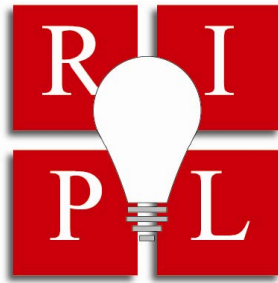


# THE JOHN MARSHALL REVIEW OF INTELLECTUAL PROPERTY LAW



## THE TRADEMARK DISCLAIMER PROVISION OF THE LANHAM ACT: IS USPTO FLEXIBILITY WORTH LITIGANT AMBIGUITY?

SCOTT D. LOCKE

### ABSTRACT

Most trademark applicants and the attorneys who counsel them are familiar with the requirement that they disclaim terms within their trademarks because those terms are descriptive or generic. The United States Patent and Trademark Office's authority to direct applicants to disclaim terms is codified in the Trademark Disclaimer Provision of the Lanham Act, which provides examiners with a great deal of discretion. The same provision has been interpreted as providing applicants with the options of: taking conflicting positions, e.g., that the term is neither descriptive nor generic in the context of their marks, when asserting common law rights; and pursuing rights without disclaiming the term when there has been a showing of secondary meaning. But for all of the ease of implementation and application, now, more than half of a century since codification of the Trademark Disclaimer Provision, one should consider whether it is worth the effort and ask: Does anyone gain by allowing examiners to require that applicants disclaim generic and descriptive portions of their marks?

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## THE TRADEMARK DISCLAIMER PROVISION OF THE LANHAM ACT: IS USPTO FLEXIBILITY WORTH LITIGANT AMBIGUITY?

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When naming a product or a service, often marketing professionals gravitate toward descriptive and generic terms because those terms can instantaneously convey a message. However, unlike arbitrary, fanciful, and suggestive terms, descriptive and generic terms are disfavored by the trademark law because as a policy, America has made a decision that in general it wants for all competitors to be able to make use of them.<sup>1</sup> In order to finesse the issue of how to build a strong brand while using generic or descriptive terms, marketers often include them within a brand name that has at least one additional element that is neither generic nor descriptive.

Historically, trademark law wrestled with whether and how to recognize trademark rights in these types of composite marks.<sup>2</sup> In order to codify a resolution of these issues, Congress included in the Lanham Act a grant to the United States Patent and Trademark Office (“USPTO”) of discretion to compel an applicant to disclaim descriptive and generic terms while still allowing an applicant to register the entire, also referred to as “composite,” mark at issue (the “Trademark Disclaimer Provision”).<sup>3</sup> For most applicants, when faced with a directive by an examiner to disclaim one or more terms, the response is to comply without objection, because compliance will usually be the quickest road to issuance of a registration.<sup>4</sup> However, applicants should beware; despite the current Trademark Disclaimer Provision being in force for more than half of a century, courts are still struggling with the significance of a disclaimer in a trademark registration. This article provides background on the standards for requiring disclaimers, examples of the

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<sup>1</sup> See generally, *Yankee Candle Co., Inc. v. Bridgewater Candle Co., LLC*, 250 F.3d 25, 41 (1d Cir. 2001) (discussing spectrum of marks); *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) (same).

<sup>2</sup> See *In re American Cyanamid & Chemical Corp.*, 99 F.2d 964, 966 (C.C.P.A. 1938) (discussion history of evolution of disclaimer practice during period prior to enactment of Lanham Act).

<sup>3</sup> 15 U.S.C. § 1056(a) (2017) (“The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registerable.”); *Grayson O Company v. Agadir International LLC*, 856 F.3d 307, 318 n.7 (4th Cir. 2017) (“When a party applies to register a mark that contains two parts, one of which is descriptive and therefore not entitled to protection, the USPTO requires the party to disclaim exclusive use of that portion aside from its use in conjunction with the mark.”); *In re Louisiana Fish Fry Products, Ltd.*, 797 F.3d 1332, 1335 (Fed. Cir. 2015) (“The PTO can condition the registration of a larger mark on an applicant’s disclaimer of an unregistrable component of a mark otherwise registrable.”); *In re Stereotaxis, Inc.*, 429 F.3d 1039, 1041 (Fed. Cir. 2005) (“The Trademark Office may require disclaimer as a condition of registration if the mark is merely descriptive for at least one of the products or services involved.”).

<sup>4</sup> The statutory discretion that is afforded to examiners, 15 U.S.C. § 1056(a), makes it unlikely that an examiner will reverse his or her initial determination that a disclaimer is improper. Further, because the discretion is codified, the cost of an appeal can be particularly intimidating.

circumstances in which the USPTO requires them, and a discussion of the ramifications of disclaiming a term in a trademark registration. It also explores the inherently problematic nature of the current scheme under which the USPTO has discretion about whether to issue requirements for filing disclaimers of terms within trademark registrations.

## I. PURPOSE AND PROCESS

When enacting the Lanham Act, Congress gave the USPTO the power to issue disclaimers in the context of otherwise registrable trademarks.<sup>5</sup> In its current form, the Trademark Disclaimer Provision recites: “The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable.”<sup>6</sup> Two things about this statutory provision are notable. First, the use of the term “may” instead of “shall” gives the USPTO discretion.<sup>7</sup> Second, the mark must otherwise be registrable,<sup>8</sup> which means that it must contain at least one additional element that alone or in combination with the descriptive or generic element(s) would be registrable, or there is a combination of unregistrable terms that form a unitary mark that differs in its connotation from the connotation of each of the terms when considered separately.

The Court of Appeals for the Federal Circuit (“CAFC”) has summarized the policy behind the Trademark Disclaimer Provision as follows: (1) it provides the benefits of the Lanham Act to applicants for composite marks that have unregistrable components, *e.g.*, allowing them to incorporate descriptive terms with arbitrary terms; while (2) it prevents applicants from claiming exclusive rights to the descriptive or generic portions apart from the composite marks of which they are a part.<sup>9</sup> Thus, under this theory, when an applicant files a disclaimer, competitors are free to use the descriptive or generic term by itself without legal harassment from the registrant.<sup>10</sup>

Typically, during prosecution of a trademark application, an examiner issues a directive to the applicant to disclaim a term, a phrase, or an element that is part of a

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<sup>5</sup> July 5, 1946, c. 540, Title I, § 6, 60 Stat. 429; Pub. L. 87-772, § 3.

<sup>6</sup> 15 U.S.C. § 1056(a).

<sup>7</sup> *Id.*

<sup>8</sup> *Dena Corp. v. Belvedere Inter., Inc.*, 950 F.2d 1555, 1560-61 (Fed. Cir. 1991) superseded in part on other grounds by 15 U.S.C. § 1052(f) as recognized by *In re Wada*, 194 F.3d 1297 (Fed. Cir. 1994).

<sup>9</sup> *Dena Corp.*, 950 F.2d at 1560. The latter benefit may be a solution looking for a problem. If the composite mark contains both a generic and an arbitrary term, it is unclear under what circumstances an applicant would be able to successfully establish rights covered by the registration in the generic term apart from the arbitrary term.

<sup>10</sup> *Id.*; *see also* Application of Hercules Fasteners, Inc., 203 F.2d 753, 757 (C.C.P.A. 1953) (“The purpose of a disclaimer is to show that the applicant is not making claim to the exclusive appropriation of such matter except in the precise relation and association in which it appeared in the drawing and description.”); *see also* *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522 (4th Cir. 1984) (quoting *Hercules Fasteners*); *Grand River Enterprises Six Nations Ltd v. VME Products LLC*, 2014 WL 2434517 n. 5 (W.D. Wis. 2014) (quoting *Hercules Fasteners*). One should also note that an applicant is not permitted to disclaim all of the terms in a word mark. *Pilates, Inc. v. Georgetown Bodyworks Deep Muscle Massage Centers, Inc.*, 157 F. Supp. 2d 75, 81-82 (D.D.C. 2001).

composite mark.<sup>11</sup> This request can be with respect to certain classes or all classes within a multi-class application.<sup>12</sup> If an applicant refuses to do so, the USPTO may refuse to register the mark.<sup>13</sup>

An applicant may also voluntarily submit a disclaimer with an initial application or at a later time even without the USPTO's having issued a disclaimer requirement,<sup>14</sup> and the USPTO may accept the disclaimer even if it were unnecessary.<sup>15</sup> As a matter of practice, some applicants that file voluntary trademark disclaimers do so because they make a calculation that not doing so would only delay prosecution.

To notify the public of a disclaimer, the corresponding registration certificate will recite: "No claim is made to the exclusive right to use '[disclaimed term(s)]', apart from the mark as shown."<sup>16</sup> However, as discussed more fully below, under the current Trademark Disclaimer Provision, many courts have been reluctant to give the inclusion of disclaimer determinative weight on this issue of the degree to which a registrant can enforce its trademark rights.<sup>17</sup>

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<sup>11</sup> 15 U.S.C. § 1056(a) ("[t]he Director may require the applicant to disclaim an unregistrable component of a mark otherwise registerable"); *Applicant of Franklin Press, Inc.*, 597 F.2d 270, 273 (C.C.P.A. 1979) ("The effect of disclaimer is to disavow any exclusive right to the use of a specified word, phrase, or design outside of its use within a composite mark.").

<sup>12</sup> TMEP § 1213 (11th ed. Apr. 2017) ("A disclaimer may be limited to pertain to only certain classes, or to only certain goods and services."); *see e.g.*, *In re Nippon Electric Glass Co., Ltd.*, 2016 WL 356619, \*9 (June 2, 2016) (recognizing that the examiner applied disclaimer to only four classes); *In re Coden*, 2012 WL 1267928, \*10 n.3 (T.T.A.B. Mar. 26, 2012) (applying disclaimer to only one class).

<sup>13</sup> Notably, when the Trademark Act of 1946 first incorporated a provision directed to the issuance of disclaimers, the statute used the term "shall," thereby mandating the issuance of disclaimer requirements by the USPTO. TMEP § 1213.01(a). In 1962, Congress amended the statute to use the permissive term "may," which has been used to justify the greater discretion by examiners. *Dena Corp.*, 950 F.2d at 1559 (discussing 1962 amendment).

<sup>14</sup> 15 U.S.C. § 1056(a) ("An applicant may voluntarily disclaim a component of a mark sought to be registered"); TMEP § 1213.01(c). *See also* *In re MCO Communications Corp.*, 21 U.S.P.Q. 2d 1534 (Comm'r Pats. 1991) (applicant may voluntarily disclaim material that is registrable or not registrable).

<sup>15</sup> *In re Cleaner's Supply, Inc.*, 2003 WL 169796, \*4 (T.T.A.B. Jan. 23, 2003).

<sup>16</sup> In general, disclaimers of individual components of complete descriptive phrases are improper. *In re Wet Technologies, Inc.*, 2012 WL 3224708 \*3 (T.T.A.B. July 20, 2012) ("Unregistrable wording must be disclaimed in its entirety; words that form a grammatically or otherwise unitary expression must be disclaimed as a composite"); *In re Wanstrath*, 7 U.S.P.Q.2d 1412, \*2 (Comm'r Pat. & Tr. Jan. 6, 1987) ("Disclaimers of individual components of complete descriptive phrases are improper"). *See also* *In re October Three LLC*, 2016 WL 2939090, \*3 (Apr. 14, 2016) ("If a unitary phrase consisting of individually descriptive components does not result in a combination presenting something more than the sum of its parts, then the phrase is merely descriptive as a whole, and must be disclaimed as a whole."). But separate disclaimers of adjacent components of a mark may be accepted when they do not form a grammatically or otherwise unitary expression, and each of the components retains its separate descriptive significance. *In re October Three LLC*, 2016 WL 2939090, \*3; *see also* *In re Prince of Wales International Business Leaders Forum* 2009 WL 4081684 \*8 (T.T.A.B. Oct. 19, 2009) ("The simple fact that initial letters of the words [in the mark GT GLASS TECHNOLOGY] correspond with the abbreviation does not mean that they are joined as a unitary expression").

<sup>17</sup> *See e.g.*, *Kelley Blue Book v. Car-Smarts, Inc.*, 802 F. Supp. 278, 291 (C.D. Ca. 1992) (noting that disclaimer did not constitute waiver or estoppel). Prior to the Lanham Act, if an applicant disclaimed certain subject matter as unregistrable, then the applicant and its successors in interest were estopped from later securing registration of the subject matter even if those portions became

Examples of elements for which the USPTO will require the filing of disclaimers are: (i) matter that is merely descriptive or misdescriptive of the goods or services or matter that is primarily geographically descriptive of the goods or services;<sup>18</sup> (ii) components that are generic or that otherwise do not function as a mark;<sup>19</sup> (iii) words or abbreviations in a trade name that designate the legal character of an entity or its family structure, unless the designation is used in an arbitrary manner and thus has trademark significance;<sup>20</sup> and (iv) unregistrable components of trade names or company names.<sup>21</sup>

## II. COMPOSITE MARKS AND THE SUBSET OF UNITARY MARKS

Trademarks that contain more than one element may be classified as composite marks, and if the elements are inseparable, those marks may be deemed unitary marks.<sup>22</sup> Under the Lanham Act, composite marks, but not unitary marks, are subject to the disclaimer requirement.<sup>23</sup> Thus, many applicants argue against USPTO requirements for disclaimers by taking the position that their marks are unitary.<sup>24</sup> Below is a discussion of guideposts that one may use in determining

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distinctive or protectable under the common law. *See Hercules, Fasteners, Inc.*, 203 F.3d at 757; *In re Canada Dry Ginger Ale*, 87 F.2d 736, 737 (C.C.P.A. 1937) (noting estoppel).

<sup>18</sup> TMEP § 1213.03(b) (11th ed. Apr. 2017); *see also* Grayson, *supra* n. 1; *In re Wada*, 194 F.3d 1297, 1301 (Fed. Cir. 1999) (NAFTA amendments rendered primarily geographically misdescriptive marks precluded from registration); *In re Jasmine LLC*, 2013 WL 2951788, \*9-10 (T.T.A.B. Mar. 5, 2013) (affirming requirement of deceptively misdescriptive phrase WHITE JASMINE); *In re Mumbai Mantrua Media Ltd.*, 2011 WL 5600313, \*1 (T.T.A.B. Oct. 26, 2011) (noting requirement to disclaim MUMBAI).

<sup>19</sup> TMEP § 1213.03(a). *See also* *In re King Koil Licensing Co., Inc.*, 79 U.S.P.Q.2d 1048, \*4 (affirming examiner required disclaimer of MATTRESS in mark THE BREATHABLE MATTRESS as being generic).

<sup>20</sup> TMEP § 1213.03(d); *In re Toast, Four Corners, Inc.*, 2016 WL 3566143, \*4 (T.T.A.B. May 24, 2016) (affirming requirement to disclaim INC.); *In re Bone Yard Industries*, 2012 WL 2024446, \*2 (T.T.A.B. May 22, 2016) (“Words or abbreviations in a trade name designating the legal character of an entity (e.g., Corporation, Corp., Co., Inc., Ltd., etc.) must be disclaimed because an entity designation has no source-indicating capacity.”; affirming requirement to disclaim INDUSTRIES).

<sup>21</sup> TMEP § 1213.04. *See e.g.*, *In re Martin’s Famous Pastry Shoppe, Inc.*, 221 USPQ 364 (T.T.A.B. 1984), *aff’d on other grounds*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984) (affirming requirement for disclaimer of PASTRY SHOPPE in mark MARTIN’S FAMOUS PASTRY SHOPPE INC. and design).

<sup>22</sup> *In re DDMB*, 2017 WL 915102, \*3 (2017) (“For a composite mark to qualify as a ‘unitary mark’ the elements of the composite must be ‘inseparable.’”).

<sup>23</sup> *Dena*, 950 F.2d at 1560

Moreover, the language of 15 U.S.C §§ 1056 and 1057 incorporated the various aspects of traditional disclaimer practice. For example, section 1056(a) adopts the Commissioner’s policy of exempting unitary marks from the disclaimer requirement . . . A unitary mark simply has no ‘unregistrable component,’ but is instead an inseparable whole. A unitary mark cannot be separated into registrable and nonregistrable parts. Because unitary marks do not fit within the language of section 1056(a), the Commissioner cannot require a disclaimer.

TMEP §§ 1213.02, 1213.05 (11th ed. Apr. 2017).

<sup>24</sup> *See e.g.*, *In re Slokevage*, 441 F.3d 957, 962-63 (Fed. Cir. 2006); *In re Nunn Milling Company, Inc.*, 2017 WL 3773111 (T.T.A.B. Jul. 24, 2017); *Nixalite of America Inc. v. Bird Barrier of America*,

whether a combination of elements presents a synergy that transforms them into a unitary mark.

Unitary marks are marks that create a commercial impression separate and apart from any unregistrable component.<sup>25</sup> “The test for unitariness inquires whether the elements of a mark are so integrated or merged together that they cannot be regarded as separable.”<sup>26</sup> Unitary marks can be identified by considering the following factors: (1) whether the elements are physically connected by lines or other design features; (2) how close the elements are located to each other -- whether side-by-side on the same line; and (3) the meanings of the words and how the meanings relate to each other and the to the goods or services.<sup>27</sup> When asking whether a mark is unitary, one should focus on how an average purchaser would encounter the mark under normal marketing conditions and how that average consumer would react to the mark.<sup>28</sup>

The recent case *In re DDMB*,<sup>29</sup> provides an example of both how the issue of unitariness arises and how the USPTO and the CAFC approach this issue. The applicant had sought to register EMPORIUM ARCADE BAR and design.<sup>30</sup> The trademark examiner required that the applicant disclaim the term EMPORIUM.<sup>31</sup> The Trademark Trial and Appeal Board (“TTAB”) affirmed, noting that the term is descriptive of video and amusement arcade services, bar services, and bar services featuring snacks.<sup>32</sup> The CAFC agreed with the TTAB’s conclusions, emphasizing that: (1) the term EMPORIUM was descriptive of video amusement and arcade services, as well as of bar services, and was supported by the Board’s evidence from dictionaries and third party registrations; and (2) the phrase EMPORIUM ARCADE BAR was not unitary because the elements were separable.<sup>33</sup>

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Inc., 2004 WL 1576472, \*2 (T.T.A.B. Jul. 2, 2004); *In re Symbra’ette, Inc.*, 189 U.S.P.Q. 448 (T.T.A.B. Aug. 25, 1975).

<sup>25</sup> *In re DDMB*, 2017 WL 915102, \*3 (“A unitary mark must have ‘a distinct meaning of its own independent of the meaning of its constituent elements.’” (quoting *Dena Corp.*, 950 F.2d at 1561) (emphasis added). For a composite mark to qualify as a ‘unitary mark’ the elements of the composite must be ‘inseparable.’); TMEP § 1213.05 (11th ed. Apr. 2017).

<sup>26</sup> TMEP § 1213.05 (11th ed. Apr. 2017); see *In re Savin*, 2003 WL 21316775, \*3 (Fed. Cir. June 6, 2003) (because a unitary mark has no unregistrable components, *i.e.*, is inseparable as a whole, it is exempt from the disclaimer requirements); *Dena Corp.*, 950 F.2d at 1561

A unitary mark has certain observable characteristics. Specifically, its elements are inseparable. In a unitary mark, these observable characteristics must combine to show that the mark has a distinct meaning of its own independent of the meaning of its constituent elements. In other words, a unitary mark must create a single and distinct commercial impression.

<sup>27</sup> *Dena*, 950 F.2d at 1561 (quoting TMEP § 807.13(a)); *Eksouzian v. Albanese*, 2015 WL 4720478, \*3-4 (C.D. Cal. Aug. 7, 2015) (quoting *Dena*); *Sexy Hair Concepts, LLC v. Conair Corp.*, 2013 WL 12119721, \*2 (C.D. Cal. 2013) (“In determining whether a mark is unitary and creates a single distinct commercial impression, USPTO examining attorneys and courts consider the observable characteristics of the mark such as proximity, alignment, color and font, as well as the connotative relationship of the mark elements.”); TMEP § 1213.05 (11th ed. Apr. 2017).

<sup>28</sup> *Dena*, 950 F.2d at 1561.

<sup>29</sup> *In re DDMB, Inc.*, 2017 WL 915102 (Fed. Cir. Mar. 8, 2017).

<sup>30</sup> *Id.* at \*1.

<sup>31</sup> *Id.*

<sup>32</sup> *Id.*

<sup>33</sup> *Id.* at \*3-4.

Below is an overview of how the USPTO approaches the issue of unitariness with respect to different configurations of words and phrases.

### *A. Unitary Words*

The issue of whether a word is unitary manifests itself in a number of contexts, including when using: (i) compound words; (ii) telescoped words; and (iii) hyphenated or otherwise punctuated words.

#### (i) Compound Words

A compound word is a word that is comprised of two or more distinct words, but it is represented as one word. “If a compound word mark consists of an unregistrable component and a registrable component combined into a single word, no disclaimer of the unregistrable component of the compound word will be required.”<sup>34</sup> However, if a compound word that is formed from two separate words, each of which is descriptive, in a manner that suggests that each component retains meaning, *e.g.*, through different stylizations of descriptive terms in a logo, then the combination of terms may be subject to a disclaimer requirement.<sup>35</sup>

#### (ii) Telescoped Words

A telescoped mark is one that comprises two or more words that share letters.<sup>36</sup> In general, a telescoped mark is considered unitary, and no disclaimer of an individual portion is required,<sup>37</sup> unless each portion is unregistrable. If, for example, a telescoped word is unregistrable

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<sup>34</sup> TMEP § 1213.05(a); *see also* *In re EBS Data Processing, Inc.*, 212 U.S.P.Q. 964, 966 (T.T.A.B. 1981); (“disclaimer of a descriptive portion of a composite mark is unnecessary . . . if the elements are so merged together that they cannot be regarded as separate elements . . . for example . . . by combining two words or terms, one of which would be unregistrable by itself”).

<sup>35</sup> *In re Wet Technologies*, 2012 WL 3224708, 7-15 (T.T.A.B. July 20, 2012) (within stylized logo of WETTECHNOLOGIES, disclaimer requirement of WET TECHNOLOGIES was proper); *see also* *In re Medical Diagnostic Labs, LLC*, 2016 WL 5866954, \*3-4 (T.T.A.B. Sept. 22, 2016) (BRCAcare for genetic testing deemed descriptive). When a disclaimer of a compound word is necessary, it may be in the form of the two separate words. *See e.g.*, *In re Twin Bay Medical, Inc.*, 2003 WL 22513447, \*2 (T.T.A.B. Nov. 4, 2013) (for compound word BARBLOCK, appropriate disclaimer was of BARBLOCK).

<sup>36</sup> TMEP § 1213.05(a)(i) (“*e.g.*, HAMERICAN, ORDERRECORDER, SUPERINSE, VITAMINSURANCE, and POLLENERGY”); *see also* *In re Genscape Intangible Holding, Inc.* 2014 WL 2990398 \*6 (T.T.A.B. June 9, 2014) (telescoped marks are considered unitary, but one must first confirm that the mark would be viewed as telescoped.); *In re Visual Analytics, Inc.* 2005 WL 1822538, \*3 (T.T.A.B. July 27, 2005) (PDALAERT, DEMRALERT and AQUALERT did not require disclaimers because each is telescoped); THOMAS MCCARTHY, 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 19:66 (5th ed. Dec. 2017) (“A telescoped mark is one that comprises two or more words that share letters and is considered to be a ‘unitary’ mark with no unregistrable portions for disclaims.”).

<sup>37</sup> TMEP § 1213.05(a)(i); *see also* *In re Renco Encoders*, 2002 WL 1359374 n. 5 (T.T.A.B. June 20, 2002) (“Where a mark consists of two words telescoped into a single term, the term is considered unitary so that disclaimer of one part of the term is not required by the PTO.”).



because each element is a descriptive and/or generic term, but the telescoped word is part of a composite mark in which there is an additional element that is neither descriptive nor generic, then the USPTO will require that the applicant file a disclaimer.<sup>38</sup>

(iii) Hyphen or other Punctuation between Terms

A compound word may be formed by using punctuation between two syllables or terms. If the compound word is formed by inserting a hyphen between two words or terms, only one of which alone would not be registrable, then no disclaimer is necessary.<sup>39</sup> Further, the use of an asterisk, a slash, or a raised period is analogous to the use of a hyphen, and thus, if only one term alone would be unregistrable, then no disclaimer is needed.<sup>40</sup> By contrast, if the combined, *e.g.*, hyphenated term, is unregistrable because the terms remain descriptive, then the USPTO may use its discretion to require a disclaimer.<sup>41</sup>

*B. Unitary Phrases*

In addition to whether individual words are unitary, there are situations in which one must consider whether phrases are unitary. Trademark law defines a phrase as “a group of words that are used together in a fixed expression”; “two or more words in sequence that form a syntactic unit that is less than a complete sentence”; and “a sequence of two or more words arranged in a grammatical

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<sup>38</sup> TMEP § 1213.05(a)(i) (11th ed. Apr. 2017); *see e.g.*, *In re Omaha Nat'l Corp.*, 819 F.2d 1117, 1119 (Fed. Cir. 1987) (affirming refusal to register *FirsTier* and design for banking services in the absence of a disclaimer of “FIRST TIER,” in view of evidence that the term describes a class of banks); *In re Kaufman*, 2014 WL 1827014, \*1 (T.T.A.B. May 2, 2014) (“If a mark comprises a word or words that are telescoped or otherwise misspelled, but nonetheless must be disclaimed, the examining attorney must require disclaimer of the word or words in the correct spelling”).

<sup>39</sup> TMEP § 1213.05(a)(ii); *see also* *Ultimate Nutrition, Inc. v. Nxcare, Inc.*, 2008 WL 96116, \*2 (T.T.A.B. Jan. 4, 2008) (“When a compound mark is formed by hyphenating two words or terms, one which would be unregistrable alone, the mark is deemed unitary and no disclaimer is necessary.”; mark *CREATINE-DT2* does not need disclaimer); *“X” Labs, Inc. v. Odonite Sanitation Serv. of Balt., Inc.*, 106 U.S.P.Q.2d 327, 329 (Comm’r Pats. 1955) (in *TIRE-X*, no need to disclaim *TIRE*). However, the use of a hyphen frees only terms that are linked by it from the disclaimer requirement. *See In re Prince of Wales International Business Leaders Forum*, 2009 WL 4081684, \*8 (T.T.A.B. Oct. 19, 2009) (disclaimer required in mark *IBLF -- INTERNATIONAL BUSINESS LEADERS FORUM*).

<sup>40</sup> TMEP § 1213.05(a)(ii); *In re Prince of Wales International Business Leaders Forum*, 2009 WL 4081683 \*7 (T.T.A.B. Oct. 19, 2009) (“When a compound word is formed by hyphenating two words or terms, one of which would be unregistrable alone, no disclaimer is necessary.”); *Ultimate Nutrition, Inc. v. Nxcare, Inc.*, 2008 WL 96116, \*2 (T.T.A.B. Jan. 4, 2008) (“When a compound word mark is formed by hyphenating two words or terms, one of which would be unregistrable, the mark is deemed unitary and no disclaimer is necessary.”); *“X” Laboratories, Inc. v. Odorite Sanitation Service of Baltimore, Inc.*, 106 U.S.P.Q. 327, 329 (Comm’r Pat. 1955) (requirement for a disclaimer of “*TIRE*” deemed unnecessary in application to register *TIRE-X* for a tire cleaner).

<sup>41</sup> TMEP § 1213.05(a)(ii) (if *SOFT-TOYS* is part of mark for stuffed animals, then disclaimer of *SOFT TOYS* is necessary, and if *OVER-COAT* for winter coats is part of mark, then *OVERCOAT* must be disclaimed).

construction and acting as a unit sentence.”<sup>42</sup> But “a phrase qualifies as unitary in the trademark sense only if the whole is something more than the sum of its parts.”<sup>43</sup>

The issue of whether a phrase is unitary arises in a number of contexts, including when using: (i) slogans, (ii) double entendres; (iii) marks that have incongruity; (iv) sound patterns; (v) marks that are part of a display; and (vi) elements to replace letters.

#### (i) Slogans

A slogan is a phrase that is brief and attention getting or a catch phrase that is used as an advertisement, and one may register a slogan that is used as a mark.<sup>44</sup> In general, “[S]logans, by their attention-getting nature, are treated as unitary matter and must not be broken up for purposes of requiring a disclaimer.”<sup>45</sup> But if the entire slogan is generic or merely descriptive, or if it is merely informational, then the USPTO will refuse registration of it as part of a word mark<sup>46</sup> or require disclaimer of it when part of a logo or design mark.<sup>47</sup> When determining whether a slogan is unitary one must consider grammar and punctuation,<sup>48</sup> which includes how the slogan uses verbs,<sup>49</sup> prepositional phrases,<sup>50</sup> punctuation,<sup>51</sup> and possessives.<sup>52</sup>

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<sup>42</sup> TMEP § 1213.05(b) (quoting MacmillanDictionary.com, search of “phrase,” <http://www.macmillandictionary.com/dictionary/american/phrase> (Jan. 31, 2012); THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE 1324 (4th ed. 2006); RANDOM HOUSE WEBSTER’S UNABRIDGED DICTIONARY 1460 (2d ed. 2001)).

<sup>43</sup> TMEP § 1213.05(b); Dena, 950 F.2d at 1561 (EUROPEAN FORMULA and design for cosmetic products not unitary because the elements were not so merged that they could be regarded as separate).

<sup>44</sup> TMEP § 1213.05(b)(i).

<sup>45</sup> TMEP § 1213.05(b)(i); *see e.g.*, In re Shachnow, 2015 WL 910207, \*3 (T.T.A.B. Feb. 2, 2015) (explaining that no disclaimers of WORLD were required in slogans THE WORLD’S TRAVEL INSPIRATION ENGINE and TRAVEL THE WORLD ONE HOP AT A TIME because each were unitary); In re Sears Brands, LLC, 2010 WL 5522986, \*7 (T.T.A.B. Dec. 20, 2010) (no disclaimer required for slogan SEARS BLUE SERVICE CREW).

<sup>46</sup> TMEP § 1213.05(b)(i); *see* In re Ralston Purina Co., 2001 WL 473991, \*2 (T.T.A.B. May 2, 2001) (cancelling registration for WORLD’S BEST CAT LITTER); In re 800-Gifthouse, Inc., 1999 WL 612964, \*2 (T.T.A.B. Aug. 11, 1984) (refusing to register WORLD’S FAVORITE FLORIST); In re Carvel Corp., 223 U.S.P.Q. 65, \*4-\*6 (T.T.A.B. 1984) (holding AMERICA’S FRESHEST ICE CREAM for flavored ices, ice cream, *etc.*, incapable of distinguishing applicant’s goods and unregistrable on the Supplemental Register); In re Wakefern Food Corp., 222 U.S.P.Q. 76, \*3-\*5 (T.T.A.B. 1984) (holding WHY PAY MORE! for supermarket services to be an unregistrable common commercial phrase).

<sup>47</sup> *See e.g.*, In re Paradise Mountain Organic Estate Coffee, Ltd., 2016 WL 1045687, \*7 (T.T.A.B. Feb. 24, 2016) (requiring disclaimer of THE WORLD’S MOST SUSTAINABLE in stylized mark).

<sup>48</sup> TMEP § 1213.05(b)(iii) (“Grammatical structure and punctuation may play a part in the analysis of whether a phrase or slogan would be viewed as unitary. Such considerations serve as guidelines rather than dispositive factors and the weight to be given each depends upon the overall meaning and commercial impression of the mark”).

<sup>49</sup> TMEP § 1213.05(b)(ii)(A) (“The presence of a verb may indicate that a mark or portion of a mark is a unitary phrase or slogan by linking a subject and an object, or by referring to something that is ongoing, thereby creating continuity of thought or expression.”).

<sup>50</sup> TMEP § 1213.05(b)(ii)(B)

Wording in a mark that comprises a prepositional phrase is generally connected or unified by the preposition(s) in such a way that the elements would

(ii) Double Entendres

This issue of a “double entendre” arises when a word or an expression has more than one meaning, and by definition, it is unitary.<sup>53</sup> If one of the meanings of a double entendre is not merely descriptive of the recited goods and services, then no disclaimer will be required for either the mark or a component of it.<sup>54</sup>

(iii) Incongruity

If two or more terms are combined within a mark in a manner to create an incongruity, then the mark is deemed unitary and no disclaimer of non-distinctive elements is necessary.<sup>55</sup>

not be regarded as separable. In addition, marks comprised of prepositional phrases often have the commercial impression of a catch phrase or slogan. In some instances, however, marks contain distinctive matter followed by unitary prepositional phrases that are informational or descriptive, and these prepositional phrases are separable from the rest of the mark and must be disclaimed.

<sup>51</sup> TMEP § 1213.05(b)(ii)(C)

Punctuation may either unite or separate all or some of the words in the mark. Where punctuation unites all the words, the mark or phrase as a whole is likely unitary. Where punctuation separates some of the words, however, the result likely indicates a mark or phrase that is not unitary, requiring disclaimer or refusal of the unregistrable matter. Therefore, the punctuation in the mark must be considered in connection with an assessment of the specific arrangement of the words and the overall meaning and commercial impression of the slogan or phrase.

<sup>52</sup> TMEP § 1213.05(b)(ii)(D)

Generally, the use of a possessive form of a word in a mark does not, by itself, merge the wording so as to create the commercial impression of a unitary phrase or slogan. However, if the mark contains the possessive form of a word as well as one of the considerations discussed above, this combination of the elements may result in a slogan or unitary phrase.

<sup>53</sup> TMEP § 1213.05(c); *see generally* Scott D. Locke and Laura-Michelle Horgan, *Double Entendres, Intentional Misspellings and Descriptive Marks*, NEW YORK LAW JOURNAL (May 15, 2017).

<sup>54</sup> TMEP § 1213.05(c)

A “double entendre” is a word or expression capable of more than one interpretation. For trademark purposes, a “double entendre” is an expression that has a double connotation or significance *as applied to the goods or services*. The mark that comprises the “double entendre” will not be refused registration as merely descriptive if one of its meanings is not merely descriptive in relation to the goods or services.

(emphasis added);

*See e.g.*, *In re Tea and Sympathy, Inc.*, 88 U.S.P.Q.2d 1062, \*3 (T.T.A.B. 2008) (THE FARMACY registrable for retail store services featuring natural herbs and organic products and related health and information services relating to dietary supplements and nutrition).

<sup>55</sup> TMEP § 1213.05(d) (“If two or more terms are combined in a mark to create an incongruity (e.g., URBAN SAFARI, MR. MICROWAVE, and DR. GRAMMAR), the mark is unitary and no disclaimer of nondistinctive individual elements is necessary.”); *In re Corporate Fuel Partners, LLC*, 2010 WL 3501479, \*2 (T.T.A.B. Aug. 27, 2010) (“Where a mark comprises two or more terms that create and incongruity the mark is unitary and no disclaimer is necessary.”); *cf.* *In re Millersport*,

(iv) Sound Patterns

The creation of sound patterns does not in and of itself render a mark unitary. Thus, alliterative or repeated wording does not necessarily make a mark unitary.<sup>56</sup> However, in some circumstances “a rhyming pattern, alliteration, or some other use of sound that creates a distinctive impression” has been found to cause the mark to be unitary. In these cases, the USPTO has not required disclaimer of any elements.<sup>57</sup>

(v) Display of a Mark

The USPTO will also consider how a mark is presented when evaluating whether a disclaimer is necessary. If the visual display causes the mark to be viewed as unitary, then the USPTO will not require a disclaimer.<sup>58</sup>

(vi) Elements Replacing Letters

Substituting one or more symbols for letters will not in and of itself render a mark unitary.<sup>59</sup> Consequently, even when a symbol is used for

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2006 WL 2646005, \*1 (T.T.A.B. Aug. 28, 2006) (GOLDEN GLOVE not incongruous and disclaimer was required).

<sup>56</sup> TMEP § 1213.05(e) (“Alliterative or repeated wording does not in itself make a mark unitary.”). *See e.g.*, In re Austin Brothers’ Beer Co LLC, 2016 WL 7646391, \*3 (Dec. 13, 2016) (alliteration of WOODY WHEAT does not render mark unitary); In re Ginc UK Ltd., 90 U.S.P.Q.2d 1472, 1477 (T.T.A.B. 2007) (finding the rhyming quality of the words ZOGGS TOGGS “does not infuse TOGGS with any separate and distinct meaning apart from its generic meaning”); In re Lean Line, Inc., 229 U.S.P.Q. 781, 782 (T.T.A.B. 1986) (holding LEAN LINE *not* unitary; “there is nothing in the record to suggest that the mere fact that both words which form the mark begin with the letter ‘L’ would cause purchasers to miss the merely descriptive significance of the term ‘LEAN’ or consider the entire mark to be a unitary expression.”).

<sup>57</sup> TMEP § 1212.05(e) (“In rare cases, a rhyming pattern, alliteration, or some other use of sound that creates a distinctive impression may contribute to a finding that the mark is regarded as unitary and individual elements should not be disclaimed.”). *See* In re Kraft, Inc., 218 U.S.P.Q. 571, 573 (T.T.A.B. 1983) (finding LIGHT N’ LIVELY to be a unitary term not subject to disclaimer, because the mark as a whole “has a suggestive significance which is distinctly different from the merely descriptive significance of the term ‘LIGHT’ per se” and that “the merely descriptive significance of the term ‘LIGHT’ is lost in the mark as a whole.”). Other evidence, such as registrations of the mark for related goods and consumer recognition of the mark as a unitary expression, may also contribute to a finding that the mark is unitary. *Id.*

<sup>58</sup> TMEP § 1212.05(f) (“The visual presentation of a mark may be such that the words and/or designs form a unitary whole. In such a case, disclaimer of individual nondistinctive elements is unnecessary.”). *See, e.g.*, In re Texsun Tire & Battery Stores, Inc., 229 U.S.P.Q. 227, 229 (T.T.A.B. 1986) (“[T]he portion of the outline of the map of Texas encircled as it is with the representation of a tire and surrounded by a rectangular border results in a unitary composite mark which is unique and fanciful.”); *cf.* In re Slokevage, 441 F.3d 957, 962-63 (Fed. Cir. 2006) (holding trade dress configuration of product design consisting of a label with the words “FLASH DARE!” in a V-shaped background, and cut-out areas located on each side of the label, with the cut-out areas consisting of a hole in a garment and a flap attached to the garment with a closure device not to be unitary where applicant owned separate registrations for some of the elements and in view of the separate locations of the words and design elements).

<sup>59</sup> TMEP § 1212.05(g) (“when a design element replaces one or more letters (or a portion of a letter or letters) in a word that is merely descriptive, generic, or geographically descriptive, this combination of word and design element does not create a “unitary mark” if the word remains recognizable”).

a letter, an examiner may require the filing of a disclaimer.<sup>60</sup> However, “[i]f literal and design elements in a mark are so merged together that they cannot be divided or regarded as separable elements, these elements may be considered unitary. For example, where the design element replacing a letter is merely one part of a larger design, the mark may be unitary, and no disclaimer of the descriptive or generic wording is required.”<sup>61</sup>

### III. DEFERENCE TO USPTO

As noted above, by statute, the USPTO has discretion in determining whether to issue a requirement for a disclaimer.<sup>62</sup> But the USPTO does not have the final word as to whether its own actions are appropriate.<sup>63</sup> Therefore, one must consider how the courts will treat appeals from the USPTO, as well as during litigation, what weight courts may give to a USPTO decision to issue or not to issue a disclaimer requirement.

#### *A. Appeals from the USPTO*

The CAFC has held that the TTAB’s determination that a mark or term is descriptive or generic is a factual finding that should be upheld unless the finding is unsupported by substantial evidence.<sup>64</sup> In *In re Stereotaxis, Inc.*, the CAFC elaborated that this type of evidence may be from any competent source, such as dictionaries, newspapers or surveys.<sup>65</sup> When challenging a determination of the TTAB, the challenger must show that its proposed meaning would be the only one accepted by the public.<sup>66</sup> As a matter of practice, applicants rarely challenge these requirements, and when they do file challenges, they often find difficulty in obtaining a reversal of an examiner’s exercise of his or her discretion.

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<sup>60</sup> See *In re Clutter Control, Inc.*, 231 U.S.P.Q. 588, 590 (T.T.A.B. 1986) (disclaimer required with two letter C’s were replaced with elongated tube like renditions of Cs in CONSTRUCT-A-CLOSET).

<sup>61</sup> TMEP § 1212.05(g)(ii).

If the design that replaces a letter within descriptive or primarily geographically descriptive wording is itself merely descriptive or primarily geographically descriptive, or is otherwise nondistinctive, the examining attorney must require the applicant to amend to the Supplemental Register or seek registration on the Principal Register under § 2(f) and to disclaim any generic wording.

*Id.*

<sup>62</sup> 15 U.S.C. § 1056.

<sup>63</sup> An applicant can appeal decisions of the USPTO to the Court of Appeals for the Federal Circuit and to a federal district court. 35 U.S.C. § 1071. Additionally, during litigation between private parties, accused infringers frequently try to challenge the validity of trademarks.

<sup>64</sup> *In re Louisiana Fish Fry Products, Ltd.*, 797 F.3d at 1335 (genericism is reviewed for substantial evidence); *In re Stereotaxis*, 429 F.3d 1039, 1041 (Fed. Cir. 2005) (review of determination of descriptiveness is reviewed for substantial evidence).

<sup>65</sup> *In re Stereotaxis*, 429 F.3d at 1042.

<sup>66</sup> *Id.*

### *B. Inferences during litigation*

In an appeal from *ex parte* prosecution, only an applicant would challenge the USPTO's decision to require the filing of a disclaimer.<sup>67</sup> When, however, a mark is the subject of litigation, an applicant might ask a court to rely on the USPTO's failure to issue a disclaimer requirement as evidence that a mark is unitary or a particular portion of a mark is neither generic nor descriptive. Similarly, a party that is being accused of infringing a trademark that is the subject of a trademark registration that contains a disclaimer might request that a court devalue the disclaimed element or deem its existence as a type of waiver. Thus, often courts will be asked to decide how much weight to give an action or inaction of the USPTO under the Trademark Disclaimer Provision.

#### *1. Treatment of terms within a registration*

For matters of trademark prosecution, the TMEP is clear: "A disclaimer does not remove the disclaimed matter from the mark. The mark must still be regarded as a whole, including the disclaimed matter, in evaluating similarity to other marks."<sup>68</sup> Many courts have echoed this view.<sup>69</sup> Yet there is a lack of consensus among the courts as to how much weight to give a disclaimer.

According to the Court of Appeals for the First Circuit, "a decision by the PTO to either require a disclaimer or not is merely a single piece of evidence in the court's overall . . . analysis."<sup>70</sup> Similar to the First Circuit, the CAFC has held that the presence or absence of a disclaimer has no legal significance in a likelihood of confusion analysis, but its presence can affect the weighting to be given to different

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<sup>67</sup> Because an applicant is permitted to file a voluntary disclaimer and an examiner must accept it, 15 U.S.C. § 1056(b), there would be no circumstance in which the applicant would appeal the non-entry of a disclaimer.

<sup>68</sup>TMEP § 1213.10; *see also* Juice Generation, Inc. v. GS Enterprises LLC., 794 F.3d 1334, 1341 (Fed. Cir. 2015) ("While the Board may properly afford more or less weight to particular components of a mark for appropriate reasons, it must still view the mark as a whole"); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1059 (Fed. Cir. 1985) (technical effect of disclaimer in application has no legal effect on the issue of likelihood of confusion); *Grout Shield Distributors, LLC v. Elio E. Salvo, Inc.*, 824 F. Supp. 2d 389 (E.D.N.Y. Nov. 16, 2011) (it is inappropriate to give the presence or absence of a disclaimer and legal significance wherein the USPTO's practice of issuing them have been far from consistent).

<sup>69</sup> *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1530 (4th Cir. 1984)

While a composite term, including disclaimed words or figures, is to be considered in its entirety in determining validity of a trade mark, it is a settled principle of trademark law that the dominant part of a mark may be given extra weight on the issue of likelihood of confusion;

*Select Auto Imports Inc.*, 2016 WL 3742312, \*12 ("Courts are particularly inclined to find similarity when there is an overlap in the marks' dominant terms, even the marks contain other dissimilar words"); *Juice & Java, Inc. v. Juice & Java Boca, LLC*, 2015 WL 11233191, \*3 (S.D. Fla. Aug. 25, 2015) (disclaimed material cannot be ignored in likelihood of confusion analysis); *Tropical Nut & Fruit Co. v. Forward Foods, LLC.*, 2013 WL 2481521, \*2 (W.D.N.C. June 10, 2013) (quoting *Pizzeria Uno Corp.*).

<sup>70</sup> *Boston Duck Tours*, 531 F.3d at 22; *Minnesota Specialty Crops, Inc. v. Minnesota Wild Hockey Club, LP*, 2002 WL 1763999, \*4 (D. Minn. July 26, 2002).

portions of mark.<sup>71</sup> Thus, to many courts, neither the action nor the inaction under the Trademark Disclaimer Provision is determinative. However, if as the First and Federal Circuits suggest, the presence or absence of a disclaimer is merely a factor to consider, it begs the unanswered question of how much weight should be given to that factor.<sup>72</sup>

Additionally, one should note that the Court of Appeals for the Fourth Circuit has chosen to rely on USPTO action to a greater degree than the courts of appeals for the First and Federal Circuits, holding that the filing of a disclaimer is a concession by an applicant that a term is at least descriptive and indistinctive.<sup>73</sup>

*Boston Duck Tours, LP v. Super Duck Tours, LLC*,<sup>74</sup> provides a good example of the framework of how courts look to disclaimers as one among many factors under the dominant view as suggested by the First and Federal Circuits. In that case, the plaintiff owned state and federal trademark registrations for the both the composite word mark BOSTON DUCK TOURS and a design mark that consisted of the company's name and logo in connection with both sightseeing tours and clothing.<sup>75</sup> For the sightseeing services, Boston Duck disclaimed the terms DUCK and TOURS.<sup>76</sup>

The defendant ("Super Duck") obtained a federal registration for the mark SUPER DUCK TOURS in connection with tour services, but the USPTO required Super Duck to register its mark on the supplemental register because the entire mark was descriptive of its services.<sup>77</sup> During *ex parte* prosecution with the USPTO, the defendant (applicant) took the position that DUCK TOURS was not generic, but during the litigation, it took the opposite position.<sup>78</sup> During litigation, at issue was whether the use of SUPER DUCK TOURS was likely to be confused with BOSTON DUCK TOURS and if so, what effect both the plaintiff's disclaimer of DUCK TOURS and the defendants' position during *ex parte* prosecution would have on the case.

The trial court issued a preliminary injunction, enjoining Super Duck from using the phrase DUCK TOURS in association with its sightseeing services.<sup>79</sup> That court examined the marks *in toto* and concluded that the plaintiff would likely prevail on

<sup>71</sup> *In re National Data Corp.*, 753 F.2d 1056, 1058-59 (Fed. Cir. 1985) ("it is inappropriate to give the presence or absence of a disclaimer any legal significance").

<sup>72</sup>  *Scooter Store, Inc. v. SprinLife.com*, 2011 WL 6415516, \*8 (S.D. Ohio Dec. 21, 2011) (*Boston Duck* court "did not discuss, however, the weight to be afforded a PTO examiner's overall determination on a mark's distinctiveness."). But at a minimum, the USPTO's failure to issue a disclaimer over a descriptive or generic term is not determinative. *Humboldt Wholesale, Inc. v. Humboldt Nation Distribution, LLC*, 2011 WL 6119149, \*3 (N.D. Cal. 2011) (failure to do so is not in and of itself a basis on which to invalidate a trademark.); *see also Top Producer Sys. v. Software Scis.*, 1997 WL 723049 (D. Or. July 21, 1997) (finding no authority that "gives the court the jurisdiction to enter a disclaimer or cancel a mark based upon failure to disclaimer").

<sup>73</sup> *Grayson O Company*, 856 F.3d 307, 318 (4th Cir. 2017) (disclaimer was concession of descriptiveness); *Smith v. Entrepreneur Media, Inc.*, 2013 WL 2296077, \*9 (E.D. Cal. May 24, 2013); *see also J. THOMAS MCCARTHY, 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION*, § 19:65 (5th ed. Dec. 2017) ("A disclaimer of a part of a composite is a concession that that part is descriptive").

<sup>74</sup> *Boston Duck Tours*, 531 F.3d 1 (1d Cir. 2008).

<sup>75</sup> *Id.* at 8.

<sup>76</sup> *Id.*

<sup>77</sup> *Id.*

<sup>78</sup> *Id.* at 22.

<sup>79</sup> *Id.*

the merits as to the issue of whether there was a likelihood of confusion, finding that the phrase DUCK TOURS, which was common to the parties' marks, was not generic.<sup>80</sup>

On appeal, the First Circuit reversed, concluding that the phrase "duck tours" was generic and noting that the decision by the USPTO to issue a disclaimer requirement should not be given too much weight because it is discretionary.<sup>81</sup> The plaintiff tried to establish that DUCK TOURS was not generic by showing that in numerous other applications, the USPTO did not require the disclaimer of those terms.<sup>82</sup> The First Circuit noted that those failures to issue disclaimer requirements were not binding.<sup>83</sup> The plaintiff also tried to take to the position that the defendant was estopped from arguing that DUCK TOURS was generic because during *ex parte* prosecution it took the contrary position.<sup>84</sup> Here too, the First Circuit disagreed with the plaintiff's conclusion.<sup>85</sup>

The First Circuit then applied its likelihood of confusion analysis, and when considering the similarity between the marks, noted: "we focus our inquiry, albeit not exclusively, on the similarities and differences between the works 'Boston' and 'Super,' the nongeneric elements of each mark."<sup>86</sup> The First Circuit acknowledged that it was "[a]llowing 'duck tours' to largely drop out of the analysis," and not surprisingly concluded that the marks are "reasonably, although not completely dissimilar."<sup>87</sup> The court then considered the other likelihood of confusion factors, but what is clear is that the court was greatly influenced by the differences in the terms in each party's mark that was not the disclaimed phrase.<sup>88</sup> Thus, the First Circuit independently reached the same conclusion as the USPTO that within the plaintiff's mark, the elements DUCK TOURS were descriptive and thus the mark was not enforceable outside of the context of its use in conjunction with the term BOSTON. Consequently, one may posit: was there any value in the USPTO issuing the disclaimer requirement?

Additionally, one should note that under the Fourth Circuit's analysis the same conclusion would likely have been reached, *i.e.*, no likelihood of confusion. However, because the Fourth Circuit would have treated the disclaimer by the plaintiff of DUCK TOURS as a concession that the phrase is not distinctive, perhaps reaching that same conclusion would have been a less cumbersome task. Additionally, an applicant does not know in which jurisdiction it might wind up litigating its trademark rights, and in the close case, the Fourth's Circuit treatment of disclaimer

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<sup>80</sup> Boston Duck Tours, 531 F.3d at 10.

<sup>81</sup> *Id.* at 21; Humboldt Wholesale, Inc., 2011 WL 6119149, \*4 ("courts have suggested that because the power of the USPTO to require a disclaimer is discretionary under the statute, and its disclaimers practice over the years inconsistent, it is inappropriate to afford the presence or absence of a disclaimer any legal significance"). Notably, Duck Tours had previously argued to the USPTO that the phrase was not generic when trying to register its own mark. However, the First Circuit held that Duck Tours would not be foreclosed from arguing during the litigation that the phrase was generic. 531 F.3d. at 22.

<sup>82</sup> *Id.* at 25.

<sup>83</sup> *Id.*

<sup>84</sup> *Id.* at 22-23.

<sup>85</sup> *Id.*

<sup>86</sup> *Id.* at 25.

<sup>87</sup> Boston Duck Tours, 531 F.3d at 25.

<sup>88</sup> *Id.*



as a concession of lack of distinctiveness might make the difference between being permitted to establish a likelihood of confusion and having waived the right to do so.

Furthermore, when a disclaimer is only one factor, defendants should not infer that if disclaimed terms are the only term(s) in common, a trademark owner will not necessarily be able to establish a likelihood of confusion. For example, in *Cava Group Inc. v. Mezeh-Annapolis, LLC*,<sup>89</sup> the plaintiff, Cava Group, Inc. (“Cava”) owned and operated a restaurant in Virginia, Maryland and Washington, D.C. that served Greek and Mediterranean food.<sup>90</sup> Cava was also the owner of U.S. Trademark Registration No. 4,059,522 (the “522 Registration”), which was a stylized service mark CAVA MEZE GRILL for restaurant services featuring take-out Mediterranean cuisine, wine, beer, and liquor.<sup>91</sup> The mark claimed the colors, black, white, and orange as features and the mark consisted of the CAVA in capital each letter of which was in white, except for the V, which was in orange.<sup>92</sup>

The defendants (“Mezeh”) opened a Mediterranean restaurant called Mezeh Mediterranean Grill. Mezeh stylized its logo to include the word “mezeh” in lower-case font with everyone-other letter colored white, while both E’s were in orange.<sup>93</sup> Under the letters “eze” was an orange curve.<sup>94</sup> Also, underneath the term Mezeh and to the side was the language MEDITERRANEAN GRILL.<sup>95</sup>

In considering the issue of the likelihood of confusion, the court noted that with respect to the ‘522 registration, the words, MEZE and GRILL were disclaimed.<sup>96</sup> Nevertheless the court deemed the mark as a whole to be distinctive, and when it came time to consider the similarities between the marks, the court applied an anti-dissection rule, which requires consideration of the mark a whole and not the component parts.<sup>97</sup> Accordingly, the court considered the similarities between the bold black, mostly white lettering with certain letters accentuated in some shade of the color orange, a dark background, the of Mezze Grill/Mediterranean Grill below the dominant word of the marks in smaller font, and the identical pronunciation of the terms mezze and mezeh.<sup>98</sup>

The court also acknowledged notable differences, including: the word CAVA appeared in all-capital letters in the ‘522 Registration, while “mezeh” was in lower-case as used by the defendants; the Cava Registration showed only one accented letter, whereas the defendant’s mark had two accented letters; the ‘522 Registration showed a slightly darker orange than the defendant’s mark; and the defendant’s mark showed an arc below the “eze,” whereas no similar element existed in the ‘522 Registration.<sup>99</sup> Ultimately, while acknowledging that the dominant term in the ‘522 Registration was not present in the defendant’s mark, the court concluded that its absence was not entitled to conclusive weight and that a jury could conclude that the

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<sup>89</sup> Cava Group, Inc., 2016 WL 3632689 (D. Md. July 7, 2016).

<sup>90</sup> *Id.* at \*1.

<sup>91</sup> *Id.*

<sup>92</sup> *Id.*

<sup>93</sup> *Id.* at \*4.

<sup>94</sup> Cava Group, Inc., 2016 WL 3632689 at \*4.

<sup>95</sup> *Id.*

<sup>96</sup> *Id.* at \*7.

<sup>97</sup> *Id.* at \*7-8.

<sup>98</sup> *Id.* at \*8.

<sup>99</sup> Cava Group, Inc., 2016 WL 3632689 at \*8.

marks were sufficiently similar to cause confusion, thereby precluding granting either of the cross-motions for summary judgment.<sup>100</sup>

## 2. Family of Marks

Although intellectual property law often focuses on consistency and predictability, section 1056(b) of title 15 is an exception, reciting:

No disclaimer . . . shall prejudice or affect the applicant's or registrant's rights then existing or thereafter arising in the disclaimed matter, or his right of registration on another application if the disclaimed matter be or shall have become distinctive on his goods or services.<sup>101</sup>

This statutory provision has been interpreted to mean that the particular registration to which it applies does not confer exclusive rights in the disclaimed material, but rights in that material can exist independent of the registration.<sup>102</sup> This has two implications.

First, a disclaimer has no effect on any common law rights.<sup>103</sup> As a matter of practice, most registrants that allege trademark infringement do so under both the Lanham Act and under the common law. Therefore, at least doctrinally, the disclaimer will not affect all causes of action. In practice, one can imagine that a court might need significant convincing that a disclaimed term was generic or descriptive for purposes of the Lanham Act but not for purposes of a common law cause of action. Nevertheless, a trademark holder who is able to allege that, for example, the composite mark has become unitary through acquired secondary meaning might be able to thread the needle.

Second, a registrant can obtain a subsequent registration to a disclaimed term or element if the registrant has shown secondary meaning.<sup>104</sup> Therefore, an applicant that has not informed the USPTO in one application that it disclaimed a

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<sup>100</sup> *Id.* at \*9.

<sup>101</sup> 15 U.S.C. §1056(b); *see also* Delta Western Group, LLC v. Ruth's Chris Steak House, 24 Fed. Appx. 957, 959 (Fed. Cir. 2001) (disclaimer in different registration by the same party would not affect the construction of the registration at issue).

<sup>102</sup> *WWP v. Wounded Warriors, Inc.*, 566 F. Supp. 2d 970, 975 (D. Neb. 2008), appeal dismissed, 628 F.3d 1032 (8th Cir. 2011).

<sup>103</sup> *Official Airline Guides, Inc. v. Goss*, 856 F.2d 85, 87 (9th Cir. 1988) (disclaimer TRAVEL PLANNER in registration did not deprive the registrant of any common law rights); *Roederer v. J. Garcia Carrion, S.A.*, 732 F. Supp. 2d 836, 866 (D. Minn. 2010) (disclaimer in one registration does not affect rights in subsequent registration or at common law); *In re Wanstrath*, 7 U.S.P.Q.2d 1412 (Comm'r Pat. & Tr. Jan. 6, 1987).

<sup>104</sup> *Robarb Inc. v. Pool Builders Supply of Carolinas Inc.*, 1991 WL 335811 (N.D. Ga Oct. 31, 1991)

Although Robarb disclaimed the words CRYSTAL CLEAR in its earlier registrations, the fact that Robarb received Registration No. 1,459,564 for "CRYSTAL CLEAR" under provisions of Section 2(f) of the Lanham Act (15 U.S.C.A. Section 1052(f)) is *prima facie* proof that the mark has achieved a secondary meaning in the pool clarifier trade, (emphasis added) affirmed 996 F.2d 1231 (11th Cir. 1993).

term in another application is not fraud on the USPTO.<sup>105</sup> Additionally one can easily see that given the plurality of factors of: different examiners processing different applications, an applicant's ability to vary the goods or services in its listings, and the possibility that a descriptive mark or term can acquire secondary meaning over time, a brand-owner could amass a portfolio of marks wherein the same term within the same or different marks as recited in different registrations would not consistently recite that the same term was disclaimed.

#### IV. POLICY CONSIDERATION

The current version of the Trademark Disclaimer Provision explicitly recites: "The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registerable."<sup>106</sup> Prior to 1962 the statute provided recited "The Commissioner shall require unregistrable matter to be disclaimed."<sup>107</sup>

In the report that the Senate issued when Congress enacted this amendment, there is no discussion of why greater flexibility was given to the USPTO,<sup>108</sup> and the CAFC has noted that the change in language gave the USPTO more "flexibility."<sup>109</sup> However, typically flexibility is appropriate used when an Administrative Agency is looking: to implement procedures for establish forms,<sup>110</sup> to control costs,<sup>111</sup> to manage

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<sup>105</sup> *Quality Services Group v. LJMJR Corp.*, 831 F. Supp. 2d 705, 711 (S.D.N.Y. Nov. 16, 2011).

<sup>106</sup> 15 U.S.C. § 1056(a) (2017).

<sup>107</sup> 15 U.S.C. § 1051(e)(1) (1953); *Dena*, 950 F.2d at 1559 ("Besides deleting some cumbersome language, the 1962 amendment also substituted 'may' for the mandatory 'shall' of the 1946 version. This amendment gave the Commissioner more flexibility in implementing disclaimer policies. The 1962 amendment also allowed applicants to disclaim voluntarily."); *Application of Hercules Fasteners, Inc.*, 203 F.2d at 755

appellant is not entitled to register the same unless descriptive and unregistrable subject matter contained therein is disclaimed. Moreover, the Commissioner of Patents has the right to enforce his requirement for disclaimer by a refusal to register the mark in the event that the requirement is not met. In *re American Cyanamid, etc.*, *supra*. We think this is clearly in accord with the mandate of section 6 of the 1946 Act.

<sup>108</sup> S. Rep. No. 2107, 87th Cong., 2d Sess. 2-3 (1962), reprinted in 1962 U.S.C.C.A.N. 2844, 2845; 87 Cong. Rec. 20,455 (1962) ("Section 3 of the bill proposes to rewrite section 6 of the act relating to disclaimers.").

<sup>109</sup> *In re Wada*, 194 F.3d at 1301 ("The Commissioner is given broad flexibility in implementing disclaimer policies.").

<sup>110</sup> 15 U.S.C. § 1059 (2017)

Subject to the provisions of [15 U.S.C.] section 1058 of this title, each registration may be renewed for periods of 10 years at the end of each successive 10-year period following the date of registration upon payment of the prescribed fee and the filing of a written application, in such form as may be prescribed by the Director.

15 U.S.C. § 1060(5) ("The United States Patent and Trademark Office shall maintain a record of information on assignments, in such form as may be prescribed by the Director"); 15 U.S.C. § 1141a

The owner of a basic application pending before the United States Patent and Trademark Office, or the owner of a basic registration granted by the United States Patent and Trademark Office may file an international application by submitting to the United States Patent and Trademark Office a written application in such form, together with such fees, as may be prescribed by the Director.

timing,<sup>112</sup> to make determinations of the sufficiency of evidence and authenticity of statements,<sup>113</sup> to initiate adversarial proceedings,<sup>114</sup> to select from a set options for resolving adversarial proceedings,<sup>115</sup> or to evaluate subjective issues such as

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15 U.S.C. § 1141(d)

The holder of an international registration that is based upon a basic application filed with the United States Patent and Trademark Office or a basic registration granted by the Patent and Trademark Office may request an extension of protection of its international registration by filing such a request . . . (2) with the United States Patent and Trademark Office for transmittal to the International Bureau, if the request is in such a form, and contains such transmittal fee, as may be prescribed by the Director.

15 U.S.C. § 1141(i) (“The affidavit referred to in subsection (a) shall . . . (1) . . . (C) be accompanied by such number of specimens or facsimiles showing current use of the mark in commerce as may be required by the Director.”).

<sup>111</sup> 15 U.S.C. § 1113(a) (“The Director may waive the payment of any fee for service or material related to trademarks or other marks in connection with an occasional request made by a department or agency of the Government, or any officer thereof.”). Yet even here, Congress was careful to micromanage the Director’s discretion, noting that the Director has discretion in allowing multiple classes in a single registration, but only if there is no cost savings to the applicant in doing so.

<sup>112</sup> 15 U.S.C. § 1051(d)(2) (2017) (“the Director may, upon a showing of good cause by the applicant, further extend the time for filing the statement of use”); 15 U.S.C. § 1126(e) (“Such applicant shall submit, within such time period as may be prescribed by the Director, a true copy, a photocopy, a certification, or a certified copy of the registration in the country of origin of the applicant.”); 15 U.S.C. § 1063(e) (“An opposition may be amended under such conditions as may be prescribed by the Director.”).

<sup>113</sup> 15 U.S.C. § 1051(a)(1) (2017) (“filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by the Director, and such number of specimens or facsimiles of the mark as used as may be prescribed by the Director.”); 15 U.S.C. § 1051 (a)(4) (“The applicant shall comply with such rules or regulations as may be prescribed by the Director. The Director shall promulgate rules prescribing the requirements for the application and for obtaining a filing date herein”); *id.* at § 1051 (b)(4) (“a verified statement, in such form as may be prescribed by the Director.”); 15 U.S.C. § 1051 (b)(4) (“The applicant shall comply with such rules or regulations as may be prescribed by the Director. The Director shall promulgate rules prescribing the requirements for the application and for obtaining a filing date herein”); 15 U.S.C. § 1051 (d)(1)

Within six months after the date on which the notice of allowance with respect to a mark is issued under section 1063(b)(2) of this title to an applicant under subsection (b) of this section, the applicant shall file in the Patent and Trademark Office, together with such number of specimens or facsimiles of the mark as used in commerce as may be required by the Director

15 U.S.C. § 1058(b) (“The affidavit referred to in subsection (a) shall . . . (C) be accompanied by such number of specimens or facsimiles showing current use of the mark in commerce as may be required by the Director”); 15 U.S.C. § 1051(f) (2017)

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 claimed distinctiveness is made.

<sup>114</sup> 15 U.S.C. § 1066 (“Upon petition showing extraordinary circumstances, the Director may declare an interference.”).

<sup>115</sup> 15 U.S.C. § 1068

In such proceedings the Director may refuse to register the opposed mark, may cancel the registration, in whole or in part, may modify the application or registration by limiting the goods or services specified therein, may otherwise restrict or rectify with respect to the register the registration of a registered mark,

intent.<sup>116</sup> Unlike these areas, the disclaimer provision of the Lanham Act is neither procedural nor evidence weighting, and thus it is unique in how it provides discretion to the Director for purposes of flexibility. Additionally, it is unclear why one would want the USPTO to have flexibility in this area beyond its typical discretion in applying the Lanham Act.

Further, even when giving discretion, in a number of areas, Congress has been careful to specifically and explicitly limit this discretion so as not to affect substantive rights. For example, the Director has discretion in establishing a system for classifying goods and services. In this section, Congress explicitly noted both that the Director is permitted to establish a classification of goods and services for the convenience and Patent and Trademark administration and that the classification is not permitted to limit or to extend the applicant's or registrant's rights.<sup>117</sup>

Similarly, the Director has discretion in accepting surrenders of registrations, partial disclaimers of registrations, and amendments of registrations.<sup>118</sup> When the Director exercises any of these rights, the registrant's rights are narrower or non-existent relative to what they were prior to the exercise, and underscoring the importance of not affecting the rights of members of the public, this provision specifically states that if a disclaimer is accepted it cannot materially alter the mark.<sup>119</sup>

Unlike in these two examples, the provision of the Lanham Act that allows for the USPTO to issue disclaimer requirements does not contain any comparable limitations to protect third-parties against improper extension of a trademark holder's rights. This lack of protection for third parties has the potential for the Trademark Disclaimer Provision of the Lanham Act to be among the more problematic provisions of Trademark Law. Yet the issue of improper use or misuse of

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may refuse to register any or all of several interfering marks, or may register the mark or marks for the person or persons entitled thereto, as the rights of the parties under this chapter may be established in the proceedings.

<sup>116</sup> See e.g., *M.Z. Berger & Co., Inc. v. Swatch AG*, 787 F.3d 1368, 1376 (Fed. Cir. 2015) (“Congress expressly rejected inclusion of a statutory definition for ‘bona fide’ in order to preserve ‘the flexibility which is vital to the proper operation of the trademark registration system.’” quoting S. Reg. 100-515 \*24 2d Sess. 1988, P.L. 100-667 ): PTC Research Foundation, *Future of the U.S. Patent and Trademark Office*, 36 IEDA 383, 384 (1996) (discussing flexibility of USPTO with respect to finances); S. Reg. 100-515 \*24 2d Sess. 1988, P.L. 100-667 (to provide flexibility to USPTO and the trademark registration system, Congress did not (i) include a statutory definition of “bona fide,” (ii) place a limit on the number of applications an applicant could file contemporaneously, and (iii) impose a prohibition against an applicant refiling an application to register a mark and thereby extending indefinitely the period of time during which it could “reserve” the mark without making use).

<sup>117</sup> 15 U.S.C. § 1112 (“The Director may establish a classification of goods and services, for convenience of Patent and Trademark Office administration, but not to limit or extend the applicant's or registrant's rights.”).

<sup>118</sup> 15 U.S.C. § 1051(e) (2017)

Upon application of the owner the Director may permit any registration to be surrendered for cancellation . . . [and] may for good cause may permit any registration to be amended or to be disclaimed in part, *Provided*, That the amendment or disclaimer does not alter materially the character of the mark.

Under this provision, the Director accepts a registrant's choice to surrender a registration or to amend the registration. *Id.* With respect to amendments, here Congress was explicitly that the amendment cannot alter materially the character of the mark.

<sup>119</sup> *Id.*

discretion by the USPTO under this provision also has the potential to be irrelevant, because as noted above, most courts believe that the USPTO's action or inaction under this provision is not binding on them, regardless of whether a registrant consents to a disclaimer, the registrant is permitted to file subsequent applications and argue against the requirement, and none of the registrant's common law causes of action bound by a USPTO disclaimer provision. Thus, one must ask, why is there a Trademark Disclaimer Provision of the Lanham Act, and why is it allowed to exist with both flexibility in implementation and ambiguity in the significance of its effects.

## V. CONCLUSION

The conventional wisdom is that the Trademark Disclaimer Provision of the Lanham Act provides the USPTO with flexibility as to whether and when to issue disclaimer requirements. However, as noted above this license of the USPTO is unique to this provision of the Lanham Act, and one should consider an alternative trademark regime under which the USPTO no longer issues these types of requirements. In such a system, the USPTO would consider whether composite marks as a whole are registerable, which is what they do now. If a mark were to contain a descriptive or generic term but as a whole be registerable, the registration would no longer contain a denotation that the registrant would not assert rights in the generic or descriptive term apart from the composite mark, but the registration would still issue. Because the registration is for the composite mark, any enforcement should under this hypothetical system (and the current system) focus on the entire composite mark. Although the applicant would not have made a representation as to refrain from enforcing any descriptive or generic term, as a practical matter, it could not do so, because the term would not be distinctive, which is exactly the same standard as currently exists for causes of action under the common law, for which disclaimers have no impact. Thus, consideration should be given to relieving the USPTO of the unnecessary burden of issuing disclaimer requirements.

Notwithstanding the foregoing, trademark applicants and registrants must accept that their rights are granted under a regime in which the USPTO has discretion whether to require and applicant to disclaim one or more elements of its mark. Because the disclaimer can have the potential to affect rights during litigation and the courts have not created a clear rubric under which to consider how to value a disclaimer, before consenting to a disclaimer, an applicant should consider whether the requirement was warranted.