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Pre-Filing Evaluation and Strategies

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The decision whether to file an opposition or cancellation action with the Trademark Trial & Appeal Board (TTAB), or to institute a lawsuit for trademark infringement in federal court, is one of the most basic calls a trademark practitioner must make, but it is also one of the most complex. It requires not only a thorough understanding of the Lanham Act¹ and the Trademark Rules of Practice (TMRP), and the TTAB Manual of Procedure (TPMB),² but an in-depth investigation and evaluation of the facts and an appreciation of your client's business needs and goals. Ignoring or shortchanging any of these elements will make you unable to effectively advise your client.

While the factual scenarios that can lead to a potential opposition, cancellation, or lawsuit are literally endless, the following presents a typical situation:

You have represented a chain of Tex-Mex casual dining restaurants called "Mama Masa's" for several years. Your client, Mama, is a former Mexican migrant farm worker, who has achieved the American dream: she started out preparing and selling lunches for her fellow farm workers from a roadside stand, got her citizenship, and in 1990 opened up the first Mama Masa's Tex-Mex restaurant in North Carolina, where many other Mexican farm workers live. The restaurant became very successful, and she started franchising, and now has franchised restaurants in six southern states, with current plans to expand into the southwest and eventually California. Her most famous menu item is her "Smokin' Chipotle Masadillas®," a unique quesadilla dish

made with corn tortillas and a chipotle chile/black bean filling. This item is her signature dish—it was the item she first started selling to her fellow farm workers, and its popularity led her to open her first restaurant. She coined the name "Smokin' Chipotle Masadillas" for the dish shortly after she opened her first restaurant, and she obtained a federal trademark registration for the name in 1996 for "Mexican-style quesadilla entrée or appetizer made with corn tortillas" as part of her preparations for franchising. Over the years, other "Masadilla" dishes, which are variations on the basic corn tortilla quesadilla idea, have appeared on the Mama Masa's menus, such as Chicken Masadillas, Poblano Chile Masadillas and, inevitably, Sun-Dried Tomato and Goat Cheese Masadillas. While she has never obtained a federal trademark registration for the just the word "Masadilla," these dishes are listed on her menus with the "TM" superscript designation on the word "Masadilla."

In his weekly review of the Official Gazette,³ your paralegal has found that a major fast food restaurant chain has filed a use-based application for registration of the word "Masadinga" in Class 29 (Meats and Processed Foods), for "Mexican-style grilled sandwich made with corn tortillas and a variety of fillings." The date of first use is very recent—less than three months prior to the application. Your paralegal reports that the fast food restaurant's Web site shows a picture of a square, yellow-colored sandwich with a salsa-type filling and an imitation sour cream dipping sauce on the side. The sandwich is labeled as "Our New Masadinga—a Mexican Treat That's Neat To Eat." According to the Web site, the "Masadinga" sandwiches are currently being sold in the fast food chain's outlets in the northeastern United States, and will be available nationwide in the next six months. The sandwiches do not yet appear on the menus of the fast food chain's local restaurants, and you have not seen any print or broadcast advertising of the product.

First Steps⁴

After informing your client of the publication of the "Masadinga" application for registration, you need additional time to gather information so that you can counsel her on the best course of action. Fortunately, the Lanham Act and the TMRP allow a potential opposer this additional time, but it is crucial to make your request in a timely manner—you have 30 days from the date of publication in the Official Gazette to decide to either file an Opposition or request an extension of time.⁵ Recently revised as a part of the rule changes implementing the Madrid Protocol, the new procedures for obtaining extensions of time to oppose are now a trap for the unwary. There are only two options. You may initially file for either: 1) a 30-day extension of time which will be granted automatically; or 2) a 90-day extension of time, which will be granted for "good cause." After obtaining a 30-day extension, you may then request an additional 60 days upon a showing of "good cause." Once a total extension of 90 days has been granted, a final request for an additional 60 days may be granted either: (a) upon consent or stipulation of both parties; or (b) a written request by the potential opposer upon a showing of "extraordinary circumstances." No further extensions will be granted, so after 180 days you must file an opposition or let the matter go. No longer can the parties stipulate to additional extensions of time to work out an amicable agreement and avoid instituting formal opposition proceedings.⁶

It is also important to remember that the first request for extension of time can be for a total of 60 days, as long as you include your "good cause" recitation for the second 30 days in your initial request. Clearly, it will be nearly impossible to initiate and conclude an investigation, advise your client on her options and get a going-forward decision from your client, all in just 30 days, so it makes sense to request a 90 day extension at the outset if there are serious grounds (a "good cause") for opposition.

Finally, on being informed of the "Masadinga" application for registration, your client's first instinct may be to immediately send out a cease and desist letter, or a letter requesting abandonment of the application, to the fast food restaurant chain. These types of letters can be very effective at the preliminary stage, particularly if a competitor has filed an ITU application,⁷ because they may flush out what was merely a "trial balloon" by the applicant. However, and especially in light of the disparity in size and resources between your client and her competitor, it is important to proceed cautiously. While not a concern with an ITU application, because ITU applications can only be opposed before the TTAB, an overly aggressive cease and desist letter against a party making commercial use of a mark that threatens potential litigation could prompt the other side to file a federal declaratory judgment action against your client.

Moreover, while not the majority rule, some jurisdictions have found that even the threat of a TTAB action can provide grounds for a declaratory judgment suit.⁸ Thus, the key is to know the law in your jurisdiction and your competitor's, and to try to get some preliminary information that may give you some insight into how "invested" the competitor is in going forward with obtaining the registration and marketing the product. In this case, the fast food restaurant chain has only introduced the new sandwich in a few markets to date, but appears to be intending to proceed with a nationwide rollout. Clearly, Mama has cause for concern, but she must proceed very carefully.

Grounds for Opposition

The Lanham Act states only that "Any person who believes that he would be damaged by the registration of a mark" may file an opposition.⁹ While there are many, many decisions interpreting the Act's standing requirement, in general, courts and the TTAB have limited the class of persons with standing to oppose a registration to competitors and those with "a personal interest in the outcome beyond that of that general public."¹⁰

The grounds for opposing the registration of a trademark, while not explicitly spelled out as such, are logically the same grounds the PTO would use in refusing a registration and are found in Section 2 of the Lanham Act.¹¹

Sections 2(a) through 2(c) are not widely used as grounds to oppose a registration. Likewise, Section 2(f) is not frequently used as grounds for opposition, since it requires the applicant to show that the mark is already "distinctive of the applicant's goods in commerce," as demonstrated by five years of "substantially exclusive and continuous use." In other words, if your client wants to oppose a Section 2(f) application, she needs to show that the applicant's evidence of secondary meaning is insufficient to prove that the term has acquired distinctiveness.

Section 2(e) presents several interesting issues when deciding whether to oppose a registration. While you would hope (and expect) a Trademark Examiner to refuse many of these applications (such as "Mexico City Taco Shells" for a competitor located in Buffalo, NY), many registrations for marks that are arguably merely descriptive are allowed. And even if a competitor seeks registration of a descriptive term that is not particularly similar to one of your client's trademarks, there still may be reason to oppose the registration. For example, if your client manufactures cleaning products, and a competitor is trying to register the term "Fresh Mop" for a cleaning product, you may want to oppose the application to prevent the competitor from trying to take that expression out of circulation, thereby interfering with your client's

use of that expression to describe its product in future advertising.

Section 2(d), "likelihood of confusion," is the most frequent grounds for opposition, and is the most likely basis for Mama's opposition of the "Masadinga" application. The factors for determining likelihood of confusion are not found in the Lanham Act, but are judicially-created. While each federal circuit court of appeals has its own variations of the factors to evaluate, the TTAB is required to use the test adopted by its reviewing court, the Court of Appeals for the Federal Circuit. That test is set out in the case *In re E.I. DuPont de Nemours and Co.*¹² The 13 *DuPont* factors that the TTAB ostensibly evaluates to determine whether there is a likelihood of confusion are:

1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
2. The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
3. The similarity or dissimilarity of established, likely-to-continue trade channels.
4. The conditions under which and buyers to whom sales are made, *i.e.* "impulse" vs. careful, sophisticated purchasing.
5. The fame of the prior mark (sales, advertising, length of use).
6. The number and nature of similar marks in use on similar goods.
7. The nature and extent of any actual confusion.
8. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
9. The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark).
10. The market interface between applicant and the owner of a prior mark:
 - a. a mere "consent" to register or use.
 - b. agreement provisions designed to preclude confusion, *i.e.* limitations on continued use of the marks by each party.
 - c. assignment of mark, application, registration and good will of the related business.
 - d. laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.
11. The extent to which applicant has a right to exclude others from use of its mark on its goods.
12. The extent of potential confusion, *i.e.*, whether *de minimis* or substantial.
13. Any other established fact probative of the effect of use.

However, the TTAB generally focuses on only the similarity of the applicant's and the opposer's marks visually and/or orally, and the similarity of the prod-

ucts or services to be identified by the marks: the "sight, sound and meaning" trilogy.¹³ Nevertheless, you should conduct a preliminary inquiry into all the *DuPont* factors before advising your client on her options—if she is considering a lawsuit in federal court, demonstrating likelihood of confusion requires not only a thorough fact investigation of the applicant's current use and planned use of the proposed mark, but a significant effort by your client to establish the strength of her own mark.

Finally, Section 2(f) of the Lanham Act¹⁴ has recently been amended to also provide that an application for registration can be opposed if it "when used would cause dilution under section 43(c), the Federal Dilution Act."¹⁵ And while dilution can be raised as grounds for an opposition or cancellation action before the TTAB, it is probably not worth the effort. In a lengthy decision, the TTAB determined that the mark TORO was not famous (and therefore could not meet its preliminary showing under the Federal Dilution Act) even in the niche market of lawn equipment and sprinkler systems, and also questioned whether "niche" fame was sufficient to support a claim for dilution.¹⁶ Thus, the TTAB has set the bar very high for any trademark owner hoping to challenge an application or registration on dilution grounds. More recently, the US Supreme Court also significantly limited the application of the Federal Dilution Act in its decision *Moseley, et al., d.b.a. Victor's Little Secret, v. V Secret Catalogue, Inc.*¹⁷ In that decision, the Court required a showing of *actual* damage from "blurring and eroding the distinctiveness" of the famous mark, which renders the anti-dilution statute essentially useless in a situation where a trademark owner is challenging a relatively recent use of a non-identical mark in federal court.

Grounds for Cancellation

Section 14 of the Lanham Act¹⁸ governs petitions for cancellation before the TTAB. Cancellations are similar to opposition proceedings, with the obvious difference that registration of the competitor's trademark has already been allowed. As with oppositions, a petition to cancel a registration may be filed by "any person who believes that he is or will be damaged . . . by the registration of a mark." And, as long as the trademark has been registered less than five years, a competitor can seek to cancel the registration on the same grounds that could have been used for an opposition. Thus, if you missed filing an opposition by one day, or by four years and 364 days, you can immediately file a petition to cancel the registration on any of the grounds upon which you could have filed an opposition. However, certain evidentiary presumptions will be allowed to your client's competitor, inasmuch as registration of the competitor's trademark on the principal register "shall be *prima facie*

evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate."¹⁹

After the first five years of registration, a petition for cancellation cannot be based on any of the Section 2 grounds discussed above. However, there are a number of other grounds upon which a cancellation can be based at any time, and these grounds should also be considered by a client, such as Mama, who is trying to decide how best to challenge an application for registration. Why? Not only do these factors provide additional grounds upon which your client can base a cancellation action, but (and perhaps more significantly) your client's competitor can counterclaim, in either an opposition or a lawsuit, to cancel any registration your client pleads in her petition or complaint if any of these factors arguably apply:

- Your client's mark has become generic;
- Your client's mark has been abandoned;²⁰
- Your client's mark was obtained fraudulently;
- Your client's mark is being used to misrepresent the source of the goods or services on which it is being used; or
- Your client's mark is merely "functional" (always an issue if your client's mark is for trade dress).

Thus, you are not fully counseling your client if you do not also analyze your client's registrations for any "warts" that could lead to a counterclaim for cancellation.

Choice of Forum

Before you can advise your client whether to proceed in an action before the TTAB or in federal court, your client needs to understand what remedy each forum can provide, and the type of proof necessary to make a successful challenge. Clients are often surprised that the sole function of the TTAB is to rule on whether the applicant is entitled to obtain a registration in an opposition proceeding, or maintain a registration in a cancellation proceeding. The TTAB has no authority to prevent a competitor from continuing to use the mark on its goods and services, even if it finds that the registration should be refused or cancelled. Only a federal district court can actually enjoin a party from using a trademark for its goods and services, and the federal courts also have the authority to cancel a trademark registration.²¹

However, the federal courts do not have the authority to refuse a registration, absent a claim of infringement. Thus, if the registration of a mark is the sole issue, the TTAB is the only forum in which to proceed. Likewise, if the only relief your client is seeking

is cancellation of the competitor's registration, then there is no federal court jurisdiction and your client must proceed before the TTAB.

As noted above, the TTAB's analysis of likelihood of confusion—and the proof required to show it—differ in significant ways from a federal court's analysis. The TTAB looks only to the application and file history before it, and analyzes and compares only the actual mark that appears in the application or registration. Thus, unless there is a restriction in the good's description (such as "canned vegetables sold to institutional users"), the TTAB presumes that your client's goods and those of the applicant will travel in the same channels of trade and be sold to the same customers for the same purposes. For example, if someone is seeking to register the word "SLIDE" for detergent, and they are opposed by the owner of the TIDE registration for detergent, the TTAB will look at the marks and words alone, the goods covered by the registration and the application, and then analyze whether there is a similar sound, appearance, or meaning for purposes of determining likelihood of confusion. And, it is likely that the application would be refused in such a situation, based on that limited review.

On the other hand, if someone begins selling SLIDE detergent in the marketplace, and they are subsequently sued for trademark infringement by the makers of TIDE, a court will look at the advertising, the packaging, whether the name of the producer appears on the package, and all other factors surrounding the actual marketing and appearance of the two marks in order to determine if consumers are likely to be confused. Accordingly, if SLIDE is sold in a black package with purple lettering and a picture of a child going down a slide into a mud puddle, a court may well find that there is no reasonable possibility of consumer confusion between SLIDE and TIDE detergent sold in an orange box with a bull's eye and blue dot in the middle. Similarly, if SLIDE is sold only to members of a consumer-goods cooperative who purchase the co-op's products from a catalogue rather than in a grocery store, a court may find that the different channels of trade are such that consumers would not be confused.

This difference in analysis means that the TTAB is more likely to find a likelihood of confusion and deny or cancel a registration, whereas a court in making an overall marketplace analysis of two products will require a plaintiff to come forward with much more proof of likely (or actual) customer confusion before enjoining a competitor and ordering them to remove their product from the marketplace. It also means that your client cannot assume that a decision by the TTAB sustaining her objection to registration of her competitor's mark is any guarantee that a federal court will grant her an injunction to stop that competitor from actually using that mark in the market-

place.²² In short, you must advise your client that a successful opposition may not be the end of the story.

Given the limited relief available from an action before the TTAB, is there ever any advantage to pursuing and opposition or cancellation proceeding? Certainly in the case of an ITU application, where there is no use claimed, opposing the application is the only option. Success before the TTAB is likely to cause the applicant to drop the application and not adopt or use the potentially infringing mark. Or if the registrant has made only limited use, and has fewer resources and a smaller potential market than your client, a cancellation action may be a more cost-effective means of "convincing" the competitor to stop using the mark. However, if the competitor has been using a common law trademark for several years, and has developed a significant market for its product, it is unlikely that the competitor will cease use, even if your client is successful in an opposition proceeding. Similarly, if the competitor has the resources and intention to initiate a nationwide rollout of a new product, a cancellation proceeding will not have the "teeth" necessary to prevent the planned use.

Fact Investigation

Regardless of whether your client ultimately decides to pursue a TTAB action or a lawsuit in federal court, certain basic facts need to be obtained prior to proceeding. It is essential to get the applicant's file history from the PTO. The file history will show any office actions,²³ any other marks that have been cited against the application, any supplemental filings by the applicant, specimens that will show how the applicant is using the mark in commerce (for use-based applications), and (in the case of a cancellation proceeding), whether the mark has ever been the subject of any other enforcement proceedings. Another valuable resource is a full trademark search report, which will show to what extent other similar marks are registered and/or are in use in the marketplace. Obviously, your client's success in opposing a mark with many similar co-existing marks (including your client's) is not as great as it would be if there were few or no similar marks in use or on the Register. An investigation of the applicant's Internet Web site can provide valuable information about the applicant's business, marketing channels, and the potential value of the proposed mark to the applicant's overall business plan. It is also important, and relatively easy, to obtain information on the applicant's past litigation experience to determine whether they are aggressive, either in prosecution or defense, or if they are litigation-averse. A private investigator can also obtain information on the extent of the applicant's use of the mark, including product samples, price lists, and other information that may only be available to the competitor's customers and suppliers. Finally, once

an action is filed before the TTAB or in federal court, you will be able to obtain information from the competitor via written discovery and deposition testimony.

Your client cannot ignore her own obligation to present evidence on the strength of her own mark. Indeed, such evidence is part of the opponent's or plaintiff's *prima facie* case. Thus, your client must be prepared to provide evidence of product sales figures, advertising expenditures to promote products marketed under your client's trademark, examples of print and broadcast advertising, information on market channels and geographic reach of the product, any research demonstrating consumer and marketplace recognition of your client's product, actual testimony on historical use of the mark and any other information which would demonstrate the overall strength and fame of your client's mark in the applicable marketplace. Obtaining this type of information can require your client to make a substantial investment of time and personnel resources—another factor she must consider in deciding on the extent to which she wishes to challenge her competitor's application for registration.

While it is not necessary to show actual confusion to successfully oppose or cancel a registration in a TTAB proceeding, anecdotal evidence of actual consumer confusion can be extremely valuable. Accordingly, it is important to alert your client to inform her business personnel to document any instances of consumer confusion, such as inquiries about the competitor's mark or requests for products from your client under the competitor's product name, and to be prepared to provide testimony regarding contacts with confused consumers.

Finally, while consumer surveys showing likely confusion in the target market are *de rigueur* in civil litigation, they are not generally necessary for TTAB proceedings, in large part because of the more limited scope of the TTAB's analysis.²⁴ The expense of a good survey, at least \$75,000 to \$100,000, must be factored in by any client who is considering pursuing a lawsuit in federal court, however.

Business Considerations

As should be clear by now, the decision to pursue an opposition, cancellation, or lawsuit has many factors beyond simply meeting the legal requirements. What resources of time and money is your client willing to commit to the process? An action before the TTAB, while less expensive than a lawsuit, can take several years from filing to resolution. A lawsuit in federal court can be resolved more quickly, but generally at greater expense. And while you must advise your client as to the strength and weaknesses of her case from a legal standpoint, from a purely business per-

spective, your client should ask herself the following questions:

1. What do I hope to accomplish?
2. Is refusal or cancellation of the contested mark sufficient?
3. How important is my trademark to my overall business plan, both now and in the future?
4. Is there really a chance of consumer confusion? If so, will that confusion hurt my product or adversely impact my sales?
5. Can my use of the mark coexist with my competitor's proposed use? Is compromise possible?
6. If I don't contest this competitor's application now, have I made my trademark vulnerable to additional third party uses from other competitors in the future?

Your client then needs to factor her answers to these business questions with your legal assessment of her chances for success in order to make a well-informed decision as to the best course of action.

What about Mama?

So what should Mama do? From a purely legal standpoint, because her competitor has made a used-based application, she can bring either an opposition action before the TTAB or an action for infringement in federal court on the grounds that there will be a likelihood of consumer confusion between her competitor's proposed mark "Masadinga" and her registered trademark, "Smokin' Chipotle Masadillas®". But it is clear that additional fact investigation is necessary, as well as some hard business decisions.

First, a preliminary analysis under the *DuPont* factors shows that some favor Mama, but some do not. For example, under the "sight, sound and meaning" test, there is undoubtedly similarity between the names "Masadinga" and "Masadilla." They sound and look similar, and the names will be used on similar products. Indeed, these similarities may be enough for the TTAB to refuse registration. The products will be sold in similar, although not identical, trade channels: Mama's restaurants are "casual dining" establishments, not fast food restaurants—a distinction that is of more importance in a lawsuit than in an opposition proceeding. And, as inexpensive, consumable food items, consumers will not scrutinize their selections in a "careful, sophisticated" manner.

Finally, while the competitor's limited use to date of the Masadinga name has likewise limited any instances of actual consumer confusion, it clearly has the capability of saturating the market with a nationwide product rollout that could confuse Mama's customers in the markets where her restaurants are currently located, and in the markets into which she is planning to expand.

On the other hand, Mama's competitor could argue that trademarks incorporating the word "masa," which roughly translates to "corn meal" or "flour," to describe a Mexican food product are relatively common and, therefore, weak.²⁵ Another potential weakness is the fact that Mama's trademark registration is for the phrase "Smokin' Chipotle Masadillas," and not for the single word "masadilla," thereby lessening the similarity of "sight, sound and meaning" between the two trademarks in the form in which they are presented to consumers.

Thus, you and Mama must consider how (or whether) these potential weaknesses can be overcome, as well as how (or whether) Mama can establish the strength and fame of her mark in her current marketplace. This task may be easier in a federal lawsuit in her home district, with live testimony before a judge who may have actually eaten at one of her restaurants, than in the sterility of a TTAB proceeding, where testimony comes in only through testimonial deposition transcripts. But before Mama places too much faith in a perceived hometown advantage, she needs to know what her competitor's marketing plans are for its "Masadinga" sandwich, and whether an amicable business solution is possible.²⁶ Ideally, these business discussions should happen before any concrete action is taken, since parties' positions tend to harden the more money is spent on legal fees.

Thus, the answer to the question, what about Mama, is a resounding "it depends." One of the most fascinating aspects of trademark practice is its highly fact-dependent nature. Obviously, the successful practitioner must know the formulas and tests, and understand the rules of practice and statutes. But good client counseling does not translate into automatically turning on the litigation machine every time it is possible to do so. Instead, the practitioner who can also develop and analyze the specific facts of his client's particular situation, and listen to and understand his client's business objectives, will provide superior counseling and insure favorable results for his clients, regardless of the forum.

1. 15 U.S.C. § 1051 *et seq.*
2. Both the TMRP and the TPMB are available at the US Patent & Trademark Office (USPTO) Web site, www.uspto.gov.
3. The Official Gazette is a weekly publication of the USPTO, which (among other things) publishes all new trademark applications received by the USPTO that week.
4. Obviously, the first step in deciding whether to oppose an application where use is claimed is to check the claimed date of first use on the application against the date of your client's first use. The last thing you want to do is file an opposition against someone who has claimed use

for ten years when your client has a one year old registration based on use that began three years ago. This would very likely lead to a counterclaim by the applicant to cancel your registration on the grounds that the applicant has priority and that there is, indeed, a likelihood of confusion between the two marks.

5. 15 U.S.C. § 1063, TMRP 2.102.
6. TMRP 2.102(c). While it can be difficult to make a satisfactory showing of extraordinary circumstances before the TTAB, tardy potential opposers can take some comfort in knowing that if they miss the dead-

- line to file an Opposition, they can still file a Petition to Cancel immediately after the issuance of the registration.
7. Section 1(b) of the Lanham Act, 15 U.S.C. § 1051(b), permits an applicant to file an application for registration on the Principal Register if the applicant has "a bona fide intention to use the mark on the goods or services listed." This is known as an "TTU" application for registration.
 8. *Compare* Chesebrough-Pond's Inc. v. Faberge, Inc., 666 F.2d 393, 396 (9th Cir. 1982) (Defendant's letter sent to plaintiff declaring its intent to file opposition proceedings stated a prima facie case for trademark infringement; thus plaintiff had a real and reasonable apprehension of litigation such that case presented an actual controversy) with *Progressive Apparel Group v. Anheuser-Busch, Inc.*, 38 U.S.P.Q.2d 1057 (S.D.N.Y. 1996) ("filing of an opposition in a trademark registration proceeding 'is not by itself a charge or warning of a future charge of infringement' and therefore does not, without more, create an actual controversy), citing *Topp-Cola Co. v. Coca-Cola Co.*, 314 F.2d 124, 125-126 (2d Cir. 1963); *accord*, *National Cable Tel. v. American Cinema*, 937 F.2d 1572, 1581 (Fed. Cir. 1991) ("An objection to registration does not legally equate with an objection to use, that is, a charge of infringement."):
 9. 15 U.S.C. § 1063.
 10. *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 U.S.P.Q.2d 2021 (Fed. Cir. 1987); *see also* *Estate of Biro v. Bic Corp.*, 18 U.S.P.Q.2d 1382 (T.T.A.B. 1991).
 11. 15 U.S.C. § 1052 (a)-(f). Section 2 states (in pertinent part): No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—
 - (a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 2(9) of the Uruguay Round Agreements Act [19 USC §3501(9)]) enters into force with respect to the United States.
 - (b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.
 - (c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.
 - (d) Consists of or comprises a mark which 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.
 - (e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 4 [15 U.S.C. § 1054], (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them, (4) is primarily merely a surname, or (5) comprises any matter that, as a whole, is functional.
 - (f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made.
 12. *In re E.I. DuPont de Nemours and Co.*, 476 F.2d 1357 (C.C.P.A. 1973).
 13. *See* 2 J. McCarthy, *Trademarks and Unfair Competition* 23:4 (2d ed. 1984).
 14. 15 U.S.C. § 1052(f).
 15. "A mark which when used would cause dilution under section 43(c) [15 U.S.C. § 1125(c)] may be refused registration only pursuant to a proceeding brought under section 13 [15 U.S.C. § 1063]. A registration for a mark which when used would cause dilution under section 43(c) [15 U.S.C. § 1125(c)] may be canceled pursuant to a proceeding brought under either section 14 [15 U.S.C. § 1064] or section 24 [15 U.S.C. § 1092]."
 16. *Toro Co. v. ToroHead, Inc.*, 61 U.S.P.Q.2d 1164 (T.T.A.B. 2001).
 17. *Moseley, et al., d.b.a. Victor's Little Secret v. V Secret Catalogue, Inc.*, ___ U.S. ___, 123 S. Ct., 1115, 65 U.S.P.Q.2d 1801 (March 4, 2003).
 18. 15 U.S.C. § 1064: "A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged, including as a result of dilution under section 43(c) [15 U.S.C. § 1125(c)], by the registration of a mark on the principal register established by this Act."
 19. 15 U.S.C. § 1057(b).
 20. Abandonment is defined as no commercial use for a period of three years with an intent not to resume such commercial use.
 21. 15 U.S.C. § 1119.
 22. There is a split among the circuits as to the *res judicata* effect, if any, of a TTAB finding of likelihood of confusion on a district court's subsequent analysis of that issue. *Compare* *Guardian Life Ins. Co. of Am. v. American Guardian Life Assur. Co.*, 943 F. Supp. 509, 523 (E.D. Pa. 1996) ("While not dispositive of the issue of likelihood of confusion, the PTO's refusal to register Defendant's marks is entitled to substantial consideration by this Court."); *Syntex Labs., Inc. v. Norwich Pharm. Co.*, 437 F.2d 566, 569 (2d Cir. 1971) (refusal of Patent Office to register a mark is "entitled to great weight") *with* *Carter-Wallace, Inc. v. Procter & Gamble Co.*, 434 F.2d 794, 802 167 USPQ 713 (9th Cir. 1970) (a preliminary determination by a PTO administrator should not be accorded much weight, especially when the PTO officer did not have access to the full record that might assist in a more complete likelihood-of-confusion analysis); *A&H Sportswear Inc. v. Victoria's Secret Stores Inc.*, 57 U.S.P.Q.2d 1097, 1110 (3d Cir. 2000) ("Any such determination made by the Patent Office under the circumstances just noted must be regarded as inconclusive since made at its lowest administrative level . . . The determination by the Patent Office is rendered less persuasive still by the fact that the Patent Office did not have before it the great mass of evidence which the parties have since presented to both the District Court and this court in support of their claims.").
 23. "Office actions" are triggered when the Trademark Examiner initially refuses an application for registration and the applicant is required to submit additional information in support of the application. The Examiner's findings regarding the weaknesses of the proposed mark can be very helpful to a potential opposer. *See generally* 37 C.F.R. §§ 2.61-2.69.
 24. *See* *Hilton Research, Inc. v. Society for Human Resource Mgmt.*, 27 U.S.P.Q.2d 1423, 1435-1436 (T.T.A.B. 1993) (survey evidence is not required by a party asserting likelihood of confusion in an opposition or cancellation proceeding).
 25. *See, e.g.*, *Miss World (UK) Ltd. v. Mrs. America Pageants Inc.*, 8 U.S.P.Q.2d (BNA) 1237 (9th Cir. 1988) (Widespread use of similar marks within an industry is evidence that the trademark at issue is weak.); *accord* 1 T. McCarthy, *Trademarks and Unfair Competition* Section 11:26, at 513.