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2012 Trademark Law Decisions of the Federal Circuit

Molly R. Silfen

Jason W. Melvin

Andrew E. Renison

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2012 TRADEMARK LAW DECISIONS OF THE FEDERAL CIRCUIT*

MOLLY R. SILFEN**

JASON W. MELVIN***

ANDREW E. RENISON****

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* This Area Summary reflects the Authors' current thoughts on the subject matter and should not be attributed, in whole or in part, to Finnegan, Henderson, Farabow, Garrett & Dunner, LLP, any of its attorneys, or any of its clients. This Area Summary is not meant to convey legal opinions or legal advice of any kind.

** Associate, Finnegan, Henderson, Farabow, Garret & Dunner, LLP; J.D., *Harvard Law School*, 2006; B.S., Mechanical Engineering, *Yale University*, 2002. Ms. Silfen served as a law clerk to the Honorable Alan D. Lourie of the U.S. Court of Appeals for the Federal Circuit.

*** Associate, Finnegan, Henderson, Farabow, Garret & Dunner, LLP; J.D., *University of Virginia School of Law*, 2006; Ph.D., Mechanical Engineering, *Massachusetts Institute of Technology*, 2003; B.S. Mechanical Engineering, *Massachusetts Institute of Technology*, 1997. Dr. Melvin served as a law clerk to the Honorable Sharon Prost of the U.S. Court of Appeals for the Federal Circuit.

**** J.D. Candidate, May 2013, *George Washington University Law School*; B.A.Sc., Materials Engineering, *University of British Columbia*, 2009.

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INTRODUCTION

Among the many cases decided every year by the U.S. Court of Appeals for the Federal Circuit, relatively few relate to trademark law. Unlike patent law and other substantive areas over which the Federal Circuit has exclusive jurisdiction, the court's jurisdiction over trademark law arises only in appeals from the U.S. Patent and Trademark Office (PTO) and in appeals that otherwise fall within the Federal Circuit's exclusive jurisdiction—such as appeals involving both patent and trademark issues.¹ In 2012, of the over 700 opinions issued by the court,² only thirteen—eleven precedential³ and two nonprecedential⁴—related to trademark law. Thus, under two percent of the court's opinions related to trademark law last year. But what the Federal Circuit lacks in quantity it makes up for in the importance of the issues, since the court addresses specialized trademark registration issues that are rarely addressed by other appellate courts. Of the thirteen trademark opinions, twelve began as proceedings before the PTO's Trademark Trial and Appeal Board

1. 28 U.S.C. § 1295(a) (2006).

2. This was determined from a search of Federal Circuit decisions in the Westlaw database, excluding orders.

3. *Stephen Slesinger, Inc. v. Disney Enters.*, 702 F.3d 640 (Fed. Cir. 2012); *In re Fox*, 702 F.3d 633 (Fed. Cir. 2012); *In re Miracle Tuesday, LLC*, 695 F.3d 1339 (Fed. Cir. 2012); *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247 (Fed. Cir. 2012); *Lens.com, Inc. v. 1-800 Contacts, Inc.*, 686 F.3d 1376 (Fed. Cir. 2012); *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046 (Fed. Cir. 2012); *In re Becton, Dickinson & Co.*, 675 F.3d 1368 (Fed. Cir. 2012); *In re The Chamber of Commerce*, 675 F.3d 1297 (Fed. Cir. 2012); *Bridgestone Ams. Tire Operations, LLC v. Fed. Corp.*, 673 F.3d 1330 (Fed. Cir. 2012); *In re Viterra Inc.*, 671 F.3d 1358 (Fed. Cir. 2012); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356 (Fed. Cir. 2012).

4. *Willis v. Can't Stop Prods., Inc.*, 105 U.S.P.Q.2d (BNA) 1577 (Fed. Cir. 2012) (per curiam); *3M Co. v. Mohan*, 482 F. App'x 574 (Fed. Cir. 2012).

(TTAB),⁵ and one began in district court, in a case that also involved patent law issues.⁶

The Federal Circuit issued another nine orders in trademark cases—one summary affirmance issued without an opinion,⁷ four remands for cases that were settled or were otherwise rendered moot during the course of the appeal,⁸ and four transfers to regional circuits based on the Federal Circuit's lack of jurisdiction.⁹

Meanwhile, in 2012, the other twelve circuits issued approximately seventeen opinions on trademark issues, while state courts of appeal issued roughly eight.¹⁰ Thus, although trademark law falls within the Federal Circuit's jurisdiction, the Federal Circuit is far from the only appellate court deciding trademark issues. But since the Federal Circuit is the only appellate court hearing appeals from the TTAB,¹¹

5. *Slesinger*, 702 F.3d at 641; *Fox*, 702 F.3d at 634; *Willis*, 105 U.S.P.Q.2d (BNA) at 1578; *Miracle Tuesday*, 695 F.3d at 1341; *DuoProSS*, 695 F.3d at 1249; *Lens.com*, 686 F.3d at 1377-78; *Midwestern*, 685 F.3d at 1048; *Becton*, 675 F.3d at 1369; *Chamber of Commerce*, 675 F.3d at 1298; *Bridgestone*, 673 F.3d at 1332; *Viterra*, 671 F.3d at 1359; *Coach Servs.*, 668 F.3d at 1360.

6. 3M, 482 F. App'x at 576.

7. *In re Collen IP Intellectual Prop. Law, P.C.*, 485 F. App'x 434, 434 (Fed. Cir. 2012) (mem.) (per curiam).

8. *Rolex Watch U.S.A., Inc. v. AFP Imaging Corp.*, No. 2012-1260, 2012 U.S. App. LEXIS 22650, at *1-2 (Fed. Cir. Nov. 1, 2012) (per curiam); *Tempur-Pedic Mgmt., Inc. v. FKA Distrib. Co.*, 481 F. App'x 615, 615 (Fed. Cir. 2012); *In re Alvogen IP Co. S.A.R.L.*, No. 2012-1305, 2012 U.S. App. LEXIS 12847, at *1 (Fed. Cir. June 21, 2012) (per curiam); *Greene v. Pitka*, No. 2012-1277, 2012 U.S. App. LEXIS 12836, at *1 (Fed. Cir. June 21, 2012); see also *Rolex Watch U.S.A., Inc. v. AFP Imaging Corp.* (*Rolex I*), 480 F. App'x 998, 999 (Fed. Cir. 2012) (dismissing the appeal), *vacated*, No. 2012-1260, 2012 U.S. App. LEXIS 22650 (Fed. Cir. Nov. 1, 2012).

9. *SIBU, LLC v. Bubbles, Inc.*, No. 2012-1651, 2012 U.S. App. LEXIS 24204, at *1-2 (Fed. Cir. Nov. 21, 2012), *transferring to* No. 13-4001 (10th Cir. docketed Jan. 3, 2013); *Select Exp. Corp. v. Jack Richeson & Co.*, No. 2012-1122, 2012 U.S. App. LEXIS 6637, at *2 (Fed. Cir. Apr. 2, 2012), *transferring to* No. 12-11761 (11th Cir. docketed Apr. 5, 2012); *Mine O'Mine, Inc. v. Calmese*, 470 F. App'x 886, 886 (Fed. Cir.), *aff'd*, 489 F. App'x 175 (9th Cir. 2012); *Joy Techs., Inc. v. N. Am. Rebuild Co.*, No. 2012-1061, 2012 WL 6054761, at *1 (Fed. Cir. Feb. 6, 2012) (per curiam), *transferred to* No. 12-2622 (3d Cir. dismissed Sept. 6, 2012).

10. These figures were determined from a search of the Westlaw database, within Westlaw's "Trademarks" key number, 382T. While these numbers appear to be somewhat low based on a separate search for the word "trademark" and a review of the cases found, they are merely intended to be an approximation. See, e.g., *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206, 212 (2d Cir. 2012) (protecting Christian Louboutin's trademarked red soles to the extent that the soles contrast in color with the shoe's upper components), *aff'd per curiam*, 709 F.3d 140 (2d Cir. 2013); *Prime Home Care, LLC v. Pathways to Compassion, LLC*, 809 N.W.2d 751, 762-63 (Neb. 2012) (holding that the registered trade name "Compassionate Care Hospice" had acquired secondary meaning and that the competitor name "Compassionate Care Hospice of Nebraska" would create a likelihood of confusion).

11. After receiving an adverse TTAB decision, a party can appeal to either the Federal Circuit or a district court, 15 U.S.C. § 1071 (2006), but it is more common to appeal to the Federal Circuit.

it is generally the only reviewer of trademark registration issues, while the other appellate courts generally review issues relating to a party's ability to use a mark.¹²

As the Federal Circuit explains in its internal operating procedures, cases are randomly assigned to panels of three judges.¹³ But once the panel has heard the case, the judges select the author amongst themselves, led by the presiding judge.¹⁴ Thus, unlike panel assignments, the authoring assignments are not random. This year, of the thirteen opinions in trademark cases, Judge O'Malley authored significantly more than any other judge, writing four of the opinions as well as participating in the one per curiam panel opinion.¹⁵ The remaining authorship fell more or less evenly among the court's other judges.¹⁶ Judge O'Malley is the only Federal Circuit judge who has also served as a district court judge, hearing trademark cases bound for both the Federal Circuit and the U.S. Court of Appeals for the Sixth Circuit.¹⁷ Given this unique background among the Federal

12. See, e.g., *Miller's Ale House, Inc. v. Boynton Carolina Ale House, LLC*, 702 F.3d 1312, 1315 (11th Cir. 2012) (determining whether one ale house violated the trademark rights of another ale house by adopting a similar "name, decor, and . . . floor plan"); *World Entm't Inc. v. Brown*, 487 F. App'x 758, 759-60 (3d Cir. 2012) (considering a trademark-infringement case brought by one production company against another).

13. U.S. COURT OF APPEALS FOR THE FED. CIRCUIT, INTERNAL OPERATING PROCEDURES § 3.1 (2008), available at <http://www.cafc.uscourts.gov/images/stories/rules-of-practice/IOP.pdf>.

14. *Id.* § 8.2.

15. See *In re Miracle Tuesday, LLC*, 695 F.3d 1339 (Fed. Cir. 2012); *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1249 (Fed. Cir. 2012); *In re Viterra Inc.*, 671 F.3d 1358 (Fed. Cir. 2012); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356 (Fed. Cir. 2012); see also *Willis v. Can't Stop Prods., Inc.*, 105 U.S.P.Q.2d (BNA) 1577 (Fed. Cir. 2012) (per curiam).

16. Of the other opinions, Judge Rader wrote two. *Stephen Slesinger, Inc. v. Disney Enters.*, 702 F.3d 640 (Fed. Cir. 2012); *3M Co. v. Mohan*, 482 F. App'x 574 (Fed. Cir. 2012). Judges Reyna, Dyk, and Linn each wrote one opinion plus a full or partial dissent. *Slesinger*, 702 F.3d at 646 (Reyna, J., dissenting); *In re Fox*, 702 F.3d 633 (Fed. Cir. 2012) (Dyk, J.); *Lens.com, Inc. v. 1-800 Contacts, Inc.*, 686 F.3d 1376 (Fed. Cir. 2012) (Linn, J.); *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1054 (Fed. Cir. 2012) (Dyk, J., concurring in part and dissenting in part); *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 1377 (Fed. Cir. 2012) (Linn, J., dissenting); *In re The Chamber of Commerce*, 675 F.3d 1297 (Fed. Cir. 2012) (Reyna, J.). Finally, Judges Bryson, Clevenger, and Newman each wrote one opinion. *Midwestern*, 685 F.3d 1046 (Bryson, J.); *Becton*, 675 F.3d 1368 (Clevenger, J.); *Bridgestone Ams. Tire Operations, LLC v. Fed. Corp.*, 673 F.3d 1330 (Fed. Cir. 2012) (Newman, J.).

17. See *Kathleen M. O'Malley, Circuit Judge*, U.S. COURT OF APPEALS FOR THE FED. CIRCUIT, <http://www.cafc.uscourts.gov/judges/kathleen-m-omalley-circuit-judge.html> (last visited Apr. 22, 2013) (indicating that Judge O'Malley presided over 100 patent and trademark cases during her sixteen years on the Northern District of Ohio bench). Indeed, a search of the Northern District of Ohio's CM/ECF database reveals that Judge O'Malley presided over forty-one trademark cases as a district court judge. See CM/ECF Database, U.S. DIST. COURT FOR THE N. DIST. OF OHIO, <https://ecf.ohnd.uscourts.gov/cgi-bin/iquery.pl> (query "Nature of Suit" is "840

Circuit judges, her relatively frequent authorship of trademark opinions may be no coincidence. Federal Circuit watchers should keep an eye open for more trademark opinions from Judge O'Malley.

In 2012, the court affirmed most of the lower tribunals' decisions, reversing only two¹⁸ and vacating one in part.¹⁹ As discussed further below, the court heard a wide variety of trademark cases. The issues underlying the cases included the PTO's refusal to register a mark,²⁰ opposition and cancellation proceedings at the PTO,²¹ and an infringement trial at the district court.²² The Federal Circuit addressed several substantive issues including those that involve comparing two marks (likelihood of confusion, dilution, and infringement) and the use or character of individual marks (use in commerce, abandonment, functionality, descriptiveness, and scandalous matter).²³ The court also addressed procedural issues such as collateral estoppel,²⁴ evidentiary rulings,²⁵ the Seventh Amendment right to a jury trial,²⁶ and the award of attorneys' fees.²⁷

This Article discusses each of the Federal Circuit's thirteen trademark cases in 2012. The case discussions are grouped by the cases' primary issue, although other issues are also discussed within the discussion of the relevant case.

(Trademark)" and search results for instances of "KMO" as the presiding judge) (last visited Apr. 22, 2013).

18. *DuoProSS*, 695 F.3d at 1249; *Bridgestone*, 673 F.3d at 1332.

19. *Coach Servs.*, 668 F.3d at 1360.

20. *Fox*, 702 F.3d at 634; *Miracle Tuesday*, 695 F.3d at 1341; *Midwestern*, 685 F.3d at 1048; *Becton*, 675 F.3d at 1369; *Chamber of Commerce*, 675 F.3d at 1298; *Viterra*, 671 F.3d at 1359.

21. *Stephen Slesinger, Inc.*, 702 F.3d at 642; *Willis v. Can't Stop Prods., Inc.*, 105 U.S.P.Q.2d (BNA) 1577, 1578 (Fed. Cir. 2012) (per curiam); *DuoProSS*, 695 F.3d at 1249; *Lens.com*, 686 F.3d at 1377-78; *Bridgestone*, 673 F.3d at 1332; *Coach Servs.*, 668 F.3d at 1360.

22. *3M Co. v. Mohan*, 482 F. App'x 574, 576 (Fed. Cir. 2012).

23. See *Fox*, 702 F.3d at 640 (scandalous matter); *Willis*, 105 U.S.P.Q.2d (BNA) at 1578 (abandonment); *Miracle Tuesday*, 695 F.3d at 1341 (descriptiveness); *DuoProSS*, 695 F.3d at 1249 (descriptiveness); *Lens.com*, 686 F.3d at 1378 (use in commerce and abandonment); *Midwestern*, 685 F.3d at 1048 (likelihood of confusion); *3M*, 482 F. App'x at 576 (infringement); *Becton*, 675 F.3d at 1369 (functionality); *Chamber of Commerce*, 675 F.3d at 1298 (descriptiveness); *Bridgestone*, 673 F.3d at 1332 (likelihood of confusion); *Viterra*, 671 F.3d at 1359 (likelihood of confusion); *Coach Servs.*, 668 F.3d at 1360 (likelihood of confusion and dilution).

24. See *Slesinger*, 702 F.3d at 642.

25. See *Miracle Tuesday*, 695 F.3d at 1341; *DuoProSS*, 695 F.3d at 1251; *Midwestern*, 685 F.3d at 1048; *Becton*, 675 F.3d at 1381; *Chamber of Commerce*, 675 F.3d at 1298; *Coach Servs.*, 668 F.3d at 1360.

26. See *3M*, 482 F. App'x at 578.

27. See *id.* at 576-77.

I. SUBSTANTIVE TRADEMARK ISSUES

A. *Likelihood of Confusion and Dilution*1. *Bridgestone Americas Tire Operations, LLC v. Federal Corp.*

In *Bridgestone Americas Tire Operations, LLC v. Federal Corp.*,²⁸ the Federal Circuit reversed a TTAB decision that had dismissed Bridgestone's opposition to registration of the MILANZA mark for tires.²⁹ Bridgestone Americas Tire Operations, LLC, owned registrations for the POTENZA and TURANZA marks for tires.³⁰ Bridgestone opposed Federal Corporation's application to register the MILANZA mark for tires on the ground of likelihood of confusion as to source.³¹ The TTAB concluded that confusion was not likely because, although Bridgestone's and Federal's goods were the same and were sold to the same consumer class, MILANZA was "not similar to the POTENZA and TURANZA marks, and . . . the marks POTENZA and TURANZA had not achieved significant consumer recognition independent of the BRIDGESTONE mark."³²

The Federal Circuit reversed the TTAB's decision that POTENZA and TURANZA were not independently strong marks.³³ The court first noted that the fame of an opposer's mark plays a significant role in a likelihood-of-confusion analysis.³⁴ Bridgestone persuaded the TTAB that its POTENZA and TURANZA marks were inherently distinctive, but the TTAB found that the marks were not strong or famous because they had been used with the accompanying BRIDGESTONE mark.³⁵ The Federal Circuit clarified that "[a] unique arbitrary word mark does not lose its strength as a trademark when the manufacturer is identified along with the branded product."³⁶ Because Bridgestone extensively showed its advertising, media publicity, and critical acclaim for the two tire brands, the court agreed that "concurrent use of the BRIDGESTONE mark d[id] not diminish the status of POTENZA and TURANZA as strong marks for tires."³⁷

28. 673 F.3d 1330 (Fed. Cir. 2012).

29. *Id.* at 1332.

30. *Id.*

31. *Id.*

32. *Id.* at 1332-33.

33. *Id.* at 1334, 1336.

34. *Id.* at 1334.

35. *Id.*

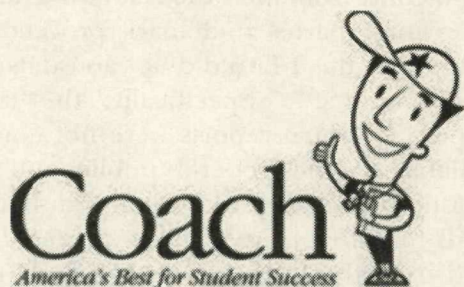
36. *Id.* at 1336.

37. *Id.*

Having found the POTENZA and TURANZA marks independently strong, the court found that the MILANZA mark would likely cause consumer confusion as to source.³⁸ Noting that newcomers carry a heavy burden to avoid consumer confusion, the court stated: “In light of the identity of the goods, the lengthy prior use of POTENZA and TURANZA, the market strength of the POTENZA and TURANZA marks, and the similarities of words, sounds, and connotation with MILANZA, sufficient similarity ha[d] been shown as would be likely to cause consumer confusion.”³⁹ Thus, the Federal Circuit reversed the TTAB’s decision and sustained Bridgestone’s opposition.⁴⁰

2. Coach Services, Inc. v. Triumph Learning LLC

In *Coach Services, Inc. v. Triumph Learning LLC*,⁴¹ the Federal Circuit affirmed in part, vacated in part, and remanded to the TTAB its decision involving the COACH mark as used for standardized testing study materials.⁴² Triumph Learning LLC, a publisher of K–12 instructional and study materials, filed use-based applications for a COACH word mark, a stylized COACH mark, and a COACH mark and design mark for educational computer software and printed materials.⁴³



Triumph claimed it had adopted the COACH mark for its products in 1986, and that after the No Child Left Behind Act of 2001,⁴⁴ it significantly expanded its marketing and enjoyed substantial commercial success.⁴⁵ Coach Services, Inc. (CSI), the well-known fashion company, sells a wide variety of “accessible luxury” products,

38. *Id.* at 1337.

39. *Id.*

40. *Id.* at 1332.

41. 668 F.3d 1356 (Fed. Cir. 2012).

42. *Id.* at 1360.

43. *Id.* at 1360–61.

44. Pub. L. No. 107-110, 115 Stat. 1425 (2002) (codified as amended in scattered sections of 20 U.S.C.).

45. *Coach Servs.*, 668 F.3d at 1360.

such as handbags, luggage, clothing, and other accessories in its 400 retail stores, department stores, and online.⁴⁶

CSI opposed Triumph's three COACH marks, alleging likelihood of confusion and dilution and arguing that the marks were merely descriptive when used on educational and test-preparation materials.⁴⁷ The TTAB dismissed CSI's opposition.⁴⁸ Specifically, the TTAB found no likelihood of confusion or dilution, and determined that, although Triumph's COACH marks were merely descriptive, the marks had acquired secondary meaning.⁴⁹ As described below, the Federal Circuit found no error in the TTAB's likelihood-of-confusion and dilution decisions, but, because of certain evidentiary errors, the court disagreed with the TTAB's acquired-distinctiveness analysis and thus remanded for further proceedings on that issue.⁵⁰

On appeal, CSI made several evidentiary and substantive challenges to the TTAB's findings.⁵¹ As an evidentiary matter, CSI argued that the TTAB erroneously excluded corporate annual reports that CSI tried to submit through a notice of reliance.⁵² The 2000–2008 annual reports showed CSI's annual sales figures and advertising and promotion expenditures for its COACH products and, thus, were potentially relevant to determining the strength of CSI's marks.⁵³ The court examined the relevant Trademark Rules of Practice governing inter partes trademark proceedings and TTAB decisions and found that the TTAB did not abuse its discretion when it excluded those reports.⁵⁴ Specifically, the court explained: "Historically, corporate annual reports were not considered printed publications available to the general public and thus were not admissible via a notice of reliance without any authentication."⁵⁵ But in 2010, the TTAB in *Safer Inc. v. OMS Investments Inc.*⁵⁶ held that a document printed from the Internet identifying its publication date or "date that it was accessed and printed, and its source" could "be admitted into evidence pursuant to a notice of reliance."⁵⁷ The TTAB, however, found—and the Federal Circuit in *Coach Services*

46. *Id.* at 1361.

47. *Id.* at 1362.

48. *Id.*

49. *Id.*

50. *Id.* at 1363.

51. *Id.* at 1362.

52. *Id.* at 1363.

53. *Id.*

54. *Id.* at 1363–65.

55. *Id.* at 1363.

56. 94 U.S.P.Q.2d (BNA) 1031 (T.T.A.B. 2010).

57. *Coach Servs.*, 668 F.3d at 1363–64 (quoting *Safer*, 94 U.S.P.Q.2d (BNA) at 1039).

agreed—that the *Safer* holding did not save CSI because its annual reports were not printed from the Internet and the annual reports did not include the online source, date accessed, or other identifying information.⁵⁸ Thus, they were not self-authenticating under *Safer*.⁵⁹ CSI tried to alternatively argue that deposition testimony of CSI's former Vice President and General Counsel corroborated the annual reports, but the court disagreed, finding that the deponent did not see or authenticate the annual reports during her deposition.⁶⁰ Further, the court noted that the sales and advertising figures the deponent quoted were not limited to the United States.⁶¹

The Federal Circuit next analyzed CSI's challenge to the TTAB's decision that Triumph's COACH mark for standardized test preparation materials would not likely confuse consumers. CSI argued that the TTAB improperly balanced the factors from *In re E.I. DuPont DeNemours & Co.*,⁶² namely by according insufficient weight to the fame of CSI's COACH mark, "the identical nature of the parties' marks," the parties' overlapping goods and consumers, and "lack of sophistication of the parties' customers."⁶³ The court rejected CSI's arguments and found that substantial evidence supported the TTAB's findings.⁶⁴

Initially, the court noted that the TTAB correctly found CSI's mark famous for purposes of likelihood of confusion.⁶⁵ CSI submitted evidence of annual sales, advertising figures, unsolicited publicity,

58. *Id.* at 1364–65.

59. *Id.* at 1365.

60. *Id.* at 1364–65.

61. *Id.* at 1365.

62. 476 F.2d 1357 (C.C.P.A. 1973). The *DuPont* court held that the following factors should be considered in a likelihood-of-confusion analysis:

(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 . . . 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. (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 the 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 . . . (10) The market interface between applicant and the owner of a prior mark . . . (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 . . . (13) Any other established fact probative of the effect of use.

Id. at 1361.

63. *Coach Servs.*, 668 F.3d at 1366.

64. *Id.*

65. *Id.* at 1367.

articles “refer[ing] to the renown of its products,” and a March 2008 internal brand awareness study showing “a high level of awareness of the COACH brand for women between the ages of 13–24.”⁶⁶ However, other factors the TTAB examined “dispel[led] any likelihood of confusion between the parties’ marks.”⁶⁷

Regarding the similarity of the marks, the court looked at the marks’ “appearance, sound, connotation and commercial impression.”⁶⁸ Despite the undisputed similarity of the marks’ appearance and sound, the marks’ differing connotations and commercial impressions favored Triumph.⁶⁹ Specifically, “Triumph’s COACH mark, when applied to educational materials, brings to mind someone who instructs students, while CSI’s COACH mark, when used in connection with luxury leather goods, . . . brings to mind traveling by carriage.”⁷⁰ Thus, the marks’ distinct commercial impressions nullified their identical sound and appearance.⁷¹

As to other *DuPont* factors, the Federal Circuit found that the similarity of the goods, channels of trade, and classes of customers weighed against any likelihood of confusion.⁷² CSI offered little support—and the court found none—that its goods and Triumph’s educational materials overlapped.⁷³ Further, the court found that Triumph only marketed products “through catalogs, direct mail, and personal sales representatives.”⁷⁴ Finally, the court agreed with the TTAB that Triumph’s targeting of educational professionals charged “with responsibility for purchasing educational materials” would outweigh any potential overlap in the classes of purchasers for the parties’ separate products.⁷⁵ The court, weighing the *DuPont* factors *de novo*, agreed with the TTAB that consumers would not likely confuse the parties’ respective COACH marks.⁷⁶

The Federal Circuit then affirmed the TTAB’s decision that CSI’s COACH mark was not famous for purposes of proving dilution.⁷⁷ The court first noted that under section 43(c) of the Lanham Act,⁷⁸

66. *Id.*

67. *Id.* at 1367–68.

68. *Id.* (quoting *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973)).

69. *Id.* at 1369.

70. *Id.*

71. *Id.*

72. *Id.* at 1369–71.

73. *Id.* at 1369–70.

74. *Id.* at 1370.

75. *Id.* at 1370–71.

76. *Id.* at 1371.

77. *Id.* at 1376.

78. 15 U.S.C. § 1125(c) (2006).

CSI had to prove that its COACH mark was famous prior to Triumph's filing date.⁷⁹ Under the Trademark Dilution Revision Act of 2006,⁸⁰ famous marks are "widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner."⁸¹ Importantly, the court explained, "dilution fame is difficult to prove."⁸² This proved true for CSI. The court examined CSI's evidence and found that it introduced insufficient evidence of dilution fame.⁸³

CSI argued that its sales and advertising figures for 2000–2008, numerous federal trademark registrations, unsolicited media attention, joint marketing efforts, and brand awareness survey all demonstrated enough fame for a claim of dilution.⁸⁴ The court rejected each in turn. Referring to its evidentiary ruling, the court refused to consider the 2000–2008 sales and advertising figures.⁸⁵ Proof of federal trademark registration, according to the court, "is not *conclusive* evidence of fame" but merely relevant to the fame inquiry.⁸⁶ Regarding CSI's media attention, the court acknowledged that CSI certainly "achieved a substantial degree of recognition."⁸⁷ But, the court explained that "many of the articles submitted [were] dated *after* Triumph filed its registration applications and thus d[id] not show that CSI's mark was famous *prior* to the filing date."⁸⁸ Further, the court noted, many articles merely included one of CSI's COACH products along with brands from other companies.⁸⁹ The court also found that CSI's evidence lacked testimony regarding the success of joint marketing efforts.⁹⁰ As to CSI's brand awareness study, although the study demonstrated significant brand awareness among women ages 13–24, "it provided no evidence of brand awareness among women generally, or among men."⁹¹ Further, CSI conducted its 2007 survey long after Triumph filed its applications.⁹²

79. *Coach Servs.*, 668 F.3d at 1372.

80. Pub. L. No. 109-312, 120 Stat. 1730 (codified at 15 U.S.C. §§ 1052(f), 1063(a), 1064, 1092, 1125(c), 1127).

81. 15 U.S.C. § 1125(c)(2)(A).

82. *Coach Servs.*, 668 F.3d at 1373.

83. *Id.* at 1373–76.

84. *Id.* at 1373–74.

85. *Id.* at 1374.

86. *Id.*

87. *Id.* at 1375.

88. *Id.*

89. *Id.*

90. *Id.*

91. *Id.*

92. *Id.*

The court's decision regarding dilution serves as a reminder to all plaintiffs bringing dilution claims: the burden to show fame that rises to the level necessary for a dilution claim is high—higher than the burden for showing likelihood-of-confusion fame⁹³—and plaintiffs must properly submit sufficient evidence demonstrating their own mark's fame among the general consuming public from *before* the opposing party's filing date.

Finally, CSI also argued that Triumph's COACH mark was merely descriptive, and Triumph challenged CSI's standing to make that argument.⁹⁴ The court found that CSI satisfied the two judicially created standing requirements: (1) a "real interest" and (2) a "reasonable basis" for believing Triumph's marks, if registered, would cause harm in the form of confusion or dilution.⁹⁵ Thus, the Federal Circuit found that CSI also had "standing to assert a claim on descriptiveness grounds" because standing required only that CSI show a personal stake; after that, it could present any theory that would prevent the harm at issue.⁹⁶ Turning to CSI's mere descriptiveness claim, the court held that substantial evidence supported the TTAB's finding that CSI sufficiently described tutoring.⁹⁷ But the court vacated the TTAB's holding that Triumph demonstrated its COACH marks had acquired secondary meaning.⁹⁸ Specifically, the TTAB should not have dismissed CSI's evidence of book and software titles unaffiliated with Triumph that included the word "coach" merely because they were published after Triumph filed its applications.⁹⁹ The court explained: "Acquired distinctiveness and buyer recognition is to be tested in an opposition proceeding as of the date the issue is under consideration. The filing date is not a cutoff for any evidence developing after that time."¹⁰⁰ Therefore, the court instructed the TTAB on remand to reconsider the issue of Triumph's "substantially exclusive use" of COACH, a requirement for establishing secondary meaning.¹⁰¹ Additionally, the court found that no testimony authenticated Triumph's advertising

93. *Id.* at 1373 ("While fame for dilution 'is an either/or proposition'—it either exists or does not—fame for likelihood of confusion is a matter of degree along a continuum." (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1375 (Fed. Cir. 2005))).

94. *Id.* at 1376.

95. *Id.* at 1377.

96. *Id.*

97. *Id.* at 1378.

98. *Id.* at 1380.

99. *Id.*

100. *Id.* (quoting *Target Brands, Inc. v. Hughes*, 85 U.S.P.Q.2d (BNA) 1676, 1681 (T.T.A.B. 2007)).

101. *Id.*

documents supporting its pre-2003 use of COACH.¹⁰² Thus, the court instructed the TTAB to address the weight, if any, to give to those documents.¹⁰³

3. *In re Viterra Inc.*

In *In re Viterra Inc.*,¹⁰⁴ the Federal Circuit found that substantial evidence supported the TTAB's finding that consumers would likely confuse the applied-for XCEED mark with the registered X-SEED mark.¹⁰⁵ Viterra, Inc., an international agricultural business, attempted to register XCEED for "agricultural seed."¹⁰⁶ The TTAB refused registration, finding a likelihood of confusion with the X-SEED mark for "agricultural seeds," which was "registered in special form as a word and design mark."¹⁰⁷



X-Seed, Inc. claimed the colors "as a feature of the X-Seed Mark" and disclaimed protection for the term "seed" apart from the mark.¹⁰⁸

The TTAB considered the *DuPont* factors relating to similarity of the marks, trade channels, and goods in its likelihood-of-confusion analysis.¹⁰⁹ The TTAB found consumer confusion likely because of the identical nature of the goods, the fact that the goods traveled in the same trade channels, the marks' virtually identical-sounding pronunciations, and the fact that both marks played on the word "exceed" to convey a laudatory suggestion.¹¹⁰ Regarding marks' similarity of appearance, the TTAB considers all reasonable manners in which the words of a mark could be depicted under a "reasonable manners" standard.¹¹¹ Applying this standard, the

102. *Id.*

103. *Id.* at 1380–81.

104. 671 F.3d 1358 (Fed. Cir. 2012).

105. *Id.* at 1359.

106. *Id.*

107. *Id.* at 1359–60.

108. *Id.*

109. *Id.* at 1361–62.

110. *Id.* at 1360.

111. *Id.*

TTAB found a “reasonable variation of XCEED could include a large capital letter ‘X’ followed by ‘ceed’ in smaller letters, which would resemble the X-Seed Mark.”¹¹² Viterra appealed the adverse decision to the Federal Circuit and the parties waived oral argument.¹¹³

On appeal, the Federal Circuit focused solely on the similarity of the marks.¹¹⁴ Because neither the application nor registration restricted the channels of trade or classes of purchasers, the “goods and services [we]re presumed to travel in the same channels of trade to the same class of purchasers.”¹¹⁵ Further, Viterra conceded that the goods were identical; thus, those issues were not before the court.¹¹⁶ Viterra made three arguments as to the dissimilarity of the X-SEED mark and its XCEED mark.¹¹⁷ Viterra primarily focused on the appearance of the marks, asserting that the X-SEED mark’s allegedly distinctive design and color claims, “render[ed] it visually different from its XCEED mark.”¹¹⁸ Viterra further argued that the marks were phonetically different and had different connotations.¹¹⁹

The court focused its attention on Viterra’s first argument as to the dissimilarity of the appearance of the marks.¹²⁰ The court first noted that this *DuPont* factor—similarity of the marks—examined “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.”¹²¹ Further, the court explained, the verbal portion of composite marks containing both words and a design is “most likely to indicate the origin of the goods.”¹²² Viterra asked the court to explain how standard character marks should be distinguished from marks registered as designs under the likelihood-of-confusion analysis.¹²³ Specifically, Viterra asked the court to reexamine *Citigroup Inc. v. Capital City Bank Group*,¹²⁴ decided after the TTAB’s appealed-from decision, where the Federal Circuit rejected the “reasonable

112. *Id.*

113. *Id.* at 1361.

114. *Id.* at 1362.

115. *Id.* (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268 (Fed. Cir. 2002)).

116. *Id.*

117. *Id.*

118. *Id.* at 1363.

119. *Id.* at 1362.

120. *Id.*

121. *Id.* (quoting *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973)).

122. *Id.* (quoting *CBS Inc. v. Morrow*, 708 F.2d 1579, 1582 (Fed. Cir. 1983)).

123. *Id.* at 1363.

124. 637 F.3d 1344 (Fed. Cir. 2011).

manners" standard.¹²⁵ The court, noting it lacked authority to "readdress" *Citigroup*, denied Viterra's request for several reasons.

First, the court agreed with the TTAB, explaining that "a standard character mark is not limited to any particular font, size, style, or color."¹²⁶ Second, the court explained that the court in *Citigroup*, in rejecting the "reasonable manners" test, actually broadened the "range of marks to be considered in the *DuPont* analysis when a standard character mark is at issue."¹²⁷ Thus, the TTAB's use of the "reasonable manners" test was harmless error because it found a likelihood of confusion under a more restrictive test.¹²⁸ Third, the court rejected Viterra's procedural attempt to avoid *Citigroup* by "arguing that *Citigroup* involved an inter partes opposition proceeding, whereas th[e current] appeal derive[d] from an ex parte examination."¹²⁹ The Federal Circuit found no reason for such a distinction, noting that both types of cases derived from the Lanham Act and that the *DuPont* factors, which also derived from the same section and originated in the ex parte context, applied in both types of cases.¹³⁰ The Federal Circuit carefully noted, however, that it left "for future cases to determine the appropriate method of comparing design marks with standard character marks."¹³¹

The court next responded to Viterra's argument that the TTAB misconstrued the dominant portion of the X-SEED mark. Viterra asserted "that the dominant portion of the X-Seed Mark actually is the stylized letter 'X' and cannot include 'Seed,' particularly because the registrant used a hyphen to separate 'X' from 'Seed' and disclaimed the term 'Seed.'"¹³² The court disagreed, first finding that the design feature and literal portion of the mark were not entirely distinct.¹³³ Second, the court reaffirmed its previous decisions "holding that the verbal portion of a word and design mark likely will be the dominant portion."¹³⁴ Finally, the court reminded Viterra that "in the ultimate determination of similarity of the marks, the [TTAB] must consider the [marks] in [their] entirety, including the disclaimed portion."¹³⁵

125. *Viterra*, 671 F.3d at 1363.

126. *Id.*

127. *Id.* at 1364.

128. *Id.* at 1365 & n.3.

129. *Id.* at 1364.

130. *Id.* at 1364-65.

131. *Id.* at 1365.

132. *Id.* at 1366.

133. *Id.*

134. *Id.*

135. *Id.* at 1367.

Finally, the Federal Circuit summarily dismissed Viterra's remaining arguments. First, the two marks sounded similar; even if the marks were intended by their owners to be pronounced differently, consumers would not necessarily do so. Second, substantial evidence supported the TTAB's finding that consumers would reasonably perceive the two marks in a similar manner.¹³⁶ While the appeal focused solely on the similarity of the marks, the court reiterated the fact that the *DuPont* factors not argued on appeal weighed heavily in the registrant's favor. Accordingly, the Federal Circuit affirmed the TTAB's refusal of registration on the ground of likelihood of confusion.¹³⁷

4. *Midwestern Pet Foods, Inc. v. Societe Des Produits Nestle S.A.*

In *Midwestern Pet Foods, Inc. v. Societe Des Produits Nestle S.A.*,¹³⁸ the Federal Circuit considered an appeal from a TTAB decision denying registration of Midwestern Pet Foods, Inc.'s WAGGIN' STRIPS mark for pet food and edible pet treats.¹³⁹ The court found that substantial evidence supported the TTAB's likelihood-of-confusion finding, and a majority found that the TTAB did not procedurally err in admitting certain evidence.¹⁴⁰

Midwestern filed an intent-to-use application seeking to register the mark WAGGIN' STRIPS for pet food and edible pet treats.¹⁴¹ Societe Des Produits Nestle S.A.—owner of the registered BEGGIN' STRIPS mark for pet treats—opposed registration, arguing that there was a likelihood of confusion between the two marks.¹⁴² During prehearing discovery, Nestle made various objections to Midwestern's document requests and interrogatories.¹⁴³ Nestle agreed to produce “at a mutually agreeable time and place” certain nonprivileged documents and further “agreed to reconsider its responses if Midwestern would narrow its requests.”¹⁴⁴ Importantly, after entry of a protective order, Midwestern did not facilitate production of the documents Nestle

136. *Id.*

137. *Id.* (noting that the TTAB also gave heavy weight to the fact that the goods at issue were identical and that, when this is the case, “the degree of similarity necessary to support a conclusion of likely confusion declines” (quoting *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877 (Fed. Cir. 1992))).

138. 685 F.3d 1046 (Fed. Cir. 2012).

139. *Id.* at 1048.

140. *Id.*

141. *Id.*

142. *Id.*

143. *Id.* at 1048–49.

144. *Id.* at 1049.

had agreed to produce, narrow its requests, or move to compel production.¹⁴⁵

The TTAB rejected Midwestern's objections to certain exhibits submitted as part of Nestle's advertising, sales, and marketing evidence, finding that Midwestern placed too much reliance on Nestle's discovery responses and should have understood Nestle might later rely on such.¹⁴⁶ Notably, the TTAB held that Midwestern needed to file a motion to compel production if it wanted to test Nestle's objections to discovery requests.¹⁴⁷ Thus, the TTAB ruled that Midwestern waived its right to object to the evidence by failing to file a timely motion.¹⁴⁸

Midwestern argued on appeal that the TTAB should have sustained its objection to Nestle's admission of its advertising, sales, and marketing evidence because Nestle failed to produce these documents in response to Midwestern's discovery requests.¹⁴⁹ The majority, over a sharp dissent by Judge Dyk on this limited issue, disagreed and held that the TTAB did not abuse its discretion when it refused to strike Nestle's evidence.¹⁵⁰ The majority noted that TTAB procedures were amended in 2007 to require mandatory initial disclosures.¹⁵¹ Accordingly, the majority asserted that because Nestle filed its opposition prior to this amendment, it was not required to specify its evidence or identify its witnesses before trial.¹⁵² The majority further explained that TTAB precedent and procedures in effect before 2007 required Midwestern to move to compel production after Nestle objected to its discovery requests in order to test Nestle's responses.¹⁵³ The majority noted that in some cases, absent a motion to compel, the TTAB would bar introduction of evidence that had not been produced in discovery but explained that in those instances, "the withholding party represented that it had no relevant documents that would be used at trial or refused to allow access to the requested documents."¹⁵⁴ On appeal, Nestle objected to the production requests.¹⁵⁵

145. *Id.*

146. *Id.* (alteration in original).

147. *Id.*

148. *Id.*

149. *Id.*

150. *Id.* at 1051–52.

151. *Id.* at 1049–50.

152. *Id.* at 1050.

153. *Id.*

154. *Id.* at 1051.

155. *Id.*

Judge Dyk, in a thorough dissent, felt that the majority's holdings conflicted with "the advisory committee notes and with decisions interpreting the Federal Rules of Civil Procedure, which [had] been adopted for [TTAB] proceedings," specifically the majority's holdings that Nestle had no duty to produce evidence it intended to rely on at trial and that Midwestern's failure to compel production waived its right to object to the admission of evidence at trial.¹⁵⁶ Regarding the mandatory disclosure of evidence, Judge Dyk agreed with the majority that the 2007 amendment did not apply, but he believed that even though the TTAB had not yet adopted the mandatory disclosure requirement, "a party is required, under the pre-2007 document production provisions, to produce the documents on which it intends to rely if so requested during discovery."¹⁵⁷ The majority's response stated that the TTAB retained discretion to adopt discovery rulings and that it had not fully adopted the federal rules regarding discovery.¹⁵⁸

Judge Dyk also disagreed with the majority's holding that Midwestern waived its right to object to the admission of Nestle's evidence at trial.¹⁵⁹ He first noted that while federal rules and the TTAB's own rules "required a motion to compel as a prerequisite for sanctions for failure to comply with an initial discovery request, there is no such obligation for failure to supplement responses to discovery requests under Federal Rule of Civil Procedure 26(e)."¹⁶⁰ Judge Dyk pointed out that Rule 26(e) applied to the TTAB proceeding pursuant to 37 C.F.R. § 2.120 and explained that Rule 26(e) required "timely supplementation without a motion."¹⁶¹ He further doubted whether Trademark Trial and Appeal Board Manual of Procedure (TBMP) section 523.04, which the majority relied on in part to find waiver, applied to supplementation, but explained that it did not carry the force of law regardless.¹⁶² As a result, Judge Dyk would have remanded the case for consideration of an appropriate sanction.¹⁶³

156. *Id.* at 1054 (Dyk, J., concurring in part and dissenting in part).

157. *Id.* at 1056. Judge Dyk cited Federal Rule of Civil Procedure 26(a)(1)(A) in support of his position: "[P]arties are required to provide 'without awaiting a discovery request,' *inter alia*, 'the name . . . of each individual likely to have discoverable information . . . that the disclosing party may use to support its claims or defenses . . . [and] a copy . . . of all documents, electronically stored information, and tangible things that the disclosing party . . . may use to support its claims or defenses.'" *Id.* (second alteration in original) (quoting FED. R. CIV. P. 26(a)(1)(A)).

158. *Id.* at 1051 (majority opinion).

159. *Id.* at 1056-57 (Dyk, J., concurring in part and dissenting in part).

160. *Id.*

161. *Id.* at 1057.

162. *Id.*

163. *Id.* at 1058.

Substantively, the majority affirmed the TTAB's finding that Midwestern's WAGGIN' STRIPS and Nestle's BEGGIN' STRIPS marks were confusingly similar.¹⁶⁴ As an initial matter, the court explained that Nestle could rely on evidence of fame that postdated Midwestern's application to demonstrate likelihood of confusion.¹⁶⁵ Next, the court noted the relevant factors that the TTAB focused on to find likelihood of confusion: "the fame of Nestle's mark; the similarity of the goods, the channels of trade, and purchasers; the conditions of sale; the similarity of the marks; and Midwestern's intent."¹⁶⁶ The court first rejected Midwestern's argument that Nestle's mark deserved only a narrow scope of protection because the TTAB found that Nestle's mark was not famous.¹⁶⁷ Because Nestle had used the BEGGIN' STRIPS mark since 1988 to advertise, market, and sell products "throughout the nation," and further, because Nestle had expended considerable sums on advertising, "Nestle ha[d] covered a broad spectrum of advertising media in seeking to promote the mark."¹⁶⁸ Thus, the court found that although the BEGGIN' STRIPS mark was not famous, it was distinctive and deserved broad protection.¹⁶⁹

The Federal Circuit next compared the marks themselves, examining their "appearance, meaning, sound, and impression."¹⁷⁰ Both marks were in the standard character format, so design differences were not relevant; moreover, the court explained that "the two marks ha[d] the same format, structure, and syntax."¹⁷¹ Both marks consisted of two words, the second word—although disclaimed by both parties—was identical, and "[t]he first word in each mark end[ed] with GGIN'."¹⁷² Although "begging" and "wagging" are different verbs, the court explained that "the verb in both marks consists of a single syllable, and the marks have generally similar pronunciations, cadences, and intonations."¹⁷³ Additionally, the court found that the marks were "used in connection with identical products, and that the products would be sold in the same

164. *Id.* at 1052–53 (majority opinion).

165. *Id.* at 1052.

166. *Id.* (citing *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973)).

167. *Id.*

168. *Id.* at 1052–53.

169. *Id.* at 1053.

170. *Id.*

171. *Id.*

172. *Id.*

173. *Id.*

channels of trade and to the same consumers.”¹⁷⁴ Finding that the marks were “sufficiently similar in their overall commercial impression,” the court held that substantial evidence supported the TTAB’s finding that consumer confusion was likely.¹⁷⁵

B. *Infringement*

I. *3M Co. v. Mohan*

In *3M Co. v. Mohan*,¹⁷⁶ the Federal Circuit, in a nonprecedential opinion, affirmed a district court’s grant of partial summary judgment, finding that Pradeep Mohan, who was in business selling stethoscopes, willfully infringed 3M Company and 3M Innovative Properties Company’s (collectively 3M) trademarks, and affirmed the award of attorneys’ fees and costs for 3M.¹⁷⁷

3M alleged that Mohan sold on the Internet stethoscopes that infringed 3M’s patent and trademarks. The trademarks included the following marks: LITTMANN, LITTMANN QUALITY Stylized L, Stylized L, CARDIOLOGY III, MASTER CARDIOLOGY, 3M, and MASTER CARDIOLOGY configuration mark.¹⁷⁸ One of Mohan’s websites presented words and images similar or identical to several of those trademarks.¹⁷⁹ 3M further argued that the case was exceptional due to Mohan’s intentional actions, necessitating attorneys’ fees under the Lanham Act.¹⁸⁰ Mohan raised several counterclaims.¹⁸¹ The district court granted 3M’s motion for partial summary judgment that, *inter alia*, Mohan’s counterclaims be dismissed, and denied Mohan’s motion for partial summary judgment that 3M’s MASTER CARDIOLOGY configuration mark and CARDIOLOGY III word mark were both invalid.¹⁸² After a bench trial, the district court found that Mohan willfully infringed 3M’s trademarks, “that a permanent injunction was warranted, and that this was an exceptional case justifying the award of 3M’s attorneys’ fees.”¹⁸³

On appeal, Mohan argued that the district court erred in granting 3M partial summary judgment, violated his Seventh Amendment

174. *Id.*

175. *Id.* The court did not find the lack of survey evidence detrimental to Nestle’s position in light of ample evidence showing likelihood of confusion. *Id.* at 1054.

176. 482 F. App’x 574 (Fed. Cir. 2012).

177. *Id.* at 576.

178. *Id.*

179. *Id.*

180. *Id.*

181. *Id.*

182. *Id.*

183. *Id.* at 577.

right to a jury trial, and erred in finding both that Mohan willfully infringed 3M's trademarks and that the case was "exceptional."¹⁸⁴ Interestingly, at the district court, Mohan had sought summary judgment of invalidity, but, in response, 3M argued that the court should hold the mark not invalid as a matter of law.¹⁸⁵ The district court held that the mark was valid, noting that it could enter summary judgment sua sponte as long as Mohan had an opportunity to present his arguments.¹⁸⁶

In its decision regarding Mohan's appeal of trademark validity, the Federal Circuit agreed that the trademarks were valid.¹⁸⁷ The court reasoned that Mohan presented no evidence showing that the marks were not suggestive, and further, that Mohan "failed to produce any meaningful evidence" showing the marks became generic and were abandoned.¹⁸⁸ Thus, the court upheld the district court's summary judgment regarding the trademark validity.¹⁸⁹

The Federal Circuit also found that the district court did not violate Mohan's Seventh Amendment right to a jury trial by entering summary judgment sua sponte.¹⁹⁰ Noting that the nature of remedies determines the right to a jury trial, the Federal Circuit explained that the district court properly denied the claim by 3M for statutory damages, determined by the court, under the Lanham Act, because this would have violated Mohan's Seventh Amendment rights.¹⁹¹ Thus, according to the court, because only equitable remedies remained, "and the Seventh Amendment does not apply in suits seeking only equitable relief," the district court did not violate Mohan's Seventh Amendment right to a jury trial.¹⁹²

Regarding trademark infringement, the Federal Circuit found that the district court did not clearly err in finding a likelihood of confusion between 3M's and Mohan's marks.¹⁹³ Strong survey evidence and emails in which Mohan apologized to consumers regarding the source of the goods that he sold supported this conclusion.¹⁹⁴ Mohan argued fair use under the Lanham Act, but

184. *Id.*

185. 3M Co. v. Mohan, No. 09-1413, 2010 WL 3200052, at *1 (D. Minn. Aug. 9, 2010), *aff'd*, 482 F. App'x 574.

186. *Id.* at *7, *9.

187. 3M, 482 F. App'x at 578.

188. *Id.*

189. *Id.*

190. *Id.*

191. *Id.*

192. *Id.*

193. *Id.* at 579.

194. *Id.*

the court affirmed the district court's findings that Mohan's uses constituted counterfeiting under the statute and that Mohan intended to free ride on 3M's goodwill with its customers.¹⁹⁵ Finally, the Federal Circuit determined that the district court did not abuse its discretion in finding the case exceptional to award attorneys' fees.¹⁹⁶

C. *Use in Commerce and Abandonment*

1. *Lens.com, Inc. v. 1-800 Contacts, Inc.*

In *Lens.com, Inc. v. 1-800 Contacts, Inc.*,¹⁹⁷ the Federal Circuit affirmed the TTAB's summary judgment in a cancellation proceeding that Lens.com, Inc. had abandoned its LENS mark.¹⁹⁸ Lens.com, an online retailer of contact lenses and similar products, was the assignee of a registration for the mark LENS "in connection with computer software featuring programs used for electronic ordering of contact lenses in the field of ophthalmology, optometry and opticianry."¹⁹⁹ 1-800 Contacts, Inc. instituted a cancellation proceeding alleging, inter alia, abandonment "because Lens.com never sold or otherwise engaged in the trade of computer software."²⁰⁰ The TTAB granted 1-800 Contacts' motion for summary judgment, finding that Lens.com's software was not a "good in trade."²⁰¹

A federal trademark registration of a mark may be cancelled if the mark has been abandoned.²⁰² As a general matter, a mark is abandoned if its use has been discontinued with intent not to resume the use.²⁰³ As the court explained, section 45 of the Lanham Act (codified as 15 U.S.C. § 1127) provides that a "mark shall be deemed to be in use in commerce on goods when . . . the goods are *sold or transported in commerce*."²⁰⁴ Because Lens.com did not sell software, the Federal Circuit examined the appeal on "whether Lens.com's software [wa]s a 'good' that [wa]s 'transported in commerce.'"²⁰⁵ Lens.com claimed that software distributed to end-users via the

195. *Id.* at 579–80.

196. *Id.* at 580.

197. 686 F.3d 1376 (Fed. Cir. 2012).

198. *Id.* at 1378.

199. *Id.* (emphasis omitted) (internal quotation marks omitted).

200. *Id.*

201. *Id.*

202. *Id.* at 1379.

203. 15 U.S.C. § 1127 (2006).

204. *Lens.com*, 686 F.3d at 1380 (quoting 15 U.S.C. § 1127).

205. *Id.*

Internet satisfied the “use in commerce” requirement and felt that there was no public awareness requirement for use.²⁰⁶ 1-800 Contacts countered, arguing that Lens.com abandoned the mark because it did not offer software to consumers and that any software was merely ancillary to Lens.com’s online retail services.²⁰⁷ Further, 1-800 Contacts argued, consumers were unaware of any downloaded software and thus “could not possibly associate the LENS mark with a source of software.”²⁰⁸

The Federal Circuit first explained several “use in commerce” jurisdictional requirements before delving into the realm of Internet services.²⁰⁹ First, the court stated that where goods are “transported” in commerce, courts require public awareness of the use.²¹⁰ Second, the court explained that “use in commerce” requires that the goods not be merely “the conduit through which [the applicant] renders services.”²¹¹ Expanding on that notion, the court noted that an article must have some “independent value apart from the services;” otherwise “such article is not likely to be an independent good in trade.”²¹²

In the context of Internet services, the court noted that little precedent existed on whether “an Internet service providers’ software [wa]s an independent good in commerce, or [wa]s merely incidental to the Internet services.”²¹³ The court explained that whether consumers “associate a mark with software” requires a case-by-case factual determination.²¹⁴ The court stated that several factors should be considered, including whether the software: “(1) is simply the conduit or necessary tool useful only to obtain applicant’s services; (2) is so inextricably tied to and associated with the service as to have no viable existence apart therefrom; and (3) is neither sold separately from nor has any independent value apart from the services.”²¹⁵

The Federal Circuit distinguished this case from a U.S. Court of Appeals for the Eleventh Circuit case, *Planetary Motion, Inc. v. Techplosion, Inc.*,²¹⁶ and found that the LENS mark was not “use[d] in

206. *Id.* at 1379.

207. *Id.*

208. *Id.*

209. *Id.* at 1380.

210. *Id.*

211. *Id.* (alteration in original) (quoting *In re S’holders Data Corp.*, 495 F.2d 1360, 1361 (C.C.P.A. 1974)).

212. *Id.* (quoting *S’holders Data*, 495 F.2d at 1360).

213. *Id.* at 1381 (emphasis omitted).

214. *Id.* at 1381–82 (emphasis omitted).

215. *Id.* at 1382.

216. 261 F.3d 1188 (11th Cir. 2001).

commerce in association with software.”²¹⁷ According to the Federal Circuit, the Eleventh Circuit panel in *Planetary Motion* held that Coolmail Software “was sufficiently transported in commerce” because the software was the primary product, the website posted a filename showing the COOLMAIL mark, and evidence showed that consumers actually associated the mark with the software.²¹⁸ In contrasting the LENS mark from the COOLMAIL mark, the court explained that “the LENS mark [wa]s used only in connection with the sale and transportation of *contact lenses* via the Internet,” and the record did not show that “consumers ha[d] any reason to be aware of any connection between the LENS mark and Lens.com’s software.”²¹⁹ Thus, the Federal Circuit affirmed the TTAB’s judgment on abandonment.²²⁰

As a final matter, the court rejected Lens.com’s argument that the TTAB “erroneously relied solely on Lens.com’s specimens of use” to cancel the mark.²²¹ The court clarified that the TTAB “properly relied on the entire application file as directed by the [TTAB]’s regulations,” which state that the entire registration file automatically becomes “*part of the record* [in a cancellation proceeding].”²²²

2. *Willis v. Can’t Stop Productions, Inc.*

In *Willis v. Can’t Stop Productions, Inc.*,²²³ a nonprecedential opinion, the Federal Circuit affirmed the TTAB’s summary judgment that Can’t Stop Productions, Inc. (Can’t Stop) did not abandon its VILLAGE PEOPLE marks and that those marks were not generic.²²⁴ The plaintiff was Karen L. Willis, the wife of the Village People’s original lead singer, Victor Willis.²²⁵ Can’t Stop owned two registered VILLAGE PEOPLE service marks, “for entertainment services rendered by a musical and vocal group, and pre-recorded phonograph records, audio cassettes, audio tapes and compact discs featuring music and vocals.”²²⁶ Can’t Stop also owned a design mark,

217. *Lens.com*, 686 F.3d at 1382–83.

218. *Id.* at 1381–82.

219. *Id.* at 1382.

220. *Id.* at 1383.

221. *Id.*

222. *Id.* (second alteration in original) (quoting *Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 1357 (Fed. Cir. 2009)).

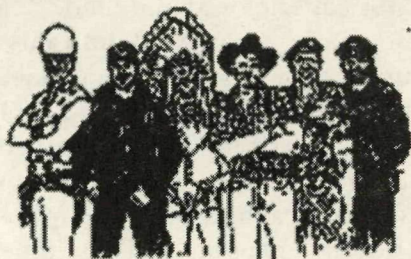
223. *Willis v. Can’t Stop Prods., Inc.*, 105 U.S.P.Q.2d (BNA) 1577 (Fed. Cir. 2012) (per curiam).

224. *Id.* at 1580.

225. *Id.* at 1578.

226. *Id.* (internal quotation marks omitted).

depicting the Village People members, for “entertainment services, namely, live performances by a musical and vocal group.”²²⁷



Before Mr. Willis left the Village People group, he signed an employment agreement whereby “he acknowledged that [Can’t Stop] own[ed] all rights to the name ‘The Village People’ and agreed not to use the name for any purpose.”²²⁸ After Can’t Stop refused to license the VILLAGE PEOPLE mark to Mrs. Willis and her husband, Mrs. Willis filed petitions to cancel Can’t Stop’s marks.²²⁹

In somewhat unclear fashion, Mrs. Willis made several arguments before the TTAB.²³⁰ Specifically, Mrs. Willis alleged that Can’t Stop misrepresented the source of its goods and services as originating from Can’t Stop rather than from Mr. Willis.²³¹ Further, Mrs. Willis argued that the marks were generic and abandoned.²³² The TTAB struck the misrepresentation-of-source claims from the pleadings because it found that the claims were legally insufficient.²³³ Additionally, the TTAB granted summary judgment, holding that Mrs. Willis did not submit evidence to support her claim that the marks were generic.²³⁴ The TTAB further granted summary judgment that Can’t Stop “did not abandon the ‘VILLAGE PEOPLE’ mark in connection with entertainment services or the design mark.”²³⁵ But the TTAB found a genuine issue of fact “as to whether [Can’t Stop] stopped using its [VILLAGE PEOPLE] mark in connection with [audio recordings].”²³⁶ Mrs. Willis appealed all adverse rulings.²³⁷

227. *Id.* (internal quotation marks omitted).

228. *Id.*

229. *Id.*

230. *Id.* at 1578–79.

231. *Id.*

232. *Id.* at 1579.

233. *Id.*

234. *Id.*

235. *Id.*

236. *Id.*

237. *Id.*

The Federal Circuit sided with the TTAB and struck down each of Mrs. Willis's arguments.²³⁸ First, the court determined that Can't Stop's marks were not generic or abandoned.²³⁹ Mrs. Willis, arguing pro se, claimed the marks "merely identif[ied] groups of people living in a community."²⁴⁰ The court explained that "Mrs. Willis offered no evidence that the term 'Village People' [wa]s used as a generic term for musical recordings or performances."²⁴¹ Regarding her abandonment claim, Mrs. Willis argued primarily "that the group d[id] not qualify as a 'musical and vocal group' because its members lip-sync[ed] and d[id] not play musical instruments."²⁴² The court noted that Mrs. Willis and her husband admitted that they saw "the Village People perform in connection with those marks," and Mrs. Willis's argument, at most, merely "reflect[ed] on the quality of entertainment [Can't Stop] offer[ed]."²⁴³ Finally, the court found that Mrs. Willis's fraud and misrepresentation-of-source claims were properly dismissed by the TTAB as legally insufficient.²⁴⁴ In the end, cursory allegations and a simple lack of evidence doomed Mrs. Willis.

D. Functionality

1. *In re Becton, Dickinson & Co.*

In *In re Becton, Dickinson & Co.*,²⁴⁵ the Federal Circuit affirmed the TTAB's decision to refuse registration of a closure cap design for blood collection tubes, finding the mark functional as a whole and therefore ineligible for trademark protection.²⁴⁶ The decision came from a divided panel, with Judge Clevenger writing for the majority²⁴⁷ and Judge Linn dissenting.²⁴⁸ Becton, Dickinson and Company (BD), a medical technology company, sought to register the mark for "closures for medical collection tubes."²⁴⁹

238. *Id.* at 1580.

239. *Id.*

240. *Id.* at 1579.

241. *Id.* at 1580.

242. *Id.* at 1579.

243. *Id.* at 1580.

244. *Id.*

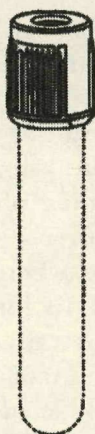
245. 675 F.3d 1368 (Fed. Cir. 2012).

246. *Id.* at 1369–70.

247. *Id.* at 1369.

248. *Id.* at 1377 (Linn, J., dissenting).

249. *Id.* at 1370 (majority opinion).



BD's trademark application "assert[ed] acquired distinctiveness based on five years of substantially exclusive and continuous use in commerce."²⁵⁰

At the PTO, the examining attorney refused to register BD's closure cap designs under the Lanham Act, finding that the cap design was functional and that, "even if non-functional, the cap design [wa]s a non-distinctive configuration of the goods."²⁵¹ In response to the examining attorney's request for additional information, BD submitted a number of patents, advertising samples, and website printouts showing caps from other companies.²⁵²

After the examining attorney issued a final refusal, BD simultaneously filed a Notice of Appeal to the TTAB and a Request for Reconsideration.²⁵³ The examining attorney denied the initial reconsideration request but accepted BD's second Request for Reconsideration, which "proposed [a] more detailed mark description."²⁵⁴ BD and the TTAB disagreed over the proposed mark: the TTAB found that "the features described in the amended description d[id] not embody the mark in its entirety."²⁵⁵ Thus, the TTAB determined "that the proposed mark included all elements shown in the drawing except the tube, which was shown in dotted lines."²⁵⁶

The TTAB applied the four factors from *In re Morton-Norwich Products, Inc.*²⁵⁷ and found the cap design—considered as a whole—functional.²⁵⁸

250. *Id.*

251. *Id.*

252. *Id.* at 1371.

253. *Id.*

254. *Id.*

255. *Id.*

256. *Id.*

257. 671 F.2d 1332 (C.C.P.A. 1982). The four factors are:

First, a finding of functionality was favored by the existence of a utility patent that described the utilitarian advantages of the cap's circular opening and ribs.²⁵⁹ Second, BD's advertising publicized several utilitarian advantages of the cap design, namely, the ridges on the cap's side that provided a secure grip, the flanged lip at the bottom that prevented users from popping off the cap, and the hooded cap design that prevented "the user's gloves from getting pinched between the stopper and tube when closing the tube."²⁶⁰ Third, based on the evidence, the TTAB found no alternative designs for collection tube caps.²⁶¹ Finally, with scant evidence on the fourth *Morton-Norwich* factor—motivation of the manufacturing technique on design aspects—the TTAB accorded it no weight in finding functionality.²⁶² Therefore, the TTAB held that "the closure cap configuration mark, considered in its entirety, [wa]s functional."²⁶³ Notably, the TTAB "gave less weight to less prominent features," finding them "incidental to the overall adoption of those features and hardly discernible when viewing the mark."²⁶⁴ The TTAB additionally found that BD failed to establish acquired distinctiveness and ultimately refused registration.²⁶⁵

BD presented two arguments on appeal to the Federal Circuit.²⁶⁶ First, BD argued that the TTAB committed legal error by discounting the significance of the closure cap's nonfunctional elements.²⁶⁷ Second, BD argued that substantial evidence did not support the TTAB's *Morton-Norwich* analysis.²⁶⁸

(1) the existence of a utility patent disclosing the utilitarian advantages of the design; (2) advertising materials in which the originator of the design touts the design's utilitarian advantages; (3) the availability to competitors of functionally equivalent designs; and (4) facts indicating that the design results in a comparatively simple or cheap method of manufacturing the product.

Value Eng'g, Inc. v. Rexnord Corp., 278 F.3d 1268, 1274 (Fed. Cir. 2002) (citing *Morton-Norwich*, 671 F.2d at 1340–41).

258. *Becton*, 675 F.3d at 1372.

259. *Id.* at 1371–72.

260. *Id.* at 1372.

261. *Id.*

262. *Id.*

263. *In re Becton, Dickinson & Co.*, No. 77254637, 2010 WL 3164746, at *4 (T.T.A.B. July 27, 2010), *aff'd*, 675 F.3d 1368.

264. *Becton*, 675 F.3d at 1372. The TTAB relied on *Textron, Inc. v. U.S. International Trade Commission*, 753 F.2d 1019 (Fed. Cir. 1985), finding that nonfunctional features do not affect the functionality determination where the overall design is functional. *Becton*, 675 F.3d at 1372.

265. *Becton*, 675 F.3d at 1372.

266. *Id.* at 1373.

267. *Id.*

268. *Id.*

BD's first argument revived its dispute with the TTAB over the scope of the mark.²⁶⁹ BD asserted that the scope of the mark was modest, explaining that the cap's elongated shape, rib spacing, and the relationship of those features to the cap as a whole was the mark design.²⁷⁰ Therefore, BD asserted that the TTAB should have considered the nonfunctional elements in its functionality determination.²⁷¹ The Federal Circuit majority, rejecting BD's position, explained that "[w]henver a proposed mark includes both functional and non-functional features, as in this case, the critical question is the degree of utility present in the overall design of the mark."²⁷² Thus, the *Morton-Norwich* analysis "weigh[s] the elements of a mark against one another to develop an understanding of whether the mark as a whole is essentially functional and thus non-registrable."²⁷³

Judge Linn dissented and explained that "[t]he proper inquiry is to examine the degree to which the mark as a whole is dictated by utilitarian concerns (functional or economic superiority) or is arbitrary ('without complete deference to utility')."²⁷⁴ While Judge Linn agreed that the degree of design utility must be considered—and de facto functional features may be analyzed—to determine de jure functionality, he felt that weighing individual elements against each other ran "contrary to the consideration of the mark as a whole."²⁷⁵

Regarding BD's second argument, the majority held that substantial evidence supported the TTAB's *Morton-Norwich* analysis.²⁷⁶ Regarding the first factor, the majority found that one of BD's patents disclosed "two prominent features of BD's mark: (1) the two concentric circles at the top of the closure cap, which allow a needle to be inserted, and (2) the ribs, which serve as a gripping surface."²⁷⁷ BD argued, and Judge Linn agreed, that the patent did not actually claim those features, but rather merely disclosed those features in the patent's specification.²⁷⁸ The majority, however, explained that the Supreme Court, in *Traffix Devices, Inc. v. Marketing Displays, Inc.*,²⁷⁹

269. *Id.*

270. *Id.*

271. *Id.*

272. *Id.*

273. *Id.*

274. *Id.* at 1377 (Linn, J., dissenting) (quoting *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1343 (C.C.P.A. 1982)).

275. *Id.*

276. *Id.* at 1376-77 (majority opinion).

277. *Id.* at 1375.

278. *Id.* at 1379 (Linn, J., dissenting).

279. 532 U.S. 23 (2001).

“d[id] not require that a patent claim the exact configuration for which trademark protection is sought in order to undermine an applicant’s assertion that an applied-for mark is not de jure functional.”²⁸⁰ Further, the majority rejected BD’s argument that its design patents demonstrated nonfunctionality because the design patents and BD’s mark lacked identity, asserting that mere similarity lacked sufficient evidentiary force to overcome the strong conclusion that functional elements were present in BD’s mark.²⁸¹

As for the second *Morton-Norwich* factor, the majority found that substantial evidence supported the TTAB’s finding that BD’s advertising touted the utilitarian features of the cap design.²⁸² Judge Linn agreed with this point but argued that BD’s advertising supported a “finding of non-functionality based on the third *Morton-Norwich* factor: the presence of alternative designs.”²⁸³ The majority briefly discussed the third factor, noting that once functionality is established, consideration of the availability of alternative designs is not necessary.²⁸⁴ Although acknowledging that rule, Judge Linn noted that alternative designs may nevertheless “be a legitimate source of evidence to determine whether a feature is functional in the first place.”²⁸⁵

Additionally, the majority summarily dismissed the fourth factor—whether the cap design results from simple or inexpensive methods of manufacture—because BD presented scarce evidence on this factor to the TTAB.²⁸⁶ In his dissent, Judge Linn felt that the majority nonetheless should have considered the evidence BD did present.²⁸⁷

Finally, the majority explained that the functionality doctrine protects industry competition.²⁸⁸ Given that BD’s competitors included similar functional features on their cap products, “the competitive need to copy the [cap’s] functional features” reinforced the conclusion that BD’s proposed mark was functional.²⁸⁹

280. *Becton*, 675 F.3d at 1375.

281. *Id.*

282. *Id.*

283. *Id.* at 1379 (Linn, J., dissenting).

284. *Id.* at 1376 (majority opinion).

285. *Id.* at 1380 (Linn, J., dissenting) (quoting *Value Eng’g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1276 (Fed. Cir. 2002)).

286. *Id.* at 1376 (majority opinion).

287. *Id.* at 1380–81 (Linn, J., dissenting).

288. *Id.* at 1376 (majority opinion).

289. *Id.*

E. Descriptiveness

1. DuoProSS Meditech Corp. v. Inviro Medical Devices, Ltd.

In *DuoProSS Meditech Corp. v. Inviro Medical Devices, Ltd.*,²⁹⁰ the Federal Circuit bared its teeth and demonstrated its ability to reverse the TTAB for lack of substantial evidence. The court overturned the TTAB's decision not to cancel a design mark and word mark, remanding the case with instructions to cancel both marks.²⁹¹

DuoProSS Meditech Corp. and Inviro Medical Devices, Ltd. both sold "medical syringes and needles . . . designed to prevent accidental needle sticks."²⁹² Inviro's products prevented needle sticks by drawing the needle into the syringe barrel with the plunger and snapping off the plunger to seal the needle inside the barrel.²⁹³ Inviro, appealing counterclaims filed against it by DuoProSS, had registered two separate marks.²⁹⁴ The first registration covered the SNAP! design mark.²⁹⁵



The second registration covered SNAP SIMPLY SAFER in standard characters.²⁹⁶ Inviro initially petitioned to cancel DuoProSS's trademark registration for the BAKSNAP design mark for use with safety syringes.²⁹⁷ Inviro withdrew its petition, but DuoProSS maintained its counterclaims to cancel several of Inviro's registrations, namely, the two registrations on appeal and several SNAP marks in typed format.²⁹⁸ The TTAB concluded that the SNAP marks in typed format were merely descriptive and ordered cancellation but declined to cancel the SNAP! design mark and the SNAP SIMPLY SAFER word mark.²⁹⁹ DuoProSS appealed the TTAB's rulings as to the design mark and word mark.³⁰⁰

290. 695 F.3d 1247 (Fed. Cir. 2012).

291. *Id.* at 1251, 1257.

292. *Id.* at 1249.

293. *Id.*

294. *Id.* at 1250.

295. *Id.*

296. *Id.*

297. *Id.*

298. *Id.* at 1250–51.

299. *Id.* at 1251.

300. *Id.*

The Federal Circuit first found that substantial evidence did not support the TTAB's finding that DuoProSS failed to show that the SNAP! design mark was merely descriptive.³⁰¹ Initially, the TTAB "improperly focused on only one portion of the mark when it considered the mark's commercial impression."³⁰² Second, the TTAB lacked evidentiary support for its conclusion that DuoProSS failed to prove descriptiveness.³⁰³ Regarding the mark itself, the court explained that the TTAB erroneously separated "the literal element SNAP [from] the broken exclamation point."³⁰⁴ The court explained that "[w]hen determining whether a mark is merely descriptive, the [TTAB] must consider the commercial impression of a mark as a whole."³⁰⁵ The TTAB cannot "dissect" a mark into separate elements.³⁰⁶ The court noted that the TTAB may examine the mark's individual components, but it "ultimately must consider the mark as a whole and do so in the context of the goods or services at issue."³⁰⁷ According to the court, after the TTAB found the SNAP element descriptive and the exclamation point fanciful, it should have considered "whether the entire mark . . . convey[ed] a commercial impression that [wa]s merely descriptive to a consumer."³⁰⁸

Second, the court reprimanded the TTAB for not supporting its conclusion that the design mark was more than descriptive with satisfactory evidence.³⁰⁹ The TTAB thought that the exclamation point merely "suggest[ed] the breaking of something, rather than a syringe plunger specifically."³¹⁰ The court, emphasizing that a mark's commercial impression "must be viewed through the eyes of a consumer," found that the TTAB failed to show evidence "that a consumer would have to employ imagination, thought, and perception to determine that the mark was referring to the snapping of a syringe plunger."³¹¹ Further, the court clarified that the proper inquiry to determine whether a mark is merely descriptive "is whether someone who knows what the goods and services are will understand

301. *Id.* (asserting that "the record supports no conclusion other than that the mark is merely descriptive" (emphasis added)).

302. *Id.* at 1252.

303. *Id.*

304. *Id.*

305. *Id.*

306. *Id.*

307. *Id.* at 1253.

308. *Id.*

309. *Id.*

310. *Id.* (internal quotation marks omitted).

311. *Id.*

the mark to convey information about them.”³¹² Given that Inviro’s instructions on how to disable needles depicted the design mark, and that its website displayed with prominence both a broken plunger and the word “Snap,” the court noted that the TTAB’s findings supported the opposite conclusion.³¹³

The Federal Circuit further held that substantial evidence did not support the TTAB’s finding that SNAP SIMPLY SAFER was not merely descriptive, and additionally, that the TTAB “legally erred when it concluded that puffery could render the mark more than descriptive.”³¹⁴ Again, the court reprimanded the TTAB for “impos[ing] its own view” about the SNAP SIMPLY SAFER mark, focusing on the words’ alliteration and thus concluding, without evidentiary support, that the commercial impression amounted to it being more than merely descriptive.³¹⁵ As the Federal Circuit panel read the record, it found only that the mark described safety, the products’ “most important advantage.”³¹⁶ Lastly, the court concluded that the TTAB erred as a matter of law in finding that the “puffery” of the SNAP SIMPLY SAFER mark made it more than descriptive.³¹⁷ The court stated “that puffing, if anything, is *more* likely to render a mark merely descriptive, not less so.”³¹⁸

The Federal Circuit took this opportunity to remind the TTAB not to substitute its own views about a mark for the commercial impression that a mark conveys to a consumer. Additionally, the court demonstrated that substantial evidence review, while deferential, provides a potential avenue for relief.

2. In re The Chamber of Commerce

In *In re The Chamber of Commerce*,³¹⁹ the Federal Circuit affirmed the TTAB’s refusal to register the mark NATIONAL CHAMBER on the ground of mere descriptiveness.³²⁰ The U.S. Chamber of Commerce (COC) sought to register the service mark NATIONAL CHAMBER in two related applications.³²¹ Both applications sought registration for services all within the same class, “which generally encompasse[d]

312. *Id.* at 1254 (quoting *In re Tower Tech, Inc.*, 64 U.S.P.Q.2d 1314, 1316–17 (T.T.A.B. 2002)).

313. *Id.* at 1254–55.

314. *Id.* at 1255.

315. *Id.* at 1254, 1256.

316. *Id.* at 1255.

317. *Id.* at 1256.

318. *Id.*

319. 675 F.3d 1297 (Fed. Cir. 2012).

320. *Id.* at 1298.

321. *Id.*

advertising and business-related services.”³²² Specifically, the first application sought registration for “providing online directory information services[,] . . . providing information and news in the field of business, . . . [and] administration of a discount program.”³²³ The second application sought registration for “business data analysis” and “analysis of governmental policy relating to businesses . . . for the purpose of promoting the interests of businessmen and businesswomen.”³²⁴ The TTAB, relying on printouts from COC’s website and dictionary definitions of “national” and “chamber,” found that consumers would “immediately understand NATIONAL CHAMBER, used in connection with applicant’s services . . . as conveying information about them,” and denied registration.³²⁵

On appeal, the Federal Circuit briefly discussed the law of descriptiveness and found that substantial evidence supported the TTAB’s finding of mere descriptiveness.³²⁶ The court explained that “[d]escriptiveness must be evaluated ‘in relation to the particular goods for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use or intended use.’”³²⁷ Because COC filed an intent-to-use application, it did not—and could not—rely on secondary meaning or acquired distinctiveness.³²⁸

As a threshold matter, COC arguably conceded that “national” meant nationwide in scope, “chamber” usually meant a chamber of commerce, and “a chamber of commerce generally serves to promote the interests of businesspersons in various ways.”³²⁹ Importantly, the court stated: “To decide this case, we need only find that NATIONAL CHAMBER immediately conveys information about one feature or characteristic of at least one of the designated services within each of COC’s applications.”³³⁰ Regarding the first application, the court found NATIONAL CHAMBER descriptive of online directory-information services because a COC website printout showed that its online directory, “provide[d] information to identify

322. *Id.* at 1298–99.

323. *Id.* (internal quotation marks omitted).

324. *Id.* at 1299.

325. *Id.*

326. *Id.* at 1300–01.

327. *Id.* at 1300 (quoting *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963–64 (Fed. Cir. 2007)) (internal quotation marks omitted).

328. *Id.*

329. *Id.* at 1301.

330. *Id.*

chambers of commerce nationwide.”³³¹ Regarding the second application, the court found substantial evidence supported the TTAB’s mere descriptiveness finding.³³² The court explained that “business and regulatory data analysis services are within the scope of traditional chambers of commerce activities,” and “chamber” often refers to “chamber of commerce.”³³³ The court further reasoned that NATIONAL CHAMBER also described the function of the former service in the second application, namely, promoting interests of businesspeople.³³⁴

Although the court found the mark merely descriptive, it carefully noted that it would not establish a broad general rule that all traditional chamber-of-commerce services further business interests and thus refused to hold “that NATIONAL CHAMBER [wa]s merely descriptive of any nationwide service that [wa]s within a broad genus of ‘chamber of commerce services.’”³³⁵ That refusal did not help COC here, as COC’s mark merely had to immediately convey knowledge of only one feature of only one designated service in an application to doom applications for the proposed marks.³³⁶

As a final, procedural matter, the court briefly “address[ed] COC’s contention that the TTAB’s reasoning was so conclusory as to preclude meaningful appellate review.”³³⁷ The court reminded the TTAB to expressly link its “evidentiary findings to the individually recited services within the two applications” but ultimately found that the TTAB’s reasoning was sufficiently clear to satisfy the substantial evidence standard of review.³³⁸

3. *In re Miracle Tuesday, LLC*

In *In re Miracle Tuesday, LLC*,³³⁹ the Federal Circuit affirmed the TTAB’s refusal to register a “primarily geographically deceptively misdescriptive” mark.³⁴⁰ Miracle Tuesday, LLC, a fashion company, filed an intent-to-use application seeking to register its JPK PARIS 75

331. *Id.*

332. *Id.*

333. *Id.*

334. *See id.* (explaining that a mark is descriptive if it immediately conveys imparts knowledge of a function of the service with which it is used).

335. *Id.*

336. *Id.*

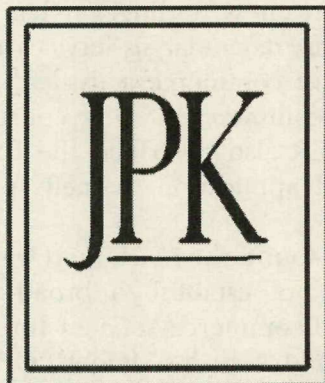
337. *Id.* at 1302.

338. *Id.*

339. 695 F.3d 1339 (Fed. Cir. 2012).

340. *Id.* at 1341; *see infra* text accompanying notes 346–47 (defining the limits of such marks).

mark and design for "sunglasses, wallets, handbags and purses, travel bags, suitcases, belts, and shoes."³⁴¹



PARIS 75

Jean-Pierre Klifa, a French citizen and manager of Miracle Tuesday, lived in Paris for twenty-two years before moving to the United States in 1986.³⁴² While in Paris, Klifa, who also designed the goods at issue, exhibited at two trade shows, although in his declaration in support of his application, he did not identify which goods he exhibited.³⁴³ The examining attorney and the TTAB were not persuaded by these facts to register the mark and design, and both found the mark "primarily geographically deceptively misdescriptive."³⁴⁴

Miracle Tuesday appealed to the Federal Circuit, arguing that the TTAB made several errors in its refusal to register the mark under section 2(e)(3) of the Lanham Act.³⁴⁵ This section bars registration "on the principal register if the mark, 'when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them.'"³⁴⁶ This provision applies to marks where

- (1) the primary significance of the mark is a generally known geographic location;
- (2) the consuming public is likely to believe the place identified by the mark indicates the origin of the goods

341. *Id.* at 1341.

342. *Id.* at 1342.

343. *Id.*

344. *Id.* at 1342-43.

345. *Id.* at 1343.

346. *Id.* (quoting 15 U.S.C. § 1052(e)(3) (2006)).

bearing the mark, when in fact the goods do not come from that place; and (3) the misrepresentation was a material factor in the consumer's decision to purchase the goods.³⁴⁷

On appeal, Miracle Tuesday took issue with the TTAB's findings as to the second and third elements of the refusal.³⁴⁸ In particular, it argued that the goods were not generated in Paris, that the TTAB applied an improper standard to determine that the word "Paris" was deceptive, and that the determination ultimately failed to account for material evidence.³⁴⁹

The Federal Circuit, responding to Miracle Tuesday's first argument, clarified the law on association and origin of goods. The second element of a Lanham Act section 2(e)(3) refusal—"whether the public would reasonably identify or associate the goods sold under the mark with the geographic location contained in the mark"³⁵⁰—examines two questions. First, whether an association exists between the goods and the identified place, known as the "goods/place association," and second, "whether the applicant's goods in fact come from that place."³⁵¹ As to the goods/place association analysis, the court explained that the PTO need not demonstrate an actual association; rather, the PTO "need only establish a *reasonable predicate* for its conclusion that the public would be *likely* to make the particular goods/place association on which it relies."³⁵² Further, in cases involving goods, the Federal Circuit noted that when a "place is known for producing the product," a goods/place association may be inferred.³⁵³ Here, the court found that because Paris is famous for fashion and fashion accessories, and "relevant purchasers are likely to think of Paris as a known source for fashion accessories," sufficient evidence supported the TTAB's determination that a goods/place association existed between the listed goods and Paris.³⁵⁴

Regarding the question under section 2(e)(3) of whether the goods in fact come from a place, the Federal Circuit clarified the law on origin.³⁵⁵ Goods must originate from the named place, but the

347. *Id.* (quoting *In re Cal. Innovations, Inc.*, 329 F.3d 1334, 1341 (Fed. Cir. 2003)) (internal quotation marks omitted).

348. *Id.*

349. *Id.*

350. *Id.* (quoting *In re Save Venice N.Y., Inc.*, 259 F.3d 1346, 1353–54 (Fed. Cir. 2001)).

351. *Id.*

352. *Id.* at 1343–44 (quoting *In re Pacer Tech.*, 338 F.3d 1348, 1351 (Fed. Cir. 2003)) (internal quotation marks omitted).

353. *Id.* at 1344.

354. *Id.*

355. *Id.* at 1344–45.

court explained that “[o]rigin can be predicated on factors other than manufacture . . . where the circumstances justify such a connection.”³⁵⁶ Miracle Tuesday disagreed with the TTAB’s “overly restrictive” interpretation of “originates.”³⁵⁷ The TTAB found “the fact that Klifa lived and worked in Paris for twenty-two years” unpersuasive.³⁵⁸ Miracle Tuesday urged the Federal Circuit to consider that Klifa “has a significant connection with Paris and that customers are more interested in the designer’s origin than the origin of the goods themselves.”³⁵⁹ Miracle Tuesday further pointed to the fact that people at red carpet events care more about the designer of celebrities’ clothing than the place the clothing was made.³⁶⁰ The court, dismissing these arguments, explained that the proper statutory inquiry is “whether there is a connection between the *goods* and Paris—not between the designer and Paris.”³⁶¹ Thus, according to the court, that the designer lived in Paris long ago could not justify a mark indicating the goods originated there.³⁶² The court further expounded on the origin requirement, noting that “there must be some other direct connection between the goods and the place identified in the mark.”³⁶³ Because Miracle Tuesday’s goods were designed in Miami and made in Asia, no current connection between the goods and Paris existed.³⁶⁴

Next, the court rejected Miracle Tuesday’s argument regarding the proper standard for materiality under the third element of a section 2(e)(3) refusal.³⁶⁵ This element requires that “a substantial portion of the relevant consumers . . . be materially influenced in the decision to purchase the product or service by the geographic meaning of the mark.”³⁶⁶ The court explained that “evidence that the place is famous as a source of the goods at issue” raises an inference favoring materiality.³⁶⁷ Miracle Tuesday argued that the TTAB applied the wrong materiality standard and that the TTAB had to find that use of

356. *Id.* at 1344. The PTO at oral argument admitted that place of *design*, rather than manufacture, can sufficiently establish origin. *Id.* Further, the location of an applicant’s “headquarters or research and development facilities” might suffice to find origin. *Id.*

357. *Id.* at 1345.

358. *Id.*

359. *Id.*

360. *Id.*

361. *Id.*

362. *Id.*

363. *Id.*

364. *Id.*

365. *Id.* at 1346.

366. *Id.* (quoting *In re Spirits Int’l, N.V.*, 563 F.3d 1347, 1357 (Fed. Cir. 2009)).

367. *Id.* (quoting *In re Les Halles de Paris J.V.*, 334 F.3d 1371, 1374 (Fed. Cir. 2003)).

the word "Paris" actually deceived the public.³⁶⁸ Noting that Miracle Tuesday relied on a case that involved services, rather than goods, however, the court responded that service marks required "a heightened association between the services and geographic location."³⁶⁹ For goods, on the other hand, evidence that the place is famous for those goods sufficiently raises an inference of materiality.³⁷⁰ Again relying on the fact that Paris is famous for fashion and design, the court found that "the geographic misrepresentation in the mark is material and would deceive a substantial portion of the relevant consumers regarding the source of the goods outlined in the application."³⁷¹

As a final evidentiary matter, the Federal Circuit rejected Miracle Tuesday's complaints that the TTAB did not consider various scholarly articles about consumer purchasing decisions and originating country issues.³⁷² Noting the presumption that fact-finders review all presented evidence, the court explained that merely because the TTAB did not discuss all of the evidence did not indicate that the evidence was not actually reviewed.³⁷³

F. Scandalous Matter

1. In re Fox

In *In re Fox*,³⁷⁴ the Federal Circuit, in one of the more interesting opinions of 2012, affirmed the TTAB's refusal to register a vulgar mark that fell within the proscription of section 2(a) of the Lanham Act.³⁷⁵ The applicant sought to register the words COCK SUCKER and a crowing rooster design for rooster-shaped chocolate lollipops.³⁷⁶

368. *Id.*

369. *Id.* at 1347.

370. *Id.*

371. *Id.*

372. *Id.* at 1347–48.

373. *Id.* at 1348.

374. 702 F.3d 633 (Fed. Cir. 2012).

375. *Id.* at 634.

376. *Id.* at 635.

Cock Sucker



Marsha Fox sold her chocolate roosters primarily to fans of schools using roosters as mascots—the University of South Carolina and Jacksonville State University.³⁷⁷

The TTAB refused registration, finding that the words, “when used in connection with the applicant’s products, create[d] a double entendre: one meaning is one who performs fellatio; and the other meaning is a rooster lollipop.”³⁷⁸ The TTAB concluded that the term COCK SUCKER was vulgar and thus fell within section 2 of the Lanham Act’s prohibition on registration of scandalous matter.³⁷⁹

The Federal Circuit affirmed the TTAB’s refusal and held that “a mark that creates a double entendre falls within the proscription of [section 2 of the Lanham Act] where, as here, one of its meanings is clearly vulgar.”³⁸⁰ Fox initially argued that the literal part of her mark meant only “rooster lollipop.”³⁸¹ The court disagreed, first noting that Fox herself conceded that “cocksucker” is a vulgar word in normal parlance, and second asserting “that the distinction between COCKSUCKER [one word] and COCK SUCKER [two words] is a distinction without a difference.”³⁸²

Alternatively, Fox asserted “that when a mark is a double entendre, with one vulgar and one non-vulgar meaning, the PTO must demonstrate that the public would ‘choose’ the non-vulgar meaning.”³⁸³ The court explained that, as an initial matter, a mark’s

377. *Id.*

378. *In re Fox*, No. 76315793, 2011 WL 6012204, at *3 (T.T.A.B. 2011), *aff’d*, 702 F.3d 633.

379. *Id.*

380. *Fox*, 702 F.3d at 634.

381. *Id.* at 637.

382. *Id.*

383. *Id.* at 638.

vulgar meaning need not be the only relevant meaning; rather, “as long as a ‘substantial composite of the general public’ perceives the mark, in context, to have a vulgar meaning, the mark as a whole ‘consists of or comprises . . . scandalous matter.’”³⁸⁴ Thus, Congress extended the prohibition on scandalous matter to marks that merely included such matter.³⁸⁵ The court distinguished an earlier case that allowed registration of a mark, which was ambiguous because of two alternative, nonvulgar meanings, explaining that in the present case, “the conceded effect of the mark is to invoke a ‘double meaning.’”³⁸⁶ The court further denied Fox’s final argument that the PTO should permit registration and rely on opposition proceedings for any public objections to the mark.³⁸⁷ The court noted its approval of this approach where a mark’s registrability was uncertain but ultimately concluded that no such uncertainty existed in this case.³⁸⁸

While the Federal Circuit denied Fox’s registration of her mark, the court reiterated the impact of its decision. The court explained that its decision did not “preclude[] Fox from continuing to sell her merchandise under the mark at issue, or from seeking trademark protection for some other, otherwise registrable element of her product’s design, dress, or labeling.”³⁸⁹ The court’s decision merely denied Fox’s ability to avail herself of the benefits of federal registration for COCK SUCKER.³⁹⁰

II. PROCEDURAL TRADEMARK ISSUES

A. *Collateral Estoppel*

1. *Stephen Slesinger, Inc. v. Disney Enterprises*

In *Stephen Slesinger, Inc. v. Disney Enterprises*,³⁹¹ a Federal Circuit majority affirmed the TTAB’s dismissal of Stephen Slesinger, Inc.’s (Slesinger’s) cancellation and opposition proceedings due to collateral estoppel.³⁹² Decades of disputes in federal courts, state courts, and the TTAB between Slesinger and Disney Enterprises, Inc.

384. *Id.* (quoting 15 U.S.C. § 1052(a) (2006), and *In re The Boulevard Entm’t*, 334 F.3d 1336, 1340 (Fed. Cir. 2003)).

385. *Id.*

386. *Id.*; see *In re Mavety Media Grp.*, 33 F.3d 1367, 1373–74 (Fed. Cir. 1994) (differentiating between a double entendre and general ambiguity regarding the word “tail”).

387. *Fox*, 702 F.3d at 639–40.

388. *Id.*

389. *Id.* at 639.

390. *Id.* at 640.

391. 702 F.3d 640 (Fed. Cir. 2012).

392. *Id.* at 642.

over the trademark rights related to A.A. Milne's Winnie-the-Pooh literary works preceded this appeal.³⁹³

A.A. Milne transferred merchandising rights for Winnie-the-Pooh works to Slesinger in 1930.³⁹⁴ Later, in 1961, Slesinger assigned those rights to Walt Disney Productions.³⁹⁵ The parties' dispute in this case stemmed from a 1983 agreement, which first revoked all previous agreements and then transferred all of the right in the work back to Slesinger.³⁹⁶ Slesinger then transferred at least certain rights back to Disney.³⁹⁷ In the dispute on appeal, Slesinger argued that it retained rights in the Winnie-the-Pooh works, while Disney argued that Slesinger assigned all rights to Disney.³⁹⁸

In a separate 1991 state court action, Slesinger alleged that the 1983 agreement gave Disney valuable rights in exchange for royalties.³⁹⁹ During these proceedings, Slesinger conceded that the 1983 agreement assigned all acquired rights to Disney.⁴⁰⁰ In addition, Slesinger explained that the grant of all "further rights" was "a catch-all designed to ensure that Slesinger was granting . . . all of the additional commercial exploitation rights Slesinger acquired that [we]re not specifically mentioned in the 1983 Agreement."⁴⁰¹ Eventually, the California Court of Appeals affirmed the state trial court's dismissal of Slesinger's claim.⁴⁰² The parties' royalty dispute continued in the Central District of California, where Slesinger amended its complaint to allege trademark and copyright infringement.⁴⁰³ There, "Disney moved to dismiss the claim because Slesinger had admitted in state court that Disney's uses of the Winnie-the-Pooh characters were authorized . . . [, and because] Slesinger retained no rights which Disney could infringe."⁴⁰⁴ On cross motions for summary judgment, the district court examined the agreement's scope and noted that the parties' conduct since 1983 "indicated the Winnie-the-Pooh rights were transferred to Disney in the 1983 agreement."⁴⁰⁵ Specifically, Disney registered a number of

393. *Id.*

394. *Id.*

395. *Id.*

396. *Id.*

397. *Id.*

398. *Id.*

399. *Id.*

400. *Id.*

401. *Id.* (quoting Milne *ex rel.* Coyne v. Stephen Slesinger, Inc., No. 2:02-cv-08508, 2009 WL 3140439, at *4 (C.D. Cal. Sept. 25, 2009)).

402. *Id.*

403. *Id.* at 643.

404. *Id.*

405. *Id.*

trademarks and copyrights; Slesinger, in contrast, took no such action.⁴⁰⁶ The district court further found “that Slesinger transferred all of its rights . . . to Disney, and [could] not now claim infringement of any retained rights.”⁴⁰⁷

The current appeal before the Federal Circuit stemmed from Slesinger’s attempt to cancel Disney’s applications to register several marks “comprising the names or images of ‘Pooh’ and related fictional characters.”⁴⁰⁸ Slesinger claimed that the 1983 agreement was a license and thus that Disney had no right to register the marks.⁴⁰⁹ Disney viewed the agreement as an assignment and filed a motion to dismiss.⁴¹⁰ The TTAB found that collateral estoppel barred Slesinger’s claims and granted Disney’s motion, treating it as a motion for summary judgment.⁴¹¹

A majority of the Federal Circuit found that the TTAB properly applied collateral estoppel to bar Slesinger’s claim that the 1983 agreement was a mere license.⁴¹² The majority first laid out the four elements required for collateral estoppel to bar a claim: “(1) a prior action presents an identical issue; (2) the prior action actually litigated and adjudged that issue; (3) the judgment in that prior action necessarily required determination of the identical issue; and (4) the prior action featured full representation of the estopped party.”⁴¹³ On appeal, Slesinger conceded the first and fourth elements.⁴¹⁴ The majority noted that the district court “litigated the identical issue, the scope of the 1983 agreement, and Slesinger was fully represented.”⁴¹⁵ The current appeal, and disagreement between the Federal Circuit majority and Judge Reyna, dissenting, concerned the second and third elements.

The majority and Judge Reyna strongly disagreed on the second element: whether the district court actually litigated and decided the critical issue. The majority rejected Slesinger’s argument “that the district court did not properly consider the critical issue on the scope of the 1983 agreement.”⁴¹⁶ The majority explained that the district

406. *Id.*

407. *Id.* (quoting Milne *ex rel.* Coyne v. Stephen Slesinger, Inc., No. 2:02-cv-08508, 2009 WL 3140439, at *4 (C.D. Cal. Sept. 25, 2009)) (internal quotation marks omitted).

408. *Id.*

409. *Id.*

410. *Id.*

411. *Id.* at 643–44.

412. *Id.* at 646.

413. *Id.* at 644.

414. *Id.*

415. *Id.*

416. *Id.*

court thoroughly analyzed whether the 1983 agreement was a license or an assignment, and that Slesinger maintained that the agreement was a license.⁴¹⁷ Slesinger argued that the district court's use of the term "retained rights" in its ruling "implied Slesinger licensed its rights to Disney," that the district court did not use the word "assignment," and that "its reference to the 'grant' or 'transfer' support[ed] Slesinger's contention the 1983 agreement was a license."⁴¹⁸ The majority disagreed with Slesinger and concluded that the parties' conduct over the past several decades, and "the district court's holding that the 1983 agreement represented 'a transfer from [Slesinger] to Disney of *all* of [Slesinger]'s interests in the Pooh characters," demonstrated that the district court found that Slesinger "retained" no rights.⁴¹⁹

Moreover, the majority felt it immaterial that the district court used "transfer" and "grant" instead of "assignment," asserting that "it is the court's ultimate '*judgment* that matters,' not the language used to discuss the court's rulings."⁴²⁰ Judge Reyna strongly disagreed, seemingly elevating form over substance, and writing that the district court's use of such language could reasonably refer to a license.⁴²¹ In Judge Reyna's view, reasonable doubt existed over whether the district court actually decided the issue.⁴²² Judge Reyna found the district court's use of ambiguity particularly important, arguing that a possible explanation for this ambiguity was that "the district court found it unnecessary to actually decide the issue as long as it focused on whether Disney had a legal right to use the Pooh trademarks."⁴²³

Finally, the majority and Judge Reyna disagreed over whether the district court judgment necessarily required a determination of the issue of ownership. The majority viewed the district court's ownership ruling as essential to its judgment because "the district court had to determine this issue before deciding whether Disney's uses of the Winnie-the-Pooh rights were infringing."⁴²⁴ Similarly, the TTAB had to determine Slesinger's ownership rights before it could consider Slesinger's request to change the registrations to its name.⁴²⁵

417. *Id.*

418. *Id.*

419. *Id.* at 644-45 (quoting *Milne ex rel. Coyne v. Stephen Slesinger, Inc.*, No. 2:02-cv-08508, 2009 WL 3140439, at *4 (C.D. Cal. Sept. 25, 2009)).

420. *Id.* at 645 (quoting *Yamaha Corp. of Am. v. United States*, 961 F.2d 245, 254 (D.C. Cir. 1992)).

421. *Id.* at 648 (Reyna, J., dissenting).

422. *Id.*

423. *Id.*

424. *Id.* at 646 (majority opinion).

425. *Id.*

Judge Reyna did not agree. He believed that “Disney could have been authorized to use the Pooh trademarks under a license.”⁴²⁶ Thus, “ownership” and “authorized user under a license” were both rational bases to find noninfringement.⁴²⁷

CONCLUSION

Although the Federal Circuit does not routinely issue many decisions on trademark law, its opinions address important issues, particularly because the court addresses trademark registration issues that are rarely addressed by other appellate courts. And, like the Federal Circuit’s other areas of jurisdiction, its trademark decisions span the procedural gamut. Readers should keep an eye on the court’s trademark decisions in the future, as the court is sure to continue to resolve new and interesting issues.

426. *Id.* at 648 (Reyna, J., dissenting).

427. *Id.* at 649.

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