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Finnegan's monthly review of essential decisions, key developments, evolving trends in trademark law, and more.

December 2013 Issue

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2013 WL 2986454 (S.D.N.Y. June 17, 2013)**

by Whitney Devin Cooke

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719 F.3d 1367 (Fed. Cir. June 18, 2013)**

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108 U.S.P.Q.2d 1463 (TTAB Sept. 30, 2013)**

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Civil Cases

Kate Spade LLC v. Saturdays Surf LLC, 2013 WL 2986454 (S.D.N.Y. June 17, 2013)

by Whitney Devin Cooke

CASE SUMMARY

FACTS

Women's apparel company Kate Spade LLC ("Kate Spade") filed an action seeking declaratory judgment that its new brand, SATURDAY, did not infringe the mark SATURDAYS SURF NYC and other SATURDAY-formative marks owned by Saturdays Surf LLC ("Surf"), a men's clothing company. Surf filed a counterclaim alleging trademark infringement and reverse confusion, claiming that Kate Spade's use of the word "Saturday" would confuse consumers by leading them to believe either that Surf's products were licensed by, affiliated with, or otherwise associated with Kate Spade, or that Surf was infringing Kate Spade's junior SATURDAY mark.

ANALYSIS

The district court analyzed Surf's trademark-infringement claims first before turning to Kate Spade's declaratory judgment action. Addressing the protectability of Surf's alleged SATURDAY-formative marks, SATURDAYS SURF NYC, SATURDAYS, and SATURDAYS SURF, the court held that SATURDAYS SURF NYC was a valid mark based on its federal registration and use as a source identifier, but noted that the scope of protection it and Surf's other asserted marks are entitled to would depend upon the strength of the mark SATURDAYS standing alone. The court ruled that the terms "Saturday" or "Saturdays" were "best described as suggestive," and the fact that "'Saturday' is a day of the week does not necessarily make it ineligible for trademark protection." The court noted that the common usage of "Saturday" or "Saturdays" in the apparel and accessories industry detracted from Surf's distinctiveness claims, and concluded that Surf should not be permitted to monopolize "Saturday" as a trademark. The court also held that Surf did not present sufficient evidence showing use of SATURDAYS as a trademark, finding among other things that the company used the mark SATURDAYS SURF NYC more often than it did SATURDAYS alone. The court also found that Surf failed to demonstrate that it used SATURDAYS SURF as a trademark for Surf's men's clothing products, as was alleged.

Turning to the likelihood-of-confusion analysis, the court considered the strength-of-the-marks factor and found that the mark SATURDAYS SURF NYC was stronger than the mark SATURDAY standing alone, but that the strength of the mark was "weakened by the fact that the word really at issue in this case—'Saturdays'—has somewhat extensive third party use." The court then considered the similarities and differences between the parties' marks, and ultimately found that the similarities were not likely to confuse consumers, given the fame of the KATE SPADE brand, which Kate Spade used in connection with its SATURDAY mark.

Regarding the actual confusion factor, the court was not persuaded by the evidence provided by Surf, namely, a single instance in which Kate Spade's SATURDAY brand shorts used in a photo shoot were mistakenly returned to Surf. The court found this evidence to be inconclusive, and likely was the result of carelessness, not confusion. Finally, the court found that Kate Spade had adopted the SATURDAY mark in good faith, citing Kate Spade's lack of knowledge about Surf and its consultation with counsel before and after learning of Surf and its SATURDAY-formative marks.

The court also rejected Surf's reverse-confusion claim, finding it unlikely that consumers would confuse Surf, a company specializing in men's clothing and licensing men's products, with Kate Spade, a famous women's apparel brand. Following its determination that there was no likelihood of consumer confusion, the court ruled in Kate Spade's favor on the infringement counterclaims and found its request for declaratory judgment to be unnecessary.

CONCLUSION

This case highlights the significance of the strength of a senior party's marks in the infringement analysis, and demonstrates that a common term, such as a day of the week, that is commonly used in a particular industry, may be entitled to a very narrow scope of protection, and may easily be distinguished by the inclusion of a well-known house mark.

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Civil Cases

Levi Strauss & Co. v. Abercrombie & Fitch Trading Co., 719 F.3d 1367 (Fed. Cir. June 18, 2013)

*by Eleanor Aktins**

CASE SUMMARY

FACTS

Levi Strauss & Company ("Levi") owns multiple federally registered trademarks for the "Arcuate" stitching design used on the back pockets of its jeans, having used the bow-shaped pattern as a source identifier since 1873. In 2005, Abercrombie & Fitch Trading Co. ("Abercrombie") applied to register a "mirror image stitching design" on the Principal Register for jackets and on the Supplemental Register for jeans, skirts, and pants. Levi opposed Abercrombie's application for registration on the Principal Register and petitioned to cancel Abercrombie's registration on the Supplemental Register, arguing the design was likely to cause confusion and to dilute Levi's mark. Levi then sued Abercrombie in the Northern District of California, alleging that jeans with the "mirror image stitching design," specifically, Abercrombie's "Ruehl" line of jeans, infringed and diluted its trademarked pattern. The PTO stayed the opposition and cancellation proceedings pending resolution of the district court litigation.

ANALYSIS

In 2009, the district court ruled for Abercrombie on both infringement and dilution. Levi appealed the 2009 judgment on dilution to the Ninth Circuit Court of Appeals, which reversed and remanded. During the appeal, Abercrombie discontinued its Ruehl brand and filed a new trademark application for the same stitching design to be used on clothing, namely, bottoms for its Gilly Hicks brand. Back at the district court, Levi requested that Abercrombie agree to include its Gilly Hicks line for consideration.

Abercrombie refused, and the district court denied Levi's subsequent request to amend its complaint.

Levi thus voluntarily dismissed the case, and the district court dismissed Levi's claim for dilution in 2011. Abercrombie then filed for summary judgment at the PTO, arguing that claim and issue preclusion barred Levi's challenges to Abercrombie's marks. The TTAB granted summary judgment for Abercrombie, finding issue preclusion but not claim preclusion, and barred Levi's opposition and cancellation proceedings due to the district court litigation.

On appeal, the Federal Circuit reversed the TTAB's decision, holding that neither issue preclusion nor claim preclusion barred Levi's cancellation and opposition proceedings at the PTO. In addressing issue preclusion, the Federal Circuit held that the 2009 judgment on dilution could not support either form of preclusion because the decision was reversed on appeal, and thus was not "an extant final judgment on the merits, as required for claim preclusion." Additionally, the 2011 judgment on dilution had no issue-preclusive effect because it was voluntarily dismissed, and thus did not decide any specific issue. The only adjudication potentially sufficient for issue-preclusion purposes was the 2009 judgment on infringement. However, even this did not bar the opposition and cancellation determinations because the

PTO proceedings involved a broader set of issues than those presented and adjudicated in the district court. For example, the infringement action only considered specific products, comparing the Ruehl brand of jeans to Levi's protected trademarks. In contrast, the TTAB proceedings involved confusion with respect to all goods for which Abercrombie sought registration, namely, jeans, skirts, shorts, pants, and jackets. Moreover, the infringement action was based in large part on how the goods appeared in the marketplace, whereas the PTO proceedings were not.

The Federal Circuit also held claim preclusion inapplicable, finding the TTAB proceedings and the district court proceeding did not involve the same transactional facts. Rather, Levi's dilution claim, like its infringement claim, challenged the uses of the stitching design that Abercrombie used on its Ruehl line of clothing, not the full range of goods that Abercrombie's application and registration sought to cover. The Federal Circuit reasoned that an alternative ruling would require owners of famous marks to litigate the entire range of potential uses for the allegedly infringing mark, even those uses that may be necessary for broad PTO registration, but that are irrelevant to the dilution claim. Accordingly, the Federal Circuit held that neither issue preclusion nor claim preclusion prevented Levi's challenges to Abercrombie's mark, and reversed and remanded the case for further determination of the TTAB proceedings.

CONCLUSION

This ruling is noteworthy because it holds that neither issue preclusion nor claim preclusion bar a trademark challenge asserted at the PTO, despite previous district court litigation addressing dilution and infringement.

**Eleanor Atkins is a Law Clerk at Finnegan.*

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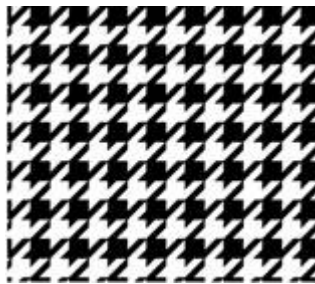
***Bd. of Trustees of Univ. of Alabama v. Pitts,* 107 U.S.P.Q.2d 2001 (TTAB July 23, 2013)**

by Naresh Kilaru

CASE SUMMARY

FACTS

The University of Alabama ("University") and the estate of Paul Bryant (a legendary football coach at the University who passed away in 1983) claimed rights in a houndstooth pattern and opposed the registration of a design mark for clothing consisting of the words HOUNDSTOOTH MAFIA displayed against a houndstooth background:



University's Houndstooth Pattern



Applicant's Mark (disclaims "houndstooth")

ANALYSIS

Given that houndstooth is a known textile pattern, the key question that the TTAB considered was whether the University could establish proprietary rights.

As an initial matter, the TTAB found that the University could not have acquired trademark rights in the pattern from Coach Bryant or his estate. Although it was undisputed that Coach Bryant was well known for wearing houndstooth-patterned fedoras at the University's football games, there was no evidence that Bryant ever used the pattern as a trademark in connection with any products or services.

With respect to the University's use of the pattern, much of the evidence submitted by the University failed to show trademark use. For instance, the University pointed to various promotional publications, including yearbooks, sports programs, and brochures, featuring Coach Bryant wearing a houndstooth-patterned fedora. The TTAB found that these uses merely showed ornamental use of a houndstooth fabric pattern, and not use that created any association between the pattern and any services offered by the University.

Although the University did use the pattern on apparel products, it had to establish common-law rights (as it did not own a federal registration) and prove the pattern was either inherently distinctive or had acquired distinctiveness. While the TTAB did not rule out the possibility that a houndstooth pattern could

be inherently distinctive depending on the manner in which it was used, the evidence showed the University's use was ornamental insofar as the pattern was employed merely as a background design on the surface of apparel products that contained one or more of the University's other trademarks. Applying the test set forth in *Seabrook Foods Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342 (C.C.P.A. 1977), the TTAB concluded that such use of a known fabric pattern design as background was not "unique or unusual" and was highly unlikely to create a distinct commercial impression.

With respect to acquired distinctiveness, the TTAB noted that a party seeking to establish acquired distinctiveness in a common or ornamental pattern has an "unusually heavy burden." Also, because the University's houndstooth pattern was a background design used in conjunction with other trademarks, the University was required to prove that the pattern acquired distinctiveness separately and apart from any other University indicia. Applying this standard, the TTAB found there was no evidence showing that the University ever promoted its houndstooth pattern separately (for instance, through "look for" advertising) or that the pattern created a separate commercial impression apart from the University's other marks. The University also failed to provide any survey evidence. Although the University offered testimony that it licensed the houndstooth pattern, it did not provide copies of the license agreements and there was no evidence that the pattern itself (as opposed to the University's other marks) was the subject matter of the agreements. Likewise, although the University submitted evidence of substantial sales of licensed apparel (\$330 million over a five-year period), the sales figures did not break down the actual dollar amount of sales for merchandise bearing the pattern. The TTAB also found it significant that the University's graphic-standards manuals from 2010-2012 setting forth the guidelines for reproducing the University's trademarks did not even identify the houndstooth design as one of the University's marks. Finally, there was substantial evidence of third-party use of the pattern for apparel items that undermined the University's claim of trademark rights. All of the above left the TTAB with little basis to find that the houndstooth pattern had acquired distinctiveness.

CONCLUSION

This case is a useful reminder that the standard for establishing trademark rights in common patterns is extremely high, particularly when the pattern is used only as a background design in conjunction with other trademarks. Unless it can be proven that the pattern itself is distinctive, separate and apart from any other indicia, the use of the pattern will likely be considered ornamental and unprotectable.

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In re Hulting, 107 U.S.P.Q.2d 1175 (TTAB June 10, 2013)

by Brian Westley

CASE SUMMARY

FACTS

Applicant Thomas Hulting filed an intent-to-use application to register the mark “No More RINOs!” for bumper stickers, paper signs, clothing, and campaign buttons.



The examining attorney refused registration under Sections 1, 2, and 45 of the Lanham Act on the ground that the mark was “merely ornamental and informational matter and does not function as a mark” for goods in the classes applied for. The examiner submitted evidence showing that “No More RINOs!” is a commonly used and well-recognized political slogan meaning “No More Republicans In Name Only.” Applicant responded by submitting substitute specimens that included the tagline “by Statesman Enterprises.”



After the examiner's final refusal of registration, Applicant appealed to the TTAB.

ANALYSIS

The TTAB first noted that not every designation placed on or used in connection with a product functions as a trademark. The TTAB explained that common laudatory phrases ordinarily used in business or in a particular trade or industry are not registrable, citing to ONCE A MARINE, ALWAYS A MARINE (an informational slogan "to express support, admiration or affiliation with the Marines"); DRIVE SAFELY ("an everyday, commonplace safety admonition"); and THINK GREEN ("an informational slogan encouraging environmental awareness"). The critical inquiry, the TTAB stated, is how the designation is perceived by the relevant public. In making such a determination, the TTAB looks to specimens and other evidence showing how the designation is used in the marketplace.

Here, the TTAB explained that evidence submitted by the examining attorney showed that consumers are accustomed to seeing the phrase "No more RINOs!" on clothing and other items from many sources. Consumers therefore would not perceive the phrase as a source indicator but instead as a political slogan.

The TTAB also determined that the placement of Applicant's proposed mark in large, prominent lettering in the center of each specimen was consistent with informational or ornamental use, not trademark use. The TTAB explained that such prominence was more consistent with conveying an informational message rather than signifying a brand or an indicator of source. The TTAB noted that although the phrase "No More RINOs!" displayed on the T-shirt, shown above, was proportionally smaller than the other specimens of use, it still did not have the commercial impression of a source indicator, given the phrase's significance as a political slogan.

Refusal was improper, Applicant asserted, in view of the substitute specimens he filed bearing the tagline "by Statesman Enterprises." But the TTAB concluded that this tagline was irrelevant because it was not part of the applied-for mark and it did not render the slogan capable of functioning as a mark. Even if the tagline did convey that the goods came from a particular source, the tagline communicated that information, not the slogan which the Applicant was trying to register.

Finally, the TTAB determined that Applicant's intent that the slogan should function as a mark was irrelevant to its analysis. "Mere intent that a term function as a trademark is not enough in and of itself, any more than attachment of the trademark symbol would be, to make a term a trademark."

CONCLUSION

This decision underscores that matter must function as a trademark to be registrable, and that commonly used political slogans will likely be unregistrable as trademarks.

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***Swatch AG v. M.Z. Berger & Co.,* 108 U.S.P.Q.2d 1463 (TTAB Sept. 30, 2013)**

by Laura K. Johnson

CASE SUMMARY

FACTS

Opposer Swatch AG ("Swatch") introduced its SWATCH-brand watches in the United States in the 1980s. M.Z. Berger & Co., Inc. ("Berger") manufactured, imported into the United States, and sold watches and clocks under many different brand names for more than sixty years. In 2007, Berger filed an intent-to-use application to register the mark IWATCH for watches, clocks, and thirty additional subsidiary goods.

Swatch opposed Berger's IWATCH application based on a likelihood of confusion with its registered SWATCH marks for watches, and on Berger's alleged lack of a bona fide intent to use the IWATCH mark in commerce at the time it filed its application, thus rendering the application void under Section 1(b) of the Trademark Act.

In an attempt to prove that it did have the requisite bona fide intent to use the IWATCH mark at the time its application was filed, Berger relied on (1) a trademark search in Class 14 that was conducted by a nonattorney employee who handled the prosecution of the matter; (2) an internal company e-mail relating to discussions with the examining attorney that "essentially echoes the wording of a response to an Office Action"; and (3) internal e-mails forwarding sample mock-ups and product renderings featuring stylized versions of the IWATCH mark, and one clock and two watches bearing the IWATCH mark.

According to Berger's deposition testimony, the pictures and images were created to submit to the examining attorney as "samples of advertisements or promotional materials of both watches and clocks," and were not created for any promotional or other purpose. Berger also submitted conflicting deposition testimony from a company employee and its owner/chief executive officer regarding its bona fide intent to use the mark.

ANALYSIS

Following briefing and an oral hearing, the TTAB rejected Swatch's likelihood-of-confusion claim, finding that the marks SWATCH and IWATCH differed significantly under the first *du Pont* factor. The TTAB determined that inclusion of the generic word "watch" into both parties' marks was an insufficient basis for finding likelihood of confusion. The mere fact that the parties' marks share a common generic root does not automatically render them similar. Thus, despite finding the SWATCH mark to be famous, the TTAB held that the "i" and "s" addition to the generic term "watch" caused the marks to differ sufficiently in sound, meaning, appearance, and overall commercial impression.

As to its second claim, Swatch bore the burden of demonstrating by a preponderance of the evidence that Berger lacked a bona fide intent to use the IWATCH mark on the identified goods at the time it filed its application. This may be done, the TTAB noted, by proving that the applicant lacks any documentary evidence to support its intent-to-use allegation at the time its application was filed.

The TTAB concluded that Berger had offered insufficient documentation to demonstrate that it had a good-faith intent to use the IWATCH mark in commerce at the time its application was filed. The evidence of record—the trademark search, and the internal e-mails about potential specimens of use for clocks and watches and the trademark application—was found to relate only to the application for the IWATCH trademark, and failed to demonstrate that Berger had made any effort to develop and market IWATCH-branded products to potential buyers.

While the TTAB held that the creation of mock-ups and renderings can be used by trademark applicants to evidence the product-development process, the “samples of promotional materials” that Berger tried to rely on had only been submitted to the examining attorney, and were not actually used in commerce. This lack of evidence was underscored by the Berger nonattorney employee’s testimony that Berger never had a bona fide intent to use the IWATCH mark on the subsidiary goods and that she had included them in the application “to leave all doors open.”

Finally, the TTAB recognized that a trademark clearance search may in some situations be probative evidence of a bona fide intent to use a mark. However, it concluded that a review of the evidence as a whole demonstrated that Berger’s intent at the time it filed its application was “merely to reserve a right in a mark” in case it made a future decision to begin developing products. The evidence was thus insufficient to prove that Berger had a good-faith intention to use the IWATCH mark in commerce at the time it filed its application, and the TTAB sustained the opposition on that ground.

On November 26, 2013, Berger appealed the TTAB’s decision to the Federal Circuit. The parties have yet to submit briefs in the appeal.

CONCLUSION

Despite its tenuous likelihood-of-confusion claim as between the marks SWATCH and IWATCH for watches and clocks, Swatch was nonetheless able to successfully oppose Berger’s application. In doing so, it added to the TTAB’s growing list of cases finding an application void for a lack of a demonstrable bona fide intent to use a mark in commerce. Applicants must be prepared to produce adequate documentation of their prefiling intent to use the applied-for mark for *all* goods and/or services identified in their trademark application. Those seeking coverage for a wide range of goods and services are particularly susceptible to challenge under Section 1(b).

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