

2005

2004 Trademark Law Decisions of the Federal Circuit

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2004 Trademark Law Decisions of the Federal Circuit

2004 TRADEMARK LAW DECISIONS OF THE FEDERAL CIRCUIT

BRUCE J. GOLDNER AND KENNETH A. PLEVAN*

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INTRODUCTION

During 2004, the Federal Circuit issued few trademark decisions of note, as the court resolved the issues it faced principally on the basis of long-standing Federal Circuit and Trademark Trial and Appeal Board (“TTAB”) precedent.

One case of interest, *In re Oppedahl & Larson LLP*,¹ presented the issue of the impact the presence of a top level Internet domain name—“.com” in this instance—has on the registrability of the mark. The Federal Circuit held that top level domain names generally do not render an otherwise generic or descriptive mark registrable, but did not rule out an analysis of the meaning of the “.com” element of the mark that might make the mark as a whole protectable.² This would particularly be the case where the top level domain name does not communicate that the applicable goods or services are being offered through the Internet, but rather imparts a different meaning altogether.³

*Shen Mfg. Co. v. The Ritz Hotel*⁴ presented an interesting factual scenario under which appellant Shen, the opposer below, has used the mark RITZ since 1892 on kitchen textiles such as dish towels, ironing board covers, and similar items.⁵ Cross-appellee-applicant has owned and operated the world famous The Ritz Hotel in Paris since 1898. The controversy itself took twenty years to resolve, as the dispute had languished at the Patent and Trademark Office (“PTO”) as a result of party inaction. In reaching the disputed issues, the Federal Circuit undertook a thorough and useful discussion of the *DuPont*⁶ relatedness-of-the-goods factor, specifically

1. 373 F.3d 1171 (Fed. Cir. 2004).

2. *Id.* at 1176 (affirming the United States Patent and Trademark Office’s determination after *de novo* review in which the mark “Patents.com” was held to be merely descriptive).

3. *Id.* at 1173-74.

4. 393 F.3d 1238 (Fed. Cir. 2004).

5. *Id.* at 1239.

6. The *DuPont* factors are used in the Federal Circuit to analyze whether a likelihood of confusion exists between two marks. These are:

(1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound connotation and commercial impression. (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use. (3) The similarity or dissimilarity of established, likely-to-continue trade channels. (4) The conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing. (5) The fame of the prior mark (sales, advertising, length of use). (6) The number and nature of similar marks in use on similar goods. (7) The nature and extent of any actual confusion. (8) The length of time during and conditions under which there had been concurrent use without evidence of actual confusion. (9) The variety of goods on which a mark is or is not used (house mark, ‘family’ mark, product mark. . .) (10) The market interface between applicant and the owner of a prior mark. . . (11) The extent to which applicant has a right to exclude others from use of its mark on its goods. (12) The extent of potential confusion, i.e., whether *de minimus* or substantial. (13) Any other established fact probative of the

addressing whether goods are sufficiently unrelated so that identical marks may co-exist.

Of a total of thirteen opinions on trademark issues in 2004, seven were substantive⁷ and six were procedural.⁸ All six of the procedural opinions were affirmances of TTAB decisions and are not citable as precedent. Two of these procedural opinions were issued per curiam.⁹ This strongly suggests that the Federal Circuit believes that the TTAB should have wide latitude in managing its docket, and that TTAB litigants would be well advised to pay careful attention to procedural rules and rulings.

Of the thirteen, only two cases were appeals from district court decisions,¹⁰ and while one was a reversal in part,¹¹ the rest were all affirmances.¹²

I. SUBSTANTIVE TRADEMARK ISSUES

A. Likelihood of Confusion

1. *Nautilus Group, Inc. v. Icon Health & Fitness, Inc.*¹³

The *Nautilus Group* case came to the Federal Circuit on an interlocutory

effect of use.

In re E.I. DuPont de Nemours & Co., 476 F.2d 1357, 1361 (C.C.P.A. 1973), cited in *In re* Chatam Int'l Inc., 380 F.3d 1340, 1342 (Fed. Cir. 2004).

7. *Shen Mfg. Co.*, 393 F.3d at 1238; *Cross Country Bank v. Cross Country Fin. Corp.*, No. 04-1371, 2004 U.S. App. LEXIS 26725 (Fed. Cir. Dec. 13, 2004); *In re* DSS Env'tl., Inc., No. 04-1041, 2004 U.S. App. LEXIS 21994 (Fed. Cir. Oct. 20, 2004); *In re* Chatam Int'l Inc., 380 F.3d at 1340; *In re* Oppedahl & Larson LLP, 373 F.3d at 1171; *Nautilus Group, Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330 (Fed. Cir. 2004); *Payday Garden City, LLC v. Cmty. Fin. Servs. Ass'n of America*, No. 03-1359, 2004 U.S. App. LEXIS 3100 (Fed. Cir. Feb. 6, 2004).

8. *Detroit Entm't, LLC v. Motor Cities Casinos, LLC*, No. 04-1218, 2004 U.S. App. LEXIS 22580 (Fed. Cir. Oct. 12, 2004); *Stoller v. Ponce*, No. 04-1305, 2004 U.S. App. LEXIS 22208 (Fed. Cir. Oct. 8, 2004); *Osmosis Tech. Inc. v. GE Osmonics, Inc.*, No. 04-1407, 2004 U.S. App. LEXIS 19411 (Fed. Cir. Aug. 20, 2004); *Leoutsakos v. Coll's Hosp. Pharm., Inc.*, No. 03-1533, 2004 U.S. App. LEXIS 8774 (Fed. Cir. May 4, 2004); *Central Mfg. v. Surgical Navigation Tech., Inc.*, No. 03-1414, 2004 U.S. App. LEXIS 5033 (Fed. Cir. Mar. 17, 2004); *Mattel, Inc. v. Henson*, No. 03-1360, 2004 U.S. App. LEXIS 1596 (Fed. Cir. Feb. 3, 2004).

9. *Detroit Entm't, LLC*, 2004 U.S. App. LEXIS 22580; *Mattel, Inc.*, 2004 U.S. App. LEXIS 1596.

10. *Leoutsakos*, 2004 U.S. App. LEXIS 8774; *Nautilus Group, Inc.*, 372 F.3d at 1330.

11. *Shen Mfg. Co.*, 393 F.3d at 1246.

12. *In re* DSS Env'tl., Inc., 2004 U.S. App. LEXIS 21994; *Cross Country Bank*, 2004 U.S. App. LEXIS 26725; *Detroit Entm't, LLC*, 2004 U.S. App. LEXIS 22580; *Stoller*, 2004 U.S. App. LEXIS 22208; *Osmosis Tech. Inc.*, 2004 U.S. App. LEXIS 19411; *Leoutsakos*, 2004 U.S. App. LEXIS 8774; *In re* Chatam Int'l Inc., 380 F.3d at 1332; *In re* Oppedahl & Larson LLP, 373 F.3d at 1171; *Nautilus Group, Inc.*, 372 F.3d at 1330; *Central Mfg.*, 2004 U.S. App. LEXIS 5033; *Payday Garden City, LLC*, 2004 U.S. App. LEXIS 3100; *Mattel, Inc.*, 2004 U.S. App. LEXIS 1596.

13. 372 F.3d at 1330.

appeal from the District Court of the Western District of Washington.¹⁴ Applying Ninth Circuit standards, the Federal Circuit affirmed the trial court's grant of a preliminary injunction to plaintiff Nautilus, finding that the district court had not abused its discretion.¹⁵

Plaintiff Nautilus, an exercise equipment manufacturer, owns the trademark BOWFLEX, registered in 1986 and used since 1984, on the Bowflex Exerciser, a resistance training system.¹⁶ The system uses vertical bendable rods which "bow" outward when the resistance cable is pulled.¹⁷ In addition, Nautilus holds two patents covering the technology for the Bowflex product.¹⁸

Another exercise equipment manufacturer, defendant Icon, introduced a competing resistance training system in 2002, called the CROSSBOW.¹⁹ Icon's system uses horizontal bendable rods that bend outward, resembling a medieval crossbow weapon.²⁰ In Icon's mark, the "O" in CROSSBOW was represented by circular crosshairs and beneath the word mark was the line "by Weider." Both companies advertised their equipment in similar channels, such as infomercials and the Internet.²¹

After reviewing the standards for granting a preliminary injunction,²² the Federal Circuit outlined the often-cited *Sleekcraft* factors, the Ninth Circuit's rendition of the digits of confusion.²³ The court's opinion principally focused on four of the confusion factors: intent to confuse, evidence of actual confusion, the strength of Nautilus's mark, and the similarity of the marks.²⁴

In analyzing the intent to confuse factor, the Federal Circuit noted that intent can be inferred when a similar mark is adopted by a defendant who

14. Federal Circuit jurisdiction was predicated on patent infringement claims in the lawsuit. *Id.* at 1334.

15. *Id.* at 1330, 1332, 1333-34.

16. *Id.* at 1332-33.

17. *Id.* at 1332.

18. *Id.* at 1333.

19. *Id.*

20. *Id.*

21. *Id.*

22. Under Ninth Circuit case law, a plaintiff seeking a preliminary injunction must demonstrate either probable success on the merits of the case and the possibility of irreparable injury, or the existence of serious questions on the merits of the case and that the balance of hardships tips in its favor. *Id.* at 1334 (citing *GoTo.com, Inc. v. Walt Disney Co.*, 202 F.3d 1199, 1205 (9th Cir. 2000)).

23. The *Sleekcraft* factors, as outlined by the Federal Circuit, are:

(1) the similarity of the marks, (2) the relatedness or proximity of the two companies' products or services, (3) the strength of the registered mark, (4) the marketing channels used, (5) the degree of care likely to be exercised by the purchaser in selecting goods, (6) the accused infringers' intent in selecting the mark, (6) the accused infringers' intent in selecting the mark, (7) evidence of actual confusion, and (8) the likelihood of expansion in product lines.

Id. at 1335 (citing *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979)).

24. *Id.* at 1334-36.

has “actual or constructive knowledge of the plaintiff’s mark,”²⁵ but that this factor is accorded minimal importance when considering the *Sleekcraft* factors together.²⁶ Icon contended that the choice to use the word “bow” in its mark was not to capitalize on the BOWFLEX fame but because of the resemblance of the shape of their machine to a crossbow.²⁷ In support, Icon pointed to the differences in the marks, such as the “by Weider” source designation.²⁸ The Federal Circuit, agreeing that the district court’s findings on this issue were conclusory and not sufficiently specific, ultimately discounted this factor.²⁹

Regarding evidence of the actual confusion factor, the Federal Circuit again agreed with Icon that Nautilus’s evidence was unreliable because the specific incidents of confusion could have been attributable to product similarity, not mark similarity.³⁰ The court consequently decided not to weigh this factor in favor of either party.³¹

Icon also challenged the district court’s finding that BOWFLEX was a strong mark. Icon argued that the mark BOWFLEX lacked distinction because the word “bow” was either generic or descriptive and therefore entitled to less protection.³² The trial court held that Nautilus’s mark was suggestive, not descriptive, because the consumer had to make a mental leap between the word mark and the product image.³³ Additionally, the trial court found that Nautilus’s twenty-year investment in marketing and advertising its mark resulted in substantial market strength. Given the strong evidence of brand recognition, the Federal Circuit did not find any error in these determinations.³⁴

Next, the Federal Circuit addressed Icon’s contentions regarding the district court’s analysis of the similarity of the marks. The district court

25. *Id.* at 1337 (citing *Brookfield Communications Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1059 (9th Cir. 1993) (citation omitted)).

26. *Id.*

27. *Id.*

28. *Id.* at 1336.

29. *Id.* at 1336-37.

30. In the district court, Nautilus had submitted the transcripts of four phone calls made to its customer service center as evidence of actual confusion. *Id.* at 1337. Icon challenged the evidence on two grounds: first, that four calls out of thousands were too few to be sufficient for a showing of actual confusion, and second, that the transcript of the calls indicate confusion stemming from the similarity of the products, not the trademarks. *Id.* at 1338. Upon reviewing the transcripts, the court noted that in each one, the caller either was confused by the similarity of the machines or knew the difference between the two companies and thus the submitted evidence was not indicative of actual trademark confusion. *Id.* at 1339 n.6.

31. *Id.* at 1337-39.

32. *Id.* at 1341.

33. *Id.* at 1343. The difference between whether a mark is suggestive or descriptive turns on how “immediate and direct . . . the thought process [is] from the mark to the particular product.” *Id.* at 1340.

34. *Id.* at 1340-43.

had determined that the two marks, BOWFLEX and CROSSBOW, were “only somewhat similar” because the meaning, appearance, and sound of the marks were different.³⁵ However, because the products were identical, the district court found this sufficient to weigh the factor in favor of Nautilus.³⁶ Icon contended that if the meaning, appearance, and sound of the marks are different, the finding should be that the marks are not similar. Icon also contended that the evaluation of the marks should focus on the words “flex” and “cross” separately rather than the mark as a whole.³⁷ The Federal Circuit agreed with Icon only to the extent that likelihood of confusion cannot be found without the marks being similar, but disagreed that the district court had erred on this factor.³⁸

In reaching this conclusion, the Federal Circuit declined to evaluate the marks in their components, stating that marks should be compared in their entirety. Because the marks share the word “bow,” the court concluded that they were “at least somewhat similar.”³⁹ Although the Federal Circuit did not cite the “anti-dissection” rule in this analysis, that principle is well-established in both the Federal Circuit and the Ninth Circuit.⁴⁰

Icon also made the novel argument that when a court determines that two marks are similar, it must, in order to find a likelihood of confusion, also find a causal link between the similarity of the marks and any confusion. This argument was rejected summarily as not a part of a digits-of-confusion analysis.⁴¹

Even though it discounted the intent-to-infringe and evidence-of-actual confusion factors, the Federal Circuit concluded that there was enough evidence to sustain the district court’s grant of the preliminary injunction, specifically the similarity of the marks, the proximity of the products and services, the strength of the BOWFLEX mark, and the similarity of marketing channels used by both parties.⁴² Ultimately, the Federal Circuit reasoned that even though the similarity of the marks was weak, this weakness was offset by the strength of the other factors, and given the limited scope of review, there was no basis to find that the district court had abused its discretion.⁴³

35. *Id.* at 1343.

36. *Id.*

37. *Id.* at 1344.

38. *Id.* at 1343-45.

39. *Id.* at 1345.

40. *See* *Official Airline Guides, Inc. v. Churchfield Publ., Inc.*, 6 F.3d 1385, 1392 (9th Cir. 1993) (“[U]nder the anti-dissection rule, the validity and distinctiveness of a composite trademark is determined by viewing the trademark as a whole, as it appears in the marketplace.”). The Federal Circuit’s anti-dissection rule is discussed in case summaries following this one.

41. *Nautilus Group, Inc.*, 372 F.3d at 1343-44.

42. *Id.* at 1346.

43. *Id.*

2. *In re Chatam International Inc.*⁴⁴

This case came before the Federal Circuit on an appeal from the TTAB's refusal to register a mark because of the likelihood of confusion between appellant Chatam's proposed mark and a prior registration.⁴⁵ Applying the substantial-evidence standard of review, the Federal Circuit affirmed the Board's determination.⁴⁶

In 2000 Chatam filed an intent-to-use application with the PTO for the mark JOSE GASPARD GOLD for a tequila brand.⁴⁷ The PTO examining attorney refused registration on the basis that there was a likelihood of confusion with the registered mark GASPARD ALE.⁴⁸ In coming to this conclusion, the examiner noted that GASPARD was the dominant feature of both parties' mark.⁴⁹

Chatam responded by contending that ale and tequila were two different classes of goods and challenged the examiner's conclusion that the word GASPARD was the dominant feature of the marks.⁵⁰ The examiner denied the response, reasserting that GASPARD was the dominant feature of the marks and that "tequila or liquor and beer or ale enjoy a close relationship."⁵¹ Chatam appealed, and the Board affirmed the examiner's refusal based on two factors of the *DuPont* test: similarity of the marks, and similarity of the goods in a commercial sense.⁵² The Board also noted that any doubt is resolved against the newcomer because of the newcomer's obligation and opportunity to avoid using a confusing mark.⁵³

On appeal, the Federal Circuit first noted that whether a likelihood of confusion exists is a legal question the Federal Circuit reviews without deference, whereas the factual findings underpinning the legal conclusion are reviewed under the standard of "substantial evidence."⁵⁴ The Federal Circuit focused its analysis on the same two factors as the Board, namely similarity of the respective marks and goods.⁵⁵

Chatam argued on appeal that the words JOSE, GOLD, and ALE as additions to the marks result in different commercial impressions, and that the Board improperly dissected the marks to support its finding of

44. 380 F.3d 1340 (Fed. Cir. 2004).

45. *Id.* at 1341.

46. *Id.* at 1342.

47. *Id.* at 1341.

48. *Id.*

49. *Id.*

50. *Id.*

51. *Id.*

52. *Id.* at 1342.

53. *Id.*

54. "Evidence is substantial if 'a reasonable person might find that the evidentiary record supports the agency's conclusion.'" *Id.* (quoting *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085 (Fed. Cir. 2000)).

55. *Id.* at 1343-44.

similarity.⁵⁶ In addressing this argument, the Federal Circuit acknowledged the anti-dissection rule, that “a likelihood of confusion ‘cannot be predicated on . . . only part of a mark’”⁵⁷ but also pointed out that “it is not improper to state that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties.”⁵⁸ In applying these principles, the Federal Circuit found that the Board properly came to its determination that the marks convey the same commercial impression, namely that “a name GASPARG is the source of related alcoholic beverages, tequila and beer or ale.”⁵⁹

The Board discounted the commercial significance of the word ALE because it was disclaimed in the registration.⁶⁰ The Board also discounted the commercial significance of the words JOSE and GOLD.⁶¹ It found that JOSE reinforces the impression that GASPARG is a name rather than distinguishing it from GASPARG.⁶² GOLD denotes a descriptive term of quality, also not offering appreciable differentiation in commercial impression between the two marks. As the Federal Circuit stated, “viewed in their entireties with non-dominant features appropriately discounted, the marks [‘Gaspar’ and ‘Gaspar’s’] become nearly identical.”⁶³

With respect to the second consideration, relatedness of the goods, the Federal Circuit found that substantial evidence supported the Board’s determination that there is a close relationship between tequila and beer or ale. The court explained that the source of these goods are frequently the same, they are marketed in many of the same channels, they are marketed to the same consumers, and they are inexpensive commodities which customers would not be able to distinguish by manufacturer.⁶⁴

In reaching this determination, the Federal Circuit cited *In re Majestic*

56. *Id.* at 1343-44. *In re Chatam International Inc.* relied on *In re Hearst Corp.*, 982 F.2d 493 (Fed. Cir. 1992), where the Federal Circuit had found that VARGA GIRL and VARGA were not confusingly similar as used for calendars, and *Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 507 F.2d 1401 (C.C.P.A. 1975), where the Federal Circuit’s predecessor found COUNTRY VOGUES for women’s dresses and VOGUE for a women’s magazine were not confusingly similar. 380 F.3d at 1343-44. Here, the court distinguished these two cases by stating that they were not controlling for the TTAB because the Board “neither inappropriately changed the marks, nor erroneously determined that the marks were similar after viewing the marks as a whole, though focusing on their dominant features,” which was the case in both *In re Hearst Corp.* and *Conde Nast, Id.* at 1344.

57. *Id.* at 1342 (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985)).

58. *Id.* (quoting *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1357 (Fed. Cir. 2000)).

59. *Id.* at 1342.

60. *Id.*

61. *Id.*

62. *Id.* at 1343.

63. *Id.*

64. *Id.* at 1344-45.

*Distilling Co.*⁶⁵ for the proposition that beer and tequila are closely related products because they are both alcoholic beverages and both marketed in the same trade channels. In that case, the Federal Circuit reached the same determination when comparing malt liquor with tequila.⁶⁶

Concluding its opinion, the Federal Circuit approved the Board's analysis of comparing the marks in their entirety but giving each term more or less weight depending on "its effect on the overall commercial impression."⁶⁷

3. *Shen Mfg. Co. v. The Ritz Hotel*⁶⁸

On appeal from the TTAB, the Federal Circuit in *Shen* affirmed the Board's decision in part and reversed in part, in effect finding that no likelihood of confusion existed between the parties for any of the marks at issue, including identical marks.⁶⁹ Applicant The Ritz Hotel ("RHL") has owned and operated The Ritz Hotel in Paris, France since 1898.⁷⁰ RHL owns the trademarks RITZ, RITZ PARIS RITZ HOTEL, and HOTEL RITZ in connection with hotel and restaurant services, as well as for the "sale of coffee, tea, chocolates, drinking glasses and champagne."⁷¹ Opposer Shen owns the mark RITZ for use in connection with the sale of "kitchen textiles, such as dish towels, potholders, and aprons"⁷² as well as other textile items such as "bathroom towels and ironing board covers."⁷³ Shen has used the RITZ mark since 1892.⁷⁴

In 1984 and 1985 RHL attempted to register the following five marks:

(1) PUTTING ON THE RITZ for shower curtains; (2) RITZ PARIS RITZ HOTEL and design for 'dinner plates of porcelain or earthenware, cups, saucers and serving pieces of porcelain, hair combs, household sponges, household brushes, steelwool, [and] household glassware'; (3) RITZ PARIS RITZ HOTEL and design for 'carpets, rugs, floor mats and

65. 315 F.3d 1311 (Fed. Cir. 2003).

66. *Id.* at 1316. In *Guinness United Distillers & Vintners B.V. v. Anheuser-Busch Inc.*, 64 U.S.P.Q.2d 1039, 1043 (S.D.N.Y. 2002), the district court granted a preliminary injunction to Guinness against Anheuser's use of "Red Label" for high end beer, as likely to cause confusion with the Guinness "Red Label" scotch product. The court stated that while scotch whiskey and beer are different products even though both are alcoholic and sold in the same channels of trade, the existence of flavored alcoholic beverages ("FABs") has "narrowed the gap between these two segments of the alcoholic beverage market." *Id.* at 1043. This decision was not cited in either *In re Majestic Distilling Co.* or *In re Chatam International Inc.*.

67. *In re Chatam Int'l Inc.*, 380 F.3d at 1345.

68. 393 F.3d 1238 (Fed. Cir. 2004).

69. *Id.* at 1245-46.

70. *Id.* at 1239.

71. *Id.* at 1240.

72. *Id.*

73. *Id.*

74. *Id.* The mark was derived from founder John Ritzenthaler's last name. *Id.*

matting, linoleum for covering existing floors [and] wall covering made of vinyl and plastic'; (4) RITZ for cooking and wine selection classes; and (5) THE RITZ KIDS for ready made and tailored clothing, including underwear, dresses, skirts, trousers, shirts, neckties, belts, gloves, hats, raincoats and galoshes.⁷⁵

Shen opposed these applications on the basis that they would likely cause confusion with its trademark.⁷⁶ The Board dismissed Shen's opposition with respect to PUTTING ON THE RITZ for shower curtains and RITZ PARIS RITZ HOTEL and design for dinnerware and floor and wall coverings.⁷⁷ However, with respect to Shen's opposition to RITZ for cooking and wine selection classes and THE RITZ KIDS for children's apparel, the Board sustained Shen's objection.⁷⁸

On appeal, the Federal Circuit's opinion focused on three of the *DuPont* factors: (1) alleged fame of the RITZ mark, (2) the similarity of the marks, and (3) the relatedness of the goods at issue.⁷⁹ First, the Federal Circuit found that Shen's mark was not famous because the evidence presented did not indicate that the mark enjoyed "extensive public recognition and renown" characteristic of a famous mark.⁸⁰ Next, the Federal Circuit analyzed each set of marks in turn with respect to the remaining two factors, similarity of the marks and relatedness of the goods.

The Federal Circuit affirmed the Board's determination that PUTTING ON THE RITZ for shower curtains was not likely to be confused with RITZ for bathroom towels because while the goods are related, the marks are not similar.⁸¹ The commercial impression of PUTTING ON THE RITZ is "specifically that of getting dressed up or of the song composed by Irving Berlin"⁸² which is significantly different from RITZ.⁸³ Shen, however, argued that the PUTTING ON THE segment of the mark was insignificant, making RITZ the only relevant part and as such, identical to Shen's RITZ mark.⁸⁴

Relying again on its anti-dissection rule, the Federal Circuit admonished that the mark must be viewed in its entirety and found that when evaluated as a whole, PUTTING ON THE RITZ conveyed an image of "comfort, sophistication and wealth"⁸⁵ that was different from the commercial

75. *Id.*

76. *Id.*

77. *Id.*

78. *Id.*

79. *Id.*

80. *Id.* at 1242.

81. *Id.*

82. *Id.*

83. *Id.*

84. *Id.*

85. *Id.*

impression that Shen's mark gave, that of cooking or manual labor, because of its use in connection with kitchen textiles.⁸⁶ The Federal Circuit also noted that the two marks are different in sound and appearance.⁸⁷

The Federal Circuit also affirmed the Board's determination that there was no likelihood of confusion between RITZ PARIS RITZ HOTEL and design for dinnerware and floor and wall coverings and RITZ for kitchen textiles.⁸⁸ Shen argued on appeal that the Board gave too much weight to PARIS and HOTEL which are disclaimed in RHL's registration.⁸⁹ However, the Federal Circuit found that the disclaimed elements of a mark are relevant to the similarity assessment because the analysis is viewed from the perspective of the consumer who is unaware of whether a word is disclaimed.⁹⁰ While there is some relatedness of goods between RHL's dinnerware and Shen's kitchen textiles, the Federal Circuit found that the marks were not similar in commercial impression, sound, or appearance.⁹¹

Finally the Federal Circuit assessed the Board's determination that RHL's registration of RITZ for cooking and wine selection classes and THE RITZ KIDS for children's apparel were confusingly similar, and reversed the Board's decision. The Federal Circuit found that while RITZ and RITZ were similar, the goods were not related.⁹² Though kitchen textiles may be used in a cooking class, the test for relatedness is not whether the goods are used together but rather whether the goods "can be related in the mind of the consuming public as to the origin of the goods."⁹³ Here, the Federal Circuit found that the consuming public would not believe that these two products would be from the same source.⁹⁴

As to RHL's registration for THE RITZ KIDS, the Federal Circuit found that the marks were not similar and that the goods were unrelated.⁹⁵ According to the Federal Circuit, the Board improperly dissected the mark THE RITZ KIDS to find it similar to RITZ. The Federal Circuit opined

86. *Id.*

87. *Id.* at 1242-43.

88. *Id.* at 1244.

89. *Id.* at 1243.

90. *Id.*

91. *Id.* at 1243-44.

92. *Id.* at 1244-45.

93. *Id.* at 1245 (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268 (Fed. Cir. 2002)).

94. *Id.* at 1244. The court analogized kitchen textiles and cooking classes to its prior holding in *In re Coors*, 343 F.3d 1340, 1343 (Fed. Cir. 2003), where beer and restaurant services were found unrelated even though both could be found in the same place. *Shen*, 393 F.3d at 1244.

95. In finding the goods were related, the Board specifically noted that gloves were similar to mitts. *Id.* at 1245. The Federal Circuit noted that this determination was erroneous, explaining that while both can be used to cover the hand, this is not relevant to the inquiry of whether a consumer could believe that the two products emanated from the same source. The court bolstered its explanation by distinguishing hard hats from fedoras. *Id.*

that even though the word THE and KIDS usually have little impact on consumers, in this situation the word THE has “elevated significance because of the well-known manner in which people refer to RHL as ‘The Ritz’ or ‘The Ritz Hotel’ but not as ‘Ritz’ or ‘Ritz Hotel.’”⁹⁶ As for KIDS, the Federal Circuit found that it served to further distinguish RHL’s mark from Shen’s. Additionally, the pronunciation of THE RITZ KIDS conveyed an impression of “wealth, a concept tied strongly to RHL and not associated in any way with Shen’s RITZ mark.”⁹⁷

B. Descriptiveness

1. *In re Oppedahl & Larson LLP*⁹⁸

Oppedahl involved an appeal from the TTAB in which the Federal Circuit was asked to reconsider its anti-dissection policy with regard to marks using a Top Level Domain name (“TLD”).⁹⁹ The court affirmed the Board’s conclusion that appellant Oppedahl’s proposed mark (“Patents.com”) was descriptive and therefore unregistrable. Oppedahl had filed an intent-to-use application for the mark in connection with “computer software for managing a database of records and for tracking the status of the records by means of the Internet.”¹⁰⁰ The PTO refused the registration, finding that the mark was merely descriptive of the service. The Board affirmed the rejection, in part because the “.com” part of the mark held no trademark significance and therefore could not make an otherwise descriptive or generic mark registrable.¹⁰¹

On appeal, Oppedahl challenged the Board’s disregard of the TLD in evaluating whether the mark was distinctive. The Federal Circuit first stated that the determination of whether a mark is generic, descriptive, suggestive, fanciful, or arbitrary is a question of fact, reviewed under the substantial evidence standard.¹⁰²

Next, the Federal Circuit reviewed the Trademark Manual of Examining Procedure (“TMEP”), which states that “[b]ecause TLDs generally serve no source-indicating function, their addition to an otherwise unregistrable mark typically cannot render it registrable.”¹⁰³ Oppedahl argued that the Board dissected the TLD from its mark before evaluating its entire

96. *Id.*

97. *Id.*

98. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1172 (Fed. Cir. 2004).

99. *Id.*

100. *Id.*

101. *Id.* at 1172-73.

102. *Id.* at 1173-74.

103. *Id.* at 1174 (quoting U.S. DEP’T OF JUSTICE, TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1209.03(m) (3rd ed. 2003)).

commercial impression.¹⁰⁴ The Federal Circuit clarified that while a mark should be considered in its entirety, that did not prohibit the Board from ascertaining the meaning of the components of a mark and weighing those individual components in determining the mark's overall impression.¹⁰⁵ Additionally, the Federal Circuit analyzed the TMEP rule and stated that the language of the rule was not a bright line prohibition against TLDs, but instead left room for the possibility that under certain circumstances a TLD could provide source-indicating information.¹⁰⁶ In this instance, however, that exceptional case was not present.

To illustrate its reasoning, the Federal Circuit posited two hypotheticals. First it discussed "tennis.net," where a company that sells tennis nets but never has any intention of selling its products on the Internet, applies for the mark "tennis.net."¹⁰⁷ This mark, a combination of a descriptive term and a TLD, is in fact distinctive. The TLD contributes to this characteristic because the mark as a whole gives the impression of a "witty double entendre" that is "immediately apparent" because the company's product is tennis nets.¹⁰⁸ This hypothetical was used to illustrate how a descriptive term combined with a TLD can sometimes be distinctive. Thus, the court declined to impose a bright line rule prohibiting TLD's from ever being used to render a mark registerable.¹⁰⁹

The second hypothetical concerned "Amazon.com." Oppedahl had argued that the word "Amazon" conjured up the area in South America, while "Amazon.com" implied the bookseller.¹¹⁰ The Federal Circuit responded that this argument was flawed because a mark must be considered in context with the goods or services associated with it.¹¹¹

104. Appellant cited to *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341 (Fed. Cir. 2001), to support its argument that the Board should not have dissected "Patents" and ".com" when evaluating its mark. *In re Oppedahl*, 373 F.3d at 1174. The court distinguished itself from *In re Dial-A-Mattress Corp.* by stating that *In re Dial-A-Mattress Corp.* did not say "that the Board cannot ascertain the meaning of each of the words or components that make up the entire mark." *Id.* In *In re Dial-A-Mattress Corp.*, the Board had determined that in the mark "1-888-M-A-T-T-R-E-S" the "888" component held no source identifying significance, and so analyzed "mattress" on its own. 240 F.3d at 1344. "M-A-T-T-R-E-S" by itself was found generic, and in the alternative, descriptive, for "telephone shop-at-home retail services in the field of mattresses" and the Board denied registration of the mark. *Id.* at 1343. The Federal Circuit found that the Board erred by not considering the mark as a whole, and reversed the Board's determination that the mark was generic. *Id.* at 1346, 1348. The Federal Circuit further held that while the Board's ruling that the mark was descriptive was correct, because there was evidence of secondary meaning, the mark had acquired distinctiveness and thus was registrable. *Id.* at 1348.

105. *In re Oppedahl*, 373 F.3d at 1174.

106. *Id.* at 1174-75.

107. *Id.* at 1175.

108. *Id.*

109. *Id.*

110. *Id.*

111. *Id.* at 1176.

According to the Federal Circuit, the statements “I bought this book from Amazon” and “I bought this book from Amazon.com” convey the same meaning—that a book was purchased from the online book retailer.¹¹² In this hypothetical, the “.com” alone does *not* add source identifying significance. The Federal Circuit did note that because such a composite mark has acquired distinctiveness through secondary meaning, the “Amazon.com” mark is registerable.¹¹³

The Federal Circuit affirmed the Board’s determination that “Patents.com” was merely descriptive of Oppedahl’s service of providing patent tracking through use of the Internet.¹¹⁴ The word “Patents” describes the patent tracking feature, while the word “.com” conveys that the mark is owned or used by a commercial entity in association with the Internet.¹¹⁵ Indeed, the Federal Circuit opined that adding “.com” to the mark only strengthened the descriptiveness of the mark, in light of the identification of goods in Oppedahl’s application: tracking patent records by means of the Internet.¹¹⁶

In summary, the Federal Circuit’s decision in *Oppedahl* reaffirmed prior legal principles regarding the trademark significance of TLDs. Although including the TLD typically will not add any source-identifying significance, *Oppedahl* teaches that the inherent registrability analysis must go further: it must evaluate a mark using a TLD in its entirety. Only in exceptional circumstances, can a TLD make a mark distinctive enough to be registerable.¹¹⁷

2. *In re DSS Environmental, Inc.*¹¹⁸

Appellant DSS appealed from the TTAB’s refusal to register its proposed mark DUALSAND on the ground that the term is descriptive. The mark was filed in connection with “water and wastewater filters” that are used in dual sand filtration systems.¹¹⁹ On appeal, DSS contended that: (1) the evidence the Board relied on was not credible or sufficient, (2) its own use of the mark was not descriptive, and (3) its list of third-party registrations should have been considered, even though DSS failed to submit physical copies of them.¹²⁰ The Federal Circuit concluded that the

112. *Id.*

113. *Id.*

114. *Id.* at 1177.

115. *Id.*

116. *Id.* at 1176-77.

117. *Id.* at 1177.

118. No. 04-1041, 2004 U.S. App. LEXIS 21994, at *1-2 (Fed. Cir. Oct. 20, 2004).

119. *Id.*

120. *Id.* at *5-12. In the proceeding below, the TTAB found the mark DUALSAND descriptive based on evidence such as articles from the Internet and two utility patents, including one registered to DSS, using the terms “dual sand filters” and “dual sand

Board's decision was supported by substantial evidence, and affirmed.¹²¹ The decision is not citable precedent.¹²²

3. *Cross Country Bank v. Cross Country Financial Corp.*¹²³

In this case, the Federal Circuit affirmed, per curiam, the TTAB's determination.¹²⁴ In the proceedings below, the Board denied opposer Cross Country Bank's motion for reconsideration of its opposition to applicant Cross Country Financial Corp.'s registration of the mark CROSS COUNTRY FINANCIAL CORP.¹²⁵ The registration of the mark was for the services of "lease-purchase financing and collection of retail installment sales contracts and consumer credit transactions."¹²⁶ The Board found that Cross County Bank was unable to prove priority of use based on first user evidence.¹²⁷ The Board further found that Cross Country Financial Corp.'s use of the mark was not descriptive.¹²⁸

C. *Genericness*

1. *Payday Garden City, LLC v. Community Financial Services Association of America*¹²⁹

In *Payday*, the Federal Circuit, per curiam, affirmed the Board's decision.¹³⁰ Petitioner Community Financial Services ("CFS"), a national trade association representing the "payday advance" industry, filed a petition to cancel the registration of the mark PAYDAY ADVANCES, registered to respondent Payday Garden.¹³¹ Payday Garden's identification of goods stated the mark was used in connection with "cash advances without credit checks up to five hundred dollars (\$500) for off-the-street

filtration" in reference with the wastewater treatment industry. *Id.* at *6. DSS challenged on appeal the accuracy of articles from the Internet as competent evidence but the Federal Circuit dismissed this contention, stating that the Board used the articles to ascertain how the term is used, not for their accuracy. *Id.* at *8-9.

With respect to the list of third-party registrations, DSS characterized its failure to produce physical copies to the Board as "a harmless procedural error" and also challenged the Board's policy as arbitrary and a denial of DSS's right to due process. *Id.* at *11. The court rejected this argument. *Id.* at *12.

121. *Id.*

122. *Id.*

123. No. 04-1371, 2004 U.S. App. LEXIS 26725 (Fed. Cir. Dec. 13, 2004).

124. *Id.*

125. TTAB Opposition, No. 91114039, at *1 (T.T.A.B. Feb. 11, 2004), at <http://ttabvue.uspto.gov/ttabvue/> (on file with the American University Law Review).

126. *Id.*

127. *Id.* at *10-11.

128. *Id.*

129. No. 01-1359, 2004 U.S. App. LEXIS 3100, at *1 (Fed. Cir. Feb. 6, 2004).

130. *Id.* The decision of the TTAB is available at 2003 TTAB LEXIS 33, but is not citable as precedent.

131. 2003 TTAB LEXIS 33, at *2 (T.T.A.B. Jan. 29, 2003).

customers with their post-dated checks as promissory note[s], and wire funds transfers for such customers.”¹³²

CFS contended that a “payday advance” is a service its members provide where the customer pays a flat fee and receives cash for a short period of time against his or her next paycheck.¹³³ After the agreed-upon time, CFS’s members will deposit the check or return it to the customer if the customer repays with cash. CFS contended that the registration for PAYDAY ADVANCES should be cancelled on grounds of genericness. CFS argued that its members have been providing payday advances for many years, and that they advertised their services nationwide by using the phrase “payday advances” in a non-trademark manner. CFS further argued that the public recognized the phrase “payday advance” as a generic term for this service.¹³⁴

In assessing whether the mark had become or was generic, the Board first determined that the relevant public in this instance consisted of “persons who currently need or those who might need a short-term advance of small amounts of money.”¹³⁵ Based on the substantial evidence submitted by CFS,¹³⁶ the Board found that the record sufficiently demonstrated that the phrase PAYDAY ADVANCES was a generic term for the same services provided by CFS’ members, and granted CFS’s petition to cancel Payday Garden’s registration.¹³⁷

II. PROCEDURAL TRADEMARK ISSUES

A. *Procedural Defects*

1. *Leoutsakos v. Coll’s Hospital Pharm., Inc.*¹³⁸

This patent and trademark infringement case came to the Federal Circuit on appeal from the District Court of New Hampshire. The Federal Circuit affirmed the district court’s grant of summary judgment to defendant Coll’s Hospital Pharmacy without considering plaintiff Leoutsakos’s common law

132. *Id.* at *1.

133. *Id.* at *2.

134. *Id.* at *1-3.

135. *Id.* at *14.

136. CFS submitted numerous examples where the term “payday advance” is used as a way to reference the payday advance industry, such as publications by its own organization, surveys and reports used by legislators and regulators, as well as news articles. *Id.* at *18, *23. Payday Gardens did not offer any arguments or other evidence to refute these submissions. *Id.* at *23.

137. *Id.* at *14, *25. The Board also noted that Payday Gardens did not take action against competitor use of the term PAYDAY ADVANCES except to mail a few cease and desist letters. *Id.* at *25. For those that did not agree to desist, Payday Gardens took no further action. *Id.*

138. No. 03-1533, 2004 U.S. App. LEXIS 8774 (Fed. Cir. May 4, 2004).

trademark infringement claim because the issue had not been properly raised below.¹³⁹ Leoutsakos raised his trademark infringement claim for the first time in his motion for partial summary judgment at the district court level.¹⁴⁰ The issue was not raised in his complaint, nor did Leoutsakos seek leave to amend the complaint.¹⁴¹ The opinion is not citable precedent.¹⁴²

2. *Osmosis Tech. Inc., v. GE Osmonics, Inc.*¹⁴³

In *Osmosis*, the Federal Circuit issued an order denying the petition for review because appellant Osmosis failed to file an Entry of Appearance form by an attorney admitted to the Federal Circuit, and because Osmosis failed to file a brief in accordance with Federal Circuit Rule 31(a).¹⁴⁴ The petition for appeal was dismissed on the grounds that Osmosis had not prosecuted according to Federal Circuit rules.¹⁴⁵

In the TTAB proceeding below,¹⁴⁶ Osmosis filed a petition to cancel GE Osmonics's registration for the mark OSMMONICS based on both an alleged likelihood of confusion with Osmosis's mark OSMOTIK, and an allegation of fraud in obtaining the registration.¹⁴⁷ The TTAB denied the petition, finding that Osmosis had failed to prove priority of its mark.¹⁴⁸ Neither the Federal Circuit nor the TTAB opinion is citable precedent.¹⁴⁹

3. *Stoller v. Ponce*¹⁵⁰

Appellant Stoller sought review of the TTAB's dismissal of his opposition to appellee Ponce's application for STEALTH SHELF; the Federal Circuit affirmed.¹⁵¹ The Board dismissed Stoller's opposition on the basis that he lacked standing to oppose.¹⁵² After finding his proffered evidence inadmissible, the Board determined that Stoller was unable to show a "real interest" in the outcome of the proceeding.¹⁵³ On appeal, Stoller argued that the Board's determination was incorrect, the decision violated his right to due process, and one of the administrative judges was biased against him.¹⁵⁴ The Federal Circuit found that the Board had not

139. *Id.* at *10.

140. *Id.* at *3-4.

141. *Id.* at *4.

142. *Id.* at *1.

143. No. 04-1407, 2004 U.S. App. LEXIS 19411, at *1 (Fed. Cir. Aug. 20, 2004).

144. *Id.*

145. *Id.*

146. 2004 TTAB LEXIS 188, at *1 (T.T.A.B. Mar. 30, 2004).

147. *Id.* at *1-2.

148. *Id.* at *30.

149. *Id.*

150. No. 04-1305, 2004 U.S. App. LEXIS 22208 (Fed. Cir. Oct. 8, 2004).

151. *Id.* at *1.

152. *Id.* at *2-3.

153. *Id.*

154. *Id.* at *4-6.

abused its discretion, and that Stoller's other arguments were without merit and unsupported.¹⁵⁵ The opinion is not citable precedent.¹⁵⁶

B. Discovery

1. *Central Mfg. v. Surgical Navigation Tech., Inc.*¹⁵⁷

On appeal from the TTAB, the Federal Circuit ruled that the Board's denial of opposer Central Manufacturing's third discovery request was not an abuse of discretion.¹⁵⁸ Petitioner Surgical Navigation Technologies ("SNT") filed an intent-to-use application for the mark STEALTHVIEW, in connection with computer hardware and software for "using medical scanning information for surgical planning for use in image guided surgery."¹⁵⁹ Central opposed the application on the basis of its ownership of several STEALTH registrations.¹⁶⁰ Central served multiple discovery requests with its opposition. SNT's response was a motion to dismiss the opposition and to stay discovery. The Board treated SNT's response as a motion for summary judgment.¹⁶¹

Central filed another discovery motion under Federal Rule of Criminal Procedure 56(f), which the Board denied, finding the request overbroad.¹⁶² In addition, the Board sanctioned Central for "falsely stating that its discovery request was 'very tailored' to SNT's motion to dismiss."¹⁶³ Central made two more attempts to fix its discovery requests.¹⁶⁴ On the third attempt, the Board denied the motion with prejudice.¹⁶⁵ At the same time, Central twice filed a motion to amend its Notice of Opposition, which the Board twice denied.¹⁶⁶ The Board gave Central thirty days to respond to SNT's motion for summary judgment, warning that if it appealed the Board's prior rulings the summary judgment motion could be decided during the pendency of those appeals.¹⁶⁷ Central then filed an appeal from the denial of its motion to amend its Notice of Opposition, and failed to respond to SNT's motion for summary judgment.¹⁶⁸ The Board granted

155. *Id.* at *6-7.

156. *Id.*

157. No. 03-1414, 2004 U.S. App. LEXIS 5033 (Fed. Cir. Mar. 17, 2004).

158. *Id.* at *5.

159. *Id.* at *1.

160. *Id.* at *2.

161. *Id.*

162. *Id.*

163. *Id.*

164. *Id.*

165. *Id.*

166. *Id.*

167. *Id.* at *2-3.

168. *Id.* at *3.

SNT's motion and dismissed Central's opposition with prejudice.¹⁶⁹

Central's appeal focused on two points: (1) the Board's denial of Central's discovery requests, and (2) the Board's denial of Central's request to suspend proceedings until the outcome of its appeal.¹⁷⁰

The Federal Circuit affirmed the Board's denial of Central's discovery request, noting that the request simply repeated the previous one.¹⁷¹ The Federal Circuit also affirmed the Board's denial of Central's motion to suspend proceedings until the outcome of the appeal because of the substantial deference given to the Board to control its own docket.¹⁷² The court noted that the Board gave Central notice that the summary judgment motion could be decided while the appeal was pending. This decision is not citable precedent.¹⁷³

C. Failure to Prosecute

1. *Mattel, Inc. v. Henson*¹⁷⁴

Appellant Mattel appealed the TTAB's dismissal of its opposition for failure to prosecute; the Federal Circuit affirmed in a per curiam decision.¹⁷⁵ In 2001, appellee Henson filed an application for the mark GRANDMA SAYS, to which Mattel filed a notice of opposition.¹⁷⁶ The notice included scheduling dates for discovery between the parties. Henson filed an answer to the opposition on September 12, 2001. Mattel never received a copy, and the TTAB's copy did not include a certification of service.¹⁷⁷

During the scheduled discovery period, Mattel did not conduct any discovery, or even check on the status of the case until July 2002.¹⁷⁸ At that time Mattel learned of Henson's answer.¹⁷⁹ Three weeks after the end date for discovery, Mattel's newly obtained counsel filed a motion to reopen the proceeding.¹⁸⁰ In response, Henson filed a cross-motion for dismissal of the proceeding for failure to prosecute.¹⁸¹ The TTAB granted Henson's motion and denied Mattel's motion on the basis that Mattel had

169. *Id.* at *2.

170. *Id.* at *3.

171. *Id.* at *4-5.

172. *Id.* at *8.

173. *Id.* at *1.

174. No. 03-1360, 2004 U.S. App. LEXIS 1596 (Fed. Cir. Feb. 3, 2004).

175. *Id.* at *1.

176. *Id.*

177. *Id.* at *2.

178. *Id.* at *3.

179. *Id.*

180. *Id.*

181. *Id.*

failed to show excusable neglect sufficient to reopen the proceeding.¹⁸²

The Federal Circuit affirmed the Board's dismissal of Mattel's opposition to Henson's failure to prosecute motion.¹⁸³ The Federal Circuit found that Mattel could not properly demonstrate that its neglect was excusable under *Pioneer Investment Services v. Brunswick Ass'n*.¹⁸⁴ Mattel failed to meet the second and third factors of the *Pioneer* test, which relate to the length of the delay and the reason for the delay.¹⁸⁵ The Federal Circuit found that Mattel failed to meet the second factor because, even though two months may be a short period of time by itself, the delay was too great when added to the extra time a new discovery period would take.¹⁸⁶ The court found that Mattel did not meet the third factor because the issuance of a default is not automatic, and a party is not justified in relying on the TTAB to issue one without any action on their part.¹⁸⁷ This decision is not citable precedent.¹⁸⁸

2. *Detroit Entertainment, LLC v. Motor Cities Casinos, LLC*¹⁸⁹

The Federal Circuit affirmed, per curiam, the TTAB's determination.¹⁹⁰ In the proceedings below, the Board granted Motor Cities Casinos's motion to dismiss opposition proceedings instituted by Detroit Entertainment because Detroit Entertainment failed to prosecute. The Board applied the excusable neglect standard found in *Pioneer Investment Services v. Brunswick Ass'n*¹⁹¹ and granted applicant Motor Cities Casinos's motion to dismiss opposition proceedings for failure to prosecute.¹⁹² The Board

182. *Id.* at *4.

183. *Id.* at *1.

184. 507 U.S. 380 (1993). In *Mattel*, the Court applied factors the Supreme Court set forth in *Pioneer* to evaluate excusable neglect: "(1) the danger of the prejudice to the [non-moving] party, (2) the length of the delay and its potential impact on judicial proceedings, (3) the reason for the delay, including whether it was within the reasonable control of the movant, and (4) whether the movant acted in good faith." 2004 U.S. App. LEXIS 1596, at *6 (citing *Pioneer*, 507 U.S. at 395).

185. *Id.* at *3. In reaching its determination the Court relied heavily on *Old Nutfield Brewing Co. v. Hudson Valley Brewing Co.*, 65 U.S.P.Q.2d 1701 (T.T.A.B. 2002), where the opposer also failed to conduct discovery during the scheduled period and then made a motion to reopen the time period based on excusable neglect because the applicant failed to file an answer. *Mattel*, 2004 U.S. App. LEXIS 1596 at *3. As part of its determination that Mattel also had not met the standard, the Federal Circuit quoted language from *Old Nutfield* wherein the TTAB had found that the opposer had not met the standard for excusable neglect. *Id.*

186. *Id.* (citing *Old Nutfield*, 65 U.S.P.Q.2d at 1701-1702).

187. *Id.* at *3-4 (citing *Old Nutfield*, 65 U.S.P.Q.2d at 1704).

188. *Id.* at *1.

189. No. 04-1218, 2004 U.S. App. LEXIS 22580 (Fed. Cir. Oct. 12, 2004).

190. *Id.*

191. 507 U.S. 380 (1993). See *supra* note 184 (explaining the four factors that the Supreme Court relies on when determining whether or not a party's neglect is excusable).

192. TTAB Opposition, No. 91151905 (T.T.A.B. Oct. 30, 2003), at <http://ttabvue.uspto.gov/ttabvue/> (on file with the American University Law Review).

found that the reason for delay was wholly within Detroit Entertainment's control, and thus the third *Pioneer* factor did not weigh in its favor.¹⁹³ With respect to the second factor, the length of delay, the Board reasoned that the delay was significant because of the length of time between the close of the discovery period and the filing, briefing, and adjudication of the excusable neglect motion itself.¹⁹⁴ The Board also denied Detroit Entertainment's motion to reopen the testimony period.¹⁹⁵

CONCLUSION

From the perspective of trademark law and policy, 2004 was an uneventful year in the Federal Circuit. Because all of the TTAB decisions to reach the Federal Circuit were affirmed (with the exception of one which was affirmed in part and reversed in part), and because many of the decisions were issued in non-precedential opinions, one can conclude that the Federal Circuit approves of business as-usual at the PTO and the Board. Accordingly, practitioners should recognize the importance of taking PTO and Board procedures seriously, and, in the absence of a compelling position, should not count on an in-depth, fresh look from the Federal Circuit.

193. *Id.*

194. *Id.* at *6.

195. *Id.* at *7.