

Blog Post

# Proud to Be an American, God Bless The USA, But Not Functioning as A Trademark

December 7, 2020

In a precedential decision, the United States Patent and Trademark Office, Trademark Trial and Appeal Board (the “Board”) affirmed the refusal to register the trademark GOD BLESS THE USA for home decor items on the ground that it failed to function as a trademark.<sup>[1]</sup> Additionally, the Board affirmed the Trademark Examining Attorney’s refusal to accept the Applicant’s request to amend its trademark to THE LEE GREENWOOD COLLECTION GOD BLESS THE USA on the ground that it was a material alteration of the originally applied-for mark.

## Facts

Applicant Lee Greenwood is a country music artist, famous for his hit song “God Bless the USA.” On September 12, 2016, Greenwood filed an application to register the song title as a trademark on home decor, and submitted a hangtag label to demonstrate that he is using the phrase as a trademark for the goods:



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Although the trademark was used properly on labels (and not merely placed ornamentally on the home decor items themselves), the Examining Attorney assigned refused registration of the mark on the ground that it conveyed an informational social, political, religious, or similar kind of message. “As such, it does not function as a trademark to indicate the source of applicant’s goods and to identify and distinguish them from others.” (First Office Action).

The applicant submitted arguments and evidence to traverse the refusal but met with no success. Eventually, the applicant requested an amendment of the “drawing” of its trademark to read: THE LEE GREENWOOD COLLECTION GOD BLESS THE USA. The Examining Attorney did not permit the amendment because it was deemed to be a material alteration of GOD BLESS THE USA. The applicant appealed the refusal.

### Failure to Function

To function as a trademark, a proposed mark must “identify and distinguish his or her goods,... from those manufactured or sold by others and... indicate the source of the goods, even if that source is unknown.” Citing *In re Texas With Love, LLC* (blogged [here](#)). The critical inquiry is how the mark would be perceived by the relevant consuming public. Where the evidence suggests that the ordinary consumer would perceive the words at their ordinary meaning rather than see them as a trademark, they fail to function as a mark. The Board noted that consumers ordinarily take widely used, commonplace messages at their ordinary meaning, and not as source indicators, absent evidence to the contrary.

To determine how consumers are likely to perceive the phrase sought to be registered, the Board looked not only to the applicant’s specimens of record, but to evidence obtained from over three dozen third-party websites. Those websites showed that a variety of sources prominently displayed the phrase GOD

BLESS THE USA ornamentally on a range of household items such as mugs, pillows, ornaments, and the like. The Board believed that this common use by third parties rendered it less likely that the public would perceive the phrase as identifying a single commercial source.

The Board looked to the seminal case *D.C. One Wholesaler v. Chien*, 120 USPQ2d 1710, 1713 (TTAB 2016), where the phrase “I ♥ DC” was commonly available on a range of goods, from apparel and aprons to commuter cups and keychains. There, the Board found that the “widespread ornamental use of the phrase by third parties ‘is part of the environment in which the [proposed mark] is perceived by the public and... may influence how the [proposed mark] is perceived.’” The Board concluded that in this case, “as there, the record indicates that the phrase GOD BLESS THE USA is displayed, not as a source indicator, but as an expression of patriotism, affection, or affiliation with the United States of America.”

The applicant insisted that “God Bless the USA” would be commonly recognized as his signature song: “In view of Mr. Greenwood’s ‘talent and fame’ and ‘the notoriety of his iconic song ‘God Bless the USA’ and his close association therewith...,” the applicant maintained that the public will regard the proposed mark as his trademark.

The Board was unpersuaded. “It is well settled that not every designation that is placed or used on a product necessarily functions as a trademark for said product and not every designation adopted with the intention that it perform a trademark function necessarily accomplishes that purpose.” In this case, the relevant consumers are members of the general public, who may or may not be music aficionados familiar with the applicant’s work.

Thus, the Board found that the applicant’s proposed mark GOD BLESS THE USA was “devoid of source-

identifying significance and therefore fails to function as a trademark.”

## Material Alteration

In general, a trademark applicant is not permitted to amend its applied-for mark to add or delete material. Amendment will be permitted, however, if the proposed change is not “material.” In this case, the applicant sought to add the phrase THE LEE GREENWOOD COLLECTION to the applied-for mark, arguing that it was not a material alteration because he had already registered THE LEE GREENWOOD COLLECTION separately.

The Trademark Manual of Examining Procedure states that “an amendment adding an element that the applicant has previously registered for the same goods or services may be permitted.” TMEP § 807.14(b). The Examining Attorney countered that “[a]dding previously registered matter to a mark is not an absolute right.”

The Board reviewed various precedents regarding this “mutilation” issue and concluded that, under current law, “the key comparison is between the proposed amendment and the drawing of the mark in the original application.” The crucial question is whether the old and new forms of the mark create “essentially the same commercial impression.”

In this case, the Board noted that the additional four words would appear prominently as the first part of the applicant’s proposed mark, the part that “is most likely to be impressed upon the mind of a purchaser and remembered.” Moreover, the additional seven syllables would create a noticeably different pronunciation. Finally, adding the applicant’s house mark would make a substantial difference in connotation and commercial impression.

Therefore, the Board found that the proposed amendment to the original applied-for mark would

constitute a material alteration of the original mark, impermissible under Trademark Rule 2.72(a)(2).

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“Failure to function” refusals generally arise when the proposed marks are used ornamentally, for example on the fronts of t-shirts or as banners on web pages. In this case, applicant felt that his use of GOD BLESS THE USA on hangtags would appear to consumers to be a trademark, and not just an informational phrase. That the Board disagreed even in light of how the proposed trademark was placed on the specimens of use shows that the USPTO does not wish to grant monopoly rights to any one trademark owner on what it believes to be widely used informational phrases.

The “material alteration” part of the decision is less surprising. In general, once a trademark is applied for, the USPTO will not approve any changes or amendments more significant than adding a dash (-) or deleting an apostrophe. Any change that would require the Examining Attorney to conduct another search or republish the mark is not permitted. This part of the Board’s decision is consistent with the common USPTO practice.

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[1] The Board also refused to register PROUD TO BE AN AMERICAN, in a separate non-precedential opinion.

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