Overview of common failure-to-function refusals

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Discussion topics

• Failure-to-function overview
• Failure-to-function refusals
• USPTO resources
Discussion topic

Failure-to-function overview
Failure-to-function overview

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

  DRINK MORE BEER

*In re Maugus Mfg., Inc.*, 2021 USPQ2d 1100 (quoting *In re DePorter*, 129 USPQ2d 1298 (TTAB 2019))
Failure-to-function overview

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

Failure-to-function overview

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

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

• Concept
  – Cannot register **decorative features** that don’t identify the source of the goods
    • Words
    • Slogans
    • Designs
    • Trade dress
Ornamentation

• Factors determining registrability
  – Commercial impression
  – Practices of the trade
  – Secondary source
  – Evidence of distinctiveness
Ornamentation refusal example

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

*In re Right-On Co., Ltd*, 87 USPQ2d 1152 (TTAB 2008)
Ornamentation refusal example

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

*In re Lululemon Athletica Can. Inc., 105 USPQ2d 1684 (TTAB 2013)*
Ornamentation refusal example

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

In re Peace Love World Live, LLC, 127 USPQ2d 1400, 1403 (TTAB 2018)
Ornamentation response options

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

• Pro tips

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

www.uspto.gov/trademarks/laws/ornamental-refusal-and-how-overcome-refusal
Knowledge check

• Is this acceptable trademark use?

YOU ARE SPECIAL TODAY

Drawing

Specimen

uspto
Discussion topic

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

• Concept
  – Cannot register the title of a single creative work
  – Cannot register a portion of the title of a single creative work
Title of a single work

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

• Single creative work
  – Book
  – Serialized writing
  – Sound recording
  – Downloadable song
  – Downloadable ringtone
  – Film
  – Single radio program
  – Single television program
  – Scripted theatrical performance
Title of a single work

• Not considered a single creative work
  – Magazines
  – Newsletters
  – Comic books
  – Guide books
  – Printed classroom materials
  – Computer software
  – Computer games
  – Coloring books
  – Activity books
  – Live musical performances
Single work refusal example

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

Mattel Inc. v. Brainy Baby Co., 101 USPQ2d 1140 (TTAB 2011)
Single work refusal example

• Title of music instruction book
  – No evidence of series of INSTANT KEYBOARD books
  – Use of mark on specimen
    • Appears on cover of book
    • Appears on spine of book
    • Appears on first page of book
Title of a single work

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

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

_In re Scholastic Inc., 23 USPQ2d 1774, 1777 (TTAB 1992)_)
Single work response options

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

*In re Arnold*, 105 USPQ2d 1953 (TTAB 2013)
Single work takeaways

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

Knowledge check

• Is this acceptable trademark use?
Discussion topic

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

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

• Factors determining registrability
  – Evidence of a series of works; and
  – Evidence name identifies the source of the series
    • Promotion and recognition of the name; or
    • Control over the nature and quality of the goods
Name of artist refusal example

• Name of artist
  – Evidence of a series of musical recordings
  – No evidence BLATANCENCY
• Controls the nature and quality of the goods
• Promoted and recognized as the source of the goods

In re Arnold, 105 USPQ2d 1953 (TTAB 2013)
Name of author refusal example

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

*In re Chicago Reader Inc.*, 12 USPQ2d 1079 (TTAB 1989)
Author/artist response options

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

In re Polar Music Int’l AB, 714 F.2d 1567 (Fed. Cir. 1983)
Name of author/artist takeaways

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

TMEP §1202.09
Knowledge check

• Is this acceptable trademark use?

Drawing

Specimen

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

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

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

• Not goods in trade
  – Letterhead
  – Invoices
  – Reports
  – Boxes
  – Business forms
  – Checkbooks
  – Brochures
  – Pamphlets
  – Mockups
  – Holiday greeting cards
Services for others

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

• Not services for others
  – Concept or idea
  – System
  – Process
  – Method
  – Intranet website
  – Soliciting investors
  – Advertising and promoting own goods
  – Performing clinical trials for own goods
  – Publishing own periodical
Goods in trade refusal example

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

_In re MGA Entertainment, Inc., 84 USPQ2d 1743 (TTAB 2007)_]
Services for others refusal example

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

In re Florists’ Transworld Delivery, Inc., 119 USPQ2d 1056 (TTAB 2016)
Goods/services response options

• Ways to overcome the refusal
  – Delete the goods or services.
  – Submit evidence:
    • Goods have utility apart from promotional use
    • Services are real, performed for others, and sufficiently distinct.
  – Amend filing basis to §1(b) intent-to-use basis.

In re Snap-On Tools Corp., 159 USPQ 254 (TTAB 1968)
Goods/services takeaways

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

• Is this acceptable trademark use?

Drawing

Specimen

RX GUARDIAN
Discussion topic

USPTO resources
USPTO resources

• Website
  – www.uspto.gov

• Trademark videos
  – www.uspto.gov/TMvideos

• Trademark Manual of Examining Procedure
  – www.uspto.gov/TMEP
Responding to office actions

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

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

• Presentation refusals
  – Ornamentation: TMEP §1202.03
  – Title of single creative work: TMEP §1202.08
  – Name of author or artist: TMEP §1202.09
  – Goods in trade: TMEP §1202.06
  – Services for others: TMEP §1301.01
USPTO resources

• Additional references
  – Names of columns and sections of publications: TMEP §1202.07
  – Names and designs of characters in creative works: TMEP §1202.10
  – Names of characters or personal names as service marks: TMEP §1301.02(b)
Questions?