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May 2020



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The May 2020 issue of Sterne Kessler's MarkIt to Market® newsletter discusses two recent precedential TTAB decisions – one regarding disclaimer scope and the other exploring how to successfully claim trademark rights in the title of a single creative work. We also discuss a recent Federal Circuit copyright decision applying the Supreme Court's separability test, and provide an update on current open gTLD sunrise periods.

Additionally, the firm is celebrating a trademark infringement win in District Court for our client Lamborghini! Read more about the case [here](#).

Sterne Kessler's [Trademark & Brand Protection practice](#) is designed to help meet the intellectual property needs of companies interested in developing and maintaining strong brands around the world. For more information, please contact [Monica Riva Talley](#) or [Tracy-Gene G. Durkin](#).

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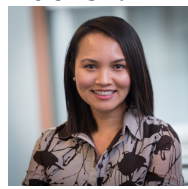
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## ONE OF THESE THINGS IS NOT LIKE THE OTHER: LIMITING DISCLAIMERS WITHIN CLASSES OF SERVICES

By: [Shana L. Olson](#)

In a precedential decision earlier this month, the TTAB found that a disclaimer of a term is required as to all services in a Class if it is descriptive as to any services in that Class. This decision appears to contravene Section 1213 of the Trademark Manual of Examining Procedure, which says “[a] disclaimer may be limited to only certain classes, or to only certain goods or services.”

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Applicant UST Global applied to register the mark INFINITY LABS for various services in Classes 35, 36, 40, 41, and 42 related to business incubation services, think tank services, and scientific and technical services. During prosecution, the Examining Attorney required a disclaimer of LABS, arguing that the word LABS means “a place equipped for experimental study in science or for testing and analysis,” and was therefore descriptive of all of the services covered by the application. In response to the Office Action, the Applicant entered a disclaimer as to all the services in Class 35 services and a portion of the services in Class 42, and did not enter the disclaimer for the remaining services in Class 42 or the services in Classes 36, 40 and 41. The Examining Attorney issued a final Office Action again requiring a disclaimer as to all of the services, and the Applicant appealed.

After analyzing the issue of descriptiveness of the term LABS in *In re UST Global (Singapore) Pte. Ltd.*, the Board found that the term is descriptive of all of the services in the application in Classes 40 and 41, and a portion of the services in Classes 36 and 42. Invoking a “well-settled principle,” the Board affirmed the refusal to register the entirety of Classes 36, 40, 41, and 42 until the Applicant enters a disclaimer of LABS for the remaining services in the application.

Notably, despite its finding that the term LABS is merely descriptive only to specific services in Classes 36 and 42, the Board did not give any reasoning as to why it would not allow a disclaimer to only apply to particular services within Classes 36 and 42, only that it was already “well-settled.” However, there is a footnote in the Conclusion section of the opinion that says that the ruling in this case “would not prevent a future applicant from dividing its application” to separately appeal a disclaimer with respect to particular services. This holding seems to contradict Section 1213 of the Trademark Manual of Examining Procedure, which says “[a] disclaimer may be limited to only certain classes, or to only certain goods or services.”

An interesting distinction in this case is that the ruling does not speak to how the Board would treat a similar disclaimer requirement with respect to *goods*. The boundaries of descriptiveness are arguably less subjective when applied to goods, so it is easy to imagine a situation where a term within a mark is descriptive as to some goods within a Class but not others. For example, perhaps the term SILVER would be found to be descriptive of metal-containing goods in Class 14, but not other goods in that Class, like “emeralds.”

In light of this decision, Applicants should carefully consider the descriptiveness of terms as applied to their services (and perhaps goods), and consider a filing strategy where services within a Class are divided between two separate applications – one where a term would be considered descriptive, and one where the term would not be considered descriptive. Alternatively, given the Board’s footnote in this decision, it also appears that it would be possible to wait for the Examining Attorney to make a decision about the descriptiveness of particular services, and then divide out the application at that point. In any case, a disclaimer of a term is simply a statement in the USPTO record that indicates that a registrant is not claiming rights to the disclaimed portion of the mark alone, apart from the other wording, and does not change the fact that a registrant still has rights to protect their mark as a whole.

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## BANANA AND PENCIL: A TALE OF TWO CIRCUITS

By: [Ivy Clarice Estoesta](#)

Three years ago, the Supreme Court announced a seemingly simple separability test for determining whether features of a useful article are eligible for copyright protection in the landmark decision *Star Athletica v. Varsity Brands*, 137 S. Ct. 1002 (2017). Under that test, a “feature incorporated into the design of a useful article is eligible for copyright protection only if the feature (1) can be perceived as a two- or three-dimensional work of art separate from the useful article, and (2) would qualify as a protectable pictorial, graphic, or sculptural work—either on its own or fixed in some other tangible medium of expression—if it were imagined separately from the useful article into which is it incorporated. *Id.* at 1007. While that test, in theory, seemed to have opened the door to asserting copyright in three-dimensional designs of useful articles, the divergent application of that test by the Third Circuit and the Federal Circuit suggests that more clarity is necessary.

In *Silvertop Associates Inc, dba Rasta Imposta. v. Kangaroo Manufacturing Inc.*, 931 F.3d 215 (3d Cir. 2019), the Third Circuit considered whether Rasta Imposta held a valid copyright in a design for a useful article, namely, a costume designed to look like a banana:



Applying the Supreme Court’s separability test, the Third Circuit determined that the costume’s combination of artistic features—colors, lines, shape, and length—could be imagined as an original sculpture apart from the costume’s utility of wearability (provided by the cutout holes for the wearer’s arms, legs, and face). According to the Court, that sculpted banana, once split from the costume (including its utilitarian cutout holes), is not intrinsically utilitarian and does not merely replicate the costume. Thus, the Court held that the banana costume, though a useful article, was copyrightable.

More recently, in *Lanard Toys Limited v. Dolgencorp LLC*, No. 2019-1781, 2020 WL 2478876 (Fed. Cir. May 14, 2020), the Federal Circuit considered whether Lanard held a valid copyright in a design for a useful article, namely a toy chalk holder designed to look like a No. 2 pencil:



Applying the Supreme Court’s separability test, the Federal Circuit determined that the cartoonish No. 2 pencil design of the chalk holder was **not** sufficiently separable from the chalk holder’s utility of storing and holding chalk and facilitating writing or drawing. In reaching that determination, the Federal Circuit reiterated the district court’s rationale that “the pencil design does not merely encase or disguise the chalk holder; it is the chalk holder.” Thus, “when one imagines the pencil design as a separate work of sculptural art, one is merely picturing a replica of the chalk holder.”

A comparison of the Third Circuit and Federal Circuit analysis suggests that the Third Circuit’s application of the separability test better aligns with the wording of the federal copyright statute, which provides that the design of a useful article may be copyrightable if the design “incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian *aspects* of the article.” [17 U.S.C. 101](#). Specifically, the Third Circuit’s analysis disregards the banana costume’s utilitarian aspects (i.e., the cutout holes) to conclude that the separately imagined sculpted banana does not merely replicate the banana costume (which includes utilitarian cutout holes). In contrast, the Federal Circuit’s analysis does not appear to have discounted the pencil design’s utilitarian opening for storing and holding chalk to facilitate writing or drawing. If it had, perhaps the Federal Circuit would not have concluded that imagining the pencil design as a separate work of sculptural art merely replicates the chalk holder (which includes a utilitarian opening for holding chalk).

Therefore, until it is clear how the Supreme Court’s separability test will be applied in the rest of the circuits, individuals and entities invested in the design of useful articles should continue to evaluate whether their designs are better protected by other types of intellectual property tools (e.g. design patents, trade dress), instead of relying exclusively on copyright protection.

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## TITLE OF A SINGLE CREATIVE WORK... OR SOMETHING MORE?

By: [Monica Riva Talley](#)

In a recent precedential opinion, the U.S. Patent & Trademark Office Trademark Trial and Appeal Board (TTAB) tackled the often frustrating question of what it takes to acquire trademark rights in the title of a single creative work, in this case a book.

It has long been the rule that a title of a single book (or play, or movie) cannot function as a trademark because the title does not create a separate and distinct commercial impression that identifies the source of the goods. Instead, titles have been held to merely describe the book, or creative work, itself. In re Cooper, 254 F.2d 611 (C.C.P.A. 1958).

However, in Shannon DeVivo v. Celeste Ortiz, Opposition No. 91242863 (TTAB Mar. 11, 2020), the TTAB provided a useful roadmap of the types of additional uses owners can employ to enhance the trademark significance of book titles.

In this case, Celeste Ortiz, (“Applicant”) filed a trademark application for the mark ENGIRLNEER covering goods such as mugs, lanyards, and clothing in Classes 21, 22, and 25. Shannon DeVivo (“Opposer”) opposed the application, asserting prior use of the identical mark for various website, educational, and information services, and for books. The TTAB sustained the opposition, finding that Opposer had established priority of use through registration and use of the engirln eer.com domain name and website, publication of a book of fictional ENGIRLNEER characters, and through speaking at public events.

Notably, the TTAB partly relied on the fact that DeVivo had used the ENGIRLNEER mark in connection with a single book in ways in which the TTAB found to be a trademark use, namely:

- Using the mark in a small “seal of approval” on the bottom of the front cover;
- Using the mark on the back cover of the book; and
- Using the mark to identify one or more fictional characters featured in the book.

The TTAB found parallels between Opposer’s use of ENGIRLNEERS and the Federal Circuit’s consideration of the trademark ABBA (of the famed music group ABBA) for sound recordings. In re Polar Music Int’l, 714 F.2d 1567 (Fed. Cir. 1983). In the ABBA case, the court considered a label affixed to a phonograph record, an album cover, and point of purchase displays in record stores to find that ABBA could function independently of the music group as a source indicator for sound recordings and “not just an identification of the singers.” Id.



In the case at hand, the TTAB explained that even though ENGIRLNEERS appears in the title of the book, and is the name of the group of characters in the book, “the positioning of the term distant from the title of the book, its inclusion within a design, its prominent size, its appearance on the second page in conjunction with an invitation to the reader to ‘learn how to become an engirlnearer,’ and its appearance on the last page of the book, results in a separate and distinct commercial impression which performs the trademark function of identifying the source of Applicant’s book to consumers.” Based on these types of uses, the TTAB held that Opposer had created a distinct commercial impression separate and apart from the title itself.

Thus, while this decision seems to depart from the traditional rule on book titles, in context it is more in line with the traditional trademark priority examination that takes the full context of use into consideration when evaluating trademark significance and rights.

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As of May 29, 2020, ICANN lists new Sunrise periods as open for the following new gTLDs that may be of interest to our clients. A full list can be viewed [here](#).

**.meet**

**.dealer**

**.cyou**

ICANN maintains an up-to-date list of all open Sunrise periods [here](#). This list also provides the closing date of the Sunrise period. We will endeavor to provide information regarding new gTLD launches via this monthly newsletter, but please refer to the list on ICANN's website for the most up-to-date information – as the list of approved/launched domains can change daily.

Because new gTLD options will be coming on the market over the next year, brand owners should review the list of new gTLDs (a full list can be found [here](#)) to identify those that are of interest.

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