

## Keeping Tabs on the TTAB®

*Decisions of the Supreme Court, the Federal Circuit, and the Trademark Trial and Appeal Board on Registrability Issues:*  
July 2019 – September 2020

By John L. Welch

### PART I. EX PARTE CASES

#### A. United States Supreme Court

##### 1. Genericness

**USPTO v. Booking.com B.V., 591 U.S. \_\_\_, 140 S.Ct. 2298 (2020).** In a closely watched case – at least by trademark attorneys – the United States Supreme Court ruled that a proposed mark comprising a generic term coupled with “.com” is not automatically generic, but may be registrable provided that consumers perceive the mark as a source indicator. The Court affirmed the judgment of the U.S. Court of Appeals for the Fourth Circuit, which rejected the USPTO’s argument that the combination of “.com” with the generic term “booking” is generic for online hotel-reservation services. The Supreme Court concluded that “[i]n circumstances like those this case presents, a ‘generic.com’ term is not generic and can be eligible for federal trademark registration.” The parties agreed that “[e]ligibility for registration ... turns on the mark’s capacity to ‘distinguish[ing]’ goods ‘in commerce.’” The question of whether BOOKING.COM is generic “turns on whether the mark, taken as a whole, signifies to consumers the class of online hotel reservation services.” The Supreme Court pointed out that “the courts below” determined that consumers “do not in fact perceive the term ‘Booking.com’ that way.” “That should resolve this case. Because ‘Booking.com’ is not a generic name to consumers, it is not generic.”

#### B. 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



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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.”

### C. Trademark Trial and Appeal Board

#### 1. Section 2(a) False Connection

***In re ADCO Industries – Technologies, L.P.*, 2020 USPQ2d 53786 (TTAB 2020) [precedential].** The Board affirmed two refusals to register each of the word-plus-design marks shown here, for “utility knives,” finding that the marks falsely suggest a connection with President Trump under Section 2(a), and further finding that because President Trump did not consent to use of his name, the marks also violated Section 2(c) [discussed in Part I.C.3, below]. The fact that Donald Trump has never used the term “Trump-It” as his name or identity does not obviate the Section 2(a) refusal. A term may be considered the identity of a person even if the person has not used the term. All that is required is that the mark sought to be registered clearly identifies a person (in this case, Donald Trump). In light of the variety of goods that are sold under the Trump name, the Board concluded that “consumers encountering utility knives bearing Applicant’s mark will perceive Applicant’s utility knives to be just one more product for which Donald Trump has licensed the use of his name.” Perhaps more importantly, in response to applicant’s assertion that Sections 2(a) and 2(c) are unconstitutional, the Board pointed out that it has no authority to rule on the constitutionality of the *Trademark Act*, but it nonetheless considered and rejected applicant’s claim.



#### 2. Section 2(b) Simulation of United States Flag

***In re Alabama Tourism Department*, 2020 USPQ2d 10485 (TTAB 2020) [precedential].** Upholding a Section 2(b) refusal to register the mark shown here, for tourism promotional services, the Board concluded that the mark incorporates a simulation of the flag of the United States. Section 2(b) prohibits registration of a mark that “[c]onsists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.” The Board found that the U.S. flag and applicant’s flag design “are highly similar and that the average member of the public would perceive Applicant’s flag design to be a simulation of an actual U.S. flag.” Applicant pointed in vain to various flag-containing registered marks, but the Board found them distinguishable and, in any case, pointed out once again that each application to register must be considered on its own merits. Applicant’s arguments that a number of features of the flag are missing missed the mark. The fact that the flag is displayed in this manner is not uncommon, and “no reasonable observer of that flag would believe that features are missing or changed, or view it as something other than the U.S. flag.”



#### 3. Section 2(c) Consent of Living Individual

***In re ADCO Industries – Technologies, L.P.*, 2020 USPQ2d 53786 (TTAB 2020) [precedential].** As indicated in Section I.C.1 above, the Board affirmed a Section 2(c)

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refusal to register each of this applicant's word-plus-design marks, for "utility knives," finding that, because President Trump did not consent to use of his name, the marks violated Section 2(c). In pertinent part, Section 2(c) bars registration of a mark that "[c]onsists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent." "While with lesser-known figures there may have to be evidence showing that the consuming public connects them with the manufacturing or marketing of the goods at issue, well-known individuals such as celebrities and world-famous political figures are entitled to the protection of Section 2(c) without having to evidence a connection with the involved goods or services." Applicant admitted that Donald Trump is a well-known political figure and a celebrity, and therefore the Board found that because the subject marks include Donald Trump's name and likeness, his consent to register was required.

#### 4. Section 2(d) Likelihood of Confusion

##### a. Likelihood of Confusion Found

***In re Country Oven, Inc.*, 2019 USPQ2d 443903 (TTAB 2019) [precedential].** The Board clarified the "something more" requirement for showing relatedness of goods and services in affirming a Section 2(d) refusal of COUNTRY OVEN for bakery shops and bakery services, in view of the identical mark registered for "bread buns." Applicant maintained that "something more" than the fact that bakeries sell bakery products is required to prove the relatedness of the goods and services, but the Board ruled otherwise. The Board observed that it is "common knowledge that retail bakery shops sell bakery products." Moreover, the examining attorney submitted third-party use-based registrations covering both applicant's services and goods that encompass bakery products. Applicant argued that "bread buns" are a specific type of product like hamburger buns or hot dog buns, and thus are not covered by the third-party registrations for "bakery goods." The Board pointed out, however, that "a registration that describes goods broadly is presumed to encompass all goods or services of the type described," and it found that the terms "bakery goods," "bakery products," and "buns" in the third-party registrations encompass "bread buns." The "something more requirement" applies when "the relatedness of the goods and services is not evident, well-known or generally recognized," which was not the case here.

***In re Guild Mortgage Company*, 2020 USPQ2d 10279 (TTAB 2020) [precedential].** On remand from the CAFC, the Board again affirmed a Section 2(d) refusal to register the mark GUILD MORTGAGE COMPANY & design for "mortgage banking services, namely, origination, acquisition, servicing, securitization and brokerage of mortgage loans" [MORTGAGE COMPANY disclaimed] in view of the registered mark GUILD INVESTMENT MANAGEMENT for "Investment advisory services" [INVESTMENT MANAGEMENT disclaimed]. In January 2019, the CAFC vacated the Board's earlier decision because the Board had "failed to consider pertinent evidence and argument under *DuPont* factor 8," which requires consideration of "the length of time during and conditions under which there has been concurrent use without evidence of actual confusion." The Board looked to the actual marketplace conditions and found a lack of evidence that would allow it to make a finding under the eighth *du Pont* factor. It therefore deemed that factor to be neutral. Although consumer sophistication weighed slightly against a finding of likely confusion, the similarity of the marks, the relatedness of the services, and the overlap in channels of trade and classes of consumers, led the Board to uphold the refusal.



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***In re St. Julian Wine Company, Inc.*, 2020 USPQ2d 10595 (TTAB 2020) [precedential].** Venturing into the seldom-visited realm of geographic certification marks, the Board affirmed a Section 2(d) refusal of REAL MICHIGAN for hard cider [MICHIGAN disclaimed], finding it likely to cause confusion with the two registered geographic certification marks shown here, for apples. Although in a typical Section 2(d) analysis, a geographic term is usually accorded less weight, that is not appropriate when considering a geographic certification mark. Here, the certification statement in each of the cited registrations reads as follows: “[t]he Certification mark, used by persons authorized by certifier, certifies that the goods bearing the mark consist of apples grown in the State of Michigan.” The Board noted that apples are a necessary component of hard cider and hard cider could be made from apples certified with registrant’s mark. The Board therefore found a commercial relationship between hard cider and apples and concluded that the goods are related. As to the marks, the Board concluded that they convey a similar connotation and commercial impression: designating goods from the State of Michigan. The differences in sound and appearance were outweighed by those similarities.



***In re Information Builders Inc.*, 2020 USPQ2d 10444 (TTAB 2020) [precedential].** One stylized letter in the word INFORMATION led to the Board’s affirmance of a Section 2(d) refusal of the mark INFORMATION BUILDERS and design (below left) for database software and related design services, due to confusing similarity with the design mark shown below right, for overlapping software and services. The Board observed that greater weight is often given to the wording in a mark since that is what purchasers use in ordering or requesting the goods or services. However, in appropriate circumstances, the Board may give greater weight to the design element of a composite mark. The Board observed that even if INFORMATION BUILDERS constitutes the dominant portion of applicant’s mark, “the design functioning as the letter ‘O’ is nonetheless a salient, distinctive feature of Applicant’s mark which must be given due consideration. . . . It functions as the letter ‘O’ but in a way that would be viewed by consumers as a distinct design and not simply as a stylized letter ‘O’.” When comparing the design which functions as the letter ‘O’ in Applicant’s mark with the cited mark, we are of the opinion that the two designs have substantial visual similarities.” The Board then affirmed the requirement that applicant disclaim the wording INFORMATION BUILDERS on the ground that it is merely descriptive.



#### b. Likelihood of Confusion Not Found

***In re Medline Industries, Inc.*, 2020 USPQ2d 10237 (TTAB 2020) [precedential].** In a rare Section 2(d) refusal involving color marks, the Board reversed a refusal to register, on the Supplemental Register, the color green (left) as applied to “medical examination gloves” in view of the registered mark shown on the right (also on the Supplemental Register), for the color green as applied to the exterior of “gloves for medical use; protective gloves for medical use.” As to the sixth *du Pont* factor, the strength of the cited mark, the Board’s decision in *Cook Medical* teaches that what is relevant is “the existence of third-party marks, not simply the presence in the marketplace of third-party goods bearing some shade of the color at issue.” (emphasis supplied). The Board observed that none of the third-party green medical gloves proffered by



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Medline were displayed in a way that identifies or refers to green or a particular shade of green as a trademark, and so “it is thus very unlikely that the colors or shades of green used by third parties on medical gloves would be perceived as marks.” Nonetheless, under the thirteenth *du Pont* factor, this evidence of third-party use of the color green “corroborates the weakness of the cited mark and its limited potential scope of protection” and “weighs against a likelihood of confusion.” The Board found that the two shades of green “would be viewed and remembered, at most, as distant relatives in the green family,” and it concluded that confusion as to source is unlikely.

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

***In re Yarnell Ice Cream, LLC*, 2019 USPQ2d 265039 (TTAB 2019) [precedential].**

The Board affirmed three refusals to register the proposed mark SCOOP for “frozen confections and ice cream promoted and distributed by a mascot named SCOOP at product promotions and distributions of the frozen confections and ice cream,” finding that the term is merely descriptive of ice cream and lacks acquired distinctiveness, that it fails to function as a source indicator, and that Applicant Yarnell’s specimens of use were unacceptable. In light of a dictionary definition of “scoop,” third-party usage, media references, and web pages discussing how to scoop ice cream, the Board concluded that the word “scoop” is merely descriptive because it means “a serving portion of ice cream and frozen confections.” As to acquired distinctiveness, Yarnell relied mainly on its use of the mark for more than five years, but the Board concluded that, in view of the highly descriptive nature of the term “scoop,” Yarnell had failed to provide sufficient evidence to prove acquired distinctiveness. [The other refusals are discussed below in Part I.C.11, below].

***In re National Association of Veterinary Technicians in America, Inc.*, 2019 USPQ2d 269108 (TTAB 2019) [precedential].**

In a real snoozer, the Board affirmed a refusal to register the proposed certification mark VETERINARY TECHNICIAN SPECIALIST for “veterinary medicine services,” finding the term merely descriptive of the services and lacking acquired distinctiveness. The evidence established that VETERINARY TECHNICIAN is the recognized name for an individual who provides veterinary medicine services. Applicant and third parties refer to “veterinary technicians” in a descriptive or generic manner. The term “specialist” is defined as “one who specializes in a particular occupation, practice, or branch of learning.” Applicant’s own certification statement and its promotional materials used the terms “specialty” and “specialization” in a descriptive or generic manner in connection with its services. “Thus, the record shows that in this context, the term SPECIALIST describes or refers to a person who specializes in a particular type of veterinary medicine.” The evidence further established that the combination of terms produces no new meaning. Because the proposed mark is highly descriptive, applicant bore an enhanced evidentiary burden to establish acquired distinctiveness, and it failed to carry that burden.

***In re Omniome, Inc.*, 2020 USPQ2d 3222 (TTAB 2019) [precedential].** Ruling that statements made in patent filings by a trademark applicant and by third parties are probative evidence as to the descriptiveness of a term, the Board affirmed a Section 2(e)(1) mere descriptiveness refusal of SEQUENCING BY BINDING for biological reagents, research laboratory analyzers, and related services. Dictionary definitions, industry articles, applicant’s patents and patent applications, and statements in its appeal briefs left the Board with no doubt that the proposed mark “immediately conveys information to the relevant target audience, microbiologists, concerning features and characteristics of Applicant’s reagents, analyzers, biological analysis devices and biological analysis services, *i.e.*, a DNA sequencing process that relies on identifying binding sites to determine the sequence of DNA molecular structure.” The Board

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emphasized that the patent filings of applicant and third parties are included in the list of evidence that may support a mere descriptiveness finding (namely, dictionaries, newspapers, surveys, websites, publications, advertising material directed to the goods or services, and the textual matter contained in an applicant's own specimen of use). In response to applicant's argument that its mark is a coined term, the Board observed that even if an applicant is the first user of a term, that does not *ipso facto* make that term distinctive.

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

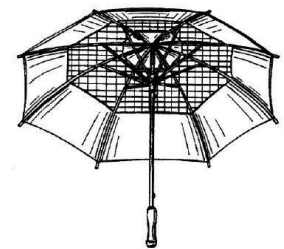
##### ***In re Colors in Optics, Ltd.*, 2020 USPQ2d 48321 (TTAB 2020) [precedential].**

Adding an initial or two to a surname may or may not avoid a Section 2(e)(4) surname refusal. It depends on how the relevant consumers perceive the proposed mark. Here, the Board upheld a refusal to register J HUTTON for "Eyewear, eyewear frames and sunglasses," finding the mark to be primarily merely a surname. Applicant did not dispute that the word HUTTON is primarily merely a surname, but it argued that J HUTTON is not a surname but rather a reference to a specific individual due to the inclusion of the initial "J" in the mark. The Board, however, observed that "[p]erhaps that was Applicant's intention, but the question is not what J HUTTON means to Applicant. The question is what it means to relevant consumers." The evidence showed that Jade Hutton is the name of a person associated with Colors in Optics, but there was no evidence that consumers identify Ms. Hutton as "J Hutton." The Board noted that, in some cases, adding one initial to a surname may lead consumers to perceive the mark as a personal name, while in others even adding two initials may not create such an impression. "In all cases involving a surname preceded by one or more initials, it is the factual record that matters most, because only from such a record can we make reliable findings about consumer perception."

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

##### ***In re OEP Enterprises, Inc.*, 2019 USPQ2d 309323 (TTAB 2019) [precedential].**

In view of Applicant OEP's own utility patent, the Board had no doubt in affirming a Section 2(e)(5) functionality refusal of the product configuration shown here, for umbrellas. Although Section 2(e)(5) is an absolute bar to registration, the Board also considered but rejected OEP's claim of acquired distinctiveness under Section 2(f). OEP owned a design patent on the umbrella design; the Board agreed that this is evidence of non-functionality, but not dispositive. OEP's expired utility patent stated that, unlike some prior designs, its mesh material "provides strength to the entire first canopy portion ... helping to keep the first canopy portion taut." Moreover, the mesh portions are "easier to sew along the panel seams," and there is less waste of material as compared to die cut vent holes. And, according to the patent, "the present invention has significantly greater airflow than prior art designs."



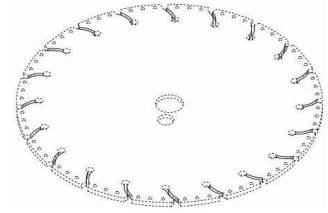
Several dependent claims of the patent "teach all elements of the applied-for mark, including the lower mesh canopy on which Applicant focuses on appeal." Both the claims and the specification of the patent supported a finding of functionality. As to acquired distinctiveness, OEP failed to satisfy the higher burden of proof that applies to product designs.

##### ***In re MK Diamond Products, Inc.*, 2020 USPQ2d 10882 (TTAB 2020) [precedential].**

Affirming another Section 2(e)(5) refusal to register, the Board found the product configuration mark shown here, for "circular saw blades for power operated saws," to

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be *de jure* functional. 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 Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001). 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. The Board concluded that MK did not meet the higher burden of proof applicable to product configurations.



## 8. 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 thus subject to challenge on descriptiveness grounds, and further because each trademark application must be assessed on its own record.



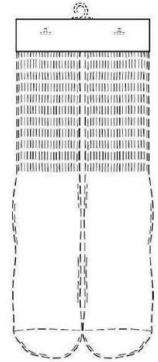
## 9. Genericness

***In re Twenty-Two Desserts, LLC*, 2019 USPQ2d 292782 (TTAB 2019) [precedential].** Finding that relevant consumers would understand the term MALAI to refer to a key aspect of ice cream and frozen desserts, the Board affirmed a refusal to register on the ground of genericness. There was no dispute that applicant's identification of goods adequately defined the genus at issue. The relevant consuming public comprised ordinary consumers who purchase and eat ice cream products. The question, then, was how does the relevant public perceive the term MALAI in the context of applicant's goods? The Board agreed with the examining attorney that “‘malai’ has an independent meaning in English for a specific cooking ingredient, cream.” Moreover, “malai” has been used to identify a creamy food principally made from malai, including items that fall within – *i.e.*, are a sub-group or type of – the goods broadly identified in the subject application: for example, “malai kulfi,” a type of Indian ice cream. The

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Board found clear evidence that consumers would understand MALAI to refer to a type of ice cream made principally with malai. It agreed with applicant that there is no *per se* rule that the name of any ingredient in a product will necessarily be generic; but where, as here, the public understands the ingredient name “to refer to a key aspect or subcategory of the genus of the goods, it is generic for those goods.”

***In re Odd Sox LLC, 2019 USPQ2d 370879 (TTAB 2019) [precedential].*** The Board upheld a refusal to register the packaging design shown here, for “socks,” finding the design to be generic for the goods. The Board also considered and upheld an alternative refusal that the proposed mark consists of a non-inherently distinctive packaging configuration. (Odd Sox did not contend that the design had acquired distinctiveness.) The subject application described the alleged mark as a “three-dimensional configuration of product packaging for displaying a single pair of socks hanging side by side.” The socks, two fasteners, and the hook are shown in dashed lines and are not part of the mark. The Board found it clear that “rectangular packaging enabling the hanging of a single pair of socks side-by-side is at most a minor variation of the common form of packaging.” The evidence further showed that the placement of socks side-by-side and front-to-back may be useful to sellers and appealing to consumers. For example, the socks may be placed together to form a single image. The Board therefore found that consumers of socks would primarily regard applicant’s design as a common type of packaging rather than as a source indicator, and so the design is generic. As to the issue of inherent distinctiveness, the Board reiterated that the configuration at issue is a common basic shape or design and is not unique or unusual in this field. Therefore, under *Seabrook*, it is not inherently distinctive.



***In re James Haden, M.D., P.A., 2019 USPQ2d 467424 (TTAB 2019) [precedential].*** In an enervating yet precedential ruling, the Board deemed the term ALLERGY CARE to be generic for “Medical and health care services, namely, medical treatment of allergies, asthma, immune disorders, and shortness of breath,” but concluded that the word-plus-design mark shown here is registrable on the Supplemental Register with a disclaimer of ALLERGY CARE. Dictionary definitions and Internet web pages convinced the Board that “ALLERGY CARE is a phrase commonly used by medical professionals in their advertising to refer to their practices that care for patients with allergies.” The Board had no doubt that consumers “would readily understand the term ALLERGY CARE to refer to the genus of services defined by Applicant’s recitation of services.”



The next question for the Board was whether applicant’s mark, as a whole, is registrable on the Supplemental Register: *i.e.*, “whether, given the background design, color, and stylization, the entire mark is capable of distinguishing Applicant’s services . . . .” Concluding that the proposed mark is “more than an ordinary geometric shape,” the Board ruled that applicant’s combination of colors, borders, and stylization are capable of distinguishing the source of applicant’s services.

## 10. Disclaimer Practice

***In re UST Global (Singapore) Pte. Ltd., 2020 USPQ2d 10435 (TTAB 2020) [precedential].*** Section 1213 of the TRADEMARK MANUAL OF EXAMINING PROCEDURE states (without cited authority) that “A disclaimer may be limited to pertain *to only certain classes, or to only certain goods or services.*” (emphasis added). Not so, according to the Board. Applicant UST Global applied to register the mark INFINITY LABS for various services in five Classes, but the examining attorney required

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disclaimer of the word LABS as to all. UST Global agreed to the disclaimer as to the services in Class 35 and some of the Class 42 services, but declined to do so as to the remaining services in Class 42 and all the services in Classes 36, 40, and 41. The Board, however, found that consumers “would immediately understand ‘LABS’ to convey information” about applicant’s think tank services, “namely that they are provided within a place, situation, or set of conditions conducive to experimentation, investigation, and/or observation.” The Board therefore affirmed the refusal in its entirety, extending to disclaimers “the well-settled principle that a ‘[i]f a mark is descriptive of any of the services in a class for which registration is sought, it is proper to refuse registration as to the entire class.’”

## 11. Failure-to-Function/Insufficient Specimens

### ***In re Yarnell Ice Cream, LLC, 2019 USPQ2d 265039 (TTAB 2019) [precedential].***

As discussed above in Part I.C.5, the Board affirmed a Section 2(e)(1) mere descriptiveness refusal of the proposed mark SCOOP for “frozen confections and ice cream promoted and distributed by a mascot named SCOOP at product promotions and distributions of the frozen confections and ice cream.” The Board also found that SCOOP fails to function as a source indicator, and that Applicant Yarnell’s specimens of use were unacceptable. In the specimens, the proposed mark appeared only on the shirt worn by Yarnell’s human or cartoon mascot. Yarnell argued that this usage constituted a display associated with the goods, but the Board disagreed, observing that SCOOP is likely to be perceived as the name of the mascot rather than as a source-identifier for the goods. As to failure-to-function, the Board relied on its findings regarding the highly descriptive nature of SCOOPS and the nature of Yarnell’s specimens of use, finding that “SCOOP also fails to function as a mark for the identified goods because, at most, it merely informs purchasers of the serving size of the goods.”

### ***In re Ocean Technology, Inc., 2019 USPQ2d 450686 (TTAB 2019) [precedential].***

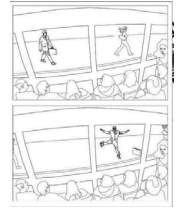
Adding to the recent stream of failure-to-function decisions, the Board upheld refusals to register the word-plus-design marks shown here, for “crabmeat,” finding that they fail to function as trademarks under Sections 1, 2, and 45 of the *Trademark Act*. The Board concluded that the proposed marks, as displayed on the specimens of use, “just convey[] the contents of the package to consumers, and do[] not show any indication of source that may be perceived by the general public.” The minimal stylization of the wording does not create a commercial impression separate from the words themselves, and the photographic depiction of a crab merely reinforces the informational nature of the wording. Moreover, applicant’s specimen of use “displays the proposed marks on the side of the product container in a manner that simply informs purchasers that the package contains all-natural, gourmet, pasteurized, 100% pure *Callinectes* crabmeat.” This evidence of actual use supported the finding that the proposed marks, as a whole, fail to function as source indicators. The Board then rejected applicant’s proposed amendments to the Supplemental Register: matter that does not indicate source cannot be registered because it does not meet the statutory definition of a mark and is incapable of acquiring distinctiveness.



***In re The Ride, LLC, 2020 USPQ2d 39644 (TTAB 2020) [precedential].*** The Board affirmed three refusals to register a motion mark for “conducting sightseeing travel tours by bus,” finding that the proposed mark failed to function as a service mark, that applicant’s specimens of use did not display the mark in connection with the services, and that applicant’s description of the mark was incomplete.

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Applicant described its mark as “the live visual and motion elements of the trade dress of a guided bus tour in which as the bus approaches at least one predetermined location on the tour an entertainer who is dressed as a banker walks normally along the street and then performs a tap dance routine dancing act when the bus stops at the predetermined location as viewed from inside of the bus.” Applicant submitted the results of two surveys regarding consumer perception, but the Board found the survey methodology flawed and the conclusions unsupported. Applicant’s specimens did not display the mark as depicted in the drawing and therefore were insufficient. And applicant’s mark description did not clearly indicate what elements displayed in its drawing were claimed, or whether the claimed trade dress is a two-dimensional or three-dimensional mark.



***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.”



## 12. Unlawful Use

***In re Stanley Brothers Social Enterprises, LLC*, 2020 USPQ2d 10658 (TTAB 2020) [precedential].** Finding that use of the mark CW for “Hemp oil extracts sold as an integral component of dietary and nutritional supplements” constitutes a *per se* violation of the Food, Drug & Cosmetics Act (FDCA), the Board affirmed the USPTO’s refusal to register under Sections 1, 2, and 45 of the *Trademark Act*. The evidence showed that applicant’s goods contain cannabidiol (CBD), an extract of the cannabis plant that is regulated under the FDCA as a drug. The FDCA prohibits “[t]he introduction or delivery for introduction into interstate commerce of any food to which has been added ... a drug or biological product for which substantial clinical investigations have been instituted and for which the existence of such investigations has been made public ....” 21 U.S.C. § 331(ll). The examining attorney maintained that applicant’s “hemp oil extracts” are food to which CBD has been added, and that CBD was the subject of clinical investigations during prosecution of the involved application. The Board agreed, noting that under 21 U.S.C. § 321(ff) “a dietary supplement shall be deemed to be a food within the meaning of this chapter.” The exception in the 2014 Farm Bill that permitted the cultivation of “industrial hemp” under limited circumstances did not override the FDCA’s prohibition.

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### 13. Prosecution Issues

#### a. Failure to Pay Sufficient Fees

***In re Carlton Cellars, LLC*, 2020 USPQ2d 10150 (TTAB 2020) [precedential].** The TTAB affirmed two refusals to register the mark SEVEN DEVILS for wine, wine-related accessories, and clothing because Applicant Carlton Cellars failed to pay sufficient fees to cover the four classes of goods in the application, and also failed to provide an acceptable identification of goods. Here, the application proceeded in International Class 8, and applicant requested reversal of the examining attorney's Section 2(d) refusal and remand to the examining attorney with instructions to issue an Office Action for payment of the filing fees. The Board would have none of it: Applicant's proposed arrangement essentially denied the fee revenue the USPTO needs to carry out its operations. Accordingly, the Board affirmed the examining attorney's requirement to submit sufficient fees or restrict the identification of goods in the application to a single class. *See Trademark Rule 2.86(a)(2)*. The Board found the identification of goods to be indefinite for two reasons: (1) it refers to specific class numbers, *see*, TMEP § 1402.01 ("The identification itself must not include references to specific class numbers") and (2) applicant refused to either delete goods to limit the application to a single class or submit fees to allow for multiple classes.

#### b. Untimely Amendment to Application

***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. 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. Failure to Address a Ground for Refusal

***In re Rainier Enterprises, LLC*, 2019 USPQ2d 463361 (TTAB 2019) [precedential].** The Board dismissed this appeal from the USPTO's refusal to register the mark shown here, for "vodka," based on the applicant's failure to comply with a drawing requirement and its failure to amend the color claim in the application. In its appeal brief, applicant argued against a Section 2(d) refusal but did not address these two requirements. The Board observed that the failure to comply with a requirement established by the *Trademark Rules* is itself a proper ground for refusal of registration. It observed that, "[r]elying on the search of Office records, a



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third party may innocently begin using a mark that conflicts with the mark, but be unaware of the conflict because the drawing is obscure.” The examining attorney required applicant to provide a substitute drawing of the mark that clearly showed the claimed gold outline around the wording described in the mark description, and to amend the color claim in the application to clarify whether the color white was being claimed as a feature of the mark. The Board observed that when an applicant fails to address a refusal or a requirement in its appeal brief, the Board may either affirm the refusal or it may treat the case as if no brief had been filed and therefore dismiss the appeal. “Either way, the application would stand abandoned.”

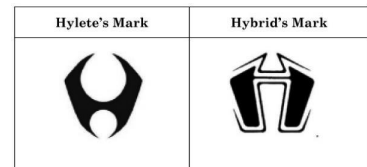
## PART II. INTER PARTES CASES

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

#### 1. Likelihood of Confusion

##### a. Likelihood of Confusion Found

***Hylete LLC v. Hybrid Athletics, LLC*, 2019 USPQ2d 285253 (Fed. Cir. 2019) [precedential].** The CAFC wasted little time in affirming the TTAB’s decision finding a likelihood of confusion between the two marks shown immediately below for athletic clothing. On appeal, Applicant Hylete argued that the Board erred by considering only Opposer Hybrid’s common law design mark and not its “composite common law mark” comprising the stylized H design above the phrase Hybrid Athletics and several dots (shown further below). The court, however, found that Hylete had waived this argument because it was not raised prior to the appeal. Absent exceptional circumstances, federal appellate courts do not consider issues “not passed upon below” or entertain arguments not made before the lower tribunal. Hylete was on notice of Hybrid’s common law rights from the time when the notice of opposition was filed, and Hybrid subsequently submitted evidence of use of its mark, and so Hylete could have raised the “composite common law mark” in the opposition proceeding. “Thus, none of the exceptional circumstances in which it is appropriate to consider arguments for the first time on appeal are present here, and declining to consider Hylete’s new arguments does not result in injustice.”



***Stratus Networks, Inc. v. UBTA-UBET Communications, Inc.*, 2020 USPQ2d 10341 (Fed. Cir. 2020) [precedential].** In a soporific, yet precedential ruling, the CAFC affirmed the TTAB’s decision sustaining an opposition to the mark STRATUS NETWORKS & design for various telecommunications services, in view of the registered mark STRATA NETWORKS & design for overlapping services. The appellate court concluded that substantial evidence supported the Board’s factual findings under *du Pont*, and further that the Board did not err in its legal analysis. The Board acknowledged the slight difference in meaning between STRATUS and STRATA, but there was little evidence that consumers would “significantly recognize” that difference. It concluded that the “marks convey over-all commercial impressions that are more similar than dissimilar.” The



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legal equivalence of the involved services “weighed heavily” in opposer’s favor, while the sophistication of consumers was a neutral factor or weighed “slightly” in applicant’s favor, given the high cost of its services. Appellant Stratus challenged the Board’s factual findings on some of the *du Pont* factors, but the court observed that Stratus was “effectively ask[ing] us to reweigh the evidence considered by the Board. That is not the role of this court. Instead, we evaluate whether the Board’s factual findings for each considered *du Pont* factor are supported by substantial evidence.” The court concluded that substantial evidence supported the Board’s findings, and the Board did not commit legal error in its consideration of the actual confusion and sophistication factors.

## 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 Therapeutic 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 respondent could use and register the mark. The Board therefore concluded that Australian did not have a real interest in this proceeding or a reasonable basis for its belief of damage. The CAFC, however, ruled that “the absence of proprietary rights does not in itself negate an interest in the cancellation proceeding or a reasonable belief of damage.” The court pointed out that, under *Lexmark*, the proper question is not “standing,” but whether Australian “has established entitlement to a statutory cause of action under Section 1064,” which provides that a petitioner may seek cancellation if he “believes that he is or will be damaged” by the registered mark. Although the agreement “could ultimately bar Australian from proving *actual* damage,” Section 1064 requires only a *belief* of damage.” The court concluded that Australian had a real interest and a reasonable belief of damage, since its applications to register were blocked by Naked’s mark. In dissent, Judge Wallach asserted that Australian did not have a legitimate commercial interest in the proceeding because it contracted away any such interest.

## B. Trademark Trial and Appeal Board

### 1. Section 2(a) False Connection

***The Pierce-Arrow Society v. Spintek Filtration, Inc.*, 2019 USPQ2d 471774 (TTAB 2019) [precedential].** The Board sustained this opposition to registration of the mark PIERCE-ARROW for automobiles, finding a likelihood of confusion with the registered collective membership mark PIERCE ARROW SOCIETY for “indicating membership in a national organization whose aim is to foster and preserve interest in Pierce Arrow motor cars.” [Discussed in Part II.B.2.a, below]. However, a false suggestion of a connection claim under Section 2(a) was denied. The Board found that PIERCE-ARROW is a close approximation of opposer’s name and that Applicant Spintek is not connected with the Society. However, opposer failed to meet the other two elements required to establish its false connection claim. It failed to show that the mark PIERCE-ARROW points uniquely and unmistakably to the Society, the Board noting that the Society did not prove that it may claim rights in the name or identity of the defunct company. And it failed to show that The Pierce Arrow Society is famous or has any reputation, the Board noting that the Society has only 1,000 members, and that its advertising is limited.

***Schiedmayer Celesta GmbH v. Piano Factory Group, Inc.*, 2019 USPQ2d 341894 (TTAB 2019) [precedential].** The Board granted a petition for cancellation of a registration for the mark SCHIEDMAYER for “pianos, namely, upright pianos, grand

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pianos, and digital pianos,” finding that the mark falsely suggests a connection with petitioner in violation of Section 2(a). To prove its claim, petitioner had to show that SCHIEDMAYER is “unmistakably associated with a particular personality or ‘persona.’” The record evidence, including encyclopedia entries, Internet search results, and media mentions, demonstrated that “Petitioner and its instruments are known to and by the public as ‘Schiedmayer.’” Indeed, SCHIEDMAYER is famous in the United States in connection with keyboard musical instruments. Thus, the mark SCHIEDMAYER points uniquely and unmistakably to petitioner. The Board found that, in fact, petitioner is the only entity that SCHIEDMAYER could possibly identify. [The Board’s rejection of respondents’ laches defense is discussed in Part II.B.9, below].

## 2. Section 2(d) Likelihood of Confusion

### a. Likelihood of Confusion Found

***The Pierce-Arrow Society v. Spintek Filtration, Inc.*, 2019 USPQ2d 471774 (TTAB 2019) [precedential].** Although the PIERCE-ARROW automobile was last produced in 1938, the Board sustained this opposition to registration of the mark PIERCE-ARROW for automobiles, finding a likelihood of confusion with the registered collective membership mark PIERCE ARROW SOCIETY for “indicating membership in a national organization whose aim is to foster and preserve interest in Pierce Arrow motor cars.” [The denial of opposer’s Section 2(a) false connection claim is discussed in Part II.B.1, above]. The likelihood of confusion analysis involving a collective membership mark and a trademark considers whether relevant consumers are likely to believe that the trademark owner’s goods “emanate from or are endorsed by or in some other way associated with the collective organization.” The Board agreed with Applicant Spintek that the trade channels differ, but found that the consumers of the Society’s services overlap with the (potential) purchasers of Spintek’s goods. The Board concluded that consumers are likely to assume a connection or affiliation with, or sponsorship by, the Society if Spintek’s mark is used for automobiles.

***DeVivo v. Ortiz*, 2020 USPQ2d 10153 (TTAB 2020) [precedential].** The Board sustained a Section 2(d) opposition to registration of the mark ENGIRLNEER for “Cups; coffee cups, tea cups and mugs; Lanyards for holding badges; Lanyards for holding keys; Hoodies; Shirts; Sweatshirts,” finding a likelihood of confusion with the identical, common law mark for books and for educational and informational services in the STEM fields. Evidence of third-party registrations for marks covering various combinations of the involved goods and services convinced the Board of their relatedness. Opposer DeVivo established priority based on her interactive website, its downloadable book, and its depiction of several cartoon character “engirlneers” that provide educational information in STEM fields. “[E]ven though ENGIRLNEERS appears in the title of the book and is the group name for the characters in the book, the positioning of the term distant from the title of the book, its inclusion within a design, its prominent size, its appearance on the second page in conjunction with an invitation to the reader to ‘learn how to become an engirlneer,’ and its appearance on the last page of the book, results in a separate and distinct commercial impression which performs the trademark function of identifying the source of Applicant’s book to consumers.”

***New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596 (TTAB 2020) [precedential].** Hip-hop collective Pro Era applied to register the mark PRO ERA for various clothing items, including hats and caps, but was foiled by Opposer New Era Cap, which for decades has extensively used, promoted, and protected its registered mark NEW ERA in connection with caps. The Board rejected New Era’s claim to ownership of a family of ERA-formative marks, but found the NEW ERA mark to be conceptually strong with a “relatively high degree of fame or commercial strength,” and similar overall

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to the PRO ERA mark in sound, appearance, connotation, and commercial impression. Given the strength of the NEW ERA mark, the Board concluded that consumers are likely to see the PRO ERA brand as an extension of the NEW ERA product line. As to the family of marks argument, the Board, with little discussion, found New Era's testimony on this issue to be vague and ambiguous and in-part relating to its use of various ERA-formative marks only after applicant Pro Era's constructive first use date.

#### b. Likelihood of Confusion Not Found

***Ricardo Media Inc. v. Inventive Software, LLC*, 2019 USPQ2d 311355 (TTAB 2019) [precedential].** Declining to apply the doctrine of foreign equivalents to a given name, the Board dismissed this opposition to registration of the mark RICHARD MAGAZINE for online services in the fields of fashion, beauty, and lifestyle, concluding that opposer had failed to prove a likelihood of confusion with its mark RICARDO for services in the culinary field. Although the involved services are related, the first *du Pont* factor, the dissimilarities between the marks, was dispositive. Considering the marks in their entirety, the Board found them more dissimilar than similar. The principal disagreement between the parties concerned whether the doctrine of foreign equivalents applied here. The Board observed that the doctrine “should generally not apply to first names such as RICHARD and RICARDO that are widely recognizable to American consumers, unless there is evidence that consumers would ‘translate’ the names.” The Board found no such evidence. “[G]enerally consumers would be unlikely to ‘stop and translate’ personal name marks, because doing so would point to not only a different person or people (whether real or fictional), but also to a different source, and to the mark losing any ‘instant recognizability.’”

***Lacteos de Honduras S.A. v. Industrias Sula, S. De R.L. de C.V.*, 2020 USPQ2d 10087 (TTAB 2020) [precedential].** In a rare Section 2(d) proceeding involving the Pan-American Convention, Lacteos de Honduras opposed registration of the mark RICA SULA for snack chips. Applicant Industrias Sula counterclaimed for cancellation of opposer's two pleaded registrations for the mark SULA in standard form and design form, for “spreads, namely, vegetable oil and dairy cream based blends,” under Article 8 of the Convention. Sula also asserted an affirmative defense of priority under Articles 7 and 8 of the Convention. The Board granted opposer's motion to dismiss the counterclaims and the affirmative defense. As to the counterclaim, the Board ruled that Sula failed to allege that it had trademark rights in a Convention country for goods that are “the same as” those of opposer, as required by Section 8 of the Convention, and therefore did not state a viable counterclaim under that Section. As to Sula's affirmative defense of priority, the Board pointed out that priority is not an issue when an opposer is relying on a registration, absent a proper counterclaim for cancellation, and applicant had none. And, in any case, Section 8 does not set forth an affirmative defense.



***Moke America LLC v. Moke USA, LLC*, 2020 USPQ2d 10400 (TTAB 2020) [precedential].** The Board dismissed the Section 2(d) claim in this opposition to registration of the mark MOKE & design for “motor vehicles, namely, four wheel low speed land vehicles and automobiles,” because Opposer Moke America LLC's testimony and evidence failed to establish prior rights in the mark MOKE. The Board also jettisoned opposer's claim that applicant was not the owner of the challenged mark, because opposer had not raised that claim in its pleading and the issue was not tried by implied consent. Although the Board accepted certain third-party sales documents



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of opposer's assignor under the business records exception to the hearsay rule, it rejected certain hearsay testimony regarding sales under the mark. Considering the entire record, the Board found that opposer's evidence fell short. The testimony of opposer's CEO was vague, inconsistent, and contradictory, and the sales records did not prove use of the mark on any goods sold in commerce. Moreover, the CEO lacked personal knowledge as to whether opposer's assignor ever labeled its products with the mark. As to the non-ownership claim, applicant had not been apprised of this new claim, and so the Board refused to amend the pleadings to include it.

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

***Spiritline Cruises LLC v. Tour Management Services, Inc.*, 2020 USPQ2d 48324 (TTAB 2020) [precedential]**. Applicant Tour Management's cruise to registration of the proposed mark CHARLESTON HARBOR TOURS travel tour services foundered on the shoals of Sections 2(e)(2) and 2(f) of the *Trademark Act*. Spiritline Cruises successfully opposed on the ground that the mark is primarily geographically descriptive and lacks acquired distinctiveness. Tour Management sought registration under Section 2(f), and therefore it was established that the proposed mark lacks inherent distinctiveness because it is primarily geographically descriptive. As to Tour Management's Section 2(f) claim, Wayback Machine evidence, authenticated by testimony from an official of the Internet Archive, was admitted under the business records exception, FED. R. EVID. 801(c) and 802, to prove the dates of publication of various website pages showing use of the phrase by third parties. The Board concluded that Charleston Harbor "is a widely recognized place associated with the particular services at issue, and ... numerous third parties in the tour and charter industry refer to Charleston Harbor." Because CHARLESTON HARBOR is highly geographically descriptive in this context, "the standard for establishing acquired distinctiveness becomes commensurately high." The Board found that "consumers do not recognize 'Charleston Harbor tours' as indicating a single source for the recited services."

### 4. Abandonment

***Double Coin Holdings Ltd. v. Tru Development*, 2019 USPQ2d 3373409 (TTAB 2019) [precedential]**. Denying Respondent Tru's abandonment counterclaim, the Board granted a petition for cancellation of a registration for the mark ROAD WARRIOR, finding a likelihood of confusion with the registered mark WARRIOR, in the stylized form shown here, both for tires. Tru was unable to prove nonuse of the WARRIOR mark for three consecutive years, which would have triggered the Section 45 presumption of abandonment, and it failed to carry its burden to establish that Double Coin intended not to resume use of the mark during the two-and-one-half year period of nonuse. The question for the Board was "whether Double Coin's decision to discontinue sales in the United States in response to the imposition of tariffs, in-and-of-itself, was 'excusable,' that is, a reasonable business judgment under the circumstances." The Board found Double Coin's efforts sufficient to show that its cessation of use of the WARRIOR mark was "unaccompanied by an intent not to resume use." Double Coin announced that it intended to find an alternative source of manufacture, including possibly in the United States, and it followed through by building a factory in Thailand. Its expert explained, "[t]hese are not the statements and acts of an entity that intended to leave the U.S. market permanently, never to return."



***Wirecard AG v. Striatum Ventures B.V.*, 2020 USPQ2d 10086 (TTAB 2020) [precedential]**. On October 20, 2015, Striatum Ventures B.V. (a Netherlands company) obtained a registration for the mark ZUPR in the word-plus-design form shown here,

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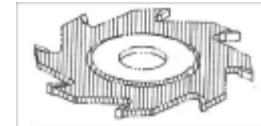


for software and various business services, via the Madrid Protocol (Section 66(a) of the *Trademark Act*). On October 22, 2018, Wirecard AG filed a petition for cancellation of that registration on the ground of abandonment. The parties, proceeding under the Board's Accelerated Case Resolution (ACR) procedure, stipulated that during the period from the issuance of the registration through the date of the stipulation (May 28, 2019), no goods or services had been sold in the United States under Striatum's mark. The Board found, however, that Striatum carried its burden of proving an intent to commence use of its mark in commerce during the three-year statutory period of nonuse and therefore had rebutted Wirecard's *prima facie* showing of abandonment. "Following registration in the U.S., Respondent entered into a contract for a U.S. marketing strategy, retooled its platform in response to that marketing strategy, demonstrated the retooled products to its public relations firm, and reached agreement at least orally with a retailer's representative to use the ZUPR goods and services in the U.S. following the product launch in 2019."



## 5. Genericness

***Milwaukee Electric Tool Corp. v. Freud America, Inc.*, 2019 USPQ2d 460354 (TTAB 2019) [precedential].** In what appears to be the first TTAB decision finding a color to be generic, the Board granted a petition for partial cancellation of a registration for the mark shown first below (lined for the color red) for, *inter alia*, saw blades, and it also granted a petition for cancellation of a registration for the mark shown second below ("the color red as applied to substantially the entire surface of the goods"), for "blades for reciprocating power saws." The question faced by the Board was "whether the color red is generic for the identified goods and thus unregistrable under Trademark Act Sections 1, 2 and 45 because it cannot function as a mark." The CAFC has held that the term "generic name" under Section 14 of the *Trademark Act* encompasses anything that "potentially can but fails to serve to indicate source, including trade dress." Since color is a form of trade dress, a single color applied to goods may be generic for those goods if it "fails to serve as an indicator of source." The Board found that the extensive evidence of use of the color red on saw blades by petitioner and by numerous others "is incompatible with a finding that the 'primary significance of the registered mark to the relevant public' of the color red is as a source-indicator pointing solely to Freud."



***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 necessary 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

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doubt in an applicant's favor in an opposition proceeding." In any case, the Board had no doubt on the question of genericness.

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

***Hole In 1 Drinks, Inc. v. Michael Lajtay*, 2020 USPQ2d 10020 (TTAB 2020) [precedential]**. Sidestepping the issue of ownership, the Board granted a petition for cancellation of Respondent Michael Lajtay's registration for the mark HOLE IN ONE for sports drinks, ruling that the registration was void *ab initio* because, at the time of filing the underlying application, Lajtay did not intend to use the mark by himself, but rather intended to use it jointly with Darryl Cazares to form a company and market beverages. Petitioner asserted that the subject registration was void because Respondent Lajtay did not "own" the mark at the time of filing. However, because the application was filed under Section 1(b), Lajtay did not have to be the "owner" of the mark sought to be registered. [See the *Norris v. PAVE* decision in Part II.B.7, below.] The Board observed, however, that "Petitioner could have asserted that Respondent did not have a right to file his intent-to-use application based on a lack of a *bona fide* intent to use the mark in commerce as of the filing date of the intent-to-use application." The Board then found that the issue of lack of *bona fide* intent had been tried by consent, since Lajtay "(1) raised no objection to the introduction of evidence on the issue, and (2) was fairly apprised that the evidence was being offered in support of the issue."

***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 Nestlé 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.

#### 7. Ownership

***Norris v. PAVE: Promoting Awareness, Victim Empowerment*, 2019 USPQ2d 370880 (TTAB 2019) [precedential]**. Shael Norris opposed an application, filed under Section 1(b), to register the mark SafeBAE for "Providing emotional counseling and emotional support services for victims of sexual violence." Norris claimed that she was the owner of the mark and therefore that the opposed application was void *ab initio*. The parties agreed that the sole issue before the Board was "which party owns the mark." The Board pointed out, however, that "a claim that an applicant is not the rightful 'owner' of the applied-for mark is not available when the application is not based on use of the mark in commerce." Under Section 1(b), an applicant "who has a *bona fide* intention, under circumstances showing the good faith of such person, to use a trademark in commerce may request registration of its trademark." There is no statutory requirement that the filer of an intent-to-use application be the owner of the mark at the time of filing. Therefore, the Board found no statutory basis for opposer's claim of non-

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ownership, and so it dismissed the opposition. [Compare this ruling with the *Hole in 1 Drinks* decision in Part II.B.6, above.]

***Sock It To Me, Inc. v. Fan*, 2020 USPQ2d 10611 (TTAB 2020) [precedential]**. The Board dismissed this opposition to registration of SOCK IT UP for “socks,” rejecting opposer’s claim of likelihood of confusion with the registered mark SOCK IT TO ME for “socks and stockings” [SOCK disclaimed] due to the dissimilarity in the marks. Perhaps more importantly, the Board first denied opposer’s claim that Applicant Aiping Fan was not the owner of the mark at the time of filing of the opposed application. The opposer contended that the mark SOCK IT UP was used in the United States not by Applicant Fan, but by JY Instyle, and therefore JY Instyle owned the mark, not Fan. The Board, however, deemed the informal arrangements between Fan and JY Instyle (a company run by Fan’s son and daughter-in-law) to be sufficient to qualify JY Instyle as a related company under Section 5 of the *Trademark Act*, and therefore its use of the mark inured to Fan’s benefit. “Sufficient control by a licensor may exist despite the absence of any formal arrangements for policing the quality of the goods sold or services rendered under the mark by its licensee(s).” “This holds true especially where the licensor and licensee have a close working relationship, such as a familial relationship.”

## 8. Standing

***AT&T Mobility LLC v. Mark Thomann and Dormitus Brands LLC*, 2020 USPQ2d 53785 (TTAB 2020) [precedential]**. In this long-running battle over the mark CINGULAR for cell phones and related products, the Board bifurcated the issues so that it could first rule on whether opposer had standing to bring its claims (including false suggestion of a connection under Section 2(a)). Applicants contended that the opposer had abandoned the mark CINGULAR when it changed its name from Cingular Wireless LLC to its current name of AT&T Mobility LLC, and therefore lacked standing. The Board, however, found that “[o]pposer is the owner of a majority share in a company named AT&T Mobility II LLC, which in turn holds a 100% interest in New Cingular, which uses the term CINGULAR in its trade name.” The Board saw no reason why a corporate plaintiff could not claim “a false suggestion of a connection with its trade name, where, as here, its allegations of standing are based on alleged injury from an unauthorized use of a mark that falsely suggests a connection with its persona.” As to standing, the Board observed that the parent corporation of a wholly-owned subsidiary “can reasonably believe that damage to the subsidiary will naturally lead to financial injury to itself.” Having proven its standing to pursue its false connection claim under Section 2(a), opposer was entitled to rely on any other available statutory grounds set forth in the *Trademark Act*. [See the CAFC’s recent decision in *Australian Therapeutics* – Part II.A.2, above – in which the court pointed out that, under the Supreme Court’s *Lexmark* decision, the proper question is not “standing,” but whether the claimant “has established entitlement to a statutory cause of action.”]

## 9. Laches/Acquiescence/Estoppel

***Schiedmayer Celesta GmbH v. Piano Factory Group, Inc. and Sweet 16 Musical Properties, Inc.*, 2019 USPQ2d 341894 (TTAB 2019) [precedential]**. The Board granted a petition for cancellation of a registration for the mark SCHIEDMAYER for “pianos, namely, upright pianos, grand pianos, and digital pianos,” finding that the mark falsely suggests a connection with petitioner in violation of Section 2(a). [Discussed in Part II.B.1, above.] The Board rejected respondents’ laches defense, finding that although Schiedmayer’s delay of nearly seven and one-half years before filing its petition for cancellation was unreasonable, respondents failed to prove “any meaningful economic or other damage” or any significant change of position resulting from petitioner’s delay. Their only evidence was a “general recollection” that they sold at most 17

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SCHIEDMAYER-labeled pianos between issuance of the registration and the filing of the cancellation petition. “Respondents’ claim of prejudice rings hollow where the only direct, marginal expense incurred in selling SCHIEDMAYER-labeled pianos is buying the SCHIEDMAYER labels from trophy or decal makers.” Consequently, they failed to meet their burden of establishing that the petition for cancellation was barred by laches.

***The Brooklyn Brewery Corporation v. Brooklyn Brew Shop, LLC*, 2020 USPQ2d 10914 (TTAB 2020) [precedential].** In an exhaustive 70-page opinion, 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 “beer making kits,” ruling that laches and acquiescence barred the plaintiff’s Section 2(d) claims. Plaintiff Brewery admitted that it was aware of Defendant Brew Shop’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 Brew Shop’s word mark and stylized mark to be substantially the same, and so laches applied in the opposition proceeding as well. The Board deemed Plaintiff Brewery’s delay unreasonable, rejected its progressive encroachment argument, and concluded that Brew Shop suffered material prejudice because of the delay. Furthermore, the Board found that confusion between Brew Shop’s marks and Brewery’s marks BROOKLYN and BROOKLYN BREWERY for beer was not inevitable. As to acquiescence, the Board found that, in view of the parties’ collaboration, Brewery actively represented that it would not assert its rights against Brew Shop.



## 10. Concurrent Use

***Hanscomb Consulting, Inc. v. Hanscomb Limited*, 2020 USPQ2d 10085 (TTAB 2020) [precedential].** Hanscomb Consulting, Inc. (HCI) sought a concurrent use registration for the mark HANSCOMB CONSULTING & design for various business services, covering the entire United States except for two geographical areas (Hinsdale, Illinois, and Los Angeles, California). HCI had the burden of proving that it was entitled to registration for its proposed geographic territory, that Hanscomb Limited’s (HL) territory should be correspondingly restricted, and that such restrictions would avoid a likelihood of confusion arising from the parties’ concurrent use of their marks. HCI established that it began using its mark prior to the filing date of HL’s application to register HANSCOMB. The Board, however, found that “HL has demonstrated prior and continuous use of its HANSCOMB mark in many locations throughout the U.S.” This finding of fact by the Board “invalidates HCI’s proposed geographic restriction on the use of HL’s mark in connection with the services.” And so, the Board dissolved the concurrent use proceeding and HCI’s application was deemed abandoned.



## 11. Procedural Issues

### a. Requirement for U.S. Counsel

***Cloudworks Consulting Services Inc. v. Ongoing Operations, LLC*, 2020 USPQ2d 10019 (TTAB 2020) [precedential].** In a three-page Order, the Board ruled that a party domiciled in Canada – despite the appearance of a USPTO-recognized Canadian trademark attorney/agent on its behalf – must appoint a qualified attorney licensed to practice law in the United States, or in a commonwealth or territory of the United

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States. The USPTO amended its *Rules*, effective August 3, 2019, to require that all applicants, registrants, or parties to a proceeding before the TTAB whose domicile is not within the United States or its territories be represented by an attorney who is an active member in good standing of the bar of the highest court of a state in the United States, or the District of Columbia, or any commonwealth or territory of the United States. “This requirement is not satisfied if a party, like Petitioner, is represented by a foreign attorney or agent, even if that attorney or agent has been granted reciprocal recognition by the USPTO pursuant to Patent and Trademark Rules 11.14(c) and (f), 37 C.F.R. §§ 11.14(c) and (f). A reciprocally recognized attorney or agent may only appear as an **additionally appointed** practitioner.”

#### b. Effect of Consented Extension of Time

***Covidien LP v. ERBE Elektromedizin GmbH*, 2019 USPQ2d 265006 (TTAB 2019) [precedential]**. In this cancellation proceeding involving a registration for the mark SOFT COAG for medical instruments, Petitioner Covidien dodged a motion to strike its summary judgment motion as untimely, but tripped over another procedural hurdle, resulting in the Board declining to consider its summary judgment motion. The Board faced the question of whether the granting of a consent motion for extension of all dates, filed just before the pretrial disclosure deadline, also extended the date for filing a summary judgment motion. Yes indeed, said the Board. Respondent ERBE had consented to the extension with no conditions or restrictions, and Covidien’s summary judgment motion, although filed before the extension was granted, was timely and was not premature because the granted extension was retroactive. The Board, however, declined to consider Covidien’s motion for summary judgment because it exceeded the allotted page limit. *Trademark Rule* 2.127(a), 37 C.F.R. § 2.127(a), provides that no motion “shall exceed twenty-five pages in length in its entirety . . . .” Covidien’s motion for summary judgment was 28 pages long. Since “[t]he Board generally does not consider briefs that exceed the page limit,” Covidien’s motion for summary judgment was given no consideration.

#### c. Sufficiency of Notice of Reliance

***STX Financing, LLC v. Terrazas*, 2020 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 notice of reliance 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 date the material was accessed and printed, and the source. Likewise, the file history document was admissible as an official record, even though it did not include the entire file history. And as to the website excerpts, it was sufficient that Terrazas supplied the date of access and identified the source in the notice of reliance.

#### d. 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

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by Respondent General Cigar on the same day as its pretrial disclosures. FED. R. CIV. P. 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” is 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.”

#### e. Discovery Issues

***Chix Gear, LLC v. Princess Race Wear Corp.*, 2019 USPQ2d 455321 (TTAB 2019) [precedential].** The Board denied a motion to compel Applicant Princess Race Wear to produce the “metadata” for five photographs that it provided during discovery, because Opposer Chix Gear did not ask for metadata in its discovery requests. After receiving five photographs (in electronic form) in response to its production requests, Chix Gear filed a motion to compel Princess to furnish the date the photographs were taken and the identity of the person who took the photographs. Princess responded that none of Chix Gear’s production requests required Princess to provide this information, and therefore there was nothing to compel. In reply, Chix Gear referred to the requested information as “metadata,” and insisted that metadata must be provided in order to fully respond to the original production requests. The Board observed that under FED. R. CIV. P. 34(b)(1)(C) a party seeking discovery may specify a form for production and may request metadata. However, Chix Gear’s production requests made no mention of metadata, nor did the parties discuss same. The Board found no legal basis for any argument that a request for metadata is implicit or inherent in Chix Gear’s discovery request.

***Spliethoff’s Bevrachtungskantoor B.V. v. United Yacht Transport LLC dba United Yacht Transport*, 2020 USPQ2d 10605 (TTAB 2020) [precedential].** The Board denied opposer’s motion for leave to take additional discovery depositions beyond the ten-deposition limit of FED. R. CIV. P. 30(a)(2), ruling that opposer had failed to make the required “particularized showing” as to the need for additional depositions. The Board looks to “whether additional depositions are proportional to the needs of the case, the importance of the issues, the parties’ relative access to relevant information, the importance of the discovery in resolving the issues, and whether the burden or expense of the proposed discovery outweighs its likely benefit.” Five of the ten witnesses that opposer deposed were its own witnesses, and were unjustified because they could have testified at trial. Two third-party deponents who were merely custodians of records and two depositions of attorneys were likewise unnecessary. “That Opposer chose to take unnecessary depositions while foregoing important ones was an unfortunate strategic decision, but not a basis for granting the relief sought.” The Board did allow Spliethoff’s to take the deposition of United Yacht’s expert, since “parties typically do not learn of the need to depose an expert until late in the discovery period.”

***Andrew R. Flanders v. DiMarzio, Inc.*, 2020 USPQ2d 10671 (TTAB 2020) [precedential].** The Board denied Respondent DiMarzio, Inc.’s motion for a protective order requiring Petitioner Flanders to take the *Rule* 30(b)(6) deposition of DiMarzio in Bozeman, Montana, where its designated witness resides. The Board declined to depart from the customary practice in federal court that the deposition of a corporation is

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ordinarily taken at its principal place of business. Flanders noticed the deposition for New York City. DiMarzio has its principal place of business in New York and had previously insisted that the deposition take place there. The Board observed that “[t]he location of a Rule 30(b)(6) deposition where the corporate designee resides in a state different from that in which the corporation has a principal place of business appears to be an issue of first impression for the Board.” Noting that federal courts have broad discretion in determining the appropriate place for a *Rule* 30(b)(6) deposition for the convenience of the parties and in the interests of judicial economy, the Board concluded that “[a]ll the equities favor holding Respondent’s deposition in New York City.”

***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. Praise moved under FED. R. CIV. P 56(d) for discovery regarding the relevant Section 2(d) issues. The Board granted the discovery motion, noting that one purpose of RULE 56(d) is to protect a party from being ambushed by a summary judgment motion having an opportunity to obtain relevant discovery. Under FED. R. CIV. P 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 interrogatories and document requests were on point. The Board found that Praise had adequately explained “why it is unable to prepare a response without discovery and confirms that what it needs is largely within Petitioner’s possession, custody or control.” Although the 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.”

#### f. Sanctions

***Optimal Chemical Inc. v. Srills LLC*, 2019 USPQ2d 338409 (TTAB 2019) [precedential]**. Finding that Petitioner Optimal Chemical had perpetrated a fraud on the Board through fabricated evidence and untruthful testimony, the TTAB invoked its inherent authority to sanction Optimal by dismissing its petition for cancellation. First, the Board dealt with Optimal’s spoliation of evidence: Optimal had blocked access to its website despite the fact that some of the website pages had been relied upon in Optimal’s filings. However, because there was no evidence of bad faith on the part of Optimal, the Board opted for the lesser sanction of refusing to consider this particular website evidence. As to fabrication, the Board found that Respondent Srills had established “by clear and convincing evidence that Petitioner participated in a pattern of submitting testimony and evidence which is inaccurate, fabricated, altered, and untruthful in order to demonstrate priority of use, an integral element of its claim of likelihood of confusion.” Optimal’s actions regarding these documents and this testimony tainted its entire case. “Petitioner’s pattern of litigation misconduct in this proceeding constitutes fraud on the Board and is deserving of such a severe sanction. Although there is other evidence of record that is not subject to Respondent’s construed motion for sanctions, the credibility and authenticity of such evidence has been severely tainted and, therefore, we do not consider it.”

***Busy Beauty, Inc. v. JPB Group, LLC*, 2019 USPQ2d 338392 (TTAB 2019) [precedential]**. In another ruling regarding the spoliation of evidence, the Board refused to consider certain of Petitioner Busy Beauty’s Instagram photographs and data, finding that petitioner had failed to preserve the corresponding electronically stored information (ESI). Busy Beauty claimed common law rights in the mark BUSY BEAUTY since 2016 for women’s shaving gel, but it admitted that it had deleted from its Instagram account all posts prior to October 1, 2018. Respondent JPB argued that Busy Beauty

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had “knowingly and willfully” deleted the posts. FED. R. CIV. P 37(e) governs the issue of spoliation of ESI and provides for the issuance of an array of possible sanctions, but “no greater than necessary to cure the prejudice” to the party seeking the information. The Board found that Busy Beauty should have preserved the Instagram posts in question and that the lost ESI could not be restored or replaced through additional discovery. Although Busy Beauty was “at least careless” in its data preservation, the Board found the prejudice to Respondent JPB to be minimal. There was no proof that Busy Beauty intended to deprive its adversary of the information, and so the Board declined to enter the severe sanctions of an adverse inference or adverse judgment.

***Fifth Generation Inc. v. Titomirov Vodka LLC*, 2019 USPQ2d 418666 (TTAB 2019) [precedential].** The Board granted Plaintiff Fifth Generation’s motion for entry of judgment as a sanction, under *Trademark Rule* 2.120(h), due to Defendant Titomirov Vodka’s failure to heed various Board orders and for its “pattern and practice . . . of avoiding its discovery obligations evidencing willful evasion.” Under *Rule* 2.120(h)(1) and FED. R. CIV. P 37(b)(2), the Board may issue appropriate sanctions for failure to comply with a discovery order, including entry of judgment. Although judgment is a harsh remedy, it is justified when there is a strong showing of willful evasion and no less drastic remedy would be effective. The Board found that Titomirov “failed to comply with Board orders regarding discovery by: (1) failing to properly supplement its discovery responses concerning [its only officer’s] presence in the United States, and (2) failing to make witnesses available for deposition.” Titomirov attempted to evade discovery by misrepresenting its relationship with two individuals and misstating their residence addresses. It filed two unsupported motions for extensions of time and requested a telephone conference apparently for the purpose of delay. “Such dubious filings not only demonstrate Titomirov’s dilatory intent, but also tax Board resources.”