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Nutrasweet Co. v. K&S Foods (TTAB 1987) [257]
[nb. 'salt' **disclaimed** in 'NUTRA SALT' application]

Held, Nutra Salt not registered because, under §2(d), it "would cause confusion or cause mistake or ... deceive" by making people think product was made by the Nutrasweet folks

[good questions on p. 260]

Marshal Fields v. Mrs. Fields Cookies (TTAB 1992) [260]

Department store (Marshal Fields) opposes registration of design mark MRS. FIELDS on grounds that

- it would be confused with its house mark.
- And they sell foods including baked goods.
- And they are the senior user.

Marshal Fields also amends its claim to cancel registration of MRS FIELDS COOKIES

Sounds like a strong case, right?

This case has lots of useful talk of what the relevant factors are. Pay attention!

Note also the P's explanation as to why this isn't laches [265]

But despite the seeming formalist strength of the case it should be no surprise that the cookies win...if you look at the marks and think about how the goods are sold/purchased, confusion really isn't that likely.

[p. 269 Q. 3 is especially good]

NOTE WELL THE LITTLE PARAGRAPH ON P. 269 about dilution.

- 1. Dilution is cause for opposition and cancellation**
- 2. Dilution is not a bar to registration under § 2 (by examiner)**
- 3. Extent to which 3rd party right to bring opposition before PTO is actually meaningful could be debated in light of *Victorias Secret* decisions (we'll get there).**

Section 2(e): Geographic Terms

American Waltham Watch Co. v. US Watch Co. (Mass 1899) (Holmes, J.) [270]

Waltham Watch has had secondary meaning (P's goods).

D. accepts he can't advertise as a "Waltham Watch".

Issue: can he put 'Waltham' as place of mfg. on the watch? (customary to say where you are so folk can find you!)

TYPO p. 271 para 2 (old edition): last 3 lines should read:

On the other, we think, the cases show that the defendant fairly may be required **to avoid deceiving the public** to the plaintiff's harm, so far as is practicable in a commercial sense.

Held, keep Waltham off the watch due to its secondary meaning

Is this fair to latecomer? Is there any better rule?

In re Nantucket, Inc (CCPA 1982) [272]

Holds that PTO should register NANTUCKET for men's shirts, overturns TTAB holding that this shouldn't be registered on grounds it is "primarily geographically deceptively misdescriptive".

TTAB relied on §2(e)2, USC § 1052(e)2

TMEP rules §1208.02 says "primarily geographical" includes

"is the name of a place which has general renown to the public at large and which is a place from which goods and services are known to emanate as a result of commercial activity."

Examiner said name was either primarily geographically descriptive if shirts come from there, or primarily geographically deceptively misdescriptive if shirts didn't come from there

P. said shirts DON'T come from there, and said people wouldn't think it did since it's not known for making shirts. Hence 'arbitrary and nondescriptive'.

P. Relied on precedent relating to 'Hawaiian' shirts.

Board's test was 'is name of place recognizable'

Court says Board used wrong test; that proper test is to ask whether public associates place with manufacture of those goods – yes, that's more work for PTO, more subjective, but that's the test ("descriptively" "misdescriptively" (e.g. ALASKA bananas vs. Alaska salmon, p. 275 n. 5)

Note that this test does NOT have a materiality element. Issue is association, not relevance to purchase.

In Re California Innovations Inc. (Fed. Cir. 2003) [supp. 26]

California Innovations, Inc. applied to register the mark CALIFORNIA INNOVATIONS & Design for goods that did not originate in California.

After the PTO refused registration based on likelihood of confusion with prior registrations, CI disclaimed "California" and amended its identification and classification of the goods. [cf. note 1 on p. 31 for the non-effect of this disclaimer!]

The mark was published without opposition, but the PTO later refused registration on misdescriptiveness ground.

Issue is proper standard for §1052(e)(3) in evaluating CALIFORNIA INNOVATIONS for a *Canadian* corporation. [Note: this is an ITU application -- would the issues be any different in an ordinary TM application?]

§1052. Trademarks registrable on the principal register; concurrent registration

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it--

...

Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 4 [15 USC §1054], (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them, (4) is primarily merely a surname, or (5) comprises any matter that, as a whole, is functional.

Before NAFTA there were three categories of geographical marks:

- (1) geographically deceptive marks that materially deceive the public (§ 1052(a)) [permanently unregistrable]
- (2) primarily geographically descriptive marks (§ 1052(e)(2)) and
- (3) primarily geographically deceptively misdescriptive marks (§ 1052(e)(3)).

NAFTA changes the rules for §1052(e)(2) & (3). Before NAFTA a "primarily geographically descriptive" mark and a "primarily geographically deceptively misdescriptive" mark were treated

much the same in that it didn't take a great showing -- lack of distinctiveness -- to say they were not registerable without secondary meaning. After relegation to the Supplemental Register, they could get promoted to the Primary with the right showing.

After NAFTA, the test for non-registration is akin to that for §1052(e)(1) -- a showing of deception. The higher showing is necessary because the consequences of a §1052(e)(3) refusal are now *permanent*. Therefore PTO must use *Budge* test and show a goods-place association [cf. *Nantucket*] before refusing to register the mark: denial if (1) the primary significance of the mark is a generally known geographic location; AND (2) the consuming public is likely to believe the place identified by the mark indicates the origin of the goods bearing the mark, when in fact the goods do not come from that place; AND (3) the misrepresentation was a material factor in the consumer's decision.

Applying this test, the court says

(1) TTAB's finding that use of CALIFORNIA not outweighed by rest of mark or by design element seems supported in record

(2) Record silent on this issue [court sounds dubious, though, given that issue is now limited to "thermal insulated food and beverage containers"!]

(3) PTO should apply materiality test here on remand.

Additional Note: In re Les Halles De Paris, 334 F.3d 1371 (Fed. Cir. 2003), uses an even stronger test for PTO rejection of misdescriptive service marks.

The Federal Circuit stated that services are different from goods because consumers will usually receive the services at the location of the business, so that they are aware that the services are not coming from the geographic location named in the mark. Thus, the Federal Circuit required the PTO to provide additional evidence to satisfy the services-place association and materiality prongs of the test. In service mark cases, the PTO must now show that

(1) consumers "will likely be misled to make some meaningful connection between...the service and the relevant place," and

(2) there is a "heightened association" between the service provided and the relevant geographic location.

Geographically suggestive marks [281]

What's the "aura" of a place?

"Park Avenue" "Wall st." "South Beach"

Good questions on p. 281.

§1502 = §2(e)(4)

No TM by which goods can be distinguished from another's to be refused registration UNLESS

...

(e) consists of a mark which ... (4) is primarily merely a surname.

In Re Quadrillion Publishing (TTAB 2000) [282]

BRAMLEY mark rejected for books magazines etc. in International Class 16

Applicant says it's a place and a type of apple. Examiner said it's a name and used a DB of 80 million names - which has 433 Bramley people in it. Plus it's not in the dictionary. CA-Fed says that's enough for prima facie surname case. Hutchinson Technology [mentioned 283]

Test: whether it is "primarily merely a surname" depends on "primary significance of the mark to the purchasing public"

Factors

- : (i) the degree of surname rareness;
- (ii) whether anyone connected with applicant has the surname;
- (iii) whether the term has any recognized meaning other than that of a surname;
- and
- (iv) the structure and pronunciation or "look and sound" of the surname.

Examining atty met initial burden of proving name is primarily surname.

Question p. 285. If you can show that the name is now distinctive w/in § 2(f) (i.e. 2ndary meaning), it's registerable. But does that registration give you exclusive use? [w/ great reluctance]

Numerals, Letters & Initials [285]

Grades generally not registerable, but possible 2ndary meaning.

IBM. Others?

§2(e)(5) [286]

can't register a mark that "comprises any matter that, a whole, is functional".
[thus, the clothes design cases]