

Decisions of the Trademark Trial and Appeal Board and Federal Courts on Registrability Issues 2008-2009

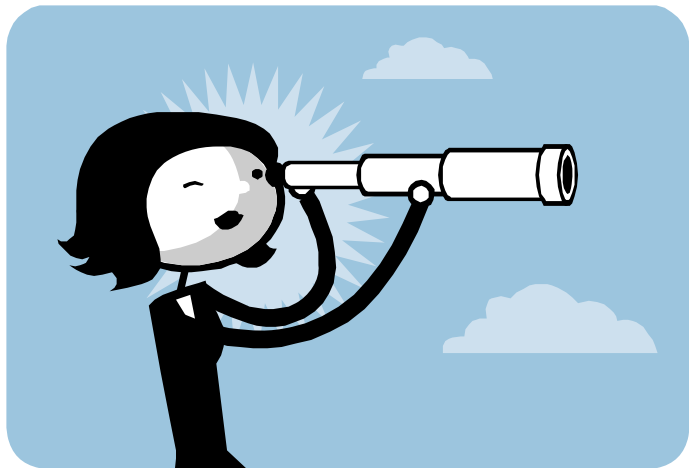
Jordan S. Weinstein

Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, Virginia, USA
703.413.3000
jweinstein@oblon.com



INTERNATIONAL TRADEMARK ASSOCIATION

Where was the Federal Circuit?



Laches

Pro-Football Inc. v. Harjo,
87 USPQ2d 1891 (D.D.C. 2008)



Pro-Football Inc. v. Harjo, 87 USPQ2d 1891 (D.D.C. 2008)

- Does a delay of 7 years 9 months constitute laches, bar claim?
 - Yes.
 - Petitioner had actual notice and constructive notice
 - Delay was undue
 - Defendant suffered trial, economic prejudice

TRADEMARK TRIAL AND APPEAL BOARD



Descriptiveness

In re Tea and Sympathy Inc.,
88 USPQ2d 1062 (TTAB 2008)

Affordable Intergrated Organic Medicine

THE FARMACY™

Fine Herbs Rare Flowers

Pharmacist On Staff Herbalist

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MEDICAL DR. REFERRALS AVAILABLE

In re Tea and Sympathy Inc.,
88 USPQ2d 1062 (TTAB 2008)

- Is THE FARMACY primarily merely descriptive?
 - No.
 - Dual meaning
 - Play on “pharmacy” and the “farm”

In re BetaBatt Inc.,
89 USPQ2d 1152 (TTAB 2008)

- Is DEC merely descriptive of nuclear decay process batteries?
 - Yes.
 - DEC = “direct energy conversion”
 - First user of merely descriptive term

In re Tokutake Industry Co.,
87 USPQ2d 1697 (TTAB 2008)

あゆみ

A Y U M I

- Merely descriptive of footwear?
 - Yes.
 - Means “walking, a step”

Res judicata

In re Hotels.com, O.P.,
87 USPQ2d 1100 (TTAB 2008)



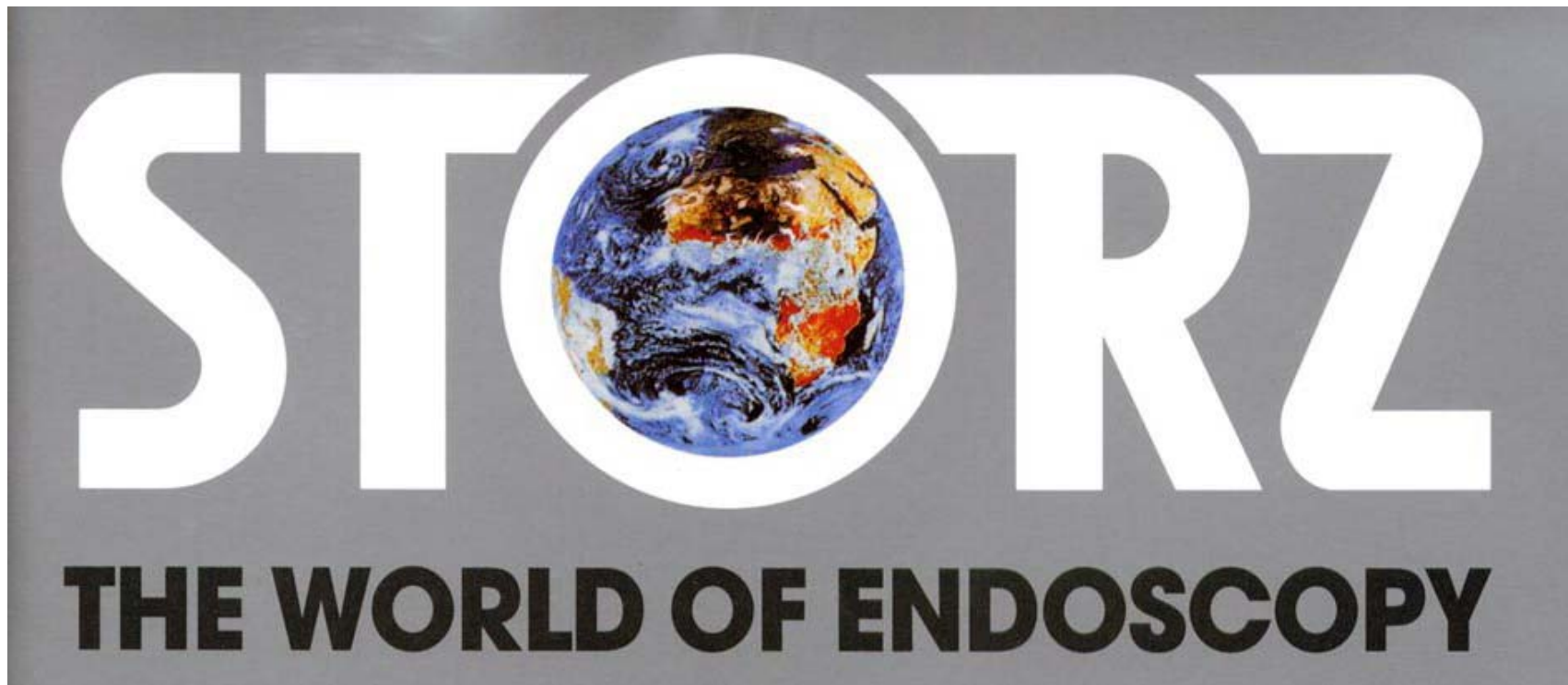
- Does new survey avoid prior decision?
 - Yes.
 - Have facts or circumstances changed since final decision rendered?
 - Yes; survey sufficient.

In re Hotels.com (cont.)

- Is HOTELS.COM generic?
 - Yes.
 - “hotels” are focus of website information
 - Generic plus “.com” still generic
 - Survey fatally overbroad
 - conceptual difference between domain name and a brand name
 - Probe understanding of terms compounds utilizing generic term and “.com.”

Agreements prohibiting use

*Bausch & Lomb Inc. v.
Karl Storz GmbH & Con. KG,
87 USPQ2d 1526 (TTAB 2008)*

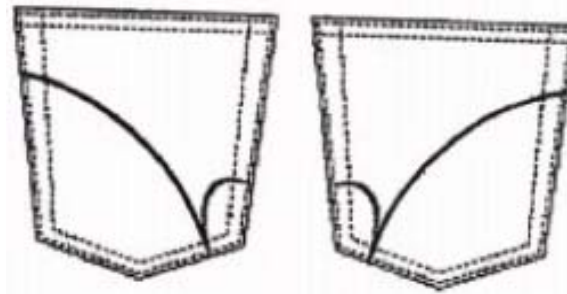
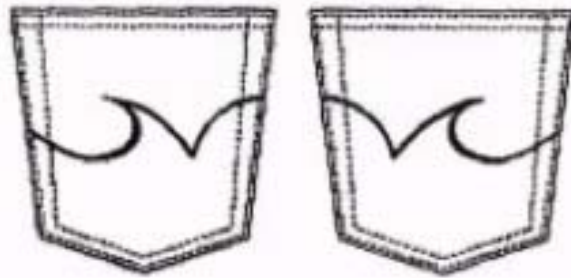


*Bausch & Lomb Inc. v.
Karl Storz GmbH & Con. KG,
87 USPQ2d 1526 (TTAB 2008)*

- May an opposition be based on breach of an agreement?
 - Yes.
 - Courts are proper tribunals
 - But Board will still consider.

Mere ornamentation

In re Right-On Co. Ltd.,
87 USPQ2d 1152 (TTAB 2008)



In re Right-On Co. Ltd.,
87 USPQ2d 1152 (TTAB 2008)

- Failure to function refusal proper for Madrid REP?
 - Yes.
 - No specimen for REP
 - Examining Attorney not aware of how mark used or perceived
 - May issue ornamentation refusal if mark decorative or ornamental

In re Right-On Co. (cont.)



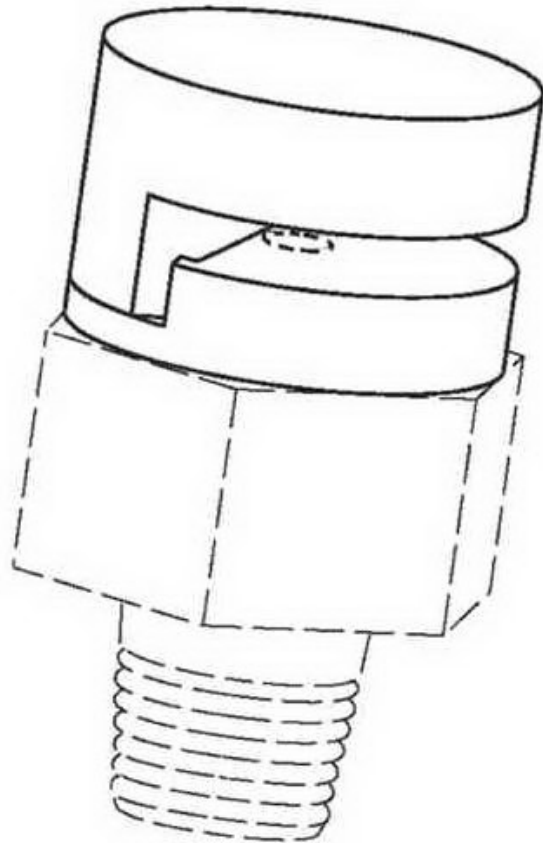
Do these function as a trademark?

No.

- Common form of ornamentation
- Mere “refinement” not inherently distinctive
- Applicant’s designs not unique or unusual

Functionality

In re Udor U.S.A., Inc., 89 USPQ2d 1978 (TTAB 2009)



(12) **United States Patent**
Johnson

(10) **Patent No.:** **US 7,108,204 B2**
(45) **Date of Patent:** **Sep. 19, 2006**

(54) **SPRAY NOZZLE**

(76) Inventor: **Thomas Les Johnson**, 7060 Knollwood Dr., Moundsview, MN (US) 55112

(*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 489 days.

(21) Appl. No.: **10/068,652**

(22) Filed: **Feb. 6, 2002**

(65) **Prior Publication Data**
US 2003/0146303 A1 Aug. 7, 2003

(51) **Int. Cl.**
B05B 1/26 (2006.01)
A62C 31/02 (2006.01)

(52) **U.S. Cl.** **239/522; 239/523; 239/512;**
239/509; 239/505; 239/595

(58) **Field of Classification Search** **239/592;**
239/595, 524, 523, 522, 513, 512, 509, 506,
239/505, 501

See application file for complete search history.

(56) **References Cited**

U.S. PATENT DOCUMENTS

1,639,162 A * 8/1927 Brooks 239/390

2,338,273 A * 1/1944 Wilkins 239/522
RE24,353 E * 9/1957 Kromer 239/505
3,085,754 A * 4/1963 Thompson 239/523
4,461,426 A * 7/1984 Christopher 239/394
4,624,414 A * 11/1986 Ferrazza 239/467
5,076,497 A 12/1991 Rabitsch

OTHER PUBLICATIONS

Catalog—W.L. Hamilton & Co., Marshall, Michigan, 1986, pp. 17, 18 and 23.
Catalog—Kuker Industries, Inc., Omaha, Nebraska, 1994, pp. 54 and 57.

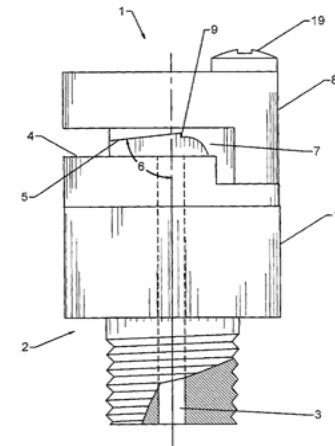
* cited by examiner

Primary Examiner—Dinh Q. Nguyen
(74) *Attorney, Agent, or Firm*—Altera Law Group, LLC

(57) **ABSTRACT**

A spray nozzle includes an orifice disposed on a substantially planar discharge surface. An impingement surface is disposed opposite the orifice, the impingement surface forming an angle with a centerline of the orifice. The angle between the orifice centerline and the surface is less than 90 degrees. A deflection ridge bridges a gap between the impingement surface and the discharge surface. The deflection ridge encompasses a partial circumference of the nozzle. The nozzle includes a fluid fitting adapted for providing a pressurized fluid to the orifice.

24 Claims, 7 Drawing Sheets



In re Udor U.S.A., Inc., 89 USPQ2d 1978 (TTAB 2009)

- Is utility patent *prima facie* evidence of *functionality*?
 - Must disclose feature's utilitarian advantages
 - Only invisible parts disclosed as functional

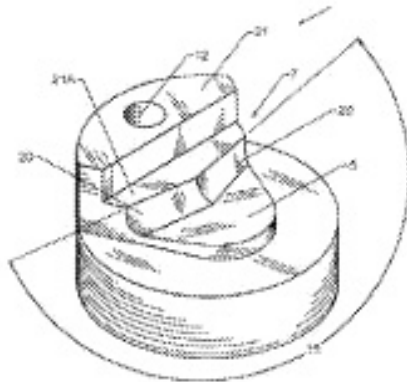


Fig. 6

In re Udor U.S.A (cont.)

- Was a cylindrical-shaped spray nozzle functional?
 - Yes.
 - Competitors' nozzles were visually and functionally similar
 - Round shape was efficient, economical and advantageous

Sound marks

In re Vertex Group LLC, 89 USPQ2d 1694 (TTAB 2009)



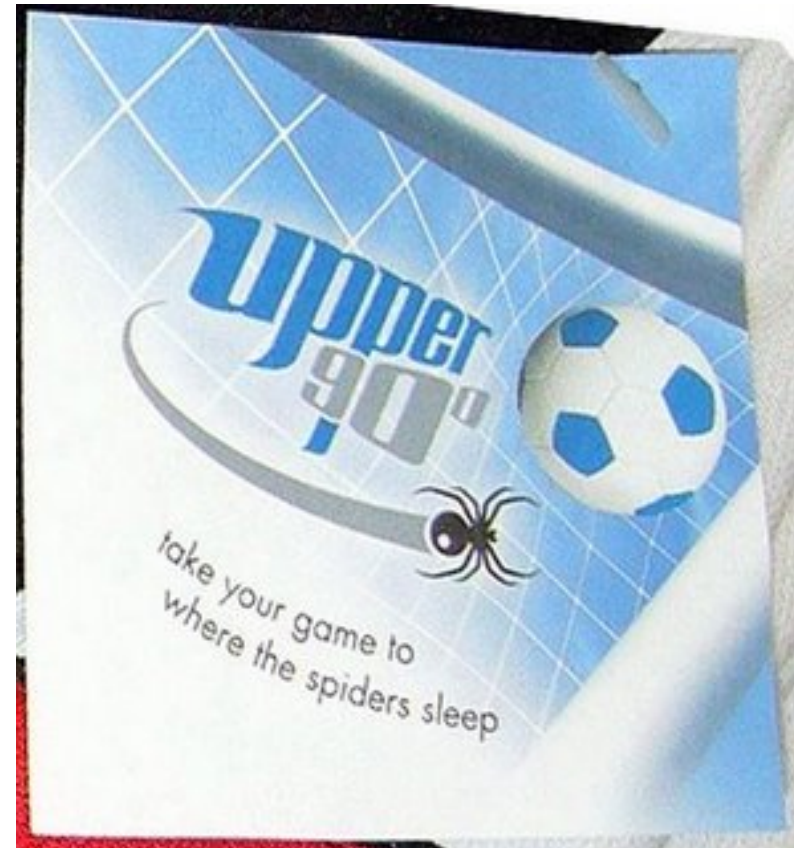
In re Vertex Group LLC, 89 USPQ2d 1694 (TTAB 2009)

- Are sounds of sound-producing products registrable?
 - Only with acquired distinctiveness
- May security alarm sound be registered?
 - No.
 - Sound was functional
 - audible alarm essential to purpose
 - sound failed to function at trademark

Specimen is “substantially exact representation” of mark

In re Yale Sportswear Corp.,
88 USPQ2d 1121 (TTAB 2008)

UPPER 90



In re Yale Sportswear Corp.,
88 USPQ2d 1121 (TTAB 2008)

- Is specimen a substantially exact representation?
 - No.
 - separate and distinct commercial impression
 - substantially changed the overall impression

In re wTe Corp.,
87 USPQ2d 1536 (TTAB 2008)

SPECTRAMET

The logo for Spectramet features the word "Spectramet" in a bold, italicized, sans-serif font. The letter "e" is replaced by a circular icon containing a stylized arrow that curves from the top to the bottom, suggesting motion or a cycle.

In re wTe Corp.,
87 USPQ2d 1536 (TTAB 2008)

- Is stylized specimen “substantially exact representation” of standard character drawing?
 - Yes, if standard character drawing creates distinct commercial impression
 - No, if design element engenders uncommon commercial impression lost in typed drawing

Improper specimen for service mark

In re wTe Corp (cont.)

Speotramet[®] LLC

28 Montague City Road
Greenfield, Massachusetts 01301

**Mr. Greg Brock
RTI Alloys, Inc.
Material Processing Division
208 Fifteenth St. SW
Canton, Ohio 44707**

CONTENTS

1. Ti-6-4, sorted

BOX #1

**CUSTOMER LOT #: 3838
CUSTOMER LOAD #: 0-13093**

In re wTe Corp (cont.)

- Is a return address label acceptable specimen for service mark?
 - No.
 - Direct association between services and mark
 - No connection here

In re DSM Pharmaceuticals Inc., 87 USPQ2d 1623 (TTAB 2008)

DSM Pharmaceuticals LiquidAdvantage™ is a flexible state-of-the-art distributed control system, which controls all SCADA, D3, and electronic cycle run report functions in a single unified solution. By utilizing a product-specific, recipe-driven single communication interface, all production operations from supply, filling, and packaging to warehousing occur with minimal production staff.

Drug Product | Fill + Finish

Aseptic Liquid Filling

LiquidAdvantage

Right here
Right now

DSM Pharmaceutical Products
45 Madison Blvd.
Parsippany, New Jersey 07054-1298
info.dsmpharmaceut@dsi@dsi.com
973-257-0011

Liquid Advantage

DSM Pharmaceuticals Inc. offers pharmaceutical and biopharmaceutical customers aseptic liquid fill and finish capabilities unlike any other in the industry. With increasing regulatory demands, expert aseptic liquid fill and finish capabilities are a critical requirement in successful product launches.

DSM Pharmaceuticals LiquidAdvantage™ provides the control needed to achieve your objectives. LiquidAdvantage™ is a proprietary, automated control system software developed and used exclusively by DSM Pharmaceuticals. This control is used on all production filling lines operating under advanced aseptic production methods.

DSM Pharmaceuticals LiquidAdvantage™ is a flexible state-of-the-art distributed control system, which controls all SCADA, D3, and electronic cycle run report functions in a single unified solution. By utilizing a product-specific, recipe-driven single communication interface, all production operations from supply, filling, and packaging to warehousing occur with minimal production staff.

In re DSM Pharmaceuticals Inc.,
87 USPQ2d 1623 (TTAB 2008)

- Acceptable specimen?
 - No.
 - Direct association required between proposed mark and services
 - Mark refers to software, not to services

QUICK TAKES ON LIKELIHOOD OF CONFUSION

QUICK TAKES ON LIKELIHOOD OF CONFUSION

Likelihood of Confusion Found

Bose Corp. v. Hexawave Inc.,
88 USPQ2d 1332
(TTAB 2007 - nonprecedential)

- Opposer:

HEXAWAVE

for electrical acoustical
equipment components

- Applicant:

ACOUSTIC
WAVE and WAVE

for acoustical
equipment

In re S L & E Training Stable Inc.,
88 USPQ2d 1216 (TTAB 2008)

- Applicant:



for luggage, etc

- Cited mark:

EDELMAN

for leather articles
including luggage

In re RSI Systems LLC,
88 USPQ2d 1445 (TTAB 2008)

- Opposer:



for ink cartridges,
machines used in
printing, ink jet printers
and cartridges, etc.

- Applicant:

RSI

for printing machines
and document imaging
services

QUICK TAKES ON LIKELIHOOD OF CONFUSION

Likelihood of Confusion Not Found

*Bass Pro Trademarks LLC v.
Sportsman's Warehouse Inc.,
89 USPQ2d 1844 (TTAB 2008)*

- Opposer:



for retail store
services.

- Applicant:




Sportsman's Warehouse

for retail store services

H. D. Lee Co. v. Maidenform Inc., 87 USPQ2d 1715 (TTAB 2008)

- Opposer:

One FAB Fit™ Hipster



The new One Fabulous Fit hipster has great appeal. This hipster has been updated with a comfort waistband and a center back seam for shaping. The same microfiber that is a proven winner in the One Fabulous Fit bras. Smooth and silky to the touch. Fabric Content: Front & Back: 87% tactel nylon, 13% lycra elastane. Gusset lining: 100% cotton. Imported.

for underwear,
foundation garments,
intimate apparel, etc.

- Applicant:

ONE TRUE FIT



for outerwear

*Boston Red Sox Baseball Club LP
v. Sherman,
88 USPQ2d 1581 (TTAB 2008)*

- Opposer:

SEX ROD

- Applicant:

RED SOX

for clothing.

The Cuban embargo and Trademarks

*Corporacion Habanos S.A. v.
Anncas Inc.,
88 USPQ2d 1785 (TTAB 2008)*

- Does Cuban Embargo bar geographic deceptive misdescriptiveness claim?
 - No.
 - Not based on ownership claim
 - Not barred by statute



Standing

Corporacion Habanos S.A. (cont.)

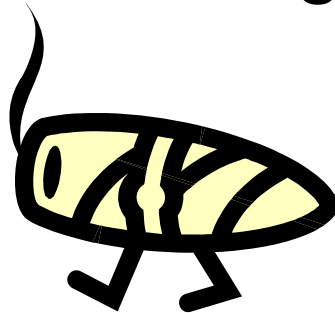
- Can Cuban company's US registration establish standing despite embargo on sales?
 - Yes.
 - Mark used in advertising
 - Intends to sell when US laws allow
 - Section 515.527 of the Cuban Assets Control Regulations specifically permits



Geographic Deceptive Misdescriptiveness

Corporacion Habanos S.A. (cont.)

- Is HAVANA CLUB geographically deceptively misdescriptive?
 - Yes.
 - Goods/place association
 - Association would be material
 - No proof Cuban seed cigars share qualities with Cuban cigars



Scandalous mark, disparagement

*Boston Red Sox Baseball Club LP
v. Sherman,
88 USPQ2d 1581 (TTAB 2008)*



*Boston Red Sox Baseball Club LP
v. Sherman,
88 USPQ2d 1581 (TTAB 2008)*

SEX ROD

- Immoral and scandalous?
 - Yes.
 - Applicant admitted sexual connotations
 - Dictionary definition = vulgar meaning
 - Applicant submitted no evidence to rebut opposer's showing

Boston Red Sox v. Sherman (cont.)

SEX ROD RED SOX

- Disparaging of Opposer?
 - Yes.
 - Applicant admits RED SOX identified with Opposer
 - Applicant copied form
 - Consumers would recognize mark as vulgar version of symbol

In re Heeb Media LLC,
89 USPQ2d 1071 (TTAB 2008)



In re Heeb Media LLC,
89 USPQ2d 1071 (TTAB 2008)

- Is HEEB disparaging of Jewish people?
 - Yes.
 - Dictionary definitions = derogatory term
 - Jewish groups object to use
 - Good intentions? Still objectionable
 - First amendment not abridged
 - Still right to use mark

False Suggestion of Connection

Hornsby v. TJX Companies Inc.,
87 USPQ2d 1411 (TTAB 2008)



Hornsby v. TJX Companies Inc., 87 USPQ2d 1411 (TTAB 2008)

- Does TWIGGY for clothing, falsely suggest connection with TWIGGY the model?
 - Yes.
 - Petitioner known as “Twiggy”
 - Respondent’s mark is identical
 - Petitioner not connected
 - Twiggy famous enough to create association

In re MC MC S.r.L.,
88 USPQ2d 1378 (TTAB 2008)



In re MC MC S.r.L.,
88 USPQ2d 1378 (TTAB 2008)

- Does MARIA CALLAS for jewelry and watches falsely suggest connotation with Maria Callas?
 - No.
 - Deceased person's right under Sec. 2
 - not protected without heirs or successors
 - Evidence was contradictory
 - Doubt resolved in applicant's favor
 - Opposition/cancellation available to any successor

Abandonment

*General Motors Corp. v. Aristide &
Co., Antiquaire de Marques,
87 USPQ2d 1179 (TTAB 2008)*



General Motors Corp. v. Aristide & Co., Antiquaire de Marques, 87 USPQ2d 1179 (TTAB 2008)

- Priority for LASALLE from use 60 years ago?
 - No.
 - Nonuse period > sixty years
 - No explanation
 - =*prima facie* evidence of abandonment
 - No testimony of plans to reintroduce
 - Brand reintroduction by industry does not avoid statutory presumption

Bona fide intent to use

Boston Red Sox v. Sherman (Extra innings)



Boston Red Sox v. Sherman (Extra innings)

- Does absence of documents prove lack of bona fide intent?
 - Yes.
 - Opposer's initial burden to demonstrate lack of bona fide intent
 - Where no documentary evidence, burden shifts to applicant

Ownership - Implied license

*Ballet Tech Foundation Inc. v.
Joyce Theatre Foundation Inc.,
89 USPQ2d 1262 (TTAB 2008)*



*Ballet Tech Foundation Inc. v.
Joyce Theatre Foundation Inc.,
89 USPQ2d 1262 (TTAB 2008)*

- Does a mark owner need a written license?
 - No.
 - Informal quality control may be sufficient

Ballet Tech Foundation (cont.)

J S O Y H E O

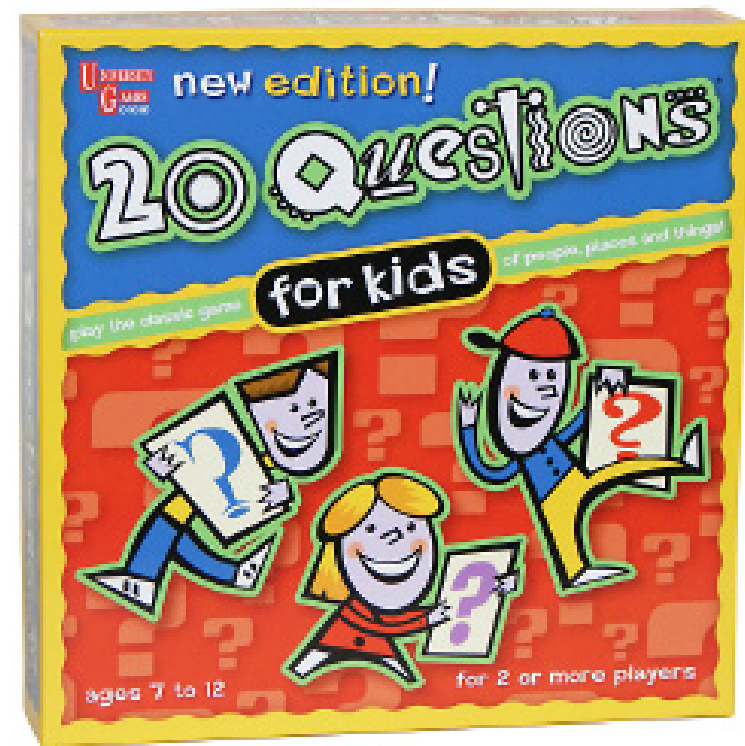


Ballet Tech Foundation (cont.)

- Does failure to object to licensee's new composite mark constitute abandonment?
 - Not necessarily.
 - Reliance on Licensee's integrity may be enough
 - Justified if no evidence of deviations
 - Expansion was consistent with original goals

Fraud

*University Games Corp. v. 20Q.net Inc.,
87 USPQ2d 1465 (TTAB 2008)*



University Games Corp. v. 20Q.net Inc.,
87 USPQ2d 1465 (TTAB 2008)

- Fraud where goods deleted before mark is published?
 - No.
 - Amendment during prosecution = rebuttable presumption of no willful intent to deceive

University Games (cont.)



- Concurring opinion: Summary Judgment appropriate
 - Deletion negated intent
 - Once deleted, not material

Bose Corp. v. Hexawave Inc.,
88 USPQ2d 1332
(TTAB 2007 - nonprecedential)



Bose Corp. v. Hexawave Inc.,
88 USPQ2d 1332
(TTAB 2007 - nonprecedential)

- Is reshipment of repaired goods sufficient to avoid fraud?
 - No.
 - No reasonable ground to believe reshipment constituted sufficient use
 - Inclusion in maintenance affidavit was fraudulent
 - Decision appealed to Federal Circuit

Grand Canyon West LLC v. Hualapai Tribe, 88 USPQ2d 1501 (TTAB 2008)



Grand Canyon West v. Hualapai Tribe (cont.)

- Is it fraud to recite “transportation of passengers by air, boat, raft, rail, tram, bus, motorized on-road and off-road vehicles, non-motorized vehicles featuring bicycles, and domestic animals,”
 - Without transportation by rail, tram, bicycles or domesticated animals?

Grand Canyon West (cont.)

- Yes.
 - Examining Attorney's suggestion?
 - Immaterial
 - Not part of verified application?
 - Immaterial
 - Claim of use is essential to integrity of application process

G&W Laboratories Inc.
v. GW Pharma Ltd.,
89 USPQ2d 1571 (TTAB 2009)

- Effect of fraud in multiple-class application?
 - Each class is a separate application
 - Cancellation limited to classes where goods/services fraudulently claimed

*Bass Pro Trademarks LLC v.
Sportsman's Warehouse Inc.,
89 USPQ2d 1844 (TTAB 2008)*

- Where use of mark ceases after registration, is it fraud not to delete those services?
 - No.
 - Reasonable to delay until filing Sec. 8 declaration of use

Laches

Land O' Lakes v. Hugunin,
88 USPQ2d 1957 (TTAB 2008)

- Laches based on earlier, expired registration?
 - Yes, but delay ends when registration expires .

Morehouse defense

Land O' Lakes v. Hugunin (cont.)

- *Morehouse* defense considered if prior registration expired?
 - (Morehouse = no injury because of prior registration for same mark; same goods)
 - No; injury expires when registration does.

Procedural issues

Electronic filing of oppositions

Vibe Records Inc. v. Vibe Media Group LLC, 88 USPQ2d 1280 (TTAB 2008)

USPTO. ESTTA. Notice of Opposition.. Validate

TTAB

Page 1

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Electronic System for Trademark Trials and Appeals

Notice of Opposition
Opposition Information | Fees | Communications | Filing | Signatures

Validate

Review the information below and click on the "to proceed with payment" button if the information is correct. If you need to edit any information, go back to proper screen using navigation facilities on this web page and make your correction (s). DO NOT USE THE BACK BUTTON ON YOUR BROWSER.

ESTTA Tracking number: ESTTA129706	
Filing date: 03/13/2007	
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD	
Notice of Opposition	
Notice is hereby given that the following party opposes registration of the indicated application.	
Opposer Information	
Name	Timothy J. Olphie Vibe Records, Inc.
Granted to Date of previous extension	03/14/2007
Address	#824 Old Country Road Westbury, NY 11590 UNITED STATES
Party who filed Extension of time to oppose	Vibe Records, Inc. Vibe Records, Inc.
Relationship to party who filed Extension of time to oppose	I am the opposer as well as President & CEO of Vibe Records, Inc.

03-15-2007
U.S. Patent & Trademark Mail Room, #72

03/16/2007 8618808 00000078 78851648

01 FC:6402 300.00 OP

PAGE 3/4 * RCVD AT 3/14/2007 12:34:06 PM [Eastern Daylight Time] * SVR:USPTO-EFAXF-6/40 * DNS:2736500 * CSID: * DURATION (mm-ss):02:28:56 PM

USPTO. ESTTA. Notice of Opposition.. Validate

Page 2

Correspondence information	Timothy J. Olphie President & CEO Vibe Records, Inc. # 824 Old Country Road Po Box 8 Westbury, NY 11590 UNITED STATES info@viberecords.com Phone:516 333 2400		
Applicant Information			
Application No	78851648	Publication date	11/14/2006
Opposition Filing Date	03/13/2007	Opposition Period Ends	03/14/2007
Applicant	VIBE MEDIA GROUP LLC 215 LEXINGTON AVENUE NEW YORK, NY 10016 UNITED STATES		
Goods/Services Affected by Opposition			
Class 035. All goods and services in the class are opposed, namely: Promoting the goods and services of others by providing a web site at which users can link to online retail stores, online coupons, online music purchasing sites and magazine subscriptions			
Attachments	Cease and Desist doc.pdf (4 pages X42159 bytes)		
Signature	/Timothy J. Olphie/		
Name	Timothy J. Olphie		
Date	03/13/2007		

Fee calculated according to USPTO fee table	
Fee code	7402
amount	300.00
description	Notice of Opposition, per Class, Electronically Filed
Serial # 78851648	# of Classes 1
Total	300.00

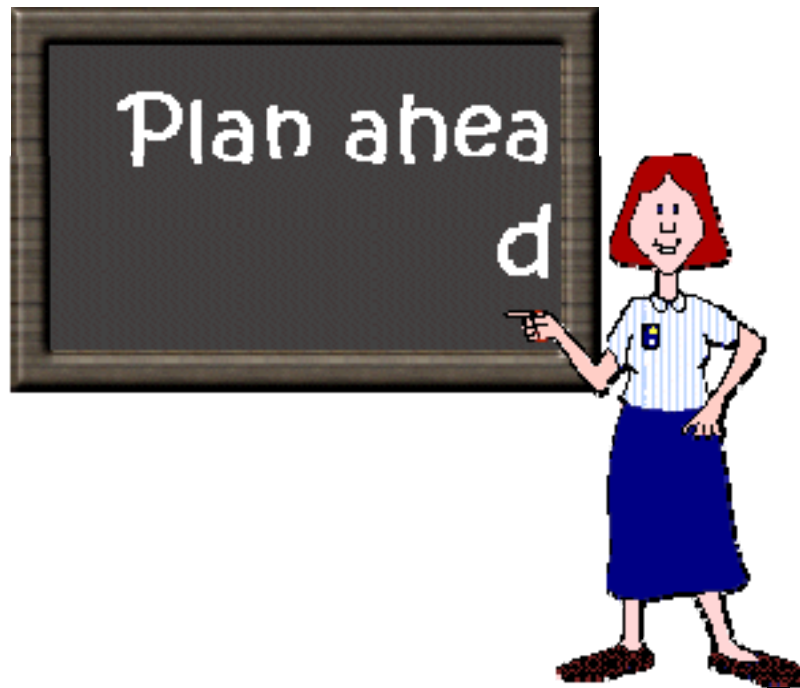
PAGE 4/4 * RCVD AT 3/14/2007 12:34:06 PM [Eastern Daylight Time] * SVR:USPTO-EFAXF-6/40 * DNS:2736500 * CSID: * DURATION (mm-ss):02:28:56 PM

*Vibe Records Inc. v.
Vibe Media Group LLC,
88 USPQ2d 1280 (TTAB 2008)*

- Failed attempt at electronic filing;
Will Opposition be declared?
 - No.
 - Opposition filing not completed.
 - Filer didn't make payment

Vibe Records v. Vibe Media (cont.)

- Attempt to file printout of draft ESTTA opposition also insufficient
 - No filing by facsimile (Rule 2.195(d)(3))



Service of Notice of Opposition

Schott AG v. Scott,
88 USPQ2d 1892 (TTAB 2008)

- Can potential opposer belatedly cure failure to serve?
 - No.
 - Could petition to cancel

Initial disclosures

*Kairos Institute of Sound Healing LLC
v. Dolittle Gardens LLC,
88 USPQ2d 1541 (TTAB 2008)*

- Sanctions available for failure to serve initial disclosures?
 - No.
 - Motion to compel must precede motion for sanctions
 - No Board order to compel here
 - No refusal to make disclosures
 - Sanctions were premature

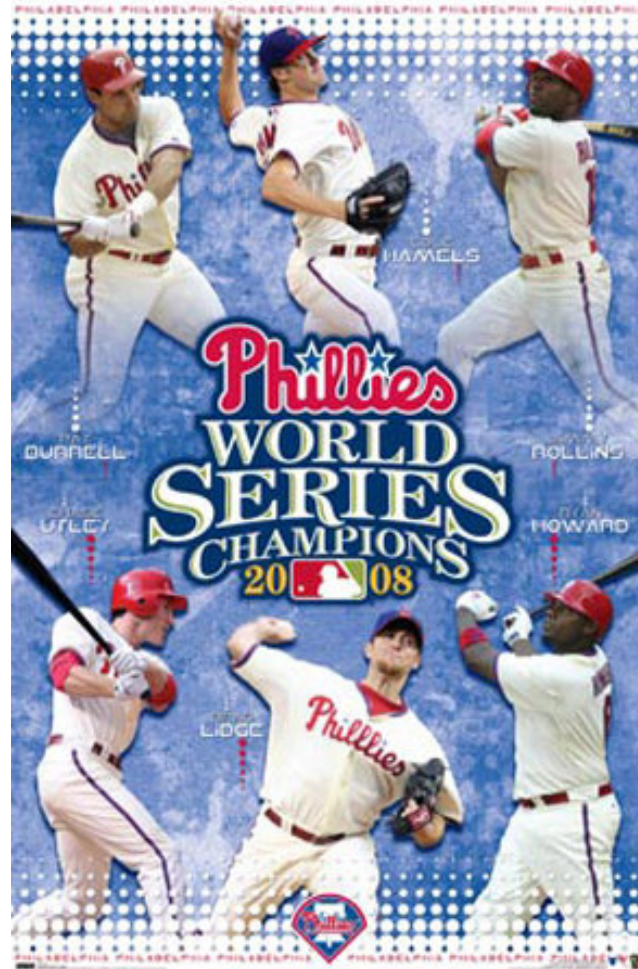
*Boston Red Sox Baseball Club
LP v. Chaveriat,
87 USPQ2d 1767 (TTAB 2008)*



*Boston Red Sox Baseball Club
LP v. Chaveriat,
87 USPQ2d 1767 (TTAB 2008)*

- May parties waive initial disclosure obligations?
 - Yes.
 - Rules 2.120(a)(2) and 2.120(a)(3) permit waiver with stipulation
 - Board prefers description of alternate discovery plans
 - Even if to use traditional discovery

No confusion with World Series Champs!



Exclusion of evidence at trial

H. D. Lee Co. v. Maidenform Inc., 87 USPQ2d 1715 (TTAB 2008)

- Evidence precluded for failure to respond to discovery requests?
 - Here, no
 - Prerequisite: Motion to compel discovery
 - OR waiver of right to object
 - Failed to provide copies of discovery requests
 - Board could not ascertain if evidence was responsive

Proving defense of tacking

H. D. Lee v. Maidenform (cont.)

- Must tacking be pleaded as affirmative defense?
 - Yes.
 - Must be pleaded affirmatively
 - Duty to put opposer on notice
 - Denial of opposer's priority is insufficient
 - Must have notice that opposer must predate tacking priority
 - Opposer objected; no implied consent

Motions practice

Conversion of Motion to Dismiss to Summary Judgment Motion

*Compagnie Gervais Danone v.
Precision Formulation LLC,
89 USPQ2d 1251 (TTAB 2009)*

- Motion to dismiss made before initial disclosures
- Evidence submitted outside pleadings
- Will Board convert to Summary Judgment?

Compagnie Gervais Danone (cont.)

- No.
 - New rules: No summary judgment before initial disclosures
 - Board will not convert into motion for summary judgment.
- Rather, Board may exclude matters outside pleadings
 - Will consider motion's merits as motion to dismiss

Compagnie Gervais Danone (cont.)

- Must Board construe all non-movant's allegations as true?
 - Board may look beyond some allegations
 - Facts not subject to proof
- Board may review USPTO records to determine if allegations are well-pleaded

Page limits – Summary Judgment Motions and Cross-Motions

*Cooper Technologies Co. v.
Denier Electric Co.,
89 USPQ2d 1478 (TTAB 2008)*

- 25 page limit applicable to Summary Judgment opposition combined with cross-motion?
 - Yes.
 - Rule 2.127(a) applies to combination brief
 - Where the issues are the same, cannot subvert page limitation
 - Where issues are different, cross motion brief not counted against response.

Introduction of evidence

Life Zone v. Middleman (cont.)

- Helpful guidelines for submitting evidence:
 - Notice of Reliance limited to
 - Adverse Depositions
 - Interrogatory answers
 - Adverse discovery depositions
 - Admissions
 - Printed publications
 - Official records

Life Zone v. Middleman (cont.)

- Submitting evidence: (cont.)
 - Web pages not admissible by Notice of Reliance
 - Not considered for truth of matter asserted
 - Internet Search results not admissible by Notice of Reliance
 - Testimony must be presented by deposition, absent stipulation

Life Zone v. Middleman (cont.)

- Submitting evidence: (cont.)
 - Don't file testimonial depositions under Notice of Reliance
 - Don't attach exhibits to trial briefs
 - New evidence untimely; not considered
 - Duplicate exhibits should not be filed
 - Cited to the record instead

THANK YOU



Jordan S. Weinstein



Alexandria, Virginia, USA
jweinstein@oblon.com