

Mailed: September 3, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Eagle Crest, Inc.

Serial No. 77114518

Correction and Redesignation of Decision as Precedent

Steven R. Scott, Esq. for Eagle Crest, Inc.

Chris Wells, Trademark Examining Attorney, Law Office 106 (Mary I. Sparrow, Managing Attorney).

Before Quinn, Bucher and Holtzman, Administrative Trademark Judges.

Opinion by Holtzman, Administrative Trademark Judge:

The decision issued August 10, 2010 affirming the refusal of registration is corrected as follows--

On page 6, in line 2, "phrase" is substituted for "phrased"; and on page 12, in line 15, "as mark" is corrected to "as a mark."

In addition, the opinion is redesignated as a precedent of the Board. However, since the substance of the opinion remains unchanged, the appeal period continues to run from the date of original issuance of the decision. A copy of the corrected precedential opinion is attached.

THIS OPINION IS
A PRECEDENT OF
THE TTAB

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Before Quinn, Bucher and Holtzman, Administrative Trademark Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Applicant, Eagle Crest, Inc., has filed an application to register the standard character mark ONCE A MARINE, ALWAYS A MARINE on the Principal Register for goods identified, as amended, as "clothing, namely hats, shirts, undergarments, swimsuits, sweatshirts, sweaters, jackets, coats, gloves, scarfs

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[sic], belts, headbands, wristbands, pants, shorts, skirts, dresses, overalls, socks, stockings, and leggings," in Class 25.¹

The trademark examining attorney ultimately refused registration of the mark under Sections 1, 2 and 45 of the Trademark Act on the ground that the designation is merely informational matter and does not function as a mark.²

When the refusal was made final, applicant appealed. Briefs have been filed.

As a preliminary matter, we address applicant's concerns raised in its brief regarding the finality of issue on appeal. In the fifth Office action dated January 21, 2009, the examining attorney refused registration citing Sections 1, 2 and 45 of the Act and stating that "the applied-for mark, as used on the specimen of record, is merely informational matter; it does not function as a trademark to identify and distinguish applicant's goods from those of others...." The examining attorney argued that the mark "is merely informational matter because the goods as worn tell the public that the wearer is either a current or a

¹ Application Serial No. 77114518, filed February 23, 2007, based on an allegation of first use and first use in commerce on January 7, 1992.

² The examining attorney initially refused registration of the mark under Sections 1, 2 and 45 of the Act as mere ornamentation. Following the final refusal on this basis and a request for reconsideration by the applicant, the examining attorney issued a refusal under Section 2(a) of the Act based on a false suggestion of a connection with the United States Marines. The Section 2(a) refusal was subsequently withdrawn, and the examining attorney reinstated the refusal under Sections 1, 2 and 45, this time based on the informational nature of the mark.

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former United States Marine." Following applicant's response to the refusal, the examining attorney made the refusal final, again on the ground that "the matter presented for registration is purely informational," but this time arguing that "the slogan is in general use and will not be seen as an indicator of source in applicant."

Applicant contends that the examining attorney in the final refusal "substantially changed the basis for rejection stated in the prior office action, while adding a variety of putative grounds for rejection and cites not directly related to the subject at hand." Brief, p. 12.

We recognize that this must have been a frustrating prosecution for applicant, but we do not agree that the final refusal was premature. While the examining attorney may have made different arguments and cited to different cases in support of the final refusal, the basis for the refusal did not change. The examining attorney, as well as the applicant, is entitled to raise new arguments and/or additional case citations that pertain to the ground for a refusal. Cf. TBMP §1217 (2d ed. rev. 2004). We also note in this regard that the Board need not find that the examining attorney's rationale was correct in order to affirm the refusal to register, but rather may rely on a different rationale. *Id*; *In re AFG Industries Inc.*, 17 USPQ2d 1162, 1163 (TTAB 1990); *In re Avocet, Inc.*, 227 USPQ 566, 567 (TTAB 1985);

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and In re D.B. Kaplan Delicatessen, 225 USPQ 342, 343 n.2 (TTAB 1985).

As an additional preliminary matter, we note applicant's argument made during prosecution and in its brief that its search of the Office records retrieved hundreds of registrations and applications for marks which include the term "marine(s)," and applicant listed several of them, including a prior registration allegedly owned by applicant for the mark GOT MARINES?. The mere listing of third-party registrations and/or applications, without copies or electronic printouts thereof, is insufficient to properly make them of record. See In re Smith and Mehaffey, 31 USPQ2d 1531, 1532 n.3 (TTAB 1994). However, while the examining attorney never objected to this evidence, and thus, we have considered the listing, it is of no probative value. We have no information as to the goods in the listed registrations and applications, we are not privy to the records in the files of those cases, and, in any event, the Board is not bound by the actions of examining attorneys in allowing those marks for registration. It has been said many times that each case must be decided on its own facts. See In re Nett Designs Inc., 236 F.3d 139, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

We turn then to the question of whether ONCE A MARINE, ALWAYS A MARINE functions as a trademark. Section 45 of the Trademark Act defines a "trademark" in relevant part as "any

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word, name, symbol, or device, or any combination thereof used by a person...to identify and distinguish his or her goods...from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown." It is well settled that "not every designation that is placed or used on or in connection with a product necessarily functions...as a trademark for said product; not every designation adopted with the intention that it performs a trademark function and even labeled as a trademark necessarily accomplishes that purpose; and there are certain designations that are inherently incapable of functioning as trademarks to identify and distinguish the source of the products in connection with which they are used."

American Velcro, Inc. v. Charles Mayer Studios, Inc., 177 USPQ 149, 154 (TTAB 1973).

The critical inquiry in determining whether a designation functions as a mark is how the designation would be perceived by the relevant public. To make this determination we look to the specimens and other evidence of record showing how the designation is actually used in the marketplace. See *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455 (TTAB 1998).

Slogans 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. See *In re*

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Boston Beer Co. L.P., 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999). The more commonly a phrase is used, the less likely that the public will use it to identify only one source and the less likely that it will be recognized by purchasers as a trademark. See Reed v. Amoco Oil Co., 611 F.Supp. 9, 225 USPQ 876, 877 (M.D. Tenn. 1984).

As applicant admits, the evidence submitted by the examining attorney "very clearly shows" that the phrase ONCE A MARINE, ALWAYS A MARINE is "a motto associated with and used by and about Marines by them and their admirers."³ Brief, p. 14. Indeed, the examining attorney's search for the slogan on the Google website retrieved nearly 3 million hits. The examining attorney submitted pages from a number of websites, some excerpts of which are set forth below.

Welcome to Darby's Desk.
These web pages are dedicated to the men and women
who have served and are serving in The United States
Marine Corps.
"Once a Marine!"
[a poem written in 1942, concluding]:
Once a Marine, Always a Marine!
Darbythorpe.homestead.com

Marines Forever.com
A community for past, present & future Marines
Once A Marine, Always A Marine!
...With Marines Forever, you can easily create your
own web page where you can upload pictures, post blog

³ While applicant argues that the slogan also refers to the marines of foreign countries, we are only concerned with the perception of consumers in the United States. We have no doubt that to most consumers in the United States, the slogan would refer to the United States Marines.

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entries and much more.... It is the perfect place to connect with Marine Corps buddies.
Marinesforever.com

It's Your Times [features an article entitled "Once a Marine, Always a Marine"]:
Fighting the Good Fight
When the call comes for our United States Marines to put their lives on the line, they do so, unconditionally...
Itsyourtimes.com

MARINES The Few. The Proud
...the Corps ethos, "Once a Marine, Always a Marine."
"... There's a saying, 'once a Marine, always a Marine,' well that's what (we'll) always be," Manary said...
Marines.mil/units

There is no dispute that the phrase 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. In fact, the evidence shows that the slogan is commonly used in an informational and ornamental manner on t-shirts and various other retail items produced and/or sold by others. For example, the website usmcstore.com offers shirts and t-shirts for sale imprinted with various Marine expressions, including "Once a Marine Always a Marine." Other retail websites show decorative use of the phrase on bumper stickers, caps, sweatshirts, t-shirts and hoodies, posters and calendars. See, e.g., bumpertalk.com; bumperstickers.cafepress.com; amazon.com; scarmy.com; cafepress.com. The function of a trademark is to identify a single commercial source. Because consumers would be accustomed

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to seeing this phrase displayed on clothing items from many different sources, they could not view the slogan as a trademark indicating source of the clothing only in applicant. It is clear that clothing imprinted with this slogan will be purchased by consumers for the message it conveys. Applicant is not entitled to appropriate the slogan to itself and thereby attempt to prevent competitors from using it to promote the sale of their own clothing. It has been noted that "as a matter of competitive policy, it should be close to impossible for one competitor to achieve exclusive rights" in common phrases or slogans. 1 McCarthy on Trademarks and Unfair Competition § 7:23 (4th ed. 2010).

The manner of use on applicant's specimens as well as its other materials would likely reinforce the perception of ONCE A MARINE, ALWAYS A MARINE as merely an informational statement. The specimens consist of a photograph of a hat, displaying ONCE A MARINE, ALWAYS A MARINE in large letters across the crown of the hat with the wording SEMPER FI and USMC appearing on the back, and a photograph of a shirt, reproduced below, showing the phrase displayed on the front breast pocket area of the shirt.

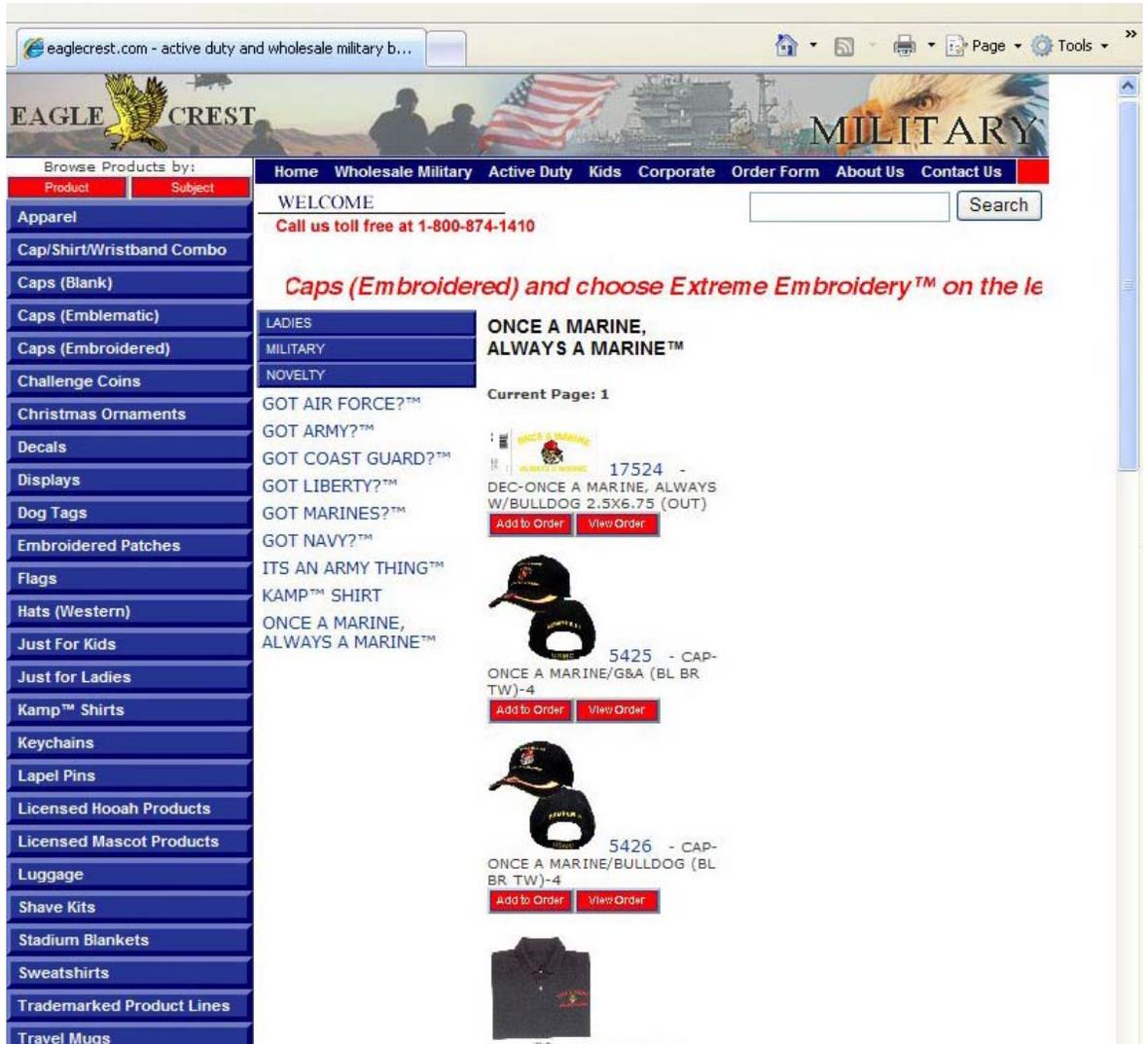


While the slogan is not exactly emblazoned across the shirt as the examining attorney contends, it is nonetheless prominently displayed in a manner that can be easily seen and read. It is clear from the evidence that many consumers want to openly express their support or admiration for the Marines or their association with the Marines, and applicant's shirts and hats accomplish that purpose. Thus, as used on applicant's clothing, the slogan would be viewed as an informational message rather than as a trademark identifying the source of applicant's clothing.

As additional evidence of use, applicant submitted screen shots from its website, eaglecrest.com, including a page offering a "blank" t-shirt for sale under the heading "ITEM NO: ONCE A

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MARINE BLANK TEE." The applied-for mark appears nowhere on this page. Another page from the website is reproduced below.



The slogan is displayed at the top of the page followed by "TM," and it appears on a shirt and various caps in a manner similar to the display on the specimens. It also appears in a listing along with eight other military or patriotic messages, where consumers are invited to choose the message, such as ONCE A MARINE, ALWAYS A MARINE, that they would like to have imprinted

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on their clothing. Used in this manner, the slogan functions solely to convey an informational message on the shirt. It would not be viewed as a trademark identifying the source of the shirt. We also note that use of the TM notation does not make this otherwise unregistrable term a trademark. Volvo Cars of North America Inc., supra at 1461.

Applicant argues that despite the fact that ONCE A MARINE, ALWAYS A MARINE is used widely as a slogan by Marines and their admirers, it is not a phrase of "universal applicability and usage" like DRIVE SAFELY or WATCH THAT CHILD. Brief, p. 13. However, the examining attorney has shown prima facie that the slogan would be perceived solely as informational matter rather than as a trademark and applicant has submitted no evidence to rebut that showing.

Applicant also argues that this case is different from the cases cited by the examining attorney to support the refusal such as In re Boston Beer Co. L.P., 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (THE BEST BEER IN AMERICA so highly laudatory and descriptive as applied to beer and ale that it is unregistrable); In re Aerospace Optics, Inc., 78 USPQ2d 1861 (TTAB 2006) (SPECTRUM fails to function as a mark for illuminated pushbutton switches, as it merely informs purchasers of the multiple color feature of the goods); In re Schwauss, 217 USPQ

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361 (TTAB 1983) (FRAGILE for labels and bumper stickers is an informational statement rather than a source identifier).

We agree that ONCE A MARINE, ALWAYS A MARINE as applied to clothing is intrinsically different from slogans in the cited cases in that it does not impart any information about the goods themselves. However, that distinction is not legally significant. The primary function of this familiar Marine slogan as shown by the evidence of use by the public, by other retailers and also by applicant, is nonetheless to convey information, that is, to express support, admiration or affiliation with the Marines. We believe the facts in this case are more analogous to those in *In re Tilcon Warren, Inc.*, 221 USPQ 86 (TTAB 1984) where the Board held that the phrase WATCH THAT CHILD for construction material would be perceived merely as an expression of general concern about child safety that does not function as a mark; and *In re Pro-Line Corp.*, 28 USPQ2d 1141, 1142 (TTAB 1993) holding that the phrase BLACKER THE COLLEGE SWEETER THE KNOWLEDGE appearing on t-shirts "would be viewed merely as an informational message or slogan devoid of trademark significance."

Finally, applicant argues that other "common 'United States Marine' expressions" such as "'HOOAH!' and 'GUNG-HO!'" are "trademarked for various products without being accused of being either identifiers for the U.S. Marines, etc. or being 'merely

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informational' as identifying product users as being past or present U.S. Marines...."

It is not clear what applicant means by "trademarked," but in any event applicant has submitted no evidence to support this assertion. Moreover, the question of whether other mottos or slogans would be registrable is not before us and, as we noted earlier, has no bearing on the question of whether this designation is registrable.

We find that ONCE A MARINE, ALWAYS A MARINE would not be perceived as a trademark to identify and distinguish applicant's goods from the like goods of others.

Decision: The refusal to register under Sections 1, 2 and 45 of the Trademark Act is affirmed.