

Overview of common failure-to-function refusals

What is the basis for the refusal?

- Issued when a proposed trademark doesn't meet the definition of a trademark
- Based on sections 1, 2, 3, and 45 of the Trademark Act
- Determined by the evidence of record, not a *per se* rule

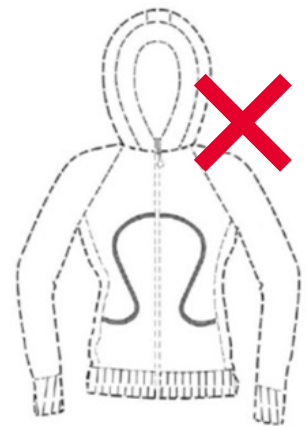
Ornamentation

Concept

- Can't register decorative features that don't identify the source of the goods.
- If the feature doesn't identify source, it's not a trademark.

Factors for determining if the mark will be refused

- What commercial impression does the feature create?
- What are the practices of the trade?
- Is there evidence of secondary source?
- Is there evidence of distinctiveness?



Practice tips

- Consider third-party use of the trademark.
- Research whether consumers are accustomed to seeing similar ornamental displays.
- Ensure acceptable non-ornamental use on other goods and services when establishing secondary source.
- See [TMEP section 1202.03](#) for more information.

Title of a single work

Concept

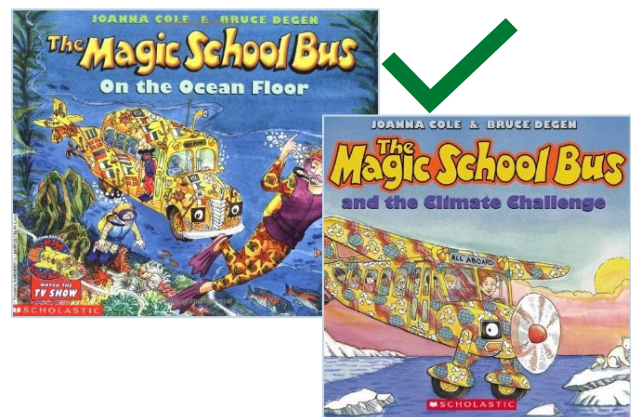
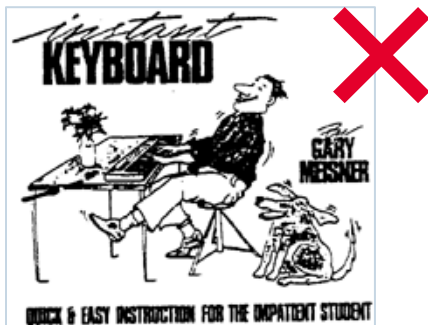
- Can't register the title (or the portion of a title) of a single creative work, unless the title identifies the source of something other than a single creative work.
- If the title doesn't identify a source, it's not a trademark.

Factors for determining if the mark will be refused

- Title of a single work
 - Is it a single creative work?
 - Does the content change significantly from work to work or format to format?
 - Is the title used on a series of works?
 - Is the work not considered to be a single creative work?
- Portion of a title of a single work
 - All factors must be true to avoid a refusal:
 - The portion creates a separate commercial impression apart from the complete title.
 - The portion is used on a series of works.
 - The portion is promoted and recognized as a mark for the series.

Practice tips

- Remember trademarks provide protection for brands, not creative works.
- Can't amend to the Supplemental Register.
- Can't claim section 2(f) acquired distinctiveness.
- See [TMEP section 1202.08](#) for more information.



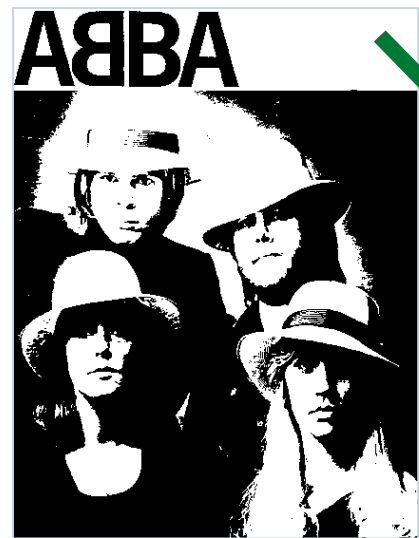
Names of artists and authors

Concept

- Can't register the name of an artist or author for a creative work if the name is solely used to identify the artist or author and not to identify the source of the work.
- If the name doesn't identify source, it's not a trademark.

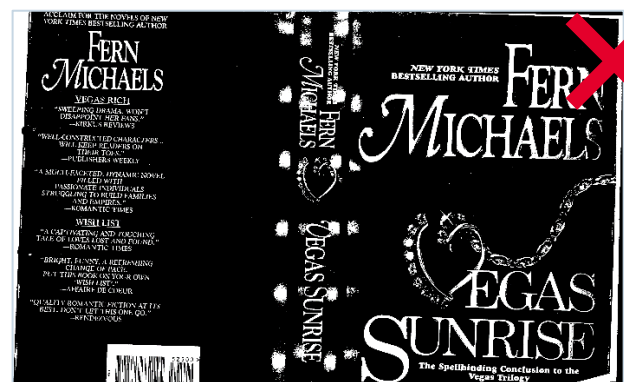
Factors for determining if the mark will be refused

- All factors must be true to avoid a refusal:
 - There is evidence of a series of creative works.
 - There is evidence that the name identifies the source of the series.
 - The name is promoted and recognized as the source of the series.
 - or
 - The artist or author controls the nature and quality of the goods.



Practice 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.
 - Paintings
 - Murals
 - Sculptures
 - Jewelry
- Can't claim section 2(f) acquired distinctiveness.
- See [TMEP section 1202.09](#) for more information.



Goods not used in trade, or services not performed for others

Concept

- Can't register a trademark for items merely incidental to the applicant's primary goods or services.
 - If the item is merely incidental, it's not a good.
- Can't register a service mark for activities that are not performed for others.
 - If the activity is not performed for others, it's not a service.

Factors for determining if the mark will be refused

- Are they goods in trade?
 - Do they exist only to help customers obtain the applicant's primary goods or services?
 - Are they so inextricably tied to the primary goods or services that they have no existence otherwise?
 - Are they sold separately or do they have independent value apart from applicant's primary goods and services?
- Are they services?
 - All factors must be true to avoid a refusal:
 - They are a real activity.
 - They are performed for the benefit of others.
 - They are sufficiently distinct from the applicant's principal activities.



Practice tips

- Think about it from the customer's point of view.
 - What are the primary goods or services provided by the applicant?
- Can't amend to Supplemental Register.
- Can't claim section 2(f) acquired distinctiveness.
- See [TMEP sections 1202.06](#) and [1301.01](#) for more information.