

**Decisions of the Federal Circuit and the
Trademark Trial and Appeal Board on Registrability Issues
July 2020 to June 2021**

By John L. Welch*

PART I. EX PARTE CASES

A. United States Court of Appeals for the Federal Circuit

1. Registrability of Color for Product Packaging

***In re Forney Industries, Inc.*, 2020 USPQ2d 10310 (Fed. Cir. 2020) [precedential].** The U.S. Court of Appeals for the Federal Circuit (CAFC) weaved its way through Supreme Court precedent on the law of color marks in vacating and remanding the TTAB’s decision upholding a refusal to register a color mark for multiple colors applied to product packaging. The Board concluded that such a mark cannot be inherently distinctive, but the CAFC disagreed, holding that “color marks can be inherently distinctive when used on product packaging, depending upon the character of the color design.” Forney sought to register a mark comprising the colors “red into yellow with a black banner located near the top as applied to packaging” for metal hardware, welding equipment, safety goods, and marking products. The Board saw “no legal distinction between a mark consisting of a single color and one, such as [Forney’s], consisting of multiple colors without additional elements, e.g., shapes or designs.” The CAFC found that the Board had “erred in two ways: (1) by concluding that a color-based trade dress mark can never be inherently distinctive without differentiating between product design and product packaging marks; and (2) by concluding (presumably in the alternative) that product packaging marks that employ color cannot be inherently distinctive in the absence of an association with a well-defined peripheral shape or border.”



B. Trademark Trial and Appeal Board

1. Section 2(d) Likelihood of Confusion

***In re Joel Embiid*, 2021 USPQ2d 577 (TTAB 2021) [precedential].** Joel Embiid of the NBA’s Philadelphia 76ers was blocked in his attempt to register TRUST THE PROCESS for shoes, the Board affirming a Section 2(d) likelihood of confusion refusal based on the identical mark registered for shirts and sweatshirts (and owned by television host Marcus Lemonis). Mr. Embiid tried various moves to overcome the refusal but the Board shut down every one of them. Although the involved marks are identical, Mr. Embiid contended that the marks engender different commercial impressions: *i.e.*, the mark TRUST THE PROCESS is uniquely associated with him when used in connection with shoes, while the cited mark TRUST THE PROCESS is

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uniquely associated with Marcus Lemonis when used for shirts and sweat shirts. The Board was unmoved. There was nothing in the application or cited registration that would change the meaning of the marks and nothing in the record to show that “consumers would differentiate the source of the non-souvenir consumer goods sold under the two TRUST THE PROCESS marks based on their respective owners.” Invoking the 13th *DuPont* factor, Embiid pointed to his ownership of a registration for THE PROCESS for various clothing items, but the Board found “meaningful differences” between that mark and the proposed mark, and it further noted that the prior registration is less than five years old and still vulnerable to cancellation under Section 2(d).

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

***In re Dolce Vita Footwear, Inc.*, 2021 USPQ2d 478 and 479 (TTAB 2021)**

[precedential]. The Board upheld two Section 2(e)(1) refusals of the proposed mark CLEAR for footwear, lingerie, and other clothing items, and for handbags, purses, wallets and the like, all “excluding transparent goods,” finding the term to be deceptively misdescriptive thereof. The Board observed that consumers are not aware of the “nontransparent” limitation in the application, and not all purchases of Applicant Dolce Vita’s goods are made after direct inspection of the goods. Dictionary definitions and third-party website evidence convinced the Board that consumers “will perceive CLEAR as describing a feature” of Dolce Vita’s clothing and other items. The Board rejected Applicant’s contention that its proposed mark CLEAR does not describe a plausible feature of its goods because the identified goods do not include transparent footwear and clothing. “We cannot assume that consumers of Applicant’s goods will be aware that its identification is so restricted, and the restriction is not controlling of public perception.” The Board also rejected Dolce Vita’s argument that consumers are unlikely to believe the misrepresentation because they will visually inspect the goods before purchase, since not all consumers will have that opportunity.

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

***In re Recreational Equipment, Inc.*, 2020 USPQ2d 11386 (TTAB 2020)**

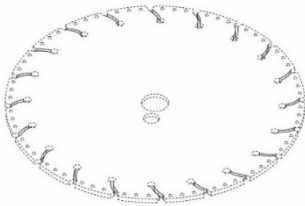
[precedential]. The Board reversed a Section 2(e)(1) mere descriptiveness refusal of the mark CO-OP for “bicycles, bicycle seats, bicycle wheels, bicycle tires, bicycle handlebars, bicycle forks, bicycle handle bar stems.” The examining attorney maintained that “co-op” merely describes something about Applicant REI, namely, that it is a cooperative business. According to the Board, the examining attorney effectively applied a per se rule: relying on *In re Major League Umpires*, “she found the mark merely descriptive of the source and then refused registration on the basis that the mark merely describes the goods.” Although that case broadly stated that, “a term which describes the provider of goods or services is also merely descriptive of those goods and services,” when read in context “it becomes clear that *Major League Umpires* does not require or support the use of a per se rule.” There, the mark MAJOR LEAGUE UMPIRE mark went well beyond simply describing something about the source of the goods. It also described characteristics of the goods: as to the source, the nature of the designer, and a portion of the classes of consumers. Here, there was no evidence “showing what consumers are likely to think when they see the CO-OP mark on bicycles or bicycle components.”

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

In re tapio GmbH, 2020 USPQ2d 11387 (TTAB 2020) [precedential]. The Board affirmed two refusals to register the proposed mark TAPIO for various Internet-related goods and services, finding applicant’s identification of goods unacceptably indefinite in part, and deeming the term TAPIO to be primarily merely a surname under Section 2(e)(4). The Board found the phrase “devices and services” in applicant’s Class 9 identification of goods to be indefinite because the phrase could include goods or services in more than one class. As to the surname refusal, the Board refused to adopt applicant’s proposed standard requiring “celebrity status,” “national notoriety,” or “significant media attention” in order to establish that a surname, although not common, has sufficient public exposure to be deemed primarily merely a surname. The examining attorney submitted LexisNexis® evidence showing 374 occurrences of the surname “Tapio,” database search results that included 71,018 “hits” for the surname “Tapio,” news items referring to five people who appear to be in the United States (including a South Dakota state senator) with the Tapio surname, and a page from the Internet website of one forty-year-old construction business located in Vancouver, Washington using the founder’s name, “Tapio.” The Board observed that “while TAPIO is not a common surname, there is meaningful and fairly widespread public exposure to the surname throughout the United States.” It further found that TAPIO has the structure and pronunciation of a surname and has no non-surname meaning, and so the Board concluded that TAPIO is primarily merely a surname.

5. Section 2(e)(5) Functionality

In re MK Diamond Products, Inc., 2020 USPQ2d 10882 (TTAB 2020) [precedential]. Affirming a Section 2(e)(5) refusal to register the product configuration mark shown here, for “circular saw blades for power operated saws,” the Board found the proposed mark to be *de jure* functional. Alternatively, the Board also agreed with the USPTO that Applicant MK Diamond failed to carry its “unusually high burden” of proving that the configuration has acquired distinctiveness. Four third-party utility patents, two pending applications, and evidence of third-party use confirmed that cut-outs interspaced along the outer edge of a circular saw blade, regardless of shape, are *de jure* functional because they provide one or more utilitarian benefits: they dissipate blade stress, prevent blade warpage, clean out kerf, and attain straighter cutting action. The Board concluded that applicant’s configuration ‘is dictated by the function it performs and is therefore essential to the use or purpose of the goods and as a whole is functional.’ *TraFFix*, 58 USPQ2d at 1006. For the sake of completeness, the Board considered applicant’s claim of acquired distinctiveness. However, the widespread use of substantially similar cut-outs undercut MK’s Section 2(f) claim, it failed to show “look-for” advertising, and its sales figures lacked industry context.



6. Section 2(f) Acquired Distinctiveness

In re Guaranteed Rate, Inc., 2020 USPQ2d 10869 (TTAB 2020) [precedential].

Conceding that GUARANTEED RATE is merely descriptive of its various mortgage lending services, applicant sought to register the phrase, and the word-plus-design mark shown here, on the basis of acquired distinctiveness under Section 2(f). The Board, however, found the phrase to be highly descriptive – indeed, a “key aspect” of the services – and ruled that applicant had failed to carry the proportionately higher burden of proof to show distinctiveness. The Board therefore affirmed the Section 2(e)(1) refusal of the word mark and likewise affirmed the requirement that applicant disclaim the phrase in the word-plus-design mark. Although applicant’s sales and advertising figures were “impressive,” the Board was not convinced that this evidence demonstrated consumer recognition as a source indicator due to the extensive evidence of third-party use. Applicant pointed to its two existing registrations for GUARANTEED RATE AFFINITY, containing Section 2(f) claims for GUARANTEED RATE, but the Board was not impressed because the registrations were less than five years old and subject to challenge on descriptiveness grounds, and further because each trademark application must be assessed on its own record.



In re Sausser Summers, PC, 2021 USPQ2d 618, (TTAB 2021) [re-designated as precedential]. For some reason, the Board re-designated as precedential its February 2021 decision affirming a Section 2(e)(1) mere descriptiveness refusal of the proposed mark ONLINETRADEMARKATTORNEYS.COM for “legal services.” Applicant claimed acquired distinctiveness under Section 2(f) but its submissions were woefully inadequate to satisfy the heightened burden of proof for this highly descriptive mark. It relied on both its verified statement that the proposed mark has been in substantially exclusive and continuous use for at least five years, and on its evidence of acquired distinctiveness. As to the five-year claim, the Board ruled that the examining attorney “was well within her discretion to reject Applicant’s claim of five years of substantially continuous use as insufficient to prove acquired distinctiveness.” As to applicant’s evidence, it offered neither consumer survey results nor declarations from clients attesting to their association of the proposed mark with the applicant. It did not reveal the amount of revenue garnered from its legal services, nor did it state the number of clients served. Although applicant was listed for several years as one of the top-filing firms in the United States, that was under the firm name, not under the proposed mark.

In re GJ & AM, LLC, 2021 USPQ2d 617 (TTAB 2021) [precedential]. In July 2020, the CAFC remanded to the TTAB the Board’s decision that found the proposed mark COOKINPELLETS.COM to be generic for “Processed wood fuel in the nature of pellets for use in barbecue grills,” and alternatively merely descriptive of the goods. The TTAB reversed its original finding of genericness (discussed below) but affirmed the mere descriptiveness refusal. Applicant claimed acquired distinctiveness under Section 2(f) but failed to meet the elevated burden of proof applicable when considering acquired distinctiveness for such a highly descriptive term. There was no survey evidence, no evidence of intentional copying, and minimal media coverage. Applicant’s sales figures were modest and were not placed in context (market

share), and its advertising figures lacked information as to the extent of exposure. Therefore, the Board was left to “analyze the evidence regarding consumer recognition, Applicant’s modest advertising expenditures, and modest sales in a vacuum.”

7. Genericness

In re The Consumer Protection Firm PLLC, 2021 USPQ2d 238 (TTAB 2021) [precedential]. The Supreme Court’s *booking.com* decision taught us that a proposed mark comprising a generic term and the gTLD “.com” is not automatically generic but may be registrable depending on consumer perception. This applicant sought to register, on the



Supplemental Register, the term THE CONSUMER PROTECTION FIRM in standard form (FIRM disclaimed) and THE CONSUMER PROTECTION FIRM.COM & Design (FIRM.COM disclaimed), both for legal services. The Board found both phrases to be generic for the services, but it deemed the word-plus-design mark to be registrable on the Supplemental Register with a disclaimer of THE CONSUMER PROTECTION FIRM.COM. The Examining Attorney submitted “a plethora of explanatory uses of ‘consumer protection,’ ‘consumer protection firm’ and ‘consumer protection law firm’ by Applicant and competitor law firms that practice “consumer protection law.” As to the applicant’s word-and-design mark, the evidence, including generic use of very similar terms as second level domain names by third-party competitors, supported a finding that “‘THE CONSUMER PROTECTION FIRM.COM’ is incapable of designating a single source of consumer protection legal services.” However, the Board was “constrained to find that the Examining Attorney failed to show that the mark as a whole [including the design element] is generic.”

In re GJ & AM, LLC, 2021 USPQ2d 617 (TTAB 2021) [precedential]. The CAFC remanded to the TTAB the Board’s decision that found the proposed mark COOKINPELLETS.COM to be generic for “processed wood fuel in the nature of pellets for use in barbecue grills.” The court required further consideration in light of the Supreme Court’s decision” in the *booking.com* case, in which the Court rejected a per se rule that a “generic.com” is always generic or always non-generic. The TTAB reversed its original finding of genericness. Although it found the term “Cooking Pellets” to be “indisputably generic” for the goods, the evidence showed that some third parties use or understand COOKINPELLETS (with or without a space) and COOKINPELLETS.COM as capable of serving as a source indicator. “Although this evidence of consumer perception is limited, . . . we find it is sufficient to create doubt about whether consumers would perceive COOKINPELLETS.COM as a whole as generic, or rather as capable of indicating source and thus eligible for registration on the Supplemental Register or on the Principal Register under Section 2(f) if Applicant can show it has acquired distinctiveness. We are constrained to resolve that doubt in favor of Applicant.”

8. Failure-to-Function

In re AC Webconnecting Holding B.V., 2020 USPQ2d 11048 (TTAB 2020)

[**precedential**]. The Board affirmed refusals to register the term “.CAM”, in standard character and stylized form, on the Supplemental Register for an extensive list of services in Classes 35, 38, 42, and 45, finding that “.CAM”, in either form, is incapable of functioning as a source indicator under Section 23 of the Trademark Act. In order to qualify for registration on the Supplemental Register, a service mark must be “capable of distinguishing” the applicant’s services, a determination that hinges on consumer perception. AC Webconnecting’s website consistently referred to “.CAM” as a gTLD and not as a mark. Moreover, excerpts from third-party websites demonstrated that “.CAM” is perceived only as a gTLD “intended to be used by multiple parties as part of their domain names to identify multiple websites offering a variety of goods and services.” The Board found that for at least one service in each class, the term “.CAM” is incapable of serving as a source indicator; therefore, the proposed marks are unregistrable as to all refused services recited in those classes. The proposed stylized mark “conveys the commercial impression of a gTLD” and “does not create a commercial impression separate from the unregistrable.”



In re Texas With Love, LLC, 2020 USPQ2d 11290 (TTAB 2020) [precedential]. The Board affirmed another failure-to-function refusal, finding that the term TEXAS LOVE for hats and shirts “only serves as an expression of a concept or sentiment, and is widely used by third parties, [and so] it would not be perceived as an indicator of source in the context of Applicant’s identified goods.” The Board found this case “closely analogous” to *D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d 1710 (TTAB 2016) in which the Board sustained an opposition to registration of the phrase I ♥ DC for t-shirts, hats and related products, There, the mark “conveys a message of love for Washington, D.C., just as Applicant’s proposed mark TEXAS LOVE conveys a message of love for or from Texas.” Applicant insisted that the refusal violates the Equal Protection Clause of the U.S. Constitution because the USPTO treats Texas citizens differently from those of Florida, California, Nevada, Maine and Hawaii. However, there was no evidence that the USPTO treats citizens of Texas differently than those of other states. Moreover, the CAFC has made clear that such an Equal Protection argument is untenable: “Even if his allegations were accurate, the most Applicant could establish is that the USPTO should have rejected the other marks.”

In re Vox Populi Registry Ltd., 020 USPQ2d 11289 (TTAB 2020) [precedential]. The Board upheld refusals to register the term .SUCKS in the stylized form shown here, as a service mark for “Domain registry operator services related to the gTLD in the mark, in International Class 42,” and the standard character mark .SUCKS for those same services and for “Domain name registration services featuring the gTLD in the mark; registration of domain names for identification of users on a global computer network featuring the gTLD in the mark, in International Class 45.” The Board observed that “consumers are ‘highly conditioned’ to view a gTLD as signifying its function as a portion of an Internet domain name.” Despite applicant’s attempts to use .SUCKS in the manner



of a source-identifier, “the evidence shows that consumers will view it as only a non-source identifying part of a domain name, rather than as a mark.” As to the stylized version, the Board found that “it does not create a sufficiently distinct commercial impression separate from the non-source-identifying element, .SUCKS. While the pixelated design may be antiquated since it was once ‘mandated by technological limitations,’ given the ubiquity of the design in the ‘early days’ of computing, consumers would view pixelated lettering as ordinary.”

In re Mayweather Promotions, LLC, 2020 USPQ2d 11298 (TTAB 2020)

[precedential]. Undeclared boxing champion Floyd Mayweather, Jr., suffered a TTAB t.k.o. (trademark knock-out) in his bout to register the phrase PAST PRESENT FUTURE for “T-shirts.” Applicant argued, *inter alia*, that “consumers recognize the PAST PRESENT FUTURE Mark as affiliated with Floyd Mayweather, and members of the purchasing public have come to recognize [it] as a trademark identifying Appellant and its services and goods.” The Board, however, found that the phrase “would be perceived by purchasers and prospective purchasers as a widely used commonplace expression of a familiar concept and not as a source indicator for t-shirts.” The Examining Attorney relied on third-party website evidence showing use of the phrase in connection with various products, including books, music albums, songs, and a number of t-shirts. The subject application was not limited as to classes of consumers, and even if it were limited to boxing fans, applicant failed “to grapple with the evidence of third-party use of the phrase on t-shirts that does not appear to be linked with Mr. Mayweather, which suggests that the broader class of t-shirt consumers would perceive only the common meaning of the phrase.”

In re Lee Greenwood, 2020 USPQ2d 11439 (TTAB 2020) [precedential]. Upholding a failure-to-function refusal of GOD BLESS THE USA for “accent pillows; decorative centerpieces of wood” and for “decorative wall hangings, not of textile,” the Board found the phrase to be a common expression of patriotism, affection for, or affiliation with the United States of America that will not be perceived as a source indicator. The Board also affirmed a refusal to enter applicant’s amendment of the mark to “THE LEE GREENWOOD COLLECTION GOD BLESS THE USA” because that amendment would constitute a material alteration of the proposed mark. Applicant Greenwood, a country music artist, insisted that “God Bless the USA” would be commonly recognized as his signature song, but the Board pointed out that there are no limitations to the channels of trade or classes of consumers for the goods in Greenwood’s application, and so the relevant consumers include members of the general public who may or may not be country music fans. As to mutilation, the Board observed that the crucial question is whether the old and new forms of the mark create “essentially the same commercial impression.” It agreed with the examining attorney that the addition of THE LEE GREENWOOD COLLECTION house mark would make a substantial difference in connotation and commercial impression.

In re Team Jesus LLC, 020 USPQ2d 11489 (TTAB 2020) [precedential]. In yet another failure-to-function ruling, the Board upheld a refusal to register TEAM JESUS for clothing items and educational and entertainment services promoting religion, under Sections 1, 2, 3, and 45 of the Trademark Act. The Board pointed out once again that “[m]atter that is widely used to convey ordinary or familiar concepts or sentiments, or social, political, religious, or similar informational messages that are in common use, would not be perceived as indicating source and is not registrable as a mark.” The examining attorney proffered numerous examples

evidencing general use, in a variety of contexts, of the phrase TEAM JESUS to convey a Christian affiliation: including at various religious websites, in media articles, on many t-shirts, and on bracelets, lanyards, and buttons. The Board found that, in light of the nature of use of the phrase TEAM JESUS, including on apparel from many sources, “it does not create the commercial impression of a source indicator, even when displayed on a hangtag or label.” *D.C. One Wholesaler, Inc.*, 120 USPQ2d at 1716.

9. Prosecution Issues

a. Indefiniteness of Identification of Goods

In re SICPA Holding SA, 2021 USPQ2d 613 (TTAB 2021) [precedential]. Applicant SICPA Holding SA ran into double trouble when it applied to register the mark SHIFTMAG for “security consulting in the nature of professional consulting on magnetic stripe color shifting smart designs based on liquid crystal technology for visual card authentication, embed protection and brand identity customization.” The Board agreed with the USPTO that SICPA’s recitation of services was fatally indefinite, and also upheld a second refusal based on SICPA’s failure to respond timely and adequately to a Rule 2.61(b) request for information. Observing that specificity is required “to provide public notice and to enable the USPTO to classify the goods and services properly,” the Board found the term “security” to be ambiguous: “it is unclear whether the term refers to data security, as suggested by the services relating to ‘card authentication and identification,’ or to physical security.” SICPA claimed that it “does not do data security,” but that did not make the identification less ambiguous. Moreover, it was not clear from SICPA’s examples of use whether it was offering a product or a product feature, rather than a service. As to the request for information under Rule 2.61(b), of the five requests made by the examining attorney, SICPA failed to respond to two of them until its final brief. “But that was too late.”

b. Acceptability of Specimens of Use

In re James S. Fallon, 2020 USPQ2d 11249 (TTAB 2020) [precedential]. The Board affirmed two of three refusals of the proposed mark THERMAL MATRIX for a “Heat responsive and malleable liner that is an integral component of an oral dental appliance used in the mouth and worn over the teeth of an individual while sleeping to reduce the effects of snoring and sleep apnea” [THERMAL disclaimed]. The Board found the mark to be merely descriptive of the goods, and further found that the specimen of use did not show the mark in use in connection with applicant’s liners. However, the Board overturned the third refusal, concluding that the mark as depicted in the application drawing (*i.e.*, THERMAL MATRIX) is a substantially exact representation of the mark as actually used. Applicant’s own promotional materials and third-party webpages made it clear that “a consumer would immediately understand the intended meaning of” the proposed THERMAL MATRIX mark as a descriptor of a key product feature. The specimen adequately displayed the proposed two-word mark (see image) but failed to “sufficiently identify any specific component, much less the component for which registration is



sought, visually or verbally, to create the required direct association between the proposed mark and that component.”

In re MN Apparel LLC, 2021 USPQ2d 535 (TTAB 2021) [precedential]. There’s nothing like a TTAB specimen-of-use case to cure your insomnia. Applicant MN Apparel applied to register the mark MOSTLY MN ONE WITH EVERYTHING for t-shirts, caps, and the like, but ran into two refusals aimed at its specimens of use: mutilation and failure to show use as a trademark. In a less than pellucid opinion, the Board rejected the first refusal but affirmed the second. As to the mutilation refusal, the Board found that, despite the variations in applicant’s mark, the specimens displayed “substantially exact representations” of the mark as shown on the application drawing. “A drawing displaying only a ‘minor alteration’ of the mark that ‘does not create a new and different mark creating a different commercial impression’ from the matter shown in the specimen is acceptable.” With respect to the failure-to-show-use refusal, the Board thumbed through the five pages of applicant’s specimens of use and found them wanting. Only one of the five displayed applicant’s goods, along with pricing and a “shop now” button, but no version of the proposed mark appeared on the page. The other four pages “fail to include sufficient information to function as point-of-sale displays associated with the identified goods.”

10. Procedural Issues

a. Res Judicata

In re SolarWindow Technologies, Inc., 2021 USPQ2d 257 (TTAB 2021) [precedential]. The TTAB sun again failed to shine on Applicant SolarWindow. The Board applied the doctrine of res judicata in affirming a Section 2(e)(1) mere descriptiveness refusal of POWERCOATINGS for coatings for solar cells. SolarWindow filed an application in 2014 for the same mark for the same goods; in 2016 the Board affirmed a mere descriptiveness refusal. SolarWindow filed again in 2018 and was rejected again on both Section 2(e)(1) and res judicata grounds. Here, the Board affirmed on the latter ground because SolarWindow failed to show any change of conditions or circumstances that would excuse the application of res judicata. SolarWindow argued that there are “additional facts” that preclude the application of that doctrine. The Board observed, however, that “pointing to additional facts or even making a more persuasive argument based on those facts does not avoid preclusion from an earlier decision.” The losing party must demonstrate “a material change in the relevant conditions or circumstances” and SolarWindow failed to do so. SolarWindow asserted that consumers may be confused as to whether the term POWERCOATINGS refers to a type of protective coating or finish applied to the product, or a method for applying the coating, or whether the term is a misspelling of the term “powder coating.” However, applicant failed to show that this argument was not available during prosecution of its first application.

b. Attempt to Amend Application During Appeal

In re Ox Paperboard, LLC, 2020 USPQ2d 10878 (TTAB 2020) [precedential]. The Board rejected this applicant’s attempt, in its appeal brief, to amend the identification of goods in its application without seeking leave or requesting remand. The Board explained the proper procedure and then affirmed the refusal to register the mark shown here, for various paper products, finding a likelihood of confusion with the registered mark OX BOX for “corrugated containers” [BOX disclaimed]. As a best practice, an applicant should seek an amendment as early as possible during prosecution. If not during prosecution, applicant should file a request for reconsideration after final refusal but before the deadline for appeal. The next preferred alternative is to file with the Board a separate request for remand and suspension of the appeal, ideally before the filing of an appeal brief. Embedded amendments in an appeal brief are not prohibited, but if the examining attorney objects the Board typically treats the attempted amendment as a request for remand for further examination and it considers whether good cause has been shown for the remand. Here, Applicant failed to demonstrate the required good cause as to why the application should be remanded. Moreover, even if accepted, the amendment would not overcome the Section 2(d) refusal because the amended goods and services would still be related to registrant’s goods.



c. Attempt to Withdraw Application After Failed Appeal

In re Information Builders Inc., 2021 USPQ2d 228 (TTAB 2021) [precedential]. In the shortest precedential decision in recent memory, the Board rejected this applicant’s attempt to expressly abandon its application “without prejudice” after the Board had issued a final decision affirming a refusal to register applicant’s mark. In a mere four pages, the Board pointed out that the purported abandonment was both untimely under Trademark Rule 2.68 and in contravention of Rule 2.142(g), which limits the Board’s power to re-open an appeal after a final decision. In April 2020, the Board affirmed a Section 2(d) refusal of the mark; the applicant appealed the decision to the CAFC, but then withdrew the appeal (stating that it no longer had a bona fide intention to use the mark). It then filed with the TTAB an express abandonment of its application, stating that the abandonment was “without prejudice.” The Board found that submission “improper and . . . of no effect.” Under Rule 2.68, an applicant may expressly abandon an application during prosecution or during an ex parte appeal to the Board. However, once the Board issues a final decision, “prosecution is over and a different rule - Rule 2.142(g) applies.” That rule allows re-opening of prosecution for entry of a disclaimer or upon order of the Director. Neither applied here.

PART II. INTER PARTES CASES

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

1. Section 2(d) Likelihood of Confusion

QuikTrip West, Inc. v. Weigel Stores, Inc., 2021 USPQ2d 35 (Fed. Cir. 2021) [precedential]. The CAFC affirmed the TTAB’s decision dismissing an opposition to



registration of the mark shown first, for “processed, ready to eat foods, namely, sandwiches, wrap sandwiches, pizza and pastries” and for “restaurant services.” The Board ruled that Opposer QuikTrip failed to prove a likelihood of confusion with its registered mark shown next, for “garden, vegetable, meat, cheese and fruit salads” and “processed, ready to eat foods, namely, sandwiches, wraps, pastries and pasta salads,” finding that Weigel’s mark “is so dissimilar to Opposer’s pleaded mark, and the common element between them is so weak that no likelihood of confusion exists.” The CAFC concluded that the Board had properly analyzed the marks – according less weight to the word “kitchen,” observing the differences in lettering and geometric shapes, and noting the inclusion of a tilted chef’s hat in QuikTrip’s mark – and it saw no error in the Board’s determination that the difference between the marks was dispositive.

2. Entitlement to a Statutory Cause of Action

Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC, 2020 USPQ2d 10837 (Fed. Cir. 2020) [precedential]. A divided CAFC panel reversed and remanded the TTAB’s decision dismissing a petition for cancellation of a registration for the mark NAKED for condoms. The Board ruled that Petitioner Australian lacked “standing” because it had agreed not to use or register the mark NAKED for condoms in the United States, and further had agreed that the respondent could use and register the mark. The Board concluded that Australian did not have a real interest in the proceeding or a reasonable basis for its belief of damage. The CAFC first pointed out that, as the Supreme Court clarified in *Lexmark*, the issues regarding “standing” are “more appropriately viewed as requirements for establishing a statutory cause of action.” It then ruled that, in order to establish entitlement to a cause of action under Section 1064 of the Trademark Act, a party must demonstrate a real interest in the proceeding and a reasonable belief of damage (the same test as that applied by the TTAB). However, the Board erred in requiring Australian to establish proprietary rights in its unregistered mark in order to state a cause of action under Section 1064. “[T]he absence of proprietary rights does not in itself negate an interest in the cancellation proceeding or a reasonable belief of damage.” In dissent, Judge Wallach opined that Australian did not have a legitimate commercial interest in the proceeding because it had contracted away any such interest.

Corcamore, LLC, v. SFM, LLC, 2020 USPQ2d 11277 (Fed. Cir. 2020) [precedential]. Following up on its *Australian Therapeutic* decision, the CAFC ruled that *Lexmark* provides the proper analytical framework for determining entitlement to a statutory cause of action under Sections 1063 and 1064 of the Trademark Act: “a party

must demonstrate (i) an interest falling within the zone of interests protected by the statute and (ii) proximate causation.” The Board had incorrectly ruled that *Lexmark* applied only in civil actions. The CAFC agreed with Corcamore that the *Lexmark* framework should apply but it found “no meaningful, substantive difference” between the *Lexmark* analysis and that of *Empresa Cubana* analysis, which required a real interest in the proceeding and a reasonable basis for belief of damage. The court concluded that the Board had reached the correct result: Corcamore’s allegations of likely confusion demonstrated both an interest falling within the zone of interests protected by Section 1064 and a reasonable belief of resulting damage. The CAFC then affirmed the Board’s entry of judgment against Corcamore as a sanction due to a litany of litigation misconduct.

B. Trademark Trial and Appeal Board

1. Section 2(a) Deceptiveness

The Scotch Whisky Association Ltd. v. ASW Distillery, LLC, (TTAB 2021) [precedential]. The Scotch Whisky Association opposed an application to register the mark BURNS NIGHT for “Malt whisky; Whiskey” on two grounds: geographically deceptive misdescriptiveness under Section 2(e)(3), and deceptiveness under Section 2(a). The Board ruled that the Association had failed to plead a claim under Section 2(e)(3) and under the “wines and spirits” provision of Section 2(a), but did sufficiently plead a claim under the general deceptiveness portion of the latter Section. The Board agreed with the applicant that the Association did not properly plead deceptiveness under the “wines and spirits” provision because it did not allege that the mark is a “geographical indication” that “identifies a place.” However, the Board concluded that the general provisions of deceptiveness provisions of Section 2(a) apply to applicant’s goods, not just the “wines and spirits” portion, and the Association’s notice of opposition properly pleaded that claim. As to Section 2(e)(3), the notice of opposition failed to include the necessary allegation that the primary significance of the proposed mark is a generally known geographic location. The Association was allowed twenty days to file an amended notice of opposition to cure the deficiencies, failing which the opposition would go forward under the general deceptiveness provision of Section 2(a) only.

2. Section 2(a) False Suggestion of a Connection

The United States Olympic Committee v. Tempting Brands Netherlands B.V., 2021 USPQ2d 164 (TTAB 2021) [precedential]. The TTAB dismissed the Olympic Committee’s opposition to registration of the mark PIERRE DE COUBERTIN for various goods in classes 3, 9, 14, 18, 25, and 28, including perfume, sunglasses, jewelry, luggage, clothing, and sporting goods. The Board found that the USOC had failed to prove its claim that the proposed mark falsely suggests a connection with the Olympic Movement in violation of Section 2(a) of the Lanham Act. Pierre de Coubertin is the name of a French baron who was instrumental in reviving the Olympic Games in the late nineteenth century by co-founding the International Olympic Committee and later becoming its president. The Board found that the Olympic Committee failed to satisfy either of the first two elements of the Section 2(a) test: (1) that the mark falsely suggests a connection with a person or institution, and (2) that the mark points uniquely and unmistakably to that person or institution. “While Pierre de Coubertin certainly was

associated with the Olympic Movement, this record does not demonstrate that the public would perceive Applicant's mark as a name or identity of the Olympic Movement or Opposer, or a close approximation thereof." Moreover, the name is associated with the person "rather than serving merely as a synonym of the Olympic institution," and thus does not point uniquely and unmistakably to opposer.

3. Section 2(e)(5) Functionality

McGowen Precision Barrels, LLC v. Proof Research, Inc., 2021 USPQ2d 559 (TTAB 2021) [precedential]. The Board granted a petition for cancellation of a registration for the trade dress of a gun barrel on the ground of *de jure* functionality under Section 2(e)(5). The registered mark consists of trade dress applied to gun barrels formed with a mottled pattern of



irregularly sized, rippled patches resembling a quilt. As often happens in Section 2(e)(5) determinations, respondent's own utility patent blew a hole in its case. There was no dispute

that carbon fiber composite barrels provide various functional benefits to rifles. "What the parties dispute is whether the particular appearance of Respondent's carbon fiber composite barrels is functional because it is a natural by-product of the manufacturing process that creates the barrels, as Petitioner claims, or whether it is simply the result of Respondent's cosmetic efforts to create a trade dress that consumers associate with Respondent." The Board looked to respondent's utility patent in concluding that the appearance of the gun barrel is dictated by its function. "Simply put, the patent evidence, combined with the evidence regarding Respondent's manufacturing process, is dispositive on the issue of functionality."

4. Section 2(f) Acquired Distinctiveness

City of London Distillery, Ltd. v. Hayman Group Limited, 2020 USPQ2d 11487 (TTAB 2020) [precedential]. This applicant squeaked by with a Supplemental Registration for CITY OF LONDON for gin [LONDON disclaimed], after surviving an opposition based on four grounds: Section 2(e)(1) mere descriptiveness, Section 2(e)(2) geographical descriptiveness, Section 2(e)(3) geographically deceptive misdescriptiveness, and failure-to-function as a trademark. The Board sustained the geographical descriptiveness claim, dismissed the other three, rejected applicant's claim of acquired distinctiveness, and then granted its motion to amend to seek registration on the Supplemental Register. The Board found that CITY OF LONDON is the name of a geographic place known generally to the American gin drinking and purchasing public, namely London, England. Although applicant's gin does not originate in the technical City of London (*i.e.*, within the boundaries of the financial district subdivision of London), it does originate in London. As to the other three claims, however, there was nothing misdescriptive or deceptive about the mark, nor was the mark so highly descriptive as to be incapable of functioning as a mark. The Board found applicant's meager proofs inadequate to satisfy Section 2(f), but it granted applicant's motion to amend to the Supplemental Register as timely, even though filed after discovery had closed.

5. Section 14(3) Misrepresentation of Source

***The Coca-Cola Company v. Meenaxi Enterprise, Inc.*, 2021 USPQ2d 709 (TTAB 2001) [precedential].** The Board ordered cancellation of registrations for the marks THUMS UP and LIMCA on the ground that Registrant Meenaxi used the marks to misrepresent the source of its soft drink products, in violation of Section 14(3). Petitioner Coca-Cola proved that it owns the two marks in India and has sold soft drinks in the United States under the marks, and it therefore was entitled to bring a statutory cause of action under Section 14(3). The Board found that Meenaxi deliberately caused consumers to believe that its products were licensed or produced by the same source as the products sold in India. Section 14(3) provides, in pertinent part, that a registration is subject to cancellation if “the registered mark is being used . . . to misrepresent the source of the goods or services” The misrepresentation “must involve a respondent deliberately passing off its goods as those of another.” The evidence showed that Coca-Cola’s THUMS UP and LIMCA brands are well known in India and their reputation extends to the Indian-American population in the United States. The Board concluded that Meenaxi, a purveyor of Indian food products distributed primarily to Indian grocers in this country, “intended to cause consumers exposed to Respondent’s use of the THUMS UP and LIMCA marks to draw the logical conclusion that Respondent’s products in the United States are licensed or produced by the source of the same types of cola and lemon-lime soda sold under these marks for decades in India.”



6. Nonuse

***NT-MDT LLC v. Irina Kozodaeva*, 2021 USPQ2d 433 (TTAB 2021) [precedential].** In a soporific, yet precedential decision, the Board granted a petition for cancellation of a registration for the mark NT-MDT and design for, *inter alia*, microscopes, sustaining petitioner’s claim that Respondent Kozodaeva did not use the registered mark prior to expiration of the time for filing a statement of use in her underlying Section 1(b) trademark application. Kozodaeva admitted that she had not used the mark, an admission that, the Board noted, “would appear to seal Petitioner’s victory on the nonuse claim.” However, Kozodaeva contended that she was entitled to rely on several trademark assignments that provided her with a 1999 first use date, and therefore that she could amend the dates in her registration to claim that early date and thereby overcome the nonuse problem. The Board noted that Section 7(c) requires a showing of “good cause” for an amendment to a registration. Moreover, “clear and convincing” evidence is required to justify an amendment claiming an earlier first use date than that set forth in the registration. Reviewing in detail the three agreements that Kozodaeva relied upon, the Board found that the documents did not establish that she had obtained rights in the subject mark.



7. Lack of Bona Fide Intent

Société des Produits Nestlé S.A. v. Cándido Viñuales Taboada, 2020 USPQ2d 10893 (TTAB 2020) [precedential]. The Board sustained this opposition to a Section 66(a) application for the mark NESPORT for a wide range of products, including pharmaceuticals, teeth filling and dental impression materials, and vermin control products, finding that Applicant Taboada lacked a bona fide intention to use the mark in commerce for the identified goods. Opposer Nestle mistakenly cited Section 1(b) as the statutory basis for its claim, rather than Section 66(a), but the Board found that this error was not fatal because the pleading had put Taboada on adequate notice. On the other hand, Taboada’s lack of documentation evidencing a bona fide intent as of his filing date did prove fatal to his application. Taboada confirmed in discovery responses in 2017 that the mark NESPORT had not been used in commerce, and that he had no advertising or promotional expenditures except for his website. He had no assignees or licensees, no agreements with potential manufacturers, no documents regarding attempted regulatory approval or attendance at trade shows, and no anticipated packaging or labels. In 2018, Taboada made some effort to commercialize the mark, but those efforts were not sufficiently contemporaneous with his 2016 filing date, nor sufficiently extensive or focused, to establish his bona fide intent at the time of filing.

8. Abandonment

Jill E. Peterson v. Awshucks SC, LLC, 2020 USPQ2d 11526 (TTAB 2020) [precedential]. Respondent fended off a petition for cancellation of its registration for the mark A.W. SHUCK’S (standard characters) for “restaurant and bar services” by proving that, during its period of nonuse of the mark (more than three years), it maintained an intent to resume use (*i.e.*, it did not intend not to resume use). Although the subsequent use of the mark was in the form AW SHUCK’S (without the periods), that was not a material alteration from its registered form and did not constitute abandonment of the original mark. During the period of nonuse, which began in January 2016, respondent looked for a new location for the restaurant, hired an architect, and worked on menu design, signage, decor, and equipment plans. In May 2019, respondent’s principal took over another restaurant under a different legal entity but using the name “AW Shuck’s Seafood Shack.” The Board found that respondent and the new entity were related companies and so respondent could rely on the new entity’s use. As to the modified mark, the Board concluded that the omission of the periods did not effect a material alteration to the mark “because ‘AW Shuck’s’ and ‘A.W. Shuck’s’ have the same continuing commercial impression.”

9. Genericness

International Dairy Foods Association v. Interprofession du Gruyère and Syndicat Interprofessionnel du Gruyère, 2020 USPQ2d 10892 (TTAB 2020) [precedential]. In this consolidated opposition to registration of GRUYERE as a certification mark for “cheese,” the Board found that “purchasers and consumers of cheese understand the term ‘gruyere’ as a designation that primarily refers to a category within the genus of cheese that can come from anywhere.” “Gruyere” cheese is sold by major retailers either under their own brand names, or sometimes under a group brand name like Boar’s Head. There was no evidence that applicants’

recent policing and educational efforts changed consumer understanding of the term. Applicants pointed to the lack of survey evidence, but the Board pointed out that a survey is not required when a coined or arbitrary mark is not involved. Moreover, the evidence of record was sufficiently persuasive that a survey was unnecessary. Finally, applicants asserted that any doubt should be resolved in their favor, but the Board observed “there is no resolution of doubt in an applicant’s favor in an opposition proceeding.” In any case, the Board had no doubt on the question of genericness.

10. Failure-to Function

University of Kentucky v. 40-0, LLC, 2021 USPQ2d 253 (TTAB 2021) [precedential]. In a case “markedly similar” to the #MAGICNUMBER108 case of two years ago [which Chicago Cub fans may remember], the Board sustained the University of Kentucky’s opposition to registration of the proposed mark “40-0” for t-shirts, finding it to be a widely used, common expression that fails to function as a trademark. The University did not go undefeated, however. The Board dismissed UK’s fraud claim and granted the applicant’s motion to amend its use-based application to delete certain goods for which the mark had not been used. The term “40-0” refers to a perfect winning record in NCAA Division I basketball. The Board first determined that UK was entitled to bring its case of action because it “has a present and prospective interest in using the term ‘40-0’ on T-shirts and other apparel to indicate its aspiration or achievement of an undefeated season, either in men’s or women’s basketball.” The Board then found that the proposed mark is merely informational in nature, expressing support, admiration or affiliation with college basketball teams that either have achieved perfect records in a single season or aspire to do so. “Consumers understand such a widely used, commonplace message as conveying the ordinary concept or sentiment normally associated with it, rather than serving any source-indicating function.”

11. Entitlement to a Statutory Cause of Action

Spanishtown Enterprises, Inc. v. Transcend Resources, Inc., 2020 USPQ2d 11388 (TTAB 2020) [precedential]. In this proceeding seeking cancellation of a registration for the mark PURISIMA & Design for wine, Respondent Transcend moved for summary judgment on two grounds: that Petitioner Spanishtown (1) was prohibited from seeking cancellation because it is suspended from doing business in its state of incorporation, and (2) it lacked “standing” to assert the alleged date of first use underlying its Section 2(d) claim because the mark was used by two individuals who were not parties to the proceeding. The Board denied the motion. It agreed with Petitioner Spanishtown that the first issue was one of capacity under FRCP 17(b) and is different from the question of entitlement to bring a statutory cause of action (formerly considered as “standing.”). As to the second issue, Transcend contended that Spanishtown was not entitled to bring a petition for cancellation based on priority and likelihood of confusion because it cannot rely on the dates of first use of the mark PURISSIMA for vodka by the corporation’s individual owners before the corporation was legally created. Wrong again, said the Board, observing that that a party may prove priority on the basis of prior use by a predecessor-in-interest, as alleged by Spanishtown.



PURISIMA

***Philanthropist.com, Inc. v. The General Conference Corporation of Seventh-day Adventists*, 2012 USPQ2d 643 (TTAB 2021) [precedential].** Finding that Petitioner failed to demonstrate its entitlement to maintain its genericness claim (f/k/a standing), the Board tossed out this petition for cancellation of two registrations for the mark ADVENTIST for religious publications, film production and distribution, educational services, and religious and missionary services. Petitioner owned the domain name <adventist.com> but “[a]ll Petitioner has ever done is to hold it for future sale at an inflated price (a practice known as ‘warehousing’), or to redirect Internet users to the TTABVue docket page for these proceedings.” The Board concluded that the petitioner did not satisfy either prong of the *Lexmark* test at the time of trial: its interests did not fall within the protectable zone of interests of Section 1064, and there was no reasonable basis in fact for a belief in damages proximately caused by the continued existence of the challenged registrations. “The purpose of the zone-of-interests test is to ‘foreclose[] suit ... when a plaintiff’s interests are so marginally related to or inconsistent with the purposes implicit in the statute that it cannot reasonably be assumed that Congress authorized that plaintiff to sue.’” Moreover, “[t]o the extent Petitioner’s belief in damage may have existed at the time Petitioner brought these proceedings in January 2017, clearly it has not been maintained.”

12. Laches/Acquiescence

***The Brooklyn Brewery Corporation v. Brooklyn Brew Shop, LLC*, 2020 USPQ2d 10914 [precedential].** The Board denied a petition for cancellation of a registration for the mark BROOKLYN BREW SHOP and dismissed an opposition to that mark in stylized form for a “beer making kit,” ruling that laches and acquiescence barred the plaintiff’s Section 2(d) claims. The Board found that confusion between defendant’s marks and plaintiff’s marks BROOKLYN and BROOKLYN BREWERY for beer was not inevitable. Plaintiff admitted that it was aware of defendant’s use of the word mark for more than four years before filing its petition for cancellation, and during that time the parties collaborated on a co-branded beer-making kit. The Board considered defendant’s word mark and stylized mark to be substantially the same, and so laches applied in the opposition proceeding as well. The Board found Plaintiff’s delay unreasonable, rejected defendant’s progressive encroachment argument, and concluded that defendant suffered material prejudice because of the delay. As to acquiescence, the Board found that, in view of the parties’ collaboration, plaintiff actively represented that it would not assert its rights against defendant.



13. Procedural Issues

a. Supplementation of Expert Report

***Empresa Cubana Del Tabaco d.b.a Cubatabaco v. General Cigar Co., Inc.*, 2020 USPQ2d 10988 (TTAB 2020) [precedential].** In this 23-year-old proceeding involving the mark COHIBA for cigars, the Board rejected a supplemental expert report submitted by Respondent General Cigar on the same day as its pretrial disclosures. FRCP 26(c) permits supplementation of an expert report “if the party learns that in some material respect the

disclosure ... is incomplete or incorrect.” The Board first found that the Supplemental Report did not make the original expert report complete or accurate, but instead was an improper attempt to bolster the expert’s original opinions with new examples and illustrations. General Cigar’s contention that the new information was necessary for the Board “to show that [his] expert opinion . . . remains valid in light of current facts” was not a basis for supplementation under the Rule. Applying the *Great Seats* factors, the Board found that the untimely disclosure of the Supplemental Report was not substantially justified or harmless. “Respondent should have inquired into the need to ‘supplement’ the Original Report earlier in this proceeding or informed Petitioner that Respondent was going to update the Original Report to reflect new information that arose after May 2017.”

b. Submission of Internet Evidence

STX Financing, LLC v. Stacey Michelle Terrazas, 020 USPQ2d 10989 (TTAB 2020) [precedential]. In this Section 2(d)/dilution opposition to registration of the marks BAD MOMS UNLIMITED and BAD MOMS BIBLE for audio books, printed matter, clothing, and charitable foundation services, Opposer STX Financing (producer of the film “BAD MOMS”) filed a motion to strike the exhibits listed in Applicant Terrazas’s notice of reliance. The exhibits comprised: (1) copies of third-party registrations and applications obtained from the TESS database; (2) selected pages from the file history of opposer STX’s pleaded pending applications obtained from the TSDR database; (3) screenshots of various websites; and (4) STX’s responses to Terrazas’s interrogatories. The Board granted STX’s motion only to the extent of requiring Terrazas to indicate the relevance of items 1 and 4, under Trademark Rule 2.122(g). Otherwise, it ruled that copies of third-party registrations are admissible as official records, even though they did not include the source and the date the material was accessed and printed. Likewise, the file history document was admissible as an official record, even though it did not include the entire file history. As to the website excerpts, it was sufficient that Terrazas, in the notice of reliance, supplied the date of access and identified the source.

14. Discovery and Motion Practice

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

Major League Soccer, L.L.C. v. F.C. Internazionale Milano S.p.A., 2020 USPQ2d 11488 (TTAB 2020) [precedential]. Major League Soccer (“MLS”) opposed the application of F.C. Internazionale Milano S.p.A. (a famous Italian soccer club) to register the mark INTER for goods and services in seven International Classes, including “entertainment services, namely, organizing, conducting, and staging professional soccer games and exhibitions and production of radio and television programs in the nature of professional soccer games and exhibitions.” MLS alleged two grounds: Section 2(d) likelihood of confusion and Section 2(e)(1) mere descriptiveness. For the Section 2(d) claim, MLS relied on use of the mark INTER by third parties prior to applicant’s filing date. Applicant moved to dismiss under FRCP 12(b)(6) for failure to state a claim upon which relief can be granted. The Board granted the motion. Although a plaintiff need not have a “proprietary interest” in its pleaded mark, it must allege some other “legitimate interest” in preventing a likelihood of confusion. Here, Opposer MLS’s reliance on prior use of INTER by five youth soccer entities having no connection with MLS did

not constitute a “legitimate interest” as contemplated by the CAFC’s *Jewelers Vigilance* decisions. “In sum, Opposer’s likelihood of confusion claim is legally insufficient because it has not sufficiently alleged priority.”

DrDisabilityQuotes.com, LLC v. Charles Krugh, 2021 USPQ2d 262 (TTAB 2021) [precedential]. Petitioner sought cancellation of a registration for the mark DOCTOR DISABILITY (in standard form) for insurance brokerage services, on the grounds of fraud and likelihood of confusion. Respondent Krugh moved under FRCP12(b)(6) to dismiss the two counts, asserting that petitioner had failed to state claims on which relief can be granted. The Board denied the motion. Petitioner alleged that Krugh’s Section 2(f) claim was false and misleading, that the false statements were material to his application, were made with the intent to deceive the USPTO, and were relied upon by the USPTO in issuing the registration. The Board found that petitioner’s allegations satisfied the pleading requirements of FRCP 9(b), and it concluded that petitioner had stated a proper claim for fraud on the USPTO. As to likelihood of



confusion, Krugh contended that the claim should be dismissed because Petitioner could not establish priority. Krugh alleged that he enjoys “constructive priority under 15 U.S.C. Section 1057(c) because of the registration of the Stethoscope Mark [shown here]

in 2006,” the priority of which may be tacked onto the standard character mark. The Board, however, found Krugh’s tacking argument to be premature. A motion to dismiss under FRCP 12(b)(6) tests only the sufficiency of the pleaded allegations, not the merits of the claim. Once Krugh files his answer, he may plead tacking and then he may try to establish “the stringent elements of tacking.”

b. Motion for Discovery Under FRCP 56(d)

Chavakula v. Praise Broadcasting AKA Praise FM, 2020 USPQ2d 10855 (TTAB 2020) [precedential]. Petitioner Chavakula, rather than respond to Praise Broadcasting’s discovery requests, filed a motion for summary judgment in this proceeding for cancellation of a registration for the mark PRAISELIVE & Design for broadcasting services. Praise moved under FRCP 56(d) for discovery regarding the relevant Section 2(d) issues. The Board granted the Rule 56(d) motion for discovery, set a date for Chavakula to respond to the motion, and further set a



date for Praise to file a response to the summary judgment motion, noting that one purpose of Rule 56(d) is to protect a party from being ambushed by a summary judgment motion before that party has had an opportunity to obtain relevant discovery. Under FRCP 56(d) a party may be allowed to take discovery provided that it states the specific reasons why it needs such discovery and sets forth the specific areas of discovery that it seeks. Praise maintained that it required discovery regarding priority and certain *du Pont* factors, pointing out which of its proposed interrogatories and document requests were on point. The Board found that Praise had adequately explained “why it is unable to prepare a response to without discovery and confirms that what it needs is largely within Petitioner’s possession, custody or control.” Although Praise’s Rule 56(d) motion was not “ideally supported,” the Board pointed out that it will not penalize a party “when the

motion arises from the actions of an uncooperative or recalcitrant adversary who gridlocks discovery.”

c. Motion to Amend Application Under Rule 2.133

Royal Crown Company, Inc. and Dr Pepper/Seven Up, Inc. v. The Coca-Cola Company, 2021 USPQ2d 387 (TTAB 2021) [precedential]. The Board reached back and deemed precedential its May 3, 2019 decision granting Coca-Cola’s Rule 2.133 motion to amend sixteen opposed applications for ZERO-formative marks (e.g., COKE ZERO, SPRITE ZERO, and PIBB ZERO) by entering a disclaimer of the word ZERO. RC Cola and Dr. Pepper squawked because they had wanted a determination as to whether the word “zero” is generic or merely descriptive of soft drinks. The Board, however, agreed with Coca-Cola that the disclaimer of ZERO rendered the issue moot and so it dismissed the oppositions. In 2020, the CAFC dismissed the appeal from the 2019 Board decision, ruling that there was no case or controversy to decide. The court observed that “litigation is conducted for the purpose of obtaining relief, not an advisory opinion.” Although such an advisory opinion might be useful to Royal Crown, that interest was “too speculative to invoke the jurisdiction of this court.”