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## 2018 Trademark Law Decisions of the Federal Circuit

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## 2018 Trademark Law Decisions of the Federal Circuit

# 2018 TRADEMARK LAW DECISIONS OF THE FEDERAL CIRCUIT

DEBORAH A. WILCOX\* AND NANCY RUBNER FRANSEN\*\*

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## INTRODUCTION

In 2018, the U.S. Court of Appeals for the Federal Circuit issued seven precedential trademark decisions. Of these decisions, six were appeals from the Trademark Trial and Appeal Board (TTAB or “the Board”) and one was an appeal from the International Trade Commission (ITC). While this number of cases nearly equals the number of trademark cases decided in 2016, it was less than the number of decisions in most other years—including the twelve decisions rendered in 2017. Notably, in 2018, there were no significant decisions that impacted the practice of trademark law.

This Area Summary reviews all of the Federal Circuit’s 2018 precedential trademark decisions in detail below.

## I. SUBSTANTIVE TRADEMARK ISSUES

A. *Likelihood of Confusion*

Three of the seven cases decided by the Federal Circuit in 2018 addressed issues relating to the likelihood of confusion factors set forth in *In re E. I. DuPont DeNemours & Co.*<sup>1</sup> (the “*DuPont* factors”).<sup>2</sup> One of those cases focused on the *DuPont* factors in the context of an opposition proceeding, while another focused on the *DuPont* factors in the context of a cancellation proceeding. The remaining case dealt with the *DuPont* factors in the context of an applicant applying to register a mark. Two of the three cases were affirmed by the Federal Circuit, while only one was vacated and remanded.

1. *Omaha Steaks International, Inc. v. Greater Omaha Packing Co.*

The Federal Circuit held in *Omaha Steaks International, Inc. v. Greater Omaha Packing Co.*<sup>3</sup> that the TTAB erred in concluding that there is no likelihood of confusion between Omaha Steaks International’s

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1. 476 F.2d 1357, 1361 (C.C.P.A. 1973). The thirteen *DuPont* factors include: similarity of the marks, similarity of the goods and/or services, similarity of the channels of trade, the sophistication of the purchasers, the fame of the prior mark, the number of similar marks in use on similar goods, the nature and extent of actual confusion, the length of time during which there has been concurrent use without evidence of actual confusion, the variety of goods on which a mark is used, the market interface between the applicant and the owner of a prior mark, the extent to which the applicant has a right to exclude others from use of its mark on its goods, the extent of potential confusion and any other established fact probative of the effect of use.

2. *Omaha Steaks*, 908 F.3d at 1324.

3. 908 F.3d 1315 (Fed. Cir. 2018).

(“Omaha Steaks”) registered trademarks and Greater Omaha Packing Company’s (“Greater Omaha”) GREATER OMAHA PROVIDING THE HIGHEST QUALITY BEEF trademark.<sup>4</sup> Most significantly, the Federal Circuit found that the TTAB erred when analyzing the fame of the registered trademarks and the relevance of third-party usage for non-similar goods in connection with the likelihood of confusion factors enumerated in *In re E. I. DuPont DeNemours & Co.*<sup>5</sup> In *Omaha Steaks*, the Federal Circuit vacated the TTAB’s prior ruling and the case was remanded for further proceedings.<sup>6</sup>

Omaha Steaks owned more than two-dozen registered trademarks, all of which included the words “Omaha Steaks.”<sup>7</sup> Greater Omaha, which sold boxed beef, filed an application to register its trademark, GREATER OMAHA PROVIDING THE HIGHEST QUALITY BEEF, for “meat, including boxed beef primal cuts.”<sup>8</sup> Omaha Steaks opposed Greater Omaha’s trademark application, alleging likelihood of confusion.<sup>9</sup> In dismissing the opposition, the TTAB concluded, *inter alia*, that the Omaha Steaks trademarks were not famous.<sup>10</sup> Omaha Steaks appealed the TTAB’s findings and argued that the TTAB improperly rejected and misapplied its evidence in connection with the likelihood of confusion analysis enumerated in the *DuPont* factors.<sup>11</sup>

A central issue in Omaha Steaks’ appeal concerned the fame of the trademark, which is the fifth *DuPont* factor<sup>12</sup> Omaha Steaks supplied the TTAB with its advertising expenditures, sales figures, a survey of consumer recognition, and trademark lawsuits as evidence of the fame of its marks.<sup>13</sup> With respect to the advertising and sales figures, Omaha Steaks spent more than “\$45 million in 2011 to advertise its beef products” and processed approximately 100,000 orders per day during peak holiday ordering season.<sup>14</sup> The TTAB concluded, however, that

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4. *Id.* at 1328.

5. *Id.* at 1324.

6. *Id.* at 1328.

7. *Id.* at 1317.

8. *Id.* at 1318.

9. *Id.*

10. *Id.*

11. *Id.*

12. *In re E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973) (noting that fame can be measured by considering “sales, advertising, [and] length of use”).

13. *Omaha Steaks*, 908 F.3d at 1319.

14. *Id.*

Omaha Steaks's evidence lacked context in how the company established evidence of actual market share.<sup>15</sup>

The Federal Circuit held that the TTAB improperly interpreted *Bose Corp. v. QSC Audio Products, Inc.*<sup>16</sup> to require evidence of market share to contextualize Omaha Steaks's raw advertising and sales figures data.<sup>17</sup> Chief Judge Prost noted that Omaha Steaks had provided significant contextual evidence concerning the forms of advertisements it employed nationwide to achieve sales, including testimony as to promotions through catalogs, direct mailings, email marketing, customer calls, tradeshow, retail stores, national television, radio, magazine and newspaper campaigns, digital marketing, and social media.<sup>18</sup> The Federal Circuit determined that this evidence of the substantiality of the sales or advertising figures for comparable types of products is another form of "context" for advertising expenditures or sales figures.<sup>19</sup> It thus vacated and remanded the TTAB's ruling and directed the TTAB to conduct a proper fame analysis under the fifth *DuPont* factor.<sup>20</sup>

Despite the remand, the Federal Circuit found no abuse of discretion in the TTAB's conclusion that the survey's exclusion of a large segment of meat eaters—those who purchase from grocery stores and markets instead of specialty kiosks and websites—made it unreliable and lacking in probative value.<sup>21</sup> The Federal Circuit also concluded that the TTAB did not abuse its discretion in failing to take judicial notice of Omaha Steaks' prior trademark lawsuits as evidence of fame, noting that the fame inquiry centers on whether the mark achieved extensive public recognition, rather than the owner's prior enforcement efforts, which are not reasonably probative of the fame inquiry.<sup>22</sup>

Also central to Omaha Steaks' appeal was the sixth *DuPont* factor, namely "[t]he number and nature of similar marks in use on similar goods."<sup>23</sup> On appeal, Omaha Steaks argued that the TTAB improperly considered unrelated products and services that include the word

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15. *Id.*

16. 293 F.3d 1367 (Fed. Cir. 2002).

17. *Omaha Steaks*, 908 F.3d at 1320.

18. *Id.* at 1320–21.

19. *Id.* at 1321.

20. *Id.* at 1322.

21. *Id.*

22. *Id.* at 1324.

23. *In re E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973).

“Omaha,” regardless of whether they involved meat.<sup>24</sup> The TTAB concluded that “Omaha” was a weak indicator of commercial source and that trademarks relying on the word were entitled only to narrow protection.<sup>25</sup> The TTAB also concluded that such a term “may be perceived as an indication of the geographic location of the producer of the goods or the geographic origin of the goods themselves.”<sup>26</sup>

The Federal Circuit disagreed with the TTAB’s analysis and clarified that the controlling inquiry is the degree of “third-party marks in use on ‘similar’ goods or services.”<sup>27</sup> The TTAB had relied on a wide range of third-party products, including wine, Asian food, popcorn, and other alcoholic beverages.<sup>28</sup> Since these goods had no relationship to meat or meat products, the Federal Circuit held that the TTAB based its decision on irrelevant evidence and that its analysis under the sixth *DuPont* factor constituted legal error.<sup>29</sup> The Federal Circuit vacated the TTAB’s findings and remanded to the TTAB with instructions “to reweigh the limited, relevant evidence of third-party use” under the sixth *DuPont* factor.<sup>30</sup>

The Federal Circuit also vacated and remanded the TTAB’s findings under the similarity of the marks analysis, the first *DuPont* factor, to the extent it relied on a flawed third-party usage analysis.<sup>31</sup>

## 2. *In re* Detroit Athletic Co.

In *In re Detroit Athletic Co.*,<sup>32</sup> the applicant, Detroit Athletic Co. (“DACo”), applied to register DETROIT ATHLETIC CO. for sports apparel retail services.<sup>33</sup> The TTAB concluded that DACo’s mark was likely to be confused with the third-party mark DETROIT ATHLETIC CLUB, and affirmed the Patent and Trademark Office’s refusal to register.<sup>34</sup> The TTAB reasoned that the marks were similar, the goods and services related, and the channels of trade and consumers overlapped.<sup>35</sup> DACo appealed the TTAB’s decision.<sup>36</sup>

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24. *Omaha Steaks*, 908 F.3d at 1324.

25. *Id.*

26. *Id.*

27. *Id.*

28. *Id.* at 1325.

29. *Id.*

30. *Id.* at 1326.

31. *Id.* at 1328.

32. 903 F.3d 1297 (Fed. Cir. 2018).

33. *Id.* at 1301.

34. *Id.* at 1310.

35. *Id.* at 1302.

36. *Id.*

The Federal Circuit reviewed “the Board’s legal determination without deference and its factual findings for substantial evidence,” which is defined as “such relevant evidence as a reasonable mind would accept as adequate to support a conclusion.”<sup>37</sup>

Likelihood of confusion is a legal determination based on underlying findings of fact<sup>38</sup> and is determined by assessing the relevant *DuPont* factors.<sup>39</sup> In this case, the *DuPont* factors deemed relevant by the TTAB were: factor one, the “similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression”; factor two, the “similarity or dissimilarity and nature of the goods or services as described in an application or registration; factor three, the “similarity or dissimilarity of established, likely-to-continue trade channels”; and factor eight, the “length of time during and conditions under which there has been concurrent use without evidence of actual confusion.”<sup>40</sup> The Federal Circuit addressed the TTAB’s ruling with respect to each of these factors.

Regarding the first *DuPont* factor, the Federal Circuit held that the TTAB’s finding that DETROIT ATHLETIC CO. and DETROIT ATHLETIC CLUB are “nearly identical in terms of sound, appearance[,] and commercial impression,” was supported by substantial evidence.<sup>41</sup> The TTAB found that “both marks consist of three words beginning with the identical phrase ‘Detroit Athletic’ and ending with one-syllable ‘C’ words (i.e., ‘Co.’ and ‘Club’).”<sup>42</sup> The TTAB also noted that the identity of the marks’ initial two words, the lead and dominant words, is “particularly significant because consumers typically notice those words first,” and the words “are likely to make the greatest impression on consumers.”<sup>43</sup> Moreover, because “Co.” and “Club” are both descriptive of the respective “business form of the entity that owns the marks,” the Federal Circuit agreed with the TTAB that neither “Co.” nor “Club” “alleviate the confusion that is likely to ensue.”<sup>44</sup> The Federal Circuit did note, however, the “mere fact that ‘Co.’ and ‘Club’ were disclaimed does not give one license to simply ignore those words

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37. *Id.* (quoting *In re Viterra Inc.*, 671 F.3d 1358, 1361 (Fed. Cir. 2012)).

38. *Id.*

39. *In re E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973).

40. *Detroit Athletic Co.*, 903 F.3d at 1302–03.

41. *Id.* at 1303 (quoting *In re Detroit Athletic Co.*, No. 86625093, 2017 WL 2876815, at \*2 (T.T.A.B. June 2, 2017)).

42. *Id.*

43. *Id.*

44. *Id.* at 1304.



in the likelihood of confusion analysis . . . ‘because confusion is evaluated from the perspective of the purchasing public, which is not aware that certain words or phrases have been disclaimed.’”<sup>45</sup> Here, though, the Federal Circuit specifically noted that the TTAB considered the marks as a whole, and “rather than simply dismissing ‘Co.’ and ‘Club’ out-of-hand . . . the TTAB proffered rational reasons why those words, as mere business identifiers, [did] not sufficiently distinguish the marks.”<sup>46</sup>

Regarding the second *DuPont* factor, while the goods and services were not identical, the Federal Circuit agreed with the TTAB that they substantially overlapped, thereby weighing in favor of finding a likelihood of confusion.<sup>47</sup> In response to DACo’s argument that because its application describes services while the cited registration is for goods, the Federal Circuit noted that “[c]lassification is solely for the ‘convenience of Patent and Trademark Office administration’ . . . and ‘is wholly irrelevant to the issue of registrability under [s]ection 1052(d) [of the Lanham Act], which makes no reference to classification.’”<sup>48</sup> Therefore, it is well established that the use of the same or similar marks for goods or services involving those goods is likely to cause confusion.<sup>49</sup>

DACo also argued that “consumers would have little problem distinguishing between DACo’s clothing store and the Detroit Athletic Club’s private social club.”<sup>50</sup> The Federal Circuit noted in response that “[w]hile this may be true, it is largely irrelevant” because the “inquiry in an ex parte proceeding focuses on the goods and services described in the application and registration, and not on real-world conditions.”<sup>51</sup> The Federal Circuit thus held that “the Board did not err by finding that consumers are in fact likely to conflate the source of the goods and services covered by the two marks at issue here.”<sup>52</sup>

Regarding the third *DuPont* factor, the Federal Circuit held that the TTAB’s finding that the registrant’s “clothing comprise[d] the type of goods likely to be sold through DACo’s sports apparel retail services” was supported by substantial evidence, noting that “[t]he registration contains no restrictions on the channels of trade or classes of

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45. *Id.* (quoting *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1243 (Fed. Cir. 2004)).

46. *Id.* at 1305.

47. *Id.* at 1306.

48. *Id.* at 1307 (quoting 15 U.S.C. § 1112 (2012); *Jean Patou, Inc. v. Theon, Inc.*, 9 F.3d 971, 975 (Fed. Cir. 1993)).

49. *Id.*

50. *Id.*

51. *Id.* (italics omitted).

52. *Id.* at 1308.

customers.”<sup>53</sup> As a result, the registrant’s “clothing is presumed to be sold in all normal trade channels to all the normal classes of purchasers.”<sup>54</sup> Like the second *DuPont* factor, the Federal Circuit noted that the third factor “must be evaluated with an eye toward the channels specified in the application and registration, not those as they exist in the real world.”<sup>55</sup> The Federal Circuit further noted that to the extent that DACo objected to the breadth of the goods or channels of trade described in the registrant’s registration, such “objection amounts to an attack on the registration’s validity” and is “better suited for resolution in a cancellation proceeding.”<sup>56</sup>

Finally, with regard to the eighth *DuPont* factor, “DACo submitted evidence purporting to show a lack of actual confusion, including an affidavit of a long-time customer attesting to his history of purchasing goods from DACo, as well as internet search results and online customer reviews for each company.”<sup>57</sup> The TTAB rejected DACo’s evidence, finding that it lacked probative value, and the Federal Circuit agreed.<sup>58</sup>

The TTAB balanced the *DuPont* factors described here and concluded that because the marks were similar, the goods and services were related, and the channels of trade and consumers overlapped, confusion between DACo’s mark and the cited mark was likely.<sup>59</sup> The Federal Circuit agreed with the TTAB’s conclusion.<sup>60</sup> As for DACo’s argument “that the Board erred by not addressing all *DuPont* factors for which evidence was proffered,” the Federal Circuit held that “[i]t is well established that the Board need not consider every *DuPont* factor.”<sup>61</sup>

### 3. *Zheng Cai v. Diamond Hong, Inc.*

In *Zheng Cai v. Diamond Hong, Inc.*,<sup>62</sup> Diamond Hong petitioned for cancellation of Mr. Cai’s mark, WU DANG TAI CHI GREEN TEA, based on a likelihood of confusion with the registered TAI CHI mark.<sup>63</sup> The TTAB found likelihood of confusion, giving limited consideration to the pro se applicant’s briefing “because it ‘contraven[ed]’ certain

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53. *Id.*

54. *Id.*

55. *Id.*

56. *Id.* at 1308–09.

57. *Id.* at 1309.

58. *Id.*

59. *Id.* at 1309–10.

60. *Id.* at 1310.

61. *Id.*

62. 901 F.3d 1367 (Fed. Cir. 2018).

63. *Id.* at 1369.

provisions of the Trademark Trial and Appeal Board Manual of Procedure ('TBMP').<sup>64</sup> The applicant appealed the TTAB's evidentiary ruling and its finding of likelihood of confusion.<sup>65</sup>

The Federal Circuit affirmed the TTAB's decision, finding that it did not abuse its discretion.<sup>66</sup> As to the procedural grounds, Mr. Cai's main brief contained numerous assertions of fact that were not properly introduced into evidence.<sup>67</sup> As the party in the position of defendant, he was not entitled to a reply brief under the TBMP.<sup>68</sup> The Federal Circuit thus held that "the TTAB did not abuse its discretion in applying the TBMP and excluding Mr. Cai's submissions."<sup>69</sup>

As to likelihood of confusion, the Federal Circuit reviewed the TTAB's legal conclusions de novo and its findings of fact for substantial evidence.<sup>70</sup> In its likelihood of confusion analysis, the TTAB had considered the first three *DuPont* factors, treating the rest as neutral because neither party submitted evidence related to them.<sup>71</sup> The Federal Circuit found substantial evidence supported the TTAB's findings with respect to each *DuPont* factor, "and the TTAB did not err" as to its ultimate conclusion of likelihood of confusion.<sup>72</sup> The parties' goods were identical, in part, because they were both tea; they were presumed to move in the same channels of trade; and, when considered as a whole, the marks were similar because they both invoked a large yin-yang symbol and prominently displayed the term TAI CHI.<sup>73</sup>

#### *B. Validity and Infringement of Trade Dress Mark*

There was only one Federal Circuit case in 2018 that dealt with issues related to trade dress and it involved an appeal from an ITC decision finding the trade dress at issue to be invalid.

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64. *Id.* at 1369–70.

65. *Id.* at 1370.

66. *Id.* at 1371.

67. *Id.* at 1370.

68. *Id.* at 1371.

69. *Id.*

70. *Id.*

71. *Id.* at 1372.

72. *Id.* at 1373.

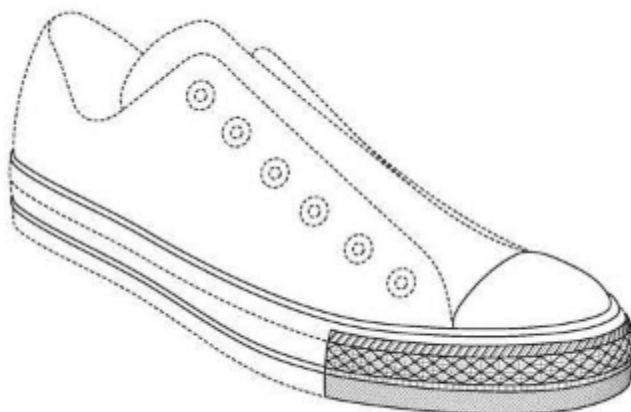
73. *Id.* at 1372–73.

### I. Converse, Inc. v. International Trade Commission

In *Converse, Inc. v. International Trade Commission*,<sup>74</sup> the Federal Circuit held that the ITC erred in applying the wrong standard in aspects of both its invalidity and infringement determinations.<sup>75</sup> The ITC held invalid Converse's trademark registration<sup>76</sup> in the midsole design of its Chuck Taylor All Star shoes, and also found no common law rights.<sup>77</sup> The ITC nonetheless addressed infringement, finding various accused products would have infringed Converse's registered and common law marks if valid.<sup>78</sup> Converse appealed the ruling of invalidity.<sup>79</sup>

Converse's trademark registration covered three design elements on the midsole,<sup>80</sup> as shown below.

Figure 1. Converse's drawing for the '753 Trademark<sup>81</sup>:



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74. 909 F.3d 1110 (Fed. Cir. 2018).

75. *Id.* at 1113.

76. *Id.* (invalidating Registration No. 4,398,753, otherwise known as the '753 Trademark).

77. *Id.*

78. *Id.*

79. *Id.*

80. As set forth in the '753 Trademark, "the mark consists of the design of the two stripes on the midsole of the shoe, the design of the toe cap, the design of the multi-layered toe bumper featuring diamonds and line patterns, and the relative position of these elements to each other." *Id.* at 1113–14.

81. *Id.* at 1114.

The Administrative Law Judge (ALJ) initially determined that the ‘753 Trademark was valid and infringed, relying on the presumption of secondary meaning afforded to the registered mark.<sup>82</sup> On the other hand, the ALJ found no common law rights due to a lack of secondary meaning.<sup>83</sup> The parties petitioned for review, and the ITC issued a final determination that the mark had not acquired secondary meaning and therefore, the registration was invalid.<sup>84</sup> However, the ITC affirmed the finding of infringement if either the ‘753 Trademark registration or the common law rights would have been valid.<sup>85</sup>

The Federal Circuit clarified that there is but a single mark, to which different rights attach from the common law and from federal registration.<sup>86</sup> Because product-design trade dress can never be inherently distinctive,<sup>87</sup> the Federal Circuit reasoned that on remand, Converse must show that its mark had acquired secondary meaning before the first infringing use by each alleged infringer.<sup>88</sup> The presumption of validity afforded to trademark registrations does not apply to infringement occurring prior to the registration date.<sup>89</sup>

The Federal Circuit also clarified the six factors for determining secondary meaning: (1) consumer surveys; (2) length, degree, and exclusivity of use; (3) amount and manner of advertising; (4) amount of sales and number of customers; (5) intentional copying; and (6) unsolicited media coverage.<sup>90</sup> All six factors are to be weighed together in determining the existence of secondary meaning.<sup>91</sup>

The Federal Circuit criticized the ITC for the weight it gave to the trademark owner’s and third parties’ uses predating the relevant time period—the recent period before first use or infringement—for a secondary meaning analysis.<sup>92</sup> The Federal Circuit found that the most relevant period is the preceding five years of substantially exclusive and continuous use, which would weigh strongly in favor of a finding of secondary meaning.<sup>93</sup> It explained that while section 2(f) of the

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82. *Id.*

83. *Id.*

84. *Id.* at 1115.

85. *Id.* at 1114–15.

86. *Id.* at 1115.

87. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 216 (2000).

88. *Converse*, 909 F.3d at 1116.

89. *Id.* at 1117.

90. *Id.* at 1120.

91. *Id.*

92. *Id.*

93. *Id.* at 1120–21.

Lanham Act cannot be read as limiting the inquiry to the five years before the relevant date, uses which predate such a time period likely would not impact consumers' perceptions as of the relevant date.<sup>94</sup> In sum, evidence older than this five-year period should be reevaluated by the ITC on remand.<sup>95</sup>

In analyzing whether the trademark owner's use of the mark was substantially exclusive, the Federal Circuit directed the ITC to constrain its analysis of both Converse's use and the use by its competitors to marks "substantially similar" to Converse's registered mark.<sup>96</sup>

As to the survey evidence on the issue of secondary meaning, the Federal Circuit cautioned against the use of current surveys "as evidence of historic secondary meaning."<sup>97</sup> A survey in the present accesses a different pool of respondents than those relevant to historic secondary meaning.<sup>98</sup> Such surveys can still be given "weight appropriate to the extent that [they] shed[] light on consumer perceptions in the past."<sup>99</sup> The Federal Circuit added that although no single factor is determinative, "[s]urveys that are conducted within five years of the relevant date may provide evidence as to secondary meaning."<sup>100</sup>

The Federal Circuit also held that in the context of trade dress infringement, accused products that are not substantially similar cannot infringe.<sup>101</sup> The brand name labelling may be highly probative evidence, but is not dispositive as a matter of law, and so the ALJ did not misapply that rule.<sup>102</sup> Nor did the ITC err in not requiring evidence of harm to reputation as a prerequisite to infringement or in finding the trademark nonfunctional.<sup>103</sup>

Judge O'Malley wrote a concurring in part and dissenting in part opinion.<sup>104</sup> Judge O'Malley argued that the issue of validity of the registration was not properly before the ITC, because the defaulting parties did not challenge Converse's claims of infringement and because the remaining parties' infringing uses occurred before

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94. *Id.* at 1121.

95. *Id.* at 1122.

96. *Id.*

97. *Id.*

98. *Id.*

99. *Id.*

100. *Id.* at 1123.

101. *Id.* at 1124.

102. *Id.*

103. *Id.* at 1124–25.

104. *Id.* at 1127.

registration.<sup>105</sup> She further found that the Federal Circuit owed deference to the detailed factual findings of the ITC as to the likelihood of confusion factors.<sup>106</sup> Finally, Judge O’Malley would have instructed the ITC to enter a remedy against all the defaulting parties, or to justify its failure to do so by reference to any relevant public interest concerns.<sup>107</sup>

### C. *Mere Descriptiveness and Genericness*

In two of the cases decided in 2018, the Federal Circuit analyzed the genericness doctrine. In both cases, the Federal Circuit found the TTAB’s approach to the generic dispute erroneous and therefore remanded both cases, directing the TTAB to reconsider issues related to the genus of the respective products at issue.

#### I. *Royal Crown Co. v. Coca-Cola Co.*

In *Royal Crown Co. v. Coca-Cola Co.*,<sup>108</sup> the Federal Circuit addressed the distinctiveness of the ZERO marks when applied to certain beverage products. In this case, Royal Crown appellants—members of the Dr. Pepper Snapple Group—opposed The Coca-Cola Company’s (“Coca-Cola”) applications to register seventeen trademarks with the term ZERO with the U.S. Patent and Trademark Office (“PTO”).<sup>109</sup> Initially, the PTO issued office actions rejecting Coca-Cola’s applications on the basis of ZERO being merely descriptive, requiring Coca-Cola disclaim that word.<sup>110</sup> Coca-Cola responded by claiming that the ZERO term in its marks had acquired distinctiveness as to its goods in the marketplace under section 2(f) of the Lanham Act.<sup>111</sup> The PTO accepted Coca-Cola’s section 2(f) submissions, dropped the disclaimer requirement, and approved the applications for publication.<sup>112</sup> Royal Crown then filed oppositions to the applications, arguing that the marks cannot indicate the products’ source because

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105. *Id.* at 1128.

106. *Id.* at 1132.

107. *Id.* at 1133.

108. 892 F.3d 1358 (Fed. Cir. 2018).

109. *Id.* at 1362. Dr. Pepper Snapple Group and Coca-Cola compete in the beverage market by manufacturing and distributing drinks that use ZERO as an element of their marks. *Id.*

110. *Id.* at 1363.

111. *Id.*

112. *Id.*

the term ZERO was “merely descriptive” of the products, and generic when applied to certain beverage products.<sup>113</sup>

The TTAB dismissed the oppositions on two main grounds.<sup>114</sup> First, it found Royal Crown failed to prove that ZERO is generic for the “genus” of the goods identified by the TTAB as “the broad category of soft drinks . . . which encompasses the narrower category of soft drinks . . . containing minimal or no calories.”<sup>115</sup> Second, the TTAB held that Coca-Cola proved by a preponderance of the evidence that it had acquired distinctiveness in the term ZERO when used as part of a mark for soft drinks.<sup>116</sup>

On appeal to the Federal Circuit, Royal Crown argued that the term ZERO is either generic or highly descriptive with no acquired distinctiveness.<sup>117</sup>

Relying on its precedent in *In re Cordua Restaurants, Inc.*,<sup>118</sup> the Federal Circuit found the TTAB’s approach to the generic dispute erroneous in two respects.<sup>119</sup> First, the TTAB failed to examine whether ZERO identified a key aspect of the genus at issue.<sup>120</sup> Second, the TTAB failed to examine how the relevant public understood the brand name at issue when used with the descriptive term ZERO.<sup>121</sup>

The Federal Circuit relied on the two-step *Marvin Ginn*<sup>122</sup> test to determine whether the term ZERO is generic or not.<sup>123</sup> First, it asked what the genus of goods or services is at issue.<sup>124</sup> The TTAB answered this question by finding that the relevant genus is “soft drinks, sports drinks, and energy drinks.”<sup>125</sup> Royal Crown argued that the TTAB erred by only discussing this broad genus of beverages.<sup>126</sup> Royal Crown

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113. *Id.* (citing *Royal Crown Co. v. Coca-Cola Co.*, 2016 TTAB LEXIS 234, at \*1 (T.T.A.B. 2016)).

114. *Royal Crown Co.*, 2016 TTAB LEXIS 234, at \*1 (sustaining in part and dismissing in part Royal Crown’s consolidated oppositions).

115. *Royal Crown*, 892 F.3d at 1363 (internal quotations omitted) (citing *Royal Crown Co.*, 2016 TTAB LEXIS 234, at \*20).

116. *Id.* at 1364 (citing *Royal Crown Co.*, 2016 TTAB LEXIS 234, at \*48).

117. *Id.* at 1365.

118. 823 F.3d 594, 603 (Fed. Cir. 2016).

119. *Royal Crown*, 892 F.3d at 1367.

120. *Id.*

121. *Id.* at 1368.

122. *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 989 (Fed. Cir. 1986). Under the *Marvin Ginn* test, the opposer—here, Royal Crown—bears the burden of proof by a preponderance of the evidence standard. *Royal Crown*, 892 F.3d at 1366.

123. *Id.*

124. *Id.* (quoting *Marvin Ginn*, 782 F.2d at 990).

125. *Id.* at 1367 (quoting *Royal Crown Co.*, 2016 TTAB LEXIS 234, at \*20) (internal quotations omitted).

126. *Id.*



contends that ZERO is generic or highly descriptive if it “clearly refers to a particular characteristic of a subset of beverages.”<sup>127</sup>

Second, the Federal Circuit asked whether the term is understood or used by the relevant public primarily to refer to that genus of goods or services.<sup>128</sup> Neither party disputed *who* the relevant public was.<sup>129</sup> The primary dispute centered on whether the relevant public primarily used or understood the term ZERO to refer to soft, sports, and energy drinks.<sup>130</sup>

In its analysis of the relevant evidence under the second prong, the Federal Circuit determined that the TTAB had failed to examine whether the relevant public understood the term ZERO to refer to a “key aspect” of the soft, sport, and energy drink genus even if the public does not understand the term to refer to the entire genus.<sup>131</sup> If the public understood the term ZERO when used in conjunction with the designated beverage name to refer to a subgroup of beverage with specific characteristics, then the term would be rendered generic.<sup>132</sup> Here, the subgroup encompasses drinks with few or no calories or few or no carbohydrates.<sup>133</sup>

The Federal Circuit remanded and directed the TTAB to consider whether the term ZERO, when appended to a beverage mark, refers to a key aspect of the genus.<sup>134</sup> ZERO is generic if it refers to a key aspect of at least a subgroup of the beverage goods.<sup>135</sup>

In addition to the incorrect genericness inquiry, the Federal Circuit determined that the TTAB should have assessed the level of the mark’s descriptiveness *before* determining whether Coca-Cola satisfied its burden of establishing acquired distinctiveness.<sup>136</sup> Without knowing the mark’s descriptiveness, the Federal Circuit cannot review on appeal whether the evidentiary record can support the TTAB’s finding of acquired distinctiveness.<sup>137</sup> The Federal Circuit thus vacated the TTAB’s finding on acquired distinctiveness with instructions that if this

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127. *Id.*

128. *Id.* at 1366 (quoting *Marvin Ginn*, 782 F.2d at 989–90).

129. The relevant public consisted of “ordinary consumers who purchase and drink soft drinks, energy drinks, or sports drinks.” *Id.* at 1363 (quoting *Royal Crown Co.*, 2016 TTAB LEXIS 234, at \*22) (internal quotations omitted).

130. *Id.* at 1367 (citing *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 965 (Fed. Cir. 2015)).

131. *Id.* (citing *In re Cordua Rests., Inc.*, 823 F.3d 594, 605 (Fed. Cir. 2016)).

132. *Id.* at 1368.

133. *Id.*

134. *Id.*

135. *Id.*

136. *Id.*

137. *Id.* at 1368–69.

question is reached on remand, the TTAB must make an “express finding” on the mark’s descriptiveness level on the “scale ranging from generic to merely descriptive” with an explanation of how the evidentiary record supports its assessment.<sup>138</sup>

The Federal Circuit further noted three concerns with how the TTAB treated the evidentiary material.<sup>139</sup> First, the TTAB erred when it required Royal Crown to provide direct evidence of consumer perception to support its genericness challenge to Coca-Cola’s marks.<sup>140</sup> The Federal Circuit explained that evidence of public perception can be obtained from “any competent source,” and no case provides precedent that Royal Crown’s evidence was categorically insufficient to support a finding of genericness.<sup>141</sup> Second, the TTAB took the incorrect position that the commonness of Coca-Cola’s ZERO product and huge sales outweighed the opposers’ evidence of genericness.<sup>142</sup> The TTAB’s position ignored “the fact that [g]eneric terms cannot be rescued by proof of distinctiveness or secondary meaning no matter how voluminous the proffered evidence may be.”<sup>143</sup> Third, the Federal Circuit found the TTAB’s reliance on an outdated, five-year-old survey to support its finding that Coca-Cola had acquired distinctiveness in its ZERO marks problematic.<sup>144</sup> An old survey does not reflect contemporary public perception, so its probative value decreases.<sup>145</sup>

## 2. *Real Foods Pty Ltd. v. Frito-Lay North America, Inc.*

In *Real Foods Pty Ltd. v. Frito-Lay North America, Inc.*,<sup>146</sup> Real Foods sought registration of two marks: CORN THINS for “crispbread slices

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138. *Id.* at 1369.

139. *Id.* at 1369–70.

140. *Id.* at 1370.

141. *Id.* (quoting *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 1559 (Fed. Cir. 1985)) (italics omitted). In *In re Northland Aluminum Products, Inc.*, the Federal Circuit interpreted any competent source to include “consumer surveys, dictionaries, newspapers and other publications.” 777 F.2d at 1559. Royal Crown offered various sources of competent evidence on the genericness issue, including evidence of competitive use, third-party registrations and applications, and evidence of third-party and Coca-Cola descriptive uses of “zero” and “0” on goods’ packaging and marketing materials. *Royal Crown*, 892 F.3d at 1370.

142. *Id.* (explaining that “[s]ales and advertising figures do not . . . demonstrate that a term is not used by the public to refer to the genus of goods in question”).

143. *Id.* (alteration in original) (internal quotations omitted) (quoting *Northland Aluminum*, 777 F.2d at 1558).

144. *Id.* at 1370–71.

145. *Id.* at 1371.

146. 906 F.3d 965 (Fed. Cir. 2018).

predominantly of corn, namely popped corn cakes” and RICE THINS for “crispbread slices primarily made of rice, namely rice cakes.”<sup>147</sup> Frito-Lay opposed the registrations, “arguing that the proposed marks should be refused as either generic or descriptive without having acquired distinctiveness.”<sup>148</sup> The TTAB refused registration finding the marks to be “merely descriptive,” but dismissed Frito-Lay’s genericness claim.<sup>149</sup> Both parties appealed.<sup>150</sup> The Federal Circuit affirmed in part and vacated in part, and remanded to the TTAB.<sup>151</sup>

After reviewing the four categories of terms that lie along the spectrum used to categorize marks, the Federal Circuit identified the burdens of proof for both parties.<sup>152</sup> Frito-Lay, as the opposer, bore the burden of establishing that the applicant, Real Foods, did not have the right to register its mark by proving that the terms at issue are generic or merely descriptive by a preponderance of the evidence.<sup>153</sup> Real Foods, on the other hand, had the burden of establishing acquired distinctiveness by at least a preponderance of the evidence.<sup>154</sup>

When determining whether a mark is merely descriptive, the Federal Circuit held that the TTAB “must consider the *commercial impression* of a mark as a whole, viewed through the eyes of a consumer.”<sup>155</sup> The Federal Circuit went on to hold that the TTAB should “consider the mark in relation to the goods for which it is registered, asking whether someone who knows what the goods and services are will understand the mark to convey information about them.”<sup>156</sup> While the Federal Circuit noted that the “TTAB may not dissect the mark into isolated elements” without considering the entire mark,<sup>157</sup> it held that the

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147. *Id.* at 971.

148. *Id.*

149. *Id.* (quoting *Frito-Lay N. Am., Inc. v. Real Foods Pty. Ltd.*, Nos. 91212680, 91213587, 2017 WL 914086, at \*21 (T.T.A.B. Feb. 21, 2017)).

150. *Id.*

151. *Id.*

152. *Id.* at 971–72 (citing *In re N.C. Lottery*, 866 F.3d 1363, 1366 (Fed. Cir. 2017)). Spanning from least to most protected, the categorization spectrum is as follows: generic, merely descriptive, suggestive, and arbitrary. *Id.* Generic marks cannot be registered as trademarks; merely descriptive marks have the potential to be registered upon a showing of sufficient secondary meaning; and suggestive or arbitrary marks are distinct and can be registered. *Id.* at 972–73.

153. *Id.* at 973.

154. *Id.* (citing *Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1580 (Fed. Cir. 1988)).

155. *Id.* at 974 (internal quotations omitted) (quoting *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1252–53 (Fed. Cir. 2012)).

156. *Id.* (internal quotations omitted) (quoting *DuoProSS Meditech Corp.*, 695 F.3d at 1254).

157. *Id.* (internal quotations omitted) (quoting *DuoProSS Meditech Corp.*, 695 F.3d at 1252–53).

TTAB “may weigh the individual components of the mark to determine the overall impression or the descriptiveness of the mark and its various components.”<sup>158</sup>

The Federal Circuit held that substantial evidence supported the TTAB’s finding that the proposed marks are highly descriptive, noting that the terms “corn” and “rice” are both grains and that both are the primary ingredients in their respective goods.<sup>159</sup> Indeed, both terms were disclaimed by Real Foods.<sup>160</sup> The Federal Circuit also found that the term “thins” described physical characteristics of the corn and rice cakes, noting that “Real Foods’s advertising materials used the word ‘thin’ to describe their products.”<sup>161</sup> Moreover, because the record was “replete with evidence of the term thins being used in marks for other, similar snack food products,” the Federal Circuit found use of the term “thin” to be descriptive.<sup>162</sup>

“Viewing the marks as composites” also did not create a different impression, noting that purchasers of Real Foods’s products have used the terms to describe the products, rather than to serve as source identifiers.<sup>163</sup> The Federal Circuit therefore found that there was substantial evidence to support the TTAB’s descriptiveness finding.<sup>164</sup>

In reviewing Real Foods’s counterarguments, the Federal Circuit was not convinced that the marks were suggestive because of their alleged “double entendre” meaning as “low calorie, light[,] and diet-friendly.”<sup>165</sup> Nor did the Federal Circuit find that the TTAB “improperly relied on Frito-Lay’s third-party evidence, contained in its expert report, concerning the usage of ‘THINS.’”<sup>166</sup> As it has previously observed, “[e]vidence of the public’s understanding of [a] term may be obtained from *any* competent source.”<sup>167</sup> The Federal Circuit also agreed with the TTAB that prior

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158. *Id.* (internal quotations omitted) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1174 (Fed. Cir. 2004)).

159. *Id.* (internal quotations omitted) (citing *Frito-Lay N. Am., Inc. v. Real Foods Pty. Ltd.*, Nos. 91212680, 91213587, 2017 WL 914086, at \*12 (T.T.A.B. Feb. 21, 2017)).

160. *Id.*

161. *Id.* at 975 (describing their product as a “delicious *thin* corn cake”).

162. *Id.* (citing *In re Chamber of Commerce*, 675 F.3d 1297, 1300 (Fed. Cir. 2012)).

163. *Id.* at 975–76.

164. *Id.* at 976.

165. *Id.* (alteration in original) (internal quotations omitted).

166. *Id.* (internal quotations omitted).

167. *Id.* at 977 (alteration in original) (internal quotations omitted) (quoting *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 1366 (Fed. Cir. 2018)).

registrations that incorporated the term “thins” does not compel registration of Real Foods’s proposed marks.<sup>168</sup>

As for Real Foods’s claims that its marks had acquired distinctiveness, the Federal Circuit agreed with the TTAB that Real Foods “has not demonstrated that its applied-for marks have acquired distinctiveness.”<sup>169</sup> The Federal Circuit noted that Real Foods had done “little or no advertising of [its] CORN THINS and RICE THINS” marks, that sales figures were not high, that use of THINS was not limited to Real Foods, and that a survey conducted by Frito-Lay’s expert, which had some probative value, established “limited recognition of CORN THINS as a mark.”<sup>170</sup>

Regarding Frito-Lay’s cross-appeal on the TTAB’s dismissal of Frito-Lay’s claim that the proposed marks are generic, the Federal Circuit agreed that the TTAB erred, albeit not for the reasons cited by Frito-Lay.<sup>171</sup> Determining whether a mark is generic involves a “two-step inquiry that asks: (1) what is the genus of goods or services at issue, and (2) is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?”<sup>172</sup> The Federal Circuit found that the TTAB “improperly narrowed the genus of the goods at issue” by defining the genus of the goods strictly by reference to Real Foods’s recently amended description, without providing any reasoning for its conclusion that the narrowed identification was the appropriate genus to use.<sup>173</sup> Accordingly, the Federal Circuit remanded to the TTAB to “reconsider its selected genus and conduct its genericness analysis in light of that genus.”<sup>174</sup>

#### D. Surnames

There was only one Federal Circuit decision in 2018 that involved surnames. The primary issue reviewed by the Federal Circuit was whether the surname at issue had acquired the requisite distinctiveness, noting that the TTAB had properly evaluated the different types of evidence in reaching its conclusion.

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168. *Id.* (citing *In re Cordua Rests., Inc.*, 823 F.3d 594, 600 (Fed. Cir. 2016)).

169. *Id.* at 976.

170. *Id.* at 977–78 (internal quotations omitted) (quoting *Frito-Lay N. Am., Inc. v. Real Foods Pty. Ltd.*, Nos. 91212680, 91213587, 2017 WL 914086, at \*20 (T.T.A.B. Feb. 21, 2017)).

171. *Id.* at 980.

172. *Id.* at 981 (internal quotations omitted) (quoting *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 965 (Fed. Cir. 2015)).

173. *Id.*

174. *Id.* at 982.

### I. Schlafly v. Saint Louis Brewery, LLC

In *Schlafly v. Saint Louis Brewery, LLC*,<sup>175</sup> Bruce Schlafly and Phyllis Schlafly, relatives of Saint Louis Brewery (“SLB”) founder, Thomas Schlafly, opposed registration of the word mark SCHLAFLY for “[b]eer, ale and lager; [b]eer, ale and porter; [b]eer, ale, lager, stout and porter; [b]eers; [b]lack beer; [b]rewed malt-based alcoholic beverage in the nature of a beer; [and] [c]offee-flavored beer.”<sup>176</sup> Bruce and Phyllis Schlafly initially filed separate oppositions against SLB, but ultimately, the oppositions were consolidated.<sup>177</sup> Phyllis, as an undisputed well-known “conservative icon” in Missouri, argued that the Schlafly surname was primarily associated in the minds of the public with the traditional values that she represented, while Bruce argued that as a Missouri doctor, use of the SCHLAFLY mark in connection with beer could “have a negative connotation due to complications with drunk driving and intoxication.”<sup>178</sup>

Ruling in favor of SLB, the TTAB granted a registration on the Principal Register for the mark SCHLAFLY.<sup>179</sup> The TTAB concluded that the allowance was on the basis of acquired distinctiveness under section 2(f) of the Lanham Act. The TTAB also found that the mark had acquired secondary meaning.<sup>180</sup> As a result, the TTAB determined that it need not decide whether the mark was primarily a surname.<sup>181</sup> It further stated that “[i]nasmuch as there is no evidence of market proximity between Applicant and the activities of Phyllis Schlafly, there is no reason to believe that those activities have interfered with the ability of customers to associate Applicant’s mark with Applicant’s goods.”<sup>182</sup>

In dismissing the opposition, “the Board rejected the Opposers’ argument that SLB was required to submit consumer surveys as evidence of secondary meaning.”<sup>183</sup> Rather, it found the evidence presented—continuous use of the mark, the geographic scope of use of the mark, the variety of products using the mark in commerce, the large sales volume and total revenue of SCHLAFLY beer, the

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175. 909 F.3d 420 (Fed. Cir. 2018).

176. *Id.* at 422 (alterations omitted) (internal quotations omitted).

177. *Id.*

178. *Id.* (alterations omitted) (internal quotations omitted).

179. *Id.*

180. *Id.*

181. *Id.*

182. *Id.* at 423 (alteration in original) (quoting *Schlafly v. Saint Louis Brewery, LLC*, 2016 TTAB LEXIS 381, at \*9 (T.T.A.B. 2016)).

183. *Id.* (citing *Schlafly*, 2016 TTAB LEXIS 381, at \*8).

marketing types and expenditures, the significant ranking among craft brewers, and the awards won by SCHLAFLY beer—was sufficient to show acquired distinctiveness.<sup>184</sup>

On appeal, the Federal Circuit affirmed the TTAB decision.<sup>185</sup> In so doing, the Federal Circuit held that the question of acquired distinctiveness of a mark is a question of fact and that the TTAB's findings are reviewed for support by substantial evidence.<sup>186</sup> The Federal Circuit also held that “[t]he question of whether the Board applied the correct legal standard to the facts is a question of law.”<sup>187</sup>

In reviewing whether the SCHLAFLY mark had acquired distinctiveness, the Federal Circuit referenced section 2(f) of the Lanham Act,<sup>188</sup> and the Code of Federal Regulations,<sup>189</sup> which provides that the following types of evidence may be considered to show secondary meaning: ownership of prior registration(s); five years of substantially exclusive and continuous use in commerce; and other evidence, such as “verified statements, depositions, or other appropriate evidence showing duration, extent and nature of the use in commerce and advertising expenditures in connection therewith, . . . and[/or] verified statements, letters or statements from the trade or public, or both, or other appropriate evidence of distinctiveness.”<sup>190</sup>

The Federal Circuit noted that “SLB presented all three types of evidence to the Board, and the Board [properly] evaluated fifteen different forms of evidence in reaching its conclusion.”<sup>191</sup>

The opposers argued that because “SCHLAFLY is significant to the public primarily as the surname of Phyllis Schlafly,” the court should have adopted a new test called a “change in significance” test, “whereby a surname cannot be registered as a trademark without showing a change in significance to the public.”<sup>192</sup> Neither the TTAB nor the Federal Circuit found merit to this argument, noting that there is “[n]o law or precedent suggest[ing] that surnames cannot be

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184. *Id.* at 422–23 (citing *Schlafly*, 2016 TTAB LEXIS 381, at \*5–8).

185. *Id.* at 426.

186. *Id.* at 423 (quoting *In re Hotels.com, LP*, 573 F.3d 1300, 1302 (Fed. Cir. 2009) (stating that “we determine whether, on the entirety of the record, there was substantial evidence to support the determination”)).

187. *Id.*

188. *Id.* (citing 15 U.S.C. § 1052(f) (2012)).

189. 37 C.F.R. § 2.41 (2015).

190. *Schlafly*, 909 F.3d at 424 (citing 37 C.F.R. § 2.41(a)).

191. *Id.*

192. *Id.* at 425.

registered as trademarks if they have acquired distinctiveness”—or secondary meaning—“in trademark use.”<sup>193</sup>

As for the opposers’ argument that the registration violates the First and Fifth Amendments of the U.S. Constitution, the Federal Circuit noted that the opposers did not “adequately explain how registration improperly impinges on their First Amendment rights.”<sup>194</sup> The Fifth Amendment claim also failed, “as trademark registration is not a taking for government use.”<sup>195</sup> Finally, in response to the opposers’ claim that their due process rights were violated “when the Board recognized secondary meaning in the SCHLAFly mark without proof of a change in public perception,” the Federal Circuit held that the “trademark opposition procedure, of which [the opposers] ha[d] availed themselves, provide[d] appropriate process of law.”<sup>196</sup>

#### CONCLUSION

While the 2018 Federal Circuit decisions helped to clarify certain issues related to the *DuPont* likelihood of confusion factors and provided further guidance in analyzing a mark for genericness, none of the decisions significantly impacted the interpretation and implementation of the Lanham Act. Rather, like most trademark cases, the decisions were very fact specific.

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193. *Id.*

194. *Id.*

195. *Id.* (citing *Acceptance Ins. v. United States*, 583 F.3d 849, 854 (Fed. Cir. 2009)).

196. *Id.* at 426.