

**Decisions of the Trademark Trial and Appeal Board
and the Federal Circuit on Registrability Issues
July 2014 to Date**

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I. EX PARTE CASES

A. United States Court of Appeals for the Federal Circuit

1. Section 2(a) Disparagement.

a. *In re Tam*, 117 USPQ2d 1001 (Fed. Cir. 2015). In a ruling that rocked the trademark world, the U.S. Court of Appeals for the Federal Circuit (CAFC) deemed the disparagement provision of Lanham Act Section 2(a) unconstitutional because it violates the Freedom of Speech Clause of the First Amendment. The court observed that federal registration confers significant benefits on a trademark owner, benefits that are denied to an applicant whose mark is not registered. “The government regulation at issue amounts to viewpoint discrimination, and under the strict scrutiny review appropriate for government regulation of message or viewpoint, we conclude that the disparagement proscription of § 2(a) is unconstitutional.” The CAFC therefore vacated the decision of the Trademark Trial and Appeal Board (TTAB) that had affirmed a Section 2(a) refusal to register the mark THE SLANTS for “entertainment in the nature of live performances by a musical band” on the ground that the mark is disparaging of persons of Asian descent. [On April 20, 2016, the USPTO filed a petition for writ of certiorari, seeking Supreme Court review of the CAFC’s decision].

2. Section 2(d) Likelihood of Confusion

a. *In re St. Helena Hospital*, 113 USPQ2d 1082 (Fed. Cir. 2014). The CAFC reversed (and remanded) a TTAB decision upholding the USPTO’s Section 2(d) refusal of the mark TAKETEN for “health care services, namely, ... weight and lifestyle health improvement plans in a hospital-based residential program.” The USPTO had found the mark confusingly similar to the registered mark TAKE 10! for “printed manuals ... dealing with physical activity and physical fitness.” The CAFC concluded that the refusal to register was not supported by substantial evidence in light of the dissimilarities between the involved services and goods and the lack of evidence to support the Board’s conclusion that the factor of purchaser care was neutral. The court observed that, when the types of goods and services at issue are “well-known or otherwise generally recognized as having a common source of origin, the PTO’s burden to establish relatedness will be easier to satisfy.” However, when the relatedness of the goods and services is “obscure or less evident,” the PTO must show “something more” than the mere fact that the goods and services are “used together.” As to purchaser care, the court found no

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evidence for the Board’s conclusion that the higher level of care exercised by consumers in analyzing printed materials before they entered a health program is any different from that exercised by consumers once entered in the program.

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

a. *In re TriVita, Inc.*, 114 USPQ2d 1574 (Fed. Cir. 2015). In an enervating ruling, the CAFC affirmed the Board’s decision upholding a Section 2(e)(1) mere descriptiveness refusal of the mark NOPALEA for dietary and nutritional supplements “containing, in whole or in substantial part, nopal juice.” The court found that substantial evidence supported the Board’s determination that relevant consumers, knowing that the goods are supplements containing nopal cactus juice, would understand the mark NOPALEA to convey information that the goods contain ingredients from the Nopalea cactus; that “nopalea” is the name of a genus of cacti used in food and supplements; that “nopal” is a common name for prickly pear cacti including cacti in the genus Nopalea; and that the words “nopal” and “nopalea” are used interchangeably to refer to cacti of that genus.

b. *In re Louisiana Fish Fry Products, Ltd.*, 116 USPQ2d 1262 (Fed. Cir. 2015). The CAFC upheld a TTAB ruling requiring disclaimer of the term FISH FRY PRODUCTS in the mark shown here, for various sauces. The Board had found the phrase to be generic, and alternatively merely descriptive of the goods and lacking in acquired distinctiveness. The Board deemed FISH FRY PRODUCTS to be “highly descriptive,” and consequently Louisiana Fish Fry was faced with an “elevated burden to establish acquired distinctiveness.” The Board concluded that this burden was not met because Louisiana Fish Fry’s evidence did not relate specifically to the term FISH FRY PRODUCTS. The CAFC affirmed on the Section 2(e)(1) ground, declining to reach the genericness issue. In a concurrence, Circuit Judge Newman asserted that the court should have affirmed on the genericness ground and not reached acquired distinctiveness.



4. Section 2(e)(2) Primarily Geographically Descriptive

a. *In re The Newbridge Cutlery Co.*, 113 USPQ2d 1445 (Fed. Cir. 2015). The CAFC reversed the Board’s affirmance of a Section 2(e)(2) geographical descriptiveness refusal of NEWBRIDGE HOME for “silverware, jewelry, and kitchen goods,” ruling that substantial evidence did not support the Board’s finding that the place named by the mark (Newbridge, Ireland) is generally known to the relevant consuming public. In order to refuse registration under Section 2(e)(2), the USPTO must show (1) that the mark is the name of a place that is generally known to the public, (2) that the public would make a goods/place association in that it would believe that the involved goods originate in that place, and (3) that the involved goods come from that place. Here, the USPTO failed to meet the first requirement. Proof that Newbridge is the second largest town in its county and the seventeenth largest in Ireland revealed nothing about the perception of the American consumer. The Board noted that a place is

not necessarily “generally known” because the purchaser is informed that the mark is the name of the place. And the fact that “Newbridge” has other meanings, some geographical, also made it less likely that Newbridge, Ireland is generally known as the name of a place.

5. Genericness

a. *In re Nordic Naturals, Inc.*, 111 USPQ2d 1495 (Fed. Cir. 2014). The CAFC affirmed the TTAB’s affirmance of a refusal to register CHILDREN’S DHA for “nutritional supplements containing DHA” [DHA disclaimed], the appellate court ruling that substantial evidence supported the Board’s conclusion that the purported mark is generic for the identified goods. Relying on *In re Merrill, Lynch, Pierce, Fenner & Smith, Inc.*, 4 USPQ 2d 1141 (Fed. Cir. 1987), Nordic argued that the record included a “mixture of usages” and that the required clear evidence of genericness was therefore absent. The court, however, pointed out that in *Merrill Lynch* the evidence included multiple third-party references “that explicitly recognized Merrill Lynch as the source of the mark [*sic*].” Here, there was a lack of such third-party references. Instead the record included generic and descriptive uses of “children’s DHA.” Some references that used “children’s DHA” to refer to Nordic’s goods also used it “to describe those goods in a generic manner.” The court concluded that “sufficiently clear evidence” supported the Board’s finding that the relevant public primarily uses “children’s DHA” to refer to the category of DHA products for children.

B. Trademark Trial and Appeal Board

1. Section 2(a) Disparagement

a. *In re Beck*, 114 USPQ2d 1048 (TTAB 2015). Not surprisingly, the Board affirmed a Section 2(a) disparagement refusal of PORNO JESUS for DVDs and video recordings “featuring music videos, adult themed content, glamour photography, and adult entertainment.” The Board found it clear that the applied-for mark would have the “likely meaning” of Jesus Christ being associated with pornography, a meaning that may be disparaging to a substantial composite of Christian-Americans. Applicant Beck pointed to the existence of a sub-genre of Christian-themed pornographic movies (featuring married couples portraying married couples engaged in sex acts intended to be instructional and reflecting the beliefs of some Christians), but the Board found that this in fact suggested that the larger body of pornography does not reflect Christian beliefs. Moreover, Mr. Beck’s identification of goods was not restricted to a type of pornography that may theoretically be acceptable to certain Christians. In any case, the Examining Attorney is not required to show that all members of the referenced group would find the mark disparaging, just that a substantial composite would find it so.

2. Section 2(a) False Association

a. *In re Nieves & Nieves LLC*, 113 USPQ2d 1629 and 113 USPQ2d 1639 (TTAB 2015). In this pair of decisions, the Board affirmed refusals to register the marks PRINCESS KATE and ROYAL KATE for cosmetics, jewelry, handbags, bedding, and clothing, finding that the marks falsely suggest a connection with Catherine, Duchess of Cambridge, the wife of Prince William of England, in violation of Section 2(a). Applicant argued that

PRINCESS KATE and ROYAL KATE are not close approximations of Kate Middleton’s name or identity because she is not, in fact, a princess and she has never used either name. The Board, however, pointed out that “a term may be considered the identity of a person even if his or her name or likeness is not used. All that is required is that the mark sought to be registered clearly identifies a specific person.” The evidence established that Kate Middleton, as a member of the British Royal Family, was the subject of great public interest in the United States and throughout the world. “As the evidence establishes, the media reports what she is wearing, where she goes and what she purchases.” The Board therefore found that Kate Middleton’s identity was of sufficient fame or reputation that when applicant’s mark PRINCESS KATE and ROYAL KATE are used in connection with its goods, a connection with Kate Middleton would be presumed.

3. Section 2(a) Immoral or Scandalous

a. *In re Manwin/RK Collateral Trust*, 111 USPQ2d 1311 (TTAB 2014). The Board affirmed a Section 2(a) refusal to register the mark MOMSBANGTEENS for “entertainment services, namely, providing a web site featuring photographic, audio, video and prose presentations featuring adult-oriented subject matter,” finding the mark to be scandalous. The evidence established that “‘bang’ is a slang term used as a synonym for sexual intercourse and often regarded as vulgar.” Dictionary definitions alone were sufficient to satisfy the USPTO’s burden to establish a *prima facie* case. Applicant maintained that the Board should consider the views only of the subset of the public who consumes its services – “an adult audience seeking adult content with an adult vocabulary.” The Board disagreed. “Previous opinions affirming refusals under Section 2(a) of marks used with adult-oriented goods or services instruct that our evaluation must consider the general public’s view as to whether a mark is vulgar”

4. Section 2(c) Consent to Register

a. *In re Nieves & Nieves LLC*, 113 U.S.P.Q.2d 1629 and 113 U.S.P.Q.2d 1639 (TTAB 2015). In addition to affirming the Section 2(a) false association refusals of the marks PRINCESS KATE and ROYAL KATE for cosmetics, jewelry, handbags, bedding, and clothing (discussed above), the Board also found that, because the marks consist of or include a name identifying a particular living individual without her consent, registration was barred by Section 2(c). For purposes of this section, a “name” does not have to be a full name but may be a nickname, stage name, or the like. When the individual identified is famous or well-known, it is not necessary to show some connection between the goods or services involved and the individual. Particularly pertinent to the case at hand was *In re Steak & Ale Rest. of Am., Inc.*, 185 USPQ 447, 448 (TTAB 1975), in which the Board affirmed a Section 2(c) refusal of the mark PRINCE CHARLES for fresh and cooked meat because the proposed mark identified a particular well-known living individual whose consent was not of record.

5. Section 2(d) Likelihood of Confusion

a. Likelihood of Confusion Found

i. *In re Aquamar, Inc.*, 115 USPQ2d 1122 (TTAB 2015). Affirming a Section 2(d) refusal to register the mark MARAZUL for “fish and seafood products, namely,

frozen and fresh processed fish and seafood, and imitation crab meat,” the Board found the mark likely to cause confusion with the registered mark BLUE SEA for “non-live fish and frozen fish.” Applying the doctrine of foreign equivalents, the Board concluded that ordinary purchasers of fish would stop and translate the term MARAZUL into English. “In fact, that is essentially Applicant’s stated intention, as MARAZUL-branded fish is ‘designed to truly target the U.S. Hispanic market with authentic bilingual packaging.’” The display of several Spanish words in applicant’s packaging next to their English equivalents increased the likelihood that consumers will translate MARAZUL, as did the display of MARAZUL in blue with a nautical-themed logo, together with the phrase “productos del mar.” The exact equivalence in meaning of MARAZUL and BLUE SEA outweighed the differences in appearance and sound. The Board also affirmed a refusal based on applicant’s failure to provide a translation of MARAZUL, rejecting applicant’s contention that the word is an “arbitrary, coined, unitary” term that has no English translation.

ii. *In re i.am.symbolic, llc*, 116 USPQ2d 1406 (TTAB 2015). In three separate opinions, the Board affirmed Section 2(d) refusals to register the mark I AM for cosmetics and personal products in International Class 3, for sunglasses and sunglass cases in International Class 9, and for jewelry, watches, and other goods, including “rubber wristbands in the nature of bracelets” in International Class 14, “all associated with William Adams, professionally known as will.i.am,” in view of the registered marks I AM for perfume, I AM (Stylized) for sunglasses and jewelry, and I AM for “silicone stretchable wrist band in the nature of a bracelet.” William Adams, known as “will.i.am,” is a well-known member of The Black-Eyed Peas. Applicant, his assignee, maintained that there was no likelihood of confusion because its marks identify its famous founder, “will.i.am,” and its goods are exclusively associated with him. The Board observed, however, that purchasers are unlikely to know of the statement in the registration that applicant’s goods are limited to those associated with Mr. Adams. Moreover, even if Mr. Adams were known as “i.am” and even if the applied-for mark had gained notoriety, the Trademark Act still protects the senior user from “adverse impact due to use of a similar mark by a newcomer” – *i.e.*, reverse confusion.

iii. *In re C. H. Hanson Company*, 116 USPQ2d 1351 (TTAB 2015). In a real yawner, the Board affirmed a Section 2(d) refusal to register the mark C.H. HANSON for various hand tools in International Class 8, finding the mark likely to cause confusion with the mark HANSON registered for “Die taps and die sets, taps and tap sets ... for use with machine tools,” in Class 7, and for, *inter alia*, “hand tools, namely, wrenches, and accessories for wrenches, namely, die taps and dies sets, taps, and tap sets” in Class 8. The Marks: The Board observed that the mere addition of “C.H.” to registrant’s mark “does not obviate the similarity between the marks because consumers would be likely to believe that the marks HANSON and C.H. HANSON refer to the same person.” It concluded that the marks are similar in appearance, sound, and meaning, and highly similar in commercial impression. The Goods: According to applicant, the term “wrenches” by itself is indefinite, and therefore “the punctuation should be interpreted as limiting Registrant’s wrenches to the drives and stocks related to its taps and dies.” The Board concluded, however, that registrant’s Class 8 identification of goods encompasses ordinary wrenches, including wrenches that are “hand tools,” and is not limited to specialized tools known as “drives” and “stocks” used solely with taps and dies.

iv. *In re Bay State Brewing Company, Inc.*, 117 USPQ2d 1958 (TTAB 2016). Although consent agreements are frequently entitled to great weight in its *du Pont* analysis, the Board was unmoved by such an agreement in its affirmance of a Section 2(d) refusal of the mark TIME TRAVELER BLONDE for “beer” (BLONDE disclaimed), in view of the registered mark TIME TRAVELER for “beer, ale and lager.” The Board found that the agreement between applicant and registrant “does not comprise the type of agreement that is properly designed to avoid confusion and does not fully contemplate all reasonable circumstances in which the marks may be used by consumers calling for the goods.” The agreement required that each party use its mark in connection with its house mark, that applicant use TIME TRAVELER or the word TRAVELER only in the mark TIME TRAVELER BLONDE, that the word BLONDE be displayed in at least equal prominence with TIME TRAVELER, and that each party use a trade dress not confusingly similar to the trade dress of the other. Particularly troublesome was the “Geographical Limitation” provision, stating that applicant will not use its applied-for mark “outside of New England and the State of New York,” while registrant’s use was not geographically limited.

v. *In re Mr. Recipe, LLC*, 118 USPQ2d 1084 (TTAB 2016). In an *ex parte* context, fame is seldom a factor in the *du Pont* analysis due to lack of evidence, but here the PTO’s submissions demonstrated that JAWS “is so well-known that it set the standard for summer blockbusters.” The Board affirmed refusals to register the marks JAWS and JAWS DEVOUR YOUR HUNGER for “entertainment, namely, streaming of audiovisual material via an Internet channel providing programming related to cooking,” finding the marks likely to cause confusion with the registered mark JAWS for “video recordings in all formats all featuring motion pictures.” Fame: The PTO relied on various websites proclaiming JAWS to be one of the best movies of all time. It was “phenomenally successful” at the box office and started a marketing trend that “has become the standard for success in the film industry.” However, the fame of the cited mark alone is not enough to establish a likelihood of confusion. Similarity of the marks: The Board found that JAWS is identical to the cited mark [what a surprise!] and that JAWS DEVOUR YOUR HUNGER is similar in terms of appearance, sound, connotation, and commercial impression. Relatedness of the Goods and Services: Although applicant’s services are limited to cooking, the cited registration is not, and it encompasses videos that may feature cooking. The Board concluded that the fame of Registrant’s mark “is sufficient to broaden the scope of protection to encompass such differences.”

b. Likelihood of Confusion Not Found

i. *In re Covalinski*, 113 USPQ2d 1166 (TTAB 2014). Lisa Covalinski applied to register the mark REDNECK RACEGIRL & design for certain clothing items, but the USPTO refused registration, deeming the mark confusingly similar to the registered mark RACEGIRL for overlapping clothing items. The goods were legally identical, but are the marks close enough? The Examining Attorney maintained that the words REDNECK RACEGIRL form the dominant feature of applicant’s mark because the literal portion of a word + design mark generally makes the more significant impact on the consumer. The Board, however, pointed to prior decisions reaching the opposite



conclusion, and it found confusion unlikely because of the “crucial differences” in the marks. The graphic elements of the applied-for mark “serve not only to draw attention to the RR letters apart from the wording, but also make the letters that form the ‘a-c-e’ of the word ‘RACEGIRL’ difficult to notice.” Consumers would be likely to encounter applicant’s clothing items in a retail setting, on hang tags or neck labels, and “[i]n that context, the visual impression of the mark is likely to be more important.” And so the Board found the first *du Pont* factor dispositive, and it reversed the refusal.

ii. *In re Thor Tech, Inc.*, 113 USPQ2d 1546 (TTAB 2015). The differences in the goods and their channels of trade and the high level of purchaser care led the Board to conclude that the mark TERRAIN for “recreational vehicles, namely, towable trailers” is not likely to cause confusion with the identical mark registered for “motor land vehicles, namely, trucks.” Thor Tech submitted dozens of third-party registrations for the same or very similar marks, owned by different entities, for vehicles and recreational vehicle trailers, suggesting to the Board that “businesses in these two industries believe that their respective goods are distinct enough that confusion between even identical marks is unlikely. The Board found that this “pattern of registrations” rebutted the two third-party registrations submitted by the Examining Attorney. The Board came to a similar conclusion in *Keebler Company v. Associated Biscuits Limited*, 207 USPQ 1034, 1038 (TTAB 1980) (“The mutual respect and restraint exhibited toward each other by the owners of the plethora of marks, evidenced by their coexistence on the Register, are akin to the opinion manifested by knowledgeable businessmen”). The third-party registrations “suggest that consumers are aware that [the goods] are offered by different companies under the same or similar marks.”

iii. *In re Allegiance Staffing*, 115 USPQ2d 1319 (TTAB 2015). The Board reversed a Section 2(d) refusal to register the mark ALLEGIANCE STAFFING for “temporary employment agency services for others” [STAFFING disclaimed]. The USPTO had deemed the mark confusingly similar to eight registered marks consisting of or including the term ALLEGIS, for personnel recruitment and placement services for temporary and permanent positions. The catch-all 13th *du Pont* factor made a rare and critical appearance in applicant’s favor. The facts in this case were unusual. Applicant had owned a registration for the same mark for the same services covered by the application. During the life of that registration, five different Examining Attorneys considered the marks in the eight cited registrations and (presumably) determined that those marks were not likely to cause confusion *vis-a-vis* applicant’s then-registered mark. Turning to the other *du Pont* factors, the Board found that any similarity in pronunciation was not significant because the services are purchased by businesses, and that the conditions of purchase (4th *du Pont* factor) were significant.

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

a. *In re Datapipe, Inc.*, 111 USPQ2d 1330 (TTAB 2014). Despite numerous third-party registrations for two-word “YOUR” marks without disclaimer of YOUR, the Board affirmed a Section 2(e)(1) mere descriptiveness refusal of YOUR CLOUD for cloud computing-related services. The immediacy with which YOUR CLOUD describes Datapipe’s personalized services distinguished the applied-for mark from the other registered marks. The Examining Attorney maintained that “cloud” is the common descriptive name for a type of computer

network in which data or software is stored and accessed remotely, and the Board found that the word “cloud” is descriptive of applicant’s services. As to the word “your,” Applicant submitted third party registrations for marks containing the word YOUR without disclaimer: YOUR CHURCH (church management guidebooks), YOUR TUBE (condoms), YOUR CHEF (seasoning mixes), and YOUR NUTS! (pecan nuts). The Board, however, observed once again that it is not bound by decisions of Examining Attorneys in other cases. Moreover, most of those marks lacked the “stark immediacy” with which the word CLOUD conveys information about applicant’s services.

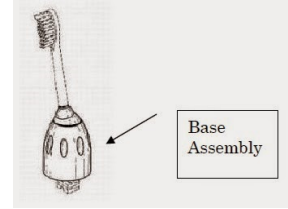
b. *In re Cannon Safe, Inc.*, 116 USPQ2d 1348 (TTAB 2015). The Board affirmed a Section 2(e)(1) refusal to register the mark SMART SERIES, finding it to be merely descriptive of “metal safes specifically designed to store firearms.” The Board agreed with the Examining Attorney that the mark describes applicant’s safes as “belonging to a larger product line” and featuring “a particular level of technology, such as microcomputers or microprocessors.” Applicant indicated that its safes will be equipped with microprocessors and microcomputers. The Board therefore concluded that the goods have a “smart” component, and applicant’s identification of goods is broad enough to include gun safes with microprocessors. Moreover, the evidence showed that the word “smart” in the field of safes has been used to describe those that include microprocessors to provide safety. As to the word SERIES, applicant uses the word “series” for several other lines of gun safes. The combination of SMART and SERIES “does not result in a mark which as a whole has a nondescriptive or incongruous meaning.” Each component retains its merely descriptive significance, resulting in a mark that is merely descriptive. Consumers will understand SMART SERIES as identifying “another of Applicant’s various series of safes, i.e., a line of safes offering enhanced capabilities made possible by the use of microprocessors.”

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

a. *In re Christopher C. Hinton*, 116 USPQ2d 1051 (TTAB 2015). In this tempest in a teapot, the Board affirmed a Section 2(e)(1) refusal to register the mark THCTea for “tea-based beverages,” finding the mark to be deceptively misdescriptive of the goods. The Board found that tea-based beverages could contain THC, the chief intoxicant in marijuana, that THCTea is merely descriptive of tea-based beverages that contain THC, that applicant’s goods (concededly) do not contain THC, and that consumers are likely to believe the misrepresentation made by the mark. The principal dispute concerned whether reasonably prudent consumers are likely to believe the misrepresentation that applicant’s beverages contain THC. Applicant Hinton maintained that consumers would know that marijuana is illegal under federal law, and that even in states having “medical marijuana” laws, use is strictly regulated. He asserted that only an unformed, gullible consumer would believe that a bottle of THCTea available in a grocery store would contain an illegal substance. The Board observed, however, that marijuana possession is considered legal, in certain circumstances, under the law of nearly half the states. Furthermore, there was some evidence in the record that teas containing THC are commercially available for medicinal use. Nothing in the subject application restricted sales of applicant’s products to states where marijuana is illegal, nor does the application indicate that the goods will not be offered through medical dispensaries.

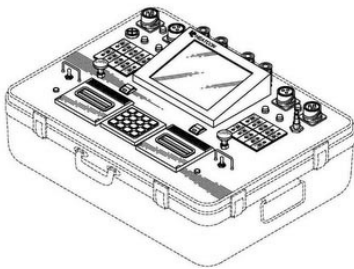
8. Section 2(f) Acquired Distinctiveness

a. *In re Koninklijke Philips Electronics N.V.*, 112 USPQ2d 1177 (TTAB 2014). The Board affirmed a refusal to register the configuration of the “base assembly” of an electric toothbrush (shown here), ruling that applicant’s evidence of acquired distinctiveness was inadequate. Of course, under *Wal-Mart*, product configurations cannot be inherently distinctive. Applicant sought registration under Section 2(f), contending that its long and continuous use of the applied-for mark, high sales figures, and evidence of infringement of its mark by competitors constituted a *prima facie* showing of acquired distinctiveness. The crucial question was whether consumers would perceive the product design as a source indicator. Although applicant’s sales figures were “not insubstantial,” the absence of detailed information regarding advertising expenditures and the lack of “look-for” advertising were major reasons for the evidentiary failure. Ten years of use and substantial sales “are not probative of purchaser recognition of a configuration as an indication of source.” And applicant’s evidence of infringement was not helpful because “[c]opying is only evidence of secondary meaning if the defendant’s intent in copying is to confuse consumers and pass off his product as the plaintiffs.”



9. Section 23(c) Functionality

a. *In re Heatcon, Inc.*, 116 USPQ2d 1366 (TTAB 2015). The Board affirmed a refusal to register the product configuration shown here, comprising the arrangement of components on a portable interface unit for “hot bonders,” finding the purported mark to be functional under Section 23(c). The Board concluded that the “overall design of Applicant’s configuration is ‘essential to the use or purpose of the article’” [*TrafFix*] and therefore that the configuration as a whole is functional and not registrable. The Board applied the CCPA’s four-part *Morton-Norwich* test in assessing functionality. The Examining Attorney cited a third-party utility patent for a



“Portable Curing System for Use with Vacuum Bag Repairs and the Like,” which claimed a carrying case and various components and explained the utilitarian advantages of the particular arrangement of the features. The Board found that the cited patent “discloses the utilitarian advantages of the various parts ... of an interface for a portable hot bonder.” In view of the “strong weight” to be accorded patent evidence under *TrafFix*, the Board found the cited patent to be sufficient to establish a *prima facie* case of functionality. Furthermore, advertising evidence supported the finding, and there was no need to consider alternative designs if functionality is found based on other considerations. Finally, there was insufficient evidence for the Board to make a determination as to the comparative costs of different designs.

10. Genericness

a. *In re ActiveVideo Network, Inc.*, 111 USPQ2d 1581 (TTAB 2014). The Board affirmed a refusal to register the purported mark CLOUDTV for software and software-

based services relating to the provision of video-on-demand, finding the term to be generic. Applicant did not contest the Examining Attorney's contention that the term "TV" is generic for its goods and services, all of which involve streaming images to an electronic device having a screen. As to the word "cloud," the definitions submitted by the Examining Attorney demonstrated that, in the context of applicant's goods and services, "cloud" will "immediately be seen as generic for packet-switched computer networks that link distant servers to one's TV, computer or other smart devices having screens." Applicant feebly argued that because it coined the term CLOUDTV, the term cannot be generic, but the Board pointed out that the first user is not entitled to register a generic term as a mark. The Board agreed with the Examining Attorney that the combination of the generic words CLOUD and TV is itself generic, since no new meaning beyond the individual meanings of the components is created by combining them. In short, the Examining Attorney established by clear evidence that the wording "Cloud TV" is a compound term that names the "central focus" or "key aspect" of applicant's goods and services, and therefore CLOUDTV is an unregistrable, generic term.

b. *In re Meridian Rack & Pinion DBA buyautoparts.com*, 114 USPQ2d 1462 (TTAB 2015). Affirming a refusal to register BUYAUTOPARTS.COM on the Supplemental Register, the Board found the term to be generic for "on-line retail store services featuring auto parts." Applicant argued that the word "buy" does not identify a genus of services associated with "selling," but the Board didn't buy it. The Board found the genus of services to be adequately defined by applicant's recitation of services. The relevant public consists of general consumers of auto parts. The issue, then, was the public's understanding of the term, considered as a whole. Applicant contended that, at most, "BUYAUTOPARTS.COM merely conveys the message that consumers may purchase auto parts from Applicant online, if consumers desire to do so, but does not describe Applicant's 'selling.'" The Board was not persuaded: the central focus of any retail sales service is to facilitate "buying." In short, "buying" is directly related to "selling." The Board has often held that a term that names the "central focus" or "key aspect" of a service is generic for that service. The addition of a top level domain indicator to the generic name of the central focus or subject matter of a service does not transform the composite phrase into a registrable mark.

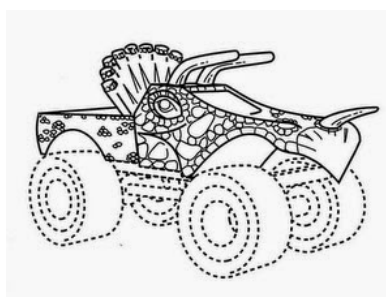
11. Failure to Function/Unacceptable Specimen of Use

a. *In re McGowan Publishing Co.*, 111 USPQ2d 2000 (TTAB 2013). The Board reversed a refusal to register the mark CASHFLOW UNITS for "investment products, namely, wealth management and performance tracking, and providing financial advisory and financial portfolio management services." The Examining Attorney had deemed the specimen web page unacceptable because it did not display the mark in association with the recited services. The Board, however, found that links labeled with the mark, connecting to documents used in the rendering of the services, supplied the required association. The Board observed that the web page informed the reader that applicant is a "federally Registered Investment Advisory Firm." Moreover, the wording "McGowan Group Asset Management" at the top of the page "informs the viewer that CASHFLOW UNITS are part of an asset management service." The Board concluded that "a client or prospective client ... would view the mark on the web page in close proximity to links for documents used in rendering those services." The link to the agreement "functions as an offer to enter into an arrangement for the provision of 'Advisory'

services relating to the client’s assets. Thus the links to these documents create an association between the mark and the offered services activity.”

b. *In re Chengdu AOB Information Technology Co.*, 111 USPQ2d 2080 (TTAB 2011). For some reason, the TTAB re-designated as precedential this three-year old decision affirming a refusal to register the mark IOBIT on the Supplemental Register for computer programming, software design, data conversion, web site hosting, computer maintenance, and related services. The USPTO deemed the specimen – a screenshot from applicant’s website – unacceptable because the only mention of services was as follows: “Our sincere commitment to all our customers is that we will continue delivering innovative system utilities that are as simple to use as they are powerful and reliable. We also promise that we will keep providing the first-class free software and online service, for personal or non-commercial use We pursue the genuine ambition of becoming one of the world’s top utility producers and Windows system service providers on the Internet.” The Board found these vague references to be insufficient: “In fact, we cannot determine from this specimen whether the ‘online service’ refers to a separate service, or is merely part of the free software product. Nor is applicant’s stated ambition to be a Windows system service provider an indication that applicant is providing a service now, and this statement certainly does not show that applicant is offering any of the services specified in the application.”

c. *In re Frankish Enterprises Ltd.*, 113 USPQ2d 1964 (TTAB 2015). The Board reversed a refusal to register the mark shown here, comprising a “truck cab body in the design of a fanciful, prehistoric animal,” for “entertainment services, namely performing and competing in motor sports events in the nature of monster truck exhibitions.” The Examining Attorney contended that applicant’s design fails to function as a service mark because monster trucks appear in a wide variety of designs and applicant’s design would not be perceived as a source indicator. The Board first noted that, although product designs cannot be inherently distinctive, product packaging trade dress and trade dress for services can be. The Board found applicant’s proposed mark to be “akin to the packaging of what is being sold.” Under *Two Pesos*, trade dress for services may be inherently distinctive. Applying the CCPA’s *Seabrook* test, the Board found the mark to be unique and unusual, and therefore inherently distinctive.



d. *In re Graystone Consulting Associates, Inc.*, 115 USPQ2d 2035 (TTAB 2015). The Board affirmed a refusal to register the mark WALK-IN SHOPPER for “business training consultancy services” on the ground that the specimen of use failed to show use of the mark in connection with the identified services. The Board agreed with the Examining Attorney that the applied-for phrase merely refers to the subject of applicant’s consulting and training services and is not used as a source indicator for applicant’s services. “Applicant is using ‘Walk-In-Shopper’ to identity a particular customer, i.e., one who ‘visit[s] a funeral home in advance to determine which firm they will choose.’” “This is evident from the use of the term in lower cases letters (‘targeting the walk-in-shopper’) and from the content of the paragraph which is referring

to an individual identified as a walk-in shopper.” Although the “TM” symbol appeared after the phrase, the mere reference to “training and consulting” was not enough to create the needed association between mark and services. The text that followed the phrase referred to the target customer, making it clear that the phrase was being used to refer to the customer, not to the services.

12. Failure to Verify Application

a. *In re Brack*, 114 USPQ2d 1338 (TTAB 2015). Here’s a shocker: a trademark application must be verified! The Board affirmed a refusal to register the mark SIMPLY ORANGECELLO for orange flavored liqueur because the applicant never satisfied the verification requirement. In fact, applicant never even addressed that refusal to register, either during prosecution of the application or during the appeal. The Board observed that an applicant filing a Section 1(b) application must submit a verified statement that the applicant has a *bona fide* intention to use the mark in commerce in connection with the identified goods and/or services. Here, the original application (filed by applicant himself) was unsigned. Although all of applicant’s communications submitted after the original application were properly signed by applicant’s attorney, none contained the required averments and thus they did not satisfy the verification requirement. “A simple and straightforward requirement, it nonetheless is necessary to support the averments made in an application. Applicant failed to comply with this requirement despite clear and repeated admonitions from the Examining Attorney.”

13. Primacy of Statute over Internal Examination Procedures

a. *In re House Beer, LLC*, 114 USPQ2d 1073 (TTAB 2015). Affirming a refusal to register the mark HOUSE BEER for “retail store services featuring beer,” the Board found the mark likely to cause confusion with the identical mark for “beer.” Applicant focused on certain procedures that were not followed during examination of the application underlying the cited registration (the “Underlying Application”) and during examination of its application. The Underlying Application was filed under Section 1(b), prior to applicant’s filing date, but it was later amended to seek registration on the Supplemental Register, such that the effective filing date became the date of filing the allegation of use. When the allegation of use was filed, applicant’s application was suspended in view of the Underlying Application, but the change in effective filing date for the Underlying Application (and applicant’s resulting priority) went unnoticed by both the PTO and the applicant. Before the Board, applicant requested that the refusal be deemed invalid because the pertinent examination procedures were not followed, but the Board observed that it cannot give the internal examination procedures primacy over statutory law. In short, “the Examining Attorney’s refusal, being required by the express terms of Section 2(d), is not rendered invalid by the procedural mishaps described herein.”

14. Request for Remand versus Request for Reconsideration

a. *In re Hughes Furniture Industries, Inc.*, 114 USPQ2d 1134 (TTAB 2015). Applicant sought to register the word + design mark shown here, for “furniture” (FURNITURE, and RECLINERS disclaimed), but the Examining Attorney refused registration both under

Section 2(d), finding the mark likely to cause confusion with the registered mark BRADLEY HUGHES for “residential and commercial furniture,” and for failure to disclaim the word



”motion.” After filing its notice of appeal, applicant requested a remand to the Office for entry of the required disclaimer of the word “motion,” in order to moot that issue on appeal. The Examining Attorney entered the disclaimer but also submitted additional Internet

evidence in further support of her likelihood of confusion refusal. Not allowed, said the Board.

The Examining Attorney improperly treated the request for remand as a request for reconsideration of the entire final refusal. However, the time had expired for a request for reconsideration. The request for remand related only to the disclaimer requirement and not the Section 2(d) refusal, and so it was impermissible for the Examining Attorney to submit new evidence on the latter issue. The Board noted that the Examining Attorney could have filed her own request for suspension of the appeal and remand, upon a showing of good cause, for the purpose of submitting new evidence regarding likelihood of confusion. And so the Board sustained applicant’s objection to the additional evidence, but it nonetheless affirmed the refusal to register under Section 2(d).

15. Application of the “Clear Error” Standard

a. *In re Driven Innovations, Inc.*, 115 USPQ2d 1261 (TTAB 2015). After receiving a notice of allowance, applicant filed its statement of use. The Examining Attorney determined that the applied-for mark was merely descriptive of the services, and entered a Section 2(e)(1) refusal. On appeal, applicant argued that the refusal was improper because it was not the result of a “clear error.” Under the “clear error” standard (Section 1109.08 of the TMEP), an Examining Attorney, when examining a Statement of Use, “should not make a requirement or refusal concerning matters that could or should have been raised during initial examination, unless the failure to do so in initial examination constitutes a clear error, *i.e.*, would result in issuance of a registration in violation of the Act or applicable rules.” The Board held that “an applicant may not directly challenge the Office’s determination under the clear error standard and that the only way an applicant may challenge a refusal that was issued during examination of the statement of use under the clear error standard is by appealing the merits of that final refusal to the Board.” Although the USPTO does have a policy that all possible refusals and requirements should be included in the first Office Action, that is not a requirement of the statute or any rule. “The Office has the inherent discretion to issue a requirement or refusal that it finds is correct at any stage of the prosecution in an application.”

II. INTER PARTES CASES

A. United States Supreme Court

1. Issue Preclusion

- a. *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 113 USPQ2d 2045 (2015).

In an attention-grabbing decision, at least in trademark circles, the Supreme Court ruled that, in an action for trademark infringement, “[s]o long as the other ordinary elements of issue preclusion are met, when the uses adjudicated by the TTAB are materially the same as those before the district court, issue preclusion should apply” to the determination of likelihood of confusion. The Court reversed the decision of the U.S. Court of Appeals for the Eighth Circuit, which had held that the TTAB decision in favor of B&B was not entitled to preclusive effect because, *inter alia*, the TTAB and the Eighth Circuit use different factors to evaluate the issue. The Court, however, concluded that, despite some differences in the factors applied by the TTAB and the Eighth Circuit in assessing likelihood of confusion, the test were not fundamentally different. The standard for purposes of registration is the same as for purposes of infringement. But the Court observed that if the TTAB does not consider the marketplace usage of the parties’ marks, the TTAB’s decision should “have no later preclusive effect in a suit where actual usage in the marketplace is the paramount issue.”

B. United States Court of Appeals for the Federal Circuit

1. Section 2(d) Likelihood of Confusion

a. Likelihood of Confusion Not Found

i. *Stoncor Group, Inc. v. Specialty Coatings, Inc.*, 111 USPQ2d 1649 (Fed. Cir. 2014). In a straightforward ruling, the CAFC affirmed the Board’s decision dismissing on opposition to registration of the mark ARMORSTONE for, *inter alia*, epoxy coating for use on concrete industrial floors. The Board found the applied-for mark not likely to cause confusion with the registered mark STONSHIELD [as well as the registered marks STONCLAD and STONHARD] for goods that include epoxy hardeners; and it also found the applied-for mark not merely descriptive of applicant’s epoxy coatings. The CAFC ruled, however, that the Board erred in considering the pronunciation of the “STON-” prefix. The Board concluded that “STON-” would be pronounced by prospective consumers “according to the spelling of ‘STON,’ with a short ‘o’ sound.” The CAFC, noting that “[t]here is no correct pronunciation of a trademark that is not a recognized word,” concluded that the Board’s pronunciation analysis was not supported by substantial evidence because the Board improperly failed to credit StonCor’s evidence that consumers would pronounce “STON” as “stone.” However, the error was deemed harmless.

ii. *Juice Generation, Inc. v. GS Enterprises LLC*, 115 USPQ2d 1671 (Fed. Cir. 2015). The CAFC vacated and remanded the TTAB’s decision that had found the mark PEACE LOVE JUICE & Design, shown here, for “juice bar services” [JUICE disclaimed] likely to cause confusion with the registered mark PEACE & LOVE for “restaurant services.” The appellate court concluded that the Board “did not adequately assess the weakness of GS’s



mark and did not properly consider the three-word combination of Juice Generation’s mark as a whole.” The CAFC found that the Board’s treatment of the evidence of use of third-party marks did not sufficiently appreciate the force of that evidence. Even though specific evidence as to extent and impact of use was not submitted, the evidence was “nonetheless powerful on its face.” Third party registrations, the court observed, are relevant to show that some segment of a mark has a “normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that the segment is relatively weak.” Of course, weak marks merit less protection on the Section 2(d) battlefield.

iii. *Jack Wolfskin Ausrüstung für Draussen GmbH & Co. KGaA v. New Millennium Sports, S.L.U.*, 116 USPQ2d 1129 (Fed. Cir. 2015). The CAFC overturned the Board’s decision that found the two marks shown here to be confusingly similar for various clothing items. The court agreed with Jack Wolfskin that the Board failed to adequately consider the literal part of the cited mark, the word KELME. The Board essentially ignored the verbal portion and found that the two paw print designs were substantially similar. In short, it did not consider the marks as a whole. Moreover, Jack Wolfskin provided voluminous evidence of paw print design elements registered and used for clothing, but the Board for the most part discounted that evidence. Such extensive evidence of third-party use, as explained in the CAFC’s *Juice Generation* decision, is “powerful on its face” even when the specific extent and impact of the usage has not been proven. Here, the evidence demonstrated “the ubiquitous use of paw prints on clothing as source indicators.” The court therefore reversed and remanded the case to the Board for further consideration in light of this ruling.



2. Genericness

a. *Princeton Vanguard, LLC v. Frito-Lay North America, Inc.*, 114 USPQ2d 1827 (Fed. Cir. 2015). The CAFC vacated the TTAB’s decision that had found the term PRETZEL CRISPS to be generic for “pretzel crackers.” The court remanded the case to the Board for application of the correct legal standard set forth in the *Marvin Ginn* decision, concluding that the Board had focused on the constituent words and had failed to consider evidence of the relevant public’s understanding of PRETZEL CRISPS in its entirety. The Board deemed PRETZEL CRISPS to be a compound term, not a phrase, and evaluated the individual terms under *In re Gould*. “Where, as here, the record is replete with evidence of the public’s perception of the term PRETZEL CRISPS as a whole, it is unclear why the Board would resort to analyzing the terms individually or why it would believe doing so would aid its analysis.” The CAFC particularly noted the Board’s questionable treatment of the survey evidence of record. The Board seemingly considered the respective survey evidence of the parties as cancelling each other out, but it did not explain why

3. Lack of *Bona Fide* Intent

a. *M.Z. Berger & Co. v. Swatch AG*, 114 USPQ2d 1892 (Fed. Cir. 2015). The CAFC affirmed the decision of the TTAB sustaining Swatch’s opposition to registration of

the mark iWatch, in standard character form, for watches, clocks, and related goods, on the ground of lack of *bona fide* intent. The CAFC first considered whether lack of *bona fide* intent is a proper basis for challenging a trademark application. The TTAB has long so ruled, and the court agreed. An opposer is “entitled to rely on any statutory ground which negates appellant’s right to the subject registration.” The CAFC held that “whether an applicant had a ‘bona fide intent’ to use the mark in commerce at the time of the application requires objective evidence of intent. *** Although the evidentiary bar is not high, the circumstances must indicate that the applicant’s intent to use the mark was firm and not merely an intent to reserve a right in the mark. *** The Board may make such determinations on a case-by-case basis considering the totality of the circumstances.” The court ruled that the Board applied the correct legal standard and that substantial evidence supported the Board’s finding that Applicant Berger’s intent at the time it filed the application at issue “was merely to reserve a right in the mark, and not a bona fide intent to use the mark in commerce.”

4. Service Mark Use

a. *Couture v. Playdom, Inc.*, 113 USPQ2d 2042 (Fed. Cir. 2015). The CAFC affirmed a decision of the TTAB that ordered cancellation of a registration for the mark PLAYDOM for certain entertainment services. The appellate court agreed with the Board that the registration was void *ab initio* because Registrant David Couture had not used the mark in the rendering of the services prior to filing his underlying Section 1(a) application. When seeking registration based on use in commerce under Section 1(a), an Applicant must have used the mark in commerce with the listed goods or services as of the filing date of the application. Section 45 provides that a service mark is in use in commerce “when it is used or displayed in the sale or advertising of services and the services are rendered in commerce” The Board found that the appellant had not rendered the identified services as of the application filing date. He had “merely posted a website advertising his readiness, willingness, and ability to render said services.”

5. Cuban Cause of Action for Cancellation

a. *Empresa Cubana Del Tabaco v. General Cigar Co.*, 111 USPQ2d 1058 (Fed. Cir. 2014). The CAFC vacated the TTAB’s decision dismissing a petition for cancellation of two registrations for the mark COHIBA for cigars. The Board had ruled that Petitioner Empresa (Cubatabaco) lacked standing in view of the decision of the U.S. Court of Appeals for the Second Circuit in *Empresa Cubana Del Tabaco dba Cubatabaco v. Culbro Corp.*, 399 F.3d 462 (2nd Cir. 2005). The CAFC, however, held that the question of cancellation was not decided by the Second Circuit, and it concluded that Cubatabaco has a statutory “cause of action” that is not barred by the Cuban Assets Control Regulations (CACR). The Second Circuit held that the district court could not grant Cubatabaco injunctive relief since that remedy would entail a prohibited transfer of property under the CACR because Cubatabaco would acquire ownership of the mark. But the Second Circuit did not address the cancellation issue and its decision on the non-availability of injunctive relief was irrelevant here. Cubatabaco is authorized to seek cancellation under the general license provided by the CACR that allows Cuban entities to engage in transactions “related to the registration and renewal” of trademarks, including a petition to cancel a prior registration.

C. Trademark Trial and Appeal Board

1. Section 2(a) Disparagement

a. *Blackhorse v. Pro-Football, Inc.*, 111 USPQ2d 1080 (TTAB 2014). A divided TTAB panel granted a petition for cancellation of six registrations for marks containing the word REDSKINS, finding that the marks, at their respective dates of registration, disparaged Native Americans. The test for disparagement under Section 2(a) has two parts: (1) what is the meaning of the term as it appears in the mark and as the mark is used?; (2) does the meaning disparage Native Americans? As to the first, the Board concluded that the term REDSKINS, when used in connection with professional football, means Native Americans. As to the second, based on a general analysis of the word (dictionary definitions, reference books, and expert testimony), and the specific views of the referenced group (deposition testimony, newspaper articles, official records, personal letters, and a 1993 Resolution of the National Congress of American Indians), the majority concluded that “a substantial composite of Native Americans found the term REDSKINS to be disparaging in connection with respondent’s services during the relevant time frame of 1967-1990.” Judge Bergsman dissented, pointing to the lack of evidence that the term was disparaging when used in connection with sports teams. [The TTAB’s ruling was affirmed on review by the U.S. District Court for the Eastern District of Virginia (115 USPQ2d 1524), a ruling that is now on appeal to the United States Court of Appeals for the Fourth Circuit. On April 25, 2016, Pro-Football, Inc. filed a petition for writ of certiorari before judgment, seeking Supreme Court review of the District Court’s ruling].

2. Section 2(a) False Association

a. *Nike, Inc. v. Palm Beach Crossfit Inc. d/b/a Crossfit CityPlace*, 116 USPQ2d 1025 (TTAB 2015). The Board granted Applicant Palm Beach Crossfit’s motion to dismiss two of Nike’s four claims in this opposition proceeding, finding that Nike had inadequately pleaded claims under Section 2(a) and 2(c) of the Lanham Act. Nike asserted that applicant’s design mark (left), for athletic clothing and athletic training services, would falsely suggest a connection with Michael Jordan, and further that the mark comprises a portrait of a living individual (Jordan) without his consent. Nike’s Section 2(d) and 43(c) claims, which were based on Nike’s ownership of registrations for the mark shown on the



right, survived. As to the Section 2(a) refusal, the “initial and critical requirement” for a false association claim is that the identity allegedly misappropriated is unmistakably associated with the person identified. Nike claimed that applicant’s “handstand” mark falsely suggests a connection with Michael Jordan – but the hoop star was not a party to the proceeding. The Board therefore dismissed Nike’s Section 2(a) claim.

b. *Boston Athletic Association v. Velocity, LLC*, 117 USPQ2d 1500 (TTAB 2015). The Board dismissed this Section 2(a) opposition to registration of the mark MARATHON MONDAY for various clothing items, ruling that applicant’s mark does not falsely suggest a connection with Opposer’s name or identity. Opposer BAA asserted that BOSTON MARATHON is its persona and that MARATHON MONDAY is a close approximation of BOSTON MARATHON. The Board agreed with the first point but not the

second. Although the two marks share the common word “marathon,” MARATHON MONDAY is not a close approximation of BOSTON MARATHON. Nor did MARATHON MONDAY *per se* qualify as the BAA’s identity. While there was evidence that the BAA has to some extent used the term “Marathon Monday” to identify the race itself, there was insufficient evidence to show that the public recognizes “Marathon Monday” as identifying not only the race, but also the entity that organizes the race. Moreover, Applicant’s evidence established that other entities use “Marathon Monday” to refer to other marathons, and therefore Opposer failed to satisfy the second element of the Section 2(a) test: that MARATHON MONDAY point uniquely to Opposer BAA.

3. Section 2(c) Consent to Register

a. *Nike, Inc. v. Palm Beach Crossfit Inc. d/b/a Crossfit CityPlace*, 116 USPQ2d 1025 (TTAB 2015). With reference to the case discussed above, Section 2(c) bars registration of a mark that consists of or comprises the portrait of a “particular living individual” without his or her consent. Opposer alleged that it has a licensing relationship with Michael Jordan, but did not assert that the “licensing relationship” gave it a proprietary right to assert a Section 2(c) claim on Jordan’s behalf, and therefore the Board dismissed the Section 2(c) claim for insufficient pleading.

4. Section 2(d) Likelihood of Confusion

a. Likelihood of Confusion Found

i. *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419 (TTAB 2014). The Board sustained a Section 2(d) opposition to registration of the mark BRUCE WINSTON (son of Harry Winston and Chairman of applicant) for gemstones and fine jewelry, finding the mark likely to cause confusion with the mark HARRY WINSTON and the registered mark WINSTON for jewelry. The strength of the WINSTON mark and the fame of the HARRY WINSTON mark, coupled with the overlap in goods, carried opposer to this gem of a victory. Opposers submitted voluminous examples of advertising and promotional materials. Its sales figures and advertising expenditures were “extremely substantial.” The Board found that through extensive public relations efforts, the mark HARRY WINSTON has become famous in the field of jewelry. Furthermore, the record demonstrated that the press often uses WINSTON as an abbreviated reference to the HARRY WINSTON brand, leading the Board to conclude that WINSTON is a very well-known source indicator in the jewelry field. The mark BRUCE WINSTON might well be seen as a “more specific reference to a person or company that is otherwise identified by the designation WINSTON.” In finding the marks BRUCE WINSTON and HARRY WINSTON to be similar, the Board pointed out that a famous mark “casts a long shadow which competitors must avoid.”

ii. *McDonald’s Corp. v. McSweet, LLC*, 112 USPQ2d 1268 (TTAB 2014). The Board sustained McDonald Corporation’s opposition to registration of the mark MCSWEET for pickled gourmet vegetables, finding the mark likely to cause confusion with, and likely to dilute, opposer’s “MC” family of marks for restaurant services and food products. Based on opposer’s staggering sales and advertising figures and its “extraordinarily impressive

number of products,” the TTAB concluded that the family of marks consisting of the prefix “MC” followed by a descriptive or generic term is famous for Section 2(d) and Section 43(c) purposes. In considering the marks, “the question is ... whether Applicant’s mark would likely be viewed as a member of Opposer’s family of marks.” Applicant acknowledged that its mark was created by Leo McIntyre using “MC” from his surname and “SWEET” to describe the sweet brine used to pickle onions. Considering the relevant *du Pont* factors, the Board found confusion likely and it sustained the Section 2(d) claim. [The dilution claim is discussed below].

iii. *Fiserv, Inc. v. Electronic Transaction Systems Corp.*, 113 USPQ2d 1913 (TTAB 2015). The Board highly commended the parties for choosing to resolve this Section 2(d) opposition under the ACR regime. The parties agreed to forego discovery and disclosures, and submitted stipulations of facts and briefs with attached evidence, but no testimony. The Board sustained the opposition, finding the mark PMONEY likely to cause confusion with the registered mark POPMONEY (in standard character and design forms), for financial services that included electronic funds transfer. Applicant claimed that “pop” has a descriptive meaning as applied to opposer’s services, but the evidence was scanty and unpersuasive. There was no evidence that the shared term, consisting of P plus MONEY, is commonly used by third parties or has any meaning in relation to the services. The Board concluded that the marks are substantially similar, finding it likely that applicant’s mark PMONEY would be perceived as an abbreviation of POPMONEY, since consumers “have a universal habit of shortening full names – from haste or laziness or just economy of words.”



iv. *Anheuser-Busch, LLC v. Innvopak Systems Pty Ltd.*, 115 USPQ2d 1816 (TTAB 2015). The TTAB sustained an opposition to registration of the mark WINEBUD for various alcoholic beverages, including wine, “except beers,” finding the mark likely to cause confusion with the famous mark BUD registered for beer. The Board deemed the marks to be highly similar, the involved goods to be related, and the channels of trade and classes of consumers overlapping. The goods are purchased by ordinary consumers who are unlikely to exercise care in their purchases. As to the marks, Applicant argued that WINEBUD is a “fanciful compound noun formed from the nouns WINE and BUD, an analogy to horticultural words such as ‘rosebud,’” but there was no evidence that WINEBUD has any meaning. As to the goods, the Board has found beer and wine to be related on a number of occasions, and it did so here. Opposer’s survey found that 24 percent of respondents believed that a wine sold under the WINEBUD mark would be “put out by, affiliated or connected with, or approved or sponsored by” Opposer. Applicant alleged flaws in the survey, but the Board concluded that it was admissible and probative.

v. *The North Face Apparel Corp. v. Sanyang Industry Co., Ltd.*, 116 USPQ2d 1217 (TTAB 2015). The Board upheld in part North Face’s Section 2(d) opposition to registration of the mark shown on the left, for a variety of goods and services in Classes 7, 11, 12, 16, 25, 35, and 37, including motorcycles, electric bicycles, various clothing items, and auto repair services, in view of the registered mark shown on the right, for footwear, backpacks, sleeping bags, and clothing. North Face contended that Sanyang’s mark is merely the North Face

mark turned on its side, whereas Sanyang asserted that its mark suggests a wheel in motion. The



Board found that, on the whole, the similarities between the marks outweighed the dissimilarities. The Board sustained the opposition as to Sanyang's clothing items in Class 25, some of which were identical to the North Face's goods. Sanyang acknowledged that its retail stores featuring clothing, textiles, and clothing accessories "are related to [Opposer's] class 25

goods," and so the Board sustained the opposition as to Class 35. As to the Sanyang's remaining goods and services, the evidence of relatedness was insufficient or totally lacking, and the Board dismissed the opposition as to the goods and services in Classes 7, 11, 12, 16, and 37.

b. Likelihood of Confusion Not Found

i. *ProMark Brands Inc. and H.J. Heinz Company v. GFA Brands, Inc.*, 114 USPQ2d 1232 (TTAB 2015). The Board gave the cold shoulder to this consolidated opposition to registration of the mark SMART BALANCE for frozen entrees and for various snack foods and desserts, finding the mark not likely to cause confusion with the registered mark SMART ONES for various types of frozen foods, including entrees, desserts, ready-to-eat wraps, pizzas, and breakfast foods. The Board concluded that the marks are significantly different, particularly in view of the weakness of the formative "SMART," the seventeen-year period of conflict-free coexistence of the parties' marks (but not for frozen foods), and applicant's corroborating survey evidence and expert testimony. A large portion of the Board's opinion focused on the expert testimony and survey evidence. Opposers' likelihood of confusion survey purported to show a 32% likelihood among the 250 respondents surveyed, but the Board found the survey to be fatally flawed, primarily because the pivotal question was close-ended and failed to ask "why?" Applicant's survey, on the other hand, comported with best practices. It reported a 2% likelihood of confusion among relevant purchasers, based on 410 respondents, and the Board found that this supported a conclusion that confusion is not likely.

5. Dilution by Blurring

a. *McDonald's Corp. v. McSweet, LLC*, 112 USPQ2d 1268 (TTAB 2014). As discussed above, the Board sustained McDonald Corporation's opposition to registration of the mark MCSWEET for pickled gourmet vegetables, finding the mark likely to cause confusion with, and likely to dilute, opposer's "MC" family of marks for restaurant services and food products. Based on opposer's staggering sales and advertising figures and its "extraordinarily impressive number of products," the TTAB concluded that the family of marks consisting of the prefix "MC" followed by a descriptive or generic term is famous for Section 2(d) and Section 43(c) purposes. In considering the marks, "the question is ... whether Applicant's mark would likely be viewed as a member of Opposer's family of marks." As to the dilution claim, the Board ruled that the term "famous mark" in Section 43(c)(2)(B) is applicable to a "famous family of marks." Considering the relevant dilution factors, including the six "blurring" factors of Section 43(c)(2)(B)(i)-(vi), the Board found that the mark MCSWEET "is likely to impair the distinctiveness of Opposer's family of 'MC' marks and is therefore likely to cause dilution by blurring within the meaning of Section 43(c)."

b. *New York Yankees Partnership v. IET Products and Services, Inc.*, 114 USPQ2d 1497 (TTAB 2015). An augmented panel sustained an opposition to registration of the mark THE HOUSE THAT JUICE BUILT for T-shirts, baseball caps, hats, jackets and sweatshirts, the mark “THE HOUSE THAT JUICE BUILT” (with quotation marks) for mugs, and the design mark shown here for “T-shirts, baseball caps, hats, jackets and sweatshirts,” finding the first two marks likely to cause dilution-by-blurring of the Yankees’ registered mark THE HOUSE THAT RUTH BUILT and the third likely to dilute its “Top Hat” design mark. The Board declined to consider applicant’s parody defense because applicant asserted an intention to use its marks as source indicators, which is neither a noncommercial use nor a “fair use” exempted from a dilution claim. Fame: Applicant conceded that opposer’s Top Hat logo is distinctive, and the Board found the mark to be famous for dilution purposes. Applicant also conceded that THE HOUSE THE RUTH BUILT is famous as referring to Yankee Stadium, but contended that it is not famous as a trademark. The Board, however, found that the Yankees’ “use of its stadium ... since the 1920s, has resulted in widespread recognition of that mark in association with Opposer’s baseball services.” Dilution or Not?: the Board ruled that Applicant’s design mark “would impair the distinctiveness of Opposer’s top hat design marks and would not constitute a non-source-indicating fair use parody.” Its analysis was similar for THE HOUSE THE RUTH BUILT.



6. Fraud

a. *Nationstar Mortgage LLC v. Ahmad*, 112 USPQ2d 1361 (TTAB 2014). In a case perhaps more significant as a curiosity than as a jurisprudential landmark, the Board sustained a fraud claim for the first time since the CAFC issued its decision in *In re Bose Corp.*, 91 USPQ2d 1938 (Fed. Cir. 2009), which raised the bar for proof of fraud on the USPTO. The Board upheld an opposition to registration of the mark NATIONSTAR for, *inter alia*, real estate brokerage, residential and commercial property and insurance brokerage, and mortgage brokerage services. It found that Applicant Ahmad’s averments as to his use of the NATIONSTAR mark for the identified services were fraudulent. Ahmad testified that he chose the name in 2004-2005 after checking corporate records and the USPTO databases. Opposer Nationstar Mortgage contacted Ahmad in early April 2006, and within days, Ahmad himself filed the application at issue under Section 1(a). However, he was not a real estate broker, insurance broker, or mortgage insurance broker, each of which requires a state license. Ahmad’s testimony regarding use as of his filing date was of grave concern to the Board because it was “so lacking in conviction and credibility as to be virtually incapable of corroboration.” Although Ahmad had been allowed, after the opposition was filed, to amend his filing basis to Section 1(b) intent-to-use, the Board observed that fraud cannot be cured once an opposition is filed.

7. Laches

a. *Ava Ruha Corporation dba Mother’s Market & Kitchen v. Mother’s Nutritional Center, Inc.*, 113 USPQ2d 1575 (TTAB 2015). In this consolidated cancellation proceeding involving allegations of likelihood of confusion, dilution, and fraud, the parties filed cross-motions for summary judgment on respondent’s affirmative defense of laches. Because

laches is not an available defense to a fraud claim, the Board considered laches only with respect to the dilution and likelihood of confusion claims. In order to establish the defense of laches, a party must show undue or unreasonable delay by the other party in asserting its rights, and prejudice resulting from the delay. The Board found the period of delay to be just over three years and two months, a length of delay that “could support a defense of laches.” Petitioner claimed that its delay was excusable due to Respondent’s “progressive encroachment,” but its evidence failed to raise a genuine issue of fact in that regard. The Board concluded that laches barred petitioner’s dilution claim, but as to likelihood of confusion a genuine issue of material fact as to whether confusion was inevitable precluded summary judgment. The Board ordered that the proceeding be resumed on the issues of fraud and likelihood of confusion, with Petitioner having the burden to prove inevitable confusion lest the Section 2(d) claim be barred by laches.

8. Lack of *Bona Fide* Intent

a. *Swiss Grill Ltd., John Hartwig, Christopher Hartwig and Matthew Hartwig v. Wolf Steel Ltd.*, 115 USPQ2d 2001 (TTAB 2015). In a case decided under the TTAB’s Alternative Case Resolution (ACR) procedure, the Board sustained an opposition to registration of the mark SWISS GRILLS for “barbecue and outdoor grills,” finding that applicant lacked the necessary *bona fide* intent to use the mark for those goods when it filed its Section 1(b) application to register. The Board also sustained opposers’ Section 2(d) claim, ruling that



opposers had established prior use of the mark SWISS GRILL & design for the same goods, based upon shipment of products bearing the mark to a U.S. distributor. *Bona Fide* Intent: A party may establish a prima facie case of lack of *bona fide* intent by demonstrating that the other party lacks any supporting documentary evidence. Here, none of applicant’s documents was dated prior to its filing date, and none related to its intention to use the mark in the U.S. Moreover, applicant’s discovery responses and evidence included inconsistencies that undermined the credibility of its claim. Likelihood of Confusion: Opposers’ Section 2(d) claim “boils down to priority.” Prior to applicant’s filing date, opposers sold and shipped 322 barbecue grills bearing the mark SWISS GRILLS to a United States distributor. The Board observed that “the sale and shipment of products bearing a trademark to one’s distributor is clearly sufficient to establish trademark rights.”

9. Ownership

a. *Kristin Marie Conolty d/b/a Fairway Fox Golf v. Conolty O’Connor NYC LLC*, 111 USPQ2d 1302 (TTAB 2014). In this ownership dispute between former business partners over the mark FAIRWAY FOX for golf clothing, the parties invoked the Board’s Accelerated Case Resolution (ACR) procedure. Opposer Conolty claimed that she was the prior user and owner of the mark. Applicant Conolty O’Connor LLC asserted that Ms. Conolty lacked standing and was barred from opposing the application by “unclean hands” as a result of “acting in bad faith.” In 2008, Kristin Marie Conolty and Kathryn O’Connor began preparations to offer a line of upscale, fashionable golf clothing. In 2011, Applicant Conolty O’Connor LLC was formed, with O’Connor as the sole shareholder. Subsequently, the two individuals continued to work together and filed the application here opposed. In 2012, they went their separate ways, each selling clothing under the FAIRWAY FOX mark. The mark was never assigned,

transferred, or licensed. There was no question that opposer had standing. The Board found that the issue of ownership, which was the real crux of the case, was tried by the consent of the parties, and concluded that the application was void *ab initio* because the applicant company was not the sole owner of the mark. Applicant was controlled by O'Connor, but she had a joint interest in the mark with Opposer Conolty. And so the Board sustained the opposition.

b. *UVeritech, Inc. v. Amax Lighting, Inc.*, 115 USPQ2d 1242 (TTAB 2015). This opposition proceeding concerned a dispute between the U.S. seller (petitioner) and the foreign manufacturer (respondent) over ownership of the mark UVF861 for light bulbs and lighting fixtures. Petitioner contended that the goods were manufactured to its order and specifications, and therefore it owned the mark. Respondent maintained that as manufacturer it owned the mark, because petitioner was a mere distributor. The Board ruled in favor of petitioner. The evidence showed that petitioner designed the bulbs and conceived the mark UVF61. It hired respondent to make the bulbs under the mark to petitioner's specifications. Respondent had never sold a bulb under the mark UVF861 prior to its dealings with petitioner. The most telling events, the Board found, occurred when petitioner became dissatisfied with respondent's products and turned to another manufacturer for a one-year period. The bulbs were still branded with the UVF861 mark, but respondent never objected or asserted its supposed rights in the mark. There was no evidence that petitioner agreed to respondent's ownership of the mark, or that petitioner ever assigned the mark to respondent, or that petitioner authorized respondent's filing of the underlying application. The Board concluded that petitioner's claim of ownership was both consistent with applicable precedent and amply supported by the evidence.

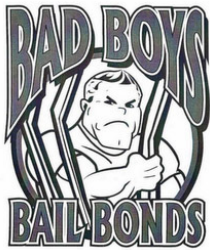
c. *Wonderbread 5 v. Patrick Gilles a/k/a Wonderbread 5 and/or Wonderbread Five*, 115 USPQ2d 1296 (TTAB 2015). The Board granted a petition for cancellation of a registration for the mark WONDERBREAD 5 for "entertainment services in the nature of live musical performances," ruling that the underlying application was void *ab initio* because respondent and ex-band member Patrick Gilles was not the owner of the mark at the time he filed the underlying application. The petition for cancellation asserted likelihood of confusion and fraud, and further alleged that Gilles did not own the mark at the time of filing his application. The Board concluded that the WONDERBREAD 5 mark was not "personal" to Respondent Gilles or any other of the band members. The mark signified the "style and quality" of the group: a Jackson 5 tribute band, not a "particular performer combination." The band monitored and controlled the "style" of its musical services, not Gilles. The band's use of prerecorded music and substitute musicians further supported the conclusion that the music performed by the band was not personalized by the performers.

10. Concurrent Use

a. *Southwestern Management, Inc. v. Ocinomled, Ltd. and Emeril's Food of Love Productions, LLC*, 115 USPQ2d 1007 (TTAB 2015). Concluding that there would be a likelihood of confusion even in Applicant Southwestern Management's current territory (upstate New York), the Board dismissed this proceeding involving a concurrent use application for the mark DELMONICO'S for "restaurant services." Southwestern, the junior user but first to file an application to register, sought a nationwide registration except for the areas of use of the two named Defendants. However, the renown of the Defendants' restaurants (one in New York City

(DELMONICO'S), the heir apparent to the historical restaurant of that name, the other based in New Orleans (DELMONICO) and promoted by Chef Emeril Lagasse) made it likely that confusion would occur even if Applicant's registration for "restaurant services" were limited to upstate New York. In short, Southwestern failed to carry its burden of proof to show that confusion is not likely. The Board hastened to add that its determination did not, in some respects, take into account actual marketplace conditions, and affected only the issue of registrability and not Southwestern's right to use the mark. And so the Board denied Southwestern the concurrent use registration requested.

b. *Bad Boys Bail Bonds, Inc. v. William Lee Yowell*, 115 USPQ2d 1925 (TTAB 2015). The Board dissolved this proceeding because plaintiff/concurrent use applicant failed to prove that its use of the applied-for mark commenced before the filing date of the application underlying defendant's registration. Applicant Bad Boys sought to register the mark shown here, for bail bond services, advertising and marketing services, and various ancillary goods. Its application was refused in view of the registered mark BAD BOYZ BAIL BONDS 'IN JAIL, WE BAIL' for "providing bail bonds for persons under arrest in the state of Missouri." Bad Boys amended its application to seek a concurrent use registration claiming California, Arizona, and Nevada, and the Board instituted the proceeding. Bad Boys claimed first use more than a year before Defendant Yowell's filing date, but Yowell moved for summary judgment, asserting that Bad Boys' first use of the applied-for mark did not occur prior to that critical date, based upon documents provided during settlement discussions. The Board overruled Bad Boys' FRE 408 objection, pointing out that the documents existed independently of the settlement discussions and did not include any statements made during them. Yowell pointed out that the documents did not show the applied-for mark, only the literal portion. The Board concluded that Bad Boys did not use the applied-for mark prior to the critical date and granted the motion.



11. Claim Preclusion

a. *The Urock Network, LLC v. Umberto Sulpasso*, 115 USPQ2d 1409 (TTAB 2015). Granting Respondent Umberto Sulpasso's motion for summary judgment, the Board dismissed this petition for cancellation of his registration for the mark UROCK, in stylized form, for digital media and live musical performances, ruling that Petitioner UNL's claims were barred by the doctrine of claim preclusion. UNL's prior opposition to Sulpasso's underlying application had been dismissed under Trademark Rule 2.132 due to the UNL's failure to take testimony or submit evidence. The Board ruled that the two proceedings involved "the same nucleus of operative facts such that both proceedings stem from the same set of transactional facts," and consequently the doctrine of claim preclusion applied. UNL contended that in this cancellation proceeding, it asserted rights in the mark THE UROCK NETWORK, claiming priority and likelihood of confusion, whereas the opposition focused on its mark UROCK RADIO. The Board, however, pointed out that as opposer in the prior proceeding, UNL had also relied on its rights in THE UROCK NETWORK. The Board therefore found no genuine dispute regarding the applicability of claim preclusion, and it granted Respondent Sulpasso's motion for summary judgment.

b. *Be Sport, Inc. v. Al-Jazeera Satellite Channel*, 115 USPQ2d 1765 (TTAB 2015). The TTAB denied Applicant Al-Jazeera’s motion to amend its answer to add an affirmative defense of claim preclusion, ruling that the amendment would be futile because claim preclusion did not apply. The Board found that the mark that was challenged in the other proceeding (BEIN) did not create the same commercial impression as the mark involved in this proceeding (BEIN SPORT). The Board noted that, although leave to amend an answer is to be “freely given when justice so requires,” leave may be denied when the claim or defense would be “legally futile.” The doctrine of claim preclusion holds that a judgment on the merits in a prior proceeding bars a second proceeding involving the same parties or their privies, based on the same cause of action (arising from the same set of transactional facts). “Here, BEIN, the mark in the prior opposition, creates a different commercial impression than does BEIN SPORT, the mark involved in this proceeding. While SPORT may be descriptive and both parties disclaimed SPORT in the involved and pleaded applications, ‘a disclaimer with the Patent and Trademark Office does not remove the disclaimed matter from the purview of determination of likelihood of confusion.’”

12. Procedural Issues

a. Cure of Defective Signature on Notice of Opposition

i. *Birlinn Limited v. Stewart*, 111 USPQ2d 1905 (TTAB 2014). In this cat fight over rights to the mark TOBERMORY CAT, applicant moved for dismissal on the ground that the notice of opposition, and two extension requests that preceded it, were signed by a foreign attorney not authorized to practice before the USPTO. The Board, however, ruled that this defect was curable. The extension requests and the notice of opposition were signed and filed by an attorney in Edinburgh, Scotland, using the ESTTA system, and were automatically approved and accepted. When applicant moved to dismiss, a new, properly authorized attorney filed an opposition to the motion and an amended notice of opposition (differing from the original notice only in the name of the signatory and the certificate of service). Rule 2.119(e) allows a party to cure the defect of a *lack of a signature* for any *inter partes* filing at the Board. The Board saw no reason why this opportunity to cure should not also apply when a paper is signed by a person not authorized to practice before the USPTO. Nor does Rule 2.119(e) require that the defect be cured within the original time limit for the filing. Rule 2.119(e) requires only that the party re-file the properly signed copy “within the time limit set in the notification of this defect by the Office.”

b. Timeliness of Notice of Opposition

1. *3PMC, LLC v. Stacy Lee Huggins*, 115 USPQ2d 1488 (TTAB 2015). On December 31, 2014, Applicant Stacy Lee Huggins electronically filed an abandonment of his application to register the mark COKE HEAD for t-shirts. On that same day, 3PMC filed a notice of opposition via the TTAB’s ESTTA system. Two months later, the Board entered judgment against Applicant Huggins under Trademark Rule 2.135 based on his abandonment of the application without consent while an opposition was pending. Here, however, the Board granted Huggins’s FRCP 60(b) motion for relief from judgment, ruling that

“a day is an indivisible period of time for purposes of the situation presented here.” The Board reaffirmed its precedent that it “shall not take cognizance of fractions of a day,” and it therefore assumed that the opposition and the express abandonment were filed “at the same instant.” Accordingly, it concluded that the involved application was not subject to opposition when it was abandoned, and therefore Trademark Rule 2.135 did not apply.

c. Privity Requirement for Filing Notice of Opposition

i. *Warren Distribution, Inc. v. Royal Purple, LLC*, 115 USPQ2d 1667 (TTAB 2015). Jennifer Wehrman filed for and was granted a 30-day extension of time within which to oppose registration of the mark HMX for motor oil. During that 30-day period, Warren Distribution, Inc. (WDI) filed a Notice of Opposition, claiming the benefit of the extension of time obtained by Wehrman. Applicant Royal Purple filed a motion to dismiss the opposition, contending that WDI was not the same entity that obtained the extension of time. WDI argued that Ms. Wehrman was in privity with it, and further that she was misidentified by mistake, and therefore the opposition was timely filed under Trademark Rule 2.102(b). Privity: WDI asserted that Wehrman and WDI were in privity because Wehrman was its employee, she was authorized to file the extension request, she intended to file it on behalf of WDI, and she used her business address, email address, and phone number in the request. The Board, however, pointed out that it has long been held that privity does not exist between a person and a corporation merely because the person is employed by the corporation. Mistake: “‘Misidentified through mistake,’ as used in Trademark Rule 2.102(b), means a mistake in the form of the potential opposer’s name or its entity type, not the naming of a different existing legal entity that is not in privity with the party that should have been named.” Accordingly the Board granted applicant’s motion to dismiss without prejudice for lack of subject matter jurisdiction.

d. Proper Pleading of Registrations

i. *United Global Media Group, Inc. v. Tseng*, 112 USPQ2d 1039 (TTAB 2014). The Board sustained, on two grounds, an opposition to registration of the mark BeauTV, in standard character form, for “providing information about beauty.” It declared the application void *ab initio* because *pro se* Applicant Tseng failed to prove use of the mark for the recited services prior to the filing of her use-based application. And the Board found a likelihood of confusion with opposer’s registered mark THE BEAUTY CHANNEL for the services of providing a website and audio-visual materials in the field of beauty. Opposer overcame an early stumble when it failed to properly submit four of its seven registrations into evidence. It relied on five registrations (and two pending applications) in its notice of opposition, but it attached mere copies of the registration certificates; that did not comport with Rule 2.122(d) because opposer did not establish status and title. However, the photocopy of the fifth registration was sufficient because its date of issuance was “substantially contemporaneous” with the filing of the notice of opposition. As to opposer’s two pending applications, they issued to registration while the proceeding was pending, and opposer submitted, via notice of reliance, the electronic records from the USPTO database for those two registrations, showing status and title.

e. Proper Pleading of Claim of Nonuse

i. *Embarcadero Technologies, Inc. v. Delphix Corp.*, 117 USPQ2d 1526 (TTAB 2016). The Board granted Embarcadero's motion to amend its petition for cancellation to add the ground of nonuse, but pointed out that its claim as pleaded was based on a "faulty premise." Embarcadero maintained that, after Delphix filed a first, flawed Statement of Use on August 12, 2009, Delphix could not later file another Statement of Use claiming a first use date." Here the Notice of Allowance issued on July 28, 2009, giving Delphix until January 28, 2010 to file its Statement of Use. It filed a first Statement of Use on August 12, 2009, and on January 25, 2010 filed a request for an "insurance extension of time" for six months, *i.e.*, to July 28, 2010. The Board found that giving Delphix the benefit of the insurance extension "satisfies the letter and the spirit of the statement of use rules." Therefore, to set forth a legally sufficient claim of nonuse, Embarcadero "must plead that Respondent did not use [its mark] with the software listed in the registration within the time for filing its statement of use as extended, *i.e.*, no later than July 28, 2010."

f. Amendment of Opposition to Section 66(a) Application

i. *Prosper Business Development Corp. v. International Business Machines, Corp.*, 113 USPQ2d 1148 (TTAB 2014). In this consolidated proceeding, Prosper filed a notice of opposition against IBM's Section 66(a) application (Request for Extension of Protection) to register the mark BIGINSIGHTS for various goods and services in International Classes 9, 35, and 42, employing the ESTTA filing system as required. The issue before the Board was this: to what extent may an opposer amend a notice of opposition to a Section 66(a) application "when the grounds stated in the original notice of opposition are arguably narrower in scope than the grounds for opposition set forth on the ESTTA electronic form?" Here, the International Bureau of WIPO was notified that Prosper opposed in three classes, and that the grounds for opposition were likelihood of confusion and dilution. The Board ruled that "[b]ecause the limitation on a party opposing registration of a Section 66(a) application prohibits asserting grounds for opposition which were not timely noticed to the IB, it is the scope of the notice to the IB which controls the scope of permissible amendments to the notice of opposition under *Trademark Rule 2.107(b)*." The Board therefore granted Prosper's motion for leave to amend.

g. Restriction of Registration

i. *Orange Bang, Inc. v. Olé Mexican Foods, Inc.*, 116 USPQ2d 1102 (TTAB 2015). In this consolidated proceeding, Plaintiff Orange Bang, Inc. opposed one application and petitioned to partially cancel two registrations owned by Olé Mexican Foods, Inc. Defendant counterclaimed under Section 18 to partially restrict Plaintiff's pleaded registration and simultaneously to restrict the identification of goods in its two challenged registrations. The Board dispensed a ruling in favor of Plaintiff on all claims. Plaintiff's petitions for partial cancellation: While the proceeding was pending, Defendant deliberately deleted several of the challenged goods from its registrations. The Board applied Trademark Rule 2.134(b), entering judgment as to those goods. Defendant's counterclaim: Defendant sought to

restrict Plaintiff's registration for the mark OLÉ as to the identified goods, or alternatively as to channel of trade, but the Board found that neither proposed restriction would avoid a likelihood of confusion. Finally, the Board sustained Plaintiff's opposition and granted Plaintiff's claims for cancellation finding that "dairy and fruit based non-alcoholic fruit beverages" and "yogurt-based beverages" offered under Defendant's OLÉ-containing marks, are likely to cause confusion with Plaintiff's mark OLÉ for "rice and milk-based beverages, namely, horchata" and "non-alcoholic and non-carbonated fruit juice beverages."

h. Expert Witnesses and Expert Reports

i. *Ate My Heart, Inc. v. GA GA Jeans Limited*, 111 USPQ2d 1564 (TTAB 2014). In this Section 2(d) opposition to registration of GAGA JEANS for jeans, when opposer noticed the discovery deposition of applicant's rebuttal expert, applicant filed a motion for a protective order to preclude the deposition on the ground that the expert was not a testifying expert witness. Applicant had named that expert as a testifying expert and provided an expert report, but it subsequently stated that the expert would not be testifying and that she was employed only to aid applicant in preparation for trial. Opposer maintained that it was entitled to take the expert's deposition under FRCP 26(a)(2) as a trial expert in order to "cross-examine [her] on both her rebuttal expert report and the raw data that appears to be an affirmative expert report" FRCP 26(b)(4)(D) states that a party may not discover the facts known by, or opinions of, an expert retained in anticipation of litigation or to prepare for trial and who is not expected to be called as a trial witness. This rule is designed "to promote fairness by preventing access to another party's diligent trial preparation." And there is obviously no need to prepare for the cross-examination of a non-testifying expert. The Board found that applicant had, by its letter to opposer and its submission to the Board, re-designated this individual as a non-testifying expert, and it granted the motion for a protective order, precluding opposer from deposing the expert.

ii. *Gemological Institute of America, Inc. v. Gemology Headquarters International, LLC*, 111 USPQ2d 1559 (TTAB 2014). The Board granted opposer's motion to strike a "supplemental expert report" submitted with applicant's notice of reliance. The Board observed that the report did not fall within the agreement between the parties allowing submission of expert declarations, nor was the supplemental report merely an attempt to correct the expert's initial report. The supplemental report was therefore not timely submitted, nor was the failure to submit the report in timely fashion "substantially justified or ... harmless." The Board ruled that the stipulations of the parties, which referred to specific dated reports, did not encompass the supplemental report, which was not in existence at the time. Turning to FRCP 26(e)(1)(A), a party may supplement or correct an expert report "if the party learns that in some material respect the disclosure or response is incomplete or incorrect" Supplementation means correcting inaccuracies or filling in an incomplete report based on information that was then unavailable. Here, the supplemental report contained additional opinions intended to rebut the other side's expert testimony. Therefore it did not qualify as a supplemental expert report under FRCP 26. The Board further concluded that the untimely disclosure of the supplemental report was neither substantially justified nor harmless under FRCP 37(c)(1).

iii. *Entravision Communications Corporation v. Liberman Television LLC*, 113 USPQ2d 1526 (TTAB 2015). In a case of first impression, the Board granted an applicant's motion to substitute a new expert witness for a previously disclosed expert and to supplement its expert disclosures. The motion was necessitated when the original expert changed her employment and her new employer prohibited employees from testifying as experts. Because applicant's motion involved substituting a witness and a new expert report after the expert disclosure date had passed, rather than supplementation of same before that date, the Board looked to FRCP 37(c)(1). Under that rule, the Board must consider whether the failure to disclose this new witness prior to the expert disclosure date was "substantially justified or is harmless." The Board found that the evidence to be provided by the expert was important, that applicant had "no choice but to find a substitute expert and to file the subject motion to substitute," that the new witness would give virtually the same testimony as the original witness, and that the disruption of the trial schedule would be minimal. It therefore granted the motion and allowed opposer time to take the discovery deposition of the new witness, if it so chose.

i. Attempt to Change Deposition Testimony Transcript

i. *Hollywood Casino LLC v. Chateau Celeste, Inc.*, 116 USPQ2d 1988 (TTAB 2015). Concluding that a genuine dispute of material fact exists as to ownership of the opposed mark HOLLYWOOD HOTEL, the Board denied Opposer Hollywood Casino's motion for summary judgment. Applicant Chateau Celeste's president attempted to change his testimony regarding licensing and control of the mark, but the changes were disallowed by the Board. He first testified that Applicant has a license to use the mark from the owner, but after opposer filed its summary judgment motion he submitted an errata sheet changing certain portions of his deposition transcript to state that Chateau Celeste controls the nature and quality of the services at the property. Opposer objected to these proposed "clarifications," and likewise objected to a declaration of the same witness submitted in opposition to the summary judgment motion, because it likewise contradicted his original testimony. The Board agreed with opposer as to the changed testimony and declaration, but it ruled that opposer had failed to carry its burden to show the absence of any genuine issue of fact as to ownership. Opposer's evidence established only that applicant was not the owner of the physical property known as the Hollywood Hotel at the time the subject application to register was filed.

13. Discovery and Motion Practice

a. Motion to Dismiss Under FRCP 12(b)(6)

i. *Dragon Bleu (SARL) v. VENM, LLC*, 112 USPQ2d 1925 (TTAB 2014). The Board granted opposer Dragon Bleu's Rule 12(b)(6) motion to dismiss three counterclaims for cancellation of its three pleaded registrations, ruling that Applicant VENM had failed to state claims (for fraud, nonuse, and abandonment) upon which relief can be granted. Applicant's fraud claim was jettisoned because the allegedly false statements were not false and also were not material to examination of an application. Moreover, applicant failed to properly plead an intent to deceive the USPTO. The nonuse claim was legally insufficient as to two of the pleaded registrations because they were based on Section 66(a), as to which use is not required

for registration. The abandonment claims raised an issue of first impression: “What is the earliest point in time from which the period of nonuse may be measured for an abandonment claim with respect to a Section 66(a) registration?” The Board observed that for a Section 44(e) registration, the CAFC in *Imperial Tobacco Ltd. v. Philip Morris Inc.*, 14 USPQ2d 1390 (Fed. Cir. 1990), ruled that the period of nonuse that constitutes prima facie evidence of abandonment does not begin until the registration issues. And so the Board similarly held that for cancellation of a Section 66(a) registration the period of non-use is measured from the registration date.

ii. *Guess? IP Holder L.P. v. Knowluxe LLC*, 116 USPQ2d 2018 (TTAB 2015). The Board had denied Respondent Knowluxe’s FRCP 12(b)(6) motion to dismiss Guess?’s petition for cancellation of a registration for a certain triangle design mark, for caps and t-shirts. On this request for reconsideration of that ruling, respondent Knowluxe likewise had no luck. In its 12(b)(6) motion, Knowluxe argued that Guess?’s claims of likelihood of confusion and dilution were implausible and that the asserted trademark rights in a triangle design “conflict with the doctrine of aesthetic functionality and the prohibition against claims of trademark rights in gross.” The Board pointed out that “[a] motion to dismiss for failure to state a claim concerns only one issue: the legal sufficiency of the pleaded claims.” It concluded that Knowluxe’s motion had been properly considered. Respondent’s arguments were in the nature of defenses, but the standard for considering a Rule 12(b)(6) motion is whether the complaint states a plausible claim for relief. The petition here met that standard. The Board noted that respondent will have “the opportunity to assert any appropriate defense, develop the record, and argue the merits of its case, but consideration of the merits is premature at this juncture.”

b. Motion to Compel Discovery

i. *Cadbury UK Limited v. Meenaxi Enterprise, Inc.*, 115 USPQ2d 1404 (TTAB 2015). The Board granted Respondent Meenaxi’s motion to compel Petitioner Cadbury to respond to Meenaxi’s FRCP 34 request for documents, which Cadbury had refused to do based on what the Board deemed an “an obvious and inadvertent” typographical error in the request. The Board found that Cadbury’s position was “unreasonable” and “resulted in the filing of an unnecessary motion, wasting the time and resources of both parties and the Board.” Meenaxi had simultaneously served interrogatories and document requests on Cadbury. Cadbury objected to the interrogatories but did not respond or object to the document requests. In the preamble to the latter Meenaxi erroneously referred to Petitioner as “Venture Execution Partners, Inc.” Although the document was correctly captioned, and though Cadbury had requested and received four extensions of time to respond to Meenaxi’s “discovery,” Cadbury contended that the typographical error was a “crucial mistake, the result of which is that the document requests were never directed to Petitioner.” Cadbury also feebly contended that the extensions of time for responding to “discovery” did not contemplate document requests. The Board found this to be “disingenuous at best.” Granting the motion to compel, the Board gave Cadbury thirty days to respond to the document requests and produce the requested documents, without objection on the merits.

ii. *Intex Recreation Corp. and Intex Marketing Ltd. v. The Coleman Company, Inc.*, 117 USPQ2d 1779 (TTAB 2016). The Board ordered Applicant Coleman to

produce unredacted versions of the documents it had previously produced, rejecting Coleman’s argument that the redacted portions were irrelevant or contained confidential material. Coleman maintained that the redacted portions concerned product lines not at issue in this proceeding, and “highly proprietary” competitive information. The Board saw no compelling reason for Coleman not to disclose purportedly irrelevant information in a document that contains relevant information. Unilateral redaction would deprive the receiving party of the full context of the relevant information, fuel mistrust about the propriety of the redaction, and incentivize parties to hide as much as they dared to hide. It would increase the potential for discovery disputes, resulting in wasteful expenditure of time and resources, and would place “an unnecessary and substantial burden” on the Board in conducting in camera review of each disputed document. Coleman should have designated the disputed documents under the appropriate tier of confidentiality. If Coleman believed the standard order was inadequate, it should have sought modification of the order.

c. Motion for Sanctions

i. *NSM Resources Corp. and Huck Doll LLC v. Microsoft Corp.*, 113 USPQ2d 1029 (TTAB 2014). The Board granted Microsoft’s motion to dismiss a petition to cancel its registration for the mark XBOX 360 for publications in the field of computer games, finding that petitioners failed to state a claim upon which relief can be granted. Petitioners, appearing *pro se*, failed to establish standing, and their claims of fraud and misrepresentation of source under Section 14(3) were woefully inadequate. The Board also granted Microsoft’s motion for sanctions, based upon petitioners’ conduct in this and 29 other proceedings. Petitioners claimed ownership of 12 applications for marks containing the word “Huck,” and asserted that use of “Huck” in a Microsoft user manual for a video game called “Stoked,” infringed the HUCK marks. But even if petitioners had suffered damage by distribution of the manuals, it was unrelated to the XBOX 360 mark, and therefore petitioners did not have a personal stake in this proceeding and lacked standing. Petitioner NSM had filed 29 proceedings since 2008, alleging ownership of marks that were, with few exceptions, entirely dissimilar from the challenged marks. The Board concluded that, under Rule 11 and its inherent authority, “any sanction short of judgment would be futile and unfair ...,” and it dismissed the case with prejudice as a sanction for petitioners’ conduct.

ii. *Emilio Pucci International BV v. Rani Sachdev*, ___ USPQ2d ___ (TTAB 2016). The Board was not pleased with Applicant Rani Sachdev’s motion for a protective order, filed on the day her discovery responses were due. It denied the motion as deficient and meritless, ordered Sachdev to show cause why sanctions should not be imposed, and barred her from filing any unconsented or unstipulated motion without Board permission. The Board observed that a party may seek a protective order where it is “readily apparent that the discovery requests are so oppressive as to constitute clear harassment,” but it found no basis for applicant’s assertion that opposer’s discovery requests would cause annoyance, embarrassment, oppression or undue expense. The discovery requests were standard and typical for this type of proceeding, and were tailored to seek relevant information. The interrogatories, under any counting method, did not exceed seventy-five in number. Applicant’s unfounded and improper motion “calls into question whether Applicant had any objective for filing it other than to stall

the proceeding.” The Board allowed applicant 15 days within which to show cause as to why the Board should not sanction her by finding that (1) she has forfeited her right to object on the merits to opposer’s discovery requests, and (2) opposer’s requests for admissions are deemed admitted pursuant to FRCP 36(a)(3).

d. Motion for a Protective Order

i. *Joshua Domond v. 37.37, Inc.*, 113 USPQ2d 1264 (TTAB 2015).

In this cancellation proceeding challenging a registration for the mark BEAUTIFUL PEOPLE for various clothing items, Petitioner Joshua Domond served 872 requests for admission, 247 document requests, and 26 interrogatories in the first two days of the discovery period. Respondent 37.37, Inc. moved for a protective order under Fed. R. Civ. P. 26(c), requesting that the Board limit the discovery items to a reasonable number. The Board found the discovery requests to be “excessive, unduly burdensome and harassing in number and content” when viewed in light of the issues raised in the proceeding, and it granted the motion, limiting the total number of discovery requests to 150, absent prior Board review and approval. Petitioner alleged fraud, abandonment, and likelihood of confusion, and claimed that the challenged registration was void *ab initio* because respondent’s specimen failed to show use in commerce. The Board pointed out that while parties to a proceeding are generally allowed to seek discovery as they deem necessary, they are expected to take into account the principles of proportionality so that the volume is not harassing or oppressive, and they are expected to consider the scope of the requests as well as to confer in good faith so as to minimize the need for motions. The Board granted the motion for a protective order, and it warned petitioner that further uncooperative or harassing behavior may result in the imposition of sanctions, and possibly entry of judgment.

e. Motion to Strike Notice of Reliance Evidence

i. *FUJIFILM SonoSite, Inc. v. Sonoscape Co.*, 111 USPQ2d 1234

(TTAB 2014). In this Section 2(d) opposition, Applicant Sonoscape won a partial victory in its motion to strike certain evidence in Opposer’s notice of reliance. The Board ruled that FUJIFILM could not rely on a newly issued registration because the underlying application had not been pleaded in the notice of opposition, but the Board deferred until trial a ruling on whether the registration had any probative value at all. It agreed that, as to certain other documents (673 pages in all) purportedly relevant to the likelihood of confusion issue, opposer was required to indicate the relevance of each page by *du Pont* factor. Newly issued registration: Opposer Fuji claimed ownership of a family of “Sono-” formative marks, and sought to add a newly issued registration to its arsenal. Since FUJIFILM did not plead ownership of the application, the Board ruled that FUJIFILM “cannot use an unpleaded registration as a basis for the opposition,” but it refused to strike the exhibit, accepting it for “whatever probative value” it may lend to opposer’s showing under the *du Pont* factors in its case-in-chief. Other evidence: Although FUJIFILM stated that certain documents were relevant to three likelihood of confusion factors, that was not good enough: “The Board will not expend its resources guessing which pages the propounding party is relying upon.... Opposer should have indicated which web page or group of web pages within each exhibit support each specific *du Pont* factor.” Fuji was allowed 15 days to submit a revised notice of reliance.

f. Motion to Vacate Board Decision

i. *The Board of Trustees of The University of Alabama and Paul W. Bryant, Jr. v. William Pitts, Jr. and Christopher Blackburn*, 115 USPQ2d 1099 (TTAB 2015) [Vacated on March 3, 2016]. An augmented Board panel denied the opposers' request to reopen, vacate, and dismiss without prejudice the TTAB's 2013 precedential decision, dismissing an opposition to registration of the mark HOUNDSTOOTH MAFIA, in the design form shown here, for "shirts, hats." A subsequent civil action under Section 21(b)(1) for review of the TTAB's decision resulted in settlement and entry of a consent judgment, which in part ordered that the Board's decision be vacated. In settling the case, the parties submitted to the court a Final Consent Judgment, which would result in assignment to the University of applicants' rights in the HOUNDSTOOTH MAFIA mark, including the opposed application. The parties agreed that the Board's Order should be vacated. The Board, however, concluding that 28 U.S.C. Section 2106 was not implicated and noting that Rule 60(b) was not invoked, ruled that Section 21(b)(1) did not require vacatur. The Board then considered the matter in view of its "general equitable authority." It saw no exceptional circumstances or any public interest that would require vacatur. The decision was deemed precedential in order to provide guidance to practitioners. The consent judgment did not point to any error in the Board's decision, and nothing suggested a public interest that would be advanced by vacatur and that would outweigh the Board's determination that the decision had precedential value. [On February 23, 2016, the U.S. District Court for the Northern District of Alabama ordered the TTAB to vacate its decision, in compliance with the consent judgment entered by the court].

