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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Donald E. Moriarty

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Serial No. 86367823

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Jed H. Hansen of Thorpe North & Western LLP,
for Donald E. Moriarty.

Natalie L. Kenealy, Trademark Examining Attorney, Law Office 104,
Zachary Cromer, Managing Attorney.

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Before Shaw, Larkin and Hudis,
Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

Donald E. Moriarty ("Applicant") seeks registration of the mark WORST MOVIE EVER! (in standard characters) on the Principal Register for goods identified as "parody of motion picture films and films for television comprising comedies and dramas featuring a mashup of different motion picture films," in International Class 9.[1]

[1] Application Serial No. 86367823 was filed on August 15, 2014 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), claiming a bona fide intention to use the mark in commerce. As discussed below, following publication of the application for opposition,

Following an Examiner's Amendment to amend the identification of goods, the application was published for potential opposition on April 21, 2015. No opposition having been filed, a Notice of Allowance for the Application was issued on June 16, 2015. After five extensions of time, Applicant filed its Statement of Use including one specimen of use on June 18, 2018.

Upon examination of the Statement of Use, the Trademark Examining Attorney refused registration of Applicant's mark on the ground that the applied-for mark is a slogan or phrase that does not function as a trademark to indicate the source of applicant's goods and to identify and distinguish them from the goods of others under Sections 1, 2, 3 and 45 of the Trademark Act, 15 U.S.C. §§ 1151, 1052, 1053 and 1127.[2]

When the refusal was made final, Applicant appealed and requested reconsideration. When the request for reconsideration was denied, the appeal resumed. The appeal is fully briefed. We affirm the refusal to register.[3]

Applicant filed a statement of use on June 18, 2018 supported by a specimen of use and claiming a date of first use of the mark anywhere and in commerce of June 7, 2018.

[2] The Examining Attorney's reliance on Section 3 of the Trademark Act, 15 U.S.C. § 1053, is unnecessary inasmuch as Applicant is seeking registration of a trademark, not a service mark. *See* TRADEMARK MANUAL OF EXAMINING PROCEDURE ("TMEP") § 1202.04 (Oct. 2018) ("[T]he statutory basis for [a failure to function] refusal is §§ 1, 2, and 45 of the Trademark Act, 15 U.S.C §§ 1051, 1052, and 1127, for trademarks, and §§ 1, 2, 3, and 45, 15 U.S.C. §§ 1051, 1052, 1053, and 1127, for service marks.").

[3] All TTABVUE and Trademark Status and Document Retrieval ("TSDR") citations reference the docket and electronic file databases for the involved application. All citations to the TSDR database are to the downloadable .PDF version of the documents.

I. Preliminary matters

The Examining Attorney objects to new evidence submitted by Applicant with his appeal brief, namely, an image of Applicant's DVD inside its packaging.[4] The objection is well taken. The evidentiary record in an application should be complete prior to the filing of an ex parte appeal to the Board. Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d). Because the material was not filed prior to the appeal, it will be given no further consideration.

Applicant objects to the entire "Statement of Facts" section of the Examining Attorney's Brief "because it does not cite to the record and mischaracterizes the procedural history."[5] Applicant argues that "TBMP § 1203.01 specifically states that both the Applicant and Examining Attorney should cite to the prosecution history when referring to the record."[6] The Examining Attorney's summary of the prosecution history is general in nature and provides all of the relevant dates and names of the documents—with no need for individual page numbers. Therefore, we find that the Examining Attorney's "Statement of Facts" complies with Board procedures. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 1203.01.

Applicant further argues that "the Examining Attorney mischaracterizes the facts [by stating] 'registration was refused under Trademark Act Sections 1, 2, 3, and 45 *because* the applied-for mark *is* a slogan or phrase that does not function as a

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[4] Examining Attorney's Br., 9 TTABVUE 4; Applicant's Appeal Br., p. 9, 7 TTABVUE 10.

[5] Applicant's Reply Br., p. 1, 10 TTABVUE 2.

[6] *Id.*

trademark to indicate the source of applicant's goods and to identify and distinguish them from others.'"[7] (Emphasis added by Applicant). Applicant objects to this characterization because the issue of whether the applied for mark "is the instant issue and is not an established fact. Applicant contends that its mark is registrable."[8]

TMEP § 705.01 states: "Refusals to register should be couched in the statutory language of the section of the Trademark Act that is the basis of the refusal, and the examining attorney must cite the appropriate section of the Act." We find that the Examining Attorney's characterization of the basis for the statutory refusal complies with TMEP § 705.01 and is not improper. Moreover, the Examining Attorney's inclusion of the statutory basis for the refusal as part of the Statement of Facts does not foreclose Applicant's arguments against the refusal. In other words, we do not accept as an established fact the Examining Attorney's statement that "the applied-for mark *is* a slogan or phrase that does not function as a trademark" merely because it is made in the Statement of Facts. In considering the record, the Board is capable of weighing the relevance and strength or weakness of the objected-to Statement of Facts, and keeping in mind the Applicant's objections in determining the probative value of any statements. *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1479 (TTAB 2017). Applicant's objections are overruled.

[7] *Id.* at 2, 10 TTABVUE 3.

[8] *Id.*

II. Failure to function as a mark

"'[A] proposed trademark is registrable only if it functions as an identifier of the source of the applicant's goods or services.'" *In re Yarnell Ice Cream, LLC*, 2019 USPQ2d 265039, *16 (TTAB 2019) (quoting *In re DePorter*, 129 USPQ2d 1298, 1299 (TTAB 2019)). "'The 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.'" *Id.* (quoting *DePorter*, 129 USPQ2d at 1299 (quoting *In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1976)).

Slogans, phrases, and other terms that are considered to be merely informational in nature, or that express support, admiration or affiliation, are generally not registrable. *See In re Eagle Crest Inc.,* 96 USPQ2d 1227, 1232 (TTAB 2010) ("ONCE A MARINE, ALWAYS A MARINE is an old and familiar Marine expression, and as such it is the type of expression that should remain free for all to use."). *See also In re Volvo Cars of N. Am., Inc.*, 46 USPQ2d 1455, 1460-61 (TTAB 1998) (affirming refusal to register "Drive Safely" for automobiles because it would be perceived as an everyday, commonplace safety admonition).

"The critical inquiry in determining whether a designation functions as a mark is how the designation would be perceived by the relevant public." *Eagle Crest*, 96 USPQ2d at 1229. "To make this determination we look to the specimens and other evidence of record showing how the designation is actually used in the marketplace." *Id.* "The more commonly a phrase is used, the less likely that the public will use it to

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