

**Decisions of the Federal Courts and the
Trademark Trial and Appeal Board on Registrability Issues
July 2023 to August 2024**

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PART I. EX PARTE CASES

A. United States Supreme Court

1. Section 2(c) Consent to Register

Vidal v. Elster, 2024 USPQ2d 1083 (2024). The Supreme Court rejected a challenge to the constitutionality of Section 2(c) of the Trademark Act, which prohibits registration of a mark that “[c]onsists of or comprises a name, portrait, or signature identifying a particular living individual except by his [sic] written consent.” Steve Elster’s application to register the mark TRUMP TOO SMALL for “shirts,” was refused by the USPTO under Section 2(c). The Trademark Trial and Appeal Board affirmed that refusal, but the U.S. Court of Appeals for the Federal Circuit reversed, ruling that, as applied to a public figure like Mr. Trump, Section 2(c) violated the Freedom of Speech clause of the First Amendment. Unlike the *Tam* and *Brunetti* cases, here the Court faced a statutory provision, referred to in the Court’s opinion as the “names clause,” that did not discriminate based on viewpoint but rather “turns on the content of the proposed mark: whether it is a person’s name.” The Court then considered the history of the “names clause,” observing that the clause has “deep roots.” “Our courts have long recognized that trademarks containing names may be restricted. And these name restrictions served established principles.” In light of this history and tradition, the Court concluded that the names clause of Section 2(c) is compatible with the First Amendment. The Court described its ruling as “narrow,” declining to set out a “comprehensive framework” for assessing the constitutionality viewpoint-neutral trademark restrictions.

B. United States Court of Appeals for the Federal Circuit

1. Failure to Function as a Source Indicator

In re GO & Assocs., LLC, 2024 USPQ2d 616 (Fed. Cir. 2024) [precedential]. The CAFC, at the request of the USPTO under FED. CIR. R. 32.1(e), redesignated as precedential its opinion upholding the Board’s affirmance of a refusal to register the proposed mark EVERYBODY VS RACISM for tote bags and various clothing items, and for the services of “promoting public interest and awareness of the need for racial reconciliation and encouraging people to know their neighbor and then affect change in their own sphere of influence.” The Board found that the phrase fails to function as a trademarks because it was in “wide use in a non-trademark manner to consistently convey an informational, anti-racist message to the

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public,” rather than as a source indicator for GO’s goods and services. The CAFC concluded that the Board’s decision was supported by substantial evidence. Applicant GO argued that “[p]er se refusals based on the Informational Matter Doctrine are unconstitutional,” but the Board was unimpressed. “GO’s constitutional argument is based on a faulty premise: that the Patent and Trademark Office’s (“PTO”) application of the so-called “Informational Matter Doctrine” results in the per se refusal of any mark that contains informational matter, regardless whether or not consumers perceive the mark as source identifying. That is not true.” “[N]othing in the Lanham Act prohibits registration of a mark containing informational matter, so long as the mark also functions to identify a single commercial source.”

2. Requirement to Provide Applicant’s Domicile Address

In re Chestek PLLC, 2024 USPQ2d 297 (Fed. Cir. 2024) [precedential]. The CAFC upheld the Board’s affirmance of a refusal to register the mark CHESTEK LEGAL for “legal services” based on Applicant Chestek PLLC’s failure to provide its “domicile address.” Chestek listed a post office address, but under Trademark Rules 2.32(a)(2) and 2.189 a post office box is not a street address. Conceding that it failed to comply with the domicile address requirement, Chestek principally argued on appeal that the Rules were unlawfully promulgated under the Administrative Procedure Act (APA), because the USPTO failed to comply with the requirements of notice-and-comment rulemaking under 5 U.S.C. § 553. Chestek asserted that the domicile address requirement is not an “interpretative” rule but rather a “substantive” rule requiring notice-and-comment. Alternatively, Chestek argued that notice-and-comment is required even for interpretative rules. The CAFC was not persuaded, concluding that the USPTO’s requirement is not a substantive rule because it “does not alter the substantive standards by which the USPTO evaluates trademark applications, e.g., a mark’s use in commerce or distinctiveness.” As to second argument, Chestek offered no support for displacing the procedural exceptions to notice-and-comment rulemaking contained within Section 553(b).

C. Trademark Trial and Appeal Board

1. Section 2(a) False Suggestion of a Connection

In re Leathernecks Motorcycle Club Int’l, Inc., 2024 USPQ2d 1023 (TTAB 2024) [precedential]. The Leathernecks Motorcycle Club was thwarted in its attempt to register the collective membership mark LEATHERNECKS in the design form shown here. The Board found that the mark, which indicates membership in a motorcycle club, falsely suggests a connection with the United States Marine Corps in violation of Section 2(a) of the Trademark Act. In determining whether the subject mark runs afoul of Section 2(a), the Board applied the *Notre Dame* test. The Club conceded that “Leatherneck” is a nickname for a member of the USMC. The Board found that “the relevant public would understand the term ‘Leathernecks’ to point uniquely and unmistakably to the USMC, especially when all of Applicant’s present members ‘are active duty or honorably discharged U.S. Marines, or U.S. Navy Corpsman who have served with the Fleet Marine Force.’” The Club did not claim any connection or affiliation with the USMC, and the



Board found that “the USMC is of sufficient fame or reputation that, when the term ‘Leathernecks’ in Applicant’s mark is used to indicate membership in a motorcycle club, a connection with the USMC would be presumed.” The four elements of the *Notre Dame* test having been met, the Board affirmed the Section 2(a) refusal.

2. Section 2(d) Likelihood of Confusion

In re OSF Healthcare Sys., 2023 USPQ2d 1089 (TTAB 2023) [precedential]. In a questionably precedential decision, the Board affirmed-in-part and reversed-in-part a refusal to register the mark IMPACT for various healthcare-related services in Classes 35, 44, and 45. The USPTO had found confusion likely with the registered mark IMPACT, in slightly stylized form, for “Consulting services in the field of patient relationship management for healthcare workers” in Class 35 and “Training in patient-centered, evidence-based community health worker-centered healthcare” in Class 41. Applicant’s Class 35 services included business consulting services that are encompassed by registrant’s consulting services, and so the Board affirmed this refusal. As to classes 44 and 45, the Examining Attorney contended, based on numerous third-party registrations and websites, that applicant’s healthcare and medical coordination services and its charitable case management services are related to registrant’s training services. The Board, however, found most of USPTO’s evidence non-probative and it therefore reversed the refusals.

IMPACT

In re Samsung Display Co., 2024 USPQ2d 1279 (TTAB 2024) [precedential]. The Board affirmed a refusal to register the mark UPC for, inter alia, display panels as components of computers and smart phones, finding confusion likely with the identical mark registered for charging cables and power connectors. Applicant Samsung argued that, to show relatedness of the goods, “something more” is required than the mere fact that some third-party manufacturers sell both types of goods. The Board was not impressed. The Board found that “the goods are related because they are each incorporated and used in the same finished electronic products.” As to Samsung’s “something more” argument, the Board pointed out that the two cases relied on by Samsung - *Coors Brewing* and *St. Helena Hospital* – involved the relatedness of goods and services, thus “limiting the requirement for ‘something more’ to circumstances where goods are used in the rendering of services and the relatedness of the goods and services is not evident, well known, or generally recognized.” [*Coors Brewing* concerned beer and restaurant services, while *St. Helena Hospital* dealt with hospital-based lifestyle programs and printed materials dealing with fitness.] Although some purchasers of the involved goods may be sophisticated, others are not, such as hobbyists and gamers who build or repair their own electronic devices, and there was no evidence that these ordinary consumers would exercise more than ordinary care.

3. Section 2(e)(1) Mere Descriptiveness

In re Sheet Pile, LLC, 2024 USPQ2d 522 (TTAB 2024) [precedential]. In a dubiously precedential ruling, the Board upheld a Section 2(e)(1) refusal to register the proposed mark ZPILE, finding it to be merely descriptive of “Metal sheet piles, metal sheet pile sections, and

metal sheet pile connectors for joining metal sheet piles.” The Board declined to reach the Office’s failure-to-function refusal, but in obvious *dictum* discussed the issue anyway. The Board had little trouble in finding that “[t]he combination of ‘Z’ and ‘PILE’ immediately describes . . . a feature or characteristic of the goods, namely, that they are or pertain to the well-known ‘Z’ shape of sheet pile.” With regard to the failure-to-function refusal, the Board opined that the USPTO should have instead applied the “distinctiveness continuum,” which includes “a threshold absolute bar to registration for generic terms—terms that by definition fail to function as source identifiers.” This continuum “provides the appropriate framework for the assessment of registrability based on the rationale articulated by the Examining Attorney in this case—i.e., that the goods at issue ‘are Z-shaped piles.’”

In re Locus Link USA, 2024 USPQ2d 1181 (TTAB 2024) [precedential]. In the Board’s first decision in an appeal arising from an expungement proceeding, the Board affirmed the USPTO Director’s decision to cancel registrations for the mark SMARTLOCK, in standard character and design form, for “Components for air conditioning and cooling systems, namely, evaporative air coolers.” The Board found that Registrant Locus Link USA never used the mark in connection with “evaporative air coolers,” and rejected Locus Link’s interpretation of the identification of goods. The Examining Attorney maintained that the subject registrations cover only the specific goods following the term “namely” in the identification of goods: i.e., “evaporative air coolers.” Locus Link conceded that it did not use the marks with finished goods, but only with certain connector components. It insisted that the registrations covered components for evaporative air coolers. The Board agreed with the examining attorney that “evaporative air coolers” modifies the otherwise indefinite wording “components for air conditioning systems.” “In other words, the identification of goods .[in each registration] . . . covers evaporative air coolers that are components of air cooling systems. It does not identify or encompass component parts for evaporative air coolers, such as Registrant’s connectors.”



In re Korn Ferry, 2024 USPQ2d 1166 (TTAB 2024) [precedential]. The Board upheld the USPTO’s refusal to register the mark KORN FERRY ARCHITECT absent a disclaimer of the word ARCHITECT, for, inter alia, “executive search, recruitment and placement services; business consultation services in the field of human resources management and development” and for “providing temporary use of online non-downloadable software in the field of human resources.” The examining attorney primarily argued that ARCHITECT is descriptive because the applicant “may provide its services for architects.” He also maintained that “architect” is a human resources industry term for “someone who sets the conceptual and political stage for accomplishing any work related to organizational issues or talent.” The evidence, however, failed to show that “architect” “identifies a defined position in the human resources field, or that it “immediately describes any quality, characteristic, feature, function, purpose, or use of any of the services identified in the application.” The Board noted that it has frequently acknowledged the “fine line between suggestive marks and descriptive terms,” and given that fine line, in this case “we must resolve any doubt in favor of finding the term [ARCHITECT] suggestive rather than descriptive.”

4. Section 2(f) Acquired Distinctiveness

In re Post Foods, LLC, 2024 USPQ2d 25 (TTAB 2024) [precedential]. The Board upheld a refusal to register the proposed multi-color mark shown here on the ground that the mark is not inherently distinctive, lacks acquired distinctiveness, and therefore fails to function as a source indicator. Post argued that its mark comprises the color combination applied to “crisp rice cereal pieces,” but the application identified the goods as “breakfast cereals,” not “crisp rice breakfast cereals.” As to distinctiveness, color marks are never inherently distinctive when applied to product configurations. *Wal-Mart Stores, 54 USPQ2d 1068.* Evidence of third-party multicolored cereals in various shapes, and Internet references to “rainbow-colored” cereals, undermined Post’s claim of acquired distinctiveness. The Board found a “mismatch” in Post’s claim of acquired distinctiveness because Post’s evidence related only to “Fruity Pebbles” crisp rice cereal, whereas the application at issue identified the goods broadly as “breakfast cereals.” “Simply put, Applicant’s extensive evidentiary showing relating to consumer recognition of its cereal’s color, shape, and texture misses the mark. . . . Applicant cannot rely upon evidence that conflates color and configuration to support its Section 2(f) claim.”



5. Failure to Function

In re Stallard, 2023 USPQ2d 1009 (TTAB 2023) [precedential]. The Board upheld a refusal to register the mark shown here, for video and computer game software, finding that the proposed mark fails to function as a source indicator for the identified goods. Reviewing Applicant Stallard’s webpage specimen of use, the Board concluded that “prospective consumers viewing the proposed mark on the webpage would have no reason to think that the cropped image of Maria’s head identifies the source of the goods.” The Board observed that “designations that merely identify a character in a creative work are not registrable, whether the character appears in a series or in a single work.” The issue here was whether the proposed mark merely depicts a character in the game, or whether consumers would perceive the proposed mark, as it appears on the specimen of use, as a source indicator. “The evidence shows that the proposed mark is merely associated with one character in the game, and it is not used in a way to identify and distinguish the source of the game itself” The position of the mark, “buried below text in the middle of the webpage, suggests that the image merely serves an informational function to familiarize prospective consumers with one of the two main characters of the game.” Thus, consumers “would have no reason to think that the cropped image of Maria’s head identifies the source of the goods.”



In re Black Card LLC, 2023 USPQ2d 1376 (TTAB 2023) [precedential]. In a rare reversal of a failure-to-function refusal, the Board found the USPTO’s evidence insufficient to establish that the phrase FOLLOW THE LEADER is incapable of serving as a source indicator for credit card incentive program, credit card financial, travel information, ticket reservation, travel advisory, salon and spa reservation, and concierge services. The Board observed that

“[t]he record need not necessarily include evidence of third-party use in connection with the specific services at issue for the evidence to support the failure to function refusal.” However, the evidence must demonstrate that the proposed mark “would convey a generally understood sentiment or meaning to the consumers of [Black Card’s] services such that they would not perceive it as signifying the source of the services.” The Board found that the phrase FOLLOW THE LEADER, though in common use, may convey different meanings depending on context. Based on the record evidence, the Board was unable to “reasonably infer” that FOLLOW THE LEADER “has a commonly understood meaning applicable to Applicant’s services that would render it incapable of being perceived as a source indicator for those services.”

6. Specimens of Use

In re Duracell U.S. Operations, Inc., 2023 USPQ2d 861 (TTAB 2023) [precedential].

Overturing a refusal to register Duracell’s sound mark consisting of three musical notes for batteries, the Board rejected the Office’s position that the specimens of use (.mp3 files) constituted mere advertising material. The Board ruled that transmission of the sound mark in retail locations where the goods are sold is “equivalent to” a display associated with the goods. Section 45 of the Trademark Act provides that, for goods, a mark is in use in commerce if “it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto” and “the goods are sold or transported in commerce.” Duracell submitted specimens in the form of .mp3 files, accompanied by a declaration stating that the specimens comprised “audio messaging” played in stores where Duracell’s batteries are sold. The three-note sound, referred to as the “slamtone,” typically appears near the end of each advertisement and is broadcast “as an inducement to purchasers to buy DURACELL batteries while shopping in the store.” The Board agreed with Duracell that the audio messaging is analogous to a traditional “shelf talker,” since the messages featuring Duracell’s sound mark have been played “in tens of thousands of stores where Applicant’s batteries are sold, often multiple times per hour, and in total the ads in question, and the slamtone, aired more than 100 million times.”



In re Weiss, 2024 USPQ2d 1376 (TTAB 2024) [precedential]. The Board affirmed a refusal to register the mark GABBY'S TABLE for "Computerized on-line retail store services in the field of food, cooking utensils, cookware, culinary arts cookbooks, magazines and videos, and lifestyle books, magazines and videos" because the specimen of use showed that Applicant Weiss "provides referrals of products for sale by third parties on their websites" and not the services recited in the application. Weiss's specimen comprised a webpage displaying a list of items that "Gabby's Table Recommends" for purchase. A picture of each item is displayed, along with a product description and a "buy now" button that re-directs the consumer to a third-party website where the item may be purchased (e.g., Amazon). The recommended items cannot be purchased directly via Weiss's website: "Applicant's specimen does not display, for instance, a virtual 'shopping cart' pricing, shipping information, or any other indicia of online retail store services." Weiss provided no evidence that “consumers clicking the “BUY NOW’ buttons on her website, upon being re-directed to a product description on a third-party vendor website where they may then purchase the product from that vendor, will perceive that Applicant herself is providing online retail store services.”

7. Single Work Refusal

***In re Wood*, 2023 USPQ2d 975 (TTAB 2023) [precedential].** The Board upheld a refusal to register CHURCH BOY TO MILLIONAIRE for, inter alia, “Books in the field of faith-based coaching, personal development, motivational and inspirational topics,” on the ground that the proposed mark is the title of a single creative work and thus fails to function as a trademark for the identified goods. The Board stated the issue as whether the Spanish-language version of Wood’s book is a “second or subsequent edition” of the English version “in which the content “[has] change[d] significantly.” TMEP Sec. 1202.8(b). The examining attorney pointed out that Applicant Wood did not argue, or provide any evidence, that the Spanish version has content that significantly differs from that of the English version. The Board agreed. “We do not rule out the possibility that creating a translation could yield a ‘second or subsequent edition’ of a book ‘in which the content [has] change[d] significantly.’ There is simply no evidence in the record here that the Spanish-language version of CHURCH BOY TO MILLIONAIRE is such a work.”

PART II. INTER PARTES CASES

A. *United States Court of Appeals for the Federal Circuit*

1. Section 2(d) Likelihood of Confusion

***Naterra Int’l, Inc. v. Bensalem*, 2024 USPQ2d 293 (Fed. Cir. 2024) [precedential].** The CAFC vacated and remanded the Board’s decision denying a petition for cancellation of a registration for the mark BABIES’ MAGIC TEA for “medicated tea for babies that treats colic and gas and helps babies sleep better.” The Board found no likelihood of confusion with the registered mark BABY MAGIC for various toiletry products (including baby lotion). The court ruled that the basis for the Board’s finding as to the second *DuPont* factor was unclear, that the Board had ignored certain evidence bearing on the third factor, and that it erred in failing to weigh the first factor heavily in favor of Petitioner Naterra. “This court’s holding in *Detroit Athletic* is instructive, where we found that similarity of the marks [DETROIT ATHLETIC CO. and DETROIT ATHLETIC CLUB] ‘weighs heavily in the confusion analysis’ because the Board found that the marks’ “lead words are their dominant portion and are likely to make the greatest impression on consumers.” Here, the Board found that “the first two words of [the] BABIES’ MAGIC mark and the entirety of [the] BABY MAGIC mark look and sound almost the same and have the same connotation and commercial impression.” Furthermore, as in *Detroit Athletic*, the Board found that TEA is “a generic term” having “no source-identifying. The CAFC agreed with Naterra that this factor “should—at a minimum—weigh heavily in favor of finding a likelihood of confusion if not be dispositive in the analysis.”

***Bureau National Interprofessionnel du Cognac, Institute National de Appellations d’Origine v. Cologne & Cognac Entertainment*, 2024 USPQ2d 1421 (Fed. Cir. 2024) [precedential].** The CAFC vacated and remanded the Board’s decision dismissing an opposition to registration of the mark shown here, for music and musical production services. The opposers claimed likelihood of confusion with, and likely dilution of, the COGNAC common law

certification mark, but a divided Board panel found that the relevant *DuPont* factors either favored the applicant or were neutral. The CAFC disagreed, ruling that the Board applied an incorrect legal standard for fame and erred in analyzing the similarity of the marks and the relatedness of the goods/services. The Board also erred in dismissing the dilution claim as inadequately pled. Most significantly, the appellate court ruled that the Board erroneously required that the opposers show that COGNAC is famous for its “certification status” rather than for its geographical significance or other characteristics (e.g., quality). The court agreed with opposers that the question was whether COGNAC is famous as a designator of regional origin. The Board also erred in requiring “unequivocal evidence that the volume of sales of certified goods “was driven by the COGNAC mark to rebut the presumption that [the Board] applied that the commercial evidence was attributable to the (accompanying house mark alone.”



2. Priority

***Araujo v. Framboise Holdings Inc.*, 2024 USPQ2d 791 (Fed. Cir. 2024) [precedential].** The CAFC affirmed the Board’s decision sustaining a Section 2(d) opposition to registration of the mark #TODECACHO for hair combs, on the ground of likelihood of confusion with Opposer Framboise Holdings Inc.’s common law mark (shown here), for hair products. Araujo argued that the Board abused its discretion when it extended Framboise’s testimony period on the last day, and further that the Board’s finding of priority in favor of Framboise on the basis of a single declaration was unsupported by substantial evidence. The CAFC disagreed on both points. It concluded that the Board applied the correct good cause standard and reasonably found good cause to grant the extension. As to the declaration, the Board found it to be “clear, convincing, and uncontradicted.” It included a list of products and specific dates of first use, along with representative examples of the mark as display on products in stores. Araujo did not offer any evidence nor did he depose the declarant. “[A] reasonable mind could conclude that Framboise had established its priority date by a preponderance of the evidence,” observing that “oral testimony, if sufficiently probative, is normally satisfactory to establish priority of use in a trademark proceeding”



3. Fraud

***Great Concepts, LLC v. Chutter, Inc.*, 2023 USPQ2d 1215 (Fed. Cir. 2023) [precedential].** A divided CAFC panel reversed and remanded the TTAB’s decision in *Chutter, Inc. v. Great Management Grp., LLC*, concluding that “a Section 14 cancellation proceeding is not available as a remedy for a fraudulent Section 15 incontestability declaration.” The Board had ordered cancellation of Great Concepts’ registration for the mark DANTANNA’S for restaurant services, finding that Great Concepts’ counsel had signed the Section 15 Declaration with reckless disregard for the truth, and, in a significant ruling, holding for the first time that “reckless disregard is equivalent to intent to deceive and satisfies the intent to deceive requirement” for a fraud claim. The CAFC ignored the “reckless disregard” portion of the Board’s decision and directed the Board to consider “whether to declare that Great Concepts’

mark does not enjoy incontestable status and to evaluate whether to impose other sanctions on Great Concepts or its attorney.” The panel majority focused on the language of Section 14, which “permits a third party to file ‘[a] petition to cancel a registration of a mark’ ‘[a]t any time if’ the registered mark’s ‘registration was obtained fraudulently.’” It concluded that “fraud committed in connection with obtaining incontestable status is distinctly not fraud committed in connection with obtaining the registration itself.” The majority further observed that Section 14 lists a number of bases for cancellation of a registration, but fraud committed in connection with an incontestability declaration is not one of them.

4. Entitlement to a Statutory Cause of Action

***Luca McDermott Catena Trust v. Fructuoso-Hobbs SL*, 2024 USPQ2d 941 (Fed. Cir. 2024) [precedential].** The CAFC affirmed the Board’s dismissal of two petitions for cancellation on the ground of lack of entitlement to a statutory cause of action under Section 1064 of the Trademark Act. The appellant, a limited partner of the Paul Hobbs Winery, challenged registrations for the marks ALVAREDOS-HOBBS and HILLICK AND HOBBS on two grounds, likelihood of confusion and fraud, but failed to satisfy the *Lexmark* test because it lacked a direct commercial interest in the PAUL HOBBS mark being asserted, and because any injury it might suffer was too remote. The appellant had Article III standing (“constitutional standing”) because its alleged injury - the diminishment of the value of its investment in Hobbs Winery - satisfied the “injury-in-fact” requirement. However, because the only basis for the appellant’s challenge was its minority interest in the owner of the mark, and not its own commercial activity, “it is not within the zone of interests entitled to seek cancellation of those marks under Section 1064.” Moreover, even if the appellant’s claims fell within the zone of interests of Section 1064, it could not satisfy the proximate causation requirement. “The applicant’s injury is derivative: absent injury to Hobbs Winery’s mark, there can be no injury to appellant. In sum, the appellant’s injury, like that of the landlord or the electric company mentioned in *Lexmark*, is too remote to provide the appellant with a cause of action under Section 1064.”

B. Trademark Trial and Appeal Board

1. Section 2(d) Likelihood of Confusion



***KME Germany GmbH v. Zhejiang Hailiang Co., Ltd.*, 2023 USPQ2d 1136 (TTAB 2023) [precedential].** The Board sustained this opposition to registration of the mark HME in stylized form for various types of pipes and other building products, finding confusion likely with opposer’s mark KME for overlapping goods. There was no dispute regarding priority, nor regarding the similarity of the goods, channels of trade, and classes of consumers. The Board found opposer’s mark to be “inherently distinctive and conceptually strong, of average commercial strength.” “Opposer’s history of renaming and restructuring itself, combined with Opposer’s prior ownership of Applicant’s brass division, industry norms concerning legal entity changes, and the similarities between the marks and the goods sold thereunder, outweigh any sophisticated purchasing decision.” Furthermore, the parties’ market interface weighed slightly in favor of opposer “to the extent the parties acknowledged a need for Applicant to

choose a non-confusingly similar mark.” According to the Board, “[t]his case presents an opportunity for the Board to expand the types of ‘market interfaces’ relevant under the tenth *DuPont* factor to include the sale of a portion of an ongoing business to a direct competitor, and to consider the impact of certain ‘agreement provisions’ in the APA [Share Asset Purchase Agreement] ‘designed to preclude confusion.’”

Monster Energy Co. v. Critical Role, LLC, 2023 USPQ2d 1382 (TTAB 2023)

[precedential]. Deeming the first *DuPont* factor to be dispositive, the Board granted Applicant Critical Role, LLC’s motion for summary judgment, dismissing Opposer’s Monster Energy’s Section 2(d) claim. Monster alleged a likelihood of confusion between its registered “Claw” design mark for various goods and

services, and applicant’s “Circled MV” design mark for goods and services in eight classes. but the Board found that the “clear visual distinctions between the marks create very different

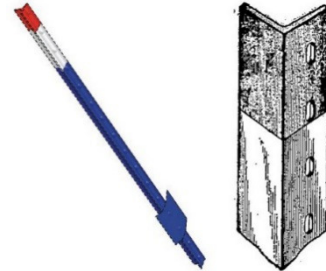
Opposer's Claw Mark	Applicant's Mark
	

commercial impressions.” Critical Role did not move for summary judgment as to Monster’s Section 43(c) dilution-by-blurring claim, but it maintained that the ruling on the Section 2(d) claim rendered the dilution claim moot. Not so, said the Board, pointing to Section 43(c)(1), which states that a claim for dilution is available “regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.” And so, Monster’s unchallenged dilution claim remained.

Sage Therapeutics, Inc. v. SageForth Psychological Serv., LLC, 2024 USPQ2d 689

(TTAB 2024) [precedential]. The Board sustained this Section 2(d) opposition to registration of the mark SAGEFORTH for “providing information in the field of psychological counseling, assessments, diagnosis, and treatment,” in view of the registered mark SAGE CENTRAL for “providing health and medical information about postpartum depression and treatment.” The Board focused on opposer’s mark SAGE CENTRAL, finding applicant’s mark SAGEFORTH to be similar in appearance, sound, meaning, and commercial impression. “The common ‘sage’ element of the marks anchors them in a way to the same theme and creates a risk that consumers will mistakenly assume connections between the services provided under the marks.” Applicant’s counterclaim sought to restrict four registrations for the mark SAGE THEREAPEUTICS in various forms to “a house mark for pharmaceutical preparations that treat post-partum depression.” The Board deemed the counterclaim to be moot, since the four targeted registrations were not included in its Section 2(d) analysis. Dismissing the Section 18 counterclaim but without prejudice, the Board stated: “we see no reason why Applicant should not retain the right to bring a counterclaim against any of the registrations asserted against it”

Keystone Consolidated Industries, Inc. v. The Franklin Investment Corp. DBA Franklin Industries, 2024 USPQ2d 2025 (TTAB 2024) [precedential]. Inter partes proceedings involving two color marks are as rare as a traffic cop in Boston. The Board denied this petition for cancellation of a supplemental registration for the color mark (red-white-and-blue) shown in Fig. 1, finding confusion unlikely with the registered color mark (red top) shown in Fig. 2, both for metal fence posts. In a 69-page decision, the Board found the first *DuPont* factor - the dissimilarity of the marks - to be dispositive. The Board pointed out that the similarity of the marks must be decided “primarily on the basis of visual similarity, which has been described as a ‘subjective eyeball test.’” Critically, as to appearance, the Board found the marks dissimilar: [t]he commercial impression of Petitioner’s Red Top Fence Post Mark, is a ‘red top,’ and the color red.” On the other hand, consumers would perceive respondent’s Red, White and Blue Fence Post Mark as referring to “the national colors of the United States of America, or the flag of the United States of America.”



2. Priority

Andrusiek v. Cosmic Crusaders LLC, 2024 USPQ2d 21 (TTAB 2024) [precedential]. The Board granted a petition for cancellation of a registration for the mark CAPTAIN CANNABIS for comic books, on the ground of likelihood of confusion with Petitioner Andrusiek’s identical mark, for which he claimed prior use for comic books. Andrusiek’s “actual” trademark use on comic books did not begin until 2017, but from 2006 he used the term as the name of a character, which the Board accepted as use analogous to trademark use, leading to the award of priority to Andrusiek. The question, then, was whether Andrusiek made technical trademark use (or “actual use,” as the Board put it) of the CAPTAIN CANNABIS mark within a reasonable time after his analogous use. Andrusiek submitted evidence of such technical trademark use from 2016 and 2017, including displays of comic book covers on Amazon.com, on YouTube, and in other media. The Board found that “Petitioner’s actual trademark use in 2017 was within a commercially reasonable period of time following his analogous use in 2013-14 so as to create a ‘continuing association of the mark’ with Petitioner’s goods.” Viewing the evidence as a whole, “as if each piece of evidence were part of a puzzle,” the Board found that “when fitted together,” the puzzle pieces established prior use by Andrusiek.

State Permits, Inc. v. Fieldvine, Inc., 2024 USPQ2d 1458 (TTAB 2024) [precedential]. In a “somewhat unusual” Section 2(d) cancellation proceeding targeting a Supplemental Register registration and involving “dueling claims of acquired distinctiveness,” the Board granted a petition for cancellation of Fieldvine’s Inc.’s registration for the mark PERMITS.COM for construction permit services. Although Petitioner State Permits, Inc. could not prove acquired distinctiveness for its mark PERMIT.COM, it did prove first use for identical services, and that was enough. Unlike in a challenge to a registration on the principal register, where the challenger must prove prior proprietary rights in its mark, if the challenged registration resides on the Supplemental Register and covers a descriptive term that lacks acquired distinctiveness, a prior user of a confusingly similar term may succeed in cancelling that registration even without establishing acquired distinctiveness for its own mark. As the CAFC

observed in *Books on Tape*, “it would be an ‘anomalous result’ if, in view of our finding of a likelihood of confusion, Respondent is permitted to keep its Supplemental Register registration for PERMITS.COM, in the absence of a showing of acquired distinctiveness and in the face of Petitioner’s prior use of PERMIT.COM.”

3. Abandonment

***Adamson Systems Engineering, Inc. v. Peavey Elec. Corp.*, 2023 USPQ2d 1293 (TTAB 2023) [precedential]**. The Board granted a petition for cancellation of a registration for the mark CS for “amplifiers,” finding that Respondent Peavey had discontinued use of the CS mark on amplifiers, with an intent not to resume use. Peavey’s *de minimis* domestic sales of amplifiers under the CS mark between 2016 and 2021 were “insufficient to constitute bona fide use of that mark in the ordinary course of trade,” and there was no evidence “showing any intention to resume use of the mark, much less evidence excusing Respondent’s extended period of nonuse.” “[L]ooking at the evidence as a whole, as if each piece were part of a puzzle to be fitted together,” the Board found that Peavey’s use of the CS mark was “sporadic, casual, and nominal” from 2016 through 2021, and “would not even meet the lower, pre-TLRA standard of use in commerce, much less the current higher standard of bona fide use made in the ordinary course of trade.” Although there was *bona fide* use of the CS mark on amplifiers from 2012 through 2015, sales then plummeted, “dwindling to single digits and then zero at some points in the critical 2016-2021 time frame.”

4. Fraud

***Look Cycle International v. Kunshan Qiyue Outdoor Sports Goods Co., Ltd.*, 2024 USPQ2d 1424 (TTAB 2024) [precedential]**. Findings of fraud are few and far between, but here the Board found that, in respondent’s underlying application for the mark BLOOKE for bicycles, parts, and accessories, respondent’s false statements regarding use of its mark were made either with the intention to deceive the USPTO or with reckless disregard for the truth, and therefore constituted fraud. The evidence demonstrated “knowing intentional deception,” but “even if the evidence were not sufficient to reveal such intention directly, at a minimum, the facts



of this case demonstrate reckless disregard for the truth from which we infer the requisite intent.” The Board then went on to find confusion likely with petitioner’s registered mark (above left) and its common law mark (above right) for overlapping goods, questionably ruling that since the respondent’s mark is registered in standard characters, the Board must consider “possible displays that emphasize the common element LOOK such as bLOOKE or BLOOKE.” And, finally, the Board deemed the BLOOKE registration void *ab initio* because respondent’s mark was not in use for any of the identified goods as of the filing date of the underlying application.

5. Nonuse

***Blizzard Entertainment, Inc. v. Ava Labs, Inc.*, 2024 USPQ2d 1299 (TTAB 2024)**. In this opposition to registration of the mark BLIZZARD for various business services, Applicant Ava Labs, Inc., counterclaimed to cancel two pleaded registrations owned by Opposer Blizzard Entertainment for online retail store and mail order services. Ava Labs asserted that the registered marks BLIZZARD and BLIZZARD ENTERTAINMENT have never been used or have been

abandoned because the offering of one's own goods does not constitute a service done primarily for the benefit of others and therefore does not qualify as use of the marks. The Board disagreed. The question was "whether, as a matter of law, online retail store or mail order activities featuring only a party's own goods are 'services' as contemplated in the Trademark Act." The Board observed that "it has long been recognized that gathering various products together, making a place available for purchasers to select goods, and providing any other necessary means for consummating purchases constitute the performance of a service." Furthermore, the Board has implicitly recognized that retail store activities featuring one's own goods are services, acknowledging that "if a retail store also uses the name of the store on the goods themselves, the same mark can serve both a trademark and service mark function." The Board concluded that Blizzard's activities under the marks constitute use of the marks that satisfies the requirement of the Trademark Act.

6. Subject Matter Jurisdiction

MyMeta Software, Inc. v. Meta Platforms, Inc., 2024 USPQ2d 780 (TTAB 2024) [precedential]. The Board denied Applicant Meta Platforms, Inc.'s motion to dismiss this Section 2(d) opposition, rejecting its claims that the Board lacked subject matter jurisdiction (FRCP 12(b)(1)) and that Opposer MyMeta Software, Inc. failed to state a claim upon which relief can be granted (FRCP 12(b)(6)). MyMeta Software, Inc. obtained an extension of time to oppose Meta Platforms' application to register META for a host of computer-related services. When the notice of opposition was filed, the ESTTA cover sheet named MyMeta Software, Inc. as the opposer, but the notice itself named myMeta SRL as the opposer. Based on the cover sheet, however, the Board considered MyMeta Software, Inc. as the opposer. Applicant Meta Platforms argued that because the amended notice naming a different opposer was filed outside the extended opposition period, the amendment was untimely and so the Board lacked jurisdiction. The Board disagreed. "Because the Board already considered MyMeta Software as the opposer in the timely filed July 14, 2023, notice of opposition, MyMeta Software's amended pleading is not an untimely effort to bring an opposition." Meta Platforms also claimed that Meta Software, Inc. could not rely on a pending application owned by myMeta SRL, but the Board concluded that under Delaware law, MyMeta Software, Inc. is the domestication of myMeta SRL, an Italian entity, and therefore myMeta SRL's rights are vested in MyMeta Software, Inc.

7. Sovereign Immunity

Mountain Gateway Order, Inc. v. Virginia Community College Sys., 2024 USPQ2d 1025 (TTAB 2024) [precedential]. In this opposition to registration of the mark MOUNTAIN GATEWAY COMMUNITY COLLEGE for educational services and various clothing items, Applicant Virginia Community College Systems moved for summary judgment, asserting that the Board lacked subject matter jurisdiction due to state sovereign immunity. Opposer did not dispute that applicant is a state agency, and so the question was "whether Applicant enjoys sovereign immunity." The Board denied the motion, ruling that sovereign immunity does not apply to opposition proceedings. It observed that states that apply for trademark registration "are subject to the same registration provisions of the Trademark Act as any other applicant, including that a State's application is subject to opposition proceedings." "Applicant chose to apply for federal trademark registrations that would evidence its presumed nationwide exclusive rights to use marks in commerce, 15 U.S.C. § 1057(b), a choice with consequences for the public.

Applicant’s status as a juristic person under the Trademark Act, and the public interest in the integrity of the trademark registration system, dictate that Applicant is subject to opposition proceedings and that sovereign immunity does not apply to opposition proceedings.”

8. Claim/Issue Preclusion

Hollywood Casinos, LLC v. Zarco Hotels Inc., 2024 USPQ2d 985 (TTAB 2024)
[precedential]. The Board denied Applicant Zarco Hotels’ construed motion for summary judgment in this opposition to registration of HOLLYWOOD HOTEL for hotel and restaurant services, ruling that claim preclusion, based on an earlier opposition, did not apply. The “Prior Opposition” raised a claim of likelihood of confusion with two registered marks. The opposer moved to amend to add a geographical descriptiveness claim but the Board denied that motion as untimely. The Board ultimately sustained the opposition on the ground of nonownership and it did not reach the likelihood of confusion claim. Here, Applicant Zarko conceded that the likelihood of confusion claim was not barred in its entirety, but argued that it should be limited to the two registered marks in the Prior Opposition. The Board disagreed. “Because Opposers’ original likelihood of confusion claim is not extinguished ... Opposers’ amended likelihood of confusion claim based upon their additional registrations and common law rights that could have been raised in the Prior Opposition also is not extinguished. There is no reason why claim preclusion would apply to only the latter claim and not the former.” As to the geographical descriptiveness claim there was no prior decision on the merits. The refusal to add that claim was not appealable since Opposer Hollywood Casinos obtained all the relief it sought, and so claim preclusion cannot apply.

Common Sense Press Inc. v. Van Sciver, 2023 USPQ2d 601 (TTAB 2023)
[precedential]. In a rather straightforward ruling, the Board held that “the termination of a reexamination or expungement proceeding in favor of a registrant cannot be the basis for the registrant’s assertion of claim or issue preclusion in a proceeding before the Board to cancel that registration.” In October 2020, Common Sense petitioned to cancel a registration for the mark COMICS GATE for “comics,” claiming nonuse, abandonment, and fraud. In March 2023, it filed a petition to the Director under Section 1066b, requesting reexamination of the challenged registration. The reexamination proceeding was terminated in respondent’s favor on January 6, 2023. Denying respondent’s subsequent motion for judgment, the Board pointed out that nothing in the Trademark Act or the Rules of Practice limits a party’s ability to petition to cancel a registration just because the registration is or has been the subject of a reexamination or expungement proceeding. Furthermore, the Board noted that because reexamination is an *ex parte* proceeding, the reexamination determination cannot, under general legal principles, have a preclusive effect on a non-participant who has no right to appeal from the decision.

9. Section 18 Petition for Restriction

Iron Balls Int'l. v. Bull Creek Brewing, LLC, 2024 USPQ2d 1004 (TTAB 2024)

[precedential]. Attempting to side-step a Section 2(d) refusal of the mark shown here, for “gin,” Iron Balls petitioned to restrict Respondent Bull Creek’s registration for the mark IRON BALLS for “beer” to “micro-brewed craft beer.” The Board found that the proposed restriction would not avoid a likelihood of confusion, and so it denied the petition. Under Section 18 of the Trademark Act, “[a] party seeking to restrict a registrant’s broadly worded identification of goods under Section 18 must plead and prove ‘(1) that the registrant is not using its mark on goods or services that would be excluded by the limitation, and (2) that the limitation would result in the avoidance of a finding of a likelihood of confusion.’” As to the first requirement, the Board found it significant that Bull Creek represented itself as a “craft brewery” and displayed the “Independent Craft Brewer Seal” on its labels, and so it concluded that relevant purchasers would see respondent as a “brewer with a limited, small batch output” and would consider it to be a “craft microbrewery” and its goods “micro-brewed craft beer.” However, as to the second requirement, “even if Respondent’s goods could be characterized as ‘micro-brewed craft beer,’ and even if its identification of goods were so restricted, the restriction would not avoid a likelihood of confusion.”



10. Timeliness of Claims

Thrive Natural Care Inc. v. Nature’s Sunshine Prods., Inc., 2023 USPQ2d 953 (TTAB

2023) [precedential]. In this proceeding for cancellation of a registration for the mark SUBSCRIBE & THRIVE for “online ordering” featuring skin care products and supplements, Respondent Nature’s Sunshine counterclaimed for cancellation of one of Petitioner Thrive’s pleaded registrations for the mark THRIVE on two grounds: fraud and violation of the “antiassignment” provision of Section 10(a)(1) of the Trademark Act. The Board dismissed the fraud claims due to the lack of fact-based allegations regarding the falsity of Thrive’s statements and its purported intent to deceive the USPTO. As to the Section 10 counterclaim, Thrive argued that it was barred by Section 14 because the challenged registration was more than five years old. The Board agreed. Section 14(3) “reflects Congress’s intent to protect registrations that are more than five years old from challenges in perpetuity, except on certain enumerated grounds.” Violations of the anti-assignment provision of Section 10(a)(1) are not included in the list of permitted claims. Moreover, the Board pointed out that “had Congress intended to include such claims in Section 14(3), it certainly could have done so.”

Taylor v. Motor Trend Grp., LLC, 2023 USPQ2d 1051 (TTAB 2023) [precedential].

The Board dismissed this petition for cancellation filed during the six-month grace period for the (second) renewal of the challenged registration. When the registrant did not file its renewal application, the registration automatically expired as of its 20th anniversary date, and so the later-filed petition for cancellation was deemed moot. Registrant Motor Trend’s Section 8 Declaration of Use and Section 9 Renewal application for its 20-year-old registration were due on October 22, 2022. However, Section 8(a)(3) and Section 9(a) of the Trademark Act provide

for a six-month grace period within which to file renewal documents. The subject petition for cancellation was filed on March 1, 2023, within the grace period for renewal. On May 11, 2023, the Board issued an order under Rule 2.134(b), requiring Motor Trend to show cause why its failure to renew should not be deemed the equivalent of a cancellation by request without the consent of the petitioner, resulting in judgment for petitioner. Motor Trend responded by moving to dismiss the proceeding as moot. The Board agreed with Motor Trend, ruling that “if a combined Sections 8 and 9 affidavit is not filed by the end of the grace period, a registration expires by operation of law as of the last day of its ten-year term, and no rights in the registration exist after that date.” Therefore, the subject registration had expired on October 22, 2022.

The Men’s Warehouse, LLC v. WKND NYC LLC, 2024 USPQ2d 86 (TTAB 2024) [precedential]. In a variation of the ruling in *Taylor v. Motor Trend*, the Board held that a cancellation proceeding commenced during the Section 8 grace period for the target registration is mooted if the registrant does not timely file its Declaration of Use. *Taylor v. Motor Trend* concerned the failure to file a renewal application before the expiration of the six-month grace period. Here, the Board dealt with the non-filing of a Section 8 Declaration of Use before the end of the six-month grace period following the sixth anniversary of a registration. Respondent WKND’s registration issued on March 14, 2017, and so its Section 8 declaration was due by March 14, 2023. Warehouse’s petition for cancellation was filed on March 15, 2023, one day after the Section 8 deadline but before September 14, 2023, the expiration of the six-month grace period for the declaration. The Board promptly instituted the proceeding, since the USPTO had not yet entered the expiration and cancellation of the registration into the trademark database. The Board, applying the principles of *Taylor v. Motor Trend*, concluded that WKND’s registration expired by operation of law as of March 14, 2023, and so the subject petition for cancellation filed on the following day was moot. The petition was therefore dismissed without prejudice.

Retrobrands Am. LLC v. Molson Coors Beverage Co. USA LLC, 2024 USPQ2d 769 (TTAB 2024) [precedential]. In another precedential procedural ruling, the Board held that, because a registration expires by law as of its sixth anniversary if a Section 8 declaration is not filed before the expiration of the six-month grace period, a petition for cancellation filed during the grace period will be deemed moot if the declaration is not filed, and consequently judgment cannot be entered against the respondent. Retrobrands petitioned to cancel a registration for the mark ZIMA for “Alcoholic flavored brewed malt beverages, except beer,” on the ground of abandonment. The petition was filed during the grace period. Molson moved to dismiss the petition as moot, arguing that, because it did not plan to file a Section 8 Declaration, the registration expired as a matter of law at the six-year deadline. Retrobrands argued that this was effectively an attempt by Molson to cancel the registration without consent under Section 7(e) of the Trademark Act, thereby avoiding judgment against it. The Board declined to consider Molson’s request as a voluntary surrender of the registration, but saw it merely as a premature request for dismissal. The Board therefore denied Retrobrands’ motion for entry of judgment and dismissed the petition “without prejudice as moot.”

11. Other Procedural Issues

Monster Energy Co. v. Coulter Ventures, LLC, 2023 USPQ2d 916 (TTAB 2023) [precedential]. In this consolidated opposition proceeding involving Applicant Coulter’s mark MONSTER LITE for weightlifting equipment, the parties served four expert reports: an initial report by Monster (“MEC”), a rebuttal report by Coulter, a sur-rebuttal report by MEC, and then a sur-sur-rebuttal report by Coulter. The Board granted MEC leave to serve its sur-rebuttal report but limited it to a critique of Coulter’s report. As to MEC’s sur-rebuttal report, the Board observed that, as in *NewEgg Inc. v. Schoolhouse Outfitters, LLC*, the report includes “new evidence in the form of a different survey performed according to a different methodology on the issue of likelihood of confusion.” The Board found that “it would serve the interest of fairness, and allow the Board to make a just determination of the merits of the case, to allow MEC to submit expert testimony opining on the survey in the [Coulter] Rebuttal.” However, “[a]ny portion that constitutes bolstering of the [original MEC] Report will not be considered.” Finally, as to Coulter’s sur-sur-rebuttal expert report, the Board drew a line in the sand, holding that “sur-sur-rebuttal expert reports will not be permitted under any circumstances.”

Sterling Comput. Corp. v. Int’l Business Machines Corp., 2023 USPQ2d 1050 (TTAB 2023) [precedential]. Sterling Computers opposed IBM’s Section 66(a) applications to register the marks STERLING and IBM STERLING for various Class 42 services. In its notice of opposition, opposer claimed a likelihood of confusion with its marks STERLING, in standard character and design form, and STERLING COMPUTERS. On its ESTTA cover sheet, opposer



listed pending applications for all three marks, as well as common law rights in the mark STERLING COMPUTERS. When it filed an amended notice of opposition, opposer added common law rights in its STERLING marks. IBM objected because those added common law rights were not included on the ESTTA cover sheet. The Board, however, sided with opposer: “The Board holds that identification of a use-based application or registration under Trademark Act Section 1(a) on the ESTTA cover sheet as grounds for an opposition against a Section 66(a) application based on likelihood of confusion claim is sufficient to satisfy the requirement to notify the IB of plaintiff’s reliance on common law rights that are coterminous with that pleaded use-based application or registration under Trademark Rules 2.104(c) and 2.107(b).”

Paul Reed Smith Guitars v. Gibson Brands, Inc., 2024 USPQ2d 11 (TTAB 2023) [precedential]. The Board unsurprisingly severed Respondent Gibson’s permissive counterclaim that had a minimal relationship to the petitioners’ cancellation claim. The Board concluded that judicial economy would be served by severance, and further found that joint Petitioner The Estate of Theodore M. McCarty would be prejudiced by the delay caused by discovery on the counterclaim for cancellation of a registration owned by Paul Reed Smith Guitars, since Estate was not a party to the counterclaim. Petitioners sought cancellation of Gibson’s registration for the mark THEODORE for “stringed musical instruments,” claiming likelihood of confusion with the mark MCCARTY for guitars under Section 2(d), and false suggestion of a connection under Section 2(a). Gibson’s permissive counterclaim targeted Paul Reed Smith’s registration for the unpleaded mark SILVER SKY NEBULA for guitars, on the ground of likely confusion with Gibson’s common law mark SILVERBURST for musical

instruments. The Board agreed with the petitioners that “their claims and the permissive counterclaim do not arise out of the same transaction, occurrence, or series of transactions or occurrences or share questions of law or fact.” And so, the Board granted the motion to sever and ordered that a new cancellation proceeding be instituted for Gibson’s counterclaim.

12. Discovery and Motion Practice

DoorDash, Inc. v. Greenside Holdings, LLC, 2024 USPQ2d 935 (TTAB 2024)

[precedential]. Trademark bullies breathed a sigh of relief when, in this opposition to registration of the mark shown here for delivery of medical cannabis via car service, the Board rejected Applicant Greenside’s affirmative defense of unclean hands. Opposer DoorDash alleged likelihood of confusion with eight registered DOORDASH marks for various goods and services, including food delivery. Greenside asserted that DoorDash has misused its trademarks in a “longstanding and habitual practice of trademark bullying” by opposing a “significant number of applications” on “dubious, weak or exaggerated” grounds. The Board granted DoorDash’s motion to strike that defense. “The Trademark Act does not refer to ‘trademark bullying’ explicitly or even implicitly.” The Board has previously considered assertions of “unclean hands” based on “overzealous enforcement” but found that this defense “does not apply to a registrant “seek[ing] to protect its rights in its registered marks, and preclud[ing] the registration of what it believes to be a confusingly similar mark.” Here, the Board found that DoorDash is “merely exercising its right to protect its marks.”



RLP Ventures, LLC v. Panini Am., Inc., 2023 USPQ2d 1125 (TTAB 2023)

[precedential]. In this Section 2(d) opposition to registration of the mark MOSAIC for “Collectible trading cards; Sports trading cards,” Opposer RLP Ventures, appearing pro se, seriously botched its attempt to submit evidence and testimony. The Board struck RLP’s notice of reliance but nonetheless allowed it to file an amended notice, and the Board re-opened RLP’s testimony period so it could file a supplemental testimony declaration authenticating certain exhibits. Notice of Reliance: RLP “dumped into the record” numerous documents not admissible by notice of reliance: Panini’s discovery requests, RLP’s own disclosures and discovery responses, and RLP’s documents responsive to Panini’s production requests. The Board struck RLP’s notice of reliance in its entirety but allowed it to file a “proper notice of reliance” confined to those documents already properly submitted. Testimony Declaration: Panini objected to several exhibits attached to RLP’s testimony declaration as lacking proper foundation. The Board re-opened RLP’s testimony period for the sole purpose of allowing it to lay a proper foundation for the documents submitted during its testimony period.

Instagram, LLC v. Instagoods Pty Ltd, 2023 USPQ2d 1185 (TTAB 2023)

[precedential]. In this consolidated opposition proceeding concerning likelihood of confusion and dilution of the mark INSTAGRAM, the Board granted Instagram’s motion for leave to take the discovery depositions of two Australia-based officers of Instagoods by oral examination via videoconference. Instagoods refused to consent to the request, but the Board found that Instagram established “good cause” under Rule 2.120(c)(1). It noted that the witnesses are the

only individuals with knowledge regarding issues pertinent to the pleaded claims. Moreover, oral depositions “are likely to aid in the furtherance of discovery in this proceeding, particularly where Instagram has had difficulty obtaining information regarding (former Instagoods employee) Ms. Willis’ role with Instagoods and her prior-filed applications through written discovery.” The fact that the depositions may be conducted without the need for translations and Instagram’s willingness to coordinate the depositions according to the schedules of the witnesses further supported a finding of good cause. The Board also found that videoconference was an appropriate method for taking the deposition since it “will promote flexibility and reduce costs to the parties, particularly where the parties may elect to break up the depositions into segments to accommodate the witnesses’ schedules.”