

## ARTICLE

THE TRADEMARK JURISPRUDENCE OF  
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## INTRODUCTION

For nearly forty-three years, Giles Sutherland Rich<sup>1</sup> served as a member of the U.S. Court of Customs and Patent Appeals (C.C.P.A.) and its successor court, the U.S. Court of Appeals for the Federal Circuit.<sup>2</sup> Judge Rich is widely regarded as one of the most influential jurists in the area of patent law—and rightfully so.<sup>3</sup> Less well known

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1. Giles Sutherland Rich was born on May 30, 1904, and died on June 9, 1999 at the age of ninety-five. A graduate of Harvard College and Columbia Law School, Rich practiced patent and trademark law in New York for twenty-seven years before his appointment to the C.C.P.A. Along with Patent Office Examiner-in-Chief Pasquale J. Federico, Rich drafted what was later enacted as the Patent Act of 1952, the most significant revision of U.S. patent law since 1836. *See Judge Giles Sutherland Rich*, 76 J. PAT. & TRADEMARK OFF. SOC'Y 305, 305-06 (1994) (detailing Judge Rich's role in the drafting of the 1952 Patent Act). Rich was awarded the Jefferson Medal of the New Jersey Patent Law Association, the Charles F. Kettering Award and Distinguished Government Service Award from George Washington University and the Harlan Fisk Stone Medal from Columbia University. The American Intellectual Property Law Association's annual patent moot court competition is named after him, as is an Inn of Court located in Washington, D.C. In addition, Judge Rich was awarded honorary Doctor of Laws degrees from George Washington University, the John Marshall Law School, and George Mason University.

2. Rich assumed office as an associate judge of the C.C.P.A. on July 20, 1956. The C.C.P.A. had jurisdiction over, *inter alia*, appeals from the U.S. Patent and Trademark Office ("PTO") with respect to patent applications and interferences and applications for registration of marks. The court, which consisted of five judges, heard each case en banc. With the merger of the C.C.P.A. with the U.S. Court of Claims on October 1, 1982, Judge Rich became an associate judge on the newly created U.S. Court of Appeals for the Federal Circuit. The Federal Circuit has jurisdiction over, *inter alia*, appeals from the PTO with respect to both patent applications and interferences, and applications for registration of marks, and over appeals from the federal district courts in patent infringement suits. *See* 28 U.S.C. § 1295 (2006). The Federal Circuit, which, at full complement, consists of twelve judges (*see* 28 U.S.C. § 44), generally sits in three-judge panels. *See* 28 U.S.C. § 46(b) and § 46(c). Judge Rich served on the Federal Circuit until his death in 1999. By the time of his death, he had become the oldest living federal judge. Judge Rich never took senior status. A special session of the Federal Circuit was held on September 27, 1999, to commemorate his life and career. The then chief judge of the court, the Honorable H. Robert Mayer, commented at that time that, "[t]he law has lost a legend, the court has lost an institution, and we all have lost a friend. But what a wonderful long life he had." *See The Third Branch*, "Oldest Active Federal Judge Dies," <http://www.uscourts.gov/tb/jul99tb/oldest.html>.

3. During his tenure on the bench, Judge Rich authored many landmark patent law decisions. *See, e.g., In re Bergy*, 596 F.2d 952, 201 U.S.P.Q. 352 (C.C.P.A. 1979), *aff'd sub nom.* *Diamond v. Chakrabarty*, 447 U.S. 303 (1980) (holding that a human-made microorganism is patentable subject matter); *In re Diehr*, 602 F.2d 982, 203 U.S.P.Q. (BNA) 44 (C.C.P.A. 1979), *aff'd sub nom.* *Diamond v. Diehr*, 450 U.S. 175 (1981) (holding that a process for curing synthetic rubber employing mathematical formula and programmable digital computer is patentable subject matter); *State St. Bank & Trust Co. v. Signature Fin. Group*, 149 F.3d 1368, 47 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1998) (holding that a method of doing business is patentable subject matter); *In re Donaldson*, 16 F.3d 1189, 29 U.S.P.Q.2d (BNA) 1845 (Fed. Cir. 1994) (holding that 35 U.S.C. § 112, para. 6, applies during *ex parte* prosecution); *In re Alappat*, 33 F.3d 1526, 31 U.S.P.Q.2d (BNA) 1545 (Fed. Cir. 1994) (en banc) (holding that data, transformed by machine through mathematical equations to produce smooth waveform display on rasterizer monitor, constituted practical application of abstract idea because it produced "useful, concrete and tangible

is that Judge Rich also authored many significant decisions in the area of trademark law. Judge Rich's opinions in the area of trademarks span the spectrum of trademark registrability issues and explore important issues of public policy.

This Article reviews a number of Judge Rich's most important trademark and intellectual property decisions.<sup>4</sup> These decisions focus on such issues as the impact of consents, functionality, trademark subject matter, and genericness. Such a review leads to the observation that the vast majority of his opinions and views remain relevant, indeed, controlling, in resolving trademark registration disputes.

#### I. THE ROLE OF THE PATENT AND TRADEMARK OFFICE IN PROTECTING THE PUBLIC INTEREST: THE IMPACT OF CONSENTS

As part of its statutory responsibilities, the Patent and Trademark Office ("PTO")<sup>5</sup> may refuse registration of a mark under Section 2(d) of the Federal Trademark ("Lanham") Act upon a finding that such mark so resembles a previously registered or used mark as to be likely to cause confusion.<sup>6</sup> One avenue open to an applicant confronted with such a refusal is to obtain the consent of the owner of the

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result"); *In re Bass*, 474 F.2d 1276, 177 U.S.P.Q. (BNA) 178 (C.C.P.A. 1973) (holding that 35 U.S.C. § 102(g) makes available as "prior art" under 35 U.S.C. § 103 prior invention of another who has not "abandoned, suppressed or concealed" invention); *In re Hilmer*, 424 F.2d 1108, 165 U.S.P.Q. (BNA) 155 (C.C.P.A. 1970) (holding that the limitation of 35 U.S.C. § 102(g) to prior inventions made "in this country" is not removed by 35 U.S.C. § 119, which provides that application for U.S. patent could be given a date prior to when the application was filed in foreign country); see also A. Samuel Oddi, *Assault on the Citadel: Judge Rich and Computer-Related Inventions*, 39 HOUS. L. REV. 1033 (2002-03) (reviewing Judge Rich's patent law decisions related to computer technology).

4. A search of the LEXIS database conducted in January 2004 revealed a total of 174 trademark-related decisions, including concurring and dissenting opinions, authored by Judge Rich. We wish to thank former research assistant, Justin Greenfelder, for help in compiling the cases and current research assistant, Kevin Quinn, for assistance.

5. The acronym "PTO" is used as a shorthand reference to the Trademark Operations of the United States Patent and Trademark Office. It was not until 1975 that the term "Trademark" was incorporated in the name of the agency responsible for examining applications for federal registration of marks. Act of Jan. 2, 1975, Pub. L. No. 93-596, § 1, 88 Stat. 1949. Prior to that time, the agency was known simply as the "Patent Office."

6. 15 U.S.C. § 1052(d) provides that a mark shall be refused registration if it: so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive . . . .

In fact, the PTO does not refuse registration based on a previously used mark unless such mark is the subject of a federal registration. See TRADEMARK MANUAL OF EXAMINING PROCEDURES, § 1207.03, MARKS PREVIOUSLY USED IN UNITED STATES BUT NOT REGISTERED (4th ed. 2005).

previously registered mark to the registration and use of the mark by the applicant. Judge Rich's opinions reflect the view that such consents should be respected. However, until the recent past, the PTO and the courts have been reluctant to accord such consents much weight, if any at all. For example, in *In re Laskin Brothers, Inc.*,<sup>7</sup> a case decided under the 1905 Trademark Act, the C.C.P.A. stated that "the Commissioner of Patents acts as the guardian of the public interests and the parties by their deeds or agreement cannot confer upon him the power to do that which he is prohibited from doing under the statute."<sup>8</sup> During his tenure on the bench, Judge Rich played a leading role in effecting a reassessment of this view to reflect the realities of the marketplace. A review of his opinions on this issue reveals his deep understanding of the underpinnings of both U.S. trademark law<sup>9</sup> and the role of the PTO.

Judge Rich first explored the premise that the PTO should serve as the guardian of the public interest in his concurring opinion<sup>10</sup> in *In re National Distillers and Chemical Corp.*<sup>11</sup> In that case, the Examiner of Trademarks refused registration of the mark MERITO for rum under Section 2(d) of the Lanham Act in view of a registration for MARQUES DEL MERITO for wines, despite the existence of a consent to use and register by the owner of the cited registration.<sup>12</sup> In reversing the decision of the Trademark Trial and Appeal Board,<sup>13</sup> the C.C.P.A. determined that its earlier decision in *Laskin* was not controlling since it was issued prior to enactment of the Lanham

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7. 146 F.2d 308, 64 U.S.P.Q. (BNA) 225 (C.C.P.A. 1944).

8. *Id.* at 309, 64 U.S.P.Q. (BNA) at 226. *Laskin* cited the decision of the Commissioner of Patents in *George A. Breon and Co., Inc. v. Aronovic*, 33 U.S.P.Q. 390, 391 (Dec. Comm'r. Pat. 1937), where it was held that "the interests of the public may not be ignored; and when it appears that the goods are so nearly related that their sale under identical trade marks would be likely to confuse the public or to deceive purchasers, registration must be denied notwithstanding the owner's consent."

9. A fundamental principle of U.S. trademark law is that rights are based on priority of use, as opposed to registration. *See, e.g., In re Trade-Mark Cases*, 100 U.S. 82 (1879). This principle animates a number of Judge Rich's opinions dealing with consent agreements and the role of the Trademark Office.

10. The principal opinion was authored by Judge Arthur Smith, a former patent law professor at the University of Michigan. Judge Rich once commented that, beginning with Judge Smith's appointment, "for quite a long time, in many instances which show up in the reports here and there, one would see Rich and Smith versus the others." *See Interview with Judge Giles S. Rich*, 9 FED. CIR. B.J. 55, 61 (1999-2000).

11. 297 F.2d 941, 132 U.S.P.Q. (BNA) 271 (C.C.P.A. 1962).

12. The consent agreement provided, among other things, that the registrant would not sell in the United States rum bearing the mark MERITO. The facts of the case demonstrated that the applicant owned the cited registration until a few weeks after the application was filed and had sold MERITO rum for over twenty years.

13. 125 U.S.P.Q. 197 (T.T.A.B. 1960).

Act,<sup>14</sup> which, according to the court, liberalized the prior 1905 Act. In his concurring opinion, Judge Rich focused on the argument that the PTO acts as the guardian of the public interest in examining applications for registration of marks and that, as such, has the responsibility to exercise independent judgment on the issue of likelihood of confusion. He disagreed with that rationale, noting:

The refusal of registration, except as it is an aspect of protecting existing marks (or the protection of the freedom of the public to use words and symbols in the public domain), does not serve to protect the public from confusion because refusal to register has almost no effect on trademark use, which use always precedes application to register,<sup>15</sup> continues during the prosecution of the application, and usually goes on after registration is finally refused, unless something other than that refusal intervenes to stop such use. . . .<sup>16</sup>

In Judge Rich's view:

The public is confused only by what is done in the marketplace, by real life activity . . . . The denial of a registration has little or no effect on such activity. Its denial affords, therefore, little or no protection to the purchasing public. On the other hand, the granting of a registration may protect the public from confusion.<sup>17</sup>

This is so, Judge Rich explained, because armed with a registration, the registrant would be in a better position to halt infringing conduct.

According to Judge Rich, the primary purpose of Section 2(d) is to protect the owners of prior marks. In carrying out this purpose, he explained, it follows as a secondary effect that the public is protected from confusion.<sup>18</sup> The clause "confusion or mistake or to deceive

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14. Act of July 5, 1946, Pub. L. 79-489, ch. 540, 60 Stat. 427.

15. Prior to November 16, 1989, the effective date of the Trademark Law Revision Act of 1988 (Act of Nov. 16, 1988, Pub. L. No. 100-667, 102 Stat. 3935), U.S. trademark owners had to use their mark in commerce before being eligible to file an application to register such mark. As of November 16, 1989, U.S. trademark owners may seek registration based solely on a bona fide intention to use the mark in commerce, although use is still required before a registration may issue. See 15 U.S.C. § 1051(b)(1) and (d).

16. 297 F.2d at 948, 132 U.S.P.Q. (BNA) at 277.

17. *Id.* at 949, 132 U.S.P.Q. (BNA) at 278.

18. In support of this proposition, Judge Rich referred to a paper presented by Professor Walter J. Derenberg in which Derenberg argued that:

For the purpose of registration proceedings the private interests of the previous registrant are primarily involved and that the public interest in such situations is not sufficiently predominant to compel the Office to reject the application in its capacity as guardian of the public interest and irrespective of the previous registrant's own attitude.

See Walter J. Derenberg, *The Patent Office as Guardian of the Public Interest in Trade-Mark Registration Proceedings*, 31 J. PAT. & TRADEMARK OFF. SOC'Y, 647, 674-75 (1949).

purchasers” in Section 2(d), Judge Rich argued, must be construed by a rule of reason to include only such acts as will injure someone. “Otherwise it prevents registration to no purpose.”<sup>19</sup>

The continued viability of *National Distillers* was placed in doubt by the C.C.P.A.’s decision six years later in *In re Continental Baking Co.*<sup>20</sup> In that case, the court,<sup>21</sup> in refusing to give effect to a consent agreement from the owner of the cited registration, stated:

Congress clearly charged the Patent Office with the initial responsibility of determining whether certain trademarks are entitled to registration, as distinguished from use . . . . To hold that the present consent to register should control would be to allow individuals to take the law in their own hands, thus usurping the responsibility that Congress has placed in the Patent Office. Should there be any language in *National Distillers* intimating that individuals have such rights regarding registration of trademarks, then to that extent that decision is hereby expressly overruled.<sup>22</sup>

Soon, thereafter, the court, in *In re Avedis Zildjian Co.*,<sup>23</sup> concluded over a dissent by Judge Rich that “the interests of the public may not be ignored; and when it appears that the goods are so nearly related that their sales under identical trade marks would be likely to confuse the public or to deceive purchasers, registration must be denied notwithstanding the owner’s consent.”<sup>24</sup> *Zildjian* was followed by the decision in *Ultra-White Co., Inc. v. Johnson Chemical Industries, Inc.*,<sup>25</sup> where the C.C.P.A. refused to apply the equitable defenses of laches, estoppel and acquiescence where likelihood of confusion was not reasonably in doubt. In his dissent, Judge Rich reiterated his view that the trademark register should reflect the realities of the marketplace. According to Judge Rich:

I cannot understand what the majority thinks is accomplished by preventing or canceling the registration of a mark which will continue in use. The lack of registration will have no effect on public confusion, one way or the other, but it will disadvantage the owner of the unregistered mark in asserting his substantive *rights* (which he still has, regardless of the lack of registration) against third parties, and it will detract from the usefulness of the register

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19. 297 F.2d at 952, 132 U.S.P.Q. (BNA) at 280.

20. 390 F.2d 747, 156 U.S.P.Q. (BNA) 514 (C.C.P.A. 1968). *Continental Baking* was authored by Chief Judge Worley, the lone dissenter in *National Distillers*.

21. Judge Rich and Judge Smith dissented from the court’s decision.

22. *Continental Baking*, 390 F.2d at 749, 156 U.S.P.Q. (BNA) at 516.

23. 394 F.2d 860, 157 U.S.P.Q. (BNA) 517 (C.C.P.A. 1968).

24. *Id.* at 862, 157 U.S.P.Q. (BNA) at 519.

25. 465 F.2d 891, 175 U.S.P.Q. (BNA) 166 (C.C.P.A. 1972).

as a convenient means for determining what marks are actually in use without being in derogation of anyone's rights.<sup>26</sup>

Judge Rich's views on the role of consents in assessing how best to advance the public interest finally gained acceptance in a series of decisions issued after creation of the U.S. Court of Appeals for the Federal Circuit in October 1982. The first such case, *In re N.A.D. Inc.*,<sup>27</sup> involved an application to register the mark NARKOMED for anesthesia machines. The examiner refused registration in view of registrations for NARCO MEDICAL SERVICES for rental and leasing of hospital surgical equipment and NARCO and DESIGN for specialized medical equipment, including machines for administering anesthesia. The owner of the cited registrations consented to applicant's registration and use of NARKOMED. In upholding the refusal to register, the Trademark Trial and Appeal Board refused to give any weight to the consent, noting that there is no doubt that a likelihood of confusion exists and the consent did not specify how confusion could be avoided.

Writing for the court, Judge Rich first took issue with the Board's "requirement" that, to be persuasive, the consent must show that the goods are different and that the parties' marketing channels will not overlap. He noted that "[c]onsents come in different forms and under circumstances in infinite variety" and are "but one factor to be taken into account with all of the other relevant circumstances bearing on the likelihood of confusion referred to in § 2(d)."<sup>28</sup> In this case, Judge Rich explained, the consent, having been given by a competitor well acquainted with the realities of the marketplace,

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26. *Id.* at 894-95, 175 U.S.P.Q. (BNA) at 168 (emphasis in original). This theme permeated a number of other decisions authored by Judge Rich arising in contexts other than the applicability of consent agreements. See, e.g., *In re The Int'l Nickel Co., Inc.*, 282 F.2d 952, 127 U.S.P.Q. (BNA) 331 (C.C.P.A. 1960) (Rich, J., dissenting) (contending that the cancellation of the registration of NI-TENSYL under Section 8 of the Lanham Act on grounds of non-use, where the evidence showed current use of NI-TENSYLIRON, defeated the basic purposes of the Lanham Act, which are to provide better protection to trademark owners and to make the registration system of greater use to the public); see also *Glenwood Labs., Inc. v. Am. Home Prods. Corp.*, 455 F.2d 1384, 173 U.S.P.Q. (BNA) 19 (C.C.P.A. 1972) (Rich, J., dissenting) (criticizing the majority for adopting a "greater care doctrine" in finding a likelihood of confusion between two marks used on drugs).

I ask the majority and I ask the board how they think their decisions are going to "avoid confusion or mistake in the dispensing of pharmaceuticals."

We are here involved in adjudicating a right to register a trademark in the Patent Office and do not have the slightest concern with dispensing pharmaceuticals or anything connected therewith, such as labeling, advertising, or the like.

*Id.* at 1389, 173 U.S.P.Q. (BNA) at 23.

27. 754 F.2d 996, 224 U.S.P.Q. (BNA) 969 (Fed. Cir. 1985).

28. *Id.* at 999, 224 U.S.P.Q. (BNA) at 971.

together with the other facts,<sup>29</sup> supports reversal of the Board's decision. Quoting from the C.C.P.A.'s decision in *In re E.I. DuPont de Nemours & Co.*,<sup>30</sup> Judge Rich observed that "[a] mere *assumption* that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not."<sup>31</sup>

Two years after *N.A.D.* was decided, the court, per Judge Rich, once again took the Board to task for failing to give effect to the parties' consent agreement.<sup>32</sup> Judge Rich emphasized that the public interest is best served by registering as many marks as possible that are in use so that they are available for search purposes. Section 2(d), Judge Rich noted, should be construed *in pari materia* with the rest of the Lanham Act and the policies that animate the Act.<sup>33</sup> "Those policies were not served by the independent, misguided efforts of the board to take it upon itself to prove facts . . . to establish a case of likelihood of confusion when not asked to do so."<sup>34</sup>

Judge Rich's last decision on the role of the PTO in protecting the public interest and the impact of a consent involved a refusal to register FOUR SEASONS BILTMORE for resort innkeeping services in view of a registration for THE BILTMORE LOS ANGELES for hotel services.<sup>35</sup> The parties entered into a consent agreement that limited applicant's use of the term BILTMORE and the registrant's use of the term FOUR SEASONS and both parties agreed to cooperate and find ways to eliminate or minimize confusion in the event any arose.

In reversing the refusal to register, the court commented as follows:

Believing that its role in enforcing Section 2(d) of the Lanham Act is to second-guess the conclusions of those most familiar with the marketplace, the PTO "is, at times, like a cat watching the wrong

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29. Such other facts included the sophistication of the relevant purchasing public and the cost of the applicant's goods.

30. 476 F.2d 1357, 177 U.S.P.Q. (BNA) 563 (C.C.P.A. 1973). In *DuPont*, Chief Judge Markey, writing for the court, explained that "a naked 'consent' may carry little weight," while "the weight to be given more detailed agreements . . . should be substantial." *Id.* at 1362, 177 U.S.P.Q. (BNA) at 568.

31. *Id.* at 1363, 177 U.S.P.Q. (BNA) at 568.

32. See *Bongrain Int'l (Am.) Corp. v. Delice de France, Inc.*, 811 F.2d 1479, 1 U.S.P.Q.2d (BNA) 1775 (Fed. Cir. 1987).

33. Judge Rich observed that the primary purpose of the Lanham Act is to add federal procedural rights to the common law rights of trademark owners. These procedural rights include prima facie evidence of the validity of the registered mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the mark in commerce. See 15 U.S.C. § 1057(b).

34. *Bongrain*, 811 F.2d at 1485, 1 U.S.P.Q.2d (BNA) at 1779.

35. *In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 26 U.S.P.Q.2d (BNA) 1071 (Fed. Cir. 1993).

rat hole.” The role of the PTO is not, in “deny[ing] registration if it feels there is, by its independent determination, *any* likelihood of confusion of any kind as between the mark sought to be registered and the prior registration, without regard to the desires, opinions or agreements of the owner the prior registration . . .” *In re Nat’l Distillers & Chem. Corp.*, 297 F.2d 941, 948, 132 U.S.P.Q. 271, 277 (C.C.P.A. 1962) (Rich, J., concurring). Rather, the PTO’s role is to protect owners of trademarks by allowing them to register their marks. Denial of registration does not deny the owner of the right to use the mark, and thus, will not serve to protect the public from confusion. “No government could police trademark *use* so as to protect the public from confusion. It must count on the self-interest of trademark owners to do that.” 297 F.2d at 950-51, 132 USPQ at 279.<sup>36</sup>

Judge Rich’s views on the effect of consent agreements represent current PTO practice. Examiners are now directed to give “great weight” to a proper consent agreement and not to interpose their views on the issue of likelihood of confusion where there exists a “credible” consent agreement and, on balance, the other factors do not support a finding of likelihood of confusion.<sup>37</sup> The Trademark Trial and Appeal Board appears to have gotten the message as well.<sup>38</sup>

## II. FUNCTIONALITY

Few, if any, issues of trademark law have evoked as much controversy as the doctrine of functionality. At its core, the functionality doctrine serves the important public purpose of preventing trademark law from being used for anticompetitive purposes.<sup>39</sup> While the purpose of the functionality doctrine may be

36. *Id.* at 1566, 26 U.S.P.Q.2d (BNA) at 1071-72.

37. See TRADEMARK MANUAL OF EXAMINING PROCEDURES, § 1207.01(d)(viii), CONSENT AGREEMENTS (4th ed. 2005).

38. See, e.g., *In re Leiner Health Servs. Corp.*, 2004 TTAB LEXIS 508 (T.T.A.B. Sept. 9, 2004); *In re Sunshine Distribution Inc.*, 2003 TTAB LEXIS 576 (T.T.A.B. Dec. 9, 2003); *In re Masco Corp. of Indiana*, 2002 TTAB LEXIS 288 (T.T.A.B. May 14, 2002).

39. The Supreme Court of the United States, in *Qualitex Co. v. Jacobson Prods. Co., Inc.*, stated that:

The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm’s reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature. It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time . . . after which competitors are free to use the innovation.

514 U.S. 159, 164 (1995). The doctrine of functionality has two branches—utilitarian functionality and aesthetic functionality. Utilitarian functionality focuses on whether the design in issue makes the product work better; aesthetic functionality focuses on whether the design makes the product more attractive from the

simply explained, its application has proven difficult. In a series of decisions, Judge Rich sought to shed light on this issue.

In two decisions issued on the same day—*In re Deister Concentrator Co., Inc.*<sup>40</sup> and *In re Shakespeare Co.*<sup>41</sup>—Judge Rich explained the rationale for denying trademark protection to functional matter. Judge Rich began his opinion in *Deister* by emphasizing that affording trademark protection to functional or utilitarian designs would conflict with patent law and policy, to the extent patent law imposes a number of specific patentability requirements<sup>42</sup> and limits the term of protection.<sup>43</sup> “To give appellant the trademark registration it asks for here would give it a potential perpetual monopoly on the outline shape of its shaking table deck,”<sup>44</sup> Judge Rich declared. He noted that socioeconomic policy encourages competition by all fair means, including the right to copy, except where copying is lawfully prevented by patent or copyright. Judge Rich emphasized that this right to copy is applicable even where the design in issue is distinctive and even where copying gives rise to consumer confusion. As explained by Judge Rich, “[p]ublic acceptance of a functional feature

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standpoint of appearance. While functional designs have long been refused registration, it was not until 1998 that Congress amended the Lanham Act to provide a specific statutory basis—15 U.S.C. § 1052(e)(5)—to refuse to register a mark that “comprises any matter that, as a whole, is functional.” See Trademark Law Treaty Implementation Act, Pub. L. No. 105-330, 15 U.S.C. § 1051 (1998) (formally implementing the aforementioned amendment and others).

40. 289 F.2d 496, 129 U.S.P.Q. (BNA) 314 (C.C.P.A. 1961). *Deister* involved an application to register the rhomboidal design of a coal cleaning table. While there was evidence that such design was recognized by the trade as applicant’s goods, the application was refused on grounds of functionality. The examiner noted that the rhomboidal design was selected to increase production and efficiency of the applicant’s coal cleaning tables. The Trademark Trial and Board affirmed the refusal to register.

41. 289 F.2d 506, 129 U.S.P.Q. (BNA) 323 (C.C.P.A. 1961). *Shakespeare* involved an application to register a continuous spiral marking formed in relief on the surface of and extending for substantially one full length of a fishing rod. The evidence established that the marking was the result of the practice of a patented process. In upholding the refusal to register, the C.C.P.A. cited *Deister* and noted that:

Were the spiral marking to be treated as a trademark the holder of the trademark rights would have a potentially perpetual monopoly which would enable it either to prevent others from using the process which results in the mark or force them to go to the trouble and expense of removing it.

*Id.* at 508, 129 U.S.P.Q. (BNA) at 325.

42. Under the patent statute, an invention may not be patented if it does not consist of patentable subject matter, is not novel, is obvious, or does not meet the written description, enablement, or best mode requirements. See 35 U.S.C. §§ 101, 102, 103, and 112 (providing the basic requirements for and conditions of obtaining a patent).

43. Under 35 U.S.C. § 154(a)(2), the term of a patent, in general, begins on the date of issuance and ends twenty years from the date on which the application was filed.

44. *Deister*, 289 F.2d at 499, 129 U.S.P.Q. (BNA) at 318.

as an indication of source is . . . not determinative of right to register. Preservation of freedom to copy ‘functional’ features is the determining factor.”<sup>45</sup>

Upon review of the evidence, the court concluded that the design in issue was functional because it provided for a number of engineering efficiencies, including saving of floor space. The court emphasized that it was not denying registration merely because the design possessed utility but, rather, because the shape was, “in essence,” utilitarian.<sup>46</sup>

The principles set forth above were summarized by Judge Rich in *Deister* through reference to what he referred to in his opinion as trademark “truisms”:

- (1) Trademarks enable one to determine the existence of common source; but not everything that enables one to determine source is a trademark.
- (2) A trademark distinguishes one man’s goods from the goods of others; but not everything that enables goods to be so distinguished will be protected as a trademark.
- (3) Some trademarks are words or configurations that are protected because they have acquired a “secondary meaning”; but not every word or configuration that has a de facto “secondary meaning” is protected as a trademark.
- (4) A feature dictated solely by “functional” (utilitarian) considerations may not be protected as a trademark; but mere possession of a function (utility) is not sufficient reason to deny protection.<sup>47</sup>

Writing for the majority several years later in *Best Lock Corp. v. Schlage Lock Co.*,<sup>48</sup> Judge Rich amplified on the fourth truism. He noted that such truism reflects the obvious fact that some articles, made in a purely arbitrary configuration (e.g., the shape of a bottle of COCA-COLA®), may perform a function, which could equally well be served by other shapes, and in such circumstances the incidental function should not by itself preclude trademark protection. On the other hand, where the configuration in issue provides a functional advantage, such configuration is not registrable as a mark. “The reason is clear. If a configuration is functional in that sense, then everyone has the right to use the configuration for its functional

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45. *Id.* at 504, 129 U.S.P.Q. (BNA) at 322.

46. *Id.* at 506, 129 U.S.P.Q. (BNA) at 323.

47. *Id.* at 502, 129 U.S.P.Q. (BNA) at 320.

48. 413 F.2d 1195, 162 U.S.P.Q. (BNA) 552 (C.C.P.A. 1969).

purpose, subject only to such exclusive right for a *limited* time as *may* exist under the patent laws.”<sup>49</sup>

Judge Rich, in *Best Lock*, also discussed the weight to be accorded to the existence of a utility patent that discloses the configuration in issue. Judge Rich noted that the court, in *In re Shenango*,<sup>50</sup> held that a utility patent is only “some evidence” as to functionality, recognizing that a patent may not be evidence of functionality in regard to things of a purely “arbitrary” or “mere design” nature that happen to be disclosed in the patent but that are not attributed to any functional significance therein.<sup>51</sup>

In his concurring opinion in *In re Mogen David Wine Corp.*,<sup>52</sup> in which the court reversed<sup>53</sup> the refusal to register the shape of a decanter bottle, Judge Rich further amplified on the policy justifications for the functionality doctrine and distinguished the

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49. *Id.* at 1199, 162 U.S.P.Q. (BNA) at 555.

50. 362 F.2d 287, 150 U.S.P.Q. (BNA) 115 (C.C.P.A. 1966).

51. *Id.* at 292, 150 U.S.P.Q. (BNA) at 119. Thirty-five years later, the Supreme Court of the United States essentially agreed. In *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 29 (2001), the Court held:

A utility patent is strong evidence that the features therein claimed are functional. If trade dress protection is sought for those features the strong evidence of functionality based on the previous patent adds great weight to the statutory presumption that features are deemed functional until proved otherwise by the party seeking trade dress protection. Where the expired patent claimed the features in question, one who seeks to establish trade dress protection must carry the heavy burden of showing that the feature is not functional, for instance, by showing that it is merely an ornamental, incidental, or arbitrary aspect of the device.

Under 15 U.S.C. § 1125 (a) (3), in a civil action for trade dress infringement for trade dress that is not the subject of a federal registration, the person who asserts trade dress protection has the burden of establishing that the trade dress is not functional. *See* 15 U.S.C. § 1125 (2006).

52. 328 F.2d 925, 140 U.S.P.Q. (BNA) 575 (C.C.P.A. 1964).

53. The Trademark Trial and Appeal Board, noting that the applied-for design was the subject of a design patent, held, as a matter of law, that the design was not eligible for registration on the Principal Register. In reversing, the C.C.P.A. held that “registration as a design and registration as a trademark are not mutually exclusive, and it is not a fatal objection to an application to register something that is claimed as a trademark that the subject matter of the application is capable of being registered as a design.” 328 F.2d at 929, 140 U.S.P.Q. (BNA) at 578. *Accord In re Honeywell, Inc.*, 497 F.2d 1344, 1348, 181 U.S.P.Q. (BNA) 821 (C.C.P.A. 1974) (Rich, J., concurring). According to the majority:

Federal design patent laws were created to encourage the invention of ornamental designs. Federal trademark laws, which are independent in origin from the design patent laws, seek to prevent the public from encountering confusion, mistake, and deception in the purchase of goods and services and to protect the integrity of the trademark owner’s product identity. With that distinction in mind, this court decided that the public interest . . . must prevail over any alleged extension of design patent rights, when a trademark is non-functional and does in fact serve as a means to distinguish the goods of the trademark owner from those of others.

497 F.2d at 1348, 181 U.S.P.Q. (BNA) at 824.

instant case from *Deister*. He contended that the crux of the matter in determining whether or not a product design or configuration is or is not functional is whether competition would in fact be hindered. If so, then the design is functional and unprotectable under trademark law. If not, then the design is nonfunctional and may be subject to trademark protection.<sup>54</sup> In responding to the Solicitor's argument that the existence of a design patent is evidence of ornamental function, Judge Rich noted that "even if we assume some value behind the specific design in an aesthetic sense, it is not in the least essential to use it in order to have a fully functioning bottle or an attractive bottle . . . ."<sup>55</sup> In contrast, Judge Rich observed that in *Deister*, use of the shape was essential to the enjoyment of the engineering advantages realized through the use of the shape.<sup>56</sup>

Judge Rich's decision for the court in *In re Morton-Norwich Products, Inc.*,<sup>57</sup> is a frequently cited<sup>58</sup> opinion on the issue of functionality. The case involved an appeal from a refusal to register the configuration of a container. After reiterating that the genesis of the functionality doctrine is the right to compete through imitation of a competitor's product, Judge Rich noted that an exception to such a right to copy exists where the design is nonfunctional and distinctive, even though such design is not protected by patent or copyright law. "Thus, when a design is 'nonfunctional,' the right to compete through imitation gives way, presumably upon balance of that right with the originator's right to prevent others from infringing upon an established symbol of trade identification."<sup>59</sup>

Judge Rich then elaborated upon his earlier-stated distinction between designs that have utility and designs that are utilitarian; the former of which may be the subject of trademark protection and the latter of which may not.<sup>60</sup> Judge Rich coined the term "de facto

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54. It "may be" subject to trademark protection because the design or configuration must be distinctive in order to be eligible for trademark protection. In *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (2000), the Supreme Court held that a product's design is protectable under the trademark law only if it has acquired distinctiveness or secondary meaning.

55. *Mogen David*, 328 F.2d at 933, 140 U.S.P.Q. (BNA) at 582.

56. 289 F.2d at 498, 129 U.S.P.Q. (BNA) at 317.

57. 671 F.2d 1332, 213 U.S.P.Q. (BNA) 9 (C.C.P.A. 1982).

58. As of February 2007, *Morton-Norwich Products* was cited positively nearly 100 times in subsequent cases.

59. *Morton-Norwich Prods.*, 671 F.2d at 1337, 213 U.S.P.Q. (BNA) at 12.

60. Judge Rich noted that some early C.C.P.A. cases, including *In re Dennison Mfg. Co.*, 39 F.2d 720, 5 U.S.P.Q. (BNA) 316 (C.C.P.A. 1930), held that a configuration that possessed utility is not the subject of trademark protection. This broad statement of the law, Judge Rich declared, "is incorrect and inconsistent with later pronouncements." *Morton-Norwich Prods.*, 671 F.2d at 1338, 213 U.S.P.Q. (BNA) at 13.

functionality” to refer to those designs that perform a function, i.e., possess utility, and the term “de jure functionality” to refer to those designs that are utilitarian. He then clarified that in determining whether a design is functional, the inquiry must focus on the design of the thing under consideration and not the thing itself,<sup>61</sup> as well as the degree of design utility. In sum, Judge Rich declared, “‘utilitarian’ means ‘superior in function (de facto) or economy of manufacture,’ which ‘superiority’ is determined in light of competitive necessity to copy.”<sup>62</sup>

*Morton-Norwich* is most often cited for Judge Rich’s articulation of the factors relevant to a determination of functionality. According to Judge Rich, in determining whether a particular design is “superior,” courts may focus on: (1) the existence of an expired utility patent that discloses the utilitarian advantage of the design sought to be protected, (2) whether the owner of the design touts its utilitarian advantages in advertising, (3) the existence of other alternatives to the design in issue, and (4) whether the design results from a comparatively simple or cheap method of manufacture.<sup>63</sup>

While Judge Rich’s decision in *Morton-Norwich* has been cited approvingly and followed by a number of federal courts of appeals,<sup>64</sup>

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61. *Id.* at 1338-39, 213 U.S.P.Q. (BNA) at 13. Judge Rich characterized this principle as the first addition to the *Deister* truisms.

62. *Id.* at 1339, 213 U.S.P.Q. (BNA) at 14.

63. *Id.* at 1340-41, 213 U.S.P.Q. (BNA) at 15-16. Upon review of the evidence, the court concluded that the design was not dictated by the functions to be performed and that the design did not result in a functionally or economically superior container; thus, the refusal to register on grounds of functionality was reversed. The case was remanded for consideration of the issue of whether the design was either inherently distinctive or had acquired distinctiveness. Judge Rich noted that a nondistinctive design does not necessarily equal a “functional” design and labeled this proposition the second addition to the *Deister* truisms. In *In re R.M. Smith, Inc.*, 734 F.2d 1482, 222 U.S.P.Q. (BNA) 1 (Fed. Cir. 1984), Judge Rich held that the fact that a design was the subject of a design patent, while some evidence of nonfunctionality, does not, without more, establish distinctiveness or recognition as a trademark.

64. See, e.g., *Sunbeam Prods. v. W. Bend Co.*, 123 F.3d 246, 255, 44 U.S.P.Q.2d (BNA) 1161, 1168 (5th Cir. 1997) (“[T]his court has adopted the ‘utilitarian’ standard of functionality, which focuses on the protection of competition.”); *Merchant & Evans, Inc. v. Roosevelt Bldg. Prods. Co.*, 963 F.2d 628, 633, 22 U.S.P.Q.2d (BNA) 1730, 1733 (3d Cir. 1992) (“The rationale for the functionality limitation on trade dress protection ‘has its genesis in the judicial theory that there exists a fundamental right to compete through imitation of a competitor’s product, which right can only be temporarily denied by the patent or copyright laws.’”); *Clamp Mfg. Co. v. Enco Mfg. Co.*, 870 F.2d 512, 516, 10 U.S.P.Q.2d (BNA) 1226, 1229 (9th Cir. 1989) (“The requirement of functionality is based ‘on the judicial theory that there exists a fundamental right to compete through imitation of a competitor’s product, which right can only be temporarily denied by the patent or copyright laws.’”); *Stormy Clime Ltd. v. Progroup, Inc.*, 809 F.2d 971, 977, 1 U.S.P.Q.2d (BNA) 2026, 2026 (2d Cir. 1987) (the functionality inquiry “should have focused on whether bestowing trade dress protection upon [a particular] arrangement of

the Supreme Court's decision in *Traffix* casts doubt on the role of competitive need or necessity in the functionality analysis, at least in cases before the federal district courts.<sup>65</sup>

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features 'will hinder competition or impinge upon the rights of others to compete effectively in the sale of goods'); *W.T. Rogers v. Keene*, 778 F.2d 334, 339, 228 U.S.P.Q.2d (BNA) 145, 147 (7th Cir. 1985) ("Ornamental, fanciful shapes and patterns are not in short supply, so appropriating one of them to serve as an identifying mark does not take away from any competitor something that he needs in order to make a competing brand. But if the feature is not ornamental or fanciful or whimsical or arbitrary, but is somehow intrinsic to the entire product consisting of the manufacturer's brand and his rivals' brands, the protection will be denied. The name of this principle is 'functionality', on which see, e.g. *In re Morton-Norwich* . . .").

65. The Supreme Court, in its decision in *Traffix*, *supra* note 51 and accompanying text, held that whether a particular design is a competitive necessity does not represent a comprehensive definition of functionality. The Court referred to its earlier decision in *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850 n.10 (1982), in which it held that, "[i]n general terms, a product feature is functional, and cannot serve as a trademark, 'if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.'" *Traffix*, 532 U.S. at 32. According to the Court in *Traffix*, "[w]here the design is functional under the *Inwood* formulation there is no need to proceed further to consider if there is a competitive necessity for the feature." However, the Court also held that it is proper to inquire into competitive necessity in cases of aesthetic, as opposed to utilitarian, functionality. See Mark Alan Thurmon, *The Rise and Fall of Trademark Law's Functionality Doctrine*, 56 FLA. L. REV. 243 (2004) (criticizing the Court for abandoning the competitive need test). However, in *Valu-Engineering Inc. v. Rexnord Corp.*, the first post-*Traffix* case decided by the Federal Circuit, the court held that:

We do not understand the Supreme Court's decision in *Traffix* to have altered the *Morton-Norwich* analysis . . . [T]he *Morton-Norwich* factors aid in the determination of whether a particular feature is functional, and the third factor focuses on the availability of "other alternatives" . . . . We did not in the past under the third factor require that the opposing party establish that there was a "competitive necessity" for the product feature. Nothing in *Traffix* suggests that consideration of alternative designs is not properly part of the overall mix, and we do not read the Court's observations in *Traffix* as rendering the availability of alternative designs irrelevant. Rather, we conclude that the Court merely noted that once a product feature is found functional based on other considerations there is no need to consider the availability of alternative designs, because the feature cannot be given trade dress protection merely because there are alternative designs available. But that does not mean that the availability of alternative designs cannot be a legitimate source of evidence to determine whether a feature is functional in the first place.

278 F.3d 1268, 1276 (Fed. Cir. 2002). The Trademark Trial and Appeal Board also continues to follow and apply *Morton-Norwich*. See, e.g., *In re N.V. Organon*, 79 U.S.P.Q.2d (BNA) 1639 (T.T.A.B. 2006) ("The *Morton-Norwich* factors provide a framework with which to evaluate the evidence relating to functionality."); *In re Bose Corp.*, 2005 TTAB LEXIS 293 (T.T.A.B. 2005) ("For more than two decades, this Board and our reviewing Court have applied the '*Morton-Norwich*' factors when determining whether a particular product design is functional."); *In re Backflow Prevention Device Inspections, Inc.*, 2004 TTAB LEXIS 539 (T.T.A.B. 2004) (after citing *Traffix*, the Board applied the *Morton-Norwich* factors).

## III. TRADEMARK SUBJECT MATTER

Writing for the C.C.P.A. in *In re Cooper*,<sup>66</sup> Judge Rich held that the title of a single book cannot be a trademark, even if the mark consists of a coined term, in this case, TEENY-BIG. Judge Rich reasoned that however arbitrary, the title of a book nevertheless describes the book. “How else,” he asked, “would you describe it—what else would you call it?”<sup>67</sup>

Judge Rich also cited policy considerations in refusing registration of the title of a book. He noted:

The protection accorded the property right in a trademark is not limited in time and endures for as long as the trademark is used. A book, once published, is protected against copying only if it is the subject of a valid copyright registration and then only until the registration expires, so eventually all books fall into the public domain. The right to copy which the law contemplates includes the right to call the copy by the only name it has and the title cannot be withheld on any theory of trademark right therein.<sup>68</sup>

While the title of a single book is not registrable, Judge Rich declared, the title of a book series may be registrable. He explained that the name of a series has a trademark function in indicating that each book of the series comes from a single source.<sup>69</sup>

Judge Rich took a much more expansive approach to the issue of trademark subject matter in his opinion for the court in *In re Tobias Kotzin*.<sup>70</sup> The applicant in that case sought to register a cloth label of elongated rectangular or oblong shape sewed to trousers at a

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66. 254 F.2d 611, 117 U.S.P.Q. (BNA) 396 (C.C.P.A. 1958).

67. *Id.* at 615, 117 U.S.P.Q. (BNA) at 400.

68. *Id.* at 616, 117 U.S.P.Q. (BNA) at 400. *Cooper* was decided prior to January 1, 1978, the effective date of the Copyright Act of 1976, which provides that copyright protection subsists upon fixation of an original work of authorship in a tangible medium of expression. See 17 U.S.C. § 102(a). *Cooper* was cited approvingly by the Federal Circuit in *Herbko Int'l, Inc. v. Kappa Books*, 308 F.3d 1156, 64 U.S.P.Q.2d (BNA) 1375 (Fed. Cir. 2002). The *Herbko* court held that a trademark in the title of a single book “would compromise the policy of unrestricted use after expiration of the copyright because a book with a trademarked title . . . could be published only under a different title.” *Id.* at 1164, 64 U.S.P.Q.2d (BNA) at 1380. Professor McCarthy has criticized the *Cooper* decision.

While the PTO refuses to register titles of single literary works, such as movies, the courts have traditionally protected such titles from infringement under the common law of unregistered marks. The better view is expressed in the litigation cases, which will protect a single work title upon acquisition of secondary meaning. This lack of congruence between registration and court enforcement impairs the ability of the federal register to reflect the reality of the marketplace.

2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION, § 10:4.1.

69. *Cooper*, 254 F.2d at 611, 117 U.S.P.Q. (BNA) at 400.

70. 276 F.2d 411, 125 U.S.P.Q. (BNA) 347 (C.C.P.A. 1960).

particular location. The label included the mark PEGGER but the application did not cover use of such mark. In upholding the refusal to register, the Assistant Commissioner held that the distinctive location of a label is not a word, name, symbol or device adopted and used by one merchant to identify his goods and distinguish them from others,<sup>71</sup> within the meaning of Section 45 of the Lanham Act.<sup>72</sup>

Judge Rich concluded, however, that the applied-for mark *could* be registered, although he found the evidence presented in support of registration lacking. He held that the Section 45 definition of the term “trade-mark” was not intended to restrict registrable marks to those falling within the terms “word,” “name,” “symbol,” or “device.” Although a location per se may not be registered, he remarked, a particular tag particularly located on particular goods may be.<sup>73</sup>

The slogan “The Weiner the World Awaited,” as used for bacon, was held registrable by Judge Rich in *In re E. Kahn’s Sons Co.*<sup>74</sup> The examiner refused registration on grounds that the mark is used only to call attention to the wieners sold by the applicant and did not identify the applicant’s bacon.

Judge Rich, in reversing the refusal, noted that Section 45 of the Lanham Act, in providing that a mark must be used so as “to identify his goods,” only requires that the mark identify the goods as his, not that the mark identifies the goods. “In other words, the requirement is not that a trademark identify what goods are but where they come from.”<sup>75</sup> In this case, Judge Rich noted, the specimens of record<sup>76</sup> indicate that the slogan identifies the bacon as from the applicant and also serves to distinguish that bacon from bacon made and sold by others.

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71. *Ex parte Kotzin*, 1956 WL 7062, 7062 (Com’r Pat. & Trademarks), 111 U.S.P.Q. (BNA) 161 (1956).

72. 15 U.S.C. § 1127.

73. Judge Rich’s decision in *Kotzin* was relied upon in finding that LEVI’s pocket tab is a protectable mark. *See* *Levi Strauss & Co. v. Blue Bell, Inc.*, 1978 WL 21731, 200 U.S.P.Q. (BNA) 434 (N.D. Cal. 1978), *aff’d*, 632 F.2d 817, 208 U.S.P.Q. (BNA) 713 (9th Cir. 1980).

74. 343 F.2d 475, 145 U.S.P.Q. (BNA) 215 (C.C.P.A. 1965).

75. *Id.* at 476, 145 U.S.P.Q. (BNA) at 216.

76. *See id.* at 476, 145 U.S.P.Q. (BNA) at 216 (listing as specimens a point of sale poster showing bacon slices stacked together and bacon cooked, the words “Hickory-Smoked BACON,” and the slogan “The Weiner the World Awaited” immediately below the word “BACON” and preceded by the words “Another ‘first’ from Kahn’s—home of”).

## IV. GENERIC/"SO HIGHLY DESCRIPTIVE" TERMS

Judge Rich's decision in *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*<sup>77</sup> provides the starting point for virtually all PTO decisions on the issue of genericness.<sup>78</sup> *Marvin Ginn* involved a petition to cancel the registration for "Fire Chief," as used for a magazine directed to the field of fire-fighting. The Trademark Trial and Appeal Board found that "Fire Chief" designates a very particular and definable target audience for the magazine and, thus, is generic.<sup>79</sup>

Judge Rich began his analysis by referring to the classic formulation of the test for genericness in Judge Learned Hand's decision in *Bayer Co. v. United Drug Co.*: "[t]he single question, as I view it, in all these cases, is merely one of fact: what do the buyers understand by the word for whose use the parties are contending?"<sup>80</sup> Judge Rich then noted that a recent amendment to the Lanham Act<sup>81</sup> had clarified that it is the "primary significance of the registered mark to the relevant public"<sup>82</sup> that governs whether a term is generic.

Determining whether a term is generic, Judge Rich remarked, thus requires a two-step inquiry: (1) what is the genus of the goods or services in issue,<sup>83</sup> and (2) is the term in issue understood by the

77. 782 F.2d 987, 228 U.S.P.Q. (BNA) 528 (Fed. Cir. 1986).

78. See, e.g., *In re DNI Holdings Ltd.*, 2005 WL 3492365, 77 U.S.P.Q.2d (BNA) 1435 (T.T.A.B. 2005) (deeming SPORTSBETTING.COM for providing of on-line casino games to be generic); *In re A la Veille Russie, Inc.*, 2001 WL 862510, 60 U.S.P.Q.2d (BNA) 1895 (T.T.A.B. 2001) (deeming the term RUSSIANART for fine art dealership services to be generic); *In re Mgmt. Recruiters Int'l Inc.*, 1986 WL 83299, 1 U.S.P.Q.2d (BNA) 1079 (T.T.A.B. 1986) (deeming SALES CONSULTANTS for employment agency services not to be generic).

79. *Int'l Ass'n of Fire Chiefs, Inc. v. H. Marvin Ginn Corp.*, 1985 WL 72026, 225 U.S.P.Q. (BNA) 940 (T.T.A.B. 1985). Generic terms are those that identify a certain product, as opposed to one specific producer, and are therefore not subject to trademark protection. Descriptive marks, on the other hand, are subject to protection upon proof that the mark identifies source, i.e., has achieved secondary meaning.

80. *Marvin Ginn*, 782 F.2d at 989, 228 U.S.P.Q. (BNA) at 530 (quoting *Bayer Co. v. United Drug Co.*, 272 F. 505, 509 (S.D.N.Y. 1921)).

81. See Act of Nov. 8, 1984, Pub. L. No. 98-620, 98 Stat. 3335, 5718-27 (1984).

82. *Marvin Ginn*, 782 F.2d at 989, 228 U.S.P.Q. (BNA) at 530 (quoting 15 U.S.C.A. § 1064(c)).

83. This factor is often outcome-determinative. The broader the genus is defined, the less likely that the term in issue will be found generic. Conversely, the narrower the genus, the more likely the term will be found generic. See, e.g., *In re Boston Beer Co.*, 47 U.S.P.Q.2d (BNA) 1914, 1919 (T.T.A.B. 1998) (reversing a refusal to register THE BEST BEER IN AMERICA on grounds of genericness by rejecting the contention that the genus is "beers brewed in America that have won taste competitions or were judged best in taste tests" as opposed to what was set forth in the application, to wit, "beverages, namely beer and ale"). Professor McCarthy has suggested that the definition of "relevant product market" under the antitrust laws be applied in defining "genus" for purposes of a genericness analysis. 4 MCCARTHY, § 12.24

relevant public primarily to refer to that genus of goods or services.<sup>84</sup> In this case, he said, the genus is magazines directed to the field of fire-fighting and the evidence does not establish that the relevant public refers to a class of fire-fighting magazines as “Fire Chief.”<sup>85</sup> Thus, the court concluded, while FIRE CHIEF may be descriptive, it is not generic.<sup>86</sup>

The decision of the C.C.P.A., including Judge Rich’s concurrence, in *In re Sun Oil Co.*<sup>87</sup> injected much doctrinal confusion into the law. Sun Oil applied to register CUSTOM-BLENDED for gasoline. The examiner refused registration on the ground that CUSTOM-BLENDED is “so highly descriptive” of applicant’s blended gasoline product that it is incapable of becoming distinctive.<sup>88</sup> In affirming the refusal of registration, the Trademark Trial and Appeal Board noted that while the generic terms for applicant’s blended gasoline are “pump-blended” and “multi-grade gasoline,” there is no question that CUSTOM-BLENDED will immediately indicate to the public that the various grades of gas dispensed are custom-blended to their needs and requirements and that, as a result, such a term could be registered only upon proof of acquired distinctiveness.<sup>89</sup> In other words, the Board held CUSTOM-BLENDED merely descriptive, as

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84. *Marvin Ginn*, 782 F.2d at 990, 228 U.S.P.Q. (BNA) at 530.

85. *Id.* at 991, 228 U.S.P.Q. (BNA) at 532.

86. *Id.* 228 U.S.P.Q. (BNA) at 532. The distinction is important because while a generic term is not subject to trademark protection, a descriptive term may be protected under the trademark laws upon proof of acquired distinctiveness or secondary meaning. See *Marvin Ginn*, 782 F.2d at 989, 228 U.S.P.Q. at 530 (“A generic term is the common descriptive name of a class of goods or services, and, while it remains such common descriptive name, it can never be registered as a trademark because such a term is ‘merely descriptive’ within the meaning of § 2(e)(1) and is incapable of acquiring de jure distinctiveness under § 2(f).”). In *Gicena Ltd. v. Columbia Telecomms. Group*, 900 F.2d 1546, 14 U.S.P.Q.2d (BNA) 1401 (Fed. Cir. 1990), in ruling on a question of first impression in the Second Circuit (the case was appealed to the Federal Circuit because, in addition to presenting a claim under the Lanham Act, the complaint also alleged design patent infringement), Judge Rich rejected the theory of “secondary meaning in the making.” The purpose of such theory is to protect a plaintiff who has spent money to create a secondary meaning, but has not yet succeeded, from those who attempt to usurp whatever goodwill the plaintiff has established. Judge Rich noted, however, that “[t]o allow a plaintiff to succeed on the theory of secondary meaning in the making would undermine the entire purpose of the secondary meaning requirement: to show that the public associates the product with a source rather than with the product itself.” *Id.* at 1550, 14 U.S.P.Q.2d (BNA) at 1405. Judge Rich’s view proved prescient as the Second Circuit, in *Laureyssens v. Idea Group, Inc.*, 964 F.2d 131, 22 U.S.P.Q.2d 1811 (2d Cir. 1992), also rejected the doctrine of secondary meaning in the making.

87. 426 F.2d 401, 165 U.S.P.Q. (BNA) 718 (C.C.P.A. 1970).

88. *Id.* at 402, 165 U.S.P.Q. (BNA) at 718.

89. 155 U.S.P.Q. (BNA) 600 (T.T.A.B. 1967).

opposed to generic. The C.C.P.A. affirmed based on the opinion of the Board.<sup>90</sup>

In his concurring opinion, Judge Rich held that registration should be refused even if there was evidence of acquired distinctiveness or secondary meaning.<sup>91</sup> In Judge Rich's opinion, CUSTOM-BLENDED is "so highly descriptive" that it cannot be protected.

Whether a mark may be denied registration because it is "so highly descriptive" as to be incapable of serving as a mark appears to be an open question today. Under prevailing case law, marks may be classified into a number of categories, including arbitrary, suggestive, descriptive, and generic.<sup>92</sup> The Lanham Act does not provide for refusals to register based on a finding that a mark is "so highly descriptive" as to be incapable. There is no category in between descriptive and generic.<sup>93</sup> However, the Federal Circuit, in a decision issued several months after Judge Rich's death, appears to have revived the "so highly descriptive" categorization as a ground of refusal.<sup>94</sup>

#### V. CONCURRENT USE

One of the most problematic issues in trademark law is determining the respective rights of concurrent users of the same or similar marks in different parts of the country. Judge Rich explored

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90. 426 F.2d at 403, 165 U.S.P.Q. (BNA) at 719.

91. Under such circumstances, Judge Rich held that such evidence would merely constitute "de facto" (as opposed to de jure) secondary meaning and, as a matter of law, could not support registration. 426 F.2d at 403, 165 U.S.P.Q. (BNA) at 719 (Rich, J., concurring). Judge Fisher (sitting by designation) dissented, finding that the evidence of secondary meaning established that CUSTOM-BLENDED is registrable. *Id.* at 404, 165 U.S.P.Q. (BNA) at 720 (Fisher, J., dissenting).

92. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9, 189 U.S.P.Q. (BNA) 759, 764 (2d Cir. 1976) ("The cases. . . identify four different categories of terms with respect to trade-mark protection.").

93. *See In re Women's Publ'g Co.*, 23 U.S.P.Q.2d (BNA) 1876, 1877 n.2 (T.T.A.B. 1992) ("The Examining Attorney's refusal that applicant's mark is 'so highly descriptive that it is incapable of acting as a trademark' is not technically a statutory ground of refusal."); *see also* TRADEMARK MANUAL OF EXAMINING PROCEDURES, § 1209.01(c)(ii), TERMINOLOGY (4th ed. 2005) (stating use of the "so highly descriptive that it is incapable of acting as a trademark" language "may lead to confusion and should be avoided").

94. *See In re Boston Beer Co.*, 198 F.3d 1370, 1373-74, 53 U.S.P.Q.2d (BNA) 1056, 1058 (Fed. Cir. 1999) (upholding a refusal to register THE BEST BEER IN AMERICA mark because it is "so highly laudatory and descriptive . . . that the slogan does not and could not function as a trademark . . ."). Interestingly, the decision of the Trademark Trial and Appeal Board in the *Boston Beer* case was careful to hold that it was "not resurrecting the discredited notion that a term can be the 'apt descriptive name' for a product, and, therefore be 'so highly descriptive as to be unregistrable.'" 47 U.S.P.Q.2d (BNA) 1914, 1920 (T.T.A.B. 1998) (citing *In re K-T Zoe Furniture Inc.*, 16 F.3d 398, 29 U.S.P.Q.2d (BNA) 1787 (Fed. Cir. 1994); *In re Rickett & Colman, N. Am., Inc.*, 18 U.S.P.Q.2d (BNA) 1389 (T.T.A.B. 1991)).

this issue in his opinion for the court in *Weiner King, Inc. v. The Wiener King Corp.*<sup>95</sup> The facts are rather convoluted: Wiener King first used the mark WIENER KING in 1962 at restaurants located in Flemington, New Jersey, but did not apply for federal registration until May 1975.<sup>96</sup> A North Carolina company, Wiener King Corp. (“WKNC”), began using the WIENER KING mark in 1970 in North Carolina in connection with restaurant services. At the time it adopted its mark, WKNC did not know of Wiener King and, in May 1972, WKNC obtained registrations for its marks. WKNC learned of Wiener King’s use of the WEINER KING mark in July 1972 and subsequent thereto expanded its operations throughout the United States, including New Jersey. Wiener King petitioned to cancel WKNC’s registrations and filed territorially unrestricted applications to register the mark WEINER KING. Wiener King then sued WKNC for trademark infringement. The district court granted Wiener King a preliminary injunction barring WKNC from using its mark within twenty miles of Wiener King’s restaurants and also ordered the cancellation of WKNC’s registrations.<sup>97</sup> The Trademark Trial and Appeal Board, thereafter, granted Wiener King’s petitions to cancel to the extent that WKNC’s registrations were restricted to exclude Wiener King’s trading area.<sup>98</sup> The Board also recommended that Wiener King’s applications be denied unless they were amended to reflect an area of right to use within a fifteen-mile radius of Flemington, New Jersey.<sup>99</sup>

Applying equitable and common law trademark principles, as well as the policy and substance of the Lanham Act, the C.C.P.A, per Judge Rich, affirmed the decision of the Trademark Trial and Appeal Board. Under the Tea Rose/Rectanus doctrine,<sup>100</sup> Judge Rich noted, each party has the right to use its mark in its own initial area of use. The case was made more complicated, he pointed out, by the fact

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95. 615 F.2d 512, 204 U.S.P.Q. (BNA) 820 (C.C.P.A. 1980).

96. *Id.* at 515, 204 U.S.P.Q. (BNA) at 823.

97. 407 F. Supp. 1274, 190 U.S.P.Q. 469 (D.N.J. 1976). *But see* *Weiner King, Inc. v. The Wiener King Corp.*, 192 U.S.P.Q. (BNA) 353 (3d Cir. 1976) (modifying the injunction to bar WKNC from using its mark within fifteen miles of Flemington, New Jersey).

98. *Weiner King, Inc. v. The Wiener King Corp.*, 201 U.S.P.Q. (BNA) 894 (T.T.A.B. 1976).

99. *Id.* at 917.

100. Under the so-called Tea Rose/Rectanus doctrine, a good faith junior user of a mark in a remote geographical area from that occupied by the senior user may establish priority over a senior user’s claim to the mark in the junior user’s area. The doctrine is named after two early Supreme Court decisions, *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403 (1916), and *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90 (1918).

that, while WKNC was the junior user and an innocent adopter, it was nevertheless the first to register the mark and it expanded its use after learning of Weiner King's prior use. Weiner King contended that the fact that WKNC expanded even though it knew of Weiner King's prior user should bar it from being recognized as a concurrent user in any areas entered after notice. Judge Rich disagreed:

It is said that nature abhors a vacuum. The same may be said of equity; it must operate in a factual environment. The TTAB had the task of balancing the equities between a prior user who remained content to operate a small, locally-oriented business with no apparent desire to expand, and who, until recently, declined to seek the benefits of Lanham Act registration, and a subsequent user, whose expressed purpose has been, from its inception, to expand into a nationwide franchising operation, and who has fulfilled its purpose, taking advantage of Lanham Act registration in the process.

[\* \* \*]

The only basis urged by Weiner King for absence of good faith on the part of WKNC is the fact that WKNC expanded out of North Carolina with notice of Weiner King's existence and use of the WEINER KING mark. We hold that this reason is legally insufficient to support a finding of bad faith . . . . While an attempt to "palm off," or a motive to 'box in' a prior user by cutting into its probable area of expansion, each necessarily flowing from knowledge of the existence of the prior user, might be sufficient to support a finding of bad faith, *mere knowledge of the existence of the prior user* should not, by itself, constitute bad faith.<sup>101</sup>

Judge Rich also deemed it significant that WKNC was the first to register the mark. Public policy is advanced in encouraging prompt registration of marks, he remarked, quoting from the court's opinion in *In re Beatrice Foods Co.*:

Where the prior user does not apply for a registration before registration is granted to another, there may be valid grounds, based on a policy of rewarding those who first seek federal registration, and a consideration of the rights created by the existing registration, for limiting his registration to the area of actual use and permitting the prior registrant to retain the nationwide protection of the act restricted only by the territory of the prior user.<sup>102</sup>

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101. *Weiner King*, 615 F.2d at 522, 204 U.S.P.Q. (BNA) at 829.

102. *Id.* at 523-24, 204 U.S.P.Q. (BNA) at 830 (quoting from *In re Beatrice Foods Co.*, 429 F.2d 466, 474 n.13, 166 U.S.P.Q. (BNA) 431, 436 n.13 (C.C.P.A. 1970)).

## VI. "DAMAGE"

Under Section 13 of the Lanham Act,<sup>103</sup> an opposition may be filed by any person who believes he would be "damaged" by the registration of the mark on the principal register. In his decision in *Otto Roth & Co. v. Universal Foods Corp.*,<sup>104</sup> Judge Rich explained that the concept of damage is tied to the grounds upon which the opposer asserts damage. He noted, for example, that in an opposition based on the allegation that the published mark is merely descriptive, any use by the opposer may be sufficient to preclude registration. Under such circumstances, the opposer is trying to prevent a claim of exclusive ownership of the mark, asserting a privilege that the opposer holds in common with all others to the free use of the language.

However, Judge Rich continued, in an opposition based on Section 2(d) of the Lanham Act,<sup>105</sup> the opposer is attempting to protect his individual rights. In this situation, Judge Rich declared, the opposer must prove he has proprietary rights in the term he relies upon to establish a likelihood of confusion.<sup>106</sup>

In *Otto Roth*, the basis of the opposition was likelihood of confusion. The opposer relied on its prior use of a mark that had been denied registration on grounds it was merely descriptive. Despite the fact that opposer's mark was merely descriptive, the Board concluded that opposer had standing to oppose under Section 2(d). In sustaining the opposition, the Board stated that prior use of a term in a descriptive sense is sufficient to successfully oppose registration provided: (1) there is a likelihood of confusion, or (2) that registration would frustrate the opposer's right to use the term in a descriptive sense unhindered and free from harassment.<sup>107</sup>

According to Judge Rich:

Absent a requirement in the first part of the board's test that the user of that term demonstrate that it identifies source and a requirement in the second part that what applicant seeks to register is a descriptive term (or its equivalent), the statement is statutorily untenable . . . . Parts (1) and (2) of the above test are mutually exclusive considerations and the misjudgment of the

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103. 15 U.S.C. § 1063 (2006).

104. 640 F.2d 1317, 209 U.S.P.Q. (BNA) 40 (C.C.P.A. 1981).

105. See *supra* note 6.

106. *Otto Roth*, 640 F.2d at 1320, 209 U.S.P.Q. (BNA) at 43.

107. *Lankor Int'l, Inc. v. Otto Roth & Co.*, 204 U.S.P.Q. (BNA) 941 (T.T.A.B. 1979) (digest only).

board in formulating that statement was to combine, respectively, Sections 2(d) and 2(e)(1) into one measure of registrability.<sup>108</sup>

In another case on damage, *Morehouse Manufacturing Corp. v. J. Strickland & Co.*,<sup>109</sup> Judge Rich determined, as a matter of law, that an opposer is not damaged by the issuance of a second registration where applicant already has an existing registration for the same mark for the same goods. This proposition is referred to as the “Morehouse” defense.

## VII. FRAUD

Judge Rich, in *Morehouse*, also offered a number of important observations regarding the issue of fraud. The issue came up in the context of a Section 8 affidavit of continued use in which the registrant, instead of submitting a specimen showing current use of the mark, submitted an earlier, discontinued label. The affidavit indicated that a specimen of the mark “as now actually being used” is attached. Based on these facts, it was argued that the registration should be canceled on grounds of either fraud or that the registrant did not make a showing of current use, as required by the statute.

Judge Rich was not persuaded, observing that the evidence established that the registrant was still using the registered mark on the same goods for which it was registered. Judge Rich emphasized that the purpose of Section 8 affidavits is to remove from the register marks that are no longer in use. “Given the fact of continuing use, from which practically all of the user’s substantive trademark rights derive, nothing is to be gained from and no public purpose is served by canceling the registration of a technically good trademark because of a minor technical defect in an affidavit.”<sup>110</sup>

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108. *Otto Roth*, 640 F.2d at 1320-21, 209 U.S.P.Q. (BNA) at 43-44; *see also* *House of Worsted-Tex, Inc. v. Superba Cravats, Inc.*, 284 F.2d 528, 128 U.S.P.Q. (BNA) 119 (C.C.P.A. 1960) (finding opposer lacked standing to maintain opposition based on common law rights in mark IVY LEAGUE for clothing since opposer failed to establish proprietary rights in term); *DeWalt, Inc. v. Magna Power Tool Corp.*, 289 F.2d 656, 129 U.S.P.Q. (BNA) 275 (C.C.P.A. 1960) (basing analysis for asserting freedom to use descriptive term on factual circumstances when registration is sought rather than applicant’s mere reliance on Section 2(f) to obtain registration of descriptive term in order to defeat opposer’s claim of standing). *See generally In re Thunderbird Prods. Corp.*, 406 F.2d 1389, 160 U.S.P.Q. 730 (C.C.P.A. 1969) (declaring that whether a mark is descriptive must be determined based upon evidence at the point when the issue of registrability is under consideration by the Patent Office).

109. 407 F.2d 881, 160 U.S.P.Q. (BNA) 715 (C.C.P.A. 1969).

110. *Id.* at 888, 160 U.S.P.Q. (BNA) at 720; *cf. Duffy-Mott Co., Inc. v. Cumberland Packing Co.*, 424 F.2d 1095, 165 U.S.P.Q. (BNA) 422 (C.C.P.A. 1970) (refusing, on grounds of “unclean hands,” to permit opposer to rely on a registration that was subject to a false Section 15 declaration (i.e., registrant included goods on which the

The court also distinguished fraud in trademark cases from fraud in patent cases. Judge Rich pointed out that every right of a patentee flows from rights granted by the Patent Office. However, trademark rights flow from use, not from registration:

It is in the public interest to *maintain* registrations of technically good trademarks on the register so long as they are still in use. The register then reflects commercial reality. Assertions of “fraud” should be dealt with realistically, comprehending . . . that trademark rights, unlike patent rights continue notwithstanding cancellation of those additional rights which the Patent Office is empowered by statute to grant.<sup>111</sup>

Judge Rich authored one other noteworthy decision on fraud. In *Rosso & Mastracco, Inc. v. Giant Food Inc.*,<sup>112</sup> Judge Rich rejected a claim of fraud based on an applicant’s failure to identify a junior user in its application. While he acknowledged that an applicant has a duty to continuously review and amend the oath<sup>113</sup> filed with the application, he pointed out that a senior user ordinarily need not identify junior users in the oath unless the rights of such junior users are clearly established.<sup>114</sup>

#### VIII. LIKELIHOOD OF CONFUSION

For the most part, Judge Rich’s jurisprudence on the issue of likelihood of confusion reflected prevailing law. Thus, for example, his decisions note that the issue of likelihood of confusion must be decided on the basis of the marks and goods and/or services set forth

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mark was not in use)). In *Duffy-Mott*, Judge Rich explained that under Section 15, the incontestability provision, registrant’s right to use a mark becomes incontestable for the goods on which the mark has been in continuous use for five consecutive years and is still in use. “This is not a question of maintaining the registration in force, which can be done by an affidavit under Section 8(a) . . . without naming any *particular* goods. . . . It is a matter of acquiring a new right with respect to the goods specifically recited in the affidavit.” 424 F.2d at 1099-1100, 165 U.S.P.Q. (BNA) at 425 (emphasis in original). *Duffy-Mott* was decided prior to the amendment to the Lanham Act that now requires a Section 8 affidavit to “set[] forth those goods or services recited in the registration on or in connection with which the mark is in use in commerce . . . .” See 15 U.S.C. § 1058 (2006).

111. *Morehouse*, 407 F.2d at 888, 160 U.S.P.Q. (BNA) at 720 (emphasis in original).

112. 720 F.2d 1263, 219 U.S.P.Q. (BNA) 1050 (Fed. Cir. 1983).

113. The oath then in effect required an applicant to aver:

no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use such mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when applied to the goods of such other person, to cause confusion, or to cause mistake, or to deceive.

*Id.* at 1266, 219 U.S.P.Q. (BNA) at 1053 (citing 15 U.S.C. § 1051(a)(1) (1976); 37 C.F.R. § 2.33(b) (1982)).

114. *Id.*, 219 U.S.P.Q. (BNA) at 1053.

in the application and cited registration(s),<sup>115</sup> that any doubt is resolved against the newcomer,<sup>116</sup> that likelihood of confusion is not decided on the basis of a side-by-side comparison of the marks,<sup>117</sup> that absent evidence of use, third-party registrations are entitled to little weight in resolving the issue of likelihood of confusion,<sup>118</sup> and that the fact that one mark may call another to mind does not by itself establish a likelihood of confusion.<sup>119</sup> Many of his decisions relied heavily on the sophistication, or lack thereof, of the relevant purchasing public.<sup>120</sup> Judge Rich also emphasized that what is

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115. See, e.g., *Luzier Inc. v. Marlyn Chem. Co., Inc.*, 442 F.2d 973, 974, 169 U.S.P.Q. (BNA) 797 (C.C.P.A. 1971) (“There is nothing in opposer’s registration nor in the description of goods in applicant’s applications to restrict the goods to any price range, method of marketing, packaging quantities, or class of purchasers.”); *Tropic-Aire, Inc. v. Approved Prods., Inc.*, 275 F.2d 728, 731, 125 U.S.P.Q. (BNA) 182, 185 (C.C.P.A. 1960) (“These registrations must be considered under Section 2(d) of the Trademark Act . . . notwithstanding the evidence that tends to show the registrant is no longer using the mark on some of the goods enumerated therein.”); *General Shoe Corp. v. Lerner Bros. Mfg. Co., Inc.*, 254 F.2d 154, 157, 117 U.S.P.Q. (BNA) 281, 284 (C.C.P.A. 1957) (“Even though the net effect of the evidence of record may be to create the impression that opposer is now primarily concerned commercially with women’s shoes under the ‘Holiday’ mark, we do not feel that this can be controlling of the issue so long as the opposer’s earlier registration of ‘Holiday’ is not so limited.”).

116. See, e.g., *In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes*, 487 F.2d 918, 920, 179 U.S.P.Q. (BNA) 729, 730 (C.C.P.A. 1973) (“[T]he rule that doubt as to likelihood of confusion shall be resolved against the newcomer has been applied in the Patent Office in ex parte cases from an early time . . . .”); *Planters Nut & Chocolate Co. v. Crown Nut Co., Inc.*, 305 F.2d 916, 920, 134 U.S.P.Q. (BNA) 504, 508 (C.C.P.A. 1962) (“[W]here there is doubt the court resolves it against the newcomer.”).

117. See, e.g., *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 1007, 169 U.S.P.Q. (BNA) 39, 40 (C.C.P.A. 1971) ([W]hat the statute prescribes . . . is whether the marks *so resemble* one another *as to be* likely to cause confusion or mistake, and this requires us to consider . . . the fallibility of memory over a period of time, not merely whether one can distinguish the marks at a given moment.”); *Rex Shoe Co., Inc. v. Juvenile Shoe Corp.*, 273 F.2d 179, 180, 124 U.S.P.Q. (BNA) 173 (C.C.P.A. 1959) (“The issue here is not likelihood that purchasers would confuse *the marks* on a side-by-side comparison.”).

118. See, e.g., *Stanadyne, Inc. v. Lins*, 490 F.2d 1396, 1397, 180 U.S.P.Q. (BNA) 649, 650 (C.C.P.A. 1974) (“[M]ere registrations are entitled to little weight in establishing whether there is likely to be confusion because registrations by themselves do not indicate how the public mind may have been conditioned.”).

119. See, e.g., *In re Ferrero*, 479 F.2d 1395, 1397, 178 U.S.P.Q. (BNA) 167, 168 (C.C.P.A. 1973) (“Seeing a yellow traffic light immediately ‘calls to mind’ the green that has gone and the red that is to come, or vice versa; that does not mean that confusion is being caused. As we are conditioned, it means exactly the opposite.”).

120. See, e.g., *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 1402, 167 U.S.P.Q. (BNA) 529, 531 (C.C.P.A. 1970) (Rich, J., dissenting) (“With respectful deference for the views of the majority, I cannot agree that a reasonable likelihood of confusion does not exist in the concurrent use of PEAK and PEAK PERIOD on the two consumer products here involved—dentifrice and deodorant. These are both low-cost, consumer-purchased, shelf items in the same category of merchandise, sold in the same departments of the same stores for the related uses of personal hygiene, bought by persons of all degrees of intelligence and perspicacity—some of them careless.”); *Clayton Mark & Co. v. Westinghouse Elec. Corp.*, 356 F.2d 943, 944, 148

important in a likelihood of confusion analysis “is not whether people will necessarily confuse the marks, but whether the marks will be likely to confuse people into believing that the goods they are purchasing emanate from the same source.”<sup>121</sup>

The one issue in which Judge Rich’s views fall outside the mainstream concerns the effect of a strong or famous mark on the question of likelihood of confusion. While the prevailing case law accords strong marks broad protection,<sup>122</sup> Judge Rich took a contrary view. For example, in his dissent in *Jiffy, Inc. v. Jordan Industries, Inc.*,<sup>123</sup> involving the well-known JIFFY mark for peanut butter, Judge Rich commented that “[t]he better known [the mark] is, the less likelihood of confusion there would be . . . .”<sup>124</sup> And, in *B.V.D. Licensing Corp. v. Body Action Design, Inc.*,<sup>125</sup> Judge Rich, writing for the court, concluded that the fame of the BVD mark for men’s underwear undercut a claim of likelihood of confusion with the use of B A D for clothing. Judge Rich reasoned that the better known a mark is, the more likely the public becomes aware of even a small difference in the marks.

#### IX. DESCRIPTIVENESS

Writing for the majority<sup>126</sup> of the court in *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson*,<sup>127</sup> Judge Rich determined that the mark SKINVISIBLE, as used on transparent adhesive tape through which the skin is visible, was not merely descriptive under Section 2(e)(1) of the statute. Judge Rich noted that SKINVISIBLE is highly suggestive in that it suggests that the skin is visible through the goods to which the mark is applied and also suggests the quality of

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U.S.P.Q. (BNA) 672, 673 (C.C.P.A. 1966) (“Purchase of ‘MARK 75’ breakers would therefore be on a very discriminating basis, by persons who not only know what they are buying and why but who is producing it.”).

121. *Kangol Ltd. v. Kangaroos U.S.A., Inc.*, 974 F.2d 161, 163, 23 U.S.P.Q.2d (BNA) 1945, 1946 (Fed. Cir. 1992); *see also* *Am. Cyanamid Co. v. U.S. Rubber Co.*, 356 F.2d 1008, 1009, 148 U.S.P.Q. (BNA) 729, 730 (C.C.P.A. 1966) (noting that Section 2(d) is not limited to confusion as to the origin of the goods, “though that is the question most often presented”).

122. *See, e.g.*, *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 U.S.P.Q.2d (BNA) 1303 (Fed. Cir. 2002) (stating that the Board erred in discounting fame of opposer’s marks); *Kenner Parker Toys v. Rose Art Indus., Inc.*, 963 F.2d 350, 353, 22 U.S.P.Q.2d (BNA) 1453, 1456 (Fed. Cir. 1992) (“[A] mark with extensive public recognition and renown deserves and receives more legal protection than an obscure or weak mark.”).

123. 481 F.2d 1323, 179 U.S.P.Q. (BNA) 169 (C.C.P.A. 1973).

124. *Id.* at 1327, 179 U.S.P.Q. (BNA) at 172 (Rich, J., dissenting).

125. 846 F.2d 727, 6 U.S.P.Q.2d (BNA) 1719 (Fed. Cir. 1988).

126. Judge Baldwin concurred and Judges Lane and Almond dissented.

127. 454 F.2d 1179, 172 U.S.P.Q. (BNA) 491 (C.C.P.A. 1972).

invisibility in the tape. He pointed out, however, that a valid mark may be highly suggestive. Judge Rich further observed that SKINVISIBLE is not a dictionary term but, rather, a term coined by the applicant and that the evidence did not show that the term had become part of the language. Under such circumstances, he concluded, providing protection to SKINVISIBLE would not deprive competitors of the right to use the language in a normal manner.

In another case, *Remington Products, Inc. v. North American Philips Corp.*,<sup>128</sup> Judge Rich determined that TRAVEL CARE, as used for electric travel irons and wrinkle remover/fabric steamers, was merely descriptive. He observed that the applicant conceded that the term “travel personal care” is merely descriptive for the goods and then determined that merely omitting the word “personal” does not convert the mark into one that is registrable. The evidence, Judge Rich pointed out, makes clear that “travel care” is a category designation for a class of goods.

Judge Rich also issued opinions on the issue of geographical descriptiveness or misdescriptiveness. In one case,<sup>129</sup> Judge Rich determined that AMERICAN BEAUTY for sewing machines and parts that were made in Japan was geographically deceptively misdescriptive under the then wording of Section 2(e)(2)<sup>130</sup> of the Lanham Act. While a majority of the Trademark Trial and Appeal Board held that the common meaning of the term “American Beauty” is that of a well-known rose, and, thus, that the mark is not “primarily” geographically deceptively misdescriptive,<sup>131</sup> the C.C.P.A. concluded that “American Beauty” has more than one “primary” meaning. Reviewing the specimens of use,<sup>132</sup> Judge Rich found that

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128. 892 F.2d 1576, 13 U.S.P.Q.2d (BNA) 1444 (Fed. Cir. 1990).

129. *Singer Mfg. Co. v. Birginal-Bigsby Corp.*, 319 F.2d 273, 138 U.S.P.Q. (BNA) 63 (C.C.P.A. 1963).

130. At the time *Singer* was decided, Section 2(e)(2) provided a basis for refusal of a mark “which, . . . when applied to the goods of the applicant . . . is primarily geographically descriptive or deceptively misdescriptive of them.” 15 U.S.C. § 1052(e)(2). *Singer* was also decided prior to the landmark decision of the C.C.P.A. in *In re Nantucket, Inc.*, 677 F.2d 95, 213 U.S.P.Q. (BNA) 889 (C.C.P.A. 1982), in which the court required evidence of a goods/place association before a mark could be refused registration as either primarily geographically descriptive or misdescriptive. In *In re Cal. Innovations, Inc.*, 329 F.3d 1334, 66 U.S.P.Q.2d (BNA) 1853 (Fed. Cir. 2003), the court held that, in order to support a refusal under current Section 2(e)(3) of the Lanham Act on grounds the mark is primarily geographically deceptively misdescriptive, the PTO also would have to show public deception that is material to the consumer’s decision to purchase.

131. *Singer Mfg. Co. v. Birginal-Bigsby Corp.*, 132 U.S.P.Q. (BNA) 471 (T.T.A.B. 1961).

132. The specimens showed the words AMERICAN BEAUTY applied in large prominent type on the arm of sewing machine heads and ads that used such

the words AMERICAN BEAUTY conveyed the impression of a beautiful sewing machine made in America.

Judge Rich, writing for the Federal Circuit, also concluded that the Trademark Trial and Appeal Board erred in holding that VITTEL for cosmetic products was primarily geographically descriptive.<sup>133</sup> The examiner, in support of the refusal, cited geographical references that show that Vittel is a town in northeast France that is known as a watering place, spa, and resort. In reversing, the court concluded that the evidence established that “Vittel” would not be perceived as a geographic term by the American cosmetic-purchasing public:

We think the evidence is inadequate to show that the bulk of cosmetics purchasers, or even a significant portion of them, would, upon seeing the word Vittel on a bottle of skin lotion or the like, conclude that it is a place name and that the lotion came from there, rather than simply a trademark or trade name of a manufacturer . . . .<sup>134</sup>

#### X. OTHER NOTEWORTHY DECISIONS

Under Section 44(d) of the Lanham Act, a foreign trademark owner may be entitled to file a U.S. trademark application based on its earlier-filed national application if the U.S. application is filed within six months from the date on which the application was first filed in the foreign country. Such registration may mature into a U.S. registration either upon proof of use in the United States or proof of ownership of a corresponding foreign registration in the applicant’s country of origin. In *In re De Luxe*,<sup>135</sup> a Dutch company, Balmain, filed an application with the PTO on November 25, 1987, to register the mark IVOIRE DE BALMAIN. The application was based on a pending Benelux<sup>136</sup> application. Balmain then submitted to the PTO a copy of the corresponding Dutch registration on April 7, 1989. On August 2, 1989, Balmain assigned its U.S. application to De Luxe, a foreign company. The examiner then required De Luxe to establish that it owned the corresponding Benelux registration. De Luxe was unable to do so, and the examiner refused registration. The Trademark Trial and Appeal Board affirmed on the ground that De

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expressions as “The American Beauty—the world’s most precious—Automatic Zig-Zag Sewing Machine.” *Singer*, 319 F.2d at 275, 138 U.S.P.Q. (BNA) at 65.

133. See *In re Societe Generale Des Eaux Minerales De Vittel S.A.*, 824 F.2d 957, 3 U.S.P.Q.2d (BNA) 1450 (Fed. Cir. 1987).

134. *Id.* at 959, 3 U.S.P.Q.2d (BNA) at 1452.

135. 990 F.2d 607, 26 U.S.P.Q.2d (BNA) 1475 (Fed. Cir. 1993).

136. The Benelux registry is the common trademark registry for Belgium, Netherlands, and Luxembourg.

Luxe, while the owner of the U.S. application, was not also, at the time of publication, the owner of the foreign registration on which the U.S. registration is based.

Deciding an issue of “first impression,” the court, per Judge Rich, concluded that a foreign applicant must comply with the requirements of Section 44 only at the time the application is filed. After the application is filed, the foreign applicant may freely alienate its U.S. application without also assigning foreign rights.<sup>137</sup>

Judge Rich’s opinion for the court in *In re ECCS, Inc.*<sup>138</sup> reflected what he termed “the most fundamental aspect of U.S. trademark law, namely, that trademark ownership and attendant rights are acquired in the marketplace by use and that . . . the Lanham Act . . . provides only for registration of existing marks.”<sup>139</sup> The case arose out of a conflict between the mark, as reflected in the specimens, and the mark as it appeared on the drawing page. On the specimens, the mark appeared as:

EXA

MODULE

On the drawing, the mark appeared as EXAMODULE. The examiner refused registration on grounds the drawing differed from the specimen. The applicant’s attempts to amend the drawing to show the mark as EXA MODULE were rejected by the examiner because such amendment constituted a material alteration of the mark, in violation of then Trademark Rule 2.72(a).

Judge Rich determined, however, that then Trademark Rule 2.72(b) permitted amendments to a drawing if warranted by the specimens. He noted that the specimens show what mark is sought to be registered and that:

It seems only a matter of common sense and sound trademark law that the specimens show what mark *is* owned by the applicant, ownership being a prerequisite to registration, and that one should look to the specimens, in a case of inconsistency, to determine what

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137. This situation is to be contrasted with that where a Section 44 application is filed by a foreign national and later assigned to a U.S. company. In that situation, the Section 44 application is considered void since a U.S. company cannot register a mark in the United States under Section 44. See *Karsten Mfg. Co. v. Editoy AG*, 79 U.S.P.Q.2d (BNA) 1783 (T.T.A.B. 2006).

138. 94 F.3d 1578, 39 U.S.P.Q.2d 2001 (Fed. Cir. 1996). In the interest of full disclosure, one of the authors of this Article served as co-counsel for the applicant in this case.

139. *Id.* at 1579, 39 U.S.P.Q. at 2002.

an applicant wishes to register, not to a clearly inconsistent and erroneous drawing . . . .<sup>140</sup>

#### CONCLUSION

Giles Sutherland Rich left a rich legacy in the field of trademark law. His jurisprudence in the area recognizes the fundamental principle that trademark rights in the United States are acquired by use and, that as a result, the law should be applied and interpreted in light of commercial reality. The PTO best fulfills its public mission, he argued, by registering marks, not by second-guessing those in the marketplace in a misguided zeal to protect the public interest. In such a fashion, Judge Rich contended, the public notice function of the trademark register is advanced, the rights of trademark owners are best protected, and public confusion is avoided.

Judge Rich's opinions clarified the law in a number of important respects. Many of his decisions, particularly *Morton-Norwich*,<sup>141</sup> *Marvin Ginn*,<sup>142</sup> and *Otto Roth*,<sup>143</sup> and the principles set forth therein, have withstood the test of time and continue to serve as basic guiding posts for the PTO in its administration of the federal registration system.

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140. *Id.* at 1581, 39 U.S.P.Q.2d at 2004. The court's decision did not sit very well with the PTO. Effective October 30, 1999, Rule 2.72 was amended to prohibit amendments that materially alter the mark on the drawing filed with the original application. 37 C.F.R. § 2.72. Also, Trademark Rule 2.52 was amended to state that the "drawing depicts the mark sought to be registered." 37 C.F.R. § 2.52. Thus, the PTO no longer accepts amendments to cure internal inconsistencies if these amendments materially alter the mark on the original drawing.

141. *See supra* note 57.

142. *See supra* note 77.

143. *See supra* note 104.