

RECENT TRADEMARK DEVELOPMENTS



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RECENT TRADEMARK DEVELOPMENTS

**UNITED STATES COURT OF APPEALS FOR
THE FEDERAL CIRCUIT
COURT OF APPEALS – SIXTH CIRCUIT
DISTRICT COURT – DISTRICT OF COLUMBIA
TRADEMARK TRIAL AND APPEAL BOARD
COMMISSIONER FOR TRADEMARKS**

**Cases Reported in
The United States Patents Quarterly
Volumes 67, 68, and 69**



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COURT OF APPEALS FOR THE FEDERAL CIRCUIT

EX PARTE



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Likelihood of Confusion

- **In re Coors Brewing Co.**
68 USPQ2d 1059
(CAFC 2003)
 - **BLUE MOON & Design for beer**
likely to cause confusion with.
 - **BLUE MOON & Design for**
restaurant services.
 - **TTAB decision reversed**
and case remanded.



Mere Descriptiveness

- **In re MBNA America Bank N.A.**
 - 67 USPQ2d 1778**
(CAFC 2003)
 - **MONTANA SERIES and PHILADELPHIA CARD, both for credit card services featuring credit cards depicting scenes or subject matter relating to Montana or Philadelphia, merely descriptive of cards and services.**
 - **Appealed to local pride or connection with city or state.**
 - **TTAB affirmed.**



Geographical Deceptive Misdeshriptiveness

- **In re Les Halles De Paris J.V.**
67 USPQ2d 1539
(CAFC 2003)
 - **LE MARAIS for restaurant services not geographically deceptively misdescriptive.**
 - **TTAB decision vacated and case remanded.**



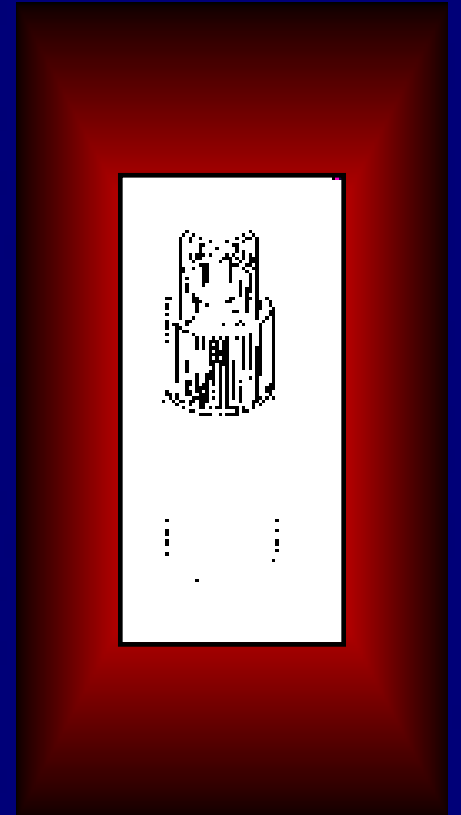
Disclaimer Requirement - Mere Descriptiveness

- **In re Savin Corporation**
 - 67 USPQ2d 1377**
(CAFC 2003) (unpublished)
 - **SAVIN NET for computer software system for processing parts and supplies, orders and computerized on-line ordering. NET merely descriptive and requirement for disclaimer was correct.**
 - **TTAB decision affirmed.**



Design Not Inherently Distinctive

- **In re Pacer Technology**
67 USPQ2d 1629
(CAFC 2003)
 - **Design of cap of container for adhesive was not inherently distinctive.**
 - **TTAB decision affirmed.**



Scandalous Term

- **In re Boulevard Entertainment Inc.**
67 USPQ2d 1475
(CAFC 2003)
 - **A vulgar term to be used for entertainment in the nature of adult-oriented conversations by telephone, when term had only one meaning, which was vulgar, was properly refused registration as scandalous on basis of dictionary definitions.**
 - **TTAB decision affirmed.**



COURT OF APPEALS FOR THE FEDERAL CIRCUIT

INTER PARTES



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Proper Party to Oppose Following Extension of Time

- **Custom Computer Services Inc. v. Paychex Properties Inc.**

**67 USPQ2d 11638
(CAFC 2003)**

- **The misstatement of the opposer's name, by mistake, in a Notice of Opposition, did not disqualify opposer on ground extension of time had been granted to a different entity.**
- **TTAB decision reversed.**



COURT OF APPEALS FOR SIXTH CIRCUIT



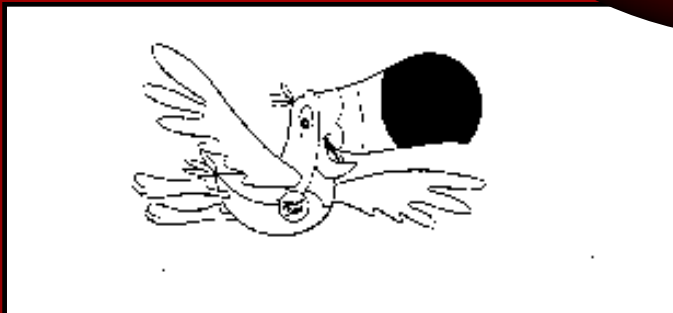
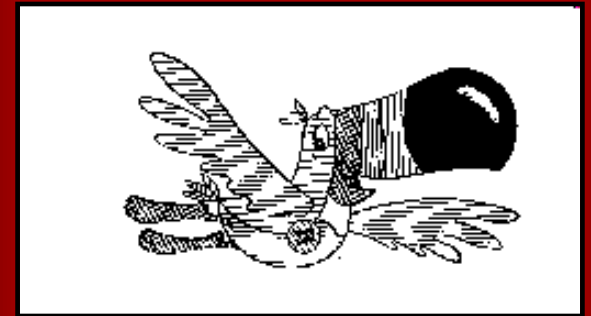
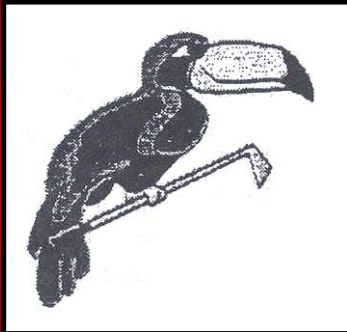
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Likelihood of Confusion

- **Kellogg Co. v. Toucan Golf Inc.**
67 USPQ2d 1481
(6th Cir. 2003)
 - **TOUCAN GOLD** for golf clubs and golf putters not likely to cause confusion with Designs of fanciful toucans and **TOUCAN SAM** for breakfast cereal and other food products.
 - **Sixth Circuit affirmed district court's dismissal of action seeking reversal of TTAB's decision for applicant.**



Likelihood of Confusion



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DISTRICT COURT FOR DISTRICT OF COLUMBIA



INTA® International Trademark Association

Section 2(a) Disparagement

- **Pro-Football v. Harjo**
 - 68 USPQ2d 1225**
(District Court District of Columbia, 2003)
 - **THE REDSKINS and other marks with word REDSKINS for entertainment services not proven to be disparaging of Native Americans when registrations were issued.**
 - **Petition barred by laches.**
 - **TTAB decision reversed by judgment for cancellation respondent.**



TRADEMARK TRIAL AND APPEAL BOARD

EX PARTE APPEALS



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Likelihood of Confusion

- **In re TSI Brands Inc.**

**67 USPQ2d 1657
(TTAB 2002)**

- **AK AMERICAN KHAKIS & Stars Design for men's and women's pants, jeans, shorts, and shirts not likely to cause confusion with AK & Circle Design and AK & Oval Design for sweaters, jerseys, shirts, tops, undershirts, pants, hosiery, and ski jackets, pants, and suits.**



Likelihood of Confusion



Likelihood of Confusion and Descriptiveness

- **In re Microsoft Corp.**
68 USPQ2d 1195
(TTAB 2003)
 - **OFFICE.NET for computer software and hardware products likely to cause confusion with OFFICENET for computer software and hardware products.**
 - **OFFICE.NET merely descriptive for its goods.**



Genericness

- **In re Cell Therapeutics Inc.**

**67 USPQ2d 1795
(TTAB 2003)**

- **CELL THERAPEUTICS INC.** was generic term for biochemical signaling pathway modulators for use in medicine and pharmacology and for research and development services in field of biomedical and therapeutic products.



False Suggestion of Association and Ownership of Mark

- **In re Los Angeles Police Revolver and Athletic Club Inc.**

**69 USPQ2d 1630
(TTAB 2003)**

- **Trademark slogan TO PROTECT AND TO SERVE for beverage glasses and clothing, including police and public safety uniforms, did not falsely suggest connection between applicant and LA Police Department.**
- **Applicant was owner of mark.**



Certification of Mark

- **In re Software Publishers Association**

**69 USPQ2d 2009
(TTAB 2003)**

- **CERTIFIED SOFTWARE MANAGER** was not a certification mark used to certify that persons had passed an examination and met certifier's standards for software asset and licensing management but was only title that conveyed personal information about the recipients.



Failure to Provide Information

- **In re DTI Partnership L.L.P.**

**67 USPQ2d 1699
(TTAB 2003)**

- **Failure to comply with examiner's requirement to supply information about the nature, purpose, and channels of trade of the goods was independent reason for refusal of application.**



Maintenance of Home Country Registration

- **In re Societe D'Exploitation de la Marque Le Fouquet's**
67 USPQ2d 1784
(TTAB 2003)
 - **When U. S. application is based on applicant's home country registration, the basic registration must remain in effect until the U. S. registration is issued.**



Filing Date

- **In re Henkel Loctite Corp.**
69 USPQ2d 1638
(Director 2003)
 - **Failure of PTO's electronic filing system to function resulted in backdating of filing date to date of futile efforts to file electronically through TEAS.**



INTER PARTES PROCEEDINGS

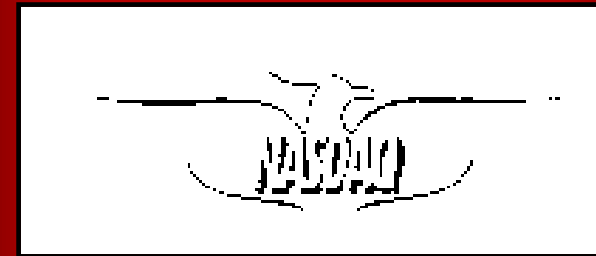


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Likelihood of Confusion And Dilution

- **NASDAQ Stock Market Inc. v. Antartica S.r.l.**

**69 USPQ2d 1718
(TTAB 2003)**



- **NASDAQ & Design of Bird for sport clothing and athletic equipment caused a likelihood of confusion with famous NASDAQ mark for financial securities services and caused likelihood of dilution.**



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Fraud

- **Medinol Ltd. v. Neuro Vasx Inc.**
67 USPQ2d 1205
(TTAB 2003)
 - **Inclusion in Statement of Use of one product on which mark had not been used constituted fraud resulting in cancellation of registration.**



Failure to State Claim for Relief

- **Carano v. Concha y Toro S.A.**

**67 USPQ2d 1149
(TTAB 2003)**



- **Failure to state a statutory basis for refusal of application was failure to state a claim upon which relief could be granted and opposition was dismissed.**



Judgment on the Pleadings - Section 14 Statute of Limitations

- **Rickson Gracie LLC v. Gracie**
67 USPQ2d 1702
(TTAB 2003) (Nonprecedential)
 - **Petition to cancel registration on ground mark was primarily merely a surname was filed after five year statute of limitation and was dismissed on motion for judgment on the pleadings.**



Evidence Case

- **M.C.A. – Medical and Chemical Agency s.r.l. v. Zenna Chemical Industry Co.**
68 USPQ2d 1958
(TTAB 2003) (Nonprecedential)
 - **Although unsigned testimonial deposition transcript was barred in one opposition, it was considered after transcript was signed, proceedings were consolidated, and transcript was filed prior to final hearing.**



Motion to Reopen Discovery Period

- **DC Comics and Marvel Characters Inc. v. Margo**

68 USPQ2d 1319

(TTAB 2003) (Nonprecedential)

- **A motion to reopen the discovery period was denied because fact applicants represented themselves did not constitute excusable neglect.**



THANK YOU



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