Decisions of the Federal Circuit and the
Trademark Trial and Appeal Board on Registrability Issues
July 2022 to June 2023

By John L. Welch[*]

PART I. EX PARTE CASES

A. United States Court of Appeals for the Federal Circuit

1. Section 2(d) Likelihood of Confusion

***In re Charger Ventures LLC*, 2023 USPQ2d 451 (Fed. Cir. 2023) [precedential].** The CAFC upheld the Board's decision affirming a refusal to register the mark SPARK LIVING for "leasing of residential real estate; residential real estate listing; residential real estate service, namely, residential rental property management; specifically excludes commercial property and office space" (LIVING disclaimed). The Board found a likelihood of confusion with the registered mark SPARK for brokerage, leasing, and management of commercial property, offices, and office space. Appellant Charger challenged the Board's factual findings on five *DuPont* factors, but the CAFC ruled that the Board's decision was supported by substantial evidence. Charger also charged the Board with failing to indicate the weight that it assigned to each *DuPont* factor, and therefore that its analysis lacked substantial evidence. The CAFC agreed that, for purposes of appellate review, the Board "must provide a reasonable explanation for its findings, explaining the weight to be assigned to the relevant factors." However, an appellate court will "uphold a decision of less than ideal clarity if the agency's path may reasonably be discerned."

B. Trademark Trial and Appeal Board

1. Section 2(b) Governmental Insignia

***County of Orange*, 2022 USPQ2d 733 (TTAB 2022) [precedential].** Every few years, like clockwork, the Board decides a Section 2(b) case. This time it affirmed refusals to register the two proposed marks depicted here, for various governmental services (e.g., maintaining parks and libraries), on the ground that they constitute insignia of a governmental entity, i.e., a "municipality." The Board rejected the argument that Orange County is not a municipality, as

[*] Counsel, Wolf, Greenfield & Sacks, P.C., Boston and New York City. Further discussion of each of these cases, and links to the opinions, may be found at The TTABlog at www.ttablog.com.

well as the argument that because Orange County already has an "official" seal, these designs cannot be insignia of the county. The Board took judicial notice of a definition of the term "municipality" as a "city, town, or other local political entity with the powers of self government." Orange County acknowledged that the California Constitution provides that a county may have some such powers: for example, a county may make and enforce local ordinances, sue and be sued, levy and collect taxes, and adopt a charter. The Board therefore concluded that Orange County is a "municipality" for purposes of Section 2(b). The Board further found that the "prominent and repeated display of the proposed Circular Mark to denote traditional government records, functions, and facilities would reasonably lead members of the general public to perceive the proposed mark as an 'insignia' of Applicant within the meaning of Section 2(b) of the Trademark Act."

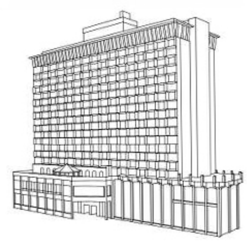
2. Section 2(e)(1) Mere Descriptiveness

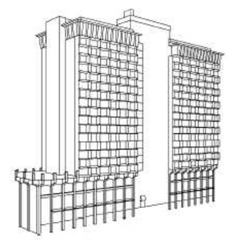
***In re Zuma Array Ltd.*, 2022 USPQ2d 736 (TTAB 2022) [precedential].** Affirming a Section 2(e)(1) refusal to register the proposed mark SMART BEZEL, the Board found the term to be merely descriptive of electronic sensor modules for controlling and integrating home automation systems, lighting systems, and smart heating systems [SMART disclaimed]. Applicant Zuma Array contended that its goods are not bezels and so the mark cannot describe the goods. The Board, however, found the mark to be descriptive of a use or purpose of the modules, and thus ineligible for registration without proof of acquired distinctiveness. Zuma acknowledged that "smart" is defined as "using a built in microprocessor" and the word "bezel" refers to "the outer frame of a computer screen, mobile phone or other electronic device." However, it asserted, "none of the applied for goods . . . feature a 'bezel' at all." The Board observed that a proposed mark that describes the intended use or purpose of the goods with which it is used is merely descriptive. Zuma's own website "'demonstrates that a consumer would immediately understand the intended meaning of' SMART BEZEL for electronic sensor modules, *N.C. Lottery*, 123 USPQ2d at 1710, namely, that the modules are used to create a 'smart bezel.'"

***In re NextGen Management, LLC*, 2023 USPQ2d 14 (TTAB 2023) [precedential].** In a soporific precedential decision, the Board affirmed a Section 2(e)(1) refusal to register the proposed mark DXPORTAL, finding the mark to be merely descriptive of "providing an Internet website portal in the healthcare field to provide a patient and caregivers with the patient's drug prescription information." Dictionary definitions of DX (a common abbreviation for "diagnostic") and of "portal," information on applicant's and third-party websites, and applicant's acknowledged intention to offer diagnostic services in connection with the mark, led the Board to conclude that consumers would immediately understand that the mark "identifies a portal that will also link them with diagnostic information, specifically the diagnosis relied upon by the healthcare provider who wrote the drug prescription." NextGen argued that, although it "does intend (in the future) to include limited diagnostic information on the portal, the storing of diagnostic information is not the focus of the portal, nor is it recited in the description of services of the mark." However, NextGen's website demonstrated that providing diagnostic information is an "integral part of Applicant's website relating to drug prescriptions, even if it is not the paramount aspect." Moreover, third-party webpages "illustrate how diagnostic information and therapeutic solutions, such as prescription drugs, are integral to each other."

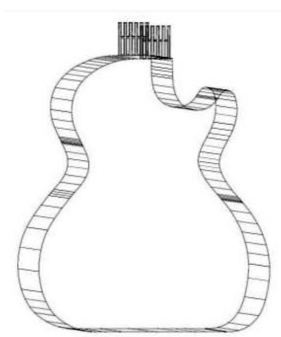
3. Inherent and Acquired Distinctiveness

***In re Palacio Del Rio, Inc*., 2023 USPQ2d 630 (TTAB 2023) [precedential].** The Board upheld the USPTO's refusals to register the two proposed marks shown here, comprising the three-dimensional configurations of the front and back of a hotel building, for "hotel services; provision of conference, exhibition, and meeting facilities," finding that the building designs are not inherently distinctive and lack secondary meaning. Applicant failed to overcome the evidence that the proposed marks "constitute the 'common' basic design elements of hotel buildings façades (e.g., grid-like hotel rooms, smooth column, outwardly extending crown, and arches); they are not unique or unusual in the hotel field, and they are mere refinements of commonly-adopted and well-known forms of ornamentation for hotel buildings that would be viewed by the public 'as a dress or ornamentation' for Applicant's hotel services." Applicant's evidence of acquired distinctiveness likewise fell short: it provided no evidence of look-for advertising, unsolicited media coverage, copying by third parties, or consumer association of the designs with applicant, and its sales data lacked industry context.





***In re Seminole Tribe of Florida*, 2023 USPQ2d 631 (TTAB 2023) [precedential].** The Board reversed a refusal to register "trade dress consisting of a three-dimensional building in the shape of a guitar" for "casinos" and "hotel, restaurant and bar services." It found the mark to be "tertium quid" akin to product packaging and thus eligible for registration without proof of acquired distinctiveness. The Board looked to decisions that analyzed the inherent distinctiveness of trade dress used with a variety of services, not just building designs: the "Cuffs and Collars" costume in *Chippendales* and the monster truck design in *Frankish.* Focusing on the uniqueness of the Tribe's building design in the relevant industry, it concluded that applicant's design is inherently distinctive for the Tribe's services. The Board's conclusion was "further supported" by the *Seabrook* test for inherent distinctiveness. "We find that Applicant's Mark is not a common design; rather, it is unique, and not a mere refinement of a commonly-adopted and well-known form of ornamentation for Applicant's Services. Given the uniqueness of Applicant's three-dimensional Guitar Design trade dress as applied to Applicant's Services, we find Applicant's Mark is of a type that consumers would immediately rely on to differentiate Applicant's Services from casinos or hotel, restaurant, and bar services offered by others, and that it therefore constitutes inherently distinctive trade dress."



4. Failure-to-Function

***In re Brunetti*, 2022 USPQ2d 764 (TTAB 2022) [precedential].** Erik Brunetti, famous in the trademark world for knocking the scandalous and immoral provision of Section 2(a) out of the Trademark Act, returned to the TTAB in this battle over the proposed mark FUCK for phone cases, jewelry, bags, and retail store services. The Board affirmed each of four refusals to register on the ground that FUCK fails to function as a trademark, concluding that the word "fuck" is in such widespread use that it does not create the commercial impression of a source indicator, but rather expresses well-recognized, familiar sentiments. The Board rejected Brunetti's argument that the Supreme Court decision in the FUCT case requires reversal here, and it also rejected his claim of biased treatment by the Board. The failure-to-function refusal was rather straightforward. The evidence established the ubiquity of the word "fuck" in general, and the widespread use of the word for various consumer goods. The Board pointed out that the Supreme Court's decision in *Iancu v. Brunetti* concerned only Section 2(a)'s prohibition of registration of marks containing scandalous matter, not the issue of failure-to-function. Applicant Brunetti provided no evidence that "plausibly suggests the USPTO maintains any bias against him . . . or is motivated by his exercise of his first amendment rights."

***In re Pound Law, LLC*, 2022 USPQ2d 1062 (TTAB 2022) [precedential].** Affirming a refusal to register the proposed mark #LAW for legal referral services, the Board found that the term, as used on Applicant Pound Law's specimens of use, fails to function as a source indicator. Instead, the Board found that #LAW, a vanity phone number, would be perceived by consumers as merely informational. Citing numerous examples from advertising materials of other law firms, the Board found that #LAW is commonly used as a hashtag in the legal field, including by the applicant's licensee, Morgan & Morgan. Pound Law argued that the Board has long recognized the registrability of mnemonic telephone numbers, but the Board pointed out that the new versions of vanity phone numbers "present a somewhat different situation than traditional alphanumeric numbers." The different "formation" of these new vanity numbers "impacts perception and distinguishes them" from traditional numbers. Turning to the applicant's own use of #LAW, multimedia files and website excerpts presented #LAW "as a mnemonic for the telephone number #529, by which prospective clients may contact a lawyer at Morgan & Morgan law firm, not as a source indicator for legal or legal referral services."

***In re Lizzo LLC*, 2023 USPQ2d 139 (TTAB 2023) [precedential].** Attempts to register common slogans, internet memes, and informational material regularly hit the failure-to-function wall at the USPTO. But the Office has the burden of proof, and here its evidence fell short with regard to two refusals of the mark 100% THAT BITCH for certain clothing items, including t-shirts and baseball hats. The Board concluded that the evidence failed to show the proposed mark to be a common expression in such widespread use that it fails to function as a mark for the identified goods. Lizzo LLC is the trademark holding company of the popular singer and performer known as Lizzo. The proposed mark was inspired by a lyric in Lizzo's song, "Truth Hurts." The examining attorney maintained that 100% THAT BITCH "is a commonplace expression widely used by a variety of sources to convey an ordinary, familiar, well-recognized sentiment." Lizzo and the examining attorney agreed that 100% THAT BITCH conveys a feeling of female strength, empowerment and independence. "But more importantly, considering the entirety of the record, we find that most consumers would perceive 100% THAT BITCH used on the goods in the application as associated with Lizzo rather than as a commonplace expression."

***In re ZeroSix, LLC*, 2023 USPQ2d 705 (TTAB 2023).** Reversing a failure-to-function refusal of BOYS WORLD for "audio recordings featuring music," the Board ruled that the term not only identifies the musical group but also serves as a trademark for the group's recordings. "Typically, in order to function as a mark for recordings, a performing artist's name must be used for a series of recordings." There must also be evidence "that the name functions as a mark." The Examining Attorney conceded that the first element – evidence of a series of works –was satisfied. The Board then reviewed the record with regard to promotion and recognition of BOYS WORLD as a source indicator for the series of recordings. "Boys World is consistently identified – by streaming services and social, print and web media as the source of BOYS WORLD audio recordings featuring music. This is not surprising because BOYS WORLD has been heavily promoted and widely recognized as the source of the group's music. As a result, consumers "know what they are getting' when they purchase BOYS WORLD 'audio recordings featuring music.' Thus, BOYS WORLD functions as a mark."

5. Genericness

***In re International Fruit Genetics, LLC*, 2022 USPQ2d 1119 (TTAB 2022) [precedential].** In a decision of importance only to those few trademark practitioners who labor in the varietal plant field, the Board affirmed a refusal to register the proposed mark IFG for, *inter alia*, live plants, holding that "proposed marks that constitute the prominent portion of a varietal denomination are unregistrable under Trademark Act Sections 1, 2, and 45 because they are generic for the varietals they identify" and therefore "incapable of functioning as a trademark." In *In re Pennington Seed Co*., the CAFC upheld the USPTO's long-standing precedent and practice of treating varietal names as generic. The Board was faced with three questions: (1) is the prominent portion of a varietal name barred from registration under Trademark Act Sections 1, 2, and 45 because varietal names are the equivalent of generic designations; (2) if so, does the record show that IFG is a prominent portion of the varietal names of record for the identified goods; and (3) does this constitute an absolute bar to registration given the applicant's prior valid and subsisting trademark registration of the same mark for 'Live plants, namely, table grape vines, cherry trees' where said registration issued prior to the application filing dates of any of the plant patents or plant breeder's rights (i.e., PVP certificates under U.S. law) and purported prior trademark use?" The Board answered the three questions in the affirmative.

***In re Uman Diagnostics AB*, 2023 USPQ2d 191 (TTAB 2023) [precedential].** In another "key aspect" genericness case, the Board upheld a refusal to register the proposed mark NF-LIGHT for "specimen analysis kits containing reagents and assays for detecting neurological biomarkers in biological samples, serum, blood, plasma, saliva, and cerebrospinal fluid in human and animal samples used by medical and clinical researchers in labs and institutions," finding the term to be generic for the goods. The Board first found that Applicant's ELISA kits are "a subset of the broad genus of goods identified in the application, and neurofilament light – the particular 'neurological biomarker' detected by applicant's kit – is a subcategory and key aspect of the genus." Then it found that the relevant consumers of the goods (clinical and medical researchers) understand "NF-Light" as substantially synonymous with, and a reference to, neurofilament light. Applicant argued that the USPTO failed to meet its burden of proving that the proposed mark is generic by clear evidence because there was a "mixed record" of usage – i.e., generic usage as well as proper trademark use. The Board was unimpressed, applying a preponderance of the evidence standard and rejecting the "mixed record" assertion.

6. Goods in Trade

***In re The New York Times Co.*, 2023 USPQ2d 392 (TTAB 2023) [precedential].** In six consolidated appeals, the Board reversed refusals to register the marks THE NEW OLD AGE, GOOD APPETITE, HUNGRY CITY, WORK FRIEND, LIKE A BOSS, and OFF THE SHELF for "columns" on the subjects of business, office, money, careers, and worklife balance, rejecting the USPTO's position that each mark identifies only "individual portions of [A]pplicant's publications" and does not identify "separate goods in trade." The Board concluded that, in light of changes in the marketplace for the delivery of news (i.e., the Internet), a new test is required for the registrability of non-syndicated columns or sections in printed publications or recorded media, and under that new test the subject columns qualified as goods in trade. The Board found that the *New York Times* columns are not merely a "conduit or necessary tool" to obtain its primary goods; that each individual print column is not so inextricably tied to or associated with the *Times* print edition as to have no viable existence apart from the print edition as a whole; and that the columns possess independent value separate and apart from the newspaper as a whole, noting that consumers may look for and search for the name of the column and then separately read that column.

7. Illegal Use

***In re National Concessions Group, Inc.*, 2023 USPQ2d 527 (TTAB 2023) [precedential].** The Board upheld refusals to register the marks BAKKED (in standard characters) and a stylized drop design for "essential oil dispenser, sold empty, for domestic use," finding that the goods are illegal drug paraphernalia under the Controlled Substances Act (CSA), and therefore the marks are ineligible for registration. The evidence "amply supports a finding" that applicant's essential oil dispenser 'primarily is intended or designed for use in connection with preparing, inhaling or introducing marijuana into the human body via 'dabbing.'" The next question was whether applicant's goods qualify for an exemption under the CSA. Section 863(f)(1) exempts "any person authorized by local, State, or Federal law to manufacture, possess, or distribute such items," and Section 863(f)(2) exempts "any item that … [is] traditionally intended for use with tobacco products, including any pipe, paper, or accessory." The Board ruled that applicant was entitled to neither exemption. As to the first, it held that "when a Section 863(f)(1) exemption is applicable based on state law, that exemption does not support federal registration." As to the second, applicant failed to convince the Board that its products are traditionally intended for lawful products.

8. Use of Collective Membership Mark

***In re Mission America Coalition*, 2023 USPQ2d 228 (TTAB 2023) [precedential].** Section 4 of the Trademark Act provides for registration of a collective membership mark, defined as a trademark or service mark adopted by a collective and used by members to indicate membership in the collective. Mission American Coalition sought to register the mark THE TABLE COALITION "to indicate membership in a group of church leaders, senior church members, ministers, independent evangelical preachers, and other evangelical principals to promote and support evangelistic activities." Its specimen of use, however, failed to show use by members to indicate membership in the collective organization. Applicant's specimen comprised a business card of its Director of Ministry. The Board agreed with the examining attorney that the business card is used by the organization itself, not by a member to indicate membership in the coalition. The record as a whole "suggests Applicant's use of the TABLE COALITION as a service mark," but it does not show use of the mark as a collective membership mark in connection with the identified services. (Emphasis by the Board). And so, the Board affirmed a refusal to register under Sections 1, 4, and 45 of the Act.

9. Prosecution Issues

a. Translation Requirement

***In re Advanced New Technologies Co.*, 2023 USPQ2d 60 (TTAB 2023) [precedential].** Trademark Rule 2.32(a)(9) requires that any non-English wording in a proposed mark be translated into English. Advanced New Technologies applied to register the mark ZHIMA for hundreds of goods and services in nine classes, but it refused to comply with the Office's requirement that it submit an English translation of the mark. Advanced advanced the argument that ZHIMA, although a transliteration of the Chinese characters for the word, is a coined term without any meaning. The Board sided with the USPTO. The examining attorney submitted translations of the Chinese characters (sometimes including the term "ZHIMA") from nine Chinese-English dictionaries, as "sesame" or "sesame seed." Advanced conceded that the dictionary evidence showed that the Chinese characters "transliterate or are pronounced 'zhima,'" but argued that this evidence does not show that the term ZHIMA "is translated to the English word 'sesame' nor that ZHIMA has any meaning at all." The Board, however, found that the evidence both established that "ZHIMA is a transliteration of a Chinese word that means 'Sesame,'" and contradicted Advanced's argument that ZHIMA is a "coined term." In sum, ZHIMA "is used and recognized as the Chinese word for 'Sesame' and . . . Applicant has improperly refused to comply with the requirement to enter a translation statement."

b. New Arguments for Refusal

***In re Berkeley Lights, Inc*., 2022 USPQ2d 1000 (TTAB 2022) [precedential].** The TTAB rejected Applicant Berkeley Lights' quixotic request for reconsideration of the Board's January 2022 decision affirming a Section 2(e)(1) mere descriptiveness refusal of DEEP OPTO PROFILING for various chemicals and for biochemical services. Berkeley claimed that the

Board violated its Constitutional due process rights and the requirements of the Administrative Procedure Act, and failed to follow Board precedent by not affording Berkeley the benefit of the doubt on the issue at hand. In a detailed review of the record and the decision, the Board found no substantive or procedural error. It rejected Berkeley's principal contention that the Board may not rely on "new arguments that the Examining Attorney never made" in reaching its decision. According to the TBMP, the Board "need not find that the examining attorney's rationale was correct in order to affirm the refusal to register, but may rely on a different rationale." Although the Board may not rely on an "additional" or "new ground" for refusal – i.e., a different statutory ground than in the final action under appeal – the Board did not adopt a new ground for refusal here. The Board pointed out that, in any case, Berkeley could have addressed the "new arguments" in this request for reconsideration, but did not. Accordingly, the Board found no lack of notice or lack of due process.

PART II. INTER PARTES CASES

A. United States Court of Appeals for the Federal Circuit

1. Section 2(d) Likelihood of Confusion

***Bertini v. Apple Inc.*, 2023 USPQ2d 407 (Fed. Cir. 2023) [precedential].** The CAFC overturned the TTAB's decision dismissing Charles Bertini's Section 2(d) opposition to registration of APPLE MUSIC for a host of services, including the production and distribution of sound recordings and presentation of live music performances. The court ruled that the Board had erred in awarding priority to Apple (via tacking) over Bertini's use of the common law mark APPLE JAZZ for live musical performances. On a question of first impression, the CAFC held that a trademark applicant cannot establish priority for every good or service in its application merely because it has priority through tacking for a single good or service listed in the application. The Board then observed that to establish tacking, Apple had to show that live performances are substantially identical to gramophone records sold under the mark APPLE by assignor Apple Corps prior to Bertini's priority date. Apple failed to do so. "No reasonable person could conclude, based on the evidence of record, that gramophone records and live performances are substantially identical. Nothing in the record supports a finding that consumers would think Apple's live musical performances are within the normal product evolution of Apple Corps' gramophone records."

***Spireon, Inc. v. Flex Ltd*., 2023 USPQ2d 737 (Fed. Cir. 2023) [precedential].** The CAFC vacated and remanded the Board's decision that found confusion likely between Spireon's mark FL FLEX for electronic devices for tracking the location of mobile assets, and Flex's registered marks FLEX, FLEX (Stylized), and FLEX PULSE for supply chain and logistics management services. The court concluded that the Board erred in its assessment of the both the conceptual and commercial strength of Flex's marks by failing to consider all relevant evidence. In finding that Flex 's marks are not conceptually weak, the Board improperly discounted the probative value of 15 registered marks comprising compound terms that included "another word or letters in addition to 'FLEX.'" The Board "compounded this error by apparently giving no weight" to Spireon's evidence and argument that "flex" is highly suggestive because it is a shortened form of "flexible." As to commercial strength, the Board erred again in declining to consider third-party use of composite marks. In addition, Spireon argued that the Board should have considered three third-party registrations for the identical mark FLEX even though there was no record evidence of use of the marks. The CAFC held that it was opposer's burden to show that these identical marks were not in use, and it directed the Board to give Flex the opportunity to prove same. "If Flex fails to establish non-use, the commercial strength of the Flex marks must be considered weak as to Spireon's non-identical mark."

B. Trademark Trial and Appeal Board

1. Section 2(a) False Suggestion of a Connection

***NPG Records, LLC and Paisley Park Enterprises, LLC v. JHO Intellectual Property Holdings LLC*, 2022 USPQ2d 770 (TTAB 2022) [precedential].** Finding that the proposed mark PURPLE RAIN for dietary and nutritional supplements falsely suggests a connection with the famous musician and performer Prince, the Board granted opposers' motion for summary judgment under Section 2(a) of the Trademark Act. The record contained "copious, unrebutted evidence of Prince's fame among the general consuming public and his unique association with the words PURPLE RAIN." Evidence of use of PURPLE RAIN by Prince included his album, a movie, and sales of a variety of consumer products under the mark. Survey results showed that 66.3% of the general public recognize PURPLE RAIN as a reference to Prince. The Board agreed with Opposers that "[b]ecause purchasers are accustomed to celebrity licensing, they may presume a connection with a celebrity even though the goods have no relation to the reason for the celebrity's fame." "If the applicant's goods are of a type that consumers would associate . . . in some fashion with a sufficiently famous person or institution, then we may infer that purchasers of the goods or services would be misled into making a false connection with the named party."

2. Section 2(c) Consent of Living Individual

***Mystery Ranch, Ltd. v. Terminal Moraine Inc. dba Moraine Sales*, 2022 USPQ2d 1151 (TTAB 2022) [precedential].** Section 2(c) inter partes proceedings are as rare as a traffic cop in Boston, but the Board gave the green light to Opposer Mystery Ranch in sustaining this opposition to registration of the mark DANA DESIGN in the form shown here, for backpacks, hiking equipment, tents, and related goods, on the ground that the mark comprises the name of a living individual, Dana Gleason, without his consent and is therefore barred from registration by Section 2(c) of the Trademark Act. The evidence established that, in the field of backpacks and hiking gear, "the name 'Dana' is recognized as a nickname for Dana Gleason." However, the Board rejected Opposer Mystery Ranch, Ltd.'s Section 2(a) false connection claim because the opposed mark is not a close approximation of Mystery Ranch's name or identity: "although consumers associate Dana Gleason and Mystery Ranch . . they are not perceived as each other's alter ego." As to the

Section 2(c) claim, the Board found Mystery Ranch to be in privity with Dana Gleason and therefore able to assert Gleason's rights under Section 2(c) to prevent the use of his first name DANA without his written consent, despite the fact that Gleason had assigned his rights in the subject trademark.

3. Section 2(d) Likelihood of Confusion

a. Likelihood of Confusion Found

***Monster Energy Co. v. Chun Hua Lo*, 2023 USPQ2d 87 (TTAB 2023) [precedential].** Frequent TTAB litigant Monster Energy prevailed in this opposition to registration of the mark ICE MONSTER & Design for "restaurants, coffee shops, ices parlors, snack bars with take-out for flavored and fruit ice products, and specifically excluding frozen yogurt" [ICE disclaimed]. The Board found the mark likely to cause confusion with the registered mark MONSTER ENERGY for restaurant services. Although the MONSTER ENERGY mark is famous for energy drinks, the Board rejected the opposer's claim of fame as to restaurant services. However, the Board found the marks to be very similar, the services legally identical in part, and the trade channels and classes of consumers presumably the same. Applicant argued that Monster "uses its cafeteria mostly to feed its employees," but the Board pointed out once again that the issue of likelihood of confusion must be decided on the basis of the recitation of services in the cited registration, regardless of actual marketplace usage. Comparing the marks, the Board found the "hyperbolic term" MONSTER to be dominant in both marks. Moreover, because Monster's mark is registered in standard character form, it could be employed in the same color and stylization as the applicant's mark.

***Major League Baseball Players Ass'n and Aaron Judge v. Chisena*, 2023 USPQ2d 444 (TTAB 2023) [precedential].** Applicant Michael Chisena went down swinging in this consolidated opposition to his applications to register the word marks ALL RISE and HERE COMES THE JUDGE and the design mark shown here, for t-shirts and the like. The Board found the proposed marks to be confusingly similar to the opposers' previously used marks for overlapping goods. By the time Chisena had filed his intent-to-use applications, Aaron Judge had established himself as a star outfielder for the New York Yankees. Sports media, the Yankees, and Yankee fans had already adopted a "judicial theme" in promotional material, stadium signage, and various souvenir items referring to him: the phrases ALL RISE and HERE COMES THE JUDGE and depictions of "judicial indicia, such as a gavel, courthouse image, or the scales of justice," accompanied by his name or likeness. The Board rejected various claims made by Chisena, finding that the opposers had "standing" to bring their claims, and that the opposers' common law marks serve as trademarks and are not merely informational or ornamental because "the consuming public recognizes the subject slogans and symbols carrying judicial connotations as pointing to only one baseball player on one major league team, similar to the record in *In re Lizzo LLC*."

b. Likelihood of Confusion Not Found

***Shenzhen IVPS Technology Co. v. Fancy Pants Products, LLC*, 2022 USPQ2d 1035 (TTAB 2022) [precedential].** You might say Applicant Fancy Pants relied on the old rope-a-dope strategy in this opposition to its application to register SMOKES & Design for "cigarettes containing tobacco substitutes not for medical purposes containing only cannabis with a delta-9 THC concentration of not more than 0.3% on a dry weight basis." Opposer Shenzhen claimed likely confusion with its registered mark SMOK and several SMOK-formative marks for electronic cigarettes, parts and components thereof, and related services. Fancy Pants neither submitted testimony and evidence nor filed a brief, but the Board ruled in its favor. Shenzhen claimed to own a family of "SMOK" marks but failed to prove that the asserted family feature had acquired distinctiveness prior to Fancy Pants's effective filing date. As to Shenzen's common law marks, its testimony was "too vague and nonspecific to associate use of any of the SMOK or SMOK-formative marks . . . with any particular goods or services or with any date of use." As to Shenzen's registered mark SMOK, the dissimilarity of the marks and the weakness of the common element SMOK, together with the lack of proof that the trade channels overlap, required a finding of no likelihood of confusion.

***DC Comics v. Cellular Nerd LLC*, 2022 USPQ2d 1249 (TTAB 2022) [precedential].** The Board tossed out this opposition to registration of the word-and-design mark shown here, for "installation, maintenance and repair of cell phone related hardware," finding no likelihood of confusion with, and no likelihood of dilution of, several "'S' shield" marks associated with the "Superman" character. The Board found the marks, goods/services, and trade channels too different for purposes of likelihood of confusion, and as to the dilution claim it deemed the difference between the marks to be fatal. The Board focused on three of DC Comics' registered "'S' Shield" marks for entertainment services, comics, clothing, credit card services, and customer loyalty rebate programs. The Board found the term CELLULARNERD.com to be dominant in applicant's mark, and further that the mark as a whole "creates the commercial impression of a tech nerd ready to solve your cell phone problems in his persona as a tech nerd, as opposed to the letter 'S' shield design marks symbolizing a specific superhero." In sum, "consumers will not view the marks in their entireties as sufficiently similar to cause them to mistakenly believe there is an association with Opposer."

c. Priority

***Narita Export LLC v. Adaptrend, Inc.*, 2022 USPQ2d 857 (TTAB 2022) [precedential].** Granting Petitioner Narita Export's motion for summary judgment, the Board unsurprisingly found the registered mark TONOSAMA for gift baskets containing candy to be confusingly similar to Narita's identical common law mark for candy. The only real dispute concerned Narita's priority of use, which hinged on the validity of a *nunc pro tunc* assignment and an oral agreement. Narita submitted declarations from its president and from the former president of the company that assigned the mark to Narita. They attested to the sale of the branded candy in the United States since March 27, 2016, and they confirmed the oral assignment. Respondent Adaptrend argued that the declarations constituted inadmissible hearsay and lacked foundation, but the Board found that the declarants were "positioned to know or have access to information relevant to the substance of their respective declarations and the assignment referenced therein." The Board then made short work of the Section 2(d) claim. Adaptrend asserted a first use date of June 13, 2016. Narita's declarations established a first use date of May 27, 2016. The marks are identical, the goods overlap, and it was undisputed that the goods travel in the same channels of trade.

***JNF LLC v. Harwood Int'l Inc.*, 2022 USPQ2d 862 (TTAB 2022) [precedential].** Petitioner JNF LLC was undoubtedly unhappy with the result of its petition to cancel a registration for the mark HAPPIEST HOUR for bar and restaurant services. JNF claimed prior use of THE HAPPIEST HOUR for the identical services, but it failed to prove priority. Its evidence regarding its first rendering of services under the mark was "characterized by contradictions, inconsistencies, and indefiniteness." Its claim of use analogous to trademark use failed because its prior publicity "was not sufficiently clear, widespread and repetitive." Normally, a cancellation petitioner must prove priority by a preponderance of the evidence, but when a party claims a first use date earlier that what it alleged in its own application, "that is considered a change in position, contrary to the admission it made against interest at the time it filed the application; in these circumstances its proof of the earlier date must be clear and convincing." With regard to analogous use, a party must show prior use sufficient to create an association in the minds of the purchasing public between the mark and the services. JNF's evidence consisted of a September 7, 2014 press release, a September 2, 2014 New York Times article, and an August 24, 2014 article at Grubstreet.com. The Board was unimpressed.

***Nkanginieme v. Appleton*, 2023 USPQ2d 277 (TTAB 2023) [precedential].** After the Board sustained Opposer Nnenna Lovette Nkanginieme's Section 2(d) opposition to registration of the mark LOVETTE for handbags, the applicant requested reconsideration, contending that the Board improperly found that, because opposer obtained a registration for her pleaded mark and entered same into the record, priority was not at issue. The Board denied the reconsideration request, pointing out that, absent a petition for cancellation of the "pleaded and proven registration," priority is not an issue in a Section 2(d) dispute. Opposer Nkanginieme filed her underlying application after Applicant Appleton had filed the application here opposed. Appleton contended it was error to allow Nkanginieme "to rely solely on a registration with a constructive priority date that postdates Applicant's application by five months." Nkanginieme pointed to Rule 2.106(b)(3)(ii), which states that "[a]n attack on the validity of a registration pleaded by an opposer will not be heard unless a counterclaim or separate petition is filed to seek the cancellation of such registration." The Board pointed out that it did not make a determination of priority because Nkanginieme's registration had removed priority as an issue. In short, the Board must consider existing registrations without regard to prior use, absent a petition for cancellation of the registration.

4. Abandonment

***Vans, Inc. v. Branded, LLC*, 2022 USPQ2d 742 (TTAB 2022) [precedential].** In an exhaustive and exhausting opinion, the Board granted petitions to cancel two registrations for the mark OLD SCHOOL for various clothing items, on the ground of abandonment. The Board found that the registrant, despite claiming attempts to sell or license the mark, had discontinued use of the mark with an intent not to resume use. The Board combed through the record evidence in great detail, noting that Branded "failed to introduce any credible documents showing use of the OLD SCHOOL mark to identify clothing or sale of clothing." Nor was there any evidence of advertising. Branded's testimony regarding use was unpersuasive because of its inconsistencies, contradictions, and unspecific nature. Petitioner Vans thus established nonuse of the mark since 2008, a period of more than three years and thus prima facie evidence of abandonment. Branded could not prove its intent to resume use of its mark on the basis of its intent to sell the mark, "especially where the evidence that it 'used' the mark at all is so vague, inconsistent and unreliable." "[H]olding a mark with no use, with only an intent to sell the mark at some time in the future, is not proof of present use or intent to resume use." Indeed, such an intent is evidence of "trafficking in trademarks," which the Trademark Act seeks to prevent by deeming such an assignment invalid and the involved application or registration void.

***ARSA Distributing, Inc. v. Salud Natural Mexicana S.A. de C.V*., 2022 USPQ2d 887 (TTAB 2022) [precedential].** Finding Applicant Salud's long period of nonuse of its mark EUCALIN for nutritional supplements to be excusable, the Board dismissed this Section 2(d) opposition because Opposer ARSA Distributing was unable to prove priority. Salud, deemed a Specially Designated Narcotics Trafficker (SDNT), was banned from doing business in the United States from 2008 to 2015. Although it did not resume use of the mark for another seven years, Salud did commence TTAB litigation with ARSA in 2016 regarding ownership of the mark. ARSA established a presumptive *prima facie* case of abandonment based on Salud's admitted nonuse of the mark during any three-year period between 2008 and 2015. The Board, however, ruled that Salud's nonuse during the ban was excusable and further that Salud maintained an intent to resume use after 2016, negating the presumption of abandonment arising from its nonuse during that later period. "This is not a case where Applicant decided to cease use of its mark for business reasons. Rather, Applicant had no choice but to cease use of its mark because its use was prohibited by government sanctions …." Salud's "vigorous defense" of this opposition also supported a finding that it maintained an intent to resume use throughout the litigation.

5. Laches

***Advance Magazine Publishers, Inc. v. Fashion Electronics, Inc*., 2023 USPQ2d XXXX (TTAB 2023) [precedential].** The Board rendered a split decision in this opposition to registration of the mark EVOGUE for a wide variety of consumer electronic devices and accessories, tossing out Opposer Advance Magazine's Section 2(d) claim but partly upholding its dilution claim, based on the registered mark VOGUE for, *inter alia*, magazines and mobile phone software. Laches barred both claims as to certain of Fashion Electronics' goods in light of its ownership of an expired, unchallenged registration for EVOGUE for substantially the same goods. As to the goods not covered by the prior registration, the Board found confusion unlikely but dilution-by-blurring likely. Advanced took no action against the prior registration for more than ten years, a delay the Board deemed unreasonable. Although a laches defense may be overcome (as to likelihood of confusion but not blurring), by a showing of inevitable confusion, the marks and particularly the goods were too dissimilar to meet the heightened standard applicable to a determination of inevitability. As to the goods not subject to the laches defense (battery chargers, speaker and stereo stands, and wireless speakers), the Board dismissed the likelihood of confusion claim due to the differences in the goods, but as to dilution it found the VOGUE mark to be famous and its distinctiveness impaired by Fashion's mark EVOGUE.

6. Nonuse

***Fender Musical Instruments Corp. v. Win-D-Fender, LLC*, 2023 USPQ2d 61 (TTAB 2023) [precedential].** The Board re-designated as precedential its decision sustaining guitar-maker Fender's opposition to registration of the mark EN-D-FENDER for "musical instruments," on the ground of nonuse. The Board rejected Applicant Win-De-Fender's Hail Mary motion to amend its identification of goods to "musical instrument accessories, namely, an ambient wind foot joint guard for flute family instruments," because the amended goods exceeded the scope of the original identification. Win-De-Fender argued that its application was "qualified" by a "miscellaneous statement" entered on the TEAS application form, stating: "For Musical Instrument Accessories namely a wind guard mounted to a flute." Unfortunately, that limiting language was not included in the proper field on the form and therefore it was not considered a part of the identification of goods. Because accessories are not musical instruments, they are not encompassed within the original identification of goods, and so the Board denied the motion to amend. As to Fender's nonuse claim, Win-D-Fender's interrogatory answers supported Fender: "Applicant states the products sold under the 'En-D-Fender' mark are not musical instruments, as such products are accessories for a flute." The Board then wasted no time in granting Fender's partial summary judgment motion.

7. Ownership

***CBC Mortgage Agency v. TMRR, LLC*, 2022 USPQ2d 748 (TTAB 2022) [precedential].** The Board granted a petition for cancellation of a registration for the mark shown here for mortgage financing services, finding that Petitioner CBC Mortgage was the first and only user of the mark for those services. Respondent TMRR created and promoted the mark but it did not use the mark in rendering mortgage services, nor was it permitted to do so by the agreement between the parties. TMRR conceived of a mortgage financing program that would be run by a Native American Tribe, and it contracted with the Paiute Indian Tribe of Utah (CBC) to implement and operate the program. TMRR created the mark CHENOA FUND and the logo. In 2013 the parties signed a Management Services Agreement (MSA) to provide the program, and Petitioner CBC Mortgage was formed pursuant to the MSA. Under the MSA, TMRR is deemed CBC's "agent" and "contracted day-to-day operator." The Board found that the agreement between the parties unambiguously established the intent and expectation of the parties that CBC would solely own the CHENOA FUND mark. Furthermore, TMRR "operates behind the scenes, out of public view," while CBC Mortgage is "out front, engaging with the public via materials that identify Petitioner, and only Petitioner, as the source of the mortgage financing services rendered in connection with the CHENOA FUND mark."

8. Entitlement to a Statutory Cause of Action

***PepsiCo, Inc. v. Arriera Foods LLC*, 2022 USPQ2d 856 (TTAB 2022).** In this opposition to registration of the mark TORTRIX for "corn-based snack foods," the Board ruled that a claim for misrepresentation of source under Section 14(3) of the Trademark Act is available not just to a cancellation petitioner, but also to an opposer. However, it dismissed Opposer PepsiCo's Section 14(3) claim due to the insufficiency of its allegations. A plaintiff may plead "entitlement based on reputational injury or lost sales provided that the plaintiff establishes a reputational interest in the United States." PepsiCo did not plead lost sales but did claim injury to its reputation in the United States, and further claimed that it will not be able to register its TORTRIX mark in this country if the opposed application matures to registration. It alleged that it has used the mark TORTRIX for years in Central and South America for corn-based snack foods, and owns several registrations for that mark in a number of countries. The Board found that PepsiCo had failed to plead "a plausible entitlement to relief." PepsiCo's allegations that Arriera "intends to make, or is making, blatant misuse" of the TORTRIX mark were mere speculation.

***Ahal Al-Sara Group for Trading v. American Flash, Inc.*, 2023 USPQ2d 79 (TTAB 2023) [precedential].** The requirement that a plaintiff in a TTAB proceeding plead and prove its entitlement to a statutory cause of action (formerly called "standing") is a low threshold, but a critical one. Petitioner Ahal Al-Sara Group sought cancellation of a registration for the mark shown here for various cleaning products, claiming abandonment and fraud, but it failed to

identify an interest that falls within the "zone of interests of the Trademark Act" and thus failed to sufficiently plead its entitlement to a statutory cause of action. A plaintiff must plead facts that, if proved, demonstrate a "real interest" that affects U.S. commerce. Here, the petition relied only on challenges to petitioner's foreign marks in foreign proceedings. "Petitioner has not pleaded a presence in the United States. Petitioner does not contend that its interests involve selling or manufacturing goods within the United States, and Petitioner has not filed any U.S. trademark applications to register FIGHTER FLASH or AMERICAN FLASH or any variations thereof. Nor does Petitioner plead an intent to enter the U.S. market in the future, or any other facts that if proved, would demonstrate an interest related to or affecting U.S. commerce falling within the scope of protection under the Trademark Act."

***Curtin v. United Trademark Holdings, Inc.*, 2023 USPQ2d 535 (TTAB 2023) [precedential].** Unsurprisingly, the Board dismissed Professor Rebecca Curtin's opposition to registration of the mark RAPUNZEL for dolls and toy figures, finding that Curtin, as a mere consumer of fairytale-themed products, failed to prove her entitlement to a statutory cause of action. "A plaintiff may oppose registration of a mark when doing so is within the zone of interests protected by the statute and she has a reasonable belief in damage that would be proximately caused by registration of the mark." In *Lexmark*, the Supreme Court pointed out that "[i]dentifying the [zone of] interests protected by" the Trademark Act "requires no guesswork." Section 45 of the Act identifies those interests: in short, the Trademark Act "regulates commerce and protects plaintiffs with commercial interests." In addition to satisfying the "zone of interests" requirement, Curtin had to show "economic or reputational injury flowing directly from" Applicant's registration of RAPUNZEL. Here, Curtin's evidence of the damage she would allegedly suffer was "too remote from registration and is entirely speculative." Furthermore, the Board pointed out, "registration would at most preclude others from using RAPUNZEL as their own source indicator for such products, subject to defenses such as 15 U.S.C. § 1115(b)(4) (creating a defense to infringement where the 'term or device … is descriptive of and used fairly and in good faith only to describe the goods and services of such party')."

9. Procedural Issues

a. Claim Preclusion

***Flame & Wax, Inc. v. Laguna Candles, LLC*, 2022 USPQ2d 714 (TTAB 2022) [precedential].** Petitioner Flame & Wax found itself on the short end of the candlestick when the Board denied its petition for cancellation of a registration for the mark LAGUNA CANDLES for "aromatherapy candles; candles; scented candles," finding that the mark had acquired distinctiveness and therefore was not primarily geographically descriptive of the goods. The Board rejected petitioner's invocation of the doctrine of claim preclusion based on its earlier successful opposition to respondent's prior application to register the same mark, finding that this cancellation proceeding involved a different set of transactional facts. In 2013, the TTAB sustained Flame & Wax's opposition to the same mark for candles on the ground of geographical descriptiveness. Four months later, respondent filed a new application, claiming acquired distinctiveness under Section 2(f). The Board found no case in which an applicant claimed acquired distinctiveness in a second application filed only four months after a successful opposition. Nonetheless, the Board ruled that additional evidence "establish[ed] a recognizable change of circumstances from the time of trial in the Prior Opposition and the time of trial in the cancellation."

b. Issue Preclusion

***Empresa Cubana Del Tabaco d.b.a. Cubatabaco v. General Cigar Co., Inc.*, 2022 USPQ2d 1242 (TTAB 2022) [precedential].** In the latest round of this 25-year-old battle, the Board granted a petition for cancellation of two registrations for the mark COHIBA for "cigars," on the ground of violation of Article 8 of the Pan American Convention. The evidence showed that Petitioner Cubatabaco enjoyed legal protection of the COHIBA mark in Cuba prior to General Cigar's constructive first use date in the United States, and that General Cigar had knowledge of Cubatabaco's use of the mark in Cuba prior to filing its underlying applications. The issue, then, was whether the Article 8 claim was barred under the doctrine of issue preclusion in light of the past federal court litigation between the parties. The Board said no. The CAFC had already held (in 2014) that the issue decided in the litigation—whether § 44(h) of the Act incorporated Article 8 claims—is not the same as the Article 8 issue here, and therefore issue preclusion was inapplicable. General Cigar argued that the Supreme Court's subsequent ruling in *B&B Hardware v. Hargis* effected a change in the law that permitted another review of the preclusion question. The Board, however, was not persuaded that *B&B Hardware* changed the law. Moreover, that case "addressed an entirely different issue: 'whether the District Court in this case should have applied issue preclusion to the [Board's] decision,' . . . not vice versa."

c. Correction of Ownership

***Phat Scooters, Inc. v. Fatbear Scooters, LLC, Isaac Ashkenazie and Isaac D. Ashkenazie d/b/a Fatbear Scooters*, 2023 USPQ2d 486 (TTAB 2023) [precedential].** The underlying application for the registered mark FAT BEAR for motor scooters was filed in the name of Fatbear Scooters, LLC on December 19, 2019, but that entity did not exist as of the filing date. Petitioner Phat Scooters moved for partial summary judgment on its claim that the registration is void ab initio because the application was not filed by the rightful owner of the mark. In response, one of the co-owners confirmed that the belated incorporation was due to an "oversight," but they intended to create the entity at the same time the application was filed. He further averred that he and his cousin started the business in about November 2019, that it has continued to the present under the same ownership, and that no other entity has owned or used the FAT BEAR mark. The Board construed the response to the summary judgment as a "cross-motion to amend the registrations due to a correctable owner's mistake." The Board found that chain of title in the same, single commercial enterprise existed between the LLC and the co-owners (d/b/a Fatbear Scooters), and it allowed the respondent to correct the misidentification because the error was "inadvertent, made in good faith, and has been formalized through the filing of and issuance of the limited liability certificate."

d. Sanction for Spoliation

***Rapid Inc. v. Hungry Marketplace, Inc.*, 2022 USPQ2d 678 (TTAB 2022) [precedential].** Finding that Opposer Rapid Inc.'s star witness "had not only been dishonest with the Board, but … also engaged in spoliation of evidence," the Board threw out this Section 2(d) opposition. Rapid claimed priority of use of its mark HUNGR for food ordering application software, and likelihood of confusion with applicant's proposed mark HUNGRY for overlapping software. Rapid's witness "engaged in a pattern of fabrication and spoliation of evidence, which vitiates the probative effect of his testimony and evidence, and taints the remainder of evidence that might otherwise indirectly support Opposer's claim of priority." Invoking the legal maxim "*falsus in uno, falsus in omnibus*" (false in one thing, false in everything), the Board looked askance at his remaining testimony. Furthermore, the Board found that opposer's third-party witnesses, "while perhaps intending to testify truthfully about the dates on which they purportedly first used or became familiar with Opposer's HUNGR app, merely signed the declarations based on the advice of or their relationship with the 'star witness' without having any independent recollection of the specific dates to which they testified." Unable to prove priority, Rapid's claim failed.

e. Unpleaded Claim

***Kimberley Kampers IP Pty Ltd v. Safiery Pty Ltd*, 2022 USPQ2d 1036 (TTAB 2022) [precedential].** In seeking cancellation of a registration for the mark KIMBERLEY KAMPERS for campers, the petitioner moved for summary judgment on the grounds of non-ownership and abandonment, but it failed to meet its initial burden to make a prima facie case. The Board therefore denied the motion as to those grounds, but in light of the petitioner's evidence regarding nonuse during the three-year statutory abandonment period, the Board chose to consider nonuse (though unpleaded) as a separate ground for summary judgment, and it set a schedule for briefing that issue. Petitioner claimed that it could meet its initial burden to prove a prima facie case "by showing that there is an absence of evidence supporting the nonmoving party's case." Wrong, said the Board. "[W]here, as here, 'the *moving* party will bear the burden of persuasion at trial, that party must support its motion with credible evidence—using any of the materials specified in [Fed. R. Civ. P.] 56(c)—that would entitle it to a directed verdict if not controverted at trial.'" (Emphasis by the Board). Here, petitioner failed to meet its burden of production on either claim. The Board observed that it is not its practice to consider an unpleaded claim on summary judgment, but in this "unusual situation" it chose to do so, finding that petitioner's allegations of abandonment were sufficient to put the respondent on notice of the issue of nonuse.

f. Explanation for Partial Abandonment

***Rifai (Shenzhen) Smart Technology Co. v. Shenzhen Chengyan Science and Technology Co.*, 2022 USPQ2d 1035 (TTAB 2022) [precedential].** After the commencement of this proceeding for cancellation of a registration for the mark DISO for various electronic devices, on the grounds of fraud and abandonment, the registration was subject to a USPTO audit regarding respondent's Section 8 Declaration of Use. The audit resulted in deletion of many of the identified goods. The Board observed that a registrant may not, by deleting goods from a registration, moot a proceeding to avoid a judgment as to the deleted goods. It allowed respondent 20 days to explain the reason for its deletions. Trademark Rule 2.134(b) applies when a respondent permits its registration to be cancelled under Section 8 during the pendency of a cancellation proceeding. Here, only certain goods were deleted from the registration. The Board held that Rule 2.134(b) still applied: "by deleting certain goods subject to this cancellation, Respondent may not moot this proceeding and avoid judgment as to the deleted goods. As set forth in TBMP § 602.02(b), we require Respondent's response regarding the deletion of goods as it relates to abandonment." Depending on respondent's explanation, the Board may or may not enter judgment as to the deleted goods.

g. Page Limit for ACR Brief

***Rasa Vineyards, LLC v. Rasasvada, LLC*, 2022 USPQ2d 769 (TTAB 2022).** The Board re-designated as precedential an interlocutory order in this Section 2(d) opposition involving the mark RASASVADA for alcohol and spirits. The parties had stipulated to proceed under the Accelerated Case Resolution (ACR) regime. When Applicant Rasasvada filed a 41-page brief (including table of contents), Opposer Rasa Vineyards moved to strike. Facing the Board was the question of whether the normal 55-page final brief limit of Rule 2.128(b) applied, or whether the summary judgment limit of 25 pages applied (Rule 2.127(a)). The parties had agreed to submission of the case "through ACR briefing in a cross-motion for summary judgment format," and therefore the Board said the latter Rule applied: "The parties clearly stipulated to submission of their briefs in summary judgment format and the page limits of a motion for summary judgment apply." The Board granted Rosa Vineyards' motion to strike the brief as "overlength," but it allowed Rasasvada one day to re-submit a brief limited to 25 pages, and Rasasvada did so.

h. Timeliness of Discovery Requests

***OMS Investments, Inc. v. Habit Horticulture LLC*, 2022 USPQ2d 1074 (TTAB 2022) [precedential].** In another questionably precedential Order, the Board ruled on several discovery-related motions in this opposition to registration of the mark GROMEO for "Planters for flowers and plants; Self-watering planters for flowers and plants." Applicant Habit moved to compel a deposition and to extend its time to respond to OMS's discovery requests. First the Board rejected opposer's claim that Habit's reply brief was untimely, but it then denied Habit's motion to compel because it was filed prematurely (OMS had not "clearly or unequivocally stated that it would not designate or produce a witness for the noticed deposition") and because Habit failed to make the required good faith effort to resolve the dispute prior to filing its motion. The Board then denied Habit's motion to extend the time for responding to OMS's discovery requests. Habit contended that it should not have to respond to the requests until after the Rule 30(b)(6) deposition of Habit in order to "maintain the status quo," – i.e., Habit noticed its deposition first. The Board rejected that argument because discovery is not governed by the concept of priority and one party's discovery obligations are independent of the actions of the other party.

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