

SNKRS held registrable for Nike's footwear-related services

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Legal updates: case law analysis and intelligence

- Nike was initially refused registration for SNKRS on the grounds of descriptiveness, including in Class 25
- Nike deleted the Class 25 classification and moved goods that had been approved for acquired distinctiveness to a separate application
- The TTAB approved the remaining application covering only footwear services, following cases holding that a “mixed record” on public opinion fails to prove genericness

In a precedential decision in *In re Nike Inc* (TTAB 28 July 2023), the Trademark Trial and Appeal Board (TTAB) has reversed a refusal to register SNKRS for use in certain Class 35 and 41 services relating to footwear, including “retail store services featuring clothing and footwear”.

Background

Registration was initially refused for SNKRS on the grounds that it was merely descriptive of a longer identification of goods and services, including Class 25 clothing.

Nike responded with a claim of acquired distinctiveness, which the USPTO accepted in relation to some of the goods and services and rejected in relation to Class 25 clothing items and footwear services.

Nike deleted the Class 25 clothing goods and divided the approved goods into a separate application, leaving only the footwear services as the subject of a final refusal that SNKRS was generic of these services or, in the alternative, that Nike had not demonstrated acquired distinctiveness.

Nike appealed to the TTAB, which reversed the decision on both grounds.

Decision

Starting with the rule that a generic term is unregistrable and can never acquire distinctiveness, the board applied the test for determining genericness – namely, “what is the genus of goods... at issue?” and “is the term sought to be registered... understood by the relevant public primarily to refer to that genus...?”

Any “competent source” may be used to determine the public’s understanding of the term, with the board listing as examples:

- consumer surveys;
- dictionary definitions;
- trade journals entries;
- newspaper articles; and
- other publications.

According to the decision, if the evidence “constitutes a mixed use of a term as both the generic name of the goods or services and as a source indicator for such goods or services, then such evidence would not demonstrate that the primary significance of the term is the generic name of the goods or services”.

The board found that the genus at issue essentially was the footwear services. To determine whether the public understood SNKRS to refer to these services, the board analysed the evidence of record. The USPTO submitted dictionary definitions and articles referring to “sneaker stores”, as well as Nike’s own use of SNKRS to refer to sneaker-related goods or services and third-party website evidence showing SNKRS used as an abbreviation of ‘sneakers’. To show that the public understood SNKRS as a source indicator, Nike submitted:

- unsolicited articles;
- testimony as to the millions of users of the SNKRS online retail platform;
- prominent advertising featuring the mark; and
- survey evidence.

In reaching its decision, the board seemed particularly impressed that independent publications and consumers drew a distinction between the “disemvoweled” SNKRS and the generic term ‘sneakers’. “[I]t is clear that the authors... carefully distinguish between their use of SNKRS as a trademark representing [the] Applicant’s goods and services and their identification of those goods and services featuring ‘sneakers’; they do not confuse the two,” the board stated. Similarly impressive were the large number of social media posts that consistently used “SNKRS” to refer to Nike’s footwear services.

Distinguishing long-settled precedent that misspellings of generic words are unregistrable “if purchasers would perceive the different spelling as the equivalent of the generic term”, the board followed the line of cases holding that a “mixed record” as to the public’s perception dictates a failure of proof by the USPTO on genericness. Alternatively, the board found that Nike had demonstrated acquired distinctiveness through its substantially exclusive use of SNKRS since 2015.

Perhaps recognising the uniqueness of the case, the board acknowledged that its determination was “fact-intensive” and “governed by the record” and the “substantial burden” that the USPTO faces in proving genericness.

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