



# 2012-2013 Decisions of the Trademark Trial and Appeal Board and the Federal Circuit on Registrability Issues

*John L. Welch  
Lando & Anastasi, LLP (United States)*

## **I. *Ex Parte* Cases**

### **A. United States Court of Appeals for the Federal Circuit**

#### **1. Section 2(a) 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." "Nothing 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

Roost Sucker



purchaser,' \*\*\* then the market will no doubt reward her ingenuity. But this does not make her mark registrable."

## 2. Section 2(d) Likelihood of Confusion

a. *In re Viterra Inc.*, 101 USPQ2d 1905 (Fed. Cir. 2012). The CAFC upheld the TTAB's affirmance of a Section 2(d) refusal to register the mark XCEED for agricultural seed, on the ground of likely confusion with the registered mark X-SEED & Design [SEED disclaimed] for agricultural seeds. Viterra's appeal focused on the first *du Pont* factor, the similarity of the marks. It maintained that its standard character mark should not be construed so broadly as to cover the distinctive form of the cited mark, and that the marks are different phonetically and in connotation. Viterra asked the court to "readdress and clarify" its ruling in *Citigroup, Inc. v. Capital City Bank Group, Inc.*, 98 USPQ2d 1253 (Fed. Cir. 2011). There, in rejecting the Board's approach of considering the "reasonable manners" in which a standard character might be displayed, the CAFC declared that the TTAB "should not first determine whether certain depictions are 'reasonable' and then apply the *du Pont* analysis to only a subset of variations of a standard character mark." Here, the CAFC confirmed the *Citigroup* approach, but it further observed that the TTAB's application of the "reasonable manners" analysis subsequently rejected in *Citigroup* did not affect the outcome of this case. *Citigroup* broadened the range of variations that could be considered (i.e., not just "reasonable" ones), and therefore the Board's approach was actually more favorable to Viterra than the *Citigroup* approach.



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

a. *In re The Chamber of Commerce of the United States of America*, 102 USPQ2d 1217 (Fed. Cir. 2012). The CAFC upheld the TTAB's affirmance of two refusals to register NATIONAL CHAMBER, finding the mark to be merely descriptive of certain chamber-of-commerce-related services. The Board relied on dictionary definitions and applicant's own website in concluding that "[i]t takes no mental leap to understand that applicant is using the mark for the services in both applications as a national chamber of commerce, whether promoting the interests of businesspersons or industry on a national level, or connecting local chambers of commerce through a nationwide network." The CAFC found that NATIONAL CHAMBER immediately conveys information about a feature or characteristic of at least one of the services designated by COC in each of its two applications. As to one application, NATIONAL CHAMBER is descriptive of "[p]roviding online directory information services featuring information regarding local and state Chambers of

Commerce.” In the other, the mark describes the “expressly-recited function” of various services listed in the application, such as policy analysis and data analysis, performed “for the purposes of promoting the interests of businessmen and businesswomen.”

#### 4. 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, handbags and purses, travel 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.”



#### 5. Section 2(e)(5) Functionality

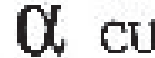
a. *In re Becton, Dickinson and Co.*, 102 USPQ2d 1372 (Fed. Cir. 2012). A divided CAFC panel affirmed the TTAB’s decision refusing registration, on the ground of Section 2(e)(5) functionality, of the product configuration shown here for a closure cap for blood collection tubes. The majority ruled that the Board had not committed legal error by weighing the functional and non-functional features of the design against each other in order to determine whether the design is *de jure* functional. “[A] mark possessed of significant functional features should not qualify for trademark protection where insignificant elements of the design are non-functional.” The dissent maintained that this “weighing” of the individual elements was improper because under Section 2(e)(5) of the Lanham Act the design must be considered “as a whole,” and further that the Board’s factual findings were not supported by substantial evidence.



## B. Trademark Trial and Appeal Board

### 1. 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 USPTO 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 USPTO’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.



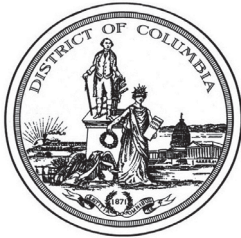
### 2. Section 2(a) False Association

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.”



### 3. Section 2(b) Official Insignia

a. *In re The Government of the District of Columbia*, 101 USPQ2d 1588 (TTAB 2012). Facing an issue of first impression, the Board affirmed the USPTO's



refusal to register the mark shown here on the ground that the mark comprises a governmental insignia that is barred from registration by Section 2(b) of the Lanham Act. Applicant sought to register its official seal for various goods, including clocks, cufflinks, and clothing items. Section 2(b) prohibits registration of any mark that "consists of or comprises the ... insignia of ... any State or municipality ...." There was no dispute that the applied-for mark is applicant's official seal,

nor that the District of Columbia qualifies as a "municipality" under the Act. The Board found the language of Section 2(b) to be "plain and clear on its face." Applicant argued that Section 2(b) should be interpreted to include an exception for governmental entities seeking to register their own insignia, but the Board noted that such an exception is absent from the statutory text and it refused to presume that Congress intended such an exception.

b. *In re City of Houston*, 101 USPQ2d 1534 (TTAB 2012). Following its decision in *District of Columbia*, the Board affirmed a Section 2(b) refusal to register the official seal of the City of Houston for various municipal services. The Board distinguished its ruling in *In re U.S. Dep't of the Interior*, 142 USPQ 506 (TTAB 1964), where it reversed a refusal to register a logo of the National Park Service. There, the question was whether the logo was an official insignia falling with Section 2(b), i.e., was it "of the same class as the flag or coats of arms of the United States." Once it is determined that the mark does fall with the Section 2(b) prohibition, then the goods or services identified in the application to register are irrelevant. Here, the City of Houston's seal is admittedly an official insignia under Section 2(b), and applicant's discussion of the particular government-related services recited in its application was of no consequence.



### 4. Section 2(d) Likelihood of Confusion

a. Likelihood of Confusion Found

i. *In re Accelerate s.a.l.*, 101 USPQ2d 2047 (TTAB 2012). The Board affirmed a refusal to register the mark COLOMBIANO COFFEE HOUSE for "providing food and drink" [COFFEE HOUSE disclaimed], finding it likely to cause confusion with the certification mark COLOMBIAN for "coffee." The same test for

likelihood of confusion applies to certification marks as to trademarks, the *du Pont* analysis, but the Board considers the mark as applied to the goods or services of the users of the certification mark. Because Colombia is renowned for coffee beans, consumers will perceive the applied-for mark as indicating that applicant serves Colombian coffee. The Board recognized that under *Jacobs v. International Multifoods*, food items and restaurant services are not automatically considered to be related for Section 2(d) purposes: “something more” is required. Here, applicant’s website indicated that it renders coffee house services. Third-party registrations showed that services of the type identified by applicant may emanate from the same source as coffee products. The Board concluded that consumers encountering applicant’s services offered under the mark COLOMBIANO COFFEE HOUSE would likely believe that applicant was authorized to use the certification mark, and would assume that applicant is licensed by or associated with the registrant.

ii. *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 USPTO’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.

iii. *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.

b. Likelihood of Confusion Not Found

i. *In re Hartz Hotel Services, Inc.*, 102 USPQ2d 1150 (TTAB 2012). The Board reversed a Section 2(d) refusal of GRAND HOTELS NYC for hotel services [HOTELS NYC disclaimed], finding the mark not likely to cause confusion with the registered mark GRAND HOTEL for hotel, restaurant, and convention services [HOTEL disclaimed]. Because the cited mark GRAND HOTEL is registered, it is entitled to a presumption of validity under Section 7(b). GRAND HOTEL therefore cannot be treated as merely descriptive; at most it can be considered as a highly suggestive, laudatory term, as evidenced by third-party registrations, third-party use, and dictionary definitions. Applicant submitted copies of five registrations for marks, owned by different entities, that include the term "Grand Hotel" or "Grande Hotel" for hotel services, and evidence of use of "Grand/Grande Hotel" marks in seven locations. The Board concluded that "[b]ecause of the highly suggestive nature of the mark 'Grand Hotel,' the proliferation of registered 'Grand Hotel' marks and the unregistered uses of 'Grand Hotel' marks, ... consumers are able to distinguish between different GRAND HOTEL marks based on small differences in the marks, including the addition of a geographic term."

ii. *In re Strategic Partners, Inc.*, 102 USPQ2d 1397 (TTAB 2012). Although the mark ANYWEAR (Stylized) for footwear would usually be considered confusingly similar to the cited mark ANYWEAR BY JOSIE NATORI & Design for "jackets, shirts, pants, stretch t-tops, and stoles," this was not the usual case. Applicant already owned a registration for the plural ANYWEARS in standard character form, for footwear, which registration had co-existed with the cited registration for more than five years. In this "unique situation," the Board found confusion unlikely. Under the 13th *du Pont* factor, the Board may consider "any other established fact probative of the effect of use." This factor "accommodates the need for flexibility in assessing each unique set of facts." Because applicant registered its mark ANYWEARS in standard character form, the registration covers the mark regardless of font size, style or color, including the identical style depicted in its applied-for mark. Consequently "there is no meaningful difference between the standard character and stylized versions of applicant's marks." Moreover, the difference



between the singular and the plural forms of ANYWEAR is not significant, since consumers are not likely to perceive that slight variation.

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

a. *In re Accelerate s.a.l.*, 101 USPQ2d 2047 (TTAB 2012). In addition to affirming the Section 2(d) refusal summarized above, the Board found the mark COLOMBIANO COFFEE HOUSE to be merely descriptive of “providing food and drink” [COFFEE HOUSE disclaimed]. The Examining Attorney maintained that COLOMBIANO COFFEE HOUSE immediately describes the nature of, or a key feature of, applicant’s services: a coffee house offering Colombian coffee. The Board agreed. Based on the record evidence, it found that consumers will immediately understand the term COLOMBIANO to describe a particular type of coffee that applicant will serve, i.e., coffee that has certain qualities and characteristics associated with authentic Colombian coffee. The Board noted that the Examining Attorney did not refuse registration on the ground of geographical descriptiveness under Section 2(e)(2), or deceptive misdescriptiveness under Section 2(e)(3), although those grounds were conceivably applicable.

b. *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 USPTO 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 USPTO’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.”

c. *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 before the Board 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 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 of the SADORU mark “does not create a separate and inherently distinctive commercial impression apart from the word itself.”



d. *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.”

e. *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 those 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 USPTO that CENTER OF SCIENCE AND INDUSTRY is “highly descriptive” of applicant’s services, since it “directly and easily” conveys information about the services, and therefore that a greater evidentiary showing is needed to establish acquired distinctiveness.

## **6. Section 2(e)(3) Primarily Geographically Deceptively Misdescriptive**

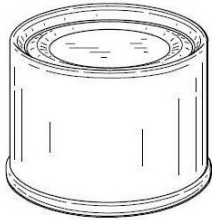
a. *In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841 (TTAB 2012). Providing a detailed discussion of Section 2(e)(3), the Board affirmed a refusal to register OLD HAVANA for rum, finding the mark to be primarily geographically deceptively misdescriptive. The Board concluded that “[t]he primary significance of Havana is the name of the capital of Cuba, a geographic location that is generally known to the American consumer. The presence of ‘OLD’ in the mark OLD HAVANA does not diminish the primary geographic significance of the mark when considered as a whole; ‘OLD’ only serves to reinforce the primary geographic significance which, in point of fact, is a section of Havana. Because of the large and well-known rum industry in Havana, consumers will make a good/place association, that is, consumers will mistakenly believe that the rum originates in Havana, Cuba when in fact it does not. Lastly, because of the renown of rum originating in Havana, Cuba, the geographic origin of the rum would be a material factor for a significant portion of the relevant consumers in their decision to buy the rum.”

b. *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.”

## 7. Section 2(e)(5) Functionality

a. *In re Mars, Inc.*, 105 USPQ2d 1859 (TTAB 2013). Mars applied to register the packaging configuration shown below 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.

b. *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.

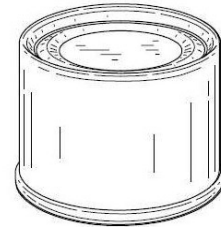
## 8. Distinctiveness of Product Design

a. *In re The Procter & Gamble Co.*, 105 USPQ2d 1119 (TTAB 2012). The Board reversed the USPTO’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 1089 (TTAB 2013). Mars applied to register the packaging configuration shown below 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.



## 9. Genericness

a. *In re Tennis Industry Assn.*, 102 USPQ2d 1671 (TTAB 2012). The USPTO failed to provide the clear evidence necessary to support its genericness refusal of TENNIS INDUSTRY ASSOCIATION for association services related to tennis. Applicant also claimed that the phrase had acquired distinctiveness, but its evidence failed to clear the net. Applicant submitted a “voluminous” number of articles from the Westlaw database discussing applicant and displaying the subject phrase in initial caps, thusly: Tennis Industry Association. The Board found that, on balance, the USPTO had failed to meet its “difficult burden of establishing by clear and convincing evidence” that TENNIS INDUSTRY ASSOCIATION, as a whole, is generic. Of the five examples submitted by the Examining Attorney, it was not

apparent in two of them that the phrase was being used generically. “A mere three unambiguous examples of generic usage ... simply is insufficient to support the genericness refusal.” The Board had “substantial doubt” whether TENNIS INDUSTRY ASSOCIATION is generic for the recited services, and it resolved that doubt, as it must, in applicant’s favor.

## 10. Failure to Function/Unacceptable Specimen of Use

a. *In re HSB Solomon Associates, LLC*, 102 USPQ2d 1269 (TTAB 2012). The Board affirmed a refusal to register the proposed mark CEI for “technical consultation in the field of hydrocarbon and chemical processing, pipeline, and power industries,” on the ground that the specimens failed to show use of the mark for the identified services. It agreed with the Examining Attorney that CEI (an initialism for “carbon emissions index”) is used only to identify a process by which applicant derives a particular measurement, and not as a source indicator. “A term that identifies only a process, style, method, system or the like is not registrable as a service mark.” TMEP Section 1301.02(e). Applicant argued that if it “uses CEI in connection with benchmarking that it provides as part of the consulting services, then the mark is being [used] in connection with the services.” Applicant also asserted that its customers are sophisticated and know that applicant’s only business is to provide technical consultation services. The Board, however, observed that customer sophistication is “largely inapposite” to the issue at hand. And the fact that CEI may be used in the performance of the service does not transform CEI into a source identifier rather than merely the name of a process.

b. *In re Azteca Systems, Inc.*, 102 USPQ2d 1955 (TTAB 2012). The Board affirmed a refusal to register the mark shown here for “computer software for management of public works and utilities assets” on the ground that Azteca’s specimen of use did not show the applied-for mark associated with the identified goods. The mark appeared in a corner of applicant’s specimen webpage but, the examining attorney contended, the textual description of the software referred to the mark CITYWORKS and not the applied-for mark. The Board found that the mark “fails to create an association with the goods and fails to serve as an indicator of source of applicant’s goods as described on the webpage.” The mark is distant from the description of the software and separated by text of marginal relevance (e.g., applicant’s philosophy regarding customers). Moreover, a number of different logos appear on the webpage that do not relate to the software. Links to event and news further distract the reader from the mark.

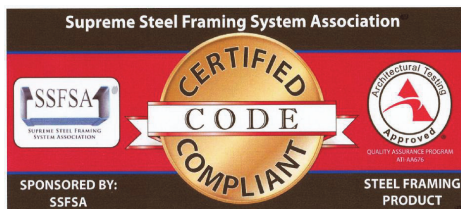


c. *In re Phoseon Technology, Inc.*, 103 USPQ2d 1822 (TTAB 2012). The Board affirmed a failure-to-function refusal of the mark SEMICONDUCTOR LIGHT

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.

d. *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 website. The USPTO 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.”

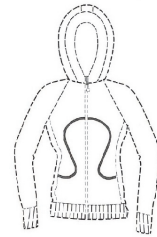
e. *In re Supreme Steel Framing System Ass’n, Inc.*, 105 USPQ2d 1385 (TTAB 2012). In a rather straightforward, yet precedential, decision the Board affirmed two refusals to register the mark SSFSA CERTIFIED CODE COMPLIANT, in standard



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.

f. *In re Lululemon Athletica Canada Inc.*, 105 USPQ2d 1684 (TTAB 2013). The Board affirmed a refusal to register the mark shown here for “hooded sweatshirts; jackets; coats,” finding 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 Board found that the registered mark and the subject mark were not the same.



g. *In re Arnold*, 105 USPQ2d 1953 (TTAB 2013). The USPTO 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 carry that burden.

h. *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. In some instances, 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.

i. *In re Pohl-Boskamp GmbH & Co. KG*, 106 USPQ2d 1042 (TTAB 2013). In affirming the USPTO’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 fail 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 would “more likely to be perceived merely as attributes of ingestible products than as indicators of source.”

## 11. Goods in Trade

a. *In re White Thomas White Int’l, Ltd.*, 106 USPQ2d 1158 (TTAB 2013). The Board affirmed a refusal to register the mark EMPOWERING THE INVESTOR, in standard character form [INVESTOR disclaimed], for “Electronic 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.”

## **12. 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 USPTO 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.”

## **13. Collateral Estoppel**

a. *In re Anderson*, 101 USPQ2d 1912 (TTAB 2012). Applicant sought to register the marks FUTURE and FUTURE MOTORS for hundreds of goods and services falling in classes 3, 12, 35, and 40. The USPTO refused registration under Section 2(d) as to various goods in class 12 and certain of the services, in view of the registered mark FUTURA for “tires” and “vehicle wheel caps and hub caps.” The Examining Attorney further asserted that collateral estoppel barred registration of the marks in view of a prior Board proceeding in which the Board sustained oppositions to several other applications of Mr. Anderson. The Board, for the first time applying collateral estoppel in an *ex parte* context based upon a prior *inter partes* judgment, agreed that estoppel applied to the FUTURE application but not the FUTURE MOTORS application. The earlier oppositions involved the marks FUTURE and FUTURE/TOMORROW & Design, but the latter mark was not substantially identical to FUTURE MOTORS.

## **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. In *Bridgestone Americas Tire Operations, LLC v. Federal Corp.*, 102 USPQ2d 1061 (Fed. Cir. 2012). The CAFC reversed a TTAB decision that found the mark MILANZA in stylized form, not likely to cause confusion with the registered marks POTENZA and TURANZA, all for tires. The TTAB ruled that “[t]he dissimilarity of the marks simply outweighs the other relevant factors.” The court concluded that the Board erred in dismissing the opposition in light of the identity of the goods, the long prior use of the POTENZA and TURANZA marks, their market strength, and the similarities in sound and connotation with MILANZA.

ii. *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 of its mark 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, 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.

##### b. Likelihood of Confusion Not Found.

i. *Coach Services, Inc. v. Triumph Learning LLC*, 101 USPQ2d 1713 (Fed. Cir. 2012). The CAFC affirmed the Board’s dismissal of opposer Coach’s Section 2(d) claims, ruling that opposer had failed to prove likelihood of confusion between Triumph’s mark COACH for educational software and publications, and opposer’s registered mark COACH for handbags, luggage, and the like. Coach argued that the Board should have given more weight to its determination that

opposer's mark was famous. The court, however, concluded that "the unrelated nature of the parties' goods and their different channels of trade" weighed heavily against Coach. "Because the *du Pont* factors favoring Triumph outweigh the factors favoring CSI, the Board was correct in finding no likelihood of confusion."

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

a. *Coach Services, Inc. v. Triumph Learning LLC*, 101 USPQ2d 1713 (Fed. Cir. 2012). The CAFC vacated the TTAB's ruling that applicant's mark COACH had acquired distinctiveness for educational software and publications. The Board relied on certain documents despite opposer Coach's objection that they had not been properly authenticated. The court agreed with Coach that the Board had committed error, and it remanded the case to the Board: "[O]n remand, the Board must address the weight, if any, to be given to pre-July 2003 documents in the absence of any testimony authenticating them or addressing their use. The Board must then assess whether these apparent gaps in Triumph's proofs impact the Board's determination that the mark was in continuous use during any relevant period." [On remand, the TTAB found acquired distinctiveness based on Triumph's other evidence. *Coach Services, Inc. v. Triumph Learning LLC*, Opposition No. 91170112 (TTAB June 18, 2012) [not precedential]].

b. *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 had failed to consider the design mark as a whole, instead focusing only on "one portion of it," 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 concluded 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, 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 trademark, featuring the word "Snap!" in a bold, black, sans-serif font. The exclamation point is stylized with a curved line above it, resembling a plunger tip.

## 3. Dilution by Blurring

a. *Coach Services, Inc. v. Triumph Learning LLC*, 101 USPQ2d 1713 (Fed. Cir. 2012). The CAFC affirmed the Board's dismissal of opposer's dilution-by-blurring claims, ruling that opposer had failed to prove that applicant Triumph's

mark COACH for educational software and publications would likely dilute opposer's registered mark COACH for handbags, luggage, and the like. The court agreed with the Board that Coach did not provide sufficient evidence to meet the higher fame standard for dilution. The only sales and advertising figures of record covered a single year (2008, four years after Triumph's filing date). Coach's 16 incontestable registrations were relevant to the fame inquiry, but of course not conclusive. Coach's evidence of media attention failed "to show widespread recognition of opposer's mark [by] the general population." The court emphasized that the burden to show fame in the dilution context is not "insurmountable," but Coach's record evidence was "just too weak" to prove fame.

#### **4. 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 other 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 service. 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.

#### **5. Collateral Estoppel**

a. *Stephen Slesinger, Inc. v. Disney Enterprises, Inc.*, 105 USPQ2d 1472 (Fed. Cir. 2012). A divided panel of the U.S. Court of Appeals for the Federal Circuit 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 issue of ownership was essential to the court's decision, that it was fully litigated, that it was necessarily decided by the court, 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. Trademark Trial and Appeal Board**

### **1. Section 2(d) Likelihood of Confusion**

#### **a. Likelihood of Confusion found**

i. *Lebanon Seaboard Corp. v. R & R Turf Supply, Inc.*, 101 USPQ2d 1826 (TTAB 2012). In this rather mundane Section 2(d) decision, the Board sustained an opposition to the mark TURFECTA for "grass seed" in view of the registered mark TRIFECTA for "lawn seed." The Board found TRIFECTA to be an arbitrary mark in use for 25 years, and therefore deemed it a strong mark entitled to a broad scope of protection. Applicant contended that FECTA is a "common laudatory suffix" that imports the word "perfect" into the mark. The Board disagreed, concluding that consumers would not view the FECTA portion of opposer's mark TRIFECTA separately from the mark as a whole; rather, they would ascribe to the mark the dictionary meaning of the word – a type of horse racing bet. As to meaning, the marks plainly differ, but that difference was not sufficient to distinguish the marks. Because of the similarity in structure of TURFECTA to "trifecta," consumers are likely to see TURFECTA as a play on "trifecta." Applicant maintained that it chose the mark TURFECTA in good faith, with no intention to mimic or copy opposer's mark. but the Board pointed out that good faith adoption of a mark does not prevent a finding of likely confusion.

ii. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434 (TTAB 2012). The fame of the marks L'OREAL and L'OREAL PARIS for cosmetics and personal care products was a major factor in the Board's sustaining opposer's Section 2(d) claim in this opposition to L'OREAL PARIS for "aloe vera drinks." (Opposer's successful claim of lack of *bona fide* intent is discussed below). The Board found opposer's marks to be famous, based on billions of dollars in sales, significant market share, huge advertising expenditures, extensive media exposure, impressive brand awareness, and consistent high ranking by *Business Week*. The marks are obviously identical and, while at first glance cosmetics and beverages "might not appear to be inherently related," opposer submitted "substantial evidence to show several reasons for finding such goods to be related;" for example, companies have marketed cosmetics and beverages under the same mark. Applicant Marcon's history of filing applications for products for which he had no relevant experience convinced the TTAB that adoption of this mark was in bad faith, although it added that even without bad faith it would still find confusion likely.

iii. *Edom Laboratories, Inc. v. Lichter*, 102 USPQ2d 1546 (TTAB 2012). The one-two punch of actual confusion and bad faith knocked out Glenn Lichter's application to register the mark SUPER CHIRO TEA for "herbal teas for medicinal purposes" [TEA disclaimed]. The Board found the mark likely to cause confusion with the registered mark CHIRO-KLENZ for "herbal teas for medicinal purposes; nutritional supplements for eliminating toxins from the body." Because the goods are partly identical, a lesser degree of similarity between the marks is necessary to support a finding of likely confusion. The Board concluded that the similarities outweigh the differences between the marks. It gave some probative value to a dozen or so telephone calls received by opposer, in which the callers either asked for SUPER CHIRO TEA or inquired as to opposer's relationship to SUPER CHIRO TEA. Additional testimony (by way of declaration) of two persons who were confused, was more probative. Invoking the 13th *du Pont* factor, the Board agreed that the "overwhelming" evidence showed that applicant had a bad faith intent to cause, and profit from, consumer confusion.

## 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 the stylized lettering shown here), finding the mark to be neither generic 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."

**CMS**

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 the 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."

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

a. *Corporacion Habanos, S.A. v. Guantanamera Cigars Co.* 102 USPQ2d 1085 (TTAB 2012). On remand from the U.S. District Court for the District of Columbia, the Board sustained this opposition to registration of the mark GUANTANAMERA for cigars, finding the mark to be primarily geographically deceptively misdescriptive under Section 2(e)(3). The district court found that "Guantanamera" means "girl from Guantanamo," that the primary significance of GUANTANAMERA is geographic, that the consuming public is likely to believe that applicant's cigars originate from Cuba, and that cigar tobacco is produced in the Guantanamo province. However the court ruled that the Board had failed to address the third element of the *California Innovations* test: whether a significant portion of relevant consumers would be materially influenced by the geographic meaning of the mark. The Board re-opened the proceeding as to that issue, and concluded that a substantial portion of consumers would "value associations with Cuba in making purchasing decisions." Applicant argued that direct evidence of materiality is required, but the Board concluded otherwise. It noted the difficulty in obtaining direct evidence from purchasers, and pointed out that the TTAB does not require survey evidence in any proceeding (given the limited nature of its jurisdiction).

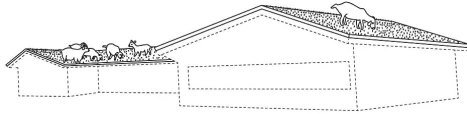
### **4. Section 2(e)(4) Primarily Merely a Surname**

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's 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.”

## 5. Section 2(e)(5) Functionality

a. *Doyle v. Al Johnson’s Swedish Restaurant & Butik, Inc.*, 101 USPQ2d 1780 (TTAB 2012). In one of the more bizarre TTAB cases in years, the Board granted



respondent’s motion to dismiss a petition for cancellation of two registrations for the mark shown here (comprising goats on a grass roof) for restaurant and retail store services. Doyle’s

pleaded ground for cancellation was functionality, but he failed to relate this claim to respondent’s services: i.e., he failed to allege that goats on sod roofs are essential to the use or purpose of restaurant or retail store services. Doyle asserted that goats on sod roofs affect respondent’s costs by reducing respondent’s energy and mowing expenses, but that allegation was completely unrelated to respondent’s particular services. Doyle also alleged that the mark was functional because it is a “form of entertainment” that attracts customers; however, there was no allegation that this method is superior to any other method for attracting customers. Moreover, the Board observed, there is “no prohibition against a trade dress mark both functioning to indicate source and being aesthetically pleasing.” And so the Board concluded that Doyle’s allegations, even if true, could not establish the functionality of the registered mark.

## 6. Non-use/Abandonment

a. *ShutEmDown Sports, Inc. v. Lacy*, 102 USPQ2d 1036 (TTAB 2012). The Board shut down *pro se* applicant Carl Dean Lacy in this cancellation proceeding involving his registration for the mark SHUT IT DOWN for 113 clothing items. Petitioner alleged abandonment and fraud, asserting that at the time of filing, Lacy had yet to use the mark on any of the goods, and that any subsequent use of the mark had been abandoned. The Board granted the petition on the ground of abandonment, ruled that the registration was void *ab initio* for nonuse – a ground that was not pleaded – and declined to consider the fraud issue. Lacy admitted that he had not used the mark in connection with 109 of the identified goods, and had no intention to do so. He therefore failed to rebut the statutory presumption of abandonment that arises after three years of nonuse. As to the remaining four items that Lacy claimed to have sold, the lack of sales for a five-year period, coupled with his lack of documentation, established a *prima facie* case of abandonment. The Board found it unnecessary to reach petitioner’s fraud claim because petitioner had also made a *prima facie* case that Lacy had not used his mark on any of the goods at the



time he filed his application, and Lacy failed to overcome that showing. The Board therefore ruled that Lacy's application was void *ab initio* for nonuse.

b. *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."

## **7. Lack of Bona Fide Intent**

a. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434 (TTAB 2012). In addition to sustaining Opposer Section 2(d) claim of likelihood of confusion between its famous marks L'OREAL and L'OREAL PARIS for cosmetics and personal care products, and Marcon's applied-for mark L'OREAL PARIS for "aloe vera drinks," the Board found that Marcon lacked a *bona fide* intent to use his purported mark. (The Section 2(d) issue is discussed above). Marcon had no documents evidencing a *bona fide* intent, and he admitted having no industry experience, no business plan, no potential partners or investors, no logos or packaging, and no concrete activities toward using the mark. Furthermore, Marcon's pattern of filing Intent-to-Use applications (16 in all) for disparate goods under the well-known or famous marks of others provided "significant, additional support" for the Board's conclusion. The legislative history of the Trademark Law Revision Act of 1988 states that the filing of an excessive number of intent-to-use applications to register marks that were ultimately not used "may cast doubt on the bona fide nature of the intent or even disprove it entirely."

## 8. Dilution by Blurring

a. *Research in Motion Limited v. Defining Presence Marketing Group, Inc.*, 102 USPQ2d 1187 (TTAB 2012). The Board sustained RIM's opposition to registration of the mark CRACKBERRY for various online computer services and assorted clothing items, finding the mark likely to likely to dilute RIM's famous mark BLACKBERRY for handheld devices including smartphones. Based on extensive promotion and use, and the role of "this historically-significant device in shaping the culture and technology of the early twenty-first century," the Board found that the mark BLACKBERRY has become "famous and well known." Considering applicants' parody defense in the dilution context, the Board ruled that parody does not insulate applicants based on two critical factors: first, the public adopted and popularized "Crackberry" as a nickname for BLACKBERRY devices, so the term "Crackberry" does not solely, "if at all," reflect applicants' attempt at parody; second, the closeness of applicants' services to the goods and services of RIM further undercuts the defense. And so the Board concluded that use of applicants' mark would blur the distinctiveness of RIM's mark. The Board also sustained RIM's Section 2(d) claim as to applicant's computer services, but not as to applicant's clothing items.

b. *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 in 2006 (TDRA), 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]).

## 9. 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 (stylized) is generic for wine. There was no question that the term CMS was derived from the initials of the varietals 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.

**CMS**

## **10. Defective Section 44(e) Basis**

a. *Kallamni v. Khan*, 101 USPQ2d 1864 (TTAB 2012). Respondent Khan, a Pakistani domiciliary and national, obtained a US registration for the mark OZO ENERGY DRINK & Design for soft drinks, under Section 44(e) of the Lanham Act, based on a Community Trademark Registration (CTM). Khan claimed that the CTM registration emanated from his "country of origin," but the Board concluded that Khan did not have a "bona fide and effective industrial or commercial establishment in the EU." He did not have a permanent place of business with employees, nor production facilities, in the EU, and the Board found as a matter of law that "a bona fide and effective industrial or commercial establishment cannot be created by respondent's reliance on the commercial facilities of an independent legal entity which respondent retained to source his European Union business." It therefore ruled that the CTM registration could not serve as a basis for registration under Section 44(e), and it cancelled Khan's registration on petitioner's motion for summary judgment.

## **11. Certification Mark Validity**

a. *Swiss Watch International, Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731 (TTAB 2012). The Board dismissed a petition for cancellation of registrations for SWISS and SWISS MADE as certification marks for watches, clocks, and their component parts and fittings. Petitioner unsuccessfully raised five grounds for cancellation: that respondent permits its marks to be used for purposes other than certification (Section 14(5)(C) of the Lanham Act); that respondent does not control use of its marks (Section 14(5)(A)); that respondent discriminates in refusing to certify (Section 14(5)(D)); that the marks are generic for the goods; and that respondent committed fraud on the USPTO in securing the registrations. Petitioner claimed that there was widespread, unauthorized use of SWISS by third parties, but respondent's witness testified as to its significant worldwide activities to ensure

adherence to its standards. It monitors trademark filings, files oppositions, tracks media usage, buys or requests sample watches, and inspects watches seized by customs authorities. The Board pointed out that absolute control is neither possible nor required; although there was some evidence of misuse of SWISS, the instances were not so extensive as to warrant cancellation of the registrations.

## 12. Procedural Issues

### a. Standing

i. *Doyle v. Al Johnson's Swedish Restaurant & Butik, Inc.*, 101 USPQ2d 1780 (TTAB 2012). In petitioning to cancel two registrations for a mark comprising goats on a grass roof for restaurant and retail store services, Doyle alleged that because "[m]any establishments in the classes to which registrant's mark apply have, because of registrant's marks, refrained from placing goats on their grass roofs, as a result of which petitioner has been, and will continued (sic) to be, damaged in that petitioner has been, and will continue to be, unable to satisfy his desire to take photographs of goats on grass roofs." Even though the standing hurdle is quite low, Doyle failed to clear it. Although he may have a "real interest" or a "personal stake" in taking photographs of goats on a roof, Doyle did not "relate [his] alleged impairment to *respondent's service mark* in any manner." There was no allegation that respondent's mark somehow prevented him from placing goats on a grass roof and photographing them, or even photographing the goats on respondent's restaurants. Thus Doyle's alleged belief that he will be damaged was not reasonable. He did not allege that he uses or wants to use goat photographs in connection with restaurant or retail store services. In short, he failed to allege a reasonable basis in fact to support his claim of standing.

### b. Proper Service of Initial Pleading

i. *Musical Directions v. McHugh*, 104 USPQ 1157 (TTAB 2012). The Board denied applicant McHugh's motion to dismiss this opposition due to lack of proper service of the Notice of Opposition. The Board found that opposer complied with the applicable rule when it *served* the Notice by certified mail five days after filing, but still within the opposition deadline, by certified mail (even though returned as undeliverable). The error made by opposer on the ESTTA cover sheet at the time of filing the notice, saying that service had already been made by fax or email, was harmless. Although opposer should have notified the Board when the Notice was returned as undeliverable, applicant's attorney was in fact aware of the Notice via an email sent to applicant McHugh four days after the filing, because the attorney asked for a telephone conference with Opposer six days later. Thus no harm was suffered by McHugh in not receiving the mailed copy.

ii. *Jacques Moret, Inc. v. Speedo Holdings B.V.*, 102 USPQ2d 1212 (TTAB 2012). When petitioner Jacques Moret, Inc. filed its petition for cancellation (under Section 2(d)), it should have served the petition on the respondent or respondent's domestic representative, if one had been appointed. See Rule 2.111(a) and (b). Respondent Speedo did not appoint a domestic representative, and so petitioner should have served Speedo directly. Instead, petitioner served an attorney who had corresponded with petitioner's counsel regarding a cease-and-desist letter. The Board therefore granted Speedo's motion to dismiss under FRCP 12(b)(5). Even if the USPTO records indicate an attorney of record in connection with a registration, if that attorney is not designated as domestic representative, service of a petition for cancellation on that attorney is not sufficient. Likewise, service on an attorney who represented registrant in prosecution, or who represented registrant in other matters, is not sufficient. Petitioner's service on the Director of the USPTO was inadequate because Rule 2.24(a)(2) concerns *ex parte* prosecution, not cancellation proceedings. Nonetheless, noting that the law firm that filed the motion to dismiss received a copy of the petition and that respondent was on notice of the proceeding, the Board deemed the proceeding commenced when the law firm received its copy. [Note that the registration issued in 2008, and so there was no issue of timeliness under Section 14(a)].

c. Section 14 Partial Abandonment versus Section 18 Modification

i. *Johnson & Johnson v. Obschestvo s Ogranitchennoy; Otvetstoennostiu WDS*, 104 USPQ2d 2037 (TTAB 2012). In this 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 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 under Section 18 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.

e. Alternative Case Resolution (ACR)

i. *Lebanon Seaboard Corp. v. R & R Turf Supply, Inc.*, 101 USPQ2d 1826 (TTAB 2012). The parties to this Section 2(d) opposition stipulated to submission of their trial evidence concurrently with their legal arguments and stipulated that testimony could be submitted by affidavit or declaration, similar to a case of cross-motions for summary judgment. They also stipulated that, *inter alia*, opposer has standing and priority of use, the goods of the parties are legally identical, and opposer’s mark TRIFECTA has no special meaning in the field of grass seed. Although the Board found it “admirable” that the parties chose the ACR route, it noted that the parties needlessly submitted evidence as to certain facts and issues that had already been stipulated. The parties also needlessly stipulated that the Board could “resolve any disputed issues of material fact in making a final determination on the merits.” Such a provision applies in a summary judgment context, but not here because the parties actually went to trial, so of course the Board could decide factual issues.

f. Board Correction of Opinion

i. *Corporacion Habanos, S.A. v. Guantanamera Cigars Co.*, Opposition No. 91152248 (TTAB June 12, 2012). On the motion of opposer’s counsel, the Board amended its decision to remove certain “erroneous” statements regarding opposer’s submission of evidence, as well as the Board’s reprimand of counsel based thereon. In its February 16, 2012 decision, the Board accused opposer’s counsel of “burying” inadmissible evidence in a “purportedly handy attachment to its brief,” in an “attempt to hoodwink us into considering material that opposer did not make of record.” The Board proclaimed that “[l]ittle is left in the integrity of a proceeding if the tribunal cannot trust the accuracy of submissions or the veracity of a party’s

representations.” In his request to amend the decision, opposer’s counsel pointed out the errors in the Board’s factual statements regarding opposer’s submission of testimony. He stated that “[t]he Board’s erroneous statements, and its subsequent unfounded reprimand, in its precedential, to be published opinion are plainly damaging to undersigned counsel’s previously unblemished professional reputation, both before the Board and elsewhere.” The Board granted opposer’s uncontested request and removed, without further comment, certain text from the original decision.

### **13. Motion Practice**

#### **a. 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 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.

#### **b. 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.

c. 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, opposer 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 USPTO 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.