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Subject: U.S. TRADEMARK APPLICATION NO. 87245967 - RANDOM ACTS OF KINDNESS - 0545764 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 87245967

MARK: RANDOM ACTS OF KINDNESS



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: The Random Acts of Kindness Foundation

CORRESPONDENT'S REFERENCE/DOCKET NO:

0545764

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the final refusals to register the marks RANDOM ACTS OF KINDNESS (Ser. No. 87245967), RANDOM ACTS OF KINDNESS (Ser. No. 87245971), RANDOM ACTS OF KINDNESS (Ser. No. 87245973), and RANDOM ACTS OF KINDNESS (Ser. No. 87245975) on the ground that the applied-for marks fail to function as trademarks and service marks under Sections 1, 2, 3, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, 1053, 1127.

STATEMENT OF FACTS

Applicant filed an application on November 22, 2016 for the mark RANDOM ACTS OF KINDNESS (Ser. No. 87245967; stylized with “OF” underlined) for use with “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.

On the same day, November, 22, 2016, applicant filed an application for the mark RANDOM ACTS OF KINDNESS (Ser. No. 87245971; stylized with “OF” underlined) for use with “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.

Also on November 22, 2016, applicant filed an application for the mark RANDOM ACTS OF KINDNESS (Ser. No. 87245973; stylized with “OF” underlined) for use with “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 35.¹

Finally, on November 22, 2016, applicant filed an application for the mark RANDOM ACTS OF KINDNESS (Ser. No. 87245975; stylized with “OF” underlined) for use with “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

¹ On November 29, 2016, applicant filed a voluntary amendment to submit a new image of the drawing.

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.

On March 6, 2017, examiner’s amendments were issued to amend the identifications of goods in Ser. Nos. 87245967 and 87245971.

On March 7, 2017, Office actions were issued for Ser. Nos. 87245973 and 87245975 refusing registration on the ground that the applied-for marks failed to function as service marks.

On March 27, 2017, after further consideration of the applications, Office actions were issued for Ser. Nos. 87245967 and 87245971 refusing registration on the ground that the applied-for marks failed to function as trademarks.

On September 7, 2017, applicant filed responses for Ser. Nos. 87245973 and 87245975 arguing that the marks function as service marks. On September 26, 2017, applicant filed corresponding responses for Ser. Nos. 87245967 and 87245971.

On September 28, 2017, final actions were issued for the four applications making final the refusals to register the applied-for marks for failure to function as trademarks and service marks.

Applicant timely filed for appeal on March 27, 2018, and filed a motion to consolidate the appeals of the four applications on May 18, 2018. The motion was granted on May 25, 2018.

Applicant filed its appeal brief on June 25, 2018, which was forwarded to the examining attorney on July 11, 2018.

ISSUE PRESENTED

The sole issue on appeal is whether the wording of the applied-for mark is merely a widely-used informational message such that the applied-for mark fails to function as a trademark and service mark under Sections 1, 2, 3, and 45 of the Trademark Act.

ARGUMENT

THE APPLIED-FOR MARK, RANDOM ACTS OF KINDNESS, IS A WIDELY-USED INFORMATIONAL MESSAGE THAT DOES NOT FUNCTION AS A TRADEMARK OR SERVICE MARK

Sections 1, 2, and 3 of the Trademark Act require that the applied-for word, name, symbol, device, or combination thereof be a trademark or service mark. 15 U.S.C. §§1051, 1052, and 1053. To be a trademark or service mark the applied-for word, name, symbol, device, or combination thereof must distinguish the applicant's goods and/or services from those of others and indicate the source of the goods and/or services. 15 U.S.C. §1127. An applied-for mark may fail to function as a trademark or service mark if it does not serve to identify the source of the goods or services due to its inherent nature or the manner in which it is used. *See, e.g., In re The Standard Oil Co.*, 275 F.2d 945, 947, 125 USPQ 227, 229 (C.C.P.A. 1960), *D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d 1710, 1716 (TTAB 2016); TMEP §1202. Widely-used messages that convey familiar concepts or sentiments by their inherent nature fail to function as trademarks or service marks because the wording will be understood as conveying the associated message rather than as identifying the source of the goods and/or services. *See, e.g., D.C. One Wholesaler, Inc.*, 120 USPQ2d at 1716.

- 1. The wording "RANDOM ACTS OF KINDNESS" is a widely-used informational message that fails to function as a trademark or service mark.**

Terms and expressions that merely convey an informational message are not registrable. *In re Eagle Crest, Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010) (finding ONCE A MARINE, ALWAYS A MARINE failed to function as a trademark because the phrase is a common motto used by and in support of the U.S. Marines). Determining whether the term or expression functions as a trademark or service mark depends on how it 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); TMEP §1202.04. “The more commonly a [term or expression] 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 [or service mark].” *In re Hulting*, 107 USPQ2d 1175, 1177 (TTAB 2013) (quoting *In re Eagle Crest, Inc.*, 96 USPQ2d at 1229); TMEP §1202.04(b). The particular manner of use of the mark may further support that consumers will not perceive the mark as an indication of source. *See Hulting*, 107 USPQ2d at 1179. However, use of a widely-used informational message in traditionally source-identifying manner does not overcome the informational nature of the wording itself. *See D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d 1710, 1716 (TTAB 2016) (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).

The evidence of record shows that RANDOM ACTS OF KINDNESS is commonly used to refer to the performing of good deeds, charitable activities, and acts of compassion and conveys a message encouraging people to perform such altruistic acts for the benefit of themselves and others in everyday life. The evidence consists of fifteen websites featuring “Random Acts of Kindness” ideas,² explanations of the meaning of the phrase,³ use of the phrase by events or groups with the purpose of performing

² See screenshots of Small Business Trends and Clarks Condensed websites in March 27, 2017 Office action at TMNG Pgs. 4-15; screenshots of Brad Aronson, BuzzFeed, Berries, Lifehack, Popsugar, and Pinterest websites in September 28, 2017 final Office action at TMNG Pgs. 7, 9, 11-14.

³ See screenshots of Compassion Games website in September 28, 2017 final Office action at TMNG pg. 5.

altruistic acts,⁴ a book detailing the history of the phrase and acts performed,⁵ and an article detailing acts performed and their effect on those involved.⁶ The evidence includes usage from a variety of sources, including schools and universities, clubs, organizations, publications, and blogs. These sources all use the phrase to convey the same message encouraging people to perform good deeds, charitable activities, and acts of compassion. The record shows that RANDOM ACTS OF KINDNESS is a widely-used informational message that consumers will not perceive as identifying the source of the identified goods and services.

Contrary to applicant's claims, the evidence is more than sufficient to show widespread use of the phrase by a variety of sources to convey the same message encouraging the doing of good deeds and other altruistic acts. In fact, applicant uses the phrase to convey the same message. Applicant states in its brief that it is "dedicated to promoting values of compassion and generosity and encouraging people to perform good deeds, charitable activities, and acts of compassion."⁷ This directly contradicts applicant's claims that its mark does not urge any action and its assertion that the claim that the applied-for mark conveys a message "makes no sense." Moreover, applicant's purpose to disseminate a message of compassion and to encourage good deeds, which comports with the commonly understood meaning of the phrase RANDOM ACTS OF KINDNESS, further reinforces that consumers will perceive the applied-for mark as conveying that message rather than as indicating the source of the goods and services.

Applicant further argues that the non-trademark uses of the phrase shown in the evidence "does not contribute to the analysis in any meaningful way." Applicant critically misunderstands the

⁴ See screenshots of Wonderopolis, The Wayne Hills High School Patriot Press, Random Acts, and University of California websites in September 28, 2017 final Office action at TMNG pgs. 6, 8, 10, and 17.

⁵ See screenshot of Amazon page selling the book in September 28, 2017 final Office action at TMNG pg. 15.

⁶ See screenshot of Readers Digest website in September 28, 2017 final Office action at TMNG pg. 17.

⁷ Applicant brief pg. 2.

role of the evidence in the analysis of an informational message. As is true in the generic and descriptive analysis, non-trademark usage of wording is essential for understanding consumer perception and understanding of the wording. The evidence performs the same function in this case. The evidence shows widespread use of the phrase “RANDOM ACTS OF KINDNESS” to convey a common message encouraging people to perform good deeds, charitable activities, and acts of compassion – the same message applicant intends to convey with its use of the phrase. As a result, consumers will understand the applied-for mark as encouraging such activities rather than indicating the source of the goods and services. Thus, applicant’s criticism of the evidence is unfounded.

Finally, the negligible stylization of block letters with the word “OF” underlined is not distinctive. Stylized non-distinctive wording is registrable only if the stylization creates 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, 1561, 227 USPQ 961, 964 (Fed. Cir. 1985); TMEP §1209.03(w). The degree of stylization in this case, however, is not sufficiently striking, unique, or distinctive so as to create a commercial impression separate and apart from the unregistrable components of the mark. *See In re Sadoru Grp., Ltd.*, 105 USPQ2d 1484, 1490 (TTAB 2012). Specifically, the block letters and underlined “OF” do not have meaning and are not unique or otherwise memorable to create a commercial impression separate and apart from the message conveyed by the phrase RANDOM ACTS OF KINDNESS.

Because consumers are accustomed to seeing “RANDOM ACTS OF KINDNESS” commonly used in everyday speech by a variety of sources to convey a specific message, they will not perceive the phrase as identifying the source of applicant’s goods and services but rather as only conveying an informational message.

2. The manner in which applicant uses the applied-for mark does not render the widely-used informational message registrable.

The crux of applicant's argument is that it uses the applied-for mark in a manner that consumers would perceive as a trademark or service mark. An applied-for mark may fail to function as a trademark or service mark in two ways: 1) the inherent nature of the applied-for mark indicates it will not be perceived as identifying the source of goods and/or services or 2) the manner of use indicates that consumers will not perceive the applied-for mark as identifying the source of goods and/or services. *See, e.g., D.C. One Wholesaler, Inc.*, 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), *In re Aerospace Optics Inc.*, 78 USPQ2d at 1864 (holding that the manner of use of the applied-for mark SPECTRUM, as shown on the specimen, did not lead consumers to perceive the applied-for mark as identifying the source of the goods); TMEP §1202. Applicant's focus only on the manner in which the mark is used is misplaced because the refusal is due to the inherent nature of the applied-for mark.

Applicant believes that the failure-to-function test has been misapplied due to that the lack of consideration of the manner in which the applied-for mark is used in the specimen and proffered evidence. However, applicant conflates the different ways in which a mark can fail to function as a trademark or service mark and applies the wrong test by focusing only on the manner of use and not on consumer perception of the applied-for mark itself. While the specific manner of use of the applied-for mark may further support that the wording would be understood as merely conveying an informational message, the refusal does not require that the wording be used in a non-source-identifying manner. *See D.C. One Wholesaler, Inc.*, 120 USPQ2d at 1716; TMEP §1202.04(b).

In *D.C. One Wholesaler, Inc.*, evidence was presented showing that the I ☐ DC mark was used in a source-identifying manner on hangtags and labels. 120 USPQ2d at 1716. The Board held that the

inherent nature of the wording itself would lead consumers to understand the wording as merely conveying enthusiasm for Washington, DC. *Id.* Furthermore, the Board added that the conventional trademark use on hangtags and labels, “does not require a different result.” *Id.* This result illustrates that the use of non-source-identifying wording in a source-identifying manner does not render the wording registrable.

This approach for widely-used messages is consistent with the approaches for other types of wording and designs that inherently do not function as trademarks and service marks. Source-identifying use of generic wording does not render the generic wording registrable. *See In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 1569 (Fed. Cir. 1987) (“Generic terms, by definition incapable of indicating sources, are the antithesis of trademarks, and can never attain trademark status.”); TMEP §1209.01. Source-identifying use of varietal and cultivar names do not render the names registrable. *See In re Pennington Seed Inc.*, 80USPQ2d 1758, 1763 (Fed. Cir. 2006) (holding that a varietal name is generic for the goods stating “[h]ere, the term ‘Rebel’ does not function as a source indicator, but rather indicates, and always has indicated, a variety of grass seed”); *In re Farmer Seed & Nursery Co.*, 137 USPQ 231, 231-32 (TTAB 1963) (upholding the refusal to register CHIEF BEMIDJI as a trademark because it is the varietal name for a strawberry plant and noting that large expenditures of money does not elevate the term to a trademark); TMEP §1202.12. Source-identifying use of an informational universal symbol does not render the symbol registrable. TMEP §1202.17(c)(i)(A) (“In these circumstances, the symbol’s position, prominence, and surrounding context on the specimen of use will not be as significant in the analysis, because the symbol will function only as informational matter regardless of its manner of use on the specimen.”). And finally, source identifying use of a widely-used informational message does not render the message registrable. *D.C. One Wholesaler, Inc.*, 120 USPQ2d at 1716.

In this case, the evidence of record shows that the applied-for mark RANDOM ACTS OF KINDNESS is a widely-used message used to encourage others to do good deeds. Again, applicant explicitly states that it is dedicated to disseminating this exact message, stating that it is “dedicated to promoting values of compassion and generosity and encouraging people to perform good deeds, charitable activities, and acts of compassion.”⁸ The commonly understood meaning of the widely-used phrase RANDOM ACTS OF KINDNESS comports with the message disseminated by applicant shows that consumers will understand the applied-for mark as conveying a message encouraging good deeds, notwithstanding the manner of use on applicant’s webpage and promotional materials.

Thus, the use of the applied-for mark on the specimens and evidence of record does not render RANDOM ACTS OF KINDNESS registrable.

3. Applicant’s prior registrations do not require registration in this case.

Finally, applicant notes that the refusal is inconsistent with its prior registrations for marks containing the wording “RANDOM ACTS OF KINDNESS”, some of which are incontestable under Section 15, and questions as to how those applications could proceed to registration while these four are refused. As is true with other refusals, it is well settled that each case must be decided on its own facts and the Trademark Trial and Appeal Board is not bound by prior decisions involving different records. *See, e.g., In re Nett Designs, Inc.*, 236 F. 3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); *In re Datapipe, Inc.*, 111 USPQ2d 1330, 1336 (TTAB 2014). In this case, the evidence of record shows that RANDOM ACTS OF KINDNESS is a widely-used message that conveys a commonly understood message such that consumers will understand the wording as merely conveying the associated message. Thus,

⁸ Applicant brief pg. 2.

the records of the applications at issue show that the applied-for mark fails to function as a trademark or service mark.

Moreover, the incontestable registrations do not preclude the failure-to-function refusal because incontestability does not bar a finding that the applied-for mark is incapable of identifying source. An incontestable registered mark cannot be challenged on the ground that the mark is merely descriptive. *Park 'N Fly v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 224 USPQ 327 (1985). However, this does not extend to marks that are generic or otherwise do not function as trademarks or service marks. *See In re Cordua Rests., Inc.*, 823 F.3d 594, 600, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016) (finding that the Board did not err in declining to consider the alleged incontestability of a prior registered standard-character word mark in evaluating the genericness of the stylized form thereof in connection with the same services); *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) (examining attorney could properly refuse registration on ground that mark DURANGO for chewing tobacco is primarily geographically deceptively misdescriptive, even though applicant owned incontestable registration of same mark for cigars); TMEP §1216.02. Thus, the incontestability of the prior registrations does not preclude finding that the applied-for mark is a widely-used informational message that does not function as a trademark.

Notwithstanding, the incontestability of the prior registrations would not apply in this case because the marks and goods are not identical. Ownership of an incontestable registration does not give the applicant a right to register the same mark for different goods or services, even if they are closely related to the goods or services in the incontestable registration. *See In re Save Venice N.Y. Inc.*, 259 F.3d 1346, 1353, 59 USPQ2d 1778, 1782 (Fed. Cir. 2001) (applicant's ownership of incontestable registration of the word mark SAVE VENICE for newsletters, brochures, and fundraising services did not preclude examining attorney from refusing registration of a composite mark consisting of the phrases THE VENICE COLLECTION and SAVE VENICE INC. with an image of the winged Lion of St. Mark for different goods;

"[a] registered mark is incontestable only in the form registered and for the goods or services claimed."); *In re Merrill Lynch, Pierce, Fenner, & Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987) (incontestable registration of CASH MANAGEMENT ACCOUNT for credit card services did not automatically entitle applicant to registration of the same mark for broader financial services); *In re Best Software Inc.*, 63 USPQ2d 1109, 1113 (TTAB 2002) (applicant's ownership of incontestable registration for the mark BEST! did not preclude examining attorney from requiring disclaimer of "BEST" in applications seeking registration of BEST! IMPERATIV HRMS "for goods which, although similar, are nevertheless somewhat different"); *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564 (TTAB 1988) (examining attorney could properly refuse registration on the ground that a mark is primarily merely a surname even if applicant owned incontestable registration of same mark for unrelated goods); *In re BankAmerica Corp.*, 231 USPQ 873 (TTAB 1986) (examining attorney could refuse registration of BANK OF AMERICA under §§2(e)(1) and 2(e)(2), despite applicant's ownership of incontestable registrations of same mark for related services). Applicant vaguely claims, without specific examples or discussion, that the registrations for RANDOM ACTS OF KINDNESS in standard characters identify "goods and services that either directly overlap with or are related to the goods and services in the applications at issue." This only suggests that the goods and services are broader, somewhat different, or may be related; however, the goods and services must be identical. Thus, even if incontestable prior registrations may preclude finding that a widely-used informational message fails to function as a trademark, the prior incontestable registrations do not apply in this case.

CONCLUSION

Therefore, because the wording RANDOM ACTS OF KINDNESS is a widely-used informational message that will not be perceived as identifying the source of the identified goods and services, the

applied-for mark fails to function as a trademark or service mark. For the foregoing reasons, the refusals to register under Sections 1, 2, 3, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, 1053, and 1127, should be affirmed.

Respectfully submitted,

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