

THIS ORDER IS NOT A
PRECEDENT OF THE TTAB

Mailed: December 15, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Erik Brunetti

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Serial Nos. 88308426, 88308434, 88308451, and 88310900

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John R. Sommer, Attorney at Law,
for Erik Brunetti.

Curtis W. French, Trademark Examining Attorney, Law Office 130,
John Lincoski, Managing Attorney.

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ON RECONSIDERATION

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Before Bergsman, Dunn and Lebow,
Administrative Trademark Judges.

Opinion by Lebow, Administrative Trademark Judge:

On August 22, 2022, the Board issued a final decision affirming the Examining Attorney's final refusals to register the word FUCK in Application Serial Nos. 88308426, 88308434, 88308451, and 88310900, for failure to function as a mark under Sections 1, 2, 3 and 45 of the Trademark Act for the goods and services identified therein. Now before us is "Applicant's Motion for Reconsideration; Augmentation of

Record; Remand,” which was filed on September 22, 2022.¹ Applicant’s request for reconsideration was filed within one month of the date of the Board’s final decision and is therefore timely.²

I. Reconsideration

The premise underlying a request for reconsideration is that, based on the evidence of record and the prevailing authorities, the Board erred in reaching the decision it issued, and a request for reconsideration normally should be limited to a demonstration that based on the evidence properly of record and the applicable law, the Board's ruling is in error and requires appropriate change. *In re Berkeley Lights, Inc.*, 2022 USPQ2d 1000 at *2 (TTAB 2022), citing TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 543 (June 2022). In other words, Applicant should point out factual errors or legal errors in the Board’s decision.

Here, Applicant does not argue that the evidence of record fails to support the Board's finding, that the Board misapplied the law, or that the Board ignored evidence supporting Applicant's right to register its proposed mark. Instead, Applicant asserts that “[t]he basis for this motion [for reconsideration; augmentation of record; remand] is that the sole ground for refusal of the Applications was the

¹ 20 TTABVUE (Serial No. 88308426); 34 TTABVUE (Serial No. 88308434); 29 TTABVUE (88308451); 62 TTTABVUE (Serial. No. 88310900). The same combined motion was filed with respect to each application, which have similar records. We cite to the record in application Serial No. 88310900 unless otherwise indicated.

² As noted in our order of November 18, 2022, although Applicant’s consolidated request for reconsideration was not filed with respect to Application Serial No. 88308434 until September 23, 2022, one day after the deadline, we consider it timely filed because Applicant’s consolidated request that was timely filed for the other three applications identified all four serial numbers and addressed all four cases.

Widely-Used Commonplace Word Doctrine (hereafter “Commonplace Word Doctrine.”) The Board’s decision was based upon a different doctrine, the Failure-to-Function (“FTF”) Doctrine.”³ Applicant elaborates:

The Board’s Opinion should be reconsidered because it was based upon the FTF Doctrine, which was not raised below, thus denying Brunetti the opportunity to introduce evidence about FTF because he had no reason to believe it was in issue. Nor did he have any reason to discuss the Doctrine in his opening brief or reply brief. ... ⁴

Applicant made a similar argument in his reply brief in the appeal:

The PTO’s brief mentions in passing Failure to Function. But that was not the ground for refusal. The PTO repeatedly chose to stand by Widely-Used Commonplace Words as its sole ground for refusal. On appeal, it is too late for the PTO to add a completely different ground for refusal.

We rejected that argument in our decision for lack of merit. Put simply, the premise of Applicant’s motion – that the Examiner never raised failure to function as a refusal in the Applications – is false. As we explained in our decision:⁵

[T]he Examining Attorney mentions or paraphrases “failure to function” 26 times in his brief, which can hardly be characterized as a mention in passing. Further, the Examining Attorney in this case clearly stated the legal basis for the refusal in each office action preceding the briefing of the appeal:

Registration is refused because the applied-for mark is a slogan or term that does not function as a trademark or service mark to indicate the source of applicant’s goods and/or services and to identify and distinguish them from others. Trademark Act Sections 1, 2, 3, and 45, 15 U.S.C. §§1051-1053, 1127.

³ 62 TTABVUE 3 (Applicant’s Motion).

⁴ *Id.*

⁵ 33 TTABVUE 27 (emphasis added).

In his motion for reconsideration, Applicant doubles down on his dubious claim that no failure to function refusal was ever raised, undeterred by our finding that the refusals were properly before the Board. Because this was fully addressed in our decision, we see no need to retread this ground.

The nature of the refusal – failure to function under Sections 1, 2, 3, and 45 (i.e., relevant consumers will not perceive the term Applicant seeks to register to be a trademark) – has been clear throughout prosecution and Applicant was adequately apprised that the refusals of his proposed mark were based on its asserted failure to function as a trademark under Sections 1, 2, 3, and 45. Consequently, we see no error in having affirmed the refusals on that basis in our final decision.

II. Augmentation / Remand

As an alternative request for relief, Applicant moves to augment the record in this case by introducing approximately 7,371 pages of evidence he filed with the Board one day after filing his motion that he would have submitted previously “if he had known that the Board intended to rely on the FTF doctrine.”⁶ According to Applicant, “[i]f the Board can raise a new ground on appeal, then Brunetti should be given the opportunity to rely on evidence and argument in response to the new ground. It cannot be a one-sided rule that only benefits the PTO.”⁷ While “augmentation of the record should not be granted after the appeal is filed, and certainly not after the decision,” “that presumes that the Board did not violate fundamental fairness by

⁶ 62 TTABVUE 12 (Applicant’s Motion); 34-61, 63-70 TTABVUE.

⁷ *Id.*

basing its opinion on a ground not raised below.”⁸ “[I]n this unique situation,” he argues, “augmentation of the record should be granted.”⁹

Applicant seeks remand as a further, alternative request for relief in the event reconsideration and augmentation are not granted. As Applicant puts it, “[i]f the Board is going to rely on FTF, instead of Commonplace Word, then [Applicant] has the right to put into the record such evidence and argument.”¹⁰

Because no new ground was raised by the Board, Applicant’s arguments for augmentation and remand are unavailing. In addition, once an application has been considered and decided on appeal it will not be reopened except for the entry of a disclaimer or upon order of the Director,¹¹ neither of which is applicable here. Trademark Rule 2.142(g), 37 C.F.R. § 2.142(g). *See also In re Societe d’Exploitation de la Marque Le Fouquet’s*, 67 USPQ2d 1784, 1789 (TTAB 2003) (Board explained it had no authority to grant applicant’s request made in the last sentence of its appeal brief for restoration of jurisdiction over its application to the Examining Attorney so that the applicant could amend the basis of its application); *In re Johanna Farms, Inc.*, 223 USPQ 459 (TTAB 1984) (Applicant’s request to reopen ex parte prosecution to submit additional evidence denied as an unavailable under Rule 2.142(g); and

⁸ 61 TTABVUE 12 (Applicant’s Motion).

⁹ *Id.*

¹⁰ *Id.*

¹¹ A petition to the Director to reopen an application will be considered only upon a showing of sufficient cause for consideration of any matter not already adjudicated. TBMP § 1218; *In re Vesper Corp.*, 8 USPQ2d 1788, 1789 n.3 (Comm’r 1988) (petitions to reopen are granted only when proposed amendment would place application in condition for publication, subject to updating search, and no other examination by examining attorney would be required).

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Board rejected contention that the affirmance of the refusal was “on a basis different than that of the Examining Attorney.”); TBMP §§ 1217-1218 (June 2022); TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1501.06 (July 2022) and cases cited therein.

Decision: Applicant’s “Motion for Reconsideration; Augmentation of Record; Remand” is denied. The Board’s August 22, 2022 decision stands as issued.