TTAB PRECEDENTIAL CASES 2025

TTAB INSIGHTS NEWSLETTER

HARNESS IP

In 2025, the TTAB issued **636 decisions**, but designated only **12**—or **1.8%**—as precedential, representing both the **fewest precedential decisions** and the **lowest rate** in the past five years. By comparison, in 2024 the Board issued 657 decisions, with 33 precedential; in 2023, 687 decisions with 51 precedential; in 2022, 644 decisions with 54 precedential; and in 2021, 721 decisions with 55 precedential. Among last year's precedential decisions, several important takeaways stand out.

1 | SECTION 44(d) PRIORITY DOES NOT REQUIRE A TREATY WHERE NATIONAL LAW PROVIDES RECIPROCITY

In *CandyVerse, LLC v. Zeeth Ltd.*, Opposition No. 91289595 (TTAB Nov. 24, 2025), CandyVerse—asserting prior common-law rights in **CANDYVERSE** for candy, candy-related educational and entertainment services, and retail store services—opposed Zeeth's application to register **CANDYVERSE** for confectionery, beverages, and retail store services.

On cross-motions for summary judgment, the sole issue was whether CandyVerse possessed prior proprietary rights in its pleaded mark. That issue, in turn, depended on whether Zeeth was entitled to claim priority to its European application under **Trademark Act § 44(d)**.

To obtain a priority filing date under Sections 44(b) and (d), an applicant must: (1) file the U.S. application within six months of the first-filed foreign application; (2) include a verified statement of a bona fide intent to use the mark in U.S. commerce; and (3) show that the applicant's country of origin and the country in which the foreign application was filed either (a) are parties to an international treaty or agreement with the United States providing a right of priority, or (b) extend reciprocal priority rights to U.S. nationals.

CandyVerse challenged Zeeth's eligibility to claim Section 44 priority on the ground that Zeeth—a juristic person organized in the British Virgin Islands—could not satisfy the treaty or reciprocity requirement. Zeeth conceded that the British Virgin Islands is not a party to a relevant treaty or agreement with the United States, but argued that the **Virgin Islands Trade Marks Act (VITMA)** extends reciprocal priority rights to U.S. nationals, thereby satisfying Section 44(d).

After examining the VITMA, the Board agreed, concluding that the statute provides priority rights to U.S. nationals reciprocal to those afforded to foreign applicants under Section 44(d). The Board emphasized that reciprocity does not require the foreign statute or procedures to be identical to U.S. law. Because the VITMA sufficiently demonstrated reciprocal treatment, Zeeth was entitled to claim priority.

Accordingly, the Board dismissed the opposition, contingent on Zeeth's establishment of constructive use to complete its priority claim.

> ***What to take away:*** The TTAB demonstrated how to assess statutory reciprocity under Section 44(b), offering guidance for priority claims from non-treaty jurisdictions.

2 | LINKED VIDEOS ARE NOT ADMISSIBLE EVIDENCE IN TTAB PROCEEDINGS

In *In re Jimenez*, Serial No. 97551823 (TTAB Nov. 5, 2025), the applicant sought registration of **GASPER ROOFING** for roofing services. The Examining Attorney issued a final refusal on two grounds: that **GASPER** was primarily merely a surname under 15 U.S.C. § 1052(e)(4), and that **GASPER ROOFING** was confusingly similar to **JASPER CONTRACTORS** for roofing services. During the appeal, the surname

refusal was withdrawn, leaving likelihood of confusion as the sole issue before the Board.

The TTAB first sustained the Examining Attorney's objection to evidence submitted for the first time with the applicant's appeal brief. Reiterating that an application record must be complete prior to appeal, the Board explained that—even if timely—submitting only a hyperlink and screenshot to a video is insufficient to place its contents into the record. Because websites are transitory, the actual video file must be submitted as evidence to be considered.

Turning to the merits, the TTAB nevertheless reversed the likelihood-of-confusion refusal. Although the Board found the services and trade channels to be identical, it concluded that the marks were sufficiently dissimilar. In particular, the Board emphasized that the initial letters "G" and "J" would be pronounced differently, resulting in distinct pronunciations of the marks as a whole. The TTAB clarified that the oft-cited principle that there is "no correct pronunciation" of a mark generally applies to coined terms; by contrast, words with established meanings have established pronunciations that may be considered in the analysis.

The Board also found that roofing services are purchased with a heightened degree of care, which further reduced the likelihood of confusion. Taken together, the dissimilarity in sound, appearance, meaning, and commercial impression—combined with elevated purchaser care—outweighed the identity of the services, trade channels, and classes of consumers.

> ***What to take away:*** The decision provides practical guidance on how to properly introduce video evidence into the record and refines the "no correct pronunciation" principle by limiting its application to coined or inherently ambiguous terms.

3 | NAKED CONSENT IS INSUFFICIENT TO OVERCOME AN APPARENT LIKELIHOOD OF CONFUSION

In *In re Ye Mystic Krewe of Gasparilla*, Serial No. 90522364 (TTAB Oct. 14, 2025), Ye Mystic Krewe of Gasparilla sought registration on the Supplemental Register of the standard-character mark **GASPARILLA** for goods in multiple classes, including mugs in Class 21 and clothing in Class 25. Registration was partially refused based on a prior registration for **GASPARILLA TREASURES** covering beverage glassware in Class 21 and "hats; shirts; sweatshirts; tank tops" in Class 25.

The applicant requested reconsideration, explaining that it had licensed its **GASPARILLA** mark to the owner of the cited registration and that it would submit either an assignment or a consent-to-registration agreement to overcome the refusal. No agreement was submitted with the request. When the applicant later included a consent agreement with its appeal brief, the Board remanded the case. On remand, the Examining Attorney reissued the final refusal, concluding that the proffered consent agreement was a "naked consent" insufficient to obviate the likelihood of confusion. The appeal resumed, during which the applicant obtained multiple extensions while unsuccessfully attempting to negotiate an assignment of the cited registration.

The TTAB affirmed the partial refusal following a comprehensive analysis of the relevant *du Pont* factors. The Board first addressed the similarity of the goods, trade channels, and classes of consumers, and then the similarity of the marks—factors the applicant largely did not contest, instead relying almost exclusively on the tenth *du Pont* factor, the consent agreement.

With respect to the consent agreement, the Board reiterated that such agreements may, in appropriate circumstances, be entitled to great weight because the parties are often in the best position to assess real-world marketplace conditions. However, there is no per se rule that any consent agreement—regardless of its terms—will overcome a likelihood-of-confusion refusal. Rather, each agreement must be examined on its face.

Relying on Federal Circuit guidance, the Board evaluated the consent agreement under five non-exclusive considerations:

1. Whether the consent reflects an agreement between both parties;
2. Whether it clearly indicates that the goods or services travel in separate trade channels;

3. Whether the parties agree to restrict their respective fields of use;
4. Whether the parties agree to take steps to prevent confusion and to cooperate if confusion arises; and
5. Whether the marks have coexisted for a meaningful period without evidence of actual confusion.

The TTAB found that the consent agreement failed on multiple fronts. It did not indicate that the goods would travel in separate trade channels, did not restrict the parties' fields of use, and did not otherwise explain how confusion would be avoided. As the Board observed, a consent agreement is more persuasive when it "shows the work" rather than merely reciting a conclusion.

Although the Board gave some weight to the existence of the agreement, the parties' acknowledgement that confusion had not occurred (over a brief period), and their promise to address any future confusion, these considerations did not outweigh the remaining *du Pont* factors. Given the high degree of similarity between the marks, the identity or legal identity of the goods, and the presumption that the goods move through the same trade channels to the same consumers, the Board concluded that confusion was likely. The tenth *du Pont* factor did not overcome the strong showing on the other factors, and the refusal was affirmed.

> ***What to take away:*** The decision provides practical guidance on how to properly introduce video evidence into the record and refines the "no correct pronunciation" principle by limiting its application to coined or inherently ambiguous terms.

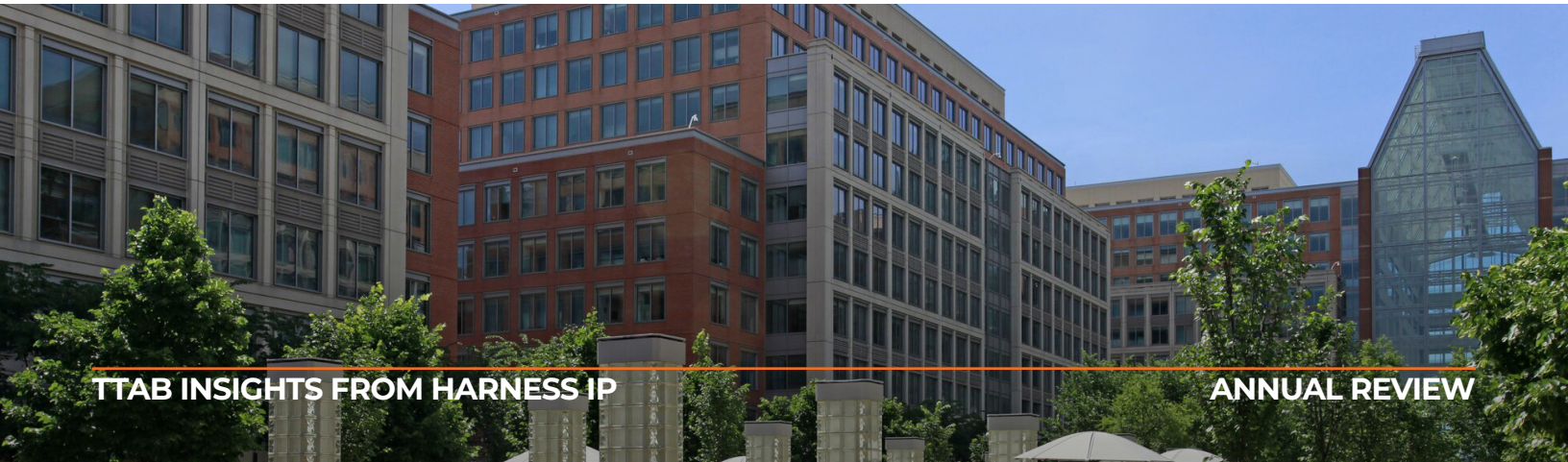
4 | EVIDENCE MUST DEMONSTRATE A BONA FIDE INTENT TO USE THE MARK AS OF THE FILING DATE

In *El Roblar Investment Property LLC v. Bianca Roe*, Opposition No. 91272200 (TTAB Sept. 22, 2025), Bianca Roe sought registration on the Principal Register of the standard-character mark **THE HOTEL EL ROBLAR** for "hotel services" in International Class 43, based on an asserted intent to use the mark in commerce at the time of filing. El Roblar Investment Property LLC ("Opposer") opposed the application on the grounds that (1) Roe lacked a bona fide intention to use the mark and (2) the mark falsely suggested a connection with Opposer in violation of Section 2(a).

After an exhaustive recitation of the applicant's conduct, the TTAB concluded that Opposer made a prima facie showing that Roe lacked a bona fide intent to use **THE HOTEL EL ROBLAR** in commerce for hotel services, and that Roe failed to rebut that showing. Based on the objective evidence of intent and the totality of the circumstances, the Board found that Opposer proved by a preponderance of the evidence that, as of the June 9, 2020 filing date, Roe did not have a bona fide intention to use the mark for hotel services at the property located at 1725 Maricopa Highway—or at any other location.

The TTAB further found that Roe filed the application merely to reserve rights in the mark, rather than with a genuine intent to use the mark in commerce, rendering the application invalid under Section 1(b).

> ***What to take away:*** The decision provides a detailed roadmap of the type and quantum of objective evidence required to establish—or rebut—a bona fide intent to use a mark as of the filing date, and illustrates how the Board evaluates intent based on the totality of the applicant's conduct.



5 MODEL, STYLE, OR GRADE DESIGNATIONS DO NOT CREATE PROTECTABLE TRADEMARK RIGHTS, AND MERE CAPABILITY TO USE A MARK DOES NOT EVIDENCE BONA FIDE INTENT

In *SawStop, LLC v. Felder KG*, Opposition No. 91255905 (TTAB Aug. 14, 2025), Felder KG sought an extension of protection of an international registration to the United States for the standard-character mark **PCS** for stationary woodworking systems on the Principal Register. SawStop opposed the application based on likelihood of confusion, relying on asserted common-law rights in **PCS** and a later-filed application.

Felder conceded that it had not used **PCS** on the identified goods prior to its filing date or prior to SawStop's alleged March 11, 2009 dates of use. Felder nevertheless argued that SawStop lacked priority because its alleged use of **PCS** was not trademark use. According to Felder, until at least Felder's priority date, SawStop used **PCS** almost exclusively as an alphanumeric model designation or alongside the generic product descriptor "professional cabinet saw."

The TTAB reiterated the well-settled principle that terms used merely as model, style, or grade designations do not function as trademarks because they do not identify and distinguish a single source. Examining SawStop's evidence, the Board found that **PCS** appeared to be an abbreviation for "Professional Cabinet Saw" or part of a model number. Although SawStop pointed to instances on its website where **PCS** appeared alone, the Board found little to suggest trademark perception, noting that **PCS** appeared within sentences, in the same size and font as surrounding descriptive text.

Considering the record as a whole, the TTAB concluded that SawStop's evidence showed **PCS** being used solely as a model designation or otherwise in a nondistinctive manner prior to Felder's December 13, 2018 constructive first-use date. The Board therefore analyzed whether **PCS** had acquired distinctiveness among relevant consumers. SawStop relied on sales and promotional figures but failed to isolate data from the relevant pre-filing period. The Board further explained that even significant sales figures do not necessarily establish consumer recognition of a term as a source identifier. Accordingly, SawStop failed to prove, by a preponderance of the evidence, that **PCS** functioned as a distinctive trademark—either inherently or through secondary meaning—prior to Felder's priority date, and the Board did not reach the likelihood-of-confusion analysis.

The Board then turned to SawStop's alternative ground for opposition: lack of bona fide intent to use. On this issue, the TTAB found that SawStop met its initial burden. Felder's only response was that it was a large entity capable of manufacturing the identified goods. The Board found this insufficient, noting that uncontroverted testimony established that Felder had never had plans to manufacture or offer many of the listed goods in U.S. commerce under the **PCS** mark. The TTAB therefore sustained the opposition in part on the ground that Felder lacked a bona fide intent to use the mark.

> ***What to take away:*** The decision provides useful guidance on when a designation will be perceived as a trademark—abbreviations for product names or model numbers, without more, are insufficient—and underscores that a bona fide intent to use requires more than the mere capacity to manufacture the goods identified in an application.

6 INVALIDITY OF A REGISTRATION IS NOT A DEFENSE IN A TTAB PROCEEDING

In *Republic Technologies (NA), LLC v. Joker Smoker Shop, Inc. dba Joker Smoker,* Opposition No. 91286550 (TTAB June 6, 2025), Joker Smoker moved for leave to file an amended answer alleging an additional affirmative defense of abandonment against Republic Technologies' Registration Nos. 1087438 and 2661926 for its "JOKER and JOKER and Design trademarks. Joker Smoker alleging opposer did not use the mark for a period of more than three (3) years, with intent not to resume use, and has thereby abandoned use.

The TTAB said that Applicant's proposed affirmative defense was procedurally improper. Applicant's allegations of abandonment are an attack against the validity of Opposer's pleaded registrations and may be raised only by counterclaims or separate petitions for cancellation, not by affirmative defense.

> ***What to take away:*** Invalidity is not a defense to a registration being asserted in a TTAB proceeding, the registration must be attacked in a counterclaim or a separate cancellation proceeding.

7 PROSECUTION ARGUMENTS MUST BE RAISED ON APPEAL

In *Princeton Equity Group LLC*, Serial No. 97397212 (TTAB June 6, 2025) Princeton Equity Group sought registration on the Principal Register for PRINCETON EQUITY GROUP in standard characters for financial services in Class 36. The Examining Attorney refused registration contending that the mark was: 1) geographically descriptive of Applicant's service, and 2) presented a likelihood of confusion with PRINCETON ENTREPRENURIAL HUB for financial services in Class 36.

On appeal after unsuccessful request for reconsideration, Applicant's "appeal brief [said] little about [the geographical descriptiveness refusal" and "did not address its legal of evidentiary basis." Instead, Applicant stated that it was "common" for the USPTO to register marks that contain a geographic term and "repeated and restated" Applicant's arguments set forth in a response to a non-final office action.

The TTAB reminded Applicant that failing to include arguments in the appeal brief may be considered a waiver of those arguments. Further, incorporation by reference of prior arguments does not suffice as presenting those arguments for the Board's consideration. Instead, this approach shifts the burden to the Board to try and identify Applicant's appeal arguments. As a result the Board stated that in future cases "Parties whose briefs purport to incorporate by reference arguments made during prosecution will be held to have failed thereby to present whatever arguments the incorporation statement purports to cover to the Board and will be deemed to have forfeited them."

> ***What to take away:*** In appeals to the Board, include all arguments in the appeal brief and do not rest solely on the record argued below. Any arguments not set forth in the appeal brief will be deemed waived.

8 INTENT TO USE REQUIRES FACTS, NOT FEELINGS

In *Tequila Cuadra S. de RL de CV v. Manufacturera de Botas Cuadra, S.A. de C.V.,* Opposition No. 91282327 (TTAB May 8, 2025), Applicant sought registration of CUADRA on the Principal Register in connection with "alcoholic beverages, except beer; distilled spirits produced in Mexico in accordance with specific standards" in International Class 33. Tequila Cuadra filed an opposition contending that Applicant lacked a bona fide intent to use the mark, and, that Applicant's mark would cause a likelihood of confusion with Opposer's CUADRA mark for alcoholic spirits.

The Board was persuaded by Opposer's lack of bona fide intent claim. Although noting that the "evidentiary bar for showing bona fide intent to use is not high", the Board stated that "real-life facts and Applicant's actions" are required. Opposer noted that Applicant failed to provide any documentary evidence, communications, invoices, contracts, business plans or any other evidence to support its alleged intent to use. Applicant argued that it had showed bottles of CUADRA labeled liquor in social media campaigns. The Board was not convinced and determined that those uses were merely as props created to be used in connection with promotion of applicant's apparel business, and, that applicant failed to provide any evidence regarding the capacity to produce and sell alcoholic beverages. As a result, the Board sustained the opposition on lack of bona fide intent grounds.

> ***What to take away:*** Remind clients to have dated and documented proof regarding intent to use prior to filing an application.

9 DISMISSALS ARE FINAL JUDGMENTS

In *Faram Holding and Furniture, Inc. v. Faram 1957 S.p.A.* , Petitioner sought to cancel four registrations for FARAM as well as related design marks contending that the marks were abandoned and were never used in commerce. Registrant filed a motion for summary judgment seeking judgment on the affirmative defense of res judicata predicated on prior proceedings between the parties.

The Board agreed that the parties had previously litigated the issues of fraud and abandonment against 3 of the registrations and litigated the issue of likelihood of confusion and false suggestion of connection against the fourth registration. The prior proceedings were both resolved via motions to dismiss with prejudice, which were granted by the Board.

In applying claim preclusion to the cancellation action, the Board stated that the Board's dismissal orders in those cases operated as final judgments on the merits for purposes of claim preclusion. The Board indicated that in seeking dismissal "with prejudice" the Parties indicated intent to decide the issues despite language in the dismissal motions that stated that the withdrawals should be "without entry of judgment against either party".

Nevertheless, the Board determined that Petitioner's claims of abandonment were not raised in the prior opposition, and could be asserted in the cancellation action only as to that registration. Further, the Board stated that Petitioner's abandonment claims against the other three registrations were only barred to the extent it was based on events occurring prior to the previous dismissal, the claim could be asserted based on post-dismissal actions. The Board did bar Petitioner's claims of non-use in commerce as that allegation was the basis for Petitioner's prior fraud claims.

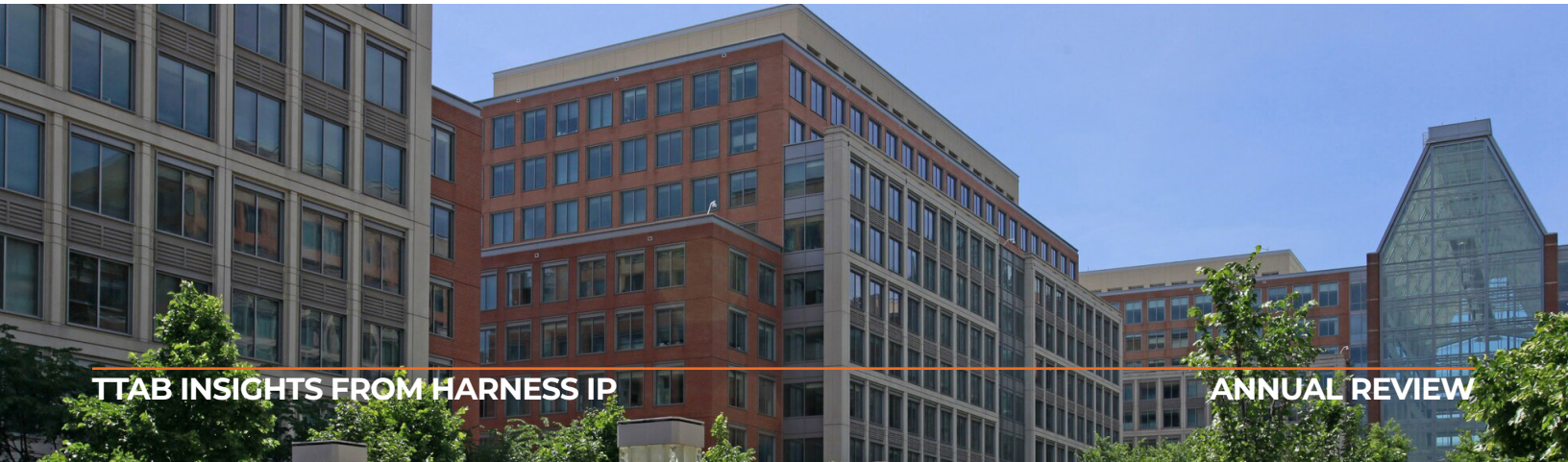
> ***What to take away:*** In appeals to the Board, include all arguments in the appeal brief and do not rest solely on the record argued below. Any arguments not set forth in the appeal brief will be deemed waived.

10 | FOREIGN COMPANIES WITH U.S. BRAND REPUTATION MAY FILE OPPOSITIONS

In Plumrose Holding Ltd. v. USA Ham LLC, Opposition No. 91272970 (TTAB Jan. 17, 2025), Applicant USA Ham, LLC sought registration on the Principal Register "La Monteserratina & Design" in connection with meat products in Class 29. Plumrose Holdings opposed registration based on use of "La Monteserratina" in connection with the name of a Venezuelana pre-package meat company and use of a design mark which includes the words "La Montserratina." Opposer alleged that Applicant's mark should be refused registration because it misrepresents that source of Applicant's goods.

The Board found that Opposer had standing to bring the mark even though Opposer was a foreign company. The Board determined that Opposer had demonstrated that U.S. consumers and grocery stores to whom ***Applicant*** sold its goods had contacted ***Opposer*** seeking clarification as to whether Opposer's goods were available in the United States. Further, Opposer demonstrated that Applicant was aware of Opposer's products and engaged in several actions of copying Applicant's branding and packaging. The Board detemined that this evidenced Opposer's reputation in the United States, and this recognition was sufficient to place Opposer within the zone of interests necessary to lodge an opposition. In doing so, the Board distinguished prior decisions which determined that harm to reputation outside the US is is insufficient to demontrate entitled to lodge an opposition. The Board sustained the opposition.

> ***What to take away:*** Foreign companies without U.S. sales may have sufficient brand recognition and reputation in the U.S. to lodge opposition proceedings.



11 | WHAT YOU SAY CAN AND WILL BE USED AGAINST YOU

In a pair of examination decisions, the Board determined that the functioanlity doctrine precluded Audemars Piguet Holding SA from registering watch designs. In *In Re Audemars Piguet Holding S.A.*, Serial Nos. 90045780 & 90045814 (TTAB Jan. 2, 2025), Applicant sought to register "three dimensional configuration design(s) of a watch". The description of the marks included twelve elements including the shape of the watch face, bezel, screw heads, watch case, attachment studs, bracelet, watch back, and winding crown. The examining attorney refused registration contending that all of the described elements were functional (except for the shape of the screw heads and watch back pattern). The examining attorney also alleged that Applicant sought registration of product designs which lacked acquired distinctiveness.

The Board affirmed the functionality refusal as to the watch face. The Board cited numerous record evidence which discussed that a circular watch face is functional. While the Board suggested that there was insufficient evidence that the other elements were functional, because the watch face was functional, and because Applicant could not amend the drawings, that the entire design had to be refused.

Further, regarding Applicant's claim of acquired distinctiveness, the Board affirmed the principle that each of the described product feature needed to be perceived as a source-indicator. Applicant argued that acquired distinctiveness should be assessed as part of the design as a whole and that Applicant's designs were "unitary" and could not be 'separated into registrable and non-registrable parts." The Board, however, noted that Applicant did separate out the various elements as part of design patent filings. These patent filings undercut Applicant's contention that the applied-for design was unitary. The Board affirmed the refusals as to lack of acquired distinctiveness.

> ***What to take away:*** In seeking trademark protection for product designs, carefully consider the description of the mark in the context of functionality, evidence that can support acquired distinctiveness in those elements, and, be consistent with any design patent filings.

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