

This Opinion is Not a
Precedent of the TTAB

Mailed: July 11, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Don Emler
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Serial No. 90688260
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Thomas J. Romano of Kolitch Romano Dascenzo Gates LLC for Don Emler.

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Before Shaw, Dunn and Thurmon, Administrative Trademark Judges.

Opinion by Thurmon, Administrative Trademark Judge:

On May 13, 2024, the Board issued a final decision in this appeal, affirming the refusal to register Applicant's product design for lack of acquired distinctiveness. On June 13, 2024, Applicant requested reconsideration, arguing that the Board also should have ruled on the functionality refusal made by the Examining Attorney. In the final decision, we noted that the Examining Attorney had refused registration on two grounds, but we elected to affirm the lack of acquired distinctiveness refusal, a decision that fully resolved the appeal before us.

Applicant does not dispute any of this and does not ask us to reconsider our decision on acquired distinctiveness. Instead, Applicant now asks us to rule on the functionality refusal, too. We decline to do so because our prior decision resolved the appeal. Applicant explains that it has filed a new application, seeking registration on the Supplemental Register. Such an application cannot be refused registration for lack of acquired distinctiveness, Applicant explains, but can be refused registration under Section 2(e)(5) if the design is functional. Request for Reconsideration at 3. Applicant's arguments are not persuasive.

While Applicant makes an accurate statement of the law concerning registration on the Supplemental Register, it is asking the Board to issue an advisory opinion. We have already decided the appeal of this application. Addressing the functionality refusal at this point would not alter anything concerning the status of this application. Indeed, Applicant implicitly concedes as much by arguing that having a Board decision on functionality of its muffler design would aid in the prosecution of the new application.

That may be true, but an advisory opinion on genericness might also aid in the prosecution because an application seeking registration on the Supplemental Register may be refused if the proposed mark is generic. Indeed, there are many other issues that might arise in the prosecution of Applicant's new application. If Applicant's new application is refused registration on the Supplemental Register, and if Applicant appeals such a refusal, that will be the time for the Board to address such refusal. We will not issue an advisory opinion on a matter that the Applicant believes

might arise in connection with its new application. *See Hall v. Beals*, 396 U.S. 45, 48 (1969) (“The case has therefore lost its character as a present, live controversy of the kind that must exist if we are to avoid advisory opinions on abstract propositions of law.”); *Cat Tech LLC v. TubeMaster, Inc.*, 528 F.3d 871, 878 (Fed. Cir. 2008) (“A party may not obtain a declaratory judgment merely because it would like an advisory opinion on whether it would be liable for patent infringement if it were to initiate some merely contemplated activity.”); *Sage Therapeutics, Inc. v. Sageforth Psych. Servs., LLC*, 2024 TTAB LEXIS 139, *42 (“But such analyses [of Section 18 counterclaims to restrict registrations that were not relied upon in the Board’s decision on the primary claim] would be effectively an advisory opinion on likelihood of confusion, because no substantive consequence would flow from our conclusions.”).

The Board acted within its discretion in affirming one of the two refusals to register. Applicant argues that the Board has treated functionality as a “threshold” issue in precedential decisions. Perhaps a Board panel used that wording, but when an appeal is issued involving two or more grounds for refusal, the Board need only decide the issue(s) necessary for full resolution of the appeal. *See In re La. Fish Fry Prods.*, 797 F.3d 1332, 1336 (Fed. Cir. 2015) (“We do not need to reach the Board’s genericness determination because we hold that substantial evidence supports the Board’s determination that Louisiana Fish Fry failed to show that FISH FRY PRODUCTS has acquired distinctiveness.”); *In re DTI P’ship LLP*, 2004 TTAB LEXIS 158, *10 (“In view of our decision with respect to the Trademark Rule 2.61(b) requirement, we deem the substantive Section 2(e)(1) mere descriptiveness refusal to

be moot. Applicant’s failure to comply with the Trademark Rule 2.61(b) requirement is a sufficient basis, in itself, for affirming the refusal to register applicant’s mark.”); *see also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE § 1218 (June 2024) (“However, in certain circumstances after the Board has affirmed one requirement or refusal it will not reach any further requirement or refusal.”).

The Board’s discretion works both ways. That is, the Board may address multiple refusals when a panel feels such treatment is appropriate, but the Board also has the discretion to decide only the refusal(s) needed to resolve the appeal. In this appeal, the Board exercised its discretion and resolved the acquired distinctiveness refusal, without reaching the functionality refusal. We appreciate Applicant’s concern that its new application might be refused on functionality grounds, but we (the Board) will not issue decisions based on refusals that might arise in a newly-filed application.

The Request for Reconsideration is denied.