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Trademark Registration: Overcoming Failure-to-Function Refusals, Meeting Use and Distinctiveness Requirements

WEDNESDAY, APRIL 22, 2020

1pm Eastern | 12pm Central | 11am Mountain | 10am Pacific

Today's faculty features:

Joseph R. Englander, Shareholder, **Fowler White Burnett**, Miami

Alexandra J. Roberts, Associate Professor, **UNH Franklin Pierce School of Law**, Concord, N.H.

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**Trademark Registration:
Overcoming Failure-to-Function
Refusals, Meeting Use and
Distinctiveness Requirements**

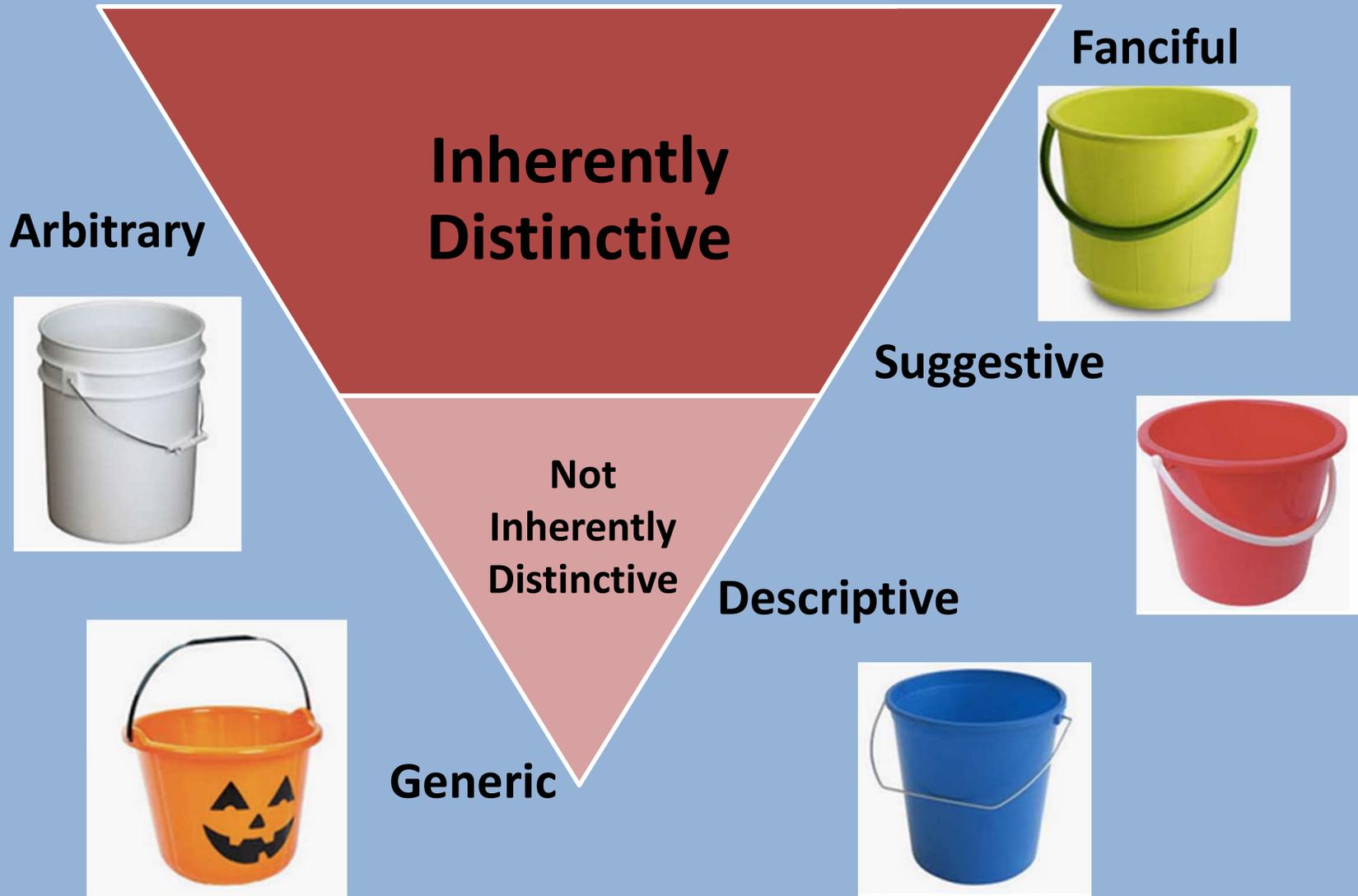
**Professor Alexandra J. Roberts
UNH Franklin Pierce School of Law
April 22, 2020**

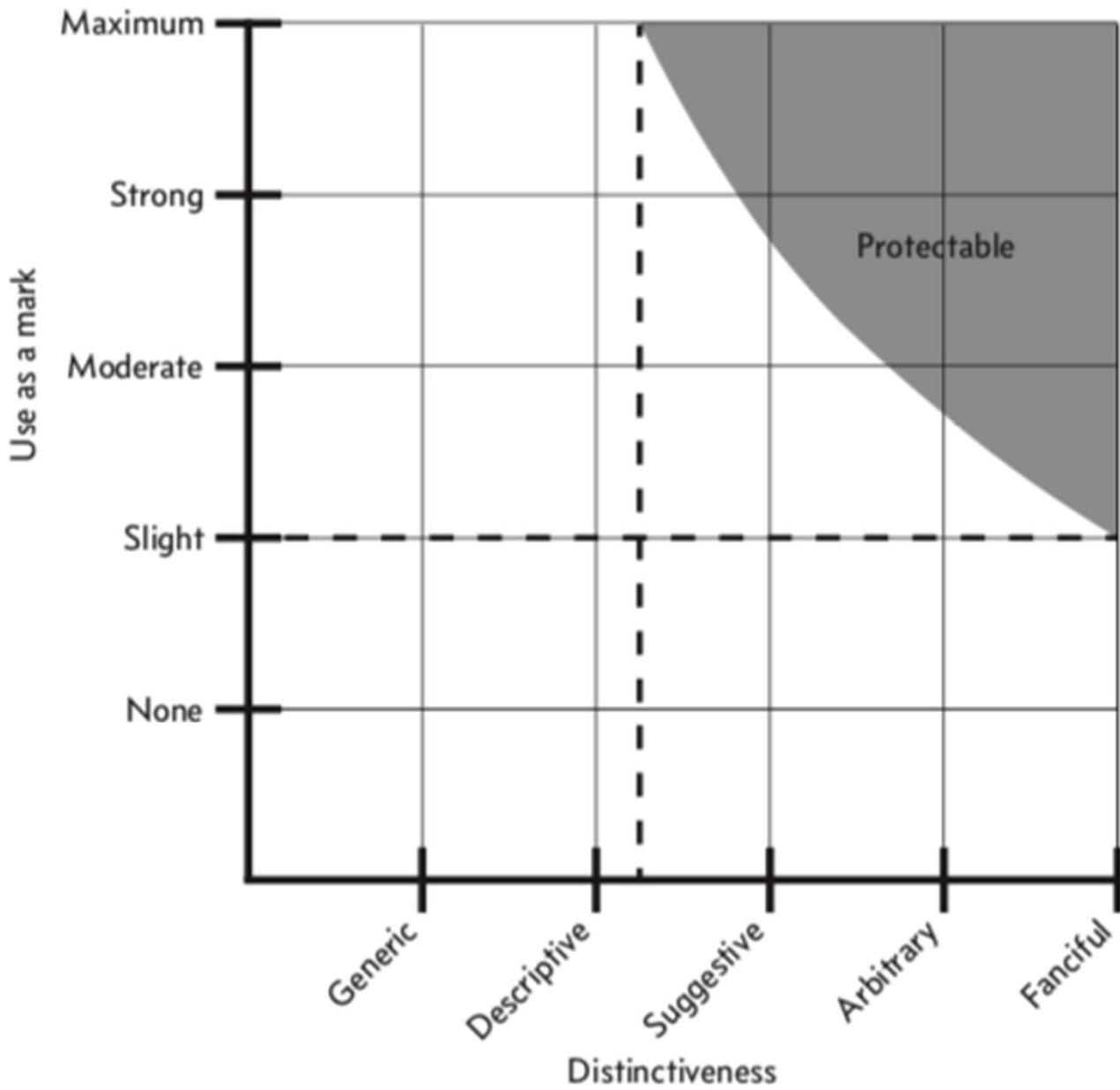
Lanham Act § 45

The term “trademark” includes any word, name, symbol, or device, or any combination thereof...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.

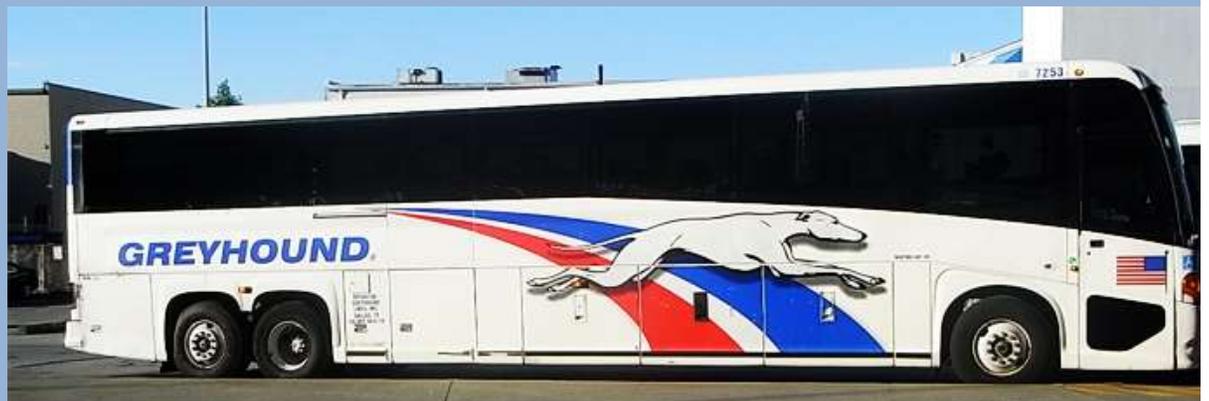


Trademark Distinctiveness





Use as a Mark



East Repair Inc.

485 Amsterdam Avenue
New York, NY 1023

INVOICE



Bill To
John Smith
2 Court Square
Long Island City
New York, NY 1120

Ship To
John Smith
684 Lexington Avenue
6th Floor
New York, NY 10022

Invoice # 00234
Invoice Date 03/25/2014
P.O.# 1742/2014
Due Date 04/09/2014

QTY	DESCRIPTION	UNIT PRICE	AMOUNT
1	Front and rear brake cables & Throttle cable	56.00	56.00
1	New set of pedal arms	182.00	182.00
3	Labor 5hrs	25.00	75.00

AMERICA'S **BIGELOW'S**
FAMILY TEA BLENDERS SINCE 1859

Peppermint
HERBAL TEA

Refreshing peppermint...
pure & simple

CAFFEINE FREE
ALL NATURAL

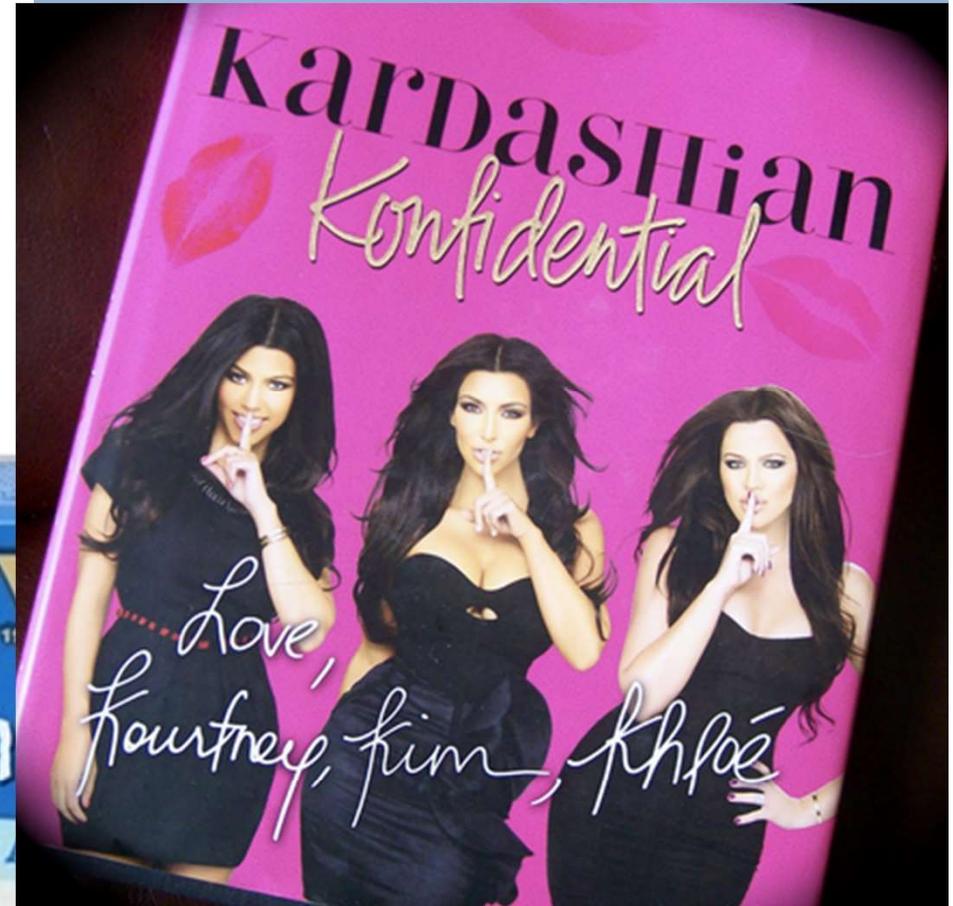
NET WT .91 OZ (25 g)

20 TEA BAGS INDIVIDUALLY WRAPPED IN FOIL POUCHES.
FRESHNESS STAYS IN. AIR AND MOISTURE STAY OUT.

Terms & Conditions
Payment is due w/

Citibank, N.A.
Account number: /
Routing: 23412

Failure to Function



Failure to Function

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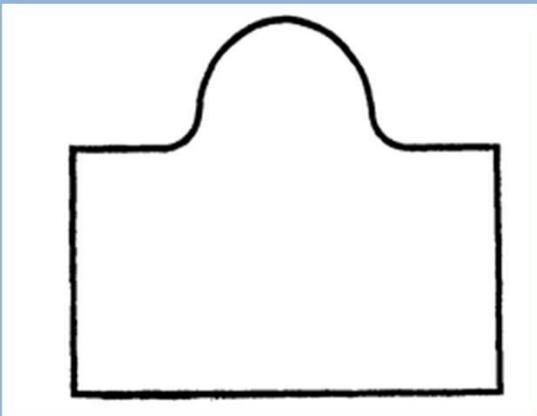
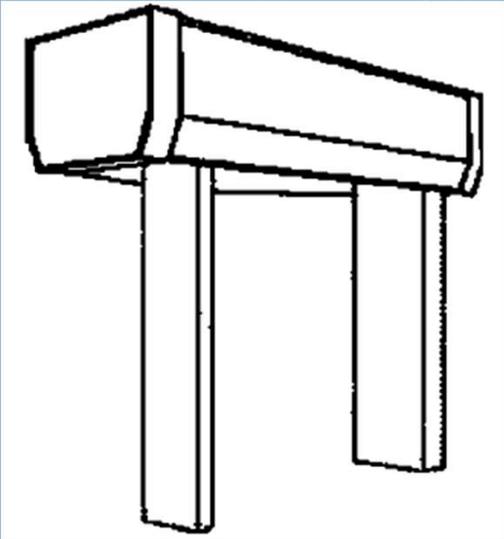
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Published on Mar 26, 2013

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Failure to Function



“Primarily something else” marks

- Hashtag (#BeUnprecedented)
- Domain name (FreshHerbs.com)
- Celebrity name (Kim Kardashian West)
- Catchphrase (Make America Great Again)
- Informational matter (Spectrum)
- Decoration, design (Fantasia)
- Serial or model no. (171994)



Hashtag: #BeUnprecedented

Mark
1st year law student



First one called on in Civ Pro.
#SocraticMethod #BeUnprecedented



Find tips on making class prep easier with
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Kater's FRESH BASIL

CELEBRATE FLAVOR

Here are just a few of the wonderful ways
to use Kater's Fresh Basil!

- In scrambled eggs or any chopped egg salad, add between one and three teaspoons minced basil.
- Finely chop the leaves and toss with flour for coating poultry, chops and vegetables. A good ratio is a tablespoon per cup of flour.
- For tomato soup, add a teaspoon of finely chopped basil 5 minutes before serving for each portion of soup.
- For an interesting beverage, warm tomato juice and add some very fine minced basil leaves. Chill and serve.

For more great Freshherb Ideas, visit
freshherbs.com



RINSE WHEN READY TO USE

Kater's is a brand of Shenandoah Growers Inc.
Harrisonburg, VA • Live Oak, FL • Homestead, FL
© 2004

 please recycle this container

In re Shenandoah Growers (TTAB 2008)

Celebrity name: KIM KARDASHIAN WEST

A screenshot of the Facebook profile for Kim Kardashian West. The page header includes the Facebook logo, a search bar, and a 'Sign Up' button. Below the header is a banner for 'KEEPING UP WITH THE KARDASHIANS' featuring a photo of Kim. The profile name 'Kim Kardashian West' is displayed as a 'Public Figure'. The page layout includes a left sidebar with navigation options like 'Timeline', 'About', 'Photos', 'Likes', and 'More'. The main content area shows a search bar, a 'PEOPLE' section with 28,165,834 likes, an 'ABOUT' section with a bio, and a 'PHOTOS' section with a grid of images. A 'VIDEOS' section is also visible at the bottom.

Kim Kardashian West
April 11 at 1:47pm · 🌐

Thank you Hakassan for having me! Thank you Olivier Rousteing & Balmain for dressing me! And thank you Ariel and Cesar for glamping me!

A photograph of Kim Kardashian West on a red carpet. She is wearing a white, off-the-shoulder, sequined dress with black accents. The background is a blue carpet with logos for 'Jakkasan' and 'MGM GRAND'.

Kim Kardashian West
April 6 at 10:30am · 🌐

TRENDING: AVIATOR JACKETS

Two images of aviator jackets. The left image shows a model wearing a light-colored, quilted aviator jacket with a high collar and dark accents. The right image is a close-up of the jacket's fabric, showing a dark, quilted texture with a white circular patch and a zipper.

TRENDING: AVIATOR JACKETS

KIMKARDASHIANWEST.COM

Catchphrase: MAKE AMERICA GREAT AGAIN

8/11/2015

Shop Trump for President Apparel, Hats & Signage | Donald J Trump for President

TRUMP
MAKE AMERICA GREAT AGAIN!

 Store Home

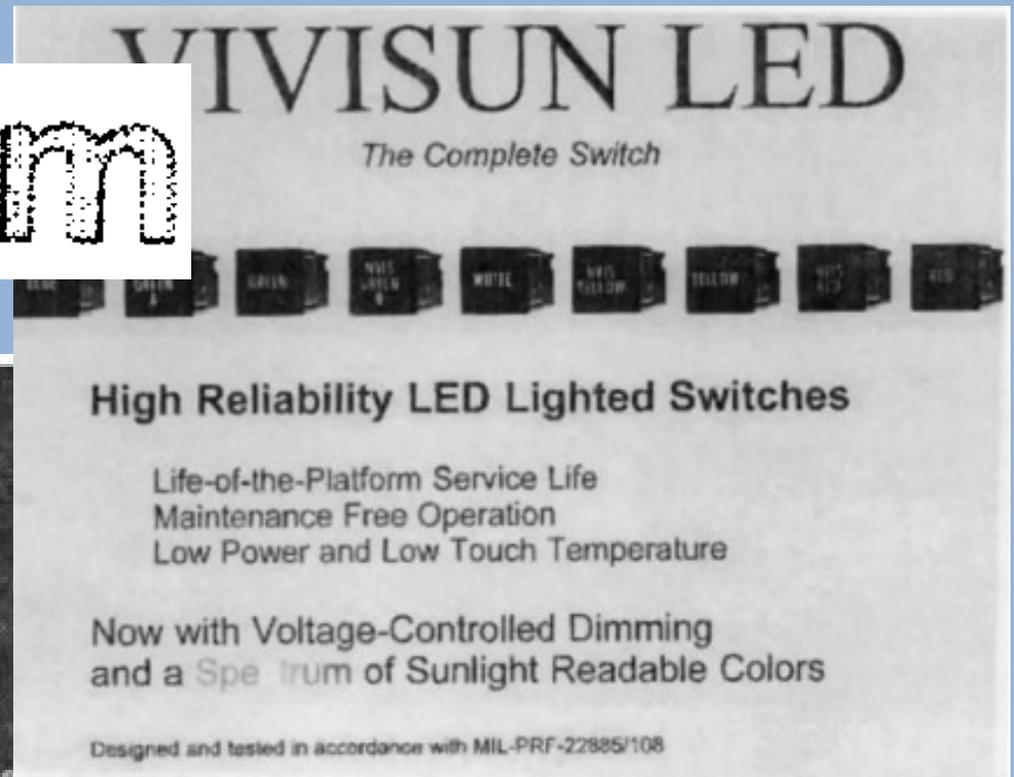
Shop By Category



FEATURED PRODUCTS

Informational matter: *In re Aerospace Optics (TTAB 2006)*

Spectrum



VIVISUN LED
The Complete Switch

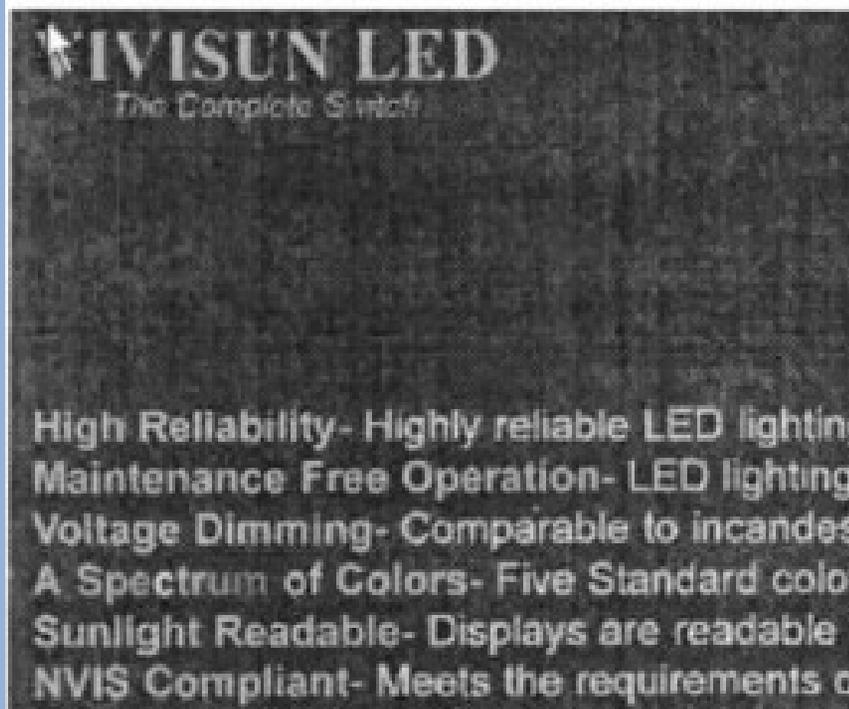
RED GREEN WHITE YELLOW RED

High Reliability LED Lighted Switches

Life-of-the-Platform Service Life
Maintenance Free Operation
Low Power and Low Touch Temperature

Now with Voltage-Controlled Dimming
and a Spectrum of Sunlight Readable Colors

Designed and tested in accordance with MIL-PRF-22885/108



VIVISUN LED
The Complete Switch

High Reliability- Highly reliable LED lighting provides life-of-the-platform service life.

Maintenance Free Operation- LED lighting eliminates replacing failed incandescent lamps.

Voltage Dimming- Comparable to incandescent lamp voltage dimming.

A Spectrum of Colors- Five Standard colors, including white and four NVIS colors.

Sunlight Readable- Displays are readable in 10,000 foot-candles.

NVIS Compliant- Meets the requirements of MIL-L-85762A referenced in JSSG-2010-5.

Thoroughbred Legends, LLC v. The Walt Disney Co., 2008 WL 616253 (N.D. Ga. Feb. 12, 2008)



I own Thoroughbred Legends, LLC, an entity that has obtained the trademarks for a number of famous thoroughbred racehorses-among them Ruffian, Alydar, Man O'War, Citation, and Whirlaway.

--

Peter E. Blum|



Model number:
Tenneco v. Kingdom Auto Parts,
410 F. App'x 841, 844 (6th Cir. 2010)



What do we talk about when we talk about use as a mark?

- Relative size
- Color
- Distinctive font
- Stylization
- Prominent placement (“the trademark spot”)
- Set off by itself
- Use of TM or ® symbol
- All caps or initial caps

Use as a Mark



Lee et al survey

“In the product package shown, ‘Wonderful’ [is a brand name] / [is not a brand name] [don’t know]”



80% brand name



70% brand name

Lee et al survey

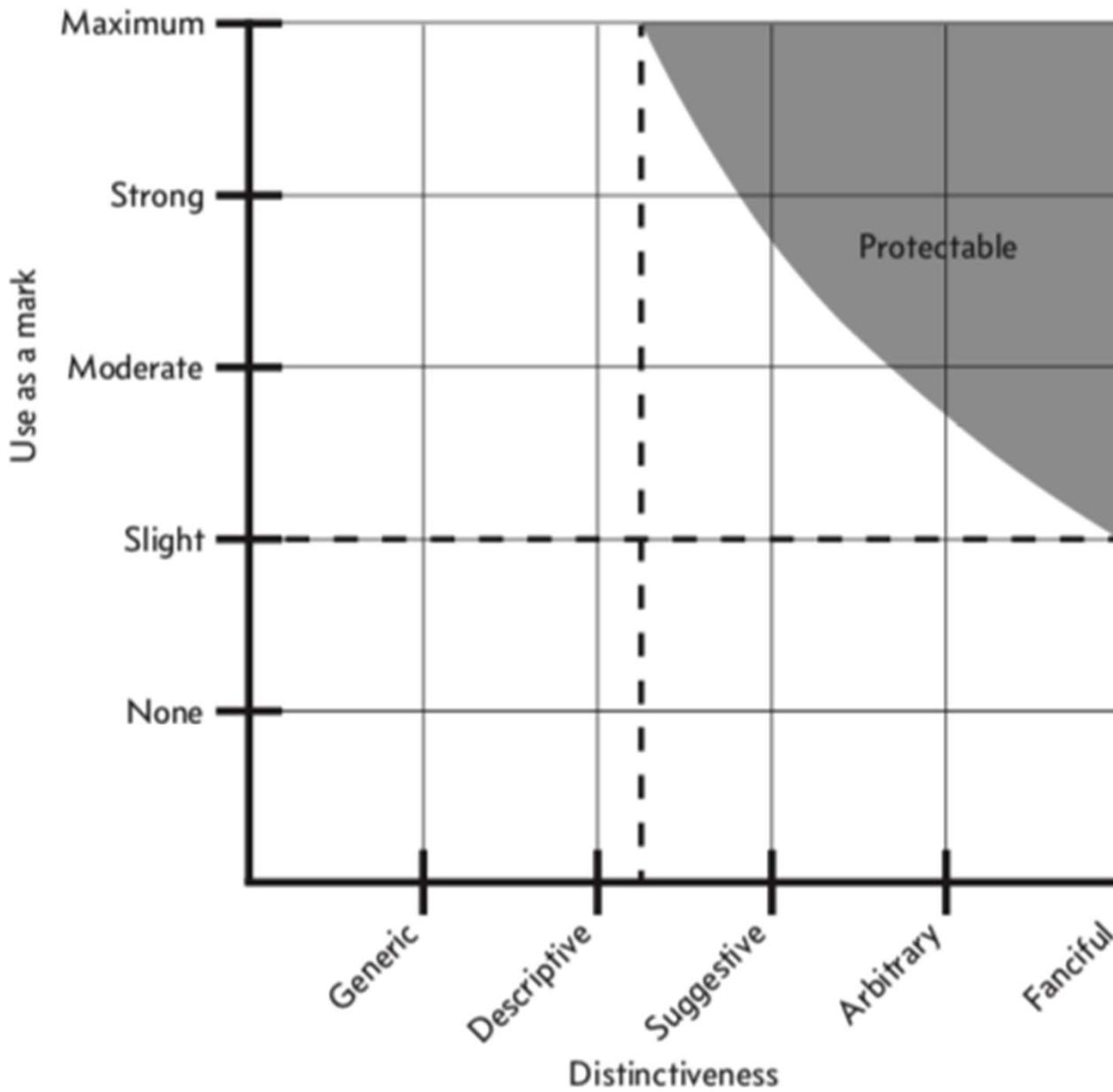
“In the product package shown, ‘Wonderful’ [is a brand name] / [is not a brand name] [don’t know]”



33% brand name



27% brand name



In re Eli Lilly & Co. (TTAB 2015)

Fanciful TM + borderline UAM = protectable

H9X-MC-GBDG

Lot: CT588529

Package Number: s / 73302



Confirmation Number: XXXXXX

Patient number: _____

Investigator: _____

Carton contains 5 syringes. Syringe contains a 0.5 mL solution for injection of Trulicity™ (dulaglutide) or placebo.

For subcutaneous use only. Use as directed by investigator.

Ready to use syringe. Do not expel air from syringe.

Store refrigerated (2 °C - 8 °C; 36 °F - 46 °F). Do not freeze.

Do not destroy. Return packaging and unused medication to the investigator. Keep out of reach of children.

CAUTION: New drug - Limited by Federal (or United States) law to investigational use.

Eli Lilly and Company, Indianapolis, IN 46285 USA

CHIPSET-FREE CHARGING

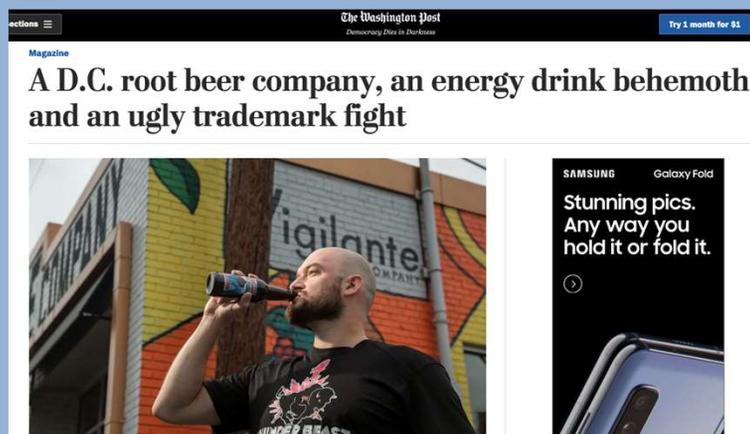
Descriptive + borderline UAM = unprotectable



So what?

Dangers of overprotecting matter that fails to function:

- Deadwood on the register
- Chills competition
- Chills competitor & consumer speech
- Bad litigation/TTAB outcomes
- Bargaining in the shadow of the law
- Bullying



RESPONDING TO FAILURE TO FUNCTION AS A TRADEMARK REJECTIONS

Joseph R. Englander, Shareholder

FOWLER WHITE BURNETT

jenglander@fowler-white.com

TMEP GUIDELINES

TMEP §1202.19(e) Failure-to-Function Refusal

In re Bose Corp., 192 USPQ 213, 215 (C.C.P.A. 1976)

Does the applied for mark function as a trademark?

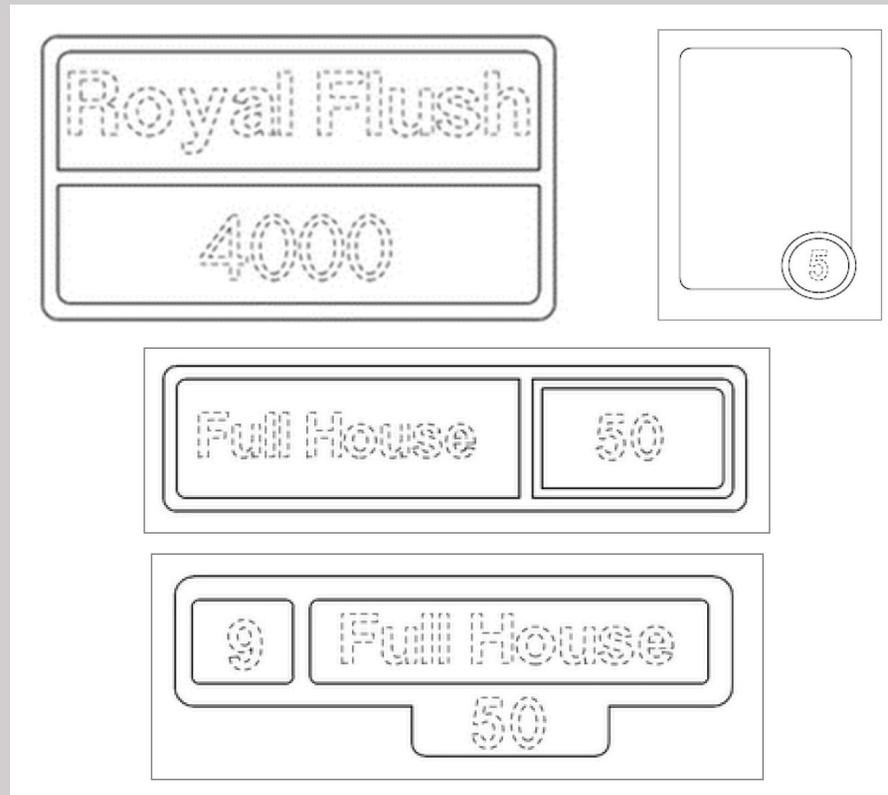
- Is the mark inherently distinctive?
- Does the mark identify the source of the goods and services?
- Does the mark create a commercial impression?

“FAILURE TO FUNCTION” AT THE USPTO

T.M.E.P. §1202 Distinctiveness Determination

- The mark **must serve as an indicator of the source** of the goods or services, identifying and distinguishing them from those of others.
- The mark **must create a commercial impression** when the mark is used in connection with the identified goods or services. *See In re Aerospace Optics, Inc.*, 78 USPQ2d 1861, 1862 (TTAB 2006). ("A critical element in determining whether matter sought to be registered is a trademark is the impression the matter makes on the relevant public. Thus . . . the critical inquiry is whether the asserted mark **would be perceived as a source indicator**. . . . To be a mark, the term must be used in a manner calculated to project to purchasers or potential purchasers a single source or origin for the goods. . . . We determine whether this has been achieved by examining the specimens of use along with any other relevant material submitted by applicant during prosecution of the application.").

RECENT PRECEDENT



RECENT PRECEDENT

In *In re Serial Podcast, LLC*, 126 USPQ2d 1061 (TTAB 2018), the Board noted, “Most common geometric shapes, such as circles, squares, triangles, ovals, and rectangles, when used as backgrounds for the display of word marks, are not considered inherently distinctive, and have difficulty acquiring distinctiveness.”

RECENT PRECEDENT

In *In re General Mills IP Holdings II, LLC*, 124 USPQ2d 1016, 1018 (TTAB 2017), the color yellow for cereal was found to lack acquired distinctiveness despite use on Cheerios boxes for seventy years. The decision was based in part on the fact that the yellow boxes also featured the CHEERIOS trademark. and so "there was little reason for consumers to rely on the yellow color of the box as a source identifier."

RECENT PRECEDENT

PREDICTIVE ENTREPRENEUR for educational services including seminars

Refusal reversed

[*In re Meredith Madsen*](#), Serial No. 87054308 (September 24, 2019)

RECENT PRECEDENT

PREDICTIVE ENTREPRENEUR

Single creative works include works in which the content does not change, whether that work is in printed, recorded, or electronic form. A theatrical performance is a single creative work because the content of the play, musical, opera, or similar production does not significantly change from one performance to another. *In re Posthuma*, 45 USPQ2d at 2014; TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) §1202.08(a) (2019).

RECENT PRECEDENT

PREDICTIVE ENTREPRENEUR

“live performances by musical bands, television and radio series, and educational seminars are presumed to change with each presentation and, therefore, are not single creative works.” TMEP § 1202.08(b)

RECENT PRECEDENT

INTELLIGENCE OF THINGS - [*In re Flex Ltd.*](#), Serial Nos. 86453853 and 86493735
(December 9, 2019)

Refusal upheld

1. The meaning of the proposed mark must be considered in relation to the services at issue, and here the evidence shows that INTELLIGENCE OF THINGS has a "consistent and well-understood meaning" in connection with applicant's services.
2. The Board is not concerned with the perception of the "general public" but with that of the purchasers of applicant's services.
3. The phrase need not be a "topic of nationwide awareness."

RECENT PRECEDENT

MOTOR NUMBERS **MR1109**, **MR1108**, and **MR1107**

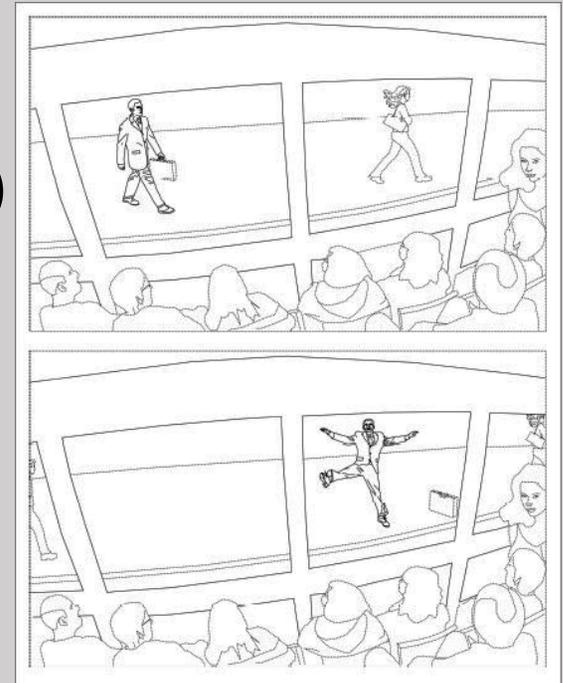
- Rejection upheld - the proposed marks were merely model designations and, therefore, the terms would not be seen source identifying marks.
- [*In re HD Medical Electronic Products Inc.*](#), Serial Nos. 87207915, 87207919, and 87207921 (Feb. 7, 2020) [not precedential].
- “record is simply devoid of any evidence that anyone other than Applicant considers the proposed marks to be source-identifiers rather than indicators of product compatibility in automotive production and repair.”
- Use of TM symbol after the model numbers was evidence of intent, but not how consumers view the marks.

RECENT PRECEDENT

A motion mark for "conducting sightseeing travel tours by bus"

Rejection upheld

[In re The Ride, LLC](#), 2020 U.S.P.Q.2d 39644 (T.T.A.B. 2020)



RECENT PRECEDENT

The application describes the mark as follows:

*The mark consists of the live visual and motion elements of the trade dress of a guided bus tour in which as the bus approaches at least one predetermined location on the tour an entertainer who is dressed as a **banker** walks normally along the street and then performs a tap dance routine dancing act when the bus stops at the predetermined location as viewed from inside of the bus. The drawing shows two sequential freeze-frames of the mark, in which the top frame shows an entertainer dressed as a **banker** walking along the street on the side of the bus and in which the bottom frame shows the entertainer performing a tap dance routine at the predetermined location. Dotted lines in the drawing show placement of the mark and are not part of the mark.*

None of the specimens showed this.

RECENT PRECEDENT

[*In re The Ride, LLC*](#), 2020 U.S.P.Q.2d 39644 (T.T.A.B. 2020)

- The Board discounted the survey provided, finding the Applicant failed to conduct a survey "mini-course" to test the understanding of the participants as to whether something functions as a mark.
- Applicant's specimen "displays various images of a tap dancer along with other identifiers, principally, **The Ride and The RideNYC.com**. The Board could not "infer ... that consumers will perceive the proposed mark, amid these other more traditional designations, as a source indicator."

RECENT FEDERAL CIRCUIT FAILURE TO FUNCTION DECISION

In re Light 662 F. App'x 929 (Fed. Cir. 2016)

Rejection upheld

Each proposed mark contains over 570 words, arranged in column format, and, at core, “identifies what appears to be a title (of a story, e.g.) and a list of fanciful, fictional names for characters.”

The submitted specimens do not suggest otherwise. The cover of the submitted playbook bears the title: “The Triple-Shimmering Shimmering Rainforest, Shimmering Ballerinas & Dancers And Shimmering Breezes Storybook Have Fun Playbook & Storybook For Children.” See Joint App. 254 (No. 2014-1597). It displays the proposed mark to the right of the Introduction, which similarly contains a list of character names. *Id.* at 257.

“[R]eaders and users of [the playbook] will understand the applied-for matter as simply identifying a title or theme for the playbook, [and] a corresponding list of character names in the playbook.” Decision I at *5; Decision II at *4. Nothing about the use of the proposed marks in the playbook supports Light's argument that the proposed marks operate to identify the source of goods.

OPTIONS FOR RESPONDING TO FAILURE TO FUNCTION REJECTION

- Amend to Supplemental Register
- Argue Distinctiveness of Mark If Possible
- Amend to 2(f) – Five Years Exclusive Use for Acquired Distinctiveness
- Confirm Specimen May Be Improved

TAKEAWAYS

1. STACK THE DECK FOR SPECIMENS – “LOOK FOR”
2. CONFIRM MINI-COURSE FOR SURVEYS.
3. ADVERTISE MODEL NUMBERS AS SOURCE IDENTIFIERS
4. PROVIDE EASY-TO-APPROVE SPECIMENS.
5. CHECK WITH YOUR CLIENTS ABOUT NEW GOODS/SERVICES:
 - MASKS
 - SANITIZERS/WIPES
 - TAKE OUT/ DELIVERY SERVICES