evidence demonstrating widespread use of the matter in question is relevant to determining whether consumers would perceive the matter as a mark. *In re DePorter*, 129 USPQ2d at 1302 (citing TMEP §1202.04(b)).

Although the failure-to-function refusal is typically a specimen-based refusal, a refusal must be issued, regardless of the filing basis, if the evidence supports a determination that a proposed mark is merely informational and thus would not be perceived as an indicator of source. *See*TMEP §1202; *In re AC Webconnecting Holding B.V.*, 2020 USPQ2d 11048, at *7 (finding an application for registration filed pursuant to §44(e) subject to the requirement that the applied-for mark function as a mark); *In re Right-On Co.*, 87 USPQ2d 1152, 1157 (TTAB 2008) (noting the propriety of and affirming a failure-to-function ornamentation refusal in a §66(a) application).

For an application where use has been alleged, registration must be refused even if the specimen of record shows technically acceptable evidence of use. *See In re Team Jesus LLC*, 2020 USPQ2d 11489, at *5-6 (quoting *D.C. One Wholesaler, Inc.*, 120 USPQ2d at 1716) (finding the nature and ubiquity of the phrase TEAM JESUS, including on apparel from many sources, did "not create the commercial impression of a source indicator, even when displayed on a hangtag or label").

See TMEP §1202 regarding use of subject matter as a trademark, §1202.04(d) regarding response options to a merely informational failure-to-function refusal, and §1301.02(a) regarding informational matter that does not function as a service mark.

1202.04(a) General Information About the Goods or Services

Matter that only conveys general information about the applicant's identified goods or services, including highly laudatory claims of superiority, fails to function as a mark. This matter is not registrable because consumers would perceive it as imparting its ordinary meaning and not as serving to identify and distinguish the applicant's goods or services from those of others and to indicate their source. *See, e.g., In re Bos. Beer Co.*, 198 F.3d 1370, 1372-74, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999) (holding THE BEST BEER IN AMERICA "so highly laudatory and descriptive of the qualities of its product that the slogan does not and could not function as a trademark"); *In re Standard Oil Co.*, 275 F.2d 945, 947, 125 USPQ 227, 229

(C.C.P.A. 1960) (holding GUARANTEED STARTING for servicing of motor vehicles to facilitate cold-weather operation "does no more than inform the public with reasonable accuracy what is being offered" and is not a service mark); *In re Ocean Tech., Inc.*, 2019 USPQ2d 450686, at *1, *9 (TTAB 2019) (holding ALL NATURAL 100% REAL CALLINECTES CRAB GOURMET CRABMEAT PASTEURIZED and the same mark with the additional wording FROM NORTH AMERICA, which both included a design of an accurate pictorial representation of a crab, for crabmeat merely informational and not source identifying because they "just convey[ed] information about the identified crabmeat"); *In re Yarnell Ice Cream, LLC*, 2019 USPQ2d 265039, at *18 (TTAB 2019) (holding SCOOP for ice cream and frozen confections merely informational and not source identifying "because, at most, it merely informs purchasers of the serving size of the goods"); *In re TracFone Wireless, Inc.*, 2019 USPQ2d 222983 (TTAB 2019) (holding UNLIMITED CARRYOVER for telecommunications services merely informational and not source identifying because the phrase "simply provides information about the services" and applicant's manner of use underscored and illustrated that meaning); *In re Eagle Crest, Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010) ("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 T.S. Designs, Inc.*, 95 USPQ2d 1669, 1671 (TTAB 2010) (finding CLOTHING FACTS to be informational matter and not a source identifier based on the likely consumer perception of the phrase as used on a clothing label reminiscent of the "Nutrition Facts" label for food products); *In re Aerospace Optics, Inc.*, 78 USPQ2d 1861, 1864 (TTAB 2006) (finding SPECTRUM for illuminated pushbutton switches merely informational and not source identifying because the mark was used in a manner that merely informed potential purchasers of the multiple color feature of the goods); *In re Schwauss*, 217 USPQ 361, 362 (TTAB 1983) (finding FRAGILE for labels and bumper stickers merely informational and devoid of any source-identifying function because the term merely informed consumers of the fragility of the item to which the labels and stickers were attached).

Any evidence demonstrating that the public perception of the matter is merely to convey general information about the goods or services supports this refusal. In addition to dictionary or encyclopedia entries showing the meaning or significance of wording, supporting evidence may include materials (e.g., website pages, social-media pages, product fact sheets, and other promotional materials) showing the wording listed with other features of the goods/services, showing the wording being used in a manner that does not stand out from other informational text, or showing the same or similar wording commonly used in business or by other providers of similar goods or services to impart the same kind of general information.

1202.04(b) Widely Used Messages

Matter that merely conveys ordinary, familiar, or generally understood concepts or sentiments, as well as social, political, religious, or similar informational messages in common use, would not be perceived as indicating source and thus is not registrable. *In re Team Jesus, LLC*, 2020 USPQ2d 11489, at *3 (TTAB 2020) (citing *In re Mayweather Promotions, LLC*, 2020 USPQ2d 11298, at *1 (TTAB 2020)). Consumers understand such widely used, commonplace messages as conveying "the ordinary concept or sentiment normally associated with [the message], rather than serving any source-indicating function." *Univ. of Ky. v. 40-0, LLC*, 2021 USPQ2d 253, at *33-34 (TTAB 2021). The more commonly a term or phrase is used in everyday speech or in an associational or affinitive manner by various sources, the less likely consumers will perceive the matter as a trademark or service mark for any goods and services. *E.g.*, *In re Greenwood*, 2020 USPQ2d 11439, at *2-3 (TTAB 2020) (citing *In re Peace Love World Live, LLC*, 127 USPQ2d 1400, 1402 (TTAB 2018)); *In re DePorter*, 129 USPQ2d 1298, 1303 (TTAB 2019) (quoting *In re Hulting*, 107 USPQ2d 1175, 1177 (TTAB 2013)); *In re Wal-Mart Stores, Inc.*, 129 USPQ2d 1148, 1153 (TTAB 2019); *see also In re Volvo Cars of N. Am. Inc.*, 46 USPQ2d 1455, 1460 (TTAB 1998) (holding DRIVE SAFELY not to function as a mark when used in connection with automobiles and structural parts therefor because it would be perceived merely as an everyday, commonplace safety admonition); *In re Manco*, 24 USPQ2d

1938, 1942 (TTAB 1992) (holding THINK GREEN for products advertised to be recyclable and to promote energy conservation not to function as a mark because it merely conveys a message of environmental awareness or ecological consciousness); *cf. In re Peace Love World Live, LLC*, 127 USPQ2d 1400, 1403 (TTAB 2018) (I LOVE YOU, appearing on bracelets, would be seen as a term of endearment rather than a source-identifying trademark).

Messages that are used by a variety of sources to convey social, political, religious, or similar sentiments or ideas are likely to be perceived as an expression of support for, or affiliation or affinity with, the ideas embodied in the message rather than as a mark that indicates a single source of the goods or services. *See In re Team Jesus LLC*, 2020 USPQ2d 11489, at *6; *In re DePorter*, 129 USPQ2d at 1299. Furthermore, goods that feature such messages are typically purchased because of the expressive sentiment conveyed by the message and not because they serve as a means for the consumer to identify and distinguish the applicant's goods or services from those of others. For example, the proposed mark ONCE A MARINE, ALWAYS A MARINE, for clothing, was found not to function as a mark because the evidence showed that it was a common motto used by, and in support of, the U.S. Marines. *In re Eagle Crest, Inc.*, 96 USPQ2d at 1232. Similarly, the proposed mark NO MORE RINOS!, for various goods, including bumper stickers, signs, and t-shirts, was found not to function as a mark because the evidence showed that consumers were accustomed to seeing this well-known political slogan on these types of goods from a variety of different sources. *In re Hulting*, 107 USPQ2d at 1179. Additionally, the proposed mark TEAM JESUS for clothing and religious educational and entertainment services was held not to function as a mark because the evidence showed that due to the nature and ubiquity of the phrase, including on apparel from many sources, consumers would perceive the wording merely as a well-recognized message of Christian affiliation. *In re Team Jesus LLC*, 2020 USPQ2d 11489, at *1, *3-6. Lastly, the proposed mark FUCK, for various carrying cases, jewelry, sports and other carrying bags, and various retail, marketing, and advertising services for such consumer goods, was held not to function as a mark because substantial dictionary, third-party use on the same and other consumer and household goods, and other internet evidence showed ubiquitous use of the word in its ordinary meaning, the applicant stated "that he intend[ed] to use FUCK as the word is commonly understood," and consumers would merely perceive the term as such. *In re Brunetti*, 2022 USPQ2d 764, at *39, *43-44 (TTAB 2022), *appeal docketed*, No. 23-1539 (Fed. Cir. Feb. 27, 2023).

Derivatives or variations of widely used messages also fail to function as marks if they convey the same or similar type of information or sentiment as the original wording. *See D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d 1710, 1716 (TTAB 2016) (noting that the informational significance of I DC was "reinforced by the fact that similar expressions in the form of 'I __' have also been widely used to express such enthusiasms with respect to other places and things"); *In re Remington Prods., Inc.*, 3 USPQ2d 1714, 1715 (TTAB 1987) (finding PROUDLY MADE IN THE USA informational in nature; the addition of "Proudly" before the common phrase "Made in USA" merely added "further information about the state of mind of the manufacturer and/or its employees in connection with the production of the goods"); *In re Melville Corp.*, 228 USPQ 970, 971 (TTAB 1986) (finding BRAND NAMES FOR LESS failed to function as a mark based evidence of widespread use of similar marketing phrases, noting that "[t]he fact that applicant may convey similar information in a slightly different way than others is not determinative.").

Any evidence demonstrating that the public would perceive the wording merely as conveying the ordinary meaning of the message, or enthusiasm for, affinity with, or endorsement of the message, supports this refusal. In addition to dictionary or encyclopedia entries showing the meaning or significance of wording, supporting evidence may include materials (e.g., website pages, Internet search results lists if sufficient surrounding text is included, social-media pages, product fact sheets, and other promotional materials) showing the applicant's manner of use and the manner of use by third parties. *See, e.g., In re Wal-Mart Stores, Inc.*, 129 USPQ2d at 1153 (finding that INVESTING IN AMERICAN JOBS failed to function as a mark for various retail, grocery, and convenience store services and promoting public awareness of goods

made or assembled by American workers, because third-party product sales webpages and media/news articles showed "third parties in several industries commonly use the phrase . . . to convey the same general idea (supporting American jobs)" that applicant did); *D.C. One Wholesaler, Inc.*, 120 USPQ2d at 1716 (finding that I DC failed to function as a mark for clothing items, because the evidence showed the wording had "been widely used, over a long period of time and by a large number of merchandisers as an expression of enthusiasm, affection or affiliation with respect to the city of Washington, D.C.").

The size, location, dominance, and significance of the wording as it is used in connection with the goods or services should also be considered to determine if any of these elements further support the perception of the wording merely as an informational message rather than as indicating the source of goods or services. *In re Hulting*, 107 USPQ2d at 1179 (comparing *In re Lululemon Athletica Can. Inc.*, 105 USPQ2d 1684, 1689 (TTAB 2013)). For example, evidence of use of the wording as adornment, by either the applicant or third parties, may support a determination that a proposed mark does not convey the commercial impression of a trademark that identifies a single source. *See In re Team Jesus LLC*, 2020 USPQ2d 11489, at *5-6; *In re Hulting*, 107 USPQ2d at 1179-80; *see also D.C. One Wholesaler, Inc.*, 120 USPQ2d at 1716 (noting that the marketplace is inundated with products featuring the wording "as a prominent ornamental feature of such goods, in such a way that the display itself is an important component of the product and customers purchase the product precisely because it is ornamented with a display of the term in an informational manner, not associated with a particular source"). In addition, use of the matter in a less prominent manner than other clear source identifiers may also support the conclusion that the matter will be perceived as merely conveying an informational message. *Cf. In re Duvernoy & Sons, Inc.*, 212 F.2d 202, 101 USPQ 288 (C.C.P.A. 1954) (finding that the phrase "Consistently Superior," which appeared less prominently than appellant's trade name, was "merely an adjunct thereto, operating in the shadow thereof, to indicate to purchasers that appellant's goods are always superior in quality" and was "merely a statement of fact which should be available to anyone who feels that his products are, in fact or belief, consistently superior, and wishes to so advise the public").

1202.04(c) Matter from Religious Texts

Some proposed marks comprise direct quotations, passages, or citations from religious texts, such as the Bible, Quran, Torah, or Diamond Sutra. These quotations, passages, or citations are often used by the providers of goods or services, and by consumers, to communicate affiliation with, support for, or endorsement of, the ideals or concepts found in the religious texts in which the quotation, passage, or citation originated. Because consumers are accustomed to seeing religious references used in this manner in the marketplace, they are unlikely to perceive the matter as indicating source and instead would perceive it merely as conveying an informational message of religious affiliation, endorsement, or support for the messages in the texts. *See In re Tex. With Love, LLC*, 2020 USPQ2d 11290, at *3 (TTAB 2020); *In re Eagle Crest, Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010).

When a quotation, passage, or citation from a religious text serves as an indicator of support or affiliation and not of source, it fails to function as a mark. Thus, if the proposed mark consists, in its entirety, of this type of matter, the examining attorney must issue a failure-to-function refusal on the ground that it merely conveys an informational message of religious affiliation, endorsement, or support for the ideals or concepts conveyed in the religious text. If the quotation, passage, or citation is part of a proposed mark that also contains registrable elements, the examining attorney must require a disclaimer of the quotation, passage, or citation, if otherwise appropriate. *See* TMEP §§1202.04, 1213, 1213.02.

Given the many different translations of religious texts, it is possible that a quotation or passage from one English version of a religious text will be slightly different from the same quotation or passage in a different English translation of the same religious text. However, for purposes of the examining attorney's

determination, it is sufficient that the quotation or passage appears in any version of the relevant religious text.

To support a refusal or disclaimer requirement on this ground, the evidence must establish that the applied-for mark comprises a quotation, passage, or citation taken from a religious text and that consumers would perceive it as merely conveying affiliation with, affinity for, or endorsement of, the religious message. Evidence may include applicant's own specimens, advertising, or website, showing how the applicant uses the wording in connection with the identified goods or services, as well as the advertising or packaging of other providers of the same or similar goods or services. Any evidence showing that the use of religious matter in connection with the identified goods or services is typical of use by marketplace participants to proclaim support for, affiliation or affinity with, or endorsement of, the message may support this refusal. *See D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d 1710, 1716 (TTAB 2016). While the refusal or disclaimer may apply regardless of whether the identified goods or services themselves are religious in nature, the fact that the proposed mark is applied to religious goods or services may lend further support to the refusal or disclaimer requirement.

Sometimes a quotation or passage from a religious text has become part of common, everyday language. If the evidence shows that the average consumer would be unlikely to perceive the wording as conveying information about the applicant's religious affiliation or endorsement without additional context, the examining attorney should not issue a failure-to-function refusal based on the wording being from a religious text. Instead, the examining attorney should consider whether the wording fails to function because it conveys a widely used message. *See*TMEP §1202.04(b). The following examples illustrate this point:

The proposed mark is EYE FOR AN EYE. A review of an online search engine's results for "eye for an eye" shows that some of the results directly reference religion, but most do not. Many of the results that do not reference religion use the phrase in a discussion of justice. In addition, entering "eye for an eye" into online dictionaries returns results referencing justice, but not religion. This suggests that the wording by itself does not generally have a religious connotation without additional indications of a religious origin, and thus it should not be treated as a quotation or passage from a religious text. But the examining attorney should consider whether the available evidence supports the conclusion that the proposed mark fails to function because it is a commonplace message or otherwise merely conveys a social, political, or ideological message.

The proposed mark is EVEN THOUGH I WALK THROUGH THE VALLEY OF THE SHADOW OF DEATH, I WILL FEAR NO EVIL. A review of an online search engine's results for this phrase shows that most of the results reference religion with only a very few that do not directly mention religion. Of the results that reference religion, most specifically note that the wording is from the Bible's Psalm 23:4. Thus, the results indicate that the wording has ongoing religious connotation even without additional context, and thus the examining attorney should treat it as a direct quotation or passage from a religious text.

If the matter comprising the proposed mark is religious in nature but is not a quotation, passage, or citation from a religious text, the examining attorney should not refuse registration based on the matter being derived from a religious text. Instead, the examining attorney should consider whether it is merely informational because it conveys a widely used religious message. *See*TMEP §1202.04(b).

1202.04(d) Response Options

An applicant may respond to a merely informational failure-to-function refusal by submitting evidence demonstrating that the matter is perceived as indicating a single source for the identified goods or services. *See In re Hallicrafters Co.*, 153 USPQ 376 (TTAB 1967) (reversing the refusal to register QUALITY THROUGH CRAFTSMANSHIP for radio equipment, holding that the wording functioned as a mark because

applicant extensively advertised the slogan, using it in the manner of a trademark on the goods, and the examiner failed to show others using the wording). *But see In re Ocean Tech., Inc.*, 2019 USPQ2d 450686, at *8-9 (TTAB 2019) (three form declarations from customer/industry representatives found insufficient to show customer perception as this was "a rather small number" and it was not clear that the declarants reflected the perceptions of most relevant purchasers of applicant's crabmeat).

The amount and nature of evidence that may be sufficient to establish that the matter would be perceived as source indicator rather than merely informational is determined on a case-by-case basis. The more generalized or commonplace and widely used the matter is, the more likely it would be perceived as merely informational and the less likely it would be perceived as indicating the source of the relevant goods/services. *See Univ. of Ky. v. 40-0, LLC*, 2021 USPQ2d 253, at *34 (TTAB 2021) (citing *In re DePorter*, 129 USPQ2d 1298, 1304-05 (TTAB 2019)); *In re Ocean Tech., Inc.*, 2019 USPQ2d 450686, at *3 (quoting *In re Hulting*, 107 USPQ2d 1175, 1177 (TTAB 2013)).

Claims of long-time use or substantial sales and advertising generally do not prove recognition of the matter as a mark and will not obviate the failure-to-function refusal. *See In re Remington Prods., Inc.*, 3 USPQ2d 1714, 1715 (TTAB 1987); *In re Wakefern Food, Corp.*, 222 USPQ 76, 79 (TTAB 1984); *see also In re Ocean Tech., Inc.*, 2019 USPQ2d 450686, at *9 ("claims about [a]pplicant's sales figures and 'confidential' advertising expenditures are not supported by documentary evidence, or put into context in the relevant market, and, in any event, that type of information is more directed to the question of acquired distinctiveness rather than capability").

Similarly, submission of an otherwise acceptable specimen bearing the proposed mark, such as a hang tag or label, will not obviate the refusal because the mere fact that the matter appears on a technically good specimen does not mean that it would be perceived as a mark. *See In re Team Jesus LLC*, 2020 USPQ2d 11489, at *5-6 (TTAB 2020) (holding the nature and ubiquity of the phrase TEAM JESUS, including on apparel from many sources, did "not create the commercial impression of a source indicator, even when displayed on a hangtag or label") (quoting *D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d 1710, 1716 (TTAB 2016)). If the evidence shows that the public would not perceive the proposed mark as serving to indicate the source of the identified goods or services, it does not function as a mark and may not be registered regardless of the manner of use depicted on the specimens or the filing basis on which applicant relies. The examining attorney should not suggest that a substitute specimen be submitted or that the application be amended to an intent-to-use filing basis.

Furthermore, an applicant cannot overcome a failure-to-function refusal issued on the ground that the matter is merely informational by attempting to amend the application to seek registration on the Supplemental Register or pursuant to §2(f). *In re Ocean Tech., Inc.*, 2019 USPQ2d 450686, at *8; *see In re TracFone Wireless, Inc.*, 2019 USPQ2d 222983, at *4 (TTAB 2019). Matter that does not operate to indicate the source or origin of the identified goods or services and distinguish them from those of others does not meet the statutory definition of a trademark and may not be registered, regardless of claims of acquired distinctiveness or the register on which registration is sought. *See In re Bos. Beer Co.*, 198 F.3d 1370, 1373-74, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999) (holding THE BEST BEER IN AMERICA "is so highly laudatory and descriptive of the qualities of its product that the slogan does not and could not function as a trademark" and was incapable of acquiring distinctiveness under section 2(f)); *In re Helena Rubinstein, Inc.*, 410 F.2d 438, 441-42, 161 USPQ 606, 608-09 (C.C.P.A. 1969) (holding PASTEURIZED for face cream so highly descriptive that it failed to function as a source identifier, noting that a proposed mark "cannot properly be registered as a trademark, even on the Supplemental Register, unless it is intended primarily to indicate origin of the goods and is of such a nature that the ordinary purchaser would be likely to consider that it indicated such origin"); *D.C. One Wholesaler, Inc.*, 120 USPQ2d at 1710 (granting petition to cancel a registration on the Supplemental Register because the mark failed to function as a trademark); *In re Remington*

Prods., Inc., 3 USPQ2d at 1715 (affirming a failure-to-function refusal and denying a claim of acquired distinctiveness for PROUDLY MADE IN THE USA for electric shavers and parts, noting that applicant's "substantial sales and advertising of its product . . . does not provide recognition by the public of the subject slogan as a trademark").

See TMEP §714.05(a)(i) regarding amendment to the Supplemental Register or submission of a claim of acquired distinctiveness and §1212.02(i) regarding §2(f) claims as to incapable matter.

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, 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 Prods. Co.*, 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.*, 529 U.S. 205, 211-12, 54 USPQ2d 1065, 1068 (2000). See TMEP §1202.05(a) and cases cited therein. However, the Court of Appeals for the Federal Circuit, in *In re Forney Industries, Inc.*, 955 F.3d 940, 945, 2020 USPQ2d 10310, at *3 (Fed. Cir. 2020), stated a limited exception where a multiple-color mark may be inherently distinctive when used on product packaging, depending on the character of the color design. *See also*TMEP §1202.02(b)(ii).

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 or 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 normally are not inherently distinctive. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 211-12, 54 USPQ2d 1065, 1068 (2000) (citing *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162-63, 34 USPQ2d 1161, 1162-63 (1995)); *In re Thrifty, Inc.*, 274 F.3d 1349, 1353, 61 USPQ2d 1121, 1124 (Fed. Cir. 2001); *In re Dimarzio, Inc.*, 2021 USPQ2d 1191, at *6 (TTAB 2021); *In re Hodgdon Powder Co.*, 119 USPQ2d 1254, 1255 (TTAB 2016). Single color marks are never inherently distinctive and can only be registered upon a showing of acquired distinctiveness. *Dimarzio*, 2021 USPQ2d at *6. A multiple-color mark may be inherently distinctive when used on product packaging, depending on the character of the color design. *In re Forney Industries, Inc.*, 955 F.3d 940, 945, 2020 USPQ2d 10310, at *3 (Fed. Cir. 2020); *see also*TMEP §1202.02(b)(ii).

Generally, the examining attorney must refuse to register a color mark on the Principal Register, unless the applicant establishes that the proposed mark has acquired distinctiveness under §2(f). The examining attorney must issue this refusal in 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 of the Trademark Act, 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 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). *See In re Hodgdon Powder Co.*, 119 USPQ2d at 1255-59. If it is not distinctive, it is registrable only on the Supplemental Register. *See In re Hudson News Co.*, 39 USPQ2d 1915, 1923 (TTAB 1996) ("blue motif" applied to retail store services not registrable on Principal Register without resort to Section 2(f)), *aff'd per curiam*, 114 F.3d 1207 (Fed. Cir. 1997); *Edward Weck Inc. v. IM Inc.*, 17 USPQ2d 1142, 1145 (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 the color had become distinctive of the goods); *In re Deere & Co.*, 7 USPQ2d 1401, 1403-04 (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 established 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) (holding applied-for mark consisting of the color pink, as uniformly applied to fibrous glass residential insulation, had acquired distinctiveness); *In re Gen. Mills IP Holdings II, LLC*, 124 USPQ2d 1016, 1028 (TTAB 2017) (holding applied-for mark consisting of "the color yellow appearing as the predominant uniform background color on product packaging" for cereal had not acquired distinctiveness); *In re Lorillard Licensing Co.*, 99 USPQ2d 1312 (TTAB 2011) (holding applied-for mark consisting of "any orange text appearing on a green background," for cigarettes had not acquired distinctiveness); *In re Benetton Grp. S.p.A.*, 48 USPQ2d 1214 (TTAB 1998) (holding applied-for mark consisting of a green rectangular background design for clothing and footwear had not acquired distinctiveness); *In re Am. Home Prods. Corp.*, 226 USPQ 327 (TTAB 1985)(holding applied-for mark consisting of tri-colored, three-dimensional, circular-shaped design for analgesic and muscle relaxant tablets had acquired distinctiveness); *In re Star Pharms., Inc.*, 225 USPQ 209 (TTAB 1985) (holding applied-for mark consisting of two-colored drug capsules and multi-colored seeds or granules contained therein for methyltestosterone had acquired distinctiveness). A mere statement of long use is not sufficient. *Benetton*, 48 USPQ2d at 1216-17 (despite long use, record devoid of any evidence that the green rectangular

background design has been used, promoted, or advertised as a mark). 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*, 274 F.3d at 1353, 61 USPQ2d at 1124. *Cf. Qualitex*, 514 U.S. at 163, 34 USPQ2d at 1162-63 ("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. *See Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165-66, 34 USPQ2d 1161, 1164 (1995); *Brunswick Corp. v. Brit. Seagull Ltd.*, 35 F.3d 1527, 1530, 32 USPQ2d 1120, 1121-22 (Fed. Cir. 1994); *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1120-21, 227 USPQ 417, 419 (Fed. Cir. 1985). A color may be functional if it yields a utilitarian or functional advantage, for example, yellow or orange for safety signs. *Brunswick*, 35 F.3d 1527, 32 USPQ2d 1120 (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 Integra Biosciences Corp.*, 2022 USPQ2d 93, at *40-41 (TTAB 2022) (holding five different pastel colors for disposable pipette tips in colored rack inserts were functional as they were part of applicant's color coding scheme to ensure that customers used the proper size pipette tips on the respective pipettes); *In re Florists' Transworld Delivery Inc.*, 106 USPQ2d 1784, 1791 (TTAB 2013) (holding the color black for floral packaging functional because there was a competitive need for others in the industry to use black in connection with floral arrangements and flowers to communicate a desired sentiment or occasion, such as elegance, bereavement, or Halloween); *Saint-Gobain Corp. v. 3M Co.*, 90 USPQ2d 1425, 1446-47 TTAB 2007 (holding a deep purple shade functional for coated abrasives, because opposer had established a prima facie case that coated abrasive manufacturers had a competitive need to be able to use various shades of purple, including applicant's shade, and that "[i]n the field of coated abrasives, color serves a myriad of functions, including color coding"); *In re Ferris Corp.*, 59 USPQ2d 1587 (TTAB 2000) (holding the color pink functional for surgical wound dressings because the actual color of the goods closely resemble[d] Caucasian human skin); *In re Orange Commc'ns, Inc.*, 41 USPQ2d 1036 (TTAB 1996) (holding the colors yellow and orange functional for public telephones and telephone booths, because they are more visible in the event of an emergency under all lighting conditions); *In re Howard S. Leight & Assocs.*, 39 USPQ2d 1058 (TTAB 1996)(holding the color coral functional for earplugs, because they are 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); *Kasco Corp. v. S. Saw Serv. 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 remain in the public domain. *Brunswick*, 35 F.3d at 1533, 32 USPQ2d at 1124; *In re Florists' Transworld Delivery Inc.*, 106 USPQ2d at 1787-88; *see*TMEP §1202.02(a)(vi); *see also TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 33, 58 USPQ2d 1001, 1006 (2001) (U.S. Supreme Court discussed aesthetic functionality, distinguishing *Qualitex*, 514 U.S. 159, 34 USPQ2d 1161, as a case where "[a]esthetic functionality was the central question").

1202.05(c) Color as a Separable Element

As with all trademarks and service marks, 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 regarding background designs and shapes.

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, 61 USPQ2d 1121 (Fed. Cir. 2001); *In re Hayes*, 62 USPQ2d 1443 (TTAB 2002). Granting an application for 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 Int'l 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, 1691 (TTAB 2001) (hologram of varying shapes, sizes, content, and positions used on trading cards 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 color drawings, accompanied by: (1) a color claim naming the color(s) that are a feature of the mark; and (2) a separate statement naming the color(s) and describing where the color(s) appear and how they are used on the mark. 37 C.F.R. §2.52(b)(1). See TMEP §§807.07–807.07(g) for color mark drawings and 808–808.03(f) for description of the mark.

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

In most cases, the proposed color mark 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 or dotted lines. The broken or dotted lines inform the viewer where and how color is used on the product or product package, while at the same time

making it clear that the shape of the product, or the shape of the product 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 proposed mark is a composite mark consisting of the product shape, or the product package shape, in a particular color.

Color used on multiple goods

If the proposed color 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 the color appears, are similar in form and function so that a depiction of only one of the goods is still a substantially exact representation of the mark as used on all of the goods. For example, if the mark is the color purple used on refrigerators and freezers, a drawing of a purple freezer shown in broken lines (with a description of the mark claiming the color purple and indicating that it is used on the freezer) 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 depicted in dotted lines (with a description of the mark claiming the color pink and stating that the handle is pink) would be sufficient. Or, if the mark consists of product packaging for various food items that is always blue with a pink circle, a drawing of any one of the packages shown in dotted lines (with a description of the mark claiming the colors blue and pink and describing the location of the colors on the packaging) would be sufficient.

If the proposed color 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 of the 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, the drawing should consist of the shape of the product package shown in broken or dotted lines, with the description of the mark identifying the color(s) 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 when examining a proposed color mark for services 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 of the mark, 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, as used on the specimen, must make a separate and distinct commercial impression in order to be considered one mark. *See In re Thrifty, Inc.*, 274 F.3d 1349, 61 USPQ2d

1121 (Fed. Cir. 2001); *In re Chem. 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 mark claiming the color(s) and describing the location of the color(s).
- If an applicant who 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, store awning, and walls of the store, submits a drawing that displays the mark as a solid-colored square with a dotted peripheral outline, the application will receive a filing date. However, the examining attorney will generally require the applicant to submit a single amended drawing showing how the mark is used in connection with the services. The applicant must also submit a detailed description of the mark identifying the color and describing its placement. *Thrifty*, 274 F.3d at 1353, 61 USPQ2d at 1124. See TMEP §1202.05(c) regarding color as a separable element.
- The commercial impression of a color may change depending on the object on which it is applied. *See Thrifty*, 274 F.3d at 1353, 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 product or product package, in the manner depicted on the drawing and explained in the description of the mark, amending the color of the proposed mark will 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 is 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 letters “ABC” and a 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 alone, or some combination of these 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 Descriptions of Color Marks

The drawing of a proposed 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) and how they are used on the mark. 37 C.F.R. §2.52(b)(1). See TMEP §§807.07–807.07(g) for color mark drawings and 808–808.03(f) for description of the mark.

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 §§807.14–807.14(f) 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 Int'l Flavors & Fragrances Inc.*, 183 F.3d 1361, 51 USPQ2d 1513 (Fed. Cir. 1999); *In re Hayes*, 62 USPQ2d 1443 (TTAB 2002). See TMEP §§807.01 regarding drawing must be limited to a single mark and 1202.05(c) regarding color as a separable element.

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 proposed mark depicted on the drawing. Therefore, an applicant who applies to register a color mark must submit a specimen showing use of the color, either with a §1(a) application or 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)), in a §1(b) application. If a black-and-white specimen is submitted, the examining attorney will require a substitute specimen displaying the proposed color mark. *See*TMEP §904.02(c)(ii).

See TMEP §§904.03–904.07(b) regarding trademark specimens and 1301.04–1301.04(d) 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. *Id.* 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) Color Marks in §1(b) Applications

A color mark can never be inherently distinctive. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 211-12, 54 USPQ2d 1065, 1068 (2000) (citing *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162-63, 34 USPQ2d 1161, 1162-63 (1995)); TMEP §1202.05(a). *But see In re Forney Indus., Inc.*, 955 F.3d 940, 945, 2020 USPQ2d 10310, at *3 (Fed. Cir. 2020) (a multiple-color mark used on product packaging may be inherently distinctive, depending on the character of the color design); TMEP §§1202.02(b)(ii); 1205.05(a). Generally, 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 of the Trademark Act, 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 color 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 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)). *See*TMEP §§1102.01, 1202.02(d), 1202.03(e), 1202.05(b). 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) Color Marks in §44 or §66(a) Applications

A color mark can never be inherently distinctive. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 211-12, 54 USPQ2d 1065, 1068 (2000) (citing *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162-63, 34 USPQ2d 1161, 1162-63 (1995)); TMEP §1202.05(a). *But see In re Forney Indus., Inc.*, 955 F.3d 940, 945, 2020 USPQ2d 10310, at *3 (Fed. Cir. 2020) (a multiple-color mark used on product packaging may be inherently distinctive, depending on the character of the color design); TMEP §§1202.02(b)(ii); 1205.05(a). Generally, 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 of the Trademark Act, 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 §§1202.02(e), 1202.03(e), 1202.05(b). However, 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), 2.75(c).

1202.06 Goods in Trade

Section 45 of the Trademark Act 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*." 15 U.S.C §1127 (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, reports, boxes, and business forms), as opposed to items sold or transported in commerce for use by others, are not "goods in trade." *See In re S'holders Data Corp.*, 495 F.2d 1360, 1361, 181 USPQ 722, 723 (C.C.P.A. 1974) (finding that reports are 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 Thomas White Int'l, Ltd.*, 106 USPQ2d 1158, 1162-63 (TTAB 2013) (finding that applicant's annual report does not constitute a "good in trade," but rather "is a common and necessary adjunct to the rendering of applicant's investment management and research services, that is, it is one of the means through which it provides investment services"); *In re Ameritox Ltd.*, 101 USPQ2d 1081, 1085 (TTAB 2011) (finding no evidence that applicant was engaged in selling printed reports apart from its laboratory testing services and that the reports were part and parcel of the services); *In re MGA Ent., Inc.*, 84 USPQ2d 1743, 1746-47 (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, 446-47 (TTAB 1972) (finding that reports and printouts are 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 Am. Nat'l Tr. & Sav. Ass'n*, 118 USPQ 165, 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 [applicant] is not engaged either in printing or selling forms as commodities in trade.").

The determination of whether an applicant's identified goods comprise independent goods in trade, or are merely incidental to the applicant's primary goods and/or services, is a factual determination to be made on a case-by-case basis. *In re Thomas White Int'l, Ltd.*, 106 USPQ2d at 1161 (citing *Lens.com, Inc. v. 1-800 Contacts, Inc.*, 686 F.3d 1376, 1381-82, 103 USPQ2d 1672, 1676 (Fed. Cir. 2012)); *see In re MGA Ent., Inc.*, 84 USPQ2d at 1746. Factors to consider include "whether [applicant's good]: (1) is simply the conduit or necessary tool useful only to obtain applicant's [primary goods and/or] services; (2) is so inextricably tied to and associated with the [primary goods and/or] service as to have no viable existence apart therefrom; and (3) is neither sold separately from nor has any independent value apart from the [primary goods and/or] services." *In re Thomas White Int'l, Ltd.*, 106 USPQ2d at 1162 (citing *Lens.com, Inc.*, 686 F.3d at 1382, 103 USPQ2d at 1676); *see In re MGA Ent., Inc.*, 84 USPQ2d at 1746-47. None of these factors is dispositive. *Lens.com, Inc.*, 686 F.3d at 1382, 103 USPQ2d at 1676.

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 trademark 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) (holding plaster mockup of toy truck not goods in trade where there was no evidence the mockup was actually used as a toy); *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768 (TTAB 1994), *aff'd*, 108 F.3d 1392 (Fed. Cir. 1997) (holding mark not registrable for games, where purported games were advertising flyers used to promote applicant's services and had no real utilitarian function or purpose as games); *In re Douglas Aircraft Co.*, 123 USPQ 271 (TTAB 1959) (holding books, pamphlets, and brochures that served only to explain and advertise the goods in which applicant dealt were not "goods"); *cf. In re Snap-On Tools Corp.*, 159 USPQ 254 (TTAB 1968) (holding ball point pens used to promote applicant's tools were goods in trade, where they had a utilitarian function and purpose, and had been sold to applicant's franchised dealers and transported in commerce under mark); *In re United Merchs. & Mfrs., Inc.*, 154 USPQ 625 (TTAB 1967) (holding calendar used to promote applicant's plastic film constituted goods in trade, where calendar had a utilitarian function and purpose in and of itself, and had been regularly distributed in commerce for several years).

In *In re MGA Entertainment, Inc.*, 84 USPQ2d 1743, 1746 (TTAB 2007), the Trademark Trial and Appeal Board rejected applicant's argument that trapezoidal cardboard boxes for toys, games, playthings, puzzles, and laptop play units had use beyond holding the goods at the point of sale, in that the laptop play-unit box functions as an ongoing carrying case for the unit, and the puzzle box might be used to store puzzle pieces when not in use. Finding the boxes to be merely point-of-sale containers for the primary goods and not separate goods in trade, the Board stated 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 was neither any indication that the laptop computer boxes were labeled as a carrying case nor any evidence that applicant promoted the boxes as carrying cases or that children actually used 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 proposed mark only on items incidental to conducting its own business, as opposed to items intended to be used by others, the examining attorney must 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 proposed 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 must require that these items be deleted from the identification of goods before approving the mark for publication or registration.

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

In an intent-to-use application under §1(b) of the Trademark Act, 15 U.S.C. §1051(b), the question of whether a proposed mark is used on goods in trade usually does not arise until the applicant files 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)) because this issue is based on the manner in which the mark is used. However, if the identification of goods in a §1(b) 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 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. If the record indicates that the mark will not be used on goods in trade, without the need to await consideration of the specimen(s), 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 the examining attorney 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, Sections, and Supplements of Publications

1202.07(a) Marks That Identify Columns, Sections, and Supplements of Printed, Downloadable, or Recorded Publications in §1(a) Applications

Columns, sections, and supplements of a publication that are printed, downloadable, or recorded on electronic media are normally not considered to be separate "goods" or "goods in trade," unless they are sold, syndicated, or offered for syndication separate and apart from the larger publication in which they appear (see TMEP §1202.07(a)(i)), or are non-syndicated and considered "goods in trade" under the three-part test set forth in *Lens.com, Inc. v. 1-800 Contacts, Inc.*, 686 F.3d 1376, 1382, 103 USPQ2d 1672, 1676 (Fed. Cir. 2012) (see TMEP §1202.07(a)(ii) for the *Lens.com* test). *See In re The N.Y. Times Co.*, 2023 USPQ2d 392, at *18-19 & n.20, *20 (TTAB 2023); *In re Broad. Publ'ns, Inc.*, 135 USPQ 374, 375 (TTAB 1962); *Ex parte Meredith Publ'g*, 109 USPQ 426, 426 (Comm'r Pats. 1956).

Historically, absent evidence of acquired distinctiveness, non-syndicated columns and sections available in print format or on recorded media were not considered "goods in trade," based on caselaw from "a time when news or opinion columns were only available to consumers as part of the overall purchase of a particular newspaper, magazine or other type of publication in print format." *In re The N.Y. Times Co.*, 2023 USPQ2d 392, at *7-8 (citing *In re Broad. Publ'ns*, 135 USPQ at 374; *Ex parte Meredith Publ'g*, 109 USPQ at 426). However, in *In re The New York Times Co.*, the Trademark Trial and Appeal Board held that non-syndicated columns or sections can in fact be goods in trade:

> [C]hanges in the marketplace for the delivery of news and opinion content have impacted consumer perceptions of what titles of non-syndicated columns represent, leading us to conclude that the correct legal standard for determining whether a non-syndicated column is a good in trade should no longer depend on the format in which it is offered. Whether a non-syndicated column that is, for example, "printed, downloadable, or recorded on electronic media," TMEP Section 1202.07(a), is a good in trade should be analyzed using the same standard we use to assess goods in trade issues in other contexts. We therefore take the opportunity to align the standards by adopting the three-part test set forth by the U.S. Court of Appeals of the Federal Circuit in Lens.com as our new test moving forward for non-syndicated print columns or sections in printed publications or recorded media. By doing so, we now have one uniform test for analyzing "goods in trade."

2023 USPQ2d 392, at *18-19. See TMEP §1206 regarding "goods-in-trade" refusals in general and the *Lens.com* test and TMEP §1202.07(a)(ii) regarding the "goods-in-trade" refusal and the *Lens.com* test as applied to non-syndicated columns and sections of a publication.

1202.07(a)(i) Syndicated Columns and Sections in §1(a) Applications

Columns and sections of printed publications, downloadable publications, or publications recorded on electronic media that are separately sold, syndicated, or offered for syndication do constitute "goods in trade." *See In re The N.Y. Times Co.*, 2023 USPQ2d 392, at *19 n.20 (TTAB 2023). A mark that identifies a column or section that is separately syndicated or offered for syndication is registrable on the Principal Register without a claim of acquired distinctiveness under Trademark Act §2(f), 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 in §1(a) Applications

Whether a column or section of a printed publication, a downloadable publication, or a publication recorded on electronic media that is not separately sold, syndicated, or offered for syndication is separate "goods in trade" is determined by applying the three-part test set forth in *Lens.com, Inc. v. 1-800 Contacts, Inc.*, 686 F.3d 1376, 1382, 103 USPQ2d 1672, 1676 (Fed. Cir. 2012). *In re The N.Y. Times Co.*, 2023 USPQ2d 392, at *18-19 (TTAB 2023).

Under the *Lens.com* test, the factors to consider when evaluating whether an applicant's non-syndicated column or section of a printed publication, downloadable publication, or publication recorded on electronic media is "goods in trade" include whether the column or section is:

(1) simply the conduit or necessary tool useful only to obtain the applicant's primary goods and/or services;
(2) so inextricably tied to and associated with the primary goods and/or service as to have no viable existence apart from them; and

(3) neither sold separately from nor have any independent value apart from the primary goods and/or services.

Lens.com, Inc., 686 F.3d at 1382, 103 USPQ2d at 1676 (citing *In re S'holders Data Corp.*, 495 F.2d. 1360, 1360-61, 181 USPQ 722, 723 (C.C.P.A. 1974); *In re MGA Ent., Inc.*, 84 USPQ2d 1743, 1746-47 (TTAB 2007); *In re Compute-Her-Look, Inc.*, 176 USPQ 445, 446-47 (TTAB 1972); *Ex parte Bank of Am. Nat'l Tr. & Sav. Ass'n*, 118 USPQ 165, 165 (Comm'r Pats. 1958)). None of these factors is dispositive. *Id*. They are evaluated in addition to "any other evidence that may be relevant to the particular case." *In re The N.Y. Times Co.*, 2023 USPQ2d 392, at *26.

If the record indicates that the mark identifies a column or section of a printed publication, a downloadable publication, or a publication recorded on electronic media that is not separately sold, syndicated, or offered for syndication, and the evidence of record fails to establish the applicant's goods as "goods in trade" under the *Lens.com* test, the examining attorney must refuse registration on the Principal Register under Trademark Act §§1, 2, and 45, 15 U.S.C. §§1051, 1052, and 1127, on the ground that the mark is not used on separate "goods in trade." *In re The N.Y. Times Co.*, 2023 USPQ2d 392, at *18-19. The applicant may respond to the refusal by submitting evidence as to the factors under the *Lens.com* test.

For example, with regard to the first factor, an applicant may show that its non-syndicated columns are not simply a conduit or necessary tool useful only in connection with obtaining or navigating the main publication in which the columns or sections appear. *See In re The N.Y. Times Co.*, 2023 USPQ2d 392, at *21 ("Applicant's columns [were not] akin to an instructional manual or brochure describing to the reader how to use or navigate the entirety of *The New York Times* print edition."); (Applicant's columns were not akin to "an annual investment report . . . [that] is a common and necessary adjunct to the rendering of applicant's investment management and research services." (quoting *In re Thomas White Int'l, Ltd.*, 106 USPQ2d 1158, 1162 (TTAB 2013))).

As to the second factor, relevant evidence to show that the column or section has a viable or separate existence apart from the main publication as a whole may include evidence showing that consumers separately seek out the columns or sections apart from the main publication, such as internet search engine results showing that the applicant's column or section may be retrieved by searching the column's or section's name. *See id.* at *21-23. Such evidence may be probative of consumer perception and consumer experience that the column or section possesses a viable existence apart from the main publication, as it shows that consumers are likely to perceive the name of each column or section as distinct from the main publication as a whole. *Id.*

Regarding the third factor, relevant evidence to show that a column or section has independent value apart from the main publication also may include the internet search engine evidence discussed in the second factor, as such evidence may show "readers recognize the columns as separate goods to such a degree that they may be searchable by name and retrieve multiple results." *Id.* at *24-25. Such internet search engine results show that "the utility of the column is more than just a section" within the main publication, and that consumers may look for and search for the name of the column to separately read the content for that column. *Id.* at *24.

Prior to *In re The New York Times Co.*, marks that identified non-syndicated columns or sections of printed publications, downloadable publications, or publications recorded on electronic media were registrable under §2(f), 15 U.S.C. §1052(f), with sufficient evidence or, if the mark had not yet acquired distinctiveness, were registrable on the Supplemental Register. Under *In re The New York Times Co.*, if the evidence of record establishes that an applicant's non-syndicated column or section of a printed publication, downloadable publication, or publication recorded on electronic media comprises "goods in trade" under the *Lens.com*

test, the mark is registrable on the Principal Register without resort to §2(f). If the evidence does not establish that it is used on "goods in trade" under the *Lens.com* test, registration may no longer be sought on the Principal Register under §2(f) or on the Supplemental Register. TMEP §1202.06(b). Accordingly, if a mark for a non-syndicated column or section of a printed publication, downloadable publication, or publication recorded on electronic media is refused on the ground that the mark is not used on separate "goods in trade," the examining attorney must not suggest that the applicant respond by claiming acquired distinctiveness or amending the application to seek registration on the Supplemental Register.

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

Because a refusal to register a mark that identifies a column or section of a printed publication, a downloadable publication, or a publication recorded on electronic media is based on whether the column or section is separately sold, syndicated, or offered for syndication, or is non-syndicated and considered "goods in trade" under the test in *Lens.com, Inc. v. 1-800 Contacts, Inc.*, 686 F.3d 1376, 1382, 103 USPQ2d 1672, 1676 (Fed. Cir. 2012), the issue ordinarily does not arise in an intent-to-use application under Trademark Act §1(b), 15 U.S.C. §1051(b), until the applicant has filed 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)). *See In re The N.Y. Times Co.*, 2023 USPQ2d 392, at *18-19 & n.20, *20 (TTAB 2023). 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, a downloadable publication, or a publication recorded on electronic media that is not separately sold, syndicated, or offered for syndication, the first Office action should include an advisory that registration may later be refused on the ground that the proposed mark is not used on separate "goods in trade." See TMEP §1202.07(a)(ii) regarding applying the *Lens.com* test to determine if an applicant's goods potentially are "goods in trade." This is done strictly as a courtesy. If the applicant is not advised about this potential ground for refusal prior to the filing of the allegation of use, 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 the examining attorney to refuse registration because the mark is not used on separate "goods in trade" where the record indicates that the mark will identify a column or section of a printed publication, a downloadable publication, or a publication recorded on electronic media that is not separately sold, syndicated, or offered for syndication and the evidence of record fails to establish the applicant's goods as "goods in trade" under the *Lens.com* test. *See In re The N.Y. Times Co.*, 2023 USPQ2d 392, at *18-19; TMEP §1202.07(a)(ii); *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

Providing an online non-downloadable publication is considered a service rather than a good. Therefore, refusal of registration on the ground that the proposed mark is not used on "goods in trade" is inappropriate. An online non-downloadable 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 used in connection with the service of providing an online non-downloadable column or section is registrable on the Principal Register without a claim of acquired distinctiveness under Trademark Act §2(f), 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)("A book title . . . identifies a specific literary work . . . and is not associated in the public mind with the publisher, printer or bookseller"); *In re MCDM Prods., LLC*, 2022 USPQ2d 227, at *4-10 (TTAB 2022) (holding the title of a role-playing game book manual unregistrable as the title of a single work); *In re Posthuma*, 45 USPQ2d 2011 (TTAB 1998) (holding the title of a live theater production unregistrable as the title of a single work); *In re Hal Leonard Publ'g Corp*., 15 USPQ2d 1574 (TTAB 1990) (holding INSTANT KEYBOARD, as used on music instruction books, unregistrable as the title of a single work); *In re Appleby*, 159 USPQ 126 (TTAB 1968) (holding the title of single phonograph record unregistrable as the title of a single work).

As noted in *In re Cooper*, there is a compelling reason why the name or title of a book cannot be a trademark, which stems from copyright law. Unlike a copyright that has a limited term, a trademark can endure for as long as the trademark is used. Therefore, once copyright protection ends, and the work falls in the public domain, others must have the right to call the work by its name. *G. & C. Merriam Co. v. Syndicate Publ'g Co.*, 237 U.S. 618, 622 (1915); *In re Cooper*, 254 F.2d at 616, 117 USPQ at 400; *Mattel, Inc. v. Brainy Baby Co.*, 101 USPQ2d 1140, 1144 (TTAB 2011). Moreover, if the work sought to be registered is not copyrighted, the public may copy it at once and would be as clearly entitled to call it by its name. *In re Cooper*, 254 F.2d at 616, 117 USPQ at 400.

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

When a title, or a portion of a title, of a single creative work appears in a composite mark with registrable matter, the title must be disclaimed, if otherwise appropriate, as an unregistrable component of the mark, unless the evidence shows use of the title on a series of creative works. See TMEP §1213.03(a) regarding disclaimer of unregistrable components.

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.

A single creative work provided in different formats is still considered a single creative work. *See, e.g.*, *In re MCDM Prods., LLC*, 2022 USPQ2d 227, at *8-9 (TTAB 2022) (holding STRONGHOLDS & FOLLOWERS the title of a single work for role-playing game book manuals offered in print and electronic formats); *Mattel, Inc. v. Brainy Baby, Co.*, 101 USPQ2d 1140, 1141, 1144 (TTAB 2011) (holding LAUGH & LEARN with design the title of a single creative work for educational materials provided in VHS and DVD formats); *In re Appleby*, 159 USPQ 126, 126, 127 n.1 (TTAB 1968) (holding HYNO-SMOKE the title of a single creative work for phonograph records and albums provided in English and Spanish).

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, 2014 (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 Cos.*, 88 USPQ2d 1095, 1102 (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, 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 (and enter a Note to the File in the record, 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. *In re Arnold*, 105 USPQ2d 1953, 1956 (TTAB 2013) . A series is not established when only the format of the work is changed, that is, the same title used on a printed version of a book and a recorded version does not establish a series. *See Mattel Inc. v. Brainy Baby Co.*, 101 USPQ2d 1140, 1143 (TTAB 2011) (finding that a program recorded on both a VHS tape and a DVD were the same creative work, and that the addition of minor enhancements in the DVD did not transform this single work into 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. Similarly, minimal variations of the same theatrical performance do not create a series. *See In re Posthuma*, 45 USPQ2d 2011, 2014 (TTAB 1998) .

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 to show that the mark was used on the other works in the series prior to the filing date of the application or the allegation of use. However, 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, 1777 (TTAB 1992) ("[T]he 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 must 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 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. *See In re Nat’l Council Books, Inc*., 121 USPQ 198, 199 (TTAB 1959) (finding “NATIONAL” to be a portion of the title “NATIONAL GARDEN BOOK”). 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, 1777 (TTAB 1992) (holding 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,” functions 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 "printed newspapers, printed books in the field of finance, pencils, and printed 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 "printed 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. *See In re Polar Music Int'l AB*, 714 F.2d 1567, 1572, 221 USPQ 315, 318 (Fed. Cir. 1983); *In re Arnold*, 105 USPQ2d 1953, 1957-60 (TTAB 2013) ; *In re First Draft, Inc.* 76 USPQ2d 1183, 1190 (TTAB 2005); *In re Peter Spirer*, 225 USPQ 693, 695 (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.

In re Arnold, 105 USPQ2d at 1958.

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. *See In re Polar Music Int'l AB*, 714 F.2d 1567, 1572, 221 USPQ 315, 318 (Fed. Cir. 1983). 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. *SeeIn re Arnold*, 105 USPQ2d 1953, 1959-60 (TTAB 2013) (holding BLATANCY fails to function as a mark because it merely identifies the name of a performer featured on applicant's musical recordings, and finding the evidence relating to control over the mark and the nature and quality of the goods conflicting and of uncertain meaning); *In re First Draft*, 76 USPQ2d 1183, 1191 (TTAB 2005) (holding pseudonym FERN MICHAELS identifies only the author and does not function as a mark to identify and distinguish a series of fictional books because the "evidence of promotion" was "indirect and rather 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, 1080 (TTAB 1989) (holding 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)). *In re Arnold*, 105 USPQ2d at 1958.

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 website associated with the series of works. *See In re First Draft*, 76 USPQ2d 1183, 1191 (TTAB 2005) , citing *In re Scholastic Inc.*, 23 USPQ2d 1774, 1777 (TTAB 1992) (holding THE MAGIC SCHOOL BUS functions 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. *See In re Polar Music Int'l AB*, 714 F.2d 1567, 1572, 221 USPQ 315, 318 (Fed. Cir. 1983) (holding the name of the musical group ABBA functions 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." *In re Arnold*, 105 USPQ2d 1953, 1958 (TTAB 2013) .

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, 431 (TTAB 1984) (holding 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, 1090-91 (TTAB 1998) (holding FURR-BALL FURCANIA, used as the principal character in a single children's book, does not 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.*, 218 USPQ 345, 347-48 (TTAB 1983) (holding 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 and there are multiple items in the identification, 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 "printed children's books, pencils, and printed 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 children's books. The use of the same mark on other non-creative matter such as the pencils and printed 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 and background designs that are not sufficiently distinctive to create a commercial impression separate from the word and/or design marks with which they are used, are not regarded as indicators of origin absent evidence of distinctiveness of the design alone. *SeeIn re Benetton Group S.p.A.*, 48 USPQ2d 1214, 1215-16 (TTAB 1998); *In re Anton/Bauer, Inc.*, 7 USPQ2d 1380, 1381 (TTAB 1988); *In re Wendy's Int'l, Inc.*, 227 USPQ 884, 885 (TTAB 1985); *In re Haggar Co.*, 217 USPQ 81, 83-84 (TTAB 1982). As stated in *In re Chem. Dynamics, Inc.*, 839 F.2d 1569, 1570, 5 USPQ2d 1828, 1829 (Fed. Cir. 1988) (citations omitted), "'[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."

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 §§1212–1212.10.

In the following cases, the evidence of distinctiveness was insufficient: *Benetton*, 48 USPQ2d at 1217 (holding green rectangular background design not inherently distinctive; evidence of acquired distinctiveness insufficient); *Anton/Bauer*, 7 USPQ2d at 1383 (holding parallelogram designs used as background for word marks not inherently distinctive; evidence of record insufficient to establish acquired distinctiveness pursuant to §2(f)); *In re Kerr-McGee Corp.*, 190 USPQ 204, 207 (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.*, 280 F.2d 169, 171, 126 USPQ 395, 397 (C.C.P.A. 1960) (finding evidence of record sufficient to show acquired distinctiveness of the design alone as a trademark for synthetic resins where use of applicant's design of a cloud and a lightning flash was always used as a background for the word "SCHENECTADY"); *In re Raytheon Co.*, 202 USPQ 317, 319-20 (TTAB 1979) (finding light-colored oval within black rectangular carrier not inherently distinctive; evidence of record 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 U.S. consumer. *See, e.g., In re Pennington Seed Co.*, 466 F.3d 1053, 80 USPQ2d 1758, 1761-62 (Fed. Cir. 2006). 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 U.S consumers.

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 Nursery v. Coe*, 131 F.2d 446, 447, 55 USPQ 315, 316 (D.C. Cir. 1942). 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.*; *accord Pennington Seed*, 80 USPQ2d at 1762.

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, a search using Internet search engines does not by itself suffice to assess whether the mark iis a varietal or cultivar. Unless a Note to the File in the record indicates that a separate search by the Trademark Law Library was conducted, the examining attorney must submit a request to the Trademark Law Library to 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**). Before any mark for live plants, agricultural seeds, fresh fruits, or fresh vegetables is approved for publication, a Note to the File must be added to the record indicating that the results of the varietal search were reviewed. In addition, the examining attorney also may 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).

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 Pennington Seed*, 80 USPQ2d at 1761-62 (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*, 55 USPQ at 316 (holding TEXAS CENTENNIAL, although originally arbitrary, has become the varietal name for a type of rose; *In re Hilltop Orchards & Nurseries, Inc.*, 206 USPQ 1034, 1035 (TTAB 1979) (affirming the refusal to register COMMANDER YORK for apple trees because it is the varietal name for the trees as evidenced by use in applicant's catalogue); *In re Farmer Seed & Nursery Co.*, 137 USPQ 231, 231-32 (TTAB 1963) (upholding the refusal to register CHIEF BEMIDJI as a trademark because it is the varietal name for a strawberry plant and noting that large expenditures of money does not elevate the term to a trademark; *In re Cohn Bodger & Sons Co.*, 122 USPQ 345, 346 (TTAB 1959) (holding BLUE LUSTRE merely a varietal name for petunia seeds as evidenced by applicant's catalogs).

Likewise, if the mark identifies the prominent portion of a varietal name, it must be refused. *In re Delta & Pine Land Co.*, 26 USPQ2d 1157 (TTAB 1993) (affirming the 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, 1239-40 (TTAB 1990) (holding that the scent of plumeria blossoms 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, are functional and not registrable. See TMEP §§1202.02(a)-1202.02(a)(viii) 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. *See In re Pohl-Boskamp GmbH & Co.*, 106 USPQ2d 1042, 1052 (TTAB 2013) (finding that peppermint scent mark for "pharmaceutical formulations of nitroglycerin" failed to function as a mark and noting the insufficiency of applicant's evidence of acquired distinctiveness

in light of evidence that the use of peppermint scent by others in the relevant marketplace (i.e., pharmaceuticals) tends to show that such scents are more likely to be perceived as attributes of ingestible products than as indicators of source)); *cf. In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985) (requiring concrete evidence that the mark is perceived as a mark to establish distinctiveness).

Flavor. Just as with a scent or fragrance, a flavor can never be inherently distinctive because it is generally seen as a characteristic of the goods. *In re Pohl-Boskamp GmbH & Co.*, 106 USPQ2d at 1048 (finding that peppermint flavor mark for "pharmaceutical formulations of nitroglycerin" failed to function as a mark); *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.* at 1650-51. Thus, an application to register a flavor "requires a substantial showing of acquired distinctiveness." *In re Pohl-Boskamp GmbH & Co.*, 106 USPQ2d at 1051-52 (noting the insufficiency of applicant's evidence of acquired distinctiveness in light of evidence that the use of peppermint flavor by others in the relevant marketplace tends to show that such flavors are more likely to be perceived as attributes of ingestible products than as indicators of source); *In re N.V. Organon*, 79 USPQ2d at 1650.

See TMEP §807.09 regarding the requirements for submitting 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, 1692-93 (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*, 59 USPQ2d at 1690-91. *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 Gen. Electric Broad. Co.*, 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 Grp. 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. *Gen. Electric Broad.* 199 USPQ at 563 (TTAB 1978). Examples of "commonplace" sound marks include 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). *In re Powermat Inc*., 105 USPQ2d 1789, 1793 (TTAB 2013) (finding battery chargers that emit "chirp" sounds slightly increasing and decreasing in pitch not inherently distinctive, and applicant's advertising only relevant in a showing of acquired distinctiveness); *Nextel Commc'ns, Inc. v. Motorola, Inc.*, 91 USPQ2d 1393 (TTAB 2009) (holding 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 (holding personal security alarm clock products that emit a sound pulse fall into the category of goods that make sound in the normal course of operation).

See TMEP §807.09 regarding the requirements for submitting applications for sound marks and §904.03(f) regarding specimens for sound marks.

1202.16 Model or Grade Designations

Model designations appear in connection with a wide variety of products, such as retaining rings, hand tools, and pens, to identify a specific style, type, or design of a product within a particular line of goods. *See In re Petersen Mfg. Co.*, 229 USPQ 466 (TTAB 1986) (noting that the following alphanumeric designations served as model numbers on the specimens, but finding the evidence of acquired distinctiveness under §2(f) sufficient for registration: 18R for a C clamp; 6LN for a locking plier with elongated jaw; 9LN for a locking plier with elongated jaw; 7CR for a locking plier with curved jaw; 6R for a C clamp; 20R for a chain clamp; 10CR for a locking plier with curved jaw; 7R for a locking plier with straight jaw; 10WR for a locking plier with wire cutter; 7WR for a locking plier with wire cutter; 5WR for a locking plier with wire cutter; RR for a locking specialty tool, namely, a pinch-off tool; 10R for a locking plier with straight jaw; 9R for a locking specialty tool, namely, a welding clamp; 8R for locking specialty tools, namely, metal clamping tools; and 11R for a C clamp); *In re Waldes Kohinoor, Inc.*, 124 USPQ 471 (TTAB 1960) (holding that 5131, 5000, and 5100 for retaining rings functioned only to differentiate one type of the applicant's retaining rings from its other types and did not function as a trademark to distinguish the applicant's goods from those of others); *Ex parte Esterbrook Pen Co.*, 109 USPQ 368 (Comm'r Pats. 1956) (holding that 2668 for pen points did not function as a mark because it was merely a style number for a particular pen point used to differentiate one pen point from other points in the product line).

Model designations also are commonly used to distinguish between different types of automobile parts within a single product line. *See In re Dana Corp.*, 12 USPQ2d 1748 (TTAB 1989) (holding that the following alphanumeric designations used in connection with vehicle parts functioned only as part numbers and not as trademarks: 5-469X; 5-438X; 5-510X; 5-515X; 5-407X; 5-279X; and 5-281X). In addition, model designations may serve the purpose of providing users with product compatibility information between goods and parts, accessories, and/or fittings for the goods. *See In re Otis Eng'g Corp.*, 218 USPQ 959, 960 (TTAB 1983) (noting that the fact that various pieces of applicant's "X" equipment for oil wells are compatible with each other tends to support the position that "X" is a style or model designation, but finding that the

specimens, advertising brochures, and affidavits when considered together demonstrate that "X" also functions as a trademark). They also facilitate ordering and tracking of goods. *Id.* (noting that the use of the same designation on various goods that work together would enable purchasers to order compatible equipment).

Grade designations are used to denote that a product has a certain level of quality within a defined range. They may also indicate that a product has a certain classification, size, weight, type, degree, or mode of manufacturing. Mere grade designations are often used by competitors within an industry, or by the general public, and do not indicate origin from a single source because their principal function is to provide information about the product to a consumer. *See* 1 Anne Gilson LaLonde, *Gilson on Trademarks* §2.03(4)(a) (Matthew Bender 2011). (Note: the use of a grade designation in the context of a certification mark is not discussed herein.)

For example, the fuel industry utilizes grade designations in the form of particular numbers to delineate different octane ratings of fuel. *See In re Union Oil Co.*, 33 USPQ 43 (C.C.P.A. 1937) (affirming the decision of the Commissioner of Patents refusing to register 76 for gasoline because the term functioned merely as a grade or quality mark to indicate either the octane rating or the Baume gravity rating and did not indicate origin). Grade designations have also been used to signify the composition or strength of various types of steel. *See Jones & Laughlin Steel Corp. v. Armco Steel Corp.* , 139 USPQ 132 (TTAB 1963) (holding that the terms 17-4PH and 17-7PH originally served only as a grade designation for stainless steel based on the composition of chromium and nickel, but finding the evidence of secondary meaning sufficient for registration). The United States Department of Agriculture (USDA) assigns grades in connection with butter to delineate between different quality levels based on flavor, aroma, and texture. *See* Agric. Mktg. Serv., U.S. Dep't of Agric., *How to Buy Butter* (Feb. 1995), **http://www.ams.usda.gov/AMSv1.0/getfile?dDocName=STELDEV3002487**. The USDA also assigns grades to other food products, such as eggs, meat, and poultry. *See* Agric. Mktg. Serv., U.S. Dep't of Agric., *Egg-Grading Manual* (July 2000), **http://www.ams.usda.gov/AMSv1.0/getfile?dDocName=STELDEV3004502**; *Inspection & Grading of Meat and Poultry: What Are the Differences?* , U.S. Dep't of Agric. (Aug. 22, 2008), **http://www.fsis.usda.gov/Fact_Sheets/Inspection_&_Grading/index.asp**.

1202.16(a) Examination of Marks with Model and Grade Designations

A trademark comprises a word, name, symbol, device, or combination thereof that is used to identify the goods of an applicant, to distinguish them from the goods of others, and to indicate the source of the goods. Trademark Act §§1-2, 45, 15 U.S.C §§1051-1052, 1127; *see*TMEP §1202. Similar to a trademark, a model or grade designation is generally comprised of numbers or letters, or a combination thereof. However, the manner of use, and resulting commercial impression imparted by the matter, differentiate a mere model or grade designation from that of a trademark (or a dual-purpose mark that is both a model or grade designation and a trademark). While letters, numbers, or alphanumeric matter may serve as both a trademark and a model or grade designation, matter used merely as a model or grade designation serves only to differentiate between different products within a product line or delineate levels of quality, and does not indicate source. *See Eastman Kodak Co. v. Bell & Howell Document Mgmt. Prods. Co.*, 994 F.2d 1569, 1576, 26 USPQ2d 1912, 1919 (Fed. Cir. 1993); *Neapco Inc. v. Dana Corp.*, 12 USPQ2d 1746, 1748 (TTAB 1989); 1 Anne Gilson LaLonde, *Gilson on Trademarks* §2.03(4)(a) (Matthew Bender 2011); J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §11.36 (4th ed. 2011).

Even though a model or grade designation seems "arbitrary" in the sense that the combination of letters, numbers, or both does not immediately describe the goods, it often does not function as a trademark. *See* Gilson LaLonde, *supra*, §2.03(4)(a). Where the model or grade designation fails to distinguish the applicant's goods from those of others or to identify the applicant as the source, the proposed mark must be refused

registration on the Principal Register under §§1, 2, and 45 for failure to function as a trademark. 15 U.S.C. §§1051-1052, 1127. However, if the mark both identifies a model or grade designation and serves as a trademark, no failure-to-function refusal should issue. *See Ex parte Eastman Kodak Co.*, 55 USPQ 361, 362 (Comm'r Pats. 1942) ("The fundamental question is not whether or not the mark as used by applicant serves to indicate grade or quality but rather whether it is or is not so used that purchasers and the public will recognize the mark as indicating the source of origin of the goods.").

In addition, the examining attorney must also consider whether the proposed mark is merely descriptive, or even generic. Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1). Grade designations often become synonymous with (and thus merely descriptive of) a classification, value, size, weight, type, degree, mode of manufacturing, or level of quality of the goods. And, more infrequently, model designations can be used in a merely descriptive manner. *See Textron, Inc. v. Omark Indus., Inc.*, 208 USPQ 524, 527-28 (TTAB 1980) (holding that model numbers which have been used in the same manner by competitors for indicating the size of the saw chains as to pitch and gauge are merely descriptive and not registrable).

1202.16(b) Identifying Model and Grade Designations in Marks

1202.16(b)(i) Model Designations

Determining whether a proposed mark is used merely as a model designation is a question of fact. *See In re Petersen Mfg. Co.*, 229 USPQ 466 (TTAB 1986) (finding that purchasers recognized the designations as trademarks in addition to functioning as model designations based on the ex parte record presented). The factual finding focuses on whether the proposed mark, as used on the specimen (and any other evidence of record), also identifies the applicant as the source of the goods or distinguishes the applicant's goods from the goods of others. Extrinsic evidence may also aid in determining whether the proposed mark functions as a source indicator. The following three considerations comprise guidelines for determining whether a proposed mark, as used on a specimen, serves merely as a model designation or whether it also functions as a source indicator.

1202.16(b)(i)(A) Stylization of Display

The stylization of display refers to the visual presentation or "look" of a proposed mark on the specimen, and takes into consideration such elements as font style and color as well as design features. In some cases, the stylization creates an impression separate and apart from that of a model designation, thereby making the designation more likely to be perceived as a trademark. In analyzing stylization of display, the examining attorney should consider whether the font or stylization of lettering in the proposed mark is unusual or relatively ordinary, and should also consider the degree of stylization. Where the stylization is minimal, the proposed mark may be more likely to be perceived as *merely* a model designation.

1202.16(b)(i)(B) Size of Proposed Mark

Size refers to the relative dimension of the proposed mark. If the proposed mark appears large in relation to any other matter, it may immediately catch the eye and make the proposed mark the focal point on the specimen. Therefore, the proposed mark would be less likely to be perceived as a mere model designation. If the proposed mark is smaller than the other matter surrounding it, however, consumers would be more likely to perceive it as merely a model designation.

1202.16(b)(i)(C) Physical Location

The physical location refers to the actual position of the proposed mark on a specimen. Although there is no prescribed location on a specimen where the proposed mark must be placed to qualify as a trademark, the physical location of matter on a specimen suggests how the mark would be perceived by consumers and whether such matter serves as a trademark or is merely a model designation. The display of a proposed mark in a prominent location on the goods themselves, or on the packaging or label, is a factor that may contribute to finding that it serves as a trademark. A proposed mark that appears in close proximity to generic or informational matter (such as the common or class name for the goods, net weight, bar code, or country of origin) is less likely to be perceived as a mark because it will be viewed together with the generic or informational matter as merely conveying information about the model of a particular product line.

1202.16(b)(ii) Grade Designations

A grade designation often indicates a standard that is common to producers or manufacturers within an industry. Determining whether a proposed mark is used *merely* as a grade designation is a question of fact. *See In re Flintkote Co.*, 132 USPQ 295, 296 (TTAB 1961) (citing *Kiekhaefer Corp. v. Willys-Overland Motors, Inc.*, 111 USPQ 105 (C.C.P.A. 1956)); J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §11.36 (4th ed. 2011). Thus, the examining attorney must supplement consideration of the application content (i.e., the drawing, the description of the mark, the identification of goods or services, and the specimen, if any), with independent research of the applicant's and competitors' websites, the Internet, and databases such as LexisNexis® to determine how the designation is used in the industry. Such research will assist in determining whether the proposed mark is used by others to convey a specific characteristic of the goods (such as value, size, type, degree, or level of quality) and, as such, has a publicly recognized meaning. For example, if the evidence shows that A, B, C, and D, or 1, 2, 3, and 4, are commonly used in an industry to represent a hierarchy of quality, a mark consisting of such a letter or number likely would not indicate source in any one producer or manufacturer. *See Shaw Stocking Co. v. Mack*, 12 F. 707, 711 (C.C.N.D.N.Y. 1882) ("It is very clear that no manufacturer would have the right exclusively to appropriate the figures 1, 2, 3, and 4, or the letters A, B, C, and D, to distinguish the first, second, third and fourth quality of his goods, respectively. Why? Because the general signification and common use of these letters and figures are such, that no man is permitted to assign a personal and private meaning to that which has by long usage and universal acceptation acquired a public and generic meaning."); 1 Anne Gilson LaLonde, *Gilson on Trademarks* §2.03(4)(a) (Matthew Bender 2011).

Where extrinsic evidence shows that matter in the proposed mark is used by competitors or members of the public to convey the same type of designation of quality, the resulting commercial impression is merely that of a grade designation with no source-identifying capability. The examining attorney should also analyze the specimen using the same considerations for model designations (i.e., stylization of display on the specimen, size of matter on the specimen, physical location on the specimen) to bolster a refusal based on a failure to function as a mark. A lack of extrinsic evidence of usage of the proposed mark as a grade designation does not necessarily foreclose a refusal, where the nature of applicant's use and the same considerations for model designations (i.e., stylization of display on the specimen, size of matter on the specimen, physical location on the specimen) indicate a grade designation.

1202.16(c) Procedures for Handling Marks with Model and Grade Designations

1202.16(c)(i) Evidentiary Considerations when Issuing Model or Grade Designation Refusals

1202.16(c)(i)(A) Model Designations

To support a refusal to register a model designation for failure to function as a mark, the examining attorney must use the applicant's specimen, along with any other relevant evidence in the application, such as the identification of goods and mark description. If available, the examining attorney should also provide additional evidence that shows that the proposed mark would be perceived merely as a model designation, such as consumers referring to the applicant's proposed mark as a model or part number when ordering the goods. Evidence that other manufacturers use similar numbering systems to identify model numbers for their goods may be submitted to show that consumers are familiar with the use of alphanumeric designations as model numbers and are consequently less likely to perceive the applicant's use of the mark as source indicating.

1202.16(c)(i)(B) Grade Designations

A refusal or requirement (such as a disclaimer requirement) on the basis that a mark comprises or includes a grade designation must be supported by relevant evidence. Where extrinsic evidence is available to show that a proposed grade designation is used by competitors within an industry and/or members of the public to convey the same meaning, the examining attorney must attach the evidence to the Office action and explain its relevance to the refusal. For example, evidence demonstrating that other manufacturers use the same or similar grading systems to identify quality levels of their own goods may be submitted with an explanation that such evidence shows that the proposed mark does not indicate origin from a single source. If no extrinsic evidence is available, the examining attorney must use the applicant's specimen, along with any other relevant evidence of record, to support a grade designation refusal for failure to function as a mark. In such situations, the examining attorney must also issue a request for relevant information (such as fact sheets, instruction manuals, and/or advertisements depicting the applicant's use of the proposed mark, and evidence of any industry use of this designation or similar designations) pursuant to 37 C.F.R. §2.61(b).

1202.16(c)(ii) Entire Mark Consists of Model or Grade Designation in §1(a) Applications

If the evidence shows that a proposed mark consists entirely of a mere model or grade designation, the examining attorney must refuse registration on the Principal Register under §§1, 2, and 45 because the proposed mark does not function as a trademark to identify and distinguish the applicant's goods from those of others and indicate the source of the goods. 15 U.S.C. §§1051-1052, 1127.

For such refusals, where appropriate, the examining attorney should advise the applicant of the various response options: (1) submitting a substitute specimen that shows the proposed mark being used as a trademark for the identified goods; (2) claiming acquired distinctiveness under §2(f) with actual evidence of distinctiveness that establishes recognition of the proposed mark as a trademark for the goods; or (3) amending the application to seek registration on the Supplemental Register. *See* Trademark Act §23, 15 U.S.C. §1091; *In re Petersen Mfg. Co.*, 229 USPQ 466, 468 (TTAB 1986) (finding letter-number combinations registrable under §2(f) for locking hand tools and stating, "there 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."); 37 C.F.R. §2.59(a); TMEP §904.05.

For marks comprising grade designations, the examining attorney must determine whether to make an additional refusal on the grounds that the mark is also merely descriptive of the goods. Trademark Act §2(e)(1), 15 U.S.C. §§1052(e)(1). Grade designations can often become synonymous with (and thus merely descriptive of) a classification, value, size, weight, type, degree, mode of manufacturing, or level of quality of the goods. Grade designations that are also the generic name of the goods are not eligible for registration on the Principal Register under §2(f) or on the Supplemental Register because they are not capable of indicating the source of the goods and must remain available to identify the relevant characteristic possessed by goods meeting such criteria. In such cases, if the applicant responds by amending the application to seek registration on the Supplemental Register, the examining attorney must issue a generic refusal under §23. In the rare situation where the applicant is the sole user of a grade designation and where the mark appears capable, the applicant should be provided with the same response options identified above for applicable model designations.

1202.16(c)(iii) Composite Mark with Model or Grade Designation in §1(a) Applications

Composite marks may comprise matter that is used as a model or grade designation in addition to other wording and/or design features. Such marks must be evaluated as a whole to determine whether they are registrable.

1202.16(c)(iii)(A) Model or Grade Designations with Arbitrary and/or Suggestive Matter

Terms used as model or grade designations that are combined with arbitrary and/or suggestive matter are generally not refused registration under Trademark Act §§1, 2, and 45, if the additional matter imparts trademark significance to the mark as a whole. Generally, no disclaimer of a portion that is a model designation need be required (unless there is evidence of descriptive or generic usage) because the composite mark creates a single unitary commercial impression and there is no need to preserve the availability of the applicant's model designation for others. However, the portion of a mark that is a grade designation must generally be disclaimed in cases where there is evidence of descriptive or generic use, to clarify the availability of the grade designation for use by others in the industry. Standard USPTO disclaimer practices would apply in such cases, including considerations of unitariness. See TMEP §§1213-1213.08(d).

1202.16(c)(iii)(B) Model or Grade Designations with Descriptive, Generic, and/or Informational Matter

Terms used merely as model or grade designations that are combined with descriptive, generic, and/or informational matter are generally refused registration under Trademark Act §§1, 2, and 45 because this type of additional matter does not diminish the mark's model or grade designation significance. In most instances involving model designations, claims of acquired distinctiveness under §2(f) and amendments to the Supplemental Register may be permissible. Additionally, in rare cases where there is no evidence of generic usage for grade designations, claims of acquired distinctiveness under §2(f) and amendments to the Supplemental Register may be permissible. In such cases, the examiner must consider standard USPTO disclaimer practice to determine whether a disclaimer of the generic and/or informational matter may be necessary. *See*TMEP §§1213-1213.08(d).

1202.16(c)(iv) Drawing and Specimen Agreement Issues in §1(a) Applications

Occasionally, the specimen will show a possible model or grade designation that is not included on the drawing and thus, the mark on the drawing and specimen will appear to disagree. *See* TMEP §807.12(d). When it is unclear whether the additional matter is a model or grade designation, the examining attorney

must refuse registration under §§1 and 45 on the ground that the specimen does not show the applied-for mark in use in commerce. 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a), 1301.04(g)(i). If the matter is not part of the mark and is merely used as a model or grade designation, the applicant may respond to the refusal by submitting the following: (1) a statement that the matter is merely a model or grade designation and (2) evidence showing use of the proposed mark with other similar notations or evidence clearly showing that the matter is merely a model or grade designation. *See* 37 C.F.R. §2.61(b); *In re Raychem Corp.*, 12 USPQ2d 1399, 1400 (TTAB 1989) (holding the mark TINEL-LOCK on the drawing to agree with the wording TR06AI-TINEL-LOCK-RING appearing on the specimen where the notation TR06AI was merely a part or stock number, as supported by a submitted brochure that explained that each letter and number in the notation represented a specific type, size, and feature of the part, and the term RING was generic for the goods); *In re Sansui Elec. Co.* , 194 USPQ 202, 203 (TTAB 1977) (holding the marks "QSE" and "QSD" on the drawing to agree with the wording "QSE-4" and "QSD-4" appearing on the specimens, where the notation "4" was merely a model number and the additional specimens showed use of the mark with various changing model numbers used to designate successive generations of equipment). In the alternative, the applicant may provide a substitute specimen showing the proposed mark depicted on the drawing. *See* 37 C.F.R. §2.59(a); TMEP §904.05. In cases where the record clearly indicates that the notation on the specimen is a model or grade designation, no specimen refusal should issue. *See In re Raychem Corp.*, 12 USPQ2d at 1400.

1202.16(c)(v) Model or Grade Designation in §1(b), §44, or §66(a) Applications

1202.16(c)(v)(A) Model Designations

Generally, the failure-to-function refusal is a specimen-based refusal. TMEP §1202. In §1(b), 44, or 66(a) applications, marks that appear to be merely model designations (either wholly comprising the mark or used with descriptive/generic/informational matter) may be refused registration for failure to function as a mark only where the drawing and mark description are dispositive of the mark's failure to function, or the record clearly and unequivocally indicates that the entire mark identifies only a model designation. *Cf. In re Right-On Co.* , 87 USPQ2d 1152, 1156-57 (TTAB 2008) (affirming a failure-to-function ornamentation refusal in a §66(a) application despite the lack of a specimen since the mark was decorative or ornamental on its face as depicted on the drawing page and described in the application). For those rare cases where a refusal issues in a §66(a) application, the examining attorney must not offer an amendment to the Supplemental Register. Applications filed under §66(a) are not eligible for registration on the Supplemental Register. 37 C.F.R. §§2.47(c), 2.75(c); TMEP §816.01; *see also*15 U.S.C. §1141h(a)(4). Otherwise, because of the lack of specimen of use, a failure-to-function refusal is inappropriate.

If upon initial examination of a §1(b) application, an examining attorney must issue an Office action for other reasons, and the proposed mark appears to be used or intended to be used merely as a model designation, the examining attorney should include a model designation failure-to-function advisory as a courtesy to the applicant. *See*TMEP §1102.01. Regardless of whether an examining attorney issues an initial advisory before the applicant files an allegation of use, the examining attorney must issue a refusal based on failure to function as a mark after the allegation of use is filed, if supported by the evidence of record. *Id.*

1202.16(c)(v)(B) Grade Designations

The examining attorney must refuse registration based on a failure to function as a mark for a mark merely comprising a grade designation (or a grade designation with descriptive/generic/informational matter) in a §1(b), 44, or 66(a) application where the evidence shows the mark is used in the industry or by the public in such a way as to clearly and unequivocally show use merely to identify a specific quality or feature of

the goods. For more information about evidence, see TMEP §1202.16(c)(i)(B). If the examining attorney can find no extrinsic evidence of such use, the procedures outlined for model designations in TMEP §1202.16(c)(v)(A) must be followed.

1202.17 Universal Symbols in Marks

The term "universal symbol" refers to a design, icon, or image that is commonly used in an informational manner and conveys a widely recognized or readily understood meaning when displayed in its relevant context. *See Webster's New World College Dictionary* 1356 (3rd ed. 1997) (defining "symbol" as "something that stands for, represents, or suggests another thing; esp., an object used to represent something abstract); *id.* at 1460 (defining "universal" as "used, intended to be used, or understood by all"). Universal symbols are typically available for use by anyone to quickly provide notice of a particular condition or to indicate a characteristic of an object or area. Thus, they appear in a variety of places, such as on road signs, near dangerous machinery, on medical apparatus, in hazardous locations, on product warning labels, or on materials connected with recycling activities. Usually, the context in which a universal symbol appears is crucial in determining the symbol's significance.

Matter that is specifically protected by statute or registered as a mark should not be considered to be a universal symbol. *See*TMEP §1205. For example, certain symbols that have a widely recognized meaning, such as the Red Cross, are subject to specific statutory protections restricting their use and may be refused under various provisions of the Trademark Act. *See*TMEP §1205.01.

The following are examples of common universal symbols:

The recycling symbol typically designates materials that are recyclable or recycled, but may also indicate that goods or services involve recycling or are otherwise environmentally friendly. *See* , *e.g.* , **Recyclenow.com**, Recycling Symbols Explained, **https://www.recyclenow.com/recycling-knowledge/packaging-symbols-explained** (accessed June 16, 2021).

The international radiation symbol indicates proximity to a source of radiation or radioactive materials. *See* , *e.g.* , U.S. Dept. of Health & Human Servs., *Examples of Radiation Signs and Symbols for Work Areas, Buildings, Transportation of Cargo* , **https://www.remm.hhs.gov/radsign.htm** (accessed April 4, 2022).

The biohazard symbol indicates the presence of pathogens or other matter that is potentially harmful or poses a health risk. *See* , *e.g.* , U.S. Department of Energy, Berkeley Lab, Biohazardous Waste Labels, **http://www2.lbl.gov/ehs/waste/pub-3095/wm_pub_3095_ch2.shtml** (accessed Aug. 14, 2017).

The universal prohibition symbol, which usually appears superimposed over another image or wording, is a visual representation of "no," "not," or "prohibited." *See* , *e.g* ., Free Signage.com, *Prohibition Signs* , **http://www.freesignage.com/prohibited_signs.php** (accessed June 16, 2021).

1202.17(a) Relevance of Universal Symbols to Examination

Universal symbols may appear as one element of a mark, or they may form an entire mark. The informational aspect of these symbols is often at odds with the functions of trademarks and service marks: to identify and distinguish one's goods or services and indicate their source. Specifically, a universal symbol may fail to function as a mark because it only imparts information, conveys an informational message, or provides ornamentation. *See*15 U.S.C. §§1051, 1052, 1053, 1127; TMEP §§1202, 1202.03, 1202.04. In addition, a universal symbol may merely describe a feature, quality, function, purpose, or characteristic of goods or services. *See*15 U.S.C. §1052(e)(1); TMEP §§1209, 1209.01(b). If a universal symbol in a mark creates a false impression about a characteristic or quality of an applicant's goods or services, the mark may be deceptive or deceptively misdescriptive. *See*15 U.S.C. §§1052(a), 1052(e)(1); TMEP §§1203.02–1203.02(g), 1209.04. As explained in TMEP §1202.17(b), however, registration of a universal symbol may be permissible in some instances.

1202.17(b) Reviewing Marks Containing Symbols

For each application, the examining attorney must determine whether the mark contains a universal symbol. Some universal symbols, such as the recycling symbol, are immediately identifiable. Others may not be, and applications for marks containing a symbol do not always identify the symbol, explain its significance, or indicate whether it is shown in a stylized or unusual form.

1202.17(b)(i) Identifying Universal Symbols in Marks

If a mark includes or consists of a symbol (or an unfamiliar symbol-like element), the examining attorney should review the application for any information the applicant may have provided about the symbol and ensure that an accurate description is included in the record. *See*TMEP §§ 808.03, 808.03(b), (d). The examining attorney may also use the mark's assigned design codes to determine the name of the symbol

and to search the Trademark database for applications and registrations that describe the symbol. *See*TMEP §104. If the design codes assigned to the mark do not accurately reflect the significant elements of the mark, the examining attorney should ensure that the design codes are updated so that the correct codes are listed. *See*TMEP §808.03(f). After identifying the symbol, the examining attorney may find additional information about it by using Internet search engines or symbol reference websites.

Even without the name of the symbol, the examining attorney may be able to find information about it by entering a textual description of it in an Internet search engine. For instance, one could find information about the recycling symbol, even without knowing the name of the symbol, by using the following textual description in a search engine query: "green curved arrows triangle." Additionally, the examining attorney could consult a symbol reference website that provides a means of searching based on a symbol's graphical characteristics. *See* Symbols.com, *Graphical Index* , **http://www.symbols.com** (accessed June 16, 2021).

In addition, the Trademark Law Library holds a number of reference books about symbols and their meaning, and its librarians are available to assist USPTO personnel in researching questions regarding the identity, significance, and use of symbols. Furthermore, under Trademark Rule 2.61(b), the examining attorney may require the applicant to provide additional information about an unfamiliar symbol in a mark. 37 C.F.R. §2.61(b).

The examining attorney's research may show that a symbol (or symbol-like element) in a mark is not a universal symbol. However, other symbols, symbol-like elements, and designs that are not universal symbols may nonetheless be perceived only as informational matter and thus fail to function as marks. In these instances, the examining attorney need not take any further action with respect to the universal symbol analysis, but should ensure that the application record contains a mark description that accurately describes the significant elements of the mark. TMEP §§808.01, 808.02, 808.03(b). The examining attorney should otherwise review the application according to standard USPTO practice and determine whether it complies with all applicable trademark statutes and rules.

1202.17(b)(ii) Marks Displaying an Unusual Depiction of a Universal Symbol

If the mark contains a universal symbol, the examining attorney must determine whether the mark displays the symbol in the usual manner or otherwise features an accurate depiction of the symbol. This may be done by comparing the symbol in the mark with any accurate depictions of the symbol the examining attorney finds while researching the symbol.

Generally, a universal symbol in a mark should be considered registrable matter if it is highly stylized, if it incorporates elements that are not usually in the symbol, or if it is integrated with other matter in the mark, and, as a result, a distinctive commercial impression separate and apart from the symbol's usual significance is created or a source-indicating unitary whole is formed. *Cf. In re LRC Prods. Ltd.*, 223 USPQ 1250, 1252 (TTAB 1984) (noting that "where designs or representations were more realistic and where the design left no doubt about the depiction of a central feature or characteristic of the goods or services," the Trademark Trial and Appeal Board has found that such designs and representations are merely descriptive); TMEP §1213.03(c) ("No disclaimer of highly stylized pictorial representations of descriptive matter should be required[,] because the design element creates a distinct commercial impression."); TMEP §1213.05(f) ("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."); TMEP §1213.05(g)(iv) ("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."). However, displaying an accurately depicted universal symbol as a replacement for a letter in a mark's literal element normally will not change the symbol's usual impression (or create a unitary whole), nor will minor alterations to the symbol, such as

slight stylizations or nondistinctive changes to color scheme or proportions. *Cf.*TMEP §§1213.03(c), 1213.05(g).

1202.17(b)(iii) Marks Displaying an Accurate Depiction of a Universal Symbol

If the mark displays the universal symbol in the usual manner, or otherwise features an accurate depiction of the symbol, the examining attorney must determine whether, in view of the identified goods or services, it is necessary to issue a refusal or disclaimer requirement based on failure to function, mere descriptiveness, deceptive misdescriptiveness, or deceptiveness grounds. *See*TMEP §§1202.17(c)(i), 1202.17(d)(i)-(d)(ii).

1202.17(c) Failure to Function

The USPTO will not register an applied-for designation unless it functions as a mark. *See*15 U.S.C. §§1051, 1052, 1053, 1127; *In re Team Jesus LLC*, 2020 USPQ2d 11489, at *2 (TTAB 2020) (quoting *In re Standard Oil Co.*, 275 F.2d 945, 947, 125 USPQ 227, 229 (C.C.P.A.1960) ("Before there can be registrability, there must be a trademark (or a service mark). . . ."); *In re Int'l Spike, Inc.*, 196 USPQ 447, 449 (TTAB1977) ("Registration presupposes the existence of a trademark to be registered."); TMEP §1202. That is, the mark must serve as an indicator of the source of the goods or services, identifying and distinguishing them from those of others. See 15 U.S.C. §1127; TMEP §1202. Not every designation that a party places on goods or packaging, or uses in connection with services, necessarily performs these source-indicating functions, regardless of the party's intentions when adopting the designation. *In re Tex. With Love, LLC*, 2020 USPQ2d 11290, at *2-3 (TTAB 2020) (quoting *In re Pro-Line Corp.*, 28 USPQ2d 1141, 1142 (TTAB 1993)); *D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d 1710, 1713 (TTAB 2016) (citing *In re Eagle Crest, Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010)); *In re Vertex Grp., LLC*, 89 USPQ2d 1694, 1701 (TTAB 2009); *Am. Velcro, Inc. v. Charles Mayer Studios, Inc.*, 177 USPQ 149, 154 (TTAB 1973).

1202.17(c)(i) Determining Whether a Universal Symbol Functions as a Source Indicator

The determination of whether a universal symbol in a proposed mark functions as a source indicator involves considering the meaning and significance of the symbol, the nature of the use of the symbol in the relevant field or marketplace, and the impression created when the symbol is used in connection with the identified goods or services. *Cf. Univ. of Ky. v. 40-0, LLC*, 2021 USPQ2d 253, at *25 (TTAB 2021) (citing *In re Greenwood*, 2020 USPQ2d 11439, at *2 (TTAB 2020)) ("The critical inquiry in determining whether a proposed mark functions as a trademark [or service mark] is how the relevant public perceives the term sought to be registered."); *In re Tex. With Love, LLC*, 2020 USPQ2d 11290, at *2 (TTAB 2020) (quoting *In re Eagle Crest, Inc.*, 96 USPQ 1227, 1229 (TTAB 2010)).

Relevant evidence of a symbol's significance and usual manner of use includes the resources referenced in TMEP §1202.17(b)(i), any other competent materials indicating the meaning of the symbol, and Internet excerpts or similar matter showing the symbol being used in a particular field or context, or in connection with the relevant goods or services.

Weighing these considerations in view of the available facts and evidence may lead the examining attorney to the conclusion that the mark does not serve as a source indicator, but instead fails to function because it (1) imparts information about the goods or services (*see*TMEP §1202.17(c)(i)(A)), (2) conveys an informational message (though not necessarily about the goods or services themselves) (*see*TMEP §1202.17(c)(i)(A)), or (3) serves only as ornamentation on the goods or services (*see*TMEP §1202.17(c)(i)(B)).

1202.17(c)(i)(A) Informational Universal Symbols

Universal Symbols that Impart Information About the Goods or Services

Merely informational matter is not registrable as a trademark or service mark. *See* TMEP §1202.04. When a universal symbol in a mark is used in its usual context or field, or with relevant goods or services, it will likely impart its generally recognized meaning and thus perform only an informational function, rather than serve to identify any single source of the goods or services. *Cf. In re Ocean Tech., Inc.* , 2019 USPQ2d 450686, at *1, *9 (TTAB 2019) (holding the mark ALL NATURAL 100% REAL CALLINECTES CRAB GOURMET CRABMEAT PASTEURIZED and the same mark with the additional wording FROM NORTH AMERICA, which both included a design of an accurate pictorial representation of a crab, failed to function as marks for crabmeat);*In re Schwauss*, 217 USPQ 361, 362-63 (TTAB 1983) (holding the mark FRAGILE appearing in a "jarred or broken" stylization failed to function as a mark for labels and bumper stickers); TMEP §1202.04(a). For instance, because the biohazard symbol commonly appears on items to indicate the presence of hazardous materials, the symbol is unlikely to function as a trademark on goods such as containers for disposing of medical waste. *See , e.g. , Graphic Products, Biohazard Signs* , **https://www.graphicproducts.com/biohazard-signs/?page=1** (accessed June 16, 2021).

In these circumstances, the symbol's position, prominence, and surrounding context on the specimen of use will not be as significant in the analysis, because the symbol will function only as informational matter regardless of its manner of use on the specimen. *Cf. In re Yarnell Ice Cream, LLC*, 2019 USPQ2d 265039, at *18 (TTAB 2019) (affirming refusal to register SCOOP for ice cream and frozen confections "because, at most, it merely informs purchasers of the serving size of the goods"); *In re Volvo Cars of N. Am. Inc.*, 46 USPQ2d 1455, 1460-61 (TTAB 1998) (affirming refusal to register DRIVE SAFELY because "to grant exclusive rights to applicant in this ordinary and commonly used safety admonition would interfere with the rights of others in the automobile industry to freely use the familiar phrase . . . to promote safe driving and/or that purchasers can drive safely in their make of automobiles. . . ."); *In re Schwauss*, 217 USPQ at 362 ("[T]o allow registration [of stylized word FRAGILE for labels and bumper stickers] would achieve the absurd result of hampering others in their use of the common word 'fragile' on any label designed to be placed on any other object to indicate the fragility of said object."). Nonetheless, the examining attorney should analyze how the mark (and the symbol in it) is used on the specimen because it may lend further support to the failure-to-function refusal. *Cf. In re TracFone Wireless, Inc.*, 2019 USPQ2d 222983, at *2 (TTAB 2019) (affirming refusal to register UNLIMITED CARRYOVER for telecommunications services because the phrase "simply provides information about the services" and applicant's manner of use underscored and illustrated that meaning).

Sometimes a symbol is applied to goods or services outside the symbol's normal context and the symbol could therefore serve a source-indicating function. Thus, the biohazard symbol could function as a service mark for live musical-performance services, for example, because the symbol would not provide any relevant information about the services, even when encountered by someone who knows what the symbol usually means.

Universal Symbols that Convey an Informational Message

Even if a proposed mark does not directly impart information about goods or services, it may nonetheless fail to function as a mark if it merely conveys ordinary or familiar concepts or sentiments, as well as social, political, religious, or similar informational messages in common use. *Cf. In re Team Jesus, LLC*, 2020 USPQ2d 11489, at *3 (TTAB 2020) (citing *In re Mayweather Promotions, LLC*, 2020 USPQ2d 11298, at *1 (TTAB 2020)). For example, common phrases and slogans that are frequently displayed by many different parties on various products or with various services are not likely to be viewed as source indicators, even

if the matter is being used in a non-ornamental manner. *Cf. In re Mayweather Promotions*, 2020 USPQ2d 11298, at *2; *In re Wal-Mart Stores, Inc.*, 129 USPQ2d 1148, 1153 (TTAB 2019). Instead, such goods would likely be purchased for the message the phrase or slogan conveys. *Cf. In re Wal-Mart Stores*, 129 USPQ2d at 1152. See TMEP §1202.04 regarding marks consisting of informational matter.

Likewise, when certain commonly used universal symbols appear on goods such as clothing, fashion accessories, and household items, they would likely be perceived as conveying an informational message and the goods featuring these symbols would likely be purchased for that reason. For example, evidence may show that when the recycling symbol appears on the upper-left chest area of a t-shirt, those encountering the shirt are likely to assume that it indicates support for recycling or environmental causes in general. Or evidence may support the conclusion that a peace symbol used on t-shirts or stickers likely will not function as mark, because even if it is not ornamental and does not necessarily provide any particular information about the goods themselves, it is informational in the sense that it conveys a message of supporting peace.

The examining attorney may support a failure-to-function refusal in these cases by providing evidence that indicates the widely recognized meaning of the symbol, establishes that the symbol is commonly used to convey particular information, and shows that the symbol commonly appears on the goods or in connection with the services at issue or analogous goods or services. *Cf. In re Wal-Mart Stores*, 129 USPQ2d at 1153-56. Factors such as the symbol's position and prominence on the goods, as shown by the specimen of use, may also support the determination that the matter will be perceived only as conveying a message. *Cf. In re Ocean Tech., Inc.*, 2019 USPQ2d 450686, at *3. As with any other substantive refusal, the amount, type, and nature of the evidence required to support a failure-to-function refusal will vary depending on the facts of the particular application.

Although this issue is more likely to arise when universal symbols are displayed on goods, it is also possible for a universal symbol to convey an informational message when used in connection with services.

1202.17(c)(i)(B) Ornamental Universal Symbols

Matter that serves only as an ornamental feature of goods does not identify and distinguish the goods and, thus, does not function as a trademark. TMEP §1202.03. Like any other design element, universal symbols may be used ornamentally on goods such as clothing, jewelry, fashion accessories, and household items. In these instances, the symbol's position, prominence, and surrounding context on the specimen are particularly significant in determining whether the matter serves as ornamentation. For more information on the relevant considerations, see TMEP §§1202.03–1202.03(d).

The examining attorney should not suggest the usual response options for an ornamental refusal (i.e., showing secondary source, claiming acquired distinctiveness, or amending to the Supplemental Register) unless the proposed mark is capable of serving as a mark and does not also fail to function because it imparts information or conveys an informational message. *See*TMEP §1202.03.

1202.17(c)(ii) Mark Consists Entirely of a Universal Symbol that Fails to Function

If a proposed mark consists entirely of a universal symbol and the examining attorney determines that the universal symbol fails to function as a source indicator for the identified goods, the examining attorney must issue a refusal to register the mark on the Principal Register under Trademark Act Sections 1, 2, and 45. 15 U.S.C. §§1051, 1052, 1127. For service marks, the refusal is based on Trademark Act Sections 1, 2, 3, and 45. 15 U.S.C. §§1051, 1052, 1053, 1127. For applications seeking registration on the Supplemental Register,

the statutory basis for the failure-to-function refusal is Trademark Act Sections 23 and 45. 15 U.S.C. §§1091, 1127.

When issuing a failure-to-function refusal, the examining attorney must explain the particular reasons the mark does not function as a trademark or service mark and provide sufficient evidence in support of the explanation. *Cf. In re Mayweather Promotions, LLC*, 2020 USPQ2d 11298, at *4 (TTAB 2020) (finding "the [e]xamining [a]ttorney's evidence establishes not only that PAST PRESENT FUTURE is a widely used message that conveys a concept, but also that consumers are accustomed to seeing that message displayed in a non-source identifying manner on t-shirts. Taken together, these two forms of evidence strongly support a finding that PAST PRESENT FUTURE is not perceived as a mark when used in connection with t-shirts"); *In re TracFone Wireless, Inc.*, 2019 USPQ2d 222983, at *2-3 (TTAB 2019) (finding that the examining attorney's dictionary and third-party website evidence "supports a finding that UNLIMITED CARRYOVER as used on the specimen will be perceived as merely an informational slogan which conveys information about [the services] rather than as a service mark to indicate source"); TMEP §§1202, 1301.02(a). See TMEP §1202.17(b)(i) and §1202.17(c)(i) for further discussion of evidence.

1202.17(c)(ii)(A) Applications Based on Sections 1(b), 44, or 66(a)

Generally, the failure-to-function refusal is a specimen-based refusal. TMEP §§1202, 1301.04(g)(ii). However, the examining attorney may issue a failure-to-function refusal for applications based on §1(b), §44, or §66(a) if information in the application record or other available evidence is dispositive of the failure of the relevant matter to function as a mark. *See*TMEP §§1202, 1301.04(g)(ii).

If the examining attorney is otherwise issuing an Office action and anticipates refusing a mark in a §1(b) application on failure-to-function grounds once the applicant submits a specimen with an allegation of use, the examining attorney should advise the applicant of the potential refusal. TMEP §§1202, 1301.04(g)(ii). If possible, this should be done in the initial Office action. However, failure to provide an advisory does not preclude an examining attorney from later refusing registration. *Id.*

1202.17(c)(ii)(B) Applicant's Response to Refusal

If a proposed mark fails to function because it consists of a universal symbol that is informational or that conveys an informational message, the examining attorney should not suggest that the applicant respond by claiming acquired distinctiveness or amending the application to seek registration on the Supplemental Register. *See In re Ocean Tech., Inc.*, 2019 USPQ2d 450686, at *8;(TTAB 2019); *see also*TMEP §1202.04(d). The relevant issue is not whether the proposed mark is distinctive but whether it question even functions as a mark. *See In re TracFone Wireless, Inc.*, 2019 USPQ2d 222983, at *4 (TTAB 2019) ("Matter that does not operate to indicate the source or origin of the identified services and distinguish them from those of others does not meet the statutory definition of a [trademark or] service mark and may not be registered, regardless of claims of acquired distinctiveness."); *In re Wakefern Food Corp.*, 222 USPQ 76, 79 (TTAB 1984) (agreeing with the examining attorney that "evidence of distinctiveness under Section 2(f) of the Act is irrelevant to the issue of whether the subject phrase [at issue] functions as a technical service mark"). Therefore, neither a claim of acquired distinctiveness under Trademark Act Section 2(f) nor an amendment to the Supplemental Register is a proper response to the refusal. *See*TMEP §1202.04(d). Furthermore, allowing registration in these instances, either on the Principal Register under Section 2(f) or on the Supplemental Register, would inhibit others from using merely informational matter that should be freely available to use. See TMEP §1202.04 regarding marks consisting of merely informational matter.

In addition, the examining attorney should not suggest that the applicant submit a substitute specimen or amend to an intent-to-use filing basis in these cases. *See In re Team Jesus LLC*, 2020 USPQ2d 11489, at *5-6 (TTAB 2020) (quoting *D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d 1710, 1716 (TTAB 2016)); *see also*TMEP §1202.04(d). If the mark is informational or conveys an informational message, the applicant likely will be unable to provide a specimen showing proper trademark or service mark use. The applicant may amend the application to an intent-to-use basis, but it likely will only temporarily overcome the refusal, given that a specimen showing proper trademark or service mark use is required before a registration may issue. *See*TMEP §1103. The examining attorney must review any substitute specimen submitted to confirm that the refusal should be maintained.

Finally, if a proposed mark consisting of a universal symbol fails to function as a mark only because it is used in an ornamental manner on the specimen, and it is possible the proposed mark could function as a mark if used in a trademark manner, then all of the response options discussed immediately above should be suggested by the examining attorney, if otherwise appropriate. See TMEP §§1202.03-1202.03(e) regarding refusing marks on the basis of ornamentation and appropriate response options.

1202.17(c)(iii) Mark Includes a Universal Symbol that Fails to Function

If a universal symbol fails to function as a source indicator because it is informational or conveys an informational message, and it appears along with other non-source-indicating matter, the examining attorney must issue a failure-to-function refusal. *See*TMEP §1202.17(c)(ii).

If a universal symbol fails to function as a source indicator because it is informational or conveys an informational message, and it appears in a non-unitary manner with other registrable matter that is arbitrary, fanciful, suggestive, or otherwise source-indicating, the examining attorney must require a disclaimer of the universal symbol. *See* Trademark Act Section 6(a), 15 U.S.C. §1056(a); TMEP §§1213, 1213.01(b), 1213.02, 1213.03(a). The examining attorney should not suggest that the applicant claim acquired distinctiveness in part as to the symbol. See TMEP §1202.17(c)(ii)(B).

An applicant may also delete a purely informational universal symbol that appears along with other registrable matter, provided the symbol is separable from the other matter and the deletion does not materially alter the commercial impression of the mark. *See*TMEP §807.14(a).

1202.17(d) Other Relevant Refusals

The examining attorney should also consider the following potential grounds for refusal when reviewing a mark featuring a universal symbol. In addition to those discussed below, the examining attorney should determine whether there is a sufficient basis for any other relevant refusals (e.g., a §2(d) refusal).

1202.17(d)(i) Merely Descriptive

Often, when the examining attorney has determined that a universal symbol fails to function because it only provides information about the goods or services, the available evidence will also support a refusal (or a disclaimer requirement) under Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1), based on mere descriptiveness.

If a mark consists of a merely descriptive universal symbol and other descriptive, generic, or otherwise non-source-indicating matter, then the mark is merely descriptive in its entirety and the examining attorney must issue a refusal under §2(e)(1). If a mark consists of a merely descriptive universal symbol, along with other arbitrary, fanciful, or suggestive matter, the examining attorney must require a disclaimer of the

universal symbol unless the composite mark creates a unitary commercial impression. See Trademark Act §6(a), 15 U.S.C. §1056(a); TMEP §§1213, 1213.01(b), 1213.02, 1213.03(a).

When both a §2(e)(1) and a failure-to-function refusal are issued, the examining attorney should not suggest that the applicant claim acquired distinctiveness or amend to the Supplemental Register. For more information, see TMEP §1202.17(c)(ii)(B).

1202.17(d)(ii) Deceptive or Deceptively Misdescriptive

The inclusion of a universal symbol in a mark may lead consumers to believe the goods or services have a particular characteristic or quality. For instance, evidence may show that a mark featuring the recycling symbol would lead to a perception that the goods to which the mark is applied are recyclable or are made of recycled materials.

If the relevant goods or services do not have the relevant characteristic or quality, then the mark may be deceptive under Trademark Act Section 2(a) or deceptively misdescriptive under Section 2(e)(1). In those instances, the examining attorney should follow the same procedures as would apply to any deceptive or deceptively misdescriptive mark. For more information, see TMEP §§ 1203.02–1203.02(g) and 1209.04.

1202.17(e) Universal Symbols Commonly Appearing in Marks

The universal symbols discussed below frequently appear in applied-for marks. Some of these symbols are so widely used and well known that they will have only non-trademark significance when used with almost any good or service in any context or field. Others will fail to function as source indicators only when used with particular goods or services. Nonetheless, all of these symbols could function as source indicators if they are displayed in the mark in a way that creates a distinct commercial impression or forms a source-indicating unitary whole. *See*TMEP §1202.17(b)(ii). Like any design element, all of these symbols may be used in an ornamental manner on goods and, if so, should be refused accordingly. Finally, depending on the particular facts and available evidence, other grounds for refusal may apply to marks containing these symbols (e.g., Section 2(e)(1), Section 2(d), Section 2(a)).

1202.17(e)(i) Awareness Ribbon Symbols

The awareness ribbon symbol is a representation of a ribbon intended to signify and promote awareness of a particular cause. The specific cause represented depends on the color or color scheme displayed. *See, e.g.* , Support Store, *Cause Awareness By Color* , **https://www.supportstore.com/cause-awareness-by-color.html** (accessed June 16, 2021). For example, the pink awareness ribbon is commonly associated with awareness of breast cancer and related causes. *See id.* Yellow ribbons are frequently used to indicate support of the armed forces. *See id.* And red ribbons are typically associated with awareness of HIV/AIDS or heart disease. *See id.*

Due to the widespread use of the awareness ribbon in various colors to indicate support for, or raise awareness of, a cause, the awareness ribbon shape by itself will not function as a source indicator. However, the examining attorney must evaluate an awareness ribbon symbol in a mark as a whole, including the color, color scheme, pattern, or other matter inside of the ribbon, to determine whether it functions as a source indicator.

Some awareness ribbons have become so widely used and well known that they are unlikely to function as a mark when used in connection with almost any goods or services. These include ribbons in pink, yellow, red, and possibly others. The pink awareness ribbon, for example, has become the universal symbol of breast cancer awareness. This symbol appears in connection with the charity activities of numerous organizations and is used on a wide variety of products, including clothing, jewelry, sports equipment, and household items. Often, when it is used, it has informational or ornamental characteristics, or both. Thus, it is more likely that consumers, upon encountering the pink ribbon symbol on a product, would view it as informational or decorative regardless of the particular context or use. For instance, evidence may support the conclusion that, when a pink ribbon is displayed on the packaging for a household appliance, the ribbon would likely be viewed as indicating that the product has some connection to a breast cancer-related cause (e.g., some portion of the proceeds from the sale of the appliance would go towards breast cancer research). Or evidence may establish that the pink ribbon symbol displayed on a shirt would be viewed as conveying the message that the wearer is a supporter of breast cancer survivors or breast cancer causes in general. Even when an awareness ribbon symbol features a particular color, color scheme, or pattern that is not commonly used or widely recognized, the examining attorney should evaluate whether the symbol is inherently distinctive.

The actions an examining attorney will take when examining a mark featuring an awareness ribbon symbol depend on which of the following categories the awareness ribbon symbol falls under:

Category 1: The awareness ribbon symbol is not displayed in the mark in a way that creates a distinct commercial impression or forms a source-indicating unitary whole. The color, color scheme, pattern, or other matter inside the awareness ribbon shape is not inherently distinctive and the evidence shows that the symbol's use by various parties in that color, color scheme, or pattern is so widespread, and its meaning so widely understood, that it will likely be perceived as only providing information or conveying an informational message when used in connection with the goods or services.

This type of awareness ribbon symbol fails to function as a mark and the examining attorney must refuse registration if the symbol forms the entire mark or appears with only other non-source-indicating matter, or disclaim the symbol if it appears with registrable matter.

Awareness ribbon symbols in this category are incapable of functioning as a mark. Thus, if the mark consists entirely of this type of symbol, claiming acquired distinctiveness under §2(f) or amending the application to seek registration on the Supplemental Register will not overcome the refusal. Likewise, a claim of acquired distinctiveness in part will not obviate a disclaimer requirement.

Awareness ribbon symbols that do not contain inherently distinctive matter inside the ribbon, and are displayed in black and white, or gray scale, because they appear in non-color mark drawings, are incapable of functioning as a mark and would be subject to the same procedures set forth above.

Examples:

Pink ribbon

Yellow Ribbon

Black-and-White or Gray Scale Ribbon

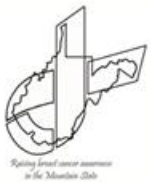
Category 2: The awareness ribbon symbol is not displayed in the mark in a way that creates a distinct commercial impression or forms a source-indicating unitary whole. The color, color scheme, pattern, or other matter inside the awareness ribbon shape is not inherently distinctive, but there is no evidence that the awareness ribbon symbol shown in the mark is widely used by various parties or that its meaning is widely understood.

In these cases, the symbol is not inherently distinctive and fails to function as a mark because, given the widespread use of awareness ribbons in various colors and patterns generally, the symbol will not be perceived as a source indicator. Thus, the examining attorney must refuse registration if the symbol forms the entire mark (or appears with other non-source-indicating matter), or require a disclaimer of the symbol if the symbol appears with registrable matter. However, the applicant may overcome the refusal by showing acquired distinctiveness based on *actual evidence* establishing recognition of the proposed mark as a source indicator, or by amending the application to seek registration on the Supplemental Register. For awareness

ribbon symbols in this category, evidence of five years' use usually will not be sufficient to show that the mark has acquired distinctiveness. See TMEP §§1212.06–1212.06(e)(iv) for information on establishing acquired distinctiveness by actual evidence. A disclaimer requirement may be obviated by claiming acquired distinctiveness in part as to the symbol based on actual evidence.

Examples:

for "promoting public awareness of domestic violence, sexual assault and child abuse"



for "surgery; and medical services, namely, treatment of breast disease"

Category 3: The matter inside the awareness ribbon shape in the mark is inherently distinctive or otherwise registrable (e.g., non-descriptive/non-informational wording, registrable design elements) and there is no evidence that the awareness ribbon shown in the mark is widely used by various parties or that its meaning is widely understood.

No refusal (or disclaimer) is necessary, as long as the awareness ribbon is not used ornamentally on the specimen, because the ribbon shape and the matter within it create a registrable unitary whole.

Examples:

for "charitable fund raising, namely, raising funds for breast cancer research and treatment"

for "educational services, namely, conducting conferences, workshops, seminars, and classes in the fields of autism and advocacy on behalf of autistic children and adults"

1202.17(e)(ii) Recycling Symbol

The recycling symbol typically appears on materials to indicate that they are recyclable or made from recycled matter. *See, e.g.* , Recyclenow.com, *Recycling Symbols Explained* , **https://www.recyclenow.com/recycling-knowledge/packaging-symbols-explained** (accessed June 16, 2021). However, the symbol is also used in connection with a wide assortment of goods and services in a variety of fields to indicate that the goods or services involve recycling or are otherwise environmentally friendly. *See id.*

Because of the widespread use of the symbol and the resulting general recognition of the symbol's significance, the symbol is not likely to function as a source indicator. Instead, the evidence will show consumers are likely to view it as merely providing information about the goods or services, in which case

a failure-to-function refusal is appropriate. Even when the symbol is displayed on clothing and fashion accessories in a manner that would normally be considered trademark use, evidence will likely show the mark will be perceived as conveying an informational message (e.g., that the wearer supports recycling or environmental awareness). *See In re Mayweather Promotions, LLC*, 2020 USPQ2d 11298, at *4 (TTAB 2020) (finding "the Examining Attorney's evidence establishes not only that PAST PRESENT FUTURE is a widely used message that conveys a concept, but also that consumers are accustomed to seeing that message displayed in a non-source identifying manner on t-shirts," which was strong evidence that the proposed mark did not function as a mark when used in connection with t-shirts.");*See In re Eagle Crest, Inc.*, 96 USPQ2d 1227, 1230 (TTAB 2010) (holding that consumers would not view the "old and familiar" slogan ONCE A MARINE, ALWAYS A MARINE as a trademark indicating the source of the applicant's clothing because they would be accustomed to seeing it displayed on clothing from many different sources, and noting that "[i]t is clear that clothing imprinted with this slogan would be purchased by consumers for the message it conveys"). The symbol will usually also have descriptive significance as applied to the relevant goods or services.

1202.17(e)(iii) Caduceus, Rod of Asclepius, and Prescription Symbol

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The caduceus and the Rod of Asclepius are commonly used to indicate that goods or services are medical in nature or otherwise relate to the medical profession. *See Webster's New World College Dictionary* 195 (3rd ed. 1997) (defining "caduceus" as "the staff of an ancient herald; esp., the winged staff with two serpents

coiled about it . . . an emblematic staff like this with either one or two serpents, used as a symbol of the medical profession"); THEFREEDICTIONARY.COM, search of "Rod of Asclepius," **https://medical-dictionary.thefreedictionary.com/Rod+of+Asclepius** (accessed June 16, 2021) (citing *Segen's Medical Dictionary*) (defining "Rod of Asclepius" as "[t]he 'correct' symbol of medicine, which is a knarled [sic] wooden staff with a single encircling snake"). The prescription symbol is frequently used in connection with prescription drugs or medicated goods, or with services relating to these items. *See Webster's New World College Dictionary* 1178 (3rd ed. 1997) (defining "Rx" as "symbol for PRESCRIPTION"). For any marks containing these symbols, the examining attorney should review the specimen, the relevant evidence, and the goods/services to determine if the mark functions as a source indicator or instead is merely informational. In those instances that the mark fails to function, there is likely also a valid basis for finding the symbol descriptive.

1202.17(e)(iv) Religious Symbols

Religious symbols, such as the Latin cross and the Star of David, may be informational or have descriptive significance when used on a variety of goods and services. For example, evidence may support the conclusion that, as used in connection with media such as books or videos, the Star of David is likely to be perceived as providing information about or describing the media's content. Or evidence may show that a Latin cross used in an advertisement for services is likely to be viewed as conveying an informational message (i.e., indicating an affiliation with Christianity). Note that a mark containing a Greek cross (i.e., an upright equilateral cross) may be subject to other refusals. *See* TMEP §1205.01.

1202.17(e)(v) Currency Symbols

When used with financial services, such as currency exchange or banking, evidence will show currency symbols, such as the dollar sign or the euro symbol, will likely be informational and merely descriptive. However, when used in connection with other types of goods or services, the evidence may show these symbols to be arbitrary or suggestive and otherwise function as a mark.

1202.17(e)(vi) Universal Prohibition Symbol

The universal prohibition symbol, which usually appears superimposed over another image or wording, is a visual representation of "no," "not," or "prohibited." *See, e.g.* , Free Signage.com, *Prohibition Signs* , **http://www.freesignage.com/prohibited_signs.php** (accessed June 16, 2021). When the prohibition symbol is superimposed over other matter, the design as a whole is unitary; thus, no disclaimer of the prohibition symbol apart from the other matter is necessary. However, the examining attorney must consider whether evidence supports the conclusion that the design as a whole (i.e., the symbol and the image it is superimposed over) fails to function as a mark or is merely descriptive (or both) and thus must be refused or disclaimed.

1202.18 Hashtag Marks

A "hashtag" is a form of metadata consisting of a word or phrase prefixed with the symbol "#" (e.g., #chicago, #sewing, and #supremecourtdecisions). Hashtags are often used on social-networking sites to identify or facilitate a search for a keyword or topic of interest. See Dictionary.com, search of "hashtag," **https://www.dictionary.com/browse/hashtag** (accessed May 27, 2021) (citing *Random House Unabridged Dictionary* as its proprietary source).

A mark consisting of or containing the hash symbol (#) or the term HASHTAG is registrable as a trademark or service mark only if it functions as an identifier of the source of the applicant's goods or services. See TMEP §1202 regarding the determination of whether a mark functions as a mark.

When examining a proposed mark containing the hash symbol, careful consideration should be given to the overall context of the mark, the placement of the hash symbol in the mark, the identified goods and services, and the specimen of use, if available. If the hash symbol immediately precedes numbers in a mark (#29 JONES, THE #1 APP, # TWELVE, etc.), or is used merely as the pound or number symbol in a mark (e.g., ICHIBAN#), such marks should not necessarily be construed as hashtag marks. This determination should be made on a case-by-case basis.

Generally, the hash symbol and the wording HASHTAG do not provide any source-indicating function because they merely facilitate categorization and searching within online social media (i.e., social-media

participants are directed to search a particular subject by typing, e.g., "hashtag ABC," where ABC is the subject). *See In re DePorter*, 129 USPQ2d 1298, 1303 (TTAB 2019); *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1633 (TTAB 2018).

Therefore, the addition of the term HASHTAG or the hash symbol (#) to an otherwise unregistrable mark typically will not render it registrable. *Cf.*TMEP §807.14(c) ("Punctuation, such as quotation marks, hyphens, periods, commas, and exclamation marks, generally does not significantly alter the commercial impression of the mark."); TMEP §1209.03(m) (addition of generic top-level domain name to otherwise unregistrable matter typically cannot render it registrable). Accordingly, if a proposed mark consists of the hash symbol or the term HASHTAG combined with wording that is merely descriptive or generic for the goods or services, or fails to function as a trademark because it is merely informational matter, then the entire mark must be refused.

Example:

#SKATER for skateboards is merely descriptive

1202.18(a) Disclaiming HASHTAG or Hash Symbol

A mark may be registrable with a disclaimer of the wording HASHTAG or the hash symbol in cases where they are separable from other registrable matter. Therefore, if a mark consists of the hash symbol or the term HASHTAG combined with wording that is distinctive for the goods or services, the hash symbol or the term HASHTAG should be disclaimed.

Examples:

INGENUITY for business consultation services is registrable with a disclaimer of the hash symbol
TMARKEY #SKATER for skateboards is registrable with a disclaimer of "# SKATER"

Cf. TMEP §1215.07 for further information and analogous examples.

When a mark containing the hash symbol or the term HASHTAG is unitary with other arbitrary or suggestive wording in the mark, (e.g., #SLUGGERTIME for t-shirts, #DADCHAT for emotional counseling for families, and HASHTAGWALKING for live music concerts), no descriptive or generic refusal or disclaimer is required. However, such marks must still be evaluated to confirm that they function as source indicators for the goods or services. If the specimen shows the hash symbol or the term HASHTAG in a proposed mark as merely a tag used to reference or organize keywords or topics of information to facilitate searching a topic, the relevant public will not view the hash symbol or the term HASHTAG in the mark as identifying the source of the goods or services. In such cases, registration must be refused under Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051, 1052, 1127, for trademarks, and Trademark Act Sections 1, 2, 3, and 45, 15 U.S.C §1051-1053, 1127, for service marks. *Cf. In re Roberts*, 87 USPQ2d 1474 (TTAB 2008); *In re Eilberg*, 49 USPQ2d 1955 (TTAB 1998); TMEP §1215.02(a).

For example, if the proposed mark #SEWFUN for instruction in the field of sewing appears on a specimen comprising a screenshot of a social networking site used merely to organize users' comments about sewing classes applicant offers, the mark must be refused registration for failure to function as a service mark.

1202.18(b) Marks Consisting Solely of HASHTAG or Hash Symbol

Sometimes, marks that consist solely of variants of the term HASHTAG or the hash symbol may function as a mark, such as when the mark will be used in connection with goods or services that do not relate to social networking. In these cases, the symbol and term HASHTAG may not create the commercial impression of being a metadata tag since they do not immediately precede other wording, and may be considered suggestive or arbitrary, depending on the associated goods and services (e.g., HASHTAG for use in connection with liquor or THE HASHTAG for rental of office space).

1202.19 Repeating-Pattern Marks

A repeating-pattern mark is a mark composed of a single repeated element or a repeated combination of designs, numbers, letters, or other characters, forming a pattern that is displayed on the surface of goods, on product packaging, or on materials associated with the advertising or provision of services. The pattern may appear over the entire surface or on just a portion of the relevant item.

Repeating-pattern marks are often applied to clothing and fashion accessories, but they also appear on other goods, including furniture, bedding, dinnerware, luggage, paper products, and cleaning implements. In addition, these marks frequently appear on packaging for a variety of goods and have been registered for use in connection with services such as retail stores and travel agencies. For examples of repeating-pattern marks, see TMEP §1202.19(k).

In a repeating-pattern mark, the repetition of the mark's elements is a feature of the mark, which must be appropriately specified in the application. *See*TMEP §§1202.19(a), (b). The fact that the specimen shows the mark depicted in the drawing being used in a repetitive fashion on the relevant items is not, by itself, a sufficient basis for treating the mark as a repeating-pattern mark. That is, despite what is shown in the specimen, the applicant might not be seeking a registration in which repetition is a feature of the mark. Accordingly, there also must be some indication in the mark description or on the drawing to indicate that the mark consists of a repeating pattern.

If the nature of the mark is ambiguous, the examining attorney must seek clarification from the applicant through a Trademark Rule 2.61(b) requirement for information, or by telephone or email communication, as appropriate. See 37 C.F.R. §2.61(b); TMEP §814. Any clarification obtained through informal communication should be recorded in a Note to the File or in a subsequent Office action or examiner's amendment. *See*TMEP §709.05.

A repeating pattern that is unique when used in connection with the relevant goods or services may be inherently distinctive. *See*TMEP §1202.19(e)(i)(A). However, because of the ornamental and typically nondistinctive nature of repeating patterns, consumers often do not perceive these patterns as source indicators, in which case they may not be registered on the Principal Register without proof of acquired distinctiveness. *See*TMEP §§1202.19(e)–(e)(iii).

1202.19(a) Drawing Requirements for Repeating-Pattern Marks

The drawing for a repeating-pattern mark must be a substantially exact representation of the mark. *See* 37 C.F.R. §2.51; TMEP §§807.12–807.12(d). The impression created by a repeating pattern may change depending on a number of factors, including the nature of the pattern and the item it appears on, the particular placement of the pattern on the item, and the size and scale of the elements in the pattern as applied. Thus, in most cases, to accurately depict the mark, a drawing showing the particular manner of display and

placement of the repeating pattern is necessary. A swatch-type drawing—one that does not show the particular placement of the mark but instead consists of a sample of the repeating pattern displayed within a square, rectangle, or other geometric shape—is acceptable only under certain circumstances. See TMEP §1202.19(a)(iii) for additional information on swatch-type drawings.

1202.19(a)(i) Mark Used on a Single Item

The drawing for a repeating-pattern mark applied in a particular manner to a single item must depict the pattern as it appears on the item. Thus, if the pattern appears only on a portion of the item, the drawing must show the pattern's placement on that portion. If the pattern appears over the entire surface of the item, the drawing must depict the pattern accordingly. The shape of the item must appear in broken lines to indicate that it is not claimed as part of the mark. 37 C.F.R. §2.52(b)(4); TMEP §807.08. If the drawing shows the item in solid lines, the USPTO will interpret the drawing as indicating that the proposed mark is a composite mark consisting of both the repeating pattern and the shape of the item to which it is applied. *Cf.* TMEP §1202.05(d)(i).

If it is unclear what portions of the drawing are claimed as part of the mark, the examining attorney must seek clarification from the applicant through a Trademark Rule 2.61(b) requirement for information, or by telephone or email communication, as appropriate. *See* 37 C.F.R. 2.61(b); TMEP §§709.05, 814. Based on that clarification, the examining attorney must also require the appropriate amendments to the drawing and mark description.

See TMEP §§1202.19(f)–(f)(ii) regarding the relevant examination procedures when an application identifies goods that are inconsistent with the depiction of the mark in the drawing.

1202.19(a)(ii) Mark Used in a Similar Manner on Similar Items

If the repeating pattern will be applied to multiple goods, a drawing showing the pattern's placement on one of the goods is appropriate if all of the identified goods are similar in form and function, and the mark will appear in a similar manner on all of the goods. Under these circumstances, a depiction of one of the goods may be considered a substantially exact representation of the mark as used on all of the goods. For example, if a repeating pattern is used in a similar manner on similarly shaped purses of various sizes, a drawing showing the repeating pattern on one version of the purses (shown in broken lines) would be acceptable. Another example is a repeating-pattern mark that is applied in the same manner to the handles of tableware forks, spoons, and knives. In that case, a drawing that depicts the mark on one of the items (shown in broken lines) would be acceptable.

Likewise, if the repeating-pattern mark will appear in a similar manner on various sizes of similarly shaped product packaging, then a drawing showing the mark appearing on one version of the packaging depicted in broken lines is acceptable.

1202.19(a)(iii) Mark Used in Various Ways or on Various Items Swatch-Type Drawings

Sometimes an applicant uses, or intends to use, a repeating-pattern mark in various ways on the same or similar items, or in similar or different ways on a variety of items. In those circumstances, a drawing depicting the mark appearing on a particular item will not accurately depict the mark and the nature of its use.

Previously, to address this issue, applicants have submitted swatch-type drawings, which do not show a particular placement of the mark, but instead consist of a sample of the repeating pattern within a square,

rectangle, or other geometric shape. These swatch-type drawings usually will not adequately depict the nature of the mark for which registration is sought, because the impression created by a repeating pattern may change depending on the nature of the pattern, the type of item on which the pattern appears, the particular placement of the pattern on that item, and the size and scale of the elements in the pattern as applied. Accordingly, these swatch-type drawings could encompass multiple versions of the mark, each of which may convey a different commercial impression. Therefore, such swatch-type drawings are usually not appropriate for repeating-pattern marks, and examining attorneys generally should not accept them.

However, a swatch-type drawing is acceptable if the applicant shows with sufficient evidence that (1) the applied-for mark is actually used, or will be used, in various ways or on a variety of different items, but (2) it will nonetheless be perceived as a source indicator and create the same commercial impression across all uses.

The evidence of variable use need not show every use of the repeated pattern on the relevant items, but it should provide a reasonable basis for concluding that the use of the mark in connection with the identified goods or services is so varied that a single depiction of the mark on a particular item would not accurately reflect the nature of the mark. For applications not based on use in commerce, the evidence should indicate the applicant's intention to use the mark in various ways or on a variety of different items. This may include declarations, marketing materials, and other similar matter.

The evidence as to the commercial impression must be substantial and must establish that the pattern will be perceived as a source indicator and create the same commercial impression in the minds of consumers. Relevant evidence may include consumer declarations; advertisements or other materials showing various instances of the pattern being used together in one place (e.g., a single advertisement that shows the pattern being used in various ways on various goods, but nonetheless projecting the same commercial impression); sales figures relevant to the various items featuring the pattern; and any other evidence of the applicant's efforts to promote the various uses of the repeating pattern as a single source indicator for the relevant goods or services, including "look-for"-type evidence. Although the evidence listed above is similar to evidence that would be submitted in support of an acquired-distinctiveness claim, here the examining attorney's determination is focused not on whether the mark has acquired distinctiveness but on whether the use or intended use of the mark, and the likely consumer perception of it, satisfy the specified conditions for acceptance of a swatch-type drawing.

Even if these conditions are satisfied, an examining attorney must also consider the applied-for mark's distinctiveness. For example, to support a swatch-type drawing for such varied goods as "business card cases; coin purses; cosmetic cases sold empty; dog collars; dog leashes; handbags; luggage tags; overnight bags; pet clothing; umbrellas; wallets; and wristlet bags" the applicant might submit some or all the following: a statement that the mark had been used for more than 10 years on hangtags, packaging, promotional materials, and across various product categories; evidence showing that it is a common practice in the industry for fashion brands to develop signature patterns; examples of pattern designs in the industry that have become well-recognized as source indicators; news articles and website excerpts touting the mark in connection with the applicant; examples of the mark in use on packaging, shopping bags, hangtags, and promotional materials; examples of various products featuring the mark; a declaration indicating substantial sales of products, packaging, or hangtags featuring the mark, as well as significant marketing expenditures relating to promotion of products featuring the repeating pattern. While this kind of evidence might be submitted to support a claim of acquired distinctiveness, it is also the kind of evidence that may support the submission of a swatch-type drawing, because it shows that the repeating-pattern mark is used in various ways on a variety of items and that the repeating pattern would be perceived as a source indicator and create in the minds of consumers the same commercial impression across that pattern's various uses.

If the applicant has submitted a swatch-type drawing but the evidence of record does not establish that a swatch-type drawing is appropriate, the examining attorney must refuse registration on the ground that the application seeks registration of more than one mark. See TMEP §§1202.19(g)–(g)(ii).

1202.19(a)(iv) Drawings for Service Marks

Repeating-pattern marks are used as service marks in a variety of ways. For instance, a repeating-pattern mark could be displayed on a retail store's façade, on a customer loyalty card, on advertising materials, or on shopping bags.

If a repeating pattern appears on elements in a service setting in a manner that makes a single commercial impression, such as a pattern that is displayed on the various architectural features or other fixtures of a retail outlet, a drawing of the setting should be submitted, along with a detailed description of the mark that specifies the location and manner of use of the repeating pattern. *Cf.* TMEP §1202.05(d)(ii) ("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 mark claiming the color(s) and describing the location of the color(s).")

The drawing must depict in broken lines those elements of the environment that display the repeating pattern but are not claimed as a feature of the mark. *See* 37 C.F.R. §2.52(b)(4); TMEP §807.08.

Otherwise, if the mark is used on a particular item, or is used in a similar manner on multiple items that are similar in form and function, and can thus be adequately represented by a depiction of a single item, a drawing consisting of the mark appearing on a single item is appropriate. *See*TMEP §§1202.19(a)(i)–(ii).

The conditions for accepting a swatch-type drawing for repeating-pattern marks used in connection with services are the same as those explained in TMEP §1202.19(a)(iii).

1202.19(b) Mark Descriptions for Repeating-Pattern Marks

The mark description must accurately describe the mark. *See*TMEP §808.02. Thus, the description for a repeating-pattern mark must indicate that the mark consists of a pattern. Although the description must identify the various elements of the pattern, it is not necessary to describe their exact placement within the pattern; it is sufficient for the description to generally characterize the elements and indicate that they are repeated. *See id*.

In addition, the description must specify how the pattern will appear on the relevant items. Thus, if the pattern is applied only to a portion of the relevant goods, packaging, or other items, the description must specify that portion. If the pattern is repeated over the entire surface of the relevant items, the description must so indicate. And, if the pattern is displayed in various ways on the relevant items (*see*TMEP §1202.19(a)(iii)), then the mark description must include wording to that effect. For example, in the latter instance, the following description would be acceptable: "The mark consists of a repeating pattern of stars and circles used on various portions of the product packaging for the identified goods."

The mark description must also describe any portions of the mark that are shown in broken lines and thus are not claimed as a feature of the mark. *See* 37 C.F.R. §2.52(b)(4); TMEP §807.08. For repeating patterns featuring color, the application must include an appropriate color claim and the description must indicate where the claimed colors appear. 37 C.F.R. §2.52(b)(1).

The mark description for a repeating-pattern mark must always be printed on the registration certificate. *See*TMEP §808.03.

1202.19(c) Material Alteration of Repeating-Pattern Marks

1202.19(c)(i) Amending the Drawing to Depict a Different Object

Generally, when the original drawing depicts the repeating pattern appearing on a particular object, amending the drawing to show the pattern appearing on a significantly different object will be considered a material alteration. Thus, if the original drawing shows the repeating pattern appearing on the outer surface of a purse, for example, it may not be amended to show the mark appearing on the handle of a walking cane.

However, if the mark will appear in a similar manner on similar items, so that a depiction of only one of the items is a substantially exact representation of the mark as used on all of the items, the applicant may amend the drawing from a depiction of one of the items to a depiction of another of the items, assuming the shape of the items is not claimed as a feature of the mark and the specimen of use or foreign registration certificate supports the amendment. *See* 37 C.F.R. §2.72; TMEP §807.13. For instance, it would not be a material alteration to amend a drawing that shows the pattern appearing on the handle of a spoon shown in broken lines to show the pattern on the handle of a fork shown in broken lines. However, any item depicted in the drawing must be consistent with the identification of goods or services. *See*TMEP §1202.19(f).

1202.19(c)(ii) Amending a Swatch-Type Drawing to Show an Object and Vice Versa

When the original drawing is a swatch-type drawing showing the elements of the pattern within a square, rectangle, or other generic geometric shape (*see*TMEP §1202.19(a)(iii)), the drawing may be amended to show the pattern appearing on a particular item, if necessary and otherwise appropriate. *See*TMEP §807.13. However, amending from a drawing showing the pattern on a particular object to a swatch-type drawing usually will be a material alteration, especially when the elements comprising the pattern are nondistinctive.

1202.19(c)(iii) Amending the Drawing to Depict a Different Placement of the Repeating Pattern

When the original drawing shows the repeating pattern displayed in a particular manner on an object, amending the drawing to show the pattern being displayed in a significantly different manner on the same object may be a material alteration. For instance, a drawing that shows the repeating pattern on the outer bill of a baseball cap may not be amended to show the pattern on the inner lining of the cap. However, a minor change to the placement of a repeating pattern on an object should not be considered a material alteration.

1202.19(c)(iv) Amending Descriptions of Repeating-Pattern Marks

An applicant may not amend a mark description if the amendment would describe a materially different mark than what was depicted in the original drawing. *See* 37 C.F.R. §2.72; *In re Thrifty Inc.* 274 F.3d 1349, 1353, 61 USPQ2d 1121, 1124 (Fed. Cir. 2001) (finding applicant's proposed amendment to the mark description was a material alteration of the drawing because the "multiple impressions created by the wide variety of objects sought to be covered under the proposed description differ significantly from the original mark of a color placed on a building").

For applications in which the original drawing is a swatch-type drawing (see TMEP §1202.19(a)(iii)) and the original mark description indicates that the pattern is used a variety of ways, an applicant may amend the mark description to indicate that the pattern appears in a particular manner on a particular item, in accordance with a corresponding drawing amendment. These amendments are not considered material alterations. In these instances, the applicant may also be required to amend the identification of goods or services to delete any items that are inconsistent with the drawing. See TMEP §1202.19(f).

1202.19(c)(v) Amendments in Applications Based on Section 44 or Section 66(a)

For applications based on Section 44 or Section 66(a), any amendments must conform to the rules and procedures governing these types of applications. *See, e.g.*, TMEP §§1011.01 ("substantially exact representation standard" for drawings in §44-based applications), 1011.03 (amendment of drawings in §44-based applications), 1904.02(j) (amendment of marks in §66(a)-based applications), 1904.02(k) (drawings and descriptions in §66(a)-based applications).

1202.19(d) Specimens for Repeating-Pattern Marks

As with other types of marks, the specimen of use for a repeating-pattern mark must show use of the mark as depicted in the drawing and described in the mark description. See TMEP §§904, 904.07(a), 1301.04(g)(i).

When a repeating pattern is applied to a single item, and the drawing thus depicts the repeating pattern on that item (*see*TMEP §1202.19(a)(i)), the specimen should show the pattern displayed on the same item or a substantially similar item. In addition, the placement of the pattern on the object in the specimen should be consistent with the placement as depicted in the drawing and specified in the description.

When a repeating pattern is applied in the same manner to similar items and thus a drawing depicting one of the items is appropriate (*see*TMEP §1202.19(a)(ii)), the specimen of use need not show the item depicted in the drawing, assuming the shape of the item in the drawing is not claimed as a feature of the mark. However, the object shown in the specimen must be sufficiently similar to the item in the drawing, such that the drawing is a substantially exact representation of the mark as actually used. *See*TMEP §1202.19(a)(ii). In addition, if the mark is applied to goods, the good shown in the specimen must be encompassed by the identification of goods. Thus, if the identified goods are spoons, forks, and knives being tableware, and the drawing shows the repeating pattern appearing on the handle of a spoon shown in broken lines, a specimen showing the same pattern in the same manner on the handle of a fork would be acceptable. See TMEP §§1202.19(f)–(f)(ii) for a discussion of the relevant examination procedures when the identified goods or services are inconsistent with the drawing.

When the drawing is a swatch-type drawing, and the examining attorney has determined that the drawing is appropriate (*see*TMEP §1202.19(a)(iii)), a specimen showing the pattern appearing on a particular object should be considered to match the drawing if the overall commercial impression created by the pattern is the same.

The fact that the specimen shows the mark depicted in the drawing being used in a repetitive fashion on the relevant items is not, by itself, a sufficient basis for treating the applied-for mark as a repeating-pattern mark. There must be some indication in the mark description or drawing to indicate that the mark consists of a repeating pattern.

If necessary, examining attorneys may require additional specimens to determine whether the applied-for mark functions as a trademark or service mark for all of the identified goods or services. *See* 37 C.F.R.

§2.61(b); TMEP §904.01(a). For example, additional specimens may be necessary when the identified goods include items that are significantly different from the goods shown in the originally submitted specimen, such that it is not clear how the mark is used on all of the goods.

1202.19(e) Failure-to-Function Refusal – Mark Not Inherently Distinctive

The USPTO will not register an applied-for mark unless it functions as a mark. *See*15 U.S.C. §§1051, 1052, 1053, 1127; *In re Bose Corp.*, 192 USPQ 213, 215 (C.C.P.A. 1976) ("Before there can be registration, there must be a trademark . . . ."); *In re Int'l Spike, Inc.*, 196 USPQ 447, 449 (TTAB 1977) ("Registration presupposes the existence of a trademark to be registered."); TMEP §1202. That is, the mark must serve as an indicator of the source of the goods or services, identifying and distinguishing them from those of others. *See*15 U.S.C. §1127; TMEP §1202.

The examining attorney must determine whether a repeating-pattern mark functions as a trademark or service mark by reviewing the available evidence, including the specimen and any other materials of record. *See In re Safariland Hunting Corp.*, 24 USPQ2d 1380, 1381 (TTAB 1992) ("Since the specimens of record show how the applied-for mark is actually used in commerce, we must primarily look to the specimens to see if the designation would be perceived as a source indicator. However, we may also consider other evidence bearing on the question of what impact applicant's use is likely to have on purchasers and potential purchasers.").

Not every designation that a party places on goods or packaging, or uses in connection with services, is an inherently distinctive source indicator, regardless of the party's intentions when adopting the designation. *In re Eagle Crest, Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010); *In re Vertex Grp., LLC*, 89 USPQ2d 1694, 1701 (TTAB 2009) ("As is the case with any trademark, mere intent that a word, name, symbol or device function as a trademark or service mark is not enough in and of itself."). Some designations are not capable of serving as a source indicator. *See In re Eagle Crest, Inc.*, 96 USPQ2d at 1229; *Am. Velcro, Inc. v. Charles Mayer Studios, Inc.*, 177 USPQ 149, 154 (TTAB 1973).

1202.19(e)(i) Inherent Distinctiveness Determination

Because repeating patterns frequently serve an ornamental function in various contexts, they are often not inherently distinctive when applied to goods, packaging, or materials associated with services. Instead, consumers may perceive these patterns as nothing more than ornamentation or background matter serving no source-indicating function. Thus, determining whether a repeating-pattern mark is inherently distinctive and functions as a source indicator involves considering the impression created when the mark is used in connection with the identified goods or services. *See In re Aerospace Optics, Inc.*, 78 USPQ2d 1861, 1862 (TTAB 2006) ("A critical element in determining whether matter sought to be registered is a trademark is the impression the matter makes on the relevant public. Thus . . . the critical inquiry is whether the asserted mark would be perceived as a source indicator. . . . To be a mark, the term must be used in a manner calculated to project to purchasers or potential purchasers a single source or origin for the goods. . . . We determine whether this has been achieved by examining the specimens of use along with any other relevant material submitted by applicant during prosecution of the application.").

Relevant considerations when determining inherent distinctiveness include those discussed below.

1202.19(e)(i)(A) Common or Widely Used Pattern

Evidence showing that the repeating pattern in the applied-for mark is similar to, or a mere refinement or variation of, a common pattern or a pattern that is widely used on the relevant items, may support the conclusion that the applied-for mark is not inherently distinctive. *See Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 1344, 196 USPQ 289, 291 (C.C.P.A. 1977).

On the other hand, if the nature of the repeating pattern is unique or unusual as applied to the relevant items, a finding of inherent distinctiveness may be appropriate. *See Seabrook Foods, Inc.*, 568 F.2d at 1344, 196 USPQ at 291.

However, the mere fact that the applicant is the only user of the particular repeating pattern is not dispositive as to the inherent distinctiveness of a mark featuring that pattern. *See In re E S Robbins Corp.*, 30 USPQ2d 1540, 1543 (TTAB 1992) ("If the concept of inherent distinctiveness was defined as meaning simply 'one and only,' then one could obtain a registration for a design which, while 'unique' in this sense, differed only slightly from the designs of other competing products and/or containers."). The examining attorney must weigh this factor together with any other relevant factors.

1202.19(e)(i)(B) Pattern Creates a Distinct Commercial Impression Apart from Other Matter

The examining attorney should consider whether the pattern creates a commercial impression distinct from any wording or other matter that may also appear on the relevant items. *See Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 1344, 196 USPQ 289, 291 (C.C.P.A. 1977). If so, this weighs in favor of finding the pattern inherently distinctive.

1202.19(e)(i)(C) Nature of Elements in the Repeating Pattern

If a repeating-pattern mark contains an element, such as arbitrary wording, which would be perceived as a source indicator if it were to appear by itself, then the relevant consumers may be more likely to perceive the repeating pattern as a source indicator.

1202.19(e)(i)(D) Industry Practice

Purchasers are unlikely to view a repeating-pattern mark as an indicator of source if the relevant industry practice is to use repeating patterns in an ornamental fashion with the relevant goods or services. However, if, because of common industry practice, consumers have come to view repeating patterns on the surface of the relevant goods, packaging, or other materials as an indicator of source, and the applied-for mark is more than common background matter, then a finding that the mark is inherently distinctive may be appropriate.

1202.19(e)(i)(E) Type of Product

The type of item the mark is applied to affects whether consumers perceive the repeating pattern as a mark rather than merely as ornamental or other nondistinctive matter. For example, when repeating patterns appear on items such as clothing, curtains, pillows, bedding, carpet, furniture, and stationery, the patterns are likely to be perceived as decoration because those types of goods are typically purchased or used, at least in part, for their aesthetic appeal. On the other hand, if the type of item the mark is applied to does not usually feature decorative matter, or is not usually purchased or used for its decorative features, like power tools, industrial machinery, or surgical equipment, a repeating pattern may be more likely to be perceived as a source indicator.

1202.19(e)(ii) Statutory Basis for Refusal

When the applicant has sought registration of a repeating-pattern mark on the Principal Register without claiming acquired distinctiveness, and the examining attorney determines that the mark is not inherently distinctive, registration must be refused on the ground that the mark fails to function as a source indicator, citing Trademark Act §§1, 2, and 45 for trademarks, and §§1, 2, 3, and 45 for service marks. *See*15 U.S.C. §§1051, 1052, 1053, 1127. The examining attorney must explain the specific reasons for the refusal and provide relevant supporting evidence. *See*TMEP §1202. The stated reason for refusal will usually be that the applied-for mark is merely ornamental as used on or in connection with the goods or services. However, in some instances, the applied-for repeating-pattern mark may be simply nondistinctive, serving neither an ornamental nor a source-indicating purpose. In either case, the same statutory bases apply.

If registration is sought on the Supplemental Register, but the examining attorney determines that the mark is incapable of serving as a source indicator, registration must be refused on that ground under Trademark Act §§23 and 45. 15 U.S.C. §§1091, 1127.

1202.19(e)(iii) Response Options

If an applied-for mark is capable of serving as a source indicator, the applicant may respond to the refusal by submitting a substitute specimen showing use of the mark as a trademark or service mark, amending to the Supplemental Register, or claiming acquired distinctiveness under Trademark Act Section 2(f), if otherwise appropriate. For repeating-pattern marks that are capable of serving as source indicators but are not inherently distinctive, evidence of five years' use, by itself, is insufficient to show acquired distinctiveness. *See*TMEP §1212.05(a). That is, actual evidence showing that consumers have come to recognize the applied-for mark as a source indicator will be required to establish acquired distinctiveness. *See id*.

Furthermore, for repeating-pattern marks used on goods, any showing of acquired distinctiveness must be made with respect to all of the identified goods for which the examining attorney has determined the mark is not inherently distinctive. For repeating-pattern marks used in connection with services, the evidence of acquired distinctiveness must establish that the mark, as used on all of the relevant items, has come to be perceived as a source indicator for the identified services.

See TMEP §816 regarding amendment to the Supplemental Register and TMEP §§1212-1212.10 regarding claims of acquired distinctiveness.

The applicant may also submit evidence of secondary source to establish that a repeating-pattern mark primarily serves a source-indicating function rather than merely serving as ornamentation. As discussed in TMEP §1202.03(c), there are a number of acceptable types of evidence for showing secondary source, such as proof of ownership of a use-based U.S. registration on the Principal Register for the same mark covering other goods or services. However, evidence of a series of ornamental uses of a repeating-pattern mark on various items will not establish that the proposed mark functions as an indicator of secondary source; use as a trademark or service mark for the other goods or services must be shown. TMEP §1202.03(c); *see also In re Astro-Gods Inc.*, 223 USPQ 621, 622-24 (TTAB 1984) .

1202.19(f) Failure-to-Function Refusal – Inconsistent Goods or Services

When the drawing shows the repeating pattern appearing on an item, the examining attorney must determine whether all of the identified goods or services are consistent with the item depicted, such that the mark

shown accurately reflects how the mark appears on all of the identified goods and services and could actually serve as a source indicator for them.

For example, in an application that depicts the mark as a repeating pattern appearing on the bill of a baseball cap shown in broken lines, the cap is not part of the mark, but the drawing nonetheless limits the mark to the particular manner of use shown. Thus, if the application identifies the goods as baseball caps, shoes, eyeglasses, and purses, the identified baseball caps are consistent with the drawing, but the identified shoes, eyeglasses, and purses are not, because the mark obviously cannot be applied to those goods in the manner depicted in the drawing. If, on the other hand, the drawing depicts a repeating pattern applied to the handle of a hand rake, any other similar type of implement with a handle that is listed in the identification of goods should be considered to be consistent with the drawing.

If the drawing shows the repeating-pattern mark appearing on packaging for goods, the identified goods should be considered consistent with the drawing if they could be sold in the packaging shown. For instance, if the packaging shown is a bottle, then goods that are not normally packaged in a bottle should be considered inconsistent with the nature of the mark as depicted in the drawing, assuming there is no evidence that the applicant's goods actually are packaged in that manner.

The fact that an application identifies services, but contains a drawing showing the mark applied to a particular object, does not necessarily raise an issue of inconsistency. Marks of this nature may function as source indicators for services. For example, a repeating pattern applied in a particular manner to the exterior of an airplane could be perceived as a source indicator for airline transportation services. However, if the application identifies both goods and services, the examining attorney must consider whether the mark shown in the drawing could actually function as both a trademark for the identified goods and a service mark for the identified services.

The determination of whether all of the identified goods or services are consistent with the drawing is distinct from the determination of whether the drawing agrees with the specimen of record. *See*TMEP §1202.19(d). Thus, if the application contains specimens showing that the drawing is not a substantially exact representation of the mark as used on the goods or packaging, or in connection with the services, the examining attorney must also issue any applicable requirement or refusal on that basis. *See*TMEP §807.12(a).

1202.19(f)(i) Statutory Basis for Refusal

If the examining attorney determines that any of the identified goods or services are inconsistent with the drawing, the examining attorney must refuse registration as to those goods or services on the ground that the mark, as depicted in the drawing, fails to function as a mark for them. *Cf.* TMEP §§1202.02(f)(i), 1202.02(f)(ii). The statutory bases for the refusal are Trademark Act §§1, 2, and 45 for trademarks, and §§1, 2, 3, and 45 for service marks. See 15 U.S.C. §§1051, 1052, 1053, 1127.

1202.19(f)(ii) Response Options

The applicant may overcome the refusal by deleting the inconsistent goods or services, or by submitting evidence that the mark, as depicted in the drawing, does in fact function as a mark for the relevant goods or services. In most instances, the applicant will be unable to overcome the refusal by amending the drawing to cover all of the identified goods or services because it will be impossible to do so using a single depiction of the mark and the necessary changes are likely to result in a material alteration of the mark on the original drawing. *See*TMEP §1202.19(c). In addition, dividing out the inconsistent goods or services typically is not an appropriate response option in these cases because the drawing in the child application would need

to depict an essentially different mark, which would also be a material alteration of the mark in the original drawing.

1202.19(g) Refusal – Application Seeks Registration of More than One Mark

As explained in TMEP §1202.19(a)(iii), a swatch-type drawing is acceptable only if the applicant has submitted sufficient evidence to establish that the mark is applied to various items but that these various uses of the repeating pattern nonetheless create the same commercial impression.

1202.19(g)(i) Statutory Basis for Refusal

In the absence of the evidentiary showing discussed in TMEP §1202.19(a)(iii), a swatch-type drawing is deemed to encompass numerous versions of the mark, each of which may create a different commercial impression, and thus the examining attorney must refuse registration under Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127, on the ground that the application seeks registration of more than one mark. *See In re Int'l Flavors & Fragrances Inc.*, 183 F.3d 1361, 1366, 51 USPQ2d 1513, 1516 (Fed. Cir. 1999) ("[U]nder the Lanham Act and the rules promulgated thereunder, a trademark application may only seek to register a *single* mark."); TMEP §1214.01; *cf. In re Hayes*, 62 USPQ2d 1443, 1445 (TTAB 2002) (noting that a trademark application may only seek to register a single mark and affirming refusal of registration on the basis that applicant's mark description described more than one mark); *In re The Upper Deck Co.*, 59 USPQ2d 1688, 1689-91 (TTAB 2001) (affirming refusal to register a mark described as "a hologram device which is applied to . . . trading cards" because the mark could encompass many different holograms having various shapes, sizes, and contents, and thus the application sought to register more than a single mark); *In re Elvis Presley Enters.*, 50 USPQ2d 1632, 1633-34 (TTAB 1999) (affirming refusal to register a mark described as "the likeness and image of Elvis Presley" because the drawing failed to convey a substantially exact representation of the mark and, given that the mark could encompass numerous likenesses of Elvis, the application sought to register more than a single mark).

1202.19(g)(ii) Response Options

In response to this refusal, the applicant may amend the swatch-type drawing to depict the mark on a particular item; amend the mark description to describe the placement of the mark on that item; and, if necessary, amend the identification to delete any goods or services that are inconsistent with the drawing (*see*TMEP §1202.19(f)).

1202.19(h) Refusals in Applications Based on Section 1(b), Section 44, or Section 66(a)

The refusals discussed in TMEP §§1202.19(e)–(g)(ii) may also apply to applications based on Trademark Act §1(b), §44, or §66(a) if the information in the application or any other available evidence indicates that the applied-for mark fails to function as a trademark or service mark; that the identification includes goods or services that are inconsistent with the mark as depicted in the drawing; or that the application seeks registration of more than one mark. *See*TMEP §1202; *cf. In re Right-On Co.*, 87 USPQ2d 1152, 1157 (TTAB 2008) (noting that, with respect to §66(a) applications, "it is appropriate for examining attorneys to issue an ornamentation refusal if the mark is decorative or ornamental on its face as depicted on the drawing page and described in the description of the mark"); TMEP §1202.02(f)(i).

For §1(b) applications, if the examining attorney anticipates issuing a failure-to-function refusal once an allegation of use is filed, the examining attorney should advise the applicant of the potential refusal if

otherwise issuing an Office action. *See*TMEP §1202. However, failure to provide an advisory does not preclude the examining attorney from subsequently issuing a refusal. *See id*.

With respect to applications based on §44 or §66(a), examining attorneys must adhere to the relevant rules and procedures governing these types of applications, including those pertaining to drawing amendments and acceptable response options. *See, e.g.*, TMEP §§801.02(b) (Supplemental Register not an option for §66(a) requests for extension of protection), 1010 (proof of acquired distinctiveness in §44-based applications), 1011.01 ("substantially exact representation standard" for drawings in §44-based applications), 1011.03 (amendment of drawings in §44-based applications), 1904.02(g) (time period for issuing a refusal of a §66(a)-based application), 1904.02(j) (amendment of marks in §66(a)-based applications), 1904.02(k) (drawings and descriptions in §66(a)-based applications).

1202.19(i) Functional Repeating Patterns

It is possible, although rare, that a repeating pattern applied to the surface of an item will serve a functional purpose. This could be a utilitarian function, which is essential to the use of the item or affects the cost or quality of the item, or an aesthetic function, which does not have a truly utilitarian function in terms of the item's use or performance, but nonetheless provides a real and significant competitive advantage. See TMEP §§1202.02(a)(iii)(A), 1202.02(a)(vi). For example, a repeating pattern could function as camouflage for a product that requires concealment (utilitarian functionality). Or a repeating pattern could make a product more aesthetically desirable, beyond mere ornamentation, by allowing the product to be visually coordinated with a variety of other related items (aesthetic functionality). *See Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 1531-1533, 32 USPQ2d 1120, 1122-1124 (Fed. Cir. 1994) (affirming TTAB's determination that the color black on the surface of outboard motors is functional because, while it has no utilitarian effect on the mechanical purpose of the engines, it does provide other identifiable competitive advantages, including compatibility with a wide variety of boat colors and reduction in the perceived size of the engines). If the available evidence supports the conclusion that a repeating-pattern mark is functional, the examining attorney must refuse registration accordingly. See TMEP §§1202.02(a)–(a)(viii) regarding functionality and the procedures for refusing registration.

1202.19(j) Random Patterns

The foregoing guidance on repeating patterns also generally applies to marks consisting of random or fractal patterns, that is, patterns in which the relevant elements are not repeated in a set or easily recognized way. However, examining attorneys must carefully review the drawing, mark description, and specimen of use for this type of mark to ensure not only that the application accurately depicts and describes the mark, but also that the mark creates the impression of a single mark.

1202.19(k) Examples of Repeating-Pattern Marks

Registered Repeating-Pattern Marks

Example 1

U.S. Registration No. 3826587 (Supplemental Register)

Mark

Specimen

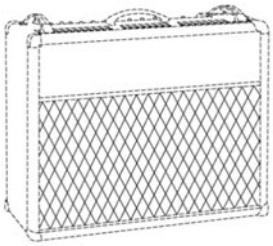
Mark Description: "The mark consists of a repeating pattern of hexagonal shapes printed or stitched on the inner lining of shoe uppers. The matter shown in broken or dotted lines is not part of the mark and serves only to show the position or placement of the mark on the goods."

Goods: Shoes, in International Class 25.

Note: Although the shape of the shoe in the drawing differs slightly from the shape of the shoe in the specimen, the drawing is a substantially exact representation of the mark as used on the goods.

Example 2

U.S. Registration No. 3679828 (Principal Register – §2(f))



Mark

Specimen

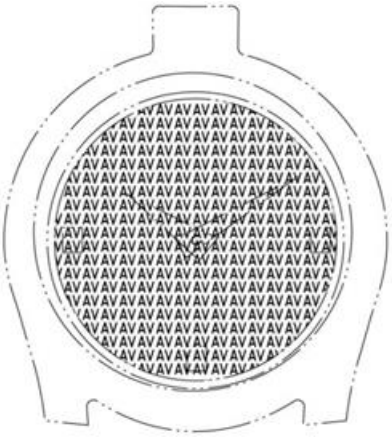
Mark Description: "The mark consists of a repetitive diamond pattern on the cloth speaker grill of a musical instrument amplifier. The dotted lines shown on the drawing are for purposes of positioning only and do not comprise a feature of the mark."

Goods: Musical instrument amplifiers, in International Class 9.

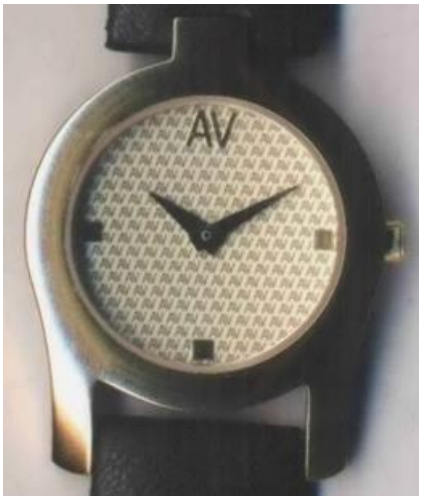
Note: The application for this mark included a large amount of evidence to establish that the mark had acquired distinctiveness as a source indicator, including samples of marketing materials, excerpts from publications, and numerous consumer declarations.

Example 3

U.S. Registration No. 3342382 (Principal Register - Cancelled)



Mark



Specimen

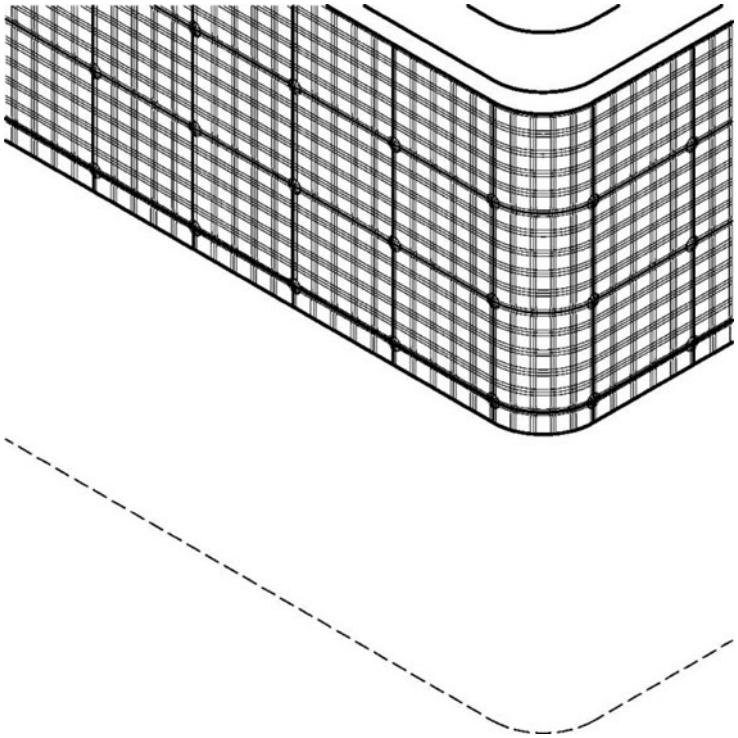
Mark Description: "The mark consists of a repeating pattern of 'AV' on the face of a watch."

Goods: Watches, in International Class 14.

Note: The drawing shows the outline of the watch in broken lines, but the mark description does not specify the meaning of the broken lines. As indicated in TMEP §§807.08 and 1202.19(b), descriptions of marks containing broken lines must indicate the significance of the lines.

Example 4

U.S. Registration No. 4100365 (Supplemental Register)



Mark

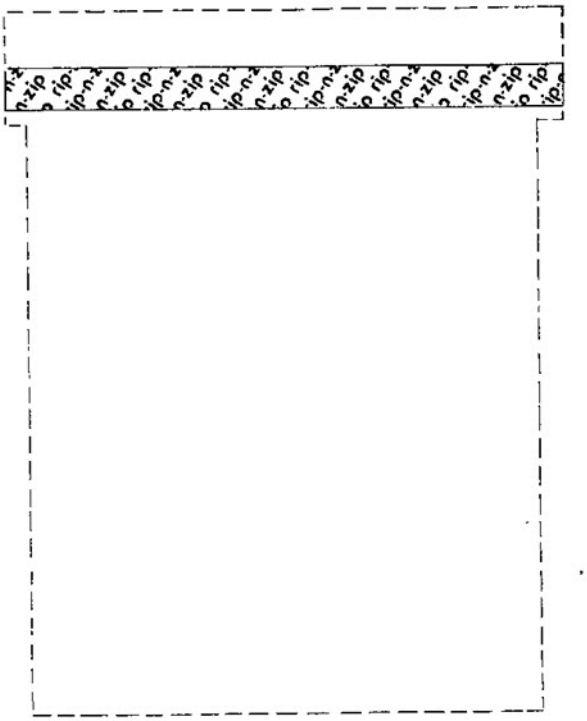
Mark Description: "The mark consists of a plaid design located on and covering the entire perimeter of the side border of a mattress, the plaid design comprising a repeat pattern no larger than approximately 1 to 1.6 inches in both its horizontal and vertical dimensions. The matter shown in dotted lines is not part of the mark but merely serves to show the placement of the mark on the goods."

Goods: Mattresses, in International Class 20.

Note: Although the entire shape in the drawing here is not depicted in broken lines, as indicated in TMEP §§807.08 and 1202.19(a)(i), broken lines must be used to indicate the shape of an item depicted in a drawing if the shape is not claimed as part of the mark.

Example 5

U.S. Registration No. 1251171 (Principal Register)



Mark

Mark Description: "The mark consists of a design showing the words 'Rip-N-Zip' repeated in a diagonal pattern along a strip extending across the upper portion of the multiwall bags."

Goods: Reclosable Multiwall Bags, in International Class 22.

Note: The drawing shows the outline of the goods in broken lines, but the mark description does not specify the meaning of the broken lines. As indicated in TMEP §§807.08 and 1202.19(a)(i), marks containing broken lines must indicate the significance of the lines (e.g., that they indicate matter that is not part of the mark).

Example 6

U.S. Registration No. 2963354 (Principal Register)

Mark

Specimen

Goods: Perfumery; cosmetics, in International Class 3.

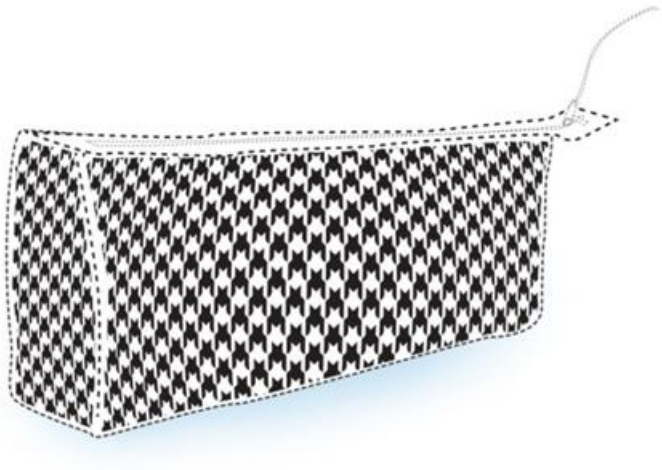
Note: Here, the repeating pattern is not a common, widely used pattern, but is instead composed of a stylized depiction of the wording DIOR. Furthermore, the pattern is placed only on part of the goods, in a place

where a trademark might appear. Although a repeated pattern often produces an ornamental effect, the repeated element here is distinctive and could serve as a source indicator if presented in a single instance, rather than being repeated. Accordingly, the mark is, as used on the goods, inherently distinctive. *See*TMEP §§1202.19(e)(i)–(e)(i)(E).

Although this registration does not include a mark description, under TMEP §§808.02 and 1202.19(b), a mark description for a repeating-pattern mark must accurately describe the elements that appear in the mark and indicate that they are repeated. In addition, to use a swatch-type drawing like the one shown here, the applicant must satisfy the requirements described in TMEP §1202.19(a)(iii). Otherwise, a drawing showing placement on the relevant item is required. *See*TMEP §1202.19(g)(ii).

Making Inherent Distinctiveness and Inconsistent Goods/Services Determinations

The following mock example is provided to illustrate concepts involved in determining whether a mark is inherently distinctive and whether the identified goods or services are consistent with the drawing. See TMEP §§1202.19(e)(i)–(e)(i)(E) and 1202.19(f) for additional information.



Mark

Mark Description: The mark consists of a repeated houndstooth pattern applied to the entire exterior surface of the side and end panels of a handbag. The matter shown in broken lines is not part of the mark and serves only to show the placement of the mark on the goods.

Goods: Handbags; purses; walking canes, in International Class 18.

Note: Although source-indicating matter is often displayed in a repetitive manner on the surface of handbags and purses, here the mark consists of a common pattern, houndstooth, which is widely used on clothing,

fashion accessories, household items, and many other goods. There is nothing unusual or distinctive about the manner in which this common pattern is displayed or placed, and thus the pattern will likely be perceived as purely ornamental. Therefore, the mark is not inherently distinctive and does not function as a source indicator for the goods. *See*TMEP §§1202.19(e)(i)–(e)(i)(E).

In addition, some of the identified goods are inconsistent with the drawing. While the handbag shown in the drawing is not part of the mark, the drawing nonetheless limits the mark to the particular manner of use shown. The mark could be applied in the manner shown to handbags and purses, but not to walking canes. Therefore, it is appropriate to refuse registration of the mark as to "walking canes" on the ground that the mark, as depicted in the drawing, fails to function as a mark for those goods. *See*TMEP §§1202.19(f)–(f)(ii).

While the pattern shown in this mock example is not distinctive as depicted in the drawing, it is possible for a commonly used pattern to be inherently distinctive, or to otherwise acquire distinctiveness, if it is used in an unusual manner on the goods, such as when the pattern appears in a unique way on a particular portion of the goods.

1203 Refusal on Basis of Deceptive Matter and Matter which May Falsely Suggest a Connection

15 U.S.C. §1052 (Extract)

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 Other Refusals Under 15 U.S.C. §1052(a) No Longer Valid

Until June 19, 2017, the USPTO examined applications pursuant to the provision in Section 2(a) of the Trademark Act, 15 U.S.C §1052(a), that prohibited 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. However, the Supreme Court held this provision of Section 2(a) discriminates based on the applicant's viewpoint and struck it down as unconstitutional under the Free Speech Clause of the First Amendment in *Matal v. Tam*, 137 S. Ct. 1744, 122 USPQ2d 1757 (2017).

In addition, until June 24, 2019, the USPTO examined applications pursuant to the provision in Section 2(a) that prohibited the registration of a mark that consists of or comprises immoral or scandalous matter. However, the Supreme Court held this provision of Section 2(a) also is viewpoint discriminatory and thus unconstitutional under the Free Speech Clause of the First Amendment in *Iancu v. Brunetti*, 139 S. Ct. 2294, 204 L. Ed. 2d 714, 2019 USPQ2d 232043.

Accordingly, that a mark may "disparage . . . or bring . . . into contempt, or disrepute" or that a mark "[c]onsists of or comprises immoral. . . or scandalous matter" are no longer valid grounds on which to refuse registration or cancel a registration. 15 U.S.C §1052(a).

In striking down these provisions in Section 2(a), the Supreme Court purposely refrained from extending its holdings to any other provisions in Section 2(a) or other sections of the Trademark Act that do not restrict trademark registration based on the applicant's viewpoint. *See, e.g., Iancu v. Brunetti*, 139 S. Ct. at 2302 n.*, 2019 USPQ2d 232043, at *7 n.* ("Nor do we say anything about how to evaluate viewpoint-neutral restrictions on trademark registration . . . "). The TTAB has since rejected an applicant's constitutional challenge to Section 2(a)'s "false suggestion" clause, explaining that the provision is viewpoint neutral and "directly furthers the goal of prevention of consumer deception in source-identifiers." *In re ADCO Indus.–Techs, L.P.*, 2020 USPQ2d 53786, at *10 (TTAB 2020) (noting that "Congress acts well within its authority when it identifies certain types of source-identifiers as being particularly susceptible to deceptive use and enacts restrictions concerning them").

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 Am. Speech-Language-Hearing Ass'n v. Nat'l 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 (*see In re White Jasmine LLC*, 106 USPQ2d 1385, 1391 (TTAB 2013); (3) a term or a portion of a term that alludes to a deceptive quality, characteristic, function, composition, or use (*seeAm. Speech-Language-Hearing Ass'n v. Nat'l 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, 1694 (TTAB 1997); *Tanners' Council of Am., Inc. v. Samsonite Corp*., 204 USPQ 150, 154 (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, 1048 (TTAB 1982)) and marks that are geographically deceptive (*see Stabilisierungsfonds fur Wein v. Peter Meyer Winery GmbH*, 9 USPQ2d 1073, 1076 (TTAB 1988) ; *In re House of Windsor, Inc.*, 221 USPQ 53, 57 (TTAB 1983), *recon. denied*, 223 USPQ 191 (TTAB 1984)). See TMEP §§1210.05-1210.06(b) 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. *SeeA. F. Gallun & Sons Corp. v. Aristocrat Leather Prods., Inc.*, 135 USPQ 459, 460 (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*, 215 USPQ at 1048; *Tanners' Council of Am.*, 204 USPQ at 154-55.

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." *See The American Heritage® Dictionary of the English Language: Fourth Ed.* 2000. 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 1489 (Fed. Cir. 2009); *In re Budge Mfg. Co.*, 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 Manufacturing Co.*, 857 F.2d 773, 775, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988) (i.e., whether a mark is misdescriptive of the goods or services and whether prospective purchasers are likely to believe the misdescription) are answered affirmatively, the mark is deceptively misdescriptive of the goods or services under §2(e)(1) of the Trademark Act. 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) of the Act from marks that are deceptively misdescriptive under §2(e)(1). To be deceptively misdescriptive under §2(e)(1), the misdescription must be deceptive in some way; i.e., consumers of the goods or services are likely to believe the misrepresentation. TMEP §1209.04 (citing *Binney & Smith Inc. v. Magic Marker Indus., Inc.*, 222 USPQ 1003, 1011 (TTAB 1984)). That is, the misdescription concerns a feature that would be relevant to the decision to purchase the goods or use the services. *In re Shniberg*, 79 USPQ2d 1309, 1311 (TTAB 2006); *seeIn re Hinton*, 116 USPQ2d 1051, 1052, 1055 (TTAB 2015) "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 also be deceptive" under §2(a). *In re Shniberg*, 79 USPQ2d at 1311; *seeIn re White Jasmine LLC*, 106 USPQ2d 1385, 1392 (TTAB 2013)See TMEP §1209.04 regarding the believability requirement for deceptive misdescriptiveness and §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 §2(a) and alternatively under §2(e)(1). *See In re Canine Caviar Pet Foods, Inc.*, 126 USPQ2d 1590 (TTAB 2018); *In re White Jasmine LLC*, 106 USPQ2d at 1385; *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047 (TTAB 2002); *see also R. Neumann & Co. v. Overseas Shipments, Inc.*, 326 F.2d 786, 140 USPQ 276 (C.C.P.A. 1964). 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(d) 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 White Jasmine LLC*, 106 USPQ2d 1385, 1392 (TTAB 2013) (citing *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694, 1698-99 (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.

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, 1353, 90 USPQ2d 1489, 1493 (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 chewing 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.

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 potential 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, the examining attorney should approve the mark for publication. Otherwise, the examining attorney should issue an Office action containing all other relevant refusals and/or requirements.

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, if appropriate (i.e., if the term at issue is not part of a unitary expression), and an amendment to the identification to include the feature or characteristic (if believable and material), 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 to the File entered in 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, i.e., if the term at issue is not part of a unitary expression), based on the presumption that the goods/services possess the feature or characteristic; and
- Issue a requirement that the applicant amend the identification to include the feature or characteristic (if believable and material); and
- Issue an information request under 37 C.F.R. §2.61(b), asking whether the goods/services possess the feature or characteristic; and
- Issue any other relevant refusals and/or requirements.

If the applicant responds that the goods/services possess the feature or characteristic or amends the identification to include the feature or characteristic, the examining attorney must issue a final Office action, assuming that the application is otherwise in condition for final action, as to the descriptiveness refusal (or disclaimer requirement, if not provided), identification requirement (if applicable and not amended), and any other relevant refusals and/or requirements, as appropriate.

If the applicant responds that the goods/services do not possess the feature or characteristic, the examining attorney must withdraw the §2(e)(1) descriptiveness refusal (or disclaimer requirement), as well as the identification requirement (if applicable), and issue a subsequent nonfinal Office action dependent on whether the misdescription would be believable and material:

> If the misdescription would be believable but not material, the examining attorney must issue a refusal under §2(e)(1) as deceptively misdescriptive (or disclaimer requirement if appropriate), with supporting evidence, and maintain all other relevant refusals and/or requirements.
> If the misdescription would be believable and material, the examining attorney must 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 maintain all other relevant refusals and/or requirements.

If the applicant does not respond to the information request and does not amend the identification to include the feature or characteristic, the examining attorney must:

> Issue a subsequent nonfinal Office action maintaining the descriptiveness refusal (or disclaimer requirement, if not provided), based on the presumption that the goods/services possess the feature or characteristic, as well as the identification requirement (if applicable), information request, and any other relevant refusals and/or requirements raised in the initial Office action, as appropriate; 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.

See, e.g ., *In re AOP LLC*, 107 USPQ2d 1644 (TTAB 2013) (holding AOP deceptive, deceptively misdescriptive, or, alternatively, merely descriptive for wine, after the applicant failed to fully respond to the examining attorney's inquiries regarding the origin and certification of applicant's goods); *In re Cheezwhse.com, Inc*., 85 USPQ2d 1917 (TTAB 2008) (holding NORMANDIE CAMEMBERT 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

Generally, an applicant may avoid or overcome a deceptiveness refusal by amending the identification of goods or services, if accurate, to include the potentially deceptive term. For deceptiveness refusals based on the material composition of the goods, 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."

The Office construes the wording "made in significant part of" as indicating that the goods contain a sufficient amount of the named ingredient/material composition to meet the standard for use of the term in the relevant industry. In the case of "coats made in significant part of leather," such wording would be construed to mean that the "coats" contain a sufficient amount of leather to be called "leather coats" in the relevant industry. However, the wording "coats made in part of leather" is not acceptable because, although the goods may contain some leather, it may not be an amount sufficient for the goods to be called "leather coats" in the relevant industry.

Note, however, that amending the identification to exclude goods made from the named ingredient or material composition will not avoid or overcome a deceptiveness refusal.

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.*, 857 F.2d 773, 775-76, 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 S. 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. Moreover, priority of use cannot overcome a deceptiveness refusal. *In re AOP LLC*, 107 USPQ2d 1644, 1650 n.6 (TTAB 2013) .

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.*, 857 F.2d 773, 8 USPQ2d 1259 (Fed. Cir. 1988), *aff'g*8 USPQ2d 1790 (TTAB 1987) (holding LOVEE LAMB deceptive for seat covers not made of lambskin); *In re AOP LLC*, 107 USPQ2d 1644 (TTAB 2013) (holding AOP deceptive for wine, where the term is used by members of the European Union to designate a particular quality and geographical origin of wine, when applicant is not the entity that administers the designation and the goods do not necessarily originate in Europe); *In re White Jasmine LLC*, 106 USPQ2d 1385 (TTAB 2013) (holding the term WHITE in the proposed mark WHITE JASMINE deceptive for tea that did not include white tea, where the evidence established that consumers perceive that white tea has desirable health benefits); *In re E5 LLC*, 103 USPQ2d 1578 (TTAB 2012) (holding a mark consisting of the alpha symbol and letters "CU" deceptive for dietary supplements not containing copper, a common ingredient in dietary supplements, which evidence showed is referred to as CU); *In re ALP of S. 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) (holding SUPER SILK deceptive for "clothing, namely dress shirts and sport shirts made of silk-like fabric"); *In re Organik Technologies, Inc.*, 41 USPQ2d 1690 (TTAB 1997) (holding 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) (holding LONDON LONDON deceptive for clothing having no connection with London); *In re Perry Mfg. Co.*, 12 USPQ2d 1751 (TTAB 1989) (holding PERRY NEW YORK and design of New York City skyline 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) (holding GOLDENER TROPFEN deceptive for wines, in view of evidence of the international renown of the Goldtropfchen vineyard of West Germany, 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. Int'l Better Drinks Corp.*, 6 USPQ2d 1610, 1616 (TTAB 1988) (holding COLAGNAC deceptive for cola-flavored liqueur containing Spanish brandy, concluding that purchasers were likely to believe that applicant's goods contained COGNAC brandy); *In re Shapely, Inc.*, 231 USPQ 72 (TTAB 1986) (holding SILKEASE 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) (holding BAHIA 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 Prods. Co. v. Boise Cascade Corp.*, 218 USPQ 160 (TTAB 1983) (holding CEDAR RIDGE deceptive for embossed hardboard siding not made of cedar); *In re Intex Plastics Corp.*, 215 USPQ 1045 (TTAB 1982) (holding TEXHYDE deceptive as applied to synthetic fabric for use in the manufacture of furniture, upholstery, luggage, and the like); *Tanners' Council of Am., Inc. v. Samsonite Corp.*, 204 USPQ 150 (TTAB 1979) (holding SOFTHIDE deceptive for imitation leather material); *In re Salem China Co.*, 157 USPQ 600 (TTAB 1968) (holding AMERICAN LIMOGES, used on dinnerware that was neither made in Limoges, France, nor made from Limoges clay, deceptive because of the association of Limoges with fine quality china); *Co. of Cutlers of Hallamshire in the Cnty. of York v. Regent-Sheffield, Ltd.*, 155 USPQ 597 (TTAB 1967) (holding SHEFFIELD, used on cutlery not made in Sheffield, England, deceptive because of the renowned status of Sheffield in relation to cutlery); *In re U.S. Plywood Corp.*, 138 USPQ 403 (TTAB 1963) (holding IVORY WOOD, for lumber and timber products, 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: *In re Tapco Int'l Corp.*, 122 USPQ2d 1369 (TTAB 2017) (holding KLEER MOULDINGS and KLEER TRIMBOARD not deceptive, because there was no evidence as to the likely consumer perception of the term "clear" (or KLEER) when used in connection with the identified PVC building products and thus the record did not establish that the term misdescribes the goods); *Philip Morris Inc. v. Reemtsma Cigarettenfabriken GmbH*, 14 USPQ2d 1487 (TTAB 1990) (holding PARK AVENUE neither deceptive nor geographically deceptively misdescriptive as applied to applicant's cigarettes and smoking tobacco, 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) (holding WOOLRICH for clothing not made of wool not to be deceptive under §2(a)); *In re Fortune Star Prods. Corp.*, 217 USPQ 277 (TTAB1982) (holding NIPPON, for radios, televisions, and the like, 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 (TTAB1968) (holding SWEDEN and design, for which registration was sought under §2(f) for external artificial kidney units, not deceptive, 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 Prods., Inc.*, 135 USPQ 459 (TTAB1962) (holding COPY CALF, for wallets and billfolds of synthetic and plastic material made to simulate leather, not deceptive, 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 That May Falsely Suggest a Connection

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, falsely suggests a connection with them.

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.*, 703 F.2d 1372, 1375-76, 217 USPQ 505, 508-09 (Fed. Cir. 1983) (footnotes omitted), *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. 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." *See U.S. Olympic Comm. v. Tempting Brands Neth. B.V.*, 2021 USPQ2d 164, at *20 (TTAB 2021) (quoting *In re Nieves & Nieves LLC*, 113 USPQ2d 1639, 1643 (TTAB 2015)). 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." *Univ. of Notre Dame du Lac*, 703 F.2d at 1376-77, 217 USPQ at 509; *In re ADCO Indus. – Techs. L.P.* , 2020 USPQ2d 53786, at *3-4 (TTAB 2020) (citing *In re Nieves & Nieves LLC*, 113 USPQ2d at 1643). A party's interest in a name or designation does not depend upon adoption and use as a technical trademark or trade name. *Univ. of Notre Dame du Lac*, 703 F.2d at 1375-77, 217 USPQ at 508-09; *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428, 429 (TTAB 1985). Section 2(a) protection is intended primarily to prevent the unauthorized use of the persona of a person or institution and not to protect the public. *In re Int'l Watchman, Inc.*, 2021 USPQ2d 1171, at *3 (TTAB 2021) (quoting *Bridgestone/Firestone Rsch. Inc. v. Auto. Club De L'Ouest De La Fr.*, 245 F.3d 1359, 1363, 58 USPQ2d 1460, 1463-64 (Fed. Cir. 2001)).

Moreover, 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. *See In re Sauer*, 27 USPQ2d 1073, 1074 (TTAB 1993) (finding that "Bo Jackson has achieved great fame and notoriety, so that when his nickname is used as part of the 'Bo Ball' and design mark on applicant's goods, purchasers will likely make a connection between him and applicant's products"); *see also Buffett*, 226 USPQ at 430 (finding 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").

See TMEP §§1203.03(b)–1203.03(b)(iii) 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) Definitions

1203.03(a)(i) "Persons"

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 "persons" in §2(a) refers to real persons, not fictitious characters. It also encompasses groups of persons. *See Matal v. Tam*, 137 S. Ct. 1744, 122 USPQ2d 1757 (2017). 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. *In re MC MC S.r.l.*, 88 USPQ2d 1378 (TTAB 2008) (holding MARIA CALLAS not to falsely suggest a connection with deceased opera singer Maria Callas); *Lucien Piccard Watch Corp. v. Since 1868 Crescent Corp.*, 314 F. Supp. 329, 165 USPQ 459 (S.D.N.Y. 1970) (holding DA VINCI not to falsely suggest a connection with deceased artist Leonardo Da Vinci). *See*TMEP §1203.03(b)(i) regarding elements of a §2(a) false suggestion of a connection refusal.

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 Section 2(a) after his or her death unless heirs or other successors are entitled to assert that right." *U.S. Olympic Comm. v. Tempting Brands Neth. B.V.*, 2021 USPQ2d 164, at *20 (TTAB 2021) (quoting *In re MC MC S.r.l.*, 88 USPQ2d at 1380). 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." *In re MC MC S.r.l.*, 88 USPQ2d at 1380. Any doubt regarding the existence of heirs or successors with such rights must be resolved in favor of the applicant. *See id.*, at 1381.

In addition to natural persons, §2(a) includes juristic persons, that is, 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 Merch. Co. v. "21" Club, Inc.*, 343 F.2d 1011, 145 USPQ 203 (C.C.P.A. 1965); *John Walker & Sons, Ltd. v. Am. Tobacco Co.*, 110 USPQ 249 (Comm'r Pats. 1956); *Copacabana, Inc. v. Breslauer*, 101 USPQ 467 (Comm'r Pats. 1954). Juristic persons do not have to be well known to be protected from the registration of a mark that falsely suggests a connection with them. *See generally Gavel Club v. Toastmasters Int'l*,127 USPQ 88, 94 (TTAB1960) (noting that §2(a) protection is not limited to large, well known, or nationally recognized institutions). However, there must be a legal successor to assert the rights of a defunct juristic person or otherwise those rights are extinguished when the juristic person becomes bankrupt or ceases to exist without an assignment of interest to another. *Pierce-Arrow Soc'y*, 2019 USPQ2d 471774, at *6-7 (TTAB 2019) (following *In re Wielinski*, 49 USPQ2d 1754, 1758 (TTAB 1998), *overruled on other grounds, In re WNBA Enters., LLC*, 70 USPQ2d 1153 (TTAB 2003)).

Section 45 of the Act, 15 U.S.C. §1127, also defines "person" to include the United States and its agencies and instrumentalities, as well as any state:

> 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.

It is well settled that the U.S. government is a "person" within the meaning of §2(a). 15 U.S.C. §1127; *FBI v. Societe: "M.Bril & Co.*", 172 USPQ 310, 313 (TTAB 1971). Therefore, the common names of, and acronyms for, U.S. government agencies and instrumentalities are considered persons. *SeeIn re Peter S. Herrick P.A.*, 91 USPQ2d 1505, 1506-08 (TTAB 2009) (stating the statutory definition of "person" includes the United States and any agency or instrumentality thereof and concluding that "[t]he only entity the name 'U.S. Customs Service' could possibly identify is the government agency" formerly known as the U.S. Customs Service and now known as U.S. Customs and Border Protection); *NASA v. Record Chem. Co.*, 185 USPQ 563, 566 (TTAB 1975) (finding the National Aeronautics and Space Administration (NASA) is a juristic person); *FBI*, 172 USPQ at 313 (noting the Federal Bureau of Investigation (FBI) is a juristic person).

1203.03(a)(ii) "Institutions"

The term "institution" has been broadly construed. *See In re Shinnecock Smoke Shop*, 571 F.3d 1171, 1173, 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 defined "institution" as "[a]n established organization," and defined "organization" as a "body of persons . . . formed for a common purpose"); *In re Int'l Watchman, Inc.*, 2021 USPQ2d 1171, at *9-11 (TTAB 2021) (finding the North Atlantic Treaty Organization, which is an intergovernmental organization and military alliance of the United States and other North American and European countries, "qualifies as an 'institution' under Section 2(a)"); *U.S. Olympic Comm. v. Tempting Brands Neth. B.V.*, 2021 USPQ2d 164, at *15 (TTAB 2021) ("the record in this case supports the finding previously made by the Board that 'the 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'") (quoting *In re Urbano*, 51 USPQ2d 1776, 1779 (TTAB 1999)); *In re White*, 73 USPQ2d 1713, 1718 (TTAB 2004) ("each federally recognized Apache tribe is necessarily either a juristic person or an institution").

In addition to qualifying as a person, United States government agencies and instrumentalities, as identified by their common names and acronyms, also may be considered institutions within the meaning of §2(a). *See In re Peter S. Herrick P.A.*, 91 USPQ2d 1505, 1506 (TTAB 2009) ("Institutions, as used in Section 2(a), include government agencies."); *In re Cotter & Co.*, 228 USPQ 202, 204-05 (TTAB1985) (finding the United States Military Academy is an institution and West Point or Westpoint "has come to be solely associated with and points uniquely to the United States Military Academy"). The common names of, and acronyms and terms for, United States government programs may also be considered institutions, depending on the evidence of record. *SeeIn re N. Am. Free Trade Ass'n*, 43 USPQ2d 1282, 1285-86 (TTAB1997) (finding "NAFTA [the acronym for the North American Free Trade Agreement] is an institution, in the same way that the United Nations is an institution," and noting that the "legislative history . . . indicates that the reference to an 'institution' in Section 2(a) was designed to have an expansive scope."); *NASA v. Record Chem. Co.*, 185 USPQ 563, 565 (TTAB1975) (finding NASA's Apollo space program is an institution).

Institutions do not have to be large, well known, or "national" to be protected from the registration of a mark that falsely suggests a connection with them. *Gavel Club v. Toastmasters Int'l*, 127 USPQ 88, 94 (TTAB 1960).

While the §2(a) prohibition against the registration of matter that may falsely suggest a connection with institutions 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 and **Appendix C** (setting forth a nonexhaustive list of U.S. statutes protecting designations of certain government agencies and instrumentalities).

1203.03(a)(iii) "National Symbols"

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 Consol. Foods Corp.*, 187 USPQ 63, 64 (TTAB 1975) (noting national symbols include the bald eagle, Statue of Liberty, designation "Uncle Sam" and the unique human representation thereof, the heraldry and shield designs used in governmental offices, and certain uses of the letters "U.S."). National symbols include the symbols of foreign countries as well as those of the United States. *In re Anti-Communist World Freedom Cong., Inc.*, 161 USPQ 304, 305 (TTAB1969).

"National symbols" cannot be equated with the "insignia" of nations, which are prohibited from registration under §2(b).

> 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 . . . used as falsely to suggest a connection between the holder of the mark and the symbol.

Liberty Mut. Ins. Co. v. Liberty Ins. Co. of Texas, 185 F. Supp. 895, 908, 127 USPQ 312, 323 (E.D. Ark. 1960). See TMEP §1204 regarding insignia.

Trademark Act Section 2(a) does not prohibit registration of marks comprising national symbols; it only prohibits registration of matter that may falsely suggest a connection with them. *Liberty Mut. Ins. Co.*, 185 F. Supp. at 908, 127 USPQ at 323 (finding marks comprising portion of the Statue of Liberty not to 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).

Some designations have been held to be national symbols within the meaning of §2(a). *E.g.*, *In re Anti-Communist World Freedom Cong.*, 161 USPQ at 304 (holding a representation of a hammer and sickle to be a national symbol of the Union of Soviet Socialist Republics (U.S.S.R.)); *In re Nat'l 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").

Other designations have been held not to be national symbols within the meaning of §2(a). *E.g.*, *NASA v. Bully Hill Vineyards, Inc.*, 3 USPQ2d 1671 (TTAB 1987) (holding SPACE SHUTTLE 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. Int'l Multifoods Corp.*, 211 USPQ 165, 170-71 (TTAB1981) , *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 Mohawk Air Serv. Inc.*, 196 USPQ 851, 854 (TTAB1977) (stating MOHAWK is not immediately suggestive of the United States and, therefore, not a national symbol); *In re Consol. Foods Corp.*, 187 USPQ 63 (TTAB1975) (holding OSS, the acronym for the Office of Strategic Services, not to

constitute a national symbol); *In re Gen. Mills, Inc.*, 169 USPQ 244 (TTAB1971) (finding 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, did not suggest a particular country, the Board noting that it could consider only the matter for which registration was sought).

The name of a country is not a national symbol within the meaning of §2(a) of the Trademark Act nor does use of the name of a country as a mark, by itself, amount to deception or a "false connection" under §2(a). *In re Fortune Star Prods. Corp.*, 217 USPQ 277, 277 (TTAB 1982) (citing *In re Sweden Freezer Mfg. Co.*, 159 USPQ 246, 248-49 (TTAB 1968)).

The common names of, and acronyms for, government agencies and instrumentalities are not considered to be national symbols. *In re Consol. Foods*, 187 USPQ at 64 (holding OSS, acronym for the Office of Strategic Services, not a national symbol but rather merely designates a particular and long-defunct government agency).

While the prohibition of §2(a) against the registration of matter that may falsely suggest a connection with national symbols 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 and **Appendix C**.

1203.03(b) 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)(i) regarding persons, TMEP §1203.03(a)(ii) regarding institutions, TMEP §1203.03(a)(iii) regarding national symbols, and TMEP §1203.03 for information about the legislative history of §2(a).

1203.03(b)(i) Elements of a §2(a) False Suggestion of a Connection Refusal

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.

Piano Factory Grp., Inc. v. Schiedmayer Celesta GmbH, 11 F.4th 1363, 1377, 2021 USPQ2d 913, at *11 (Fed. Cir. 2021) (citing *In re Jackson*, 103 USPQ2d 1417, 1419 (TTAB 2012)); *U.S. Olympic Comm. v. Tempting Brands Neth. B.V.*, 2021 USPQ2d 164, at *17-18 (TTAB 2021) (citing *Pierce-Arrow Soc'y v. Spintek Filtration, Inc.*, 2019 USPQ2d 471774, at *4 (TTAB 2019)); *see In re ADCO Indus. – Techs., L.P.*, 2020 USPQ2d 53786, at *3 (TTAB 2020); *In re Pedersen*, 109 USPQ 2d 1185, 1188-89 (TTAB 2013); *In re Jackson Int'l Trading Co. Kurt D. Bruhl GmbH & Co. KG*, 103 USPQ2d 1417, 1419 (TTAB 2012); *In re Peter S. Herrick, P.A.*, 91 USPQ2d 1505, 1507 (TTAB 2009); *In re MC MC S.r.l.*, 88 USPQ2d 1378, 1379 (TTAB 2008); *Ass'n Pour La Def. et la Promotion de L'Oeuvre de Marc Chagall dite Comite Marc Chagall v. Bondarchuk*, 82 USPQ2d 1838, 1842 (TTAB 2007); *In re White*, 80 USPQ2d 1654, 1658 (TTAB

2006); *In re White*, 73 USPQ2d 1713, 1718 (TTAB 2004); *In re Nuclear Rsch. 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); *see also Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 1375-77, 217 USPQ 505, 508-10 (Fed. Cir. 1983) (providing foundational principles for the four-part test used to determine false connection).

First element. The term at issue need not be the actual, legal name of the party falsely associated with the applicant's mark. *See, e.g., NPG Recs., LLC v. JHO Intell. Prop. Holdings LLC*, 2022 USPQ2d 770, at *6, *15 (TTAB 2022) (finding PURPLE RAIN, the name of a well-known song and album written and performed by Prince and the title of a motion picture scored by and starring Prince, to be "synonymous with Prince"); *Hornby v. TJX Cos.*, 87 USPQ2d 1411, 1417, 1424 (TTAB 2008) (finding TWIGGY to be the nickname of professional model Lesley Hornby); *Buffett v. Chi Chi's, Inc.*, 226 USPQ at 429-30 (finding MARGARITAVILLE, the name of a well-known song written and performed by Jimmy Buffett, to be the public persona of singer Jimmy Buffett). "[A] nickname or an informal reference, even one created by the public, can qualify as an entity's 'identity,' thereby giving rise to a protectable interest." *Bos. Athletic Ass'n v. Velocity, LLC*, 117 USPQ2d 1492, 1496 (TTAB2015).A term may also be considered the identity of a person "even if the person has not used that term." *In re ADCO Indus. – Techs., L.P.*, 2020 USPQ2d 53786, at *4 (citing *In re Nieves & Nieves LLC*, 113 USPQ2d 1629, 1644 (TTAB 2015); *In re Urbano*, 51 USPQ2d 1776, 1779 (TTAB 1999)). In addition, the fact that a term identifies both a particular group of people and the language spoken by some of the members of the group is not evidence that it fails to identify the group. *In re Pedersen*, 109 USPQ 2d at 1190 (rejecting applicant's argument that, because the term LAKOTA identifies a language, it does not approximate the name or identity of a people or institution).

Second element. 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. *In re Jackson Int'l Trading Co. Kurt D. Bruhl GmbH & Co. KG*, 103 USPQ2d at 1419, 1420; *Hornby*, 87 USPQ2d at 1426. Rather, the question is whether, as used with the goods or services in question, consumers would view the mark as pointing uniquely to the person or institution, or whether they would perceive it to have a different meaning. *E.g., Univ. of Notre Dame du Lac*, 703 F.2d at 1377, 217 USPQ at 509 (finding NOTRE DAME did not point uniquely and unmistakably to the appellant, the University of Notre Dame in Indiana, because the name identifies a famous religious figure and is used in the names of churches dedicated to this figure such as the Cathedral of Notre Dame in Paris, France); *Schiedmayer Celesta GmbH v. Piano Factory Grp., Inc.*, 2019 USPQ2d 341894, at *7 (TTAB 2019) (quoting *In re White*, 73 USPQ2d at 1720) (finding SCHIEDMAYER pointed uniquely and unmistakably to petitioner based on evidence that the name had been associated with a family prominent in the keyboard musical instrument industry for hundreds of years and had no other meaning), *aff'd*, 11 F.4th 1363, 2021 USPQ2d 913 (Fed. Cir. 2021);*Hornby*, , 87 USPQ2d at 1427 (finding TWIGGY pointed uniquely and unmistakably to petitioner, who was recognized as a famous British model, and that the dictionary meaning of "twiggy" as resembling or abounding in twigs would not be the consumers' perception of the name for respondent's children's clothing).

In addition, unassociated third-party use of a term does not in and of itself establish that that the term does not point uniquely or unmistakably to a particular person or institution. *See In re Pedersen*, 109 USPQ2d at 1196 (finding consumer exposure to third-party use of LAKOTA on products and services unrelated to applicant's insufficient to show that applicant's use of LAKOTA did not point uniquely to the Lakota people); *Hornby*, 87 USPQ2d at 1427 (finding evidence of third-party registrations showing registration of the term "TWIGGY" for goods unrelated to children's clothing had "no probative value"); *cf. NPG Recs., LLC v. JHO Intell. Prop. Holdings*, 2022 USPQ2d 770, at *19 (finding applicant's evidence of three third-party registrations for items related to the goods in applicant's application insufficient to show that PURPLE RAIN did not point uniquely to opposer).

Third element. A connection with an entity is established when the record establishes a specific endorsement, sponsorship, or the like of the particular goods and services, whether written or implied. *In re White*, 80 USPQ2d 1654, at 1660-61. In *In re Sloppy Joe's International Inc.*, 43 USPQ2d 1350, 1353-54 (TTAB1997), 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 did not establish the kind of "connection" that entitled applicant to register a mark consisting in part of a portrait of Hemingway. 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. *Id*.

If it is unclear whether the person or institution is connected with the goods sold or services performed by the applicant, the examining attorney must make an explicit inquiry under 37 C.F.R. §2.61(b). If the examining attorney independently confirms that the person or institution is connected with the goods sold or services performed by the applicant, a Note to the File must be entered in the record to reflect that no further action is required as to the issue of false suggestion of a connection. *See*TMEP §710.02.

Fourth element. To establish the fame or reputation of the person or institution under this factor, one is not required to show the fame or reputation of the name "in the entire United States." *Ass'n Pour la Defense et la Promotion de L'Oeuvre de Marc Chagall Dite Comite Marc Chagall v. Bondarchuk*, 82 USPQ2d at 1843, 1844 (finding the evidence sufficiently showed the fame and reputation of Russian artist Marc Chagall where his work had been featured in exhibits in several major U.S. cities in several regions as well as in permanent public displays, including large stained glass windows installed at the United Nations).

Further, the Court of Appeals for the Federal Circuit has stated

> [A] party's name may be famous among the particular consumers of those goods and services even if it is not famous among members of the general public. And a party's name may be associated with particular goods such that a false association may be established with goods or services of that type even if it would not have been established with respect to entirely different goods or services.

Piano Factory Grp., Inc., 11 F.4th at 1380, 2021 USPQ2d 913, at *14-15 (citing *In re Nieves & Nieves*, LLC, 113 USPQ2d at 1633; *In re Pedersen*, 109 USPQ2d at 1202; *U.S. Navy v. U.S. Mfg. Co.*, 2 USPQ2d 1254, 1260 (TTAB 1987); 7 Louis Altman & Mall Pollack, *Callmann on Unfair Competition, Trademarks & Monopolies* §26.21, at 26-103-04 (4th ed. 2021)).

Intent. 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 (TTAB1987); *Consol. Natural Gas Co. v. CNG Fuel Sys., 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. *Piano Factory Grp. Inc.*, 11 F.4th at 1380-81, 2021 USPQ2d 913, at *15 (citing *Univ. of Notre Dame du Lac*, 703 F.2d at 1377, 217 USPQ at 509; *In re Pedersen*, 109 USPQ2d at 1202; *In re Peter S. Herrick, P.A.*, 91 USPQ2d at 1509; *Ass'n Pour la Defense et la Promotion de L'Oeuvre de Marc Chagall Dite Comite Marc Chagall*, 82 USPQ2d at 1843).

Prior user. 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. *In re Nuclear Rsch. Corp.*, 16 USPQ2d at 1317 (citing *In re Mohawk Air Servs., Inc.*, 196 USPQ 851, 854-55 (TTAB 1977)); *see In re Wielinski*, 49 USPQ2d 1754, 1758 (TTAB 1998) (citing *In re Kayser-Roth Corp.*, 29 USPQ2d 1379, 1384-85 (TTAB 1993); *Kardex Sys., Inc. v. Sistemco N.V.*, 221 USPQ2d 149, 151 (TTAB 1983)). However, it is not necessary that the prior user ever commercially exploit the name as a trademark or in a manner analogous to trademark

use. *In re Pedersen*, 109 USPQ2d at 1193; *see In re ADCO Indus. – Techs., L.P.*, 2020 USPQ2d 53786, at *4. A false suggestion of a connection may be found when the party's right to control the use of its identity is violated, even if there is no juristic entity having the authority to authorize use of the mark. *In re Pedersen*, 109 USPQ2d at 1193.

1203.03(b)(ii) Government Agencies and Instrumentalities

Registration of matter that may falsely suggest a connection with a United States government agency or instrumentality is prohibited under §2(a). *See* TMEP §1203.03(b)(i) (setting out the four-element test). Some names, acronyms, titles, terms, and symbols of United States government agencies or instrumentalities are also protected by separate statute. See TMEP §1205.01 for information about statutorily protected matter and **Appendix C** for a nonexhaustive list of United States statutes protecting designations of certain government agencies and instrumentalities. Many of these statutes allow third parties to use the protected matter when authorized by an agency official. This authorization to use, by itself, should not be construed to extend to authorization to register marks that include matter the applicant does not own. See generally TMEP §1201 regarding the ownership requirement. Where it appears from the record that the applicant is not the agency or instrumentality referenced in the mark, but the record suggests an affiliation between the applicant and the referenced agency, the examining attorney must require the applicant to establish its authorization to register the mark by requesting information pursuant to 37 C.F.R. §2.61(b). *See*TMEP §1201.06(c).

Registration must be refused if the nature of the mark and the nature of the goods or services is such that a United States government agency or instrumentality would be presumed to be the source or sponsorship of the applicant's goods or services. *In re Peter S. Herrick, P.A.*, 91 USPQ2d 1505, 1507-08 (TTAB2009) (finding "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 Nat'l Intelligence Acad.*, 190 USPQ 570, 572 (TTAB1976) (stating NATIONAL INTELLIGENCE ACADEMY, for educational and instructional services in intelligence gathering for law enforcement officers, falsely suggests a connection with the United States government since intelligence gathering is a known function of a number of government agencies and "[a] normal outgrowth and development of such activities would be the training of officers in intelligence gathering"); *In re Teasdale Packing Co.*, 137 USPQ 482 (TTAB1963) (holding U. S. AQUA and design 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).

The record must include evidence showing that the designation in the mark references the agency or instrumentality and that the goods or services are such that a connection with that agency or instrumentality would be presumed, particularly when it is not readily apparent that the wording or acronym in the mark refers to the agency or instrumentality. *Compare In re Mohawk Air Serv. Inc.*, 196 USPQ 851, 855 (TTAB 1977) (holding MOHAWK 298, for airplanes, to not falsely suggest a connection with the U.S. Army and the Army's use of the term "Mohawk" to identify one of its airplanes, since there was no evidence of record that the Army continuously used the term since 1958, that the public was aware of such use, or that the public would associate "Mohawk" named airplanes with the U.S. Army), *with In re U.S. Bicentennial Soc'y*,

197 USPQ 905, 906-07 (TTAB 1978) (holding U.S. BICENTENNIAL SOCIETY, for ceremonial swords, to falsely suggest a connection with the American Revolution Bicentennial Commission and the United States government, based on applicant's claims in the specimen of record and the fact that "swords have historically been presented by grateful sovereigns and governments to persons who have been honored by such gifts and that ceremonial swords are on display in the museum at Mt. Vernon").

Furthermore, the question of the registrability of a mark under §2(a) "is determined in each case by the nature of the goods or services in connection with which the mark is used and the impact of such use on the purchasers of goods or services of this type." *NASA v. Record Chemical Co. Inc.*, 185 USPQ 563, 568 (TTAB1975). Thus, the identified goods or services must be scrutinized in the context of the current marketplace to determine whether they are of the type to be offered by United States government agencies and instrumentalities. For instance, if the evidence supports a finding that it is commonplace for government agencies to sell or license the sale of consumer merchandise featuring agency names or acronyms, such as clothing, toys, key chains, and calendars, a false connection with a government agency would be presumed if that agency name or acronym is used in connection with those goods and, therefore, the mark should be refused registration under §2(a).

The §2(a) false suggestion of a connection refusal and the procedures stated above also apply to marks containing names of, and acronyms and terms for, United States government programs (e.g., Medicare or FAFSA), military projects (e.g., BigDog), and quasi-government organizations (e.g., Smithsonian Institution). The examining attorney may also require the applicant to provide additional information about the mark and/or the goods or services, under Trademark Rule 2.61(b). 37 C.F.R. §2.61(b).

Disclaiming the name of, or acronym for, the United States government agency or instrumentality to which the mark refers generally will not overcome the §2(a) refusal. See TMEP §1213.03(a) regarding unregistrable components of marks. If the test for false suggestion of a connection under §2(a) is not met, the examining attorney must still determine whether the applicant is authorized to register the designation in the mark. If, based on the record, the applicant lacks authorization from the government agency or instrumentality to register the mark, the examining attorney must refuse under §§1 and 45 of the Trademark Act. *See*TMEP §1201.06(c).

1203.03(b)(iii) False Suggestion of a Connection: Case References

Some designations have been held to falsely suggest a connection to a person or an institution within the meaning of §2(a). *E.g., Piano Factory Grp., Inc. v. Schiedmayer Celesta GmbH*, ___ F.4th ___, 2021 USPQ2d 913, at 15-16 (Fed. Cir. 2021) (holding SCHIEDMAYER for pianos falsely suggests a conection with the well-known Schiedmayer Celesta GmbH business that has manufactured and sold quality keyboard musical instruments for nearly 300 years); *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 91 USPQ2d 1218 (Fed. Cir. 2009) (holding SHINNECOCK BRAND FULL FLAVOR and SHINNECOCK BRAND LIGHTS, both for cigarettes, falsely suggest a connection with the Shinnecock Indian Nation); *In re ADCO Indus. – Techs., L.P.*, 2020 USPQ2d 53786 (TTAB 2020) (holding TRUMP-IT MY PACKAGE OPENER MAKE OPENING PACKAGES GREAT and design and TRUMP-IT MY PACKAGE OPENER and design, both for utility knives, falsely suggest a connection with Donald Trump); *In re Jackson Int'l Trading Co. Kurt D. Bruhl GmbH & Co. KG*, 103 USPQ2d 1417 (TTAB 2012) (holding BENNY GOODMAN COLLECTION THE FINEST QUALITY (stylized) for fragrance and cosmetics falsely suggests a connection with the deceased musician Benny Goodman; the record showed that Benny Goodman's estate had a business representative that granted people the use of his name and/or persona); *In re Peter S. Herrick, P.A.*, 91 USPQ2d 1505 (TTAB 2009) (holding U.S. CUSTOMS SERVICE and seal design for attorney services falsely suggests a connection with the government agency formerly known as the U.S. Customs Service and now known as the U.S. Customs and Border Protection); *Hornby v. TJX Cos.*, 87 USPQ2d 1411 (TTAB2008)

(holding TWIGGY for children's clothing falsely suggests 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); *Ass'n Pour La Def. et la Promotion de L'Oeuvre de Marc Chagall dite Comite Marc Chagall v. Bondarchuk*, 82 USPQ2d 1838 (TTAB2007) (holdinig MARC CHAGALL for vodka falsely suggests a connection with the painter Marc Chagall); *In re White*, 80 USPQ2d 1654 (TTAB2006) (holding MOHAWK for cigarettes falsely suggests 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) (holding APACHE for cigarettes falsely suggests a connection with the nine federally recognized Apache tribes); *In re Urbano*, 51 USPQ2d 1776 (TTAB1999) (holding SYDNEY 2000, used for advertising and business services and communication services, falsely suggests a connection with Olympic Games, since the 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 N. Am. Free Trade Ass'n*, 43 USPQ2d 1282 (TTAB1997) (holding NAFTA, used on "promotion of trade and investment" services, falsely suggests a connection with the 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) (holding SLOPPY JOE'S, with design that includes portrait of Ernest Hemingway falsely suggests a connection with deceased writer); *In re Sauer*, 27 USPQ2d 1073 (TTAB 1993) holding BO BALL for oblong shaped leather ball with white stitching falsely suggests a connection with athlete Bo Jackson, *aff'd per curiam*, 26 F.3d 140 (Fed. Cir. 1994); *Bd. of Tr. of Univ. of Alabama v. BAMA-Werke Curt Baumann*, 231 USPQ 408 (TTAB 1986) (granting petition to cancel registration of BAMA, for shoes, slippers, stockings because BAMA pointed uniquely to the University of Alabama and thus falsely suggests a connection with the University); *In re Cotter & Co.*, 228 USPQ 202 (TTAB 1985) (holding WESTPOINT, for shotguns and rifles, falsely suggests a connection with an institution, the U.S. Military Academy); *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB1985) (denying applicant's motion for summary judgment since evidence of record supported an association of MARGARITAVILLE with the public persona of opposer Jimmy Buffett); *In re U.S. Bicentennial Soc'y*, 197 USPQ 905 (TTAB 1978) (holding U.S. BICENTENNIAL SOCIETY, for ceremonial swords, falsely suggests a connection with the American Revolution Bicentennial Commission and the U.S. government); *In re Nat'l Intelligence Acad.*, 190 USPQ 570 (TTAB 1976) (holding NATIONAL INTELLIGENCE ACADEMY, for educational and instructional services in intelligence gathering for law enforcement officers, falsely suggests a connection with the U.S. government); *In re Nat'l Collection & Credit Control*, 152 USPQ 200 (TTAB1966) (holding the word "national" along with an outline representation of the United States or a representation of an eagle, for collection and credit services, falsely suggests a connection with the U.S. government).

Other designations have been held not to falsely suggest a connection to a person or institution within the meaning of §2(a). *E.g., Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 1377, 217 USPQ 505, 509 (Fed. Cir. 1983) (holding NOTRE DAME and design, for cheese, 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."), *aff'g* 213 USPQ 594 (TTAB 1982); *U.S. Olympic Comm. v. Tempting Brands Neth. B.V.*, 2021 USPQ2d 164, at *2-3, 22, 32-33 (TTAB 2021) (holding PIERRE DE COUBERTIN for a variety of personal goods, including toiletries, jewelry, and clothing, not to falsely suggest a connection with opposer the U.S. Olympic Committee because, although Coubertin is widely recognized for launching the Olympic movement in the late 19th century, evidence did not show his name pointing uniquely to the USOC or the Olympic movement); *Pierce-Arrow Soc'y v. Spintek Filtration*,

Inc., 2019 USPQ2d 471774, at *6-8 (TTAB 2019) (holding PIERCE-ARROW for automobilies not to falsely suggest a connection with the Pierce-Arrow Society because the evidence did not show the society was a legal successor of the Pierce-Arrow Motor Car Company, the sociey's preservation efforts of the car made by and protection of the marks of that company did not uniquely point to the society, and the former company and its abandoned trademarks were not famous or had any reputation that transferred to the society); *Bos. Athletic Ass'n v. Velocity, LLC*, 117 USPQ2d 1492, 1496-99 (TTAB 2016) (oholding MARATHON MONDAY for clothing not to falsely suggest a connection with opposer because the evidence did not establish that MARATHON MONDAY is perceived by the relevant public as a close approximation of the name or identity of opposer, and frequent and various third-party uses of MARATHON MONDAY indicated that the term does not point uniquely and unmistakably to opposer); *In re MC MC S.r.l.*,88 USPQ2d 1378, 1381 (TTAB2008) holding MARIA CALLAS for jewelry and other goods not to falsely suggest a connection with Maria Callas, the famous deceased opera singer, her heirs or her estate 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); *In re L.A. Police Revolver & Athletic Club, Inc.*, 69 USPQ2d 1630 (TTAB2004) (holding slogan TO PROTECT AND TO SERVE, used by applicant Los Angeles Police Revolver and Athletic Club, Inc., not to 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); *Internet Inc. v. Corp. for Nat'l Resch. Initiatives*, 38 USPQ2d 1435 (TTAB1996) (holding cancellation petitioners failed to state claim for relief where they had not alleged, and could not 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 (TTAB1990) (holding RIT-Z in stylized form for toilet seats not to falsely suggest a connection with opposer, where there was no evidence showing a connection between applicant's mark and opposer corporation, The Ritz Hotel Limited); *In re Nuclear Rsch. Corp.*, 16 USPQ2d 1316 (TTAB1990) (holding NRC and design, for radiation and chemical agent monitors, electronic testers, and nuclear gauges, 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) (dismissing opposition to the registration of SPACE SHUTTLE for wines and holding "shuttle" to be a generic term for a space vehicle or system; "[w]here 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" of connection); *In re Mohawk Air Serv. Inc.*, 196 USPQ 851 (TTAB1977) (holding MOHAWK 298 not to falsely suggest a connection with the U.S. Army and the Army's use of the term "Mohawk" to identify one of its airplanes, since there was no evidence that the Army continuously used that term since 1958, the public was aware of such use, or the public would associate "Mohawk" named airplanes with the Army); *NASA v. Record Chem. Co.*, 185 USPQ 563 (TTAB1975) (dismissing opposition to registrations of APOLLO 8 for moth preventatives and mothproofing agent-air freshener because, while NASA is a juristic person and prior user of the terms APOLLO and APOLLO 8 for its space missions, it is unlikely that the average purchaser of applicant's goods would assume NASA to be source or sponsorship of the goods or mistakenly believe that the goods were of NASA space exploration technology); *FBI v. Societe: "M.Bril & Co."*, 172 USPQ 310 (TTAB1971) (dismissing opposition to registration of FBI FABRICATION BRIL INTERNATIONAL for clothing since it was unreasonable that the public would assume applicant's goods originated with, were sponsored or endorsed by, or associated with the Federal Bureau of Investigation, finding that "FBI" represents "Fabrication Bril International" and purchasers would see the entire composite mark on the goods and not just "FBI," and noting that both the U.S. government and the Federal Bureau of Investigation are juristic persons); *In re Horwitt*, 125 USPQ 145, 146 (TTAB 1960) (holding U. S. HEALTH CLUB 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."); *Lucien Piccard Watch Corp. v. Since*

1868 Crescent Corp., 314 F. Supp. 329, 165 USPQ 459 (S.D.N.Y. 1970) (holding DA VINCI not to falsely suggest a connection with deceased artist Leonardo Da Vinci).

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

15 U.S.C. §1052 (Extract)

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 of the United States, or of any foreign nation. *See Ceccato v. Manifattura Lane Gaetano Marzotto & Figli, S.p.A.*, 32 USPQ2d 1192, 1196 (TTAB 1994) (noting that "it would appear that the reference to 'municipality' in the Statute is to a municipality in the United States, and that prohibition of registration with respect to foreign coats of arms, etc., is to those of the countries themselves, rather than to those of the states or municipalities of the foreign countries"). Moreover, registration of all such official insignia is barred regardless of the identity of the applicant, that is, the statutory prohibition allows no exception even when the applicant is a government entity seeking to register its own flag, coat of arms, or other insignia. *See In re City of Hous.*, 731 F.3d 1326, 1331, 108 USPQ2d 1226, 1229 (Fed. Cir. 2013); *In re Cnty. of Orange*, 2022 USPQ2d 733, at *18-25 (TTAB 2022), *appeal docketed*, No. 23-1004 (Fed. Cir. Oct. 4, 2022).

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." *In re Ala. Tourism Dep't*, 2020 USPQ2d 10485, at *2 (TTAB 2020) (quoting *In re Fam. Emergency Room LLC*, 121 USPQ2d 1886, 1887 (TTAB 2017)); *In re Advance Indus. Sec., Inc.*, 194 USPQ 344, 346 (TTAB 1977). 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 Ala. Tourism Dep't*, 2020 USPQ2d 10485, at *2 (quoting *In re Fam. Emergency Room LLC*, 121 USPQ2d at 1887);*In re Waltham Watch Co.*, 179 USPQ 59, 60 (TTAB 1973). The focus is on the general recollection of the flag or insignia by purchasers, "without a careful analysis and side-by-side comparison." *In re Ala. Tourism Dep't*, 2020 USPQ2d 10485, at *2 (quoting *In re Fam. Emergency Room LLC*, 121 USPQ2d at 1888); *In re Advance Indus. Sec.*, 194 USPQ at 346.

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) (holding 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"); *In re Advance Indus. Sec.*, 194 USPQ at 346 (finding 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"); *In re Waltham Watch Co.*, 179 USPQ at 60 (finding mark comprising wording with the design of a globe and flags not to be a simulation of the flags of Switzerland and Great Britain, 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."). Thus, marks with elements of flags in a stylized or incomplete form

are generally not refused under §2(b). *In re Ala. Tourism Dep't*, 2020 USPQ2d 10485, at *2 (quoting *In re Fam. Emergency Room LLC*, 121 USPQ2d at 1888); *In re Advance Indus. Sec.*, 194 USPQ at 346.

Section 2(b) differs from the provision of §2(a) regarding national symbols (*see*TMEP §1203.03(a)(iii)) in that §2(b) requires no additional element, such as 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." *In re Ala. Tourism Dep't*, 2020 USPQ2d 10485, at *2 (TTAB 2020) (quoting *In re Fam. Emergency Room LLC*, 121 USPQ2d 1886, 1887-88 (TTAB 2017)). 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)." *In re Ala. Tourism Dep't*, 2020 USPQ2d 10485, at *2 (quoting TMEP §1204.01(a)) (affirming the standards set forth in this section).

Generally, an examining attorney should issue a refusal if 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.

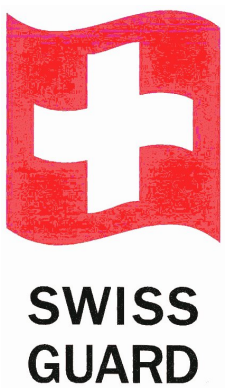
Examples of Situations Where Registration Should Be Refused. The following are examples of situations where registration should be refused, because all significant features of the flag are present or a simulation of the flag is used with state or national indicia:

Buon Giorno
Caffe

VICTORIOUS
AMERICA

AMERICAN
HOT
SAUCE

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.

See TMEP §§1205.01(d)-(d)(iii) regarding procedures for marks containing the Swiss Confederation coat of arms or flag.

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.

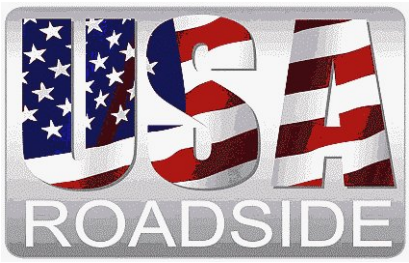
If the flag design fits one of the following scenarios, the examining attorney should not refuse registration under §2(b):

- 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.

In re Ala. Tourism Dep't, 2020 USPQ2d 10485, at *2 (TTAB 2020) (quoting TMEP §1204.01(b)) (affirming the standards set forth in this section).

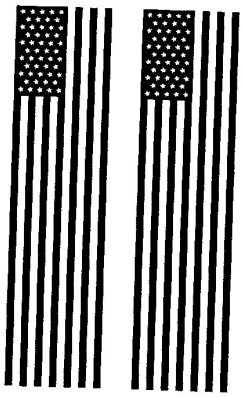
Examples. The following are examples of stylized designs that are registrable under §2(b):

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



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

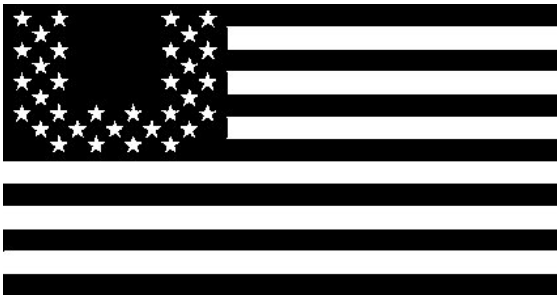
Flag Design Is Not In the Normal Flag Shape - No §2(b) Refusal



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) Case Law Finding No Simulation of a Flag

In certain cases, the Trademark Trial and Appeal Board found that the flag design was not a simulation of a particular national flag.*In re Am. 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 Maint. Orgs., Inc*., 188 USPQ 473 (TTAB 1975) (holding dark cross, with legs of equal length, having a caduceus symmetrically imposed thereon 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 or [sic] 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. Dep't of the Interior, 142 USPQ 506, 507 (TTAB 1964) (finding 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, not to be an insignia of the United States). The Trademark Trial and Appeal Board reaffirmed this interpretation in *In re Peter S. Herrick, P.A.*, 91 USPQ2d 1505 (TTAB 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 Under §2(b)

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

1204.02(c) Examples of Designs That Should Not Be Refused Under §2(b)

Designs that do not rise to the level of being emblems of national authority, or emblems of state or municipal authority, should not be refused. Exception: 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**. The amendments adding this section do not affect rights that vested before October 19, 1984. Applications claiming use after October 19, 1984 must 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) Case Law 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). *SeeIn re United States Dep't of the Interior*, 142 USPQ 506, 507 (TTAB 1964) (finding 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 Mut. Ins. Co. v. Liberty Ins. 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). *SeeIn re Brumberger Co., Inc.*, 200 USPQ 475 (TTAB 1978) (finding representation of the U.S. mailbox was 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) (finding 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 §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) (finding 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.

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.

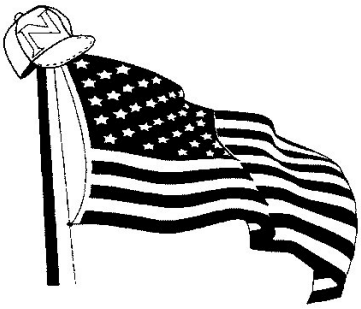
Section 44 Applications. Amendments to the drawing to delete §2(b) matter are not permitted because the drawing must be a substantially exact representation of the mark as registered in the foreign country. TMEP §1011.01.

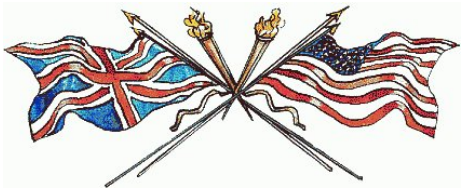
Section 66(a) Applications. Amendments to the drawing to delete the §2(b) matter are not permitted because the Madrid Protocol does not permit the amendment of a mark in an international registration. TMEP §807.13(b).

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:

- **https://www.crwflags.com/fotw/flags/**
- **https://en.wikipedia.org/wiki/Gallery_of_sovereign_state_flags**

United States, State, and Territory Flags:

- **https://en.wikipedia.org/wiki/Flags_of_the_U.S._states_and_territories**
- **https://statesymbolsusa.org/categories/state-flag**

Insignia:

- Great Seal of the United States **http://www.greatseal.com** /
- Seal of the President of the United States **https://en.wikipedia.org/wiki/Seal_of_the_President_of_the_United_States**
- Seals of Government departments - see specific agency website

Coat of Arms - Gallery of Coats of Arms:

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

Non Registration Data: X-Search and TESS

The "89" series code (i.e., serial numbers beginning with the digits "89") includes designations protected by federal statute or regulation, designations submitted to the USPTO from the IB pursuant to Article 6 *ter* of the Paris Convention, and official insignia of federally and state-recognized Native American tribes. These submissions are sometimes referred to as "non-registrations." *See*TMEP §§1205.01 1205.03.

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, including any agency or instrumentality thereof, 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 **Appendix C** for a nonexhaustive list of United States statutes protecting designations of certain government agencies and instrumentalities.

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); 707 (4-H Club); 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).

If the USPTO is made aware of a federal statute or regulation that prohibits or restricts the use of certain words, names, symbols, terms, initials, marks, emblems, seals, insignia, badges, decorations, medals, and characters, they are entered into the USPTO search records to assist USPTO examining attorneys. These designations are 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 statutory restriction should be discovered in an examining attorney's search and a copy of the statutory language may be in the search record.

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. 17 U.S.C. §§101-1332. 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) Red Cross Emblem or the designations "Red Cross" and "Geneva Cross": Under 18 U.S.C. §706, the use of the Red Cross emblem as well as the designations "Red Cross" and "Geneva Cross," or any imitation thereof, is prohibited except by the American National Red Cross, and by sanitary and hospital authorities of the armed forces of the United States. The statute carves out an exception for use of any such emblem, sign, insignia, or words that were lawfully used on or before June 25, 1948. *See In re Health Maint. Orgs., Inc.*, 188 USPQ 473 (TTAB1975) (holding mark comprising a dark cross with legs of equal length on which a caduceus is symmetrically imposed (representation of caduceus disclaimed) 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)). See TMEP §§1205.01(c)–1205.01(c)(iv) for further information.

(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. 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 Comm.*, 483 U.S. 522, 3 USPQ2d 1145 (1987) (concerning petitioner's use of "Gay Olympic Games"). See TMEP §§1205.01(b)–1205.01(b)(vii) for information about marks comprising Olympic matter.

(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 Am. Veterans Found.*, 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)–1205.01(a)(vi) for further information.

(7) *Swiss Confederation Coat of Arms*. Under 18 U.S.C. §708, use of the Swiss Confederation coat of arms as a trademark or for any other commercial purpose is prohibited. Because the statute does not specify any authorized users, no one may lawfully use the coat of arms as a trademark or service mark in the United States, unless the mark was in use on or before August 31, 1948. *See In re Health Maint. Orgs., Inc.*, 188 USPQ 473 (TTAB 1975) (holding mark comprising a dark cross with legs of equal length on which a caduceus is symmetrically imposed (representation of caduceus disclaimed) 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)). See TMEP §§1205.01(d)–1205.01(d)(iii) 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. *See*TMEP §907.

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 person, institution, belief, or national symbol specified in the statute (e.g., the United States Olympic Committee). *See*TMEP §§1203.03(b)–1203.03(b)(iii). 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.

In some instances, it may be appropriate for the examining attorney to refuse registration pursuant to §§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. For service mark applications, §3 of the Act, 15 U.S.C. §1053, must 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 must 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.

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. Geneva Distinctive Emblems Protection Act of 2006, Pub. L. No. 109-481, 120 Stat. 3666 (2007). 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. *Id.*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.

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. 18 U.S.C. §706a. 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 goods or services may include, but are not limited to, medical or first-aid assistance, religious and charitable services, clothing, and food items. 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.

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

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.

Although applications based on §1(b), §44, or §66(a) need not initially show actual use of the mark in commerce, applicants filing under these bases must have a bona fide intent to use the mark in commerce. *See*TMEP §§1008, 1009, 1101, 1102, 1904.01(c), 1904.01(d). Because "use in commerce" under the Trademark Act means "lawful use in commerce," any intended use of the mark serving as the basis for these types of applications must also be lawful. *SeeIn re Brown*, 119 USPQ2d 1350, 1351 (TTAB2016); *John W. Carson Found. v. Toilets.com, Inc.*, 94 USPQ2d 1942, 1948 (TTAB2010) ; *In re Midwest Tennis & Track Co.*, 29 USPQ2d at 1386 n.2 (TTAB1993) ; *Clorox Co. v. Armour-Dial, Inc.*, 214 USPQ 850, 851 (TTAB1982); *In re Stellar Int'l, Inc.*, 159 USPQ 48, 50-51 (TTAB 1968); *CreAgri, Inc. v. USANA Health Sciences, Inc.*, 474 F.3d 626, 630 (9th Cir. 2007) ("It has long been the policy of the PTO's Trademark Trial and Appeal Board that use in commerce only creates trademark rights when the use is lawful. . . . [W]e also agree with the PTO's policy and hold that only lawful use in commerce can give rise to trademark priority.") (citations omitted). With respect to a mark containing the Red Crescent, the Third Protocol Emblem, or the designation "Red Crescent" or "Third Protocol Emblem," actual lawful use in commerce is not possible and thus there can be no bona fide intent to lawfully use the mark in commerce. *See John W. Carson Found.*, 94 USPQ2d at 1948. Therefore, it is appropriate to issue a refusal under §§1 and 45 for applications based on §1(b), §44, or §66(a) if the facts and available evidence support the conclusion that the mark contains the prohibited symbols or wording.

1205.01(a)(iv) Applicable Refusals

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." 18 U.S.C. §706a. 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, and it is not significantly altered, stylized, or merged with other elements in the mark, the examining attorney must refuse registration under §§1 and 45, because the mark is not in lawful use in commerce, and under §2(a), if any of the following conditions exist:

the drawing or foreign registration shows the symbol in red;
the drawing is not in color, but the specimen shows the symbol in red; or
the drawing is not in color, but it includes the wording "Red Crescent" or "Third Protocol Emblem."

*See*TMEP §§1205.01(a) and 1205.01(a)(i). If the drawing shows the symbol in red, the refusals may be withdrawn if the applicant amends the drawing to a different, non-prohibited color scheme, or a non-color version of the drawing (i.e., a black-and-white or gray scale drawing), and submits a proper substitute specimen showing use of the mark in a color other than red. If the drawing is not in color, but the specimen shows the symbol in red, the refusals may be withdrawn if the applicant submits a proper substitute specimen showing use of the mark in a color other than red. *Cf.*TMEP §§1205.01(d)(i)(D), 1205.01(d)(ii)(D). A photocopy of the original specimen is not an acceptable substitute specimen.

A mark that includes a crescent or crystal design element will generally be considered registrable, and will not be refused under §§1 and 45, or under §2(a), if the applicant does not claim color as a feature of the mark and the specimen shows the symbol in a color other than red. In such cases, a statement that the mark is not used in the color red is unnecessary, and if submitted, must not be printed on the registration certificate.

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)-807.14(e)(iii) 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 Federation of Red Cross and Red Crescent Societies).

1205.01(b) Examination Procedures for Marks Comprising Matter Related to the United States Olympic Committee or the Olympics

Following passage of the Amateur Sports Act of 1978, 36 U.S.C. §380, unauthorized use of words and symbols associated with the United States Olympic Committee ("USOC") or the Olympics subjected the user to civil actions and remedies. In 1998, Congress amended the 1978 act to the Ted Stevens Olympic and Amateur Sports Act ("OASA"), 36 U.S.C. §220506. In the amended Act, Congress designated certain Olympic-related words and symbols as being the exclusive property of the USOC, subject to limited exceptions. 36 U.S.C. §220506.

The USOC has the exclusive right to use the name "United States Olympic Committee" and the words "Olympic," "Olympiad," "Citius Altius Fortius," "Pan American," "Paralympic," "Paralympiad," "America Espirito Sport Fraternite," or any combination of these words. 36 U.S.C. §220506(a). The statutory protection also extends to the International Olympic Committee's symbol of five interlocking rings, the International Paralympic Committee's symbol of three TaiGeuks, and the Pan-American Sports Organization's symbol of a torch surrounded by concentric rings. Id. The statute permits the USOC to authorize its contributors and suppliers to use the enumerated Olympic-related words or symbols, 36 U.S.C. §220506(b), exempts certain pre-existing uses and geographic references, 36 U.S.C. §220506(d), and allows the USOC to initiate civil-action proceedings to address unauthorized use, 36 U.S.C. §220506(c).

Proposed marks that contain the designated Olympic-related words or symbols, or any combination thereof, cannot be registered on the Principal or Supplemental Register (nor can the matter be disclaimed) and must be refused 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, for trademark applications or §§1, 3, and 45, 15 U.S.C. §§1051, 1053, and 1127, for service mark applications, as well as the OASA. Other statutory refusals under the Trademark Act may also bar registration, such as falsely suggesting a connection under 15 U.S.C. §§1052(a) and likelihood of confusion under 15 U.S.C. §§1052(d), and should be issued as appropriate. *See*TMEP §1205.01(b)(ii).

1205.01(b)(i) Nature of the Mark

Under 36 U.S.C. §220506(a), no applicant other than the USOC is capable of having lawful use in commerce of marks containing the designated Olympic-related words and symbols, or any combination thereof, and an applicant cannot obviate the spirit of the law by crafting a mark that combines a designated Olympic-related word or symbol with a non-designated word or symbol. *U.S. Olympic Comm. v. O-M Bread, Inc.*, 29 USPQ2d 1555, 1557-58 (TTAB 1993) (sustaining opposition to registration of OLYMPIC KIDS).

A refusal for unlawful use pursuant to §§1 and 45 of the Trademark Act, 15 U.S.C. §§1051 and 1127 or §§1, 3, and 45, 15 U.S.C. §§1051, 1053, and 1127, is required if the applicant's mark contains the exact words or symbols, or any combination thereof, enumerated in the statute. *See, e.g., In re Midwest Tennis & Track Co.*, 29 USPQ2d 1386, 1388 (TTAB 1993) (reversing the refusal to register OLYMPIAN GOLDE since the mark did not comprise any of the forbidden words themselves, or a combination of them, and the statute did not encompass "simulations" of the listed words); *U.S. Olympic Comm. v. Olymp-Herrenwaschefabriken Bezner GmbH & Co.*, 224 USPQ 497, 500 (TTAB 1984) (denying USOC's opposition because OLYMP was not the same as OLYMPIC or OLYMPIAD, or a combination thereof, and, therefore, USOC cannot claim exclusive right of use).

1205.01(b)(ii) Issuing Other Substantive Refusals

Applications for marks comprising Olympic-related matter must also be analyzed for other substantive refusals in the same manner as any other application. The most common refusals that may accompany a refusal for unlawful use, or be issued by themselves or in combination, are a §2(a) refusal for deception or falsely suggesting a connection with the USOC or the Olympics and a §2(d) refusal for likelihood of confusion. 15 U.S.C. §1052(a) and (d). See TMEP §§1203.02–1203.02(f)(ii) regarding deceptive matter, §§1203.03–1203.03(f) regarding matter falsely suggesting a connection, and §§1207–1207.04(g)(i) regarding likelihood of confusion.

As to §2(a) refusals, the Board determined that "there are various international and national organizations pertaining to the Olympic Games" and that "the entire organization which comprises the Olympic Games, as a whole qualifies as an "institution" within the meaning of Section 2(a)." *In re Urbano*, 51 USPQ2d 1776, 1779-80 (TTAB 1999) (affirming the §2(a) refusal to register SYDNEY 2000 because the mark falsely suggested a connection with the Olympic Games held in Sydney, Australia in 2000; 15 U.S.C. §1052(a). Therefore, the United States Olympic Committee is part of the "institution" and entitled to protection under §2(a)). *See In re Midwest Tennis & Track, Co.*, 29 USPQ2d 1386, 1389 (TTAB 1993) (reversing the §2(a) refusal and finding that OLYMPIAN GOLDE had multiple connotations and did not point "uniquely and unmistakably to the USOC" as would be required under §2(a)); *In re Kayser-Roth Corp.*, 29 USPQ2d 1379, 1385 (TTAB 1993) (reversing the §2(a) refusal and noting "[t]he question is not whether the word 'Olympic' falsely suggests a connection with the persona or identity of the United States Olympic Committee's but whether applicant's mark OLYMPIC CHAMPION does . . . [we cannot] say on the basis of the record before us that the mark OLYMPIC CHAMPION 'points uniquely and unmistakably' to the United States Olympic Committee inasmuch as that term may as likely point to a contestant representing a country other than the United States in the Olympic games."); *U.S. Olympic Comm. v. Olymp-Herrenwaschefabriken Bezner GmbH & Co.*, 224 USPQ 497, 499 (TTAB 1984) (denying USOC's §2(a) claims since there was no evidence presented to establish that OLYMP was deceptive of the clothing goods or that OLYMP falsely suggested a connection with USOC).

Factors that may be relevant to a §2(d) refusal for likelihood of confusion include the wide variety of goods and services in connection with which marks consisting of Olympic-related matter are often used, the channels of trade in which they are found, and the level of sophistication of consumers of such Olympic-related

products as t-shirts, mugs, and pins. The Board has also upheld likelihood of confusion where an applicant other than the USOC used OLYMP or LYMPIC as part of its mark. *See Olymp-Herrenwaschefabriken* 224 USPQ at 498 (sustaining USOC's opposition to registration of OLYMP based on likelihood of confusion with its OLYMPIC marks); *U.S. Olympic Comm. v. Org. for Sport Aviation Competition*, 2002 TTAB Lexis 195 (TTAB 2002) (granting summary judgment to the USOC on the issue of likelihood of confusion against the mark SKYLYMPICS for aviation sporting events).

In proposed marks identifying specific Olympic Games by city and year, the examining attorney should consider the marks unitary, with the primary significance being that of the Olympic Games event, and not issue substantive refusals for descriptiveness or geographic descriptiveness or requirements for disclaimers. *Urbano*, 51 USPQ2d at 1779-80 (reversing the refusals under §§2(e)(1), 2(e)(2), and 2(e)(3) because the primary significance of the mark was as a reference to the Olympic Games).

1205.01(b)(iii) Amendments to Disclaim, Delete, or Amend the Unregistrable Wording or Symbol

If the mark is unregistrable because it includes Olympic-related matter, a disclaimer of the unregistrable matter will not render the mark registrable. If the applicant submits an amendment deleting the unregistrable matter, the examining attorney must, if appropriate, refuse registration because the amendment to the mark is material and maintain the refusal(s) based on the unregistrable symbol or designation in the alternative.

1205.01(b)(iv) Consent to Register

The USOC is permitted to authorize third parties to use and register the restricted Olympic-related words and symbols listed in the OASA. 36 U.S.C. §220506(b). If an applicant submits proof of consent from the USOC to both use and register the mark, the statutory requirement is satisfied.

1205.01(b)(v) First Use On or After September 21, 1950

If a party other than the USOC applies to register Olympic-related matter designated in the OASA and claims a date of first use in commerce on or after September 21, 1950, 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, for trademark applications or §§1, 3, and 45, 15 U.S.C. §§1051, 1053, and 1127, for service mark applications. The examining attorney must provide appropriate supporting evidence for the refusal. In addition, refusals may also be made on other relevant grounds. *See* TMEP §1205.01(b)(ii).

1205.01(b)(vi) First Use Before September 21, 1950 – Grandfather Clause

Olympic-related matter enumerated in the OASA need not be refused registration where an applicant claims pre-existing use of the mark for any lawful purpose prior to September 21, 1950. 36 U.S.C. §220506(d)(1). An applicant making such a claim is permitted to continue lawful use of the mark for the same purpose and same goods or services. 36 U.S.C. §220506(d)(2).

Registration of a new mark that creates a materially different commercial impression than the earlier mark, even if that mark incorporates the grandfathered wording, is not permitted. *O-M Bread, Inc. v. U.S. Olympic Comm.*, 65 F.3d 933, 938-39, 36 USPQ2d 1041, 1045 (Fed. Cir. 1995) (sustaining opposition against registration of OLYMPIC KIDS for bakery products, even though applicant had grandfather rights in OLYMPIC for the same goods, and noting that OLYMPIC and OLYMPIC KIDS are not legal equivalents).

Expanding the use of a grandfathered mark to additional goods and services is generally not permissible, and should be construed very narrowly. *See In re Kayser-Roth Corp.*, 29 USPQ2d 1379, 1383-84 (TTAB 1993) (reversing the refusal to register OLYMPIC CHAMPION when applicant sought to expand use of the mark from various clothing goods to socks; finding that applicant had grandfather rights in the same mark for certain apparel and noting that socks have "attributes in common with the other named [clothing] goods" that permitted this additional use by applicant).

1205.01(b)(vii) Date of First Use Not Specified

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 September 21, 1950, unless the application record indicates otherwise.

Although applications based on §1(b), §44, or §66(a) need not initially show actual use of the mark in commerce, applicants filing under these bases must have a bona fide intent to use the mark in commerce. See TMEP §§1008, 1009, 1101, 1102, 1904.01(c), 1904.01(d). Because "use in commerce" under the Trademark Act means "lawful use in commerce," any intended use of the mark serving as the basis for these types of applications must also be lawful. *SeeJohn W. Carson Found. v. Toilets.com, Inc.*, 94 USPQ2d 1942, 1948 (TTAB2010) ; *In re Midwest Tennis & Track Co.*, 29 USPQ2d at 1386 n.2 (TTAB1993) ; *Clorox Co. v. Armour-Dial, Inc.*, 214 USPQ 850, 851 (TTAB1982); *In re Stellar Int'l, Inc.*, 159 USPQ 48, 50-51 (TTAB 1968); *CreAgri, Inc. v. USANA Health Sciences, Inc.*, 474 F.3d 626, 630 (9th Cir. 2007) ("It has long been the policy of the PTO's Trademark Trial and Appeal Board that use in commerce only creates trademark rights when the use is lawful. . . . [W]e also agree with the PTO's policy and hold that only lawful use in commerce can give rise to trademark priority.") (citations omitted). With respect to a mark containing the designated Olympic-related words or symbols, or any combination thereof, actual lawful use in commerce is not possible and thus there can be no bona fide intent to lawfully use the mark in commerce. *See John W. Carson Found.*, 94 USPQ2d at 1948. Therefore, it is appropriate to issue a refusal under §§1 and 45 for applications based on §1(b), §44, or §66(a) if the facts and available evidence support the conclusion that the mark contains the prohibited wording and/or symbols.

1205.01(b)(viii) Geographic-Reference Exception

The OASA provides a narrow geographic-reference exception for use of the word OLYMPIC for businesses, goods, or services operated, sold, and marketed in the State of Washington west of the Cascade Mountain range. 36 U.S.C. §220506(d)(3). To qualify for the exception, the following requirements must be met: (1) the owner must not use the word OLYMPIC in combination with any of the other designated Olympic-related words or symbols; (2) it must be evident from the circumstances that use of the word OLYMPIC refers to the naturally occurring mountains or geographical region of the same name that were named prior to February 6, 1998, and not to the USOC or any Olympic activity; and (3) the goods or services offered under the OLYMPIC mark must be marketed and sold locally in Washington state west of the Cascade Mountain range, and not have substantial operations, sales, and marketing outside of this area. Since these requirements severely restrict the option of interstate commerce, which is regulated by Congress and a requirement under the Trademark Act, it is unlikely an applicant will be able to obtain a federal trademark registration under this exception.

1205.01(c) Examination Procedures for Marks Containing Greek Red Cross or the Phrases "Red Cross" or "Geneva Cross"

Federal law prohibits anyone other than the American National Red Cross and its duly authorized employees and agents and the sanitary and hospital authorities of the armed forces of the United States from using the Greek red cross on a white ground or the words "Red Cross" or "Geneva Cross." 18 U.S.C. §706. There is an exception for use of any such emblem, sign, insignia, or words that were lawfully used on or before June 25, 1948.

1205.01(c)(i) Date of First Use is Before or After June 25, 1948

Registration of the Greek red cross on a white ground or the words "Red Cross" or "Geneva Cross" 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 June 25, 1948. However, if a party other than an authorized party applies to register the Greek red cross on a white ground, or the designation "Red Cross" or "Geneva Cross," and claims a date of first use in commerce after June 25, 1948, 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 American National Red Cross under the statute. *See* 18 U.S.C. §706; 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.

1205.01(c)(ii) Date of First Use Not Specified

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 June 25, 1948, unless the application record indicates otherwise.

Although applications based on §1(b), §44, or §66(a) need not initially show actual use of the mark in commerce, applicants filing under these bases must have a bona fide intent to use the mark in commerce. *See*TMEP §§1008, 1009, 1101, 1102, 1904.01(c), 1904.01(d). Because "use in commerce" under the Trademark Act means "lawful use in commerce," any intended use of the mark serving as the basis for these types of applications must also be lawful. *SeeIn re Brown*, 119 USPQ2d 1350, 1351 (TTAB 2016); *John W. Carson Found. v. Toilets.com, Inc.*, 94 USPQ2d 1942, 1948 (TTAB 2010) ; *In re Midwest Tennis & Track Co.*, 29 USPQ2d at 1386 n.2 (TTAB 1993) ; *Clorox Co. v. Armour-Dial, Inc.*, 214 USPQ 850, 851 (TTAB 1982); *In re Stellar Int'l, Inc.*, 159 USPQ 48, 50-51 (TTAB 1968); *CreAgri, Inc. v. USANA Health Sciences, Inc.*, 474 F.3d 626, 630 (9th Cir. 2007) ("It has long been the policy of the PTO's Trademark Trial and Appeal Board that use in commerce only creates trademark rights when the use is lawful. . . . [W]e also agree with the PTO's policy and hold that only lawful use in commerce can give rise to trademark priority.") (citations omitted). With respect to a mark containing the Greek red cross on a white ground, or the designation "Red Cross" or "Geneva Cross," actual lawful use in commerce is not possible and thus there can be no bona fide intent to lawfully use the mark in commerce. *See John W. Carson Found.*, 94 USPQ2d at 1948. Therefore, it is appropriate to issue a refusal under §§1 and 45 for applications based on §1(b), §44, or §66(a) if the facts and available evidence support the conclusion that the mark contains the prohibited symbol or wording.

1205.01(c)(iii) Applicable Refusals

The statute prohibiting use of the Greek red cross on a white ground, or the designation "Red Cross" or "Geneva Cross," by unauthorized parties applies to "any insignia colored in imitation thereof." 18 U.S.C. §706. If the mark includes a design element that would be likely to be perceived as the Geneva red cross, and it is not significantly altered, stylized, or merged with other elements in the mark, the examining attorney must refuse registration under §§1 and 45, because the mark is not in lawful use in commerce, and under §2(a), if any of the following conditions exist:

the drawing or foreign registration shows the symbol in red;
the drawing is not in color, but the specimen shows the symbol in red; or
the drawing is not in color, but it includes the wording Red Cross or Geneva Cross.

See TMEP §1205.01(c). If the drawing shows the symbol in red, the refusals may be withdrawn if the applicant amends the drawing to a different, non-prohibited color scheme, or a non-color version of the drawing (i.e., a black-and-white or gray scale drawing), and submits a proper substitute specimen showing use of the mark in a color other than red. If the drawing is not in color, but the specimen shows the symbol in red, the refusals may be withdrawn if the applicant submits a proper substitute specimen showing use of the mark in a color other than red. *Cf.* TMEP §§1205.01(d)(i)(D), 1205.01(d)(ii)(D). A photocopy of the original specimen is not an acceptable substitute specimen.

A mark that includes a Greek cross will generally be considered registrable, and will not be refused as a red cross under §§1 and 45, or under §2(a), if the applicant does not claim color as a feature of the mark and the specimen shows the symbol in a color other than red. In such cases, a statement that the mark is not used in the color red is unnecessary, and if submitted, must not be printed on the registration certificate.

Regarding the phrases "Red Cross" and "Geneva Cross," 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 CROSS or GENEVA CROSS, with or without additional wording, must be refused under §2(a) and §§1 and 45.

For example, RED CROSSES would not be refused registration, but RED CROSS DONOR could be refused registration if the date of first use is after June 25, 1948.

1205.01(c)(iv) Amendments to Disclaim, Delete, or Amend the Unregistrable Symbol or Designation

If the mark is unregistrable because it includes the Greek red cross on a white ground, or the designation "Red Cross" or "Geneva Cross," 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)-807.14(e)(iii)

regarding amendments to color features of marks, and TMEP §1205.01(c)(iii) 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(d) Examination Procedures for Marks Containing the Swiss Confederation Coat of Arms or Flag

The Trademark Act bars registration of trademarks or service marks containing the coat of arms or flag of the Swiss Confederation, commonly known as Switzerland. See 15 U.S.C. §§1052(a), 1052(b), 1052(e)(2), 1052(e)(3), 1127; Britannica.com, *Switzerland*, **http://www.britannica.com/EBchecked/topic/577225/Switzerland** (accessed Aug. 15, 2012); Cent. Intelligence Agency, The World Factbook, *Switzerland*, **https://www.cia.gov/the-world-factbook/countries/switzerland/** (accessed Feb. 24, 2022).

The Swiss coat of arms consists of a white equilateral cross displayed upright on a red triangular shield and the Swiss flag consists of a white equilateral cross displayed upright on a red square. *See* Swiss Fed. Act of 21 June 2013 on the Protection of the Swiss Coat of Arms and Other Public Signs (Coat of Arms Protection, CAPA) **https://www.fedlex.admin.ch/eli/cc/2015/613/en** (accessed April 19, 2022) (indicating that "[t]he Swiss cross is a white, upright, free-standing cross depicted against a red background, whose arms, which are all of equal size, are one-sixth longer than they are wide" and that "[t]he Coat of Arms of the Swiss Confederation (the Swiss coat of arms) is a Swiss cross in a triangular shield"); Britannica.com, *flag of Switzerland*, **https://www.britannica.com/topic/flag-of-Switzerland** (accessed April 19, 2022); Cent. Intelligence Agency, The World Factbook, *Switzerland*, **https://www.cia.gov/the-world-factbook/countries/switzerland/flag** (accessed April 19, 2022).

Swiss Coat of Arms

Swiss Flag

The primary refusals that apply to marks containing the Swiss coat of arms, the Swiss flag, or simulations thereof, are the following:

> A refusal under Trademark Act §§1 and 45, because the mark is not in lawful use in commerce, based on the prohibition, under **18 U.S.C. §708**, of the commercial use of the Swiss coat of arms. 15 U.S.C. §§1051, 1127; see also TMEP §1205.01.
> A refusal under §2(b), because the mark consists of or comprises the flag or coat of arms of a foreign country, namely, Switzerland. 15 U.S.C. §1052(b); see also TMEP §§ 1204–1204.01(e), 1204.04.

1205.01(d)(i) Refusal Under Sections 1 and 45: Swiss Coat of Arms Not in Lawful Use

Federal law prohibits anyone from using the Swiss Confederation coat of arms as a trademark or for any other commercial purpose. Specifically, the text of 18 U.S.C. §708 reads as follows:

> Whoever, whether a corporation, partnership, unincorporated company, association, or person within the United States, willfully uses as a trade mark, commercial label, or portion thereof, or as an advertisement or insignia for any business or organization or for any trade or commercial purpose, the coat of arms of the Swiss Confederation, consisting of an upright white cross with equal arms and lines on a red ground, or any simulation thereof, shall be fined under this title or imprisoned not more than six months, or both. This section shall not make unlawful the use of any such design or insignia which was lawful on August 31, 1948.

The statute describes the coat of arms as "an upright white cross with equal arms and lines on a red ground." **18 U.S.C. §708**. Although the Swiss flag features this same type of white cross, the statute refers to the "coat of arms" and therefore is applied only to the Swiss coat of arms, which consists of a white equilateral cross displayed upright on a red triangular shield.

The text of **18 U.S.C. §708** does not specify any authorized users of the Swiss coat of arms. Accordingly, no one may lawfully use the coat of arms as a trademark or service mark in the United States, unless the mark was in use on or before August 31, 1948. *See* **18 U.S.C. §708**. Thus, regardless of the identity of the applicant, any mark containing the Swiss coat of arms, or a simulation thereof, which was not in use on or before that date, must be refused under §§1 and 45 because the mark is not in lawful use in commerce.

Although applications based on §1(b), §44, or §66(a) need not initially show actual use of the mark in commerce, applicants filing under these bases must have a bona fide intent to use the mark in commerce. *See*TMEP §§1008, 1009, 1101, 1102, 1904.01(c), 1904.01(d). Because "use in commerce" under the Trademark Act means "lawful use in commerce," any intended use of the mark serving as the basis for these types of applications must also be lawful. *SeeJohn W. Carson Found. v. Toilets.com, Inc.*, 94 USPQ2d 1942, 1948 (TTAB 2010) ; *In re Midwest Tennis & Track Co.*, 29 USPQ2d at 1386 n.2 (TTAB 1993) ; *Clorox Co. v. Armour-Dial, Inc.*, 214 USPQ 850, 851 (TTAB 1982); *In re Stellar Int'l, Inc.*, 159 USPQ 48, 50-51 (TTAB 1968); *CreAgri, Inc. v. USANA Health Sciences, Inc.*, 474 F.3d 626, 630 (9th Cir. 2007) ("It has long been the policy of the PTO's Trademark Trial and Appeal Board that use in commerce only creates trademark rights when the use is lawful. . . . [W]e also agree with the PTO's policy and hold that only lawful use in commerce can give rise to trademark priority.") (citations omitted). With respect to a mark containing the Swiss coat of arms, actual lawful use in commerce is not possible and thus there can be no bona fide intent to lawfully use the mark in commerce. *John W. Carson Found.*, 94 USPQ2d at 1948. Therefore, it is appropriate to issue a refusal under §§1 and 45 for applications based on §1(b), §44, or §66(a)

if the facts and available evidence support the conclusion that the mark contains the Swiss coat of arms or a simulation thereof.

To properly support a refusal under §§1 and 45, based on a finding that the mark is not, or cannot be, in lawful use in commerce, there must be some indication that the mark features the Swiss coat of arms or a simulation thereof. A "simulation" refers to "something that gives the appearance or effect or has the characteristics of an original item." *In re Waltham Watch Co.*, 179 USPQ 59, 60 (TTAB 1973) (citing Webster's Third New Int'l Dictionary (unabridged ed. 1965)); *see*TMEP §1204. Whether particular matter is a simulation of the Swiss coat of arms is determined by a visual comparison of the matter and the coat of arms. *Id*.

The application record usually contains sufficient information to establish that the mark contains the Swiss coat of arms or a simulation thereof. For example, the drawing may show a white cross on a red triangular shield. Or, if the drawing is not in color, the specimen, color claim, or color description may indicate that these elements appear in the prohibited color scheme.

Even if the application record itself does not provide evidence of unlawful use, it may be appropriate in some instances to base a refusal under §§1 and 45 on extrinsic evidence of applicant's use of the mark. Examining attorneys are not required to search for extrinsic evidence. However, if the examining attorney locates relevant extrinsic evidence in the course of examining the mark, that evidence may be used to support the refusal.

1205.01(d)(i)(A) When a Refusal Under Sections 1 and 45 Must Be Issued

The examining attorney must issue a "not in lawful use" refusal under §§1 and 45 if a mark contains an element composed of an upright equilateral cross on a triangular shield (or a simulation thereof) that is not significantly altered, stylized, or merged with other elements in the mark; the dates of use are after August 31, 1948 (or are not provided); and any of the following conditions exist:

> the drawing shows the cross in white and the triangular shield in red;
> the drawing is not in color, but (i) the color claim or mark description indicates the cross is white and the shield is red or (ii) the specimen shows the cross in white and shield in red; or
> the drawing is not in color, there is no color claim, the mark description does not reference color (or there is no mark description), and there is no specimen of record (because one has not been submitted or is not required), but the examining attorney has found extrinsic evidence indicating that the applicant actually uses the mark in the white cross/red shield color scheme.

If the dates of use provided do not clearly indicate that the mark was in use on or before August 31, 1948, it should be presumed that the first use occurred after that date. In applications based on §1(b), §66(a), or solely on §44, the use dates should be presumed to be after August 31, 1948. These procedures apply regardless of the application filing basis.

The basis for concluding that a mark containing the Swiss coat of arms is not in lawful use is **18 U.S.C. §708**, but the basis for refusing registration of the mark is Trademark Act §§1 and 45. Thus, when refusing registration on the ground that the mark is not in lawful use in commerce, the examining attorney must cite §§1 and 45, 15 U.S.C. §§1051, 1127, in support of the refusal and explain that the finding of unlawful use is based on 18 U.S.C. §708. *See*TMEP §1205.01. When issuing the refusal, the examining attorney should provide evidence showing the typical depiction of the Swiss coat of arms. *See*TMEP §1205.01(c).

For applications based on §1(a), the examining attorney must issue a requirement for additional information under Trademark Rule 2.61(b), 37 C.F.R. §2.61(b), if a mark contains an element composed of an upright equilateral cross on a triangular shield (or a simulation thereof), the dates of use are after August 31, 1948 (or are not provided), and all of the following conditions exist:

the drawing is not in color;
there is no color claim;
the mark description does not reference color (or there is no mark description);
the specimen of record shows the mark but is not in color (i.e., the specimen is a black-and-white or gray scale reproduction of a color specimen); and
the examining attorney has found no extrinsic evidence indicating applicant actually uses the mark in the white cross/red shield color scheme.

The requirement for additional information should advise the applicant that the use of the Swiss coat of arms in the white and red color scheme is prohibited under **18 U.S.C. §708**, and require the applicant to provide either a color version of the specimen of record or a statement that the cross-and-shield element in the mark, as used in the specimen of record, does not appear in the colors white and red. If, in response, the applicant submits a color version of the specimen and it shows that the cross-and-shield is displayed in colors other than white and red, no refusal under §§1 and 45 should issue. The statement that the cross-and-shield element, as used in the specimen of record, is not displayed in the prohibited color scheme may be submitted in a response to an Office action or entered by examiner's amendment. If the applicant submits this statement, no further inquiry is necessary. Although the statement will appear in the application record, it will not be printed on the registration certificate, should one issue.

1205.01(d)(i)(B) When an Advisory Should Be Provided

If issuing an Office action for other reasons, the examining attorney should provide an advisory regarding the potential refusal under §§1 and 45 when all of the following conditions exist:

the dates of use are after August 31, 1948 (or are not provided);
the mark contains an upright equilateral cross on a triangular shield that is not significantly altered, stylized, or merged with other elements in the mark;
the drawing is not in color;
the application record does not contain a specimen or any indication of the colors that appear in the mark as it is actually used; and
the examining attorney has found no extrinsic evidence that the applicant uses the cross-and-shield element in the prohibited color scheme (the examining attorney is not required to search for such extrinsic evidence).

If the dates of use provided do not clearly indicate that the mark was in use on or before August 31, 1948, it should be presumed that the first use occurred after that date. In applications based on §1(b), §66(a), or solely on §44, the use dates should be presumed to be after August 31, 1948.

If possible, the examining attorney should provide the advisory in the initial Office action. The advisory should indicate that a refusal under Trademark Act §§1 and 45 will issue if the specimen submitted with an allegation of use (for §1(b) applications) or a §8 or §71 affidavit or declaration of use (for §44 and §66(a) applications) shows the cross-and-shield element in a white and red color scheme. In addition, the applicant should be advised that a color version of the specimen showing a red cross on a white ground may result in a refusal on the ground that the mark is not in lawful use in commerce based on **18 U.S.C. §706** (see TMEP

§§ 1205.01(c)–(c)(iv) regarding marks containing the Greek red cross and TMEP §1205.01(d)(iii). Failure to provide an advisory does not preclude a refusal of registration in a subsequent Office action or a refusal of a §8 or §71 affidavit or declaration of use. *Cf.* TMEP §1202.

1205.01(d)(i)(C) When a Refusal Under Sections 1 and 45 Should Not Be Issued

Even if the mark contains an element composed of an upright equilateral cross on a triangular shield, the examining attorney should not issue a refusal under §§1 and 45 if any of the following conditions exist:

the applicant specifies that the mark was in use on or before August 31, 1948;
the coat of arms shown in the mark is significantly altered, stylized, or merged with other elements in the mark, so as to create a different commercial impression from the actual Swiss coat of arms;
the drawing is not in color, there is no color claim, the mark description has been omitted or does not reference color, and the application contains a color specimen that shows the relevant matter in a color scheme other than white and red; or
the drawing is in color and shows the cross and triangular shield in a color scheme other than white and red. In this situation, a refusal should not issue, even if the color claim, mark description, or specimen indicates that the cross and shield appear in the prohibited color scheme. Instead, to address the discrepancy between the drawing and the other information in the application record, the examining attorney must require a corrected color claim, an amended mark description, and/or a matching specimen, as appropriate. In addition, the examining attorney should provide an advisory indicating that the use of the Swiss coat of arms in the white and red color scheme is prohibited by federal law and that, if the applicant amends the drawing to show the cross in white and the shield in red, the mark will be refused under Trademark Act §§1 and 45.

The refusal should not be issued even if the cross is white and the shield is red.

1205.01(d)(i)(D) Applicant's Response to Refusal

If a mark is unregistrable under §§1 and 45 because it contains the Swiss coat of arms, disclaiming the coat of arms will not make it registrable, nor will claiming acquired distinctiveness under Trademark Act §2(f) or amending the application to the Supplemental Register. *Cf.* TMEP §§1204.04(a) and 1205.01(a)(v). In addition, an applicant may not overcome the refusal under §§1 and 45 by disclaiming the colors that appear in the coat of arms. If registration is refused because the drawing or specimen actually shows the cross-and-shield element in white and red, the applicant may not overcome the refusal by merely providing a statement that the mark will not be used in the prohibited colors. (If the drawing contains a black-and-white depiction of the Swiss coat of arms, and the applicant provides a statement that the mark does not, or will not, appear in the colors white and red, the statement will remain in the application record but will not be printed on any registration certificate that may issue.)

For applications based on §1, applicants may overcome the refusal as follows:

Amending the Colors in the Drawing. If the mark is refused because the drawing shows the cross-and-shield element in the prohibited color scheme, a §1 applicant may overcome the refusal by submitting an amended drawing showing the cross-and-shield element in a different, non-prohibited color scheme, or by submitting a non-color version of the drawing (i.e., a black-and-white or gray scale drawing). Under these circumstances, these amendments to the drawing usually will not be considered a material alteration of the mark. *Cf.*TMEP §1205.01(a)(v). The color claim and color

description must also be amended or deleted, as appropriate. If the application is based on §1(a), the record must contain an acceptable matching specimen. Black-and-white or gray scale reproductions of specimens are not acceptable for this purpose; a color version of the specimen must be submitted.

Amending the Color Claim/Description; Substitute Specimen. If the drawing is not in color, but registration is refused because the color claim or mark description indicates that the cross-and-shield element appears in white and red, a §1 applicant may overcome the refusal by amending the color claim or mark description to delete any reference to color. Likewise, if the original drawing is not in color, but registration was refused because the specimen showed the cross-and-shield element in the prohibited color scheme, the applicant may obviate the refusal by submitting a color specimen showing use of the mark in colors other than white and red.

Deleting the Coat of Arms from the Drawing. A §1 applicant may also overcome the refusal by deleting the coat of arms from the mark if the coat of arms is separable from the other elements in the mark and the remaining matter is registrable. *Cf.*TMEP §1204.04(b). Generally, the deletion of this matter will not be considered a material alteration of the mark. Furthermore, if the coat of arms is deleted from the drawing, any specimen showing the mark with the deleted matter should still be considered to match the drawing. *Cf.*TMEP §1204.04(b).

For applications based on §44 or §66(a), applicants generally may not make amendments to the mark. Therefore, the option to delete the Swiss coat of arms is not available in these types of applications. 37 C.F.R. §§2.51(c), 2.72(c)(1); TMEP §§807.12(b), 1011.01, 1904.02(j). However, if the mark in a §44 or §66(a) application is refused because the drawing presents the cross-and-shield element in the prohibited color scheme, but there is no corresponding color claim in the foreign or international registration, the applicant may overcome the refusal under §§1 and 45 by submitting a statement that no claim of color is made with respect to the foreign or international registration and amending the drawing to a black-and-white reproduction of the mark. *See*TMEP §§1011.01, 1904.02(k). In addition, the applicant must submit a statement confirming applicant's bona fide intent to use the mark lawfully (i.e., in colors other than white and red). This statement does not need to be verified.

1205.01(d)(i)(E) Refusals Based on Extrinsic Evidence

If a §1(b), §44, or §66(a) application is refused based solely on extrinsic evidence of applicant's unlawful use of the Swiss coat of arms, the applicant may overcome the refusal by submitting a verified statement that the applicant has a bona fide intention to use the mark lawfully (i.e., in colors other than white and red). TMEP §§804–804.01(b). For a §1(a) application refused based on extrinsic evidence (or based on the specimen of record), the applicant may overcome the refusal by amending the application filing basis to §1(b), and need only submit the usual verified statement corresponding to that amendment (i.e., that the applicant has a bona fide intention to use the mark in commerce on or in connection with the goods or services, and that the applicant had this intention as of the application filing date). 15 U.S.C. §1051(b)(3)(B); 37 C.F.R. §2.34(a)(2); TMEP §806.03(c). If the specimen submitted with the applicant's subsequent allegation of use, or with an affidavit or declaration of use under §8 or §71, shows the mark is not in lawful use, the refusal must be reissued.

1205.01(d)(ii) Refusal Under §2(b): Swiss Flag or Swiss Coat of Arms

Trademark Act §2(b) prohibits registration on the Principal Register or Supplemental Register of a mark that consists of or comprises the flag or coat of arms of a foreign nation. 15 U.S.C. §1052(b); *see*TMEP §§1204-1204.05. In determining whether a mark must be refused under §2(b), the relevant question is

whether consumers will perceive matter in the mark as a flag or coat of arms. *See In re Family Emergency Room LLC*, 121 USPQ2d 1886, 1888 (TTAB 2017); TMEP §1204.01(a).

Section 2(b) also prohibits registration of any simulation of a foreign nation's flag or coat of arms. 15 U.S.C. §1052(b); *see In re Family Emergency Room LLC*, 121 USPQ2d at 1887; TMEP §1204.01(a). As previously noted, a "simulation" refers to "something that gives the appearance or effect or has the characteristics of an original item." *In re Advance Indus. Sec., Inc.*, 194 USPQ 344, 346 (TTAB 1977); *see*TMEP §1204.

Whether particular matter is a simulation of a flag or coat of arms is determined by a visual comparison of the matter and the actual flag or coat or arms. *See In re Waltham Watch Co.*, 179 USPQ 59, 60 (TTAB 1973); TMEP §1204. The focus of the analysis is on the relevant purchasers' general recollection of the flag or coat of arms, "without a careful analysis and side-by-side comparison." *In re Advance Indus. Sec., Inc.*, 194 USPQ at 346 . See TMEP §1204.01(a) for examples of flag simulations.

The examining attorney should consider the following factors when determining whether matter in a mark will be perceived as the Swiss coat of arms or Swiss flag:

> the colors, if any, that appear in the matter;
> the stylization of the matter and its relationship to other elements in the mark;
> the presence of any words or other designs on the drawing that might create or reinforce the impression that the matter is the Swiss flag or Swiss coat of arms; and
> the presentation and use of the mark on the specimen of record, if one is provided. *See In re Family Emergency Room LLC*, 121 USPQ2d at 1888; TMEP §1204.01(a).

The determination of whether a refusal under §2(b) must issue should be based on how the mark is displayed in the drawing, described in the application, or used in the specimen of record. *See In re Family Emergency Room LLC*, 121 USPQ2d at 1888. Extrinsic evidence of applicant's use of the mark should not be considered.

1205.01(d)(ii)(A) When a Refusal Under §2(b) Must Be Issued

The examining attorney must refuse registration under §2(b) if the mark contains an element composed of an upright equilateral cross on a square, a rectangle, or a triangular shield (or a simulation thereof) that is not significantly stylized, altered, or merged with other elements in the mark, and any of the following conditions exist:

> the drawing shows the cross in white and the square, rectangle, or triangular shield in red;
> the drawing is not in color, but (i) the color claim or mark description indicates the cross is white and the square, rectangle, or triangular shield is red, or (ii) the specimen shows the cross and square, rectangle, or triangular shield in the prohibited color scheme; or
> the drawing is not in color, but in addition to an upright equilateral cross on a square, a rectangle, or a triangular shield, the mark contains wording or other matter that creates or reinforces the impression that the cross and square/rectangle/shield design is the Swiss flag or Swiss coat of arms (e.g., "Switzerland," "Swiss," "Suisse," "Schweiz," "Swiss Confederation").

For applications based on §1(a), the examining attorney must issue a requirement for additional information based on Trademark Rule 2.61(b), 37 C.F.R. §2.61(b), if a mark contains an element composed of an upright equilateral cross on a square, a rectangle, or a triangular shield (or a simulation thereof) and all of the following conditions exist:

the drawing is not in color;
there is no color claim;
the mark description is omitted or does not reference color;
the mark does not contain wording or other matter that creates or reinforces the impression that the matter is the Swiss flag or Swiss coat of arms (e.g., "Switzerland," "Swiss," "Suisse," "Schweiz," "Swiss Confederation"); and
the specimen of record shows the mark but is not in color (i.e., the specimen is a black-and-white or gray scale reproduction of a color specimen).

The requirement for additional information should advise that registration of the Swiss coat of arms or Swiss flag in the white-and-red color scheme is barred under Trademark Act §2(b) and require the applicant to provide either a color version of the specimen of record or a statement that the relevant matter in the mark, as used in the specimen of record, does not appear in the colors white and red. If, in response, the applicant submits a color version of the specimen and it shows that the relevant matter is displayed in colors other than white and red, a refusal under §2(b) should not be issued. The statement that the relevant matter, as used in the specimen of record, does not appear in the prohibited color scheme may be submitted in a response to an Office action or may be entered by examiner's amendment. If the applicant submits this statement, no further inquiry is necessary. Although the statement will appear in the application record, it will not be printed on the registration certificate, should one issue.

When issuing the §2(b) refusal, the examining attorney must provide evidence supporting the conclusion that the matter in the mark is the official coat of arms or flag of the Swiss Confederation. *See* Swiss Fed. Act of 21 June 2013 on the Protection of the Swiss Coat of Arms and Other Public Signs (Coat of Arms Protection, CAPA) **https://www.fedlex.admin.ch/eli/cc/2015/613/en** (accessed April 19, 2022) (indicating that "[t]he Swiss cross is a white, upright, free-standing cross depicted against a red background, whose arms, which are all of equal size, are one-sixth longer than they are wide" and that "[t]he Coat of Arms of the Swiss Confederation (the Swiss coat of arms) is a Swiss cross in a triangular shield"); Britannica.com, *flag of Switzerland* , **https://www.britannica.com/topic/flag-of-Switzerland** (accessed April 19, 2022); Cent. Intelligence Agency, The World Factbook, *Switzerland* , **https://www.cia.gov/the-world-factbook/countries/switzerland/flag** (accessed April 19, 2022). In addition, if the refusal is based on the examining attorney's conclusion that other wording or matter in the mark creates or reinforces the impression that the cross and square/rectangle/shield design is the Swiss flag or Swiss coat of arms, the examining attorney should provide evidence to support that conclusion.

When an examining attorney issues a §2(b) refusal because the mark features a cross-and-shield design that appears in, or is used in, the prohibited color scheme, the examining attorney must also issue a "not in lawful use" refusal under Trademark Act §§1 and 45. *See*TMEP §1205.01(c)(i). Sometimes, however, a §2(b) refusal will be issued not because information in the application indicates that the cross-and-shield design appears in, or is used in, the prohibited color scheme, but because other Swiss indicia in the mark would lead to the impression that a non-color cross-and-shield design is the Swiss coat of arms. In these instances, a refusal under §§1 and 45 is not appropriate unless there is extrinsic evidence that, as used by the applicant, the coat of arms in the mark appears in the prohibited color scheme.

1205.01(d)(ii)(B) When an Advisory Should Be Provided

If sending an Office action for other reasons, the examining attorney should provide an advisory regarding the potential refusal under §2(b) when all of the following conditions exist:

the mark contains an upright equilateral cross on a square, a rectangle, or a triangular shield that is not significantly stylized, altered, or merged with other elements in the mark;
the drawing is not in color;
the application record does not contain a specimen or any other indication of the colors that appear in the mark as it is actually used; and
there is no wording or other indicia in the mark that would create or reinforce the impression that the mark contains the Swiss flag or the Swiss coat of arms.

If possible, the examining attorney should provide the advisory in the initial Office action. The advisory should indicate that a refusal under Trademark Act §2(b) will issue if the specimen submitted with an allegation of use (for §1(b) applications) or a §8 or §71 affidavit or declaration of use (for §44 and §66(a) applications) shows the cross and square/rectangle/shield in a white and red color scheme. Failure to provide an advisory does not preclude a refusal of registration in a subsequent Office action or a refusal of a §8 or §71 affidavit or declaration. *Cf.*TMEP §1202.

1205.01(d)(ii)(C) When a Refusal Under §2(b) Should Not Be Issued

Even if the mark contains an upright equilateral cross on a square, a rectangle, or a triangular shield (or simulation thereof), a §2(b) refusal should not be issued if any of the following conditions exist:

the flag or coat of arms shown in the mark is sufficiently altered, stylized, or merged with other elements in the mark, so as to create a distinct commercial impression;
the drawing is not in color, there is no color claim, the mark description does not reference color (or there is no mark description), and the application contains a color specimen that shows the relevant matter in a color scheme other than white and red; or
the drawing is in color and shows the cross and square/rectangle/shield in a color scheme other than white and red. In this situation, a refusal should not issue, even if the color claim, mark description, or specimen indicates that the cross and square/rectangle/shield appears in the prohibited color scheme. Instead, to address the discrepancy between the drawing and the other information in the application record, the examining attorney must require a corrected color claim, an amended mark description, and/or a matching specimen, as appropriate. In addition, the examining attorney should provide an advisory indicating that, under §2(b), the Swiss flag and Swiss coat of arms may not be registered as a trademark or service mark and that, if the applicant amends the drawing to show the cross in white and the square, rectangle, or shield in red, the mark will be refused under Trademark Act §2(b).

1205.01(d)(ii)(D) Applicant's Response to Refusal

Section 2(b) provides an absolute bar to registration. *See*TMEP §1204.04(a). Thus, a disclaimer of the relevant matter will not overcome the refusal, nor will a claim of acquired distinctiveness under §2(f) or an amendment to the Supplemental Register. *Id*.

In addition, if registration is refused because the drawing or specimen actually shows the cross and square/rectangle/shield element in white and red, the applicant may not overcome the refusal by merely providing a statement that the mark will not be used in the prohibited colors. (If the drawing contains a black-and-white depiction of the Swiss flag or the Swiss coat of arms, and the applicant provides a statement that the mark does not, or will not, appear in the colors white and red, the statement will remain in the application record but will not be printed on any registration certificate that may issue.)

For applications based on §1, an applicant may overcome a §2(b) refusal as follows:

> *Amending the Colors in the Drawing.* If registration is refused because the drawing shows the relevant matter in the prohibited color scheme, amending the drawing to show the matter in another color scheme—either in different colors or in no particular colors (i.e., black and white or gray scale)—will usually be sufficient to overcome the refusal. However, amending to a non-color drawing showing the mark in black and white or gray scale will not overcome the refusal if there is other matter in the mark (e.g., wording such as "Swiss" or "Switzerland") that creates or reinforces the impression that the cross and square/rectangle/shield design in the mark is the Swiss flag or the Swiss coat of arms.
>
> Generally, amending the colors in the cross and square/rectangle/shield element in a mark to overcome a §2(b) refusal will not result in a material alteration of the mark. If the colors in the drawing are changed, the color claim and color description must also be amended or deleted, as appropriate. If the application is based on §1(a), the record must contain an acceptable matching specimen. Black-and-white or gray scale reproductions of specimens are not acceptable for this purpose; a color version of the specimen must be submitted.
>
> *Amending the Color Claim/Description; Substitute Specimen.* If the drawing is not in color, but registration is refused because the color claim or mark description indicates that the relevant matter appears in white and red, a §1 applicant may overcome the refusal by amending the color claim or mark description to delete any reference to color. Likewise, if the original drawing is not in color, but registration was refused because the specimen showed the relevant matter in the prohibited color scheme, the applicant may obviate the refusal by submitting a color specimen showing use of the relevant matter in the mark in colors other than white and red.
>
> *Deleting the Coat of Arms or Flag from the Drawing.* Section 1 applicants may also overcome a §2(b) refusal by deleting the unregistrable flag or coat of arms, but only if the matter is separable from other elements in the mark (e.g., the flag design is separated from, or is used as a background for, other matter in the mark) and the remaining matter is registrable. If the flag or coat or arms is deleted from the drawing, any specimen showing the mark with the deleted matter should still be considered to match the drawing. *See*TMEP §1204.04(b).
>
> *Amending the Filing Basis to §1(b).* If registration of the mark is refused under §2(b) because the specimen of record shows the relevant matter in white and red, applicant may amend the application filing basis to §1(b), in which case the examining attorney should withdraw the refusal. However, the refusal must be reissued if the specimen submitted with applicant's subsequent allegation of use shows the relevant matter in the prohibited color scheme.

For applications based on §44 or §66(a), applicants generally may not make amendments to the mark; thus, the option to delete the Swiss flag or Swiss coat of arms is not available. 37 C.F.R. §§2.51(c), 2.72(c)(1); TMEP §§ 807.12(b), 1011.01, 1904.02(j). However, if a §44 or §66(a) application presents the mark in color, but there is no corresponding color claim in the foreign or international registration, the applicant may submit a statement that no claim of color is made with respect to the foreign or international registration and amend the drawing to a black-and-white reproduction of the mark. *See*TMEP §§ 1011.01, 1904.02(k). In this manner, the applicant may overcome the §2(b) refusal, provided there are no other Swiss indicia in the mark that would create the perception that the black-and-white or gray-scale coat of arms or flag in the mark is the Swiss coat of arms or Swiss flag.

1205.01(d)(iii) Other Refusals

If a mark containing matter that would be perceived as the Swiss coat of arms or Swiss flag also includes other Swiss indicia, such as the wording "Switzerland" or "Swiss," or foreign equivalents, the examining

attorney should consider whether the primary significance of the mark as a whole is geographic. If so, a refusal under Trademark Act §2(e)(2) (geographically descriptive) or §2(a)/§2(e)(3) (geographically deceptive/primarily geographically deceptively misdescriptive) may be appropriate, in addition to refusals under §§1 and 45 and/or §2(b). For detailed information regarding the examination procedures relating to geographic refusals, see TMEP §§1210-1210.07(b).

Like the Swiss coat of arms and the Swiss flag, the Red Cross features an upright equilateral cross and the colors red and white. However, the color scheme in the Red Cross is reversed, displaying the cross in red and the background in white. The Red Cross is also protected by federal statute, and marks containing this matter may be subject to refusals under Trademark Act §§1 and 45 (not in lawful use) and §2(a) (false suggestion of a connection with the American National Red Cross). *See* **18 U.S.C. §706**. If the mark contains an equilateral cross, but the application does not provide a clear indication of the colors that appear in the mark, examining attorneys should consider whether a refusal on the basis that the mark appears to contain the Red Cross may be appropriate. For additional information, see TMEP §1205.01.

Refusals for failure to function as a trademark or service mark, 15 U.S.C. §§1051, 1052, 1053, 1127 (*see also*TMEP §§1202, 1301.02(a)), or for likelihood of confusion, 15 U.S.C. §1052(d), may also apply to these marks.

1205.01(d)(iv) Examples

Examples of Situations Where Registration Must (or Might) Be Refused. In some of the following examples, a refusal under §§1 and 45, §2(b), or both must be issued because the drawing itself shows that the mark contains the Swiss coat of arms, the Swiss flag, or a simulation thereof. In the remaining examples, other information will dictate whether either or both refusals are appropriate.

Mark: The mark consists of the wording SWISS OVEN appearing on a banner that is positioned over a red triangular shield containing a white cross, with depictions of wheat appearing on both sides of the shield.

Analysis: The mark contains a red triangular shield containing a white equilateral cross. The shield is partially obscured and the cross is proportionally larger than the cross in the Swiss coat of arms.

Nonetheless, this matter is essentially a simulation of the Swiss coat of arms (regardless of the wording in the mark). Thus, refusals under §§1 and 45 and §2(b) must be issued.

Mark: The mark consists of the wording ZURICH SWISS appearing below a red square containing a white equilateral cross.
Analysis: The mark contains the Swiss flag: a white equilateral cross on a red square. Therefore, the mark must be refused under §2(b). The wording in the mark reinforces the impression that the matter is the Swiss flag and further supports the §2(b) refusal. A refusal under §§1 and 45 is not appropriate, because this refusal applies only to the Swiss coat of arms. See TMEP §1205.01(d)(iii) regarding this mark's geographic significance.

Mark: The mark consists of an oval carrier featuring, among other things, a triangular shield containing an upright equilateral cross. Color is not claimed as a feature of the mark.

Analysis: A §2(b) refusal must be issued because, although the shield-and-cross element is not shown in color and is slightly different from the actual Swiss coat of arms, other Swiss indicia in the mark create the impression that the design is the Swiss coat of arms. A refusal under §§1 and 45 should not be issued based on the drawing alone, because the drawing does not show the relevant matter in a white-and-red color scheme. If, however, the specimen of use or extrinsic evidence shows that the cross-and-shield element is used in the prohibited color scheme, a refusal under §§1 and 45 would be appropriate. Otherwise, an advisory or a Rule 2.61(b) requirement for additional information may be appropriate.

Mark: The mark consists of a circular carrier containing a depiction of a mountain, a triangular shield containing an upright equilateral cross, and the wording SWISS GRILL and SWISS GOURMET FOOD. Color is not claimed as a feature of the mark.

Analysis: A §2(b) refusal must be issued in this case because, although the cross-and-shield element is not shown in color, other Swiss indicia in the mark will create the impression that the design is the Swiss coat of arms. A refusal under §§1 and 45 should not be issued based on the drawing alone, because the drawing does not show the relevant matter in a white-and-red color scheme. If, however, the specimen of record or extrinsic evidence shows that the cross-and-shield element is used in the prohibited color scheme, a refusal under §§1 and 45 would be appropriate. Otherwise, an advisory or a Rule 2.61(b) requirement for additional information may be appropriate.

Mark: The mark consists of the wording ADVANCED DERMATOLOGIC SOLUTIONS, LLC appearing above a rectangle containing an upright equilateral cross. Color is not claimed as a feature of the mark.

Analysis: A §2(b) refusal is appropriate if the color claim, mark description, or specimen of record indicates that the cross appears in white and the rectangle appears in red. A refusal under §§1 and 45 would not be appropriate, regardless of the colors these elements appear in, because this refusal applies only to the Swiss coat of arms. Otherwise, an advisory or a Rule 2.61(b) requirement for additional information may be appropriate.

Mark: The mark consists of a red background containing a white cross above the wording ANDREW CHRISTIAN, which is also in white.

Analysis: The red portion of the mark represents a red background, but not necessarily a red rectangular background. If the specimen of record shows the mark in a rectangular form, then the mark is essentially a simulation of the Swiss flag and a §2(b) refusal is appropriate. The inclusion of the wording

immediately below the cross would not detract from this impression. A refusal under §§1 and 45 is not appropriate because this refusal applies only to the Swiss coat of arms.

Mark: The mark consists of a rectangle containing a white equilateral cross on a red square, all of which is bordered in black, and the wording REMOTE MEDICAL INTL.
Analysis: Because it is bordered in black, the cross-and-square element in the mark is slightly different from Swiss flag. However, it is sufficiently similar to be considered a simulation of the Swiss flag. Thus, a §2(b) refusal is appropriate. A refusal under §§1 and 45 is not appropriate because this refusal applies only to the Swiss coat of arms.

Examples of Situations Where Refusal of Registration Is Not Appropriate. In the following examples, a refusal under §§1 and 45 or §2(b) is not appropriate for one or more of the following reasons: (1) the mark is displayed in a color scheme other than white and red; (2) the mark does not contain all of the characteristic elements of the Swiss coat of arms or the Swiss flag; or (3) the relevant matter in the mark is sufficiently altered, or merged with other design elements, to create a distinct commercial impression.

Mark: The mark consists of the word MCCORMACK in silver appearing above a white cross on a silver triangular background, all within a silver shield-shaped outline.
Analysis: Although the mark contains an upright equilateral cross on a triangular background, a refusal under §§1 and 45 is not appropriate because the relevant elements are not displayed in white and red. A refusal under §2(b) is not appropriate because the drawing and color claim indicate that the cross-and-shield design appear in the colors silver and white.

Mark: The mark consists of the word PROCARE, with the letters "PR" and “CARE” in blue and the letter "O" formed by a red circle containing a white cross.

Analysis: Although the mark features a design element composed of a white equilateral cross on a red background, a refusal under §§1 and 45 is not appropriate because the background shape is not a triangular shield. A §2(b) refusal is not appropriate because the relevant matter does not appear in the shape of the Swiss flag or Swiss coat of arms.

Mark: The mark consists of a red silhouette of a house containing a white equilateral cross.
Analysis: Although the mark contains an upright equilateral cross in white on a red background, this matter is integrated into a stylized silhouette of a house. As a result, the mark creates an impression of something entirely different from the Swiss flag or the Swiss coat of arms. Thus, a refusal under §§1 and 45 or §2(b) would not be appropriate.

Mark: The mark consists of a triangular shield containing an upright equilateral cross, appearing below the word REPEL and to the left of the wording ANTIMICROBIAL PROTECTED. The colors black, white, and gray are claimed as a feature of the mark.

Analysis: Although the mark contains an upright equilateral cross on a triangular shield, refusals under §§1 and 45 and §2(b) are not appropriate, because the drawing and color claim indicate that the cross-and-shield design appear in the colors black, white, and gray. These refusals should not issue, even if the specimen shows use of the cross-and-shield in the prohibited white-and-red color scheme. Instead, to address the discrepancy between the drawing and the specimen, the examining attorney must require a matching specimen that necessarily would not include the prohibited color scheme.

1205.02 Article 6ter 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. Paris Convention for the Protection of Industrial Property art. 6*ter* , Mar. 20, 1883, **http://www.wipo.int/treaties/en/ip/paris/trtdocs_wo020.html**.

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 §§1203-1203.03(f). 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.

1205.03 Native American Tribal Insignia

Various federally and state-recognized Native American tribes have identified a particular insignia as their official tribal insignia. When a federally or state-recognized Native American tribe submits its official insignia to the USPTO, it 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") and entered into the USPTO search records to assist examining attorneys and applicants. There is no legal requirement to submit such an insignia to the USPTO. Therefore, the search records include only the insignia of federally and state-recognized Native American tribes that choose to submit their insignia.

When the USPTO receives a request to enter an insignia, the USPTO complies if the request is made by a federally or state-recognized Native American tribe and includes certain required information. The USPTO does not investigate whether the insignia truly is the official insignia of the tribe.

Inclusion of the insignia in the search records aids in the examination of applications for trademark registration. Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), disallows the registration of marks that falsely suggest a connection with a non-sponsoring person or institution, including a Native American tribe. *See In re Shinnecock Smoke Shop* 571 F. 3d 1171, 91 USPQ 2d 1218 (Fed. Cir. 2009); *In re White*, 73 USPQ2d 1713 (TTAB 2004). Thus, if a mark that a party wishes to register as a trademark resembles an insignia of a Native American tribe, it may falsely suggest a connection with the tribe.

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

15 U.S.C. §1052 (Extract)

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), absolutely bars the registration of these marks on either the Principal Register or the Supplemental Register. See 15 U.S.C §1052(f), 1091(a). The provision "recognizes the right of privacy and publicity that a living person has in his or her identity and protects consumers against source deception." *In re ADCO Indus. – Techs., L.P.*, 2020 USPQ2d 53786, at *10-11 (TTAB 2020).

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." *In re ADCO Indus. – Techs., L.P.*, 2020 USPQ2d 53786, at *7-8 (citing *In re Hoefflin*, 97 USPQ2d 1174, 1176 (TTAB 2010); *Martin v. Carter Hawley Hale Stores, Inc.*, 206 USPQ 931, 933 (TTAB 1979)); *see also Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 1376 n.8, 217 USPQ 505, 509 n.8 (Fed. Cir. 1983). See TMEP §1203.03 regarding 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*15 U.S.C. §1052(c); *In re Masucci*, 179 USPQ 829 (TTAB 1973) (affirming §2(c) refusal of a mark consisting of the name EISENHOWER, a portrait of President Dwight D. Eisenhower, and the words PRESIDENT EISENHOWER REGISTERED PLATINUM MEDALLION #13 on the ground that the mark comprised the name, signature, or portrait of a deceased United States president without the written consent of his living widow).

"Whether consent to registration is required depends on whether the public would recognize and understand the mark as identifying a particular living individual." *In re ADCO Indus. – Techs., L.P.*, 2020 USPQ2d 53786, at *8. Specifically, a consent is required only if the individual bearing the name in the mark will be associated with the mark as used with the goods or services because the person is either (1) so well known that the public would reasonably assume a connection between the person and the goods or services, or (2) publicly connected with the business in which the mark is used. *Id.* at *8 (citing *In re Hoefflin*, 97 USPQ2d at 1175-76; *Krause v. Krause Publ'ns, Inc.*, 76 USPQ2d 1904, 1909-10 (TTAB 2005); *In re Sauer*, 27 USPQ2d 1073, 1075 (TTAB 1993); *Martin*, 206 USPQ at 933)). See TMEP §1206.02 regarding whether consent is required.

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 §§813.01(a)-(c) regarding the entry of pertinent statements in the record for publishing in the *Trademark Official Gazette* and including 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. For purposes of §2(c), a "name" does not have to be the full name of an individual. "Section 2(c) applies not only to full names, but also first names, surnames, shortened names, pseudonyms, stage names, titles, or nicknames, if there is evidence that the particular name identifies a specific living individual who is publicly connected with the business in which the mark is used, or who is so well known that such a connection would be assumed." *In re ADCO Indus. – Techs., L.P.*, 2020 USPQ2d 53786, at *8 (TTAB 2020) (holding registration of the marks TRUMP-IT MY PACKAGE OPENER MAKE OPENING PACKAGES GREAT and design and TRUMP-IT MY PACKAGE OPENER and design barred under Section 2(c) in the absence of consent to register, because they created a direct association with President Donald Trump);*see In re Hoefflin*, 97 USPQ2d 1174, 1177-78 (TTAB 2010) (holding registration of the marks OBAMA PAJAMA, OBAMA BAHAMA PAJAMAS, and BARACK'S JOCKS DRESS TO THE LEFT barred under §2(c) in the absence of consent to register, because they created a direct association with President Barack Obama); *In re Sauer,*27 USPQ2d 1073, 1074-75 (TTAB 1993) (holding registration of a mark containing BO, used in connection with a sports ball, barred under §2(c) in the absence of consent to register, because BO is the nickname of Bo Jackson, a well-known athlete, and thus use of the mark would lead to the assumption that he was associated with the goods), *aff'd per curiam*, 26 F.3d 140 (Fed. Cir. 1994); *In re Steak & Ale Rests. of Am., Inc.*, 185 USPQ 447, 448 (TTAB 1975) (holding registration of the mark PRINCE CHARLES for fresh and cooked meat barred under Section 2(c) in the absence of consent to register, because the mark created a direct association with Prince Charles, a well-known member of the English royal family.

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 business in which the mark is used, or a deceased U.S. president whose spouse is living. *See Steak & Ale Rests.*, 185 USPQ at 447 ("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) (involving a mark consisting of a sign on which the portrait of a young girl appears below the words LITTLE DEBBIE); *In re Masucci*, 179 USPQ at 829 (involving a mark containing the name and portrait of President Eisenhower); *Garden v. Parfumerie Rigaud, Inc.*, 34 USPQ 30 (Comm'r Pats. 1937) (involving marks containing the name and portrait of petitioner).

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 bearing the name in the mark will be associated with the mark as used with the goods or services, because the person is either: (1) so well known that the public would reasonably assume a connection between the person and the goods or services, or (2) publicly connected with the business in which the mark is used. *In re ADCO Indus. – Techs., L.P.*, 2020 USPQ2d 53786, at *8 (TTAB 2020) (citing *In re Hoefflin*, 97 USPQ2d 1174, 1175-76 (TTAB 2010); *Krause v. Krause Publ'ns, Inc.*, 76 USPQ2d 1904, 1909-10 (TTAB 2005); *In re Sauer*, 27 USPQ2d 1073, 1075 (TTAB 1993); *Martin v. Carter Hawley Hale Stores, Inc.*, 206 USPQ 931, 933 (TTAB 1979)). For purposes of §2(c), "publicly connected" means that the named individual is associated in some significant manner with the applicant, is actually connected to the goods or services at issue, or is well known in the relevant field of goods or services, and, as a result, the relevant public will recognize or perceive the name as identifying that particular individual. *See In re Sauer*, 27 USPQ2d at 1075 (holding registration of a mark containing BO, used in connection with a sports ball, barred by §2(c) in the absence of written consent to register from a well-known athlete nicknamed BO, Bo Jackson), *aff'd per curiam*, 26 F.3d 140 (Fed. Cir. 1994); *Reed v. Bakers Eng'g & Equip. Co.*, 100 USPQ 196 (PTO 1954) (holding

registration of REED REEL OVEN barred by §2(c) in the absence of written consent to register from the designer and builder of the ovens, Paul N. Reed); *see also*TMEP §1206.03. Although there may need to be evidence to show that the consuming public connects lesser-known figures with the manufacturing or marketing of the goods or services at issue, "well-known individuals such as celebrities and world-famous political figures are entitled to the protection of Section 2(c) without having to evidence a connection with the involved goods or services." *In re ADCO Indus. – Techs., L.P.*, 2020 USPQ2d 53786, at *8 (citing *In re Hoefflin*, 97 USPQ2d at 1177; *In re Masucci*, 179 USPQ 829, 830 (TTAB 1973)).

The Trademark Trial and Appeal Board stated the following in *Martin*, 206 USPQ at 933:

> [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.

In *Krause*, 76 USPQ2d at 1907-11, the evidence of record showed, among other things, that the cancellation petitioner, Chester L. Krause, formed a sole proprietorship under the name "Krause Publications" for the purpose of publishing coin collecting publications; was subsequently associated for almost fifty years with the respondent Krause Publications Inc., a major publisher of hobby magazines, newspapers, and price guides, as its president and/or chairman; coauthored at least three publications in the field of the study and collecting of coins; conducted a number of lectures on this subject around the country; received awards from national coin- and car-collecting organizations in recognition of his contributions to those fields; was the founder of a car show and swap meet; and had his large collection of cars featured in a film by an organization dedicated to automotive history. The Board found that this evidence established that the petitioner was publicly connected with the fields of coin collecting, car collecting, and publishing activities relating thereto, such that a connection between petitioner and the mark KRAUSE PUBLICATIONS would be presumed by those who have an interest in such fields. *Id.* at 1910. Thus, as to the goods and services related to those fields, the Board granted the petition to cancel because the mark identified a particular living individual and there was no written consent to register. *Id.* at 1914. However, the petition to cancel the registration for "entertainment services in the nature of competitions and awards in the field of cutlery," was dismissed 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. *Id.* at 1910, 1911-12, 1914.

If no one with the name of the person identified in the mark is actually connected with the applicant or with the business in which the mark is used, and no person with the name in the mark is generally known such that a connection would be assumed, the mark generally would not be deemed to identify a particular person under §2(c), and consent would not be required. *See In re Morrison & Foerster LLP*, 110 USPQ2d 1423, 1428 (TTAB2014) (holding no consent required because applicant's FRANKNDODD mark would be understood by the relevant consuming public as referencing and commenting on the Dodd-Frank Act, rather than as specifically identifying Congressman Barney Frank and Senator Chris Dodd); *Martin*, 206 USPQ

at 933 (holding 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); *Brand v. Fairchester Packing Co.*, 84 USPQ 97 (Comm'r Pats. 1950) (affirming dismissal of a petition to cancel the registration of the mark ARNOLD BRAND for use with fresh tomatoes because nothing in the record indicated 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 or services in the class. *See Krause*, 76 USPQ2d at 1911.

1206.03 When Inquiry is Required

Generally, if a mark comprises a name, portrait, or signature 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. If there is sufficient evidence that the name, portrait, or signature identifies a particular living individual, the examining attorney may exercise discretion regarding whether to issue a §2(c) refusal instead of an inquiry.

Full Name. If a mark contains a full name, consisting of a first name/initial(s) and a 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 generally known or publicly connected with the business in which the mark is used before making the inquiry. If there is sufficient evidence that the individual is generally known or publicly connected with the business in which the mark is used, the examining attorney may, at his or her discretion, issue a §2(c) refusal rather than an inquiry.

Example: The mark is STEVEN JONES (or S. JONES), the application is silent as to whether the name identifies a living individual, and there is no evidence that the individual is generally known or publicly connected with the business in which the mark is used. 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 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 generally known or publicly connected with the business in which the mark is used before making the inquiry. If there is sufficient evidence that the individual is generally known or publicly connected with the business in which the mark is used, the examining attorney may, at his or her discretion, issue a §2(c) refusal rather than an 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 because they are names of well-known fictitious characters. Likewise, 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," "The Amazing Jeffrey," or "Aunt Sally"), the examining attorney must determine whether there is evidence that the name identifies an individual who is generally known or is publicly connected with the business in which the mark is used and, as a result, the relevant public would perceive the name as identifying a particular living individual. See TMEP §1206.02 regarding the meaning of "publicly connected."

Whether the relevant public would perceive a first name, pseudonym, stage name, surname, nickname, or title as identifying a particular individual usually depends on whether the particular individual has achieved some public recognition under that name, either generally or in connection with the relevant industry, business entity, goods, or services (e.g., as the inventor of the goods or services, the public face of the company, or a notable user of the products). *See In re Sauer*, 27 USPQ2d 1073, 1074-75 (TTAB 1993) (holding registration of a mark containing BO, used in connection with a sports ball, barred under §2(c) in the absence of consent to register, because BO is the nickname of a well-known athlete and thus use of the mark would lead to the assumption that he was associated with the goods), *aff'd per curiam*, 26 F.3d 140 (Fed. Cir. 1994); *Reed v. Bakers Eng'g & Equip. Co*., 100 USPQ 196 (PTO 1954) (holding registration of REED REEL OVEN barred by §2(c) in the absence of written consent to register from the designer and builder of the ovens, Paul N. Reed).

Typically, in the absence of fame or public recognition, first names, pseudonyms, stage names, surnames, nicknames, and titles are not necessarily associated with a particular individual. Thus, when the name in a mark is a first name, pseudonym, stage name, surname, nickname, or title, an inquiry is usually unnecessary unless the available information indicates that the relevant public will recognize or perceive the name as identifying a particular individual. *See Société Civile Des Domaines Dourthe Frères v. S.A. Consortium Vinicole De Bordeaux Et De La Gironde*, 6 USPQ2d 1205, 1209 (TTAB 1988).

Example: The mark is DOCTOR JONES, and the application is silent as to whether this name identifies a living individual. Unless there is evidence that the name identifies an individual who is generally known or publicly connected with the business in which the mark is used, the examining attorney should not issue an inquiry or §2(c) refusal.

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 identifies an individual who is generally known or publicly connected with the business in which the mark is used, the examining attorney should not issue an inquiry or §2(c) refusal.

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 identifies an individual who is generally known or publicly connected with the business in which the mark is used, the examining attorney should not issue an inquiry or §2(c) refusal.

Because there must be some indication that the relevant public would actually perceive the name as identifying a particular individual, the mere fact that the name is the first name, pseudonym, stage name, surname, nickname, or title of a living individual associated with the applicant (e.g., an employee, founder, or corporate officer) usually would not, by itself, necessitate an inquiry regarding the name.

Example: The mark is DAVE'S AUTO SHOP and the application is silent as to whether the name identifies a living individual. A review of the applicant's website indicates the owner of the shop is Dave Smith. In the absence of evidence that the relevant public recognizes DAVE as identifying Dave Smith, either generally (such as recognition as a former professional athlete or television personality) or with respect to the specific services (such as through numerous references in trade publications or social media postings), the examining attorney need not inquire whether the name DAVE is that of a particular living individual.

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 obtain 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. If the mark comprises a name that is distinctive and well known (e.g., Leonardo da Vinci), the examining attorney may consult with his or her manager regarding foregoing the inquiry. If there is evidence that the name, portrait, or signature identifies a particular living individual, the examining attorney may exercise discretion regarding whether to issue a §2(c) refusal instead of an inquiry. See TMEP §§1206 and 1206.04(a) regarding marks that consist of or comprise a name, portrait, or signature of a deceased U.S. president with a living widow.

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. 15 U.S.C. §1052(c). The consent must be a written consent to the registration of the identifying matter as a mark, and, in the case of a living individual, must be personally signed by the individual whose name, signature, or likeness appears in the mark. Where the name, signature, or likeness is that of a deceased president, the consent should be signed by the president's surviving spouse.

Consent to Use is Not Consent to Registration. Consent to use of a mark does not constitute consent to register. *See Krause v. Krause Pub'ns, Inc.*, 76 USPQ2d 1904, 1913 (TTAB 2005); *Reed v. Bakers Eng'g & Equip. Co.*, 100 USPQ 196, 199 (PTO 1954); *Garden v. Parfumerie Rigaud, Inc.*, 34 USPQ 30, 31 (Comm'r Pats. 1937) ("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. *AlfordMfg. Co. v. Alfred Elecs.*, 137 USPQ 250, 250 (TTAB 1963)

("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 . . . .") , *aff'd*, 333 F.2d 912, 142 USPQ 168 (C.C.P.A. 1964); *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 is entered into the Trademark database. *See*TMEP §§813.01(a)and (c). 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. In such cases, the examining attorney must ensure that the consent statement is entered into the Trademark database. *See*TMEP §§813.01(a)and (c).

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 is entered into the Trademark database. *See*TMEP §§ 813.01(a)and (c).

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 and/or services, or such goods and/or services as would encompass those in the subsequent

application. *See In re McKee Baking Co.*, 218 USPQ 287, 288 (TTAB 1983). 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 or email, the examining attorney must enter an appropriate Note to the File in the record. The examining attorney must ensure that the consent statement is entered into the Trademark database. *See*TMEP §§813.01(a) and (c).

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 companion applications, but the applicant must submit a copy of the consent for each pending application. *See In re McKee Baking Co.* , 218 USPQ at 288; 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) (finding consent to the use and registration of the mark D. B. KAPLAN'S DELICATESSEN 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 Publ'ns, Inc.*, 76 USPQ2d 1904, 1912 (TTAB 2005) (finding cancellation petitioner did not give implied consent to register when he incorporated a business utilizing his name, sold his stock in the business, and pledged the business's assets, including trademarks, to finance expansion and acquisitions, 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) (finding consent to register JOHN NISSEN MANNEQUINS not implied from appearance of the name "John Nissen" in a deed of incorporation of applicant's predecessor under the name "John Nissen Mannequins," nor from existence of foreign registrations for trademarks 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 §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. *See*TMEP §813.01(b).

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

15 U.S.C. §1052 Extract

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 regardless of whether registration of the mark is sought on the Principal Register or the Supplemental Register.

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 regarding the §2(d) provision relating to marks that so resemble another mark as to be likely to deceive, and §1207.03 regarding §2(d) refusals based on unregistered marks (which generally are not issued in ex parte examination).

The issue is not whether the respective marks themselves, or the goods or services offered under the marks, are likely to be confused but, rather, whether there is a likelihood of confusion as to the source or sponsorship of the goods or services because of the marks used thereon. *See, e.g., In re Majestic Distilling Co.*, 315 F.3d 1311, 1316, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003) ("[T]he . . . mistaken belief that [a good] is manufactured or sponsored by the same entity [as another good] . . . is precisely the mistake that §2(d) of the Lanham Act seeks to prevent."); *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993) ("The degree of 'relatedness' must be viewed in the context of all the factors, in determining whether the services are sufficiently related that a reasonable consumer would be confused as to source or sponsorship."); *Paula Payne Prods. Co. v. Johnson's Publ'g Co.*, 473 F.2d 901, 902, 177 USPQ 76, 77 (C.C.P.A. 1973) ("[T]he question is not whether people will confuse the marks, but rather whether the marks will confuse people into believing that the goods they identify emanate from the same source."); *In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *2-3 (TTAB 2019) ("[T]he overriding concern is not only to prevent buyer confusion as to the source of the goods, but also to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer."); *Hilson Research Inc. v. Soc'y for Human Res. Mgmt.*, 27 USPQ2d 1423, 1429 (TTAB 1993) ("Although confusion, mistake or deception about source or origin is

the usual issue posed under Section 2(d), any confusion made likely by a junior user's mark is cause for refusal; likelihood of confusion encompasses confusion of sponsorship, affiliation or connection.").

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 §§1208-1208.03(c) regarding conflicting marks. The examining attorney must include 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 or marks, the examining attorney refuses registration of the applicant's mark 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 Trademark 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 must check the automated records of the Assignment Recordation Branch of the USPTO to determine whether the conflicting mark has been assigned to applicant.

In the seminal case involving §2(d), *In re E. I. du Pont de Nemours and Company*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), the U.S. Court of Customs and Patent Appeals, the predecessor court of the U.S. Court of Appeals for the Federal Circuit, discussed the factors relevant to a determination of likelihood of confusion. In setting forth the factors, the court cautioned that, with respect to determining likelihood of confusion, "[t]here is no litmus rule which can provide a ready guide to all cases." *Id*. at 1361, 177 USPQ at 567. Not all of the factors are relevant and only those relevant factors for which there is evidence in the record must be considered. *Id.* at 1361-62, 177 USPQ at 567-68; *see In re Guild Mortg. Co.*, 912 F.3d 1376, 1379, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)); *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1372, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010)) ("'Not all of the DuPont factors are relevant to every case, and only factors of significance to the particular mark need be considered.'"). Furthermore, the significance or weight of a particular factor may differ from case to case. *See Stratus Networks, Inc. v. UBTA-UBET Commc'ns Inc.*, 955 F.3d 994, 998, 2020 USPQ2d 10341, at *3 (Fed. Cir. 2020) ("Any single factor may control a particular case.").

Although the weight given to the relevant *du Pont* factors may vary, the following two factors are key considerations in any likelihood of confusion determination:

- 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 the application and registration(s).

See, e.g., Stratus Networks, Inc., 955 F.3d at 999, 2020 USPQ2d 10341, at *5 (quoting *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001)); *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int'l Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *In re Embiid*, 2021 USPQ2d 577, at *11 (TTAB 2021) (quoting *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976)).

The following factors may also be relevant in an ex parte likelihood-of-confusion determination and must be considered if there is pertinent evidence in the record:

- 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 (*see*TMEP §1207.01(d)(vii)).
- The number and nature of similar marks in use on similar goods (*see*TMEP §1207.01(d)(iii)).
- The existence of a valid consent agreement between the applicant and the owner of the previously registered mark (*see*TMEP §1207.01(d)(viii)).

See, e.g., *In re i.am.symbolic, llc*, 866 F.3d at 1325, 1327, 123 USPQ2d at 1749, 1751; *du Pont*, 476 F.2d at 1361-63, 177 USPQ at 567-69; *In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, at *6-7 (TTAB 2020); *In re Am. Cruise Lines, Inc.*, 128 USPQ2d 1157, 1158-60, 1161-63 (TTAB 2018); *In re Thor Tech, Inc.*, 113 USPQ2d 1546 (TTAB 2015); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1272-74 (TTAB 2009); *Ass'n of the U.S. Army*, 85 USPQ2d at 1271-73.

See TMEP §1207.01(d)(ii) regarding the "actual confusion" factor and §1207.01(d)(ix) regarding the "fame of the prior mark" factor.

There is no mechanical test for determining likelihood of confusion and "each case must be decided on its own facts." *du Pont*, 476 F.2d at 1361, 177 USPQ at 567. In some cases, a determination that there is no likelihood of confusion may be appropriate, even where the marks are similar and the goods or services are related, because these factors are outweighed by other factors, such as differences in the relevant trade channels of the goods or services, the presence in the marketplace of a significant number of similar marks in use on similar goods or services, the existence of a valid consent agreement between the parties, or another established fact probative of the effect of use. For example, in *In re Strategic Partners, Inc.*, 102 USPQ2d 1397 (TTAB 2012), the Board reversed a refusal to register the mark ANYWEAR (in stylized text), for "footwear," finding no likelihood of confusion with the registered mark ANYWEAR BY JOSIE NATORI (and design), for "jackets, shirts, pants, stretch T-tops and stoles." Given the similarity in the marks and the relatedness of the goods, the Board stated that "under usual circumstances" it would conclude that confusion is likely to occur; however, an "unusual situation" compelled the Board "to balance the similarities between the marks and goods against the facts that applicant already own[ed] a registration for a substantially similar mark for the identical goods, and that applicant's registration and the cited registration ha[d] coexisted for over five years." *Id.* at 1399. Applicant's prior registration of ANYWEARS (in standard characters) for goods including footwear was "substantially similar" to the applied-for mark ANYWEAR for the same goods, and the prior registration had achieved incontestable status "and thus [was] not subject to attack by the owner of the cited registration on a claim of priority and likelihood of confusion." *Id.* Basing its decision on the thirteenth *du Pont* factor, which "relates to 'any other established fact probative of the effect of use,'" the Board determined that this factor outweighed the others and confusion was unlikely. *Id.* at 1399-1400 (quoting *du Pont*, 476 F.2d at 1361, 177 USPQ at 567).

In view of *Strategic Partners*, when determining whether the coexistence of the applicant's prior registration with another party's registration weighs against citing the latter registration in a §2(d) refusal of the applicant's applied-for mark, the examining attorney should consider the following: (1) whether the applicant's prior registered mark is the same as the applied-for mark or is otherwise not meaningfully different; (2) whether the identifications of goods or services in the application and the applicant's prior registration are identical or identical in relevant part; and (3) the length of time the applicant's prior registration has co-existed with the registration being considered as the basis for the §2(d) refusal. *See id.* at 1400; *see also In re Country*

Oven, Inc., 2019 USPQ2d 443903, at *16-18 (citing TMEP §1207.01) (finding applicant's over five-year-old prior registration was for different services than in the application at issue, such that its coexistence with the cited registration did not weigh against a finding of likelihood of confusion); *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1748 (TTAB 2018) (finding applicant's over five-year-old prior registration of a partially similar mark was a neutral factor in the §2(d) analysis, because the applied-for mark was more similar to the cited registered mark than applicant's previously registered mark). The duration of coexistence is not dispositive as to whether a §2(d) refusal should issue; instead, this *du Pont* factor should be considered together with all the other relevant *du Pont* factors. *See In re Strategic Partners, Inc.*, 102 USPQ2d at 1400; *cf. In re Embiid*, 2021 USPQ2d 577, at *43-44 (distinguishing *Strategic Partners* and finding that the mark in applicant's prior registration is meaningfully different from the applied-for mark and has been registered for fewer than five years); *In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1793 (TTAB 2017) (distinguishing *Strategic Partners* and finding that the 3½-year coexistence of applicant's prior registration and the cited registration was a relevant consideration but did not outweigh the other relevant *du Pont* factors). However, where the registered and applied-for marks were substantially similar and the goods were identical, the five-years coexistence in *Strategic Partners* supported this *du Pont* factor, outweighing an otherwise strong likelihood-of-confusion showing. *In re Strategic Partners, Inc.*, 102 USPQ2d at 1399-1400.

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 or services, the more similar the marks at issue, the less similar the goods or services need to be to support a finding of likelihood of confusion. *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); *Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *44 (TTAB 2022) (quoting *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1440 (TTAB 2012)); *In re House Beer, LLC*, 114 USPQ2d 1073, 1077 (TTAB 2015); *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1353 (TTAB 2015) (citing *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001)). If the marks of the respective parties are identical or virtually 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 if there were differences between the marks. *In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *5 (TTAB 2019) ("Where identical marks are involved, . . . the degree of similarity between the goods and services that is required to support a finding of likelihood of confusion declines.") (citing *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2011), *aff'd*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017)); *In re Shell Oil Co.*, 992 F.2d at 1207, 26 USPQ2d at 1689 ("even when goods or services are not competitive or intrinsically related, the use of identical marks can lead to the assumption that there is a common source"); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202 (TTAB 2009).

In some instances, because of established marketing practices, the use of identical marks on seemingly unrelated goods or services could result in a likelihood of confusion. *See In re Sloppy Joe's Int'l, Inc.*, 43 USPQ2d 1350, 1356 (TTAB 1997) ("[T]he licensing of the names and/or likenesses of well known persons for use on various goods and services is a common practice."); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949, 951 (TTAB1986) ("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

In a §2(d) determination, the goods or services do not have to be identical or even competitive to find a likelihood of confusion. *In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, at *5 (TTAB 2020) (citing *In re Iolo Techs.*, LLC, 95 USPQ2d 1498, 1499 (TTAB 2010)); *In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1368 (TTAB 2009). The issue is not whether the goods and/or services will be confused with each other, but rather whether consumers would be confused as to their source. *See Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) ("[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis."); *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); *In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, at *5 (citing *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1439 (TTAB 2012); *In re Rexel Inc.*, 223 USPQ 830, 832 (TTAB 1984)). The goods or services of the applicant and the registrant need only be related in some manner and/or the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (citing *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); *see, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1082-87, 56 USPQ2d 1471, 1472-76 (Fed. Cir. 2000) (holding ON-LINE TODAY for Internet connection services and ONLINE TODAY for an electronic publication likely to cause confusion); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984) (holding MARTIN'S for wheat bran and honey bread, and MARTIN'S for cheese, likely to cause confusion); *Weider Publ'ns, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347 (TTAB 2014) (holding SHAPES for a variety of beauty salon, day spa, and health spa services likely to cause confusion with SHAPE for magazines where the services are of the type normally featured in the magazines); *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1433 (TTAB 2013) (holding GOTT LIGHT for various water beverages likely to cause confusion with GOTT and JOEL GOTT for wine); *Gen. Mills, Inc. v. Fage Dairy Processing Indus. S.A.*, 100 USPQ2d 1584, 1597 (TTAB 2011) (holding composite marks containing the word TOTAL for yogurt and other products likely to cause confusion with the mark TOTAL for ready-to-eat breakfast cereal); I *n re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266 (TTAB 2009) (holding VANTAGE TITAN for MRI diagnostic apparatus, and TITAN for medical ultrasound device, likely to cause confusion); *L.C. Licensing, Inc. v. Berman*, 86 USPQ2d 1883 (TTAB 2008) (holding ENYCE for custom automotive accessories, and ENYCE for various urban lifestyle clothing items and accessories, likely to cause confusion); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (holding CONFIRM for a buffered solution equilibrated to yield predetermined dissolved gas values in a blood gas analyzer, and CONFIRMCELLS for diagnostic blood reagents for laboratory use, likely to cause confusion).

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 may not be likely. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d at 1371, 101 USPQ2d at 1723 (affirming the Board's dismissal of opposer's likelihood-of-confusion claim, noting "there is nothing in the record to suggest that a purchaser of test preparation materials who also purchases a luxury handbag would consider the goods to emanate from the same source" though both were offered under the COACH mark); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244-45, 73 USPQ2d 1350, 1356 (Fed. Cir. 2004) (reversing TTAB's holding that contemporaneous use of RITZ for cooking and wine selection classes and RITZ for kitchen textiles is likely to cause confusion, because the relatedness of the respective goods and services was not supported by substantial evidence); *In re Thor Tech, Inc.*, 113 USPQ2d 1546, 1551 (TTAB 2015) (holding use of identical marks for towable trailers and trucks not likely to cause confusion given the difference in the nature of the goods and their channels of trade and the high degree of consumer care likely to be exercised by the relevant consumers).

1207.01(a)(ii) Establishing Relatedness of Goods to Services

It is well recognized that confusion may be 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 Detroit Athletic Co.*, 903 F.3d 1297, 1307 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (finding clothing and sports apparel retail services related as "confusion is likely where one party engages in retail services that sell goods of the type produced by the other party"); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025-26 (Fed. Cir. 1988) (holding BIGG'S (finding furniture and retail grocery and general merchandise store services related); *In re H.J. Seiler Co.*, 289 F.2d 674, 129 USPQ 347 (C.C.P.A. 1961) (finding catering food services related to smoked and cured meats); *In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *13-14 (TTAB 2019) (finding bread buns and retail bakery shops related); *In re United Serv. Distribs., Inc.*, 229, 239-40 USPQ 237 (TTAB 1986) (finding skin cream and distributorship services in the field of health and beauty aids related); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949, 951 (TTAB 1986) (finding clothing and restaurant services related); *In re U.S. Shoe Corp.*, 229 USPQ 707, 708 (TTAB 1985) (finding retail women's clothing store services uniforms related); *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433, 435 (TTAB 1983) (refinishing of furniture, office furniture, and machinery related to office furniture and accessories); *Corinthian Broad. Corp. v. Nippon Elec. Co., Ltd.*, 219 USPQ 733, 736 (TTAB 1983) (finding transmitters and receivers of still television pictures related to television broadcasting services).

When the goods and services in question are well known or otherwise generally recognized as having a common source of origin, the burden of establishing relatedness is easier to satisfy. *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082 (Fed. Cir. 2014). For example, relatedness would generally be recognized when the services clearly include or encompass the goods in the identification, such as when the services are "brewpubs" and the goods are "beer" or when the services are "electronic transmission of data and documents via computer terminals" and the goods are "facsimile machines, computers, and computer software." *In re Coors Brewing Co.*, 343 F.3d 1340, 1347, 68 USPQ2d 1059, 1064 (Fed. Cir. 2003); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002).

However, when the relatedness of the goods and services is not evident, well known, or generally recognized, "something more" than the mere fact that the goods and services are used together must be shown. *In re St. Helena Hosp.* , 774 F.3d at 754, 113 USPQ2d at 1087 (finding that substantial evidence did not support relatedness of hospital-based residential weight and lifestyle program and printed materials dealing with physical activity and fitness). Therefore, when comparing services such as "restaurant services" with less apparently related goods such as "beer," or "cooking classes" with "kitchen towels," "something more"—beyond the fact that the goods are used in the provision of the services—must be shown to indicate that consumers would understand such services and goods to emanate from the same source. Although the Court in Coors found evidence of "a few registrations" covering both the goods and services at issue insufficient, *see In re Coors Brewing Co.* , 343 F.3d at 1346, 68 USPQ2d at 1063, examples of actual use of a mark for both the goods and services at issue and/or evidence of a large number of third-party registrations covering both the goods and services at issue may suffice. When such evidence is not readily available through searches of electronic resources, examining attorneys should consider issuing an information request under 37 C.F.R. §2.61(b), asking whether the applicant provides both the goods and services at issue and inquiring whether the applicant is aware of others who provide both the goods and services at issue, and if so, requesting additional information about them.

1207.01(a)(ii)(A) Food and Beverage Products Versus Restaurant Services

While likelihood of confusion has often been found 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. *See Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 768, 25 USPQ2d 2027, 2030 (Fed. Cir. 1993); *In re Opus One Inc.*,

60 USPQ2d 1812, 1813 (TTAB 2001) . Thus, the relatedness of such goods and services may not be assumed and the evidence of record 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) (quoting *Jacobs v. Int'l Multifoods Corp.*, 668 F.2d 1234, 1236, 212 USPQ 641, 642 (C.C.P.A. 1982)); *see also In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011).

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 several third-party registrations showing that a single mark had been registered for both beer and restaurants services. 343 F.3d at 1345, 68 USPQ2d at 1063. 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. *Id*. at 1346, 68 USPQ2d at 1063. 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.

Id. at 1346, 68 USPQ2d at 1063–64.

In the following cases, the Board found the "something more" requirement to be satisfied: *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1060 (TTAB 2017) (holding TAO VODKA for alcoholic beverages likely to cause confusion with the mark TAO for restaurant and nightclub services where the record showed that petitioner used the TAO mark to promote alcoholic beverages, its primary source of revenue, and that its menus featured beverages with TAO-formative names, amongst other business practices linking the TAO mark with alcohol, which met the requisite "something more" to establish that the goods and services were related); *In re Accelerate s.a.l.*, 101 USPQ2d 2047, 2050-51 (TTAB2012) (holding COLOMBIANO COFFEE HOUSE, for providing food and drink, likely to cause confusion with the registered certification mark COLOMBIAN, for coffee, given the inclusion of COFFEE HOUSE in applicant's mark, third-party registrations covering both restaurant or café services and coffee beverages, and because coffee houses specialize in coffee beverages); *In re Opus One Inc.*, 60 USPQ2d at 1814-16 (holding use of OPUS ONE for both wine and restaurant services likely to cause confusion, where the evidence of record indicated that OPUS ONE is a strong and arbitrary mark, 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 served at applicant's restaurant); *In re Comexa Ltda.*, 60 USPQ2d 1118, 1123 (TTAB 2001) (holding AMAZON and parrot design for chili sauce and pepper sauce and AMAZON for restaurant services likely to cause confusion, based on, inter alia, 48 use-based third-party registrations showing registration of the same mark for both sauces and restaurant services, and the determination that "of all food products[,] sauces . . . are perhaps the ones most likely to be marketed by the restaurants in which those items are served"); *In re Azteca Rest. Enters.*, 50 USPQ2d 1209, 1211 (TTAB1999) (holding AZTECA MEXICAN RESTAURANT for restaurant

services and AZTECA (with and without design) for Mexican food items likely to cause confusion, where the AZTECA MEXICAN RESTAURANT mark itself indicated that the relevant restaurant services featured Mexican food and the evidence showed that the goods at issue "are often principal items of entrees served by . . . Mexican restaurants"); *In re Golden Griddle Pancake House Ltd.*, 17 USPQ2d 1074 (TTAB 1990) (holding GOLDEN GRIDDLE for table syrup and GOLDEN GRIDDLE PANCAKE HOUSE for restaurant services likely to cause confusion, based on third-party registration evidence showing that entities offering restaurant services may also offer a variety of goods under the same mark, as well as findings that "restaurants frequently package certain of their products for retail sale" and that the GOLDEN GRIDDLE PANCAKE HOUSE mark itself suggests that the relevant restaurant services feature pancakes and pancake syrup); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1469 (TTAB) (holding use of applied-for mark, MUCKY DUCK and duck design, for mustard, and registered mark, THE MUCKY DUCK and duck design, for restaurant services, likely to cause confusion, in view of the substantial similarity of the marks and the "unique and memorable nature" of registrant's mark, and given that "mustard is . . . a condiment which is commonly utilized in restaurants by their patrons" and that "restaurants sometimes market their house specialties, including items such as salad dressings, through retail outlets"), *aff'd per curiam*, 864 F.2d 149 (Fed. Cir. 1988). *Cf. In re Giovanni Food Co.*, 97 USPQ2d at 1991 (finding the Office had not met its burden of proving likelihood of confusion where the marks were JUMPIN' JACKS for barbeque sauce and JUMPIN JACK'S for catering services, because evidence indicating that some restaurants also provide catering services and sell barbeque sauce was not sufficient to establish catering services alone are related to barbeque sauce); *Steve's Ice Cream v. Steve's Famous Hot Dogs*, 3 USPQ2d 1477, 1478 (TTAB1987) (holding use of applicant's mark, STEVE'S and design comprising hot dog characters, for restaurants featuring hot dogs, and registrant's mark STEVE'S, for ice cream, not likely to cause confusion, where the marks differed and there was no evidence of record that applicant made or sold 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 and cited registration. *See, e.g.*, *B & B Hardware, Inc. v. Hargis Inds., Inc.*, 135 S. Ct. 1293, 1300 (2015) (recognizing that an "applicant's right to register must be made on the basis of the goods described in the application"); *In re Detroit Athletic Co.*, 903 F.3d 1297, 1308, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018); *Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1370, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1463, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991); *Octocom Sys., Inc. v. Hous. Computer Servs., Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Canadian Imperial Bank of Com., N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1493, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); *Paula Payne Prods. Co. v. Johnson Publ'g Co.*, 473 F.2d 901, 902, 177 USPQ 76, 77 (C.C.P.A. 1973); *In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, at *5 (TTAB 2020); *New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *13 (TTAB 2020); *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1500 (TTAB 2010).

If the cited registration describes goods or services broadly, and there is no limitation as to their 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.*, *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 1373, 107 USPQ2d 1167, 1173 (Fed. Cir. 2013); *New Era Cap Co.*, 2020 USPQ2d 10596, at *15-16 (citing *SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 1042-43, 216 USPQ 937, 940 (Fed. Cir. 1983); *In re*

Bercut-Vandervoort & Co., 229 USPQ 763, 764 (TTAB 1986)) ("the Board may not read limitations into [the] unrestricted registration or [] application"); *see also B & B Hardware, Inc. v. Hargis Inds., Inc.*, 135 S. Ct. 1293, 1300 (2015) (explaining that "if an application does not delimit any specific trade channels of distribution, no limitation will be applied" (cleaned up)). 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 (TTAB1992) (noting that, where 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 must be assumed that registrant's goods encompass all such computer programs, including computer programs of the type offered by applicant, that they travel in the same channels of trade normal for such goods, and that they are available to all classes of prospective purchasers of those goods); *In re Diet Ctr., Inc.*, 4 USPQ2d 1975 (TTAB1987) (noting that, although applicant had limited its identification to indicate that its goods were sold only through franchised outlets offering weight-reduction services, the cited registration's identification contained no limitations as to trade channels or classes of customers and thus it must be presumed that registrant's goods travel through all the ordinary channels of trade).

Similarly, there may be a likelihood of confusion where 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 Solid State Design Inc.*, 125 USPQ2d 1409, 1413, 1415 (TTAB 2018) (holding POPULACE and design for computer software intended for travel and destination marketing organizations and travel marketing professionals, and POPULACE (stylized) for computer software for visualizing the popularity of places in real time with an underlying map capability for navigation sold only as business to consumer software and not as "business to business" software, likely to cause confusion); *In re Fiesta Palms LLC*, 85 USPQ2d 1360 (TTAB 2007) (holding CLUB PALMS MVP for casino services, and MVP for casino services offered to preferred customers identified by special identification cards, likely to cause confusion); *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986) (holding RESPONSE for banking services, and RESPONSE CARD for banking services rendered through 24-hour teller machines, likely to cause confusion).

In addition, language seeking to limit otherwise identical, or highly similar, goods or services may not be sufficient to distinguish them so as to avoid a likelihood of confusion. *See In re i.am.symbolic, llc*, 866 F.3d 1315, 1326, 123 USPQ2d 1744, 1751 (Fed. Cir. 2017) (affirming the Board's finding that an identification restricting the goods to those "associated with William Adams, professionally known as 'will.i.am,'" imposed no meaningful limitation on the nature of the goods or the trade channels or classes of purchasers of the goods); *Bd. of Regents, Univ. of Tex. Sys. v. S. Ill. Miners, LLC*, 110 USPQ2d 1182, 1190-93 (TTAB 2014) (finding that although opposer's clothing items were limited by the wording "college imprinted" and the applicant's identical or highly similar items were limited by the wording "professional baseball imprinted," these restrictions did not distinguish the goods, their trade channels, or their relevant consumers in any meaningful way).

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 FCA US LLC*, 126 USPQ2d 1214, 1217 (TTAB 2018); *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647 (TTAB 2008) ; *In re Bercut-Vandervoort & Co.*, 229 USPQ at 764–65; *see also In re Detroit Athletic Co.*, 903 F.3d at 1308, 128 USPQ2d at 1052 ("The third DuPont factor—like the second factor—must be evaluated with an eye toward the channels specified in the application and registration, not those as they exist in the real world.").

In cases where the terminology in an identification is unclear or undefined, 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. *See, e.g., In re Thor Tech, Inc.*, 90 USPQ2d at 1638 & n.10 (noting that, although extrinsic evidence may not be used to limit or restrict the identified goods, it is nonetheless proper to consider extrinsic evidence in the nature of dictionary entries to define the terminology used to describe the goods); *In re Trackmobile Inc.*, 15 USPQ2d 1152, 1154 (TTAB 1990) (noting that, "when the description of goods for a cited registration is somewhat unclear . . . it is improper to simply consider that description in a vacuum and attach all possible interpretations to it when the applicant has presented extrinsic evidence showing that the description of goods has a specific meaning to members of the trade.")

1207.01(a)(iv) No "Per Se" Rule

The facts in each case vary and the weight to be given each relevant *du Pont* 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, 1285 (TTAB 2009) (regarding alcoholic beverages); *Info. Res. Inc. v. X*Press Info. Servs.*, 6 USPQ2d 1034, 1038 (TTAB 1988) (regarding computer hardware and software); *Hi-Country Foods Corp. v. Hi Country Beef Jerky*, 4 USPQ2d 1169, 1171–72 (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) (regarding clothing); *see also M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 1383, 78 USPQ2d 1944, 1947–48 (Fed. Cir. 2006) (noting that relatedness between software-related goods may not be presumed merely because the goods are delivered in the same media format and that, instead, a subject-matter-based mode of analysis is appropriate).

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, Inc.*, 84 USPQ2d 1581, 1584 & n.4 (TTAB 2007) ; *see alsoIn re Kysela Pere et Fils, Ltd.*, 98 USPQ2d 1261, 1266 (TTAB 2011).

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. *SeeOrange Bang, Inc. v. Ole Mexican Foods, Inc.*, 116 USPQ2d 1102, 1119 (TTAB 2015) (noting that the "natural zone of expansion" doctrine normally applies in inter partes cases in the context of the parties' dueling claims of priority); *1st USA Realty Prof'ls*, 84 USPQ2d 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 . . . 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, e.g., In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009) (finding Office had failed to establish that wine and vodka infused with caffeine are related goods because there was no evidence that vodka and wine emanate from a single source under a single mark or that such goods are complementary products that would be bought and used together). Evidence of relatedness may include news articles and/or evidence from computer databases showing that the relevant goods or services are used together or used by the same purchasers; advertisements showing that the relevant goods or services are advertised together or sold by the same manufacturer or dealer; and/or copies of prior use-based registrations of the same mark for both applicant's goods or services and the goods or services listed in the cited registration. *E.g., In re Ox Paperboard, LLC* 2020 USPQ2d 10878, at *5 (TTAB 2020) (citing *In re Davia*, 110 USPQ2d 1810, 1817 (TTAB 2014); *In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *4-5 (TTAB 2019). See TMEP §1207.01(d)(iii) and cases cited therein regarding the probative value of third-party registrations.

The identification of goods or 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) (finding the Board erred in concluding that there was insufficient evidence of relatedness, because it "did not consider the important evidence already before it, namely the ITU application and [opposer's] registrations").

1207.01(b) Similarity of the Marks

Under *In re E. I. du Pont de Nemours & Company*, 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 is not whether the marks can be distinguished when subjected to a side-by-side comparison, but whether "the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties." *In re i.am.symbolic, LLC*, 866 F.3d 1315, 1323, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012)); *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 2-3 (C.C.P.A. 1977); *In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, at *4-5 (TTAB 2020).

When comparing 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) (citing *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 202-03, 22 USPQ2d 1542, 1544-45 (Fed. Cir. 1992); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985)). However, the analysis is based on the marks as depicted in the respective application and registration, without regard to whether the marks will appear with other marks, such as house marks, or other elements when used. *SeeIn re Shell Oil Co.*, 992 F.2d 1204, 1207 n.4, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993) (indicating that applicant's assertions that the applied-for mark would appear with applicant's house mark were not considered in the likelihood-of-confusion determination); *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1186 (TTAB 2018) ("[W]e do not consider how Applicant and Registrant actually use their marks in the marketplace, but rather how they appear in the registration and the application. We must compare the marks as they appear in the drawings, and not on any labels that may have additional wording or information."); *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016)(rejecting applicant's argument that, because its mark would appear along with its house mark and

other distinguishing matter, the marks at issue were not confusingly similar); *see alsoCunningham v. Laser Golf Corp.*, 222 F. 3d 943, 950, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000)("Registrations with typed drawings are not limited to any particular rendition of the mark and, in particular, are not limited to the mark as it is used in commerce.").

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. *In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, at *4 (citing *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016)); *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018); *see In re St. Helena Hosp.*, 774 F.3d 747, 750-51, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014); *Neutrogena Corp. v. Bristol-Myers Co.*, 410 F.2d 1391, 161 USPQ 687, 688 (C.C.P.A. 1969) (many consumers "may have but dim recollections from having previously seen or heard one or the other of the involved marks.").

The Court of Appeals for the Federal Circuit has provided the following guidance for evaluating the marks:

> 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. 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. 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. Indeed, this type of analysis appears to be unavoidable.

In re Nat'l Data Corp., 753 F.2d at 1058, 224 USPQ at 750-51 (Fed. Cir. 1985) (footnotes omitted) (citations omitted); *see Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 1322, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014).

When the goods or services are identical or virtually identical, the degree of similarity between the marks necessary to support a determination that confusion is likely declines. See *Bridgestone Ams. Tire Operations, LLC v. Fed. Corp.*, 673 F.3d 1330, 1337, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012); *In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); *Century 21 Real Est. Corp. v. Century Life of Am.*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992); *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *27 (TTAB 2021); *New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *14 (TTAB 2020); *Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, at *6 (TTAB 2019) (citing *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d at 1370, 101 USPQ2d at 1722); *In re Max Cap. Grp. Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010).

1207.01(b)(i) Word Marks

The points of comparison for a word mark are appearance, sound, meaning, and commercial impression. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1371, 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 determination that confusion is likely even if the goods are identical or closely related; rather, 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. *See In re Thor*

Tech, Inc., 90 USPQ2d 1634, 1635 (TTAB 2009); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988).

1207.01(b)(ii) Similarity In Appearance

Similarity in appearance is one factor to consider when comparing 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). Marks may be confusingly similar in appearance despite the addition, deletion, or substitution of letters or words. *See, e.g., Weiss Assocs. Inc. v. HRL Assocs. Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (finding TMM confusingly similar to TMS); *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (affirming Board's holding that source confusion is likely where COMMCASH and COMMUNICASH are used in connection with identical banking services); *Ava Enters. v. Audio Boss USA, Inc.*, 77 USPQ2d 1783 (TTAB 2006) (finding AUDIO BSS USA and design similar in appearance to BOSS AUDIO SYSTEMS (stylized)); *In re Lamson Oil Co.*, 6 USPQ2d 1041 (TTAB 1987) (finding TRUCOOL and TURCOOL confusingly similar in appearance); *In re Pix of Am.*, Inc., 225 USPQ 691 (TTAB 1985) (finding NEWPORTS and NEWPORT to be essentially identical in appearance); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (finding MILTRON and MILLTRONICS (stylized) to be highly similar in appearance); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (finding difference between marks LUTEX and LUTEXAL insufficient to avoid source confusion).

1207.01(b)(iii) Comparing Marks that Contain Additional Matter

Determining whether there is a likelihood of confusion requires careful consideration of the nature of the common elements of the marks at issue, as well as the overall commercial impression created by each mark.

Likelihood of confusion is not necessarily avoided between otherwise confusingly similar marks merely by adding or deleting a house mark, other distinctive matter, or a term that is descriptive or suggestive of the named goods or services; if the dominant portion of both marks is the same, then the marks may be confusingly similar notwithstanding peripheral differences. *See, e.g., In re Detroit Athletic Co.*, 903 F.3d 1297, 1304, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (affirming TTAB's finding that the marks DETROIT ATHLETIC CO. and DETROIT ATHLETIC CLUB are nearly identical in terms of sound, appearance and commercial impression, and noting that, while "the words 'Co.' and 'Club' technically differentiate the marks, those words do little to alleviate the confusion that is likely to ensue"); *Stone Lion Cap. Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 1322 110 USPQ2d 1157, 1161 (Fed. Cir. 2014) (affirming TTAB's finding that applicant's mark STONE LION CAPITAL incorporated the entirety of the registered marks LION CAPITAL and LION, and that the noun LION was the dominant part of both parties' marks); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1347-48, 94 USPQ2d 1257, 1260-61 (Fed. Cir. 2010) (affirming TTAB's finding that applicant's mark, ML, likely to be perceived as a shortened version of registrant's mark, ML MARK LEES (stylized), when used on the same or closely related skin-care products); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1372-73, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (affirming TTAB's holding that contemporaneous use of appellant's mark, VEUVE ROYALE, for sparkling wine, and appellee's marks, VEUVE CLICQUOT and VEUVE CLICQUOT PONSARDIN, for champagne, is likely to cause confusion, 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, 1266, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (finding that, even though applicant's mark PACKARD TECHNOLOGIES (with "TECHNOLOGIES" disclaimed) did not incorporate every feature of opposer's

HEWLETT PACKARD marks, a similar overall commercial impression was created); *Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, at *6-7 (TTAB 2019) (holding registrant's mark ROAD WARRIOR confusingly similar to petitioner's mark WARRIOR in that registrant's mark incorporated the entirety of petitioner's mark and the term ROAD was weak); *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1187 (TTAB 2018) ("[W]here . . . we are comparing a mark in standard characters to a mark that includes a pictorial representation of that term, the fact that the word + design mark includes such a pictorial representation will be taken into account to determine likelihood of confusion in terms of the marks' overall connotation and commercial impression."); *In re Max Cap. Grp. Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010) (holding applicant's mark, MAX with pillar design, and registrant's mark, MAX, likely to cause confusion, noting that the "addition of a column design to the cited mark . . . is not sufficient to convey that [the] marks . . . identify different sources for legally identical insurance services"); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1271 (TTAB 2009) (holding VANTAGE TITAN for MRI diagnostic apparatus, and TITAN for medical ultrasound device, likely to cause confusion, noting that the marks are more similar than they are different and that the addition of applicant's "product mark," VANTAGE, to the registered mark would not avoid confusion); *In re SL&E Training Stable, Inc.*, 88 USPQ2d 1216, 1219 (TTAB 2008) (holding SAM EDELMAN and EDELMAN, both for wallets and various types of bags, likely to cause confusion, noting that there are strong similarities between the marks because they share the same surname, and that consumers viewing the mark EDELMAN may perceive it as an abbreviated form of SAM EDELMAN because it is the practice in the fashion industry to refer to surnames alone); *In re Chica, Inc.*, 84 USPQ2d 1845, 1848-49 (TTAB 2007) (holding CORAZON BY CHICA with design, and CORAZON with design, both for jewelry, likely to cause confusion, noting that, "to many consumers, applicant's mark for the identical word 'Corazon' followed by the phrase 'BY CHICA' will simply be viewed as the identification of the previously anonymous source of the goods sold under the mark CORAZON"); *In re El Torito Rests. Inc.*, 9 USPQ2d 2002 (TTAB 1988) (holding MACHO COMBOS (with "COMBOS" disclaimed), and MACHO (stylized), both for food items as a part of restaurant services, likely to cause confusion); *In re Computer Sys. Ctr. Inc.*, 5 USPQ2d 1378, 1381 (TTAB 1987) (holding CSC ADVANCED BUSINESS SYSTEMS for retail computer store services and computer maintenance and repair services in connection therwith, and CSC for various computer-related services, likely to cause confusion, noting that "the inclusion of 'ADVANCED BUSINESS SYSTEMS' as a feature of applicant's mark is not likely to help customers . . . distinguish the source of each party's service"); *In re Equitable Bancorporation*, 229 USPQ 709, 711 (TTAB 1986) (holding RESPONSE and RESPONSE CARD (with "CARD" disclaimed), both for banking services, likely to cause confusion, noting that "the addition of descriptive matter to one of two otherwise similar, nondescriptive marks will not serve to avoid a likelihood of confusion"); *In re Apparel Ventures, Inc.*, 229 USPQ 225, 226 (TTAB 1986) (holding applicant's mark, SPARKS BY SASSAFRAS (stylized), for clothing, and registrant's mark, SPARKS (stylized), for footwear, likely to cause confusion, noting that "[t]hose already familiar with registrant's use of its mark in connection with its goods, upon encountering applicant's mark on applicant's goods, could easily assume that 'sassafras' is some sort of house mark that may be used with only some of the 'SPARKS' goods"); *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985) (holding CONFIRM for a buffered solution equilibrated to yield predetermined dissolved gas values in a blood-gas analyzer, and CONFIRMCELLS for diagnostic blood reagents for laboratory use, likely to cause confusion, noting that the relevant consumers would view the "CELLS" portion of CONFIRMCELLS as merely descriptive); *In re U.S. Shoe Corp.*, 229 USPQ 707, 709 (TTAB 1985) (holding CAREER IMAGE (stylized) for clothing and retail women's clothing store services, and CREST CAREER IMAGES (stylized) for uniforms, likely to cause confusion, noting that CAREER IMAGE would be perceived by consumers as a shortened form of CREST CAREER IMAGES); *In re Energy Images, Inc.*, 227 USPQ 572, 573 (TTAB 1985) (holding SMART-SCAN (stylized) for optical line recognition and digitizing processors, and SMART for telemetry systems and remote-data gathering and control systems, likely to cause confusion, noting that, because of the descriptive significance of the term "SCAN," it would be the portion of applicant's mark that consumers would least likely rely upon to distinguish applicant's goods); *In re Denisi*, 225 USPQ 624, 624 (TTAB 1985) (holding PERRY'S PIZZA and PERRY'S, both

for restaurant services, likely to cause confusion, noting that "where a newcomer has appropriated the entire mark of a registrant, and has added to it a non-distinctive term, the marks are generally considered to be confusingly similar"); *In re Riddle*, 225 USPQ 630, 632 (TTAB 1985) (holding RICHARD PETTY'S ACCU TUNE and design for automotive service stations, and ACCU-TUNE for automotive testing equipment, likely to cause confusion); *In re Collegian Sportswear, Inc.*, 224 USPQ 174, 176 (TTAB 1984) (holding COLLEGIAN OF CALIFORNIA and design (with "CALIFORNIA" disclaimed), and COLLEGIENNE, both for items of clothing, likely to cause confusion, noting that the addition of "OF CALIFORNIA" would not obviate confusion because consumers might believe that such wording denotes a new product line from the same source); *In re Pierre Fabre S.A.*, 188 USPQ 691, 692 (TTAB 1975) (holding PEDI-RELAX for foot cream with antiperspirant properties, and RELAX for antiperspirant, likely to cause confusion).

Additions or deletions to marks may be sufficient to avoid a likelihood of confusion 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., Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011) (affirming TTAB's holding that contemporaneous use of applicant's CAPITAL CITY BANK marks for banking and financial services, and opposer's CITIBANK marks for banking and financial services, would not likely cause confusion, based, in part, on findings that the phrase "City Bank" was frequently used in the banking industry and that "CAPITAL" was the dominant element of applicant's marks, which gave the marks a geographic connotation as well as a look and sound distinct from opposer's marks); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1245, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004) (reversing TTAB's holding that contemporaneous use of THE RITZ KIDS for clothing items (including gloves) and RITZ for various kitchen textiles (including barbeque mitts) was likely to cause confusion, because, *inter alia*, THE RITZ KIDS created a different commercial impression); *Safer, Inc. v. OMS Invs., Inc.*, 94 USPQ2d 1031, 1044-45 (TTAB 2010) (holding DEER-B-GON for animal repellant used to repel deer, other ruminant animals, and rabbits, and DEER AWAY and DEER AWAY PROFESSIONAL for repellant for repelling deer, other big game, and rabbits, not likely to cause confusion, noting that "DEER" was descriptive as applied to the relevant goods and thus had no source-indicating significance); *Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844, 1857-58 (TTAB 2008) (finding that, although cancellation petitioner's and respondent's marks were similar by virtue of the shared descriptive wording "SPORTSMAN'S WAREHOUSE," this similarity was outweighed by differences in terms of sound, appearance, connotation, and commercial impression created by other matter and stylization in the respective marks); *In re Farm Fresh Catfish Co.*, 231 USPQ 495, 495-96 (TTAB1986) (holding CATFISH BOBBERS (with "CATFISH" disclaimed) for fish, and BOBBER for restaurant services, not likely to cause confusion, because the word "BOBBER" has different connotation when used in connection with the respective goods and services); *In re Shawnee Milling Co.*, 225 USPQ 747, 749 (TTAB 1985) (holding GOLDEN CRUST for flour, and ADOLPH'S GOLD'N CRUST and design (with "GOLD'N CRUST" disclaimed) for coating and seasoning for food items, not likely to cause confusion, noting that, because "GOLDEN CRUST" and "GOLD'N CRUST" are highly suggestive as applied to the respective goods, the addition of "ADOLPH'S" is sufficient to distinguish the marks); *In re S.D. Fabrics, Inc.*, 223 USPQ 54, 55-56 (TTAB 1984) (holding DESIGNERS/FABRIC (stylized) for retail fabric store services, and DAN RIVER DESIGNER FABRICS and design for textile fabrics, not likely to cause confusion, noting that, because of the descriptive nature of "DESIGNERS/FABRIC" and "DESIGNER FABRICS," the addition of "DAN RIVER" is sufficient to avoid a likelihood of confusion); *see also* TMEP §1207.01(b)(viii).

1207.01(b)(iv) Similarity in Sound – Phonetic Equivalents

Similarity in sound is one factor in determining whether the marks are confusingly similar. *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 White Swan, Ltd.*, 8 USPQ2d 1534, 1535 (TTAB1988) . For purposes of the §2(d) analysis, there is no "correct"

pronunciation of a mark 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., In re Viterra Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012) (upholding the Board's affirmance of a Section 2(d) refusal to register XCEED for agricultural seed based on a likelihood of confusion with the registered mark X-SEED and design, SEED disclaimed, for identical goods); *Centraz Indus. Inc. v. Spartan Chem. Co. Inc.*, 77 USPQ2d 1698, 1701 (TTAB2006) (acknowledging that "there is no correct pronunciation of a trademark" and finding ISHINE (stylized) and ICE SHINE, both for floor finishing preparations, confusingly similar); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 n.3 (TTAB1987) ("[C]orrect pronunciation as desired by the applicant cannot be relied upon to avoid a likelihood of confusion."); *Kabushiki Kaisha Hattori Tokeiten v. Scuotto*, 228 USPQ 461 (TTAB1985) (holding SEYCOS and design for watches, and SEIKO for watches and clocks, likely to cause confusion); *In re Great Lakes Canning, Inc.*, 227 USPQ 483 (TTAB 1985) (holding CAYNA (stylized) for soft drinks, and CANA for, *inter alia*, canned and frozen fruit and vegetable juices, likely to cause confusion); *In re Energy Telecomms. & Elec. Ass'n*, 222 USPQ 350 (TTAB 1983) (holding ENTELEC and design for association services relating to telecommunications and other electrical control systems for use in the energy related industries, and INTELECT for promoting, planning, and conducting expositions and exhibitions for the electrical industry, likely to cause confusion); *In re Cresco Mfg. Co.*, 138 USPQ 401 (TTAB 1963) (holding CRESCO and design for leather jackets, and KRESSCO for hosiery, likely to cause confusion).

1207.01(b)(v) Similarity in Meaning

Similarity in meaning or connotation is another factor in determining whether the marks are confusingly similar. *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 Cynosure, Inc.*, 90 USPQ2d 1644, 1645-46 (TTAB2009) . The focus is on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (citing *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd per curiam*, 972 F.2d 1353 (Fed. Cir. 1992)); *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1353 (TTAB 2015) (citing *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1430 (TTAB 2013)); *see also San Fernando Elec. Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 2-3 (CCPA 1977) ("Obviously, the marks here are constructed of old linguistic elements, but they must be considered as wholes, and not on the basis of side-by-side comparison, and in the light of the fallibility of memory."); *Neutrogena Corp. v. Bristol-Myers Co.*, 410 F.2d 1391, 161 USPQ 687, 688 (CCPA 1969) (many consumers "may have but dim recollections from having previously seen or heard one or the other of the involved marks.").

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 & Co.*, 2 USPQ2d 1312, 1314 (TTAB1987) (holding CROSS-OVER for bras and CROSSOVER for ladies' sportswear not likely to cause confusion, noting that the term "CROSS-OVER" was suggestive of the construction of applicant's bras, whereas "CROSSOVER," as applied to registrant's goods, was "likely to be perceived by purchasers either as an entirely arbitrary designation, or as being suggestive of sportswear which "crosses over" the line between informal and more formal wear . . . or the line between two seasons"); *In re British Bulldog, Ltd.*, 224 USPQ 854, 856 (TTAB 1984) (holding PLAYERS for men's underwear and PLAYERS for shoes not likely to cause confusion, agreeing with applicant's argument that the term "PLAYERS" implies a fit, style, color, and durability suitable for 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.*, 197 USPQ 629, 630 (TTAB1977) (holding BOTTOMS UP for ladies' and children's underwear and BOTTOMS UP for men's clothing not likely to cause confusion, noting that the wording connotes the drinking phrase "Drink Up" when applied to men's clothing, but does

not have this connotation when applied to ladies' and children's underwear). *Cf. In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017) (affirming Board decision holding standard-character mark I AM likely to cause confusion with registered I AM marks and rejecting applicant's argument that restriction limiting the goods to those "associated with William Adams, professionally known as 'will.i.am,'" changed the meaning or overall commercial impression of the mark).

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., In re Thomas*, 79 USPQ2d 1021 (TTAB2006) (holding MARCHE NOIR for jewelry, and BLACK MARKET MINERALS for retail jewelry and mineral store services, likely to cause confusion); *In re Am. Safety Razor Co.*, 2 USPQ2d 1459 (TTAB1987) (holding BUENOS DIAS for soap, and GOOD MORNING and design for latherless shaving cream, likely to cause confusion); *In re Hub Distrib., Inc.*, 218 USPQ 284 (TTAB 1983) (holding EL SOL for clothing and footwear, and SUN and design for footwear, likely to cause confusion).

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 (TTAB1986) (holding LUPO for men's and boys' underwear, and WOLF and design for various clothing items, likely to cause confusion, because, *inter alia*, "LUPO" is clearly the foreign equivalent of the English word "wolf").

If an examining attorney determines that the doctrine is applicable, the examining attorney must also consider all other relevant *du Pont* factors in assessing whether there is a likelihood of confusion. *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 (TTAB1984) (noting that "similarity [of the marks] in connotation 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 (TTAB1973) .

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 into its English equivalent. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1377, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005) (reversing holding of likelihood of confusion where the marks were VEUVE ROYALE (the French equivalent of "Royal Widow") and THE WIDOW, deeming it improbable that American purchasers would stop and translate "VEUVE" into "widow"); *see In re Aquamar, Inc.*, 115 USPQ2d 1122, 1127 (TTAB 2015) (applying foreign equivalents doctrine after finding that Spanish is a common language in the U.S. and that ordinary purchasers would stop and translate mark MARAZUL into English). 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 the likelihood of confusion determination, 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 (TTAB1987); *In re Hub Distrib., Inc.*, 218 USPQ 284 (TTAB1983). 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) (noting 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" and translating the marks BIEN JOLIE and TRES JOLIE to compare their meanings, but concluding that confusion was not likely, despite their substantially similar meanings, because of, inter alia, the highly laudatory nature of the registered mark, BIEN JOLIE). 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. *Cf. Palm Bay Imps.*, 396 F.3d at 1377, 73 USPQ2d at 1692, 1696 (noting that the doctrine of foreign equivalents will not be applied when it is unlikely that an American buyer will translate a foreign mark and agreeing with TTAB's determination that purchasers were unlikely to translate applicant's French mark VEUVE ROYALE and opposer's French marks VEUVE CLICQUOT PONSARDIN and VEUVE CLICQUOT, but concluding that confusion was likely because, *inter alia*, the presence of the arbitrary term "VEUVE" as the first word in both parties' marks renders the marks similar); *Brown Shoe Co. v. Robbins*, 90 USPQ2d 1752, 1756 (TTAB2009) (determining that the relevant circumstances of the case did not warrant application of the doctrine where the parties' respective marks were the Spanish terms PALOMITA and PALOMA, but concluding that confusion was likely because, inter alia, the marks were substantially similar in appearance, pronunciation, meaning, and commercial impression).

The Board has also applied the doctrine in an inter partes case where the wording in one of the marks was in a foreign language and the wording in the other mark or marks was in a different foreign language. *SeeMiguel Torres S.A. v. Casa Vinicola Gerardo Cesari S.R.L.*, 49 USPQ2d 2018 (TTAB1998) (applying the doctrine and concluding that confusion was likely where the applicant's mark featured the Italian wording DUE TORRI, meaning "two towers," and the opposer's marks featured the Spanish wording TORRES and TRES TORRES, meaning "towers" and "three towers" respectively), *vacated and remanded on other grounds*, 230 F.3d 1372 (Fed. Cir. 1999) (unpublished table decision). However, the Board has stated that, in general, it does not apply the doctrine where both marks are non-English words from two different foreign languages. *Brown Shoe Co.*, 90 USPQ2d at 1756; *see also Safeway Stores, Inc. v. Bel Canto Fancy Foods, Ltd.*, 5 USPQ2d 1980, 1982 (TTAB1987) ("[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 to determine whether there is similarity as to connotation . . . ."). One reason for not applying the doctrine where the marks are in different foreign languages is that it is less likely that the ordinary American purchaser would be fluent in two or more foreign languages. In *Miguel Torres*, the Board noted that the relevant marks were of such a nature that it was unnecessary for those encountering the relevant marks to be fluent in both Spanish and Italian to understand the connotations of the marks, because, for instance, a purchaser who is fluent in Spanish and familiar with meaning of the mark TORRES may be able to discern the meaning of a mark containing the Italian wording DUE TORRI and a design of two towers. 49 USPQ2d at 2021. In any case, 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 are also similar in other respects.

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 would 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 combined foreign and English 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 §§809.01-809.03 for information regarding how to ascertain the meaning of non-English wording in a mark and when a translation is required.

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 Federal Circuit has stated that "[t]he test to be applied to a foreign word vis-a-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).

Thus, the English translation evidence is a critical factor for the Board and the courts 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. *SeeIn re Aquamar, Inc.*, 115 USPQ2d 1122, 1126-28 (TTAB2015) (holding MARAZUL for fish and seafood, and BLUE SEA for fish, likely to cause confusion, after finding that the record evidence established that "mar azul" means "blue sea"); *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1648-50 (TTAB2008) (holding LA PEREGRINA for jewelry, pearls, pearl jewelry, and precious stones, and PILGRIM for jewelry, likely to cause confusion, where dictionary evidence showed that "pilgrim" is an exact translation of "peregrina" and there was no other dictionary evidence to the contrary); *In re Thomas*, 79 USPQ2d 1021, 1024-25 (TTAB2006) (holding MARCHE NOIR for jewelry, and BLACK MARKET MINERALS for retail jewelry and mineral store services, likely to cause confusion, where the evidence showed "MARCHE NOIR" is the exact French equivalent of the English idiom "Black Market"); *In re Ithaca Indus., Inc.*, 230 USPQ 702, 704 (TTAB1986) (holding LUPO for men's and boys' underwear, and WOLF and design for various clothing items, likely to cause confusion, where there was no dispute that "LUPO" is the Italian equivalent of "wolf"); *In re Hub Distrib., Inc.*, 218 USPQ 284, 284-85 (TTAB1983) (holding EL SOL for clothing, and SUN and design for footwear, likely to cause confusion, where "EL SOL" was determined to be the "direct foreign language

equivalent" of the term "sun"); *see also Ex parte Odol-Werke Wien GmbH.*, 111 USPQ 286, 286 (Comm'r Pats. 1956) (finding the French language mark CHAT NOIR and its English language equivalent BLACK CAT confusingly similar because "'CHAT NOIR' undoubtedly means, and is the same as, 'Black Cat' to a substantial segment" of the relevant purchasers).

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, e.g., In re Perez*, 21 USPQ2d 1075, 1076-77 (TTAB 1991) (holding EL GALLO for fresh vegetables, and ROOSTER for fresh citrus fruit, likely to cause confusion, rejecting applicant's argument that purchasers would ascribe other meanings to "gallo," where "rooster" was the first English translation listed in a Spanish-English language dictionary entry for "gallo," where "gallo" was the only listed Spanish translation in a dictionary entry for "rooster," and where the design of a rooster on the specimen reinforced the translation of "GALLO").

Where the evidence shows that the English translation is not exact, literal, or direct, the doctrine of foreign equivalents has generally not been applied to find the marks confusingly similar. *See Sarkli*, 721 F.2d at 354-55, 220 USPQ at 112-13 (holding REPECHAGE for various skin-care products, and SECOND CHANCE for face creams and other toiletries, not likely to cause confusion, where the evidence failed to show that the terms were direct foreign equivalents); *see alsoIn re Buckner Enters.*, 6 USPQ2d 1316, 1316-17 (TTAB1987) (holding DOVE (with design) for stoves and furnaces, and PALOMA for various forms of gas heating apparatus, not likely to cause confusion, because, *inter alia*, the Spanish word "paloma" and the English word "dove" were not exact synonyms in that "paloma" could be translated to either "dove" or "pigeon"). 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.

Common, Modern Foreign Languages

The doctrine applies to words or terms from common, modern languages, which encompasses all but dead, obscure, or unusual languages. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1377, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005). Thus, 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 showing that, after English, Spanish is the most commonly spoken language in the United States, and that over 12% of the United States population speaks Spanish, supports established case law showing the Board has routinely applied the doctrine of foreign equivalents to Spanish-language marks. *Ricardo Media Inc. v. Inventive Software, LLC*, 2019 USPQ2d 311355, at *7 (TTAB 2019); *see, e.g., In re Aquamar, Inc.*, 115 USPQ2d 1122, 1127 (TTAB 2015); *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1648 (TTAB 2008).
- Census evidence provided by applicant, showing that only 0.6% of the American population speak French "very well" or "well," was used by the Board against the applicant to find that French is a commonly spoken language and 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 **https://data.census.gov/table?q=B16001&tid=ACSDT5Y2020.B16001**.

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 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 may be obtained from the USPTO's Translations Branch, as well as the Internet, LexisNexis®, and any other relevant electronic or print resources.

If evidence shows that the language at issue is highly obscure or a dead language, the doctrine will generally not be applied. *See Palm Bay Imps.*, 396 F.3d at 1377, 73 USPQ2d at 1696; *cf. In re Spirits Int'l, N.V.*, 563 F.3d 1347, 1351, 90 USPQ2d 1489, 1491 (Fed. Cir. 2009) (indicating that the doctrine of foreign equivalents did not require that terms from dead or obscure languages be literally translated for the purpose of determining descriptiveness). The determination of whether a language is "dead" is 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 may 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/or
(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 In re Jos. Schlitz Brewing Co.*, 223 USPQ 45, 45-46 (TTAB 1983) (considering whether purchasers would be likely to translate the mark "KUHLBRAU" into its merely descriptive English equivalent, "cool brew"). In making such determinations, the Board generally reviews evidence such 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 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"); *cf. 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 applicant's ownership of a prior registration for "BLUE RIBBON" did not preclude opposer from asserting damage resulting from applicant's registration of the mark CORDON BLEU, (which literally translated to "blue ribbon") because CORDON

BLEU would not be translated by, or have the same significance to, an American purchaser in view of the adoption by the English language of the wording CORDON BLEU, as evidenced by American English dictionary entries indicating that such wording refers to a highly skilled cook).

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; *see also Thomas*, 79 USPQ2d at 1026 (finding "MARCHE NOIR" confusingly similar to "BLACK MARKET MINERALS," but suggesting that a different conclusion might have been reached if the marketplace circumstances or commercial setting in which the mark was used were such that it would be unlikely for purchasers to translate "MARCHE NOIR"); *In re Tia Maria, Inc.*, 188 USPQ 524, 525-26 (TTAB 1975) (holding TIA MARIA (which translates to "Aunt Mary") for restaurant services, and AUNT MARY'S for canned fruits and vegetables, not likely to cause confusion, because, inter alia, a person dining at the TIA MARIA restaurant surrounded by its Mexican décor and Mexican food, would be likely to accept "TIA MARIA" as it was and not translate it into "AUNT MARY").

Additionally, the doctrine typically will not be applied to personal names that would be recognizable as first names to ordinary American consumers and thus perceived as identifying a person. *Ricardo Media*, 2019 USPQ2d 311355, at *7-9 (record did not support a finding that "consumers would be likely to translate RICARDO to RICHARD, or RICHARD to RICARDO, but would instead take each name as it is, in its own language, as identifying the person named, whether real or fictional, known or anonymous." *Id.* at *8; *In re Tia Maria, Inc.*, 188 USPQ at 525-26.

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 foreign wording comprising a mark 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. However, applying the doctrine is only part of the process of determining whether the marks being compared are confusingly similar. Appearance, sound, meaning, and overall commercial impression are also factors to be considered when comparing marks. *See Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1371, 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); *In re Ness & Co.*, 18 USPQ2d 1815, 1816 (TTAB1991) ("'[S]uch similarity as there is in connotation [between the foreign word mark and the English word mark] must be weighed against the dissimilarity in appearance, sound, and all other factors, before reaching a conclusion on likelihood of confusion as to source.'" (quoting *In re Sarkli, Ltd.*, 721 F.2d 353, 354, 220 USPQ 111, 113 (Fed. Cir. 1983))).

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. *See In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB1988) ; 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 Ness & Co.*, 18 USPQ2d at 1816 (holding GOOD-NESS for cheese and meats, and LABONTE (which translates to "the goodness") for cheese, not likely cause confusion, because of the laudatory nature of the term "goodness," the dissimilarity of the marks in appearance and sound, the slight differences in meaning of the marks, and

the connotation of the mark GOOD-NESS in relation to applicant's company name "Ness & Co."); *In re L'Oreal S.A.*, 222 USPQ 925, 925-26 (TTAB1984) (considering the English translation of the French mark HAUTE MODE (meaning "high fashion" in English), but concluding that contemporaneous use with the HI-FASHION SAMPLER was not likely to cause confusion, because of, *inter alia*, the "less than wholly arbitrary nature of the marks" and the differences in the marks, including the addition of the term SAMPLER in the English-language mark).

If both marks being compared are in a foreign language and have the same or a very similar meaning when translated, 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, they may be found to be confusingly similar. *See Miguel Torres S.A v. Casa Vinicola Gerardo Cesari S.R.L.*, 49 USPQ2d 2018 (applying the doctrine and concluding that confusion was likely where the applicant's mark featured the Italian wording DUE TORRI, meaning "two towers," and opposer's marks featured the Spanish wording TORRES and TRES TORRES, meaning "towers" and "three towers" respectively, because the marks were similar not only in connotation but also in sound), vacated and remanded on other grounds, 230 F.3d 1372 (Fed. Cir. 1999) (unpublished table decision); *In re Lar Mor Int'l, Inc.*, 221 USPQ 180 (translating the marks BIEN JOLIE and TRES JOLIE to compare their meanings, but concluding that confusion was not likely, despite the marks' substantially similar meanings, because of, *inter alia*, the highly laudatory nature of the wording "JOLIE," and the "obvious visual and phonetic differences" between the marks).

In addition, when comparing only foreign language marks, even if it is determined that the marks are not likely to be translated by purchasers, the marks may still be found confusingly similar for other reasons, such as similarity in sound and/or appearance. *See Palm Bay Imps.*, 396 F.3d at 1372-73, 1377, 73 USPQ2d at 1691, 1696 (agreeing with Board's finding that purchasers would not translate into English applicant's French mark VEUVE ROYALE and opposer's French marks VEUVE CLICQUOT PONSARDIN and VEUVE CLICQUOT, and upholding the Board's determination that confusion was nonetheless likely as to these marks, because, *inter alia*, "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 . . . significance of the word ROYALE").

See also TMEP §§1209.03(g), 1210.05(b), 1210.10, and 1211.01(a)(vii) for additional information 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 Soc'y of Am. Inc.*, 12 USPQ2d 1139, 1142 (TTAB1989) (holding THE WINE SOCIETY OF AMERICA and design for wine club membership services including the supplying of printed materials, and AMERICAN WINE SOCIETY 1967 and design for newsletters, bulletins, and journals, likely to cause confusion); *In re Nationwide Indus., Inc.*, 6 USPQ2d 1882, 1884 (TTAB1988) (holding RUST BUSTER (with "RUST" disclaimed) for rust-penetrating spray lubricant, and BUST RUST for penetrating oil, likely to cause confusion); *In re Gen. Tire & Rubber Co.*, 213 USPQ 870, 871 (TTAB 1982) (holding SPRINT STEEL RADIAL (with "STEEL" and "RADIAL" disclaimed) for pneumatic tires, and RADIAL SPRINT (with "RADIAL" disclaimed) for radial tires, likely to cause confusion).

However, if the transposed mark creates a distinctly different commercial impression, then confusion is not likely. *See, e.g., In re Best Prods. Co.*, 231 USPQ 988, 989-90 (TTAB1986) (holding BEST JEWELRY

and design (with "JEWELRY" disclaimed) for retail jewelry store services, and JEWELERS' BEST for bracelets, not likely to cause confusion).

1207.01(b)(viii) Marks Consisting of Multiple Words

When assessing the likelihood of confusion between compound word marks, although each mark must be considered as a whole, it is appropriate to consider whether a portion of the mark is dominant in creating the mark's commercial impression. As the Court of Appeals for the Federal Circuit has when articulating reasons for reaching a conclusion on the issue of confusion, "there is nothing improper in stating that. . . 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." *Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 1322, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014) (quoting *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985)); *In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, at *4 (TTAB 2020); *see also In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018).

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. *See, e.g., In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (affirming TTAB's finding that "DELTA," not the disclaimed generic term "CAFE," is the dominant portion of the mark THE DELTA CAFE); *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009) (finding that "BINION'S," not the disclaimed descriptive wording "ROADHOUSE," is the dominant portion of the mark BINION'S ROADHOUSE). Accordingly, if two marks for related goods or services share identical or similar dominant features and the marks, when viewed in their entireties, create similar overall commercial impressions, then confusion is likely. *See, e.g., In re Cynosure, Inc.*, 90 USPQ2d 1644, 1646 (TTAB 2009) (holding CYNERGY for medical lasers for, *inter alia*, treatment of the face and skin, and SYNERGIE PEEL for medical devices for microdermabrasion, likely to cause confusion, noting that "SYNERGIE" is the dominant portion of the cited mark and "PEEL" is insufficient to distinguish the marks); *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB1987) (holding JM ORIGINALS (with "ORIGINALS" disclaimed) for various items of apparel, and JM COLLECTABLES for sport shirts, likely to cause confusion).

If the common element of two marks is "weak" in that it is generic, descriptive, or highly suggestive of the named goods or services, it is unlikely that consumers will be confused unless the overall combinations have other commonality. *See, e.g., Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338-40, 115 USPQ2d 1671, 1674-75 (Fed. Cir. 2015) (remanded for consideration of whether and to what degree the phrase PEACE & LOVE was suggestive or descriptive in the food-service industry); *In re Bed & Breakfast Registry*, 791 F.2d 157, 159, 229 USPQ 818, 819 (Fed. Cir. 1986) (reversing TTAB's holding that contemporaneous use of BED & BREAKFAST REGISTRY for making lodging reservations for others in private homes, and BED & BREAKFAST INTERNATIONAL for room booking agency services, is likely to cause confusion, because, inter alia, the descriptive nature of the shared wording weighed against a finding that the marks are confusingly similar); *In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1675 (TTAB 2018) (holding I'M SMOKING HOT for cosmetics and related non-medical personal care items and SMOKIN' HOT SHOW TIME for cosmetics not likely to cause confusion based on a totality of the evidence showing that the shared wording is somewhat weak in view of its suggestiveness and that the marks overall convey different commercial impressions); *U.S. Shoe Corp. v. Chapman*, 229 USPQ 74, 75 (TTAB1985) (holding COBBLER'S OUTLET for shoes, and CALIFORNIA COBBLERS (in typed and stylized forms) for footwear and women's shoes, not likely to cause confusion); *In re Istituto Sieroterapico E Vaccinogeno, Toscano "SCLAVO" S.p.A.*, 226 USPQ 1035, 1037 (TTAB1985) (holding ASO QUANTUM (stylized, with "ASO"

disclaimed) for diagnostic laboratory reagents, and QUANTUM I for laboratory instruments for analyzing body fluids, not likely to cause confusion); *see also*TMEP §§1207.01(b)(iii), (b)(ix).

However, while the public may rely more on the nondescriptive portions of marks to distinguish them, "this does not mean that the public looks only at the differences [between the marks], or that descriptive words play no role in creating confusion." *In re Nat'l Data Corp.*, F.2d at 1060, 224 USPQ at 752; *see also In re Detroit Athletic Co.*, 903 F.3d at 1305, 128 USPQ2d at 1050 (affirming the Board's holding that the marks DETROIT ATHLETIC CO. and DETROIT ATHLETIC CLUB are similar, noting that "the Board proffered rational reasons why th[e] words ['Co.' and 'Club'], as mere business identifiers, do not sufficiently distinguish the marks").

1207.01(b)(ix) Weak or Descriptive Marks

The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that merely descriptive and weak designations may be entitled to a narrower scope of protection than an entirely arbitrary or coined word. *See, e.g., Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1373, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (citing *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338-39, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en* 1772, 396 F.3d 1369, 1373, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005)); *Shenzhen IVPS Tech. Co. v. Fancy Pants Prods., LLC*, 2022 USPQ2d 1035, at *40-41, *51-52 (TTAB 2022); *Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1026 (TTAB2009) ; *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1957-58 (TTAB 2006); *In re Cent. Soya Co.*, 220 USPQ 914, 916 (TTAB1984). However, even a weak mark is entitled to protection against the registration of a similar mark for closely related goods or services. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 1401 182 USPQ 108, 109 (C.C.P.A.1974); *In re Max Cap. Grp. Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010) (quoting *In re Chica, Inc.*, 84 USPQ2d 1845, 1850 (TTAB 2007)).

With respect to marks registered on the Supplemental Register, the Board stated the following in *In re Hunke and Jochheim*:

> [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. 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.

185 USPQ 188, 189 (TTAB 1975) (citation omitted).

However, even marks that are registered on the Supplemental Register may be cited under §2(d)of the Trademark Act. *In re Clorox Co.*, 578 F.2d 305, 308-09, 198 USPQ 337, 341 (C.C.P.A. 1978); *In re Medline Indus., Inc.*, 2020 USPQ2d 10237, at *3 (TTAB 2020) (quoting *Otter Prods. LLC v. BaseOneLabs LLC*, 105 USPQ2d 1252, 1254 (TTAB 2012)).

1207.01(b)(x) Parody Marks

The fact that a mark is intended to be a parody of another trademark is not, by itself, sufficient to overcome a likelihood of confusion refusal, because "[t]here are confusing parodies and non-confusing parodies." J.

Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §31.153 (4th ed. 2010); *see alsoNike, Inc. v. Maher*, 100 USPQ2d 1018, 1023 (TTAB2011) ("[P]arody is not a defense if the marks would otherwise be considered confusingly similar."). "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." *Mutual of Omaha Ins. Co. v. Novak*, 648 F. Supp. 905, 910, 231 USPQ 963, 965 (D. Neb. 1986), aff'd, 836 F.2d 397, 5 USPQ2d 1314 (8th Cir. 1987). Thus, "[w]hile a parody must call to mind the actual product to be successful, the same success also necessarily distinguishes the parody from the actual product." *Id.*

Cases involving a discussion of parody include the following: *Research in Motion Ltd. v. Defining Presence Mktg. Grp., Inc.*, 102 USPQ2d 1187, 1192 (TTAB2012) (sustaining oppositions to applications for the mark CRACKBERRY, for a variety of online computer services and clothing items, on the bases of a likelihood of confusion and likelihood of dilution by blurring with the mark BLACKBERRY, for handheld devices, including smartphones, and related goods and services, noting that "likelihood of confusion will usually trump any First Amendment concerns"); *Starbucks U.S. Brands, LLC v. Ruben*, 78 USPQ2d 1741 (TTAB2006) (holding contemporaneous use of applicant's mark, LESSBUCKS COFFEE, and opposer's marks, STARBUCKS and STARBUCKS COFFEE, for identical goods and services, likely to cause confusion, noting that "parody is unavailing to applicant as an outright defense and, further, does not serve to distinguish the marks"); *Columbia Pictures Indus. Inc. v. Miller*, 211 USPQ 816, 820 (TTAB1981) (holding CLOTHES ENCOUNTERS for clothing, and CLOSE ENCOUNTERS OF THE THIRD KIND for t-shirts, likely to cause confusion, noting that the "right of the public to use words in the English language in a humorous and parodic manner does not extend to use of such words as trademarks if such use conflicts with the prior use and/or registration of the substantially same mark by another"); *see also Jordache Enters. v. Hogg Wyld Ltd.*, 828 F.2d 1482, 4 USPQ2d 1216, 1220, 1222 (10th Cir. 1987) (noting that "a parody of an existing trademark can cause a likelihood of confusion," but affirming district court's holding that contemporaneous use of LARDASHE and JORDACHE, both for jeans, is not likely to cause confusion).

1207.01(b)(xi) Color Marks

When the marks at issue are both color marks, "the similarity of the marks must be decided primarily on the basis of visual similarity." *In re Cook Med. Tech. LLC*, 105 USPQ2d 1377, 1381 (TTAB 2012) (citing *Gen. Foods Corp. v. Ito Yokado Co.*, 219 USPQ 822, 828 (TTAB 1983)). However, "'the test is not whether the marks can be distinguished when subjected to a side-by-side comparison,' but 'rather whether the marks are sufficiently similar in terms of their appearance and overall commercial impression so that confusion as to the source of the goods [or services] offered under the respective marks is likely to result.'" *In re Medline Indus., Inc.*, 2020 USPQ2d 10237, at *7-8 (TTAB 2020) (quoting *In re Cook Med. Tech. LLC*, 105 USPQ2d at 1381.

In *In re Cook Medical Technologies*, the Board affirmed a refusal to register the color "teal" for "medical devices, namely, guiding sheaths for use in conjunction with access needles, wire guides, and dilators for providing access for diagnostic and interventional devices in vascular and non-vascular procedures," holding the mark likely to cause confusion with a registered mark for the color "blue" applied to the tip and indwelling length of catheters. 105 USPQ2d at 1385. Because the registrant's "blue" mark was not limited to a particular shade of blue, it covered all shades of blue, including the applicant's "teal." *Id.*, 105 USPQ2d at 1382. Further, the Board found that, in the context of the goods at issue, the marks were similar in color, noting that the original description of the applicant's mark identified it as the color "blue/teal," and that the goods were complementary. *Id.*, at 1380, 1382-83. However, in *In re Medline Industries*, the Board reversed a Section 2(d) refusal to register a pale shade of green (Pantone 2274C) for "medical examination gloves" with a registration for a bright shade of green (Pantone 7488U) for "gloves for medical use," because the mark descriptions identified specific shades of green instead of all shades of green and significant third-party

evidence corroborated the weakness of the registered mark, such that the difference in shades was "significant enough to make confusion unlikely even though the involved shades of green [were] used on identical goods sold through identical channels of trade to identical customers"). 2020 USPQ2d 10237, at *1, *5-6, *13.

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. *E.g.*, *In re ATV Network Ltd.*, 552 F.2d 925, 927 (C.C.P.A. 1977) *; In re Vienna Sausage Mfg. Co.*, 16 USPQ2d 2044, 2047 (TTAB 1990). In this situation, consideration must be given to the fact that the marks usually will not be viewed side-by-side in the marketplace and a purchaser's recollection of design marks is often of a general, rather than specific, nature; thus the marks may be confusingly similar despite differences between them. *See*, *e.g.*, *Grandpa Pidgeon's of Mo., Inc. v. Borgsmiller*, 477 F.2d 586, 587 (C.C.P.A. 1973) ("Legal surgery, in which trademarks have parts enhanced or discarded, is of little aid in determining the effect of design marks on purchasers who merely recollect"); *In re United Serv. Distribs., Inc.*, 229 USPQ 237 (TTAB 1986) (holding mark consisting of a design featuring silhouettes of a man and woman, used in connection with distributorship services in the field of health and beauty aids, and mark consisting of a design featuring silhouettes of a man and woman, used in connection with skin cream, likely to cause confusion); *In re Steury Corp.*, 189 USPQ 353 (TTAB1975) (holding mark consisting of three generally horizontal bars, for, *inter alia*, boats, campers, and travel trailers, and mark consisting of two generally horizontal bars, for, inter alia, boats, campers, and travel trailers, likely to cause confusion); *Matsushita Elec. Indus. Co. v. Sanders Assocs., Inc.*, 177 USPQ 720 (TTAB1973) (holding mark consisting of a triangular arrow design within a square border, for various items of electrical and electronic equipment, and mark consisting of a triangular arrow design, for various items of electrical and electronic equipment, likely to cause confusion); *cf. Red Carpet Corp. v. Johnstown Am. Enters.*, 7 USPQ2d 1404 (TTAB 1988) (holding mark consisting of a highly stylized house design for use in connection with real estate property management, and mark consisting of a highly stylized house design for use in connection with real estate brokerage services, not likely to cause confusion); *Ocean Spray Cranberries, Inc. v. Ocean Garden Prods., Inc.*, 223 USPQ 1027 (TTAB1984) (holding mark consisting of a circle containing three curved lines with rounded ends, for seafood, and mark consisting of a stylized breaking wave within an oval, for various food items including juices and fruits, not likely to cause confusion).

1207.01(c)(i) Legal Equivalents – Comparison of Words and Their Equivalent Designs

Under the doctrine of legal equivalents, which is based on a recognition that a pictorial depiction and equivalent wording are likely to impress the same mental image on purchasers, a design mark may be found to be confusingly similar to a word mark consisting of the design's literal equivalent. *See, e.g., In re Rolf Nilsson AB*, 230 USPQ 141 (TTAB1986) (holding applicant's mark consisting of a silhouette of a lion's head and the letter "L," for shoes, and registrant's mark, LION, for shoes, likely to cause confusion); *Puma-Sportschuhfabriken Rudolf Dassler KG v. Garan, Inc.*, 224 USPQ 1064 (TTAB1984) (holding applicant's marks featuring a design of a mountain lion, for clothing items, and opposer's marks, a puma design and PUMA (with and without puma design), for items of clothing and sporting goods, likely to cause confusion); *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974) (holding mark consisting of a design of an eagle lined for the color gold, for sports apparel, and mark consisting of GOLDEN EAGLE and design of an eagle, for various items of clothing, likely to cause confusion).

Where, however, a pictorial representation in a mark is so highly stylized or abstract that it would not readily evoke in the purchaser's mind the wording featured in another mark, the marks may not be confusingly similar. *See, e.g., In re Serac, Inc.*, 218 USPQ 340, 341 (TTAB1983) (concluding that applicant's design mark was "so highly stylized that an image of a ram's head would not be immediately discerned and the

connection with [the registered mark] 'RAM's HEAD' would not be readily evoked with the resulting generation of a likelihood of source confusion").

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 combined with 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. *See, e.g., In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018); *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1357, 56 USPQ2d 1351, 1354 (Fed. Cir. 2000); *In re Nat'l Data Corp.*, 753 F. 2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985); *see also*TMEP §1207.01(b)(iii). However, the fundamental rule in this situation is that the marks must still be considered in their entireties. *See Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1371, 116 USPQ2d 1129, 1134 (Fed. Cir. 2015); *In re Shell Oil Co.*, 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993).

If a mark comprises both wording and a design, greater weight is often given to the wording, because it is the wording that purchasers would use to refer to or request the goods or services. *See, e.g., Viterra*, 671 F.3d at 1366, 101 USPQ2d at 1911; *Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *41-42 (TTAB 2022) (quoting *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *31 (TTAB 2021)); *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB 2018); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1247 (TTAB2010) ; *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB1987) ; *see also Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1571, 218 USPQ 390, 395 (Fed. Cir. 1983). 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 Labs. Inc.*, 913 F.2d 930, 932, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990).

The comparison of composite marks must be done on a case-by-case basis, without reliance on mechanical rules of construction. *See, e.g., Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA*, 797 F.3d at 1371-72, 116 USPQ2d at 1134-35 (finding the Board lacked substantial evidence for minimizing the literal element in the composite mark); *Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 1295, 184 USPQ 35, 37 (C.C.P.A.1974) (reversing the Board's holding that confusion was not likely between SPICE TREE with tree design, for garlic powder and minced onion, and SPICE ISLANDS with and without tree design, for seasoning herbs and spices); *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *1-3, *31 (holding confusion likely between ROYAL MIRAGE with crown and carrier design for cosmetics, including perfume and cologne, and MIRAGE BRANDS and M MIRAGE BRANDS with design (both with BRANDS disclaimed) for perfumes and colognes); *In re Info. Builders Inc.*, 2020 USPQ2d 10444, at *7 (TTAB 2020) (holding confusion likely between INFORMATION BUILDERS where the first "o" in "information" appeared as a plain circle broken in the upper right and lower left with three parallel bars within the "o", and a similar "o" design with no wording, both used for related software and IT services);*In re Covalinski*, 113 USPQ2d 1166 (TTAB2014) (holding confusion not likely between REDNECK RACEGIRL and design of large, double-letter RR configuration and registered mark RACEGIRL, even when used on in-part identical goods); *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1284 (TTAB2009) (holding confusion not likely betwee VOLTA for vodka infused with caffeine, and TERZA VOLTA and vine shoot design for wines); *In re Sun Supermarkets, Inc.*, 228 USPQ 693, 694 (TTAB1986) (holding confusion likely between SUN SUPERMARKETS with sun design, for retail supermarket services, and SUNSHINE and SUNRISE (both with sun designs), 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 of the mark. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 950, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000); *Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *42 (TTAB 2022); *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1186 (TTAB 2018); *In re Cox Enters.*, 82 USPQ2d 1040, 1044 (TTAB2007). 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. *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1284 (TTAB2009) . A registrant is entitled to all depictions of a standard character mark regardless of the font style, size, or color, and not merely "reasonable manners" of depicting such mark. *See In re Viterra Inc.*, 671 F.3d 1358, 1364-65, 101 USPQ2d 1905, 1910 (Fed. Cir. 2012); *Citigroup Inc. v. Cap. City Bank Grp., Inc.*, 637 F.3d 1344, 1353, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011); *In re Aquitaine Wine USA, LLC*, 126 USPQ2d at 1187 ("We hold that when we are comparing a standard character mark to a word + design mark for Section 2(d) purposes, we will consider variations of the depictions of the standard character mark only with regard to 'font style, size, or color' of the 'words, letters, numbers, or any combination thereof.'"). 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 Sys., LLC*, 88 USPQ2d 1445, 1448 (TTAB2008) ; *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB1991) ; *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2015 (TTAB1988) . Likewise, the fact that an applied-for mark is presented in standard character form would not, by itself, be sufficient to distinguish it from a similar mark in special form. *See, e.g., In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); *Sunnen Prods. Co. v. Sunex Int'l, Inc.*, 1 USPQ2d 1744, 1747 (TTAB1987) ; *In re Hester Indus., Inc.*, 231 USPQ 881, 882 n.6 (TTAB1986).

See TMEP §§807.03-807.04(b) regarding standard character and special form drawings.

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. *See In re Homeland Vinyl Prods., Inc.*, 81 USPQ2d 1378, 1382 (TTAB2006) .

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. *See In re Shell Oil Co.*, 992 F.2d 1204, 1209, 26 USPQ2d 1687, 1691 (Fed. Cir. 1993); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988); *In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1372 (TTAB2009) ; *see alsoIn re C.H. Hanson Co.*, 116 USPQ2d 1351 (TTAB2015) (noting that to the extent that the punctuation in registrant's identification of goods created ambiguity as to the scope of the identification, any doubt must be resolved in favor of the registrant).

1207.01(d)(ii) Absence of Actual Confusion

It is well settled that the relevant test is likelihood of confusion, not actual confusion; thus, it is unnecessary to show actual confusion to establish likelihood of confusion. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1309, 128 USPQ2d 1047, 1053 (Fed. Cir. 2018); *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1372, 17 USPQ2d 1797, 1800 (Fed. Cir. 2018); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002); *Weiss Assocs. Inc. v. HRL Assocs. Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990); *Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *58-59 (TTAB 2022); *In re Big Pig, Inc.*, 81 USPQ2d 1436, 1439-40 (TTAB2006).

1207.01(d)(iii) Third-Party Registrations and Evidence of Third-Party Use

Third-party registrations used to show relatedness. Third-party registrations that cover the goods or services of the applicant and registrant may 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. *See Hewlett-Packard Co. v. Packard Press, Inc.*, 28h1 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (evidence that "a single company sells the goods and services of both parties, if presented, is relevant to the relatedness analysis"); *Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *45-46 (TTAB 2022) (quoting *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1432 (TTAB 2013)); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB), *aff'd per curiam*, 864 F.2d 149 (Fed. Cir. 1988). Third-party registrations that are not based on use in commerce, such as those registered under §66(a) of the Trademark Act (15 U.S.C. §1141f(a)), or those registered solely under §44 of the Act (15 U.S.C. §1126(e)), and for which no §8 or §71 affidavits or declarations of continuing use have been filed (15 U.S.C §§1058, 1141k), have very little, if any, persuasive value. *See Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *25-26; *In re Info. Builders Inc.*, 2020 USPQ2d 10444, at *6 n.19 (TTAB 2020) (citing (citing *Calypso Tech., Inc. v. Calypso Cap. Mgmt., LP*, 100 USPQ2d 1213, 1221 n.15 (TTAB 2011), *appeal dismissed*, No. 20-1979 (Fed. Cir. Oct. 20, 2020); *In re Princeton Tectronics, Inc.*, 95 USPQ2d 1509, 1511 (TTAB 2010)); *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993).

Third-party registrations used to show inherent or conceptual weakness of a term or mark component. 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. *E.g., In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017); *In re Max Cap. Grp. Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1272 (TTAB 2009). However, a large number of active third-party registrations including the same or similar term or mark component for the same or similar goods or services may be given some weight to show, in the same way that dictionaries are used, that a mark or a portion of a mark has a normally understood descriptive or suggestive connotation, leading to the conclusion that the term or mark component is relatively weak. *See, e.g., Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1339, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917, 189 USPQ 693, 694-95 (C.C.P.A. 1976); *Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *24; *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1059 (TTAB 2017); *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1036 (TTAB 2016); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1471 (TTAB 2014); *In re Hartz Hotel Servs., Inc.*, 102 USPQ2d 1150, 1153-54 (TTAB 2012); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991). However, cancelled or expired third-party registrations for similar marks are not probative evidence of a mark's descriptiveness, suggestiveness, or strength. *See New Era Cap Co. v. Pro Era, LLC*,

2020 USPQ2d 10596, at *13 (TTAB 2020) (citing *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1745 (TTAB 2018), *aff'd per curiam*, 777 F. App'x 516, 2019 BL 343921 (Fed. Cir. 2019)); *In re Info. Builders Inc.*, 2020 USPQ2d 10444, at *6 n.19 (citing *Bond v. Taylor*, 119 USPQ2d 1049, 1054 n.10 (TTAB 2016), *appeal dismissed*, No. 20-1979 (Fed. Cir. Oct. 20, 2020); *In re Kysela Pere et Fils Ltd.*, 98 USPQ2d 1261, 1264 (TTAB 2011)).

Third-party use to show commercial weakness. 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). Evidence of third-party use may bear on the commercial strength or weakness of a mark. *Juice Generation*, 794 F.3d at 1338-39, 115 USPQ2d at 1674. Significant evidence of third-party use of similar marks on similar goods or services can show that consumers have become conditioned by encountering so many similar marks that they distinguish between them based on minute distinctions. *Id.*; *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005). If the applicant's evidence is properly submitted and establishes ubiquitous or considerable third-party use of the same or similar marks on the same or similar goods or services, it may be "relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection." *Palm Bay Imps.*, 396 F.3d at 1373-74, 73 USPQ2d at 1693; *see Jack Wolfskin*, 797 F.3d at 1373-74, 116 USPQ2d at 1136-37, 1136 (finding evidence of ubiquitous use of a paw print design on clothing rendered that component of the opposer's mark relatively weak for clothing); *Juice Generation*, 794 F.3d at 1337 n.1, 1341-42, 115 USPQ2d at 1673 n.1, 1676-77 (finding evidence of a considerable number of third-party uses of the component "peace and love" in connection with restaurant services or food products relevant to assessing the opposer's mark's strength or weakness without the need for specifics as to the extent or impact of use); *In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1674-75 (TTAB 2018) (finding the component term SMOKING HOT in the marks I'M SMOKING HOT and SMOKIN' HOT SHOW TIME to be "somewhat weak" based in part on evidence of third-party use of the term on similar cosmetics goods, noting that such uses "tend to show consumer exposure to third-party use of the term on similar goods"); *see also Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, at 1034-36 (finding weakness based on at least eighty-five actual uses of ROSE-formative marks for similar services and eight similar third-party registrations); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1565-66 (TTAB 1996) (holding no likelihood of confusion due to differences in the marks and finding "Broadway" weak for restaurant services based on evidence that hundreds of restaurants and eating establishments used Broadway as a trademark or trade name); *cf. In re i.am.symbolic, llc*, 866 F.3d at 1329, 123 USPQ2d at 1751 ("Symbolic's evidence of third-party use of I AM for the same or similar goods falls short of the 'ubiquitous' or 'considerable' use of the mark components present in its cited cases.").

Limitations regarding probative value of third-party registration or use evidence to show weakness of mark in cited registration. The potential relevance of third-party registrations and uses offered to support registrability over the cited registration depends on the relationship they bear to the application and registration at issue. The third-party marks must generally be as similar to the registered mark as the applied-for mark. *See, e.g., Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 675, 223 USPQ 1281, 1284-85 (Fed. Cir. 1984) ("Applicant introduced evidence of eight third-party registrations for tea which contain the word 'SPICE', five of which are shown to be in use. None of these marks has a 'SPICE (place)' format or conveys a commercial impression similar to that projected by the SPICE ISLANDS mark, and these third-party registrations are of significantly greater difference from SPICE VALLEY and SPICE ISLANDS than either of these two marks from each other."); *see also In re Mighty Leaf Tea*, 601 F.3d 1342, 1347, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010). Potential relevance also depends on whether the third-party registered marks and uses are for goods or services as similar to those in the cited registration as those identified in the application. *See, e.g., Nat'l Cable Tel. Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1580, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991) ("None of the third party marks and uses of ACE made of record are nearly as closely related to the activities of the parties as the virtually identical uses of the parties are to each

other. Thus, we agree with the Board that nothing in the record shows a narrowing of Editors' identification with A.C.E./ACE by third party marks with respect to the relevant public, namely, the film industry or even the broader entertainment industry. In sum, Cable's argument that it can use ACE because ACE is a 'weak' mark, as an abstract proposition, is not only unpersuasive but essentially meaningless.") (citation omitted); *see also Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 1325-26, 128 USPQ2d 1686, 1694-95 (Fed. Cir. 2018) (citing *Nat'l Cable Tel. Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1580, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991)).

However, considering a mark's relative strength or weakness is only part of the process of determining whether there is a likelihood of confusion. Even registered marks deemed "weak" are entitled to the presumptions of validity under Section 7(b), and are entitled to protection under Section 2(d) against the registration of confusingly similar marks. *See, e.g., In re Detroit Athletic Co.*, 903 F.3d 1297, 1304, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (affirming the Board's conclusion that confusion was likely between DETROIT ATHLETIC CO. and DETROIT ATHLETIC CLUB, marks comprised of the "conceptually weak" wording DETROIT ATHLETIC combined with the non-source identifying business identifiers "Co." and "Club"); *see also King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974); *Food Specialty Co. v. Standard Prods. Co.*, 406 F.2d 1397, 1398, 161 USPQ 46, 47 (C.C.P.A. 1969) (in speaking of marks as being weak or strong, "we should not lose sight of the ultimate question that must be answered, namely, whether there is a likelihood of confusion, mistake, or deception."). Thus, arguments that third-party use has rendered the registered mark so weak as to lack any source-identifying ability may not be raised in examination, but only in cancellation proceedings. *See, e.g., In re Dixie Rests., Inc.*, 105 F.3d 1405, 1408, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) ("it is not open to an applicant to prove abandonment of a registered mark in an ex parte registration proceeding"; a cancellation proceeding against the registrant is required) (citations omitted); *Wallpaper Mfrs., Ltd. v. Crown Wallcovering Corp.*, 680 F.2d 755, 766, 214 USPQ 327, 336 (C.C.P.A. 1982) (where a "fail[ure] to police its mark" has "caused the [registered] mark to lose its significance as a mark," a cancellation proceeding for abandonment may lie).

See TMEP §710.01(b) regarding the proper submission of Internet evidence and §710.03 regarding making third party registrations of record.

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. "The presumption of validity is not conditional; the statute provides that a certificate of registration 'shall' result in the presumption, without specifying any exceptions." *SoClean, Inc. v. Sunset Healthcare Sols., Inc.*, 52 F.4th 1363, 1369, 2022 USPQ2d 1067, at *3 (Fed. Cir. 2022).

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 Detroit Athletic Co.*, 903 F.3d 1297, 1309, 128 USPQ2d 1047, 1053 (Fed. Cir. 2018) (noting that applicant's objection to the breadth of the goods or trade channels described in the cited registration "amounts to an attack on the registration's validity" and that "the present ex parte proceeding is not the proper forum from which to launch such an attack," which is "better suited for resolution in a cancellation proceeding"); *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1408, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997); *In re Fiesta Palms, LLC*, 85 USPQ2d 1360, 1363 (TTAB2007); *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n.5 (TTAB1992); *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012, 2014-15 (TTAB1988) .

It is also inappropriate for the applicant in an ex parte proceeding 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) ("'It 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 Rests.*, 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. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018); *Jean Patou, Inc.* v. Theon Inc., 9 F.3d 971, 975, 29 USPQ2d 1771, 1774 (Fed. Cir. 1993). Rather, it is the manner in which the applicant and/or registrant have identified their goods or services that is controlling. *SeeNat'l Football League v. Jasper All. Corp.*, 16 USPQ2d 1212, 1216 & n.5 (TTAB1990) .

1207.01(d)(vi) Prior Decisions of Examining Attorneys

Each case must be decided on its own merits. *E.g.*, *In re Binion*, 93 USPQ2d 1531, 1536 (TTAB 2009) (citing *In re Sunmarks Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994)). Previous decisions by examining attorneys in approving other marks are without evidentiary value and are not binding on the agency or the Trademark Trial and Appeal Board. *In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1793 n.10 (TTAB 2017); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1206 (TTAB 2009); *In re Wilson*, 57 USPQ2d 1863, 1871 (TTAB 2001).

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 to source confusion. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993) ("even sophisticated purchasers can be confused by very similar marks"); *Weiss Assocs. v. HRL Assocs.*, 902 F.2d 1546, 1548, 14 USPQ2d 1840, 1841-42 (Fed. Cir. 1990) (similarities of goods and marks outweighed sophisticated purchasers, careful purchasing decision, and expensive goods); *In re Info. Builders Inc.*, 2020 USPQ2d 10444, at *4 (TTAB 2020) (quoting *In re Rsch. & Trading Corp.*, 793 F.2d 1276, 1279, 230 USPQ 49, 50 (Fed. Cir. 1986)) ("That the relevant class of buyers may exercise care does not necessarily impose on that class the responsibility of distinguishing between similar trademarks for similar goods [or services]. 'Human memories even of discriminating purchasers . . . are not infallible.'"); *Top Tobacco, LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011) (citing *In re Wilson*, 57 USPQ2d 1863, 1865-66 (TTAB 2001); *In re Decombe*, 9 USPQ2d 1812, 1814-15 (TTAB 1988)) ("even consumers who exercise a higher degree of care are not necessarily knowledgeable regarding the trademarks at issue, and therefore immune from source confusion"); *cf. Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 1325, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014) (affirming that TTAB properly considered all potential investors for recited services, which included sophisticated investors, but that precedent required TTAB decision to be based "on the least sophisticated potential purchasers"). However, circumstances suggesting care in purchasing may tend to minimize the likelihood of confusion. *See, e.g.*, *In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (Fed. Cir. 1985) (concluding that, because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED); *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1039 (TTAB 2016) ("even in the case of the least sophisticated purchaser, a decision as important as choosing a senior living community will be made with some thought and research, even when made hastily").

1207.01(d)(viii) Consent Agreements

The term "consent agreement" generally refers to an agreement between parties in which one party (e.g., a prior registrant) consents to the registration of a mark by the other 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 an identical or similar mark by the other party.

An applicant may submit a consent agreement in an attempt to overcome a refusal of registration under Trademark Act §2(d), or in anticipation of a refusal to register. However, an examining attorney may not solicit a consent agreement.

A consent agreement may take a number of different forms and arise under a variety of circumstances, but, when present, it is "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, 999, 224 USPQ 969, 971 (Fed. Cir. 1985); *see also In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1963 (TTAB 2016) ("[T]here is no per se rule that a consent, whatever its terms, will always tip the balance to finding no likelihood of confusion, and it therefore follows that the content of each agreement must be examined.").

Factors to be considered in weighing a consent agreement include the following:

(1) Whether the consent shows an agreement between both parties;
(2) Whether the agreement includes a clear indication that the goods and/or services travel in separate trade channels;
(3) Whether the parties agree to restrict their fields of use;
(4) Whether the parties will make efforts to prevent confusion, and cooperate and take steps to avoid any confusion that may arise in the future; and
(5) Whether the marks have been used for a period of time without evidence of actual confusion.

In re Dare Foods Inc., 2022 USPQ2d 291, at *11-12 (TTAB 2022) (citing *In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 1569, 26 USPQ2d 1071, 1074 (Fed. Cir. 1993); *In re Mastic Inc.*, 829 F.2d 1114, 1117-18, 4 USPQ2d 1292, 1295-96 (Fed. Cir. 1987); *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1362-63, 177 USPQ 563, 568 (C.C.P.A 1973)).

"Naked" consent agreements (i.e., agreements that contain little more than a prior registrant's consent to registration of an applied-for mark and possibly a mere statement that source confusion is believed to be unlikely) are typically considered to be less persuasive than agreements that detail the particular reasons why the relevant parties believe no likelihood of confusion exists and specify the arrangements undertaken by the parties to avoid confusing the public. *See In re Mastic Inc.*, 829 F.2d at 1117, 4 USPQ2d at 1295 ("If . . . the consent is 'clothed' with the parties' agreement to undertake specific arrangements to avoid confusion of the public, as in *DuPont*, the parties' assessment of no likelihood of confusion is entitled to greater weight, not because of the consent itself, but because such arrangements are additional factors which enter into the likelihood of confusion determination."); *In re E.I. du Pont de Nemours & Co.*, 476 F.2d at 1362, 177 USPQ at 568 (noting that "[i]n considering agreements, a naked 'consent' may carry little weight," but "[t]he weight to be given more detailed agreements . . . should be substantial"); *In re Dare Foods Inc.*, 2022 USPQ2d 291, at *19 ("The consent agreement in this appeal constitutes more than a mere naked consent and, therefore, plays a more dominant role in the likelihood of confusion analysis" even though the agreement did not discuss all the factors relevant to reviewing consent agreements); *In re Am. Cruise Lines, Inc.*, 128 USPQ2d 1157, 1162 (TTAB 2018) (finding "[t]he consent agreement . . . constitute[d] more than a mere naked consent and, therefore, ought to play a more dominant role in the likelihood of confusion analysis.");

see also In re Bay State Brewing Co., 117 USPQ2d at 1967 (holding confusion likely even if the parties' marks were used in accordance with the consent agreement of record, because the agreement did "not comprise the type of agreement that is properly designed to avoid confusion," nor did it "fully contemplate all reasonable circumstances in which the marks may be used by consumers calling for the goods");*In re Donnay Int'l, S.A.*, 31 USPQ2d 1953, 1956 (TTAB 1994) ("[T]he more information that is in the consent agreement as to why the parties believe confusion to be unlikely, and the more evidentiary support for such conclusions in the facts of record or in the way of undertakings by the parties, the more we can assume that the consent is based on a reasoned assessment of the marketplace, and consequently the more weight the consent will be accorded."); *In re Permagrain Prods., Inc.*, 223 USPQ 147, 149 (TTAB 1984) (finding a consent agreement submitted by applicant did not alter the conclusion that confusion was likely, because the agreement was "naked" in that it merely indicated that each party would recognize, and refrain from interfering with, the other's use of their respective marks and that the applicant would not advertise or promote its mark without its company name, but the agreement did not restrict the markets or potential customers for their goods in such a way as to avoid confusion); *cf. In re Wacker Neuson SE*, 97 USPQ2d 1408, 1415-16 (TTAB 2010) (finding an otherwise "thin consent" to be viable and reversing a §2(d) refusal, in view of the relationship of the parties, the provisions of a licensing agreement executed by the parties, and the fact that the goods and services offered under both parties' marks were manufactured and sold by applicant). Although including a provision that the parties agree to make efforts to avoid any potential confusion (see factors (3) and (4) above) is preferred and may render a consent agreement more probative, such provisions are not mandatory. *In re Am. Cruise Lines, Inc.*, 128 USPQ2d at 1162. And while evidence that the marks have been in use for a period of time without actual confusion may render a consent agreement more probative (see factor 5 above), it is not an essential provision for a consent agreement to have probative value. *In re Dare Foods Inc.*, 2022 USPQ2d 291, at *18-19.

If a consent agreement makes representations about both parties' beliefs regarding the lack of likelihood of confusion (see factors (2) through (4) above) and/or indicates that both parties have agreed to undertake certain actions to avoid confusion (see factors (3) and (4) above), then it should be signed by both parties, or by individuals with legal authority to bind the respective parties. In some instances, however, a consent document might be signed only by the registrant, because only the registrant has provided its consent, agreed to take certain actions, or made representations as to the likelihood of confusion. The absence of applicant's signature on the document in such cases does not necessarily render the document unacceptable, but, like any other consent document, its persuasive value should be determined in light of all other evidence in the record. *See, e.g., Donnay Int'l*, 31 USPQ2d at 1956-57 (finding that a consent letter signed only by the registrant and consisting merely of registrant's consent to applicant's registration and use of the applied-for mark was entitled to limited weight, but nonetheless concluding that it served to "tip the scales" in favor of reversing the §2(d) refusal, especially in view of the minimal evidence supporting the conclusion that confusion was likely); *In re Palm Beach Inc.*, 225 USPQ 785, 787-88 (TTAB1985) (concluding there was no reasonable likelihood of confusion as to applicant's and registrant's marks, based on, *inter alia*, the different nature of the parties' goods, two consent letters signed only by owners of the cited registration, and an affidavit of an officer of applicant's subsidiary indicating that actual confusion had not occurred during the more than 45 years of the marks' coexistence and that future likelihood of confusion was believed to be unlikely).

In the *In re E. I. du Pont de Nemours & Co.* decision, 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.
476 F.2d at 1363, 177 USPQ at 568.

Accordingly, the Court of Appeals for the Federal Circuit has indicated 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 relevant factors clearly dictate a finding of likelihood of confusion. *See In re Four Seasons Hotels Ltd.*, 987 F.2d at 1569, 26 USPQ2d at 1074; *In re N.A.D. Inc.*, 754 F.2d at 996, 224 USPQ at 969; *see also du Pont*, 476 F.2d at 1362-63, 177 USPQ at 568; *cf. In re Mastic Inc.*, 829 F.2d at 1118, 4 USPQ2d at 1295-96 (affirming TTAB's holding that applicant's mark was barred by §2(d), because the provided consent to register was essentially a "naked" consent and all other relevant factors weighed in favor of a conclusion that confusion was likely).

Thus, examining attorneys should give substantial weight to a proper "clothed" consent agreement. When an applicant and registrant have entered into a consent agreement that shows they have clearly thought out their commercial interests, and, *on balance*, the other factors do not dictate a finding of likelihood of confusion, the parties' consent agreement favors a conclusion that confusion is not likely.

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 regarding concurrent use.

1207.01(d)(ix) Fame of the Prior Registered Mark

According to *In re E. I. du Pont de Nemours & Co.*, the "fame of the prior mark" is a factor to be considered in determining likelihood of confusion. 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Because, in ex parte proceedings, the examining attorney is not expected to submit evidence regarding the fame of the cited mark, this factor is usually treated as neutral in such proceedings. However, this factor is usually considered more significant in inter partes proceedings. *See Bridgestone Ams. Tire Operations, LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061 (Fed. Cir. 2012); *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); *Rsch. in Motion Ltd. v. Defining Presence Mktg. Grp., Inc.*, 102 USPQ2d 1187, 1192-93 (TTAB2012) ; *In re Thomas*, 79 USPQ2d 1021, 1027 n.11 (TTAB2006) .

Famous marks are afforded a broad scope of legal protection because they are more likely to be remembered and associated in the public mind than a weaker mark. *Tiger Lily Ventures Ltd. v. Barclays Cap. Inc.*, 35 F.4th 1352, 1363, 2022 USPQ2d 513, at *8 (Fed. Cir. 2022) (finding "the LEHMAN BROTHERS mark ha[d] achieved a high degree of fame" and thus was "afforded a broad scope of protection"); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1374, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (finding Board did not err in evaluating the fame of opposer's mark VEUVE CLICQUOT); *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 1371-76, 63 USPQ2d 1303, 1305-09 (Fed. Cir. 2002) (finding opposer's marks, ACOUSTIC WAVE and WAVE, to be famous and thus entitled to broad protection); *Recot*, 214 F.3d at 1327, 54 USPQ2d at 1897 (finding Board erred in limiting the weight accorded to the fame of opposer's FRITO-LAY mark); *Kenner Parker Toys Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 353, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992) (finding Board erred in discounting the significance of the fame of opposer's mark PLAY-DOH); *UMG Recordings, Inc. v. Mattel, Inc.*, 100 USPQ2d 1868, 1883 (TTAB 2011) (finding MOTOWN very famous in connection with musical recordings and musical entertainment, and noting that "a famous mark such as Motown can be expected to cast a long shadow and to be used in connection with numerous collateral goods").

When present, the fame of a mark is "a dominant factor in the likelihood of confusion analysis . . . independent of the consideration of the relatedness of the goods." *Recot*, 214 F.3d at 1328, 54 USPQ2d at 1898 (noting that "the fame of the mark must always be accorded full weight when determining likelihood of confusion"); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB2012) (noting that "a finding that a mark enjoys significant fame expands the scope of protection which might be accorded a lesser-known mark" and that "the fame of a registered or previously used mark can never support a junior party"); *see Tiger Lily Ventures*, 35 F.4th at 1364-65, 2022 USPQ2d 513, at *8-9 (noting that applicant's attempt to benefit from the fame of the LEHMAN BROTHERS mark played a "dominant role in the process of balancing the [*du Pont*] factors" (quoting *Bose*, 293 F.3d at 1371, 63 USPQ2d at 1305)).

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. Thus, a party who asserts that its mark is famous must submit evidence clearly establishing that its mark is viewed by relevant purchasers as a famous mark. *See In re Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1409 (TTAB1998). The fame of a mark may be shown by evidence of, *inter alia*, the quantity of sales of products bearing the mark, the amount of advertising expenditures relating to the mark, and the length of time such indications of commercial awareness have been evident. *See Bose*, 293 F.3d at 1371, 63 USPQ2d at 1305-06.

Because of the nature of the evidence required to establish the fame of a registered mark, the Board normally does not expect the examining attorney to submit evidence as to the fame of the cited mark in an ex parte proceeding. *See In re Thomas*, 79 USPQ2d at 1027 n.11; *see also In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1086-88 (TTAB 2016) (considering and finding persuasive examining attorney's evidence of fame of the registered mark JAWS, but reiterating that examining attorneys are not expected to submit evidence of fame). And, in an ex parte analysis of the *du Pont* factors for determining likelihood of confusion (*see*TMEP §1207.01), the "fame of the mark" factor is normally treated as neutral when no evidence as to fame has been provided. *See id.*; *see alsoIn re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB2009) (noting that the absence of evidence as to the fame of the registered mark "is not particularly significant in the context of an ex parte proceeding").

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 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, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991). The common element may be a term, a phrase, or a component in the nature of a prefix or suffix.

In such cases, "[o]wnership of multiple registrations containing the alleged family feature or term is not sufficient, in and of itself, to establish that a party owns a family of marks"; "common law rights in the

alleged family" must be established. *Shenzhen IVPS Tech. Co., v. Fancy Pants Prods., LLC*, 2022 USPQ2d 1035, at *15-16 (TTAB 2022) (citing *New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *7 (TTAB 2020); *In re Globe-Union Inc.*, 189 USPQ 158, 160 (TTAB 1975)). Thus, it is necessary to consider "the use, advertisement, and distinctiveness of the marks, including assessment of the contribution of the common feature to the recognition of the marks as of common origin." *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d at 1463, 18 USPQ2d at 1891-92.

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 Prods.*, 24 USPQ2d 1048 (TTAB), amended by 1992 TTAB LEXIS 27 (TTAB 1992).

A family of marks argument is not available to an applicant seeking to overcome a likelihood of confusion refusal in an ex parte proceeding; instead, 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, 1645 (TTAB2009) ; *see also In re Ald, Inc.*, 148 USPQ 520, 521 (TTAB1965) ("[I]n view of the specific prohibition of Section 2(d) . . ., the fact that applicant may possess a 'family' of marks characterized by the term 'ALD' is of no particular significance herein if the mark for which applicant now seeks registration . . . is confusingly similar to the previously registered mark . . . .").

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 Chem. Co.*, 166 USPQ 218, 219 (TTAB1970). 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. *See In re Hitachi High-Techs. Corp*., 109 USPQ2d 1769, 1772 (TTAB2014); *In re Mobay Chem. Co.*, 166 USPQ at 219.

See TMEP §1212.06(e)(v) regarding the use of evidence of a family of marks to support of a claim of acquired distinctiveness.

1207.01(d)(xii) Pharmaceuticals or Medicinal Products

When determining if a likelihood of confusion exists between marks used in connection with pharmaceuticals or medicinal products for human use, greater care must be taken to avoid confusion because mistakes in the selection and use of these goods may result in serious and harmful consequences. *See Clifton v. Plough, Inc.*, 341 F.2d 934, 934, 144 USPQ 599, 600 (C.C.P.A.1965) ; *In re Cook Med. Tech. LLC*, 105 USPQ2d 1377, 1381-82 (TTAB2012); *Schering Corp. v. Alza Corp.*, 207 USPQ 504, 509 (TTAB1980); *Am. Home Prods. Corp. v. USV Pharm. Corp.*, 190 USPQ 357, 359-60 (TTAB1976) . Thus, in cases where confusion involving pharmaceuticals or medicinal products could result in harm or other serious consequences to consumers, the Trademark Trial and Appeal Board and its primary reviewing court have considered this an additional relevant factor and applied a stricter standard that may require a lesser degree of proof to establish likelihood of confusion. *See Glenwood Labs., Inc. v. Am. Home Prods. Corp.*, 455 F.2d 1384, 1386-87, 173 USPQ 19, 21-22 (C.C.P.A.1972); *Schering Corp.*, 207 USPQ at 509; *Ethicon, Inc. v. Am. Cyanamid Co.*, 192 USPQ 647, 651-52 (TTAB1976) . *But seeMini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1478 (TTAB2016)(considering opposer's arguments based on safety concerns about potential consumer confusion regarding opposer's ice cream and applicant's medicine, but finding that "any problems arising from the abuse or misuse of Applicant's medicine, whether potential or actual, has no demonstrated relationship to the identical trademarks under which Applicant's medicine and Opposer's ice cream are sold").

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 based on rights acquired by concurrent use of its mark, either with the owner of a registration or application for a conflicting mark or with a common-law user of a conflicting mark.

In a concurrent use application, the applicant normally requests a geographically restricted registration. *See* TBMP §§1101.01, 1103.01(d)(2). 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. *See* 15 U.S.C. §1051(a)(3)(D); 37 C.F.R. §2.42(b); TBMP §§1102.01, 1103.01. These other parties may own applications or registrations, or they may have common law rights in a mark, but no application or registration. TBMP §1104.

There are two bases upon which a concurrent use registration may be issued: (1) a determination by the Trademark Trial and Appeal Board, in either a prior or to-be-instituted concurrent use proceeding, that the applicant is entitled to a concurrent registration; or (2) a final determination by a court of competent jurisdiction of the concurrent rights of the relevant parties to use the same or similar marks in commerce. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.99; TBMP §1102.02.

"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. TBMP §1105; *see Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 319-20, 189 USPQ 630, 636 (C.C.P.A.1976) ; *Thriftimart, Inc. v. Scot Lad Foods, Inc.*, 207 USPQ 330, 334 (TTAB1980).

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); TBMP §1105.

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 Registration

Before seeking concurrent use, an applicant must assert use in commerce in its application and include in the application all the application requirements for a trademark, service mark, collective mark, or certification mark. 37 C.F.R. §2.42(a). For information regarding specific application requirements, see TMEP §§801-806.01(e) for trademarks and service marks, TMEP §1303.01 for collective trademarks and collective service marks, TMEP §1304.02 for collective membership marks, and TMEP §1306.02 for certification marks.

If an application is based on use in commerce under §1(a) of the Trademark Act, the applicant may seek concurrent use registration at the time the application is filed or in a subsequent amendment. *See* 37 C.F.R. §§2.42(a), 2.73. For information regarding amending to concurrent use, see 37 C.F.R. §2.73.

If an application is based on a bona fide intent to use the mark in commerce under §1(b) of the Trademark Act, the applicant may not amend to seek concurrent use registration until the applicant files an acceptable allegation of use. *See* 37 C.F.R. §§2.73, 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).

1207.04(c) Criteria for Requesting Concurrent Use Registration

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 (or a decision by the Board in a prior concurrent use proceeding) reflecting a 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.

See 15 U.S.C. §1052(d); 37 C.F.R. §2.99(e). The applicant has the burden of proving that it is entitled to a concurrent use registration. 37 C.F.R. §2.99(e); *Hanscomb Consulting, Inc. v. Hanscomb Ltd.*, 2020 USPQ2d 10085, at *4 (TTAB 2020) (citing *Stawski v. Lawson*, 129 USPQ2d 1036 (TTAB 2018)); *America's Best Franchising, Inc. v. Abbott*, 106 USPQ2d 1540, 1548 (TTAB 2013) (quoting *Over the Rainbow, Ltd. v. Over the Rainbow, Inc*., 227 USPQ 879, 883 (TTAB 1985)).

1207.04(d) 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.

1207.04(d)(i) Concurrent Use Application for a Trademark or Service Mark

In addition to the requirements for a trademark or service mark application (*see* TMEP §§801-806.01(e)), a concurrent use application must include a verified statement in which the applicant attests to certain information. *See* 37 C.F.R. §2.42(b).

The required verified statement must include the following:

(1) the applicant's goods and/or services, the geographic area in which the applicant is using the mark in commerce, and the mode of use for which the applicant seeks registration;
(2) the concurrent users' names and addresses, the concurrent user's goods and/or services, and the registrations issued to or applications filed by the concurrent users (if any), to the extent known by the applicant; and
(3) the geographic areas in which the concurrent user is using the mark in commerce, the mode of use by the concurrent users, and the time periods of such use by the concurrent users, to the extent known by the applicant.

See 15 U.S.C. §§1051(a)(3)(D), 1053; 37 C.F.R. §2.42(b); TBMP §1101.

For a §1(a) application, an applicant must also modify the verified statement required for an unrestricted application under 37 C.F.R. §2.33(b)(1) (*see* TMEP §804.02) to indicate an exception, i.e., that no other person *except as specified in the application* has the right to use the mark in commerce. 37 C.F.R. §2.33(f); *see*15 U.S.C. §1051(a)(3)(D).

The applicant does not have to insert the information in the list above directly in the verification or declaration at the end of the application; this information may be set forth anywhere in the application as long as it is attested to by the applicant.

In addition to the requirements noted above, 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)-(e)(i)), pursuant to the decree of a court (*see*TMEP §§1207.04(f)-(f)(i)), or based on a final decision by the Board in a prior concurrent use proceeding (*see*TMEP §§1207.04(g)-(g)(i)).

1207.04(d)(ii) Concurrent Use Application for a Collective or Certification Mark

In addition to the requirements for a collective or certification mark application (*see* TMEP §§1303.01, 1304.02, 1306.02), a concurrent use application must include a verified statement in which the applicant attests to certain information. *See* 37 C.F.R. §2.42(b).

The required verified statement must include the following, to the extent known by the applicant:

(1) the applicant's members' or authorized users' goods and/or services, for a collective trademark, collective service mark, or certification mark, or the nature of the applicant's collective membership organization, for a collective membership mark;
(2) the geographic area in which the applicant's members or authorized users are using the mark in commerce and the mode of use for which the applicant seeks registration;
(3) the concurrent users' names and addresses and the registrations issued to or applications filed by the concurrent users (if any);

(4) the concurrent user's members' or authorized users' goods and/or services, for a collective trademark, collective service mark, or certification mark, or the nature of the concurrent user's collective membership organization, for a collective membership mark; and
(5) the geographic areas in which the concurrent user's members or authorized users are using the mark in commerce, the mode of use by the concurrent users' members or authorized users, and the time periods of such use by the concurrent users' members or authorized users.

See 15 U.S.C. §§1051(a)(3)(D) ,1054; 37 C.F.R. §2.42(b); TBMP §1101.01.

For a §1(a) collective mark application, an applicant must also modify the verified statement required for an unrestricted application under 37 C.F.R. §2.44(a)(4)(i)(D) (*see* TMEP §§1303.01(b)(i), 1304.02(b)(i)) to indicate an exception, i.e., that no other persons *except members and the concurrent user(s) as specified in the application* have the right to use the mark in commerce. 37 C.F.R. §2.44(d); *see*15 U.S.C. §§1051(a)(3)(D), 1054.

For a §1(a) certification mark application, an applicant must also modify the verified statement required for an unrestricted application under 37 C.F.R. §2.45(a)(4)(i)(F) (*see* TMEP §1306.02(b)(i)) to indicate an exception, i.e., that no other persons except authorized users and *concurrent user(s) as specified in the application* have the right to use the mark in commerce. 37 C.F.R. §2.45(d); *see*15 U.S.C. §§1051(a)(3)(D), 1054.

The applicant does not have to insert the information in the list above directly in the verification or declaration at the end of the application; this information may be set forth anywhere in the application as long as it is attested to by the applicant.

In addition to the requirements noted above, 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)-(e)(i)), pursuant to the decree of a court (*see*TMEP §§1207.04(f)-(f)(i)), or based on a final decision by the Board in a prior concurrent use proceeding (*see*TMEP §§1207.04(g)-(g)(i)).

1207.04(e) Applications Subject to Concurrent Use Proceeding Before the Trademark Trial and Appeal Board

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 superior 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 Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 526-27, 3 USPQ2d 1306, 1308-09 (Fed. Cir. 1987); *America's Best Franchising Inc. v. Abbott*, 106 USPQ2d 1540, 1549 (TTAB2013) (citing *In re Beatrice Foods Co*., 429 F.2d 466, 472-73, 166 USPQ 431,435-36 (C.C.P.A. 1970)); *In re The Place for Vision, Inc.*, 196 USPQ 267, 269-70 (TTAB1977).

If an application that seeks registration through a concurrent use proceeding before the Board complies with the relevant requirements and it appears that the applicant is otherwise entitled to registration but for the question of concurrent rights, the examining attorney will approve the application for publication subject to a concurrent use proceeding. *See*15 U.S.C. §1062(a). The examining attorney must not issue a refusal under §2(d) as to any registration named by the applicant as an exception to its exclusive rights.

If, in response to a refusal under §2(d) or an advisory regarding an earlier-filed application, an application is amended to seek registration through a concurrent use proceeding and complies with the relevant requirements, and it appears that the applicant is otherwise entitled to registration but for the question of concurrent rights, the examining attorney will withdraw the previously issued refusal or advisory as to any registration or application named by the applicant as an exception to its exclusive rights and will approve the application for publication subject to a concurrent use proceeding.

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. 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. Pursuant to TBMP §1103.01(f), 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].

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. *See* 37 C.F.R. §2.99; TMEP §1506. 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 TBMP Chapter 1100 regarding concurrent use proceedings.

1207.04(f) Application for Concurrent Use Registration Pursuant to Court Decree

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. 15 U.S.C. §1052(d). An applicant who seeks a concurrent use registration on the basis of a court determination does not have to be a prior user or obtain the consent of the owner of the involved mark. *See Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 317-18, 189 USPQ 630, 633-34 (C.C.P.A.1976); *cf. Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc.*, 293 F.2d 685, 690-94, 130 USPQ 412, 417-20 (C.C.P.A.1961); TBMP §1103.03.

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)(i)-(ii)) and the requirements that would apply to an unrestricted application (see TMEP §§801-806.01(e) for trademarks and service marks, 1303.01 for collective trademarks and collective service marks, 1304.02 for collective membership marks, and 1306.02 for certification marks).

In addition, under 37 C.F.R. §2.99(f), all 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), (e)(i)), rather than pursuant to the court decree. *See* 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. Pursuant to TBMP §1103.03, the statement must 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.

1207.04(g) Application for Concurrent Use Registration Based on Final Board Decision in Prior Concurrent Use Proceeding

A concurrent use registration may also be based on a final determination by the Trademark Trial and Appeal Board, in a prior concurrent use proceeding, that applicant is entitled to a concurrent use registration of its mark. TBMP §1103.02.

When examining an application for a concurrent use registration based on a final Board decision in a prior concurrent use proceeding, the examining attorney must determine whether the application complies with the specific requirements for concurrent use applications (*see*TMEP §1207.04(d)(i)-(ii)) and all other requirements that would apply to an unrestricted application.

In addition, pursuant to TBMP §1103.02, the following conditions must be met:

(1) The applicant is entitled to registration subject only to the concurrent lawful use of a party or parties to the prior concurrent use proceeding;

(2) The Board's prior decision specifies applicant's right to concurrent use registration;
(3) A copy of the Board's prior decision is submitted to the examining attorney;
(4) The concurrent use application complies with the Board's prior decision, in that it seeks registration for the same, or a more limited, geographic area or mode of use than granted to the applicant in the prior decision; seeks registration for substantially the same mark or one less confusingly similar to those of the other party or parties in the prior proceeding; and seeks registration for substantially the same goods/services/collective membership organization as, or more limited goods/services/collective membership organization than those listed in the Board's prior specification of the applicant's entitlement to concurrent registration; 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 Board's prior decision.

If the conditions listed above are satisfied, the examining attorney must ensure that the appropriate concurrent use statement for registration based on a final determination by the Board in a *prior* concurrent use proceeding is entered into the Trademark database (*see* TMEP §1207.04(g)(i)) and approve the application for publication. *See* TBMP §1103.02.

If any of the conditions listed above are *not* satisfied, the examining attorney will approve the application for publication subject to a new concurrent use registration proceeding before the Board (*see* TMEP §§1207.04(e), (e)(i)), rather than pursuant to a final decision of the Board in a prior concurrent use proceeding. *See* TBMP §1103.02.

1207.04(g)(i) Preparing the Record for Publication

If the application satisfies all the conditions listed in TMEP §1207.04(g), complies with all other relevant requirements, and is otherwise entitled to registration, the examining attorney will approve the application for publication of the mark. 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. Pursuant to TBMP §1103.02, the statement must delineate the concurrent rights of the parties as determined by the Board, in the following form:

> Registration limited to the area comprising _____ [indicating the area specified in the Board's prior decision as the area for which applicant is entitled to registration and any other restriction designated by the Board] pursuant to Concurrent Use Proceeding No. _____ [specifying the number of the prior concurrent use proceeding].
> Concurrent registration with _____ [specifying the application serial number(s) or registration number(s), if any, of each other party involved in the prior concurrent use proceeding; 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 CFR §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. *See* 37 C.F.R. §2.83(a).

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. *Id*. In rare situations, the effective filing date changes after submission of an amendment to allege use and amendment to the Supplemental Register. *See*TMEP §206.01. In such cases, the examining attorney must conduct a new search and follow the procedures discussed in TMEP §206.04. However, once a registration issues, a likelihood-of-confusion refusal that is required by the Trademark Act applies regardless of the filing-date priority of the underlying application. Internal examination procedures do not have primacy over statutory law, and a refusal that is authorized by the Trademark Act will not be considered invalid due to errors in examination procedure. *In re House Beer, LLC*, 114 USPQ2d 1073, 1076 (TTAB2015). See TMEP §§206-206.03 regarding effective filing dates.

The examining attorney cannot refuse registration under §2(d) of the Trademark Act based on a conflicting mark in an earlier-filed application until the conflicting mark registers. *See* TMEP §1207.01. Therefore, when the examining attorney has examined the later-filed application and determined that, but for the conflict between the marks, it is in condition to be approved for publication or issue, or in condition for a final refusal, 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 §§1207-1207.01(d)(xi) regarding likelihood of confusion. There may be multiple 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. TMEP §201. 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. 15 U.S.C. §1141f(b); 37 C.F.R. §7.26; 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 §§206.01-206.03. 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 the foreign application was first filed in the foreign country. 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. 37 C.F.R. §2.75(b); TMEP §206.01. However, the USPTO does not alter the original filing date in its automated records. TMEP §206.

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 approved for publication for opposition or for issuance of a registration 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.

Although a properly signed declaration is part of an international registration on file with the IB, it is not sent to the USPTO with a request for extension of protection under §66(a). Therefore, if an application under §66 has the same effective filing date as an application under §1 or §44, the filing date of the §66 application will be treated as the 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”-“79,” “87,” “88,” or “90”) and look only to the six-digit serial number that follows.

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.

Whenever the effective filing date of an application changes to a date that is later than the original filing date, the assigned examining attorney must conduct a new search of the mark. *See* TMEP §206.04.

1208.01(d) Examination of Conflicting Marks After Reinstatement or Revival

When an application listed as abandoned in the USPTO’s Trademark database is revived or reinstated (*see* TMEP §§1712.01, 1713, and 1714), 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 for a conflicting mark has been approved, or the §2(d) search for the later-filed application occurred when the earlier-filed application was in abandoned status, the examining attorney should inform the examining attorney with the later-filed application that the earlier-filed application has been revived or reinstated, so that appropriate action may be taken. 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.

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 §§206-206.03 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 must 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); *see In re Direct Access Commc'ns (M.C.G.) Inc.*, 30 USPQ2d 1393, 1394 (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 must 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.

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 arguments are 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 §§1504.03-1504.04(a) concerning obtaining jurisdiction of an application after publication.

The examining attorney has jurisdiction over 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

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 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. These cases are extremely rare and are generally limited to situations where a party would be unduly prejudiced without an interference, such as where it would otherwise be required to engage in a series of opposition or cancellation proceedings involving substantially the same issue. *See*TMEP §1208.03(b).

An interference will not be declared except upon petition to the Director. 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

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. The availability of opposition and cancellation procedures provides a remedy and ordinarily precludes the possibility of undue prejudice to a party. *Id* . 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 Am., Inc.* , 180 USPQ 332, 333 (Comm'r Pats. 1974). 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. 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) also 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, 172 (Comm'r Pats. 1974); *Ex parte H. Wittur & Co.* , 153 USPQ 362, 362-63 (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.

All marks must be published for opposition before interference proceedings are instituted. *Id*. 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.

*See*TBMP Chapter 1000.

1209 Refusal on Basis of Descriptiveness

15 U.S.C. §1052 (Extract)

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 Dev. 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 Prods., Inc. v. N. Am. 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.*, "[t]he name of a thing is in fact the ultimate in descriptiveness." 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)).

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 §2(f) of the Trademark Act, 15 U.S.C. §1052(f). See TMEP §1209.01(b) regarding merely descriptive marks and §§1212–1212.10 regarding acquired distinctiveness. Merely descriptive marks may be registrable on the Supplemental Register in applications under §1 or §44 of the Trademark Act. *See*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)–(c)(iii).

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 Grp., 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. *In re N.C. Lottery*, 866 F.3d 1363, 1367, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017) (citing *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251-52, 13 USPQ2d 1753, 1755 (Fed. Cir. 2012)); *see In re Fallon*, 2020 USPQ2d 11249, at *7 (TTAB 2020) (citing *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1515 (TTAB 2016)). 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 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 (TTAB1978) (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 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, 364–65 (TTAB1983) (SNO-RAKE held not merely descriptive of a snow-removal hand tool); *see alsoIn re Vienna Sausage Mfg. Co.*, 156 USPQ 155, 156 (TTAB1967) (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 (TTAB1966) (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. *See Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.* , 372 F.3d 1330, 1340, 71 USPQ2d 1173, 1180 (Fed. Cir. 2004). Therefore, a designation does not have to be devoid of all meaning in relation to the goods or services to be registrable. If, after conducting independent research, it is unclear to the examining attorney whether a term in a mark has meaning in the relevant industry, the examining attorney must make an inquiry of the applicant, pursuant to 37 C.F.R. §2.61(b). If the examining attorney determines that the term is arbitrary or fanciful, the examining attorney may enter a Note to the File in the record indicating that research was conducted regarding the meaning of the term in the relevant industry, without stating any legal opinions or conclusions.

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 TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574 (Fed. Cir. 2015) (NOPALEA held descriptive of dietary and nutritional supplements); *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). Similarly, a mark is considered merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of an applicant's goods or services. *In re N.C. Lottery*, 866 F.3d 1363, 1367, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017) (citing *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963-64, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012).

The examining attorney is not required to prove that others have used the mark at issue or that they need to use it; the correct test is whether the mark conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods. *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1514 (TTAB2016); *see also KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 122 (2004) (trademark law does not countenance someone obtaining "a complete monopoly on use of a descriptive term simply by grabbing it first"); *In re Walker Mfg. Co.*, 359 F. 2d 474, 149 USPQ 528 (C.C.P.A.1966); (quoting Board decision with approval) ("The question . . . is not whether the Board or others may or would utilize 'CHAMBERED PIPE' to describe applicant's goods, but whether this designation does, in fact, describe such goods. That there are other words which others may employ to describe or define applicant's goods does not, in any way, lessen the descriptive character of the words 'CHAMBERED PIPE.'"); *Clairol, Inc. v. Roux Distrib. Co.*, 280 F.2d 863, 126 USPQ 397, 398 (C.C.P.A. 1960) ("Even novel ways of referring to a product may nonetheless be merely descriptive."); *In re Bailey Meter Co.*, 102 F.2d 843, 41 USPQ 275, 276 (C.C.P.A. 1939) ("The fact that appellant may have been the first and only one to adopt and use the mark sought to be registered does not prove that the mark is not descriptive . . . .").

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. *In re Chamber of Commerce*, 675 F.3d at 1300, 102 USPQ2d at 1219 (quoting *In re Bayer*, 488 F.3d at 964, 82 USPQ2d at 1831); *In re Omniome, Inc.*, 2020 USPQ2d 3222, at *3 (TTAB 2019) (citing *In re Fat Boys Water Sports LLC*, 118 USPQ2d at 1513); *see In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (C.C.P.A. 1978). This requires consideration of the context in which the mark is used or intended to be used in connection with those goods or 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 Chamber of Commerce*, 675 F.3d at 1300, 102 USPQ2d at 1219 (quoting *In re Bayer*, 488 F.3d at 964, 82 USPQ2d at 1831); *In re Nett Designs, Inc.*, 236 F.3d 1339, 1341-42, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); *In re Omaha Nat'l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Dev. Corp.*, 588 F.2d at 814, 200 USPQ at 218. Sources for considering the context in which the mark is or may be used include websites, publications, labels, packages, advertising material, and explanatory text on specimens for the goods and services. *See In re N.C. Lottery*, 866 F.3d at 1368, 123 USPQ2d at 1710; *In re Nett Designs, Inc.*, 236 F.3d at 1342, 57 USPQ2d at 1566; *In re Abcor Dev. Corp.*, 588 F.2d at 814, 200 USPQ at 218.

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 Chamber of Commerce*, 675 F.3d at 1300, 102 USPQ2d at 1219 (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); *In re Zuma Array Ltd.*, 2022 USPQ2d 736, at *5 (TTAB 2022); *In re Fallon*, 2020 USPQ2d 11249, at *7 (TTAB 2020); *In re Fat Boys Water Sports LLC*, 118 USPQ2d at 1513; *see 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."). Similarly, the mark need not describe all the goods and services identified, as long as it merely describes one of them. *In re Chamber of Commerce*, 675 F.3d at 1300, 102 USPQ2d at 1219; *In re Oppedahl & Larson LLP*, 373 F.3d at 1173, 71 USPQ2d at 1371 (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d at 1346, 57 USPQ2d at 1812); *In re Gyulay*, 820 F.2d at 1218, 3 USPQ2d at 1010; *In re Zuma Array Ltd.*, 2022 USPQ2d 736, at *5-6; *In re Positec Group Ltd.*, 108 USPQ2d 1161, 1171 (TTAB 2013) ("[I]f the mark is descriptive of some identified items – or even just one – the whole class of goods still may be refused by the examiner."); *In re Cox Enters. Inc.*, 82 USPQ2d 1040 (TTAB 2007); *see also In re Omaha Nat'l Corp.*, 819 F.2d 1117, 1119, 2 USPQ2d 1859, 1861 (Fed. Cir. 1987) (rejecting argument that descriptiveness should be limited to a quality or characteristic of the service itself and holding that it includes a designation descriptive of the service provider).

A term also may be considered merely descriptive if the identified services fall within a subset of services indicated by the term. *See In re Am. Soc'y of Clinical Pathologists, Inc.*, 442 F.2d 1404, 1406-07, 169 USPQ 800, 801 (C.C.P.A. 1971) (holding that REGISTRY OF MEDICAL PATHOLOGISTS was descriptive of certain claimed services that were implicitly subsumed within service of providing a registry of medical pathologists and of additional claimed services that were "supporting, ancillary or auxiliary to the primary function" of applicant's registry services); *see also In re Chamber of Commerce*, 675 F.3d at 1301-02, 102 USPQ2d at 1220 (NATIONAL CHAMBER held descriptive because "substantial evidence supports the TTAB's determination that the designated business and regulatory data analysis services are within the scope of traditional chambers of commerce activities" of "promoting the interests of businessmen and businesswomen").

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 (TTAB1985); *In re Venturi, Inc.*,197 USPQ 714 (TTAB 1977).

See TMEP §§1209.03–1209.03(y) regarding factors that often arise in determining whether a mark is merely descriptive or generic, §§1213–1213.11 regarding disclaimers of merely descriptive matter within marks, and §1306.04 regarding assessing descriptiveness in certification marks.

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 Am. Fertility Soc'y*, 188 F.3d 1341, 1346, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999). A generic term is "the ultimate in descriptiveness" under §2(e)(1) and incapable of acquiring distinctiveness under §2(f). *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989, 228 USPQ 528, 530 (Fed. Cir. 1986). A generic term also does not meet the statutory definition of a mark because it is incapable of denoting a unique source. *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 1569 (Fed. Cir. 1987) ("Generic terms, by definition incapable of indicating source, are the antithesis of trademarks, and can never attain trademark status."). Thus, generic terms are not registrable on the Principal Register under §2(f) or on the Supplemental Register. *See also Clairol, Inc. v. Roux Distrib. Co.*, 280 F.2d 863, 126 USPQ 397, 398 (CCPA 1960) ("The generic name by which a product is known is

not a mark which can be registered on the Supplemental Register under section 23 because such a name is incapable of distinguishing applicant's goods from goods of the same name manufactured or sold by others."); *In re Empire Tech. Dev. LLC*, 123 USPQ2d 1544, 1566 (TTAB 2017) (affirming the refusal to register COFFEE FLOUR on the Supplemental Register).

Generic terms are refused registration on the Principal Register under Trademark Act §§1, 2, and 45, for trademarks, and §§1, 2, 3, and 45, for service marks. See 15 U.S.C. §§1051, 1052, 1053, 1127. The statutory basis for refusal on the Supplemental Register is §§23(c) and 45. *See*15 U.S.C. §§1091(c), 1127.

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. A disclaimer does not render an otherwise unregistrable generic mark registrable. *See*TMEP §§1213.06 and 1213.08(c).

1209.01(c)(i) Test

A mark is generic if its primary significance to the relevant public is the class or category of goods or services on or in connection with which it is used. *See USPTO v. Booking.com B.V.*, 140 S. Ct. 2298, 2304, 2020 USPQ2d 10729, at *5 (2020); *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 965, 114 USPQ2d 1827, 1830 (Fed. Cir. 2015) (quoting *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989-90, 228 USPQ 528, 530 (Fed. Cir. 1986)). A two-part inquiry is used to determine whether a designation is generic:

(1) What is the genus of goods or services at issue?

(2) Does the relevant public understand the designation primarily to refer to that genus of goods or services?

In re Cordua Rests., Inc., 823 F.3d 594, 599, 118 USPQ2d 1632, 1634 (Fed. Cir. 2016) (citing *H. Marvin Ginn Corp.*, 782 F.2d at 990, 228 USPQ at 530).

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, 1364, 92 USPQ2d 1682, 1685 (Fed. Cir. 2009).

The genus of the goods or services may be defined by an applicant's identification of goods or services. *SeeIn re Cordua Rests., Inc.*, 823 F.3d 594, 602, 118 USPQ2d 1632, 1636 (Fed. Cir.2016)(quoting *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 640, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991). The relevant public for a genericness determination refers to the purchasing or consuming public for the identified goods or services. *Loglan Inst., Inc. v. Logical Language Grp., Inc.*, 962 F.2d 1038, 1041, 22 USPQ2d 1531, 1533 (Fed. Cir. 1992) (quoting *Magic Wand Inc.*, 940 F.2d at 641, 19 USPQ2d at 1553); *Int'l Dairy Foods Ass'n*, 2020 USPQ2d 10892, at *12 (TTAB 2020); *Milwaukee Elec. Tool Corp.*, 2019 USPQ2d 460354, at *9 (TTAB 2019).

The examining attorney must establish a prima facie case that a term is generic by providing a reasonable predicate (or basis) that the relevant purchasing public would primarily use or understand the matter sought to be registered to refer to the genus of goods or services in question.

Evidence of the relevant public's understanding of a term can be obtained from any competent source, including dictionary definitions, research databases, Internet websites, newspapers, and other publications. *See USPTO v. Booking.com* B.V., 140 S. Ct. at 2307 n.6, 2020 USPQ2d 10729, at *7 n.6 ("Evidence

informing [a genericness] inquiry can include not only consumer surveys, but also dictionaries, usage by consumers and competitors, and any other source of evidence bearing on how consumers perceive a term's meaning."); *In re Consumer Prot. Firm PLLC*, 2021 USPQ2d 238, at *8-12 (TTAB 2021) (THE CONSUMER PROTECTION FIRM held generic for legal services, where the examining attorney cited examples of webpages of third party consumer protection law firms and three different lawyer search sites where "consumer protection" could be selected as a search term for consumers to find attorneys in that practice area); *see also In re Cordua Rests., Inc.*, 823 F.3d at 594, 118 USPQ2d at 1632 (finding the evidence of record, which included dictionary excerpts, online magazine articles, and newspaper articles, supported the conclusion that CHURRASCOS is generic for restaurant services); *In re Northland Aluminum Prods., 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, where the examining attorney cited cookbooks and food-related news articles); *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, where the examining attorney cited dictionaries and Nexis® articles). 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 or services. *In re Reed Elsevier Props. Inc.*, 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007) (finding that, 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."). In addition, competitor use is recognized as evidence of genericness. *In re Hikari Sales USA, Inc.*, 2019 USPQ2d 111514, at *2 (TTAB 2019) (finding probative the generic uses of the term "algae wafers" by competitors); *Cont'l Airlines, Inc. v. United Air Lines, Inc.*, 53 USPQ2d 1385, 1395 (TTAB 1999) (use of term "e-ticket" by media and competitors indicates term is generic for electronic tickets); *Philip Morris Inc. v. Brown & Williamson Tobacco Corp.*, 230 USPQ 172, 176 (TTAB 1986) (evidence that competitors have used a particular word as the name of their goods is persuasive evidence of genericness)).

There can be more than one generic term for a particular genus of goods or services. "Any term that the relevant public uses or understands to refer to the genus of goods [or services], or a key aspect or subcategory of the genus, is generic." *In re Twenty-Two Desserts, LLC*, 2019 USPQ2d 292782, at *2 (TTAB 2019) (citing *Royal Crown Co. v. Coca Cola Co.*, 892 F.3d 1358, 1368, 127 USPQ2d 1041, 1046-47 (Fed. Cir. 2018)); *see In re Cordua Rests., Inc.*, 823 F.3d at 604, 118 USPQ2d at 1638; *In re 1800Mattress.com IP, LLC*, 586 F.3d at 1364, 92 USPQ2d at 1685. See TMEP §1209.03(v) regarding generic terms that are a key aspect of goods or services.

The test for genericness is the same whether the mark is a compound term or a phrase, and the examining attorney should include, if available, evidence showing use of the mark as a whole in the record. *See Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d at 968, 114 USPQ2d at 1832 (citing *In re Am. Fertility Soc'y*, 188 F.3d 1341, 1348-49, 51 USPQ2d 1832, 1837 (Fed. Cir. 1999)). However, the fact that there is no evidence of third-party use of the precise compound term or phrase is not, by itself, necessarily fatal to a finding of genericness. *In re Mecca Grade Growers, LLC*, 125 USPQ2d 1950, 1957 (TTAB 2018). When a term consists of a compound word or a telescoped word, the examining attorney may establish that the term is generic by producing evidence that each of the constituent words is itself generic, and that the separate words retain their generic significance when joined to form the compound or telescoped word that has "a meaning identical to the meaning common usage would ascribe to those words as a compound." *E.g., In re Gould Paper Corp.*, 834 F.2d 1017, 1018, 5 USPQ2d 1110, 1111–12 (Fed. Cir. 1987) (holding SCREENWIPE generic where "screen" and "wipe" were "as generic in the compound as individually, and the compound thus created [was] itself generic"); *In re Virtual Indep. Paralegals, LLC*, 2019 USPQ2d 111512, at *8 (TTAB 2019) (holding VIRTUAL INDEPENDENT PARALEGALS generic where "virtual paralegal" referred to a paralegal who worked remotely, "independent paralegal" identified a class of

paralegals who performed their work without attorney supervision, and combining these terms provided no additional or changed meaning); *In re Mecca Grade Growers, LLC*, 125 USPQ2d at 1957 (holding MECHANICALLY FLOOR-MALTED generic where "mechanically" meant "of or relating to machinery" and "floor-malted" was the adjectival form of "floor malting," which was an established practice in the brewing and distilling industry that could be performed manually or with machinery; and combining these terms provided no additional or changed meaning); I *n re Greenliant Sys. Ltd.*, 97 USPQ2d 1078, 1081 (TTAB 2010) (finding that consumers were likely to perceive the telescoped term NANDRIVE merely as a stylized version of the generic term "nand drive"); *In re Wm. B. Coleman Co., Inc.*, 93 USPQ2d 2019 (TTAB 2010) (finding 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, 1345, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001) (citing *In re Am. Fertility Soc'y*, 188 F.3d at 1348-49, 51 USPQ2d at 1837). Thus, 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 because, unlike in *Gould*, the evidence did not establish that the public would perceive "the mark as a whole" to be no less generic than its constituents. *In re Am. Fertility Soc'y*, 188 F.3d at 1348, 51 USPQ2d at 1837; *see also Princeton Vanguard*, 786 F.3d at 968, 114 USPQ2d at 1832. In *In re Wm. B. Coleman Co.*, however, the Board stated that *American Fertility Society* cannot be read to suggest that an applicant can create a trademark merely by adding a clearly generic term to a non-source-identifying word, even without proof that others have used the composite. *In re Wm. B. Coleman Co.*, 93 USPQ2d at 2025; *accord Princeton Vanguard*, 786 F.3d at 968, 114 USPQ2d at 1833 ("[T]he Board must then consider *available* record evidence of the public's understanding of whether joining those individual words into one lends additional meaning to the mark as a whole." (emphasis added)).

In *Dial-A-Mattress*, 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, as with other marks, even if the evidence shows that the individual components that make up the proposed mark are generic, one must determine whether the evidence shows that the composite is itself generic or is instead merely descriptive and thus capable of indicating source. *See USPTO v. Booking.com B.V.*, 140 S. Ct. at 2298, 2020 USPQ2d 10729, at *1. However, "[a] compound of generic elements is [also] generic if the combination yields no additional meaning to consumers capable of distinguishing the goods or services." *Id.* at 2306, 2020 USPQ2d 10729, at *7. 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 & Assocs., Inc.*, 199 USPQ 358, 364 (TTAB1978) , *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 is inappropriate. Rather, the terminology of the Act must 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 (TTAB1984) (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 Indus. Rels. Couns., 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 the terminology used in refusing registration of such matter, the Trademark Trial and Appeal Board noted as follows in *In re Women's Publishing Co.*, 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 . . . on the basis that the mark sought to be registered is generic.

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* Linda McLeod, *The Status of so Highly Descriptive & Acquired Distinctiveness*, 82 Trademark Rep. 607 (1992). Therefore, examining attorneys must 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" must be used in appropriate refusals, and use of the terminology "so highly descriptive" must 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 an 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. Int'l Ass'n of Fire Chiefs, Inc.*, 782

F.2d 987, 989–90, 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. *See, e.g., In re Serial Podcast, LLC,* 126 USPQ2d 1061, 1067 (TTAB 2018) (holding SERIAL generic for an ongoing audio program featuring investigative reporting, interviews, and documentary storytelling); *In re Mecca Grade Growers, LLC,* 125 USPQ2d 1950, 1959-60 (TTAB 2018) (holding MECHANICALLY FLOOR-MALTED generic for malt for brewing and distilling and processing of agricultural grain); *Sheetz of Del., Inc. v. Doctor's Assocs. Inc.,* 108 USPQ2d 1341 (TTAB2013) (holding FOOTLONG generic for sandwiches, excluding hot dogs); *In re Reckitt & Colman, N. Am. Inc.,* 18 USPQ2d 1389 (TTAB1991) (holding PERMA PRESS generic for soil and stain removers for use on permanent press products). Similarly, evidence showing that a term in singular form is generic typically will suffice to show that the plural also is generic. *SeeIn re Cordua Rests., Inc.,* 823 F.3d 594, 603, 118 USPQ2d 1632, 1637 (Fed. Cir.2016) ("While each trademark must always be evaluated individually, pluralization commonly does not alter the meaning of a mark."); *In re Hotels.com, L.P.,* 573 F.3d 1300, 91 USPQ2d 1532, 1535 (Fed. Cir. 2009) (dictionary and other evidence of meaning of "hotel" sufficed to show that the plural form in HOTELS.COM was generic for the information and reservation services at issue).

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 Cordua Rests., Inc.,* 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir.2016) (CHURRASCOS generic for restaurant services); *In re Nordic Naturals, Inc.,* 755 F.3d 1340, 111 USPQ2d 1495 (Fed. Cir. 2014) (CHILDREN'S DHA generic for "nutritional supplements containing DHA"); *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) (holding THE BEST BEER IN AMERICA for beer and ale 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 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, generic for ring cake mix); *Frito-Lay N. Am., Inc. v. Princeton Vanguard, LLC,* 124 USPQ2d 1184 (TTAB 2017) (PRETZEL CRISPS held generic for pretzel crackers), civil action filed, No. 3:17-cv-00652-RJC-DSC (W.D.N.C.); *In re Empire Tech, Dev. LLC,* 123 USPQ2d 1544 (TTAB 2017) (COFFEE FLOUR held generic for flour made from coffee cherry skins, pulp, and pectin); *In re Emergency Alert Sols. Grp., LLC,* 122 USPQ2d 1088 (TTAB 2017) (LOCKDOWN ALARM held generic for training services in the field of safety, security, and crisis preparedness); *In re Meridian Rack & Pinion,* 114 USPQ2d 1462 (TTAB 2015) (BUYAUTOPARTS.COM held generic for "on-line retail store services featuring auto parts"); *In re ActiveVideo Network, Inc.,* 111 USPQ2d 1581 (TTAB2014) (CLOUDTV held generic for software, non-downloadable software, broadcasting television programs, providing telecommunication

connectivity services, and provision of audiovisual and multimedia content); *Sheetz of Del., Inc. v. Doctor's Assocs. Inc.*, 108 USPQ2d 1341 (TTAB 2013) (FOOTLONG held generic for sandwiches, excluding hot dogs); *In re Greenliant Sys., Ltd.*, 97 USPQ2d 1078 (TTAB 2010) (NANDRIVE generic for electronic integrated circuits that include high-speed solid state flash memory drives); *In re Wm. B. Coleman Co., Inc.,* 93 USPQ2d 2019 (TTAB 2010) (ELECTRIC CANDLE COMPANY generic for "light bulbs; lighting accessories, namely, candle sleeves; lighting fixtures"); *In re Tires, Tires, Tires, Inc.*, 94 USPQ2d 1153 (TTAB2009) (TIRES TIRES TIRES generic for retail tire store services); *Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549 (TTAB2009) (product design configurations of "the body portion of a guitar" generic for "guitar bodies"); *In re Noon Hour Food Prods., Inc.*, 88 USPQ2d 1172 (TTAB2008) (BOND-OST held generic for cheese); *In re Rosemount, Inc.*, 86 USPQ2d 1436 (TTAB2008) (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 generic for "retail store services featuring contact eyewear products rendered via a global computer network"); *In re Active Ankle Sys., Inc.*, 83 USPQ2d 1532 (TTAB2007) (DORSAL NIGHT SPLINT generic for "orthopedic splints for the foot and ankle"); *In re Int'l Bus. Machs. 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 Grp.*, 81 USPQ2d 1392 (TTAB2006) (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 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 (TTAB2005) (SPORTSBETTING.COM 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 & Drapery, Inc.*, 74 USPQ2d 1037 (TTAB2005) (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 (TTAB2003) (CELL THERAPEUTICS INC. generic for pharmaceutical preparations and laboratory research and development services); *In re Am. Inst. of Certified Pub. Accountants*, 65 USPQ2d 1972 (TTAB2003) (CPA EXAMINATION generic for "printed matter, namely, practice accounting examinations; accounting exams; accounting exam information booklets; and prior accounting examination questions and answers"); *In re Am. Acad. of Facial Plastic & Reconstructive Surgery*, 64 USPQ2d 1748 (TTAB 2002) (FACIAL PLASTIC SURGERY 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); *Cont'l 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 Commc'ns*, 49 USPQ2d 1478 (TTAB1998) (WEB COMMUNICATIONS generic for consulting services to businesses seeking to establish sites on a global computer network); *In re Cent. Sprinkler Co.*, 49 USPQ2d 1194 (TTAB 1998) (ATTIC generic for sprinklers installed primarily in attics); *In re Stanbel Inc.*, 16 USPQ2d 1469 (TTAB1990), *aff'd*, 20 USPQ2d 1319 (Fed. Cir. 1991) (ICE PAK for reusable ice substitute for use in food and beverage coolers held generic); *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 Mortg. Bankers Ass'n of Am.*, 226 USPQ 954 (TTAB1985) (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"); *Shammas v. Rea*, 978 F. Supp. 2d 599, 614 (E.D. Va. 2013) (PROBIOTIC found generic for a type of fertilizer).

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 Am. Fertility Soc'y*, 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. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986) (FIRE CHIEF not generic for publications); *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1482-97 (TTAB 2017) (finding that the evidence of record tended to show that TEQUILA has significance as a designation of geographic origin and thus opposer failed to establish by a preponderance of the evidence that the term is generic); *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750 (TTAB 2013) (ANNAPOLIS TOURS, with TOURS disclaimed, not generic for "conducting guided tours of historic districts and other areas of cities," but cancellation granted on ground that mark was merely descriptive and had not acquired distinctiveness); *Baroness Small Estates, Inc. v. Am. Wine Trade, Inc.*, 104 USPQ2d 1224, 1229 (TTAB2012) (CMS not generic acronym for "wine" made from the grape varietals cabernet, merlot, and syrah; the Board noted that "the fact that a term is derived from individual generic words or even a listing of generic words does not necessarily make the derived term generic"); *In re Tennis Indus. Ass'n*, 102 USPQ2d 1671 (TTAB2012) (TENNIS INDUSTRY ASSOCIATION not generic for "association services, namely, promoting the interests of tennis facilities, tennis manufacturers, tennis retailers and tennis court contractors; providing market research services to track the economic vitality of the tennis industry," but applicant failed to prove that the mark had acquired distinctiveness); *In re Country Music Ass'n*, 100 USPQ2d 1824 (TTAB2011) (COUNTRY MUSIC ASSOCIATION, with ASSOCIATION disclaimed, not generic for "association services, namely, promoting country music entertainers and the country music recording industry"; evidence submitted by applicant held sufficient to demonstrate acquired distinctiveness under §2(f)); *In re Am. Online, Inc.*, 77 USPQ2d 1618 (TTAB2006) (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. Nat'l Ass'n of Realtors*, 70 USPQ2d 1425 (TTAB2004) (collective service marks REALTOR and REALTORS not generic for real estate brokerage, management, appraisal, and planning services); *In re Federated Dept. Stores Inc.*, 3 USPQ2d 1541 (TTAB1987) (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 Publ'g Co. v. Caulfield Publ'g Ltd.*, 1 USPQ2d 1996 (TTAB1986) (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 Assocs.*, 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 meaning of the mark or the nature of the goods or services. 37 C.F.R. §2.61(b); TMEP §814; *seeIn re AOP LLC*, 107 USPQ2d 1644, 1650-51 (TTAB2013). This would be especially appropriate for goods or services where the meaning of the mark or the nature of the goods or services would be readily apparent only to someone knowledgeable in that field. 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 Am. Psychological Ass'n*, 39 USPQ2d 1467, 1469 (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 (TTAB2006). If the examining attorney refuses registration, he or she must support the refusal with appropriate evidence. *See generally In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087 (Fed. Cir. 2005) (finding a press release cited by the examining attorney relevant to show the public's perception of the goods in an intent-to-use application).

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 asserted 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, the examining attorney should include a statement that the subject matter appears to be a generic name for the goods or services 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. Int'l 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 nonfinal 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 nonfinal Office action.

If the record is unclear as to whether the designation is capable of functioning as a mark, the examining attorney must 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), 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 must 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 must then issue a nonfinal action refusing registration on the Supplemental Register. The statutory basis for such a refusal is §§23(c) and 45 of the Trademark Act. *See*15 U.S.C. §§1091(c), 1127.

*See*TMEP §§815–816.05 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 §§714.05(a)(i) and 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 §§1, 2, and 45 (§§1, 2, 3, and 45 for service marks) 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 Publ'g Co. Inc.*, 23 USPQ2d 1876, 1877 n.2 (TTAB1992) :

> 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 & 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 Publ'ns Inc. v. Redbook Publ'g 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. *See In re Country Music Ass'n*, 100 USPQ2d 1824, 1834 (TTAB2011) (interpreting the examining attorney's silence on the sufficiency of the evidence submitted in support of applicant's claim of acquired distinctiveness "as a concession that, if the term is not generic, the record evidence is sufficient to show acquired distinctiveness under Section 2(f)"). *Compare 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 nonfunctional.

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 §§1212–1212.10 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 Am. Acad. of Facial Plastic & 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 Trademark Act §§1, 2, and 45, for trademarks, and §§1, 2, 3, and 45, for service marks, on the basis that the mark is generic and stating that the claim of acquired distinctiveness is insufficient to overcome the refusal. *See*15 U.S.C. §§1051, 1052, 1053, 1127. 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 §§1, 2, and 45, or §§1, 2, 3, and 45, on the ground that the mark is generic, the descriptiveness refusal under §2(e)(1), 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,* 73 USPQ2d 1883 (TTAB 2004); *In re Am. Acad. of Facial Plastic & 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. *SeeIn re Country Music Ass'n*, 100 USPQ2d 1824, 1834 (TTAB2011) (interpreting the examining attorney's silence on the sufficiency of the evidence submitted in support of applicant's claim of acquired distinctiveness "as a concession that, if the term is not generic, the record evidence is sufficient to show acquired distinctiveness under Section 2(f)"). *CompareIn re Dietrich*, 91 USPQ2d 1622, 1625 (TTAB2009) , 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 nonfunctional.

See TMEP §§1212–1212.10 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 or genericness. Each case must stand on its own merits, and a mark that is merely descriptive or generic does not become registrable simply because other seemingly similar marks appear on the register. *In re Consumer Prot. Firm PLLC*, 2021 USPQ2d 238, at *22 (TTAB 2021) (citing *In re Scholastic Testing Serv., Inc.*, 196 USPQ 517, 519 (TTAB 1977)). The question of whether a mark is merely descriptive or generic must be determined based on the evidence of record at the time registration is sought. *In re Consumer Prot. Firm PLLC*, 2021 USPQ2d 238, at *22 (citing *In re theDot Commc'ns Network LLC*, 101 USPQ2d 1062, 1064 (TTAB 2011)) (holding THE CONSUMER PROTECTION FIRM generic for legal services where the Board found third-party registrations presented dissimilar circumstances); *see In re Nett Designs Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (holding ULTIMATE BIKE RACK merely descriptive of "bicycle racks" despite the presence of "ultimate" without a disclaimer in other marks on the Principal Register); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) (holding AGENTBEANS merely descriptive of computer software for use in software development and deployment where the Board found that changes in the vocabulary of the field reduced the relevance of third-party registrations).

1209.03(b) 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 Hikari Sales USA, Inc.*, 2019 USPQ2d 111514, at *1, *8 (TTAB 2019) (citing *In re ActiveVideo Networks, Inc.*, 111 USPQ2d 1581, 1603 (TTAB 2014); *In re Dairimetics, Ltd.*, 169 USPQ 572, 573 (TTAB 1971)) (holding ALGAE WAFERS merely descriptive of fish food although the term was not found in the dictionary); *In re Orleans Wines, Ltd.*, 196 USPQ 516, 516-17 (TTAB 1977) (holding BREADSPRED merely descriptive of jellies and jams although the term was not found in the dictionary).

Moreover, in terms of establishing a term's likely meaning to consumers, evidence of current usage may carry more weight than dictionary evidence. *See In re Well Living Lab Inc.*, 122 USPQ2d 1777, 1781 (TTAB 2017) (finding modern-day usage of "well-living" more significant than dictionary definition).

1209.03(c) First or Only User

The fact that an applicant may be the first and only user of a merely descriptive designation does not justify registration if the only significance conveyed by the term is merely descriptive. *See In re Zuma Array Ltd.*, 2022 USPQ2d 736, at *16-17 (TTAB 2022); *In re Fallon*, 2020 USPQ2d 11249, at *11 (TTAB 2020); *In*

re Fat Boys Water Sports LLC, 118 USPQ2d 1511, 1514 (TTAB2016); *In re Nat'l Shooting Sports Found., Inc.*, 219 USPQ 1018, 1020 (TTAB 1983); *see also KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 122, 72 USPQ2d 1833, 1838 (2004) (trademark law does not countenance someone obtaining "a complete monopoly on use of a descriptive term simply by grabbing it first"); *Clairol, Inc. v. Roux Distrib. Co.*, 280 F.2d 863, 865, 126 USPQ2d 397, 398 (C.C.P.A. 1960) (even novel ways of referring to the goods may nonetheless be descriptive). Likewise, the fact that an applicant may be the first or only user of a generic designation does not justify registration if the only significance conveyed by the term is that of a category of goods. *In re Empire Tech, Dev. LLC*, 123 USPQ2d 1544, 1549 (TTAB 2017) (citing *In re Greenliant Systems Ltd.*, 97 USPQ2d 1078, 1083 (TTAB 2010)); *see alsoIn re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 1569, 4 USPQ2d 1141, 1142 (Fed. Cir.1987)("To allow trademark protection for generic terms, *i.e.*, names which describe the genus of goods being sold, even when these have become identified with a first user, would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are."); *In re Preformed Prods. Co.*, 323 F.2d 1007, 1008, 139 USPQ 271, 273 (C.C.P.A. 1963) (quoting *J. Kohnstam, Ltd. v. Louis Marx & Co.*, 280 F.2d 437, 440 (C.C.P.A. 1960))(exclusive use, even when coupled with "large sales volume of such goods and its substantial advertising expenditure . . . cannot take the common descriptive name of an article out of the public domain and give the temporarily exclusive user of it exclusive rights to it, no matter how much money or effort it pours into promoting the sale of the merchandise"); TMEP §1212.06(e)(i).

1209.03(d) Combined Terms

When two or more descriptive terms are combined, the determination of whether the composite mark also has a descriptive significance turns on whether the combination of terms evokes a new and unique commercial impression. *See In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1174-75, 71 USPQ2d 1370, 1372 (Fed. Cir. 2004) (citing *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985)) ("[T]he PTO must . . . determine whether the mark as a whole, i.e., the combination of the individual parts, conveys any distinctive source-identifying impression contrary to the descriptiveness of the individual parts."); *In re Omniome, Inc.*, 2020 USPQ2d 3222, at *4 (TTAB 2019) (citing *In re Colonial Stores Inc.*, 394 F.2d 549, 551-52, 157 USPQ 382, 384 (C.C.P.A. 1968); *In re Shutts*, 217 USPQ 363, 364-65 (TTAB 1983)) ("A mark comprising a combination of merely descriptive components is registrable only if the combination of terms creates a unitary mark with a non-descriptive meaning, or if the composite has a bizarre or incongruous meaning as applied to the goods or services.").

If each component retains its descriptive significance in relation to the goods or services, the combination results in a composite that is itself descriptive. *DuoProSS Meditech Corp. v. Inviro Medical Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753 (Fed. Cir. 2012) (SNAP SIMPLY SAFER merely descriptive of "medical devices, namely, cannulae; medical, hypodermic, aspiration and injection needles; medical, hypodermic, aspiration and injection syringes"); *In re Oppedahl & Larson LLP*, 373 F.3d at 1171, 71 USPQ2d at 1370 (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, 1111–12 (Fed. Cir. 1987) (SCREENWIPE generic as applied to premoistened antistatic cloths for cleaning computer and television screens); *In re Zuma Array Ltd.*, 2022 USPQ2d 736, at *7, *16 (TTAB 2022) (SMART BEZEL merely descriptive of electronic sensor modules for controlling and integrating home automation systems); *In re Fallon*, 2020 USPQ2d 11249, at *12 (TTAB 2020) (THERMAL MATRIX merely descriptive of a heat-responsive, malleable liner that is an integral component of an oral dental appliance); *In re Omniome, Inc.*, 2020 USPQ2d 3222, at *10-11 (SEQUENCING BY BINDING merely descriptive of various goods and services used to sequence DNA by the process of binding); *In re Nat'l Ass'n of Veterinary Technicians in Am., Inc.*, 2019 USPQ2d 269108, at *1, *5 (TTAB 2019) (VETERINARY TECHNICIAN SPECIALIST merely descriptive of "veterinary medicine services" provided by persons certified as having "completed the required curriculum of a defined body of veterinary

technology knowledge pertinent to that particular specialty"); *In re Mecca Grade Growers, LLC*, 125 USPQ2d 1950, 1955 (TTAB 2018) (MECHANICALLY FLOOR-MALTED merely descriptive of malt for brewing and distilling and processing of agricultural grain); *In re Positec Gr. Ltd.*, 108 USPQ2d 1161 (TTAB2013) (SUPERJAWS merely descriptive of a variety of machine and hand tools including jaws); *In re Petroglyph Games, Inc.*, 91 USPQ2d 1332 (TTAB2009) (BATTLECAM merely descriptive of computer game software); *In re Carlson*, 91 USPQ2d 1198 (TTAB2009) (URBANHOUZING merely descriptive of real estate brokerage, real estate consultation, and real estate listing services); *In re Leonhardt*, 109 USPQ2d 2091 (TTAB 2008) (BOBBLE POPS held merely descriptive of "candy," which the record showed was a lollipop candy featuring a bobble head device); *In re Cox Enters. Inc.*, 82 USPQ2d 1040 (TTAB2007) (THEATL – a compressed version of the term "THE ATL," a recognized nickname for the city of Atlanta – merely descriptive of printed matter of interest to residents of and tourists and visitors to Atlanta, Georgia); *In re King Koil Licensing Co.*, 79 USPQ2d 1048 (TTAB 2006) (THE BREATHABLE MATTRESS 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 (TTAB2006) (SMARTSFP merely descriptive of optical transceivers), *aff'd per curiam*, 223 Fed. App'x 984 (Fed. Cir. 2007); *In re Tower Tech, Inc.*, 64 USPQ2d 1314 (TTAB2002) (SMARTTOWER merely descriptive of "commercial and industrial cooling towers and accessories therefor, sold as a unit"); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB2001) (AGENTBEANS merely descriptive of computer software for use in development and deployment of application programs on global computer network); *In re Putman Publ'g Co.*, 39 USPQ2d 2021 (TTAB1996) (FOOD & BEVERAGE ONLINE merely descriptive of news and information service for the food processing industry); *In re Copytele Inc.*, 31 USPQ2d 1540 (TTAB1994) (SCREEN FAX PHONE merely descriptive of "facsimile terminals employing electrophoretic displays"); *In re Entenmann's Inc*., 15 USPQ2d 1750 (TTAB1990) (OATNUT merely descriptive of bread containing oats and hazelnuts), *aff'd per curiam*, 928 F.2d 411 (Fed. Cir. 1991); *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 at 549, 157 USPQ at 382 (SUGAR & SPICE held not merely descriptive of bakery products); *In re Shutts*,217 USPQ at 363 (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, 1958 (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 Int'l Bus. Machs. Corp.*, 81 USPQ2d 1677, 1679 (TTAB2006) ("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 (TTAB2000) (E FASHION merely descriptive of software used to obtain beauty and fashion information, and for electronic retailing services); *Cont'l Airlines Inc. v. United Airlines Inc*., 53 USPQ2d 1385 (TTAB 1999) (E-TICKET generic as applied to 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 (TTAB2000) (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 Integrated Embedded*, 120 USPQ2d 1504,1507 (TTAB 2016) ("The addition of the disclaimed term GROUP to Applicant's mark . . . is incapable of lending source-identifying significance to the mark."); *In re Cell Therapeutics Inc.*, 67 USPQ2d 1795 (TTAB2003) (CELL THERAPEUTICS INC. generic for pharmaceutical preparations and laboratory research and development services); *In re Taylor & Francis [Publishers] Inc.*, 55 USPQ2d 1213, 1215 (TTAB2000) ("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 Pat. & Trademark Servs. Inc.*, 49 USPQ2d 1537 (TTAB1998) (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 Paint Prods. Co*., 8 USPQ2d 1863, 1866 (TTAB1988) ("'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 E. I. Kane, Inc.*, 221 USPQ 1203, 1205 (TTAB1984) ("The addition of the term 'INC.' does not add any trademark significance to the matter sought to be registered. The complete term 'OFFICE MOVERS, INC.' is so highly descriptive that it is incapable of distinguishing applicant's services [which included "moving services, namely the moving of office facilities"]."). *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. *In re Omniome, Inc.*, 2020 USPQ2d 3222, at *10 (TTAB 2019) (citing *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979)). Therefore, the fact that a term may have a different meaning(s) in a different context is not controlling. *Id.*; *seeIn re RiseSmart Inc*., 104 USPQ2d 1931, 1933 (TTAB2012) (citing *In re Chopper Indus*., 222 USPQ 258, 259 (TTAB1984)); *In re Bright-Crest, Ltd.*, 204 USPQ at 593. If a term has a primary significance that is descriptive in relation to at least one of the recited goods or services, and does not create any double entendre or incongruity, then the term is merely descriptive. *See, e.g., In re Calphalon Corp.*, 122 USPQ2d 1153, 1164 (TTAB 2017) (finding nothing incongruous about the use of the word sharpen (or its phonetic equivalent SHARPIN) to describe the function of knife blocks with built-in sharpeners that automatically sharpen knives).

*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 Trademark Act, just as a merely descriptive word would be. *See In re Underwater Connections, Inc.*, 221 USPQ 95, 95 (TTAB 1983) (holding pictorial representation of a compressed air gas tank merely descriptive of travel-tour services involving underwater diving); *In re Eight Ball, Inc*., 217 USPQ 1183, 1184 (TTAB1983) (holding the mark comprising a pictorial representation of a cue stick and eight ball to be merely descriptive of applicant's billiard parlor services); *Thistle Class Ass'n v. Douglass & McLeod, Inc*., 198 USPQ 504, 511-12 (TTAB 1978) (holding the pictorial representation of a thistle in the mark to be merely descriptive of the class of sailboats sold by applicant); *See also In re Soc'y for Priv. & Com. Earth Stations*, 226 USPQ 436, 438 (TTAB1985) (holding representation of earth station merely descriptive of services of an association promoting the interests of members of the earth-station industry). *But see In re LRC Prods., Ltd.*, 223 USPQ 1250 (TTAB 1984) (stylized hand design found not merely an illustration of the goods, i.e., gloves; thus not held merely descriptive).

Similarly, when a mark is comprised of wording that is descriptive under §2(e)(1) and a design element that is a pictorial representation of the goods, or that reinforces the descriptive meaning of the wording, the entire mark is merely descriptive. *See, e.g.*, *DuoProSS Meditech Corp. v. Inviro Med. Devices Ltd.*, 695 F3d 1247,1255, 103 USPQ2d 1753, 1758 (Fed. Cir. 2012) (finding that the combination of the term SNAP and the design of a broken exclamation point, viewed as a whole, would be perceived as depicting the snapping of a syringe plunger, which is used in connection with various medical syringes); *Robinson v. Hot Grabba Leaf, LLC*, 2019 USPQ2d 149089, at *8 (TTAB 2019) (finding that the design of a tobacco leaf combined with the wording GRABBA LEAF, viewed as a whole, would be perceived as conveying applicant's cigar wrap could be used as a tobacco leaf to wrap grabba tobacco or that grabba leaf tobacco was an ingredient in the wraps); I *n re Swatch Grp. Mgmt. Servs. AG*, 110 USPQ2d 1751, 1762 (TTAB 2014) (finding that the design element depicting a tourbillon - a watch component - combined with the word TOURBILLON reinforced the singular impression conveyed by the mark as a whole as merely descriptive for "jewellery, horological and chronometric instruments"), *aff'd per curiam*, 599 Fed. Appx. 959 (Fed. Cir. 2015).

1209.03(g) Foreign Equivalents

The foreign equivalent of a merely descriptive English word is no more registrable than the English word itself. "[A] word taken from a well-known foreign modern language, which is, itself, descriptive of a product, will be so considered when it is attempted to be registered as a trade-mark in the United States for the same product." *In re N. Paper Mills*, 64 F.2d 998, 998, 17 USPQ 492, 493 (C.C.P.A.1933) ; *seeIn re Tokutake Indus. Co.*, 87 USPQ2d 1697 (TTAB2008) (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 (TTAB1986) (Chinese characters that mean ORIENTAL DAILY NEWS held merely descriptive of newspapers); *In re Geo. A. Hormel & Co.*, 227 USPQ 813 (TTAB1985) (SAPORITO, an Italian word meaning "tasty," held merely descriptive because it describes a desirable characteristic of applicant's dry sausage).

Under the doctrine of foreign equivalents, foreign words from common, modern languages are translated into English; however, the doctrine is not an absolute rule, but merely a guideline. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1377, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005) (citing *In re Sarkli, Ltd.*, 721 F.2d 353, 354, 220 USPQ 111, 113 (Fed. Cir. 1983); *In re Am. Safety Razor Co.*, 2 USPQ2d 1459, 1460 (TTAB 1987)). The doctrine should be applied only when it is likely that the ordinary American purchaser would stop and translate the foreign wording into its English equivalent. *See id.* (citing *In re Tia Maria, Inc.*, 188 USPQ 524, 525-26 (TTAB 1975)); *see also In re*

Highlights for Child., Inc., 118 USPQ2d 1268, 1271 (TTAB 2016) (citing *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1127 (TTAB 2015)) (noting that the doctrine of foreign equivalents applies even when the foreign wording in the mark will appear with its English equivalent, because ordinary purchasers will still recognize the terms as equivalents due to the provided translation). Thus, an examining attorney will generally apply the doctrine when the relevant English translation is literal and direct, the term comes from a common, modern language, and there is no contradictory evidence of another relevant meaning. *SeeIn re Sadoruo Grp. Ltd.*, 105 USPQ2d 1484, 1485 (TTAB2012). "The 'ordinary American purchaser' in this context refers to the ordinary American purchaser who is knowledgeable in the foreign language. . . . [Defining "ordinary American purchaser" as the "average American buyer"] would write the doctrine out of existence." *In re Thomas*, 79 USPQ2d 1021, 1024 (TTAB2006). 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); *In re S. Malhotra & Co. AG*, 128 USPQ2d 1100, 1103 (TTAB 2018) (quoting *In re Highlights for Child., Inc.*, 118 USPQ2d at 1271).

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, 443, 54 USPQ2d 1497, 1499 (5th Cir. 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 (TTAB1988) (holding LA YOGURT for yogurt registrable on the Principal Register with a disclaimer of YOGURT); *In re Sweet Victory, Inc.*, 228 USPQ 959 (TTAB1986) (holding GLACÉ LITE not merely descriptive for ice creams, sherbets, frozen yogurts, and nondairy frozen desserts because the combination of the French word GLACÉ with the English word LITE makes the expression somewhat incongruous); *In re Universal Package Corp.*, 222 USPQ 344 (TTAB 1984) (holding LE CASE not merely descriptive of jewelry boxes and gift boxes and registrable on the Principal Register with a disclaimer of CASE).

*See*TMEP §§809–809.03 for information regarding how to determine the meaning of non-English wording in a mark. *See also*TMEP §§1207.01(b)(vi)–(b)(vi)(C), §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. *See Modern Optics Inc. v. The Univis Lens Co.*, 234 F. 2d 504, 506, 110 USPQ 293, 295 (C.C.P.A. 1956); *Baroness Small Estates, Inc. v. Am. Wine Trade, Inc.*, 104 USPQ2d 1224, 1230-31 (TTAB2012) (holding CMS not substantially synonymous with the grape varietals cabernet, merlot, and syrah and therefore not merely descriptive for wine); *In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1715 (TTAB2011) (holding

NKJV substantially synonymous with merely descriptive term "New King James Version" and thus merely descriptive of bibles). A mark consisting of an abbreviation, initialism, or acronym will be considered substantially synonymous with descriptive wording if: (1) the applied-for mark is an abbreviation, initialism, or acronym for specific wording; (2) the specific wording is merely descriptive of applicant's goods and/or services; and (3) a relevant consumer viewing the abbreviation, initialism, or acronym in connection with applicant's goods and/or services will recognize it as an abbreviation, initialism, or acronym of the merely descriptive wording that it represents. *See In re Thomas Nelson, Inc.*, 97 USPQ2d at 1715-16 (citing *In re Harco Corp.*, 220 USPQ 1075, 1076 (TTAB1984)). 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. *Modern Optics*, 234 F.2d 504, 506, 110 USPQ 293, 295 (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 (TTAB2008) (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 Publ'g Co. v. Caulfield Publ'g Ltd.*, 1 USPQ2d 1996 (TTAB1986) (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 In re Calphalon Corp.*, 122 USPQ2d 1153, 1164 (TTAB 2017) (holding SHARPIN, the phonetic equivalent of "sharpen," merely descriptive of knife blocks with built-in sharpeners); *In re ING Direct Bancorp*, 100 USPQ2d 1681, 1690 (TTAB2011) (holding PERSON2PERSON PAYMENT generic for direct electronic funds transfers including electronic payment services between individuals); *In re Carlson*, 91 USPQ2d 1198, 1203 (TTAB 2009) (holding 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, 1475 (TTAB2007) ("The generic meaning of 'togs' is not overcome by the misspelling of the term as TOGGS. . ."); *In re Hubbard Milling Co.*, 6 USPQ2d 1239 (TTAB1987) (holding MINERAL-LYX generic for mineral licks for feeding livestock); *C-Thru Ruler Co. v. Needleman*, 190 USPQ 93 (E.D. Pa. 1976) (holding C-THRU to be the equivalent of "see-through" and, therefore, merely descriptive of transparent rulers and drafting aids).

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 Duopross Meditech Corp. v. Inviro Medical Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1759 (Fed. Cir. 2012) (finding SNAP SIMPLY SAFER merely descriptive for "medical devices, namely, cannulae; medical, hypodermic, aspiration and injection needles; medical, hypodermic, aspiration and

injection syringes"); *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001) (finding THE ULTIMATE BIKE RACK 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) (finding 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 Positec Group Ltd.*, 108 USPQ2d 1161, 1172 (TTAB2013) (applying the guidance set forth in *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1052 (TTAB2002), the Board found SUPERJAWS to be merely descriptive for a variety of machine and hand tools including jaws); *In re Phillips-Van Heusen Corp.*, 63 USPQ2d at 1052 (concluding that "if the word 'super' is combined with a word which names the goods or services, or a principal component, grade or size thereof, then the composite term is considered merely descriptive of the goods or services, but if such is not strictly true, then the composite mark is regarded as suggestive of the products or services."); *In re Best Software Inc.*, 58 USPQ2d 1314 (TTAB2001) (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); *Gen. 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 must refuse registration under §2(e)(1). *See In re Page*, 51 USPQ2d 1660 (TTAB1999) (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 Mortg. Brokers Inc. v. Simpson Mortg. Inc.*, 31 USPQ2d 1371, 1374 (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 §§1202–1202.16 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 Assocs. 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) indicate an address on the world wide web, and, therefore, generally serve no source-indicating function. *See*TMEP §1215 regarding marks composed of domain names.

If a TLD has three or more characters, it is known as a "generic top-level domain" or "gTLD." However "generic" in this term does not refer to genericness in the trademark sense. The gTLD typically signifies the type of entity using the domain name. For example, the gTLD ".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. These types of gTLDs, which merely indicate the type of entity using the gTLD, must be treated as non-source-indicating. Further, as the number of available gTLDs is increased by the Internet Corporation for Assigned Names and Numbers ("ICANN"), or if the nature of new gTLDs changes, the examining attorney must consider any potential source-indicating function of the gTLD and introduce evidence as to the significance of the gTLD. *See* TMEP §§1215.02(d)(d)(iv) regarding marks comprised solely of gTLDs for domain registry operator and domain name registrar services and **www.icann.org** for information about gTLDs. *Cf.In re theDot Commc'ns Network LLC*, 101 USPQ2d 1062, 1067 (TTAB2011) (finding ".music conveys the commercial impression of a top-level domain name similar to .com, .net, etc.," and that consumers would understand it to be a TLD in the field of music based on the current marketing environment which included evidence of a concerted effort to obtain TLD status for .music).

Because gTLDs generally indicate the type of entity using a given domain name, and therefore serve no source-indicating function, their addition to an otherwise unregistrable mark typically cannot render it registrable. *Booking.com B.V. v. USPTO*, 915 F.3d 171, 185 (4th Cir. 2019), *aff'd, USPTO v. Booking.com B.V.*, 140 S. Ct. 2298, 2304, 2020 USPQ2d 10729, at *2 (2020) ("Where the proposed mark is a composite that includes .com, we clarify that. . . .com does not itself have source-identifying significance when added to an [a second-level domain] like booking."); *see also 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," and applicant "presented no evidence that '.com' evoked anything but a commercial internet domain"); *In re Microsoft Corp.*, 68 USPQ2d 1195, 1203 (TTAB2003) ("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 (TTAB2002) ("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.").

However, there is no bright-line, per se rule that the addition of a gTLD to an otherwise descriptive mark will never, under any circumstances, operate to create a registrable mark. *See In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1175, 71 USPQ2d 1370, 1374 (Fed. Cir. 2004). In rare instances, the addition of a gTLD 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.

*Cf.*TMEP §1215.02(d). Additionally, the Federal Circuit has cautioned that in rare, exceptional circumstances, a term that is generic by itself may acquire some additional meaning from the addition of a non-source-indicating gTLD such as ".com" or ".net." *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005) (citing *Oppedahl & Larson*, 373 F.3d at 1175–76, 71 USPQ2d at

1373) (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).

Thus, when examining domain-name marks, it is important to evaluate the commercial impression of the mark as a whole to determine whether the gTLD may be capable of source-indicating significance, and whether the composite mark conveys to consumers a source-identifying impression apart from its individual components. *Booking.com*, 140 S. Ct. at 2307, 2020 USPQ2d 10729, at *7. The examining attorney must introduce evidence as to the significance of the individual components, including the gTLD, but must also consider the significance of the composite to determine whether the addition of a gTLD has resulted in a composite that is capable of distinguishing the applicant's goods or services and indicating their source. *See In re 1800Mattress.com*, 586 F.3d at 1359, 92 USPQ2d at 1682 (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, L.P.*, 573 F.3d 1300, 91 USPQ2d 1532 (Fed. Cir. 2009) (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 providing online gaming services and information about sports and gaming, with the Board finding that "applicant's own website uses the expression 'sports betting,' e.g., touting itself as 'the leader in online sports betting' and providing tips on 'sports betting' as a game of skill. Furthermore, as the Trademark Examining Attorney has demonstrated in this record, other entities competing with applicant also use the term 'sports betting' (and 'sportsbetting') in generic fashion in describing their wagering and information services").

*See*TMEP §1215.04 and §1215.05 regarding of gTLDs 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 for ice cream); *In re Wileswood, Inc.*, 201 USPQ 400 (TTAB 1978) (AMERICA'S BEST POPCORN! and AMERICA'S FAVORITE POPCORN! merely descriptive of unpopped popcorn). 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 In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217 (Fed. Cir. 2012) (NATIONAL CHAMBER merely descriptive of nationwide online directory services featuring information regarding local and state chambers of commerce and business and regulatory data analysis services for nationally promoting the interests of businesspersons or industry); *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 Nat'l Rent A Fence, Inc.*, 220 USPQ 479 (TTAB1983) (NATIONAL RENT A FENCE merely descriptive of nationwide fence rental services); *BankAmerica Corp. v. Int'l Travelers Cheque Co.*, 205 USPQ 1233 (TTAB1979) (INTERNATIONAL TRAVELERS CHEQUE merely descriptive of financial consulting services that are international in scope); *Nat'l Fid. Life Ins. v. Nat'l Ins. Trust*, 199 USPQ 691 (TTAB1978) (NATIONAL INSURANCE TRUST merely descriptive of services of handling administrative matters in locating suitable insurance coverage for attorneys); *Jefferson Bankshares Inc. v. Jefferson Sav. Bank*, 14 USPQ2d 1443, 1447 (W.D. Va. 1989) (NATIONAL BANK merely descriptive of banking services); *Nat'l Auto. Club v. Nat'l 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).

The terms "GLOBAL" and "WORLDWIDE" are also considered to be merely descriptive of services that are global or worldwide in scope.

Note: A map of the world or a depiction of a globe generally is not considered the pictorial equivalent of the terms "INTERNATIONAL," "GLOBAL," or "WORLDWIDE."

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. *See, e.g., In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) (SCREENWIPE generic for an anti-static cloth used for cleaning computer and television screens); *In re Zuma Array Ltd.*, 2022 USPQ2d 736, at *1-2, *15-17 (TTAB 2022) (SMART BEZEL merely descriptive of electronic sensor modules for controlling and integrating home automation systems in which the sensor modules were to be used on bezels); *In re Box Solutions Corp.*, 79 USPQ2d 1953 (TTAB2006) (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 (TTAB2006) (ERGONOMIC merely descriptive of ceiling fans); *In re Cent. Sprinkler Co.*, 49 USPQ2d 1194 (TTAB 1998) (ATTIC generic for sprinklers installed primarily in attics); *In re Reckitt & Colman, N. Am. Inc.*, 18 USPQ2d 1389 (TTAB1991) (PERMA PRESS generic for soil and stain removers for use on permanent press products); *In re Wallyball, Inc*., 222 USPQ 87 (TTAB1984) (WALLYBALL descriptive of sports clothing and game equipment); *In re Nat'l Presto Indus., Inc.*,197 USPQ 188 (TTAB 1977) (BURGER merely descriptive of cooking utensils); *In re Orleans Wines, Ltd*., 196 USPQ 516 (TTAB1977) (BREADSPRED 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 also be merely descriptive under §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1) or generic of the goods or services. *See, e.g., In re Wm. B. Coleman Co.*, 93 USPQ2d 2019, 2027 (TTAB2010) (ELECTRIC CANDLE COMPANY for lighting

fixtures "incapable of identifying source for electric candles because it is a term a purchaser would understand and could use to refer to the type of company that sells electric candles, and must be left available for use by other such companies selling electric candles"); *In re Major League Umpires*, 60 USPQ2d 1059 (TTAB2001) (MAJOR LEAGUE UMPIRE merely descriptive of clothing, face masks, chest protectors, and shin guards provided, designed, and used by major league umpires); *In re Taylor & Francis [Publishers] Inc.*, 55 USPQ2d 1213 (TTAB2000) (PSYCHOLOGY PRESS merely descriptive of books in the field of psychology); *In re Paint Prods. Co.*, 8 USPQ2d 1863 (TTAB1988) (PAINT PRODUCTS COMPANY incapable for paint); *In re Phone Co.*, 218 USPQ 1027 (TTAB1983) (THE PHONE COMPANY merely descriptive of telephones). *See also In re Omaha Nat'l Bank*, 819 F.2d 1117, 1119, 2 USPQ2d 1859, 1861 (Fed. Cir. 1987) (rejecting argument that descriptiveness should be limited to a quality or characteristic of the good or service itself and holding that it includes a designation descriptive of the service provider); *cf. In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1301-02, 102 USPQ2d 1217, 1220 (Fed. Cir. 2012) (NATIONAL CHAMBER held descriptive of "traditional chambers of commerce activities" of "promoting the interests of businessmen and businesswomen").

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. *See, e.g., 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 & 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 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 in the application, 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. *See 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 also*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. *SeeIn 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 Duopross Meditech Corp. v. Inviro Medical Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757-58 (Fed. Cir. 2012) (finding SNAP!, with a broken exclamation point, merely descriptive of medical syringes using snap-off plungers); *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) (finding that the presence of 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, 1305 (TTAB 2006) (finding that the exclamation mark in the mark PARTY AT A DISCOUNT! "simply emphasize[d] the descriptive nature of the mark" for advertising services in the field of private party venues); *In re S.D. Fabrics, Inc.*, 223 USPQ 54 (TTAB 1984), *reopening denied* 223 USPQ 56 (1984) (finding that the presence of a 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).

1209.03(v) Key Aspect or Subcategory of Goods or Services

A term may be generic for a genus of goods or services if the relevant public understands the term to refer to a key aspect of that genus, such as a key product that characterizes a particular genus of retail services or identifies a category of goods or services within the genus. *See Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 1368, 127 USPQ2d 1041, 1047 (Fed. Cir. 2018) (directing the Board to consider whether the relevant public understands the term ZERO to refer to a key aspect of at least a sub-group or type of the claimed genus of beverages, which encompassed zero-calorie beverages as a sub-group); *In re Cordua Rests., Inc.*, 823 F.3d 594, 603-04, 118 USPQ2d 1632, 1637-38 (Fed. Cir. 2016) (finding substantial evidence supported the Board's conclusion that CHURRASCOS was generic because it referred to a key aspect of restaurant services featuring grilled meat); *In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 1361–63, 92 USPQ2d 1682, 1683-84 (Fed. Cir. 2009_(agreeing with the Board's determination that "mattress" was generic as applied to online retail mattress store services because the term identified a key aspect of the services); *In re Hotels.com, L.P.*, 573 F.3d 1300, 1304, 91 USPQ2d 1532, 1535 (Fed. Cir. 2009)(agreeing with the Board's determination that, when applied to information services and reservation services dealing

with hotels, the term "hotels" was generic because it named a key aspect of the services); *In re Twenty-Two Desserts, LLC*, 2019 USPQ2d 292782, at *5 (TTAB 2019) (holding MALAI, which refers to an Indian dairy ingredient, generic for applicant's frozen desserts because relevant consumers would understand it to refer to a key aspect or subcategory of the genus of the goods); *In re Emergency Alert Sols. Grp., LLC*, 122 USPQ2d 1088, 1091-93 (TTAB 2017) (holding LOCKDOWN ALARM generic because relevant customers would readily understand it to refer to a type of safety, security, and crisis preparedness training, noting that "[t]he subject matter of any training [was] not an insignificant 'facet' of the training," but "[was] quite literally the focus of the training"); *In re Cent. Sprinkler Co.*, 49 USPQ2d 1194, 1199 (TTAB 1998) (finding ATTIC generic for automatic sprinklers for fire protection because the term "directly names the most important or central aspect or purpose of applicant's goods" and would be understood by the relevant public as referring to a category of sprinklers); *In re Reckitt & Colman, N. Am. Inc.*, 18 USPQ2d 1389, 1391 (TTAB 1991) (finding PERMA PRESS generic for soil and stain removers for permanent press fabrics because "the term 'perma press' may be considered a term identifying a category of goods at issue—perma press products (including perma press soil and stain removers)"); *see also In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 1559-60, 227 USPQ 961, 963-64 (Fed. Cir. 1985) (affirming the Board's holding that BUNDT is generic for ring cake mix); *Shammas v. Rea*, 978 F. Supp. 2d 599, 609 (E.D. Va. 2013) (noting that a term "may be generic in connection with [goods] if the relevant public uses the term to refer to [the goods] generally, or if the term does nothing more than identify a distinctive characteristic of [the goods]").

1209.03(w) Stylization

Adding stylization to descriptive or generic wording does not render the resulting mark registrable on the Principal Register unless the stylization creates a commercial impression separate and apart from the impression made by the wording itself, or the applicant can otherwise show by evidence that the particular stylized display has acquired distinctiveness. *SeeIn re Cordua Rests., Inc.*, 823 F.3d 594, 606, 118 USPQ2d 1632, 1639-1640 (Fed. Cir. 2016); *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 1561, 227 USPQ 961, 964 (Fed. Cir. 1985).

If descriptive or generic wording is in fact presented in a distinctive display or design, the mark as a whole may be registered with a disclaimer of the unregistrable component. *SeeIn re Sadoru Grp., Ltd.*, 105 USPQ2d 1484, 1486-88 (TTAB 2012).

If generic wording is stylized to create a display or design that is not inherently distinctive, but is nonetheless capable of functioning as a mark, the mark may be registered on the Supplemental Register with a disclaimer of the generic wording. *SeeIn re Wella Corp.*, 565 F.2d 143, 144, 196 USPQ 7, 8 (C.C.P.A. 1977); *In re Sadoru Grp., Ltd.*, 105 USPQ2d at 1486-88; *In re Carolyn's Candies, Inc.*, 206 USPQ 356, 360-61 (TTAB 1980); TMEP §1213.03(b).

1209.03(x) Historical Figure Names and Fictional Character Names

The determination of whether a mark comprising the name of an historical figure or a fictional character serves as a source identifier or is merely descriptive turns on whether consumers link the mark to a particular commercial entity or whether others have a competitive need to use the name to describe their products. *See In re United Trademark Holdings, Inc.*, 122 USPQ2d 1796, 1799-1800 (TTAB 2017); *In re Carlson Dolls Co.*, 31 USPQ2d 1319, 1320 (TTAB 1994). Thus, the case law has drawn a distinction between situations where the applicant owns intellectual property rights in the work(s) from which the character arose and those where the character is a historical figure or is in the public domain. *In re United Trademark Holdings*, 122 USPQ2d at 1799.

The Board has held that consumers reasonably expect goods and services bearing the name or image of a fictional character that is a proprietary creation of a business entity to emanate from, or be produced or marketed under license from, the entity that created the character and owns the right to profit from commercialization of it. *In re Carlson Dolls*, 31 USPQ2d at 1320.

However, a mark that identifies an historical figure was found to be merely descriptive because consumers do not necessarily link such a name or image to particular commercial entities as they do a fictional character. *Id.* (finding "[t]he likely reaction of ordinary consumers presented with 'MARTHA WASHINGTON' on tags attached to 'historical dolls' made to look like women in colonial clothing would be that the name indicates not the commercial source of the dolls, but rather is used as a description of the historical figure the dolls are supposed to represent").

Likewise, prospective purchasers expect goods, such as dolls, labeled with the name of a fictional public-domain character to represent the character. *In re United Trademark Holdings*, 122 USPQ2d at 1799. Thus, a mark that identifies a fictional public-domain character used on goods such as dolls is merely descriptive because it describes the purpose or function of the goods. *Id*. (concluding that "dolls described as or named LITTLE MERMAID refer to the fictional public domain character, and other doll makers interested in marketing a doll that would depict the character have a competitive need to use that name to describe their products").

1209.03(y) Marks Including Geographic Wording that Does Not Indicate Geographic Origin of Cheeses and Processed Meats

Some applications for marks used in connection with cheeses and processed meats may include geographic wording ("geo-significant wording") that does not indicate geographic origin, but otherwise may be a generic designation for such goods. *See*TMEP §1210.02(b)(iii). Two federal agencies maintain lists of particular cheeses or processed meats for which the producers of such goods must satisfy certain requirements or standards in order to label or market them with the listed common name of the product. Thus, these names cannot be single-source indicators, and inclusion on such lists is strong evidence that the otherwise geo-significant wording is generic for the goods.

The U.S. Food and Drug Administration (FDA), responsible for protecting the public health by ensuring the safety of the nation's food supply, establishes mandatory requirements, known as "standards of identity," for marketing cheese products under specific common names. These standards of identity relate solely to the production methods and ingredients necessary to label a product with the common name given to that standard. For example, part 133 of title 21, chapter 1, subchapter B (Food for Human Consumption) includes standards of identity for the following types of cheeses: cheddar, edam, romano, and provolone.

The U.S. Department of Agriculture (USDA), also responsible for ensuring food safety, establishes standards of identity for labeling of processed meat products under specific common names. For example, USDA regulations part 319 include standards of identity for the following types of processed meat: frankfurter, wiener, bologna, and braunschweiger.

In addition to these two federal agencies, an international body, Codex Alimentarius (Codex), operates within the U.N. Food and Agriculture Organization and the World Health Organization to establish international food standards for, among other things, cheese. Codex standards of identity for cheese include: brie, camembert, edam, gouda, and havarti.

Because standards of identity relate solely to production methods and ingredients, there is no requirement that the product come from a specific place, even though many of these terms identify a cheese or processed meat that once came only from the place referred to in the name (e.g., CHEDDAR originated in Cheddar, England; brie originated in Brie, France; and bologna originated in Bologna, Italy). Therefore, such geo-significant terms differ from certification and collective marks of regional origin, which are registrable under §4 of the Trademark Act, 15 U.S.C. §1054. Certification and collective marks of regional origin refer to the place the products come from and the quality standards they meet. Standards of identity are food-labeling requirements intended to prevent consumers from being misled as to what product they are buying.

In addition to searching for evidence using traditional sources, when a mark includes geo-significant wording relating to a particular cheese or processed meat, the examining attorney must also conduct research to determine if the wording is a standard of identity for the goods specified in the application, using sources of evidence that are appropriate for the particular goods specified in the application (e.g., the FDA, USDA, and Codex databases). The examining attorney may submit a request to the Trademark Law Library to undertake such research or may personally conduct the research. Evidence that the particular term is a standard of identity must be included with the Office action. If available, the examining attorney should include additional evidence that shows how the proposed mark would be perceived in the marketplace. Note that if the name of a product appears only on the Codex list, further evidence, such as a dictionary definition or internet evidence of the product's availability to U.S. consumers, must be included.

When warranted by the evidence, the examining attorney must refuse registration or require a disclaimer under §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), in accordance with current practice. TMEP §§1209.02, 1209.02(a), 1213.03(a). Because inclusion on the FDA or USDA list is strong evidence that the term is generic for the particular cheese or processed meat, when the marks include or consist of such terms, the examining attorney should also advise the applicant that the relevant wording appears to be the generic term for the goods. *See*TMEP §1209.02(a).

When there is evidence that the accuracy of a product's compliance with standards of identity is material to purchasing decisions, a mark including or consisting of such terms used on non-compliant cheeses or processed meats would be deceptive under § 2(a) of the Trademark Act, 15 U.S.C. §1052(a). Therefore, the examining attorney must require that the applicant amend the identification of goods to include the term. *See*TMEP §§1203.02(a), (d), (e)(i)-(ii), (f)(i).

If the name of a standard of identity comprises, in whole or in part, a mark for services that relate to cheese or processed meat, the examining attorney must consult the Office of the Deputy Commissioner for Trademark Examination Policy before taking any action on the application.

1209.04 Deceptively Misdescriptive Marks

Two-part test. 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. A mark is considered deceptively misdescriptive if (1) the mark misdescribes the goods or services and (2) consumers would be likely to believe the misrepresentation. *In re Dolce Vita Footwear, Inc.*, 2021 USPQ2d 478, at *11 (TTAB 2021) (citing *In re Budge Mfg. Co.*, 857 F.2d 773, 775, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988); *In re White Jasmine LLC*, 106 USPQ2d 1385, 1394 (TTAB 2013)).

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, feature, purpose, or use of the goods or services with which it is used is merely descriptive. 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 Dolce Vita Footwear, Inc.*, 2021 USPQ2d 478, at *11 (quoting *In re Hinton*, 116 USPQ2d 1051, 1052 (TTAB 2015); *In re Phillips-Van Heusen*, 63 USPQ2d 1047, 1048 (TTAB 2005));*In re AOP LLC*, 107 USPQ2d 1644 (TTAB 2013) (AOP deceptive, deceptively misdescriptive, or, alternatively, merely descriptive for wine, after the applicant failed to fully respond to the examining attorney's inquiries regarding the origin and certification of applicant's goods); *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); *see alsoIn re Hinton*, 116 USPQ2d 1051, 1055 (TTAB 2015) (finding that the misdescription presented by the mark THCTEA is plausible and would be highly relevant to a consumer's purchasing decision); *In re Shniberg*, 79 USPQ2d 1309, 1311 (TTAB 2006) ("[T]he misdescription must concern a feature that would be relevant to a purchasing decision.").

The examining attorney must make of record evidence demonstrating why the mark is misdescriptive, regardless of whether the wording in the mark appears in the identification of goods or services. Specifically, the record must show the meaning of the wording at issue and that applicant's goods or services lack the feature or characteristic. Examples of such evidence include dictionary definitions, LexisNexis® articles, Internet websites (see TMEP §710.01(b) regarding Internet evidence requirements), advertising material, product information sheets, hang tags, point-of-purchase displays, and trade journals. An applicant's admission in the application record regarding its goods or services may also satisfy the first prong of the test.

Thus, restricting the identification of goods or services to exclude the feature or characteristic referenced in the mark will generally not avoid or overcome the refusal. *See In re Dolce Vita Footwear, Inc.*, 2021 USPQ2d 478, at *13. It cannot be assumed that consumers of the applicant's goods or services will be aware that the identification is so restricted, and the restriction is not controlling on public perception. *Id.* (citing *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1187-88 (TTAB 2018)).

With respect to the second part of the test, the Trademark Act does not prohibit the registration of misdescriptive terms unless they are deceptively misdescriptive, that is, unless reasonably prudent consumers of the goods or services are likely to believe the misrepresentation. *See In re Dolce Vita Footwear, Inc.*, 2021 USPQ2d 478, at *11 (citing *In re Hinton*, 116 USPQ2d at 1052); *In re Quady Winery Inc.*, 221 USPQ 1213, 1213-14 (TTAB 1984) (finding ESSENSIA deceptively misdescriptive for wines not containing essensia, a rare, commercially unavailable type of Hungarian Tokay wine); *Binney & Smith Inc. v. Magic Marker Indus.*, Inc., 222 USPQ 1003, 1011 (TTAB 1984) (holding LIQUID CRAYON neither the common descriptive name, nor merely descriptive, nor deceptively misdescriptive of coloring kits or markers).

To prove that the description conveyed by the mark is believable, the examining attorney must provide evidence demonstrating that consumers regularly encounter the same or similar goods or services with 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.*, 857 F.2d at 775, 8 USPQ2d at 1260. In another case, 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 Techs., Inc.*, 41 USPQ2d 1690, 1693–94 (TTAB 1997). Applicant's own hang tags, labels, advertising, and product information may also provide evidence of the believability of the misdescription. *SeeIn re Shapely, Inc.*, 231 USPQ 72, 75 (TTAB 1986) (concluding that statements on hangtags can be used to show the materiality of the mispresentation in the purchasing decision); *Evans Prods. Co. v. Boise Cascade Corp.*, 218 USPQ 160, 164–65 (TTAB 1983) (finding that applicant's advertising materials and affidavit indicated that it did attempt to "adopt a mark [CEDAR RIDGE] which conveyed the impression

of authentic cedar"). Webpage evidence showing third-party usage of the proposed mark used in a descriptive manner with the same or similar goods or services has also been accepted as evidence of the believability of the misrepresentation. *See In re Dolce Vita Footwear, Inc.*, 2021 USPQ2d 478, at *13.

The examining attorney should consider and make of record, or require the applicant to make of record under 37 C.F.R §2.61(b) (see TMEP §814 regarding requests for information), all available information that shows the presence or absence, and the believability, of a misrepresentation. *See Glendale Int'l Corp. v. USPTO*, 374 F. Supp. 2d 479, 486, 75 USPQ2d 1139, 1144 (E.D. Va. 2005) (holding TITANIUM deceptively misdescriptive of recreational vehicles that did 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, 790, 140 USPQ 276, 279 (C.C.P.A. 1964) (holding DURA-HYDE deceptive and deceptively misdescriptive of plastic material of leather-like appearance made into shoes regardless of the presence of tags stating that the material "outwears leather"); *In re Shniberg*, 79 USPQ2d 1309, 1313 (TTAB 2006) (holding SEPTEMBER 11, 2001 deceptively misdescriptive of books and entertainment services that 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 did not prevent the mark from being deceptively misdescriptive); *see also In re Dolce Vita Footwear, Inc.*, 2021 USPQ2d 478, at *15-16 (finding "[p]re-sale discussion and promotion leading to deception is likely in this case" even though visual inspection of the goods by consumers would show they did not include the particular feature; however, applicants goods could be promoted "by word-of-mouth or on social media or in print . . . without an image of the goods");*In re ALP of S. Beach Inc.*, 79 USPQ2d 1009, 1014-15 (TTAB 2006) (holding that pre-sale deception may occur without a sale taking place based on the deception); *Nw. Golf Co. v. Acushnet Co.*, 226 USPQ 240 (TTAB 1985) (finding deception unlikely given alternative meanings of the mark and that even cursory curiosity on the part of consumers would avoid any potential deception).

Response options. 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), 1091. Similarly, marks that contain registrable matter in addition to deceptively misdescriptive components can be registered with a disclaimer of the deceptively misdescriptive matter, when appropriate. *See*TMEP §1213.03(a).

Section 2(a) consideration. If the misdescription represented by the mark is material to the decision to purchase the goods or use the services, then the mark must be refused registration under §2(a) of the Trademark Act, 15 U.S.C §1052(a). See TMEP §1203.02 regarding deceptive marks, §1203.02(c) regarding the distinction between deceptive marks and deceptively misdescriptive marks, and §1203.02(d)-(d)(ii) regarding determining materiality. Marks that are deceptive under §2(a) are not registrable on either the Principal Register or the Supplemental Register under any circumstances. TMEP §1203.02.

Case references. Some designations have been held deceptively misdescriptive under §2(e)(1). *See, e.g.*, *In re Dolce Vita Footwear, Inc.*, 2021 USPQ2d 478, at *1, *16-17 (holding CLEAR deceptively misdescriptive of footwear and clothing items, excluding transparent goods; third-party evidence showed "clear" used to describe footwear and clothing that was transparent or clear or contained transparent or clear elements); *In re Hinton*, 116 USPQ2d at 1055 (holding THCTEA deceptively misdecriptive for tea that does not contain THC; evidence showed that such teas could be offered through medical marijuana dispensiaries or locations where marijuana products are legally sold under state law); *In re Woodward &*

Lothrop Inc., 4 USPQ2d 1412 (TTAB 1987) (holding CAMEO deceptively misdescriptive of jewelry "which has no cameos or cameo-like elements"; evidence showed that "cameo" names a type of jewelry); *In re Ox-Yoke Originals, Inc.*, 222 USPQ 352 (TTAB 1983) (holding G.I., a well-known abbreviation for "government issue," deceptively misdescriptive of gun cleaning patches, rods, brushes, solvents, and oils that are not government issued, although "[t]he [U.S.] government does in fact issue gun cleaning products to its armed forces).

1210 Refusal on Basis of Geographic Significance

15 U.S.C. §1052 (Extract)

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 1054 of this title, (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 support a refusal to register a mark as primarily geographically descriptive under Section 2(e)(2) of the Trademark Act, 15 U.S.C §1052(e)(2), the examining attorney must show that:

(1) the primary significance of the mark is a generally known geographic location (*see*TMEP §§1210.02–1210.02(b)(iv));
(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 §§1210.04–1210.04(d)). *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)).

See Spiritline Cruises LLC v. Tour Mgmt. Servs., Inc., 2020 USPQ2d 48324, at *5 (TTAB 2020) (citing *In re Nantucket, Inc.*, 677 F.2d 95, 96-97, 213 USPQ 889, 891 (C.C.P.A. 1982)); *see also In re Newbridge Cutlery Co.*, 776 F.3d 854, 860-61, 113 USPQ2d 1445, 1448-49 (Fed. Cir. 2015); *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 959, 3 USPQ2d 1450, 1452 (Fed. Cir. 1987); *In re JT Tobacconists*, 59 USPQ2d 1080, 1081 (TTAB 2001). Relevant purchasers are the purchasing public in the United States of the types of goods or services identified in the involved application. *City of London Distillery, Ltd. v. Hayman Grp. Ltd.*, 2020 USPQ2d 11487, at *6 (TTAB 2020); *In re Broken Arrow Beef & Provision, LLC*, 129 USPQ2d 1431, 1432 (TTAB 2019) (citing *In re Newbridge Cutlery Co.*, 776 F.3d at 861, 113 USPQ2d at 1449).

1210.01(b) Geographically Deceptively Misdescriptive Marks – Test

To support a refusal to register a mark as primarily geographically deceptively misdescriptive under Section 2(e)(3) of the Trademark Act, 15 U.S.C §1052(e)(3), the examining attorney must show that:

(1) the primary significance of the mark is a generally known geographic location (*see*TMEP §§1210.02–1210.02(b)(iv));
(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 §§1210.04–1210.04(d)). *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)–(c)(ii)).

In re Miracle Tuesday, LLC, 695 F.3d 1339, 1343, 104 USPQ2d 1330, 1332 (Fed. Cir. 2012); *In re Spirits Int'l, N.V.*, 563 F.3d 1347, 1350–54, 90 USPQ2d 1489, 1490–95 (Fed. Cir. 2009); *In re Les Halles De Paris J.V.*, 334 F.3d 1371, 67 USPQ2d 1539 (Fed. Cir. 2003). See TMEP §1210.01(a) for more information regarding determining relevant purchasers.

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 to establish that a mark was primarily geographically deceptively misdescriptive. However, in *In re California Innovations, Inc.*, 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) of the Trademark Act. 329 F.3d 1334, 1339, 66 USPQ2d 1853, 1856 (Fed. Cir. 2003).

*See*TMEP §1210.05(c) for further information regarding the distinction between marks comprising deceptive matter under §2(a) of the Act and marks comprising primarily geographically deceptively misdescriptive matter under §2(e)(3) of the Act, and TMEP §§1210.05(c)–c)(ii) 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) of the Trademark Act is the same as the test for determining whether a mark is deceptive under §2(a) of the Act. 15 U.S.C §§1052(a), (e)(3). 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 §§1210.02–1210.02(b)(iv));
(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 §§1210.04–1210.04(d)). *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)–(c)(ii)).

In re Miracle Tuesday, LLC, 695 F.3d 1339, 1343, 104 USPQ2d 1330, 1332 (Fed. Cir. 2012); *In re Spirits Int'l, N.V.*, 563 F.3d 1347, 1350–54, 90 USPQ2d 1489, 1490–95 (Fed. Cir. 2009); *Institut Nat'l des Appellations D'Origine v. Vintners Int'l Co.*, 958 F.2d 1574, 1580, 22 USPQ2d 1190, 1195 (Fed. Cir. 1992); *In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1843 (TTAB 2012); *In re House of Windsor, Inc.*, 221 USPQ 53 (TTAB 1983); *see also In re Cal. Innovations Inc.*, 329 F.3d 1334, 66 USPQ2d 1853 (Fed. Cir. 2003). See TMEP §1210.01(a) for more information regarding determining relevant purchasers.

*See*TMEP §1210.05(a) for more 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)–(c)(ii) 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

The significance of 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) (holding that the 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) of the Trademark Act. *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) (finding "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) (holding 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 South Carolina). *But see In re Broken Arrow Beef & Provision, LLC*, 129 USPQ2d 1431 (TTAB 2019) (finding "the letters 'BA' in the applied-for mark have no obvious, generally known geographic significance, much less as a known abbreviation for Broken Arrow, Oklahoma" and thus did not identify a place known generally to the purchasing public);*In re Trans Cont'l Records, Inc.*, 62 USPQ2d 1541 (TTAB 2002) (finding O-TOWN "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) (holding BAIKALSKAYA – the Russian equivalent of "from Baikal" or "Baikal's" – primarily geographically descriptive of vodka); *In re Jack's Hi-Grade Foods, Inc.*, 226 USPQ 1028 (TTAB 1985) (holding NEAPOLITAN primarily geographically deceptively misdescriptive of sausage emanating from the United States, where the term is defined as "of or pertaining to Naples in Italy"); *In re BankAmerica Corp.*, 231 USPQ 873 (TTAB 1986) (holding BANK OF AMERICA 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 Can. Dry Ginger Ale, Inc.*, 86 F.2d 830, 32 USPQ 49 (C.C.P.A. 1936) (finding a map of Canada to be the equivalent of the word "Canada"). *But seeIn re Texsun Tire & Battery Stores, Inc.*, 229 USPQ 227, 229 (TTAB 1986) (holding 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) of the Act. For example, names of amusement parks, residential communities, and business complexes which are coined by the applicant, must not be refused. *In re Pebble Beach Co.*, 19 USPQ2d 1687, 1688-89 (TTAB 1991) (finding 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 to the relevant consumers in the United States be that of a geographic location. 15 U.S.C. §§1052(e)(2) and (3). *See, e.g., In re Newbridge Cutlery Co.*, 776 F.3d 854, 113 USPQ2d 1445 (Fed. Cir. 2015) (finding evidence insufficient to establish that Newbridge, Ireland is a place known generally to the relevant American public); *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999) (NEW YORK held to have primarily geographic significance; 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 Broken Arrow Beef and Provision, LLC*, 129 USPQ2d 1431, 1444 (TTAB 2019) (finding the record failed to establish that "'BA' in the applied-for mark is anything other than 'a relatively obscure term which would not be perceived as a geographic reference to' Broken Arrow, Oklahoma by beef consumers outside Broken Arrow");*In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738(TTAB 2016)(reversing a §2(e)(3) refusal of a mark containing the wording MT. RAINIER THE MOUNTAIN OF SEATTLE ESPRESSO & MILK, noting that "[w]hile there is no doubt that the term SEATTLE identifies a generally known geographic location, as it is used in the context of Applicant's mark, we do not find that the relevant public would consider it to indicate of the origin of the goods");*In re Cheezwhse.com, Inc.*, 85 USPQ2d 1917 (TTAB

2008) (NORMANDIE CAMEMBERT, with 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).

When the primary significance of a geographic designation identifying a city is that of a geographic location, the designation may include locations in the metropolitan area of the identified city.

When it is not clear on its face that the primary significance of the mark is that of a geographic location, the record must include substantial evidence to support a conclusion that the mark identifies a place "known generally to the relevant American public." *See In re Newbridge Cutlery*, 776 F.3d at 862, 113 USPQ2d at 1450. A showing " . . . that the population of the location is sizable and/or that members of the consuming public have ties to the location (to use the example in *Loew's*: that Durango, Mexico, would be recognized by "the Mexican population of this country") is evidence that a location is generally known." *Id*. at 861, 113 USPQ2d at 1449. A gazetteer entry alone, or a description of the place on the internet, does not necessarily evidence that a place is generally known to the relevant American consuming public. *Id*. at 863, 113 USPQ2d at 1450. Such evidence must, therefore, be supported by evidence showing the extent to which relevant American consumers would be familiar with the location. *Id*. at 862, 113 USPQ2d at 1450.

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).

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)–1210.02(c)(iii).

*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 must be refused under §2(e)(2), §2(e)(3), or §2(a). *See, e.g.*, *In re Hollywood Lawyers Online*,110 USPQ2d 1852, 1858 (TTAB 2014) (finding no allusion to the alternative meaning of "Hollywood" referencing the film industry when viewed in the context of applicant's services and without additional elements in the mark to detract from the geographic significance); *In re Opryland USA Inc.*, 1 USPQ2d 1409 (TTAB 1986) (holding THE NASHVILLE NETWORK primarily geographically descriptive of television program production and distribution services, as the Board found 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) (finding the fact that MANHATTAN identifies an alcoholic cocktail does not alter the primary significance of the term as a borough of New York City); *In re Jack's Hi- Grade Foods, Inc.*, 226 USPQ 1028, 1029 (TTAB 1985) (finding 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 must not be refused under §2(e)(2), §2(e)(3), or §2(a). *See In re Newbridge Cutlery Co.*, 776 F.3d 854, 113 USPQ2d 1445 (Fed. Cir. 2015) (finding it less likely that Newbridge (a town in Ireland) is generally known as the name of a place given its other meanings); *In re Sibony*, 2021 USPQ2d 1036, at *13 (TTAB 2021) (reversing a §2(e)(3) refusal because, "[w]hile REPUBLIC OF LONDON includes the geographic term 'London,' the primary significance of the mark as a whole is a fictitious place"); *In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1748(TTAB 2016) (reversing a §2(e)(3) refusal of a composite mark containing the wording MT. RAINIER THE MOUNTAIN OF SEATTLE ESPRESSO & MILK, noting that "[w]hile there is no doubt that the term SEATTLE identifies a generally known geographic location, as it is used in the context of [a]pplicant's mark, we do not find that the relevant public would consider it to indicate of the origin of the goods"); *In re Int'l Taste Inc.*, 53 USPQ2d 1604, 1605–06 (TTAB 2000) (finding doubt as to the primary significance of HOLLYWOOD because of other prominent, significant meaning of HOLLYWOOD as referring to the entertainment industry in general, with the doubt resolved in favor of the applicant); *In re Urbano*, 51 USPQ2d 1776, 1780 (TTAB 1999) (finding the primary significance of SYDNEY 2000, used for advertising, business, and communication services, is as a reference to the Olympic Games, not to the name of a place); *In re Jim Crockett Promotions Inc.*, 5 USPQ2d 1455, 1456 (TTAB 1987) (finding that the 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 Ins. 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. *SeeIn re Hamilton Pharm. Ltd.*, 27 USPQ2d 1939, 1943 (TTAB 1993) (HAMILTON held primarily merely a surname, even though the term had some geographical connotations); *In re Colt Indus. 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 Sys.*, 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," "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 Grp. Inc.*

v. Arrow Trading Co. Inc., 30 F.3d 348, 356, 31 USPQ2d 1614, 1619 (2d Cir. 1994), *aff'd*, 124 F.3d 402, 43 USPQ2d 1942 (2d Cir. 1997) (finding that SWISS ARMY KNIFE refers to a knife used by the Swiss Army, not an Army Knife from Switzerland); *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) (finding 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). *See*TMEP §1209.03(y) regarding the procedures for examining applications for cheeses and processed meats in which the mark includes geographic wording that does not indicate geographic origin, but otherwise may be a generic designation for such goods.

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 must 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 Am. 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 Enters. 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 Entm't Corp.*, 60 USPQ2d 1130 (TTAB 2000) (EGYPT merely descriptive of subject matter or motif of amusement park services). *See*TMEP §§1209–1209.04 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., Am. Diabetes Ass'n, Inc. v. Nat'l 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 Am., 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); *Am. Paper & Plastic Products, Inc. v. Am. 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, e.g., 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); *Am. Plan Corp. v. State Loan & Fin. 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 for insurance brokerage services); *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, with a disclaimer of AMERICAN, 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 BEST POPCORN! and AMERICA'S FAVORITE POPCORN! held merely descriptive of unpopped popcorn); *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, with a disclaimer of NEW YORK, held primarily geographically deceptively misdescriptive of backpacks, handbags, purses, and similar items); *In re Bacardi & Co. Ltd.*, 48 USPQ2d 1031 (TTAB 1997) (HAVANA SELECT, HABANA 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, with a disclaimer of NEW YORK, 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 §§1210.06–1210.06(b) 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 or services originate from or are rendered in both of the locations named in the mark. *See In re Narada Prods., Inc.*, 57 USPQ2d 1801, 1803 (TTAB 2001) (holding CUBA L.A. primarily geographically deceptively misdescriptive of musical recordings and live musical performances that did 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 Ins. Grp. Ltd.*, 36 USPQ2d 1367 (TTAB 1995) (holding 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) (holding LONDON LONDON 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. *Spiritline Cruises LLC v. Tour Mgmt. Servs., Inc.*, 2020 USPQ2d 48324 (TTAB 2020) (holding CHARLESTON HARBOR TOURS primarily geographically descriptive of various travel tour and cruise services because TOURS is generic for the services and CHARLESTON HARBOR is a well known harbor in Charleston, South Carolina);*In re Cheezwhse.com, Inc.*, 85 USPQ2d 1917 (TTAB 2008) (holding NORMANDIE CAMEMBERT with CAMEMBERT, disclaimed, 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) (holding MINNESOTA CIGAR COMPANY primarily geographically descriptive of cigars); *In re Carolina Apparel*, 48 USPQ2d 1542

(TTAB 1998) (holding CAROLINA APPAREL primarily geographically descriptive of retail clothing store services); *In re Chalk's Int'l Airlines Inc.*, 21 USPQ2d 1637 (TTAB 1991) (holding PARADISE ISLAND AIRLINES 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 Wine Soc'y of Am. Inc.*, 12 USPQ2d 1139 (TTAB 1989) (holding THE WINE SOCIETY OF AMERICA primarily geographically descriptive of wine club membership services); *In re Cal. Pizza Kitchen Inc.*, 10 USPQ2d 1704 (TTAB 1988) (holding CALIFORNIA PIZZA KITCHEN, with a disclaimer of PIZZA KITCHEN, primarily geographically descriptive of restaurant services).

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 Sibony*, 2021 USPQ2d 1036, at *11-13 (TTAB 2021) (holding REPUBLIC OF LONDON for clothing items not primarily geographically deceptively misdescriptive under §2(e)(3) because the primary significance of the mark as a whole was a fictitious or whimsical location); *In re Sharky's Drygoods Co.*, 23 USPQ2d 1061 (TTAB 1992) (holding PARIS BEACH CLUB for T-shirts and sweatshirts not deceptive under §2(a) because Paris "is not located on an ocean or lake, and does not have a beach," thus, "[t]he juxtaposition of Paris with Beach Club results in an incongruous phrase;" and the inclusion of "Paris" in the mark was humorous or facetious because Paris is known for haute couture and purchasers would not expect T-shirts and sweatshirts to originate there).

1210.03 Geographic Origin of the Goods or Services

The question of whether a term is primarily geographically descriptive under §2(e)(2) of the Trademark Act, primarily geographically deceptively misdescriptive under §2(e)(3) of the Act, or geographically deceptive under §2(a) of the Act 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, 1694-95 (TTAB 1996) (holding RODEO DRIVE primarily geographically deceptively misdescriptive of perfume, where opposer's evidence showed that a significant number of Rodeo Drive retailers sold "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, 391-92, 13 USPQ2d 1725, 1727 (Fed. Cir. 1990) (holding RODEO DRIVE 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 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 City of London Distillery Ltd. v. Hayman Grp. Ltd.*, 2020 USPQ2d 11487, at *6, *10 (TTAB 2020) (holding CITY OF LONDON primarily geographically descriptive of gin distilled at a distillery in London and bottled just outside of London); *In re Joint-Stock Co. "Baik,"* 80 USPQ2d 1305, 1310 (TTAB 2006) (holding BAIKALSKAYA, the Russian equivalent of "from Baikal" or "Baikal's," 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 was made from the water of Lake Baikal). However, the fact that a product may have been produced in a geographic style under the direction of someone trained from that geographic place is not a sufficient connection to deem the goods originate from there. *See In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1850 (TTAB 2012) (holding OLD HAVANA primarily geographically deceptively misdescriptive for rum despite applicant's arguments including that the rum was

produced in a "Cuban" or "Havanese" style under the direction of someone trained in Cuba and that purchasers know the rum could not come from Cuba because of the embargo). The relevant inquiry is whether there is a connection between the goods and the place named in the mark. *See In re Miracle Tuesday, LLC*, 695 F.3d 1339, 1343, 104 USPQ2d 1330, 1332 (Fed. Cir. 2012) (holding the fact that the designer of applicant's products lived in Paris more than 25 years before was insufficient to establish that goods now marketed under JPK PARIS 75, and design, originated there).

Goods and services do not always originate in the applicant's place of business. *See In re Mankovitz*, 90 USPQ2d 1246 (TTAB 2009) (holding THE MONTECITO DIET *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, because the Board found 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) (holding HARVEYS BRISTOL CREAM not primarily geographically descriptive of cakes flavored with sherry wine, because the Board found that neither applicant's sherry wines nor applicant's cakes came 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) (holding NANTUCKET NECTARS 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) (holding PARADISE ISLAND AIRLINES 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) (holding NIPPON not deceptive of, *inter alia*, radios and televisions because, although the applicant was an American corporation, the goods were 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). *In re Cal. Pizza Kitchen Inc.*, 10 USPQ2d 1704, 1706 n.2 (TTAB 1988) (holding CALIFORNIA PIZZA KITCHEN for restaurant services 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 because 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, and misdescriptiveness would not be material to the decision to purchase the goods/services, the examining attorney must do the following:

(1) If (a) the entire mark would be geographically misdescriptive, or a portion of the mark would 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 must:

> 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 by entering a Note to the File in the record, enter any amendments necessary to put the application in condition for approval, and approve the mark for publication.

(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 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. The examining attorney may also 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
Issue any other relevant refusals and requirements.

See In re Cheezwhse.com, Inc., 85 USPQ2d 1917, 1919 (TTAB 2008), (affirming 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").

See TMEP §1210.05(d)(ii) regarding the procedures when it is unclear where the goods/services originate or will originate and any misdescriptiveness would be material to the decision to purchase.

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 Indus., Inc.*, 60 USPQ2d 1511, 1517 (TTAB 2001) (finding 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, 1146 (TTAB 1993) (finding that 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). Note, however, that evidence other than the mark found on a

specimen, which provides further information as to source, does not negate the geographic deceptive misdescriptiveness that may be conveyed by the mark itself. *In re Premiere Distillery, LLC*, 103 USPQ2d 1483, 1486-87 (TTAB 2012); *In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1848-49 (TTAB 2012) (finding the statements "brand," "Cuban Style Rum," and "Product of the USA" on applicant's label do not negate the primary geographically deceptive misdescriptiveness of the OLD HAVANA mark).

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, 1621 (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 held 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, because the applicant's services included flights to and from Paradise Island, Bahamas, even though the flights were not based there); *In re Cal. 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 (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 §§1210.02–1210.02(c)(iii) 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, 1374, 67 USPQ2d 1539, 1542 (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 Miracle Tuesday, LLC*, 695 F.3d 1339, 1344, 104 USPQ2d 1330, 1333 (Fed. Cir. 2012) (JPK PARIS 75 and design held primarily geographically deceptively misdescriptive of fashion accessories that do not originate in Paris where it is undisputed that Paris is famous for such products); *In re Save Venice New York Inc.*, 259 F.3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001) (THE VENICE COLLECTION and SAVE VENICE INC. composite marks featuring an image of the winged Lion of St. Mark 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) (finding evidence from a gazeteer and dictionary showing that tobacco is a crop produced and marketed in Durango, Mexico 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 Indus., Inc.*, 60 USPQ2d 1511, 1516-17 (TTAB 2001) (finding 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, was 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, HABANA 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. [citation omitted] 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. *SeeIn re Mun. Capital Mkts., 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 re Consol. Specialty Rests., Inc.,* 71 USPQ2d 1921 (TTAB 2004) (COLORADO STEAKHOUSE and design held primarily geographically deceptively misdescriptive of restaurant services). In *Consol. Specialty Rests.*, 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. *Id.* at 1927-28.

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, 1827 (TTAB 2006) (finding Balashi, Aruba 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. *SeeIn 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. Int'l 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 Cal. 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 Miracle Tuesday LLC, 695 F.3d 1339, 1343, 104 USPQ2d 1330, 1332 (Fed. Cir. 2012); *In re Spirits Int'l, N.V.*, 563 F.3d 1347, 1350–54, 90 USPQ2d 1489, 1490–95 (Fed. Cir. 2009); *Cal. Innovations*, 329 F.3d at 1341; 66 USPQ2d at 1858.

The determination of whether the primary significance of the mark is a generally known geographic location can be made "by showing that the mark in question consists of or incorporates a term that denotes a geographical location which is neither obscure nor remote." *In re Sharky's Drygoods Co.*, 23 USPQ2d 1061, 1062 (TTAB 1992). See TMEP §1210.06 regarding procedures for examining geographic composite marks and TMEP §1210.06(b) regarding primarily geographically deceptively misdescriptive and deceptive composites. Thus, the focus is on whether the term in question is primarily geographic in the context of the mark, rather than on whether the geographic reference dominates the mark.

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 1493; *seeCorporacion Habanos, S.A. v. Guantanamera Cigars Co.*, 102 USPQ2d 1085, 1097 (TTAB 2012).

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 Cal. 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, 56 (TTAB 1983), *recon. denied*, 223 USPQ 191 (TTAB 1984). Materiality may be established inferentially based on indirect evidence such as gazetteer entries and third-party websites. *SeeCorporacion Habanos, S.A. v. Guantanamera Cigars Co.*, 102 USPQ2d 1085, 1098 (TTAB 2012) . 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. *In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1850 (TTAB 2012) ; *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 must 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 Cal. 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); *Compania de Licores Internacionales*, 102 USPQ2d at 1850; *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. *Compania de Licores Internacionales*, 102 USPQ2d at 1850.

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 examining attorney 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 Consol. Specialty Rests., 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, 334 F.3d at 1375, 67 USPQ2d at 1542.

In *Consol. Specialty Rests., Inc.*, the Board held COLORADO STEAKHOUSE and design primarily geographically deceptively misdescriptive of restaurant services. In the course of that holding, 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. *Id*. at 1924-28. 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 §§1203.02–1203.02(g) 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 in commerce 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 claims use in commerce prior to December 8, 1993, the examining attorney must issue a nonfinal refusal under §2(a), supported by appropriate evidence.
- 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 to a nonfinal refusal under §§2(e)(3) and 2(a), 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 S. Park Cigar, Inc., 82 USPQ2d 1507, 1509, n.3 (TTAB 2007). *See also Corporacion Habanos, S.A. v. Guantanamera Cigars* Co., 86 USPQ2d 1473, 1475 (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, the record does not indicate whether the goods/services originate in that place (*see*TMEP §1210.03), and misdescriptiveness would be material to the decision to purchase, the examining attorney must do the following:

(1) If (a) the entire mark would not be geographically descriptive (making disclaimer an option if the goods/services originate from the place), (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, such that the mark is geographically deceptively misdescriptive, the examining attorney must so indicate by entering a Note to the File in the record. The examining attorney must then follow the appropriate procedure in TMEP §1210.05(d)(i).

(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 uncertainty as to 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
- 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).

See TMEP §1210.03 regarding the procedures when it is unclear where the goods/services originate or will originate and any misdescriptiveness would not be material to the decision to purchase.

1210.05(e) Geographically Deceptive Matter: Case References

In re Miracle Tuesday LLC, 695 F3d 1339, 104 USPQ2d 1330 (Fed. Cir. 2012) (affirming the TTAB’s refusal to register JPK PARIS 75 and design as primarily geographically deceptively misdescriptive for fashion accessories that did not originate in Paris); *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, 1375, 67 USPQ2d 1539,

1542 (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 Cal. 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) (TTAB found to have applied an outdated standard of review under §2(e)(3), case remanded for application of new, post-NAFTA test); *In re Save Venice New York Inc.*, 259 F.3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001) (THE VENICE COLLECTION and SAVE VENICE INC. composite marks featuring an image of the winged Lion of St. Mark 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); *In re Premiere Distillery, LLC*, 103 USPQ2d 1483 (TTAB 2012) (finding REAL RUSSIAN primarily geographically deceptively misdescriptive for vodka); *In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841 (TTAB 2012) (finding OLD HAVANA primarily geographically deceptively misdescriptive for rum and applicant's claim of acquired distinctiveness insufficient); *Corporacion Habanos, S.A. v. Guantanamera Cigars Co.*, 102 USPQ2d 1085 (TTAB 2012) (finding GUANTANAMERA, a Spanish word meaning "girl from Guantanamo" or "of or from Guantanamo, Cuba," primarily geographically deceptively misdescriptive for cigars not from Cuba); *In re Jonathan Drew, Inc.*, 97 USPQ2d 1640 (TTAB 2011) (finding KUBA KUBA primarily geographically deceptively misdescriptive of cigars, tobacco, and related products that did not originate in Cuba nor would they be made from Cuban seed tobacco); *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); *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 S. 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 Consol. Specialty Rests., 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) (holding that the 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, with a disclaimer of NEW YORK, 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)–1210.02(c)(iii).

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 re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1748(TTAB 2016). In order to do so, the examining attorney may also consider the significance of each element within the mark. *In re Save Venice New York Inc.*, 259 F.3d at 1352, 59 USPQ2d at 1782.

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. *Id.* at 1062. 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 case of the mark YBOR GOLD, 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 S. 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. *Id.* at 1513.

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 must 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 §§1213-1213.11 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

Geographically deceptive and primarily geographically deceptively misdescriptive matter need not comprise the entire mark, or even the dominant portion of the mark, to form the basis for a refusal under §2(a) or §2(e)(3). *See*15 U.S.C. §1052(a), (e)(3). However, a §2(e)(3) refusal is not appropriate unless the evidence shows that the mark as a whole would likely be perceived as indicating the geographic origin of the goods

or services. *In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1748 (TTAB 2016). Likewise, a mark should not be refused under §2(a) unless the relevant geographic matter, when considered in the context of the mark as a whole, is deceptive. *Id.* ("Even under Trademark Act Section 2(a), which permits a narrower focus on the allegedly deceptive matter, a refusal to register may not be based on a term taken out of context when doing so would change its significance in the mark.").

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). Similarly, 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 §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. *See*TMEP §714.05(a)(i). However, in certain circumstances, a primarily geographically descriptive mark may be considered incapable. *SeeIn re Bee Pollen from Eng. Ltd.*, 219 USPQ 163 (TTAB 1983) (finding BEE POLLEN FROM ENGLAND incapable of distinguishing bee pollen from England); *Mineco, Inc. v. Lone Mountain Turquoise Mine*, 217 USPQ 466 (TTAB 1983) (finding LONE MOUNTAIN 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, 1696 (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 §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 §714.05(a)(i) regarding a §2(f) claim submitted with an allegation of use in response to a refusal and §§1212–1212.10 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. *SeeIn re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1852 (TTAB 2012) ; *In re Boyd Gaming Corp*., 57 USPQ2d 1944, 1947 (TTAB 2000); *Fred Hayman Beverly Hills Inc. v. Jacques Bernier Inc*., 38 USPQ2d 1691, 1692 (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, TMEP §1210.08(c) regarding geographical indications that are generic for wines and spirits, and TMEP §1402.03(g) regarding situations in which the name and/or acronym of a trademark protection system or scheme for a geographical indication appears in an identification.

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. No. 103-465, 108 Stat. 4809 (1994), 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.R. Doc. No. 103-316, §B.1.e (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)–1210.02(b)(iv));
(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 §§1210.04–1210.04(d));
(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)–1210.05(c)(ii)); 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 must 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).

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(b) regarding amendment to a different type of mark, and TMEP §§1210.09 and 1306.05-1306.05(c) 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 §§1209.02-1209.02(b). Or, if appropriate, the examining attorney must require a disclaimer of the generic term or design. See TMEP §§1213–1213.11 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)–1209.01(c)(iii). 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 §§1306.05(a)–1306.05(c) 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, 1351, 90 USPQ2d 1489, 1491 (Fed. Cir. 2009) (applying doctrine in determining whether MOSKOVSKAYA, a Russian word meaning "of or from Moscow," was primarily geographically deceptively misdescriptive for vodka not from Moscow); *Corporacion Habanos, S.A. v. Guantanamera Cigars Co.*, 102 USPQ2d 1085 (TTAB 2012) (holding GUANTANAMERA, a Spanish word meaning "girl from Guantanamo" or "of or from Guantanamo, Cuba," primarily geographically deceptively misdescriptive for cigars); *In re Joint Stock Co. "Baik"*, 80 USPQ2d 1305 (TTAB 2006) (holding BAIKALSKAYA, a Russian word meaning "from Baikal," 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 Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1377, 73 USPQ2d 1689, 1696 (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 at 1352, 90 USPQ2d at 1492.

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, 443, 54 USPQ2d 1497, 1499 (5th Cir. 2000) (noting that "one policy undergirding the doctrine is 'the assumption that there are (or someday will be) customers in the U.S. who speak that foreign language.'" (quoting *Otokoyama Co. v. Wine of Japan Import, Inc.*, 175 F.3d 266, 270, 50 USPQ2d 1626, 1629 (2d Cir. 1999))); *cf. Gen. Cigar Co. Inc. v. G.D.M. Inc.*, 988 F. Supp. 647, 660, 45 USPQ2d 1481, 1492 (S.D.N.Y. 1997) (finding it doubtful that prospective purchasers would associate the mark with a word in a language spoken by the indigenous population of the Dominican Republic). 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 §§809–809.03 for information regarding how to ascertain the meaning of non-English wording in a mark. See also TMEP §§1207.01(b)(vi)–1207.01(b)(vi)(C), 1209.03(g), and 1211.01(a)(vii) regarding the doctrine of foreign equivalents.

1211 Refusal on Basis of Surname

15 U.S.C. §1052 (Extract)

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 §§1212–1212.10 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 legislative history of the Trademark Act of 1946 indicates that the 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. *SeeSears, Roebuck & Co. v. Watson*, 204 F.2d 32, 33-34, 96 USPQ 360, 362 (D.C. Cir. 1953); *Ex parte Rivera Watch Corp.*, 106 USPQ 145, 149 (Comm'r Pats. 1955).

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).

1211.01 "Primarily Merely a Surname"

The test for determining whether a mark is primarily merely a surname depends on the primary significance of the mark as a whole to the purchasing public. *Earnhardt v. Kerry Earnhardt, Inc.*, 864 F.3d 1374, 1377, 123 USPQ2d 1411, 1413 (Fed. Cir. 2017); *In re Hutchinson Tech. Inc.*, 852 F.2d 552, 554, 7 USPQ2d 1490, 1492 (Fed. Cir. 1988); *In re tapio GmbH*, 2020 USPQ2d 11387, at *8 (TTAB 2020). Thus, the impact the applied-for term has or would have on the purchasing public must be evaluated in determining whether the primary, and only, significance of the term is that of a surname. *In re Eximius Coffee, LLC*, 120 USPQ2d 1276, 1278 (TTAB 2016) (quoting *In re Harris-Intertype Corp.*, 518 F.2d 629, 631, 186 USPQ 238, 239 (C.C.P.A. 1975)).

Each case must be decided on its own facts, based upon the evidence in the record. *See In re Etablissements Darty et Fils*, 759 F.2d 15, 17, 225 USPQ 652, 653 (Fed. Cir. 1985). There is no rule as to the kind or amount of evidence necessary to show that relevant consumers will perceive the applied-for mark as primarily merely a surname. *In re Six Continents Ltd.*, 2022 USPQ2d 135, at *4 (TTAB 2022); *In re tapio*, 2020 USPQ2d 11387, at *8.

The Trademark Trial and Appeal Board has identified five examples of inquiries that may lead to evidence regarding the public's perception of a term's primary significance:

(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 (*see* TMEP §1211.02(b)(iv));
(3) whether the term has any recognized meaning other than as a surname (*see* TMEP §§1211.01(a)–1211.01(a)(vii));
(4) whether it has the "structure and pronunciation" 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 Colors in Optics, Ltd., 2020 USPQ2d 53784, at *1-2 (TTAB 2020) (citing *In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1333-34 (TTAB 1995)). Where the mark is in standard characters, it is unnecessary to consider the fifth inquiry. *In re Yeley*, 85 USPQ2d 1150, 1151 (TTAB 2007).

These inquiries are not exclusive and any of these circumstances, singly or in combination, as well as any other relevant circumstances, may be considered when making this determination. *In re Six Continents Ltd.*, 2022 USPQ2d 135, at *54 (citing *In re tapio GmbH*, 2020 USPQ2d 11387, at *9; *In re Olin Corp.*, 124 USPQ2d 1327, 1330 (TTAB 2017); *Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1480 (TTAB 2017); *In re Integrated Embedded*, 120 USPQ2d 1504, 1506 n.4 (TTAB 2016)).

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. *In re Yeley*, 85 USPQ2d at 1151; *In re Benthin*, 37 USPQ2d at 1334.

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. Evidence that a term has no recognized meaning other than as a surname further supports a determination that its primary significance is as a surname. *See In re Six Continents Ltd.*, 2022 USPQ2d 135, at *114 (TTAB 2022); *In re tapio GmbH*, 2020 USPQ2d 11387, at *11 (TTAB 2020); *In re Eximius Coffee, LLC*, 120 USPQ2d 1276, 1280 (TTAB 2016)); *In re Isabella Fiore LLC*, 75 USPQ2d 1564, 1566 (TTAB 2005).

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) (holding FIORE 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) (holding the relatively rare surname HACKLER not primarily merely a surname, in light of dictionary meaning); *Fisher Radio Corp. v. Bird Elec. Corp.*, 162 USPQ 265 (TTAB 1969) (holding BIRD not primarily merely a surname despite surname significance); *In re Hunt Elecs. Co.*, 155 USPQ 606 (TTAB 1967) (holding HUNT 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 a term to obviate a refusal under §2(e)(4). *See In re Nelson Souto Major Piquet*, 5 USPQ2d 1367 (TTAB 1987) (holding N. PIQUET (stylized) primarily merely a surname despite significance of the term "piquet" as "the name of a relatively obscure card game"). The mere existence of other non-surname meanings of a term

does not preclude a finding that the term is primarily merely a surname. *Mitchell Miller, P.C. v. Miller*, 105 USPQ2d 1615, 1621 (TTAB 2013) (holding MILLER LAW GROUP primarily merely a surname for legal services despite other meanings of the term "miller"). "The question is not whether a mark having surname significance might also have a non-surname significance, but whether, in the context of the goods or services at issue, that non-surname significance is the mark's primary significance to the purchasing public." *Id.*; *seeIn re Harris-Intertype Corp*., 518 F.2d 629, 631, 186 USPQ 238, 239 (C.C.P.A. 1975) .

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) (holding PICKETT SUITE HOTEL 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) (holding CALISTO 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 *Pickett Hotel Co.*, 229 USPQ 760)). 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 impact of the word. *See In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985) (holding DARTY 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) (holding PETRIN 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 Indus. Operating Corp.*, 195 USPQ 75 (TTAB 1977) (holding FAIRBANKS 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 Pharm. Ltd.*, 27 USPQ2d 1939 (TTAB 1993) (holding HAMILTON 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, 331, 165 USPQ 459, 461 (S.D.N.Y. 1970) (holding 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) (holding 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, 1136 (TTAB 2000) (finding the primary significance of M. C. ESCHER to be that of a famous deceased Dutch artist); *cf. In re Pickett Hotel Co.*, 229 USPQ 760, 762 (TTAB 1986) (holding PICKETT SUITE HOTEL 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, 551 (TTAB 1985) (holding McKINLEY 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) (holding 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) (holding WATSON 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.* at 1290.

1211.01(a)(v) Rare Surnames

The rarity of a surname is a factor to be considered in determining whether a term is primarily merely a surname. *In re Joint-Stock Co. "Baik,"* 84 USPQ2d 1921, 1924 (TTAB 2007) (finding the extreme rarity of BAIK weighed against surname refusal); *In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1333 (TTAB 1995) (finding the fact that BENTHIN was a rare surname 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, 1381 (TTAB 1994) (finding 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) (holding GARAN 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) (holding DARTY primarily merely a surname); *In re Olin Corp.*, 124 USPQ2d 1327, 1330-31 (TTAB 2017) ("'The relevant question is not simply how frequently a surname appears, however, but whether the purchasing public for Applicant's [goods] is more likely to perceive Applicant's proposed mark as a surname rather than as anything else.'" (quoting *In re Beds & Bars Ltd.*, 122 USPQ2d 1546, 1551 (TTAB 2017))); *In re Rebo High Definition Studio Inc.*, 15 USPQ2d 1314 (TTAB 1990) (holding REBO primarily merely a surname); *In re Pohang Iron & Steel Co.*, 230 USPQ 79 (TTAB 1986) (holding POSTEN 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. *SeeIn re Adlon Brand GmbH & Co. KG*, 120 USPQ2d 1717, 1721 (TTAB2016) ("The issue to be determined under the statute is whether the public would perceive the surname significance as the proposed mark's primary significance, not whether the surname is rarely encountered.").

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. *In re Bed & Bars Ltd.*, 122 USPQ2d at 1551 ("[A]lthough BELUSHI is a rare surname in terms of the number of people in the U.S. with that name, it is anything but rare when we consider how many consumers have been exposed to it as a surname, often repeatedly, over the years"). 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, 1795 (TTAB 2004); *cf.In re Eximius Coffee, LLC*, 120 USPQ2d 1276, 1281 (TTAB 2016).

1211.01(a)(vi) "Structure and Pronunciation" 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) (holding PIRELLI primarily merely a surname, the Board stated 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, 904 (TTAB 1986) (holding PETRIN 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, 1222 (TTAB 2000) (finding HACKLER does not have the look and feel of a surname); *see also In re Joint-Stock Co. "Baik,"* 84 USPQ2d 1921, 1923 (TTAB 2007) (finding lack of other recognized meaning does not in itself imbue a mark with the "look and feel" of a surname).

Examining attorneys may submit evidence that the public would perceive a term to have surname significance due to its structure or pronunciation. *In re Six Continents Ltd.*, 2022 USPQ2d 135, at *13 (TTAB 2022); *In re Eximius Coffee, LLC*, 120 USPQ2d 1276, 1280 (TTAB 2016). For example, the examining attorney may compare the mark at issue to other common surnames that are configured similarly and sound similar. *In re tapio GmbH*, 2020 USPQ2d 11387, at *12 (TTAB 2020) (citing *In re Eximius Coffee*, 120 USPQ2d at 1280)); *see In re Six Continents Ltd.*, 2022 USPQ2d 135, at *13-15. In such cases, the examining attorney must provide evidence to show that the public would be likely to perceive the mark as a surname due to the similar structure and pronunciation, such as evidence that the terms to which the mark is being compared are common surnames to which the public has been exposed. *In re Eximius Coffee*, 120 USPQ2d at 1280; *see also In re Bed & Bars Ltd.*, 122 USPQ2d 1546, 1551 (TTAB 2017) (Board noting that it would require evidence bearing on how members of the public would perceive the structure and sound of BELUSHI and whether they would be likely to perceive the proposed mark as similar or dissimilar in structure and sound to other surnames, common words, or coined terms); *In re Adlon Brand GmbH & Co. KG*, 120 USPQ2d 1717, 1724 (TTAB 2016)(noting that "[t]he mere sharing of a prefix, suffix or letter string does not result in the sort of structural similarity that is helpful to [the surname] analysis" and that arguments about surname structure and pronunciation "would require more objective evidence . . . of how members of the public would perceive the structure and sound of [the applied-for mark] and whether they would be likely to perceive it as similar to the structure and sound of other surnames, common words or coined terms").

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) (holding 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 Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1377, 73 USPQ2d 1689, 1696 (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, 95 (TTAB 1984) (finding 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 *In re Isabella 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.

In *In re Weiss Watch Co.*, 123 USPQ2d 1200 (TTAB 2017), the Board determined that application of the doctrine of foreign equivalents was not appropriate. *Id.* at 1205. Applicant argued that WEISS means "white" in German and supported its argument with evidence from on online translation tool. The evidence indicated, however, that in German the word "white" is spelled as "Weiß" (with the German letter eszett), rather than WEISS. *Id.* at 1204. Moreover, the evidence did not show that WEISS spelled without the eszett translates to "white" in English. *Id.* The fact that the applied-for mark WEISS was not spelled in the standard German dictionary form of Weiß weighed against a finding that German speakers, upon seeing WEISS, would stop and transliterate first to Weiß and then translate to "white" in English. *Id.* at 1205.

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) .

See TMEP §§809–809.03 for information regarding how to ascertain the meaning of non-English wording in a mark.

See also TMEP §§1207.01(b)(vi)–1207.01(b)(vi)(C), 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 as a whole would be perceived by the public primarily merely as a surname. *In re Hutchinson Tech. Inc.*, 852 F.2d 552, 554, 7 USPQ2d 1490, 1492 (Fed. Cir. 1988). The determination involves assessing the distinctiveness of the additional matter and whether its addition to the surname alters the primary significance of the mark as a whole to the purchasing public. *Earnhardt v. Kerry Earnhardt, Inc.*, 864 F.3d 1374, 123 USPQ2d 1411, 1415 (Fed. Cir. 2017). See TMEP §§1211.01(b)(i)–1211.01(b)(viii) 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, 873, 152 USPQ 563, 566 (C.C.P.A. 1967) (holding SCHAUB-LORENZ 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 Mgmt. GmbH*, 37 USPQ2d 1332, 1334 (TTAB 1995) (finding stylized display of term BENTHIN 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) (holding PICKETT SUITE HOTEL 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 Mktg. Corp.*, 204 USPQ 675, 677 (TTAB 1979).

1211.01(b)(iii) Surname Combined with Initials

In all cases involving a surname preceded by one or more initials, the factual record "matters most" when making findings regarding consumer perception. *In re Colors in Optics*, 2020 USPQ2d 53784, at *3 (TTAB 2020). 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, 1414 (TTAB 2010) (holding that the initials P.J. coupled with the surname Fitzpatrick would be perceived as a given name and comprised a personal name, not primarily merely a surname); *see In re Yeley*, 85 USPQ2d 1150, 1153 (TTAB 2007) (holding J.J. YELEY would be perceived as referencing a particular person, not primarily merely a surname, because J.J. Yeley was recognized as the full name of a well-known NASCAR race driver); *Michael S. Sachs Inc. v. Cordon Art B.V.*, 56 USPQ2d 1132, 1136 (TTAB 2000) (holding 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.").

Marks consisting of a single initial preceding a surname have been held to be primarily merely a surname. *See In re I. Lewis Cigar Mfg. Co.*, 205 F.2d 204, 206, 98 USPQ 265, 267 (C.C.P.A. 1953); *In re Colors in Optics, Ltd.*, 2020 USPQ2d 53784, at *4. However, the Board has noted that there is no per se rule that a single initial preceding a surname must be deemed primarily merely a surname. *See In re Colors in Optics*, 2020 USPQ2d 53784, at *4 (quoting *In re Yeley*, 85 USPQ2d at 1154). For example, a surname preceded by one initial may 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. *See In re P.J. Fitzpatrick*, 95 USPQ2d at 1413 (discussing *In re I. Lewis Cigar*, 205 F.2d at 206, 98 USPQ at 267). Thus, 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 be perceived as a personal name by the relevant consumers. *See In re Colors in Optics*, 2020 USPQ2d 53784, at *2-3. An applicant could show that such a mark is the name of a particular individual, such as the applicant or a signatory of the applicant, and provide evidence showing it would be recognized as such by the consuming public. *See id.* (holding J HUTTON primarily merely a surname rather than a personal name where no evidence was submitted to show Jade Hutton, an individual associated with applicant, went by or was known by J. Hutton and how the term was used, and she had signed a written consent Jade Hutton rather than J. Hutton). An applicant, however, must provide evidence that the mark would be perceived as a personal name by the relevant consumers, not argument alone. *Id.* at *4 (citing *In re U.S. Tsubaki, Inc.*, 109 USPQ2d 2002, 2007 (TTAB 2014)).

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), 1206.04(a). If the name in the mark is identical to the name of the applicant or to a signer of the application (e.g., the mark is A. JONES and the applicant's name or signatory is A. Jones), written consent is not necessary. In such cases, consent is presumed, but the examining attorney must ensure that a consent statement is entered into the Trademark database. *See*TMEP §§813, 813.01(a), 1206.04(b).

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) (affirming Board decision holding that DR. RATH was primarily merely a surname); *In re Giger*, 78 USPQ2d 1405 (TTAB 2006) (holding GIGER MD primarily merely a surname); *In re Revillon*, 154 USPQ 494 (TTAB 1967) (holding MLLE. REVILLON primarily merely a surname); *cf. In re Hilton Hotels Corp.*, 166 USPQ 216, 217 (TTAB 1970) (holding LADY HILTON 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 Bed & Bars Ltd.*, 122 USPQ2d 1546, 1551 (TTAB 2017) (noting that presenting BELUSHI in the possessive form "is consistent with perception of the term as a surname"); *Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1481 (TTAB 2017) (noting that "the possessive form of the term AZEKA'S, as used in the proposed mark AZEKA'S RIBS, is consistent with perception of the term as a surname"); *In re Binion*, 93 USPQ2d 1531 (TTAB 2009) (holding BINION and BINION'S primarily merely a surname); *In re Woolley's Petite Suites*, 18 USPQ2d 1810 (TTAB 1991) (holding WOOLLEY'S PETITE SUITES for hotel and motel services primarily merely a surname); *In re McDonald's Corp.*, 230 USPQ 304, 306 (TTAB 1986) (holding MCDONALD'S 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) (holding BURDONS primarily merely a surname based in part on telephone listings showing surname significance of "Burdon"); *In re Directional Mktg. Corp.*, 204 USPQ 675 (TTAB 1979) (holding DRUMMONDS primarily merely a surname based on a showing of surname significance of "Drummond").

1211.01(b)(vi) Surname Combined with Additional Wording

When a mark is comprised of a term that, standing by itself, is primarily merely a surname, combined with additional wording, the distinctiveness of the additional wording is relevant to determining whether the primary significance of the mark as a whole is that of a surname. *Earnhardt v. Kerry Earnhardt, Inc.*, 864 F.3d 1374, 1380-81, 123 USPQ2d 1411, 1415 (Fed. Cir. 2017). The inquiry is not limited only to the question of whether the additional matter is capable of functioning as a mark. *Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1482 n.9 (TTAB 2017) (construing *In re Hutchinson Tech. Inc.*, 852 F.2d 552, 554, 7 USPQ2d 1490, 1492-93 (Fed. Cir. 1988)). The additional term(s) must be evaluated to determine whether they are generic or merely descriptive. *Earnhardt v. Kerry Earnhardt, Inc.*, 864 F.3d at 1380-81, 123 USPQ2d at 1415. In addition, the meaning of the mark as a whole must be assessed to determine whether adding the additional term to the surname alters the primary significance of the mark as a whole. *Id.* at 1381 (remanding to the Board to determine both whether the term COLLECTION in the mark EARNHARDT COLLECTION is merely descriptive and the primary significance of the mark as a whole to the purchasing public).

Merely descriptive terms that have not acquired distinctiveness do not have source-identifying significance and—like generic terms—when added to a surname will typically not alter the primary surname significance of the mark as a whole. *In re Six Continents Ltd.*, 2022 USPQ2d 135, at *26-28, *30 (TTAB 2022) (holding ATWELL SUITES for hotel and other related services primarily merely a surname); *Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477 at n.9 (holding AZEKA'S RIBS for barbecue sauce primarily merely a surname). See TMEP §1209.01(b) regarding merely descriptive marks and TMEP §1209.01(c) regarding generic terms. If the policy were otherwise, one could evade Trademark Act §2(e)(4) by the easy expedient of adding merely descriptive matter or the generic name of the goods or services to a word that is primarily merely a surname. *See In re Weiss Watch Co.*, 123 USPQ2d 1200 (TTAB 2017) (holding WEISS WATCH COMPANY for clocks, watches, and related goods primarily merely a surname); *In re Integrated Embedded*, 120 USPQ2d 1504 (holding BARR GROUP for training, engineering, and expert witness services in the field of computer hardware and software primarily merely a surname); *Mitchell Miller, P.C. v. Miller*, 105 USPQ2d 1615 (TTAB 2013) (holding MILLER LAW GROUP for legal services primarily merely a surname); *In re Hamilton Pharm. Ltd.*, 27 USPQ2d 1939 (TTAB 1993) (holding HAMILTON PHARMACEUTICALS for pharmaceutical products primarily merely a surname); *In re Cazes*, 21 USPQ2d 1796, 1797 (TTAB 1991) (holding BRASSERIE LIPP 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) (holding WOOLLEY'S PETITE SUITES for hotel and motel services primarily merely a surname); *In re Possis Med., Inc.*, 230 USPQ 72, 73 (TTAB 1986) (holding POSSIS PERFUSION CUP 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) (holding LIQUORE MARTINONI (stylized) for liqueur primarily merely a surname, with "liquore" being the Italian word for "liqueur").

If the structure of the mark is "surname + additional wording" and none of the additional wording is inherently distinctive or has acquired distinctiveness, refusal of the entire mark under §2(e)(4) will be appropriate in most circumstances. Note that when the wording following the surname is geographic in nature, the wording should be assessed for whether standing alone it would be considered geographically descriptive or geographically deceptively misdescriptive of the applied-for goods or services. For example, if the geographic meaning of the additional term is obscure, then its addition to a surname would normally result in a combination that does not have the primary significance of a surname and the mark as a whole would not be considered to be primarily merely a surname under §2(e)(4).

If the wording combined with the surname is inherently distinctive (i.e., matter that is fanciful, arbitrary, or suggestive), the mark is not considered to be primarily merely a surname under §2(e)(4).

Some wording may enhance rather than diminish the surname significance of the mark. *See In re Piano Factory Grp. Inc.*, 85 USPQ2d 1522, 1527 (TTAB 2006) (finding 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 TMEP §1211.01(b)(iv) regarding surnames combined with titles, §1211.01(b)(iii) regarding surnames combined with initials, and §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. *SeeIn 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 re Piano Factory Grp. Inc*., 85 USPQ2d 1522 (TTAB 2006) (holding VOSE & SONS 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 Grp. 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. *In re J.J. Yeley*, 85 USPQ2d 1150, 1151 (TTAB 2007) (citing *In re Etablissements Darty et Fils*, 759 F.2d 15, 17, 225 USPQ 652, 653 (Fed. Cir. 1985)). The burden then shifts to the applicant to rebut this showing. *In re Colors in Optics, Ltd.*, 2020 USPQ2d 53784, at *3 (TTAB 2020) (citing *In re Hutchinson Tech. Inc.*, 852 F.2d 552, 553-54, 7 USPQ2d 1490, 1492 (Fed. Cir. 1988)). Evidence submitted by an examining attorney has been found in some cases to be insufficient to establish a prima facie case. *E.g.*, *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 833, 184 USPQ 421, 422 (C.C.P.A. 1975) (finding six telephone directory listings insufficient to establish a prima facie case); *In re BDH Two Inc.*, 26 USPQ2d 1556, 1558 (TTAB 1993) (finding twenty-one telephone directory listings, eleven excerpts from a research database, primarily from foreign publications, and a dictionary page showing no listing for the proposed mark insufficient to establish a prima facie case); *In re Raivico*, 9 USPQ2d 2006, 2006-07 (TTAB 1988) (finding applicant's statement that the mark is a surname and the specimens insufficient to establish a prima facie case).

There is no rule as to the kind or amount of evidence necessary to make a prima facie showing that a term is primarily merely a surname. *In re tapio GmbH*, 2020 USPQ2d 11387, at *8 (TTAB 2020); *In re Olin Corp.*, 124 USPQ2d 1327, 1330 (TTAB 2017). "This question must be resolved on a case-by-case basis." *In re tapio*, 2020 USPQ2d 11387, at *8, (citing *In re Etablissements Darty et Fils*, 759 F.2d at 17, 225 USPQ at 653); *see In re Olin*, 124 USPQ2d at 1330. The entire record is examined to determine the primary significance of a term. *In re Six Continents Ltd.*, 2022 USPQ2d 135, at *4 (TTAB 2022); *In re tapio GmbH*, 2020 USPQ2d 11387, at *8; *In re Olin Corp.*, 124 USPQ2d at 1330. 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 at 17, 225 USPQ at 653.

See TMEP §§710–710.03 and 1211.02(b)–1211.02(b)(vii) 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)–1211.02(b)(vii) 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 and similar electronic databases, such as the LexisNexis® surname database (which is a regularly updated nationwide directory of mobile phone numbers and other numbers, and the names with which they are associated) are a type of evidence of the surname significance of a term. *See In re tapio GmbH*, 2020 USPQ2d 11387, at *9 (TTAB 2020) (finding evidence from the LexisNexis® surname database and whitepages.com database probative to show surname significance);*In re Integrated Embedded*, 120 USPQ2d 1504, 1507 (TTAB 2016)(finding evidence from the LexisNexis® surname database probative to show surname significance); *In re Petrin Corp.*, 231 USPQ 902, 903 (TTAB 1986) (finding evidence from telephone directories and the LexisNexis® research database probative to show surname significance). 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. *In re Petrin Corp.*, 231 USPQ 902,at 903 (TTAB 1986); (citing *In re Wickuler-Kupper-Brauerei KGaA*, 221 USPQ 469, 470 (TTAB 1983)).

It is the American public's perception of a term that is determinative. Therefore, telephone directory listings from foreign sources are generally of little probative value unless they are shown to be accessible and relevant to the purchasing public in the United States, regardless of whether the applicant is of foreign origin. *In re tapio*, 2020 USPQ2d 11387, at *9 n.31 (citing *In re Wickuler-Kupper-Brauerei*, 221 USPQ at 470 n.2); *See Société Civile Des Domaines Dourthe Frères v. S.A. Consortium Vinicole De Bordeaux Et De La Gironde*, 6 USPQ2d 1205, 1208 (TTAB 1988).

See TMEP §710.01(a) regarding the requirements for providing evidence from research databases in Office actions and §1211.02(b)(ii) regarding providing evidence from the LexisNexis® research database for surname significance.

1211.02(b)(ii) LexisNexis® Research Database Evidence

Excerpted newspaper, magazine, and newswire articles from the LexisNexis® research database are one type of evidence of the surname significance of a term. *See In re Petrin Corp.*, 231 USPQ 902, 903 (TTAB 1986). There is no requirement that the examining attorney make of record every article found in a LexisNexis® search. However, the examining attorney is presumed to make the best case possible. *See In re Federated Dep't 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.") See TMEP §710.01(b) regarding evidence originating in foreign publications.

Examining attorneys may also show surname significance by providing evidence of the total number of occurrences of a particular surname in the LexisNexis® surname database, which is a regularly updated nationwide directory of mobile phone numbers and other numbers (such VOIP numbers) and the names with which they are associated. See TMEP §710.01(a) regarding the requirements for providing evidence

from research databases in Office actions and §1211.02(b)(i) regarding providing evidence from telephone directory databases for surname significance.

1211.02(b)(iii) U.S. Census Database Evidence

The U.S. Census Bureau's database of surnames, (**https://www.census.gov/topics/population/genealogy/data/2010_surnames.html**), which is taken from the most recent decennial census, is one type of evidence of the surname significance of a term. *See, e.g.*, *In re Olin Corp.*, 124 USPQ2d 1327, 1331 (TTAB 2017); *In re Weiss Watch Co.*, 123 USPQ2d 1200, 1203 (TTAB 2017). The surnames in this database 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. See TMEP §710.01(a) regarding the requirements for providing evidence from research databases in Office actions, and §1211.02(b)(i) regarding providing evidence from telephone directory databases for surname significance.

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, e.g.*, *In re Etablissements Darty et Fils*, 759 F.2d 15, 17, 225 USPQ 652, 653 (Fed. Cir. 1985); *In re Colors in Optics, Ltd.*, 2020 USPQ2d 53784, at *3 (TTAB 2020); *In re Olin Corp.*, 124 USPQ2d 1327, 1332 (TTAB 2017); *In re Weiss Watch Co.*, 123 USPQ2d 1200, 1203 (TTAB 2017); *In re Eximius Coffee, LLC*, 120 USPQ2d 1276, 1278-80 (TTAB 2016). However, the lack of such an association does not necessarily reduce the likelihood that the mark would be perceived as a surname. *See In re Six Continents Ltd.*, 2022 USPQ2d 135, at *11 (TTAB 2022); *In re tapio GmbH*, 2020 USPQ2d 11387, at *11 (TTAB 2020); *In re Gregory*, 70 USPQ2d 1792, 1795 (TTAB 2004); *In re Adlon Brand GmbH & Co. KG*, 120 USPQ2d 1717, 1724 (TTAB 2016).

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 In re Integrated Embedded*, 120 USPQ2d 1504, 1510 (TTAB 2016)(holding BARR GROUP primarily merely a surname, noting evidence that applicant's co-founder, Michael Barr, is prominently featured on specimens, which also indicate that applicant derived its name from him);*In re Eximius Coffee, LLC* 120 USPQ2d 1276, 1279 (TTAB 2016)(holding ALDECOA primarily merely a surname, noting applicant's presentation of the mark with the phrase "Premium Family Coffee" on packaging for the goods); *Société Civile Des Domaines Dourthe Frères v. S.A. Consortium Vinicole De Bordeaux Et De La Gironde*, 6 USPQ2d 1205, 1208 (TTAB 1988) (holding DOURTHE primarily merely a surname, the Board noted applicant's references to "Dourthe" as the name of a particular family and found 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) (holding J. TAVERNITI primarily merely a surname, the Board considered, 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) (holding BURDONS primarily merely a surname, the Board weighted 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. *In re Six Continents Ltd.*, 2022 USPQ2d 135, at *10-11 (TTAB 2022) ("The evidence that 'Atwell' has no other recognized meaning supports finding that 'Atwell' is primarily merely a surname."); *In re Olin Corp.*, 124 USPQ2d 1327, 1331 (TTAB 2017) (finding, in the absence of any countervailing evidence, that negative dictionary evidence established that OLIN has no recognized meaning other than as a surname); *In re Adlon Brand GmbH & Co. KG*, 120 USPQ2d 1717, 1719-20 (TTAB 2016)) (finding negative dictionary evidence supported that ADLON had no meaning other than as a surname); *In re Eximius Coffee, LLC*, 120 USPQ2d 1276, 1280 (TTAB 2016) ("The evidence that ALDECOA has no other recognized meaning further supports the Examining Attorney's case that its primary significance is as a surname.").

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) (holding McDonald's 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 Olin Corp.*, 124 USPQ2d 1327, 1329 (TTAB 2017); *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564, 1565 (TTAB 1988); *In re Nelson Souto Major Piquet*, 5 USPQ2d 1367, 1368 (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 trademark or service 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). 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., 840 F.2d 1572, 1580, 6 USPQ2d 1001, 1007 (Fed. Cir. 1988) (citation omitted) (quoting *In re Cap. Formation Couns., 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. 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. 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) (citations omitted).

Three basic types of evidence may be used to establish acquired distinctiveness under §2(f) for a trademark or service mark:

(1) *Prior Registrations* : A claim of ownership of one or more active prior registrations on the Principal Register of the same mark for goods or services that are sufficiently similar to those identified in the pending application (37 C.F.R. §2.41(a)(1); *see*TMEP §§1212.04–1212.04(e));
(2) *Five Years' Use* : A verified statement that the mark has become distinctive of the applicant's goods or services by reason of the applicant's substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made (37 C.F.R. §2.41(a)(2); *see*TMEP §§1212.05–1212.05(d)); and
(3) *Other Evidence* : Other appropriate evidence of acquired distinctiveness (37 C.F.R. §2.41(a)(3); *see*TMEP §§1212.06–1212.06(e)(iv)).

These three basic types of evidence apply similarly to collective trademarks, collective service marks, and collective membership marks (together "collective marks"), and certification marks, with slight modifications regarding the type of evidence required due to (1) the different function and purpose of collective and certification marks and (2) the fact that these types of marks are used by someone other than the applicant. *See* 37 C.F.R. §2.41(b)-(d).

(1) *Prior Registrations* : A claim of ownership of one or more active prior registrations on the Principal Register of the same mark for: goods or services that are sufficiently similar to those identified in the pending application, for a collective trademark or collective service mark (37 C.F.R. §2.41(b)(1); *cf.* TMEP §§1212.04–1212.04(e)); goods, services, or nature of the collective membership organization that are sufficiently similar to those identified in the pending application, for a collective membership mark (37 C.F.R. §2.41(c)(1); *cf.* TMEP §§1212.04–1212.04(e)); and goods or services that are sufficiently similar to the goods or services certified in the pending application, for a certification mark (37 C.F.R. §2.41(d)(1)); *cf.*TMEP §§1212.04–1212.04(e));

(2) *Five Years' Use* : A verified statement that the mark has become distinctive of: the members' goods or services by reason of the members' substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made, for a collective trademark or collective service mark (37 C.F.R. §2.41(b)(2); TMEP §1212.05(d)); indicating membership in the applicant's collective membership organization by reason of the members' substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made, for a collective membership organization (37 C.F.R. §2.41(c)(2); TMEP §1212.05(d)); or the certified goods or services, by reason of the authorized users' substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made, for a certification mark (37 C.F.R. §2.41(d)(2); TMEP §1212.05(d)); and

(3) *Other Evidence* : Other appropriate evidence of acquired distinctiveness (37 C.F.R. §2.41(b)(3), (c)(3), (d)(3); *cf.*TMEP §§1212.06–1212.06(e)(iv)).

The applicant may submit one or any combination of these types of evidence, which are discussed in more detail below. In addition, see TMEP §1212.01 regarding the factors considered when determining whether a mark has acquired distinctiveness.

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. In which case, the applicant may then submit additional other evidence of acquired distinctiveness.

The legal principles pertaining to evidence of acquired distinctiveness discussed in this section and below with respect to trademarks and service marks apply generally to collective marks and certification marks as well.

1212.01 General Evidentiary Matters

Whether acquired distinctiveness has been established is a question of fact. *Schlafly v. St. Louis Brewery, LLC*, 909 F.3d 420, 423, 128 USPQ2d 1739, 1742 (Fed. Cir. 2018) (citing *In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 1335, 116 USPQ2d 1262, 1264 (Fed. Cir. 2015); *Hoover Co. v. Royal Appliance Mfg. Co.*, 238 F.3d 1357, 1359, 57 USPQ2d 1720, 1722 (Fed. Cir. 2001)) The record must contain facts or evidence of acquired distinctiveness.

The burden of proving that a mark has acquired distinctiveness is on the applicant. *In re La. Fish Fry Prods., Ltd.*, 797 F.3d at, 1335, 116 USPQ2d at 1265 (citing *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005)); *In re Guaranteed Rate, Inc.*, 2020 USPQ2d 10869, at *2 (TTAB 2020) (citing *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1578-79, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988)).

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. *See Ex parte Fox River Paper Corp.*, 99 USPQ 173, 174 (Comm'r Pats. 1953).

"The amount and character of evidence required to establish acquired distinctiveness depends on the facts of each case and the nature of the mark sought to be registered." *In re Gen. Mills IP Holdings II, LLC*, 124 USPQ2d 1016, 1018 (TTAB 2017) (citing *Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 829, 166 USPQ 34, 39 (C.C.P.A. 1970); *In re Hehr Mfg. Co.*, 279 F.2d 526, 528, 126 USPQ 381, 383 (C.C.P.A. 1960)).

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 Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1047 (Fed. Cir. 2018); *In re Steelbuilding.com*, 415 F.3d at 1300, 75 USPQ2d at 1424 (citing *In re Bongrain Int'l (Am.) Corp.*, 894 F.2d 1316, 1318, 13 USPQ2d 1727, 1729 (Fed. Cir. 1990)); *City of London Distillery, Ltd. v. Hayman Grp. Ltd.*, 2020 USPQ2d 11487, at *16 (TTAB 2020) (quoting *In re Greenliant Sys. Ltd.*, 97 USPQ2d 1078, 1085 (TTAB 2010)); *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1767 (TTAB 2013); *In re Seaman & Assocs., Inc.*, 1 USPQ2d 1657, 1659 (TTAB 1986); *In re Packaging Specialists, Inc.*, 221 USPQ 917, 919 (TTAB 1984). *See also Real Foods Pty. v. Frito-Lay N. Am.*, 128 USPQ2d 1370, 1378 (Fed. Cir. 2018) ("while evidence of substantially exclusive and continuous use may be sufficient to prove a prima facie case of acquired distinctiveness, this is not always the case. . . . 'Particularly for a mark that is . . . highly descriptive like [Real Foods' proposed marks], the [TTAB] was within its discretion not to accept [Real Foods'] alleged five years of substantially exclusive and continuous use as prima facie evidence of acquired distinctiveness.'") (internal citations omitted); *In re La. Fish Fry Prods.*, 116 USPQ2d at 1265 (Board has discretion not to accept an applicant's allegation of five years of substantially exclusive and continuous use as prima facie evidence of acquired distinctiveness when the proposed mark is "highly descriptive"). 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. See TMEP §1202.02(b)(i) regarding the heavy evidentiary burden for acquired distinctiveness of trade dress.

If the applicant has one or more prior federal registrations under §2(f) for a different depiction of the same mark (e.g., stylized vs. standard character) or a portion of the proposed mark, for the same goods/services, the examining attorney's review of the records to assess the probative value of the prior registrations may assist in resolving whether the mark in question has acquired distinctiveness, and thereby obviate the necessity of determining the issue on appeal. *In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1713 (TTAB 2011).

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 registration is being sought. *In re Chippendales USA, Inc.*, 622 F.3d 1346, 1354, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (quoting *In re Morton-Norwich Prods., Inc.*, 671 F.2d, 1332, 1344, 213 USPQ 9, 18 (C.C.P.A. 1982)); *Gen. Foods Corp. v. MGD Partners*, 224 USPQ 479, 486 (TTAB 1984) (citing *In re Thunderbird Prods., Corp.*, 406 F.2d 1389, 1391-92, 160 USPQ 730, 732-33 (C.C.P.A. 1969); *Hartford Fire Ins. Co. v. Structured Settlements Co.*, 215 USPQ 1145, 1150 (TTAB 1982)).

In determining whether a mark has acquired distinctiveness, the evidence is considered as a whole, guided by the following factors: (1) association of the applied-for mark with a particular source by actual purchasers (typically measured by customer surveys); (2) length, degree, and exclusivity of use; (3) amount and manner of advertising; (4) amount of sales and number of customers; (5) intentional copying; and (6) unsolicited media coverage of the product embodying the mark. *Converse, Inc. v. ITC*, 909 F.3d 1110, 1120, 128 USPQ2d 1538, 1546 (Fed. Cir. 2018) (*Converse* factors); *City of London Distillery, Ltd.*, 2020 USPQ2d 11487, at *16 (quoting *In re Snowizard, Inc.*, 129 USPQ2d 1001, 1005 (TTAB 2018)); *In re Guaranteed Rate, Inc.*, 2020 USPQ2d 10869, at *2-3. "[N]o single factor is determinative." *In re Steelbuilding.com*, 415 F.3d at 1300, 75 USPQ2d at 1424. Rather, all factors are weighed together in light of all the circumstances to determine whether the mark has acquired distinctiveness. *Id.*

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. *See*TMEP §714.05(a)(i). 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), (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)–1210.05(d)(ii) 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.*, 507 F.2d 1400, 1403 n.3, 184 USPQ 345, 348 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 a concession that the matter to which it pertains is not inherently distinctive and, thus, not registrable on the Principal Register absent proof of acquired distinctiveness. *See Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009) ("Where an applicant seeks registration on the basis of Section 2(f), the mark's descriptiveness is a nonissue; an applicant's reliance on Section 2(f) during prosecution presumes that the mark is descriptive."); *In re Am. Furniture Warehouse CO*, 126 USPQ2d 1400, 1403 (TTAB 2018) (noting that a claim of acquired distinctiveness by applicant to overcome a refusal in a prior registration for the same wording in connection with the same services "can be viewed as a concession by [a]pplicant that the wording itself is not inherently distinctive for those services"). For the purposes of establishing that the subject matter is not inherently distinctive, the examining attorney may rely on this concession alone. 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.* , 840 F.2d 1572, 1577, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988); *In re Guaranteed Rate, Inc.*, 2020 USPQ2d 10869, at *2 (TTAB 2020); *Spiritline Cruises LLC v. Tour Mgmt. Servs., Inc.*, 2020 USPQ2d 48324, at *5 (TTAB 2020); *In re Hikari Sales USA, Inc.*, 2019 USPQ2d 111514, at *1 (TTAB 2019).

However, claiming distinctiveness in the alternative is *not* an admission that the proposed mark is not inherently distinctive. TMEP §1212.02(c).

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 Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1713 (TTAB 2011); *In re E S Robbins Corp.*, 30 USPQ2d 1540, 1542 (TTAB 1992); *In re Prof'l Learning Ctrs., Inc.*, 230 USPQ 70, 71 n.2 (TTAB 1986).

When an applicant claims acquired distinctiveness in the alternative, the examining attorney must 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. *See, e.g., In re Olin Corp.*, 124 USPQ2d 1327, 1329 (TTAB 2107) ("It has long been established . . . that whether a mark is primarily merely a surname and whether it has acquired secondary meaning are separate considerations under the Trademark Act."). If the applicant has one or more prior registrations under §2(f) for a different depiction of the same mark (e.g., stylized vs. standard character) or a portion of the proposed mark, and for the same goods/services, the examining attorney's review of the records of the registrations would reveal whether the applicant previously conceded descriptiveness or whether the Board found the mark descriptive on appeal. *See In re Thomas Nelson*, 97 USPQ2d at 1713. Such an assessment of the probative value of the prior registrations might also assist in resolving whether the mark in question has acquired distinctiveness, thereby obviating the necessity of determining that issue on appeal as well. *Id.*

In the event of an appeal on both grounds, 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 appeal results in a finding of descriptiveness, and also that the mark has acquired distinctiveness, then descriptiveness would be present, even though not conceded by the applicant. *In re Thomas Nelson*, 97 USPQ2d at 1713.

If the examining attorney accepts the §2(f) evidence, the applicant must 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 email, with a Note to the File in the record indicating the applicant's decision, wherever possible. If the applicant wants to appeal, or if the examining attorney is unable to reach the applicant by telephone or email, 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.

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, 1127 (e.g., is generic or purely ornamental) (or §§1, 2, 4, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, 1054, 1127, for collective and certification marks), 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. An applicant may not, however, state that it "reserves the right" to amend to the Supplemental Register if the refusal is not withdrawn or is affirmed on appeal. *In re Integrated Embedded*, 120 USPQ2d 1504, 1511(TTAB 2016) (stating the "[a]pplicant cannot 'reserve a right' that does not exist").

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 must 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 In re Educ. Commc'ns, Inc.*, 231 USPQ 787, 787 (TTAB 1986); *In re Broco*, 225 USPQ 227, 228 (TTAB 1984).

See TMEP §§816–816.05 and §1102.03 regarding amending an 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 must 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 must 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 email. 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 email message (applicant must be given at least three business days), the examining attorney must enter a Note to the File in 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, if otherwise appropriate. 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 resorting 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 should delete the statements from the Trademark database, enter a Note to the File in the record indicating 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." *SeeIn re Creative Goldsmiths of Wash., 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 §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, examining attorneys must focus their 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 for a trademark or service mark:

(1) *Prior Registrations* : A claim of ownership of one or more active prior registrations on the Principal Register of the *relevant portion of the mark* for goods or services that are sufficiently similar to those identified in the pending application (*see* 37 C.F.R. §2.41(a)(1); TMEP §§1212.04–1212.04(e));
(2) *Five Years' Use* : A verified statement that the *relevant portion of the mark* has become distinctive of the applicant's goods or services by reason of the applicant's substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made (*see* 37 C.F.R. §2.41(a)(2); TMEP §§1212.05–1212.05(d)); or
(3) *Other Evidence* : Other appropriate evidence of acquired distinctiveness of the *relevant portion of the mark* (*see* 37 C.F.R. §2.41(a)(3); TMEP §§1212.06–1212.06(e)(iv)).

These three basic types of evidence apply similarly to collective trademarks, collective service marks, and collective membership marks (together "collective marks"), and certification marks, with slight modifications

regarding the type of evidence required due to (1) the different function and purpose of collective and certification marks and (2) the fact that these types of marks are used by someone other than the applicant. *See* 37 C.F.R. §2.41(b)-(d).

(1) *Prior Registrations* : A claim of ownership of one or more active prior registrations on the Principal Register of the relevant portion of the mark for: goods or services that are sufficiently similar to those identified in the pending application, for a collective trademark or collective service mark (37 C.F.R. §2.41(b)(1); *cf.* TMEP §§1212.04–1212.04(e)); goods, services, or nature of the collective membership organization that are sufficiently similar to those identified in the pending application, for a collective membership mark (37 C.F.R. §2.41(c)(1); *cf.* TMEP §§1212.04–1212.04(e)); or goods or services that are sufficiently similar to the goods or services certified in the pending application, for a certification mark (37 C.F.R. §2.41(d)(1); *cf.*TMEP §§1212.04–1212.04(e));

(2) *Five Years' Use* : A verified statement that the relevant portion of the mark has become distinctive of: the members' goods or services by reason of the members' substantially exclusive and continuous use of the relevant portion of the mark in commerce for the five years before the date on which the claim of distinctiveness is made, for a collective trademark or collective service mark (37 C.F.R. §2.41(b)(2); TMEP §1212.05(d)); indicating membership in the applicant's collective organization by reason of the members' substantially exclusive and continuous use of the relevant portion of the mark in commerce for the five years before the date on which the claim of distinctiveness is made, for a collective membership organization (37 C.F.R. §2.41(c)(2); TMEP §1212.05(d)); or the certified goods or services, by reason of the authorized users' substantially exclusive and continuous use of the relevant portion of the mark in commerce for the five years before the date on which the claim of distinctiveness is made, for a certification mark (37 C.F.R. §2.41(d)(2); TMEP §1212.05(d)); and

(3) *Other Evidence* : Other appropriate evidence of acquired distinctiveness of the relevant portion of the mark (37 C.F.R. §2.41(b)(3), (c)(3), (d)(3); *cf.*TMEP §§1212.06–1212.06(e)(iv)).

The applicant may submit one or any combination of these types of evidence. Depending on the nature of the relevant portion 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 in part.

The amount and character of evidence required typically depends on the facts of each case and the nature of the relevant portion of the mark sought to be registered. *See Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 829, 166 USPQ 34, 39 (C.C.P.A. 1970); *In re Hehr Mfg. Co.*, 279 F.2d 526, 528, 126 USPQ 381, 383 (C.C.P.A. 1960) ; *In re Gammon Reel, Inc.*, 227 USPQ 729, 730 (TTAB 1985); TMEP §1212.01. A determination regarding the acceptability of a §2(f) claim depends on the nature of the relevant portion of the mark and/or the nature and sufficiency of the evidence provided by the applicant. *See In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262 (Fed. Cir. 2015) (finding that applicant's evidence of prior registrations did not establish that the specific wording at issue had acquired distinctiveness); TMEP §§1212.04(a), 1212.05(a), 1212.06.

The legal principles pertaining to evidence of acquired distinctiveness in part discussed below with respect to trademarks and service marks apply generally to collective marks and certification marks as well.

1212.02(f)(ii) Appropriate/Inappropriate Situations for Claiming §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 §66(a) applications.

See also TMEP §1212.10 for information on printing §2(f)-in-part notations and limitation statements.

1212.02(f)(ii)(A) Appropriate Situations for Claiming §2(f) in Part

Descriptive Matter Combined with an Inherently Distinctive Element

Claiming §2(f) in part is appropriate when descriptive matter that is combined with an inherently distinctive element, such as arbitrary words or an inherently distinctive design, presents a separate and distinct commercial impression apart from the other matter in the mark and has acquired distinctiveness through use by itself.

For example, if the mark is TASTY SNACKARAMA for potato chips and the applicant can show acquired distinctiveness as to the descriptive word TASTY by itself, 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 SNACKARAMA is inherently distinctive.

Similarly, if the mark is TASTY SNACKARAMA POTATO CHIPS for potato chips and the applicant can show acquired distinctiveness as to TASTY by itself, 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 SNACKARAMA 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 by itself, 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. *See In re Am. Furniture Warehouse CO*, 126 USPQ2d 1400, 1407 (TTAB 2018) ("While a generic term standing alone certainly cannot acquire distinctiveness . . . the generic term may be included in the claim of acquired distinctiveness as long as an accompanying disclaimer of the generic term is provided.").

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 and has acquired distinctiveness through use by itself.

For example, if the mark is TEXAS GOLD for car-cleaning preparations and the applicant, who is based in Texas, can show acquired distinctiveness as to TEXAS by itself, the applicant must limit the claim under §2(f) to the word TEXAS only (i.e., "2(f) in part as to TEXAS") since the term GOLD is inherently distinctive.

Similarly, if the mark is TEXAS combined with an inherently distinctive design element for car-cleaning preparations and the applicant, who is again from Texas, can show acquired distinctiveness as to the wording in the mark, the applicant must limit the claim under §2(f) to the word TEXAS only (i.e., "2(f) in part as to TEXAS").

An applicant may claim §2(f) in part as to wording consisting of both geographically descriptive matter and generic matter if the applicant establishes that the combined wording as a whole has acquired distinctiveness and provides a disclaimer of the generic matter. *See In re Am. Furniture Warehouse CO*, 126 USPQ2d at 1407-08 (TTAB 2018) (accepting a §2(f)-in-part claim as to AMERICAN FURNITURE WAREHOUSE, provided that applicant disclaimed FURNITURE WAREHOUSE).

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 must enter a disclaimer of MOIST MORSELS or, if appropriate, a claim of §2(f) in part as to MOIST MORSELS. Any generic matter included in such a claim must still be disclaimed. *See In re Am. Furniture Warehouse CO*, 126 USPQ2d at 1407-08.

Examining attorneys are not required to offer the applicant the option of claiming §2(f) in part when issuing a disclaimer 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 §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 or otherwise unregistrable component. *See In re Am. Furniture Warehouse CO*, 126 USPQ2d 1400, 1407 (TTAB 2018) ("[A] generic term may be included in the claim of acquired distinctiveness as long as an accompanying disclaimer of the generic term is provided."). See TMEP §1212.02(f)(ii)(A) regarding including generic matter in §2(f)-in-part claims.

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. 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, or vice versa, the examining attorney must issue a new requirement to correct the §2(f) claim. See TMEP §§1212.05(d) and 1212.07 regarding verification of amended §2(f) claims based on five years' use.

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) (affirming requirement for disclaimer of PROVENDER 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 Indus.*,222 USPQ 258 (TTAB 1984) (reversing

requirement for disclaimer of CHOPPER 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 claimed prior registration, the prior registration may not be accepted as prima facie evidence of acquired distinctiveness. *SeeKellogg Co. v. Gen. Mills, Inc.*, 82 USPQ2d 1766, 1771 n.5 (TTAB 2007) ; *In re Candy Bouquet Int'l, Inc.*, 73 USPQ2d 1883, 1889-90 (TTAB 2004); TMEP §1212.04(a). For example, if the mark is TASTY SNACKARAMA for potato chips and the applicant attempts to rely on a prior registration for the mark TASTY combined with an inherently distinctive design, with TASTY disclaimed, for the same goods, to support its claim of acquired distinctiveness as to the descriptive word TASTY, such evidence would not be sufficient since the word TASTY was disclaimed in the prior registration. 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 instead provide a disclaimer of the term TASTY.

Second, when an applicant is claiming §2(f) in part as to only a portion of its mark, 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 multiple-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 will 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 (i.e., §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 Educ. Commc'ns, 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.

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, 243 (TTAB 1970); *In re H. A. Friend & Co.*, 158 USPQ 609, 610 (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. Int'l 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) (finding 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.").

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 Prods. Inc.*, 3 USPQ2d 1714, 1715 (TTAB 1987). *See, e.g., In re Melville Corp.*, 228 USPQ at 971 n.2 ("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 Sys., 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. Mktg. 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, 1554 (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 must also consider whether the applicant's evidence has any bearing on the underlying refusal. See TMEP §§1209.02–1209.02(b) 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, assuming the mark is not functional, applicant's evidence is sufficient to establish that the mark has 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 nonfunctional.

See also In re Wakefern Food Corp., 222 USPQ 76, 79 (TTAB 1984) (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 a 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 Trademark 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 2F 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>.

A separate limitation statement is also required for claims of §2(f) in part. *See*TMEP §1212.10.

1212.03 Three Types of Evidence of Distinctiveness under §2(f)

37 CFR §2.41 Proof of distinctiveness under section 2(f).

(a) For a trademark or service mark.

(1) Ownership of prior registration(s). In appropriate cases, ownership of one or more active prior registrations on the Principal Register or under the Trademark Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness if the goods or services are sufficiently similar to the goods or services in the application; however, further evidence may be required.

(2) Five years substantially exclusive and continuous use in commerce. In appropriate cases, if a trademark or service mark is said to have become distinctive of the applicant's goods or services by reason of the applicant's substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made, a showing by way of verified statements in the application may be accepted as prima facie evidence of distinctiveness; however, further evidence may be required.

(3) Other evidence. In appropriate cases, where the applicant claims that a mark has become distinctive in commerce of the applicant's goods or services, the applicant may, in support of registrability, submit with the application, or in response to a request for evidence or to a refusal to register, verified statements, depositions, or other appropriate evidence showing duration, extent, and nature of the use in commerce and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and verified statements, letters or statements from the trade or public, or both, or other appropriate evidence of distinctiveness.

See also 37 C.F.R. §2.41(b)-(d) (for collective and certification marks).

"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 Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.11, 214 USPQ 1, 4 n.11 (1982).

1212.04 Prior Registrations as Proof of Distinctiveness

Trademark Rule 2.41(a)(1), 37 C.F.R. §2.41(a)(1), provides that the examining attorney may accept, as prima facie evidence of acquired distinctiveness, ownership by the applicant of one or more active 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 §§1212.09–1212.09(b) concerning §1(b) applications.

The rule states that, "in appropriate cases," ownership of existing registrations to establish acquired distinctiveness "may be accepted as sufficient prima facie evidence of distinctiveness," but that the USPTO may, at its option, require additional evidence of distinctiveness. *In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262 (Fed. Cir. 2015); *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1347, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001); *In re Loew's Theatres, Inc.*, 769 F.2d 764, 769, 226 USPQ 865, 869 (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 an active prior registration on the Principal Register for sufficiently 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, 769, 226 USPQ 865, 869 (Fed. Cir. 1985); *In re Guaranteed Rate, Inc.*, 2020 USPQ2d 10869, at *9 (TTAB 2020); *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1234 (TTAB 2014), *aff'd*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016).

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. Gen. Mills, Inc.*, 82 USPQ2d 1766, 1771 n.5 (TTAB 2007); *In re Candy Bouquet Int'l, Inc.*, 73 USPQ2d 1883, 1889-90 (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(a)(1) 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*, 96 USPQ2d 1414, 1423 (TTAB 2010) (finding three-dimensional product packaging trade dress mark is not the legal equivalent of a two-dimensional design logo); *In re Nielsen Bus. Media, Inc.*, 93 USPQ2d 1545, 1547-48 (TTAB 2010) (finding 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, 1539 (TTAB 2009) (finding 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 Prods. Co.*, 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, 1159, 17 USPQ2d 1866, 1868 (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) as to only a portion of its mark, then the previously registered mark must be the legal equivalent of the relevant portion for which the applicant is claiming acquired distinctiveness. See TMEP §1212.02(f) regarding claims of acquired distinctiveness as to a portion of a mark.

1212.04(c) Goods or Services Must be "Sufficiently Similar"

The examining attorney must determine whether the goods or services identified in the application are "sufficiently similar" to the goods or services identified in the active prior registration(s) on the Principal Register. *See* 37 C.F.R. §2.41(a)(1). If the similarity or relatedness is self-evident, the examining attorney may generally accept the §2(f) claim without additional evidence. This is most likely to occur with ordinary consumer goods or services where the nature and function or purpose 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).

If the similarity or relatedness of the goods or services in the application and prior registration(s) is not self-evident, the examining attorney may not accept the §2(f) claim without evidence and an explanation demonstrating the purported similarity or relatedness between the goods or services. This is likely to occur with industrial goods or services where there may in fact be a high degree of similarity or 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 Prods. Co.*, 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) (holding applicant's ownership of prior registration of LIBBEY for cut-glass articles acceptable as prima facie evidence of distinctiveness of identical mark for plastic tableware, the Board stated, "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 Eng'g & Mfg. Co.*, 125 USPQ 308, 309 (TTAB 1960) (holding applicant's ownership of prior registration

of LYTLE for various services, including the planning, preparation, and production of technical publications, 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(a)(1), 37 C.F.R. §2.41(a)(1), states that ownership of an active 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) may not be based on ownership of registrations on the Supplemental Register. *See In re Canron, Inc.*, 219 USPQ 820, 822n.2 (TTAB 1983).

Additionally, a claim of acquired distinctiveness may not be based on a registration that is cancelled or expired. *See* 37 C.F.R. §2.41(a)(1); *In re Info. Builders, Inc.*, 2020 USPQ2d 10444, at *6 n.19 (TTAB 2020);*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) for a trademark or service mark on the basis of ownership of one or more prior registrations:

> The mark has become distinctive of the goods and/or services as evidenced by ownership of active U.S. Registration No(s). _____ on the Principal Register for the same mark for sufficiently similar goods and/or services.

See 37 C.F.R. §2.41(a)(1).

If the applicant is relying solely on its ownership of one or more active prior registrations on the Principal Register 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 in commerce with the applicant's goods or services. *See* 37 C.F.R. §2.41(a)(2).

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, Pub. L. No. 100-667, 102 Stat. 3935 (1988), 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(a)(2) 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. *In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 1336-37, 116 USPQ2d 1262, 1265 (Fed. Cir. 2015) (noting that the statute does not require the USPTO to accept five years' use as prima facie evidence of acquired distinctiveness). Whether a claim of five years' use will be deemed sufficient to establish that the mark has acquired distinctiveness depends largely on the nature of the mark in relation to the specified goods, services, or classes.

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.

For marks refused under §2(e)(1) or §2(e)(2), the amount of evidence necessary to establish secondary meaning varies. "[T]he greater the degree of descriptiveness the 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) (citing *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1581, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988)); *see also Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 1368-69, 127 USPQ2d 1041, 1047 (Fed. Cir. 2018). For terms with a greater degree of descriptiveness, statements of length of use alone generally will not be sufficient to establish acquired distinctiveness. *See, e.g., In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 1336-37, 116 USPQ2d 1262, 1265 (Fed. Cir. 2015) (holding that the Board was within its discretion not to accept applicant's allegation of five years' use given the highly descriptive nature of the mark); *Spiritline Cruises LLC v. Tour Mgmt. Servs. Inc.*, 2020 USPQ2d 48324, at *11 (TTAB 2020) (holding applicant's claim of use since 2003 not sufficient to show the mark CHARLESTON HARBOR TOURS had become distinctive because the term was highly geographically descriptive); *In re Yarnell Ice Cream, LLC*, 2019 USPQ2d 265039, at *10-11 (TTAB 2019) (holding applicant's claim of use since 2012 not sufficient to show the mark SCOOP had become distinctive for ice cream because other circumstances undercut the significance of this claim of extended use); *In re Virtual Indep. Paralegals, LLC*, 2019 USPQ2d 111512, at *11-12 (TTAB 2019) (holding applicant's claim of use for the last five years not sufficient to show the mark VIRTUAL INDEPENDENT PARALEGALS had become distinctive for various paralegal services due to the highly descriptive nature of the proposed mark); *Apollo Med. Extrusion Techs., Inc. v. Med. Extrusion Techs., Inc.*, 123 USPQ2d 1844, 1856 (TTAB 2017) (finding, despite applicant's claim of use since 1991, that much more evidence, especially in the quantity of direct evidence from the relevant purchasing public, would be necessary to show that the designation MEDICAL EXTRUSION TECHNOLOGIES has become distinctive for Applicant's medical extrusion goods); *In re Crystal Geyser Water Co.*, 85 USPQ2d 1374 (TTAB 2007) (holding applicant's evidence of acquired distinctiveness, including a claim of use since 1990, sales of more than 7,650,000,000 units of its goods, and extensive display of its mark CRYSTAL GEYSER ALPINE SPRING WATER on advertising and delivery trucks and promotional paraphernalia, insufficient to establish that the highly descriptive phrase ALPINE SPRING WATER had acquired distinctiveness for applicant's bottled spring water); *In re Kalmbach Publ'g Co.*, 14 USPQ2d 1490 (TTAB 1989) (holding applicant's sole evidence of acquired distinctiveness, a claim of use since 1975, insufficient to establish that the highly descriptive, if not generic, designation RADIO CONTROL BUYERS GUIDE had become distinctive of applicant's magazines).

For matter that is not inherently distinctive because of its nature (e.g., nondistinctive product design, 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, services, or classes 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 Commc'ns, Inc. v. Motorola, Inc.*, 91 USPQ2d 1393, 1401 (TTAB 2009) (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 Black & Decker Corp.*, 81 USPQ2d 1841, 1844 (TTAB 2006) (finding 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 included twenty-four 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 Pharm., 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 in commerce does not have to be exclusive, but must be "substantially" exclusive. 15 U.S.C. §1052(f); 37 C.F.R. §2.41(a)(2). 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, 1352, 52 USPQ2d 1307, 1309 (Fed. Cir. 1999). Thus, when evaluating whether an applicant has had "substantially" exclusive use of a mark, the determination is based on "whether any use by a third party [is] 'significant' or whether it [is] merely 'inconsequential or infringing.'" *Galperti, Inc. v. Galperti S.R.L.*, 17 F.4th 1144, 1147, 2021 USPQ2d 1115, at *2 (Fed. Cir. 2021).

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 significant or does not otherwise nullify the claim of distinctiveness. *See Galperti, Inc.*, 17 F.4th at 1148, 2021 USPQ2d 1115, at *4 ("a significant amount of marketplace use of a term not as a source identifier for those users does tend to undermine an applicant's assertion that its own use has been substantially exclusive"); *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."); *In re Jasmin Larian, LLC*, 2022 USPQ2d 290, at *40-41 (TTAB 2022) (finding "the widespread use, sale of and discussions/comments about bamboo handbag designs similar to [a]pplicant's applied-for mark" showed that "[a]pplicant's use [was] not 'substantially exclusive'"); *In re Dimarzio, Inc.*, 2021 USPQ2d 1191, at *13-25 (TTAB 2021) (finding the examining attorney's evidence of extensive third-party use of applicant's proposed color mark on the same goods showed that applicant's use was not substantially exclusive); *Spiritline Cruises LLC v. Tour Mgmt. Servs. Inc.*, 2020 USPQ2d 48324, at *11 (TTAB 2020) (finding "the substantially non-exclusive use of CHARLESTON HARBOR TOURS . . . interfere[d] with the relevant public's perception of the designation as an indicator of a single source"); *In re MK Diamond Prods., Inc.*, 2020 USPQ2d 10882, at *21 (TTAB 2020) ("[w]hile absolute exclusivity is not required for a Section 2(f) registration, . . . the widespread use of other substantially similar [designs] . . . is inconsistent with the 'substantially exclusive' use required by the statute"); *Milwaukee Elec. Tool Corp. v. Freud Am., Inc.*, 2019 USPQ2d 460354, at *25 (TTAB 2019) (finding evidence of third-party use

of the proposed mark showed that registrant's use had not been "substantially exclusive either at the time of registration or thereafter"); *In re Gen. Mills IP Holdings II, LLC*, 124 USPQ2d 1016, 1024 (TTAB 2017) (finding that "the presence in the market of yellow-packaged cereals from various sources . . . would tend to detract from any public perception of the predominantly yellow background as a source-indicator pointing solely to Applicant"); *Ayoub, Inc. v. ACS Ayoub Carpet Serv.*, 118 USPQ2d 1392, 1404 (TTAB 2016) (finding that, because of widespread third-party uses of the surname Ayoub in connection with rug, carpet and flooring businesses, applicant's use of the applied-for mark, AYOUB, was not "substantially exclusive" and thus the mark had not acquired distinctiveness in connection with applicant's identified carpet and rug services); *Nextel Commc'ns, Inc. v. Motorola, Inc.*, 91 USPQ2d 1393, 1408 (TTAB 2009) (finding 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) (finding 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 Indus. 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 also be continuous, without a period of "nonuse" or suspension of trade in the goods or services in connection with which the mark is used. 15 U.S.C. §1052(f); 37 C.F.R. §2.41(a)(2).

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, 793 (TTAB 1984) (finding 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) (holding declarations as to sales volume and advertising expenditures 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. The following is the suggested format for a claim for a trademark or service mark, for a certification mark, for a collective membership mark, and for a collective trademark or collective service mark, based on 37 C.F.R. §2.41(a)(2), (b)(2), (c)(2), and (d)(2).

For a *trademark or service mark*, the claim of distinctiveness should read as follows, if accurate:

> The mark has become distinctive of the goods/services through the applicant's substantially exclusive and continuous use of the mark in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement.

See 37 C.F.R. §2.41(a)(2).

For a *certification mark*, the claim of distinctiveness should read as follows, if accurate:

> The mark has become distinctive of the certified goods/services through the authorized users' substantially exclusive and continuous use of the mark in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement.

See 37 C.F.R. §2.41(d)(2).

For a *collective membership mark*, the claim of distinctiveness should read as follows, if accurate:

> The mark has become distinctive of indicating membership in the collective membership organization through the members' substantially exclusive and continuous use of the mark in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement.

See 37 C.F.R. §2.41(c)(2).

For a *collective trademark or collective service mark*, the claim of distinctiveness should read as follows, if accurate:

> The mark has become distinctive of the goods/services through the applicant's members' substantially exclusive and continuous use of the mark in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement.

See 37 C.F.R. §2.41(b)(2).

The claim of five years of use is required to be supported by a properly signed affidavit or declaration under 37 C.F.R. §2.20. *See* 37 C.F.R. §2.41(a)(2), (b)(2), (c)(2), (d)(2). The affidavit or declaration must 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 of the mark in commerce" is essential. *See In re Olin Corp.*, 124 USPQ2d 1327, 1337 (TTAB 2017).
(3) It must be clear from the record that the five years of use has been in commerce that may lawfully be regulated by the U.S. Congress. *See Blanchard & Co. v. Charles Gilman & Son, Inc.*, 239 F. Supp. 827, 145 USPQ 62 (D. Mass. 1965), *aff'd*, 353 F.2d 400, 147 USPQ 263 (1st Cir. 1965).
(4) The use of the mark must cover the five years immediately 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) If the claim of acquired distinctiveness applies only to a portion of the mark (a claim of §2(f) "in part"), the claim must be limited to the relevant portion of the mark. *See*TMEP §§1212.02(f)(i), 1212.02(f)(ii).

(7) The affidavit or declaration must contain a reference to distinctiveness with respect to the applicant's goods, services, or membership in the collective membership organization because the distinctiveness created by the five years' use must relate to the goods/services/collective membership organization specified in the application. If there is doubt that the distinctiveness pertains to all or any of the goods/services/classes specified in the application, the examining attorney must inquire regarding that issue.

(8) While a response clarifying a §2(f) claim does not have to be verified, a substitute statement regarding acquired distinctiveness based on five years' use must be verified. For example, if the applicant amends a §2(f) claim as to the entire mark to a claim of §2(f) in part, or vice versa, the amended claim of distinctiveness based on five years' use must be supported by a properly signed affidavit or a declaration under 37 C.F.R. §2.20.

1212.06 Establishing Distinctiveness by Actual Evidence

Under Trademark Rule 2.41(a)(3), 37 C.F.R. §2.41(a)(3), 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 the U.S. 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.*:

> 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.

774 F.2d 1116, 1125, 227 USPQ 417, 422 (Fed. Cir. 1985). 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.*, 840 F.2d 1572, 1581, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988); *Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 829, 166 USPQ 34, 39 (C.C.P.A. 1970); *In re Hehr Mfg. Co.*, 279 F.2d 526, 528, 126 USPQ 381, 383 (C.C.P.A. 1960); *In re Cap. Formation Couns., Inc.*, 219 USPQ 916, 918 (TTAB 1983).

Evidence that only shows a mark used in conjunction with other wording may be insufficient to show that the mark has acquired distinctiveness. *SeeIn re Mogen David Wine Corp.*, 372 F.2d 539, 542, 152 USPQ 593, 595-96 (C.C.P.A. 1967) (holding evidence of a bottle design failed to prove secondary meaning where advertising depicting the bottle design always featured applicant's word mark); *In re Franklin Cnty. Hist. Soc'y*, 104 USPQ2d 1085, 1093 (TTAB 2012) (noting none of applicant's evidence showed use of the proposed mark "CENTER OF SCIENCE AND INDUSTRY" without the acronym "COSI," while other evidence only used the acronym to refer to applicant's services).

The following sections provide examples of 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. In addition, see TMEP §1212.01 regarding the factors considered when determining whether a mark has acquired distinctiveness.

1212.06(a) Long Use of the Mark in Commerce

Long-term use of the mark in commerce is one relevant factor to consider in determining whether a mark has acquired distinctiveness. *See, e.g., In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262 (Fed. Cir. 2015) (holding evidence of long use insufficient to establish acquired distinctiveness of FISH FRY PRODUCTS where evidence involved uses of LOUISIANA FISH FRY PRODUCTS); *In re Guaranteed Rate, Inc.*, 2020 USPQ2d 10869, at *6-7 (TTAB 2020) (finding §2(f) claim based on applicant's use since 2000 not dispositive, even if the use was considered "substantially exclusive," due to the highly descriptive nature of applicant's mark and the nature and number of third-party descriptive uses in the record); *In re OEP Enters., Inc.*, 2019 USPQ2d 309323, at *22 (TTAB 2019) (finding applicant's evidence of use since 1998 of an umbrella trade dress design "supports a finding of acquired distinctiveness to some extent because there is no evidence that competitive double canopy umbrellas had a mesh design between 1998 and 2017"); *In re Hikari Sales USA, Inc.*, 2019 USPQ2d 111514, at *15 (TTAB 2019) (finding applicant's evidence of continuous use of ALGAE WAFERS since at least Oct. 31, 1991 and advertisment of the goods sold under the mark since at least Oct. 1992 did not convince the Board that "ordinary purchasers of fish food have come to view that term primarily as an indicator of source"); *In re Uncle Sam Chem. Co.*, 229 USPQ 233, 235 (TTAB 1986) (holding §2(f) claim of acquired distinctiveness persuasive where applicant had submitted declaration of its president supporting sales figures and attesting to over eighteen years of substantially exclusive and continuous use).

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 §§901–901.04 regarding 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. *Mattel, Inc. v. Azrak-Hamway Int'l, Inc.*, 724 F.2d 357, 361 n.2, 221 USPQ 302, 305 n.2 (2d Cir. 1983) (citing *Am. Footwear Corp. v. Gen. Footwear Co.*, 609 F.2d 655, 663, 204 USPQ 609, 615-16 (2d Cir. 1979)); *see In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262 (Fed. Cir. 2015) (finding evidence of sales and advertising expenditures insufficient to establish acquired distinctiveness of FISH FRY PRODUCTS where evidence involved uses of LOUISIANA FISH FRY PRODUCTS); *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (finding §2(f) 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 – insufficient to establish distinctiveness, in view of the highly descriptive nature of the proposed mark).

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. *In re Sausser Summers, PC*, 2021 USPQ2d 618, at *23 (TTAB 2021); *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1480 (TTAB 2016) (citing *In re Redken Labs., Inc.*, 170 USPQ 526, 529 (TTAB 1971)). 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. *In re Redken Labs., Inc.*, 170 USPQ at 528-29 (holding §2(f) evidence 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 where advertising and promotional material showed only descriptive usage of applied-for mark); *see In re Jasmin Larian, LLC*, 2022 USPQ2d 290, at *42-44 (TTAB 2022) (finding no "look for" advertising in the

record but rather applicant displayed its product design for handbags in advertising without any visible label or identifier, which caused some consumers to mistakenly associate the handbag with applicant's related business entity); *In re Dimarzio, Inc.*, 2021 USPQ2d 1191, at *26-28 (TTAB 2021) (finding applicant's extensive advertising and promotional materials featuring prominent images of the applied-for color mark on the goods insufficient because the color was "not touted at all in [a]pplicant's advertising," and was just one of many colors offered for applicant's goods, which strongly undercut applicant's claims "that the color cream [was] promoted as a mark and would be perceived as one by consumers"); *In re OEP Enters., Inc.*, 2019 USPQ2d 309323, at *25 (TTAB 2019) (holding evidence of acquired distinctiveness deficient in part because "[a]pplicant's consumer facing advertisements, like its ones to the trade, do little more than show the products, and they do not establish that consumers associate the features of the applied-for trade dress mark with [a]pplicant"); *In re Chevron Intell. Prop. Grp. LLC*, 96 USPQ2d 2026, 2031 (TTAB 2010) (finding evidence of acquired distinctiveness deficient in part because of the lack of advertisements promoting recognition of pole spanner design as a service mark); *Mag Instrument Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701, 1723 (TTAB 2010) (finding absence of "look for" advertisements damaging to attempt to demonstrate acquired distinctiveness of proposed configuration mark); *Nextel Commc'ns, Inc. v. Motorola, Inc.*, 91 USPQ2d 1393, 1408 (TTAB 2009) (sustaining opposition 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 ic! berlin brillen GmbH*, 85 USPQ2d 2021, 2023 (TTAB 2008) (affirming refusal to register product configuration for spectacles and sunglasses, as the applicant 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) (affirming refusal to register OFFICE MOVERS, INC., for moving services, 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, 1247-48 (TTAB 1983) (holding evidence 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) (holding background design of a black swatch 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. *See In re Chem. Dynamics Inc.*, 839 F.2d 1569, 1571, 5 USPQ2d 1828, 1830 (Fed. Cir. 1988) (finding conclusionary declaration from applicant's vice-president 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. *See In re The Paint Prods. 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 Mag Instrument Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701, 1723 (TTAB 2010) (finding sixteen declarations of little persuasive value, as they were nearly identical in wording and only one of the declarants was described as an end consumer); *In re Gray Inc.*, 3 USPQ2d 1558, 1560 (TTAB 1987) (finding affidavit of applicant's counsel expressing his belief that the mark has acquired secondary meaning of "no probative value whatsoever" because, among other reasons, the statement is subject to bias); *In re Petersen Mfg. Co.*, 2 USPQ2d 2032, 2035 (TTAB 1987) (finding 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 persuasive); *In re Bose Corp.*, 216 USPQ 1001, 1005 (TTAB 1983), *aff'd*, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985) (deeming retailer's statement that he has been in contact with many purchasers of loudspeaker systems of whom a substantial number would recognize the depicted design as originating with applicant 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. *See In re Hikari Sales USA, Inc.*, 2019 USPQ2d 111514, at *14-15 (TTAB 2019) (citing *Schlafly v. St. Louis Brewery, LLC*, 909 F.3d 420, 424, 128 USPQ2d 1739, 1743 & n.2 (Fed. Cir. 2018)) ("Consumer surveys can, when conducted properly, be a form of direct evidence of acquired distinctiveness."); *Yankee Candle Co. v. Bridgewater Candle Co.*, 259 F.3d 25, 43, 59 USPQ2d 1720, 1730 (1st Cir. 2001) ("Although survey evidence is not required, 'it is a valuable method of showing secondary meaning.'" (quoting *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 42, 49 USPQ2d 1225, 1235 (1st Cir. 1998))).

To establish acquired distinctiveness, the survey must show that the consuming public views the proposed mark as an indication of the source of the product or service. *See In re Hikari Sales USA, Inc.*, 2019 USPQ2d 111514, at *11-12 (finding survey did not show the nature of the association a consumer perceived between the proposed mark and applicant and the other companies identified in survey answers as there were no follow-up questions inquiring as to the reason for identifying applicant or another company that would have established what the respondents understood);*Nextel Commc'ns, Inc. v. Motorola, Inc.*, 91 USPQ2d 1393, 1402-03 (TTAB 2009) (finding survey did not provide evidence of acquired distinctiveness as it was unclear if respondents associated the sound mark with applicant's goods or opposer's services). Moreover, the survey should reveal that the consuming public associates the proposed mark with a *single source*, and not that the applicant is the first among many parties associated with the designation. *See* J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* §15.42 (5th ed. June 2021) (citing *Am. Flange & Mfg. Co. v. Rieke Corp.*, 80 USPQ2d 1397, 1415 (TTAB 2006), *withdrawn on other grounds*, 90 USPQ2d 1127 (TTAB 2009)); *see alsoIn re Hikari Sales USA, Inc.*, 2019 USPQ2d 111514, at *11;*Brit. Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1202 (TTAB 1993)(finding survey did not provide convincing proof that respondents believed all black engines came from the same source), *aff'd*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994).

To have any probative value, a survey must be conducted in accordance with accepted principles of survey research. *See, e.g.*, *In re Van Valkenburgh*, 97 USPQ2d 1757, 1767 (TTAB 2011); *Zimmerman v. Nat'l Ass'n of Realtors*, 70 USPQ2d 1425, 1435-36 (TTAB 2004); *In re Wilcher Corp.*, 40 USPQ2d 1929, 1934 (TTAB 1996) (citing *Flowers Indus. Inc. v. Interstate Brands Corp.*, 5 USPQ2d 1580, 1582 n.4 (TTAB 1987)); *see also USPTO v. Booking.com B.V.*, 140 S. Ct. 2298, 2307 n.6, 2020 USPQ2d 10729, at *7 n.6 (2020); TBMP §1208; McCarthy, *supra*, §§32:158, 32:170-72. The applicant must document the procedural and statistical accuracy of this type of evidence and carefully frame the questions contained therein. *In re*

Van Valkenburgh, 97 USPQ2d at1757, 1767 (finding "no basis on which to conclude that the survey is based on scientifically valid principles" where the survey consisted of questionnaires distributed to an unknown number of people who filled them out and mailed them back to applicant's counsel); *see In re Steelbuilding.com*, 415 F.3d 1293, 1300, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005) (deeming applicant's Internet poll on name recognition 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 Hotels.com, L.P.*, 87 USPQ2d 1100, 1109–10 (TTAB 2008) (finding applicant's survey entitled to no probative weight as to the public's perception of HOTELS.COM due to flaws including the order of the questions and an assumption that consumers understood the difference between a brand name and domain name), *aff'd*, 573 F.3d 1300, 91 USPQ2d 1532 (Fed. Cir. 2009). Therefore, information regarding how a survey was conducted (the entire survey report, including all data and/or statistics gathered regarding participants responses), the complete questionnaire provided to participants, the criteria for selecting participants, the number of participants surveyed, all the individual responses to the questionnaire, the geographic scope of the survey, and an explanation of the survey method and/or design employed may assist the examining attorney in determining the probative weight of such evidence.

For a survey to be probative, the proper universe of participants must be surveyed. *In re Hikari Sales USA, Inc.*, 2019 USPQ2d 111514, at *12 (where identification broadly identified goods as fish food, survey universe was too narrow because it did not include people who purchased fish food for fish other than tropical fish) (citing *Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 1322, 128 USPQ2d 1686, 1692 (Fed. Cir. 2018) (where identification of goods broadly identified goods as meat and beef, survey universe too narrow because it eliminated from survey meat eaters who buy their meat from sources other than plaintiff); *In re FCA US LLC*, 126 USPQ2d 1214, 1226 (TTAB 2018) (survey was of limited relevance because it did not consider the entire universe of customers for automobiles, trim and structural parts but was limited to customers for vehicles capable of off-road driving); *Sheetz of Del., Inc. v. Doctor's Assocs. Inc.*, 108 USPQ2d 1341, 1363 n.41, 1371 (TTAB 2013) (finding survey universe too narrow and stating "[b]ased on the description of goods, the proper survey universe should include all people who purchase and eat sandwiches (defined to exclude only hot dogs)"; "[t]here may be an overreliance on patrons of 'fast food' establishments that skews the results because the proper universe is all consumers who purchase and eat sandwiches.")).

Further, the Trademark Trial and Appeal Board has given little weight to surveys that do not include an education or pre-testing portion regarding the difference between a generic term and a trademark or such portion is insufficient to educate respondents. *See Frito-Lay N. Am., Inc. v. Princeton Vanguard, LLC*, 124 USPQ2d 1184, 1198-99 (TTAB 2017); *Sheetz of Del., Inc. v. Dr.'s Assocs. Inc.*, 108 USPQ2d 1341, 1361-62 (TTAB 2013); *see also In re Hikari Sales USA, Inc.*, 2019 USPQ2d 111514, at *11 (TTAB 2019) (citing David H.B. Bednall, *Color, Champagne, & Trademark Secondary Meaning Survs.: Devilish Detail*, 102 Trademark Rep. 967, 999 (July-Aug. 2012)); *Zimmerman*, 70 USPQ2d at 1435-36.

Evidence of acquired distinctiveness may be sufficient if it shows that a substantial portion of the consuming public associates the proposed mark with a single source. *See Perini Corp. v. Perini Constr., Inc.*, 915 F.2d 121, 125, 16 USPQ2d 1289, 1292 (4th Cir. 1990) (quoting *Food Fair Stores, Inc. v. Lakeland Grocery Corp.*, 301 F.2d 156, 161, 133 USPQ 127, 131 (4th Cir. 1962)); McCarthy, *supra* §§15.45, 32.190; *see also In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1127, 227 USPQ 417, 424 (Fed. Cir. 1985) (noting "the results show a syndetic relationship between the color 'pink' and Owens-Corning Fiberglas in the minds of a significant part of the purchasing public"). As noted by the Court of Customs and Patent Appeals (the predecessor to the Court of Appeals for the Federal Circuit), "proof of distinctiveness requires more than proof of the existence of a relatively small number of people" who associate the proposed mark with the applicant. *Roselux Chem. Co. v. Parsons Ammonia Co.*, 299 F.2d 855, 862, 132 USPQ 627, 633

(C.C.P.A. 1962) . Although all evidence must be reviewed on a case-by-case basis, generally, survey results showing less than 10% consumer recognition are insufficient to establish secondary meaning, and results over 50% are sufficient to establish secondary meaning. *See id*. (finding 10% insufficient to establish secondary meaning); *In re Owens-Corning Fiberglas Corp.*, 774 F.2d at 1127–28, 227 USPQ at 424–25 (finding 50% probative in establishing secondary meaning given the totality of the evidence); McCarthy, *supra* §§15.45, 32.190. However, the probative value of a survey is significantly weakened, despite consumer recognition rates greater than 50%, if there are flaws in the way the survey is conducted. *SeeStuart Spector Designs Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 1569–71 (TTAB 2009) .

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.*, 280 F.2d 437, 440, 126 USPQ 362, 364 (C.C.P.A. 1960) ; *In re Mortg. Bankers Ass'n of Am.*, 226 USPQ 954, 956 (TTAB 1985) ; *In re Nat'l Shooting Sports Found., Inc.*, 219 USPQ 1018, 1020 (TTAB 1983); *In re Meier's Wine Cellars, Inc.*, 150 USPQ 475, 475 (TTAB 1966); *In re G. D. Searle & Co.*, 143 USPQ 220, 223 (TTAB 1964), *aff'd*,360 F.2d 650, 149 USPQ 619 (C.C.P.A. 1966).

Similarly, evidence of intentional copying of a product design is not probative of acquired distinctiveness. "Where the proposed mark is a product design, the copier may be attempting to exploit a desirable product feature, rather than seeking to confuse customers as to the source of the product." *In re Van Valkenburgh*, 97 USPQ2d 1757, 1768 (TTAB 2011) .

1212.06(e)(ii) State Trademark Registrations

State trademark registrations are of relatively little probative value. *See, e.g., In re Vico Prods. Mfg. Co.*, 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) (finding California trademark registration not controlling with respect to federal registrability).

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. *In re Vico Prods. Mfg. Co.*, 229 USPQ 364, 370 (TTAB 1985), *recon. denied*, 229 USPQ 716 (TTAB 1986) (citing *In re R.M. Smith, Inc.*, 734 F.2d 1482, 1485, 222 USPQ 1, 3 (Fed. Cir. 1984).

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 Consol. Cigar Corp.*, 13 USPQ2d 1481, 1483 (TTAB 1989) .

1212.06(e)(v) Family of Marks

An applicant may present evidence that an applied-for mark has acquired distinctiveness because it is a new member of a recognized family of marks. *See In re LC Trademarks, Inc.*, 121 USPQ2d 1197, 1202-04 (TTAB 2016). To establish acquired distinctiveness, the evidence must show (1) that a family of marks exists in that the claimed collection of marks shares a recognizable common characteristic that is distinctive and has been promoted in such a way as to create recognition among the purchasing public as a source indicator for the goods/services and (2) that the purchasing public would perceive the applied-for mark as part of that family of marks and thus as a source indicator. *See id.*; *cf. TPI Holdings, Inc. v. TrailerTrader.com, LLC*, 126 USPQ2d 1409, 1428 (TTAB 2018) (finding that the shared element in petitioner's marks was so commonly used by others that it does not constitute a distinguishing feature upon which a family-of-marks claim could be based).

1212.06(e)(vi) Parodies and Copies

In rare cases, evidence of the creation of intentional parodies and copies of an otherwise nondistinctive mark may be significant in assessing whether the mark has successfully achieved public recognition as a source indicator. In *In re Serial Podcast, LLC*, 126 USPQ2d 1061 (TTAB 2018), the Board found that parodies of applicant's service on a national weekly television show, using an almost identical graphical display of applicant's composite marks, constituted "highly unusual and highly significant evidence" that was "highly probative of acquired distinctiveness." *Id.* at 1076. The record also included evidence of unauthorized copying of the marks. Based on the totality of this unique evidence, the Board found that, when all the elements of the composites were taken together, the marks had acquired distinctiveness. *Id.* at 1078. The Board noted, however, that the finding of acquired distinctiveness was limited to the particular display of the composite marks as a whole, and did not extend to the individual components taken separately, or to anything less than the whole. *Id.*

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/services/classes 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 must 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 active prior registrations on the Principal Register 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 and/or services through substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made, the claim must be verified, i.e., supported by an affidavit or a declaration in accordance with 37 C.F.R. §2.20. 15 U.S.C. §1052(f); 37 C.F.R. §2.41(a)(2). In addition, any substitute statement amending the nature of an acquired-distinctiveness claim based on five years' use – such as an amendment of a §2(f) claim as to the entire mark to a §2(f) claim in part, or vice versa – must be verified. See TMEP §1212.05(d) regarding the suggested format for a claim of proof of five years' use for a trademark, service mark, collective mark, and certification mark and §1212.02(f)(i) regarding the standards for establishing acquired distinctiveness for §2(f)-in-part claims. 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, 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 verification 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, 15 U.S.C. §1126(d), §1126(e), §1141f(a), 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 the U.S. 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 the U.S. 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 U.S. 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, 1746 (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 allegation 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 allegation 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).

See also In re Olin Corp., 124 USPQ2d 1327, 1333-34 (TTAB 2017); *In re Binion*, 93 USPQ2d 1531, 1538 (TTAB 2009). To satisfy the first element, the applicant must establish acquired distinctiveness as to the other goods or services by the following means:

(1) Ownership of an active prior registration on the Principal Register for the same mark for sufficiently similar or related goods or services (*see* TMEP §§1212.04–1212.04(e));
(2) A prima facie showing of acquired distinctiveness based on five years' use of the same mark with sufficiently similar or related goods or services (*see* TMEP §§1212.05–1212.05(d)); or
(3) Actual evidence of acquired distinctiveness for the same mark with respect to sufficiently similar or related goods or services (*see* TMEP §§1212.06–1212.06(e)(iv)).

In re Olin Corp., 124 USPQ2d at 1334; *see In re Highlights for Children, Inc.*, 118 USPQ2d 1268, 1273-75 (TTAB 2016) (finding that the applied-for mark, IMÁGENES ESCONDIDAS, and the previously registered English equivalent, HIDDEN PICTURES, are not the "same mark" because they are entirely different both aurally and visually, and applicant provided no evidence demonstrating that consumers would consider the two marks to be the same mark even if they understood the equivalence in meaning); *In re Nielsen Bus. Media, Inc.*, 93 USPQ2d 1545, 1547-48 (TTAB 2010) (finding 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 at 1539 (finding 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. Gen. Mills, Inc.*, 82 USPQ2d 1766, 1771 (TTAB 2007) (deeming close relationship between cereal and food bars derived from cereal "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 §1(a), 15 U.S.C. §1051(a), may also base a claim of acquired distinctiveness under §2(f) on long-term 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) as to part of a mark prior to filing an acceptable allegation of use if 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. See TMEP §1212.02(f) regarding claims of §2(f) "in part."

The requirements to support such a claim are twofold. First, the applicant must establish acquired distinctiveness of the relevant portion of the mark 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 an active prior registration on the Principal Register covering the relevant portion of the mark and sufficiently similar or related goods or services (*see*TMEP §§1212.04–1212.04(e)); (2) a prima facie showing of acquired distinctiveness based on five years' use of the relevant portion of the mark with the same or related goods or services (*see*TMEP §§1212.05–1212.05(d)); 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 §§1212.06–1212.06(e)(iv)).

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, by submission of relevant evidence, 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 related goods or services when use in commerce begins. *In re Rogers*, 53 USPQ2d 1741, 1745 (TTAB 1999); *see*TMEP §1212.09(a).

> Simply because the mark may not have been used on or in connection with the goods or services identified in the intent-to-use application, applicant is not excused from the need to demonstrate this

> strong likelihood of transference in order to establish acquired distinctiveness of the mark in connection with the goods or services with which applicant intends to use the mark.

In re Rogers, 53 USPQ2d at 1745.

There are numerous ways the strong likelihood of transference can be shown, including, but not limited to, "results of focus groups and market surveys of prospective purchasers, and/or evidence regarding practices in the relevant industry." *Id.* at 1745 n.5.

If the examining attorney determines that the applicant has established acquired distinctiveness as to the relevant portion of the mark, the examining attorney must 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 Trademark 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 registration.

For example, if the mark is SOFTSOAP for non-medicated liquid soap and the applicant has successfully shown acquired distinctiveness, the examining attorney must ensure that the "§2(f)" field in the Trademark 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 non-medicated 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 Trademark database reads as follows before approving the mark for publication:

MISCELLANEOUS INFORMATION

SECTION 2F: NO	**SECTION 2F IN PART:** YES
2F Limitation Statement:	as to "SOFTSOAP"

If the applicant has successfully shown acquired distinctiveness as to non-English wording in the mark, or as to non-English wording that has been transliterated from non-Latin characters, the examining attorney must ensure that the §2(f) claim is entered as shown in the following examples.

If the mark is KONE UNIPOWER for specific machine parts, the term KONE means "machine or engine," and the applicant has successfully shown acquired distinctiveness as to the term KONE, the examining attorney must ensure that the "§2(f)" field in the Trademark database reads as follows before approving the mark for publication:

MISCELLANEOUS INFORMATION

SECTION 2F: NO	**SECTION 2F IN PART:** YES
2F Limitation Statement:	as to "KONE"

Similarly, in the mark shown below, where the non-Latin characters transliterate to "ME-RI-LAND-HAN-IN-SI-MIN-HYUP-IIOY," which means

"MARYLAND, KOREAN AMERICAN LEAGUE," and the mark is used for organizing and conducting community service projects and programs to promote cultural and social awareness, if the applicant has successfully shown acquired distinctiveness as to the portion of the mark comprised of the non-Latin characters, the examining attorney must ensure that the "§2(f)" field in the Trademark database reads as follows before approving the mark for publication:

MISCELLANEOUS INFORMATION

SECTION 2F: NO	**SECTION 2F IN PART:** YES
2F Limitation Statement:	as to the non-Latin characters that transliterate to "ME-RI-LAND-HAN-IN-SI-MIN-HYUP-IIOY"

In the past, the USPTO did not print §2(f) notations on the registration. Therefore, the absence of a "§2(f)" notation on an older registration does not necessarily mean that the mark was registered without a §2(f) claim.

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 1057 of this title, 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 (D.C. Cir. 1924) (citing *Estate of P. D. Beckwith, Inc. v. Comm'r of Pats.*, 252 U.S. 538, 544 (1920)):

> [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, Inc. v. Comm'r of Pats.*, 252 U.S. 538 (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. *See also In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262 (Fed. Cir. 2015) (stating that registration can be conditioned on disclaimer of an unregistrable component of a mark).

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 must 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 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 Am. Cyanamid & Chem. 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 UST Global (Sing.) Pte. Ltd.*, 2020 USPQ2d 10435, at *2 (TTAB 2020); *In re Nat'l Presto Indus., Inc.*, 197 USPQ 188 (TTAB 1977).

If an applicant fails to comply with the examining attorney's requirement for a disclaimer, the examining attorney must 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 §§1213.08–1213.08(d).

In *In re MCI Commc'ns Corp.*, 21 USPQ2d 1534 (Comm'r Pats. 1991), the Commissioner held that §6(a) 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. *Id.* at 1539. (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). *Id.* at 1538. The examining attorney must evaluate the entire mark, including any disclaimed matter, to determine registrability. *Id. See In re RSI Sys., LLC*, 88 USPQ2d 1445, 1448 (TTAB 2008) (finding voluntary disclaimer of "RSI" has no legal effect on the issue of likelihood of confusion because it is not a weak term). Furthermore, the *MCI* decision states that the applicant may not disclaim the entire mark. *MCI*, 21 USPQ2d at 1538. *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 must offer the applicant the opportunity to withdraw the disclaimer.

If it is necessary to communicate with the applicant about another matter, the examining attorney must 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 the applicant does not respond to the inquiry regarding the unnecessary disclaimer, and the application is otherwise in condition for final action or approval for publication for opposition or registration, the examining attorney must enter a Note to the File regarding the disclaimer and issue the final action or approve the application for publication for opposition or registration, as appropriate, without deleting the disclaimer.

In applications under §1 or §44, if it is otherwise unnecessary to issue a first Office action, the inquiry may be made by telephone or email. 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 email message (applicant should be given at least three business days), the examining attorney must enter an appropriate Note to the File and approve the application for publication for opposition or registration without deleting the disclaimer.

In applications under §66(a), if it is otherwise unnecessary to issue a first Office action, the examining attorney should issue a "no-call" Examiner's Amendment informing the applicant that the disclaimer appears

to be unnecessary and inquiring as to whether the applicant wants to withdraw the disclaimer. (This is meant only to provide information to the applicant and does not "amend" the application. An examiner's amendment may not be issued as a first Office action because the IB will not accept such amendments.) The examining attorney should then approve the application for publication for opposition without deleting the disclaimer. It is not necessary to wait for the applicant to respond.

1213.01(d) Disclaimer Offered in the Alternative

An applicant may argue the merits of an examining attorney's requirement for a disclaimer and, in the alternative, consent to entry of the disclaimer. In such circumstances, submission of the disclaimer does not constitute a concession that the matter sought to be registered is not inherently distinctive or registrable. *SeeIn re RiseSmart Inc*., 104 USPQ2d 1931, 1932 (TTAB 2012). Thus, when an applicant submits a disclaimer in the alternative, while maintaining that the wording at issue is not descriptive, the disclaimer requirement is not moot. If the examining attorney finds the disclaimer acceptable, the applicant must be given the option of entering the disclaimer in the record or going forward with appeal of the underlying issue of whether the wording subject to the requirement is merely descriptive. This should be done by telephone or email, with a Note to the File in the record indicating the applicant's decision, wherever possible. If the applicant wants to appeal, or if the examining attorney is unable to reach the applicant by telephone or email, the examining attorney must maintain the requirement, or issue a final Office action requiring the disclaimer, as appropriate. *Id.* If the applicant elects to enter the disclaimer in the record and not appeal the requirement, then the disclaimer constitutes a concession that the matter is not inherently distinctive or registrable.

See TMEP §1212.02(c) regarding a claim, in the alternative, that matter sought to be registered has acquired distinctiveness under §2(f).

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 §§1213.05–1213.05(g)(iv).

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, Inc. v. Comm'r of Pats., 252 U.S. 538 (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."

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 Prods., Inc.*, 109 USPQ 399 (Comm'r Pats. 1956) (finding disclaimer of "NORQUIST" 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. Moreover, the voluntary disclaimer of a surname is not an appropriate response to a surname refusal. If the addition of other registrable matter creates a composite mark with an overall impression that is not primarily merely that of a surname, then no refusal is made under §2(e)(4). 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), must be made. *See In re E. Martinoni Co.*, 189 USPQ 589, 590-91 (TTAB 1975) (holding LIQUORE MARTINONI (stylized) for liqueur primarily merely a surname, with "liquore" being the Italian word for "liqueur"). See TMEP §§1211.01(b)–1211.01(b)(viii) 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., Am. Speech-Language-Hearing Ass'n v. Nat'l Hearing Aid Soc'y*, 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 §1203.02 regarding disclaiming deceptive matter, TMEP §1204.04(a) about disclaiming flags or insignia, TMEP §§1210.05(d)(ii) and 1210.06(a)–(b) regarding disclaimer of geographic terms in composite marks, and TMEP §1213.10 concerning disclaimers with regard to likelihood of confusion.

1213.03(b) Generic Matter and Matter That Does Not Function as a Mark

If a mark is comprised in part of matter that, as applied to the goods or 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 §§1213.05–1213.05(g)(iv).

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 Wash., 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, as stated in *In re Water Gremlin Co.*, 635 F.2d 841, 845 n.6, 208 USPQ 89, 91 n.6 (C.C.P.A. 1980) (citing *In re Wella Corp.*, 565 F.2d 143, 196 USPQ 7 (C.C.P.A. 1977)), "Section 6 is equally applicable to the Supplemental Register." *See Wella*, 565 F.2d 143, 196 USPQ 7 (finding mark comprising stylized

lettering of BALSAM, with disclaimer of "BALSAM," 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. *SeeThistle Class Ass'n v. Douglass & McLeod, Inc.*, 198 USPQ 504, 511-12 (TTAB 1978) (finding thistle design 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. *SeeIn re LRC Prods. Ltd.*, 223 USPQ 1250, 1252 (TTAB 1984) (holding outline of two gloved hands arbitrary and fanciful), and cases cited therein. *Note*: A map of the world or a depiction of a globe generally is not considered the pictorial equivalent of the terms "INTERNATIONAL," "GLOBAL," or "WORLDWIDE."

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. *See In re Piano Factory Grp., 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) (finding "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 Prods. 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" (citing *In re E.I. Kane, Inc.*, 221 USPQ 1203 (TTAB 1984))). Further, such designations must also be disclaimed in marks seeking registration on the Principal Register under §2(f) or on the Supplemental Register.

However, a disclaimer should not be required when the entity designation is used in an arbitrary manner and thus has trademark significance (e.g., THE LTD. or KIDS INCORPORATED for clothing or CHUCKLE BROS. for a comic strip). *See Nautilus Grp., 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"); TMEP §1209.01(a). Likewise, a disclaimer is unnecessary when the entity designation is part of a unitary, registrable whole (e.g., "T-MarkeyInc."). *See*TMEP §§1213.05–1213.05(h).

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) (affirming requirement for disclaimer of PASTRY SHOPPE in application to register MARTIN'S FAMOUS PASTRY SHOPPE INC. and design for various baked goods).

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. The test for unitariness inquires whether the elements of a mark are so integrated or merged together that they cannot be regarded as separable. *See In re Lego Juris A/S*, 2022 USPQ2d 443, at *6 (TTAB 2022); *In re Kraft, Inc.*, 218 USPQ 571, 573 (TTAB 1983); *In re EBS Data Processing, Inc.*, 212 USPQ 964, 966 (TTAB 1981). The inquiry focuses on "how the average purchaser would encounter the mark under normal marketing of such goods and also . . . what the reaction of the average purchaser would be to this display of the mark." *Dena Corp. v. Belvedere Int'l, Inc.*, 950 F.2d 1555, 1561, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991) (quoting *In re Magic Muffler Serv., Inc.*, 184 USPQ 125, 126 (TTAB 1974)). The Court of Appeals for the Federal Circuit has set forth the elements of a unitary mark:

> A unitary mark has certain observable characteristics. Specifically, its elements are inseparable. In a unitary mark, these observable characteristics must combine to show that the mark has a distinct meaning of its own independent of the meaning of its constituent elements. In other words, a unitary mark must create a single and distinct commercial impression.

Dena Corp., 950 F.2d at 1561, 21 USPQ2d at 1052. 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.*, 950 F.2d at 1561, 21 USPQ2d at 1052.

The examining attorney should exercise discretion in determining whether a mark or portion of a mark is unitary, in which case a disclaimer of a nondistinctive component must not be required. Some considerations that may factor into an assessment of whether wording in a mark or portion of a mark is unitary are discussed in TMEP §§1213.05(a)–(b)(iii). Each consideration may not apply in every case, and a phrase may be found to be unitary or to constitute a slogan even where none apply if, for some other reason, the whole is something more than the sum of its parts. Furthermore, if a mark that includes a registrable unitary phrase or slogan also has other unregistrable components that are separable, the latter must be disclaimed.

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.

See In re EBS Data Processing, Inc., 212 USPQ 964, 966 (TTAB 1981) (finding that "[a] disclaimer of a descriptive portion of a composite mark is unnecessary . . . if the elements are so merged together that they cannot be regarded as separable elements . . . for example, . . . by combining two words or terms, one of which would be unregistrable by itself . . .").

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 – that is, 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" Labs., Inc. v. Odorite Sanitation Serv. of Balt., Inc.*, 106 USPQ 327, 329 (Comm'r Pats. 1955) (holding requirement for a disclaimer of "TIRE" 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 must require a disclaimer of the words in the correct spelling.

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.

1213.05(b) Unitary Phrases

A phrase is "a group of words that are used together in a fixed expression," and "a word or words that act as a unit in a clause." MacmillanDictionary.com, search of "phrase," **http://www.macmillandictionary.com/dictionary/american/phrase** (Accessed April 19, 2022). Acting as a single idea or a syntactical unit, however, does not necessarily mean that a phrase is "unitary" in the trademark sense. A phrase qualifies as unitary in the trademark sense only if the whole is something more than the sum of its parts. *Dena Corp. v. Belvedere Int'l, Inc.*, 950 F.2d 1555, 1561, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991) (finding EUROPEAN FORMULA and design for cosmetic products not unitary since the "elements are not so merged together that they cannot be regarded as separate" and the proximity of the words to the design feature "does not endow the whole with a single, integrated, and distinct commercial impression").

Even where it includes an otherwise unregistrable component, a unitary phrase as a whole will have "some degree of ingenuity in its phraseology as used in connection with the goods; or [say] something a little different from what might be expected to be said about the product; or [say] an expected thing in an unexpected way." *Ex parte Mooresville Mills, Inc.*, 102 USPQ 440, 441 (Comm'r Pats. 1954) (holding FROM FIBER TO FABRIC FOR THE STYLE CONSCIOUS MILLIONS for fabrics capable of registration on the Supplemental Register).

Phrases must be analyzed on a case-by-case basis to determine whether their meaning and commercial impression indicate an inseparable whole. As noted above, a unitary phrase derives its meaning when viewed as a whole, with the combination of the components having a distinct commercial impression that is independent of the constituent elements. *Dena Corp.*, 950 F.2d at 1561, 21 USPQ2d at 1052 (noting that the proximity of the words EUROPEAN FORMULA to the design feature "does not endow the whole with a single, integrated, and distinct commercial impression"). In some cases, in addition to the mark itself, the specific arrangement and placement of all the elements of the phrase and the manner of use and presentation on the specimen, on applicant's website, in promotional materials, and in connection with other goods or services may all demonstrate how the phrase is presented to and perceived by consumers.

Some considerations for determining whether a phrase that comprises a mark or part of a mark is unitary are set forth below.

1213.05(b)(i) Slogans

A slogan is a type of phrase and is defined as "a brief attention-getting phrase used in advertising or promotion" and "a catch phrase used to advertise a product." Merriam-Webster.com, search of "slogan," **http://www.merriam-webster.com/dictionary/slogan** (Jan. 31, 2012); *Webster's New World College Dictionary* (4th ed. 2010). A registrable slogan is one that is used in a trademark sense and functions as a trademark or service mark on the Principal or Supplemental Register, including the Principal Register under §2(f). *Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34 (C.C.P.A. 1970) (holding that the mark HAIR COLOR SO NATURAL ONLY HER HAIRDRESSER KNOWS FOR SURE for hair tinting, dyeing, coloring preparations had become distinctive of the goods and was registrable); *In re The Hallicrafters Co.*, 153 USPQ 376 (TTAB 1967) (holding QUALITY THROUGH CRAFTSMANSHIP registrable for radio receivers and transmitters, power supplies, and antennae). Slogans, by their attention-getting nature, are treated as unitary matter and must not be broken up for purposes of requiring a disclaimer.

However, if a mark consists entirely of a slogan that is generic, merely descriptive, merely informational, or that is otherwise not being used as a mark, registration must be refused. *See In re Carvel Corp.*, 223 USPQ 65 (TTAB 1984) (holding AMERICA'S FRESHEST ICE CREAM for flavored ices, ice cream, etc., incapable of distinguishing applicant's goods and unregistrable on the Supplemental Register); *In re Wakefern Food Corp.*, 222 USPQ 76 (TTAB 1984) (holding WHY PAY MORE! for supermarket services to be an unregistrable common commercial phrase); *see*TMEP 1213.05(b)(iii).

If an unregistrable slogan is a component of a mark with registrable matter, the examining attorney must require that the slogan be disclaimed.

1213.05(b)(ii) Grammar and Punctuation

Grammatical structure and punctuation may play a part in the analysis of whether a phrase or slogan would be viewed as unitary. Such considerations serve as guidelines rather than dispositive factors and the weight to be given each depends upon the overall meaning and commercial impression of the mark.

1213.05(b)(ii)(A) Verbs

Verbs indicate "the performance or occurrence of an action or the existence of a condition or a state of being." The Chicago Manual of Style ¶ 5.95 (16th ed. 2010). The presence of a verb may indicate that a mark or portion of a mark is a unitary phrase or slogan by linking a subject and an object, or by referring to something that is ongoing, thereby creating continuity of thought or expression. *See id*. ¶ 5.96.

Example 1: TIP YOUR HAT for "hats"

When linked with the phrase YOUR HAT, the verb TIP renders the mark as a unitary phrase that creates the commercial impression of touching or raising a hat as a greeting or polite gesture. No disclaimer of HAT is required.

Example 2: TRANSFORMING STATE GOVERNMENT for "providing information in the field of government affairs"

The verb TRANSFORMING indicates an ongoing activity being performed on STATE GOVERNMENT, thereby unifying the terms so that they function as a unit. No disclaimer of STATE GOVERNMENT is required.

Some additional examples of phrases in which the verb renders the phrase unitary are:

FILING TAXES SO YOU DON'T HAVE TO for "tax preparation"

BOATS ARE FUN for "boats"

TAKE THIS MEDICINE for "cough syrup"

See TMEP §1213.05(b)(ii)(B) for examples in which the combination of a verb and a preposition link the wording to create a unitary phrase.

1213.05(b)(ii)(B) Prepositional Phrases

Prepositions are words or phrases that link a grammatical object–such as a noun, pronoun, verb, adjective, or phrase–to another word to indicate the relationship between them. *See* The Chicago Manual of Style ¶

5.169 (16th ed. 2010). For instance, the relationship could be one of space, location, time, cause, means, or possession. *See id.* ¶ 5.174. Examples of prepositions include *above, at, before, between, by, for, from, in, into, of, on, since, through, to, toward, until,* and *with*. *See id.* ¶ 5.170. A prepositional phrase is the combination of the "preposition, its object, and any words that modify the object," such as "over the hill," "in the sports car," or "near her." *See id.* ¶ 5.173.

Wording in a mark that comprises a prepositional phrase is generally connected or unified by the preposition(s) in such a way that the elements would not be regarded as separable. In addition, marks comprised of prepositional phrases often have the commercial impression of a catch phrase or slogan. In some instances, however, marks contain distinctive matter followed by unitary prepositional phrases that are informational or descriptive, and these prepositional phrases are separable from the rest of the mark and must be disclaimed. Common examples include "of" followed by a geographic place name (e.g., "of Atlanta") and "for" followed by a consumer designation (e.g., "for children").

Example 1: MANGOES FOR THE EARTH for "fresh mangoes"

The preposition FOR joins THE EARTH with MANGOES, indicating a relationship between the wording. MANGOES is not separable because the prepositional phrase modifying it brings all the wording in the mark together to convey something more than the individual components. No disclaimer of MANGOES is required.

Example 2: A DAY OF HOPE FOR HEART DISEASE for "educational services, namely, conducting workshops in the field of heart disease"

The prepositions OF and FOR create two prepositional phrases joined as a unit that could be viewed as a catch phrase. No disclaimer of HEART DISEASE is required.

Example 3: ESTEE LAUDER FOR MEN for "cologne"

The descriptive prepositional phrase FOR MEN appears separable from the rest of the mark and does not create a distinct meaning independent of the meaning of the separate elements. Disclaimer of FOR MEN is required.

Some additional examples of phrases in which the preposition renders the phrase unitary are:

TALES OF THE COCKTAIL for "educational services, namely, conducting seminars in the field of mixology"
MENTORS FOR COMPLETE TEACHING for "conducting remedial tutoring programs for children in the areas mathematics and science"
CHECK UP FROM THE NECK UP for "medical services"
LANGUAGE OF LOLLIPOPS for "candy"
DEPARTMENT OF THE NAVY for "printed newsletters in the field of military science"
A DIVISION OF XYZ INDUSTRIES for "construction of buildings"

In some cases, the combination of a verb and a preposition link the wording to create a unitary phrase. For example:

GET MORE FROM ENERGY for "providing temporary use of online non-downloadable software for computing energy savings"
CHANGING THE WORLD OF SUSHI for "restaurant services"
WOMEN WHO RUN FROM COMPUTERS for "computer education training using multisensoral methods, group process and drama to motivate those with computer anxiety or fear"

1213.05(b)(ii)(C) Punctuation

The use of punctuation, such as a question mark, exclamation point, colon, dash, or period, as well as the meaning of the punctuation itself, may be a factor weighing either in favor of or against a mark or a portion of a mark being a unitary phrase or slogan. Note, however, that the presence of punctuation in a mark comprising a slogan or phrase should not be confused with the significance of punctuation in a mark containing compound words that are formed using punctuation. *See*TMEP §1213.05(a)(ii). Punctuation may either unite or separate all or some of the words in the mark. Where punctuation unites all the words, the mark or phrase as a whole is likely unitary. Where punctuation separates some of the words, however, the result likely indicates a mark or phrase that is not unitary, requiring disclaimer or refusal of the unregistrable matter. Therefore, the punctuation in the mark must be considered in connection with an assessment of the specific arrangement of the words and the overall meaning and commercial impression of the slogan or phrase.

Example 1: CREATIVE NAILS? for “nail polish”

A question mark can be "used to indicate a direct question" or "express surprise, disbelief, or uncertainty." The Chicago Manual of Style ¶ 6.66 (16th ed. 2010). Here, the question mark at the end of the phrase joins the terms so that they function as a unit, thereby changing the commercial impression. No disclaimer of NAILS is required.

Example 2: GO! PUZZLE for “downloadable computer game software”

An exclamation point can be used to indicate “an outcry or an emphatic or ironic comment.” *Id.* ¶ 6.71. It is usually placed at the end of a thought and indicates the conclusion of that thought. Here, the exclamation point is in the middle of the mark and physically separates GO and PUZZLE. The exclamation point also conceptually separates GO from PUZZLE because it gives GO a commanding and urgent connotation not applied to PUZZLE. Since PUZZLE is outside of the exclamatory statement and is descriptive for the goods, it is not united with GO. Disclaimer of PUZZLE is required.

Example 3: COMFY. COZY. COTTON for “bed sheets and blankets”

In this example, the period after each term physically and conceptually separates the terms such that each stands alone. Therefore, the wording does not comprise a unitary mark and a disclaimer of COTTON is required.

Example 4: NAA – NATIONAL ASSOCIATION OF ACCOUNTANTS for “association services, namely, promoting the interests of accountants”

Here, the punctuation physically and conceptually separates the wording in the mark. Moreover, the phrase NATIONAL ASSOCIATION OF ACCOUNTANTS is descriptive and must be disclaimed.

Example 5: BONDS – THE FUTURE OF INVESTING for “financial planning”

The punctuation physically and conceptually separates the wording in the mark and a disclaimer of BONDS is required. Note, however, that THE FUTURE OF INVESTING is a unitary phrase, avoiding a disclaimer of INVESTING.

In some cases, the use of punctuation in combination with a verb and/or preposition may combine to create a unitary phrase or a mark with a distinct meaning independent of the meaning of the separate elements, as shown below:

HAVE YOU HAD YOUR MEDS TODAY? for “prescription pills for diabetics”

PAPER FOR YOUR OFFICE. TO YOUR OFFICE. for “retail store services in the field of office products”

WHERE SNACKS LOVE TO DIP! for “dips”

GO FOR GOLD! for “gold jewelry”

1213.05(b)(ii)(D) Possessives

Generally, the use of a possessive form of a word in a mark does not, by itself, merge the wording so as to create the commercial impression of a unitary phrase or slogan. However, if the mark contains the possessive form of a word as well as one of the considerations discussed above, this combination of the elements may result in a slogan or unitary phrase.

Example 1: BILL’S CARPETS for “retail carpet stores”

The possessive form of BILL’S alone is not sufficient to unite BILL’S with CARPETS such that the whole is more than the sum of its parts. Disclaimer of CARPETS is required.

Example 2: BILL’S IS CARPETS for “retail carpet stores”

The possessive BILL’S does not, by itself, unite BILL’S with CARPETS. However, the presence of the verb IS unites all the words to convey a complete thought that functions as a unit and expresses a fanciful state of being. No disclaimer of CARPETS is required.

Some other examples of wording in which the possessive does not create a unitary phrase and disclaimer of the descriptive wording is required are:

THE CHILDREN’S PLACE for “shirts”; “backpacks”; “retail clothing stores” (disclaimer of CHILDREN’s required)

BARB’S BREAD BAKERY, INC. for “bakery services, namely, the manufacture of bakery products to order and/or specification of others” (disclaimer of BREAD BAKERY, INC. required)

HUBER'S PREMIUM WORKWEAR for “clothing, namely, shirts and pants” (disclaimer of PREMIUM WORKWEAR required)

1213.05(b)(iii) Other Considerations

Even if none of the considerations discussed above apply, there may be something about the components of the mark that joins them together and transforms them into a unitary phrase or slogan. If other considerations, such as word pattern, double entendre, and incongruity (*see* TMEP §§1213.05(c)-1213.05(e)), or the context, rhetorical structure, or some other aspect of the mark creates a distinct meaning or commercial impression that is more than its constituent parts, the phrase should be deemed unitary for purposes of a disclaimer. 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.

Example 1: BLACK MAGIC for "accessories for skateboards and snowboards, namely grip tape"

The wording "Black Magic" 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.

Example 2: NOT YOUR ORDINARY DINER for "restaurant services"

The combination formed by the familiar phrase NOT YOUR ORDINARY followed by a descriptive or generic term creates a unitary phrase. No disclaimer of DINER is required.

Example 3: CORPORATE FUEL for "business management and advisory services"

Here, the descriptive term CORPORATE and the arbitrary word FUEL combine to create a unitary phrase that is a play on actual types of fuel, like jet fuel or diesel fuel. No disclaimer of CORPORATE is required.

Note, however, that in the following examples, nothing about the components of the marks joins them together and transforms them into unitary phrases.

Example 4: SWEETER PEARS REGENCY ORCHARD for "fresh pears"

The mark does not contain a verb, preposition, or punctuation. Except for REGENCY, all the terms are descriptive and inform about the goods, their nature, and the type of place where they are grown. That the arbitrary term REGENCY is in the middle does not connect all the words to create a unitary phrase. Therefore, SWEETER PEARS and ORCHARD must be disclaimed.

Example 5: AAMCO COMPLETE CAR CARE EXPERTS for "motor vehicle maintenance and repair services"

The arbitrary term AAMCO is not connected to the rest of the terms, since there is no verb, preposition, or punctuation. The wording COMPLETE CAR CARE EXPERTS, which is descriptive and a separable element from AAMCO, must be disclaimed.

1213.05(b)(iv) Unregistrable Unitary Phrases or Slogans

Although the determination that a mark or portion of a mark is unitary may provide an exception to the disclaimer requirement, when an entire unitary phrase or slogan is generic, descriptive, or merely informational, it remains unregistrable. To illustrate, "common laudatory phrases or statements that would ordinarily be used in business or in the particular trade or industry" are unregistrable despite the fact that they may be unitary phrases or slogans. *See In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (THE BEST BEER IN AMERICA for beer and ale); *In re Remington Prods. Inc.*, 3 USPQ2d 1714 (TTAB 1987) (PROUDLY MADE IN USA for electric shavers); *In re Carvel Corp.*, 223 USPQ 65 (TTAB 1984) (AMERICA'S FRESHEST ICE CREAM for flavored ices); *In re Tilcon Warren, Inc.*, 221 USPQ 86 (TTAB 1984) (WATCH THAT CHILD for construction material); *see also* TMEP §§1209.03(s) and 1202.04. Therefore, unless a unitary phrase or slogan otherwise meets all requirements for registrability, it must be disclaimed or refused registration, as appropriate.

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. *In re Leonhardt*, 109 USPQ2d 2091, 2098 (TTAB 2008) (citing *In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968); *In re Simmons Co.*, 189 USPQ 352 (TTAB 1976); *In re Del. Punch Co.*, 186 USPQ 63 (TTAB 1975); *In re Nat'l Tea Co.*, 144 USPQ 286 (TTAB 1965)).

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. In *In re Kraft, Inc.*, 218 USPQ 571, 573 (TTAB 1983), 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) (holding SHEER ELEGANCE for panty hose 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, e.g.*, *In re Yarnell Ice Cream, LLC*, 2019 USPQ2d 265039, at *7-8 (TTAB 2019) (finding SCOOP for ice cream, which merely described the serving size of the goods, did not present a double entendre because the applicant made no showing that the interpretation of SCOOP in this context was that of a 'news scoop');*In re RiseSmart Inc*., 104 USPQ2d 1931, 1934 (TTAB 2012) (finding that TALENT ASSURANCE does not present a double entendre such that "the merely descriptive significance of the term [TALENT] is lost in the mark as a whole"); *In re The Place, Inc.*, 76 USPQ2d 1467, 1470 (TTAB 2005) (holding THE GREATEST BAR 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 separate from the mark itself, then the mark is not a double entendre"); *In re Wells Fargo & Co.*, 231 USPQ 95, 99 (TTAB 1986) (holding EXPRESSERVICE merely descriptive for banking services, despite applicant's argument that the term also connoted the Pony Express, the Board finding that, in the relevant context, the public would not make that association).

If all meanings of a double entendre are merely descriptive in relation to the goods, then the mark comprising the double entendre must be refused registration as merely descriptive.

In certain cases, marks were considered to be double entendres and, therefore, registrable unitary marks. *In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (SUGAR & SPICE for bakery products); *In re Tea & Sympathy, Inc.*, 88 USPQ2d 1062 (THE FARMACY 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 (THE HARD LINE for mattresses and bed springs); *In re Del. Punch Co.*, 186 USPQ 63 (THE SOFT PUNCH for noncarbonated soft drink); *In re Nat'l Tea Co.*, 144 USPQ 286 (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. See TMEP §1209.01(a) regarding incongruity.

1213.05(e) Sound Patterns

Alliterative or repeated wording does not in itself make a mark unitary. *In re Ginc UK Ltd.*, 90 USPQ2d 1472, 1477 (TTAB 2007) (finding 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) (holding LEAN LINE *not* 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.")

In rare cases, a rhyming pattern, alliteration, or some other use of sound that creates a distinctive impression may contribute to a finding that the mark is regarded as unitary and individual elements should not be disclaimed. *See In re Kraft, Inc.*, 218 USPQ 571, 573 (TTAB 1983) (finding LIGHT N' LIVELY 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."). Other evidence, such as registrations of the mark for related goods and consumer recognition of the mark as a unitary expression, may also contribute to a finding that the mark is unitary. *Id*.

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 Lego Juris A/S*, 2022 USPQ2d 443, *7-9 (TTAB 2022) (holding the mark, MONKIE KID and monkey head design with stylized non-Latin characters, unitary where "the words MONKIE and KID are physically connected to the design of a monkey's head, which touches and slightly overlaps with the final letter of MONKIE and the first letter of KID;" and the vertical depiction of a similar MONKIE KID mark unitary for the same reasons); *In re Texsun Tire & 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) (holding 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 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

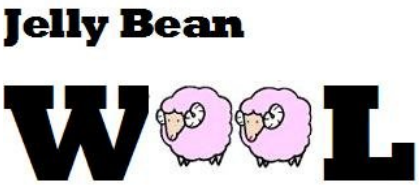
Generally, when a design element replaces one or more letters (or a portion of a letter or letters) in a word that is merely descriptive, generic, or geographically descriptive, this combination of word and design element does not create a "unitary mark" if the word remains recognizable. Accordingly, the examining attorney must require a disclaimer of the merely descriptive, generic, or geographically descriptive word in such cases. *See In re Clutter Control, Inc.*, 231 USPQ 588, 590 (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. *See In re Venturi, Inc.*, 197 USPQ 714, 717 (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 “WOOL”

Principal Register – Disclaimer of “INC.” and “ANIMAL FOOD”

Principal Register – Disclaimer of “CLOTHING CO.”

Principal Register – Disclaimer of “PARIS”

Principal Register – Disclaimer of “PONY”

Principal Register – Disclaimer of “FISH”

Principal Register – Disclaimer of “KIDS”

Principal Register – Disclaimer of “NUTRITION”

Principal Register – Disclaimer of “TOWELS”

Principal Register – Disclaimer of "DOGGIE"

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 nondistinctive, 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 §2(f) or on Supplemental Register

Disclaim "BUILDERS ASSOCIATION" on Principal Register under §2(f) or on Supplemental Register

Disclaim “CHECK CASHERS” on Principal Register under §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 must 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 §2(f) or on 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:

1213.05(h) Unitary Marks: Case References

In the following cases, marks were considered unitary: *B. Kuppenheimer & Co., v. Kayser-Roth Corp.*, 326 F.2d 820, 822, 140 USPQ 262, 263 (C.C.P.A. 1964) (holding that KUPPENHEIMER and SUP-PANTS were combined so that they shared the double "P," making "an indivisible symbol rather than two divisible words"); *In re Lego Juris A/S*, 2022 USPQ2d 443, *7-9 (TTAB 2022) (holding MONKIE KID and monkey head design with stylized non-Latin characters unitary); *In re Kraft, Inc.*, 218 USPQ 571, 573 (TTAB 1983) (finding that purchasers would regard LIGHT N'LIVELY as a unitary mark); *In re Hampshire-Designers, Inc.*, 199 USPQ 383, 384 (TTAB 1978) (holding DESIGNERS PLUS+ for sweaters unitary); *In re J.R. Carlson Labs., Inc.*, 183 USPQ 509, 511 (TTAB 1974) (holding E GEM unitary for bath oil containing vitamin E).

In the following cases, marks were found not to be unitary: *In re Slokevage*, 441 F.3d 957, 963 78 USPQ2d 1395, 1400 (Fed. Cir. 2006) (holding not unitary trade dress mark 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); *Dena Corp.*, 950 F.2d at 1561, 21 USPQ2d at 1052 (holding EUROPEAN FORMULA above a circular design on a dark square or background not unitary); *In re Ginc UK Ltd.*, 90 USPQ2d 1472, 1476 (TTAB 2007) (holding ZOGGS TOGGS for clothing not unitary and affirming requirement for disclaimer of "TOGGS"); *In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1288 (TTAB 2006) (holding GALA ROUGE for wine not unitary and affirming requirement for disclaimer of "ROUGE"); *In re Lean Line, Inc.*, 229 USPQ 781 (TTAB 1986) (holding LEAN LINE for low calorie foods not unitary; requirement for disclaimer of "LEAN" held proper); *In re IBP, Inc.*, 228 USPQ 303 (TTAB 1985) (holding IBP SELECT TRIM for pork not unitary; refusal of registration in the absence of a disclaimer of "SELECT TRIM" affirmed); *In re Uniroyal*, Inc., 215 USPQ 716 (TTAB 1982) (holding UNIROYAL STEEL/GLAS for vehicle tires not unitary; requirement for disclaimer of "STEEL/GLAS" deemed appropriate); *In re EBS Data Processing*, 212 USPQ at 966 (TTAB 1981) (holding PHACTS POCKET PROFILE, for personal medication history summary and record forms, 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 Nat'l Presto Indus., Inc.*, 197 USPQ 188 (TTAB 1977) (holding PRESTO BURGER for electrical cooking utensils not unitary; requirement for disclaimer of "BURGER" affirmed).

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. *SeeIn re Sadoru Group, Ltd.*, 105 USPQ2d 1484 (TTAB 2012) (finding the stylization of SADORU does not create a separate and inherently distinctive commercial impression apart from the word itself); *In re Carlson*, 91 USPQ2d 1198, 1203 (TTAB 2009); *In re Anchor Hocking Corp.*, 223 USPQ 85, 86 (TTAB 1984) (citing *In re Carolyn's Candies, Inc.*, 206 USPQ 356, 360 (TTAB 1980)); *Ex parte Ste. Pierre Smirnoff Fls, Inc.*, 102 USPQ 415, 416 (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.

See also In re MCI Commc'n Corp., 21 USPQ2d 1534, 1538 (Comm'r Pat. 1991).

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 §§807.14–807.14(f).

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.*, 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. *See Dena Corp. v. Belvedere Int'l Inc.*, 950 F.2d 1555, 1561, 21 USPQ2d 1047, 1052 (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 Trademark 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 1022 OG 44 (Sept. 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 data base 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 "_____" and "_____" apart from the mark as shown.

While the "and" connector is preferred, the USPTO will also accept a statement that "no claim is made to the exclusive right to use "_____" or "_____" 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., 175 USPQ 621, 621-22 (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(a)(iii) Unacceptable Statements in Disclaimers

A statement that purports to limit a mark by excluding color(s) or other features that do not appear in the mark is not appropriate for inclusion in a disclaimer. The issue most often arises where there are possible infringement issues involving a particular color, the applicant's mark does not claim any color, but the applicant attempts to "disclaim" the color from the application with a statement such as: "No claim is made to the exclusive right to use the color purple within or as part of the (design element) apart from the mark as shown."

Although applicants may include such restrictive statements in the application record, they are not appropriate for the registration certificate. Accordingly, if an applicant inserts any such limiting statement in a disclaimer, the examining attorney must ensure that it is deleted from the Trademark database so that it will not be printed on the registration certificate.

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 be disclaimed in their entirety. *See, e.g., In re Med. Disposables Co.*, 25 USPQ2d 1801 (TTAB 1992) (finding MEDICAL DISPOSABLES to be a unitary expression that must be disclaimed as a composite); *Am. Speech-Language-Hearing Ass'n v. Nat'l Hearing Aid Soc'y*, 224 USPQ 798, 805 n.3 (TTAB 1984) (finding "CERTIFIED HEARING AID AUDIOLOGIST" to be "a unitary expression that should be disclaimed in its entirety"); *In re Surelock Mfg. Co.*, 125 USPQ 23, 24 (TTAB 1960) (holding proposed disclaimer of "THE" and "RED" and "CUP" 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"); *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.").

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) (reversing requirement for unitary disclaimer of "SNAP ON 3000," and accepting 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 must require disclaimer of the word or words in the correct spelling. *See In re Omaha Nat'l Corp.*,

819 F.2d 1117, 1119, 2 USPQ2d 1859, 1861 (Fed. Cir. 1987); *In re Carlson*, 91 USPQ2d 1198, 1203 (TTAB 2009); *In re Newport Fastener Co.* , 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 must offer the applicant the opportunity to withdraw the disclaimer. If it is necessary to communicate with the applicant about another matter, the examining attorney must 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 email. 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 email message (applicant should be given at least three business days), the examining attorney must enter an appropriate Note to the File in the record. Again, the disclaimer does not 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.* , 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 must 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 §§809–809.03 regarding translation and transliteration 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 §2(d) of the Trademark Act, 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 Nat'l Data Corp.*, 753 F.2d 1056, 1059, 224 USPQ 749, 751 (Fed. Cir. 1985); *Specialty Brands, Inc. v. Coffee Bean Distribs.*,

Inc., 748 F.2d 669, 672, 223 USPQ 1281, 1282 (Fed. Cir. 1984); *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 Commc'ns 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 Commc'ns 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, Inc. v. Comm'r of Pats.*, 252 U.S. 538, 545 (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 Prods., Inc.*, 107 F.2d 82, 84, 43 USPQ 425, 427 (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." 15 U.S.C. §1056 (1946), *amended by* 15 U.S.C. §1056(b) (1962). 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 must be examined in the same manner as other applications. *See Quaker Oil Corp. v. Quaker State Oil Ref. Corp.*, 161 USPQ 547, 549 (TTAB 1969), *aff'd*, 453 F.2d 1296, 172 USPQ 361 (C.C.P.A. 1972); *Victor Tool & Mach. Corp. v. Sun Control Awnings, Inc.*, 299 F. Supp. 868, 875-76, 162 USPQ 389, 394 (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. *See Roux Distrib. Co. v. Duart Mfg. Co.*, 114 USPQ 511, 512 (Comm'r Pats. 1957); *Helena Rubinstein, Inc. v. Ladd*, 219 F. Supp. 259, 260, 138 USPQ 106, 107 (D.D.C. 1963), *aff'd*, 141 USPQ 623 (D.C. Cir. 1964).

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

If an application seeks registration of a mark with a significant changeable or "phantom" element, the examining attorney must consider whether the element encompasses so many potential combinations that the drawing would not give adequate constructive notice to third parties as to the nature of the mark and a thorough and effective search for conflicting marks is not possible. If so, the examining attorney must 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 Int'l Flavors & Fragrances Inc.*, 183 F.3d 1361, 51 USPQ2d 1513 (Fed. Cir. 1999); *In re Soc'y of Health & Physical Educators*, 127 USPQ2d 1584 (TTAB 2018); *In re Constr. Research & Tech. GmbH*, 122 USPQ2d 1583 (TTAB 2017); *In re Primo Water Corp.*, 87 USPQ2d 1376 (TTAB 2008); *see also*TMEP §807.01 (regarding the requirement that an application be limited to one mark).

In *International Flavors*, the applicant filed three applications to register the designations "LIVING xxxx," "LIVING xxxx FLAVOR," and "LIVING xxxx FLAVORS," for essential oils and flavor substances. The applications indicated that "the 'xxxx' served to denote 'a specific herb, fruit, plant or vegetable.'" *Int'l Flavors*, 183 F.3d at 1363-64, 51 USPQ2d at 1514-15. 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 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. *Id.* at 1367-68, 51 USPQ2d at 1517-18.

In Soc'y of Health & Physical Educators, the Board affirmed a refusal of the standard-character mark SHAPE XXX, in which "XXX" was intended to denote "the unabbreviated name of a state of the United States and Puerto Rico." *In re Soc'y of Health & Physical Educators*, 127 USPQ2d at 1585. The Board noted that the registrability of a mark with a variable element depends on "whether the permutations of the variable element affect the commercial impression so as to result in more than one mark." *Id.* at 1587. Thus, for such a mark to register, the "the possible variations of the mark must be legal equivalents." *Id.* The Board found that, while the variable element in the applied-for mark was geographically descriptive, it nonetheless "alters the characteristics of the purported mark SHAPE XXXX, resulting in the commercial impression of multiple marks" and that "[t]he differences in the variable elements are more than minor variations or inconsequential modifications of the basic mark." *Id.* at 1589 (noting that the variable terms have different meanings, sounds, and appearances, and may also acquire distinctiveness). Accordingly, the Board determined that "the different permutations of SHAPE XXXX are not legal equivalents" and therefore the mark comprised more than one mark. *Id.* at 1588, 1590.

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." *Primo Water*, 87 USPQ2d at 1377. 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. *Id.* at 1379-80. 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. *Id.* at 1380; *see alsoIn re Upper Deck Co.*, 59 USPQ2d 1688, 1691 (TTAB 2001) (finding 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).

A mark with a changeable element may be registrable if the element is limited in terms of the number of possible variations, such that the drawing provides adequate notice as to the nature of the mark and an effective §2(d) search is possible. *Cf. In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1347-48, 57 USPQ2d 1807, 1812-13 (Fed. Cir. 2001) (rejecting the argument that the mark (212) M-A-T-T-R-E-S is an unregistrable phantom mark, because, although 212 was displayed in dotted lines to indicate it was a changeable element, it was clear that this element was "an area code, the possibilities of which are limited by the offerings of the telephone companies"). For example, a "phantom mark" refusal would not be necessary for the mark T.MARKEY TRADEMARK EXHIBITION 2***, in which the asterisks represent elements that change to indicate different years. However, if the changeable element's potential significance and range of meanings is not readily clear from the context, and thus the public would be unable to determine scope of any resulting registration, refusal is appropriate. *See In re Constr. Research & Tech. GmbH*, 122 USPQ2d at 1586 (affirming a "phantom mark" refusal of the marks NP - - - and SL - - -, in which "- - -" represented up to three numeric digits, noting that the missing information in the marks is potentially wide-ranging and subject to different interpretations depending on the context).

See 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

The examining attorney must also consider whether the "phantom mark" 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 §§807.12–807.12(e).

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 §§807.14–807.14(f) 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. In that case, 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 may 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.

Otherwise, if it is clear that the applicant is seeking registration of a "phantom mark" (e.g., if the application includes a statement that "the blank line represents matter that is subject to change") that would not provide adequate constructive notice of the nature of the mark and that precludes a thorough and effective search for conflicting marks (*see*TMEP §1214.02), 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.

1214.04 "Phantom Marks" in §44 and §66(a) Applications

The "phantom mark" refusal may be issued 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. 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.

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. A TLD is the string of letters that follows the last "." or "dot".

Example: If the domain name is "ABC.com," the term "ABC" is a second-level domain and the term "com" is a TLD.

Generic TLDs. If a TLD has three or more characters, it is known as a "generic top-level domain" or "gTLD." The following are examples of gTLDs designated for use by the public:

.com	commercial, for-profit organizations
.edu	4-year, degree-granting colleges/universities
.gov	U.S. federal government agencies
.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 gTLDs listed above is intended for use by a certain type of organization. For example, the gTLD ".com" is for use by commercial, for-profit organizations. However, the administrator of the .com, .net, .org, and .edu gTLDs 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 gTLDs. On the other hand, .mil, .gov, and .int gTLD 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 its 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** and TMEP §§1215.02(d)(i) 1215.02(d)(iv) for additional information about other gTLDs and TMEP §1209.03(m) about descriptiveness or genericness of marks comprising domain names.

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 gTLD has 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 gTLD are a part of every URL.

However, in 2011, the Internet Corporation for Assigned Names and Numbers (ICANN) authorized the launch of a program to introduce new gTLDs. Some of the gTLDs under consideration may have significance as source identifiers. To the extent that some of the new gTLDs under consideration comprise existing registered trademarks or service marks that are already strong source identifiers in other fields of use, some of the premises mentioned above may no longer hold true for such gTLDs (e.g., a gTLD consisting of a coined mark is not an abbreviation of an entity type or class of intended user of domain space). Where the wording following the "." or "dot" is already used as a trademark or service mark, the appearance of such marks as a gTLD may not negate the consumer perception of them as source indicators. Accordingly, in some circumstances, a gTLD may have source-indicating significance. See TMEP §1215.02(d) 1215.02(d)(iv) (mark consisting of a gTLD for domain registry operator and domain name registrar services, where the wording following the "." or "dot" is already used as a trademark or service mark, may be registrable).

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, 1479 (TTAB 2008) (finding that irestmycase did not function as a 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, 1957 (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:

WILLIAM H. EILBERG
ATTORNEY AT LAW
820 HOMESTEAD ROAD, P.O. BOX 7
JENKINTOWN, PENNSYLVANIA 19046
215-885-4600
FAX: 215-885-4603
EMAIL WHE@EILBERG.COM

PATENTS, TRADEMARKS
AND COPYRIGHTS

WWW.EILBERG.COM

(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.

Eilberg, 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. *SeeIn re The Standard Oil Co.*, 275 F.2d 945, 947, 125 USPQ 227, 229 (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 services 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, 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" under the Trademark Act. *In re Reichhold Chems., 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. The statutory basis for the refusal is 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 generally look to the second-level domain name for source identification, not to the generic top-level domain (gTLD) 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 a traditional gTLD (such as .COM) or the terms "http://www." or "www." However, if the mark depicted in the specimen includes a gTLD that serves a source-indicating function, the drawing of record must include such source-indicating gTLD. *Cf. Institut Nat'l des Appellations D'Origine v. Vintners Int'l Co.* , 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)–(b), and TMEP §§807.12–807.12(e).

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 specimen only shows ABC). If the drawing of the mark includes a gTLD, or the terms "http://www." or "www.," the specimen must also show the mark used with these 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.

If, in an application in which the identification of services specifies or otherwise encompasses domain registry operator or domain name registrar services, and the applied-for mark consists of or includes wording without a dot (".") before it, but the specimen provided shows use of the mark only with a "." before the wording, or vice versa, the examining attorney must refuse the specimen on the grounds that the marks do not match because the commercial impression created by the applied-for mark differs from the commercial impression created by the mark shown in the specimen. Specifically, when used in connection with domain registry operator or domain name registrar services, wording immediately preceded by a "." will likely be viewed by consumers as a generic top-level domain (gTLD). On the other hand, the same wording, used in connection with the same services, but shown without the "." would not give the impression of a gTLD and could be viewed as an indicator of source, such that the commercial impression created by the marks materially differs. Thus, in this context, the "."does not constitute the type of "extraneous, nondistinctive punctuation" discussed in TMEP §807.12(a)(i) and the drawing may not be amended to add a "." to, or delete a "." from, the mark. *See*TMEP §1215.08(c).

Example: If the applied-for mark is TMARKIE for "domain-name registration services," a specimen that shows the mark as .TMARKIE is unacceptable.

See TMEP §§807.14–807.14(f) and 1215.08–1215.08(b) regarding material alteration.

1215.02(d) Marks Comprised Solely of gTLDs for Domain Registry Operator and Domain Name Registrar Services

Background . A "registry operator" maintains the master database of all domain names registered in each top-level domain (TLD), and also generates the "zone file," which allows computers to route Internet traffic to and from TLDs anywhere in the world. A "registrar" is an entity through which domain names may be registered, and which is responsible for keeping website contact information records and submitting the technical information to a central directory known as the "registry." The terms "registry operator" and "registrar" refer to distinct activities and are not interchangeable. Further, "registry operators" and "registrars" are distinguishable from re-sellers, which are entities that are authorized by registrars to sell or register particular Internet addresses on a given TLD. See Internet Corporation for Assigned Names and Numbers (ICANN), Acronyms and Terms, **https://www.icann.org/en/icann-acronyms-and-terms?nav-letter=a&page=1** (accessed Nov. 30, 2022).

Failure to function refusal. A mark composed solely of a generic TLD (gTLD) for domain registry operator or domain name registrar services typically fails to function as a mark because consumers are predisposed to perceive gTLDs as merely a portion of a web address rather than as an indicator of the source of domain registry operator and domain name registrar services. *See In re Vox Populi Registry Ltd.*, 2020 USPQ2d 11289, at *3-4 (TTAB 2020) (citing *In re AC Webconnecting Holding B.V.*, 2020 USPQ2d 11048, at *3-4 (TTAB 2020)), *aff'd*, 25 F.4th 1348, 2022 USPQ2d 115 (Fed. Cir. 2022); TMEP §1215.02. For any proposed mark, including a gTLD, the determination of whether the designation functions as a mark hinges on consumer perception. *In re Vox Populi Registry Ltd.*, 25 F.4th 1348, 1351, 2022 USPQ2d 115, at *2 (Fed. Cir. 2022); *In re AC Webconnecting Holding B.V.*, 2020 USPQ2d 11048, at *3. Therefore, registration on the Principal Register of such proposed marks must initially be refused under Trademark Act §§1, 2, 3, and 45, 15 U.S.C. §§1051, 1052, 1053, and 1127, on the ground that the gTLD does not function as a mark to identify and distinguish the source of the services because it would not be perceived as a mark. TMEP §1301.02(a). For applications on the Supplemental Register, the refusal must be made under Trademark Act §§23(c) and 45, 15 U.S.C §§1091(c), 1127.

Including stylization in a gTLD does not render it registrable on the Principal Register unless the stylization creates a commercial impression separate and apart from the impression made by the wording itself. *In re*

Vox Populi Registry, 25 F.4th at 1353, 2022 USPQ2d 115, at *4; *In re Cordua Rests., Inc.*, 823 F.3d 594, 606, 118 USPQ2d 1632, 1639-40 (Fed. Cir. 2016). In addition, a "completely ordinary and nondistinctive" stylized display of a gTLD does not render it registrable on the Supplemental Register. *In re AC Webconnecting Holding B.V.*, 2020 USPQ2d 11048, at *13-14 (citing *In re Anchor Hocking Corp.*, 223 USPQ 85, 88 (TTAB 1984)). See TMEP §1209.03(w) regarding stylization of descriptive or generic wording.

Response options. The applicant may, in some circumstances, avoid or overcome the refusal by providing evidence that the mark will be perceived by consumers as a source identifier. In addition to such evidence, the applicant must show that: (1) it has entered into a currently valid Registry Agreement with ICANN designating the applicant as the Registry Operator for the gTLD identified by the mark and (2) the identified services will be primarily for the benefit of others.

Descriptiveness refusal. If the gTLD merely describes the subject or user of the domain space, the examining attorney must also refuse registration under Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1), on the ground that the gTLD is merely descriptive of the registry services. See TMEP §§1209-1209.03(w) regarding refusals based on descriptiveness.

1215.02(d)(i) Prior Registration(s) of the Same Mark for Goods or Services in the Same Field of Use

Relevant evidence that the gTLD shown in the mark may be perceived as a source identifier includes evidence that the gTLD is the subject of one or more prior U.S. registrations for goods/services that are related to the identified subject matter of the websites to be registered via the domain registry operator and domain name registrar services. Applicants seeking to demonstrate that a gTLD functions as a mark by relying on prior U.S. registration(s) must establish:

(1) Ownership of one or more currently active U.S. registrations on the Principal Register for the same mark, based on use in commerce under §1 of the Trademark Act, 15 U.S.C. §1051, or
(2) Ownership of a U.S. registration on the Principal Register for the same mark, based on either a foreign registration under §44(e) of the Trademark Act, 15 U.S.C. §1126(e), for which an affidavit of use in commerce under §8 of the Trademark Act, 15 U.S.C. § 1058, has been accepted, or a registration under §66(a) of the Trademark Act, 15 U.S.C. §1141(f)(a), for which an affidavit of use in commerce under §71 of the Trademark Act, 15 U.S.C. §1141k, has been accepted.

The prior U.S. registration(s) must show the same mark as that shown in the relevant application. However, the lack of a "." or "dot" in the prior U.S. registration(s) is not determinative as to whether the mark in the registration is the same as the mark in the application. In addition, the prior registration may be registered pursuant to §2(f) of the Trademark Act, 15 U.S.C. §1052(f).

Because a consumer's ability to recognize a gTLD in an application as a source-identifying mark is based, in part, on the applicant's prior registration(s) for the same mark, the applicant must limit the "field of use" for the identified domain registry operator and domain name registrar services to fields that are related to the goods/services listed in the submitted prior registration(s). For example, if the applicant submits prior registrations identifying its goods as "automobiles," the services in the application may be identified as "domain name registrar services for websites featuring automobiles." However, the applicant may not identify its services as, for example, "domain name registrar services for websites featuring restaurants" or merely as "domain name registrar services."

If the applicant does not specify a field of use for the identified domain registry operator and domain name registrar services, or specifies a field of use that includes goods/services not listed in the prior registration(s), the examining attorney must require the applicant to amend the identification of services so as to indicate only a field of use that is related to goods/services that are the subject of the prior registration(s). In amending the identification, the applicant may not broaden its scope. 37 C.F.R. §2.71(a); TMEP §§1402.06–1402.06(b).

If the application is not amended, or cannot be amended, to specify a field of use that is related to the goods/services listed in the prior registration(s), the examining attorney must refuse registration under Trademark Act §§1, 2, 3, and 45, 15 U.S.C. §§1051, 1052, 1053, and 1127, because, absent a relevant prior registration, the gTLD would not be perceived by consumers as a mark.

1215.02(d)(ii) Additional Proof that the Mark Used as a gTLD Will Be Perceived as a Mark

In addition to the prior registration(s), the applicant must also submit a significant amount of additional evidence relevant to the issue of whether the mark, with or without the "." or "dot," will immediately function to identify the source of the domain registry operator and domain name registrar services rather than merely being perceived as a portion of an Internet domain name that can be acquired through applicant's services. Because consumers are so highly conditioned, and may be predisposed, to view gTLDs as non-source-indicating, the applicant must show that consumers already will be so familiar with the wording as a mark that they will transfer the source recognition even to the domain registry operator and domain name registrar services. The amount of additional evidence required may vary, depending on the nature of the wording set out in the gTLD, Relevant evidence may include, but is not limited to: examples of advertising and promotional materials that specifically promote the mark shown in the application, with or without the "." or "dot," as a trademark or service mark in the United States; dollar figures for advertising devoted to such promotion; and/or sworn consumer statements of recognition of the applied-for mark as a trademark or service mark.

1215.02(d)(iii) Registry Agreement/ICANN Contract

If the applicant has not entered into a Registry Agreement with ICANN designating the applicant as the Registry Operator for the gTLD identified by the mark, consumers may be deceived by use of a particular gTLD as a mark. Consumers generally would believe that the applicant's domain registry operator and domain name registrar services feature the gTLD in the proposed mark, and would consider that material in the purchase of these services. Therefore, to avoid a deceptiveness refusal under §2(a) of the Trademark Act, 15 U.S.C. §1052(a); TMEP §§1203, 1203.02–1203.02(g), the applicant must: (1) submit evidence that it has entered into a currently valid Registry Agreement with ICANN, designating the applicant as the Registry Operator for the gTLD identified by the mark prior to registration and (2) indicate in the identification of services that the domain registry operator and domain name registrar services feature the gTLD shown in the mark.

If the application does not include a verified statement indicating that the applicant has an active or currently pending application for a Registry Agreement with ICANN designating the applicant as the Registry Operator for the gTLD identified by the mark, the examining attorney must issue an Office action with an information request under Trademark Rule 2.61(b), 37 C.F.R. 2.61(b), that requires the applicant to submit a verified statement indicating: (1) whether the applicant has in place, or has applied for, such a Registry Agreement with ICANN and (2) if the applicant has so applied, the current status of such application. The examining attorney must include an advisory indicating that if the applicant does not have a currently active, or currently pending application for a, Registry Agreement with ICANN designating the applicant as the Registry Operator for the gTLD identified by the mark, a deceptiveness refusal will be issued pursuant to §2(a). A currently pending application with ICANN avoids an immediate deceptiveness refusal, but as discussed below, the

USPTO will not approve the trademark application for publication without proof of the award of the Registry Agreement.

If the applicant fails to respond to the information requirement, the examining attorney must maintain and continue the information requirement and issue a deceptiveness refusal under §2(a). If, in response to the information requirement, the applicant indicates that: (1) the applicant has not applied for a Registry Agreement with ICANN designating the applicant as the Registry Operator for the gTLD identified by the mark; (2) the applicant has applied for a Registry Agreement with ICANN designating the applicant as the Registry Operator for the gTLD identified by the mark, but that the application has not been approved and is no longer pending with ICANN; or (3) the applicant's previous Registry Agreement with ICANN is no longer valid, the examining attorney must issue a deceptiveness refusal under §2(a).

If the applicant indicates that it has a currently pending application before ICANN for a Registry Agreement for the gTLD identified by the mark and the applicant has otherwise demonstrated that the mark consisting of the gTLD in the application before the USPTO could function as a mark, the examining attorney may suspend the application until the resolution of the applicant's pending application with ICANN. *See*TMEP §716.02(i).

1215.02(d)(iv) Legitimate Service for the Benefit of Others

To be considered a service within the parameters of the Trademark Act, an activity must, inter alia, be primarily for the benefit of someone other than the applicant. *See In re Reichhold Chems., Inc*., 167 USPQ 376, 377 (TTAB 1970); TMEP §1301.01(a)(ii). Therefore, the examining attorney must issue an information request pursuant to Trademark Rule 2.61(b), 37 C.F.R. 2.61(b), to ascertain the following information to determine if the domain registry operator and domain name registrar services will be primarily for the benefit of others:

> Does the applicant intend to use the applied-for mark as a gTLD?
> Does the applicant intend to operate a registry for the applied-for mark as a new gTLD and sign a Registry Agreement with ICANN for such gTLD?
> To what entities and industries will the applicant's domain registry operator and domain name registrar services be targeted?
> Does the applicant intend to register domain names for others using the gTLD identified by the applied-for mark and will there be any restrictions on to whom it will be available?

While operating a gTLD registry that is only available for the applicant's employees or for the applicant's marketing initiatives alone generally would not qualify as a service, registration for use by the applicant's affiliated distributors typically would.

If the applicant fails to indicate for the record that the applicant's domain registry operator and domain name registrar services are, or will be, primarily for the benefit of others, the examining attorney must refuse registration pursuant to §§1, 2, 3, and 45 of the Trademark Act, 15 U.S.C §§1051-1053, 1127. *See*TMEP §1301.01(a)(ii).

The USPTO's Acceptable Identification of Goods and Services Manual (ID Manual) includes "domain registry operator services" in International Class 42 and "domain name registrar services" in International Class 45 for use by those entities with valid Registry Agreements or current accreditation as a registrar by ICANN.

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 filed under §1(b) of the Trademark Act, a mark that includes a domain name will not be refused on this ground until the applicant has submitted specimen(s) of use *and* 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)). 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 must 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. 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, 15 U.S.C. §§1051, 1052, 1053, and 1127, for service marks.

1215.03 Surnames

If a mark is composed of a surname and a non-source-identifying gTLD, 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 gTLD has no trademark significance, and the primary significance of a term is that of a surname, adding the gTLD 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. for cigars held primarily merely a surname); *In re Hamilton Pharms. 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 for restaurant services 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 gTLD, in general, the examining attorney must 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 gTLD 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, 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; 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 Props. Inc.*, 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007) (LAWYERS.COM generic for "providing access to an online interactive database featuring information exchange in the fields of law, lawyers, 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 DNI Holdings Ltd.*, 77 USPQ2d 1435 (TTAB 2005) (SPORTSBETTING.COM 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 (TTAB 2003) (OFFICE.NET merely descriptive of various computer software and hardware products); *In re CyberFinancial.Net, Inc.*, 65 USPQ2d 1789 (TTAB 2002) (BONDS.COM generic for providing information regarding financial products and services and electronic commerce services rendered via the Internet); *In re Martin Container, Inc.*, 65 USPQ2d 1058 (TTAB 2002) (CONTAINER.COM generic for "retail store services and retail services offered via telephone featuring metal shipping containers" and "rental of metal shipping containers").

However, there is no bright-line, per se rule that the addition of a non-source-identifying gTLD 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 gTLD 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," noting that "the addition of the TLD can show Internet-related distinctiveness, intimating some 'Internet feature' of the item.") (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 must introduce evidence as to the significance of the individual components, including the gTLD, but must also consider the significance of the composite term (e.g., "Sportsbetting" in the mark SPORTSBETTING.COM) to determine whether the addition of the TLD has resulted in a mark that conveys a source-identifying impression.

*See also*TMEP §§1209.03(m), 1215.02(d) 1215.02(d)(iv), and 1215.05.

1215.05 Generic Refusals

There is no per se rule that the addition of a generic term to a generic top-level domain (gTLD) (i.e., a "generic.com" term) can never under any circumstances operate to create a registrable mark. *USPTO v. Booking.com B.V.*, 140 S. Ct. 2298, 2020 USPQ2d 10729 (2020) (holding that "[w]hether any given 'generic.com' term is generic ... depends on whether consumers in fact perceive that term as the name of a class or, instead, as a term capable of distinguishing among members of the class"). In reaching its decision in *Booking.com*, the Supreme Court left undisturbed a lower-court finding that ".com does not itself have source-identifying significance when added to a [second-level domain] like booking." *Booking.com B.V. v. USPTO*, 915 F.3d 171, 185 (4th Cir. 2019), *aff'd*, 140 S. Ct. 2298, 2301, 2020 USPQ2d 10729, at *2 (2020). Therefore, under Booking.com, a proposed mark composed of a generic term combined with a generic top-level domain, such as ".com," is not automatically generic, nor is it automatically non-generic. *See Booking.com*, 140 S. Ct. at 2307, 2020 USPQ2d 10729, at *7. Instead, as in any other genericness

analysis, examining attorneys must evaluate all of the available evidence, including the applicant's evidence of consumer perception, to determine whether the relevant consumers perceive the term as generic for the identified class of goods and/or services or, instead, as capable of serving as a mark. *See id.*; *In re Consumer Prot. Firm PLLC*, 2021 USPQ2d 238, at *6-9 (TTAB 2021).

Accordingly, generic.com terms are potentially capable of serving as a mark and may be eligible for registration on the Supplemental Register, or on the Principal Register upon a sufficient showing of acquired distinctiveness. However, a generic.com term may still be refused as generic when warranted by the evidence in the application record.

1215.05(a) Genericness Analysis and Relevant Evidence

Although the Court in *Booking.com* rejected a per se rule that generic.com terms are automatically generic, it specifically declined to adopt a rule that these terms are automatically non-generic. *See USPTO v. Booking.com B.V.*, 140 S. Ct. 2298, 2307, 2020 USPQ2d 10729, at *7 (2020). Thus, the decision did not otherwise significantly alter the genericness analysis to be applied to generic.com terms or the USPTO's examination procedures regarding marks consisting of a generic.com term, that is, any combination of a generic term and generic top-level domain designating an entity or information, such as ".com," ".net," ".org," ".biz," or ".info." Thus, examining attorneys must continue to assess on a case-by-case basis whether, based on the evidence of record, consumers would perceive a generic.com term as the name of a class of goods and/or services or, instead, as at least capable of serving as a source indicator.

To establish that a generic.com term is generic and incapable of serving as a source indicator, the examining attorney must show that the relevant consumers would understand the primary significance of the term, as a whole, to be the name of the class or category of the goods and/or services identified in the application. *See id*. at 2304, 2020 USPQ2d 10729, at *5; *In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 1364, 92 USPQ2d 1682, 1685 (Fed.Cir. 2009) ("[I]t is irrelevant whether the relevant public refers to online mattress retailers as 'mattress.com.'. . . the correct inquiry is whether the relevant public would understand, when hearing the term 'mattress.com,' that it refers to online mattress stores"); *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989-90, 228 USPQ 528, 530 (Fed. Cir. 1986); TMEP §1209.01(c)(i). Generally, evidence showing generic use of the generic.com term in its entirety, including evidence of domain names containing the term for third-party websites offering the same types of goods or services, is a competent source of the consumers' understanding that will support a finding of genericness. *See Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 968, 114 USPQ2d 1827, 1832 (Fed. Cir. 2015); TMEP §1209.01(c)(i); *see also In re Hotels.com, L.P.*, 573 F.3d 1300, 1304, 91 USPQ2d 1532, 1535-36 (Fed. Cir. 2009) (evidence of similar usages of "hotels.com" in domain names of others providing hotel information and reservation services supported a prima facie case of genericness); *In re Reed Elsevier Props.*, 482 F.3d 1376, 1379-80, 82 USPQ2d 1378, 1380-81 (Fed. Cir. 2007) (evidence of eight websites containing "lawyer.com" or "lawyers.com" in the domain name constituted substantial evidence to support the Trademark Trial and Appeal Board's (TTAB) finding that "LAWYERS.COM" is generic for the service of providing an online interactive database featuring information exchange in the field of law, legal news, and legal services). However, even in the absence of such evidence, a genericness refusal may be appropriate if the evidence of record otherwise establishes that the combination of the generic elements of the proposed mark "yields no additional meaning to *consumers* capable of distinguishing the goods or services." *See Booking.com*, 140 S. Ct. at 2306, 2020 USPQ2d 10729, at *7; *see also*TMEP §1209.01(c)(i).

Evidence of consumer perception may include "dictionaries, usage by consumers and competitors, use in the trade, and any other source of evidence bearing on how consumers perceive a term's meaning," including relevant and probative consumer surveys. *Booking.com*, 140 S. Ct. at 2307 n.6, 2020 USPQ2d 10729, at *7 n.6. These are the same types of evidence examining attorneys traditionally consider when assessing

genericness. *See, e.g., In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 1570, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987) ("Evidence of the public's understanding of the term may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers, and other publications.").

The following are examples of the types of evidence that may support the conclusion that consumers would perceive the generic.com term, as a whole, as the name of the class of goods and/or services:

> a combination of dictionary excerpts defining the component elements of the generic.com term;
> significant evidence of generic usage of those elements or the combined term by consumers or competitors in the relevant marketplace;
> evidence of the "generic.com" term used by third parties as part of their domain names (e.g., "[adjective]generic.com") in connection with the same or similar goods and/or services; or
> evidence of the applicant's own use of the generic.com term.

See In re Hotels.com, L.P., 573 F.3d 1300, 91 USPQ2d 1532 (Fed. Cir. 2009) (affirming the TTAB's finding that 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," and evidence from the applicant's website); TMEP §1209.01(c)(i).

When issuing a genericness refusal, the examining attorney must explain how the evidence of record supports the conclusion not only that the individual elements of the generic.com term are generic, but also that, when combined, the combination creates no new or additional significance among consumers capable of indicating source. *See In re 1800Mattress.com IP*, 586 F.3d 1359, 1363, 92 USPQ2d 1682, 1684 (Fed. Cir. 2001) (affirming the TTAB's conclusion that MATTRESS.COM is generic for "online retail store services in the field of mattresses, beds, and bedding," where the TTAB considered each of the constituent words, "mattress" and ".com," and determined that they were both generic, and 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 1306, 91 USPQ2d at 1537; TMEP §1209.01(c)(i).

1215.05(b) Procedures for Refusals

Consistent with existing examination procedures, the examining attorney must not initially refuse registration of a generic.com term on the Principal Register as generic, even if there is strong evidence of genericness. *See*TMEP §1209.02(a). Instead, the examining attorney must refuse the proposed mark as merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), and provide relevant supporting evidence. *See id.* If the evidence strongly suggests that the generic.com term is not capable of serving as a source indicator, the refusal must include an advisory that a claim of acquired distinctiveness or an amendment to the Supplemental Register is not recommended. *See id.* If, on the other hand, the examining attorney determines that the generic.com term is at least capable of serving as a source indicator based on the available evidence, then the examining attorney may advise that the applicant may amend the application to the Supplemental Register. *See*TMEP §816.04. If the record creates doubt as to whether the applied-for generic.com term is capable of functioning as a mark, the examining attorney must refrain from giving any advisory statement. *See*TMEP §1209.02(a).

If the initial application seeks registration on the Supplemental Register or on the Principal Register under a claim of acquired distinctiveness, and there is strong evidence of genericness, then a refusal on the basis that the generic.com term is generic will be appropriate.

1215.05(b)(i) Claim of Acquired Distinctiveness

If the application itself or a subsequent submission includes a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. §1052(f), the examining attorney must carefully review the applicant's evidence in support of the claim, along with all other available evidence, to determine whether the relevant consumers have, in fact, come to view the proposed generic.com term as an indicator of source for the identified goods and/or services. *See generally*TMEP §§1212.01-1212.02.

Under *Booking.com*, generic.com terms are neither per se generic, nor *per se* non-generic. *See USPTO v. Booking.com B.V.*, 140 S. Ct. 2298, 2307, 2020 USPQ2d 10729, at *7 (2020). However, given the nature of these terms, the available evidence will likely support a conclusion that they are, at least, highly descriptive, and thus consumers would be less likely to believe that they indicate source in any party. *See In re Steelbuilding.com*, 415 F.3d 1293, 1301, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005) (holding that STEELBULDING.COM was highly descriptive and unregistrable on the Principal Register under §2(e)(1), absent "a concomitantly high level of secondary meaning."). Thus, for generic.com terms, applicants will generally have a greater evidentiary burden to establish that the proposed mark has acquired distinctiveness. *See Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 1368, 127 USPQ2d 1041, 1047 (Fed. Cir. 2018); *In re Nat'l Ass'n of Veterinary Technicians in Am.*, 2019 USPQ2d 269108, at *6 (TTAB 2019); *In re Yarnell Ice Cream, LLC*, 2019 USPQ2d 265039, at *9 (TTAB 2019); *see also*TMEP §1212.01.

Accordingly, evidence of five years' use or reliance solely on a prior registration for the same term will usually be insufficient to support a Section 2(f) claim for a generic.com term. *See*TMEP §§1212.04-1212.04(a), 1212.05(a). Typically, the applicant will need to provide a significant amount of actual evidence that the generic.com term has acquired distinctiveness in the minds of consumers. *See*TMEP §§1212.06-1212.06(e)(vi).

Evidence submitted in support of the Section 2(f) claim may include consumer surveys; consumer declarations; declarations or other relevant and probative evidence showing the duration, extent, and nature of the applicant's use of the proposed mark, including the degree of exclusivity of use; related advertising expenditures; letters or statements from the trade or public; and any other appropriate evidence tending to show that the proposed mark distinguishes the goods or services to consumers. *See* 37 C.F.R. §2.41; TMEP §§1212.06-1212.06(e)(vi).

Regarding consumer surveys, in particular, the Supreme Court cautioned that they must be properly designed and interpreted to ensure that they are an accurate and reliable representation of consumer perception of a proposed mark. *See Booking.com* , 140 S. Ct. at 2307 n.6, 2020 USPQ2d 10729, at *7 n.6.; *accord id.* at 2309, 2020 USPQ2d 10729, at *9 (Sotomayor, J., concurring) ("Flaws in a specific survey design, or weaknesses inherent in consumer surveys generally, may limit the probative value of surveys in determining whether a particular mark is descriptive or generic in this context."). Therefore, an applicant submitting a survey must carefully frame its questions and provide a report, typically from a survey expert, documenting the procedural aspects of the survey and statistical accuracy of the results. *See* TMEP §1212.06(d). Information regarding how the survey was conducted, the questionnaire itself, the universe of consumers surveyed, the number of participants surveyed, and the geographic scope of the survey should be submitted within or along with such a report. *See id.* If this information is not provided, the examining attorney may request it under 37 C.F.R. §2.61(b).

If the examining attorney determines that the evidence of record establishes that the generic.com term is, in fact, a generic name for the identified goods and/or services, the examining attorney must refuse registration on the ground that the term is generic and indicate that the claim of acquired distinctiveness does not overcome the refusal. *See*TMEP §§1209.02(a)(ii), 1209.02(b). The statutory basis for this refusal is Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051, 1052, and 1127, for goods, or Sections 1, 2, 3, and 45, 15 U.S.C. §§1051, 1052, 1053, and 1127, for services. In addition to this refusal, the examining attorney must issue or maintain, in the alternative, a refusal under Trademark Act Section 2(e)(1) on the ground that the proposed mark is merely descriptive. *See Id*. This refusal must separately explain why the showing of acquired distinctiveness is insufficient to overcome the descriptiveness refusal even if the proposed mark is ultimately deemed not to be generic. *See Id*.

1215.05(b)(ii) Supplemental Register

If the application itself or a subsequent submission requests registration on the Supplemental Register, and the evidence supports a determination that the proposed generic.com term is generic, registration must be refused under Trademark Act Sections 23(c) and 45, 15 U.S.C. §§1091(c), 1127. *See*TMEP §1209.02(a)(i).

If the examining attorney determines that the available evidence establishes that the proposed generic.com term is at least capable of indicating source but is insufficient to show that the term has acquired distinctiveness, the examining attorney may allow registration on the Supplemental Register, if otherwise appropriate. *See*TMEP §§815-815.02.

1215.05(c) Generic.com Terms Combined with Other Matter

Examining attorneys must follow existing disclaimer policy and procedure when examining proposed marks containing generic.com terms and other matter. *See generally*TMEP §§1213-1213.11. If the examining attorney determines that, based on the evidence, the generic.com term is incapable of serving as a source indicator and is separable from the other matter in the proposed mark, a disclaimer of the term is appropriate, whether registration is sought on the Principal Register or Supplemental Register. *See*TMEP §1213.03(b). Generally, when disclaiming a generic.com term, the term must be disclaimed in its entirety, rather than disclaiming the generic term and the generic top-level domain separately. *See*TMEP §1213.08(b).

If an applicant claims acquired distinctiveness in part as to a generic.com term that is combined with other matter, the evidence of acquired distinctiveness should be evaluated in accordance with TMEP §1215.05(b)(i).

1215.05(d) Failure to Function

Examining attorneys must also consider whether the specimen of use shows the generic.com term being used solely as a website address and not in a trademark or service mark manner. If so, a refusal on the ground that the proposed mark fails to function as a trademark or service mark is appropriate. *See*TMEP §1202. The statutory basis for this refusal is Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051, 1052, and 1127, for goods, or Sections 1, 2, 3, and 45, 15 U.S.C. §§1051, 1052, 1053, and 1127, for services. The statutory basis for refusal of registration on the Supplemental Register of matter that does not function as a mark is Sections 23(c) and 45 of the Trademark Act, 15 U.S.C. §§1091(c), 1127.

1215.05(e) Section 2(d) Considerations

In *Booking.com*, the Supreme Court recognized that registered generic.com terms may be subject to a narrower scope of trademark protection, noting that "[w]hen a mark incorporates generic or highly descriptive

components, consumers are less likely to think that other uses of the common element emanate from the mark's owner." *USPTO v. Booking.com B.V.*, 140 S. Ct. 2298, 2307, 2020 USPQ2d 10729, at *7 (2020).

Accordingly, examining attorneys may take this into account when considering whether a prior registration for a generic.com term that contains the same generic or highly descriptive terms that appear in a proposed mark should be cited under Trademark Act Section 2(d). Generally, in these circumstances, if there is other matter in either of the marks that would allow consumers to differentiate them, the examining attorney may reasonably determine that confusion as to source is not likely. *Cf.*TMEP §1207.01(d)(iii) ("[A]ctive third-party registrations may be relevant to show that a mark or a portion of a 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."). However, each case must be considered on its own merits, with consideration given to all relevant likelihood-of-confusion factors for which there is evidence of record. *See*TMEP §1207.01. For more information regarding Section 2(d) and domain names, see TMEP §1215.09.

1215.06 Marks Containing Geographical Matter

The examining attorney should examine marks containing geographic matter along with a gTLD in the same manner that any mark containing geographic matter is examined. *See generally*TMEP §§1210–1210.10. 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 must 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 §§1213–1213.11 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 gTLD), 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 gTLD is considered unitary, and, therefore, no disclaimer of the gTLD is required. See examples below and TMEP §§1213.05–1213.05(g)(iv) 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 §§807.14–807.14(f) regarding further information about material alteration. *In re Yale Sportswear Corp*., 88 USPQ2d 1121 (TTAB 2008) (mark on the specimen (UPPER 90°) not a substantially exact representation of the mark on the drawing (UPPER 90); *In re Innovative Cos.*, LLC, 88 USPQ2d 1095 (TTAB 2008) (proposed amendment of the drawing from FREEDOMSTONE to FREEDOM STONE not material alteration of the mark); *Paris Glove of Can., LTD, v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1862 (TTAB 2007) (in an application to renew a registration, the old and new specimens (AQUA STOP and AQUASTOP, both stylized) 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 gTLD to/from the drawing of a domain name mark (e.g., COOPER amended to COOPER.COM, or COOPER.COM amended to COOPER) that includes an inherently distinctive or descriptive second-level domain name without materially altering the mark. Although a mark that includes a gTLD generally will be perceived by the public as a domain name, while a mark without a gTLD will not, if the gTLD merely indicates the type of entity using the domain name, the essence of the mark in such cases is created by the second-level domain name, not the gTLD. Thus, the commercial impression created by the second-level domain name usually remains the same whether the non-source-identifying gTLD is present or not. If the gTLD 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 gTLD.

Similarly, substituting one non-source-identifying gTLD 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 original mark was ABC and the proposed mark now includes a source-identifying gTLD.

1215.08(b) Adding or Deleting gTLDs in Other Marks

If a mark that is not used as an Internet domain name includes a gTLD, adding or deleting the gTLD may be a material alteration.

Example: Deleting the term .COM from the mark ".COM " used on printed sports magazines would materially change the mark.

1215.08(c) Adding or Deleting "." in Marks for Domain Registry Operator or Domain Name Registrar Services

When used in connection with domain registry operator or domain name registrar services, wording immediately preceded by a dot (".") will likely be viewed by consumers as a gTLD. On the other hand, the same wording, used in connection with the same services, but shown without the "." would not give the impression of a gTLD and could be viewed as an indicator of source, such that the commercial impression created by the marks materially differs. Thus, the "." in this context does not constitute the type of "extraneous, nondistinctive punctuation" discussed in TMEP §807.12(a)(i).

Accordingly, an applicant may not amend an application to add a "." before wording in a mark for which the identification of services encompasses domain name registry operator or registrar services. Nor may an applicant amend a drawing to delete a "." from the beginning of wording in a mark in these instances.

Example: Amending an applied-for mark from TMARKIE to .TMARKIE would materially change the commercial impression of the mark from that of a source-indicating mark to that of a gTLD.

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 gTLD portion of the mark. *Apple Comput. v. TVNET.net, Inc.*, 90 USPQ2d 1393 (TTAB 2007); *see*TMEP §1207.01(b)(iii). For more information regarding Section 2(d) and generic.com terms, see TMEP §1215.05(e).

1215.10 Marks Containing the Phonetic Equivalent of a Generic Top-Level Domain

Marks that contain the phonetic equivalent of a non-source-identifying gTLD (e.g., ABC DOTCOM) are treated in the same manner as marks composed of the gTLD itself. If a disclaimer is necessary, the disclaimer must be in the form of the gTLD 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 must 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 gTLD ".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 Prods., Inc.*, 671 F.2d 1332, 213 USPQ 9 (C.C.P.A. 1982); *In re Thunderbird Prods. 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. *SeeIn re Cordua Rests., Inc.*, 823 F.3d 594, 600, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016)("The PTO is required to examine all trademark applications for compliance with each and every eligibility requirement . . . even if the PTO earlier mistakenly registered a similar or identical mark suffering the same defect."); *In re Omega SA*, 494 F.3d 1362, 83 USPQ2d 1541 (Fed. Cir. 2007) (upholding examining attorney's requirement for amendment of the term "chronographs" in the identification of goods, 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 DURANGO for chewing tobacco is primarily geographically deceptively misdescriptive, even though applicant owned incontestable registration of same mark for cigars); *In re Am. Furniture Warehouse CO*, 126 USPQ2d 1400, 1407 (TTAB 2018) ("[C]onsistency in examination is not itself a substantive rule of trademark law, and a desire for consistency with the decisions of prior examining attorneys must yield to proper determinations under the Trademark Act and rules."); *In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1793 n.10 (TTAB 2017) ("The issuance of Applicant's first registration does not require the approval of a second registration if, on the facts of the case, it would be improper to do so under the governing legal standard."); *In re Rodale Inc.*, 80 USPQ2d 1696 (TTAB 2006) (NUTRITION BULLETIN 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 of BEST! did not preclude examining attorney from requiring disclaimer of "Best" in applications seeking registration of BEST! SUPPORTPLUS and BEST! SUPPORTPLUS PREMIER for the same and 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 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) (upholding refusal of registration on the ground that WHEN IT'S TIME TO ACT did not identify advertising services; Board not bound to allow registration simply because applicant owned registrations for identical 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 §§1605–1605.06 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 Am. 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, and the identical part of the applied-for mark would not be considered generic. 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." *Id.* at 880.

For determining likelihood of confusion, "the fact that opposer's 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 Invs., Inc.*, 94 USPQ2d 1031, 1036 (TTAB 2010). Moreover, although "an incontestable registration may not be challenged as invalid for mere descriptiveness," incontestability does not preclude a finding that, in terms of conceptual strength, the mark is descriptive for purposes of determining the inherent strength of a mark as a factor relevant to likelihood of confusion. *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1476-77 (TTAB 2014); *see also In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1517-18 (TTAB 2016)(noting that registrant's mark was "presumptively distinctive" under Trademark Act §§7(b) and 33(a), but finding that the evidence showed that the mark was "nevertheless weak as a source indicator" for purposes of determining likelihood of confusion).

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 N.Y. Inc.*, 259 F.3d 1346, 1353, 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, 227 USPQ 1, 6–7 (Fed. Cir. 1985) (incontestable status of registration for one speaker design did not establish nonfunctionality 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 examining attorney from requiring 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 disclaimer of "BEST" in applications seeking registration of BEST! SUPPORTPLUS and BEST! SUPPORTPLUS PREMIER for the same and additional services); *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564 (TTAB 1988) (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 BANK OF AMERICA under §§2(e)(1) and 2(e)(2), despite applicant's ownership of incontestable registrations of same mark for related services); *see alsoIn re Cordua Rests., Inc.*, 823 F.3d 594, 600, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016)(finding that the Board did not err in declining to consider the alleged incontestability of a prior registered standard-character word mark in evaluating the genericness of the stylized form thereof in connection with the same 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, 1335, 81 USPQ2d 1748, 1752 (Fed. Cir. 2007) (quoting *Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 326 (1979)).

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." *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 1372, 107 USPQ2d 1167, 1171 (Fed. Cir. 2013) (quoting *Jet, Inc. v. Sewage Aeration Sys.*, 223 F.3d 1360, 1362, 55 USPQ2d 1854, 1856 (Fed. Cir. 2000)); *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); *see Flame & Wax, Inc. v. Laguna Candles, LLC*, 2022 USPQ2d 714, at *32 (TTAB 2022); *Zachry Infrastructure, LLC v. Am. Infrastructure, Inc.*, 101 USPQ2d 1249, 1253 (TTAB 2011).

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 in the first action, or (2) the claim or defense represents what is essentially a collateral attack on the first judgment." *Freki Corp. N.V. v. Pinnacle Ent., Inc.*, 126 USPQ2d 1697, 1701 (TTAB 2018) (citing *Nasalok Coating Corp. v. Nylok Corp.*, 522 F.3d 1320, 1324, 86 USPQ2d 1369, 1372 (Fed. Cir. 2008) (finding that cancellation petitioner is 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, and noting that the cancellation petition amounted to a collateral 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 Am.*, 209 USPQ 627 (TTAB 1981); *In re Bordo Prods. 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. Res judicata does not apply unless the subsequent claim is based on that same set of transactional facts as the prior claim. *Levi Strauss & Co.*, 719 F.3d at 1372, 107 USPQ2d at 1171; *see alsoChutter, Inc. v. Great Concepts, LLC*, 119 USPQ2d 1865, 1870 (TTAB 2016).

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 between the same parties or their privies. Collateral estoppel applies where: "(1) a prior action presents an identical issue; (2) the prior action actually litigated and adjudged that issue; (3) the judgment in that prior action necessarily required determination of the identical issue; and (4) the prior action featured full representation of the estopped party." *Stephen Slesinger Inc. v. Disney Enters. Inc.* , 702 F3d 640, 644, 105 USPQ2d 1472, 1474 (Fed. Cir. 2012); *see also Levi Strauss & Co.*, 719 F.3d at 1371, 107 USPQ2d at 1171; *Mayer/Berkshire*, 424 F.3d at 1232, 76 USPQ2d at 1313; *Jet*, 223 F.3d at 1366, 55 USPQ2d at 1859; *NH Beach Pizza LLC v. Cristy's Pizza Inc.*, 119 USPQ2d 1861, 1864 (TTAB 2016); *In re Anderson*, 101 USPQ2d 1912, 1916 (TTAB 2012). In *Lukens Inc. v. Vesper Corp.*, 1 USPQ2d 1299, 1301 (TTAB 1986) , *aff'd unpub'd op.*, 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 Indus., 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." *See alsoIn re Cordua Rests., Inc.*, 823 F.3d 594, 601, 118 USPQ2d 1632, 1635 n.2 (Fed. Cir. 2016)(rejecting appellant's argument that an ex parte determination of registrability in a previous application was binding in a subsequent application as a matter of issue preclusion); *In re FCA US LLC*, 126 USPQ2d 1214, 1218-19 (TTAB 2018) (refusing to apply issue preclusion

based on district court litigation because USPTO was not a party to the litigation and the issues involved were different). In *In re Anderson*, 101 USPQ2d at 1917, the Board found the doctrine of collateral estoppel to be applicable and to preclude registration in an ex parte proceeding based on a final judgment involving an identical likelihood-of-confusion issue entered in a prior inter partes proceeding involving the applicant and cited registrant, and in *Zachry Infrastructure, LLC v. Am. Infrastructure, Inc.*, 101 USPQ2d 1249 (TTAB 2011), the Board determined that the district court's finding that the term AMERICAN INFRASTRUCTURE had not acquired distinctiveness was binding on the parties and the Board under the doctrine of collateral estoppel, but declined to enter judgment on the genericness claims since the district court had not addressed the issue of genericness. In *Nextel Commc'ns, Inc. v. Motorola, Inc.*, 91 USPQ2d 1393, 1399 (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, 1950 (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, 1410 (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. *SeeIn re Honeywell Inc.*, 8 USPQ2d 1600, 1602–03 (TTAB 1988) (finding that 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); *Johanna Farms*, 8 USPQ2d at 1411-12 (stating that 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 Indus.*, 5 USPQ2d at 1584 (finding that application for registration of HONEY WHEAT for bread under §2(f) is 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 Prods.*, 188 USPQ at 514 (holding that application for registration of BORDO for pitted dates is 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 due to 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 failure of the owner of the cited registration to take steps to enjoin applicant from using the mark).

In *Bose*, 476 F.3d at 1334, 81 USPQ2d at 1751, 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. Mktg. 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* did 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 is 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." *Bose*, 476 F.3d at 1335-37, 81 USQP2d at 1752-53.

Slight differences in a mark or in an identification of goods or 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. Am. Express Co.*, 14 USPQ2d 1551, 1553 (TTAB 1990) (finding that applicant is 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).

"[P]ointing to additional facts or even making a more persuasive argument based on those facts does not avoid preclusion from an earlier decision." *In re SolarWindow Techs., Inc.*, 2021 USPQ2d 257, at *8 (TTAB 2021) (citing *SynQor, Inc. v. Vicor Corp.*, 988 F. 3d 1341, 1355, 2021 USPQ2d 208, at *12 (Fed. Cir. 2021)). Rather, the losing party must demonstrate "a material change in the relevant conditions or circumstances." *In re SolarWindow Techs., Inc.*, 2021 USPQ2d 257, at *8 (finding no material change where the same applicant, mark, and goods were involved in both the prior and present proceedings and the Board's prior decision affirming the examining attorney's descriptiveness refusal issued less than two years before applicant filed the present application; "[a]pplicant's arguments . . . are, at best, alternative arguments why it believes its mark is not merely descriptive").

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.