



Destination IP Virtual Summit

# 2020 Mid-Year Review: Top TM Rulings and Practice Updates

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## Before We Get Started...



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A link to the recording and slides will be emailed to all registrants.



### Questions

Type in the question box and we will answer in real time or during the Q&A.



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# Panel

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**Pamela Huff**  
Trademark Principal



**Jessica McDonald**  
Trademark Attorney

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# Episode Overview

- 2019-2020 Federal Trademark rulings
- 2019-2020 TTAB rulings
- Recent USPTO Trademark Practice Updates



# Federal Trademark Rulings

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- *United States Patent and Trademark Office et al. v. Booking.com B.V.*
- *Romag Fasteners, Inc. v. Fossil, Inc. et al.*
- *Tiffany & Co. v. Costco Wholesale Corp.*
- *Royal Crown Company, Inc. and Dr Pepper/Seven Up, Inc., v. The Coca-Cola Company*
- *Woodstock Ventures LC v. Woodstock Roots, LLC*





# USPTO v. Booking.com B.V.

- 591 U.S. \_\_\_ (2020)
  - Argued: May 4, 2020
  - Opinion: June 30, 2020
  - Judgment: Affirmed, 8-1. Opinion by Justice Ginsburg. Justice Sotomayor filed a concurring opinion. Justice Breyer filed a dissenting opinion.
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# Booking.com

Examples of Use submitted in  
Joint Appendix filed with  
SCOTUS on January 6, 2020



# Procedural History

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- *USPTO* – Examiner and TTAB maintained a *per se* rule that adding ".com" to a generic term is unprotectable and refused registration.
- *United States District Court for the Eastern District of Virginia* – Held Booking.com as compared to "booking" is not generic.
- *Fourth Circuit Court of Appeals* – Affirmed - holding Booking.com was a descriptive mark recognizable by consumers as a brand. Rejected USPTO's *per se* rule that combining a generic term with ".com" results in a generic composite.





**Issue:** Whether the addition of “.com” to a generic term can result in a protectable trademark.

**Holding:** A term styled “generic.com” is a generic name for a class of goods or services—and thus ineligible for federal trademark protection—only if the term has that meaning to consumers.

Whether a “generic.com” mark is generic turns on whether that term, as a whole, signifies to consumers a class of goods or services.

# USPTO's Position



- Argued for a *per se* rule for "generic.com" marks
- Anti-competitive concerns limiting third-party rights to use generic term

# Booking.com's Position

**Booking.com**

- Lead to cancellation of other registered marks
- Harder to protect against cybersquatters and typosquatters

**“If ‘Booking.com’ were generic, we might expect consumers to understand Travelocity—another such service—to be a ‘Booking.com.’ We might similarly expect that a consumer, searching for a trusted source of online hotel-reservation services, could ask a frequent traveler to name her favorite ‘Booking.com’ provider. Consumers do not in fact perceive the term ‘Booking.com’ that way, the courts below determined.” – SCOTUS**



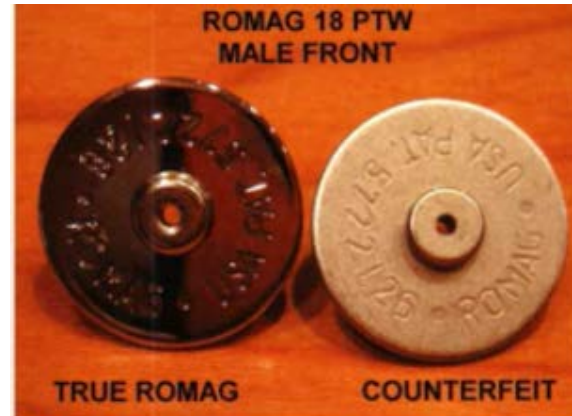
# Romag Fasteners, Inc. v. Fossil, Inc. et al.

- 140 S. Ct. 1492 (2020)
  - Argued: January 14, 2020
  - Opinion: April 23, 2020
  - Judgment: Vacated and remanded, 9-0. Opinion by Justice Gorsuch. Justice Alito filed a concurring opinion, in which Justices Breyer and Kagan joined. Justice Sotomayor filed an opinion concurring in the judgment.
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**Issue:** Whether willful infringement is a prerequisite to an award of profits under 15 U.S.C. §1117(a).

**Holding:** Willfulness is a highly important consideration in awarding profits under §1117(a) but not an absolute precondition.



# Procedural History

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- *United States District Court for the District of Connecticut* – Jury held for Romag as to trademark infringement but rejected Romag's accusation that Fossil had acted willfully. District Court held that willfulness is required for an award of profits.
- *Federal Circuit Court of Appeals* – Affirmed – Held that Romag was required to prove willfulness in order to recover an award of profits for trademark infringement.
- *Supreme Court* – Vacated and remanded – holding that willfulness was a highly important consideration in awarding profits under 15 U.S.C. Section §1117(a) but was not a prerequisite for such an award.

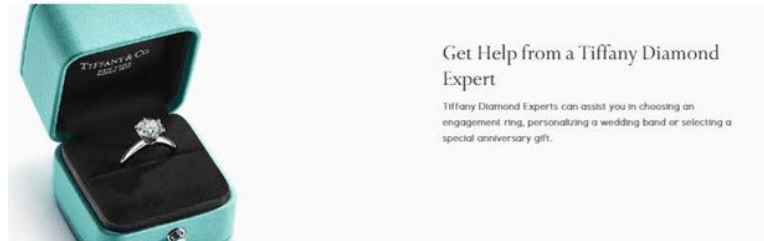
# Tiffany & Co. v. Costco Wholesale Corp.



# Procedural History

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- *United States District Court for the Southern District of New York* – District Judge held that the use of the TIFFANY mark by Costco constituted trademark infringement and counterfeiting. District Court's ruling called for jury to determine damages.
- In a two-phase damages trial, the jury awarded approximately \$15 million in damages. The Judge then rejected Costco's challenge to how damages had been calculated and ruled that Tiffany would be entitled to \$6 million in attorney's fees.
- *United States Court of Appeals, Second Circuit* – In 2017, Costco appealed to Second Circuit. Decision is expected in 2020.



## Get Help from a Tiffany Diamond Expert

Tiffany Diamond Experts can assist you in choosing an engagement ring, personalizing a wedding band or selecting a special anniversary gift.



# Royal Crown Company, Inc. and Dr Pepper/Seven Up, Inc., v. The Coca-Cola Company

Fed. Cir. August 3, 2020

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# Procedural History

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- Multiple "Zero" applications by Coca-Cola were opposed after Coca-Cola's claim of acquired distinctiveness was successful and no disclaimer was required.
- Opposition was dismissed, in part, after TTAB held that Royal Crown had not carried its burden in establishing "Zero" was generic for the genus of goods, and Coca-Cola had established "Zero" had acquired distinctiveness.
- *Federal Circuit Court of Appeals* – Vacated Board's decision and remanded – Board erred in its legal framing of genericness inquiry and failed to take into account that the burden of establishing acquired distinctiveness increases with the level of descriptiveness.
- *TTAB* – dismissed Royal Crown's consolidated oppositions after granting Coca-Cola's motion to amend applications to add disclaimer of "Zero." Royal Crown appealed to the Federal Circuit Court of Appeals.

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**Issue:** Was TTAB's granting Coca-Cola's motion to amend applications to add disclaimer of "Zero" procedurally improper and did disclaimers render the appeal moot.

**Holding:** Board did not abuse its discretion in granting the motion and that entry of the disclaimers rendered this appeal moot.



# Woodstock Ventures LC v. Woodstock Roots, LLC

- Decided July 29, 2019
- 387 F. Supp. 3d 306 (S.D.N.Y. 2019)
- Appealed to the *Second Circuit Court of Appeals*



# Woodstock Ventures LC

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- **WOODSTOCK** for clothing, entertainment services, motion pictures, and in connection with the 1969 music festival.
- Sought to sell cannabis and cannabis related goods under **WOODSTOCK** mark



# Woodstock Roots, LLC

- **WOODSTOCK** for smokers' articles.
- Sought to enjoin the selling of cannabis and cannabis-related products alleging goods fall within the natural zone of expansion of its marks.
- Failed to demonstrate a likelihood of confusion between the use of **WOODSTOCK** for recreational marijuana and its use of **WOODSTOCK** for smokers' articles.



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**Issue:** Whether there was a likelihood of confusion between the two party's uses of **WOODSTOCK**.

**Holding:** No likelihood of confusion. Court denied the motion for preliminary injunction and ruled for the producers of the 1969 music festival. Using **WOODSTOCK** on marijuana products is not likely to infringe the trademark rights of Woodstock Roots LLC.

# TTAB Rulings

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- *Ricardo Media Inc. v. Inventive Software, LLC*
- *In re Yarnell Ice Cream, LLC*
- *In re MK Diamond Products, Inc.*







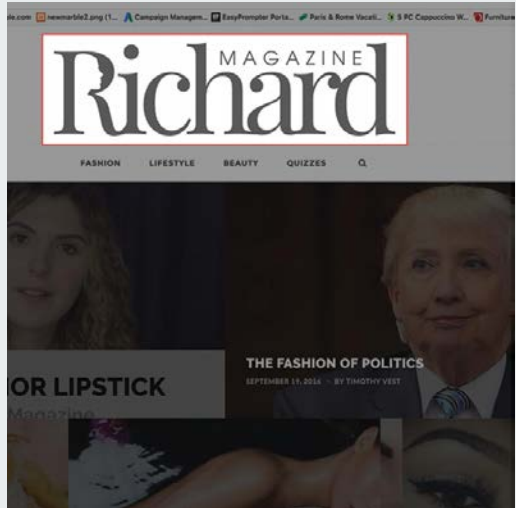
# Ricardo Media Inc. v. Inventive Software, LLC

- TTAB Opposition No. 91235063
- Decided August 21, 2019
- 2019 USPQ2d 311355 (TTAB 2019) [precedential]



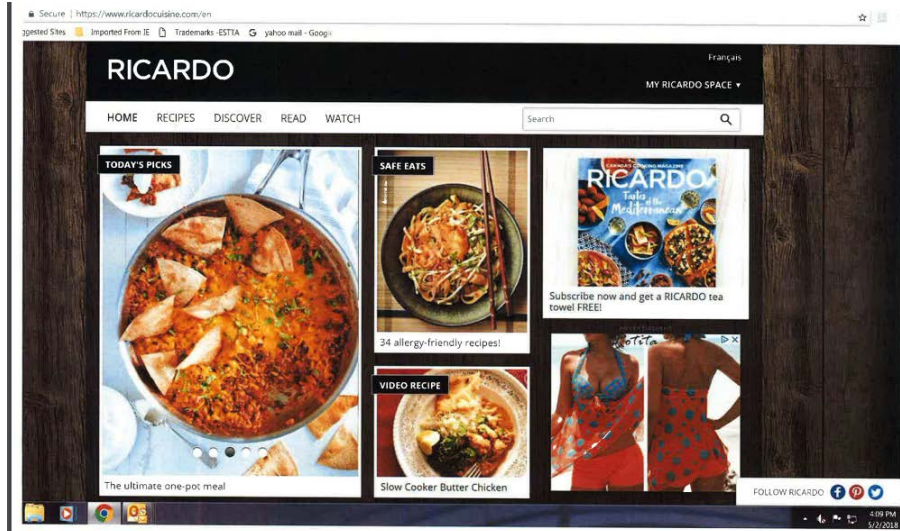
# Applicant, Inventive Software LLC

- Applied to register RICHARD MAGAZINE for online services in the fields of fashion, beauty and lifestyle.



# Opposer, Ricardo Media Inc.

- Owns a registration for RICARDO for magazines and books in the culinary field
- Opposed on the basis of a likelihood of confusion



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**Issue:** Whether the Doctrine of Foreign Equivalents applies to personal names.

**Holding:** The Doctrine of Foreign Equivalents should generally not apply to first names, *unless there is evidence that consumers would 'translate' the names.*"

# In re Yarnell Ice Cream, LLC



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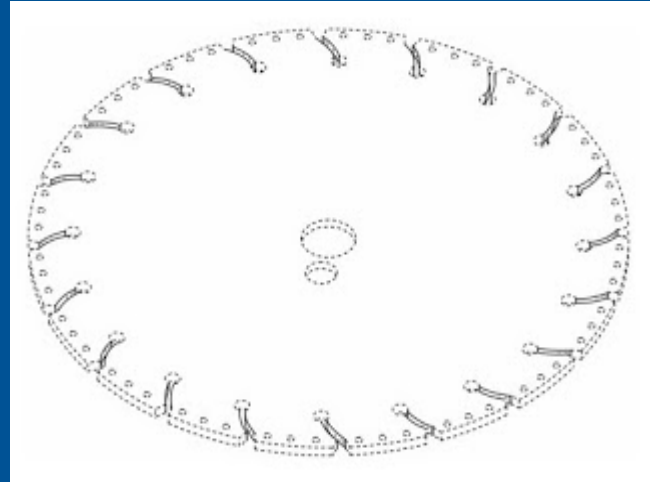
**Issue:** Whether the mark "Scoop" was entitled to registration for frozen confections and ice cream when use of the mark was through a mascot named "Scoop."

**Holding:** Affirmed refusal to register because of mark's failure to function for the identified goods, because the mark is merely descriptive, and because specimens fail to show use of the mark in commerce in connection with identified goods.

# In re MK Diamond Products, Inc.

- Serial No. 86813875
- Decision on July 27, 2020

Description of the mark: The mark consists of a configuration of a circular saw blade comprising the curved portion of a repeating slot design around the circumference of the goods. The portions of the blade shown in broken lines are intended solely to indicate the positioning of the mark and are not part of the mark.



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**Issue:** Whether the product configuration for "circular saw blades for power operated saws" was registrable.

**Holding:** Affirmed a Section 2(e)(5) refusal to register, proposed mark is *de jure* functional and failed to meet the burden of acquired distinctiveness.





# USPTO Practice Changes



# COVID-19 Prioritized Examination

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## Requirements:

- Petition to the Director under 37 CFR § 2.146(a)(3) to advance the initial examination of the application (no fee)
- Seeking registration for one or more of the following products and services:
  - Pharmaceutical products or medical devices that prevent, diagnose, treat, or cure COVID-19 and **are subject to approval by the United States Food and Drug Administration** (e.g., diagnostic tests, ventilators, and PPE, including surgical masks, face shields, gowns, and gloves), and/or
  - Medical services or medical research services for the prevention, diagnosis, treatment of, or cure for COVID-19

# Requirements for U.S. Licensed Attorneys

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- Implemented August 3, 2019
- Applies to Applicants, Registrants, or parties to a proceeding having a domicile outside of the U.S.
- Requirement for representation by a U.S. licensed attorney - Require state of bar admission, year of admission, and registration number on filings
- Goal to instill greater confidence that registrations are valid and comply with U.S. laws and more effectively ensure compliance

# USPTO Guidelines regarding Specimens

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- Examiner training in June 2019 and Examination Guide in July 2019
- Identified several factors for Examiners to consider
  - Examples*
  - missing URL or browser tab in website screenshots and date of access*
  - labeling appears crudely applied*
  - mark appears superimposed*
  - mark appears on goods known to be marketed by a 3<sup>rd</sup>-party*
  - Images of products appearing on a white background or which are too sharp or clean*
- Greater Examiner scrutiny and request for more information

# Post-Registration Proof of Use Audit Program

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A registration is potentially subject to audit when a Declaration of Use is filed and the registration contains either:

at least one class with four or more goods or services;

*For example, registration covers:*

*purses, wallets, back packs, luggage tags and suitcases (all Class 18).*

or

at least two classes with each having two or more goods or services

*For example, registration covers:*

*Purses and suitcases (Class 18)*

*Clothing, namely shirts, shorts, pants, coats and hats (Class 25)*

*Retail clothing stores (Class 35).*

# What happens if audited?

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- Issuance of Office Action identifying two (2) additional goods or services for each audited class
- Required to submit proof of use for **each** good or service identified
- If acceptable proof of use is submitted, USPTO sends notice of acceptance
- If unacceptable proof of use is submitted **or goods are deleted**, USPTO issues a second Office Action - requiring proof of use for **ALL** of the remaining goods or services in the registration
- If there are goods or services remaining in the registration for which Registrant has not provided acceptable proof of use, USPTO issue a third and final action, advising that the goods or services will be deleted.
- If no response is filed to the Office Actions, the registration will be cancelled **in its entirety**.

# Updated Login, Email and Filing Requirements

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- Requirement to login using USPTO.gov account
- Future phases – security process to verify account holder information
- Mandatory electronic filing requirement implemented February 15, 2020
- Requirement for Applicants to maintain valid email address effective February 15, 2020 – taking steps to mask Applicant's email address in all viewable documents
- Recommendations for attorneys to proactively monitor database for filings without their knowledge or consent





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Thank you for your interest.

# Questions?



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