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Civil Cases

Architectural Mailboxes, LLC v. Epoch Design, LLC, 2011 WL 1630809 (S.D. Cal. Apr. 28, 2011)

by David M. Kelly

ABSTRACT

Defendant used plaintiff's trademark on its website to compare its product to plaintiff's competing product, and plaintiff sued for trademark infringement and dilution. The district court granted defendant's motion to dismiss based on the allegations in plaintiff's complaint and in the examples of defendant's use of plaintiff's mark in the exhibits to the complaint. The court held that defendant's use of its competitor's trademark was nominative fair use because the mark was used to distinguish the parties' products, and there was no likelihood of consumer confusion.

CASE SUMMARY

FACTS

Plaintiff Architectural Mailboxes, LLC ("AM") sold metal mailboxes under the licensed trademark OASIS. Defendant Epoch Design, LLC ("ED") sold competing mailboxes. AM alleged that ED used the OASIS mark on its website to divert customers to ED's stores, and that ED used an OASIS mailbox at trade shows and in its stores to make false and misleading statements about the OASIS mailbox. AM sued for trademark infringement and dilution, among other claims. ED filed a motion to dismiss AM's complaint in its entirety.

ANALYSIS

The district court granted ED's motion to dismiss AM's infringement, dilution, and false-designation-of-origin claims, but refused to dismiss AM's false-advertising claim. ED argued that its use of OASIS to refer to AM's products was a nominative fair use of that mark, and the court agreed. Nominative fair use applies when (1) the product is not readily identifiable without use of the mark; (2) the defendant uses no more of the mark than necessary; and (3) the defendant does not falsely suggest that he is sponsored or endorsed by the trademark owner.

AM argued that ED did not meet this test and, in any event, this issue was not appropriate for resolution on a motion to dismiss. ED relied on the Sixth Circuit's 2009 decision in *Hensley v. Propride*, holding that the defendant's use of the HENSLEY surname of its competitor's former designer to advertise trailer hitches designed by the same person for defendant was a noninfringing, nominative fair use of the name. In *Hensley*, the Sixth Circuit affirmed the district court's grant of the defendant's motion to dismiss because the complaint did not allege facts sufficient to show that the defendant's use of the HENSLEY name created a likelihood of confusion. The Sixth Circuit also looked to the exhibits attached to the plaintiff's complaint. Specifically, the defendant's print ads included a disclaimer that Hensley was no longer affiliated with the plaintiff, and provided the defendant's telephone number and website address. The defendant's website, as well as an eBay listing, provided information on Hensley's separation from the plaintiff and his new relationship with the defendant. For these reasons, the Sixth Circuit concluded that the defendant's use of the HENSLEY mark did not create a likelihood of consumer confusion.

Applying *Hensley* to this case, the court stated that the exhibits attached to AM's complaint "lead to the same conclusion, namely that [AM] failed to allege sufficient facts to demonstrate a likelihood of confusion." Specifically, the excerpts from ED's website clearly identified AM as the manufacturer of the OASIS mailbox, and even indicated that "OASIS is a registered trademark of Architectural Mailboxes" (emphasis added by the court). The court also agreed with ED that it did not seek to create an affiliation, connection, or sponsorship between itself and AM's products, because all of ED's statements about the OASIS mailbox were negative and critical (i.e., ED would not want to associate itself with a competitor's inferior product). According to the court, ED's intention in using the OASIS mark was instead to draw a "clear distinction" between its products and AM's OASIS products. The court thus held that AM did not allege facts sufficient to support its infringement claims.

The court was careful to note that other district courts in the Ninth Circuit have declined to dismiss trademark-infringement claims based on nominative fair use at the pleading stage. However, it also noted that one district court dismissed an infringement claim based on the descriptive-fair-use defense, which was upheld by the Ninth Circuit. Although the court recognized that descriptive fair use is not the same defense as nominative fair use, the Ninth Circuit's decision indicated that courts may resolve fair-use issues at the pleading stage. Accordingly, the district court dismissed AM's infringement and false-designation-of-origin claims. The court also dismissed AM's dilution claim because the Lanham Act expressly provides that "[a]ny fair use, including a nominative or descriptive fair use," may not be actionable as dilution. However, the court denied ED's motion to dismiss AM's false-advertising claim because AM sufficiently alleged that ED made false statements on its website about AM's OASIS mailboxes.

Although the court granted ED's motion to dismiss AM's claims for infringement, false designation of origin, and dilution, it did give AM leave to file an amended complaint to attempt to cure the pleading deficiencies discussed above, failing which the court would dismiss the claims with prejudice and without further leave to amend.

CONCLUSION

This decision is important because it provides infringement defendants with some hope of dismissing trademark claims on nominative-fair-use grounds at an early stage of the case. At the same time, this decision emphasizes the need for plaintiffs to exercise care in drafting their complaints and deciding which exhibits to include to lower the risk of an early dismissal on nominative-fair-use grounds.

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Civil Cases

be2 LLC v. Ivanov, 98 USPQ2d 1499 (7th Cir. Apr. 27, 2011)

by Danny M. Awdeh

ABSTRACT

The Seventh Circuit reversed the district court's finding of personal jurisdiction where the defendant's interactive dating website had users in, but did not "target," the forum state. The Seventh Circuit held that the website's mere 20 members in Illinois did not show that the defendant deliberately targeted or exploited the Illinois market, and thus could not give rise to personal jurisdiction without offending traditional notions of fair play and substantial justice.

CASE SUMMARY

FACTS

be2 LLC ("be2") operates an Internet dating website located at be2.com, with users in 36 countries, including the United States.

Nikolay Ivanov is a New Jersey resident who allegedly founded and owned the website be2.net. In December 2006, Ivanov moved his existing online dating website from sladurana.com to be2.net. be2 alleged that this move was made deliberately "with the intention of misleading consumers" looking for be2's website at be2.com.

be2 sued Ivanov in the U.S. District Court for the Northern District of Illinois for trademark infringement under federal and state law, and for violating the Illinois Deceptive Business Practices Act. When Ivanov did not answer the complaint, default judgment was entered against him.

To prove damages, be2 submitted a declaration that included documents showing that 20 Chicago residents registered for dating services on the be2.net website one year earlier. Additional documents, taken from sladurana.com, identified Ivanov as the CEO and cofounder of be2.net, and the "one responsible for [the website's] censorship, profile approval, and advertising."

After default judgment was entered, Ivanov appeared in the case for the first time and moved to vacate the judgment for lack of personal jurisdiction. Ivanov submitted an affidavit contesting be2's account of his relationship with the be2.net website. Ivanov claimed that he had never received any "financial benefit" from be2.net and had never set foot in Illinois.

Relying on "the whole list of Chicago contacts, the result of Mr. Ivanov's activity," the district court concluded that Ivanov had made himself susceptible to personal jurisdiction in Illinois. Ivanov appealed the decision, arguing that the evidence did not support a finding of personal jurisdiction.

ANALYSIS

The specific issue before the Seventh Circuit on appeal was whether the evidence submitted by be2 showed that Ivanov had purposefully availed himself of the Illinois market. To be sufficient, the evidence must establish that Ivanov had minimum contacts with Illinois such that defending the case there would "not offend traditional notions of fair play and substantial justice."

The Seventh Circuit warned that questions of personal jurisdiction involving online contacts should be decided carefully to ensure that defendants are not haled into court simply because they own or operate a website in the forum state, even if that site is "highly interactive." Beyond simply operating an interactive website, the defendant must in some way target or exploit the forum state to become subject to personal jurisdiction.

The Seventh Circuit concluded that the record before it did not show that Ivanov had deliberately targeted or exploited the Illinois market. The court dismissed the 20 Chicago members of be2.net as "attenuated contacts" that could not give rise to personal jurisdiction. "[T]he constitutional requirement of minimum contacts is not satisfied simply because a few residents have registered accounts on be2.net."

The Seventh Circuit distinguished this case from *uBID v. GoDaddy Group*, 623 F.3d 421 (7th Cir. 2010), where GoDaddy was found to have subjected itself to personal jurisdiction by exploiting the Illinois market through an advertising campaign producing hundreds of thousands of customers in the state and millions of dollars in annual revenues. Unlike GoDaddy's advertising specifically targeting Illinois residents, the court commented that the 20 Chicagoans who created free profiles on be2.net may have done so simply by "stumbling across the website and clicking a button that automatically published their dating preferences online." Such contacts on their own do not support a finding of personal jurisdiction.

CONCLUSION

This decision is interesting because it rejects a finding of personal jurisdiction for a "highly interactive" website even where the defendant has users of that website (albeit a relatively minimal number) in the forum state.

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Civil Cases

Newport News Holdings Corp. v. Virtual City Vision, Inc., 2011 WL 1467183 (4th Cir. Apr. 18, 2011)

by David M. Kelly

ABSTRACT

Plaintiff brought trademark and cybersquatting claims against the owner of the domain name newportnews.com based on its NEWPORT NEWS trademark. In a previous UDRP decision between the parties, the UDRP panel held that defendant's website provided bona fide services about the city of Newport News, Virginia, and was not likely to be confused with plaintiff's women's clothing. Years later, defendant changed the focus of its website away from providing city information to displaying advertisements for women's clothing. The district court granted summary judgment to plaintiff on its cybersquatting claim and awarded plaintiff its attorney's fees and $80,000 in ACPA statutory damages. The Fourth Circuit affirmed, agreeing with the district court that defendant's transformation of its website after the UDRP decision was an egregious example of a bad-faith intent to profit from plaintiff's mark.

CASE SUMMARY

FACTS

Plaintiff Newport News Holdings Corporation ("NNHC") sold women's clothing under the federally registered mark NEWPORT NEWS at its retail locations and its website located at newport-news.com. When NNHC registered the newport-news.com domain name in 1997, it also attempted to register newportnews.com, but that domain was already owned by defendant Virtual City Vision, Inc. ("VCV"). VCV, which owned 31 domain names incorporating the names of geographic locations, initially used newportnews.com to provide information about Newport News, Virginia, to tourists and residents. In 2000, NNHC filed a UDRP complaint against VCV and its newportnews.com domain name. The UDRP panel denied NNHC's complaint, finding that (1) consumers seeking NNHC's clothing would not be confused by a website "that explicitly provides city information . . . with no connection whatsoever to women's and home fashions"; (2) VCV's site provided bona fide services by providing city information about Newport News; and (3) VCV did not register the domain name in bad faith because the two companies were not competitors.

Between 2000 and 2004, VCV's newportnews.com website continued to provide city information about Newport News. In 2004, however, VCV's website began running "occasional" advertisements for women's clothing. NNHC placed its own ads on VCV's website in February and March 2007 to measure revenue losses attributable to the website. Later in 2007, NNHC offered to purchase newportnews.com from VCV, but VCV rejected the offer and stated that it would either sell the domain name for a "seven-figure" amount or sell NNHC's goods on its website for a commission. Shortly thereafter, VCV shifted the focus of the newportnews.com website to one emphasizing women's fashion, with very little information about the city of Newport News. VCV made more money on the women's fashion website than all of its other city websites combined.

NNHC sued for trademark infringement and cybersquatting, among other claims. VCV moved for summary judgment on all claims and NNHC moved only on its cybersquatting claim. The district court granted NNHC's motion for summary judgment on its cybersquatting claim, finding that VCV "substantially changed the content of the website and ceased to offer bona fide services related to the city of Newport News." It interpreted VCV's change in its website content as "an egregious violation of the ACPA" because the UDRP proceeding clearly illustrated how VCV could use newportnews.com in a legitimate and good-faith manner to provide only city information. The district court later dismissed NNHC's remaining claims, awarded NNHC $80,000 in ACPA statutory damages and $249,753 in attorney's fees, and ordered transfer of newportnews.com to NNHC. VCV appealed.

ANALYSIS

The Fourth Circuit affirmed the district court's judgment for NNHC in its entirety. First, it rejected VCV's argument that it did not act in bad faith, finding that VCV's website underwent a "deliberate metamorphosis" in 2007 from the legitimate service of providing city information to advertising for women's apparel. That VCV's website still contained a few references to the city of Newport News was irrelevant. According to the court, VCV's argument would allow any cybersquatter to avoid liability by simply providing a minimal amount of information about a legitimate subject on its otherwise infringing website. The Fourth Circuit next rejected VCV's argument that the district court failed to properly analyze whether there was a likelihood of confusion between NNHC's and VCV's "websites" because the ACPA standard is simply whether the disputed domain name is identical or confusingly similar to the plaintiff's mark. For the same reason, the Fourth Circuit rejected VCV's argument that the disclaimer on its website eliminated any likelihood of confusion as to the domain name. VCV also disputed the district court's reliance on the UDRP decision to show bad faith because it did not expressly prohibit any of VCV's later website changes. The Fourth Circuit disagreed, stating that the UDRP decision was relevant because it found VCV's previous website use proper precisely because its business of providing city information was unrelated to and not competitive with NNHC's women's clothing business.

VCV also challenged the district court's rejection of its laches and acquiescence defenses. The Fourth Circuit initially noted that it was unaware of a case from any circuit applying laches in the ACPA context. Even assuming laches was applicable, it would not bar relief here because action against the infringing party is not necessary until "the right of protection has clearly ripened." VCV's bad faith was not evident until November 2007, when it switched from a website providing city-based information to one focused on women's fashion. NNHC's filing of its ACPA claim in November 2008, only a year after the relevant changes to VCV's website, did not constitute an unreasonable delay that would support laches. Regarding acquiescence, the doctrine of estoppel by acquiescence bars an infringement claim where the trademark owner expressly or impliedly consented to the infringement through affirmative word or deed. Based on the court's finding that VCV's use of the newportnews.com domain name did not become a clear infringement until November 2007, NNHC's placing of ads on VCV's website in February 2007 could not establish its implied consent or acquiescence to VCV's later infringing conduct.

Finally, VCV challenged the district court's awards of attorney's fees and statutory damages. The Fourth

Circuit upheld the district court's decision that VCV's conduct was "exceptional" and merited attorney's fees because VCV "clear[ly] and deliberate[ly]" transformed its city website into a women's fashion website after being made aware of NNHC's trademark rights in the UDRP proceeding. Regarding the $80,000 ACPA statutory-damages award, the district court awarded damages at the high end of the statutory range ($1,000 to $100,000 per domain name) because VCV's conduct was "exceptional and egregious." VCV argued that its actions were not egregious because it advertised women's clothing on its website during 2005-2007 before NNHC sued. Once again, however, VCV missed the point that its wrongdoing did not take shape until VCV transformed its website into a women's fashion site in November 2007.

CONCLUSION

This decision shows that a party can be liable for cybersquatting even if its original purpose for registering and its initial use of a domain name were legitimate, if it later abandons its good-faith purpose and transforms the website into one that is likely to cause consumer confusion. The Fourth Circuit also reiterated that the test for likelihood of confusion in ACPA cases is simply whether the disputed domain name is identical or confusingly similar to the plaintiff's mark, and not whether there is a likelihood of confusion between the parties' websites.

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Civil Cases

THOIP v. Walt Disney Co., 2011 WL 1792585 (S.D.N.Y. May 10, 2011)

by Lynn M. Jordan

ABSTRACT

The Southern District of New York granted summary judgment to Disney, holding that no reasonable juror could find that Disney's use of the wording LITTLE MISS and MISS on t-shirts bearing its iconic cartoon characters would cause reverse confusion with plaintiff's use of LITTLE MISS and its own cartoon characters. After finding plaintiff's survey inadmissible as flawed and not credible, the court concluded that absent any evidence of actual confusion, the likelihood-of-confusion factors weighed in favor of Disney.

CASE SUMMARY

FACTS

Plaintiff THOIP is the owner of several trademarks consisting of the phrase LITTLE MISS followed by a descriptive term, such as LITTLE MISS TROUBLE, LITTLE MISS BOSSY, and others. The marks appear on t-shirts along with characters drawn from the popular children's book series titled "Little Miss" by Rogers Hargreaves, to which THOIP owns the rights. The Walt Disney Company ("Disney") began selling t-shirts in its theme parks and World of Disney stores with images of its iconic female characters (e.g., Minnie Mouse, Daisy Duck, Tinker Bell) appearing next to phrases such as LITTLE MISS PERFECT and MISS CHATTERBOX. Examples of the parties' respective character art as displayed on t-shirts are shown below.

THOIP filed suit in 2008, alleging that Disney's t-shirts were likely to cause forward and reverse confusion with its own t-shirts. In August 2010, the court granted Disney's motion for partial summary judgment on the forward-confusion claim. The court left open the issue of reverse confusion, however, finding that four of the eight *Polaroid* factors weighed in THOIP's favor, and invited the parties to submit evidence on the issue of actual confusion.

In response, THOIP commenced an "array" survey in shopping malls around the country, where consumers viewed various t-shirts lined up next to each other, including the parties' t-shirts, and were asked a series of questions to determine whether they believed any of the t-shirts were put out by the same companies. THOIP's expert concluded that there was a net likelihood of reverse confusion between THOIP's t-shirts and Disney's t-shirts of 8% for the MISS t-shirts and 19% for the LITTLE MISS t-shirts. Disney conducted a different type of survey known as an "*Eveready*" survey, where participants were shown only one t-shirt and asked questions about its source. Disney's survey expert found no residual evidence of reverse confusion.

Disney moved to exclude THOIP's survey as flawed and inadmissible under Federal Rules of Evidence 702 and 403, and moved for summary judgment on the issue of reverse confusion.

ANALYSIS

After a detailed analysis of THOIP's survey and expert report, the court concluded that (1) the survey failed to replicate actual marketplace conditions because there was no evidence that the t-shirts would ever be encountered side-by-side as they had been shown in the survey; (2) the survey lacked a proper control because the alleged "control" group t-shirts were more unlike than like the Disney t-shirts; (3) the expert improperly counted certain responses as indicating confusion even if Disney was not mentioned; and (4) the survey suffered from demand defects in that the expert set up the survey so that the Disney and THOIP t-shirts were clearly open to comparison. Ultimately, the court found that THOIP's survey was not a reliable indicator of consumer confusion, and found it inadmissible.

The court then turned to an analysis of whether the remaining evidence was sufficient to grant Disney's motion for summary judgment on THOIP's reverse-confusion claim. In its earlier ruling, the court had concluded that the first *Polaroid* factor—the strength of THOIP's marks—favored THOIP. But the court revisited this finding in response to Disney's argument that, although forward confusion is more likely where a plaintiff's mark is strong, the opposite is true with respect to reverse confusion, as a strong mark is less likely to be swamped by a junior user. The court agreed that in a reverse-confusion case, it must look at the *comparative* strength of the junior user's marks. Within this framework, the court concluded that although the strength of THOIP's marks could weigh against it for purposes of assessing reverse confusion, the comparatively greater strength of Disney's marks (i.e., its characters) meant that the first factor still weighed in THOIP's favor, "albeit less heavily" than the court had initially concluded.

In its previous ruling, the court had also found that the following factors all weighed in favor of THOIP on the issue of reverse confusion: (1) the similarity of the allegedly infringing elements of Disney's t-shirts to THOIP's mark; (2) the competitive proximity of the parties' t-shirts; and (3) the equal quality of the products. However, while the court found that Disney had likely intended to copy THOIP's t-shirts, this was not the same as demonstrating that Disney had intended to exploit the goodwill and reputation of THOIP by creating t-shirts "with the intent to sow confusion between two companies' products." Accordingly, the court looked to the remaining factor—evidence of actual reverse confusion—to tip the balance in finding reverse confusion.

Although actual confusion need not be shown in order to prevail in a reverse-confusion case, the court noted that it is “highly probative” on the issue. Both parties’ t-shirts were available on the market for close to a year, but THOIP presented no evidence of actual confusion, and its survey was excluded. Although Disney’s survey was admissible, the court nevertheless found that it failed to replicate actual market conditions and was thus “largely irrelevant.” Thus, the court found that it was in essentially the same position that it had been at the time of its August 2010 ruling, with neither party proffering probative, reliable evidence of reverse confusion. As a result, the court concluded that the “actual-confusion” factor weighed in Disney’s favor.

The court found that the competitive proximity, similar quality of the t-shirts, and strength of Disney’s marks weighed slightly in THOIP’s favor on the issue of reverse confusion. However, in light of THOIP’s lack of reliable survey evidence suggestive of actual reverse confusion, the absence of any nonhypothetical evidence showing that Disney’s t-shirts were likely to overwhelm THOIP’s mark, and no evidence demonstrating Disney’s bad faith, the court concluded that no reasonable juror could find reverse confusion.

CONCLUSION

This decision shows the value of a properly conducted confusion survey. In balancing the *Polaroid* factors, the court expressly stated that “had THOIP submitted strong (probative and reliable) survey evidence of reverse confusion,” the court would have “conclude[d] that a reasonable juror *could* find reverse confusion,” and denied Disney’s motion for summary judgment.

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TTAB Cases

In re Kysela Pere et Fils, Ltd., Ser. No. 77686637 (TTAB Mar. 24, 2011)

by Linda K. McLeod and Stephanie H. Bald

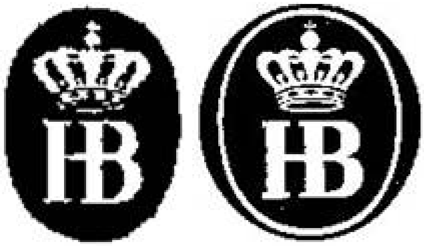
ABSTRACT

The TTAB affirmed the Examining Attorney's refusal to register the mark HB in standard characters for wine based on a likelihood of confusion with prior registrations for the mark HB with a crown design for beer. The TTAB held that the marks were similar, and that the parties' goods were related, sold in the same channels of trade, and included inexpensive consumer goods that may be purchased by unsophisticated members of the general public who may purchase them on impulse.

CASE SUMMARY

FACTS

Kysela Pere et Fils, Ltd. ("Applicant") appealed the Examining Attorney's final refusal to register the mark HB in standard characters for wine on the ground that Applicant's mark so resembled the registered marks shown below for beer, among other goods, that it was likely to cause confusion.



ANALYSIS

The TTAB applied the *DuPont* likelihood-of-confusion factors and ultimately affirmed the Examining Attorney's refusal to register. Regarding the relatedness of the goods, the Examining Attorney initially relied on evidence of registrations showing that various entities had registered a single mark for both beer and wine. On appeal, Applicant noted that the Examining Attorney had submitted only about 30 third-party registrations and, because there are many thousands of applications and registrations in the USPTO database that included the terms "wine" or "beer," the 30 submitted were only a negligible percentage (.00025-.00053). Applicant argued that these 30 registrations were not nearly enough to establish a relationship between the goods sufficient to establish a likelihood of confusion.

The TTAB rejected Applicant's argument for several reasons. First, the TTAB explained that the fact that an application or registration contained the term "beer" and was retrieved by one search did not mean that the same application or registration did not contain "wine" as well. Second, the evidence submitted by Applicant consisted of a search printout from the USPTO database, but did not include TESS/TARR printouts showing the identifications for the applications and registrations. Accordingly, there was no way of telling whether the use of "wine" and "beer" in the identifications was for those particular beverages or for other goods, such as "root beer" or "wine glasses." Third, the fact that the Examining Attorney effectively submitted approximately 20 probative third-party registrations (the TTAB refused to give any weight to some of the registrations submitted by the Examining Attorney) listing beer and wine did not mean that they were the only registrations that included those goods. The TTAB noted that there was no requirement that the Examining Attorney submit *all* of the evidence that supported the Examining Attorney's position. Thus, the TTAB found the third-party registrations sufficient to establish the relatedness of the goods.

Moreover, the TTAB noted that the Examining Attorney had also submitted website printouts showing that companies made and sold both wine and beer. It found that this evidence further supported that the goods were related because the websites showed that consumers had been exposed to the concept that wineries also make and sell beer. Consequently, the TTAB found that the third-party registration evidence and the website evidence together amply demonstrated the relatedness of beer and wine, and showed that consumers, if they encountered both goods sold under confusingly similar marks, were likely to believe that they emanated from the same source.

Finally, the TTAB rejected the Examining Attorney's argument that Applicant's goods or services were in the natural zone of expansion of the goods and services of the registrant, and Applicant's argument that it was not likely that the particular registrant that owned the cited marks would expand its use of the mark as inappropriate in the context of an ex parte proceeding. The TTAB explained that whether the owner of the cited registration had or was likely to expand its particular business to include the goods of the Applicant is not a proper analysis for an ex parte proceeding. Rather, the proper inquiry is whether consumers are likely to believe that the goods emanated from a single source.

Regarding the remaining factors, the TTAB found that the channels-of-trade, conditions-of-purchase, and similarities-of-marks factors weighed in favor of a likelihood of confusion. The TTAB found that wine and beer were general consumer goods sold to adult members of the general public, that both products could be purchased at liquor stores and, in some cases, supermarkets and other retail outlets, and that Applicant's own website showed that it offered both beer and wine. In addition, the TTAB reasoned that less expensive beer and wine would not necessarily be purchased with any degree of care or with knowledge by sophisticated purchasers, and could be purchased on impulse.

With respect to the similarities between the marks, the TTAB rejected Applicant's argument that the crown design in the registered marks was sufficient to distinguish them from Applicant's mark because it indicated the royal pedigree of the brewery associated with the mark. The TTAB found that, although the royal pedigree information appeared on the registrant's website, it could not assume that ordinary purchasers encountering the beer on a store shelf would be aware of the history. Rather, the TTAB found that consumers were more likely to view the design merely as indicating that the goods are superior or "fit for a king" and laudatory. The TTAB thus found that "HB" was the dominant element of the registered mark.

The TTAB also found unpersuasive a number of other arguments by Applicant regarding dissimilarities between the marks in appearance, pronunciation, and meaning, including that consumers would read the registrant's mark as including the verbal description of the crown as royal or royalty, that consumers would view HB as referring to "hofbrauhaus" and would pronounce it as HOFBRAUHAUS, or that consumers would treat registrant's marks as having the meaning HOFBRAUHAUS. The TTAB found instead that consumers would understand the HB marks as merely the letters HB with a laudatory suggestiveness as to the superior or special nature of the goods due to the crown design. For these reasons, when compared in their entireties, the TTAB held that the marks engendered the same commercial impression.

In sum, The TTAB held that the marks were similar, and that the goods were related, sold in the same channels of trade, and included inexpensive consumer goods that could be purchased by members of the general public who may not be particularly sophisticated and may purchase on impulse. The TTAB affirmed the Examining Attorney's refusal based on a likelihood of confusion.

CONCLUSION

In an ex parte context, as few as 20 third-party registrations covering both wine and beer, together with Internet evidence showing that such goods may be made and sold by the same entity, might be sufficient evidence to show that such goods are related for purposes of a likelihood-of-confusion analysis by the Board.

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May 2011 Issue

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Unregistrable

A Brand Like No Other

by Robert D. Litowitz

These days, it's hard to watch a news or talk show without hearing mention of someone's personal brand. Politicians like Obama and Palin have them, celebrities from J Lo to Snooki have them, sports figures from LeBron to Kobe have them, and even CEOs of companies that sell brands from Bill Gates to Steve Jobs are their own brands. And then, of course, there's The Donald, who trumps them all. Rarely do we encounter an ordinary civilian whose personality is so outsized and sparkling that she defines a brand of her own. My late wife of nearly 27 years, Karen Dubin, was a brand unto herself, a brand like no other. Karen died April 19th from injuries sustained when a truck struck her as she waited patiently by the roadside while out jogging on a soft spring day in D.C. Her absence from this year's INTA was profoundly felt, not just by her Finnegan family, but by so many friends of the firm, who looked forward to their encounter with Karen each year. The phrase I heard most often over my last 23 INTAs was not "how are you" or "how's business," but "where's your wife?" Our world has been sadly diminished by Karen's passing.

In pondering what to write for this month's column, my thoughts were drawn repeatedly to Karen, and to the role she played for so many years but chafed at nearly every day. That role was that of a litigator's wife. You see, Karen was not only vivacious and fiercely independent, she also took great pride and satisfaction in her own career. When we met, she was a civilian employee of the Navy, where she was responsible for purchasing sophisticated avionics equipment for jet planes that protected our skies and shores. Those who knew Karen, with her flair for fashion and passion for jewelry, had a hard time picturing her striking deals for aircraft electronics. Yet she thrived as an unconventional presence in the spit-and-polish military world. Later, after taking a break to raise our three kids, and hating every minute of being out of the limelight, she resumed her government career as an international trade specialist, where she organized and led international trade missions for the Department of Commerce. Executives from companies at home and abroad knew and respected Karen as a vibrant force who could open new doors for U.S. businesses in markets ranging from Old Europe and Russia to Asia and the Middle East.

As a litigator's wife, however, she came up perhaps a tad short from time to time, though ever the good sport. Two stories are legendary.

The Tale of the Incommunicado Associate: Just a few months after I joined Finnegan in 1986, Karen was pregnant with our first child. I'd been enlisted to work on a post-trial brief for a patent case, and a late night loomed. These were the days before cell phones, before BlackBerry devices, and even before we had computers on every desk top, let alone e-mail and the Internet. Finnegan's office systems were so primitive that, after hours, the phone only rang on certain floors. I called Karen around 10:00 P.M. to wish her good night, and then continued slaving away, giving little thought to whether she might need to contact me in the middle of the night, and oblivious to the fact that I was working on one of those floors that rivaled the dark side of the moon in terms of telecommunication. Basking in the satisfaction of a job well done, I finally breezed home at dawn and opened the front door expecting to enter a still dark home. Instead, I was greeted by an angry, ranting dynamo that took the form of a beet-red Karen. "Where were you? How could you? I've been calling you all night?" she incanted over and over like a betrayed siren. And like an angered deity on Mt. Olympus, there was no appeasing her, even after I explained my airtight alibi and apologized for Finnegan's archaic phone system. I think she forgave me sometime after the birth of our third child, but she never forgave Larry Hefter, the partner I was working for at the time. Serves Larry right for handling a patent case.

The Wire: It was October 1999. I was up in Boston getting ready for trial in a big patent case. We were defending the patent on tamoxifen, the gold-standard treatment for breast cancer, and one of the biggest products of our client (now known as AstraZeneca). On the eve of trial, our jury consultant, Dr. Phil McGraw (yes, *that* Dr. Phil), arranged for us to present opening statements to a mock jury. I was cast as the attorney for our opponent. I stood before the jury explaining with cold precision why they should declare our client's patent invalid and unenforceable (positions I vigorously disagreed with, but as an advocate enjoyed presenting anyway). As I reached my crescendo, the phone rang. A recess was declared. The call is urgent, someone said (perhaps Dr. Phil's colleague Tara Trask, now a successful litigation consultant in her own right). It's for Rob. It's his wife! My heart raced in the few seconds it took me to cross the room from the podium to the receiver. Was one of the kids sick? Had there been an accident? Had yet another nanny quit without notice? Now I knew Karen was getting ready to load the kids in our minivan and drive up to Scranton, Pa., for a family event. And I knew that hauling three children ages 5-15 in a minivan for five hours through the wilds of Northeast Pennsylvania would be no picnic. But nothing could prepare me for what I heard when I picked up the phone. In her trademarked desperation, Karen did not let me get past hello. "I can't find the cord that connects the portable TV to the cigarette lighter outlet in the van," Karen shrieked, practically in tears, her voice dripping with blame.

With the same cool precision I had used in addressing the jurors just moments before, I uttered four words that still live in infamy: "Go to Radio Shack."

With that, I replaced the receiver in its cradle and, with one crisp pivot, resumed the podium. Karen went straight to Radio Shack, purchased a new cord, fed the kids a steady diet of Disney videos—this in the day before DVDs or Blu-ray—and made it safely to Scranton with her sanity intact. And, oh yes, one other incidental detail—we won the case, and the tamoxifen patent remained in force for the rest of its natural life.

Sadly, the phone call I received twelve years later on April 14, 2011, was not from Karen, but from the hospital. And cruelly, Karen was taken from us, long before her natural life should have ended. Yet, as clichéd as it may sound, she truly was one of those rarest of people who lived life to the fullest, crammed in everything she possibly could, and was one of a kind. A personal brand that will never tarnish, never expire, can never be abandoned. A brand that will live forever.

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