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## Keeping Tabs on the TTAB® *The Ten Worst TTAB Decisions of 2005?*

By John L. Welch

Babe Ruth failed to hit safely 65 percent of the time. Michael Jordan missed about half his shots. So is it any wonder that, out of the 500 or so final decisions issued by the TTAB in 2005, there were a few clunkers? I list below what I believe to be the Board's ten worst decisions of the year. Obviously, these are subjective judgments, and some may disagree with one or more of my selections. My response: they're wrong.

1. ***PEI Licensing, Inc. v. Ellis, Opposition No. 91151870*** (February 24, 2005) [not citable]. This *pro se* Applicant met the fate of so many *pro se* parties at the TTAB — he lost. The Board found the mark ELLIS BLACK for clothing likely to cause confusion with the registered PERRY ELLIS mark. Ruling that “many” consumers would perceive “ELLIS” as a surname, the Board then declared that a “majority” of consumers would believe ELLIS BLACK brand clothing is a line of PERRY ELLIS clothing designed for blacks. [What a great marketing idea that would be! Not!]

2. ***In re Guber, Serial No. 76469243*** (April 22, 2005) [not citable] and ***In re Guber, Serial No. 76469246*** (June 1, 2005) [not citable]. The very same Board panel that in April found the mark CONTACT YOGA to be merely descriptive of publications on the subject of meditation and exercise, in June found the identical mark to be *not* merely descriptive of “personal exercise mats, exercise blocks and exercise straps” (YOGA disclaimed in both). In each case the same Examining Attorney relied on the same evidence regarding the descriptiveness of the phrase, but the Board inexplicably flip-flopped on the significance of that evidence and then applied the wrong test. Frankly, the Board got it right the first time.

3. ***Vignette Corp. v. Marino, 77 USPQ2d 1408 (TTAB 2005)***. In this (unfortunately) citable decision, the Board seemed to condone discovery gamesmanship when it denied Opposer's summary judgment motion on the ground that Applicant's declaration submitted in opposition to that 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 demand a “substantial justification” for his withholding of the information, nor a showing that no harm was done, as required by *Rule 37(c)(1)*, Fed. R. Civ. P.

4. ***In re Ocusoft, Inc., Serial No. 76378707*** (June 10, 2005) [not citable]. In a decision that left me rubbing my eyes, the Board found the mark NIGHT & DAY not merely descriptive of ophthalmic lubricants because the mark supposedly has a “double connotation or significance in that it evokes the ‘famous’ Cole Porter song ‘Night and Day,’” or alternatively evokes the phrase “I’ve been working night and day.” As to the former connotation, where was the proof that this song is famous now? And even if the song is famous, how does its title detract from the descriptiveness of the mark? As to the latter connotation, the usage in the phrase “working night and day” again supports the descriptiveness refusal.

5. ***Wyeth v. Graham, Opposition No. 91124967*** (October 24, 2005) [not citable]. This is the kind of decision we sometimes get when one party fails to put in any evidence or make the least effort. In finding confusion likely, the Board provided a wholly unconvincing analysis of the similarities between the marks ADVIL for analgesics and ADVALIFE for vitamins, minerals, and nutritional supplements. The fame of the ADVIL mark and the Board's extreme concern with confusion between health care products sealed Applicant's fate.

6. ***In re Isabella Fiore, LLC, 75 USPQ2d 1564 (TTAB 2005)***. In this citable but 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 and purses. Despite the PTO's strong evidence, the Board concluded that FIORE, an Italian word meaning “flower,” is “the type of term that potential custom-

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ers would stop and translate,” and therefore 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) and the propriety of applying the doctrine of foreign equivalents in that context.

7. *In re Reebok Int'l Ltd.*, Serial No. 78271326 (October 26, 2005) [not citable]. In another dubious decision regarding Section 2(e)(4), the Board reversed a surname refusal of the mark J.W. FOSTER for footwear, headwear, and clothing. Once again failing to consider the purpose behind Section 2(e)(4), the panel majority employed specious logic in reasoning that the addition of initials to the word FOSTER — which is not primarily a surname because it has other meanings — cannot yield a mark that is primarily merely a surname. The dissent had the better argument.

8. *In re Fits Corporation KK*, Serial No. 76501790 (August 24, 2005) [not citable]. In finding LOVE PASSPORT and PASSPORT confusingly similar for perfume, the Board rejected Applicant's sensible argument regarding the differing connotations of the marks, and instead embraced the PTO's position, offering a stale and unconvincing analysis regarding the significance of “love” in this context, concluding that “the additional word ‘LOVE’ merely identifies more specifically the goal or destination of the passport.”

9. *Allied Domecq Spirits & Wine USA, Inc. v. Richards, Opposition No. 91116378* (January 25, 2005) [not citable]. In sustaining this Section 2(d) opposition to the mark MALIBU ROCKS for “white chocolate covered walnuts and pecans” (MALIBU disclaimed), the Board applied a formulaic *du Pont* approach in finding a likelihood of confusion with Opposer's mark MALIBU for “liqueur.” The Board rejected Applicant's plausible argument that its mark would bring to mind “pebbles strewn on the beaches of Malibu,” and it curiously found the products to be related because they “could be served during the course of a single meal.”

10. *In re Savisa (Pty) Ltd.*, Serial No. 78154196 (February 24, 2005) [not citable]. The Board blindly applied the doctrine of foreign equivalents in finding the marks SUNRISE and SUNOP (Afrikaans for sunrise) confusingly similar for wine. It found that Afrikaans is not an obscure language and it pointed to the diversity of the U.S. population and the “innumerable” foreign languages used in the American marketplace. However, it ignored the CAFC's *Palm Bay* decision, which held that the doctrine of foreign equivalents should be applied only when the “ordinary American purchaser would ‘stop and translate [the word] into its English equivalent.’”

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