

TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP)

UNITED STATES PATENT AND TRADEMARK OFFICE

April 2017

Foreword

The *Trademark Manual of Examining Procedure* (TMEP) may be downloaded free of charge from the United States Patent and Trademark Office (USPTO) website at

<http://www.uspto.gov/trademark/guides-and-manuals/tmep-archives>.

The Manual is published to provide trademark examining attorneys in the USPTO, trademark applicants, and attorneys and representatives for trademark applicants with a reference work on the practices and procedures relative to prosecution of applications to register marks in the USPTO. The Manual contains guidelines for Examining Attorneys and materials in the nature of information and interpretation, and outlines the procedures which Examining Attorneys are required or authorized to follow in the examination of trademark applications.

Trademark Examining Attorneys will be governed by the applicable statutes, the Trademark Rules of Practice, decisions, and Orders and Notices issued by the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, Commissioners, or Deputy Commissioners. Policies stated in this revision supersede any previous policies stated in prior editions, examination guides, or any other statement of Office policy, to the extent that there is any conflict.

Suggestions for improving the form and content of the Manual are always welcome. They should be e-mailed to tmtmep@uspto.gov, or addressed to:

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INTRODUCTION

Constitutional Basis

The authority of Congress to provide for the registration of marks which are used in commerce stems from the power of Congress under the commerce clause of the Constitution of the United States to regulate commerce.

Statutes

Under its authority to regulate commerce, Congress has over the years passed a number of statutes providing for the registration of marks in the USPTO. The provisions of statutes cannot be changed or waived by the USPTO. The statute now in effect is Public Law 489, 79th Congress, approved July 5, 1946, 60 Stat. 427, commonly referred to as the Trademark Act of 1946 or the Lanham Act. The Trademark Act of 1946 (as amended) forms Chapter 22 of Title 15 of the United States Code. In referring to a particular section of the Trademark Act, this Manual often gives the citation of the United States Code, e.g., 15 U.S.C. §1051. The text of the current statutes can be downloaded from the USPTO website at <http://www.uspto.gov>.

Rules of Practice

Section 2 of Title 35 of the United States Code authorizes the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office to establish regulations, not inconsistent with law, for the conduct of proceedings in the USPTO. The rules which govern the practices and procedures in the USPTO as they relate to the registration of marks are set forth in Title 37 of the Code of Federal Regulations.

The trademark rules are a part of the Code of Federal Regulations, which is a codification of Federal regulations under the provisions of The Federal Register Act of 1937 and The Administrative Procedure Act of 1946 and which is published pursuant to 44 U.S.C. §1510. Rules relating to patents, trademarks and copyrights are codified in Title 37 of the Code of Federal Regulations. The trademark rules constitute Part 2, the rules relating to assignments constitute Part 3, the classification of goods and services constitutes Part 6, the rules relating to filings under the Madrid Protocol constitute Part 7, and the rules relating to the representation of others before the USPTO constitute Parts 10 and 11. The text of the current rules is also available on the USPTO website at <http://www.uspto.gov>.

In creating numbers for rules, the number of the appropriate Part in Title 37 of the Code of Federal Regulations is placed first, followed by a decimal point and then the number of the rule, so that, for example, Trademark Rule 2.56 is Rule 56 in Part 2 of Title 37 of the Code of Federal Regulations. In the Code of Federal Regulations itself, and in material published in the Federal Register, the rules are identified by the term "sections." Thus, section 2.56 in 37 C.F.R. (37 CFR §2.56) is Trademark Rule 2.56.

Notices of proposed and final rulemaking are published in the Federal Register and in the *Official Gazette* of the USPTO, and posted on the USPTO website at <http://www.uspto.gov/>.

The primary function of the rules of practice is to advise the public of the regulations that have been established in accordance with the statutes, which must be followed before the USPTO.

Director's Orders and Notices

From time to time the Director of the United States Patent and Trademark Office issues Orders and Notices relating to various specific situations that have arisen in operating the USPTO. Notices, circulars of information, or instructions and examination guides have also been issued by other USPTO officials under authority of the Director. These Orders and Notices are published in the *Official Gazette* of the USPTO, and posted on the USPTO website at <http://www.uspto.gov>. See notice at **72 Fed. Reg. 72999** (Dec. 26, 2007).

Decisions

In addition to the statutory regulations, the actions taken by the examining attorneys in the examination of applications to register marks are to a great extent governed by decisions on prior cases. Applicants dissatisfied with an examining attorney's action may have it reviewed. In general, procedural matters may be reviewed by petition to the Director (see TMEP §1702) and substantive matters may be reviewed by appeal to the Trademark Trial and Appeal Board (see TMEP §1501).

Trademark Manual of Examining Procedure

The *Trademark Manual of Examining Procedure* sets forth the guidelines and procedures followed by the examining attorneys at the USPTO. The manual may be downloaded free of charge from the USPTO website at <http://www.uspto.gov/>. See notice at **67 Fed. Reg. 18176** (April 15, 2002) regarding the dissemination of the manual in electronic format.

First Edition, January 1974

Revision 1, January 1976

Revision 2, January 1977

Revision 3, January 1978

Revision 4, January 1979

Revision 5, December 1982

Revision 6, December 1983 (Incorporating Exam Guide Nos. 1-83 to 31-83)

Revision 7, January 1986 (Incorporating Office practice and relevant case law prior to January 1986; drawing rules amendment effective Sept. 22, 1986; letter of protest procedures effective April 23, 1986; Exam Guide Nos. 1-83 to 2-86)

Second Edition, May 1993 (Incorporating Office practice and relevant case law reported prior to April 1993)

Revision 1, April 1997 (Incorporating Office practice and relevant case law reported prior to March 31, 1997)

Revision 1.1, August 1997 (Corrected errors in Rev. 1)

Third Edition, January 2002, issued March 18, 2002 (Incorporating Office practice and relevant case law reported prior to Jan. 24, 2002)

Revision 1, June 2002, issued June 24, 2002 (Incorporating Office practice and relevant case law reported prior to June 24, 2002)

Revision 2, May 2003, issued May 1, 2003 (Incorporating Office practice and relevant case law reported prior to April 21, 2003)

Fourth Edition, April 2005, issued April 29, 2005 (Incorporating Office practice and relevant case law reported prior to March 25, 2005)

Fifth Edition, September 2007, issued Sept. 30, 2007 (Incorporating Office practice and relevant case law reported prior to August 11, 2007)

Sixth Edition, September 2009, issued Oct. 12, 2009 (Incorporating Office practice and relevant case law reported prior to Sept. 1, 2009)

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Revision 1, October 2009, issued October 27, 2009 (Revising §§1202.02(c)(iii), 1206.03, and 1402.15)

Revision 2, May 2010, issued May 21, 2010 (Incorporating amendments to 15 U.S.C. §§1058 and 1141k effective March 17, 2010 and signature, representation, and correspondence address rules amendments effective December 28, 2009; revising §§904.03(h), 904.03(i), 1109.15, 1109.15(a), and 1905)

Seventh Edition, October 2010, issued Oct. 15, 2010 (Incorporating Office practice and relevant case law reported prior to Sept. 1, 2010)

Eighth Edition, October 2011, issued Oct. 15, 2011 (Incorporating Office practice and relevant case law reported prior to Sept. 1, 2011)

October 2012, issued Oct. 31, 2012 (Incorporating Office practice, amendments to the Trademark Rules, and relevant case law prior to Oct. 1, 2012)

April 2013, issued April 30, 2013 (Incorporating Office practice and relevant case law reported prior to April 1, 2013)

October 2013, issued Oct. 30, 2013 (Incorporating Office practice, amendments to the Trademark Rules, and relevant case law reported prior to Oct. 1, 2013)

April 2014, issued April 30, 2014 (Incorporating Office practice and relevant case law reported prior to April 1, 2014)

October 2014, issued Oct. 30, 2014 (Incorporating Office practice and relevant case law reported prior to Oct. 1, 2014)

January 2015, issued Jan. 17, 2015 (Incorporating changes in accordance with final rules issued at 79 FR 63036, 79 FR 74633, and 80 FR 2303)

July 2015, issued July 11, 2015 (Incorporating Office practice, changes in accordance with the final rule issued at 80 FR 33170, and relevant case law reported prior to July 1, 2015)

October 2015, issued Oct. 30, 2015 (Incorporating Office practice and relevant case law reported prior to Oct. 1, 2015)

April 2016, issued April 30, 2016 (Incorporating Office practice and relevant case law reported prior to April 1, 2016)

October 2016, issued Oct. 30, 2016 (Incorporating Office practice and relevant case law reported prior to Oct. 1, 2016)

January 2017, issued Jan. 14, 2017 (Incorporating Office practice, changes in accordance with final rules issued at 81 FR 69950, 81 FR 72694, 81 FR 76867, 81 FR 78042, and 81 FR 89382, and relevant case law reported prior to Jan. 1, 2017)

April 2017, issued April 30, 2017 (Incorporating Office practice and relevant case law reported prior to March 1, 2017)

Trademark Trial and Appeal Board Manual of Procedure

References in this Manual to the *Trademark Trial and Appeal Board Manual of Procedure* (TBMP) refer to the January 2017 Revision, currently available on the USPTO website at <http://tbmp.uspto.gov/RDMS/detail/manual/TBMP/current/tbmpd1e2.xml#/manual/TBMP/current/tbmpd1e2.xml>. The TBMP sets forth guidelines and practices followed in proceedings held before the Trademark Trial and Appeal Board.

clothing originating in North Carolina, in view of the renown of New York City in the apparel industry); *Stabilisierungsfonds für Wein v. Peter Meyer Winery GmbH*, 9 USPQ2d 1073, 1075 (TTAB 1988) (holding GOLDENER TROPFEN deceptive for wines, in view of evidence of the international renown of the Goldtropfchen vineyard of West Germany, the Board finding that the purchasing public would be likely to think, mistakenly, that applicant's wines were produced from grapes grown there in accordance with German wine laws and regulations); *Bureau Nat'l Interprofessionnel Du Cognac v. Int'l Better Drinks Corp.*, 6 USPQ2d 1610, 1616 (TTAB 1988) (holding COLAGNAC deceptive for cola-flavored liqueur containing Spanish brandy, the Board concluding that purchasers were likely to believe that applicant's goods contained COGNAC brandy); *In re Shapely, Inc.*, 231 USPQ 72 (TTAB 1986) (holding SILKEASE deceptive as applied to clothing not made of silk); *In re House of Windsor, Inc.*, 221 USPQ 53 (TTAB 1983), *recon. denied*, 223 USPQ 191 (TTAB 1984) (holding BAHIA deceptive as applied to cigars having no connection with the Bahia province of Brazil, the record indicating that tobacco and cigars are important products in the Bahia region); *Evans Prods. Co. v. Boise Cascade Corp.*, 218 USPQ 160 (TTAB 1983) (holding CEDAR RIDGE deceptive for embossed hardboard siding not made of cedar); *In re Intex Plastics Corp.*, 215 USPQ 1045 (TTAB 1982) (holding TEXHYDE deceptive as applied to synthetic fabric for use in the manufacture of furniture, upholstery, luggage, and the like); *Tanners' Council of Am., Inc. v. Samsonite Corp.*, 204 USPQ 150 (TTAB 1979) (holding SOFTHIDE deceptive for imitation leather material); *In re Salem China Co.*, 157 USPQ 600 (TTAB 1968) (holding AMERICAN LIMOGES, used on dinnerware that was neither made in Limoges, France, nor made from Limoges clay, deceptive because of the association of Limoges with fine quality china); *Co. of Cutlers of Hallamshire in the Cnty. of York v. Regent-Sheffield, Ltd.*, 155 USPQ 597 (TTAB 1967) (holding SHEFFIELD, used on cutlery not made in Sheffield, England, deceptive because of the renowned status of Sheffield in relation to cutlery); *In re U.S. Plywood Corp.*, 138 USPQ 403 (TTAB 1963) (holding IVORY WOOD, for lumber and timber products, deceptive since the goods were not made of ivorywood nor did they contain an ivorywood pattern).

Marks were found not to be deceptive in the following cases: *Philip Morris Inc. v. Reemtsma Cigarettenfabriken GmbH*, 14 USPQ2d 1487 (TTAB 1990) (holding PARK AVENUE neither deceptive nor geographically deceptively misdescriptive as applied to applicant's cigarettes and smoking tobacco, the Board finding no goods/place association between Park Avenue in New York City, on which opposer's world headquarters was located, and tobacco products); *In re Woolrich Woolen Mills Inc.*, 13 USPQ2d 1235 (TTAB 1989) (holding WOOLRICH for clothing not made of wool not to be deceptive under §2(a)); *In re Fortune Star Prods. Corp.*, 217 USPQ 277 (TTAB 1982) (holding NIPPON, for radios, televisions, and the like, not deceptive in relation to the goods because, although the applicant was an American firm, the goods were actually made in Japan); *In re Sweden Freezer Mfg. Co.*, 159 USPQ 246 (TTAB 1968) (holding SWEDEN and design, for which registration was sought under §2(f) for external artificial kidney units, not deceptive, the Board finding the case to be in the category "where a geographical trademark may involve a degree of untruth but the deception may be perfectly innocent, harmless or negligible"); *A. F. Gallun & Sons Corp. v. Aristocrat Leather Prods., Inc.*, 135 USPQ 459 (TTAB 1962) (holding COPY CALF, for wallets and billfolds of synthetic and plastic material made to simulate leather, not deceptive, the Board noting that the mark, as an obvious play on the expression "copy cat," suggested to purchasers that the goods were imitations of items made of calf skin).

1203.03 Matter That May Disparage, Falsely Suggest a Connection, or Bring into Contempt or Disrepute

Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), bars the registration on either the Principal or the Supplemental Register of a designation that consists of or comprises matter which, with regard to persons, institutions, beliefs, or national symbols, does any of the following: (1) disparages them; (2) falsely suggests a connection with them; (3) brings them into contempt; or (4) brings them into disrepute.

Section 2(a) is distinctly different from §2(d), 15 U.S.C. §1052(d), for which the relevant test is likelihood of confusion. In *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 1375-76, 217 USPQ 505, 508-09 (Fed. Cir. 1983), *aff'd* 213 USPQ 594 (TTAB 1982), the Court of Appeals for the Federal Circuit noted as follows:

A reading of the legislative history with respect to what became §2(a) shows that the drafters were concerned with protecting the name of an individual or institution which was not a technical “trademark” or “trade name” upon which an objection could be made under §2(d)....

Although not articulated as such, it appears that the drafters sought by §2(a) to embrace concepts of the right to privacy, an area of the law then in an embryonic state (footnote omitted). Our review of case law discloses that the elements of a claim of invasion of one’s privacy have emerged as distinctly different from those of trademark or trade name infringement. There may be no likelihood of such confusion as to the source of goods even under a theory of “sponsorship” or “endorsement,” and, nevertheless, one’s right of privacy, or the related right of publicity, may be violated.

The right to privacy protects a party’s control over the use of its identity or “persona.” A party acquires a protectible interest in a name or equivalent designation under §2(a) where the name or designation is unmistakably associated with, and points uniquely to, that party’s personality or “persona.” A party’s interest in a name or designation does not depend upon adoption and use as a technical trademark or trade name.

Univ. of Notre Dame du Lac, 703 F.2d at 1375-77, 217 USPQ at 508-09; *Buffett v. Chi-Chi’s, Inc.*, 226 USPQ 428, 429 (TTAB 1985). Section 2(a) protection is intended to prevent the unauthorized use of the persona of a person or institution and not to protect the public. *In re MC MC S.r.l.*, 88 USPQ2d 1378, 1380 (TTAB 2008) (quoting *Bridgestone/Firestone Research Inc. v. Auto. Club De L’Ouest De La France*, 245 F.3d 1359, 58 USPQ2d 1460 (Fed. Cir. 2001)).

Moreover, a mark does not have to comprise a person’s full or correct name to be unregistrable; a nickname or other designation by which a person is known by the public may be unregistrable under this provision of the Act. *Buffett*, 226 USPQ at 430 (finding evidence of record “sufficient to raise a genuine issue of material fact as to whether the term ‘MARGARITAVILLE’ is so uniquely and unmistakably associated with opposer as to constitute opposer’s name or identity such that when applicant’s mark is used in connection with its [restaurant] services, a connection with opposer would be assumed”).

See TMEP §§1203.03(b)–1203.03(b)(ii) regarding disparagement, bringing into contempt, and bringing into disrepute, and TMEP §§1203.03(c)–1203.03(c)(iii) regarding false suggestion of a connection.

See *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831, 218 USPQ 1 (6th Cir. 1983), concerning the various forms of identity which have been protected under the rights of privacy and publicity.

1203.03(a) Definitions

1203.03(a)(i) “Persons”

Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), protects, *inter alia*, “persons, living or dead.”

Section 45 of the Act, 15 U.S.C. §1127, defines “person” and “juristic person” as follows:

The term “person” and any other word or term used to designate the applicant or other entitled to a benefit or privilege or rendered liable under the provisions of this Act includes a juristic person as well

as a natural person. The term “juristic person” includes a firm, corporation, union, association, or other organization capable of suing and being sued in a court of law.

The term “persons” in §2(a) refers to real persons, not fictitious characters. With respect to natural persons, they may be living or dead. However, §2(a) may not be applicable with regard to a deceased person when there is no longer anyone entitled to assert a proprietary right or right of privacy. *Lucien Piccard Watch Corp. v. Since 1868 Crescent Corp.*, 314 F. Supp. 329, 165 USPQ 459 (S.D.N.Y. 1970) (holding DA VINCI not to falsely suggest a connection with the deceased artist Leonardo Da Vinci); *In re MC MC S.r.l.*, 88 USPQ2d 1378 (TTAB 2008 (holding MARIA CALLAS did not falsely suggest a connection with deceased opera singer Maria Callas). See TMEP §1203.03(c)(i) regarding elements of a §2(a) false suggestion of a connection refusal.

In the case of a mark comprising the name of a deceased natural person, the “right to the use of a designation which points uniquely to his or her persona may not be protected under Section 2(a) after his or her death unless heirs or other successors are entitled to assert that right.... In order to possess rights, such person, or someone to whom those rights have been transferred, must exist.” *In re MC MC S.r.l.*, 88 USPQ2d at 1380 (quoting *In re Wielinski*, 49 USPQ2d 1754, 1758 (TTAB 1998) (*overruled on other grounds by In re WNBA Enter., LLC*, 70 USPQ2d 1153 (TTAB 2003)); see *In re Jackson Int'l Trading Co. Kurt D. Bruhl GmbH & Co. KG*, 103 USPQ2d 1417, 1421 (TTAB 2012) . A key consideration is “whether or not there is someone (this may be a natural person, estate, or juristic entity) with rights in the name.” *Id.* Any doubt regarding the existence of heirs or successors with such rights must be resolved in favor of the applicant. *In re MC MC S.r.l.*, 88 USPQ2d at 1381.

In addition to natural persons, §2(a) includes juristic persons, that is, legally created entities such as firms, corporations, unions, associations, or any other organizations capable of suing and being sued in a court of law. See *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (C.C.P.A. 1969); *Popular Merch. Co. v. “21” Club, Inc.*, 343 F.2d 1011, 145 USPQ 203 (C.C.P.A. 1965); *John Walker & Sons, Ltd. v. Am. Tobacco Co.*, 110 USPQ 249 (Comm’r Pats. 1956); *Copacabana, Inc. v. Breslauer*, 101 USPQ 467 (Comm’r Pats. 1954). Juristic persons do not have to be well known to be protected from the registration of a mark that falsely suggests a connection with or disparages them, or brings them into contempt or disrepute. See generally *Gavel Club v. Toastmasters Int’l*, 127 USPQ 88, 94 (TTAB 1960) (noting that §2(a) protection is not limited to large, well known, or nationally recognized institutions).

A juristic person’s rights under §2(a) are extinguished when the juristic person ceases to exist. *In re Wielinski*, 49 USPQ2d at 1758 (*overruled on other grounds, In re WNBA Enter., LLC*, 70 USPQ2d 1153 (TTAB 2003)).

Section 45 of the Act, 15 U.S.C. §1127, also defines “person” to include the United States and its agencies and instrumentalities, as well as any state:

The term “person” also includes the United States, any agency or instrumentality thereof, or any individual, firm, or corporation acting for the United States and with the authorization and consent of the United States. The United States, any agency or instrumentality thereof, and any individual, firm, or corporation acting for the United States and with the authorization and consent of the United States, shall be subject to the provisions of this Act in the same manner and to the same extent as any nongovernmental entity.

The term “person” also includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this Act in the same manner and to the same extent as any non-governmental entity.

It is well settled that the United States government is a “person” within the meaning of §2(a). 15 U.S.C. §1127; *FBI v. Societe: “M.Brill & Co.”*, 172 USPQ 310, 313 (TTAB 1971). Therefore, the common names of, and acronyms for, United States government agencies and instrumentalities are considered persons. *See In re Peter S. Herrick P.A.*, 91 USPQ2d 1505, 1506-08 (TTAB 2009) (stating the statutory definition of “person” includes the United States and any agency or instrumentality thereof and concluding that “[t]he only entity the name ‘U.S. Customs Service’ could possibly identify is the government agency” formerly known as the United States Customs Service and now known as United States Customs and Border Protection); *NASA v. Record Chem. Co.*, 185 USPQ 563, 566 (TTAB 1975) (finding the National Aeronautics and Space Administration (NASA) is a juristic person); *FBI*, 172 USPQ at 313 (noting the Federal Bureau of Investigation (FBI) is a juristic person).

1203.03(a)(ii) “Institutions”

The term “institution” has been broadly construed. *See In re Shinnecock Smoke Shop*, 571 F.3d 1171, 91 USPQ2d 1218, 1219 (Fed. Cir. 2009) (“[T]he ordinary meaning of ‘institution’ suggests the term is broad enough to include a self-governing Indian nation,” quoting *Black’s Law Dictionary* 813, 1133 (8th ed. 2004), which defines “institution” as “[a]n established organization,” and defines “organization” as a “body of persons ... formed for a common purpose”); *In re White*, 73 USPQ2d 1713, 1718 (TTAB 2004) (“each federally recognized Apache tribe is necessarily either a juristic person or an institution”); *In re Urbano*, 51 USPQ2d 1776, 1779 (TTAB 1999) (“[T]he entire organization which comprises the Olympic Games, as a whole, qualifies as an ‘institution’ within the meaning of Section 2(a) of the Trademark Act.

In addition to qualifying as a person, United States government agencies and instrumentalities, as identified by their common names and acronyms therefor, also may be considered institutions within the meaning of §2(a). *See In re Peter S. Herrick P.A.*, 91 USPQ2d 1505, 1506 (TTAB 2009) (“Institutions, as used in Section 2(a), include government agencies.”); *In re Cotter & Co.*, 228 USPQ 202, 204-05 (TTAB 1985) (finding the United States Military Academy is an institution and West Point or Westpoint “has come to be solely associated with and points uniquely to the United States Military Academy”). The common names of, and acronyms and terms for, United States government programs may also be considered institutions, depending on the evidence of record. *See In re N. Am. Free Trade Ass’n*, 43 USPQ2d 1282, 1285-86 (TTAB 1997) (finding that the “NAFTA is an institution, in the same way that the United Nations is an institution,” the Board noted that the “legislative history ... indicates that the reference to an ‘institution’ in Section 2(a) was designed to have an expansive scope.”); *NASA v. Record Chem. Co.*, 185 USPQ 563, 565 (TTAB 1975) (finding NASA’s Apollo space program is an institution).

Institutions do not have to be large, well known, or “national” to be protected from the registration of a mark that falsely suggests a connection with or disparages them, or brings them into contempt or disrepute. *Gavel Club v. Toastmasters Int’l*, 127 USPQ 88, 94 (TTAB 1960).

While the §2(a) prohibition against the registration of matter that may disparage or falsely suggest a connection with institutions, or bring them into contempt or disrepute, may not be applicable to a particular designation, many names, acronyms, titles, terms, and symbols are protected by other statutes or rules. *See* TMEP § 1205.01 and Appendix C (setting forth a nonexhaustive list of United States statutes protecting designations of certain government agencies and instrumentalities).

1203.03(a)(iii) “National Symbols”

A “national symbol” is subject matter of unique and special significance that, because of its meaning, appearance, and/or sound, immediately suggests or refers to the country for which it stands. *In re Consol. Foods Corp.*, 187 USPQ 63, 64 (TTAB 1975) (noting national symbols include the bald eagle, Statue of Liberty, designation “Uncle Sam” and the unique human representation thereof, the heraldry and shield designs used in governmental offices, and certain uses of the letters “U.S.”). National symbols include the symbols of foreign countries as well as those of the United States. *In re Anti-Communist World Freedom Cong., Inc.*, 161 USPQ 304, 305 (TTAB 1969).

“National symbols” cannot be equated with the “insignia” of nations, which are prohibited from registration under §2(b). As noted in *Liberty Mut. Ins. Co. v. Liberty Ins. Co. of Texas*, 185 F. Supp. 895, 908, 127 USPQ 312, 323 (E.D. Ark. 1960):

The Act ... does not put national symbols on a par with the flag, coat of arms, or other insignia of the United States, which may not in any event be made the subject matter of a trade or service mark. With regard to national symbols the statute provides merely that they shall not be disparaged or held up to contempt or disrepute, and shall not be used as falsely to suggest a connection between the holder of the mark and the symbol.

See TMEP §1204 regarding insignia.

Trademark Act Section 2(a) does not prohibit registration of marks comprising national symbols; it only prohibits registration of matter that may disparage national symbols, falsely suggest a connection with them, or hold them up to contempt or disrepute. *Liberty Mut. Ins. Co.*, 185 F. Supp. at 908, 127 USPQ at 323 (finding marks comprising portion of the Statue of Liberty not to disparage, bring into contempt or disrepute, or falsely suggest a connection with the Statue of Liberty or the United States government, the Court “[a]ssuming without deciding” that the statue is a national symbol).

Designations have been held to be national symbols within the meaning of §2(a) in the following cases: *In re Anti-Communist World Freedom Cong.*, 161 USPQ 304 (holding a representation of a hammer and sickle to be a national symbol of the Union of Soviet Socialist Republics (U.S.S.R.)); *In re Nat'l Collection & Credit Control, Inc.*, 152 USPQ 200, 201 n.2 (TTAB 1966) (“The American or bald eagle with wings extended is a well-known national symbol or emblem of the United States”).

Designations have been held not to be national symbols in the following cases: *In re Consol. Foods Corp.*, 187 USPQ 63 (TTAB 1975) (holding OSS, the acronym for the Office of Strategic Services, not to constitute a national symbol); *W. H. Snyder & Sons, Inc. v. Ladd*, 227 F. Supp. 185, 140 USPQ 647 (D.D.C. 1964) (holding HOUSE OF WINDSOR not to be a national symbol of England, but merely the name of its present reigning family); *NASA v. Bully Hill Vineyards, Inc.*, 3 USPQ2d 1671 (TTAB 1987) (holding SPACE SHUTTLE not to constitute a national symbol on the evidence of record, the Board also finding “shuttle” to be a generic term for a space vehicle or system); *Jacobs v. Int'l Multifoods Corp.*, 211 USPQ 165, 170-71 (TTAB 1981), *aff'd on other grounds*, 668 F.2d 1234, 212 USPQ 641 (C.C.P.A. 1982) (“[H]istorical events such as the ‘BOSTON TEA PARTY’ ..., although undoubtedly associated with the American heritage, do not take on that unique and special significance of a ‘national symbol’ designed to be equated with and associated with a particular country.”); *In re Mohawk Air Serv. Inc.*, 196 USPQ 851, 854 (TTAB 1977) (stating MOHAWK is not immediately suggestive of the United States and, therefore, not a national symbol); *In re Gen. Mills, Inc.*, 169 USPQ 244 (TTAB 1971) (finding UNION JACK, which applicant was using on packages of frozen fish marked “English cut cod” and in its restaurant near representations of the British

national flag, did not suggest a particular country, the Board noting that it could consider only the matter for which registration was sought).

The name of a country is not a national symbol within the meaning of §2(a) of the Trademark Act, *In re Sweden Freezer Mfg. Co.*, 159 USPQ 246, 248-49 (TTAB 1968), nor does use of the name of a country as a mark, by itself, amount to deception, disparagement, or a “false connection” under §2(a). *In re Fortune Star Prods. Corp.*, 217 USPQ 277, 277 (TTAB 1982) .

The common names of, and acronyms for, government agencies and instrumentalities are not considered to be national symbols. *In re Consol. Foods*, 187 USPQ at 64 (OSS, acronym for the Office of Strategic Services, held not to be a national symbol, but merely to designate a particular (and long defunct) government agency, the Board contrasting national symbols with names and acronyms of government agencies: “‘National symbols’ ... are more enduring in time, ... and immediately conjure up the image of the country as a whole. Symbols of a country take on a special meaning and significance and are not so numerous as to dilute the special meaning and significance that each has.”)

While the prohibition of §2(a) against the registration of matter that may disparage or falsely suggest a connection with national symbols, or bring them into contempt or disrepute, may not be applicable to a particular designation, many names, acronyms, titles, terms, and symbols are protected by other statutes or rules. See TMEP §1205.01 and Appendix C.

1203.03(b) Disparagement, Bringing into Contempt, and Bringing into Disrepute

Section 2(a) prohibits the registration of a mark that consists of or comprises matter that may disparage, or bring into contempt or disrepute, persons, institutions, beliefs, or national symbols. See TMEP §1203.03(a)(i) regarding persons, TMEP §1203.03(a)(ii) regarding institutions, and TMEP §1203.03(a)(iii) regarding national symbols.

In sustaining an opposition on this ground, the Trademark Trial and Appeal Board stated as follows:

Disparagement is essentially a violation of one’s right of privacy – the right to be “let alone” from contempt or ridicule. See, *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831, 218 USPQ 1 (6th Cir. 1983). It has been defined as the publication of a statement which the publisher intends to be understood, or which the recipient reasonably should understand, as tending “to cast doubt upon the quality of another’s land, chattels, or intangible things.” Restatement (Second) of Torts §629 (1977).

Greyhound Corp. v. Both Worlds Inc., 6 USPQ2d 1635, 1639 (TTAB 1988) .

1203.03(b)(i) Elements of a §2(a) Disparagement Refusal

The Board applies one of two substantive tests in determining whether a proposed mark is disparaging. The test depends on the nature of the interest disparaged by the mark, that is, whether the interest is commercial or non-commercial (e.g., religious, ethnic, personal reputation, or national interest). Compare *In re Geller*, 751 F.3d 1355, 110 USPQ2d 1867 (Fed. Cir. 2014) (finding mark would be disparaging to a substantial composite of American Muslims), with *Greyhound Corp. v. Both Worlds Inc.*, 6 USPQ2d 1635 (TTAB 1988) (finding design of defecating dog disparaged a corporation that was strongly identified with a similar-looking running dog design mark).

In an ex parte case involving disparagement of a non-commercial interest, the following two-part test applies in determining whether a proposed mark is disparaging:

- (1) What is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services; and
- (2) If that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.

See In re Geller, 751 F.3d at 1358, 110 USPQ2d at 1869; *In re Tam*, 108 USPQ2d 1305 (TTAB 2013), cert. filed, No. 15-1293 (Apr. 20, 2016); *In re Lebanese Arak Corp.*, 94 USPQ2d 1215, 217 (TTAB 2010); *In re Squaw Valley Dev. Co.*, 80 USPQ2d 1264, 1267 (TTAB 2006); *Order Sons of Italy in Am. v. Memphis Mafia, Inc.*, 52 USPQ2d 1364, 1368 (TTAB 1999); *Harjo v. Pro-Football Inc.*, 50 USPQ2d 1705, 1740-41 (TTAB 1999), *rev'd on other grounds*, 284 F. Supp. 2d 96, 68 USPQ2d 1225 (D.D.C. 2003).

In such cases, the examining attorney must make a prima facie showing that a substantial composite, although not necessarily a majority, of the referenced group would find the proposed mark, as used on or in connection with the relevant goods or services, to be disparaging in the context of contemporary attitudes. *See In re Geller* 751 F.3d at 1362, 110 USPQ2d at 1872; *In re Tam*, 108 USPQ2d at 1310; *Lebanese Arak*, 94 USPQ2d at 1218 (citing *In re Heeb Media LLC*, 89 USPQ2d 1071, 1074 (TTAB 2008)). In *Lebanese Arak*, the Board clarified that when the application of a mark to a product would offend the sensibilities of an ethnic or religious group, the proper ground for refusal is not under the clause of §2(a) that prohibits registration of matter that is “immoral” or “scandalous,” but under the clause that prohibits registration of matter that “may disparage” the affected person, belief, institution, or symbol, or may bring them into contempt or disrepute. 94 USPQ2d at 1217. Moreover, when religious beliefs or tenets are involved, the proper focus is on the group of persons that adhere to those beliefs or tenets. *Id.* The fact that an applicant may be a member of that group or has good intentions underlying its use of a term does not obviate the fact that a substantial composite of the referenced group would find the term objectionable. *In re Tam*, 108 USPQ2d at 1312 (citing *Heeb Media*, 89 USPQ2d at 1077). The prima facie showing shifts the burden to applicant for rebuttal. *Squaw Valley*, 80 USPQ2d at 1271.

In the more rare situation where disparagement relates to a commercial interest, such as disparaging a particular business or trademark owner, the following two-part test applies in determining whether a proposed mark is disparaging:

- (1) Whether the communication reasonably would be understood as referring to the commercial entity; and
- (2) Whether the communication is disparaging, that is, would be considered offensive or objectionable by a reasonable person of ordinary sensibilities.

See Greyhound Corp. v. Both Worlds Inc., 6 USPQ2d at 1639.

The question of disparagement must be considered in relation to the goods or services identified in the application and the manner of use in the marketplace. The mere fact that a term has several meanings, even when many may be innocuous, does not foreclose the possibility that the term is disparaging. *In re Tam*, 108 USPQ2d at 1310. In *Squaw Valley*, the terms SQUAW and SQUAW ONE were found to be disparaging when used in connection with clothing in Class 25 and retail store services in the field of sporting goods and equipment and clothing in Class 35, because the likely meaning of “Squaw” is an American Indian

woman or wife, and the examining attorney's evidence established prima facie that a substantial composite of Native Americans would consider the term to be offensive. 80 USPQ2d at 1276-77, 1279. However, these terms were found not to be disparaging when used in connection with ski-related equipment in Class 28, because the likely meaning of "Squaw" in relation to these goods was deemed to be applicant's Squaw Valley ski resort. *Id.* at 1282.

1203.03(b)(ii) Disparagement, Bringing into Contempt, and Bringing into Disrepute: Case References

Disparagement was found in the following cases: *In re Tam*, 108 USPQ2d 1305 (TTAB 2013), *cert. filed*, No. 15-1293 (Apr. 20, 2016) (finding THE SLANTS for live performances by a musical band to be disparaging to a substantial composite of people of Asian descent); *In re Lebanese Arak Corp.*, 94 USPQ2d 1215 (TTAB 2010) (finding KHORAN for wines to be disparaging because the public, in general, and Muslim Americans, in particular, would regard the mark as referring to the holy text of Islam, and given that Islamic authorities view alcohol as a prohibited substance, Muslims would find KHORAN used for wine as disparaging to themselves, their religion, and their beliefs); *In re Heeb Media LLC*, 89 USPQ2d 1071 (TTAB 2008) (finding HEEB for clothing and entertainment services to be disparaging since HEEB means a Jewish person, dictionary definitions unanimously support the derogatory nature of HEEB, evidence of record supports that a substantial composite of the referenced group, i.e., the Jewish community, will perceive HEEB as disparaging, and HEEB has no other meaning in relation to clothing or entertainment services); *Boston Red Sox Baseball Club Ltd. P'ship v. Sherman*, 88 USPQ2d 1581 (TTAB 2008) (finding SEX ROD to be disparaging because it is sexually vulgar and offensive and the public will associate it with opposer's mark RED SOX); *In re Squaw Valley Dev. Co.*, 80 USPQ2d 1264 (TTAB 2006) (finding SQUAW and SQUAW ONE to be disparaging when used in connection with clothing in Class 25 and retail store services in the field of sporting goods and equipment and clothing in Class 35, because the likely meaning of "Squaw" in relation to these goods or services is an American Indian woman or wife, and the examining attorney's evidence established prima facie that a substantial composite of Native Americans would consider the term to be offensive; however, these terms were found not to be disparaging when used in connection with ski-related equipment in Class 28, because the likely meaning of "Squaw" in relation to these goods was deemed to be applicant's Squaw Valley ski resort); *Greyhound Corp. v. Both Worlds Inc.*, 6 USPQ2d 1635, 1639-40 (TTAB 1988) (finding design of dog defecating, for clothing, to disparage, and bring into contempt or disrepute, opposer's running dog symbol, the Board finding the evidence of record "sufficient to show prima facie that this design [the running dog symbol] is, in effect, an alter ego of opposer which points uniquely and unmistakably to opposer's persona."); *In re Anti-Communist World Freedom Cong., Inc.*, 161 USPQ 304 (TTAB 1969) (holding design of an "X" superimposed over a hammer and sickle to disparage, and hold in contempt and disrepute, a national symbol of the U.S.S.R.).

Disparagement was not found in the following cases: *Boswell v. Mavety Media Grp. Ltd.*, 52 USPQ2d 1600 (TTAB 1999) (finding BLACK TAIL used on adult entertainment magazines, not to be disparaging of women in general, or African-American women in particular, nor to bring those groups into contempt or disrepute); *Order Sons of Italy in Am. v. Memphis Mafia Inc.*, 52 USPQ2d 1364 (TTAB 1999) (finding THE MEMPHIS MAFIA for entertainment services not to be matter that disparages Italian-Americans or bring them into contempt or disrepute); *In re In Over Our Heads Inc.*, 16 USPQ2d 1653, 1654 (TTAB 1990) (finding MOONIES and design incorporating a "buttocks caricature," for dolls whose pants can be dropped, not to be disparaging matter that is unregistrable under §2(a), the Board finding that the mark "would, when used on a doll, most likely be perceived as indicating that the doll 'moons,' and would not be perceived as referencing members of The Unification Church.").

1203.03(c) False Suggestion of a Connection

Section 2(a) prohibits the registration of a mark that consists of or comprises matter that may falsely suggest a connection with persons, institutions, beliefs, or national symbols. See TMEP §1203.03(a)(i) regarding persons, TMEP §1203.03(a)(ii) regarding institutions, TMEP §1203.03(a)(iii) regarding national symbols, and TMEP §1203.03 for information about the legislative history of §2(a).

1203.03(c)(i) Elements of a §2(a) False Suggestion of a Connection Refusal

To establish that a proposed mark falsely suggests a connection with a person or an institution, it must be shown that:

- 1 the mark is the same as, or a close approximation of, the name or identity previously used by another person or institution;
- 2 the mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution;
- 3 the person or institution named by the mark is not connected with the activities performed by the applicant under the mark; and
- 4 the fame or reputation of the person or institution is such that, when the mark is used with the applicant's goods or services, a connection with the person or institution would be presumed.

In re Pedersen, 109 USPQ 2d 1185, 1188-89 (TTAB 2013) ; *In re Jackson Int'l Trading Co. Kurt D. Bruhl GmbH & Co. KG*, 103 USPQ2d 1417, 1419 (TTAB 2012) ; *In re Peter S. Herrick, P.A.*, 91 USPQ2d 1505, 1507 (TTAB 2009) ; *In re MC MC S.r.l.*, 88 USPQ2d 1378, 1379 (TTAB 2008); *Ass'n Pour La Def. et la Promotion de L'Oeuvre de Marc Chagall dite Comite Marc Chagall v. Bondarchuk*, 82 USPQ2d 1838, 1842 (TTAB 2007) ; *In re White*, 80 USPQ2d 1654, 1658 (TTAB 2006); *In re White*, 73 USPQ2d 1713, 1718 (TTAB 2004) ; *In re Nuclear Research Corp.*, 16 USPQ2d 1316, 1317 (TTAB 1990) ; *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428, 429 (TTAB 1985) ; *In re Cotter & Co.*, 228 USPQ 202, 204 (TTAB 1985) ; *see also Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 1375-77, 217 USPQ 505, 508-10 (Fed. Cir. 1983) (providing foundational principles for the current four-part test used to determine the existence of a false connection).

With regard to the first element, “[a] nickname or an informal reference, even one created by the public, can qualify as an entity's ‘identity,’ thereby giving rise to a protectable interest.” *Bos. Athletic Ass'n v. Velocity, LLC*, 117 USPQ2d 1492, 1496 (TTAB2015). In addition, the fact that a term identifies both a particular group of people and the language spoken by some of the members of the group is not evidence that it fails to identify the group. *In re Pedersen*, 109 USPQ 2d at 1190 (rejecting applicant's argument that because the term LAKOTA identifies a language, it does not approximate the name or identity of a people or institution).

The requirement that the proposed mark would be recognized as pointing uniquely and unmistakably to the person or institution does not mean that the term itself must be unique. Rather, the question is whether, as used on the goods or services in question, consumers would view the mark as pointing uniquely to petitioner, or whether they would perceive it to have a different meaning. *Hornby v. TJX Cos., Inc.*, 87 USPQ2d 1411, 1427 (TTAB 2008) (in granting the petition to cancel registration of the mark TWIGGY, Board found that, at the time of registration in 2000, the mark TWIGGY on children's clothing would be recognized as pointing uniquely and unmistakably to petitioner, who was recognized as a famous British model, and that consumers would presume an association with petitioner). In addition, unassociated third-party use of a term does not in and of itself establish that that the term does not point uniquely or unmistakably to a particular people or

institution. *In re Pedersen*, 109 USPQ2d at 1196 (finding consumer exposure to third-party use of LAKOTA on products and services unrelated to applicant's insufficient to show that applicant's use of LAKOTA does not point uniquely to the Lakota people); *Hornby v. TJX Cos.*, 87 USPQ2d at 1427 (finding evidence of third-party registrations showing registration of the term "TWIGGY" for goods unrelated to children's clothing to have "no probative value").

A connection with an entity is established when the record establishes a specific endorsement, sponsorship, or the like of the particular goods and services, whether written or implied. *In re White*, 80 USPQ2d 1654, 1660-61 (TTAB 2006). In *In re Sloppy Joe's Int'l Inc.*, 43 USPQ2d 1350, 1353-54 (TTAB 1997), the Trademark Trial and Appeal Board held that Ernest Hemingway's friendship with the original owner of applicant's bar, his frequenting the bar, and his use of the back room as an office did not establish the kind of "connection" that entitled applicant to register a mark consisting in part of a portrait of Hemingway. Rather, a commercial connection, such as an ownership interest or commercial endorsement or sponsorship of applicant's services would be necessary to entitle the applicant to registration. *Id.*

If it is unclear whether the person or institution is connected with the goods sold or services performed by the applicant, the examining attorney must make an explicit inquiry under 37 C.F.R. §2.61(b). If the examining attorney independently confirms that the person or institution is connected with the goods sold or services performed by the applicant, a Note to the File must be entered in the record to reflect that no further action is required as to the issue of false suggestion of a connection. See TMEP §710.02.

A refusal on this basis requires, by implication, that the person or institution with which a connection is falsely suggested must be the prior user. *In re Nuclear Research*, 16 USPQ2d at 1317; *In re Mohawk Air Servs. Inc.*, 196 USPQ 851, 854-55 (TTAB 1977). However, it is not necessary that the prior user ever commercially exploit the name as a trademark or in a manner analogous to trademark use. *In re Pedersen*, 109 USPQ2d at 1193. A false suggestion of a connection may be found when the party's right to control the use of its identity is violated, even if there is no juristic entity having the authority to authorize use of the mark. *Id.*

Intent to identify a party or trade on its goodwill is not a required element of a §2(a) claim of false suggestion of an association with such party. *S & L Acquisition Co. v. Helene Arpels, Inc.*, 9 USPQ2d 1221, 1224 (TTAB 1987); *Consol. Natural Gas Co. v. CNG Fuel Sys., Ltd.*, 228 USPQ 752, 754 (TTAB 1985). However, evidence of such an intent could be highly persuasive that the public would make the intended false association. *Univ. of Notre Dame du Lac*, 703 F.2d at 1377, 217 USPQ at 509, *aff'd* 213 USPQ 594 (TTAB 1982).

1203.03(c)(ii) Government Agencies and Instrumentalities

Registration of matter that may falsely suggest a connection with a United States government agency or instrumentality is prohibited under §2(a). See TMEP §1203.03(c)(i) (setting out the four-element test). Some names, acronyms, titles, terms, and symbols of United States government agencies or instrumentalities are also protected by separate statute. See TMEP §1205.01 for information about statutorily protected matter and Appendix C for a nonexhaustive list of United States statutes protecting designations of certain government agencies and instrumentalities. However, if the mark references a United States government agency or instrumentality in such a manner that a connection with it would not be presumed, a refusal may not be necessary. Instead, a disclaimer may be required, if appropriate. See below for a discussion of situations in which a disclaimer is applicable.

Registration must be refused if the nature of the mark and the nature of the goods or services is such that a United States government agency or instrumentality would be presumed to be the source or sponsorship of

the applicant's goods or services. *In re Peter S. Herrick, P.A.*, 91 USPQ2d 1505, 1507-08 (TTAB 2009) (finding "U.S. CUSTOMS SERVICE" is a close approximation of the former name of the government agency, United States Customs Service, which is now known as the United States Customs and Border Protection but which is still referred to as the U.S. Customs Service by the public and the agency itself, that the seal design in the proposed mark is nearly identical to the seal used by the former United States Customs Service, that the only meaning the "U.S. Customs Service" has is to identify the government agency, and that a connection between applicant's attorney services and the activities performed by the United States Customs and Border Protection would be presumed); *In re Nat'l Intelligence Acad.*, 190 USPQ 570, 572 (TTAB 1976) (stating NATIONAL INTELLIGENCE ACADEMY, for educational and instructional services in intelligence gathering for law enforcement officers, falsely suggests a connection with the United States government since intelligence gathering is a known function of a number of government agencies and "[a] normal outgrowth and development of such activities would be the training of officers in intelligence gathering"); *In re Teasdale Packing Co.*, 137 USPQ 482 (TTAB 1963) (holding U. S. AQUA and design unregistrable under §2(a) on the ground that purchasers of applicant's canned drinking water would be misled into assuming approval or sponsorship by the United States government in view of the nature of the mark, including a red, white, and blue shield design, and the nature of the goods, the Board noting a program for stocking emergency supplies of water in fallout shelters and the setting of standards for drinking water by United States government agencies).

The record must include evidence showing that the designation in the mark refers to the agency or instrumentality and that the goods or services are such that a connection with that agency or instrumentality would be presumed, particularly when it is not readily apparent that the wording or acronym in the mark refers to the agency or instrumentality. *Compare In re Mohawk Air Serv. Inc.*, 196 USPQ 851, 855 (TTAB 1977) (holding MOHAWK 298, for airplanes, to not falsely suggest a connection with the U.S. Army and the Army's use of the term "Mohawk" to identify one of its airplanes, since there was no evidence of record that the Army continuously used the term since 1958, that the public was aware of such use, or that the public would associate "Mohawk" named airplanes with the U.S. Army), *with In re U.S. Bicentennial Soc'y*, 197 USPQ 905, 906-07 (TTAB 1978) (holding U.S. BICENTENNIAL SOCIETY, for ceremonial swords, to falsely suggest a connection with the American Revolution Bicentennial Commission and the United States government, based on applicant's claims in the specimen of record and the fact that "swords have historically been presented by grateful sovereigns and governments to persons who have been honored by such gifts and that ceremonial swords are on display in the museum at Mt. Vernon").

Furthermore, the question of the registrability of a mark under §2(a) "is determined in each case by the nature of the goods or services in connection with which the mark is used and the impact of such use on the purchasers of goods or services of this type." *NASA v. Record Chemical Co. Inc.*, 185 USPQ 563, 568 (TTAB 1975). Thus, the identified goods or services must be scrutinized in the context of the current marketplace to determine whether they are of the type to be offered by United States government agencies and instrumentalities. For instance, if the evidence supports a finding that it is commonplace for government agencies to sell or license the sale of consumer merchandise featuring agency names or acronyms, such as clothing, toys, key chains, and calendars, a false connection with a government agency would be presumed if that agency name or acronym is used in connection with those goods and, therefore, the mark should be refused registration under §2(a).

The examining attorney may contact the Trademark Law Library regarding resource materials relating to government agencies and instrumentalities. The examining attorney may also require the applicant to provide additional information about the mark and/or the goods or services, under Trademark Rule 2.61(b). 37 C.F.R. §2.61(b).

Disclaiming the name of, or acronym for, the United States government agency or instrumentality to which the mark refers generally will not overcome the §2(a) refusal. See TMEP §1213.03(a) regarding unregistrable components of marks. If the applicant is the government agency or instrumentality referenced in the mark, no disclaimer of the name or acronym of the agency or instrumentality is necessary because the agency or instrumentality retains the rights to its name or acronym, unless specifically prohibited by statute. A disclaimer of the relevant portion of the mark is required when (i) the applicant is not the government agency or instrumentality referenced in the mark, (ii) the nature of the goods or services is such that the government agency name or acronym is used in a descriptive manner to describe the identified goods or services, and (iii) the mark does not otherwise establish a false connection with the named government agency or instrumentality. For example, the wording “homeland security” in a mark may refer to the United States government agency responsible for handling terrorist threats on American soil or it may be used descriptively to describe actions taken to protect against terrorist attacks. The appropriateness of disclaiming “homeland security” will depend on examination of the mark as a whole in the context of the goods or services of record.

The §2(a) false connection of a suggestion refusal and the procedures stated above also apply to marks containing names of, and acronyms and terms for, United States government programs (e.g., Medicare), military projects (e.g., BigDog), and quasi-government organizations (e.g., Smithsonian Institution), even if such programs, projects, and organizations are not protected by separate statute.

1203.03(c)(iii) False Suggestion of a Connection: Case References

False suggestion of a connection was found in the following cases: *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 91 USPQ2d 1218 (Fed. Cir. 2009) (holding SHINNECOCK BRAND FULL FLAVOR and SHINNECOCK BRAND LIGHTS, both for cigarettes, falsely suggest a connection with the Shinnecock Indian Nation); *In re Sauer*, 27 USPQ2d 1073 (TTAB 1993), *aff'd per curiam*, 26 F.3d 140 (Fed. Cir. 1994) (finding registration of BO BALL for oblong shaped leather ball with white stitching properly refused under §2(a), since use of “Bo” would be recognized by purchasers as reference to football and baseball player Bo Jackson, and there was no connection between Jackson and applicant); *In re Jackson Int'l Trading Co. Kurt D. Bruhl GmbH & Co. KG*, 103 USPQ2d 1417 (TTAB 2012) (affirming §2(a) refusal to register the mark BENNY GOODMAN COLLECTION THE FINEST QUALITY (stylized) for fragrance and cosmetics because the mark falsely suggests a connection with the deceased musician Benny Goodman; the record showed that Benny Goodman's estate has a business representative that grants people the use of his name and/or persona); *In re Peter S. Herrick, P.A.*, 91 USPQ2d 1505 (TTAB 2009) (Board affirmed §2(a) refusal, finding U.S. CUSTOMS SERVICE and seal design for attorney services falsely suggests a connection with the government agency formerly known as the United States Customs Service and now known as the United States Customs and Border Protection); *Hornby v. TJX Cos., Inc.*, 87 USPQ2d 1411 (TTAB 2008) (affirming refusal of registration of TWIGGY for children's clothing, on the ground that it would falsely suggest a connection with the internationally known British model and actress who was a major celebrity in the late 1960s, finding that she retained a sufficient degree of fame or reputation that a connection would still be presumed by consumers seeing the mark TWIGGY on children's clothing as of the date on which respondent's registration issued in 2000); *Association Pour La Def. et la Promotion de L'Oeuvre de Marc Chagall dite Comite Marc Chagall v. Bondarchuk*, 82 USPQ2d 1838 (TTAB 2007) (granting petition to cancel registration of MARC CHAGALL for vodka because the totality of the evidence of record established a false suggestion of a connection with the painter Marc Chagall); *In re White*, 80 USPQ2d 1654 (TTAB 2006) (affirming refusal of MOHAWK for cigarettes under §2(a), on the ground that it would falsely suggest a connection with the federally recognized tribe the St. Regis Band of Mohawk Indians of New York); *In re White*, 73 USPQ2d 1713 (TTAB 2004) (holding APACHE, for cigarettes, falsely suggests a connection with the nine federally recognized Apache tribes); *In re Urbano*, 51 USPQ2d 1776 (TTAB 1999) (holding SYDNEY 2000, used for advertising and business services and communication services, falsely suggests connection with Olympic Games, since general public would recognize phrase as referring unambiguously

to Olympic Games to be held in Sydney, Australia, in 2000; entire organization that comprises Olympic games qualifies as “institution.”); *In re N. Am. Free Trade Ass’n*, 43 USPQ2d 1282 (TTAB 1997) (holding NAFTA, used on “promotion of trade and investment” services, falsely suggests connection with North American Free Trade Agreement; NAFTA qualifies as institution because it encompasses treaty, supplemental agreements, and various commissions, committees and offices created by those documents); *In re Sloppy Joe’s Int’l Inc.*, 43 USPQ2d 1350 (TTAB 1997) (holding use of mark SLOPPY JOE’S, with design that includes portrait of Ernest Hemingway, falsely suggests connection with deceased writer); *Bd. of Tr. of Univ. of Alabama v. BAMA-Werke Curt Baumann*, 231 USPQ 408 (TTAB 1986) (granting petition to cancel registration of BAMA, for shoes, slippers, stockings, socks, and insoles, and finding that the evidence of record indicated that BAMA points uniquely to the University of Alabama and thus falsely suggests a connection with the University); *In re Cotter & Co.*, 228 USPQ 202 (TTAB 1985) (holding WESTPOINT, for shotguns and rifles, to falsely suggest a connection with an institution, the United States Military Academy); *Buffett v. Chi-Chi’s, Inc.*, 226 USPQ 428 (TTAB 1985) (denying applicant’s motion for summary judgment since evidence of record supported an association of MARGARITAVILLE with the public persona of opposer Jimmy Buffett); *In re U.S. Bicentennial Soc’y*, 197 USPQ 905 (TTAB 1978) (holding U.S. BICENTENNIAL SOCIETY, for ceremonial swords, to falsely suggest a connection with the American Revolution Bicentennial Commission and the United States government); *In re Nat’l Intelligence Acad.*, 190 USPQ 570 (TTAB 1976) (holding NATIONAL INTELLIGENCE ACADEMY, for educational and instructional services in intelligence gathering for law enforcement officers, to falsely suggest a connection with the United States government); *In re Nat’l Collection & Credit Control*, 152 USPQ 200 (TTAB 1966) (holding the word “national” along with an outline representation of the United States or a representation of an eagle used for collection and credit services falsely suggests a connection with United States government).

False suggestion of a connection was not found in the following cases: *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 1377, 217 USPQ 505, 509 (Fed. Cir. 1983), *aff’d* 213 USPQ 594 (TTAB 1982) (holding NOTRE DAME and design, for cheese, not to falsely suggest a connection with the University of Notre Dame. “As the Board noted, ‘Notre Dame’ is not a name solely associated with the University. It serves to identify a famous and sacred religious figure and is used in the names of churches dedicated to Notre Dame, such as the Cathedral of Notre Dame in Paris, France. Thus it cannot be said that the only ‘person’ which the name possibly identifies is the University and that the mere use of NOTRE DAME by another appropriates its identity.”); *Bos. Athletic Ass’n v. Velocity, LLC*, 117 USPQ2d 1492, 1496-99 (TTAB 2016) (finding applicant’s use of MARATHON MONDAY on clothing does not falsely suggest a connection with opposer because the evidence did not establish that MARATHON MONDAY is perceived by the relevant public as a close approximation of the name or identity of opposer, and frequent and various third-party uses of MARATHON MONDAY indicated that the term does not point uniquely and unmistakably to opposer); *In re MC MC S.r.l.*, 88 USPQ2d 1378, 1381 (TTAB 2008) (reversing §2(a) refusal of MARIA CALLAS for jewelry and other goods, because the record contained contradictory evidence as to the existence of anyone currently possessing rights in the name “Maria Callas,” and resolving doubt in favor of applicant “removes the possibility that we might be denying registration to an applicant based on non-existent rights,” and because a person or entity claiming rights in a name or persona has recourse since §2(a) is not time barred); *In re Los Angeles Police Revolver & Athletic Club, Inc.*, 69 USPQ2d 1630 (TTAB 2004) (holding slogan TO PROTECT AND TO SERVE, used by applicant Los Angeles Police Revolver and Athletic Club, Inc., does not *falsely* suggest a connection with the Los Angeles Police Department, where evidence showed an actual longstanding commercial connection, publicly acknowledged and endorsed by both parties); *Internet Inc. v. Corp. for Nat’l Research Initiatives*, 38 USPQ2d 1435 (TTAB 1996) (holding cancellation petitioners failed to state claim for relief where they have not alleged, and cannot reasonably allege, that the term INTERNET points uniquely and unmistakably to their own identity or persona); *Ritz Hotel Ltd. v. Ritz Closet Seat Corp.*, 17 USPQ2d 1466, 1471 (TTAB 1990) (holding RIT-Z in stylized form, for toilet seats, not to falsely suggest a connection with opposer, the Board observing that

there was “no evidence of record directed to showing a connection of applicant’s mark with opposer corporation, The Ritz Hotel Limited”); *In re Nuclear Research Corp.*, 16 USPQ2d 1316 (TTAB 1990) (holding NRC and design, for radiation and chemical agent monitors, electronic testers, and nuclear gauges, not to falsely suggest a connection with the U.S. Nuclear Regulatory Commission in view of applicant’s use of NRC long prior to the inception of that agency); *NASA v. Bully Hill Vineyards, Inc.*, 3 USPQ2d 1671, 1676 (TTAB 1987) (dismissing opposition to the registration of SPACE SHUTTLE for wines and finding “shuttle” to be a generic term for a space vehicle or system. “Where a name claimed to be appropriated does not point uniquely and unmistakably to that party’s personality or ‘persona,’ there can be no false suggestion.”); *In re Mohawk Air Serv. Inc.*, 196 USPQ 851 (TTAB 1977) (holding MOHAWK 298 to not falsely suggest a connection with the U.S. Army and the Army’s use of the term “Mohawk” to identify one of its airplanes, since there was no evidence of record that the Army continuously used that term since 1958, that the public is aware of such use, or that the public would associate “Mohawk” named airplanes with the Army); *NASA v. Record Chem. Co. Inc.*, 185 USPQ 563 (TTAB 1975) (dismissing opposition to registrations of APOLLO 8 for moth preventatives and mothproofing agent-air freshener because, while NASA is a juristic person and prior user of the terms APOLLO and APOLLO 8 for its space missions, it is unlikely that the average purchaser of applicant’s goods would assume NASA to be source or sponsorship of the goods or mistakenly believe that the goods are of NASA space exploration technology); *FBI v. Societe: “M.Brill & Co.”*, 172 USPQ 310 (TTAB 1971) (dismissing opposition to registration of FBI FABRICATION BRIL INTERNATIONAL for clothing since it is unreasonable that the public would assume applicant’s goods originate with, are sponsored or endorsed by, or associated with the Federal Bureau of Investigation, finding that “FBI” represents “Fabrication Brill International” and purchasers will see the entire composite mark on the goods and not just “FBI,” and noting that both the United States government and the Federal Bureau of Investigation are juristic persons); *In re Horwitt*, 125 USPQ 145, 146 (TTAB 1960) (holding U. S. HEALTH CLUB registrable for vitamin tablets. “Considering both the nature of the mark and the goods, it is concluded that the purchasing public would not be likely to mistakenly assume that the United States Government is operating a health club, that it is distributing vitamins, or that it has approved applicant’s goods.”); *Lucien Piccard Watch Corp. v. Since 1868 Crescent Corp.*, 314 F. Supp. 329, 165 USPQ 459 (S.D.N.Y. 1970) (holding DA VINCI not to falsely suggest a connection with the deceased artist Leonardo Da Vinci).

1204 Refusal on Basis of Flag, Coat of Arms, or Other Insignia of United States, State or Municipality, or Foreign Nation

15 U.S.C. §1052 (Extract)

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it ... (b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

Section 2(b) of the Trademark Act, 15 U.S.C. §1052(b), bars the registration on either the Principal Register or the Supplemental Register of marks that consist of or comprise (whether consisting solely of, or having incorporated in them) the flag, coat of arms, or other insignia of the United States, of any state or municipality of the United States, or of any foreign nation. See *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli, S.p.A.*, 32 USPQ2d 1192, 1196 (TTAB 1994) (noting that “it would appear that the reference to ‘municipality’ in the Statute is to a municipality in the United States, and that prohibition of registration with respect to foreign coats of arms, etc., is to those of the countries themselves, rather than to those of the states or municipalities of the foreign countries”). Moreover, registration of all such official insignia is barred regardless of the identity of the applicant, that is, the statutory prohibition allows no exception even when the applicant is a government entity seeking to register its own flag, coat of arms, or other insignia. *In re City of Houston*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013).