

THIS OPINION IS A NOT  
PRECEDENT OF THE TTAB

Mailed: May 31, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Craigslist, Inc.*

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Serial Nos. 77956067; 77956069; 77956070<sup>1</sup>

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James L. Vana of Perkins Coie LLP for Craigslist, Inc.

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Managing Attorney)

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Before Quinn, Kuhlke and Hightower, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Craigslist, Inc., filed applications to register on the Principal  
Register the peace symbol as shown below



for the following services:

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<sup>1</sup> On June 12, 2012, the Board granted the examining attorney's motion to consolidate the appeals of the above-noted applications "[i]n light of the similarity of the records and issues in these cases." Citations to the briefs and record refer to the briefs and record filed in application Serial No. 77956067; however, we have, of course, considered all arguments and evidence filed in each case.

Advertising and information distribution services, namely, providing classified advertising space via the global computer network; providing consumer product and service information via the Internet; promoting the goods and services of others over the Internet; providing an online business information directory on the Internet; computerized database management; promoting and advertising information about the professional services of others; providing on-line computer databases and on-line searchable databases featuring classified listings and want ads; providing on-line computer databases and on-line searchable databases featuring information, classified listings and announcements about employment information and resumes, job openings, volunteer information and volunteer opportunities through community and charitable organizations and businesses, information about community service programs, information about politics, business events, and business meetings; classified listings for rentals of a wide-variety of consumer and business goods; computer services, namely, providing on-line computer databases and on-line searchable databases featuring consumer information on a wide variety of topics of general interest to the consuming public, in International Class 35;<sup>2</sup>

Providing on-line computer databases and on-line searchable databases featuring information, classified listings and announcements about housing, apartments, condominiums, town homes, real estate, commercial real estate, roommate-wanted, and rental and leasing and for sale advertisements for the foregoing, in International Class 36;<sup>3</sup> and

Providing online interactive bulletin boards for transmission of messages among computer users concerning classified listings and listings for announcements, events, classes, meetings, activities, housing, real estate, roommates, rentals, for sale advertisements, commercial notices, want ads, employment, job listings, resumes, volunteerism, services, community, personals, politics, family, arts and information on a wide variety of topics of general interest to the public; providing on-line forums and discussion groups for transmission of messages among computer users concerning health, family, arts,

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<sup>2</sup> Application Serial No. 77956067, filed on March 10, 2010, based on an allegation of first use and use in commerce on August 18, 2004, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

<sup>3</sup> Application Serial No. 77956069, filed on March 10, 2010, based on an allegation of first use and use in commerce on August 18, 2004, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

politics, leisure, romance, work, and information on a wide variety of topics of general interest to the public; electronic mail services; electronic mail subscription services; and electronic transmission of messages, data and images, in International 38.<sup>4</sup>

The applications include a description of the proposed mark as consisting of “a peace symbol.” In addition, applicant’s amendment of the drawing page to depict the mark in color and to claim the color purple as a feature of the mark in each application has been accepted by the examining attorney.<sup>5</sup>

The examining attorney has refused registration on the ground that applicant’s proposed mark fails to function as a service mark to identify and distinguish applicant’s services from those of others and to indicate the source of applicant’s services under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052 and 1127.

### Prosecution History

A brief review of the prosecution history of these applications is helpful to set the stage for the issues that remain for appeal. The examining attorney initially refused registration because “the applied-for mark, as used on the specimen of record, does not function as a service mark ... .”<sup>6</sup> This refusal was based on two grounds: 1) the specimens did not support service mark use because they were

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<sup>4</sup> Application Serial No. 77956070, filed on March 10, 2010, based on an allegation of first use and use in commerce on August 18, 2004, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

<sup>5</sup> “Subsequent Final” Office Action (November 13, 2012).

<sup>6</sup> First Office Action (May 30, 2010).

“customized browser icons” otherwise known as favicons<sup>7</sup> and, as such, bore “no relation whatsoever to any particular services”; and 2) a non-distinctive depiction of the peace symbol fails to function as a mark.<sup>8</sup> In support of the refusals, the examining attorney cited to Sections 1, 2 and 45 of the Trademark Act and the May 2010 version of Trademark Manual of Examining Procedure (TMEP) §§ 904.07(b) (“Whether The Specimen Shows the Applied-for Mark Functioning as a Mark”) and 1301.02 (“What is a Service Mark”). The examining attorney included relevant information regarding the submission of substitute specimens to overcome the refusal.

In the Second Office Action, the examining attorney continued and maintained the failure to function refusal stating that “even assuming” favicons “have been recognized as protectable by [the USPTO],” applicant’s mark “does not function as a service mark because it is a universally recognized symbol (and has been for over fifty years) that would not be perceived as belonging to any one party or separating one person’s goods or services from those of another party.”<sup>9</sup> The examining attorney cited to the October, 2010 version of the TMEP § 1202.03 (“Refusal on Basis of Ornamentation”) which provided:

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<sup>7</sup> “A favicon or Favorites Icon is a small graphic that is associated with a page or Web site. The favicon allows the Web developer to customize the site in the Web browser, both in the tab bar that is displayed in many browsers as well as in the bookmarks when a site is saved. ... Most site favicons are designed as a small rendition of their logo or other branding mechanism.” <http://webdesign.about.com/od/favicon>, attached to Applicant’s Response (November 23, 2010).

<sup>8</sup> First Office Action (May 30, 2010).

<sup>9</sup> Second Office Action (December 27, 2010).

The significance of the proposed mark is a factor to consider when determining whether ornamental matter serves a trademark function. Common expressions and symbols (e.g., the peace symbol, “smiley face,” or the phrase “Have a Nice Day”) are normally not perceived as marks.

The examining attorney continued to provide applicant with information regarding the submission of a substitute specimen to overcome the refusal.

In the Third Office Action, mailed on August 7, 2011, the examining attorney made the failure to function refusal final but did not repeat the information regarding the filing of substitute specimens.

On March 4, 2012, the examining attorney denied applicant’s request for reconsideration and maintained the refusal that applicant’s proposed mark fails to function as a mark. The refusal does not mention the manner of applicant’s use, i.e., does not state that it fails to function as used on the specimen of record. In addition, the examining attorney rejected applicant’s assertion of acquired distinctiveness, in the alternative, presented in its February 7, 2012 response. Citing to the October 11, 2011 version of TMEP § 1212.02(i), the examining attorney contended that the matter is unregistrable because it is a universally recognized symbol and a claim of acquired distinctiveness cannot overcome the refusal. The examining attorney added that if the peace symbol could function as a mark applicant’s showing of acquired distinctiveness was insufficient. The examining attorney did not address applicant’s offer to amend its mark to include a color claim, referenced at the end of its February 7, 2012 response.

On May 7, 2012 and August 10, 2012, applicant and the examining attorney respectively filed briefs in this appeal. On October 1, 2012, applicant filed a request for remand for consideration of its proposed amendment to the asserted mark and in support thereof submitted a description of the mark claiming the color purple as a feature of the mark and a substitute drawing page depicting the mark as shown below.



In its request for remand, applicant stated that it “believes that its claimed color makes its Mark inherently distinctive” and that “the color purple is arbitrary as applied to the peace symbol and in connection with the services identified in the Applications.”<sup>10</sup>

On October 2, 2012, the Board granted applicant’s request for remand to the examining attorney for consideration of its proposed amendment of its mark to include the color purple. On November 13, 2012, the examining attorney accepted the amendment to applicant’s mark to include the color purple as a feature of its mark but maintained the refusal because “the color purple is not unique to applicant, nor is it unique at all.”<sup>11</sup> Far from an ‘inherently distinctive’ mark, ...

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<sup>10</sup> Request for Remand (October 1, 2012) p. 4.

<sup>11</sup> We note that the drawing page in the online application file depicts the mark in the color blue, whereas the description of the mark and the color claim reference the color purple. In order to claim color as a feature of the mark, the drawing must show the mark in color. Trademark Rule 2.52(b)(1). 37 C.F.R. § 2.52(b)(1). The description is restricted to “only

designs featuring purple peace symbols are common in commerce and are applied to a wide variety of goods and/or services. ... As a result, consumers do not and would not view such designs as indicators of source.”<sup>12</sup>

In support of the maintained refusal based on the amended mark, the examining attorney cited to the October 2012 issue of the TMEP which included a new subsection, § 1202.17, providing more detailed information regarding universal symbols. Specifically, the examining attorney stated that even with the color purple the “overall impact and impression of the universally-known peace symbol remains unchanged [because] the color purple is not unique to applicant, nor is it unique at all...designs featuring purple peace symbols are common in commerce and are applied to a wide variety of goods and/or services.”<sup>13</sup> In support of his position, the examining attorney attached additional evidence, which includes examples of use of

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those colors shown on the drawing.” TMEP § 807.07(a)(1). “When the color shown in the drawing page in a paper application, or in the digitized image of the drawing in a TEAS application, is inconsistent with the color claimed in the written application (e.g., the mark is shown in blue in the drawing, but the color claimed is orange), the drawing controls. The color claim may be corrected to conform to the drawing. The drawing may not be corrected to conform to the color claim, unless the examining attorney determines that the amendment is non-material.” TMEP § 807.07(c). It would appear the difference in the drawing color and color claim and description would have been grounds to reject the amendment inasmuch as the only option to correct at that point would have been to amend the color claim and description to the color blue, which would not be possible because the drawing depicting the proposed mark in blue does not match the specimen of use depicting the proposed mark in purple. In view of our decision, we have not remanded the application to issue an additional refusal on this basis. For purposes of our decision regarding the proposed mark that claims color, we base our analysis on the proposed mark claiming the color purple as that is the color shown in the specimens and intended to be claimed by applicant.

<sup>12</sup> Subsequent Final Office Action (November 13, 2012).

<sup>13</sup> *Id.*

purple peace symbols. Thereafter, the Board resumed proceedings and allowed applicant time in which to file a reply brief.<sup>14</sup>

Based on this history, we consider the refusal that the specimens did not support service mark use because they were “customized browser icons” to be withdrawn.<sup>15</sup> The issues remaining to be determined are: (1) whether the standard depiction of the peace symbol fails to function as a mark because it consists only of a common universal symbol; (2) in the alternative, to the extent that the standard peace symbol is capable of functioning as a mark, whether applicant’s evidence is sufficient to establish acquired distinctiveness; and (3) whether the purple peace symbol is inherently distinctive.<sup>16</sup>

In view of the above, applicant’s argument that the examining attorney did not properly withdraw the refusal based on usage as a customized browser icon is moot. In addition, applicant’s argument that in response to applicant’s request to accept its claim of acquired distinctiveness and offer to amend its mark in its request for reconsideration, the examining attorney should have issued a new non-

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<sup>14</sup> Applicant did not file a reply brief.

<sup>15</sup> Because this issue has been withdrawn it is not on appeal, we make no statement as to whether use of a designation as a favicon is sufficient to support use as a mark, other than to note the record includes several examples where it appears that the USPTO has accepted specimens of use that only depict the respective applied-for marks as favicons.

<sup>16</sup> Applicant did not argue or move to amend in the alternative that, if not inherently distinctive the purple peace symbol has acquired distinctiveness. Moreover, although there is some evidence of use of the purple peace symbol, the declaration attesting to length of use and exposure to the standard peace symbol does not reference the color and as such does not establish that it has been used in this color for all of that time. Because applicant’s request for remand and argument only pertain to its position that the purple peace symbol is inherently distinctive we reach only that issue; the question of any possible acquired distinctiveness of the purple peace symbol is not before us.



final Office action rather than simply deny the request for reconsideration, is moot in view of the subsequent remand by the Board, as noted above. Finally, applicant's argument that the examining attorney's categorization of the refusal as "failure to function" rather than "lack of distinctiveness" prevented applicant from fully responding to the refusal, is misplaced. "Lack of distinctiveness" is basically a subset of "failure to function." Here, "failure to function" is the appropriate expression of the refusal, in that the examining attorney is asserting that the proposed mark is simply the universal peace symbol, and, as such, is unregistrable without the addition of distinctive matter.

#### FAILURE TO FUNCTION

Subject matter presented for registration must be a trademark. 15 U.S.C. §§ 1051, 1052 and 1127. *In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1976) ("Before there can be registration, there must be a trademark"). Sections 1, 2 and 45 of the Trademark Act provide the statutory basis for refusal to register on the Principal Register subject matter that, due to its inherent nature, does not function as a mark to identify and distinguish an applicant's goods or services as required by the statute. Once it is determined that the applied-for designation is not capable of functioning as a mark within the meaning of the Trademark Act, a claim of acquired distinctiveness under § 2(f) cannot overcome the refusal. See TMEP § 1212.02(i) ("If matter ... fails to function as a mark, the matter is unregistrable [and] a claim that the matter has acquired distinctiveness under § 2(f) as applied to the applicant's goods or services does not overcome the refusal"). If it

is determined that a designation although not inherently distinctive may be capable of distinguishing source, such a refusal may be overcome by a showing of acquired distinctiveness. *Id.*

Typically, a universal symbol fails to function as a mark “because it only imparts information, conveys an informational message, or provides ornamentation.” TMEP § 1202.17(a). Universal symbols include designs, icons or images that are commonly used in an informational manner and convey a widely recognized or readily understood meaning when displayed in their relevant context.<sup>17</sup> As provided in the TMEP:

The determination as to whether a universal symbol in a mark functions as a source indicator involves considering the significance of the symbol, the nature of the symbol’s use in the relevant marketplace, and the impression created when the mark is used in connection with the identified goods or services. ... Weighing these considerations in view of the available facts and evidence may lead the examining attorney to the conclusion that the mark does not serve as a source indicator, but instead fails to function because it (1) imparts information about the goods or services, (2) conveys an informational message (though not necessarily about the goods or services themselves), or (3) serves only as ornamentation on the goods or services.<sup>18</sup>

Universal symbols that convey an informational message fail to function as source indicators because their significance is based on their underlying message rather than serving as source identifiers.<sup>19</sup>

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<sup>17</sup> TMEP § 1202.17.

<sup>18</sup> TMEP § 1202.17(c)(i).

<sup>19</sup> TMEP § 1202.17(c)(i)(A).

An otherwise unregistrable universal symbol may be “considered registrable matter if it is highly stylized, if it incorporates elements that are not usually in the symbol, or if it is integrated with other matter in the mark, and, as a result a distinctive commercial impression separate and apart from the symbol’s usual significance is created or a source-indicating unitary whole is formed. ... However, displaying an accurately depicted universal symbol as a replacement for a letter in a mark’s literal element normally will not change the symbol’s usual impression (or create a unitary whole), nor will minor alterations to the symbol, such as slight stylizations or nondistinctive changes to color scheme or proportions.”<sup>20</sup>

#### Standard Peace Symbol

The examining attorney contends that “the applied-for mark does not function as a service mark because it is a pervasive universally-recognized symbol (and has been for over fifty years) that would not be perceived as belonging to any one party or separating one person’s goods or services from those of another party. ... [A]pplicant’s proposed mark is a ubiquitous, non-distinctive icon, instantly recognizable to the general public in any context.”<sup>21</sup> In support of the refusal, the examining attorney attached printouts from a variety of third-party websites using and/or discussing the peace symbol. A few examples are reproduced below:

The internationally recognized symbol for peace was originally designed for the British nuclear disarmament movement ... on 21 February 1958 by Gerald Holtom... The symbol was later adopted by the Campaign for Nuclear Disarmament (CND). It was adopted by first the 1960s anti-war movement, then the counterculture, and

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<sup>20</sup> TMEP § 1202.17(b)(ii).

<sup>21</sup> E. A. Br. p. 5-6.

finally the popular culture of the time. ... In Unicode, the peace sign is U+262E. ([www.wikipedia.org](http://www.wikipedia.org), attached to First Office Action (May 30, 2010));

The Peace Symbol ... the anti-nuclear emblem or the peace sign is one of the most widely known symbols in the world. It was invented on the request of lord [B]ertrand [R]ussell, head of the [B]ritish 'campaign for nuclear disarmament' or CDN ... the symbol was quickly adopted in the US ... deliberately never copyrighted, the symbol ... is ... known worldwide for peace and non-violence. No one has to pay or to seek permission before they use it as a symbol of freedom it is free for all ([www.designboom.com](http://www.designboom.com), attached to First Office Action (May 30, 2010));

One of the most widely known symbols in the world ... . In the United States and much of the rest of the world it is known more broadly as the peace symbol. ... Although specifically designed for the anti-nuclear movement it has quite deliberately never been copyrighted. No one has to pay or to seek permission before they use it. A symbol of freedom, it is free for all. This of course sometimes leads to its use, or misuse, in circumstances that CND and the peace movement find distasteful. It is also often exploited for commercial, advertising or generally fashion purposes. ([www.docspopuli.org](http://www.docspopuli.org), attached to First Office Action (May 30, 2010));

The Peace Symbol ... Few symbols are as recognized and cherished in the world as the peace symbol. ([www.bukisa.com](http://www.bukisa.com), attached to Second Office Action (December 27, 2010));

The Peace Symbol – Born in the Boomer Era ... The peace symbol has become the universally recognized icon of peace. (<http://ezinearticles.com>, attached to Section Office Action (December 27, 2010)); and

The peace sign symbol is one of the most widely used symbols in the world ... The peace sign is displayed in many places, including social networking websites like [www.myspace.com](http://www.myspace.com). You can find a peace sign symbol online and then copy and paste it on your MySpace page, or you can make your own using a word processing program like Microsoft Word. ([www.ehow.com](http://www.ehow.com), attached to Final Office Action (August 7, 2011)).

Based on the evidence, the examining attorney concludes that the peace symbol "has managed to cross borders and span generations and has found

relevance in a host of contexts ... [and] [f]or applicant to now suggest that consumers would associate this iconic symbol (with no other additional matter) with its particular services, after existing for over fifty years in the public domain, is simply not supported by the evidence of record.”<sup>22</sup>

The record amply demonstrates and applicant acknowledges that the proposed mark is the universal symbol that conveys the message of supporting peace.<sup>23</sup> In addition, the record establishes that the peace symbol is commonly used in virtually any context and always conveys the message of peace.

In view of the above, without the addition of distinctive matter, the peace symbol cannot serve a source-indicating function and may not be appropriated by one entity.

In responding to the refusals, applicant made of record several third-party registrations for peace symbols arguing that the evidence supports the proposition that the peace symbol is capable of functioning as a mark.<sup>24</sup> However, in each

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<sup>22</sup> E. A. Br. p. 8.






<sup>23</sup> App. Br. p. 10 (“the peace symbol is commonly associated with pacifism”); see also TMEP § 1202.17(c)(i)(A).

<sup>24</sup> Applicant also submitted smiley face registrations which have less relevance to this case as they comprise a different symbol. In connection with this evidence, applicant references the unpublished case *Loufrani v. Wal-Mart Stores, Inc.*, 91152145 slip op. at 14 (March 20, 2009) for the proposition that the smiley face symbol may be registrable upon a showing of acquired distinctiveness. In *Loufrani* the Board stated:

The evidence shows that the “smiling face” is a common, non-inherently distinctive design. ... Inasmuch as Wal-Mart’s smiling face design is not inherently distinctive, we must determine if it acquired distinctiveness prior to Loufrani’s priority date...

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example the peace symbol contains other distinctive elements. A few examples are highlighted below.


Registration No.	Mark	Goods/Services
Reg. No. 3201897		hats, jackets, shirts, and sweat shirts
Reg. No. 3768888		men's, women's, and children's apparel
Reg. No. 3010850		Wine
Reg. No. 3928639		bumper stickers, decals, and decorative decals for vehicle windows, stickers
Reg. No. 3962378	 (mark described	hats, jackets, shirts

We first note that unpublished cases are not binding on the Board. *In re Luxuria s.r.o.*, 100 USPQ2d 1146, 1151 n.7 (TTAB 2011); TBMP § 101.03. In addition, the mark involved in



that case, (claiming the color yellow), contains the added design elements of shading and tilting that suggest movement. While the additional design elements may be minimal, the symbol is not displayed in the usual manner. See TMEP § 1202.17(b)(ii).

	as “the stylized letter ‘C.’ Inside the letter ‘C’ is the peace symbol.”)	
Reg. No. 38337000		human apparel, namely shirts, sweatshirts, sneakers and shoes

Finally, applicant claims ownership of Registration No. 3856547, filed on February 24, 2010 and issued on October 5, 2010, for the peace symbol design  for goods identified as “Downloadable software for use in viewing and posting classified advertising, consumer product and service information, product and service rental information and advertising, and consumer information on a wide variety of topics of general interest to the consuming public; downloadable software for use in accessing electronic mail services and for electronic transmission of messages, data and images.” The mark is described as “a peace symbol” and color is not claimed as a feature of the mark. Applicant argues that its prior registration demonstrates secondary source. However, because we find the accurate depiction of the peace symbol to be unregistrable it cannot be considered as a secondary source or acquire distinctiveness based on its prior registration. While the USPTO strives for consistency, “[t]he Board must decide each case on its own merits ... Even if some prior registrations had some characteristics similar” to the instant

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applications, such decisions in other application files are not binding on the Board.  
*In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

### Purple Peace Symbol

With regard to the added color claim, the examining attorney argues that the amendment “is merely a ‘nondistinctive change[] to [the] color scheme’ of the mark. The overall impact and impression of the universally-known peace symbol remains unchanged. Even as applied to the peace symbol, the color purple is not unique to applicant, nor is it unique at all. ... [D]esigns featuring purple peace symbols are common in commerce and are applied to a wide variety of goods and/or services. As a result, consumers do not and would not view such designs as indicators of source.”<sup>25</sup> Below are a few examples of purple peace signs used in a variety of contexts submitted by the examining attorney:



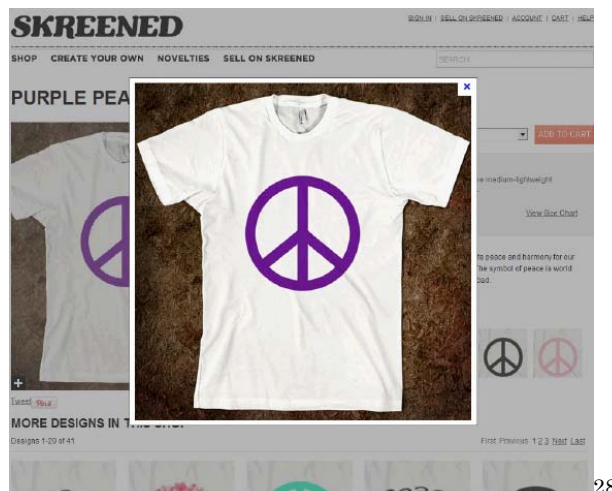
<sup>25</sup> Subsequent Final Office Action p. 3.

<sup>26</sup> Various items a displaying purple peace sign offered for sale at [www.peaceproject.com](http://www.peaceproject.com).





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<sup>27</sup> Purple peace sign used as part of an embellished contact box design offered for use at [www.zingerbug.com/contact\\_table](http://www.zingerbug.com/contact_table).

<sup>28</sup> <http://skreened.com>.



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The record includes evidence of the peace symbol in its usual form used ubiquitously in the color purple in a variety of contexts. We find that the purple color claim is not sufficiently distinctive to transform the universal peace symbol into an inherently distinctive mark, even as to applicant's specific services.

In conclusion, the record establishes that the standard peace symbol is a universal symbol that retains its message in all contexts, including applicant's services. In view thereof, it fails to function as a mark and is incapable matter. Because we find that the standard peace symbol does not function as a mark and is unregistrable we do not address applicant's arguments that there is sufficient acquired distinctiveness to allow registration under Section 2(f). TMEP § 1212.02(i) ("[W]here the examining attorney has determined that matter sought to be registered is not registrable because it is not a mark within the meaning of the Trademark Act, a claim that the matter has acquired distinctiveness under § 2(f) as applied to the applicant's goods or services does not overcome the refusal.") Finally, the record establishes that the standard peace symbol rendered in the color purple is not inherently distinctive.

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<sup>29</sup> <http://wanelo.com>.

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