

**Stylised mark refused registration due to prior NORDIC mark
United States - Alston & Bird LLP**

**Examination/opposition
Confusion**

September 28 2017

- **TTAB refuses to register stylised mark for likelihood of confusion with NORDIC mark**
- **Held that Icelandic letters did not distinguish it from block letter mark**
- **Goods covered by the registration were legally identical to the applicant's**

In *In re A-Plant 2000 ApS* the Trademark Trial and Appeal Board (TTAB) upheld the examiner's refusal to register the below mark for "horticultural and forestry products, namely, live shrubs, flowering plants in the nature of perennials, and groundcover plants; natural plants and flowers", which was subject to Application Serial 79/162,833.

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The refusal was based on a likelihood of confusion with an existing registration for NORDIC for "live plants, namely holly cultivars" and for being primarily geographically descriptive.

With regard to the likelihood of confusion refusal, the applicant had obtained a consent agreement from the registrant. However, consent agreements are but one of the *du Pont* factors taken into account in evaluating likelihood of confusion. The applicant argued that its mark, in an alleged stylised form (ie, Icelandic letters) looked and sounded different and gave a different commercial impression to the block letter NORDIC mark. The TTAB disagreed, stating that the diacritical markings in the applied-for mark did not serve to distinguish it from the existing block letter NORDIC mark. Since the goods in the application were broadly covering "natural plants" the TTAB also held that the goods covered by the registration overlapped with the applicant's goods as filed and were legally identical.

The applicant attempted to argue that its prior registered NORDIC CARPET mark for the same goods (and for which the parties had a consent agreement) has co-existed with the registrant's NORDIC mark for years without actual confusion and therefore this lack of actual confusion should carry over to the applicant's current application. The TTAB rejected this argument, stating that the lack of actual confusion was inconsequential as the applicant's current mark had not yet been used in the United States; further, the differences in the marks were clear as the prior mark included the word 'carpet'.

With regard to the consent agreement, the TTAB emphasised that there is no rule *per se* that a consent will always tip the balance to finding no likelihood of confusion. It held that the consent agreement proposed by the applicant had multiple failings. First, although the consent agreement stated that the applicant will not use its mark on "holly cultivars" (the goods covered by the registrant's registration), the goods recited in the application did not reflect this. Additionally, the TTAB was not persuaded by attempts in the agreement to highlight distinctions in the look and commercial impressions of the respective marks. There were also no restrictions in the consent agreement to the parties' respective markets, trade channels or consumers and the agreement lacked any specific measures that would be taken to avoid consumer confusion (eg, different packaging or labels). Finally, the agreement lacked provisions stating that each party had done business for many years in the United States with no instances of confusion. The parties could not make such a statement because the applicant had not yet used the stylised NORDIC mark in the United States. Therefore, in considering the *du Pont* factors, the TTAB found a likelihood of confusion.

With regard to the examiner's geographically descriptive refusal, the applicant accepted a disclaimer by NORDIC thereby conceding that the mark was descriptive. However, the issue remained as to whether the stylisation of the applicant's mark rendered it inherently distinctive and registrable without a claim of acquired distinctiveness. The TTAB held that the Icelandic letters used in the applicant's mark did not create distinctive design elements, and the mark was therefore not inherently distinctive.

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