

This Opinion Is Not a
Precedent of the TTAB

Mailed: July 31, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Uncle Sam GmbH

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Application Serial No. 79187215

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Heather E. Balmat of Balmat Law PLLC for Uncle Sam GmbH.

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

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Before Mermelstein, Bergsman and English, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Uncle Sam GmbH (Applicant) filed an application to register the image of Uncle Sam, reproduced below, for a variety of goods in International Classes 28 (games and playthings), 29 (foods), 30 (foods), 32 (beer and fruit drinks) and 33 (alcoholic beverages).¹

¹ Application Serial No. 79187215 was filed on January 15, 2016, under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a), requesting an extension of protection based on Applicant's International Registration No. 1298500 registered January 15, 2016.



The description of the mark reads as follows:

The mark consists of a man with pink skin and white hair and beard pointing his right index finger at the viewer and wearing a white top hat with a blue band and white stars, a red tie, a white shirt, and a blue jacket; the elements of the drawing are outlined and/or shaded in black, white and gray.

The color(s) blue, white, pink, red, black, and gray is/are claimed as a feature of the mark.

Although Applicant did not claim ownership of another registration during the prosecution of its application, Applicant informed the USPTO in a Response to an Office Action and again in its Request for Reconsideration that it is the owner of Registration No. 3557762 for the mark UNCLE SAM and design, reproduced below, for clothing, in Class 25:²

² Applicant's July 31, 2017 Response to Office Action (TSDR 15); Applicant's Request for Reconsideration (5 TTABVUE 2-3). Registration No. 3557762 was registered January 6, 2009 based on an application filed under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a), requesting an extension of protection based on Applicant's International Registration No. 0948844. The USPTO accepted Applicant's Section 71 declaration of use.

Citations to the examination record refer to the Trademark Office's online Trademark Status and Document Retrieval system (TSDR), by page number. All citations to the documents contained in the TSDR database are to the downloadable .pdf version of the documents.



The description of the mark in Applicant's registration reads as follows:

The color(s) black, white, yellow is/are claimed as a feature of the mark. The mark consists of an "Uncle Sam" figure surrounded by a circle overlaid by the words "Uncle Sam". The color yellow appears in the wording "Uncle Sam" and in the design in the star on the hat band. The color white appears in the design in the circle surrounding the figure as well as in the figure's hat, shirt, face, hair and hand. The color black appears in the design in the hat band, the figure's facial features and the figure's jacket.

The Examining Attorney has refused to register the subject matter sought to be registered on the ground that the image of Uncle Sam does not function as a trademark. Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052 and 1127. The Examining Attorney contends that the subject matter sought to be registered "does not function as a trademark because of the iconic nature and cultural significance of this specific version of Uncle Sam" and, therefore, "consumers will not interpret the applied-for mark as indicating source."³

According to the *ENCYCLOPEDIA BRITANNICA*, Uncle Sam is a popular symbol for the United States "usually associated with a cartoon figure having long white hair and chin whiskers and dressed in a swallow-tailed coat, vest, tall hat, and striped

³ Examining Attorney's Brief (9 TTABVUE 6).

trousers.”⁴ The ENCYCLOPAEDIA BRITANNICA displayed the recruiting poster, reproduced below, which was designed by James Montgomery Flagg in 1917.⁵



The renown of Uncle Sam has been recognized in judicial decisions. *See Durable Toy & Novelty Corp. v. J. Chien & Co.*, 133 F.2d 853, 56 USPQ 339, 341 (2d Cir. 1943) (“Uncle Sam’ is part of the national mythology, not entirely unlike the flag, or any other part of our inherited patriotic paraphernalia.”); *In re Consolidated Foods Corp.*, 187 USPQ2d 63, 64 (TTAB 1975) (quoting *W. H. Snyder & Sons, Inc. v. Ladd*, 227 F. Supp. 185, 140 USPQ 647 (D.D.C. 1964) (identifying the designation “Uncle Sam” and “the unique human representation thereof” as national symbols)).

⁴ January 31, 2017 Office Action (TSDR 9); *see also* Merriam-Webster.com (“Uncle Sam is a fictional character who represents the United States government.”) attached to the March 28, 2018 Office Action (TSDR 9).

⁵ January 31, 2017 Office Action (TSDR 9).

Even though Uncle Sam has been referred to as “a symbol of patriotism” and “a personification of the government of the United States,”⁶ “the increased commercialization of seemingly every aspect of American life found Uncle Sam appropriated as a symbol that did everything from raise money for a local zoo to hawk cupcakes.”⁷ Nevertheless, the Uncle Sam imagery has never been found to be an insignia of the United States pursuant to Section 2(b) of the Trademark Act, 15 U.S.C. § 1052(b), and it is not in this appeal. In this regard, the USPTO has registered the images of Uncle Sam for other goods and services. Copies of those mark are reproduced below:

Registration No. 4852344 for the mark SAM’S ACTION and design for engine oils;⁸

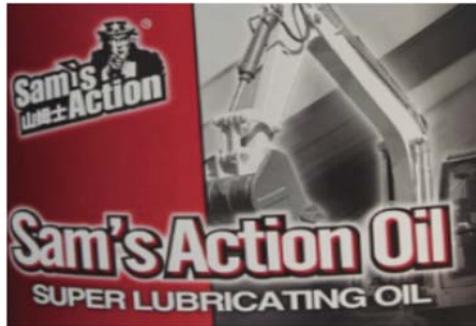
⁶ Danna Bell, “Uncle Sam: American Symbol, American Icon,” Library of Congress Website (blogs.loc.gov/teachers/2014/07/uncle-sam-american-symbol-america-icon/) attached to the January 31, 2017 Office Action (TSDR 11); *see also* World Digital Library (loc.gov/item/today-in-history/junme-18/) (referring to the Flagg image of Uncle Sam as “an indelible American icon”) attached to the September 6, 2017 Office Action (TSDR 6); The Spruce website (thespruce.com) (Flagg created “the truly iconic Uncle Sam imagery”) attached to the September 6, 2017 Office Action (TSDR 7); Natalie Elder, “Uncle Sam: The man and the meme,” (September 13, 2013), Smithsonian website (americanhistory.si.edu) (“The image of Uncle Sam as a personification of our nation and government is widespread and instantly recognizable.”) attached to the September 6, 2017 Office Action (TSDR 9).

⁷ Carl Anthony, “Uncle Sam: Reviled, Rebuked & Revived into a New Century,” [Carlanthonyonline.com](https://carlanthonyonline.com) (July 7, 2014) attached to Applicant’s July 31, 2017 Response to Office Action (TSDR 83); *see also* Natalie Elder, “Uncle Sam: The man and the meme,” (September 13, 2013), Smithsonian website (americanhistory.si.edu) (“He has been part of advertising for over 100 years, appearing on products ranging from cereal to car insurance.”) attached to the September 6, 2017 Office Action (TSDR 8).

⁸ Applicant’s July 31, 2017 Response to Office Action (TSDR 64); Applicant’s Request for Reconsideration (5 TTABVUE 204).



The specimen showing use of the mark is reproduced below:⁹



Registration No. 2912012 for the mark I WANT YOU OUT OF JAIL and design for bail bond services;¹⁰



The specimen showing use of the mark is reproduced below:¹¹

⁹ Applicant's Request for Reconsideration (5 TTABVUE 229).

¹⁰ Applicant's Request for Reconsideration (5 TTABVUE 269). This registration was cancelled for failure to file a Section 8 declaration of use. While we rarely consider cancelled registrations, we exercise our discretion in this case to help us get of sense of when Uncle Sam imagery has been registered and how it has been used in a trademark sense.

¹¹ Applicant's Request for Reconsideration (5 TTABVUE 303).



Registration No. 4358933 for the mark BALLYHOO REPUBLIC and design for online publications;¹²



Registration No. 4267825 for the mark U.S. PIZZA and design for restaurant services;¹³



¹² Applicant's July 31, 2017 Response to Office Action (TSDR 58); Applicant's Request for Reconsideration (5 TTABVUE 330). The specimen of use is not of record.

¹³ Applicant's July 31, 2017 Response to Office Action (TSDR 60); Applicant's Request for Reconsideration (5 TTABVUE 332). The specimen of use is not of record.

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Registration No. 4782778 for the stylized image of Uncle Sam for charitable services;¹⁴



Registration No. 5117559 for the mark ROD'S AMERICAN MARKET and design for retail store services in the field of apparel, furniture, gifts, and hunting and outdoor gear;¹⁵



Registration No. 4341699 for the mark UNCLE SAM'S AVENGERS and design for charitable fund raising services;¹⁶



¹⁴ Applicant's July 31, 2017 Response to Office Action (TSDR 62); Applicant's Request for Reconsideration (5 TTABVUE 334). The specimen of use is not of record.

¹⁵ Applicant's July 31, 2017 Response to Office Action (TSDR 66); Applicant's Request for Reconsideration (5 TTABVUE 336). The specimen of use is not of record.

¹⁶ Applicant's July 31, 2017 Response to Office Action (TSDR 34); Applicant's Request for Reconsideration (5 TTABVUE 343). The specimen of use is not of record.

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Registration No. 4148670 for the stylized image of Uncle Sam for clothing and uniforms;¹⁷



Registration No. 3708155 for the mark USA INSULATION and design for the installation of building insulation;¹⁸



Registration No. 4145702 for the stylized image of Uncle Sam for insurance services;¹⁹



¹⁷ Applicant's July 31, 2017 Response to Office Action (TSDR 54); Applicant's Request for Reconsideration (5 TTABVUE 357). The specimen of use is not of record.

¹⁸ Applicant's July 31, 2017 Response to Office Action (TSDR 52). The specimen of use is not of record.

¹⁹ Applicant's July 31, 2017 Response to Office Action (TSDR 56). The registration has been cancelled for failure to file a Section 8 declaration of use. As noted above, we exercise our discretion to consider this cancelled registration to help us understand when the USPTO registers Uncle Sam imagery. The specimen of use is not of record.

The Examining Attorney submitted images of Uncle Sam used to advertise various goods and services.²⁰ Representative advertisements are reproduced below:

An advertisement for Bobcat of Knoxville. On the left, Uncle Sam is depicted in his iconic attire, pointing directly at the viewer. The background is a gradient of white and orange. The text "DON'T DELAY. ACT NOW." is written in large, bold, orange letters at the top. Below it, the text "It's Your Money or The IRS deduct up to \$500,000 purchase/finance/lease" is displayed. To the right, the text "NEW & USED" is written in bold, white letters. Below this, a list of equipment types is provided: "Excavators", "Loaders", "Attachments", "Tractors", and "Utility Vehicles". At the bottom right, the text "NOW UNTIL DEC. 31ST" is written in bold, white letters. Below this, the text "This is not tax advise. Visit www.bobcatofknoxville.com for details" is displayed. At the bottom left, the Bobcat logo and the text "Bobcat OF KNOXVILLE" are visible. At the bottom right, the address "4600 BOBCAT LANE", phone number "(865) 588-8115", email "knoxstore@bobcatofknoxville.com", and website "www.BOBCATOFKNOXVILLE.com" are listed.

²⁰ September 6, 2017 Office Action (TSDR 12-36); *see also* March 28, 2018 Office Action (TSDR 66-80).



These three examples of third-party use convey the commercial impression that Uncle Sam wants the consumer to try the advertised product or service.

Section 45 of the Trademark Act defines a “trademark,” in relevant part, as “any word, name, symbol, or device, or any combination thereof 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.” 15 U.S.C. § 1127. “It is the source-distinguishing ability of a mark — not its ontological status as color, shape, fragrance, word, or sign — that permits it to serve” as a trademark. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1163 (1995). Nevertheless, “not every designation that is placed or used on or in connection with a product necessarily functions ... as a trademark for said product; not every

designation adopted with the intention that it performs a trademark function and even labeled as a trademark necessarily accomplishes that purpose; and there are certain designations that are inherently incapable of functioning as trademarks to identify and distinguish the source of the products in connection with which they are used.” *Am. Velcro, Inc. v. Charles Mayer Studios, Inc.*, 177 USPQ 149, 154 (TTAB 1973).

The critical inquiry in determining whether a designation functions as a mark is how the designation would be perceived by the relevant public. To make this determination we look to the specimens and other evidence of record showing how the designation is actually used in the marketplace. *See In re Volvo Cars of N. Am. Inc.*, 46 USPQ2d 1455 (TTAB 1998).

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. *See In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999). 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. *See Reed v. Amoco Oil Co.*, 611 F. Supp. 9, 225 USPQ 876, 877 (M.D. Tenn. 1984).

In re Eagle Crest, Inc., 96 USPQ2d 1227, 1229 (TTAB 2010).

Because the filing basis of the application at issue is a request for protection based on an International Registration under Section 66(a) of the Trademark Act, there is no specimen of use in the record. However, in Applicant’s March 5, 2018 Response to an Office Action, Applicant submitted a “presentation showing examples of how the

applied-for design mark will be used in connection with Applicant's goods."²¹ A representative example of Applicant's proposed packaging is reproduced below:²²



Applicant's proposed use of its Uncle Sam imagery is analogous to the representative examples of third-party use noted above engendering the commercial impression that Uncle Sam wants you – the consumer – to try this product. Thus, Applicant argues that its proposed use of UNCLE SAM is consistent with “[t]he evidence of record show[ing] ubiquitous and varied use of the exact image for a number of goods and services” and “the Smithsonian website stat[ing] that the image ‘has been part of advertising for over 100 years, appearing on products ranging from cereal to car insurance.’”²³

²¹ March 5, 2018 Response to an Office Action (TSDR 1).

²² *Id.* at TSDR 26.

²³ Applicant's Brief, p. 4 (7 TTABVUE 5) citing the March 28, 2018 Final Office Action (TSDR 5).

Based on the evidence regarding Applicant's proposed use as well as the third-party use of the Uncle Sam imagery, we find that Applicant's depiction of UNCLE SAM fails to function as a trademark because it would be perceived by the consuming public as an ornamental use of the Uncle Sam imagery, rather than as indicator of source. This finding is based, in part, on the renown of the Flagg created image of Uncle Sam that is recognized as a personification of the United States and evokes the "I want you" demand of the Flagg recruiting poster, and in part, on the presentation of the image on essentially the entire packaging of the products.

The evidence of record shows that the Flagg created image of Uncle Sam is often employed in advertising to convey the commercial impression that the product provider "wants you" to try the product. Applicant's proposed product packaging shows that this is the manner in which Applicant intends to use the Uncle Sam image. As so used, purchasers and prospective customers for Applicant's goods would be unlikely to regard Uncle Sam as identifying and distinguishing Applicant's products and indicating their source. In other words, the Flagg image of Uncle Sam, which because it extensively has been used to advertise a wide variety of goods and services, has taken on the characteristics of a common basic shape or design. *See Wiley v. Am. Greetings Corp.*, 762 F.2d 139, 226 USPQ 101, 103-04 (1st Cir. 1985) (mark consisting of "a red heart, permanently affixed to the "left breast of a teddy bear," even if such a combination could be deemed unique, is simply a mere refinement of a red heart motif which is a commonly adopted and well-known means of ornamentation for teddy bears, other stuffed animals and toys in general); *In re File*, 48 USPQ2d 1363, 1367

(TTAB 1998) (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 to which they have become accustomed and would not be inherently regarded as a source indicator.”); *In re F.C.F. Inc.*, 30 USPQ2d 1825, 1827 (TTAB 1994) (rose design packaging for cosmetics not inherently distinctive because it is simply a refinement of a basic, common, and well-known form of decoration or ornamentation for cosmetic packaging).

While Applicant intends that the Flagg image of Uncle Sam functions as a trademark for its products, it is also true that:

“... not everything that a party adopts and uses with the intent that it function as a trademark necessarily achieves this goal or is legally capable of doing so and not everything that is recognized or associated with a party is necessarily a registrable trademark.”

In re Port-A-Hut, Inc., 183 USPQ 680, 682 (TTAB 1974). Because of the renown of the Flagg image of Uncle Sam, its extensive use in advertising by others, and the display of the image over the entire packaging of Applicant’s products, we find that, without proof to the contrary, it will not be perceived as a trademark. Instead, due to its proposed manner of use on Applicant’s packaging, Applicant asks potential purchasers to try its products using the iconic image of Uncle Sam, which consumers are accustomed to seeing, in advertising. Consequently, the image of Uncle Sam sought to be registered does not function as a trademark for Applicant’s products.

Applicant argues that third-party registrations for other iconic images (e.g., Statute of Liberty or Mona Lisa) are evidence that images such as Uncle Sam are

registrable.²⁴ However, the question of whether other images are registrable is not before us and has no bearing on the question of whether the image of Uncle Sam that Applicant seeks to register is registrable. *See In re Eagle Crest, Inc.*, 96 USPQ2d at 1232; *see also In re Nett Designs Inc.*, 236 F.3d 139, 57 USPQ2d 1554, 1564 (Fed. Cir. 2001) (each case must be decided on its own merit and even “if some prior registrations had some characteristics similar to [applicant’s] application, the PTO’s allowance of such prior registrations does not bind the Board or this court”); *In re United Trademark Holdings, Inc.*, 122 USPQ2d 1976 (TTAB 2017) (“we must decide the case based on the record in that case in accordance with the governing statutory standard. We are not estopped or disqualified from applying the statute because ... an examining attorney (or attorneys) may have overlooked a relevant statutory provision and, perhaps erroneously, allowed an application to register.”).²⁵

Specifically, as to the other third-party registrations consisting of the Uncle Sam imagery, with the exception of Registration No. 4852344 for the mark SAM’S ACTION and design for engine oil and Registration No. 2912012 for the mark I

²⁴ Applicant’s Brief, pp. 6-7 (7 TTABVUE 7-8) citing March 5, 2018 Response to Office Action (TSDR 38-65); September 28, 2018 Request for Reconsideration (5 TTABVUE 304-326).

²⁵ *See, e.g., In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016) (“The PTO is required to examine all trademark applications for compliance with each and every eligibility requirement, including non-genericness, even if the PTO earlier mistakenly registered a similar or identical mark suffering the same defect.”); *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 91 USPQ2d 1218, 1221 (Fed. Cir. 2009) (“Even if all of the third-party registrations should have been refused registration under section 1052(a), such errors do not bind the USPTO to improperly register Applicant’s marks.”) (citation omitted); *In re Boulevard Entm’t, Inc.*, 334 F.3d 1336, 67 USPQ2d 1475, 1480 (Fed. Cir. 2003) (“The fact that, whether because of administrative error or otherwise, some marks have been registered even though they may be in violation of the governing statutory standard does not mean that the agency must forgo applying that standard in all other cases.”).

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WANT YOU OUT OF JAIL and design for bail bond services, we are not privy to the files of these registrations, so we have no way of knowing how those marks were used. Registration No. 4852344 for the mark SAM'S ACTION and the Uncle Sam image forms a unitary mark and, as displayed on the specimen, is not merely ornamental. Likewise, the mark I WANT YOU OUT OF JAIL and the Uncle Sam image for bail bond services design in Registration No. 2912012 is a unitary mark, not just the Flagg image of Uncle Sam. If any lesson can be gleaned from these two registrations, it is that interplay of words and the image of Uncle Sam may form the basis of registration.

The decision in this appeal refusing registration is limited to the record in this case. This decision should not be construed as creating a per se rule against the registration of the Flagg image of Uncle Sam.

Decision: The refusal to register Applicant's mark consisting of the image of Uncle Sam is affirmed.