

Submission of the United States of America

GROUNDNS FOR REFUSAL OF TRADEMARK REGISTRATION

In the United States, examining attorneys review applications for registration for compliance with basic filing requirements, informal statutory requirements, and both relative and absolute grounds for refusal. The Trademark Act of 1946, also known as “The Lanham Act,” governs the filing of applications for registration.¹

Section 2 of the Lanham Act establishes most of the grounds for refusals of registration. Under Section 2 of the Lanham Act, no trademark may be refused registration on the Principal Register unless one of the statutory grounds for refusal listed in the Act applies. Thus, the language of Section 2 presumes that the mark can be registered and the burden of establishing that a mark cannot be registered rests with the assigned examining attorney at the United States Patent and Trademark Office (USPTO). Any application that is finally refused by an examining attorney may be appealed to the Trademark Trial and Appeal Board (TTAB) and then to the U.S. Court of Appeals for the Federal Circuit or a federal district court.

Immoral, Deceptive, Scandalous or Disparaging Marks, Marks that Suggest a False Connection, and Certain Geographical Indications for Wine or Spirits

Immoral or scandalous marks²

A mark will be refused registration if it consists of or comprises immoral or scandalous matter. The examining attorney determines whether matter in a mark is immoral or scandalous by considering its ordinary and common meaning based on dictionary definitions and other evidence of usage and significance. Matter is considered to be scandalous or immoral if it is shocking to the sense of propriety, offensive to the conscience or moral feelings, or calls out for condemnation. A mark will likely be refused registration if it contains matter that offends religious, ethical, patriotic, or political beliefs. Marks are also scandalous or immoral if they are vulgar or morally crude. A mark will likely be refused if it identifies in vulgar terms certain body parts, bodily activities, or describes certain bodily functions.

The examining attorney must judge whether a mark is scandalous based on a substantial composite of the general public but not necessarily a majority. This requires the examining attorney to provide evidence that a substantial portion of the general public would consider the mark to be scandalous in the context of contemporary attitudes and the relevant marketplace. This evidence may include dictionary definitions and newspaper and magazine articles. It is also proper to look to any specimens of use submitted by the applicant to determine the connotation or meaning of a mark.

¹ 15 United States Code (U.S.C.) §§1051 et seq.

² Trademark Manual of Examining Procedure (TMEP) §1203.01; The TMEP can be accessed at: <http://tess2.uspto.gov/tmdb/tmep/>

Refusals on the grounds that a mark is immoral or scandalous apply only to the marks and not to the nature of the goods and/or services for which registration is sought. Examining attorneys are required to have their supervisors review marks that may be considered immoral or scandalous to help ensure consistent application of this standard.

A refusal on the grounds that matter in a mark consists of or comprises immoral or scandalous matter is intended to prevent the use of public resources by the USPTO to protect and thereby encourage the commercial use of matter that is inconsistent with contemporary social values and norms.

*Deceptive marks*³

A mark will be refused registration if it consists of deceptive matter, that is, if: (1) the mark or a portion of the mark is misdescriptive of the character, quality, function, composition or use of the goods and/or services, (2) prospective purchasers are likely to believe the misdescription, and (3) the misdescription is likely to affect the decision of consumers to purchase the goods and/or services. This includes matter that is geographically deceptive. The test for determining whether a mark is geographically deceptive is whether: 1) the primary significance of the mark is a generally known geographic location; 2) the goods and/or services do *not* originate in the place identified in the mark; 3) purchasers would be likely to believe that the goods and/or services originate in the geographic place identified in the mark; and 4) the misrepresentation is a material factor in the consumer's decision to buy the goods and/or use the services.⁴

For example, if geographic matter in a proposed mark identifies a specific good and/or service to U.S. consumers with a particular quality, reputation or other characteristic—and it is a material element to the purchasing decision that the goods and/or services have that quality, reputation or other characteristics attributable to the origin of the goods and/or services—and the goods and/or services do not originate from the place identified in the proposed mark, a geographically deceptive refusal under this provision may be appropriate.

If a mark is misdescriptive and prospective purchasers are likely to believe the misdescription, but the misdescription would not lead consumers to purchase the goods and/or services, the mark is misdescriptive but not deceptive. Unlike deceptive marks, misdescriptive marks may be registered on the Supplemental Register (because the misdescriptive matter is not salient to the purchasing decision) or, if the applicant can show that it has acquired distinctiveness, on the Principal Register.

When issuing a refusal of a deceptive mark, the examining attorney must provide evidence that the misdescribed quality or characteristic would make the product or service more appealing or desirable to prospective purchasers in the United States. In support of the refusal, the examining attorney may attach electronic copies of articles,

³ TMEP §1203.02

⁴ TMEP §1210.01(c)

advertisements of competitors, or the applicant's own advertisements or pages from the Internet. A disclaimer of deceptive matter will not overcome a refusal on these grounds.

Refusals on the grounds that a mark is deceptive helps prevent misrepresentations concerning goods and/or services, as well as other deceptive commercial practices. This protects both businesses and individual consumers from falsely marked goods and/or services consistent with the common-law principles of unfair competition law.

*Marks that suggest a false connection*⁵

A mark will be refused registration if it consists of matter which may falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or brings them into contempt or disrepute.

To establish that a proposed mark falsely suggests a connection with a person or an institution, it must be shown that: (1) the mark is the same as, or a close approximation of, the name or identity used by another person or institution; (2) the mark would be recognized as such in that it points uniquely and unmistakably to that person or institution; (3) the person or institution named by the mark is not connected with the activities performed by the applicant under the mark; and (4) the fame or reputation of the person or institution is such that, when the mark is used with the applicant's goods and/or services, a connection with the person or institution would be presumed.

If the examining attorney can find the appropriate evidence to establish that an applied-for mark falsely suggests a connection with a person or institution that is known to the U.S. consumer in the relevant purchasing sector, a refusal may be made under this provision.

Refusals on these grounds protect the names of known individuals or institutions but which may not necessarily be protected by relative refusals on the basis of confusing similarity. Such refusals do not require a showing that the applicant has an intent to benefit unfairly from the good will of any association with the party in question.

*Marks that disparage or bring into contempt or disrepute*⁶

Marks may not be registered if they disparage a person, institution, belief or national symbol. It is not necessary for persons, institutions, beliefs or national symbols to be well-known.

Disparagement is essentially a violation of one's right of privacy, the right to be "let alone" from contempt or ridicule. In determining whether a proposed mark is disparaging, a two part test is utilized (1) what is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the

⁵ TMEP §1203.03

⁶ TMEP §1203.03

manner in which the mark is used in the marketplace in connection with the goods or services; and (2) if that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.

Under this provision, a person or institution includes real persons, legally-created entities such as firms, corporations, unions and associations, and any other organization capable of suing or being sued in a court of law. Under this provision a “belief” may be religious, ethical, patriotic, political, etc. and a “national symbol” is matter which, because of its meaning, appearance and/or sound, immediately suggests or refers to the country for which it stands.

*Certain Geographical Indications for Wines or Spirits*⁷

Marks may not be registered if they consist of a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods.

A designation is considered a geographical indication under this provision if it identifies the applicant's wines or spirits as originating in a territory known for a given quality, reputation, or other characteristic associated with wines or spirits. A mark for wines or spirits that includes a geographical indication cannot be registered if 1) purchasers would erroneously believe the goods originate in the relevant geographic location; and 2) the quality, reputation, or characteristic associated with wines or spirits from that location would materially affect the purchaser's decision to buy the goods.

This refusal, along with others, provides protection for the unregistered rights of mark owners whose wines or spirits originate in the geographic place named in the mark.

Flag, Coat of Arms or Insignia⁸

A mark will be refused registration if it consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

With regard to flags, a refusal would be issued if the design sought to be registered includes a true representation of a flag and would be perceived by the public as a flag, regardless of the presence of other matter. Marks containing elements of flags in a stylized or incomplete form are not refused under this provision. The wording "other insignia" includes only those emblems and devices that also represent governmental authority and that are of the same general class and character as flags and coats of arms. Designs that do not rise to the level of being "emblems of national authority" are not refused. For example, insignia used by governmental departments merely to identify a service or facility are not protected by this refusal. That being said, marks that are not

⁷ TMEP §1210.08

⁸ TMEP §1204

prohibited under this provision may be refused if prohibited by other sections of the Lanham Act. For example, a design may not be an insignia for purposes of this provision but may be refused as deceptive or falsely suggesting a connection under different provisions of the Lanham Act.

When issuing such a refusal, the examining attorney must provide evidence showing that the mark resembles the flag, coat of arms or insignia without careful analysis or a side-by-side comparison. Applicants may respond to refusals on these grounds by deleting the unregistrable matter from the mark so long as the deletion would not result in a material alteration of the mark.⁹

The purpose of this refusal is to prohibit registration for commercial use of an emblem of official governmental authority.

Name, Portrait or Signature¹⁰

A mark will be refused registration if it consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

Examining attorneys must inquire whether any name, including a portion of a name or a nickname, likeness or signature appearing in a mark, is that of a living individual. Written consent from the living individual identified is required if the public would recognize the mark and understand it to identify the person in question.

If the matter in question does not identify a living individual, the applicant must submit a statement indicating that it does not identify a living individual.¹¹ If the individual in question is also the applicant, and has signed the application either personally or through an authorized representative, the necessary consent is inferred and the examining attorney will not issue a refusal or require further consent.

Refusals on these grounds avoid the registration of an individual's name, portrait or signature without authorization, thereby preserving the individual's privacy rights and rights to use his or her name, portrait and signature in publicity.

Likely to Cause Confusion, Mistake or to Deceive¹²

A mark will be refused registration if it consists of or comprises a mark which so resembles a mark currently registered in the USPTO, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or

⁹ TMEP §807.14(a)

¹⁰ TMEP §1206

¹¹ TMEP §813

¹² TMEP §1207

in connection with the goods and/or of the applicant, to cause confusion, or to cause mistake, or to deceive.

When determining whether a likelihood of confusion exists, the examining attorney can only consider marks that are currently registered or pending in the USPTO. As for marks or trade names previously used in the United States and not abandoned, that is not a grounds for refusal in examination but is a grounds for opposition at the USPTO's Trademark Trial and Appeal Board. The examining attorney will primarily consider the similarity of the marks and the relatedness of the goods and/or services. USPTO examining attorneys utilize a set of factors identified by a U.S. judicial decision in determining whether a likelihood of confusion exists. Some of the following factors may be relevant to the analysis:

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
- (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a mark is in prior use.
- (3) The similarity or dissimilarity of established, likely-to-continue trade channels.
- (4) The conditions under which and buyers to whom sales are made, *i.e.* "impulse" vs. careful, sophisticated purchasing.
- (5) The fame of the prior mark based on sales, advertising, and/or length of use.
- (6) The number and nature of similar marks in use on similar goods.
- (7) The nature and extent of any actual confusion.
- (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
- (9) The variety of goods on which a mark is or is not used, that is, whether it is used as a house mark, "family" mark, or product mark.
- (10) The market interface between applicant and the owner of a prior mark, which might include, for example:
 - (a) a mere "consent" to register or use the mark.
 - (b) an agreement designed to preclude confusion, *i.e.*, limitations on continued use of the marks by each party.
 - (c) an assignment of the mark, application, registration and good will of the related business.
 - (d) failure by the owner of the prior mark to act to protect its rights, (laches and estoppel), and indicative of a lack of confusion.
- (11) The extent to which the applicant has a right to exclude others from use of its mark on its goods.
- (12) The extent of potential confusion, *i.e.*, whether *de minimis* or substantial.
- (13) Any other established fact probative of the effect of use.

In the United States, the likelihood of confusion analysis is not constrained by any artificial limitation on the relatedness of the goods/services between those of the prior registrant and those of the applicant. In other words, a likelihood of confusion with a registered mark may be established when the same or similar mark is applied for on less-related goods/services, depending on the facts in the case. Determining likelihood of

confusion depends on the facts of each specific case and how those facts are evaluated vis-à-vis the list of factors noted above. Because of this, the United States does not provide for defensive registrations or specifically provide for refusals of unauthorized well-known marks.

From the point of view of the United States, *ex officio* refusals based on a likelihood of confusion provide enforcement of the registered mark owner's rights without the need for litigation by the mark owner. This makes it less expensive for owners of registered marks, SMEs as well as large multinationals, to enforce their rights while making it less profitable for third parties seeking to unfairly benefit from the mark owner's rights and good will.

Moreover, *ex officio* refusals based on a likelihood of confusion prevent or limit confusion before any party, including consumers, rely on the status of a mark as registered to evaluate the validity of the mark.

Descriptive or Misdescriptive Marks¹³

A mark will be refused registration if it consists of matter which, when used on or in connection with the goods of the applicant, is merely descriptive or deceptively misdescriptive of them.

A mark is merely descriptive if it describes even a single ingredient, quality, characteristic, function, feature, purpose or use of the specified goods and/or services. When looking at the proposed mark, if some imagination, thought or perception is required to determine the nature of the goods and/or services, the proposed mark is considered suggestive and no refusal is issued. However, if no such "step" in reasoning is required and the proposed mark instead "immediately identifies" some attribute of the goods and/or services, it is merely descriptive. Additionally, terms that attribute a certain quality to, or claim excellence for goods and/or services, are merely descriptive terms. A slight misspelling of a word will not turn a descriptive or generic word into a non-descriptive mark. Moreover, if a term has multiple meanings, and at least one of those meanings is descriptive, or misdescriptive, or generic, the term is descriptive, or misdescriptive or generic.

A mark that consists of the class of goods and/or services for which the mark is used, and the relevant public would understand the mark to refer to that class of goods and/or services, is generic. Generic marks are not capable of serving as an indicator of the source of the goods and/or services and may not be registered.¹⁴

A visual representation that consists merely of an illustration of the goods, or of an article that is an important feature or characteristic of the goods or services is descriptive and will be refused registration. If an applicant applies to register a designation that consists of a merely descriptive term with numerals in the form of an alphanumeric telephone

¹³ TMEP §1209

¹⁴ TMEP §1209.01(c)(i)

number, this proposed mark generally lacks distinctiveness and will not be allowed. Moreover, a mark comprised of an Internet domain name can be registered as a trademark or service mark only if it functions as an identifier of the source of the goods or services. The foreign equivalent of a merely descriptive English word generally is no more capable of registration than the English word itself.

Descriptive marks may be registered if they have become a distinctive indicator of the source of the applicant's goods and/or services in commerce and thus are no longer “merely” descriptive.¹⁵ The applicant bears the burden of providing evidence that the mark has become distinctive when used on or in connection with the applicant's goods and/or services in commerce.

To establish acquired distinctiveness, applicants may submit evidence consisting of affidavits, declarations, depositions or other evidence showing the duration, extent and nature of use in commerce and advertising expenditures in connection with such use, and affidavits, declarations, letters or statements from the public or participants in the relevant trade that show that the mark distinguishes the goods. Alternatively, applicants may submit a claim of ownership of any prior registration(s) on the Principal Register of the same mark for similar goods and/or services. Applicants may also submit a statement verified by the applicant that the mark has become distinctive of the applicant's goods and/or services through substantially exclusive and continuous use in commerce by the applicant for the five years preceding the date of the claim of distinctiveness. The examining attorney then evaluates whether the evidence submitted demonstrates that the mark has acquired distinctiveness.

In some cases, marks consisting entirely of descriptive (but not generic) matter that have not acquired distinctiveness may nevertheless be eligible for registration on the Supplemental Register if used in commerce in the United States. When and if distinctiveness is acquired, the owner of these marks may then apply for registration on the Principal Register.¹⁶ The Supplemental Register is available for marks that are not inherently distinctive and which have not yet acquired distinctiveness, but are nevertheless capable of distinguishing goods or services in commerce.

Marks that are misdescriptive of the goods and/or services may not be registered if they are primarily deceptively misdescriptive. If the term immediately conveys an idea of an ingredient, quality, characteristic, function or feature of the goods and/or services with which it is used but the idea is false, although plausible, then the term is primarily deceptively misdescriptive and will be refused registration. In U.S. practice, a mark may be deceptively misdescriptive if it: 1) misdescribes some aspect of the goods and/or services; and 2) consumers are likely to believe the misdescription. If the misdescription is false, but not believable, the mark is not deceptively misdescriptive.

A mark is primarily deceptively misdescriptive if it is used on or in connection with the goods and/or services in such a way as to make it likely for persons encountering the

¹⁵ TMEP §1212

¹⁶ TMEP §1212

mark to believe the misrepresentation. However, if the misrepresentation is material to the consumer's decision to purchase the goods and/or services, then the mark would be refused registration under the deceptive provision of the Lanham Act, in addition to the primarily deceptively misdescriptive provision.

Refusals on the ground that the mark is descriptive of the goods and/or services preserves the ability of competitors to fairly use descriptive wording to describe their goods and/or services in commerce. Such refusals also allow the public to use the descriptive wording without concern about mark owners taking enforcement actions against them.

Geographically Descriptive¹⁷

A mark will be refused registration if, when applied to the goods and/or services of the applicant, it is primarily geographically descriptive. A mark is geographically descriptive if 1) its primary significance is a generally known geographic location, 2) the goods and/or services originate in the geographic location identified in the mark, and 3) purchasers would be likely to believe that the mark originates in the geographic place identified in the mark (called a "goods/place association"). The examining attorney is required to provide evidence of each of these factors.

A mark is primarily geographic if it identifies a real and significant geographic location and the primary meaning of the mark is the geographic meaning. Therefore, marks that identify a remote or obscure geographic place and marks which also have a non-geographic primary meaning are unlikely to result in an association between the place and the goods and/or services and are therefore not geographically descriptive. If the most prominent meaning or significance of the mark is not geographic or if the mark creates a separate readily understood meaning that is not geographic, registration will likely not be refused.

Goods are said to originate from any place where they are manufactured or produced. Services are said to originate from any place where they are performed, at least in part. A product might be found to originate from a place if the main component or ingredient is made in that place. When the goods and/or services may be said to originate both in the geographic place named in the mark and outside that place, registration will normally be refused on the ground that the mark is primarily geographically descriptive.

A goods/place or services/place association requires that the public must be likely to think that the goods or services do in fact originate in the place named. The goods/place or services/place association may ordinarily be presumed from the fact that the applicant's goods and/or services originate in the place named in the mark.

Marks that are primarily geographically descriptive of the goods and/or services may be registered if the applicant can show that the mark has acquired distinctiveness through use or through a prior registration for the same mark for similar goods and/or services.

¹⁷ TMEP §1210

Marks that are primarily geographically descriptive of the goods and/or services may alternatively be registered on the Supplemental Register if they are in use in commerce.

Refusing registration on the grounds that the mark is geographically descriptive preserves the ability for competitors to use geographically descriptive wording in advertising the origin of their goods and/or services.

Geographically Deceptively Misdescriptive¹⁸

A mark will be refused registration if, when applied to the goods and/or services of the applicant, it is primarily geographically deceptively misdescriptive. A mark is considered primarily geographically deceptively misdescriptive if 1) the primary significance of the mark is a generally known geographic location; 2) the goods and/or services do *not* originate in the place identified in the mark; 3) purchasers would be likely to believe that the goods and/or services originate in the geographic place identified in the mark; and 4) the misrepresentation is a material factor in the consumer's decision to buy the goods and/or use the services.

In a case involving goods, if there is evidence that the relevant goods, or related goods, are a principal product of the geographical area named by the mark, then the deception will most likely be found to be material. In a case involving services, a showing that the geographic location in the mark is known for performing the service is not sufficient, unless it rises to the level of fame and it is believable that some connection between the place and services could exist. An inference of materiality arises in the event of a very strong services-place association.

The examining attorney must provide evidence of each of these factors. Marks that identify a remote or obscure geographic place and marks which also have a non-geographic primary meaning are unlikely to result in an association between the place and the goods and/or services and therefore are not primarily geographically misdescriptive.

Marks that are not only primarily geographically deceptively misdescriptive but are also "geographically deceptive" may not be registered even if the applicant shows that the mark has become distinctive through use.

Refusals on the ground that a mark is primarily geographically deceptively misdescriptive or primarily geographically deceptive help prevent the public from experiencing confusion, mistake and deception in the purchase of goods and services.

Surname¹⁹

A mark will be refused registration if, when applied to the goods or services of the applicant, it is primarily merely a surname. A mark is considered primarily merely a

¹⁸ TMEP §1210.01(b)

¹⁹ TMEP §1211

surname if its primary significance to the purchasing public is that of a surname. The factors that must be considered in any such determination include: 1) whether the surname is rare; 2) whether the term is the surname of the applicant or anyone connected with the applicant; 3) whether the term has any recognized meaning other than as a surname; 4) whether it has the “look and feel” of a surname; and 5) whether the stylization of lettering is distinctive enough to create a separate commercial impression.

Surnames may be registered if they have become distinctive of the applicant's goods and/or services in commerce.²⁰ The applicant bears the burden of providing evidence that the mark has become distinctive when used on or in connection with the applicant's goods and/or services in commerce. Such evidence must typically include proof of substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made. Surnames that have not acquired distinctiveness are eligible for registration on the Supplemental Register if they are in use in commerce. When distinctiveness is acquired, these marks may be registered on the Principal Register.

Refusals on the grounds that a mark is primarily merely a surname helps preserve the right of individuals to use their surname in business by requiring applicants to show use or distinctiveness before a surname may be registered on the Supplemental or Principal Register respectively. Refusals on these grounds also help to prevent surnames from losing their significance as names rather than as marks.

Functional Matter²¹

Applicants may seek registration of a product design, product packaging, color or other trade dress for goods or services. However, even if a sign is used and can serve as a mark, it may not be “capable of distinguishing,” as a public policy matter, if it is a functional feature of the goods, that is if it is essential to the use or purpose of the product or if it affects the cost or quality of the product. Examining attorneys will evaluate evidence from the industry as well as solicit information from the applicant to determine whether the claimed feature is functional, including inquiring as to whether a utility patent covers the feature.

In reaching a determination as to functionality, the examining attorney must consider factors identified by U.S. judicial decisions such as 1) any advertising by the applicant that refers to the utilitarian benefits of the matter sought to be registered, 2) the filing of any patent applications by the applicant for the matter in question, 3) the availability of alternative designs, and 4) the impact of the matter on the efficiency or cost of manufacturing.

In order for a proposed mark to be held functional, the evidence need not establish that the configuration is the very best design for the particular product or product packaging. Rather a finding of functionality is proven where the evidence indicates that the

²⁰ TMEP §1212

²¹ TMEP §1202.02(a)

configuration provides specific utilitarian advantages that make it one of a few superior designs available. On the other hand, where the evidence shows that the specific product or container configuration provides no real utilitarian advantages to the user, but rather is one of many feasible, efficient and competitive designs, then the mark may be registered.

Matter that is functional may not be registered, even if the applicant is able to show that the matter has become distinctive.

The functionality doctrine, which prohibits registration of functional product features, is intended to encourage legitimate competition by maintaining the proper balance between trademark law and patent law. It ensures that protection for utilitarian product features is granted through a limited-duration utility patent, and not through the potentially unlimited protection of a trademark registration. Upon expiration of a utility patent, the invention covered by the patent enters the public domain and the functional features disclosed in the patent may then be copied by others. This encourages advances in product design and manufacture. Even where the evidence establishes that consumers have come to associate a functional product feature with a single source, trademark protection will not be granted in light of these overriding public policy reasons.

Ornamental²²

Marks that are merely ornamental may not be registered. Words, slogans or other trade dress is considered ornamental if it is a decorative feature of goods that does not serve to indicate the source of the goods.

In making a determination concerning a refusal on the grounds that matter is ornamental, the examining attorney must consider 1) the overall commercial impression of the mark based on its size, location and dominance in relation to the goods; 2) relevant practices of the trade (*i.e.*, how marks are typically used on comparable goods); 3) secondary sources (*i.e.*, uses of the matter as a mark on other goods and/or services) if applicable; and 4) evidence of distinctiveness.

Ornamental marks may be registered if the applicant shows that the mark serves as an indicator of source for the goods and/or services specified in the application. To show that a proposed mark that appears to be merely ornamental also serves a source-indicating function, the applicant may submit evidence of its use by the applicant with goods or services other than those identified in the application (*i.e.*, that the goods in the present application constitute a “secondary source” of an already known mark). Evidence that the mark serves as an indicator of source may consist of: 1) ownership of a prior United States registration on the Principal Register for the same mark for other goods or services in use in commerce; 2) use of the mark as an indicator of source on other goods and/or services in commerce; or 3) ownership of a prior pending use-based application for the same mark, used as an indicator of source for other goods and/or services in commerce.

²² TMEP §1202.03.

Refusals on the basis that matter is ornamental prevent the registration of material that does not serve as an indicator of source and that could cause confusion as to the nature of the owner's rights in the ornamental matter.

Failure to Function as a Trademark or Service Mark²³

Matter that does not function as a trademark or service mark because it does not indicate the source of goods and/or services may not be registered. Such matter includes, for example, marks for color only and which have not acquired distinctiveness,²⁴ informational wording or matter,²⁵ titles of single creative works,²⁶ the names of artists and authors,²⁷ model or grade designations,²⁸ background designs and shapes,²⁹ and the names of characters used only to indicate the name of the characters and not used as an indicator of source.³⁰

When determining whether subject matter actually serves as a mark, the examining attorney will evaluate whether the overall commercial impression of the proposed mark is that of a trademark and whether consumers would perceive it as a mark. An examining attorney also evaluates whether the subject matter is unique or unusual in a particular field or whether it is a mere refinement of a common and well-known feature for a particular class of goods. Certainly, the practices of the trade may be relevant in assessing whether the proposed mark has become distinctive. Typically, more evidence is required if the proposed mark is a type of matter used so frequently in the relevant industry that consumers would be less apt to discern a source-indicating significance from its use.

If a proposed mark, due to its inherent nature or the manner in which it is used, does not function as a mark to identify and distinguish the applicant's goods and/or services, it will be refused on that basis. Examining attorneys must determine whether the subject matter for which registration is sought is used as a trademark by reviewing all evidence (*e.g.*, the specimens of use and any promotional material) of record in the application. Not everything that a party adopts and uses with the intent that it function as a trademark necessarily achieves this goal or is legally capable of doing so, and not everything that is recognized or associated with a particular party is a trademark.

Trade Name³¹

Trade names may not be registered if they merely identify a person or a business, but do not serve as an indicator of source for goods and/or services. If the examining attorney

²³ TMEP §1202

²⁴ TMEP §1202.05

²⁵ TMEP §1202.04; §1301.02(a)

²⁶ TMEP §1202.08

²⁷ TMEP §1202.09

²⁸ TMEP §1202.10

²⁹ TMEP §1202.11

³⁰ TMEP §1301.02(b)

³¹ TMEP §1202.01

determines that matter for which registration is requested is merely a trade name, registration must be refused because the trade name fails to function as a trademark, as defined under the Lanham Act. If subject matter presented for registration in an application is a trade name or part of a trade name, the examining attorney must review the evidence of record in the application to determine whether it is also used as a trademark.

Phantom Marks³²

Phantom marks are marks with a missing element (such as a date or model number that is represented by a blank space or dashes) that causes the mark to be subject to change. Such marks may not be registered on either the Supplemental Register or the Principal Register. Since phantom marks possess multiple combinations, it is not possible to conduct a thorough search for similar marks or to provide adequate notice to competitors of the filing of an application for registration.

Matter Protected by Statute or Convention: Special Symbols, Emblems, Seals, Insignia, Badges and Names of Special Organizations³³

In addition to the grounds for refusal listed above, specific statutes have been enacted by the U.S. Congress precluding the registration of certain symbols, emblems, seals, insignia and badges and names of special organizations. These include, for example, symbols, emblems, seals, insignias, badges and names of the American Legion, the Boy Scouts of America, the Coast Guard, the Girl Scouts of America, the Olympic Committee, and the Red Cross.

Failure to Respond to an Office Requirement

An examining attorney, as part of the examination process, may request the applicant to provide certain information or amend the application to comply with U.S. trademark practice and regulations. Failure to comply with such requests within the time provided will result in the proposed mark being refused registration. Examples of these requirements include a request to provide information as to the significance of the proposed mark, a request to amend the identification of goods and services so that the identification is clear and unambiguous, and a request to disclaim a descriptive/generic component of the mark.

³² TMEP §1214

³³ TMEP §1205.01