This Opinion is Not a Precedent of the TTAB

Mailed: November 23, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Donald E. Moriarty

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Serial No. 86367823

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

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

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Before Shaw, Larkin and Hudis,
Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

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

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

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

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

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

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

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

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

I. Preliminary matters

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

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

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

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

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

[6] *Id.*

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

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

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

[8] *Id.*

II. Failure to function as a mark

"'[A] proposed trademark is registrable only if it functions as an identifier of the source of the applicant's goods or services.'" *In re Yarnell Ice Cream, LLC*, 2019 USPQ2d 265039, *16 (TTAB 2019) (quoting *In re DePorter*, 129 USPQ2d 1298, 1299 (TTAB 2019)). "'The Trademark Act is not an act to register mere words, but rather to register trademarks. Before there can be registration, there must be a trademark, and unless words have been so used they cannot qualify.'" *Id.* (quoting *DePorter*, 129 USPQ2d at 1299 (quoting *In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1976)).

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

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

identify only one source and the less likely that it will be recognized by purchasers as a trademark." *Id.*

With his Statement of Use, Applicant filed the single specimen shown below, comprising a DVD case featuring a cover for a movie entitled *HERCULES RECYCLED 2.0.* The applied-for mark appears on the left side of the image below, i.e., on the back of the DVD case, as part of the wording "WORST MOVIE EVER! presents a Cole and Sean Production™ Steve Reeves in Hercules Recycled 2.0™".

The Examining Attorney argues that the applied-for mark WORST MOVIE EVER! is merely a commonplace slogan used by a variety of sources and merely conveys an ordinary, familiar or well recognized concept or sentiment, that is, "[t]he applied-for mark conveys the ordinary and well recognized concept that the movie in

question is the most wanting in quality, value or condition of all time."[9] In support of the refusal, the Examining Attorney submitted a number of news stories and articles about movies to establish that the phrase "WORST MOVIE EVER!" is commonly used by the authors to convey the idea that the movie being discussed is "the most wanting in quality, value or condition of all time."[10] The following examples are most relevant (all with emphasis added):

1) A New York Post article stating "How James Franco made the '**worst movie ever**' into something good" (Office Action of July 20, 2018, TSDR p. 2).

2) A Screenrant web site article stating "Often called the **worst movie ever** to win Best Picture, *Crash* has been criticized for its message on race relations in the United States" (Office Action of July 19, 2019, TSDR p. 58).

3) An article in The Guardian describing a "follow-up [movie] to the '**worst movie ever**'" and stating "[Actor] Sestero also starred in *The Room*, … described as 'the **worst movie ever**'" (Office Action of July 19, 2019, TSDR pp. 59-61).

4) An article on the web site of TheMarySue.com discussing whether *Twilight* was the "**Worst Movie Ever**?" (Office Action of July 19, 2019, TSDR p. 64).

5) An article in The Sun newspaper web site stating that "Netflix's new festive film *Christmas Wedding Planner* slammed as '**worst movie ever**' by viewers" and "viewers of Netflix's new festive special … have dubbed it the '**worst movie EVER**'" (Office Action of July 19, 2019, TSDR p. 68).

6) Reviews from the Rotten Tomatoes movie review web site stating: "Crowned as the '**worst movie ever made**' back in the 1980 book *The Golden Turkey Awards*, [*Plan 9 From Outer Space*] is the movies' most famous Z-grade clunker"; and the movie *Manos: The Hand of Fate* is "A serious contender for the "**worst-worst movie ever made**" (Office Action of July 20, 2018, TSDR pp. 10 and 19).

[9] Examining Attorney's Br., 9 TTABVUE 5.

[10] *Id*.

7) An article in The Guardian (US edition) entitled "*Ishtar* at 30: is it really the **worst movie ever made**?" (Office Action of July 20, 2018, TSDR p. 28).

8) A Mental Floss article stating: "Libby Coleman over at Ozy found that *Ballistic: Ecks vs. Sever* (2002) may actually be the **worst movie ever made**"; "If you go by the Razzies, the **worst movie ever** is Adam Sandler's cross-dressing 'comedy' *Jack and Jill*"; and "*Empire's* 50 **Worst Movies Ever** list gave the dishonor to Joel Schumacher's Batman and Robin[.]" (Office Action of July 20, 2018, TSDR pp. 37 and 39).

9) A Vanity Fair article entitled "The **worst movie ever made**?" providing a review of the movie *Chooch*. (Office Action of July 20, 2018, TSDR pp. 41-42).

10) A Geeks.media article entitled "*Armageddon*: The Best **Worst Movie Ever Made**" (Office Action of July 20, 2018, TSDR p. 44).

11) An article on the web site Some Drunk Blogger stating "*Downsizing* is the **Worst Movie Ever Made**" (Office Action of July 20, 2018, TSDR p. 49).

12) A Roosevelt Island Daily article stating "*Why Gone with the Wind* is the **Worst Movie Ever Made**" and "the **worst movie ever**" (Office Action of July 20, 2018, TSDR p. 52-53).

13) An article in The Atlantic asking "is [*Birdemic: Shock and Terror*] the **worst movie ever made**?" (Office Action of July 20, 2018, TSDR p. 56).

14) A Wikipedia article providing a list of "**worst films ever made**" (Office Action of July 19, 2019, TSDR p. 7).

15) A Screenrant web site article discussing Every Batman Movie Ever, Ranked and stating "*Batman & Robin* is not just the prime candidate for the worst Batman movie ever made – it might just be the **worst movie ever made**, ever." (Office Action of July 19, 2019, TSDR p. 46).

The Examining Attorney argues that, in light of this evidence, the applied-for mark fails to function as a trademark:

> [C]onsumers of movies – the relevant public – would perceive the applied-for mark as a commonplace term or expression rather than as an indicator of the source of applicant's goods. Consumers who are accustomed to seeing or using this phrase would not regard the applied-

> for mark as being capable of distinguishing the source of applicant's goods from those of another.[11]

The record before us establishes that the phrase WORST MOVIE EVER! is frequently used by newspapers, magazines, media sites, movie reviewers, and others to describe really bad movies, or as the Examining Attorney argues, movies that are "the most wanting in quality, value or condition of all time."[12] Among movie-watchers and reviewers, much time and effort has been spent debating which movie deserves the characterization "worst movie ever." Although there is no shortage of candidates, surprisingly, there is significant public interest in watching really bad movies. That is, some of these movies are so bad they have become popular because of their campy badness. The record includes a number of references to movies that have become popular despite being really bad. For example:

- The New York Post describes the movie *The Disaster Artist* as "a truly awful movie that has become a cult classic."[13]
- The movie-review web site Rotten Tomatoes lists "24 MOVIES SO BAD THEY'RE UNMISSABLE." Rotten Tomatoes further describes the movies as "HORRIBLE! UTTERLY HORRIBLE! AND YET, FASCINATING...".[14]
- Wikipedia's "List of films considered the worst" includes summaries of nearly one-hundred of the worst films ever made, chosen in part based on

[11] *Id*. at 7.

[12] *Id*. at 5.

[13] Office action of July 20, 2018, TSDR p. 2.

[14] *Id*. at 8.

awards they received for being so bad. These awards include The Golden Turkey Awards, the Golden Raspberry Awards, and the Stinkers Bad Movie Awards.[15] Summaries of the individual movies include descriptions such as a "disastrous flop turned cult classic",[16] "far too entertaining to be considered as the worst film ever made",[17] and "one of the 100 Most Enjoyably Bad Movies Ever Made"[18]

- A review of *Birdemic: Shock and Terror* states that the movie is "one of those so bad it's good films" and "so dumbfounding that it ends up being compelling viewing[.]"[19]

In addition, some of the really bad movies described in the record, like Applicant's identified films, are parodies of other movie genres. For example, the Wikipedia listing includes reviews of *Leonard Part 6*, a parody of spy movies;[20] *Epic Movie*, a parody of fantasy movies;[21] *Disaster Movie*, a parody of disaster movies;[22] and *Meet the Spartans*, a parody of historical fantasy movies.[23] Thus, parodies such as

[15] Office Action of July 19, 2019, TSDR p. 7.

[16] *Reefer Madness*, *id.* at 10.

[17] *Plan 9 from Outer Space*, *id.* at 12.

[18] *The Swarm*, *id.* at 15.

[19] Theatlantic.com, Office Action of July 20, 2018, TSDR p. 56.

[20] Office Action of July 19, 2019, TSDR p. 19.

[21] *Id.* at 28.

[22] *Id.* at 29.

[23] *Id.*

Applicant's fall within the genre of movies that are so bad that they are good, i.e., "cult classics."

The movie depicted in Applicant's single specimen, shown above, appears to follow the well-worn path of movies that are so bad, they are good. Applicant's DVD case—in addition to featuring the applied-for mark WORST MOVIE EVER!—identifies a movie entitled HERCULES RECYCLED 2.0 and includes enticements to prospective consumers of bad movies such as "Slow Death through Bad Cinema", "CHEESY HERCULES MOVIES", and "two teenagers a green screen & a laptop". The cover of Applicant's Hercules-based parody also includes images depicting dogs with multi-colored Mohawk haircuts and sunglasses, a character named "Gaylord The Wonder Cockroach™", and, as is not uncommon in the genre, a scantily clad woman.

The function of a trademark is to identify a single commercial source of goods or services. Applicant's use of the phrase WORST MOVIE EVER! simply informs prospective consumers that Applicant's movies are part of the cinematic genre of really bad movies. Because consumers are accustomed to seeing the phrase "worst movie ever!" used by newspapers, magazines, media sites, movie reviewers, and others to describe similar movies, these consumers would not view the applied-for mark as a trademark indicating that Applicant is the sole source of parodies of really bad motion picture and television films bearing the mark. Applicant is not entitled to appropriate the phrase to himself and thereby attempt to prevent competitors from using it to promote the sale or viewing of their own really bad movies. *In re Melville Corp.*, 228 USPQ 970, 972 (TTAB 1986) (describing the phrase BRAND NAMES FOR

LESS as "a highly descriptive and informative slogan [that] should remain available for other persons or firms to use to describe the nature of their competitive services"). "[A]s a matter of competitive policy, it should be close to impossible for one competitor to achieve exclusive rights" in common phrases. 1 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 7:23 (5th ed. Sept. 2019).

Applicant conceded that the examples of "worst movie ever" in the Examining Attorney's evidence "did convey information about the films they referred to."[24] Applicant nevertheless argues that "in addition to the words themselves and their commercial context, the position and styling of Applicant's mark on the specimen of record . . . creates a unique commercial impression that is capable of source indication and is not merely informational".[25] We disagree.

Applicant's use of WORST MOVIE EVER! on the DVD case does not establish that the proposed mark would be perceived by the relevant public as a source indicator. Submission of an otherwise acceptable specimen, such as a label, bearing the proposed mark will not obviate the refusal; the mere fact that the matter appears on a technically good specimen does not mean that it would be perceived as a mark. *See D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d 1710, 1716 (TTAB 2016) (finding that the phrase I ♥ DC "does not create the commercial impression of a source indicator, even when displayed on a hangtag or label"). Instead, based on the evidence of widespread use of the phrase by others to describe really bad movies, we find that

[24] Applicant's Br., p. 8, 7 TTABVUE 9.

[25] *Id*. at 9, 7 TTABVUE 10.

consumers are likely to perceive that WORST MOVIE EVER! simply informs them that the enclosed movie belongs to the genre of movies that must be watched because they are so bad.

Applicant further argues that many of the Internet excerpts made of record by the Examining Attorney are irrelevant because they show the applied-for mark in the context of a sentence, but not as a slogan. "Applicant's contention . . . is that the context of Applicant's mark without usage in a sentence creates a different commercial impression that is not merely informational."[26] This argument is unpersuasive. As noted above, the phrase WORST MOVIE EVER! would be perceived simply as referring to the movie genre of movies that are so bad that they are good. Here, given the widespread use of the phrase, the primary purpose of WORST MOVIE EVER! is to convey information about the products being sold, nothing more.

Applicant also argues that the Examining Attorney's evidence falls short because it does not show "that film production companies use the term WORST MOVIE EVER! to convey information about their own films."[27] This argument is unpersuasive as well. It is not necessary that the evidence show use by competitors. Rather, it is sufficient if the evidence establishes that potential purchasers would perceive the phrase as merely an informational slogan devoid of trademark significance. *See In re Manco Inc.*, 24 USPQ2d 1938 (TTAB 1992) (evidence of use by media and businesses

[26] *Id.* at 8-9.

[27] *Id.* at 11.

in a variety of industries established that the slogan THINK GREEN for mailing and shipping items and weather-stripping does not function as a trademark).

Simply put, Applicant's intent that WORST MOVIE EVER! function as a trademark does not make it so. "Mere intent that a term function as a trademark is not enough in and of itself, any more than attachment of the trademark symbol would be, to make a term a trademark." *In re Remington Prods., Inc.*, 3 USPQ2d 1714, 1715 (TTAB 1987); *see also Apollo Med. Extrusion Techs., Inc. v. Med. Extrusion Techs., Inc.,* 123 USPQ2d 1844, 1855 (TTAB 2017); *In re Vertex Grp. LLC*, 89 USPQ2d 1694, 1701 (TTAB 2009) ("[M]ere intent that a word, name, symbol or device function as a trademark or service mark is not enough in and of itself."); *In re Morganroth*, 208 USPQ 284, 287 (TTAB 1980) ("Wishing does not make a trademark or service mark be."). If, as here, the evidence shows that the public would not perceive the proposed mark as serving to indicate the source of the identified goods, it does not function as a mark and may not be registered regardless of the manner of use depicted on the specimen.

Applicant argues that since other informational phrases have registered, such as "WORST-CASE SCENARIO" for use in connection with video games, books, and audiovisual programs, his mark should be entitled to registration as well. "While we recognize that 'consistency is highly desirable,' consistency in examination is not itself a substantive rule of trademark law, and a desire for consistency with the decisions of prior examining attorneys must yield to proper determinations under the Trademark Act and rules." *In re Am. Furniture Warehouse CO*, 126 USPQ2d 1400,

1407 (TTAB 2018) (quoting *In re Omega SA*, 494 F.3d 1362, 83 USPQ2d 1541, 1544 (Fed. Cir. 2007)). We "must assess each mark on its own facts and record." *Id.* The fact that the USPTO registered "WORST-CASE SCENARIO" on a different record for use in connection with different goods does not entitle Applicant to register WORST MOVIE EVER! for "parody of motion picture films and films for television comprising comedies and dramas featuring a mashup of different motion picture films".

Finally, in his Reply Brief, Applicant argues that the Examining Attorney's refusal is foreclosed because it was not issued prior to publication of the mark:

> Applicant maintains that since the Examiner sent the Application to Publication and issued a Notice of Allowance, the Examiner also believed that the mark WORST MOVIE EVER! was capable of acting as a trademark. It is clear error that the Examiner should suddenly do an about face about the ability of the mark itself to function as a trademark once the Statement of Use was filed.[28]

This argument is unavailing. USPTO practice does not require that a failure to function refusal issue during first examination of an application filed under Trademark Act Section 1(b):

> The issue of whether a designation functions as a mark usually is tied to the use of the mark, as evidenced by the specimen. Therefore, unless the drawing and description of the mark are dispositive of the failure to function without the need to consider a specimen, generally, no refusal on this basis will be issued in an intent-to-use application under § 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), until the applicant has submitted a specimen(s) with an

[28] Applicant's Reply Br., p. 2, 10 TTABVUE 3.

> allegation of use (i.e., either an amendment to allege use under 15 U.S.C. § 1051(c) or a statement of use under 15 U.S.C. § 1051(d)).

TMEP § 1202.

Moreover, even if Applicant's drawing and description of the mark were dispositive of the mark's failure to function without the need to consider a specimen, there is no restriction in the Trademark Act or Trademark Rules of Practice as to the point in time prior to registration when the USPTO may issue a new requirement or new refusal. TMEP § 706.01; *In re Driven Innovations, Inc.,* 115 USPQ2d 1261, 1264 (TTAB 2015), *overruled on other grounds*, 674 Fed. Appx. 996, 2017 WL 33574 (Fed. Cir. 2017).[29]

In summary, we find that WORST MOVIE EVER! 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 Applicant's mark WORST MOVIE EVER! on the ground that it fails to function as a trademark under Sections 1, 2, and 45 of the Trademark Act is affirmed.

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[29] Consistent with USPTO practice, in the first Office Action, the Examining Attorney advised Applicant that upon review of an allegation of use, a refusal may be issued finding that the applied-for mark fails to function as a mark under Trademark Act Sections 1, 2, 3 and 45 because it is the title of a single work. (Office Action of December 2, 2014.) The Examining Attorney's advisory regarding the title of a single work refusal does not preclude the issuance a refusal that the mark is merely informational. *See* TMEP § 1202:

> [I]n a § 1(b) application for which no specimen has been submitted, if the examining attorney anticipates that a refusal will be made on the ground that the matter presented for registration does not function as a mark, the potential refusal should be brought to the applicant's attention in the first Office action. This is done strictly as a courtesy.