

Supplemental Registrations – Actually Worth a Hill of (Coffee) Beans

October 24, 2016 – The TMCA

by Cathy Dahl



The potential defensive value of a registration on the Supplemental Register is highlighted in a recent opinion of the Trademark Trial and Appeal Board, *In re Morinaga Nyugyo*

Kabushiki Kaisha. While we often think of trademarks on the Supplemental Register as less valuable and “junior” in significance, this case reminds us that Supplemental Registrations may bar registration of a mark applied for on the Principal Register on the ground of likely confusion.

Applicant Morinaga Nyugyo Kabushiki Kaisha sought to register the mark MT. RAINIER THE MOUNTAIN OF SEATTLE EXPRESSO & MILK and Design (Serial No. 86/338,392) on the Principal Register for a variety of milk and espresso beverage and food items.

The USPTO issued a final refusal on the basis of likely confusion with two registered marks for coffee owned by Mount Rainier Coffee Company, located in Puyallup, Washington: the MOUNT RAINIER COFFEE COMPANY & Design mark and MOUNT RAINIER COFFEE COMPANY (word mark).

The word mark registration is on the Supplemental Register, and the MOUNT RAINIER COFFEE COMPANY & Design mark is on the Principal Register, with a disclaimer of exclusive rights to “MOUNT RAINIER COFFEE COMPANY.”



Applicant argued that “[g]ranting broad protection to the word portion of the cited registrations would essentially nullify the effect of choosing to register the word mark on the Supplemental Register and eviscerate the disclaimer in the word-plus-design Principal Registration.” Applicant further quoted the observation by Professor McCarthy in his trademark treatise that it is “strange and unsettling” for the USPTO to cite a

Related People

- Cathy Dahl

Related Capabilities

- Trademark, Copyright + Advertising
- Intellectual Property Litigation

Supplemental Registration as a bar to an application for registration on the Principal Register. The Board in *Morinaga* addressed this argument by saying “however strange it may appear to Applicant,” longstanding and binding precedent of the Federal Circuit supports this result.

Indeed, prior rulings of the Court of Customs and Patent Appeals have held that a mark registered on the Supplemental Register is “a mark registered in the Patent and Trademark Office” and may therefore be cited as a bar to registration under Section 2(d) of the Trademark Act. *In re Clorox Co.*, 578 F.2d 305, 198 USPQ 337, 340 (CCPA 1978). The *Clorox* ruling was confirmed in *Towers v. Advent Software Inc.*, 913 F.2d 942, 16 USPQ2d at 1042: “likelihood of confusion can be found even if a term is merely descriptive and does not identify source: Registration on the Supplemental Register is sufficient, and a showing of trade identity rights in the form of secondary meaning is unnecessary.”

According to the Board in *In re Morinaga*, the MOUNT RAINIER COFFEE COMPANY mark may, at least at the time of registration, be primarily geographically descriptive, but that does not mean that it is incapable of achieving acquired distinctiveness. In addition, registering a mark on the Supplemental Register is not an admission that a mark has not acquired distinctiveness, and neither the Trademark Trial and Appeal Board nor the Supplemental Registrant is bound by such an “admission.”

Bottom of the coffee cup: Refusal stands based upon a primarily geographically descriptive mark registered on the Supplemental Register, barring registration of a similar mark for closely related goods.

In re Morinaga also involved an interesting issue concerning refusal of registration on the ground that a mark is primarily geographically deceptively misdescriptive under Section 2(e)(3) of the Lanham Act.

When we think of coffee, many consumers are apt to think of Seattle, mostly likely because of the strength of the Starbucks brand and its origins in that city. The Examining Attorney had issued a final refusal of registration on the additional ground that the word “SEATTLE” is featured in the mark and, as such, the mark is geographically deceptively misdescriptive because the goods do not originate from that location. This determination was made by narrowly focusing on the presence of the word “SEATTLE” in the mark without considering its context in reference to “Mt. Rainier” as “The Mountain of Seattle.” On appeal to the TTAB, Applicant argued that the Examining Attorney improperly dissected the mark and should have instead focused on the context in which the word “SEATTLE” appears, referring to the city’s proximity to Mt. Rainier, rather than indicating the source of origin of the goods. The TTAB agreed, holding that under Section 2(e)(3), the “determination of the geographic misdescriptiveness must be based on consideration of the whole mark.” Accordingly, the refusal under Section 2(e)(3) was reversed by the Board.

Had the Examining Attorney maintained and made final a refusal of registration under Section 2(a) of the Trademark Act, the test is different and may potentially have had a

better leg to stand on. The test under Section 2(a) allows dissection of a mark – “No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it...**consists of or comprises**...deceptive...matter....” (*emphasis added*) Section 2(a) allows a more narrow focus on the allegedly deceptive matter in a mark, whereas Section 2(e)(3) focuses on the mark as a whole.

Bottom of the Coffee Cup: A word within a trademark should be analyzed in context. If the word dominates the commercial impression of the mark as a whole and would be perceived by consumers as indicating the geographic origin of the goods, a refusal on the ground that the mark is primarily geographically deceptively misdescriptive may stand if the goods identified in the application do not in fact originate in the geographic area.