

This Opinion Is Not A
Precedent Of The TTAB

Mailed: August 18, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

Lego Juris A/S

v.

Once Kids LLC
—

Opposition No. 91228548
—

Laura Popp-Rosenberg of Fross Zelnick Lehrman & Zissu, P.C.
for Lego Juris A/S.

Darin M. Klemchuk of Klemchuk LLP
for Once Kids LLC.
—

Before Kuhlke, Greenbaum and Dunn,
Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Once Kids LLC, seeks registration on the Principal Register of the proposed mark ECO-BRICKS in standard characters for “Toy building blocks,” in International Class 28.¹

¹ Serial No. 86867392, filed January 6, 2016, based on an allegation of first use on August 27, 2013 and first use in commerce on November 7, 2015 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

Opposer, Lego Juris A/S, has opposed registration of Applicant's proposed mark on the ground that it is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1) and has not acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f).

By its answer, Applicant generally denies the salient allegations and pleaded the affirmative defense of acquired distinctiveness in the alternative.² See *Colonial Arms Corp. v. Trulock Firearms Inc.*, 5 USPQ2d 1678, 1680 n.5 (TTAB 1987). See also *Perma Ceram Enters. Inc. v. Preco Indus. Ltd.*, 23 USPQ2d 1134, 1139 n.13 (TTAB 1992) (“Although the application did not include a Section 2(f) claim, the defense of acquired distinctiveness clearly could have been raised.”) (citing *Colonial Arms, supra*).

Opposer, as plaintiff in this proceeding, must prove its entitlement to a statutory cause of action and its claims by a preponderance of the evidence. *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998); *Cerveceria Centroamericana, S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989).

² Ans., 12 TTABVUE. Applicant also pleaded “affirmative defenses” that are merely amplifications of its denials, not true affirmative defenses, or not sufficiently pleaded. See February 2, 2021 Board Order, 75 TTABVUE.

I. RECORD

The record includes the pleadings and, by operation of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), the file of the application subject to the notice of opposition. In addition the record includes:

- Opposer's Trial Declaration of Lauren O'Hara, Director of Sustainability for Lego System's Inc., and exhibits;³
- Opposer's Notices of Reliance on: discovery materials including the Deposition Transcript of Elizabeth Grimes, Applicant's Co-founder, taken pursuant to Fed. R. Civ. P. 30(b)(6);⁴ printouts of pages from Opposer's, Applicant's and third-parties' websites;⁵ printouts from the USPTO's Trademark Status & Document Retrieval (TSDR) database of Opposer's and third parties' registrations;⁶
- Applicant's Trial Declaration of Emmy Grimes (Elizabeth Grimes, Applicant's Co-founder), and exhibits;⁷
- Applicant's Notices of Reliance on: discovery materials, including the Deposition Transcript of Lauren O'Hara taken pursuant to Fed. R. Civ. P. 30(b)(6);⁸ printouts from the USPTO's TSDR database of Opposer's

³ 81 TTABVUE.

⁴ 82 TTABVUE.

⁵ 83 TTABVUE.

⁶ 84 TTABVUE.

⁷ 88 TTABVUE.

⁸ 85 TTABVUE.

registrations and applications;⁹ printouts of pages from various online articles and websites;¹⁰ and

- Opposer's rebuttal notice of reliance on excerpts from the discovery depositions of Lauren O'Hara and Emmy Grimes, and Opposer's responses to Interrogatories under Trademark Rule 2.120(k)(5).¹¹

II. ENTITLEMENT TO A STATUTORY CAUSE OF ACTION

Opposer's entitlement to a statutory cause of action is a requirement that must be proven by the plaintiff in every inter partes case. *See Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, *3 (Fed. Cir. 2020) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2067 n.4 (2014)). A party in the position of plaintiff may oppose registration of a mark where such opposition is within the zone of interests protected by the statute, 15 U.S.C. § 1063, and the party has a reasonable belief in damage that is proximately caused by the prospective registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, *6-7 (Fed. Cir. 2020).

Where, as here, descriptiveness of the proposed mark is in issue, plaintiff may prove its entitlement to a statutory cause of action by alleging that it is engaged in the sale of the same or related products or services (or that the product or service in question is within the normal expansion of plaintiff's business) and that the plaintiff

⁹ 86 TTABVUE.

¹⁰ 87 TTABVUE.

¹¹ 90 TTABVUE (public); 89 TTABVUE (confidential).

has an interest in using the term descriptively in its business. *University of Kentucky v. 40-0, LLC*, 2021 USPQ2d 253, at *13, *15 (TTAB 2021) (opposer demonstrated entitlement to a statutory cause of action by establishing that it has a present or prospective interest in using the term 40-0); *Poly-America, L.P. v. Illinois Tool Works Inc.*, 124 USPQ2d 1508, 1512 (TTAB 2017) (standing established by plaintiff showing that it is engaged in the manufacture or sale of the same or related goods and that the product in question is one which could be produced in the normal expansion of plaintiff's business); *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1487 (TTAB 2017) (opposer's status as competitor establishes standing to oppose registration of product configuration); *Kistner Concrete Products Inc. v. Contech Arch Technologies, Inc.*, 97 USPQ2d 1912, 1918 (TTAB 2011) (competitor in industry has a real interest in cancelling registration for product configuration); *Kellogg Co. v. General Mills Inc.*, 82 USPQ2d 1766, 1767 (TTAB 2007) (commercial interest in allegedly descriptive term).

Opposer has shown that it sells “toy construction blocks” and it has an interest in using the terms eco and bricks separately and together to describe its toy construction bricks.¹² We are not persuaded by Applicant's argument that Opposer has not shown a “real interest” because it “does not compete with Applicant [and] ... because of the specific nature of Applicant's products, Applicant's actual competitors are companies

¹² Opp. brief, 91 TTABVUE 22; O'Hara Decl. ¶¶ 1-3 and 5, 81 TTABVUE 2-3.

like Melissa and Doug who offer wooden products.”¹³ Clearly, both parties compete in the toy building block market.

We are further unpersuaded by Applicant’s argument that Opposer has no reasonable belief in damage because it “currently has no need to use the term ‘ECO’ to describe any of its products” and “registration of Applicant’s Mark will not preclude Lego or any third parties from descriptive or fair use of either term to describe their products.”¹⁴ It is not necessary to show a current need or use of a descriptive term, it is sufficient that the term is descriptive of the goods and Opposer has shown a demonstrable interest in using the term descriptively. *De Walt, Inc. v. Magna Power Tool Corp.*, 48 CCPA 909, 289 F.2d 656, 129 USPQ 275, 280 (1961) (“[D]amage to an opposer or injury to a petitioner for cancellation ... will be presumed or inferred when the mark sought to be registered is descriptive of the goods and the opposer or petitioner is one who has a sufficient interest in using the descriptive term in its business.”); *Nature’s Way Products Inc. v. Nature’s Herbs Inc.*, 9 U.S.P.Q.2d 2077, 2080 (TTAB 1989) (“In the present case, petitioner has demonstrated its standing by showing that it manufactures and sells products similar to those recited in respondent’s registration and that, being a competitor of respondent, it is in a position to use the designation sought to be cancelled in a descriptive manner.”) As shown below, ECO connotes something that is environmentally friendly which includes sustainability. Opposer has shown its interest in using the term through its

¹³ App. Brief, 92 TTABVUE 14.

¹⁴ App. Brief, 92 TTABVUE 15, 16.

marketing touting their efforts to shift to a sustainable product (“LEGO Group to invest up to US\$400 million over three years to accelerate sustainability efforts” and “The LEGO Group is working to make its packaging sustainable by 2025”), O’Hara Decl., Exh. LJ11, 81 TTABVUE 94-104 (www.lego.com)). As Ms. O’Hara testifies:

[T]he term “eco” would be appropriately used to describe the LEGO Group’s products made from recyclable sugarcane plastic and any other environmentally-friendly products it may produce in the future.

Moreover, since the LEGO Group refers to many of its building pieces as bricks, use of the combined term “eco-brick” would also be appropriate for these pieces. ...

Because the LEGO Group has committed to manufacturing its products from environmentally-friendly, sustainable resources and materials, Opposer has an interest in making sure that the term “eco” and the term “eco-brick” remains free for it and others to use in connection with toy building blocks.

O’Hara Decl. ¶¶ 27, 28, 29, 81 TTABVUE 9-10.

In addition, Opposer has shown its use of the term ECO in connection with its products as an indication that they are environmentally friendly (LEGO Red/Blue Brick Print Eco Heritage Backpack, featuring “durable recycled fabric” and “recycled PET main body material”, O’Hara Decl. Exh. LJ9, 81 TTABVUE 73-76), and its marketing that includes a LEGO IDEAS program where people may submit proposals for new LEGO construction set designs, frequently featuring environmentally-friendly designs as referenced in the name that includes the prefix ECO (ECO-SKYSCRAPERS (“These Eco-skyscrapers are an example of an emerging trend in architecture. Create environmentally friendly structures that reduce the environmental impact of new developments”), ECO-ROBOT (“The Eco-Robot is just

as it sounds, a programmable robot that picks up garbage to help clean nature”), ECO-FRIENDLY DHABA (“This is a picture of an eco-friendly dhaba ... The pictured dhaba has got solar panels on the roof, but also the employees are ecologically conscious”), ECO-FUELS REFINERY (“Where do the Octan gas stations get their eco fuels from? Environmentally friendly fuels are refined here every day”), O’Hara Decl. ¶ 26, Exh. LJ10, 81 TTABVUE 9, 77-93).

Finally, the Board determined on summary judgment based on similar evidence that “Opposer sells, inter alia, related, if not identical, ‘toy construction bricks’ and indicates that the term brick ‘is also extensively used by competitors of [Opposer] and third parties to describe interlocking toy construction pieces, and the term has become commonplace in the industry.” *See DeWalt, Inc. v. Magna Power Tool Corp.*, 289 F.2d 656, 129 USPQ 275, 280 (CCPA 1961) (Standing, now entitlement, “will be presumed or inferred when ... the opposer or petitioner is one who has a sufficient interest in using the descriptive term in its business.”)

Opposer has established its entitlement to a statutory cause of action to oppose registration of Applicant’s proposed mark.

III. Mere descriptiveness

In the absence of acquired distinctiveness, Section 2(e)(1) of the Trademark Act prohibits registration of a term on the Principal Register that, when used in connection with the goods or services identified in the registration, is merely descriptive of them. “A mark is merely descriptive if it immediately conveys information concerning a feature, quality, or characteristic of the goods or services for which registration is sought.” *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906

F.3d 965, 128 USPQ2d 1370, 1373 (Fed. Cir. 2018) (quoting *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017)). A mark is suggestive, and not merely descriptive, if it requires imagination, thought, and perception on the part of someone who knows what the goods or services are to reach a conclusion about their nature from the mark. *See, e.g., In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1513 (TTAB 2016). Suggestive marks, unlike merely descriptive terms, are registrable on the Principal Register without proof of acquired distinctiveness. *See Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 71 USPQ2d 1173, 1180 (Fed. Cir. 2004).

We “must consider the mark as a whole and do so **in the context of the goods or services at issue.**” *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (emphasis added); *In re Calphalon Corp.*, 122 USPQ2d 1153, 1162 (TTAB 2017). “Whether consumers could guess what the product is from consideration of the mark alone is not the test.” *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985). Rather, “the question is whether someone who knows what the goods and services are will understand the mark to convey information about them.” *DuoProSS*, 103 USPQ2d at 1757 (quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002)). It is not necessary, in order to find a term merely descriptive, that the term describe each feature of the goods or services, only that it describe a single, ingredient, quality, characteristic, function, feature, purpose or use of the goods or services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

“Evidence of the public’s understanding of [a] term ... may be obtained from any competent source, such as purchaser testimony, consumer surveys, listing in dictionaries, trade journals, newspapers and other publications,” *Real Foods*, 128 USPQ2d at 1374 (quoting *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1046 (Fed. Cir. 2018)), as well as websites, “labels, packages, or in advertising material directed to the goods [or services].” *N.C. Lottery*, 123 USPQ2d at 1710 (quoting *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978)); *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1565 (Fed. Cir. 2001).

The term BRICK is defined as “a block used for building walls and other structures.”¹⁵ It is used in the toy industry, including by Applicant and Opposer, to refer to certain toy construction blocks. A few examples are shown below:


The quick, easy way to buy from Japan.

Shop any store, we can buy-and-ship the the items to you.

[Try the NEW White Rabbit Express Buying Service](#) [Package Forwarding Service](#)

Posts Tagged 'wooden toy bricks'
[Mokulock Wooden Bricks](#)
Sunday, February 3rd, 2013

Japanese design firm New Tech Shinsei has produced [Mokulock](#), a limited edition of beautiful wooden interlocking toy bricks, handmade from maple and birch that are compatible with the most common plastic toy bricks.



The carefully crafted bricks are an excellent opportunity for children to incorporate organic materials into their play. Mokulock’s intention is to provide children who grow up in an urban and rather sterile environment with the possibility to connect to and understand nature and ecology in a playful manner. 16

¹⁵ Opp. Notice of Reliance, Exh. LJ50, 83 TTABVUE 243 (Macmillan Dictionary www.macmillandictionary.com retrieved October 16, 2020).

¹⁶ *Id.*, Exh. LJ29, 83 TTABVUE 58 (<https://cms.whiterabbitexpress.com>).

Toys & Games › Building Toys › Building Sets



1500

Tingingbaby 1500 Pcs Building Bricks for Kids, 1500 Pieces Classical Building Blocks for Children with Doors and Windows, Compatible with All Major Brands for Ages 3 4 5 6 7 8 9 10 Year Old Boys Girls

Visit the [GARUNK Store](#)
12 ratings

17

Toys & Games › Building Toys › Building Sets



Strictly Briks Classic Bricks 96 Piece 2x4 Blue Building Brick Creative Play Set - 100% Compatible with All Major Brick Brands

Visit the [Strictly Briks Store](#)
248 ratings

18

¹⁷ *Id.*, Exh. LJ30, 83 TTABVUE 60 (www.amazon.com).

¹⁸ *Id.*, Exh. LJ31, 83 TTABVUE 64 (www.amazon.com).



1000 Piece Building Bricks Set- 10 Classic Colors Guaranteed Tight Fit, Compatible with All Major...

677

\$27⁹⁹

Save 5% with coupon

FREE Delivery Fri, Oct 16

More Buying Choices

\$23.42 (3 used & new offers)

Ages: 3 years and up



Playlearn Foam Brick Building Blocks for Kids - 25 Pack - Actual Brick Size, Builders Set for Construction and Stacking

97

\$84⁹⁹

FREE Delivery for Prime members



PANLOS STEM Robot Educational Learning Building Bricks Toy Cars Set Vehicles Gifts for Kids Boys and Girls...

\$29⁹⁹

Save 20% with coupon

FREE Delivery Sat, Oct 17

Ages: 6 months and up



Mini Materials - Mini Red Bricks

34

\$27⁹⁵



Room Copenhagen 8 Lego Brick Box, Bright Yellow

239

\$34⁴³



Lekebaby Big Building Bricks 220 Pieces Classic Large Building Blocks Set Compatible with All Major...

1

19

¹⁹ *Id.*, Exh. LJ32 , 83 TTABVUE 62 (www.amazon.com).



Best-Buy Jumbo Building Bricks - Starter Set

\$39.99

Qty

1

Add to Cart

Add to Registry

Add to Shopping List

20



Click N' Play

Click N' Play 1000 piece Value Pack of Building Bricks

★★★★☆ (4.3) [34 reviews](#)

\$18.96 ~~\$24.99~~

Add to cart

Shipping, arrives **Wed, Sep 22** to **New York, 10011**

Sold and shipped by **Walmart.com**

Free 90-Day returns [Details](#)

Add



Add to

21

Opposer uses the term brick “to identify the toy products it offers under the LEGO mark.”²² It appears in Opposer’s marketing materials and on its website offering

²⁰ *Id.*, Exh. LJ35, 83 TTABVUE 81 (www.lakeshorelearning.com).

²¹ *Id.*, Exh. LJ36, 83 TTABVUE 83 (www.walmart.com).

²² O’Hara Decl. ¶ 10, 81 TTABVUE 4.

“brick sets” and “brick boxes” and allowing consumers to report “missing bricks,” seek help for “broken bricks” and to “buy replacement bricks.”²³

The record also includes over 65 registrations with marks that include the word BRICK for toy products and in most cases the word BRICK is disclaimed. A few examples are set forth below:²⁴

Registration Number	Mark	Goods
6474505	GAME OF BRICKS (BRICKS disclaimed)	Toy accessories for building block sets
6415043	ARTORBRICKS (BRICKS disclaimed)	Toy building blocks
6411437	GENERAL JIM’S TOYS AND BRICKS (and design) (TOYS & BRICKS disclaimed)	Toy building bricks and toy building blocks
6194091	PIX BRIX (and design) (BRICKS disclaimed)	Toy building and construction blocks and

²³ *Id.*, Exh. LJ3, 81 TTABVUE 24-30.

²⁴ Opp. Notice of Reliance, 84 TTABVUE 41-282. We do not consider the proffered applications. *Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 109 USPQ2d 1949, 1956 n.9 (TTAB 2014) (“The applications are not evidence of anything except that they were filed.”), *vacated and remanded on other grounds, Princeton Vanguard, LLC v. Frito-Lay North America, Inc.*, 786 F.3d 960, 114 USPQ2d 1827 (Fed. Cir. 2015), *original decision aff’d, Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 124 USPQ2d 1184 (TTAB 2017), *dismissed without prejudice sub nom. Snyder’s-Lance, Inc. v. Frito-Lay North America, Inc.*, 414 F. Supp. 3d 822, 2019 USPQ2d 401574 (W.D.N.C. 2019), *reversed and remanded on other grounds*, 991 F.3d 512 (4th Cir. 2021); *Kemi Organics, LLC v. Gupta*, 126 USPQ2d 1601, 1606 (TTAB 2018) (abandoned application only probative to show it had been filed). Applicant also submitted several third-party registrations with marks that include the word “brick,” many of which are compound or hyphenated words where a disclaimer would not be required, others include disclaimers of the word “BRICK.” App. Not. of Reliance Exhs., OK63-81, 86 TTABVUE 249-330.

Registration Number	Mark	Goods
		interlocking toy building and construction blocks
6298447	DREAMBRICKS	Toy building blocks capable of interconnection
5989410	CITIZEN BRICK	Toy construction brick sets
5866138	YEABRICKS (BRICKS disclaimed)	Toy building blocks capable of interconnection

The term ECO is a prefix defined as “relating to the environment: used with some nouns and adjectives”²⁵ and “relating to the environment”²⁶ and “ecological or environmental, not harmful to the environment”²⁷ According to Ms. O’Hara:²⁸

“Eco” is a term commonly used by companies, including toy companies – frequently as a prefix in hyphenated form – to mean “ecological,” “environmentally-friendly,” “made from renewable or sustainable resources” and the like.

²⁵ Opp. Notice of Reliance, Exh. LJ54, 83 TTABVUE 257 (MacMillan Dictionary retrieved October 19, 2020 www.macmillandictionary.com).

²⁶ *Id.*, Exh. LJ55, 83 TTABVUE 259 (Longman Dictionary of Contemporary English retrieved October 13, 2020 www.idoceanline.com).

²⁷ *Id.*, Exh. LJ57, 83 TTABVUE 263 (Dictionary.Com retrieved October 13, 2020 www.dictionary.com).

²⁸ O’Hara Decl. ¶ 24, 81 TTABVUE 8.

A few examples of third-party uses and online articles showing the term “eco” to connote environmentally friendly in the context of toys are set out below:

A Quick Guide to **Eco Toys** You Can Choose For Your Kids ... This has also been corroborated by a New York Times [sic] published on the importance of eco-friendly products. ... Not to worry, these harmful playthings can be discarded and replaced with eco-friendly ones, and we’ll be showing you how soon enough.²⁹

The Best **Eco-Friendly**, Natural Green Toys For Kids ... Eco friendly toys are a natural extension of a society that is seeking to live in a healthier, more sustainable manner. ... With eco-friendly toys, we can provide children with toys that are made from safe, recycled, materials, and offer an opportunity to teach kids about our environment and the ways we affect it, both positive and negative.³⁰

and

Eco-Friendly Beach Toys for Sustainable Fun in the Sand this Summer! ... That’s where eco-friendly toys come into the picture. Sure, it may take a little more planning ahead to make sure you’ve got your **eco beach toys** prepared for the summer fun ahead, but these sustainable beach and water toys will last much longer than one summer in the sand!³¹

As discussed above in the entitlement section, Opposer and Opposer’s fans providing proposals for possible construction set designs also use “eco” to refer to something being ecological or environmentally-friendly. A few examples of an advertisement and the design proposals are shown below:

²⁹ *Id.*, Exh. LJ38, 83 TTABVUE 94-96 (The Environmental Magazine emagazine.com).

³⁰ *Id.*, Exh. LJ41, 83 TTABVUE 118-132 (Fractus Learning www.fractuslearning.com).

³¹ *Id.*, Exh. LJ4, 83 TTABVUE 152-169 (The Zero Waste Memoirs <https://zerowastememoirs.com>).

LEGO® Red/Blue Brick Print Eco
Heritage Backpack

32

CONTEST ENTRY

ARCHITECTURE: ECO-SKYSCRAPERS



33

³² O'Hara Decl., Exh. LJ9, 81 TTABVUE 74.

³³ *Id.*, Exh. LJ10, 81 TTABVUE 78.

PRODUCT IDEA | May 04, 2021

ECO-FUELS REFINERY



34

Opposer also submitted printouts of online articles referencing Opposer's move to incorporate sustainability into its products, and in some cases, the articles use the term "eco" to indicate environmentally friendly or "brick" to indicate a toy block. A two examples are set out below (**emphasis** added):

Lego unveils sustainable bricks made from sugarcane as brand continues **eco overhaul**;³⁵ and

Lego Is Making Sustainable **Eco-Friendly** Blocks Made of Sugar Cane Bioplastic ... LEGO introduced a new line of building block toys made from plant-based plastic that is sustainable and biodegradable ... To usher in the new era

³⁴ *Id.*, Exh. LJ10, 81 TTABVUE 81.

³⁵ *Id.*, Exh. LJ18, 83 TTABVUE 20 (The Drum <https://www.thedrum.com>).


of sustainable LEGO toys, the debut box will contain a “botanical element,” such as trees and leaves, LEGO added.³⁶

The record also has several registrations with marks that include the term ECO for toy products registered on the Supplemental Register or on the Principal Register where ECO is often disclaimed, or part of a unitary phrase or compound or hyphenated word where a disclaimer would not be required. A few examples are set forth below:³⁷

Registration Number	Mark	Goods
6474281	ECOJOUR	Manipulative blocks for displaying patterns and groupings
6415412	THREE LITTLE TWIGS AN ECO CONSCIOUS COMPANY (AN ECO CONSCIOUS COMPANY disclaimed)	Toy building blocks
6141314	ECO WOOD 2.0	Various types of toys
6099132	CULTURALLY ANCHORED ECO-GAME	Educational board games
6022292	ECO FANTASY (and design)	Children’s multiple activity table
5751202	MIND SPARKS ECO- PUZZLE (ECO-PUZZLE disclaimed)	Educational poster, puzzle and printed educational booklet about the ecosystem, sold as a unit
5857587	BE AN ECO PAL	Stuffed and plush toys

³⁶ *Id.*, Exh. LJ19, 83 TTABVUE 23-24 (Newsweek www.newsweek.com).

³⁷ *Opp. Notice of Reliance*, 84 TTABVUE 283-414. We do not consider the proffered applications. Applicant also submitted several third-party registrations for marks that include the term ECO for toys or sporting goods many of which are compounds or hyphenated words where a disclaimer would not be required and in some cases ECO is disclaimed. *App. Notice of reliance*, Exhs. OK08-62, 86 TTABVUE 37-248.

Registration Number	Mark	Goods
5850181	ECO PAL (ECO disclaimed)	Stuffed and plush toys
5821109	 (EWA ECO-WOOD-ART)	Toy building blocks
5562751	MODERN ECO (ECO disclaimed)	Children's multiple activity toys
5654291	ECO POWER (and design ECO disclaimed)	Toy vehicles and accessories therefor
5405409	ECO WALKER (ECO disclaimed)	Model toy vehicles
5454067	ECO SANCTUARY	Plush animals
4994029	ECO BUILDER (and design BUILDER disclaimed)	Puzzle games; puzzles; stuffed toys; toy models; toy vehicles
4893771	ECO PLAYHOUSE (Supplemental Register)	Play houses
4593785	ECO WARRIORS ZEENIE	Dolls
77967970	ECOWEIGHT (Supplemental Register)	Sporting equipment and toy airplanes and cars

This evidence serves to show the tendency to find ECO merely descriptive in connection with toys and further corroborates the dictionary definition of ECO in connection with toys.

ECO is commonly used to denote a feature of the product namely that it is environmentally friendly. BRICKS describes the characteristic of the product as a synonym in the toy industry for a toy block. Together these terms retain their descriptive significance. Their combination does not result in a separate distinctive meaning through, for example, incongruity or double meanings. Moreover, this record establishes ECO-BRICKS as highly descriptive of “toy construction blocks.”

Applicant’s arguments and evidence do not persuade us of a different result. Opposer did not improperly dissect the proposed mark, in fact, it is appropriate and often necessary to analyze each portion separately in considering the designation in its entirety. *DuoProSS*, 103 USPQ2d at 1758. Moreover, even if Applicant is the first to use this particular combination of merely descriptive terms for “toy construction blocks,” that does not justify registration if the only significance conveyed by the term is merely descriptive. *See Fat Boys*, 118 USPQ2d at 1514. In addition, descriptiveness must be determined in relation to the goods or services for which registration is sought. *In re Omniome, Inc.*, 2020 USPQ2d 3222, at *10 (TTAB 2019) (citing *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979)). Therefore, the fact that a term may have a different meaning(s) in a different context is not controlling.³⁸ *Id.*

³⁸ Applicant’s observations and speculations about Opposer’s marks that include the word BRICKS and Opposer’s possible motivation to bring this opposition are not relevant to the issue of the descriptiveness of Applicant’s ECO-BRICKS.

IV. Acquired Distinctiveness

Pursuant to Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), matter that is merely descriptive under Section 2(e)(1) may nonetheless be registered on the Principal Register if it “has become distinctive of the applicant’s goods in commerce.” Thus, Applicant may register its proposed mark on the Principal Register if Applicant proves that the merely descriptive matter has acquired distinctiveness (also known as “secondary meaning”) as used on Applicant’s goods in commerce. *See Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1728-30 (Fed. Cir. 2012); *Apollo Med. Extrusion Techs., Inc. v. Med. Extrusion Techs., Inc.*, 123 USPQ2d 1844, 1848 (TTAB 2017).

We generally understand acquired distinctiveness to mean an acquired “mental association in buyers’ minds between the alleged mark and a single source of the product.” *Apollo Med. Extrusion Techs.*, 123 USPQ2d at 1848 (quoting 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 15:5 (4th ed., June 2017 Update)). An applicant seeking registration of a mark under Section 2(f) bears the ultimate burden of establishing acquired distinctiveness. *See In re Becton, Dickinson & Co.*, 675 F.3d 1368, 102 USPQ2d 1372, 1377 (Fed. Cir. 2012); *Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005-06 (Fed. Cir. 1988). Applicant’s burden increases with the level of descriptiveness. *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005). *See also In re Bos. Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999) (“[C]onsidering the highly descriptive nature of the proposed mark, [Applicant] has

not met its burden to show that the proposed mark has acquired secondary meaning.”).

Because we have found that the term “ECO-BRICKS” is highly descriptive of Applicant’s goods, Applicant’s burden of establishing acquired distinctiveness under Section 2(f) is commensurately high. *See Steelbuilding.com*, 75 USPQ2d at 1424; *In re Bongrain Int’l Corp.*, 894 F.2d 1316, 13 USPQ2d 1727, 1729 (Fed. Cir. 1990); *In re Greenliant Sys. Ltd.*, 97 USPQ2d, 1078, 1085 (TTAB 2010).

To establish acquired distinctiveness, Applicant must demonstrate that relevant consumers perceive the proposed mark as identifying the producer or source of the product. *See Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 54 USPQ2d 1065, 1068 (2000) (acquired distinctiveness exists “when, in the minds of the public, the primary significance of a [proposed mark] is to identify the source of the product rather than the product itself”) (citation and internal quotation marks omitted); *Stuart Spector Designs Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 1554 (TTAB 2009) (“An applicant must show that the primary significance of the product configuration in the minds of consumers is not the product but the source of that product in order to establish acquired distinctiveness.”).

Applicants may show acquired distinctiveness by direct or circumstantial evidence. *Schlafly v. Saint Louis Brewery, LLC*, 909 F.3d 420, 128 USPQ2d 1739, 1743 (Fed. Cir. 2018) (“The Board and courts have recognized that both direct and circumstantial evidence may show secondary meaning.”) (citation omitted); *In re Ennco Display Sys.*, 56 USPQ2d 1279, 1283 (TTAB 2000). Direct evidence includes

testimony, declarations or surveys of consumers as to their state of mind. *Ennco Display Sys.*, 56 USPQ2d at 1283. Circumstantial evidence, on the other hand, is evidence from which we may infer a consumer association, such as years of use, prior registrations, extensive sales and advertising, unsolicited media coverage, and any similar evidence showing wide exposure of the mark to consumers. *Id.*; *see also Tone Bros. v. Sysco Corp.*, 28 F.3d 1192, 31 USPQ2d 1321 (Fed. Cir. 1994) (listing, as examples of circumstantial evidence, advertising, sales figures, and intentional copying by competitors).

In particular, the Federal Circuit set out factors to consider in assessing whether a mark has acquired distinctiveness, stating as follows:

[T]he considerations to be assessed in determining whether a mark has acquired secondary meaning can be described by the following six factors: (1) association of the trade[mark] with a particular source by actual purchasers (typically measured by customer surveys); (2) length, degree, and exclusivity of use; (3) amount and manner of advertising; (4) amount of sales and number of customers; (5) intentional copying; and (6) unsolicited media coverage of the product embodying the mark.

Converse, Inc. v. Int'l Trade Comm'n, 909 F.3d 1110, 128 USPQ2d 1538, 1546 (Fed. Cir. 2018). *See also In re SnoWizard, Inc.*, 129 USPQ2d 1001, 1004-05 (TTAB 2018). On this list, no single factor is determinative and “[a]ll six factors are to be weighed together in determining the existence of secondary meaning.” *In re Guaranteed Rate, Inc.*, 2020 USPQ2d 10869, at *3 (TTAB 2020) (quoting *Converse*, 128 USPQ2d at 1546); *In re Tires, Tires, Tires Inc.*, 94 USPQ2d 1153, 1157 (TTAB 2009).

1. Association of the trademark with a particular source by actual purchasers (typically measured by customer surveys)

There is no testimony or other evidence by actual purchasers, nor is there a consumer survey to show purchasers associate ECO-BRICKS with a particular source.

2. Length, degree, and exclusivity of use

Applicant submitted evidence showing its toy blocks have been continuously available for purchase since 2015 with the first sale either on November 7, 2015 or 2016 (compare “Once Kids began development of ECO-BRICKS in 2013, with the first sale of the products in commerce taking place at least as early as November 7, 2015” with “Since the first sale in 2016, ECO-BRICKS has grown substantially” Grimes Decl. ¶¶ 6 and 9, 88 TTABVUE 4-5). To show it is substantially exclusive, Applicant relies on statements made by Ms. O’Hara, Opposer’s 30(b)(6) witness, during the discovery deposition that she had never heard of any toy manufacturer using ECO-BRICKS.³⁹ The fact that Opposer does not know of any other relevant use of the combined term, while relevant, is not definitive. It is Applicant’s burden to show continuous and substantially exclusive use. Taken as a whole, however, the record supports substantially exclusive continuous use of ECO-BRICKS as a combined term.

³⁹ App. brief n. 74, 92 TTABVUE 28 (citing App. Notice of Reliance OK02, 81 TTABVUE 61-62 “Q. Are you aware of any companies anywhere in the world ever in the history of mankind that has used the phrase ‘eco bricks’ together? A. I don’t know. Q. Have you ever heard of anybody using ‘eco bricks’ other than Once Kids? A. To my knowledge, the word ‘eco’ and ‘bricks’ have been used, but not ‘eco’ and ‘bricks’ attached. Q. Okay. So your testimony today is you’ve never heard of anybody ever using the combination ‘eco bricks’? A. Not to my knowledge.”)

Nonetheless, given the highly descriptive nature of ECO-BRICKS this is not sufficient to establish acquired distinctiveness.

3. Amount and manner of advertising

Applicant did not submit evidence of advertising other than its store placement and the trade shows it attends. Specifically, Applicant's ECO-BRICKS toy blocks "have been promoted by [Applicant's] attendance and participation in various international, regional, and local trade shows including the New York Toy Fair (2016-the present) and the Dallas Toy Preview ... Additionally, [Applicant] will be participating in the largest Toy Show in the world, the Spielwarenmesse, in Germany in February 2022, where it will showcase ECO-BRICKS, and will attend the upcoming New York Toy Fair, where we have additional mass appointments."⁴⁰ In addition, Applicant asserts the ECO-BRICKS toys have been featured on nationally syndicated television programs including Good Morning America, Fox & Friends, and The Talk.⁴¹ However, based on the exhibits it is not clear how or at all ECO-BRICKS was visible on these programs. The images are set out below:⁴²

⁴⁰ Grimes Decl. ¶ 12, 88 TTABVUE 6.

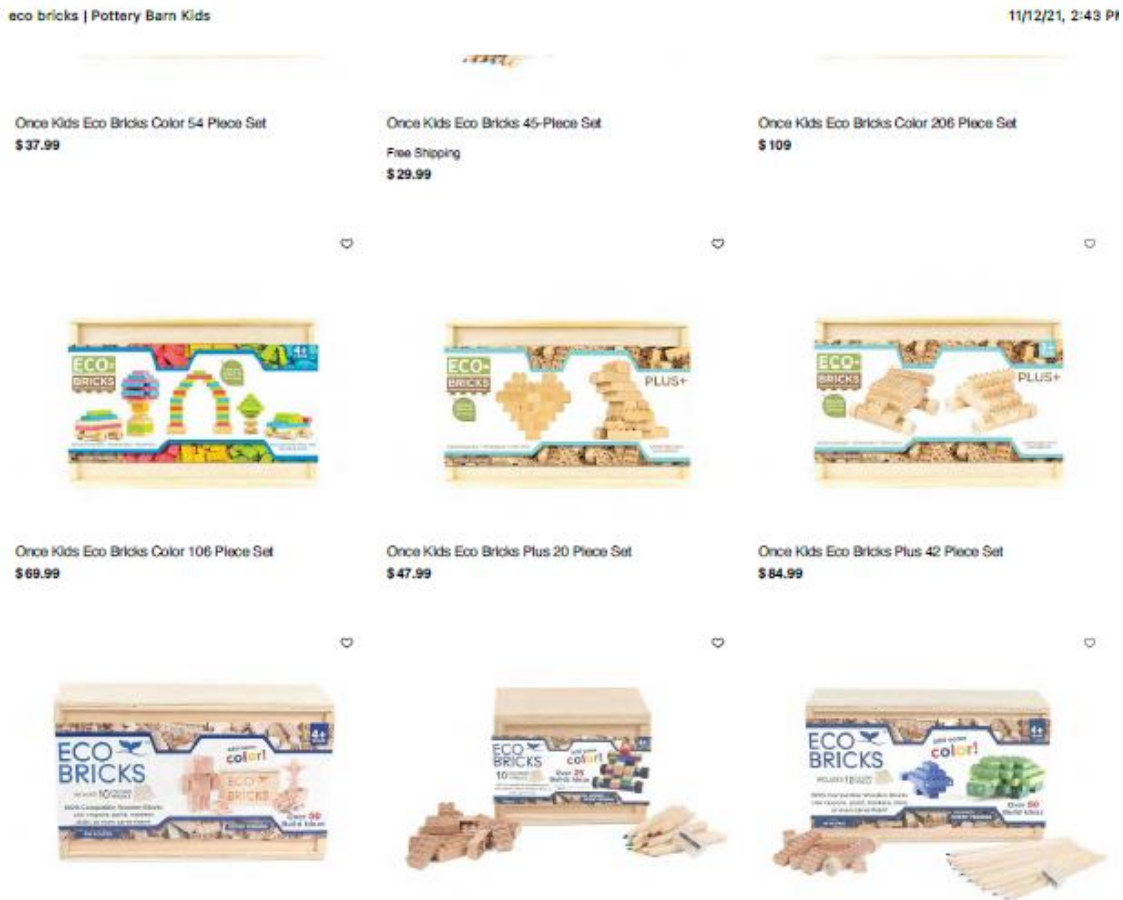
⁴¹ *Id.*, ¶ 11, 88 TTABVUE 6.

⁴² *Id.*, Exh. OK142, 88 TTABVUE 171-173.





Applicant also references the placement of its products where the proposed mark “has been featured in and advertised by more than 173 specialty independent stores nationwide as well as big box, nationally-recognized retailers.”⁴³ One online example is set forth below:⁴⁴



The number of prospective purchasers exposed to this use is unknown; however, based on the increasing sales discussed below we may infer some consumer exposure.

⁴³ App. brief, 92 TTABVUE ; *see also* Grimes Decl. ¶ 9, 88 TTABVUE 4.

⁴⁴ Grimes Decl. Exh. OK139, 88 TTABVUE 131 (ww.potterybarnkids.com).

4. Amount of sales and number of customers

The sales have grown over the years and the places the products are offered has been steadily increasing.⁴⁵ The online, and brick and mortar stores include, at various times, Neiman Marcus, Amazon, Crate and Barrel, Pottery Barn Kids, Anthropologie, Neighborhood Goods, Kohls, and FAO Schwartz.⁴⁶ Although Applicant testifies that it has sold a total number of 177,791 ECO-BRICKS products and total sales in the amount of \$2,468,174.05 through November 5, 2020, Applicant did not provide information regarding market share to understand the context of these sales.⁴⁷ Opposer argues that:⁴⁸

Compared to Opposer's multi-billion dollar annual revenues (81 TTABVUE 3 at ¶ 7), Applicant's lifetime sales are miniscule and do little to establish secondary meaning. Further, while Applicant contends that its "market share has grown exponentially" since the ECO-BRICKS product was introduced (92 TTABVUE 9, 29), there is no evidence in the record of Applicant's market share at any point in time or, concomitantly, any evidence that Applicant's market share has grown.

We find these numbers without more context do not weigh in Applicant's favor.

5. Intentional copying

There is no evidence of intentional copying.

⁴⁵ Grimes Decl. ¶ 13, 88 TTABVUE 7.

⁴⁶ Grimes Decl. ¶ 9, 88 TTABVUE 4.

⁴⁷ Grimes Decl. ¶ 13, 88 TTABVUE 7.

⁴⁸ Opp. brief, 93 TTABVUE 17.

6. Unsolicited media coverage of the product embodying the proposed mark

Applicant argues:⁴⁹

Still further, Applicant *and its marks*, including the mark at issue herein, have been featured on popular nationally syndicated news and consumer programs including Good Morning America, Fox & Friends, and The Talk and—due to high visibility resulting in unsolicited press and media—have been featured in the Neiman Marcus Holiday Book, *D Magazine*, and The Bump, as well as by Once Kids through its own website at <http://once-kids.com>.⁸⁶ In 2019, ECO-BRICKS were featured in a licenseglobal.com tribute to the 50th Anniversary of Sesame Street, one of the most popular and longest running children’s shows of all time.

Opposer argues:⁵⁰

As Applicant has admitted, much of the media coverage of Applicant and its products was solicited rather than organic, and thus does not count toward this factor. The only *unsolicited* media that Applicant claims to have had is placement in Neiman Marcus’s Holiday Book for one year, a single placement in *D Magazine* (a publication local to Dallas, Texas), and a single reference on TheBump.com pregnancy-related website. (92 TTABVUE 31.) Three examples of unsolicited media coverage hardly points to acquired distinctiveness, particularly since Applicant has not provided any information about how many consumer impressions this media coverage might have had. *See Apollo Med. Extrusion Techs., Inc. v. Med. Extrusion Techs., Inc.*, 123 U.S.P.Q.2d 1844, 1856 (T.T.A.B. 2017).

In sum, Applicant’s limited evidence on the question of acquired distinctiveness is neither compelling nor sufficient in light of the highly descriptive nature of the ECO-BRICKS mark. *See In re Bos. Beer Co.*, 53 U.S.P.Q.2d 1056, 1058, 198 F.3d 1370, 1373 (Fed. Cir. 1999) (“[T]he greater the degree of descriptiveness the term has, the

⁴⁹ App. brief, 92 TTABVUE 30-31.

⁵⁰ Opp. reply brief, 93 TTABVUE 17-18.

heavier burden to prove it has attained secondary meaning.”) (citation omitted).

Looking at Applicant’s evidence, there is minimal unsolicited media coverage. Further, as discussed above, with regard to the television features, it is unclear whether and to what extent the term ECO-BRICKS appeared and was presented as a trademark. Given the highly descriptive nature of ECO-BRICKS we would need substantially more evidence to find it has acquired source-identifying distinctiveness by potential consumers of Applicant’s goods.⁵¹

7. Conclusion

After considering all of the factors for which there is evidence in determining whether Applicant’s purported mark ECO-BRICKS has acquired distinctiveness, we find that Applicant has not met its burden of proving ECO-BRICKS has acquired distinctiveness.

DECISION: We sustain the opposition to register ECO-BRICKS on the ground that it is merely descriptive and has not acquired distinctiveness.

⁵¹ We do not consider Applicant’s last statement in its brief that if ECO-BRICKS is found merely descriptive and lacking acquired distinctiveness “Opposer’s request that Applicant’s application be refused registration is improper and unnecessary, as the proceeding may be resolved by requiring disclaimer.” App. brief, 92 TTABVUE 31. As explained by Opposer, this “request” is essentially an untimely motion to amend the application, without particularity as to what should be disclaimed, and in any event “the only disclaimer that could possibly resolve all of the issues in this proceeding is one that would disclaim the entirety of Applicant’s mark. But [a]n entire mark may not be disclaimed.” Opp. brief, 93 TTABVUE 18-19 (citing TMEP § 1213.06 (2022)).