

On My Mind Blog

Proving a Slogan Fails to Function as a Trademark

01.28.2025 By [William M. Borchard](#)

To be registrable, a trademark must identify and distinguish an applicant's goods from those of others and indicate the source of those goods.

When an Examining Attorney or an opposer challenges a phrase on the ground that it fails to function as a trademark, the burden is on the challenger to prove the phrase is merely informational or is a common phrase (ordinarily used in the industry). We previously covered this in "[Refuting a 'Failure to Function' Refusal to Register a Trademark](#)" concerning a case in which the Trademark Trial and Appeal Board (TTAB) reversed an Examiner's failure-to-function refusal to register MAKE YOUR PASSION YOUR PAYCHECK for clothing.

A recent opposition decision, in which the TTAB held evidence unpersuasive to establish a failure-to-function claim, is instructive as to what might constitute sufficient proof.



Anthony Uzzo applied to register FIRST YEAR DOWN for baby clothing, claiming nearly two years of use of that slogan as a trademark. TaShae Watson also sold baby clothing online. After Watson received a cease-and-desist letter from Uzzo objecting to use of the similar slogan ½ WAY TO FIRST, Watson (Opposer) challenged Uzzo's trademark application.

Opposer asserted that FIRST YEAR DOWN failed to function as a trademark because it is nothing more than a cute slogan, pairing the football term “first down” with “first year.” Opposer also claimed this slogan is merely a commonplace phrase and produced evidence that many online sellers use the phrase on baby clothing intended to celebrate first birthdays, and not as a source indicator.

The Applicant countered that it was the first to sell blank football shirts with hangtags displaying the tagline FIRST YEAR DOWN, although perhaps others had used this phrase in “one-off” sales here and there. Applicant also used “First Year Down by Little Sweeties” on printed stickers affixed to packaging, as well as on interior neck labels sewn into the baby clothing.



Packaging Sticker



Sewn Label

In such cases, the TTAB analyzes the way a phrase is used in the marketplace and how consumers perceive it. Testimony established that both parties, and two other online sellers, had used the phrase FIRST YEAR DOWN in prominent but ornamental displays, on the front of baby clothing. However, apart from general statements, and absent from the testimony, were any statements, data establishing sales volumes, number of user views and quantity of customers or the like. Moreover, the limited sampling of customer reviews about Applicant’s website did not show how customers perceived this phrase.

In addition, the third-party use evidence consisted of 11 screen shots of other online sellers’ products available on the Etsy and Amazon e-commerce platforms, displaying this phrase. However, the sole Amazon seller evidence contained only two consumer ratings for a single item. It was not clear whether Amazon chose to use this phrase itself, or whether it was printed by the request of the third-party seller. One Etsy seller page showed 302 reviews, and other Etsy shops had overall total reviews in the thousands, but there was no way to determine how many consumers had been exposed to these products.

Applicant conceded that the phrase FIRST YEAR DOWN had been used ornamentally by others, but argued that this did not prevent the words from functioning as a trademark. The TTAB agreed. It held that Opposer’s evidence was insufficient to establish that the phrase was of such a nature, or its use so widespread, that consumers would not view it as a source indicator for Applicant’s goods. Further, the TTAB observed that the words were not informational about baby clothing, but rather merely hinted at a possible use for them.

Finally, the TTAB pointed out that Opposer had presented no dictionary definitions, news articles or social commentary to show that the phrase had found its way into popular culture. In this case, the relatively small number of uses, with an unknown magnitude of sales, was insufficient to meet Opposer's burden.

Accordingly, the TTAB dismissed this opposition.

<https://ttabvue.uspto.gov/ttabvue/ttabvue-91277679-OPP-27.pdf>

Author's Note:

This TTAB opinion suggests some items of evidence that might have been sufficient to establish that a phrase is informational or in common use such that it should not be registered due to consumer perception that it fails to function as a trademark:

- The phrase is used ornamentally and not in the traditional manner of a trademark by the applicant or by third parties.
- The sales volume and number of purchasers of goods displaying the phrase sold by the applicant and by third parties.
- The number of user views of websites displaying the phrase.
- The number of reviews by customers regarding websites displaying the phrase.
- Dictionary definitions, news articles, or social commentary using the phrase.
- The descriptive nature of the phrase as applied to the goods.

In other words, to prevent a phrase from being registered on the ground that it fails to function as a trademark, a showing must be more robust than just that the phrase is in some use by competitors or the public.

For further information, please contact [William M. Borchard](#) or your CLL attorney.

[William M. Borchard](#)



Senior Counsel

[Email](#) | 212.790.9290

Bill has handled domestic and international trademark and copyright matters at the highest level for over 60 years. He has counseled and represented clients on domestic and international trademark matters concerning clearance, registration, proper use, licensing, contested administrative proceedings and infringement claims. He became Senior Counsel in January 2024 and is now focusing on providing guidance and advice to other lawyers within our firm and writing informative and engaging articles on intellectual property law developments.