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### What We've Got Here Is a Failure to Indicate

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## WHAT WE'VE GOT HERE IS A FAILURE TO INDICATE

🕒 Dec 4, 2019 | 👤 Laura A. Heymann | 💬 Add a Comment

Alexandra J. Roberts, *Trademark Failure to Function*, 104 Iowa L. Rev. 1977 (2019).

When a new word or catchphrase enters the social lexicon, some individuals will rush to the U.S. Patent and Trademark Office to try to be the first to obtain a trademark registration. That was the case with one John E. Gillard, who applied *pro se* to register #COVFEEFE for hats, T-shirts, and related goods mere hours after the President included the word at the end of a midnight tweet on May 31, 2017. The Trademark Trial and Appeal Board [affirmed refusal](#) of the registration on the grounds that #COVFEEFE, as a “sui generis nonsense word” that allowed users and observers to “project onto it any meaning they wish,” failed to function as a trademark for the applicant’s goods, particularly given the wide array of merchandise from different sources already featuring the term.



[Laura A. Heymann](#)

The question may be a bit murkier, though, when the applied-for mark has a closer association with the applicant. In August, many media outlets were abuzz with the news that The Ohio State University had filed an [application](#) seeking a trademark registration for the word THE, for use on “clothing, namely t-shirts, baseball caps and hats” in “standard characters, without claim to any particular font style, size, or color.” Included among the submitted specimens was a [photograph](#) of a women’s T-shirt from “The Official Team Shop of Buckeye Nation®,” depicting a red shirt with the word THE in large block letters, with a smaller Ohio State logo underneath, as well as a [photograph](#) of a white baseball cap with the word THE in large red capital letters. The popular reaction seemed to revolve around the perception that it was ludicrous to obtain a trademark registration for a common English word, even though many such trademarks exist. (APPLE comes immediately to mind.)

A more nuanced critique, as Alexandra Roberts’s insightful article [Trademark Failure to Function](#) helps us to understand, would ask whether THE functions as a trademark in this context — whether consumers would use the word THE on the front of a T-shirt or cap to allow them to find merchandise produced by (or perhaps authorized by) the university or whether the word functions simply as an expressive device, a way of communicating support for the institution and/or its athletic teams (what trademark law calls ornamental use). This, of course, is not an issue limited to Ohio State’s application. A consumer who buys a t-shirt with a swoosh on the front may be using the swoosh both to identify a perceived high-quality shirt

and to communicate to others that the consumer is a person who wears Nike apparel. But when what is on the front of the shirt is less likely to be used to communicate the quality of the manufacture, as with many T-shirts adorned with words or graphics, one might ask whether it is functioning as a trademark at all. Indeed, on September 11, the trademark examining attorney [refused Ohio State's registration](#). Given the location of the word THE on the "upper-center area on the front of the shirt and the front portion of the hat, where ornamental elements often appear," the examining attorney concluded, the word did not function as a trademark to indicate the source of Ohio State's merchandise. It remains to be seen whether Ohio State will challenge this conclusion or abandon its attempt to seek registration.

Professor Roberts's article highlights that the "failure to function" doctrine has not received enough attention from trademark scholars, particularly in comparison to the question of trademark distinctiveness. The two are different, although related. Distinctiveness analyzes the semantic content of a mark — whether consumers will understand the mark to have a relationship to its good or service that conveys that it is functioning as a proper name and not as a description or generic term. The trademark GREYHOUND for bus services will be interpreted by consumers as a proper name, we surmise, because the term is being deployed metaphorically. One must first understand that greyhounds are known for being fast animals before one can understand that the mark suggests that the bus service is also fast. Because the mark owner could have conveyed this information more directly by using a word like "speedy," we assume that consumers will conclude that the choice to use a metaphor must mean that the mark owner intends the mark as a name. The *Abercrombie* spectrum (derived from [Abercrombie & Fitch Co. v. Hunting World, Inc.](#)), a hierarchy of trademark distinctiveness, is a mainstay of trademark validity analysis.

Whether a trademark functions as a mark, however, asks whether the mark "appear[s] where consumers expect a trademark to appear" and whether it is "sufficiently set off from the surrounding text and images to attract notice" (P. 1981) — in other words, the "visual relationship" between the mark and its goods or services rather than the "conceptual relationship" between them. (P. 1983.) The interaction between distinctiveness and function, Professor Roberts contends, is "interdependent and inverse: the less distinctive a mark is, the greater indicators of trademark use are needed to ensure consumers will perceive it as a mark, and vice-versa." (P. 1987.) In other words, consumers might recognize a fanciful term such as a pharmaceutical name no matter how it appears, but a less distinctive mark might require visual clues such as font, color, design, or a ™ symbol to convey that it is intended as a mark. These are things that the marketing and design literature has studied for some time, and Professor Roberts mines the research to demonstrate the importance of a consumer-centric analysis. Scholars building on her work might think about the ways in which these interpretations depend, as Rebecca Tushnet has [noted](#), on understanding the role of implication in speech and on cultural competency; considerations of literacy, visual acuity, and other tools that consumers may or may not bring to the table may also complicate the analysis.

Because courts have not paid enough attention to the failure to function doctrine, writes Professor Roberts, and often analyze it separately from distinctiveness, the doctrine has been underdeveloped, which means that some faulty registrations have managed to escape close review. A tandem review also militates against strategic lawyering, as Professor Roberts points out, as a savvy trademark practitioner can easily help her client overcome a failure to function refusal by, for example, advising the creation of a hangtag or other ways commonly used to indicate trademark use.

The article caused me to think more deeply about something I had largely taken for granted. Professor Roberts's focus is largely on word marks, but her analysis of trade dress and the *Seabrook* standard provides a helpful way of considering the various ways in which we assume consumers will understand trademarks. The more nuanced analysis she suggests doesn't always, of course, provide an easy answer. Professor Roberts cites as examples of error the registration of #BeUnprecedented for legal research services and #SharetheSilence for alcoholic beverages, contending that the specimens offered no evidence that consumers would see these as anything but hashtags. (Pp. 2011-2012.) But a marketing expert might argue that those are exactly the kinds of phrases one would develop as a slogan for a client, and consumers in this context might assume that the hashtag developed from a slogan, rather than the reverse. Those who follow the news might immediately understand that #COVFEEFE refers to the President's tweet, not to any one manufacturer, but do buyers of Ohio State apparel understand THE to be only an expression of fan support or also an indicator of licensed merchandise? And if the university's registration attempt is ultimately successful, what will consumers learn from that about trademark law generally?

Professor Roberts's article reminds us that consumer perceptions are both the cause and the result of trademark validity. And it comes at the right time: The TTAB, as John L. Welch has documented, appears to be focusing more on failure-to-function in recent months, which makes Professor Roberts's article even more relevant for practitioners as well as scholars. (A commenter at Mr. Welch's blog offers the perceptive [suggestion](#) that the recent spate of failure-to-function denials at the TTAB may be evidence of a developing post-*Brunetti* strategy, as [this example](#) may confirm.) Failure to function may have been a somewhat dormant doctrine in recent years, but thanks to Professor Roberts, we can better understand the benefits of its coming out of hibernation.



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