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Hearing:  
June 3, 1997

Paper No. 25  
JQ

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Volvo Cars of North America, Inc.

Serial No. 74/212,578

Paul A. Bondor, William T. Boland, Jr. and Allen J. Baden of  
Kenyon & Kenyon for applicant.

Lori S. Schulman, Trademark Examining Attorney, Law Office  
103 (Kathryn D. Erskine, Managing Attorney).

Before Cissel, Quinn and Walters, Administrative Trademark  
Judges.

Opinion by Quinn, Administrative Trademark Judge.

An application has been filed by Volvo Cars of North  
America, Inc. to register the designation DRIVE SAFELY for  
"automobiles and structural parts therefor."<sup>1</sup> Applicant has  
claimed the benefits of acquired distinctiveness under  
Section 2(f) of the Act.

The Trademark Examining Attorney has refused  
registration under Sections 1, 2 and 45 of the Trademark  
Act, 15 USC §§1051, 1052 and 1127, on the ground that the

<sup>1</sup> Application Serial No. 74/212,578, filed October 10, 1991,  
claiming dates of first use of January 1986

designation sought to be registered does not function as a trademark, but rather acts as a mere cautionary phrase which admonishes drivers to operate their automobiles in a safe manner.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney filed briefs, and an oral hearing was held before the Board.

Applicant contends, in urging that the refusal be reversed, that Volvo and its automobile products are synonymous with safety. Therefore, according to applicant, DRIVE SAFELY is more than a mere safety admonition, acting, rather, as a source identifier for applicant. The essence of applicant's arguments is as follows:

Volvo's established reputation as a producer of safe--indeed, the safest--automobiles renders DRIVE SAFELY a double entendre which emphasizes both that Volvo's automobiles enable one to *drive safely* because the car's safety features protect its occupants, and that Volvo is concerned about the safety of its current and prospective customers (who constitute the driving public generally). That double entendre connects Volvo with the mark, and through Volvo's extensive promotion and use, the mark has gained secondary meaning entitling it to registration. Moreover, the context and manner of Volvo's uses of DRIVE SAFELY demonstrate that the mark is not used in its ordinary, cautionary meaning, and the mark is not so understood by the public. (appeal brief, p. 4) [emphasis in original]

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. . .the double meaning stems from (1)the ordinary meaning of the phrase, and (2)the implicit continuation, "in an automobile manufactured by Volvo." That implicit continuation derives from the public's association of Volvo with safe automobiles, and the extensive use and promotion that Volvo has made of the DRIVE SAFELY mark. (reply brief, pp. 4-5)

Applicant also relies upon the way the designation is encountered in the marketplace, pointing out that DRIVE SAFELY is separated from the text in its print advertisements, and that all of applicant's print advertisements include the legend "Drive Safely is a trademark of Volvo Cars of North America, Inc." Applicant further argues that issuance to it of a registration of DRIVE SAFELY will not prevent competitors and others from making descriptive use of the phrase "drive safely." Applicant contends that competitors would remain free to use "drive safely" in a descriptive manner, such as, in applicant's example, "the four wheel drive feature helps you drive safely in hazardous conditions " (brief, p. 15) Applicant lastly contends that any doubts about the issue must be resolved in its favor, thereby allowing any person who believes that he would be hindered by the registration an opportunity to oppose registration of the mark and to

present evidence, not present in this ex parte appeal, to that effect."

In connection with its arguments, applicant submitted the declaration (with related exhibits) of David Wertheim, applicant's assistant general counsel, who claims that the designation sought to be registered has become distinctive.<sup>3</sup> Mr. Wertheim attests to applicant's substantially exclusive and continuous, extensive use of DRIVE SAFELY since at least as early as January 1, 1986. Mr. Wertheim also indicated

<sup>3</sup> In its brief, applicant argues, for the first time, that the Office has registered or published many common, everyday phrases. Applicant goes on to list several registrations and applications, contending that the refusal in this application is at odds with the Office's practice as shown in these other files. The Examining Attorney, in her brief, objected to this evidence because it was not properly made of record.

The objection is sustained. Trademark Rule 2.142(d) provides that the record in an application should be complete prior to the filing of the appeal, and that the Board will ordinarily not consider additional evidence filed with the Board after the appeal is filed. Moreover, the mere listing of third-party registrations and/or applications is insufficient to properly make them of record. Rather, copies of the official records themselves, or the electronic equivalent thereof, that is, printouts of the registrations taken from the electronic records of the Patent and Trademark Office's own data base, must be submitted. In re Smith and Mehaffey, 31 USPQ2d 1531, 1532 at n. 3 (TTAB 1994). Thus, the listing in applicant's brief has not been considered in reaching our decision. We hasten to add that, even if considered, this evidence would have had scant probative value on the specific issue in this case involving the registrability of applicant's designation. Further, we are not privy to the records of the listed registrations and applications, the propriety of the issuance of those registrations is not before us, and neither the Board nor the Examining Attorney is bound by the determinations made by other Examining Attorneys who handled those cases.

Earlier in the prosecution of this application applicant's senior vice president filed a declaration to the effect that Mr. Wertheim has actual authority to act on behalf of applicant.

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that applicant has extensively promoted its DRIVE SAFELY designation through print, audio and audiovisual advertisements and commercials which have been featured in and on national, regional and/or local newspapers, magazines, radio programs and television programs. The designation also has been used on point-of-purchase displays in applicant's dealership showrooms throughout the United States. Mr. Wertheim asserts that applicant has spent, since 1991, approximately \$150 million in fees for advertising space and airtime to publish and broadcast its advertisements and commercials featuring its DRIVE SAFELY designation, and has spent an additional \$34 million to produce these advertisements and commercials. Finally, Mr. Wertheim states that no one other than applicant is using DRIVE SAFELY in commerce. The accompanying exhibits comprise advertising slicks, television commercial storyboards, radio commercial copy and a variety of other advertising and promotional materials. Applicant also introduced excerpts retrieved from the NEXIS database to support its claim that Volvo is synonymous with safety.

The Examining Attorney contends that the designation sought to be registered, as actually used in commerce, does not function as a trademark and, therefore, is incapable of being registered as a trademark. The phrase "drive safely," according to the Examining Attorney, is commonly used to

caution drivers to operate motor vehicles in a safe manner. The Examining Attorney concedes that applicant enjoys a reputation for safety, but asserts that consumers in the marketplace would view the phrase DRIVE SAFELY as nothing more than a public service message from an automobile manufacturer who is concerned about safety. The Examining Attorney disagrees that applicant's designation has a double entendre because, in her view, there is no ambiguity of meaning of DRIVE SAFELY that lends itself to more than one interpretation. The Examining Attorney goes on to argue that issuance of a registration to applicant would give applicant exclusive property rights in a common phrase; that is, applicant could enforce its rights against others in the industry who wish to use the common admonition "drive safely," thus depriving competitors of conveying the automobile safety concerns that are prevalent in today's world.

In connection with the refusal, the Examining Attorney submitted the following materials printed publication excerpts retrieved from the NEXIS and DATATIMES databases, dictionary definitions of the terms "drive" and "double entendre<sup>4</sup>;" a newsletter distributed by the New Jersey

<sup>4</sup> The dictionary evidence accompanied the Examining Attorney's brief. Although this submission with the brief is untimely under Trademark Rule 2.142(d), we are able to take judicial notice of the definitions University of Notre Dame du Lac v

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Turnpike; and photographs taken by the Examining Attorney of a highway store sign and of various placards that appeared on the sides of tractor truck trailers, all showing uses of the phrases "Drive Safely" or "Please Drive Safely."

The Examining Attorney accepted as specimens product brochures for applicant's 1992 model year automobiles.<sup>5</sup> At the bottom of the back cover of the brochure, the designation sought to be registered appears as follows:



The back cover also includes the notice that "Drive Safely is a trademark [of applicant]." As noted above, this notice appears on all printed promotional materials whenever applicant uses the designation DRIVE SAFELY.

The record also includes a variety of promotional materials, a representative sample of which is reproduced below (pertinent portions of the advertisements are shown).

**DRIVE SAFELY.**

**VOLVO**

J. C. Gourmet Food Imports Co , 213 USPQ 594 (TTAB 1982), *aff'd*, 701 F.2d 1372, 217 USPQ 505 (Fed Cir 1983)

The affixation clause was amended to indicate that the mark is used on point-of-sale displays associated with the goods

# HIRE A BODYGUARD. \$000 A MONTH.

Insurance  
Institute for

**Drive Safely.**



Highway Safety found that it had the lowest fatality rate in its class \*

But you don't have to buy a Volvo 240 to receive this kind of protection. You can lease one at your Volvo dealer.

Drive safely

**VOLVO**

**VOLVO**

(Dealer Name)

The Examining Attorney introduced numerous excerpts from printed publications wherein "drive safely" was used in its everyday, common meaning. A representative sample of these uses is reproduced below.

Volume Services employees will wear "Age, I.D." and "Drive Safely" tags.  
*Entertainment and Leisure*, February 24, 1992

And those big, round headlamps. They look like car eyes in a happy-car cartoon--you know, the kind where the car is saying something like, "Have a good day!" or "Drive safely!" or "Please change my oil!"  
*The Washington Post*, July 19, 1991

This caveat has a vague, obvious sound to it, like highway signs that urge, Drive Safely.

*Factory Equipment, Machine Tools,*  
February 1, 1989

Mayhugh stressed what the others also called the most significant ways to keep auto insurance rates down--drive safely, soberly and defensively.

*Business First-Louisville,* May 30, 1988

As Pritchard got over, the speeding truck roared past, revealing a "Please Drive Safely" sign on the rear.

*The Los Angeles Times,* March 31, 1986

On the counter of Thrifty's New Orleans office is a stack of printed cards with this cheery message. "Please Drive Safely."

*Wall Street Journal,* April 30, 1985

. . . is trying to get the Maryland and Virginia transportation departments to use some of their signs to provide more specific proselytizing than "PLEASE DRIVE SAFELY."

*The Washington Post,* May 20, 1993

Drive safely. Wear your seat belt.  
Don't drink and drive

*The Plain Dealer,* January 5, 1993

But, as always, the rubric still applies. Buckle up and drive safely.

*Los Angeles Times,* January 2, 1993

Happy Holidays! Drive Safely, buckle up and don't drink and drive, please!

*Star Tribune,* December 20, 1992

Drive Safely--Save a Life

*Parade,* November 1, 1992

It was as if Mom had just given me a little pat on the shoulder and told me to please drive safely.

*The San Diego Union-Tribune,* February 26, 1994

Why Die? Think--Drive Safely

*Newsday,* February 6, 1994

Antihistamines help some people, but they can make some too drowsy to drive safely or work efficiently.  
*Austin-American-Statesman*, September 26, 1992

As people get older, things happen that could affect their ability to drive safely.  
*Orlando Sentinel*, September 24, 1992

Older drivers might wonder what the "right" car is for them. And their children, friends and anyone else who wants to see them drive safely and comfortably may wonder the same thing.  
*Chicago Sun-Times*, August 19, 1992

His building sports a colorful painted facade featuring a bearded smiling portrait of himself telling people to drive safely.  
*Philadelphia Business Journal*, May 4, 1992

Elderly pedestrians reminded motorists to drive safely near Moscone Center yesterday.  
*The San Francisco Chronicle*, July 29, 1992

The Driver Safety Program helps to identify motorists who may no longer be able to drive safely.  
*The Orange County Register*, June 13, 1992

The smoke clears, a winner is declared, any loose parts are swept from the track and Weaver cheerfully advises the fans to drive safely on the way home.  
*The Los Angeles Times*, July 2, 1988

Gartner warned drivers from cargo companies, airlines and government agencies to "please slow down and drive safely" .  
*Los Angeles Times*, May 23, 1993

"We are promoting safe driving and the ribbons are a reminder to drive safely," she said.

*The Plain Dealer*, December 31, 1992

Wear your seat belt and drive safely.

*Newsday*, November 24, 1992

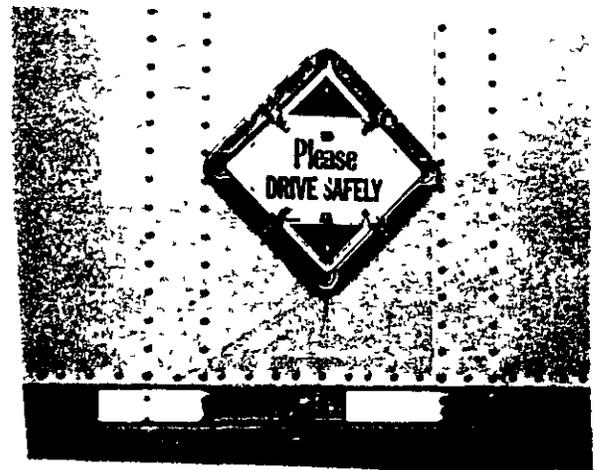
Loudon said he has deployed officers to remind motorists to drive safely. . .

*The Hartford Courant*, March 13, 1994

. . .her son began to enjoy his time there and often told his parents stories about the ladies there who warned him to drive safely.

*Chicago Tribune*, March 13, 1994

The Examining Attorney also submitted a photograph that she took which shows a store sign bearing the phrase "DRIVE SAFELY". The Examining Attorney took additional photographs which show signs bearing the phrase "DRIVE SAFELY" or "PLEASE DRIVE SAFELY" on the sides of tractor truck trailers. Two of these latter photographs are reproduced below



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Also of record is a publication of the New Jersey Turnpike, *The Trailblazer*. The headline banner of the publication uses the phrase "Buckle Up Drive Safely."

Section 45 of the Trademark Act, 15 USC §1127, defines the term "trademark" in relevant part as including "any word, name, symbol, or device, or any combination thereof-- (1) used by a person. . .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." In this regard, the Court of Customs and Patent Appeals, a predecessor to the Court of Appeals for the Federal Circuit, stated the following: "The Trademark Act is not an act to register mere words, but rather to register trademarks. Before there can be registration, there must be a trademark, and unless words have been so used they cannot qualify." *In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1976), citing *In re Standard Oil Co.*, 275 F.2d 945, 125 USPQ 227 (CCPA 1960).

We note that not every word or combination of words which appears on an entity's goods functions as a trademark. *In re Morganroth*, 208 USPQ 284 (TTAB 1980). Thus, the mere fact that an applicant's phrase appears on the specimens, even separate and apart from other indicia which appear on them, does not make it a trademark. To be a mark, the

phrase must be used in a manner calculated to project to purchasers or potential purchasers a single source or origin for the goods. Mere intent that a term or phrase function as a trademark is not enough in and of itself. Id. at 287 ["Wishing does not make a trademark or service mark be."] A critical element in determining whether a term or phrase is a trademark is the impression the term or phrase makes on the relevant public. Accordingly, in this case, the critical inquiry becomes: Would the phrase DRIVE SAFELY be perceived as a source indicator or merely an informational phrase or slogan? In re Remington Products Inc., 3 USPQ2d 1714, 1715 (TTAB 1987). See generally: J. T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, §7:23 (4<sup>th</sup> ed 1997). In order to assess the commercial impact created by the designation involved here, we look to the specimens and other materials which show how the mark is actually used in the marketplace In re Bose Corp., supra.

We begin our analysis with the acknowledgment, shared by the Examining Attorney, that applicant has a reputation for designing and manufacturing safe automobiles. Applicant has heavily promoted this reputation, and applicant's advertisements are replete with references to the safety features of its automobiles. One of applicant's advertisements highlights applicant's two founders. The advertisement sets forth their quote "An underlying

principle in everything we do is, and always will be, safety.", and describes Messrs. Larson and Gabrielson as follows: "They became the conscience of an entire industry." Applicant even has a "Volvo Saved My Life Club" for those owners who survive serious automobile accidents, and who believe that their lives were saved due to the safety features of applicant's automobiles.

Notwithstanding applicant's reputation for safety, we find that the primary significance of the phrase DRIVE SAFELY, as used by applicant, and as likely to be perceived by purchasers and prospective purchasers, is merely that of an everyday, commonplace safety admonition. In re Wakenfern Food Corp., 222 USPQ 76 (TTAB 1984) [WHY PAY MORE' for supermarket services is not registrable because the slogan does not function as a service mark]. The evidence introduced by the Examining Attorney establishes that the phrase "drive safely" commonly is used to express a cautionary concern about the operation of a motor vehicle. Thus, rather than being regarded as an indicator of source, the phrase DRIVE SAFELY would be regarded simply as a familiar safety admonition, particularly when used in connection with automobiles.

It is common knowledge that automobile safety is at the forefront of the American consciousness. This is borne out by the evidence of record, including applicant's own

promotional efforts. Whether the issue is drunk driving, road rage, the proper installation of child restraint seats, or the like, American drivers are bombarded with information and reminders about automobile safety. The ordinary meaning of the often-repeated phrase DRIVE SAFELY is so ingrained in the minds of our society that it would not be perceived as a trademark. Applicant contends, as noted above, that its reputation for safety gives the phrase DRIVE SAFELY, when used by applicant, a double entendre, indicating both that applicant's automobiles enable one to "drive safely" due to the automobiles' safety features, and that applicant is concerned about the safety of its customers. To our way of thinking, however, the second meaning ascribed by applicant to the phrase is not really any different from the first meaning given by applicant. That is to say, the common ordinary meaning of "drive safely" broadly encompasses both of the connotations suggested by applicant. We believe that instead of a "double entendre" which may be indicative of source, there is no ambiguity of meaning arising from the admonition DRIVE SAFELY that lends itself to more than one interpretation.' We hasten to add that to the extent that

Applicant proffers yet a third meaning for its alleged mark, pointing to another definition of the term "drive": "to urge relentlessly to continuous exertion " Applicant contends that this meaning, in the context of DRIVE SAFELY, promotes an additional theme of applicant's advertising, namely, "achieving exceptional performance without sacrificing practicality " (brief, p 7) Suffice it to say that applicant is stretching in

applicant's designation DRIVE SAFELY engenders some minor double entendre, this should not result in registration inasmuch as the primary significance of the phrase remains that of a commonplace safety admonition.

In our minds, use of the phrase "Drive Safely" is as familiar as "Have a nice day" or "Don't worry." It is the type of phrase that is uttered on a daily basis, almost automatically with no thought, to others as they drive off in an automobile. See: Reed v. Amoco Oil Co., 611 F Supp 9, 225 USPQ 876 (M.D. Tenn. 1984) [the more commonly a phrase is used in everyday parlance, the less the likelihood that it will be recognized by purchasers as a trademark]. Based on the record before us, our view is that the phrase DRIVE SAFELY should remain in the public domain. Contrary to the gist of some of applicant's arguments, to grant exclusive rights to applicant in this ordinary and commonly used safety admonition would interfere with the right 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 this connection, it has been noted that "as a matter of competitive policy, it should be close to impossible for one competitor to achieve

making this argument It is highly unlikely that consumers would ascribe this meaning to "drive" when the term is combined with the term "safely," to form DRIVE SAFELY for use in connection with automobiles Nor has applicant provided any evidence indicating that consumers would so understand the phrase

exclusive rights" in common phrases or slogans. *McCarthy on Trademarks and Unfair Competition*, supra, §7:23 at p. 7-34.

Furthermore, unlike some of the examples and cases relied upon by applicant, we find that the phrase DRIVE SAFELY is instead analogous to the slogans in the cases of *In re Manco Inc.*, 24 USPQ2d 1938 (TTAB 1992) [finding slogan THINK GREEN for mailing and shipping items and weatherstripping does not function as a trademark], *In re Remington Products Inc.*, supra, [holding slogan PROUDLY MADE IN USA for electric shavers and parts thereof would not be recognized as source indicator] and *In re Tilcon Warren, Inc.*, 221 USPQ 87 (TTAB 1984) [finding slogan WATCH THAT CHILD for construction materials does not function as a trademark]. These slogans respectively expressed the ecological concerns of the expanding environmental movement, a preference for American-made products and a general concern for child safety. Thus, the slogans would not be regarded, due to their general informational nature, as signifying the source or origin of the goods in connection with which they were used. In a similar vein, because applicant's phrase DRIVE SAFELY conveys the familiar safety admonition that expresses the concern of our society about the safe operation of motor vehicles, we believe that the commonplace meaning imparted by the phrase would be the primary meaning impressed upon the purchasing public

Consequently, purchasers and prospective purchasers would not recognize or regard the familiar phrase as denoting source. See: American Dairy Queen Corp. v. RTO, Inc., 16 USPQ2d 1077 (N.D. Ill. 1990) [the slogan WE TREAT YOU RIGHT viewed as too common and undistinctive to justify exclusive rights therein for fast food outlets].

In reaching our decision, we are aware, of course, of applicant's extensive promotional efforts over the years. Although the advertising expenditures are indeed impressive, they do not prove recognition by the public of the subject phrase as a trademark. In re Remington Products Inc, supra at 1715; In re Tilcon Warren, Inc., supra at 88; and In re Wakefern Food Corp., supra at 79. There is no evidence bearing on the purchasing public's reaction to applicant's promotional efforts. The simple and unassailable fact remains--the record is devoid of any direct evidence whatsoever to indicate that the purchasing public recognizes the phrase DRIVE SAFELY as a source indicator of applicant's automobiles and parts therefor. As used on the specimens and the other examples of actual use of record, we are convinced that DRIVE SAFELY would not be perceived as a trademark. In any event, to the extent that there is an association in purchasers' minds of DRIVE SAFELY with applicant as a result of applicant's extensive promotion,

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this is an association that is not entitled to legal recognition resulting in a trademark registration.

Finally, use of the notice indicating that DRIVE SAFELY is a trademark of applicant does not transform this unregistrable phrase into a trademark indicating source or origin. In re Manco, supra at 1942, n. 11; In re B. C. Switzer & Co., 211 USPQ 644, 645 (TTAB 1981); In re General Foods Corp., 177 USPQ 403, 404 at n. 1 (TTAB 1973); and In re Nosler Bullets, Inc., 169 USPQ 62, 64 (TTAB 1971).

Accordingly, we are of the opinion that the phrase DRIVE SAFELY, as used by applicant, does not function as a trademark for applicant's goods.

Decision: The refusal to register is affirmed.



R. F. Cissel



T. J. Quinn



C. E. Walters  
Administrative Trademark  
Judges, Trademark Trial  
and Appeal Board

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