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# 2010 Trademark Law Decisions of the Federal Circuit

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## 2010 Trademark Law Decisions of the Federal Circuit

# 2010 TRADEMARK LAW DECISIONS OF THE FEDERAL CIRCUIT

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## INTRODUCTION

While not breaking any new ground, the United States Court of Appeals for the Federal Circuit's ("Federal Circuit") trademark decisions rendered during 2010 provide colorful applications of well-founded substantive trademark law principles and illustrate numerous procedural cautionary tales. During 2010, the Federal Circuit issued twenty-three trademark decisions<sup>1</sup> and designated eight

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1. *In re Sharp*, No. 2010-1148, 2010 U.S. App. LEXIS 25356 (Fed. Cir. Dec. 13, 2010) (per curiam); *Bell's Brewery, Inc. v. Bell Hill Vineyards, L.L.C.*, No. 2010-1280, 2010 U.S. App. LEXIS 25499 (Fed. Cir. Dec. 13, 2010) (per curiam); *ERBE Elektromedizin GmbH v. Canady Technology L.L.C.*, 629 F.3d 1278, 97 U.S.P.Q.2d (BNA) 1048 (Fed. Cir. 2010); *Anthony's Pizza Holding Co. v. Anthony's Pizza & Pasta Int'l, Inc.*, No. 2010-1191, 2010 U.S. App. LEXIS 23898 (Fed. Cir. Nov. 18, 2010) (per curiam); *Gen. Cas. Co. of Wis. v. Amerisure Mut. Ins. Co.*, No. 2010-1422, 2010 U.S. App. LEXIS 26870 (Fed. Cir. Oct. 4, 2010); *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 U.S.P.Q.2d 1681 (Fed. Cir. 2010); *Green Edge Enters. v. Rubber Mulch Etc., L.L.C.*, 620 F.3d 1287, 96 U.S.P.Q.2d (BNA) 1425 (Fed. Cir. 2010); *In re The Lex Group VA*, 383 F. App'x 949 (Fed. Cir. 2010) (per curiam); *Outdoor Kids, Inc. v. Parris Mfg. Co.*, 385 F. App'x 992 (Fed. Cir. 2010); *Deere & Co. v. ITC*, 605 F.3d 1350, 95 U.S.P.Q.2d (BNA) 1206 (Fed. Cir. 2010); *Sadeh v. Biggs*, 374 F. App'x 996 (Fed. Cir. 2010) (per curiam); *Fred Beverages, Inc. v. Fred's Capital Mgmt. Co.*, 605

as precedential.<sup>2</sup> One case consisted of an appeal from the United States International Trade Commission (“ITC”),<sup>3</sup> two cases were appeals from decisions by United States District Courts,<sup>4</sup> and the remaining twenty cases consisted of appeals from the United States Patent and Trademark Office’s (“Trademark Office”) Trademark Trial and Appeal Board (“TTAB” or the “Board”).

Of the twenty cases appealed from the TTAB, seven involved an *ex parte* appeal of application refusals,<sup>5</sup> five involved cancellation proceedings, including one cancellation counterclaim,<sup>6</sup> eight involved opposition proceedings,<sup>7</sup> and one involved a consolidated cancellation and opposition proceeding.<sup>8</sup> Five of the eight precedential trademark decisions predominantly involved substantive

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F.3d 963, 94 U.S.P.Q.2d (BNA) 1958 (Fed. Cir. 2010); *In re Achenbach Buschhütten GmbH*, No. 2010-1192, 2010 U.S. App. LEXIS 12248 (Fed. Cir. May 4, 2010); *Crash Dummy Movie, L.L.C. v. Mattel, Inc.*, 601 F.3d 1387, 94 U.S.P.Q.2d (BNA) 1315 (Fed. Cir. 2010); *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 U.S.P.Q.2d (BNA) 1257 (Fed. Cir. 2010); *Odom’s Tenn. Pride Sausage, Inc. v. FF Acquisition, L.L.C.*, 600 F.3d 1343, 93 U.S.P.Q.2d (BNA) 2030 (Fed. Cir. 2010); *Campbell v. Bassani Mfg.*, 368 F. App’x 133 (Fed. Cir. 2010) (per curiam), *reh’g denied*, No. 2009-1534, 2010 U.S. App. LEXIS 9432 (Fed. Cir. Apr. 20, 2010); *Benedict v. Super Bakery, Inc.*, 367 F. App’x 161 (Fed. Cir. 2010) (per curiam); *In re Mi Pueblo San Jose, Inc.*, 367 Fed. App’x 144 (Fed. Cir. 2010) (per curiam); *Stoller v. Best Data Prods., Inc.*, No. 2010-1031, 2010 U.S. App. LEXIS 4354 (Fed. Cir. Feb. 5, 2010); *Univ. of S.C. v. Univ. of S. Cal.*, 367 F. App’x 129 (Fed. Cir.), *cert. denied*, 131 S. Ct. 387 (2010); *Found. for a Christian Civilization, Inc. v. Mary Queen of the Third Millennium, Inc.*, 360 F. App’x 150 (Fed. Cir. 2010) (per curiam); *In re Hyatt*, No. 2009-1229, 2010 U.S. App. LEXIS 26199 (Fed. Cir. Jan. 7, 2010).

2. *ERBE*, 629 F.3d 1278, 97 U.S.P.Q.2d (BNA) 1048; *In re Chippendales*, 622 F.3d 1346, 96 U.S.P.Q.2d (BNA) 1681; *Green Edge*, 620 F.3d 1287, 96 U.S.P.Q.2d (BNA) 1425; *Deere*, 605 F.3d 1350, 95 U.S.P.Q.2d (BNA) 1206; *Fred Beverages*, 605 F.3d 963, 94 U.S.P.Q.2d (BNA) 1958; *Mattel*, 601 F.3d 1387, 94 U.S.P.Q.2d (BNA) 1315; *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 U.S.P.Q.2d (BNA) 1257; *Odom’s*, 600 F.3d 1343, 93 U.S.P.Q.2d (BNA) 2030.

3. *Deere*, 605 F.3d 1350, 95 U.S.P.Q.2d (BNA) 1206.

4. *ERBE*, 629 F.3d 1278, 97 U.S.P.Q.2d (BNA) 1048; *Green Edge*, 620 F.3d 1287, 96 U.S.P.Q.2d (BNA) 1425.

5. *In re Sharp*, 2010 U.S. App. LEXIS 25356 at \*1; *In re Chippendales*, 622 F.3d at 1348, 96 U.S.P.Q.2d (BNA) at 1681; *In re The Lex Group*, 383 F. App’x at 949; *In re Achenbach*, 2010 U.S. App. LEXIS 12248 at \*1; *In re Mighty Leaf Tea*, 601 F.3d at 1344, 94 U.S.P.Q.2d (BNA) at 1257; *In re Mi Pueblo*, 367 Fed. App’x at \*1; *In re Hyatt*, 2010 U.S. App. LEXIS 26199 at \*1.

6. *Gen. Cas. Co.*, 2010 U.S. App. LEXIS 26870 at \*1; *Outdoor Kids*, 385 F. App’x at 993; *Fred Beverages*, 605 F.3d at 964, 94 U.S.P.Q.2d (BNA) at 1958; *Super Bakery*, 367 F. App’x at 162; *Univ. of S.C.*, 367 F. App’x at 131 (cancellation counterclaim).

7. *Bell’s Brewery, Inc. v. Bell Hill Vineyards, L.L.C.*, No. 2010-1280, 2010 U.S. App. LEXIS 25499, at \*1 (Fed. Cir. Dec. 13, 2010) (per curiam); *Sadeh v. Biggs*, 374 F. App’x 996, 997 (Fed. Cir. 2010) (per curiam); *Mattel*, 601 F.3d at 1389, 94 U.S.P.Q.2d (BNA) at 1315; *Odom’s*, 600 F.3d at 1344, 93 U.S.P.Q.2d (BNA) at 2030; *Campbell v. Bassani Mfg.*, 368 F. App’x 133, 133 (Fed. Cir. 2010), *reh’g denied*, No. 2009-1534, 2010 U.S. App. LEXIS 9432 (Fed. Cir. Apr. 20, 2010); *Super Bakery*, 367 F. App’x at 162; *Univ. of S.C.*, 367 F. App’x at 131; *Found. for a Christian Civilization, Inc. v. Mary Queen of the Third Millennium, Inc.*, 360 F. App’x 150, 150 (Fed. Cir. 2010) (per curiam).

8. *Anthony’s Pizza Holding Co. v. Anthony’s Pizza & Pasta Int’l, Inc.*, No. 2010-1191, 2010 U.S. App. LEXIS 23898, at \*1–2 (Fed. Cir. Nov. 18, 2010) (per curiam).

issues,<sup>9</sup> two predominantly involved TTAB procedural issues,<sup>10</sup> and one presented both significant substantive and procedural issues.<sup>11</sup>

Of note, in five of the six per curiam cases, the Federal Circuit rendered judgments without written opinions after the parties had fully briefed and argued the appeals.<sup>12</sup> Each of these judgments affirmed the decision of the TTAB, and all related to substantive trademark issues. Consequently, in 2010, thirty-three percent of all appeals of substantive trademark issues to the Federal Circuit resulted in the Federal Circuit affirming without a written opinion.

In fourteen of fifteen appeals of substantive trademark law issues, the Federal Circuit affirmed the TTAB's or district court's decision; often, this was because the Board or court had evaluated and weighed evidence relating to likelihood of confusion, abandonment, inherent distinctiveness, genericism, or descriptiveness.<sup>13</sup> In two instances, the Federal Circuit reversed or vacated TTAB orders due to the TTAB's misapplication of its own procedural rules.<sup>14</sup> Additionally, the Federal Circuit dismissed three appeals before they were heard because the appellant or the appellant's counsel failed to follow the Federal Circuit's procedural rules.<sup>15</sup> In one instance, upon request of the Board, the Federal Circuit vacated an appeal of an *ex parte* decision because the registration upon which the application denial

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9. *In re Chippendales*, 622 F.3d at 1348, 96 U.S.P.Q.2d (BNA) at 1681; *Green Edge*, 620 F.3d at 1290, 96 U.S.P.Q.2d (BNA) at 1425; *Mattel*, 601 F.3d at 1389, 94 U.S.P.Q.2d (BNA) at 1315; *In re Mighty Leaf Tea*, 601 F.3d at 1344, 94 U.S.P.Q.2d (BNA) at 1257; *Mary Queen*, 360 F. App'x at 150.

10. *Fred Beverages*, 605 F.3d at 964, 94 U.S.P.Q.2d (BNA) at 1958; *In re Hyatt*, 2010 U.S. App. LEXIS 26199, at \*1.

11. *Odom's*, 600 F.3d at 1344-45, 93 U.S.P.Q.2d (BNA) at 2030.

12. *In re Sharp*, No. 2010-1148, 2010 U.S. App. LEXIS 25356, at \*1 (Fed. Cir. Dec. 13, 2010) (per curiam) (without opinion); *Bell's Brewery*, 2010 U.S. App. LEXIS 25499, at \*1 (without opinion); *Anthony's Pizza*, 2010 U.S. App. LEXIS 23898, at \*1-10 (with opinion); *In re The Lex Group VA*, 383 F. App'x 949, 949 (Fed. Cir. 2010) (per curiam) (without opinion); *Mary Queen*, 360 F. App'x at 150 (without opinion).

13. Only in *Deere v. ITC*, 605 F.3d 1350, 95 U.S.P.Q.2d (BNA) 1206 (Fed. Cir. 2010), which was an appeal from a decision of the ITC regarding interpretation of the Tariff Act of 1930, did the Federal Circuit vacate and remand on a substantive trademark law issue. *Id.* at 1361-62, 95 U.S.P.Q.2d (BNA) at 1206.

14. *Fred Beverages*, 605 F.3d at 967, 94 U.S.P.Q.2d (BNA) at 1958 (reversed and remanded); *Benedict v. Super Bakery, Inc.*, 367 F. App'x 161, 163 (Fed. Cir. 2010) (per curiam) (vacated).

15. *Gen. Cas. Co. of Wis. v. Amerisure Mut. Ins. Co.*, No. 2010-1422, 2010 U.S. App. LEXIS 26870 (Fed. Cir. Oct. 4, 2010) (dismissed for failure to file timely appeal brief); *In re Achenbach Buschhuten GmbH*, No. 2010-1192, 2010 U.S. App. LEXIS 12248, at \*1 (Fed. Cir. May 4, 2010) (dismissed for counsel's failure to become a member of the bar); *Stoller v. Best Data Prods., Inc.*, No. 2010-1031, 2010 U.S. App. LEXIS 4354, at \*1 (Fed. Cir. Feb. 5, 2010) (dismissed for failure to pay docketing fee).

was based was cancelled just days before the oral argument on the appeal.<sup>16</sup>

Each of the Federal Circuit's 2010 trademark decisions is discussed in detail below. In a few instances, the opinions involve both noteworthy substantive and procedural determinations.<sup>17</sup> In such cases, both the substantive and procedural issues are discussed together in Part I, Substantive Trademark Issues. In the interest of brevity, facts and issues unrelated to trademark law are omitted from the case discussions.

## I. SUBSTANTIVE TRADEMARK ISSUES

### A. *Likelihood of Confusion*

#### 1. *University of South Carolina v. University of Southern California*

In *University of South Carolina v. University of Southern California*,<sup>18</sup> the Federal Circuit upheld the TTAB's decision to sustain Southern California's opposition to South Carolina's trademark application for a stylized SC mark, given the likelihood of confusion with Southern California's prior SC registration.<sup>19</sup> Further, the court upheld the TTAB's dismissal of South Carolina's cancellation counterclaim, which alleged that Southern California's use of "SC" created a false connection with the state of South Carolina.<sup>20</sup> However, the court disagreed with the TTAB's lack of standing determination, and

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16. *In re Hyatt*, No. 2009-1229, 2010 U.S. App. LEXIS 26199, at \*1 (Fed. Cir. Jan. 7, 2010).

17. *In re Sharp*, 2010 U.S. App. LEXIS 25356, at \*1 (affirming the TTAB's review of both the refusal of registration on the grounds that the applicant's mark was merely descriptive of the applicant's services—the procedural issue—and that the mark's name was generic—the substantive issue); *Odom's Tenn. Pride Sausage, Inc. v. FF Acquisition, L.L.C.*, 600 F.3d 1343, 1346–47, 93 U.S.P.Q.2d (BNA) 2030, 2030 (Fed. Cir. 2010) (holding both that the TTAB was not required to consider unregistered marks in its "likelihood of confusion" analysis—the procedural issue—and that a single "likelihood of confusion" factor may be dispositive when that factor is the dissimilarity of the marks at issue—the substantive issue); *Campbell v. Bassani Mfg.*, 368 F. App'x 133, 134–35 (Fed. Cir. 2010) (addressing the propriety of evaluating use by competitors in determining whether a mark is generic—the procedural issue—and whether the TTAB correctly granted summary judgment against the applicant—the substantive issue); *Univ. of S.C. v. Univ. of S. Cal.*, 367 F. App'x 129, 132, 135 (Fed. Cir.), *cert. denied*, 131 S. Ct. 387 (2010) (addressing the TTAB's grant of summary judgment against South Carolina on South Carolina's counterclaim—the procedural issue—and the TTAB's refusal to register South Carolina's mark based on a likelihood of confusion—the substantive issue).

18. 367 F. App'x 129 (Fed. Cir.), *cert. denied*, 131 S. Ct. 387 (2010). This opinion also involves a false connection counterclaim and a related standing issue. *Id.*

19. *Id.* at 134–35.

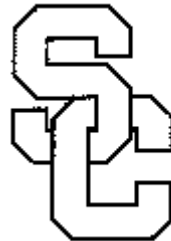
20. *Id.* at 131, 135–37.

instead, it tossed out the counterclaim on the merits of the false connection claim.<sup>21</sup>

The University of South Carolina applied to register the following mark:



in connection with various types of clothing in International Class 25.<sup>22</sup> Southern California opposed South Carolina's application on the basis that the South Carolina mark was likely to be confused with two of Southern California's existing registered marks with earlier priority, namely the standard character word mark SC and the stylized version as shown below<sup>23</sup>:



South Carolina challenged the TTAB's decision with respect to the third, fourth, and eighth factors from *In re E. I. DuPont DeNemours & Co.*<sup>24</sup>: the similarity of the trade channels, the care consumers employ

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21. *Id.* at 136.

22. *Id.* at 131.

23. *Id.*

24. 476 F.2d 1357, 1361, 177 U.S.P.Q. (BNA) 563 (C.C.P.A. 1973). *DuPont* is the seminal case setting forth the factors that, when of record, are to be considered by the United States Trademark Office in deciding whether to refuse registration of a trademark under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d) (2006), due to a likelihood of confusion between the trademark contained in an application for registration and any preexisting trademarks. The *DuPont* likelihood of confusion



when purchasing the goods, and the absence of evidence of actual confusion.<sup>25</sup>

With regard to the trade channels, Southern California had limited its goods identification in International Class 25 to include only “university authorized” goods.<sup>26</sup> The Federal Circuit agreed with the TTAB that this included “any trade channels which are or could be authorized or approved by [Southern] California.”<sup>27</sup> Thus, the Federal Circuit found no error in the TTAB’s conclusion that South Carolina’s goods would appear in the same trade channels as Southern California’s.<sup>28</sup>

With respect to the care exercised by consumers, the Federal Circuit agreed with South Carolina that the TTAB’s conclusions regarding a lower level of care exercised by gift-purchasers and “new or casual fans” rested on speculation, rather than substantial evidence.<sup>29</sup> Nevertheless, the Federal Circuit held that even if the TTAB erred on this point, it was a harmless error that would not warrant reversal of the Board’s decision on likelihood of confusion.<sup>30</sup>

Turning to the lack of actual confusion factor, the Federal Circuit held that, being presented with no evidence that the parties’ marks “appeared together for a significant length of time,” the TTAB had properly given little weight to the absence of evidence of actual confusion.<sup>31</sup>

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factors are: 1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression; 2) the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use; 3) the similarity or dissimilarity of established, likely-to-continue trade channels; 4) the conditions under which and buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing; 5) the fame of the prior mark (sales, advertising, length of use); 6) the number and nature of similar marks in use on similar goods; 7) the nature and extent of any actual confusion; 8) the length of time during and conditions under which there has been concurrent use without evidence of actual confusion; 9) the variety of goods on which a mark is or is not used (house mark, “family” mark, product mark); 10) the market interface between applicant and the owner of a prior mark: a) a mere “consent” to register or use, b) agreement provisions designed to preclude confusion, i.e. limitations on continued use of the marks by each party, c) assignment of mark, application, registration and good will of the related business, or d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion; 11) the extent to which applicant has a right to exclude others from use of its mark on its goods; 12) the extent of potential confusion, i.e., whether de minimis or substantial; and 13) any other established fact probative of the effect of use. *In re DuPont*, 476 F.2d at 1361.

25. *Univ. of S.C.*, 367 F. App’x at 132.

26. *Id.*

27. *Id.* at 132–33 (quoting *Univ. of S. Cal. v. Univ. of S.C.*, No. 91125615, 2008 WL 3333839, at \*8 (T.T.A.B. 2008)).

28. *Id.* at 133.

29. *Id.* at 133–34.

30. *Id.* at 134.

31. *Id.* at 135.

The Federal Circuit's ruling regarding standing on South Carolina's cancellation counterclaim is perhaps the more notable part of this case. South Carolina's counterclaim was based on Section 2(a) of the Lanham Act,<sup>32</sup> alleging that Southern California's use of "SC" created a false connection with the state of South Carolina.<sup>33</sup> The TTAB granted summary judgment to Southern California on the counterclaim because it believed that the University of South Carolina was not an agency of the State of South Carolina, and thus, that the University of South Carolina lacked standing to assert a Section 2(a) claim based on a false association between the University of Southern California and the State of South Carolina.<sup>34</sup> The Federal Circuit rejected the TTAB's reasoning, without deciding whether the University of South Carolina was an agent of the state, and held that in order to establish standing South Carolina only needed to show: 1) that it had a reasonable belief that it would be damaged by Southern California's registration and 2) that it had a direct and personal stake in the cancellation of that registration.<sup>35</sup> The Federal Circuit concluded that South Carolina did, in fact, establish standing.<sup>36</sup>

Nevertheless, the court affirmed the TTAB's grant of summary judgment in favor of Southern California on this issue because, in order to prevail, South Carolina needed to show that there was a genuine issue for trial on whether the initials "SC" "point uniquely" to the State of South Carolina.<sup>37</sup> In the context of another issue, South Carolina itself had submitted evidence that "at least sixteen other universities and colleges represent themselves as 'SC.'"<sup>38</sup> In light of this evidence, the Federal Circuit agreed with the Board that South Carolina's counterclaim could not survive summary judgment.<sup>39</sup>

## 2. *In re Mi Pueblo San Jose, Inc.*

In *In re Mi Pueblo San Jose, Inc.*,<sup>40</sup> the Federal Circuit affirmed, in an unpublished, per curiam opinion, the TTAB's ruling that consumer confusion is likely between the applicant's MI PUEBLO (and Design)

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32. 15 U.S.C. § 1052(a) (2006).

33. *Univ. of S.C.*, 367 F. App'x at 131.

34. *See id.* at 136 (summarizing and affirming the TTAB's grant of summary judgment against South Carolina on its cancellation counterclaim).

35. *Id.*

36. *Id.*

37. *Id.* (citing *Univ. of Notre Dame Du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 1377, 217 U.S.P.Q. (BNA) 505, 505 (Fed. Cir. 1983)).

38. *Id.* at 136.

39. *Id.*

40. 367 Fed. App'x 144 (Fed. Cir. 2010) (per curiam).

for “retail grocery stores” and the registrant’s MI PUEBLO for “sauces and salsas.”<sup>41</sup> The TTAB thus affirmed the Examining Attorney’s *ex parte* refusal of the application at hand.<sup>42</sup>

The TTAB rejected the applicant’s argument that the Ninth Circuit’s likelihood of confusion factors should apply, and instead applied the *DuPont* factors.<sup>43</sup> The TTAB also rejected the applicant’s argument that the registrant’s rights were limited to the representations of the mark it actually used, because word marks such as the registrant’s must be constructed to cover all representations that do not materially change the character of the mark.<sup>44</sup>

The Board found the marks to be highly similar, given that “the dominant portion of the applicant’s mark:



is MI PUEBLO, which is identical to the registrant’s mark.”<sup>45</sup> The Board also found that similarities between the target customers and trade channels of the goods and services, as set forth in the application and registration, weighed in favor of a likelihood of confusion given that “sauces and salsa” are commonly sold in “retail grocery stores.”<sup>46</sup> The fact that the applicant claims to not sell the registrant’s specific salsa is irrelevant in this determination.<sup>47</sup>

This case supports the general trend that the addition of a design element to a word mark will not prevent a likelihood of confusion with an identical word mark.

### 3. Odom’s Tennessee Pride Sausage, Inc. v. FF Acquisition, L.L.C.

In *Odom’s Tennessee Pride Sausage, Inc. v. FF Acquisition, L.L.C.*,<sup>48</sup> the Federal Circuit upheld the dismissal of the appellant’s opposition to a trademark application filed by FF Acquisition after finding that no

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41. *Id.* at \*1; *In re Mi Pueblo San Jose, Inc.*, No. 76/679,535, 2009 TTAB LEXIS 214, at \*13 (T.T.A.B. Mar. 27, 2009).

42. *In re Mi Pueblo*, 2009 TTAB LEXIS 214, at \*15.

43. *Id.* at \*3.

44. *Id.* at \*5–6.

45. *Id.* at \*8.

46. *Id.* at \*13–14.

47. *Id.* at \*15.

48. 600 F.3d 1343, 93 U.S.P.Q.2d (BNA) 2030 (Fed. Cir. 2010). This opinion also involves a procedural issue regarding the effect of claims that are not pled. *Id.* at 1346, 93 U.S.P.Q. 2d (BNA) at 2031.

likelihood of confusion existed between the appellant food producer's registered farm boy marks:



and the appellee supermarket's farm boy mark.<sup>49</sup>



The central issue on appeal involved Odom's contention that the TTAB inappropriately failed to consider Odom's common law trademark rights.<sup>50</sup> The Federal Circuit dismissed Odom's argument, holding that while opposition claims may be asserted based upon common law rights, Odom's failed to plead or reference any common law rights in the notice of opposition and instead relied only upon its federal registrations.<sup>51</sup> The Federal Circuit held that, in such circumstances, the TTAB is not required to consider any unpled, unregistered marks in its analysis.<sup>52</sup> The Federal Circuit noted that while Section 528.07(b) of the TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE permits the TTAB to deem pleadings as having been amended to include any unpled issues, the TTAB is not required to do so.<sup>53</sup>

The Federal Circuit next affirmed the TTAB's conclusion under the *DuPont* factors that the parties' marks are sufficiently dissimilar in appearance as to create different commercial impressions.<sup>54</sup> The Federal Circuit cited the distinctions in the marks as found by the TTAB, namely that the farm boys' hands and feet differed in size and shape, that their hats differed in shape and style, and that one boy had a piece of straw in his mouth and shoes on his feet while the opposer's farm boys had neither.<sup>55</sup> The Federal Circuit found that the TTAB had properly dissected the marks in making those

49. *Id.* at 1344-46, 93 U.S.P.Q.2d (BNA) at 2030-31.

50. *Id.* at 1345-46, 93 U.S.P.Q.2d (BNA) at 2031.

51. *Id.* at 1346, 93 U.S.P.Q.2d (BNA) at 2031.

52. *Id.*, 93 U.S.P.Q.2d (BNA) at 2031.

53. *Id.*, 93 U.S.P.Q.2d (BNA) at 2032.

54. *Id.* at 1346-47, 93 U.S.P.Q.2d (BNA) at 2032.

55. *Id.* at 1346, 93 U.S.P.Q.2d (BNA) at 2032.

distinctions.<sup>56</sup> Accordingly, the court affirmed the TTAB's holding that the visual distinctions between the marks created "unquestionably different commercial impressions" and that dissimilarity of the marks in and of itself was a sufficient basis to dismiss an opposition.<sup>57</sup>

#### 4. *In re* Mighty Leaf Tea

In *In re Mighty Leaf Tea*,<sup>58</sup> the Federal Circuit upheld the TTAB's conclusion that customer confusion was likely between the trademarks ML and ML MARK LEES (stylized), as used in connection with related skin care products.<sup>59</sup> As a result, the court found that the ML trademark was unregistrable.<sup>60</sup>

Mighty Leaf Tea applied to register the mark "ML" in International Class 3 for "personal care products and skin care preparations, namely, skin soap, body wash, foam bath, body lotion, body scrub, bath salts and massage oil; potpourri; incense."<sup>61</sup> The Examining Attorney refused registration of Mighty Leaf Tea's mark under Section 2(d) of the Lanham Act, finding that the applied-for mark was likely to be confused with the following pre-existing mark:



("ML MARK LEES (stylized) mark").<sup>62</sup> The ML MARK LEES (stylized) mark is registered in International Class 3, in connection with "skin care products, namely, skin cleanser, skin toner, skin cream, skin lotion, skin mask gel, make-up foundation, powder and blush."<sup>63</sup> Mighty Leaf Tea appealed the refusal to register to the TTAB.<sup>64</sup>

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56. *Id.*, 93 U.S.P.Q.2d (BNA) at 2032.

57. *Id.*, 93 U.S.P.Q.2d (BNA) at 2032.

58. 601 F.3d 1342, 94 U.S.P.Q.2d (BNA) 1257 (Fed. Cir. 2010).

59. *Id.* at 1344, 94 U.S.P.Q.2d (BNA) at 1257.

60. *Id.*, 94 U.S.P.Q.2d (BNA) at 1257.

61. *Id.*, 94 U.S.P.Q.2d (BNA) at 1257.

62. *Id.* at 1344-45, 94 U.S.P.Q.2d (BNA) at 1258.

63. *Id.* at 1345, 94 U.S.P.Q.2d (BNA) at 1258.

64. *Id.*, 94 U.S.P.Q.2d (BNA) at 1258.

In comparing the marks, the TTAB found the “ML” designation to be the dominant portion of both marks, and thereby dismissed Mighty Leaf Tea’s argument that the marks differ in appearance so much that there would be no likelihood of confusion.<sup>65</sup> The Federal Circuit agreed with the TTAB on this conclusion and affirmed.<sup>66</sup>

Mighty Leaf Tea’s arguments to the TTAB and to the Federal Circuit focused on the sixth *DuPont* factor: “[t]he number and nature of similar marks in use on similar goods.”<sup>67</sup> Mighty Leaf Tea argued that its evidence of third-party use of the “ML” mark shows that “ML” is a weak mark, and thus, that even minor variations of the cited registration should be registrable.<sup>68</sup> It argued to the Federal Circuit that the TTAB had improperly focused on only the cited registered mark, without giving proper weight to third-party evidence.<sup>69</sup>

The Federal Circuit acknowledged that third-party registrations may be given some weight in showing how third parties are using similar marks on similar goods, but the court rejected Mighty Leaf Tea’s contention that it had made an adequate showing of common elements so as to render consumer confusion unlikely.<sup>70</sup> Specifically, the court cited the TTAB’s skeptical view of registrations containing two letter strings “ML” within longer words or strings, such as MLUXE, M’LIS, JML, and AMLAVI.<sup>71</sup> The court agreed that such registrations did not act as evidence that “ML” had any recognized meaning or significance within the longer strings.<sup>72</sup>

##### 5. *Outdoor Kids, Inc. v. Parris Manufacturing Co.*

In *Outdoor Kids, Inc. v. Parris Manufacturing Co.*,<sup>73</sup> the Federal Circuit agreed with the TTAB’s conclusion that customer confusion was not likely between the trademarks KID’S OUTDOORS (and Design), and OUTDOORS KIDS (word mark) for three reasons: because the OUTDOORS KIDS mark was weak, the word portion of the KID’S OUTDOORS (and Design) mark was descriptive, and the transposition of the words in the respective marks and the presence of an elk design element in the registered marks were sufficient to

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65. *Id.* at 1347–48, 94 U.S.P.Q.2d (BNA) at 1258, 1260–61.

66. *Id.* at 1348, 94 U.S.P.Q.2d (BNA) at 1261.

67. *Id.* at 1346, 94 U.S.P.Q.2d (BNA) at 1259 (quoting *In re E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q.2d (BNA) 563, 567 (C.C.P.A. 1973)).

68. *Id.*, 94 U.S.P.Q.2d (BNA) at 1259.

69. *Id.*, 94 U.S.P.Q.2d (BNA) at 1259.

70. *Id.* at 1346–48, 94 U.S.P.Q.2d (BNA) at 1259–60.

71. *Id.* at 1347, 94 U.S.P.Q.2d (BNA) at 1260.

72. *Id.*, 94 U.S.P.Q.2d (BNA) at 1260.

73. 385 F. App’x 992 (Fed. Cir. 2010).

distinguish the marks.<sup>74</sup> As a result, the Federal Circuit upheld the Board's dismissal of the cancellation proceedings brought by Outdoor Kids.<sup>75</sup>

Outdoor Kids obtained a registration for the word mark OUTDOOR KIDS in connection with various types of outdoor clothing and sporting goods for children.<sup>76</sup> The registration included a disclaimer of rights in the term "KIDS" apart from the mark as a whole.<sup>77</sup> Subsequently, Parris obtained two registrations for the following mark<sup>78</sup>:



The goods listed in the Parris registrations were various types of clothing and toys.<sup>79</sup>

Outdoor Kids petitioned the TTAB to cancel both of the Parris registrations based on a likelihood of confusion with Outdoor Kids' prior existing registration.<sup>80</sup> The TTAB found that the OUTDOOR KIDS mark was weak and was not famous, placing special emphasis on the fact that the mark was registered under a claim of acquired distinctiveness with a disclaimer of the term "KIDS".<sup>81</sup> The TTAB discussed several relevant *DuPont* factors, finding that while some factors favored a finding of a likelihood of confusion, the differences between the marks and the weakness of the word portions of the marks ultimately rendered customer confusion unlikely.<sup>82</sup> The Federal Circuit affirmed the TTAB's decision in all respects.<sup>83</sup>

This case is notable because courts generally accord greater weight to the words in a mark than the design features when they analyze a likelihood of confusion claim; this case demonstrates that where, as

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74. *Id.* at 994–96.

75. *Id.* at 996.

76. *Id.* at 993.

77. *Id.* at 994.

78. *Id.* at 993.

79. *Id.*

80. *Id.* at 993–94.

81. *Id.* at 994.

82. *Id.* at 994–96.

83. *Id.* at 996.

here, the words are highly descriptive or suggestive, the design may be more significant than the wording.<sup>84</sup> The TTAB considered the elk design element to be a distinguishing feature between the marks, and the Federal Circuit found no error in that conclusion.<sup>85</sup> Specific examples of likelihood of confusion cases that find a design more significant than wording are few and far between,<sup>86</sup> but this case shows that the TTAB and the Federal Circuit are willing to recognize the power that a design feature may have in militating against finding a likelihood of confusion.

6. *Anthony's Pizza Holding Co. v. Anthony's Pizza & Pasta International, Inc.*

In *Anthony's Pizza Holding Co. v. Anthony's Pizza & Pasta International, Inc.*,<sup>87</sup> the Federal Circuit affirmed, in an unpublished, per curiam opinion, the TTAB's ruling, in a consolidated proceeding, to sustain an opposition and grant a petition to cancel after holding that ANTHONY'S PIZZA & PASTA is likely to be confused with ANTHONY'S COAL-FIRED PIZZA.<sup>88</sup>

Appellant Anthony's Pizza Holding ("APH") obtained a registration for ANTHONY'S COAL-FIRED PIZZA in standard character form, and sought to register the same mark with the following design element both for restaurant services.<sup>89</sup>



Appellee Anthony's Pizza & Pasta ("APPI") previously used and registered ANTHONY'S PIZZA & PASTA, also for restaurant services.<sup>90</sup> In seeking to cancel the standard character word mark and

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84. *See id.* at 994 (finding that where the word portion of Parris' mark is descriptive, the transposition of the words and the presence of the elk design were sufficient to distinguish the two marks).

85. *Id.*

86. *See, e.g.,* *Parfums de Coeur, Ltd. v. Lazarus*, No. 91161331, 2007 WL 683784, at \*1, \*4, 83 U.S.P.Q.2d (BNA) 1012, 1016 (T.T.A.B. 2007) (holding that in a particular instance, the design element of the BODYMAN mark was very noticeable and eye-catching, and therefore more dominant than the word element of the mark).

87. No. 2010-1191, 2010 U.S. App. LEXIS 23898 (Fed. Cir. Nov. 18, 2010) (per curiam).

88. *Id.* at \*1.

89. *Id.* at \*1-2.

90. *Id.*



to oppose the application for ANTHONY'S COAL-FIRED PIZZA (and Design), appellee APPI argued that a likelihood of confusion existed and that APPI, having used its mark for restaurant services for more than twenty-three years, had priority.<sup>91</sup> The TTAB and the Federal Circuit agreed.<sup>92</sup>

The appellant first challenged the TTAB's focus on certain factors and its finding of likelihood of confusion.<sup>93</sup> While the TTAB considered all the *DuPont* factors for which there was record evidence, it focused on the factors it considered dispositive, namely similarity of the marks and relatedness of the services.<sup>94</sup> Noting the TTAB's finding that the parties' services are legally identical, the Federal Circuit found that "[w]hen marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines."<sup>95</sup>

Reviewing the TTAB's analysis of the similarity of the marks, the Federal Circuit found that substantial evidence supported the TTAB's finding that the marks were similar.<sup>96</sup> Specifically, the court noted that the TTAB found that "ANTHONY'S" was the dominant portion of each mark and that consumers were likely to shorten both marks to "Anthony's" or "Anthony's Pizza," particularly in light of the weaker, descriptive remaining terms in the marks.<sup>97</sup> Additionally, the TTAB found that the design element in the composite mark was comprised of the letter "A" and that the primary commercial impression engendered thereby remains the name "Anthony's."<sup>98</sup> The TTAB also found that the flames in the design element and the phrase "COAL-FIRED PIZZA" were so much smaller than the word "ANTHONY'S" that they had little or no source-indicating significance and should be given less weight.<sup>99</sup> The Federal Circuit held that the TTAB did not improperly dissect the marks and "properly analyzed the marks in their entireties, while appropriately focusing on the dominant element."<sup>100</sup>

The appellant also argued that APPI failed to police its mark.<sup>101</sup> The Federal Circuit held that the record did not show a reticence on

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91. *Id.* at \*2.

92. *Id.* at \*1, \*10.

93. *Id.* at \*3.

94. *Id.* at \*4.

95. *Id.* at \*4-5 (quoting *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877, 23 U.S.P.Q.2d (BNA) 1698, 1700 (Fed. Cir. 1992) (citations omitted)).

96. *Id.* at \*6.

97. *Id.* at \*5.

98. *Id.*

99. *Id.*

100. *Id.* at \*6.

101. *Id.* at \*7-8.

the appellee's part to protect its mark.<sup>102</sup> In so holding, the court considered evidence of the APPI's watch service and the fact that no evidence disclosed a confusingly similar mark to APPI's mark either registered with the Trademark Office or used in an overlapping geographic area. The court also noted the fact that APPI took efforts to minimize potential confusion with a third party by participating in a co-existence agreement with the owner of the ANTHONY'S PIZZA THE WORLD'S GREATEST mark, which established distinct trade channels between the two.<sup>103</sup>

The Federal Circuit found the TTAB's determination to be precisely consistent with the intent of the Lanham Act, which is to prevent registration of marks likely to cause confusion.<sup>104</sup> This decision is consistent with an abundance of case law holding that the more related the goods and services, the less the degree of similarity of the marks required to support a finding of likelihood of confusion.

### *B. Inherent Distinctiveness/Acquired Distinctiveness of Trade Dress*

In both inherent distinctiveness decisions issued by the Federal Circuit this year, it affirmed the test and governing law as stated in *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*<sup>105</sup> Both cases below illustrate that an applicant's trade dress will not be deemed inherently distinctive if the elements of the trade dress are either common shapes or designs, usual in the relevant field, or if the trade dress consists of a mere refinement of an existing form or ornamentation for the particular class of goods or services.

#### *1. Foundation for a Christian Civilization, Inc. v. Mary Queen of the Third Millennium, Inc.*

*Foundation for a Christian Civilization, Inc. v. Mary Queen of the Third Millennium, Inc.*<sup>106</sup> is an unpublished per curiam decision without opinion affirming the TTAB's judgment in favor of the opposer.<sup>107</sup> In this atypical trademark dispute, after five and one-half years of contentious opposition between two formerly aligned religious groups, both claiming a desire to use the contested trade dress, the TTAB found, in a non-precedential decision, that the applicant's trade dress:

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102. *Id.* at \*7-8.

103. *Id.*

104. *Id.* at \*10.

105. 568 F.2d 1342, 196 U.S.P.Q. (BNA) 289 (C.C.P.A. 1977).

106. 360 F. App'x 150 (Fed. Cir. 2010) (per curiam).

107. *Id.*



was incapable of distinguishing its goods and services.<sup>108</sup>

The trade dress consisted of the design of a ceremonial religious habit: a scapular containing a cross centered on the front and a hood in the back, worn atop a habit with a metal and beaded belt (the “Habit”).<sup>109</sup> The applicant sought to register the Habit for “clothing, namely ceremonial habit worn by distinguished religious representatives in certain ceremonies” and “promoting public awareness of the need for healthy and religious families in the United States.”<sup>110</sup>

The TTAB first examined whether the opposer had standing to oppose the registration of the trade dress on grounds that the applicant’s mark lacked distinctiveness.<sup>111</sup> “To have standing to assert a ground that a mark lacks distinctiveness opposer must have a present or prospective right to use the same or similar ‘mark’ in its ‘business.’”<sup>112</sup> While the opposer had not used the Habit, the TTAB held that such use is not required and found that the opposer had a sufficient interest in the mark to support a finding of standing.<sup>113</sup> Additionally, the TTAB found that the opposer was, in effect, a competitor of the applicant because the opposer—an organization akin to a religious trade association—represented the legal interests of and was affiliated with the group that actually used the Habit.<sup>114</sup>

During examination of the application, the applicant was required to establish acquired distinctiveness with respect to the identified

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108. *Mary Queen of the Third Millenium, Inc. v. Found. for a Christian Civilization, Inc.*, No. 91157073, 2009 TTAB LEXIS 157 (T.T.A.B. Mar. 25, 2009).

109. *Id.* at \*1–2.

110. *Id.* at \*1.

111. *Id.* at \*22.

112. *Id.* at \*24 (citing *Plyboo Am., Inc. v. Smith & Fong Co.*, 51 U.S.P.Q.2d (BNA) 1633 (T.T.A.B. 1999)).

113. *Id.* at \*25–26.

114. *Id.* at \*25.

goods.<sup>115</sup> No similar requirement was made with respect to the applied-for services, and the Examining Attorney found that the Habit was inherently distinctive with respect to those services.<sup>116</sup> The Examining Attorney accepted a declaration submitted by the applicant claiming substantially exclusive and continuous use of the Habit on clothing since 1978 and passed the mark on for publication with respect to all goods and services listed in the application.<sup>117</sup>

In arguing that the Habit was not distinctive of the applicant's goods and services, the opposer first argued that the applicant was aware at the time of filing that the opposer's members had appeared publically wearing the Habit.<sup>118</sup> The opposer also argued that prior to the opposer's and the applicant's schism, the Habit had only been used and perceived as a symbol of dedication to a life of sanctity, that use of the Habit in religious celebrations far outweighed public use by the applicant after the parties' schism; therefore, the Habit had not acquired distinctiveness.<sup>119</sup>

The TTAB, in finding that the Habit lacked inherent distinctiveness, analyzed the distinctiveness question regarding the applied-for goods and services separately. First, the TTAB considered whether the Habit was inherently distinctive with respect to the applied-for services.<sup>120</sup> After finding that the Habit was a form of trade dress that could be inherently distinctive, the TTAB focused on "whether or not it is reasonable to assume that the consumer is predisposed to view the trade dress as a source indicator."<sup>121</sup>

The TTAB applied the relevant *Seabrook*<sup>122</sup> factors: 1) "[w]hether the Habit is a common basic shape or design;" 2) "[w]hether the Habit is unique or unusual in the particular field;" and 3) "[w]hether the Habit is a mere refinement of a commonly-adopted and well-known form or ornamentation for a particular class of goods or services."<sup>123</sup> The TTAB refined these factors to the single question, "whether the design, shape or combination of elements is so unique, unusual or unexpected in this market that one can assume without proof that it will automatically be perceived by customers as an

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115. *Id.* at \*26.

116. *Id.* at \*26-27.

117. *Id.*

118. *Id.* at \*27.

119. *Id.*

120. *Id.* at \*29.

121. *Id.* at \*32.

122. *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 196 U.S.P.Q. (BNA) 289 (C.C.P.A. 1977).

123. *Mary Queen*, 2009 TTAB LEXIS 157, at \*29-30.

indicia of origin—a trademark.”<sup>124</sup> Holding that the Habit was not inherently distinctive, the TTAB found the elements of the Habit “[un]surprising,” “far from novel,” “conventional,” and “prosaic,” such that the Habit could not be assumed to stand out and be perceived as a single source indicator without proof of the same.<sup>125</sup> Instead, the TTAB found that the Habit fell within the “general realm of habits worn by other religious groups.”<sup>126</sup>

In finding that the applicant had not submitted sufficient evidence to demonstrate acquired distinctiveness for either the applied-for goods or services, the TTAB noted that because the trade dress of the Habit was relatively ordinary, the applicant bore a heavy burden to prove acquired distinctiveness.<sup>127</sup> Furthermore, it stated that due to the atypical nature of the proceeding, the types of evidence commonly used to demonstrate acquired distinctiveness—such as sales and advertising figures, promotional efforts, product/service popularity, brand awareness numbers, and market share—were not present.<sup>128</sup>

Considering the evidence as of the time of registrability (i.e., through the trial period)<sup>129</sup> the TTAB discussed the amount and nature of the demonstrated uses of the Habit, such as at weekly meetings by approximately fourteen members, some public events, parades and appearances, and in some media coverage.<sup>130</sup> Ultimately, the TTAB found that the uses were “relatively minor” and fell “far short of establishing acquired distinctiveness of the mark sought to be registered.”<sup>131</sup> In parsing the evidence of events where the Habit was displayed, the TTAB repeatedly noted as significant the small number of attendees in total (typically less than one hundred), the small number of attendees wearing the Habit (typically less than two dozen), and, in particular, the small number of non-member attendees (typically less than thirty).<sup>132</sup>

Overall, the TTAB found the applicant’s evidence lacking regarding exposure of the Habit to members of the public and held that the “mere wearing of the Habit, mostly in private situations, does not magically transform the Habit into a source indicator for

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124. *Id.* at \*33 (quoting J. T. MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 8.02[4] (3d ed. 1993)).

125. *Id.* at \*34.

126. *Id.*

127. *Id.* at \*38.

128. *Id.*

129. *Id.* at \*40–41 (citing *Gen. Foods Corp. v. MGD Partners*, 224 U.S.P.Q. (BNA) 479, 486 (T.T.A.B. 1984)).

130. *Id.* at \*41–42.

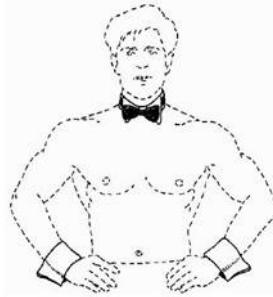
131. *Id.* at \*43.

132. *Id.* at \*42–47.

applicant's goods and services."<sup>133</sup> Finally, the TTAB also found that the opposer's evidence establishing its own, more significant, public use of the Habit rebutted the applicant's contention of the requisite substantially exclusive use.<sup>134</sup> This finding further acted to defeat the applicant's claim of acquired distinctiveness.<sup>135</sup>

## 2. *In re Chippendales USA, Inc.*

In *In re Chippendales USA, Inc.*,<sup>136</sup> the Federal Circuit affirmed the TTAB's denial after an *ex parte* appeal of the applicant's application for the Chippendales uniform trade dress, consisting of cuffs and a bow tie (the "Cuffs & Collar trade dress"), holding that the trade



dress was not inherently distinctive.<sup>137</sup>

At the start of the proceedings, Chippendales already held an incontestable registration for the Cuffs & Collar trade dress on the basis of acquired distinctiveness.<sup>138</sup> After receiving a waiver of the typical bar from registering the same mark for the same goods and services, Chippendales proceeded with the instant application solely in order to resolve the underlying substantive issue: whether the Cuffs & Collar trade dress was inherently distinctive.<sup>139</sup>

Stripping the Federal Circuit's determination down to the bare essentials, the TTAB and the Federal Circuit determined that the trade dress was not inherently distinctive at the time Chippendales sought to register the trade dress,<sup>140</sup> given that the prior use and registrations for adult female costumes consisted of cuffs and a bow

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133. *Id.* at \*47–48.

134. *Id.* at \*50–51.

135. *Id.*

136. 622 F.3d 1346, 96 U.S.P.Q.2d (BNA) 1681 (Fed. Cir. 2010).

137. *Id.* at 1358, 96 U.S.P.Q.2d (BNA) at 1689.

138. *Id.* at 1349, 96 U.S.P.Q.2d (BNA) at 1683.

139. *Id.*, 96 U.S.P.Q.2d (BNA) at 1683.

140. As acknowledged in the TTAB's opinion, the Federal Circuit held that the appropriate time for measuring inherent distinctiveness is at the time of registration, not at the time of first use of the mark. *Id.* at 1354–55, 96 U.S.P.Q.2d (BNA) at 1686–87.

tie and that the relevant market was adult entertainment, not specifically adult entertainment for women.<sup>141</sup>

As they did in *Mary Queen*,<sup>142</sup> both the TTAB and the Federal Circuit applied the *Seabrook* factors in reaching their respective decisions.<sup>143</sup> The Federal Circuit held that the issue of inherent distinctiveness is a factual determination to be made by the TTAB, and that “[i]f a mark satisfies any of the first three [*Seabrook* factors], it is not inherently distinctive.”<sup>144</sup>

Here, the Federal Circuit agreed with the TTAB’s conclusion that the third *Seabrook* factor prevented the Cuffs & Collar trade dress from being deemed inherently distinctive.<sup>145</sup> Citing Chippendales’ inspiration for its trade dress from the pervasive and “ubiquitous Playboy bunny suit, which included cuffs, a collar and bowtie, a corset, and a set of bunny ears,”<sup>146</sup> which had been used for two decades prior to Chippendales’ introduction of its Cuffs & Collar trade dress, the TTAB and Federal Circuit concluded that the Cuffs & Collar trade dress was merely “a refinement of an existing form of ornamentation for the particular class of services.”<sup>147</sup> As such, Chippendales’ trade dress was not of such a design that a consumer would immediately rely on it to differentiate the services from those of competitors, or as a single source identifier.<sup>148</sup>

### C. Genericness

#### 1. Campbell v. Bassani Manufacturing

As with *In re Achenbach Buschhutzen GmbH*,<sup>149</sup> the outcome of *Campbell v. Bassani Manufacturing*<sup>150</sup> highlighted the need to strictly adhere to rules and required procedure. In *Campbell*, the *pro se* trademark applicant’s evidence of non-genericness was rejected after

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141. *Id.* at 1355–57, 96 U.S.P.Q.2d (BNA) at 1687–89.

142. *See supra* Part I.B.1 for a discussion of *Mary Queen*.

143. *In re Chippendales*, 622 F.3d at 1351–52, 96 U.S.P.Q.2d (BNA) at 1684–85.

144. *Id.* at 1350–51, 96 U.S.P.Q.2d (BNA) at 1684.

145. *Id.* at 1356–57, 96 U.S.P.Q.2d (BNA) at 1688.

146. *Id.* at 1350, 96 U.S.P.Q.2d (BNA) at 1683 (citing *In re Chippendales USA, Inc.*, 90 U.S.P.Q.2d (BNA) 1535, 1546 (T.T.A.B. Mar. 25, 2009)).

147. *Id.* at 1350, 1356–57, 96 U.S.P.Q.2d (BNA) at 1683 (citing *In re Chippendales*, 90 U.S.P.Q.2d (BNA) at 1542).

148. *Id.* at 1352, 96 U.S.P.Q.2d (BNA) at 1685.

149. No. 2010-1192, 2010 U.S. App. LEXIS 12248 (Fed. Cir. May 4, 2010). *See infra* Part II.F.2 for a further discussion of *In re Achenbach*.

150. 368 F. App’x 133 (Fed. Cir.), *reh’g denied*, No. 2009-1534, 2010 U.S. App. LEXIS 9432 (Fed. Cir. Apr. 20, 2010) (per curiam). This opinion also involves a procedural issue, namely, the effect of improper submission of evidence before the Board.

he failed to follow the proper procedure for authenticating evidence.<sup>151</sup>

In this case, the applicant “filed an application to register the mark X-PIPE for ‘internal combustion engine exhausts.’”<sup>152</sup> Bassani opposed the registration, arguing, *inter alia*, that X-PIPE is generic.<sup>153</sup> Bassani submitted evidence of genericness, including printouts of magazine articles, newspaper articles, online publications, website printouts, copies of catalogs, and a declaration of a competitor of Campbell.<sup>154</sup> Campbell submitted evidence in response, but the Board rejected Campbell’s evidence as inadmissible under TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE section 528.05(e) because the evidence was not accompanied by an authenticating affidavit or declaration.<sup>155</sup> Bassani prevailed on summary judgment and Campbell’s motion for reconsideration was denied.<sup>156</sup> Campbell appealed to the Federal Circuit.<sup>157</sup>

In affirming the Board, the Federal Circuit framed the genericness test as follows: “[t]o determine whether a term is generic, we identify the genus of goods or services at issue and ask whether the term is ‘understood by the relevant public primarily to refer to that genus of goods or services.’”<sup>158</sup> The Federal Circuit agreed with the Board’s conclusion that there was no genuine issue of material fact as to whether the relevant public primarily understood X-PIPE to refer to “internal combustion engine exhausts which contain exhaust pipes and discharge pipes.”<sup>159</sup>

Along the way, the Federal Circuit rejected Campbell’s argument that separate references by the Board to the genus as “exhaust pipes and discharge pipes” in one instance, and as “internal combustion engine exhausts” in another instance, created inconsistency which would render the Board’s decision reversible.<sup>160</sup> The Federal Circuit also rejected Campbell’s argument that it was improper for the Board to rely upon case law not cited by the parties.<sup>161</sup>

While it is not clear that the outcome of this case would have been different if Campbell had followed the procedural rules, it is clear

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151. *Id.* at 133–35.

152. *Id.* at 133.

153. *Id.* at 133–34.

154. *Id.* at 134.

155. *Id.*

156. *Id.*

157. *Id.*

158. *Id.* (quoting *In re 1800Mattress.com IP, L.L.C.*, 586 F.3d 1359, 1364 (Fed. Cir. 2009)).

159. *Id.* (quotation omitted).

160. *Id.*

161. *Id.* at 135.



that the trademark applicant had no leg to stand on given his failure to authenticate his evidence. *Pro se* trademark applicants beware: the rules apply equally to you.

## 2. *In re Sharp*

In *In re Sharp*,<sup>162</sup> the Federal Circuit affirmed, per curiam, and without opinion,<sup>163</sup> the TTAB's non-precedential decision in an *ex parte* appeal that denied registration of the mark PHONECASTING on the Supplemental Registry because it was generic.<sup>164</sup> The mark PHONECASTING referred to "wireless communications services, specifically, the transmission of multimedia content to mobile telephones and wireless communications devices via the Internet."<sup>165</sup> The Board's discussion of genericism and the evidence presented by the Examining Attorney provide useful guidelines regarding the types of evidence sufficient to support a finding of genericism and why the PHONECASTING application was denied pursuant to Section 23 of the Lanham Act.<sup>166</sup> In affirming the Examining Attorney's finding that the mark was generic, the Board first found that there was "a distinct genre or type of wireless communication services conducted specifically by telephone," and further found that the Examining Attorney accurately described the category of services at issue as "wireless communication services."<sup>167</sup>

In the remainder of the opinion, the Board discussed the plethora of evidence submitted by the Trademark Office that demonstrated how the relevant consumers perceived the term "phonecasting."<sup>168</sup> The evidence included patent applications bearing the term in the title and explaining the invention in accordance with the services listed in the applicant's application, dictionary and Wikipedia entries

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162. No. 2010-1148, 2010 U.S. App. LEXIS 25356, at \*1 (Fed. Cir. Dec. 13, 2010) (per curiam). This opinion also involves a procedural issue regarding objections to arguments and evidence presented by the Examining Attorney in an *ex parte* appeal. *Id.*

163. *Id.*

164. *In re Sharp*, No. 78765022, 2009 WL 4085613, at \*4 (T.T.A.B. Aug. 31, 2009). During the *ex parte* appeal to the TTAB, the applicant raised a procedural issue, objecting to the basis of the Trademark Office's final refusal and its submission of evidence to the Board in support of the refusal. *Id.* at \*1-3. Specifically, the applicant argued that the Examining Attorney improperly sought to change the basis of the final refusal from descriptive to genericism; however, the Board rejected the applicant's argument in light of the Trademark Office's mandate to register only eligible marks and because it found the Examining Attorney's citation to a wrong rule inconsequential given that the Examining Attorney accurately explained her position. *Id.*

165. *Id.* at \*4.

166. *Id.* at \*3-6; see also 15 U.S.C. § 1091(a)-(c) (2006) (explaining the registration process for the Supplemental Registry).

167. *In re Sharp*, 2009 WL 4085613, at \*4.

168. *Id.* at \*4-6.

for the term, news articles discussing the term, numerous websites and blogs referencing the term in connection with the services as applied for by the applicant, and press releases from entities launching “phonecasting service[s]” and applications.<sup>169</sup> After considering all of the above, the Board found that “the primary significance of the term ‘phonecasting’ as applied to wireless communications services is a generic or common name.”<sup>170</sup>

#### D. Descriptiveness

##### 1. *In re* The Lex Group VA

In *In re The Lex Group VA*,<sup>171</sup> an unpublished per curiam judgment without opinion, the Federal Circuit affirmed the Board’s non-precedential decision to affirm the Examining Attorney’s refusal to register the mark E-LEX as merely descriptive of the applicant’s services, pursuant to Section 2(e)(1) of the Lanham Act.<sup>172</sup> The applicant sought to register E-LEX for “litigation support services for attorneys provided via an electronic network with court-specific consultation on the rules and implementation of procedures for filing electronically.”<sup>173</sup> In finding the mark descriptive, both the Examining Attorney and the Board cited four dictionary definitions in which “lex” means “law”, and the Board took judicial notice of the definition.<sup>174</sup> The Examining Attorney and the Board also cited numerous dictionary definitions, other references, and cases in which the term “e” was found to be “a term that simply describes the fact that the goods or services are associated with the internet,” or that they are electronic in nature.<sup>175</sup> Finally, the Board noted that “the addition of the hyphen is not significant” and that the combination of the two terms does not have any unique meaning “that would be different from the individual terms.”<sup>176</sup>

##### 2. ERBE Elektronedizin GmbH v. Canady Technology L.L.C.

In the only color mark decision issued in 2010, *ERBE Elektronedizin GmbH v. Canady Technology L.L.C.*,<sup>177</sup> the Federal Circuit affirmed both

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169. *Id.*

170. *Id.* at \*6.

171. 383 F. App’x 949 (Fed. Cir. 2010) (per curiam).

172. *Id.* (affirming *In re* Lex Group VA, No. 76665046, 2009 TTAB LEXIS 534 (T.T.A.B. Aug. 28, 2009)); see also 15 U.S.C. § 1052(e)(1) (2006) (not permitting registration of a trademark if it is “merely descriptive”).

173. *In re Lex Group*, 2009 TTAB LEXIS 534, at \*7.

174. *Id.* at \*2, \*4–5.

175. *Id.* at \*4–7.

176. *Id.* at \*6, \*8.

177. 629 F.3d 1278, 97 U.S.P.Q.2d (BNA) 1048 (Fed. Cir. 2010) (per curiam).

the district court's grant of summary judgment in favor of Canady dismissing ERBE's trademark and trade dress infringement claims and the district court's finding that ERBE's blue color mark and trade dress were not protectable.<sup>178</sup>

ERBE based its trademark infringement claims on a registration from the Supplemental Register for the color blue for surgical endoscopic probes and common law rights in trade dress consisting of a blue tube with black markings at the end of the probe.<sup>179</sup> The Examining Attorney denied ERBE's application to register the color mark on the Principal Register after determining that the color blue on probes was ornamental and that ERBE failed to show evidence of secondary meaning, of whether competitors used the color for their products, and of whether the color was functional.<sup>180</sup>

Asserting a mark registered only on the Supplemental Register, ERBE bore the burden of proving that it owned a valid mark.<sup>181</sup> Specifically, in order to survive summary judgment, ERBE would have had to establish a genuine issue of material fact that the color blue was non-functional and had acquired secondary meaning in connection with endoscopic probes.<sup>182</sup> With respect to functionality, a "[c]olor may not be granted trademark protection if the color performs a utilitarian function in connection with the goods it identifies or there are specific competitive advantages for use."<sup>183</sup> The evidence in the record demonstrated that the color blue was prevalent in the medical field and that blue was specifically used by companies in the field on endoscopic probes because the color enhances identification of the endoscopic tip.<sup>184</sup> Consequently, the Federal Circuit concluded that the district court properly found the

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178. *Id.* at 1280, 97 U.S.P.Q.2d (BNA) at 1050.

179. *Id.* at 1282, 97 U.S.P.Q.2d (BNA) at 1051.

180. *Id.* at 1287, 97 U.S.P.Q.2d (BNA) at 1055–56. In dissenting, Judge Newman challenged the majority's recitation and application of trademark law regarding functionality, stating that the fact that ERBE was granted a registration in the Supplemental Register established in and of itself a genuine issue as to the question, given that the Trademark Office's Trademark Manual of Examining Procedure dictates that functional marks are not registrable on either the Principal or Supplemental Registers. *See id.* at 1294, 97 U.S.P.Q.2d (BNA) at 1060 (Newman, J., dissenting) (citing TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1202.05(b) (7th ed. 2010)). Judge Newman also criticized the majority's and the district court's evaluations and determinations of factual issues, arguing that genuine issues of fact existed both with respect to functionality and secondary meaning. *Id.* at 1294–96, 97 U.S.P.Q.2d (BNA) at 1060–61 (Newman, J., dissenting).

181. *Id.* at 1288, 97 U.S.P.Q.2d (BNA) at 1056.

182. *Id.*, 97 U.S.P.Q.2d (BNA) at 1056.

183. *Id.*, 97 U.S.P.Q.2d (BNA) at 1056 (citing *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 1530–33, 32 U.S.P.Q.2d (BNA) 1120, 1122–24 (Fed. Cir. 1994), *cert. denied*, 514 U.S. 1050 (1995)).

184. *Id.* at 1289, 97 U.S.P.Q.2d (BNA) at 1057.

mark to be functional and held that appropriation by ERBE alone of the color blue would place others at a competitive disadvantage.<sup>185</sup>

In dicta, the Federal Circuit stated that it would also affirm on the issue of secondary meaning of the mark because ERBE failed to present any evidence that, “in the minds of the public, the primary significance of the color blue is to identify ERBE as the source of the product.”<sup>186</sup> The Federal Circuit also summarily affirmed the district court’s dismissal of ERBE’s trade dress claims “because ERBE failed to present any argument that the black rings on the end of the probe were non-functional” and, similarly, because ERBE presented no “evidence relating to its trade dress claims on appeal.”<sup>187</sup>

### *E. Primarily Geographically Descriptive*

#### *1. Bell’s Brewery, Inc. v. Bell Hill Vineyards, L.L.C.*

In *Bell’s Brewery, Inc. v. Bell Hill Vineyards, L.L.C.*,<sup>188</sup> a per curiam decision without opinion, the Federal Circuit affirmed the TTAB’s dismissal of the appellant’s opposition proceeding on all grounds: likelihood of confusion, fraud, and that the applicant’s mark was primarily geographically descriptive.<sup>189</sup> The applicant sought to register BELL HILL for wine.<sup>190</sup> The appellant owned a registration for BELL’S (and Design) for beer.<sup>191</sup>



The Board stated that the test for determining whether an applicant’s mark should be refused as “primarily geographically

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185. *Id.*, 97 U.S.P.Q.2d (BNA) at 1057.

186. *Id.* at 1290, 97 U.S.P.Q.2d (BNA) at 1057.

187. *Id.* at 1291, 97 U.S.P.Q.2d (BNA) at 1058.

188. No. 2010-1280, 2010 U.S. App. LEXIS 25499 (Fed. Cir. Dec. 13, 2010) (per curiam). This opinion also involves likelihood of confusion and fraud issues.

189. *Id.* at \*1, *affg*, No. 91177980, 2009 TTAB LEXIS 699 (T.T.A.B. Dec. 18, 2009).

190. *Bell’s Brewery, Inc. v. Bell Hill Vineyards, L.L.C.*, No. 91177980, 2009 TTAB LEXIS 699, at \*1 (T.T.A.B. Dec. 18, 2009).

191. *Id.* at \*1-2.

descriptive,” under Section 2(e)(2) of the Lanham Act<sup>192</sup> is whether “the term in the mark sought to be registered is the name of a place known generally to the public” and that “the public would . . . believe that the goods or services for which the mark is sought to be registered originate in that place.”<sup>193</sup> The Board makes the determination “in connection with the goods or services with which the mark is used and from the perspective of the relevant public for those goods.”<sup>194</sup> While typically it may be presumed that there is a goods/place association if the goods do in fact emanate from the place named in the mark, an exception to that presumption exists if “the place named in the mark is so obscure or remote that purchasers would fail to recognize the term as indicating the geographical source of the goods.”<sup>195</sup>

The Board referred to several evidentiary points in finding the exception applicable and “Bell Hill” obscure, despite the fact that a road named Bell Hill existed near the applicant.<sup>196</sup> Specifically, the Board found that the opposer failed to establish that Bell Hill designated a specific geographic region or location other than a local road, known at best only by locals; further, the Board found that the opposer’s handful of submitted marketing materials and menus referencing Bell Hill was insufficient.<sup>197</sup> While the applicant submitted its own evidence from the Geographic Names Information Systems<sup>198</sup> showing that no such geographic designation existed in its area, the Board rejected this evidence as not relevant and insufficient to create a genuine issue of material fact, reiterating that the opposer need only prove that the place is known generally to the public and that the public would make a goods/place association.<sup>199</sup>

Once the Board determined that Bell Hill was remote, the opposer’s fraud claim also quickly fell. Because the opposer did not prove the stringent fraud elements, the Board found that the applicant did not commit fraud when it represented to the

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192. 15 U.S.C. § 1052(e)(2) (2006).

193. See *Bell’s Brewery*, 2009 TTAB LEXIS 699, at \*14 (citing *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 959, 3 U.S.P.Q.2d (BNA) 1450, 1452 (Fed Cir. 1987)).

194. See *id.* at \*15 (citing *In re MCO Properties Inc.*, 1995 WL 838977, 38 U.S.P.Q.2d (BNA) 1154 (T.T.A.B. 1995)).

195. *Id.* at \*14–15 (quoting *Vittel*, 824 F.2d at 959, 3 U.S.P.Q.2d (BNA) at 1451).

196. *Id.* at \*15–16.

197. *Id.*

198. The Geographic Names Information Systems database is maintained by the U.S. Board of Geographic Names, within the U.S. Geological Survey in the Department of the Interior. *Id.* at \*16.

199. *Id.* at \*16 n.8.

Trademark Office that Bell Hill did not have a geographic significance.<sup>200</sup>

Finally, in applying the *DuPont* factors, the Board concluded that there was no likelihood of confusion between the parties' marks.<sup>201</sup> Of all the *DuPont* factors, the Board found that the dissimilarities of the marks carried the most weight here.<sup>202</sup> In reaching this conclusion, the Board emphasized the dominance of BELL'S in the opposer's mark, the fact that the applicant's mark was a unitary phrase giving the impression of a place, and that the connotation and commercial impressions given off by both were sufficiently different to outweigh any similarities based upon the common element BELL.<sup>203</sup>

#### F. Abandonment

##### 1. The Crash Dummy Movie, L.L.C. v. Mattel, Inc.

In *Crash Dummy Movie, L.L.C. v. Mattel, Inc.*,<sup>204</sup> the appellant and applicant of the mark CRASH DUMMIES crashed and burned when the Federal Circuit found no abuse of discretion by the TTAB. The court affirmed the TTAB's decision to sustain an opposition brought by Mattel based upon its marks CRASH DUMMIES and THE INCREDIBLE CRASH DUMMIES.<sup>205</sup> The Federal Circuit found that substantial evidence existed to support the TTAB's finding that Mattel had overcome the statutory presumption of abandonment of its marks and that "no doubt" existed that the appellant's mark was likely to be confused with the appellee's marks in light of the parties' agreement that likelihood of confusion existed.<sup>206</sup>

Mattel's former owner ceased use of its marks in late 1995 or early 1996.<sup>207</sup> Mattel purchased the marks in 1997.<sup>208</sup> Mattel recorded the assignment of the marks in 1998, but the United States Patent and Trademark Office cancelled the registrations in 2000 due to Mattel's failure to submit Section 8 declarations of use.<sup>209</sup> The TTAB and the Federal Circuit found that recordation of the trademark assignment in 1998, evidence of toy development from 2000 to 2003, and a first shipment of toys bearing the mark CRASH DUMMIES in December

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200. *Id.* at \*18.

201. *Id.* at \*5-13.

202. *Id.* at \*13.

203. *Id.* at \*12-13.

204. 601 F.3d 1387, 94 U.S.P.Q.2d (BNA) 1315 (Fed. Cir. 2010).

205. *Id.* at 1389, 94 U.S.P.Q.2d (BNA) at 1315.

206. *Id.*, 94 U.S.P.Q.2d (BNA) at 1315.

207. *Id.*, 94 U.S.P.Q.2d (BNA) at 1315-16.

208. *Id.* at 1390, 94 U.S.P.Q.2d (BNA) at 1316.

209. *Id.*, 94 U.S.P.Q.2d (BNA) at 1316.

2003 together constituted sufficient evidence to rebut the presumption that the marks had been abandoned.<sup>210</sup>

On appeal, under the “substantial evidence standard,” the Federal Circuit must determine “whether a reasonable person might find that the evidentiary record supports the agency’s conclusion.”<sup>211</sup> The TTAB found that Mattel showed “reasonable grounds for the suspension and plans to resume use in the reasonably foreseeable future when the conditions requiring suspension abate[d].”<sup>212</sup> In upholding the TTAB’s conclusion, the Federal Circuit pointed to several specific facts. First, it referenced the fact that the marks had not been abandoned before they were assigned to Mattel in 1997 and that the appellant did not challenge this issue.<sup>213</sup> Second, as the Federal Circuit reiterated, a finding of abandonment requires not only a cessation of use, but also a finding of intent not to resume such use.<sup>214</sup> In holding Mattel had not abandoned the marks, the Federal Circuit cited Mattel’s evidence that it intended to resume use of the marks, specifically, Mattel’s (i) discussions with a third-party retailer regarding an exclusive sales arrangement and retooling of the product line in 1998, (ii) the fact that Mattel recorded the trademark assignment in 1998, and (iii) the internal documents and testimony regarding research and development efforts from 2000 to 2003 to launch a new product line.<sup>215</sup> Finally, the Federal Circuit also cited the shipment of toys bearing the mark at the end of 2003 as supportive of Mattel’s witness’ testimony regarding the planning and development of the new product line under the CRASH DUMMIES mark.<sup>216</sup> The Federal Circuit also made it a point to note that “cancellation of a trademark registration does not necessarily translate into abandonment of common law trademark rights. Nor does it establish an owner’s lack of intent to use a mark.”<sup>217</sup>

### G. “All or Substantially All” Gray Goods Infringement Test

#### 1. Deere & Co. v. ITC

*Deere & Co. v. ITC*<sup>218</sup> is the only 2010 trademark case that involved an appeal from the United States International Trade Commission (“ITC”). The case involved a challenge to the ITC’s application of

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210. *Id.* at 1391-92, 94 U.S.P.Q.2d (BNA) at 1316-18.

211. *Id.* at 1390, 94 U.S.P.Q.2d (BNA) at 1316.

212. *Id.*, 94 U.S.P.Q.2d (BNA) at 1316.

213. *Id.* at 1391, 94 U.S.P.Q.2d (BNA) at 1316-17.

214. *Id.*, 94 U.S.P.Q.2d (BNA) at 1316 (citing 15 U.S.C. § 1127 (2006)).

215. *Id.*, 94 U.S.P.Q.2d (BNA) at 1317.

216. *Id.* at 1391-92, 94 U.S.P.Q.2d (BNA) at 1317.

217. *Id.* at 1391, 94 U.S.P.Q.2d (BNA) at 1317.

218. 605 F.3d 1350, 95 U.S.P.Q.2d (BNA) 1206 (Fed. Cir. 2010).

Section 337 of the Tariff Act of 1930.<sup>219</sup> After review, the Federal Circuit vacated and remanded the ITC's judgment denying Deere & Co. ("Deere") an exclusion order after the ITC had determined that the sale of European versions of John Deere harvesters in the United States by third parties did not violate Section 337.<sup>220</sup> The Federal Circuit held that the ITC improperly applied the "all or substantially all" test for finding trademark infringement based on gray market goods under the Tariff Act.<sup>221</sup> Gray market goods are goods that are "produced by the owner of the United States trademark or with its consent, but [are] not authorized for sale in the United States."<sup>222</sup>

This was the second trip to the Federal Circuit for these litigants. In 2004, the ITC had granted a general exclusion order barring importation of European-version harvesters bearing Deere trademarks, gray market Deere harvesters, which Bourdeau Bros., Inc., a Deere dealer, appealed to the Federal Circuit.<sup>223</sup> In that appeal, the Federal Circuit vacated in part and remanded the ITC's decision, dictating that Deere show that "all or substantially all" of Deere's authorized domestic products were materially different from the accused gray market goods.<sup>224</sup> After remand, the ITC determined that not "all or substantially all" of the authorized harvesters sold in the United States were North American-version harvesters, thus concluding that Deere was not entitled to relief for a violation of Section 337 for gray market trademark infringement. That ITC decision led to the instant appeal.

Deere manufactured self-propelled forage harvesters for sale in Europe, but manufactured different forage harvesters for sale in the United States (the "North American harvester").<sup>225</sup> Both forage harvesters, however, were sold under Deere trademarks that were registered in the United States.<sup>226</sup> Deere objected to the sale of the European version of the harvesters in the United States by various third parties, and Deere contended that such sales infringed Deere's trademarks through gray market importation.<sup>227</sup> Deere's products were either sold by independent dealers who operated without

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219. 19 U.S.C. § 1337 (2006) (providing a trade remedy against unfair import competition).

220. *Deere*, 605 F.3d at 1351, 95 U.S.P.Q.2d (BNA) at 1207.

221. *Id.*, 95 U.S.P.Q.2d (BNA) at 1207.

222. *Id.* at 1352, 95 U.S.P.Q.2d (BNA) at 1208.

223. *Bourdeau Bros., Inc. v. Int'l Trade Comm'n*, 444 F.3d 1317, 78 U.S.P.Q.2d 1221 (Fed. Cir. 2006).

224. *Id.* at 1327, 78 U.S.P.Q.2d at 1224.

225. *Deere*, 605 F.3d at 1352, 95 U.S.P.Q.2d (BNA) at 1208.

226. *Id.*, 95 U.S.P.Q.2d (BNA) at 1207.

227. *Id.* at 1351, 95 U.S.P.Q.2d (BNA) at 1207.



oversight from Deere or official dealers who operated pursuant to a dealership agreement with Deere.<sup>228</sup>

A trademark owner is entitled to recover for a violation of Section 337 for gray market trademark infringement as long as all or substantially all of the trademark owner's authorized sales in the United States are of the permitted, United States version of the product.<sup>229</sup> The reasoning behind this rule is to prevent the inconsistency of allowing a trademark owner to argue that consumers will be confused by the sale of gray goods, while simultaneously allowing the trademark owner to sell goods other than its defined United States product.<sup>230</sup>

The ITC refused to find gray market goods infringement or allow Deere to recover for a violation of Section 337 because the ITC calculated that as many as 40% to 57% of the European harvesters sold in the United States had been sold by "official" Deere dealers, and consequently, Deere itself was responsible for introducing the nonconforming goods into U.S. commerce.<sup>231</sup>

On appeal, Deere first challenged which categories of European harvester sales were counted as "authorized" sales; however, the Federal Circuit affirmed each of the ITC's decisions, finding that they were supported by substantial evidence.<sup>232</sup> Of note, the ITC and the Federal Circuit held that apparent authority of official Deere dealers—defined as buyers' reasonable belief based on the acts and omissions of Deere that sales were authorized—is sufficient for sales to be deemed authorized.<sup>233</sup> The Federal Circuit also held that as long as a dealer was an "official" dealer, it did not matter whether the dealer that made the sale into the United States was located in Europe or the United States.<sup>234</sup>

Second, Deere argued that regardless of the number of "authorized" sales of European harvesters, the ITC still misapplied the formula used to determine the "all or substantially all test."<sup>235</sup> The Federal Circuit agreed that the ITC misapplied the formula that the Federal Circuit itself had dictated be used in a prior decision in this matter.<sup>236</sup> Instead of dividing the number of authorized European

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228. *Id.* at 1352, 95 U.S.P.Q.2d (BNA) at 1207–08.

229. *Id.*, 95 U.S.P.Q.2d (BNA) at 1208.

230. *Id.* at 1352–53, 95 U.S.P.Q.2d (BNA) at 1208.

231. *Id.* at 1354–55, 95 U.S.P.Q.2d (BNA) at 1209–10.

232. *Id.* at 1355–57, 95 U.S.P.Q.2d (BNA) at 1210–11.

233. *Id.* at 1357, 95 U.S.P.Q.2d (BNA) at 1211–12.

234. *Id.* at 1357–58, 95 U.S.P.Q.2d (BNA) at 1212.

235. *Id.* at 1358–59, 95 U.S.P.Q.2d (BNA) at 1213.

236. *See id.* at 1360, 95 U.S.P.Q.2d (BNA) at 1214 (explaining the proper way to calculate the "all or substantially all" test in this case as requiring Deere to establish "by a preponderance of the evidence that the number of sales of European forage

harvesters sold in the United States (141) by the total number of authorized harvesters sold in the United States (*both the North American and the European versions* (between 4,541 and 4,555)), the ITC divided the number of authorized European harvesters sold in the United States (141) by only the total number of European harvester versions sold in the United States (between 247 and 347).<sup>237</sup> Thus, the true calculation of authorized sales totaled only 3.1% to 3.4%, in stark contrast to the ITC's calculation that 40% to 57% of the non-confirming, European harvesters sold in the United States were authorized.<sup>238</sup>

While a prior decision by the United States Court of Appeals for the Second Circuit found that 4.4% of authorized gray goods sales was a small enough number to allow a trademark owner relief,<sup>239</sup> the Federal Circuit remanded the case back to the ITC to determine whether 3.1% to 3.4% is an insubstantial percentage. If deemed insubstantial, Deere would be entitled to relief under Section 337 of the Tariff Act, and the gray market harvesters (European-version harvesters) would be excluded from the United States.<sup>240</sup>

## II. PROCEDURAL TRADEMARK ISSUES<sup>241</sup>

This year, the Federal Circuit rendered several decisions which made it clear that not only do litigants have trouble following rules, but that the TTAB also must pay them closer attention.

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harvesters was so small that substantially all of Deere's sales in the United States were of North American forage harvesters, such that substantially all of the authorized sales were of goods bearing the asserted material differences").

237. *Id.* at 1359, 95 U.S.P.Q.2d (BNA) at 1214-15.

238. *Id.* at 1360, 95 U.S.P.Q.2d (BNA) at 1214-15.

239. *See Warner-Lambert Co. v. Northside Dev. Corp.*, 86 F.3d 3, 7-8 (2d Cir. 1996) (reversing the lower court's denial of injunctive relief to trademark owner).

240. *Deere*, 605 F.3d at 1361, 95 U.S.P.Q.2d (BNA) at 1215.

241. *See supra* Part I. For additional procedural decisions, *see, e.g., In re Sharp*, No. 2010-1148, 2010 U.S. App. LEXIS 25356, at \*1 (Fed. Cir. Dec. 13, 2010) (per curiam) (objections to arguments and evidence presented by the Examining Attorney in *ex parte* appeal); *Odom's Tenn. Pride Sausage v. FF Acquisition, L.L.C.*, 600 F.3d 1343, 1346, 93 U.S.P.Q.2d (BNA) 2030 (Fed. Cir. 2010) (effect of unpled claims); *Campbell v. Bassani Mfg.*, 368 F. App'x 133 (Fed. Cir. 2010) (per curiam) (repercussions for failure to adhere to TTAB's authentication of evidence procedure); *Univ. of S.C. v. Univ. of S. Cal.*, 367 F. App'x 129 (Fed. Cir. 2010), *cert. denied*, 131 S. Ct. 387 (2010) (standing requirements); *Found. for a Christian Civilization, Inc. v. Mary Queen of the Third Millennium, Inc.*, 360 F. App'x 150 (Fed. Cir. 2010) (per curiam) (standing requirements).

*A. Motion for Leave to Amend**I. Fred Beverages, Inc. v. Fred's Capital Management Co.*

In *Fred Beverages, Inc. v. Fred's Capital Management Co.*,<sup>242</sup> the Federal Circuit held that the Board acted in an arbitrary and capricious manner when it denied a motion for leave to amend a petition for cancellation of a registered trademark.<sup>243</sup>

Fred Beverages, Inc. originally sought cancellation of Fred's Capital Management Company's registration in International Class 32 on the grounds of abandonment.<sup>244</sup> The beverage company's original petition for cancellation was accompanied by the \$300.00 payment required by 37 C.F.R. § 2.6(a)(16).<sup>245</sup> Subsequently, the beverage company filed a motion for leave to amend its cancellation petition to state new grounds of cancellation in connection with International Classes 2, 25, 28, and 29 of the twelve-class registration and to include fraud as an additional ground for cancellation of the registration in International Class 32.<sup>246</sup> The Board denied the motion for leave to amend the cancellation petition because movant Fred Beverages, Inc. did not submit a \$300.00 payment with its motion.<sup>247</sup>

The Federal Circuit concluded that the Board had no legal basis for its decision.<sup>248</sup> According to the Federal Circuit, 37 C.F.R. § 2.6(a)(16) requires a \$300.00 payment only with respect to the filing of a petition of cancellation.<sup>249</sup> However, because there is no stated rule or established practice requiring that a motion for leave to amend a petition for cancellation be accompanied by a statutory fee corresponding to the classes for which cancellation is sought by amendment, there was no authority to support the Board's decision.<sup>250</sup>

Further, the Federal Circuit noted that in other cases, the Board granted or deferred ruling on motions for leave and set a subsequent deadline for the payment of the underlying fee.<sup>251</sup> Because the Board departed here from established precedent without a reasoned

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242. 605 F.3d 963, 94 U.S.P.Q.2d (BNA) 1958 (Fed. Cir. 2010).

243. *Id.* at 964, 94 U.S.P.Q.2d (BNA) at 1958.

244. *Id.*, 94 U.S.P.Q.2d (BNA) at 1958.

245. *Id.*, 94 U.S.P.Q.2d (BNA) at 1958.

246. *Id.*, 94 U.S.P.Q.2d (BNA) at 1959.

247. *Id.* at 965, 94 U.S.P.Q.2d (BNA) at 1959.

248. *Id.* at 967, 94 U.S.P.Q.2d (BNA) at 1960.

249. *Id.* at 966, 94 U.S.P.Q.2d (BNA) at 1959.

250. *Id.* at 966-67, 94 U.S.P.Q.2d (BNA) at 1959-60.

251. *Id.* at 967, 94 U.S.P.Q.2d (BNA) at 1960.

explanation, the Federal Circuit vacated its decision as arbitrary and capricious.<sup>252</sup>

*B. Case or Controversy and Standing to Sue*

*I. Green Edge Enterprises, L.L.C. v. Rubber Mulch Etc., L.L.C.*

In *Green Edge Enterprises, L.L.C. v. Rubber Mulch Etc., L.L.C.*,<sup>253</sup> the Federal Circuit reversed the United States District Court for the Eastern District of Missouri's dismissal of defendant Rubber Mulch's counterclaim on the basis of lack of controversy.<sup>254</sup> The Federal Circuit held that a cease and desist letter threatening suit and a current trademark infringement claim constituted sufficient case or controversy to permit Rubber Mulch to proceed with its counterclaim.<sup>255</sup> Rubber Mulch sought a declaratory judgment of noninfringement against both the plaintiff and the third-party trademark assignee, International Mulch, brought into the case by the defendants as a second counterclaim defendant.<sup>256</sup> The Federal Circuit also affirmed the district court's decision finding no case or controversy and dismissing defendant Rubber Resources' counterclaims because the trademark infringement claim did not extend to Rubber Resources, nor had it been a recipient of a cease and desist letter.<sup>257</sup> The Federal Circuit explained that only the party with legal title to the mark is entitled to prosecute an infringement suit.<sup>258</sup>

Ruling in favor of International Mulch on its motion for summary judgment, the District Court found that no case or controversy existed because International Mulch had not demanded in its cease and desist letter that Rubber Mulch cease using the mark.<sup>259</sup> The District Court found that although Rubber Mulch did have a reasonable apprehension of litigation as a result of the cease and desist letter, no case or controversy existed because Rubber Mulch had not demonstrated that it intended to use "Rubber Mulch" as a

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252. See *id.*, 94 U.S.P.Q.2d (BNA) at 1960 (citing *Pontchartrain Broad. Co. v FCC*, 15 F.3d 183, 185 (D.C. Cir. 1994) and *Graphic Commc'ns Int'l Union, Local 554 v. Salem-Gravure*, 843 F.2d 1490, 1493 (D.C. Cir. 1988) for the proposition that, where an agency "depart[s] from established precedent without a reasoned explanation [its] decisions will be vacated as arbitrary and capricious").

253. 620 F.3d 1287, 96 U.S.P.Q.2d (BNA) 1425 (Fed. Cir. 2010).

254. *Id.* at 1290, 96 U.S.P.Q.2d (BNA) at 1427.

255. *Id.* at 1301, 96 U.S.P.Q.2d (BNA) at 1435.

256. *Id.*, 96 U.S.P.Q.2d (BNA) at 1435.

257. *Id.* at 1302, 96 U.S.P.Q.2d (BNA) at 1435.

258. *Id.* at 1301, 96 U.S.P.Q.2d (BNA) at 1435.

259. *Id.* at 1292-93, 96 U.S.P.Q.2d (BNA) at 1428.

trademark, and instead planned only to use it descriptively.<sup>260</sup> The defendants appealed the dismissal of their counterclaims.

The Federal Circuit found appellee International Mulch's arguments that Rubber Mulch claimed the term was not being used as a trademark and was only descriptive were "disingenuous" because Rubber Mulch stated that it did intend to continue using the phrase "Rubber Mulch."<sup>261</sup> The Federal Circuit found that those arguments related to Rubber Mulch's defenses to the plaintiff's infringement claim, and did not impact whether a case or controversy existed with respect to Rubber Mulch's noninfringement and invalidity counterclaims.<sup>262</sup> Instead, the Federal Circuit held that its analysis with respect to whether a case or controversy existed was satisfied, as both the plaintiff and International Mulch accused Rubber Mulch of "infringing a valid trademark, which is the hallmark of an actual controversy."<sup>263</sup>

During the appellate hearing, International Mulch (the alleged assignee of the plaintiff's trademark) sought to influence the Federal Circuit's determination regarding case or controversy with respect to the counterclaims by representing that the plaintiff was prepared to drop its trademark infringement claim against Rubber Mulch entirely.<sup>264</sup> The Federal Circuit clarified that the plaintiff's offer to dismiss the infringement claim did not divest the court of its declaratory judgment jurisdiction.<sup>265</sup>

In discussing the fact that the legal title to the mark allegedly infringed upon was in question, the Federal Circuit also reiterated that only the party with the legal title to the mark was entitled to prosecute an infringement suit, and that "if International Mulch [was] found to be the legitimate assignee, only [it would have] standing to sue for infringement."<sup>266</sup> The Federal Circuit explained that in such circumstances, a "court may not dismiss an action for failure to prosecute in the name of the real party in interest until, after an objection, a reasonable time has been allowed for the real party in interest to ratify, join, or be substituted into the action."<sup>267</sup> Here, the Federal Circuit stated that if plaintiff Green Edge was "ultimately found not to have standing to pursue its infringement

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260. *Id.* at 1293, 96 U.S.P.Q.2d (BNA) at 1428–29.

261. *Id.* at 1301–02, 96 U.S.P.Q.2d (BNA) at 1435.

262. *Id.*, 96 U.S.P.Q.2d (BNA) at 1435.

263. *Id.* at 1302, 96 U.S.P.Q.2d (BNA) at 1435.

264. *Id.* at 1301 n.4, 96 U.S.P.Q.2d (BNA) at 1434 n.4.

265. *Id.*, 96 U.S.P.Q.2d (BNA) at 1434 n.4.

266. *Id.* at 1301, 96 U.S.P.Q.2d (BNA) at 1435.

267. *Id.*, 96 U.S.P.Q.2d (BNA) at 1435 (citing *In re Signal Int'l, L.L.C.*, 579 F.3d 478, 487 (5th Cir. 2009) (quoting FED. R. CIV. P. 17(a)(3))).

claim,” International Mulch could be substituted as the party in interest.<sup>268</sup>

*C. Default Judgment; Ordering of Determination of Multiple Motions; Timing of Suspension*

*1. Benedict v. Super Bakery, Inc.*

In *Benedict v. Super Bakery, Inc.*,<sup>269</sup> the Federal Circuit vacated the TTAB’s entry of a default judgment against the respondent in a cancellation proceeding and remanded the case.<sup>270</sup> While noting the TTAB’s apparent failure to discuss its own rule, Trademark Rule 2.217(d), in its opinion below, the Federal Circuit refrained from ruling on the rule’s applicability in the first instance and instead vacated the lower decision of the TTAB.<sup>271</sup> Trademark Rule 2.127(d) relates to suspension of proceedings upon filing dispositive motions.<sup>272</sup>

Petitioner Super Bakery filed a motion to compel discovery responses from the *pro se* respondent, Benedict, who failed to comply with the TTAB’s order directing responses to the petitioner.<sup>273</sup> Instead of granting Super Bakery’s motion for a default judgment, the TTAB gave Benedict a second chance to produce discovery responses.<sup>274</sup> The day before the TTAB’s second established deadline, Benedict filed a motion for summary judgment instead of producing discovery.<sup>275</sup> In response, the TTAB granted Super Bakery’s motion for sanctions and for default judgment.<sup>276</sup>

The Federal Circuit pointed to Trademark Rule 2.127(d), which provides, “[w]hen any party files . . . a motion for summary judgment . . . the case will be suspended . . . with respect to all matters not germane to the motion and no party should file any paper which is not germane to the motion . . . .”<sup>277</sup> Though it disagreed with the appellant’s interpretation of Trademark Rule 2.127(d) that his discovery production requirements became suspended once he had filed his summary judgment motion the day before his discovery obligations were due, the Federal Circuit noted that the TTAB failed to address the applicability of Trademark Rule

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268. *Id.*, 96 U.S.P.Q.2d (BNA) at 1435.

269. 367 F. App’x 161 (Fed. Cir. 2010) (per curiam).

270. *Id.* at 162–63.

271. *Id.* at 163.

272. *Id.* at 162; 37 C.F.R. § 2.127(d).

273. *Super Bakery*, 367 F. App’x at 162.

274. *Id.*

275. *Id.*

276. *Id.*

277. *Id.*; 37 C.F.R. § 2.127(d) (2010).

2.127(d) in its decision.<sup>278</sup> Thus, the court remanded the case back to the TTAB.<sup>279</sup>

On remand, the TTAB held, in a precedential decision, that the filing of a motion for summary judgment, or other dispositive motion, does not automatically suspend a proceeding and noted that the same conclusion was reached during the rulemaking process for Trademark Rule 2.127(d).<sup>280</sup> The TTAB held that only an order of the TTAB formally suspending the proceedings has such effect from the date of the suspension forward, unless otherwise indicated by the TTAB in the suspension order.<sup>281</sup>

Here, the TTAB's suspension order did not issue until *after* Benedict's discovery responses were due.<sup>282</sup> The TTAB held that the pendency of Benedict's "clearly meritless" motion did not, in this case, constitute good cause for failing to comply with the TTAB's prior order.<sup>283</sup> The TTAB, therefore, held that the applicability of 37 C.F.R. § 2.127(d) did not change its decision to enter judgment against the respondent and to cancel his registration.<sup>284</sup>

Although an unpublished opinion,<sup>285</sup> *Benedict* stands as yet another reminder to the TTAB that it must not ignore its own stated procedural rules. Despite the TTAB's and the opposing party's apparent frustration with Benedict's actions before the TTAB,<sup>286</sup> the TTAB must at least address applicable procedural issues in its decisions, particularly where, as here, the decision resulted in a judgment against the respondent.

#### D. Treatment of Non-Response to Motion

##### 1. Sadeh v. Biggs

In *Sadeh v. Biggs*,<sup>287</sup> the Federal Circuit affirmed the TTAB's dismissal of the subject opposition with prejudice and affirmed its denial of a motion for reconsideration.<sup>288</sup> The opposer failed to

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278. *Super Bakery*, 367 F. App'x at 162–63.

279. *Id.*

280. *Super Bakery, Inc. v. Benedict*, No. 92047859, 2010 TTAB LEXIS 384, at \*5, 96 U.S.P.Q.2d (BNA) 1134, 1136 (T.T.A.B. Sept. 16, 2010).

281. *Id.*, 96 U.S.P.Q.2d (BNA) at 1136.

282. *Id.*, 96 U.S.P.Q.2d (BNA) at 1136.

283. *Id.* at \*6–7, 96 U.S.P.Q.2d (BNA) at 1136.

284. *Id.* at \*8, 96 U.S.P.Q.2d (BNA) at 1136.

285. *But see infra* text accompanying note 311 (discussing that citation to nonprecedential decisions is acceptable in certain contexts).

286. *Benedict v. Super Bakery*, 367 F. App'x 161, 163 (Fed. Cir. 2010) (per curiam); *Super Bakery, Inc.*, 2010 TTAB LEXIS 384, at \*7–8, 96 U.S.P.Q.2d (BNA) at 1136.

287. 374 F. App'x 996 (Fed. Cir. 2010) (per curiam).

288. *Id.* at 997.

provide any response to the applicant's motion to dismiss, and could not, on appeal, proffer an adequate explanation for failing to do so.<sup>289</sup> Instead, the opposer argued on appeal that he was not obliged to respond to the motion to dismiss because he felt his notice of opposition was "bullet proof," and he did not argue that extenuating circumstances existed justifying his failure to respond.<sup>290</sup> In an unpublished opinion, the Federal Circuit stated that "[l]itigation is run by rules designed to assure orderly conduct of the proceedings" and held that the TTAB did not abuse its discretion in granting the applicant's motion to dismiss as conceded, pursuant to 37 C.F.R. § 2.127(a).<sup>291</sup>

### E. *Motion for Vacatur and Remand; Appeal Moot*

#### 1. *In re Hyatt*

In *In re Hyatt*,<sup>292</sup> the Federal Circuit vacated the underlying decision of the TTAB in an *ex parte* appeal in which the TTAB had affirmed the refusal of the appellant's application on the basis of likelihood of confusion with a prior registration.<sup>293</sup> The court remanded the case to the TTAB pursuant to a motion of the Director of the Trademark Office which stated that the Federal Circuit appeal was now moot, as the Trademark Office had cancelled the registration upon which denial of the appellant's application was based just four days prior to the parties' scheduled oral argument before the Federal Circuit.<sup>294</sup> Of note, the Director also informed the Federal Circuit that "procedures are being put in place to check registration status prior to oral argument to prevent a similar occurrence in the future."<sup>295</sup>

### F. *Federal Circuit Rule Compliance*

As the below three cases illustrate, an appellant's entire appeal may be jeopardized and not heard on the merits if the appellant, or the appellant's counsel, fails to strictly adhere to the procedural rules and timeline deadlines of the Federal Circuit.

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289. *Id.*

290. *Id.*

291. *Id.* (quoting *Chesebrough-Pond's Inc. v. Faberge, Inc.*, 618 F.2d 776, 780, 205 U.S.P.Q. (BNA) 888, 891 (C.C.P.A. 1980)).

292. No. 2009-1229, 2010 U.S. App. LEXIS 26199 (Fed. Cir. Jan. 7, 2010).

293. *Id.*; see *In re Hyatt*, No. 76611740, 2008 TTAB LEXIS 106, at \*3, \*7, \*16-17 (T.T.A.B. Nov. 18, 2008).

294. *In re Hyatt*, 2010 U.S. App. LEXIS 26199, at \*1; Director's Opposed Motion for Vacatur and Remand at 1-2, *In re Hyatt*, 2010 U.S. App. LEXIS 26199 (Feb. 6, 2011), available at

<http://ttabvue.uspto.gov/ttabvue/v?pno=76611740&pty=EXA&eno=22>.

295. Director's Opposed Motion for Vacatur and Remand *supra* note 294, at 3.



### I. Stoller v. Best Data Products, Inc.

In *Stoller v. Best Data Products, Inc.*,<sup>296</sup> perhaps the harshest application of its rules in 2010, the Federal Circuit denied as moot appellant Leo Stoller's<sup>297</sup> motion seeking an extension of time to file his opening brief immediately after dismissing the entire appeal because Stoller had failed to pay the Federal Circuit docketing fee that was due eight days earlier.<sup>298</sup>

The appeal stemmed from a TTAB opposition proceeding related to an application for the mark STEALTH. An application had been filed over a decade earlier in 1998, to which an opposition was sustained after the applicant, The Society for the Prevention of Trademark Abuse, L.L.C., filed to expressly abandon the application.<sup>299</sup> Stoller filed the appeal after the TTAB refused initially, and again upon reconsideration, to substitute Stoller as the assignee applicant owner of the opposed STEALTH application.<sup>300</sup> Stoller moved for substitution and to extend his time to answer *after* the opposition had been sustained due to the current record holder's express abandonment.<sup>301</sup> The TTAB refused Stoller's motions, citing a complete lack of evidence regarding the chain of title argued by Stoller.<sup>302</sup>

Despite the fact that only eight days had passed between the docketing fee due date and the Federal Circuit's dismissal of the appeal in an unpublished opinion, the Federal Circuit affirmed its

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296. No. 2010-1031, 2010 U.S. App. LEXIS 4354 (Fed. Cir. Feb. 5, 2010).

297. By way of background, it is notable that the judicial system seems to have run out of patience with Mr. Stoller. Stoller has been sanctioned numerous times for being a vexatious litigant and for other dubious conduct. *See, e.g.*, Order at 2, *In re Leo D. Stoller*, No. 1:07-cv-05118 (7th Cir. Dec. 4, 2009) (No. 08-4240), *available at* <http://docs.justia.com/cases/federal/appellate-courts/ca7/09-3569/16/0.pdf?1272466371> (ordering all federal courts in the Seventh Circuit to "return unfiled any papers submitted either directly or indirectly by [Mr. Stoller] or on his behalf[,] except for those relating to criminal cases and applications for writs of habeas corpus); *see also* *Central Mfg. Co. v. Brett*, No. 04-C-3049, 2005 U.S. Dist. LEXIS 23379, at \*2, 78 U.S.P.Q.2d 1662, 1664 (N.D. Ill. Sept. 30, 2005), *aff'd* 492 F.3d 876 (7th Cir. 2007) ("Stoller appears to be running an industry that produces often spurious, vexatious, and harassing federal litigation.").

298. *Stoller v. Best Data Prods., Inc.*, No. 2010-1031, 2010 U.S. App. LEXIS 4354, at \*1 (Fed. Cir. Feb. 5, 2010).

299. *Best Data Prods., Inc. v. Soc'y for Prevention of Trademark Abuse, L.L.C.*, No. 91190926 (T.T.A.B. Sept. 1, 2009).

300. *See id.* (denying Stoller's request for reconsideration and affirming the Board's August 5, 2009 order, as modified by the Board's August 7, 2009 order).

301. Motion to Substitute Party, *Best Data Prods., Inc. v. Leo Stoller*, Opposition No. 91190926 (T.T.A.B. 2009), *available at* <http://ttabvue.uspto.gov/ttabvue/v?pno=91190926&pty=OPP&eno=4>.

302. *See Best Data Prods., Opposition No. 91190926* (T.T.A.B. Sept. 1, 2009), *available at* <http://ttabvue.uspto.gov/ttabvue/v?pno=76611740&pty=EXA&eno=22> (denying Stoller's request for reconsideration and affirming the Board's August 5, 2009 order, as modified by the Board's August 7, 2009 order).

decision upon Stoller's motion for reconsideration.<sup>303</sup> While the best practice to take away from this opinion is to strictly adhere to all procedural deadlines of the Federal Circuit, one cannot help but wonder whether similar treatment would have befallen an appellant who did not have Stoller's reputation and had not previously brought appeals before the Federal Circuit on more than fifteen occasions.

## 2. *In re Achenbach Buschhutzen GmbH*

*In re Achenbach Buschhutzen GmbH*<sup>304</sup> also highlighted the need to strictly follow the rules of the Federal Circuit. In that case, the attorney for trademark applicant Achenbach Buschhutzen GmbH appealed the TTAB's affirmation of the Examining Attorney's final refusal to register the proposed mark OPTIFOIL (and Design) under Section 2(d) of the Lanham Act.<sup>305</sup> Counsel for Achenbach failed to become a member of the Federal Circuit bar as required by Federal Circuit Rule 46, and the Federal Circuit therefore dismissed the appeal for failure to prosecute in accordance with the rules.<sup>306</sup>

## 3. *General Casualty Co. of Wisconsin v. Amerisure Mutual Insurance Co.*

*General Casualty Co. of Wisconsin v. Amerisure Mutual Insurance Co.*<sup>307</sup> provides another example of the Federal Circuit's strict application of its rules, to the detriment of appellants. General Casualty Co. failed to timely file its appellate brief, as required by Federal Circuit Rule 31(a).<sup>308</sup> Citing the same rule, the Federal Circuit dismissed the appeal.<sup>309</sup>

## CONCLUSION

All told, the Federal Circuit did not promulgate any momentous advances or changes in trademark law in 2010. This is not to say that it was not a busy year for the Federal Circuit, as the number of trademark cases decided by the court in 2010 was in line with recent years, and the court's decision to designate only eight of the twenty-three trademark cases as precedential was also comparable to recent years.<sup>310</sup> In any event, the cases surveyed herein may be useful for

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303. *Stoller*, 2010 U.S. App. LEXIS 4354, at \*1.

304. No. 2010-1192, 2010 U.S. App. LEXIS 12248 (Fed. Cir. May 4, 2010).

305. 15 U.S.C. § 1052(d) (2006); *In re Achenbach Buschhutzen GmbH*, No. 76581689, 2009 TTAB LEXIS 650 (T.T.A.B. Oct. 26, 2009).

306. *In re Achenbach*, 2010 U.S. App. LEXIS 12248, at \*1.

307. No. 2010-1422, 2010 U.S. App. LEXIS 26870 (Fed. Cir. Oct. 4, 2010).

308. *Id.* at \*1.

309. *Id.*

310. The Federal Circuit issued sixteen trademark decisions in 2009 (including nine designated precedential), eight trademark decisions in 2008 (one designated

similarly situated litigants. Practitioners are reminded that since the adoption of Federal Rule of Appellate Procedure 32.1, all federal opinions, including those of the Federal Circuit, issued on or after January 1, 2007, are citable in all federal courts even if designated as unpublished or nonprecedential.<sup>311</sup> Further, the Federal Circuit may refer to nonprecedential dispositions in opinions or orders and may look to nonprecedential dispositions for guidance or persuasive reasoning.<sup>312</sup> The decision of the court to affirm four judgments in 2010 without opinion reflects the court's determination that an opinion in those cases would have no precedential value,<sup>313</sup> but these cases should not be overlooked by practitioners who may wish to supplement other authority.

Practitioners should be aware that this article is a survey only of 2010 trademark judgments issued by the Federal Circuit. Opinions issued by the Federal Circuit in 2010 involving other substantive areas of the law may also impact trademark law practice but are not considered or discussed herein.

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precedential), fifteen trademark decisions in 2007 (eight designated precedential), eleven trademark decisions in 2006 (seven designated precedential), and twelve trademark decisions in 2005 (six designated precedential). See Stephen R. Baird, *2005 Trademark Decisions of the Federal Circuit*, 55 AM. U. L. REV. 1263, 1263-64 (2006); Stephanie H. Bald & David M. Kelly, *2008 Trademark Law Decisions of the Federal Circuit*, 58 AM. U. L. REV. 947, 948 (2009); Rebecca Gan, *2009 Trademark Law Decisions of the Federal Circuit*, 59 AM. U. L. REV. 1115, 1116 (2010); Christine Haight Farley & Geri L. Haight, *Review of the 2006 Trademark Decisions of the Federal Circuit*, 56 AM. U. L. REV. 987, 988 (2007); David Jaquette & Susan M. Kayser, *2007 Trademark Law Decisions of the Federal Circuit*, 57 AM. U. L. REV. 1039, 1040 (2008).

311. See FED. R. APP. P. 32.1; FED. CIR. R. 32.1(c). By way of comparison, TTAB decisions not designated as precedential "are not citable authority and will not be considered by the Board." TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE § 1203.02(f) (2004).

312. FED. CIR. R. 32.1(d).

313. FED. CIR. R. 36. We note that in all four instances the underlying TTAB opinion was also nonprecedential.