

Keeping Tabs on the TTAB®

2004 at the TTAB: 12 Citables and 3 Precedential CAFC Decisions

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In 2004, the TTAB deemed twelve of its decisions citable, out of about 600 rulings rendered. This ratio of citable to uncitable (1/50) is the lowest in recent memory, despite the clamor of the trademark bar for more citable TTAB precedent. Moreover, by recent TTAB standards, the twelve citable decisions can hardly be called monumental.

The CAFC chimed in with a mere three precedential TTAB-related decisions. That, too, was a noticeable decrease from prior years.

Just why these numbers have decreased is a mystery. Could it be that all of the difficult questions of TTAB jurisprudence have now been answered?

Set out below are brief summaries of the twelve citable TTAB decisions, and three brief essays discussing the precedential CAFC rulings

Twelve Citable TTAB Decisions

Section 2(a) — falsely suggesting a connection

In re Los Angeles Police Revolver and Athletic Club, Inc., 69 USPQ2d 1630 (TTAB 2004). The Board reversed Section 1 and 2(a) refusals to register the mark TO PROTECT AND SERVE for beverage glasses and various clothing items. The Examining Attorney contended that the mark falsely suggests a connection with the Los Angeles Police Department (LAPD) — which adopted that motto for its Police Academy and displays the motto on its patrol cars — and further that Applicant LAPRAAC is not the owner of the mark. Candidly calling this an “unusual case that perhaps raises more questions than it answers,” the TTAB concluded that the mark does indeed suggest a connection, but it could not conclude that the connection is a *false* one. In light of the history of the close relationship between LAPRAAC and the LAPD, and particularly the fact that the LAPD’s website refers inquiries about LAPD memorabilia to LAPRAAC, “the evidence suggests that there is a substantial commercial connection” between the two entities. As to the issue of ownership, the Board could not say that LAPRAAC is not the owner of the mark, noting that TMEP § 1201.01 directs the Examining Attorney to accept an applicant’s statement of ownership unless it is “clearly contradicted by the information on the record.”

In re White, S.N. 78175476 (Sept. 8, 2004). Affirming a Section 2(a) refusal to register the mark APACHE for cigarettes, the Board found that the mark falsely sug-

gests a connection with the nine federally-recognized and variously-named Apache tribes. The Board first ruled that Section 2(a) “clearly contemplates refusal of matter that would falsely suggest a connection with multiple persons, whether natural or juristic, or with multiple institutions,” and it found that each Apache tribe is “necessarily either a juristic person or an institution.” Applying its “fairly standard” analysis, the Board determined that APACHE “would be recognized as a name, or equivalent thereof, for each of the tribes;” that the mark points uniquely and unmistakably to the Apache tribes; that Applicant Julie White (a member of the St. Regis Band of Mohawk Indians of New York) has no connection with the tribes; and that the name APACHE is of sufficient fame or reputation that a connection with the tribes would be presumed by consumers of cigarettes. The evidence showed that “Native Americans not only are engaged in large-scale marketing of cigarettes, but in manufacturing of Native American brands of cigarettes.” The Board noted that it is neither necessary nor sufficient under Section 2(a) that the name in question be “famous;” the key is whether the name is unmistakably associated with, and *as used* would point uniquely to, the person or institution.

Section 2(d) — likelihood of confusion

Baseball America, Inc. v. Powerplay Sports, Ltd., 71 USPQ2d 1844 (TTAB 2004). In this Section 2(d) opposition, Opposer pitched a shutout: the Board sustained its opposition to registration of the mark BASEBALL AMERICANA (BASEBALL disclaimed) for posters and educational

services related to baseball, finding the mark confusingly similar to Opposer’s mark BASEBALL AMERICA (registered in the stylized form shown here (BASEBALL disclaimed)) for publications, posters, and educational services in the field of baseball. Applicant stood with the bat on its shoulder, failing to offer any evidence during its testimony period. The Board crisply called Applicant out on strikes, deeming Opposer’s mark to be famous, the involved goods and services to be in part identical, and the marks “more similar than dissimilar.” The only real question that remains is why the



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Board deemed this perfectly straightforward decision to be worthy of the “citable” designation.

Rule 2(e)(3) — primarily geographically deceptively misdescriptive

In re Consolidated Specialty Restaurants, Inc., 71 USPQ2d 2004 (TTAB 2004). Affirming a Section 2(e)(3) refusal to register COLORADO STEAKHOUSE & Design, the Board found the mark to be primarily geographically deceptively misdescriptive of Applicant's restaurant services. Last year's CAFC decisions in *California Innovations* and *Les Halles* set out the test for determining whether a service mark runs afoul of Section 2(e)(3):

for a restaurant, it must be shown that patrons are likely to believe that the restaurant



services have their origin in the location indicated by the mark, and this belief must be a material factor in the decision to patronize the restaurant. The Examining Attorney submitted dictionary definitions of “Colorado” and “steakhouse,” along with considerable NEXIS and Internet evidence showing that Colorado is known for its steaks. Applicant, located in Indiana and Illinois, admitted that the beef it serves does not come from Colorado, but it argued that the PTO had failed to provide direct evidence of materiality needed to satisfy the “heightened standard” applicable in Section 2(e)(3) cases. The Board, however, ruled that the PTO had established a “very strong services-place association,” and that this “heightened association” leads to an inference of materiality that Applicant failed to overcome.

Section 2(e)(4) — primarily merely a surname

In re Gregory, 70 USPQ2d 1792 (TTAB 2004). Applying its five-factor Section 2(e)(4) test, the Board affirmed a refusal to register the mark ROGAN for certain jewelry, handbag, and clothing items, finding it to be primarily merely a surname. The Examining Attorney relied, *inter alia*, on 1,087 residential listings in a computerized telephone database. Applicant argued that the number of listings for ROGAN are fewer than the 1,295 listings for HACKLER, which the TTAB found to be a rare and registrable surname in *In re United Distillers plc*, 56 USPQ2d 1220 (TTAB 2000). The Board declined to consider the HACKLER decision as setting any benchmark, and it rejected the notion that the question of whether a surname is rare is to be “determined

solely by comparing the number of listings of the name to the total number of listings in a vast computerized database.” Here, media attention given to the surname ROGAN in recent years — e.g., James Rogan is the former Director of the PTO and a former California congressman who received considerable media coverage as a manager during the impeachment trial of President Clinton — and evidence regarding others so named led the Board to conclude that ROGAN, although it “may be rare when viewed in terms of frequency of use as a surname in the general population, [is] not at all rare when viewed as a name repeated in the media and in terms of public perception.”

Section 13 — timely filing of opposition

Yahoo! Inc. v. Loufrani, 70 USPQ2d 1735 (TTAB 2004). The Board granted a motion to dismiss this opposition on the ground that it was not timely filed. Opposer wanted to oppose Applicant's *parent* application, but mistakenly identified Applicant's *child* application in the Notice of Opposition.

After the opposition deadline for the parent application had passed, Opposer sought to amend the Notice to identify the correct application, but the Board ruled that it was too late. The original notice “clearly identified the child application, not only by number but also



SMILEY

by date of publication and classes of goods and services.” Thus the Board noted that “[t]his is not a case where the serial number is wrong in the caption while the body of the notice correctly identifies the application being opposed, such that there is notice of which application is being opposed and an amendment can correct a minor discrepancy.” Section 13(a) of the *Trademark Act* sets forth the statutory requirements for timely filing an opposition; Opposer's remedy lies in the filing of a petition for cancellation when and if the registration issues.

Genericness

Zimmerman v. National Ass'n of Realtors, 70 USPQ2d 1425 (TTAB 2004). The Board dismissed petitions for cancellation of registrations for the marks REALTOR and REALTORS for real estate brokerage services. Zimmerman argued that the general public perceives these marks as “generic terms for real estate agents.” Registrant contended that the marks are collective *membership* marks and therefore the only relevant population for the genericness determination comprises members of the real

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estate profession. The Board ruled that the marks are not membership marks but collective service marks, and so both the general public and real estate professionals are relevant survey universes. Respondent's survey evidence demonstrated that the terms do indeed serve as source indicators with "the population subset of real estate agents and brokers." As to the general population, Petitioner Zimmerman failed to show by a preponderance of the evidence that the terms are perceived as generic. The Board noted, however, that even Petitioner's "flawed" survey suggests that "members of the general public seeking real estate services from an association professional" may perceive the terms as generic, "in spite of respondent's best efforts to create perceptions of these terms as source indicators among members of the general public."

***In re Candy Bouquet Int'l, Inc.*, S.N. 78058216 (Sept. 8, 2004).** The Board affirmed a genericness refusal of the term CANDY BOUQUET (CANDY disclaimed) for "retail, mail, and computer order services in the field of gift packages of candy." NEXIS and Internet evidence demonstrated that CANDY BOUQUET is used generically "in the candy industry and among candy sellers to name a floral-type gift arrangement of candies and chocolate." Furthermore, "ordinary consumers would understand the term primarily to refer to a specific type of gift package of candy." The Board observed that a term that is generic for a particular class of goods is also generic for the services of selling those goods (e.g., BONDS.COM, RUSSIANART). For the sake of completeness, the Board also considered Applicant's Section 2(f) evidence, noting that "[i]n this case the standard is extremely difficult to meet since, if CANDY BOUQUET is not generic for applicant's services, it must be considered highly descriptive of them." Applicant offered proof of use of the term for 14 years, approximately \$9.9 million in sales, and some \$7.8 million in advertising expenditures, but no direct evidence that ordinary consumers view CANDY BOUQUET as a distinctive source indicator. The Board noted that in light of the "widespread use of the term 'candy bouquet,'" this financial evidence was insufficient.

Rule 2.56(b)(1) — trademark specimen of use

***In re Dell Inc.*, 71 USPQ2d 1725 (TTAB 2004).** In this potentially significant decision, the Board reversed a refusal to register based on Applicant Dell's alleged failure to submit a specimen evidencing actual trademark use. Dell sought to register the mark QUIETCASE for "computer hardware: internal cases for computer hardware being parts of computer workstations." It submitted as its specimen of use a webpage printout, asserting that the webpage comprised a display associated with the goods

(Rule 2.56(b)(1)). The Board recognized that "[i]n effect, a website is an electronic retail store, and the webpage is a shelf-talker or banner which encourages the customer to buy the product." It therefore held that "a website page which displays a product, and provides a means of ordering the product, can constitute a 'display associated with the goods,' as long as the mark appears on the webpage in a manner in which the mark is associated with the goods." As to Dell's actual specimen, the Examining Attorney argued that the mark, which appeared in a list of bullet points, was not sufficiently near the picture of the goods and was not prominently displayed. The Board, however, found the mark "sufficiently prominent that consumers will recognize it as a trademark for the computer hardware shown on the webpage."

Rule 2.61(b) — PTO request for information

***In re Planalytics, Inc.*, 70 USPQ2d 1453 (TTAB 2004).** The Board affirmed a Section 2(e)(1) refusal to register the mark GASBUYER, finding it merely descriptive of "providing on-line risk management services in the field of pricing and purchasing decisions for natural gas." The Board also affirmed a refusal based on Applicant's failure to comply with a request for information under *Trademark Rule* 2.61(b). NEXIS evidence showed that "gas buyer" is a term applied to people who purchase natural gas, and is used in conjunction with risk management. Thus Applicant's mark "describes a feature or characteristic of the services to the extent that it immediately conveys that its services are intended for individuals who purchase natural gas." As to the *Rule* 2.61(b) issue, the Examining Attorney required that Applicant "submit product information for the identified goods/services." Applicant responded that "information regarding its services may be found on its website, located at www.planalytics.com." The Board found that response insufficient because websites often contain voluminous information and are transitory and subject to change at the owner's discretion. "Therefore, it is important that the party actually print out the relevant information and supply it to the Examining Attorney."

Affirmative Defenses — laches

***Alfacell Corp. v. Anticancer, Inc.*, 71 USPQ2d 1301 (TTAB 2004).** The Board sustained a Section 2(d) petition for cancellation of Respondent's registration for the mark ONCASE for "therapeutic compositions containing reagents for in vivo anticancer use," finding the mark likely to cause confusion with the registered and earlier-used mark ONCONASE for "pharmaceuticals, namely, cancer-treating drugs." The Board deemed the goods to be legally

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identical for Section 2(d) purposes and, because the identifications of goods do not include any limitations, it assumed that the goods move through the same, normal channels of trade. The Board found that the similarities in the marks — particularly the suggestive meaning generated by “ONC,” which connotes oncology — outweigh the differences, observing that “where the marks are used on pharmaceuticals . . . it is extremely important to avoid that which will cause confusion.” Respondent pleaded laches based on Petitioner’s delay of more than seven years from the day the ONCASE mark was published for opposition before bringing this cancellation petition. The Board found this delay to be “substantial” and “unexplained,” but it pointed out that Respondent has the burden to show some detriment as a result of the delay, and it found Respondent’s evidence insufficient to establish material prejudice.

Attorney disqualification

Finger Furniture Co. v. Finger Interests Number One, Ltd., 71 USPQ2d 1287 (Dir. of PTO 2004). The Director of the PTO (acting through the Chief Administrative Trademark Judge) granted Applicant’s petition to disqualify the law firm representing Opposer in this Section 2(d) opposition. Applicant contended that, when the opposition was filed, Opposer’s law firm was simultaneously representing Applicant on another matter: namely, the formation of an “exchange fund.” Opposer argued that Applicant is a *former* client, not a *current* client, of its attorneys, that the test for disqualification is thus the “substantially related test,” and that the law firm’s representation of Applicant “was not at all related, much less substantially related” to this trademark dispute. However, the Director agreed with Applicant that it must be considered a “current client,” since it was a client at the time the opposition was filed. In such case, the law firm must meet a more stringent test: “when a firm seeks to maintain an action against a current client, the sued client has established a *prima facie* case that it will be ‘adversely affected.’” Opposer’s arguments regarding delay, consent, and the unrelatedness of the representations “do not overcome the presumption that applicant will be adversely affected.”

Three Precedential CAFC Decisions

CAFC Rules TLD May Affect Mark’s Registrability

In re Oppedahl & Larson LLP, 71 USPQ2d 1370 (Fed. Cir. 2004).

Oppedahl & Larson LLP maintains a website at www.patents.com that for many years has been a valu-

able source of information and software related to intellectual property. In the trademark realm, its *Feathers!* software — available for free downloading at the website — is an indispensable tool for tracking the status of pending trademark applications and registrations. Its Madrid Protocol webpage provides links to a wealth of materials and commentary on that topic.

Oppedahl & Larson LLP is, however, apparently not content with its current important supporting role in the trademark field. It is intent on affecting substantive trademark law directly, as evidenced by this recent CAFC decision and by a pending TTAB appeal.

In *In re Oppedahl & Larson LLP*, the CAFC affirmed the TTAB’s ruling that PATENTS.COM is merely descriptive for “computer software for managing a database of records and for tracking the status of the records by means of the Internet,” but while doing so it clarified two prior Board precedents regarding the effect of a top level domain indicator (TLD) on the registrability of a mark.

In *In re Martin Container, Inc.*, 65 USPQ2d 1058 (TTAB 2002) [CONTAINER.COM] and *In re CyberFinancial.Net, Inc.*, 65 USPQ2d 1789 (TTAB 2002) [BONDS.COM] the Board held that “.com” has no trademark significance and that its addition to an otherwise descriptive or generic term did not make the proposed mark registrable. The Board cited Professor McCarthy’s view that “a top level domain indicator has no source identifying significance and cannot serve any trademark purpose.” *McCarthy on Trademarks and Unfair Competition*, Sec. 7:17.1 (4th ed. 2002).

Oppedahl & Larson LLP challenged the Board’s application of a strict rule that *always* disregards the use of “.com” and other TLDs in assessing the registrability of a trademark. It argued that the Board should consider the domain designation as part of the mark as a whole, in accordance with the anti-dissection rule of *In re Dial-A-Mattress Operating Corp.*, 57 USPQ2d 1807 (Fed. Cir. 2001) [requiring the Board to consider the mark “1-888-M-A-T-R-E-S-S” as a whole, even though the area code portion was devoid of source-identifying significance.]

The CAFC agreed with the law firm, but it noted that PTO policy does not dictate “an absolute prohibition on the possibility that adding a TLD to a descriptive term could operate to create a distinctive mark.” TMEP §1209(m) states that “Because TLDs *generally* serve no source-indicating function, their addition to an otherwise unregistrable mark *typically* cannot render it registrable.” [emphasis added]. Thus, the court opined, it would be legal error to apply a bright-line rule that the addition of a TLD to a descriptive term could *never* affect the registrability of a mark.

The court offered a rather strange hypothetical case that “might illustrate” a TLD’s effect on registrability: the descriptive word “tennis” combined with the TLD

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“.net” for a store that sells tennis nets, but not via the Internet. (One wonders why the term “.net” should be considered a TLD at all under these circumstances.) According to the court, although the “net” portion alone has no source-identifying significance, “the hypothetical mark, as is immediately apparent, produces a witty double entendre relating to tennis nets . . . [that] could enhance the prospects of registrability for the mark as a whole.”

This hypothetical example illustrates that, although TLDs will most often not add any significant source-identifying function to a mark, a bright-line rule might foreclose registration to a mark with a TLD component that can demonstrate distinctiveness. 71 USPQ2d 1373.

In the case of PATENTS.COM, while Oppedahl & Larson LLP may have won the skirmish over the appropriateness of a bright-line rule regarding TLDs, it lost the war. The CAFC observed that the law firm’s website at www.patents.com offers software to track patent applications and issued patents via the Internet. Thus, according to the court, “patents” describes a feature of the goods and “.com” refers to their accessibility via the Internet. It ruled that the combination of the “.com” TLD with the word “patents” does not create any different impression, and that the mark PATENT.COM as a whole is merely descriptive of the goods. It therefore upheld the Board’s decision.

Meanwhile, Oppedahl & Larson LLP owns a pending service mark application for the identical mark PATENTS.COM for “on-line information services in the field of intellectual property law provided via interconnected computer network linked by common protocols.” (Serial No. 75051843). That mark has been refused registration on the grounds of genericness and failure to function as a service mark. The law firm has appealed to the TTAB, and the case stands fully briefed and argued, and a decision by the TTAB is awaited. Oppedahl & Larson LLP contends not only that PATENTS.COM is *not* generic, but also that it has acquired secondary meaning. The firm asserts that *Martin Container* and *CyberFinancial.Net* were wrongly decided and that PATENTS.COM should be treated like the 1-888-M-A-T-R-E-S-S mark in *Dial-A-Mattress* – i.e., as merely descriptive but not generic. It seeks further clarification of the trademark significance of the “.com” TLD, challenges the CAFC’s artificial compound word/phrase dichotomy that the Board applies in the genericness area (1-888-M-A-T-R-E-S-S was considered a phrase, whereas CONTAINER.COM was treated as a compound word), and questions the appropriateness of Examination Guide 2-99, which equates domain names with unregistrable addresses.

Thus this second Oppedahl & Larson LLP case may yield further clarification of a number of important issues concerning the registrability of domain names as trademarks.

CAFC Affirms *In re Chatam’s* Section 2(d) Analysis

In re Chatam Int’l Inc., 71 USPQ2d 1944 (Fed. Cir. 2004).

In a straightforward ruling, the CAFC upheld the TTAB’s decision affirming a Section 2(d) refusal to register the mark JOSE GASPARGOLD for tequila. The Board found the mark likely to cause confusion with the mark GASPARGOLD (ALE disclaimed), registered for “beer or ale.”

Appellant Chatam asserted that the Board, in finding the marks similar, improperly dissected the marks and discarded the dissimilar portions. The court disagreed, noting that the Board “clearly recognized and acknowledged the differences,” and “for good reason” discounted the significance of ALE in the registered mark and JOSE and GOLD in Chatam’s mark. ALE, of course, is a generic term, JOSE “simply reinforces the impression that GASPARGOLD is an individual’s name,” and GOLD is a descriptive term “offering little to alter the commercial impression of the mark.” Thus the dominant feature of Chatam’s mark is GASPARGOLD and that of the cited mark is GASPARGOLD.

Accordingly, even though the Chatam’s mark and the registered mark are not word-for-word copies of one another, substantial evidence supports the Board’s decision that the two marks, when viewed in their entireties, are strikingly similar. 71 USPQ2d 1947.

The CAFC decided that the TTAB also properly considered the relatedness of the goods, and that the Board’s finding of a “close relationship” between tequila and beer or ale was supported by substantial evidence. “Indeed, the goods often emanate from the same source because ‘both are alcoholic beverages that are marketed in many of the same channels of trade to many of the same consumers.’” (quoting *In re Majestic Distilling Co.*, 65 USPQ2d 1201 (Fed. Cir. 2003)). They are “inexpensive commodities that consumers would be unlikely to distinguish by manufacturer.” 71 USPQ2d 1948.

In closing, the CAFC confirmed that, like the TTAB, it “resolves doubts about the likelihood of confusion against the newcomer because the newcomer has the

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opportunity and the obligation to avoid confusion with existing marks.” 71 USPQ2d 1948.

CAFC Partially Reverses TTAB in Ritz Hotel Opposition

Shen Mfg. Co. v. The Hotel Ritz Limited, 73 USPQ2d 1350 (Fed. Cir. 2004).

Five trademark applications filed twenty years ago by The Ritz Hotel, Ltd. (owner of the Paris Ritz) have finally cleared the opposition hurdle. In a precedential opinion, the CAFC in *Shen Mfg. Co. v. The Ritz Hotel, Ltd.* reversed the part of the TTAB's decision (17 *Allen's Trademark Digest* 5, (November 2003)) that had refused registration of two marks, and it affirmed the part that had dismissed Shen's opposition as to the other three.

The Ritz sought to register the marks PUTTING ON THE RITZ for shower curtains, RITZ PARIS RITZ HOTEL and Design shown here for dinnerware, the same RITZ PARIS RITZ HOTEL and Design mark for various floor and wall coverings, RITZ for cooking and wine selection classes, and THE RITZ KIDS for clothing. Shen succeed at the Board level in preventing registration of the last two marks under Section 2(d), relying on its use of the mark RITZ since 1892 for various textile items, including dish towels, potholders, aprons, bathroom towels, and ironing board covers, as well as for various other textile items.

The CAFC first considered Shen's assertion that its RITZ mark is famous and entitled to enhanced protection under Section 2(d). Agreeing with the TTAB, the court found inadequate Shen's evidence of \$5 million in annual sales, use of its mark for more than a century,



and hundreds of thousands of dollars in annual advertising expenditures. Shen's evidence "does not compare in terms of sales, advertising, or media interest" with that in other cases in which the CAFC has found fame.

As to the marks, the CAFC agreed with the Board that PUTTING ON THE RITZ is sufficiently different from RITZ to avoid a likelihood of confusion. It reached the same conclusion as to the two RITZ PARIS RITZ HOTEL and Design marks.

As to the mark RITZ for cooking and wine selection classes, the CAFC disagreed with the TTAB that those services are related to kitchen textiles. The Board had reasoned that "in providing cooking courses . . . it would be necessary that one make use of kitchen towels, dish cloths, aprons, barbecue mitts and potholders." The CAFC noted the lack of evidence that the consuming public would perceive these goods and services as originating from the same source. It ruled that "[a]lthough the marks are identical, the differences in the products as well as the *weakness* of Shen's mark" required dismissal of Shen's opposition to this mark. [emphasis added].

Finally, as to the mark THE RITZ KIDS, the TTAB had dubiously found the goods related because the hotel's goods included gloves, and Shen's barbecue mitts are a kind of glove. Then, relying on this "partial identity" of the goods, the Board opined that a lesser degree of similarity of the marks was required to support a likelihood of confusion finding. The CAFC, however, found the goods unrelated and the marks dissimilar, and it therefore reversed the Board's ruling.

There was no mention in either the Board's opinion or that of the CAFC about actual confusion or the lack thereof. One would think that, had confusion been likely between the marks in question, some evidence of confusion would have arisen over the century of simultaneous use of the RITZ marks by the parties. Somehow I doubt that many people would associate RITZ brand potholders and ironing board covers with the ultra-posh Hotel Ritz in Paris.