

Notable Trademark Trial and Appeal Board Decisions

By Pina Campagna and Michael Cannata*

(Unless noted, all decisions are precedential.)

Board Dispatches Procedural Argument

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 the 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, 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 to give "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, 114 USPQ2d 1073 (TTAB 2015).

BUYAUTOPARTS.COM Deemed Generic

The Board rejected the 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 the Applicant's argument that the proposed mark was not generic because the word "buy," which is the first or dominant portion of the

proposed mark, stands in marked contrast to a genus of services affiliated with "selling." The Board concluded that "buying 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 marketplace 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 marketplace to support its holding.

In re Meridian Rack & Pinion d/b/a BUYAUTOPARTS.COM, 114 USPQ2d 1462 (TTAB 2015).

HUGHES Marks Are Confusingly Similar

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

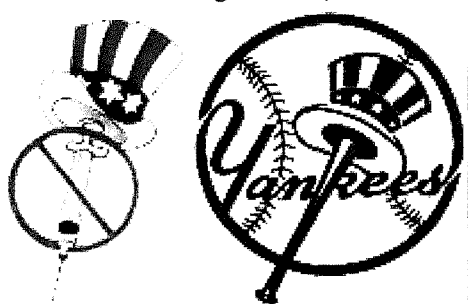


After sustaining the Applicant's objection to the introduction of certain evidence, the Board conducted a comprehensive likelihood of confusion analysis under Section 2(d) of the Trademark Act. As a result of that analysis, the Board, in affirming the refusal to register under Section 2(d) of the Trademark 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., 114 USPQ2d 1134 (TTAB 2015).

“THE HOUSE THAT JUICE BUILT” and “TOP HAT SYRINGE & Design Mark” Cause Dilution of Yankees’ Famous Top Hat Design Mark and “THE HOUSE THAT RUTH BUILT” Mark

In a precedential ruling, the Board refused to register the Applicant’s (IET Products) marks THE HOUSE THAT JUICE BUILT and a TOP HAT SYRINGE & Design mark (illustrated below) on the grounds that they would dilute the Opposer’s (Yankees) famous slogan THE HOUSE THAT RUTH BUILT and the TOP HAT BASEBALL BAT & Design mark (illustrated below).



The Applicant argued that its marks succeed as a parody precisely because they create an association with the Opposer’s marks, i.e., the marks convey that they are the original (Opposer’s marks) but that the inclusion of the representations of the syringe, the prohibition symbol, or the term JUICE simultaneously convey that they are not the original, but rather are a parody. The Applicant’s president testified that its marks “play off of the idea that steroids are a player on MLB teams and the Yankees.”

The Board rejected the Applicant’s fair use parody defense, indicating that the Applicant ignored the language of Section 43(c)(3)(A), which limits the “fair use” exclusion as defined in the statute to use of a famous mark “other than as a designation of source for the person’s own goods or services.” The Board stated that since the Applicant applied to register its trademarks as designations of the source of the Applicant’s own goods, then the parody defense is not applicable here.

Based on the evidence of record of fame of the marks, including the Applicant’s own admissions that the Opposer’s marks were famous, the Board found the Applicant’s marks likely to dilute the distinctive quality of the Opposer’s marks and sustained the opposition.

New York Yankees Partnership v. IET Products and Services, Inc., 114 USPQ2d 1497 (TTAB 2015).

Deer Logo with Phantom Antlers Rejection Affirmed by the Board on Four Grounds

Applicant Bar NND Ranches, LLC sought to register the design mark reproduced below for coffee and coffee-

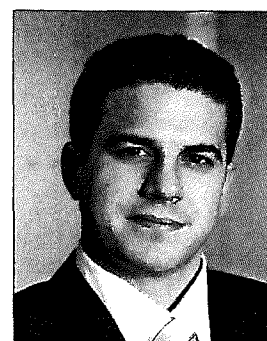
based beverages. The Applicant appealed the Examining Attorney’s refusal which was based on four related grounds: (1) the application seeks to register more than one mark because the antlers in dashed lines represent a changeable or phantom element in violation of Sections 1 and 45 of the Trademark Act; (2) the Applicant’s drawing is unacceptable under Section 1(a) (1); (3) the description of the mark is unacceptable; and (4) the mark on the specimen does not match the drawing as required by Sections 1 and 45.



The Applicant admitted in its brief that it places different antler configurations above the deer to describe particular qualities for each particular coffee product sold, i.e., more tips for bolder coffee. The Board found that the Applicant was impermissibly seeking to register more than one mark because the antlers shown in broken lines constitute a changeable, phantom element of the mark, despite the Applicant’s argument that the antlers do not constitute an “integral portion” of the mark as required to support the “phantom element” claim. For the same reasons, the Board found that the specimen which depicted a deer with very large antlers did not show use of the mark in the drawing. Based on these conclusions, the Board also found that the drawing and description of the mark were unacceptable and affirmed refusals on all grounds.

In re Bar NND Ranches, LLC, Serial No. 77928601 (July 28, 2015) [not precedential].

(Endnote)



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