

**Decisions of the Trademark Trial and Appeal Board  
and the Federal Circuit on Registrability Issues  
July 2015 to April 2017**

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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) (*en banc*) as corrected (Feb. 11, 2016), *cert. granted sub nom. Lee v. Tam*, 137 S. Ct. 30 (2016). 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.

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

a. *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.



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### 3. Genericness

a. *In re Cordua Restaurants, Inc.*, 118 USPQ2d 1532 (Fed. Cir. 2016). The CAFC upheld the Board’s affirmance of a refusal to register the mark CHURRASCOS in stylized form, ruling that substantial evidence supported the Board’s determination that the term



is generic for restaurant services. The fact that the applicant already owns a registration for CHURRASCOS in standard character form for the same services was irrelevant because each trademark application must be examined on its own merits. Cordua argued that the Board should have fully considered its “incontestable registration,” but the court pointed out that a mark’s incontestability under Section 15 is not a shield against genericness. Section 14 states that a registration for a mark that has become generic may be cancelled at any time. Cordua maintained that “churrascos” refers to a style of grilling meat and not to restaurant services, but the court observed: “[i]f the relevant public would understand a term denoting a specialty dish to refer to a key aspect of restaurant services, then the term is generic for restaurant services.” Substantial evidence supported the finding that “churrascos” refers to a “key aspect” of a class of restaurants because those restaurants are commonly referred to as “churrasco restaurants.”

### 4. Service Mark Use

a. *In re JobDiva, Inc.*, 121 USPQ2d 1122 (Fed. Cir. 2016). The CAFC vacated a TTAB ruling that ordered cancellation of a registration for the mark JOBDIVA for “personnel placement and recruitment” services, on the ground of abandonment. JobDiva’s software provides a database of employment applications that a hiring manager or recruiter may use to fill a job opening. JobDiva submitted screenshots of its website, along with a declaration from its CEO, in explaining its services, but the Board found the evidence insufficient because “[t]here was no reference ... to [JobDiva’s] performance of personnel placement and recruitment services other than supplying [its] software.” Concluding that the marks had not been in use for the services in question, the Board found that JobDiva had abandoned the mark. The CAFC observed that the Board appeared to apply a bright-line test, requiring the registrant to show that it actually rendered its services rather merely providing SAAS software at its website. The CAFC rejected that standard, pointing out that “[e]ven though a service may be performed by a company’s software, the company may well be rendering a service.” The court remanded the case to the Board for consideration of the following question: “whether purchasers would perceive JobDiva’s marks to identify ‘personal placement and recruitment’ services.” The CAFC directed the Board to consider the nature of the user’s interaction with JobDiva when using the software, as well as the location of the software host in making that determination.

## B. Trademark Trial and Appeal Board

### 1. Section 2(a) Deceptiveness

a. *In re Tapco International Corporation*, 122 USPQ 2d \_\_\_\_ (TTAB 2017). The Board adhered to its standard test for deceptiveness under Section 2(a) in affirming a refusal of KLEER ADHESIVES for adhesives and mortar for use with PVC building materials, the products being “optically opaque, color-matched, or otherwise non-transparent.” As to the marks KLEER MOULDINGS and KLEER TRIMBOARD for PVC building materials, however, the Board reversed the same refusals due to lack of evidence that the term KLEER (or its phonetic equivalent, “clear”) has an understood meaning with regard to such synthetic products. As to KLEER ADHESIVES, the Board agreed with the examining attorney that KLEER is the phonetic equivalent of “clear,” that “clear” means transparent, and that applicant’s goods are not transparent. Consumers are likely to believe that the description of the goods as transparent because - as shown by web pages, new stories, and “how-to” articles - manufacturers provide clear adhesives for use in the construction industry. The evidence demonstrated that clear adhesives have important and desirable advantages over non-transparent adhesives, and so the Board found that “a clear-drying finish would be material to the decision by consumers to purchase PVC adhesives.” As to the other two marks, although “clear” has an understood meaning with respect to wood, “there is no evidence in the record establishing a similar recognized distinction between clear and blemished synthetic building products.”

### 2. Section 2(b) Foreign Flag or Insignia

a. *In re Family Emergency Room LLC*, 121 USPQ2d 1886 (TTAB 2017). Section 2(b) of the Trademark Act, in pertinent part, prohibits registration of a mark that “[c]onsists of or comprises the flag ... of any foreign nation, or any simulation thereof.” Applicant sought to register the mark shown here for “hospitals,” but it was refused registration under Section 2(b). Does the mark include a simulation of the Swiss flag? Applicant described the relevant portion of its mark as “a white cross on a red field, [with] diagonal lines on the left edge of the field.” It claimed red and white as a feature of the mark and conceded that the mark “borrow[s] elements of the Swiss national flag.” The Board found applicant’s design to be “highly similar” to the Swiss flag. The addition of lines at the left of the design and the very slight tilt of the design are “insignificant in altering the commercial impression of the design.” “Simply put, the design shown in the proposed mark is not sufficiently altered, stylized, or merged with the other elements in the mark, so as to create a distinct commercial impression, other than as a simulation of the Swiss flag. The average member of the general public seeing the proposed mark would associate the design feature with the flag of Switzerland.” Therefore, registration of applicant’s mark is prohibited by Section 2(b).



b. *In re Shabby Chic Brands LLC*, 122 USPQ2d 1139 (TTAB 2017). The TTAB affirmed a Section 2(b) refusal of the mark shown below left, for various goods including furniture, dinnerware, and fabrics, on the ground that the mark comprises a design that simulates

a governmental insignia of the United Kingdom, namely, the Prince of Wales' emblem (shown below right)]. Section 2(b) bars registration of a mark that “[c]onsists of or comprises the flag or coat of arms or other insignia ... of any foreign nation, or any simulation thereof.” The



Government of the United Kingdom identified the emblem as “[t]he official emblem of the Prince of Wales” when it notified WIPO in 2005, under the Paris Convention, that this emblem is a ‘state emblem’ of the United Kingdom. The emblem is included in the USPTO database and may form the basis of a Section 2(a) or 2(b) refusal. The Board concluded that the Prince of Wales’ emblem is an “insignia

of national authority” on a par with a coat of arms. In determining whether the mark is a “simulation” of the emblem, the Board must consider the “first impression gathered from a view of such mark without a careful analysis and side-by-side comparison ...” The Board concluded that that the similarities in the commercial impressions of the marks outweighed their differences and it found that found that the applied-for mark is a simulation of the Prince of Wales’ emblem.

### 3. 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). The Board affirmed a Section 2(d) refusal to register the mark I AM for cosmetics and personal care products, “all associated with William Adams, professionally known as will.i.am,” in view of the registered mark I AM for perfume. 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 mark identifies 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 Lanham 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 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. As to 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.” The fame of the cited mark alone is not enough to establish a likelihood of confusion, but the Board found that JAWS is identical to the cited mark and that JAWS DEVOUR YOUR HUNGER is similar in terms of appearance, sound, connotation, and commercial impression. 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."

vi. *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511 (TTAB 2016). The Board affirmed two refusals of the mark HOUSEBOAT BLOB for inflatable floating mattresses "from which the user may be launched into the air and onto a body of water" (BLOB disclaimed), finding the mark merely descriptive under Section 2(e)(1), and likely to cause confusion with the registered mark THE BLOB for goods legally identical to applicant's goods. As to mere descriptiveness, the evidence established that the term "blob" refers to a type of air mattress used on bodies of water as a recreational device whereby one is catapulted off the blob when another person jumps onto the other side of the blob. Applicant's own marketing materials described a version of its product "that will accommodate House Boats and Yachts." The Board therefore concluded that the words in combination are merely descriptive of the goods. [The Section 2(d) refusal is discussed below].

b. Likelihood of Confusion Not Found

i. *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.

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

a. *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.”

b. *In re Highlights for Children, Inc.*, 118 USPQ2d 1268 (TTAB 2016). Ruling that the marks IMÁGENES ESCONDIDAS and HIDDEN PICTURES are not “the same mark” for Section 2(f) purposes, the Board affirmed a Section 2(e)(1) mere descriptiveness refusal to register the former for “books and magazines for children.” Although IMÁGENES ESCONDIDAS means “hidden pictures” in English, the Board ruled that the acquired distinctiveness of the registered HIDDEN PICTURES mark could not be transferred to IMÁGENES ESCONDIDAS. Trademark Rule 2.41(a)(1) provides that ownership of a prior registration of the same mark “may be accepted as prima facie evidence of distinctiveness if the involved goods or services are sufficiently similar....” In *Dial-A-Mattress Operating Corp.*, 15 USPQ2d 1807, 1812 (Fed. Cir. 2002), the CAFC explained that a proposed mark is the “same mark” if it is the “legal equivalent” of that mark: “A mark is the legal equivalent of another if it creates the same, continuing commercial impression such that the consumer would consider them both the same mark. . . .” The Board found the answer to be readily apparent: “IMÁGENES ESCONDIDAS, even though it has the same meaning as HIDDEN PICTURES, is *not* ‘the same mark’ as HIDDEN PICTURES.” They are different aurally and visually, and according to *Dial-A-Mattress* no other evidence need be considered.

c. *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511 (TTAB 2016). As noted above, the Board affirmed two refusals of the mark HOUSEBOAT BLOB for inflatable floating mattresses “from which the user may be launched into the air and onto a body of water” (BLOB disclaimed), finding the mark merely descriptive under Section 2(e)(1), and likely to cause confusion with the registered mark THE BLOB for goods legally identical to applicant’s goods. As to the Section 2(d) refusal, the Board found the term “blob” to be a weak source indicator, but “[e]ven so, we see little in Applicant’s mark to distinguish it from Registrant’s mark, as Applicant’s mark merely adds a highly descriptive term to the registered mark, in such a way as to indicate to customers a suitable purpose of the goods.” The presence or absence of the word “THE” is “unlikely to allow consumers to meaningfully distinguish the marks.”

d. *In re LC Trademarks, Inc.*, S.N. 85890412, 121 USPQ2d 1197 (TTAB 2016). The TTAB ruled that an applicant, when seeking registration based upon acquired descriptiveness under Section 2(f), may rely on a “family of marks” argument to support its claim. Nonetheless, the Board affirmed a Section 2(e)(1) mere descriptiveness refusal of the mark DEEP! DEEP! DISH PIZZA, in standard character form, for “pizza” (DEEP DISH PIZZA” disclaimed), finding that applicant’s proofs fell short of establishing acquired distinctiveness. The Board observed that, although it is theoretically possible that a common structure could be the common element of a family of marks, LC’s structure of a descriptive word and an exclamation point followed by the same word and another exclamation point “is too abstract to constitute a common characteristic that could give rise to a family of similarly-structured marks.” LC’s double word structure would pave the way for LC to “enforce almost any descriptive word in the dictionary, so long as it repeats.” This would create an unacceptable

risk to competition, and would be analogous to a phantom mark. Putting aside the “family of marks” argument, the Board also found insufficient applicant’s evidence that the applied-for mark by itself had acquired distinctiveness.

e. *In re Calphalon Corp.*, 122 USPQ2d \_\_\_ (TTAB 2017). The Board affirmed a Section 2(e)(1) refusal to register the mark SHARPIN, in standard character form, finding it merely descriptive of “cutlery knife blocks which incorporate built-in sharpeners that automatically sharpen knives.” Applicant Calphalon asserted that the examining attorney had failed to enter its amendment of the mark to the special form “SharpIN” and instead improperly treated the mark as a standard character mark (although the examining attorney accepted the amendment to the drawing). Calphalon further contended that SharpIN (in special form) is incongruous or a double entendre. No dice, said the Board, pointing out that Calphalon did not select the special form option when it requested the drawing amendment via TEAS. Therefore, the standard character designation remained the designation of choice. As to mere descriptiveness, the examining attorney contended that consumers would perceive the mark SHARPIN as equivalent to the word “sharpen.” “Applicant’s mark is not a double entendre because ... Applicant’s second proposed meaning of SHARPIN—that ‘a sharpener is built within the knife block’—inheres in the presentation of the mark in a special form as SharpIN, and that is not the form of the mark for which Applicant seeks registration.”

#### 5. 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.

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

a. *In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738 (TTAB 2016). The Board affirmed a Section 2(d) refusal of MT. RAINIER THE MOUNTAIN OF SEATTLE ESPRESSO & MILK and Design for various coffee-related products (ESPRESSO & MILK disclaimed), finding confusion likely with the mark MOUNT RAINIER COFFEE



COMPANY, registered on the Supplemental Register for “coffee” (COFFEE COMPANY disclaimed). However, the Board reversed a Section 2(e)(3) refusal to register, finding the applied-for mark not primarily geographically deceptively misdescriptive of the goods. The examining attorney based this refusal on the word SEATTLE, maintaining that the focus of Section 2(e)(3) is whether the term in question is primarily geographic in the context of the mark, not whether the geographic reference dominates the mark. The Board disagreed, pointing out that a refusal to register under Section 2(e)(3), by its terms, is appropriate only if the matter applicant seeks to register “consists of a mark” that is geographically misdescriptive. Thus the focus is on whether the mark as a whole, not merely some part of it, is “primarily geographically deceptively misdescriptive.” The Board found that the word SEATTLE plays a relatively minor role here, and the relevant public would therefore not consider that word as an indicator of the origin of the goods.



7. Section 2(e)(4) Primarily Merely a Surname

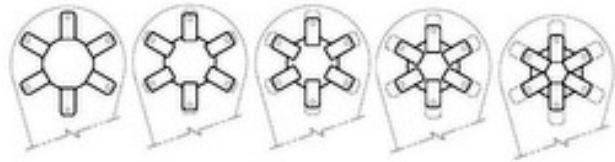
a. *In re Integrated Embedded*, 120 USPQ2d 1504 (TTAB 2016). The Board affirmed a Section 2(e)(4) refusal to register the mark BARR GROUP for engineering, training, and expert witness services in the field of computer hardware and software (GROUP disclaimed), finding the mark to be primarily merely a surname. The Board observed that resolution of the Section 2(e)(4) issue “can be made only after the primary significance of the mark to the purchasing public is determined ...” “Mr. Barr is not a historical figure who founded Applicant in the distant past and of whom the public may not be aware. To the contrary, the record evidence established that Mr. Barr is an active participant in Applicant’s activities under its mark, and that consumers are exposed to his name in several locations on Applicant’s website such that consumers are likely to view BARR, as it appears in Applicant’s mark, as a surname.” The addition of the disclaimed term GROUP does not lend source-identifying significance to applicant’s mark. Considered in its entirety in the context of applicant’s services, BARR GROUP “does not engender a consumer perception beyond that of a surname.”

b. *In re Eximius Coffee, LLC*, 120 USPQ2d 1276 (TTAB 2016). In another Section 2(e)(4) appeal, the Board again emphasized consumer perception over a more mechanical approach in affirming a refusal to register the mark ALDECOA for coffee, finding the mark to be primarily merely a surname. Although ALDECOA is a rare surname, the term has no other recognized meaning and there is a “strong connection” between the surname and the owners of the application: *i.e.*, the Aldecoa family runs the business. “ALDECOA is not simply the name of the historical founder of Applicant’s business at some time in the past. Rather, ALDECOA identifies individuals who have been continuously involved in the business and presently are active participants in the daily operation and leadership of the company.” The evidence showed that ALDECOA has no recognized meaning other than as a surname, albeit a rare one. Applicant argued that an “extremely rare surname” cannot be primarily merely a surname, but the Board was unmoved, pointing out that Section 2(e)(4) does not exempt from its prohibition, surnames shared by only a few or provide that the purpose of this Section is to protect others’ rights to use their surnames except for those with uncommon surnames.

c. *In re Adlon Brand GmbH & Co. KG c/o FUNDUS FONDS-Verwaltungen GmbH*, 120 USPQ2d 1717 (TTAB 2016). A divided TTAB panel affirmed a Section 2(e)(4) refusal of ADLON for various goods and services, including “hospitality industry services,” finding it to be primarily merely a surname. Although ADLON is a rare surname, the panel majority observed that it has no meaning or significance other than as a surname. The evidence indicated that there are approximately 75 individuals in the United States having the surname ADLON, including actress Pamela Adlon. Applicant argued that the “rareness” of the surname ADLON should be decisive, but the Board again observed that “even a rare surname is unregistrable if its primary significance to purchasers is a surname.” *In re Eximius Coffee, LLC*, 102 USPQ2d 1276, 1281 (TTAB 2016). Applicant contended that consumers would perceive the mark as indicating applicant or its Hotel Adlon, one of the famous hotels in Berlin throughout the Nazi period. The Board was unmoved, observing that applicant failed to demonstrate that the term has another significance that is its primary significance as perceived by the public. Judge Quinn dissented, contending that ADLON is an extremely rare surname that consumers would view as a coined term having no meaning.

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

a. *In re Loggerhead Tools, LLC*, 119 USPQ2d 1429 (TTAB 2016). The Board affirmed a refusal to register a motion mark “depicting the product configuration of a hand tool in which six rectangular-shaped jaw-like elements of the circular head of a hand tool radially move in and out,” for “hand tools, namely, gripping tools in the nature of wrenches and wire crimpers for sale through mass merchandisers to retail consumers,” on the ground of Section 2(e)(5) functionality. The Supreme Court has stated that a product feature is functional, and thus cannot serve as a trademark, if “it is essential to the use or purpose of the article or if it affects the cost or quality of the article.” See *TrafFix* and *Inwood*. Treating the mark like a product configuration mark, the Board applied the ever-popular four-part test of *Morton-Norwich*. Reviewing *Loggerhead’s* utility patent for an “Adjustable Gripping Tool” and its design patent for a “Hydrant Tool,” the Board found that the design patent did not cover the motion described in the trademark application and so did not overcome the “strong conclusion” that the utility patent’s disclosure of the utilitarian advantages of the proposed mark indicated functionality. The USPTO pointed to numerous examples of advertising touting the utilitarian advantages of the tool. The Board found *Loggerhead’s* evidence of alternative designs unpersuasive, and a conclusory statement by applicant’s president that its device “was not the most cost-effective combination among the various alternatives available” to be unavailing. Because the mark affects the quality of the tool, the Board affirmed the refusal.



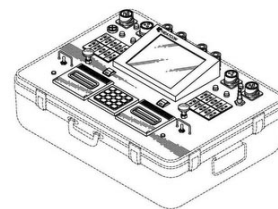
#### 9. Section 2(f) Acquired Distinctiveness

a. *In re Hodgdon Powder Company, Inc.*, 119 USPQ2d 1254 (TTAB 2016). In a rare “color mark” decision, the Board reversed a refusal to register a mark comprising the

color “white” for “preformed gunpowder charges for muzzleloading firearms,” finding that Applicant Hodgdon Powder had proven acquired distinctiveness under Section 2(f). Of course, under *Wal-Mart* and *Qualitex*, single color marks are never inherently distinctive. Hodgdon stated that the color white for its gunpowder serves no purpose other than to identify Hodgdon’s products, that the color white is not a natural by-product of the manufacturing process, and that no one else in the industry uses the color white for gunpowder. The Board concluded that the color white “is an anomaly contrary to consumers’ expectations regarding the appearance of the product.” Hodgdon filed a declaration attesting to substantially exclusive and continuous use of the color white for at least the five years preceding the filing date of its application. Its advertising stated that the products, sold under the mark WHITE HOTS, is “The Only White Gunpowder.” The Board found Hodgdon’s advertising to be “effective ‘look for’ advertising.” Reviewing the totality of the evidence, the Board concluded that the color white for Hodgdon’s products had acquired distinctiveness.

#### 10. Section 23(c) Functionality

a. *In re Heatcon, Inc.*, 116 USPQ2d 1366 (TTAB 2015). The Board affirmed a refusal to register, on the Supplemental 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 again 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.



#### 11. Failure to Function/Specimen of Use

a. *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 those services. “Applicant is using ‘Walk-In-Shopper’ to identify 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.

b. *In re WAY Media, Inc.*, 118 USPQ2d 1697 (TTAB 2016). Affirming a refusal to register the mark WORLD’S BIGGEST SMALL GROUP for radio broadcasting services, the Board found that applicant’s specimens of use failed to show that the phrase served as a source indicator for radio broadcasting services, as opposed to applicant’s own radio program. A service mark specimen of use is acceptable if it either (1) shows the mark used or displayed as a service mark in the sale of the services, which includes use in the course of rendering or performing the services, or (2) shows the mark used or displayed as a service mark in advertising the services, which encompasses marketing and promotional materials. Applicant focused on four pages of material, including several Internet website pages referring to a radio program and YouTube screenshots that purportedly depicted the mark in a “radio broadcast booth environment.” The Board noted that the TMEP provides guidance as to the meaning of “radio broadcasting services,” and it found that the phrase WORLD’S BIGGEST SMALL GROUP, as it appears on the specimens, refers to applicant’s Bible-reading and devotion program. There was no direct association in the specimens between WORLD’S BIGGEST SMALL GROUP and radio broadcasting services.

c. *In re Fantasia Distribution, Inc.*, 120 USPQ2d 1137 (TTAB 2016) . The Board affirmed a refusal to register a mark consisting of a repeated diamond pattern applied to the lower third of the cylinders of “electronic hookahs,” deeming it to be a non-distinctive, merely ornamental design that lacked acquired distinctiveness under Section 2(f). The Board noted that the refusal to register is consistent with TMEP Section 1202.19 (April 2016). Analogous to color and product design, repeating patterns are often used to make products more attractive and so consumers would not be predisposed to equate the pattern with source. The Board did not rule out the possibility that a repeating pattern could be inherently distinctive, but in most cases it would not be. Inherent Distinctiveness: The Board concluded that applicant’s repeating diamond pattern is not inherently distinctive. It “plays a significant role in giving the devices an attractive appearance,” and consumers would not be inclined to view the pattern as source-indicating. Acquired Distinctiveness: Of course, an ornamental element may be registrable on the Principal Register upon proof of acquired distinctiveness, but the Board found that applicant’s proofs fell short. There was no “look for” advertising, and the evidence showed that applicant’s hookahs are sold in packaging that hides the diamond pattern from view. And so, the Board affirmed the refusal to register under Sections 1, 2, and 45.



d. *In re Kohr Brothers, Inc.*, \_\_\_ USPQ2d \_\_\_ (TTAB 2017). The Board affirmed a refusal to register the mark CONEY ISLAND BOARDWALK CUSTARD for frozen custards due to applicant’s failure to submit an acceptable specimen of use. Applicant contended

that its specimen – a small sign located at eye level on a wall facing the customer as he or she approaches a boardwalk stand to purchase the goods – qualified as a display closely associated with the goods. Section 45 of the Lanham Act states that a mark is used in commerce on goods when “it is placed in any manner on the goods or their containers or the displays associated therewith ....” The Board must determine on a case-by-case basis whether a particular specimen qualifies as a “display” adequate to demonstrate use in commerce; “mere advertising” does not suffice. The Board concluded that consumers would not be likely “to associate the mark with the goods such that the specimen serves as an inducement to the sale of the goods.” The sign was small and located next to a business license and a certificate from the Delaware Public Health and Social Services Division of Public Health, “hardly a place where a merchant would place material intended ‘to catch the attention of purchasers and prospective purchasers as an inducement to make a sale.’”



## 12. Genericness

a. *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477 (TTAB 2017). Because Opposer Luxco failed to prove its claims of genericness, lack of legitimate control, and fraud, the Board dismissed this opposition to registration of the mark TEQUILA as a certification mark for “distilled spirits, namely, spirits distilled from the blue tequilana weber variety of agave plant.” A certification mark that certifies regional origin as well as the qualities and characteristics associated with that origin “will not be deemed to have become a generic term as applied to particular goods unless it has lost its significance as an indication of regional origin for those goods.” *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1887 (TTAB 2006). The Board reviewed dictionary definitions of “tequila,” encyclopedia and website references, several expert reports, advertising and bottle labels for Tequila, recipes, news articles, retail signage, and consumer survey results. It found that the record evidence was, at best, mixed, and “tends to show that Tequila has significance as a designation of geographic origin.” In short, Luxco did not meet its burden to prove genericness by a preponderance of the evidence, and so the Board dismissed this claim. It further found that CRT exercised legitimate control over the mark, and there was nothing in the record to support the claim that CRT made a false statement or intended to deceive the USPTO.

b. *In re Emergency Alert Solutions Group, LLC*, 122 USPQ2d 1088 (TTAB 2017). The Board affirmed a refusal to register the term LOCKDOWN ALARM on the Supplemental Register, finding it to be generic for “Training services in the field of school safety ... and crisis preparedness,” it reversed a refusal based on applicant’s supposed failure to adequately respond to a Rule 2.61(b) request for information (discussed below). Applicant’s specimen of use indicated its services were directly related to lockdown alarms. The Board observed that a the CAFC has repeatedly treated the generic name of a “key aspect” of a service as generic for the service itself. *See, e.g., In re Cordua Rests. Inc.* 118 USPQ2d 1632 (Fed. Cir. 2016). “In this case, relevant customers would readily understand LOCKDOWN ALARM to refer to the type of training identified in the application.”

13. Service Mark Use

a. *In re Florists' Transworld Delivery, Inc.*, 119 USPQ2d 1056 (TTAB 2016). The Board affirmed a refusal to register SAY IT YOUR WAY for “creating an on-line community for registered users ...,” finding that Applicant FTD failed to show use of the mark with the recited service. Reviewing FTD’s specimen of use, the Board ruled that FTD did not offer this social-networking service as a separable service to others, but rather as merely incidental to its primary services. The Board pointed to TMEP Section 1301.04(h)(iv)C), which cautioned examining attorneys to carefully examine webpages from social-networking websites to make sure that the mark in question is being used with the recited services. FTD argued that it had created its own virtual sub-community within Twitter, but the Board was unmoved. “Applicant has done nothing more than use the Twitter online community forum to engage in social-networking for its own benefit, and to advertise its online retail store services, which are rendered over its own corporate website ....” Moreover, to the extent that FTD provides information regarding flowers or conducts events to promote the sale of flowers, those activities did not appear to constitute a separate “registrable service,” but were also merely incidental to its primary services.

14. Lawful Use in Commerce

a. *In re Morgan Brown*, 119 USPQ2d 1350 (TTAB 2016). The Board affirmed a refusal to register the mark HERBAL ACCESS for “retail store services featuring herbs,” on the ground that the mark is being used in connection with the sale of a substance (marijuana) that is illegal under federal law. To qualify for federal registration, a mark must be in “lawful” use, and so any goods or services for which the mark is used must not be illegal under federal law. Applicant’s specimen of use featured photographs of his retail store depicting a green cross (a symbol of the organized medical marijuana industry) on the door and window. His website displayed a map with the wording “Marijuana for the Masses” and depicted a marijuana plant with the text: “Call or stop by today and find out why people consider our marijuana to be the best of the best!” Thus applicant’s services included the provision of an illegal substance in violation of the federal Controlled Substances Act (CSA) and constituted a *per se* violation of federal law. Applicant Brown argued that he was seeking to register his mark for the sale of herbs, not for marijuana, and that the sale of herbs is not illegal. The Board concluded that, because the mark is being used in connection with the sale of a specific substance that falls within both the recitation of services and the prohibitions of the CSA, Applicant Brown’s services include the sale of a good that is illegal under federal law, and therefore encompass a use that is unlawful.

b. *In re JJ206, LLC, dba JuJu Joints*, 120 USPQ2d 1568 (TTAB 2016). The Board affirmed, under Sections 1 and 45 of the Lanham Act, refusals to register POWERED BY JUJU and JUJU JOINTS for smokeless marijuana vaporizers, on the ground that the identified goods constitute illegal drug paraphernalia under the federal Controlled Substances Act (CSA) and therefore use of the marks in commerce is unlawful. Applicant maintained that it does business only in states where marijuana is legal, but the Board, however, ruled that the CSA controls. Citing *In re Brown*, the Board observed that use of a mark must be “lawful” if the mark is to qualify for federal registration. “[A]ny goods ... for which the mark is used must not be

illegal under federal law.” It follows that if the goods on which a mark is intended to be used are unlawful, there can be no *bona fide* intent to use the mark in lawful commerce. When the goods are illegal under the CSA, the applicant cannot use its mark in lawful commerce and it is legally impossible for the applicant to have the requisite *bona fide* intent to use the mark. [The POWERED BY JUJU application was based on Section 1(b) intent to use].

15. Application of the “Clear Error” Standard

a. *In re Driven Innovations, Inc.*, 115 USPQ2d 1261 (TTAB 2015). After receiving a notice of allowance, the applicant filed its statement of use for the mark DOTBLOG for “providing specific information as requested by customers via the Internet.” The examining attorney determined that the applied-for mark was merely descriptive of the services, and that it was “clear error” under Section 1109.08 of the TMEP to have failed to refuse registration, during initial examination, on the ground of mere descriptiveness. He therefore entered refusals to register the mark under Sections 1, 2, 3 and Section 2(e)(1) of the Lanham Act. The applicant argued that the refusal was improper because it was not a “clear error.” According to 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.”

16. Amendment Beyond Original Scope

a. *In re Jimmy Moore LLC*, 119 USPQ2d 1764 (TTAB 2016). Applicant Jimmy Moore LLC struck out in its attempt to register the mark PITCHINGSMART for “entertainment in the nature of baseball games.” Recognizing that this original recitation of services was incorrect, applicant immediately tried to amend its identification to a pitching training system, and then to educational services, but the examining attorney rejected the amended identifications as beyond the scope of the original, and concluded that applicant’s specimens of use did not show the mark in use with the original recited services. Applicant petitioned the Director to reverse the refusal, but the Director pointed out “an applicant who selects the wrong identification of services in the initial application must file a new application if the identification cannot be amended within the scope of the original identification.” The Board declined to revisit the Director’s decision, and it agreed with the examining attorney that the proposed amendments were unacceptable and that applicant’s specimens did not show use of its mark with the identified services.

17. Response to Rule 2.61 Request for Information

a. *In re Emergency Alert Solutions Group, LLC*, 122 USPQ2d 1088 (TTAB 2017). The Board affirmed a refusal to register the term LOCKDOWN ALARM on the

Supplemental Register, finding it to be generic for “Training services in the field of school safety ... and crisis preparedness” (discussed above), but it reversed a refusal based on applicant’s supposed failure to adequately respond to a Rule 2.61(b) request for information. The examining attorney asserted that applicant failed to respond suitably to three questions contained in the Rule 2.61 request for information. The Board disagreed. “[E]xamining attorneys should not elevate the form of an applicant’s response to an information requirement over its substance. We find that Applicant was reasonably forthcoming in its responses, and did not withhold the required information. It merely insisted on giving the information in its own words, coupled with submission of a sample of its advertising.”

18. Failure to Address Grounds for Refusal on Appeal

a. *In re Heather Harley and Carolyn Jones*, 119 USPQ2d 1755 (TTAB 2016). The Board affirmed the USPTO’s refusal to register the mark HEMP HOME HEALTH for “home health care services” because Applicants, in their appeal, failed to address the three grounds of refusal: mere descriptiveness or deceptive misdescriptiveness under Section 2(e)(1) and failure to respond to a Rule 2.61(b) request for information. During prosecution, the PTO also advised applicants regarding a possible refusal based on unlawful use, and it requested certain information under Rule 2.61: concerning the significance of HEMP as applied to the services, whether the services comply with the federal Controlled Substances Act, and whether applicants will be using hemp-based products in their services. Applicants did not comply fully with the Rule 2.61 request and the PTO made the three refusals final. The Board observed that applicant’s arguments on appeal “suggest that they are attempting to appeal a mere advisory statement made in the examining attorney’s Office Actions.” But an advisory action is not a refusal to register. The filing of a notice of appeal has the effect of appealing all refusals or requirements made final. Applicants’ failure to address these refusals is a basis for affirming the refusal of registration on all grounds.

**II. INTER PARTES CASES**

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

1. Section 2(d) Likelihood of Confusion

a. Likelihood of Confusion Not Found

i. *Juice Generation, Inc. v. GS Enterprises LLC*, 115 USPQ2d 1671 (Fed. Cir. 2015). The CAFC vacated and remanded the TTAB’s decision that 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 court found that the Board’s treatment of the evidence of use and registration 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.” The court also pointed out that third-party registrations 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.” The Board, however, never inquired as to whether PEACE & LOVE has a suggestive or descriptive connotation.

ii. *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 and registrations, 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 its ruling.

iii. *Oakville Hills Cellar, Inc., dba Dalla Valle Vineyards v. Georgallis Holdings, LLC*, 119 USPQ2d 1286 (Fed. Cir. 2016). Ruling that substantial evidence supported the Board’s findings, and agreeing with the Board’s conclusion that the marks MAYARI and MAYA, both for wine, are sufficiently dissimilar to avoid confusion, the CAFC affirmed the Board’s dismissal of this Section 2(d) opposition. Likelihood of confusion is a legal conclusion based on findings of fact under the *du Pont* factors. The first factor requires the Board to consider the marks in their entirety as to appearance, sound, meaning, and commercial impression. “[T]he Board correctly found that the unfamiliar MAYARI is distinguishable from the familiar MAYA, and that the marks, considered in their entirety, are dissimilar as to appearance, sound, meaning, and overall commercial impression. We also conclude, on this record, that the Board did not err in balancing all relevant *DuPont* factors and in determining that the dissimilarity of the marks was sufficient to preclude a likelihood of confusion.” The court observed that “a single *du Pont* factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks.”

## 2. Use in Commerce

a. *Christian Faith Fellowship Church v. adidas AG*, 120 USPQ2d 1640 (Fed. Cir. 2016). Reversing the TTAB, the CAFC ruled that the sale of two hats at the Church’s bookstore to an out-of-state purchaser constituted use in commerce of applicant’s mark ADD A ZERO. The Board had granted the petition of adidas AG for cancellation of two registrations owned by the Church for the mark ADD A ZERO, in standard character and design form, for “clothing, namely shirts and caps,” finding that these sales were *de*



*minimis* and insufficient to show use that affects interstate commerce. The CAFC observed, however, that “when a general regulatory statute bears a substantial relation to commerce, the *de minimis* character of individual instances arising under that statute is of no consequence,” and Congress has the power to regulate it under the Commerce Clause. *Gonzalez v. Raich*, 545 U.S. 1, 17 (2005), quoting *United States v. Lopez*, 514 U.S. 549, 558 (1995). The CAFC pointed out that the Church was not required to present evidence of “an actual and specific effect that its sale of hats to an out-of-state resident had on interstate commerce. Nor did it need to make a particularized showing that the hats themselves were destined to travel out of state.”

## **B. Trademark Trial and Appeal Board**

### **1. 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 its 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.

2. 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 inadequate pleading.

3. Section 2(d) Likelihood of Confusion

a. Likelihood of Confusion Found

i. *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.

ii. *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. With regard to Sanyang’s remaining goods and services, the evidence of relatedness was insufficient or totally lacking, and so the Board dismissed the opposition as to the goods and services in Classes 7, 11, 12, 16, and 37.

iii. *Beverly A. Bond v. Michael Taylor*, 119 USPQ2d 1049 (TTAB 2016). In a case that “illustrates the efficiency of the Board’s Accelerated Case Resolution procedure (‘ACR’),” the TTAB sustained a Section 2(d) opposition to the mark BLACK MEN ROCK & Design for “caps, hats, jackets, t-shirts” and for “education services ... in the field of personal development.” The Board found the mark likely to cause confusion with the registered mark BLACK GIRL’S ROCK! for “tee shirts,” “charitable services, namely organizing volunteer programs for at-risk teenage women of color,” and “entertainment, namely, a continuing award show ... and live musical performances.” Each party had filed an unsuccessful summary judgment motion, leading the Board to encourage them to stipulate to resolution of the proceeding via the ACR procedure. In order to take advantage of ACR, the parties must stipulate that the Board may resolve any genuine disputes of material fact “in the context of something less than a full trial.” The parties so stipulated, and further agreed to rely upon the evidence from the summary judgment motion, with supplemental declarations, and to limit supplemental briefing to ten pages with no reply briefing.

b. Likelihood of Confusion Not Found

1. *Mini Melts, Inc. v Reckitt Benckiser LLC*, 118 USPQ2d 1464 (TTAB 2016). The Board rendered a split decision in this opposition to registration of the marks MINIMELTS and MINI-MELTS for “pharmaceutical preparations for use as an expectorant.” It dismissed opposer’s Section 2(d) claim of likely confusion with the registered mark MINI MELTS for ice cream, but sustained a Section 2(e)(1) mere descriptiveness claim, finding applicant’s proof of acquired distinctiveness inadequate. As to the Section 2(d) claim, the Board not surprisingly found the marks to be virtually identical, and this first *du Pont* factor weighed heavily in opposer’s favor. However, there was no evidence that a single entity produces both ice cream and pharmaceutical preparations, and the Board concluded that, notwithstanding the virtual identity of the marks, the significant differences between the goods made confusion unlikely.

2. *Primrose Retirement Communities, LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030 (TTAB 2016). According “significant weight” to applicant’s evidence of third-party use and registration of marks containing the word “rose” for retirement home services, the Board dismissed this opposition to registration of the mark ROSE SENIOR LIVING for management of senior housing communities, providing assisted living facilities, and nursing home services (SENIOR LIVING disclaimed). Opposer claimed a likelihood of confusion with its registered mark PRIMROSE for “providing congregate, independent, and assisted living facilities.” Applicant submitted evidence of eight existing registrations for marks containing the word “rose” in the field of assisted living services, and more than 90 websites showing various ROSE or ROSE-containing marks used in connection with senior living communities and related services. In addition, applicant provided expert testimony averring that the word “rose” is “commonly used as a naming convention for many senior living communities under different ownership.” The expert listed 76 senior living communities using the word “Rose” as part of their names. The Board observed that, under the CAFC’s recent *Jack Wolfskin* decision, evidence of extensive use and registration of a term by others as a mark can be

“powerful on its face, even when the specific extent and impact of the usage has not been established.”

#### 4. Section 2(f) Acquired Distinctiveness

a. *Ayoub, Inc. and Ayoub Supply, LLC v. ACS Ayoub Carpet Service*, 118 USPQ2d 1392 (TTAB 2016). The Board sustained a rare Section 2(e)(4) opposition to registration of the mark AYOUB for “retail carpeting and drug stores” and “carpet and rug cleaning services,” finding that applicant failed to prove acquired distinctiveness under Section 2(f) because use of its mark was not “substantially exclusive.” In response to a Section 2(e)(4) surname refusal, applicant had amended its application to seek registration under Section 2(f), claiming “substantially exclusive and continuous use” of the mark for at least the immediately preceding five years. The only issue in this opposition was whether AYOUB had acquired distinctiveness under Section 2(f). Opposes’ own use of the surname Ayoub from 1996 to 2015 was “not insubstantial.” Moreover, testimonial and documentary evidence established use of Ayoub by third-parties in the same or similar business. The Board noted that “absolute exclusivity” is not required to satisfy Section 2(f) but “the widespread use of the surname Ayoub by unaffiliated rug, carpet and flooring businesses is inconsistent with Applicant’s claim of acquired distinctiveness of AYOUB.”

b. *Terry Nazon, d/b/a Terry Nazon Inc. v. Charlotte Ghiorse*, 119 USPQ2d 1178 (TTAB 2016). The Board dismissed this Section 2(d) opposition to registration of the mark SEXY ASTROLOGY for “astrology consultation” because Opposer Terry Nazon failed to prove proprietary rights in her mark SEXSTROLOGY, registered on the Supplemental Register for services in the nature of “astrology horoscopes.” Because Nazon owned a Supplemental Registration for her mark, priority was not an issue. However, a registration on the Supplemental Register is not entitled to the presumptions of Section 7(b) of the Lanham Act, and is not evidence that Nazon owned proprietary rights in her mark. A mark so registered is presumed to be merely descriptive and Nazon had the burden to establish acquired distinctiveness. Since priority was not an issue, Nazon was not required to establish acquired distinctiveness prior to any date on which Applicant Ghiorse might rely. The question was whether Nazon “has now established proprietary rights in SEXSTROLOGY.” Third-party descriptive uses of SEXSTROLOGY and SEXTROLOGY undermined Nazon’s claim. Moreover, she admitted that “Sexstrology” may have been viewed as the subject matter of her services rather than as a source indicator.

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

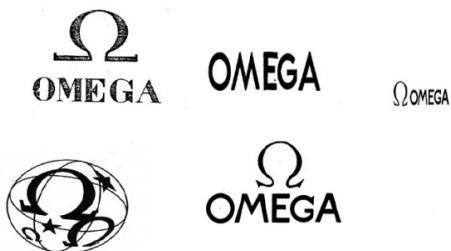
a. *Swiss Grill Ltd., John Hartwig, Christopher Hartwig and Matthew Hartwig v. Wolf Steel Ltd.*, 115 USPQ2d 2001 (TTAB 2015). In another case decided under the TTAB’s Alternative Case Resolution (ACR) procedure, the Board sustained an opposition to registration of the mark SWISS GRILLS for “barbecue 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 barbeque 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."

6. Dilution

a. *Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289 (TTAB 2016). The Board denied Alpha Phi Omega's motion for summary judgment aimed at opposer's likelihood of confusion and dilution claims based on opposer's OMEGA marks (shown below left) for watches, clothing, and retail store services featuring watches and jewelry. However, the Board entered summary judgment on both claims as to applicant's mark shown below right (the Crest Mark) on the ground that the subject marks are too dissimilar to support either claim. With regard to applicant's ΑΦΩ standard character mark, the Board denied applicant's motion regarding likelihood of confusion due to genuine issues of material fact



regarding the similarity of the involved marks and the relatedness of the goods and services. On the dilution claim, the Board ruled that a dilution-by-blurring claimant must prove that its mark became famous "prior to *any*

*established, continuous use* of the defendant's involved mark as a trademark or trade name." Genuine issues of fact existed as to whether the involved marks are sufficiently similar that applicant's mark "conjures up an association" with opposer's mark, and as to when applicant first used the ΑΦΩ mark in interstate commerce, whether as a trade name for a fraternal organization or as a trademark for any goods.

b. *Mini Melts, Inc. v Reckitt Benckiser LLC*, 118 USPQ2d 1464 (TTAB 2016). As noted above, the Board rendered a split decision in this opposition to registration of the marks MINIMELTS and MINI-MELTS for "pharmaceutical preparations for use as an expectorant." It dismissed opposer's Section 2(d) claim of likely confusion with the registered mark MINI MELTS for ice cream, but sustained a Section 2(e)(1) mere descriptiveness claim, finding applicant's proof of acquired distinctiveness inadequate. As to the mere descriptiveness claim, Applicant relied on a declaration that the mark was in continuous and substantially exclusive use for the five years preceding its filing date. It also pointed to sale of approximately 779 million doses of its product, and to advertising expenditures of more than \$20 million dollars

in a four-year period ending in 2010. The Board, in view of the degree of descriptiveness of the mark, found the evidence insufficient to establish acquired distinctiveness.

7. Failure to Function

a. *D.C. One Wholesaler, Inc. v. Jonathan E. Chien*, 120 USPQ2d 1710 (TTAB 2016). The Board sustained an opposition to registration of the mark “I ♥ DC” in design form for various clothing items, and ordered cancellation of a registration (on the Supplemental Register) for a slight variation of that mark, for backpacks, clothing, and stuffed toys, on the ground that the marks fail to function as trademarks. Plaintiff argued that “I ♥ DC” is a common slogan used in an informational sense, and that consumers are accustomed to seeing the phrase on goods from multiple sources. The evidence demonstrated that apparel bearing the phrase is available from many suppliers, as is merchandise prominently displaying the phrase, such as mugs, teddy bears, aprons, etc. Plaintiff also showed that designs consisting of “I ♥” followed by other terms (RUGBY, KETCHUP, JESUS, etc.) are common in the souvenir industry. Defendant testified that he did not create the design and that the logo “has been out since the ‘60s for anyone to use.” The Board concluded that consumers purchase the product because of this ornamentation, which appears as informational matter not associated with a particular source. Because of the informational nature and the ubiquity of the phrase, it does not convey source even when used on a hangtag.



8. Fraud

a. *Daniel J. Quirk, Inc. v. Village Car Company*, 120 USPQ2d 1146 (TTAB 2016). The Board dismissed a petition for cancellation of registrations for the marks QUIRK and QUIRK AUTO PARK for “automobile dealership” because petitioner failed to prove its claim of fraud on the USPTO. Petitioner asserted that respondent’s underlying applications were executed fraudulently because respondent (admittedly) knew of and failed to disclose petitioner’s allegedly prior rights in the marks QUIRK and QUIRK WORKS TO SAVE YOU MONEY for auto dealerships. However, petitioner failed to establish superior rights in its mark, and that alone was fatal to its fraud claim. The Board nonetheless proceeded to consider the issue of fraudulent intent, concluding that petitioner failed to demonstrate that respondent intended to deceive the USPTO. As we all know, fraud must be proven “to the hilt” with clear and convincing evidence. Fraud will not lie against a party who holds an honest and good faith belief in its right to register a mark and who verifies the statutorily prescribed ownership statement, which is phrased in terms of subjective belief. There was nothing in the record to indicate that respondent’s belief that - because petitioner’s use was intrastate – it had prior rights in the mark, was not an honest belief.

9. Ownership

a. *UVeritech, Inc. v. Amax Lighting, Inc.*, 115 USPQ2d 1242 (TTAB 2015). This cancellation 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 by respondent, but respondent maintained that 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.

b. *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 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. Parent/Subsidiary Control

a. *Noble House Home Furnishings, LLC v. Floorco Enterprises, LLC*, 118 USPQ2d 1413 (TTAB 2016). The Board granted this petition for cancellation of a registration for the mark NOBLE HOUSE for furniture, ruling that Respondent Floorco had abandoned the mark. The Board held that use of a wholly-owned subsidiary's registered mark by a parent entity does not inure to the benefit of the subsidiary when the parent controls the nature and quality of the goods. Respondent Floorco asserted that it had been marketing and advertising NOBLE HOUSE brand furniture. However, it was not Floorco that was marketing and advertising the products, but its parent corporation, Furnco. Moreover, the latter controlled the nature and quality of the furniture that may have been sold. The Board noted that in most cases the affairs of a subsidiary are controlled by the parent, and so no license or other agreement is needed regarding a mark owned by the parent and used by a subsidiary. Here, however, Furnco authorized its subsidiary, Floorco, to be the owner of the registration, but parent Furnco did not meet the definition of a related company under the Lanham Act – *i.e.*, an entity whose use of the mark is controlled by the registrant with respect to the nature and quality of the goods. Therefore, as to the abandonment issue, the parent's use of the mark cannot be deemed use of the mark by the subsidiary, and "cannot show that Respondent intended to resume use of the NOBLE HOUSE mark."



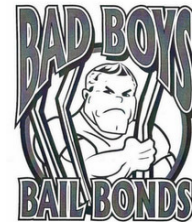
11. Family of Marks/Unity of Control

a. *Wise F&I, LLC; Financial Gap, Administrator LLC; Vehicle Service Administrator LLC; and Administration America LLC v. Allstate Insurance Company*, 120 USPQ2d 1103 (TTAB 2016). The Board dismissed this consolidated opposition to registration of the marks MILEWISE and ALLSTATE MILEWISE for insurance services, based on claims of likelihood of confusion with opposers' family of WISE-formative marks. Applicant Allstate moved to dismiss under FRCP 12(b)(6) for failure to state a claim, asserting that the pleaded marks are not owned by a single entity and therefore cannot, as a matter of law, comprise a family of marks. Allstate further asserted that opposers failed to allege that the common characteristic of the purported family of marks is distinctive and that the marks have been used and promoted in such a way that consumers would associate the common characteristic WISE with a single source. The Board agreed with Allstate on both points. It ruled that the marks in a family of marks may be owned by different entities if there is "unity of control," but opposer failed to plead unity of control, and it also failed to properly allege a family of marks.. The Board allowed opposers 30 days within which to submit amended notices of opposition (or a single consolidated notice).

12. 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, promoted by celebrity 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 that it sought.

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 Bad Boys failed to prove that its use of the applied-for mark commenced before the filing date of the application underlying defendant's registration. 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 the discussions.

13. Claim Preclusion/Issue 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.'"

c. *NH Beach Pizza LLC v. Cristy's Pizza Inc.*, 119 USPQ2d 1861 (TTAB 2016). In November 2015, the Board dismissed a cancellation petition brought by NH Beach Pizza LLC because NH failed to prove standing. NH then filed a new petition for cancellation on the same ground as the prior petition. Respondent moved for summary judgment on the basis of

collateral estoppel (issue preclusion) because the issue of standing had already been decided against Petitioner NH. The Board granted the motion and dismissed the new petition. Under *B & B Hardware, Inc. v. Hargis Indus., Inc.*, issue preclusion bars the re-litigation of the same issue in a second action. As to the first element, Petitioner pled the same basis for standing as in the first proceeding: that it uses “the generic term ‘beach pizza’” to promote its goods and that respondent claimed that this usage caused actual consumer confusion. As to the second element, the issue of standing was actually litigated and decided in the prior proceeding. The fact that the basis for the decision was NH’s failure to provide evidence of its standing does not change the fact that the issue was actually litigated. The third factor was met because the standing determination was necessary to the Board’s prior decision. The fourth factor was satisfied because Petitioner NH was fully represented in the prior proceeding and had a full and fair opportunity to introduce testimony or other evidence on the issue of its standing.

d. *Chutter, Inc. v. Great Concepts, LLC*, Canc. No. 92061951, 119 USPQ2d 1865 (TTAB 2016). The Board entered summary judgment in favor of petitioner on the issue of claim preclusion in this proceeding seeking cancellation of a registration for the mark DANTANNA’S for “steak and seafood restaurant.” Respondent contended that petitioner’s sole claim, based on the allegedly fraudulent filing of a Section 15 declaration, could have been raised in an earlier cancellation proceeding brought by petitioner and dismissed for failure to prosecute, and therefore the claim was barred. The Board, however, ruled that the claim of fraud in this proceeding was not based on the same transactional facts as petitioner’s earlier fraud claim, and therefore was not barred. The first fraud claim concerned a failure to reveal during *ex parte* examination of the underlying application, that the mark identified a living individual. In contrast, the second proceeding involves alleged fraud based on a different representation made at a time removed by six years from the *ex parte* issue involved in the prior proceeding. The earlier claim involved communication with the examining attorney, while the later claim involved communication with the Post Registration Section of the USPTO. “These are very different fact sets, and the transactions are unrelated; they are not ‘so woven together as to constitute a single claim in their relatedness in time, space, origin, or motivation ....’”

#### 14. Procedural Issues

##### a. 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. 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.

2. *DFC Expo LLC v. Coyle*, 121 USPQ2d 1903 (TTAB 2017). DFC Expo LLC tried to oppose Brian Coyle’s application to register the mark SODA CITY FIRE DEPT. for Mobile beverage cart services,” but it turned out to be a false alarm. DFC’s notice of opposition was untimely, did not include the required fee payment, and was filed on paper without the required petition to the Director of the USPTO. On February 6, 2017, the deadline date for opposition, DFC’s counsel mailed the notice of opposition to the USPTO, accompanied by a letter claiming that he had attempted to file the notice electronically via ESTTA but could not access the payment screen. The notice of opposition was filed without a certificate of mailing under Trademark Rule 2.197(a), and so the effective date of the filing was the date of receipt by the USPTO, February 9, 2017. Therefore, the notice was untimely. A separate ground for rejecting the notice was DFC’s failure to pay the required fee. Finally, under the amendments to the Trademark Rules that took effect on January 14, 2017, a notice of opposition must be filed electronically via the ESTTA system. However, the notice of opposition may be filed in paper form if “ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present.” However, in such case, the paper opposition must “be accompanied by a petition to the Director under Rule 2.146, with the fees therefor and the showing required.” DFC did not file the required petition with its notice. [In any case, the ESTTA system was down for only a few hours on the deadline day.]

b. 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 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.

c. 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 after August 12, 2009. Here the Notice of Allowance issued on July 28, 2009, giving Delphix until January 28, 2010 to file its Statement of Use. 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.”

d. 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.”

e. Tolling of Section 14 for Adding Cancellation Claim

i. *Ashland Licensing & Intellectual Property LLC v. Sunpoint International Group USA Corp.*, 119 USPQ2d 1125 (TTAB 2016). Ashland Licensing petitioned to cancel two registrations for the mark MAXOLINE, in standard and design forms, for “lubricants for automobiles,” within five years of issuance of each of the registrations, on the grounds of likelihood of confusion and abandonment. After the five-year anniversary dates, Ashland filed a motion to add a claim for nonuse. the Board granted the motion, ruling that the commencement of a cancellation proceeding tolls Lanham Act Section 14 for the purpose of adding claims against a challenged registration. Section 14 of the Lanham Act provides that, prior to the fifth anniversary date of a registration, a party may plead any ground for cancellation of a registration, but after that date a petition to cancel must be restricted to certain grounds enumerated in Section 14 (genericness, fraud, abandonment, functionality, and a few others). Nonuse is not one of them. Nonetheless, The Board found this case to be congruent with *The Williamson-Dickie Mfg. Co. v. Mann Overall Co.*, 359 F.2d 450, 149 USPQ 518 (CCPA 1966), wherein the CCPA ruled that in an opposition filed prior to the fifth anniversary of the opposer’s pleaded registration, Section 14 does not bar the filing of a Section 2(d) counterclaim to cancel

the pleaded registration even though more than five years had then passed since issuance of the registration.

f. 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 existed 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 had 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 controlled 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 upheld opposer's objection to the changed testimony and the 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. It did not show that applicant was not the owner of the mark.

15. Discovery and Motion Practice

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

i. *Guess? IP Holder L.P. v. Knowlux LLC*, 116 USPQ2d 2018 (TTAB 2015). The Board had denied Respondent Knowlux'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 Knowlux likewise had no luck. In its 12(b)(6) motion, Knowlux 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 Knowlux'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 Amend Opposed Application

1. *Wisconsin Cheese Group, LLC v. Comercializadora de Lácteos y Derivados, S.A. de C.V.*, 118 USPQ2d 1262 (TTAB 2016). In this consolidated opposition to

registration of the mark SOYSALUD for various products in International Classes 29, 30, and 32, applicant filed a motion to amend its opposed Section 1(b) intent-to-use applications to limit the goods (various beverages) to soy-based products. Opposer based its opposition in part on Section 2(a) deceptiveness and Section 2(e)(1) deceptive misdescriptiveness, alleging that applicant's original identifications of goods included products that did not contain soy. Applying the framework set out in *Johnson & Johnson v. Stryker Corp.*, 109 USPQ2d 1077 (TTAB 2013), the Board granted the motion. Applicant unconditionally consented to judgment as to the Sections 2(a) and 2(e)(1) claims with respect to the broader identifications of goods for which the applications were published, and it made a *prima facie* showing that the proposed amendments "serve to change the nature and character of the goods so as to introduce a substantially different issue for trial with respect to the Sections 2(a) and 2(e)(1) claims." The Board entered judgment in favor of opposer as to its Section 2(a) and Section 2(e)(1) claims with respect to all goods encompassed by applicant's broader identifications of goods.

c. 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.

d. Motion for Discovery Sanctions

i. *Emilio Pucci International BV v. Rani Sachdev*, 118 USPQ2d 1383 (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). [Ultimately, the Board dismissed the case as a discovery sanction for Sachdev’s failure to respond to the discovery requests.]

e. Motion to Allow Sur-Rebuttal Expert Report

i. *Newegg Inc. v. Schoolhouse Outfitters, LLC*, 118 USPQ2d 1242 (TTAB 2016). In this Section 2(d) opposition, the Board granted Opposer Newegg’s motion for leave to prepare and serve a sur-rebuttal expert report. The Board refused to read FRCP 26(a)(2)(D) as prohibiting sur-rebuttal reports, concluding that, in light of the two conflicting expert surveys, a sur-rebuttal report to analyze and critique applicant’s rebuttal survey would “benefit the Board in its ability to make a just determination of the merits of the case.” Opposer’s expert, Dr. Kaplan, conducted a survey on the issue of likelihood of confusion between the NEWEGG and EGGHEAD marks. In rebuttal, applicant’s expert, Dr. Ericksen, conducted a likelihood of confusion survey employing a different method. Opposer then filed a motion seeking permission to serve a sur-rebuttal report. Many courts have ruled that FRCP 26(a)(2)(D) does not contemplate or permit sur-rebuttal expert disclosures. The Board did not so read the rule. “Instead, the Board finds that, under appropriate circumstances, a sur-rebuttal expert would be proper,” as long as the request is made promptly. The Board ruled that Dr. Kaplan’s report must be limited to rebuttal and/or critique of “the methodology of the survey conducted by Dr. Erickson, as well as the analysis of the data resulting from the survey.” Applicant was allowed to depose Dr. Kaplan again, limited to the new subject matter.



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 resulted in assignment to the University of applicants' rights in the HOUNDSTOOTH MAFIA mark, including the opposed application. The consent judgment required that the Board's decision 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 original decision, in compliance with the consent judgment entered by the court. The Board promptly complied.]