

This Opinion Is Not a
Precedent of the TTAB

Mailed: August 14, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Eddie Bauer Licensing Services LLC
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Application Serial No. 87471896
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Pamela N. Hirschman and Miriam D. Trudell of Sheridan Ross P.C.
for Eddie Bauer Licensing Services LLC.

Steven W. Ferrell, Jr., Trademark Examining Attorney, Law Office 121,
Richard White, Acting Managing Attorney.

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Before Kuhlke, Bergsman and Kuczma, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Eddie Bauer Licensing Services LLC (Applicant) seeks registration on the Supplemental Register of the term WORLD'S BEST DOWN (in standard characters) for "bedding containing down, namely, pillows," in Class 20, and "bedding containing down, namely, comforters, blankets, throws," in Class 24.¹ Applicant disclaimed the exclusive right to use the word "Down."

¹ Application Serial No. 87471896, filed June 1, 2017 (on the Principal Register), under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant's claim of a bona fide intent to use the mark in commerce on the listed goods. On November 27, 2017 Applicant filed an Amendment to Allege Use claiming November 16, 2017 as Applicant's dates of first use anywhere and first use in commerce for the goods in both classes. Finally, on January

The Examining Attorney refused to register the applied-for mark on the ground that WORLD'S BEST DOWN for bedding containing down does not function and is incapable of functioning as a mark. Sections 1, 2, 23(c), and 45 of the Trademark Act, 15 U.S.C. §§ 1051-1052 1091(c) and 1127.² According to the Examining Attorney, WORLD'S BEST DOWN for bedding containing down "is merely informational and constitutes a common term or slogan that is widely used in the marketplace, commonly used by businesses, and commonly used by those in Applicant's particular trade or industry such that it fails to function as a trademark when used in connection with the down goods at issue"³ and is incapable of identifying and distinguishing source.⁴

23, 2018, Applicant filed an amendment to register its mark on the Supplemental Register. Thus, the effective filing date is January 23, 2018.

² While the Examining Attorney referenced Section 23(c) of the Trademark Act in the body of his brief, he did not refer to that section of the statute in the opening or concluding portions of the brief. However, in the July 28, 2018 Final Refusal, after Applicant amended the application to the Supplemental Register, the Examining Attorney included a refusal under Section 23(c) and the application was prosecuted under Section 23(c) of the Trademark Act as a basis for the refusal to register. Applicant's January 11, 2019 Request for Reconsideration expressly noted that "the Examining Attorney maintained the refusal of the application on the Supplemental Register under Trademark Act Sections 1, 2, 3, 23(c), and 45 on the basis that the Examining Attorney believes the mark consists of common informational wording about Applicant's goods and is not able to function as a trademark." (4 TTABVUE 10). In his denial of the request, the Examining Attorney continued the refusal of registration under, inter alia, Section 23(c). (5 TTABVUE 2). *See also* Applicant's Brief, p. 5 (7 TTABVUE 6) (noting the refusal to register under Sections 1, 2, 23(c), and 45). Accordingly, the refusal to register includes Section 23(c) of the Trademark Act.

³ Examining Attorney's Brief (9 TTABVUE 4). References to the briefs, motions and orders on appeal are to the Board's TTABVUE docket system. Citations to the examination record refer to the Trademark Office's online Trademark Status and Document Retrieval system (TSDR), by page number. All citations to the documents contained in the TSDR database are to the downloadable .pdf version of the documents.

⁴ July 28, 2018 Office Action, TSDR 1.

Applicant argues that WORLD'S BEST DOWN does not convey an ordinary or familiar concept.⁵ For example,

While an individual may commonly say to a third party "DRIVE SAFELY" before the third party enters a car, an individual would not commonly say to a third party "WORLD'S BEST DOWN" before the third party gets into a bed with down filled bedding.⁶

Further,

Applicant has been using its WORLD'S BEST DOWN mark as an indicator of source for its clothing since at least as early as July 2008 and has now expanded such use to other products. Therefore, Applicant's use of "WORLD'S BEST DOWN" is not informational, but puffery or exaggerated praise for Applicant's products, and capable of registration on the Supplemental Register.⁷

Finally, Applicant proffered that the USPTO has registered over 50 "World's Best" formative marks primarily registered on the Supplemental Register or under the provisions of Section 2(f) without disclaiming the exclusive right to use the term "World's Best."⁸ Accordingly, Applicant contends that consumers will perceive WORLD'S BEST DOWN as a trademark.

⁵ Applicant's Brief, p. 6 (7 TTABVUE 7).

⁶ *Id.* at p. 8 (7 TTABVUE 8).

⁷ *Id.* at p. 9 (7 TTABVUE 9). Applicant is the owner of Registration No. 3548475 for the mark WORLD'S BEST DOWN, registered on the Supplemental Register, for "clothing containing down, namely, jackets, parkas, coats, vests, scarves, gloves and hats," in Class 25, registered December 16, 2008, Section 8 declaration accepted, renewed. January 23, 2018 Response to Office Action (TSDR 3). Applicant did not include a copy of the specimen of use so we cannot see how the mark was used.

⁸ *Id.* at p. 9 (7 TTABVUE 10); January 11, 2019 Request for Reconsideration (4 TTABVUE 11-24 and 27-165). Although Applicant submitted copies of the third-party registrations, Applicant did not include the specimens of use.

I. Preliminary Issue

The Examining Attorney refused registration in the first Office Action on the ground that WORLD'S BEST DOWN does not function as a mark prior to Applicant filing an Amendment to Allege Use and a specimen of use:⁹

Registration is refused **because the applied-for mark is merely informational and constitutes a common term or slogan that is widely used in the marketplace, commonly used by businesses, and commonly used by those in applicant's particular trade or industry; it does not function as a trademark to indicate the source of applicant's goods to identify and distinguish them from others.** Trademark Act Sections 1, 2, 3, and 45, 15 U.S.C. §§1051-1053, 1127; *see In re Boston Beer Co.*, 198 F.3d 1370, 1372-74, 53 USPQ2d 1056, 1058-59 (Fed. Cir. 1999) (holding THE BEST BEER IN AMERICA unregistrable for beer and ale because the mark would be perceived as a common, laudatory advertising phrase and not a trademark); *In re Aerospace Optics, Inc.*, 78 USPQ2d 1861, 1864 (TTAB 2006) (holding SPECTRUM unregistrable for illuminated pushbutton switches because the mark would be perceived as information about the multiple color feature of the goods and not a trademark); *In re Melville Corp.*, 228 USPQ 970, 971 (TTAB 1986) (holding BRAND NAMES FOR LESS unregistrable for retail clothing store services because the mark would be perceived as a common promotional phrase and not a service mark); TMEP §1202.04.¹⁰ (Emphasis added).

⁹ September 1, 2017 Office Action (TSDR 2). Nevertheless, “[a]lthough the failure-to-function refusal is normally a specimen-based refusal, a refusal must be issued, regardless of the filing basis, if the evidence supports a determination that a proposed mark is merely informational and thus would not be perceived as an indicator of source. *See* Trademark Manual of Examining Procedure (TMEP) § 1202 (Oct. 2018); *cf. In re Right-On Co.*, 87 USPQ2d 1152, 1157 (TTAB 2008) (noting that, with respect to § 66(a) applications, ‘it is appropriate for examining attorneys to issue an ornamentation refusal if the mark is decorative or ornamental on its face as depicted on the drawing page and described in the description of the mark’).” TMEP § 1202.04.

¹⁰ *Id.*

Applicant contends that because the Examining Attorney issued the failure-to-function refusal prior to the filing of Applicant's Amendment to Allege Use and specimen, "the refusal in this case is based solely on the meaning of Applicant's mark and not the manner of use [sic] Applicant's use of the mark."¹¹

The Examining Attorney, in his brief, did not address Applicant's contention and, in fact, argued that WORLD'S BEST DOWN does not function as a trademark based on the nature of the term, rather than the manner in which Applicant uses WORLD'S BEST DOWN.

In view thereof, we limit our analysis of the failure to function refusal based on the nature of WORLD'S BEST DOWN. *See In re Peace Love World Live, LLC*, 127 USPQ2d 1400, 1401-02 (TTAB 2018) (because the final refusal under Sections 1, 2, and 45 of the Trademark Act was limited to the mere ornamentation rationale and the merely informational rationale was raised only in an advisory manner during examination, the Board exercised its discretion to limit its review to whether the subject matter sought to be registered is ornamental). However, we consider the manner in which Applicant uses WORLD'S BEST DOWN in analyzing how it may be perceived (i.e., merely informational or as a trademark) because in making this determination "we look to the specimens and other evidence of record showing how the designation is actually used in the marketplace." *In re Eagle Crest, Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010).

¹¹ Applicant's Brief, p. 6 (7 TTABVUE 7).

II. Whether WORLD'S BEST DOWN is capable of functioning as a trademark?

“[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)). “There are multiple reasons why a proposed mark may fail to function as one.” *Id.* (citing TMEP § 1202)). As noted above, the Examining Attorney “invokes the line of cases holding that ‘terms and expressions that merely convey an informational message are not registrable.’” *Id.* (quoting *DePorter*, 129 USPQ2d at 1299). Matter that does not operate to indicate the source or origin of the identified goods or services and distinguish them from those of others does not meet the statutory definition of a trademark and may not be registered, regardless of claims of acquired distinctiveness or the register on which registration is sought. *See In re Boston Beer Co. L.P.*, 53 USPQ2d at 1058 (finding that the phrase THE BEST BEER IN AMERICA “is so highly laudatory and descriptive of the qualities of its product that the slogan does not and could not function as a trademark” and is incapable of acquiring distinctiveness under section 2(f)); *In re Helena Rubinstein, Inc.*, 410 F.2d 438, 441-42, 161 USPQ 606, 608-09 (C.C.P.A. 1969) (finding PASTEURIZED for face cream as so highly descriptive that it fails to function as a source identifier, noting that a

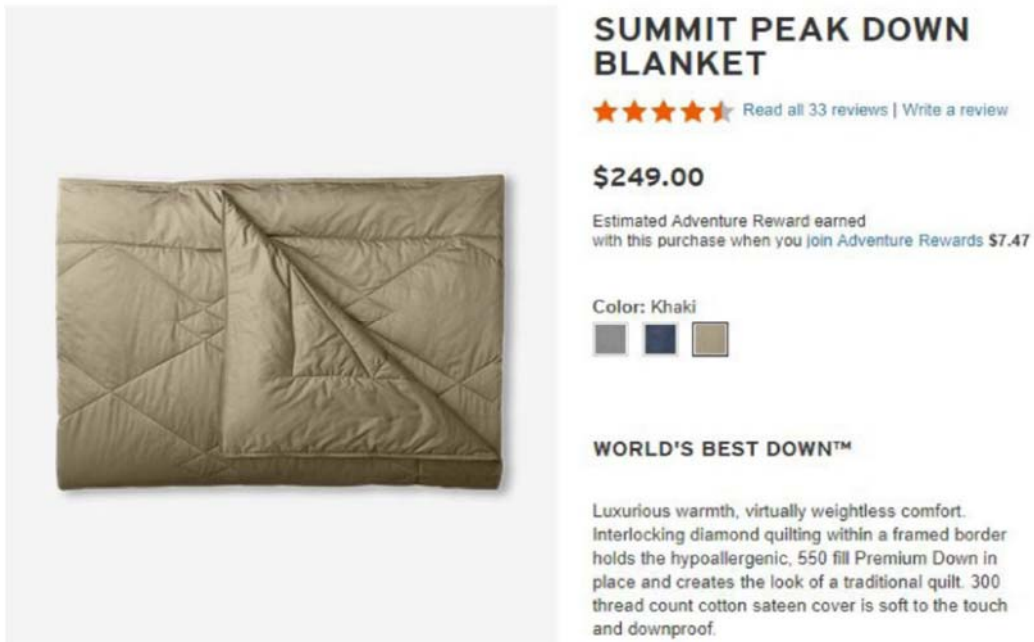
proposed mark “cannot properly be registered as a trademark, even on the Supplemental Register, unless it is intended primarily to indicate origin of the goods and is of such a nature that the ordinary purchaser would be likely to consider that it indicated such origin”); *D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d 1710 (TTAB 2016) (granting petition to cancel a registration on the Supplemental Register because the mark failed to function as a trademark).

Under these cases, “[s]logans and other items that are considered to be merely informational in nature, or to be common laudatory phrases or statements that would ordinarily be used in business or in the particular trade or industry, are not registrable.” *In re Eagle Crest, Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010) (affirming refusal to register “Once a Marine, Always a Marine” for clothing because it would be perceived as an informational slogan “to express support, admiration or affiliation with the Marines”). *See also D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d at 1716 (sustaining opposition to registration of I ♥ DC for clothing because it would be perceived as “an expression of enthusiasm, affection or affiliation with respect to the city of Washington, D.C.”); *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.*

An excerpt from the specimen of use displaying the mark is reproduced below:



In addition, the Examining Attorney submitted third-party websites showing use of the term “World’s Best Down” used in connection with bedding and other products. For example:¹²

1. Anhui Eafashion Home Textiles Co., Ltd. (aheafshion.com)

Anhui down quilt has been named “the world’s best down” by the world’s feather Bureau.¹³

¹² The Examining Attorney has confirmed that the third parties whose websites have been made of record offer their products for sale in the United States. February 14, 2018 Office Action (TSDR 3).

¹³ September 1, 2017 Office Action (TSDR 6).

2. Backcountry Gear (backcountrygear.com)

Western Mountaineering – Down Booties – Unisex

Western Mountaineering’s top-notch construction methods, attention to detail, and years of experience working solely with premium down set them apart from other brands; they are simply one of the world’s best down companies, bar none.¹⁴

3. Danish Eiderdowns (danishedierdowns.com.au)¹⁵



4. DownTown Company (downtowncompany.com)

DownTown

Company

More Than Just Down

DownTown Company specializes in bringing together the highest quality materials with the best textile craftsmen in the world, creating the ultimate luxury bedding and premium home accessories. We use luxurious white goose down from Siberia and Hungary and is therefore renowned for providing the world’s best down products.¹⁶

¹⁴ September 1, 2017 Office Action (TSDR 7).

¹⁵ *Id.* at TSDR 8.

¹⁶ *Id.* at TSDR 9.

5. Joutsen Finland Oy (finnairshop.com)

Joutsen Finland Oy is the world's northernmost manufacturer of down products. Joutsen down coats and bedding items are made of the world's best down qualities.¹⁷

6. Kauffmann (Kauffmann.at/en)

Education and Entertainment

The employees are the main contribution to the success of KAUFFMANN. Ambition, enthusiasm and passion are necessary to implement the company's vision realizing the world's best down and feather comforters.¹⁸

7. The Northwestern Business Review
(northwesternbusinessreview.org)

Canada Goose and the Technology of Warmth

Those trendy Canada Goose jackets many students at Northwestern wear often have hefty price tags. But are they really worth it?

... The warmest jackets they sell "are good to minus seventy standing still," Canada Goose director of design and marketing Spencer Orr boasted in a 2013 interview with the Toronto Star. "We have the world's best down."¹⁹

¹⁷ *Id.* at TSDR 10. This website is an excerpt from the Finnair website offering a wide variety of products to Finnair flyers.

¹⁸ *Id.* at 12.

¹⁹ *Id.* at 14.

8. Primaloft (primaloft.com)²⁰



9. Sierra Trading Post (sierratradingpost.com)²¹

Haglofs Nube Hooded Down Jacket (For Women) [View this Product](#)

★★★★★ **World's Best Down Jacket**
Reviewed by toyger from Santa Fe, New Mexico on Saturday, December 22, 2007

Went skiing at 12,000 feet today with the wind blasting and as soon as I put this jacket on the day was practically balmy. Head turning jacket to wear around town in the winter too. There is no comparison between a 800 fill jacket of this caliber and the lower grade down jackets.

Best Uses: Casual Wear, Cold Weather, Extreme Conditions, Hiking and Camping
Chest Size: Feels true to size
Describe Yourself: Avid Adventurer
Fit: Feels true to size

²⁰ *Id.* at 15.

²¹ *Id.* at 16.

10. Tundra (tundrasleepingbags.com)

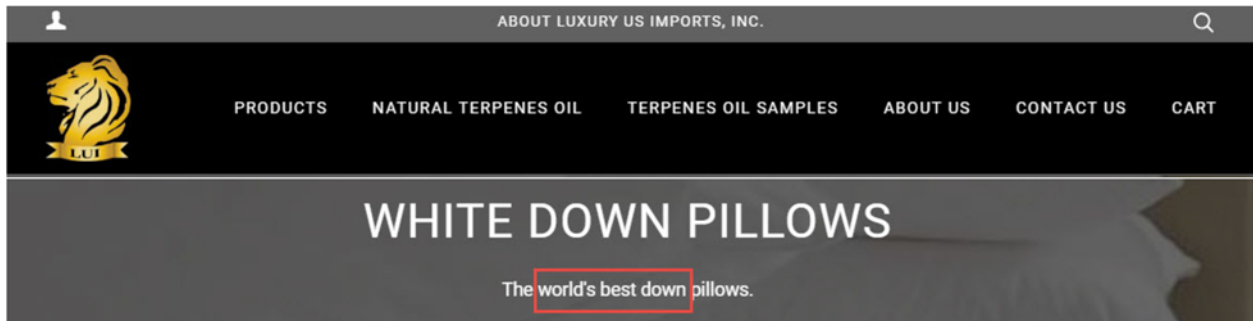
Ethical Down

Design & Philosophy

Why Ethical Production?

Tundra draws on the skills of designers who have many years' experience in producing practical, high quality equipment for outdoor enthusiasts and their contemporary approach is coupled with Poland's expert long tradition of manufacturing down products. Add to this fact that we use the lightest practical fabric available ... and the world's best down ... and you have an end product that easily surpasses competition in quality and performance.²²

11. Luxury US Imports, Inc. (luxuryimports.com)²³



12. Pillowpacker Pillows (pillowpackerpillows.com)

PILLOWPACKER® PILLOWS – THE WORLD'S BEST INFLATABLE TRAVEL PILLOW

We think we have the best inflatable pillow. We also think we have the world's best down travel pillow and the world's best microfiber travel pillow. Those are big claims for a small company.²⁴

²² *Id.* at 17.

²³ July 28, 2018 Office Action (TSDR 6).

²⁴ *Id.* at 7.

13. MooseJaw (Moosejaw.com)

First Ascent Men's Peak XV Down Jacket

Features of the Men's Peak XV Jacket by First Ascent

- 850 Fill Power Premium Northern European Goose Down: Ultra-light, ultra-warm, ultra-compressible World's Best Down²⁵

The evidence shows that the term "World's Best Down" is a common advertising phrase used to tout the high quality down in bedding and other products. Applicant uses WORLD'S BEST DOWN in the manner of a superiority claim that should be freely available to all manufacturers of down products subject to the laws regarding false advertising. Where, as here, consumers encounter a term such as "World's Best Down," used in connection with the goods for numerous third parties, they will not view the term as a trademark. *See D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d at 1716; *In re Eagle Crest*, 96 USPQ2d at 1230. Thus, it is incapable of distinguishing goods and cannot function as a trademark or indicator of source.

With regard to the third-party registrations relied on by Applicant, the Board is not bound by the underlying decisions by Examining Attorneys to register those marks. *See In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("The Board must decide each case on its own merits" and "[e]ven if some prior registrations had some characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind the Board or this court.") (internal

²⁵ January 24, 2019 Denial of Request for Reconsideration (5 TTABVUE 5).

Serial No. 87471896

citation omitted). Rather, we look to precedents set by previous court and Board cases discussed above.

Decision: The refusal to register Applicant's mark WORLD'S BEST DOWN is affirmed.