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Mailed: July 27, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

*Milk & Honey LLC*
*v.*
*Melissa Beeson, d/b/a Spoon Tracker*

Opposition Nos. 91221098 and 91222928

CONSOLIDATED PROCEEDINGS[1]

Robert D. Michaux of Thorsen Hart & Allen LLP for Milk & Honey LLC.

Kerri E. Dobbins of Fears Nachawati PLLC for Melissa Beeson.

Before Shaw, Adlin, and Larkin, Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

Melissa Beeson,[2] a sole proprietorship d/b/a Spoon Tracker ("Applicant"), seeks registration of the mark STILL SPOONING, in standard characters, on the Principal Register for "Custom imprinting of flatware and fishing lures," in International Class

[1] The proceedings were consolidated by order of the Board on November 17, 2015. In this decision, TTABVUE citations refer to the record in Opposition No. 91221098.

[2] During the course of these proceedings Applicant married and changed her name from McKeon to Beeson. We have updated the caption accordingly.

40"[3] and "On-line retail store services featuring a wide variety of consumer goods," in International Class 35.[4] Milk & Honey LLC ("Opposer") opposes registration, *inter alia*, on the grounds that STILL SPOONING is merely descriptive, and also that STILL SPOONING is merely ornamental and thus fails to function as a source identifier for Applicant's services.[5] Applicant has denied the salient allegations of the notices of opposition.

I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the files of the involved applications. Opposer submitted the following evidence via Notice of Reliance:[6]

1. Transcript of its discovery deposition of Applicant Melissa Beeson ("Beeson Dep."), and exhibits, including copies of Applicant's web pages, product

[3] Application Serial No. 86417226, filed on October 7, 2014, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging a date of first use anywhere and in commerce of August 28, 2014.

[4] Application Serial No. 86547415, filed on February 26, 2015, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging a date of first use anywhere and in commerce of August 28, 2014.

[5] Opposer's Br., p. 7, 11 TTABVUE 13. Opposer also argues that Applicant's specimens do not satisfy the requirements for registration. This is not a valid ground for opposition. *See, e.g.*, *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1273 n.6 (TTAB 1992) ("[T]he question of the sufficiency of the specimens is not a proper ground for opposition."); *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355, 1358 (TTAB 1989) ("[T]he insufficiency of the specimens, per se, is not a ground for cancellation."); *Century 21 Real Estate Corp. v. Century Life of America*, 10 USPQ2d 2034, 2035 (TTAB 1989) ("[I]t is not the adequacy of the specimens, but the underlying question of service mark usage which would constitute a proper ground for opposition.").

[6] 7 TTABVUE.

listings, sales figures, and e-mails between Applicant and Opposer and third parties regarding use of STILL SPOONING;[7]

2. Excerpts of Applicant's Responses to Opposer's Interrogatories; and
3. Excerpts of Applicant's admissions in response to Opposer's Requests for Admission.

Applicant submitted the following evidence via Notice of Reliance:

1. Applicant's Responses to Opposer's Interrogatories; and
2. Applicant's Responses and Amended Responses to Opposer's Requests for Production of Documents.[8]

II. The Parties

Applicant is an online retailer of gifts, primarily flatware and fishing lures, all imprinted with various personal messages.[9] Some of the items are sold with pre-printed messages celebrating annual events such as anniversaries, whereas other items are custom-imprinted with messages created by the purchaser.[10] Applicant's goods are sold primarily through an electronic "storefront" on Etsy.com, an online retail community. Applicant also sold her goods on Amazon.com, but has discontinued such sales.

[7] The parties stipulated to use of the Beeson Deposition as trial testimony. *See also* Trademark Rule 2.120(k)(1).

[8] We note that Applicant submitted her own responses to Opposer's discovery requests as part of its Notice of Reliance, 8 TTABVUE. However, Trademark Rule 2.120(k)(5), 37 C.F.R. § 2.120(k)(5), permits the introduction of discovery responses only by the *receiving* party, subject to a limited exception not applicable here.

[9] Beeson Dep., pp. 11-12, 7 TTABVUE 16-17.

[10] *Id.* at 8, 7 TTABVUE 13.

Opposer also is an online retailer selling similar goods, identified as "gifts and housewares, including vintage silverware which has been hand stamped" with words or phrases.[11] Opposer too sells its goods through several online retail sites, including Etsy.com.[12]

III. Standing

Standing is a threshold issue that must be proven by the plaintiff in every *inter partes* case. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 1401 (2015); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). Our primary reviewing court, the U.S. Court of Appeals for the Federal Circuit, has enunciated a liberal threshold for determining standing, namely that a plaintiff must demonstrate that it possesses a "real interest" in a proceeding beyond that of a mere intermeddler, and "a reasonable basis for his belief of damage." *Empresa Cubana Del Tabaco* 111 USPQ2d at 1062 (citing *Ritchie v. Simpson*, 170 F.3d 1902, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999)). A "real interest" is a "direct and personal stake" in the outcome of the proceeding. *Ritchie v. Simpson*, 50 USPQ2d at 1026.

In order to establish its standing to object to the registration of an allegedly merely descriptive or ornamental term, a plaintiff need only show that it is engaged in the manufacture or sale of the same or related goods as those listed in the defendant's involved application or registration or that the product in question is one

[11] Opposer's Notice of Opposition, p. 1, 1 TTABVUE 3.

[12] *Id.* at 2, 1 TTABVUE 4.

which could be produced in the normal expansion of plaintiff's business; that is, that plaintiff has a real interest in the proceeding because it has a present or prospective right to use the term in its business. *See Binney & Smith Inc. v. Magic Markers Indus., Inc.*, 222 USPQ 1003, 1010 (TTAB 1984) (allegations that a petitioner is engaged in the manufacture or sale of the same or related products as those listed in respondent's involved registration, or that the product in question is one which could be produced in the normal expansion of petitioner's business, constitute a sufficient pleading of standing); *Southwire Co. v. Kaiser Aluminum & Chem. Corp.,* 196 USPQ 566, 572-73 (TTAB 1977).

Like Applicant, Opposer sells housewares imprinted with the wording STILL SPOONING.[13] This establishes its standing. *Ritchie v. Simpson*, 50 USPQ2d at 1026. Moreover, Applicant has sought to limit Opposer's ability to sell its imprinted goods on sites like Etsy.com by alleging trademark infringement, which also establishes Opposer's standing.[14] *See e.g. Ipco Corp. v. Blessings Corp.*, 5 USPQ2d 1974, 1976-77 (TTAB 1988). Opposer has therefore established its standing. *See Empresa Cubana Del Tabaco,* 111 USPQ2d at 1061-62.

IV. Whether STILL SPOONING is merely descriptive

Citing Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), Opposer first argues that STILL SPOONING is unregistrable because it is a "descriptive term for Applicant's goods."[15] Opposer points to Applicant's web page and Applicant's

[13] Exh. 7 to Beeson Dep., 7 TTABVUE 216-24.

[14] *Id.*

[15] Opposer's Br., p. 9, 11 TTABVUE 15.

testimony wherein STILL SPOONING is sometimes used to refer to flatware and lures imprinted with the term STILL SPOONING. In essence, Opposer is arguing that STILL SPOONING is merely descriptive of Applicant's services simply because it appears on the goods and because Applicant stated that STILL SPOONING "describes the product."[16] This argument is unpersuasive. It conflates common or ordinary use of the term "describes" with the Trademark Act's statutory prohibition on registration of merely descriptive marks.

"Spooning" is defined as the gerund or present participle of the verb "spoon":

> **spoon**
>
> 1. convey (food) somewhere by using a spoon.
> "Rosie spooned sugar into her mug"
>
> 2. Informal dated
> (of two people) behave in an amorous way; kiss and cuddle.
> "I saw them spooning on the beach"[17]

As used on Applicant's flatware and lures, STILL SPOONING intends to celebrate interpersonal relationships and thus conveys no information about the services themselves. By Opposer's logic, every mark applied to goods could be considered merely descriptive of the service of creating those goods because the mark could and probably would be used in referring to the goods. Under this logic, APPLE for computers and FORD for cars would be merely descriptive because APPLE and FORD "describe"—in the sense Opposer is using the term—a particular type (brand) of computer or a car. Such an outcome is anathema to trademark law. The fact that

[16] Beeson Dep., p. 112, 7 TTABVUE 117.

[17] 8 TTABVUE 258.

Applicant's services create goods imprinted with STILL SPOONING, and that Applicant's web page depicts the goods bearing STILL SPOONING does not make the mark merely descriptive inasmuch as STILL SPOONING does not "immediately convey[] knowledge of a *quality, feature, function, or characteristic* of" Applicant's services. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (emphasis added) (quoting *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); *In re Gyulay,* 820 F.2d 1216, 3 USPQ2d 1009, 1009-10 (Fed. Cir. 1987).

For the foregoing reasons, we find that STILL SPOONING is not merely descriptive when used in connection with the identified services.

V. Whether STILL SPOONING is merely ornamental and thus fails to function as a source identifier for the identified services

Subject matter presented for registration must function as a trademark or service mark. 15 U.S.C. §§ 1051, 1052, and 1127. *In re Bose Corp*., 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1976) ("Before there can be registration, there must be a trademark."). Sections 1, 2, and 45 of the Trademark Act provide the statutory bases for refusal to register on the Principal Register subject matter that, due to its inherent nature, does not function as a mark to identify and distinguish an applicant's services. It is well settled that not every designation that is used in connection with services necessarily functions as a service mark and not every designation adopted with the intention that it perform a service mark function necessarily does so. *In re Hulting*, 107 USPQ2d 1175, 1177 (TTAB 2013).

Opposer argues that STILL SPOONING is unregistrable for Applicant's services because it is "an ornamental feature . . . for Applicant's goods."[18] That is, inasmuch as some of Applicant's products have been imprinted with STILL SPOONING, "the only possible significance the Still Spooning Designation would have to any purchaser is as an ornamental feature [of] Applicant's goods."[19]

Applicant counters that "the issue of ornamental usage is irrelevant and does not apply in this matter."[20] For authority, Applicant cites to Section 1202.03 of the Trademark Manual of Examining Procedure ("TMEP") which states: "Generally, the ornamentation refusal applies only to trademarks, not to service marks." When read in its entirety, TMEP Section 1202.03 is not as clear-cut as Applicant suggests. Indeed, it refers readers to Section 1301.02(a) (Matter that Does Not Function as a Service Mark) which states: "Matter that is merely ornamental in nature does not function as a service mark." This language suggests that whether matter is ornamental is relevant to service mark registrability determinations. Although the TMEP is not binding on the Board, *West Florida Seafood Inc. v. Jet Rests. Inc.*, 31 USPQ2d 1660, 1664 n.8 (Fed. Cir. 1994) ("While the TMEP does not have the force and effect of law, it sets forth the guidelines and procedures followed by the examining attorneys at the PTO."), in this instance we concur with the TMEP's general proposition that merely ornamental matter does not function as a service

[18] *Id.* at 9, 11 TTABVUE 15.

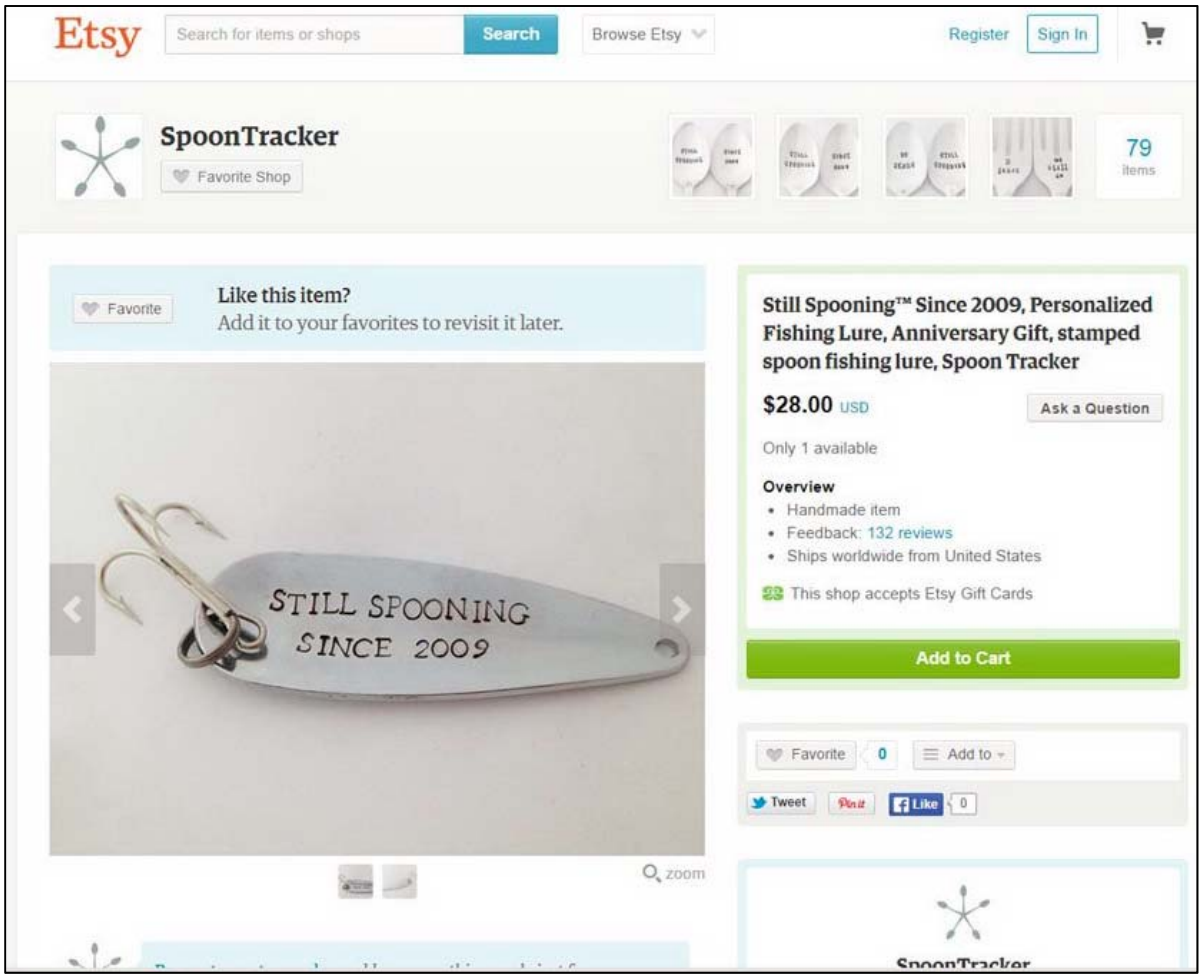
[19] *Id.* at 10, 11 TTABVUE 16.

[20] Applicant's Br., p. 7, 12 TTABVUE 8.

mark. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1684 (Fed. Cir. 2010) ("Cuffs & Collar [service] mark constitutes 'a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods.'"); *In re Chevron Intellectual Prop. Grp. LLC*, 96 USPQ2d 2026 (TTAB 2010) (affirming that applicant's gasoline pump signage "is a mere refinement of a commonly used form of a gasoline pump ornamentation rather than an inherently distinctive service mark for automobile service station services"); *In re File*, 48 USPQ2d 1363, 1367 (TTAB 1998) (stating that novel tubular lights used in connection with bowling alley services would be perceived by customers as "simply a refinement of the commonplace decorative or ornamental lighting . . . and would not be inherently regarded as a source indicator."); and *In re Tad's Wholesale, Inc.*, 132 USPQ 648 (TTAB 1962) (ornamental wallpaper design was found to be unregistrable as a service mark for restaurant services).

The critical inquiry in determining whether a potentially ornamental designation functions as a mark is how the designation would be perceived by the relevant consumers. To make this determination we look to 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); *Michael S. Sachs Inc. v. Cordon Art B.V.*, 56 USPQ2d 1132, 1135 (TTAB 2000).

Specimens from the two involved applications appear below.



[21]

[21] Serial No. 86417226, Application of October 7, 2014, TSDR p. 4.

[22]

These web pages present the prospective consumer with a variety of terms used as possible marks. "Etsy," in the upper left hand corner, is the name of the third-party platform through which Applicant sells her goods. The terms SPOONTRACKER and SPOON TRACKER appear prominently at the top of both pages and in the largest font. On the Serial No. 86547415 specimen, SPOONTRACKER appears just below the gray banner followed by the wording

[22] Serial No. 86547415, Application of February 26, 2015, TSDR p. 3.

"Personalized spoons, stamped silverware, Unique Gifts." SPOONTRACKER also appears immediately after the wording "Shop Info." And the wording "FEATURED ITEMS FROM SPOONTRACKER" appears immediately above Applicant's featured flatware and a lure. Given the prominence of SPOONTRACKER and SPOON TRACKER and their close association with wording describing Applicant's services, we find that consumers would likely view these terms as identifying the source of Applicant's retail services and custom imprinting services inasmuch as they appear in the same place and manner as service marks are typically used on webpages.

The use of STILL SPOONING is much less prominent than the use of SPOON TRACKER and is not closely associated with any wording describing or identifying Applicant's services. For example, STILL SPOONING appears prominently on both the fishing lures and on five of the seven "featured" utensil sets, as well as in the product descriptions accompanying them. The fishing lure product description on the Serial No. 86417226 specimen reads: **Still Spooning™ Since 2009, Personalized Fishing Lure, Anniversary Gift, stamped spoon fishing lure, Spoon Tracker**." Similarly, two of the spoon sets are identified by the wording "10 Years Still Spooning™. . . ." The wording "STILL SPOONING™ SETS" also appears on the left-hand side of the Applicant's web page under the heading "**Shop Sections**" alongside other product categories such as "Anniversary," "Engagement/Wedding," "Personalized Spoons," "Fishing Lures," and "Ready to Ship." None of these uses associate STILL SPOONING with Applicant's services. Similarly, STILL SPOONING appears in the phrase EST. 2011 AND STILL SPOONING in the banner

below the wording SPOON TRACKER, but its use as part of a tagline associated with the service mark SPOONTRACKER argues against its being perceived as a service mark.

Based on these specimens, we find that the term STILL SPOONING fails to function as a service mark because it would be perceived by the relevant public as merely referring to the inscription on Applicant's flatware sets and lures, rather than to Applicant's retail store or imprinting services. This finding is based, in part, on the commemorative nature of STILL SPOONING, defined *supra*, as it appears on the flatware and lures, which is likely to be perceived by consumers as a sentimental expression celebrating personal relationships.

Slogans and other terms, such as STILL SPOONING, that are considered to be merely informational in nature, or that express support, admiration or affiliation, are generally not registrable. *See In re Eagle Crest Inc.,* 96 USPQ2d 1227, 1232 (TTAB 2010) ("ONCE A MARINE, ALWAYS A MARINE is an old and familiar Marine expression, and as such it is the type of expression that should remain free for all to use."); *D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d 1710, 1716 (TTAB 2016) (I ♥ DC fails to function as a trademark because it would not be perceived as an indicator of the source of the goods on which it appears); *In re Melville Corp.*, 228 USPQ 970, 972 (TTAB 1986) (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."). *See also In re Compagnie Nationale Air France*, 265 F2d 938, 121 USPQ 460, 461 (CCPA 1959) (SKY-ROOM is not registrable

as service mark for air transportation of passengers since it is used to connote particular type of accommodation); *In re British Caledonian Airways Ltd.*, 218 USPQ 737 (TTAB 1983) (SKYLOUNGER identified a type of airplane seat not a service mark for air transportation services).

Applicant argues that STILL SPOONING nevertheless functions as a mark for its services because it is closely associated with the services:

> [T]he Mark is placed in proximity to the links for features in rendering those services, i.e. the cart option for purchasing goods from an online retailer. Furthermore, Applicant's Mark is placed in close proximity to the "Request Custom Order" button which is used by Applicant to receive and accept offers for custom orders, and to gather the necessary information from purchaser to render the Class 040 custom imprinting services."[23]

This argument is unavailing. STILL SPOONING, as used on Applicant's web sites, would be perceived as an informational or sentimental slogan on Applicant's flatware and lures, and not as a service mark. Although we have no doubt that Applicant is providing the identified services, STILL SPOONING does not appear to be a service mark for these services. Further, although Applicant may intend STILL SPOONING to be a service mark for its services, "'[m]ere intent that a term function as a trademark [or service mark] is not enough in and of itself . . . to make a term a trademark.'" *In re Manco Inc.*, 24 USPQ2d 1938, 1941 (TTAB 1992) (quoting *In re Remington Prods. Inc.*, 3 USPQ2d 1714, 1715 (TTAB 1987)) (THINK GREEN failed to function as a mark for, inter alia, mailing and shipping cardboard boxes); *In re*

[23] Applicant's Br, p. 15, 12 TTABVUE 16.

*Niagara Frontier Servs., Inc.*, 221 USPQ 284 (TTAB 1983) (WE MAKE IT, YOU BAKE IT! failed to function as a service for grocery store services).

Nor does Applicant's frequent use of the "TM" symbol support a finding that Applicant is using STILL SPOONING as a service mark. The use of the "TM" symbol cannot transform a non-trademark term into a trademark, much less a service mark. *In re Brass-Craft Mfg. Co.,* 49 USPQ 1849, 1853 (TTAB 1998); *In re Remington Prods. Inc.,* 3 UPSQ2d at 1715. Here, the use of the "TM" symbol does not negate the informational nature of STILL SPOONING, which is primarily used on Applicant's flatware and lures. Moreover, in the unlikely event that consumers are familiar with the technical difference between the "SM" and "TM" symbols, Applicant's use of "TM" suggests that STILL SPOONING is a trademark rather than a service mark. *See* TMEP Section 906.

Applicant's more recent web pages also support the finding that STILL SPOONING would be perceived by consumers as merely referring to the inscription on Applicant's spoon sets and lures. On one representative page, below, STILL SPOONING appears variously as: part of the "Still Spooning™ Collection," displayed on spoons in a heart-shaped floral design, a product category heading, part of product descriptions, and as part of the wording "Custom Still Spooning™." None of these uses constitutes service mark usage, rather, these spoons clearly display "spooning" used in the romantic, relationship sense (i.e., "Still Spooning After 25 Years").

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3/17/2015 Still Spooning™ Collection - Spoon Tracker


Est. 2011 and Still Spooning™

Home
About
Twitter
Instagram
Contact
Basket 0

Anniversary
Engagement and Wedding
Gold Flatware

**Still Spooning™**

Coffee Spoons
Runner/Athlete Spoons
Tea Spoons
Fishing Lures

**Still Spooning™**

**$28**
10 Years Still Spooning™ or Personalize

**$28**
40 Years - Spooning Since 1975

**$28**
1 or Personalize year - Anniversary Vintage Spoon Set

**$28**
Custom Still Spooning™

**$28**
5 or Personalize years - Still Spooning™ Set

**$28**
40 Years - Anniversary Spoon Set

**$28**
16th Anniversary - Since 1999

**$28**
Still Spooning™ Since Cu
Spoon Set

**$28**
Still Spooning™ Since 2004 - 11th anniversary

**$28**
6th Anniversary - Since 2009 Spoon Set

**$28**
15 years Still Spooning™

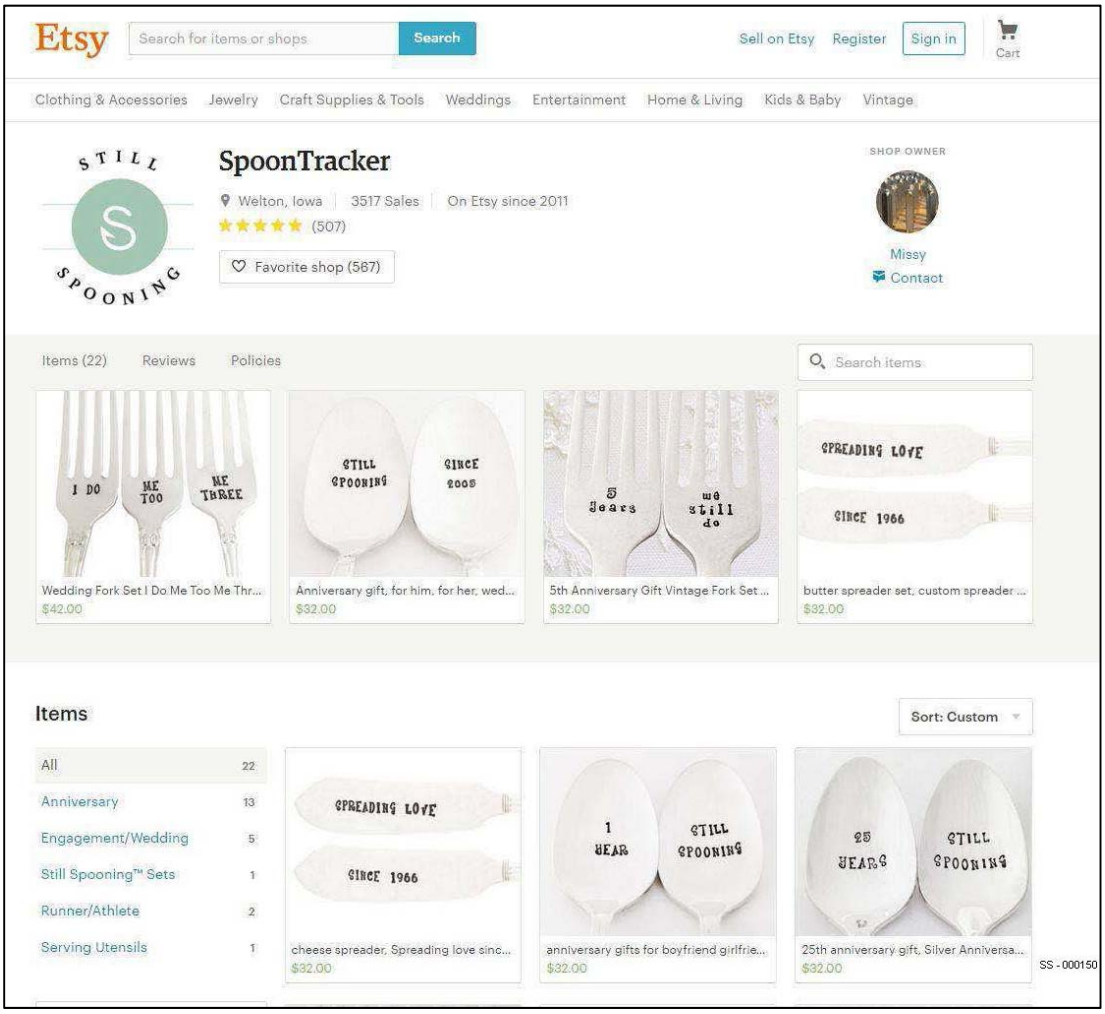
**$28**
5th Anniversary Spoon

http://www.spoontracker.com/collections/still-spooning-collection 1/2

[24]

[24] 7 TTABVUE 197.

On another representative page, STILL SPOONING appears in a revised logo to the left of "**SpoonTracker**" Given the likely consumer understanding of the term STILL SPOONING, the prevalence of STILL SPOONING on Applicant's flatware and lures elsewhere on the page, the prominence of SpoonTracker, and the lack of any connection with the identified services, as with the other web pages, STILL SPOONING likely would be perceived by the relevant public as merely referring to the inscription on Applicant's spoon sets and lures.



[25]

[25] 7 TTABVUE 207.

In summary, the manner in which STILL SPOONING is being used does not support a finding that potential consumers would perceive it as a service mark for the identified services. As used in the specimens of record and elsewhere in the record, STILL SPOONING does not convey the commercial impression of a mark identifying the source of origin of Applicant's services. Instead, STILL SPOONING likely would be perceived by the relevant public as merely referring to the romantic inscription on Applicant's flatware and lures, not Applicant's retail store or custom imprinting services. Accordingly, we find that STILL SPOONING does not function as a mark to identify and distinguish Applicant's services under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052, and 1127.

**Decision**: The Oppositions are sustained and registration of the mark is refused.