

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB MARCH 17, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Winner International Royalty Corporation

Serial No. 75/082,025

Robert V. Vickers of Vickers, Daniels & Young
for Winner International Royalty Corporation.

Cindy B. Greenbaum, Trademark Examining Attorney, Law
Office 104 (Sidney Moskowitz, Managing Attorney).

Before Simms, Hairston and Wendel, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Winner International Royalty Corporation has filed an
application to register the mark AMERICA'S FAVORITE for an
"anti-theft steering wheel lock for motor vehicles made
primarily of metal" on the Principal Register under the
provisions of Section 2(f).¹ Applicant claims that the mark

¹ Ser. No. 75/082,025, filed April 1, 1996, claiming first use
dates of Jan. 15, 1991.

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has become distinctive, as applied to its goods, by reason of applicant's substantially exclusive and continuous use of the mark in commerce for the five years next preceding the filing date of its application.

Registration has been finally refused on the grounds that the mark is merely descriptive under Section 2(e)(1) of the Trademark Act and that applicant's evidence is insufficient to show acquired distinctiveness under Section 2(f). Applicant and the Examining Attorney have filed briefs, but no oral hearing was requested.

Applicant states that it is the owner of Registration No. 1,791,096 on the Supplemental Register for the same mark for the same goods² and is now seeking registration on the Principal Register under the provisions of Section 2(f). Thus, we find no reason for any further consideration of whether or not the mark is merely descriptive under Section 2(e)(1). Applicant has admitted as much, by seeking registration under Section 2(f) on the basis of acquired distinctiveness. See *In re Leatherman Tool Group Inc.*, 32 USPQ2d 1443 (TTAB 1994).

Accordingly, we turn to the question of whether applicant's claim based solely on five years of

substantially exclusive and continuous use is sufficient to establish acquired distinctiveness for the mark AMERICA'S FAVORITE. The Examining Attorney maintains that, in view of the highly self-laudatory nature of the mark, applicant's statement of five years use, without more, is insufficient to meet applicant's burden of proof with respect to distinctiveness. Applicant contends that, pursuant to Section 2(f), five years use is prima facie evidence of acquired distinctiveness and should be adequate, considering that its mark is not close to being generic, but rather falls near the dividing line between suggestive and merely descriptive marks. Applicant points to several third-party registrations on the Principal Register of marks which include as a portion thereof the phrase "America's Favorite", some of which are registered under Section 2(f) and some not, as support for its argument that the phrase falls near the center of the descriptiveness/distinctiveness spectrum and is clearly capable of acquired distinctiveness.³

² Reg. No. 1,791,096 issued Aug. 31, 1993 and no Section 8 affidavit has been filed. Thus, the registration, although not yet officially cancelled, appears to no longer be valid.

³ The Examining Attorney initially objected to applicant's improper attempt to make these third-party registrations of record by the submission of printouts from the Trademarkscan database in its request for reconsideration. Applicant subsequently submitted soft copies of the registrations in its

With the exception of the statement that substantially exclusive and continuous use for a period of five years immediately preceding the filing of an application may be considered as prima facie evidence of distinctiveness, Section 2(f) is silent as to the weight of evidence required for a showing of acquired distinctiveness. It is well established, however, that the standard of proof under Section 2(f) is a preponderance of evidence, with the standard becoming more difficult to meet as the mark's descriptiveness increases. *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1573, 6 USPQ2d 1001 (Fed. Cir. 1988). See also *In re Boston Beer Co.*, 47 USPQ2d 1914 (TTAB 1998); *In re Recorded Books Inc.*, 42 USPQ2d 1276 (TTAB 1997).

In the present case, the mark AMERICA'S FAVORITE can only be construed as a purely laudatory expression which applicant uses in promoting its anti-theft device, or, in other words, applicant's boast of the popularity of its product. Unless applicant has met the requisite level of proof of acquired distinctiveness, applicant should not be able to preclude competitors from making similar claims for

petition to the Commissioner. Because the petition, which was denied, is part of the file history, and because the Examining Attorney referred to the registrations in her brief, we have treated the registrations as being of record for purposes of this appeal.

their products. See *In re Wileswood, Inc.*, 201 USPQ 400 (TTAB 1978)[AMERICA'S FAVORITE POPCORN found to be merely laudatory epithet describing claimed popularity of applicant's goods, unregistrable in the absence of compelling proof of acquired secondary meaning]. Thus, applicant must have established that the highly laudatory claim AMERICA'S FAVORITE has lost its merely descriptive significance and become distinctive as an indication of source of applicant's anti-theft device. See *In re Boston Beer Co.*, supra at 1921.

We find that applicant has failed to meet this burden of proof. In view of the highly laudatory nature of the phrase AMERICA'S FAVORITE, which would most reasonably be viewed by the purchasing public as no more than a claim of popularity for the product, a statement of five years substantially exclusive and continuous use is insufficient to prove acquired distinctiveness. There is no evidence of any promotion or use by applicant of this phrase in itself as an indication of source, much less of any recognition by purchasers that AMERICA'S FAVORITE functions in this manner.

While applicant has pointed to other marks containing the phrase "America's Favorite" which have been registered either under Section 2(f) or without resort to Section

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2(f), we find the existence of these registrations to be of little help in deciding the issue before us. We are without any knowledge as to the amount of evidence required for registration under Section 2(f) of marks such as AMERICA'S FAVORITE MUSTARD or AMERICA'S FAVORITE OIL CHANGE. We are similarly without the benefit of the prosecution history with respect to the marks registered without resort to Section 2(f).

Accordingly, we find that, on the record before us, applicant has failed to establish acquired distinctiveness for the merely descriptive mark AMERICA'S FAVORITE, as required for registration under the provisions of Section 2(f).

Decision: The refusal to register under Section 2(e)(1) is affirmed.

R. L. Simms

P. T. Hairston

H. R. Wendel
Trademark Administrative Judges,
Trademark Trial and Appeal Board

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