

Exhibit “A”

McCarthy on Trademarks

Copy of 2 McCarthy on Trademarks and Unfair Competition § 11:87
(5th ed. – September 2019 update)

Document: Response to Office Action
Trademark: **FUCK**
Serial Number: 88/308,434
Classification: 14
Deadline: May 8, 2020
Owner: Erik Brunetti

Document By **WESTLAW**

2 McCarthy on Trademarks and Unfair Competition § 11:87 (5th ed.)

McCarthy on Trademarks and Unfair Competition, Fifth Edition September 2019 Update
J. Thomas McCarthy

Chapter 11. The Spectrum of Distinctiveness of Marks

VI. STRENGTH OF MARKS

C. STRENGTH AND THIRD PARTY USE

§ 11:87. “Common word” fallacy

References

West’s Key Number Digest

- West’s Key Number Digest, Trademarks  1033

Some courts occasionally make loose reference to the fact that plaintiff’s mark is a “common word” found in the dictionary and is therefore “weak.”¹ But this is a nonsequitur. That a word is in “common usage” is quite irrelevant.² The issue is whether that word is in common usage as a mark for similar goods or services such that its distinctiveness in the customer’s mind is blurred. Some of the strongest marks are “common words” found in the dictionary. For example, SHELL, CAMEL, and APPLE. They are intrinsically strong because they are arbitrary when applied to gasoline, cigarettes and computers, respectively.³ They are also strong under the second prong because widely known and recognized by customers as marks.

The Sixth Circuit, rejecting the fallacy that a “common word” found in the dictionary, such as “classic,” is either weak or “unworthy of protection,” observed that: “The significant factor is not whether the word itself is common, but whether the way the word is used in a particular context is unique enough to warrant trademark protection.”⁴

A similar fallacy is the argument that because a designation is a generic name for something, it cannot be a trademark for anything.⁵

Undoubtedly, common phrases and bits of slang which are in routine, everyday use are relatively weak as trademarks simply because their common occurrence makes it difficult for them to stand out as source identifiers.⁶

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Footnotes

¹ See, e.g., *Alpha Industries, Inc. v. Alpha Steel Tube & Shapes, Inc.*, 616 F.2d 440, 205 U.S.P.Q. 981 (9th Cir. 1980) (ALPHA said to be “weak” as a “common word;” apparently meaning that it is in widespread use as a mark);

Consumers Petroleum Co. v. Consumers Co. of Illinois, 169 F.2d 153, 78 U.S.P.Q. 227 (7th Cir. 1948), cert. denied, 335 U.S. 902, 93 L. Ed. 437, 69 S. Ct. 406, 80 U.S.P.Q. 600 (1949) (CONSUMERS for home fuel oil apparently regarded as descriptive of class of users); *see also* dissent, 169 F.2d at 165; *Daddy’s Junky Music Stores, Inc. v. Big Daddy’s Family Music Ctr.*, 109 F.3d 275, 42 U.S.P.Q.2d 1173 (6th Cir. 1997) (“It is true that the more common a word or phrase is, the less inherently trademark strength it may have, even when the mark has an arbitrary relation to the good or service to which it applies.”).

2 *Foxfire Fund, Inc. v. Burke*, 203 U.S.P.Q. 416 (N.D. Ga. 1978) (that word “foxfire” is a common word in the English language does not make it a weak mark as applied to log cabin homes); *Sovereign Military Hospitaller Order of Saint John of Jerusalem of Rhodes and of Malta v. Florida Priory of the Knights Hospitallers of the Sovereign Order of Saint John of Jerusalem, Knights of Malta, The Ecumenical Order*, 809 F.3d 1171, 1186, 116 U.S.P.Q.2d 1478 (11th Cir. 2015) (District court erred in thinking that “commonly used” words were “generic” or weak as a trademark. “[T]he strength of a mark does not turn on its component words in a vacuum, but instead ‘the relationship between the name and the service or good it describes.’”).

3 *See* §§ 11:11 to 11:14; *Fisons Horticulture v. Vigoro Indus., Inc.*, 30 F.3d 466, 31 U.S.P.Q.2d 1592, 1601 (3d Cir. 1994) (approving of this example and the view of this treatise).

4 *Wynn Oil Co. v. Thomas*, 839 F.2d 1183, n.4, 5 U.S.P.Q.2d 1944 (6th Cir. 1988).

5 *See* § 12:1.

6 *See* § 7:23.

Exhibit “B”

Printout of Etsy Mugs Results

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- Jewelry & Accessories
- Clothing & Shoes
- Home & Living
- Wedding & Party
- Toys & Entertainment
- Art & Collectibles
- Craft Supplies
- Vintage
- 🏠

Gifts

All categories > "mugs" (1,052,811 Results)

Sort by: Relevancy ▾

Ad



Fuck Off Black Stoneware Handmade Mug
 gceramicandco
 ★★★★★ (98)
\$48.00 FREE shipping

Ad



More colors
 Mugs- Set of 4, Assorted Colors 3" wide x 4" tall, 10 oz. Group B
 KALPracticalPottery
 ★★★★★ (18)
\$36.00

Ad



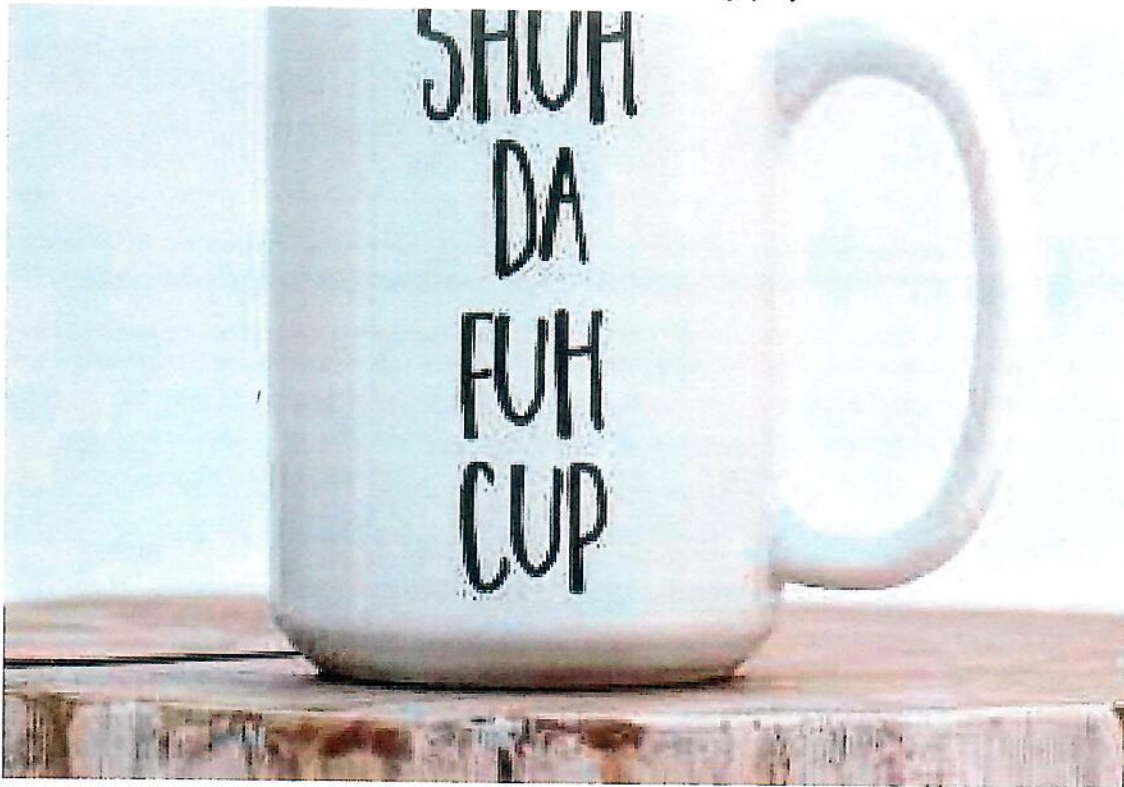
More colors
 PERSONALIZED 20 oz Yeti Rambler - LASER ENGRAVED
 ImpressMeGifts
 ★★★★★ (1,212)
\$44.99 FREE shipping
 @ Bestseller



More colors
 Enamel mug Bird wit autumn sprigs 250ml
 DzoLama
 ★★★★★ (35)
\$20.64
 @ Bestseller



More colors
 I miss Barack/Obama Coffee Mug 15oz
 JustEnchanted
 ★★★★★ (125)
\$17.95 FREE shipping

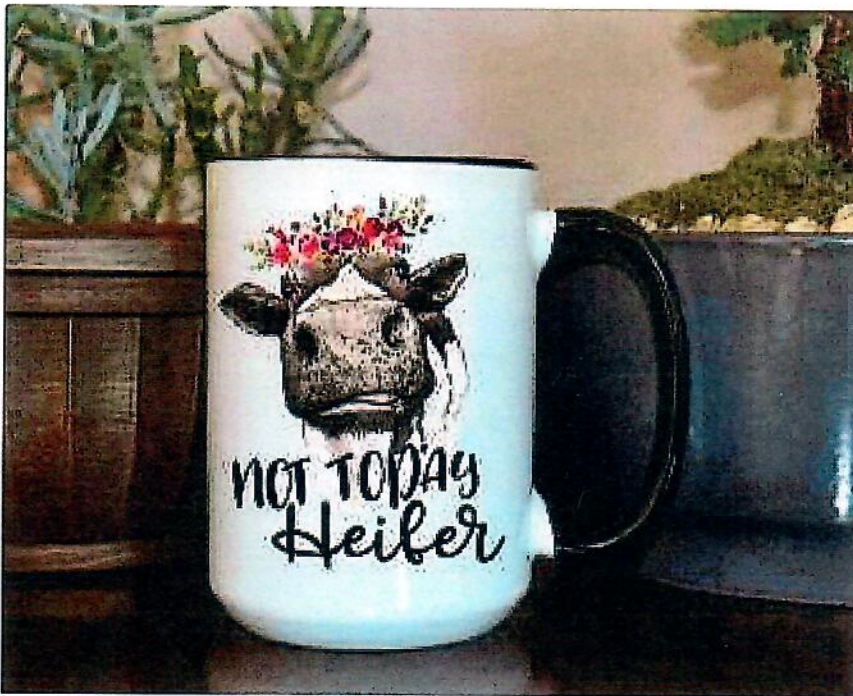


More colors

Shuh Duh Fuh Cup 15 oz coffee mug, Shuh Duh Fuh Cup Coffee Mug, Funny Coffee Mugs, Funny profane mugs, Funny Inappropriate gift idea
JitterBeanMugs

★★★★★ (555)

\$15.16 ~~\$18.95~~ (20% off)



More colors

Not today heifer mug, not today heifer cow mug, funny coffee cups for her, cow gift, funny cow coffee mug,
JitterBeanMugs

★★★★★ (555)

\$15.16 ~~\$18.95~~ (20% off)



[More colors](#)

Eat A Bag of Dicks 15 ounce Coffee Mug, Funny Coffee Mug for Her, Gift Idea for Her, Funny Gift Idea for Friend, Can be PERSONALIZED

JitterBeanMugs

★★★★★ (555)

\$15.16 ~~\$18.95~~ (20% off)