

This Opinion is Not a
Precedent of the TTAB

Mailed: February 15, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Random Acts of Kindness Foundation

Serial Nos. 87245967, 87245971, 87245973, and 87245975¹

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Paisner LLP for The Random Acts of Kindness Foundation.

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Odette Bonnet, Managing Attorney.²

Before Ritchie, Lykos, and Adlin,
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

On November 22, 2016, The Random Acts of Kindness Foundation (“Applicant”) filed four applications under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), to register the following marks on the Principal Register:

Application Serial No. 87245967 for the mark

¹ These appeals were consolidated on May 25, 2018. Citations to the record are to parent application Serial No. 87245967 and refer to the downloadable .pdf version of the USPTO's Trademark Status & Document Retrieval (“TSDR”) system. *See, e.g., In re United Trademark Holdings, Inc.*, 122 USPQ2d 1796, 1797 n.5 (TTAB 2017).

² Managing Attorney Odette Bonnet has since retired from the USPTO.

RANDOM ACTS OF KINDNESS

for “Downloadable educational course materials in the fields of social and emotional learning, philanthropy, citizenship, the promotion of public awareness of the need to do good, and the promotion of ethical and character values, to be a good citizen and to perform community services, charitable activities and the doing of good deeds for others; downloadable publications, namely, educational activity sheets, worksheets, teacher and educator guides, manuals, lesson plans, assessments, articles, written supplemental educational materials and educational booklets in the fields of social and emotional learning, philanthropy, citizenship, the promotion of public awareness of the need to do good, and the promotion of ethical and character values, to be a good citizen and to perform community services, charitable activities and the doing of good deeds for others; downloadable posters and book marks in the nature of downloadable images that may be printed for use as posters and book marks” in International Class 9;

Application Serial No. 87245971 for the mark

RANDOM ACTS OF KINDNESS

for “Printed educational course materials in the fields of social and emotional learning, philanthropy, citizenship, the promotion of public awareness of the need to do good, and the promotion of ethical and character values, to be a good citizen and to perform community services, charitable activities and the doing of good deeds for others; printed publications and materials, namely, educational activity sheets, worksheets, teacher and educator guides, manuals, lesson plans, assessments, articles, written supplemental educational materials and educational booklets in the fields of social and emotional learning, philanthropy, citizenship, the promotion of public awareness of the need

to do good, and the promotion of ethical and character values, to be a good citizen and to perform community services, charitable activities and the doing of good deeds for others; posters, book marks, note cards, printed recipe cards, stickers, decals, folders” in International Class 16;

Application Serial No. 87245973 for the mark

**RANDOM ACTS
OF KINDNESS**

for “Providing a website featuring news and information promoting the public awareness of good deeds for others; association services, namely, organizing and administering the formation of social and service clubs; association services, namely, promoting the public awareness of doing good deeds for others; charitable services, namely, promoting public awareness of the need to do good deeds for others; charitable services namely, namely, organizing and conducting volunteer programs and community service projects and club” in International Class 35; and

Application Serial No. 87245975 for the mark

**RANDOM ACTS
OF KINDNESS**

for “Education and entertainment services, namely, organizing events and assisting others with organizing events instructing and encouraging the doing of kind acts for others; education and entertainment services, namely, organizing and conducting social entertainment, cultural events and an ambassador program to encourage the doing of kind acts for others; education services, namely, providing courses, classes, seminars, lectures, workshops,

conferences and instructions in the fields of social and emotional learning, philanthropy, citizenship, the promotion of public awareness of the need to do good, and the promotion of ethical and character values, to be a good citizen and to perform community services, charitable activities and the doing of good deeds for others and distribution of course material in connection therewith; educational services, namely, providing online courses, classes, seminars, lectures and workshops in the fields of social and emotional learning, philanthropy, citizenship, the promotion of public awareness of the need to do good, and the promotion of ethical and character values, to be a good citizen and to perform community services, charitable activities and the doing of good deeds for others, and distribution of course material in connection therewith; educational and entertainment services, namely, providing motivational and educational speakers in the fields of social and emotional learning, philanthropy, citizenship, the promotion of public awareness of the need to do good, and the promotion of ethical and character values, to be a good citizen and to perform community services, charitable activities and the doing of good deeds for others; educational services, namely, conducting informal on-line programs in the fields of social and emotional learning, philanthropy, citizenship, the promotion of public awareness of the need to do good, and the promotion of ethical and character values, to be a good citizen and to perform community services, charitable activities and the doing of good deeds for others, and printable materials distributed therewith; educational services, namely, developing supplemental educational materials for others in the fields of social and emotional learning, philanthropy, citizenship, the promotion of public awareness of the need to do good, and the promotion of ethical and character values, to be a good citizen and to perform community services, charitable activities and the doing of good deeds for others; educational services, namely, providing online instruction in the fields of social and emotional learning, philanthropy, citizenship, the promotion of public awareness of the need to do good, and the promotion of ethical and character values, to be a good citizen and to perform community services, charitable activities and the doing of good deeds for others; educational services, namely, developing supplemental educational materials

for teachers; entertainment services, namely, organizing and conducting social entertainment and cultural events to encourage the doing of kind acts for others; providing a website featuring non-downloadable videos and prerecorded digital media in the nature of audio and video recordings in the fields of social and emotional learning, philanthropy, citizenship, the promotion of public awareness of the need to do good, and the promotion of ethical and character values, to be a good citizen and to perform community services, charitable activities and the doing of good deeds for others” in International Class 41.³

Each of the marks was finally refused on the ground that the applied-for marks fail to function as either a trademark or service mark under Sections 1, 2, 3, and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052, 1053, 1127, because the wording RANDOM ACTS OF KINDNESS is merely informational and constitutes a widely used common slogan that does not indicate the source of Applicant’s goods and services. Applicant appealed each of the refusals.

The appeal is fully briefed. We reverse.

The sole issue on appeal is whether RANDOM ACTS OF KINDNESS is merely a widely-used informational message such that the applied-for marks fail to function as trademarks or service marks under Sections 1, 2, 3, and 45 of the Trademark Act. To be clear, the refusals are not based on how each mark is used on the specimens or in relation to the particular goods and services identified in each application. Rather, the refusals are based on the “inherent nature” of the phrase RANDOM ACTS OF KINDNESS as so ubiquitously used as a message to refer to “the performing of good

³ On March 6, 2017, Examiner’s Amendments were issued to amend the identifications of goods in Serial Nos. 87245967 and 87245971.

deeds, charitable activities, and acts of compassion ...” that it is devoid of any source indicating significance.⁴

“The Trademark Act is not an act to register mere words, but rather to register trademarks. Before there can be registration, there must be a trademark, and unless words have been so used they cannot qualify.” *In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1976). Terms and expressions that merely convey an informational message are not registrable. *See e.g., D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d 1710, 1716 (TTAB 2016) (the phrase I ♥ DC on apparel and other souvenirs, whether displayed in a stacked or horizontal format would be not be perceived by as a trademark but rather as “an expression of enthusiasm for the city of Washington, DC.”); *In re Eagle Crest*, 96 USPQ2d 1227, 1232 (TTAB 2010) (ONCE A MARINE, ALWAYS A MARINE would not be perceived as a trademark but rather as an informational slogan “to express support, admiration or affiliation with the Marines”); *In re Volvo Cars of N. Am., Inc.*, 46 USPQ2d 1455, 1460-61 (TTAB 1998) (DRIVE SAFELY not registrable because it would be perceived only as an everyday, commonplace safety admonition and not as a trademark for “automobiles and structural parts therefor”); *In re Manco, Inc.*, 24 USPQ2d 1938, 1942 (TTAB 1992) (THINK GREEN and design not registrable because it would be perceived only as an informational slogan encouraging environmental awareness and not as a trademark for weather stripping and paper products); *In re Tilcon Warren, Inc.*, 221 USPQ 86 (TTAB 1984) (the phrase WATCH THAT CHILD for construction material would be

⁴ Examining Attorney’s Brief at 9 TTABVUE 8.

perceived merely as an expression of general concern about child safety that does not function as a mark). Use of a widely-used informational message in a traditionally source-identifying manner does not overcome the informational nature of the wording itself. *See D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d at 1716 (stating that use of I ♥ DC in a manner that is “conventional for the display of trademarks” is not sufficient for the informational message to act as a source identifier). To be a mark, the phrase must be used in a manner calculated to project to purchasers or potential purchasers a single source or origin for the goods. *In re Volvo Cars*, 46 USPQ2d at (TTAB 1998). “The critical inquiry in determining whether a designation functions as a mark is how the designation would be perceived by the relevant public.” *In re Eagle Crest Inc.*, 96 USPQ2d at 1229; *In re Aerospace Optics, Inc.*, 78 USPQ2d 1861, 1862 (TTAB 2006).

The Office takes the position that because the wording RANDOM ACTS OF KINDNESS is incapable of designating the source of *any* goods or services, the particular usage or placement of the wording on Applicant’s specimens does not obviate the refusal. In support thereof, the Examining Attorney has submitted excerpts from websites encouraging people to perform good deeds, charitable activities, and acts of compassion as well as articles discussing altruism. We highlight the following examples:

An online article posted on February 25, 2017 on the website “Small Business Trends” entitled “50 Acts of

Random Kindness Your Customers Will Love” by Anne Pilon.⁵

An undated personal blog post for a family with the surname Clark, called “Clarks Condensed,” entitled “Random Acts of Kindness Ideas.”⁶

An online article posted on BuzzFeed on July 23, 2014 entitled “101 Easy Ideas for Random Acts of Kindness” by Jessica Misener.⁷

An excerpt entitled “Random Acts of Kindness” on Compassion Games website retrieved on September 27, 2017.⁸

Wonderopolis excerpt explaining the “unofficial holiday” entitled “Random Acts of Kindness Day,” retrieved on September 27, 2017.⁹

An online article entitled “102 Random Acts of Kindness – Ideas to Inspire Kindness” by Brad Aronson on the blog bradaronson.com retrieved on September 27, 2017.¹⁰

An online article sponsored by The Wayne Hills High School Patriot Press entitled “Random Act of Kindness Club Has Productive Year Planned,” by Joseph Mezza dated September 26, 2017.¹¹

An excerpt retrieved on September 27, 2017 from Random Act’s website “At Random Acts, it’s our mission to conquer the world one random act of kindness at a time.”¹²

⁵ March 27, 2017 Office Action, pp. 4-14.

⁶ March 27, 2017 Office Action, pp. 4-14.

⁷ September 28, 2017 Final Office Action, p. 5.

⁸ September 28, 2017 Final Office Action, p. 6.

⁹ September 28, 2017 Final Office Action, p. 7.

¹⁰ September 28, 2017 Final Office Action, p. 8.

¹¹ September 28, 2017 Final Office Action, p. 9.

¹² September 28, 2017 Final Office Action, p. 11.

A post from the Berries blog dated February 1, 2017 entitled “53 Random Acts of Kindness.”¹³

An article posted on Lifehack dated July 3, 2017 entitled “29 Ways to Carry Out Random Acts of Kindness Every Day” by Arvin Devalia.¹⁴

An article posted on Popsugar dated June 30, 2017 entitled “109 Random Acts of Kindness You Can Start Doing Today” by Euna Park.¹⁵

Pinterest “Random Acts of Kindness Ideas” with 61 Pins and 1.7k followers retrieved on September 27, 2017.¹⁶

A printout from Amazon offering for sale a book entitled “Random Acts of Kindness Then and Now: The 20th Anniversary of a Simple Idea That Changes Lives” (paperback – February 1, 2013).¹⁷

Reader’s Digest article entitled “21 People Reveal the Random Acts of Kindness That Changed Their Lives” by Lindsay Tigar retrieved on September 27, 2017.¹⁸

The Examining Attorney further asserts that degree of stylization in each mark is negligible, failing to create a commercial impression separate and apart from the impression made by the wording itself. *See In re Cordua Rests., Inc.*, 823 F.3d 594, 606, 118 USPQ2d 1632, 1639-40 (Fed. Cir. 2016); *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 227 USPQ 961, 964 (Fed. Cir. 1985); *In re Sadoru Grp. Ltd.*, 105 USPQ2d 1484, 1490 (TTAB 2012).

¹³ September 28, 2017 Final Office Action, p. 12.

¹⁴ September 28, 2017 Final Office Action, p. 13.

¹⁵ September 28, 2017 Final Office Action, p. 14.

¹⁶ September 28, 2017 Final Office Action, p. 15.

¹⁷ September 28, 2017 Final Office Action, p. 16.

¹⁸ September 28, 2017 Final Office Action, p. 17.

Applicant counters that its previously registered marks, all on the Principal Register, preclude a finding that the applied-for marks fail to function as marks:¹⁹

Registration No. 2999484 for the standard character mark RANDOM ACTS OF KINDNESS for “Reading materials and written communications, namely greeting cards, a series of books instructing and encouraging the doing of kind acts for others, posters and bookmarks” in International Class 16; “Combined Declaration of Use and Incontestability under Sections 8 & 15” accepted on April 16, 2012; Section 9 renewal accepted on November 2, 2015.

Registration No. 3009883 for the standard character mark RANDOM ACTS OF KINDNESS for “Education and entertainment services, namely organizing events and assisting others with organizing events instructing and encouraging the doing of kind acts for others” in International Class 41; “Combined Declaration of Use and Incontestability under Sections 8 & 15” accepted on May 1, 2012; Section 9 renewal accepted on November 2, 2015.

Registration No. 4042929 for the standard character mark THE RANDOM ACTS OF KINDNESS FOUNDATION (FOUNDATION disclaimed) for “Computer services, namely, creating an on-line community for users to participate in discussions about doing good deeds for others, to offer suggestions about doing good deeds for others, and to engage in social networking relating to doing good deeds for others” in International Class 42, registered on October 18, 2011; “Combined Declaration of Use and Incontestability under Sections 8 & 15” accepted on July 13, 2017.

Registration No. 3916506 for the standard character mark RANDOM ACTS OF KINDNESS FOUNDATION (FOUNDATION disclaimed) for “Paper goods and printed matter, namely, posters” in International Class 16, registered on February 8, 2011; “Combined Declaration of

¹⁹ Applicant’s registrations showing current status and title were properly made of record during prosecution. See September 26, 2017 Response to Office Action, pp. 46-114. We have not considered Registration Nos. 3916504 and 3916505 which were cancelled on September 15, 2017 for failure to file a Section 8 declaration.

Use and Incontestability under Sections 8 & 15” accepted on March 31, 2017.

Registration No. 4119103 for the standard character mark THE RANDOM ACTS OF KINDNESS FOUNDATION (FOUNDATION disclaimed) for “Downloadable digital media, namely, images in the nature of calendars, images in the nature of printable book marks, images in the nature of printable posters, [and images in the nature of printable banners,] all provided via a global computer network; [downloadable computer software for providing users with information and reminders to do good deeds; downloadable software in the nature of mobile applications for providing users with information and reminders to do good deeds;] video recordings featuring content related to doing good deeds for others” in International Class 9, registered on March 27, 2012; “Combined Declaration of Use and Incontestability under Sections 8 & 15” accepted on July 13, 2017.

Registration No. 2999483 for the standard character mark RANDOM ACTS OF KINDNESS WEEK (WEEK disclaimed) for “Education and entertainment services, namely organizing events and assisting others with organizing events instructing and encouraging the doing of kind acts for others” in International Class 41, registered on September 27, 2005; “Combined Declaration of Use and Incontestability under Sections 8 & 15” accepted on October 19, 2011; renewed September 15, 2015.

Registration No. 5249686 for the mark

**RANDOM ACTS
OF KINDNESS
FOUNDATION**

(FOUNDATION disclaimed) for “Downloadable educational course materials in the fields of social and emotional learning, philanthropy, citizenship, the

promotion of public awareness of the need to do good, and the promotion of ethical and character values, to be a good citizen and to perform community services, charitable activities and the doing of good deeds for others; downloadable publications, namely, educational activity sheets, worksheets, teacher and educator guides, manuals, lesson plans, assessments, articles, written supplemental educational materials and educational booklets in the fields of social and emotional learning, philanthropy, citizenship, the promotion of public awareness of the need to do good, and the promotion of ethical and character values, to be a good citizen and to perform community services, charitable activities and the doing of good deeds for others; downloadable posters and book marks in the nature of downloadable images that may be printed for use as posters and book marks” in International Class 9, registered on July 25, 2017.

Registration No. 5249687 for the mark

RANDOM ACTS OF KINDNESS FOUNDATION

(FOUNDATION disclaimed) for “Printed educational course materials in the fields of social and emotional learning, philanthropy, citizenship, the promotion of public awareness of the need to do good, and the promotion of ethical and character values, to be a good citizen and to perform community services, charitable activities and the doing of good deeds for others; printed publications and materials, namely, educational activity sheets, worksheets, teacher and educator guides, manuals, lesson plans, assessments, articles, written supplemental educational materials and educational booklets in the fields of social and emotional learning, philanthropy, citizenship, the promotion of public awareness of the need to do good, and the promotion of ethical and character values, to be a good citizen and to perform community services, charitable activities and the doing of good deeds for others; posters, book marks, note cards, printed recipe cards, stickers, decals, folders” in International Class 16, registered on July 25, 2017.

Registration No. 5249688 for the mark

RANDOM ACTS OF KINDNESS FOUNDATION

(FOUNDATION disclaimed) for “Printed educational course materials in the fields of social and emotional learning, philanthropy, citizenship, the promotion of public awareness of the need to do good, and the promotion of ethical and character values, to be a good citizen and to perform community services, charitable activities and the doing of good deeds for others; printed publications and materials, namely, educational activity sheets, worksheets, teacher and educator guides, manuals, lesson plans, assessments, articles, written supplemental educational materials and educational booklets in the fields of social and emotional learning, philanthropy, citizenship, the promotion of public awareness of the need to do good, and the promotion of ethical and character values, to be a good citizen and to perform community services, charitable activities and the doing of good deeds for others; posters, book marks, note cards, printed recipe cards, stickers, decals, folders” in International Class 16, registered on July 25, 2017.

Registration No. 5249689 for the mark

RANDOM ACTS OF KINDNESS FOUNDATION

(FOUNDATION disclaimed) for “Providing a website featuring news and information promoting the public awareness of good deeds for others; association services, namely, organizing and administering the formation of

social and service clubs; association services, namely, promoting the public awareness of doing good deeds for others; charitable services, namely, promoting public awareness of the need to do good deeds for others; charitable services namely, organizing and conducting volunteer programs and community service projects and club” in International Class 35, registered on July 25, 2017.

Registration No. 5249690 for the mark

RANDOM ACTS OF KINDNESS FOUNDATION

for “Education and entertainment services, namely, organizing events and assisting others with organizing events instructing and encouraging the doing of kind acts for others; education and entertainment services, namely, organizing and conducting social entertainment, cultural events and an ambassador program to encourage the doing of kind acts for others; education services, namely, providing courses, classes, seminars, lectures, workshops, conferences and instructions in the fields of social and emotional learning, philanthropy, citizenship, the promotion of public awareness of the need to do good, and the promotion of ethical and character values, to be a good citizen and to perform community services, charitable activities and the doing of good deeds for others and distribution of course material in connection therewith; educational services, namely, providing online courses, classes, seminars, lectures and workshops in the fields of social and emotional learning, philanthropy, citizenship, the promotion of public awareness of the need to do good, and the promotion of ethical and character values, to be a good citizen and to perform community services, charitable activities and the doing of good deeds for others, and distribution of course material in connection therewith; educational and entertainment services, namely, providing motivational and educational speakers in the fields of

social and emotional learning, philanthropy, citizenship, the promotion of public awareness of the need to do good, and the promotion of ethical and character values, to be a good citizen and to perform community services, charitable activities and the doing of good deeds for others; educational services, namely, conducting informal on-line programs in the fields of social and emotional learning, philanthropy, citizenship, the promotion of public awareness of the need to do good, and the promotion of ethical and character values, to be a good citizen and to perform community services, charitable activities and the doing of good deeds for others, and printable materials distributed therewith; educational services, namely, developing supplemental educational materials for others in the fields of social and emotional learning, philanthropy, citizenship, the promotion of public awareness of the need to do good, and the promotion of ethical and character values, to be a good citizen and to perform community services, charitable activities and the doing of good deeds for others; educational services, namely, providing online instruction in the fields of social and emotional learning, philanthropy, citizenship, the promotion of public awareness of the need to do good, and the promotion of ethical and character values, to be a good citizen and to perform community services, charitable activities and the doing of good deeds for others; educational services, namely, developing supplemental educational materials for teachers; entertainment services, namely, organizing and conducting social entertainment and cultural events to encourage the doing of kind acts for others; providing a website featuring non-downloadable videos and prerecorded digital media in the nature of audio and video recordings in the fields of social and emotional learning, philanthropy, citizenship, the promotion of public awareness of the need to do good, and the promotion of ethical and character values, to be a good citizen and to perform community services, charitable activities and the doing of good deeds for others” in International Class 41, registered on July 25, 2017.

The Examining Attorney in turn relies on *In re Nett Designs, Inc.*, 236 F. 3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) for the often-cited principle that each case must be decided on its own facts and that the Board is not bound by prior decisions

involving different records. *See also In re Cordua Rests., Inc.*, 118 USPQ2d at 1635 (“The PTO is required to examine all trademark applications for compliance with each and every eligibility requirement . . . even if the PTO earlier mistakenly registered a similar or identical mark suffering the same defect.”).

While it is true that trademark rights are not static, *see In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 213 USPQ 9 (CCPA 1982), we are faced with a unique situation. Each of Applicant’s prior registrations issued on the Principal Register meaning that they are entitled to following presumption under Trademark Act Section 7(b), 15 U.S.C. § 1057(b):²⁰

Certificate as prima facie evidence. A certificate of registration of a mark upon the principal register provided by this chapter shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the owner’s ownership of the mark, and of the owner’s exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate.

Applicant has eleven registrations which are either comprised of or incorporate the same wording at issue here, in either standard character or stylized format. Six of these registrations are over five years old, and the remaining five issued from applications filed on the same day as the four applications at issue in this appeal.

²⁰ By contrast, the registration at issue in the consolidated opposition/cancellation proceeding in *D.C. One Wholesaler, Inc. v. Chien*, was registered on the Supplemental Register and as such, was not entitled to any of the Section 7(b) presumptions. 120 USPQ2d at 1713 n. 12 (“...Respondent's registered mark is not entitled to the presumption of validity established by Trademark Act Section 7(b), 15 U.S.C. § 1057(b), because Respondent's mark is registered on the Supplemental Register. The Section 7(b) presumption is, by its terms, limited to marks registered on the Principal Register.”).

None of Applicant's previously registered marks comprised in part of the phrase RANDOM ACTS OF KINDNESS include a disclaimer of the phrase. The Examining Attorney's refusals thus constitute a departure from the Office's prior position.

There is no evidence, or even argument, to suggest that the alleged incapability of this phrase to identify source could not have been discerned at the time any of the prior registrations were examined. The same types of evidence the Examining Attorney now relies on was previously available. Furthermore, the Office offers no reason for its inconsistent treatment of the five registrations which recently issued that were filed on the same day as the four applications before us. In light of these unusual circumstances, we are compelled to reverse the Examining Attorney's refusals. To find otherwise would result in inconsistent examination.

Decision: The refusals to register Applicant's marks are reversed.