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### Initial Impressions: Trademark Protection for Abbreviations of Generic or Descriptive Terms

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# INITIAL IMPRESSIONS: TRADEMARK PROTECTION FOR ABBREVIATIONS OF GENERIC OR DESCRIPTIVE TERMS

Mary LaFrance\*

I. Introduction: The Distinctiveness of Abbreviations.....	201
II. The Evolving Law by Jurisdiction.....	203
A. The PTO and CCPA Approach .....	203
B. In the Circuits.....	207
III. Concluding Observations .....	238

## I. INTRODUCTION: THE DISTINCTIVENESS OF ABBREVIATIONS

The question whether, and under what circumstances, an abbreviation<sup>1</sup> for a generic<sup>2</sup> or merely descriptive term qualifies for

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1. In general, the analysis in this article does not distinguish between initials and other forms of abbreviations. While the nature of a particular abbreviation will certainly affect the outcome of the trademark analysis in any given case, the same general analytical questions arise. Terminology is not always consistently used in the relevant case law. The term “abbreviations” covers the broadest category, referring to any shortening of a word or phrase. The rarely-used term “initialisms” refers to abbreviations made up of the first letters of all or most words in a phrase. The more common term “acronym,” in its narrowest sense, refers to a subset of initialisms which are pronounced as words (e.g., LASIK, NATO, BEARS), unlike ordinary initialisms which are pronounced as a series of letters (AARP, AAA, SSRN, DVD). Some terms which originated as acronyms are today recognized as ordinary words (e.g., scuba, laser, radar, sonar). Some initialisms have sprouted word equivalents based on their pronunciation (e.g., deejay, tee-shirt, emcee). However, many courts use the term “acronyms” in a broader sense, as a synonym for initialisms. Even more detailed distinctions can be drawn among various categories of initialisms, as illustrated by the Wikipedia entry on acronyms and initialisms. See *Acronym and initialism*, WIKIPEDIA, <http://en.wikipedia.org/wiki/Acronym> (last modified Aug. 24, 2011). While the same general analytical questions arise in determining whether an abbreviation of any of these types qualifies for trademark protection, the nature of the particular abbreviation in question may affect the outcome of the trademark analysis in any given case.

2. Generic terms are not eligible for protection as trademarks. See *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111, 116-17 (1938); *Harley-Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 810 (2d Cir. 1999); *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9-10 (2d Cir. 1976);

trademark protection has produced a surprising variety of juristic responses. Many courts ask whether, in the minds of the public, the abbreviation has a meaning distinct from the underlying words; however, courts have expressed the necessary degree of distinction in different ways and have entertained widely varying presumptions with respect to consumer perceptions. As a result, the federal courts impose inconsistent burdens on the party seeking protection for a trademark that takes the form of an abbreviation. Other courts do not inquire as to consumer perceptions at all, and have instead adopted *per se* rules categorically holding such abbreviations to be either inherently distinctive or unprotectable at all.

In this jungle of irreconcilable doctrines, the Second Circuit, which ordinarily plays a leadership role in trademark jurisprudence, has issued inconsistent and poorly explained rulings, and as a result had little influence on doctrinal development, and the Federal Circuit, in its modern incarnation, has contributed nothing at all. The most influential and well-considered doctrine has emerged from two sources—the Court of Customs and Patent Appeals (CCPA) (one of the Federal Circuit’s predecessor courts) and the Seventh Circuit. Because these precedents conflict—with the CCPA’s approach favoring trademark owners, and the Seventh Circuit’s approach disfavoring them—other federal courts have faced a choice between opposing approaches, and in some cases have developed their own approaches. Unfortunately, not all of the juristic approaches have involved careful analysis, and a number of courts have adopted *per se* rules that automatically favor or disfavor trademark owners, with no serious inquiry into the source-identifying capacity of the marks.

This article compares the approaches which different federal courts have adopted to address the distinctiveness of abbreviations where the underlying expression or information conveyed by the abbreviation is

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Weiss Noodle Co. v. Golden Cracknel & Specialty Co., 290 F.2d 845, 847 (C.C.P.A.1961); J. Kohnstam, Ltd. v. Louis Marx & Co., 280 F.2d 437, 440 (C.C.P.A. 1960). “This rule protects the interest of the consuming public in understanding the nature of goods offered for sale, as well as a fair marketplace among competitors by insuring that every provider may refer to his goods as what they are.” Otokoyama Co., Ltd. v. Wine of Japan Imp., Inc., 175 F.3d 266, 270 (2d Cir. 1999) (citing CES Publ’g Corp. v. St. Regis Publ’ns, Inc., 531 F.2d 11, 13 (2d Cir. 1975) (Friendly, J.) (“To allow trademark protection for generic terms, i.e., names which describe the genus of goods being sold [is impermissible because] a competitor could not describe his goods as what they are.”) (citations omitted); see also RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 15cmt. b (“A seller . . . cannot remove a generic term from the public domain and cast upon competitors the burden of using an alternative name.”)); John F. Coverdale, *Trademarks and Generic Words: An Effect-on-Competition Test*, 51 U. CHICAGO L. REV. 868 (1984).

unprotectable either because it is generic or because it is descriptive and lacks secondary meaning. While this study is not intended as a comprehensive survey, it is designed to highlight the inconsistencies in approaches. The article concludes with some observations about the patterns and trends emerging from the unsettled decisional law.

## II. THE EVOLVING LAW BY JURISDICTION

### A. *The PTO and CCPA Approach*

Decisions of the Court of Customs and Patent Appeals (CCPA) and the PTO have generally focused on whether the abbreviation has the same significance to the relevant consumers as the underlying phrase. For example, in *Martell & Co. v. Societe Anonyme De La Benedictine*,<sup>3</sup> the CCPA held that a mark consisting predominantly of the abbreviation “B and B” could not be registered as a trademark for a bottled beverage consisting of Benedictine and brandy. Because both parties agreed “that the notation ‘B and B’ is a designation of Benedictine and brandy in equal parts and that the designation has been popularly and exclusively so used in the United States for approximately thirty years,” the court held that “the term is necessarily descriptive of the said goods.”<sup>4</sup>

In *Breth v. Cutting Room Appliances Corp.*,<sup>5</sup> the PTO Commissioner upheld the refusal to register “C.R.A.,” an abbreviation for the generic term “cutting room appliances,” as a trademark for various devices used in cutting rooms of clothing manufacturers. The Commissioner held that “‘C.R.A.,’ when displayed in association with applicant’s name, can have no other meaning than ‘cutting room appliances;’ and . . . applicant in its advertising has assiduously taught the public to regard the mark as having that significance.”<sup>6</sup> Because the evidence indicated that “C.R.A.” had “the same significance in the trade” as the underlying generic phrase, it was ineligible for registration.<sup>7</sup>

Opinions of the CCPA consistently recognized that not all abbreviations for generic or descriptive terms are themselves generic or descriptive, as exemplified by the influential decision in *Modern Optics*

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3. *Martell & Co. v. Societe Anonyme De La Benedictine*, 116 F.2d 516, 519 (C.C.P.A. 1941).

4. *Id.*

5. *Breth v. Cutting Room Appliances Corp.*, 57 U.S.P.Q. (BNA) 46, 4 (Com’r Pat. & Trademarks Jan. 1, 1943).

6. *Id.* at 1.

7. *Id.* at 2.

v. *Univis Lens Co.*<sup>8</sup> *Modern Optics* concerned the initials “CV,” standing for “continuous vision,” a term which itself was either descriptive or suggestive (a question the court did not decide) as applied to trifocal eyeglass lenses.<sup>9</sup> The CCPA held that “CV” was not itself descriptive for these lenses because there was insufficient evidence that CV was “a generally recognized term for multifocal lenses and lens blanks.”<sup>10</sup> While noting that it was “possible for initial letters to become so associated with descriptive words as to become descriptive themselves,”<sup>11</sup> the court held: “It does not follow, however, that all initials of combinations of descriptive words are ipso facto unregistrable.”<sup>12</sup> The court distinguished “CV” from other abbreviations, such as those in *Martell* and *Breth*, which had, in the minds of consumers, become synonymous with their underlying generic phrases:

While each case must be decided on the basis of the particular facts involved, it would seem that, as a general rule, *initials cannot be considered descriptive unless* they have become so generally understood as representing descriptive words as to be accepted as substantially synonymous therewith.<sup>13</sup>

Although *Modern Optics* did not expressly articulate the burden of proof or persuasion, the emphasized language implies that the party challenging the abbreviation’s trademark status bears the burden of establishing that consumers assign a descriptive meaning to the abbreviation. The factual record in *Modern Optics* was mixed in this regard; while some consumers viewed CV as a generic term, the evidence was insufficient to establish that this perception was the rule rather than the exception.<sup>14</sup>

The Trademark Trial and Appeal Board (TTAB) has consistently followed the *Modern Optics*<sup>15</sup> approach, focusing on whether consumers perceive the abbreviation *itself* as having generic or descriptive meaning,

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8. *Modern Optics, Inc. v. Univis Lens Co.*, 234 F.2d 504 (C.C.P.A. 1956).

9. *Id.* at 505.

10. *Id.* at 506.

11. *Id.*

12. *Id.*

13. *Id.* (emphasis added) (citing *Martell & Co. v. Societe Anonyme De La Benedictine*, 116 F.2d 516 (C.C.P.A. 1941) and *Breth v. Cutting Room Appliances Corp.*, 57 U.S.P.Q. (BNA) 46 (Com’r Pat. & Trademarks Jan. 1, 1943)).

14. *Id.* at 506.

15. *Id.* at 504.

regardless of how they perceive the underlying phrase.<sup>16</sup> The TTAB has explicitly stated that the question whether initials are generic is distinct from the question whether the words they stand for are generic.<sup>17</sup>

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16. T.T.A.B. decisions refusing trademark protection for abbreviations include: *In re Finisar Corp.*, 78 U.S.P.Q.2d (BNA) 1618 (T.T.A.B. 2006) (“SFP” is a common abbreviation for “small form-factor pluggable” as applied to optical transceivers); *Capital Project Mngt., Inc., v. IMDISI, Inc.*, 70 U.S.P.Q.2d (BNA) 1172, 1182-83 (T.T.A.B. 2003) (relevant consumers equated “TIA” with underlying generic phrase “time impact analysis”); *Cont’l Airlines Inc. v. United Air Lines Inc.*, 53 U.S.P.Q.2d (BNA) 1385 (T.T.A.B. 2000) (refusing registration for “e-ticket” because public understood the term as referring to generic category of electronic ticketing services); *In re Unif. Prod. Code Council, Inc.*, 202 U.S.P.Q. (BNA) 618 (T.T.A.B. 1979) (refusing service mark registration for “UPC,” an abbreviation for “Universal Product Code,” because applicant (a consortium) used both terms as common descriptive names for machine-readable product codes on product packaging); *Southwire Co. v. Kaiser Aluminum & Chem. Corp.*, 196 U.S.P.Q. (BNA) 566 (T.T.A.B. 1977) (as perceived by persons in industry, “ALR” is descriptive for electrical wire, because it stands for “aluminum revised”); *In re Harris-Intertype Corp.*, 188 U.S.P.Q. (BNA) 585 (T.T.A.B. 1975) (“rf” is descriptive for radio transmitters, receivers and parts because it is a recognized abbreviation for “radio frequency”); *Intel Corp. v. Radiation Inc.*, 184 U.S.P.Q. (BNA) 54 (T.T.A.B. 1974) (“PROM” is merely descriptive as applied to programmable read only memories); *El Paso Prods. Co. v. C.P. Hall Co.*, 180 U.S.P.Q. (BNA) 409, 413-14 (T.T.A.B. 1973) (“DMG” is recognized or would be recognized and referred to by the average purchaser of dimethyl glutarate as the apt and common descriptive abbreviation for the product rather than as a trademark serving to identify and distinguish the dimethyl glutarate produced and/or marketed by any one person.”); *Foremost Dairies, Inc. v. Borden Co.*, 156 U.S.P.Q. (BNA) 153, 154 (T.T.A.B. 1967) (“HOMO” is merely a recognized abbreviation for the word homogenized and has been so used both by opposer and others in the dairy industry. As such, it cannot function as a trademark for homogenized milk. . . .); *In re Initial Teaching Alphabet Publ’ns, Inc.*, 153 U.S.P.Q. (BNA) 684 (T.T.A.B. 1967) (letters “i.t.a.” have a commonly recognized meaning in applicant’s particular field” as an abbreviation for “initial teaching alphabet”); *Burroughs Corp. v. Microcard Reader Corp.*, 138 U.S.P.Q. (BNA) 517 (T.T.A.B. 1963) (refusing registration for “MICR” for machines used for viewing magnetic ink characters because “MICR” was used in electronics and banking industries as an abbreviation for and interchangeably with “magnetic ink character recognition”); and *In re Gen. Aniline & Film Corp.*, 136 U.S.P.Q. (BNA) 306 (T.T.A.B. 1962) (“PVP” was unregistrable for polyvinylpyrrolidone because it was the “accepted abbreviation” for this synthetic material).

T.T.A.B. decisions holding abbreviations protectable as trademarks include: *Racine Indus. Inc. v. Bane-Clene Corp.*, 35 U.S.P.Q.2d (BNA) 1832, 1838 (T.T.A.B. 1994) (although “Professional Cleaners Association” is descriptive or generic, “PCA” is not understood by the relevant public as synonymous therewith) (citing *Modern Optics*, 234 F.2d 504); *Sbs Prods. Inc. v. Sterling Plastic & Rubber Prods. Inc.*, 8 U.S.P.Q.2d (BNA) 1147, 1149 n.6 (T.T.A.B. 1988) (“SBS” is not a weak mark even though derived from the initials of “stuffing box sealant” or “sugar beet soap,” absent a showing that these letters are recognized abbreviations for those products); *Aloe Creme Labs., Inc. v. Aloe 99, Inc.*, 188 U.S.P.Q. (BNA) 316 (T.T.A.B. 1975) (despite phonetic equivalence, “ALO” was not generic for opposer’s products made with aloe, because it had acquired secondary meaning among customers); *In re Pac. Indus., Inc.*, 167 U.S.P.Q. (BNA) 704 (T.T.A.B. 1970) (because purchasers recognized “EDP” as source indicator for applicant’s carbon paper, it can be registered even though the initials may stand for “electronic data processing” or “extra data print-out”); *In re U.S. Catheter & Instrument Corp.*, 158 U.S.P.Q. (BNA) 53 (T.T.A.B. 1968) (where record failed to indicate that “NBH” possessed any known meaning for purchasers of applicant’s medical devices, initials were eligible for registration on principal register); *Nife, Inc. v. Gould-Nat’l Batteries, Inc.*, 128 U.S.P.Q. (BNA) 453, 454-55 (T.T.A.B. 1961) (“The record is wholly

In its most recent application of *Modern Optics*, the TTAB was asked in *In re Thomas Nelson, Inc.*,<sup>18</sup> to determine whether “NKJV” was merely descriptive of the applicant’s bibles because the initials stand for the descriptive term “New King James Version.” The Board outlined a three-step inquiry:

- (1) Whether “NKJV” is an abbreviation for “New King James Version”;
- (2) Whether “New King James Version” is merely descriptive of bibles; and
- (3) Whether a relevant consumer viewing “NKJV” in connection with bibles would recognize it as an abbreviation for “New King James Version.”<sup>19</sup>

The Board derived this inquiry from its 1984 decision in *In re Harco Corp.*,<sup>20</sup> where it held that “CPL” (standing for “computerized potential log”) was arbitrary, even though the underlying phrase was descriptive, because there was no “convincing evidence” that persons coming into contact with the applicant’s services would perceive “CPL” as “no more than” an abbreviation for the underlying descriptive phrase.<sup>21</sup> Thus, the Board in *Harco* placed the burden of proof squarely on the Examining Attorney rather than the applicant, and required the Examining Attorney to show not only that consumers recognized what “CPL” stood for, but also to show that they perceived it as “no more than” an abbreviation for the underlying descriptive term.<sup>22</sup> In contrast, the Board’s decision in *Nelson* did not expressly discuss the burden of proof.<sup>23</sup> Furthermore, in its analysis of the third inquiry, the Board imposed a lower burden of proof on the Examiner, requiring proof only that consumers “would recognize” NKJV as an abbreviation, rather than requiring proof, as in *Harco*, that consumers perceived it as “no more than” an abbreviation.<sup>24</sup>

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insufficient to show that ‘NICAD’ is an abbreviation, contraction or foreshortening for nickel cadmium and is commonly used in the trade and by purchasers in lieu of the complete words in referring to nickel cadmium batteries. To the contrary, the record tends to indicate that ‘NICAD’ is used and recognized as the trademark for applicant’s nickel cadmium batteries.”).

17. See *Capital Project Mgmt., Inc., v. IMDISI, Inc.*, 70 U.S.P.Q.2d (BNA) 1172, 1179 (T.T.A.B. 2003) (“[W]e must examine whether the letters ‘TIA’ are generally recognized and used in the construction field as an accepted abbreviation for ‘time impact analysis.’”) (citing *Modern Optics*, 234 F.2d 504).

18. *In re Thomas Nelson, Inc.*, 97 U.S.P.Q.2d 1712 (T.T.A.B. 2011).

19. *Id.* at \*5.

20. *In re Harco Corp.*, 220 U.S.P.Q. (BNA) 1075 (T.T.A.B. 1984).

21. *Id.*

22. *Id.*

23. *Nelson*, 97 U.S.P.Q.2d 1712.

24. *Id.* at \*6; *Harco*, 220 U.S.P.Q. (BNA) at 1076.

Accordingly, while there is some variation in the standard of proof required by the TTAB, the Board has consistently followed *Modern Optics*<sup>25</sup> in requiring the PTO to establish that consumers perceive the abbreviation itself as a descriptive term.

### B. *In the Circuits*

Outside of the CCPA, courts have taken divergent approaches to analyzing the distinctiveness of abbreviations. As discussed below, while some courts have adopted an analysis consistent with the CCPA and TTAB approaches as exemplified by *Modern Optics*,<sup>26</sup> others have placed significantly greater—and sometimes insurmountable—burdens on parties seeking to protect abbreviations of generic or descriptive terms; still others have adopted *per se* rules either favoring or disfavoring the trademark owner. Only in a small minority of cases have these courts offered persuasive reasoning to justify the rules they have adopted.

Many appellate courts have avoided discussing the issue by affirming district court decisions without issuing opinions, or by issuing perfunctory memorandum opinions. Thus, while federal case law on this topic goes back at least as far as 1924, relatively few appellate decisions provide substantive analyses of the issues. But the few appellate opinions, together with the larger number of district court opinions, reveal a surprising range of disagreement on the proper approach to abbreviations. Furthermore, even though there is a substantial body of CCPA and TTAB precedents available for guidance, these authorities have been largely ignored by the district and appellate courts.

#### 1. Second Circuit: Turn, and Turn Again<sup>27</sup>

Although the Second Circuit is one of the most influential jurisdictions in trademark jurisprudence, the decisions of its courts on the distinctiveness of abbreviations have been inconsistent and not entirely coherent. Very few opinions have been issued at the appellate level and, as discussed below, those opinions have largely been ignored by the district courts.

The pre-Lanham Act opinion in *Standard Brands, Inc. v. Smidler*<sup>28</sup> provided a generous degree of protection to the “V-8” mark for the

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25. *Modern Optics, Inc. v. Univis Lens Co.*, 234 F.2d 504 (C.C.P.A. 1956).

26. *Id.*

27. WILLIAM SHAKESPEARE, HENRY VI, PART I, act 3, sc. 3.

28. *Standard Brands, Inc. v. Smidler*, 151 F.2d 34 (2d Cir. 1945).



plaintiff's vegetable juice product. The Second Circuit held that the mark was "arbitrary and fanciful," even though many consumers were aware that the product consisted of eight vegetable juices, and probably understood "V-8" as a shorthand reference to that fact:

Yet we agree with the court below that the mark is a non-descriptive one when used on the container of a vegetable juice cocktail. The letter V by itself no more signifies 'vegetable' than it does any other word of which it is the initial letter and it is only when resort is had to other parts of the label that one may glean that it stands for 'vegetable.' As much is true of the figure 8, and when put together as they are in the mark they are only an arbitrary and fanciful symbol chosen to designate the plaintiff's vegetable juice cocktail. This mark has become the distinctive name of that cocktail not because it is inherently descriptive of anything but because it has been so used that it has become associated in the public mind as the banner of that product. That does not make the mark descriptive but is only evidence of the effectiveness of its use. By repeatedly advertising the fact that its cocktail is made of the combined juices of eight vegetables, the plaintiff has undoubtedly taught the purchasing public that V-8 on a tin can means such a cocktail. Except for this association, we think, no one could reasonably be expected to know that 'V-8' designated a vegetable juice cocktail, or any other particular thing for that matter, unless it be something so described by both shape and number, like an eight cylinder automobile engine, for instance, having cylinder[s] set at an acute angle to each other.<sup>29</sup>

This case stands in sharp contrast to later decisions in the Seventh<sup>30</sup> and Eleventh<sup>31</sup> Circuits, which found abbreviations to be descriptive where the merchant's packaging or marketing materials conveyed (or might in the future convey) to consumers the descriptive aspects of the abbreviation. However, the opinion appears to have had no influence on subsequent Second Circuit case law regarding abbreviations.

In 1961, the Second Circuit held in *Blisscraft of Hollywood v. United Plastics Co.*,<sup>32</sup> that "Poly" could be protected as a common law mark for polyester pitchers, because the defendant provided insufficient evidence that the relevant purchasing public equated the term with polyethylene (and thus that the mark was descriptive). The court reached this conclusion in spite of evidence showing that the plaintiff's

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29. *Id.* at 36.

30. *See infra* notes 71-96 and accompanying text.

31. *See infra* notes 166-212 and accompanying text.

32. *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 699-702 (2d Cir. 1961).

advertising informed consumers that its “Poly Pitcher” and its entire line of “Poly Ware” were made of polyethylene.<sup>33</sup> The court noted that the dictionary meaning of “poly” has nothing to do with polyethylene,<sup>34</sup> and that the word was also “reminiscent or suggestive of Molly Pitcher of Revolutionary time.”<sup>35</sup> However, this was uniquely true of the “Poly Pitcher” product, and completely inapplicable to the other products in the “Poly Ware” line. Furthermore, the court did not consider the fact that a consumer’s inclination to pronounce “Poly” so as to rhyme with “Molly” (as opposed to rhyming with “holy”) might be based in part on that consumer’s recognition that “Poly” was short for “polyester” (although the consumer might not be fully conscious of making that association).<sup>36</sup> Without considering these potential flaws in its reasoning, the court concluded that “Poly Pitcher” was “an incongruous expression,” having “the characteristics of a coined or fanciful mark.”<sup>37</sup>

*Blisscraft*<sup>38</sup> could be viewed as consistent with the *Modern Optics*<sup>39</sup> approach, because, however flawed its analysis, the court at least considered how consumers actually perceived the term “Poly.”

On the heels of *Blisscraft*<sup>40</sup>, a district court in Connecticut expressly relied on *Modern Optics*<sup>41</sup> in holding that the registered mark “hi-g” was descriptive for devices designed to withstand a high multiple of gravitational force. The court in *General Controls Co. v. Hi-G, Inc.* observed:

The parties agree that the letter ‘g’ is a well-known abbreviation or symbol for the forces of gravity and acceleration. ‘Hi-g’ is commonly used to express a high multiple of gravitational force which may range from a fraction of a ‘g’ up into the hundreds. The abbreviation of ‘high’ to ‘hi’ when hyphenated to ‘g’ is a combination so widely

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33. *Id.* at 701-02.

34. “Webster’s New International Dictionary (2d ed. 1958) defines ‘poly’ as ‘consisting of many,’ ‘a plurality,’ ‘a number above the normal.’ In the absence of any evidence to the contrary, we cannot assume that to members of the public at large the word ‘poly,’ either alone or in combination with ‘pitcher,’ had any meaning other than that attributed to it by the lexicographer.” *Id.* at 699.

35. *Blisscraft*, 294 F.2d at 700.

36. *Id.*

37. *Id.*

38. *Blisscraft*, 294 F.2d 694.

39. *Modern Optics, Inc. v. Univis Lens Co.*, 234 F.2d 504 (C.C.P.A. 1956).

40. *Blisscraft*, 294 F.2d 694.

41. *Modern Optics*, 234 F.2d 504.

associated with high gravity as to be generally accepted as a contraction.<sup>42</sup>

Furthermore, the plaintiff's advertisements had educated its customers about the meaning of "hi-g" for nearly two decades.<sup>43</sup>

In contrast to these two early precedents, two subsequent decisions from the Southern District of New York are clearly at odds with *Modern Optics*<sup>44</sup> and take the position that initials are inherently descriptive. These cases are *Programmed Tax Systems, Inc. v. Raytheon Co.* (involving "P.T.S." for "programmed tax systems")<sup>45</sup> and *American Optical Corp. v. American Olean Tile Co., Inc.* (involving "AO" for "American Optical").<sup>46</sup> Both decisions involved initials rather than shortened forms of longer words, such as "Poly." In each case, the court seemed to state that initials by their very nature cannot be inherently distinctive. *American Optical* held that "[t]he initials 'AO' are letters in the alphabet available for use by everyone," and "[t]here is nothing about those initials to conjure up instantaneously the plaintiff."<sup>47</sup> In *Programmed Tax Systems*, the court was even blunter: "Combinations of letters of the alphabet are readily available for use by anyone and are merely descriptive."<sup>48</sup> Because *all* word marks are made up of letters of the alphabet (or sometimes numbers), this statement is absurd. Neither opinion explained why letters of the alphabet should be treated differently from words in a dictionary, which, depending on context, can be arbitrary or suggestive as well as descriptive or generic. In neither case did the court consider the Second Circuit's *Blisscraft*<sup>49</sup> precedent, probably because that case did not involve initials. Furthermore, neither of these cases considered how the initials were actually perceived by the relevant consumers, whether those consumers typically encountered the initials together with the underlying expressions, or the degree of distinctiveness in the underlying expressions.

Still later, the Southern District of New York appears to have abandoned the "inherently descriptive" rule for initials and reverted to an

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42. *Gen. Controls Co. v. Hi-G, Inc.*, 212 F. Supp. 152, 155-56 (D. Conn. 1962) (citing *Modern Optics*, 234 F.2d at 504).

43. *Id.* at 156.

44. *Modern Optics*, 234 F.2d 504.

45. *Programmed Tax Sys., Inc. v. Raytheon Co.*, 419 F. Supp. 1251 (S.D.N.Y. 1976).

46. *Am. Optical Corp. v. Am. Olean Tile Co., Inc.*, 185 U.S.P.Q. (BNA) 405 (S.D.N.Y. 1974).

47. *Id.* at 409.

48. *Programmed Tax Sys.*, 419 F. Supp. at 1253.

49. *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 699-702 (2d Cir. 1961).

approach resembling *Modern Optics*<sup>50</sup> and *Blisscraft*<sup>51</sup> (although it failed to mention either case). In its 1985 opinion in *Merritt Forbes & Co. Inc. v. Newman Investment Securities, Inc.*,<sup>52</sup> the Southern District held that the acronym “TOP’s” could be a valid trademark even though it stood for the generic term “tender option program.” The court noted that some abbreviations can be arbitrary or fanciful, while acknowledging that “commonly understood abbreviations” might be descriptive or generic.<sup>53</sup>

Why the change of heart? Was the *Merritt Forbes*<sup>54</sup> court influenced by the fact that “TOP’s” was an acronym—and thus pronounceable as a word, like “Poly”—rather than an unpronounceable initialism like “P.T.S.” or “AO”?

In the interim, the Eastern District had also weighed in with two opinions on marks that, while combining letters and numbers, could be considered to be abbreviations in the sense that they summarized information that would otherwise be communicated in lengthier expressions. *Nature’s Bounty, Inc. v. Basic Organics*<sup>55</sup> held that the mark “B-100” was descriptive as applied to a vitamin containing 100 milligrams of vitamin B. Because it had become commonplace for vitamin companies to identify single-entity vitamins by the letter name of the vitamin plus its potency, the court observed, “the public now assumes it is buying 100 milligrams of a vitamin B complex when it sees a vitamin marked with B-100. B-100 was a term coined by plaintiff, but it is now associated with the product.”<sup>56</sup> Shortly thereafter, in *Nature’s Bounty, Inc. v. SuperX Drugs Corp.*,<sup>57</sup> the same court held that the registered mark “KLB 6” was probably suggestive rather than descriptive for a food supplement containing kelp, lecithin, and vitamin B6.<sup>58</sup> The court noted that it would probably have reached this conclusion even without the presumption of validity arising from registration,<sup>59</sup> and distinguished its earlier holding that “B-100” for a single-entity vitamin was merely descriptive:

In the absence of evidence as to actual customer reactions, the acronym “KLB 6” appears more suggestive of the nature of the goods than

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50. *Modern Optics, Inc. v. Univis Lens Co.*, 234 F.2d 504 (C.C.P.A. 1956).

51. *Blisscraft*, 294 F.2d at 699-702.

52. *Merritt Forbes & Co. Inc. v. Newman Inv. Sec., Inc.*, 604 F. Supp. 943 (S.D.N.Y. 1985).

53. *Id.* at 956.

54. *Merritt Forbes*, 604 F. Supp. 943.

55. *Nature’s Bounty, Inc. v. Basic Organics*, 432 F. Supp. 546 (E.D.N.Y. 1977).

56. *Id.* at 552.

57. *Nature’s Bounty, Inc. v. SuperX Drugs Corp.*, 490 F. Supp. 50 (E.D.N.Y. 1980).

58. *Id.* at 54.

59. *Id.*

descriptive of the three nutritional ingredients contained therein. The conclusion that KLB 6 is suggestive is strengthened by the fact that none of the products introduced as exhibits list the ingredients in the order suggested by the designation “KLB 6.” . . . The use of an acronym referring to an admixture of not wholly familiar ingredients distinguishes this trademark from that used in connection with another Nature's Bounty product, “B-100,” a mark held by Judge Neaher to be merely descriptive of 100 milligrams of vitamin B and, therefore, not entitled to protection against infringement.<sup>60</sup>

The court also noted that the defendant had “not demonstrated that acronyms are commonly used as generic terms for nutritional compounds;”<sup>61</sup> in contrast, such a marketplace practice no doubt had influenced consumer perceptions that the “B-100” mark in the earlier case was descriptive.<sup>62</sup>

In 2010, the Western District of New York classified “NYSEG”—the abbreviation for “New York State Electric & Gas Corp.”—as a suggestive mark.<sup>63</sup> The court ignored the conflicting authorities from the Southern District; for support, it cited precedents from other circuits which had recognized that abbreviations can be arbitrary or suggestive.<sup>64</sup> Because “NYSEG” was registered and incontestable, the defendant did not challenge its validity, only its strength.<sup>65</sup> Even though the underlying phrase (which was unregistered) was merely descriptive and

60. *Id.* (citations omitted).

61. *Id.* at 54 n.4.

62. A later case from the Eastern District involved the incontestable “AAA” mark for the American Automobile Association. The defendant conceded that the mark was arbitrary, and the court did not consider the trademark status of the underlying expression. *Am. Auto. Ass’n, Inc. v. AAA Auto. Club of Queens, Inc.*, No. 97 CV 1180 SJ, 1999 WL 97918 (E.D.N.Y. Feb. 8, 1999).

63. *N.Y. State Elec. & Gas Corp. v. U.S. Gas & Elec., Inc.*, 697 F. Supp. 2d 415, 435-36 (W.D.N.Y. 2010). “A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of goods. A term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods.” *Bernard v. Commerce Drug Co.*, 964 F.2d 1338, 1341 (2d Cir. 1992) (quoting *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 11 (2d Cir. 1976)).

64. *Anheuser-Busch Inc. v. Stroh Brewery Co.*, 750 F.2d 631, 641-42 (8th Cir. 1984) (acronym is suggestive if “some operation of the imagination” is necessary to equate the initials with the product); *Vertos Med., Inc. v. Globus Med., Inc.*, No. C 09-1411, 2009 WL 3740709, at \*5 (N.D. Cal. Nov. 6, 2009) (“MILD,” which stood for generic phrase “minimally invasive lumbar decompression,” “[d]id not suggest anything to do with spinal surgery,” and, therefore, was arbitrary); *Operation Able of Greater Boston, Inc. v. Nat’l Able Network, Inc.*, 646 F. Supp. 2d 166, 176 (D. Mass. 2009) (“ABLE,” for “Ability Based on Long Experience” was suggestive and “at least moderately strong”); *Savannah Coll. of Art and Design, Inc. v. Houeix*, 369 F. Supp. 2d 929, 931-32 (S.D. Ohio 2004) (“The SCAD mark is distinctive and arbitrary . . . in as much as it is an acronym for the college’s full name, ‘Savannah College of Art and Design’”).

65. *N.Y. State Elec. & Gas Corp.*, 697 F. Supp. 2d at 435.

had “no more than moderate strength” through secondary meaning,<sup>66</sup> the court concluded that “NYSEG” was suggestive:

That the letters of the acronym stand for words that are themselves descriptive does not mean that the acronym is likewise descriptive. Although “NYS” probably connotes “New York State” to most adults rather quickly, the combination “EG” does not seem likely to *immediately* convey to a person that it refers to electricity and gas.<sup>67</sup>

It is unlikely that consumers would have attempted to pronounce “NYSEG” as a word, nor does it resemble any existing word so as to conjure up a dictionary meaning. (If it did, the court might have ruled that it was arbitrary rather than suggestive). Thus, the Western District’s ruling cannot be reconciled with *Programmed Tax Systems*<sup>68</sup> and *American Optical*<sup>69</sup> on the basis of pronunciation or dictionary-word resemblance.

Whither the Second Circuit? With no appellate guidance other than *Blisscraft*,<sup>70</sup> the district courts in this circuit have been unable or unwilling to develop a consistent body of law with respect to abbreviations, either circuit-wide or even within the prolific and trademark-savvy Southern District of New York.

## 2. Seventh Circuit: “Heavy Burden” on Trademark Proponent

The Seventh Circuit initially adopted the *Modern Optics*<sup>71</sup> approach, but in more recent cases has imposed a greater burden on the trademark proponent.

The Circuit’s early approach is illustrated by *FS Services, Inc. v. Custom Farm Services, Inc.*,<sup>72</sup> where the court held that “abbreviations for generic terms *where they are generally recognized* must be treated similarly.”<sup>73</sup> Applying this rule, the court found that the abbreviation “FS” had come to signify “farm service” or “farm supply” to the farmers

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66. *Id.*

67. *Id.* at 436 (emphasis in original).

68. *Programmed Tax Sys., Inc. v. Raytheon Co.*, 419 F. Supp. 1251 (S.D.N.Y. 1976).

69. *Am. Optical Corp. v. Am. Olean Tile Co., Inc.*, 185 U.S.P.Q. (BNA) 405 (S.D.N.Y. 1974).

70. *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 699-702 (2d Cir. 1961).

71. *Modern Optics, Inc. v. Univis Lens Co.*, 234 F.2d 504 (C.C.P.A. 1956).

72. *FS Servs., Inc. v. Custom Farm Servs., Inc.*, 471 F.2d 671 (7th Cir. 1972). An even earlier precedent, *Metropolitan Opera Ass’n v. Metropolitan Opera Ass’n of Chicago*, 81 F. Supp. 127 (N.D. Ill. 1948), dealt with the trademark status of “Metropolitan” as well as its abbreviation “Met.” but found both of them to be well-recognized marks. *Id.* at 133.

73. *FS Servs.*, 471 F.2d at 674 (emphasis added).

within the area where both parties conducted business.<sup>74</sup> Because both of these phrases were descriptive or generic, the court concluded that “FS” was itself descriptive or generic.<sup>75</sup>

Ten years later, however, the Seventh Circuit departed from this approach. In *National Conference of Bar Examiners v. Multistate Legal Studies, Inc.*,<sup>76</sup> (“NCBE”) the Seventh Circuit held that the plaintiff’s unregistered “MBE” mark was generic *solely* because the underlying term from which it was derived, “Multistate Bar Examination,” was itself generic. Unlike *FS Services*,<sup>77</sup> the *NCBE* court did not consider whether “MBE” was in fact generally recognized as having generic significance.<sup>78</sup> Instead, the court held:

Under settled trademark law if the components of a trade name are common descriptive terms, a combination of such terms retains that quality. We note further that plaintiffs also use the initials “MBE” to designate their test is of no consequence. Abbreviations for generic or common descriptive phrases must be treated similarly.<sup>79</sup>

With no further explanation, the *NCBE* decision appeared to abandon the rule of *FS Services*,<sup>80</sup> and the *Modern Optics*<sup>81</sup> rule long embraced by the CCPA and the TTAB, by eliminating the requirement that, to be generic, the abbreviation must itself be generally recognized by the relevant public as having generic significance.<sup>82</sup>

Seven years later, the Seventh Circuit altered its approach yet again, turning the seemingly-absolute rule of *NCBE* into a rebuttable presumption, albeit one which is difficult to overcome. In *G. Heileman Brewing Co. v. Anheuser-Busch, Inc.*,<sup>83</sup> the court applied this presumption in refusing to recognize the abbreviation “LA” as a common law trademark for beer with a low alcohol content. In the opinion below, the district court had applied *NCBE* to hold that the initials “LA” were descriptive solely because they stood for the descriptive and protectable phrase “low alcohol”: “[I]nitials are merely

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74. *Id.*

75. *Id.* Although the plaintiff held several trademark registrations for variations on the “FS” mark, none of these involved the letters by themselves. *Id.* at 673.

76. *Nat’l Conference of Bar Exam’rs v. Multistate Legal Studies, Inc.*, 692 F.2d 478 (7th Cir. 1982).

77. *FS Servs.*, 471 F.2d at 671.

78. *Nat’l Conference of Bar Exam’rs*, 692 F.2d at 488.

79. *Id.* (citing *FS Servs.*, 471 F.2d at 674).

80. *FS Servs.*, 471 F.2d at 671.

81. *Modern Optics, Inc. v. Univis Lens Co.*, 234 F.2d 504 (C.C.P.A. 1956).

82. *Nat’l Conference of Bar Exam’rs*, 692 F.2d at 488.

83. *G. Heileman Brewing Co., Inc. v. Anheuser-Busch, Inc.*, 873 F.2d 985 (7th Cir. 1989).

short forms of the words for which they stand and should be accorded the same degree of protection as those words.”<sup>84</sup> The district court distinguished the *Merritt Forbes*<sup>85</sup> case from the Southern District of New York because the abbreviation in that case “formed an acronym, TOP’s.”<sup>86</sup> On appeal, the Seventh Circuit refused to hold that the district court’s statement of the law was legal error *per se*.<sup>87</sup> Nonetheless, the appellate court went on to articulate a somewhat different rule, holding that initials are *rebuttably* presumed to convey the same meaning to the public as the underlying words they represent:

As a practical matter, there must be a presumption that initials mean, or will soon come to mean, to the public the descriptive phrase from which they are derived. Although the matter is certainly not foreclosed, there is a *heavy burden on a trademark claimant* seeking to show an independent meaning of initials apart from the descriptive words which are their source.<sup>88</sup>

Placing such a “heavy burden” on the trademark proponent, the court explained, was justified by “the policy of the trademark laws to guard against unjustified appropriation from the public domain of terms needed to perform a descriptive function,” and by “the general rule that the claimant of trademark law protection bears the burden of establishing by a preponderance of the evidence that an unregistered mark is entitled to trademark status.”<sup>89</sup>

Even as it imposed a “heavy burden” on the trademark proponent seeking to establish trademark significance for the abbreviation of a generic phrase, the Seventh Circuit acknowledged that its analysis was focused on situations where the public encounters both the initials and the underlying phrase in a way that establishes a connection between the two.<sup>90</sup> Nonetheless, the court speculated that only rarely would the public encounter initials without associating them with an underlying expression.<sup>91</sup>

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84. *G. Heileman Brewing Co., Inc. v. Anheuser-Busch, Inc.*, 676 F. Supp. 1436, 1493 n.48 (E.D. Wis. 1987), *aff’d*, *G. Heileman Brewing Co., Inc. v. Anheuser-Busch, Inc.*, 873 F.2d 985 (7th Cir. 1989).

85. *Merritt Forbes & Co. Inc. v. Newman Inv. Sec., Inc.*, 604 F. Supp. 943 (S.D.N.Y. 1985).

86. *G. Heileman Brewing*, 676 F. Supp. at 1493 n.48.

87. *G. Heileman Brewing*, 873 F.2d at 994.

88. *Id.* (emphasis added).

89. *Id.*

90. *Id.*

91. Even if consumers did not initially make the connection, the court suggested, they might do so in the future:

It is possible, although not likely, that the public might become acquainted with initials



When that “rare” instance occurred twelve years later, however, in *CAE, Inc. v. Clean Air Engineering, Inc.*,<sup>92</sup> the Seventh Circuit treated “CAE” as a “strong and distinctive” mark,<sup>93</sup> without citing any of its prior rulings on abbreviations, and without even considering the strength or distinctiveness of the underlying phrase. As used by the owner of the registered mark, the abbreviation originally stood for “Canadian Aviation Electronics,” and as used by the applicant (who sought to register the same mark for different goods and services), it stood for “Clean Air Engineering.” The Court of Appeals held that the registered “CAE” mark “is an unpronounceable set of letters and thus falls into the category of letter marks generally accorded broader trademark protection because ‘it is more difficult to remember a series of arbitrarily arranged letters than it is to remember words, figures, phrases or syllables.’”<sup>94</sup> The court found this principle to be “particularly applicable here because the letters CAE appear without reference to the underlying words from which they were originally derived.”<sup>95</sup> The court’s failure to apply the more rigorous analysis of its prior cases to the abbreviation at issue in this case may reflect the failure of both parties to brief the issue, since both the registrant/opposer and the applicant wanted the mark to be protected. It also reflects a muddling of two factors relevant to the likelihood of confusion analysis: the strength of the senior mark, and the degree of similarity between the senior and junior marks.

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used in connection with a product without ever being aware that the initials were derived from, and stood for, a descriptive phrase or generic name. This is conceivable, though rather improbable, because the connection between the initials and the descriptive words *is in normal course very likely to become known*. The process of identifying initials with the set of descriptive words from which they are derived is, after all, usually fairly simple. Ordinarily, no flight of imagination or keen logical insight is required. There is a natural assumption that initials do generally stand for something. All that needs to be done is to convert the next-to-obvious to the obvious by answering the inevitable question: What do the initials stand for? As a rule, no very extensive or complicated process of education or indoctrination is required to convey that initials stand for descriptive words.

*Id.* at 993-94 (emphasis added) (citations omitted).

92. 267 F.3d 660 (7th Cir. 2001).

93. *Id.* at 685.

94. *Id.* at 684 (quoting 3 J. THOMAS MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 23:33, at 23-97 (2001), and citing *Weiss Assocs., Inc. v. HRL Assocs., Inc.*, 902 F.2d 1546, 1548 (Fed. Cir. 1990) (finding TMS and TMM confusingly similar)).

95. *Id.*

### 3. Eighth Circuit: Embracing *Modern Optics*

On facts similar to *G. Heileman Brewing*,<sup>96</sup> the Eighth Circuit rejected the Seventh Circuit's approach, holding in *Anheuser-Busch, Inc. v. Stroh Brewery Co.*<sup>97</sup> that initials may be suggestive even where they stand for an underlying descriptive or generic phrase. Based on consumer survey evidence, the district court in this case found that the "LA" mark for low alcohol beer was suggestive rather than descriptive or generic:

In this Court's opinion, a term should not be equated with generic or descriptive phrases merely because the individual letters of the term may be interpreted to be initials of that generic or descriptive phrase. As explained more fully below, the real test is the consumer's perception of such term.

...

[I]t is this Court's opinion that the study supports a conclusion that "LA", when placed prominently on a can of beer as the sole brand name, stands for an idea which requires some operation of the imagination to connect it with the product, and therefore is suggestive in nature.<sup>98</sup>

Citing *Modern Optics*<sup>99</sup> with approval,<sup>100</sup> the Eighth Circuit agreed with the district court that initials, like other types of marks, are suggestive when "some operation of the imagination is required" to connect the initials with the product.<sup>101</sup> Defendant Stroh had argued that this holding was legal error, because initials which stand for a phrase that is generic or merely descriptive should be equated with that phrase as a matter of law.<sup>102</sup> Rejecting this, the appellate court held that "if some operation of the imagination is required to connect the initials with the product, the initials cannot be equated with the generic phrase but are suggestive in nature, thereby rendering them protectable."<sup>103</sup> In contrast to the Seventh Circuit, the Eighth Circuit did not suggest that such a scenario would be rare or improbable.<sup>104</sup>

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96. *G. Heileman Brewing*, 873 F.2d at 985.

97. *Anheuser-Busch Inc. v. Stroh Brewery Co.*, 750 F.2d 631 (8th Cir. 1984).

98. *Anheuser-Busch, Inc. v. Stroh Brewery Co.*, 587 F. Supp. 330, 335, 337 (E.D. Mo. 1984), *aff'd*, *Anheuser-Busch Inc. v. Stroh Brewery Co.*, 750 F.2d 631 (8th Cir. 1984).

99. *Modern Optics, Inc. v. Univis Lens Co.*, 234 F.2d 504 (C.C.P.A. 1956).

100. *Anheuser-Busch, Inc.*, 750 F.2d at 636.

101. *Id.* at 635-36.

102. *Id.* at 635.

103. *Id.* at 635-36.

104. *Id.*

A recent district court decision in Minnesota presented the abbreviation question in reverse. In *American Ass'n for Justice v. American Trial Lawyers Ass'n*,<sup>105</sup> the defendant challenged the validity of the common law trademark "Association of Trial Lawyers of America" (which the plaintiff was transitioning away from but had not yet abandoned), but did not challenge the validity of the plaintiff's registered mark, "ATLA."<sup>106</sup> The court found that consumers did not distinguish between the initials "ATLA" and the underlying phrase; the evidence indicated that consumers perceived the two marks as interchangeable source indicators.<sup>107</sup> The court briefly examined the underlying phrase to determine whether it was suggestive or descriptive, but undertook no such analysis of the abbreviation.<sup>108</sup> Nor did the court distinguish between the abbreviation and the underlying phrase in determining whether there was a likelihood of confusion with the defendant's "American Trial Lawyers Association" mark.<sup>109</sup> This approach seems inconsistent with the court's conclusion that consumers perceived both "ATLA" and "Association of Trial Lawyers of America" as indicating the same source; if that were true, then by conceding that the abbreviation was a valid mark, the defendant also conceded that the underlying phrase was a valid mark.<sup>110</sup>

While other district court decisions in the Eighth Circuit have addressed abbreviation marks, they have involved abbreviations that were registered marks; thus, the analysis in those cases has been truncated due to the presumption of validity.<sup>111</sup>

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105. *Am. Ass'n for Justice v. Am. Trial Lawyers Ass'n*, 698 F. Supp. 2d 1129, 1144 (D. Minn. 2010).

106. *Id.* at 1141.

107. *Id.* at 1144.

108. *Id.* at 1142.

109. *Id.* at 1144 (citing *G. Heileman Brewing Co., Inc. v. Anheuser-Busch*, 873 F.2d 985, 994 (7th Cir. 1989)).

110. *Id.*

111. In *Community of Christ Copyright Corp. v. Miller*, 85 U.S.P.Q.2d (BNA) 1314, 1316 (W.D. Mo. 2007), a district court summarily rejected a genericness challenge to the incontestable marks "RLDS" and "Reorganized Church of Jesus Christ of Latter-Day Saints" without making any separate analysis of the abbreviation. Deference went a bit too far, however, in *Hubbs Machinery & Manufacturing, Inc. v. Brunson Instrument Co.*, 635 F. Supp. 2d 1016, 1018 (E.D. Mo. 2009), where the district court refused to invalidate the registered mark "SM," which stood for the generic phrase "sphere mount," on the erroneous ground that genericness cannot invalidate a registered mark.

#### 4. Fourth Circuit: Erratic Decisionmaking

The inconsistency of the decisions on abbreviation marks that have emerged from courts in the Fourth Circuit rivals that of the Second Circuit.

The early cases offered little useful guidance. In the 1970 case of *Communications Satellite Corp. v. Comcet*,<sup>112</sup> the Fourth Circuit considered a mark—“comsat,” used for the plaintiff’s communications satellite services—that was a cross between a coined word and an abbreviation. Because the component “com” is associated with a variety of concepts (computers, community, communication), the court held that it was not uniquely associated with communications; accordingly, “comsat” was not descriptive.<sup>113</sup>

In *America Online, Inc. v. AT & T Corp.*,<sup>114</sup> an obtusely-reasoned 2001 decision, the Fourth Circuit held that “IM” (for “instant messaging”) was not generic, but was nonetheless not an enforceable mark. Finding substantial evidence of widespread generic use of the term “IM” to refer to instant messaging regardless of source, the court held that this evidence outweighed AOL’s conclusory assertions that the term was uniquely associated with its own messaging service.<sup>115</sup> While the district court explicitly held that both IM and “instant message” were generic,<sup>116</sup> the Fourth Circuit declined to hold that IM was generic, but held—without explanation—that IM was “unenforceable” as a mark.<sup>117</sup>

In 2004, a district court in the Fourth Circuit expressly rejected the *Modern Optics*<sup>118</sup> approach, holding in *U.S. Conference of Catholic Bishops v. Media Research Center*<sup>119</sup> that initials which stand for descriptive phrases are themselves inherently descriptive: “Initials for a descriptive phrase merely represent short forms of the words for which they stand and should receive the same degree of protection as those

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112. *Commc’ns Satellite Corp. v. Comcet, Inc.*, 429 F.2d 1245 (4th Cir. 1970).

113. *Id.* at 1248.

114. *Am. Online, Inc. v. AT & T Corp.*, 243 F.3d 812, 823 (4th Cir. 2001) (upholding district court’s conclusion that abbreviation “IM” for instant messaging lacked trademark significance because it was synonymous with the service itself), *cert. dismissed*, *Am. Online, Inc. v. AT&T*, 534 U.S. 946 (2001).

115. *Id.*

116. *Id.*

117. *Id.*

118. *Modern Optics, Inc. v. Univis Lens Co.*, 234 F.2d 504 (C.C.P.A. 1956).

119. *U.S. Conference of Catholic Bishops v. Media Research Ctr.*, 432 F. Supp. 2d 616 (E.D. Va. 2006).

words.”<sup>120</sup> Accordingly, the court held that “CNS” was descriptive simply because it stood for the descriptive phrase “Catholic News Service.”<sup>121</sup> When the plaintiff pointed out that the TTAB had found “CNS” to be inherently distinctive, the court observed:

[T]he TTAB, as it expressly acknowledged in its decision, was constrained to follow *Modern Optics* regardless of whether that case has received favorable treatment from other Courts of Appeals. In fact, courts in this Circuit have adopted the legal standard established in *Heileman* to determine whether trademarks consisting solely of initials qualify for protection under the Lanham Act. Even the case [*Am. Online, Inc. v. AT & T Corp.*] that Plaintiff cites as evidence that this Court relies upon the *Modern Optics* test for evaluating the protectability of initial marks in fact adopted the *Heileman* test and cited with approval other cases from the Seventh and Eleventh Circuits that did the same. As discussed above, since “Catholic News Service” is merely descriptive, the initials for that name are likewise merely descriptive and will receive protection only upon a showing of secondary meaning.<sup>122</sup>

Despite this attempt at a strong doctrinal pronouncement, no court in the Fourth Circuit (or elsewhere) has ever cited *Catholic Bishops* for this proposition.<sup>123</sup> Indeed, subsequent Fourth Circuit decisions reveal the circuit’s continuing confusion over the analytical framework for abbreviations. In its 2009 decision in *George & Co. v. Imagination Entertainment Ltd.*,<sup>124</sup> the Fourth Circuit appeared to follow the general path of *Catholic Bishops*,<sup>125</sup> assessing an abbreviation without regard to consumer perception. *George & Co.* involved the registered mark “LCR,” which stood for “LEFT CENTER RIGHT.”<sup>126</sup> In finding that the abbreviation was suggestive, the court of appeals reluctantly deferred to the judgment of the PTO and the district court only because the infringement defendant offered no evidence of descriptiveness to rebut the presumption of distinctiveness that arose from the PTO’s registration

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120. *Id.* at 623 (citing *G. Heileman Brewing Co., Inc. v. Anheuser-Busch Inc.*, 676 F. Supp. 1436, 1493 (E.D. Wis. 1987), *aff’d*, *G. Heileman Brewing Co., Inc. v. Anheuser-Busch, Inc.*, 873 F.2d 985 (7th Cir. 1989)).

121. *Id.*

122. *Id.* at 625 (citation omitted).

123. *Catholic Bishops* has been cited only once, and for a different proposition. See *Field of Screams, LLC v. Olney Boys & Girls Cmty. Sports Ass’n*, 2011 U.S. Dist. LEXIS 25634, at \*27 (D. Md. Mar. 14, 2011).

124. *George & Co. LLC v. Imagination Entm’t Ltd.*, 575 F.3d 383, 395 nn.11-12 (4th Cir. 2009).

125. *Catholic Bishops*, 432 F. Supp. 2d at 616.

126. *George & Co.*, 575 F.3d at 395 nn.11-12.

of the mark without evidence of secondary meaning.<sup>127</sup> However, the appellate court expressed doubt as to the correctness of their conclusions, noting that “LEFT CENTER RIGHT” is “a descriptive term” that describes “a generic dice game,” and that the PTO “has repeatedly found LEFT CENTER RIGHT descriptive.”<sup>128</sup> The court thus implied that LCR itself was either descriptive or generic, but it seemed to draw this conclusion simply from the nature of the underlying phrase, rather than considering how LCR was actually used or perceived by the relevant consumers.<sup>129</sup>

In contrast, another 2009 decision by the Fourth Circuit focused squarely on consumer perception, although the result was to find the abbreviation unprotectable—the same result that would have followed if the court had focused on the underlying expression. In *OBX-Stock, Inc. v. Bicast, Inc.*,<sup>130</sup> the court held that OBX, a registered trademark which the registrant had coined as an abbreviation for the Outer Banks of North Carolina, was perceived by consumers as synonymous with the Outer Banks, and not as a source indicator for any goods or services; thus, the abbreviation was geographically descriptive and lacked secondary meaning. Although the court declined to cancel the registrations,<sup>131</sup> it noted that its holding would prevent the mark from becoming incontestable. Apparently the registrant had initially been rebuffed in its efforts to register OBX. However, the PTO eventually bowed to political pressure from North Carolina’s congressional delegation and granted the registrations in violation of its own well-established standards.<sup>132</sup> The PTO’s obvious error of judgment no doubt explains the court’s willingness to overcome the presumption of validity that attaches to registered marks. It seems clear that the Fourth Circuit would have found the mark in this case invalid whether it focused on the abbreviation itself or on the underlying expression.

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127. *Id.*

128. *Id.* at 395 n.12.

129. *Id.*

130. *OBX-Stock, Inc. v. Bicast, Inc.*, 558 F.3d 334 (4th Cir. 2009).

131. This was partly on procedural grounds (i.e., the defendant failed to file a counterclaim for cancellation) and partly because, in the court’s view, the defendant’s “evidence d[id] not conclusively establish that every one of” the plaintiff’s registrations should be cancelled. *Id.* at 342-43.

132. *Id.* at 342.

## 5. First Circuit: Treating Abbreviations Independently

In the First Circuit, courts have analyzed the distinctiveness of abbreviations independently of the underlying expression. None of these opinions clearly articulates a presumption for or against trademark protection, or expressly addresses the respective burdens of proof of the parties advocating or opposing protection. The opinions are largely consistent with *Modern Optics*,<sup>133</sup> with some minor departures.

In *Grove Laboratories. v. Brewer & Co.*,<sup>134</sup> a decision predating *Modern Optics*,<sup>135</sup> *Breth*,<sup>136</sup> and *Martell*,<sup>137</sup> the First Circuit reversed its own conclusion as to the distinctiveness of a mark consisting of the initials "LBQ" (standing for "laxative bromo quinine") enclosed in a circle. In the initial hearing, the First Circuit held that the abbreviation was descriptive because the underlying phrase was descriptive, and because the underlying phrase appeared together with the abbreviation on the labels of medicine bottles.<sup>138</sup> In a subsequent review, however, the court concluded that its prior conclusion was erroneous, and that the mark was arbitrary or fanciful despite the descriptiveness of the underlying phrase:

The letters as thus arranged and embossed on the tablets are not in themselves descriptive of the ingredients which the tablets contain, but are arbitrary and fanciful. It is only when they are used on the labels in association with the words 'Laxative Bromo Quinine' that one is led to inquire whether they may or may not be descriptive. But being arbitrary and fanciful when adopted and embossed upon the tablets we think that they do not lose that character when printed on the label, enclosed in a circle.<sup>139</sup>

This analysis anticipates both *Modern Optics*<sup>140</sup> and the Second Circuit's *Blisscraft*<sup>141</sup> decision; the fact that the abbreviation was sometimes accompanied by the underlying descriptive phrase was relevant to the analysis, but it was not conclusive, serving only to prompt an "inquiry"

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133. *Modern Optics, Inc. v. Univis Lens Co.*, 234 F.2d 504 (C.C.P.A. 1956).

134. *Grove Labs. v. Brewer & Co.*, 103 F.2d 175 (1st Cir. 1939).

135. *Modern Optics*, 234 F.2d at 504.

136. *Breth v. Cutting Room Appliances Corp.*, 57 U.S.P.Q. (BNA) 46, 4 (Com'r Pat. & Trademarks Jan. 1, 1943).

137. *Martell & Co. v. Societe Anonyme De La Benedictine, Distillerie De La Liqueur De L'Ancienne Abbaye De Fecamp*, 116 F.2d 516 (C.C.P.A. 1941).

138. *Id.* at 178.

139. *Id.* at 179.

140. *Modern Optics*, 234 F.2d at 504.

141. See *supra* notes 33-38 and accompanying text.

into descriptiveness.<sup>142</sup> Although the court did not expressly articulate a presumption for or against trademark protection for abbreviations, it seems to have tacitly embraced a presumption in favor of such protection, rebuttable by proof of descriptiveness.<sup>143</sup>

More recently, the First Circuit was asked to decide whether the term “duck” was generic for a tour in an amphibious vehicle. The term “duck” is a colloquial term commonly substituted for the abbreviation DUKW, which refers to a class of World War II amphibious vehicles made by General Motors and first deployed by the U.S. military in 1942 (and pronounced the same as “duck”).<sup>144</sup> DUKW itself is not, strictly speaking, an acronym, but it is the abbreviation that was adopted (by the Army or GM, depending on the source) to identify this class of vehicles.<sup>145</sup> The “D” stands for 1942, “U” for utility, “K” for either front-wheel drive or 6-wheel drive or all-wheel drive, depending on the source, and “W” for two powered rear axles.<sup>146</sup> In *Boston Duck Tours, LP v. Super Duck Tours, LLC*,<sup>147</sup> the district court had concluded that “duck” was not generic for the service of offering tours in such vehicles, because the tours did not involve the creatures known as ducks. The First Circuit held that this was clear error.<sup>148</sup> Instead of analyzing whether the term “duck” was generic, the appellate court held that the district court should have analyzed the entire term “duck tours.”<sup>149</sup> Because the term “duck tours” was widely used generically to refer to tours utilizing these amphibious vehicles,<sup>150</sup> the phrase was generic.

In a discussion of abbreviations, this case is, to be sure, an “odd duck.” Both the district court and the appellate court focused on the meaning of the word “duck” rather than on the abbreviation for which it was a phonetically-identical substitute.<sup>151</sup> Yet both opinions are still consistent with the *Modern Optics*<sup>152</sup> approach. The average consumer was probably not even aware of the expression DUKW, much less the generic or description terms which it abbreviated. To the average consumer, a “duck” was a common water-bird; this meaning was

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142. *Id.*

143. *Id.*

144. See *DUKW*, WIKIPEDIA, <http://en.wikipedia.org/wiki/DUKW>.

145. *Id.*

146. *Id.*

147. 531 F.3d 1 (1st Cir. 2008).

148. *Id.* at 18.

149. *Id.* at 18-19.

150. *Id.* at 19-21.

151. *Id.* at 18-21.

152. *Modern Optics Inc. v. Univis Lens Co.*, 234 F.2d 504 (C.C.P.A. 1956).



reinforced by the logos and other graphics used by duck tour services, several of which featured cartoon-like ducks.<sup>153</sup> Thus, neither the consumers nor the courts equated the term with the generic expression from which it was derived.<sup>154</sup>

As in other circuits, the presumption of validity that attaches to registered marks has influenced decisions in the First Circuit regarding abbreviations for generic phrases.<sup>155</sup>

#### 6. D.C. Circuit: Rejecting *Modern Optics*

In a 1924 decision that appeared to anticipate the *Modern Optics*<sup>156</sup> approach, the D.C. Circuit held that the initials “MM” were descriptive specifically because they always appeared together with “malted milk” on the trademark owner’s product label, because this juxtaposition made clear to consumers what the initials stood for.<sup>157</sup>

In 1989, however, the Circuit implicitly rejected *Modern Optics*,<sup>158</sup> concluding in *Blinded Veterans Ass’n v. Blinded American Veterans Foundation*<sup>159</sup> that the initials “BVA” were generic simply because the phrase for which they stood (“Blinded Veterans Association”) was itself generic. The district court’s analysis of the marks, while brief, had assessed the distinctiveness of *both* marks, concluding that while both of them were descriptive, both had been used in a manner that gave rise to secondary meaning:

Plaintiff BVA has, from its inception, been known by no other name. It has employed its initials as a logo, on its official publication and elsewhere, for the same period. And it has continuously promoted

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153. *Boston Duck Tours*, 531 F.3d at 8.

154. A subsequent district court decision, *Operation Able of Greater Boston, Inc. v. National Able Network, Inc.*, 646 F. Supp. 2d 166 (D. Mass. 2009), also involved an acronym with a word-equivalent. The plaintiff’s unregistered mark, “ABLE,” stood for “Ability Based on Long Experience.” The court held that “ABLE” was both suggestive, *id.* at 171-72, and “at least moderately strong,” *id.* at 176, and this conclusion was not altered by the mark’s acronym status. The court did not analyze the distinctiveness of the underlying phrase. *Id.* at 172. If it had, it seems unlikely that the court would have held it to be descriptive or generic as to the plaintiff’s services (helping older workers find employment).

155. *E.g.*, *Diomed, Inc. v. Vascular Solutions, Inc.*, No. Civ.A.03-12498 RWZ, 2006 WL 516756 (D. Mass. Mar. 2, 2006) (although evidence was mixed as to whether doctors used “EVL” as a generic term for “endovenous laser therapy (or treatment),” as a registered mark the abbreviation was presumptively valid; also, defendant implicitly conceded it was valid even though the underlying term was generic).

156. *Modern Optics Inc. v. Univis Lens Co.*, 234 F.2d 504 (C.C.P.A. 1956).

157. *Horlick’s Malted Milk Co. v. Borden Co.*, 295 F. 232 (D.C. Cir. 1924).

158. *Modern Optics*, 234 F.2d at 504.

159. 872 F.2d 1035 (D.C. Cir. 1989).

itself, without hiatus, as the preeminent private voluntary proponent of the interests of blinded former U.S. service personnel, and its 'product,' i.e., the services it can render to and for them, for such a length of time, and at such effort and expense, that the Court concludes the name 'Blinded Veterans Association,' and the initials 'BVA,' have, indeed, acquired a secondary meaning for which BVA is entitled to protection against all competitors employing a name which is confusingly similar. The Court is reinforced in that conclusion by both the defendant's startling success in its maiden fundraising venture with no history of significant accomplishment, and by the tenacity with which it seeks to preserve its right to use the name it has chosen for itself.<sup>160</sup>

In rejecting this analysis, the D.C. Circuit explained its position in a brief and conclusory footnote, citing only the Seventh Circuit's decisions in *NCBE*<sup>161</sup> and *FS Services*<sup>162</sup>:

"We need not deal separately with the question whether the initials 'BVA' are generic; if the full name is generic, an abbreviation is treated similarly."<sup>163</sup> It is clear that the D.C. Circuit gave no serious thought to the question of whether and how abbreviations can achieve independent trademark status.<sup>164</sup>

## 7. Eleventh Circuit: Burdening the Trademark Proponent

As discussed below, district court decisions involving abbreviations in the Eleventh Circuit have been inconsistent and occasionally downright bizarre. However, a 2007 decision at the appellate level may have stabilized the law of the Circuit.

In one of the oddest district court decisions involving abbreviations, the Middle District of Florida held in *Anheuser-Busch, Inc. v. A-B Distributors, Inc.*<sup>165</sup> that Anheuser-Busch's "A-B" mark was descriptive. The *A-B* court relied in part on the reasoning of the Southern District of New York in *American Optical*, which held that initials are "letters in

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160. *Blinded Veterans Ass'n v. Blinded Am. Found.*, 680 F. Supp. 442, 445 (D.D.C. 1988), *vacated and remanded*, 872 F.2d 1035 (D.C. Cir. 1989).

161. *Nat'l Conference of Bar Exam'rs & Educ. Testing Serv. v. Multistate Legal Studies, Inc.*, 692 F.2d 478 (7th Cir. 1982).

162. *FS Servs., Inc. v. Custom Farm Servs., Inc.*, 471 F.2d 671 (7th Cir. 1972).

163. *Blinded Veterans*, 872 F.2d at 1041 n.12.

164. Despite its poverty of analysis, this part of the court's holding was cited with approval by the Fifth Circuit in *Society of Financial Examiners v. National Ass'n of Certified Fraud Examiners*, 41 F.3d 223, 226 n.5 (5th Cir. 1995), discussed in the text accompanying notes 248-53 *infra*.

165. 910 F. Supp. 587 (M.D. Fla. 1995).

the alphabet available for use by anyone.”<sup>166</sup> Although the Florida court also stated the reasonable proposition that initials are descriptive if they impart information directly,<sup>167</sup> it held that “A-B” was a descriptive mark even though it did *not* convey any information about the qualities of the product (beer) with which it was associated. The court reached this conclusion without ever considering whether the underlying phrase “Anheuser-Busch” was itself descriptive.<sup>168</sup> (It might be viewed as such, if consumers perceive both parts of the name as surnames; if not, it could be fanciful.). Under this “alphabet” approach, a court could treat initials as descriptive even if they abbreviated a fanciful or arbitrary mark.<sup>169</sup>

Three years later, however, the same district court addressed the memorable acronym “BEARS,” which stood for “British-European-American Racing Series.” The court held that the acronym’s distinctiveness should be examined separately from that of the underlying expression; based on evidence of consumer perception, “BEARS” was an arbitrary mark even though the underlying phrase was descriptive.<sup>170</sup> This decision, *American Historic Racing Motorcycle Ass’n, Ltd. v. Team Obsolete Promotions* (“AHRMA”),<sup>171</sup> was affirmed without opinion by the Eleventh Circuit in 2000.<sup>172</sup> The district court undertook a detailed analysis of the “BEARS” mark, and considered the leading precedents from the TTAB and CCPA as well as the Seventh and Eighth Circuits:

BEARS is an arbitrary mark rather than a descriptive mark for several reasons. On its face, BEARS does not convey the phrase, British-American-European Racing Series. Unlike an abbreviation such as MBE, which stands for Multistate Bar Examination, BEARS doubles for an animal and an abbreviation. Consequently, a consumer who sees BEARS in connection with motorcycle racing may associate the word with any number of things, and not immediately think that BEARS is an abbreviation. This is particularly true because, aside from the AHRMA rulebook and articles discussing BEARS, the

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166. *Id.* at 593.

167. *Id.* (citing *G. Heileman Brewing Co. v. Anheuser-Busch, Inc.*, 873 F.2d 985, 996-97 (7th Cir. 1989)).

168. *Id.*

169. *Id.*

170. *Am. Historic Racing Motorcycle Ass’n, LTD. v. Team Obsolete Promo.*, 33 F. Supp. 2d 1000, 1005 (M.D. Fla. 1998), *aff’d without reported opinion*, 233 F.3d 577 (11th Cir. 2000).

171. *Id.*

172. *Am. Historic Racing*, 233 F.3d 577.

promotional materials do not feature BEARS together with its underlying phrase.<sup>173</sup>

Finally, the evidence showed that motorcycle racing fans in fact perceived “BEARS” not as a generic motorcycle racing class but as a mark for the plaintiff’s entertainment services;<sup>174</sup> rather than treating this as evidence of secondary meaning (which would be essential to validity if the mark were descriptive), the court held that this evidence of consumer perception supported its conclusion that the “BEARS” mark was arbitrary.<sup>175</sup> Ironically, the district court in *AHRMA* cited the *A-B* case for the proposition that “[a]n abbreviation is treated similarly to its underlying phrase where the abbreviation imparts the original generic or descriptive connotation,”<sup>176</sup> a proposition that is neither supported nor articulated in the *A-B* decision.

Consumer perceptions in this case were clearly influenced by the fact that “BEARS” conjures up the image of an animal.<sup>177</sup> This strong association probably overwhelmed any consumer awareness that “BEARS” was an acronym at all, thus making it irrelevant whether the underlying phrase was descriptive or even generic. On the other hand, if the underlying phrase were very familiar to the relevant consumers, then arguably the mental association with bears and the mental association with the descriptive or generic meaning of the underlying phrase would co-exist—in the minds of different consumers or even within the mind of an individual consumer. In that case, it would be less clear that “BEARS” should be treated as an arbitrary mark. The situation would be analogous to other dual-purpose marks, such as those which have both functional and nonfunctional aspects,<sup>178</sup> or those which are perceived as generic by some consumers but not by others.<sup>179</sup> At the very least, *AHRMA* illustrates the same phenomenon seen in the *Blisscraft*<sup>180</sup> (“Poly Pitcher”) and *Merritt Forbes*<sup>181</sup> (“TOP’s”) opinions

173. *Am. Historic Racing*, 33 F. Supp. 2d at 1005.

174. *Id.*

175. *Id.*

176. *Id.* at 1004.

177. *Id.* at 1005.

178. *See, e.g., Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 203-04 (2d Cir. 1979) (noting that cheerleaders’ uniforms had both functional and nonfunctional features).

179. *See, e.g., King-Seeley Thermos Co. v. Aladdin Indus., Inc.*, 321 F.2d 577, 579-80 (2d Cir. 1963) (finding that substantial majority of public perceived “thermos” as generic, but minority still perceived it as a trademark).

180. *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 699-702 (2d Cir. 1961).

181. *Merritt Forbes & Co. Inc. v. Newman Inv. Sec., Inc.*, 604 F. Supp. 943 (S.D.N.Y. 1985).

from the Second Circuit and, to a lesser degree, the *Boston Duck Tours*<sup>182</sup> (“DUCK”) opinion from the First Circuit<sup>183</sup>—if the abbreviation constitutes (or at least conjures up) a word that does not *itself* describe the goods in question, then courts will treat the trademark status of the underlying expression as irrelevant.

The Eleventh Circuit finally addressed abbreviations at the appellate level in the 2007 case of *Welding Services, Inc. v. Forman*.<sup>184</sup> Its holding in this case supports independent analysis of the abbreviation and the underlying expression, and appears to strike a middle course between the *Modern Optics*<sup>185</sup> approach burdening the trademark opponent and the Seventh Circuit’s “heavy burden” on the trademark proponent.<sup>186</sup>

The abbreviation at issue in *Welding Services* was “WSI,” derived from “Welding Services, Inc.”<sup>187</sup> The Eleventh Circuit held that the phrase “welding services” was generic, and that the plaintiff had failed to establish the distinctiveness of “WSI.”<sup>188</sup> However, the court did *not* hold that “WSI” was generic.<sup>189</sup> Instead, the court articulated the following rule: “Abbreviations of generic words may become protectable if the party claiming protection for such an abbreviation shows that the abbreviation has a meaning distinct from the underlying words in the mind of the public.”<sup>190</sup>

The court also noted the Seventh Circuit’s admonition in *G. Heileman Brewing*<sup>191</sup> that the proponent of trademark protection for an abbreviation bears a “heavy burden” in demonstrating that the abbreviation has a meaning distinct from the underlying generic or descriptive phrase.<sup>192</sup> While the Eleventh Circuit did not expressly adopt or endorse this “heavy burden” rule, and its analysis does not appear to impose such a burden, its analysis does place the burden of proof on the trademark proponent, who must establish that the abbreviation conveys

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182. *Boston Duck Tours, LP v. Super Duck Tours, LLC*, 531 F.3d 1 (1st Cir. 2008).

183. *See also* *Operation Able of Greater Boston, Inc. v. Nat’l Able Network, Inc.*, 646 F. Supp. 2d 166 (D. Mass. 2009) (holding that “ABLE” was suggestive without even considering the underlying expression). *See supra* note 155.

184. 509 F.3d 1351 (11th Cir. 2007).

185. *Modern Optics, Inc. v. Univis Lens Co.*, 234 F.2d 504 (C.C.P.A. 1956).

186. *Welding Servs.*, 509 F.3d 1351.

187. *Id.* at 1355.

188. *Id.* at 1360.

189. *Id.* at 1359.

190. *Id.*

191. *G. Heileman Brewing Co., Inc. v. Anheuser-Busch, Inc.*, 873 F.2d 985 (7th Cir. 1989).

192. *Welding Servs.*, 509 F.3d at 1359.

to consumers a meaning distinct from its underlying expression.<sup>193</sup> This is the opposite of the *Modern Optics*<sup>194</sup> burden of proof.

In the decision below, the district court had found “WSI” protectable, based on the factors which have traditionally been considered as circumstantial evidence of secondary meaning: Welding Services had used the abbreviation since 1990, had spent significant amounts on advertising, and had generated significant revenues.<sup>195</sup> However, the Eleventh Circuit held that this circumstantial evidence of secondary meaning was insufficient to resolve the question whether “WSI” had a meaning distinct from the underlying generic phrase: “[T]he question of whether the abbreviation has a discrete meaning in the minds of the public from the generic words for which it stands requires a different kind of evidence.”<sup>196</sup> The court did not specify what this “different kind of evidence” might be.<sup>197</sup> It noted merely that “[t]he only evidence in the record relevant to this question shows Welding Services has not created a separate meaning for the abbreviation.”<sup>198</sup>

Welding Services presented only circumstantial evidence to establish that WSI had secondary meaning—length of use, advertising expenditures, and sales volume—and this evidence was derived from marketing materials in which the “WSI” abbreviation was *always displayed immediately next to* the words “Welding Services, Inc.”<sup>199</sup> In the Eleventh Circuit’s view, it was, therefore, likely that consumers gave the abbreviation the same meaning as the generic phrase that it accompanied. Welding Services failed to submit any evidence—consumer surveys or testimony, for example—demonstrating that consumers separately recognized “WSI” as a source indicator. By always displaying the abbreviation and the generic phrase jointly, Welding Services was, in effect, teaching consumers to see “WSI” as a generic term.

Under the *Welding Services* approach, if the expression underlying an abbreviation is generic or descriptive, then the circumstantial evidence which ordinarily helps to establish secondary meaning will be of little or no value unless the abbreviation is presented to the consumer

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193. *Id.* at 1359-60.

194. *Modern Optics, Inc. v. Univis Lens Co.*, 234 F.2d 504 (C.C.P.A. 1956).

195. *Welding Servs.*, 509 F.3d at 1360.

196. *Id.* at 1359.

197. *Id.* at 1360.

198. *Id.* at 1359.

199. *Id.* at 1360.

*separately* from the underlying expression.<sup>200</sup> Teaching the consumer to equate the two will be fatal to a claim that the abbreviation is distinctive. In contrast, under the Second Circuit's opinions in *Standard Brands* ("V-8")<sup>201</sup> and *Blisscraft* ("Poly Pitcher"),<sup>202</sup> marketing materials which taught consumers the underlying meaning of abbreviations did not undermine the distinctiveness of those abbreviations.

While the appellate court held that Welding Services had failed to show that "WSI" was protectable, it stopped short of holding that the abbreviation was generic.<sup>203</sup> Thus, it did not adopt the Seventh Circuit's rebuttable presumption that abbreviations for generic terms are themselves generic. Although the Eleventh Circuit did not expressly state that it was imposing the "heavy burden" of proof which was applied in *G. Heileman Brewing*,<sup>204</sup> it did require WSI to provide secondary meaning evidence that was specific to the "WSI" abbreviation.<sup>205</sup> To satisfy the court, WSI could have supplied direct evidence of consumer perceptions, such as consumer surveys or direct consumer testimony.

The Eleventh Circuit did not consider the possibility that "WSI" was inherently distinctive by virtue of being arbitrary, fanciful, or suggestive; there is no indication that Welding Services even raised the issue of inherent distinctiveness.

More recently in 2009, a district court in Florida interpreted *Welding Services*<sup>206</sup> as adopting the Seventh Circuit's "heavy burden" of proof. In *Knights Armament Co. v. Optical Systems Technology, Inc.*,<sup>207</sup> the Middle District of Florida held that "UNS" lacked a meaning distinct from the descriptive phrase "universal night sight." Citing *Welding Services*,<sup>208</sup> *G. Heileman Brewing*,<sup>209</sup> and *AHRMA* (the "BEARS"

200. This problem has also afflicted sound marks that are an intrinsic feature of the product or service being advertised, such as alarm sounds and ringtones. *E.g., In re Vertex Group LLC*, 89 U.S.P.Q.2d (BNA) 1694 (T.T.A.B. 2009); *Nextel Commc'n, Inc. v. Motorola, Inc.*, 91 U.S.P.Q.2d (BNA) 1393 (T.T.A.B. 2009).

201. *Standard Brands, Inc. v. Smidler*, 151 F.2d 34 (2d Cir. 1945).

202. *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 699-702 (2d Cir. 1961).

203. Ultimately, the Eleventh Circuit found it unnecessary to decide whether WSI's stylized logo was so lacking in distinction to warrant summary judgment for the defendant on this issue alone, because it also found that WSI presented insufficient evidence of a likelihood of confusion between the parties' marks.

204. *G. Heileman Brewing Co., Inc. v. Anheuser-Busch, Inc.*, 873 F.2d 985 (7th Cir. 1989).

205. *Welding Servs., Inc. v. Forman*, 509 F.3d 1351, 1360 (11th Cir. 2007).

206. *Id.* at 1351.

207. 647 F. Supp. 2d 1321 (M.D. Fla. 2009).

208. *Welding Servs.*, 509 F.3d at 1351.

209. *G. Heileman Brewing Co., Inc.*, 873 F.2d 985.

case),<sup>210</sup> the court stated that “[t]he party claiming protection has a ‘heavy burden’ to show an independent meaning for an abbreviation of a descriptive phrase.”<sup>211</sup>

### 8. Ninth Circuit: A North/South Divide?

Considering the volume and nature of its trademark-related caseload, the Ninth Circuit’s case law on abbreviation marks is surprisingly sparse. The appellate opinions are unreported or unpublished. The district court decisions are few, and their reasoning is underdeveloped. The only theme that emerges from these opinions is that, in California, abbreviations are more likely to be protected by courts in the Northern District.

In 1982, the Ninth Circuit upheld a decision treating initials as inherently descriptive in *CPP Insurance Agency, Inc. v. General Motors Corp.*<sup>212</sup> In a decision that was affirmed without a reported opinion, the Central District of California held that “CPP,” which stood for the descriptive phrase “consumer protection plan,” was “by its very nature descriptive”<sup>213</sup>: “Initials, *especially when they are initials derived from a corporate name*, are descriptive and are entitled to protection only if they have acquired a secondary meaning.”<sup>214</sup> The court offered no explanation for this bizarre holding.<sup>215</sup> Unlike the district courts in the Second Circuit, the California court did not rely on the public domain status of the alphabet. Nor did it explain the reasoning behind its counterintuitive conclusion that descriptiveness was “especially” inherent in initials derived from corporate names.<sup>216</sup>

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210. *Am. Historic Racing Motorcycle Ass’n, Ltd. v. Team Obsolete Promo.*, 33 F. Supp. 2d 1000 (M.D. Fla. 1998), *aff’d without reported opinion*, 233 F.3d 577 (11th Cir. 2000).

211. *Knights Armament Co.*, 647 F. Supp. 2d at 1331.

212. 212 U.S.P.Q. 257 (C.D. Cal. 1980), *aff’d without opinion*, 676 F.2d 709 (9th Cir. 1982).

213. *Id.* at 259.

214. *Id.* at 260 (emphasis added).

215. *Id.*

216. Two subsequent opinions from the Central District conclude, after cursory analyses, that the abbreviations in question lacked distinctiveness, but the trademark proponent in each case presented a weak argument. In *Aminolabs, Inc. v. Natural Organics, Inc.*, 228 U.S.P.Q. (BNA) 783 (C.D. Cal. 1985), *aff’d without opinion*, 825 F.2d 413 (9th Cir. 1987), the Central District held that “DLPA” was generic for a food supplement consisting of D- and L-phenylalanine, because it was known in the scientific literature by that abbreviation and the plaintiff did not seem to have advertised its product, thus making it unlikely that consumers could develop any perceptions as to the mark. In *Ford Motor Co. v. Ultra Coachbuilders, Inc.*, 57 U.S.P.Q.2d (BNA) 1356 (C.D. Cal. 2000), *aff’d*, 238 F.3d 428 (9th Cir. 2000) (unpub. mem. opinion), the court held that the unregistered abbreviation “QVM” was descriptive merely because it stood for the descriptive phrase “quality vehicle modifier.” Because the underlying phrase was a “self-laudatory term” describing a characteristic of Ford’s limousine conversion program, the court assumed that this was equally true



More recently, the Central District held that the “DMS” component of “TrackerDMS” (an unregistered mark) was descriptive simply because “DMS” stood for the descriptive phrase “Dealer Management Software.”<sup>217</sup> In making this conclusory determination, the court did not discuss any evidence of consumer perceptions.<sup>218</sup>

In contrast, a 2009 decision from the Northern District of California, *Vertos Medical, Inc. v. Globus Medical, Inc.*,<sup>219</sup> held that “MILD,” which stood for the generic phrase “minimally invasive lumbar decompression,” was an arbitrary mark.<sup>220</sup> The court reached this conclusion despite the fact that at least some of the plaintiff’s marketing materials explained the acronym’s derivation, and thus arguably “taught” consumers to equate the acronym with the underlying generic phrase.<sup>221</sup> “MILD” was a registered mark, and the court found that the defendant’s evidence of genericness was simply insufficient to rebut the presumption of validity.<sup>222</sup> In assessing the strength of the mark, the court focused entirely on the acronym, disregarding the underlying phrase.<sup>223</sup> Because “MILD” neither described nor suggested “anything to do with spinal surgery,” the court held that it was arbitrary and “moderately strong.”<sup>224</sup> Reflecting the same phenomenon seen in the *Blisscraft*,<sup>225</sup> *Merritt Forbes*,<sup>226</sup> and *AHRMA*<sup>227</sup> cases, the fact that the acronym resembled an actual word which did *not* describe the product or service may have displaced the underlying generic phrase from the consumer’s mind.<sup>228</sup> However, nothing in the *Vertos* opinion indicates that the court consciously considered this factor.<sup>229</sup>

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of the abbreviation. In this case, the court had no reason to delve deeper into the analysis; the plaintiff presented a particularly weak case, offering no evidence that the mark had ever been used as a source indicator.

217. *Finance Express LLC v. Nowcom Corp.*, 564 F. Supp. 2d 1160, 1170 (C.D. Cal. 2008).

218. *Id.*

219. 2009 WL 3740709 (N.D. Cal. Nov. 6, 2009).

220. *Id.* at \*5.

221. *Id.* at \*3.

222. *Id.*

223. *Id.* at \*5.

224. *Id.*

225. *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 699-702 (2d Cir. 1961).

226. *Merritt Forbes & Co., Inc. v. Newman Inv. Sec., Inc.*, 604 F. Supp. 943 (S.D.N.Y. 1985).

227. *Am. Historic Racing Motorcycles Ass’n v. Team Obsolete Promo.*, 33 F. Supp. 2d 1000 (M.D. Fla. 1998), *aff’d without reported opinion*, *Am. Historic v. Team Obsolete*, 233 F.3d 577 (11th Cir. 2000).

228. *Vertos Medical, Inc. v. Globus Med., Inc.*, No. C 09-1411 PJH, 2009 WL 3740709 (N.D. Cal. Nov. 6, 2009).

229. *Id.*

In *China International Travel Service, Inc. v. China & Asia Travel Service, Inc.*,<sup>230</sup> the Northern District held that “CITS,” an unregistered abbreviation for “China International Travel Services,” was either arbitrary or suggestive. It gave three reasons: (1) “Acronyms of full business names are commonly protected as trademarks,” (2) the defendant had “acknowledged” the inherent distinctiveness of “CITS” by filing its own trademark registrations for similar marks, and (3) the “plaintiff ha[d] made long, prominent use” of the mark.<sup>231</sup> The court did not discuss whether the underlying phrase was descriptive, whether the plaintiff’s marketing materials presented the abbreviation separately from the underlying phrase, or how consumers actually perceived the abbreviation.<sup>232</sup>

In 2011, the Northern District rejected Apple’s attempt to enjoin Amazon from using the term “App Store,” without even noting that “App” is an abbreviation for the generic term “application.”<sup>233</sup> While Apple argued that “App Store” is suggestive,<sup>234</sup> and Amazon argued that the phrase is generic,<sup>235</sup> the court rejected both characterizations, treating the phrase as descriptive.<sup>236</sup> Some abbreviations, it seems, transcend their status as abbreviations and enter the lexicon, thus becoming subject to the same analysis as traditional word marks.

As in other circuits, the presumption of validity that applies to federally registered abbreviations has generally led the district courts in the Ninth Circuit to uphold such marks, notwithstanding the descriptiveness of the underlying phrases.<sup>237</sup> Therefore, if Apple succeeds in its effort to obtain a federal service mark registration for “App Store,”<sup>238</sup> a court will be even more likely to ignore the origin of “App” as an abbreviation of a generic term.

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230. No. 08–cv–01293 JSW (MEJ), 2008 WL 5480840 (N.D. Cal. Dec. 18, 2008).

231. *Id.* at \*6-7.

232. *Id.*

233. *Apple, Inc. v. Amazon.com, Inc.*, No. C 11-1327 PJH, 2011 WL 2638191 (N.D. Cal. July 6, 2011).

234. *Id.* at \*2-3.

235. *Id.* at \*5.

236. *Id.* at \*7.

237. *Ricks v. BMEzine.com, LLC*, No. 2:08-CV-01174-PMP-GWF, 2010 WL 2985795 (D. Nev. July 26, 2010) (upholding registered mark “BME” for “body modification ezine” because defendant failed to prove that consumers perceived it simply as shorthand for a generic expression); *Vertos Med., Inc. v. Globus Med., Inc.*, No. C 09-1411 PJH, 2009 WL 3740709 (N.D. Cal. Nov. 6, 2009) (finding insufficient evidence to rebut presumption of validity for registered mark MILD, even though it stood for descriptive phrase “mildly invasive lumbar decompression”).

238. U.S. Trademark Application Serial No. 77525433 (filed July 17, 2008). Microsoft is opposing the registration, on the ground that “App Store” is generic. U.S. Trademark Opposition Serial No. 91195582 (filed July 6, 2010).

### 9. Fifth Circuit: Possible Rejection of *Modern Optics*

Like the Ninth Circuit, the Fifth Circuit offers little jurisprudence on the trademark analysis of abbreviations. Courts at both the district and appellate levels have addressed the trademark status of the American Automobile Association's registered and incontestable "AAA" mark without ever considering whether consumers perceived it as the equivalent of the underlying phrase. A 1985 district court decision held that the mark was arbitrary,<sup>239</sup> and in an unrelated 1991 decision<sup>240</sup> the Fifth Circuit reached the same conclusion with little analysis. The 1991 case was poorly argued on the defendant's side,<sup>241</sup> which may explain the appellate court's complete failure to consider whether consumers perceived "AAA" as an abbreviation for the name of the automobile club or simply as a self-laudatory term (i.e., descriptive),<sup>242</sup> or whether the name of the automobile club was itself descriptive or generic. Skirting these issues, the Fifth Circuit simply stated that "AAA" was not generic because it "is not a class of services, but instead identifies the source of those services."<sup>243</sup> While both opinions, in effect, evaluated "AAA" independently of the underlying expression, which would be consistent with *Modern Optics*,<sup>244</sup> they are such weak precedents that they cannot be seen as reliable indicators of the prevailing law in this Circuit.<sup>245</sup>

Moreover, a later opinion from the Fifth Circuit could be read as rejecting *Modern Optics*.<sup>246</sup> In *Society of Financial Examiners v. Nat'l Ass'n of Certified Fraud Examiners*,<sup>247</sup> the court addressed an infringement claim involving the federally registered "CFE" designation, used by one party to signify "Certified Financial Examiner" and by another to signify "Certified Fraud Examiner." The court held that material facts needed to be resolved in order to determine whether

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239. *American Automobile Ass'n (Inc.) v. AAA Insurance Agency, Inc.*, 618 F. Supp. 787 (W.D. Tex. 1985), held that AAA was arbitrary in connection with insurance services, because it was neither suggestive nor descriptive of those services, nor a generic term for such services. At no point did the court consider the distinctiveness of the underlying phrase, American Automobile Association, or whether consumers perceived AAA as the equivalent of that phrase.

240. *Am. Auto. Ass'n v. AAA Legal Clinic*, 930 F.2d 1117 (5th Cir. 1991).

241. Sadly, the appellee's brief speaks for itself. See Brief for Appellee, *Am. Auto. Ass'n v. AAA Legal Clinic*, 930 F.2d 1117 (5th Cir. 1991) (No. 90-8233), 1990 WL 10083387.

242. Self-laudatory terms are generally treated as descriptive. See *Platinum Home Mortg. Corp. v. Platinum Fin. Grp., Inc.*, 149 F.3d 722, 728 (7th Cir. 1998).

243. *Am. Auto. Ass'n*, 930 F.2d at 1121.

244. *Modern Optics, Inc. v. Univis Lens Co.*, 234 F.2d 504 (C.C.P.A. 1956).

245. See *supra* notes 241-43.

246. *Modern Optics, Inc.*, 234 F.2d at 504.

247. 41 F.3d 223 (5th Cir.), *cert. denied*, 515 U.S. 1103 (1995).

“CFE” was perceived as a source indicator or as a designation of a person’s professional qualifications (in which case, the court noted, it would be generic).<sup>248</sup> The appellate court did not reach its own conclusion as to the distinctiveness of the designation, but quoted cryptically from *Blinded Veterans Ass’n*, the D.C. Circuit’s 1989 opinion rejecting *Modern Optics*<sup>249</sup>: “We need not deal separately with the question whether the initials [“CFE”] are generic; if the full name is generic, an abbreviation is treated similarly.”<sup>250</sup> While the court did not expressly offer an opinion on the appropriateness of this rule, the citation certainly implies approval.<sup>251</sup> Also noteworthy is the court’s willingness to question the distinctiveness of a federally registered service mark, despite the statutory presumption of validity; the court seemed doubtful of the mark’s ability to indicate source, although it acknowledged that the possibility was “not inconceivable.”<sup>252</sup>

#### 10. Tenth Circuit: Leaning Toward *Blinded Veterans*?

A district court in the Tenth Circuit recently adopted the rule of *Blinded Veterans Ass’n*,<sup>253</sup> holding in *Triple-I Corp. v. Hudson Associate Consulting, Inc.* that “Certified Knowledge Manager (CKM)”—a designation combining an abbreviation and its underlying expression—was generic.<sup>254</sup> Although the mark was registered in Kansas, the USPTO had refused registration on the ground that it was merely descriptive.<sup>255</sup> While the dispute concerned the combination mark in its totality, the court nonetheless cited the rule from the D.C. Circuit’s *Blinded Veterans* decision as its basis for finding that the “CKM” portion of the mark was generic.<sup>256</sup>

In contrast, the same court in the related case of *Hudson Associates Consulting, Inc. v. Weidner*<sup>257</sup> upheld the federally registered “CKL” mark (standing for “certified knowledge leader”). The federal registration covered the combination mark “Certified Knowledge Leader CKL,” but the PTO required the registrant to disclaim the underlying

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248. *Id.* at 225.

249. *Modern Optics, Inc.*, 234 F.2d at 504.

250. *Soc’y of Fin. Exam’rs*, 41 F.3d at 226 n.5 (quoting *Blinded Veterans Ass’n v. Blinded Am. Veterans Found.*, 872 F.2d 1035, 1041 n.12 (D.C. Cir. 1989)).

251. *Id.*

252. *Id.* at 227.

253. *Blinded Veterans Ass’n*, 872 F.2d at 1035.

254. *Triple-I Corp. v. Hudson Assocs. Consulting, Inc.*, 713 F. Supp. 2d 1267 (D. Kan. 2010).

255. *Id.* at 1278.

256. *Id.* at 1284-85 & n.49 (citing *Blinded Veterans Ass’n*, 872 F.2d 1035 at 1041 n.12).

257. No. 06-2461-EFM, 2010 WL 1946414 (D. Kan. May 14, 2010).

phrase on the ground that it was merely descriptive;<sup>258</sup> thus, the PTO apparently considered “CKL” to be distinctive even though the underlying expression was not (and apparently later permitted registration of “CKL” on its own<sup>259</sup>). While the defendant presented some evidence of genericness, the court found this insufficient to overcome the presumption of validity that attaches to registered marks.<sup>260</sup>

### 11. Sixth Circuit: Too Soon to Tell

In the Sixth Circuit, the distinctiveness of abbreviation marks has received little attention. Only a single unpublished district court opinion addresses the issue, but its approach is consistent with *Modern Optics*.<sup>261</sup> In *Upjohn Co. v. American Home Products Corp.*,<sup>262</sup> the owner of the registered trademark “PROVERA,” a drug containing progesterone (the naturally occurring progestin), alleged that its mark was infringed by the defendant’s “PREMPRO” mark, because of the “PRO” component of both marks. Because “PRO” could be understood as indicating the presence of progestin in each product, the court considered the possibility that consumers would perceive “PRO” as generic.<sup>263</sup> In this case, of course, “PRO” functioned both as an abbreviation and as a prefix/suffix. Rather than automatically equating the abbreviation with the underlying expression, the court evaluated the distinctiveness of the abbreviation itself.<sup>264</sup> Citing *Modern Optics* and other PTO precedents with approval, the court wrote:

Where dictionaries do not define a good by the contraction or abbreviation, where there is no history of use of the contraction by consumers, where few other trademarks for the good employ the contraction, where the term is incongruous to the good, or where the term does not give tolerably distinct knowledge of the good to a reasonably informed consumer, the contraction or abbreviation is not generic or descriptive. Ultimately, these factors get at the question:

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258. *Id.* at \*11.

259. *Id.* at \*12 n.90.

260. *Id.* at \*12.

261. *Modern Optics, Inc. v. Univis Lens Co.*, 234 F.2d 504 (C.C.P.A. 1956).

262. No. 1:95CV237, 1996 WL 33322175 (W.D. Mich. Apr. 5, 1996) (unpub.).

263. *Id.* at \*3-\*4.

264. “An abbreviation of a generic name which still conveys to the buyer the original generic connotation of the abbreviated name, is still ‘generic’. . . . However, if the abbreviation is not recognizable as the original generic term, then the abbreviation is like a fanciful mark and protectable.” *Id.* at \*6 (quoting J. THOMAS MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 12.12[1]).

what does the mark mean to the reasonably informed consumer? The Court assumes that the reasonably informed consumer has seen relevant promotional material.

Here, no dictionary defines the term “pro-” as denoting progestin. Nor is there a history among consumers of employing “pro-” as a short form for progestin. This kind of evidence has been considered *prima facie* proof of suggestiveness.

Indeed, “pro-” is so contracted a form of the name progestin that it is another word entirely. The dictionary definitions for “pro-,” although not necessarily creatively incongruous, support a finding of suggestiveness. . . . Such multiple meanings are more in keeping with a source indicating term than a descriptive or identifying term. Some exercise of the imagination is required to derive progestin from “pro-.”

. . . There is no evidence indicating “pro-” has fallen into any lexicon as equivalent to, or directly descriptive of, progestin.<sup>265</sup>

## 12. Third Circuit: No Cohesive Approach

The Third Circuit’s jurisprudence on abbreviations is limited to district court opinions and does not offer anything resembling a cohesive approach. In a 1976 decision affirmed without opinion by the Third Circuit, the Delaware district court in *Kampgrounds of America, Inc. v. North Delaware A-OK Campground, Inc.*,<sup>266</sup> treated the “KOA” mark, derived from “Kampgrounds of America,” as arbitrary or fanciful: “Certainly KOA alone is not a ‘meaningful word in common usage’; nor does it describe the services being offered.”<sup>267</sup> Because the KOA mark was often displayed independently of the underlying phrase, the court held that the weakness and descriptiveness of that phrase did not affect the trademark status of the KOA mark.<sup>268</sup> Consistent with this approach, a federal district court in Pennsylvania held in 2004 that the acronym “CNB,” standing for “County National Bank,” had acquired sufficient

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265. *Id.* at \*6-8 (citing *Modern Optics*, 234 F.2d at 506; McCarthy, *supra*, §§ 11.06[3], 12.12[1]) (additional citations omitted).

266. 415 F. Supp. 1288 (D. Del. 1976), *aff’d without op.*, 556 F.2d 566 (3d Cir. 1977).

267. *Id.* at 1292 (citation omitted). The court recognized that koa is also a type of tree found in Hawaii, but found that consumers of campground services would be unlikely to make this association. *Id.* at 1292 n.7.

268. *Id.* at 1291-92.

secondary meaning to be a trademark, even if the underlying phrase was generic.<sup>269</sup>

More confusing, however, is *AFP Imaging Corp. v. Photo-Therm, Inc.*,<sup>270</sup> a 1989 opinion in which the New Jersey district court held that the registered mark "AFP," as applied to automatic film processing equipment made by plaintiff AFP Imaging, was not generic. Although it appears clear that the abbreviation was derived from the phrase "automatic film processor (or processing)," the opinion does not mention the provenance of the abbreviation, and it is possible that no evidence was presented on that point.<sup>271</sup> Because the mark was registered, the burden was on the defendant to present evidence of genericness; however, the defendant's argument seems to have been based solely on the fact that the *defendant* was using the term in a generic sense.<sup>272</sup> Rather than deciding the case based on the burden of proof, the court based its conclusion on the inscrutable observation that the plaintiff "use[d] the designation AFP to identify that the product in question is made by AFP imaging [sic]."<sup>273</sup> The court did not even consider the question of how the "AFP" designation was perceived by the relevant consumers, which would have been the crucial inquiry under *Modern Optics*.<sup>274</sup>

### III. CONCLUDING OBSERVATIONS

One early trademark authority observed:

Corporate names or parts of these names when used to designate goods or business houses, or as trade "nicknames" are trade names pure and simple, in most instances, and can be protected as such. The commercial nickname, or abbreviated name, is often more valuable, far better known, and more carefully guarded from use by rivals than the formal or full name from which it is taken. . . . One hears or sees the full corporate name used seldom in comparison to the number of times the nickname is used.<sup>275</sup>

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269. *CNB Fin. Corp. v. CNB Cmty. Bank (IO)*, No. Civ.A. 03-6945(PBT), 2004 WL 2434878, at \*7 (E.D. Pa. Sept. 30, 2004) (unpub.).

270. *AFP Imaging Corp. v. Photo-Therm, Inc.*, 12 U.S.P.Q.2d (BNA) 1534 (D.N.J. 1989).

271. *Id.*

272. *Id.* at \*1536.

273. *Id.* at \*1537.

274. *Modern Optics, Inc. v. Univis Lens Co.*, 234 F.2d 504 (C.C.P.A. 1956).

275. *Great Atl. & Pac. Tea Co. v. A & P Radio Stores*, 20 F. Supp. 703, 705-06 (E.D. Pa. 1937) (quoting HARRY DWIGHT NIMS, *NIMS ON UNFAIR COMPETITION AND TRADE-MARKS* 246, 170 (3d ed. 1929)). On trademark protection for consumer-coined nicknames, see Peter M. Brody, *What's*

Whatever the truth of this observation as a matter of branding and marketing strategy, it is clear that the validity or strength of abbreviations as trademarks is uncertain when the underlying expression (be it a corporate name or some other unit of information) does not itself qualify for trademark protection, or does so only weakly. While it would be desirable for a uniform rule to emerge from the current array of competing approaches, such a result is unlikely in the near future. The application of federal trademark law should in theory be consistent across the circuits. When it comes to the trademark status of abbreviations, however, disharmony is the order of the day.

Nonetheless, a few observations emerge from surveying the current landscape of decisional law.

First, the PTO and CCPA approaches, as exemplified by *Modern Optics*,<sup>276</sup> are much more favorable to the trademark proponent than the approaches that have developed in several circuits, most notably the Seventh Circuit, with its “heavy burden” on the party seeking to establish the distinctiveness of an abbreviation, and the D.C. Circuit, with its *per se* rule that abbreviations of generic terms are necessarily generic themselves. Thus, in many cases it will be easier to obtain federal registration for an abbreviation mark than to invoke protection under common law or under section 43(a) of the Lanham Act<sup>277</sup> in the context of an infringement proceeding. This is ironic, because many marks that are protectable under section 43(a) or common law are barred from federal registration.<sup>278</sup>

Second, despite the skepticism with which abbreviation marks are viewed in some of the circuits, most courts are reluctant to hold that a challenger’s evidence of genericism or lack of secondary meaning is sufficient to overcome the presumption of validity that attaches to federally registered marks.<sup>279</sup> This is another reason why trademark owners should seek federal registration of their abbreviation marks. No

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*in a Nickname? Or Can Public Use Create Private Rights?*, 95 TRADEMARK REP. 1123, 1125 (2005).

276. *Modern Optics, Inc.*, 234 F.2d 504.

277. 15 U.S.C. § 1125(a).

278. Examples include: (1) personal names of celebrities, entertainers, and sportspeople, (2) marks that are deemed immoral, scandalous or disparaging, and (3) titles of individual literary, dramatic, or musical works. See also James E. Harper, *Single Literary Titles and Federal Trademark Protection: The Anomaly Between the USPTO and Case Law Precedents*, 45 IDEA 77 (2004). See generally 15 U.S.C. § 1052.

279. 15 U.S.C. §§ 1057(b), 1115(a). There are, of course, exceptions. See *supra* text accompanying note 254.



such presumption attaches to unregistered abbreviations,<sup>280</sup> thus placing them at the mercy of each federal court's individual philosophy. It remains to be seen, however, whether the statutory presumption of validity will be weaker in jurisdictions such as the Seventh Circuit, which places an especially "heavy burden" on the proponent of a mark that abbreviates a generic or merely descriptive phrase. And even if a court rules that the presumption of validity has not been overcome, the court could still hold, in a likelihood of confusion analysis, that the abbreviation is a weak mark because of its generic or descriptive associations.

Third, in at least some federal courts, abbreviations of generic or descriptive phrases seem to have a greater chance of achieving protection if the abbreviation is an acronym that resembles a word and thereby conveys a dictionary meaning unrelated to that of the underlying phrase—for example, "Poly," "BEARS," "TOP's," "MILD," and "ABLE"—as opposed to a mere initialism, like "WSI."<sup>281</sup> The resemblance to an unrelated word allows consumers to perceive the acronym as an arbitrary mark, and this may tend to displace the competing mental association that otherwise connects the acronym to the underlying generic or descriptive phrase (what the Seventh Circuit called the "natural assumption that initials do generally stand for something"<sup>282</sup>). This will not be helpful, of course, in those instances—e.g., "duck," for amphibious motor vehicles—where the seemingly arbitrary word has itself suffered genericide, becoming synonymous with the goods or services.

Finally, in at least some circuits (e.g., the Seventh and Eleventh), the validity of an abbreviation mark for an underlying generic or

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280. See *Utah Lighthouse Ministry v. Found. for Apologetic Info. & Research*, 527 F.3d 1045, 1051 (10th Cir. 2008).

281. The case of the "BADASS" trademark arguably presents an exception, although that particular acronym has never been challenged as generic or descriptive. Instead, the ordinary meaning of the term led the trademark examiner to refuse registration on the grounds that the mark was "scandalous or immoral" under 15 U.S.C. § 1052(a). The T.T.A.B. reversed, largely because the term was an acronym for "Bettencourt Acoustically Designed Audio Sound Systems." *In re Leo Quan, Inc.*, 200 U.S.P.Q. (BNA) 370 (T.T.A.B. 1978); see Llewellyn Joseph Gibbons, *Semiotics of the Scandalous and the Immoral and the Disparaging: Section 2(a) of Trademark Law after Lawrence v. Texas*, 9 MARQ. INTELL. PROP. L. REV. 187, 207-08 (2005); Regan Smith, *Trademark Law and Free Speech: Protection for Scandalous and Disparaging Marks*, 42 HARV. C.R.-C.L. L. REV. 451, 461 (2007). However, the Board did not even inquire whether consumers encountering the mark would actually recognize it as an acronym. The Board also stated that the term was "susceptible to a wholly innocent pronunciation," without specifying what that pronunciation was, and without citing any evidence that consumers actually used the "innocent" pronunciation.

282. *G. Heileman Brewing Co., Inc. v. Anheuser-Busch, Inc.*, 873 F.2d 985, 993 (7th Cir. 1989).

descriptive expression will be imperiled to the extent that the labeling and marketing materials for the goods or services juxtapose the mark with the generic or descriptive content to which it corresponds. This has the opposite effect of selecting an acronym that conjures up an arbitrary word; instead of displacing the mark's generic or descriptive associations, this juxtaposition will tend to reinforce those associations, by "teaching" consumers that the abbreviation is not a source indicator but an indicator of content. As illustrated by the Eleventh Circuit's decision in *Welding Services*,<sup>283</sup> where the trademark proponent relies on circumstantial evidence of secondary meaning to validate the mark, this failure to distinguish the abbreviation from the underlying generic or descriptive content can negate the impact of otherwise-persuasive evidence

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283. *Welding Servs., Inc. v. Forman*, 509 F.3d 1351, 1360 (11th Cir. 2007).

