

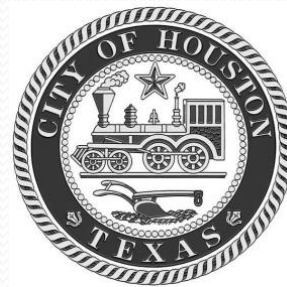
RECENT TTAB CASES

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MARKS CONSISTING OF OFFICIAL INSIGNIA

In re The Government of the District of Columbia and In re City of Houston

- In two separate cases, the District of Columbia and the City of Houston applied to register their official seals:



In re Gov't of the Dist. of Columbia and City of Houston

- The examiners in both cases refused registration on the basis that Section 2(b) prohibits registration of these marks
- Section 2(b) prohibits registration of a mark that :
 - Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

In re Gov't of the Dist. of Columbia and City of Houston

- On appeal to the TTAB, the Board affirmed the refusals in both cases, noting that the statute has no exception for governmental entities seeking to register their own insignia
- In a combined decision from the Federal Circuit, the Court held that the language of the statute was clear and while the applicants may not feel the statute makes sense, the Court is not the proper forum for rewriting Congressional acts.

In re Pohl-Boskamp GmbH

- Applicant applied to register sensory marks for “medicines, namely pharmaceutical formulations of nitroglycerin” – one was for the distinctive flavor of peppermint and the other was a peppermint scent
- Product is nitroglycerin in a spray bottle for acute relief of an angina attack – examiner refused both marks on the basis that they didn’t function as a trademark and on the flavor mark, that it was functional

In re Pohl-Boskamp GmbH

- Functionality of the flavor mark – nitroglycerin is odorless and tasteless so peppermint didn't perform the function of masking taste. Peppermint oil listed as an inactive ingredient so no pharmaceutical effectiveness function
- Examiner argued that herbal medicines use peppermint oil as a vasodilator – Board gave this little weight – not pharmaceutical preparations
- Other medications for angina contain peppermint flavor – language in a patent showed peppermint oil reduces common side effects like headache and fainting – Board agreed the peppermint flavor was functional.

In re Pohl-Boskamp GmbH

- Whether they function as trademarks – flavor and scent can never be inherently distinctive so secondary meaning is required. Use since 1989 and submitted 23 declarations from physicians and pharmacists
- The declarations were almost identical in form which impacted their probative weight
- The fact that there were similar products that were peppermint flavored and scented reinforced the consumer perception that these were physical attributes rather than source indicators.

LIKELIHOOD OF CONFUSION

In re Cook Medical Technologies, LLC

- Applicant filed to register the color teal for guiding sheaths for use with access needles and guides used in vascular and non-vascular procedures
- Refused based on three registrations owned by another party for the color blue for catheters – teal and blue are legally identical and the products are complimentary – catheters are used with sheaths
- On appeal – goods are closely related and registrant's blue was not limited to a particular shade

In re Cook Medical Technologies, LLC

- Applicant's argument that it used its mark contemporaneously with the registrant for over 18 years is entitled to little weight in an ex parte proceeding
- Board noted that the applicant could have sought a consent from the owner of the cited registrations or sought a restriction of the registrations to the actual shade of blue used for their products

Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.

- Applicant filed for this mark for fortified water, mineral water:



- Opposer owned GOTT and JOEL GOTT (word marks) covering wine – sales over \$73 million and use since 2006
- Priority was established so only issue is likelihood of confusion

Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.

- Board found marks to be similar – applicant's design is insignificant and GOTT is the dominant portion
- Goods do not have to be identical or even competitive to be related – evidence showed that wine and water are related goods
- Applicant intended to market its goods in similar retail markets as opposer's goods and goods would be sold in the same areas of those stores
- Likelihood of confusion found

Great Seats, Inc. v. Great Seats, Ltd.

- Great Seats, Ltd. applied in 1999 for GREAT SEATS for arranging for ticket reservations – based on use since 1992 with 2(f) claim
- Great Seats, Inc. claimed prior use
- Only issue was priority since likelihood of confusion was a given
- Inc. had use since 1995 for the services but claimed that its principal, Mr. Matta has been known as “Great Seats” since 1980 – argument is this is analogous use to trademark usage

Great Seats, Inc. v. Great Seats, Ltd.

- Analogous use is use that creates a public awareness that the designation serves as a trademark and identifies the party as the source
- No documents supported use prior to 1995 – wasn't clear if the term was identifying Mr. Matta or as a person to go to in order to get “great seats”
- Different from VW “bug” case – advertising and references in news media supported analogous trademark use
- Opposer could not prevail in establishing priority

Inter IKEA Systems v. Akea, LLC

- Applicant applied for AKEA for nutritional supplements in Class 5 and providing advice and information to consumers regarding lifestyle topics, namely diet planning, nutrition, nutritional supplements and gardening (ITU app)
- IKEA opposed on likelihood of confusion and dilution
- Board found IKEA famous for purposes of likelihood of confusion for retail stores in the field of furniture and home furnishings but not for restaurant services or other specific food products

Inter IKEA Systems v. Akea, LLC

- Marks have the same number of letters, both begin with a vowel and end in KEA – both are coined words and have a similar commercial impression
- IKEA is registered for retail store services and a wide variety of goods and services – food products and educational services in the field of personnel management and personal development
- There was not enough evidence that those services and goods were related to the Class 5 goods but IKEA's educational services were related to the Class 35 services so the opposition was granted as to those services

Weider Publications v. D&D Beauty Care

- Applicant applied for the mark SHAPES for beauty salon services, health spa services and cosmetic body care services (ITU app)
- Weider publishes SHAPE magazine and opposed
- Opposer's audience for the magazine is about 6 million people each month, mostly women
- Opposer sponsors live events under its SHAPE mark involving make-up touchups, dry hair styling, manicures, etc.

Weider Publications v. D&D Beauty Care

- Applicant has a registration for SHAPES BROW BAR used since 2007 for beauty salons, cosmetology services and eyebrow threading services – used since 2007 in 62 locations around the US
- Applicant has had gross sales of about 40 million since 2009
- Opposer claimed likelihood of confusion
- Fame for likelihood of confusion does not require opposer to show fame among every segment of the US population – only that a significant portion of the relevant consuming public recognizes it as source indicating

Weider Publications v. D&D Beauty Care

- There was significant evidence that the SHAPE mark is famous for purposes of likelihood of confusion
- Applied for services are of the type that are normally featured in opposer's magazine
- SHAPE magazine has material on health spas and services going back to 2003 – the articles discussed the services offered
- Opposer has also cross promoted it magazine with spa operators

Weider Publications v. D&D Beauty Care

- Applicant contended the SHAPE mark is weak – submitted third party applications and excerpts from websites
- Applications are of no probative value
- Evidence of use is of limited probative value because they don't show the context in which the term or phrase is used on the listed web page
- TTAB – acknowledge that SHAPE has suggestive significance in the field but opposer's mark has achieved a degree of fame that makes it distinctive

LACK OF BONA FIDE INTENT

Swatch AG v. M.Z. Berger & Co. Inc.

- Swatch opposed IWATCH as confusingly similar to SWATCH and that Applicant had no bona fide intent
- No likelihood of confusion – marks are too dissimilar
- One way to show lack of intent is that applicant has no documents to support its intent as of the filing date
- Applicant had a search report and the filing documents from its application but nothing before that
- M.Z. Berger had the capacity to make watches and clocks

Swatch AG v. M.Z. Berger & Co. Inc.

- Principal of M.Z. Berger said to apply for only watches and clocks but the application had 30 goods “to leave all doors open”
- Witness testified that the owner said he would apply for the IWATCH name and figure out what they would do with it – viewed by the Board as merely an intent to reserve rights in the name – not the same as a bona fide intent to use the mark – opposition granted

Lincoln National Corporation v. Kent Anderson

- Here, the applicant applied for the mark FUTURE in eleven classes, including Classes 35 and 36
- Services were wide ranging – banking, insurance agencies, loan financing, stock brokerage in Class 36
- Class 35 – very long – included retail grocery stores, automobile dealerships, modeling agencies, physician referrals services, etc.
- Opposed on the basis of lack of bona fide intent and likelihood of confusion

Lincoln National Corporation v. Kent Anderson

- Applicant identified his prospective consumers as “The world, Every person in the world.”
- He had a website that was created in 2000 which discussed his vision for FUTURE – wanted to create global opportunities from the brand for all people
- Applicant’s idealistic hopes for forming a futuristic company do not suffice as the requisite bona fide intent and is merely an attempt to reserve a general right in the mark for potential use on some undetermined goods or services at some indefinite time in the future.

Lincoln National Corporation v. Kent Anderson

- Legislative history – an excessive number of ITU apps may cast doubt on one's intent – here the 11 classes is the same as 11 applications
- It is highly unlikely that applicant would be able to introduce these services during the pendency of his applications
- No evidence that applicant has or has ever had the capacity to provide any of the services
- Application is void ab initio as to Classes 35 and 36

MERELY DESCRIPTIVE OR GENERICNESS

In re Positec Group Limited

- Filed for SUPERJAWS:
 - Machine tools, namely, **jaws** for use in the precision clamping of work pieces; Workbench accessories, namely, metal attachable machine tool holder in the nature of clamps, **jaws**, and vices...
- Refused as merely descriptive – “super” is laudatory
- ITU – can’t amend to the Supplemental Register
- On appeal – Board noted that “jaws” appeared 2 times in Class 7 and 6 times in Class 8

In re Positec Group Limited

- Not all goods were “jaws” but if the mark is descriptive of even one, whole class may be refused
- Board found “jaws” highly descriptive and alone may be generic
- SUPERJAWS immediately conveys information about heavy duty tools with large amounts of clamping pressure – merely descriptive refusal affirmed

In re Cordua Restaurants

- Application to register CHURRASCOS (Stylized) for bar and restaurant services initially rejected as merely descriptive – 2(f) claim submitted and then rejected as generic
- Evidence – Applicant owned a prior word mark registration for the same mark and same services; restaurants grossed over \$8 million per year; over \$80K per year in advertising expenses
- On appeal – the genus of the services is restaurant services – Churrasco is defined as meat cooked over an open fire

In re Cordua Restaurants

- Many articles referred to Brazilian churrasco restaurants – the examining attorney established that the general public understands churrascos as a restaurant that services “churrascos”
- Applicant’s specialty food is churrascos – a term that is the generic name of a particular category of goods is generic for any service directed to or focused on that class of goods
- Fact that applicant owned a prior registration was not persuasive - not bound by prior examiner’s decisions

Frito-Lay v. Princeton Vanguard

- Princeton filed for PRETZEL CRISPS for “pretzel crackers” – claimed 2(f) based on use since 2004 – owned a Supplemental registration for the same mark
- Frito Lay opposed – mark is generic or highly descriptive without secondary meaning – also petitioned to cancel the Supplemental registration
- Genus of goods is “pretzel crackers”
- Term pretzel is clearly generic – question is the effect of crisps – is a pretzel crisp a pretzel cracker?



Triscuit Thin Crisps

Baked whole grain wheat crackers

Chile
Pepper

NATURAL FLAVOR WITH OTHER NATURAL FLAVOR

May Help
Reduce
the Risk of
Heart Disease



ENLARGED TO SHOW DETAIL

NET WT 7.6 OZ (215g)

DIETS RICH IN WHOLE GRAIN FOODS & OTHER PLANT FOODS, & LOW IN SATURATED FAT & CHOLESTEROL, MAY HELP REDUCE THE RISK OF HEART DISEASE.



Frito-Lay v. Princeton Vanguard

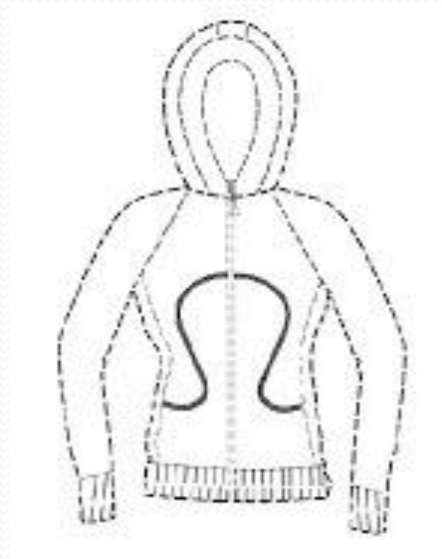
- Frito Lay showed use by competitors of the term crisp to name or identify crackers (Special K cracker crisps; Triscuit thin crisps; HEB wheat crisps; Keebler nut crisps; Nabisco harvest crisps)
- Media references naming crackers as “crisps”
- Numerous active registrations for cracker products which disclaimed the term “crisps”
- Most damning evidence – applicant’s nutritional information on the box used “crisps” generically

Frito-Lay v. Princeton Vanguard

- Both parties used a “Teflon” survey – Frito Lay’s survey showed that 41 % considered the term a brand and 4⁰% considered it a category – survey is flawed because it wasn’t clear that the respondent knew the difference and he failed to test their knowledge
- Defendant’s expert used a mini-test – 55⁰% found it to be a brand name
- Board gave little weight to the surveys
- Found weight of the evidence in favor of finding that “pretzel crisps” is generic for “pretzel crackers”

ORNAMENTAL REFUSAL

In re Lululemon Athletica Canada, Inc.



In re Lululemon Athletica Canada, Inc.

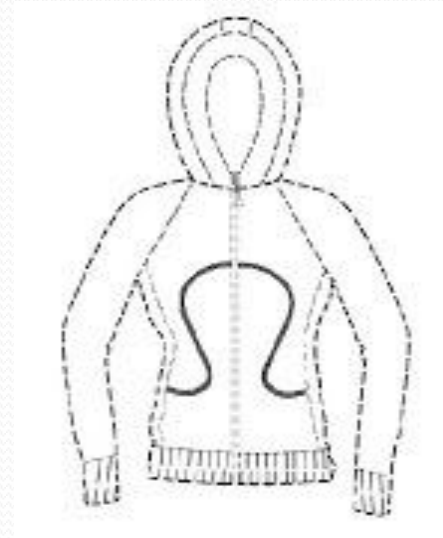
- Examiner refused registration as ornamental – primarily concerned with the size of the design but applicant argued that many well known brands are displayed in large letters on the front of garments
- On appeal – Board rejected a per se rule based on the size of the mark on the clothing – it is merely one consideration – must also look at the commercial impression made by the design and any evidence of distinctiveness

In re Lululemon Athletica Canada, Inc.

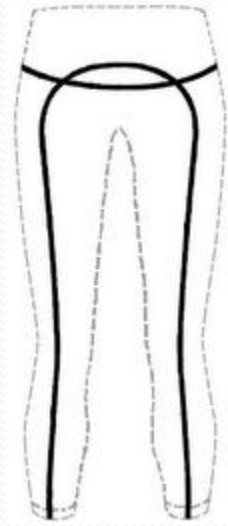
- Board found that the commercial impression of the mark was of simple piping so it was ornamental and not inherently distinctive
- Ornamental refusal can be overcome by showing (1) it is inherently distinctive; (2) it has acquired secondary meaning or (3) the design has been used or registered by the applicant for other goods and services in a non-ornamental fashion
- This was an intent to use application so there was no secondary meaning

In re Lululemon Athletica Canada, Inc.

- Same mark used on other goods and services? Not the same mark:



Thoughts on this one?



PROCEDURAL ISSUES

In re Faucher Industries, Inc.

- Applicant filed for mark identifying goods as “choke seals” and “choke seals for electric cables”
- Examiner asked Applicant to provide common commercial or generic name for the goods
- Applicant amended to “electrical connections in the nature of choke seals for electric cables” – examiner continued to request information about the goods
- On appeal – applicant argued that the initial ID should have been accepted – asked the Board to pick one

In re Faucher Industries, Inc.

- Board can't pick and choose – they can only look at the most recent amended ID
- The Director has more flexibility – could have filed a petition or picked up the phone to talk to the examiner
- Examiner didn't have enough information about the goods and his inquiries were reasonable and correct
- Refusal to register was affirmed

In re Thomas White International, Inc.

- Applicant filed for the mark EMPOWERING THE INVESTOR for reports featuring investment management and investment research information recorded on computer media
- The specimen was a 52 page electronic document captioned “Annual Report” for a fund called “Thomas White Funds” for which the applicant is the advisor
- Registration refused on the ground that the mark is not used for goods in trade and that the specimen didn’t show the mark for the applied for goods

In re Thomas White International, Inc.

- Applicant argued that the specimen is an electronic publication featuring information on specific funds and because it is published once a year it is entitled “Annual Report”
- Examiner argued it is an annual report of corporate activity for applicant’s family of funds and relates to applicant’s own business
- The question is whether the reports are independent goods in trade or merely incidental to applicant’s investment services

In re Thomas White International, Inc.

- If the reports are merely the means by which applicant's services are transmitted they have no viable existence separate and apart from those services
- For customers who invested in the funds, the report serves the purpose of reporting on their investments – for prospective customers, it is tantamount to a sales document
- “What is being offered for sale?” – the opportunity to invest in the funds and receive applicant's investment management services, not the reports

In re U.S. Tsubaki, Inc.

- Applicant applied for TSUBAKI: THE CHOICE FOR CHAIN for chains and sprockets – submitted a catalog as a specimen – rejected as merely advertising material
- Applicant argued that the catalogs offer the products to customers by inviting orders using the phone number in the catalog
- Question- do the specimens provide the potential purchase with the information normally associated with ordering products of that kind

In re U.S. Tsubaki, Inc.

- On appeal – a simple invitation to call for quotes for placing orders is not sufficient – there is no information on how much the goods cost, how orders are shipped, etc.
- Although applicant's counsel argued that orders are taken over the phone by skilled chain experts and consumers go to the internet address on the catalogs as well to obtain information, those arguments were not supported by any declaration by applicant

RECENT TTAB CASES

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