

## Trademark Law Alert - A Limitation in your Trademark Application may not Avoid a Refusal Based on a Prior Registration

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In an attempt to avoid a refusal based on a prior registration of the same or a similar mark for identical or related goods or services, a limitation in your trademark application may be ineffective.

Recent cases demonstrate this.

1. [\*\*\*Kicking Horse Coffee Co. Ltd. v. David John Critchley, Consolidated Opposition No. 91218282 & Cancellation No. 92059924 \(T.T.A.B. February 28, 2019\).\*\*\*](#)

Before the current case was brought, a UK citizen named David John Critchley had applied to register KICK ASS as a trademark for clothing and various beverages including “energy drinks.” The Examining Attorney had refused registration because of a likelihood of confusion with a prior registration of KICK ASS for coffee owned by a Canadian company named Kicking Horse Coffee Co. Ltd. The Trademark Trial and Appeal Board (TTAB) had affirmed the refusal, and Critchley had sought review by the U.S. District Court for the Eastern District of Virginia. However, the U.S. Patent Office (USPTO) and Critchley had settled the case on condition that the beverage goods be amended to say

“excluding coffee-flavored energy drinks, coffee-based energy drinks, and energy drinks having coffee as an ingredient.”

Critchley was granted a registration with this limitation.

Kicking Horse did not like the terms of the USPTO’s settlement. Since Kicking Horse had priority of use, it petitioned to cancel Critchley’s registration, and it also opposed another application filed by Critchley with a similar goods limitation.

The TTAB, found for Kicking Horse, sustained the opposition, and ordered the registration cancelled. It held that there was a likelihood of confusion notwithstanding Critchley’s language excluding coffee from its energy drinks. The TTAB reasoned as follows:

- KICK ASS had essentially the same connotations for coffee and energy drinks.
- Coffee and non-coffee energy drinks have similar energy-providing functions and have emanated from the same source under the same marks.

- Third party uses and registrations of KICK ASS formative marks did not weaken that mark for coffee.
- Consumers familiar with KICK ASS coffee were likely to believe that non-coffee related energy drinks and clothing sold under the identical mark had a connection with the coffee sold under the same mark.

2. [In re Richard Rawlings' Garage, Serial No. 87039427 \(T.T.A.B. November 16, 2018\).](#)

Rawlings Sporting Goods Company, Inc. owned twelve registrations of the marks RAWLINGS and **RAWLINGS** for articles of clothing. Richard Rawlings, a TV personality known for his automotive reality show Fast N' Loud, which had an average weekly viewership of 2.65 million people, had his company, Richard Rawlings' Garage, LLC, apply to register RICHARD RAWLINGS' GARAGE for various articles of clothing that were in part identical to those covered by the prior registration.

The application was limited to

“goods bearing ornamental designs that associate the goods with the persona of Richard Rawlings or his businesses.”

The Examining Attorney refused registration, and the applicant appealed to the TTAB, which affirmed the refusal with the following reasoning:

- The restrictive language was insufficient because the nature and extent of the applicant's proposed ornamental designs were not specified and could be changed at any time. It was not clear how these designs would affect consumer perception of applicant's clothing. Further, both marks were in standard characters, so could be displayed in a similar stylization.
- Applicant had argued that the registrant's goods consisted primarily of sporting apparel while the applicant's goods were related to the persona of Richard Rawlings. In fact, not all of the registrant's listed goods were sports related, and some of applicant's listed goods, such as “t-shirts, underwear and socks,” were identical to registrant's goods.
- The fame of the senior user, not the junior user, was the relevant inquiry for a likelihood of confusion analysis. Consumers would be likely to assume that RICHARD RAWLINGS was the same person as RAWLINGS, and the addition of GARAGE, though arbitrary as to clothing, was subordinate to the first words and not sufficient to differentiate the marks.
- The TTAB referred to *In re 1.am.symbolic, LLC*, 123 USPQ2d at 1748 (Fed. Cir. August 8, 2017), which in the face of a prior registration of I AM for similar or related goods had affirmed the rejection of similar restrictive language “associated with William Adams, professionally known as ‘will.i.am’.”

**Author's Note:** In the first case discussed above, the applicant tried to exclude the registrant's goods. In the second case, the applicant tried to say it would limit its use of the mark in a way that would associate it with a celebrity related to the applicant. Neither approach succeeded.

To have any chance of registering a trademark in the face of a prior registration of a similar mark, the application should, to the extent possible:

- Omit goods identical to those of the prior registrant.
- Include in the description of any related goods specific limitations as to trade channels and classes of purchasers that differ from those of the prior registrant.
- Where the applicant is a celebrity, incorporate into the applied-for mark a specific design or wording clearly associated with the celebrity.

If it is not possible to do these things, the applicant may have to contact the prior registrant to negotiate a consent agreement in which each party agrees to take steps that will avoid a likelihood of confusion. Such an agreement still may not be accepted by the USPTO unless the registration and application are amended to reflect the agreed steps.

For further information, contact [William M. Borchard](#) or your CLL attorney.