

**CHADBOURNE  
& PARKE LLP**

**Recent U.S.  
Trademark Decisions**

**Joseph A. Calvaruso**

May 2006

**Merely Descriptive**

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***In re America Online, Inc.***

77 USPQ2d 1618 (TTAB 2006)

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**CHADBOURNE  
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***In re America Online, Inc.***

77 USPQ2d 1618 (TTAB 2006)

- America Online, Inc. was refused registration of the term INSTANT MESSENGER for various telecommunication and computer services for genericness and merely descriptiveness.
- The Examining Attorney argued that the wording INSTANT MESSENGER is (1) generic because it has become the term that consumers use to refer to real-time internet communication services and as such, (2) merely describes a feature of applicant's services.
- The Examining Attorney presented numerous examples of uses of the term INSTANT MESSENGER in several categories from the internet and the NEXIS database, some of which appear to be generic uses for similar services.

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Applicant responded with the following evidence supporting its position that INSTANT MESSENGER is not generic nor descriptive and that it had acquired secondary meaning:

1. Its INSTANT MESSENGER services had 8 million customers as early as May 1997, 80 million users in 2000, and 125 million users in 2001.
2. Its website [www.aol.com](http://www.aol.com) with a link to the INSTANT MESSENGER service receives 28 million hits per day.
3. Declarations that applicant licensed its INSTANT MESSENGER mark to Earthlink, Lycos, Juno and others.

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Applicant's supporting evidence (continued):

4. Evidence of advertising efforts where 60 million copies of a mail piece prominently displayed INSTANT MESSENGER.
5. Declarations from users that they recognize INSTANT MESSENGER as a service from American Online as opposed to other companies.
6. Articles where INSTANT MESSENGER is designated as a trademark.
7. Evidence that Applicant policed its mark.

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**Genericness:**

- "[T]he evidence of generic use is offset by applicant's evidence that shows not only a significant amount of proper trademark use but also trademark recognition by customers, publishers and third parties."
- The refusal on the ground of genericness is reversed

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***In re America Online, Inc.***

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**Merely Descriptive**

- A mark is merely descriptive if the ultimate consumers immediately associate it with a quality or characteristic of the product or service.
- There is evidence that consumers understand the term "instant messaging" as the term that refers to the services of the type identified by Applicant.
- The refusal to register the mark on the ground of mere descriptiveness is affirmed.

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**Acquired Distinctiveness**

- Section 2(f) of the Trademark Act provides that "nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce."
- Based upon the evidence of the millions of users and the licensing to many corporations, Applicant has met its burden of showing that INSTANT MESSENGER has acquired distinctiveness and the refusal to register under Section 2(f) of the Trademark Act is reversed.

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## **Merely Descriptive**

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***In re Hunter Fan Co.***  
2006 WL 479001 (TTAB Feb. 15, 2006)

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***In re Hunter Fan Co.***  
2006 WL 479001 (TTAB Feb. 15, 2006)

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**ERGONOMIC**  
for "ceiling fans".

**Q. Merely Descriptive?**

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***In re Hunter Fan Co.***  
2006 WL 479001 (TTAB Feb. 15, 2006)

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**A. Yes, ERGONOMIC is  
merely descriptive of the described goods.  
Refusal to register is affirmed.**

- "[A] word need not be in common use in an industry to be descriptive, and the mere fact that an applicant is first to use a descriptive term in connection with its goods, does not imbue the term with source-identifying significance."
- The term ERGONOMIC "when used in connection with ceiling fans would immediately inform potential consumers that the fans are designed to 'interact efficiently and safely' with the user, in a way that makes it easier to use and beneficial to the user's living environment."

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## **Merely Descriptive**

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***In re King Koil Licensing Co.***  
2006 WL 639160 (TTAB Mar. 2, 2006)

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***In re King Koil Licensing Co.***  
2006 WL 639160 (TTAB Mar. 2, 2006)

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## **THE BREATHABLE MATTRESS**

for "beds, mattresses, box springs and pillows".

### **Q. Merely Descriptive?**

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***In re King Koil Licensing Co.***  
2006 WL 639160 (TTAB Mar. 2, 2006)

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### **A. Yes, THE BREATHABLE MATTRESS is merely descriptive of the goods. Refusal to register is affirmed.**

- "Mattress" is a generic term when used for the identified goods.
- The term "breathable" retains its ordinary dictionary meaning and indicates "to the prospective mattress purchaser that the mattress allows air to circulate through it".
- The mark is "nothing more than a combination of descriptive terms that immediately convey a feature of the goods . . . ."

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## **Merely Descriptive**

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### ***In re Finisar Corp.***

2006 WL 717515 (TTAB Mar. 6, 2006)

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### ***In re Finisar Corp.***

2006 WL 717515 (TTAB Mar. 6, 2006)

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**SMARTSFP**

for "optical transceivers."

**Q. Merely Descriptive?**

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***In re Finisar Corp.***  
2006 WL 717518 (TTAB Mar. 8, 2006)

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**A. Yes, SMARTSFP is  
merely descriptive of the goods.  
Refusal to register is affirmed.**

- SFP is "an abbreviation for small form-factor pluggable as used in connection with optical transceivers."
- "Smart" conveys to prospective consumers that "the transceivers contain a computer chip or micro-chip, are electronically guided and/or are computer programmed."
- Applicant offered a definition of "smart" as a "highly automated device that imitates intelligence."

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**Likelihood of  
Confusion**

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***DC Comics v. Pan American Grain Mfg. Co.***

77 USPQ2d 1220 (TTAB 2005)

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**DC Comics v.  
Pan American Grain Mfg. Co.**  
77 USPQ2d 1220 (TTAB 2005)

# KRYPTONITE

for T-Shirts, toys, and sporting goods, etc.

VS.

# KRIPTONITA

for prepared alcoholic fruit cocktail

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**DC Comics v.  
Pan American Grain Mfg. Co.**  
77 USPQ2d 1220 (TTAB 2005)

A proposed label  
for Pan American's  
identified goods:



**Original Formula**  
MADE WITH RUM, TEQUILA, FRUIT JUICES,  
NATURAL FLAVORS, ARTIFICIAL COLORS  
AND FOOD-YELLOW # 6  
Alcohol: 11% by Volume 6.75 FL. OZ. (200 ML.)

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**DC Comics v.  
Pan American Grain Mfg. Co.**  
77 USPQ2d 1220 (TTAB 2005)

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- Pan American sought to register KRIPTONITA for "prepared alcoholic fruit cocktail" and DC Comics opposed the application alleging a likelihood of confusion with its Superman character and the mark KRYPTONITE.
- Under the doctrine of foreign equivalents, the marks are regarded as identical because KRIPTONITA is the Spanish term for KRYPTONITE.

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**DC Comics v.  
Pan American Grain Mfg. Co.**  
77 USPQ2d 1220 (TTAB 2005)

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- Pan American's goods, prepared alcoholic fruit cocktails, are different from DC Comics's goods for which it owns registrations for KRYPTONITE including T-Shirts, toys, and sporting goods, etc.
- However, KRYPTONITE is a "merchandising mark" that has been used in promoting food products and beverages and it has been the subject of licenses for certain collateral products.

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**DC Comics v.  
Pan American Grain Mfg. Co.**  
77 USPQ2d 1220 (TTAB 2005)

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- DC Comics coined the word KRYPTONITE for the fictional substance and consumers will view the term "as an indicia of the Superman mythos".
- Adult consumers of alcoholic beverages who would be aware of the term kryptonite as part of the Superman stories from their childhood.
- The Board concluded that if KRIPTONITA appears on Pan American's cocktails, consumers would likely believe that DC Comics licensed the mark and sponsored the goods.

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**DC Comics v.  
Pan American Grain Mfg. Co.**  
77 USPQ2d 1220 (TTAB 2005)

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- DC Comics has challenged and stopped most third-party uses of KRYPTONITE.
- There was evidence of Applicant's bad faith adoption of the mark with intention to trade off of DC Comics's goodwill, especially considering that Applicant's proposed label clearly depicts a green KRYPTONITE crystal.
- The Board sustained the opposition on the ground of likelihood of confusion.

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## Likelihood of Confusion

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***Standard Knitting, Ltd. v. Toyota Jidosha  
Kabushiki Kaisha***

77 USPQ2d 1917 (TTAB 2006)

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***Standard Knitting, Ltd. v.  
Toyota Jidosha Kabushiki Kaisha***  
77 USPQ2d 1917 (TTAB 2006)

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**TUNDRA and TUNDRA SPORT**

for "men's ladies' and children's clothing, namely,  
sweaters, hats, jackets, coats, shorts, t-shirts,  
vests and shirts"

vs.

**TUNDRA**

for "automobiles and structural parts thereof"

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**Standard Knitting, Ltd. v.  
Toyota Jidosha Kabushiki Kaisha**  
77 USPQ2d 1917 (TTAB 2006)

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**NO Likelihood of Confusion.  
Opposition is dismissed.**

- Automobiles and clothing are sold in completely different marketing environments and channels of trade (malls and department stores vs. automobile dealerships).
- Ordinary consumers purchase both clothing and automobiles, however, automobiles are expensive and are only purchased after careful consideration.

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**Likelihood of  
Confusion**

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***Aktieselskabet AF v. Fame Jeans, Inc.***  
77 USPQ2d 1861 (TTAB 2006)

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**CHADBOURNE  
& PARKER LLP**

**Aktieselskabet AF v.  
Fame Jeans, Inc.**  
77 USPQ2d 1861 (TTAB 2006)

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**JACK & JONES**

for clothing.

vs.

**JACK & JONES**

for clothing.

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**Aktieselskabet AF v.  
Fame Jeans, Inc.**  
77 USPQ2d 1861 (TTAB 2006)

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**Summary judgment  
on the ground of priority of use and likelihood of  
confusion is granted.**

**Opposition dismissed with prejudice.**

- Both parties sought to register JACK & JONES for clothing.
- Applicant's January 9, 2004 filing date precedes Opposer's December 6, 2004 application date.
- Opposer's use of its mark in foreign commerce and its ownership of numerous registrations throughout Europe, South America and the Middle East do not confer priority of use on Opposer for purposes of establishing its claim of priority in the United States.

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## Likelihood of Confusion

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***Teledyne Techs., Inc. v. Western Skyways, Inc.***

2006 WL 337553 (TTAB Feb. 2, 2006)

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***Teledyne Techs., Inc. v.  
Western Skyways, Inc.***

2006 WL 337553 (TTAB Feb. 2, 2006)

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**GOLD SEAL**

for "airplane parts, namely ignition harnesses"

VS.

**GOLD SEAL**

for "aircraft engines"

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**Teledyne Techs., Inc. v.  
Western Skyways, Inc.**  
2006 WL 337553 (TTAB Feb. 2, 2006)

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**There is a likelihood of confusion but the  
petition for cancellation is dismissed.**

**DEFENSE OF LACHES:**

- "[P]etitioner's delay of over three and one-half years, and the complete absence of any reasonable excuse for its inaction, constitutes undue delay prior to filing the petition for cancellation."
- The evidence shows that "respondent invested in and promoted its GOLD SEAL aircraft engines during the period during which petitioner was silent."

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**Teledyne Techs., Inc. v.  
Western Skyways, Inc.**  
2006 WL 337553 (TTAB Feb. 2, 2006)

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**IS CONFUSION INEVITABLE?**

- The defense of laches is not applicable if confusion between the parties' marks is inevitable.
- The marks are identical but the goods are not "the same or substantially the same" even though they are commercially related.
- The purchasers are a sophisticated class of consumers that includes aircraft owners and operators who would be knowledgeable about what they are buying.
- There was an absence of actual confusion over a period of ten years.
- For these reasons, confusion is not inevitable and respondent's valid laches defense is applicable.

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## Likelihood of Confusion

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### ***Starbucks U.S. Brands, LLC v. Ruben***

2006 WL 402564 (TTAB Feb. 9, 2006)

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### ***Starbucks U.S. Brands, LLC v. Ruben***

2006 WL 402564 (TTAB Feb. 9, 2006)

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### **STARBUCKS and STARBUCKS COFFEE**



for coffee, tea, coffee-based and tea-based beverages as well as  
retail store services featuring such goods

vs.

### **LESSBUCKS**

for "coffee, tea, and coffee-based and tea-based beverages" and  
"retail store services featuring coffee, tea, coffee-based beverages,  
and tea-based beverages"

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**Starbucks U.S. Brands, LLC v.  
Ruben**

2006 WL 402564 (TTAB Feb. 9, 2006)

**Likelihood of Confusion.  
Opposition sustained.**

- STARBUCKS is a distinctive, strong and famous mark.
- The respective goods and services herein are legally identical.
- The trade channels and classes of purchasers are therefore legally identical.
- The marks are similar as to appearance, sound and commercial impression.
- The goods and services are inexpensive and are sold to ordinary classes of consumers.
- Purchasers are unlikely to exercise care in purchasing the identified goods and services.
- Parody is unavailing to applicant as an outright defense and does not serve to distinguish the marks.

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**Thank You**

Joseph A. Calvaruso  
Chadbourne & Parke LLP  
30 Rockefeller Plaza  
New York, NY 10112  
(212) 408-1198  
[jcalvaruso@chadbourne.com](mailto:jcalvaruso@chadbourne.com)

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