

Third-Party Registrations in the PTO

Hon. James Walsh
Michael E. Hall

I. Third-Party Registrations Used to Show Relatedness of Goods and Services in Likelihood of Confusion

A. Third-Party Registrations May Be Probative – *Mucky Duck* and *Trostel*

Third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, although not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, may nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source.

In re Mucky Duck Mustard Co. Inc., 6 U.S.P.Q.2d 1467, 1470 n.6 (T.T.A.B. 1988).

Five years later, the Board's decision in *In re Albert Trostel & Sons Co.*, 29 U.S.P.Q.2d 1783 (T.T.A.B. 1993), cited *Mucky Duck* for the proposition that third-party registrations may be relevant to show relatedness. These two decisions – *Mucky Duck* and *Trostel* – are often cited together as support for the relevancy of third-party registrations. See, e.g., *In re Davey Prods. Pty Ltd.*, 92 U.S.P.Q.2d 1198, 1203 (T.T.A.B. 2009); T.M.E.P. § 1207.01(d)(iii).

B. Important Limitations on *Mucky Duck-Trostel* Line of Cases

Third-party registrations are often accepted by the Board as competent evidence to show relatedness. However, it is not unusual for at least some of the third-party registrations of record to suffer from one or more of the deficiencies noted below.

1. Do the Third-Party Registrations Actually Include Both Applicant's Goods and Registrant's Goods?

If the third-party registrations do not include both the applicant's specific goods and the specific goods in the cited registration, the third-party registrations may have little or no probative value. This problem is fairly common.

Cases

- *In re W.W. Henry Co.*, 82 U.S.P.Q.2d 1213, 1215 (T.T.A.B. 2007) (“[U]pon review, we find that none of the registrations appear to include goods of the type

listed in applicant's application *and* the cited registration. In particular, none of the registrations cover preparations for the repair of polyolefin surfaces. Thus, the third-party registrations are insufficient to show that applicant's and registrant's goods are of a type that may emanate from a single source.")

- *In re Band-It-IDEX, Inc.*, Serial No. 77363240 (T.T.A.B. October 20, 2009) (non-precedential) (finding third-party registrations that contained similar, but not identical, goods to have "less probative value, under *Trostel* and *Mucky Duck*, as evidence that applicant's goods and the goods in the cited registration are related.")
- *In re Formax, Inc.*, Serial Nos. 77298497 and 77298501 (T.T.A.B. October 14, 2009) (non-precedential) ("we find the Examining Attorney's reliance on the third-party registrations misplaced. Not one of the registrations covers the two specific types of goods identified in the application and the cited registration.")
- *In re Force Tech.*, Serial No. 79040079 (T.T.A.B. June 19, 2009) (non-precedential) (dismissing examining attorney's ten third-party registrations)
- *In re Deceuninck N. Am. LLC*, Serial No. 77465459 (T.T.A.B. May 27, 2009) (non-precedential) ("Based on the sparse record (*i.e.*, seven third-party registrations that do not include registrant's specifica [sic] goods), we do not find that the Examining Attorney met her burden . . .")
- *Tensar Corp., LLC v. McElroy Metal Mill, Inc.*, Opposition No. 91174290 (T.T.A.B. March 17, 2009) (non-precedential) (recurring problem with opposer's third-party registrations was that they did not "include both the specific types of goods and services identified in opposer's registrations *and* the specific types of goods identified in the opposed application.")
- *In re Carrier Corp.*, Serial No. 78329277 (T.T.A.B. February 15, 2008) (non-precedential) ("Upon closer examination of the evidence submitted by the examining attorney, we find that only one use-based third-party registration includes fan coils and ceiling fans This single registration is insufficient to show that applicant's fan coils and registrant's ceiling fans are of a type which may emanate from a single source.")
- *In re Itec Mfg., Ltd.*, Serial No. 78621722 (T.T.A.B. February 13, 2008) (non-precedential) ("We find this evidence to be particularly unpersuasive in this case. None of the third-party registrations lists both specific types of goods covered by the application and any of the cited registrations.")
- *In re Breach Sec., Inc.*, Serial No. 78668939 (T.T.A.B. June 18, 2007) (non-precedential) ("the third-party registrations submitted by the examining attorney fail to yield a single registration in which the same mark is used to identify a 'network security appliance' or, for that matter, any sort of goods that prevent

security breaches, and registrant's goods. While the third-party registrations make reference to goods that are similar to those identified in the cited registration, they do not refer either to the goods recited in the challenged application or to similar goods used for the purpose of providing computer network security.”)

- *In re Vafiadis*, Serial No. 78509712 (T.T.A.B. January 24, 2007) (non-precedential) (applicant amended its goods to mineral water distributed in the dental field – “None of the third-party registrations includes ‘mineral water distributed in the dental field.’ Therefore, we do not find the examining attorney’s evidence persuasive on this point.”)

Somewhat related to this issue, it has been called “an overstatement of the probative value of third-party registrations” to argue that, for the purpose of showing relatedness, a broad identification in a third-party registration encompasses all goods/services logically falling within that identification – i.e., to apply to third-party registrations the same presumption used in determining likelihood of confusion:

Clearly, a determination of the issue of likelihood of confusion between the applied-for and registered marks must be made on the basis of the goods or services as they are identified in the involved application and registration. . . . However, when third-party registrations are being submitted for the purpose of showing that goods or services are related, the same presumptions of Section 7(b) of the Trademark Act do not apply.

In re Waterstone Capital Mgmt., L.P., Serial No. 78223503 (T.T.A.B. December 30, 2005) (non-precedential).

Thus, though the Board in *Waterstone* cautioned that it did “not mean to suggest that, unless the identification in a third-party registration mimics exactly the identification in the application and the cited registration, it is of no probative value,” it nevertheless found that the examining attorney was giving “too broad a reading to a listing of financial investment or financial management services in a third-party registration when she asserts that such a listing shows that the registrant is offering [the applicant’s more specific] hedge fund management services.” *Cf. In re Phillips-Van Heusen Corp.*, 228 U.S.P.Q. 949, 950 n.5 (T.T.A.B. 1986) (when third-party registrations are introduced, “the Section 7(b) presumptions do not come into play; that is, only the owner of a registration is entitled to rely upon the presumptions afforded thereto under Section 7(b).”).

Similarly, in *In re Optical Sensors Inc.*, Serial No. 78566607 (T.T.A.B. August 13, 2007) (non-precedential), the Board found none of the third-party registrations probative because each employed broad language:

[T]here is not a single registration which sets forth, on the one hand, “hemodynamic monitoring systems” or similarly identified goods, and

“ambulatory blood pressure monitors” or the like specified products, on the other. Such registrations, instead, refer in each instance to a broad category of goods rather than the particular products at issue in this appeal. . . . [T]he approach taken by the Examining Attorney with respect to the third-party registrations which he made of record is tantamount to finding an all-encompassing term for applicant’s and the cited registrant’s goods rather than a showing of relatedness in that the same parties typically offer such goods under an identical mark.

2. Are the Third-Party Registrations Based on Use In Commerce?

Mucky Duck posited that third-party registrations issued under Section 44 “have very little, if any, persuasive value,” and *Trostel* held that their “probative value is very limited.” However, more recent cases, such as those listed below, have accorded *no* probative value to third-party registrations that issued under Section 44 or Section 66.

Cases

- *In re 1st USA Realty Prof’ls. Inc.*, 84 U.S.P.Q.2d 1581, 1583 (T.T.A.B. 2007) (“To the extent that the [examining attorney’s third-party] registrations are based on Section 44 or Section 66 of the Trademark Act, applicant’s objection is well-taken. Because these registrations are not based on use in commerce they have no probative value in showing the relatedness of the services, and they have not been considered.”)
- *In re W.W. Henry Co.*, 82 U.S.P.Q.2d 1213, 1215 (T.T.A.B. 2007) (third-party registrations may be relevant if based on use, but “in this case, only two of the third-party registrations are based on use.”)
- *In re Ervin Leasing, Inc.*, Serial No. 78974694 (T.T.A.B. June 30, 2009) (non-precedential) (“all four of these registrations are based on Section 44 [of] the Trademark Act, and none are based on Section 1(a) use in commerce. Because these registrations are not based on use in commerce they have no probative value in showing the relatedness of the services, and they have not been considered.”)
- *In re Santana Textil S.A.*, Serial No. 77149567 (T.T.A.B. March 20, 2009) (non-precedential) (“none of the registrations submitted by the examining attorney is use-based, so we are unable to accord these registrations any weight in determining the relationship of the goods.”)
- *In re Crave, Inc.*, Serial No. 78865900 (T.T.A.B. September 24, 2008) (non-precedential) (“As we have held many times before, registrations without use in commerce dates are not indicative of a common source in the United States of the goods or services identified therein and have no probative value.”)

3. Do the Third-Party Registrations Cover a Wide Range of Goods?

Mucky Duck itself appeared to dismiss the value of two third-party registrations “issued to Saks & Company and to Knott’s Berry Farm, owners of a large department store and an amusement or theme center, respectively, where a wide variety of goods and services are sold.” *In re Mucky Duck Mustard Co., Inc.*, 6 U.S.P.Q.2d 1467, 1470 n.6 (T.T.A.B. 1988). The Board has since given little or no weight to third-party registrations for house marks or that cover a wide range of goods.

Cases

- *In re Gebhard*, Serial No. 78950320 (T.T.A.B. March 26, 2009) (non-precedential) (“We have given no weight to those third-party registrations for marks which are in the nature of house marks, designer marks and merchandising marks, as it is well-recognized that such marks may be used for a wide variety of items, and therefore they are of little value in showing that the goods for which they are registered are all related.”)
- *In re Tomberlin Prod. Group, LLC*, Serial No. 78734308 (T.T.A.B. November 30, 2007) (non-precedential) (“we do not give further consideration to those registrations submitted by the examining attorney that . . . include a ‘laundry list’ of goods and services”)
- *In re The Orvis Co., Inc.*, Serial No. 78276739 (T.T.A.B. October 22, 2007) (non-precedential) (“we find that the vast majority of [the examining attorney’s third-party] registrations are analogous to house marks because the identifications of goods encompass a broad range of clothing, accessory and sporting goods products. Therefore, the inclusion of fishing vests, swimwear and/or leotards in the identifications of goods is not particularly significant.”)
- *In re Invivo Corp.*, Serial No. 78670679 (T.T.A.B. September 5, 2007) (non-precedential) (“Generally, registrations of house marks are given little probative value in terms of showing that the various goods listed therein are related because they cover such a disparate range of goods.”)
- *7-Eleven Inc. v. HEB Grocery Co. LP*, 83 U.S.P.Q.2d 1257, 1262 (T.T.A.B. 2007) (published but non-precedential) (the “registrations cover a broad array of goods, many of which are wholly unrelated, and, therefore, no conclusion can be drawn as to the relationship between the goods in issue in this case.”)

But see In re Davey Prods. Pty Ltd., 92 U.S.P.Q.2d 1198, 1203 (T.T.A.B. 2009) (“we find that in none of the third-party registrations are the identified goods so varied,

numerous and obviously unrelated that the probative value of the registration under *Trostel* and *Mucky Duck* is negated.”).

4. Are Some of the Third-Party Registrations Owned by the Same Entity?

If some of the third-party registrations are owned by the same entity, they are redundant.

Cases

- *In re Albert Trostel & Sons Co.*, 29 U.S.P.Q.2d 1783, 1785 (T.T.A.B. 1993) (“The five third-party registrations made of record by the Examining Attorney . . . indicate that four entities (two of the registrations have the same owner) have registered their marks . . .”)
- *In re The Orvis Co., Inc.*, Serial No. 78276739 (T.T.A.B. October 22, 2007) (non-precedential) (“Of the remaining fifteen registrations, three are owned by the same entity and, thus, two of these registrations are redundant for purposes of exemplifying the goods registered by that entity. Therefore, we find that the examining attorney has submitted thirteen third-party registrations that may be probative of the issues herein.”).

5. How Many Third-Party Registrations Are of Record?

Once any non-probative registrations have been discarded, if the remaining ones are too few in number they may be insufficient to support the refusal. Indeed, a low number may, under some circumstances, suggest that the goods/services are in fact *not* related. See *In re Coors Brewing Co.*, 68 U.S.P.Q.2d 1059, 1063 (Fed. Cir. 2003) (“although the Board had before it a few registrations for both restaurant services and beer, . . . the small number of such registrations suggests that it is quite uncommon for restaurants and beer to share the same trademark.”).

A single third-party registration would probably never be sufficient by itself. See *In re RAM Oil, Ltd., LLP*, Serial Nos. 77280977 and 77280981 (T.T.A.B. September 3, 2009) (non-precedential) (“One third-party registration is not sufficient to prove that [the applicant’s] gasoline and diesel fuel and [the registrant’s] oil and gas production and exploration services emanate from the same source.”); *In re Carrier Corp.*, Serial No. 78329277 (T.T.A.B. February 15, 2008) (non-precedential) (“This single registration is insufficient to show that applicant’s fan coils and registrant’s ceiling fans are of a type which may emanate from a single source.”); *In re Waterstone Capital Mgmt., L.P.*, Serial No. 78223503 (T.T.A.B. December 30, 2005) (non-precedential) (“the fact that the Examining Attorney has been able to discover only one such [third-party] registration . . . indicates that these services generally do not emanate from a single source under a single

mark.”).

Beyond that, there is no magic number.

Cases

- *In re Picture Entm’t Corp.*, Serial No. 78917269 (T.T.A.B. June 10, 2009) (non-precedential) (**six** third-party registrations held **sufficient** where marks were identical)
- *In re The Boler Co.*, Serial No. 77059048 (T.T.A.B. February 17, 2009) (non-precedential) (**three** third-party registrations plus some additional evidence held **insufficient**)
- *In re 3-D Belt Co., LP*, Serial No. 76650341 (T.T.A.B. November 7, 2008) (non-precedential) (**six** third-party registrations held **insufficient** – “[T]he examining attorney has submitted such a small number of third-party registrations relative to the belts and wallets involved herein, and no additional evidence of actual use, that we find this showing insufficient”)

C. Third-Party Registrations Are Not Conclusive

Even if there are a significant number of probative third-party registrations of record, they are not conclusive on the question of relatedness.

For example, in *In re Platinum Services, Inc.*, Serial No. 77181654 (T.T.A.B. September 28, 2009) (non-precedential), the applicant applied to register the mark shown below (left) for “insurance agency services, namely, providing insurance services in the fields of home, accident, fire, auto, life, medical, and marine insurance to individuals and businesses,” but was refused in view of the registered mark shown below (right) for “reinsurance services, namely, property and casualty reinsurance underwriting and reinsurance claims handling services.”



The decisive point in applicant’s favor was that whereas its insurance services were provided to individuals and businesses, the registrant’s reinsurance services were, by their very nature, provided to other insurance companies. The Board therefore reversed the refusal “since insurance agency services and reinsurance services are rendered to different purchasers and the purchasers of reinsurance are sophisticated.” As for the third-party registrations:

[W]hile the examining attorney’s third-party registration evidence is

probative of the fact that the involved services may emanate from the same source, it does not establish that such services travel in the same channels of trade and are bought by the same purchasers.

D. Applicant May Introduce Its Own Third-Party Registrations

Just as examining attorneys may use third-party registrations to show relatedness, “applicants may submit sets of third-party registrations to suggest the opposite, i.e., that the Office has registered the same mark to different parties for the goods at issue.” *In re G.B.I. Tile and Stone, Inc.*, 92 U.S.P.Q.2d 1366, 1369-70 (T.T.A.B. 2009). As explained more fully in another case:

By submitting the third-party registrations, the Examining Attorney is essentially asking us to draw the inference that when different products are listed in the same registration, those products may emanate from a single source. Applicant may rebut this inference with evidence (*e.g.*, a declaration from counsel or a paralegal that he/she investigated the use of the marks in the third-party registrations and could not find any evidence that the registrants used the marks on both of the products at issue and/or an equal or greater number of third-party registrations owned by different entities for the same or similar marks where each entity has registered its mark for one of the goods at issue).

In re Ayurvedic Concepts, Ltd., Serial No. 78800436 (T.T.A.B. December 5, 2008) (non-precedential).

Cases

- *In re U.S. Vision, Inc.*, Serial No. 76676410 (T.T.A.B. March 31, 2009) (non-precedential) (examining attorney submitted approximately 30 third-party registrations while applicant submitted six sets of registrations – “[t]he weight of this evidence is in favor of the examining attorney’s position”)
- *In re Hyundai Motor Am.*, Serial No. 78889340 (T.T.A.B. September 14, 2009) (non-precedential) (“the fact that there are *numerous* third-party registrations for similar marks owned by different entities for tires and automobiles is consistent with the conclusion that trademark owners in these respective industries do not believe that there is a likelihood of confusion between these marks for the listed goods.”)

E. Criticism of *Mucky Duck-Trostel*

In a non-precedential 2003 decision, Judge Hanak dissented from the majority’s finding of a likelihood of confusion. *In re Nutro Prods., Inc.*, Serial No. 76017060

(T.T.A.B. February 14, 2003). Judge Hanak was particularly critical of what he viewed as the overreliance on third-party registration evidence:

More importantly, third-party registrations by themselves are of virtually no probative value in showing that two types of goods are related merely because they are listed in the same third-party registration. The majority cites but does not quote from In re Mucky Duck Mustard Co., 6 USPQ2d 1467 (TTAB 1988). There the Board stated that third-party registrations “although not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, may nevertheless have some probative value to the extent that they may serve to suggest that the goods or services are of a type which may emanate from a single source.” Mucky Duck, 6 USPQ2d at 1470 n.6 (emphasis added). As the underlined language from Mucky Duck indicates, this Board had been very reluctant to accord even the most minimal evidentiary value to third-party registrations for the purposes of showing that two types of goods are related. This reluctance is quite understandable in that to rely upon third-party registrations to show that two types of goods are related in the minds of the consuming public runs contrary to the teachings of one of the predecessor courts to our primary reviewing Court. That court stated that “in the absence of any evidence showing the extent of use of any of such marks or whether any of them are now in use, they [the third-party registrations] provide no basis for saying that the marks so registered have had, or may have, any effect at all on the public mind so as to have a bearing on likelihood of confusion.” Smith Bros. Mfg. Co. v. Stone Mfg. Co., 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) (original emphasis).

Citing Judge Hanak’s dissent, an applicant in a recent case argued that while “[t]hird-party registrations are certainly a convenient PTO source for evidence on the issue of the relatedness of goods and services, . . . such registrations are simply not probative by themselves.” The Board, however, was unmoved:

A lone dissenting opinion is simply an insufficient basis to deviate from the prevailing case law which, we reiterate, provides that third-party registrations have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source. Albert Trostel & Sons Co., 29 USPQ2d at 1786. Moreover, we point out that the examining attorney did not base her assertion that the goods and services involved herein are related solely on the third-party registrations.

In re Int’l Demographics, Inc., Serial No. 78871559 (T.T.A.B. September 29, 2009) (non-precedential).

In *CNL Tampa International Hotel Partnership, LP v. Palazzolo*, Opposition No. 91163724 (T.T.A.B. March 7, 2007) (non-precedential), opposer relied on 102 third-party registrations to argue that its “restaurant services” were related to the applicant’s “shirts,” both bearing the mark PELAGIA. Writing for the Board, Judge Bergsman emphasized the tentative language in *Trostel*, similar to Judge Hanak’s approach:

the registrations “*may* have some probative value to the extent that they serve to *suggest* that the listed goods and/or services are of a type that may emanate from a single source.” *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786 (TTAB 1993) (emphasis added).

He pointed out that the use of third-party registrations can be taken too far:

[I]f we accepted opposer’s argument that the third-party registrations alone were sufficient evidence to prove that restaurant services and clothing are legally related, we would, in essence, be creating a *per se* rule that the same or similar marks for restaurant services and clothing is likely to cause confusion. Thus, not only would the senior user of a mark for restaurant services have prior rights for that mark for clothing, but the senior user of a mark for clothing would have prior rights for that mark for restaurant services. But that is just the start. Based on opposer’s third-party registrations, restaurant services and clothing are also related to housewares, glassware, toys, sporting equipment, . . . Taken to its absurd extreme, if third-party registrations alone are considered sufficient to prove that goods and services are related, then virtually all consumer products and services would be related. Accordingly, a *per se* rule regarding the relatedness of goods and services is contrary to trademark law which requires that each case be decided on the basis of all of the relevant facts in evidence.

But see In re New Morning Country Store, LLC, Serial No. 77181494 (T.T.A.B. October 23, 2009) (non-precedential) (Judge Bergsman distinguishing *CNL Tampa*, primarily on the ground that the “shirts” in *CNL Tampa* were collateral merchandise).

Lastly, John Welch at *The TTABlog* has wondered whether the Office needs to rely on third-party registrations anymore:

I suspect that this doctrine was created because Examining Attorneys did not have the ability to gather evidence of actual use of third-party registered marks, and so the TTAB accepted the registrations alone. In this Internet age, however, isn’t it now a lot easier for an Examining Attorney to find actual use of a third-party mark? Shouldn’t he or she be required to search the Internet to see if a third-party mark is indeed in use? In short, is the *Albert Trostel/Mucky Duck* doctrine necessary or appropriate any more?

II. Other Uses of Third-Party Registrations

- *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 U.S.P.Q. 693 (C.C.P.A. 1976) (D DAKTRONICS INC. and design for “electronic voting systems, including a plurality of voting stations, at least one display unit and recording unit and one or more control units for the same; and electronic scoreboards for athletic events, including a control unit for the same” held not likely to be confused with TEKTRONIX for “electronic measuring instruments and auxiliary apparatus — namely, oscilloscopes, wave generators, amplifiers, and preamplifiers for use with oscilloscopes and time mark generators for use in testing and calibration” based, in part, on third-party registrations showing that TRONICS and TRONIX were common suggestive elements of marks for electronic goods)
- *Conde Nast Publ’ns., Inc. v. Miss Quality, Inc.*, 507 F.2d 140, 184 U.S.P.Q. 422 (C.C.P.A. 1975) (COUNTRY VOGUES for “ladies’ and misses’ dresses” held not likely to be confused with VOGUE for “a magazine” based, in part, on evidence of sixty-nine third-party registrations for marks which include VOGUE)
- *Truescents LLC v. Ride Skin Care LLC*, 81 U.S.P.Q.2d 1334 (T.T.A.B. 2006) (RIDE GENUINE SKIN CARE and design for “non-medicated skin care products namely sunscreen, skin cleansers, skin moisturizers, pre-moistened cosmetic wipes and lip balms” held not likely to be confused with GENUINE SKIN for “skin soaps, liquid soaps, and lotions for hands, face, hair and body” based, in part, on dictionary evidence and forty-six third-party registrations for marks which include GENUINE for a variety of goods showing that GENUINE was laudatory)
- *Knight Textile Corp. v. Jones Inv. Co.*, 75 U.S.P.Q.2d 1313 (T.T.A.B. 2005) (NORTON MCNAUGHTON ESSENTIALS for “ladies’ sportswear, namely, shirts, shorts, pants, jumpers, dresses, skirts, jackets, blouses and vests” held not likely to be confused with ESSENTIALS for “women’s clothing, namely pants, blouses, shorts, and jackets for women” based, in part, on dictionary evidence and twenty-three third-party registrations, owned by twenty-one different owners, for similar goods for marks which include ESSENTIALS showing that ESSENTIALS was highly suggestive)

But see In re Fiesta Palms, LLC, 85 U.S.P.Q.2d 1360, 1364-66 (T.T.A.B. 2007) (distinguishing *Knight Textile* on the facts)