Knobbe Martens
INTELLECTUAL PROPERTY LAW

IP FOR A NEW AGE®

Trademark Review

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Beware of The "Simple" Assignment of Intent to Use Applications to an Affiliate

Central Garden owned registrations for the mark ZILLA for goods that include pet food, pet treats, and aquariums. Central opposed Doskocil's applications and sought cancellation of Doskocil's registration for marks that include DOGZILLA for dog toys. In addition to denying the allegations of likelihood of confusion, Doskocil brought counterclaims to cancel Central's registrations. Doskocil petitioned to cancel Central's earliest ZILLA registration on the basis that the intent-to-use application underlying that registration was improperly assigned prior to the filing of a statement of use.

Applications filed on the basis of an applicant's intent to use a mark are not assignable prior to filing an amendment to allege use of the mark in commerce, unless the assignment is "to a successor to the business of the applicant, or portion thereof, to which the mark pertains, if that business is ongoing and existing." Trademark Act §10(a)(1); 15 U.S.C. §1060(a)(1).

The application at issue was filed by All-Glass Aquarium Co. Central owns Pennington Seed, which in turn owns All-Glass. Prior to filing an amendment to allege use, All-Glass assigned the application to Central. The assignment expressly included the ZILLA mark and the goodwill of the business connected with the mark. Following the assignment, All-Glass continued in its business of manufacturing aquariums.

The Board held that the assignment of the ZILLA application was contrary to the anti-assignment provisions of the Trademark Act and that the registration must therefore be cancelled. There was no evidence that Central was a successor to the business of All-Glass or any portion thereof. The Board noted that All-Glass continued in the exact same business after the transfer. Section 10 of the Trademark Act "plainly requires more than that the assignee be the recipient of the goodwill associated with the mark."

Central Garden & Pet Company v. Doskocil Manufacturing Company, Inc. (TTAB August 16, 2013)

TTAB Reverses the Refusal to Register BITES OF BOSTON

Bites of Boston Food Tours appealed the refusals to register the marks BITES OF BOSTON and BITES OF BOSTON FOOD TOURS for conducting cultural and culinary guided walking tours of neighborhoods, restaurants and specialty food shops. The applications were refused on the ground of likelihood of confusion with the mark BITE OF SEATTLE for organizing, conducting and supervising

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food festivals. The Board found that the "BITE OF" elements of the registered mark is highly suggestive when used in connection with food festivals, and thus BITE OF SEATTLE is entitled to a narrow scope of protection. As to the similarity of the services, the Examining Attorney asserted the services are closely related in that food festivals and cultural and culinary tours commonly emanate from a single source, and that food festivals commonly feature cultural or culinary tours as events. The Board held that the Examining Attorney's evidence did not support that assertion. The Board also held that there was no evidence that consumers would expect culinary and cultural guided walking tours to emanate from the same source as or to be associated with food festivals. Thus, the Board held there was no likelihood of confusion and reversed the refusals to register both marks.

In re Bites of Boston Food Tours, LLC, Serial Nos. 85376420 and 85397975 (TTAB August 15, 2013)

Updates on Registration of New Generic Top-Level Domains

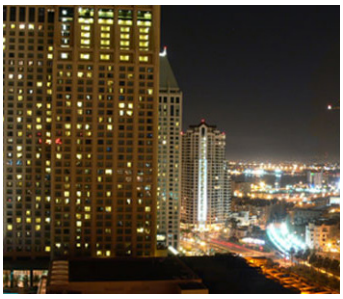
Del Monte Corp. objected to Del Monte International's application to register ".delmonte" as a generic top-level domain (gTLD) claiming the gTLD would lead to customer confusion. The two Del Montes are competing fruit and vegetable sellers that were once commonly owned. WIPO upheld the objection and refused Del Monte International's application. Del Monte International has now filed a lawsuit seeking to reverse the WIPO decision. Del Monte International GmbH v. Del Monte Corp., case number 2:13-cv-05912 (D.C.Cal.)

Dish Network Corp. lost its bid to register the gTLD ".direct" after an objection by DirecTV. Dish Network and DirecTV are direct competitors in the satellite television market. WIPO found that the ".direct" top-level domain is similar to DirecTV's trademarks and would lead to consumer confusion.

DirecTV Group Inc. v. Dish DBS Corp., case number LR02013-0005, (WIPO Arbitration and Mediation Center, August 2013).

Knobbe Martens Offices

Orange County



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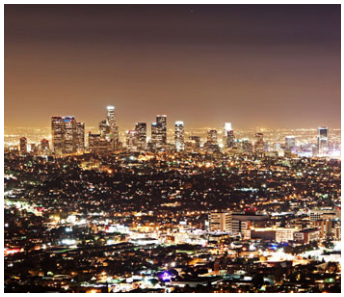
Silicon Valley



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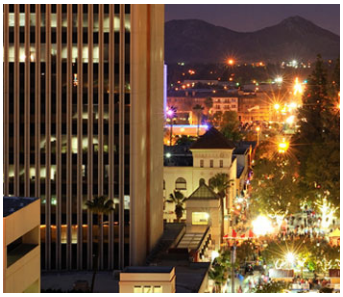

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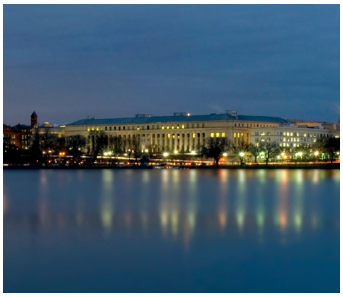
Seattle



Washington DC

Who We Are

Over 95% of our litigators hold technical degrees, including electrical engineering, computer science, mechanical engineering, chemistry, chemical engineering, biochemistry, biology, and physics. Many of our litigators are former Federal Circuit or district court clerks. With eight offices, Knobbe Martens represents clients in all areas of intellectual property law.

- Exclusive practice in the area of intellectual property since 1962
- More than 250 lawyers, many of whom have advanced degrees in various technologies
- Internationally recognized leaders in IP across a vast spectrum of technology areas