

This Opinion is Not a  
Precedent of the TTAB

Mailed: September 18, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Scherr's Cabinets & Doors, Inc.*  
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Serial No. 87685028  
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Geoffrey Dureska of Dunlap Bennett & Ludwig PLLC,  
for Scherr's Cabinets & Doors, Inc.

Edward Fennessy, Trademark Examining Attorney, Law Office 114,  
Laurie Kaufman, Managing Attorney.

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Before Ritchie, Shaw and Pologeorgis,  
Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

Scherr's Cabinets & Doors, Inc. ("Applicant") seeks registration of the mark CABINETS ASSEMBLED BY YOU (in standard characters) on the Supplemental Register for goods identified as "Cabinets being furniture for residential and commercial properties," in International Class 20.<sup>1</sup> Applicant disclaimed "CABINETS."

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<sup>1</sup> Application Serial No. 87685028 was filed on November 15, 2017 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging a date of first use anywhere and in commerce of September 15, 2016. Applicant amended the application to seek registration on the

The Trademark Examining Attorney has refused registration of Applicant's mark on the ground that it fails to function as a trademark under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1151, 1052 and 1127.

When the refusal was made final, Applicant appealed and requested reconsideration. When the request for reconsideration was denied, the appeal resumed. The appeal is fully briefed. We affirm the refusal to register.<sup>2</sup>

### **Failure to function as a mark**

“[A] proposed trademark is registrable only if it functions as an identifier of the source of the applicant's goods or services.” *In re Yarnell Ice Cream, LLC*, 2019 USPQ2d 265039, \*16 (TTAB 2019) (quoting *In re DePorter*, 129 USPQ2d 1298, 1299 (TTAB 2019)). “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.” *Id.* (quoting *DePorter*, 129 USPQ2d at 1299 (quoting *In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1976)).

Slogans, phrases, and other terms that are considered to be merely informational in nature, or that express support, admiration or affiliation, are generally not registrable. *See In re Eagle Crest Inc.*, 96 USPQ2d 1227, 1232 (TTAB 2010) (“ONCE A MARINE, ALWAYS A MARINE is an old and familiar Marine expression, and as

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Supplemental Register to overcome a Section 2(e)(1) refusal, 15 U.S.C. § 1052(e)(1). Response to Office action of March 18, 2019.

<sup>2</sup> All TTABVUE and Trademark Status and Document Retrieval (“TSDR”) citations reference the docket and electronic file database for the involved application. All citations to the TSDR database are to the downloadable .PDF version of the documents.

such it is the type of expression that should remain free for all to use.”). *See also In re Volvo Cars of N. Am., Inc.*, 46 USPQ2d 1455, 1460-61 (TTAB 1998) (affirming refusal to register “Drive Safely” for automobiles because it would be perceived as an everyday, commonplace safety admonition).

“The critical inquiry in determining whether a designation functions as a mark is how the designation would be perceived by the relevant public.” *Eagle Crest*, 96 USPQ2d at 1229. “To make this determination we look to the specimens and other evidence of record showing how the designation is actually used in the marketplace.” *Id.* “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.” *Id.*

The Examining Attorney argues that: “the phrase or slogan ‘assembled by you’ is widely used in the marketplace to indicate that goods are sold in pieces that must be put together by the consumer after they are purchased.”<sup>3</sup> Further, “addition of the word ‘cabinets’ to the informational phrase ‘assembled by you’ does not diminish the informational nature of this wording or provide the proposed mark with source-identifying significance.”<sup>4</sup> In support of the refusal, the Examining Attorney submitted a number of excerpts from Internet webpages establishing that the phrase “assembled by you” is commonly used by manufacturers and retailers of cabinetry and furniture:

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<sup>3</sup> Examining Attorney’s Br., p. 6, 9 TTABVUE 6.

<sup>4</sup> *Id.* at 15.

- 1) Ikea.com – stating “IKEA products are designed to be **assembled by you.**” Office action of March 3, 2018, TSDR p. 14;
- 2) Rtacabinetstore.com – stating “our cabinets are **assembled by you.**” Office action of March 3, 2018, TSDR p. 31;
- 3) Homedoctor.net – stating “[Ready-to-assemble Kitchen Cabinets] can be taken home immediately and **assembled by you** or a carpenter.” Office action of March 3, 2018, TSDR p. 38;
- 4) Arwoodsfurniture.com – stating “Crafted with care by Delta Children, [furniture] easily **assembled by you.**” Office action of September 19, 2018, TSDR p. 18;
- 5) Beststeelkitchen.myshopify.com – stating “A line of kitchen cabinets . . . with the practicality of being **assembled by you.**” Office action of September 19, 2018, TSDR p. 31;
- 6) Architecturaldigest.com – stating “IKEA solved the tiny hallway big furniture dilemma by designing pieces in a million tiny parts that can be neatly packed in a box and **assembled by you.**” Denial of Reconsideration of April 4, 2019, TSDR p. 3;
- 7) American-outpost.com – stating “The [furniture] pieces will arrive in a wooden crate and will need to be un-crated and moved into your location and **assembled by you** the customer or someone you contract.” Denial of Reconsideration of April 4, 2019, TSDR p. 26;

- 8) Bicaflorida.com – stating “When fully assembled it will be strong, precise, durable, and practical furniture . . . BICA [furniture] products are designed to be **assembled by you.**” Denial of Reconsideration of April 4, 2019, TSDR p. 31;
- 9) Brownsfurnitureassembly.com – stating “Ready-to-assemble furniture was designed to be **assembled by you.**” Denial of Reconsideration of April 4, 2019, TSDR p. 35;
- 10) Carolinacabinetwarehouse.com – stating “This type of cabinets comes in different sizes and colors so that you can choose them online and they will be sent to your home and **assembled by you** or the professionals of your choice.” Denial of Reconsideration of April 4, 2019, TSDR p. 40;
- 11) Destinationbabykids.com – stating “Crafted with care by Serta, [furniture is] easily **assembled by you.**” Denial of Reconsideration of April 4, 2019, TSDR p. 45;
- 12) Pawleysislandhammocks.com – stating “[furniture is] [c]onstructed of ultra-low maintenance HDPE and is easily **assembled by you.**” Denial of Reconsideration of April 4, 2019, TSDR p. 51;
- 13) Rtskitchenandmore.com – stating “Our [cabinet] products are designed to be **assembled by you.**” Denial of Reconsideration of April 4, 2019, TSDR p. 54;
- 14) Rusticahardware.com – stating “The basic idea is that we design and fabricate unique barn doors which you can choose as unfinished or finished

slats . . . that are wrapped as boards ready to be **assembled by you** at home!” Denial of Reconsideration of April 4, 2019, TSDR p. 55;

15) Stirworks.com – stating “The [desk] is designed to be **assembled by you** and a friend.” Denial of Reconsideration of April 4, 2019, TSDR p. 67;

16) Verticalbunkbed.com – stating “Our bunk beds can easily be **assembled by you.**” Denial of Reconsideration of April 4, 2019, TSDR p. 69; and

17) Winecellarspec.com – stating “Packed and shipped flat, these [wine cellar] rooms are **assembled by you** on site.” Denial of Reconsideration of April 4, 2019, TSDR p. 71.

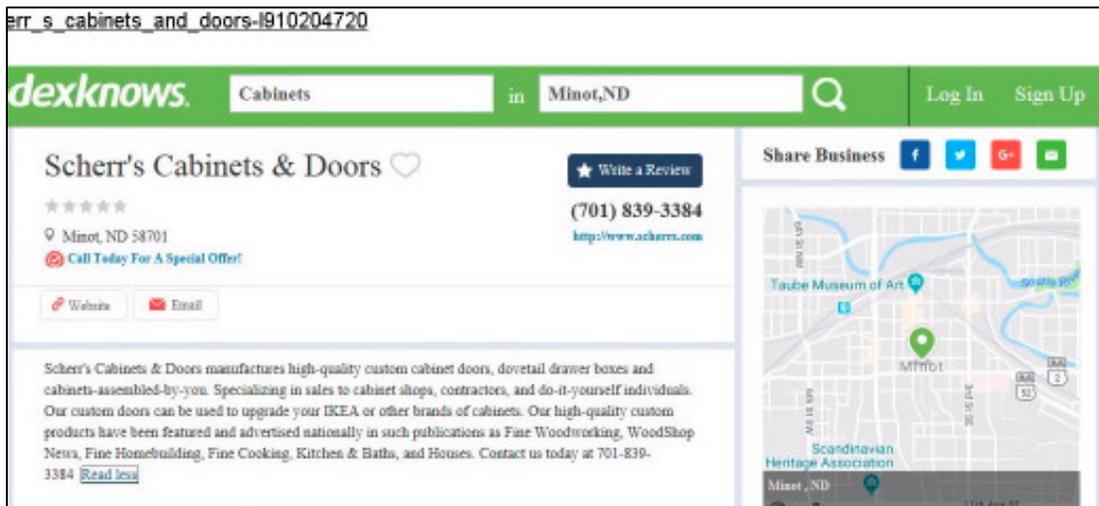
In addition, the Examining Attorney points to excerpts from Applicant’s website which “reinforce the informational meaning of the wording in the proposed mark.”<sup>5</sup> Applicant’s relevant web page appears below.



<sup>5</sup> Examining Attorney’s Br., p. 22.

<sup>6</sup> Office action of March 3, 2018, TSDR p. 19.

Applicant’s website further states its goods are “Ready to Assemble”<sup>7</sup> and “[c]abinet parts are shipped unassembled and are assembled by the customer or contractor employed by the customer.”<sup>8</sup> Other Internet advertisements for Applicant use the term “cabinets-assembled-by-you” alongside Applicant’s other products such as cabinet doors and drawers. The following Internet advertisement for Applicant states: “Scherr’s Cabinets & Doors manufactures high-quality custom cabinet doors, dovetail drawer boxes, and cabinets-assembled-by-you.”<sup>9</sup>



The function of a trademark is to identify a **single** commercial source. The record before us establishes that the phrase ASSEMBLED BY YOU is widely used by manufacturers and retailers to identify the fact that their products, such as cabinets and furniture, are sold unassembled. That is, they must be assembled by the

<sup>7</sup> Scherr’s.com, Office action of March 3, 2018, TSDR p. 27.

<sup>8</sup> *Id.*

<sup>9</sup> Office action of September 19, 2019, TSDR p. 92.

consumer. Applicant's addition of the designation CABINETS to the phrase ASSEMBLED BY YOU does not diminish the informational nature of the entire phrase CABINETS ASSEMBLED BY YOU for Applicant's "Cabinets being furniture for residential and commercial properties." Rather, it simply tells the consumer what kind of product Applicant sells.

Because consumers are accustomed to seeing ASSEMBLED BY YOU used by many different manufacturers and retailers of ready-to-assemble furniture and cabinets, they would not view the phrase CABINETS ASSEMBLED BY YOU as a trademark indicating that Applicant is the sole source of cabinets bearing the mark. Applicant is not entitled to appropriate the phrase to itself and thereby attempt to prevent competitors from using it to promote the sale of their own products. *In re Melville Corp.*, 228 USPQ 970, 972 (TTAB 1986) (describing the phrase BRAND NAMES FOR LESS as "a highly descriptive and informative slogan [that] should remain available for other persons or firms to use to describe the nature of their competitive services"). It has been noted that "as a matter of competitive policy, it should be close to impossible for one competitor to achieve exclusive rights" in common phrases. 1 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 7:23 (5th ed. Sept. 2019).

Applicant argues that "the specimens of record unambiguously demonstrate that the Applicant uses its mark as a trademark."<sup>10</sup> Applicant points to the original specimens submitted with the application which Applicant says show the mark

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<sup>10</sup> Applicant's Br., p. 4, 7 TTABVUE 5.

[E]mblazoned across the product packaging of its cabinetry. The Applicant's mark is designated as a trademark, as is evidenced by the TM after the word YOU. Thus, the Applicant clearly uses its Mark in a trademark fashion and consumers encountering the Mark could see it as functioning as a trademark.<sup>11</sup>



Applicant also points to its website arguing that “Applicant’s mark is set off from any other words in the nature of an advertisement and is directly associated with the goods, with different typeface for the Mark, along with a different size, offset nature, and use of the trademark symbol thereafter.”<sup>13</sup> The website excerpt appears again below.

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

<sup>12</sup> Application of November 15, 2017.

<sup>13</sup> Applicant’s Br., p. 5, 7 TTABVUE 6.



We do not find that the original specimens or Applicant’s website establish that the proposed mark would be perceived by the relevant public as a source indicator. Submission of an otherwise acceptable specimen, such as a label, bearing the proposed mark will not obviate the refusal; the mere fact that the matter appears on a technically good specimen does not mean that it would be perceived as a mark. *See D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d 1710, 1716 (TTAB 2016) (finding that the phrase I ♥ DC “does not create the commercial impression of a source indicator, even when displayed on a hangtag or label”). Moreover, the presence of the letters “TM” on the label and website cannot transform an otherwise unregistrable designation into a registrable mark. *In re Remington Prods. Inc.*, 3 USPQ2d 1714, 1715 (TTAB 1987); *In re Anchor Hocking Corp.*, 223 USPQ 85, 88 (TTAB 1984); *In re Minnetonka, Inc.*, 212 USPQ 772, 779 n.12 (TTAB 1981).

<sup>14</sup> Office action of March 3, 2018, p. 19.

Simply put, Applicant's intent that CABINETS ASSEMBLED BY YOU function as a trademark does not make it so. "Mere intent that a term function as a trademark is not enough in and of itself, any more than attachment of the trademark symbol would be, to make a term a trademark." *In re Remington Prods. Inc.*, 3 USPQ2d at 1715; *see also Apollo Med. Extrusion Techs., Inc. v. Med. Extrusion Techs., Inc.*, 123 USPQ2d 1844, 1855 (TTAB 2017); *In re Vertex Grp. LLC*, 89 USPQ2d 1694, 1701 (TTAB 2009) ("[M]ere intent that a word, name, symbol or device function as a trademark or service mark is not enough in and of itself."); *In re Morganroth*, 208 USPQ 284, 287 (TTAB 1980) ("Wishing does not make a trademark or service mark be."). If, as here, the evidence shows that the public would not perceive the proposed mark as serving to indicate the source of the identified goods, it does not function as a mark and may not be registered regardless of the manner of use depicted on the specimens.

Applicant also seeks to rebut the Examining Attorney's evidence on the grounds that many of the Internet excerpts are irrelevant because they don't include the word CABINET, and they "show the words [ASSEMBLED BY YOU] in the greater context of a sentence, but not as a slogan."<sup>15</sup> This argument is unpersuasive. The phrase ASSEMBLED BY YOU would be perceived simply as modifying the particular item to be assembled that precedes it, in this case cabinets. Moreover, the fact that ASSEMBLED BY YOU is used by others in a sentence describing ready-to-assemble cabinets and furniture establishes that the phrase cannot serve as an indicator of the

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<sup>15</sup> Applicant's Br., p. 10, 7 TTABVUE 11.

source of Applicant's cabinets. Here, the primary purpose of CABINETS ASSEMBLED BY YOU, as shown by the evidence of use by the public, is to convey information about the products being sold, nothing more.

Finally, Applicant argues that since other informational phrases, such as "FOR TOTS" for use in connection with children's educational services, have registered, its mark should be entitled to registration as well. "While we recognize that 'consistency is highly desirable,' consistency in examination is not itself a substantive rule of trademark law, and a desire for consistency with the decisions of prior examining attorneys must yield to proper determinations under the Trademark Act and rules." *In re Am. Furniture Warehouse CO*, 126 USPQ2d 1400, 1407 (TTAB 2018) (quoting *In re Omega SA*, 494 F.3d 1362, 83 USPQ2d 1541, 1544 (Fed. Cir. 2007)). We "must assess each mark on its own facts and record." *Id.* The fact that the USPTO registered "FOR TOTS" for use in connection with unrelated services does not entitle Applicant to register CABINETS ASSEMBLED BY YOU for "Cabinets being furniture for residential and commercial properties."

In sum, we find that CABINETS ASSEMBLED BY YOU would not be perceived as a trademark to identify and distinguish Applicant's cabinets from the like goods of others.

**Decision:** The refusal to register Applicant's mark CABINETS ASSEMBLED BY YOU on the ground that it fails to function as a trademark under Sections 1, 2 and 45 of the Trademark Act is affirmed.