

Highlights for the 2026-2 Edition

§§ 5:15, 7:7, 7:9 Doctrine of foreign equivalents expanded: Now applies across descriptiveness, genericness, geographic, and surname analysis; the burden rests on the party opposing translation, and bilingual purchasers are not exempt. *In re Vetements Group AG*.

§§ 2:27, 15:1 First Section 16B reexamination decision: Cancellation affirmed where the registrant could not prove source-indicating use as of the SOU deadline; the original examiner's acceptance is not preclusive. *In re Everwise Credit Union*.

§ 2:6 Genericness of incontestable marks: A registration's presumption of validity collapses when the evidence shows the mark's primary significance to the public is generic. *Illinois Tamale Co. v. LC Trademarks*.

§ 6:5 First *DuPont* factor can be dispositive: Mark dissimilarity alone defeated confusion despite related goods and overlapping channels. *Fuente Marketing v. Vaporous Technologies*.

§ 6:9 Fame does not bridge unrelated goods or substitute for similarity: BARBIE famous for dolls, but no relatedness to a social-networking app and the logo differed. *Mattel v. BarBee*.

§ 6:10 *DuPont* factor-scope consistency and crowded-field evidence: Factor-six third-party use must be measured at the same scope as factor-two relatedness, and crowded-field arguments need marketplace evidence, not just registrations. *Apex Bank v. CC Serve; In re Mario's*.

§ 6:13 Bare consent agreements get only slight weight: A consent reciting conclusions without trade-channel or field-of-use restrictions did not overcome a 2(d) refusal on near-identical marks and goods. *In re Ye Mystic Krewe of Gasparilla*.

§ 7:10 Color marks: softened language, new genericness ground: Absolute "never" language replaced with "generally"; genericness is now an independent two-step refusal ground. TMEP §§ 1202.05, 1202.05(b).

§ 7:10 Descriptive AI/SaaS marks and § 2(f): Marks built from "AI," "GPT," "chat," and similar face a heavy acquired-distinctiveness burden. *In re OpenAI OpCo (CHATGPT)*.

§ 8:2 Failure-to-function refusals need a rational standard: Conclusory "commonality" findings rejected; the Board must articulate a coherent standard. *In re Brunetti*.

§ 26:7 Mid-litigation assignment of common law rights: Section 1060(a)(1)'s anti-trafficking bar reaches only bare ITU applica-

tions, not pre-existing common law rights. *Game Plan v. Uninterrupted IP*.