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Precedent of the TTAB

Mailed: December 21, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Home Dynamix, LLC

Serial No. 87116576

Paul E. Paray of Paray Law Group, LLC,
for Home Dynamix, LLC.

Emma Sirignano, Trademark Examining Attorney, Law Office 113,
Odette Bonnet, Managing Attorney.

Before Ritchie, Masiello, and Heasley,
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

Home Dynamix, LLC (“Applicant”) seeks registration on the Principal Register of
DESIGNED WITH YOU IN MIND (in standard characters) for “Wholesale
distributorship featuring consumer goods, namely, floor covering such as rugs and
mats, flooring material such as laminates, bedding linens, animal beds, and bathroom
accessories” in International Class 35.¹

¹ Application Serial No. 87116576 was filed on July 26, 2016, based upon Applicant’s claim of
first use anywhere and use in commerce since at least as early as March 25, 2016.

The Trademark Examining Attorney has refused registration of Applicant's proposed mark under Trademark Act Sections 1, 2, 3, and 45, 15 U.S.C. §§ 1051, 1052, 1053, and 1127, on the ground that it is a common informational message that fails to function as a service mark. After the refusal was made final, Applicant requested reconsideration. The Examining Attorney denied the request for reconsideration, and Applicant appealed. For the following reasons, we affirm the refusal to register.

I. Discussion

A. Applicable Law

We note that “[t]he 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...” *In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1976) *quoted in In re Keep A Breast Foundation*, 123 USPQ2d 1869, 1879 (TTAB 2017). The Office is statutorily constrained to register matter on the Principal Register if and only if it functions as a mark. *Id.* To function as a service mark, a proposed mark must, by definition, “identify and distinguish the services of one person ... from the services of others and ... indicate the source of the services, even if that source is unknown.” 15 U.S.C. § 1127.

“Mere intent that a term or phrase function as a trademark is not enough in and of itself. ... ‘Wishing does not make a trademark or service mark be.’” *Apollo Medical Extrusion Techs., Inc. v. Medical Extrusion Techs., Inc.*, 123 USPQ2d 1844, 1855 (TTAB 2017) (quoting *In re Morganroth*, 208 USPQ 284, 287 (TTAB 1980)) (internal punctuation omitted). The critical inquiry in determining whether a designation

functions as a mark is how it would be perceived by the relevant public. *D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d 1710, 1713 (TTAB 2016). To be a mark, it must be used in a manner that would readily be perceived by purchasers as identifying the specified services and distinguishing a single source or origin therefor. *In re Roberts*, 87 USPQ2d 1474, 1478 (TTAB 2008). TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) § 1301.02(a) (Oct. 2017).

Informational phrases or slogans commonly used in advertising or promotions are not typically perceived as source indicators. *E.g.*, *In re Standard Oil Co.*, 275 F.2d 945, 125 USPQ 227 (CCPA 1960) (GUARANTEED STARTING found to be ordinary words that convey information about the services, not a service mark for the services of “winterizing” motor vehicles); *In re Eagle Crest, Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010); *In re Melville Corp.*, 228 USPQ 970 (TTAB 1986) (BRAND NAMES FOR LESS found to be informational phrase that does not function as a mark for retail store services). “[I]f a mark consists entirely of a slogan that is ... merely informational, or that is otherwise not being used as a mark, registration must be refused.” TMEP § 1213.05(b)(i). A ubiquitous phrase or slogan emanating from multiple sources would not create the commercial impression of a mark. *D.C. One Wholesaler*, 120 USPQ2d at 1714-16; *see In re First Union Nat’l Bank*, 223 USPQ 278, 280 (TTAB 1984) (virtually impossible for commonly used phrases such as “Sale Today” or “We Sell at Low Prices” to be perceived as identifying and distinguishing services).

In sum, commonly used informational phrases are not registrable because they fail to perform the essential functions of a mark. Because they are commonly used by

multiple sources, they do not identify and distinguish one person's goods or services from those of others, and because they are merely informational, they fail to indicate the source of the goods or services. 15 U.S.C. § 1127; *see generally Examination Guide 2-17, Merely Informational Matter* 4-6 (July 2017); TMEP § 1202.04. They must instead remain in the public domain, available to all competitors. *In re Volvo Cars of N. Am., Inc.*, 46 USPQ2d 1455, 1460 (TTAB 1998).

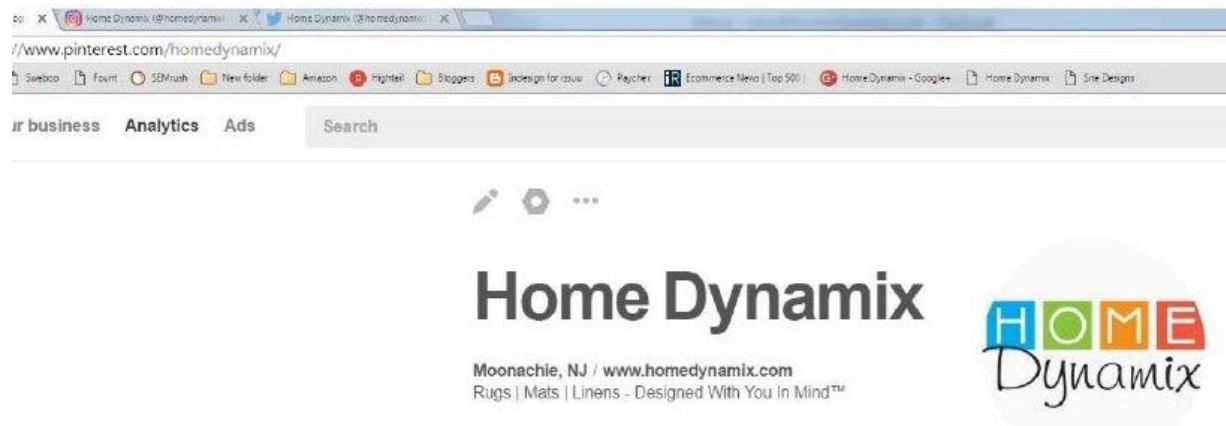
Under the principles set forth above, the critical inquiry becomes: Would the phrase DESIGNED WITH YOU IN MIND be perceived as a source indicator or as a common informational phrase or slogan? *See In re Volvo Cars of N. Am., Inc.*, 46 USPQ2d at 1459; *see also In re Aerospace Optics, Inc.*, 78 USPQ2d 1861, 1862 (TTAB 2006). "The critical inquiry in determining whether a designation functions as a mark is how the designation would be perceived by the relevant public." *D.C. One Wholesaler*, 120 USPQ2d at 1713. That perception turns on the proposed mark's wording and the nature and context of its use in the marketplace. *Examination Guide 2-17 Merely Informational Matter* 2-3; TMEP § 1202.04.

B. The Examining Attorney's Evidence and Arguments

To establish whether purchasers encountering the proposed mark are likely to perceive it as indicating the source of Applicant's services or as merely conveying information, the Examining Attorney must review the evidence in the application record, particularly the specimens and identification of goods or services, and should also adduce evidence from other sources, such as dictionaries, encyclopedias, Applicant's and third parties' websites, trade publications, news articles, social

media, retail and other websites. *Id.*; *In re Keep A Breast Foundation*, 123 USPQ2d at 1879.

The Examining Attorney refers to Applicant's two specimens. The first consists of its webpage on Pinterest:



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The second specimen consists of a photograph of the entrance to its showroom:



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² July 26, 2016 specimen, Pinterest.com/HomeDynamix/.

³ March 30, 2017 specimen.

In both specimens, the phrase “DESIGNED WITH YOU IN MIND” is subordinated to Applicant’s more prominently displayed HOME DYNAMIX marks. In the first specimen, the slogan appears in small print in the phrase “Rugs|Mats|Linens-Designed With You In Mind™”. The Examining Attorney argues that the slogan, placed in the midst of information about Applicant’s goods, would be perceived as informational. The Examining Attorney points out that a similar situation arose in *In re Wakefern Food Corp.*, 222 USPQ 76 (TTAB 1984) where the applicant’s proposed mark, the relatively common merchandising slogan WHY PAY MORE for supermarket services, was set in the midst of informational advertising:⁴

WHY PAY MORE FOR GROCERIES?

WHY PAY MORE? COME AND GET IT!

MORE MEAT FOR LESS. WHY PAY MORE?

The Board found that “WHY PAY MORE” would not be perceived by the public as a service mark, but as a familiar commercial phrase meaning “that applicant’s stores offer lower food prices than others while the SHOP RITE sign [applicant’s trade name] is likely to be seen as the sole indicator of origin.” *Id.* at 78.

The Examining Attorney has introduced dictionary definitions of the words composing the slogan “DESIGNED WITH YOU IN MIND.” According to the Merriam-Webster Dictionary, “DESIGNED” means “to create, fashion, execute, or construct according to plan,” “WITH” “indicate[s] the object of attention,” “YOU”

⁴ Examining Attorney’s brief, 6 TTABVUE 13-14.

means “the one or ones being addressed,” and “IN MIND” means “in one’s thoughts.”⁵ Taken together in a phrase, the words convey the message that the producer thinks its goods or services are suitable for the customer’s intended use. The Merriam-Webster Dictionary provides this example of use of the phrase “in mind”: “We designed this product with people like you in mind.”⁶

To reinforce the finding regarding the informational nature of the phrase, the Examining Attorney adds excerpts from newspaper articles retrieved from the LEXIS database using the phrase in an informational manner, e.g.:

- “Airline seats are not **designed with you in mind.**” *Chicago Tribune*, March 6, 1994;
- “The Senior Games has an event **designed with you in mind.**” *El Paso Times*, March 19, 2004;
- “If you’re the wife or widow of a retired commissioned or warrant officer or you’re a woman who is a retired military officer, ROWS was **designed with you in mind.**” *The Virginian-Pilot* (Norfolk, VA.), May 15, 2008;
- “Since kids are particularly partial to bananas, these recipes are **designed with them in mind.**” *Newsday*, April 24, 1988.⁷

⁵ Merriam-Webster.com 6/1/2017, June 2, 2017 Office Action TSDR pp. 11, 14, 20, 21. All references to the Trademark Status and Document Retrieval site (“TSDR”) are to the pdf version.

⁶ *Id.* TSDR p. 14.

⁷ June 2, 2017 Office Action TSDR pp. 5-8.

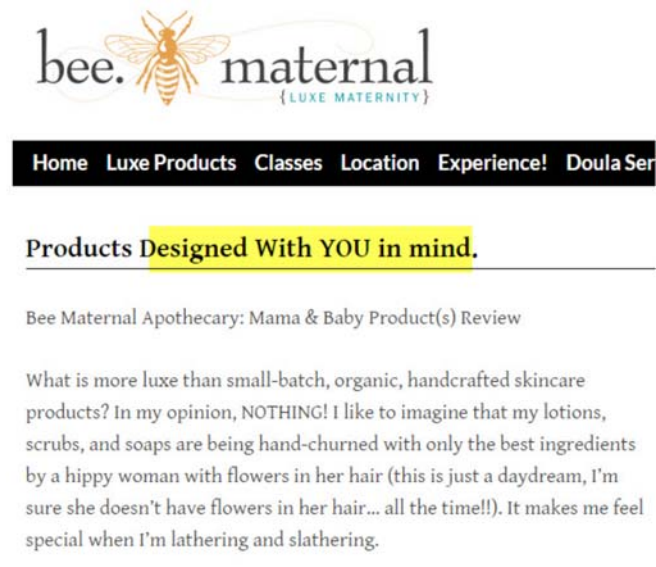
Newspaper articles of this sort show how the phrase is used in everyday writing to convey information about disparate subjects, be they airline seats, athletic games, clubs or recipes.⁸

The Examining Attorney has also adduced evidence from approximately 25 third-party websites showing that this slogan is commonly used as an informational phrase in the marketplace, *e.g.*:



⁸ Examining Attorney's brief, 6 TTABVUE 13.

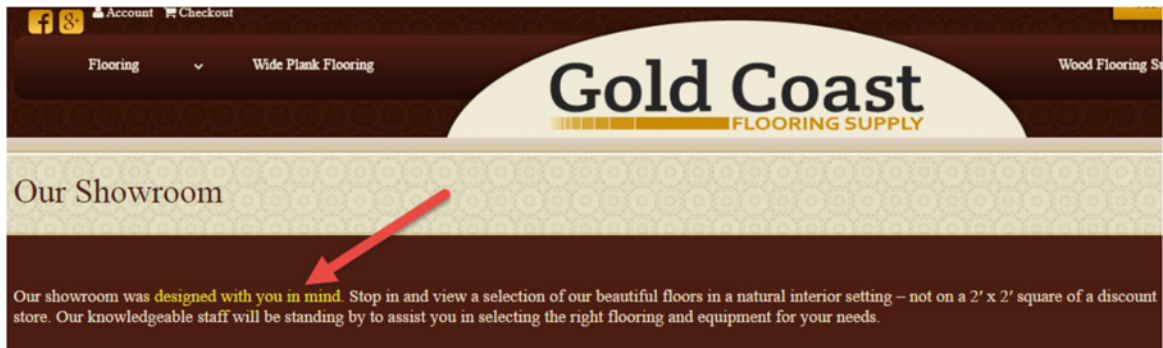
⁹ Aqua-Tots.com 5/7/2017, May 8, 2017 Office Action TSDR p. 4.



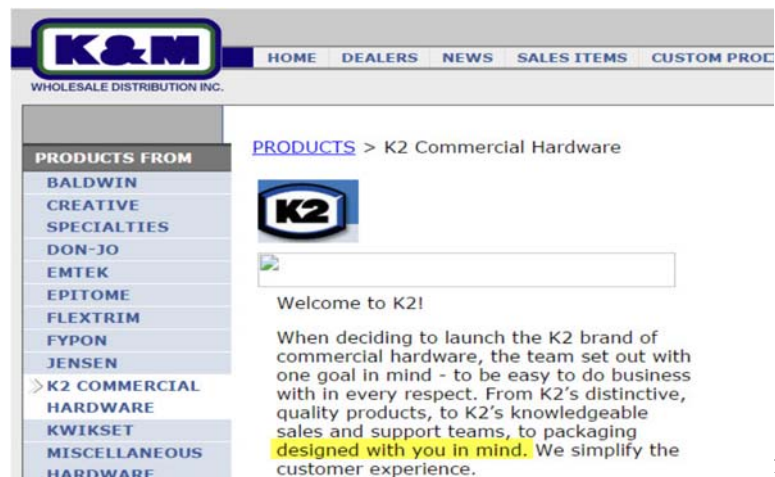
To emphasize the point, the Examining Attorney adds examples from flooring showroom and wholesale businesses:

¹⁰ WeddingShoppeInc.com 4/21/2017, April 24, 2017 Office Action TSDR p. 7.

¹¹ Bee-Material.com 5/7/2017, May 8, 2017 Office Action TSDR p. 5.



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¹² GoldCoastFlooring.com 6/1/2017, June 2, 2017 Office Action TSDR p. 12.

¹³ KandMWholesale.com 6/1/2017, June 2, 2017 Office Action TSDR p. 15.

¹⁴ OwenCarpet.com 6/1/2017, June 2, 2017 Office Action TSDR p. 18.



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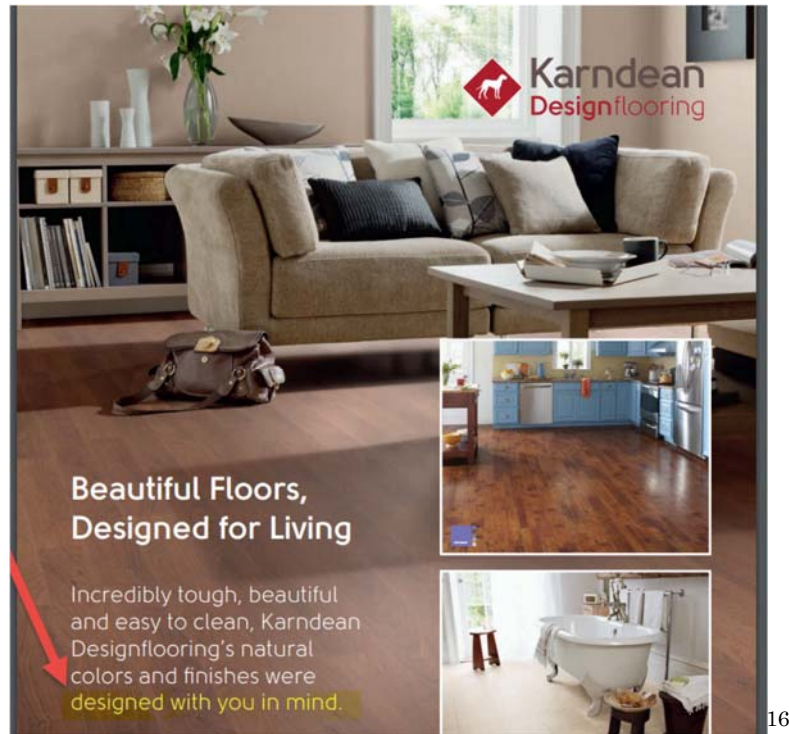
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The Examining Attorney has, in sum, adduced evidence in the form of specimens depicting Applicant's use of the phrase, dictionary definitions, newspaper articles, and third-party websites demonstrating widespread use of "designed with you in mind" as a phrase that imparts general information other than source.

C. Applicant's Response

In view of the Examining Attorney's evidence and arguments, it is incumbent upon Applicant to provide evidence that relevant consumers would recognize DESIGNED WITH YOU IN MIND as a source indicator that distinguishes its services from those of others. *Examination Guide 2-17, Merely Informational Matter* 12 (citing *In re Tilcon Warren, Inc.*, 221 USPQ 86, 88 (TTAB 1984)).

¹⁶ TaliankoDesignGroup.com 6/2/2017, June 2, 2017 Office Action TSDR p. 22.

Applicant argues that none of the Examining Attorney's third-party examples uses the phrase in the context of Applicant's identified services—a wholesale distributorship for home products.¹⁷ This distinction is important, Applicant argues, because its wholesale distributorship caters to wholesale buyers, namely retailers, rather than retail consumers and flooring contractors, to whom the third-party advertising is directed.¹⁸ “Again, as to the flooring consumer and contractor marketplace, there are only four cited instances of the alleged promotional phrase ‘designed with you in mind,’” Applicant suggests. Applicant further argues that its services “have no overlap with the usage cited by the Examining Attorney in that Applicant ... only expressly uses this Mark with regards to wholesale buyers, namely retailers, rather than retail consumers or flooring contractors.”¹⁹

Applicant submits that even if the phrase “DESIGNED WITH YOU IN MIND” is generally used promotionally, as indicated by the third-party evidence above, the retailers to whom Applicant offers its identified services would nonetheless perceive the phrase as a source indicator. In support of this distinction, Applicant analogizes to likelihood-of-confusion cases under Section 2(d), 15 U.S.C. § 1052(d), where identical marks for consumer goods were differentiated from marks for business-to-business services. *Citing, e.g., Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not

¹⁷ Applicant's brief p. 3, 4 TTABVUE 8.

¹⁸ *Id.* at p. 9, 4 TTABVUE 14.

¹⁹ *Id.*

confusingly similar to LITTLE PLUMBER and design for advertising services, namely the formulation and preparation of advertising copy and literature in the plumbing field).²⁰ It also analogizes to “the sister test” of genericness, since generic and informational matter are both unable to indicate a particular source of goods or services, and cannot function as marks.²¹ See TMEP § 1213.05(b)(1) (“[I]f a mark consists entirely of a slogan that is generic, ... merely informational, or that is otherwise not being used as a mark, registration must be refused.”). Applicant quotes the Federal Circuit for the proposition that “The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question.” *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). Similarly here, Applicant argues, there is no evidence that the relevant public of retailers would interpret DESIGNED WITH YOU IN MIND to refer in any way to the genus of Applicant’s wholesale distributorship services. “Rather, the evidence presented by the Examining Attorney is a hodgepodge of sentences spread across various decades far removed from any cohesive ‘slogan’ or common usage,” Applicant concludes.²² Applicant points out that this use of the phrase across the decades did not prevent the USPTO from issuing eight certificates of registration on the Principal Register to different registrants for DESIGNED WITH YOU IN MIND for a variety

²⁰ *Id.* at 8-9, 4 TTABVUE 13-14.

²¹ *Id.* at 14-15, 4 TTABVUE 19-20.

²² *Id.* at 15-16, 4 TTABVUE 20-21.

of goods and services.²³ Even though six were cancelled, Applicant maintains that “[t]o the extent the USPTO has previously determined that the mark can function as a trademark, the Examining Attorney was left without room to claim this alleged ‘informational phrase’ is unable to serve as a trademark.”²⁴

D. Analysis

We find Applicant’s arguments and evidence legally inapposite, and insufficient to rebut the Examining Attorney’s evidence demonstrating the phrase’s widespread informational use. Applicant admits that “the term ‘designed with you in mind’ has been used in English speech for centuries....”²⁵ The dictionary definition of the words “in mind,” exemplified by “We designed this product with people like you in mind,”²⁶ shows that a typical use of this expression is to convey that goods are suitable for producers’ intended customers. This informational interpretation is corroborated by Applicant’s specimens. In its first specimen, the slogan appears in small print in the phrase “Rugs | Mats | Linens-Designed With You In Mind™”.²⁷ This merely indicates that Applicant offers rugs, mats, and linens that it thinks are suitable for its

²³ May 18, 2017 Response to Office Action TSDR pp. 7-14. Registration no. 4909420 issued March 1, 2016 (live); no. 2952494 issued May 17, 2005 (live); no. 2999276 issued Sept. 20, 2005 (cancelled April 22, 2016); no. 3438002 issued May 27, 2008 (cancelled Jan. 2, 2015); no. 3248480 issued May 29, 2007 (cancelled Jan. 3, 2014); no. 3060984 issued Feb. 21, 2006, (cancelled Sept. 28, 2012); no. 2649625 issued Nov. 12, 2002, (cancelled June 20, 2009); no. 3453041 issued Nov. 12, 2002 (cancelled June 20, 2009).

²⁴ Applicant’s brief p. 11, 4 TTABVUE 16. *See also* Applicant’s reply brief p. 2 et seq., 7 TTABVUE 5 et seq.

²⁵ Applicant’s brief p. 5, 4 TTABVUE 9.

²⁶ Merriam-Webster.com 6/1/2017, June 2, 2017 Office Action TSDR p. 14.

²⁷ July 26, 2016 specimen, [Pinterest.com/HomeDynamix/](https://www.pinterest.com/HomeDynamix/).

customers' intended uses. As the Examining Attorney correctly observes, the decision *In re Wakefern Food*, 222 USPQ at 76, is instructive. In that case, where the applicant placed its slogan, WHY PAY MORE, in the midst of its advertisement of its goods (as in "WHY PAY MORE FOR GROCERIES"), the Board found that:

[T]his 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.²⁸

Here, as in *Wakefern*, the phrase "Designed With You In Mind" would be perceived as modifying the list of home furnishings that precede it. As the Board once observed, "The text of this ad only impresses upon the public the informational nature of the slogan...." *In re Remington Prods.*, 3 USPQ2d 1714, 1715 (TTAB 1987) (affirming a failure-to-function refusal for the mark PROUDLY MADE IN THE USA for electric shavers and parts thereof). *See also In re AOP LLC*, 107 USPQ 2d 1644, 1654 (TTAB 2013) ("Set in the midst of other clearly informational matter, and far from the mark naming the wine itself, this use of the term 'AOP' does indeed convey nothing more than information itself and would not likely be perceived as a mark."). Applicant's use of the "TM" symbol in its specimen indicates no more than its intent that the phrase function as a mark, which does not transform it into a trademark. *E.g., In re Vertex Grp. LLC*, 89 USPQ2d 1694, 1701 n. 16 (TTAB 2009); *In re Aerospace Optics*, 78 USPQ2d at 1864; TMEP § 1202.

²⁸ *Id.* at 78.

Furthermore, as in *Wakefern*, Applicant's HOME DYNAMIX mark, prominently displayed in both specimens, is likely to be seen as the indicator of origin. As the Federal Circuit's predecessor put it in a similar case, "[W]e think it is clear from the exhibits that [Applicant's] trade name (generally shown in large, fanciful letters), is relied upon to denote origin and that [the slogan] is merely an adjunct thereto, operating in the shadow thereof, to indicate to purchasers that [Applicant's] goods are always superior in quality." *In re Duvernoy & Sons, Inc.*, 212 F.2d 202, 101 USPQ 288, 289 (CCPA 1954) (term "Consistently Superior" held laudatory and merely informational of applicant's bakery products); *see also Apollo Medical Extrusion Technologies*, 123 USPQ2d at 1855 (relevant purchasers would associate the prominently displayed mark MET, not the subordinate "MEDICAL EXTRUSION TECHNOLOGIES", with applicant).

Even though, in Applicant's specimens, the term "YOU" could refer to retailers who purchase Applicant's goods at wholesale or to the ultimate end users who purchase them at retail,²⁹ the retailers and consumers have a common interest in obtaining goods that are suitable for their intended purposes. As Applicant states, "[T]he mark merely suggests that the goods retailers are purchasing should be considered well thought out for individual consumer needs, i.e., the retailers' customers."³⁰

²⁹ See Applicant's brief p. 4, 4 TTABVUE 9.

³⁰ April 16, 2017 Response to Office Action TSDR p. 4.

Indeed, the Examining Attorney's third-party Internet evidence demonstrates the term's general use in advertising to consumers and to businesses. In all of the website examples, third parties use the phrase to indicate that they think their goods and services will suit the needs of their customers. "In an environment where consumers are accustomed to the use by merchants of similar informational phrases, we believe that consumers are not likely to view applicant's slogan as a service mark but rather as a merchandising slogan using common ordinary words merely to convey information about applicant's services." *In re Melville*, 228 USPQ at 971 (citing *In re Wakefern*, 222 USPQ 76). And given the widespread nature of its use, consumers and competitors are not likely to view the phrase as an indicator of a unique source. "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." *In re Eagle Crest*, 96 USPQ2d at 1229 *quoted in In re Thomas J. Hulting d/b/a No More RINOs! Enterprises*, 107 USPQ2d 1175, 1177 (TTAB 2013).

Rather, consumers and competitors would view the phrase as informational matter that all competitors can use. *In re Melville*, 228 USPQ at 972 (finding BRAND NAMES FOR LESS, for retail store services in the clothing field, "should remain available for other persons or firms to use to describe the nature of their competitive services."); *American Dairy Queen Corp. v. RTO, Inc.*, 16 USPQ2d 1077 (N.D. Ill. 1990) (the slogan WE TREAT YOU RIGHT viewed as too common and undistinctive to justify exclusive rights therein for fast food outlets), *cited in In re Volvo*, 46 USPQ2d at 1461. "As a matter of competitive policy, it should be close to impossible for one

competitor to achieve exclusive rights in such common advertising slogans as ‘Shop and Compare,’ ‘½ Off Sale,’ or ‘Two for the Price of One.’” 1 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 7:23 (5th ed. 2017).

Applicant’s analogy to likelihood-of-confusion and genericness cases is not well taken. Unlike Section 2(d) likelihood-of-confusion cases (such as the LITTLE PLUMBER case, on which Applicant relies), two businesses can use the same informational phrase, not because their goods and services are distinguishable, but because they have an equal right to use the language in communicating with their respective customers, no matter what their goods and services are. A generic term is not a mark because members of the relevant public would use or understand it as “the common descriptive name of a class of goods or services,” *Marvin Ginn*, 228 USPQ at 530, which cannot distinguish one product from another product of the same class. An informational phrase—such as “Shop and Compare,” or “Two for the Price of One”—is not a mark, either, but for a different reason. Members of the relevant public would not use or understand it as the name of the class of goods or services, but they would use or understand it as serving a purpose other than source identification: i.e., providing commercial information that may be used by all.

Applicant protests that “It is unclear how the Examining Attorney could possibly know what consumers ‘are accustomed to perceiving’ without the benefit of any consumer surveys on the subject.”³¹ Examining attorneys, with their limited resources, are not expected to conduct market surveys. *In re Budge Mfg. Co.*, 857 F.2d

³¹ Applicant’s brief p. 12, 4 TTABVue 17.

773, 8 USPQ2d 1259, 1261 (Fed. Cir. 1988); *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865, 868 (Fed. Cir. 1985) *both quoted in In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1087 n.4 (TTAB 2016); *see also* TMEP § 1208. In any event, if the Examining Attorney introduces other persuasive evidence, such as dictionary definitions, specimens showing an applicant's use of its proposed mark, newspaper articles, and third-party Internet evidence, to demonstrate that a term is merely informational, the burden shifts to Applicant to show otherwise. *See In re Bose*, 192 USPQ at 216; *In re Keep A Breast Foundation*, 123 USPQ2d at 1879; *Examination Guide 2-17, Merely Informational Matter 2-3*; TMEP § 1202.04.

The Examining Attorney's presentation of evidence differentiates this case from other cases to which Applicant refers. As noted above, Applicant has adduced copies of eight certificates of registration on the Principal Register, issued for DESIGNED WITH YOU IN MIND for various goods or services. As the Examining Attorney points out, six have been cancelled, and are thus deprived of the statutory presumption of validity.³² 15 U.S.C. § 1057(b); *Bond v. Taylor*, 119 USPQ2d 1049, 1054-55 (TTAB 2016). "An expired or cancelled registration is evidence of nothing but the fact that it once issued." *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1819 n.4 (TTAB 2016). But two of the registrations are still live, and the fact remains that all eight issued.

³² June 2, 2017 Office Action TSDR p. 3.

The issuance of these registrations, however, does not mean that “the Examining Attorney was left without room to claim this alleged ‘informational phrase’ is unable to serve as a trademark,” as Applicant contends.³³ As with any refusal, the determination of whether a designation fails to function as a mark is made based on all of the available evidence at the time of examination of the application. *Examination Guide 2-17, Merely Informational Matter 6*. Where, as here, an applicant adduces bare registration certificates, without more, “we are not privy to the records in the files of those cases, and, in any event, the Board is not bound by the actions of examining attorneys in allowing those marks for registration. It has been said many times that each case must be decided on its own facts.” *In re Eagle Crest, Inc.*, 96 USPQ2d at 1229 citing *In re Nett Designs Inc.*, 236 F.3d 139, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); see also *In re Carvel Corp.*, 223 USPQ 65, 66-67 (TTAB 1984) (“nor should the Board’s duty to decide issues in ex parte appeals presented to it be delegated by the adoption of conclusions reached by Examiners on the registrability of third party marks not involved in the instant application [on appeal of failure-to-function refusal].”). In the case of those eight registrations, unlike the present case, we are left to guess what the evidentiary record was: whether the specimens displayed the term under a more prominent mark; whether the term was set in the midst of a description of goods and services; whether dictionary definitions, newspaper articles, or third-party Internet evidence demonstrating common use was

³³ Applicant’s brief p. 11, 4 TTABVUE 16. See also Applicant’s reply brief p. 2 et seq., 7 TTABVUE 5 et seq.

adduced. In short, “We do not know what records were before the Examining Attorneys in other cases. Thus, there is little persuasive value in the third-party registrations.” *In re Best Software Inc.*, 58 USPQ2d 1314, 1316 (TTAB 2001).

In the present case, the Examining Attorney’s evidence demonstrates that businesses and consumers are generally accustomed to encountering the subject phrase, and that they would perceive it not as an indication of a single source, but as an informational message imparted by many sources. *See In re Eagle Crest*, 96 USPQ2d at 1230. We therefore find that it fails to function as a mark.

II. Conclusion

For the foregoing reasons, we find that Applicant’s proposed mark, DESIGNED WITH YOU IN MIND, fails to identify or distinguish its services from the services of others, or to indicate the source of those services. In consequence, it fails to function as a mark, and is ineligible for registration under Trademark Act Sections 1, 2, 3, and 45. 15 U.S.C. §§ 1051, 1052, 1053, and 1127.

Decision: The refusal to register Applicant’s proposed mark DESIGNED WITH YOU IN MIND is affirmed.