

This Opinion is Not a  
Precedent of the TTAB

Mailed: November 13, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*adidas AG*  
*v.*  
*Christian Faith Fellowship Church*  
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Cancellation No. 92053314  
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On Remand  
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Angelo Notaro, John Zaccaria and Bradley S. Corsello of Notaro, Michalos &  
Zaccaria, P.C.,  
for adidas AG.

Richard W. Young and John E. Conour of Quarles & Brady LLP,  
for Christian Faith Fellowship Church.

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Before Thurmon<sup>1</sup>, Deputy Chief Administrative Trademark Judge,  
Taylor and Greenbaum, Administrative Trademark Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

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<sup>1</sup> Judge Seeherman sat on the panel and participated in writing the September 14, 2016 decision. Judge Seeherman has since retired, and Deputy Chief Administrative Judge Thurmon has been substituted for her on the panel deciding this case. The change in composition of the panel does not necessitate a retrial of this case. *In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1, 4 (Fed. Cir. 1985); *Hunt Control Sys. Inc. v. Koninklijke Philips Elect. N.V.*, 98 USPQ2d 1558, 1560 n.1 (TTAB 2011).

## I. Background

adidas AG (“Petitioner”) filed a petition for cancellation of two registrations owned by Christian Faith Fellowship Church (“Respondent” or the “Church”) for the marks ADD A ZERO (in standard characters) and ADD A ZERO in special form with design, displayed as



for, as amended, “clothing, namely, shirts and caps.”<sup>2</sup>

The grounds for cancellation are (1) nonuse prior to the filing dates of Respondent’s use-based applications, rendering the registrations void ab initio; (2) abandonment of Respondent’s registrations based on at least three consecutive years of nonuse with intent not to resume such use; and (3) failure of the marks to function as trademarks because ADD A ZERO is simply an informational slogan.<sup>3</sup>

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<sup>2</sup> Registration Nos. 3173207 and 3173208, respectively, both issued on November 21, 2006, and both have been renewed. Respondent filed applications for the former on March 23, 2005, and the latter on March 24, 2005. Color is not claimed as a feature of the mark in Registration No. 3173208, and there is no description of the mark.

<sup>3</sup> The petition for cancellation also includes a claim that Respondent’s marks are “ornamental and/or functional” (Pet. ¶¶ 24, 26, 11 TTABVUE 4), but Petitioner did not pursue this claim at trial or in its briefs. The claim, therefore, is deemed to be waived. *Krause v. Krause Publ’ns Inc.*, 76 USPQ2d 1904, 1906 n.2 (TTAB 2005). We also note that the petition for cancellation originally included a claim for partial cancellation of the registrations pursuant to Section 18

Respondent, in its answer to the petition, admitted that Petitioner's application, Serial No. 77822018 for the mark ADIZERO, has been refused registration under Section 2(d) based on Respondent's registrations, and that Respondent never used the marks on pants,<sup>4</sup> and denied the remaining salient allegations in the petition.

Both parties filed briefs, and Petitioner file a reply brief.

In a decision dated September 14, 2016, the Board granted the petition for cancellation on the ground of nonuse, finding that Respondent's sale of two caps to an out-of-state resident in the Church's bookstore prior to filing the use-based applications was not sufficient to satisfy the "use in commerce" requirement to register a mark.<sup>5</sup> In view of this finding, the Board did not reach the remaining issues of abandonment and failure to function.<sup>6</sup> On appeal, the U.S. Court of Appeals for the Federal Circuit reversed the Board's finding of nonuse and remanded for further proceedings. *Christian Faith Fellowship Church v. adidas AG*, 841 F.3d 986, 120 USPQ2d 1640, 1647 (Fed. Cir. 2016).

We presume the parties are familiar with the record and evidentiary objections pending in this case.<sup>7</sup> We need not and do not address any evidentiary objections

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of the Trademark Act, 15 U.S.C. § 1068. On February 3, 2014, the Board granted Petitioner's motion to withdraw said claim, and dismissed the claim with prejudice. 46 TTABVUE 1.

<sup>4</sup> The registrations originally included "pants" in the identification of goods, but these goods were deleted from the registrations with preclusive effect. *See* May 22, 2013 Board Order. 31 TTABVUE 6-7, 9.

<sup>5</sup> 67 TTABVUE 17.

<sup>6</sup> 67 TTABVUE 2-3.

<sup>7</sup> The Board made certain evidentiary rulings in the September 14, 2016 Board Order, which pertained only to evidence concerning Petitioner's nonuse claim. 67 TTABVUE 3-9. The

raised by either party as none of the evidence to which an objection has been raised is outcome determinative, and we have not relied on any of it in reaching our decision.<sup>8</sup> We turn now to the remaining two grounds for cancellation.

## II. Abandonment/Intent to Resume Use

Section 45 of the Trademark Act, 15 U.S.C. § 1127, states, in pertinent part, that abandonment of a mark occurs

When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. “Use” of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

A petitioner for cancellation of a registration on the ground of abandonment bears the burden of proving its case by a preponderance of evidence. *See On-Line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1476 (Fed. Cir. 2000); *Imperial Tobacco Ltd. v. Philip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390, 1393 (Fed. Cir. 1990); *Cerveceria Centroamericana, S.A. v. Cerveceria India, Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1310 (Fed. Cir. 1989). Petitioner must meet this burden by showing that, with respect to any particular identified good, the mark’s “use has been discontinued with intent not to resume such use.” 15 U.S.C. § 1127.

For the reasons we discuss below, we find Petitioner to have failed to establish a prima facie case of abandonment as to the use of Respondent’s mark on shirts, and

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record includes all other items detailed in Petitioner’s brief (58 TTABVUE 6-8), as supplemented by Respondent’s brief (60 TTABVUE 6).

<sup>8</sup> Indeed, we reference only one such piece of evidence, and do so in a footnote at the end of our discussion on the abandonment claim, where we explain why it is not outcome determinative.

Respondent's showing of excusable nonuse of the mark on caps overcomes Petitioner's prima facie showing of abandonment of the mark as to those goods.

Petitioner bases its case primarily on the absence of sales of caps and the minimal sales of shirts during the four-year period between November 21, 2006, the date on which the registrations issued, and November 23, 2010, the date on which the instant petition was filed. The documentary evidence of use of the marks on Respondent's identified goods during that four-year period consists solely of a receipt journal covering the period of January 1, 2005 to July 22, 2011, which Respondent produced during discovery, and which both parties made of record.<sup>9</sup> Respondent's witness, Craig Mason, who serves as Respondent's secretary, treasurer and executive pastor, explained that the receipt journal lists all sales of ADD A ZERO shirts and caps.<sup>10</sup>

During the period between November 21, 2006 and November 23, 2010, the receipt journal lists the sale of one hoodie on January 7, 2007, one crew shirt on August 30, 2009, and no caps.<sup>11</sup> However, Mr. Mason testified that Respondent offered ADD A ZERO shirts and hats in Respondent's bookstore continuously since 2006 to the time of his testimony, with the exception of 2008, when the bookstore was closed for renovation.<sup>12</sup> In addition, as we found in the September 14, 2016 decision, it is

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<sup>9</sup> Petitioner made the receipt journal of record with its Ninth Notice of Reliance, as Exhibit 7 to the Mason Discov. Dep., 36 TTABVUE 475-492. Respondent also introduced the receipt journal as Exhibit 2 to the Mason Tr. Test., 50 TTABVUE 50-67.

<sup>10</sup> 36 TTABVUE 401.

<sup>11</sup> 36 TTABVUE 484.

<sup>12</sup> 36 TTABVUE 410-411, 413-416. The parties have used the terms "caps" and "hats" interchangeably, and we follow suit in this decision.

undisputed that Respondent launched its on-line bookstore (and first made ADD A ZERO merchandise available for sale through the on-line bookstore) in December 2010.<sup>13</sup> The receipt journal shows that Respondent sold three ADD A ZERO shirts on December 19, 2010, and a number of ADD A ZERO shirts and caps and thereafter.<sup>14</sup>

Petitioner contends that Respondent's sale of two shirts and no caps during the aforementioned four-year period comprises a prima facie case of abandonment of the marks on the goods, and creates a rebuttable presumption that Respondent did not intend to resume use of the marks on the goods.

Turning first to ADD A ZERO shirts, we find that there is no period of three consecutive years when Respondent sold no shirts. While Respondent's sale of two shirts from January 7, 2007 to August 30, 2009 are admittedly "modest,"<sup>15</sup> and Mr. Mason acknowledged, in connection with the December 2010 "Add A Zero relaunch," that "sales on the Add A Zero apparel had been slow,"<sup>16</sup> nothing in the record supports a finding that such sales were not "bona fide use[s] of [the] mark[s] in the ordinary course of trade," rather than "made merely to reserve a right in [the] mark[s]." 15 U.S.C. § 1127.

Moreover, we are constrained by the holding of the Federal Circuit in this proceeding that "the Church's sale of two 'ADD A ZERO'-marked hats to an out-of-

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<sup>13</sup> 67 TTABVUE 5 (referencing in n.11 Respondent's Answers to Interrogatory Nos. 3 and 7, 36 TTABVUE 286-287, and 36 TTABVUE 436).

<sup>14</sup> 36 TTABVUE 484-492.

<sup>15</sup> 50 TTABVUE 9.

<sup>16</sup> 36 TTABVUE 427.

state resident is regulable by Congress under the Commerce Clause, and, therefore, constitutes ‘use in commerce’ under the Lanham Act.” *Christian Faith Fellowship Church*, 120 USPQ2d at 1647. As there is no *de minimis* test for the “use in commerce” requirement to register a mark, we fail to see how there could be such a test for the “use” requirement to defeat an abandonment claim.<sup>17</sup> Therefore, contrary to the line of cases Petitioner cites in its brief, where abandonment was found when sales were “de minimis,” “minimal” or “inconsequential,”<sup>18</sup> we find that the sale of two ADD A ZERO shirts in three years constitutes sufficient use to defeat Petitioner’s claim of abandonment.

As for ADD A ZERO caps, it is true that Respondent sold none during this four-year period. However, to the extent Petitioner has established a prima facie case of abandonment as to caps, we find that Respondent has rebutted such prima facie case, because any nonuse by Respondent of ADD A ZERO on caps which occurred in 2008 is excusable nonuse, due to the temporary closure of the bookstore for remodeling that year. *Cf. Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1775 n.9 (TTAB 1994) (suggesting that “an interrupted use due to special circumstances, with no intent to abandon” constitutes excusable nonuse sufficient to overcome any inference of abandonment). We also are mindful that where a three-year statutory period of

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<sup>17</sup> Section 45 of the Trademark Act uses the term “use” rather than “use in commerce” when defining “abandonment of a mark.” However, Section 45 defines “[t]he term ‘mark’ [to] include[s] any trademark ...,” and it defines “[t]he term ‘trademark’ as “any word, name, symbol, or device, or any combination thereof -- ... (2) which a person has a bona fide intention to *use in commerce* and applies to register on the principal register established by this chapter” (emphasis added).

<sup>18</sup> 58 TTABVUE 25-26.

nonuse of a mark is established, the Board may consider evidence and testimony regarding a defendant's practices that occurred before or after the three-year statutory period to infer the defendant's intent to resume use during the nonuse period. *Crash Dummy Movie LLC v. Mattel Inc.*, 601 F.3d 1387, 94 USPQ2d 1315, 1317 (Fed. Cir. 2010). To this end, we note that sales of ADD A ZERO caps and shirts increased noticeably starting in December 2010, when Respondent launched its online bookstore.<sup>19</sup> Accordingly, we find that Respondent has rebutted any prima facie case of abandonment as to caps.<sup>20</sup>

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<sup>19</sup> 36 TTABVUE 484-492.

<sup>20</sup> We would be remiss if we did not mention the declaration of Petitioner's investigator Edgar Bridges, and his attached report, which were submitted by Petitioner with its summary judgment motion (18 TTABVUE and 19 TTABVUE (confidential) respectively) and again at trial as exhibits to Mr. Bridge's trial testimony deposition (34 TTABVUE). Respondent objects to this evidence on admissibility and relevance grounds (61 TTABVUE 25-32).

Mr. Bridges testified, and his earlier declaration and report attest, to his two unsuccessful attempts in May 2010 to buy ADD A ZERO shirts and caps from Respondent by phone, during which he was told by two individuals, Ora Brown and LaBella (no last name provided), that Respondent had not used the ADD A ZERO mark for years (34 TTABVUE 15, 18-21, 34-36 (testimony); 34 TTABVUE 53, 56 (report); 34 TTABVUE 61, 62-63 ¶¶ 5-6 (declaration)).

Even if we were to overrule Respondent's objections, consideration of this evidence would not change our decision. First, in its response to Interrogatory No. 32, Respondent has denied that any "person having the name 'LaBella' has ever worked for Respondent." 36 TTABVUE 290. Second, as Mr. Mason explained, Ms. Brown is an administrative assistant who occasionally works in the bookstore when the regular bookstore staff is not available. (50 TTABVUE 12). Although Petitioner points to Ms. Brown's statement to Mr. Bridges as evidence of Respondent's abandonment of the marks ("Any use of the trademarks at issue after 2006 was so minimal and inconsequential that Respondent's own employees were unaware of it." 58 TTABVUE 23), the basis for her statement is unclear, and she simply could be wrong.

Petitioner has the burden of proving its abandonment claim by a preponderance of the evidence, yet Petitioner did not call Ms. Brown (or any bookstore staff) as a witness, preferring instead to rely on the investigator's report as if it were conclusive. We simply do not view Mr. Bridges' testimony, and his earlier declaration and report, as persuasive evidence of Respondent's abandonment of ADD A ZERO on shirts and caps.

In view thereof, Petitioner's claim of abandonment is dismissed with prejudice as to both caps and shirts.

### III. Failure to Function as Trademarks

Section 45 of the Trademark Act, 15 U.S.C. § 1127 defines a "trademark" in relevant part as "any word, name, symbol, or device, or any combination thereof – (1) used by a person ... to identify and distinguish his or her goods ... from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown."

It is well-settled that not every designation that is placed or used on a product necessarily functions as a trademark and not every designation adopted with the intention that it perform a trademark function necessarily does so. *See In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1976) ("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."). Following this precept, the Board has affirmed refusals to register slogans and composite word and design marks that convey information but which do not function as marks. *See, e.g., D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d 1710, 1716 (TTAB 2016) (finding that I ♥ DC does not create the commercial impression of a source indicator because it would be perceived as informational); *In re Volvo Cars of N. Am. Inc.*, 46 USPQ2d 1455, 1459-60 (TTAB 1998) (refusal to register DRIVE SAFELY affirmed because phrase would not be regarded as indicator of source but as a familiar safety admonition).

Likewise, slogans and other terms that express support, admiration, or affiliation are generally not registrable. *See, e.g., In re Hulting*, 107 USPQ2d 1175, 1177 (TTAB 2013) (finding “No More RINOs” is a political slogan of the conservative wing of the Republican Party and not registrable as a trademark for bumper stickers, t-shirts, and political pins); *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 such it is the type of expression that should remain free for all to use.”); *In re Manco Inc.*, 24 USPQ2d 1938, 1941 (TTAB 1992) (refusals to register THINK GREEN and THINK GREEN and design affirmed because they would be regarded as “slogan of environmental awareness and/or ecological consciousness, rather than be regarded as indicators of source for weather stripping and paper products.”).

“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.” *Eagle Crest*, 96 USPQ2d at 1229 (citation omitted).

In determining whether a designation functions as a mark, the critical inquiry is how the relevant public would perceive the designation. *Id.* at 1229. To make this determination, we look to specimens and other evidence of record showing how the designation actually is used in the marketplace. *D.C. One Wholesaler*, 120 USPQ2d at 1713 (citing *Eagle Crest*, 96 USPQ2d at 1229-30). *See Bose*, 192 USPQ at 216 (“[T]he manner in which an applicant has employed the asserted mark, as evidenced by the specimens of record, must be carefully considered in determining whether the asserted mark has been used **as a trademark** with respect to the goods named in

the application.”) (emphasis in original). Thus, the determinative factor as far as registrability is concerned is the manner in which the mark actually is used. *Michael S. Sachs Inc. v. Cordon Art B.V.*, 56 USPQ2d 1132, 1135 (TTAB 2000).

Petitioner argues that “add a zero” is a commonly used fundraising slogan, that Respondent used “add a zero” “as an informational message to encourage its members to contribute monies to Respondent’s building fund,”<sup>21</sup> and that the relevant public, consisting of Respondent’s congregants and their families, who view the slogan on the shirts and caps identified in the registrations would understand it as such, rather than as a trademark identifying the source of Respondent’s goods. The following testimony from Mr. Mason, in particular, supports Petitioner’s position:

Q.	Was Add A Zero used in conjunction with fund-raising?
Mr. Young	Objection, it’s been asked and answered.
A.	Yes.
Q.	To raise revenues for the building fund?
A.	Yes.
Q.	How was Add A Zero used in connection with fund-raising?
Mr. Young	Objection, it’s been asked and answered now multiple times.
A.	That the proceeds would go toward paying off the debt of the church.
Q.	Other than placing the name on shirts and hats, was Add A Zero used in connection with fund-raising in any other way?
A.	No, not that I can recall. <sup>22</sup>

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Q.	Was any explanation ever given to the congregation of why the CFFC was using the words Add a Zero?
A.	Yes.
Q.	Okay. How were those explanations provided?

<sup>21</sup> 58 TTABVUE 33.

<sup>22</sup> 36 TTABVUE 418-419.

A.	The senior pastor made the announcement to the congregation in regard to how it was being used from the prophetic word that was spoken by the traveling evangelist back in 2004 I believe it was.
Q.	Can you tell us as best you can what was said to the congregation?
A.	That based on a prophetic word that God is adding a zero to the income of the church, that in support of paying off the land of the church and the building at that time, that the apparel would be sold – the Add A Zero apparel would be sold, and all proceeds would go toward the building fund – into the building fund account. <sup>23</sup>

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Q.	What, if anything, does the Add a Zero name have to do with the Brick and Mortar Building Fund Drive?
A.	I believe with the prophetic word that was spoken of the church that it also stated that there would be an increase in expenses, but God was also going to add to the income of the church and also to the senior pastors personally. So then in regard to the Add a Zero, being that’s where the word derived from, the Add A Zero is adding a zero to the income and adding a zero to the expenses. So in regard to the campaign, the proceeds would be used to pay off that debt. <sup>24</sup>

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Q.	Do you have an understanding as to why people are buying the product that has the Add A Zero trademark on it?
A.	For one, it’s pretty fashionable, I think, and, two, in support of the building campaign of the church. <sup>25</sup>

Petitioner also has made of record a number of news articles, webpages, and blog posts showing that the slogan “add a zero” has been widely used by others in connection with fundraising. Illustrative examples follow (emphasis added).

- The Maharishi Vedic Prevention Center of Hamden, Connecticut webpage discusses a “small fundraising event” that the Center hosted in connection with

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<sup>23</sup> 36 TTABVUE 420-421.

<sup>24</sup> 36 TTABVUE 422-423.

<sup>25</sup> 36 TTABVUE 433.

“The ‘**Add a Zero**’ Campaign, where “donors were encouraged to think of what they could give comfortably but significantly ... and then **add a zero** to the end of that amount. One participant jumped in and extolled the benefits of **adding a zero**. He explained how he had done this in the past and how it had always worked in his favor.”<sup>26</sup>

- The Three Dollar Bill Cinema webpage advertises an event titled “Our Community, In Focus: \$15 for 15,” where “[w]e are asking for your support to help us continue to bring the LGBT community together to showcase our stories and harness the power of film to create change. In recognition of the 15th year of The Seattle Lesbian and Gay Film Festival, please consider making a donation of \$15. **Add a zero** to make a donation of \$150 or considering pledging \$15 a month.”<sup>27</sup>
- An April 16, 2000 article from THE SUNDAY ADVOCATE (BATON ROUGE, LOUISIANA) titled *A Tournament for Kid’s Sake* reports a fundraising event for St. Jude’s Children’s Research Hospital, and the ability of “renowned bass pro and ESPN fishing-host Jimmy Houston” to help raise money at an upcoming tournament: “Somehow, Houston exacts a little more from pockets when it comes to raffles and auctions. He has a knack for opening pocketbooks or getting somebody to **add a zero** to a figure on a check.”<sup>28</sup>

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<sup>26</sup> 36 TTABVUE 662 <http://www.vedichealth-ct.org/contributors/donate.htm> accessed September 10, 2013.

<sup>27</sup> 36 TTABVUE 681 <https://www.threedollarbillcinema.org/calendar/15-for-15/> accessed September 14, 2013.

<sup>28</sup> 36 TTABVUE 590 at 591.

- A May 22, 2004 article from the SAINT PAUL PIONEER PRESS (MINNESOTA) titled *Wetterling Wins Nod of DFL at Convention* reports the endorsement of political candidate Patty Wetterling and her fundraising efforts: “On Friday night, Duluth Mayor Herb Bergson welcomed delegates to ‘Patty’s army’ and urged them – and all of more than 2,000 delegates to the convention – to think about how much they could afford to give Wetterling’s campaign, **add a zero** and send in their checks.”<sup>29</sup>
- A July 20, 2008 article from the SACRAMENTO BEE (CALIFORNIA) titled *New Moon still shines; A decade since our last visit, this Nevada City restaurant remains a sliver of heaven*, discusses a note on a restaurant bill, which says “[a]t the risk of being presumptuous, we added \$1 to your bill to protect the spacious lands and emerald rivers in the northern Sierra foothills. If you object, we’ll cheerfully deduct the amount. Simply cross it out ... .” “Some do, but some also **add a zero** to boost the donation to \$10, says manager Buzz Crouch.”<sup>30</sup>
- A May 3, 2009 article from THE SEATTLE TIMES titled *SIFF returns for 35<sup>th</sup> year with some new venues* discusses the Seattle International Film Festival (SIFF), and mentions its membership program: “Throughout the festival, SIFF will promote membership in the 35 club, a fundraising program ... Members who contribute \$35 (or more, with special encouragement to ‘add a zero’ to \$350 or \$3,500) will receive special recognition ... at the Film Center.”

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<sup>29</sup> 36 TTABVUE 601 at 602.

<sup>30</sup> 36 TTABVUE 614 at 617.

- A December 13, 2011 column by reporter John Kelly in the [washingtonpost.com](http://www.washingtonpost.com) titled *Getting the word out about scam artists* concludes with a fundraising pitch: “It’s the season for giving, and I hope you won’t forget to give to Children’s National Medical Center this year. How much? How about adding the ages of all your children together and making out a check in that amount? **Add a zero** if you can afford it.”<sup>31</sup>
- A May 17, 2013 blog post by “Christopher” on the United Way of Stanislaus County website titled *How To Be Courageous When Giving To Charity* lists “four ways to give more courageously,” including “[p]art of giving courageously means giving courageously in the amount that you donate. Perhaps you want to **add a zero** to the end of your normal donation – that is an act of courage.”<sup>32</sup>

Respondent argues that Petitioner’s evidence is inapposite because none of the stories show use of the wording “add a zero” on clothing. We acknowledge that none of the stories show use of the slogan on clothing, but such use is not necessary to demonstrate that “add a zero” is an informational phrase in the nature of a slogan, and would be understood as such by the relevant purchasing public. In this case, Mr. Mason’s testimony makes it clear that Respondent uses the phrase “add a zero” in the same manner as nearly all of the third parties featured in the stories Petitioner made of record – to raise money for a particular cause – and that members of the Church and their families would understand the slogan in that manner. The phrase

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<sup>31</sup> 36 TTABVUE 631 at 633.

<sup>32</sup> 36 TTABVUE 670 at 671. <http://www.uwaystan.org/blog-entry/17-05-2013/how-be-courageous-when-giving-charity> accessed September 10, 2013.

“add a zero” is not somehow transformed into a trademark simply because Respondent sells shirts and caps imprinted with that phrase as part of a fundraising effort for the Church.<sup>33</sup>

Respondent also contends that Petitioner “has submitted **no** evidence of how the relevant public perceives the ADD A ZERO Marks as used by the Church” (emphasis in original),<sup>34</sup> suggesting that Petitioner’s evidence is deficient because Petitioner did not conduct a survey or speak to any Church members or their families. We disagree. For the reasons discussed below, we find Petitioner’s evidence sufficient to establish that the slogan “add a zero” is informational and would be understood as such by the relevant public.

The function of a trademark is to identify a **single** commercial source. The record before us establishes that the slogan “add a zero” has been widely used over a long period of time by various groups and organizations as an expression of enthusiasm and support for their particular fundraising events or causes. Because consumers are accustomed to seeing “add a zero” as a fundraising slogan used by many different groups, we find that the relevant public, Respondent’s congregants and their families, would not view the slogan as a trademark indicating that Respondent is the sole source of caps and shirts bearing the mark. We further find that most, if not all, of the members of the relevant public have purchased and will continue to purchase

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<sup>33</sup> Also contrary to Respondent’s position in its brief (60 TTABVUE 19, n.8), Respondent’s use of the TM notation (on the shirts and caps) in and of itself does not make an otherwise unregistrable term a trademark. *Volvo Cars*, 46 USPQ2d at 1461.

<sup>34</sup> 60 TTABVUE 19.

caps and shirts bearing the slogan because it conveys a message of financial support for the Church. *See Eagle Crest*, 96 USPQ2d at 1232 (holding the primary function of slogan ONCE A MARINE, ALWAYS A MARINE is to express support, admiration or affiliation with the U.S. Marines). *See also D.C. One Wholesaler*, 120 USPQ2d at 1716 (“Because the nature of the phrase [I ♥ DC] will be perceived as informational, and also because the ubiquity of the phrase ... on apparel and other souvenirs of many makers has given it a significance as an expression of enthusiasm, it does not create the commercial impression of a source indicator, even when displayed on a hangtag or label.”). Respondent is not entitled to exclusively appropriate the slogan to itself and thereby attempt to prevent competitors from using it to promote the sale of their own caps and shirts. 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 or slogans. 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 7:23 (5<sup>th</sup> ed. September 2019).

Here, the primary purpose of the slogan “add a zero,” as shown by the evidence of use by the public and Respondent, is to convey information, that is, to convey enthusiasm and support for a particular fundraising cause including the fundraising activities of Respondent.

Based on the record evidence, we find that the wording “add a zero” is an informational slogan that would not be perceived as a trademark to identify and distinguish Respondent’s goods from the like goods of others. *See Manco*, 24 USPQ2d at 1941 (THINK GREEN and THINK GREEN and design not registrable because

they would be regarded as “slogan of environmental awareness and/or ecological consciousness, rather than be regarded as indicators of source for weather stripping and paper products.”). Accordingly, we grant the petition to cancel Registration No. 3173207 for ADD A ZERO in standard characters.

However, cancellation of Registration No. 3173208 for ADD A ZERO in special form with design, displayed as



is not appropriate. Notwithstanding the informational nature of the wording, the specific combination, placement and shading of the wording and design elements of this special form mark create an integrated whole with a single and distinct three-dimensional commercial impression; that is, the mark is unitary. *Compare Dena Corp. v. Belvedere Int'l, Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991) (finding EUROPEAN FORMULA and design not unitary because the “elements are not so merged together that they cannot be regarded as separate” and the proximity of the words to the design feature “does not endow the whole with a single, integrated, and distinct commercial impression.”). *See In re EBS Data Processing, Inc.*, 212 USPQ 964, 966 (TTAB 1981) (noting that “if the elements are so merged together that they cannot be regarded as separable elements, the mark is a single unitary mark”).

**Decision:** The petition to cancel Respondent's Registration No. 3173207 for ADD A ZERO in standard characters and Registration No. 3173208 for ADD A ZERO in



special form with design, displayed as \_\_\_\_\_, is dismissed on the ground of abandonment.

The petition to cancel the registrations on the ground of failure to function is granted as to Registration No. 3173207 and denied as to Registration No. 3173208.

Registration No. 3173207 will be cancelled in due course.