

THE TRADEMARK YEAR IN REVIEW:

**2005 Trademark Decisions of
The Court of Appeals for the Federal Circuit
and
The Trademark Trial & Appeal Board**

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For each case 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>.

GENERICNESS

***In re Eddie Z's Blinds and Drapery, Inc.*, 74 USPQ2d 1037 (TTAB 2005)**

Applicant filed for registration of BLINDSANDDRAPERY.COM on the Supplemental Register as a mark for services for distributing and selling blinds, draperies, and other wall coverings. Registration was refused on the ground that the proposed mark is generic in connection with the identified services. This appeal followed. Numerous third party registrations, article excerpts, and web pages were used to show the genericness of “blinds and drapery.” The evidence showed that the term “blinds and drapery” is used as the name or designation for a class of products and that businesses refer to themselves or are referred to by others as “blinds and drapery” businesses. As a result, the refusal to register BLINDSANDDRAPERY.COM on the Supplemental Register on grounds that the mark is generic is affirmed.

***In re Steelbuilding.com*, 75 USPQ2d 1420 (Fed. Cir. 2005)**

Applicant filed an intent-to-use application to register the mark STEELBUILDING.COM for use in selling pre-engineered metal buildings and roofing systems and providing interactive unique design services on line. The Board affirmed rejection of the mark, finding that STEELBUILDING.COM is generic for selling pre-engineered metal buildings over the Internet. The Board, however, ignored the interactive design feature of the website. The Board also did not adequately consider potential multiple meanings of the mark; it only considered “steel buildings,” but not “the building of steel structures.” Finally, the Board ignored the addition of the top level domain indicator “.com.” Therefore, the court vacated the Board’s determination that the mark is generic. However, the mark is merely descriptive because consumers would recognize the word “STEELBUILDING” as conveying the same impression as the phrase “steel buildings.” Finally, the mark had not acquired distinctiveness or a secondary meaning. Refusal to register is vacated-in-part and affirmed-in-part.

***In re KRB Seed Co.*, 76 USPQ2d 1156 (TTAB 2005)**

Applicant filed an application to register the mark REBEL for grass seed. The examining attorney refused to register the mark on the ground that it is a varietal (or cultivar) name for applicant's grass seeds, and such names are generic designations. Applicant did not deny that the mark is a varietal name for a type of grass seed and was the subject of a plant variety protection certificate. Applicant argued that the Board should overturn the PTO's application of prior case law treating varietal names as generic terms. After reviewing prior case law on the subject, the Plant Variety Protection Act, and the International Convention for the Protection of New Varieties of Plants, in which the U.S. is a member, the Board rejected applicant's argument for a change in the law. The Board concluded by commenting that all of the prior law implement the "common sense notion" that when a new plant is created it must be called something, and that when others begin to sell it after expiration of the breeder's protection period the need to call it by the name that it is known by or otherwise consumers will not know what they are buying. Refusal to register is affirmed.

LIKELIHOOD OF CONFUSION

***Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d 1689 (Fed. Cir. 2005)**

Applicant, Palm Bay, appeals from the TTAB's decision refusing to register the mark VEUVE ROYALE for sparkling wine on the ground of likelihood of confusion with Veuve Clicquot Ponsardin's ("VCP") marks VEUVE CLICQUOT PONSARDIN, VEUVE CLICQUOT, and THE WIDOW. VEUVE is considered an arbitrary term as applied to champagne and sparkling wine, and thus is strong as a trademark. Because the common term among the marks is distinctive, its presence in both parties' marks enhances the likelihood of confusion. Moreover, the strength of VCP's marks is not undermined by the third-party use of VEUVE because it is not likely that the consuming public is aware of third-party use of the term. In addition, both general consumers and sophisticated purchasers could easily conclude that VEUVE ROYALE was VCP's sparkling wine. Finally, applying the doctrine of foreign equivalents, the average American purchaser would not translate the word "VEUVE" into "widow." As a result, the Board's refusal to register Applicant's mark is affirmed with respect to marks VEUVE CLICQUOT PONSARDIN and VEUVE CLICQUOT, and reversed with respect to THE WIDOW.

***Knight Textile Corp. v. Jones Inv. Co.*, 2005 WL 1787250 (TTAB June 21, 2005)**

Applicant's mark NORTON MCNAUGHTON ESSENTIALS for women's clothing is not likely to be confused with opposer's ESSENTIALS mark, even where the marks are used on identical goods marketed in the same trade channels and to the same classes of

purchasers. The marks are dissimilar in their overall commercial impression. Although both marks contain the word ESSENTIALS, the word ESSENTIALS in applicant's mark contributes less to the commercial impression than does the house mark NORTON MCNAUGHTON. ESSENTIALS is a highly suggestive term as applied to clothing, and applicant's addition of its house mark suffices to distinguish the marks. The opposition is dismissed.

***Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d 1811 (TTAB 2005)**

Applicant sought to register BLUEMAN for tobacco products. The well known production company that puts on the BLUE MAN GROUP show opposed the application based on likelihood of confusion and dilution grounds. Applicant presented no evidence. Opposer presented evidence directed principally to coverage of the Blue Man Group in printed publications and television. The Board concluded the evidence was of limited probative value, much of it being regional, or in foreign language, or duplicative. Opposer failed to provide any evidence of sales under its mark and no evidence concerning advertising expenditures. Based on this evidence, the Board found that the BLUE MAN GROUP mark was strong and distinctive, but not famous. The differences in the goods and commercial impressions of the marks, however, favor applicant. The opposition is dismissed.

***DC Comics v. Pan American Grain Mfg. Co*, 2005 WL 2093233 (TTAB Aug. 24, 2005)**

Applicant, a corporation of Puerto Rico, sought to register KRIPTONITA for prepared alcoholic fruit cocktail. DC Comics opposed the application alleging it would likely cause confusion with its famous Superman comic character, and in particular, the mark KRYPTONITE. Under the doctrine of foreign equivalents the Board first held that KRIPTONITA is the Spanish term for Kryptonite, and therefore the marks are identical. Though applicant's goods differ from the goods on which opposer had used the specific KRYPTONITE mark (T-Shirts, toys, gum, jewelry and others), the Board focused on the facts that (1) KRYPTONITE is a "merchandising mark" that is one of the marks that opposer licenses as part of its SUPERMAN licenses, which has been licensed for "just about every consumer products category"; and (2) that KRYPTONITE has been used as an "indicia of the Superman mythos," and has become such an integral part of the stories for so many decades, that it is akin to a character in the stories. On the record, the Board concluded that consumers, seeing KRIPTONITA on prepared alcoholic fruit cocktails, are likely to believe that the mark has been licensed by opposer for such goods, and that the goods are therefore sponsored by opposer. The opposition is sustained.

DISCOVERY

Pioneer Kabushiki Kaisha v. Hitachi High Techs. Am., Inc., 74 USPQ2d 1672 (TTAB 2005)

Applicant, Hitachi, sought to register the mark SUPERSCAN ELITE for use on audio and video games, but Pioneer opposed registration on the grounds that the mark would likely be confused with its registered mark ELITE. Hitachi moved for a protective order to prevent Pioneer from taking six additional depositions. Hitachi's motion for a protective order is granted with respect to three depositions and denied with respect to the others. Pioneer filed a motion for sanctions because of Hitachi's failure to produce witnesses for depositions. Because Hitachi filed its motion for a protective order to prevent the taking of depositions before the scheduled deposition dates, the witnesses' failure to appear at their depositions is not sanctionable conduct. Pioneer's motion for sanctions is denied. Finally, Hitachi moved to compel production of survey documents of Pioneer's survey expert Robert Klein. Hitachi acted reasonably in assuming that the documents would be in Pioneer's possession or control, and Pioneer acted unreasonably by failing to inform Hitachi that they were not, depriving Hitachi of the chance timely to seek subpoena or obtain the documents by other means. Hitachi's motion to compel is granted.

RES JUDICATA/COLLATERAL ESTOPPEL

Mayer/Berkshire Corp. v. Berkshire Fashions, Inc., 2005 WL 2298131 (Sept. 22, 2005 Fed. Cir.)

The Board had previously held on summary judgment that the opposition to the application to register the mark BERKSHIRE, for clothing in Class 25, was barred by res judicata and collateral estoppel. Applicant and Opposer had previously litigated, to a jury verdict, the issue of likelihood of confusion of the BERKSHIRE trademark for certain apparel related goods. The jury had ruled in favor of the defendant-applicant, that there was no likelihood of confusion. Subsequently, the applicant filed the application at issue for apparel related goods and the opposition was filed. The Federal Circuit reversed the dismissal of the opposition. The Court noted that despite "superficial similarity" in the likelihood of confusion analysis in Court and at the Board, differences in transactional facts will generally avoid preclusion. Here, there was a factual dispute concerning the extent to which the applicant's description of goods was broader than those before the district court. In addition, opposer proffered evidence of actual confusion which it claimed arose from changed marketing practices by the applicant following the jury verdict. The Federal Circuit pointed to both of these facts as reasons that prevented the grant of summary judgment based on preclusion.

SURNAMES

In re Rath, 74 USPQ2d 1174 (Fed. Cir. 2005)

Applicant sought to register the marks DR. RATH and RATH for goods and services including nutritional supplements, books, grains, and educational services. The applications were based on German trademark registration of the marks. Registration was refused on the grounds that the marks are primarily merely surnames. Rath, conceding that the marks are primarily merely surnames, argues that the surname rule conflicts with the Paris Convention for those holding foreign registrations. The Paris Convention, however, is not a self-executing treaty and registration of a foreign mark under the Paris Convention is only granted “if eligible,” meaning that the mark must satisfy the surname rule. Refusal to register is affirmed.

In re Isabella Fiore, L.L.C., 2005 WL 1787224 (TTAB July 13, 2005)

Applicant sought to register the mark FIORE for accessories such as bags, purses, and wallets. Registration was refused on the ground that the mark is primarily merely a surname. Although the examining attorney met her initial burden of a prima facie showing that FIORE would be viewed by consumers as a surname, the applicant submitted sufficient evidence to rebut the examining attorney’s showing. Applicant demonstrated that FIORE means “flower” in Italian. The Board considered the significance of that meaning in the United States and found that the alternative meaning “flower” detracts from the surname significance of the term. Refusal to register is reversed.

AUTHORS’ NAMES

In re First Draft, Inc., 2005 WL 2451658 (TTAB Sept. 20, 2005)

Applicant sought to register FERN MICHAELS for a series of fictional books. Registration was refused on the ground that, as used in the specimens, Fern Michaels was used only to identify the author and not as a trademark. In considering what the Board described as a question of “first impression,” the Board concluded that, as a general rule, an author’s name is not registerable for a single work, but may be registerable for a series of written works when there is sufficient evidence that the name also functions as a mark. This may be provided by two types of evidence (1) establishing that the author controls the quality of the distributed works and the use of the name; or (2) establishing promotion and recognition of the author’s name so that prospective readers, when they see the name, know what they are getting. Despite 30 years of use of the FERN MICHAELS name on 67 separate works with over 60 million books sold, the Board concluded that the “scant” evidence of advertising and promotion did not satisfy either standard. Refusal to register affirmed.