3B. Registration and the Trademark Office

3.3. The TTAB

{This section by EEJ in 2026,}

3.3.1 About TTAB In a nutshell

{This section's text is adapted from text obtained from the TTAB website in fall 2026. It has been lightly edited by EEJ for brevity and for appropriateness as book text rather than as website content. Changes are not indicated in the text.}

3.3.1.1. Introduction

The Trademark Trial and Appeal Board (TTAB) is a neutral body that functions like a court for trademark matters at the United States Patent and Trademark Office (USPTO). The Board's administrative trademark judges are authorized to determine a party's right to register a trademark with the federal government. The Board is not authorized to determine whether you have the right to use a trademark, and does not issue injunctions halting use. The Board only determines whether an applicant or registrant has the right to register a mark or to retain a registration under challenge. Additionally, the Board is not authorized to determine questions of trademark infringement or unfair competition or to award money damages or attorney's fees. For anything other than determining the right of federal registration, you must file a case in federal or state court.

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While the Board is authorized to handle five different types of cases, there are three main categories of proceedings that applicants and registrants should know about: appeals, oppositions, and cancellations. If you file a case at the TTAB or if someone files a case against you at the TTAB, you will be a party to a legal proceeding and may want to consider hiring an attorney. Any party to such a proceeding without domicile in the United States must be represented by a properly-licensed U.S. attorney.

3.3.1.2. Staff

TTAB is composed of statutory members and appointed administrative trademark judges, as well as interlocutory attorneys, paralegals, and administrative staff to support operations and manage oral hearings. The statutory members are the USPTO Director, Deputy Director, Commissioner for Patents, and Commissioner for Trademarks. Administrative trademark judges are appointed by the Secretary of Commerce.

3.3.1.3. Practice and procedure

Rules and laws

TTAB proceedings are governed by the Lanham Trademark Act of 1946, as amended, (Trademark Act), 15 U.S.C. § 1051 et seq.; the rules of practice in trademark cases (commonly known as the Trademark Rules of Practice) found in Parts 2 and 7 of Title 37 of the Code of Federal Regulations (C.F.R.); the rules relating to the conduct of practitioners and the representation of others before the USPTO found in Part 11 of 37 C.F.R.; and guidance provided in the Trademark Trial and Appeal Board Manual of Procedure (TBMP).

The USPTO rules governing procedure in inter partes proceedings before the TTAB are adapted, in large part, from the Federal Rules of Civil Procedure, with modifications due primarily to the administrative nature of the TTAB proceedings.

There is a PDF version of the *U.S. Trademark Law: Rules of Practice and Federal Statutes* for the current rules of practice and federal statutes governing TTAB proceedings: http://www.uspto.gov/sites/default/files /documents/tmlaw.pdf

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Policies and procedures

Practices and procedures for litigating before the TTAB are published in the TBMP. It provides practitioners with basic and detailed information generally useful for litigating trial cases before the TTAB, and pursuing appeals of decisions made in the Trademarks unit of the USPTO. The manual does not modify, amend, or serve as a substitute for any existing statutes, rules, or decisional law and is not binding upon the TTAB, its reviewing courts, the Director of the USPTO, or any part of the USPTO. Nonetheless, the TBMP describes current practice and procedure under the applicable authority, as of the manual's issue date and is a valuable resource.

The most recent version of the TBMP is available in a searchable e-version format (http://tbmp.uspto.gov/RDMS/TBMP/current) and PDF format (http://www.uspto.gov/trademarks/ttab/tbmp-preface). Earlier editions of the TBMP are archived on the TTAB's webpages.

Additional policies and guidance

The TTAB website has additional TTAB guidance and policy, including:

- Selection of decisions for designation as precedents
- Ethics guidance
- TTAB phone conferencing
- FAQs

The TTAB invites comments and suggestions by email to TTABFeedback@uspto.gov.

3.3.1.4. Proceedings

Ex parte appeals

Each year, TTAB panels decide hundreds of appeals from refusals to register trademarks because they are descriptive, generic, confusingly similar to existing marks, or otherwise ineligible under the Trademark Act. Such refusals to register are initially issued by trademark examining attorneys, whose decisions may be appealed to the TTAB. New ex parte cancellation proceedings are being implemented and appeals of final decisions in those proceedings will also be decided by the TTAB. Decisions of the TTAB

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may, in turn, be appealed, in some cases, to a United States district court, or the United States Court of Appeals for the Federal Circuit.

Inter partes

The TTAB is also responsible for hearing certain kinds of inter partes proceedings (also called adversarial or trial cases), including oppositions to applications for registration, cancellation proceedings against registered marks, and concurrent use proceedings where a party alleges its mark is entitled to joint registration, based on geographic divisions of territory between the concurrent use applicant and other parties, often registrants.

3.3.1.5. Public systems

- The **Trademark Trial and Appeal Board Center (TTAB Center)** (https://ttabcenter.uspto.gov/) allows users to file notices of opposition and petitions for cancellation, trial evidence, trial briefs, requests for oral hearing, responses to motions and board orders, replies in support of motions and submissions related to correspondence and parties in inter partes proceedings.
- The **Electronic System for Trademark Trial and Appeals (ESTTA)** (https://estta.uspto.gov/) allows users to file new and subsequent requests for extensions of time to oppose, file new ex parte appeals, file responses to motions or orders in an existing ex parte or inter partes proceeding, and legal briefs in ex parte proceedings.
- The **Trademark Trial and Appeal Board Inquiry System (TTABVUE)** (https://ttabvue.uspto.gov/ttabvue/) allows users to obtain current proceeding status and to view proceeding prosecution history entries and most submissions or orders in the proceeding. ESTTA and TTAB Center filers should use TTABVUE to verify online submissions are received and entered into the proceeding record.
- The **TTAB Reading Room** (https://ttab-reading-room.uspto.gov/efoia/efoia-ui/#/search/decisions) allows users to search for final decisions and precedential orders.

3.3.1.6. Filing with the TTAB

Mandatory electronic filing

The TTAB requires electronic filing for all submissions in TTAB proceedings and for requests for extensions of time to oppose. Notices of opposition, petitions for cancellation, trial evidence, trial briefs, requests for oral hearing, responses to motions and board orders, replies in support of motions and submissions related to correspondence and parties in inter partes proceedings must be filed using TTAB Center, TTAB's modernized electronic system. All other filings must be submitted through ESTTA.

If TTAB Center or ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, customers may use alternative filing methods for most filings. Email or facsimile submissions are not permitted and will not be assigned a filing date.

3.3.1.7. Settlement and alternative methods for dispute resolution

When feasible, settling disputed matters in a TTAB proceeding prior to a final decision is cost-effective for parties and encouraged by the TTAB. Most TTAB trial proceedings settle before a final hearing by a panel of judges. View the alternate dispute resolution and settlements webpage if you are a party to a TTAB proceeding and would like to consider a settlement or alternate resolution to your proceeding.

3.3.1.8. Hearing and decision information

Oral hearings

The TTAB usually conducts oral hearings Tuesdays through Thursdays either virtually or in one of the shared hearing rooms on the Alexandria campus. Oral hearings are usually open to the public. Visit the hearings webpage to view more information about TTAB hearings such as schedules, protocols, and Alexandria campus visiting information.

TTAB receipts and issued decisions

Visit the filing and pendency statistics webpage to view current pendency, inventory, new filing metrics, final decisions issued, processing times, and other statistics updated quarterly.

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3.3.1.9. TTAB archives

The following are archives available from the TTAB website:

Alternate resolution options archives
Rules/laws archives
Stakeholder outreach archives
Standard protective order archives
TTAB Manual of Procedure (TBMP) archives

3.3.1.10. Attorney practice

Proceedings before the TTAB are legal proceedings. They are quite technical and highly specialized, involve complex questions of trademark law and procedure, and involve strict rules of practice. It is strongly recommended that any party to a proceeding secure the services of an attorney who is familiar with trademark law and Board practice; and representation by a U.S. attorney is required for any party without a U.S. domicile.

Board personnel are not permitted to provide legal advice to any applicant or party, and they will not give any special consideration to applicants or parties who elect not to retain counsel.

The Trademark Trial and Appeal Board (TTAB) Pro Bono Clearinghouse Program recognizes existing organizations that coordinate free legal services to members of the public in proceedings before the TTAB. These organizations match eligible clients with volunteer member attorneys. Currently, the International Trademark Association (INTA) Pro Bono Clearinghouse is recognized by TTAB. The Law School Clinic Certification Program also provides pro bono representation to individuals and small businesses throughout the country in the prosecution of patent and trademark applications before the USPTO.

3.4. Regulations regarding practice before the USPTO on trademark matters

{This section by EEJ in 2026,}

37 C.F.R. § 11.1 Definitions.

˜Unless otherwise clear from the context, the following definitions apply to this part:˜

Attorney or lawyer means an individual who is an active member in good standing of the bar of the highest court of any State. A non-lawyer means a person who is not an attorney or lawyer.

State means any of the 50 states of the United States of America, the District of Columbia, and any Commonwealth or territory of the United States of America.

United States means the United States of America, and the territories and possessions the United States of America.

37 C.F.R. § 11.14 Individuals who may practice before the Office in trademark and other non-patent matters.

(a) **Attorneys**. Any individual who is an attorney as defined in § 11.1 may represent others before the Office in trademark and other non-patent matters. An attorney is not required to apply for registration or recognition to practice before the Office in trademark and other non-patent matters. Registration as a patent practitioner does not itself entitle an individual to practice before the Office in trademark matters.

(b) **Non-lawyers**. Individuals who are not attorneys are not recognized to practice before the Office in trademark and other non-patent matters, except that individuals not attorneys who were recognized to practice before the Office in trademark matters under this chapter prior to January 1, 1957, will be recognized as agents to continue practice before the Office in trademark matters.

(e) **Appearance**. No individual other than those specified in paragraphs (a), (b), and (c) of this section will be permitted to practice before the Office in trademark matters on behalf of a client. Except as specified in § 2.11(a) of this chapter, any individual may appear in a trademark or other non-patent matter in his or her own behalf or on behalf of:

(1) A firm of which he or she is a member;

(2) A partnership of which he or she is a partner; or

(3) A corporation or association of which he or she is an officer and which he or she is authorized to represent

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3.5. Case: *In re Jason Jimenez* (Gasper vs. Jasper) (TTAB 2025)

{Edit by EEJ in 2026. Various footnotes have been omitted without indication.}

In re Jason Jimenez

Trademark Trial and Appeal Board
November 5, 2025

This Opinion is a Precedent of the TTAB. UNITED STATES PATENT AND TRADEMARK OFFICE. Mailed: November 5, 2025. Serial No. 97551823 Ashok Tankha of Lipton, Weinberger & Husick, for Jason Jimenez. Jonathon Schlegelmilch, Trademark Examining Attorney, Law Office 108, Kathryn E. Coward, Managing Attorney. Before Lykos, Larkin and Lavache, Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

Jason Jimenez ("Applicant") seeks to register on the Principal Register pursuant to Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), the standard character mark GASPER ROOFING (ROOFING disclaimed) for "Roofing consultation; Roofing contracting; Roofing installation; Roofing maintenance; Roofing maintenance services; Roofing repair; Roofing services; Maintenance of roofing; Repair of roofing" in International Class 37.[1]

[1] Application Serial No. 97551823, filed August 17, 2022 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging January 1, 1972 as the date of first use anywhere and in commerce. Applicant claims acquired distinctiveness under Section 2(f) as to the entirety of its mark.

Citations to the prosecution file refer to the USPTO's Trademark Status & Document Retrieval ("TSDR") system in Portable Document Format ("PDF"). Citations to the record also include references to TTABVUE, the Board's online docketing system. *See, e.g., Turdin v. Trilobite, Ltd.*, No. 94002505, 2014 TTAB LEXIS 17, at *6 n.6.

This opinion cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals by the pages on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). For decisions of the Board, this opinion uses citations to the Lexis legal database as well as the TTABVUE proceeding number, where available. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 101.03(a)(2) (2025) for acceptable citation options to TTAB cases.

Applicant appealed the Trademark Examining Attorney's final refusal to register the mark on the grounds that Applicant's mark (1) is primarily merely a surname within the meaning of Section 2(e)(4) of the Trademark Act, 15 U.S.C. § 1052(e)(4); and (2) so resembles the registered standard character mark JASPER CONTRACTORS (CONTRACTORS disclaimed) on the Principal Register for "Roofing services" in International Class 37, that it is likely to cause confusion or mistake or to deceive under Trademark Act Section 2(d), 15 U.S.C. § 1052(d).[2]

[2] Registration No. 3867023, registered October 26, 2010 on the Principal Register; renewed. The Examining Attorney also initially made a third refusal that the original specimen was unacceptable but this refusal was withdrawn.

When he filed his notice of appeal, Applicant requested reconsideration of both refusals, but the Examining Attorney denied Applicant's request and maintained each final refusal.[3] Upon resumption of the appeal, Applicant and the Examining Attorney filed briefs addressing the surname and likelihood of confusion refusals.[4] The Board then sua sponte suspended the appeal and remanded the application to the Examining Attorney for consideration of Applicant's evidence submitted during prosecution in support of his claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), which had not been previously addressed, and the related issue of a disclaimer of the generic wording ROOFING in Applicant's mark.[5] The Examining Attorney accepted Applicant's claim of acquired distinctiveness and disclaimer, thereby obviating the surname refusal.[6]

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[4] Applicant's submission with his appeal brief of portions of the prosecution record was superfluous and the Board strongly discourages this practice. *See In re Info. Builders Inc.*, No. 87753964, 2020 TTAB LEXIS 20, at n.4 (attaching previously submitted evidence to an appeal brief is unnecessary and impedes efficient disposition of the appeal by the Board), *appeal dismissed*, No. 20-1979 (Oct. 20, 2020).

[6] 11 TTABVUE. Because Applicant's Section 2(f) claim was not made in the alternative, the claim constituted a concession that Applicant's mark is not inherently distinctive. *Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 1358 (Fed. Cir. 2009) ("where an applicant seeks registration on the basis of Section 2(f), the mark's descriptiveness is a nonissue; an applicant's reliance on Section 2(f) during prosecution presumes that the mark is descriptive").

The Board resumed proceedings. The remaining issue before the Board is the likelihood of confusion refusal. For the reasons explained below, we reverse.

I. Evidentiary Objection

As a preliminary issue, we address an evidentiary objection raised during briefing. Applicant included links to and screenshots of YouTube videos in his brief. The Examining Attorney objects to this evidence on the grounds of untimeliness and improper format.

The objection is sustained. The record in an application should be complete prior to the filing of an appeal. Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d). The hyperlinks and the descriptions of their alleged content on YouTube embedded in Applicant's brief constitute an improper attempt to augment the record. And even if timely, providing only a link and screenshot to a video is insufficient to make its content of record due to the transitory nature of websites. *See In re Change Wind Corp.*, No. 86046590, 2017 TTAB LEXIS 233, at *23 n.8 (providing only a web address or hyperlink is insufficient to make such materials of record); *In re HSB Solomon Assocs. LLC*, No. 77136242, 2012 TTAB LEXIS 79, at *9 (Board will not utilize web address to access site and consider whatever content appears). The hyperlinks to the videos embedded

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in Applicant's appeal brief, the screenshots themselves, and any arguments associated therewith have been given no consideration.

For future reference, we note that applicants may make video files of record during prosecution by submitting them in one of the formats designated as acceptable by the USPTO, such as .wav, .wmv, .wma, .mp3, .mpg, or .avi format, and in a size not to exceed 30 MB. *See, e.g., In re Fantasia Distrib., Inc.*, No. 86185623, 2016 TTAB LEXIS 471, at *21 n.13 (TEAS accepts multimedia evidence, including video files under 30 MB)~[10]~.

[10] For more information regarding TMEO's electronic filing system, *see* TMEP § 301.01(a).

The Board will consider videos that are timely and properly made of record during prosecution.~ Applicants should, if possible, file a transcript of the video content to support the request for remand with the Board, and indicate that if and when the remand request is granted and jurisdiction is restored to the examining attorney, the applicant will submit the video file through TMEO's electronic filing system so that it can be uploaded to TSDR.[11] This is another reason why applicants should not wait until after the filing of a notice of appeal to attempt to make video evidence of record.

[11] Alternatively, applicants may mail to the Board an Internet video file in CD or DVD format. Applicants should concurrently file in ESTTA a "placeholder" exhibit page to indicate that the CD or DVD was mailed to the Board to make clear that the evidence is part of the record. *See* TBMP § 106.03. That being said, electronic submissions are preferred.

II. Likelihood of Confusion under Trademark Act Section 2(d)

Section 2(d) of the Trademark Act prohibits the registration of a mark that:

> [c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods [or services] of

the applicant, to cause confusion, or to cause mistake, or to deceive.

15 U.S.C. § 1052(d).

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E. I. DuPont de Nemours & Co*., 476 F.2d 1357, 1361 (CCPA 1973) ("*DuPont*"), *cited in B&B Hardware, Inc. v. Hargis Indus., Inc*., 575 U.S. 138, 144 (2015). In making our determination, we have considered each *DuPont* factor for which there is evidence and argument.

Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Cap. City Bank Grp. Inc*., 637 F.3d 1344, 353 (Fed. Cir. 2011). "Each case must be decided on its own facts and the differences are often subtle ones." *Indus. Nucleonics Corp. v. Hinde,* 475 F.2d 1197, 1199 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. *See In re i.am.symbolic, LLC*, 866 F.3d 1315, 1322 (Fed. Cir. 2017) (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc*., 308 F.3d 1156, 1164-65 (Fed. Cir. 2002)); *see also Federated Foods, Inc. v. Fort Howard Paper Co*., 544 F.2d 1098, 1103 (CCPA 1976) ("The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."). These factors, and others, are discussed below.

A. The Services and the Established, Likely-to-Continue Channels of Trade and Classes of Consumers

We commence by comparing the services as identified in the application and cited registration. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1307 (Fed. Cir. 2018). The sole service identified in the cited registration, "roofing services," is identical to the "roofing services" identified in the application and encompasses each of the specific roofing services listed in the application. *See Sw. Mgmt., Inc. v. Ocinomled, Ltd.,* No. 92080469, 2015 TTAB LEXIS 176, at *60-61 (given broad identification of services, "we must presume that the services encompass all services of the type identified"), *aff'd*, 652 Fed. Appx. 971 (Fed. Cir. 2016); *Info. Builders*, 2020 TTAB LEXIS 20, at *9-11 (finding services legally identical in part where registrant's services encompassed by applicant's services). This *DuPont* factor therefore weighs in favor of finding a likelihood of confusion.

This brings us to the established, likely-to-continue channels of trade and classes of consumers. *DuPont*, 476 F.2d at 1361. Because the services are identical and unrestricted as to trade channels and consumer classes, we must presume that the services travel in the same ordinary trade and distribution channels and will be marketed to the same potential consumers. *See In re Viterra Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 771 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same). This *DuPont* factor also weighs in favor of finding a likelihood of confusion.

B. The Marks

Keeping in mind that where the services are identical, the degree of similarity between the marks necessary to support a determination that confusion is likely declines, *Bridgestone Ams. Tire Operations, LLC v. Fed. Corp.*, 673 F.3d 1330, 1337 (Fed. Cir. 2012), we now consider the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371 (Fed Cir. 2005) (citing *DuPont*, 476 F.2d at 1361). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, 2018 TTAB LEXIS 170, at *13 (quoting *In re Davia,* No. 85497617, 2014 TTAB LEXIS 214, at *21-24, *aff'd per curiam*, 777 F. App'x 516 (Fed. Cir. 2019); *accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 732 (CCPA 1968) ("It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.") (citation omitted).

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"Similarity is not a binary factor but is a matter of degree." *In re St. Helena Hosp.*, 774 F.3d 747, 751 (Fed. Cir. 2014) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340 1344 (Fed. Cir. 2003)). The proper test regarding similarity "is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties." *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1373 (Fed. Cir. 2018) (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368 (Fed. Cir. 2012) (internal quotation marks and citation omitted)). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re St. Julian Wine Co.*, No. 87834973, 2020 TTAB LEXIS 196, at *13; *In re Bay State Brewing Co., Inc.,* No. 85826258, 2016 TTAB LEXIS 46, at *9 (citing *Spoons Rests. Inc. v. Morrison Inc.*, No. 91079317, 1991 TTAB LEXIS 53, at *18, *aff'd per curiam*, 972 F.2d 1353 (Fed. Cir. 1992)).

Our analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re Nat'l Data Corp.*, 753 F.2d 1056 (Fed. Cir. 1985). *See also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 1007 (CCPA 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion."). "No element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone." *In re Electrolyte Labs. Inc.*, 929 F.2d 645, 647 (Fed. Cir. 1990) (citing *Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293 (CCPA 1974)). Nonetheless, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *Detroit Athletic Co.*, 903 F.3d at 1305 (quoting *Nat'l Data Corp.*, 753 F.2d at 1058); *see also Sabhnani v. Mirage Brands, LLC*, No. 92068086, 2021 TTAB LEXIS 464, at *31.

We now compare Applicant's mark GASPER ROOFING with the cited mark JASPER CONTRACTORS, both in standard characters. The Examining Attorney argues that the marks are similar in sound, appearance, connotation and commercial impression because the first terms, GASPER and JASPER, are dominant and are "nearly identical." The Examining Attorney asserts that the surname GASPER and the term JASPER are phonetic equivalents because GASPER can be pronounced with a hard or soft letter "g" sound. In making this finding, the Examining Attorney relies solely on the line of case law holding that there is no correct pronunciation of a mark, citing cases such as *Viterra*, 671 F.3d at 1367 (comparing XCEED versus X-SEED (stylized) and finding that "substantial evidence supports the Board's determination that any minor differences in the sound of these marks may go undetected by consumers") and *Interlego AG v. Abrams/Gentile Entm't, Inc.*, No. 91103612, 2002 TTAB LEXIS 200, at *5 (comparing LEGO versus MEGO).

The case law relied on by the Examining Attorney does not require us to find that GASPER and JASPER would be pronounced the same. Generally, the principle that there is no correct pronunciation of a mark applies with greater force when one of the marks involved is a coined mark without a specific meaning. As explained by the U.S. Court of Appeals for the Federal Circuit in *StonCor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 1331-32 (Fed. Cir. 2014), "there is no correct pronunciation of a trademark that is not a recognized word."[13] *Accord Chas. Pfizer & Co., Inc. v. R. J. Moran Co.*, 1960 TTAB LEXIS 105, at *4 (finding that DIABINESE and DIABLAISE "when spoken are substantially similar in sound" because "there is no correct pronunciation of a mark" where the marks are "coined marks having no specific meaning and no established pronunciation"). In other words, this principle may apply to instances involving an invented term devoid of any known or understood meaning. *See, e.g., Inter Ikea Sys. B.V. v. Akea, LLC*, No. 91196527, 2014 TTAB LEXIS 166, at *18 (finding IKEA and AKEA confusingly similar, where "both marks are coined terms that look alike and sound alike" with "no apparent meaning in any language"); *In re Cresco Mfg. Co.*, 1963 TTAB LEXIS 84, at *2 ("The terms "CRESCO" and "KRESSCO" are phonetically indistinguishable; both terms are obviously derived from their respective corporate names and they are equally arbitrary in nature

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as applied to the products to which they are applied."). In this case, we find that the lead letters "G" and "J" in the marks would be pronounced differently, and that the entire marks differ in pronunciation, for the reasons discussed below.

[13] In *StonCor Grp.*, the Court found that the Board erred in failing to credit the opposer's testimony that consumers would pronounce "STON" as "stone" in its coined mark STONSHIELD. 759 F.3d at 1331. The Court observed that the prefix in the opposer's mark is neither a word in English nor in any other language. *Id.* at 1332. The Court found that "[w]here a trademark is not a recognized word and the weight of the evidence suggests that potential consumers would pronounce the mark in a particular way, it is error for the Board to ignore this evidence entirely and supply its own pronunciation." *Id.*

As explained in Section 1209.01(a) of the TMEP, coined or fanciful marks are

> terms that have been invented for the sole purpose of functioning as a trademark or service mark. Such marks comprise words that are either unknown in the language (e.g., PEPSI, KODAK, and EXXON) or are completely out of common usage (e.g., FLIVVER).

The record demonstrates that neither the word "jasper" nor the surname "Gasper" is a coined term.[14] As a result, and contrary to the Examining Attorney's position, the case law discussed above does not require us to find that these two terms may be pronounced in an identical manner. The Examining Attorney merely speculates and assumes, without evidentiary support, that "jasper" and "Gasper" are pronounced the same. *Cf. StonCor Grp.*, 759 F.3d at 1331 (the Board erred in failing to credit the opposer's testimony that consumers would pronounce "STON" as "stone" in its coined mark STONSHIELD). The record in this case establishes that "Gasper" is a surname that begins with the letter strings "G-a-s" and "G-a-s-p," each of which forms the words "gas" and "gasp" that are recognized in U.S. English, and pronounced with a hard letter "g" sound. *See Great Lakes Canning*, No. 365360, 1985 TTAB LEXIS 75 at 4 ("the pronunciation given by dictionaries for "Cana", per se, is a "long first a" pronunciation."). The dictionary entry for "jasper"

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further shows that it is pronounced as "ˈja-spər" with the soft letter "j" sound and not with the hard letter "g" sound. Therefore, contrary to the Examining Attorney's argument, we find that "Gasper" would be pronounced with a hard letter "g" sound and that "Jasper" would be pronounced with a soft "j" sound, consistent with the rules of pronunciation for U.S. English. We find that "Gasper" and "Jasper" sound different when verbalized.

[14] The record in this appeal establishes that "Gasper" is a recognized surname. *See* June 14, 2024 Office Action at TSDR 7 (negative dictionary evidence from the online U.S. English version of The Oxford Learner's Dictionary) and 11 (U.S. Census Data). *See also* footnote 6, *supra*.

We take judicial notice from the online version of THE MERRIAM-WEBSTER DICTIONARY that "jasper" is a recognized word in U.S. English defined as a "an opaque cryptocrystalline quartz of any of several colors especially : green chalcedony." *Merriam-Webster.com Dictionary*, Merriam-Webster, https://www.merriam-webster.com/dictionary/jasper. Accessed October 31, 2025. *See In re Zuma Array Ltd.*, 2022 LEXIS 281 at *15 n.18 (Board took judicial notice of meaning of the word "module"). We take further judicial notice that "Jasper" may also refer to "a city in NW Alabama;" "a resort town in SW Alberta;" or "a male given name"; or slang for "a fellow: guy." Dictionary.com https://www.dictionary.com/browse/jasper. Accessed October 31, 2025.

The additional wording in each mark, ROOFING and CONTRACTORS, albeit disclaimed, further contributes to differences in sound and appearance. To state the obvious, the words "roofing" and "contractors" look and sound completely different.

The presence of the words ROOFING and CONTRACTORS in the respective marks also engenders differences in connotation and commercial impression when the marks are considered in their entireties. Consistent with the Examining Attorney's issuance of a refusal under Trademark Act Section 2(e)(4), the primary connotation and commercial impression of Applicant's mark

GASPER ROOFING is that of a surname. The word "jasper" projects the connotation and commercial impression of a semi-precious stone. And even assuming arguendo that JASPER in the cited mark JASPER CONTRACTORS is also perceived as a surname, it is a different surname than GASPER. We find, in sum, that the marks in their entireties are different in appearance, pronunciation, connotation, and overall commercial impression which weighs against a finding of likelihood of confusion.

C. Purchasing Conditions

We now consider '[t]he conditions under which and buyers to whom sales are made, i.e. 'impulse' vs. careful, sophisticated purchasing.'" *DuPont*, 476 F.2d at 1361. A heightened degree of care when making a purchasing decision may tend to minimize likelihood of confusion. *See, e.g., In re N.A.D., Inc.*, 754 F.2d 996, 999-1000 (Fed. Cir. 1985) (because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED). Conversely, impulse purchases of inexpensive services may tend to have the opposite effect. *Palm Bay Imps.*, 396 F.3d at 1376.

Neither the application nor cited registration limit the identified roofing services to any particular type or consumer, meaning that they encompass both commercial and residential. Roofing services, by their intrinsic nature, are not impulse purchases but are relatively expensive and would ordinarily be purchased with a relatively high degree of care. *See In re Charger Ventures LLC,* 64 F.4th 1375, 1378-79 (Fed. Cir. 2023) (noting the Board's finding that the identified real estate services are "not average consumer services" and that the purchaser would exercise elevated care due to the nature and cost of real estate services); *Info. Builders*, 2020 TTAB LEXIS 20, at *14 ("[I]n light of the inherent nature of the goods and services involved, some degree of purchasing care may be exercised by Applicant's potential or actual consumers."); *Edwards Lifesciences Corp. v. VigiLanz Corp.*, No. 91154210, 2010 TTAB LEXIS 84, at *51 ("Just based on the products involved in this proceeding [medical monitors], one would expect that all of the purchasers would exercise a high degree of care when making their purchasing decision."). Indeed, Applicant's substitute specimen touts his ability to assist his customers with insurance claims, and Applicant's website invites consumers to schedule a consultation and advertises that Applicant offers financing options.[16] This evidence supports a finding that roofing service purchases may involve multiple steps and may be complex. As a result, even the least sophisticated consumer is likely to exercise an elevated level of care. This *DuPont* factor therefore weighs against a likelihood of confusion.

[16] August 23, 2023 Response to Office Action at TSDR 34 (www.gasperroofing.com accessed on 23 August. 2023).

D. Actual Confusion and Contemporaneous Use

Lastly, we address Applicant's argument that the Examining Attorney's failure to present evidence of instances of actual confusion indicates that Applicant's and Registrant's marks are dissimilar. Applicant's assertions implicate the "nature and extent of any actual confusion," and the "length of time during and conditions under which there has been concurrent use without evidence of actual confusion." *DuPont*, 476 F.2d at 1361. The Examining Attorney is under no obligation to adduce such evidence in an ex parte appeal.

In any event, "[t]he relevant test is likelihood of confusion, not actual confusion." *Detroit Athletic Co.*, 903 F.3d at 1309. "[A] showing of actual confusion is not necessary to establish a likelihood of confusion." *Herbko Int'l*, 308 F.3d at 1165 (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1571 (Fed. Cir. 1983)); *cf. Sunkist Growers, Inc. v. Intrastate Distrib. Inc.*, 144 F.4th 1376, 1381 (Fed. Cir. 2025). We deem both of these *DuPon*t factors neutral.

E. Weighing the *DuPont* Factors

The final step in analyzing likelihood of confusion is to weigh the *DuPont* factors for which there has been evidence and argument; "explain the results of that weighing;" and discuss "the weight [we] assigned to the relevant factors." *Charger Ventures LLC*, 65 F.4th at 1379. "No mechanical rule determines likelihood of confusion, and each case requires weighing of the facts and circumstances of the particular mark." *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346 (Fed. Cir. 2010). "[T]he weight afforded to each factor depends on the circumstances" and "[a]ny single factor may control a particular case." *Stratus Networks, Inc. v. UBTA-UBET Commc'ns Inc.*, 955 F.3d 994, 998 (Fed. Cir. 2020).

We have carefully considered all of the evidence made of record, as well as all of the arguments related thereto. The services are identical, which weighs heavily in favor of concluding that confusion is likely. Because the services are identical and unrestricted as to trade channels and consumers classes, we can rely on the presumption that the services travel in the same ordinary trade and distribution channels and will be marketed to the same potential consumers which also favors a likelihood of confusion. The marks, however, are different in their entireties, weighing heavily against finding a likelihood of confusion. Because purchasing decisions for the services will likely be made with an elevated degree of care, this *DuPont* factor also weighs against a likelihood of confusion. The remaining factors discussed above are neutral.

We find that the dissimilarity of the marks in sound, appearance, meaning and commercial impression is sufficiently great that, coupled with an elevated level of purchaser care, outweighs the identical nature of the services, trade channels and classes of consumers. We conclude that there is no likelihood of confusion.

Decision: The Section 2(d) refusal is reversed.

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4. Failure to Function as a Trademark

4.1. Prof. Roberts on Failure to Function

"Distinctiveness is the primary protectability hurdle for most trademarks," observes legal scholar Alexandra J. Roberts. But there's another doctrine that has been recently ascendant in trademark law – particularly in practice before the USPTO: *failure to function*:

> "Under the Lanham Act and common law, matter used in commerce is only protectable if it is both distinctive and *used as a mark*. Its success as a mark depends upon how it is used not just semantically, but aesthetically. While courts pay little attention to the latter requirement, and the USPTO applies it somewhat inconsistently, use as a mark plays a crucial role – along with distinctiveness – in predicting whether or not the public will perceive matter as indicating source. To be protectable, a trademark must be not only used in commerce, but used in a trademark way: It must appear where consumers expect a trademark to appear, and it must be sufficiently set off from the surrounding text and images to attract notice. If it isn't, it will fail to function as a trademark to consumers, and thus shouldn't merit protection under federal trademark law."

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Roberts, *Trademark Failure to Function*, 104 IOWA L. REV. 1977 (2019).

4.2. Case: *In re Erik Brunetti* ("fuck" failure to function) (Fed Cir. 2025)

{This section by EEJ in 2026}

4.2.1. Advance Notes

Erik Brunetti tried to register the word "fuck" as a trademark for sunglasses, cell phones cases, jewelry, watches, backpacks, wallets, luggage, and other goods, as well as retail services selling such goods. The examining attorney rejected the application, and the Trademark Trial and Appeals Board (TTAB) upheld the refusal on the basis that "fuck" failed to function as a trademark. Brunetti appealed to the Federal Circuit.

On appeal, the Federal Circuit rejected many of Brunetti's arguments but held the TTAB didn't provide a sufficiently clear explanation for its decision, so the court vacated and remanded.

4.2.2. Opinion

Note about editing marks: The superscript tilde ˜ denotes a deletion from the text. It is intended as a less obtrusive means of indicating an ellipsis than three dots or three asterisks.

{Edit by EEJ in 2026. Footnotes and citations to record omitted without indication.}

In Re: Erik Brunetti

United States Court of Appeals for the Federal Circuit
(August 26, 2025)

IN RE: ERIK BRUNETTI, Appellant. 2023-1539. Appeal from the United States Patent and Trademark Office, Trademark Trial and Appeal Board in Nos. 88308426, 88308434, 88308451, 88310900.

DYK, Circuit Judge.

Erik Brunetti appeals a decision of the Trademark Trial and Appeal Board ("Board"). The Board affirmed the examining attorney's refusal to register the word FUCK as a trademark for certain goods and services because it failed to function as a trademark. In re Brunetti, No. 88308426, 2022 WL 3644733 (T.T.A.B. Aug. 22, 2022). We reject many of Mr. Brunetti's arguments but nonetheless conclude that the decision of the Board lacks sufficient clarity, and, accordingly, we vacate and remand for further proceedings.

BACKGROUND

In February 2019, Mr. Brunetti filed four intent-to-use trademark registration applications. He sought registration on the principal register of the standard character mark FUCK (the "proposed mark" or the "applied-for mark") for (1) goods including sunglasses and carrying cases for cell phones, laptops, and glasses; jewelry, watches, and related products; backpacks, wallets, luggage, and other bags; and (2) services including retail store services featuring the aforementioned goods and a wide variety of other consumer goods.

After issuing non-final refusals and receiving responses from Mr. Brunetti,[6] the United States Patent and Trademark Office ("PTO") examining attorney refused the trademark applications on the ground that "the applied-for mark is a slogan or term that does not function as a trademark or service mark to indicate the source of applicant's goods and/or services and to identify and distinguish them from others." The examining attorney refused the applications under the heading "Refusal under Trademark Act Sections 1, 2, 3, and 45—Widely-used Commonplace Wording." *Id.* In relation to the jewelry and related goods application, for example, the examining attorney explained "the applied-for mark is a commonplace term, message, or expression widely used by a variety of sources that merely conveys an ordinary, familiar, well-recognized concept or sentiment." The examining attorney "attached evidence from multiple internet websites and internet based periodicals [to] show[] that the term FUCK is commonly used as a versatile expression that conveys a wide range of emotion, from disdain to joy." The evidence included images of jewelry and other goods with no connection to Mr. Brunetti marketed on websites.

[6] The applications were initially refused on the ground that the proposed mark "[c]onsists of or comprises immoral[] . . . or scandalous matter." 15 U.S.C. §

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> 1052(a). The Supreme Court subsequently held, in a separate case involving Mr. Brunetti, that section 1052(a)'s bar on registering immoral or scandalous matter was unconstitutional. *Iancu v. Brunetti*, 588 U.S. 388, 390 (2019). The examining attorney then reexamined the applications, leading to the decisions under review here.

On August 22, 2022, the Board in a precedential opinion affirmed the refusals to register the proposed mark for failure to function as a mark. The Board concluded that "[m]ere commonality[] . . . is not the test" for a failure to function refusal but, instead, the Board "must assess whether Applicant's proposed mark, [FUCK], functions as a mark based on whether the relevant public, i.e. purchasers or potential purchasers of the identified [] goods and [] services . . . would perceive [FUCK] as identifying the source or origin of such goods and services." But the Board explained that "[m]atter may be merely informational and fail to function as a trademark if it is a common term or phrase that consumers of the goods or services identified in the application are accustomed to seeing used by various sources to convey ordinary, familiar, or generally understood concepts or sentiments." "[T]here are designations, including certain widely-used messages, which are inherently incapable of being regarded as source indicators." "Such widely used messages will be understood as merely conveying the ordinary concept or sentiment normally associated with them, rather than serving any source-indicating function."

The Board then considered the ubiquity of the applied-for mark, explaining that "FUCK is no ordinary word, but rather one that has acquired a multitude of recognized meanings . . . , and whose popularity has soared over the years" such that it is "arguably one of the most expressive words in the English language—an 'all-purpose word.'" Next, the Board considered the applied-for mark's use in the marketplace, explaining that "[p]rominent use of an applied-for-mark, as shown in the examples of record, 'is probative in determining whether a term or phrase would be perceived in the marketplace as a trademark or as a widely used message.'" The Board concluded that:

> The record before us establishes that the word FUCK expresses well-recognized familiar sentiments and the relevant consumers are accustomed to seeing it in widespread use, by many different sources, on the kind of goods identified in the [applications at issue]. Consequently, we find that it does not create the commercial impression of a source indicator, and does not function as a trademark to distinguish Applicant's goods and services in commerce and indicate their source.

Accordingly, the Board affirmed the refusals to register.

Mr. Brunetti appealed. We have jurisdiction under 28 U.S.C. § 1295(a)(4)(B).

DISCUSSION

We review the Board's decision in accordance with the standards of the Administrative Procedure Act ("APA"). *Bridgestone/Firestone Rsch., Inc. v. Auto. Club De L'Quest e La France*, 245 F.3d 1359, 1361 (Fed. Cir. 2001) (citing *Dickinson v. Zurko*, 527 U.S. 150, 152 (1999)). We evaluate the Board's legal conclusions de novo. *In re HOTELS.COM, L.P.*, 573 F.3d 1300, 1302 (Fed. Cir. 2009). We uphold the Board's factual findings unless they are arbitrary, capricious, an abuse of discretion, or unsupported by substantial evidence. *Id.* "The [APA] . . . establishes a scheme of 'reasoned decisionmaking,'" which requires that "the process by which [an agency] reaches [a] result must be logical and rational." *Allentown Mack Sales & Serv., Inc. v. NLRB*, 522 U.S. 359, 372 (1998) (quoting *Motor Vehicle Mfrs. Ass'n of United States, Inc. v. State Farm Mut. Auto. Ins. Co.*, 463 U.S. 29, 52 (1983) ("*State Farm*")).

We reject most of Mr. Brunetti's arguments but conclude that the Board has failed to articulate a satisfactory explanation for its action.

I

We begin by considering Mr. Brunetti's arguments that the Board violated various constitutional rights and that the Supreme Court's decision in *Iancu v. Brunetti*, 588 U.S. 388 (2019), dictates the outcome of this case. We find these arguments unpersuasive.

First, Mr. Brunetti argues that the PTO has violated the First Amendment by engaging in viewpoint discrimination because it has allowed trademark registration of "positive terms," such as FUCK CANCER and LOVE, while refusing registration of "negative terms" or "profanity," such as the applied-for mark. Appellant's Br. 52–53 (citing *Iancu v. Brunetti*, 588 U.S. 388 (2019); *Matal v. Tam*, 582 U.S. 218 (2017)). The Board explained that the focus of a failure-to-function refusal is "whether the relevant consumers perceive [the applied-for mark] as a trademark" and that such a "refusal applies evenhandedly, regardless of any viewpoint expressed." Mr. Brunetti has identified no basis for concluding that the Board's analysis in this case deviated from that viewpoint-neutral principle.

Second, Mr. Brunetti argues that the PTO is retaliating against him for exercising his "right to petition" the courts for redress. Mr. Brunetti appears to be referring to his prior case addressed by the Supreme Court in *Iancu v. Brunetti*, 588 U.S. 388 (2019), where Mr. Brunetti prevailed and the Supreme Court held that the PTO had erred in declining to register the mark FUCT on the ground that it was "immoral or scandalous" within the meaning of 15 U.S.C. § 1052(a). *Brunetti*, 588 U.S. at 390 (holding that section 1052(a) bar to registration of "immoral[ ] or scandalous" trademarks violated the First Amendment). Mr. Brunetti's sole evidence of retaliation is that the refusals in this case came after his Supreme Court victory. We conclude Mr. Brunetti has failed to show the Board's decision in this case is retaliatory.

Third, Mr. Brunetti appears to argue that *Iancu v. Brunetti* dictates the outcome of this case. We disagree. *Iancu v. Brunetti* addressed a different legal issue (the constitutionality of a prohibition on scandalous words) than is present in this case (failure to function as a mark). 588 U.S. at 390. It also addressed a fundamentally different mark (FUCT as compared to FUCK). The applied-for mark in this case is a well-defined and widely used word. FUCT, on the other hand, is not a word at all; it is wordplay on its "phonetic twin[,] . . . 'fucked,'" *In re Brunetti*, 877 F.3d 1330, 1338 (Fed. Cir. 2017), *aff'd sub nom. Iancu v. Brunetti*, 588 U.S. 388 (2019). *Iancu v. Brunetti* thus did not answer the question in this case: whether the Board erred in determining the applied-for mark fails to function as a trademark. Additionally, Mr. Brunetti's successful registration of the FUCT mark, *see* U.S. Trademark Registration No. 6230977 (registered Dec. 29, 2020), does not guarantee him the ability to register a separate and fundamentally different mark.

II

Mr. Brunetti next appears to argue that, in affirming the examining attorney's refusals, the Board improperly created an "entirely novel" failure-to-function doctrine "wherein there are some words or phrases that just can never be registered for any goods or services because the terms are allegedly 'too widely-used.'"

A

The registrability of a trademark is governed by the Lanham Act. *See* 15 U.S.C. §§ 1051, 1052. By definition, a "trademark" must indicate a product's source:

> The term "trademark" includes any word, name, symbol, or device, or any combination thereof— (1) used by a person, or (2) which a person has a bona fide intention to use in commerce . . . , to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

15 U.S.C. § 1127. It is thus "a threshold requirement of registrability that [an applied-for] mark 'identify and distinguish' the goods and services of the applicant from those of others, as well as 'indicate the source' of those goods and services." *In re GO & Assocs., LLC*, 90 F.4th 1354, 1356 (Fed. Cir. 2024) (quoting 15 U.S.C. § 1127); *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 146 (2023) ("[A] trademark is not a trademark unless it identifies a product's source (this is a Nike) and distinguishes that source from others (not any other sneaker brand).").

To distinguish one producer's goods or services from another's, and thus be a registerable trademark, a proposed mark must be "distinctive," either inherently or through the acquisition of secondary meaning. 1 J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* § 4:13 (5th ed.) ("McCarthy"). "Distinctiveness is often expressed on an increasing scale: Word

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marks 'may be (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful.'" *United States Pat. & Trademark Off. v. Booking.com B.V.*, 591 U.S. 549, 553 (2020) (quoting *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992)). "A mark that is, for example, generic or descriptive, fails to function as a source identifier, though descriptive marks can be registered if they have acquired secondary meaning in the perception of consumers." *In re Vox Populi Registry Ltd.*, 25 F.4th 1348, 1351 (Fed. Cir. 2022) (citations omitted).[8]

[8] "To establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself." *Inwood Lab'ys, Inc. v. Ives Lab'ys, Inc.*, 456 U.S. 844, 851 n.11 (1982). The Supreme Court has explained that a mark that otherwise fails to indicate a source may become sourceidentifying by attaining secondary meaning. *See, e.g.*, *Qualitex*, 514 U.S. at 166 (explaining that a color alone can "distinguish[] a firm's goods and identif[y]" if it develops secondary meaning).

But "the source identifier requirement is broader than just whether a proposed mark is generic or descriptive." *Vox*, 25 F.4th at 1351. The Supreme Court and our court have recognized that a claimed mark that does not serve as a source identifier cannot be registered under the Lanham Act. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162–64 (1995) ("It is the source-distinguishing ability of a mark . . . that permits it to serve the[] basic purposes [of trademark law]."); *GO*, 90 F.4th at 1356 ("If the nature of a proposed mark would not be perceived by consumers as identifying the source of a good or service, it is not registrable."); *Vox*, 25 F.4th at 1350–51 ("[T]he source identifier and descriptiveness inquiries are 'complementary and opposite sides of the same coin to the extent that a mark . . . is "merely descriptive" of the goods.'" (quoting *In re Cooper*, 254 F.2d 611, 613 (CCPA 1958)). It is thus well-established that an applied-for mark that does not serve as a source identifier fails to function as a trademark and should be refused federal trademark registration.

The source-identifier inquiry "typically focuses on how the mark is used in the marketplace and how it is perceived by consumers." *GO*, 90 F.4th at 1356. Whether or not a proposed mark functions as a source identifier is a question of fact that we review for substantial evidence. *Id.* at 1357. At least as an initial matter, the examining attorney bears the burden to establish a prima facie case of failure to function.[9]

[9] The Board explained that "[t]he Examining Attorney is required to establish a reasonable predicate for his position—i.e., a prima facie case—that FUCK is not registrable" and, after the examining attorney made such a showing, Mr. Brunetti was required to rebut it by "com[ing] forth with competent evidence that consumers would perceive the proposed mark as a source identifier." Neither party here disputes that the examining attorney had the initial burden to establish a prima facie case of failure to function. Because we conclude the Board erred in assessing the examining attorney's prima facie case, we do not address the correctness of the Board's burden-shifting framework.

B

Mr. Brunetti argues that the Board misconstrued the failure-to-function doctrine in holding that marks cannot be registered if they are "widely-used commonplace terms." Neither the examining attorney nor the Board made such a holding.

The examining attorney explained that the basis for the refusals was that "the applied-for mark [was] a slogan or term that [did] not function as a trademark or service mark to indicate the source of applicant's goods and/or services and to identify and distinguish them from others." The Board's affirmance similarly was based on the applied-for mark's failure to distinguish the goods and services of the user from those of others, i.e., its failure to function as a trademark. The Board made clear that "commonality . . . is not the test" for determining whether an applied-for mark functions as a trademark.

This is correct under our caselaw—the fact that a mark is a commonplace word is itself not a ground for refusing registration. Courts have repeatedly explained that arbitrary or suggestive marks consisting of only a commonplace word or phrase, such as CAMEL for cigarettes, can be inherently distinctive and thus registered on the principal register.[10] *See, e.g.*, *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 209–11 (2000) (noting inherent distinctiveness of "arbitrary" marks such as "Camel" cigarettes). The Board's decision appropriately acknowledged that the "commonality" of a word or phrase alone cannot form the basis of a refusal to register an applied-for mark.

[10] Arbitrary word marks are "words in common linguistic use but which, when used with the goods or services in issue, neither suggest nor describe any ingredient, quality or characteristic of those goods or services," such as "APPLE for computers and other electronic goods" and "SHELL for gasoline." 1 McCarthy § 11:11. "Marks[] . . . that are '"arbitrary" ("Camel" cigarettes), "fanciful" ("Kodak" film), or "suggestive" ("Tide" laundry detergent)'[] may be placed on the principal trademark register because they are 'inherently distinctive.'" *Booking.com*, 591 U.S. at 553 (quoting *Wal-Mart*, 529 U.S. at 210–11).

Mr. Brunetti also suggests that the Board's decision cannot be sustained under the informational matter doctrine. The Board's failure-to-function analysis in this case is similar to, but not identical to, an informational matter refusal. The Board has held that "[s]logans and other terms that are considered to be merely informational in nature[] . . . are not registrable." *In re Eagle Crest, Inc.*, 96 U.S.P.Q.2d 1227, 2010 WL 3441109, at *2 (T.T.A.B. 2010). But in those cases, the proposed marks conveyed recognized information. In affirming the refusals here, the Board relied on its determination that the applied-for mark "is arguably one of the most expressive words in the English language" and that it is used "to convey a wide[] range of recognized concepts and sentiments." Unlike the proposed marks refused as merely informational matter, the applied-for mark in this case does not convey a single idea or a complete piece of information, nor did the Board analyze it as such.

[11] *See Eagle Crest*, 2010 WL 3441109, at *5 (refusing registration of ONCE A MARINE, ALWAYS A MARINE for clothing because "[t]he primary function of this familiar Marine slogan . . . is[] to express support,

> admiration, or affiliation with the Marines"); *D.C. One Wholesaler, Inc. v. Chien*, 120 U.S.P.Q.2d 1710, 2016 WL 7010638, at *7 (T.T.A.B. 2016) (refusing registration of I ♥ DC for bags, clothing, and plush toys "[b]ecause the nature of the phrase will be perceived as informational[] and . . . because the ubiquity of the phrase . . . has given it a significance as an expression of enthusiasm"); *In re Volvo Cars of N. Am., Inc.*, 46 U.S.P.Q.2d 1455, 1998 WL 239298, at *5 (T.T.A.B. 1998) (refusing registration of DRIVE SAFELY for cars and car parts because the phrase "would be regarded simply as a familiar safety admonition, particularly when used in connection with automobiles"); Trademark Manual of Examining Procedure (July 2022) § 1202.04(b) (precluding from trademark protection "informational matter," such as slogans, terms, and phrases used by the public to convey familiar sentiments, because consumers are unlikely to "perceive the matter as a trademark or service mark for any goods and services").

III

The broad spectrum of marks about which the Board is concerned here is clear enough. The Board focused on the applied-for mark's use as an "all-purpose word." App'x 38–39 (citation omitted); *see also id.* ("FUCK is no ordinary word, but rather one that has acquired a multitude of recognized meanings since its first recorded use[] . . . ."). We refer to such words with many meanings as "all-purpose word marks." We see no error in the Board's fact determination that the record demonstrates the "the ubiquity of the term FUCK as an expression to convey a wide[] range of recognized concepts and sentiments."

But Mr. Brunetti argues that the Board erred by allowing the registration of some all-purpose word marks while inexplicably denying registration of others, including registrations for the word FUCK, without any explanation as to the difference. For example, Mr. Brunetti argues that the PTO has registered other marks consisting only of a ubiquitous word that has a variety of meanings, such as LOVE, and that "all of the 100 most common words in English are registered."; *see also*, *e.g.*, U.S. Trademark Registration

No. 2191439 (LOVE in standard characters registered for "fresh fruit and vegetables" on September 22, 1998). In fact, he argues that the applied-for mark, FUCK in standard characters, has been registered by a third party for goods in International Class 28, "[s]now globes; [t]oy snow globes," U.S. Trademark Registration No. 6172195 (registered Oct. 13, 2020), and then by another party for goods in International Class 30, "[g]ummy candies," U.S. Trademark Registration No. 7344225 (registered Apr. 2, 2024), after the Board's decision in this case was published.

On appeal, the PTO does not dispute the existence of these registrations. It admits that "the [PTO] has registered other marks including FUCK or other common words," but argues that our cases have consistently recognized that the PTO need not reconcile all past cases with the case under consideration.

We have recognized that a decision of the Board may not be challenged on the ground that examining attorneys in other cases may have made erroneous rulings. *See, e.g.*, *In re Cordua Rests., Inc.*, 823 F.3d 594, 600 (Fed. Cir. 2016); *In re Nett Designs*, 236 F.3d 1339, 1342 (Fed. Cir. 2001). Understanding the basis and scope of this principle requires some understanding of the structure of PTO trademark examination. In 2022, there were over 700 examining attorneys charged with addressing trademark registration applications. *See* U.S. Patent & Trademark Office, Fiscal Year 2022 Agency Financial Report 20 ("2022 Financial Report"). If the examining attorney issues a final decision refusing registration of the application, appeal is available to the Board, 15 U.S.C. § 1070, which is comprised of administrative trademark judges and certain other high-level PTO officers, *id.* § 1067(b). The Board issues precedential decisions (such as the decision here), which are binding on the Board, and nonprecedential decisions, which are not binding.

Our decisions recognize that, through examiner error, some marks are granted that should not have been granted, making it impossible to require the PTO to assure consistency among all examining attorney decisions. We have explained that "[t]he PTO is required to examine all trademark applications for compliance with each and every eligibility requirement, . . . even if the PTO earlier mistakenly registered a similar or identical mark suffering the same defect." *Cordua*, 823 F.3d at 600; *see also Nett*, 236 F.3d at 1342 ("Even if some prior registrations had some characteristics similar to [the application], the PTO's allowance of such prior registrations does not bind the Board or this court."). To that end, we have explained that "[e]ach application for registration must be considered on its own merits." *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 1569 (Fed. Cir. 1987); *accord Nett*, 236 F.3d at 1342; *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1127 (Fed. Cir. 1985); *In re Loew's Theatres, Inc.*, 769 F.2d 764, 769 (Fed. Cir.1985). This does not mean that the Board need not take account of prevailing practice. The Supreme Court recently in *Booking.com* explained that the PTO must consider its "own past practice" in developing a "comprehensive rule." 591 U.S. at 558.

Nor does this mean that the Board has no obligation to develop coherent and rational rules for the guidance of examining attorneys and the Board in other proceedings. Like other agencies, the Board "must examine the relevant data and articulate a satisfactory explanation for its action including a 'rational connection between the facts found and the choice made.'" *State Farm*, 463 U.S. at 43 (quoting *Burlington Truck Lines v. United States*, 371 U.S. 156, 168 (1962)).

In addition, to enable us in our role of judicial review, the Board must make "sufficient findings and reasoning to permit meaningful appellate scrutiny"—a requirement that applies with equal force to issues of law and issues of fact. *Gechter v. Davidson*, 116 F.3d 1454, 1458 (Fed. Cir. 1997) (vacating decision of the Board of Patent Appeals and Interferences); *Nazomi Commc'ns, Inc. v. Arm Holdings, PLC*, 403 F.3d 1364, 1371 (Fed. Cir. 2005); *see also Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 970 (Fed. Cir. 2015) (explaining that judicial review under the substantial evidence standard "can only take place when the agency explains its decisions with sufficient precision, including the underlying factfindings and the agency's rationale" (quoting *Packard Press, Inc. v. Hewlett– Packard Co.,* 227 F.3d 1352, 1357 (Fed. Cir. 2000))); *SEC v. Chenery Corp.*, 318 U.S. 80, 94 (1943) ("[T]he orderly functioning of the process of review requires that the grounds upon which the administrative agency acted [be] clearly disclosed and adequately sustained."); *Allentown Mack*, 522 U.S. at 374 ("[A]djudication is subject to the requirement of reasoned decisionmaking . . . .").

For all these reasons, the Board must provide rational guidance that is sufficiently explained. *See, e.g.*, *State Farm*, 463 U.S. at 43. That guidance is missing here. The Board consistently dismissed Mr. Brunetti's reliance on other registered marks by explaining that "the cited thirdparty registrations for other single word marks, perceived in a vacuum without any contextual information, are not relevant to our determination of whether FUCK functions as a mark for the applied[-]for goods and services." But the Board did not explain what such contextual information might be. The Board also contemplated that Mr. Brunetti could "come forward with competent evidence that consumers would perceive the proposed mark as a source identifier" to rebut the examining attorney's prima facie showing. Again, the Board did not indicate what that evidence would be. The Board determined that Mr. Brunetti failed to meet a standard, but it did not articulate what that standard would be. In other words, the Board's decision is unclear as to the circumstances under which all-purpose word marks can be registered and which are "inherently incapable of being regarded as [a] source indicator[]."

The Board's reasoning in this case suggests that the Board has concluded that it need not articulate a viable registration standard. The apparent inconsistency of past examining attorneys' decisions with respect to the registration of all-purpose word marks is itself strong evidence of the failure to articulate coherent rules and engage in reasoned decisionmaking.

The Board's reasoning sounds in fact very much as though it has taken an "I know it when I see it" approach to failure-to-function refusals. Such an approach is inconsistent with the Board's mandate to engage in reasoned decisionmaking under the APA. *Pearson v. Shalala*, 164 F.3d 650, 660–61 (D.C. Cir. 1999) (holding invalid FDA's interpretation of regulation where FDA took "I know it when I see it" approach to the term "significant scientific agreement"); *Stanojkova v. Holder*, 645 F.3d 943, 949 (7th Cir. 2011), *as amended* (Aug. 16, 2011) (explaining that "I know it when I see it" approach of the Board of Immigration Appeals resulted in

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"capricious adjudication"); *see also In re Scheer,* 819 F.3d 1206, 1210 (9th Cir. 2016) ("It is fair to say that the 'I know it when I see it approach' of [a prior precedent] has led to predictably unpredictable results.").[16]

[16] To be sure, our own decisions have provided some limited but incomplete guidance. We have explained that marks containing informational matter may be registerable so long as they are also source-identifying by conveying matter that is associated with a particular source of goods and services. *GO*, 90 F.4th at 1358. In *GO*, we recognized that many "widely used slogans" are valid marks because they serve dual functions, both conveying information and indicating source. *Id.* (providing as examples Donald Trump's MAKE AMERICA GREAT AGAIN, Nike's JUST DO IT, DeBeers' A DIAMOND IS FOREVER, and Verizon's CAN YOU HEAR ME NOW?).

We have also suggested that the stylization of a mark and its placement on marked goods or in advertisements for services may impact its ability to operate as a source identifier. In *Vox*, we explained that "[d]esign or stylization may make an otherwise unregistrable mark registrable if the features 'create an impression on the purchasers separate and apart from the impression made by the words themselves.'" 25 F.4th at 1353 (quoting *Cordua*, 823 F.3d at 606); *see also* 1 McCarthy § 3:4.

We note that in concluding that the examining attorney established a prima facie case that consumers would not perceive the applied-for mark as indicating the source of the applied-for goods and services, the Board relied in part on the fact that the applied-for mark has been used by other entities in the past on commercial listings for goods falling within the claimed categories. As the Board explained, the "record in this case demonstrates that a variety of sources prominently display the term FUCK on a wide range of consumer merchandise and household items, including the kinds of goods identified in [Mr. Brunetti's] Applications . . . ." The Board's reliance on this factor—prior third-party use of the applied-for mark for the applied-for goods or services in the marketplace—was appropriate under our caselaw. *See GO*, 90 F.4th at 1357 (concluding that "the Board properly considered both [the applicant's] uses and third-party uses when assessing how the public would likely perceive the [applied-for] mark"). It was also proper for the Board to consider that Mr. Brunetti could not "appropriate the term exclusively . . . , denying others the ability to use [the applied-for mark] freely."

But the Board's reliance on third-party use does not create a coherent standard. We conclude the Board failed to provide sufficient precision in its rationale for why some commonplace words can serve as a mark, but others, such as FUCK, cannot. The Board's lack of clarity in this regard is especially troubling given the increasing number of failure-to-function refusals in recent years. Without a clearer explanation, we are unable to determine whether substantial evidence supports the Board's determination that the applied-for mark fails to function as a source identifier. Accordingly, remand is required.

CONCLUSION

We have considered Mr. Brunetti's remaining arguments and find them unpersuasive. We vacate the Board's decision and remand for further proceedings consistent with this opinion.

VACATED AND REMANDED

LOURIE, *Circuit Judge*, dissenting.

"[A] trademark is not a trademark unless it . . . tells the public who is responsible for a product." *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140, 146 (2023); *see* 15 U.S.C. § 1127 (a trademark must "indicate the source" of the applicant's goods and "distinguish [the applicant's] goods . . . from those manufactured or sold by others"). Substantial evidence supports a conclusion that the f-word[1] cannot do so for the classes of goods in Brunetti's applications. I therefore respectfully dissent.

[1] Brunetti's applications use the f-word in full. Application Serial Nos. 88308426, 88308434, 88308451, 88310900.

As the record shows, the word is widely used to express an innumerable range of "well-recognized familiar sentiments." *In re Brunetti*, No. 88308426, 2022 WL 3644733, at *21 (T.T.A.B. Aug.

22, 2022) (the word is used generally as an "intensifier to express extremes of emotion, negative and positive (e.g., shock), to note disdain, sadness, confusion, panic, boredom, annoyance, disgust, or pleasure; to insult or offend; and to evoke other emotions") (cleaned up). And the word is frequently used in connection with the classes of goods in Brunetti's applications. *E.g.*, *id.* at *10– 11 (showing the word used on bags, jewelry, cellphone cases, etc.). Because of its ubiquity, consumers cannot specifically associate the word with Brunetti's brand. *See id.* at *21–22.

Brunetti argues that the widely-used words and phrases that the PTO has registered, "love" and "f[] cancer," support his position. But those examples demonstrate why Brunetti's applications were correctly rejected here. "Love," as Brunetti points out, is one of the most common words in the English language. Critically though, "love" does not carry a wide variety of meanings. Rather, it is used to convey primarily one thing—a strong feeling of attachment. "F[] cancer" is similarly limited. By adding the word "cancer," the meaning of the phrase is substantially narrowed to signify a passionate displeasure for the disease. Such words and phrases are not so ubiquitous as to be incapable of acting as a source identifier. This case is different. The f-word is primarily an explicative, expressive of a variety of definitions, or none at all.

The majority well points out shortcomings in the Board's analysis of the failure to function issue. But anyone living in today's society of degraded language can readily tell that the f-word does not indicate the source of the proposed trademarked goods and distinguish them from goods of another. If the Board's overall analysis needs sharpening, this case, which has been pending for most of a decade, surely isn't one in which we need more help from the Board to know the right answer under the law. There will be better cases in which we need more guidance from the Board in order to properly review its decisions.

For the above reasons, I dissent from the majority's decision to vacate a decision that should be affirmed.

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