

The Top Ten TTAB Decisions of 2009-2010

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During the July 2009 to June 2010 time period, the most significant decision for TTAB practitioners came not from the Trademark Trial and Appeal Board but from the U.S. Court of Appeals for the Federal Circuit. In *In re Bose Corporation*, 91 U.S.P.Q.2d 1938 (Fed. Cir. 2009), the appellate court discarded the “knew or should have known” standard for fraud set out by the TTAB in *Medinol Ltd. v. Neuro Vasx, Inc.*, 67 U.S.P.Q.2d 1205 (TTAB 2003), ruling that “[b]y equating ‘should have known’ with a subjective intent,” the board had “erroneously lowered the fraud standard to a simple negligence standard.” *Bose* swept aside the board’s still-developing fraud jurisprudence and left practitioners facing a rather barren landscape that the board has slowly begun to repopulate.

The *Bose* decision brought an abrupt end to the reign of *Medinol*, when fraud was a favored avenue of attack in TTAB inter partes proceedings. Under *Medinol*, once a party

discovered that the other side had filed its use-based application, or maintained its registration, for a mark that was not in use for all the listed goods or services, summary judgment for fraud was a near certainty. The attacking party did not have to prove that its adversary intended to deceive the U.S. Patent and Trademark Office (USPTO), but only that the adversary “knew or should have known” that its statement regarding use was false. All that changed with *Bose*.

In light of *Bose*, clear and convincing evidence of deceptive intent is required to prove fraud; but because “direct evidence of deceptive intent is rarely available” in most cases “indirect and circumstantial evidence” will have to fill the bill. The CAFC stated in *Bose* that “there is no fraud if a false misrepresentation is occasioned by an honest misunderstanding or inadvertence without a willful intent to deceive.” 91 U.S.P.Q.2d at 1942. But how much inadvertence is too much? And what types of misunderstandings are excusable? In *Bose*, the court indicated that even gross negligence is not enough for fraud, but it left open the question of whether reckless disregard for the truth will suffice. So what is the fraud new standard? The board, as of this writing, has yet to find fraud in a post-*Bose* decision. While it has ruled on several procedural issues involving fraud, many basic substantive questions remain unanswered.

Meanwhile, the TTAB rendered important decisions in several other areas. For the first time in seven years, the board sustained a dilution claim, and in another case it ruled that the defense of noncommercial use is not available against a claim of dilution. It confirmed that U.S. trademark law does not recognize the “well known mark” or “famous foreign mark” doctrine as a basis for preventing registration by another, but nonetheless held that the fame of a foreign mark in this country may support a dilution claim. Applying Trademark Rule 2.107(b), the board rejected an opposer’s attempt to amend its opposition to a Madrid-based section 66(a) application. In what may be a portentous development, the board side-stepped the *Gould* and *American Fertility* tests in finding ELECTRIC CANDLE COMPANY generic. And in the procedural realm, it issued two significant rulings concerning submission of pleaded registrations and Internet evidence, and several decisions emphasizing the importance that the TTAB places on its new discovery conference and disclosure regime.

These and other developments will be discussed below in this wholly subjective selection of ten of the more important and/or interesting board decisions during the aforementioned 12-month period.

I. NATIONAL PORK BOARD AND NATIONAL PORK PRODUCTS COUNCIL V. SUPREME LOBSTER AND SEAFOOD COMPANY, OPPOSITION NO. 91166701 (JUNE 11, 2010) [PRECEDENTIAL]

Not since Hector was a pup has the TTAB sustained a dilution claim. In fact, the board had upheld only one (*Nasdaq Stock Market Inc. v. Antartica S.r.l.*, 69 U.S.P.Q.2d 1718 (TTAB 2003)) since dilution became available as a ground for opposition and cancellation in 1999. But the board found the mark THE OTHER RED MEAT for “fresh and frozen salmon” to be dilutive of the registered mark THE OTHER WHITE MEAT for “association services namely, promoting the interests of members of the pork industry.” A “well-designed” telephone survey demonstrated an association between the marks, and played a crucial role in the board’s decision.

TTAB sustains dilution claim for first time in seven years.

In its 59-page opinion, the board addressed in some detail the elements of a Lanham Act section 43(c) dilution claim: (1) whether the opposers’ mark is famous: (2) whether it became famous prior to the applicant’s filing date (i.e., its constructive first use date); and (3) whether Applicant’s mark is likely to blur the distinctiveness of opposers’ famous mark. *Nat’l Pork Board*, at 51.

Fame. Advertising expenditures, tracking studies, consumer surveys, and media references convinced the board that THE OTHER WHITE MEAT is famous. “It is among the most well-know advertising slogans in the U.S. given awareness rates of eighty to eighty-five percent of the general adult population and rates of correct source recognition at nearly seventy percent of the population.”

Famous When. The board also concluded that the fame of THE OTHER WHITE MEAT “was well-established prior to the date that Supreme Lobster and Seafood Company filed the involved application.” *Id.* at 52.

Blurring. The board then turned to the nonexclusive factors set out in section 43(c)(2)(B). Beginning with the similarity between the marks, it found that this factor favored the opposers, noting that the survey evidence “shows that more than thirty-five percent of the survey respondents associate applicant’s slogan with opposers’ slogan (or with the pork being promoted by the mark) in an unaided survey response. This degree of association demonstrates that a sizeable segment of the target population sees the two marks as similar.” *Id.* at 54.

Because the opposers' mark is registered, it is entitled to a presumption of inherent distinctiveness. Moreover, the mark is merely suggestive of "a healthy attribute of the commodity being promoted by the pork industry, namely, the color of some cuts of pork after being cooked." The board found the mark to be inherently distinctive, and this factor weighed in the opposers' favor.

The opposers' use of the mark is "virtually exclusive," which again supports a finding of dilution by blurring.

Voluminous evidence established the wide recognition of the opposers' mark and led the board to conclude that "THE OTHER WHITE MEAT, has become part of the fabric of popular culture in the United States." *Id.* at 56. This also supports "the conclusion that dilution by blurring is likely upon the introduction of applicant's slogan into the marketplace." *Id.*

As to the applicant's intent, the board was "reluctant to conclude bad faith on the part of applicant," *Id.* at 58, (which is not required anyway), but it did find that the "applicant's principals may have believed it was permissible for applicant to create such an association," *Id.*, and so the board concluded that this factor favored the opposers.

Finally, as to actual association between the applicant's mark and the opposers' mark, the board noted that the applicant has not yet used its mark, and so "this statutory factor ... is neutral but consistent with a likelihood of dilution by blurring." *Id.*

The board therefore found dilution by blurring likely and it sustained the opposition on that ground, declining to reach the opposers' likelihood of confusion claim.

II. MECKATZER LÖWENBRÄU BENEDIKT WERB KG V. WHITE GOLD, LLC, 95 U.S.P.Q.2D 1185 (TTAB 2010) [PRECEDENTIAL]

Petitioner Löwenbräu's fraud claim alleged that, according to its investigation, Respondent White Gold, at the time of filing its statements of use, was using its marks only on vodka and not on all the goods listed in its two registrations. Furthermore, Löwenbräu alleged that the respondent (but not that any particular individual) had the requisite intent to deceive the USPTO. The board found those allegations to be sufficiently specific and particular to satisfy Federal Rule of Civil

Procedure 9(b), and it denied White Gold's motion to dismiss.

The respondent (a Russian company) received registrations in 2008 for its mark WHITE GOLD in standard character and design form, for some 30 alcoholic products, including vodka. The petitioner alleged “[u]pon information and belief, and upon the results of the investigation” that: (1) at the time it filed Statements of Use in connection with the applications that matured into Registrations, Respondent's marks “were not in use in connection with all of the goods referenced in the Statements of Use;” and that (2) “Respondent knowingly made false, material misrepresentations of fact in procuring the Registrations with the intent to defraud the U.S.P.T.O.” because “Respondent knew that [its involved marks] were not in use in connection with all of the goods referenced in the Statements of Use at the time the Statements of Use were filed” *Löwenbräu*, at 3.

White Gold moved to dismiss, contending that *Löwenbräu* did not allege sufficient facts for the board to “reasonably infer that a specific individual knew of the withheld material information or of the falsity of the material misrepresentation, and withheld or misrepresented this information with a specific intent to deceive the PTO.” It further argued that, in any case, it was entitled to registrations covering vodka. (Apparently, White Gold did not argue that it had used the marks on anything other than vodka.) *Id.* at 6.

The board denied the motion. Although allegations of fraud made on mere “information and belief,” without more, do not satisfy the particularity requirements of Federal Rule of Civil Procedure 9(b) (*see Asian and Western Classics B.V. v. Lynne Selkow*, 92 U.S.P.Q.2d 1478 (TTAB 2009) [precedential]), *Löwenbräu*'s allegations were based not just on “information and belief,” but on a factual investigation. Moreover, *Löwenbräu* properly pleaded that “Respondent knowingly made false, material misrepresentations of fact in procuring the Registrations with the intent to defraud the U.S.P.T.O.” *Id.*

Allegations of fraud need not name particular individual involved.

The board further pointed out that “the question is not whether petitioner has alleged that a nonparty ‘specific individual’ had the requisite intent, but rather whether petitioner has alleged with particularity that respondent, the defendant and owner of the subject Registrations, had the requisite intent.”

We do not read *In re Bose* as requiring that a party identify a “specific individual” who “knew of the withheld material information or of the falsity of the material misrepresentation, and withheld or misrepre-

sented this information with a specific intent to deceive the PTO,” as respondent argues.

Id. at 6-7.

As to the respondent’s assertion regarding keeping its registrations, but only for vodka, the board observed that “*In re Bose* did not change the consequences of fraud, when it is proved. A finding of fraud with respect to a particular class of goods or services renders any resulting registration void as to that class.” *Id.* at 7.

Although, as noted above, the board has yet to find fraud in a post-*Bose* case, this one seems like a very good candidate.

III. FIAT GROUP AUTOS S.P.A V. ISM, INC., 94 U.S.P.Q.2D 1111 (TTAB 2010) [PRECEDENTIAL]

In this case of first impression, the board ruled that a foreign trademark owner who has filed an ITU application may rely on the fame of its mark in the United States to support a dilution claim in an opposition. This is true despite the fact that the TTAB does not recognize the “well known mark” or “famous foreign mark” doctrine as a basis for preventing registration by another. *See e.g., Bayer Consumer Care AG v Belmora LLC*, 90 U.S.P.Q.2d 1587 (TTAB 2009). (For prior discussion regarding the “famous foreign mark” doctrine, *see* 2008 IP Book at 111-113, 2007 IP Book at 95-99, 2005 IP Book at 90-99.)

Fiat opposed registration of the mark PANDA for automobiles, asserting dilution of Fiat’s “internationally famous” marks FIAT PANDA and PANDA. The applicant moved to dismiss, arguing that Fiat “has no reasonable basis for damage in the absence of an allegation of ‘continuing prior use of any form of ‘Panda’ in the United States.’” *Fiat Group Autos S.P.A.*, at 1112.

The board turned to the requirements of the Trademark Dilution Revision Act (section 43(c)), which affords certain relief to the “owner of a famous mark.” The TDRA does not define the term “mark,” and so the board looked to section 45 of the Act for its meaning of “mark.”

Utilizing the statutory definition of “mark” to infuse our understanding of “famous mark” as referenced in the TDRA leaves no doubt that any reference in that act to a “famous mark” is a reference to a mark in use in the United States, or for which there is an intent to use the

mark in the United States coupled with an application for registration.

Id. at 1114.

The board concluded that it must “at least recognize the possibility that, in an unusual case, activity outside the United States related to a mark could potentially result in the mark becoming well-known within the United States, even without any form of activity in the United States.” *Id.* at 1115.

Foreign fame may support section 43(c) dilution claim.

Therefore, while Section 43(c) provides a dilution cause of action for the protection of famous unregistered marks, it does not provide a cause of action for famous unregistered marks not in use, in some way, in the United States, in the absence of a specific pleading of intent to use, the filing of an application for registration, and some basis for concluding that recognition of the mark in the United States is sufficiently widespread as to create an association of the mark with particular products or services, even if the source of the same is anonymous and even if the products or services are not available in the United States.

Id.

The board then ruled that Fiat had not properly pleaded a dilution claim because it did not allege “any particular type of use or specific facts which could be proved at trial as demonstrating widespread recognition of its mark in the United States.” *Id.* Fiat was given 30 days to replead its dilution claim.

IV. AMERICAN EXPRESS MKTG. & DEVPT. CORP. V. GILAD DEVPT. CORP., 94 U.S.P.Q.2D 1294 (TTAB 2010) [PRECEDENTIAL]

In this consolidated opposition to registration of two marks – GRAND AMERICAN EXPRESS in standard character and logo form – for “transportation services, namely, transporting passengers by means of a nineteenth century replica train,” the parties filed cross-motions for summary judgment. American Express claimed likelihood of confusion with and likely dilution of its family of AMERICAN EXPRESS marks. Applicant Gilad moved to add the affirmative defense of “noncommercial use” with regard to the dilution claim, and moved for summary judgment on that defense.

Gilad contended that it chose its marks as an allusion to an 1855 lithograph by Currier and Ives titled American “Express” Train and the nineteenth century

history and era it evokes. Therefore, according to the applicant, its marks, “in addition to their intended service mark usage, serve as a form of artistic expression.”

The board considered the only significant question on the motion to amend to be whether the amendment would be futile. Gilad urged that the TDRA expressly includes “noncommercial use” as a defense to a dilution claim. American Express maintained that the defense is unavailable in a board proceeding, where only registrability is at issue and not whether Applicant Gilad has the right to use its mark. Gilad countered by arguing that there is no reason why use of a mark cannot be both “use in commerce” for purposes of registrability and “noncommercial” for dilution purposes.

The board observed that “the applicability of the ‘noncommercial use’ exception as an affirmative defense to a dilution claim is an issue of first impression before the board.” *American Express Marketing*, at 1298. It concluded that the defense is not available.

First, the board reasoned, the definition of “service mark” precludes the applicability of the “noncommercial use” defense in a board proceeding. In order to obtain registration, Applicant Gilad is required to demonstrate use of its marks in commerce as service marks, and thus cannot claim that the use is noncommercial.

Second, the board agreed with Professor McCarthy that the mere use of another’s famous mark as a mark for its own goods or services, whether commercial or not, disqualifies the applicant from invoking the “noncommercial use” exception.

Moreover, even if the “noncommercial use” exception were available here, the applicant’s use or intended use of its marks would not qualify as noncommercial. “‘Noncommercial use’ has been referred to as constitutionally protected speech that consists of parody, satire, editorial and other forms of expression that are not part of a commercial transaction.” *Id.* at 1299. The applicant’s use does not fall into any of those categories.

And so the board denied the applicant’s motion for leave to amend on the ground that the amendment would be futile.

The board then wasted little time in denying American Express’s summary judgment motion. As to the section 2(d) claim, it found that genuine issues of material fact exist as to the similarity between the marks and the relatedness of the goods. As to the dilution claim, disputed factual issues involve “whether the marks

evoke similar commercial impressions so that registration of applicant's marks would impair the alleged distinctiveness of opposer's pleaded marks." *Id.* at 1299.

**V. O.C. SEACRETS, INC. V. HOTELPLAN ITALIA S.p.A,
95 U.S.P.Q.2D 1327 (TTAB 2010) [PRECEDENTIAL]**

Opposer O.C. Seacrets sought to amend its notice of opposition to add a new ground (lack of bona fide intent), but it ran into one big problem: the opposed application was a section 66(a) Madrid request for extension of protection and Trademark Rule 2.107(b) prohibits such an amendment in an opposition to a Section 66(a) application. The opposer claimed that it was merely clarifying an existing ground, not adding a new ground, but the board disagreed and it denied the motion to amend.

The opposer's notice of opposition alleged, in pertinent part, that "Applicant lacks a bona fide intent to use SECRETS LINE ... and therefore, has committed fraud on the U.S. Patent and Trademark Office." *O.C. Seacrets, Inc.*, at 4. Its proposed amendment would replace that allegation with this: "In violation of 15 U.S.C. 1141(f). Applicant lacked a bona fide intent to use SECRETS LINE ... (for certain goods and services in the opposed application)." *Id.*

Opposition to Madrid-based application may not be amended to add new ground.

The opposer argued that the claim that the applicant lacked a bona fide intent was an element of its original fraud claim, and that the proposed amendment is therefore a permissible clarification of an existing ground. The board found that argument unpersuasive:

Although the particular basis for opposer's claim of fraud in this case was the allegation that applicant falsely stated it had a bona fide intent to use its mark on all of its identified goods and services, applicant was apprised of only one ground by Paragraph 13 of the original notice of opposition, that of fraud. Fraud was the ground that applicant defended against in its motion for judgment on the pleadings, and the ground upon which judgment for applicant was entered by the Board in its April 2, 2010 order. We will not parse an asserted ground to see if any of the elements that go to pleading that ground would independently state a separate ground.

Id. at 6. And so the board denied the motion to amend as violative of Trademark Rule 2.107(b).

Note that the applicant had moved for judgment on the pleadings as to the opposer's original fraud claim on the ground that it was inadequately pleaded under *Bose*. The opposer did not contest the motion, apparently recognizing that its fraud claim was dead in the water, but instead filed a combined motion to amend the opposition to assert the bona fide intent claim, and for summary judgment on that new claim. The board's denial of the motion to amend, of course, rendered the summary judgment motion moot.

VI. *IN RE WM. B. COLEMAN CO.*, 93 U.S.P.Q.2D 2019 (TTAB 2010) [PRECEDENTIAL]

In a decision that may signal the arrival of a more realistic interpretation of the law of genericness, one that is not hamstrung by the current, impractical CAFC precedent, the board found the term ELECTRIC CANDLE COMPANY to be generic for "light bulbs; lighting accessories, namely, candle sleeves; lighting fixtures." In addition to genericness, the board also found the phrase to be "incapable of identifying source for electric candles" under section 23 of the Trademark Act.

In refusing registration, the examining attorney relied on excerpts from the applicant's website, on third-party websites, and on dictionary definitions, to show that the term "electric candle" is generic. In fact, "electric candle" is an entry in the Trademark Manual of Acceptable Identifications of Goods and Services. He applied both the "compound word" approach of *In re Gould Paper Corp.*, 5 U.S.P.Q.2d 1110 (Fed. Cir. 1987), and the "phrase" approach of *In re American Fertility Society*, 51 U.S.P.Q.2d 1832 (Fed. Cir. 1999), maintaining that under *Gould*, electric candle is a unitary generic term and the addition of 'company' creates a compound term," and that under *American Fertility*, the phrase is generic pursuant to *In re Cell Therapeutics*, 67 U.S.P.Q.2d 1795 (TTAB 2003) (CELL THERAPEUTICS generic for pharmaceuticals). The applicant argued that ELECTRIC CANDLE COMPANY is not a compound term and therefore that *Gould* is inapplicable, and further that there are no examples of third-party use of the entire phrase, thus requiring reversal under *American Fertility*.

The board observed that the dispute "centers on the effect of the addition of the word 'company' to the term 'electric candle' and the standard to be applied in analyzing the evidence." *In re Wm. B. Coleman Co.*, at 14. Under its creative reading of the two cases, the board found ELECTRIC CANDLE COMPANY to be generic under both *Gould* and *American Fertility*.

*Sidestepping
CAFC precedent,
TTAB gets tough
on genericness.*

As to *Gould*:

The record shows that “electric candle” is a unitary generic term. *** The space between the generic terms “electric candle” and “company” does not disqualify this type of proposed mark from the *Gould* analysis. If anything, the terms appearing as they should in normal usage make it even more common. There is no logical basis upon which to conclude that *Gould* would have yielded a different result if the mark had been SCREEN WIPE rather than SCREENWIPE. Therefore, the *Gould* analysis applies under these circumstances.

Id. at 15. As for *American Fertility*:

In *American Fertility*, the Court of Appeals for the Federal Circuit (Court) determined that the USPTO did not satisfy its “burden of showing that the phrase SOCIETY FOR REPRODUCTIVE MEDICINE is generic as applied to the Society’s’ services, namely, promoting the interests of the reproductive medicine profession.” *American Fertility*, 51 U.S.P.Q.2d at 1836. However, we do not believe that *American Fertility* can be read such that an applicant could take a clearly generic term and add to it a non-source identifying word such as “company” and thereby create a trademark. This is true even in the absence of proof by the examining attorney that others have used “electric candle company.”

Id. at 15-16.

Finally, dealing with the applicant’s contention that ELECTRIC CANDLE COMPANY is not the term that consumers would use to describe the genus, the board ruled that “the relevant public would nonetheless understand ELECTRIC CANDLE COMPANY to refer to a company that offers electric candles, and public understanding is critical. *1800Mattress.com*, 92 U.S.P.Q.2d at 1685. It is, therefore, incapable of identifying source for electric candles because it is a term a purchaser would understand and could use to refer to the type of company that sells electric candles, and must be left available for use by other such companies selling electric candles.” *Id.* at 20.

As has been found in other cases, marks may not equate to the literal name of the goods or services for which registration is sought, but still be deemed to be “generic” or otherwise incapable of attaining source significance and thus unregistrable, even on the Supplemental register. See *In re Boston Beer Co. Ltd. Partnership*, 47 U.S.P.Q.2d 1914 (TTAB 1998), *aff’d*, 198 F.3d 1370, 53 U.S.P.Q.2d 1056 (Fed. Cir. 1999) (The Best Beer in America, although not the generic name

of the goods, is such a commonly used laudatory phrase that it is incapable of registration as a trademark).

Id. at 20-21.

VII. CITIGROUP INC. V. CAPITAL CITY BANK GROUP, INC., 94 U.S.P.Q.2D 1645 (TTAB 2010)

One can learn a whole lot about trademark law by reading this 68-page opinion covering myriad issues concerning Trademark Act section 2(d) likelihood of confusion and Trademark Act section 43(c) dilution. Citigroup opposed registration of the marks CAPITAL CITY BANK, CAPITAL CITY BANK INVESTMENTS, CAPITAL CITY BANK GROWING BUSINESS, and CAPITAL CITY BANK INVESTMENTS for banking and financial services, in view of the registered mark CITIBANK and variations thereof for banking services. The board dismissed the opposition, finding no likelihood of confusion or dilution primarily in view of the differences in commercial impression engendered by the parties' marks.

Fame as of When. The board began with a discussion of Citigroup's burden of proof in establishing when the CITIBANK mark became famous for dilution purposes. Normally, in opposing an ITU application on dilution grounds, an opposer must show that fame was acquired before the filing date of the application. Here, however, each of the applicant's three ITU applications include the term CAPITAL CITY BANK (the fourth applied-for mark), and so the board concluded that Citigroup must show that its mark became famous prior to the first use date of that use-based application.

Morehouse Defense. The applicant claimed that Citigroup could not be harmed by registration of the applied-for marks because the applicant already owns three registrations for marks containing the term "Capital City Bank." As usual, this defense failed because the marks of the prior registrations and the recited services are not "essentially the same" as the applied-for, standard character marks at issue here.

The Opposer's Family of Marks. Here, the question was whether Citigroup established a family of marks prior to the applicant's first use date. The board found that the applicant may rely on its use of the mark CAPITAL CITY BANK GROUP to establish priority, and that its first use date was 1975. Citibank did not address this issue in its brief, and its evidence failed to establish an earlier date

for its family of marks. Thus the family of marks doctrine was unavailable to Citigroup.

Likelihood of Confusion. Citigroup presented overwhelming evidence that CITIBANK is a famous mark for section 2(d) purposes. The board then found the services involved to be, at least in part, identical as to each opposed application. As a result, the board presumed that the channels of trade and classes of customers are the same. Next, the board found the lack of actual confusion to be a factor weighing in favor of the applicant, since there had been ample opportunity for confusion to arise.

The key issue was the similarity or dissimilarity of the marks. The board found the applicant's marks not similar to Citigroup's marks:

Since the commercial impression of applicant's marks is the geographic designation CAPITAL CITY and the generic term "Bank," applicant's marks are not similar in appearance, sound or meaning with opposer's CITIBANK marks. The absence of any reported instances of actual confusion lends credence to this finding because, considering the widespread advertising of opposer's marks and the identity of the services, if the marks were similar then it is likely that there would be some reported instances of confusion or mistake as to source such as misdirected telephone calls, visits, or requests for information, or other indicia of confusion in the marketplace.

99 U.S.P.Q.2d at 1664. Balancing all the factors, the board concluded that the "significant differences" between the marks outweigh the fame of the CITIBANK marks.

Dilution by Blurring. Based on the record, the board found that the CITIBANK marks became famous in 1983, after the applicant's first use of the CAPITAL CITY BANK mark. Therefore Citigroup's dilution claim failed for that reason alone. Moreover, the board reviewed the statutory dilution factors and found no likelihood of dilution:

We have found that the marks are not substantially similar, that there are numerous third-party users of the term "City Bank," that there is no evidence demonstrating any association between the parties' marks, and that there is no evidence that applicant [sic] intended to create an association with opposer's marks outweigh the fame and distinctiveness of the CITIBANK marks.

Id. at 1668-69.

VIII. SAFER, INC. V. OMS INVESTMENTS, INC., 94 U.S.P.Q.2D 1031 (TTAB 2009) [PRECEDENTIAL]

In a significant new interpretation of Trademark Rule 2.122(e), the board held that “*if a document obtained from the Internet identifies its date of publication or date that it was accessed and printed, and its source (e.g., the URL), it may be admitted into evidence pursuant to notice of reliance in the same manner as a printed publication in general circulation.*” [emphasis in original]. *Id.* at 1039.

Under Trademark Rule 2.122(e), “[p]rinted publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public,” 37 C.F.R. § 2.122(c), may be introduced into evidence by way of notice of reliance. In other words, they are self-authenticating.

Opposer Safer proffered, in its notice of reliance, certain publications obtained from the Internet. The board, acknowledging its obligation to “recognize and adapt to changes in technology, particularly the prevalence of the Internet,” deemed these publications admissible.

The board observed that its decision broadens

the types of documents that may be introduced by notice of reliance to include not only printed publications in general circulation, but also documents such as websites, advertising, business publications, annual reports, studies or reports prepared for or by a party or non-party, if, and only if, they can be obtained through the Internet as publicly available documents.

94 U.S.P.Q.2d at 1039. Of course these downloaded documents are admissible for the limited purpose of demonstrating what the documents show on their face; they are not admissible to prove the truth of the statements contained therein.

Furthermore, the board noted that “the party proffering information obtained through the Internet, runs the risk that the website owner may change the information contained therein. However, any relevant or significant change to the information submitted by one party is a matter for rebuttal by the opposing party.” *Id.*

Practitioners will welcome this change because it will eliminate the formalistic step of authenticating Internet documents by witness testimony (or by declaration in non-trial situations), and it should save both the board and practitioners considerable time and expense (not to mention the time of paralegals and legal

*Board deems
Internet
documents
to be self-
authenticating
and admissible
via notice of
reliance.*

assistants who no longer have to testify about when and how they downloaded documents).

IX. RESEARCH IN MOTION LIMITED V. NBOR CORPORATION, 92 U.S.P.Q.2D 1926 (TTAB 2009) [PRECEDENTIAL]

Trademark Rule 2.122(d)(1) permits the introduction of a pleaded registration into evidence if the original opposition or petition for cancellation is accompanied by TARR printouts showing the status and title of the registration. But what about introduction at the trial stage? Rule 2.122(d)(2), seems to preclude the use of mere TARR printouts. Not so, said the board. TARR printouts are acceptable at trial.

Applicant NBOR sought to register the mark BLACK MAIL for “computer software for facilitating interactive communication, namely, chat, electronic mail, voice, instant messages, text transfer, multi-media transfer, live collaboration, motion pictures, and sound over a global computer information network and other networks.” RIM opposed on the ground of likelihood of confusion with its registered BLACKBERRY marks for a variety of goods and services in the wireless telecommunications field. RIM also contended that NBOR lacked a bona fide intent to use its mark in commerce when the opposed application was filed.

NBOR raised several evidentiary objections, the most interesting being its attack on RIM’s registration evidence. RIM submitted its registrations in the form of TARR printouts as part of its notice of reliance, and NBOR argued that this violated the Trademark Rules. The board, however, concluded that the 2007 amendment of Rule 2.121(d)(1) to allow TARR printouts with the original pleading “can only be taken as an indication that the office meant to liberalize the means for providing a pleaded registration.” 92 U.S.P.Q.2d at 1928. Therefore, the board decided that this same liberalization should apply at the trial stage, despite the wording of Rule 2.122(d)(2). (Note that this liberalization applies only to proceedings commenced on or after August 31, 2007.)

*TARR printouts
acceptable
as proof of
registration at
trial stage.*

Turning to the issue of bona fide intent, RIM “met its burden . . . by showing that applicant has no documentary evidence regarding such intent.” *See Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1503, 1507 (TTAB 1993). Moreover, in its discovery responses NBOR indicated that its mark has not been used; that there are no plans as to how the mark may be used; and that there is no projected date of first use, no consideration of channels of trade,

no determination as to classes of customers or geographic areas of sales, no market studies, and no plan for growth or expansion.

NBOR's mere statement that it intended to use the mark, and its denial of a lack of bona fide intent, was outweighed by the lack of objective evidence.

Finally, the board noted that NBOR had twice previously filed applications to use the mark BLACK MAIL, and in each case the application went abandoned for failure to file a statement of use. The legislative history of the Trademark Law Revision Act discusses bona fide intent, and gives examples of circumstances that "may cast some doubt on the bona fide nature of the intent or even disprove it entirely." *Id.* at 1931. One example is the filing of numerous intent-to-use applications to replace applications that have lapsed because no timely statement of use was filed. The board found that NBOR's history of filing and abandoning successive applications also supported the conclusion that NBOR lacked the requisite bona fide intent.

And so the board sustained the opposition on this ground, declining to reach the issue of likelihood of confusion.

X. *PROMGIRL, INC. V. JPC CO., LTD.*, 94 U.S.P.Q.2D 1759 (TTAB 2009) [PRECEDENTIAL]

One of the cornerstones of the TTAB's 2007 rule changes is the requirement of Rule 2.120 that the parties hold a discovery conference at the outset of each inter partes proceeding. The board takes that requirement seriously, as demonstrated by its ruling in this precedential decision.

Opposer Promgirl, Inc. filed a motion for sanctions or, alternatively, for an order compelling Applicant JPC to participate in a Rule 2.120 discovery conference. The parties had exchanged some e-mails regarding settlement, but the applicant refused to cooperate when the opposer sought to hold the required conference.

The board made the observation that, even though the parties discussed settlement, they did not address all the issues outlined in Federal Rule of Civil Procedure 26 and in the board's institution order:

As the institution order makes clear, the parties are **required** to discuss their plans relating to disclosures, discovery, and trial evidence **unless** they are successful in settling the case. This includes discussion of the possibility of utilizing the Board's Accelerated Case Resolution

(“ACR”) procedure (see information posted at the Board’s website, at <http://www.uspto.gov/trademarks/process/appeal/index.jsp>), possible modification of the Board’s standard protective order, limitations on disclosures or discovery, the willingness of the parties to enter into stipulations of fact, and the willingness of the parties to enter into stipulations to utilize efficiencies for the introduction of evidence at trial, all as explained in the Board’s standard institution order. (slip op. at 7) [emphasis in original].

TTAB takes conference and disclosure rules seriously.

94 U.S.P.Q.2d at 1761-62. The board pointed out that the parties have a mutual obligation to hold the discovery conference. Here, the applicant made “no overture of its own to schedule a conference ... and failed to cooperate in the scheduling of a conference.” On the other hand, the “opposer is not without blame.” According to the board, Promgirl should have made an earlier attempt to schedule a conference and should have followed up earlier with regard to its settlement proposal. Moreover, either party could have requested board participation in the discovery conference, under Rule 2.120(a)(2).

Therefore, the board denied the opposer’s request for sanctions and ordered that the parties hold a discovery conference with board participation. (One might argue that if the board really wanted the discovery conference requirement to be taken seriously, it should have issued a stronger sanction against the applicant.)

The TTAB also has little patience for parties who fail to comply with its disclosure rules (the majority of which are effective for proceedings commenced on or after November 1, 2007) that require the timely exchange of information regarding the existence of and location of witnesses and documents, and the timely identification of trial exhibits and witnesses.

For example, in *Dating DNA, LLC v. Imagini Holdings, Ltd.*, 94 U.S.P.Q.2d 1889 (TTAB 2010), the board refused to excuse Dating DNA’s failure to comply with Rule 2.120(a)(3), which states that a party “must make its initial disclosures prior to seeking discovery,” and so the board declined to compel Imagini to respond to Dating DNA’s discovery requests. Note, however, that a party who seeks to invoke that rule as an excuse for not responding to its adversary’s discovery must state its objection specifically. *Amazon Technologies, Inc. v. Jeffrey S. Wax*, 93 U.S.P.Q.2d 1702 (TTAB 2009).

A party who ignores the rules for pretrial disclosure will receive similarly unsympathetic treatment from the board. In *Jules Jurgensen/Rhapsody, Inc. v.*

Peter Baumberger, 91 U.S.P.Q.2d 1443 (TTAB 2009), Petitioner Jules Jurgensen ran afoul of Trademark Rule 2.121(e), which requires that a party identify, no later than 15 days before the opening of its testimony period, each witness “from whom it intends to take testimony, or may take testimony if the need arises.” Consequently, the board struck the trial testimony of its president.

The lesson to be learned from these cases is simple. Pay attention to the Trademark Rules. The board does.

During the coming year, trademark practitioners may look forward to important developments in the fraud area, as the board sets out to reconstruct its dismantled jurisprudence. Challenges to an applicant’s or registrant’s bona fide intent will likely increase, bringing some clarity to the parameters of that doctrine. And the interpretation and application of the board’s rules will undoubtedly continue to be a focus of our attention. What other areas will spark our interest? We will have to wait and see. But one thing is for sure: we won’t have *Medinol* to kick around any more.