

## Examination Guide ^-17

### Incapable Informational Matter

^ 2017

I.	BACKGROUND .....	1
II.	REFUSALS .....	2
A.	Failure-to-Function Refusal – Incapable Informational Matter.....	3
1.	Information about the Goods/Services.....	3
2.	Widely Used Messages.....	4
a.	Commonplace Messages .....	5
b.	Social, Political, Religious and Similar Messages .....	5
c.	Evidence.....	6
3.	Religious Texts .....	7
a.	Direct Quotations, Passages, and Citations.....	7
b.	Matter from Religious Texts that Has Become Part of Everyday Language .....	8
c.	Wording that References Religion But Is Not a Direct Quotation, Passage, or Citation .....	9
4.	Applications Based on Section 1(b), 44, or 66(a) .....	9
B.	Consideration of Additional Refusals .....	9
III.	DISCLAIMER AND DELETION WHERE MARK HAS REGISTRABLE MATTER .....	10
IV.	APPLICANT’S RESPONSE OPTIONS .....	10
	APPENDIX A .....	A-1
	APPENDIX B .....	B-1
A.	Information About the Goods/services .....	B-1
B.	Widely Used Commonplace Messages .....	B-4
C.	Widely Used Social, Political, Religious or Similar Messages .....	B-10
D.	Direct Quotations, Passages, and/or Citations from Religious Texts .....	B-19

#### Introduction

This examination guide clarifies the policies and procedures for examining marks containing certain types of informational matter that does not indicate source and thus fails to function as a mark. The guide explains certain types of matter that would be considered informational and sets forth the relevant case law. The guide also identifies when an examining attorney must refuse registration or require a disclaimer of such matter, discusses an applicant’s response options, and provides examples illustrating the concepts covered. The guidance provided herein supersedes any previous United States Patent and Trademark Office (USPTO) guidance on this topic.

#### I. BACKGROUND

Matter must function as a mark to be eligible for registration.<sup>1</sup> To function as a mark the matter must serve as an indicator of the source of origin of the goods/services, identifying and distinguishing them from those of others.<sup>2</sup> Matter that fails to distinguish the applicant’s goods/services from those of others or to identify a single source does not qualify for registration because it fails to function as a mark.<sup>3</sup>

Incapable informational matter in marks is used merely to impart information or convey an informational message. This examination guide details the following three types of matter that are considered informational:

- Matter that is used in a manner merely to convey information about the goods/services;
- Matter that is a widely used message; and
- Matter that is a direct quotation, passage, and/or citation from a religious text.

These types of incapable informational matter do not function as marks because, even when used in the marketplace, consumers would understand the wording to convey information or an informational message rather than as a mark to indicate a single source for the goods/services offered under the wording.

To determine whether matter merely conveys information or an informational message, the “critical inquiry . . . is how the designation would be perceived by the relevant public.”<sup>4</sup> Both the meaning and the context of use of the wording are relevant to this determination.<sup>5</sup> To support this refusal the examining attorney must review the evidence in the application record (e.g., drawing, mark description, identification of goods/services, specimens, miscellaneous statements) as well as search for additional evidence showing the meaning and use of the wording (e.g., dictionaries, encyclopedias, applicant’s and third parties’ websites, trade publications, news articles, social media, retail and other websites) to show that consumers will not perceive the wording as indicating a single source. The examining attorney may also contact the Trademark Law Library about resources to search and to assist with research.

A request for information from the applicant may also be issued pursuant to Trademark Rule 2.61(b).<sup>6</sup> In the rare case where the requirement is issued without a refusal, the basis for the inquiry must be explained in the Office action.<sup>7</sup>

If, after review of the available evidence, the examining attorney determines that no refusal should issue due to the inability to establish a prima facie case, a Note to the File should be entered indicating the sources checked.<sup>8</sup>

For a flow chart of the analysis, see [Appendix A](#) and, for examples of proper handling of marks that may contain incapable informational matter discussed in this guide, see [Appendix B](#).

## **II. REFUSALS**

If a mark consists entirely of incapable informational matter, a failure-to-function refusal must issue because the mark does not serve as a source indicator of the identified goods/services. The statutory basis for such refusal is Sections 1, 2, and 45 for a trademark and Sections 1, 2, 3, and 45 for a service mark. When part of the mark comprises incapable informational matter, a failure-to-function refusal is not appropriate. See [Part III](#) for issuing a disclaimer requirement or the option to delete the matter from the drawing.

A refusal on the ground that the matter fails to function as a mark because it consists of matter that is incapable of indicating source cannot be overcome by claiming acquired distinctiveness, by amending the application to seek registration on the Supplemental Register, or by submitting an otherwise acceptable substitute specimen, such as a hang tag or label. Review [Part IV](#) for further information about appropriate response options.

Additional refusals may be relevant, such as ornamentation, descriptiveness and likelihood of confusion, depending on the results of the research conducted.

## **A. Failure-to-Function Refusal – Incapable Informational Matter**

The USPTO’s primary reviewing court has stated that “[t]he 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.”<sup>9</sup> The USPTO therefore will not register matter unless it is capable of distinguishing the applicant’s goods/services from those of others and functioning as a mark.<sup>10</sup> Not every designation that a party places on goods or packaging, or uses in connection with services, necessarily performs these source indicating functions, regardless of the party’s intentions when adopting the designation.<sup>11</sup> And some designations may never serve as source indicators.<sup>12</sup>

When incapable informational matter is refused because it fails to function as a mark, the examining attorney must explain the basis for the refusal and support the refusal with evidence bearing on the public perception of the wording.<sup>13</sup> The reasons the incapable informational refusal could apply are because the wording: conveys information about the goods/services;<sup>14</sup> conveys a widely used message or expression;<sup>15</sup> or is a direct quotation, passage, and/or citation from a religious text. (This is not an exhaustive list of the types of incapable matter that may be refused as failing to function as a trademark/service mark under Sections 1, 2, and 45/1, 2, 3, and 45.) The types of relevant evidence for each of these types of matter are discussed further in the sections below.

### **1. Information about the Goods/Services**

Please leave comments on this section [here](#).

Matter that is used in a manner merely to convey information about the goods/services listed in the application is not registrable. Competitors should be free to use informational matter to provide facts or details about their goods/services. As informational wording provides details about the nature of the goods/services, analysis of the identified goods/services is critical.

Though this failure-to-function refusal is similar to the descriptiveness refusal, in the failure-to-function refusal the focus is primarily on whether the use of the wording by the applicant and third-parties will be perceived as an indicator of a single source of origin.<sup>16</sup> The type of information conveyed can vary, e.g., the environmentally friendly manufacturing process for the goods,<sup>17</sup> the certification process for the goods,<sup>18</sup> or the superior qualities of the goods.<sup>19</sup> So long as the use of the wording conveys information about the goods/services rather than indicates source, this refusal likely applies.<sup>20</sup> The following examples from case law illustrate this point:

- The mark FRAGILE for labels and bumper stickers failed to function as a mark because it alerted consumers to the fragility of any goods on which the labels and bumper stickers were used.<sup>21</sup> By presenting the term across the face of the labels, the term informed consumers of the fragility of the item to which the labels and stickers were attached rather than indicate the source of the labels and bumper stickers.<sup>22</sup>
- The mark SPECTRUM for illuminated pushbutton switches failed to function as a mark, supported by the meaning of the term informing customers of the multiple color feature of the goods and the evidence of the term listed on the specimen among the features of the product.<sup>23</sup>
- The mark GUARANTEED STARTING for motor vehicle services failed to function as a mark for applicant’s services of winterizing vehicles and vehicle starting services

because it merely conveyed to consumers the normal meaning of the wording that using the applicant's services would guarantee that the consumer's car will start.<sup>24</sup>

### Evidence

To support the refusal or disclaimer requirement, the evidence of record must be reviewed for how the wording in the mark is used in connection with the identified goods/services. Any use demonstrating the wording to merely convey facts or details about the goods/services supports this refusal, such as listing the wording with other features of the goods/services or use in a manner that does not stand out from other informational text.<sup>25</sup>

A search for evidence must also be conducted, with a particular focus on the applicant's and any competitors' websites and social media pages, to determine how the wording is used in connection with the same or similar goods/services. Other evidence may include both print and online dictionary and encyclopedia evidence showing that the meaning of the wording merely provides information about the goods/services. Examining attorneys may find print dictionaries with industry specific definitions in the Trademark Law Library.

## **2. Widely Used Messages**

Please leave comments on this section [here](#).

Matter is generally not recognized as source indicating if consumers are accustomed to viewing it in use by many different third parties either in connection with goods/services,<sup>26</sup> or in ordinary language unconnected with any goods/services.<sup>27</sup> The more commonly a phrase is used in everyday parlance, the less likely the public will use it to identify only one source and the less likely the phrase will be recognized by purchasers as a trademark or service mark.<sup>28</sup> Because the function of a trademark is to identify a single commercial source for particular goods or services, if consumers are accustomed to seeing a slogan used in connection with goods/services from many different sources, it is likely that consumers would not view the slogan as a source identifier for such goods/services.<sup>29</sup> Furthermore, different parties should be free to use non-source indicating wording in connection with their own goods, services, and/or activities, and granting one party exclusive rights would put these other parties at a competitive disadvantage.<sup>30</sup>

Messages that are derivatives or variations of widely used messages may also be incapable if they convey the same or similar type of message as the original wording.<sup>31</sup> For example, the "Occupy Wall Street" slogan and protests received widespread attention but the term "Occupy" was used with other terms, e.g. "Occupy DC" and "Occupy Congress," in order to promote the same social message of protesting social and economic inequality.<sup>32</sup> The original and derivative messages may fail to function as marks if evidence shows that, at the time registration is sought, consumers recognize and perceive the wording to promote the social message rather than indicate source.

The types of widely used messages addressed here are those that are commonplace and those that are social, political, religious, or other types of messages and expressions. The "commonplace" category is intended to describe wording, such as DRIVE SAFELY, that has become so common or ordinary that consumers will primarily associate the wording with a particular well-recognized, everyday meaning rather than viewing the wording as an indicator of source for the goods or services. Alternatively, wording considered a social, political, religious, or similar type of message or expression differs because while the wording in question is not so common or ordinary so as to have a particular well-recognized, everyday meaning, this wording, such as BOSTON STRONG, is so widely used to

promote a social, political, religious or other type of message that consumers will primarily associate them with that message rather than viewing them as a source indicator.

**a. Commonplace Messages**

Commonplace messages or expressions generally are incapable of functioning as source indicators because, as used, they convey the ordinary, everyday meaning of the message rather than indicate the source of the goods/services. These messages merely convey ordinary, familiar concepts or sentiments that are widely used by a variety of sources in the marketplace. The identification of goods/services will likely be relevant to the determination of whether the message is commonplace. However, some messages may be found to be in such common usage across a wide variety of goods/services that the specific goods/services in the application are not relevant. Consumers will primarily view these messages as conveying the ordinary and well-recognized concept or sentiment normally associated with them, rather than serving any source indicating function.<sup>33</sup> Moreover, because of these messages' common usage, others should be allowed to use them in connection with their goods/services. The following examples from case law illustrate this point:

- The mark DRIVE SAFELY failed to function as a mark because it would be perceived as an everyday, commonplace safety admonition that does not function as a mark when used in connection with automobiles and structural parts therefor.<sup>34</sup>
- The mark THINK GREEN failed to function as a mark, as this slogan merely conveys a message of environmental awareness and/or ecological consciousness, especially when used in connection with the applicant's products which were advertised to be made from recycled material or recyclable and to promote energy conservation.<sup>35</sup>
- The mark PROUDLY MADE IN USA for electric shavers failed to function as a mark because it is a commonly used expression to encourage purchase of American made products.<sup>36</sup>

**b. Social, Political, Religious and Similar Messages**

Some marks comprise a social, political, religious, or similar message in widespread use. Many of these messages become popular and widely used after a newsworthy event or occurrence. The messages are then spread through use by consumers, business owners, print and television media coverage, and social media appearances such that they become known to significant portions of the populous by frequent exposure. As such, these messages are not attributed to a single source and, thus, are incapable of functioning as source indicators in the marketplace.

Goods/services used in connection with these widely used social, political, religious, and similar messages may be purchased because of the message they convey.<sup>37</sup> Since the rationale is that the goods/services are purchased because of the popular message, the specific goods/services in the application may be less important when determining if this refusal applies. These messages are widely used by multiple third parties to convey support and admiration for or affiliation with the ideals conveyed by the message. Because consumers are accustomed to seeing these messages used by variety of third parties, it is unlikely that they will view them as marks indicating a single source.<sup>38</sup> The following examples, either from case law or created as a hypothetical, illustrate this point:

- The mark ONCE A MARINE, ALWAYS A MARINE for clothing failed to function as a mark because it was shown to be a commonly known motto used by, and in support of, the Marines.<sup>39</sup> The evidence submitted is shown in detail in the example in [Appendix B](#).

- The mark ONE NATION UNDER GOD for charity bracelets failed to function as a mark because it was shown to be a well-known phrase from the Pledge of Allegiance, as well as signifying patriotism.<sup>40</sup> The evidence showed numerous third parties mentioning the phrase in their articles and using it in connection with the sale of their products.<sup>41</sup>
- The mark NO MORE RINOS! for various goods, including bumper stickers, signs and t-shirts, failed to function as a trademark because the evidence showed that consumers were accustomed to seeing this well-known political slogan on these types of goods from a variety of different sources.<sup>42</sup>
- The hypothetical mark KEEP CALM AND FOLLOW JESUS for t-shirts would fail to function as a mark based on evidence that it is a common message of support for a religious sentiment. See the example in [Appendix B](#). For further discussion of wording that references religion but is not a direct quotation, passage, citation see [Part II.A.3.c](#).

### **c. Evidence**

To support the refusal or disclaimer requirement, the evidence of record must be reviewed to determine how the applicant uses the wording in connection with the identified goods/services. Sufficient evidence establishing that the wording is used to either convey the ordinary and well-recognized meaning of the message, or to proclaim support for, affiliation with, or endorsement of the message would support this refusal. Such evidence can include the applicant’s own specimen, advertising, or website. For example, the slogan WHY PAY MORE! was found to be a common advertising slogan and held not to function as a service mark for supermarket services.<sup>43</sup> The specimens clearly showed use as a commonplace advertising message by repeating the WHY PAY MORE wording as follows:

WHY PAY MORE FOR GROCERIES?  
WHY PAY MORE? COME AND GET IT!  
MORE MEAT FOR LESS. WHY PAY MORE?<sup>44</sup>

The size, location, dominance, and significance of the wording as it is used in connection with the goods/services should be considered to determine if any or all of these elements further supports the perception of the wording as a message rather than indicating a single source. For example, evidence of use of the wording in a decorative manner or in a less prominent manner than other clear source identifiers supports a determination that a mark is incapable of identifying a single source.<sup>45</sup>

A search for evidence must also be conducted to show the meaning of the wording, how widespread the use by third parties has become, and the manner of use by third parties.<sup>46</sup>

Research should include a search of dictionaries and encyclopedias to determine if the wording in the proposed mark has a defined meaning or significance, keeping in mind the guidance in [Part I](#). Research should also include searches of the NEXIS<sup>®</sup> database and the Internet for the wording generally and in connection with the identified goods/services. Note that for these types of marks, Internet search results lists can be probative to show the widespread use of the wording if sufficient surrounding text is included, but this must be supplemented with other relevant evidence of public perception. In particular, sources such as online catalogs, retail websites, industry publications, social media websites and marketplace advertising should be reviewed. Some of these sources can provide information on how widespread a message has become (e.g., the number of “likes”, page views, and message forwards on social media websites). The results should be reviewed to determine if there is sufficient evidence of widespread use of the matter by various third

parties. There is no set number of results that will establish that the wording be refused as a commonplace message. The examining attorney should rely on his or her own judgment based on all of the available evidence.

### **3. Religious Texts**

Please leave comments on this section [here](#).

#### **a. Direct Quotations, Passages, and Citations**

Some marks are comprised of direct quotations, passages, or citations from religious texts (e.g., JOHN 3:16 and I AM THE WAY, AND THE TRUTH, AND THE LIFE. NO ONE COMES TO THE FATHER EXCEPT THROUGH ME.). Religious texts are holy books or scriptures, such as the Bible, Quran, Torah, and Diamond Sutra, which the different religions or spiritual movements consider sacred or essential to their religious traditions and beliefs.<sup>47</sup> Such quotations, passages, or citations are often used by the providers of goods/services as an expression of support for, and endorsement of, the ideals or concepts found in the religious texts in which the quotation, passage, or citation originated.<sup>48</sup> This matter is considered an informational message because based on this usage in the marketplace, consumers are thus likely to perceive such wording as indicating the provider's religious affiliation, endorsement, or support for the messages in the texts rather than as source-indicating marks.

Where a quotation, passage, or citation from a religious text serves as an indicator of support and not source, such wording is incapable of indicating source and fails to function as a mark. It should remain in the public domain so that others may use it for similar purposes in connection with their goods/services. The refusal applies regardless if the identification of goods/services is religious in nature. However, the inclusion of religious goods/services further supports this refusal. The following examples illustrate this point:

- Mark is comprised, in its entirety, of a direct quotation/passage and/or citation from a religious text (e.g., ALLAH IS THE LIGHT OF THE HEAVENS AND THE EARTH The Qur'an, Surah An-Nur 24:35; I AM THE WAY, AND THE TRUTH AND THE LIGHT. NO ONE COMES TO THE FATHER EXCEPT THROUGH ME; or MATTHEW 19:26). The entire marks must be refused registration because the matter fails to function as marks.
- Mark is comprised, in part, of a direct quotation/passage and/or citation from a religious text and registrable matter (e.g., NEXT GOD SAID, 'LET THERE BE ANIMALS IN THE WATERS AND BIRDS TO FLY IN THE SKY' and the image of the Earth being held in a pair of hands; ROMANS 8:28 and an image of a teddy bear). The direct quotation/passage and/or citation must be disclaimed because they fail to function as marks.

#### Evidence

To support the refusal or disclaimer requirement, the evidence of record must be reviewed to ascertain the religious origin of the wording, if any. A search for evidence must be conducted to determine both the religious origin and public perception of the wording. A broad Internet search may be performed to see if the wording/citation appears to have a religious origin, and, if so, with which religion it appears to be associated. Additionally, specialized religion-focused websites may be useful for determining if the wording is of religious origin, keeping in mind the research guidance in [Part I](#).

Given the many different translations of religious texts, it is possible that a quotation or passage from one English version of a religious text will have language that is slightly different from the same quotation or passage in a different English translation of the same religious text. If it appears in any version of a religious text, the wording must be treated as religious text. For example:

Bible Version	Translation of Exodus 3:14 <sup>49</sup>
King James Bible	AND GOD SAID UNTO MOSES, I AM THAT I AM: AND HE SAID THUS SHALT THOU SAY UNTO THE CHILDREN OF ISREAL, I AM HATH SENT ME UNTO YOU
New International Version of the Bible	GOD SAID TO MOSES, "I AM WHO I AM. THIS IS WHAT YOU ARE TO SAY TO THE ISRAELITES: 'I AM HAS SENT ME TO YOU'"
Young's Literal Translation of the Bible	AND GOD SAITH UNTO MOSES, 'I AM THAT WHICH I AM;' HE SAITH ALSO, 'THUS DOST THOU SAY TO THE SONS OF ISRAEL, I AM HATH SENT ME UNTO YOU'

**b. Matter from Religious Texts that Has Become Part of Everyday Language**

Some wording from religious texts has become part of common, everyday language and, to many consumers, would have no religious connotation without additional context. Based on the examining attorney’s research, if the evidence indicates that the wording in question has become part of common, everyday language such that the average consumer would be unlikely to perceive the wording as conveying the applicant’s religious affiliation or endorsement, a refusal must not issue based on the wording being from a religious text. Instead, the wording must be analyzed for whether it is a widely used message, as set out in [Part II.A.2](#). The following examples illustrate this point:

- The mark is EYE FOR AN EYE: A review of the first four pages of the results of a search of “eye for an eye” in the Google® search engine shows that some of the hits reference religion, but the strong majority do not directly mention religion. Many of the hits that do not reference religion use the phrase in a discussion of justice. In addition, entering “eye for an eye” into the Cambridge® and Merriam-Webster® online dictionaries returns results referencing justice, but not religion. Together, these results indicate that this wording alone does not generally have a religious connotation without additional context. Absent additional indications of a religious origin, this wording should not be treated as a direct quotation/passage from a religious text. Thus, if the mark is EYE FOR AN EYE for t-shirts or retail store services, a failure-to-function refusal as an incapable informational message should not issue because consumers would likely not view this wording as matter from a religious text indicating the provider’s religious affiliation and endorsement.
- Mark is EVEN THOUGH I WALK THROUGH THE VALLEY OF THE SHADOW OF DEATH, I WILL FEAR NO EVIL: A review of the first four pages of the results of a search of “even though I walk through the valley of the shadow of death, I will fear no evil” in the Google® search engine shows that the vast majority reference religion with only a very few that do not directly mention religion. Of the results that reference religion, most specifically note that the wording is from Bible Psalm 23:4. These results indicate that the wording has ongoing religious connotation even without additional context. Accordingly, this wording should be treated as a direct

quotation/passage from a religious text. Thus, if the mark is EVEN THOUGH I WALK THROUGH THE VALLEY OF THE SHADOW OF DEATH, I WILL FEAR NO EVIL for metal shelter structures or religious instruction services, a failure-to-function refusal based on incapable informational matter should issue because consumers would view this wording as matter from a religious text indicating the provider’s religious affiliation and endorsement.

**c. Wording that References Religion But Is Not a Direct Quotation, Passage, or Citation**

Some marks may comprise of wording that appears to make reference to religious texts, concepts, figures, or citations, but that are not direct quotations, passages, or citations from a religious text. Based on research, if the wording is not a quotation, passage, or citation taken directly from a religious text, then, regardless of the goods/services in the application, the mark should not be examined according to this section. Instead, the mark should be analyzed for whether it conveys support, admiration, sponsorship, or affiliation with a widely used religious message, as set out in [Part II.A.2b](#). The following examples illustrate this point:

- Mark is highly similar, but not identical, to wording that appears in an English translation of the relevant religious text, e.g., I AM BUT WHO I AM is highly similar, but not identical, to several translations of the wording in Exodus 3:14.<sup>50</sup>
- Mark appears to reference religion but does not contain a direct quotation/passage or a correct citation from a religious text, e.g., GOD IS MY CO-PILOT.
- Mark alludes to a religious text but does not contain a direct quotation/passage or correct citation from a religious text, e.g., AUSTIN 3:16, which pays homage to the well-known religious citation “John 3:16”.

**4. Applications Based on Section 1(b), 44, or 66(a)**

Generally, the failure-to-function refusal is a specimen-based refusal.<sup>51</sup> However, if the evidence of record and/or the results of the evidence searches yield a determination that the mark fails to function as a source indicator, the failure-to-function refusal should be issued for applications based on Section 1(b), 44, or 66(a).<sup>52</sup>

**B. Consideration of Additional Refusals**

**Ornamentation:** In certain situations, marks refused as incapable informational matter may also be refused registration as ornamental matter.<sup>53</sup> The evidence of record should be reviewed to determine whether the wording is used in a merely ornamental manner, taking into consideration the size, location, and dominance on the goods or in connection with the services.<sup>54</sup> For more information about this refusal, see TMEP §§1202.03–1202.03(g).

**Descriptiveness:** If the evidence also supports that the mark is merely descriptive or laudatory for the identified goods/services, a refusal under Section 2(e)(1) based on mere descriptiveness must also be issued.<sup>55</sup> For example, merely descriptive and failure-to-function refusals were affirmed for the mark SEMICONDUCTOR LIGHT MATRIX for use with light & UV curing systems.<sup>56</sup> It was held that the mark was merely descriptive because it directly described the technology in the curing systems and failed to function as a trademark because the wording was used on the specimens and evidence of record in a manner that would merely identify the technology used in the curing systems, rather than identify the source of the goods (i.e., “UV Curing Systems Using Semiconductor Light Matrix (SLM) Technology For Optical Storage Media”).<sup>57</sup>

**Likelihood of Confusion:** The guidance provided herein supersedes any previous USPTO guidance on this topic. However, any previously registered marks similar to those described in this guide must still be given protection against potentially confusing marks for the same or related goods/services.<sup>58</sup> For purposes of Section 2(d) analysis, if a previously registered mark is comprised of or includes incapable matter, the mark as a whole must be considered valid and its relative strength determined in light of the circumstances at the time when performing the relevant Section 2(d) analysis.<sup>59</sup>

**III. DISCLAIMER AND DELETION WHERE MARK HAS REGISTRABLE MATTER**

Please leave comments on this section [here](#).

**Disclaimer:** If a mark contains registrable matter, a disclaimer of the incapable informational matter must be required, unless the mark is unitary.<sup>60</sup> Acquired distinctiveness in part as to the incapable mater must not be suggested. See [Part IV](#) for applicant’s response options.

**Mark Deletion:** In limited circumstances, incapable informational matter may be deleted from the drawing but *only if*: the deletion does not result in material alteration of the mark and does not change the mark’s overall commercial impression; the matter to be deleted is separable from the other elements; and there is registrable source-indicating matter to carry the mark.<sup>61</sup>

The following examples illustrate these points:

Mark and Goods/Services	Incapable Matter	Disclaimer Requirement	Deletion from Drawing
HOLDING HANDS NET WEIGHT 6 OZ.  for cookies	NET WEIGHT 6 OZ.	Yes	Allowed as informational matter, per TMEP §807.14(a).
HOLDING HANDS MADE IN USA  for cookies	MADE IN USA	Yes	Consider if deletion constitutes material alteration. Depends on commercial impression of mark upon removal of wording. Consult managing/senior attorney.
HOLDING HANDS PSALM 23  for cookies	PSALM 23	Yes	Not allowed because deletion constitutes material alteration since commercial impression of mark changes upon removal of wording.

**IV. APPLICANT’S RESPONSE OPTIONS**

Please leave comments on this section [here](#).

**Arguments Against Refusal:** Once a prima facie case has been established that the matter is incapable and fails to function as an indicator of the origin of the identified goods/services, the burden shifts to the applicant to show that the wording would be perceived as a mark.<sup>62</sup> To do so, the applicant must provide evidence that the relevant consumers recognize the matter as a source indicator that distinguishes the applicant’s

goods or services from those of others.<sup>63</sup> For example, in reversing the failure-to-function refusal to register TAKE A CLOSER LOOK for banking services, the Board explained that the applicant's response containing advertisements showing the mark used in a trademark manner combined with the lack of evidence that third parties in the banking industry use the wording were sufficient to overcome the refusal.<sup>64</sup>

The more commonplace and widely used the wording is, the more difficult it is to overcome the failure-to-function refusal.<sup>65</sup> Note that mere use of the "TM" or "SM" notation in and of itself cannot transform an unregistrable term into a trademark or service mark.<sup>66</sup> Furthermore, mere claims of long time use or substantial sales and advertising will not obviate the refusal without evidence that public perception of the wording is as a mark.<sup>67</sup>

**Acquired Distinctiveness and Supplemental Register:** A claim of acquired distinctiveness under §2(f) or amendment to the Supplemental Register is not a relevant and proper response to the failure-to-function refusal as incapable matter and does not constitute a new issue. Matter that does not serve to indicate the source or origin of the identified goods/services and distinguish them from those of others is incapable of registration, regardless of claims of acquired distinctiveness or the register on which registration is sought.<sup>68</sup> Accordingly, if a claim or amendment is submitted in response to the refusal, and if there are otherwise no new issues, a final Office action may be issued and must include an explanation that the claim or amendment is not a proper and relevant response to the refusal.<sup>69</sup>

Where a refusal based on ornamentation or descriptiveness is also issued, the customary response options to claim acquired distinctiveness or amend to the Supplemental Register must not be suggested because these amendments will not obviate the refusal that matter is incapable of functioning as a mark. However, if a sufficient claim or amendment is submitted in response to an Office action containing both a failure-to-function refusal as incapable matter and an ornamentation or descriptiveness refusal, the ornamentation or descriptiveness refusal may be withdrawn while the failure-to-function refusal must be maintained in the final Office action, which must include an explanation that the claim or amendment is not a proper or relevant response to that refusal.

**Substitute Specimens or Amending Filing Basis:** The examining attorney should also not suggest that a substitute specimen be submitted or the application be amended to an intent-to-use filing basis. This is because such a mark is incapable of serving as an indicator of the source of the identified goods/services, regardless of the manner of use depicted on the specimens or the filing basis on which applicant relies.<sup>70</sup> As shown in Appendix B, examples [B.2](#), [B.3](#), and [C.3](#), merely responding to the refusal with an otherwise acceptable specimen, such as on a hang tag or shirt label, will not overcome the failure-to-function refusal that the matter is incapable of source indication.<sup>71</sup>

---

<sup>1</sup> See 15 U.S.C. §§1051, 1052, 1053, 1127; *In re Bose Corp.*, 192 USPQ 213, 215 (C.C.P.A. 1976) ("Before there can be registration, there must be a trademark . . ."); *In re Int'l Spike, Inc.*, 196 USPQ 447, 449 (TTAB 1977) ("Registration presupposes the existence of a trademark to be registered."); Trademark Manual of Examining Procedure (TMEP) §1202.

<sup>2</sup> See 15 U.S.C. §§1052, 1127; TMEP §1202.

<sup>3</sup> See, e.g., *In re Bongrain Int'l Corp.*, 894 F.2d 1316, 1317 n.4, 13 USPQ2d 1727, 1728 n.4 (Fed. Cir. 1990) ("If a mark is generic, incapable of serving as a means by which the goods of the applicant may be distinguished from the goods of others'... it is not a trademark and cannot be registered under the Lanham Act."); see also *In re Melville Corp.*, 228 USPQ 970, 972 (TTAB 1986) (finding BRAND NAMES FOR LESS, for retail store services in the clothing field, "should remain available for other persons or firms to use to describe the nature of their competitive services."); TMEP §1212.02(i).

<sup>4</sup> See *In re Eagle Crest Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010).

<sup>5</sup> See *In re Bose Corp.*, 192 USPQ 213, 216 (C.C.P.A. 1976); *In re Aerospace Optics, Inc.*, 78 USPQ2d 1861, 1863-64 (TTAB 2006).

---

<sup>6</sup> See 37 C.F.R. 2.61(b); TMEP §814.

<sup>7</sup> See TMEP §814.

<sup>8</sup> See TMEP §710.02.

<sup>9</sup> *In re Bose Corp.*, 192 USPQ 213, 215 (C.C.P.A. 1976) (citation and footnote omitted).

<sup>10</sup> See 15 U.S.C. §§1051, 1052, 1053, 1127; *In re Bose Corp.*, 192 USPQ at 215; *In re Int'l Spike, Inc.*, 196 USPQ at 449; TMEP §1202.

<sup>11</sup> See *In re Eagle Crest, Inc.*, 96 USPQ2d at 1229; *In re Vertex Grp., LLC*, 89 USPQ2d 1694, 1701 (TTAB 2009) (“As is the case with any trademark, mere intent that a word, name, symbol or device function as a trademark or service mark is not enough in and of itself.”).

<sup>12</sup> See *In re Eagle Crest, Inc.*, 96 USPQ2d at 1229; *Am. Velcro, Inc. v. Charles Mayer Studios, Inc.*, 177 USPQ 149, 154 (TTAB 1973).

<sup>13</sup> See *In re Eagle Crest, Inc.*, 96 USPQ2d at 1229.

<sup>14</sup> See *In re AOP LLC*, 107 USPQ2d 1644, 1655 (TTAB 2013) (finding AOP merely informational and not source-identifying for wine as it informs consumers of a certification process); *In re T.S. Designs, Inc.*, 95 USPQ2d 1669 (TTAB 2010) (holding CLOTHING FACTS merely an informational phrase and not a source identifier based on the likely consumer perception of the phrase used on a clothing label in connection with manufacturing information reminiscent of the “Nutrition Facts” label required for food products by the United States Food and Drug Administration); *In re Melville Corp.*, 228 USPQ 970 (BRAND NAMES FOR LESS found to be informational phrase that does not function as a mark for retail store services because it informs consumers that applicant sells brand name products for less than other retail stores).

<sup>15</sup> See *In re Volvo Cars of N. Am., Inc.*, 46 USPQ2d 1455 (TTAB 1998) (holding DRIVE SAFELY merely an informational phrase or slogan that would be perceived as an everyday, commonplace safety admonition that does not function as mark); *In re Manco Inc.*, 24 USPQ2d 1938 (TTAB 1992) (holding THINK GREEN and design for weather stripping and paper products “merely an informational slogan devoid of trademark significance”); *In re Remington Prods., Inc.*, 3 USPQ2d 1714 (TTAB 1987) (holding PROUDLY MADE IN USA, for electric shavers, merely an informational slogan that is incapable of functioning as a mark, notwithstanding use of letters “TM” in connection with prominent display of slogan on packages for the goods and claim of acquired distinctiveness); *In re Eagle Crest, Inc.*, 96 USPQ2d at 1230 (holding ONCE A MARINE, ALWAYS A MARINE to be an “old and familiar Marine expression . . . that should remain free for all to use”); *In re Michael Sones*, Ser. No. 78717427, 2012 TTAB LEXIS 146 (TTAB Apr. 20, 2012) [not precedential] (holding ONE NATION UNDER GOD as used in connection with charity bracelets merely gives information about the goods).

<sup>16</sup> See *In re Standard Oil Co.*, 275 F.2d 945, 125 USPQ 227, 229 (C.C.P.A. 1960).

<sup>17</sup> See *In re T.S. Designs, Inc.*, 95 USPQ2d at 1670.

<sup>18</sup> See *In re AOP LLC*, 107 USPQ2d at 1655.

<sup>19</sup> See *In re Innovation Ventures, LLC*, Ser. No. 85637294, 2014 TTAB LEXIS 126 \*16 (March 25, 2014) [not precedential].

<sup>20</sup> See *Id.*; *In re Prema Jyothi Light*, Ser. No. 76293326, 2016 U.S. App. LEXIS 18226 at \*11 (Fed. Cir. Oct. 7, 2016) [not precedential].

<sup>21</sup> *In re Schwauss*, 217 USPQ 361, 362 (TTAB 1983) (finding FRAGILE for labels and bumper stickers merely informational and devoid of any source-identifying function).

<sup>22</sup> *Id.*

<sup>23</sup> *In re Aerospace Optics, Inc.*, 78 USPQ2d 1861 (TTAB 2006) (holding SPECTRUM fails to function as a mark for illuminated pushbutton switches, where the mark is used in a manner that merely informs potential purchasers of the multiple color feature of the goods, and the coloring and font in which the mark is displayed are not sufficient to imbue the term with source-identifying significance or to set it apart from other informational wording).

<sup>24</sup> *In re Standard Oil Co.*, 125 USPQ 227 (GUARANTEED STARTING found to be ordinary words that convey information about the services, not a service mark for the services of “winterizing” motor vehicles).

<sup>25</sup> *Cf. In re C.R. Anthony Co.*, 3 USPQ2d 1894 (TTAB 1987) (“[I]n every exhibit submitted by applicant to illustrate use of ‘PART OF THE BARGAIN’, that four-word phrase, whether written small or large, forms part of a longer sentence or phrase. Stating the point differently, applicant has offered no evidence that ‘PART OF THE BARGAIN’ is used, alone, as a slogan in the advertisement of applicant’s retail department store services.”); *In re Compagnie Nationale Air France*, 121 USPQ 460 (C.C.P.A. 1959) (“Nothing in the advertisement pertaining to the ‘Sky-Room’ identifies the air transportation service of appellant and there is no other evidence which reveals that the public considers ‘Sky-Room’ as an identifying mark of this airline. In our opinion, the advertisement, taken as a whole, indicates that ‘Sky-Room’ is used to connote a particular type of accommodation, regardless of who provides it, rather than to distinguish any service provided by appellant from similar services provided by others.”); *In re Paris Medicine Co.*, 32 USPQ 189 (C.C.P.A. 1937) (“[I]t is not shown that the term ‘Tasteless Chill Tonic,’ standing alone, was ever used in a trade-mark sense, but only as descriptive of the goods to which the term was applied. There is no evidence that the term ‘Tasteless Chill Tonic,’ standing alone, was ever used by appellant, but on the contrary the specimen shows that the term used was ‘Grove’s Tasteless Chill Tonic,’ and we agree with the commissioner that it was the word ‘Grove’s’ that indicated to purchasers the origin or source of manufacture of the goods upon which the label was applied, and not the term ‘Tasteless Chill Tonic.’”).

<sup>26</sup> See *In re Eagle Crest, Inc.*, 96 USPQ2d at 1229-1230.

<sup>27</sup> *In re Standard Oil Co.*, 125 USPQ 227, 229 (CCPA 1960); see also *America Online, Inc. v. AT & T Corp.*, 57 USPQ2d 1902, 1910 (4th Cir. 2001) (“You Have Mail” used in common sense to announce that the user has email);

---

*Cosmetically Sealed Indus. Inc. v. Chesebrough-Pond's USA Co.*, 43 USPQ2d 1956, 1958 (2d Cir. 1997) (“[T]he challenged phrase ‘Seal it with a Kiss’ (with or without the two exclamation points) is a clear instance of a non-trademark use of words.... The [plaintiff’s] phrase ‘sealed with a kiss’ is a fixture of the language....”).

<sup>28</sup> *In re Eagle Crest*, 96 USPQ2d at 1229-30 (noting that “[a]s a matter of competitive policy, it should be close to impossible for one competitor to achieve exclusive rights’ in common phrases or slogans.” (quoting J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §7.23 (4th ed. 2010))).

<sup>29</sup> *Id.* at 1230.

<sup>30</sup> *In re Eagle Crest, Inc.*, 96 USPQ2d at 1230 (noting that “[a]s a matter of competitive policy, it should be close to impossible for one competitor to achieve exclusive rights’ in common phrases or slogans.” (quoting J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §7.23 (4th ed. 2010))).

<sup>31</sup> See *In re Melville Corp.*, 228 USPQ at 971 (In holding BRAND NAMES FOR LESS failed to function as a mark, evidence of widespread use of similar marketing phrases was acceptable evidence the wording did not indicate source. The Board stated “[t]he fact that applicant may convey similar information in a slightly different way that others is not determinative.”); See also *D.C. One Wholesaler, Inc.*, 2016 TTAB LEXIS at \*14 (The Board noted that the informational significance of the mark was “reinforced by the fact that similar expressions in the form of “I ♥\_\_” have also been widely used to express such enthusiasms with respect to other places and things.”).

<sup>32</sup> See [Appendix B, Subpart C](#), Example 2.

<sup>33</sup> See *D.C. One Wholesaler, Inc. v. Chien*, \_\_\_ USPQ2d \_\_\_, Opp’n No. 91199035 & Canc. No. 92053919, 2016 TTAB LEXIS 508 at \*14–15 (Oct. 4, 2016) (holding I ♥ DC failed to function as a mark for clothing items because it would be perceived as an expression of enthusiasm for the city and not as a source indicator).

<sup>34</sup> *In re Volvo Cars of N. Am., Inc.*, 46 USPQ2d 1455 (holding DRIVE SAFELY merely an incapable phrase or slogan that would be perceived as an everyday, commonplace safety admonition that does not function as mark).

<sup>35</sup> *In re Manco Inc.*, 24 USPQ2d at 1942 (holding THINK GREEN and design for weather-stripping and paper products “merely an informational slogan devoid of trademark significance”).

<sup>36</sup> *In re Remington Prods., Inc.*, 3 USPQ2d at 1714–15.

<sup>37</sup> See *In re Eagle Crest, Inc.*, 96 USPQ2d at 1230.

<sup>38</sup> *Id.* at 1229 (internal citation omitted); See also *D.C. One Wholesaler, Inc.* 2016 TTAB LEXIS at \*15 (In holding the mark I ♥ DC failed to function as a mark for clothing items, the Board found that the mark would be perceived as an “expression of enthusiasm for the city of Washington, DC” and not “as an indicator of source of the goods on which it appears.”).

<sup>39</sup> *Id.*

<sup>40</sup> *In re Michael Sones*, Ser. No. 78717427, 2012 TTAB LEXIS 146 (Apr. 20, 2012) [not precedential].

<sup>41</sup> *Id.* at \*11,\*17

<sup>42</sup> *In re Hulting*, 107 USPQ2d at 1179.

<sup>43</sup> *In re Wakefern Food Corp.*, 222 USPQ2d 77, 78 (TTAB 1984) (finding the relatively common merchandising slogan WHY PAY MORE! does not function as a mark which identifies and distinguishes applicant’s services from others).

<sup>44</sup> *Id.*

<sup>45</sup> *In re Hulting*, 107 USPQ2d 1175, 1178–79 (TTAB 2013); See also *D.C. One Wholesaler, Inc. v. Chien*, \_\_\_ USPQ2d \_\_\_, Opp’n No. 91199035, & Canc. No. 92053919, 2016 TTAB LEXIS 508 at \*15 (Oct. 4, 2016) (The Board noted that the marketplace is inundated with products featuring the wording “as a prominent ornamental feature of such goods, in such a way that the display itself is an important component of the product and customers purchase the product precisely because it is ornamented with a display of the term in an informational manner, not associated with a particular source.”); *In re J. Hungerford Smith Co.*, 126 USPQ 372, 373 (C.C.P.A. 1960) (use of the wording BURGUNDY in a non-trademark manner along with use of other source identifiers on the specimens supported finding that wording is descriptive and has not acquired secondary meaning).

<sup>46</sup> *Id.* at \*14-15 (Oct. 4, 2016) (In holding the mark I ♥ DC failed to function as a mark for clothing items, the Board stated that the evidence shows that the wording “has been widely used, over a long period of time and by a large number of merchandisers as an expression of enthusiasm, affection or affiliation with respect to the city of Washington, D.C.”).

<sup>47</sup> Encyclopedia Britannica, <http://www.britannica.com/topic/scripture> (last visited October 12, 2016); Wikipedia, [https://en.wikipedia.org/wiki/Religious\\_text](https://en.wikipedia.org/wiki/Religious_text) (last visited October 12, 2016); Webster’s Dictionary, <http://www.webster-dictionary.org/definition/religious%20text> (last visited October 12, 2016)

<sup>48</sup> Danny Johnston, *At Christian Companies, Religious Principles Complement Business Practices*, THE NEW YORK TIMES, Aug. 2, 2013, at A14; Deborah Kolben, *Evangelism in Fashion*, THE NEW YORK SUN, Aug. 18, 2006, <http://www.nysun.com/new-york/evangelism-in-fashion/38174/>; Wilmaladia, *John 3:16 Bible Verses on bags at Forever 21*, Society (August 10, 2011), <http://www.christiantoday.com/article/bible-verses.on.bags.at.forever.21/28408.htm>.

<sup>49</sup> Translations of *Exodus 3:14*, BibleHub, <http://biblehub.com/exodus/3-14.htm> (last visited October 10, 2016).

<sup>50</sup> *Id.*

<sup>51</sup> TMEP §1202.

<sup>52</sup> See TMEP §1202; *cf. In re Right-On Co.*, 87 USPQ2d 1152, 1157 (TTAB 2008) (noting that, with respect to §66(a) applications, “it is appropriate for examining attorneys to issue an ornamentation refusal if the mark is decorative or ornamental on its face as depicted on the drawing page and described in the description of the mark”).

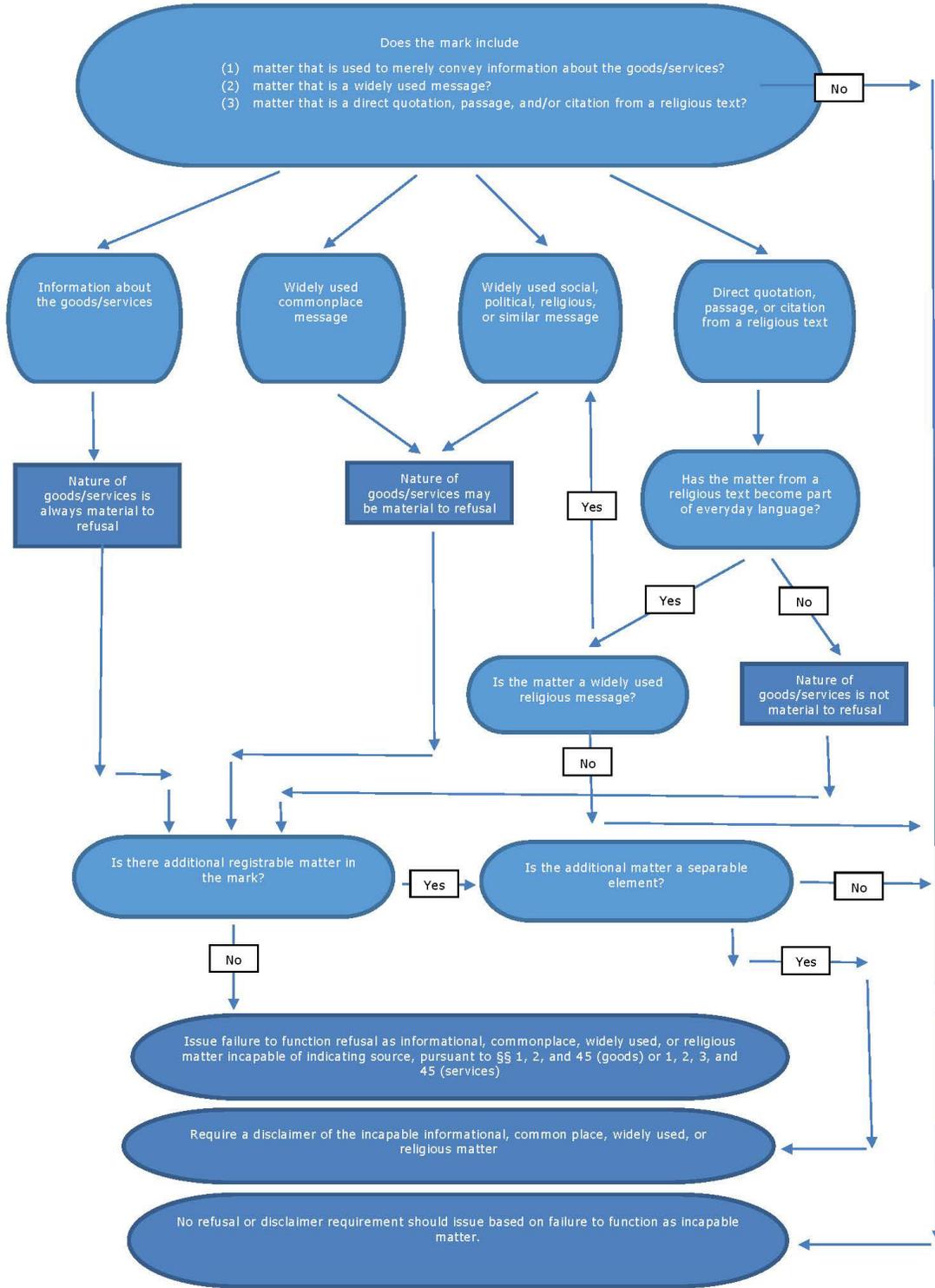
- 
- <sup>53</sup> See *In re Hulting* 107 USPQ2d at 1181 (refused registration on the ground that the mark is merely ornamental and informational matter); TMEP §1202.03(f)(i).
- <sup>54</sup> See *In re Hulting* 107 USPQ2d at 1178-79; TMEP §1202.03(a).
- <sup>55</sup> See *In re Boston Beer Co. L.P.*, 53 USPQ2d 1056 (holding that THE BEST BEER IN AMERICA is so highly laudatory and descriptive as applied to beer and ale that it is incapable of acquiring distinctiveness); *In re Phoseon Tech. Inc.*, 103 USPQ2d 1822 (TTAB 2012) (Finding SEMICONDUCTOR LIGHT MATRIX merely describes the technology used in the goods and fails to function as a trademark because the use of the wording on the specimens and evidence of record was merely to identify the technology); TMEP §§1209.03(k), 1209.03(s).
- <sup>56</sup> *In re Phoseon Tech. Inc.*, 103 USPQ2d 1822 (TTAB 2012).
- <sup>57</sup> *Id.* at 1826-28.
- <sup>58</sup> TMEP §§1207.01(b)(ix), 1207.01(d)(iii).
- <sup>59</sup> TMEP §1207.01(d)(iii).
- <sup>60</sup> See Trademark Act Section 6(a), 15. U.S.C. §1056(a); TMEP §§1213, 1213.01(b), 1213.02, 1213.05, 1213.03(a), 1213.03(b).
- <sup>61</sup> See TMEP §§807.14–807.14(a).
- <sup>62</sup> See *In re Tilcon Warren, Inc.*, 221 USPQ 86, 88 (TTAB 1984).
- <sup>63</sup> See *In re Remington Prods., Inc.*, 3 USPQ2d at 1715; See also *Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34 (C.C.P.A. 1970) (affirming the Board's dismissal of an opposition to the registration of HAIR COLOR SO NATURAL ONLY HER HAIRDRESSER KNOWS FOR SURE for hair coloring preparation since the evidence including use of the slogan as a trademark, exclusive use for several years and extensive advertising expenditures, showed the slogan functioned as a mark); *In re The Hallicrafters Co.*, 153 USPQ 376 (TTAB 1967) (reversing the refusal to register where QUALITY THROUGH CRAFTSMANSHIP for radio equipment functioned as a mark because applicant used the slogan in the manner of a trademark on the goods and extensively advertised the slogan and the examiner failed to show others using the wording).
- <sup>64</sup> *In re First Union Nat'l Bank*, 223 USPQ 278, 280 (TTAB 1984).
- <sup>65</sup> *In re Eagle Crest*, 96 USPQ2d at 30 (noting that "[a]s a matter of competitive policy, it should be close to impossible for one competitor to achieve exclusive rights' in common phrases or slogans." (quoting J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition §7.23 (4th ed. 2010)))
- <sup>66</sup> See *In re Volvo Cars*, 46 USPQ2d at 1461; TMEP §1202.04.
- <sup>67</sup> See *In re Tilcon Warren, Inc.*, 221 USPQ at 88; *In re Wakefern Food Corp.*, 222 USPQ at 79; *In re Remington Prods., Inc.*, 3 USPQ2d at 1715.
- <sup>68</sup> See *In re Eagle Crest*, 96 USPQ2d at 1229 (noting that "[s]logans and other terms that are considered to be merely informational in nature, or to be common laudatory phrases or statements that would ordinarily be used in business or in the particular trade or industry, are not registrable"); *In re Remington Prods., Inc.*, 3 USPQ2d at 1715 (In affirming a failure-to-function refusal and denying a claim of acquired distinctiveness for the mark PROUDLY MADE IN THE USA for electric shavers and parts thereof, the Board stated that although the applicant has "substantial sales and advertising of its product, that does not provide recognition by the public of the subject slogan as a trademark."); *In re Prema Jyothi Light, Ser. No. 76293326*, 2016 U.S. App. LEXIS 18226 at \*11 (Fed. Cir. Oct. 7, 2016)[not precedential] (The Board affirmed the failure-to-function refusal and denied a claim of acquired distinctiveness stating acquired distinctiveness cannot be found where a mark has not been promoted as a trademark); *D.C. One Wholesaler, Inc. v. Chien*, \_\_\_ USPQ2d \_\_\_, Opp'n No. 91199035, & Canc. No. 92053919, 2016 TTAB LEXIS 508 (Oct. 4, 2016) (cancelling a registration on the Supplemental Register because the mark failed to function as a trademark); TMEP §§1202.04, 1212.02(i).
- <sup>69</sup> See TMEP §714.05(a)(i).
- <sup>70</sup> See TMEP §904.07(b).
- <sup>71</sup> See *D.C. One Wholesaler, Inc. v. Chien*, 2016 TTAB LEXIS at \*16 (In finding the mark failed to function as a mark the Board noted that "it does not create the commercial impression of a source indicator, even when displayed on a hangtag or label.").



Draft – 1/19/2017

Draft – 1/19/2017

# Appendix A





# Appendix B

## A. Information About the Goods/services

### 1. *In re T.S. Designs, Inc.*, 95 USPQ2d 1669 (TTAB 2010)

**Mark:** CLOTHING FACTS

**Goods/Services:** Long-sleeved shirts; Polo shirts; Short-sleeved shirts; T-shirts, in International Class 25.

**Analysis:** Affirmed failure-to-function refusal as merely informational. The Board stated that prospective consumers would view the mark, as used on the entire label device, as informational matter, not as a source identifier for the shirts. The likelihood that consumers would perceive the mark as informational matter was enhanced because the label contained two clear source identifiers, specifically "tsdesigns.com" and "printing t-shirts for good," with the latter specifically bearing the informal "TM" designation, while the mark CLOTHING FACTS did not. Although the inclusion of the "TM" designation in and of itself does not make an otherwise unregistrable word a trademark, the inclusion of TM next to "printing t-shirts for good" reinforced the trademark significance of that portion of the label.

### Specimen and Applicant's Evidence of Use:

Clothing Facts	
Amount Per Shirt	
% Daily Values	
Sweatshop Labor	0%
Pesticides Used	0%
Plastic Prints	0%
Harsh Resins	0%
Certified Organic Cotton	100%
Water Based Inks	100%

tsdesigns.com  
printing t-shirts for good™  
©2007



**2. *In re Innovation Ventures, LLC, U.S. Application Serial No. 85637294 (TTAB 2014) (Non-Precedential)***

**Mark:** HOURS OF ENERGY NOW

**Goods/Services:** Dietary supplements, in International Class 5; non-alcoholic liquids for human consumption, namely, energy shots, in International Class 32.

**Analysis:** Affirmed failure-to-function refusal. The Board held that the mark, as actually used by the applicant, merely informed prospective purchasers that applicant's products provide an immediate boost of energy upon consumption and that the increased levels of energy last for several hours. Because the proposed mark would be perceived as merely touting the fast-acting and long-lasting qualities of the product, and not identifying its source of origin, the slogan was incapable of functioning as a trademark.

**Specimen:**



Evidence:

The screenshot shows the Advantage Vitamin Health & Body website. At the top, there are contact numbers for Mail Order Hotline (800) 328-1022 and Fax Line (760) 961-7373. A search bar is located at the top right. Below the header, there are navigation links for various product categories like Vitamins, Supplements, and Sports Nutrition. The main content area features a product listing for '5-hour ENERGY decaf \* Hours of energy now \* No Crash later 2 oz' priced at \$2.89. A red arrow points to the 'Hours of energy now' text in the product title. To the right of the product listing, there are sections for 'Manufacturer Info', 'Notifications', and 'Tell A Friend'.

The screenshot shows the Amazon.com product page for '5-Hour Energy Extra Strength (24 Bottles Berry)'. The product is listed by Chaser with a 4.5-star rating from 23 customer reviews. The price is \$50.99 (\$0.80 / oz) with free shipping. A red arrow points to the 'Hours of Energy Now' feature in the product description. The page includes a 'Frequently Bought Together' section at the bottom, showing three bottles of the product for a total price of \$130.64. The Amazon header features the 'Off to College' promotion and various navigation options like 'Shop by Department', 'Search', and 'Hello, Sign in Your Account'.

## B. Widely Used Commonplace Messages

### 1. *In re Manco Inc.* 24 USPQ2d 1938 (TTAB 1992)

**Marks:** THINK GREEN (Ser. Nos. 74020187 and 74020235) and THINK GREEN and design (Ser. Nos. 74020176 and 74020199)



**Goods/Services:** Mailing and shipping cardboard boxes, padded envelopes, photo mailers, wrapping paper, tissue paper, paper labels, and adhesive tape for household use, in International Class 16; and weather-stripping, namely, plastic and rubber foam tapes, door seals, window seals, plastic storm window kits, plastic air conditioner covers, rubber and plastic caulk and insulating tapes, in International Class 17.

**Analysis:** Affirmed failure-to-function refusal. The Board stated that the mark would be viewed as an informational slogan conveying the need for environmental sensitivity and/or ecological concern.

**Evidence:** Excerpts from several Nexis® articles including:

- P3 (the name is code for Earth, the third planet from the sun) appears six times yearly and aims to engage and inform readers from ages 6 to 12 on environmental issues -- the dwindling supply of fossil fuels, for example. . . . -- People , May 27, 1991, Section EARTH, at 54 (containing an article headlined: "FOR PRETEENS WHO **THINK GREEN**; Two Vermont editors create an environmental magazine for kids");
- PETER JENNINGS: . . . On the American Agenda tonight, the environment: business learning to **think green** . . . . -- ABC News , May 22, 1991 (broadcast of television show: World News Tonight with Peter Jennings); and
- Stars of show business -- and show-business businesses -- joined forces Thursday in urging ad agencies to **think green**. At a luncheon in New York, celebrities and execs associated with Time Warner Inc. announced "The Environmental Challenge." The contest, by Time magazine, asks agencies to create ads on environmental themes. -- USA Today, April 20, 1990, Section MONEY, at 28.

## 2. Application Serial No. 86160320 (Abandoned)

**Mark:** BEST. DAD. EVER.

**Goods/Services:** Clothing for men, women and children, namely, shirts, t-shirts, sweatshirts, hooded sweatshirts, pants, jeans, shorts, tops, vests, headbands, visors, wrist bands, boxer briefs, pajamas and one-piece garments for children, in International Class 25.

**Analysis:** Abandoned for failure to respond to the Office action. Registration was refused because the mark failed to function as a trademark based on evidence that the mark is a phrase commonly used by third parties as a promotional or decorative/ornamental element on goods. The specimen included a shirt label showing the mark used on the identified goods, which would otherwise be acceptable to show trademark use for the goods. Because the mark was deemed informational, it was incapable of functioning as a source indicator for these goods regardless of the specimen.

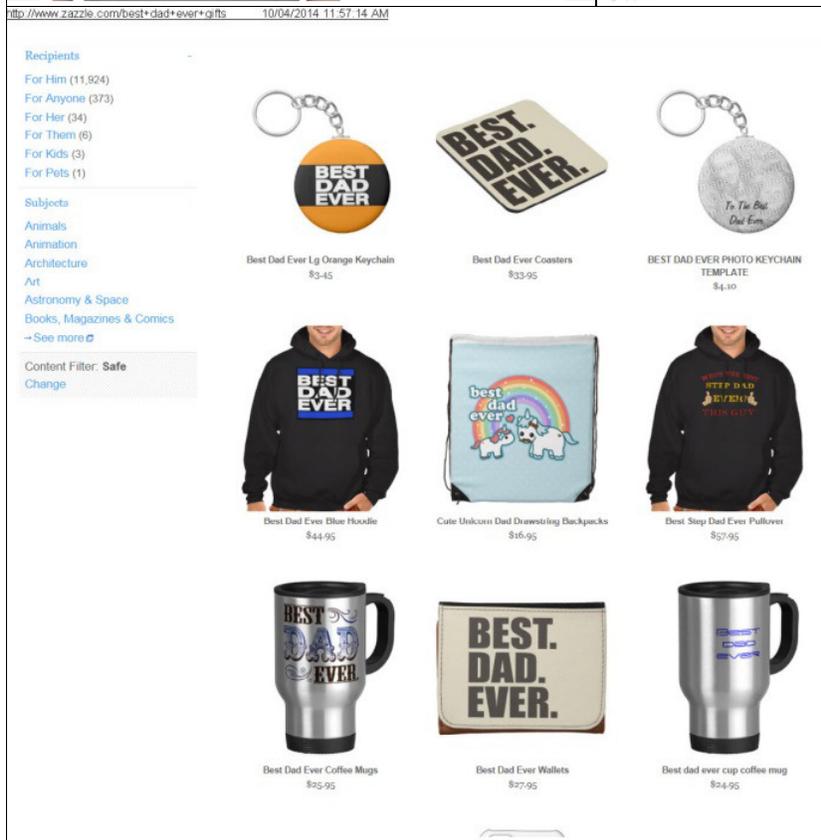
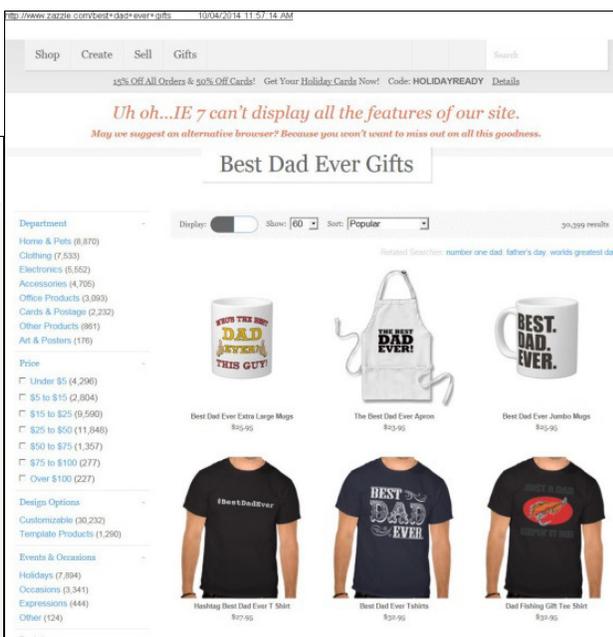
### Specimens:



The screenshot shows an Amazon product listing for a black t-shirt. The main image shows the t-shirt with the text "Best. Dad. Ever." printed in a white, serif font. To the right of the image, the product title is "Best. Dad. Ever. Mens T-shirt, Father's Day Best Dad Ever Men's Tee Shirt". Below the title is a star rating of 4.5 stars and "35 customer reviews". The price is listed as "\$13.15". The size is set to "Medium" with a "Sizing info" link. The color is "Black", and there are several color swatches shown below. A button labeled "Add to Collection" is visible. Below the product information, it says "In Stock." and "Ships from and sold by UltraD INC." with a note "UltraD Inc. exclusive drip font".



Evidence:



**3. D.C. One Wholesaler, Inc. v. Chien, \_\_\_ USPQ2d \_\_\_, Opp'n No. 91199035, & Canc. No. 92053919, 2016 TTAB LEXIS 508 (Oct. 4, 2016)**

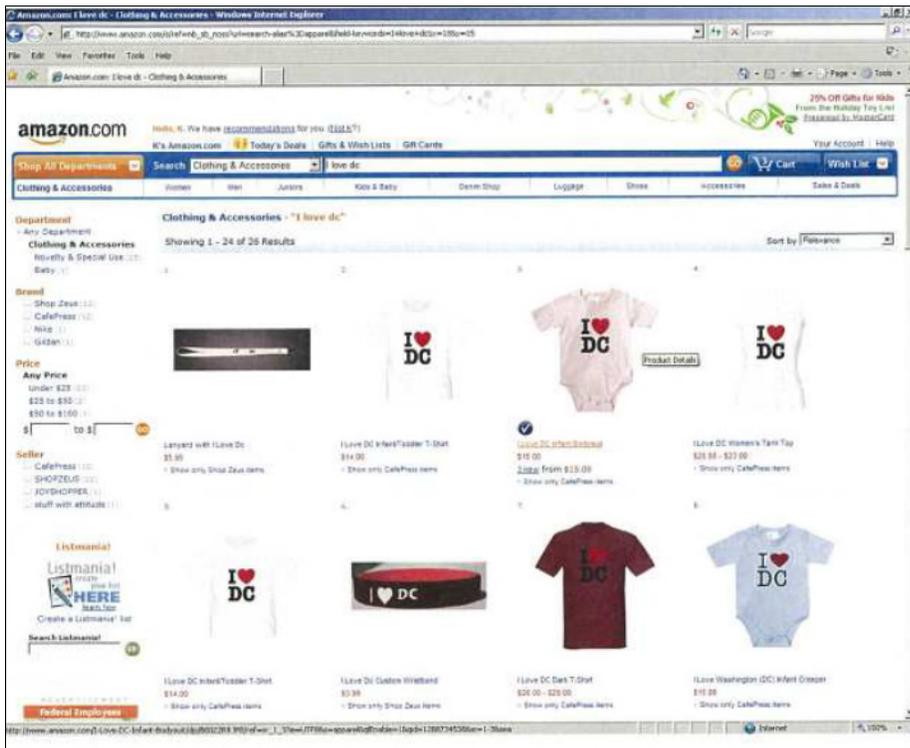


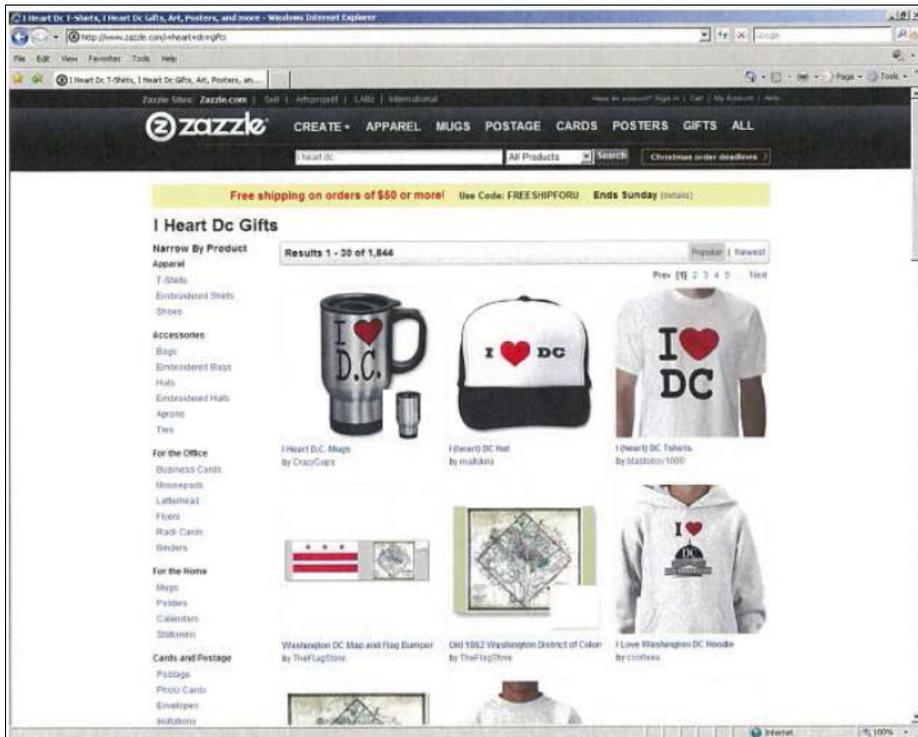
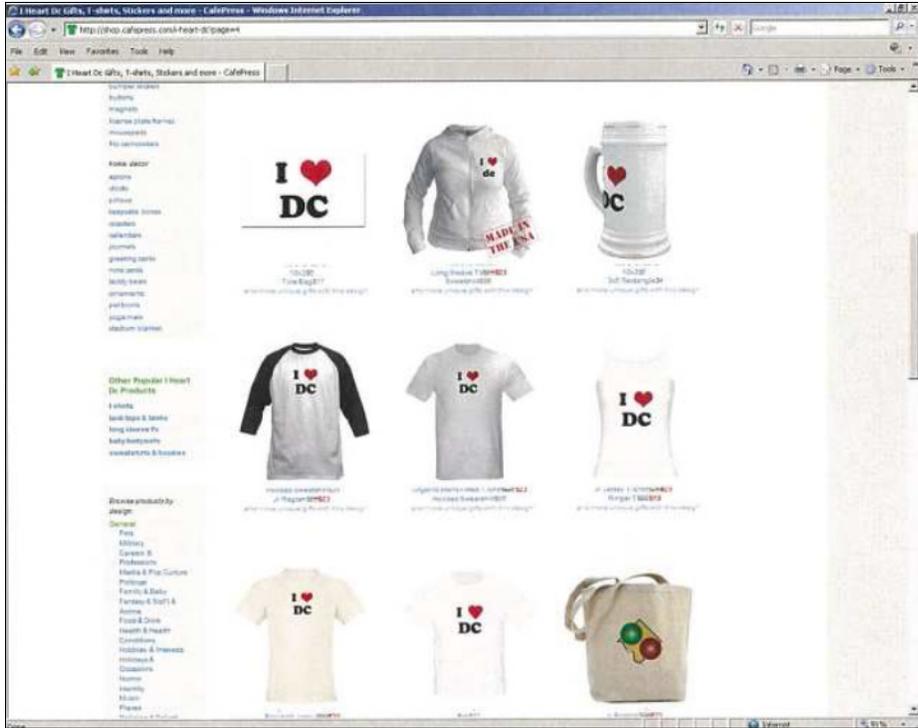
**Goods/Services:** Variety of bags, clothing items, and toys in International Classes 18, 25, and 28.

**Analysis:** Affirmed failure to function refusal as merely informational. The Board stated that, in the relevant fields, “I ♥ DC” has been widely used, over a long time, by a large number of merchandisers, as an expression of enthusiasm for the city of Washington, D.C. Furthermore, the significance as an expression of enthusiasm is reinforced by the fact that similar expressions featuring the “I ♥ \_\_\_” format are widely used on similar merchandise to express enthusiasm for other places and things. The Board stated that because of the widespread use as a prominent ornamental feature of these types of goods, consumers purchase the goods because of the ornamental display of the phrase, viewing it as an expression of enthusiasm not associated with a particular source. The Board further stated that because of the informational nature and widespread use of the phrase “I ♥ DC” such phrase does not create the commercial impression of a source indicator, even if displayed on a hangtag or label.

**Evidence:**

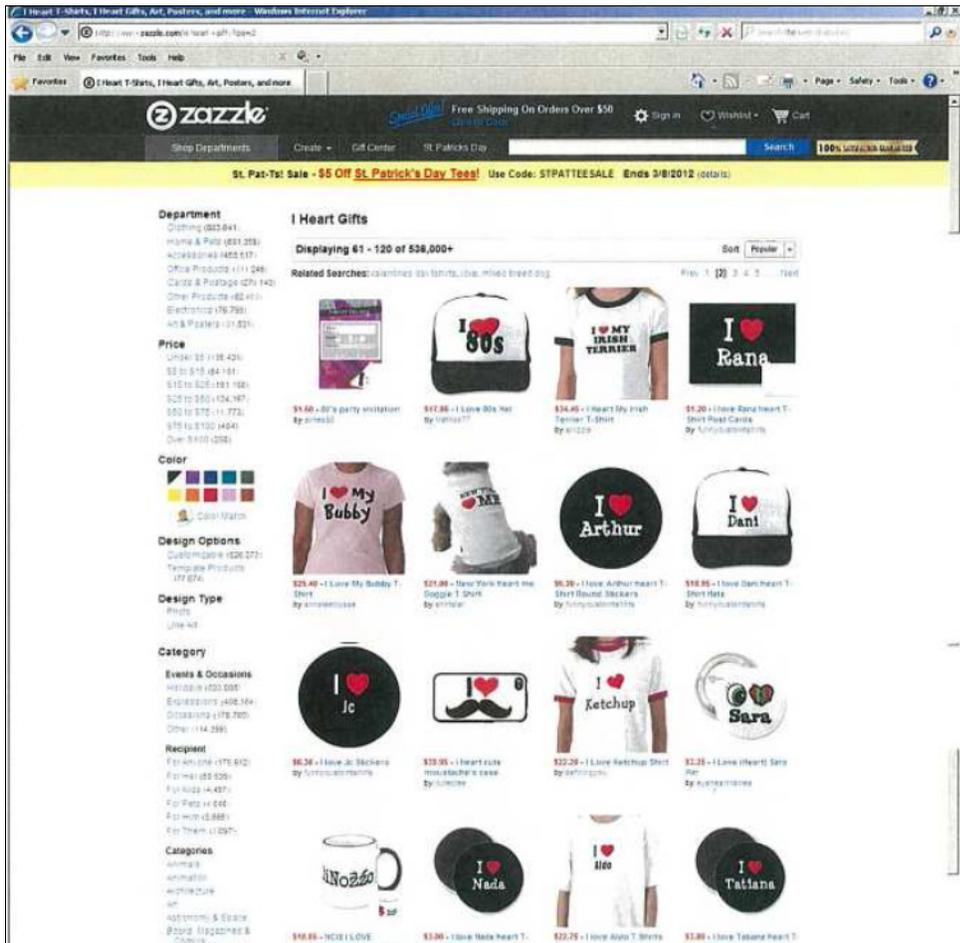
- Petitioner demonstrated apparel, mugs, commuter cups, carry-bags, teddy bears, aprons, keychains and other types of merchandise bearing a prominent display of the phrase are available from a variety of sources;





- Testimony of third party retailers that they have purchased the goods from a variety of sources;

- Examples showing merchandise bearing phrase “I ♥ [insert designation]” phrase are common in the souvenir industry;



**Specimens:**



### C. Widely Used Social, Political, Religious or Similar Messages

#### 1. *In re Eagle Crest, Inc., 96 USPQ2d 1227 (TTAB 2010)*

**Mark:** ONCE A MARINE, ALWAYS A MARINE

**Goods/Services:** Various clothing items in International Class 25.

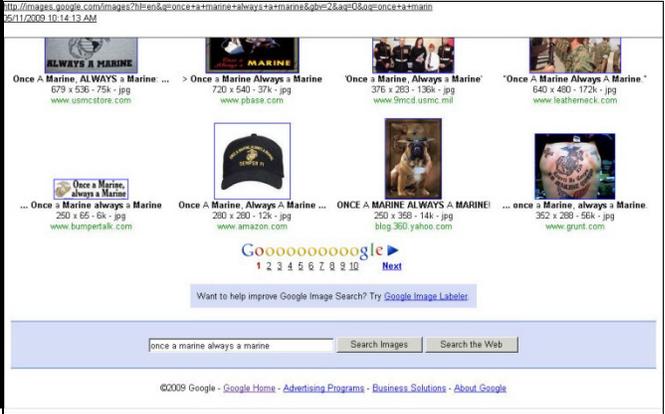
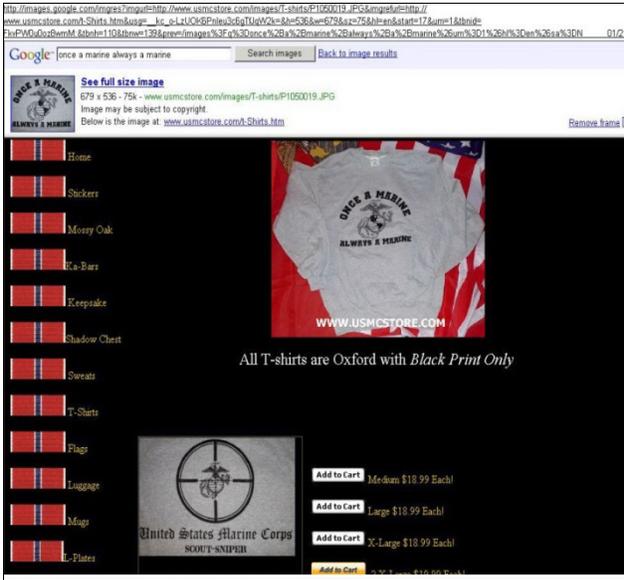
**Analysis:** Affirmed failure-to-function refusal as merely informational. The Board stated that the mark was an old and familiar Marine expression often used to convey support, admiration, or affiliation with the Marines, and because consumers are accustomed to seeing the phrase displayed on clothing items from many different sources, consumers would not view the slogan as a trademark indicating only the applicant as the source of the clothing. The Board further noted that because clothing imprinted with the mark would be purchased by consumers for the message it conveyed, the applicant was not entitled to appropriate the slogan and thereby attempt to prevent competitors from using it to promote the sale of their own clothing.

**Evidence:**

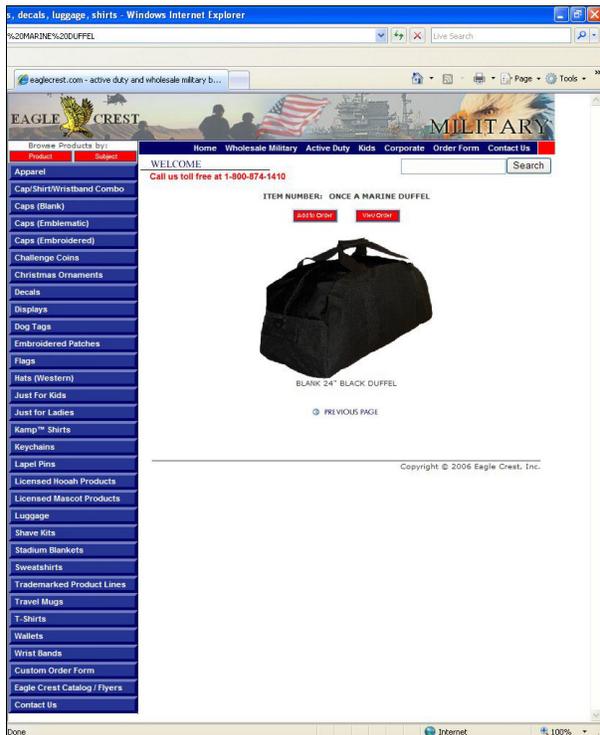
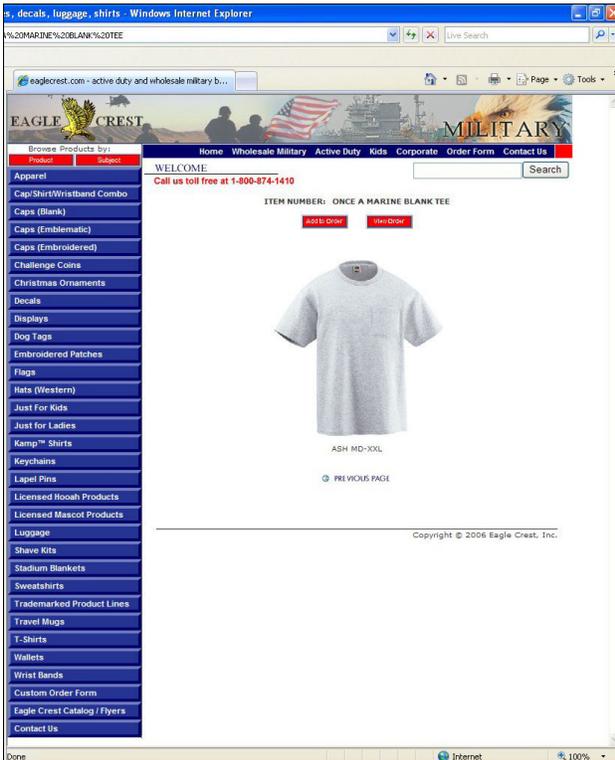
- Nearly three million hits using the Google® search engine for ONCE A MARINE, ALWAYS A MARINE;



- Several websites showing decorative and informational use of ONCE A MARINE, ALWAYS A MARINE on t-shirts, and other goods, such as bumper stickers, caps, sweatshirts, hoodies, posters, and calendars;



- Applicant submitted pages from their website showing the mark along with eight other military or patriotic messages that the consumer may choose for imprinting on clothing; and



- Applicant submitted this page from their website that the Board found useful:



**Specimens:**



## 2. Application Serial No. 85503818 (Abandoned)

**Mark:** OCCUPY CONGRESS

**Goods/Services:** Imprinting messages on T-shirts, in International Class 40.

**Analysis:** Abandoned for failure to respond to the Office action. Registration was refused because the mark failed to function as a service mark because it was merely informational based on evidence that the mark is a widely used message used in a nationally recognized political movement.

**Specimen:** None – §1(b) application

### Evidence:

The screenshot shows the Wikipedia article for "Occupy movement" as of February 25, 2012. The article text reads: "The **Occupy movement** is an international protest movement which is primarily directed against economic and social inequality.<sup>[7][8]</sup> The first Occupy protest to receive wide coverage was Occupy Wall Street in New York City's Zuccotti Park, which began on September 17, 2011. By October 9, Occupy protests had taken place or were ongoing in over 95 cities across 62 countries, and over 600 communities in the United States.<sup>[9][10][11][12][13]</sup> Occupy Wall Street was initiated by the Canadian activist group Adbusters,<sup>[14][15]</sup> and partly inspired by the Arab Spring,<sup>[17][18]</sup> especially Cairo's Tahrir Square protests, and the Spanish Indignants.<sup>[19][20][21]</sup> The movement commonly uses the slogan *We are the 99%*, the #Occupy hashtag format, and organizes through websites such as "Occupy Together".<sup>[22]</sup> According to the *Washington Post*, the movement, which has been described as a "democratic awakening" by Cornel West.

The screenshot shows a CNN U.S. news article from November 09, 2011, titled "Occupy movement fights foreclosures, protests program cuts". The article text states: "What started as the Occupy Wall Street movement in New York in September has spread across major cities worldwide as a call to action against unequal distribution of wealth. Here is a roundup of some of the movement's recent developments. ATLANTA Up to 20 protesters in Atlanta moved to the suburbs Monday, taking up position in a home with a family of five facing foreclosure. Members of Occupy Atlanta will stay in Snellville for 48 hours, according to a group spokesman." The article includes a photo of protesters holding a "Good Bye Banks" sign and a "Prudential Can Help" advertisement.



<http://www.occupyoutcongress.info/> 03/31/2012 05:08:57 PM

**OCCUPY CONGRESS**  
ANOTHER WORLD IS POSSIBLE

HOME ABOUT US CONGRESS #MIGS MEDIA CONTACT US DONATIONS LOGIN MINUTES

[http://www.washingtonpost.com/blogs/the-buzz/post/occupy-congress-protesters-gathering-outside-capitol-live-updates/2012/01/17/gIQA5ytk5P\\_blog.html](http://www.washingtonpost.com/blogs/the-buzz/post/occupy-congress-protesters-gathering-outside-capitol-live-updates/2012/01/17/gIQA5ytk5P_blog.html) 03/31/2012 05:11:17 PM

Sign In Register Print Subscription Conversations Today's Paper

POLITICS OPINIONS LOCAL SPORTS National World Business Investigations

**The Washington Post** Make us your start page  
**POSTLOCAL**

D.C. Maryland Virginia Crime Education On Faith Local Obituaries Traffic & Commuting

In the News **Mercy killing** 'Pink slime' D.C. Peeps Pot growers New Hoya

**theBUZZ** What the D-M-V is talking about\*

Get Updates: [Twitter](#) | [Facebook](#) | [XML](#) [RSS Feed](#)

**ABOUT THE BUZZ** Posted at 01:20 PM ET, 01/17/2012  
**Occupancy Congress: Protesters gathering outside Capitol (live updates)**  
By [Katie Rogers](#)  
The rain isn't delaying the events of a long-planned protest, Occupy Congress, by members of the Occupy Wall Street movement.

**SEARCH THIS BLOG**

**POST READS**

- Capital Weather Gang
- Crime Scene
- D.C. Sports Bog
- Express
- Going Out Guide
- Post Now
- The Root D.C.
- District of DeBonis

**3. Application Serial Nos. 86007909, 85926320, 85910709, 85910126, etc.<sup>72</sup>  
(Abandoned)**

**Mark:** BOSTON STRONG

**Goods/Services:** Variety of goods and services including t-shirts and bracelets in International Classes 14, 25, 28, 30, 35, 40 and 41.

**Analysis:** Abandoned for failure to respond to the Office action. Registration was refused in part because the mark failed to function as a trademark and service mark because it was merely informational based on evidence that it was a commonplace message used widely by third parties in support of those affected by the bombing that occurred at the Boston Marathon on April 15, 2013. The specimen included hang tag showing the mark used on the identified goods, which would otherwise be acceptable to show trademark use for the goods. Because the mark was deemed informational, it was incapable of functioning as a source indicator for these goods regardless of the specimen.

**Evidence:**

<http://chicago.cbslocal.com/2013/06/15/bernstein-go-ahead-make-fun-of-boston-strong/>  
07/11/2013 11:01:18 AM

Reporting Dan Bernstein

**Filed Under**  
Bernstein's Columns, Blackhawks, Blogs, NHL, Sports, The Boers And Bernstein Show, Uncategorized

**Related Tags**  
#BostonStrong, Blackhawks, Bruins, CBS @ Chicago Stronger, CubbyTees.com, Dan Bernstein, Lance Armstrong, Livestrong, Maple Leafs, NHL, Red Sox, Stanley Cup, Toronto

#BostonStrong began in the immediate aftermath of the marathon bombing havoc as nothing but good intention to unify the city and the relief effort. As was noted in this space at the time, the unfortunate aspect of anything "\_\_\_\_Strong" is the continuing reminder of the source of that branding template: the utterly fraudulent Lance Armstrong, and his corrupt, mismanaged charity that bears half his name, LiveStrong.

Negative connotations notwithstanding, BostonStrong has succeeded in galvanizing fundraising for victims and given a proud city a standardized, positive, recognizable slogan as it works to move beyond the terror of those days.

StrongBostonStrong 07/11/2013 11:14:29 AM

facebook

Boston Strong is on Facebook.  
To connect with Boston Strong, sign up for Facebook today.  
Sign Up Log In

**BOSTON STRONG**  
22,004 likes · 318 talking about this

Community  
Buy The Shirt: <http://kickstpeople.com/marketplace/kit-detail/7560>  
Charity Info: <http://onefundboston.org/>

About Photos Likes Notes 3 Events

Highlights

Boston Strong shared a link.  
July 2 · vfb

How beautiful and a wonderful tribute to Boston!

This is Boston  
I created this video as a tribute to the beautiful city of Boston. Bostonians are proud of their city and I wanted to create a video they could be proud of, and...

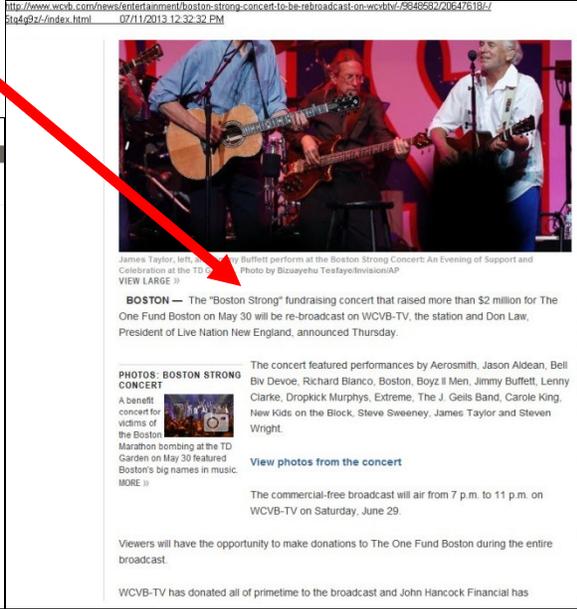
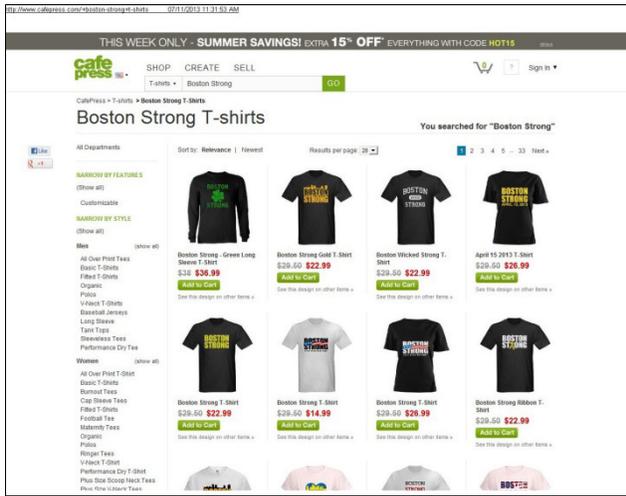
Recent Posts by Others on Boston Strong

Ralph Lopez  
<http://www.dailypaul.com/2013/08/12/ohio-pleads-emoc...>  
14 hours ago

Jennifer Baker  
The family in Calgary Alberta has lost everything in the re...  
Yesterday at 5:24am

Colleen Bordenau  
All the way in Germany...we say "Boston Strong"  
11 · 10 · 11 · Tuesday at 8:40am

More Posts -



Specimens:



### 3. Hypothetical

**Mark:** KEEP CALM AND FOLLOW JESUS

**Goods/Services:** T-shirts, in International Class 25.

**Analysis:** The mark should be refused registration because it fails to function as a trademark based on evidence that it is a message widely used by third parties to show support for a religion. Since the clothing imprinted with the mark would be purchased by consumers for the message it would convey, the applicant would not be entitled to appropriate the slogan and thereby prevent competitors from using it to promote the sale of their own clothing. Although the mark references a religious figure, there is no evidence that the wording in the mark appears in a religious text. Therefore, the mark should not be refused registration as material from a religious text.

### Evidence:

The screenshot shows a Google Shopping search for "keep calm follow jesus". The search results are displayed in a grid format. On the left side, there are filters for location (Dallas, TX), price (ranging from \$15 to \$45), category (Mobile Phone Cases, Books), gender (Women's, Men's), and seller (Etsy - MediaShack, Etsy - UltimateGraphix, Teespring, Walmart, Zazzle). The search results include various items such as t-shirts, hoodies, pillows, tea cups, car mats, stickers, metal ornaments, and phone cases, all featuring the "KEEP CALM AND FOLLOW JESUS" slogan. Prices range from \$12.99 to \$114.00. The items are sold by various sellers including Etsy, Zazzle, and Teespring.

Item Description	Price	Seller
Keep Calm and Follow Jesus T-Shirt	\$12.99	Etsy - MediaShack
Keep Calm and Follow Jesus T-Shirt	\$25.65	Zazzle
Keep calm and follow Jesus T-shirt	\$22.20	Zazzle
Keep Calm And Follow Jesus Basic Tees	\$22.99	Teespring
Keep Calm And Follow Jesus Hoodies & Sweatshirts	\$38.99	Teespring
Keep Calm and Follow Jesus T-Shirt, Beautiful I front design T...	\$13.95	Etsy - UltimateGraphix
I can't keep calm I follow Jesus T-shirt	\$30.15	Zazzle
Keep Calm And Follow Jesus Tea Cup	\$19.95	Zazzle
Keep Calm and Follow Jesus Throw Pillow	\$32.25	Zazzle
Keep Calm And Follow Jesus Car Mat	\$79.80	Zazzle
Keep Calm And Follow Jesus Stickers	\$6.00	Teespring
Keep Calm and Follow Jesus iPhone 5C Cover	\$33.20	Zazzle
Keep Calm and Follow Jesus Christian Humor Ceramic Ornament	\$16.85	Zazzle
Keep Calm and Follow Jesus Courier Bag	\$114.00	Zazzle
Keep Calm and Follow Jesus Metal Ornament	\$24.35	Zazzle
Keep Calm and Follow Jesus Sleeves For Ipad	\$51.50	Zazzle
Keep Calm And Follow Jesus iPhone 4s Case	\$31.65	Zazzle
Keep Calm and Follow Jesus Spiritual iPhone Se/5s Case	\$39.05	Zazzle

Etsy keep calm and follow jesus Search Sell on Etsy Register Sign in Cart

Clothing & Accessories Jewelry Craft Supplies & Tools Weddings Entertainment Home & Living Kids & Baby Vintage

Show results for: All categories > "keep calm and follow jesus" (17 Results) Sort by: Relevancy

All categories  
Electronics & Accessories  
Bags & Purses  
Clothing  
Books, Movies & Music  
Home & Living  
Art & Collectibles

Refine your search

Shop location  
 Anywhere  
 United States  
Choose a custom location

Item type  
 All items  
 Handmade  
 Vintage

Price (\$)  
Low to High

Filter by color  
[Color swatches]

Ordering options  
 Accepts Etsy gift cards  
 Customizable

Ship to  
United States

<p>NEW...Keep Calm and Follow Jesus T-Shirt...Christia... MayberryQuilts \$2.00</p>	<p>Spigen Thin Fit Exact Fit for Apple iPhone 6 6S &amp; Plus... CustomOtterbox \$27.99</p>	<p>Keep Calm and Follow Jesus vinyl wall art decal designstudiosigns \$35.00</p>	<p>Keep Calm and Follow Jesus T-Shirt. Beautiful! front... UltimateGraphix \$13.95</p>
<p>Keep Calm and Follow Jesus SWATrends \$20.00</p>	<p>Keep Calm and Follow Jesus T-Shirt DesignGusto \$18.00</p>	<p>Keep Calm and Follow Jesus T-Shirt. TSLZ1 \$18.00</p>	<p>Keep Calm and Follow Jesus T-Shirt MediaShack \$12.99</p>
<p>Keep Calm and Follow Jesus or Keep Calm. Keep Ca... MyChristianshirts \$14.99</p>	<p>Keep Calm and Follow Faith - Fine Art Print - Choice ... LetsKeepCalm \$15.00</p>	<p>Hard Snap-On Case for Apple 5 5S 6 6S 6 Plus 6S PL... CustomOtterbox \$12.99</p>	<p>CUSTOM OtterBox Defender Case for Apple iPhone ... CustomOtterbox \$59.99</p>

## D. Direct Quotations, Passages, and/or Citations from Religious Texts

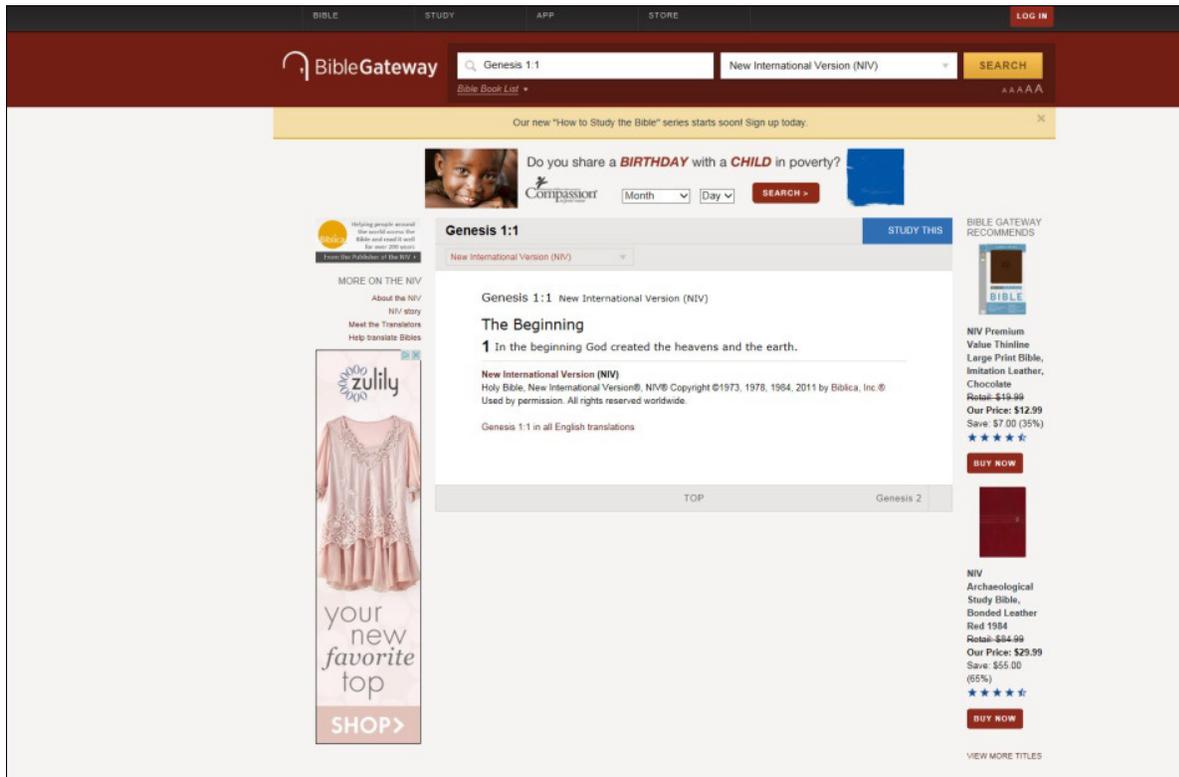
### 1. Hypothetical

**Mark:** IN THE BEGINNING GOD CREATED THE HEAVENS AND THE EARTH GENESIS 1:1

**Goods/Services:** Religious books in International Class 16; T-shirts, in International Class 25; Soft drinks, in International Class 32; providing information about religion, in International Class 45.

**Analysis:** The mark comprises a direct quotation/passage from a religious text and a citation indicating the location of the quotation/passage. Registration should be refused because the mark fails to function as a trademark and service mark based on evidence showing that the quotation/passage and the citation is matter from a religious text and consumers would view the matter as religious text.

### Evidence:



The screenshot shows the BibleStudyTools.com website. At the top, there is a navigation bar with "Read", "Study", "Teach", and "Newsletter" options. The main header displays "The Bible" and "Genesis 1:1" with a search bar and a "Find it" button. Below this, there are dropdown menus for "Translation" (New International Version) and "Book" (All Books). A prominent banner reads "Ready to be a Pastor? Earn a Degree in Pastoral Studies At Home! Take the First Step". The main content area features the text of Genesis 1:1 NIV: "1 In the beginning God created the heavens and the earth." Below the text are options for "In Context", "Paralel", and "Compare". A sidebar on the right includes a "STAY CONNECTED" section with a "Play Bible Trivia!" game, a "Bible Study" section with a video titled "4 Prayers Every Husband Needs to Pray over His Wife", and another video titled "Beyond Sunday: The Potter and the Clay". At the bottom, there is a "Study tools for Genesis 1:1" section with a list of resources such as "Comentario Biblico", "Commentary Critical and Explanatory on the Whole Bible", and "Wesley's Explanatory Notes".

**Note:** The inclusion or exclusion of minor punctuation elements in the mark (e.g., commas and periods) when compared to the wording as shown in the evidence is not sufficient to obviate the refusal or disclaimer requirement.

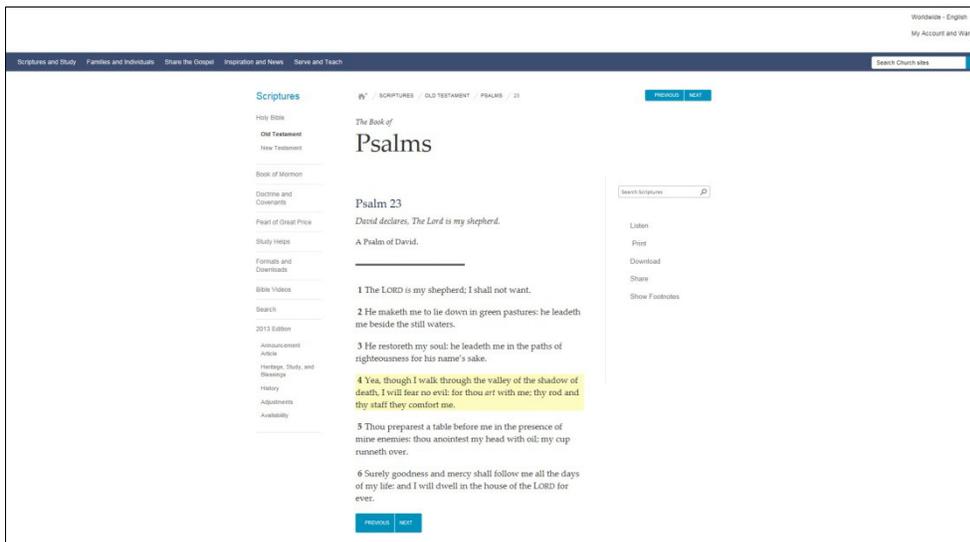
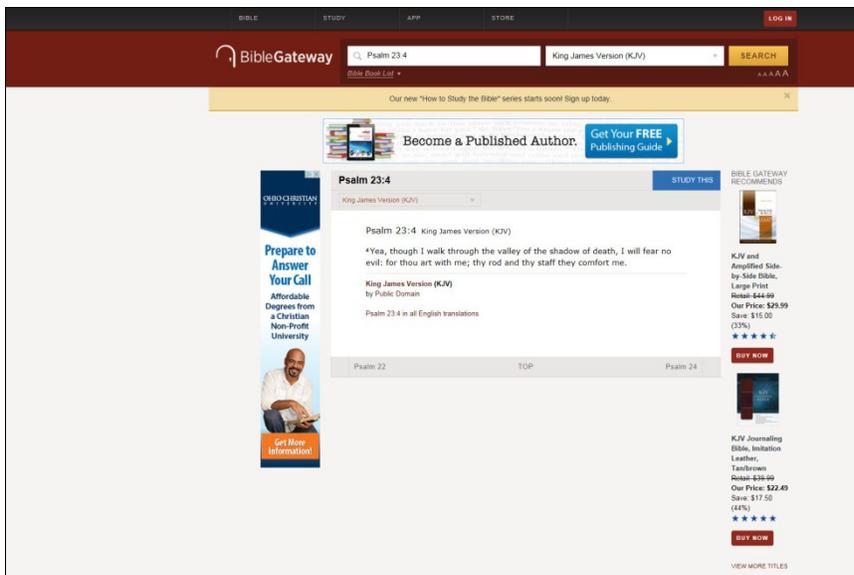
## 2. Hypothetical

**Mark:** YEA, THOUGH I WALK THROUGH THE VALLEY OF THE SHADOW OF DEATH, I WILL FEAR NO EVIL: FOR THOU ART WITH ME; THY ROD AND THY STAFF THEY COMFORT ME.

**Goods/Services:** Bumper stickers, in International Class 16; Religious instruction services, in International Class 41.

**Analysis:** The mark comprises a direct quotation/passage from a religious text. Registration should be refused because the mark fails to function as a trademark and service mark based on evidence showing that the quotation/passage is matter from a religious text and consumers would view the matter as religious text.

### Evidence:



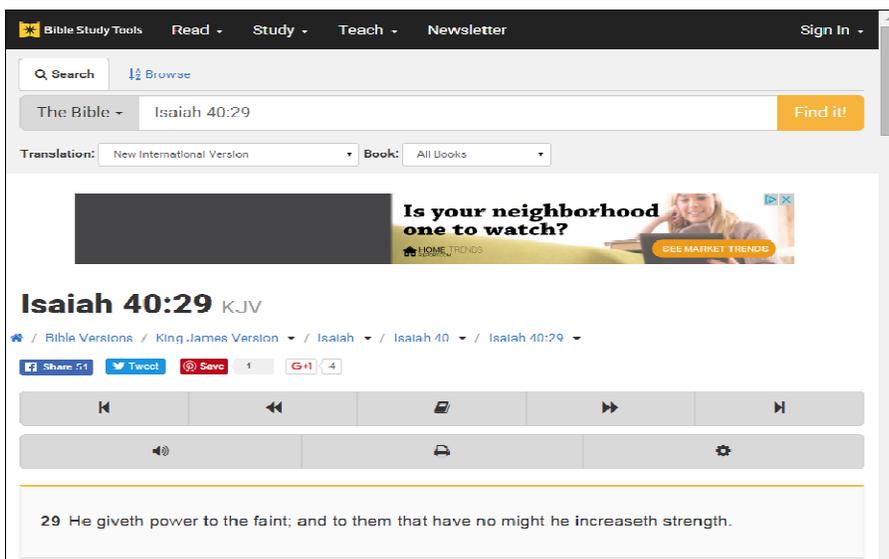
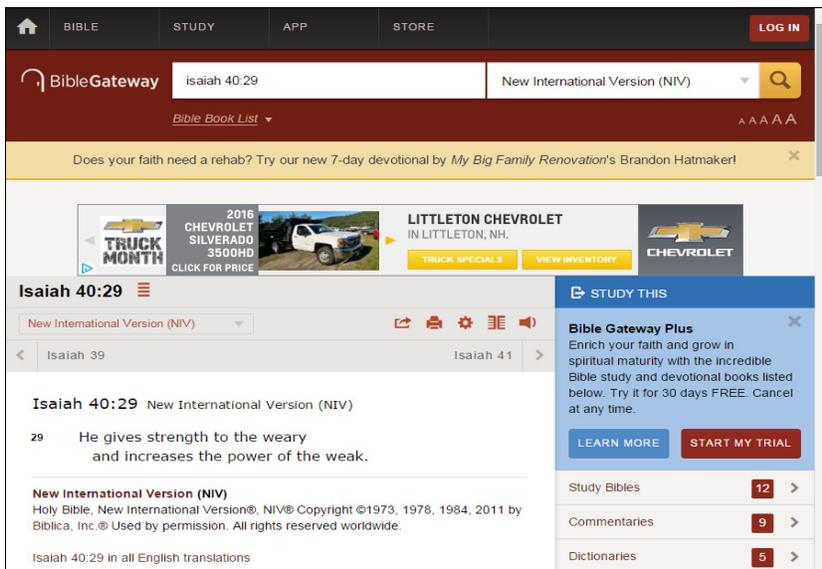
### 3. Hypothetical

**Mark:** Isaiah 40:29

**Goods/Services:** Cookies, in International Class 30.

**Analysis:** The mark comprises a citation to a quotation/passage in a religious text. Registration should be refused because the mark fails to function as a trademark based on evidence showing that the citation is matter from a religious text and consumers would view the matter as religious text.

#### Evidence:



**4. Registration No. 2490548 (Cancelled for Failure to File Section 8 Affidavit of Use or Excusable Nonuse of Mark in Commerce)**

**Mark:** GOD’S GEAR GOSPEL WEAR FOR GOD SO LOVED THE WORLD



**Disclaimer:** “GEAR”, “WEAR” and “FOR GOD SO LOVED THE WORLD”

**Goods/Services:** Clothing, namely, footwear, sweats suits, sweat bands, t-shirts, caps, hats, shoes, jackets, shirts, skirts, blue jeans, pants, socks,” in International Class 25.

**Analysis:** The wording “For God So Loved The World” appears in the Bible as a portion of the verse John 3:16. Consumers would view such wording as a direct quotation/passage from a religious text. Registration was not refused on the basis of failure to function as a trademark since the mark also contains registrable matter. Instead, a disclaimer requirement was properly issued for “For God so Loved the World” as well as “Gear” and “Wear.”

**Evidence:**



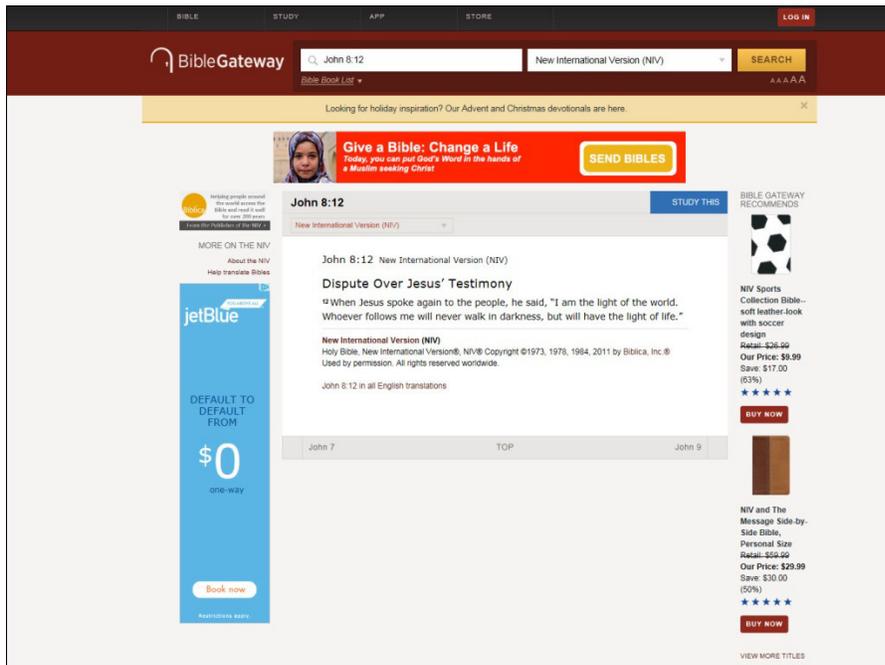
## 5. Hypothetical

**Mark:** BE READY FOR HIS LOVE – JOHN 8:12

**Goods/Services:** Motorcycles, in International Class 12; T-shirts, in International Class 25; Television broadcasting, in International Class 38.

**Analysis:** The wording BE READY FOR HIS LOVE is not a direct quotation/passage from the Bible but the wording JOHN 8:12 is a citation from the Bible. Consumers would view the citation as matter from a religious text but not the other wording. Registration should not be refused on the basis of failure to function as a trademark and service mark as matter from a religious text since part of the mark is not directly from a religious text and is, thus, registrable. However, a disclaimer requirement should be issued for “John 8:12” because it is matter from a religious text. Additionally, the phrase BE READY FOR HIS LOVE should be analyzed for whether it comprises a widely used religious message under [Part II.A.2.b](#) of this examination guide.

### Acceptable Evidence:



# oremus Bible Browser

---

Omit verse numbers;  Omit footnotes  
 Show section headings;  Omit passage reference  
 Omit adjacent passage references

---

## John 8:12

<sup>12</sup> Again Jesus spoke to them, saying, "I am the light of the world. Whoever follows me will never walk in darkness but will have the light of life."

<<   >>

---

The New Revised Standard Version, copyright 1989 by the Division of Christian Education of the National Council of the Churches of Christ in the United States of America. Used by permission. All rights reserved.

---

Enter another bible reference:

---

**obb**  
bible browser  
biblemail@oremus.org  
v 2.2.7  
10 February 2011

**YAHOO!**

**Web** Images Video News More ▾ Anytime ▾

We did not find results for: "be ready for his love".  
Check spelling or type a new query.

Try asking your question on [Yahoo Answers](#)

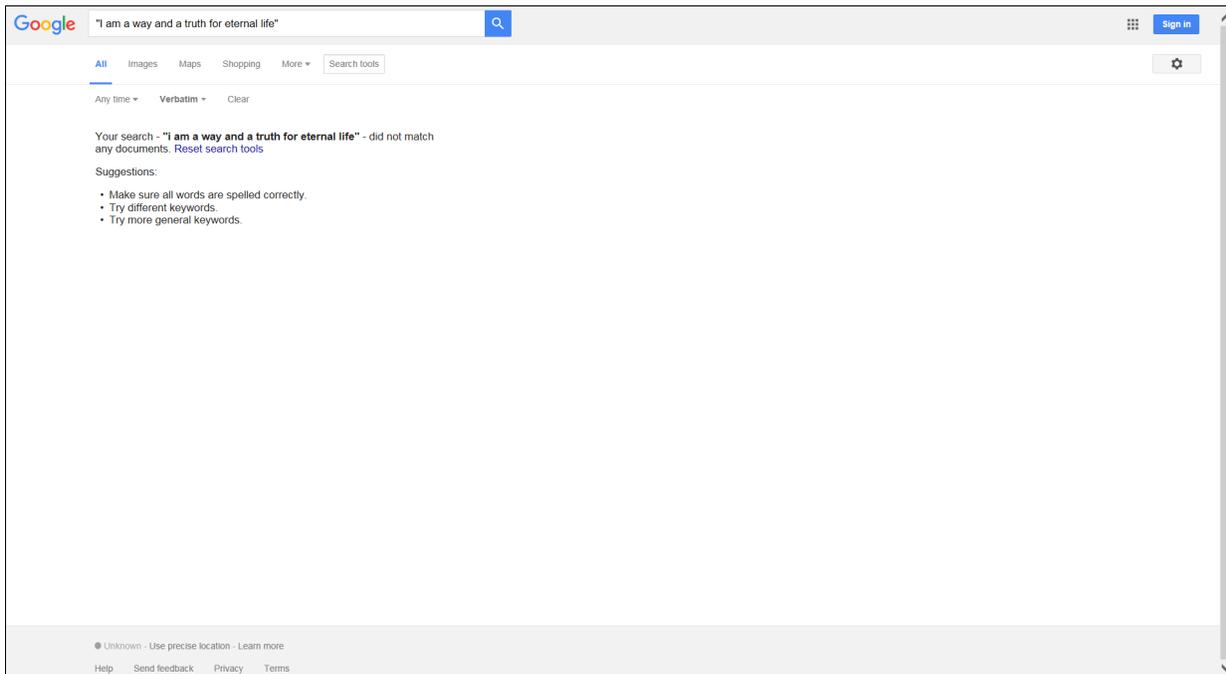


## 6. Hypothetical

**Mark:** I AM A WAY AND A TRUTH FOR ETERNAL LIFE

**Goods/Services:** Notebooks, in International Class 16; T-shirts, in International Class 25; cookies, in International Class 30; and educational services, namely, conducting classes in the field of religion, in International Class 41.

**Analysis:** The mark comprises wording that is not a direct quotation/passage from a religious text. The mark is highly similar, but not identical, to wording which appears in the English translations of the Bible verse John 14:6. One translation of John 14:6 is “I am the way and the truth and the life. No one comes to the Father except through me.” An Internet search for the phrase “I am a way and a truth for eternal life” returns zero results. Accordingly, registration should not be refused on the basis of failure to function as a trademark and service mark since the mark is not a direct quotation/passage from a religious text. However, the mark should be analyzed for whether it comprises a widely used religious message under [Part II.A.2.b](#) of this examination guide.



**7. Application Serial No. 85082970 (Abandoned For Failure To File Statement Of Use)**

**Mark:** BRON 3:16

**Goods/Services:** Clothing products, namely, shirts, t-shirts, hats, caps, jackets, tank-tops, warm-up suits, wristbands, headbands and footwear for consumers of all ages, in International Class 25; and sporting goods, namely, basketballs,” in International Class 28.

**Analysis:** BRON 3:16 is not a citation from a religious text. However, it is presented in a format that resembles a religious citation and appears to allude to the Bible citation “John 3:16.” Registration was not refused on the basis of failure to function as a trademark since the mark is not a citation from a religious text.

## 8. Hypothetical

**Mark:** MALL 20:3-17

**Goods/Services:** Leasing of shopping mall space, in International Class 36.

**Analysis:** MALL 20:3-17 is not a citation from a religious text. However, it is presented in a format that resembles a religious citation and appears to allude to the Bible citation “Exodus 20:3-17.” Registration should not be refused on the basis of failure to function as a service mark since the mark is not a citation from a religious text. However, because the term “Mall” is descriptive of the identified services and the mark as a whole is not unitary, a disclaimer requirement for “Mall” is appropriate.

### Evidence:

The screenshot shows the Merriam-Webster website interface. At the top, there is a navigation bar with the Merriam-Webster logo and links for Dictionary, Thesaurus, Medical, Scrabble, Spanish Central, Browse Dictionary, and Browse Thesaurus. A search bar is present with the word "mall" entered. Below the search bar, there is a banner for "NO MONTHLY PAYMENTS UNTIL 2016." The main content area displays the definition of "mall" as a noun, with two primary meanings: "a large building or group of buildings containing stores of many different kinds and sizes" and "a public area where people walk." Below the definition, there is a section for "Full Definition of MALL" with numbered entries: 1. "an alley used for post-mail" and 2. "The Mall, promenade in London, originally a post-mail alley." Under entry 2, there are sub-definitions: a. "a usually public area often set with shade trees and designed as a promenade or as a pedestrian walk" and b. "a usually paved or grassy strip between two roadways." There is also a sub-definition for "a" as "an urban shopping area featuring a variety of shops surrounding a usually open-air concourse reserved for pedestrian traffic" and for "b" as "a usually large suburban building or group of buildings containing various shops with associated passageways." To the right of the main content, there are several promotional banners and widgets, including "Word of the Day" (slapstick), "sprout by hp", "Words at Play" (Monster of the Day), "All Right or Alright?", "Internet Essentials", "Word Games" (Name That Thing, True or False?, Spell It), and "Trend Watch" (Unscathed Hillary Clinton testifies before the Benghazi Committee).

**9. Application Serial No. 85722211 (Abandoned For Failure to Respond To Office Action)**

**Mark:** ON THE 8<sup>TH</sup> DAY, GOD CREATED WEST VIRGINIA

**Goods/Services:** T-shirts, in International Class 25.

**Analysis:** The mark comprises wording that is not a direct quotation/passage from a religious text. However, the wording is presented in a format that resembles wording from The Book of Genesis in the Bible. Registration was not refused on the basis of failure to function as a trademark since the mark is not a direct quotation/passage from a religious text.

---

<sup>72</sup> 10 applications total filed by 10 different owners between April 17, 2013 and July 11, 2013. The applications are US. Serial Nos. 86007909, 85926320, 85910709, 85911532, 85910589, 85910126, 85910031, 85909994, 85906569, and 85906495.