

UNITED STATES
PATENT AND TRADEMARK OFFICE



Attorney practitioners: failure to function refusals and the TTAB

Thomas L. Casagrande and Catherine Dugan O'Connor

Administrative Trademark Judges
Trademark Trial and Appeal Board (TTAB)

December 17, 2024



UNITED STATES
PATENT AND TRADEMARK OFFICE ®

Discussion topics

- Statutory and historical background of failure to function refusals
- Current practice and decisions regarding failure to function refusals
- Relationship to other refusals, e.g., descriptiveness and genericness refusals

Discussion topic

Background

Failure to function statutory basis

- Trademark Act § 45
 - A trademark must
 - Identify and distinguish the owner's goods and services
 - Indicate the source of the goods and services
 - If the subject matter primarily does something else, it fails to function as a trademark.
- Trademark Act §§ 1, 2 and 3 use this defined term.

Failure to function statutory basis (cont'd 2)

- *In re Standard Oil Co.*
 - “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.”



Types of failure to function refusals

- Trade name
- Informational matter
- Merely ornamental
- Color, sound, scent, flavor
- Title of single creative work
- Author/performer name
- Character in creative work

See generally, TMEP § 1202 and subsections; TMEP § 1301.02(a).



Failure to function refusals by other names

- Generic
- Merely descriptive
 - May overcome with proof of acquired distinctiveness.

Failure to function refusals by other names (cont'd 2)

- Failure to function: Informational matter
 - Traditionally, refusal focused on:
 - Merely informational slogans and terms
 - Common laudatory phrases or statements ordinarily used in business or the particular industry

Early decisions: informational matter

- *In re Medic Alert Co.*
 - MEDIC ALERT for “identification tags”
 - Refusal affirmed
 - Wording only serves to direct attention to the fact that the wearer has a medical disability
- *In re Standard Oil Co.*
 - GUARANTEED STARTING for “servicing motor vehicles for use in cold weather”
 - Refusal affirmed
 - Wording is a condensed announcement of a guarantee that the car will start

'70s and early '80s: informational matter

- *In re O.R. Mossberg & Sons, Inc.*
 - MORE GUN FOR THE MONEY for “firearms”
 - Refusal affirmed
 - Wording is an informational phrase that the products are sold for less money than competitors’ products
- *In re Niagara Frontier Services, Inc.*
 - WE MAKE IT, YOU BAKE IT! for “supermarket services”
 - Refusal affirmed
 - Wording simply provides advertising or promotional information

'70s and early '80s: informational matter (cont'd 2)

- *In re Tilcon Warren, Inc.*
 - WATCH THAT CHILD for “construction material, including crushed stone and concrete”
 - Refusal affirmed
 - Wording is a familiar safety slogan



Mid '80s-'90s: informational matter (and/or "so highly descriptive"?)

- *In re Wakefern Food Corp.*
 - WHY PAY MORE! for "supermarket services"
 - Refusal affirmed
 - Wording is a common informational merchandising slogan
- *In re Melville Corp.*
 - BRAND NAMES FOR LESS for "retail store services"
 - Refusal affirmed
 - Wording is a merchandising slogan using ordinary words merely to convey information about applicant's services

Mid '80s - '90s: informational matter (and/or "so highly descriptive"?) (cont'd 2)

- *In re Manco Inc.*
 - THINK GREEN for "household packing and insulating materials."
 - Refusal affirmed
 - Wording broadly conveys the ecological concerns of the environmental movement
- *In re Remington Prods. Inc.*
 - PROUDLY MADE IN USA for "electric shavers"
 - Refusal affirmed
 - Wording informs the public where the applicant manufactured the product and about the applicant's state of mind

Mid '80s - '90s: informational matter (and/or “so highly descriptive”?) (cont'd 3)

- *In re Volvo Cars of North America, Inc.*
 - DRIVE SAFELY for “automobiles”
 - Refusal affirmed
 - Wording is a commonplace safety admonition

Historical case development

- So highly descriptive/laudatory
 - *In re Boston Beer Co.*
 - Phrase “The Best Beer In America”
 - “The proposed mark is . . . so highly laudatory and descriptive of the qualities of its 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.”



Discussion topic

Current practice

Failure to function: Informational matter

- Common general fact patterns:
 - General information about the goods or services
 - Common phrase or widely-used message
 - Direct quotation, passage, or citation from a religious text used to show affiliation with, support for, or endorsement of the ideals conveyed in the text

Informational matter: Common phrase or widely used message

- Widely-used messages include:
 - Slogans, terms, and phrases that various parties use to convey ordinary or familiar concepts or sentiments
 - Social, political, religious, or similar informational messages that are commonly used or are otherwise generally understood

Current practice: Key case quotes

- *In re Team Jesus LLC*
 - “Matter that is widely used to convey ordinary or familiar concepts or sentiments, or social, political, religious, or similar informational messages that are in common use, would not be perceived as indicating source and is not registrable as a mark.”

Current practice: Key case quotes

(cont'd 2)

- *In re Pro-Line Corp.*
 - “Not every word, name, phrase, symbol or design, or combination thereof which appears on a product functions as a trademark.”
 - “[M]ere intent that a phrase function as a trademark is not enough in and of itself to make it a trademark.”
 - Evidence of consumer perception



Current practice: Key case quotes

(cont'd 3)

- *In re Greenwood*

- “The more commonly a phrase is used, the less likely that the public will use it to identify only one source and the less likely that it will be recognized by purchasers as a trademark [or service mark].”

Basic inquiry

- Assess evidence of how the relevant public would perceive the proposed mark:
 - As something that identifies and distinguishes source, or
 - As communicating something else?
- For example
 - *In re Team Jesus LLC*

How to assess perception as a source

- Examine the evidence:
 - Use of the phrase by third parties
 - Use of the phrase by the applicant
- For example,
 - *In re Team Jesus LLC*

Trademark Act § 2(f) claim

- Typically cannot be used to overcome a failure to function refusal.
- Section 2(f)-type evidence can be used to show consumer perception and whether the subject matter functions as a trademark.
 - For example
 - *In re Ocean Tech., Inc.*



Recent Federal Circuit precedents

- *In re Vox Populi Registry Ltd.*
 - Proposed mark:
 - “.SUCKS” for “[d]omain registry operator services” for .sucks domains and “[d]omain name registration services” for .sucks domains.
 - Evidence supported Board’s finding:
 - “Consumers will view [the standard character mark .SUCKS] as only a non-source identifying part of a domain name, rather than as a mark.”



Recent Federal Circuit precedents

(cont'd 2)

- *In re Vox Populi Registry Ltd.*
 - Evidence showed
 - Website using .SUCKS to refer to a product
 - Online articles discussing .SUCKS to refer to a product rather than the provider of services
 - Third party registrars using .SUCKS to refer to a product being sold to the public rather than as an identifier for Vox's services



Recent Federal Circuit precedents

(cont'd 3)

- *In re GO & Assocs., LLC*
 - Proposed mark:
 - EVERYBODY VS RACISM for clothing, tote bags, race-related informational services.
 - “The source identifier requirement is broader than just whether a proposed mark is generic or descriptive, and typically focuses on how the mark is used in the marketplace and how it is perceived by consumers.”



Recent Federal Circuit precedents

(cont'd 4)

- *In re GO & Assocs., LLC.*
 - Evidence showed third parties commonly use “Everybody vs. Racism” in an informational and ornamental manner on clothing items, tote bags, and other retail items sold by third-parties to convey an anti-racist sentiment.
 - Consumers thus would not view it as an indicator of a unique source.



TTAB precedents: Informational, common phrase, widely used

- *D.C. One Wholesaler, Inc. v. Chien*
 - I ♥ DC for “clothing, bags, and plush/stuffed toys”
 - Opposition sustained; cancellation granted
 - A large number of merchandisers have widely used the wording over a long period of time to express enthusiasm or affection for, or affiliation with, Washington, D.C.
- *Univ. of Ky. v. 40-0*
 - 40-0 for “t-shirts and other sports-related apparel”
 - Opposition sustained
 - Widespread, common use of “40-0” in an informational manner to convey a perfect, undefeated NCAA basketball season

TTAB precedents: informational, common phrase, widely used (cont'd 2)

- *In re Texas With Love, LLC.*
 - TEXAS LOVE for “hats and shirts”
 - Refusal affirmed
 - The public would perceive proposed trademark as a widely-used phrase that merely conveys a well-recognized and commonly expressed concept or sentiment.
- *In re Eagle Crest, Inc.*
 - ONCE A MARINE, ALWAYS A MARINE for various clothing items
 - Refusal affirmed
 - Specimens showed applicant’s use of the phrase to express support, admiration, or affiliation with the Marines
 - Evidence showed others’ widespread use of the phrase to express the same sentiment

TTAB precedents: informational, common phrase, widely used (cont'd 3)

- *In re Greenwood*
 - GOD BLESS THE USA for “accent pillows, decorative wood centerpieces, and non-textile decorative wall hangings”
 - Refusal affirmed
 - Evidence showed widespread use of the phrase for household items such as those identified in applicant’s application
- *In re DePorter*
 - #MAGICNUMBER108 for various clothing items
 - Refusal affirmed
 - Wording relates to and expresses support for the Chicago Cubs and their World Series win and, therefore, does not function as a source indicator

TTAB precedents: Informational, common phrase, widely used (cont'd 4)

- *In re Wal-Mart, Inc.*
 - INVESTING IN AMERICAN JOBS for “retail store services and promoting public awareness of goods made by American workers”
 - Refusal affirmed
 - Evidence showed other businesses have widely used similar wording to show that they promote American-made goods by investing in American jobs



TTAB precedents: miscellaneous

- *In re Mission America Coalition*
 - THE TABLE COALITION for a collective membership mark
 - Refusal affirmed
 - Failure to function as a collective mark because applicant has not shown use in commerce by a member to indicate membership in a collective organization but instead as a service mark. Use was by applicant through its Director of Ministry



TTAB precedents: Ornamentation

- *In re Peace Love World Live*
 - I LOVE YOU for “bracelets”
 - Refusal affirmed
 - Size, location, dominance and significance of alleged mark as applied to the goods are relevant. Phrase as seen in specimen is essentially the bracelet itself
 - Conveys term of endearment but does not identify or distinguish source. There were many similarly decorated items in the marketplace



TTAB precedents: Ornamentation (or secondary source?)

- *Major League Baseball Players Ass'n v. Chisena*
 - “The ‘ornamentation’ of a T-shirt can be of a special nature which inherently tells the purchasing public the source of the T-shirt, not the source of manufacture but the secondary source.” (quoting *In re Olin Corp.*, 181 USPQ 182, 182 (TTAB 1973)).
 - Opposition sustained
 - “Consumers wear Opposers’ licensed goods to show support or approval for other services, namely, Aaron Judge’s baseball entertainment services.”



TTAB precedents: Color

- *In re Post Foods*

- Refusal of proposed color mark affirmed
- Proposed color mark was not inherently distinctive
- Third parties used similar colors on breakfast cereals
- Extensive evidence of long-time use with crisp rice cereals v. broad identification of goods, “breakfast cereal”
- Evidence that consumers recognized cereal’s color, shape, and texture insufficient. Did not establish acquired distinctiveness in the color of the goods



TTAB precedents: Characters in creative works



- *In re Joseph A. Stallard*
 - Affirmed failure to function refusal for use in connection with goods including computer game software because design mark is used in a manner to be perceived as video game character and nothing else, not as a trademark
 - No prohibition on character designations also serving as trademarks or service marks
 - Where the usage of a character in specimens fails to impart any commercial impression as a trademark or service mark, it is not registrable as such



TTAB precedents: Name of author or performer

- *In re ZeroSix, LLC.*
 - Refusal reversed
 - BOYS WORLD is not just name of musical group, but used for series of recordings and promoted and recognized as source of the identified goods
 - Website and social media pages prominently displayed BOYS WORLD and provided access to recorded music. Evidence of their significant following, including:
 - At least 335,000 monthly listeners on Spotify music streaming service
 - YouTube page had 154,000 subscribers and millions of views
 - TikTok page had 2 million followers
 - Articles in Billboard and People publications
 - “As a result, consumers ‘know what they are getting’ when they purchase BOYS WORLD ‘audio recordings featuring music.’ Thus, BOYS WORLD functions as a mark”



TTAB precedents: Title of single creative work

- *In re Wood*
 - Refusal to register CHURCHBOY TO MILLIONAIRE affirmed
 - "This court's precedent . . . clearly holds that the title of a single book cannot serve as a source identifier." (quoting *Herbko Int'l Inc. v. Kappa Books, Inc.*, 308 F.3d 1156 (Fed. Cir. 2002))
 - "[H]owever arbitrary, novel or nondescriptive of contents the name of a book -- its title -- may be, it nevertheless describes the book." (quoting *In re MCDM Prods., LLC*, 2022 USPQ2d 227, at *2 (TTAB 2022))
 - Allowing registration may create obstacles to copyrighted material entering public domain
 - Single creative works include those in which the content does not change; significant changes may take case outside the rule
 - No evidence that second, Spanish-language version of book significantly changed content



TTAB precedents: Reversals

- *In re Black Card LLC*
 - FOLLOW THE LEADER for services in Classes 35, 36, 39, 41, 43, and 45.
 - Failure to function refusal REVERSED
 - The evidence as a whole does not demonstrate use for services or in contexts from which we may reasonably infer that FOLLOW THE LEADER has a commonly understood meaning applicable to applicant's services that would render it incapable of being perceived as a source indicator for those services.
 - Nor did the evidence show that FOLLOW THE LEADER is a phrase used to convey a single, common sentiment or meaning across a variety of goods or services, such that consumers will view the phrase as conveying that same sentiment or meaning regardless of the goods or services in connection with which it is used.



TTAB precedents: Reversals (cont'd 2)

- *In re Lizzo LLC*
 - 100% THAT BITCH for various clothing items
 - Failure to function as widely used common phrase REVERSED, evidence in record shows use of phrase pointing to applicant
- *In re ZeroSix, LLC*
 - BOYS WORLD for “audio recordings featuring music”
 - Failure to function refusal REVERSED, performer’s name functions as mark for audio recordings featuring music

Discussion topic

Relationship to other refusals

Relationship to other refusals (cont'd 2)

- Other refusals
 - Trademark Act § 2(e)(1) — Merely descriptive
 - Trademark Act §§ 1, 2, (3) and 45 — Generic
 - Trademark Act § 2(e)(5) — Functional
 - Trademark Act §§ 1, 2 and 45 — Application requirements (drawing, specimen, direct association with services)

Relationship to other refusals (cont'd 3)

- Merely descriptive
 - Sometimes both refusals apply:
 - BRAND NAMES FOR LESS for retail store services
 - *In re Melville Corp.*
 - WALK IN, PHONE IN, LOG IN for retail, mail order, and online retail store services
 - *In re J&R Electronics, Inc.* (non precedential)

Relationship to other refusals (cont'd 4)

- Merely descriptive
 - Sometimes failure to function is correct and Trademark Act § 2(e)(1) is not:
 - WE MAKE IT, YOU BAKE IT! for supermarket services
 - *In re Niagara Frontier Services*
 - WHY PAY MORE! for supermarket services
 - *In re Wakefern Food Corp.*

Relationship to other refusals (cont'd 5)

- Merely descriptive
 - Sometimes a failure to function refusal may overlap with a mere descriptiveness refusal:
 - *In re Sheet Pile, LLC*
 - ZPILE for metal sheet piles
 - Affirmed refusal based on Trademark Act § 2(e)(1); did not reach failure to function refusal
 - Where examining attorney reasoned that the goods “are Z-shaped piles,” Board assessed registrability on distinctiveness continuum rather than an informational matter failure to function refusal

Relationship to other refusals (cont'd 6)

- Generic
 - General rule:
 - Where a specific sub-type of failure-to-function is mentioned in the Lanham Act—e.g., merely descriptive, generic, functional—that is the preferred way to treat the case.
 - “Because the distinctiveness continuum includes a threshold absolute bar to registration for generic terms—terms that by definition fail to function as source identifiers—this continuum (rather than an informational matter failure-to-function refusal) provides the appropriate framework for the assessment of registrability based on the rationale articulated by the examining attorney in this case—i.e., that the goods at issue ‘are Z-shaped piles.’”
 - *In re Sheet Pile, LLC*
 - Sometimes the evidence will not be clear, however



Relationship to other refusals (cont'd 7)

- Ornamental

- *In re Hulting*

- NO MORE RINOS! for “stickers, signs, shirts, and buttons”

- Refusal affirmed

- Failure to function because informational matter
 - Failure to function because ornamental



Relationship to other refusals (cont'd 8)

- Ornamental

- *In re Pro-Line Corp.*

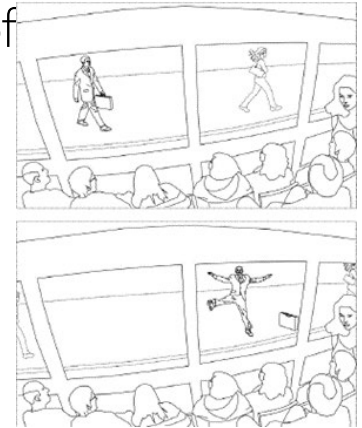
- BLACKER THE COLLEGE SWEETER THE KNOWLEDGE for “shirts”
 - Refusal affirmed. Failure to function because ornamental

- *In re Peace Love World Live, LLC*

- I LOVE YOU for “bracelets”

Relationship to other refusals (cont'd 9)

- Application requirements, *In re Ride*
 - Drawing must be a substantially exact representation of mark as used
 - Description required for any mark not in standard characters
 - Specimen must show mark as used in commerce
 - “The proposed mark is not Applicant's main identifier of the source of its services (THE RIDE is), and it represents a tap dancing routine that varies rather than a repetitive motion mark that is always the same, and consumers would not be pre-disposed to view the tap dance as a mark.”



Takeaways and practice tips:

Specific types of refusals

- Has the matter come to be associated with a single source?
 - Often does not apply and heavy burden
 - Consider ability to argue Trademark Act § 2(f) acquired distinctiveness
 - Argue mark is at most merely descriptive and is capable of functioning as a mark
 - Mere ornamentation: Is there evidence that it also indicates a secondary source?
- Characters in creative work?
 - Develop consistent use as a source identifier and not merely as a character in a creative work.
 - What if any commercial impression does the use impart?
- Title of creative work?
 - Submit evidence that it is used on a series of works or that the content of the work changes.

Takeaways and practice tips: General

- Trademark Act § 45 defines the function of a trademark and §§ 1, 2, and 3 employ that defined term.
- Refusal for failure to function issued when evidence shows the proposed trademark is perceived as a common phrase or widely used message or in another way that is not source-identifying.
- Evidence is based on both applicant's use and third party use in the marketplace.



Prosecution practice tips: General

- Applicant:
 - Provide evidence showing use/recognition of the phrase or other matter as a source identifier and of exclusivity.
 - Counsel clients in selecting and developing marks to use them consistently, in a source identifying manner.
 - Be mindful of “mismatch” between the proposed mark and identified goods/services and/or your evidence.

Prosecution practice tips: General

(cont'd 2)

- Opposer/petitioner:
 - Provide evidence showing extensive or common use by third parties.
 - Provide evidence showing public perceives the phase not as a source identifier but as, e.g., a common phrase or expression.

Questions?

