

# Trademark Review

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## **In-N-Out Loses its Opposition Against In & Out Car Wash**

In-N-Out has been serving hamburgers since 1948 and owns several registrations for its IN-N-OUT marks for restaurants, menu items, clothing and other merchandise. In-N-Out initiated an opposition to an application to register IN & OUT CAR WASH. Then, In-N-Out acquired a registration for the mark IN & OUT covering vehicle repair and painting services and added that registration to its opposition. The Board, however, dismissed the opposition, finding no likelihood of confusion. The Board held that In-N-Out failed to establish that its In-N-Out restaurant marks were famous and thus, the registrations were not entitled to the broader scope of protection given famous marks in determining likelihood of confusion. Although In-N-Out has 262 restaurants, those restaurants are located in only 5 states and most of In-N-Out's advertising is geographically limited to locations near its restaurants. Further, as a private company, In-N-Out opted not to introduce its sales figures into the record and instead relied upon testimony of one of its executives. The Board found the testimony of that witness was unsupported and speculative and failed to show that the general consuming population has the required level of recognition of the IN-N-OUT marks.

The Board focused its discussion of likelihood of confusion on the asserted registration "which is most similar to that of applicant," namely, the registration for IN & OUT covering vehicle repair and painting services. The Board concluded there was insufficient proof that car washing and car repair and painting services are related. That conclusion was supported in part by the testimony of In-N-Out's witness that "the primary business of a car wash business is distinct from the primary business of a paint and body shop . . .," and the washing of a vehicle would be incidental to the repair or painting of a vehicle.

*In-N-Out Burgers v. Fast Lane Car Wash & Lube, LLC*, Opposition No. 91183888 (March 14, 2013)

## **Did Tiffany Catch Costco Red-Handed or Is "TIFFANY" Generic for Ring Settings?**

Tiffany sued Costco Wholesale Corp. on February 14, 2013, alleging that Costco is using the TIFFANY trademark in its stores to sell unauthorized diamond rings. Tiffany alleges that its investigators found signs in the store using the "TIFFANY" trademark. In reply, Costco alleges that it uses a term to refer to the particular type of ring setting and that "TIFFANY" has become a generic term when used to describe that particular ring setting. Costco has also asked for a declaratory judgment that would cancel Tiffany's trademark rights to the TIFFANY name when used for ring settings. This will likely be a hard fought battle as Tiffany fights to protect

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- Did Tiffany Catch Costco Red-Handed or Is "TIFFANY" Generic for Ring Settings?
- RED GOLD® Is Revived on Appeal After Being Declared Generic



its valuable trademark.

*Tiffany & Co. v. Costco Wholesale Corp.*, (Case number 1:13-cv-01041 (SDNY)).

## **RED GOLD® Is Revived on Appeal After Being Declared Generic**

Solid 21 was issued a U.S. registration for the term RED GOLD® in 2008 for use on fine jewelry made of a special alloying of gold with a distinct color. The special alloying is a mixture of gold and copper. Solid 21 sued Breitling seeking to stop Breitling's use of "red gold" in relation to Breitling's watches made of a similar alloy. Breitling brought a motion to dismiss the lawsuit claiming the term "red gold" is generic. The court took notice of Breitling's evidence of published works and other public uses of "red gold" and granted Breitling's motion to dismiss the lawsuit. On appeal, the Ninth Circuit Court of Appeals reversed the district court ruling. In reversing the district court's decision, the court found that a party asserting a U.S. registration is entitled to a strong presumption that the registered mark is valid and not generic and that the district court inappropriately considered Breitling's evidence challenging the allegations in the complaint. Rather, the proper inquiry on a motion to dismiss is whether the pleadings adequately state a claim upon which relief can be granted.

*Sold 21, Inc. v. Breitling USA, Inc.*, (Case number 11-56439 (9th Cir. March 19, 2013)).

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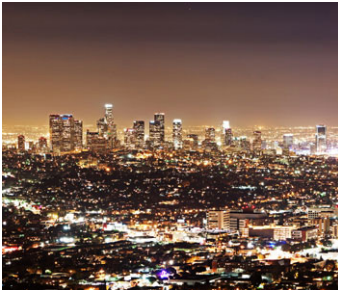
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