

THIS OPINION
IS NOT A PRECEDENT OF
THE T.T.A.B.

Mailed: 1/23/08

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Labor Ready, Inc.
v.
Randstad General Partner (US) LLC

Opposition No. 91155885
to application Serial No. 76399152
filed on April 23, 2002

James L. Vana and Matthew Schneller of Perkins Coie for
Labor Ready, Inc.

John M. Bowler and Auma N. Reggy of Troutman Sanders for
Randstad General Partner (US) LLC.

Before Seeherman, Quinn and Drost, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

Randstad General Partner (US) LLC filed an application
to register the phrase WE PUT PEOPLE TO WORK for "temporary
and permanent employment agency and staffing services."¹

Labor Ready, Inc. opposed registration of applicant's
mark on the ground of mere descriptiveness under Section

¹ Application Serial No. 76399152, filed April 23, 2002, based on
a bona fide intention to use the mark in commerce. Applicant
subsequently filed an amendment to allege use setting forth a
date of first use anywhere of June 2001, and a date of first use
in commerce of October 2001.

2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

Applicant, in its answer, denied the salient allegations of the notice of opposition. A few allegations in the pleadings merit specific mention. Opposer alleged that applicant "has not established distinctiveness in the phrase." Applicant responded by denying "that it is required to establish distinctiveness of its mark," and further stated that "Applicant specifically shows that if the establishment of distinctiveness is required to obtain protection of the mark, that such distinctiveness has been established." (Paragraph 7 in the notice of opposition and answer). Opposer also alleged that it, "as a provider of temporary manual labor services, is entitled to use the descriptive phrase 'We Put People to Work.'" In response, applicant admitted, "Opposer is entitled to make 'fair use' of the mark as such term has been defined under U.S. Trademark law." (Paragraph 9 in the notice of opposition and answer).

The record consists of the pleadings; the file of the involved application; trial testimony, with related exhibits, taken by each party;² excerpts of articles

² The depositions are replete with objections. Not a single objection was maintained in the briefs and, accordingly, we deem any objection to be waived. *Hard Rock Café International (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1507 n.5 (TTAB 2000); and *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1126 n.4 (TTAB 1990). See TBMP §707.03(c) (2d ed. rev. 2004).

Opposition No. 91155885

appearing in printed publications, applicant's responses to certain discovery requests, and official record file histories, all made of record in opposer's notices of reliance; and advertisements in printed publications introduced in applicant's notice of reliance. The record is accurately set forth in greater detail by the parties in their respective briefs. (Opposer's Brief, pp. v-vii; Applicant's Brief, p. 1-2).³ The record also includes other documents submitted by way of the parties' stipulations, including excerpts of Internet websites and transcripts of radio advertisements. The parties filed briefs, and the record includes dictionary definitions that accompany opposer's brief.⁴

Opposer is one of the nation's leading providers of temporary manual labor for the light industrial and small business markets. Opposer first used "We Put People to Work" as part of its mission statement, and the phrase began to appear in a prominent manner in opposer's marketing materials in late 2001. According to Jim Young, opposer's director of marketing and advertising, the chief executive

³ The Board, in an order dated January 16, 2007 (p. 3), struck certain documents that applicant sought to introduce. The parties acknowledged that these documents do not form part of the record in their respective summaries of the record, and we have not considered this evidence in reaching our decision.

⁴ The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

Opposition No. 91155885

officer liked the phrase because it "was a simple explanation of what we do." (Young dep., p. 33).

Applicant, in its mission statement, indicates that it seeks to be the third largest employment services company in the world. Rebecca Johnson, applicant's vice president and director of marketing, testified that applicant's services feature matching the supply and demand of the workforce needs. Ms. Johnson testified that applicant adopted the phrase WE PUT PEOPLE TO WORK in the summer of 2000 "[b]ecause it reflected our--our goals, our aspirations, our--who we are to our audiences. Who we are is what we aspire to be, what we in our culture want our people to aspire to and be." (Johnson dep., p. 22). Ms. Johnson stated, when asked about various third-party uses of WE PUT PEOPLE TO WORK or variations thereof, that she had no knowledge of any contacts between applicant and the third parties making such uses.

Opposer has standing to object to the registration of applicant's mark on the ground that it is merely descriptive. Not only did applicant admit opposer's standing (Brief, p. 3), but also the evidence establishes that the parties are engaged in providing essentially the same services.

We thus turn to the substantive merits of the opposition, namely whether the proposed phrase WE PUT PEOPLE

Opposition No. 91155885

TO WORK is merely descriptive of "temporary and permanent employment agency and staffing services."⁵

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *In re Abcor Development*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; rather, it is sufficient that the term describes one significant attribute, function or property of the goods or services. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). Whether a term is merely descriptive is

⁵ So as to be clear, despite the statement made by applicant in its answer, applicant subsequently did not claim that its mark has acquired distinctiveness under Section 2(f). Applicant has taken the position that because, in its view, opposer has failed to show by a preponderance of the evidence that applicant's mark is merely descriptive, "[t]here is no need for [applicant] to prove acquired distinctiveness or secondary meaning in the first instance...Where, as here, [opposer's] claim of mere descriptiveness is inadequately supported, the burden does not rest on [applicant] to prove acquired distinctiveness." (Brief, p. 29). In any event, even if applicant had claimed acquired distinctiveness, it would have had the burden of proof relating thereto, but the record falls short of establishing acquired distinctiveness. See *In re Andes Candies, Inc.*, 478 F.2d 1264, 178 USPQ 156 (CCPA 1973); and *In re Packaging Specialists, Inc.*, 221 USPQ 917, 920 (TTAB 1984). The evidence of significant third-party uses of the phrase "we put people to work" seriously undermines any contention by applicant that it has made substantially exclusive use of the phrase with the result that it has become distinctive of its services. See *Quaker State Oil*

Opposition No. 91155885

determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with the goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use; that a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). It is settled that "[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them. *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002). The "average" or "ordinary" consumer is the class or classes of actual or prospective customers of applicant's goods or services. *In re Omaha National Corporation*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987).

A slogan, phrase or any other combination of words may act as a trademark so long as the slogan or combination is used in a way to identify and distinguish the user's goods or services from those of others. A slogan or phrase may be merely descriptive and, thus, unregistrable on the Principal Register in the absence of acquired distinctiveness, if it

Refining Corp. v. Quaker Oil Corp., 453 F.2d 1296, 172 USPQ 361,

directly refers to a characteristic of the goods or services with which it is used. The mere descriptiveness analysis is the same for a slogan as it is with any other proposed mark. See *In re Standard Oil Co.*, 275 F.2d 945, 125 USPQ 227 (CCPA 1960). See generally J.T. McCarthy, McCarthy on Trademarks and Unfair Competition, (4th ed. 2007).

The terms comprising applicant's mark are commonly used and readily understood terms; nevertheless, we will set forth the relevant dictionary definitions of these terms:

we: I and the rest of a group that includes me.

put: to place in a specified position or relationship; to move in a specified direction.

people: human beings making up a group or assembly or linked by a common interest.

to: used as a function word to indicate movement or an action or condition suggestive of movement toward a place, person, or thing reached.

work: the labor, task, or duty that is one's accustomed means of livelihood. Syn. Employment.

Merriam-Webster's Collegiate Dictionary (10th ed. 1993).

The record includes numerous examples of applicant's use of the proposed mark WE PUT PEOPLE TO WORK in a prominent fashion in the manner of a service mark. The phrase is conspicuously displayed in various promotional

Opposition No. 91155885

materials. The record also is replete with applicant's descriptive uses of "put people to work" and slight variations thereof within text and with no capitalization, oftentimes within the same document that also shows use in a prominent fashion. These uses are particularly probative. See *In re European-American Bank & Trust Company*, 201 USPQ 788, 790 (TTAB 1979) ["We particularly note...applicant's use of the phrase 'THINK ABOUT THIS:' at the top of the ad and the phrase 'THINK ABOUT IT' as part of the regular text of applicant's ad. These usages simply serve to reinforce the ordinary meaning of the phrase 'THINK ABOUT IT.'"]. Examples of applicant's descriptive uses include the following:

We put people to work--now you can too...At Randstad, our job is simple--we put people to work...We guarantee you won't find a better place to work--or a better way to put people to work.
(*Washington Post* advertisement, July 23, 2000).

Let us put you to work today.
(Chicago suburban newspapers advertisement, May 28, 2004)

The people we put to work as Production Laborers are Talent that makes companies work.
(www.randstad.com (applicant's website))

Our passion is putting people to work, and every day we find jobs for over 200,000 members of our worldwide talent pool...We're here to put people to work.
(applicant's brochure)

Opposition No. 91155885

Meeting a company's workforce needs and putting people to work. It's what we do 217,000 times everyday throughout the world.

(Jacksonville, FL newspaper, October 24, 2002)

The people we put to work as Biochemists are Talent with a vast, educated knowledge and understanding of the chemistry of living things.
(applicant's website)

The Randstad Group operates in Europe, North America, and Asia, putting an average of 250,000 people to work everyday. The very nature of our core business--putting people to work--means Randstad plays an important role in society.
(applicant's website)

Simply put, we put people to work...In 2002, Randstad North America put 219,749 people to work and provided employment services, outsourcing and counsel to more than 100,000 American and Canadian businesses.
(applicant's 2000 "Employee Review")

As shown above, applicant itself states on its website, "[t]he very nature of our core business [is] putting people to work." Applicant's repeated uses of "we put people to work" or slight variations thereof in a narrative and descriptive fashion throughout its promotional materials corroborate the descriptive nature of the phrase. See *Hartford Fire Insurance Company v. The Structured Settlements Company*, 215 USPQ 1145, 1149 (TTAB 1982).

The record also includes uses of WE PUT PEOPLE TO WORK by competitors in the employment agency field. Opposer's

Opposition No. 91155885

evidence shows that competitors' providing employment agency and staffing services throughout the United States use the phrase "WE PUT PEOPLE TO WORK" or slight variations thereof in a prominent manner.

Opposer took the testimony of four of these third-party users. These third-party uses were prior to the first use alleged by applicant, and the uses have been continuous to the date of the testimony. In each instance, the testimony is of a person knowledgeable about the adoption and use by his/her company.

Goodwill Industries of the Southern Piedmont ("Goodwill") serves seven counties in North Carolina and South Carolina, including the Charlotte area. Among its services are job search and employment placement. Since 1998, Goodwill has used the phrase "We put people to work" as "our primary tag line" in connection with its services; the phrase has appeared on signage, and in brochures, newsletters and annual reports. This phrase has been adopted by other Goodwill organizations in additional states. According to Michael Elder, Goodwill's president and chief executive officer, the phrase means "placing people with an employer directly in a position." (Elder dep., p. 55).

Senior Recruiters and Total Healthcare Services ("Senior Recruiters") is an employment agency based in

Opposition No. 91155885

Springfield, Missouri. According to Eric Naegler, president and owner, his firm has used, since April 2000, "We're putting people to work" or "We're putting people to work everyday from the ages of Eighteen to Eighty-Two." The phrases have appeared on Senior Recruiter's website, and in handouts and brochures. Mr. Elder testified that the phrases mean, "we're effective at what we do. I mean that we put people to work. I mean that's--in generic terms, that's what an employment agency does is it puts people to work." (Naegler dep., p. 25).

Riojas Enterprises ("Riojas") is an employment agency that has rendered services in at least nine states. Carlos Riojas, its president, testified that his firm offers temporary and full-time employment services, and that since 1988, his firm has continuously used "Putting People to Work" in connection with the services. The phrase has appeared in advertisements, newsletters and brochures, and has been displayed at trade shows and job fairs. According to Mr. Riojas, "we're here to help people find a job." (Riojas dep., p. 60).

Careers USA, Inc. ("Careers USA") offers staffing and employment agency services, and since at least as early as 1983 it has used the phrase "Putting People to Work." Marilyn Ounjian, owner, testified that the services have been rendered nationwide on a continuous basis.

Opposer also introduced several examples of descriptive uses by others in connection with employment services:

Adecco's role is putting people to work.
(*Newsday*, April 9, 2000)

"We put 2 million people to work every year. That is absolutely core. That's the foundation from which we can build."
(*Milwaukee Journal Sentinel*, May 2, 1999)

We are literally changing lives and the unemployment rate in Memphis by putting people to work.
(*Commercial Appeal*, August 16, 2004)

"Staffing firms such as mine put tens of thousands of people to work in Florida each year."
(*Palm Beach Post*, October 28, 2004)

"My job is putting people to work...If they have any kind of skills, or if they are unskilled, they should be working."
(*The Cincinnati Enquirer*, December 25, 2001)

"The last half of last year was dynamite for us. The fourth quarter was our best quarter ever in terms of putting people to work."
(*Journal-Gazette*, February 15, 2004)

"Our philosophy is to help our customer get their work done and get their product out. Our job is putting people to work."
(*Business People Magazine*, January 1995)

"I'm in business to put people to work."
(*The Providence Journal*, December 1, 2004)

Who is CDI? We put people to work. We're a leading innovative provider of outsourcing solutions. We are the nation's largest provider of technical staffing services. We are the world's

largest professional search and
recruitment organization.
(Johnson dep., ex. no. 34)

"We put people to work"
(www.power-plant-jobs.com)

Outcomes - We Put People to Work
(www.dors.state.md.us)

Thus, the record shows employee staffing entities routinely using or are reported as using the phrases "we put people to work," "we are putting people to work," and other variations thereof in a descriptive manner.

Opposer further took the testimony of Frederick Newmeyer, Ph.D. in linguistics. Dr. Newmeyer has been a professor in the linguistics department of the University of Washington since 1967. Opposer offered Dr. Newmeyer as a linguistics expert. According to Dr. Newmeyer, linguistics is the study of human language, and Dr. Newmeyer's particular focus has been on syntax, "that is how words are put together to form sentences." (Newmeyer dep., p. 10). Dr. Newmeyer also has focused more recently on "pragmatics," "but it's usually or often called discourse analysis or functional linguistics, the study of how sentences are situated in a discourse context or in a social context." (Newmeyer dep., pp. 10-11).

Dr. Newmeyer testified about the meaning conveyed by applicant's proposed mark WE PUT PEOPLE TO WORK. According to Dr. Newmeyer, "we" can "only refer to [applicant]; an

advertisement would make no sense if the 'we' in the advertisement didn't refer to the advertiser." "People, given the nature of the company, can only be referring to people who have some interest in the services provided by the company. In other words, those people who are looking for work and would come to [applicant] for help." And the term "work," according to Dr. Newmeyer, has no other possible interpretation other than "gainful employment." (Newmeyer dep., pp. 13-14). The phrase, in its entirety, means, "we are successful in helping people to find employment." (Newmeyer dep., p. 15). Dr. Newmeyer further testified: "[T]he expression 'put people to work,' 'putting people to work' is understood as part of, I don't want to be too technical, everyday English conversation, that it doesn't have some kind of special sense that could only be understood in a very specific context. In other words, it shows...that 'put people to work,' 'putting people to work' is just ordinary English." (Newmeyer dep., p. 37). During the course of his testimony, Dr. Newmeyer was asked to review and offer comments on not only applicant's use of "we put people to work," but also on various third-party uses made of record. In each instance, Dr. Newmeyer interpreted the phrase in the same fashion as set forth above. Dr. Newmeyer offered these additional views:

My opinion is that the expressions,
well, two things: 'We put people to

work,' 'putting people to work'...have the same meaning. They are just variations of the phrase that have the same meaning. And secondly, that it's an ordinary English expression that's descriptive of what an employment agency does that would be understood by anybody in the particular discourse context.

Again, words are interpreted in context. Sentences are interpreted in context. In the context of an advertisement, I would say the conclusion is overwhelming that it's an employment agency that provides it. In ordinary English, it can be used in all kinds of ways because specifically, as I've said, it's an ordinary expression of English that can be used whenever it might be appropriate... "We put people to work" is ordinary English.

(Dr. Newmeyer dep., p. 58 and p. 80). Dr. Newmeyer indicated, "because of my expertise in linguistics I have a good understanding of what the average person would interpret." (Newmeyer, p. 61).

To counter Dr. Newmeyer's testimony, applicant took the testimony of James Nelems, founder of a marketing, survey and opinion research firm. Applicant retained Mr. Nelems as a marketing expert, and Mr. Nelems testified that applicant's mark is a "suggestive" mark because "[I]t suggests what the category is, but it doesn't necessarily automatically bring to mind what the product or service is." (Nelems dep., p. 13). Mr. Nelems was asked about one of applicant's promotional brochures, and he testified that if a person read the entire document, "I think they know that

Opposition No. 91155885

'we put people to work' applies to [applicant]." (Nelems dep., p. 52). He went on to say that "if a person reads the entire document, they should have a good idea of what [applicant] does." When asked if the phrase "we put people to work" as used by applicant identifies what applicant does, Mr. Nelems responded, "Well, I think, again, if you read the entire document, the 'we put people to work' makes sense, and I think maybe that is a summary way of saying in a few words the things that [applicant] does." (Nelems dep., pp. 52-53).

Opposer must prove its claim of mere descriptiveness by a preponderance of the evidence. We do not view each deposition or each item of evidence in isolation; rather, we have looked at the evidence as a whole, as if each piece of the record were part of a puzzle which, when fitted together, establishes that the involved mark is merely descriptive. Thus, the dictionary definitions, applicant's own descriptive uses, competitors' and other third-party descriptive uses, and the views of a linguistic expert, when considered as an evidentiary whole, demonstrate by a preponderance of the evidence that the phrase WE PUT PEOPLE TO WORK for "temporary and permanent employment agency and staffing services" is merely descriptive thereof. Although applicant vigorously defends the inherent distinctiveness of its phrase and maintains that the words are not

Opposition No. 91155885

"automatically linked in the ordinary human experience" to its services, applicant does concede that the phrase "may provoke some intrinsic association with making work opportunities available." (Brief, p. 17).

Applicant places individuals seeking employment into employment positions. Applicant simply has combined ordinary words to create a unitary phrase that is merely descriptive of applicant's services. We conclude that the phrase WE PUT PEOPLE TO WORK, as encountered by those individuals seeking employment, directly conveys a significant feature or purpose of applicant's services: applicant succeeds in finding employment for individuals, that is, it puts people to work. No multistage reasoning or any thought, imagination, or perception is necessary to understand this feature of applicant's services.

Decision: The opposition is sustained, and registration to applicant is refused.