

This Opinion is not a  
Precedent of the TTAB

Mailed: February 14, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re W.F. Young, Inc.*

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Serial No. 86454618

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Jeffrey E. Schiller of Grogan, Tuccillo & Vanderleeden, LLP,  
for W.F. Young, Inc.

Barbara A. Gaynor, Trademark Examining Attorney, Law Office 115,  
Daniel Brody, Managing Attorney.

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Before Zervas, Lynch and Coggins,  
Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

W.F. Young, Inc. (“Applicant”) seeks registration on the Principal Register of the

proposed mark  for the following goods:

“Non-medicated cleaning preparations for livestock, horses and domestic animals, namely, shampoos, hair polish, detanglers, conditioners, fragrance sprays, stain removers; coat, mane and tail whiteners; mane and tail cleaners; non-medicated hoof care products namely conditioners, moisturizing creams and polish” in International Class 3;

“Veterinary preparations for livestock, horses and domestic animals, namely, liniments, antimicrobials for dermatologic use, medicated shampoos, topical analgesics and anti-inflammatory creams, ointments and sprays; animal feed supplements and feed additives for use as dietary supplements and animal health supplements; medicated hoof ointments; hoof packing for reducing hoof heat, pain, swelling and for killing and preventing growth of bacterial and fungal infections; insecticides, insect repellents and flea and tick control products in the form of liquids, sprays, creams, shampoos, powders, spot-ons and dips” in International Class 5;

“Bag netting for covering eyes and head for livestock and horses” in International Class 18; and

Sponges, combs and brushes; shedding combs and brushes; cleaning mitts for grooming livestock[,] horses and domestic animals” in International Class 21.<sup>1</sup>

The mark is described as a banner with a ribbon-like shape. Color is not claimed as a feature of the mark.

The Examining Attorney refused registration of Applicant’s mark under Trademark Act Section 2(d), 15 U.S.C. §1052(d), based on the following two registrations which issued to different registrants:

- Registration No. 4653735 (“the ‘735 registration”) for the

*Head to Tail*

mark  (HEAD TO TAIL and design) for “dietary supplements for pets” in International Class 5;<sup>2</sup> and

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<sup>1</sup> Application Serial No. 86454618, filed on November 14, 2014. The application claims first use and first use in commerce on January 9, 2014 for all goods.

<sup>2</sup> Registered December 9, 2014. The description of the mark in the registration states, “The mark consists of the words ‘Head to Tail’ above a banner with a tail-like stroke creating the ‘H’ in the word ‘Head’ and crossing the ‘T’ in the word ‘Tail.’” Color is not claimed as a feature of the mark.

- Registration No. 4724070 (“the ‘070 registration”) for the



mark (BIOMANE and design) for “topical body lotion” in International Class 3; and “veterinary preparations in the form of equine pellets for the thickening of horse manes” in International Class 5.<sup>3</sup>

In addition, the Examining Attorney refused registration under (i) Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127, because Applicant’s mark, as used



on the specimens of record, as or , is merely a background design which is part of a composite mark that incorporates additional wording and hence fails to function as a trademark; and (ii) Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127, because the International Class 21 specimen of record does not show Applicant’s mark in use in commerce in connection with any of the International Class 21 goods.

After the Examining Attorney made the refusals final, Applicant appealed to this Board and requested reconsideration. The Examining Attorney denied the request for reconsideration. The appeal resumed and both Applicant and the Examining Attorney filed briefs.

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<sup>3</sup> Registered April 21, 2015. The description of the mark in the registration states, “The mark consists of a banner/ribbon with the words ‘BioMane’ across it.” Color is not claimed as a feature of the mark.

## I. Failure to Function as a Mark

We begin with the Examining Attorney's failure to function refusal under Sections 1, 2 and 45 of the Trademark Act. By way of background, we note that the application was filed as an intent-to-use application pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b). On September 2, 2015, after the issuance of the first Office Action, Applicant filed an Amendment to Allege Use, submitting the following specimen (a webpage):



In the subsequent Office Action of September 22, 2015, the Examining Attorney issued a failure to function refusal under Sections 1, 2 and 45 for the first time, citing TRADEMARK MANUAL OF EXAMINING PROCEDURE ("TMEP") §§904.07(b) and 1202.11 (June 2017), and stating:

Registration also is refused because the applied-for mark, as used on the specimens of record, is merely a background design that functions as part of a composite mark that incorporates additional designs or wording. As such, it does not function separately as a mark. ...

The applicant has applied to register the design of a blank ribbon-shaped banner. The specimens show the mark as the word “ABSORBINE” in the center of a ribbon-shaped banner. The ribbon-shaped banner is not sufficiently distinctive or unique so as to create a separate commercial impression apart from the word “ABSORBINE.”

The Examining Attorney also offered Applicant the option of claiming acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. §1052(f), or amending the application to seek registration on the Supplemental Register.<sup>4</sup>

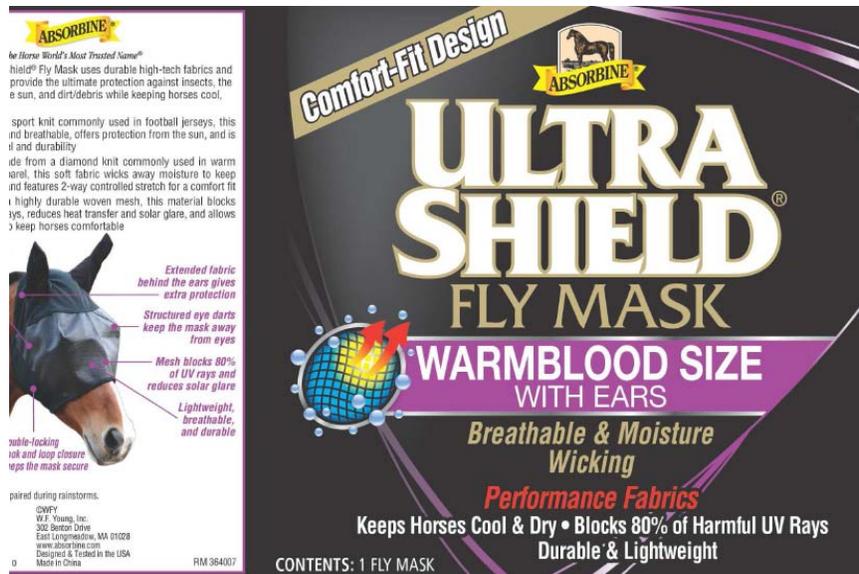
In a response filed on March 21, 2016, Applicant argued against the failure to function refusal and submitted additional specimens, evidently in a “product series,”<sup>5</sup> including the following specimens (images of its actual goods and a label):



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<sup>4</sup> TSDR 1.

<sup>5</sup> March 21, 2016 Resp., TSDR 2-3, 10-11.



The additional specimens did not persuade the Examining Attorney to withdraw her refusal. She stated in the Final Office Action:

The failure to function as a trademark refusal is based solely on the applicant's use of the applied-for mark on the specimens of record. In this case, the specimens of record all show that the mark consists of the word "ABSORBINE" printed across the center of the ribbon-shaped banner. The applied-for mark, the ribbon-shaped banner, functions solely as a background design and does not create a commercial impression apart from the word "ABSORBINE."<sup>6</sup>

Where an applicant seeks to register a background design that is used in connection with a word mark, that background design may be registered as a trademark only if it creates a commercial impression separate and apart from the word mark in conjunction with which it is used. *In re Anton/Bauer Inc.*, 7 USPQ2d 1380 (TTAB 1988) (citing 1 J.T. McCarthy, TRADEMARKS AND UNFAIR COMPETITION, 200 (2d ed. 1984)). See also *In re Benetton Group S.p.A.*, 48 USPQ2d 1214 (TTAB

<sup>6</sup> April 9, 2016 Office Action, TSDR 1.

1998). “If the background design is inherently distinctive, it may be registered without evidence that it is recognized as a trademark (i.e., without proof of secondary meaning); if it is not inherently distinctive, such proof is essential.” *Id.* at 1381 (citing *In re E.J. Brach & Sons*, 256 F.2d 325, 118 USPQ 308, 310 (CCPA 1958)).<sup>7</sup> Professor McCarthy has commented that “the more fanciful and distinctive the background design, the more likely it is to ‘hit the buyer in the eye’ and hence be more than background. In such a case, the so-called ‘background’ comes out into the spotlight of real trademark significance.” J.T. McCarthy, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* §7.27 (5th ed. Dec. 2017 update).

For the reasons set forth below, we find that the ribbon-shaped banner design does not create a commercial impression separate and apart from the word mark with which it is used but rather is merely a background design, and that the purchasing public would be unlikely to regard this design as identifying and distinguishing Applicant’s goods and indicating their source. None of the specimens show use of the ribbon-shaped banner design alone; they all have ABSORBINE superimposed thereon. Further, ABSORBINE is depicted in the center of the ribbon-shaped banner in large lettering that covers much of the design, and its lettering follows the incline in its central portion. The arrangement of the wording and the geometry of the ribbon-shaped banner in the specimens suggest that they are part of the same mark. Because

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<sup>7</sup> Applicant rests on the inherent distinctiveness of its design inasmuch as it has not sought registration under Section 2(f).

color is not claimed as a feature of the design, we do not consider the vivid yellow background as distinguishing the design.

Professor McCarthy has characterized the issue as “whether this shape is so unusual for this type of goods or services that its distinctiveness can be assumed.” *Id.* at §7.33.<sup>8</sup> Applicant’s ribbon-shaped banner is used in connection with goods intended for livestock, horses and domestic animals, and the cited registered marks, which include ribbons, are for goods intended for horses and pets. From these materials, we cannot conclude that ribbons are uncommon in connection with pets, livestock, horses and domestic animals. The ribbon shape of the banner hence is not so unusual for such animal-related goods.

We recognize that the record does not show any other uses of the same specific combined design employed by Applicant. The design, however, appears to be no more than a mere refinement of a basic background and would be so regarded by the public. That is to say, while the design sought to be registered may be unique in the sense that there is no evidence that others in the animal products trade are using an identical ribbon-shaped banner, it is nonetheless not inherently distinctive.

In sum, we find that Applicant’s applied-for design fails to emerge out of the background of the specimens and hit the prospective buyer in the eye, and find that Applicant’s ribbon-shaped banner is a background design that does not create a

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<sup>8</sup> We note too that “common geometric shapes such as circles, ovals, triangles, diamonds and stars, when used as backgrounds for the display of word or letter marks, are not regarded as trademarks for the goods to which they are applied absent evidence of distinctiveness of the design alone.” *In re Anton/Bauer Inc.*, 7 USPQ2d at 1381 (citing *In re Raytheon Co.*, 282 USPQ 317 (TTAB 1979)).

commercial impression separate and apart from the word mark in conjunction with which it is used. Thus, it does not function as an indicator of the source of Applicant's goods.

## II. Remaining Issues

In view of our affirmance of the failure to function refusal under Sections 1, 2 and 45, we need not consider the likelihood of confusion or specimen refusals.

**Decision:** The Section 1, 2 and 45 refusal to register is affirmed for each International Class.