

Mailing:
August 17, 2004

This Opinion is Not
Citable as Precedent
of the TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Dorel Juvenile Group, Inc.¹

Serial No. 76237565

Julia Spoor-Gard, Amanda Pecchioni Thompson, and Erin Roth Bohannon of Barnes & Thornburg for Dorel Juvenile Group, Inc.

Julie A. Watson, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Simms, Bottorff and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

In April 2001, Safety 1st, Inc. applied to register the following as a mark for goods ultimately identified as "plastic novelty signs."



¹ Documents recorded in the USPTO Assignment Branch indicate that Safety 1st, Inc. has merged into Dorel Juvenile Group, Inc.

Ser No. 76237565

The application, filed April 9, 2001, recites that the proposed mark was first used and was first used in commerce as of September 10, 1984. As filed, the application did not include a statement describing the mark or explaining the significance of the stippling in the mark, and did not state how the mark is used.

As a specimen showing use of the mark, applicant submitted one of its signs. It is yellow and it looks precisely the same as the drawing of the mark reproduced herein, except that the actual sign includes a suction cup centered in the top corner (for affixing the sign to car windows, according to the package instructions), displays a slogan in much smaller letters below the word BOARD! ("Safety 1st® puts Children 1st"), and bears an even smaller copyright notice on the right side of the bottom corner ("© 1998 Safety 1st").

The sign is encased in clear plastic and attached to a card suitable for hanging on a display rack. The card includes a photo of the rear window of a car sporting one of the signs. At the top of the card is the designation "Safety 1st," and just below this is the legend "Baby on Board Sign," and then, in smaller lettering, the phrase "Reminds others to drive safely." Consumers might view "Baby on Board Sign Reminds others to drive safely" as one

phrase or, because the phrase "Baby on Board Sign" is in larger letters and underscored by a line, may view that as separate from "Reminds others to drive safely."

In her first office action, the examining attorney refused registration on the ground that the design proposed for registration is incapable of functioning as a mark and "is nothing more than informational matter." This refusal was stated to be based on Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052 and 1127. The examining attorney also required applicant to submit a color lining statement and a proper specimen showing use of the proposed mark, as illustrated by the specimens. Specifically, the examining attorney noted that the specimen included the "Safety 1st® puts Children 1st" slogan under the word BOARD!, while the drawing of the mark did not. In essence, the examining attorney required applicant to submit a substitute specimen showing the BABY ON BOARD! design without the noted slogan.

By its response to the first office action, applicant amended the application to include a statement that the drawing of the mark is lined for the color yellow and to seek registration under Section 2(f), 15 U.S.C. § 1052(f). The latter amendment was based on a declaration from applicant's general manager, who asserts that the mark has

been in continuous and substantially exclusive use for, at the time of the declaration, 18 years, that millions of its signs have been sold in, and continue to be sold in, all 50 states and "many international markets," and that articles about the sign and its popularity have appeared in numerous publications.²

The examining attorney maintained the refusal, arguing that the proposed mark is not registrable on the Principal Register, even under Section 2(f), and is not registrable on the Supplemental Register. She also maintained the requirement for a new specimen. When the substantive refusal and the requirement for a new specimen eventually were made final, applicant appealed. Applicant and the examining attorney filed briefs, but applicant did not request an oral hearing.

The examining attorney, in her brief, has withdrawn the requirement that applicant submit a new specimen. Thus, the only issue before us is the question whether the matter presented for registration functions as a mark.³

² The declaration lists seven publications that purportedly contained articles about applicant's sign, and the declaration states that copies are enclosed, but copies of the articles were not submitted.

³ It appears the examining attorney's concern with the specimen was actually a concern with the drawing, i.e., concern that the drawing represented a mutilation of the mark as used because it did not show significant matter present on applicant's actual

The record includes, apart from the application, drawing and specimen: the declaration of applicant's general manager; reprints of web pages from applicant's web site; reprints of certain other web sites alleged by applicant to establish recognition of its design as a mark; reprints of information retrieved from USPTO records regarding the registration of marks including the term ON BOARD and, in particular, two registrations for BABY ON BOARD⁴; web pages from www.cafeshops.com, featuring maternity clothes and a wide variety of collateral products bearing a BABY ON BOARD design identical to applicant's, but without an exclamation point⁵, such pages being alleged by applicant to be "an example of how BABY ON BOARD is used as a trademark" and to show "that the public recognizes the

novelty sign. The examining attorney apparently was not concerned that the composite phrase and design is not actually used on the packaging for the product and "appears" only as the product itself. Of course, when an applicant seeks registration of its product's design, there need not be use on a hang tag, display card or the like, for the product itself is also the mark.

⁴ Registration no. 2007828 is for BABY-ON-BOARD in typed form and covers certain prenatal health care coordination services; Registration no. 1440672 is for BABY ON BOARD [no hyphens], also in typed form, for "maternity clothing, namely shirts, tops, and swimsuits." Applicant owns neither; and they are owned by different entities.

⁵ These pages feature products of an entity designated as www.Materni-Tee.com, and show a "TM" designation not on the designs that are on the products, but on the web pages adjacent to the listings of the various BABY ON BOARD products.

Ser No. 76237565

trademark significance of BABY ON BOARD" (March 31, 2003 response to second office action, p. 9).

There is only one procedural issue relative to the record to resolve. Applicant first referenced certain third-party registrations in its brief. These registrations are for slogans applicant says "suggest a cautionary course of action" but which applicant says are suggestive and stand as evidence that applicant's mark, too, should be registered. These registrations, being referenced by list alone, have not been properly made of record. Moreover, all evidence to be considered in an ex parte appeal must be made of record prior to the appeal. See Trademark Rule 2.142(d), 37 C.F.R. 2.142(d). Accordingly, the examining attorney's objection to consideration of these registrations is entirely proper and we have not considered them.

The Court of Customs and Patent Appeals, a predecessor to our primary reviewing court, the Court of Appeals for the Federal Circuit, long ago stated, "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." *In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1976), *citing* *In re Standard Oil Co.*, 275

Ser No. 76237565

F.2d 945, 125 USPQ 227 (CCPA 1960). 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., In re Volvo Cars of North America 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); and In re Manco Inc., 24 USPQ2d 1938, 1941-42 (TTAB 1992)(Refusals to register THINK GREEN and composite THINK GREEN and design affirmed because, rather than be regarded as indicators of source, they would be regarded as "slogan of environmental awareness and/or ecological consciousness").

In the case at hand, the examining attorney has chiefly analogized applicant's design to the DRIVE SAFELY phrase in Volvo and to the WATCH THAT CHILD phrase refused registration in In re Tilcon Warren, Inc., 221 USPQ 86 (TTAB 1984). In the final refusal of registration, she states: "[T]he proposed mark is merely informational in nature. When displayed in a car it reminds other[s] to drive safely," and "merely conveys the message of a familiar safety slogan to which consumers would give its ordinary meaning - that it is a slogan uniquely suitable to be displayed on vehicles carrying babies or young

children." The examining attorney also contends that the yellow color of applicant's design is commonplace for signs intended to frame alerts or warnings, and the diamond shape is a common, non-distinctive shape.

Finally, as in the case of *In re Wakefern Food Corp.*, 222 USPQ 76 (TTAB 1984), wherein the Board affirmed a refusal to register the phrase WHY PAY MORE for supermarket services, noting, inter alia, that the "familiar phrase" would be perceived as suggesting only that the applicant offered lower prices in its stores, while its SHOP RITE sign would be seen as the indicator of origin, in this case the examining attorney asserts that the phrase "Safety 1st® puts Children 1st," which appears on the instant applicant's sign just below the phrase BABY ON BOARD!, is the matter that would be perceived as the indicator of origin.

Applicant has advanced numerous arguments against the refusal of registration, which we consider in turn.⁶

First, applicant argues that the examining attorney has not borne the burden of proof the USPTO must bear in refusing registration. Specifically, applicant asserts

⁶ Applicant has advanced many of the same arguments in its responses to office actions and in its briefs, though not always in the same way or the same order. Our discussion of applicant's arguments is an attempt to summarize them as best we can, but we do not make any presumptions about which are most important to applicant and the order of presentation should not be deemed to suggest anything about the relative merits of the arguments.

that the only items relied on by the examining attorney are applicant's specimens and reprints from applicant's website. No particular quantity of evidence, however, is necessary for the examining attorney to carry her burden of proof. To the extent that applicant is arguing that the examining attorney has not put in evidence to establish that BABY ON BOARD! is a commonplace phrase or safety admonition, we agree that the record does not support such a conclusion. This does not, however, establish that applicant's sign, sans the "Safety 1st® puts Children 1st" slogan, would be viewed as anything more than informational. In other words, it is not a linchpin for the refusal that the examining attorney establish that BABY ON BOARD! is a commonplace or familiar phrase.

Second, applicant argues that the phrase BABY ON BOARD! is suggestive not descriptive and doesn't impart any information about the sign's function, purpose or features. This is not, however, a case like Wakefern, wherein there were two refusals, first that WHY PAY MORE failed to function as a mark and, second, that it was descriptive. In this case, the examining attorney did not issue a descriptiveness refusal. Moreover, as we know from Wakefern, a phrase may be found suggestive, rather than descriptive, and still not be used in a manner where it

would be perceived as a mark. Finally, this application does not present only a slogan or phrase for registration. Rather, it seeks to register the major elements (diamond shape, yellow color, and most visually prominent words) of applicant's actual sign, so our focus is not on the phrase alone.⁷ In short, the argument that the phrase is suggestive is inapposite to the question at hand.

Third, applicant argues that the examining attorney is incorrect in asserting that applicant's signs inform those who see the signs to drive safely. In this, we agree with applicant, notwithstanding that applicant's specimen contains the statement "Baby On Board Sign Reminds others to drive safely." In terms of the information that the proposed mark imparts, it is not the exhortation to "Drive Safely" but that the vehicle bearing the sign contains a baby or young child, presumably in a seat other than that behind the wheel. That the examining attorney has misstated the nature of the information the proposed mark imparts does not undermine the refusal.

Fourth, applicant contends that a proposed mark need not identify the name of the source of a product, i.e., it

⁷ As the proposed mark aptly depicts the major elements of applicant's plastic novelty sign, it certainly does immediately inform prospective purchasers of the shape, color and most visually prominent message on the sign.

need not be a trade name or house mark or identifier of a particular source but, rather, it is sufficient qualification for registration of a slogan or phrase if it identifies a single, even if anonymous source. We do not disagree with the statement as a proposition of law, but it begs the question at hand, i.e., whether applicant's proposed mark would be perceived as an indicator of source or merely informational insofar as it consists merely of a representation of applicant's actual sign.

Fifth, applicant contends that there is no need for its competitors to utilize the proposed mark, and that the examining attorney has not proffered any evidence of such need. While such need might provide additional support for a refusal under Sections 1, 2 and 45, see Volvo, *supra*, its absence from this case does not establish that the proposed mark is not merely informational and, instead, is source indicating.

Sixth, applicant argues that others actually do use the proposed mark as a mark, and that the office has even registered the phrase in its proposed mark. That others may use the proposed mark, per se,⁸ and claim it is a trademark by utilizing a "TM" designation, does not

⁸ This argument relates to the use of a design virtually identical to applicant's by www.Materni-Tee.com.

establish that it is in fact a trademark as so used. Moreover, even presuming that it is a trademark when used on maternity clothes and collateral items, this does not establish that the design serves as a mark when used as the design of a novelty sign.⁹ As for the registrations, it is, of course, well settled that each case is taken on its own merits. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). Moreover, the two registrations are for the phrase alone, not the design of a sign, and are for different types of goods or services.

The seventh argument we consider may or not have been intended by applicant for us to consider on appeal. That relates to whether its proposed mark has acquired distinctiveness under Section 2(f). In response to the initial office action, applicant amended the application to seek registration under Section 2(f). The amendment was not made conditionally or to stake out an alternative position. The examining attorney responded by stating that she did not need to consider the Section 2(f) evidence, because it could not overcome a refusal under Sections 1, 2 and 45. In a subsequent response, applicant appeared to

⁹ We note again that applicant's specimen does not show use of the proposed mark as a logo on packaging or a hang tag or the like, but only "appears" as the product itself.

assert that it should be able to argue acquired distinctiveness in the alternative and that even if the phrase BABY ON BOARD! were found merely informational, it should be able to register the composite mark with a claim of acquired distinctiveness, in part, as to its design elements. This argument is a non sequitur, as it does not follow that a claim of acquired distinctiveness as to a design element would overcome a finding that words were merely informational. Finally, applicant did not argue the sufficiency of its evidence of acquired distinctiveness in its brief.

In Wakefern, the Board suggested that Section 2(f) evidence might indeed be irrelevant when the refusal is that a proposed mark would not be perceived as a mark. See Wakefern, 222 USPQ at 79. Subsequent to Wakefern, however, the Federal Circuit ruled, in In re Owens-Corning Fiberglas Corporation, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985), that the applicant therein could rely on a claim of acquired distinctiveness to overcome a refusal that the color pink applied to the surface of insulation did not function as a mark. Later, in Volvo, see 46 USPQ2d at 1461, the Board clearly contemplated the question whether there was direct evidence of public recognition that DRIVE SAFELY pointed to one source. See also in In re Remington

Ser No. 76237565

Products Inc., 3 USPQ2d 1714, 1715 (TTAB 1987).

Accordingly, and notwithstanding our uncertainty as to what applicant's precise position is, we have considered whether the record shows a secondary meaning in applicant's proposed mark.

The only evidence we have is the brief declaration of applicant's general manager and certain web pages. The declaration attests to sales of millions of signs, but is vague and general. It was not accompanied by any copies of the articles that purportedly recognize applicant as the source of its sign. The declaration claims continuous and substantially exclusive use of the design, but the CafePress.com web page featuring the Materni-Tee.com products shows stickers with the virtually identical design as applicant's proposed mark (without the exclamation point).¹⁰ Thus, applicant has actually provided evidence that it is not the only producer of stickers or signs bearing its design, both of which could be used on vehicles.

In addition, two of the web sites for which applicant has put in reprints actually call into question the extent

¹⁰ This vendor also markets a bumper sticker and a license plate holder that do not have the precise mark proposed for registration by applicant but do bear the phrase BABY ON BOARD.

of applicant's current sales. The www.badfads.com web site states that by 1990, few drivers believed that anyone heeded the BABY ON BOARD message and abandoned use of the signs. The www.awesome80s.com web site states that while applicant sold millions of signs in 1986 their use was passé by 1987 or '88.

Applicant places great reliance on a web site entitled "What You Need to Know About Inventors" which includes a reprint of information about applicant's involved application and states that applicant "trademarked the 'Baby on Board' logo and words in 1984." The page provides no basis for this statement, however, and we can hardly be persuaded by a third party's claim regarding what applicant may or may not have "trademarked" in 1984, when applicant itself has not claimed to have done so.¹¹ Finally, there is a "Yahoo! Shopping" web page that offers applicant's signs for sale. This states that some shoppers may remember the signs from the late 1980s and early 1990s, which suggests that sales were not robust in the intervening years, and does not, in any event, establish that shoppers actually do

¹¹ The web page may very well have focused on applicant's claim of first use in 1984 as the basis for its conclusion that applicant "trademarked" the phrase and logo in 1984. In any event, even if the web page were probative evidence, which it is not, that applicant "trademarked" the involved logo in 1984, that would not establish that there was any public recognition of the logo.

remember the signs or that they associated the signs during their heyday with any particular source.

Applicant's evidence of acquired distinctiveness is patently insufficient. Even if we were to accept as unchallenged applicant's contention that it has sold millions of signs in all 50 states, mere sales volume alone does not establish recognition of a mark and may be readily attributable to desire of purchasers to acquire the product itself. See, e.g., Remington, 3 USPQ2d at 1715 ("While applicant may have had substantial sales and advertising of its product, that does not prove recognition by the public of the subject slogan as a trademark.").

The eighth and final argument we can discern in applicant's responses to office actions and in its briefs is that it is entitled to the "benefit of the doubt" and its mark should be published for opposition. We do not, however, have any doubt to resolve in this case. Applicant's proposed mark is nothing more than a representation of its actual sign, without the references to applicant in the "Safety 1st® puts Children 1st" slogan and its copyright notice, and prospective purchasers would not view this as a trademark but would view it as a representation of the sign itself.

Ser No. 76237565

Decision: The refusal of registration under Sections 1, 2 and 45 on the ground that the proposed mark is merely informational and would not be perceived as an indicator of source is affirmed.