

<p>This Opinion is Not a Precedent of the TTAB</p>
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Hearing: June 12, 2019

Mailed: September 18, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Lisa Brewer Buffaloe*

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Serial No. 87880862

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Mark Lebow of Ladas & Parry, for Lisa Brewer Buffaloe

Samuel R. Paquin, Trademark Examining Attorney, Law Office 101,  
Ronald Sussman, Managing Attorney.

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Before Mermelstein, Ritchie, and Dunn,  
Administrative Trademark Judges.

Opinion by Dunn, Administrative Trademark Judge:

Lisa Brewer Buffaloe (“Applicant”) filed an application pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), to register the mark JOHN 15:11 PUBLICATIONS (in standard character format with PUBLICATIONS disclaimed) on the Principal Register for the following goods:

International Class 9

Downloadable e-books, audio books, multimedia files, and electronic publications in the field of literary works featuring inspirational and religious fiction and non-fiction, all of the foregoing not featuring the bible verse John 15:11

International Class 16

Printed books in the field of literary works featuring inspirational and religious fiction and non-fiction, all of the foregoing not featuring the Bible verse John 15:11

(application Serial No. 87880862 filed April 17, 2018).

The Trademark Examining Attorney has finally refused registration of Applicant's purported mark under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052, and 1127, on the ground that the mark JOHN 15:11 PUBLICATIONS is informational and does not function as a trademark, and under Section 2(e)(1) on the ground that mark JOHN 15:11 PUBLICATIONS is deceptively misdescriptive of publications which do not feature the Bible verse JOHN 15:11.<sup>1</sup> After the Trademark Examining Attorney issued the final refusal, Applicant filed a (second) request for reconsideration and this appeal. After the (second) request for reconsideration was denied, the appeal was resumed. The appeal is fully briefed. Applicant requested a hearing, which was presided over by this panel.

Because we affirm on the failure to function refusal, we do not reach the refusal that the mark is deceptively misdescriptive.

### **I. Applicable Law**

Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§ 1051, 1052, and 1127, provide the statutory basis for refusal to register on the Principal Register subject matter that, due to its inherent nature or the manner in which it is used, does not function as a mark to identify and distinguish the applicant's goods. Sections 1 and 2 of the

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<sup>1</sup> Other refusals were withdrawn by the Examining Attorney.

Trademark Act require that the subject matter presented for registration be a “trademark.” Section 45 defines a “trademark” as “any word, name, symbol, or device, or any combination thereof — (1) used by a person ... to identify and distinguish his or her goods ... from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.” As the predecessor to the Board’s primary reviewing court held:

The Trademark Act is not an act to register words but to register trademarks. Before there can be registrability, there must be a trademark (or a service mark) and, unless words have been so used, they cannot qualify for registration. Words are not registrable merely because they do not happen to be descriptive of the goods or services with which they are associated.

*In re Standard Oil Co.*, 275 F.2d 945, 125 USPQ 227, 229 (CCPA 1960).

The proposed mark must be perceived by the relevant public as conveying the commercial impression of a trademark. That is, the mark must identify the source of goods. *In re Owens–Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985); *In re Brass-Craft Mfg. Co.*, 49 USPQ2d 1849, 1852 (TTAB 1998), *aff’d mem.*, 217 F.3d 855 (Fed. Cir. 1999). The fact that a party intends a proposed mark to function as a trademark is insufficient. *In re Standard Oil Co.*, 125 USPQ at 229 (“[I]t may be conceded that in using the words ‘guaranteed starting’ in order to bring its services to the attention of the public the applicant intended and hoped, or perhaps expected, that they would distinguish them from similar services offered by others. However, having chosen words which, taken in their normal meaning, do no more than inform the public with reasonable accuracy what is being offered, it did not succeed.”). *Accord Am. Velcro, Inc. v. Charles Mayer Studios, Inc.*, 177 USPQ 149, 154

(TTAB 1973) (“not every designation adopted with the intention that it performs a trademark function and even labeled as a trademark necessarily accomplishes that purpose.”). The classic function of a trademark is to point out distinctly the origin of the goods to which it is attached. *In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1976).

Matter is merely informational and does not function as a mark when, based on its nature and the context of its use by the applicant or others in the marketplace, consumers would perceive it as merely conveying general information about the goods or services or an informational message, and not as a means to identify and distinguish the applicant’s goods or services from those of others. *In re Standard Oil Co.*, 125 USPQ at 229 (“Taken together, [the words GUARANTEED STARTING] amount to no more than a sort of condensed announcement that the applicant will guarantee the work done in order to insure the starting of the customer’s car.”); *In re True Temper Corp.*, 219 F.2d 957, 105 USPQ 69, 71 (CCPA 1955) (“whether the term ‘CRIPPLED SHAD’ indicates a lure simulating a crippled shad, or a lure for catching shad, appellant is not authorized under the law to appropriate these words exclusively to its own use”); *In re Volvo Cars of N. Am., Inc.*, 46 USPQ2d 1455, 1460 (TTAB 1998) (“The ordinary meaning of the often-repeated phrase DRIVE SAFELY is so ingrained in the minds of our society that it would not be perceived as a trademark.”). An informational message includes a message which communicates affiliation or support instead of a single source for the goods. *See D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d 1710, 1716 (TTAB 2016) (“We find that the phrase I ♥ DC

on apparel and other souvenirs, whether displayed in the stacked format shown in the Registration or in the horizontal format shown in the Application, would be perceived by purchasers and prospective purchasers as an expression of enthusiasm for the city of Washington, DC.”); *In re Hulting*, 107 USPQ2d 1175, 1179 (TTAB 2013) (“consumers purchasing applicant’s goods will perceive applicant’s proposed mark [NO MORE RINOS] as a political slogan commonly used by multiple individuals and entities rather than a sole source of products or services); *In re Eagle Crest, Inc.*, 96 USPQ2d 1227, 1230-31 (TTAB 2010) (“It is clear from the evidence that many consumers want to openly express their support or admiration for the Marines or their association with the Marines, and applicant’s shirts and hats [bearing the proposed mark ONCE A MARINE, ALWAYS A MARINE] accomplish that purpose.”); *In re Manco Inc.*, 24 USPQ2d 1938, 1942 (TTAB 1992) (“[B]ecause applicant’s slogan broadly conveys the ecological concerns of the expanding environmental movement, we believe that only the informational significance imparted by the term ‘THINK GREEN’ would be impressed upon purchasers and prospective customers for applicant’s goods”).

## **II. Background to Bible verses**

While there is no dispute that JOHN 15:11 identifies a Bible verse, because there is a specialized nomenclature associated with the Bible, it is useful to review its structure before turning to the parties’ evidence. The Bible is a religious work whose organization is recognized in the dictionary, and whose citation follows bibliographic

custom.<sup>2</sup> The Examining Attorney placed into evidence a dictionary entry which lists the Bible as the 24 Books of the Hebrew Scriptures or the 66 Books of the Christian Old and New Testaments. February 13, 2019 Office Action, TSDR 8-10. In addition, we note the following dictionary definitions<sup>3</sup>:showing that the Bible always is organized by books, chapters, and verses.<sup>4</sup>

VERSE noun

4 : one of the short divisions into which a **chapter** of the Bible is traditionally divided

CHAPTER noun

: a main division of a **book**

BOOK noun

d : a major division of a treatise or literary work  
*the books of the **Bible***

BIBLE noun

1 capitalized, religion

a : the sacred **scriptures** of Christians comprising the Old Testament and the **New Testament**

b : the sacred scriptures of some other religion (such as Judaism)

SCRIPTURE noun

1a (1) capitalized : the books of the Bible —often used in plural

(2) often capitalized : a passage from the Bible

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<sup>2</sup> In a 2008 Harris Poll, the Bible ranked as the most popular book of all time among American readers. *Saul Zaentz Co. v. Bumb*, 95 USPQ2d 1723, 1724 (TTAB 2010).

<sup>3</sup> The Board may take judicial notice of dictionary definitions. *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1374 (Fed. Cir. 2018); *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

<sup>4</sup> The predecessor to our primary reviewing court, when reversing a decision that a book called “The Child’s Bible” was a Bible and exempt from import taxes, quoted the 1921 Summary of Tariff Information as stating “The term ‘Bible’ is sufficiently familiar to make unnecessary any lengthy statement relating to description and uses. *United States v. Bobbs-Merrill Co.*, 19 CCPA 141, 143 (1931) (not reported in F.2d, available at 1931 WL 2368).

**NEW TESTAMENT** noun

the second part of the Christian Bible comprising the canonical **Gospels** and Epistles and also the book of Acts and book of Revelation

**GOSPEL** noun

one of the first four New Testament **books** telling of the life, death, and resurrection of Jesus Christ

**JOHN** noun

3: the fourth **Gospel** in the New Testament

**COLON** noun

2 b : the sign : used between the parts of a numerical expression of time in hours and minutes (as in 1:15) or in hours, minutes, and seconds (as in 8:25:30), in a bibliographical reference (as in Nation 130:20), in a ratio where it is usually read as "to" (as in 4:1 read "four to one"), or in a proportion where it is usually read as "is to" or when doubled as "as" (as in 2:1::8:4 read "two is to one as eight is to four")

*Merriam-Webster, <https://www.merriam-webster.com/dictionary/>.*

Based on these dictionary definitions, we find as pertinent background facts that the Christian Bible includes Books; that one of the Books in the Bible is referred to as John, and that the Books are divided into chapters, and the chapters are divided into verses. A bibliographic reference to a Bible verse identifies the Book in which the verse is located, and then lists the chapter in which the verse is located, and the number of the verse within the chapter, separated by a colon.

### **III. Examining Attorney's Evidence and Arguments**

The Examining Attorney contends that the purported mark JOHN 15:11 PUBLICATIONS does not function as a trademark for inspirational and religious publications, whether in print or electronic form, but will be perceived by the prospective purchaser of such publications as informing them that the publications endorse or support the concepts conveyed by the well-known Biblical verse JOHN

15:11, which states “These things I have spoken to you so that My joy may be in you, and that your joy may be made full.”

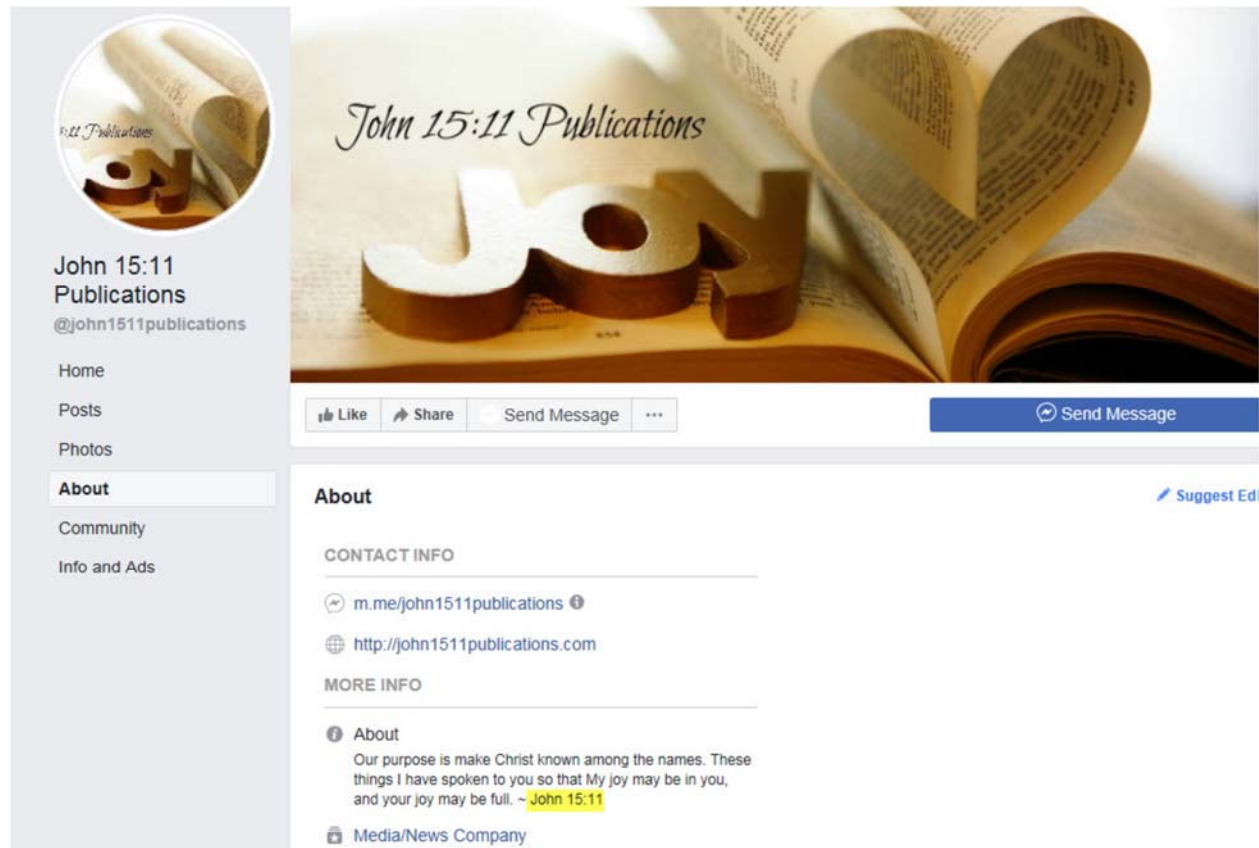
The Examining Attorney relies on Internet evidence including Applicant’s website, dictionary definitions, and third party uses of the term JOHN 15:11 which demonstrate that JOHN 15:11 identifies a Bible verse; that the Bible verse so identified states “These things I have spoken to you so that My joy may be in you, and that your joy may be made full”; that the Bible verse JOHN 15:11 is significant among Bible verses; that the Bible verse JOHN 15:11 is the subject of inspirational and religious publications in the forms of sermons by religious leaders, scholarly analysis, religious and spiritual discussions by Christians discussing the verse or citing it as inspiration; and that the Bible verse JOHN 15:11 is recognized by the general public because it is encountered on a wide variety of everyday items. Excerpts from the evidence of the various ways in which the public encounters the Bible verse JOHN 15:11 are set forth below:





*Applicant's homepage*

June 4, 2018 Office Action, TSDR 5.<sup>5</sup>



*Applicant's Facebook page*

The Examining Attorney also submitted evidence of hundreds of online JOHN 15:11 publications in the form of three databases of sermons in which the Bible verse John 15:11 is the focal point of the sermon, and JOHN 15:11 is used as the search term to locate the sermons. Some examples include the following:

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<sup>5</sup> The TTABVUE and Trademark Status and Document Retrieval (TSDR) citations refer to the two locations on the USPTO website where the appeal record can be found, namely the Board's electronic docket and the Trademark database for the involved application. All citations to the TSDR database are to the downloadable .pdf version of the documents.

**Bible Hub**

Enter Reference or Keyword 🔍

NIV NLT ESV BSB NAS KJV HCS ASV DBT DRB ERV GWT ISR ISV KJP NET OJB WEB WBT WYC YLT TNT WEY KJ2 KJ100





Parallel Sermons Topics Strong's Comment Interlinear Greek lexicon Multi

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BP-le , Ser mons., John15: 11

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## ... John 15:11

 <p>Powered by <a href="#">Christi nBook.com</a></p>  <p>The Parable Blueprint</p>  <p>CJ Learning to Live in Spiritual Victory</p>  <p>How the Bible</p>	<p>Ser m on s</p> <ul style="list-style-type: none"> <li>Chri st' s Inner Joy</li> <li>Chri st' s Joy</li> <li>Chri st' s Things to Make His Disciples Happy</li> <li>Divine Joy</li> <li>Happiness and Joy</li> <li>The Abiding Joy</li> <li>The Christian's Joy</li> <li>The Difference Between Worldly Mirth and Chri stan Joy</li> <li>The Fellowship of Christ's Joy the Source of True Blessedness</li> <li>The Joy of the Master and the Joy of the Disciples</li> <li>The Nature and Sources of Christi an Joy</li> <li>The Sources of Christ's Joy</li> <li>Abiding in Love</li> <li>Chri st's l ove for His Di sciples</li> <li>Continuing in Chri st's Love</li> <li>Divine l ove</li> <li>Obedient Love Bringir,g Fulnessof Joy</li> <li>The Divine Measure of l ove</li> </ul>	<ul style="list-style-type: none"> <li>Homiletic Magazine</li> <li>T. Stephenson.</li> <li>R. V. Pryce, LL. B.</li> <li>J.R. Thomson</li> <li>H. Bushnell, D. D.</li> <li><b>Weekly Pulpit</b></li> <li>J. Culross, D. D.</li> <li>W.B urch.</li> <li>E. L. Hull, B. A.</li> <li>B. Thomas</li> <li>R. Cec,il M.A.</li> <li>J. T. Stannard.</li> <li>A. Maclaren, D. D.</li> <li>D. Thomas, D. D.</li> <li>J. Brown, D. D.</li> <li>G. Phillips.</li> <li>T.G. Hort on.</li> <li>T.Davies, Ph. D.</li> </ul>	<ul style="list-style-type: none"> <li>John15:11</li> <li>John15:11</li> <li>John15:11</li> <li>John 15:11</li> <li>John15:11</li> <li>John 15:11</li> <li>John15:11</li> <li>John15:11</li> <li>John15:11</li> <li>John15:11</li> <li>John15:11</li> <li>John15:9-11</li> <li>John 15:9-11</li> <li>John15:9-11</li> <li>John15:9-11</li> <li>John15:9-11</li> <li>John15:9-11</li> </ul>
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June 4, 2018 Office Action, TSDR 12.

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**Hope In The Conquest - More Than Conquerors In Christ** Series  
Contributed by Dean Courtier on Nov 14, 2018  
based on 1 ratings | 360 views  
We continue in our series Hope Found Here and this month our theme is Hope in the Conquest. If we are in Christ, if we have accepted Him as our Lord and Saviour we have no need to fear our past, our present or our future.  
We continue in our series Hope Found Here and this month our theme is Hope in the Conquest. Hope in the Conquest of what? Hope in the Conquest of Sin; Hope in the Conquest of Death; and Hope in the Conquest of Fear. Our hope comes from being in a real relationship with Jesus, He has conquered the ... [read more](#)  
**Scripture:** Romans 8:37, Proverbs 3:5-6, Deuteronomy 32:4, Acts 10:34-36 [\(view more\)](#)  
**Denomination:** Pentecostal



**Remembrance Sunday** Series  
Contributed by Dean Courtier on Nov 14, 2018  
based on 2 ratings | 290 views  
Remembrance Sunday is an important event in the church calendar because it helps us to not forget why we have the freedom that we enjoy today.  
Remembrance Sunday is an important event in the church calendar because it helps us to not forget why we have the freedom that we enjoy today. It reminds us of the peace we have experienced here in England was not bought cheaply. Remembrance Sunday is more than a reminder of those who died in the ... [read more](#)  
**Scripture:** John 15:9-13, Psalms 105:1-5, Psalms 105:7, Psalms 105:8 [\(view more\)](#)  
**Denomination:** Pentecostal

December 18, 2018, TSDR.


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The screenshot displays the sermonaudio.com website interface. At the top, the site logo and a search bar are visible. A sidebar on the left contains navigation links such as 'Home', 'News, SITE', 'Events & Blogs', 'New Audio & Video', 'Broadcasters', 'Local & Church Finder', 'Live Webcasts', 'Sermons by Bible', 'Sermons by Topic', 'Sermons by Speaker', 'Sermons by Date', 'Staff Picks', 'Comments', 'Top Sermons', 'Daily Log', 'Photos', 'Stores', 'Online Bible', 'Hymnal', 'Daily Reading', 'Our Services', 'Sermon Dashboard', and 'Members Only'. The main content area features a search result for 'John 15:11' by M. Henry Commentary, Chapter 15, Verse 11. Below this, there is a section for 'The Paperback Bible' by the Ministry of SermonAudio, which is described as a portable, readable, and personal Bible with ample margins for notations. A quote from John 15:11 is displayed: 'These things have I spoken unto you, that my joy might remain in you, and that your joy might be full.' At the bottom, a search bar and filter options are shown, along with a list of search results. The first result is 'Abiding in the Vine, Part 2B' by Pastor John MacArthur, dated Friday, 10/24/2014, with 13,240+ views and 28 minutes duration.

December 18, 2018 Office Action, TS DR 34.

The Examining Attorney also submitted evidence that JOHN 15:11 is a common abbreviation used to refer to the full Bible verse found at the Book of John, chapter 15, verse 11, to express the sentiment contained therein: “These things I have spoken to you so that My joy may be in you, and that your joy may be made full.”





## Love Worth Finding

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### A Recipe for Joy

*"These things have I spoken unto you, that My joy might remain in you, and that your joy might be full." [John 15:11](#)*

Joy is the birthright of the child of God. Every child of God ought to have a conscious, conspicuous, continuous, and contagious joy. If you are not living a life of joy, you are living beneath your privileges as a Christian.

**The Source of Joy**  
 What is the source of your joy? [John 15:11](#) says the joy that you are to have as a Christian is the joy of Jesus. He says "My joy." Jesus literally wants to take the joy that He has and place it in you. We think of Jesus as a Man of Sorrows, but there was a genuine joy in Jesus; and if you do not have that joy, you are not like Him. Jesus is the source of joy.

**The Stability of Joy**

Excerpt from "A Recipe for Joy" by Adrian Rogers of Love Worth Finding Ministry  
 (June 4, 2018 Office Action, TS DR 10):

Bible > Commentaries > John 15:11
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### ◀ John 15:11 ▶

*These things have I spoken to you, that my joy might remain in you, and that your joy might be full.*

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EXPOSITORY (ENGLISH BIBLE)

**Ellicott's Commentary for English Readers**

(11) *These things have I spoken unto you, that my joy might remain in you.*—The better reading is, . . . *that My joy may be in you.* The joy thought of is that which Christ Himself possessed in the consciousness of His love towards the Father, and of the Father's love towards Him. The brightness of that joy lit up the darkest hours of His own human life, and He wills that it should light up theirs. In the consciousness of their love to God, and of God's love to them, there would be in them, as part of their true life, joy which no sorrow could ever overcome. They were as men with troubled hearts. He has told them of the true source of peace. His own peace He has given to them. He tells them now of the source of joy, and has spoken the word that they may possess the very joy which was the light of His own heart.

*And that your joy might be full.*—Comp. the words of the Intercessory Prayer in [John 17:13](#), and the

EXEGETICAL (ORIGINAL LANGUAGES)

**Meyer's NT Commentary**

[John 15:11](#). Conclusion of the section [John 15:1-10](#) (παύται).  
 ἵνα ἡ χαρὰ, κ.τ.λ.] Note the juxtaposition of ἡ ἐμὴ and ἐν ὑμῖν; that *my* joy may be *i.e.* that the same joy which / have may be *yours*. The holy joyous tone of soul is intense conscious moral courage of joy, which also rises victorious over all suffering, as Christ, in His fellowship with the Father and of His obedience towards Him, must and did possess in [John 17:13](#), and as it is so often audible in Paul's writings also in the sense of Christ ([1 Cor 7:30](#); [2 Corinthians 13:11](#); [Php 2:17-18](#); [Php 4:4](#); [Romans 14:17](#); [Galatians 5:22](#)). Yet ἡ ἐμὴ the joy *produced by me* (Calvin, De Wette), or of which I have opened to you the spring (I which is forcing a meaning on the simple possessive expression (comp. [John 3:29](#), [John Corinthians 2:3](#)), and does not satisfy the significant juxtaposition of ἡ ἐμὴ and ἐν ὑμῖν (

Excerpt from BibleHub website (June 4, 2018 Office Action, TS DR 9):

“ “These things I have spoken to you, that my joy may be in you, and that your joy may be full.” (John 15:11 RSV)

What was his joy? In the 12th chapter of the book of Hebrews there is a verse that says of Jesus, “who for the joy that was set before him endured the cross, despising the shame,” (Hebrews 12:2b RSV). What was it that filled his heart with joy as he faced the cross, and enabled him to go through that terrible ordeal? It was the expectation that he would be the instrument of redemption for the entire world -- that a host, a great harvest of people, would be changed and redeemed and restored, their humanity given back to them -- by his action. In other words, his joy was the joy of being used of God.

Excerpt from transcript by Ray Stedman Ministries (June 4, 2018 Office Action, TSDR 11).

**11 I have told you this so that my joy may be in you and that your joy may be complete. (John 15:11 NIV)**

Did you notice any common theme while I read the verses from God’s Word? Let me give you a hint: Where does joy come from? Joy doesn’t find its place of origination in this world: in people, things, or experiences. Joy is generated, originates, in God alone. In Psalm 4, David said, **“You have put more joy in my heart...”** and he compares what he’s experiencing “in the Lord” to what others experience with great prosperity. Then, in Psalm 16, he said, **“in your presence there is fullness of joy.”** These verses speak of the joy of God the Father. Then, we read from John 15:11 where Jesus, God the Son, said, **“I have told you this so that my joy may be in you and that your joy may be complete.”** God the Son makes His joy available to His followers. In the words of those late night infomercials, “But wait...that’s not all!” In Galatians 5:22-23 we can learn about God the Holy Spirit when we read,

Excerpt from *Joy in the Midst of Sorrow* by Britton Church (June 4, 2018 Office Action, TSDR 13).

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L E A D E R ' S   N O T E S

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## A BIBLICAL PORTRAIT

### Read John 15:9–11

**Questions Two & Three** Some group members will have clear and profound memories of how their life was joyless before knowing Christ. Others may have known the love of Christ from their childhood and may have a difficult time identifying a time of not knowing Him. Be sure to affirm those who came to faith early in life. Their journey of faith is just as rich as the person who had a dramatic conversion later in life. For those who have known the love of God from their childhood, invite them to communicate how their joy has grown deeper over the years.

God says in His Word that He wants joy to be a distinguishing mark of a Christian. He says in Galatians 5:22–25 that His Spirit is going to work twenty-four hours a day to produce joy in our lives. In **John 15:11**, Jesus says that He wants to make our joy full and complete. In Psalm 23, the psalmist says that

Excerpt from Hybels & Harney, *Fruit of the Spirit* (June 4, 2018 Office Action, TSDR 14).



## JANUARY

28

*That my joy might remain in you, and that your joy might be full—John 15:11.*

There is a joy that springs spontaneously in the heart without any external or even rational cause. It is like an artesian fountain. It rejoices because it cannot help it. It is the glory of God; it is the heart of Christ; it is the joy divine of which He says, *These things have I spoken unto you, that my joy might remain in you, and that your joy might be full* (John 15:11). And your joy no man can take from you. Those who possess this fountain are not discouraged by surrounding

Excerpt from Simpson, *Days of Heaven On Earth: A Daily Devotional to Comfort and Inspire* (June 4, 2018 Office Action, TSDR 15).

It was a beautiful fall day. The car windows were all rolled down. I (Josh) was in my first year of college, and I was driving some of my friends from campus to downtown. We were laughing and just having a lot of fun. A woman pulled up beside us at the traffic light, rolled down her window, and with a scowl on her face said, “What right do you kids have to be so happy!”

### Our Desire for Deep Happiness

Deep down all of us want to be happy. We want to live a satisfying life, a life of joy and contentment. Actually, God wants us to enjoy that as well. Jesus said, “I have told you this so that my joy may be in you and that your joy may be complete” (John 15:11 NIV). Yet the quest for deep happiness often eludes us. Webster’s dictionary defines happiness as “a pleasurable or satisfying experience.” Happiness is often equated with pleasurable feelings. And of course there’s nothing inherently wrong with pleasurable satisfaction, except in how we pursue it.

Excerpt from McDowell & McDowall, *The Unshakable Truth: How You Can Experience the 12 Essentials of a Relevant Faith* (June 4, 2018 Office Action, TSDR 16).

What does **John 15:11–12** convey that will be a part of this relationship?

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Sisters, as an outpouring of this intimate relationship with our Lord, we will experience the fullness of joy. It is through this relationship that we develop a love for one another.

Excerpt from Joy, *A Journey Toward Contentment* (June 4, 2018 Office Action, TSDR 17).

The goal of this receptive learning of the Word, possible only in the Holy Spirit, consists in our bearing the ecclesial fruit of the eternal life of the community of the blessed. Aquinas interprets Christ's wish "that that your fruit should abide" (John 15:16) to mean "that the society of the faithful would be led into eternal life and their spiritual fruit flourish: 'He gathers fruit for eternal life' (John 4:36)."<sup>18</sup> Christ desires eternal life for us, and so he gives us his Wisdom – that is, himself – that inspires love. He does this in two ways: through the gift of faith, and through the sacrament of the Eucharist. As Aquinas remarks in his *Commentary on John* as regards the Eucharist, "whatever is an effect of our Lord's passion is also an effect of this sacrament. For this sacrament is nothing other than the application of our Lord's passion to us."<sup>19</sup> Christ's gift of himself in the Eucharist flows from his desire to unite human beings to himself; he enables us to "love one another as I have loved you" by enabling us to share Eucharistically in the self-giving love of his sacrifice on the Cross. The Eucharist enables us to abide in the divine Wisdom of his Pasch. Abiding in and with him, in the joy of the life of the Trinity, we accomplish his intense desire, his thirst, that "my joy may be in you, and that your joy may be full" (**John 15:11**).

Excerpt from Levering, *Sacrifice and Community: Jewish Offering and Christian Eucharist Contentment* (June 4, 2018 Office Action, TSDR 18)

Excerpt from Ringma, *Hear the Ancient Wisdom: A Meditational Reader for the Whole Year* (June 4, 2018 Office Action, TSDR 20).



## Evening, October 3 JOY: Jesus--Others—Yourself

**John 15:11 (NLT)**

**"I have told you these things so that you will be filled with My joy. Yes, your joy will overflow!"**

Have you ever stopped to think and reflect on the fact of this verse.....that the Lord Jesus Christ desired that His disciples and all His followers be filled with joy; actually filled with HIS joy? The joy He is talking about is "chara" ("Car-rah") that literally means cheerfulness and calm delight. As you read these words, can you honestly say that you are filled with cheerfulness and calm delight? Yet that is what Jesus wants you to be and to overflow with cheerfulness and calm delight. I know that when I reflect on this I confess that this is very difficult for me. To have the kind of joy that Jesus is referring to here probably is very difficult for the great majority of Christians to experience and practice. Yet, why is this so?

The famous British theologian, C.S. Lewis, described joy and happiness this way: "A car is made to run on petrol, and it would not run properly on anything else. Now God designed the human machine to run on Himself. He Himself is the fuel our spirits were designed to burn, or the food our spirits were designed to feed on. There is no other. That is why it is just no good asking God to make us happy in our own way without bothering about religion. God cannot give us a happiness and peace apart from Himself because it is not there."<sup>129</sup>

What does **John 15:11** and Lewis' analogy teach you (and definitely teaches me as I write this)? Joy—cheerfulness, calm delight—comes from God through Christ. Joy is one of the 9 attributes or fruits of the Holy

Excerpt from Akers, *Morning and Evening Meditation from the Word of God: Education, Challenge* (June 4, 2018 Office Action, TSDR 23).

John 12; 3 John 4). John's statement here echoes one of Jesus, who, on the night before he died, consoled his disciples by saying, "I have told you this so that my joy may be in you and that *your* joy may be complete" (italics added; **John 15:11**). If John's gospel influenced the author's choice of words here, it provides intrinsic evidence that the original reading was the second person plural.

The repetition of the verb "write" (γράφω) throughout 1 John makes it difficult to argue that this book originated as anything but in written form, despite its rhetorical features that suggest an oral delivery.<sup>37</sup> Given that most reading was done aloud in the first century, even written works would have been composed with consideration of how the wording sounded, and the elusive structure of 1 John may be due largely to this aural context, which is unfamiliar to readers within literary cultures.<sup>38</sup> Although it originated as written discourse, the letter's lack of the standard Hellenistic letter opening and of any



Excerpt from *Jobes, 1, 2, and 3 John (Zondervan Exegetical Commentary on the New Testament)* (June 4, 2018 Office Action, TSDR 22).

Supplementing the evidence of recognition of JOHN 15:11 as the shorthand reference to the Bible verse, the Examining Attorney submitted evidence that JOHN 15:11 is commonly referenced as a Bible verse:

Today's readings are so wonderful and are the heart of what it means to be a Christian.

To take an especially significant example, Jesus repeatedly speaks of joy at the Last Supper. In John 15:11, Jesus says, "I have told you this so that my joy may be in you and your joy may be complete." Although we are not yet defining joy, note that Jesus says these words knowing that he is soon to suffer and die on the Cross.

Hudson Taylor was the founder of the China Inland Mission, and ... [and in 1869] [h]e began to drink more deeply at the experiential fountain of John 15:1-11. He was given a deeper, and more constant, more satisfying experience of abiding in Christ. ... So this passage of Scripture has proved to be enormously important in both the experience and the articulation of the doctrine of union with Christ.

Jesus wrote these very important things about love for the purpose of our joy. He's basically telling us that if we focus on loving others as he's loved us, we'll have the joy our hearts crave.

The Family Blessing Projects delivers three very important gifts that are priceless:

1. The Gift of Joy: In John 15:11 it says, "I have told you this so that my joy may be in you and that your joy may be complete." When a family knows their church family cares about them, joy is delivered.

July 2019 Office Action, TDSR 5-7, 9-10

In addition, the Examining Attorney submitted evidence that the Bible verse John 15:11 is referenced on a variety of common items, a sample of which are shown below:



*JOHN 15:11 PHONE CASE*



*JOHN 15:11 T-SHIRT*



*JOHN 15:11 PENCIL HOLDER*



*JOHN 15:11 COASTERS*



*JOHN 15:11 MUG*




*JOHN 15:11 SWITCH PLATE*



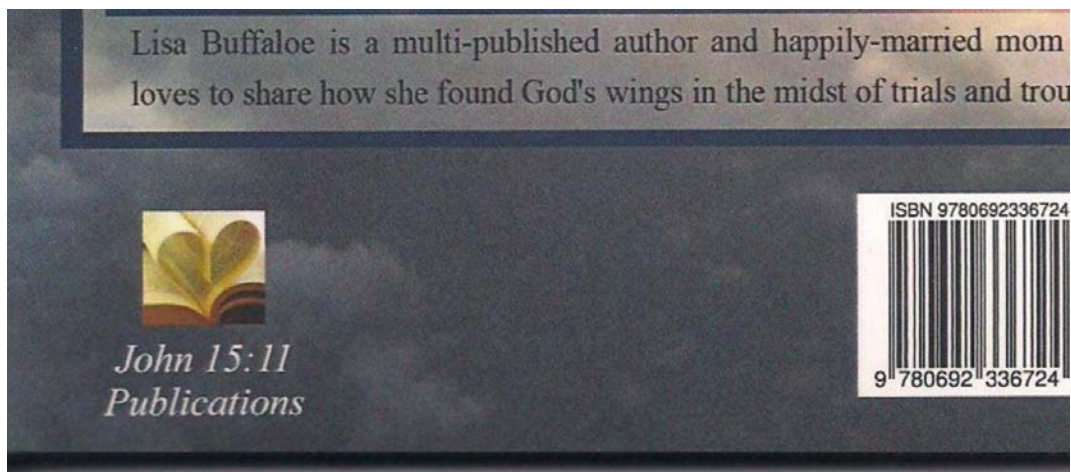
#### **IV Applicant's Evidence and Arguments**

Applicant argues that her specimens of use show JOHN 15:11 PUBLICATIONS in an online advertisement for her electronic publication and in the lower left hand corner on the back cover of a print publication, that these are typical uses of a trademark for publications, that marks with Bible verses or citations are routinely registered, that the additional term PUBLICATIONS distinguishes the proposed mark from Bible verses that fail to function as a mark; and, in sum, that the Examining Attorney has failed to show that JOHN 15:11 PUBLICATIONS does not function as a mark for Applicant's inspirational and religious publications.

In support of her argument that JOHN 15:11 PUBLICATIONS will be perceived by the relevant public as a trademark for Applicant's publications, Applicant relies on the specimens of use, pages from her website, dictionary definitions, and third party registrations. With respect to the specimens, Applicant contends that JOHN 15:11 PUBLICATIONS appears at the beginning of her electronic book and on the back cover of her print book, and thus will be perceived as a trademark.

Kindle Book	Print Book
 <p>No Wound Too Deep For The Deep Love Of Christ (Kindle Edition) by Lisa Buffaloe</p> <p>★★★★★ (11) Kindle Edition <b>\$0.99</b></p> <p><b>Buy with 1-Click</b></p> <p>Deliver To Mark Lebow's iPad ▼</p> <p>Send this sample to your Kindle <b>Try a Sample</b></p> <hr/> <p><b>Book sections</b></p> <p>Cover</p> <p>Beginning</p>	<p>© 2014 Lisa Buffaloe</p> <p>Published by <b>John 15:11 Publications</b>, Boise, ID</p> <p>ISBN: 978-0-9859295-9-6</p> <p>All rights reserved. No part of this book may be reproduced in any form or by any means, electronic or mechanical, including photocopying, recording, or by any information storage and retrieval system, without the prior written permission of the publisher or the author. The only exception is brief quotations for review purposes.</p> <p>Scripture taken from the English Standard Version (ESV) Standard Version Copyright © 2001 by Crossway Bibles, Publishers.</p>

*Specimen for electronic publications*



*Specimen for print publications*



Applicant also contends that the public encounters JOHN 15:11 PUBLICATIONS throughout her website, and as part of the sales information when purchasing a book, and these uses reinforce that JOHN 15:11 PUBLICATIONS is a trademark.



*Example from Applicant's website*

## Product details



**Paperback:** 216 pages  
**Publisher:** John 15:11 Publications (April 27, 2018)  
**Language:** English  
**ISBN-10:** 0692132406  
**ISBN-13:** 978-0692132401  
**Product Dimensions:** 7 x 0.5 x 10 inches

*Example of Applicant sale listing*

December 27, 2018 Response, TSDR 25-55.

Applicant also submits the third party registrations with Bible verse citations listed below to show (Brief, 7 TTABVUE 10) that the USPTO "routinely permits registrations of Bible chapter and verse citations or similar terms, either with a

design or a stylized element, or in standard characters, with no disclaimer of the religious verse or term.”

Reg. 2909992	ACTS 16:5 INITIATIVE	Conducting religious conferences
Reg. 3724095		Christian brochures, stationery, business cards
Reg. 4308012		Indicating membership in a religious women's organization

January 9, 2019 Response, TSDR 51-54; .

Applicant submitted other third party registrations which are not citations to Bible verses, and so do not demonstrate that the Office allows registration of marks consisting of or comprising a Bible verse. As set forth above, the term JOHN 15:11 refers to the Biblical verse “These things I have spoken to you so that My joy may be in you, and that your joy may be made full.” by providing the book, chapter, and verse where the words are located in the Bible. We do not find probative to our analysis in this case third party registered marks comprising the name of a book of the Bible, or the name and chapter of a book of the Bible, because these marks have a different

commercial connotation, describing a complete narrative, and not a single Bible verse.

Similarly, we do not find probative to our analysis in this case third party registered marks comprising two numbers separated by a colon, but which are not connected with a particular Book from the Bible. Not only might such numbers refer to any number of Bible verses, but in various contexts such numerical expression may be understood to indicate a time, a ratio, or a proportion, all of which have a different commercial impression than the term for which Applicant seeks registration.

Finally, we do not find probative to our analysis in this case the third party registered mark comprising a sentiment from a Bible verse (REJOICE IN THE LORD), because the verse creates a different commercial impression than either the citation JOHN 15:11 or the corresponding Bible verse “These things I have spoken to you so that My joy may be in you, and that your joy may be made full.”

## V. Analysis

In determining whether the asserted mark has been used as a trademark with respect to the goods named in the application, the manner in which an applicant has employed the asserted mark, as evidenced by the specimens of record, must be carefully considered. *In re Bose Corp.*, 192 USPQ at 216; *In re AOP LLC*, 107 USPQ2d 1644 (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.”).

As set forth above, we agree that Applicant has placed her purported mark JOHN 15:11 PUBLICATIONS where source indicators for publications generally are found on the copyright page and the back cover of her publications. However, as set forth above, the Board does not measure Applicant’s effort in having her proposed mark perceived as a source indicator, but rather her success in doing so. “In every case, the question is not whether the mark has been associated with the goods by a particular mode or manner, but whether the matter sought to be registered performs the function of a trademark by signifying to purchasers the source of the goods sold or offered for sale.” *In re Paramount Pictures Corp.*, 213 USPQ 1111, 1115 (TTAB 1982). More specifically, a specimen with technically acceptable evidence of use does not end the inquiry as to how the relevant public perceives the purported mark. *D.C. One Wholesaler, Inc v. Chien*, 120 USPQ at 1716 (“The fact that Respondent has sometimes displayed I♥DC on hangtags and labels, in a non-ornamental manner that is conventional for the display of trademarks, does not require a different result.”); *In re Remington Prods. Inc.*, 3 USPQ2d 1714, 1715 (TTAB 1987) (“[T]he mere fact that applicant’s slogan appears on the specimens, even separate and apart from any other indicia which appear on them, does not make it a trademark.”).

While the evidence indicates that there are some variations in the wording of the Bible verse John 15:11, depending on the source and translations, the variations are minor, and all include the identical reference to joy, which is, in all versions of record,

used twice in a verse of just two dozen words. Furthermore, there is no variation in how to cite the verse. Rather, we find that JOHN 15:11 always cites to the same eleventh Biblical verse in the fifteenth chapter in the book of John. The record demonstrates that JOHN 15:11 is not an obscure Biblical verse, but rather is commonly referenced in publications, sermons, and various consumer goods.

We also find that the evidence of record demonstrates that the addition of the term PUBLICATIONS to the JOHN 15:11 Bible verse does not alter the non-trademark significance of JOHN 15:11 when used on publications. A “publication”<sup>6</sup> or “published work”<sup>7</sup> is the result of creative effort which has been released or disseminated to the public, and this description applies to all of Applicant’s listed goods, downloadable and printed books and electronic publications featuring inspirational and religious fiction and non-fiction not featuring the bible verse John 15:11.<sup>8</sup> Because Applicant disclaimed any exclusive right to use PUBLICATIONS apart from the mark as

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<sup>6</sup> publication *noun*

2 : a published work

<sup>7</sup> work *noun*

3a : something produced or accomplished by effort, exertion, or exercise of skill this book is the work of many hands

b : something produced by the exercise of creative talent or expenditure of creative effort : artistic production an early work by a major writer

<sup>8</sup> publish *verb*

2a : to disseminate to the public

b : to produce or release for distribution

specifically : PRINT sense 2c

c : to issue the work of (an author)

*Merriam-Webster, <https://www.merriam-webster.com/dictionary/>*

shown, this is not in dispute. *Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972) (disclaimer is an admission of descriptiveness at the time the disclaimer was made).

This description of a publication also applies to all the Internet writings in the form of sermons, blog posts, Bible commentary, daily inspirational essays, workbooks, and books on religion which feature JOHN 15:11 and were made of record by the Examining Attorney. Of particular note, the Examining Attorney submitted evidence of three different online sermon databases which include John 15:11 sermons, or publications. Using John 15:11 as a search term, the Examining Attorney demonstrated that the combined search results for John 15:11 sermons were in the hundreds.

We have considered Applicant's evidence that the Bible verses ACTS 16:5, PROV. (or Proverbs) 16:3, and HEBREWS 10:24-25 form part of registered marks for religious goods and services, and have not been disclaimed, but we are not convinced that the evidence leads to a different result here. The record before us includes significant evidence of how and under what circumstances the public encounters the term JOHN 15:11, including in connection with JOHN 15:11 publications. Applicant, who contends that its mark also should be allowed to register, makes no effort to demonstrate that the public encounters the Bible verses ACTS 16:5, PROV. (or Proverbs) 16:3, and HEBREWS 10:24-25 in the same way.

Based on this record, we are persuaded that public perception of the term JOHN 15:11 PUBLICATIONS is shaped by the ready availability of hundreds of JOHN

15:11 publications online as well as the recognition of the Bible verse JOHN 15:11 to the public, as shown by the broad market for goods from light switches to coasters bearing the verse. We find that JOHN 15:11 PUBLICATIONS as used by Applicant merely provides information about the identified goods, and is not perceived as indicating a single source for Applicant's print and electronic religious and spiritual publications.

After our decision on the failure to function issue, there is no reason to consider the claim of deceptive misdescriptiveness; both of these claims bear on the same ultimate issue, that is, the registrability of Applicant's mark based on the present application. We have "discretion to decide only those claims necessary to enter judgment and dispose of the case," as our "determination of registrability does not require, in every instance, decision on every pleaded claim." *Multisorb Tech., Inc. v. Pactive Corp.*, 109 USPQ2d 1170, 1171-72 (TTAB 2013) (citing *Am. Paging Inc. v. Am. Mobilphone Inc.*, 13 USPQ2d 2036, 2039-40 (TTAB 1989)), *aff'd*, 923 F.2d 869, 17 USPQ2d 1726 (Fed. Cir. 1990) (non-precedential).

#### IV. Decision

The refusal to register Applicant's mark JOHN 15:11 PUBLICATIONS for failure to function as a trademark for Applicant's electronic and print inspirational and religious publications is affirmed.