

## The Top Ten TTAB Decisions of 2004™

By John L. Welch

The Trademark Trial and Appeal Board issued some 600 decisions in 2004, but it deemed only 13 of those decisions “citable.” This fraction (about 1/46) of citable decisions is the lowest in memory, despite the clamor of the trademark bar for more precedential TTAB rulings. Moreover, unlike the past two years when the Board rendered noteworthy decisions on the issues of dilution, fraud, and trade dress protection, none of the citable decisions in 2004 can exactly be called monumental.

Perhaps the most significant of the year's citable cases is *In re Dell*, in which the Board may be signaling an easing of the standard for trademark specimens when the mark is used in connection with products sold on the Internet.

The following 10 decisions, five of them citable, are arguably of most importance and/or interest to the everyday trademark practitioner.

1. *In re Dell Inc.*, 71 USPQ2d 1725 (TTAB 2004). The Board reversed a refusal to register based on Dell's alleged failure to submit a specimen evidencing actual trademark use. Dell sought to register the mark QUIETCASE for “computer hardware: internal cases for computer hardware being parts of computer workstations.” It submitted as its specimen of use a webpage printout, asserting that the webpage comprised a display associated with the goods (*Rule 2.56(b)(1)*). The Board recognized that “[i]n effect, a website is an electronic retail store, and the webpage is a shelf-talker or banner which encourages the customer to buy the product.” It therefore held that “a website page which displays a product, and provides a means of ordering the product, can constitute a ‘display associated with the goods,’ as long as the mark appears on the webpage in a manner in which the mark is associated with the goods.” As to Dell's actual specimen, the Examining Attorney argued that the mark, which appeared in a list of bullet points, was not sufficiently near the picture of the goods and was not prominently displayed. The Board, however, found the mark “sufficiently prominent that consumers will recognize it as a trademark for the computer hardware shown on the webpage.”

2. *Texaco Inc. v. Pennzoil-Quaker State Co.*, Opposition No. 91120520 (May 28, 2004) [not citable]. Texaco motored to a clear victory in this opposition to registration of “the color clear used on containers for motor oil.” The Board applied the CAFC's *Morton-Norwich* factors in a “competitive need” analysis in finding the applied-for mark to be *de jure* functional. It considered the evidence under factor three (alternative designs) to

be the most damaging: Pennzoil introduced the clear bottle after determining that there was an “obvious competitive advantage” to displaying the coloration of its products, even though the clear bottle is more expensive to manufacture. For purposes of completeness, the Board also considered Pennzoil's evidence of acquired distinctiveness, noting that the Section 2(f) showing must be “much greater” than for a descriptive term, a slogan, or a label, in view of “the ubiquity of nearly identical packaging for many related automotive products.” Despite the expenditure of millions of dollars promoting its motor oils, prominent use of such slogans as “The Difference is Clear,” and inclusion of the statement “CLEAR BOTTLE IS A TRADEMARK OF PENNZOIL QUAKER STATE COMPANY” on the containers, Pennzoil's proofs fell short.



3. *In re Gregory*, 70 USPQ2d 1792 (TTAB 2004). The Board applied its five-factor test in affirming a Section 2(e)(4) refusal to register the mark ROGAN for certain jewelry, handbag, and clothing items, finding it to be primarily merely a surname. The Examining Attorney relied, *inter alia*, on 1,087 residential listings in a computerized telephone database. Applicant argued that the number of listings for ROGAN are fewer than the 1,295 listings for HACKLER, which the TTAB found to be a rare and registrable surname in *In re United Distillers plc*, 56 USPQ2d 1220 (TTAB 2000). The Board declined to consider the HACKLER decision as setting any benchmark, and it rejected the notion that the question of whether a surname is rare is to be “determined solely by comparing the number of listings of the name to the total number of listings in a vast computerized database.” Here, media attention given to the surname ROGAN in recent years – e.g., James Rogan is the former Director of the PTO and a former California congressman who received considerable media coverage as a manager during the impeachment trial of President Clinton – and evidence regarding others so-named led the Board to conclude that ROGAN, although it “may be rare when viewed in terms of frequency of use as a surname in the general population, [is] not at all rare when viewed as a name repeated in the media and in terms of public perception.”

4. *In re Consolidated Specialty Restaurants, Inc.*, 71 USPQ2d 2004 (TTAB 2004). The Board affirmed a

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Section 2(e)(3) refusal to register COLORADO STEAKHOUSE & Design, finding it primarily geographically deceptively misdescriptive of Applicant's restaurant services. Last year's CAFC decisions in *California Innovations* and *Les Halles* set out the test for determining whether a service mark runs afoul of Section



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

5. *In re DataMirror Corp.*, S.N. 75203278 (February 12, 2004) [not citable]. In a decision that continues a trend toward greater admissibility of Internet evidence, the Board affirmed a Section 2(e)(1) refusal to register the mark TRANSFORMATION SERVER, finding it merely descriptive of "computer software for use in extraction, filtering, reformatting and replication of data between the compatible and incompatible database software and computer platforms." The Examining Attorney relied on dictionary definitions and NEXIS articles, and on Internet website excerpts discussing DataMirror's product, in arguing that the mark is descriptive because the software transforms data on or in conjunction with servers. Two of the Internet excerpts were foreign in origin (and apparently in English), but the Board cited *In re Remacle*, 66 USPQ2d 1222 (TTAB 2002), for the proposition that professionals in the computer field would find these items of interest regardless of the country of origin.

6. *Alfacell Corp. v. Anticancer, Inc.*, 71 USPQ2d 1301 (TTAB 2004). The Board sustained a Section 2(d) petition for cancellation of Anticancer's registration for the mark ONCASE for "therapeutic compositions containing reagents for in vivo anticancer use," finding the mark likely to cause confusion with the registered and ear-

lier-used mark ONCONASE for "pharmaceuticals, namely, cancer-treating drugs." The Board found that the similarities in the marks – particularly the suggestive meaning generated by "ONC," which connotes oncology – outweigh the differences, observing that "where the marks are used on pharmaceuticals . . . it is extremely important to avoid that which will cause confusion." Anticancer pleaded laches based on Alfacell's delay of more than seven years from the day the ONCASE mark was published for opposition before bringing this cancellation petition. The Board found this delay to be "substantial" and "unexplained," but it pointed out that Anticancer has the burden to show some detriment as a result of the delay, and it found Anticancer's evidence insufficient to establish material prejudice.

7. *In re Planalytics, Inc.*, 70 USPQ2d 1453 (TTAB 2004). For the third consecutive year, the Board issued a citable decision affirming a refusal based on an applicant's failure to comply with an Examining Attorney's request for information under *Trademark Rule* 2.61(b). The Examining Attorney required that Planalytics "submit product information for the identified goods/services" regarding its mark GASBUYER for on-line services in the natural gas field. Planalytics responded that "information regarding its services may be found on its website, located at www.planalytics.com." The Board found that response insufficient because websites often contain voluminous information and are transitory and subject to change at the owner's discretion. "Therefore, it is important that the party actually print out the relevant information and supply it to the Examining Attorney."

8. *Dallas Basketball Ltd. v. Carlisle*, Opposition No. 91156064 (Nov. 8, 2004) [not citable]. Applicant John Jacob Carlisle sought to register the mark DEEP 3 and Design for various clothing items, but Dallas opposed solely on the ground that Carlisle "failed to have a *bona fide* intention to use his mark in commerce"



when he filed the subject application. [Dallas had filed its own application to register DEEP THREE for clothing, but Carlisle had priority]. After developing his business with the assistance of friends and family, and after using the mark for two years, Carlisle formed a corporation with two of the friends. Dallas contended that Carlisle thus lacked a *bona fide* intent to use the mark in his *individual* capacity at the time of filing the application because he always had the intention of forming a business with his friends. The Board observed that "[b]y arguing that applicant did not have the *bona fide* intention to use the mark in a particular legal entity-type capacity," Dallas sought to add a requirement

not found in the *Trademark Act* or the legislative history of Section 1(b).

9. *Stoller v. Ponce*, Opposition No. 91120339 (Jan. 22, 2004) [not citable]. The Board dismissed this opposition to registration of the mark STEALTH SHELF for shelving, on the ground that frequent TTAB litigant Leo Stoller failed to introduce properly any evidence to demonstrate standing or to support any of his pleaded grounds. The “testimonial depositions” submitted by Stoller were apparently prepared by him rather than a court reporter. As to his own deposition, Stoller asked a single “question”: “I am submitting into evidence the attached affidavit of Leo Stoller in support of Opposer’s opposition.” The document was signed before a notary and an affidavit of Stoller was attached. The trial deposition of the other witness was submitted in like fashion. The Board rejected these purported testimony depositions because they violate *Trademark Rule 2.123*: affidavits may be accepted as testimony only with the written agreement of the parties. Although Applicant Karen Ponce, appearing *pro se*, did not move to strike Stoller’s testimony, the Board refused to find the rule “for taking testimony by having questions and answers recorded by an officer to be a merely technical requirement .... Rather, such a procedure goes to the very heart of the taking of an oral deposition.”

10. *Fox v. Hornbrook*, Opposition No. 91121292 (Aug. 25, 2004) [not citable]. In perhaps the worst decision of 2004, the Board sustained an opposition to registration

of the phrase DENTISTRY FOR THE QUALITY CONSCIOUS (DENTISTRY disclaimed) on the ground that the phrase is *generic* for dental services. Dr. Fox submitted various Internet pages, advertisements, and a book excerpt showing use of the phrase by dentists promoting their dental practices. The Board concluded, in a perfunctory analysis, that “such phrase is so commonly used in the field of dentistry as a designation for a high level of, or excellence in, dental care services as to be generic, in the sense that the slogan essentially denotes a category or class of dentistry to the general public as well as to members of the dental profession.” Dr. Fox had failed to claim that the phrase was merely descriptive, and so the Board, in apparent eagerness to sustain the opposition, may have chosen to force this mark into the genericness pigeonhole in order to deny registration. One is left to ponder whether there is also a category or class of dentistry called DENTISTRY FOR THE QUALITY UNCONSCIOUS?

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The TTAB seemed to glide through the year 2004 on cruise control. There were no neck-bending accelerations into new legal territory, no significant swerves from the straight-and-narrow, and certainly no U-turns. Trademark practitioners are hoping for some interesting twists and turns in the coming months. In any case, we can expect the Board to crank out another 50 dozen or so decisions in 2005, furnishing the trademark bar with much to digest, dissect, and discuss.