

Intellectual Property Law – Trademark

Enforcement Efforts Demonstrate Suggestiveness of Trademark - *In re Murad, Inc.* (TTAB 2010)

The Trademark Trial and Appeal Board (“TTAB”) reversed a USPTO examining attorney’s refusal to register “Perfecting Serum” on the Principal Register on the grounds that the mark was merely descriptive of skin moisturizer. The trademark owner had obtained registration on the Supplemental Register, and had undertaken aggressive policing and enforcement efforts to challenge third parties’ uses of the mark. While the examining attorney relied on the dictionary definitions of the two words used in the trademark, the TTAB found that the mark “requires and effort of imagination on the part of the observer to resolve the incongruity between skin moisturizer and the term ‘Perfecting’ and ‘Serum’ (*i.e.*, a serum does not normally perfect something.)”

No Likelihood of Confusion Where Trademarks are Visually Dissimilar – *Odom’s Tennessee Pride Sausage, Inc. v. FF Acquisition, LLC* (Fed. Cir. 2010)

Trademark infringement occurs where one party uses a trademark that is similar or identical to another party’s trademark in a way that causes a likelihood of confusion in the relevant marketplace. The “likelihood of confusion” test involves a non-exclusive multi-factor analysis. However, where the trademarks in question are sufficiently dissimilar, this alone can lead to a determination that no likelihood of confusion exists. In *Odom’s Tennessee Pride*, the Federal Circuit affirmed the TTAB’s finding that two design marks depicting farm boys were sufficiently dissimilar not to warrant further scrutiny under the likelihood of confusion analysis. Among the relevant distinctions, the Court noted that one mark depicted the boy with shoes and a piece of straw while the other did not.

Use of Third-Party Trademarks in Domain Names – *Toyota Motor Sales U.S.A. v. Tabari* (9th Cir. 2010)

The Court of Appeals for the Ninth Circuit vacated a lower court’s decision enjoining two individuals from using the domain names *buy-a-lexus.com* and *buyorleaselexus.com*, holding that the domain names constituted “nominative fair use.” Even though the domain names directly incorporate Toyota’s famous trademark, they are non-infringing because their use of the trademark is limited to identifying the services offered by the owners and does not falsely suggest sponsorship or endorsement by Toyota. Since the domain name owners could not describe their services without using Toyota’s mark, “the injunction [was] modified to allow some use of the Lexus mark in [the defendants’] domain names.”

Modification of Registered Trademarks – *In re. Thor Tech* (TTAB 2010)

The owner of the registered trademark “Mt Rainier” for use in connection with travel trailers was not permitted to amend its registration to drop the “Mt” from the trademark. While the registrant argued that “Rainier” and “Mt Rainier” were interchangeable to refer to the famous peak, the TTAB found dispositive the fact that “Rainier” alone had several additional possible meanings that were not applicable to the more-specific term, “Mt Rainier”. Thus, the TTAB held that the proposed “Rainier” trademark “would have to be republished after the alteration in order to fairly present the mark for purposes of opposition.”