

THE TRADEMARK YEAR IN REVIEW:

2004 Trademark Decisions of The Court of Appeals for the Federal Circuit and The Trademark Trial & Appeal Board

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For ease of reference, decisions are sorted by their principal significant subject matter (e.g., descriptiveness, likelihood of confusion, etc.). Comparatively few trademark decisions of the TTAB are published precedential decisions. For those wishing to reference all TTAB decisions, the USPTO has these decisions sorted by topic at the TTAB website: <http://www.uspto.gov/web/offices/com/sol/foia/ttab/ttab.htm>.

ACQUIRED DISTINCTIVENESS

In re Candy Bouquet Int'l, Inc., 2004 WL 2202265 (TTAB Sept. 8, 2004)

After finding applicant's mark CANDY BOUQUET generic for retail, mail and computer order services in the field of gift packages of candy, the Board addressed acquired distinctiveness for completeness. Applicant's evidence of sales under the mark for 14 years, millions of dollars in advertising expenses, and recognition in articles, established the popularity of applicant's services, not that relevant customers view the mark as a source-identifier. This is particularly true in view of the widespread use of the term "candy bouquet" by third parties. Applicant's prior incontestable registration for a design mark that includes "Candy Bouquet" does not help establish distinctiveness of that phrase because the phrase was disclaimed in the registration. Refusal to register affirmed.

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ATTORNEY DISQUALIFICATION

Finger Furniture Co. v. Finger Interests Number One, 71 USPQ2d 1287 (TTAB 2004)

Opposer's law firm had previously represented applicant on an unrelated, non-trademark matter. Applicant moved to disqualify Opposer's firm. Despite the law firm's argument that applicant should be considered a "former client" for purposes of the analysis, the Board found that the facts established that applicant was a current client at the time the firm filed the Notice of Opposition – the relevant time for the inquiry. Filing an opposition against a current client, according to the Board, establishes a prima facie case that the representation will have an adverse effect on the lawyer's independent professional judgment, in violation of PTO Rule 10.66(b). Opposer's arguments that the applicant had unjustifiably delayed in raising the motion, that applicant had consented, and that the subject matter of the representations are not substantially related do not overcome the presumption that the applicant will be adversely affected. Motion to disqualify granted.

DESCRIPTIVENESS

In re Oppedahl & Larson LLP, 71 USPQ2d 1370 (Fed. Cir. 2004)

In "exceptional circumstances," addition of a top level domain name (TLD) may render an otherwise unregistrable term sufficiently distinctive for registration. When evaluating marks, the PTO must determine whether the mark as a whole – i.e., the combination of the individual parts of the mark, including the TLD – conveys any source-identifying impression. Applicant's mark PATENTS.COM, as a whole, conveys the meaning of patent-related goods in connection with the Internet. This describes appellant's goods, which include a website with software to track patent applications and issued patents. Refusal to register affirmed.

FALSE CONNECTION WITH PERSONS OR INSTITUTIONS

In re Julie White, 2004 WL 2202268 (TTAB Sept. 8, 2004)

Applicant, a member of the St. Regis Band Mohawk Indians of New York, sought registration of APACHE for cigarettes. The "critical" requirement in a Section 2(a) case is that the name at issue be "unmistakably associated" with another person, institution, etc. The historic association of the term with certain Native American tribes was not

overcome by the minimal amount of evidence that the term had other meanings, according to the Board. The “fame” of the name must also be considered in the context of the goods or services to determine if the name would point consumers of those goods or services to a particular person or institution. Here, the Board found that the Apache tribes of the Southwest United States are renowned for their business, tourism, archeological and cultural enterprises, and consumers know they own smoke shops and manufacture cigarettes under Native American brands. The Board concluded that applicant’s use of APACHE as a mark for cigarettes would falsely suggest a connection between applicant and the federally recognized Apache tribes. Refusal to register affirmed.

GENERICNESS

Zimmerman v. National Association of Realtors, 70 USPQ2d 1425 (TTAB 2004)

Petitioner, an entrepreneur who owns 1900 website names that incorporate the term “realtor” and a geographic designation, failed to establish that the relevant public primarily understands the terms REALTOR and REALTORS to refer generically to all real estate agents. Virtually all of the evidence of record supports the conclusion that the marks at issue function as an identifier of respondent’s members, as opposed to real estate professionals who are not members. In the battle of surveys, the parties disputed whether the proper universe to query was the general public, or the more limited group of real estate professionals. The TTAB concluded that both groups fell within the relevant public for determining perceptions, but gave little weight to petitioner’s survey because of its flawed methodology. Petition to cancel denied.

GEOGRAPHIC MISDESCRIPTIVENESS

In re Consolidated Specialty Restaurants, Inc., 71 USPQ2d 1921 (TTAB 2004)

To establish that a mark is geographically deceptively misdescriptive, the PTO must establish (1) the primary significance of the mark is a generally known geographic location; (2) the consuming public is likely to believe the place identified by the mark indicates the origin of the goods bearing the mark, when in fact the goods do not come from that place; and (3) the misrepresentation was a material factor in the consumer’s decision to purchase the goods. Applicant did not dispute the first factor, but



argued under factors 2 and 3 that its mark was not deceptive because consumers come to its restaurant expecting a Colorado or western “atmosphere or ambiance” – which they get – not food from Colorado. The Board concluded there was no evidence supporting Applicant’s argument, and that the Examining attorney had satisfied his burden by submitting evidence that restaurants outside Colorado tout they serve Colorado steaks, as well as other similar evidence showing a recognition that Colorado is known for its steaks and the public is aware of the connection. Refusal to register affirmed.

INFORMATION REQUESTED BY EXAMINER

In re Planalytics, Inc., 70 USPQ2d 1453 (TTAB 2004)

Responding to an application to register the mark GASBUYER, the examining attorney requested the applicant to submit product information for the identified services of “providing on-line risk management services in the field of pricing and purchasing decisions for natural gas.” After ignoring the request and having registration finally refused for descriptiveness, the applicant stated in its request for reconsideration “information regarding its services may be found on its website located at www.planalytics.com.” The Board concluded that under PTO regulations, an applicant has an obligation to produce the requested information, not send an examining attorney on “a scavenger hunt through a website in search of relevant information.” In addition, by referring merely to its website address, it is unclear as to what portions of the website the applicant intended to put in the record. And, the Board pointed out that information on websites is transitory and subject to change at any time at the owner’s discretion. Refusal to register based on the separate grounds of descriptiveness and applicant’s failure to comply with the requirement for information is affirmed.

LACHES

Alfacell Corp. v. Anticancer, Inc., 71 USPQ2d 1301 (TTAB 2004)

Despite Petitioner’s seven year, unexplained, delay in filing petition for cancellation, Respondent failed to prove laches defense. Petitioner was “completely silent” as to the reason for its delay, which the Board concluded was “substantial.” Nevertheless, according to the Board, Respondent provided insufficient specifics about the prejudice it alleges to have suffered. Respondent shipped only seven vials of its anticancer drug. Over nine years Respondent

promoted its drug at 78 presentations, meetings and trade shows, including two of the most widely attended annual meetings drawing 10,000 to 15,000 attendees respectively. In the absence of “dollar amounts or other specific information relative to its promotion efforts,” the Board concluded it is difficult to gauge the degree to which there has been any detriment. Petition for cancellation granted.

LIKELIHOOD OF CONFUSION

Baseball America, Inc. v Powerplay Sports Ltd., 71 USPQ2d 1844 (TTAB 2004)

Applicant’s mark BASEBALL AMERICANA for posters and educational services relating to baseball is likely to be confused with Registrant’s mark BASEBALL AMERICA for various baseball-



related goods and services. The Board concluded the respective goods of the parties were virtually identical. The marks have similar, though not identical connotations in that both marks generally connote “baseball in America” or “American baseball.” Both parties’ goods are or could be marketed in the same trade channels to the same classes of purchasers, baseball fans, who are general consumers who exercise only ordinary care in purchasing decisions. Given these facts, and the fame of Registrant’s mark, the Board concluded there is a likelihood of confusion. Opposition sustained.

In re Chatam International, Inc., 71 USPQ2d 1944 (Fed. Cir. 2004)

Applicant’s mark JOSE GASPAR GOLD for tequila is likely to be confused with Registrant’s mark GASPAR’S ALE for beer and ale. The Board did not violate the “anti-dissection rule” by giving more or less weight to particular features of the marks in its confusion analysis. The Board properly discounted the terms “JOSE,” “GOLD,” and “ALE” as not changing the underlying commercial impression that a name, GASPAR, is the source of related alcoholic beverages. GASPAR is thus the dominant feature of both marks. Refusal to register affirmed.

Shen Manuf. Co., Inc. v. The Ritz Hotel, Ltd., No. 04-1063 (Fed. Cir. Dec. 17, 2004)

Applicant’s series of “RITZ” marks, including PUTTING ON THE RITZ, RITZ PARIS, RITZ HOTEL, and THE RITZ KIDS for shower curtains, cooking classes, plates, steel wool, sponges and kids clothing is not likely to be

confused with Registrant's RITZ marks for household textile products such as towels, potholders and aprons. Applicant's mark is not famous, despite over 100 years of use and millions of dollars annually in sales and marketing. The Federal Circuit's analysis focused on the commercial impressions of the respective marks. Applicant's marks make a strong commercial impression of goods and services that are "fancy," "even swanky," and imbued with "wealth." In contrast, to the extent Registrant's products convey a commercial impression, it is one of cleaning, cooking or manual labor. Additionally, in the mark THE RITZ KIDS, the word "THE" distinguishes the parties' marks further, even though that word typically does not act as a source identifier. "THE" has an elevated significance here because of the well known manner the hotel is referred to as "The Ritz," not simply "Ritz." Oppositions dismissed.

PROCEDURE

Yahoo, Inc. v. Loufrani, 70 USPQ2d 1735 (TTAB 2004)

Notice of Opposition that lists the wrong serial number, date of publication, and classes of goods and services in the application cannot be corrected by filing an Amended Notice of Opposition after the statutory time period for filing an opposition expires. The Amended Notice did not correct a minor discrepancy such as where the serial number in the caption of the Notice did not correspond with the body, but there was notice of which application is being opposed. Opposition dismissed.



SPECIMENS OF USE

In re Dell, Inc., 71 USPQ2d 1725 (TTAB 2004)

A website page which displays a product, and provides a means for ordering the product can constitute "a display associated with the goods," as long as the mark appears on the webpage in a manner in which the mark is associated with the goods. The Board concluded that traditional point of purchase displays are not feasible for on-line shopping, which in today's commercial environment, make up a significant portion of trade. Web pages which display goods and their trademarks, and provide for the on-line ordering of such goods, are in fact electronic displays which are associated with the goods.

SURNAMES

In re Gregory, 70 USPQ2d 1792 (TTAB 2004)

The question of whether a surname is rare is not to be determined solely by comparing the number of listings of the name to the total number of listings in a vast computerized database. Another issue to be considered, in assessing how rarely a name is used, is the media attention or publicity accorded public personalities with the name. The Board reasoned that a surname rarely appearing in birth records may nonetheless appear more routinely in news reports, articles and the like, so as to be broadly exposed to the general public as a surname. The name ROGAN has received much public exposure as the surname of James Rogan, the former Director of the USPTO and politician, and the surname of other Rogans involved in sports, publishing and TV. The Board concluded that Rogan's primary significance as a surname is not outweighed by other meanings which may be attributed to it. Refusal to register affirmed.