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## Keeping Tabs on the TTAB®

### The Top Ten TTAB Decisions of 2007

By John L. Welch

The TTAB issued 500 or so final decisions in 2007, as well as numerous interlocutory rulings. Sixty-six of its decisions and rulings were deemed precedential. Once again yours truly has unabashedly chosen the 10 decisions that he believes are the year's most important and/or interesting. Five are precedential decisions and five (or six) are not. Perhaps the precedential determinations are the more important because they constitute binding precedent, but the non-precedential ones at a minimum have educational and/or entertainment value. Or at least I hope so.

**Hurley Int'l LLC v. Volta, 82 USPQ2d 1339 (TTAB 2007) [precedential].** Extending its *Medinol* jurisprudence to a pending application, the TTAB found fraud because Applicants' mark was not in use in commerce in connection with all of the recited entertainment services when the Voltas filed their use-based application. But in *dictum*, the Board pointed practitioners to a possible escape route out of the fraud quagmire. The Voltas pleaded innocence, claiming that they misunderstood the requirements of Section 1(a), did not comprehend the legal meaning of "use in commerce," and "honestly believed that their ownership of the same mark in Australia and their use in commerce of such mark in Australia justified their Section 1(a) filing in the U.S." They noted that Applicant Paul Volta suffered a major coronary infarct in November 2003 [after the application was published and opposed], and further that they have been "defending themselves and have no legal representation as such." The Board was totally unsympathetic and it agreed with Opposer that "this case is similar to the *Medinol* case." "[P]roof of specific intent is not required." Significantly, Applicants' "asserted misunderstanding regarding the meaning of 'use' was not reasonable." The Board therefore deemed the application void *ab initio* and entered summary judgment in Opposer's favor. In a noteworthy footnote, however, the Board cited *Universal Overall Co. v. Stonecutter Mills Corp.*, 154 USPQ 104 (CCPA



1967), in observing that a false statement corrected prior to an application's publication does not constitute fraud.

**Intel Corp. v. Emeny, Opposition No. 91123312 (May 15, 2007) [not precedential].** In a rare ruling on "intent to use" that may cause trademark practitioners to re-think their approach to ITU applications, the Board sustained an opposition to registration of the mark IDEAS INSIDE for on-line ordering and distribution services for a host of goods (including more than 200 items of clothing, from "anoraks" to "wrestling uniforms"), search engine services, and digital transmission services. Applicant Steven Emeny, appearing *pro se*, failed to produce any objective evidence of a *bona fide* intent to use his mark: There was no evidence of any business plans, nor any evidence of a single business contact with any potential partner who would supply the goods that Applicant would sell. Moreover, the instant application (like eight others filed by Emeny and later abandoned) included "an unreasonably broad listing of goods and services," and on cross-examination, Emeny admitted that he wanted to "make sure that nobody else [can] take advantage of those marks." The Board observed, ominously, that under *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993), the "failure to produce any objective evidence of an intent to use is sufficient basis for ruling in Intel's favor."

**In re Joint-Stock Company "Baik", Serial No. 78521961 (August 28, 2007) [precedential].** Judge Seeherman's concurring opinion was the highlight of this decision reversing a Section 2(e)(4) refusal of the mark BAIK for vodka. The Board found that the PTO failed to establish a *prima facie* case that BAIK is primarily merely a surname. Based upon the PTO's evidence, essentially comprising 456 hits from a Verizon database, the Board saw BAIK as an "extremely rare surname." As to other meanings of the term, the PTO pointed to "negative dictionary evidence," while Applicant argued that BAIK is an arbitrary Russian-sounding word mark "similar to Baikal, a Russian lake in Siberia" and to "the Baikal mountain range in Siberia" and that the public sees BAIK as a "fanciful Russian term used in a trademark sense." The

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Board agreed with Applicant. It was not convinced that “the similarity of Baik to other obscure surnames somehow results in Baik having the ‘look and feel’ of a surname.” Judge Seeherman thoughtfully questioned the appropriateness of the “look and feel” factor, opining that registration should not be refused just because a mark “is similar in sound or appearance to other surnames.” She urged that the refusal of a surname should focus on how many people have that same surname and thus would be affected by registration of the surname.

***In re IP Carrier Consulting Group*, 84 USPQ2d 1028 (TTAB 2007) [precedential].** The TTAB adopted the same stance as the Trademark side of the USPTO on the admissibility of *Wikipedia* evidence: admissible, but its weight may vary depending on corroborating sources. The PTO refused registration under Section 2(e)(1) of the marks ipPICS and ipPIPE for telecommunications services featuring a device that allows Internet transmission of images and video. Applicant submitted the *Wikipedia* entry for “Internet Service Provider” to show that a common abbreviation for “Internet Provider” is “ISP.” The Board observed that “[t]here are inherent problems regarding the reliability of *Wikipedia* entries because *Wikipedia* is a collaborative website that permits anyone to edit the entries.” On the other hand, the Board also noted that Internet evidence is “generally admissible and may be considered for purposes of evaluating a trademark.” It determined that it will consider *Wikipedia* evidence “so long as the non-offering party has an opportunity to rebut that evidence...,” but the “better practice” is to corroborate that information. Although there was corroborating evidence for Applicant’s definition in the form of a dictionary listing, the Board nonetheless found that “IP” means “Internet Provider” and/or “Internet Protocol,” and it deemed the two marks to be merely descriptive.

***New York State Dept. of Economic Development v. Stewart*, Opposition No. 91162024 (March 13, 2007) [not precedential]** and ***New York State Dept. of Economic Development v. I Love Santa Barbara, Inc.*, Opposition No. 91165648 (October 31, 2007) [not precedential].** The TTAB dismissed two Section 2(d) oppositions brought by the State of New York in connection with the familiar, registered I♥NY mark, because New York failed to prove its case in each instance. New York took no testimony and submitted mere photocopies of its registrations, rather than status-and-title

copies, by way of notice of reliance. In the first, the Board ruled that New York had failed to establish priority, and in the second New York failed to prove both standing and priority. What makes New York’s mistake particularly unfathomable is the fact that, in each case, the Board, in denying New York’s summary judgment motion, gave notice to New York that mere photocopies of the registrations were not sufficient for purposes of Rule 2.122(d). [As of August 31, 2007, ordinary photocopies from the PTO database are sufficient under Rule 2.122(d) when submitted with an original pleading, but that new rule applies only to proceedings commenced on or after that date].

***Bose Corp. v. Hexawave, Inc.*, Opposition No. 91157315 (November 6, 2007) [not precedential].** Opposer Bose lost the fraud battle but won the war in its Section 2(d) opposition to registration of the mark HEXAWAVE for various electronic devices, including amplifiers and tuners. The Board sustained Applicant Hexawave’s fraud claim concerning one of Bose’s pleaded registrations, but went on to find the HEXAWAVE mark likely to cause confusion with Bose’s famous WAVE and ACOUSTIC WAVE marks for audio products that include amplifiers and tuners. The claim of fraud against Bose centered on the renewal in 2001 of its registration for the mark WAVE for, *inter alia*, audio tape recorders. Although Bose stopped offering audio tape recorders in 1996-97, it did not delete those goods when it filed for renewal, claiming that shipment of returned products after repair satisfied the use requirement. The Board noted that Bose offered no case support for its theory that “transporting” a product back to its owner after repair constitutes use of a trademark on the product as contemplated by Section 45 of the *Trademark Act*. Finding that it was not reasonable for Bose to believe that this shipment of goods that it no longer owned constituted “use” under the *Act*, the Board (rather harshly) ruled that Bose had committed fraud.

***CNL Tampa Int’l Hotel Partnership, LP v. Palazzolo*, Opposition No. 91163724 (March 7, 2007) [not precedential].** The TTAB dismissed a Section 2(d) opposition to registration of the mark PELAGIA for “clothing, namely shirts,” finding the mark not likely to cause confusion with the identical mark for restaurant services. Opposer claimed that clothing “is within the natural scope of expansion for restaurant services.” Its only proof of relatedness of these goods and services, however, was a collection of 102 third-party registrations each encompassing both restaurant services and clothing. The Board noted that third-party registrations “may have some probative value to the extent that they serve to suggest that the listed goods and/or services are of a type that may emanate from a single source,” but the Board refused to

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draw the inference that these goods and services are “legally related products” requiring a finding of likelihood of confusion. It noted that acceptance of Opposer’s argument would be tantamount to creating a *per se* rule “that the same or similar marks for restaurant services and clothing is likely to cause confusion.” Taken to the “absurd extreme,” if third-party registrations alone were sufficient to prove relatedness of goods and services, “then virtually all consumer products and services would be related.”

***Hormel Foods Corp. v. Spam Arrest, LLC, Cancellation No. 92042134 (November 21, 2007) [not precedential].*** The Board dismissed Hormel’s petition for cancellation of a registration for the mark SPAM ARREST for “computer software, namely software designed to eliminate unsolicited commercial electronic mail,” finding that Hormel had failed to prove likelihood of confusion and dilution vis-à-vis its famous mark SPAM. Likelihood of Confusion: Respondent conceded the fame of the SPAM mark for purposes of Section 2(d), and also conceded that Hormel owns a family of SPAM marks. It was undisputed that “spam” is a generic term for unsolicited commercial e-mail. “This dichotomy between the fame of petitioner’s trademark and the generic meaning of the same term” was crucial to the Board’s 2(d) determination. Although the Board gave “great weight” to the fame of the SPAM mark, “that fame does not extend to computer software.” Dilution: The Board found that Hormel had proven SPAM to be famous for canned meat but failed to prove that its mark is “distinctive” for dilution purposes – *i.e.*, “that the mark has become the principal meaning of the word.” Hormel’s dilution by tarnishment claim was given short shrift, being based on a few Internet postings dissing Respondent’s software. And so, Hormel’s petition for cancellation was scraped off the Board’s plate and into the trash can.

***In re Valenite Inc., Serial No. 76482852 (July 31, 2007) [precedential].*** In view of the “prevalence of online retailing” and the specialized nature of Applicant’s products, the Board found Applicant’s home webpage to constitute a “display associated with the goods” and therefore a proper specimen of use for the mark VALPRO for tools for power operated metal cutting machines. Applicant relied on *Lands’ End Inc. v. Manbeck*, 24 USPQ2d 1314 (E.D. Va. 1992) and *In re Dell Inc.*, 71 USPQ2d 1725 (TTAB 2004) in arguing that its webpage is a display associated with the goods (Rule 2.56(b)(1)). The PTO maintained that the specimen of use failed

because “the mark is not associated with the goods” and “sufficient ordering information” is lacking. The word VALPRO appears at the top middle of the Web page, to the right of a picture of some of Applicant’s tools. A link to an online catalog is provided, along with a toll free number and web links to customer service, technical support, and Applicant’s “Technical Resource Center.” The Board found that the webpage satisfies *Lands’ End* and *Dell* because it (i) includes a picture of the goods; (ii) shows the mark near enough to associate the mark with the goods; and (iii) contains information necessary to order the goods.

***Paris Glove of Canada, Ltd. v. SBC/Sporto Corp., Cancellation No. 92044132 (August 22, 2007) [precedential].*** The Board granted Respondent’s motion for summary judgment, permitting amendment of its registered mark and finding Petitioner’s claims of abandonment, naked licensing, and fraud to be without merit. Respondent convinced the Board to strike from the record a Google “hit list” search summary retrieved via the “Wayback Machine” because it was not properly authenticated. The Board pointed out that Internet materials “may be admissible as evidence in connection with a summary judgment motion, if competent and relevant, provided that they are properly authenticated by and affidavit or declaration pursuant to FRCP 56(e). See TBMP Section 528.04(e)(2d ed. rev. 2004).” Petitioner argued that concerns about authentication no longer exist in view of the availability of the *Internet Archive* and its “Wayback Machine” feature. According to Petitioner, the “Wayback Machine” shows “each date on which a website has undergone a significant change.” The Board, however, observed that the “Wayback Machine” suffers from a serious evidentiary flaw: “What may be insignificant to the archivers for the ‘Wayback Machine’ may have significance from the standpoint of evidentiary value in a trademark proceeding. Thus, changes to a website, or in this case the excerpts taken from a website that appear in a Google search summary, may not appear in the Internet Archive.”

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