

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Mailed:
May 2, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Eddie Bauer Licensing Services LLC

Serial No. 77585551

Miriam D. Trudell of Sheridan Ross P.C. for Eddie Bauer Licensing Services LLC.

James T. Griffin, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Walters, Zervas and Bergsman,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Eddie Bauer Licensing Services LLC ("applicant") filed a use-based application under Section 1(a) of the Trademark Act of 1946 for the phrase

OUR GUARANTEE EVERY ITEM WE SELL WILL
GIVE YOU COMPLETE SATISFACTION OR YOU
MAY RETURN IT FOR A FULL REFUND

("the Eddie Bauer guarantee") in standard character form,
for the services set forth below:

Catalog ordering service featuring
clothing, backpacks, outerwear, gloves,
sunglasses, slippers, pajamas, bags,
camera bags, luggage, travel items, pet

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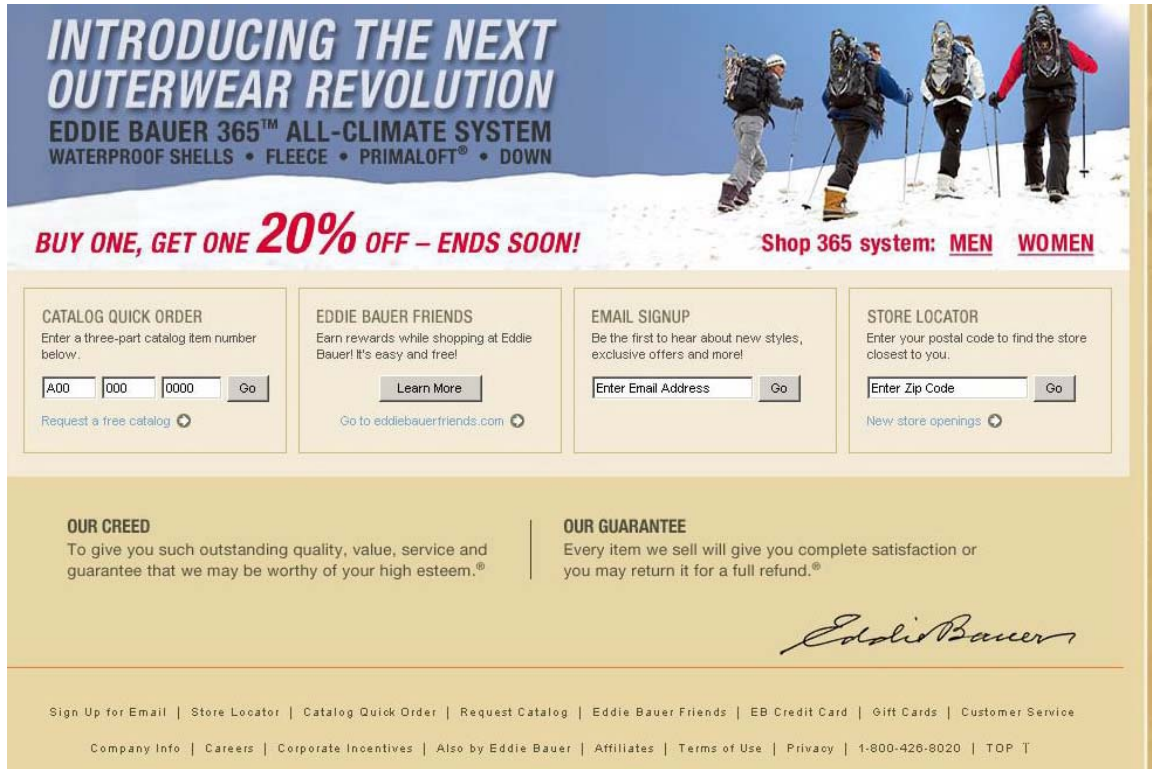
products, outdoor gear, bedding, pillows, comforters, blankets, shoes, hats, scarves, jewelry, watches, umbrellas, flashlights, multi-tools, camping equipment, picnic coolers, water bottles, first aid kits and survival kits; retail store and on-line retail store services featuring clothing, backpacks, outerwear, gloves, sunglasses, slippers, pajamas, bags, camera bags, luggage, travel items, pet products, outdoor gear, bedding, pillows, comforters, blankets, shoes, hats, scarves, jewelry, watches, umbrellas, flashlights, multi-tools, camping equipment, picnic coolers, water bottles, first aid kits and survival kits, in Class 35.

Applicant seeks registration under the provisions of Section 2(f) of the Trademark Act of 1946, 15 U.S.C. §1052(f), based on applicant's substantially exclusive and continuous use of the Eddie Bauer guarantee in commerce since 1984. Applicant also claimed ownership of Registration No. 2327854 for the Eddie Bauer guarantee mark for essentially the same services. The Office cancelled this registration because applicant failed to file a Section 8 declaration of continued use.¹

¹ Applicant claimed ownership of this registration for informational purposes. Because the effective date of the cancellation of the claimed registration was prior to the filing date of this application, the registration could not be a basis for applicant's claim of acquired distinctiveness.

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Applicant submitted a printout of a webpage and a print advertisement as its specimens of use. Portions of the webpage and the advertisement are set forth below.



INTRODUCING THE NEXT OUTERWEAR REVOLUTION
EDDIE BAUER 365™ ALL-CLIMATE SYSTEM
WATERPROOF SHELLS • FLEECE • PRIMALOFT® • DOWN

BUY ONE, GET ONE 20% OFF – ENDS SOON! Shop 365 system: **MEN** **WOMEN**

CATALOG QUICK ORDER
Enter a three-part catalog item number below.
A00 000 0000
[Request a free catalog](#)

EDDIE BAUER FRIENDS
Earn rewards while shopping at Eddie Bauer! It's easy and free!

[Go to eddiebauerfriends.com](#)

EMAIL SIGNUP
Be the first to hear about new styles, exclusive offers and more!

STORE LOCATOR
Enter your postal code to find the store closest to you.

[New store openings](#)

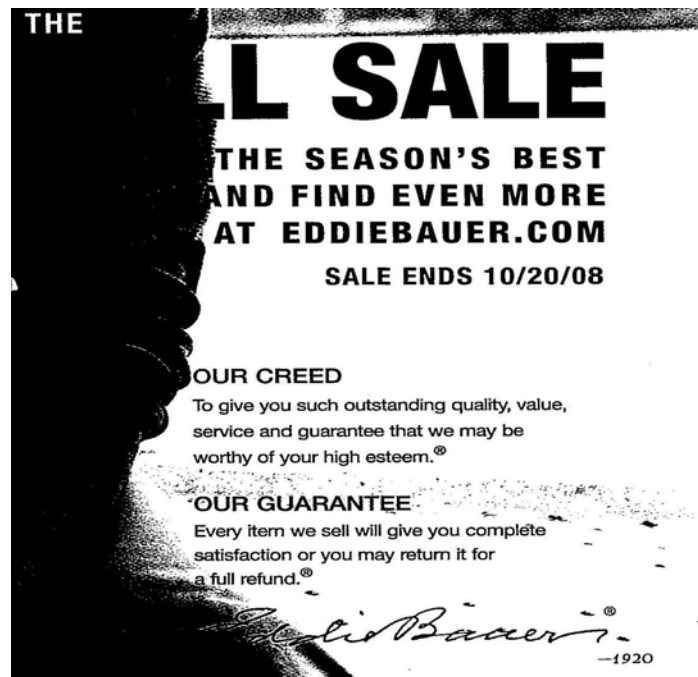
OUR CREED
To give you such outstanding quality, value, service and guarantee that we may be worthy of your high esteem.®

OUR GUARANTEE
Every item we sell will give you complete satisfaction or you may return it for a full refund.®

Eddie Bauer

[Sign Up for Email](#) | [Store Locator](#) | [Catalog Quick Order](#) | [Request Catalog](#) | [Eddie Bauer Friends](#) | [EB Credit Card](#) | [Gift Cards](#) | [Customer Service](#)

[Company Info](#) | [Careers](#) | [Corporate Incentives](#) | [Also by Eddie Bauer](#) | [Affiliates](#) | [Terms of Use](#) | [Privacy](#) | 1-800-426-8020 | [TOP](#)



THE FALL SALE
THE SEASON'S BEST AND FIND EVEN MORE AT EDDIEBAUER.COM
SALE ENDS 10/20/08

OUR CREED
To give you such outstanding quality, value, service and guarantee that we may be worthy of your high esteem.®

OUR GUARANTEE
Every item we sell will give you complete satisfaction or you may return it for a full refund.®

Eddie Bauer
—1920

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The Examining Attorney refused registration "under Sections 1, 2, 3 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, 1053 and 1127, on the ground that applicant's proposed mark does not function as a service mark in that it neither identifies and distinguishes the services of applicant from those of others, nor indicates their source."²

During the prosecution of the application, applicant submitted numerous examples of its use of the Eddie Bauer guarantee. The original specimens are representative of applicant's use. Applicant submitted a photograph of the cash register counter in one of applicant's retail stores, shown below, as a substitute specimen.³



Applicant submitted articles from publications that reference the Eddie Bauer guarantee to show that the public

² Applicant's Brief, unnumbered pages 1-2.

³ Applicant's October 6, 2009 Response.

perceives the phrase as a service mark. Excerpts from the relevant references are discussed below.

1. Legal Guide for Starting and Running a Small Business by Fred Steingold (books.google.com).⁴

Developing Your Customer Satisfaction Policy

* * *

But for starters consider the policy of Eddie Bauer - a highly successful national company that sells outdoor goods through its catalogue and retail outlets:

Our Guarantee

Every item we sell will give you complete satisfaction or you may return it for a full refund.

Our Creed

To give you such outstanding quality, value, service, and guarantee that we may be worthy of your high esteem.

* * *

But just knowing that the company stands behind what it sells has given us confidence in Eddie Bauer products. And that, of course, is the point. By reassuring customers in advance that they control the resolution of any problems, Eddie Bauer's good customer service is a marketing advantage.

⁴ This excerpt also appears in "How to build better customer relationships" in *WomenGateway.com*.

2. "Bauer, Eddie" in *Encyclopedia.jrank.org*

However, what made Eddie Bauer a success? Throughout the book *The Legend of Eddie Bauer*, a personal and business history of the Bauer corporation, author Robert Spector made it clear the Bauer's winning personality, energy, and integrity were the key elements to the Bauer's successful business style. He aimed to please and most often did, guaranteeing everything he manufactured with no exceptions. His guarantee was in writing and became famous: **"Every item we sell will give you complete satisfaction, or you may return it for a full refund."**

3. The Eddie Bauer guarantee was noted in an article in *Popular Mechanics*, "In Search of Eddie Bauer" (February 1994) as the foundation of the company's customer relations.

4. In Customers as partners: building relationships that last by Chip Bell, the author notes that Eddie Bauer's guarantee has become "wired into their ads."

5. In The Brandmindset by Duane E. Knapp, the author noted how Eddie Bauer, among others, took a routine guarantee and elevated it to the status of extraordinary to link the brand with customer loyalty.

On the other hand, the Examining Attorney argues that the Eddie Bauer guarantee is simply informational: that is, a guarantee featured in the advertisements. To show

that consumers would not perceive the Eddie Bauer guarantee as a service mark, the Examining Attorney submitted "evidence of other online retailers using similar 'satisfaction guaranteed wording.'"⁵ Three representative examples are shown below.

1. *Zazzle.com*



If you don't love it, we'll take it back!

We want you to love your creation. If you are not satisfied for any reason with the final product, you may return your purchase for a replacement or refund within 30 days of receipt.



Achieve Total Happiness

Your **satisfaction** is our top priority. If you're not absolutely satisfied with your purchase, you can return it for a full exchange or refund within 30 days of receipt.

2. *Orvis.com*

The strongest guarantee for over 150 years
The Orvis 100% Satisfaction Guarantee

For over 150 years, we have offered the strongest return policy in the business. We will refund your money on any purchase that isn't 100% satisfactory. Anytime, for any reason. It's that simple.

3. *Getodd.com*

Your **complete satisfaction** is our goal.

We stand behind the products we sell, and hope that they will bring joy, reduced stress, and a smile to your face.

⁵ June 2, 2009 Office Action.

With respect to third-party guarantees, applicant submitted the specimens from nine applications for guarantee services that were ultimately registered.⁶ According to applicant, "[a]ll of these third party marks were allowed to register despite the informational content they contain because the U.S. Patent and Trademark Office determined that these marks were capable of functioning as service marks and that the marks were used in a source-identifying fashion."⁷ Three representative examples are shown below.

1. "\$500 No-Frustration Guarantee"



⁶ October 6, 2009 Response.

⁷ *Id.*

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2. "Friendly Services, Clean Rooms, Comfortable Surroundings, Every Time. If You're Not Satisfied, We Don't Expect You To Pay, That's Our Commitment And Your Guarantee, That's 100% Hampton" in standard character form.

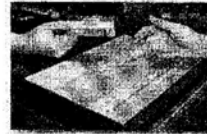


100 % Hampton



For years, Hampton has been an industry leader with our 100% Satisfaction Guarantee. That promise remains stronger than ever. It is at the heart of the changes that will be taking place at every Hampton through the end of 2004.

Newly named the "100% Hampton Guarantee," we have boldly etched it on our front desk so that it is constantly visible to our employees and our guests at check in. Our guarantee epitomizes the pride we take in our brand, our hotels, and our service to you, our guest. We'll do whatever it takes to make our guests feel welcome, relaxed, and completely comfortable.



Simply stated, the 100% Hampton Guarantee promises:

Friendly service, clean rooms, comfortable surroundings, every time.
If you're not satisfied, we don't expect you to pay.
That's our commitment and your guarantee. That's 100% Hampton.™



3. "We Guarantee The Lowest Prices Or It's Free"

WE GUARANTEE THE LOWEST PRICE or it's FREE		
2006 MODEL CLEARANCE		
2006 MONTE CARLO "LT" 3.5L V6 FWD Engine, A/C, ABS, Power Windows/Locks, Bluetooth, Alarm/Burglar, Alloy Wheels, AM/FM/CD, XM Satellite Radio, Keyless Entry with Remote Start, and More. MSRP \$22,360 \$19,661* GM FAMILY \$18,739*	2006 AVEO LS 4-DOOR 1.8L Engine, Auto, ABS, Power Locks, Cruise, Air/Air Conditioning, Aluminum Wheels, Keyless Entry, and More. MSRP \$13,965 \$13,087* GM FAMILY \$12,513*	2006 TRAILBLAZER LS 4x4 3.5L V6, Power Windows/Locks, Tire/Cross, Aluminum Wheels, Factory Backup, AM/FM/CD, On Star Service, XM Satellite Radio, Outlets, Keyless Entry, and More. MSRP \$29,700 \$23,767* GM FAMILY \$22,561*
\$259* 36 MO. LEASE TO ALL \$300 Total Due	\$319* 36 MO. LEASE TO ALL \$350 Total Due	\$319* 36 MO. LEASE TO ALL \$350 Total Due
\$237* 36 MO. LEASE TO ALL \$250 Total Due		\$259* 36 MO. LEASE TO ALL \$250 Total Due

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The issue before us is whether the Eddie Bauer guarantee, OUR GUARANTEE EVERY ITEM WE SELL WILL GIVE YOU COMPLETE SATISFACTION OR YOU MAY RETURN IT FOR A FULL REFUND, as displayed in the specimens, is used as a service mark. A service mark is "a mark used in the sale or advertising of services to identify the services of one person and distinguish them from the services of others." Section 45 of the Trademark Act of 1946, 15 U.S.C. §1127. Not every word, phrase, or slogan that appears in advertising, marketing and other sales materials function as a service mark. *In re Morganroth*, 208 USPQ 284, 287 (TTAB 1980). Thus, the mere fact that the subject matter sought to be registered appears as a distinct phrase or slogan, separate and apart from other matter, does not make it a service mark. To be a mark, the word, phrase or slogan at issue, must be used in a manner calculated to project to purchasers or potential purchasers a single source or origin of the services. The mere intent that the term, phrase or slogan function as a service mark is not enough in and of itself. *In re Morganroth*, 208 USPQ at 287. *See also In re Volvo Cars of North America Inc.*, 48 USPQ2d 1455, 1459 (TTAB 1998); *In re Remington Products Inc.*, 3 USPQ2d 1714, 1715 (TTAB 1987).

The critical question in determining whether applicant's phrase is a service mark is the commercial impression it makes on the relevant public (*i.e.*, whether it would be perceived as mark or merely as an informational phrase). *In re Volvo Cars of North America Inc.*, 48 USPQ2d at 1459; *In re Remington Products Inc.*, 3 USPQ2d at 1715; *In re Morganroth*, 208 USPQ at 287. In this regard, applicant submitted the articles from publications to show that the Eddie Bauer guarantee has become well known and, presumably, as evidence that it has acquired distinctiveness and, thus, that the public perceives the phrase as a service mark. However, the articles are not probative of consumer perceptions of the matter as a mark; rather, the articles show that business writers use the Eddie Bauer guarantee to illustrate what the writers perceive to be a successful customer satisfaction policy.

Accordingly, we must look to the specimens to determine how consumers would perceive the Eddie Bauer guarantee. *In re The Signal Companies, Inc.*, 228 USPQ 956, 957 (TTAB 1986); *In re Wakefern Food Corp*, 222 USPQ 76, 77 (TTAB 1984). We find that the primary significance of the Eddie Bauer guarantee, OUR GUARANTEE EVERY ITEM WE SELL WILL GIVE YOU COMPLETE SATISFACTION OR YOU MAY RETURN IT FOR A FULL REFUND, as used by applicant, is likely to be

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perceived as simply informational matter conveying applicant's customer satisfaction policy. For example, in the webpage specimen, the Eddie Bauer guarantee is presented at the bottom of the webpage in relatively small print immediately above the stylized signature of Eddie Bauer in larger print. Under these circumstances, consumers would perceive the Eddie Bauer stylized signature as the service mark and would perceive the Eddie Bauer guarantee as the customer satisfaction policy, not as a trademark indicating the source of any services (e.g., OUR GUARANTEE EVERY ITEM WE SELL WILL GIVE YOU COMPLETE SATISFACTION OR YOU MAY RETURN IT FOR A FULL REFUND brand of catalog ordering services).

Furthermore, as indicated by the third-party guarantees made of record by the Examining Attorney, consumers often come in contact with the guarantees and warranties offered by other retailers and manufacturers. Under the facts in this record, we find that consumers encountering the Eddie Bauer guarantee would not perceive it any differently from the way they would perceive any other information or advertising about a guarantee or warranty.

With respect to the specimens submitted by the applicant showing third-party guarantees that the Office

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previously found to be acceptable service mark use and the prior cancelled registration of the Eddie Bauer guarantee, we note that even proof that various examining attorneys have registered a particular mark in the past does not establish that there is an Office practice holding such marks are generally registrable. *See In re First Draft Inc.*, 76 USPQ2d 1183, 1188 (TTAB 2005). While we have considered the evidence submitted by applicant, the decisions made by examining attorneys to register those marks are not binding on the Board. The Board's responsibility is to focus on the record at hand. *In re First Draft Inc.*, 76 USPQ2d at 1188 n. 10. *See also In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("The Board must decide each case on its own merits ... The PTO's allowance of such prior registrations does not bind the Board or this court").

As the Eddie Bauer guarantee is presented in the specimens and other advertising submitted by applicant consumers would not attribute any service mark significance to it (*i.e.*, that the phrase identifies a brand of retail sales). *See In re Manco Inc.*, 24 USPQ2d 1938, 1942 (TTAB 1992) (THINK GREEN and design conveys ecological concerns, not source); *In re Melville Corporation*, 228 USPQ 970, 971 (TTAB 1986) (consumer's will view BRAND NAMES FOR LESS as a

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merchandising slogan conveying information about applicant's services); *In re Wakefern Food Corp*, 222 USPQ at 78 (WHY PAY MORE! would be perceived as a familiar phrase suggesting that applicant's stores offer lower prices); *In re Tilton Warren, Inc.*, 221 USPQ 86, 88 (TTAB 1984) (WATCH THAT CHILD is a familiar safety slogan and would not be perceived as a trademark); *In re European-American Bank & Trust Co.*, 201 USPQ 788, 790 (TTAB 1979) (consumers will identify THINK ABOUT as a familiar expression and would perceive its ordinary meaning).

Accordingly, we find that the Eddie Bauer guarantee, OUR GUARANTEE EVERY ITEM WE SELL WILL GIVE YOU COMPLETE SATISFACTION OR YOU MAY RETURN IT FOR A FULL REFUND, as used by applicant in its specimens, does not function as a service mark to identify and distinguish its catalog ordering services, retail store services and online retail store services.

Decision: The refusal to register is affirmed.