

Taco Tuesday for Everyone (But Not to Register as a Trademark)

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According to a recent ESPN report, Los Angeles Lakers basketball player LeBron James made “IT’S TACO TUESDAY” T-shirts to promote his video posts of his family’s taco nights. He then sought a trademark registration for the phrase for use on T-shirts and other goods. Unfortunately for LeBron, his shot to beat others down the court for

Tuesday tacos fell short. In an office action refusing the application, the U.S. Patent and Trademark Office said that TACO TUESDAY “is a commonplace term, message, or expression widely used by a variety of sources that merely conveys an ordinary, familiar, well-recognized concept or sentiment message.”

To be eligible for trademark registration, a word, symbol or phrase must function as a mark. In other words, the matter must serve to indicate the source of the goods/services and to identify and distinguish the goods/services from those of other sources. Matter that fails to indicate the source of goods/services is therefore ineligible for trademark registration.

As one example, matter that simply informs purchasers about certain features, characteristics or functions of a product would not be perceived as a source indicator but rather as merely informational or explanatory content.

Another way in which a designation could fail to function as a trademark is if it is a common phrase or widely used message, in which case it would not be perceived as a source indicator. As demonstrated by the LeBron application, “Taco Tuesday” on a T-shirt is more likely to be perceived by the public as a general celebration of eating tacos on Tuesday, a sentiment associated with many different sources and public uses, rather than indicating that LeBron James’ company is the source of the T-shirt.

According to USPTO policy, “a common phrase or message that would ordinarily be used in advertising or in the relevant industry, or that consumers are accustomed to seeing used in everyday speech by a variety of sources” is considered merely “informational matter” that fails to function as a source indicator and is thus not registrable. TMEP §1202.04(b).

In another recent case, the famous rapper Cardi B was refused a trademark registration for her catchphrase “Okurr”, as it was considered “commonplace.” In the Office Action refusal, the USPTO stated, “a minor variation of this term, e.g., OKURRR, is commonly used in the drag community and by celebrities as an alternate way of saying ‘OK’ or ‘something that is said to affirm when someone is being put in their place.’ Because consumers are accustomed to seeing this term or expression commonly used in everyday speech by many different sources, they would not perceive it as a mark identifying the source of applicant’s goods and/or services but rather as only conveying an informational message.” While Cardi B may have coined the phrase, the phrase became so integrated into everyday language that it was no longer only associated with Cardi B as the source, and it became too late for Cardi B to register the mark.

Another way in which matter might fail to function as a mark is if it is purely ornamental or decorative in the context of the applied-for goods, a ground of refusal often asserted when T-shirts and other promotional merchandise are involved. This principle was recently demonstrated by the USPTO’s refusal of an application filed by Ohio State University to register the word “THE” for clothing, such as T-shirts and hats. In this instance, the mark was not refused based on its commonality—and can you think of a more common word than “the”? Instead, the mark was refused based on how the words

were presented on the specimen submitted to the USPTO. According to the USPTO, “the applied-for mark as used on the specimen of record is merely a decorative or ornamental feature of applicant’s clothing and, thus, does not function as a trademark to indicate the source of applicant’s clothing and to identify and distinguish applicant’s clothing from others.” The rejection issued by the USPTO suggests the university may be able to receive trademark protection for “THE” so long as it is applied to clothing in a manner that clearly signifies association with Ohio State and its brand (e.g., small or discrete wording as opposed to the large font dominating the overall appearance of the goods).

What is particularly notable about failure-to-function refusals based on the informational nature of a mark is that the refusals “cannot be overcome by claiming acquired distinctiveness, by amending the application to seek registration on the Supplemental Register, or by merely submitting an otherwise acceptable substitute specimen.” USPTO Examination Guide 2-17, Merely Informational Matter, July 2017, at 3.

On the other hand, a refusal on the ground that a mark fails to function due to ornamental use may be overcome by submitting a different specimen that shows proper trademark use (e.g., hang tags and labels used inside a garment that more clearly indicate source). However, according to USPTO guidance, “[i]f the evidence shows that the public would not perceive the proposed mark as serving to indicate the source of the identified goods/services, the mark may not be registered regardless of the manner of use depicted on the specimens or the filing basis on which applicant relies.” Examination Guide 2-17 at 13.

Essentially, if you want the USPTO to say “Okurr” to your trademark, make sure the matter you seek to register is more likely to be associated with your brand than it is to be considered merely an everyday use or ornamental display of the designation.