

Keeping Tabs on the TTAB®

The Top Ten TTAB Decisions of 2021

By John L. Welch

The TTAB issued more than 600 final decisions and numerous interlocutory rulings in 2021. Thirty-five of the Board's opinions were deemed precedential. Once again yours truly has chosen the 10 decisions that he believes were the most important and/or interesting during the past year. The cases are not necessarily listed in order of importance (whatever that means).

Chutter, Inc. v. Great Management Group, LLC and Chutter, Inc. v. Great Concepts, LLC, 2021 USPQ2d 1001 (TTAB 2021) [precedential] (Opinion by Judge Marc A. Bergsman). In the seminal fraud case of *In re Bose*, the CAFC left open the question of whether “reckless disregard” for the truth is sufficient for a finding of fraud on the USPTO. The Board has now answered that question in the affirmative, significantly lowering the bar for proof of a claim of fraud. It granted a petition for cancellation of a registration for the mark DANTANNA'S for “steak and seafood restaurant” on the ground of fraud. Plaintiff Chutter's fraud claim was founded on defendant's filing of a Section 15 Declaration of Incontestability in which its counsel, Mr. Taylor, falsely stated that there were no civil actions or USPTO proceedings pending against the DANTANNA'S mark and registration. Mr. Taylor testified that he did not review the document “carefully enough to see that the statement is in [t]here incorrectly.” Neither he nor Great Concepts notified the USPTO about the false statement, although they were aware of it since 2015. The Board pointed out that in *Bose* the CAFC held that the intent to deceive must be willful. The Supreme Court and various circuit courts of appeal have ruled that “willful” includes reckless behavior. Therefore, the Board held that “[i]n matters of trademark registration and maintenance, where the USPTO relies on declarations to be complete, accurate, and truthful . . . reckless disregard is equivalent to intent to deceive and satisfies the intent to deceive requirement.”



Fuji Medical Instruments Mfg. Co., Ltd. v. American Crocodile International Group, Inc., 2021 USPQ2d 831 (TTAB 2021) [precedential] (Opinion by Judge Thomas Shaw). For only the second time since the CAFC's 2009 decision in *In re Bose*, the Board upheld a claim of fraud, ordering cancellation of a registration for the mark FUJIIRYOKI for massage chairs. William Shen, the CEO of Respondent ACIGI, filed the underlying application and then assigned the registration to ACIGI soon after issuance. The Board found that Shen knew he was not the owner of the mark, that his false statement of ownership was material to the registration, and that he intended to deceive the USPTO. Respondent ACIGI became Fuji's exclusive U.S. distributor in 2005 and was still in that role when Mr. Shen filed the underlying trademark application in 2015. The Board found that Fuji was the owner of the mark and that Shen's claim of ownership was a false and material representation. The Board further found that “contradictions, inconsistencies, and indefiniteness” in Shen's testimony demonstrated his lack of credibility. The evidence was “clear and convincing” that Shen intended to deceive the USPTO - not only the documentary evidence but also Shen's “grossly evasive testimony, and his self-serving claims.”



Philanthropist.com, Inc. v. The General Conference Corporation of Seventh-day Adventists, 2021 USPQ2d 643 (TTAB 2021) [precedential] (Opinion by Judge Jonathan Hudis). Finding that petitioner failed to demonstrate its entitlement to maintain its genericness claim (f/k/a “standing”), the Board tossed out this petition for cancellation of two registrations for the mark ADVENTIST for religious publications, film production and distribution, educational services, and religious and missionary services. Petitioner owned the domain name “adventist.com,” but “[a]ll Petitioner has ever done is to hold it for future sale at an inflated price (a practice known as ‘warehousing’), or to redirect Internet users to the TTABVUE docket page for these proceedings.” The Board

concluded that the petitioner did not satisfy either prong of the *Lexmark* test at the time of trial: its interests did not fall within the protectable zone of interests of Section 1064, and there was no reasonable basis in fact for a belief in damages proximately caused by the continued existence of the challenged registrations. “The purpose of the zone-of-interests test is to ‘foreclose[] suit ... when a plaintiff’s interests are so marginally related to or inconsistent with the purposes implicit in the statute that it cannot reasonably be assumed that Congress authorized that plaintiff to sue.’” Moreover, “[t]o the extent Petitioner’s belief in damage may have existed at the time Petitioner brought these proceedings in January 2017, clearly it has not been maintained.”



***The Coca-Cola Company v. Meenaxi Enterprise, Inc.*, 2021 USPQ2d 709 (TTAB 2021) [precedential] (Opinion by Judge Cynthia C. Lynch).** The Board ordered cancellation of registrations for the marks THUMS UP and LIMCA on the ground that Registrant Meenaxi used the marks to misrepresent the source of its soft drink products, in violation of Section 14(3). Petitioner Coca-Cola proved that it owns the two marks in India and that third-party importers have sold the soft drinks in the United States under the marks, and it therefore was entitled to bring a statutory cause of action under Section 14(3). The Board found that Meenaxi deliberately caused consumers to believe that its products were licensed or produced by the same source as the products sold in India. Section 14(3) provides, in pertinent part, that a registration is subject to cancellation if “the registered mark is being used . . . to misrepresent the source of the goods or services” The misrepresentation “must involve a respondent deliberately passing off its goods as those of another.” The evidence showed that Coca Cola’s THUMS UP and LIMCA brands are well known in India and their reputation extends to the Indian-American population in the United States. The Board concluded that Meenaxi, a purveyor of Indian food products distributed primarily to Indian grocers in this country, “intended to cause consumers exposed to Respondent’s use of the THUMS UP and LIMCA marks to draw the logical conclusion that Respondent’s products

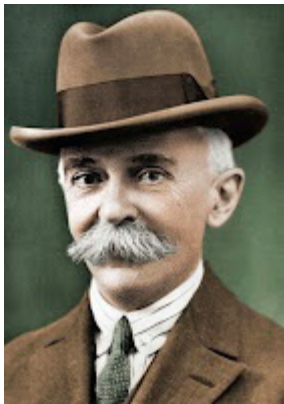
in the United States are licensed or produced by the source of the same types of cola and lemonlime soda sold under these marks for decades in India.”



***In re Dolce Vita Footwear, Inc.*, 2021 USPQ2d 478 and 479 (TTAB 2021) [precedential] (Opinions by Judge Jyll Taylor).** The Board upheld two Section 2(e)(1) refusals of the proposed mark CLEAR for footwear, lingerie, and other clothing items and for handbags, purses, wallets and the like, all “excluding transparent goods,” finding the term to be deceptively misdescriptive thereof. Dictionary definitions and third-party website evidence convinced the Board that consumers “will perceive CLEAR as describing a feature” of Dolce Vita’s clothing and other items. The Board rejected applicant’s contention that its proposed mark CLEAR does not describe a plausible feature of its goods because the identified goods do not include transparent footwear and clothing. “We cannot assume that consumers of Applicant’s goods will be aware that its identification is so restricted, and the restriction is not controlling of public perception.” The Board also rejected Dolce Vita’s argument that consumers are unlikely to believe the misrepresentation because they will visually inspect the goods before purchase, since not all consumers will have that opportunity.

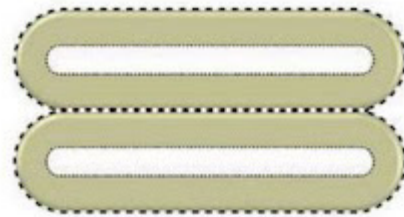


***The United States Olympic Committee v. Tempting Brands Netherlands B.V.*, 2021 USPQ2d 164 (TTAB 2021) [precedential] (Opinion by Judge Cynthia C. Lynch).** The TTAB dismissed the Olympic Committee's opposition to registration of the mark PIERRE DE COUBERTIN for various goods in classes 3, 9, 14, 18, 25, and 28, including perfume, sunglasses, jewelry, luggage, clothing, and sporting goods. Pierre de Coubertin is the name of a French baron who was instrumental in reviving the Olympic Games in the late nineteenth century by co-founding the International Olympic Committee and later becoming its president. The Board found that the Committee had failed to prove its claim that the proposed mark falsely suggests a connection with the Olympic Movement in violation of Section 2(a) of the *Trademark Act*. The Committee did not clear either of the first two hurdles of the Section 2(a) test: (1) that the mark falsely suggests a connection with a person or institution and (2) that the mark points uniquely and unmistakably to that person or institution. "While Pierre de Coubertin certainly was associated with the Olympic Movement, this record does not demonstrate that the public would perceive Applicant's mark as a name or identity of the Olympic Movement or Opposer, or a close approximation thereof." Moreover, the name is associated with the person "rather than serving merely as a synonym of the Olympic institution," and thus does not point uniquely and unmistakably to opposer.



***In re Dimarzio, Inc.*, 2021 USPQ2d 1191 (TTAB 2021) [precedential] (Opinion by Judge Mark Lebow).** A single-color mark on a product design is registrable only upon a showing of acquired distinctiveness. *Wal-Mart* (citing *Qualitex*). Applicant Dimarzio, Inc. fell far short of proving that its claimed color "cream" for electronic guitar pickups met that test, and so the Board affirmed a refusal to register under Sections 1, 2, and 45 of the *Trademark Act*. In making the Section 2(f) determination, the Board applied the CAFC's *Converse* factors. Dimarzio did not offer survey evidence, but submitted "fill-in-the-blank" declarations from eight different distributors and customers; the Board found them of

little, if any, probative value. Dimarzio claimed use of the proposed mark since 1979, with millions of consumers observing its guitar pickups in videos, advertisements, and musical performances. The Board pointed out, however, that long-time use of a supposed mark does not alone establish acquired distinctiveness. In fact, the evidence showed that Dimarzio's use of the color cream on guitar pickups was not substantially exclusive. Dimarzio did not provide details regarding its purported sales or its market share, nor did it submit evidence of unsolicited media coverage. Its advertising characterized the color cream as one of many colors available, and so there was nothing to lead consumers to perceive the color cream as a mark.



***In re Taverna Izakaya LLC*, 2021 USPQ2d 1134 (TTAB 2021) [precedential] (Opinion by Judge Cynthia C. Lynch).** Because the ordinary American purchaser would not stop and translate a mark comprising words from different languages, the TTAB refused to apply the doctrine of foreign equivalents and it reversed a Section 2(e)(1) mere descriptiveness refusal of TAVERNA COSTERA for "restaurant, cafe, and bar services." Applicant argued that because the first word is understood in English, it is "exceeding likely" that the average consumer would not stop to translate COSTERA, "particularly since the Spanish word COSTERA is pronounceable in English." The Board agreed: "Given that ordinary consumers would recognize the first word in Applicant's mark not only as an English word but one that connotes a Greek café and Greek cuisine, those consumers would not be inclined to stop and translate the next word in the mark from Spanish." The Board observed that courts and the TTAB have frequently ruled that consumers would not "stop and translate" marks



comprised of terms in multiple languages, “often finding that the marks combine the different languages for suggestive purposes to create a certain commercial impression:” for example, LE CASE for jewelry boxes; GLACÉ LITE for ice cream products.

***McGowen Precision Barrels, LLC v. Proof Research, Inc.*, 2021 USPQ2d 559 (TTAB 2021) [precedential] (Opinion by Judge Mark Lebow).** The Board granted a petition for cancellation of a registration for the trade dress of a gun barrel on the ground of *de jure* functionality under Section 2(e)(5). The registered mark consists of trade dress applied to gun barrels formed with a mottled pattern of irregularly sized, rippled patches resembling a quilt. As often happens in Section 2(e)(5) determinations, respondent’s own utility patent blew a hole in its case. There was no dispute that carbon fiber composite barrels provide various functional benefits to rifles. “What the parties dispute is whether the particular appearance of Respondent’s carbon fiber composite barrels is functional because it is a natural byproduct of the manufacturing process that creates the barrels, as Petitioner claims, or whether it is simply the result of Respondent’s cosmetic efforts to create a trade dress that consumers associate with Respondent.” The Board looked to respondent’s utility patent in concluding that the appearance of the gun barrel is dictated by its function. “Simply put, the patent evidence, combined with the evidence regarding Respondent’s manufacturing process, is dispositive on the issue of functionality.”



***In re Maugus Manufacturing, Inc.*, 2021 USPQ2d 1100 (TTAB 2021) [precedential] (Opinion by Judge Cindy B. Greenbaum).** To be registrable, a proposed trademark

must function as a source indicator in the eyes of relevant consumers. Applicant Maugus Manufacturing failed to meet that basic requirement in its attempt to register the phrase DRINK MORE BEER for “non-metal and non-paper closures for containers.” Applicant’s specimens of use showed that it uses the trademark NNBC to identify and distinguish the source of its closures; DRINK MORE BEER “merely identifies optional wording that may appear on one of the products, or one of the available styles for the product sold, under the NNBC mark.” The Board agreed with the examining attorney that the proposed mark, as presented on Maugus’s specimens of use, would not be perceived as identifying source, but rather would be seen as examples of how wording may appear on the products that consumers purchase. “They would not associate the wording DRINK MORE BEER stamped or embossed on the growler cap as a source identifier of the ‘non-metal and non-paper closures for containers’ identified in the application.”



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