

INTELLECTUAL
PROPERTY
LAW



presents

TRADEMARK OFFICE COMES TO CALIFORNIA

TTAB Year in Review

Tuesday and Thursday, June 13 & 15, 2023
3:00 p.m. – 4:00 p.m.

MCLE: 1 Hour

Speakers:

John Welch, Wolf, Greenfield & Sacks, P.C.

Conference Reference Materials

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2023 Annual Review

TTAB DEVELOPMENTS

John L. Welch



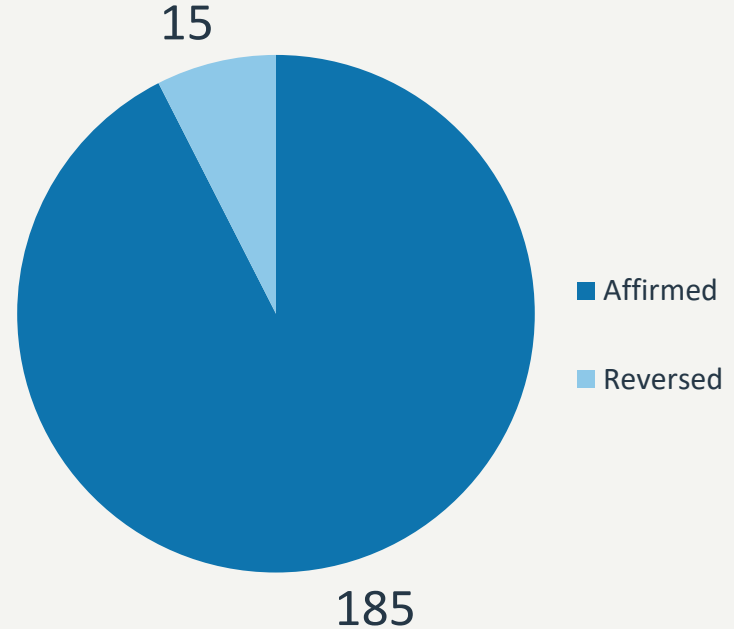


HOUSEKEEPING?

Likelihood of Affirmance of a 2(d) Refusal?

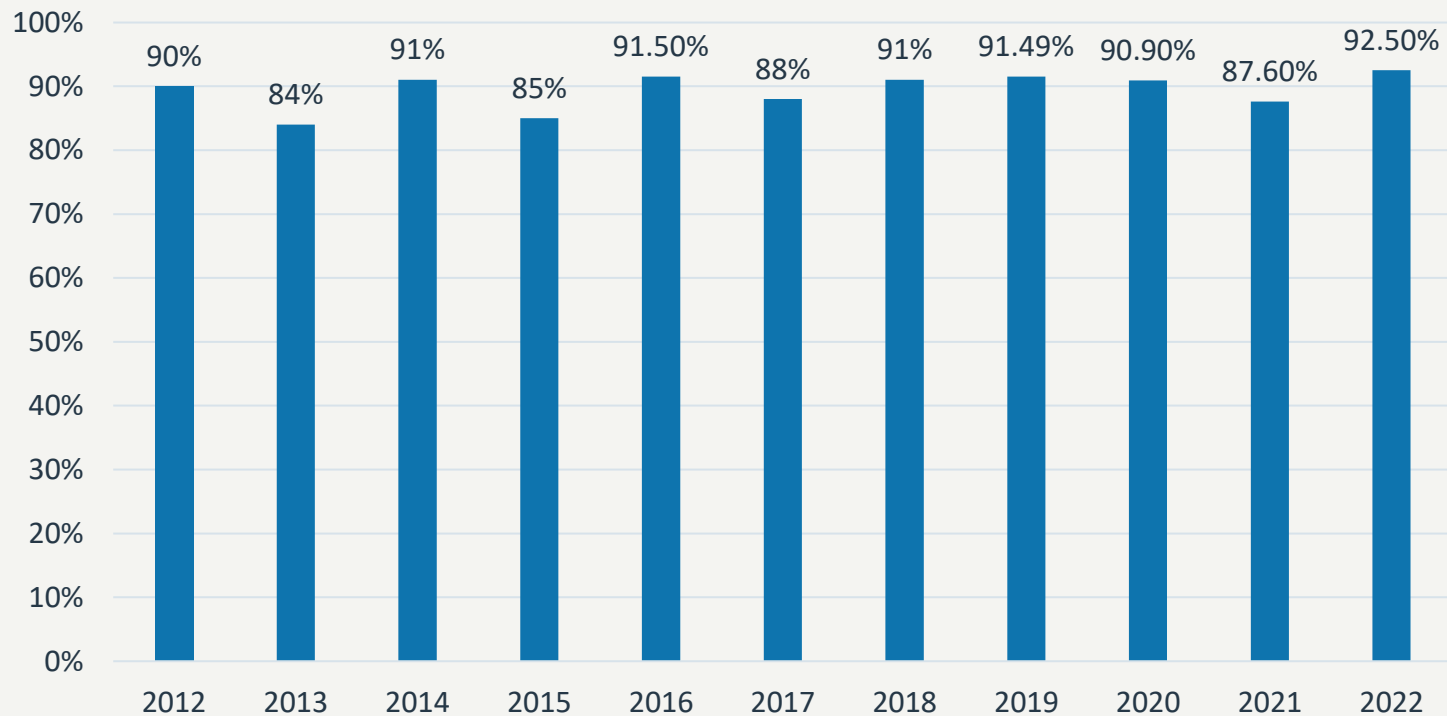
For the calendar year 2022, I counted 200 Section 2(d) refusals, of which 185 were affirmed and 15 reversed.

That's an affirmance rate of 92.5%, slightly higher than last year's rate.





Likelihood of Affirmance of a 2(d) Refusal?

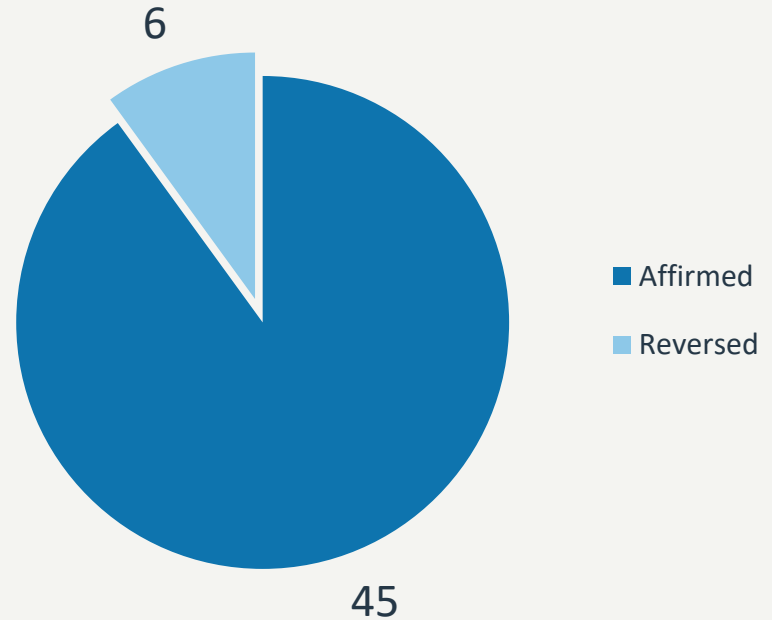




What About Section 2(e)(1) Mere Descriptiveness Refusals?

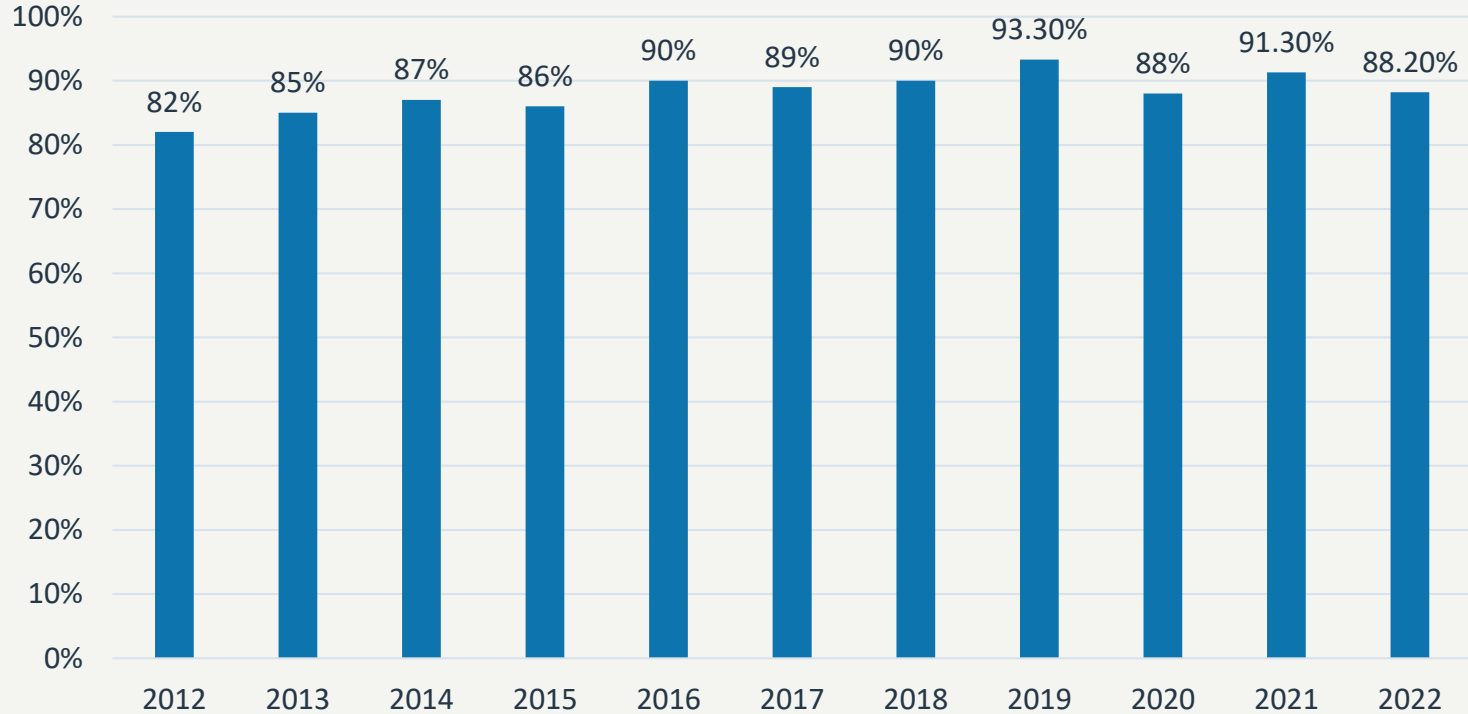
Of the 51 Section 2(e)(1) mere descriptiveness refusals, 45 were affirmed and 6 reversed, for an affirmance rate of 88.2%.

That's a drop from last year's 91.3% rate.





What About Section 2(e)(1) Descriptiveness Refusals?





Judge Linda Kuczma Leaves the Board

Linda Kuczma has left the TTAB to return to private practice in Chicago. The Board now consists of 25 Administrative Trademark Judges, including Chief Judge Rogers and Deputy Chief Judge Thurmon.





Pilot Program for Final Pretrial Conferences

The TTAB has announced the implementation of a pilot program for holding a Final Pretrial Conference (“FPC”) in selected cases





Pilot Program for Final Pretrial Conferences

The Board will focus on cases with large or unwieldy records, "overly contentious" proceedings, and cases in which the parties or counsel are unfamiliar with TTAB practice.





Pilot Program for Final Pretrial Conferences

The parties will be required to file a detailed Final Joint Pretrial Order setting forth the issues, witnesses, exhibits, objections, etc., etc. A model format is provided at the TTAB website.



Pilot Program for Final Pretrial Conferences

The Pretrial Conference will be scheduled by the TTAB and held sometime after the close of discovery but before the usual deadline for the Plaintiff's Pretrial Disclosures. During the conference, the ATJ and IA will review with the parties their proposed FPC Order. Once final, the FPC Order will limit what the parties may pursue at trial.



Proposed Trademark Fee Increases – Nov. 2024

Fee category	Description	Current fee	Proposed fee	Dollar change	Percent change
Application filings	Basic application, per class	\$250	\$350	\$100	40%
Application filings	Fee for insufficient information, per class	n/a	\$100	n/a	n/a
Application filings	Fee for using goods and services identifications not contained in Trademark Next Generation ID Manual (using the free-form text box), per class	n/a	\$200	n/a	n/a
Application filings	For each additional 1,000 characters in excess of 1,000, per class	n/a	\$200	n/a	n/a
Intent to use/Use fees	Amendment to allege use (AAU), per class	\$100	\$200	\$100	100%
Intent to use/Use fees	Statement of use (SOU), per class	\$100	\$150	\$50	50%
Intent to use/Use fees	Request for six-month extension for filing an SOU, per class	\$125	n/a	n/a	n/a
Intent to use/Use fees	Fourth and subsequent request for six-month extension for filing an SOU, per class	n/a	\$250	\$125	100%
Trademark processing fees	Petition to the Director	\$250	\$400	\$150	60%
Trademark processing fees	Petition to revive an application	\$150	\$250	\$100	67%
Trademark processing fees	Letter of protest	\$50	\$250	\$200	400%
Maintaining exclusive rights	\$9 registration renewal application, per class	\$300	\$350	\$50	17%
Maintaining exclusive rights	\$8 declaration, per class	\$225	\$300	\$75	33%
Maintaining exclusive rights	\$15 declaration, per class	\$200	\$250	\$50	25%
Madrid Protocol fees	\$71 declaration, per class	\$225	\$300	\$75	33%



CAFC DECISION(S)



Bertini v. Apple Inc.

CAFC DECISIONS

The CAFC overturned the TTAB's decision dismissing Charles Bertini's Section 2(d) opposition to registration of APPLE MUSIC for a host of services, including the production and distribution of sound recordings and presentation of live music performances.





Charlie Bertini

Trumpet player, recording artist, teacher
& president of AppleJazz Records

Orlando, Florida



Bertini v. Apple Inc.

CAFC DECISIONS

Bertini's first used his mark APPLE JAZZ for entertainment services in 1985. Apple, Inc. has used the mark APPLE MUSIC since 2015, when it launched the APPLE MUSIC streaming service. However, Apple asserted that it acquired trademark rights in the mark APPLE from Apple Corps, with an August 1968 date of use, for gramophone records



Bertini v. Apple Inc.

CAFC DECISIONS

Apple claimed priority for all 15 categories of services in its application, including live musical performances, by tacking on Apple Corps' 1968 use of APPLE for gramophone records.



Bertini v. Apple Inc.

CAFC DECISIONS

The CAFC ruled that the Board erred in awarding priority to Apple (via tacking). On a question of first impression, it held that a trademark applicant cannot establish priority for every good or service in its application merely because it has priority through tacking in a single good or service listed in its application.



Bertini v. Apple Inc.

CAFC DECISIONS

The court further ruled that, even if Apple could tack on its use of APPLE MUSIC for sound recordings, to Apple Corps' 1968 use of APPLE for gramophone records, "this does not give Apple priority for live musical performances," nor for the "laundry list" of other services in its application.



Bertini v. Apple Inc.

CAFC DECISIONS

To establish tacking, Apple had to show that live performances are substantially identical to gramophone records. Although tacking is a question of fact, the CAFC saw no need to remand to the Board for finding on the issue of tacking.



Bertini v. Apple Inc.

CAFC DECISIONS

No reasonable person could conclude . . . that gramophone records and live performances are substantially identical. Nothing in the record supports a finding that consumers would think Apple's live musical performances are within the normal product evolution of Apple Corps' gramophone records.



TTAB DECISIONS



CELEBRITIES



NPG Records, LLC and Paisley Park Enterprises, LLC v. JHO Intellectual Property Holdings LLC

SECTION 2(a): FALSE SUGGESTION OF A CONNECTION

Finding that **PURPLE RAIN** for supplements falsely suggests a connection with the famous musician and performer Prince, the Board granted opposers' motion for summary judgment under Section 2(a).





NPG Records, LLC and Paisley Park Enterprises, LLC v. JHO Intellectual Property Holdings LLC

SECTION 2(a): FALSE SUGGESTION OF A CONNECTION

The record contained “copious, unrebutted evidence of Prince’s fame . . . and his unique association with the words PURPLE RAIN,” including his album, a movie, and sales of a variety of consumer products under the mark. Survey results showed that 66.3% of the general public recognize PURPLE RAIN as a reference to Prince.



NPG Records, LLC and Paisley Park Enterprises, LLC v. JHO Intellectual Property Holdings LLC

SECTION 2(a): FALSE SUGGESTION OF A CONNECTION

The Board agreed with Opposers that “[b]ecause purchasers are accustomed to celebrity licensing, they may presume a connection with a celebrity even though the goods have no relation to the reason for the celebrity’s fame.”



NPG Records, LLC and Paisley Park Enterprises, LLC v. JHO Intellectual Property Holdings LLC

SECTION 2(a): FALSE SUGGESTION OF A CONNECTION

“If the applicant’s goods are of a type that consumers would associate . . . in some fashion with a sufficiently famous person or institution, then we may infer that purchasers of the goods or services would be misled into making a false connection with the named party.”



In re Lizzo LLC

FAILURE-TO-FUNCTION

The USPTO's evidence fell short with regard to two refusals of the mark **100% THAT BITCH** for certain clothing items. The Office failed to show that the proposed mark is a common expression in such widespread use that it fails to function as a mark for the identified goods.





In re Lizzo LLC

FAILURE-TO-FUNCTION

Lizzo LLC is the trademark holding company of the popular singer and performer known as Lizzo. The proposed mark was inspired by a lyric in Lizzo’s song, “Truth Hurts.”





In re Lizzo LLC

FAILURE-TO-FUNCTION

The Office maintained that 100% THAT BITCH "is a commonplace expression widely used by a variety of sources to convey an ordinary, familiar, well-recognized sentiment."



In re Lizzo LLC

FAILURE-TO-FUNCTION

Why men great 'til they gotta be great?

Wooh

I just took a DNA test, turns out I'm 100% that bitch

Even when I'm crying crazy

Yeah, I got boy problems, that's the human in me

*Bling Bling, then I solve 'em, that's the goddess in
me*



In re Lizzo LLC

FAILURE-TO-FUNCTION

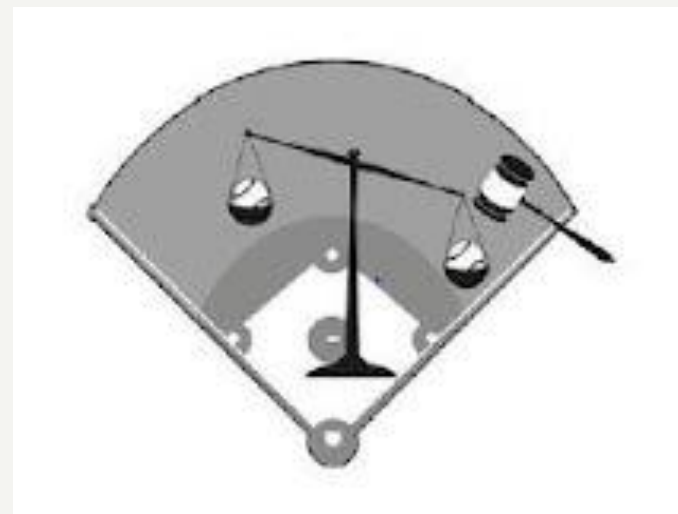
Lizzo and the examining attorney agreed that 100% THAT BITCH conveys a feeling of female strength, empowerment and independence. “But more importantly, considering the entirety of the record, we find that most consumers would perceive 100% THAT BITCH used on the goods in the application as associated with Lizzo rather than as a commonplace expression.”



Major League Baseball Players Association and Aaron Judge v. Michael P. Chisena

SECTION 2(d): LIKELIHOOD OF CONFUSION

The Board sustained this opposition to registration of the word marks **ALL RISE** and **HERE COMES THE JUDGE** and the design mark shown here, for t-shirts, etc., finding confusion likely with certain common law rights of the opposers.





*Major League Baseball Players Association and Aaron Judge
v. Michael P. Chisena*

SECTION 2(d): LIKELIHOOD OF CONFUSION

Applicant Chisena, a Long Island resident purportedly oblivious to the meteoric ascent of Aaron Judge in the baseball world, filed his intent-to-use applications for the word marks on July 14, 2017, and for the design mark on October 12, 2017.



*Major League Baseball Players Association and Aaron Judge
v. Michael P. Chisena*

SECTION 2(d): LIKELIHOOD OF CONFUSION

Sports media, the Yankees, and Yankee fans had already adopted a "judicial theme" in promotional material, stadium signage, and various souvenir items referring to him.





*Major League Baseball Players Association and Aaron Judge
v. Michael P. Chisena*

SECTION 2(d): LIKELIHOOD OF CONFUSION

By that time, Aaron Judge had established himself as a star outfielder for the New York Yankees. Sports media, the Yankees, and Yankee fans had already adopted a "judicial theme" in promotional material, stadium signage, and various souvenir items referring to him, displaying the phrases ALL RISE and HERE COMES THE JUDGE and depictions of "judicial indicia, such as a gavel, courthouse image, or the scales of justice, accompanied by his name or likeness."



*Major League Baseball Players Association and Aaron Judge
v. Michael P. Chisena*

SECTION 2(d): LIKELIHOOD OF CONFUSION

The Board found that the Opposer’s had “standing” to bring their claims, that they had priority of use, and that the word marks and the judicial indicia served as source indicators and were not merely ornamental or informational (citing *In re Lizzo LLC*).



*Major League Baseball Players Association and Aaron Judge
v. Michael P. Chisena*

SECTION 2(d): LIKELIHOOD OF CONFUSION

“[The design mark] confirms the reference to baseball, framing the key judicial images against a baseball diamond background. Superimposed over the baseball field are the scales of justice, tilting toward right field, Aaron Judge’s frequent defensive position. Suspended in the scales of justice are baseballs. Striking the baseball in right field is a judicial gavel—an image frequently used to replace a baseball bat in the hands of Mr. Judge.”



Curtin v. United Trademark Holdings, Inc.

ENTITLEMENT TO A STATUTORY CAUSE OF ACTION

Unsurprisingly, the Board dismissed Professor Rebecca Curtin's opposition to registration of **RAPUNZEL** for dolls and toy figures, finding that Curtin, as a mere consumer of fairytale-themed products, failed to prove her entitlement to a statutory cause of action.





Curtin v. United Trademark Holdings, Inc.

ENTITLEMENT TO A STATUTORY CAUSE OF ACTION

“A plaintiff may oppose registration of a mark when doing so is within the zone of interests protected by the statute and she has a reasonable belief in damage that would be proximately caused by registration of the mark.” (emphasis added).



Curtin v. United Trademark Holdings, Inc.

ENTITLEMENT TO A STATUTORY CAUSE OF ACTION

Here, “the essential problem” for Opposer Curtin is that mere consumers “are generally not statutorily entitled to oppose registration under 115 U.S.C. § 1063.”



Curtin v. United Trademark Holdings, Inc.

ENTITLEMENT TO A STATUTORY CAUSE OF ACTION

The Board observed that Section 1063 entitles “[any person who believes that [she] would be damaged by the registration of a mark” to oppose it. Although this language is quite broad, it is not to be given an expansive reading. As required by *Lexmark*, the Board must first look to see whether Curtin came within the “zone of interests” protected by the Trademark Act.



Curtin v. United Trademark Holdings, Inc.

ENTITLEMENT TO A STATUTORY CAUSE OF ACTION

In *Lexmark*, the Supreme Court pointed out that “[i]dentifying the interests protected by’ the Trademark Act “requires no guesswork.” *Lexmark*, 109 USPQ2d at 268. Section 45 of the Act identifies those interests:



Curtin v. United Trademark Holdings, Inc.

ENTITLEMENT TO A STATUTORY CAUSE OF ACTION

“The intent of this chapter is to regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in such commerce; ... to protect persons engaged in such commerce against unfair competition”



Curtin v. United Trademark Holdings, Inc.

ENTITLEMENT TO A STATUTORY CAUSE OF ACTION

In short, the Trademark Act “regulates commerce and protects plaintiffs with commercial interests.”

If, according to *Lexmark*, a business that buys goods or services does not fall within the Act, then “[a] fortiori, a mere consumer that buys goods or services is not under the Trademark Act’s aegis.”



Curtin v. United Trademark Holdings, Inc.

ENTITLEMENT TO A STATUTORY CAUSE OF ACTION

In addition, Curtin "must show economic or reputational injury flowing directly from" Applicant's registration of RAPUNZEL. *Lexmark*, 109 USPQ2d at 2069.

Here, Curtin's evidence of the damage she would allegedly suffer is "too remote from registration and is entirely speculative."



In re Erik Brunetti

FAILURE-TO-FUNCTION

The Board affirmed refusals to register **FUCK** for phone cases, jewelry, bags, and retail store services, on the ground that the word “fuck” fails to function as a trademark.





In re Erik Brunetti

FAILURE-TO-FUNCTION

The Board concluded that the word "fuck" is in such widespread use that it does not create the commercial impression of a source indicator, but rather expresses well-recognized, familiar sentiments.





In re Erik Brunetti

FAILURE-TO-FUNCTION

The Board rejected Brunetti's argument that the Supreme Court decision in the **FUCT** case requires reversal here, and it also rejected his claim of biased treatment by the Board.





In re Erik Brunetti

FAILURE-TO-FUNCTION

“Applicant has not provided any evidence that plausibly suggests the USPTO maintains any bias against him for prevailing in his appeal of the Office’s refusal to register a different word (FUCT) based on a different statutory basis (Section 2(a)’s now invalidated scandalous and immoral provision), or is motivated by his exercise of his first amendment rights.”



Mystery Ranch, Ltd. v. Terminal Moraine Inc. dba Moraine Sales

SECTION 2(c): CONSENT OF LIVING INDIVIDUAL

In a rare Section 2(c) opposition, the Board sustained this opposition to registration of DANA DESIGN in the form shown here, for backpacks, hiking equipment, and related goods, on the ground that the mark comprises the name of a living individual, Dana Gleason, without his consent.







Mystery Ranch, Ltd. v. Terminal Moraine Inc. dba Moraine Sales

SECTION 2(c): CONSENT OF LIVING INDIVIDUAL

The Board rejected Opposer’s Section 2(a) false connection claim because the opposed mark is not a close approximation of Mystery Ranch’s name or identity, nor does it point uniquely or unmistakably to Mystery Ranch. “[A]lthough consumers associate Dana Gleason and Mystery Ranch . . . they are not perceived as each other’s alter ego.”



Mystery Ranch, Ltd. v. Terminal Moraine Inc. dba Moraine Sales

SECTION 2(c): CONSENT OF LIVING INDIVIDUAL

As to the Section 2(c) claim, the Board found Mystery Ranch to be in privity with Dana Gleason and therefore able to assert Gleason's rights under Section 2(c) to prevent the use of his first name DANA without his written consent, despite the fact that Gleason had assigned his rights in the subject trademark.



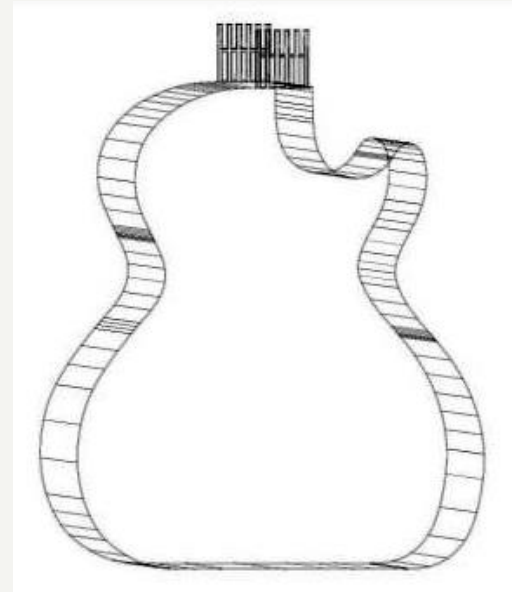
HOTEL SHAPES



In re Seminole Tribe of Florida

INHERENT DISTINCTIVENESS

In a “Seminole” decision, the Board reversed the USPTO's refusal to register “trade dress consisting of a three-dimensional building in the shape of a guitar” for "casinos" and "hotel, restaurant and bar services," finding the proposed mark to be inherently distinctive.





In re Seminole Tribe of Florida

INHERENT DISTINCTIVENESS

In *Two Pesos*, the Supreme Court held that proof of secondary meaning is not required for trade dress that is inherently distinctive, and it upheld the finding that the décor of Taco Cabana's Mexican restaurants was inherently distinctive.





In re Seminole Tribe of Florida

INHERENT DISTINCTIVENESS



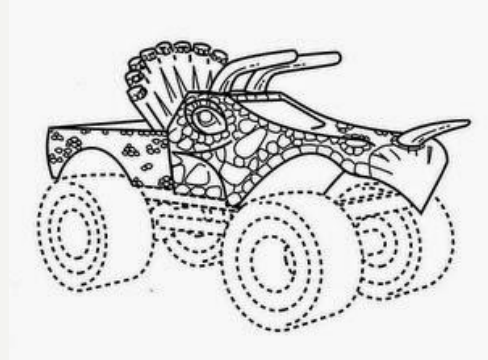
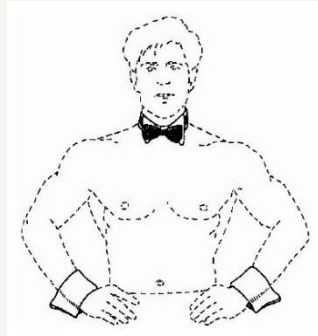
In *Wal-Mart*, the Court distinguished "product design" trade dress from "product packaging," ruling that the former is protectable "only upon a showing of secondary meaning." The Court ruled that the clothing designs at issue constituted product design.



In re Seminole Tribe of Florida

INHERENT DISTINCTIVENESS

The Board found the proposed hotel mark to be "tertium quid" akin to product packaging. Focusing on the uniqueness of the Tribe's building design in the relevant industry – as it did in *Chippendales* and *Frankish* – it concluded that applicant's building design is inherently distinctive for the Tribe's services.





In re Seminole Tribe of Florida

INHERENT DISTINCTIVENESS





In re Seminole Tribe of Florida

INHERENT DISTINCTIVENESS

The Board's conclusion was "further supported" by the *Seabrook* test for inherent distinctiveness: "[W]hether the trade dress is a 'common' basic shape or design; whether it is unique or unusual in a particular field; or whether it is a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods."



In re Seminole Tribe of Florida

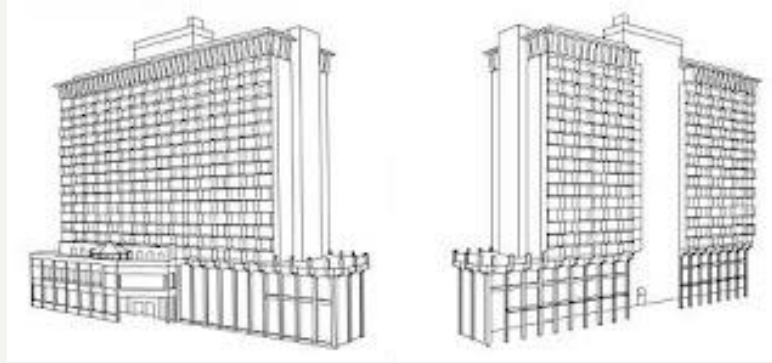
INHERENT DISTINCTIVENESS

We find that Applicant's Mark is not a common design; rather, it is unique, and not a mere refinement of a commonly-adopted and well-known form of ornamentation for Applicant's Services. Given the uniqueness of Applicant's three-dimensional Guitar Design trade dress as applied to Applicant's Services, we find Applicant's Mark is of a type that consumers would immediately rely on to differentiate Applicant's Services from casinos or hotel, restaurant, and bar services offered by others, and that it therefore constitutes inherently distinctive trade dress.



In re Palacio Del Rio, Inc.

INHERENT/ACQUIRED DISTINCTIVENESS



On the same day, the Board upheld the USPTO's refusals to register the two proposed marks shown above, for "hotel services; provision of conference, exhibition, and meeting facilities," finding that the building designs are not inherently distinctive and lack secondary meaning.



In re Palacio Del Rio, Inc.

INHERENT/ACQUIRED DISTINCTIVENESS





In re Palacio Del Rio, Inc.

INHERENT/ACQUIRED DISTINCTIVENESS

Unlike in the *Seminole Tribe* decision, where the Board deemed a hotel building configuration to be neither product design nor trade dress packaging but rather "tertium quid," here the Board panel found the designs to be "akin to the packaging of what is being rendered and sold inside, namely, hotel services."



In re Palacio Del Rio, Inc.

INHERENT/ACQUIRED DISTINCTIVENESS

Following the Supreme Court's decisions in *Two Pesos* and *Wal-Mart*, the Board observed that, unlike product configuration trade dress, product packaging trade dress may be inherently distinctive.



In re Palacio Del Rio, Inc.

INHERENT/ACQUIRED DISTINCTIVENESS

The examining attorney provided evidence of a dozen or so hotel buildings having common design elements similar to the proposed marks. Applicant submitted declarations from four customers of the hotel (the Hilton Palacio Del Rio in San Antonio, Texas). The Board, however, found the declarations to be of "minimal persuasiveness" since they were few in number and identical ("cookie cutter") in many ways, and they included legal conclusions that were the sole province of the Board.



In re Palacio Del Rio, Inc.

INHERENT/ACQUIRED DISTINCTIVENESS

Applying the *Seabrook* factors, the Board found that the proposed marks constitute the “common” basic design elements of hotel buildings façades. “[T]hey are not unique or unusual in the hotel field, and they are mere refinements of commonly-adopted and well-known forms of ornamentation for hotel buildings that would be viewed by the public ‘as a dress or ornamentation’ for Applicant’s hotel services.” And so, the Board rejected applicant’s claim of inherent distinctiveness.



In re Palacio Del Rio, Inc.

INHERENT/ACQUIRED DISTINCTIVENESS

As to acquired distinctiveness, the Board applied the CAFC's *Converse* factors. There was no direct evidence of consumer perception of the hotel design as a trademark, no evidence of copying by third-parties, and no unsolicited media coverage regarding the role of the hotel shape as source indicators. Although the building has been in use since 1968, applicant's sales figures were not placed in context of market share. And there was no evidence that applicant promoted the look of the building by itself, separate from the hotel name, as a service mark.



DUBIOUS DECISIONS



Monster Energy Company v. Chun Hua Lo

SECTION 2(d): LIKELIHOOD OF CONFUSION

Monster Energy successfully opposed registration of **ICE MONSTER & Design** for "restaurants, coffee shops, ices parlors, snack bars with take-out for flavored and fruit ice products, and specifically excluding frozen yogurt" [ICE disclaimed], finding the mark likely to cause confusion with the registered mark **MONSTER ENERGY** for restaurant services.





Monster Energy Company v. Chun Hua Lo

SECTION 2(d): LIKELIHOOD OF CONFUSION

The Board found MONSTER ENERGY to be famous for energy drinks but not for restaurant services. Nonetheless, the Board found the involved marks to be "very similar," the services legally identical in part, and the trade channels and classes of consumers presumably the same.



Monster Energy Company v. Chun Hua Lo

SECTION 2(d): LIKELIHOOD OF CONFUSION

The Board observed that Monster's broad recitation of "restaurant services" encompasses the applicant's restaurants with take-out for flavored and fruit ice products.



Monster Energy Company v. Chun Hua Lo

SECTION 2(d): LIKELIHOOD OF CONFUSION

Monster operates one restaurant, Monster Bistro Café, in its headquarters building, for employees and visitors to the building, and so the Board found no evidentiary basis for finding MONSTER ENERGY to be commercially strong for restaurant services.





Monster Energy Company v. Chun Hua Lo

SECTION 2(d): LIKELIHOOD OF CONFUSION

Comparing the marks at issue, the Board found the "hyperbolic term" MONSTER to be dominant in both marks. Moreover, the term ICE is not only disclaimed, but as presented in the opposed mark may indicate the specialty of the restaurant, "while the term MONSTER alone indicates the mark." [Really?].



Monster Energy Company v. Chun Hua Lo

SECTION 2(d): LIKELIHOOD OF CONFUSION

“Considering the marks as a whole, we find the common term MONSTER, especially when applied to legally identical restaurant services, creates the same commercial impression, and this impression does not alter with the addition of the terms ENERGY, ICE, and the background design or stylization of Applicant’s mark.”



Monster Energy Company v. Chun Hua Lo

SECTION 2(d): LIKELIHOOD OF CONFUSION

On April 3, 2023, the applicant filed a notice of appeal by way of civil action, in the US District Court for the Central District of California.



DC Comics v. Cellular Nerd LLC

SECTION 2(d): LIKELIHOOD OF CONFUSION

The Board tossed out this opposition to registration of this mark for "installation, maintenance and repair of cell phone related hardware," finding no likelihood of confusion with, and no likelihood of dilution of, several "'S' shield" marks associated with the "Superman" character.





DC Comics v. Cellular Nerd LLC

SECTION 2(d): LIKELIHOOD OF CONFUSION



The Board focused on three of DC Comics' registered marks: two "S & Design" marks for entertainment services, comics, clothing, and a few other mundane products, and the colorful design mark shown on the right, for credit card services and customer loyalty rebate programs.



DC Comics v. Cellular Nerd LLC

SECTION 2(d): LIKELIHOOD OF CONFUSION

The Board found the involved marks, goods/services, and trade channels too different for purposes of likelihood of confusion, and as to the dilution claim it deemed the difference between the marks to be fatal.





DC Comics v. Cellular Nerd LLC

SECTION 2(d): LIKELIHOOD OF CONFUSION

As to the marks, the term CELLULARNERD.com dominates applicant's mark because it identifies the character superimposed over the letters "CN" in the diamond shield design. "This creates the commercial impression of a tech nerd ready to solve your cell phone problems in his persona as a tech nerd, as opposed to the letter "S" shield design marks symbolizing a specific superhero."



MISCELLANEOUS LOSERS



Failure-to-Function



In re National Concessions Group, Inc.

FAILURE-TO-FUNCTION

The Board upheld refusals to register the mark **BAKKED** (in standard characters) and a stylized drop design, for "essential oil dispenser, sold empty, for domestic use," finding that the goods are illegal drug paraphernalia under the Controlled Substances Act (CSA), and therefore ineligible for registration.





In re National Concessions Group, Inc.

FAILURE-TO-FUNCTION

The Board rejected applicant's arguments that because the goods are legal under Colorado state law, or are traditionally used with tobacco products, they fall within either of two exemptions set forth in the CSA.



In re National Concessions Group, Inc.

FAILURE-TO-FUNCTION

The evidence "amply supports a finding" that applicant's essential oil dispenser "primarily is intended or designed for use in connection with preparing, inhaling or introducing marijuana into the human body via 'dabbing.'" Consequently, the dispenser comprises prohibited drug paraphernalia as defined in the CSA.



In re National Concessions Group, Inc.

FAILURE-TO-FUNCTION



GET BAKKED

Bakked products offer high purity and value to the cannabis market. With an emphasis on leveraging cutting edge scientific processes into novel product forms at an affordable price, Bakked is a marketplace disruptor.

LEARN MORE [▶](#)





In re National Concessions Group, Inc.

FAILURE-TO-FUNCTION

Not surprisingly, the Board ruled that any authorization by the State of Colorado “cannot override the laws of the other states or federal law outside Colorado.”



In re National Concessions Group, Inc.

FAILURE-TO-FUNCTION

Applicant also contended that its identified goods could be used to dispense tobacco oil because they are “of the type traditionally intended for use with tobacco products.” However, its evidence fell short of convincing the Board that such a tradition existed. The devices that applicant pointed to did not resemble the goods with which applicant uses its mark.



In re Pound Law, LLC

FAILURE-TO-FUNCTION

The Board affirmed a refusal to register the proposed mark **#LAW** for legal referral services, finding that the term, as used on the specimens of use, fails to function as a source indicator.





**MORGAN
&
MORGAN**

CALL #LAW (#529)
FROM YOUR CELLPHONE



In re Pound Law, LLC

FAILURE-TO-FUNCTION

Instead, the Board found that the term, a new type of vanity phone number (#529), would be perceived by consumers as merely informational - a means to contact the applicant or its licensee, the Morgan & Morgan law firm.



In re Pound Law, LLC

FAILURE-TO-FUNCTION

Numerous examples from advertising materials of other law firms demonstrated that #LAW is commonly used as a hashtag in the legal field. “When encountering Applicant’s use of its proposed mark, consumers would be less inclined to view this common term as a source indicator, because they have been exposed to third-party use of the same term in the same field.



In re Pound Law, LLC

FAILURE-TO-FUNCTION

Although the Board has long recognized the registrability of mnemonic telephone numbers (*e.g.*, 1-800-MATTRESS) but this case is distinguishable because Pound Law is not using #LAW as a source indicator but as a means for contacting a law firm.



Section 2(b): Governmental Insignia



In re County of Orange

SECTION 2(b): GOVERNMENTAL INSIGNIA



The Board upheld Section 2(b) refusals of the two marks depicted here, for various governmental services (e.g., maintaining parks and libraries), on the ground that they constitute insignia of a governmental entity, i.e., a “municipality.”



In re County of Orange

SECTION 2(b): GOVERNMENTAL INSIGNIA

The Board rejected the argument that Orange County is not a municipality, as well as the argument that because Orange County already has an “official” seal, these two designs cannot be insignia of the county.



In re County of Orange

SECTION 2(b): GOVERNMENTAL INSIGNIA

The Board took judicial notice of a definition of the term “municipality” as a “city, town, or other local political entity with the powers of self government.” Orange County acknowledged that the California Constitution provides that a county may have some such powers: for example, a county may make and enforce local ordinances, sue and be sued, levy and collect taxes, and adopt a charter. The Board therefore concluded that Orange County is a “municipality” for purposes of Section 2(b).



In re County of Orange

SECTION 2(b): GOVERNMENTAL INSIGNIA



Your Board of Supervisors



In re County of Orange

SECTION 2(b): GOVERNMENTAL INSIGNIA

The Board further found that the “prominent and repeated display of the proposed Circular Mark to denote traditional government records, functions, and facilities would reasonably lead members of the general public to perceive the proposed mark as an ‘insignia’ of Applicant within the meaning of Section 2(b) of the Trademark Act.”



Nonuse/Abandonment



Vans, Inc. v. Branded, LLC

NON-USE/ABANDONMENT

The Board granted petitions to cancel two registrations for the mark **OLD SCHOOL** for various clothing items, on the ground of abandonment.





Vans, Inc. v. Branded, LLC

NON-USE/ABANDONMENT

The Board found that the registrant, despite claiming attempts to sell or license the mark, had discontinued use of the mark with an intent not to resume use.



Vans, Inc. v. Branded, LLC

NON-USE/ABANDONMENT

The Board noted that Branded “failed to introduce any credible documents showing use of the OLD SCHOOL mark to identify clothing or sale of clothing.” Branded’s testimony regarding use was unpersuasive because of its inconsistencies, contradictions, and unspecific nature.



Vans, Inc. v. Branded, LLC

NON-USE/ABANDONMENT

Petitioner Vans thus established nonuse of the mark since 2008, a period of more than three years and thus prima facie evidence of abandonment. Branded could not prove its intent to resume use of its mark on the basis of its intent to sell the mark, “especially where the evidence that it ‘used’ the mark at all is so vague, inconsistent and unreliable.”



Vans, Inc. v. Branded, LLC

NON-USE/ABANDONMENT

“[H]olding a mark with no use, with only an intent to sell the mark at some time in the future, is not proof of present use or intent to resume use.” Indeed, such an intent is evidence of “trafficking in trademarks,” which the Trademark Act seeks to prevent by deeming such an assignment invalid and the involved application or registration void.



Judgment as a Sanction



Rapid Inc. v. Hungry Marketplace, Inc.

JUDGMENT AS A SANCTION

Because Opposer Rapid's star witness "had not only been dishonest with the Board, but he also engaged in spoliation of evidence," the Board threw out this Section 2(d) opposition.





Rapid Inc. v. Hungry Marketplace, Inc.

JUDGMENT AS A SANCTION

Rapid claimed priority of use for its mark **HUNGR** for food ordering application software, and likelihood of confusion with applicant's proposed mark **HUNGRY** for overlapping software. However Rapid was unable to prove priority once the testimony was excluded.



Rapid Inc. v. Hungry Marketplace, Inc.

JUDGMENT AS A SANCTION

Rapid's witness "engaged in a pattern of fabrication and spoliation of evidence, which vitiates the probative effect of his testimony and evidence and taints the remainder of evidence that might otherwise indirectly support Opposer's claim of priority."



Rapid Inc. v. Hungry Marketplace, Inc.

JUDGMENT AS A SANCTION

Furthermore, the Board found that the third-party witnesses, "while perhaps intending to testify truthfully ... merely signed the declarations based on the advice of or their relationship with Mr. Mortensen"



Collective Membership Mark



In re Mission America Coalition

COLLECTIVE MEMBERSHIP MARK

Section 4 of the Trademark Act provides for registration of a collective membership mark, defined as a trademark or service mark adopted by a collective and used by members to indicate membership in the collective.





In re Mission America Coalition

COLLECTIVE MEMBERSHIP MARK

Mission American Coalition sought to register the mark **THE TABLE COALITION** "to indicate membership in a group of church leaders, senior church members, ministers, independent evangelical preachers, and other evangelical principals to promote and support evangelistic activities."



In re Mission America Coalition

COLLECTIVE MEMBERSHIP MARK





In re Mission America Coalition

COLLECTIVE MEMBERSHIP MARK

However, its specimen of use failed to show use by members to indicate membership in the collective organization. And so, the Board affirmed a refusal to register under Sections 1, 4, and 45 of the Act.



Entitlement to a Statutory Cause of Action



Ahal Al-Sara Group for Trading v. American Flash, Inc.

“ENTITLEMENT TO A STATUTORY CAUSE OF ACTION

Petitioner sought to cancel a registration for the mark shown here for various cleaning products, claiming abandonment and fraud, but it failed to sufficiently plead its entitlement to a statutory cause of action.





Ahal Al-Sara Group for Trading v. American Flash, Inc.

ENTITLEMENT TO A STATUTORY CAUSE OF ACTION

Petitioner alleged that Respondent American Flash relied on the subject registration in a cancellation proceeding in Saudi Arabia involving petitioner's FIGHTER FLASH mark.



Ahal Al-Sara Group for Trading v. American Flash, Inc.

ENTITLEMENT TO A STATUTORY CAUSE OF ACTION

A plaintiff must plead facts that, if proved, demonstrate a "real interest" that affects U.S. commerce. Here, the petition relied only on challenges to petitioner's foreign marks in foreign proceedings. "Petitioner has not pleaded a presence in the United States."



Ahal Al-Sara Group for Trading v. American Flash, Inc.

ENTITLEMENT TO A STATUTORY CAUSE OF ACTION

Petitioner did not contend that its interests involve selling or manufacturing goods within the United States, and it had not filed U.S. trademark applications to register FIGHTER FLASH or AMERICAN FLASH or any variations thereof. Nor did Petitioner plead an intent to enter the U.S. market in the future, “or any other facts that if proved, would demonstrate an interest related to or affecting U.S. commerce falling within the scope of protection under the Trademark Act.”



Issue Preclusion



Empresa Cubana Del Tabaco d.b.a. Cubatabaco v. General Cigar Co.

ISSUE PRECLUSION

In the latest round of this 25-year-old battle, the Board granted a petition for cancellation of two registrations for the mark COHIBA for “cigars,” on the ground of violation of Article 8 of the Pan American Convention.





Empresa Cubana Del Tabaco d.b.a. Cubatabaco v. General Cigar Co.

ISSUE PRECLUSION

The evidence showed that Petitioner Cubatabaco enjoyed legal protection of the COHIBA mark in Cuba prior to General Cigar's constructive first use date in the United States, and that General Cigar had knowledge of Cubatabaco's use of the mark in Cuba prior to filing its underlying applications.



Empresa Cubana Del Tabaco d.b.a. Cubatabaco v. General Cigar Co.

ISSUE PRECLUSION

The issue, then, was whether the Article 8 claim was barred under the doctrine of issue preclusion in light of the past federal court litigation between the parties. The Board said no. The CAFC had already held (in 2014) that the issue decided in the litigation—whether § 44(h) of the Act incorporated Article 8 claims—is not the same as the Article 8 issue here, and therefore issue preclusion was inapplicable.



Empresa Cubana Del Tabaco d.b.a. Cubatabaco v. General Cigar Co.

ISSUE PRECLUSION

General Cigar argued that the Supreme Court’s subsequent ruling in *B&B Hardware v. Hargis* effected a change in the law that permitted another review of the preclusion question. The Board, however, was not persuaded that *B&B Hardware* changed the law. Moreover, that case “addressed an entirely different issue: ‘whether the District Court in this case should have applied issue preclusion to the [Board’s] decision,’ . . . not vice versa.”



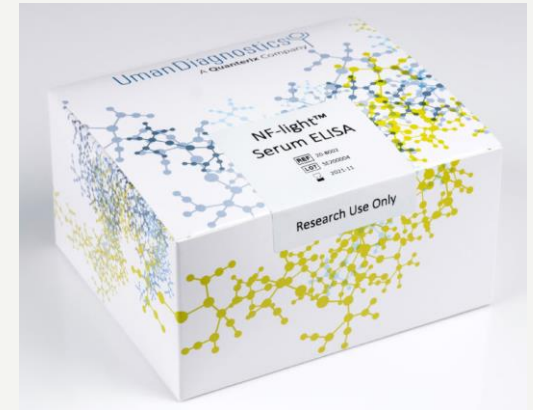
Genericness



In re Uman Diagnostics AB

GENERICNESS

In a “key aspect” genericness case, the Board upheld a refusal to register **NF-LIGHT** for “specimen analysis kits containing reagents and assays for detecting neurological biomarkers. . . used by medical and clinical researchers in labs and institutions,” finding the term to be generic for the goods.





In re Uman Diagnostics AB

GENERICNESS

The Board first found that Applicant Uman’s ELISA kits are “a subset of the broad genus of goods identified in the application,” and that “neurofilament light – the particular ‘neurological biomarker’ detected by applicant’s kit – is a subcategory and key aspect of the genus.” Then it found that the relevant consumers of the goods (clinical and medical researchers) understand NF-Light as a generic term referring to neurofilament light.



In re Uman Diagnostics AB

GENERICNESS

Numerous articles and dictionary references, in addition to third party uses, convinced the Board that “the term NF-LIGHT, or similar variation NF light, is a commonly used and well recognized abbreviation for the neurofilament light subunit. The evidence showed the terms to be “substantially synonymous.” The evidence also showed the term NF-Light is so used by competitors, which is “strong evidence of genericness.”



In re Uman Diagnostics AB

GENERICNESS

Uman, relying on the CAFC's *Merrill Lynch* decision, argued that the USPTO failed to meet its burden of proving that the proposed mark is generic because there was a “mixed record” of usage – i.e., generic usage as well as proper trademark use. The Board was unimpressed.



In re Uman Diagnostics AB

GENERICNESS

[T]his is not a "mixed record" case that compels a finding of non-genericness. "[T]he mere fact that a record includes evidence of both proper trademark use and generic use does not necessarily create a mixed record that would overcome an examining attorney's evidence of genericness." *In re Am. Online, Inc.*, 77 U.S.P.Q.2d 1618, 1623 (T.T.A.B. 2006).



In re Uman Diagnostics AB

GENERICNESS

“Where the record shows a ‘mixture’ of uses, our task remains the same: to determine whether a preponderance of the evidence shows that the proposed mark's ‘primary significance’ to the relevant consuming public is to refer to the product or to indicate source.”



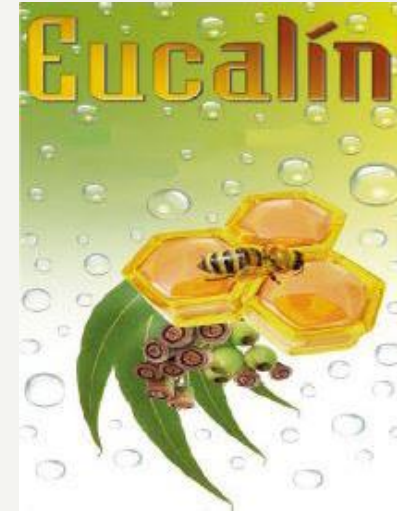
MISCELLANEOUS WINNERS



ARSA Distributing, Inc. v. Salud Natural Mexicana S.A. de C.V.

NON-USE/ABANDONMENT

Finding Applicant Salud's long period of nonuse of its mark **EUCALIN** for nutritional supplements to be excusable, the Board dismissed this Section 2(d) opposition because the Opposer was unable to prove priority.





ARSA Distributing, Inc. v. Salud Natural Mexicana S.A. de C.V.

NON-USE/ABANDONMENT

Salud, deemed a Specially Designated Narcotics Trafficker (SDNT), was banned from doing business in the USA from 2008 to 2015. Although it did not resume use of the mark for another seven years, Salud did commence TTAB litigation with ARSA in 2016 regarding ownership of the mark.



ARSA Distributing, Inc. v. Salud Natural Mexicana S.A. de C.V.

NON-USE/ABANDONMENT

The Board, however, ruled that Salud's nonuse during the ban was excusable and further that Salud maintained an intent to resume use after 2016, negating the presumption of abandonment arising from its nonuse during the period after 2015.



ARSA Distributing, Inc. v. Salud Natural Mexicana S.A. de C.V.

NON-USE/ABANDONMENT

“This is not a case where Applicant decided to cease use of its mark for business reasons. Rather, Applicant had no choice but to cease use of its mark because its use was prohibited by government sanctions”



ARSA Distributing, Inc. v. Salud Natural Mexicana S.A. de C.V.

NON-USE/ABANDONMENT

Salud’s “vigorous defense” of this opposition also supported a finding that it maintained an intent to resume use throughout the litigation.



Goods in Trade



In re The New York Times Company

GOODS IN TRADE

The Board reversed six “goods in trade” refusals for NY Times non-syndicated column titles, under a new test for the registrability of non-syndicated columns or sections in printed publications or recorded media.

HEALTH

The New Old Age

Paula Span explores the unprecedented challenges posed by a rapidly aging population.



THE NEW OLD AGE | BY PAULA SPAN

Birthdays as Part of a Coronavirus Calculation

Reopenings, reclosings and inconsistent guidance complicate weighing risks.

WHAT TO DO about Luke Flacik?

For weeks, Dave and Nancy Nathan had been debating whether to proceed with a long-planned family trip to a lodge there next month, marking his 80th birthday.

"It looked dreamy, mountains and lakes," said Nancy, 74. Besides, they hadn't gathered their clan — three daughters and their families, a dozen people in all — for a year. She thought she and Dave could manage the drive from their home in Bethesda, Md., to upstate New York.

He wasn't so sure.

Both retirees, they'd been cautious through the pandemic, mindful that while neither had health conditions that would make Covid-19 especially dangerous, age alone put them at higher risk. They had avoided supermarkets, relying on grocery delivery services and takeout food. Dave wore gloves on the tennis court.

"I've been dubious about travel," he said. "I have no need to be more daring." Worried, too, about the family members flying from Oregon and Florida for his birthday, he called himself Dr. No.

"It's not fun for him, or anyone, if he's always looking over his shoulder," Nancy said. Still, she hoped they could go.

Early on in the pandemic, most public health officials warned older adults to simply stay at home, except to buy food or medicine or exercise outdoors apart from others. Now, with states and cities reopening (and some reclosing) at varying paces,



ing on Zoom. Can the four couples now meet in a backyard? The members agreed, as

Nancy and Dave Nathan of Bethesda, Md., worried about

things to maintain our mental health and well-being."

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In re The New York Times Company

GOODS IN TRADE

The examining attorney maintained that each mark identifies only “individual portions of [A]pplicant’s publications” and does not identify “separate goods in trade.” Although syndicated columns are considered goods in trade, non-syndicated columns are not. But the Office had carved out an exception for non-syndicated columns allowing registration on the Principal Register under Section 2(f), or on the Supplemental Register.



In re The New York Times Company

GOODS IN TRADE

The NY Times did not dispute that its columns are not syndicated. Nor did it invoke the exception by claiming acquired distinctiveness or seeking registration on the Supplemental Register. It did, however, challenge the contention that its columns are not “goods in trade.”



In re The New York Times Company

GOODS IN TRADE

The Board decided that changes in the marketplace for the delivery of news "have impacted what titles of non-syndicated columns represent," and so "the correct legal standard for determining whether a non-syndicated column is a good in trade should no longer depend on the format in which it is offered."



In re The New York Times Company

GOODS IN TRADE

The Board adopted a new test, based on Lens.com:

- 1) whether the goods are simply the conduit or necessary tool useful only in connection with the applicant's primary goods or services;
- 2) whether they are so inextricably tied to and associated with the primary goods or services as to have no viable existence apart from them; and
- 3) whether they are neither sold separately nor of any independent value apart from the primary goods or services.



In re The New York Times Company

GOODS IN TRADE

The Board concluded that the proposed marks identify individual columns of the newspaper, "distinguishing them from columns of other publishers' newspapers and may be perceived as such by the public."



In re The New York Times Company

GOODS IN TRADE

The Board concluded that the proposed marks identify individual columns of the newspaper, "distinguishing them from columns of other publishers' newspapers and may be perceived as such by the public."



Phat Scooters, Inc. v. Fatbear Scooters, LLC, et al.

GOODS IN TRADE

The Board allowed Respondent Fatbear to correct the identification of the owner of the challenged registration, because the error was "inadvertent, made in good faith, and has been formalized through the filing of and issuance of the limited liability certificate."





Phat Scooters, Inc. v. Fatbear Scooters, LLC, et al.

GOODS IN TRADE

Petitioner contended that the registration was void *ab initio* because Fatbear Scooters, LLC, the applicant named on the underlying application, did not exist as of the filing date.



Phat Scooters, Inc. v. Fatbear Scooters, LLC, et al.

GOODS IN TRADE

When a use-based application is filed by the owner of the mark, the Trademark Act and Rules allow for correction of certain mistakes in the manner or form in which the owner's name is set out in the application or resulting registration. Trademark Act § 7(h), 15 U.S.C. § 1057(h); Trademark Rule 2.71(d).



Phat Scooters, Inc. v. Fatbear Scooters, LLC, et al.

GOODS IN TRADE

For example, if the named applicant did not exist as of the application filing date, the name may be corrected. *See Accu Personnel, Inc. v. Accustaff, Inc.*, 38 USPQ2d 1443, 1446 (TTAB 1996) (holding application filed in name of non-existent entity not void ab initio so long as application filed by correct person).



Phat Scooters, Inc. v. Fatbear Scooters, LLC, et al.

GOODS IN TRADE

Such a correction requires a showing that the applicant be the same, single commercial enterprise that filed and owned the mark at the time of filing the application. *Argo & Co. v. Springer*, 198 USPQ 626, 635 (TTAB 1978).



Phat Scooters, Inc. v. Fatbear Scooters, LLC, et al.

GOODS IN TRADE

“Fatbear Scooters, LLC is ‘merely a later manifestation of the same, single commercial enterprise which filed the application.’ The same single commercial enterprise operated by the Ashkenazie cousins has owned the mark, the application, and the resulting registration the entire time, and the misidentification of the commercial business as a New Jersey limited liability company is a correctable mistake.”



THE TOP EIGHT OR NINE LOSING TTAB ARGUMENTS



The Top Eight or Nine Losing TTAB Arguments

1. Reading limitations into i.d. of goods/services
2. Mere descriptiveness as a guessing game
3. Third-party registrations without use (I of c)
4. Fraud
5. Lack of actual confusion
6. Sophistication of customers
7. Competitiveness of products or services
8. Family of Marks
9. *Morehouse* defense



Things I Don't Like to Hear from TM Attorneys

1. “Incontestable Registration” – no such thing.
2. “Trademark” used as a verb – it’s not.
3. “Mark cancelled” – Registrations are cancelled, not marks.
4. “Cancellation action” – it’s a proceeding, not an action.



**Decisions of the Federal Circuit and the
Trademark Trial and Appeal Board on Registrability Issues
July 2022 to June 2023**

By John L. Welch*

PART I. EX PARTE CASES

A. United States Court of Appeals for the Federal Circuit

1. Section 2(d) Likelihood of Confusion

In re Charger Ventures LLC, 2023 USPQ2d 451 (Fed. Cir. 2023) [precedential]. The CAFC upheld the Board’s decision affirming a refusal to register the mark SPARK LIVING for “leasing of residential real estate; residential real estate listing; residential real estate service, namely, residential rental property management; specifically excludes commercial property and office space” (LIVING disclaimed). The Board found a likelihood of confusion with the registered mark SPARK for brokerage, leasing, and management of commercial property, offices, and office space. Appellant Charger challenged the Board’s factual findings on five *Du Pont* factors, but the CAFC ruled that the Board’s decision was supported by substantial evidence. Charger also charged the Board with failing to indicate the weight that it assigned to each *DuPont* factor, and therefore that its analysis lacked substantial evidence. The CAFC agreed that, for purposes of appellate review, the Board “must provide a reasonable explanation for its findings, explaining the weight to be assigned to the relevant factors.” However, an appellate court will “uphold a decision of less than ideal clarity if the agency’s path may reasonably be discerned.”

B. Trademark Trial and Appeal Board

1. Section 2(b) Governmental Insignia

County of Orange, 2022 USPQ2d 733 (TTAB 2022) [precedential]. Every few years, like clockwork, the Board decides a Section 2(b) case. This time it affirmed refusals to register the two proposed marks depicted here, for various governmental services (e.g., maintaining parks and libraries), on the ground that they constitute insignia of a governmental entity, i.e., a “municipality.” The Board rejected the argument that Orange County is not a municipality, as



* Counsel, Wolf, Greenfield & Sacks, P.C., Boston and New York City. Further discussion of each of these cases, and links to the opinions, may be found at The TTABlog at www.ttablog.com.

well as the argument that because Orange County already has an “official” seal, these designs cannot be insignia of the county. The Board took judicial notice of a definition of the term “municipality” as a “city, town, or other local political entity with the powers of self government.” Orange County acknowledged that the California Constitution provides that a county may have some such powers: for example, a county may make and enforce local ordinances, sue and be sued, levy and collect taxes, and adopt a charter. The Board therefore concluded that Orange County is a “municipality” for purposes of Section 2(b). The Board further found that the “prominent and repeated display of the proposed Circular Mark to denote traditional government records, functions, and facilities would reasonably lead members of the general public to perceive the proposed mark as an ‘insignia’ of Applicant within the meaning of Section 2(b) of the Trademark Act.”

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

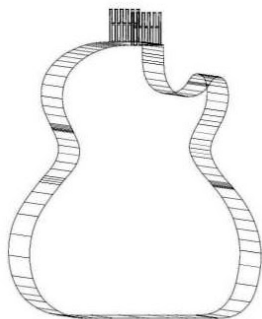
In re Zuma Array Ltd, 2020 USPQ2d 736 (TTAB 2022) [precedential]. Affirming a Section 2(e)(1) refusal to register the proposed mark SMART BEZEL, the Board found the term to be merely descriptive of electronic sensor modules for controlling and integrating home automation systems, lighting systems, and smart heating systems [SMART disclaimed]. Applicant Zuma Array contended that its goods are not bezels and so the mark cannot describe the goods. The Board, however, found the mark to be descriptive of a use or purpose of the modules, and thus ineligible for registration without proof of acquired distinctiveness. Zuma acknowledged that “smart” is defined as “using a built in microprocessor” and the word “bezel” refers to “the outer frame of a computer screen, mobile phone or other electronic device.” However, it asserted, “none of the applied for goods . . . feature a ‘bezel’ at all.” The Board observed that a proposed mark that describes the intended use or purpose of the goods with which it is used is merely descriptive. Zuma’s own website “demonstrates that a consumer would immediately understand the intended meaning of” SMART BEZEL for electronic sensor modules, *N.C. Lottery*, 123 USPQ2d at 1710, namely, that the modules are used to create a ‘smart bezel.’”

In re NextGen Management, LLC, 203 USPQ2d 14 (TTAB 2023) [precedential]. In a soporific precedential decision, the Board affirmed a Section 2(e)(1) refusal to register the proposed mark DXPORTAL, finding the mark to be merely descriptive of “providing an Internet website portal in the healthcare field to provide a patient and caregivers with the patient’s drug prescription information.” Dictionary definitions of DX (a common abbreviation for “diagnostic”) and of “portal,” information on applicant’s and third-party websites, and applicant’s acknowledged intention to offer diagnostic services in connection with the mark, led the Board to conclude that consumers would immediately understand that the mark “identifies a portal that will also link them with diagnostic information, specifically the diagnosis relied upon by the healthcare provider who wrote the drug prescription.” NextGen argued that, although it “does intend (in the future) to include limited diagnostic information on the portal, the storing of diagnostic information is not the focus of the portal, nor is it recited in the description of services of the mark.” However, NextGen’s website demonstrated that providing diagnostic information is an “integral part of Applicant’s website relating to drug prescriptions, even if it is not the

paramount aspect.” Moreover, third-party webpages “illustrate how diagnostic information and therapeutic solutions, such as prescription drugs, are integral to each other.”

3. Inherent and Acquired Distinctiveness

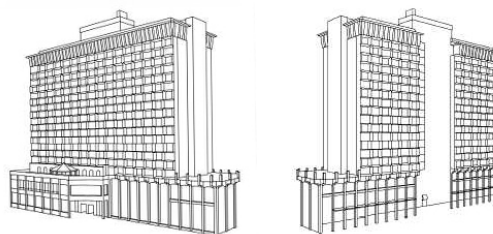
In re Seminole Tribe of Florida, 2023 USPQ2d 631 (TTAB 2023) [precedential]. The Board reversed a refusal to register “trade dress consisting of a three-dimensional building in the shape of a guitar” for “casinos” and “hotel, restaurant and bar services.” It found the mark to be “tertium quid” akin to product packaging and thus eligible for registration without proof of



acquired distinctiveness. The Board looked to decisions that analyzed the inherent distinctiveness of trade dress used with a variety of services, not just building designs: the “Cuffs and Collars” costume in *Chippendales* and the monster truck design in *Frankish*. Focusing on the uniqueness of the Tribe’s building design in the relevant industry, it concluded that applicant’s design is inherently distinctive for the Tribe’s services. The Board’s conclusion was “further supported” by the *Seabrook* test for inherent distinctiveness. “We find that Applicant’s Mark is not a common design; rather, it is unique, and not a mere refinement of a commonly-adopted and well-known form of

ornamentation for Applicant’s Services. Given the uniqueness of Applicant’s three-dimensional Guitar Design trade dress as applied to Applicant’s Services, we find Applicant’s Mark is of a type that consumers would immediately rely on to differentiate Applicant’s Services from casinos or hotel, restaurant, and bar services offered by others, and that it therefore constitutes inherently distinctive trade dress.”

In re Palacio Del Rio, Inc., 203 USPQ2d 630 (TTAB 2023) [precedential]. The Board upheld the USPTO’s refusals to register the two proposed marks shown here, comprising the three-dimensional configuration of the front and back of a hotel building, for “hotel services; provision of conference, exhibition, and meeting facilities,” finding that the building designs are not inherently distinctive and lack secondary meaning. Applicant failed to overcome the evidence that the proposed marks “constitute the ‘common’ basic design elements of hotel buildings façades (e.g., grid-like hotel rooms, smooth column, outwardly extending crown, and arches); they are not unique or unusual in the hotel field, and they are mere refinements of commonly-adopted and well-known forms of ornamentation for hotel buildings that would be viewed by the public ‘as a dress or ornamentation’ for Applicant’s hotel services.” Applicant’s evidence of acquired distinctiveness likewise fell short: it provided no evidence of look-for advertising, unsolicited media coverage, copying by third parties, or consumer association of the designs with applicant, and its sales data lacked industry context.



4. Failure-to-Function

In re Pound Law, LLC, 2022 USPQ2d 1062 (TTAB 2022) [precedential]. Affirming a refusal to register the proposed mark #LAW for legal referral services, the Board found that the term, as used on Applicant Pound Law’s specimens of use, fails to function as a source indicator. Instead, the Board found that #LAW, a vanity phone number, would be perceived by consumers as merely informational. Citing numerous examples from advertising materials of other law firms, the Board found that #LAW is commonly used as a hashtag in the legal field, including by the applicant’s licensee, Morgan & Morgan. Pound Law argued that the Board has long recognized the registrability of mnemonic telephone numbers, but the Board pointed out that the new versions of vanity phone numbers “present a somewhat different situation than traditional alphanumeric numbers.” The different “formation” of these new vanity numbers “impacts perception and distinguishes them” from traditional numbers. Turning to the applicant’s own use of #LAW, multimedia files and website excerpts presented #LAW “as a mnemonic for the telephone number #529, by which prospective clients may contact a lawyer at Morgan & Morgan law firm, not as a source indicator for legal or legal referral services.”

In re Brunetti, 2022 USPQ2d 764 (TTAB 2022) [precedential]. Erik Brunetti, famous in the trademark world for knocking the scandalous and immoral provision of Section 2(a) out of the Trademark Act, returned to the TTAB in this battle over the proposed mark FUCK for phone cases, jewelry, bags, and retail store services. The Board affirmed each of four refusals to register on the ground that FUCK fails to function as a trademark, concluding that the word “fuck” is in such widespread use that it does not create the commercial impression of a source indicator, but rather expresses well-recognized, familiar sentiments. The Board rejected Brunetti’s argument that the Supreme Court decision in the FUCT case requires reversal here, and it also rejected his claim of biased treatment by the Board. The failure-to-function refusal was rather straightforward. The evidence established the ubiquity of the word “fuck” in general, and the widespread use of the word for various consumer goods. The Board pointed out that the Supreme Court’s decision in *Iancu v. Brunetti* concerned only Section 2(a)’s prohibition of registration of marks containing scandalous matter, not the issue of failure-to-function. Applicant Brunetti provided no evidence that “plausibly suggests the USPTO maintains any bias against him . . . or is motivated by his exercise of his first amendment rights.”

In re Lizzo LLC, 2023 USPQ2d 139 (TTAB 2023) [precedential]. Attempts to register common slogans, internet memes, and informational material regularly hit the failure-to-function wall at the USPTO. But the Office has the burden of proof, and here its evidence fell short with regard to two refusals of the mark 100% THAT BITCH for certain clothing items, including t-shirts and baseball hats. The Board concluded that the evidence failed to show the proposed mark to be a common expression in such widespread use that it fails to function as a mark for the identified goods. Lizzo LLC is the trademark holding company of the popular singer and performer known as Lizzo. The proposed mark was inspired by a lyric in Lizzo’s song, “Truth Hurts.” The examining attorney maintained that 100% THAT BITCH “is a commonplace expression widely used by a variety of sources to convey an ordinary, familiar, well-recognized sentiment.” Lizzo and the examining attorney agreed that 100% THAT BITCH conveys a feeling of female strength, empowerment and independence. “But more importantly, considering the

entirety of the record, we find that most consumers would perceive 100% THAT BITCH used on the goods in the application as associated with Lizzo rather than as a commonplace expression.”

5. Genericness

In re Uman Diagnostics AB, 2023 USPQ2d 191 (TTAB 2023) [precedential]. In another “key aspect” genericness case, the Board upheld a refusal to register the proposed mark NF-LIGHT for “specimen analysis kits containing reagents and assays for detecting neurological biomarkers in biological samples, serum, blood, plasma, saliva, and cerebrospinal fluid in human and animal samples used by medical and clinical researchers in labs and institutions,” finding the term to be generic for the goods. The Board first found that Applicant’s ELISA kits are “a subset of the broad genus of goods identified in the application, and neurofilament light – the particular ‘neurological biomarker’ detected by applicant’s kit – is a subcategory and key aspect of the genus.” Then it found that the relevant consumers of the goods (clinical and medical researchers) understand “NF-Light” as substantially synonymous with, and a reference to, neurofilament light. Applicant argued that the USPTO failed to meet its burden of proving that the proposed mark is generic by clear evidence because there was a “mixed record” of usage – i.e., generic usage as well as proper trademark use. The Board was unimpressed, applying a preponderance of the evidence standard and rejecting the “mixed record” assertion.

In re International Fruit Genetics, LLC, 2022 USPQ2d 1119 (TTAB 2022) [precedential]. In a decision of importance only to those few trademark practitioners who labor in the varietal plant field, the Board affirmed a refusal to register the proposed mark IFG for, *inter alia*, live plants, holding that “proposed marks that constitute the prominent portion of a varietal denomination are unregistrable under Trademark Act Sections 1, 2, and 45 because they are generic for the varieties they identify” and therefore “incapable of functioning as a trademark.” In *In re Pennington Seed Co.*, the CAFC upheld the USPTO’s long-standing precedent and practice of treating varietal names as generic. The Board was faced with three questions: (1) is the prominent portion of a varietal name barred from registration under Trademark Act Sections 1, 2, and 45 because varietal names are the equivalent of generic designations; (2) if so, does the record show that IFG is a prominent portion of the varietal names of record for the identified goods; and (3) does this constitute an absolute bar to registration given the applicant’s prior valid and subsisting trademark registration of the same mark for ‘Live plants, namely, table grape vines, cherry trees’ where said registration issued prior to the application filing dates of any of the plant patents or plant breeder’s rights (i.e., PVP certificates under U.S. law) and purported prior trademark use?” The Board answered the three questions in the affirmative.

6. Goods in Trade

In re The New York Times Co., 2023 USPQ2d 392 (TTAB 2023) [precedential]. In six consolidated appeals, the Board reversed refusals to register the marks THE NEW OLD AGE, GOOD APPETITE, HUNGRY CITY, WORK FRIEND, LIKE A BOSS, and OFF THE SHELF for “columns” on the subjects of business, office, money, careers, and worklife balance, rejecting the USPTO’s position that each mark identifies only “individual portions of [A]pplicant’s

publications” and does not identify “separate goods in trade.” The Board concluded that, in light of changes in the marketplace for the delivery of news (i.e., the Internet), a new test is required for the registrability of non-syndicated columns or sections in printed publications or recorded media, and under that new test the subject columns qualified as goods in trade. The Board found that the *New York Times* columns are not merely a “conduit or necessary tool” to obtain its primary goods; that each individual print column is not so inextricably tied to or associated with *Times* print edition as to have no viable existence apart from the print edition as a whole; and that the columns possess independent value separate and apart from the newspaper as a whole, noting that consumers may look for and search for the name of the column and then separately read that column.

7. Illegal Use

In re National Concessions Group, Inc., 2023 USPQ2d 527 (TTAB 2023)

[precedential]. The Board upheld refusals to register the marks BAKKED (in standard characters) and a stylized drop design for “essential oil dispenser, sold empty, for domestic use,” finding that the goods are illegal drug paraphernalia under the Controlled Substances Act (CSA), and therefore the marks are ineligible for registration. The evidence “amply supports a finding” that applicant’s essential oil dispenser ‘primarily is intended or designed for use in connection with preparing, inhaling or introducing marijuana into the human body via ‘dabbing.’“ The next question was whether applicant’s goods qualify for an exemption under the CSA. Section 863(f)(1) exempts “any person authorized by local, State, or Federal law to manufacture, possess, or distribute such items,” and Section 863(f)(2) exempts “any item that ... [is] traditionally intended for use with tobacco products, including any pipe, paper, or accessory.” The Board ruled that applicant was entitled to neither exemption. As to the first, it held that “when a Section 863(f)(1) exemption is applicable based on state law, that exemption does not support federal registration.” As to the second, applicant failed to convince the Board that its products are traditionally intended for lawful products.



8. Use of Collective Membership Mark

In re Mission America Coalition, 2023 USPQ2d 228 (TTAB 2023) **[precedential]**.

Section 4 of the Trademark Act provides for registration of a collective membership mark, defined as a trademark or service mark adopted by a collective and used by members to indicate membership in the collective. Mission American Coalition sought to register the mark THE TABLE COALITION “to indicate membership in a group of church leaders, senior church members, ministers, independent evangelical preachers, and other evangelical principals to promote and support evangelistic activities.” Its specimen of use, however, failed to show use by members to indicate membership in the collective organization. Applicant’s specimen comprised a business card of its Director of Ministry. The Board agreed with the examining attorney that the business card is used by the organization itself, not by a member to indicate membership in the coalition. The record as a whole “suggests **Applicant’s** use of the TABLE COALITION as a service mark,” but it does not show use of the mark as a collective membership mark in

connection with the identified services. [Emphasis by the Board]. And so, the Board affirmed a refusal to register under Sections 1, 4, and 45 of the Act.

9. Prosecution Issues

a. Translation Requirement

In re Advanced New Technologies Co., 2023 USPQ2d 60 (TTAB 2023) [precedential]. Trademark Rule 2.32(a)(9) requires that any non-English wording in a proposed mark be translated into English. Advanced New Technologies applied to register the mark ZHIMA for hundreds of goods and services in nine classes, but it refused to comply with the Office’s requirement that it submit an English translation of the mark. Advanced advanced the argument that ZHIMA, although a transliteration of the Chinese characters for the word, is a coined term without any meaning. The Board sided with the USPTO. The examining attorney submitted translations of the Chinese characters (sometimes including the term “ZHIMA”) from nine Chinese-English dictionaries, as “sesame” or “sesame seed.” Advanced conceded that the dictionary evidence showed that the Chinese characters “transliterate or are pronounced ‘zhima,’” but argued that this evidence does not show that the term ZHIMA “is translated to the English word ‘sesame’ nor that ZHIMA has any meaning at all.” The Board, however, found that the evidence both established that “ZHIMA is a transliteration of a Chinese word that means ‘Sesame,’” and contradicted Advanced’s argument that ZHIMA is a “coined term.” In sum, ZHIMA “is used and recognized as the Chinese word for ‘Sesame’ and . . . Applicant has improperly refused to comply with the requirement to enter a translation statement.”

b. New Arguments for Refusal

In re Berkeley Lights, Inc., 2022 USPQ2d 1000 (TTAB 2022) [precedential]. The TTAB rejected Applicant Berkeley Lights’ quixotic request for reconsideration of the Board’s January 2022 decision affirming a Section 2(e)(1) mere descriptiveness refusal of DEEP OPTO PROFILING for various chemicals and for biochemical services. Berkeley claimed that the Board violated its Constitutional due process rights and the requirements of the Administrative Procedure Act, and failed to follow Board precedent by not affording Berkeley the benefit of the doubt on the issue at hand. In a detailed review of the record and the decision, the Board found no substantive or procedural error. It rejected Berkeley’s principal contention that the Board may not rely on “new arguments that the Examining Attorney never made” in reaching its decision. According to the TBMP, the Board “need not find that the examining attorney’s rationale was correct in order to affirm the refusal to register, but may rely on a different rationale.” Although the Board may not rely on an “additional” or “new ground” for refusal – i.e., a different statutory ground than in the final action under appeal – the Board did not adopt a new ground for refusal here. The Board pointed out that, in any case, Berkeley could have addressed the “new arguments” in this request for reconsideration, but did not. Accordingly, the Board found no lack of notice or lack of due process.

PART II. INTER PARTES CASES

A. United States Court of Appeals for the Federal Circuit

1. Section 2(d) Likelihood of Confusion

Bertini v. Apple Inc., 2023 USPQ2d 407 (Fed. Cir. 2023) [precedential]. The CAFC overturned the TTAB’s decision dismissing Charles Bertini’s Section 2(d) opposition to registration of APPLE MUSIC for a host of services, including the production and distribution of sound recordings and presentation of live music performances. The court ruled that the Board had erred in awarding priority to Apple (via tacking) over Bertini’s use of the common law mark APPLE JAZZ for live musical performances. On a question of first impression, the CAFC held that a trademark applicant cannot establish priority for every good or service in its application merely because it has priority through tacking for a single good or service listed in the application. The Board then observed that to establish tacking, Apple had to show that live performances are substantially identical to gramophone records sold under the mark APPLE by assignor Apple Corps prior to Bertini’s priority date. Apple failed to do so. “No reasonable person could conclude, based on the evidence of record, that gramophone records and live performances are substantially identical. Nothing in the record supports a finding that consumers would think Apple’s live musical performances are within the normal product evolution of Apple Corps’ gramophone records.”

B. Trademark Trial and Appeal Board

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

NPG Records, LLC and Paisley Park Enterprises, LLC v. JHO Intellectual Property Holdings LLC, 2022 USPQ2d 770 (TTAB 2022) [precedential]. Finding that the proposed mark PURPLE RAIN for dietary and nutritional supplements falsely suggests a connection with the famous musician and performer Prince, the Board granted opposers’ motion for summary judgment under Section 2(a) of the Trademark Act. The record contained “copious, un rebutted evidence of Prince’s fame among the general consuming public and his unique association with the words PURPLE RAIN.” Evidence of use of PURPLE RAIN by Prince included his album, a movie, and sales of a variety of consumer products under the mark. Survey results showed that 66.3% of the general public recognize PURPLE RAIN as a reference to Prince. The Board agreed with Opposers that “[b]ecause purchasers are accustomed to celebrity licensing, they may presume a connection with a celebrity even though the goods have no relation to the reason for the celebrity’s fame.” “If the applicant’s goods are of a type that consumers would associate . . . in some fashion with a sufficiently famous person or institution, then we may infer that purchasers of the goods or services would be misled into making a false connection with the named party.”

2. Section 2(c) Consent of Living Individual

Mystery Ranch, Ltd. v. Terminal Moraine Inc. dba Moraine Sales, 2022 USPQ2d 1151 (TTAB 2022) [precedential]. Section 2(c) inter partes proceedings are as rare as a traffic cop in Boston, but the Board gave the green light to Opposer Mystery Ranch in sustaining this opposition to registration of the mark DANA DESIGN in the form shown here, for backpacks, hiking equipment, tents, and related goods, on the ground that the mark comprises the name of a living individual, Dana Gleason, without his consent and is therefore barred from registration by Section 2(c) of the Trademark Act. The evidence established that, in the field of backpacks and hiking gear, “the name ‘Dana’ is recognized as a nickname for Dana Gleason.” However, the Board rejected Opposer Mystery Ranch, Ltd.’s Section 2(a) false connection claim because the opposed mark is not a close approximation of Mystery Ranch’s name or identity: “although consumers associate Dana Gleason and Mystery Ranch . . . they are not perceived as each other’s alter ego.” As to the Section 2(c) claim, the Board found Mystery Ranch to be in privity with Dana Gleason and therefore able to assert Gleason’s rights under Section 2(c) to prevent the use of his first name DANA without his written consent, despite the fact that Gleason had assigned his rights in the subject trademark.



3. Section 2(d) Likelihood of Confusion

a. Likelihood of Confusion Found

Monster Energy Co. v. Chun Hua Lo, 2023 USPQ2d 87 (TTAB 2023) [precedential]. Frequent TTAB litigant Monster Energy prevailed in this opposition to registration of the mark ICE MONSTER & Design for “restaurants, coffee shops, ices parlors, snack bars with take-out



for flavored and fruit ice products, and specifically excluding frozen yogurt” [ICE disclaimed]. The Board found the mark likely to cause confusion with the registered mark MONSTER ENERGY for restaurant services. Although the MONSTER ENERGY mark is famous for energy drinks, the Board rejected the opposer’s claim of fame as to restaurant services. However, the Board found the marks to be very similar, the services legally identical in part, and the trade channels and classes of consumers presumably the same. Applicant argued that Monster “uses its cafeteria mostly to feed its employees,” but the Board pointed out once again that the issue of likelihood of confusion must be decided on the basis of the recitation of services in the cited registration, regardless of actual marketplace usage. Comparing the marks, the Board found the “hyperbolic term” MONSTER to be dominant in both marks. Moreover, because Monster’s mark is registered in standard character form, it could be employed in the same color and stylization as the applicant’s mark.

Major League Baseball Players Ass’n and Aaron Judge v. Chisena, 2023 USPQ2d 444 (TTAB 2023) [precedential]. Applicant Michael Chisena went down swinging in this consolidated opposition to his applications to register the word marks ALL RISE and HERE COMES THE JUDGE and the design mark shown here, for t-shirts and the like. The Board found the proposed marks to be confusingly similar to the opposers’ previously used marks for overlapping goods. By the time Chisena had filed his intent-to-use applications, Aaron Judge had established himself as a star outfielder for the New York Yankees. Sports media, the Yankees, and Yankee fans had already adopted a “judicial theme” in promotional material, stadium signage, and various souvenir items referring to him: the phrases ALL RISE and HERE COMES THE JUDGE and depictions of “judicial indicia, such as a gavel, courthouse image, or the scales of justice,” accompanied by his name or likeness. The Board rejected various claims made by Chisena, finding that the opposers had “standing” to bring their claims, and that the opposers’ common law marks serve as trademarks and are not merely informational or ornamental because “the consuming public recognizes the subject slogans and symbols carrying judicial connotations as pointing to only one baseball player on one major league team, similar to the record in *In re Lizzo LLC*.”



b. Likelihood of Confusion Not Found

Shenzhen IVPS Technology Co. v. Fancy Pants Products, LLC, 2022 USPQ2d 1035 (TTAB 2022) [precedential]. You might say Applicant Fancy Pants relied on the old rope-a-dope strategy in this opposition to its application to register SMOKES & Design for “cigarettes containing tobacco substitutes not for medical purposes containing only cannabis with a delta-9 THC concentration of not more than 0.3% on a dry weight basis.” Opposer Shenzhen claimed likely confusion with its registered mark SMOK and several SMOK-formative marks for electronic cigarettes, parts and components thereof, and related services. Fancy Pants neither submitted testimony and evidence nor filed a brief, but the Board ruled in its favor. Shenzhen claimed to own a family of “SMOK” marks but failed to prove that the asserted family feature had acquired distinctiveness prior to Fancy Pants’s effective filing date. As to Shenzhen’s common law marks, its testimony was “too vague and nonspecific to associate use of any of the SMOK or SMOK-formative marks . . . with any particular goods or services or with any date of use.” As to Shenzhen’s registered mark SMOK, the dissimilarity of the marks and the weakness of the common element SMOK, together with the lack of proof that the trade channels overlap, required a finding of no likelihood of confusion.



DC Comics v. Cellular Nerd LLC, 2022 USPQ2d 1249 (TTAB 2022) [precedential].

The Board tossed out this opposition to registration of the word-and-design mark shown here, for “installation, maintenance and repair of cell phone related hardware,” finding no likelihood of confusion with, and no likelihood of dilution of, several “‘S’ shield” marks associated with the “Superman” character. The Board found the marks, goods/services, and trade channels too different for purposes of likelihood of confusion, and as to the dilution claim it deemed the difference between the marks to be fatal. The Board focused on three of DC Comics’ registered “S’



Shield” marks for entertainment services, comics, clothing, credit card services, and customer loyalty rebate programs. The Board found the term CELLULARNERD.com to be dominant in applicant’s mark, and further that the mark as a whole “creates the commercial impression of a tech nerd ready to solve your cell phone problems in his persona as a tech nerd, as opposed to the letter ‘S’ shield design marks symbolizing a specific superhero.” In sum, “consumers will not view the marks in their entireties as sufficiently similar to cause them to mistakenly believe there is an association with Opposer.

c. Priority

Narita Export LLC v. Adaptrend, Inc., 2022 USPQ2d 857 (TTAB 2022)

[precedential]. Granting Petitioner Narita Export’s motion for summary judgment, the Board unsurprisingly found the registered mark TONOSAMA for gift baskets containing candy to be confusingly similar to Narita’s identical common law mark for candy. The only real dispute concerned Narita’s priority of use, which hinged on the validity of a *nunc pro tunc* assignment and an oral agreement. Narita submitted declarations from its president and from the former president of the company that assigned the mark to Narita. They attested to the sale of the branded candy in the United States since March 27, 2016, and they confirmed the oral assignment. Respondent Adaptrend argued that the declarations constituted inadmissible hearsay and lacked foundation, but the Board found that the declarants were “positioned to know or have access to information relevant to the substance of their respective declarations and the assignment referenced therein.” The Board then made short work of the Section 2(d) claim. Adaptrend asserted a first use date of June 13, 2016. Narita’s declarations established a first use date of May 27, 2016. The marks are identical, the goods overlap, and it was undisputed that the goods travel in the same channels of trade.

JNF LLC v. Harwood Int’l Inc., 2022 USPQ2d 862 (TTAB 2022) [precedential].

Petitioner JNF LLC was undoubtedly unhappy with the result of its petition to cancel a registration for the mark HAPPIEST HOUR for bar and restaurant services. JNF claimed prior use of THE HAPPIEST HOUR for the identical services, but it failed to prove priority. Its evidence regarding its first rendering of services under the mark was “characterized by contradictions, inconsistencies, and indefiniteness.” Its claim of use analogous to trademark use failed because its prior publicity “was not sufficiently clear, widespread and repetitive.”

Normally, a cancellation petitioner must prove priority by a preponderance of the evidence, but when a party claims a first use date earlier than what it alleged in its application, “that is considered a change in position, contrary to the admission it made against interest at the time it filed the application; in these circumstances its proof of the earlier date must be clear and convincing.” With regard to analogous use, a party must show prior use sufficient to create an association in the minds of the purchasing public between the mark and the services. JNF’s evidence consisted of a Sept. 7, 2014 press release, a September 2, 2014 New York Times article, and an August 24, 2014 article at Grubstreet.com. The Board was unimpressed.

***Nkanginieme v. Appleton*, 2023 USPQ2d 277 (TTAB 2023) [precedential].** After the Board sustained Opposer Nnenna Lovette Nkanginieme’s Section 2(d) opposition to registration of the mark LOVETTE for handbags, the applicant requested reconsideration, contending that the Board improperly found that, because opposer obtained a registration for her pleaded mark and entered same into the record, priority was not at issue. The Board denied the reconsideration request, pointing out that, absent a petition for cancellation of the “pleaded and proven registration,” priority is not an issue in a Section 2(d) dispute. Opposer Nkanginieme filed her underlying application after Applicant Appleton had filed the application here opposed. Appleton contended it was error to allow Nkanginieme “to rely solely on a registration with a constructive priority date that postdates Applicant’s application by five months.” Nkanginieme pointed to Rule 2.106(b)(3)(ii), which states that “[a]n attack on the validity of a registration pleaded by an opposer will not be heard unless a counterclaim or separate petition is filed to seek the cancellation of such registration.” The Board pointed out that it did not make a determination of priority because Nkanginieme’s registration had removed priority as an issue. In short, the Board must consider existing registrations without regard to prior use, absent a petition for cancellation of the registration.

4. Abandonment

***Vans, Inc. v. Branded, LLC*, 2022 USPQ2d 742 (TTAB 2022) [precedential].** In an exhaustive and exhausting opinion, the Board granted petitions to cancel two registrations for the mark OLD SCHOOL for various clothing items, on the ground of abandonment. The Board found that the registrant, despite claiming attempts to sell or license the mark, had discontinued use of the mark with an intent not to resume use. The Board combed through the record evidence in great detail, noting that Branded “failed to introduce any credible documents showing use of the OLD SCHOOL mark to identify clothing or sale of clothing.” Nor was there any evidence of advertising. Branded’s testimony regarding use was unpersuasive because of its inconsistencies, contradictions, and unspecific nature. Petitioner Vans thus established nonuse of the mark since 2008, a period of more than three years and thus prima facie evidence of abandonment. Branded could not prove its intent to resume use of its mark on the basis of its intent to sell the mark, “especially where the evidence that it ‘used’ the mark at all is so vague, inconsistent and unreliable.” “[H]olding a mark with no use, with only an intent to sell the mark at some time in the future, is not proof of present use or intent to resume use.” Indeed, such an intent is evidence of “trafficking in trademarks,” which the Trademark Act seeks to prevent by deeming such an assignment invalid and the involved application or registration void.

ARSA Distributing, Inc. v. Salud Natural Mexicana S.A. de C.V., 2022 USPQ2d 887 (TTAB 2022) [precedential]. Finding Applicant Salud’s long period of nonuse of its mark EUCALIN for nutritional supplements to be excusable, the Board dismissed this Section 2(d) opposition because Opposer ARSA Distributing was unable to prove priority. Salud, deemed a Specially Designated Narcotics Trafficker (SDNT), was banned from doing business in the United States from 2008 to 2015. Although it did not resume use of the mark for another seven years, Salud did commence TTAB litigation with ARSA in 2016 regarding ownership of the mark. ARSA established a presumptive *prima facie* case of abandonment based on Salud’s admitted nonuse of the mark during any three-year period between 2008 and 2015. The Board, however, ruled that Salud’s nonuse during the ban was excusable and further that Salud maintained an intent to resume use after 2016, negating the presumption of abandonment arising from its nonuse during that later period. “This is not a case where Applicant decided to cease use of its mark for business reasons. Rather, Applicant had no choice but to cease use of its mark because its use was prohibited by government sanctions . . .” Salud’s “vigorous defense” of this opposition also supported a finding that it maintained an intent to resume use throughout the litigation.

5. Nonuse

Fender Musical Instruments Corp. v. Win-D-Fender, LLC, 2023 USPQ2d 61 (TTAB 2023) [precedential]. The Board re-designated as precedential its decision sustaining guitar-maker Fender’s opposition to registration of the mark END-D-FENDER for “musical instruments,” on the ground of nonuse. The Board rejected Applicant Win-De-Fender’s Hail Mary motion to amend its identification of goods to “musical instrument accessories, namely, an ambient wind foot joint guard for flute family instruments,” because the amended goods exceeded the scope of the original identification. Win-De-Fender argued that its application was “qualified” by a “miscellaneous statement” entered on the TEAS application form, stating: “For Musical Instrument Accessories namely a wind guard mounted to a flute.” Unfortunately, that limiting language was not included in the proper field on the form and therefore it was not considered a part of the identification of goods. Because accessories are not musical instruments, they are not encompassed within the original identification of goods, and so the Board denied the motion to amend. As to Fenders nonuse claim, Win-De-Fender’s interrogatory answers supported Fender: “Applicant states the products sold under the ‘En-D-Fender’ mark are not musical instruments, as such products are accessories for a flute.” The Board then wasted no time in granting Fender’s partial summary judgment.

6. Ownership

CBC Mortgage Agency v. TMRR, LLC, 2022 USPQ2d 748 (TTAB 2022) [precedential]. The Board granted a petition for cancellation of a registration for the mark shown here for mortgage financing services, finding that Petitioner CBC Mortgage was the first and only user of the mark for those services. Respondent TMRR created and promoted the mark but it did not use the mark in rendering mortgage services, nor was it permitted to do so by the



agreement between the parties. TMRR conceived of a mortgage financing program that would be run by a Native American Tribe, and it contracted with the Paiute Indian Tribe of Utah (CBC) to implement and operate the program. TMRR created the mark CHENOA FUND and the logo. In 2013 the parties signed a Management Services Agreement (MSA) to provide the program, and Petitioner CBC Mortgage was formed pursuant to the MSA. Under the MSA, TMRR is deemed CBC's "agent" and "contracted day-to-day operator." The Board found that the agreement between the parties unambiguously established the intent and expectation of the parties that CBC would solely own the CHENOA FUND mark. Furthermore, TMRR "operates behind the scenes, out of public view," while CBC Mortgage is "out front, engaging with the public via materials that identify Petitioner, and only Petitioner, as the source of the mortgage financing services rendered in connection with the CHENOA FUND mark."

7. Procedural Issues

a. Entitlement to a Statutory Cause of Action

PepsiCo, Inc. v. Arriera Foods LLC, 2022 USPQ2d 856 (TTAB 2022). In this opposition to registration of the mark TORTRIX for "corn-based snack foods," the Board ruled that a claim for misrepresentation of source under Section 14(3) of the Trademark Act is available not just to a cancellation petitioner, but also to an opposer. However, it dismissed Opposer PepsiCo's Section 14(3) claim due to the insufficiency of its allegations. A plaintiff may plead "entitlement based on reputational injury or lost sales provided that the plaintiff establishes a reputational interest in the United States." PepsiCo did not plead lost sales but did claim injury to its reputation in the United States, and further claimed that it will not be able to register its TORTRIX mark in this country if the opposed application matures to registration. It alleged that it has used the mark TORTRIX for years in Central and South America for corn-based snack foods, and owns several registrations for that mark in a number of countries. The Board found that PepsiCo had failed to plead "a plausible entitlement to relief." PepsiCo's allegations that Arriera "intends to make, or is making, blatant misuse" of the TORTRIX mark were mere speculation.

Ahal Al-Sara Group for Trading v. American Flash, Inc., 2023 USPQ2d 79 (TTAB 2023) [precedential]. The requirement that a plaintiff in a TTAB proceeding plead and prove its entitlement to a statutory cause of action (formerly called "standing") is a low threshold, but a critical one. Petitioner Ahal Al-Sara Group sought cancellation of a registration for the mark shown here for various cleaning products, claiming abandonment and fraud, but it failed to identify an interest that falls within the "zone of interests of the Trademark Act" and thus failed to sufficiently plead its entitlement to a statutory cause of action. A plaintiff must plead facts that, if proved, demonstrate a "real interest" that affects U.S. commerce. Here, the petition relied only on challenges to petitioner's foreign marks in foreign proceedings. "Petitioner has not pleaded a presence in the United States. Petitioner does not contend that its interests involve selling or manufacturing goods within the United States, and Petitioner has not filed any U.S. trademark applications to register FIGHTER FLASH or AMERICAN FLASH or any variations thereof.



Nor does Petitioner plead an intent to enter the U.S. market in the future, or any other facts that if proved, would demonstrate an interest related to or affecting U.S. commerce falling within the scope of protection under the Trademark Act.”

Curtin v. United Trademark Holdings, Inc., 2023 USPQ2d 535 (TTAB 2023)

[precedential]. Unsurprisingly, the Board dismissed Professor Rebecca Curtin’s opposition to registration of the mark RAPUNZEL for dolls and toy figures, finding that Curtin, as a mere consumer of fairytale-themed products, failed to prove her entitlement to a statutory cause of action. “A plaintiff may oppose registration of a mark when doing so is within the zone of interests protected by the statute and she has a reasonable belief in damage that would be proximately caused by registration of the mark.” In *Lexmark*, the Supreme Court pointed out that “[i]dentifying the [zone of] interests protected by” the Trademark Act “requires no guesswork.” Section 45 of the Act identifies those interests: in short, the Trademark Act “regulates commerce and protects plaintiffs with commercial interests.” “In addition to satisfying the “zone of interests” requirement, Curtin had to show “economic or reputational injury flowing directly from” Applicant’s registration of RAPUNZEL. Here, Curtin’s evidence of the damage she would allegedly suffer was “too remote from registration and is entirely speculative.” Furthermore, the Board pointed out, “registration would at most preclude others from using RAPUNZEL as their own source indicator for such products, subject to defenses such as 15 U.S.C. § 1115(b)(4) (creating a defense to infringement where the ‘term or device ... is descriptive of and used fairly and in good faith only to describe the goods and services of such party’).

b. Claim Preclusion

Flame & Wax, Inc. v. Laguna Candles, LLC, 2022 USPQ2d 714 (TTAB 2022)

[precedential]. Petitioner Flame & Wax found itself on the short end of the candlestick when the Board denied its petition for cancellation of a registration for the mark LAGUNA CANDLES for “aromatherapy candles; candles; scented candles,” finding that the mark had acquired distinctiveness and therefore was not primarily geographically descriptive of the goods. The Board rejected petitioner’s invocation of the doctrine of claim preclusion based on its earlier successful opposition to respondent’s prior application to register the same mark, finding that this cancellation proceeding involved a different set of transactional facts. In 2013, the TTAB sustained Flame & Wax’s opposition to the same mark for candles on the ground of geographical descriptiveness. Four months later, respondent filed a new application, claiming acquired distinctiveness under Section 2(f). The Board found no case in which an applicant claimed acquired distinctiveness in a second application filed only four months after a successful opposition. Nonetheless, the Board ruled that additional evidence “establish[ed] a recognizable change of circumstances from the time of trial in the Prior Opposition and the time of trial in the cancellation.”

c. Issue Preclusion

Empresa Cubana Del Tabaco d.b.a. Cubatabaco v. General Cigar Co., Inc., 2022

USPQ2d 1242 (TTAB 2022) [precedential]. In the latest round of this 25-year-old battle, the Board granted a petition for cancellation of two registrations for the mark COHIBA for “cigars,”

on the ground of violation of Article 8 of the Pan American Convention. The evidence showed that Petitioner Cubatabaco enjoyed legal protection of the COHIBA mark in Cuba prior to General Cigar’s constructive first use date in the United States, and that General Cigar had knowledge of Cubatabaco’s use of the mark in Cuba prior to filing its underlying applications. The issue, then, was whether the Article 8 claim was barred under the doctrine of issue preclusion in light of the past federal court litigation between the parties. The Board said no. The CAFC had already held (in 2014) that the issue decided in the litigation—whether § 44(h) of the Act incorporated Article 8 claims—is not the same as the Article 8 issue here, and therefore issue preclusion was inapplicable. General Cigar argued that the Supreme Court’s subsequent ruling in *B&B Hardware v. Hargis* effected a change in the law that permitted another review of the preclusion question. The Board, however, was not persuaded that *B&B Hardware* changed the law. Moreover, that case “addressed an entirely different issue: ‘whether the District Court in this case should have applied issue preclusion to the [Board’s] decision,’ . . . not vice versa.”

d. Correction of Ownership

Phat Scooters, Inc. v. Fatbear Scooters, LLC, Isaac Ashkenazie and Isaac D. Ashkenazie d/b/a Fatbear Scooters, 2023 USPQ2d 486 (TTAB 2023) [precedential]. The underlying application for the registered mark FAT BEAR for motor scooters was filed in the name of Fatbear Scooters, LLC on December 19, 2019, but that entity did not exist as of the filing date. Petitioner Phat Scooters moved for partial summary judgment on its claim that the registration is void ab initio because the application was not filed by the rightful owner of the mark. In response, one of the co-owners confirmed that the belated incorporation was due to an “oversight,” but they intended to create the entity at the same time the application was filed. He further averred that he and his cousin started the business in about November 2019, that it has continued to the present under the same ownership, and that no other entity has owned or used the FAT BEAR mark. The Board construed the response to the summary judgment as a “cross-motion to amend the registrations due to a correctable owner’s mistake.” The Board found that chain of title in the same, single commercial enterprise existed between the LLC and the co-owners (d/b/a Fatbear Scooters), and it allowed the respondent to correct the misidentification because the error was “inadvertent, made in good faith, and has been formalized through the filing of and issuance of the limited liability certificate.

e. Sanction for Spoliation

Rapid Inc. v. Hungry Marketplace, Inc., 2022 USPQ2d 678 (TTAB 2022) [precedential]. Finding that Opposer Rapid Inc.’s star witness “had not only been dishonest with the Board, but . . . also engaged in spoliation of evidence,” the Board threw out this Section 2(d) opposition. Rapid claimed priority of use of its mark HUNGR for food ordering application software, and likelihood of confusion with applicant’s proposed mark HUNGRY for overlapping software. Rapid’s witness “engaged in a pattern of fabrication and spoliation of evidence, which vitiates the probative effect of his testimony and evidence, and taints the remainder of evidence that might otherwise indirectly support Opposer’s claim of priority.” Invoking the legal maxim “*falsus in uno, falsus in omnibus*” (false in one thing, false in everything), the Board looked askance at his remaining testimony. Furthermore, the Board found that Opposer’s third-party

witnesses, “while perhaps intending to testify truthfully about the dates on which they purportedly first used or became familiar with Opposer’s HUNGR app, merely signed the declarations based on the advice of or their relationship with the ‘star witness’ without having any independent recollection of the specific dates to which they testified.” Unable to prove priority, Rapid’s claim failed.

f. Unpleaded Claim

Kimberley Kampers IP Pty Ltd v. Safiery Pty Ltd, 2022 USPQ2d 1036 (TTAB 2022) [precedential]. In seeking cancellation of a registration for the mark KIMBERLEY KAMPERS for campers, the petitioner moved for summary judgment on the grounds of non-ownership and abandonment, but it failed to meet its initial burden to make a prima facie case. The Board therefore denied the motion as to those grounds, but in light of the petitioner’s evidence regarding nonuse during the three-year statutory abandonment period, the Board chose to consider nonuse (though unpleaded) as a separate ground for summary judgment, and it set a schedule for briefing that issue. Petitioner claimed that it could meet its initial burden to prove a prima facie case “by showing that there is an absence of evidence supporting the nonmoving party’s case.” Wrong, said the Board. “[W]here, as here, ‘the *moving* party will bear the burden of persuasion at trial, that party must support its motion with credible evidence—using any of the materials specified in [Fed. R. Civ. P.] 56(c)—that would entitle it to a directed verdict if not controverted at trial.’” (Emphasis by the Board). Here, Petitioner failed to meet its burden of production on either claim. The Board observed that it is not its practice to consider an unpleaded claim on summary judgment, but in this “unusual situation” it chose to do so, finding that Petitioner’s allegations of abandonment were sufficient to put the respondent on notice of the issue of nonuse.

g. Explanation for Abandonment

Rifai (Shenzhen) Smart Technology Co. v. Shenzhen Chengyan Science and Technology Co., 2022 USPQ2d 1035 (TTAB 2022) [precedential]. After the commencement of this proceeding for cancellation of a registration for the mark DISO for various electronic devices, on the grounds of fraud and abandonment, the registration was subject to a USPTO audit regarding respondent’s Section 8 Declaration of Use. The audit resulted in deletion of many of the identified goods. The Board observed that a registrant may not, by deleting goods from a registration, moot a proceeding to avoid a judgment as to the deleted goods. It allowed respondent twenty days to explain the reason for its deletions. Trademark Rule 2.134(b) applies when a respondent permits its registration to be cancelled under Section 8 during the pendency of a cancellation proceeding. Here, only certain goods were deleted from the registration. The Board held that Rule 2.134(b) still applied: “by deleting certain goods subject to this cancellation, Respondent may not moot this proceeding and avoid judgment as to the deleted goods. As set forth in TBMP § 602.02(b), we require Respondent’s response regarding the deletion of goods as it relates to abandonment.” Depending on respondent’s explanation, the Board may or may not enter judgment as to the deleted goods.

h. Page Limit for ACR Brief

Rasa Vineyards, LLC v. Rasasvada, LLC, 2022 USPQ2d 769 (TTAB 2022). The Board dubiously re-designated as precedential an interlocutory order in this Section 2(d) opposition involving the mark RASASVADA for alcohol and spirits. The parties had stipulated to proceed under the Accelerated Case Resolution (ACR) regime. When applicant filed a 41-page brief (including table of contents), opposer moved to strike. Facing the Board was the question of whether the normal 55-page final brief limit of Rule 2.128(b) applied, or whether the summary judgment limit of 25 pages applied (Rule 2.127(a)). The parties had agreed to submission of the case “through ACR briefing in a cross-motion for summary judgment format,” and therefore the Board said the latter Rule applied: “The parties clearly stipulated to submission of their briefs in summary judgment format and the page limits of a motion for summary judgment apply.” The Board granted opposer’s motion to strike the brief as “overlength,” but it allowed applicant one day to re-submit a brief limited to 25 pages, and applicant did so.

i. Timeliness of Discovery Requests

OMS Investments, Inc. v. Habit Horticulture LLC, 2012 USPQ2d 1074 (TTAB 2022) [precedential]. In another questionably precedential Order, the Board ruled on several discovery-related motions in this opposition to registration of the mark GROMEEO for “Planters for flowers and plants; Self-watering planters for flowers and plants.” Applicant Habit moved to compel a deposition and to extend its time to respond to OMS’s discovery requests. First the Board rejected opposer’s claim that Habit’s reply brief was untimely, but it then denied Habit’s motion to compel because it was filed prematurely (OMS had not “clearly or unequivocally stated that it would not designate or produce a witness for the noticed deposition”) and because Habit failed to make the required good faith effort to resolve the dispute prior to filing its motion. The Board then denied Habit’s motion to extend the time for responding to OMS’s discovery requests. Habit contended that it should not have to respond to the requests until after the Rule 30(b)(6) deposition of Habit in order to “maintain the status quo,” – i.e., Habit noticed its deposition first. The Board rejected that argument because discovery is not governed by the concept of priority and one party’s discovery obligations are independent of the actions of the other party.

– Finis –