

Keeping Tabs on the TTAB®

The Top Ten TTAB Decisions of 2015®

By John L. Welch

The TTAB issued more than 600 final decisions in 2015, as well as numerous interlocutory rulings. Forty-one of its opinions were deemed precedential. Once again yours truly has unabashedly chosen the 10 decisions that he believes are the year's most important and/or interesting. Eight are precedential decisions and two (or three, depending on how you count) are not. Perhaps the precedential determinations are the more important because they constitute binding precedent, but the non-precedential ones at a minimum have educational and/or entertainment value. Or at least I hope so.

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) [precedential]. 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 below, for "shirts, hats." A subsequent civil action under Section 21(b)(1) of the *Trademark Act* for review of the TTAB's decision resulted in settlement and entry of a consent judgment, which in part ordered that the Board's decision be vacated. In settling the case, the parties submitted to the court a Final Consent Judgment, which would result in assignment to the University of applicants' rights in the HOUNDSTOOTH MAFIA mark, including the opposed application. The parties agreed that the Board's Order should be vacated. The Board, however, concluding that 28 U.S.C. Section 2106 was not implicated and, noting that Rule 60(b) was not invoked, ruled that Section 21(b)(1) did not require vacatur. The Board then considered the matter in view of its "general equitable authority." It saw no exceptional circumstances or any public interest that would require vacatur. The decision was deemed precedential in order to provide guidance to practitioners. The consent judgment did not point to any error in the Board's decision, and nothing suggested a public interest that would be advanced by vacatur and that would outweigh the Board's determination that the decision had precedential value. [The case is now pending



in the district court, after intervention by the USPTO, on the University's motion to enforce the consent decree].

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



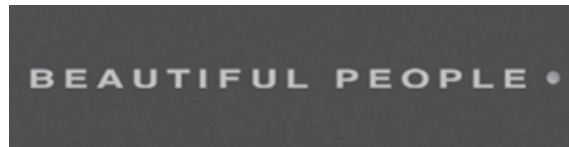
Ava Ruha Corporation dba Mother's Market & Kitchen v. Mother's Nutritional Center, Inc., 113 USPQ2d 1575 (TTAB 2015) [precedential]. In this consolidated cancellation proceeding involving allegations of likelihood of confusion, dilution, and fraud, the parties filed cross-motions for summary judgment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

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



Joshua Domond v. 37.37, Inc., 113 USPQ2d 1264 (TTAB 2015) [precedential]. In this cancellation proceeding challenging a registration for the mark BEAUTIFUL PEOPLE for various clothing items, Petitioner Joshua Domond served 872 requests for admission, 247 document requests, and 26 interrogatories in the first two days of the discovery period. Respondent 37.37, Inc. moved for a protective order under Fed. R. Civ. P. 26(c), requesting that the Board limit the discovery items to a reasonable number. The Board found the discovery requests to be “excessive, unduly burdensome and harassing in number and content” when viewed in light of the issues raised in the proceeding, and it granted the motion, limiting the total number of discovery requests to 150, absent prior Board review and approval. Petitioner alleged fraud, abandonment, and likelihood of confusion, and claimed that the challenged registration was void *ab initio* because respondent’s specimen failed to show use in commerce. The Board pointed out that while parties to a proceeding are generally allowed to seek discovery as they deem necessary, they are expected to take into account the principles of proportionality so that the volume is not harassing or oppressive, and they are expected to consider the scope of the requests as well as to confer in good faith so as to minimize the need for

motions. The Board granted the motion for a protective order, and it warned petitioner that further uncooperative or harassing behavior may result in the imposition of sanctions, and possibly entry of judgment.

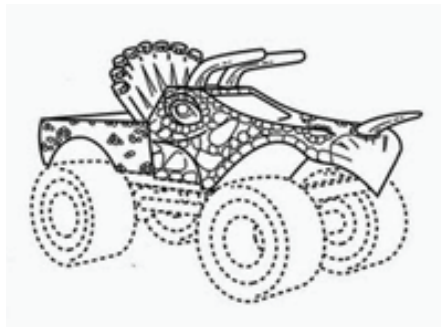


INTS It Is Not The Same, GmbH v. Disidual Clothing, LLC, Opposition No. 91212768 (March 28, 2015) [not precedential]. The Board denied a petition to disqualify counsel for Opposer INTS, ruling that, although the attorney had signed and verified certain documents pursuant to a power of attorney from opposer, he was not the sole source for information regarding those documents and therefore was not a “necessary witness.” Opposer’s counsel signed and filed applications, statements of use, renewals, and/or declarations of use and incontestability, in connection with opposer’s pleaded registrations, pursuant to a Power of Attorney from opposer. Section 11.307(a) of the USPTO Rules of Professional Conduct indicates when a “practitioner for a party” who may become a witness in a USPTO proceeding should be disqualified. The first question was whether opposer’s attorney was a “necessary witness,” *i.e.*, whether “no other person is available to testify in his place.” Here, there was no showing that opposer’s counsel alone would need to testify to the contents of the documents he signed. “Evidence and information as to the contents of those submissions can be found elsewhere.” The Board noted, “[i]n passing, a policy of disqualifying an attorney for signing a declaration on behalf of his client, especially where it is permitted by the Trademark Rules of Practice, without anything more, would have an undesired consequence of rendering many attorneys practicing before the Board eligible for disqualification.”

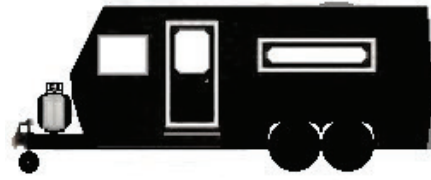


In re Frankish Enterprises Ltd., 113 USPQ2d 1964 (TTAB 2015) [precedential]. The Board reversed a

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



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



***In re Engine 15 Brewing Co., LLC*, S.N. 86038803 (October 29, 2015)[not precedential] and *In re Left Nut Brewing Company, Inc.*, S.N. 85935569 (November 13, 2015) [not precedential].** This pair of “nut” cases may be interesting, but perhaps not very important after the CAFC’s decision in *In re Tam*, since the complete demise of the Section 2(a) immoral or scandalous refusal seems imminent. The Board reversed Section 2(a) refusals, finding the marks NUT SACK DOUBLE BROWN ALE and LEFT NUT BREWING COMPANY for beer, not to be immoral or scandalous. The Board observed that the USPTO may prove that a mark is scandalous under Section 2(a) by showing that the mark is “vulgar” as applied to the identified goods. The mark must be considered in light of contemporary attitudes, from the standpoint of a substantial composite (not necessarily a majority) of the public. The Board has noted for several decades that “contemporary attitudes toward coarse language are more accepting than they had been in earlier eras.” As to the first mark, the Board concluded that “beer drinkers can cope with Applicant’s mark without suffering meaningful offense.” Even when the consumer thinks of body parts or insults, he or she is still likely to see the mark as an attempt at humor. As to the second, in view of the mixed record of vulgar and non-vulgar meanings, the Board ruled that the evidence had failed to establish that LEFT NUT is vulgar: the term has even been use “by senators and web-authors with no evidence of offense or disapproval” and the PTO has registered similarly-suggestive “nut” marks.



***Southwestern Management, Inc. v. Ocinomled, Ltd. and Emeril's Food of Love Productions, LLC*, 115 USPQ2d 1007 (TTAB 2015) [precedential].** Concluding that there would be a likelihood of confusion even in Applicant Southwestern Management's current territory (upstate New York), the Board dismissed this proceeding involving a concurrent use application for the mark DELMONICO'S for "restaurant services." Southwestern, the junior user but first to file an application to register, sought a nationwide registration except for the areas of use of the two named Defendants. However, the renown of the Defendants' restaurants (one in New York City (DELMONICO'S), the heir apparent to the historical restaurant of that name, the other based in New Orleans (DELMONICO) and promoted by Chef Emeril Lagasse) made it likely that confusion would occur even if applicant's registration for "restaurant services" were limited to upstate New York. In short, Southwestern failed to carry its burden of proof to show that confusion is not likely. The Board hastened to add that its determination did not, in some respects, take into account actual marketplace conditions, and affected only the issue of registrability and not Southwestern's right to use the mark. And so the Board denied Southwestern the concurrent use registration requested.



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

survey, on the other hand, comported with best practices. It reported a 2 percent likelihood of confusion among relevant purchasers, based on 410 respondents, and the Board found that this supported a conclusion that confusion is not likely.



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