

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: You Are Beautiful, Inc. Trademark Law Office 119

Serial No.: 88/ 231,914

Filed: December 17, 2018

Mark: YOU ARE BEAUTIFUL

 Lesley Wallerstein

Examiner: Henry S Zak

RESPONSE TO OFFICE ACTION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Applicant, through counsel, responds as follows to the Office action of March 15, 2019

Clarification of Description – Applicant not claiming Class 41

As a preliminary matter, the examining attorney requests clarification of goods and services in Class 41. However, applicant is not claiming Class 41 goods and services. This application is directed only to goods in Class 25. Therefore, applicant requests the examining attorney to withdraw this requirement as not applicable.

No Likelihood of Confusion – Page 2

Not Informational Matter – Page 7

1. The YOU ARE BEAUTIFUL stylized logo mark is FAMOUS WORLDWIDE – eliminating any likelihood of confusion with registrant’s standard mark.

There is actually “no litmus test” for determining likelihood confusion. Rather, it is determined on a case by case basis, In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361; 177 USPQ 563, 567 (C.C.P.A. 1973). Not all of the factors are relevant and only those relevant factors for which there is evidence in the record must be considered. Id. at 1361-62, 177 USPQ at 567-6. Fame ... is a factor to be considered in determining likelihood of confusion. 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973).

Applicant’s logo and stylized mark is famous, unlike the registrant’s mark (Reg. 3,202,169). By way of background, Applicant has two separate businesses arising from the creation of this simple silver sticker.



One business is the sale of the sticker, stationery, apparel and other merchandise bearing the image of this sticker. The other business is providing public art installations, creating murals and sculptures in the image of the sticker, the words YOU ARE BEAUTIFUL in other fonts and other equally inspirational messages.

This sticker and its message took off, literally and figuratively. The stickers are photographed all around the globe. Applicant documented the growth and global impact of his sticker in his 2013 book, A Decade of You Are Beautiful (cover, inside cover art and copyright page uploaded as evidence). At that time, he had printed and distributed over 1 million stickers worldwide (page 50). As of today this number has grown to over 5 million. The sticker has been translated into over 30 languages (page 52).

The book itself would be the best evidence of this mark's fame. However, the examining attorney requested we provide electronic copies of the 10 best excerpts from the book. We provide 19 photos from the book (uploaded as 5 contact sheets with 4 images apiece, plus the cover, the inside cover and copyright credits) showing just how far around the world the logo has spread and how many people have seen it.

The sticker and its message have spread to most cities on every continent of the world, including Antarctica. This includes Amsterdam, St. Petersburg, Indonesia, on the Great Wall of China, overlooking Mount Fuji, the Temples of Angkor, page 52, 108 and others). A giant version of the sticker overlooks the famous Lake Shore Drive in Chicago, seen by tens if not hundreds of thousands of drivers every day and featured on Fox News, WGN radio and the Oprah Winfrey Show (attached). More recently, my daughter's classmate at the Rhode Island School of Design summer school incorporated the sticker into one of her collages (attached).

A. Google knows who created the You Are Beautiful logo stickers and public art Installations

The image shows a Google search interface. The search bar contains the text "who created the you are beautiful stickers". Below the search bar, there are navigation links for "All", "Shopping", "Images", "Videos", "News", "More", "Settings", and "Tools". The search results show "About 159,000,000 results (0.54 seconds)". The first result is a featured snippet for "Matthew Hoffman". The snippet includes a quote from Hoffman: "I landed on that phrase just because I believe that it's true no matter what," said artist Matthew Hoffman, the founder and custodian of the **You Are Beautiful** project, which started with **stickers** in 2002 in Chicago. Nov 1, 2015. Below the quote is a link: "Meet the artist behind the many 'You Are Beautiful' signs around ..." with the URL "https://www.chicagotribune.com/.../redeye-artist-behind-you-are-beautiful-si...". Below the featured snippet are two more search results. The first is "About Us – You Are Beautiful" with the URL "https://you-are-beautiful.com/pages/about-us" and a description: "Simply put, we want to make life a little better. Three short words. One powerful message. A small tiny **sticker**, shared over 5 million times, **creating** smiles on ...". The second result is "You Are Beautiful: Share this message with your world!" with the URL "https://you-are-beautiful.com/" and a description: "The little **sticker** with a big message, since 2002. Millions of **stickers** in 100 languages shared by the community. Get your **stickers** today & keep the hopeful ...". Below this is a link: "You Are Beautiful Stickers · Public Art · Stickers & Gear · Everything". The third result is "You Are Beautiful Stickers" with the URL "https://you-are-beautiful.com/products/you-are-beautiful-stickers" and a price of "\$10.00 - In stock". The description reads: "Share positivity with these motivational **stickers**, and remind each and every single person to be confident in who **they** are. There's no one **you** need to try to be, ...".

Google

who created the you are beautiful stickers

All Shopping Images Videos News More Settings Tools

About 159,000,000 results (0.54 seconds)

Matthew Hoffman

"I landed on that phrase just because I believe that it's true no matter what," said artist Matthew Hoffman, the founder and custodian of the **You Are Beautiful** project, which started with **stickers** in 2002 in Chicago. Nov 1, 2015

[Meet the artist behind the many 'You Are Beautiful' signs around ...](https://www.chicagotribune.com/.../redeye-artist-behind-you-are-beautiful-si...)

About Featured Snippets Feedback

About Us – You Are Beautiful

<https://you-are-beautiful.com/pages/about-us>

Simply put, we want to make life a little better. Three short words. One powerful message. A small tiny **sticker**, shared over 5 million times, **creating** smiles on ...

You Are Beautiful: Share this message with your world!

<https://you-are-beautiful.com/>

The little **sticker** with a big message, since 2002. Millions of **stickers** in 100 languages shared by the community. Get your **stickers** today & keep the hopeful ...

[You Are Beautiful Stickers](#) · [Public Art](#) · [Stickers & Gear](#) · [Everything](#)

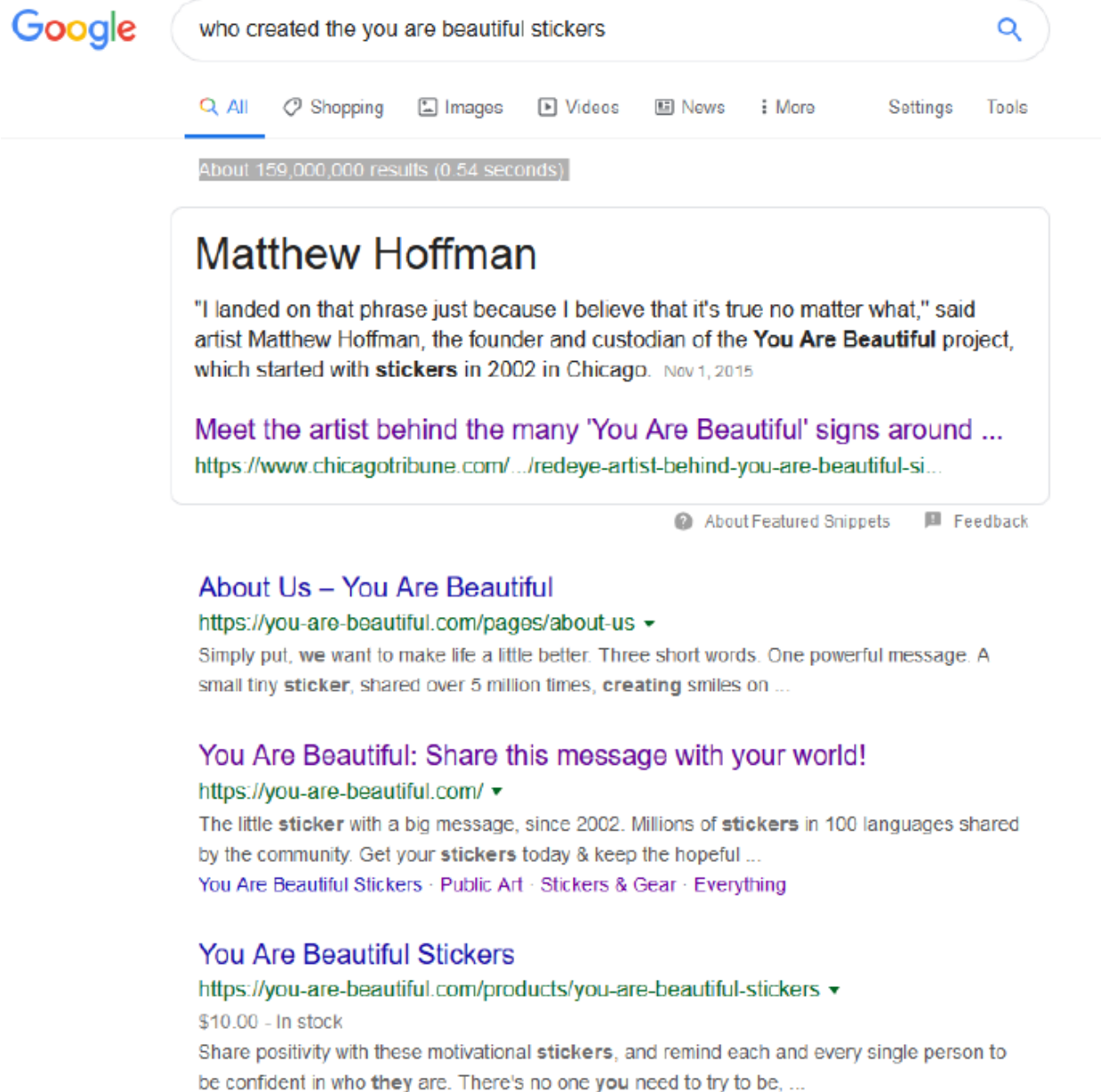
You Are Beautiful Stickers

<https://you-are-beautiful.com/products/you-are-beautiful-stickers>

\$10.00 - In stock

Share positivity with these motivational **stickers**, and remind each and every single person to be confident in who **they** are. There's no one **you** need to try to be, ...

Google also knows who created the You Are Beautiful public art installations.



The image shows a Google search interface. The search bar contains the text "who created the you are beautiful stickers". Below the search bar, there are navigation links for "All", "Shopping", "Images", "Videos", "News", "More", "Settings", and "Tools". The search results show "About 159,000,000 results (0.54 seconds)". The first result is a featured snippet for "Matthew Hoffman". The snippet text reads: "I landed on that phrase just because I believe that it's true no matter what," said artist Matthew Hoffman, the founder and custodian of the **You Are Beautiful** project, which started with **stickers** in 2002 in Chicago. Nov 1, 2015. Below the snippet is a link: "Meet the artist behind the many 'You Are Beautiful' signs around ..." with the URL "https://www.chicagotribune.com/.../redeye-artist-behind-you-are-beautiful-si...". To the right of the snippet are links for "About Featured Snippets" and "Feedback". Below the snippet are three more search results, each with a title, a URL, and a short description. The first is "About Us – You Are Beautiful" with the URL "https://you-are-beautiful.com/pages/about-us" and the description "Simply put, we want to make life a little better. Three short words. One powerful message. A small tiny **sticker**, shared over 5 million times, **creating** smiles on ...". The second is "You Are Beautiful: Share this message with your world!" with the URL "https://you-are-beautiful.com/" and the description "The little **sticker** with a big message, since 2002. Millions of **stickers** in 100 languages shared by the community. Get your **stickers** today & keep the hopeful ...". The third is "You Are Beautiful Stickers" with the URL "https://you-are-beautiful.com/products/you-are-beautiful-stickers", a price of "\$10.00 - In stock", and the description "Share positivity with these motivational **stickers**, and remind each and every single person to be confident in who **they** are. There's no one **you** need to try to be, ...".

Google

who created the you are beautiful stickers

All Shopping Images Videos News More Settings Tools

About 159,000,000 results (0.54 seconds)

Matthew Hoffman

"I landed on that phrase just because I believe that it's true no matter what," said artist Matthew Hoffman, the founder and custodian of the **You Are Beautiful** project, which started with **stickers** in 2002 in Chicago. Nov 1, 2015

[Meet the artist behind the many 'You Are Beautiful' signs around ...](#)
<https://www.chicagotribune.com/.../redeye-artist-behind-you-are-beautiful-si...>

About Featured Snippets Feedback

About Us – You Are Beautiful

<https://you-are-beautiful.com/pages/about-us>

Simply put, we want to make life a little better. Three short words. One powerful message. A small tiny **sticker**, shared over 5 million times, **creating** smiles on ...

You Are Beautiful: Share this message with your world!

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The little **sticker** with a big message, since 2002. Millions of **stickers** in 100 languages shared by the community. Get your **stickers** today & keep the hopeful ...

[You Are Beautiful Stickers](#) · [Public Art](#) · [Stickers & Gear](#) · [Everything](#)

You Are Beautiful Stickers

<https://you-are-beautiful.com/products/you-are-beautiful-stickers>

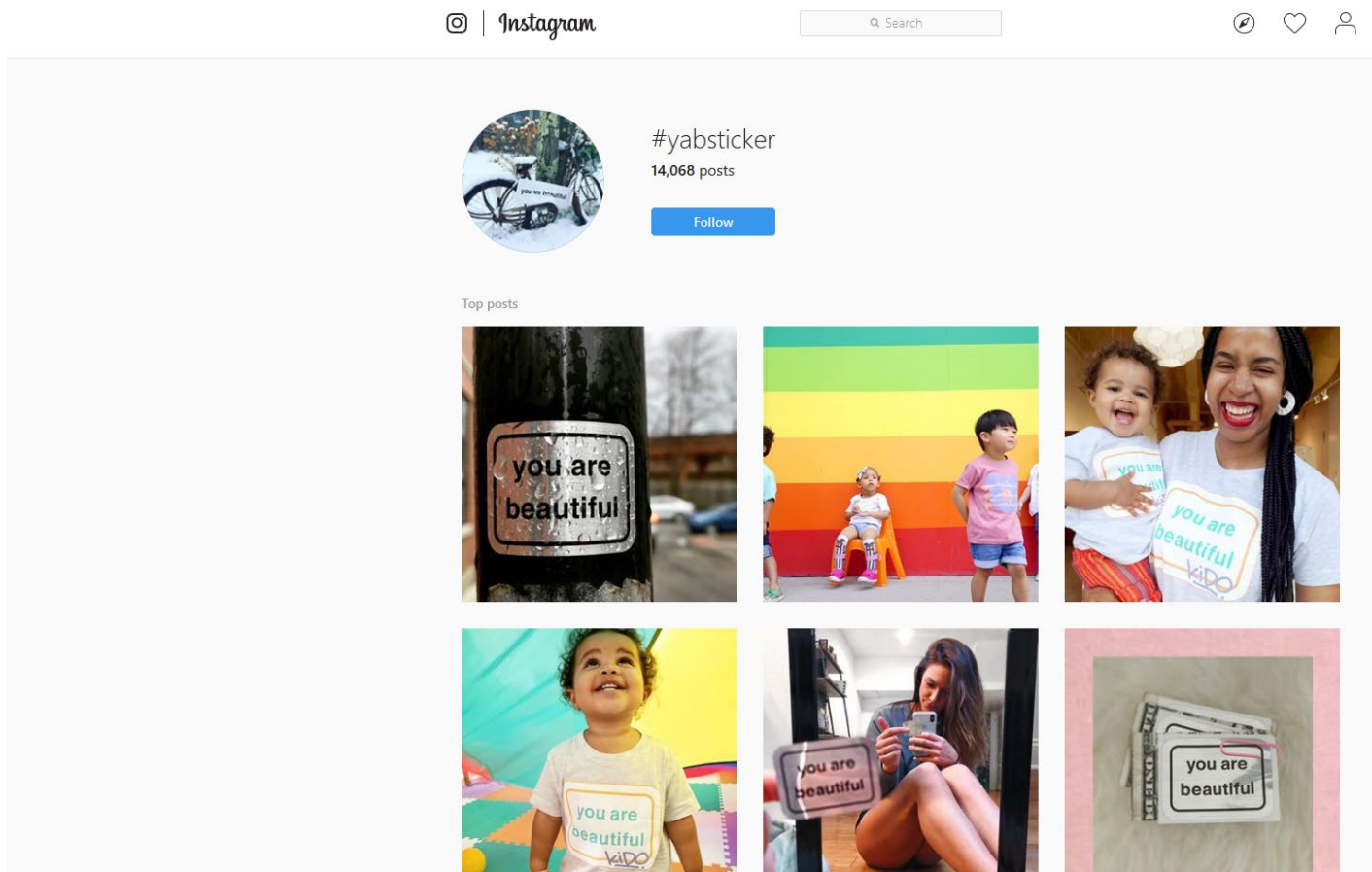
\$10.00 - In stock

Share positivity with these motivational **stickers**, and remind each and every single person to be confident in who **they** are. There's no one **you** need to try to be, ...

B. 27 individuals and businesses nationwide reached out to applicant’s branded website commission request form, specifically because they recognized his prior work

These letters are printed out and enclosed as evidence. Prospective customers see applicant’s work on display, and immediately recognize him. They visit his website named you-are-beautiful.com, which displays a large YOU ARE BEAUTIFUL sticker front and center. They click on About, then choose You Are Beautiful Installations.

C. Instagram users around the globe have created the hashtag #yabsticker to identify applicant’s stickers and installation art and tag it daily wherever it appears—over 14,000 times



It is plain to see from applicant's book, Google, and social media just how famous the YOU ARE BEAUTIFUL logo is, especially compared to registrant's mark. This fame far outweighs any resemblance to registrant's mark. Apparel with this logo can only refer to applicant's famous sticker and art installations. There can be absolutely no likelihood of confusion. Please withdraw your refusal on these grounds.

2. YOU ARE BEAUTIFUL is recognized WORLDWIDE as the source of Applicant's Public Art Installation Services. It Functions as a Trademark and should be allowed to register

The Examining Attorney refused registration for apparently being an informational slogan or term that fails to function as a trademark. Applicant respectfully disagrees.

The critical question is whether the applicant's relevant purchasing public recognizes the slogan as a source indicator (In re Eagle Crest, 96 USPQ2d at 1229, TTAB 2010). Slogans, even widely used sayings, can function as trademarks (In re Random Acts of Kindness Foundation, TTAB 87245967, February 15, 2019...reversing the refusal to register the mark RANDOM ACTS OF KINDNESS on informational grounds, especially in view of 21 other registered trademarks for RANDOM ACTS OF KINDNESS/Foundation). Applicant's art installation customers for over fifteen (15) years have perceived YOU ARE BEAUTIFUL as a source indicator for his public art installation services.

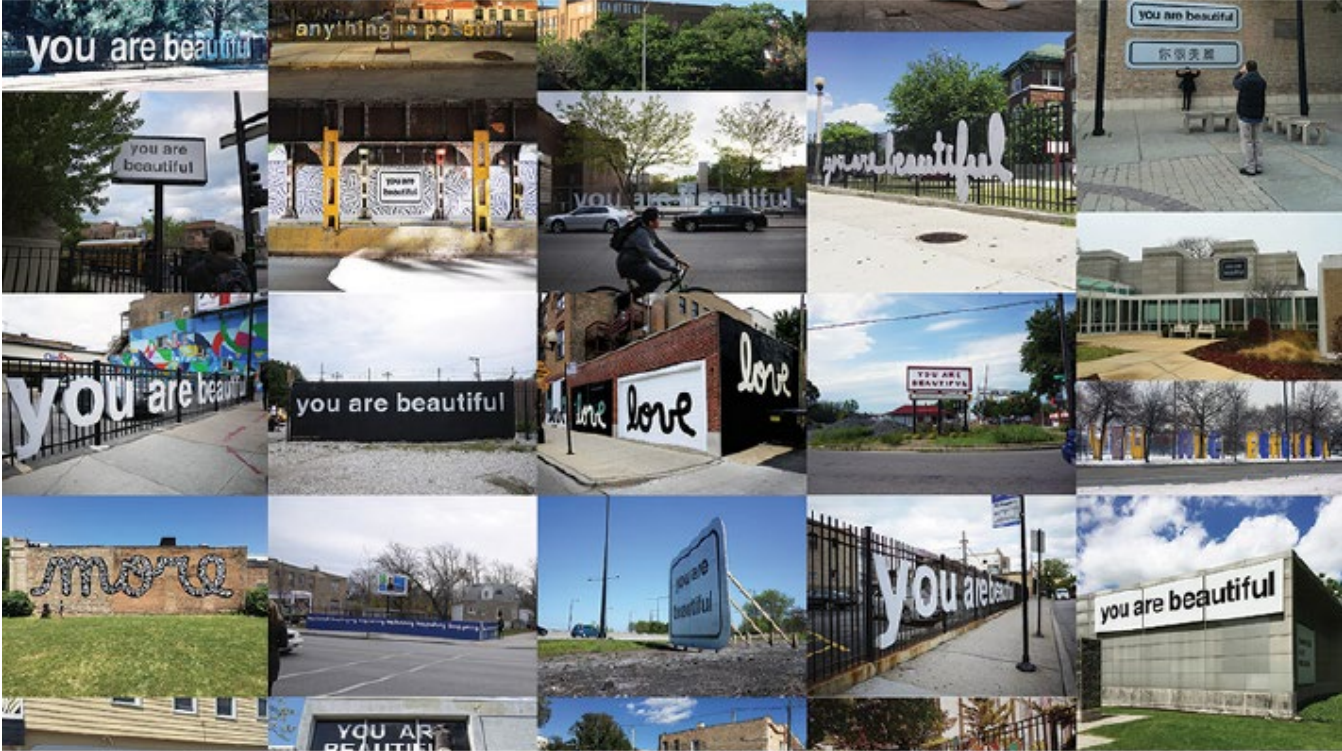
By way of background, Applicant has two separate businesses arising from the creation of this simple silver sticker.



One business is the sale of the sticker, stationery, apparel and other merchandise bearing the image of this sticker. The other business is providing public art installations, creating murals and sculptures in the image of the sticker, the words YOU ARE BEAUTIFUL in other fonts and other equally inspirational messages.

This sticker and its message took off, literally and figuratively. Since 2005, applicant has sold over 5 million of these stickers worldwide. The stickers are photographed all around the

globe. The tiny sticker spread so quickly, resonated so strongly and universally, that the applicant began to offer the same message on larger media such as murals and as sculptures. Here is a small sample of some of the public art he has created. Many have the phrase “you are beautiful,” in the same distinctive font and color of the stickers. Others use a different font. Yet others offer different inspirational messages (“love” “more,” “anything is possible”).

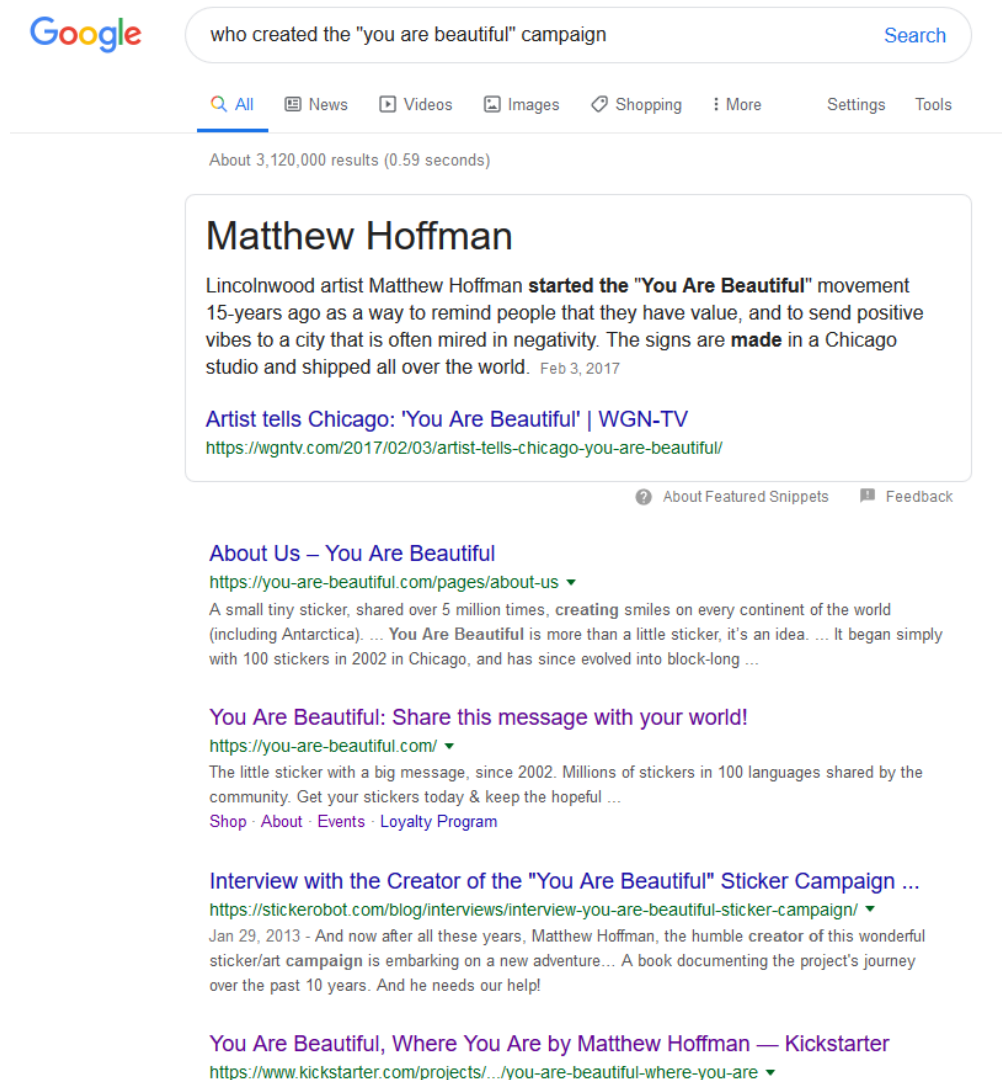


The artwork has been installed in high-traffic public spaces throughout the world. Applicant uses the same few fonts and colors in most all of his work, making it very recognizable, distinctive and identifiable as his own. He is recognized worldwide as the creator of these installations.

A. Google knows who created the You Are Beautiful public art campaign

For an artist with as global a reach and recognizable style as You Are Beautiful, the artwork itself becomes the trademark for future art production services. Public art by its very nature is on display for people to see. Customers see the artwork, recognize it, then want one of their own. This is how artwork services move in commerce. The slogan YOU ARE BEAUTIFUL has become applicant's trademark for his art.

If you ask Google "Who created the You Are Beautiful campaign?" it correctly answers "Matthew Hoffman," the owner of You Are Beautiful, Inc.



The image shows a Google search interface. The search bar contains the text "who created the 'you are beautiful' campaign" and the search button is labeled "Search". Below the search bar, there are navigation links for "All", "News", "Videos", "Images", "Shopping", "More", "Settings", and "Tools". The search results show "About 3,120,000 results (0.59 seconds)". The first result is a featured snippet for "Matthew Hoffman", a Lincolnwood artist who started the "You Are Beautiful" movement 15 years ago. Below this, there are three more search results, each with a title, a URL, and a brief description.

Google

who created the "you are beautiful" campaign Search

All News Videos Images Shopping More Settings Tools

About 3,120,000 results (0.59 seconds)

Matthew Hoffman

Lincolnwood artist Matthew Hoffman **started the "You Are Beautiful" movement** 15-years ago as a way to remind people that they have value, and to send positive vibes to a city that is often mired in negativity. The signs are **made** in a Chicago studio and shipped all over the world. Feb 3, 2017

[Artist tells Chicago: 'You Are Beautiful' | WGN-TV](https://wgntv.com/2017/02/03/artist-tells-chicago-you-are-beautiful/)
<https://wgntv.com/2017/02/03/artist-tells-chicago-you-are-beautiful/>

About Featured Snippets Feedback

[About Us – You Are Beautiful](https://you-are-beautiful.com/pages/about-us)
<https://you-are-beautiful.com/pages/about-us>

A small tiny sticker, shared over 5 million times, creating smiles on every continent of the world (including Antarctica). ... You Are Beautiful is more than a little sticker, it's an idea. ... It began simply with 100 stickers in 2002 in Chicago, and has since evolved into block-long ...

[You Are Beautiful: Share this message with your world!](https://you-are-beautiful.com/)
<https://you-are-beautiful.com/>

The little sticker with a big message, since 2002. Millions of stickers in 100 languages shared by the community. Get your stickers today & keep the hopeful ...
[Shop](#) · [About](#) · [Events](#) · [Loyalty Program](#)

[Interview with the Creator of the "You Are Beautiful" Sticker Campaign ...](https://stickerobot.com/blog/interviews/interview-you-are-beautiful-sticker-campaign/)
<https://stickerobot.com/blog/interviews/interview-you-are-beautiful-sticker-campaign/>

Jan 29, 2013 - And now after all these years, Matthew Hoffman, the humble creator of this wonderful sticker/art campaign is embarking on a new adventure... A book documenting the project's journey over the past 10 years. And he needs our help!

[You Are Beautiful, Where You Are by Matthew Hoffman — Kickstarter](https://www.kickstarter.com/projects/.../you-are-beautiful-where-you-are)
<https://www.kickstarter.com/projects/.../you-are-beautiful-where-you-are>

B. 27 individuals and businesses nationwide reached out to applicant's branded website commission request form, specifically because they recognized his prior work

Screenshots of these are uploaded to the case file. Prospective customers see applicant's work on display, and immediately recognize him. They visit his website named you-are-beautiful.com, which displays a large YOU ARE BEAUTIFUL sticker front and center. They click on About, then choose You Are Beautiful Installations.

Applicant has placed his signature sticker front top and center on all his pages, so there is no question whose artwork you are ordering. The page provides different examples of work he has created, and then a clear link to contact him (the green contact links, highlighted by the red arrows).

As such, he is using the slogan as a trademark. See, for example, In re Michelin North America, Inc., TTAB 85077031, September 11, 2015, reversing the refusal to register 1-800-TIRE-911 on informational grounds, because the vanity phone number was prominently displayed, visually separated from the advertising copy and used a large font; In re Mentor Graphics Corporation, TTAB 78325604, March 6, 2008, reversing the refusal to register VIRTUALWIRE on informational grounds where the mark was in all capital letters, used to modify descriptive terminology 'VIRTUALWIRE technology' and followed by a TM; In re the Hallicrafters, 153 USPQ 376 (TTAB 1967), reversing the refusal to register QUALITY THROUGH CRAFTSMANSHIP because of how heavily it was advertised.

SEARCH



ITEMS

Shop

About

Loyalty Program

Events

Contact

Account

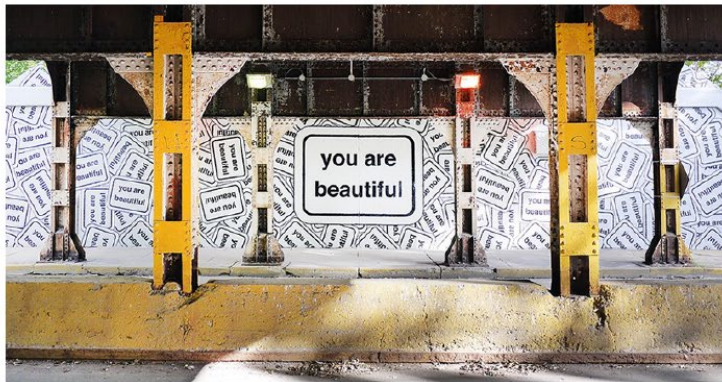
You Are Beautiful
Installations

Public Reaction

Map

HOME / PUBLIC ART

Public Art



Public Art - You Are Beautiful

Morse Ave Metra Underpass, Miles of Murals Program in Rogers Park for 49th Ward, Chicago, IL, 12' x 150', 2013 - Present

We make grand gestures in public places.

While we've distributed over 3 million small stickers, we also strive to beautify communities with massive and inspiring installations.


We've collaborated with major cities & organizations around the globe, on both temporary & permanent installations, with long term planning and fast track projects. We are a nimble organization, and are quickly adaptable to the needs of a specific project.

When the phrase You Are Beautiful is integrated into a city or community, it creates an immediate positive dialogue. Often, due to the upbeat & universal message, our installations quickly generate human interest stories online, in print, and on TV.

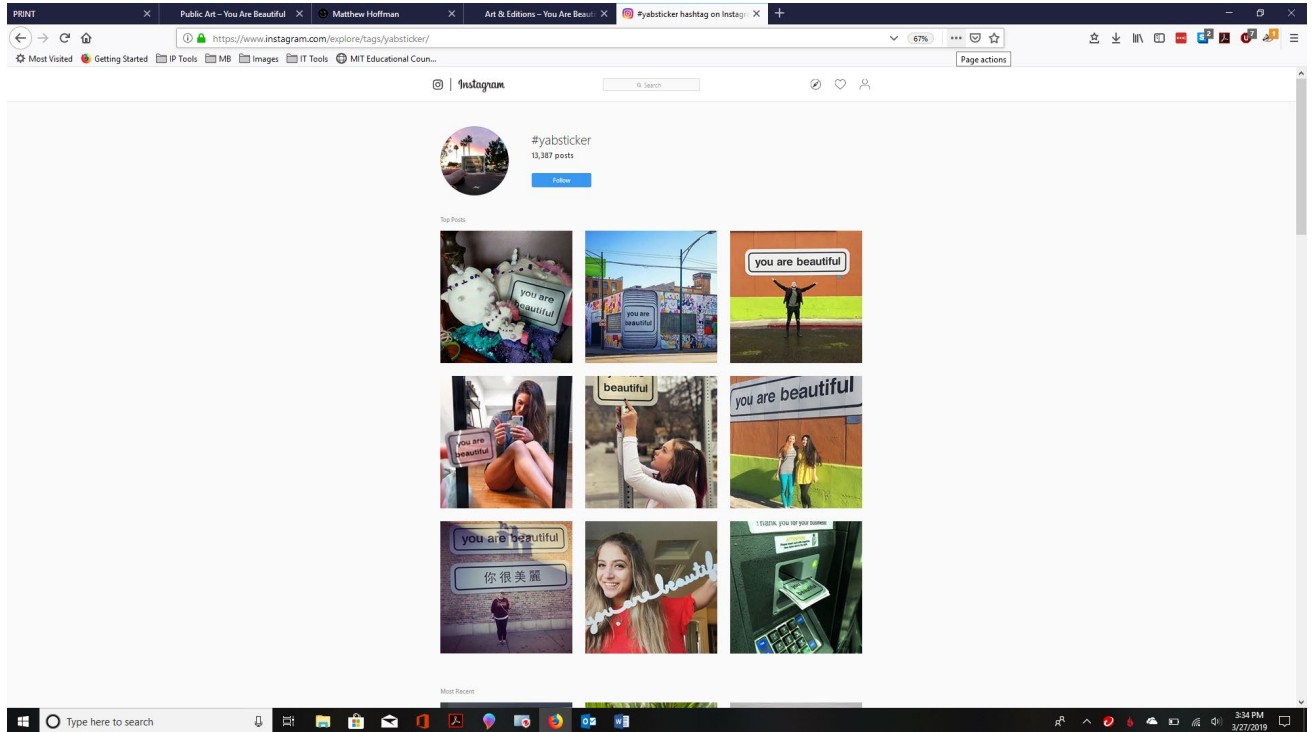
It is our mission to leave the world a little better than when we found it.

Scroll down to see a curated selection of past work. [Click here](#) to view a more comprehensive case study of the impact of a single installation.

Interested in bringing a You Are Beautiful installation to your city? [Contact us here](#), or email us directly at hi@you-are-beautiful.com.



C. Instagram users around the globe have created the hashtag #yabsticker to identify applicant’s stickers and installation art and tag it daily wherever it appears—over14,000 times



D. There are 7 other registrations for YOU ARE BEAUTIFUL, none of which were ever challenged on failure to function grounds:

TSDR shows at least 7 live registrations for the slogan YOU ARE BEAUTIFUL (or translated equivalent). None of these were challenged on failure to function grounds. Formal copies, as well as their file wrappers are uploaded with the other evidence. These are:

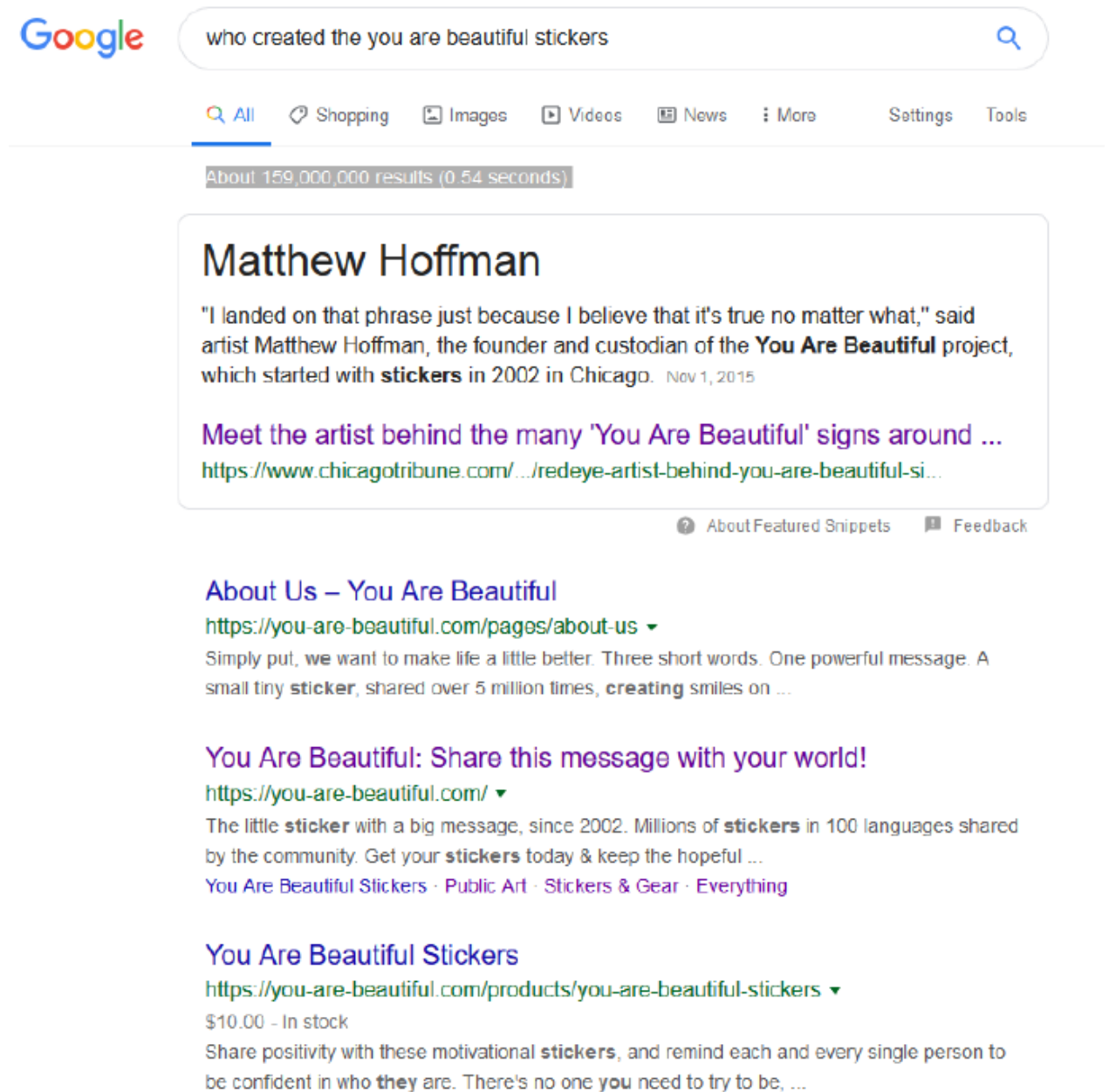
- i. Reg. 3202169 – YOU ARE BEAUTIFUL (apparel)
- ii. Reg. 3938931 – SEI BELLA (cosmetics)
- iii. Reg. 4054113 – SEI BELLA (haircare)
- iv. Reg. 4377610 – SEI BELLA (perfume)
- v. Reg. 4655234- YOU ARE BEAUTIFUL, YOU ARE YOU (haircare)
- vi. Reg. 5149115 – YOU ARE BELLISSIMA (shampoo and apparel)
- vii. Reg. 4974759 – YOU ARE BEAUTIFUL (skin care)

3. YOU ARE BEAUTIFUL is recognized WORLDWIDE as the source of Applicant's Stickers and Stationery Goods. It Functions as a Trademark and should be allowed to register.

The Examining Attorney refused registration on the grounds that the applied for mark is an informational slogan or term, and also ornamental with respect to this category of goods, and apparently fails to function as a trademark. Applicant respectfully disagrees.

A. Google knows who created the You Are Beautiful stickers

As with applicant’s public art, if you ask Google “Who created the You Are Beautiful stickers?” it correctly answers “Matthew Hoffman,” the owner of You Are Beautiful, Inc.



- B. Applicant has sold over 5 million silver YOU ARE BEAUTIFUL stickers worldwide since 2002.**

Applicant tells the story best in his store, in his own words:

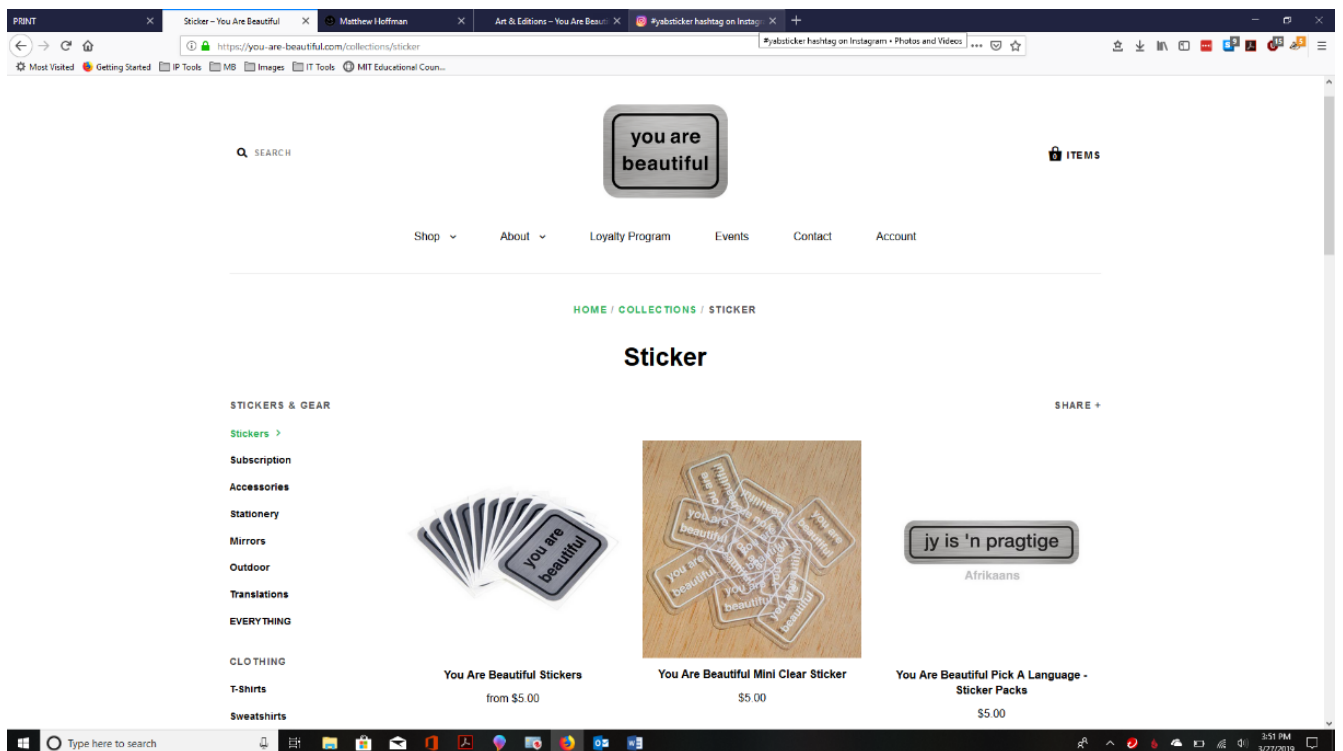


C. Applicant’s branding carries through his website, packaging materials and brick and mortar store

You can buy applicant’s globally recognized stickers at applicant’s website or at his brick and mortar store in Chicago. Both are branded and decorated throughout with the slogan YOU ARE BEAUTIFUL.

1. Applicant’s website shows his mark in addition to the stationery products on his page

Applicant’s website places his signature slogan front and center on his home page, so that you know exactly whose stickers and merchandise you are buying. This is in addition to showing the stationery products themselves on the page itself. In this way, the slogan on the front center functions as a trademark, and not just a display of the goods.



2. Applicant's gift wrap and packaging

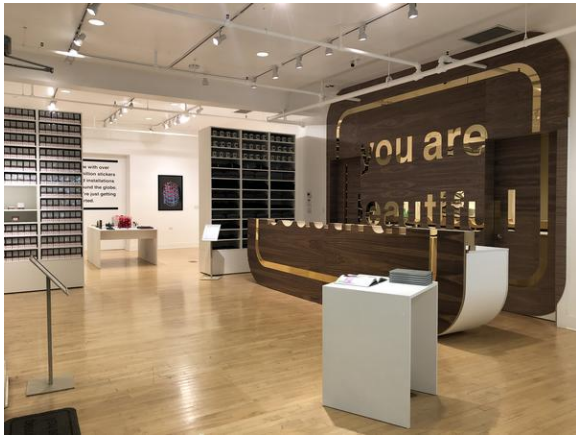
Applicant wraps his online orders, whether stickers, apparel or stationery products, in wrapping paper that repeats his signature silver sticker. Custom packing tape further reinforces the brand:



Page-a-day calendar

3. Applicant's Brick and Mortar Store:

Applicant carries the sticker branding throughout his flagship Chicago storefront. The slogan is painted on the outside wall of his store, is his welcome mat, the cashier station, as well as product packaging. All are painted and decorated in the manner of applicant's signature silver sticker. His page a day calendars are shown on the left shelving unit. Stickers hang on a separate wall their own within this store.



Page a day calendars



The stickers!

It is plain to see all of the packaging and branding that applicant puts into selling his products. These are not just any stickers having the words YOU ARE BEAUTIFUL—these are applicant’s unique and globally recognized stickers. He has gone to great lengths to reinforce his specific sticker and related merchandise in the mind of his customers. The slogan is front and center throughout his website, covers the entrance of his brick and mortar store, his cashier station, welcome mat, inner and outer packaging materials. 13,000+ independent Instagram tags prove he’s got something uniquely his.

Not only is there no likelihood of confusion with Reg. , applicant’s logo functions as his trademark for his public art services and stationery goods. Given how famous and widespread this mark is, the relevant purchasing public would only associate any apparel having this logo with applicant.

Accordingly, please withdraw your refusals and permit this application to register.

Thank you,

Lesley A. Wallerstein, Attorney of record and Illinois Bar Member