

**This Opinion is Not a  
Precedent of the TTAB**

Mailed: December 5, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*TaShae Watson v. Anthony Uzzo*

Opposition No. 91277679  
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Stephen Joncus of Joncus Law P.C. for TaShae Watson.

Vincent G. LoTempio of the Law Office of Vincent LoTempio for Anthony Uzzo.

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Before Greenbaum, Lynch and O'Connor,  
Administrative Trademark Judges.

Opinion by O'Connor, Administrative Trademark Judge:

Anthony Uzzo (“Applicant”) seeks registration on the Principal Register of the mark FIRST YEAR DOWN, in standard characters, for

Baby bodysuits; Bottoms as clothing; Children’s and infant’s apparel, namely, jumpers, overall sleepwear, pajamas, rompers and one-piece garments; Tops as clothing in International Class 25.<sup>1</sup>

TaShae Watson (“Opposer”) opposes registration of Applicant’s mark (1) under Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§ 1051-1052, 1127, asserting that FIRST YEAR DOWN fails to function as a trademark because it is merely

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<sup>1</sup> Application Ser. No. 90893276 was filed on Aug. 20, 2021 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s claim of first use of the mark in connection with the Class 25 goods anywhere and in commerce at least as early as August 2019.

informational matter or a common phrase or message ordinarily used in the online baby clothing industry and (2) fraud under *In re Bose Corp.*, 580 F.3d 1240 (Fed. Cir. 2009)<sup>2</sup> based on allegations that Applicant filed a deceptive specimen showing a baby bodysuit with a hang tag bearing the mark, but no words on the front of the garment, contrary to Applicant’s actual use in commerce.<sup>3</sup> Applicant filed an Answer denying Opposer’s salient allegations.<sup>4</sup>

## I. Record

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant’s involved application file. The record also includes the following materials submitted by the parties:

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<sup>2</sup> As part of an internal Board pilot program to broaden acceptable forms of legal citation in Board cases, citations in this opinion are in the form recommended in TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 101.03 (2024). This opinion cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals by the pages on which they appear in the Federal Reporter (*e.g.*, F.2d, F.3d or F.4th). For opinions of the Board, this opinion uses citations to the Lexis legal database and cites only precedential decisions, including in the citation, where available, the application serial number or proceeding number. Practitioners should also adhere to the practice set forth in TBMP § 101.03.

<sup>3</sup> Notice of Opposition, 1 TTABVUE; Amended Notice of Opposition, 9 TTABVUE. On Applicant’s motion to dismiss, the Board found that Opposer sufficiently pled the grounds of failure to function as a trademark and fraud. 14 TTABVUE 9-12.

Opposer also pled that the mark “is generic [and] descriptive.” 9 TTABVUE 6 ¶ 12. As explained below, Opposer waived these arguments by not including them in her main brief.

<sup>4</sup> Applicant’s “affirmative defenses,” 15 TTABVUE 4, are either not proper affirmative defenses or were not pursued at trial and therefore are waived. *See, e.g., Made in Nature, LLC v. Pharmavite LLC*, Opp. No. 91223352, 2022 TTAB LEXIS 251, at \*3-4 (TTAB 2022) (cleaned up) (rejecting attempt to reserve right to add defenses); *U.S. Olympic Comm. v. Tempting Brands Netherlands B.V.*, Opp. No. 91233138, 2021 TTAB LEXIS 45, at \*4-5 n.5 (TTAB 2021) (failure to state a claim is not an affirmative defense); *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, Opp. No. 91153147, 2014 TTAB LEXIS 284, at \*5 (TTAB 2014) (affirmative defenses not pursued through motion or briefing were waived).

- Opposer’s Testimony Declarations, with exhibits, of Opposer TaShae Watson, online sellers Irma Johnson and Nicole Limpert, two friends of Opposer who purchased goods from Applicant, Brittany White and Tracy Hardrick Ellis, and Opposer’s counsel, Stephen Joncus.<sup>5</sup>
- Applicant’s Testimony Declarations, with exhibits, of Applicant Anthony Uzzo, Applicant’s wife, Kristy Uzzo, and Applicant’s daughter, Angelina Sohmers.<sup>6</sup>

## II. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action, formerly referred to as “standing” by the Federal Circuit and the Board, must be established by the plaintiff in every inter partes case. *See Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 1303 (Fed. Cir. 2020); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 1373-74 (Fed. Cir. 2020). To establish entitlement to bring a statutory cause of action, a plaintiff must demonstrate: (i) an interest falling within the zone of interests protected by the statute and (ii) a reasonable belief in damage proximately caused by registration of the mark. *See Corcamore*, 978 F.3d at 1303 (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 129-33 (2014)).

Section 13 of the Trademark Act provides that “[a]ny person who believes that he would be damaged by the registration of a mark upon the principal register” may file an opposition. 15 U.S.C. § 1063(a). Opposer contends that she would be damaged by registration of Applicant’s mark because she sells baby clothes bearing the slogan

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<sup>5</sup> 16 TTABVUE - 21 TTABVUE. Opposer’s Amended Notice of Opposition included at least one link and an image that Opposer did not submit during her testimony period. *E.g.*, 9 TTABVUE 3 (footnote 2; Figure 1). These items were not made of record during the trial period through a Notice of Reliance or testimony, and therefore we do not consider them. *See* Trademark Rule 2.122(c), 37 C.F.R. § 2.122(c); *TVAzteca, S.A.B. de C.V. v. Martin*, Canc. No. 92068042, 2018 TTAB LEXIS 417, at \*11 n.15 (TTAB 2018) (“The Board does not accept Internet links as a substitute for submission of a copy of the resulting page.”).

<sup>6</sup> 22 TTABVUE.

FIRST YEAR DOWN on the Etsy website and, if the mark is registered, Applicant could demand that she stop selling such goods.<sup>7</sup> Opposer testified that Applicant sent cease and desist letters to Opposer and others, asserting his trademark registration for another slogan, ½ WAY TO FIRST, causing Opposer to stop using that slogan and lose sales.<sup>8</sup> Opposer further testified that she believes Applicant is attempting to do the same with FIRST YEAR DOWN.<sup>9</sup> This testimony establishes that Applicant has an interest falling within the zone of interests protected by the statute, i.e., an interest in using the term FIRST YEAR DOWN in her business, and a reasonable belief that she would suffer harm proximately caused by registration of Applicant's mark. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945 (Fed. Cir. 2000) (“A belief in likely damage can be shown by establishing a direct commercial interest.”); *Books on Tape, Inc. v. Booktape Corp.*, 836 F.2d 519, 520 (Fed. Cir. 1987) (competitor clearly has interest “beyond that of the public in general” in seeking cancellation); *see also DowntownDC Bus. Improvement Dist. v. Clarke*, Opp. No. 91275100, 2024 TTAB LEXIS 412, at \*36 (TTAB 2024) (testimony that it used the mark established “Opposer’s real interest and reasonable belief in damage”). Applicant does not dispute Opposer’s entitlement to bring a statutory cause of action.

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<sup>7</sup> Amended Notice of Opposition, 9 TTABVUE 2, 6 ¶ 10; Watson Decl., 16 TTABVUE 2 ¶ 2, 4 ¶¶ 15-18.

<sup>8</sup> Watson Decl., 16 TTABVUE 4 ¶¶ 15-16.

<sup>9</sup> *Id.*, 16 TTABVUE 4 ¶ 18.

### III. Failure to Function

Opposer contends that the applied-for mark fails to function as a trademark because the words “First Year Down” are nothing more than a cute slogan, coupling the football term “first down” with “first year,” appealing to parents seeking clothing to celebrate their baby’s first birthday.<sup>10</sup> According to Opposer, “First Year Down” is merely a common phrase or message used by many online sellers on goods intended to celebrate first birthdays, and not an indicator of source.<sup>11</sup>

“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.” *In re Standard Oil Co.*, 275 F.2d 945, 947 (CCPA 1960). A “trademark” is defined as “any word, name, symbol, or device or any combination thereof [used] ... to identify and distinguish [a person’s] goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.” Trademark Act § 45, 15 U.S.C. § 1127.

Thus, it is a threshold requirement of registrability under the Trademark Act that the mark “identify and distinguish” the goods of the applicant from those of others, and “indicate the source” of those goods. *In re Go & Assocs., LLC*, 90 F.4th 1354, 1356 (Fed. Cir. 2024) (citing *Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140 (2023) and *Abitron Austria GmbH v. Hetronic Int’l, Inc.*, 600 U.S. 412, 429 (2023))

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<sup>10</sup> Opposer’s Brief, 23 TTABVUE 7-8.

<sup>11</sup> *Id.*

(Jackson, J., concurring) (“It is clear beyond cavil that what makes a trademark a trademark under the Lanham Act is its source-identifying function.”)).

“[N]ot every designation adopted with the intention that it perform a trademark function necessarily accomplishes that purpose.” *D.C. One Wholesaler, Inc. v. Chien*, Opp. No. 91199035, Canc. No. 92053919, 2016 TTAB LEXIS 508, at \*8 (TTAB 2016) (citing *In re Eagle Crest Inc.*, Ser. No. 77114518, 2010 TTAB LEXIS 346 (TTAB 2010)). “Slogans and other terms 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*, 2010 TTAB LEXIS 346, at \*6-7. Similarly, “[m]atter that is widely used to convey ordinary or familiar concepts or sentiments, or social, political, religious, or similar informational messages that are in common use, would not be perceived as indicating source and is not registrable as a mark.” *In re Team Jesus LLC*, Ser. No. 88105154, 2020 TTAB LEXIS 503, at \*7 (TTAB 2020); see *In re Vox Populi Registry Ltd.*, 25 F.4th 1348, 1351 (Fed. Cir. 2022) (“The Board has determined that certain categories of [proposed marks] fail to function as a source identifier, such as matter that ‘merely convey[s] general information about the goods or services or an informational message.’”) (quoting TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1202.04) (July 2021)).

In analyzing whether the phrase functions as a source indicator, we consider how FIRST YEAR DOWN is used in the marketplace and how it is perceived by consumers. *In re Go & Assocs.*, 90 F.4th at 1356 (citing *In re Vox Populi*, 25 F.4th at

1351); *Univ. of Kentucky v. 40-0, LLC*, Opp. No. 91224310, 2021 TTAB LEXIS 68, at \*32 (TTAB 2021) (“The critical inquiry in determining whether a proposed mark functions as a trademark is how the relevant public perceives the term sought to be registered.”) (citation omitted). “[E]vidence of the public’s perception may be obtained from any competent source, such as consumer surveys, dictionaries, newspapers and other publications.” *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 969 (Fed. Cir. 2015) (cleaned up). Internet evidence can be relevant to show consumer perception. *See In re Bayer AG*, 488 F.3d 960, 966 (Fed. Cir. 2007). Because there are no limitations on the channels of trade or classes of consumers of the goods identified in the Application, the relevant consuming public comprises all potential purchasers of “baby bodysuits; bottoms as clothing; children’s and infant’s apparel, namely, jumpers, overall sleepwear, pajamas, rompers and one-piece garments; tops as clothing.” *See In re Mayweather Promotions, LLC*, Ser. No. 86753084, 2020 TTAB LEXIS 467, at \*7 (TTAB 2020). “The more commonly a phrase is used, the less likely that the public will use it to identify only one source and the less likely that it will be recognized by purchasers as a trademark.” *In re Eagle Crest*, 2010 TTAB LEXIS 346, at \*7.

The record includes evidence of Applicant’s use, Opposer’s use, and use by third parties in the online marketplace. Applicant testified that First Year Down is a line of clothing branded by his family business, Little Sweetees, LLC, which first used Applicant’s mark in August 2019.<sup>12</sup> According to Applicant’s testimony,

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<sup>12</sup> A. Uzzo Decl., 22 TTABVUE 2 ¶¶ 3-4.

5. The trademark “First Year Down” is currently used and was used at the time the Application was filed as a source identifier. I am endeavoring to expand my brand beyond online retail sales and become a supplier of baby and toddler clothes to other retailers.

6. At the time I began selling my “First Year Down” line of clothing in the summer of 2019, there were no other sellers using the trademark “First Year Down,” except perhaps one off sales here and there. It was only after my shirts became extremely successful in the spring of 2020 and were awarded Best Seller badges by Etsy that other sellers began to copy my “First Year Down” mark.

7. Initially, we sold blank football shirts with striped sleeves made in nine colors and five sizes without any ornamental use using the “First Year Down” mark. This item was a top seller. A screenshot of this product as it appeared on our Etsy Page since about September 8, 2021 and currently appears on our Etsy Page is attached hereto in Exhibit A [excerpted below for ease of reference].

The screenshot shows an Etsy product listing for a 'First Year Down' football cake smash outfit. The listing includes a title, price, description, seller information, shipping details, and a size chart. The main image shows a young child wearing the outfit, which consists of a blue short-sleeved shirt with white stripes on the sleeves, blue shorts, and brown football-style leg warmers with white laces. The size chart is as follows:

Age	Height (IN)	Weight (LBS)
NEWBORN	16-21	5-9
6 MONTHS	22-24	10-16
12 MONTHS	25-28	17-20
18 MONTHS	29-31	21-24
24 MONTHS	32-34	25-27

The listing also features a 'Size Chart' section with arrows indicating the fit, a 'Ships from New York' location, and a 'Personalization' section with a text input field for customization. The price is listed as \$27.00+.



8. As a beta test, I used the mark ornamentally on the shirts to test if the mark was catchy. The mark took off and I've been using it as a brand ever since.<sup>13</sup>

After clearance-searching but not finding a trademark registration for FIRST YEAR DOWN, along with general Internet searching that “did not find the mark being used,” Applicant “took a number of actions to protect the mark,” including buying the domain name <www.firstyeardown.com> in January 2021 and creating a Facebook page that forwarded to the domain.<sup>14</sup> As for use of the phrase on the goods, he testified that:

15. A tagging gun was used to create tags to brand my trademark “First Year Down.”

16. At the time of our application for trademark registration, and from about January 2021, the words “Little Sweetees” were sewn in the cloth tag on the back of the collar and the sewn tag was used on the collar in conjunction with a hang tag bearing the mark “First Year Down” as shown on **Exhibit B**.

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<sup>13</sup> *Id.* at 3 ¶¶ 5-8. *See also* K. Uzzo Decl., 22 TTABVUE 25-26 ¶¶ 5-6; A. Sohmers Decl. 22 TTABVUE 28 ¶¶ 5-8.

<sup>14</sup> A. Uzzo Decl., 22 TTABVUE 4 ¶¶ 10, 12-14 (attaching receipt for purchase of domain name but not including screenshots of the website or Facebook page).

Exhibit B



According to Angelina Sohmers, Applicant’s daughter, who worked for the business at the time:

9. From about January 2021, I along with my parents, packaged shirts both with and without ornamental use using the company name “Little Sweetees” sewn in the cloth tag on the back of the collar and used a tagging gun to affix the hang tag bearing the “First Year Down” mark to the shirts. We shipped that merchandise as shown on Exhibit B to my father’s Declaration.<sup>16</sup>

Applicant’s use of the mark also includes “First Year Down by Little Sweetees” printed on stickers placed on packaging and on labels sewn in the back collar of the garments; examples are seen below.

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<sup>15</sup> *Id.*, 22 TTABVUE 4 ¶¶ 15-16. This is the photo depicted in Applicant’s specimen. *Id.* ¶ 10, Aug. 20, 2021 Specimen of Use, TSDR (the “Specimen”).

<sup>16</sup> A. Sohmers Decl., 22 TTABVUE 28 ¶ 9.



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According to Applicant, Opposer and several of the online sellers identified in her Declaration only began selling baby shirts with the slogan FIRST YEAR DOWN after he applied to register the trademark and Etsy labelled his listing with the “best seller” badge.<sup>18</sup> Applicant believes Opposer and these other sellers have infringed his trademark rights.<sup>19</sup>

In support of her argument that FIRST YEAR DOWN is a widely-used, common message in the baby clothes industry, Opposer submitted evidence that both she and other online sellers offer baby clothing or other goods with the slogan FIRST YEAR DOWN or 1<sup>st</sup> Year Down. This evidence consists of the declaration of Opposer, the declarations of Irma Johnson and Nicole Limpert, two other online sellers of children’s clothing, screenshots of the Etsy pages or products of those witnesses, and screenshots of other third-party Etsy pages and an Amazon.com page.

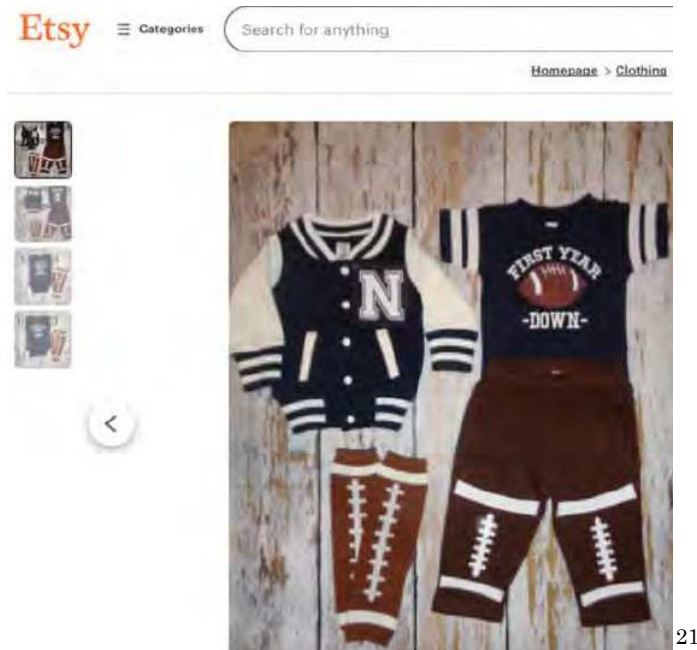
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<sup>17</sup> A. Uzzo Decl., 22 TTABVUE 4-5 ¶¶ 17-18, Exhibits D, F.

<sup>18</sup> A. Uzzo Decl., 22 TTABVUE 5-6 ¶¶ 20-24.

<sup>19</sup> *Id.*, 22 TTABVUE 5 ¶ 22.

Opposer testified that the “words FIRST YEAR DOWN are widely used on children’s clothing by many online sellers to celebrate a baby’s first birthday. I first used FIRST YEAR DOWN for that very reason—it is a cute slogan that many customers want for celebrating their child’s first birthday.”<sup>20</sup> Below is a screenshot of Opposer’s Etsy page where she sells the item in question.



Opposer’s two witnesses provided similar testimony. Irma Johnson (of Creative Prints of Joy LLC), an online seller of children’s clothing for about 18 years, began selling baby clothing bearing the phrase FIRST YEAR DOWN in 2018.<sup>22</sup> At that time, Ms. Johnson “had been aware of others using the slogan for a long time” and “had seen the slogan FIRST YEAR DOWN used on decorations for first-year birthday

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<sup>20</sup> Watson Decl., 16 TTABVUE 2 ¶ 3.

<sup>21</sup> *Id.*, 16 TTABVUE 2 ¶ 2, Exhibit 1.

<sup>22</sup> Johnson Decl., 17 TTABVUE 2 ¶¶ 2, 4.

parties such as posters and banners.”<sup>23</sup> She sold baby bodysuits and t-shirts bearing those words on the Amazon and eBay platforms, as seen below:



Ms. Johnson testified that this is her best-selling product, and it would be “devastating” to her business if she could not sell it.<sup>25</sup> According to Ms. Johnson, “[e]ven Amazon puts the slogan FIRST YEAR DOWN on its own brand of clothing.”<sup>26</sup>

Online seller Nicole Limpert testified that she sold clothing bearing the slogan FIRST YEAR DOWN for about 2 years.<sup>27</sup> Ms. Limpert came up with the design “by looking up popular 1<sup>st</sup> birthday themes through a Google search. I found examples of clothing and other articles using the FIRST YEAR DOWN theme being offered for sale by many sellers on Amazon and Etsy.”<sup>28</sup> At the time she adopted the phrase, Ms. Limpert had seen “FIRST YEAR DOWN used on decorations for first-year birthday

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<sup>23</sup> *Id.*, 17 TTABVUE 2 ¶ 4.

<sup>24</sup> *Id.*, 17 TTABVUE 3 ¶ 5, Exhibit 12.

<sup>25</sup> *Id.*, 17 TTABVUE 3 ¶ 8.

<sup>26</sup> *Id.*, 17 TTABVUE 3 ¶ 11, Exhibit 15.

<sup>27</sup> Limpert Decl., 18 TTABVUE 2 ¶¶ 2-3.

<sup>28</sup> *Id.*, 18 TTABVUE 2 ¶ 4.

parties such as posters and banners, as well as on baby clothing.”<sup>29</sup> Below is an example of Ms. Limpert’s baby bodysuit, which was one of her most viewed products:



The record evidence thus establishes that each of Applicant, Opposer, Ms. Johnson and Ms. Limpert has, at some time in the past five years, sold via online marketplaces, baby bodysuits or shirts bearing the phrase FIRST YEAR DOWN in a prominent, ornamental display on the front of the garment.<sup>31</sup> Opposer submitted evidence of 11 additional online sellers of items bearing the phrase FIRST YEAR DOWN or 1<sup>st</sup> Year Down, namely, screenshots from six Etsy pages and one

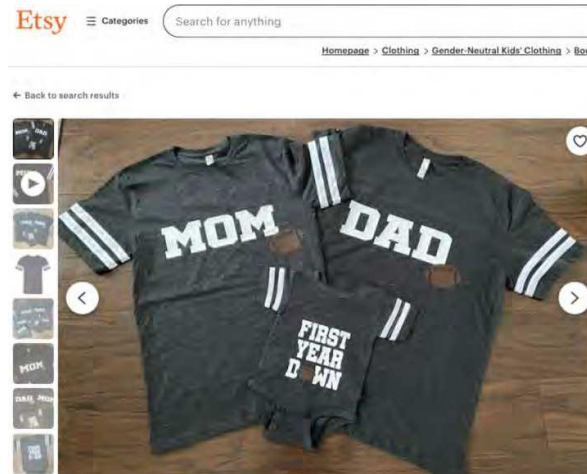
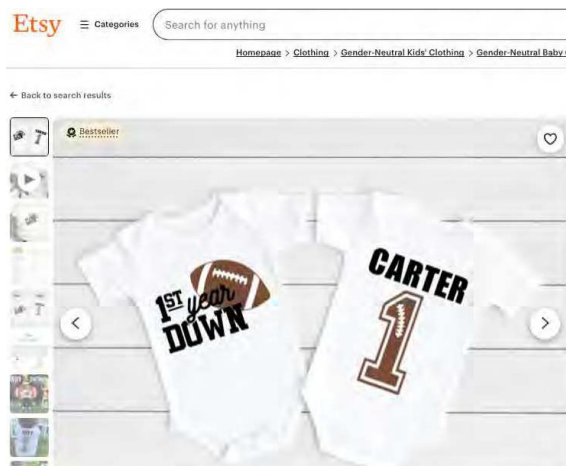
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<sup>29</sup> *Id.*, 18 TTABVUE 3 ¶ 5.

<sup>30</sup> *Id.*, 18 TTABVUE 3 ¶¶ 6-7, Exhibit 16.

<sup>31</sup> Ms. Limpert does not provide dates of sale. She testified in her December 2023 Declaration that she had been an online seller of children’s clothing for almost four years, and of the items at issue for about 2 years. 18 TTABVUE 2 ¶¶ 2-3. Ms. Johnson testified that she started selling the product in question in 2018, and provided records showing sales on Amazon.com from March and July 2019. Johnson Decl., 17 TTABVUE 2-3 ¶¶ 4, 6-7, Exhibits 13 and 14.

Amazon.com page offering baby bodysuits or shirts<sup>32</sup> and four Etsy pages offering birthday banners, invitations or similar items.<sup>33</sup> Examples are shown below.



<sup>32</sup> Watson Decl., 16 TTABVUE 2-3 ¶¶ 2, 4-9 and Exhibits 1-7; Johnson Decl., 17 TTABVUE 3 ¶ 11, Exhibit 15. Although the declarants did not provide dates of capture, the screenshots are otherwise authenticated by their testimony and we consider the screenshots for what is shown on the face of the materials. See *Icon Health & Fitness, Inc. v. Eifit LLC*, Opp. No. 91264393, 2022 TTAB LEXIS 119, \*18 (TTAB 2022) (lack of URL or date not valid basis to strike testimony exhibit if authentication is otherwise established); *Shenzhen IVPS Tech. Co. v. Fancy Pants Prods., LLC*, Opp. No. 91263919, 2022 TTAB LEXIS 383, at \*28-29 n.26 (TTAB 2022) (absent objection, Board considered website exhibits to testimony declaration for what they show on their face, where URL was provided, but not access date).

<sup>33</sup> Watson Decl., 16 TTABVUE 3 ¶¶ 10-14 and Exhibits 8-11.

<sup>34</sup> Screenshot from Etsy.com page of SKKDesignBaby, 16 TTABVUE 2 ¶ 4, Exhibit 2.

<sup>35</sup> Screenshot from Etsy.com page of TinyLoves Co, 16 TTABVUE 3 ¶ 6, Exhibit 4.



Apart from general statements about the success of their products bearing FIRST YEAR DOWN, none of the witnesses testified about their sales volume, number of user views, customers or the like. Without such information, we have little, if any, evidence of the extent to which consumers in the marketplace encounter the phrase FIRST YEAR DOWN used as ornamentation on the front of baby clothing. It is possible to glean a sense of exposure to certain of the product listings through the number of consumer ratings or reviews shown on the face of the screenshots.<sup>38</sup> The screenshots of record show between 2 (Amazon.com listing) and 302 (SKKDesignBaby listing) reviews for the shirts bearing FIRST YEAR DOWN or 1<sup>st</sup> YEAR DOWN. Some of the Etsy shops had overall total reviews in the thousands, but we have no way of knowing how many consumers have been exposed to the products in question here.

<sup>36</sup> Screenshot from Etsy.com page of themommybarn, 16 TTABVUE 3 ¶ 12, Exhibit 9.

<sup>37</sup> Screenshot from Etsy.com page of HighPeaksStudios, 16 TTABVUE 3 ¶ 14, Exhibit 11.

<sup>38</sup> See, e.g., Watson Decl., 16 TTABVUE Exhibits 1-11 (Etsy listings); Johnson Decl. 17 TTABVUE Exhibit 15 (Amazon listing).



Opposer argues that consumers only purchase the goods because of the message conveyed by the slogan printed on the front of garments, citing reviews on Applicant's Esty page.<sup>39</sup> But it is not disputed that the phrase holds appeal to consumers; Applicant and his wife testified as much.<sup>40</sup> However, this limited sampling of customer reviews from Applicant's own website does not answer the critical question of whether consumers perceive the applied-for mark as identifying and distinguishing Applicant's goods from those of others and indicating Applicant as the source of the goods.

Nor does the screenshot from Amazon.com show that "'First year down' is such a popular slogan to celebrate first birthdays that the largest retailer in the world, Amazon.com, has jumped on the bandwagon to sell its own baby clothing merchandise."<sup>41</sup> Although bearing the heading "Amazon Fashion" in the upper left corner, embedded between the price and size options are the words "amazon merch on demand," with a "learn more" button.<sup>42</sup> Without information about the nature of this service, we are left to guess whether the product is Amazon-branded or printed on demand by a third-party seller. In any case, the screenshot reflects only two ratings for the item listed on Amazon.com.

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<sup>39</sup> Opposer's Reply, 25 TTABVUE 3-4 (citing 21 TTABVUE 4) (reviews posted include "Was perfect for my son's party.;" "This is exactly what we wanted for our first birthday!"; "I can't wait for my Littles to wear this on their birthday.")). We consider these reviews to the extent they show some consumers' stated perceptions. *See WeaponX Performance Prods. v. Weapon X Motorsports, Inc.*, Opp. No. 91221553, 2018 TTAB LEXIS 72, \*23 (TTAB 2018).

<sup>40</sup> *E.g.*, A. Uzzo Decl., 22 TTABVUE 3 ¶ 8.

<sup>41</sup> Opposer's Brief, 23 TTABVUE 8.

<sup>42</sup> Johnson Decl., 17 TTABVUE Exhibit 15.

In addition to this evidence, each of Opposer's witnesses testified that there are many other online sellers of goods bearing the phrase FIRST YEAR DOWN.<sup>43</sup> Each of these witnesses has some knowledge of the online marketplace for children's clothing by virtue of selling goods there, and Ms. Johnson testified that she often searches for competitive products.<sup>44</sup> Without details about these other sellers or any information about the nature of their use, this testimony is of limited value.

Finally, Opposer and the two sellers each testified that "FIRST YEAR DOWN is merely a cute slogan announcing the milestone of a baby's first birthday."<sup>45</sup> To the extent this testimony reflects how the phrase is viewed from the perspective of these three sellers, we consider it for whatever probative value it may have. However, this testimony is not direct evidence of how consumers view the phrase, and we are mindful that these witnesses have an interest in the outcome of this proceeding. In any case, we "will not substitute the opinion of a witness ... for our evaluation of the facts." *Edwards Lifesciences Corp. v. VigiLanz Corp.*, Opp. No. 91154210, 2010 TTAB LEXIS 84, at \*3 (TTAB 2010).

Viewed as a whole, Opposer presented evidence of fifteen online sellers of goods using FIRST YEAR DOWN, or the nearly identical 1<sup>st</sup> Year Down, ornamentally on baby bodysuits, shirts, banners and invitations promoted for use to celebrate a baby's

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<sup>43</sup> Watson Decl., 16 TTABVUE 2 ¶ 3 (phrase is "widely used ... by many online sellers"); Johnson Decl., 17 TTABVUE 2-3 ¶¶ 4, 9-10 (describing use by "many people" and "many other stores"); Limpert Decl. 18 TTABVUE 3 ¶¶ 5, 8 ("[o]n information and belief, other sellers" are using phrase as a message of celebration for baby's first birthday).

<sup>44</sup> Johnson Decl., 17 TTABVUE 3 ¶ 10.

<sup>45</sup> *Id.*, 17 TTABVUE 2 ¶ 4; Limpert Decl., 18 TTABVUE 3 ¶ 5.

first birthday. Applicant concedes that the phrase has been used ornamentally, but argues that this does not prevent the words from functioning as a trademark, particularly when he has used the mark consistently in other ways, such as on hang tags, collar labels and his Etsy page.<sup>46</sup>

As plaintiff, Opposer bears the burden of proving, by a preponderance of the evidence, that Applicant “does not have the right to register [his] mark.” *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 973 (Fed. Cir. 2018) (citation omitted). “The totality of the evidence must be sufficient to show that the phrase sought to be registered is used in such a way that it cannot be attributed to a single source of the goods or services at issue.” *In re Black Card LLC*, Ser. No. 90641690, 2023 TTAB LEXIS 478, at \*10, 26 (TTAB 2023) (reversing refusal to register FOLLOW THE LEADER for use in connection with credit card incentive program and travel services); see *In re DePorter*, Ser. No. 87229711, 2019 TTAB LEXIS 7, at \*16 (TTAB 2019) (affirming refusal where evidence showed “that upon encountering Applicant’s ‘mark,’ prospective purchasers familiar with such widespread non-trademark use are unlikely to consider it to indicate the source of Applicant’s goods”).

Here, although Opposer’s evidence shows some use of the phrase as an ornamental slogan on baby clothing other than Applicant’s and on first birthday banners and invitations, this evidence is insufficient to establish that the phrase FIRST YEAR DOWN is of such a nature, or its use so widespread, that consumers would not view it as indicating the source of Applicant’s goods. *Cf. City of London Distillery, Ltd. v.*

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<sup>46</sup> A. Uzzo Decl., 22 TTABVUE 5 ¶ 21; Applicant’s Brief, 24 TTABVUE 10-11.

*Hayman Grp., Ltd.*, Opp. No. 91235280, 2020 TTAB LEXIS 501, at \*37-38 (TTAB 2020) (although phrase CITY OF LONDON was primarily geographically descriptive, “we do not view the record here as showing that the phrase is **so** ... commonly used in connection with gin that it is incapable of being perceived, in the eyes of the gin-consuming public, as a source identifier”) (emphasis in original); *D.C. One Wholesaler*, 2016 TTAB LEXIS 536, at \*23 (“Because the nature of the phrase will be perceived as informational, and also because the ubiquity of the phrase I ♥ DC on apparel and other souvenirs of many makers has given it a significance as an expression of enthusiasm, it does not create the commercial impression of a source indicator, even when displayed on a hang tag or label.”).

As for the nature of FIRST YEAR DOWN, Applicant argues, persuasively, that the words themselves are only suggestive of the baby bodysuits and clothing items identified in the Application.<sup>47</sup> The words are not informational about the identified goods, but hint at a possible use for them. As detailed above, the evidence does reflect some ornamental use of the phrase on goods promoted to consumers planning to

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<sup>47</sup> Applicant’s Brief, 24 TTABVUE 7. Opposer’s arguments in her main brief are not to the contrary. 23 TTABVUE 9 (noting “playful combination” of football term “first down” and celebration of a “first year” birthday).

We do not consider Opposer’s argument, made for the first time in her Reply, that the applied-for mark “is merely descriptive and unregistrable.” 25 TTABVUE 4-5; 23 TTABVUE 13 (Opposer’s main brief expressly did not argue that applied-for mark was merely descriptive, stating “[m]erely descriptive matter and **(as here) commonly used expressive phrases and matter** are not accorded trademark registrations as a matter of public interest and to protect competition”). See, e.g., *Major League Baseball Players Ass’n v. Chisena*, Opp. No. 91240180, 2023 TTAB LEXIS 117, at \*72-73 (TTAB 2023) (argument under the thirteenth *DuPont* factor, raised by opposers for first time in reply brief, not considered as such), appeal docketed, No. 23-2073 (Fed. Cir. June 26, 2023).

celebrate a child's first birthday. However, this record does not indicate an inability of FIRST YEAR DOWN to signify the source of a line of clothing for toddlers.

Opposer argues that merely being the first to adopt a phrase or intending to use it as a trademark is not determinative of whether consumers are likely to perceive it as an indicator of source.<sup>48</sup> We agree. *See, e.g., In re Vox Populi*, 25 F.4th at 1352-53. However, unlike cases where the Board found a phrase was so commonly used that it would not be considered a source indicator, the evidence of third party use here is relatively weak and scant in comparison. Opposer has presented no dictionary definitions, news articles, or social commentary evidencing that the phrase has found its way into the American English vernacular or popular culture, even that of families with young children. Rather, Opposer's evidence consists of a limited quantity of products sold on online marketplaces. Although online marketplaces offering goods of third-party sellers can provide relevant evidence of consumer perception, in this case, the relatively small number of uses with an unknown magnitude of sales is insufficient to meet Opposer's burden of proof, particularly in the absence of other evidence showing use of the phrase. *Cf. In re Go.*, 90 F.4th at 1357 (affirming refusal to register EVERYBODY VS RACISM where dozens of third-party uses, including on clothing and in media such as opinion pieces, music and podcasts, showed that consumers would perceive phrase as an informational statement against racism and not as a trademark); *Univ. of Kentucky*, 2021 TTAB LEXIS 68, at \*39-41 (sustaining opposition to registration of 40-0 where evidence showed use by three nationally-

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<sup>48</sup> Opposer's Brief, 23 TTABVUE 12.

known college basketball programs to refer to a perfect NCAA basketball season and extensive media coverage surrounding the same).

The other cases cited by Opposer are not to the contrary.<sup>49</sup> For example, in *In re Vox Populi*, 25 F.4th at 1352, the Federal Circuit affirmed a refusal to register .SUCKS where the applicant's website, online articles and third party use showed that consumers would perceive it as referring to a type of domain name and not as a source identifier for domain name registry services. *See also D.C. One Wholesaler*, 2016 TTAB LEXIS 508, at \*20-21 (I ♥ DC failed to function as trademark where marketplace was "awash" in goods using phrase ornamentally); *In re Eagle Crest*, 2010 TTAB LEXIS 346, at \*7-10, 14 (evidence including nearly 3 million hits in a Google search showed that phrase ONCE A MARINE, ALWAYS A MARINE is "a motto associated with and used by and about Marines" and would not be perceived as a trademark to identify and distinguish applicant's goods from those of others).<sup>50</sup>

We find that, on this record, Opposer has failed to show that use of the mark ornamentally on baby clothing and first birthday items is so widespread that consumers would perceive the phrase merely as a commonly-used message and not as a means of identifying and distinguishing Applicant's goods and indicating their source.

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<sup>49</sup> Opposer's Brief, 23 TTABVUE 7, 11.

<sup>50</sup> We are not unsympathetic to Opposer's and Declarants' statements that they should be free to use the phrase "First Year Down" or "1<sup>st</sup> Year Down" as an ornamental feature on clothing. *E.g.*, Opposer's Brief, 23 TTABVUE 13-14. Yet cases such as *In re Eagle Crest*, in which there was no dispute that ONCE A MARINE, ALWAYS A MARINE "is an old and familiar Marine expression ... that should remain free for all to use," are a far cry from this case. *In re Eagle Crest*, 2010 TTAB LEXIS 346, at \*8-9. We express no opinion on the ability to use such phrases ornamentally, and not as source indicators, even if Applicant's mark is registered.

#### IV. Fraud

“Fraud in procuring a trademark registration occurs when an applicant for registration knowingly makes a false, material representation of fact in connection with an application to register with the intent of obtaining a registration to which it is otherwise not entitled.” *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, Opp. No. 91190827, 2017 TTAB LEXIS 6, at \*89 (TTAB 2017) (citing *In re Bose Corp.*, 580 F.3d 1240, 1245 (Fed. Cir. 2009)). A party alleging fraud bears the heavy burden of proving fraud by clear and convincing evidence. *Id.* “There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party.” *In re Bose*, 580 F.3d at 1243 (quoting *Smith Int’l, Inc. v. Olin Corp.*, 1981 TTAB LEXIS 47, at \*27 (TTAB 1981)).

Opposer claims that Applicant’s Specimen misrepresented Applicant’s actual use of the mark because the Specimen (1) did not show FIRST YEAR DOWN printed ornamentally on the front of the garment, despite this being the “fundamental characteristic” of Applicant’s goods, and (2) bore a hang tag that did not exist in the actual product as shipped to purchasers.<sup>51</sup>

As to the first point, Opposer contends that because Applicant promotes his product as a “Football 1<sup>st</sup> Birthday Jersey” designed to “[c]elebrate your little football cuties’ first birthday with our adorable outfit that’s sure to be a touchdown,” the ornamental display of FIRST YEAR DOWN is the “essence” of the product and the

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<sup>51</sup> Opposer’s Brief, 23 TTABVUE 15-16.

Specimen must have been false because it did not show this ornamentation.<sup>52</sup> Opposer quotes testimony that once Applicant put the slogan on the front of the garment, “the product ‘took off’ and they have been using ‘first year down’ ornamentally ever since.”<sup>53</sup> Yet, Opposer overreaches when it concludes that “[i]n other words, they were not using the alleged mark until they started testing it ornamentally, and when they did, sales took off.”<sup>54</sup> This is directly contradicted by testimony of Applicant and his two witnesses that they initially sold blank football shirts with striped sleeves “without any ornamental use” of the mark; Applicant’s daughter, Ms. Sohmers, also specifically testified that they continued to sell both blank bodysuits and those with ornamental use.<sup>55</sup>

As to the second point, Opposer submitted declarations of two friends who purchased bodysuits from Applicant’s Etsy site that did not have a hang tag or any other tag or label bearing the phrase “FIRST YEAR DOWN.”<sup>56</sup> Images of the products received by these witnesses are shown below:

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<sup>52</sup> *Id.*, 23 TTABVUE 15.

<sup>53</sup> *Id.*

<sup>54</sup> *Id.*

<sup>55</sup> A. Uzzo Decl., 22 TTABVUE 3 ¶ 7; K. Uzzo Decl., 22 TTABVUE 25 ¶ 5; A. Sohmers Decl., 22 TTABVUE 28 ¶¶ 5, 9.

<sup>56</sup> White Decl., 19 TTABVUE; Ellis Decl., 20 TTABVUE. The witnesses do not state when they purchased the items; Ms. White received the product in August 2022, and Ms. Ellis received the product on an unknown date and opened it on December 28, 2023, the date of her declaration. White Decl., 19 TTABVUE 3 ¶¶ 5-8; Ellis Decl., 20 TTABVUE 3 ¶¶ 4-6.





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<sup>57</sup> White Decl., 19 TTABVue 3 ¶¶ 5-9, Exhibits 18-19.





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According to Opposer, this is part of a pattern by Applicant of applying to register popular baby slogans, in which he “slipped” the applications past the examining attorney by submitting fake specimens showing garments without the slogan on the front and with hang tags that are not actually used, to conceal the ornamental use.<sup>59</sup>

If such conduct involving fake specimens were proven, it very well could undergird a fraud claim. *Look Cycle Int’l v. Kunshan Qiyue Outdoor Sports Goods Co.*, Canc. No. 92079409, 2024 TTAB LEXIS 289, at \*39 (TTAB 2024) (“falsity of the specimens is a material misrepresentation”); *see also Hurley Int’l LLC v. Volta*, Opp. No. 91158304, 2007 TTAB LEXIS 10, at \*24 (TTAB 2007) (“[S]tatements regarding specimens

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<sup>58</sup> Ellis Decl., 20 TTABVUE 3 ¶¶ 4-6, Exhibit 20.

<sup>59</sup> Opposer’s Brief, 23 TTABVUE 5, 15-17. Opposer points to prior applications filed by Applicant, including for the mark, ½ WAY TO FIRST, Reg. No. 6319251, using specimens that only showed the mark on a hang tag but without ornamental use. *Id.* at 17; Joncus Decl., 21 TTABVUE Exhibits 23, 24. Opposer asks that we consider her briefing “as a formal report of suspicious submissions and a suspicious pattern of behavior under the first step of the RPO [Register Protection Office] administrative sanctions process for both” marks. 23 TTABVUE 18, 19. Opposer’s request falls outside of the Board’s purview in this matter, as reflected in TMEP § 720 (May 2024). To share information with the RPO, Opposer may utilize the resources and contact information on the USPTO’s website, including <https://www.uspto.gov/about-us/trademark-register-protection-office>, <https://www.uspto.gov/trademarks/protect/administrative-sanctions-process>, and the email address [TMScams@uspto.gov](mailto:TMScams@uspto.gov). Opposer also may consider pursuing any available remedies with respect to Reg. No. 6319251, which is not before us in this case.

submitted in support of an application are certainly material to issuance of a registration.”) (citing *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46 (Fed. Cir. 1986)).

However, the evidence does not come close to proving that Applicant submitted a fake specimen, let alone by clear and convincing evidence. As noted above, Applicant and his witnesses testified that they sold baby bodysuits without any ornamental use of FIRST YEAR DOWN and with the hang tag seen in the Specimen, including in August 2021 when the Application was filed.<sup>60</sup> Ms. Sohmers, who participated in ordering inventory and packaging merchandise for shipment, testified that from about January 2021 she and her parents packaged shirts “both with and without ornamental use” bearing the hang tag with the FIRST YEAR DOWN mark, “and shipped that merchandise as shown on [Uzzo] Exhibit B,” the image seen in the Specimen.<sup>61</sup> Opposer provides no reason for us to doubt the veracity of this testimony, and we find none.

Further, Applicant proffers a credible explanation for the products that Ms. White and Ms. Ellis received without a hang tag or other label bearing the applied-for mark, as their purchases appear to have been made when Applicant was in the midst of changing the labels it used. After several months of using a tagging gun to affix the hang tag, Applicant decided instead to use stickers reading “First Year Down by Little Sweetees.”<sup>62</sup> The stickers were used until existing product inventory was depleted,

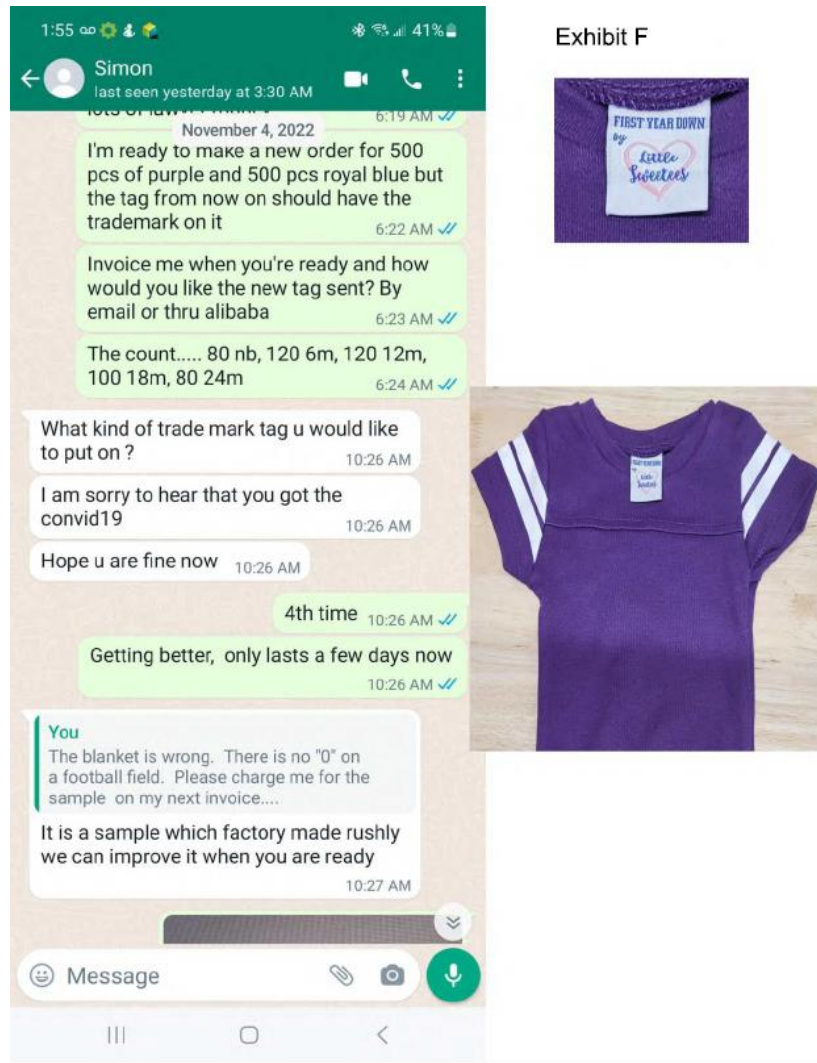
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<sup>60</sup> A. Uzzo Decl. 22 TTABVUE 3-4 ¶¶ 7, 16; *see id.*, K. Uzzo Decl., 22 TTABVUE 25-26 ¶¶ 5, 7; A. Sohmers Decl., 22 TTABVUE 28 ¶¶ 5, 8-9.

<sup>61</sup> A. Sohmers Decl., 22 TTABVUE 28 ¶ 9.

<sup>62</sup> A. Uzzo Decl., 22 TTABVUE 4 ¶¶ 16-17; K. Uzzo Decl., 22 TTABVUE 26 ¶ 8; A. Sohmers Decl., 22 TTABVUE 28 ¶¶ 9-10.

after which Applicant began placing “First Year Down by Little Sweetees” on a sewn-in collar label.<sup>63</sup> Corroborating evidence, in the form of a screenshot of a text exchange from November 2022 between Applicant and his factory’s representative, is shown below:



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<sup>63</sup> A. Uzzo Decl., 22 TTABVUE 4-5 ¶¶ 17-18; K. Uzzo Decl., 22 TTABVUE 25 ¶ 9.

<sup>64</sup> A. Uzzo Decl. 22 TTABVUE 5 ¶ 18, Exhibit F. Applicant provided receipts showing purchase of 8,200 of these shirts. *Id.* ¶ 19, Exhibit G.

To Applicant's knowledge, no orders of the products left their premises without the mark affixed to the sticker, hang tag, or sewn-in label, although "[i]t is possible that [they] sealed the bag with the incorrect sticker."<sup>65</sup> And the testimony submitted by Opposer, a sample of two purchases, does not foreclose the possibility of products also shipped with the branded stickers. In light of Applicant's explanation, corroborated by the evidence described above, the declarations of Ms. White and Ms. Ellis about their orders fall short of proving that Applicant's Specimen was fake.

Applicant submitted testimony that the Specimen showed the mark as actually used on the goods, including at the time the Application was filed. Opposer has not undermined this testimony, either through cross-examination or other evidence. Thus, Opposer has failed to prove by clear and convincing evidence that Applicant made a false representation regarding the Specimen, and the fraud claim must fail. *See, e.g., Dragon Bleu v. VENM, LLC*, Opp. No. 91212231, 2014 TTAB LEXIS 352, at \*10 (TTAB 2014) (absent allegation of false statement, a "critical element[] in proving fraud," claim was insufficient); *Threshold.TV, Inc. v. Metronome Enters.*, Opp. No. 91152662, 2010 TTAB LEXIS 314, at \*31 (TTAB 2010) ("Because opposer has not demonstrated that any statements made in applicant's statements of use were false ... opposer's claim of fraud must fail.").

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<sup>65</sup> A. Uzzo Decl., 22 TTABVUE 6 ¶ 26.

## V. Conclusion

Opposer has proven entitlement to bring this proceeding. However, considering the record as whole, we find that Opposer has not carried her burden to show that the applied-for mark fails to function as a trademark. We also find that Opposer has failed to prove by clear and convincing evidence that Applicant made a false statement to the USPTO in connection with his Specimen of use.

**Decision:** The opposition to registration of FIRST YEAR DOWN on the ground of failure to function as a trademark under Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§ 1051-1052, 1127, and on the ground of fraud, is dismissed.