

THIS DISPOSITION IS  
NOT CITABLE AS PRECEDENT  
OF THE TTAB

Mailed: June 27, 2002

Paper No. 29  
BAC

**UNITED STATES PATENT AND TRADEMARK OFFICE**

-----  
**Trademark Trial and Appeal Board**  
-----

United German-American Societies of Greater Chicago  
v.  
German American Committee of Greater New York Inc.

-----  
Opposition No. 112,342  
to application Serial No. 75/196,492  
filed on November 1, 1996  
-----

Barry W. Sufrin and Brian J. Lum of Michael Best &  
Friedrich LLC for United German-American Societies of  
Greater Chicago.

William E. O'Brien, Esq. for German American Committee of  
Greater New York Inc.

-----  
Before Seeherman, Hairston and Chapman, Administrative  
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

German American Committee of Greater New York Inc.  
(a New York corporation) filed on November 1, 1996, an  
application to register on the Principal Register the  
mark shown below



for goods and services ultimately identified as "books, journals, and pamphlets, all relating to the activities of a not-for-profit organization which promotes the German-American heritage" in International Class 16, and "organizing community festivals featuring a variety of activities namely, parades, beauty pageants, ethnic dances and the like" in International Class 41.<sup>1</sup> In an amendment to the application, applicant claimed acquired distinctiveness under Section 2(f) of the Trademark Act.

United German-American Societies of Greater Chicago (an Illinois corporation) has opposed registration, alleging that for many years opposer has engaged in the promotion of German-American cultural awareness through (i) the organization of community festivals featuring activities such as parades, (ii) the publication of books, journals and pamphlets, and (iii) the distribution of souvenirs and memorabilia, all of which opposer has a valid and legal right to describe by use of the words "German-American Steuben Parade"; that since 1966 opposer

---

<sup>1</sup> The application is based on a claimed date of first use and first use in commerce of March 20, 1991. The procedural history of the application will be set forth later in this decision.

**Opposition No. 112342**

has continuously used "the term 'German-American Steuben Parade,' or

**Opposition No. 112342**

substantially similar terms" for the above-named goods and services (paragraph 2); that since 1966 and most recently in September 1996 representatives of applicant have corresponded with and visited opposer and, thus, applicant was aware of opposer's "use of the term 'German-American Steuben Parade,' or substantially similar terms" (paragraph 3); that since September 1996 applicant has also been aware of the longstanding use of the terms "Steuben Parade" and "German-American Steuben Parade and Celebration" by the Steuben Day Observance Association of Philadelphia and Vicinity, Inc.; that notwithstanding applicant's prior knowledge of the use of the terms by opposer and the Philadelphia association, applicant erroneously stated in its application that no other entity has the right to use the mark either in the identical form or in near resemblance thereto; and that notwithstanding applicant's prior knowledge of the use of the terms by opposer and the Philadelphia association, applicant stated in its declaration under Section 2(f) that the mark had become distinctive as applied to "applicant's goods 'by reason of substantially exclusive and continuous use as a mark by Applicant' in commerce which may be lawfully regulated by Congress for the 5

**Opposition No. 112342**

years next preceding the date of filing of this Declaration" (paragraph 6).

Opposer specifically alleges that the mark is not registrable because it violates Section 2(e)(1) in that it consists of words which, when applied to applicant's goods and services, are merely descriptive thereof; that applicant has not satisfied the requirements of establishing a claim of distinctiveness under Section 2(f); that the term "German-American" is a generic term which, as applied to applicant's goods and services, describes the individuals who are the subjects of and participants in the community festivals organized by applicant; and that the term "Steuben Parade" is a generic term which, as applied to applicant's goods and services, describes the type of community festivals organized by applicant, celebrating both the birth of General von Steuben and the participants' German-American heritage.

Applicant, in its answer, denied the salient allegations of the notice of opposition, and raised the affirmative defenses of laches, acquiescence and estoppel.<sup>2</sup>

---

<sup>2</sup> Inasmuch as applicant offered no evidence on any affirmative defense and did not raise any affirmative defense in its brief

The record consists of the pleadings; the file of the opposed application; and the testimony depositions, with exhibits, of Erich M. Himmel, opposer's president, and Alfred W. Taubenberger, president and general chairman of the Steuben Day Observance Association of Philadelphia and Vicinity. Applicant offered no testimony or other evidence.

Both parties filed briefs on the case. An oral hearing was not requested.

**The Issues Before the Board**

As noted above, the issues pleaded in the notice of opposition are that applicant's mark is generic; and if not generic, then merely descriptive, and lacking acquired distinctiveness; and fraud. These issues were also tried. Applicant, thus, was on notice it was required to prove acquired distinctiveness. Although opposer, in its main brief, characterizes the issues as being genericness and fraud, it is clear that acquired distinctiveness is also at issue in this proceeding as was reiterated by opposer in its reply brief.<sup>3</sup>

---

on the case, we consider the affirmative defenses to have been waived by applicant.

<sup>3</sup> Opposer stated the following in its reply brief (p. 4):

[Applicant's] arguments are  
insufficient to carry its burden of

In summary, the Board considers the issues before us in this case to be genericness, descriptiveness, the sufficiency of applicant's proof of acquired distinctiveness, and fraud in connection with applicant's Section 2(f) declaration.

**The Burden of Proof**

Opposer stated the following in the "Introduction" section of its brief (p. 4):

Applicant has not entered any evidence into the record to carry its burden of proving that the proposed mark is not generic, nor to establish that its declaration under Section 2(f) was not knowingly false.

Applicant contends that the burden of proof on these issues lies with opposer. (Brief, p. 4.)

In support of its position, opposer cited the cases of *Filipino Yellow Pages Inc. v. Asian Journal Publications Inc.*, 198 F.3d 1143, 53 USPQ2d 1001 (9th Cir. 1999) (arguing that "in litigation, [the] proponent of the proposed mark has the burden of showing that an unregistered mark is not generic"); and *Mil-Mar Shoe Co. v. Shonac Corp.*, 75 F.3d 1153, 37 USPQ2d 1633 (7th Cir.

---

showing that the alleged mark is not generic and has acquired distinctiveness, and to rebut [opposer's] evidence that [applicant's] declaration under Section 2(f) was knowingly false.

**Opposition No. 112342**

1996), (quoting the Court that "'when the mark claimed as a trademark is not federally registered ... the burden is on the claimant to establish that it is not an unprotectable generic mark.'" ) (Brief, p. 12.) However, both of the cited cases involve situations in which the plaintiff was asserting rights in a mark, and because the mark was not federally registered, the plaintiff had the burden of showing that the term was indeed functioning as a mark. Thus, these cases are simply not applicable to the present situation.

In Board proceedings, our primary reviewing Court has held that the plaintiff must establish its pleaded case (e.g., likelihood of confusion, descriptiveness, genericness, abandonment), and must generally do so by a preponderance of the evidence. See *Martahus v. Video Duplication Services Inc.*, 3 F.3d 417, 27 USPQ2d 1846, 1850 (Fed. Cir. 1993); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1554 (Fed. Cir. 1991); and *Cerveceria Centroamericana, S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989).

The ground of fraud must also be established by the plaintiff, but it must be in accordance with the higher standard of clear and convincing proof. See A.C.

**Opposition No. 112342**

Aukerman Co. v. R.L. Chaides Construction Co., 960 F.2d 1020, 22 USPQ2d 1321, 1338 (Fed. Cir. 1992). See also, Woodstock's Enterprises Inc. (California) v. Woodstock's Enterprises Inc. (Oregon), 43 USPQ2d 1440, 1443-1444 (TTAB 1997), aff'd unpub'd, Appeal No. 97-1580, Fed. Cir., March 5, 1998.

Thus, it is opposer (plaintiff) who bears the burden of proving by a preponderance of the evidence its claim that applicant's applied-for mark is generic or merely descriptive<sup>4</sup>; and opposer bears the burden of proving by clear and convincing evidence its claim that applicant committed fraud on the USPTO.

However, it is applicant who bears the burden of establishing that its mark has become distinctive. See Yamaha International Corp. v. Hoshino Gakki Co. Ltd., 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988). The issue of acquired distinctiveness is a question of fact. See In re Loew's Theatres, Inc., 769 F.2d 764, 226 USPQ 865, 869 (Fed. Cir. 1985). There is no specific rule as to the exact amount or type of evidence necessary at a minimum to prove acquired distinctiveness, but generally,

---

<sup>4</sup> In this opposition, opposer need not prove that the words "German-American Steuben Parade" are merely descriptive of the involved goods and services because applicant has conceded this, first, by amending its application to seek registration under Section 2(f), and second, in its brief on the case (pp. 10-11.)

the more descriptive the term or phrase, the greater the evidentiary burden to establish acquired distinctiveness. That is, the less distinctive the term or phrase, the greater the quantity and quality of evidence that is needed to prove acquired distinctiveness. See *In re Bongrain International (American) Corp.*, 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990); and *Yamaha*, 6 USPQ2d at 1008. See also, 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §15:28 (4th ed. 2001).

**The Evidence**

Applicant's Application

Applicant filed its use-based application for the mark



on November 1, 1996, for the following goods and services:

"[goods] Books, journals, pamphlets;  
[services] Organizing parades, parties and pageants."

In the first Office action, the Examining Attorney refused registration of the mark as merely descriptive under Section 2(e)(1), and also held the mark incapable of functioning as a mark and refused registration on the

**Opposition No. 112342**

Supplemental Register. The Examining Attorney attached copies of eight stories retrieved from the Nexis database to show "Steuben Parade" describes the type of festival applicant organizes. Some of these stories referred to a New York festival (presumably applicant's) and some referred to a Chicago festival (presumably opposer's).

In response, applicant contended that a claim of acquired distinctiveness could be made under Section 2(f) of the Trademark Act.

In the second Office action, the same Examining Attorney stated that the previous refusal under Section 2(e)(1) was in error, and required applicant to either disclaim the words "German-American Steuben Parade," or claim acquired distinctiveness **as to the word portion of the mark** (emphasis in the original) through affidavit or declaration of the applicant. Noting that applicant had indicated a desire to proceed under Section 2(f), the Examining Attorney explained that a properly worded Section 2(f) declaration was required and the Examining Attorney provided the following sample declaration:

The wording 'German-American Steuben Parade' has become distinctive of the applicant's goods and services through applicant's substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement.

It was in response to this Office action that applicant stated that the words have acquired distinctiveness and supported this claim by a declaration under Section 2(f). The Section 2(f) declaration was dated January 12, 1998 and signed by Theobald J. Dengler.

The Examining Attorney then approved the application for publication in the Official Gazette, and it was published in the October 27, 1998 issue.

Testimony of Erich M. Himmel

Erich M. Himmel, opposer's president, has been associated with opposer for over 20 years--as vice president for 10 years and then president for the past 11 years. Opposer was founded over 80 years ago, with a goal of maintaining German culture. The witness testified that he is aware of German-American organizations in Milwaukee, New York, and Philadelphia. Opposer currently oversees about 65 German clubs, assisting the member clubs in conducting different functions; and opposer hosts "German-American Day" which includes the "Steuben Parade."<sup>5</sup> The parade is held in September because that is von Steuben's birth month.

---

<sup>5</sup> This parade is in honor of General Friedrich Wilhelm von Steuben, a Prussian Army officer recruited to come to the United

**Opposition No. 112342**

Opposer has presented an annual "Steuben Parade" in Chicago for the last 36 years, using various names including, "Steuben Parade," "von Steuben Parade," "Wilhelm von Steuben Parade" and "German-American Steuben Parade." (Dep., p. 31.)

In organizing the "Steuben Parade," opposer obtains the appropriate city of Chicago permits, lines up groups to be in the parade, produces and distributes flyers, invites various politicians, and the like. Opposer also produces programs for the event; and it advertises its "German Day" and "Steuben Parade" activities not only in Chicago area newspapers, but also in German language newspapers (e.g., the "Eintracht") distributed outside of the Chicago area. In addition, opposer has a website on the Internet.

Mr. Himmel has known of the term "German-American Steuben Parade" since "as long as I can think back" (dep., p. 13); and he explained that when there are only Germans present at a discussion or event, the parade is referred to as the "Steuben Parade," but otherwise it is referred to as the "German-American Steuben Parade." The opposer's parade

---

States by Benjamin Franklin and who then worked closely with General George Washington in training the Continental Army.

**Opposition No. 112342**

brochure for 1996 (exhibit 2) is titled "CHICAGO 76th German Day and 31st von Steuben Day PARADE", whereas opposer's website page printed out in September 2001 (exhibit 4) shows opposer's parade banner "Societies of Greater Chicago United German - American STEUBEN PARADE." According to Mr. Himmel, this banner has been used for over 20 years in the parade.

Opposer participated in applicant's parade in 1997 (e.g., marched in the parade carrying opposer's banner), and applicant participated in opposer's parade in 1996 or 1997. Opposer has also participated in the Philadelphia association's parade at least once in 1998.

On January 28, 1997, opposer sent a letter (signed by Mr. Himmel as opposer's president) to applicant complaining of applicant's pending application; explaining that any attempt by applicant to claim exclusive proprietary rights in "German American Steuben Parade" would be resisted by opposer; and requesting that applicant withdraw the application. (Exhibit 6.) Applicant has never requested that opposer take a license to use the term "German-American Steuben Parade."

Only Philadelphia, Chicago (opposer) and New York (applicant) present these "German-American Steuben

**Opposition No. 112342**

Parades"; and Mr. Himmel testified as to his personal knowledge of applicant's awareness of the three major cities' "Steuben Parades."

On cross-examination Mr. Himmel testified that although opposer at one time used a cornflower design in the advertising of its parade, and the queen of the parade sold cornflowers, opposer stopped doing so about five years ago. The witness was asked if he had any knowledge of any fraud committed by applicant in filing its application with the USPTO, and he responded "No." (Dep., p. 36.)

Testimony of Alfred W. Taubenberger

The other testimony taken herein is that of Alfred W. Taubenberger, president and general chairman of the Steuben Day Observance Association of Philadelphia and Vicinity (Philadelphia association). The Philadelphia association was founded in 1970, and Mr. Taubenberger has been associated therewith since 1980, holding first the office of corresponding secretary and later vice chairman.

The Philadelphia association coordinates, develops and promotes the "German-American Steuben Parade" in Philadelphia. It has been organizing this parade for over 31 years. Prior to January 1992, the Philadelphia

**Opposition No. 112342**

association parade was called the "Steuben Parade" or, occasionally, the "German-American Steuben Parade." The lead banner for this parade carries the wording "Philadelphia German-American Steuben Parade, Ethnic Heritage and Pride."

The Philadelphia association's parade has officially been called the "German-American Steuben Parade" since January 27, 1992, when the association passed a motion to that effect in order to identify it as a German-American ethnic event. All signs, stationery, press releases, programs, t-shirts and the like now carry the wording "German-American Steuben Parade." This phrase is intended to relate to German immigrants and their descendants who are celebrating the immigrant General von Steuben's accomplishments and his support of General Washington in the Revolutionary War. Mr. Taubenberger testified that he believed about 95% of the people who participate in the German events around Philadelphia are aware of General von Steuben.

In organizing the parade, the Philadelphia association prints and distributes programs, fliers, posters, mailings to its members, and invitations to other German associations, and specifically invites officers/representatives from both the New York (8-10

**Opposition No. 112342**

people) and the Chicago associations (2-3 people) to participate therein. The parade is advertised in local newspapers, in German-American papers throughout the United States, and in magazines. The Philadelphia association sells cornflowers, and gives away t-shirts to people who have been helpful to the parade committee.

The Philadelphia association also runs a German-American Day in June, and a German-American Penn's Landing Summer Fest. Mr. Taubenberger is aware of opposer and applicant, as well as German-American associations in Baltimore, Maryland and Lancaster, Pennsylvania.

Mr. Bill Hetzler, chairman of the German-American Steuben Parade Committee of New York (which is governed by applicant), is well known to Mr. Taubenberger as they speak several times a year, and have done so since their first meeting in the mid-1990s. Mr. Hetzler and Mr. Taubenberger are invited to each other's parades; and they speak at each other's banquets connected with their respective "German-American Steuben Parades." Mr. Taubenberger has sought the advice of Mr. Hetzler regarding the Philadelphia association parade--e.g., selecting a grand marshal, obtaining cornflowers. However, Mr. Taubenberger was clear that in all of their

**Opposition No. 112342**

discussions, Mr. Hetzler has never mentioned or suggested a license or other agreement between the New York and Philadelphia associations relating to giving Philadelphia permission to use the words "German-American Steuben Parade." In fact, he reiterated that there has never been a license or other agreement with any other party regarding the Philadelphia association's use of "German-American Steuben Parade" to his knowledge; and that no such matter is reflected in any minutes or any other records of the association. (Dep., pp. 41, 43.) The Philadelphia association has never paid royalties to the New York committee, and there are no restrictions on Philadelphia's use of the words "German-American Steuben Parade." The New York committee has never raised any objection to the Philadelphia association's use of the words "German-American Steuben Parade."

The witness recalled his association's January 27, 1992 meeting at which the then-chairman, Mr. Karnas, as part of his motion that the association change its letterhead to read "German-American Steuben Parade," remarked that "the New York Steuben Parade had been using ['German-American Steuben Parade'] for some time and it made sense." (Dep., p. 36.) Mr. Taubenberger's recollection of the discussion about this motion was that

**Opposition No. 112342**

"German-American Steuben Parade" unites a large group of people who are of German descent and background, and the New York committee "does use it [and] they are a successful parade." (Dep., p. 78.)

To Mr. Taubenberger's knowledge, the only cities putting on this type and scale of "Steuben Parade" are New York, Philadelphia and Chicago.

Due to their close proximity, the Philadelphia association has more rapport with the New York committee than with the Chicago association. In the past, the Philadelphia association has participated in at least one of the Chicago association's parades. Moreover, Mr. Taubenberger is aware that the New York committee has been holding a parade for 44 years. Philadelphia association representatives have attended the New York committee's parade since at least 1992; and it is Mr. Taubenberger's belief that the Philadelphia association has participated in the New York parade for all of the Philadelphia association's 31 years of existence. Further, New York committee representatives have attended the Philadelphia association's parade since at least 1996. In addition, each of the two organizations (Philadelphia and New York) has run advertisements for its own parade in the other's parade program, with the

**Opposition No. 112342**

advertisements clearly labeled "German-American Steuben Parade." (Exhibit 4, page three; exhibit 2, page three; and exhibit 3, page three.) The New York committee's 1997 parade program clearly lists "Philadelphia German-American Steuben Parade Committee" as a participant. (Exhibit 5, page four.)

Mr. Taubenberger testified that the cornflower is an historic symbol for German-Americans throughout the United States, and particularly for German immigrants because they remember cornflowers growing in wheat fields throughout Germany. In applicant's 1997 parade program, the Philadelphia association provided a float of the Philadelphia Cornflower Queen and her court.

On cross-examination, Mr. Taubenberger explained that the only entity other than the New York and Chicago organizations using the cornflower is The Steuben Society of the United States (formed in 1919). The Philadelphia association does not use the cornflower in its advertising.

**Genericness**

The critical issue in determining genericness is whether members of the relevant public primarily use or understand the designation sought to be registered to refer to the genus or category of goods or services in

question. See *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). In making our determination, we follow the two-step inquiry set forth in *Marvin Ginn* and reaffirmed in *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999), namely:

- (1) What is the genus or category of goods at issue?, and
- (2) Is the designation sought to be registered understood by the relevant public primarily to refer to that genus or category of goods?

"The correct legal test for genericness, as set forth in *Marvin Ginn*, requires evidence of 'the genus of goods or services at issue' and the understanding by the general public that the mark refers primarily to 'that genus of goods or services.'" *American Fertility Society*, 51 USPQ2d at 1836. That is, do the members of the relevant public understand or use the term sought to be protected to refer to the genus of the goods and/or services in question?

The genus or category of goods and services involved in this case are books, journals, and pamphlets, all relating to activities which promote the German-American heritage, and organizing community festivals featuring parades, beauty pageants, ethnic dances and the like.

**Opposition No. 112342**

In considering the understanding of the relevant public, we must first determine who comprises the public for the identified goods and services. There are two groups of relevant public, German-Americans and the public at large. The evidence in this case shows that many, if not most, of the persons encountering applicant's applied-for mark are German-Americans. Although applicant (New York), opposer (Chicago) and a third party (Philadelphia) each distribute fliers and posters throughout their respective cities, and advertise in newspapers and magazines, all of which, except for the German language publications, may potentially be seen by or be available to the general public, nonetheless we find the primary relevant public consists of German-Americans. See *Stocker v. General Conference Corp. of Seventh-day Adventists*, 39 USPQ2d 1385, at 1394 (TTAB 1996).

As we previously stated, it is opposer's burden to establish that the applied-for mark is generic. Opposer argues that applicant's proposed mark is a juxtaposition of the generic terms "German-American" and "Steuben Parade" which, when coupled together, remain generic for the involved goods and services; and that the cornflower design has long been a generic emblem or symbol of

**Opposition No. 112342**

various German-American events including "Steuben Parades," much like the shamrock is a generic symbol of Irish-Americans and St. Patrick's Day.

In its brief, applicant acknowledges that the term "parade" is generic for parades; but otherwise contends that the term "Steuben" is a surname, and that the term "'German-American' is merely descriptive of a community comprised of Germans and Americans." Applicant concludes that the combination of the terms "German-American, Steuben, and Parade" does not depict a genus or class of goods or services, but "[r]ather, the resulting combination of terms merely describes the nature of applicant's services to the general public." (Brief, p. 11.)

Applicant contends that on this record opposer has not met its burden of establishing that the phrase "German-American Steuben Parade" is generic for either applicant's identified services or its identified goods which are related thereto.

There is no evidence that the phrase "German-American Steuben Parade" is the term by which the identified goods ("books, journals and pamphlets, all relating to the activities of a not-for-profit organization which promotes the German-American

**Opposition No. 112342**

heritage") and services ("organizing community festivals featuring a variety of activities namely parades, beauty pageants, ethnic dances and the like") are known. The evidence of record falls far short of establishing that the phrase "German-American Steuben Parade" is understood by the relevant public as referring to the genus of goods and services represented by applicant's identifications. That is, opposer has failed to provide any evidence that the phrase as a whole, "German-American Steuben Parade," is generic, or that the cornflower design is.<sup>6</sup> Even if some of the constituent elements are generic, this combination of terms and design have not been shown to be generic for the identified goods and services. See American Fertility Society, supra.

Accordingly, opposer has failed to prove that the applied-for mark is generic.

---

<sup>6</sup> The case cited by opposer relating to a grape-leaf design appearing on wine labels being held generic, Kendall-Jackson Winery Ltd. v. E. & J. Gallo Winery, 150 F.3d 1042, 47 USPQ2d 1332 (9th Cir. 1998), involved trademark infringement, trade dress, dilution and unfair competition claims. The appellate court upheld the judgment for the defendant, stating that the use of a grape leaf as a mark for wine would normally be inherently distinctive because it suggests rather than describes the product. However, the court explained that the difference in the specific case then before it was that because wine bottlers other than the plaintiff have long used grape leaves to decorate their labels, the emblem of the grape leaf has become generic for wine. In the present case, however, there is not sufficient evidence that the cornflower design is in such common usage.

**Descriptiveness / The Sufficiency of Applicant's Section 2(f) Evidence**

By amending its application to claim that the mark has acquired distinctiveness, applicant conceded that the words "German-American Steuben Parade" are merely descriptive of the involved goods and services. Further, as noted previously, applicant acknowledged in its brief that the term "parade" is the generic name for a parade; and the combination of the words "German-American Steuben Parade" is merely descriptive.

We find the words "German-American Steuben Parade" are merely descriptive of both applicant's services (organizing festivals) and the goods related thereto (publications relating to the activities of an organization promoting the German heritage). Further, we find that these words are highly descriptive of applicant's service of organizing festivals featuring, inter alia, parades, as well as the publications related thereto. Applicant's identification of goods specifically references that the publications promote the German-American heritage; and the term "parade" is admittedly generic for the involved services. In addition, there is evidence that others use various combinations of these terms for their respective parades.

**Opposition No. 112342**

With this in mind, we turn to the question of the sufficiency of applicant's evidence of acquired distinctiveness.

In order to establish acquired distinctiveness, "an applicant must show that 'in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself.'" In re Dial-A-Mattress Operating Corporation, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001), quoting from the case of Inwood Labs, Inc. v. Ives Labs., 456 U.S. 844, at footnote 11 (1982).

As noted previously, the question of acquired distinctiveness is one of fact which must be determined on the evidence of record. The Board stated in the case of Hunter Publishing Co. v. Caulfield Publishing Ltd., 1 USPQ2d 1996, 1999 (TTAB 1986):

[e]valuation of the evidence requires a subjective judgment as to its sufficiency based on the nature of the mark and the conditions surrounding its use. While some terms may never acquire distinctiveness no matter how long they have been used, others may acquire such significance in a relatively short period of time, sometimes even less than five years. See In re Capital Formation Counselors, Inc., 219 USPQ 916 (TTAB 1983).

**Opposition No. 112342**

See also, *Braun Inc. v. Dynamics Corp. of America*, 975 F.2d 815, 24 USPQ2d 1121 (Fed. Cir. 1992); and *Omicron Inc. v. Open Systems, Inc.*, 19 USPQ2d 1876 (TTAB 1989, released 1991).

In this case, applicant's evidence of acquired distinctiveness consists solely of the declaration submitted during the prosecution of its application of substantially exclusive use for five years.<sup>7</sup> Applicant offered nothing further in this inter partes case. There is no evidence of consumer recognition of the phrase "German-American Steuben Parade" as applicant's trademark for its identified goods and services. Nor is there any evidence of the amount applicant spends on advertisements; or the general attendance at its annual parade. Conversely, opposer has submitted evidence of third-party uses of the same or substantially similar phrases by associations in two other major cities (Philadelphia and Chicago), with such uses being prior to applicant's filing date and continuing through to the present. While the Examining Attorney was presumably aware of the Chicago association's parade, the evidence

---

<sup>7</sup> It is noted that applicant's declaration asserts that the mark "...has become distinctive as applied to applicant's goods..." and does not mention applicant's services.

**Opposition No. 112342**

of use by the other third-party was not before the Examining Attorney.

Thus, on the record before us, it is clear that the public is exposed to at least three different entities using the words "German-American Steuben Parade" for publications, parades, pageants and the like. Conversely, there is no evidence that the public recognizes the phrase as applicant's mark. Hence, applicant's claim of acquired distinctiveness cannot be successful because the distinctiveness on which purchasers rely is lacking. See *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939 (Fed. Cir. 1984).

Given the highly descriptive nature of "German-American Steuben Parade" for the identified goods and services, we would need to see a great deal more evidence than applicant has submitted in this case in order to find that the term has become distinctive as the indicator of a single source for such goods and services. See *In re Recorded Books Inc.*, 42 USPQ2d 1275 (TTAB 1997); *In re Leatherman Tool Group Inc.*, 32 USPQ2d 1443 (TTAB 1994); *In re Medical Disposables Co.*, 25 USPQ2d 1801 (TTAB 1992); and *Flowers Industries Inc. v. Interstate Brands Corp.*, 5 USPQ2d 1580 (TTAB 1987).

The words "German-American Steuben Parade" are merely descriptive and applicant has not submitted sufficient proof to establish acquired distinctiveness under Section 2(f).

**Fraud**

Opposer's ground of fraud refers to applicant's submission of its Section 2(f) declaration during the prosecution of its application. That declaration reads as follows:

The Applicant, owner of the above captioned application, believes that the mark has become distinctive as applied to applicant's goods as set forth in the above application (as amended) by reason of substantially exclusive and continuous use as a mark by Applicant in commerce which may be lawfully regulated by Congress for the 5 years next preceding the date of filing of this Declaration.<sup>8</sup>

Opposer essentially contends that applicant could not reasonably assert that its use of the words "German-American Steuben Parade" was substantially exclusive

---

<sup>8</sup> In the notice of opposition opposer also pled that applicant committed fraud in signing the declaration in the original application relating to the statement that "...no other person, firm, corporation..." However, opposer did not pursue this issue in its brief, presumably because during the testimony deposition of opposer's president, Erich Himmel, Mr. Himmel specifically answered "no" to the question of any knowledge he had as to whether applicant committed fraud in filing its application. In any event, such fraud was not proven by clear and convincing evidence. See 5 J. Thomas McCarthy, McCarthy on

**Opposition No. 112342**

based on the known uses of those words by at least two other entities. Opposer maintains that the mark in the involved application should not be registered because it was allowed by the Examining Attorney as a result of applicant's knowing and willful false statement to the USPTO that applicant had made five years substantially exclusive use, and it was this false claim that persuaded the Examining Attorney that the words "German-American Steuben Parade" had acquired distinctiveness as a trademark/service mark of applicant's.

Applicant strenuously argues that its declaration refers to "substantially exclusive use as a mark..." and thus, there was no fraud or intent to defraud the USPTO; and that opposer has not met the burden of establishing fraud by clear and convincing evidence.

Fraud in procuring a trademark registration occurs when an applicant knowingly makes false, material representations of fact in connection with the application. See *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483, 1484 (Fed. Cir. 1986). In making our analysis of applicant's actions, we are governed by the following principles of what constitutes fraud:

---

Trademarks and Unfair Competition, §31:71 (4th ed. 2001), and

Fraud implies some intentional deceitful practice or act designed to obtain something to which the person practicing such deceit would not otherwise be entitled. Specifically, it involves a willful withholding from the Patent and Trademark Office by an applicant or registrant of material information or facts which, if disclosed to the Office, would have resulted in the disallowance of the registration sought or to be maintained. Intent to deceive must be "willful." If it can be shown that the statement was a "false misrepresentation" occasioned by an "honest" misunderstanding, inadvertence, negligent omission or the like rather than one made with a willful intent to deceive, fraud will not be found. Fraud, moreover, will not lie if it can be proven that the statement, though false, was made with a reasonable and honest belief that it was true or that the false statement is not material to the issuance or maintenance of the registration. It thus appears that the very nature of the charge of fraud requires that it be proven "to the hilt" with clear and convincing evidence. There is no room for speculation, inference or surmise and obviously, any doubt must be resolved against the charging party.

Smith International, Inc. v. Olin Corp, 209 USPQ 1033, 1043-44 (TTAB 1981), citations omitted. See also, First International Services Corp. v. Chuckles, Inc., 5 USPQ2d 1628 (TTAB 1986); and Girard Polly-Pig, Inc. v. Polly-Pig by Knapp, Inc., 217 USPQ 1338 (TTAB 1983).

Fraudulent intent is an essential element of any fraud claim. See Electronic Realty Associates, Inc. v. Extra Risk Associates, Inc., 217 USPQ 810 (TTAB 1982). See also, 5 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §31:69 (4th ed. 2001) ("Fraud in

---

cases cited therein.

**Opposition No. 112342**

a §2(f) five-year declaration claiming the existence of secondary meaning is possible but very difficult to prove." ).

In determining opposer's claim of fraud, we must consider the record that was before the Examining Attorney at the time applicant filed its Section 2(f) declaration. The record of applicant's application included the stories retrieved from the Nexis database which were put into the record by the Examining Attorney as part of her July 9, 1997 Office action. These stories clearly included references to "Steuben Parades" in both New York and Chicago. Thus, it cannot be said that the Examining Attorney was unaware of at least one other use of the term "Steuben Parade" by others. (In fact, the Examining Attorney submitted this material to establish that "Steuben Parade" describes the type of festival that applicant organizes.)

Further, it was the Examining Attorney who required (in the Office action dated March 2, 1998) that applicant either disclaim the wording "German-American Steuben Parade" or claim acquired distinctiveness based on five years use. The Examining Attorney even presented applicant with a suggested claim of distinctiveness based on five years use. On this record, it simply cannot be

**Opposition No. 112342**

said that applicant's declaration under Section 2(f) involved a withholding of information from the USPTO, which, if disclosed, would have resulted in disallowance.

Opposer has also failed to prove applicant's willful intent to deceive the USPTO. As stated above, the Examining Attorney invited the proof of acquired distinctiveness through a claim of five years substantially exclusive use, despite the evidence of the Chicago parade before her. Also, the record shows that opposer's use was not consistently the exact phrase "German-American Steuben Parade" but rather "CHICAGO 76th German Day and 31st von Steuben German Day PARADE"; and the Philadelphia association's parade was identified as "Philadelphia German-American Steuben Parade, Ethnic Heritage and Pride." These differing uses give credence to applicant's argument that it did not believe others were using the phrase "German-American Steuben Parade" as a mark; and therefore, applicant believed it had a reasonable basis for asserting a claim of substantially exclusive use of the words as a mark. See *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355 (TTAB 1989) (procedural discussion of fraud relating to a Section 2(f) claim); and also at 25 USPQ2d 1321 (TTAB 1992)(decision after trial). On this record, we cannot

**Opposition No. 112342**

find a willful intent on the part of applicant to deceive the USPTO by signing and submitting the declaration under Section 2(f).

Opposer has failed to establish by clear and convincing evidence its claim of fraud.

**Decision**

The opposition is sustained only on the grounds that the words "German-American Steuben Parade" are merely descriptive when used on or in connection with applicant's identified goods and services, and applicant has not established that the words have acquired distinctiveness under Section 2(f). Registration to applicant is accordingly refused.

\*\*\*\*\*

Seeherman, Administrative Trademark Judge, concurring in part and dissenting in part:

I concur in the majority's holding that the opposition must be sustained on the ground that the word portion of applicant's mark is merely descriptive and has not acquired distinctiveness, and that the opposition must be dismissed on the ground of genericness. However, I disagree with the finding that opposer has failed to

**Opposition No. 112342**

prove that applicant committed fraud in the filing of its Section 2(f) declaration.

As the majority notes, the plaintiff has the burden of proving fraud by clear and convincing evidence. Moreover, case law mandates that it be proven "to the hilt," with no speculation, inference or surmise, and any doubt must be resolved against the charging party. *Smith International, Inc. v. Olin Corp.*, 209 USPQ 1033 (TTAB 1981). I believe that opposer has done so in this case.

There are three elements to establishing fraud. It must be shown that the applicant made 1) a false statement which was 2) material to the Examining Attorney's decision to allow the application. Further, it must be shown 3) that the applicant knew that the statement was false, i.e., the false statement was intentionally made.

Here, opposer has shown that applicant's statement in its Section 2(f) declaration was false. Applicant stated, in connection with its claim that the phrase "German-American Steuben Parade" had acquired distinctiveness, that "...the mark has become distinctive as applied to applicant's goods as set forth in the above application (as amended) by reason of substantially exclusive and continuous use as a mark by Applicant in

**Opposition No. 112342**

commerce which may be lawfully regulated by Congress for the 5 years next preceding the date of filing of this Declaration." The statement was dated January 12, 1998. Thus, according to the statement, applicant's use of the phrase was substantially exclusive since January 1993. However, opposer has shown that at the time the declaration was made, applicant knew of the use of "German-American Steuben Parade" by both opposer and the Philadelphia organization. As the majority notes, opposer marched in applicant's parade in 1997 (within the year prior to applicant's making its Section 2(f) declaration), carrying opposer's banner which bears the statement "Societies of Greater Chicago United German-American STEUBEN PARADE." And applicant participated in opposer's parade in 1996 or 1997. Applicant also knew at the time that it filed its declaration that opposer objected to applicant's application in which applicant was attempting to claim exclusive rights to the phrase "German-American Steuben Parade." (Opposer's letter dated January 28, 1997).

Opposer has also shown that the Philadelphia organization officially adopted the name "German-American Steuben Parade" in January 1992 (six years before applicant's declaration of substantially exclusive use),

**Opposition No. 112342**

and that this name has been used on all of the Philadelphia organization's stationery, programs and the like. As the majority opinion details, the Philadelphia association has invited representatives from the New York committee to its parade, and New York committee members have attended the Philadelphia association's parade since at least 1996 (again, prior to the execution of the Section 2(f) declaration in January 1998). Alfred Taubenberger, of the Philadelphia association, testified that Bill Hetzler, chairman of the German-American Steuben Parade Committee, which is governed by applicant, has been invited to the Philadelphia parade, and vice versa. Each man is a speaker at the other's banquets connected with their respective "German-American Steuben Parades." Further, each organization advertises in the other's parade program, and opposer has introduced into evidence the applicant's program for its 1997 parade which lists "Philadelphia German-American Steuben Parade Committee" as a participant.

This evidence is sufficient to show that the statement made by applicant in its Section 2(f) declaration was false, and also that applicant knew (or should have known) of its falsity. I recognize that we have no direct testimony that Theobald J. Dengler,

**Opposition No. 112342**

applicant's then president-chairman who signed the declaration, was personally aware of the aforesaid activities by opposer and the Philadelphia association, but it is not necessary to provide such direct evidence. It is clear that the officers of applicant either knew through their direct contact with both organizations of the use by these organizations of "German-American Steuben Parade," or would otherwise have been aware of the organizations' use of the phrase because applicant participated in the other organizations' parades, and vice versa. Applicant cannot hide from the knowledge its organization had by having the declaration signed by someone who would have been unaware of this information. See *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986).

Finally, it is clear that the Section 2(f) declaration was material to the Examining Attorney's determination of registrability. The Examining Attorney had actually refused registration of the application on the ground that the phrase was merely descriptive, and had indicated that the mark would not be accepted without a showing of acquired distinctiveness.

Thus, I believe that opposer has made out a prima facie case of fraud. And what has applicant submitted to

rebut that case? Nothing. Applicant has submitted no evidence whatsoever. In its brief applicant's attorney has made the argument that applicant did not believe opposer and the Philadelphia organization were using the phrase "German-American Steuben Parade" as a mark, but were using the term descriptively, and therefore applicant believed it had a reasonable basis for asserting a claim of substantially exclusive use of the words as a mark. Aside from the fact that this argument is totally unsupported, I do not believe that this semantic game-playing may avoid a claim of fraud. The manner in which opposer and the Philadelphia organization were using the phrase was the same as the manner in which applicant was using the phrase.<sup>9</sup> The other organizations may not have been claiming trademark rights in it because

---

<sup>9</sup> The majority comments that "opposer's use was not consistently the exact phrase 'German-American Steuben Parade' but rather 'CHICAGO 76th German Day and 31st von Steuben German Day PARADE'; and the Philadelphia association's parade was identified as 'Philadelphia German-American Steuben Parade, Ethnic Heritage and Pride.'" The majority states that these differing uses give credence to applicant's argument that it did not believe others were using the phrase "German-American Steuben Parade" as a mark. This argument is equally unpersuasive. Again, there is no testimony from applicant as to its belief. Further, although there is evidence as to variations in the names used by opposer, the majority's recitation of the facts makes clear that one of the terms used is "German-American Steuben Parade." Also, the official name of the Philadelphia association's parade, used since 1992 on all signs, stationery, press releases, programs, t-shirts and the like, is "German-American Steuben Parade."

**Opposition No. 112342**

they recognized that it was a descriptive term which was free for all German-Americans to use to describe their parades and related activities (in the same way that American towns would not attempt to gain exclusive rights to FOURTH OF JULY PARADE for their particular parades). But if applicant believed it was using the phrase as a mark, it should have accorded the same effect to the other associations' use of the phrase. That is, to the extent that applicant was using "German-American Steuben Parade" as a mark, the use of this phrase by opposer and the Philadelphia organization was no less of a mark.

The majority also relies on the fact that during the prosecution of the application the Examining Attorney invited applicant to submit a Section 2(f) claim, even though the Examining Attorney's Nexis search had revealed four articles that made reference to opposer's parades. The majority deduces from this fact that the information about others' using the term was not material to the decision to allow the application, and makes equivocal whether applicant intended to deceive the Examining Attorney with its Section 2(f) declaration. I disagree with both points.

First, the articles made of record by the Examining Attorney refer variously to "Von Steuben German Day

**Opposition No. 112342**

Parade" ("Chicago Sun-Times," May 23, 1997); the "von Steuben German Day Parade" ("Chicago Sun-Times," September 14, 1996); the "31st annual General von Steuben Day Parade" ("Chicago Tribune," September 13, 1996); and the "Steuben Parade" ("The Associated Press" wire service report, September 5, 1996). Thus, the Examining Attorney was not aware, when she indicated that applicant could assert a claim of acquired distinctiveness for the phrase "German-American Steuben Parade," that opposer was using the latter phrase. More importantly, the fact that the Examining Attorney accepted the Section 2(f) declaration does not show that the applicant's statement in its Section 2(f) declaration of substantially exclusive use was not material to the Examining Attorney's decision to allow the application. If the Examining Attorney had known of opposer's use of the phrase "German-American Steuben Parade" and the extent of opposer's use, or that there was an entirely separate organization (Philadelphia) also using the term, she might well have refused to allow the application. Just as the majority has found (and I have concurred with this finding) that applicant has failed to show that the phrase has acquired distinctiveness in view of opposer's and the Philadelphia

**Opposition No. 112342**

organization's use of the phrase, the Examining Attorney may have also determined this.

The majority's second point is that the Examining Attorney's suggestion that applicant submit a Section 2(f) declaration somehow negated any intent to deceive on the part of applicant. I would point out that even applicant has not contended, let alone submitted evidence, that it relied on the Examining Attorney's suggestion of filing a Section 2(f) declaration as a basis for believing that the statements made in its Section 2(f) were not knowingly false. And I do not believe that the mere fact that an Examining Attorney suggests that an applicant may want to make a Section 2(f) claim can insulate an applicant from a claim of fraud. Examining Attorneys routinely will suggest, if they believe a mark to be merely descriptive and not generic, that an applicant consider seeking registration under Section 2(f). This does not relieve an applicant of being truthful in its Section 2(f) declaration. Even if we could go as far as saying that on the basis of the articles the Examining Attorney was fully aware of the use by opposer (and, as I stated above, the Examining Attorney was not even aware that opposer was using the exact phrase for which applicant claimed acquired

**Opposition No. 112342**

distinctiveness), the Examining Attorney had no information as to the use by the Philadelphia association. Therefore, applicant cannot be said to have relied on the Examining Attorney's invitation to seek registration pursuant to Section 2(f) despite her supposed knowledge of opposer's use to justify applicant's claim of substantially exclusive use when applicant knew, and the Examining Attorney did not know, of the Philadelphia organization's use.

I would also like to make a comment about the element of intent. Intent does not have to be shown by a so-called smoking gun, such as testimony by the applicant itself or exhibits in which applicant states that it intends to lie. Intent may be inferred. Here, the statement of substantially exclusive use has been shown by opposer to be false. The evidence of applicant's knowledge of opposer's and the Philadelphia organizations' use of "German-American Steuben Parade" is sufficient to prove that the false statement was knowingly and intentionally made. Thus, applicant's conduct falls within the language quoted by the majority from *Smith International, Inc. v. Olin Corp.*, supra: a willful withholding from the Patent and Trademark Office by an applicant of material information or facts which,

**Opposition No. 112342**

if disclosed to the Office, would have resulted in the disallowance of the registration.

Accordingly, because opposer has established by clear and convincing evidence that applicant's statements in its Section 2(f) declaration were knowingly and intentionally false, and that these statements were material to the acceptance of the application by the Examining Attorney, I would also sustain this opposition on the ground of fraud.