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Initial Interest Deception

The Board recently analogized and extended the doctrine of initial interest confusion *In re ALP of South Beach Inc.*, (Serial Number 75819306), to include initial interest deception for the purposes of Section 2 (a). Applicant sought registration for CAFETERIA Stylized on the Supplemental Register for “*restaurants providing full service to sit-down patrons, excluding cafeteria-style restaurants*”. Applicant had argued that the mark was not deceptively misdescriptive because everyone who comes to its restaurant knows in advance the true nature of the establishment, namely that it is a trendy sit-down full service restaurant. The board found that the critical point for the purposes of determining whether the mark was deceptively misdescriptive was not when customers walk into the restaurant, but when they first encounter the mark in an advertisement or sign. The mark here was deceptively misdescriptive because might serve to improperly lure potential customers by indicating that the establishment was a cafeteria, when that is not the case.

Proposed Changes in TTAB Rules Appear Likely to Add Complexity

The extended comment period for the proposed changes to the Rules of Practice before the Trademark Trial and Appeal Board closed May 4, 2006. Generally, the proposed changes would conform TTAB procedure to the Federal Rules of Civil Procedure, particularly with respect to the Discovery process. The changes would mandate certain “initial disclosures” including the origin and history of the use of a mark, evidence of any actual confusion, evidence of awareness of third party use, marketing efforts, and, if applicable, information regarding any other proceedings involving the parties’ rights in the subject marks. The new rules would also require a discovery conference between the parties in addition to the long list of mandatory disclosure. These changes would bring a TTAB proceeding more in line with a federal court proceeding. The bulk of the comments submitted during the open period agree that the changes will make the process more cumbersome, rather than simplifying the process, and increase the costs to pursue matters before the TTAB. The detailed rules can be reviewed at <http://www.uspto.gov/web/offices/com/sol/notices/71fr2498.pdf>

STARBUCKS Fails To See The Humor Of LESSBUCKS

On February 9, 2006, in a Citable Decision, the TTAB upheld an opposition by Starbucks U.S. Brands, LLC and Starbucks Corporation to Marshall S. Rubens’ application to register the trademark LESSBUCKS COFFEE for, among other things, “*coffee*” and “*retail store services featuring coffee*”. The board had little difficulty in determining that STARBUCKS COFFEE is a famous mark and noted that “*there is no excuse for even approaching the well-known mark of a competitor inasmuch as [a] strong mark...casts a long shadow which competitors must avoid*”. The applicant had suggested that there would be no likelihood of confusion as its mark would likely be perceived as a parody of the STARBUCKS mark, however, the TTAB saw no refuge in this for the applicant as “*joking use of trademarks are deserving of less protection when the object of the joke is the mark of a directly competing product*”. Perhaps the “topping” on this case was the fact that the Opponent’s mall intercept survey found that almost half of the ordinary consumer participants would encountered applicant’s mark believed that there was a connection to Opponent’s mark.