

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

Mailed:
April 20, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Michael Sones

Serial No. 78717427

James R. Menker of Holley & Menker, P.A. for Michael Sones

Brian D. Brown, Supervisory Attorney Advisor, Law Office
102 (Karen M. Strzyz, Managing Attorney).¹

Before Seeherman, Quinn and Kuczma, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Michael Sones has applied to register ONE NATION UNDER
GOD, in standard character form, for "charity bracelets."²

¹ Mr. Brown is referred to in the file as both a "supervisory attorney advisor" and a "supervisory senior examining attorney." We recognize that Mr. Brown is a senior attorney who has supervisory duties, but for ease of reference we will use the term "examining attorney" to refer to him in this opinion.

² Application Serial No. 78717427, filed September 21, 2005. The application was initially based on Section 1(b) of the Trademark Act (intent-to-use); applicant subsequently filed a Statement of Use claiming first use and first use in commerce on February 14, 2007.

This is the second time this application has been before the Board on appeal. The examining attorney who initially examined this application had issued a final refusal under sections 1, 2, and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052, and 1127, for failure to function as a trademark as used on the specimen of record. See final action issued July 23, 2007. Applicant's specimen was deemed unacceptable to show trademark use as a display associated with the goods because the electronic catalog page or webpage did not show the mark in close proximity to a picture of the goods. The Board affirmed that refusal in a decision mailed September 30, 2008,³ finding that the specimen did not show trademark use of the mark, and did not satisfy the criteria for a point of sale display associated with the goods, as set forth in *Lands' End Inc. v. Manbeck*, 797 F.Supp. 511, 24 USPQ2d 1314 (E.D. Va. 1992) and *In re Dell, Inc.*, 71 USPQ2d 1725 (TTAB 2004), i.e., that the specimen (1) include a picture of the relevant goods and (2) show the mark sufficiently near the picture of the goods to associate the mark with the goods.

Applicant appealed the Board's decision to the Federal Circuit, which vacated the Board's decision and remanded

³ Two of the judges who decided the first appeal have since retired, and one passed away.

the application. *In re Sones*, 590 F.3d 1282, 93 USPQ2d 1118 (Fed. Cir. 2009). The Federal Circuit held that a picture is not a mandatory requirement for a website-based specimen of use, and that the test for an acceptable website-based specimen, just as any other specimen, is simply that it must in some manner evidence that the mark is "associated" with the goods and serves as an indicator of source. The Office was specifically instructed as follows:

On remand, the PTO must consider the evidence as a whole to determine if Sones' specimen sufficiently associates his mark with his charity bracelets so as to "identify and distinguish the goods." *BellSouth*, 60 F.23d at 1569;⁴ see also *Damn I'm Good, Inc. v. Sakowitz, Inc.*, 514 F.Supp. 1357 [212 USPQ684] (S.D.N.Y. 1981) (finding "Damn I'm Good" on bracelets to be ornamental, not source-identifying.) (footnote added).

93 USPQ2d at 1123. The Court indicated certain relevant factors for determining whether the mark is sufficiently associated with the charity bracelets (whether the webpages have a point of sale nature; whether the actual features or inherent characteristics of the goods are recognizable from the textual description; and, although not dispositive, whether the designation "TM" leads a degree of visual

⁴ *BellSouth Corp. v. DataNational Corp.*, 60 F.3d 1565, 35 USPQ2d 1554 (Fed. Cir. 1995).

prominence to the term), and stated that they and other factors "will help determine whether Sones' mark 'signifies the source and quality of the goods.'" Id., citing *Int'l Flavors and Fragrances Inc.*, 183 F.3d 1361, 51 USPQ2d 1513, 1516 (Fed. Cir. 1999).

On April 27, 2010, the Board remanded the application to the examining attorney to "consider the evidence as a whole to determine whether applicant's webpage specimen sufficiently associates his mark with his charity bracelets so as to identify and distinguish the goods." p. 3.

On remand, Mr. Brown became responsible for examining the application. In an Office action mailed June 28, 2010, he made two refusals of registration, both pursuant to Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052 and 1127, on the basis that the applied-for matter fails to function as an indicator of source because it is informational and is merely ornamental. Specifically, the examining attorney asserted that the mark would be perceived only as a phrase from the pledge of allegiance signifying a sense of patriotism.

Applicant responded to this Office action, asserting, inter alia, that it was improper for the examining attorney to raise new refusals in the June 28, 2010 Office action. The examining attorney subsequently issued a final Office

action on February 28, 2011 maintaining the refusals, and proceedings in the appeal were resumed, with both applicant and the examining attorney filing appeal briefs.

We turn first to a procedural issue. Applicant states that the examining attorney "extensively supplemented the record with [a] voluminous amount [of] new evidence including in the February 28, 2011 Office action to which Applicant was not given an opportunity to address or respond," and that "Applicant avers that the record was closed when the TTAB rendered its decision and that the new refusals and evidence are improperly raised." Brief, p. 5.

On appeal, the Board will review only the correctness of a substantive refusal to register, and will not consider whether the examining attorney's issuance of the refusal is procedurally in error. *In re Sambado & Sons Inc.*, 45 USPQ2d 1312, 1314-15 (TTAB 1997). *See also In re Greenliant Systems Ltd.*, 97 USPQ2d 1078, 1080, n. 3 (TTAB 2010); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1373 (TTAB 2006); TBMP § 1201.05 (3d ed. 2011). If applicant had wished to challenge the propriety of the examining attorney's raising the refusals that he did on remand, applicant should have done so by a timely petition to the Director, i.e., within two months of the issuance of the

Office action in which these refusals were first made. See Trademark Rule 2.146(d).

As for applicant's statement that he was not given an opportunity to address or respond to the "voluminous amount" of new evidence, applicant did respond to the June 28, 2010 Office action, which was designated as a "non-final" action, and which included the "six-months-response" clause. It is true that upon the issuance of the February 28, 2011 Office action, which contained additional evidence, the application was returned to the Board, which then resumed proceedings in the appeal. However, the trademark examiner has the "last word" in terms of issuing an Office action (including the submission of evidence), whether that action is a final Office action or a denial of a request for reconsideration. In this case, the examining attorney was directed by the Board that, if a final Office action were to issue, the examining attorney was to return the application to the Board for resumption of proceedings in the appeal. Applicant did not, as usually occurs with a final Office action, have an opportunity to file a request for reconsideration, because a request for reconsideration can be filed as of right only when it is filed before or

with a notice of appeal.⁵ Applicant had filed his notice of appeal three years earlier, and therefore filing a request for reconsideration at this point in the proceeding would not have been available to him; in fact, applicant had filed a request for reconsideration on January 23, 2008, along with his notice of appeal, and the application was remanded to the examining attorney that same day to consider that request. If applicant had felt that he needed, in fairness, to submit additional evidence in response to the evidence submitted by the examining attorney with the February 28, 2011 final Office action, the proper course was to file with the Board a request for remand, supported by a showing of good cause. The Board would then have determined whether, given the circumstances, good cause had been shown, and determined whether or not to remand the application so that any additional evidence applicant wished to submit would become part of the record.

Because applicant did not file a petition to the Director to challenge the propriety of the refusals, or request remand from the Board in order to submit additional

⁵ Although it is very unusual, it is technically possible for a request for reconsideration to be filed as of right even if it is filed after the filing of a notice of appeal, as long as it is filed within six months of the issuance of the final refusal, and briefing has not begun. See TBMP § 1204.

evidence, we give no further consideration to his complaints about procedure.⁶

Turning to the substantive issues on appeal, it appears to us that there is one statutory basis for the refusals, that applicant's proposed mark fails to function as a mark, and therefore is not eligible for registration under Sections 1, 2 and 45 of the Trademark Act. Specifically, Section 1 requires that only a *trademark* may be registered: "(a)(1) The owner of a trademark used in commerce may request registration of its trademark,"; Section 2 states that the trademark must act as a trademark to indicate source: "No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless"; and Section 45 defines what a trademark is:

The term "trademark" includes any word, name, symbol, or device, or any combination thereof—
 (1) used by a person, or
 (2) which a person has a bona fide intention to use in commerce and applies to register on

⁶ We also point out that the Office has the inherent right to raise a refusal of registration, as the mandate of the Office is to issue registrations only for valid marks. See *Last Best Beef LLC v. Dudas*, 506 F.3d 333, 84 USPQ2d 1699, 1704 (4th Cir. 2007) (USPTO has authority to "cancel or suspend the trademark registrations, applications, and Notices of Allowance" due to its inherent discretion to correct its own errors and to manage its own docket); TBMP § 1209.02 ("the mandate of the USPTO is to register only eligible marks").

the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

The two refusals, that the applied-for matter is informational and that it is ornamental, are merely the reasons why the proposed mark fails to function as a mark, with different lines of cases cited to support the reasoning behind each refusal.

We first consider the refusal that the proposed mark is merely informational. The examining attorney contends that the applied-for mark is a common, informational statement that fails to identify and distinguish applicant's goods from those of others or to indicate their source. He asserts that "ONE NATION UNDER GOD is such a common phrase universally signifying a sense of patriotism and displayed for the message it conveys that it is incapable of being perceived as a trademark in this case." Brief, unnumbered p. 5. In support of his position he has submitted a large amount of evidence indicating that ONE NATION UNDER GOD is a well-known phrase from the Pledge of Allegiance, and is frequently mentioned in articles and used by third parties in connection with the sale of their

products. The following are examples of articles, highlighted by the examining attorney in his brief:

To help you do that, our friends at Gateways to Better Education are offering Breakpoint listeners a free poster of the American flag that also has an explanation for each phrase of the Pledge—including what it means to be one nation under God.

www.breakpoint.org/bpcommentaries/entry/13/15183
February 28, 2011 Office action, p. 2.

(We note that the language quoted by the examining attorney comes from an article entitled "One Nation Under God," written by Chuck Colson and published on August 27, 2010. The extreme right side of each page of the article has been cut off, and in fact some of the language quoted above does not appear in the screen shot submitted with the Office action.⁷ From the portion of the article that is visible, it seems to say that U.S. liberties come from God, and the poster is being distributed to parents so that they can remind their children of this principle.)

A billboard in Arizona displaying, in large letters, ONE NATION UNDER GOD, with "A Reminder from Clear Channel Outdoor" shown in much smaller size below.

<http://cardhouse.com/travel/az/billboards/billboards/htm>

Feb. 28, 2011 Office action, p. 13

Man says Home Depot fired him over God button
(title)

... Keezer said he'd been wearing an American flag button on his Home Depot apron since he began working as a cashier at the store in March 2008. The button read, "One nation under God, indivisible."

"I've worn it for well over a year and I support my country and God," Keezer said Tuesday. "I was

⁷ We assume that the examining attorney, during his research, was able to view the entire page.

just doing what I think every American should do,
just love my country."

"USA Today," posted October 28, 2009

June 28, 2010 Office action, p. 5.

The following are examples of products being offered by
third parties using the phrase ONE NATION UNDER GOD:

Pages from the amazon.com website, featuring on
one webpage "One Nation Under God Italian Charm
Bracelet," for sale at \$10.65, and on another
"10K Yellow Gold One Nation Under God Lapel Pin"
offered for sale at \$114.99

www.amazon.com

June 28, 2010 Office action, pp. 10 and 12.

A webpage from Christianbook.com showing metal
tags next to the heading "USA One Nation Under
God Tag", below which is "Shields of
Strength/Gift." Next to this text are
photographs of the front and back of the tag, the
front showing "United States of America, One
Nation Under God" appearing on two lines at the
top of the tag, above a depiction of what is
clearly an American flag, and the back of the tag
containing a biblical quote from Joshua.

www.christianbook.com/usa-one-nation-under-god-
tag/pd/1-2170X

February 28, 2011 Office action, p. 5.

The JMJ Products LLC website, featuring "Tri
Color One Nation Under God Wristband" for sale at
\$3.99

www.totallycatholic.com

June 28, 2010 Office action, p. 8.

A webpage from Mardi Gras Imports offering for
sale party beads with "One Nation Under God" on
them.

www.mardigrasimports.com

February 28, 2011 Office action, p. 15.

The Imagination Gone Wild website, listing
products under the heading "Shop One Nation Under
God," and featuring "One Nation Under God Tshirt"
and "One Nation Under God Decal"

www.imaginationgonewild.com
June 28, 2010 Office action, p. 13

A webpage from Zazzle offering "One Nation Under God Beverage Coaster" and showing a coaster with these words, along with a representation of an American flag.
www.zazzle.com
February 28, 2011 Office action

We begin our analysis with the recognition that:

[N]ot every word or combination of words which appears on an entity's goods functions as a trademark. *In re Morganroth*, 208 USPQ 284 (TTAB 1980). Thus, the mere fact that an applicant's phrase appears on the specimens, even separate and apart from other indicat[ors] which appear on them, does not make it a trademark. To be a mark, the phrase must be used in a manner calculated to project to purchasers or potential purchasers a single source or origin for the goods. Mere intent that a term or phrase function as a trademark is not enough in and of itself.

In re Volvo Cars of North America Inc., 46 USPQ2d 1455, 1459 (TTAB 1988) (finding DRIVE SAFE for automobiles does not function as a mark).

It is obvious that ONE NATION UNDER GOD would be understood by virtually all Americans as a phrase from the Pledge of Allegiance. In fact, many of the exhibits submitted by the examining attorney in which this term appears use the term to reference the Pledge of Allegiance, or patriotism. However, the mere fact that ONE NATION UNDER GOD has this meaning does not, *per se*, make it

incapable of functioning as a trademark.⁸ This meaning and common use of the phrase, however, makes it more difficult for applicant to overcome the examining attorney's evidence and show that the public views ONE NATION UNDER GOD as a source-indicator for his charity bracelets, rather than merely as a phrase providing information as to the nature of the bracelets. *See Reed v. Arnoco Oil Co.*, 611 F.Supp 9, 225 USPQ 876 (M.D. Tenn. 1984) (the more commonly a phrase is used in everyday parlance, the less the likelihood that it will be recognized by purchasers as a trademark); *In re Volvo Cars of North America, Inc.*, 46 USPQ2d at 1461 ("as a matter of competitive policy, it should be close to impossible for one competitor to achieve exclusive rights' in common phrases or slogans," quoting 1 McCarthy, *McCarthy on Trademarks and Unfair Competition* § 7:23 (4th ed.)).

The numerous uses by third parties of ONE NATION UNDER GOD in an informational manner for their goods are strong support for the examining attorney's position. The evidence shows that the use of ONE NATION UNDER GOD for

⁸ In this connection, we note that applicant has submitted two third-party registrations for marks containing or consisting of the phrase ONE NATION UNDER GOD, one for a cross with the letters O, N, U and G in the four spaces created by the cross design prominently displayed, and with ONE NATION UNDER GOD in small letters under this design, for clothing items (Reg. No. 3767173),

various products, including jewelry and wristbands, is ubiquitous, and that these third parties use the phrase to provide information about their goods. This is similar to the evidence in *In re Wakefern Food Corp.*, 222 USPQ 76 (TTAB 1984), in which the applicant attempted to register WHY PAY MORE! for supermarket services. In refusing registration on the ground that the matter did not function as a service mark, the examining attorney submitted newspaper advertisements of three food stores, and twenty-four other businesses, which used the same slogan in advertisements or store displays. On the basis of this evidence, the Board found that WHY PAY MORE! did not function as a service mark. The Board stated, at page 78:

We fully agree with the Examining Attorney that this relatively common merchandising slogan does not act or function as a mark which identifies and distinguishes applicant's services from those of others. This commercial phrase, in our opinion, would not be perceived by the public as a service mark identifying the source of applicant's services. Rather, this familiar phrase would be perceived as an expression suggesting that applicant's stores offer lower food prices than others while the SHOP RITE sign is likely to be seen as the sole indicator of origin.

and one for fireworks (Reg. No. 3071941), as well as his own registration for metal dog tags (Reg. No. 3707015).


We recognize that in the present case, as opposed to *Wakefern*, applicant uses a TM symbol next to ONE NATION UNDER GOD in its specimen of use:

Beaches Chapel School


Page 1 of 5

Beaches Chapel School Store

Youth & Adult Sizes Available

 View Cart

Click here for Size Chart




ONE NATION UNDER GOD™ CHARITY BRACELET

» for \$2.00

ONE NATION UNDER GOD™


CHARITY BRACELET

CHOICE OF BLUE OR RED \$2.00 EACH


Color: Select One 


Add to Cart

Click here for Size Chart




Youth Polo » for \$15.00


Color: Select One 

Size: Select One 

Add to Cart

Girls Short Sleeve Peter Pan Collar Blouse » for \$15.00

Color: Select One 

Size: Select One 

Add to Cart

<http://www.beacheschapel.com/UniformStore.htm>

2/13/2007

Your Shopping Cart - PayPal
Page 1 of 1

Beaches Chapel Church and School

Your Shopping Cart

| Item | Options | Quantity | Remove |
|------------------------------------|---------------------------|----------|--------------------------|
| ONE NATION UNDER GOD™ Item #102 | field 1 not used: red: | 1 | <input type="checkbox"/> |

Subtotal:

Shipping & Handling:

PayPal protects your privacy and security.
For more information, read our [User Agreement](#) and [Privacy Policy](#).

<https://www.paypal.com/cgi-bin/webscr>
A-26
2/13/2007

However, the inclusion of a TM symbol, signifying that the matter is being claimed as a trademark, does not in and of itself mean that consumers will perceive it to be a trademark. *See In re Volvo Cars of North America Inc.*, 46

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USPQ2d at 1461; *In re Manco*, 24 USPQ2d 1938, 1942 n.11 (TTAB 1992).

Applicant's use of his asserted mark must be considered in the context of the third-party uses, which are very similar to applicant's use. See, for example, the amazon.com offer of the "One Nation Under God Italian Charm Bracelet":

http://www.amazon.com/dp/B001Y43VK2/ref=asc_df_B001Y43VK21136921?tag=the004-20&creative=380333&creativeASIN=B001Y43VK2&linkCode=asn 06/27/2010 08:58 08 AM

amazon.com Hello, Brian Brown. We have recommendations for you. (Not Brian?) Your Amazon Browser History Internet Explorer 9 Optimized for Amazon.com

Brian's Amazon.com Today's Deals Gifts & Wish Lists Gift Cards Your Account Help

Shop All Departments Search Jewelry GO Cart Wish List

Jewelry What's New Diamonds Gemstones Silver Gold Pearls Engagement Rings Wedding & Anniversary Education & Buying Guides On Sale Now

One Nation Under God Italian Charm Bracelet
by Pugster

No customer reviews yet. [Be the first.](#)

List Price: ~~\$27.54~~
Price: ~~\$21.34~~
Sale: **\$10.65**
You Save: **\$16.99 (61%)**
[Special Offers Available](#)

In Stock.
Ships from and sold by **Pugster Inc.**
Gift-wrap available.

\$10.65 + \$5.00 shipping
In Stock. Sold by **Pugster Inc.**
Quantity: 1
Add to Cart
or
[Sign in](#) to turn on 1-Click ordering.
Add to Wish List

Express checkout with PayPhrase
Brian's True Rhythms
[What's this?](#) [Create PayPhrase](#)
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[See larger image and other views](#)

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[Learn more about jewelry and watches](#)

Special Offers and Product Promotions

- Free elegant cushioned Gift box available with every order from Pugster. Hassle-free Gift giving idea is perfect for any gift occasion. [Here's how](#) (restrictions apply)
- Shop worry free with our 30-day return, exchange policy with any purchase from Pugster. [Here's how](#) (restrictions apply)
- Pugster offers High-quality Italian Charms at Affordable prices. Choose from a large assortment of variety and start designing your own bracelet. Create personalized gifts for friends and family with Pugster Italian charms. [Here's how](#) (restrictions apply)
- FREE SHIPPING! Free USPS First Class Shipping on all orders of \$35.00 or more! [Here's how](#) (restrictions apply)

Product Specifications

Jewelry Information
Brand Name: Pugster

or the "Tri Color One Nation Under God Wristband":

The screenshot shows the JMJ Products LLC website. The header includes the company name, logo, and website URL. A search bar is present. The left sidebar lists various product categories. The main content area displays the 'Tri Color One Nation Under God Wristband' product, including its description, price (\$3.99), and availability. Below the product, there are 'Add to Cart', 'View Cart', and 'Checkout' buttons. A 'View Large Image' link is also provided. At the bottom, there is a section for 'Other Related Products' featuring three additional items: 'Tri Color One Nation...', 'Red Rosary Wristband...', and 'Divine Mercy Jesus w...'. Each related product shows a small image, name, price, and a 'More Details' link.

JMJ PRODUCTS LLC
www.TotallyCatholic.com

SEARCH IN TOTALLYCATHOLIC.COM: GO

[Home](#) [View Cart](#)

[Catholic Jewelry](#) >> [Wristbands](#) >> [Tri Color One Nation Under God Wristband](#)

Tri Color One Nation Under God Wristband



Tri color red, white and blue 'tie dye' look bands - \$3.99 each

Price: **\$3.99** Stock Availability: **In Stock**

[Add to Cart](#) [View Cart](#) [Checkout](#)

[View Large Image](#)

Other Related Products:

| | | |
|--|--|---|
|  <p>Tri Color One Nation... Price: \$3.99 More Details</p> |  <p>Red Rosary Wristband... Price: \$1.99 More Details</p> |  <p>Divine Mercy Jesus w... Price: \$3.5 More Details</p> |
|--|--|---|

Left Sidebar Categories:

- Fonts and Bottles
- Candles
- Catholic Saints Statues
- Special Occasion
- Car Devotionals
- Kids and Baby
- Pictures - Wall Hangings
- Holy Cards
- Catholic Scapulars
- Catholic Jewelry
- Saints Coins
- Crucifixes
- St. Joseph House Selling Kits
- Shop By Saint
- From The Holy Land
- Saints Relic Items
- Catholic Patron Saints Medals

Right Sidebar Categories:

- OVAL
- St. An
- Holy T
- Our Le
- St. Ber
- GIFT B
- Rosary
- Little I
- Mirror
- Christ

Against this backdrop, we must conclude that because of the manner in which applicant displays ONE NATION UNDER GOD the phrase would not be viewed by consumers as a source-indicator for charity bracelets, but merely as giving information about them, in the same way that consumers would view such third-party uses as "One Nation Under God Italian Charm Bracelet," "10K Yellow Gold One Nation Under God Lapel Pin" and "Tri Color One Nation Under God

Wristband" as giving information about the respective bracelets, pins and wristbands.

In fact, the manner in which applicant uses the asserted mark on his specimen, along with and in a similar manner to the offering of "Youth Polo" and "Girls Short Sleeve Peter Pan Collar Blouse," would convey to most purchasers that ONE NATION UNDER GOD is similarly informational, rather than indicating source. We recognize that ONE NATION UNDER GOD appears in all capital letters, while the Youth Polo and Girls Short Sleeve Peter Pan Collar Blouse listings are in initial capital letters. However, consumers are not likely to treat ONE NATION UNDER GOD as a source-indicator because of this difference inasmuch as the other information appearing in this block, including the generic term CHARITY BRACELET and the informational phrase CHOICE OF BLUE OR RED \$2.00 EACH, is shown in all capital letters as well. Thus, consumers are likely to view the all upper case depiction of ONE NATION UNDER GOD as simply a font style choice.

After having considered all the evidence and arguments, including those not specifically addressed herein, we find that ONE NATION UNDER GOD, as used on applicant's specimens, would not be viewed as an indication of source but merely as informational, and therefore it

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fails to function as a trademark for charity bracelets.

The refusal on this basis is therefore affirmed.

In view thereof, we need not address the refusal on the basis that ONE NATION UNDER GOD is ornamental for charity bracelets.

Decision: The refusal based on the ground that applicant's proposed mark fails to function as a trademark because it is merely informational is affirmed.