

## Submission of the United States of America

### GROUNDINGS FOR REFUSAL OF TRADEMARK REGISTRATION

#### *Case Law Examples*

#### **Immoral, Deceptive, Scandalous or Disparaging Marks, Marks that Suggest a False Connection, and Certain Geographical Indications for Wine or Spirits**

##### *Immoral or scandalous marks*<sup>1</sup>

*Boston Red Sox Baseball Club Limited Partnership v. Sherman*, 88 USPQ2d 1581, (TTAB 2008) (The Trademark Trial and Appeal Board sustained an opposition on grounds of lack of bona fide intent to use the mark and Trademark Act §2(a) scandalousness and disparagement, but dismissed the opposition as to §2(a) false connection and §2(d) likelihood of confusion. At issue was the mark shown below,

The image shows the trademark 'SEX ROD' in a hand-drawn, blocky, outlined font. The letters are slightly irregular and have a sketchy appearance.

, for goods that the applicant admitted are identical or closely related to the goods and services offered in connection with the opposer's numerous RED SOX marks, including the mark shown below.

The image shows the trademark 'RED SOX' in a hand-drawn, blocky, outlined font, similar to the 'SEX ROD' mark above. The letters are slightly irregular and have a sketchy appearance.

The Board held the applied-for mark immoral or scandalous under §2(a) based on vulgarity designations of the word “ROD” in mainstream dictionaries and the context of use in the applicant’s mark SEX ROD, which the applicant admitted had a sexual connotation. The Board was unswayed by the applicant’s argument that the mark was merely a parody of the opposer’s marks, noting that any parody was itself vulgar, and therefore did not overcome §2(a). Also applying §2(a), the Board held that “[b]ecause the applicant’s mark is offensive, and because the public will associate the offensive message with opposer,” the mark is disparaging. Finally, the Board held that the marks were not confusingly similar due to the significant differences in the marks themselves and their commercial impressions, which were sufficient to outweigh other factors favoring confusion, such as the fame of opposer’s marks, the similarity of the goods and the impulse nature of the purchase of these types of goods.)

##### *Deceptive marks*<sup>2</sup>

*In re Beaverton Foods, Inc.*, 84 USPQ2d 1253 (TTAB 2007) (NAPA VALLEY MUSTARD CO., in standard characters, held geographically deceptive for “condiments,

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<sup>1</sup> Trademark Manual of Examining Procedure (TMPEP) §1203.01; The TMPEP can be accessed at: <http://tess2.uspto.gov/tmdb/tmep/>

<sup>2</sup> TMPEP §1203.02

namely mustard” pursuant to Section 2(a). Applicant admitted that the goods did not come from Napa Valley, and for the most part, conceded that the mark was at least primarily geographically misdescriptive. Looking to the merits of the Section 2(a) refusal, the Board found that the evidence supported the refusal. The evidence of record demonstrated that Napa Valley is used by third parties as a geographic location and in connection with mustard. In fact, it was shown that Napa Valley hosts a well publicized mustard festival. The Board concluded that Napa Valley is a well known geographic location; that purchasers were likely to believe that the mustard originates from there; and that the misrepresentation is a material factor in the consumer’s decision to purchase these goods.)

***Marks that suggest a false connection***<sup>3</sup>

*In re MC MC S.r.l.*, 88 USPQ2d 1378 (TTAB 2008) (The Board reversed the refusal to register concluding that the proposed mark, MARIA CALLAS, for jewelry and other goods did not falsely suggest a connection with the deceased opera singer Maria Callas. The Board focused on “whether or not there is someone (this may be a natural person, estate, or juristic entity) with rights in the name ‘Maria Callas.’” It determined that since “the record is replete with contradictory information,” there is “significant doubt remaining as to whether anyone currently possesses rights in the name ‘Maria Callas’ and resolving such doubt in applicant’s favor, found that the examining attorney did not meet her burden in establishing the false suggestion of a connection refusal.” The Board noted that §2(a) is not intended to protect the public, but to prevent the unauthorized use of the persona of a person or institution.

*Hornby v. TJX Companies, Inc.*, 87 USPQ2d 1411, (TTAB 2008) (The Board granted the petition to cancel TJX Companies’ (TJX’s) registration of the mark TWIGGY for various types of clothing on the grounds that it falsely suggests a connection with petitioner, Lesley Hornby a/k/a/ Lesley Lawson a/k/a Twigg (“petitioner”), a famous British model in the 1960’s and 70’s. The Board noted that a §2(a) claim requires the plaintiff to demonstrate that: (1) the defendant’s mark is the same or a close approximation of plaintiff’s previously used name or identity; (2) the mark would be recognized as pointing uniquely and unmistakably to the plaintiff; (3) the plaintiff is not connected with the activities performed by the defendant under the mark; and (4) the plaintiff’s name or identity is of sufficient fame or reputation that when the mark is used on its goods or services a connection with the plaintiff would be presumed. The Board found no dispute as to the first and third factors. As to factor four, the Board found that the relevant time frame to look at petitioner’s fame was as of July 4, 2000 when TJX’s registration issued. The Board found that such fame had been shown and that purchasers of children’s clothing would, upon seeing the mark TWIGGY on clothing, presume an association with petitioner. The Board found that petitioner’s modeling and entertainment career continued beyond the ‘70’s, through the ‘80’s, ‘90’s and up to the present. The Board also took judicial notice that the *American Heritage Dictionary* in 2000 included “Twiggy” as an entry identifying her as “a British model,” and found other indications in the record of her continuing fame. Considering the second factor of the test, the Board

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<sup>5</sup> TMEP §1203.03

found that the TWIGGY mark on clothing would be recognized as pointing uniquely and unmistakably to petitioner based on all the evidence of her fame and recognition. The Board noted that “twiggy” does have another meaning, *i.e.* resembling twigs, etc. and, if the goods had been some kind of plant or different goods, then the use of the term “Twiggy” might mean something different to consumers. However, when it is used on these goods, clothing, it pointed uniquely to petitioner, recognizing the close relationship between models and clothing.

*Association pour la Defense et la Promotion de L'Oeuvre de Marc Chagall Dite Comite Marc Chagall v. Bondarchuk*, , 82 USPQ2d 1838, (TTAB 2007) (Board granted a petition to cancel registration of the mark MARC CHAGALL for “alcoholic beverages, namely, vodka,” because it creates a false suggestion of a connection with the deceased painter Marc Chagall, in violation of §2(a) of the Trademark Act. First, the Board found that petitioner had standing to bring the proceeding. A granddaughter and one of the heirs of Marc Chagall testified that she is a member of the petitioner’s committee and that the purpose of the committee is to defend the rights and works of the painter Marc Chagall. The Board applied the test set forth in *Buffet v. Chi-Chi’s, Inc.*, 226 USPQ 428 (TTAB 1985). A plaintiff asserting a claim that a mark falsely suggests a connection with persons living or dead, or institutions, must “demonstrate (i) that the defendant’s mark is the same or a close approximation of plaintiff’s previously used name or identity; (ii) that the mark would be recognized as such; (iii) that the plaintiff is not connected with the activities performed by the defendant under the mark; and (iv) that the plaintiff’s name or identity is of sufficient fame or reputation that when the defendant’s mark is used on the goods or services, a connection with the plaintiff would be presumed.” Here, requirements (i) and (ii) were conceded by respondent and therefore were not at issue. The Board then found that the mark would be recognized as the name of the painter Marc Chagall and that the name is of sufficient fame or reputation that when the respondent’s mark is used on the goods, a connection with the painter Marc Chagall would be presumed.)

*In re White*, 80 USPQ2d 1654, (TTAB 2006) (Board affirmed refusal of MOHAWK, used on cigarettes, under §2(a), on the ground that it would falsely suggest a connection with a federally recognized tribe, the St. Regis Band of Mohawk Indians of New York (“Mohawk tribe”). The record included dictionary definitions and Internet evidence that Indian tribes in general, and the Mohawk tribe in particular, are engaged in large-scale marketing of cigarettes and manufacturing of native American brands of cigarettes; that the MOHAWK tribe inhabits New York and Canada and is well known among residents of and visitors to that region; and that the tribe operates several commercial enterprises that contribute to its fame and recognition. Applicant submitted evidence that the term had other meanings, but the Board found that each of the other meanings was associated with the Mohawk tribe. The Board further found that purchasers of cigarettes would be aware of the manufacturing and sale of Native American brand cigarettes and would think uniquely of the Mohawk tribe when they encountered the proposed mark.)

***Marks that disparage or bring into contempt or disrepute***<sup>4</sup>

*In re Heeb Media, LLC*, 89 USPQ2d 1071 (TTAB 2008) (The Board upheld the refusal to register the proposed mark HEEB for clothing and entertainment services under Trademark Act §2(a), finding that the mark is disparaging to a substantial composite of the public. The dictionary evidence indicated that HEEB is a disparaging term for Jewish people. Moreover, the dictionary definitions and Lexis-Nexis evidence of record demonstrated that a substantial composite of Jewish groups and individuals consider the term to be disparaging. The applicant argued that the term has been reclaimed by Jewish people and no longer has a disparaging meaning. In particular, the applicant noted that the USPTO did not find the term to be disparaging in the applicant's prior registration for the mark HEEB for magazine services. The applicant submitted evidence from prominent members of the Jewish community and Jewish organizations which supported the non-disparaging meaning of the term. The applicant also submitted a dictionary definition that included two meanings for the term, one derogatory and one as simply meaning "Jewish." Thus, the applicant asserted that this dictionary definition showed that the meaning of HEEB had changed over time. The Board focused on whether the term would be disparaging to a substantial composite of the Jewish population "in the context of contemporary attitudes." The Board reviewed the evidence and determined that a substantial composite of the Jewish community would still find the term derogatory. The Board stated that the phrase substantial composite "is not necessarily a majority." The Board noted that all the dictionary definitions characterize the term as derogatory, including the dictionary definition with both a derogatory and non-derogatory meaning. According to the Board, this demonstrated that although the meaning of the term is changing, it is still used in a derogatory fashion. Noting that the USPTO's allowance of other marks does not bind the Board, the Board found unpersuasive the applicant's arguments based on the prior registration for different goods.)

***Certain Geographical Indications for Wines or Spirits***<sup>5</sup>

No precedential cases to report at this time.

***Flag, Coat of Arms or Insignia***<sup>6</sup>

*In re U.S. Department of the Interior*, 142 USPQ 506, 507 (TTAB 1964) (logo comprising the words "NATIONAL PARK SERVICE" and "Department of the Interior," with depiction of trees, mountains and a buffalo, surrounded by an arrowhead design, held not to be an insignia of the United States).

*Liberty Mutual Insurance Co. v. Liberty Insurance Co. of Texas*, 185 F. Supp. 895, 908, 127 USPQ 312, 323 (E.D. Ark. 1960) ("That the Statue of Liberty is not a part of the 'insignia of the United States' is too clear to require discussion.")

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<sup>4</sup> TMEP §1203.03

<sup>5</sup> TMEP §1210.08

<sup>6</sup> TMEP §1204

*In re Waltham Watch Co.*, 179 USPQ 59, 60 (TTAB 1973) (mark consisting of wording and the design of a globe and six flags for watches found registrable, the Board stating, “[A]lthough the flags depicted in applicant’s mark incorporate common elements of flag designs such as horizontal or vertical lines, crosses or stars, they are readily distinguishable from any of the flags of the nations alluded to by the examiner. In fact, applicant’s mark would be regarded as nothing more than a conglomeration of nondescript flags utilized to symbolize the significance of the globe design and the slogan ‘TIMING THE WORLD’ appearing thereon.”)

*In re Advance Industrial Security, Inc.*, 194 USPQ 344, 347 (TTAB 1977) (ADVANCE SECURITY and design consisting of an eagle on a triangular shield, in gold and brown, for detective and investigative services and providing security systems and services, found registrable, the Board stating, “When the mark of the applicant and the Coat of Arms or Great Seal of the United States are compared in their entirety, it is adjudged that applicant’s mark does not consist of or comprise the Coat of Arms of the United States or any simulation thereof ....”)

*Knorr-Nahrmittel A.G. v. Havland International, Inc.*, 206 USPQ 827, 833 (TTAB 1980) (While applicant originally may have intended to include the flags of the Scandinavian countries in the mark, NOR-KING and design, “[a]ll that the record reflects is that the mark contains a representation of certain flags, but not the flag or flags of any particular nation.” Opposer’s cause of action under §2(b) found to be without merit; opposition sustained on other grounds).

*In re National Van Lines, Inc.*, 123 USPQ 510 (TTAB 1959) (mark comprising words and the design of a shield with vertical stripes held registrable, the Board finding the design to be readily distinguishable from the shield of the Great Seal of the United States and, therefore, not a simulation of the seal or any portion thereof).

*In re American Box Board Co.*, 123 USPQ 508 (TTAB 1959) (design mark comprising an eagle and shield held registrable, the Board finding that it did not involve a simulation of the Great Seal of the United States because the eagle and shield of applicant’s mark differed substantially from those on the seal in both appearance and manner of display).

### **Name, Portrait or Signature<sup>7</sup>**

*Ross v. Analytical Technology Inc.*, 51 USPQ2d 1269 (TTAB 1999) (registration of opposer’s surname without consent prohibited by §2(c), where the record showed that because of opposer’s reputation as an inventor in the field of electrochemical analysis, the relevant public would associate the goods so marked with opposer).

*In re Sauer*, 27 USPQ2d 1073 (TTAB 1993), *aff’d per curiam*, 26 F.3d 140 (Fed. Cir. 1994) (BO, the recognized nickname of professional football and baseball star Bo Jackson, found to be so well known by the general public that use of the name BO in

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<sup>7</sup> TMEP§1206

connection with sports balls would lead to the assumption that he was in some way associated with the goods or with applicant's business).

*In re Steak and Ale Restaurants of America, Inc.*, 185 USPQ 447 (TTAB 1975) (PRINCE CHARLES found to identify a particular living individual whose consent was not of record).

*Laub v. Industrial Development Laboratories, Inc.*, 121 USPQ 595 (TTAB 1959) (LAUB, for flowmeters, found to identify the holder of a patent for flowmeters, whose written consent was not of record).

*Reed v. Bakers Engineering & Equipment Co.*, 100 USPQ 196, 199 (PTO 1954) (registration of REED REEL OVEN, for ovens, held to be barred by §2(c) without written consent of the designer and builder of the ovens, Paul N. Reed. "'Name' in §2(c) is not restricted to the full name of an individual but refers to any name regardless of whether it is a full name, or a surname or given name, or even a nickname, which identifies a particular living individual...")

### **Likely to Cause Confusion, Mistake or to Deceive<sup>8</sup>**

*In re SL&E Training Stable, Inc.*, 88 USPQ2d 1216 (TTAB 2008) (Likelihood of confusion found between the applicant's mark SAM EDELMAN for "luggage, handbags, purses, wallets, all-purpose tote bags, all-purpose sports bags, backpacks," in class 18 and the registrant's mark EDELMAN for "wallets, handbags, traveling bags, luggage trunks," and other items in class 18. The Board found that the case law did not support applicant's argument that there is a "strong public policy to allow individuals to use their names." In fact, the Board found that the more compelling public policy is to avoid a likelihood of confusion. Then using a typical §2(d) analysis, the Board found that the goods are identical in part, and therefore presumed that the goods travel in the same channels of trade and have the same classes of purchasers. As to the similarity of the marks, the Board determined that the marks are similar because they share the same surname and it is the practice in the fashion industry to refer to surnames alone. The Board was unswayed by the applicant's ownership of a registration for the identical mark for footwear.)

*General Motors Corp. v. Aristide & Co.*, 87 USPQ2d 1179 (TTAB 2008) (The Board dismissed the opposition to the mark LA SALLE for goods that included motor vehicles and bicycles on grounds of likelihood of confusion and dilution, finding that opposer's LASALLE mark had been abandoned for at least three consecutive years--*prima facie* evidence of abandonment under the Trademark Act--and opposer had neither shown an intention to resume use nor established a subsequent priority date. In evaluating which party had priority, a critical issue in an opposition grounded on likelihood of confusion, the Board found that applicant could rely on December 15, 2003, the filing date of its international application. Turning next to opposer, the Board determined that although vehicles bearing the LASALLE mark were first introduced in 1927, none had been

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<sup>8</sup> TMEP §1207

produced since 1940. The Board rejected opposer's various arguments in support of priority, including allegations that despite nonuse for 65 years, it had no intention to abandon its mark; and that the LASALLE model was still "highly acclaimed" and that residual goodwill remained through car collector clubs. The Board disagreed, finding that opposer had failed to demonstrate use of the mark in the ordinary course of trade, and had failed to rebut the presumption of abandonment. The Board also rejected opposer's claim that licensing activities beginning in the 1990's established a new priority date, noting that the act of licensing without more was not actual use. The Board found that the evidence showed the licenses did not actually begin until 2001, and concluded that the record was unclear as to "whether or when and on what goods opposer's mark had actually be used," and was also unclear as to the number of sales and whether they showed actual use and not mere "token" sales. In dismissing the opposition, the Board concluded that opposer could not prevail without establishing a date of priority before applicant's priority date, and did not address the likelihood of confusion or dilution claims).

*Green Spot (Thailand) Ltd. v. Vitasoy International Holdings Limited*, 86 USPQ2d 1283 (TTAB 2008) (The Board granted summary judgment and sustained opposition on the grounds of likelihood of confusion and priority of use by the opposer. The Board found a likelihood of confusion since the mark used by both parties, VITAMILK, was used on the same goods, soy beverages. The opposer established priority of use of the mark in the United States beginning December 20, 2003. The applicant had no use and argued that the mark is famous in other countries. The Board noted that fame outside of the U.S. could not be used for purposes of establishing priority of use in the U.S. and therefore held that the filing date of the applicant's intent to use application was the earliest date on which the applicant could rely for purposes of determining priority. The Board rejected applicant's "Morehouse" defense, an "equitable doctrine that applies where an applicant owns a prior registration for essentially the same mark identifying essentially the same goods or services that are the subject mark and goods of the proposed application." Here, the proffered registration, a Chinese character mark, was found to be dramatically different in appearance such that it creates a wholly different commercial impression and therefore, could not be considered as essentially the same mark.)

*In re La Peregrina Limited*, 86 USPQ2d 1654, (TTAB 2008) (Likelihood of confusion found between the applicant's mark LA PEREGRINA, which means "pilgrim" in Spanish for "jewellery; precious stones; pearls in loose pieces, pairs and strands; pearl jewellery" and the registrant's mark PILGRIM for "jewelry." The Board took judicial notice of a translation from a standard Spanish-English dictionary indicating that "la peregrina" is translated into English as "the pilgrim." As to the application of the doctrine of foreign equivalents, the Board noted its previous statements that the doctrine is applied when it is likely that "the ordinary American purchaser would stop and translate [the term] into its English equivalent," and that "the ordinary American purchaser" is one who is knowledgeable in English as well as the pertinent foreign language. Based on the evidence of record, the Board had no doubt that Spanish is a common, modern language which is spoken or understood by an appreciable number of

U.S. consumers who also speak or understand English. Various factors supported a finding that these consumers would “stop and translate.”)

*Apple Computer v. TVNET.net, Inc.*, 90 USPQ2d 1393, (TTAB 2007) (The Board granted summary judgment to opposer based on likelihood of confusion of its registered marks ITUNES and ITUNES MUSIC STORE with the applied-for mark VTUNES.net. Applicant’s identified goods were digital video music internet downloads for entertainment purposes, while opposer’s marks covered a wide range of goods and services in the entertainment and telecommunications field, as well as various facilities to enable the programming of multimedia content. The Board found the dominant, non-distinctive portions of the marks – ITUNES and VTUNES – very similar. The Board also found the goods and services closely related, and even overlapping, and noted the shared channel of trade. Finding no genuine issue of material fact, the Board deemed summary judgment on the likelihood of confusion appropriate.)

*Tea Board of India v. Republic of Tea, Inc.* 80 USPQ2d 1880 (TTAB 2006) (Board sustained opposition by Tea Board of India, owner of certification mark featuring the term “DARJEELING” and design for “tea,” against the mark “DARJEELING NOUVEAU,” with “DARJEELING” disclaimed, for “tea,” based upon a likelihood of confusion between the marks. The Board noted when determining likelihood of confusion with respect to certification marks, all of the relevant factors established by the Court in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) apply, with the exception of use of the mark by the registrant. As the registrant does not use a certification mark itself, use of the mark by authorized users of the certification mark is evaluated instead. In arguing against likelihood of confusion, applicant noted that its goods consist entirely of Darjeeling tea and asserted that the genuineness of the goods sold under the mark should be considered, though it acknowledged that such a factor was not dispositive. The Board disagreed, stating “the fact that a user’s products may be genuine, in whole or in part, is simply irrelevant, and is not a defense to a likelihood of confusion claim.” As to the marks themselves, the Board found that the presumption that a geographic term is inherently weak does not attach to geographic terms that are used to certify regional origin. The Board further considered the term “DARJEELING” to be inherently distinctive as a certification mark “as it inherently identifies the geographic source of the tea” and that “[g]enerally, greater protection is afforded to more distinctive marks.” Finally, the Board determined that the evidence of record demonstrated that DARJEELING is a strong mark and noted that the applicant submitted no evidence to the contrary.)

### **Descriptive or Misdescriptive Marks<sup>9</sup>**

*In re Leonhardt*, \_\_\_ USPQ2d \_\_\_, Serial No. 78666879 (TTAB November 13, 2008) (The Board affirmed the §2(e)(1) refusal to register the mark BOBBLE POPS for “candy,” which the record showed was a lollipop candy featuring a bobble head device. Since the applicant disclaimed “BOBBLE,” the issue on appeal was whether “POPS” is descriptive of the goods. The examining attorney’s evidence included third-party

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<sup>9</sup> TMEP §1209



registrations in which “POPS” is either disclaimed or registered on the Supplemental Register, and Internet screenshots showing that “pop” or “pops” is used interchangeably with “lollipop” or “lollipops,” and that “pops” is used in a generic manner to refer to a variety of candy on a stick. The Board took judicial notice of dictionary definition of “lollipop” to mean “a piece of hard candy on the end of a stick.” It determined that the evidence supported the conclusion that “pops” is short for “lollipops” and, therefore, highly descriptive, if not generic, for the applicant’s goods. The applicant argued that “pop” is a shortened form of “popular,” as in “pop art,” “pop music,” “pop singers” or “pop culture,” that it refers to popular characters, celebrities, and athletes whose likenesses are featured on applicant’s goods, and that it is suggestive of applicant’s goods. The Board was not persuaded and, instead, noted the lack of evidence to support the applicant’s interpretation of the term “pops,” and focused on the applicant’s product packaging which described the goods as “Collectible Bobble and Lollipop!”)

*In re BetaBatt, Inc.*, 89 USPQ2d 1152 (TTAB 2008) (Board affirmed refusal of registration of the acronym DEC under §2(e)(1), on the ground that it was merely descriptive of “batteries deriving power from nuclear decay processes,” and related treatment, consulting and technical advisory services. The record included an entry in the AF Acronym Finder and Internet evidence showing use of DEC as an abbreviation for “direct energy conversion,” and evidence that “direct energy conversion” describes a power source and an efficient way of transforming energy into electricity. Applicant argued that there was no evidence that purchasers of hearing aids and other medical devices would know that DEC stands for “direct energy conversion,” but the Board noted that the identification of goods was not limited to these products but instead included all batteries deriving power from nuclear decay processes. The Board also rejected applicant’s argument that consumers would have to “conduct multi-stage reasoning” to determine the characteristics and features of applicant’s products and services, noting that applicant neither described the multi-stage reasoning process nor submitted any evidence to support its argument. The Board further noted that applicant submitted no evidence that the letters DEC would not be readily recognized as an abbreviation of “direct energy conversion.” The Board found that “direct energy conversion” directly describes a feature or characteristic of applicant’s products and services, *i.e.*, that applicant’s products generate power for the decay of radioactive sources and its services are rendered in connection with batteries generating power from the decay of radioactive sources; that DEC is routinely used as an abbreviation for “direct energy conversion;” and that relevant consumers would recognize the abbreviation.)

*In re Noon Hour Food Products, Inc.*, 88 USPQ2d 1172, (TTAB 2008) (The Board affirmed the refusal to register BOND-OST as generic for “cheese.” The Board determined that the genus of goods was aptly described by the identification of goods, and that the relevant class of consumers is ordinary consumers of cheese, including consumers of specialized ethnic cheese. The record included (1) references to the term “Bond-Ost” (as well as “bondost,” “Bondost,” and “Bond Ost”) in books on cheese, cooking, or ethnic foods; (2) evidence relating to use of the term in government and dairy publications, on the Internet, and in newspapers and magazines available to the purchasing public; and (3) evidence of use of the term in the marketplace by cheese

vendors, including online suppliers and deli or cheese counters of supermarkets and specialty shops. The Board concluded the term was generic, finding that others frequently used Bondost and Bond Ost as generic designations and that members of the relevant public understood the mark to refer to a type of cheese, rather than to a particular source of cheese. The applicant argued in the alternative that the mark had acquired distinctiveness as a result of long use and sought registration under §2(f). The Board determined that, should the mark ultimately be found not to be generic, and in spite of nearly a hundred years use in commerce, applicant had failed to make a *prima facie* case of acquired distinctiveness in light of the highly descriptive nature of the mark. Applicant had provided no information about its volume of sales, the amount of money expended for promotion, or its market share, nor any direct evidence that the majority of the relevant consumers viewed “Bond-Ost” as a source identifier. Taking into consideration the entire record, the Board stated that applicant had failed to make a sufficient showing of acquired distinctiveness.)

*In re Tokutake Industry Co., Inc.*, 87 USPQ2d 1697, Serial No. 79018656 (TTAB 2008) (The Board affirmed §2(e)(1) refusal to register the mark shown below for “footwear.”

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A Y U M I

The Western and Japanese characters represent the same term, AYUMI, which applicant translated as “walking, a step.” Thus the Board found the term to be merely descriptive since footwear would include all types of footwear including walking shoes. In determining whether the doctrine of foreign equivalents applied, the Board found that Japanese is a modern language spoken by hundreds of thousands of people in the United States and that no evidence was provided that the relevant American purchaser who speaks Japanese would not stop and translate the mark. Since the mark is translated into “walking,” the descriptiveness refusal was proper.)

*In re Tea and Sympathy, Inc.*, 88 USPQ2d 1062, (TTAB 2008) (The Board reversed a refusal to register, concluding that the mark “THE FARMACY” is *not* merely descriptive of “retail store and online retail store services featuring natural herbs and organic products and integrated health services at retail locations in the nature of dietary and nutritional guidance and information about dietary supplements and nutrition.” The examining attorney argued that the proposed mark merely describes the place where the services are provided, *i.e.* an environment that is essentially a “pharmacy” and that applicant’s mark is merely a different spelling for “pharmacy” which does not diminish the descriptiveness of the term. The record included: dictionary definitions of pharmacy, Internet articles and third party websites showing that pharmacies sell products such as herbal items and natural items for medicinal purposes, and applicant’s own advertisements that discussed the goods being sold by applicant as medicinal in nature. Applicant alleged, however, that the mark has a double meaning; it connotes that applicant’s services are for products that come from a “farm setting”. The applicant alleged that the mark is a play on the words “pharmacy” and “farm” meant to connote the idea that applicant is selling “farm fresh, natural, pure and completely unprocessed products.” The Board agreed with the applicant and noted that applicant’s mark is

“clever enough, being an obvious play on “the pharmacy” and “farm” so that the meaning or commercial impression of the mark is more than simply “the pharmacy”.)

*In re ic! berlin brillen GmbH*, 85 USPQ2d 2021 (TTAB 2008) (The Board affirmed the refusal to register a product configuration mark under Trademark Act §§1, 2 and 45, finding that the applicant had failed to provide sufficient evidence of acquired distinctiveness under Section 2(f). The applicant’s goods consisted of “spectacles, sunglasses,” with the applied-for mark comprising “three ‘fingers’” near the hinge that connects the earpiece with the eyeglass frame, which resembled an “asymmetrical fork.” The Board found that the applied-for mark had not become distinctive of applicant’s eyewear chiefly because of the “absence of evidence of the advertising and/or promotion by applicant of the earpiece design as a trademark.” The Board determined that the ultimate purchasers would view this particular feature as nothing more than a component of the eyeglass/sunglass frame. In addition, although applicant argued that eyewear manufacturers “use the earpiece to display their trademarks,” the Board concluded that “there [was] no evidence . . . to support applicant’s contention” and that, in any case, the display of “word and logo marks are different in nature from applicant’s earpiece design.” With respect to applicant’s §2(f) evidence, the Board found the following: The promotional materials and advertisements for the goods did not mention or reference the applied-for mark; the ten uniformly worded declarations from opticians claiming that the design serves as a source indicator and that customers ask for the eyewear by the earpiece design were entitled to “some weight,” but were found to relate to only an “extremely small number of the purchasing public;” the sales and advertising figures were “not especially impressive” even though applicant had failed to provide information regarding the size of its sales relative to competitors; however, even presuming that millions of persons in the U.S. wear eyeglasses/sunglasses, the sale of 40,000 units in five years would represent a small portion of the total eyewear sales; and applicant’s declaration of exclusive and continuous use for five years was “insufficient to establish acquired distinctiveness” given the absence of any evidence of promotion of the configuration as a mark and applicant’s rather limited market share.)

*In re Bayer Aktiengesellschaft*, 488 F.3d 960 , 82 USPQ2d 1828 (Fed. Cir. 2007) (The Court affirmed the Board’s ruling that the mark, ASPIRINA, is merely descriptive for analgesic goods. The court held that despite the conflicting nature of the evidentiary record, which supported both registration and refusal of registration, the Board’s decision was supported by substantial evidence. The examining attorney had submitted dictionary definitions, Spanish/English translations, NEXIS excerpts (both domestic and foreign publications) and a GOOGLE search report showing use of the term, ASPIRINA, as aspirin. In response, Bayer provided its own dictionary evidence that referred to ASPIRINA as a trademark, and pointed to its numerous foreign trademark registrations. However, the court determined that Bayer’s registrations of ASPIRINA, only in Spanish speaking countries, are not legally or factually relevant to consumer perception of the mark in the United States. Additionally, contrary to the Board’s finding, the court concluded that foreign publications carry “some probative value” in discerning US consumer impression of a proposed mark. The court found that consumers were exposed to ASPIRINA as the equivalent of the generic English term for aspirin, as well as to

identify Bayer's analgesic goods. Thus, the evidentiary record was conflicting as to the mere descriptiveness of ASPIRINA as a variation or misspelling of aspirin, as concluded by the Board. However, the court concluded that the issue of descriptiveness is a factual finding, and that the Board's fact finding is reviewed not *de novo*, but under the deferential "substantial evidence standard," set forth as "such relevant evidence as a reasonable mind might accept as adequate to support a conclusion." *Consol. Edison Co. v. N.L.R.R.*, 305 US 197, 229 (1938). The court held "[w]here two different conclusions may be warranted based on the evidence or record, the Board's decision to favor one conclusion over the other is the type of decision that must be sustained by substantial evidence.")

*In re Pennington Seed, Inc.*, 466 F.3d 1053, 80 USPQ2d 1758 (Fed. Cir. 2006), *aff'g In re KRB Seed Co., LLC*, 76 USPQ2d 1156 (TTAB 2005) (The Court affirmed the Board's holding that REBEL is the generic designation for a variety of grass seed. The Board had held that the longstanding USPTO policy of treating varietal names as generic terms is valid and in accord with the Plant Variety Protection Act (7 U.S.C. §2422) (PVPA), the International Convention for the Protection of New Varieties of Plants (UPOV), and with case law since 1942. In affirming, the court noted that applicant had previously designated the term as the varietal name for a grass seed that was the subject of a plant variety protection certificate, and held that "having designated the term "Rebel" as the varietal name for grass seed and having failed to associate any additional word with the Rebel grass seed that would indicate the seed's source, Applicant here is prohibited from acquiring trademark protection for the generic and only name of that variety of grass seed.")

*In re The Black & Decker Corporation*, 81 USPQ2d 1841, (TTAB 2006) (The Board allowed registration of the design of a key head under §2(f), finding that applicant's evidence was sufficient to establish a *prima facie* case of acquired distinctiveness. The Board found that (1) applicant used the mark continuously for twenty-four years; (2) the key head design was prominently displayed in advertising, promotional materials, and lapel pins worn by salespersons; and (3) applicant's sales and advertising figures were substantial. The Board gave particular consideration to industry practice, noting applicant's evidence that it is common for manufacturers of door hardware to use key head designs as source indicators and that its design was unlike the designs used by other manufacturers. The Board also noted that the record contained no evidence to rebut applicant's position (i.e., evidence of use of very similar designs by others). The Board determined that the absence of "look for" advertising or promotion was not a critical factor in this case and that the totality of the evidence was competent to show consumer recognition of the design as a trademark.)

*Tea Board of India v. Republic of Tea, Inc.* 80 USPQ2d 1881 (TTAB 2006) (Board sustained opposition by Tea Board of India, owner of certification mark featuring the term "DARJEELING" and design for "tea," against the mark "DARJEELING NOUVEAU," with "DARJEELING" disclaimed, for "tea." As part of its counterclaim against the opposer, applicant asserted that the term "DARJEELING" was generic and sought cancellation of opposer's mark. In considering the merits of the counterclaim, the

Board, referencing *Institut National Des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875 (TTAB 1998), noted “[a] certification mark used to certify regional origin will not be deemed to have become a generic term as applied to particular goods unless it has lost its significance as an indication of regional origin of those goods.” The Board stated it was “applicant’s burden to demonstrate by a preponderance of the evidence that DARJEELING is generic or that it has become generic as a result of opposer’s failure to exercise control over use of the mark,” and after extensive review of the evidence of record, including applicant’s telephone survey of 301 respondents, found “insufficient probative evidence” of record to establish genericness, and dismissed applicant’s cancellation counterclaim.)

### **Geographically Descriptive<sup>10</sup>**

*In re Spirits of New Merced, LLC*, 85 USPQ2d 1614, (TTAB 2007) (The Board affirmed the refusal to register YOSEMITE BEER, with BEER disclaimed, for alcoholic beer, on the ground that it is primarily geographically descriptive of the goods, which are manufactured and sold at applicant’s brewpub in Merced, California, 80 miles away from Yosemite National Park. The Board rejected applicant’s arguments that Yosemite does not refer to a geographic location, finding instead that the word is shorthand for Yosemite National Park and the surrounding region. The Board was similarly unpersuaded by arguments that in the context of the mark, YOSEMITE would be perceived as a reference to the “theme” of the brewpub, or as the word for “those who kill” in the Native American Miwok tribal language from which the word derives, noting that the overwhelming evidence showed that consumers would perceive the word as a reference to the park and its surrounding region. In addressing applicant’s contentions that the USPTO registered a number of other “Yosemite” marks without a §2(f) claim, including for the same or similar goods, the Board distinguished some cited registrations, and generally noted that the USPTO is not bound by these prior determinations, and must decide registrability in each case on its own merit. On appeal, applicant argued that its goods do not come from Yosemite, because applicant’s brewpub where the beer is made and sold is located in Merced, California. However, the Board noted and agreed with applicant’s own contentions and evidence – offered earlier in the prosecution – that Merced is “physically and historically linked to and associated with the nearby Yosemite National Park.” The Board held that the goods/place association may be presumed in cases such as this, where the geographic location is not obscure and applicant’s goods come from the place.)

### **Geographically Deceptively Misdescriptive<sup>11</sup>**

*Corporacion Habanos, S.A. v. Anncas, Inc.*, 88 USPQ2d 1785, (TTAB 2008) (The Board sustained an opposition under §2(e)(3) to the mark HAVANA CLUB for “cigars made from Cuban seed tobacco.” Considering each of the three elements of a §2(e)(3) claim in turn, the Board first concluded that opposer had established that Havana is known to the relevant public as a geographic location, and that the primary significance of the overall

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<sup>10</sup> TMEP §1210

<sup>11</sup> TMEP §1210.01(b)

mark HAVANA CLUB was geographic. Turning to the second element, the Board concluded that the consuming public was likely to believe the mark identified the origin or the goods when it did not. While recognizing that the goods/place association was not in dispute, the Board noted as an aside that opposer's evidence had also established the connection. On the central issue of the case, whether applicant's "cigars made from Cuban seed tobacco" should be deemed to originate from Havana, Cuba, even though they will be made elsewhere, the Board found an insufficient nexus arising out of the uncontroverted testimony that "Cuban seed tobacco" descended from tobacco seeds taken decades ago from Cuba. Turning to the final element of the 2(e)(3) claim, the Board found that the misleading goods/place association would be material in a customer's decision to purchase applicant's goods in light of evidence establishing that cigars are a principal product of Havana, and that the desirability of cigars from Havana is world renowned.)

*Corporacion Habanos, S.A. v. Guantanamera Cigars Company*, 86 USPQ2d 1473, (TTAB 2008) (The Board sustained the opposition to registration of GUANTANAMERA for cigars and smokers' articles as geographically deceptively misdescriptive under §2(e)(3), concluding that the primary significance of the term was geographic, in light of the meaning likely ascribed by Spanish-speaking U.S. consumers, "of or from Guantanamo, Cuba" or "a female from Guantanamo." The Board discounted other meanings of the term proffered by the applicant, concluding that none of them would be widely-known to relevant consumers. As to the second prong, the Board found a goods-place association, noting opposer's testimony that tobacco is grown in the providence of Guantanamo, as well as evidence of Cuba's renown for tobacco and cigars, and the fact that applicant had sought to foster a false association between its tobacco products and Cuba. And as to the final prong, the Board concluded that given Cuba's reputation for high-quality cigars, the goods-place association was material to a consumer's decision to purchase applicant's goods.)

*In re Cheezwhse.com, Inc.*, 85 USPQ2d 1917, (TTAB 2008) (The Board affirmed the refusal to register NORMANDIE CAMEMBERT for cheese, for failure to comply with the examining attorney's Rule 2.61(b) requirement for information as to the geographic origin of the goods, on the ground that the mark is primarily geographically descriptive of the goods, and on the alternative ground that the mark is primarily geographically deceptively misdescriptive of the goods. Regarding the misdescriptiveness refusal, though registration had been refused under both §§2(a) and 2(e)(3), the Board noted that the proper basis for refusal in this case was §2(e)(3). The Board noted that, despite repeated requests, the applicant had neither complied with nor acknowledged the Rule 2.61(b) requirement. In light of this inexcusable failure to provide the requested information, the Board made two adverse presumptions. With respect to the refusal under §2(e)(2), the Board presumed that the goods did, or would, originate in the place named in the mark. As to the alternative refusal under § 2(e)(3), the Board presumed that applicant's goods did not, or would not, come from the place named in the mark. As to the refusal under §2(e)(2), based on the evidence of record, the Board found that (1) "Normandy" is the name of a generally known geographic place in France; (2) NORMANDIE is the French spelling for Normandy; and (3) consumers would

recognize NORMANDIE as the equivalent of Normandy. The Board rejected applicant's argument that the primary significance of the term NORMANDIE was that of the former ocean liner SS NORMANDIE. Moreover, given that CAMEMBERT is a generic term for applicant's goods, the primarily geographic significance of the term NORMANDIE was not overcome by the addition of the generic word. As noted above, the Board presumed that the goods did or would originate from Normandy, which led to the presumption that a goods/place association existed between cheese and Normandy. Regardless of the actual origin of applicant's goods, however, the evidence of record indicated that Normandy was famous for cheeses, and for Camembert in particular, thereby establishing the existence of a goods/place association. When it turned to the alternative refusal under §2(e)(3), the Board found that the primary significance of the mark was that of a generally known geographic location for the same reasons discussed in connection with the §2(e)(2) refusal. As discussed above, the Board deemed it appropriate to presume that applicant's goods would not originate in or from Normandy. To determine whether this misrepresentation as to the origin of the goods would be material to the decision to purchase, the Board turned to the evidence used to establish a goods/place association. Because it demonstrated that cheese is a principal product of Normandy, and that Normandy is famous for its cheeses, the same evidence was also sufficient to establish the materiality element of the §2(e)(3) refusal.)

*In re South Park Cigar, Inc.*, 82 USPQ2d 1507 (TTAB 2007) (YBOR GOLD (standard characters) held geographically deceptively misdescriptive for "cigars, pipe tobacco and roll-your-own tobacco." The evidence indicated that Ybor, short for Ybor City, was a geographic area of Tampa, Florida. The record included travel guides and local papers using the shortened Ybor to define the geographic area of Ybor City. The evidence showed that the city was named after a Spanish cigar maker who arrived in the city in 1886 and started a very successful cigar business. By the early 1900's, Ybor was considered the "cigar capital of the world." Several travel guides, including *Frommer's* and *Fodor's*, discussed the history of the city, the tours of the city, its connection with cigar making, and how it is currently "one of the best places in Florida to buy hand-rolled cigars." Web-site evidence discussed the "Ybor cigar industry" and identified the numerous "cigar stores, manufacturers, retailers, and sidewalk cart vendors" still in the city. The TTAB concluded that the area had prominence as both a current and a historical source of cigars, and that a cigar aficionado who knew of the Ybor history would mistakenly believe that the goods come from Ybor. The TTAB found use of "Gold" did not change the primary geographic significance of the mark, concluding that "Gold" was highly suggestive and laudatory for the goods.

One principal argument raised by the applicant was that the mark was not misdescriptive because the goods "would come" from the area (the application was based on an intent to use the mark). The TTAB rejected that argument. The applicant's address in the application was Ohio and it was never changed. While the applicant asserted it was relocating to "Tampa," the TTAB concluded that just saying applicant was relocating to "Tampa" did not mean that they would be within the boundaries of Ybor, noting that any assertion by applicant that it would be located in Ybor City was "conspicuously absent."

*United States Playing Card Company v. Harbro, LLC*, 81 USPQ2d 1537 (TTAB 2006) (The Board dismissed an opposition to registration of the mark VEGAS for “playing cards” on the grounds that the mark is deceptive under §2(a), and primarily geographically descriptive or primarily geographically deceptively misdescriptive under §§2(e)(2) or 2(e)(3), respectively. As an initial matter, the Board noted that the test for determining whether a mark is geographically deceptive under §2(a) is the same as determining whether a mark is primarily geographically deceptively misdescriptive under §2(e)(3), and therefore addressed only the question of whether the mark VEGAS is primarily geographically deceptively misdescriptive under §2(e)(3).

Turning to the §2(e)(2) claim, the Board noted that in the case *sub judice*, opposer had not tried to prove that applicant’s playing cards were made or sold in Las Vegas. Indeed, the record included opposer’s own deposition testimony that applicant’s playing cards were printed in China, while applicant is located in Michigan, as well as testimony that all playing cards used in Las Vegas are manufactured elsewhere. Accordingly, the only issue actually before the Board, and the only one the parties argued, was whether the mark VEGAS is primarily geographically deceptively misdescriptive under §2(e)(3) when applied to playing cards. The Board found that it was not.

Based on the evidence of record, which included an entry from a geographical dictionary, the Board found that opposer clearly demonstrated that VEGAS is an abbreviation for Las Vegas, Nevada, and that Las Vegas, Nevada is a generally known geographic location, satisfying the first prong of the three-part test under Section 2(e)(3). Turning to the second prong of the test, proof of a goods-place association, the Board found that, while there was no evidence establishing a direct association between playing cards and Las Vegas, due to the association of Las Vegas with casinos and gambling, and the association of gambling with playing cards, consumers may associate playing cards with Las Vegas, citing *In re Save Venice New York Inc.*, 259 F. 3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001).

Finally, in considering the last prong of the test, the Board found that opposer had failed to show that the misleading goods-place association was a material factor in the customer’s decision to purchase applicant’s playing cards. The Board noted that to raise an inference of materiality to support the statutory requirement of deception, opposer must show a heightened association between the goods and the geographic location. Opposer failed to make such a showing. While acknowledging the evidence of a market for used playing cards from casinos, the Board found no evidence of a market for playing cards specifically made or used in Las Vegas. Accordingly, the goods-place association between the playing cards and VEGAS is merely indirect, and not “so strong that the Board may presume that the geographical connection between the place and the goods led to the consumer’s decision to purchase the goods,” as opposer had alleged.)

*In re Brouwerij Nacional Balashi NV*, 80 USPQ2d 1820, (TTAB 2006) (Board reversed refusal of registration of BALASHI BEER under §2(e)(2) on the ground that it was primarily geographically descriptive of beer originating in Balashi, Aruba. The Board



found Balashi so obscure or remote that purchasers of beer in the United States would fail to recognize it as indicating the geographical source of applicant's goods.)

### **Surname**<sup>12</sup>

*In re Yeley*, 85 USPQ2d 1150 (TTAB 2007) (The Board reversed the refusal of registration under §2(e)(4), holding that the examining attorney failed to meet the burden of establishing a prima facie case that J. J. YELEY, used on a variety of goods, is primarily merely a surname. Based on the evidence of record, which comprised listings from the LexisNexis phone directory and from a website, the Board concluded that Yeley is a rare surname and the primary significance of J. J. YELEY is as a personal name and the identity of a race car driver.)

*In re Piano Factory Group, Inc.*, 85 USPQ2d 1522 (TTAB, 2006) [re-designated as precedential] (The Board affirmed the refusal to register the mark "VOSE & SONS" as primarily merely a surname. The Board observed that the proper starting point for its surname analysis was *In re Hamilton Pharmaceuticals, Ltd.*, 27 USPQ2d 1939 (TTAB 1993). This decision places the burden on the examining attorney to establish a *prima facie* case that the primary significance of the mark to the purchasing public is that of a surname. The Board agreed with the examining attorney that the record contained sufficient evidence to establish a *prima facie* case, and that the term "VOSE" would have surname significance irrespective of whether or not it is regarded as a "rare" surname or anyone with the name was presently associated with applicant. The Board also concluded that the addition of the wording "& SONS" does not distinguish or relate to anything other than the surname that precedes such notation as it "serves only to emphasize or reinforce that 'VOSE' is the surname of the sons' parents.")

*In re Joint-Stock Company "Baik,"* 84 USPQ2d 1921, (TTAB, 2007) (Board reversed refusal of registration under §2(e)(4), holding that the examining attorney failed to meet the burden of establishing a prima facie case that BAIK, used on vodka, is primarily merely a surname. The Board concluded that Baik was an extremely rare surname, finding that evidence from the Verizon superpages.com database showing 456 individuals whose surname is "Baik," together with four stories, one financial abstract and four "screenshots" from Lexis/Nexis fell "far short" of establishing that the name Baik is well recognized as a surname. While there was no evidence that the term has any recognized meaning other than that of a surname, the Board found that the evidence supported applicant's contention that Baik "sounds like a Russian language term," and that it also sounds similar to "Baikal," which has a recognized geographic significance, denoting a lake and mountain range in the Siberian region of Russia.)

*In re Thermo LabSystems Inc.*, 85 USPQ2d 1285, (TTAB 2007). (WATSON held to be primarily merely a surname under §2(e)(4) for "computer software for use in laboratory information management, namely, software used in analyzing, reporting, and tracking pharmaceutical drug study sample data for regulatory compliance." The TTAB looked to four factors in its surname analysis: (1) whether the surname is rare; (2) whether anyone

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<sup>12</sup> TMEP §1211

connected with the applicant has the involved term as a surname; (3) whether the term has any other recognized meaning; and (4) whether the term has the “look and feel” of a surname. The Board concluded that the evidence of record showed that three of the four factors favor a determination that the primary significance of the mark WATSON to the purchasing public is that of a surname. The fact that no one connected with the applicant had WATSON as a surname made that factor neutral. The examining attorney’s evidence included: over 81,000 residential listings for the surname WATSON; various web pages identifying famous persons with the surname WATSON; web pages identifying WATSON as a common surname; one web page identifying WATSON as one of the “Most Common Surnames Used Today;” and web pages stating that over 250,000 persons have WATSON as a surname in the U.S. The applicant alleged that WATSON had other recognized meanings, but the Board held that while there is some geographical and given-name significance for the term WATSON, the record reflects that the surname significance of WATSON is far more common and predominates.)

### **Functional Matter**<sup>13</sup>

*Saint-Gobain Corporation v. 3M Company*, 90 USPQ2d 1425, (TTAB 2007) (Applicant sought registration of a mark consisting of a shade of purple as applied to the entirety of the rough side of “sandpaper, namely, coated abrasives with either paper or cloth backing.” As marks consisting of a particular color are not inherently distinctive, *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 211-212, 54 USPQ2d 1065, 1068 (2000) (citing *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 162-163, 34 USPQ2d 1161, 1162-1163 (1995)), applicant claimed acquired distinctiveness. Opposer Saint-Gobain Corporation challenged applicant’s claim of acquired distinctiveness and alleged that the color was functional with respect to the identified goods, and therefore not registrable. With regard to the issue of acquired distinctiveness, the Board found that there was little direct evidence of record of customer recognition, and that applicant’s circumstantial evidence, consisting of advertisements from various trade magazines promoting the color purple and testimony from four non-expert witnesses, was unconvincing. Opposer’s evidence included proof of third-party use of purple as well as the existence of color coding systems for abrasive coatings. The opposition was sustained for applicant’s failure to establish that its mark had acquired distinctiveness. In the alternative, the Board considered the issue of whether the applicant’s mark was functional, an absolute bar to registration. Opposer alleged that the color purple “is a by-product of the manufacturing process, and purple is used in color-coding.” The Board remarked that the present case differed from most color functionality cases, noting that the manufacturing process for the identified goods results in products with numerous colors and that manufacturers tend to dye their products for various reasons, including to maintain a uniform appearance. In typical color cases, the final color is dictated by aesthetic considerations. In the coated abrasives field, color is common with several factors affecting the final color, including the color of the backing material, the filler or grit material used in manufacturing. Opposer maintained, and the Board agreed, that “[d]yeing coated abrasives a dark color has the functional use of concealing imperfections like cracking and streaking.” The Board also found that the

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<sup>13</sup> TMEP §1202.02(a)

opposer's evidence established that color coding of coated abrasives was common and that color is often used to indicate grit size. "Indeed, applicant itself uses color coding for its abrasive products." The Board held that applicant had not rebutted opposer's *prima facie* case that there was competitive need for others to use the color purple with respect to the identified goods. "When color is so subject to variables that applicant itself needs to sell its own 'distinct' shade of purple in a different shade of purple, it would place competitors at a disadvantage if they were forced to vary their production techniques and research to avoid subjecting themselves to claims of infringement by a company that cannot consistently market its own product with the same distinctive shade of purple." Accordingly, the Board sustained the opposition on the ground of functionality.)

*In re Howard Leight Industries, LLC*, 80 USPQ2d 1507, (TTAB 2006) (Board affirmed the functionality-based refusal of registration of an earplug configuration used on "earplugs for noise protection formed of slow recovery resilient foam material." Applicant described the proposed mark as "a bullet-shaped earplug with a vertical axis, a rounded bottom, and a radially outwardly flared top.")

The Board found that applicant's expired utility patent, which specifically disclosed and claimed the utilitarian advantages of the shape depicted and described in the subject application, was such strong evidence of functionality that it was a sufficient basis in itself for finding the configuration functional. The Board found that the patent evidence outweighed contrary evidence that might support a finding of non-functionality, given the strong weight to be accorded such patent evidence under *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58 USPQ2d 1001 (2001). There was no evidence that applicant touts the utilitarian advantages of its earplug design, and there was some evidence of the availability of alternative designs, but the Board found this insufficient to overcome the evidence of functionality of the design as specifically disclosed and claimed in the patent.

The Board looked to applicant's utility patent as a whole, noting that the claims in a patent are strong evidence of functionality, and that it is also proper to look to the disclosure elsewhere in the patent. The Board noted that: the cylindrical shape "serves an essential functional, i.e., it allows the body of the earplug to directly contact the surface of the human ear canal, which likewise is cylindrical in shape;" the flanged or flared rear end of the earplug is essential to the proper functioning of the earplug, because it reduces the possibility of deep insertion into the ear, and it reduces the difficulty of removing the earplug; the bullet-shaped main body is one of only a few possible reasonable variations of the cylindrical shape repeatedly claimed and disclosed in the patent; and both the disclosures and the claims of the patent reveal that the shape of the earplug serves an essential function in the use of the earplug, and affects its quality.

The Board also held that even if applicant were to appeal and ultimately prevail on the issue of functionality, the earplug configuration would still be unregistrable because applicant had not established that it had acquired distinctiveness under §2(f).)

**Ornamental**<sup>14</sup>

*In re Pro-Line Corp.*, 28 USPQ2d 1141 (TTAB 1993) (holding the wording BLACKER THE COLLEGE SWEETER THE KNOWLEDGE to be a primarily ornamental slogan that is not likely to be perceived as source indicator for t-shirts).

*In re Villeroy & Boch S.A.R.L.*, 5 USPQ2d 1451 (TTAB 1987) (holding floral pattern design of morning glories and leaves for tableware nondistinctive and merely a decorative pattern with no trademark significance)

**Failure to Function as a Trademark or Service Mark**<sup>15</sup>

*In re DSM Pharmaceuticals, Inc.* 87 USPQ2d 1623, (TTAB 2008) (The Board affirmed the refusal to register under Trademark Act §§1, 2, 3, and 45 the proposed mark LIQUIDADVANTAGE for “custom manufacturing of pharmaceuticals featuring liquid fill and finish technology,” holding that the specimen of record (copied below) only showed use as the name of a software product, not as a service mark. The Board noted that the case was analogous to *In re Walker Research, Inc.*, 228 USPQ 691 (TTAB 1986), where it had affirmed a refusal to register a service mark because the specimen clearly referred to a software product, not to the service for which the applicant sought registration. In *Walker*, the Board had found it irrelevant that the software was used in the performance of the service, holding that “without direct association between the service and the proposed mark in the specimen, the Board could not conclude that the service mark was in use”).

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<sup>14</sup> TMEP §1202.03.

<sup>15</sup> TMEP §1202



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*In re Right-On Co., Ltd.*, 87 USPQ2d 1152 (TTAB 2008) (The Board affirmed the ornamentation-based refusals to register the pocket-stitching designs shown below for various articles of clothing, including jeans, shirts, footwear and headgear.



With arguments and evidence focusing exclusively on the jeans, the Board applied the *Seabrook* factors to conclude that the marks are not inherently distinctive. Given the evidence that pocket-stitching is a prevalent form of ornamentation in the jeans industry, the Board found that a “mere refinement” in this common basic design cannot be inherently distinctive. The Board further found that the size, dominance and mirror image pattern of the designs weighed in favor of ornamentation. The Board discounted the evidence of a number of pocket-stitching registrations on the Principal Register and a number on the Supplemental Register or under §2(f) as indicating nothing more than that sometimes such designs have been deemed inherently distinctive and sometimes not. Addressing the Office’s usual practice of not making ornamentation refusals in ITU cases until the SOU is filed, the Board distinguished §66(a) cases where no specimens need be filed prior to registration. Accordingly, the Board held that with §66(a) cases, “it is appropriate for examining attorneys to issue an ornamentation refusal if the mark is decorative or ornamental on its face as depicted on the drawing page and described in the description of the mark.”)

*In re Roberts*, 87 USPQ2d 1474, (TTAB 2008) (The Board upheld a refusal for failure to function as a mark under Trademark Act §§1, 2, 3 and 45 where applicant’s specimens only showed the wording IRESTMYCASE used as part of a website address along with other informational matter. The web address [www.irestmymcase.com](http://www.irestmymcase.com) appeared on applicant’s letterhead beneath her address, telephone and fax numbers, and it appeared in two places in a message board profile as part of her contact information. Finding the case of *In re Eilberg* 49 USPQ2d 1955 (TTAB 1999) controlling, the Board said the usage on applicant’s letterhead “clearly is intended to indicate the address for applicant’s website, and its position at the end of applicant’s other contact information reinforces this impression.” The Board said both uses on the message board “indicate that [www.irestmymcase.com](http://www.irestmymcase.com) is one of applicant’s websites.” The Board found that in neither specimen is [www.irestmymcase.com](http://www.irestmymcase.com) used to indicate the source of applicant’s legal services. While noting that usage as a website address does not *per se* preclude a term from serving as a source identifier, the Board said that for such a designation to function as a mark, applicant must first take the necessary actions to use it as such. The wording that is part of the web address must be used in such a manner that it is perceived as a mark.)

### **Trade Name<sup>16</sup>**

*In re Diamond Hill Farms*, 32 USPQ2d 1383 (TTAB 1994) (DIAMOND HILL FARMS, as used on containers for goods, found to be a trade name that identifies applicant as a business entity rather than a mark that identifies applicant’s goods and distinguishes them from those of others).

*In re Unclaimed Salvage & Freight Co., Inc.*, 192 USPQ 165, 168 (TTAB 1976) (“It is our opinion that the foregoing material reflects use by applicant of the notation ‘UNCLAIMED SALVAGE & FREIGHT CO.’ merely as a commercial, business, or trade name serving to identify applicant as a viable business entity; and that this is or would be the general and likely impact of such use upon the average person encountering this material under normal circumstances and conditions surrounding the distribution thereof.”).

*In re Lytle Engineering & Mfg. Co.*, 125 USPQ 308 (TTAB 1960) (“‘LYTLE’ is applied to the container for applicant’s goods in a style of lettering distinctly different from the other portion of the trade name and is of such nature and prominence that it creates a separate and independent impression.”)

*In re Univar Corp.*, 20 USPQ2d 1865, 1869 (TTAB 1991) (“[T]he mark “UNIVAR” independently projects a separate commercial impression, due to its presentation in a distinctively bolder, larger and different type of lettering and, in some instances, its additional use in a contrasting color, and thus does more than merely convey information about a corporate relationship.”)

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<sup>16</sup> TMEP §1202.01

**Phantom Marks**<sup>17</sup>

*In re International Flavors & Fragrances Inc.*, 183 F.3d 1361, 51 USPQ2d 1513 (Fed. Cir. 1999) (The applicant filed three applications to register the designations “LIVING xxxx,” “LIVING xxxx FLAVOR,” and “LIVING xxxx FLAVORS,” for essential oils, flavor substances, and fragrances. Each application included a statement that “[t]he meaning of ‘xxxx’ is for a specific herb, fruit, plant or vegetable.” In upholding the refusal of registration, the Federal Circuit noted that under §22 of the Trademark Act, 15 U.S.C. §1072, registration serves as constructive notice to the public of the registrant’s ownership of the mark and, therefore, precludes another user from claiming innocent misappropriation as a trademark infringement defense. To make this constructive notice meaningful, the mark as registered must accurately reflect the mark that is used in commerce, so that someone who searches the register for a similar mark will locate the registration. The court stated that “phantom marks” with missing elements “encompass too many combinations and permutations to make a thorough and effective search possible” and, therefore, the registration of these marks does not provide adequate notice to competitors and the public. *International Flavors*, 51 USPQ2d at 1517-18.

**Matter Protected by Statute or Convention: Special Symbols, Emblems, Seals, Insignia, Badges and Names of Special Organizations**<sup>18</sup>

*U.S. Olympic Committee v. Toy Truck Lines Inc.*, 237 F.3d 1331, 57 USPQ2d 1380 (Fed. Cir. 2001); *O-M Bread, Inc. v. U.S. Olympic Committee*, 65 F.3d 933, 36 USPQ2d 1041 (Fed. Cir. 1995); *U.S. Olympic Committee v. Intelicense Corp., S.A.*, 737 F. 2d 263, 222 USPQ 766 (2d Cir. 1984), *cert. denied* 469 U.S. 982 (1984); *U.S. Olympic Committee v. Union Sport Apparel*, 220 USPQ 526 (E.D. Va. 1983); *U.S. Olympic Committee v. International Federation of Body Builders*, 219 USPQ 353 (D.D.C. 1982); *Stop the Olympic Prison v. U.S. Olympic Committee*, 489 F. Supp. 1112, 207 USPQ 237 (S.D.N.Y. 1980).

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<sup>17</sup> TMEP §1214

<sup>18</sup> TMEP §1205.01