

Something More, Something Less

TTAB Finds no Likelihood of Confusion between Food and Catering Services in *In re Giovanni Food Co., Inc.*, Serial No. 77796257 (February 18, 2011).

The Trademark Trial and Appeal Board ("the Board") reversed the United States Patent and Trademark Office's decision to refuse an application for JUMPIN' JACKS based on a likelihood of confusion with prior registered mark, JUMPIN JACK'S. In this precedential decision, *In re Giovanni Food Co., Inc.*, the Board deemed the marks nearly identical, but the goods and services unrelated under the "something more" test.

Giovanni Food Co. filed an application to register the trademark JUMPIN' JACKS, in standard characters, for "barbeque sauce" in International Class 30. The Examining Attorney refused the mark under section 2(d) of the Trademark Act, concluding that JUMPIN' JACKS was confusingly similar to prior registration, JUMPIN JACK'S, for "coffee-house services; and catering services." The Examining Attorney focused the refusal on the prior mark's "catering services." The Board disagreed, holding that "catering services" and "barbecue sauce" were not related enough to create confusion, though the marks were nearly identical.

The Board and Examining Attorney agreed with respect to the marks, both noting that JUMPIN JACK'S and JUMPIN' JACKS were identical except for the placement of the apostrophe. The Board also found the connotation and commercial impression of the marks similar as nothing in the record suggested that use of JUMPIN' JACKS on barbeque sauce and JUMPIN JACK'S on catering services would result in differing meanings. Most importantly, the applicant did not dispute the similarity of marks.

The goods "barbecue sauce" and "catering services" were not related, though, according to the Board. Goods and services

need not be similar to result in a finding of likelihood of confusion (*Helene Curtis Industries Inc. v. Suave Show Corp.*, 13 USPQ2d 1618 (TTAB 1989)), but the Board noted that no per se rule exists listing certain goods and services as "related." *Lloyd's Food Products, Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993). In addition, the Board turned to *Jacobs v. International Multifoods Corp.*, 668 F.2d 1234 (CCPA 1982), for further analysis, which held that the USPTO must show "something more" for likelihood of confusion above and beyond identical marks covering foods products and restaurant services. Though *Jacobs* involved "restaurant services" rather than "catering services," the Board decided this "something more" requirement would be an appropriate test.

The Examining Attorney supported her conclusion that "barbeque sauce" and "catering services" were related by submitting third-party registrations for single marks covering both "catering services" and "barbeque sauce" in addition to third-party website excerpts for barbeque restaurants offering catering services and retail barbeque sauce. These particular goods and services often originated from a singular source, according to the Examining Attorney. The Board, however, stated that the "something more" test was satisfied when either 1) applicant's mark made clear that its services (restaurant or catering, in this case) specialized in the registrant's type of goods (See *In re Golden Griddle Pancake House Ltd.*, 17 USPQ2d 1074, (TTAB 1990)), or 2) when the mark in question was found to be a "very unique, strong mark," (See *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1469 (TTAB 1988) (MUCKY DUCK for mustard found

continued on page 2

Substantial Reform to U.S. Patent Law Passes in the Senate as the "America Invents Act"

On March 8, 2011, the U.S. Senate passed patent reform bill S. 23, entitled the "America Invents Act" a bill that includes several substantial reforms to longstanding patent law. The bill now moves to the House of Representatives for further consideration. At present, there is no timetable for the House to take up the bill.

The America Invents Act includes many substantial reforms to current U.S. patent law. A few of the highlights of the bill include the following:

1. Change to First-to-File System

The current filing system awards patents to the "first-to-invent" which has led to complicated issues when the first-to-file on a particular invention is not the first-to-invent. An amendment moving to a first-to-file system would reward inventors who are diligent in initiating the patent process and would harmonize the U.S. filing system with the majority of patent systems around the world.

2. Supplemental Examination Process

The "supplemental examination" provision would enable patent owners to request the USPTO to consider, reconsider, or correct information believed to be relevant to the patent that may not have been disclosed or not fully considered during the original examination of the application. In terms of information not previously disclosed to the USPTO, this provision would potentially eliminate inequitable conduct allegations during litigation when the supplemental examination is concluded prior to litigation, as the newly disclosed materials could not be used to support such a claim.

continued on page 2

Something More (continued from page 1)
confusingly similar to MUCKY DUCK for restaurant services).

The Board reasoned as follows:

The mere fact that some restaurants that specialize in barbeque also provide catering services and sell barbeque sauce is not sufficient to establish a relationship between catering services in general and barbeque sauce. See Coors Brewing, 68 USPQ2d at 1064. There is no evidence that registrant's catering services specialize in barbeque. See Azteca, 50 USPQ2d 1209; Golden Griddle, 17 USPQ2d 1074.

The Board also stated that "jumpin jacks" was not a "very strong, unique" term, under the *Mucky Duck* test, and ordered the likelihood of confusion refusal to be withdrawn.

The Board failed to explain why "jumpin jacks" was not a "very strong, unique" term for the relevant goods and services under the *Mucky Duck* test, but simply arrived at the conclusion and proceeded to the holding. It would have been interesting to hear the Board's analysis on this point, as how would the USPTO or TTAB establish a standard to determine whether a term is "very strong," "unique," or both.

—Amanda R. Peluse

Patent Reform (continued from page 1)

3. USPTO Fees

The bill gives the USPTO the authority to set patent and trademark fees without the prior approval of the Congress. The bill also ends the current system of diverting fees paid to the USPTO into a general fund and directs the collected fees into a fund for use by the USPTO for future expenditures, e.g. technology upgrades, hiring and training of new patent examiners.

4. Third Party Prior Art Submissions during Prosecution

The bill would enable third parties to submit prior art for consideration during patent application examination.

5. Post-Grant Review Proceedings

Post-grant review could be requested on any grounds within the first 9-months of the patent grant, which should quickly address patents that should not have issued, reducing litigation later in the life of the patent.

6. Ban on Tax Strategy Patents

Tax strategy patents, e.g. strategies for reducing, avoiding, or deferring tax liabilities, would no longer be considered as patentable subject matter.

The bill includes a number of additional, interesting provisions including further filing fee reductions for "micro-entities," amendment to the adverse effects of failing to disclose the best mode, modification to the inter partes re-examination process, and a gate-keeping function for judges in patent damages issues. We now await the House's version of patent reform.

—Sean Swidler