



# WITCON 2014

BANNER & WITCOFF'S CORPORATE  
INTELLECTUAL PROPERTY SEMINAR

FRIDAY, SEPTEMBER 19, 2014  
8:30 A.M. TO 4:30 P.M.  
CHICAGO, ILLINOIS

## Recent Developments in TTAB Practice and Procedure

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***Amanda Blackhorse et al. v. Pro-Football, Inc., 111  
USPQ2d 1080 (TTAB 2014)***

**WASHINGTON**



**REDSKINS**

- For Second Time, TTAB concluded that Pro Football , Inc.'s federal registrations comprised of or including the term "REDSKINS" should be cancelled on the basis of Section 2(a) – disparagement



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## ***Amanda Blackhorse et al. v. Pro-Football, Inc.*** continued

Section 2(a) Disparagement :

- (1) What is the meaning of the term in question as it appears in the mark and as it is used in connection with the identified goods and services and
- (2) Does the meaning of the mark disparage Native Americans
  
- Key Issue:
- The relevant time period for determining answers to (1) and (2) is at the time of the date of registration, not the date of the challenge



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*In re New York Football Giants, Inc.*





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## *In re New York Football Giants, Inc.* (SN 85599795) (July 3, 2014 – TTAB Unpublished Opinion)

- NY Football Giants applied to register G-MEN for various clothing articles with no limitations or restrictions in goods ID
- PTO refused registration based on prior registration for G-MAN SPORT & Design, also for clothing items
- NY Giants argued Board should take into account marketplace conditions for its goods (essentially, that the Board should not follow its precedent and should give greater weight to alleged marketplace circumstances)
- Board reminded NY Giants in unequivocal terms that its precedent required assessing LOC based on the similarity/dissimilarity of goods as described in the application



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## *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 134 S.Ct. 2899 (U.S. July 1, 2014)

- B&B Hardware filed a petition for writ of certiorari requesting the review of the Eighth Circuit decision
- B&B sued for trademark infringement claiming that Hargis' use of SEALTITE for "self-drilling and self-taping screws" infringed B&B's SEALTIGHT trademark for fasteners used in the aerospace industry
- The TTAB sustained B&B's opposition in view of likelihood of confusion
- The district court and Eighth Circuit held that the TTAB decision was not to be given preclusive effect on the issue of likelihood of confusion in an infringement proceeding because it is not an Article III court
- The Supreme Court will review:
  - (a) whether the TTAB's finding of LOC precludes Hargis from re-litigating the issue in an infringement proceeding where LOC is an element and
  - (b) if issue preclusion does not apply, whether the district court was obliged to defer to the TTAB's finding of LOC absent strong rebuttal evidence



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*Hana Financial, Inc. v. Hana Bank, et al.*, 735 F.3d 1158  
(9th Cir. 2013), petition for certiorari filed, 82 U.S. L. W.  
3616 (U.S. Apr. 7, 2014)

- Supreme Court granted a writ of certiorari on issue of whether “tacking” is an issue of fact for a jury or an issue of law for the court
- Hana Financial alleged that “Hana Bank” infringed its trademark rights.
- Hana Bank argued that it could tack “Hana Overseas Korean Club” to its later use of “Hana World Center” and that “Hana World Center” could then be tacked to “Hana Bank”
  - Tacking doctrine permits a party to “tack” the use of an older mark onto a new mark for priority purposes; however, marks must be “legal equivalents”
- The district court held that tacking is a factual question and submitted it to the jury which ruled for Hana Bank
- The Ninth Circuit affirmed, but indicated that the result would perhaps be different if tacking were considered a legal issue



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*Pom Wonderful LLC v. Coca-Cola Co.*, 134 S.Ct.  
2228 (2014)

- Pom sued Coca-Cola under the Lanham Act, which prohibits false and misleading statements about a product because Coca-Cola’s labeling of a product as “pomegranate blueberry favored blend of five juices” was misleading, as it only contains 0.3% pomegranate juice and 0.2% blueberry juice
- Coca-Cola argued that the FDA approved the label and that the approval precluded any claims under the Lanham Act



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## *Pom Wonderful LLC v. Coca-Cola Co. continued*

- Lower courts agreed with Coca-Cola and ruled that Pom could not sue because the FDA's rules superseded other claims
- S. Ct. disagreed and ruled to allow Pom to proceed with its Lanham Act claim. They found no statutory text or principle precluding Lanham Act suits of this nature. They held that competitors may bring claims that challenge food and beverage labels that are regulated by the FDA



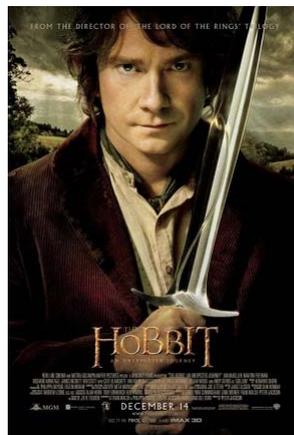
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*Warner Bros. Entm't v. Global Asylum, Inc.*, 107 U.S.P.Q.2d 1910 (C.D. Cal. 2012), *aff'd*, No. 13-5532, 2013 WL 5814731 (9th Cir. Oct. 30, 2013)





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## *Warner Bros. Entm't v. Global Asylum, Inc.* continued

- Warner Bros. was about to release "The Hobbit: An Unexpected Journey" when Global Asylum began distributing "Age of Hobbits"
- Warner Bros. filed a complaint for infringement and other grounds alleging likelihood of confusion with its HOBBIT mark for fantasy-related goods. Warner Bros. also requested a TRO barring Asylum from releasing its film.
- Warner Bros. succeeded in showing a likelihood of success on the merits by proving protectable ownership of the mark and that Asylum's use was likely to cause confusion. It proved that the mark had acquired secondary meaning for films and that although distribution varied, both goods were films, 30-40% of those surveyed found confusion, both parties used the internet to their promote films, the parties targeted similar audiences and the Defendant acted in bad faith



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## *SA Bay LLC v. Hall*, 849 F. Supp. 2d 761 (S.D. Tex. 2012)

- Hall was employed by SA Bay at a restaurant called BUBBA'S "THE" BOILING SPOT
- After Hall left SA Bay's employ he opened a BUBBA'S "THE" BOILING SPOT restaurant within one mile of the other restaurant
- Hall also advertised in a local newspaper that the original restaurant was closing and reopening in his new location



photo by Chris Oranger



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## *SA Bay LLC v. Hall* continued

- SA Bay asserted trademark infringement and filed for summary judgment
- The court found the mark suggestive because the mark was not in a dictionary, did not specifically describe a seafood restaurant and competitors did not need to use the mark to describe their products and services
- The court also easily found a likelihood of confusion and bad faith on the part of Hall



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## *Lorillard Tobacco Co. v. Cal. Imps., LLC*, 886 F. Supp. 2d 529 (E.D. Va. 2012).

- Lorillard brought a Lanham Act action claiming that users of NEWPROT for a “potpourri” smoking product violated its NEWPORT trademark
- No actual confusion was found; however, the likelihood of confusion factors favored Lorillard: the NEWPORT mark is distinct and well known, there were only trivial differences between the marks, the marks were both used for smoking products, trade channels were similar and the defendants’ bad faith intent was established by their decision to trade off of the goodwill Lorillard had established in NEWPORT



Image © William & Mary Law School



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## *In re Morrison & Foerster LLP*, 110 USPQ2d 1423 (TTAB 2014)

- Refusal to register “FRANKNDODD” for legal services reversed
- A rare case involving Section 2(c) - here, as it applies to legislative act named after Barney Frank and Christopher Dodd (Dodd-Frank Act)
- Board determined that FRANKNDODD would not create a likelihood of confusion due to the association between the legislators responsible for the Act named after them
- The Board noted that the application was not for Dodd-Frank, but instead for FRANKNDODD and stated “[t]he reversal of the order of the names in the title of the Dodd-Frank Act, and the addition of the “N” in applicant’s...[mark], results in an allusion to the name popularly attributed to the monster in Mary Shelley’s *Frankenstein*”



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## *Weider Publications, LLC v. D & D Beauty Care Company, LLC*, 109 USPQ2d 1347 (TTAB 2014)

- SHAPE versus SHAPES
- SHAPES for beauty salon nail care and health care spa services found likely to cause confusion with SHAPE for print and online magazines and related internet content
- Fame of prior SHAPE mark for publications and online services played key role
- Board relied on fame of the SHAPE mark for the publications and its website, which reached millions of views monthly as well as 25+ years of use



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## *Inter IKEA Systems B.V. v. Akea, LLC*, 110 USPQ2d 1734 (TTAB 2014)

- Classic 2(d) likelihood of confusion and dilution case
- *IKEA v. AKEA* (for nutritional supplements in Class 5), retail services associated with nutritional supplements as well as advice in the field of career and business opportunities (Class 35) and advice in the area of diet planning, nutrition and nutritional supplements and gardening (Class 44)
- Dilution claim failed because IKEA failed to prove sufficient fame prior to Applicant's filing date
- LOC successful as to Class 35 services, but failed as to Classes 5 and 44 goods/services (goods and services were not sufficiently similar to Ikea's goods/services)



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## *In re Cordua Restaurants LP*, 110 USPQ2d 1227 (TTAB 2014)

- Cautionary tale that trademark rights are not static and genericness objection can be raised at any time
- Applicant had a prior registration for CHURRASCOS in typed form for restaurant services
- Applicant sought to register CHURRASCOS in stylized form and the Board found the term generic



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## *Turdin, Jr. v. Trilobite, Ltd*, 109 USPQ2d 1473 (TTAB 2014)

- Concurrent use proceeding for “TRILOBITE”
- Trilobite, Ltd. had prior use of “TRILOBITE” in Ohio and Michigan and filed application first (services = audio recording and production and video production services)
- Turdin used “TRILOBITE PICTURES” for motion picture film production and animation services in New York and Connecticut prior to Trilobite, Ltd.’s application, but not prior to Trilobite, Ltd.’s use of the mark
- Turdin proposed concurrent use registration for him for New York and Connecticut and for Trilobite Pictures, Ohio and Michigan



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## *Turdin, Jr. v. Trilobite, Ltd.* continued

- Turdin needed to establish lawful concurrent use of “TRILOBITE” prior to filing of Trilobite, Ltd.’s application **and** no LOC as a result of his continued use of Trilobite Pictures
- Trilobite argued it had clients in New York and that Turdin could not establish no likelihood of confusion due to close proximity of New York and Connecticut
- Board agreed with Trilobite and granted it unrestricted federal registration, even though Trilobite did not produce any evidence of clients or prior activities in Connecticut



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## *Chanel, Inc. v. Jerzy Makarczyk*, 110 USPQ2d 2013 (TTAB 2014)

- PTO sustained Chanel's opposition to application by Makarczyk for real estate development and construction of commercial residential and hotel property
- The parties adopted an ACR procedure that followed a summary judgment model. Board ruled for Chanel on basis of dilution and did not reach the Section 2(a) and Section 2(d) claims



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## *Patagonia, Inc. v. Joseph Azzolini*, 109 USPQ2d 1859 (TTAB 2014)

- Ultimate sanction of dismissal of the case for failure to participate in a discovery conference
- While rare, the record shows that even the Board can lose patience with pro se litigants who do not follow its procedures
- Here, the Board *sua sponte* issued the order to show cause why a default judgment should not be entered rather than waiting for the plaintiff to file a motion



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## *Hot Tamale Mama...and More, LLC v. SF Investments, Inc.*, 110 USPQ2d1080 (TTAB 2014)

- *Hot Tamale* explores the meaning of “good faith effort” in resolving discovery dispute
- Here a single email with no follow up did not qualify under the facts as a show of good faith effort required before filing a motion to compel
- The ruling may be based partly on the facts of the particular case but, as a cautionary note, it is better to do follow up
- Board distinguished this from a case where Opposer was a defiant adversary who simply refused to engage in discovery or provide any answer. Thus, Board left open possibility that there could be circumstances where a single communication would be sufficient



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## *Covidien LP v. Masimo Corporation*, 109 USPQ2d 1696 (TTAB 2014)

- Covidien addressed whether a Section 18 petition for a restriction of a registration is appropriate for restricting a color in a registration (Colors at issue: Red versus Pink)
- The context was a Rule 12(b)(6) motion to dismiss for failure to state a claim
- The Board ruled that plaintiff has standing maintain the proceeding and a valid ground existed for cancelling the registration (i.e. the partial cancellation or restriction based on color)
- However, the Board required clarification of the pleading because the pleading referenced use of the Pantone color system in describing the restrictions





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## *In re U.S. Tsubaki, Inc.*, 109 USPQ2d 2002 (TTAB 2014)

- The issue in Tsubaki is whether Applicant's catalogs could function as a display associated with the goods and be appropriate goods for the specimens
- Catalogs contained a telephone number prospective purchasers could call and obtain information on the products and place orders, but did not have ordering information costs, etc. on it
- The Board held these did not meet the threshold of a display associated with the goods because they did not have the characteristics that would make them be seen as specimens



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## *In re Hitachi High-Technologies Corp.*, 109 USPQ2d 1769 (TTAB 2014)

- While the Board affirmed the refusal to register the Applicant's mark, it rejected use of the family of marks doctrine by the Examiner in an ex parte context
- The Board rejected the Examining Attorney's reliance on alleged family of marks featuring the term "OPTI" stating that the family of marks doctrine is not available in an ex parte proceeding (it is available in an inter partes proceeding)
- The mere existence of similar registrations does not establish that there is public recognition of the shared characteristic that indicated it came from a common origin. (The Examining Attorney lacks resources to determine that, and therefore, application family of marks is inappropriate in the ex parte context)



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## *Lincoln National Corporation v. Kent G. Anderson*, 110 USPQ2d 1271 (TTAB 2014)

- Opposition sustained on ground of lack of bona fide intent
- Applicant sought to register FUTURE for variety of goods
- Case provides a good road map for how to challenge bona fide intent
- Among the factors considered: application covered numerous goods/services, Applicant lacked resources/ability to provide services, Applicant testimony indicated intent to reserve right to mark



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## *Bayer Consumer Care AG v. Belmora LLC*, 110 USPQ2d 1623 (TTAB 2014)

- Bayer brought an Opposition based on Section 14(3) of the Lanham Act asserting misrepresentation of the source of the goods
- Belmora sought to register FLANAX for an analgesic
- Bayer's Mexican branded version of its ALEVE analgesic was named FLANAX
- Bayer did not use the mark FLANAX in the United States, but many purchasers (particularly those who speak Spanish) were familiar with Bayer's product based on its use of the mark in Mexico



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## *Bayer v. Belmora* continued

- The Board concluded that Section 14(3) does not require use and must only show that Respondent took steps to deliberately pass off its goods as those of Petitioner...or blatant misuse of the mark by Respondent in a manner calculated a trade on the good will and reputation of Petitioner
- The Board concluded that the evidence “readily establishes blatant misuse of the FLANAX mark in a manner calculated to trade in the United States on the reputation and goodwill of [Bayer’s] mark created by its use in Mexico”



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## *Shammas v. Focarino*, 109 USPQ2d 1320 (E.D. Va. 2014)

- Beware of ex parte appeal by a civil action in the United States District Court
- “PROBIOTIC” refused registration on genericness grounds
- Applicant appealed by a civil action
- 15 U.S.C. Section 1071(b)(3) states: “unless the court finds the expenses to be unreasonable, all of the expenses of the proceeding shall be paid by the party bringing the case, whether the final decision is in favor of such party or not.”

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## *Shammas v. Focarino* continued

- District Court affirmed the Board's genericness refusal and awarded the PTO reasonable expenses including attorney's fees of \$36,000
- Attorney's fees award based on calculations derived from PTO staff and attorney and paralegal salaries

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