



Recent Decisions by the Trademark Trial and Appeal Board

By: **Michael C. Cannata, Esq.** • michael.cannata@rivkin.com

Board Dispatches Procedural Argument

In this case, the Board affirmed the examining attorney's refusal to register "HOUSE BEER" under Section 2(d) of the Trademark Act based upon a registration on the Supplemental Register for "House Beer." The Applicant did not challenge the merits of the Section 2(d) refusal. Rather, the Applicant claimed that a procedural error improperly resulted in the issuance, in the first instance, of the Section 2(d) refusal.

According to the Applicant, the Registrant filed an amendment to allege use and requested transfer to the Supplemental Register subsequent to Applicant's filing date. As a result, the Applicant argued that the effective filing date of the now-registered mark post-dated the Applicant's filing date and, thus, the now-registered mark could not serve as a basis for refusing the Applicant's submission under Section 2(d).

The Board concluded, however, that the refusal was proper as the governing statute, here 15 U.S.C. § 1052(d), did not make reference to filing dates as a basis for refusal and simply provides that "a mark *registered* in the Patent and Trademark Office..." can serve as a basis for a Section 2(d) refusal. In that connection, the Board held that it could not afford "the internal examining procedures of the USPTO...primacy over statutory law."

The Board concluded its analysis by affirming the conclusions of the examining attorney with respect to the merits of the Section 2(d) refusal.

In re House Beer, LLC, Serial No. 85/684,754 (T.T.A.B. March 27, 2015)

Board Affirms Section 2(d) Refusal

The Board rejected Applicant's attempt to trademark the below stylized logo in light of an existing registration for the standard character mark "BRADLEY HUGHES":



After sustaining Applicant's objection to the introduction of certain evidence, the Board conducted a comprehensive likelihood of confusion analysis under Section 2(d) of the trademark act. As a result of that analysis, the Board, in affirming the refusal to register under Section 2(d) of the Trademark Act concluded that: (1) the Applicant's goods (furniture) and Registrant's goods (residential and commercial furniture) are legally identical; (2) the factor addressing the conditions under which the goods are to be purchased was neutral; and (3) the respective marks were confusingly similar in that they both featured the surname "Hughes" as the dominant component of the marks.

In re Hughes Furniture Industries, Inc., Serial No.: 85/627,379 (T.T.A.B. March 27, 2015)

BUYAUTOPARTS.COM Deemed Generic

The Board rejected Applicant's request to register BUYAUTOPARTS.COM on the Supplemental Register on the basis that the proposed mark was generic.



After initially concluding that the recitation of services set forth in the application adequately identified the relevant genus - - the online sale of auto parts - - the Board went on to analyze the relevant public's understanding of the proposed mark. In conducting this analysis, the Board rejected Applicant's argument that the proposed mark was not generic because the word "buy," which is prominently featured in the proposed mark, stands in marked contrast to a genus of services affiliated with "selling." The Board concluded that "the buying of auto parts is a central focus of the service of offering auto parts for sale."

In support of its decision to affirm the examining attorney's finding of genericness, the Board cited relevant market place usage which demonstrated the generic nature of the proposed mark. In that connection, the Board even cited to the applicant's own generic usage of the proposed mark in the market place to support its holding.

In re Meridian Rack & Pinion DBA buyautoparts.com, Serial No.: 85/504,151 (T.T.A.B. April 21, 2015)

Board Dismisses, In Part, Nike’s Opposition To Crossfit Design Marks

The Board dismissed, in part, Nike’s opposition to Applicant’s attempt to register certain design marks featuring a silhouetted individual performing a one-handed handstand based upon Nike’s registered “Jumpman” marks.

Exemplar of Applicant’s Marks	Exemplar of “Jumpman” Marks
	

Nike alleged the following claims for relief: (1) likelihood of consumer confusion pursuant to Trademark Act Section 2(d); (2) dilution pursuant to Trademark Act Section 43(c); (3) false suggestion of a connection with Michael Jordan pursuant to Trademark Act Section 2(a); and (4) that Applicant’s marks comprise a portrait of a living individual, namely Michael Jordan, without consent pursuant to Trademark Act Section 2(c).

Applicant sought the dismissal of Nike’s likelihood of confusion and dilution claims on the basis that the marks are so dissimilar that, as a matter of law, there can be no confusion or dilution. The Board held that in this case, such a determination was not amenable to resolution as a matter of law and that Nike had sufficiently pled claims for likelihood of confusion and dilution.

The Board did dismiss, without prejudice, Nike’s claims that Applicant’s marks: (i) create the false suggestion of a connection with Michael Jordan; and (ii) comprise a portrait of a living individual without consent. With respect to the false suggestion claim, the Board concluded that Nike’s allegations did not sufficiently allege that the public would recognize Applicant’s marks as pointing to Nike or Nike’s persona. Likewise, the Board dismissed Nike’s argument that Applicant’s marks comprise a portrait of Michael Jordan without his consent on the basis that Nike’s licensing relationship with Michael Jordan did not give rise to a cognizable or proprietary right by Nike to assert such a claim under Trademark Act Section 2(c).

Nike, Inc. v. Palm Beach Crossfit Inc. d/b/a Crossfit CityPlace, Opposition No. 91218512 (September 11, 2015) (precedential)

Board Affirms Refusal To Register “Smart Series”

The Board affirmed the refusal to register Applicant’s mark, SMART SERIES, on the basis that the mark is descriptive under Trademark Act 2(e)(1).

Applicant sought registration of SMART SERIES for “[m]etal safes specifically designed to store firearms.” During the prosecution process, the examining attorney objected to the application on the basis that the mark was “merely descriptive.” On appeal, Applicant argued that even if

SMART SERIES conveys some information about Applicant's goods, that information is too vague and lacks particularity because the mark does not identify what type of technology is used or what series the goods belong to.

In rejecting this argument, the Board relied upon record evidence and the definition of "smart" and reasoned that "...consumers will readily understand from the word "smart" that Applicant's gun safes will contain automated, technological devices such as microprocessors, making them 'smart.'" The Board next considered the definition of the word "series" and concluded that "[c]onsidering the mark as a whole, the combination of the two descriptive components "smart" and "series" does not result in a mark which as a whole has a nondescriptive or incongruous meaning." Rather, with respect to SMART SERIES, the Board concluded that each component of the mark retained its descriptive significance in relation to the goods identified in the application.

In re Cannon Safe, Inc., Serial No. 85/651,960 (TTAB Sept. 24, 2015) (precedential).



Rivkin Radler LLP

926 RXR Plaza, Uniondale NY 11556

www.rivkinradler.com

© 2015 Rivkin Radler LLP. All Rights Reserved.