



THE TIPSHEET

State Bar of Texas Intellectual Property Law Section

Vol. 16 No. 1

MESSAGE FROM THE CHAIR



by Michael G. Locklar

Welcome to our 2021/2022 session for our Section. We are excited to transition to in-person events this year. Our Section hosts two large CLE events throughout the year: the Advanced Intellectual Property course held in February (February 16–18) and the IP track at the State Bar of Texas Annual Meeting held in June. In addition, our committees put on other educational events, for example, the Trademark Committee regularly hosts Trademark Boot Camps designed as a primer for those new to trademark law. As described in this Tip Sheet, the Patent Committee is sponsoring a hosting a state-wide virtual chapter to benefit practitioners across the state who are not able to attend the Austin, Dallas, or Houston bar association intellectual property sections. A great way to get involved in the educational component of our mission is to join a substantive committee of the Section (Copyright, Patent, Trademark, or Trade Secrets).

We also are committed to connecting intellectual property lawyers across the state to increase the collegiality of the IP bar and provide opportunities for fellowship and mentorship. Our committees are meeting virtually and in-person and developing valuable relationships. If connecting people is where you think you may best serve the IP community, I would encourage you to join one of our Connect committees (Women in IP, Diversity, Membership, New Lawyers, or Website) by reaching out to me or the chair of that committee.

Finally, we take our mission to serve our members and the IP community in Texas very seriously. As we transition to in-person events this year, we are planning at least one Pro Bono tour to provide local inventors, artists, and small businesses education and counseling on IP issues. We continue to plan even more of those events for the future. We also are committed to recording the history of IP law in Texas through our IP Legends program and through awards, such as the Inventor-of-the-Year and Trademark Awards. If you have suggestion for this year's Inventor-of-the-Year or Trademark award, please check our website for submission forms. Further, if service is of interest to you, I encourage you to join one of our Service committees (Pro Bono, Public Relations, or IP Legends) by contacting the chair or reaching out to me. We also sponsor the work of the Texas IP Law Journal and we encourage your to attend their Symposium.

If you are not a member of the Section, I encourage you to join. If you are, I hope you will consider becoming more involved. I'm happy to answer any questions you may have.

Best Regards,

A handwritten signature in black ink, appearing to read "M. Locklar", is positioned above a faint, light-colored watermark. The watermark consists of a circular logo with the text "STATE BAR OF TEXAS" and "INTELLECTUAL PROPERTY LAW SECTION" around it.

Michael G. Locklar, Chair
Intellectual Property Law Section
State Bar of Texas

OCTOBER 2021 TIPSHEET FEATURED ARTICLE

In re Texas With Love, LLC:

Failure to Function or Failure of Logic?

by John R. Sommer¹

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Few trademark attorneys have not received a Failure to Function refusal without wondering why her application was refused and not others. The simple answer to this confusion is that the current Failure to Function doctrine is not capable of reasoned application. The refusal of the mark TEXAS LOVE is a good example to explain why.

The refusal of TEXAS LOVE was affirmed by the Trademark Trial and Appeal Board in *In re Texas With Love, LLC*, 87793802 (October 29, 2020) (precedential opinion). However, the Board's ruling is incorrect for several reasons that are detailed in this article.

1. Application for TEXAS LOVE

The application for TEXAS LOVE in Class 25 was filed with this specimen:



The examining attorney's first office action explained the refusal:

Registration is refused because the applied-for mark "TEXAS LOVE" is a slogan or term that does not function as a trademark or service mark to indicate the source of applicant's goods and/or services and to identify and distinguish them from others. Trademark Act Sections 1, 2, 3, and 45, 15 U.S.C. §§1051-1053, 1127. In this case, "TEXAS LOVE" 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.

The evidence attached to the office action showed use of Texas Outline with LOVE or Heart. But not a single example showed TEXAS LOVE.

In response, the applicant argued that TEXAS LOVE was not an unambiguous informational message. The applicant also referred to seven other registrations (BURMA LOVE, CALIFORNIA LOVE, EAST COAST LOVE, FLORIDA LOVE, SOUTHERN LOVE, VERONA LOVE,

¹ This article expresses only the views of the author. He argued and won *Iancu v. Brunetti*, 588 U.S. ___, 139 S. Ct. 2294, 204 L. Ed. 2d 714 (2019).

WAIKIKI LOVE) and argued that if those were registrable, then its application should also be approved.

A final office action was issued, maintaining the refusal. An appeal to the TTAB followed.

2. TTAB Decision in *Texas With Love*

The Board held that:

Because the evidence of record shows that TEXAS LOVE only serves as an expression of a concept or sentiment, and is widely used by third-parties, it would not be perceived as an indicator of source in the context of Applicant's identified goods. TEXAS LOVE thus fails to function as a trademark under Sections 1, 2 and 45 of the Trademark Act. 15 U.S.C. §§ 1051-1052, 1127.

The Board also concluded that the PTO's registration of analogous third-party marks was irrelevant. It also rejected the applicant's Equal Protection argument (this latter point is beyond the scope of this article).

3. The Refusal Might Have Been Correct if Based Upon Ornamental Specimens

Any attorney with much experience before the PTO knows that large words on the front of a t-shirt will not be accepted. The public is deemed to consider such use as ornamental. The author has no disagreement with that. Only if the words or logo are small, say on the left front pocket, would the public consider the words to be a brand, i.e., a trademark and source indicator.

The applicant's hat specimen showed TEXAS LOVE on one side of the front of a hat. The t-shirt specimens had the words covering most of the t-shirt. Why the Examining Attorney did not reject the specimens as ornamental is not clear. Had the refusal been on such grounds, the case would have been unremarkable. But the Board did not discuss this issue at all.

4. Is There a Rule that LOVE with Place Marks Are Not Registrable?

The Board's conclusion was, in effect, LOVE with a geographic location ("Place")² can never be registered. Ever. There is nothing in the Board's decision that limits this to Texas or this specific application. Nor is there any logical way to distinguish TEXAS LOVE from other similar marks.

The case most important to the Board's decision is *D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d 1710 (TTAB 2016). The PTO and the Board read *D.C. One* as creating an inflexible rule that LOVE Place marks cannot be registered. The Board quoted from *D.C. One*:

² For convenience, the author refers to Place LOVE, LOVE Place, and I [Heart] Place, as "LOVE Place" marks. There seems to be no logical difference between these variations. The Board did not see any difference either because it relied on the Texas Outline and Heart as equivalent to the word TEXAS and LOVE.

We find that phrase . . . on apparel and other souvenirs, whether displayed in the stacked format shown in the Registration or in the horizontal format shown in the Application, would be perceived by purchasers and prospective purchasers as an expression of enthusiasm for the city of Washington, DC.

If *D.C. One* stands for such proposition, then *Texas With Love* was easy to decide. But does *D.C. One* actually create such rule and if so, is it valid? To start with, *D.C. One* did not create any such rule. The Board in *D.C. One* only found that the registration for I [Heart] D.C. should be cancelled based on the record in that case which the Board decided showed primarily ornamental use.

Second, the *D.C. One* decision was a default case. The registrant did not file any brief. It is not surprising that the petitioner was successful. Default cases usually do not make for good law because the tribunal is given only one side.

Third, did *D.C. One* reflect the PTO’s actual practice then, or now? Justice Brandeis lived by the maxim, *ex facto jus oritur*, “the law arises out of fact.” What do the facts show? Let us first look at the ten largest states in the USA. Are LOVE Place marks registered for these states?

Ten Largest States (by Area)	Registration/Application
Alaska	I [Heart] LOVE ALASKA, 77658704 (NOA); LOVALASKA, Reg. 4585977
Texas	I [Texas map] TX, 4303076; I [heart] TEXAS, Reg. 1256446
California	I [heart] CALIFORNIA, 75121186 (NOA); CALIFORNIA LOVE, Reg. 4449946; I [heart] CALI, Reg. 4527885
Montana	MONTANA LOVE, 85585916 (OA on other grounds)
New Mexico	N [heart] M, published and opposed, 74216934
Arizona	ARIZONA LOVE, 88832554 (NOA); IN LOVE WITH ARIZONA, 1823191
Nevada	I LOVE NEVADA, 1562552
Colorado	DENVER COLORADO, 3905066; BIG COLORADO LOVE, 6093974
Oregon	LOVE, OREGON, 4320548
Wyoming	I [heart] WY, 85242036 (published, but opposed).

For the ten largest states by population and the ten largest cities, almost all are registered. Additionally, there are more than one hundred other LOVE Place registrations. From this, it is clear that the PTO almost always approves LOVE Place marks. In other words, the *D.C. One* case does not reflect the law nor the PTO's actual practice.

Why then, does the PTO rely on *D.C. One* as if it expressed the general rule? When confronted with evidence of the PTO's actual practice, the PTO ignores it (and Justice Brandies' maxim). The Board in *Texas With Love* said:

[A]llegations of disparate treatment, even if accurate, do not diminish the Board's and Examining Attorney's legitimate, nondiscriminatory reasons for denying registration. Even if his allegations were accurate, the most Applicant could establish is that the USPTO should have rejected the other marks. It does not follow that the proper remedy for such mischief is to grant Applicant's marks. . . .

The author has no objection to the principle that one or two incorrect allowances are not reason to incorrectly allow a third. But should that reasoning be applied if over one hundred registrations were correctly granted and one or two were incorrectly refused or invalidated (e.g., in *D.C. One*)? Obviously not.

5. Other Problems with the Failure to Function Doctrine

There are other problems with the PTO's use of the Failure to Function doctrine.

In general, the "evidence" that the PTO uses to show that a word or phrase is widely-used is almost always ornamental use. Ornamental use is, of course, not trademark use. How is such use relevant?

The PTO also confuses *used* with *widely used*. Just because a particular term is used, it is not necessarily widely used. In *Texas With Love*, the first office action had six examples of use. The final action had five more. A Google search on "t-shirts" comes up with 6 trillion hits. Eleven examples are not much compared to trillions. Even if the PTO comes up with dozens more examples, hundreds, or even thousands more, such examples still would not show that the term is *widely used*. If one wished to prove pink flowers are common, would a dozen, or even a hundred examples prove that proposition? Certainly not if one selected only pink flowers and ignored all examples of other colors. But this is exactly what the PTO does. And in fact, when the applicant provides actual data about the frequency of use, such as the applicant did in SN 88/308426 (response dated October 27, 2020), the PTO simply ignores the data. *See*, reconsideration letter dated January 8, 2021.

What is more, not a single example cited by the PTO in *Texas With Love* is for the mark that the applicant applied for, TEXAS LOVE. The Board relied on evidence of a different mark: Texas Outline with LOVE or Texas Outline with a heart. Those are not the same marks.

6. Conclusion

Rather than trying to argue for the withdrawal of Failure to Function refusals, it is time for practitioners to confront the misuse of that doctrine. *Texas With Love* illustrates some of these defects.

UPCOMING EVENTS AND ANNOUNCEMENTS

Pro Bono Opportunities

- The Patent Committee of the IP Section of the State Bar of Texas encourages Texas patent attorneys to help with the pro bono program of the USPTO Texas Regional Office which is administered in Texas by the Texas Accountants and Lawyers for the Arts (TALA). The pro bono program offers financially under-resourced, independent inventors in Texas assistance to turn their invention disclosures into filed patent applications. To that end, TALA hosts training courses and periodic clinics where volunteer attorneys provide initial evaluations of patentability and readiness for entry into the program and answer initial questions from inventors. TALA needs on-going volunteer support to assist with both filing of patent applications and with the intake process at its patent clinics.

- <https://talarts.org/volunteer/> (volunteering)

- <https://talarts.org/inventors/> (pro bono)

- <https://www.uspto.gov/patents/basics/using-legal-services/pro-bono/patent-pro-bono-program?MURL=probonopatents> (pro bono)

Patent Committee of the State Bar of Texas IP Section State-Wide Virtual Chapter

- The Patent Committee of the IP Section of the State Bar of Texas is hosting a state-wide virtual chapter to benefit practitioners across the state who are not able to attend the Austin, Dallas, or Houston bar association intellectual property sections. This virtual chapter will primarily use Zoom and other internet tools interspersed with in-person meetings across the state to provide for networking, hosting relevant speakers, promoting IP-related studies in the academic community, and other activities consistent with promoting professional networking and outreach for IP practitioners.

- Email texasbaripsection.patent@gmail.com by October 31, 2021 if interested in participating

2021-2022 IP SECTION OFFICERS & COUNCIL

The officers and council members for the Section were elected at the Annual Meeting last summer. They are as follows:

	Name	Firm	City
Chair	Michael Locklar	Locklar PLLC	Houston
Chair-Elect	Joseph Cleveland	Brackett & Ellis, P.C.	Fort Worth
Immediate Past Chair	Leisa Talbert Peschel	Jackson Walker LLP	Houston
Vice Chair	Devika Kornbacher	Vinson & Elkins LLP	Houston
Secretary	Craig Stone	Phillips 66	Houston
Treasurer	Thomas Kelton	Haynes & Boone, LLP	Richardson
Newsletter Officer	Erin Choi	Weil, Gotshal & Manges LLP	Dallas
Website Officer	Nick Guinn	Gunn Lee & Cave	San Antonio
Council			
<i>Term ends 2022</i>	David Cho	AT&T Services	Dallas
	Michele Connors	Cirrus Logic	Austin
	Kat Li	McKool Smith	Austin
<i>Term ends 2023</i>	Yocel Alonso	Alonso PLLC	Sugar Land
	Marylauren Ilagen	Mary Kay Inc.	Addison
	George W. Jordan, III	Norton Rose Fulbright US LLP	Houston
<i>Term ends 2024</i>	Michael Smith	Scheef & Stone, LLP	Marshall
	Austin Teng	Holland & Knight, LLP	Dallas
	Saurabh Vishnubhakat	Texas A&M School of Law	Fort Worth

IP SECTION COMMITTEES

Much of the Section's work is performed by committees, which help carry out its mission of educating, connecting and serving the Section's members. This year's committees and chairs are as follows:

Activities	Committees	Committee Chairs/Officers
<i>Educate:</i>	Copyright	Yocel Alonso
	Patent	Nick Guinn
	Trademark	Craig Stone
	Trade Secret	Austin Teng
	Newsletter	Erin Choi
	Advanced IP CLE	Devika Kornbacher
	Annual Meeting	Joe Cleveland
<i>Connect:</i>	Women in IP	Michele Connors
	Diversity	George Jordan
	Membership	Saurabh Vishnubhakat
	New Lawyers	David Cho
	Website	Nick Guinn
<i>Serve:</i>	Pro Bono/TALA	Michele Connors
	Public Relations	Marylaura Ilagen
	Tex IP Law	Kat Li
	IP Legends	Derrick Pizarro

CALL FOR SUBMISSIONS

The TIPSHEET welcomes the submission of articles for potential publication in upcoming issues, as well as any information regarding IP-related meetings and CLE events. If you are interested in submitting an article to be considered for publication or adding an event to the calendar, please email erin.choi@weil.com.

Article Submission Guidelines

STYLE: Journalistic, such as a magazine article, in contrast to scholarly, such as a law review article. We want articles that are current, interesting, enjoyable to read, and based on your opinion or analysis.

LENGTH: We accept a wide range of articles, with most falling into the 500-2500 word range.

FOOTNOTES AND ENDNOTES: Please use internal citations.

PERSONAL INFO: Please provide a one-paragraph bio and a photograph, or approval to use a photo from your company or firm website.

If you have any questions, please email erin.choi@weil.com.