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Keeping Tabs on the TTAB® The Top Ten TTAB Decisions of 2005®

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Just in time for this year's list (see below), the USPTO issued a Supplemental Registration for the mark THE TOP TEN TTAB DECISIONS OF 20** for "Printed publications, namely, articles reviewing and commenting upon the decisions of the Trademark Trial and Appeal Board of the US Patent and Trademark Office." (Registration No. 3,061,302). The application was hung up in prosecution while the PTO contemplated whether the mark was unregistrable as a "phantom mark."

The Examining Attorney asserted that "'Phantom marks,' or marks that include an element that is subject to change, are unregistrable because they include more than a single mark," citing *In re International Flavors & Fragrances, Inc.*, 51 USPQ2d 1513 (Fed. Cir. 1999) ["LIVING XXXX FLAVORS"] and *Cineplex Odeon Corp. v. Fred Wehrenberg Circuit of Theatres Inc.*, 56 USPQ2d 1538 (TTAB 2000) ["—SHOW"; the broken lines "indicate a telephone prefix that will vary."]

(212) M-A-T-T-R-E-S

In response, however, yours truly argued that the Examining Attorney had applied the "phantom mark" principle much too broadly because not all marks containing elements that are "subject to change" are ineligible for registration. The CAFC made that clear in *In re Dial-A-Mattress Operating Corp.*, 57 USPQ2d 1807 (Fed. Cir. 2001), when it stepped back from its rigid one-mark-per-application stance of *International Flavors*. It ruled that Dial-A-Mattress could establish secondary meaning in connection with its application for the mark 1-888-M-A-T-R-E-S-S, based upon the acquired distinctiveness of its legally equivalent mark (212) M-A-T-T-R-E-S (shown above). [In each case "The drawing is lined to indicate that the area code will change."] The court recognized that the "212" mark is a "phantom mark" but it rejected the PTO's argument that the mark was therefore unregistrable and entitled to little weight, stating:

Although the registration of the "(212) M-A-T-T-R-E-S" mark is a "phantom" mark, the use of which we have questioned, see *In re Int'l Flavors & Fragrances, Inc.*, 51 USPQ2d 1516-17 (Fed. Cir. 1999), it is apparent in the present case that the missing information in the mark is an area code, the possibilities of which are limited by the offerings of the telephone companies. 57 USPQ2d at 1813.

Just as the possibilities with regard to an area code are limited, so are the possibilities regarding the "year element" in the "Top Ten" mark. In fact, in the latter the number of possible year elements is limited to 100, whereas in the case of area codes there are perhaps as many as 999 possibilities.

Thus, I argued, because the CAFC has indicated that the inclusion of a phantom element in a mark is not fatal to registrability, and because the possibilities for the "Top Ten" mark are fewer than for the area code mark, the PTO's phantom mark refusal should be withdrawn.

Nearly two years later, the PTO responded by withdrawing the phantom mark refusal, but maintained its Section 2(e)(1) mere descriptiveness refusal — which is why the registration issued on the Supplemental Register.

All of that leads, more or less, to this year's list. The cases chosen for inclusion here are not necessarily the Board's "best" decisions for the year. [In fact, two on this list also made last month's "Ten Worst" list.] These are simply the decisions that I think are the most interesting or important from a practical standpoint. Seven of the ten are citable. The three uncitable cases are so identified. The ten cases are not presented in any particular order.

1. *Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313 (TTAB 2005). Everyone knows that the addition of your house mark to someone else's registered mark is not enough to avoid a Section 2(d) problem, right? Wrong. Here, third-party registration evidence played a crucial role in the Board's dismissal of

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this Section 2(d) opposition to registration of the mark NORTON MCNAUGHTON ESSENTIALS for women's clothing. In light of the appearance of the word ESSENTIALS in 23 third-party registrations in the clothing field, the Board concluded that "applicant's addition of its house mark [to Opposer's ESSENTIALS mark] ... suffices to distinguish the two marks."

2. *Blue Man Productions, Inc. v. Tarmann*, 75 USPQ2d 1811 (TTAB 2005). The Board accords very broad protection to "famous" marks under Section 2(d), so it was good to see the Board raise the bar for proof of fame in this context. Here, the Board found Blue Man's evidence inadequate to support its fame claim, ruling that "in view of the extreme deference that is accorded to a famous mark in terms of the wide latitude of protection that it receives, and the dominant role that fame plays in the likelihood of confusion analysis, ... it is the duty of a plaintiff asserting that its mark is famous to clearly prove it." As to Opposer's dilution claim, the Board held that, since Opposer failed to prove the mark famous for Section 2(d) purposes, it could not possibly meet the "stricter standard" for dilution.

3. *Stoller v. Northern Telepresence Corp.*, Opposition No. 91162195 (February 11, 2005) [not citable]. The TTAB is moving inexorably toward mandatory electronic filing, and in this opposition it took another step in the ESTTA direction by ordering that the parties file all papers electronically. The Board exercised its "inherent authority to manage the cases on its docket" in order to "simplify matters" and "avoid unnecessary effort by the parties and undue delay." It ruled that it would "consider only those papers filed herein via the ESTTA system." The genesis of that ruling, and the basis for dismissal, was frequent TTAB litigant Leo Stoller's three bumbling and unsuccessful attempts to file by mail a request for an extension of time to oppose.

4. *In re Isabella Fiore, LLC*, 75 USPQ2d 1564 (TTAB 2005). In this questionable decision, the Board applied the doctrine of foreign equivalents in reversing a Section 2(e)(4) refusal of the mark FIORE for sports bags, purses, and other goods in class 18. Despite the PTO's strong evidence, the Board concluded that FIORE, an Italian word meaning "flower," is "the type of term that potential customers would stop and translate," and therefore that FIORE is not "primarily merely a surname." Completely lacking in the opinion is any consideration or analysis of the purpose of Section 2(e)(4), or the propriety of applying the doctrine of foreign equivalents in that context.

5. *In re Reed Elsevier Properties Inc.*, Serial No. 75530795 (December 16, 2005). The Board affirmed a

genericness refusal of the term LAWYERS.COM for "providing an online interactive database featuring information exchange in the fields of law, legal news and legal services." Applicant argued that its deletion of the word "lawyers" from its original recitation of services "limited its covered services," but the Board found the genus to include the provision of "information about lawyers and information from lawyers." The Board distinguished the CAFC's rulings in the STEELBUILDING.COM (*In re Steelbuilding.com*, 75 USPQ2d 1420 (Fed. Cir. 2005)), and PATENTS.COM (*In re Oppedahl & Larson LLP*, 71 USPQ2d 1370 (Fed. Cir. 2004)) cases, noting that in *Steelbuilding* the word "steelbuilding" is a double entendre, and in *Oppedahl* that only in exceptional cases will a top-level domain name (TLD) have trademark significance.

6. *First Niagara Ins. Brokers Inc. v. First Niagara Financial Group, Inc.*, 77 USPQ2d 1334 (TTAB 2005). The Board dismissed a Section 2(d) opposition because the Canadian Opposer failed to establish "use of its pleaded marks on insurance brokerage services regulable by Congress." Distinguishing this case factually from *International Bancorp L.L.C. v. Societe de Bains de Met et du Cercle des Etrangers Monaco*, 66 USPQ2d 1705 (4th Cir. 2003), the Board found Opposer's activities in the U.S. to be "minimal and incidental," and it ruled that Opposer "cannot establish priority and cannot prevail on its claim of likelihood of confusion."

7. *In re Advanced Lighting Technologies, Inc.*, Serial No. 76422584 (April 21, 2005) [not citable]. Oral argument persuaded the Board to change its mind and rule that the mark E-LAMP is not merely descriptive of metal halide lighting systems and components. In its original decision the Board affirmed the PTO's mere descriptiveness refusal, but that decision was vacated in order to give Applicant the oral hearing it had requested. "During the oral hearing, applicant's counsel made a particularly cogent argument that while the prefatory letter 'E' is readily seen as connoting 'electronic' in the context of the Internet, it is not perceived this way as used in connection with electronic devices." The Board was therefore "not persuaded that the letter 'E' is a readily recognized shorthand for 'electronic' apart from functions involving the Internet or computers."

8. *Vignette Corp. v. Marino*, 77 USPQ2d 1408 (TTAB 2005). In a decision that seems to encourage discovery gamesmanship, the Board denied Opposer's summary judgment motion on the ground that Applicant's declaration submitted in opposition to the motion raised a genuine issue of material fact, even though Applicant had failed to provide the same information in response to earlier discovery requests. The Board did not require

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Applicant to provide “substantial justification” for his withholding or show that no harm was done, as required by FRCP 37(c)(1).

9. *Turbo Sportswear, Inc. v. Marmot Mountain Ltd.*, 77 USPQ2d 1152 (TTAB 2005). The Board continued to display its concern with the issue of fraud, here allowing the Applicant to introduce fraud counterclaims even though the case was already in Opposer’s testimony period. The Board granted Applicant’s motion to amend its answer to add the counterclaims seeking cancellation of five asserted registrations, finding the motion timely because it was based on evidence of non-use of the pleaded marks that was not previously available to Applicant.

10. *Hubcap Heaven, LLC v. Hubcap Heaven, Inc.*, Concurrent Use No. 94001147 (January 28, 2005) [not citable]. Concurrent use decisions are as rare as a White Sox fan in Boston, but this otherwise mundane decision was noteworthy because of the Board’s rhetorical question regarding the continued viability of the concurrent use registration in view of growing use of the Internet. The Board noted that there is “little judicial precedent or guidance” as to the impact of Internet websites on trademark infringement suits or concurrent use proceedings. However, it declined to create an absolute rule barring geographically restricted registration when one or more of the parties does business via the Internet, instead falling back on the old rubric that “the Board must look at the facts of each case.”

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