

**Decisions of the Trademark Trial and Appeal Board
and the Federal Circuit on Registrability Issues
June 2012 to March 2014**

John L. Welch¹

I. EX PARTE CASES

A. United States Court of Appeals for the Federal Circuit

1. Section 2(a) Immoral or Scandalous

a. *In re Fox*, 105 USPQ2d 1247 (Fed. Cir. 2012). The CAFC affirmed the TTAB’s decision holding that the mark depicted here, for “chocolate suckers molded in the shape of a rooster,” is scandalous under Section 2(a) and therefore unregistrable. The appellate court concluded that “a mark that creates a double entendre falls within the proscription of Section 1052(a) where, as here, one of its meanings is clearly vulgar.” The court observed that “[n]othing in this decision precludes Fox from continuing to sell her merchandise under the mark at issue, or from seeking trademark protection for some other, otherwise registrable element of her product’s design, dress, or labeling. If Fox is correct that the mark at issue ‘bring[s] [nothing] more than perhaps a smile to the face of the prospective purchaser,’ *** then the market will no doubt reward her ingenuity. But this does not make her mark registrable.”



2. Section 2(b) Governmental Insignia

a. *In re City of Houston and In re The Government of the District of Columbia*, 108 USPQ2d 1226 (Fed. Cir. 2013). In a combined opinion, the CAFC affirmed the TTAB’s decisions upholding the PTO’s Section 2(b) refusals to register the governmental seals of the District of Columbia and the City of Houston. Section 2(b) prohibits an “applicant” from registering a mark that “consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.” These two cases raised a question



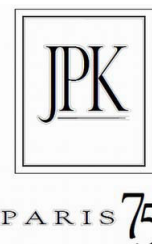
of first impression: whether a local government entity may obtain a federal trademark registration for its official insignia. The City of Houston argued that the context of Section 2(b) suggests that Congress did not mean “applicant” to include a government entity seeking to register its own seal. The court found nothing in the “plain language” of the statute that suggests an exemption for a governmental entity like Houston. The District asserted that to deny it registration for its seal would violate the obligations of the United States under the Paris

¹ Of Counsel, Lando & Anastasi LLP, Cambridge, Massachusetts. Further discussion of each of these cases, and links to the opinions therein, may be found at The TTABlog at www.ttablog.com.

Convention, but the court concluded that, even assuming the Lanham Act was intended to implement the obligations of the Paris Convention, there was nothing in either the text or the context thereof to suggest any support for the District’s position.

3. Section 2(e)(3) Primarily Geographically Deceptively Misdescriptive

a. *In re Miracle Tuesday, LLC*, 104 USPQ2d 1330 (Fed. Cir. 2012). The CAFC upheld the TTAB’s decision affirming a Section 2(e)(3) refusal to register the mark shown here, finding it to be primarily geographically deceptively misdescriptive of sunglasses, wallets, bags, suitcases, belts and shoes. Miracle Tuesday did not dispute that the primary significance of the mark is Paris. It argued that the Board erred in finding that the goods do not originate in Paris when the designer of the goods had significant ties to Paris, that the Board applied the wrong standard in concluding that the word PARIS is deceptive, and that the Board failed to consider certain material evidence. The CAFC, however, agreed with the Board that the evidence failed to show the necessary “direct connection” between the goods and Paris to satisfy the “origination” test. It also ruled that the Board properly applied an inference of materiality based on the fame of Paris as a source of fashion accessories. Finally, the court found that the Board had fully considered the “origination” issue, and that “the mere fact that the Board did not recite all of the evidence it considered does not mean that the evidence was not, in fact, reviewed.”



B. Trademark Trial and Appeal Board

1. Section 2(a) Immoral or Scandalous

a. *In re Star Belly Stitcher, Inc.*, 107 USPQ2d 2059 (TTAB 2013). Aw, shucks! Here we go again. The Board affirmed a Section 2(a) refusal to register the mark AWSHIT WORKS for baseball caps and other clothing items, finding the mark to be scandalous. Dictionary definitions uniformly deemed the term “shit” to be vulgar or offensive. In addition, newspaper articles and other media evidence demonstrated that the word “shit” is considered offensive. And a recent Supreme Court opinion opted for the designation “s***” in place of the word “shit.” Consequently, the Board had “no trouble” finding a violation of Section 2(a)’s ban on immoral or scandalous marks. The Board observed that the PTO may prove scandalousness by establishing that a mark is “vulgar.” When it is clear from dictionary definitions alone that the mark is vulgar to a substantial composite of the public, the mark is unregistrable. Here the evidence included a definitions of “aw shit” from the *Urban Dictionary*, an online slang dictionary whose definitions are submitted by visitors to the website. The Board ruled that this dictionary should be treated like the *Wikipedia* website: definitions will be accepted from the *Urban Dictionary* as long as the non-offering party has an opportunity to rebut the evidence. Here, the examining attorney submitted the *Urban Dictionary* definition at an early stage, and applicant failed to provide any alternative meanings of “aw shit.”

2. Section 2(a) Deceptiveness

a. *In re E5 LLC*, 103 USPQ2d 1578 (TTAB 2012). The Board affirmed a Section 2(a) refusal of the mark shown here (the symbol alpha followed by the upper-case letters CU), finding it to be deceptive for “dietary supplements, namely, lipoic acid, vitamin C, ascorbic acid, zinc, zinc amino acid chelate, riboflavin, biotin, vanadium, vanadium sulfate.” The Board agreed with the PTO that CU means copper to consumers, that copper is not included in applicant’s goods, and that this misrepresentation will materially affect the consumer’s decision to purchase the goods. Applicant acknowledged that “Cu” with a lowercase “u” represents copper on the periodic table, but it argued that CU (upper case) would not be understood by consumers to mean copper. The Board was persuaded otherwise by the PTO’s submission of more than a dozen references showing the use of CU to refer to copper. Because the evidence also demonstrated that copper is a common ingredient in dietary supplements, the Board found that consumers “encountering applicant’s mark with the term ‘CU’ will likely understand the term in context to refer to the chemical element copper.” The materiality of the misstatement was demonstrated by proof that copper has important and desirable health benefits.



b. *In re White Jasmine LLC*, 105 USPQ2d 1385 (TTAB 2013). The Board affirmed a Section 2(a) refusal of the mark WHITE JASMINE & Design, finding the word “White” to be deceptive for applicant’s tea. The PTO put applicant in hot water by submitting a considerable batch of Internet evidence establishing that “white jasmine” is a type of tea. The Board noted that a mark may be found deceptive based on a single embedded term. White jasmine tea is a subcategory of two types of tea: white tea and jasmine tea. Applicant admitted that its tea does not contain white tea leaves. Consequently, WHITE JASMINE misdescribes applicant’s tea. The Board found it quite likely that consumers would believe that applicant’s tea contains white tea. And the PTO’s evidence showed that consumers perceived that white tea has desirable health benefits; therefore, the misdescription is material to the purchasing decision.



c. *In re AOP LLC*, 107 USPQ2d 1644 (TTAB 2013). The Board affirmed a quintet of refusals to register the term AOP for wine, finding it to be deceptive under Section 2(a), and merely descriptive or deceptively misdescriptive under Section 2(e)(1). The Board also found that the term fails to function as a trademark (Sections 1, 2, and 45), and that applicant failed to comply with the PTO’s requirement for more specific information regarding the goods (Rule 2.61(b)). The evidence established that “AOP” is a term used in the European Union (EU) to designate a particular quality and geographical origin of wine. Applicant admitted that it is not the administrator of the AOP designation, and further that its goods “do not necessarily originate in Europe.” The Board concluded that AOP misdescribes applicant’s wine. Moreover, consumers would believe the misdescription, and such misdescription is material to the purchasing decision. Applicant’s answers were evasive and equivocal to the examining attorney’s questions regarding the origination and certification of applicant’s wine and the Board therefore found that applicant failed to comply with Rule 2.61(b). Finally, the Board ruled that the term AOP, as used by applicant, would be viewed as merely informational and not as source-identifying, and therefore it failed to function as a trademark.

3. Section 2(a) Disparagement

a. *In re Tam*, 108 USPQ2d 1305 (TTAB 2013). The Board affirmed a Section 2(a) refusal to register the mark THE SLANTS for “entertainment in the nature of live performances by a musical band,” finding that the mark, when used in connection with applicant’s services, would be perceived as disparaging to a substantial composite of the referenced group, namely, persons of Asian descent. Relying on dictionary definitions, online articles, and applicant’s own webpage and *Wikipedia* entry, the PTO maintained that THE SLANTS is a highly disparaging term to people of Asian descent, that it retains that disparaging meaning when used in connection with applicant’s services, and that a substantial composite of the referenced group finds it to be disparaging. Applicant Simon Shiao Tam contended that the word “slant” has several meanings and is therefore not “inherently disparaging.” He challenged the propriety of the PTO’s consideration of the manner in which applicant used the mark, asserting that the refusal was “dependent on the identity of the person, rather than the content of the application,” and maintaining that the PTO improperly considered applicant’s ethnicity and his use of the mark in reaching its conclusion. Applying the two-part test of *In re Lebanese Arak Corp.*, 94 USPQ2d 1215, 1217 (TTAB 2010), and then observing that the refusal to register does not affect applicant’s right to use the subject mark but only his right to register, the Board affirmed the refusal.

4. Section 2(a) False Association

a. *In re Jackson Int’l Trading Co. Kurt D. Bruhl GmbH & Co. KG*, 103 USPQ2d 1417 (TTAB 2012). The Board affirmed a Section 2(a) refusal to register the mark BENNY GOODMAN COLLECTION THE FINEST QUALITY (stylized) for fragrances, cosmetics, leather goods and clothing, finding that the mark falsely suggested a connection with the late band leader and musician, Benny Goodman. Noting that performers commonly capitalize on their renown by licensing their names for collateral products, the Board concluded that consumers would associate applicant’s goods with the “well-known bandleader, composer and clarinetist.” There was no evidence of a connection between Benny Goodman and applicant’s business, and the Board found that “Benny Goodman remains a well-known figure among a sufficient segment of the population as to support finding a false suggestion of a connection.”



b. *In re Pedersen*, 109 USPQ2d 1185 (TTAB 2013). The Board held that the mark LAKOTA for medical herbal remedies falsely suggests a connection with the Lakota people, in violation of Section 2(a) of the Trademark Act. It found that the subject mark is identical to the name used to identify existing Native American people and their language and points uniquely and unmistakably to the Lakota people and language, that applicant Kent Pedersen has no actual or commercial connection with the Lakota people or language, and that the LAKOTA name is of sufficient fame or reputation that a connection with the Lakota people would be presumed if applicant’s mark were used in connection with his goods. Pedersen argued that LAKOTA has multiple definitions and primarily identifies a language or dialect, and therefore the term cannot point uniquely and unmistakably to a person or institution. The Board, however, ruled that the fact that LAKOTA refers to the language spoken by the subgroup of the

Sioux tribe known as the Lakota does not mean that the term cannot also approximate the identity of a people or institution. The phrase “persons or institutions” in Section 2(a) is given a broad scope, and “may include groups of persons and individual members of a group such as the members of an Indian tribe having a common heritage and speaking a common language.”

5. Section 2(d) Likelihood of Confusion

a. Likelihood of Confusion Found

i. *In re RiseSmart, Inc.*, 104 USPQ2d 1931 (TTAB 2012). The Board affirmed Section 2(d) refusals of the marks TALENT ASSURANCE for “personnel placement and recruitment services” and JOB ASSURANCE for “employment counseling and recruiting services; employment outplacement services,” finding the marks likely to cause confusion with the registered mark ASSURANCE for “temporary personnel services.” The Board also affirmed the PTO’s requirement under Rule 6(a) that the applicant disclaim the words TALENT and JOB in its respective marks. RiseSmart contended that its marks engender commercial impressions different from the mark ASSURANCE, but the Board disagreed: “We find that the marks would convey the same connotation with regard to the word ASSURANCE and the additional words in applicant’s mark simply provide more information as to the nature of the services.” Applicant’s marks are likely to be seen as variations of the registered mark. In short, the similarities outweigh the differences in the marks.

ii. *In re Cook Medical Technologies LLC*, 105 USPQ2d 1377 (TTAB 2012). In this “somewhat unusual” likelihood of confusion case involving the comparison of two color marks, the Board affirmed a refusal to register the color “teal” for “medical devices, namely, guiding sheaths for use in conjunction with access needles, wire guides, and dilators for providing access for diagnostic and interventional devices in vascular and non-vascular procedures.” The Board found the applied-for mark confusingly similar to a registered mark comprising the color “blue” applied to the tip and indwelling length of catheters. Cook confirmed that its sheaths may be used with catheters, and its website so indicated. Third-party websites corroborated the same type of complementary use. The Board therefore found the goods to be closely related. The Board noted that Cook originally dubbed its mark as the color “blue/teal,” and the Board further observed that the narrow shapes of the products may make it more difficult to differentiate between the shades of blue. Although sympathizing with Cook’s plight, the Board pointed out that Cook could have tried to narrow the cited registration via Section 18 to the specific shade of blue actually used, or it could have sought a consent from the registrant.

iii. *In re Midwest Gaming & Entertainment LLC*, 106 USPQ2d 1163 (TTAB 2013). The Board affirmed a refusal to register the mark LOTUS for “bar services located in a casino,” finding it likely to cause confusion with the identical mark registered for “providing banquet and social function facilities for special occasions; restaurant and bar services.” Applicant argued that the “restaurant and bar services” of the cited registration must be considered in the context of the entire recitation of services and therefore read narrowly to be services offered in connection with “banquet and social function facilities for special occasions.” The Board disagreed and instead read the disputed phrase as identifying discrete and separate services. Under standard examination practice, a semicolon is used to separate distinct categories

of goods or services. *See Trademark Manual of Examining Procedure* Section 1402.01(a) (October 2012). The Board observed that applicant essentially was asserting that “restaurant and bar services” should be read *in pari materia* with “providing banquet and social function facilities for special occasions.” That argument was unavailing. *See In re Thor Tech Inc.*, 90 USPQ2d 1634 (TTAB 2009) [Interpreting the term “trailers” broadly in the phrase “trailers, dump trailers, and truck bodies” to include recreational trailers, rather than restrictively to refer to industrial and commercial trailers].

iv. *In re Sela Products, LLC*, 107 USPQ2d 1580 (TTAB 2013). In this appeal from two Section 2(d) refusals to register the mark FORZA for metal mounting brackets for televisions, speakers, and custom audio/video accessories, including cables and wires, the Board affirmed the first refusal, finding Sela’s mark likely to cause confusion with the registered mark FORZA POWER TECHNOLOGIES for surge protectors and other electrical items [POWER TECHNOLOGIES disclaimed]. The Board concluded that purchasers are likely to encounter applicant’s complementary products during the course of purchasing a television, audio or home theater system.

v. *In re Hitachi High-Technologies Corp.*, 109 USPQ2d 1769 (TTAB 2014). In this straightforward Section 2(d) affirmance, the Board took time to point out that the “family of marks” doctrine is inapplicable in an *ex parte* context. It upheld a refusal to register the mark OPTICROSS for “liquid chromatography apparatus and parts thereof,” finding the mark likely to cause confusion with the registered mark OPTI for components of liquid chromatography systems. The Board found it unnecessary to consider six additional registrations for “OPTI-” formative marks (all seven registrations being members of the purported “OPTI” family). The “family of marks” doctrine is reserved for *inter partes* proceedings because “establishing a ‘family’ of marks requires a detailed assessment of not just the registrations but, more importantly, of how the ‘family’ is used in the marketplace.” The mere existences of multiple registrations of similar marks does not establish a family; there must be public recognition that the “family surname” (i.e., the shared characteristic) is perceived as a source indicator. Of course, such an assessment of marketplace usage is “usually beyond the scope of an *ex parte* examination.”

b. Likelihood of Confusion Not Found

i. *In re Sela Products, LLC*, 107 USPQ2d 1580 (TTAB 2013). The Board reversed the second of two Section 2(d) refusals to register the mark FORZA for metal mounting brackets for televisions, speakers, and custom audio/video accessories, including cables and wires, finding applicant’s mark not likely to cause confusion with the registered mark FORZA MILAN! ACM 1899 & Design, shown here, for various goods, including optical and electrical cables and sound and image recording and transmission apparatus. The Board concluded that any similarities between Sela’s mark and the cited mark (which refers to the world-renowned football club, A.C. Milan) are outweighed by the differences in appearance and commercial impression (and in the case of soccer aficionados, connotation).



6. Section 2(e)(1) Mere Descriptiveness

a. *In re Future Ads LLC*, 103 USPQ2d 1571 (TTAB 2012). In this “very unusual” case, the Board reversed a refusal to register the mark ARCADEWEB & Design for Internet marketing services, finding that the PTO had failed to meet its burden to show that the term ARCADEWEB is merely descriptive and must be disclaimed. The examining attorney had



cited applicant’s prior Supplemental Registration for the word mark ARCADEWEB for identical services, but that was only in the context of requesting that applicant acknowledge ownership thereof. On appeal, however, the examining attorney asserted for the first time that this Supplemental Registration constituted an implied admission that ARCADEWEB is merely descriptive. The Board found it unfair for the examining attorney to use this evidence “for an argument that is totally different from the purpose for which the registration was submitted, and not even hinted at in the Office actions” Although applicant’s evidence was “quite limited for rebutting the prima facie evidence of mere descriptiveness of a Supplemental Register registration,” the Board observed that one cause for this limited evidence was the PTO’s belated argument after examination had long closed. Moreover, because the examining attorney did not provide any evidence going directly to the mere descriptiveness of ARCADEWEB, “these points outweigh any prima facie evidence of mere descriptiveness from the Supplemental Register registration.”

b. *In re Phoseon Technology, Inc.*, 103 USPQ2d 1822 (TTAB 2012). In this straightforward decision, the Board affirmed a Section 2(e)(1) refusal to register the mark SEMICONDUCTOR LIGHT MATRIX, finding it merely descriptive of “light curing systems composed primarily of light emitting diodes for industrial applications; UV curing systems composed primarily of light emitting diodes, for commercial applications, namely, for curing inks, coatings, adhesives, and a variety of other materials.” The examining attorney relied on dictionary definitions of the constituent words and on use of the term in published articles, on third-party websites, and in two patent applications, leading the Board to find that “SEMICONDUCTOR LIGHT MATRIX describes the technology featured in applicant’s products and, therefore, is merely descriptive of a significant feature of the product.”

c. *In re Franklin County Historical Society*, 104 USPQ2d 1085 (TTAB 2012). The Board affirmed a Section 2(e)(1) refusal to register CENTER OF SCIENCE AND INDUSTRY, finding it to be merely descriptive of “education and entertainment services, namely, operating a museum and conducting workshops, programs and demonstrations in the field of science,” and also lacking in acquired distinctiveness. Dictionary evidence showed the applied-for mark to be descriptive, and third-party websites established that there is a competitive need to use these words. Although applicant’s identification of goods encompasses more than “museum services,” a mere descriptiveness refusal is proper if the mark is descriptive of any of the identified services. Applicant also claimed acquired distinctiveness under Section 2(f), but the Board found its evidence insufficient, despite 35 years of use of the alleged mark, millions of museum visitors, and the receipt of national awards. The Board agreed with the PTO that CENTER OF SCIENCE AND INDUSTRY is “highly descriptive” of applicant’s services,

since it “directly and easily” conveys information about the services; therefore a greater evidentiary showing is needed to establish acquired distinctiveness.

d. *In re Sadoru Group, Ltd.*, 105 USPQ2d 1484 (TTAB 2012). The Board affirmed a Section 2(e)(1) refusal of SADORU (Stylized), finding it merely descriptive of “motorcycle parts and accessories, namely motorcycle seats and ergonomic motorcycle pads for use with seats.” Applicant did not dispute that “sadoru,” which approximates the Japanese word for “saddle,” is at least descriptive of the goods. The sole issue was whether the stylization of SADORU “creates a separate and distinctive commercial impression apart from the word itself, such that the mark as a whole is not merely descriptive.” Applicant argued that the stylization of its mark is inherently distinctive because “the hand-drawn script creates an impression taken from Japanese ink-style script,” giving the mark a “distinctive oriental flavor reminiscent of the ink brush strokes of Japanese (or other Oriental) calligraphy” and creating a mental reference to ancient Japan. The examining attorney, however, provided a sample of Japanese calligraphy, and the Board agreed that applicant’s lettering is “not the same.” The Board viewed the lettering in applicant’s mark to be “more in the nature of slightly stylized block lettering” and concluded that the stylization “does not create a separate and inherently distinctive commercial impression apart from the word itself.”



e. *In re Positec Group Limited*, 108 USPQ2d 1161 (TTAB 2013). The Board affirmed a Section 2(e)(1) refusal to register the mark SUPERJAWS, finding it merely descriptive of machine tools and hand tools, including jaws and metal vice jaws. “Super-” formative marks have been discussed in a number of precedential TTAB decisions, and applicant and the PTO seemingly agreed that there is no *per se* rule as to how the PTO treats the word “super.” The Board found helpful guidance in *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047 (TTAB 2002), where the Board affirmed a Section 2(e)(1) refusal of SUPER SILK for “shirts made of silk-like fabric.” The distinction made in *Phillips-Van Heusen* “explains well the difference in result” between many of the “Super-” formative marks listed by applicant and by the PTO. The marks cited by applicant were either unitary marks in which a disclaimer would not be required, or, for registrations issuing after *Phillips-Van Heusen*, comprised the word “Super” followed by a suggestive term. In the registrations cited by the PTO, the second term “names the goods,” and therefore the registrations included a disclaimer of “Super” or a Section 2(f) claim of acquired distinctiveness, or resided on the Supplemental Register. The Board concluded that consumers would readily understand that the applied-for mark “describes a superior vice system for grasping and holding work pieces” and it affirmed the mere descriptiveness refusal.

7. Section 2(e)(1) Deceptive Misdescriptiveness

a. *In re AOP LLC*, 107 USPQ2d 1644 (TTAB 2013). As discussed above, the Board affirmed a quintet of refusals to register the term AOP for wine, finding it to be deceptive under Section 2(a), and merely descriptive or deceptively misdescriptive under Section 2(e)(1). The Board also found that the term fails to function as a trademark (Sections 1, 2, and 45), and that applicant failed to comply with the PTO’s requirement for more specific information regarding the goods (Rule 2.61(b)). The evidence established that “AOP” is a term used in the European Union to designate a particular quality and geographical origin of wine.

Applicant admitted that it is not the administrator of the AOP designation, and further that its goods “do not necessarily originate in Europe.” The Board concluded that AOP misdescribes applicant’s wine. Moreover, consumers would believe the misdescription, and the misdescription is material to the purchasing decision.

8. Section 2(e)(3) Primarily Geographically Deceptively Misdescriptive

a. *In re Premiere Distillery, LLC*, 103 USPQ2d 1483 (TTAB 2012). The Board affirmed a refusal to register REAL RUSSIAN for vodka, finding it to be primarily geographically deceptively misdescriptive under Section 2(e)(3). Applicant feebly contended that the primary significance of RUSSIAN is not a generally known geographic location because the definitions of record “include multiple meanings for the term ‘Russian.’” The Board pointed out, however, that the meaning of RUSSIAN must be considered in the context of the goods. For vodka, RUSSIAN has a primarily geographic meaning. As to the requisite goods/place association, “[n]ot surprisingly, the evidence of record here overwhelmingly supports a finding that Russia is extremely well known for vodka,” and applicant’s goods do not emanate from Russia. Finally, as to materiality, the evidence established that “vodka is an important product of Russia and that both the public in general, and vodka drinkers in particular, would be aware that Russia is well-known for vodka.” In view of the demonstrated fame and reputation of Russian vodka, the Board may infer that “a substantial portion of consumers who encounter REAL RUSSIAN on applicant’s vodka are likely to incorrectly believe that the vodka comes from Russia and that such mistaken belief would materially influence their decision to purchase the vodka.”

9. Section 2(e)(5) Functionality

a. Utilitarian Functionality

i. *In re Mars, Inc.*, 105 USPQ2d 1859 (TTAB 2013). Mars applied to register the packaging configuration shown here for “pet food.” The mark comprises a cylindrical, inverted container having a “rounded top” with two concentric ridges forming the inner and outer lip of the top. The bottom has a wider ridged lip. The PTO refused registration on the ground of functionality under Section 2(e)(5), and alternatively on the ground that the package design is not inherently distinctive and fails to function as a trademark. The Board affirmed both refusals. (The second refusal is discussed below). Third-party patents disclosed various benefits of the subject design: it better withstands pressure during thermal processing, and the flared bottom lip allows stacking of the containers. Applying the *Morton-Norwich* factors, the Board found the design to be *de jure* functional.



ii. *In re Pohl-Boskamp GmbH & Co. KG*, 106 USPQ2d 1042 (TTAB 2013). The Board turned up its collective nose at applicant Pohl-Boskamp’s unpalatable attempt to register “the distinctive flavor of peppermint” and “the scent of peppermint” for pharmaceutical formulations of nitroglycerin. As to the purported flavor mark, the Board affirmed the PTO’s Section 2(e)(5) functionality refusal. [The failure-to-function refusals are discussed below] A third-party patent disclosed that peppermint oil reduces both the required dosage of nitroglycerin and its side effects. Applying the *Inwood* test, the Board concluded that,

because peppermint oil “imparts a flavor of peppermint ... and potentiates the effect of nitroglycerin,” it affects the quality of nitroglycerin. Although peppermint oil was not an active ingredient in Pohl-Boskamp’s product, a competitor who desired to improve its nitroglycerin spray by adding peppermint oil might be put at a competitive disadvantage if this applicant had the exclusive right to market nitroglycerin spray having a peppermint flavor, because the competitor would have to avoid using peppermint oil or find a way to mask the flavor.

b. Aesthetic Functionality

i. *In re Florists’ Transworld Delivery, Inc.*, 106 USPQ2d 1784 (TTAB 2013). The Board affirmed two refusals to register the color black applied to packaging for flowers, finding the mark to be aesthetically functional under Section 2(e)(5). In *In M-5 Steel Mfg. Inc. v. O’Hagin’s Inc.*, 61 USPQ2d 1086 (TTAB 2001), the Board recognized that there are two forms of functionality: utilitarian and aesthetic. A design feature that does not meet the *Inwood* test for utilitarian functionality is still prohibited from registration if the exclusive appropriation of that feature would put competitors at a significant non-reputation related disadvantage. The Board agreed that the color black “serves an aesthetic function” when used for floral packaging; the evidence showed that color communicates particular messages in the presentation of flowers. The Board concluded that the PTO had demonstrated *prima facie* that competitors in the industry need to use the color black in connection with floral arrangements and flowers.



10. Distinctiveness of Product Packaging

a. *In re The Procter & Gamble Co.*, 105 USPQ2d 1119 (TTAB 2012). The Board reversed the PTO’s refusals to register the two marks shown here, consisting of the overall shape of a container with cap, and the shape of the cap by itself, for mouthwash. The examining attorney deemed the marks to be non-distinctive product packaging, and further maintained that the designs are merely ornamental with no showing of acquired distinctiveness. The Board, however, ruled that the designs are inherently distinctive source indicators whose decorative or ornamental aspects are merely incidental. Considering the cap design, the Board compared it to the bottle tops in the record and found it to be unusual and not a mere variation or refinement of an existing design. As to the bottle-and-cap design, the Board deemed it to be “not common” for oral care products. The record showed that this award-winning design “not only enhanced the appeal of the product, but served simultaneously to identify P&G’s SCOPE OUTLAST brand as well as to update consumers’ associations with the SCOPE brand.”



b. *In re Mars, Inc.*, 105 USPQ2d 1859 (TTAB 2013). Mars applied to register the packaging configuration shown here for “pet food.” The mark comprised a cylindrical, inverted container having a “rounded top” with two concentric ridges forming the inner and outer lip of the top, and a bottom having a wider ridged lip. The PTO refused registration on the ground of functionality under Section 2(e)(5), as discussed above. For the

sake of completeness, the Board also considered and affirmed the alternative refusal, finding that the package design is not inherently distinctive and fails to function as a trademark. Product packaging may be inherently distinctive, provided that it passes the *Seabrook* test. The Board found that the Mars container resembled many metal cans used in the pet field, concluding that the subject design is a common basic shape that is neither unique nor unusual; it was a mere refinement of a commonly adopted and well known form of ornamentation for pet food containers.

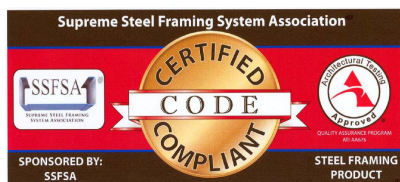


11. Failure to Function/Unacceptable Specimen of Use

a. *In re Phoseon Technology, Inc.*, 103 USPQ2d 1822 (TTAB 2012). The Board affirmed a failure-to-function refusal of the mark SEMICONDUCTOR LIGHT MATRIX, for “light curing systems composed primarily of light emitting diodes for industrial applications; UV curing systems composed primarily of light emitting diodes, for commercial applications.” Phoseon’s specimen of use consisted of a photograph purportedly showing “use of the mark in association with the goods at a trade show.” The examining attorney maintained that the term SEMICONDUCTOR LIGHT MATRIX identifies a technology, not the source of the UV curing system. The critical issue concerned how the relevant public would perceive the mark. The Board found that Phoseon’s trade show display engenders the commercial impression that Phoseon is selling a UV curing system that uses semiconductor light matrix technology. In other words, consumers would perceive the term SEMICONDUCTOR LIGHT MATRIX as identifying the technology used in Phoseon’s product, not as identifying the source of the goods.

b. *In re Rogowski*, 104 USPQ2d 2012 (TTAB 2012). Gary J. Rogowski sought to register the trademark ACTIVE REASONER for “audio recordings featuring music” in class 9. His specimen of use consisted of a screen shot of his YouTube webpage depicting a scene from one of his music videos, and displaying the term ACTIVE REASONER in several locations at the webpage. The PTO issued a refusal to register on the ground that the specimen of use failed to show the mark in direct connection with the identified goods. The Board affirmed. Although it recognized Rogowski’s YouTube music video as an “audio recording featuring music,” it concluded that the specimen “does not show the required correspondence between the mark and the identified goods.” Drawing a parallel with online retailing cases in which a website fails to provide means for ordering a product, the Board ruled that “in the absence of a ‘download’ link or the equivalent thereof, applicant’s specimen on its face fails to show use of his mark in commerce for the identified goods.”

c. *In re Supreme Steel Framing System Ass’n, Inc.*, 105 USPQ2d 1385 (TTAB 2012). The Board affirmed two refusals to register the mark SSFSA CERTIFIED CODE COMPLIANT, in standard character form, for “testing, analysis and evaluation of the goods and

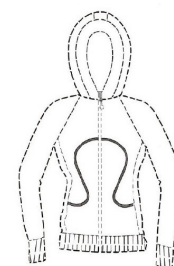


services of others for the purposes of certification in the field of the use of cold-formed steel tracks and steel framing studs” It agreed with the PTO that (1) applicant “is seeking to register multiple marks, as displayed in its specimens,” and (2) applicant’s “mark differs in the drawing and the specimen,” both in violation of Sections 1 and 45 of the Trademark Act.

Examining the specimen of use, the Board concluded that, “[a]s they are presented on these

specimens, ‘SSFSA’ and ‘CERTIFIED CODE COMPLIANT’ would not be perceived as components of a single unitary mark, but rather as two separate marks.” The Board therefore affirmed the (rather dubious) first refusal. Having found that the drawing presents a single composite mark while the specimen does not, the Board perforce concluded that “the mark on the drawing differs from the multiple marks on the specimen.” And so the Board affirmed the second refusal as well.

d. *In re Lululemon Athletica Canada Inc.*, 105 USPQ2d 1684 (TTAB 2013). Affirming a refusal to register the mark shown here for “hooded sweatshirts; jackets; coats,” the Board found the design it to be merely ornamental and not functioning as a trademark. Because Lululemon’s application was not based on actual use, it could not claim acquired distinctiveness. Its attempt to prove inherent distinctiveness was unsuccessful, as was its assertion that the design serves as a secondary source indicator. Lululemon argued that the commercial impression of the mark is a distinctive design, and further that competitors use similar “large marks” on their clothing items. The Board observed that the large size of Lululemon’s design does not *per se* rule out its registrability, but it found that the design “is rather simple and looks like piping.” The Board concluded that it is “likely to be perceived by the public as merely ornamental.” Lululemon claimed that the mark serves as a secondary source indicator because it has registered and used the “same mark” on storefronts and other goods. The Board recognized that ornamentation on clothing (e.g., logos on T-shirts) may be of a “special nature which inherently tells the purchasing public the source of the T-shirt, not the source of manufacture but the secondary source,” but it found that the registered mark and the subject mark were not the same.



e. *In re Arnold*, 105 USPQ2d 1953 (TTAB 2013). The PTO refused registration of the mark BLATANCY for “audio recordings featuring music” on the ground(s) that the mark failed to function as a trademark because it comprised the title of a single artistic work, and because it merely identified the featured performer. The Board reversed the first refusal but affirmed the second. Applicant Arnold overcame the “single work” refusal by showing that the mark BLATANCY has been used on two CDs identified by the BLATANCY designation; because it was not clear whether the two CDs had the same content, the Board gave applicant the benefit of the doubt on this issue. However, the evidence showed that BLATANCY is the name of a performing artist associated with applicant’s goods. The examining attorney advised Arnold that he could overcome this refusal by submitting a verified statement as to his control over the nature and quality of the goods, but Arnold did not do so. The Board then looked to applicant’s MySpace Music page, his official website, advertisement cards, and CD insert, but it found the evidence as to control “conflicting and of uncertain meaning.” It was applicant’s burden to dispel the ambiguities by means of reliable evidence, such as business records or affidavits, and he failed to meet that burden.

f. *In re Powermat Inc.*, 105 USPQ2d 1789 (TTAB 2013). Two more applications to register “chirp” sounds as trademarks fell on deaf ears at the TTAB. The Board affirmed the PTO’s refusals to register applied-for marks comprising “five short electronic chirps,” one in slightly increasing pitch, and the other in slightly decreasing pitch, for battery chargers. The Examining Attorney found that these two sounds were not, as Powermat claimed,

inherently distinctive, and therefore they failed to function as a trademark. The Board observed that, in some circumstances, a sound may function as a mark. Sounds emitted in the course of a product's ordinary function, however, cannot be inherently distinctive. Powermat's battery chargers emit the ascending tones when an electronic device is placed on the charger, and the descending tones when the device is removed. Powermat did not dispute that its battery chargers emit the sounds in their ordinary course of operation. Therefore its applied-for sound marks are not inherently distinctive. Powermat did not claim acquired distinctiveness, and so its applications to register were silenced by the Board.

g. *In re Pohl-Boskamp GmbH & Co. KG*, 106 USPQ2d 1042 (TTAB 2013). In affirming the PTO's refusals to register "the distinctive flavor of peppermint" and "the scent of peppermint" for pharmaceutical formulations of nitroglycerin, the Board found that both purported marks failed to function as trademarks. (The Section 2(e)(5) functionality refusal of the flavor mark is discussed above). Because flavor and scent marks cannot be inherently distinctive, the issue was acquired distinctiveness. A "substantial showing" is required under Section 2(f) in order to demonstrate that a flavor or scent is registrable. Applicant's evidence of sales and advertising expenditures was equivocal, there was no direct evidence of promotion of the purported marks, and the form declarations from 23 professionals were alone insufficient to satisfy Section 2(f). In contrast, evidence of use of peppermint scent and flavor by others tended to show that flavor and scent were "more likely to be perceived merely as attributes of ingestible products than as indicators of source."

h. *In re Gulf Coast Nutritionals, Inc.*, 106 USPQ2d 1243 (TTAB 2013). The Board affirmed a refusal to register the mark PLAQUE-ZAPPER for "pet products, namely, edible pet treats, pet food and pet beverages," finding that applicant's specimen did not show use of the mark for the identified goods. The specimen described the product as a veterinary dental or health care product rather than a pet treat as Applicant claimed. The Board pointed to *In re Bose Corp.*, 192 USPQ 213, 216 (CCPA 1976) regarding the role of the specimen of use: "[T]he manner in which an applicant has employed the asserted mark, as evidenced by the specimens of record, must be carefully considered in determining whether the asserted mark has been used as a trademark with respect to the goods named in the application." The specimen described an odorless, colorless, and tasteless dental healthcare product that controls plaque. The Board concluded that any reasonable interpretation of the language used on the specimen, including instructions and warnings, pointed to a healthcare product, not a treat. Therefore, registration was properly refused under Sections 1 and 45 of the Trademark Act.

i. *In re Thomas J. Hulting d/b/a No More RINOs! Enterprises*, 107 USPQ2d 1175 (TTAB 2013). The Board affirmed a refusal to register the phrase "No More RINOs!," in standard character form, for bumper stickers, clothing, and campaign buttons, on the ground that the applied-for mark is a merely ornamental or informational political slogan that fails to function as a trademark. The Board observed that "there are certain designations that are inherently incapable of functioning as trademarks to identify and distinguish the source of products in connection with which they are used." Common laudatory phrases ordinarily used in business or in a particular trade or industry are not registrable (e.g., ONCE A MARINE, ALWAYS A MARINE; DRIVE SAFELY; and THINK GREEN). The examining attorney

submitted evidence that “No More RINOs!” is a commonly-used political slogan meaning “No More Republicans In Name Only.” The evidence showed that consumers are accustomed to seeing that phrase on bumper stickers, t-shirts, novelty pins, and other items, from a variety of sources. Consequently, they will not perceive this phrase as a source indicator, but rather as a political message or statement.

j. *In re U.S. Tsubaki, Inc.*, 109 USPQ2d 2009 (TTAB 2014). Once again visiting the “catalog as trademark specimen” issue, the Board affirmed a refusal to register the mark TSUBAKI: THE CHOICE FOR CHAIN for “industrial machine parts, namely, chains and sprockets” on the ground that Applicant Tsubaki failed to provide an acceptable specimen of use. Tsubaki submitted six catalogs in which potential purchasers were invited to call the company phone number to obtain information and place an order. That was not, however, sufficient information to qualify the catalogs as acceptable specimens of trademark use. “Applicant’s catalogs do not have the characteristics that would make a catalog a point-of-sale display (e.g., sales forms, ordering information, minimum quantities, cost, payment plans, shipping, etc.). After reviewing applicant’s catalogs, a customer would have to contact applicant to obtain additional information in order to select a product. Only after obtaining that information would the purchaser be able to make a purchasing decision.” Despite the assertions of Tsubaki’s attorney, there was no evidence that Tsubaki’s industrial chains were typically ordered by telephone following customer review of technical information in the catalogs and consultation with Tsubaki’s employees.

12. Goods in Trade

a. *In re Thomas White Int’l, Ltd.*, 106 USPQ2d 1158 (TTAB 2013). The Board affirmed a refusal to register the mark EMPOWERING THE INVESTOR for “[e]lectronic publications, namely, reports featuring investment management and investment research information, and financial research and equity research information recorded on computer media” in Class 9. The Board agreed with the PTO that the specimen of use comprised a report that is merely incidental to applicant’s own business, investment management services, and did not constitute a good in trade. “The annual report provides advertising for the services, rather than being a product in itself. The report is not sold separately from the services, and the report has no viable existence or independent value separate and apart from the services. The publications are part and parcel of the services.” Consequently, “the specimen is unacceptable to support registration of the mark for the identified goods.”

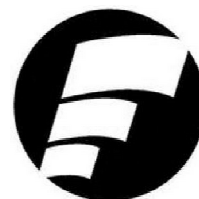
13. Material Alteration of the Mark

a. *In re Guitar Straps Online, LLC*, 103 USPQ2d 1745 (TTAB 2012). The Board affirmed two refusals to register the mark GOT STRAPS for “bumper stickers” and “online retail store services featuring straps,” agreeing with the PTO that the proposed amendment of the mark to add a question mark constitutes a material alteration of the original mark under Trademark Rule 2.72(b)(2), and that the application drawing is not a substantially exact representation of the mark GOT STRAPS? as used on the specimens, under Trademark Rule 2.51(b). It found that the addition of a question mark to GOT STRAPS constitutes a material alteration “because it changes the commercial impression of the original mark from a

declaratory statement to an interrogative phrase.” The Board agreed with the examining attorney that GOT STRAPS? versus GOT STRAPS is equivalent to “do you have guitar straps?” versus “I have guitar straps.”

14. Proper Identification of Goods/Classification

a. *In re Faucher Industries Inc.*, 107 USPQ2d 1355 (TTAB 2013). In this enervating decision, the Board affirmed a refusal to register a stylized “F” design mark for “choke seals” and “choke seals for electric cables,” finding “reasonable and correct” the examining attorney’s requirement that applicant disclose the material composition of its goods so that they could be properly classified. Applicant contended that “choke seals” is the common commercial name of the goods. It offered two sets of amended identifications, including “choke seals, namely, connection fittings for electric junction boxes,” but the PTO requested more information. Classification is an important organizational tool for PTO personnel and for the public. The PTO has discretion in determining the degree of particularity needed for proper classification, but any ambiguity “should be governed by the exercise of reason and in light of the evidence of record.” The PTO requested information regarding the material composition of the goods, since metal seals may be in class 6, non-metal seals in class 17, certain seals may be in classes 7 or 12, and not all goods that are used in connection with electrical systems fall in class 9. The Board concluded that the identifications offered by applicant do not “meet the standards” of the ID Manual, nor do they include sufficient information so that classification of the goods is not “difficult or ambiguous.”



b. *In re Fiat Group Marketing & Corporate Communications S.p.A.*, 109 USPQ2d 1593 (TTAB 2014). Applying the “Ordinary-Meaning Test,” the Board affirmed a refusal to register the mark FIAT 500 for “retail store services and on-line retail store services featuring a wide variety of consumer goods of others,” in International Class 35, on the ground that the proposed wording exceeded the scope of the original recitation of services (“advertising services; business management; business administration; office functions”). Even though the original recitation was identical to the class heading for Class 35, and even though the proposed language itself would fall within Class 35, the Board ruled it was not encompassed by the original recitation of services. Finding no support in the record for Fiat’s assertion that the meaning of the term “business management” includes “operating a retail store,” the Board agreed with the Examining Attorney that the proposed amendment violated Rule 2.71(a) because it improperly broadened the recitation of services. Finally, although some Madrid Protocol countries have adopted a “class heading covers all” policy, “no provision in U.S. law or any obligation by treaty obliges the USPTO to deviate from or make an exception to its longstanding practice governing the scope and interpretation of identifications and in deciding what amendments are permissible.”

15. Effect of Statements Made in File History of Cited Registration

a. *In re Sela Products, LLC*, 107 USPQ2d 1580 (TTAB 2013). In this appeal from two Section 2(d) refusals to register the mark FORZA for metal mounting brackets for

televisions, speakers, and custom audio/video accessories, including cables and wires, Applicant Sela contended that the Board should consider certain statements made in the file history of one of the cited registrations. But there were two problems: Sela never made that file history of record during the prosecution of its own application, and even if it had, the statements were mere opinions submitted in a wholly different context and of no probative value here. [The Section 2(d) refusals are discussed above].

II. *INTER PARTES* CASES

A. United States Court of Appeals for the Federal Circuit

1. Section 2(d) Likelihood of Confusion

a. Likelihood of Confusion Found

i. *Midwestern Pet Foods, Inc. v. Societe Produits de Nestle S.A.*, 103 USPQ2d 1435 (Fed. Cir. 2012). The CAFC affirmed the Board’s decision finding the mark WAGGIN’ STRIPS for pet food and edible pet treats [STRIPS disclaimed] likely to cause confusion with the registered mark BEGGIN’ STRIPS for dog snacks [STRIPS disclaimed]. Circuit Judge Dyk concurred on the Section 2(d) issue but disagreed with the “flawed process” by which the TTAB reached its decision. The Board properly accorded the BEGGIN’ STRIPS mark a broad scope of protection, based on use since 1988 and nationwide advertising, marketing, and sales, concluding that the mark has enjoyed “at least a high degree of recognition.” The two marks at issue have the same format, structure, and syntax, and similar pronunciations, cadences, and intonations. Moreover, “the verbs ‘wag’ and ‘beg’ both suggest dog behavior, and in particular both convey the excitement exhibited by dogs during feeding.” The disagreement between the panel majority and Judge Dyk centered on whether, under the “old” TTAB Rules (*i.e.*, pre-2007), Nestle could rely on certain documents relating to sales and marketing activities that it had not produced during discovery. Judge Dyk would have precluded such reliance, but the panel majority concluded that Midwestern should have moved to compel production.

2. Section 2(e)(1) Mere Descriptiveness

a. *DuoProSS Meditech Corp. v. Inviro Medical Devices Ltd.*, 103 USPQ2d 1753 (Fed. Cir. 2012). The CAFC reversed the Board’s ruling that appellant DuoProSS had failed to prove mere descriptiveness with regard to Inviro’s registered marks SNAP & Design (shown here) and SNAP SIMPLY SAFER for syringes. The court concluded that the Board did not consider the design mark as a whole, failed to make adequate findings of fact, and erroneously ruled that “puffing could render the marks more than descriptive.” As to the first mark, the court asserted that “the only reasonable inference is that a consumer would perceive the mark, in the context of the goods, as depicting the snapping of a plunger.” As to the second mark, the Board erred as a matter of law when it deemed the phrase more than descriptive because SIMPLY SAFER is a laudatory phrase or puffery, the court observing that “adding SIMPLY SAFER to SNAP does nothing more than laud the safety of Inviro’s products, which ... is a merely descriptive use.”

The logo for the SNAP & Design mark, featuring the word "Snap!" in a bold, black, sans-serif font. The exclamation point is stylized with a small arrowhead pointing upwards and to the right.

3. Goods in Trade

a. *Lens.com, Inc. v. 1-800 Contacts, Inc.*, 103 USPQ2d 1672 (Fed. Cir. 2012). The CAFC affirmed the decision of the TTAB summarily cancelling a registration for the mark LENS for “computer software featuring programs used for electronic ordering of contact lenses” on the ground that “software is merely incidental to [Lens.com’s] retail sale of contact lenses, and is not a ‘good in trade.’” The question was whether consumers associate the mark LENS with software as opposed to services, “a factual determination that must be conducted on a case-by-case basis.” Lens.com’s software was merely the conduit through which it rendered its online retail services, and while the software may enhance the overall consumer experience, there was no evidence that it has any independent value apart from its role in rendering the services. And there was no evidence indicating that “consumers have any reason to be aware of any connection between the LENS mark and Lens.com’s software.” Therefore, since Lens.com had not actually used the mark in connection with software for a period of three consecutive years, the mark was properly deemed abandoned and the Board’s ruling was correct.

4. Collateral Estoppel

a. *Stephen Slesinger, Inc. v. Disney Enterprises, Inc.*, 105 USPQ2d 1472 (Fed. Cir. 2012). A divided CAFC panel affirmed the TTAB’s entry of summary judgment in a consolidated proceeding involving trademark rights in various Winnie-the-Pooh marks. The Board had ruled that, in view of a prior district court decision, collateral estoppel barred SSI from re-litigating the issue of ownership, and that absent ownership, SSI’s claims for likelihood of confusion, dilution, and fraud must fail. The CAFC panel majority found that the identical issue of ownership was fully litigated and decided by the district court, that the prior action necessarily required determination of that issue, and that SSI was fully represented by counsel. The dissenting judge concluded that the court had not decided whether Disney was the owner of the marks or merely a licensee, each being a possible basis for the court’s finding of non-infringement.

b. *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 107 USPQ2d 1167 (Fed. Cir. 2013). The CAFC reversed a TTAB decision that had dismissed, on the ground of issue preclusion, an opposition and a cancellation proceeding brought by Levi Strauss over a stitching design created by Abercrombie & Fitch. After the TTAB proceedings were commenced, Levi sued Abercrombie for trademark infringement and dilution. In 2009, both claims were dismissed in separate judgments, but the dilution ruling was later overturned by the Ninth Circuit Court of Appeals, and in 2011 Levi opted to dismiss that claim. The TTAB held that claim preclusion was inapplicable because of the “significant differences” between the facts required to establish infringement in court, and those required for cancellation at the TTAB. However, the Board entered summary judgment on the issue preclusion ground. The CAFC partly agreed with the TTAB, ruling that neither issue preclusion nor claim preclusion was applicable to the TTAB proceedings, primarily due to the different legal standards and factual inquiries.

B. Trademark Trial and Appeal Board

1. Section 2(d) Likelihood of Confusion

a. Likelihood of Confusion Found

i. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424 (TTAB 2013). The Board sustained a Section 2(d) opposition to registration of the word-and-design mark shown here [LIGHT disclaimed], for bottled water (and other related goods), finding a likelihood of confusion with the registered marks GOTT and JOEL GOTT for wine. Marketplace evidence and third-party registrations demonstrated that wine and water are of the type of goods that may emanate from a single source. The Board viewed the design portion of applicant's mark as "insignificant background elements," and concluded that "applicant has essentially appropriated registrant's mark GOTT without adding any other distinguishing features." The Board found applicant's mark and the mark GOTT to be similar in sight, sound, meaning, and commercial impression. The inclusion of the first name JOEL in opposer's other mark merely underscores the fact that GOTT connotes a person's name.



ii. *Weider Publications, LLC v. D & D Beauty Care Company, LLC*, 109 USPQ2d 1347 (TTAB 2014). The fame of the registered mark SHAPE for print and online magazines and for related online Internet content weighed heavily in opposer Weider's favor in its opposition to registration of the mark SHAPES for beauty salon, nail care, and health spa services. The Board sustained the opposition on the likelihood of confusion ground, declining to reach opposer's dilution-by-blurring claim. Opposer's SHAPE magazine focuses on health, fitness, beauty, and fashion, and applicant D&D's typical customers are, not surprisingly, women. The Board deemed helpful its decision in *The Conde Nast Publications Inc. v. Vogue Travel*, 205 USPQ 579 (TTAB 1979), wherein it found a likelihood of confusion between Conde Nast's magazine trademark VOGUE and the identical mark for travel agency services, based on the fact that the topic of travel was a significant feature of the magazine. The Board observed that the "logical underpinnings of *Conde Nast* are equally, if not more relevant in the digital age with the delivery of magazines now available via websites and mobile apps." It therefore found a close relationship between the content of SHAPE magazine and the services identified by applicant.

b. Likelihood of Confusion Not Found

i. *Syndicat Des Proprietaires Viticulteurs De Chateaufeuf-Du-Pape v. Pasquier DesVignes*, 107 USPQ2d 1930 (TTAB 2013). Deeming the first *duPont* factor to be dispositive, the Board dismissed this opposition to registration of the mark CHEMIN DES PAPES for "wines, sparkling wines, distilled spirits and liquors," finding the mark not likely to cause confusion with the registered mark CHATEAUNEUF-DU-PAPE CONTRÔLÉ & Design for wine. Furthermore, in a significant ruling, the Board held that the opposed application was not void in its entirety



due to applicant's (admitted) lack of *bona fide* intent to use the mark on "distilled spirits and liquors," citing *The Wet Seal, Inc. v. FD Management, Inc.*, 82 USPQ2d 1629 (TTAB 2007). Opposer claimed rights in the word mark or designation CHATEAUNEUF-DU-PAPE but the Board concluded that the evidence failed to establish that this term is a common law regional certification mark for wine, or that opposer is the rightful owner of that mark. As to the registered mark, the Board recognized that the involved goods are identical and the presumed channels of trade and classes of consumers the same, but it found the dissimilarity between the marks to be dispositive. However, the Board ordered that "distilled spirits and liquors" be deleted from the opposed application.

ii. *The Board of Trustees of The University of Alabama and Paul W. Bryant, Jr. v. William Pitts, Jr. and Christopher Blackburn*, 107 USPQ2d 2001 (TTAB 2013). In a 78-page opinion, the Board dismissed this opposition to registration of the mark depicted here for "shirts, caps" [HOUNDSTOOTH disclaimed], denying opposers' claims of likelihood of confusion under Section 2(d), and false suggestion of a connection and disparagement, both under Section 2(a). Opposers based their opposition principally on the alleged extensive use of a houndstooth pattern that identifies Coach Paul "Bear" Bryant and the University of Alabama's goods and educational and athletic services. Likelihood of Confusion: Although Coach Bryant was recognized for wearing patterned fedoras at the University's football games, that fact "does not endow either Coach Bryant (including his estate) or the University with trademark rights in the Houndstooth Pattern." False Suggestion of a Connection: The Board focused on the "key factor" in the Section 2(a) false suggestion analysis: "whether applicants' mark is a close approximation of opposers' name or identity..." The Board found no basis for concluding that applicants' mark closely approximates that identity of Bryant or the university. Disparagement: Opposers contended that the mark is disparaging and brings them into contempt and disrepute because "mafia" refers to a criminal organization, but the Board disagreed.



2. Section 2(e)(1) Mere Descriptiveness

a. *Baroness Small Estates, Inc. v. American Wine Trade, Inc.*, 104 USPQ2d 1224 (TTAB 2012). The Board dismissed a two-pronged petition for cancellation of a registration for the mark CMS, in stylized form, finding the mark to be neither generic for, nor merely descriptive of, wine. As to mere descriptiveness, there was no question that CMS was derived from the initials of the varietals that make up respondent's wine. However, there was no evidence that "C" is a recognized abbreviation for "cabernet sauvignon," or "M" for "merlot," or "S" for "syrah." In fact, the evidence showed that the mark CMS does not directly and immediately convey the meaning of the three varietals. "The authors of the various articles and reviews and sales information believed that they needed to spell out the connection between CMS and the names of the varietals that are contained in the wine, and that readers would not immediately understand that the mark CMS has the meaning of cabernet sauvignon, merlot, syrah. *** [T]he process of recognizing that derivation requires some thought, and that is the very essence of a suggestive mark."

b. *ChaCha Search, Inc. v. Grape Technology Group, Inc.*, 105 USPQ2d 1298 (TTAB 2012). Grape Technology was squashed by ChaCha in this combined opposition/cancellation proceeding. The Board granted ChaCha's summary judgment motion seeking a ruling that its registered mark 242242 is not merely descriptive of "[p]roviding search engine services for obtaining specific user-requested information via text messaging, instant messaging, mobile internet, voice messaging, and wireless devices." It found no genuine dispute that the mark 242242 does not identify an ingredient, quality, characteristic, function, feature, purpose, or use of ChaCha's recited services. Grape's assertion that "the fact that ... marks are presented as telephone numbers gives rise to an inference that they are functional and descriptive" lacked any support and, the Board found, was "incorrect."

c. *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750 (TTAB 2013). The Board granted a petition for cancellation of a registration for ANNAPOLIS TOURS for "conducting guided tours of historic districts and other areas of cities," finding the mark to be merely descriptive and lacking in acquired distinctiveness. The Board dismissed petitioner's claims of genericness and fraud, but ruled that petitioner had met its ultimate burden to show that the mark is merely descriptive. As to genericness, the record was mixed with generic use and trademark use. The fraud claim failed because, even if respondent's statements as to continuous and exclusive use were false, its president believed them to be true based on her own observations. As to mere descriptiveness, the Board found that petitioner had demonstrated that the subject mark is "highly descriptive," and that, because respondent relied only on a statement of five-years of use, petitioner had satisfied its initial burden of making a *prima facie* showing of lack of acquired distinctiveness. The burden then shifted to respondent to "now prove acquired distinctiveness based on any 'additional evidence or argument' ..., keeping in mind that petitioner bears the ultimate burden of proof by a preponderance of the evidence." The Board found respondent's evidence insufficient and concluded that petitioner met its evidentiary burden.

3. Section 2(e)(4) Primarily Merely a Surname

a. *Miller v. Miller*, 105 USPQ2d 1615 (TTAB 2013). The Board sustained an opposition to MILLER LAW GROUP for legal services [LAW GROUP disclaimed], finding the alleged mark to be primarily merely a surname under Section 2(e)(4), and lacking in acquired distinctiveness. The evidence was overwhelming that the primary significance of "Miller" to the relevant public is that of a surname. The addition of the phrase LAW GROUP did not change the mark's primary significance. As to acquired distinctiveness, applicant proved use of the applied-for mark since 1998, with growing revenues and tens of thousands of dollars spent on marketing. However, she failed to establish that her use of MILLER was substantially exclusive as required by Section 2(f). Opposer used the mark MILLER LAW GROUP, P.C. since 2007, and at least seven third-parties were using MILLER in connection with legal services. Moreover the State Bar of California included 274 active attorneys with the surname MILLER, and San Francisco alone had 68. With MILLER being the sixth most common surname in the country, "it is reasonable to assume that there are additional legal practitioners that use MILLER in connection with legal services, and that the record only reflects a small sampling of those users."

4. Dilution by Blurring

a. *Academy of Motion Picture Arts and Sciences v. Alliance of Professionals & Consultants, Inc.*, 104 USPQ2d 1234 (TTAB 2012). In a case of first impression, the Board granted respondent APC's Rule 12(b)(6) motion to dismiss cancellation petitioner Motion Picture Academy's claim for dilution-by-blurring, on the ground that Section 43(c)(6) provides a "complete bar" to a dilution claim against a federal registration. Although the parties and commentators agreed that a "clerical error" was made during passage of the Trademark Dilution Revision Act (TDRA) in 2006, the Board applied the statute as written, finding insufficient basis in the legislative history to justify an alternative reading of the statutory language. The Board found no cases raising this issue in the federal courts or before the Board; the fact that the Board has entertained dilution claims in other cancellation proceedings was "not persuasive." (On October 5, 2012, the President signed into law "An Act to amend the Trademark Act of 1946 to correct an error in the provisions relating to remedies for dilution," to eliminate the "federal registration defense." However, the corrected version of Section 43(c), by its terms, is not retroactive; it applies only to actions commenced on or after October 5, 2012. *See Under Armour, Inc. v. Evade, LLC*, Cancellation No. 92052716 (February 14, 2013) [not precedential].

5. Fraud

a. *Caymus Vineyards v. Caymus Medical, Inc.*, 107 USPQ2d 1519 (TTAB 2013). The Board denied opposer's motion to dismiss applicant's counterclaim for cancellation of a registration for the mark CAYMUS for wine, on the ground of fraud, ruling that applicant's pleading was adequate to state a claim. However, the Board granted opposer's motion to dismiss applicant's second counterclaim, which was based on Section 2(e)(2) geographic descriptiveness, because it was barred by the 5-year statute of limitations embodied in Section 14 of the Trademark Act. As to fraud, the examining attorney had asked opposer, when an applicant, whether CAYMUS had "any geographical significance or any meaning in a foreign language." Applicant alleged that opposer knowingly, and with deceptive intent, failed to disclose that CAYMUS "had primarily geographic significance, and that its grapes are grown and/or its wine is produced near or at the Caymus locale." Opposer maintained that "CAYMUS" has no geographic, but only historical and cultural significance, but the Board pointed out that this was irrelevant to whether applicant had properly stated a claim of fraud. Instead, it constituted a response on the substantive issue. With regard to applicant's Section 2(e)(2) counterclaim: applicant maintained that because of opposer's fraud, the Section 14 bar to cancellation should not apply to its claim of geographic descriptiveness. The Board disagreed.

6. Lack of *Bona Fide* Intent

a. *Swatch AG v. M.Z. Berger & Co.*, 108 USPQ2d 1463 (TTAB 2013). The Board sustained an opposition to registration of the mark IWATCH for watches, clocks, and parts thereof, finding that applicant lacked the requisite *bona fide* intent to use the mark in commerce in connection with its identified goods. The Board concluded that applicant filed its application merely in order to reserve a right in the mark in case it developed a product at some future time. "[A]pplicant's idea was to use the IWATCH mark only in association with a 'smart watch.'" But applicant had never previously offered a watch incorporating such technological features, and it made no plans for developing or sourcing such a watch at any time before or

within fifteen months after filing its application. The Board, however, dismissed opposer's Section 2(d) claim based on its famous mark SWATCH for identical goods. Despite the overlap in goods, the presumed identity of channels of trade and classes of consumers, and the fame of opposer's SWATCH mark, the Board found the first *duPont* factor to be dispositive because the involved marks differ significantly in sound, meaning, and overall commercial impression. [This decision was upheld by the U.S. District Court for the Eastern District of Virginia, and then by the U.S. Court of Appeals for the Fourth Circuit. *See Swatch AG v. Beehive Wholesale, L.L.C.*, 109 USPQ2d 1291 (4th Cir. 2014)].

b. *Lincoln National Corporation v. Anderson*, 110 USPQ2d 1271 (TTAB 2014). The Board sustained two oppositions to registration of the mark FUTURE, in standard character and stylized forms, for various services in classes 35 and 36, finding that applicant Kent G. Anderson lacked a *bona fide* intention to use the marks with the services as of the filing date of the applications. The class 36 services related to banking and finance, while the class 35 recitation encompassed services ranging from shopping malls and aircraft dealerships to talent agencies and dog breeding. In its 46-page decision, the Board concluded that Anderson was “merely attempting to reserve a general right in his FUTURE mark when he filed his intent-to-use applications.” His “idealistic hopes for forming a futuristic company” did not suffice to establish a *bona fide* intention to use the mark. The legislative history of Section 1(b) supported the Board's finding: it provides as an example of objective evidence that may cast doubt on an applicant's *bona fides*, the filing of “an excessive number of intent-to-use applications in relation to the number of products the applicant is likely to introduce.” Although Anderson filed for many classes in each of the two applications here opposed, rather than filing a multiplicity of applications, the same reasoning applied.

7. Non-use

a. *The Clorox Company v. Salazar*, 108 USPQ2d 1063 (TTAB 2013). The Board granted Clorox's motion for summary judgment in this opposition to registration of the mark CLOROTEC & Design for “electronic equipment, namely, electrolysis cell for use in the manufacture of various ionic solutions,” finding that applicant did not make a *bona fide* use of the mark in commerce on the identified goods prior to filing his use-based application. The application therefore was declared void *ab initio*. Applicant Hermilo Tamez Salazar admitted, in his interrogatory answers and in a declaration, that he had not used the mark on any product sold in the United States and had not shipped any product into the United States. He contended, however, that it would be inequitable and inconsistent with Congressional intent to require a sale of his product when he sells fewer than one per year, on average, at prices ranging from two hundred thousand dollars to two million dollars or more, or to require transportation of a one-ton piece of machinery that is custom made. The Board observed that Salazar's position conflicts with the statutory definition of “use in commerce,” and that Salazar failed to cite any supporting authority for his theory.



8. Genericness

a. *Baroness Small Estates, Inc. v. American Wine Trade, Inc.*, 104 USPQ2d 1224 (TTAB 2012). As to the second prong of this decision (mere descriptiveness is discussed above), the Board dismissed petitioner's claim that the mark CMS (in stylized form) is generic for wine. There was no question that the term CMS was derived from the initials of the varieties that make up respondent's wine: namely, cabernet sauvignon, merlot, and syrah. "However, the fact that a term is derived from individual generic words or even a listing of generic words does not necessarily make the derived term generic. Nor does the fact that one can figure out the derivation of a term by seeing it in the context of the generic words make that term generic." The Board concluded that petitioner had failed to prove that the consuming public perceives the term CMS as generic for wine.

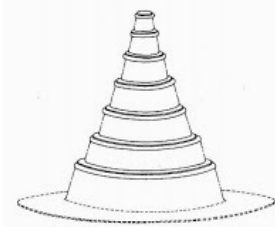
b. *Sheetz of Delaware, Inc. v. Doctor's Associates Inc.*, 108 USPQ2d 1341 (TTAB 2013). The Board sustained an opposition to registration of FOOTLONG for "sandwiches, excluding hot dogs," finding the term to be generic, and if not generic, then merely descriptive and lacking in acquired distinctiveness. Opposer introduced many examples of third-party use of "footlong" to identify sandwiches. Applicant's "Teflon" survey failed to pass ~~mustard~~ muster, while opposer's rebuttal survey supported the Board's view that applicant's survey had little probative value. The Board concluded that "Footlong" identifies a type or category of sandwich that includes 12-inch sandwiches and is generic for "sandwiches, excluding hot dogs." For purposes of completeness, and assuming *arguendo* that "footlong" is highly descriptive but not generic, the Board considered whether the term has acquired distinctiveness. Opposer Sheetz had the initial burden to show that "Footlong" has not acquired distinctiveness, but the ultimate burden of persuasion rested on applicant. Applicant submitted evidence of extensive sales and advertising, alleged copying of the FOOTLONG designation by Sheetz, unsolicited media coverage, and its survey results. The Board observed that, although applicant has achieved great commercial success, such success is not necessarily indicative of acquired distinctiveness. Moreover, widespread use of "footlong" by third parties would itself be sufficient to dispose of the claim of acquired distinctiveness.

c. *Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 109 USPQ2d 1949 (TTAB 2014). In this consolidated opposition and cancellation proceeding, the Board found the designation PRETZEL CRISPS to be generic for "pretzel crackers" [PRETZEL disclaimed]. The Board gave controlling weight to dictionary definitions of the constituent words, evidence of use by the public, including use by the media and by third-parties in the food industry, and applicant Princeton Vanguard's own use of the term. There was no dispute that the genus of goods was adequately defined as "pretzel crackers." The question, then, was whether the relevant public - ordinary consumers who purchase and eat pretzel crackers - understands the term "pretzel crisps" to refer primarily to the genus of goods. The Board found that when "pretzel" and "crisps" are combined, no additional meaning results, so the purported mark may be analyzed via its constituent terms in accordance with *In re Gould*, using "the ordinary grammatical construction." Each party submitted the results of a "Teflon" survey, but the Board accorded them little significance in its decision. Frito-Lay's survey was flawed because the survey expert did not conduct a "mini-test" to make sure that his survey respondents understood the difference between a brand name and a common (or category) name.

9. Functionality

a. Utilitarian Functionality

i. *AS Holdings, Inc. v. H & C Milcor, Inc., f/k/a Aquatico of Texas, Inc.*, 107 USPQ2d 1829 (TTAB 2013). H & C Milcor sought to register the product configuration mark shown here for “pipe flashing for use in sealing openings for pipe,” but AS Holdings opposed on the grounds of *de jure* functionality under Section 2(e)(5) and, in the alternative, lack of acquired distinctiveness. In a relatively



straightforward but instructive ruling, the Board sustained the opposition on both grounds. The Board applied the CCPA’s *Morton-Norwich* analysis, finding that the patent evidence disclosed the utility of various features of the design, and that applicant’s own advertising “extols specific utilitarian advantages of the applied-for design and is strong evidence that the matter sought to be registered is functional.”

The Board concluded that the overall design of applicant’s pipe boot is dictated by utilitarian concerns and is therefore unregistrable. For the sake of completeness, the Board considered opposer’s Section 2(f) claim, concluding that applicant failed to overcome the evidence submitted by opposer. Applicant’s sales and advertising figures were devoid of context, were not limited to the subject pipe boot, and in any case were relatively modest. Moreover, there was no evidence of “look for” advertising that pointed to any unique design features.

10. Assignment in Violation of Section 10

a. *Central Garden & Pet Company v. Dorskocil Manufacturing Company, Inc.*, 108 USPQ2d 1134 (TTAB 2013). In these complicated proceedings, Central Garden opposed Dorskocil’s applications to register PETZILLA and DOGZILLA & Design, and petitioned to cancel Dorskocil’s registration for DOGZILLA in standard character form, for pet toys, claiming priority and likelihood of confusion with its twice-registered mark ZILLA for pet food and pet treats. The Board granted Defendant Dorskocil’s first counterclaim for cancellation (improper assignment), dismissed its second counterclaim (likelihood of confusion), and dismissed Central’s oppositions and petition for cancellation (lack of priority). Central’s priority claim was based on the filing date of its intent-to-use application for ZILLA, but the Board concluded that the assignment of the application to Central’s grandparent company violated Section 10 and therefore the registration must be cancelled. With that, Central’s three likelihood of confusion claims failed. Dorskocil’s Section 2(d) counterclaim against Central’s ‘833 registration was a perfunctory, hypothetical claim and Dorskocil argued at length that confusion was not likely, so the Board chose to “leave the parties as we found them, without reaching the merits of either party’s claim.”



11. Concurrent Use

a. *America’s Best Franchising, Inc. v. Abbott*, 106 USPQ2d 1540 (TTAB 2013). The Board awarded junior user ABF concurrent use registrations for three marks for hotel and motel services, in the entire United States except for the State of Arizona. The Board

ruled that although Roger Abbott was the first user of the mark 3 PALMS, there is a policy of rewarding those who first seek registration under the Lanham Act, and there is “no bias in favor of the prior user.” Abbott’s inaction over a considerable time amounted to an abandonment of his right to expand beyond his original trading area, “especially since ABF was the first to seek federal registration.” Abbott licensed his 3 PALMS mark only to a single hotel in Scottsdale, Arizona, but he contended that Internet marketing had necessarily expanded his territory nationwide, or at least significantly beyond Arizona. Abbott first used his 3 PALMS mark in April 2004, whereas ABF began use in 2008 in Florida, unaware of Abbott’s use. It first learned of Abbott’s use in mid-2008, and subsequently reached service agreements with hotels in Indiana, South Carolina, Georgia, Michigan, and California. The question was whether confusion may be avoided by a geographic restriction, and the Board answered yes. It found that PALMS is a weak formative and that the localized nature of hotel services would make confusion unlikely between hotels in different locations. The fact that both parties advertise online is not enough to result in a likelihood of confusion.



b. *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473 (TTAB 2014). The Board ruled that Defendant Trilobite, Ltd. was entitled to an unrestricted federal registration for its mark TRILOBITE for audio and video recording and production services. The concurrent use application of Peter Turdin, Jr., seeking a registration of TRILOBITE PICTURES for “motion picture film production, and animation services,” restricted to New York City and Connecticut, was refused because Turdin was unable to establish that there was no likelihood of confusion if the involved marks were concurrently used in these two areas. Although Defendant had never rendered its services in New York City, the Board relied on *First Niagara* in awarding priority to Defendant based on its business contacts in Gotham. As for Connecticut, the Board applied the *Weiner King* factors in ruling in favor of Defendant. Although there was no evidence that Trilobite had previous business activity in Connecticut, and no evidence of any significant business in states contiguous to Connecticut (other than in New York City), its president testified that there is “quite an overlap of people who live in the Connecticut area and work in New York....” Consequently, Plaintiff Turdin failed to persuade the Board that confusion is not likely “if Turdin is granted Connecticut as part of his concurrent use territory.”

12. Goods in Trade

a. *City National Bank v. OPGI Management GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668 (TTAB 2013). The Board sustained a petition for cancellation of OPGI’s registration (issued under Section 44(e)) for the service mark TREASURYNET for “providing information on financial information, namely corporate treasury and loan information and commercial real estate property management information via a global computer network,” finding that OPGI had used the mark only internally and not “in commerce” and therefore had abandoned the mark. OPGI owns an intranet website whereby its employees may access an informational database identified as “TreasuryNet.” Third parties cannot directly access the information in the TREASURYNET database. OPGI relied on several decisions in which the

provision of services to employees (administration of an annuity plan, in-house sales training) was deemed to be use of a `mark in interstate commerce. The Board, however, pointed out that OPGI “is the real beneficiary and not its employees who are accessing the TREASURYNET database in order to perform their jobs.” The Board concluded that OPGI did not use TREASURYNET in commerce since at least the date of issuance of its registration, February 20, 2007, resulting in more than three years of nonuse and establishing a *prima facie* case of abandonment, which OPGI did not successfully rebut.

13. Procedural Issues

a. Proper Service of Initial Pleading

i. *Musical Directions v. McHugh*, 104 USPQ 1157 (TTAB 2012). In this procedural kerfuffle, the Board denied Applicant Norman W. McHugh’s motion seeking dismissal of this opposition due to lack of proper service of the Notice of Opposition. The Board found that Opposer Musical Directions complied with the applicable rule when it served the Notice by certified mail (returned as undeliverable) – albeit five days after filing the Notice with the Board – and that the error made by opposer on the ESTTA cover sheet – saying that service had been made by fax or email – was harmless. Although opposer should have notified the Board when the Notice was returned, Applicant McHugh’s attorney was in fact aware of the Notice via an email sent to McHugh four days after the filing, and so no harm was suffered by McHugh in not receiving the mailed copy.

b. Stipulated Service by email

i. *McDonald’s Corporation v. Cambridge Overseas Development Inc.*, 106 USPQ2d 1339 (TTAB 2013). The parties to this opposition proceeding filed a stipulation to accept service by e-mail while retaining the five additional days afforded by Rule 2.119(c) for filing and/or serving responsive documents, and applicable to service by first-class mail. No can do, said the Board, and it rejected the stipulation. Rule 2.119(b)(6) allows service of papers by electronic transmission when the parties so agree. But they cannot also take advantage of the five-extra-days-for-mailing provision of Rule 2.119(c). That five-extra-days rule applies only to service by first-class mail, Express Mail, or overnight courier. *See* Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42442, 42250 (August 1, 2007) (“as for agreed use by parties of e-mail or fax for forwarding service copies, the office confirms that Section 2.119(c) would not apply to service by electronic transmission (email or fax) under Section 2.119(b)(6)”). The Board pointed out that a stipulation such as that filed here would run afoul of Rule 2.127, which states that the time for filing reply briefs and motions under FRCP 56(d) “will not be extended.” The Board noted that the parties could stipulate that they would accept service by first-class mail but with a courtesy e-mail copy sent simultaneously. Then the five-extra-days-for-mailing would apply.

c. Section 14 Partial Abandonment versus Section 18 Modification

i. *Johnson & Johnson v. Obschestvo s Ogranitchennoy; Otvetstvennosti WDS*, 104 USPQ2d 2037 (TTAB 2012). In another procedural skirmish,

petitioner J&J moved to dismiss applicant OsO's counterclaim for partial cancellation of a registration on the ground of abandonment as to some of the identified goods. Applicant invoked Section 18 in its counterclaim; J&J argued that the counterclaim lacked the necessary allegation that the cancellation would avoid a likelihood of confusion. The Board ruled that Section 18 does not apply at all, and that this "straightforward" counterclaim for partial abandonment falls under Section 14. A counterclaim for partial abandonment "does not require any reference to avoidance of a likelihood of confusion." Such an allegation is needed, under *Eurostar, Inc. v. "Euro-Star" Reitmoden GmbH*, 34 USPQ2d 1266, 1271 n.3 (TTAB 1994), only when the claimant seeks to modify or restrict the identification of goods or services, and not when, as here, a party seeks to have discrete goods or services deleted on a theory of abandonment.

d. Section 18 Rectification of a Color Registration

i. *Covidien LP v. Masimo Corporation*, 109 USPQ2d 1696 (TTAB 2014). In a case of first impression, the Board denied respondent Masimo's Rule 12(b)(6) motion to dismiss this cancellation proceeding, ruling that a petition for restriction under Section 18 of the Trademark Act is a proper vehicle for restricting a registration of a color mark to a particular shade. Covidien's application to register the color pink (Pantone PMS 806) for medical connectors and lead wires, was refused under Section 2(d) in view of Masimo's Supplemental registration for the color "red" for patient monitoring sensors and cables. Covidien then filed a petition under Section 18 to restrict the cited registration to the particular shade of red (Pantone PMS185) actually used by Masimo. Covidien alleged that such a restriction would avoid a likelihood of confusion. Masimo moved to dismiss under FRCP 12(b)(6), urging that such a restriction is permitted only when the description of the mark is "ambiguous or overly broad," citing *Wellcome Foundation Ltd. v. Merck & Co.*, 46 USPQ2d 1478 (TTAB 1998). The Board, however, "also reads § 18 as allowing for, and thus encompassing, relief where a plaintiff alleges that a feature of the description of the mark renders the description not specific to the mark actually used by the defendant." The Board refused to dismiss Covidien's petition, but required Covidien to set forth a more definite statement as to the color of its mark, in ordinary language.

e. Rule 2.133 Amendment of an Opposed Application

i. *Embarcadero Technologies, Inc. v. R Studio, Inc.*, 105 USPQ2d 1825 (TTAB 2013). Prior to the close of discovery in this Section 2(d) opposition, Applicant RStudio moved under Rule 2.133 and Section 18 to narrow the descriptions of its software and related services in the opposed applications "in the event that the Board deems such amendments necessary to dismiss the opposition." Applicant applied to register the mark RSTUDIO for goods and services identified in fairly broad terms, encompassing all types of statistical software and application development software, as well as training and design and development services. Its motion aimed to restrict the applications to the field of "advanced" statistical software using the "R" computer language and data from two dimensional datasets. Embarcadero alleged likelihood of confusion with its registered mark ER/STUDIO for "entity relationship modeling software for SQL databases." The Board deferred ruling on the motion until final decision, ultimately finding that, taking into account applicant's proposed amendments, there was no

significant relationship between applicant's software and services, as amended, and opposer's software, and so it dismissed the opposition.

ii. *Johnson & Johnson v. Stryker Corporation*, 109 USPQ2d 1077 (TTAB 2013). Stryker Corporation filed an intent-to-use application to register the mark MICROFX, for "surgical instruments." Johnson & Johnson opposed, alleging likelihood of confusion with its registered mark MICROFIX for "suture anchors." Prior to trial, Stryker filed a motion under Rule 2.133, without opposer's consent, to amend its identification of goods to read: "surgical instruments, namely osteochondral drills, drill guides, and curettes used to create microfracture holes." The Board looked to the three elements necessary to support the motion. The first and third requirements were satisfied because the proposed amendment would narrow the identification, and the narrowing of the category of users would restrict the channels of trade and the prospective customer base, creating a substantially different issue for trial. The crucial question was whether Stryker unconditionally stated its willingness to accept judgment as to the broader range of goods. The Board found that Stryker had expressed a position "that if the specified condition precedent - that its amendment be immediately accepted - occurs, then applicant will immediately accept judgment against it on the broader range of goods." Concluding that the second condition was satisfied, the Board entered judgment "with respect to the mark as applied to all goods encompassed by the broader description 'surgical instruments,' except as for the goods identified by the amended identification." Proceedings were resumed as to the amended identification.

f. Cancellation of a Madrid Protocol Extension of Protection

i. *SaddleSprings, Inc. v. Mad Croc Brands, Inc.*, 104 USPQ2d 1948 (TTAB 2012). The Board denied respondent's Rule 12(b)(6) motion to dismiss this petition for cancellation of a Section 66(a) registration (a/k/a Madrid Protocol extension of protection). Petitioner alleged that the subject mark had been abandoned, but respondent asserted that because the corresponding International Registration is still viable, the U.S. registration cannot be cancelled under Section 14. Respondent contended that its registration is subject to Section 71 of the Trademark Act, 15 U.S.C. Section 1141k, which states that "an extension of protection remains in force for the term of the international registration, except that the Director may cancel the extension if the affidavit required by Section 1141k is not timely filed." Consequently, according to respondent, the Director has no authority to cancel its registration prior to expiration of the grace period for filing a declaration or affidavit of use - *i.e.*, prior to six years and six months after the registration issued on February 20, 2007. The Board, however, ruled that "an owner of a Section 66(a) registration is subject to the same treatment and conditions which prevail in connection with any other registrant. *** [T]his includes the possibility that the registration may be cancelled on any available ground under Section 14 of the Trademark Act, 15 U.S.C. § 1064."

g. Accelerated Case Resolution (ACR)

i. *Chanel, Inc. v. Makarczyk*, 106 USPQ2d 1774 (TTAB 2013). The parties to this opposition opted for the Board's Accelerated Case Resolution (ACR) procedure,

agreeing to forgo discovery, expert testimony, trial, and oral hearing. The Board approved their stipulation that the Board may resolve genuine issues of fact and issue a final ruling based on their submissions: *i.e.*, briefs and declarations or affidavits. Applicant Jerzy Makarczyk, appearing *pro se*, applied to register the mark CHANEL for “real estate development and construction of commercial, residential and hotel property.” Chanel, Inc. opposed on the grounds of likelihood of confusion, false suggestion of a connection (Section 2(a)), and dilution, relying on a number of registrations for the mark CHANEL for cosmetics, toiletries, etc. In addition to streamlining the procedure, the parties stipulated to a number of facts. The Board set a briefing schedule, and stated that it would “endeavor to issue a decision on the merits within 50 days of the due date for opposer’s rebuttal brief.”

h. Assignability of Extension of Time to Opposer

i. *Renaissance Rialto Inc. v. Boyd*, 107 USPQ2d 1083 (TTAB 2013).

The Board dismissed this opposition for lack of jurisdiction because the notice of opposition was filed too late. Opposer claimed the benefit of an extension of time to oppose that was obtained by a third-party, Lakeside Cinema, who had entered into a “Transfer Agreement” with opposer. The Board, however, ruled that opposer failed to show that Lakeside used the mark that it purported to transfer or that opposer and Lakeside were in the position of parent-subsidiary, licensor-licensee, or any other relationship of privity. Under Rule 2.102(b), the party filing an opposition during an extended period for filing must have obtained the extension of time in its own name or must be in privity with the person that obtained the extension of time. The concept of “privity” includes, among other things, the relationship of successive ownership of a mark. The Board looked to the Transfer Agreement to see whether Lakeside effectively transferred its right to oppose (and the benefit of the extension of time to do so). The Transfer Agreement assigned to opposer any right that Lakeside might have to use the name RIALTO CINEMAS, as well as its right to oppose the subject application. The Board, however, found it “not at all clear” from the agreement that Lakeside ever used the mark or had any goodwill therein to transfer to opposer, and the record was devoid of evidence of use of the mark.

i. Board Discretion to Decline to Hear Claim

i. *Multisorb Technologies, Inc. v. Pactiv Corporation*, 109 USPQ2d

1170 (TTAB 2013). Faced with a petition for cancellation of its registration for the mark ACTIVETECH on the grounds of abandonment and fraud, Respondent Pactiv filed a motion consenting to judgment on the abandonment claim, contending that the proceeding should be terminated without judgment on the fraud claim. Petitioner Multisorb opposed the motion, maintaining that respondent must either consent to entry of judgment on the fraud claim or answer the petition and defend its position. The Board observed that whether it allows a proceeding to continue after entry of judgment on one claim, falls within the Board discretion in light of the circumstances of each case. Like the courts, the TTAB has generally invoked its discretion to decide only those claims necessary to enter judgment and dispose of the case. Multisorb maintained that the granting of respondent’s motion would deprive petitioner of the preclusive effect that would result from a judgment on the fraud claim. The Board pointed out, however, that the fraud claim relates only to procurement of the challenged registration, and

would not bar applicant from filing a new application nor permit Multisorb to challenge that new registration on the basis of claim preclusion. And so the Board granted respondent's motion and declined to reach the fraud claim.

j. *Vacatur* due to Mootness

1. *Rolex Watch U.S.A., Inc. v. AFP Imaging Corporation*, 107 USPQ2d 1626 (TTAB 2013). The TTAB vacated its precedential decision in *Rolex Watch U.S.A., Inc. v. AFP Imaging Corporation*, 101 USPQ2d 1188 (TTAB 2011), in which it dismissed Rolex's dilution-by-blurring claim, concluding that opposer had failed to prove that the applied-for mark ROLL-X for "x-ray tables for medical and dental use" would, despite an "actual association" between the marks, impair the distinctiveness of Opposer's famous ROLEX mark. While Rolex's appeal to the CAFC was pending, AFP unilaterally withdrew its application. The CAFC then dismissed the appeal as moot, and remanded. The Board concluded that *U.S. Bancorp* mandated that its decision be vacated. In *U.S. Bancorp*, the Supreme Court held that *vacatur* is appropriate if a decision becomes moot as a result of the unilateral actions of the prevailing party. Here, AFP, the prevailing party, abandoned its application without Rolex's consent. There was no evidence that the appeal was rendered moot by any voluntary action of Rolex, and Rolex objected to AFP's abandonment. AFP argued that it was "forced" to withdraw its application due to the cost of litigation, but the Board found that to be irrelevant. Under the circumstances, the Board entered judgment against AFP under Rule 2.135.

k. Mootness of Cancellation Counterclaim

i. *Delaware Quarries, Inc. v. PlayCore IP Sub, Inc.*, 108 USPQ2d 1331 (TTAB 2013). In an earlier decision, the Board had dismissed the Section 2(d) likelihood of confusion claims of opposer and sustained applicant PlayCore's counterclaim for cancellation of opposer's pleaded registration on the grounds of genericness and, alternatively, mere descriptiveness. Delaware requested reconsideration, contending that once its claims were dismissed, PlayCore lacked standing to pursue its counterclaims. The Board denied the request for reconsideration. The Supreme Court, in *Cardinal Chemical Co. v. Morton Int'l Inc.*, 508 U.S. 83 (1993), made it clear that the issue is one of mootness, not standing. There, the Court ruled that a counterclaim for a declaratory judgment of patent invalidity was not rendered moot when the CAFC affirmed the district court's finding of non-infringement. The Board applied the Court's reasoning here: An applicant/defendant might later face an infringement action to enjoin its use of its mark, and a finding of genericness - even in the narrow context of an opposition proceeding - would undoubtedly be "of interest" to the applicant. In addition, the public has an interest in resolving questions regarding the genericness of a registered trademark.

14. Discovery and Motion Practice

a. Motion for Sanctions for Failure to Attend Discovery Conference

1. *Patagonia, Inc. v. Azzolini*, 109 USPQ2d 1859 (TTAB 2014). When Respondent Joseph Azzolini, appearing *pro se*, failed to attend the mandatory Rule 2.120

discovery conference, the Board issued an order requiring him to show cause why judgment should not be entered against him. Finding Azzolini's arguments and explanations unconvincing, and in view of the "continuing nature of respondent's violations despite multiple prior admonitions," the Board concluded that any sanction short of judgment would be futile and unfair to the petitioner. In June 2012, Patagonia filed a petition for cancellation of Azzolini's registration for the mark EL CAP for clothing. Azzolini ignored several Board orders attempting to move the proceeding forward, did not file his answer until February 2013, and then served it a month later. Patagonia requested that a Board interlocutory attorney participate in a telephonic discovery conference. Azzolini agreed by email to "May 24th Thursday" at 11 AM, the time and date of the conference, but May 24th was a Friday. Azzolini was unreachable and never called. One week later, Azzolini informed the Board that he had traveled to the Poconos, where his phone lost connection; when he came home he realized he had left his phone in the Poconos. The Board's patience had been exhausted. Azzolini had ample notice and an opportunity to be heard but failed to show good cause as to why the sanction of judgment should not be entered.

b. Motion for a Protective Order

i. *The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 USPQ2d 2149 (TTAB 2013). In this Section 2(d) opposition, when The Phillies were served with 507 requests for admission, they cried "foul" and filed a motion for a protective order under FRCP 26(c). They claimed that the sheer number of requests demonstrated that applicant made no effort to seek only proper and relevant discovery, and that the time to be spent and expenses incurred in responding would be unduly burdensome. Those arguments failed to get The Phillies to first base, the Board unsympathetically noting that The Phillies had pleaded more than two dozen marks as bases for the pleaded claim. There was nothing improper in The Phillies filing a motion for a protective order rather than responding to the requests. But the Board found applicant's requests to be neither improper individually, nor harassing or oppressive as a whole. The subject admission requests included 32 requests for each of fourteen marks (although The Phillies had pleaded 26 marks in all). Since opposer chose to draft its notice of opposition broadly, the sheer number of requests (507) is not *per se* oppressive and unduly burdensome.

c. Motion to Compel Expert Report

i. *RTX Scientific, Incorporated v. Nu-Calgon Wholesaler, Inc.*, 106 USPQ2d 1492 (TTAB 2013). The Board granted respondent's motion to compel petitioner to serve a written expert report pursuant to FRCP 26(a)(2)(B), ruling that the question of whether a party's witness is "retained or specially employed to provide expert testimony" does not depend on whether the party controls the expert's time or compensates the expert. Rather it turns on whether the expert opinion testimony "arises from his enlistment as an expert and not from an on-the-scene involvement in any incidents giving rise to the litigation." Petitioner admitted that Mr. Holder is a third-party witness capable of giving expert testimony, but asserted that it did not retain Mr. Holder, that he was not specially employed by petitioner, that he had not been and would not be compensated, and that he had not prepared any written report. In Board proceedings, an expert is typically recruited not on the basis of personal knowledge of an event, but because of his or her particular knowledge of a relevant field. Mr. Holder had no "on-the-

scene” involvement in any incidents giving rise to the proceeding, and therefore he was a “retained” expert witness and his report must be provided.

d. Motion to Dismiss Under Rule 2.132

i. *Otter Products LLC v. BaseOneLabs LLC*, 105 USPQ2d 1252 (TTAB 2012). In this Section 2(d) opposition, Otter relied solely on a Supplemental Registration for its pleaded mark, proffering no other evidence or testimony. Rule 2.132(b) provides for involuntary dismissal of a proceeding if the plaintiff relies only on PTO records and defendant establishes that plaintiff has “shown no right to relief.” Otter’s ownership of a Supplemental Registration sufficed to give it standing to oppose and removed priority as an issue in the proceeding. But to prevail under Section 2(d), an opposer must show that it has “proprietary rights in the term [it] relies upon to demonstrate likelihood of confusion as to source.” Otter’s only evidence, the Supplemental Registration, was not evidence of ownership, validity, or the exclusive right to use. In short, it did not enjoy the presumptions of Section 7(b). The mark in Otter’s Supplemental Registration is presumed to be merely descriptive, and because Otter provided no evidence of acquired distinctiveness, it could not prevail in this proceeding.

ii. *Skincode AG v. Skin Concept AG*, 109 USPQ2d 1325 (TTAB 2013). At the close of Opposer Skincode’s testimony period, Applicant Skin Concept filed a motion to dismiss under Rule 2.132(b). The Board denied Skin Concept’s motion, finding that Skincode, which had relied only on USPTO records, had made out a *prima facie* case of likelihood of confusion under Section 2(d). Skin Concept sought to register the mark SWISSCODE for soaps and cosmetics; Skincode claimed likely confusion with its registered mark SKINCODE 2 & Design (shown here) for overlapping goods. Applying the *duPont* factors, the Board found that Skincode had presented a *prima facie* case. Because some of the goods are legally identical, a lesser degree of similarity is necessary to support a finding of likely confusion. The word portions of the marks are similar in appearance and commercial impression in that each mark comprises a two-syllable word that begins with the letter S, has soft “I” vowel sounds in the first syllable, and includes CODE as the second syllable. Moreover, the applied-for mark appears in standard character form, and therefore the Board must consider all manners in which it might be displayed, including a manner similar to that of the cited mark.



e. Motion to Withdraw Voluntary Surrender

i. *Christiane E, LLC v. International Expeditions, Inc.*, 106 USPQ2d 2042 (TTAB 2013). Respondent International Expeditions, rather than answer Christiane E’s petition for cancellation on the ground of abandonment, filed a voluntary surrender of the challenged registration without petitioner’s consent, pursuant to Trademark Rule 2.134(a). In such circumstances, the Rule provides that “judgment shall be entered against the respondent.” About four months later, and before the Board acted on the surrender, Expeditions moved to withdraw it. The Board said no dice. Although this case presented an issue of first impression, the Board found instructive *In re Glaxo Group Ltd.*, 33 USPQ2d 1535 (Comm’r 1993), involving

abandonment of an application during *ex parte* examination. Expeditions voluntarily relinquished an interest and that became part of the public record, available for inspection by the public and by employees of the PTO, “some of whom may have relied to their detriment on the filing.” Furthermore, the voluntary surrender of the registration during the proceeding “directly implicates the concrete rights of petitioner.” The Board saw no reason to apply a less stringent standard than that applied in *Glaxo*. In short, the Board did not find this to be an “extraordinary situation” that would warrant the granting of Expeditions’ request to withdraw its surrender.

f. Motion to Re-open Discovery

i. *Luster Products, Inc. v. John M. Van Zandt d/b/a Vanza USA*, 104 USPQ2d 1877 (TTAB 2012). Applicant Van Zandt moved to re-open the discovery period, claiming that he did not take discovery because he thought opposer Luster had lost interest in the case. He had asked Luster for its initial disclosures, but Luster did not provide them – until the last day of discovery, when Luster also served discovery requests. The Board applied the Supreme Court’s *Pioneer* factors to determine whether Van Zandt met the “excusable neglect” standard of FRCP 6(b)(1)(B). The third factor is often deemed the most important: the reason for the delay and whether it was in the control of the moving party. The Board found that this factor weighed strongly against a finding of excusable neglect. If Van Zandt had been concerned about Luster’s failure to timely serve initial disclosures, he should have filed a motion to compel. Although Van Zandt contended that he needed the initial disclosure in order to prepare his own discovery requests, the Board again noted his failure to move to compel. Moreover, Van Zandt could have prepared discovery requests based on Luster’s pleaded claim. Turning to the second *Pioneer* factor, the Board found that the delay caused by the failure of Van Zandt to act in a timely fashion was significant. Based on these two factors, the Board denied the motion.

g. Motion to Exclude Belatedly-Identified Witness

i. *Spier Wines (PTY) Ltd. v. Shepher*, 105 USPQ2d 1239 (TTAB 2012). Spier Wines noticed the testimony deposition of one witness, Ms. Eve Jell, but only in its pre-trial disclosures was she first identified as a potential witness. Spier’s initial disclosures had identified a person who had subsequently left the company. Applicant Shepher moved to strike the pre-trial disclosures and to quash the notice of taking testimony due to Spier’s failure to timely identify Ms. Jell in a supplement to its initial disclosures or otherwise. The Board granted the motion. It weighed the five factors set forth in *Great Seats, Inc. v. Great Seats, Ltd.*, 100 USPQ2d 1323 (TTAB 2011), concluding that the failure to identify Ms. Jell was neither harmless nor substantially justified. “Essentially, opposer treated the initial and pretrial disclosure requirements as unrelated events, rather than recognizing that disclosures and discovery responses should be viewed as a continuum of *inter partes* communication designed to avoid unfair surprise and to facilitate fair adjudication of the case on the merits.” Consequently, the Board applied the “estoppel sanction” and precluded the testimony of Ms. Jell.

h. Deposition on Written Questions

i. *Leonid Nahshin v. Product Source International, LLC*, 107 USPQ2d 1257 (TTAB 2013). In this petition for cancellation of a registration for the mark NIC OUT for “mechanical cigarette filters for removing nicotine,” the Board ruled that petitioner, as the manufacturer of the goods and first user, owned the mark, and the U.S. distributor did not. Generally, the Board observed, the mere fact that a distributor in this country distributes a foreign manufacturer’s branded product does not give the U.S. distributor ownership of the mark. Before reaching its decision, the Board overruled several objections made by respondent to petitioner’s testimony, taken by way of a deposition on written questions under Rule 2.124(d)(1). Respondent objected to the testimony because it had not been given the opportunity to serve cross-questions or objections, as required by the Rule. Rather than strike the testimony, the Board gave respondent 25 days to serve cross-questions. The Board noted that respondent thus had “the unique opportunity to review the deponent’s answers before drafting its cross-questions. It also had an opportunity to object to the responses and the [related] documents, but failed to do so.” The Board deemed respondent’s later objections on the ground of lack of authentication to be untimely, as was its objection to particular testimony as “not responsive.”

i. Motion to Exclude Evidence

i. *Dan Foam ApS v. Sleep Innovations, Inc.*, 106 USPQ2d 1939 (TTAB 2013). The Board denied cross-motions for summary judgment in this Section 2(d) cancellation proceeding. Noting that the goods overlap (pillows and mattresses), the Board suggested that, because disposition will likely turn on the issues of the similarity of the marks and their scopes of protection, the parties consider the Board’s Accelerated Case Resolution (ACR) procedure. Before reaching that point, however, the Board ruled on two evidentiary matters. It denied a motion to exclude certain documents obtained via a third-party subpoena because, although respondent had not received timely notice under FRCP 45, it had ample time to obtain additional documents from, or take a deposition of, the third-party. Turning to the issue of whether certain subpoenaed documents were admissible, the Board denied a motion to exclude undated transcripts of online chats and telephone conversations between representatives of the third party and customers (neither fully identified). Although these statements were hearsay, the documents were admissible under FRE 803(1) to the extent they reflected the “present sense impressions of the customers.” Moreover, the Board observed, “statement of consumer confusion in the trademark context fall under within the FRE 803(3) ‘state of mind’” exception to the hearsay rule.” In any case, the documents had little probative value absent explanatory testimony.