

This Opinion is not a
Precedent of the TTAB

Mailed: February 10, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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The Topps Company, Inc.

v.

Panini America, Inc.
—

Opposition No. 91209769
—

Andrew Baum and Janina Gorbach of Foley & Lardner
for The Topps Company, Inc.

Charles E. Phipps and Robert E. Nail of Locke Lord
for Panini America, Inc.
—

Before Quinn, Wellington and Gorowitz,
Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Panini America, Inc. (“Applicant”) filed an application to register on the Principal Register the mark **LIMITED** (in standard characters) for “sports trading cards” in International Class 16.¹ Applicant claims that its applied-for mark has

¹ Application Serial No. 85650691, filed June 13, 2012 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a *bona fide* intention to use the mark in commerce. Applicant subsequently filed an amendment to allege use that sets forth dates of first use anywhere and in commerce of 1994.

acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).

The Topps Company, Inc. (“Opposer”) opposed registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that Applicant’s applied-for mark, when applied to Applicant’s goods, is merely descriptive thereof. Further, Opposer alleges that Applicant’s mark has not acquired distinctiveness.

Applicant, in its answer, denied the salient allegations in the Notice of Opposition.

Evidentiary Objections

Before turning to the merits of this litigation, we focus our attention on evidentiary matters raised by the parties. The first involves Opposer’s objection to Applicant’s evidence of sales and advertising numbers based on inadmissible hearsay under Fed. R. Evid. 803(6) and 1006. More specifically, Opposer objected to spreadsheets comprising summaries of Applicant’s sales and advertising numbers because Applicant “failed to lay a proper foundation for their admission either as business records under Fed. R. Evid. 803(6) or as summaries of admissible business records under Fed. R. Evid. 1006.” (Brief, p. 17).

During the testimony of Martin Welling, Applicant’s vice president of operations, product development, for the 2.5 years prior to his deposition, Mr. Welling identified and introduced spreadsheet summaries covering sales revenue and advertising expenditures. See Exhibit 34 “Donruss and Panini America, Inc. LIMITED Sales History (through August 2013) Consolidated” and “Donruss and Panini America,

Inc. LIMITED Advertising and Promotional History (through August 2013) Consolidated”; and Exhibit 35 “Donruss & Panini America, Inc. LIMITED (Brand) Information (through March 2014) Consolidated.” The deposition and accompanying exhibits are designated as confidential.² According to Applicant, the data reports “comprise written summaries of accounting information routinely and systematically prepared and maintained by Panini and its predecessors in the course of their regularly conducted business activities.” (Brief, p. 19). Further, Applicant makes the following claim: “Panini’s aforementioned sales revenue and advertising expenditure reports were first provided to Topps back on September 17, 2013 during the discovery phase of this proceeding (marked at that time as Panini Exhibit PA-0387 and Exhibit PA-0045) as part of Panini’s Response to Topps’ First Set of Requests for Production of Documents. Topps never made any demand or request for Panini’s detailed accounting records from which the reports were prepared, although such records would certainly have been made available for review had Topps bothered to request such materials.” (Brief, p. 20).³ Opposer responded by contending that it was Applicant’s burden to offer the documents summarized in the spreadsheets for Opposer’s inspection, and not Opposer’s burden to ask for them.

² In view of this confidentiality, the documents do not appear on TTABVue and, thus, they cannot be identified herein by this manner.

³ Applicant also points out that, in any event, its claim of \$30 million in sales revenue under the LIMITED designation for the period 2001-2012 is already of record by virtue of Applicant’s response setting forth this figure in the application file. *See Cold War Museum Inc. v. Cold War Air Museum Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1628-29 (Fed. Cir. 2009). Unlike the numbers introduced at trial, the number in the involved application is not confidential.

Opposer highlights certain testimony of Mr. Welling to establish the lack of a proper foundation for admitting this evidence:

Q: And are these Panini's business records kept in the ordinary course of business? Can you verify these are Panini's records?

A: Yes, as they've been presented to me.
(Welling dep., p. 39)

Q: With respect to Exhibits 34 and 35, if you could – if you could verify that the – information represented in these actual reports are based on Panini's business records kept in the ordinary course of business?

A: As it's been presented to me, yes.
(Welling dep., p. 40).

Mr. Welling was not familiar with the spreadsheets until the meeting with Applicant's attorneys; further, he never saw for himself the underlying business records, and ensured their accuracy only to the extent "as presented to [him]."

As pointed out by Opposer, business records are trustworthy because they are prepared contemporaneously with the recorded events and because businesses need to rely on them in their commercial affairs. To the contrary, as Opposer states, "[t]he spreadsheets at issue here have none of those characteristics: they were prepared long after most of the events they purport to record, and they were designed to be passed on to others, not to be relied on by the preparing company itself." (Brief, p. 18).

We are inclined to agree with Opposer that the spreadsheet summaries are not business records under Fed. R. Evid. 803(6), and that the summaries do not satisfy the requirements of Fed. R. Evid. 1006. Nevertheless, because consideration of the

sales and advertising numbers does not alter our determination on the merits of Applicant's claim of acquired distinctiveness, we will consider this evidence in making our decision. Accordingly, Opposer's objections are overruled.

As to the second evidentiary matter, Applicant raised objections to certain of Opposer's evidence, citing Trademark Rule 2.123(1) and TBMP § 706 (2014). More specifically, Applicant objected to articles retrieved from the Internet (Exhibits B and C) because, in Applicant's view, the evidence comprises search summaries and further that Opposer failed to indicate the relevance of the material being offered; and to excerpts from the website, www.ebay.com (Exhibits D-1 through D-8), because Opposer failed to indicate the relevance of the material being offered. Opposer has responded to the objections.

The objections are not well taken. First, Applicant's objection that Opposer did not indicate the relevance of the materials being offered should have been promptly raised when the notice of reliance was filed. An objection to a notice of reliance on the ground that the notice does not comply with the procedural requirements of the particular rule under which it was submitted generally should be raised promptly. Applicant's objection, which is a procedural objection under Trademark Rule 2.122(e), should have been raised at a time when Opposer would have had an opportunity to cure the alleged deficiency. *See* TBMP §§ 532, 704.08(b) and 707.02. Accordingly, on this basis the objection is deemed waived. *Corporacion Habanos S.A. v. Guantanamera Cigars Co.*, 102 USPQ2d 1085, 1093 (TTAB 2012) (objection that notice of reliance failed to indicate relevance of materials was waived because

the deficiency was curable and the objection should have been raised at a time that applicant would have had an opportunity to cure the alleged deficiency). Second, and more importantly, the notice of reliance sufficiently sets forth the relevance of the materials being offered.

With respect to Applicant's objection based on admissibility, the evidence at issue does not comprise, contrary to Applicant's characterization, internet search summaries. Rather, as aptly pointed out by Opposer, the evidence comprises actual articles available in general circulation to members of the public retrieved from the Lexis/Nexis database. *See Safer Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1038 (TTAB 2010) (if a document obtained from the Internet identifies its date of publication or date that it was accessed and printed, and its source, it may be admitted into evidence pursuant to a notice of reliance in the same manner as a printed publication in general circulation in accordance with Trademark Rule 2.122(e)).

Accordingly, Applicant's objections are overruled in their entirety.

The Record

The record consists of the pleadings; the involved application; trial testimony, with related exhibits, taken by each party; dictionary definitions, excerpts from printed publications, excerpts from a third-party website, and Applicant's responses to Opposer's Requests for Admission, all introduced by way of Opposer's notices of reliance. Both parties filed briefs.

The Parties

Opposer has manufactured and sold sports trading cards for over 65 years. Based on sales volume, Opposer is the leader in this industry. Clay Luraschi, Opposer's vice president of product development, North America sports and entertainment, testified that over the years Opposer published sports trading cards in various sets and series, with its current collection comprising trading cards for Major League Baseball, the National Football League, Major League Soccer and Ultimate Fighting Championship. Opposer also published trading cards for the National Hockey League through 2004, and for the National Basketball Association through 2009. (Luraschi dep., p. 7; 21 TTABVue 9).

Mr. Luraschi stated that Opposer has sold various sets of sports trading cards displaying the designation "Limited Edition." These include the 2001 and 2002 Topps Major League Baseball Limited Edition complete set. (Luraschi dep., p. 10; Ex. Nos. 1-3; 21 TTABVue 12, 29-31). Although Opposer has not used the word "limited" on sports trading cards since 2002, Opposer remains interested in resuming its use on such goods. (Luraschi dep., p. 13; 21 TTABVue 15). Opposer views it as essential to preserve the ability to use the terminology "limited" or "limited edition" to describe certain sports trading cards because the terminology accurately describes the types of trading cards that are released in limited quantities. (Luraschi dep., p. 14; 21 TTABVue 16). When Opposer wishes to protect the collectability of certain trading cards, it limits production to smaller amounts. (Luraschi dep., p. 9; 21 TTABVue 11). Scarcity is equivalent to collectability.

(Luraschi dep., p. 10; 21 TTABVue 12). “Limited is the essence of what we do. It’s collectability.” (Luraschi dep., p. 14; 21 TTABVue 16).

Applicant, like Opposer, is in the same business of manufacturing and selling sports trading cards. According to Opposer, Applicant is Opposer’s most direct and most significant competitor in the sports trading card business.

Standing

Section 13(a) of the Trademark Act, 15 U.S.C. § 1063(a), allows for opposition to the registration of a mark by anyone “who believes that they would be damaged by the registration of a mark” The party seeking to oppose the registration of the mark must prove two elements: (1) that it has standing, and (2) that there is a valid ground to prevent the registration of the opposed mark. *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1755 (Fed. Cir. 1998).

Standing is a threshold issue that must be proven in every *inter partes* case. To establish standing, an opposer must show that it is not an intermeddler, but has a real interest in the proceeding. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999). To establish standing in this case, Opposer must prove that it has a “real interest” in this opposition proceeding and a “reasonable basis” for its belief in damage. To prove a “real interest” in this case, Opposer must show that it has a “direct and personal stake” in the outcome and is more than a “mere intermeddler.” *See Ritchie v. Simpson*, 50 USPQ2d at 1026-27. In the present case, where the claim of mere descriptiveness is asserted and Opposer further alleges that Applicant’s claim of acquired distinctiveness is insufficient, it is enough for Opposer to establish

that it is engaged in the sale of the same or related goods, that is, Opposer is a competitor. *Anheuser-Busch Inv. v. Holt*, 92 USPQ2d 1101, 1103 (TTAB 2009); *Plyboo America, Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633 (TTAB 1999); *Binney & Smith, Inc. v. Magic Marker Indus., Inc.*, 222 USPQ 1003, 1010 (TTAB 1984).

Opposer and Applicant are no strangers to one another. In fact, as indicated earlier, the parties are direct competitors and this proceeding involves a conflict between the two largest manufacturers of trading cards in the United States (Opposer is number one, Applicant is number two). Thus, Opposer has standing.

The Law

Section 2(e)(1) provides that a mark (or portion thereof) is unregistrable on the Principal Register if, “when used on or in connection with the goods of the applicant [it] is merely descriptive or deceptively misdescriptive of them”

Pursuant to Section 2(f), matter which is merely descriptive under Section 2(e)(1) may nonetheless be registered on the Principal Register if it “has become distinctive of the applicant’s goods [or services] in commerce.” Thus, the mark may be registered on the Principal Register if the applicant proves that the merely descriptive matter has acquired distinctiveness (also known as “secondary meaning”) as used on the applicant’s goods and/or services in commerce. *See Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1728-30 (Fed. Cir. 2012).

An applicant seeking registration of a mark under Section 2(f) bears the ultimate burden of establishing acquired distinctiveness. *See Yamaha Int’l Corp. v.*

Hoshino Gakki Co., 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988). Applicant's burden is to prove acquired distinctiveness by a preponderance of the evidence. *Id.* at 1006 "Finally, the applicant's burden of showing acquired distinctiveness increases with the level of descriptiveness; a more descriptive term requires more evidence of secondary meaning." *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005). As the Board has explained:

That is to say, the greater the degree of descriptiveness, the greater the evidentiary burden on the user to establish acquired distinctiveness. The sufficiency of the evidence offered to prove acquired distinctiveness should be evaluated in light of the nature of the designation. Highly descriptive terms, for example, are less likely to be perceived as trademarks and more likely to be useful to competing sellers than are less descriptive terms. More substantial evidence of acquired distinctiveness thus will ordinarily be required to establish that such terms truly function as source-indicators.

In re Greenliant Systems Ltd., 97 USPQ2d 1078, 1085 (TTAB 2010) (internal citations omitted).

Degree of Descriptiveness

The initial question before us in our analysis of whether LIMITED has acquired distinctiveness is the degree of descriptiveness of that word as used in connection with Applicant's sports trading cards. As noted above, the higher the degree of descriptiveness of the designation in question, the higher the burden Applicant faces in proving acquired distinctiveness.

A term is considered to be merely descriptive under Section 2(e)(1) if it immediately conveys knowledge of a quality, feature, function, or characteristic of

the goods or services with which it is used. *See In re Chamber of Commerce of the United States of America*, 675 F.3d 1297, 102 USPQ2d 1217 (Fed. Cir. 2012). A designation need not immediately convey an idea of each and every specific feature of the applicant's goods in order to be considered merely descriptive; it is enough that the term describes one significant attribute or function of the goods. *See In re H.U.D.D.L.E.*, 216 USPQ 358, 359 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338, 339 (TTAB 1973).

By seeking registration of its proposed mark LIMITED pursuant to Section 2(f), Applicant has conceded that this word is, at the least, merely descriptive of its goods, under Section 2(e)(1). *See In re RiseSmart Inc.*, 104 USPQ2d 1931, 1932 (TTAB 2012) (“... when an applicant responds to a refusal based on mere descriptiveness of a mark, or portion of a mark, by claiming acquired distinctiveness, such amendment to seek registration under Section 2(f) of the Trademark Act is considered an admission that the proposed mark is not inherently distinctive”). *See also Cold War Museum Inc. v. Cold War Air Museum Inc.*, 92 USPQ2d at 1629.⁴ Accordingly, Applicant’s contention that its applied-for mark is not merely descriptive, but rather at worst is only suggestive because it is “vague and indirect” (Brief, p. 12), is untenable.⁵

⁴ So as to be clear, Applicant did not claim acquired distinctiveness in the alternative. *Cf. In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1713 (TTAB 2011). *See* TMEP § 1202.02(c) (2015).

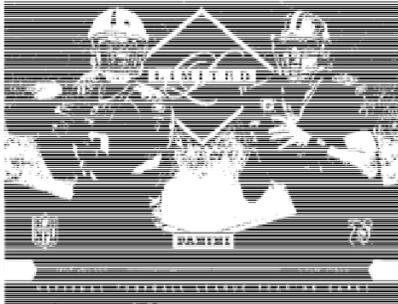
⁵ We must determine whether a designation is merely descriptive not in the abstract, but *in relation to the goods identified in the application* and the possible significance that the designation would have to the average purchaser of the goods. *In re ICE Futures U.S. Inc.*, 85 USPQ2d 1664, 1665-66 (TTAB 2008); *In re Polo International Inc.*, 51 USPQ2d 1061, 1062 (TTAB 1999); *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Contrary to

The word “limited” is defined as “confined within limits; restricted in extent, number, or duration.” (WEBSTER’S THIRD NEW INTERNATIONAL DICTIONARY OF THE ENGLISH LANGUAGE (unabridged ed. 1971)). The terminology “limited edition” means “an edition of a publication limited to a specified number of copies and usu. printed in a special format.” (WEBSTER’S NEW COLLEGIATE DICTIONARY (1975)). (Opposer’s Ex. A; 7 TTABVue 12-22).

Mr. Welling, before his employment with Applicant, was an executive with a third-party competitor, Upper Deck, for 18 years, and he admitted that he was aware of Upper Deck’s use of “limited” during the five years prior to Applicant’s claim of acquired distinctiveness. (Welling dep., pp. 73-74). To a large extent the sports trading card business caters to collectors and hobbyists. Their interest in a specific card and the card’s value is often driven by the card’s scarcity. Thus, to preserve the collectability of its cards, the parties frequently limit the quantity of cards that are released in the market. (Welling dep., pp. 93-94; Luraschi dep., p. 9; 21 TTABVue 11).

Applicant uses the word LIMITED on its sports trading cards as shown by the following representative samples covering the sports of football, baseball, basketball and hockey:

the gist of Applicant’s contention that “consumers must rely upon their own imagination before concluding the specific nature of [Applicant’s] goods” (Brief, p. 12), it is settled that “[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them.” *DuoProSS Meditech Corp. v. Inviro Medical Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (quoting *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002)).



(Welling Ex. 36, PA-0055)



(Welling Ex. 36, PA-0063)



(Welling Ex. 36, PA-0073)



(Welling Ex. 36, PA-0091)

In one of the examples above, a series of NHL cards, Applicant set forth “Highlights” of the collection, namely that the cards included autographs and sweater patches with “variations limited to 25 copies or fewer!” (Welling Ex. 36, PA-0093). With respect to certain of its NFL cards, Applicant’s blog indicates that “Every card produced for 2011 Limited Football is sequentially numbered to 499 or less, including the stunning Material Phenoms RCs that this year will [be] included [with] all on-card autographs, prime memorabilia pieces and sequential numbering to 299 or less.” (Ex. 38, PA-0157).

The record is replete with numerous third-party articles retrieved from printed publications showing uses of the terminology “limited edition” (or “limited-edition”) in connection with sports trading cards. (Opposer’s Ex. B). A representative sample is set forth below.

“The second set of the limited edition collectible cards will be available....”

(*The Daily Gazette*, Aug. 12, 2013; 7 TTABVue 24)

13-by-19-inch limited edition rookie trading cards of Jack Hoffman

(*Aberdeen American News*; June 4, 2013, 7 TTABVue 26)

Built on the optimistic assumption that when our 401(k)s crumble, we can ride out retirement on the statistics side of limited-edition baseball cards.

(*Washington Post*, Jan. 4, 2013; 7 TTABVue 27)

All fans at the Nets’ home game against the Magic will receive a limited edition Brooklyn Knight trading card.

(*New York Post*, Nov. 4, 2014; 7 TTABVue 28)

The 2009 Pro-Football Hall of Fame inductee also will have limited-edition trading cards to be handed out as souvenirs.

(*Phoenix Business Journal*, Nov. 3, 2010; 7 TTABVue 35)

“Aside from the kids, I get a lot of serious collectors, who are often looking for limited-edition cards to complete their collection,” said O’Rourke.

(*Connecticut Post Online*, Aug. 27, 2009; 7 TTABVue 38)

Best baseball souvenir of the year, I predict, will be the limited-edition baseball card set that the Wisconsin Historical Museum has developed in honor of the 1957 World Series winners, the Milwaukee Braves.

(*The Capital Times*, July 14, 2007; 7 TTABVue 46)

This weekend the WNBA debuted trading cards for its players, including limited edition cards containing a piece of a player’s jersey or warm-up uniform.

(*Daytona Beach News Journal*, July 31, 2005; 7 TTABVue 54)

The record also includes articles in printed publications showing use of the word “limited” in names for sets of sports trading cards. (Opposer’s Ex. C). Examples include the following:

They are scheduled to include both current and past legends. In addition to the commemorative sports coins, the Company plans to release Limited Edition collector cards in both Silver and Gold.

(*Marketwire*, April 30, 2010; 7 TTABVue 60)

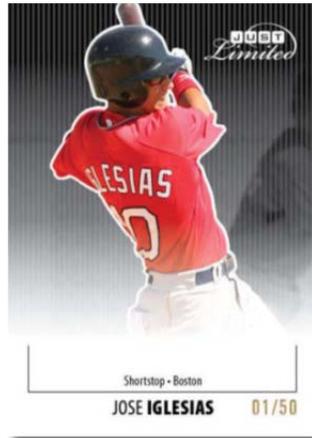
The 2008 Ty Cobb Limited Edition Baseball Card will go on sale at 10 a.m.

(*Birmingham News*, July 6, 2008; 7 TTABVue 63)

Opposer took the testimony of Alan Narzissenfeld, owner of a trading card store in Orlando, Florida and a consultant for opposer. Opposer introduced several listings on the website www.ebay.com showing individuals offering sports trading cards for sale. (Opposer's Ex. D). Opposer also introduced listings showing cards originating from other competitors in the industry, Upper Deck, Fleer Skybox, Just Memorabilia and Images Limited, include the following:



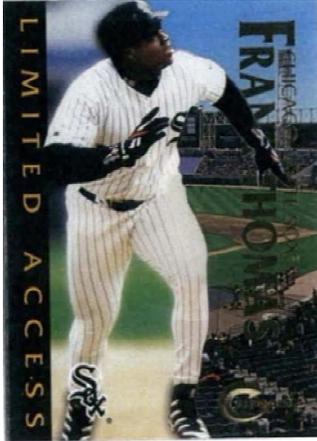
(Ex. No. D-2; 7 TTABVue 76)



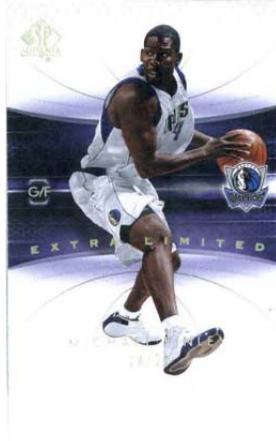
(Ex. No.D-4; 7 TTABVue 82)



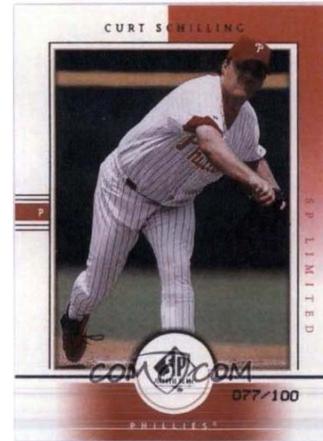
(Narzissenfeld dep., Ex. No. 5; 21 TTABVue 121)



(Narzissenfeld dep., Ex. No. 24; 21 TTABVue 145)



(Narzissenfeld dep., Ex. No. 13; 21 TTABVue 134)



(Narzissenfeld dep., Ex. No. 27; 21 TTABVue 148)



(Narzissenfeld dep., Ex. No. 53; 21 TTABVue 177)



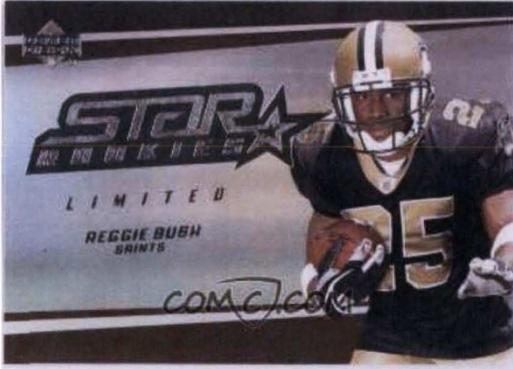
(Narzissenfeld dep., Ex. No. 34; 21 TTABVue 156)



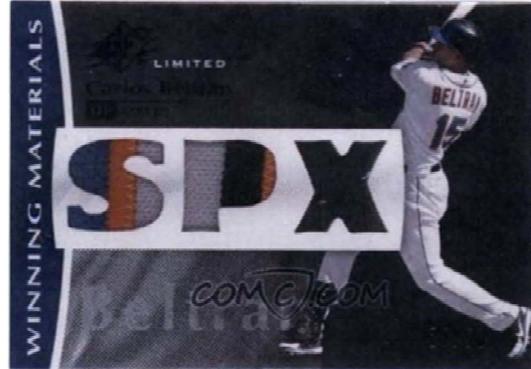
(Ex. D-1; 7 TTABVue 69)



(Narzissenfeld dep., Ex. No. 6; 21 TTABVue 128)



(Narzissenfeld dep., Ex. No. 22; 21 TTABVue 143)



(Narzissenfeld dep., Ex. No. 40; 21 TTABVue 162)

The application file includes an excerpt from a third-party website, www.askmen.com, featuring an article captioned “5 Things You Didn’t Know: Sports Cards.” (Office action, September 6, 2012). The excerpt reads in part:

It all comes down to supply and demand. In the late 1990s, card companies introduced serial numbering, the antidote to mass-produced cards such as Gretzky’s rookie. Cards were printed in limited quantities and stamped with a unique number. Only 99 copies exist of Crosby’s The Cup card, meaning if you want The Next One’s top rookie, be prepared to pay for it.

As shown by the record, Applicant seeks registration of the word “limited” that is, at the very least, highly descriptive of sports trading cards. The exclusivity of such cards is at the core of the sports trading card industry; the production of cards in limited quantities is an industry practice, thereby enhancing the product value to collectors. The rarity of cards drives the sports trading card business. In the context of the sport trading card industry, the word “limited” immediately describes that certain cards are produced in “limited” quantity or in a “limited edition.” *See In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ2d 215, 219 (CCPA 1978) (Rich, J., concurring) (“the users of language have a universal habit of shortening full names

– from haste or laziness or just economy of words”). No thought or imagination is required to immediately understand that sport trading cards sold under the designation LIMITED are just that, namely, sports trading cards produced or available in limited quantities. *See In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089-90 (Fed. Cir. 2005), citing *In re Abcor Dev. Corp.*, 200 USPQ at 217 (“The major reasons for not protecting such [merely descriptive] marks are: (1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods; and (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.”).

Acquired Distinctiveness

We turn now to the question of whether Applicant has established that the highly descriptive designation LIMITED has acquired distinctiveness for purposes of Section 2(f), such that the designation is registrable on the Principal Register. As noted above, Applicant bears the ultimate burden of proving acquired distinctiveness, by a preponderance of the evidence.

Because we have found that the word LIMITED is highly descriptive of Applicant’s goods, Applicant’s burden of establishing acquired distinctiveness under Section 2(f) likewise is very high. *See In re Steelbuilding.com*, 75 USPQ2d at 1424; *In re Bongrain Int’l Corp.*, 894 F.2d 1316, 13 USPQ2d 1727, 1729 (Fed. Cir. 1990); *In re Greenliant Systems Ltd.*, 97 USPQ2d at 1085.

“To show that a mark has acquired distinctiveness, an applicant must demonstrate that the relevant public understands the primary significance of the mark as identifying the source of a product or service rather than the product or service itself.” *In re Steelbuilding.com*, 75 USPQ2d at 1422. *See also Coach Services Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1729. Our ultimate Section 2(f) analysis and determination in this case is based on all of the evidence considered as a whole. In determining whether Applicant has demonstrated acquired distinctiveness of the its proposed mark LIMITED for sports trading cards, the Board may examine advertising expenditures, sales success, length and exclusivity of use, unsolicited media coverage, and consumer studies (linking the name to a source). *Cicena Ltd. v. Columbia Telecomms Group*, 900 F.2d 1546, 14 USPQ2d 1401 (Fed. Cir. 1990). On this list, no single fact is determinative. *In re Tires, Tires, Tires Inc.*, 94 USPQ2d 1153, 1157 (TTAB 2009). *See also In re Ennco Display Sys. Inc.*, 56 USPQ2d 1279, 1283 (TTAB 2000) (“Direct evidence [of acquired distinctiveness] includes actual testimony, declarations or surveys of consumers as their state of mind. Circumstantial evidence, on the other hand, is evidence from which consumer association might be inferred, such as years of use, extensive amount of sales and advertising, and any similar evidence showing wide exposure of the mark to consumers.”).

The Examining Attorney accepted Applicant’s claim of acquired distinctiveness based on Applicant’s purported substantially exclusive and continuous use in commerce for the five years preceding the date of its claim, and Applicant’s

unverified statement that it and its predecessor sold “more than \$30,000,000 of sports trading cards under the LIMITED trademark since 2001.”⁶ Contrary to the gist of one of Applicant’s arguments, the Board is not bound by the Examining Attorney’s decision to allow publication of the mark. *See Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1765 (TTAB 2013).

At the outset of our consideration of Applicant’s claim of acquired distinctiveness, we address Applicant’s view of its claim to exclusive rights in LIMITED:

Panini does not dispute that “limited” is an English word or that numerous third parties have used the term “limited” in a descriptive sense, including the sports card industry. Rather, Panini and its predecessors-in-interest are the only entities to have used LIMITED in commerce as a trademark in a branding sense (and as part of a coordinated branding or marketing strategy) for sports trading cards. Further ... Panini makes no claim that others should be precluded from continuing to use “limited” in a descriptive sense, and indeed such usage is expressly permitted by Section 33(b)(4), 15 U.S.C. § 1115(b)(4).

(Brief, p. 14). Applicant points out that no one else in the industry uses the specific word LIMITED *as a trademark* in connection with the same or similar goods. Arguments similar to Applicant’s argument quoted above have proved unavailing. *See, e.g., DeWalt, Inc. v. Magna Power Tool Corp.*, 289 USPQ2d 656, 129 USPQ 275, 279 (CCPA 1961) (“Power Shop” for woodworking saws). Moreover, even assuming that Applicant may be the first or only user of the word LIMITED as a purported

⁶ As indicated earlier, the sales and advertising numbers introduced at trial are confidential. The sales figure in the involved application is not confidential.

trademark in the sports trading cards industry, we find that this fact does not negate the highly descriptive nature of the word or suffice to establish acquired distinctiveness in this case. *See J. Kohnstam, Ltd. v. Louis Marx & Co.*, 280 F.2d 437, 126 USPQ 362, 364 (CCPA 1960); *In re Greenliant Systems Ltd.*, 97 USPQ2d at 1083; *In re Mortg. Bankers Ass'n of Am.*, 226 USPQ 954, 956 (TTAB 1985); *In re Nat'l Shooting Sports Found., Inc.*, 219 USPQ 1018 (TTAB 1983).

As Applicant itself acknowledges, Applicant's use of the word "limited" hardly has been substantially exclusive. The evidence of Opposer's use, but especially of third-party use of "limited" in connection with sports trading cards militates against Applicant's claim of acquired distinctiveness.⁷ The fact that the word "limited" has been used by unrelated entities in the industry is inconsistent with the requirement of acquired distinctiveness that the word indicate a single source. Given the number of third-party uses, consumers are likely to perceive the word "limited" when used for sports trading cards, not as a trademark for one company, but rather as a common word used by different entities in the industry to describe those cards. *See Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 172 USPQ 361 (CCPA 1972). As the Board stated in a similar case:

[T]he average cigarette consumer would be likely to equate "ENRICHED FLAVOR" with other similar designations [*e.g.*, "Full Rich Tobacco Flavor," "Full Flavor," and "Rich Tobacco Flavor"] that he or she has been exposed to over the years and attribute it to the same descriptive significance intended by the other phrases, namely, a message to the effect that applicant's

⁷ Opposer does not claim trademark rights in the word, but rather is seeking to ensure its continuing right to use the word descriptively for its future trading cards unfettered by any claim or potential claim by Applicant of infringement.

“MERIT” cigarettes have an enriched flavor or, if you will, a rich full flavor.

R.J. Reynolds Tobacco Co. v. Philip Morris, Inc., 210 USPQ 34, 42 (TTAB 1981).

Likewise, consumers would equate the words “limited” and “limited edition” to convey the same descriptive significance.

Notwithstanding Applicant’s remarks to the contrary, the registration sought by Applicant, if granted, would be inconsistent with Opposer’s right to use the word descriptively for its trading cards. As the predecessor of our primary reviewing stated:

[Opposer] asserts, and we must agree, that it is entirely within its rights in using as a descriptive designation of its business the phrase “THE HOUSE OF FLAVOR.” It must be emphasized that [Opposer] is not asserting trademark rights but merely freedom to continue a descriptive use. Certainly this right would be placed in jeopardy by a grant of registration as sought by [Applicant] on the Principal Register with its attendant presumptions of validity, ownership and the right to exclusive use.

McCormick & Co. v. Summers, 354 F.2d 668, 148 USPQ 272, 276 (CCPA 1966). *See also Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939 (Fed. Cir. 1984); *Roselux Chemical Co. v. Parsons Ammonia Co.*, 299 F.2d 855, 132 USPQ 627 (CCPA 1962); *Goodyear Tire and Rubber Co. v. Interco Tire Corp.*, 49 USPQ2d 1705 (TTAB 1998).

We now direct our attention to Applicant’s testimony and other evidence introduced at trial in further support of its Section 2(f) claim of acquired distinctiveness.

We have considered Applicant's statement that it has used the designation LIMITED since 1994. It is well settled that an applicant's use of a word for a long time does not necessarily establish that the word has acquired distinctiveness as a mark. *In re The Interstate Folding Box Co.*, 167 USPQ 241, 245 (TTAB 1970). In the present case, this length of use is outweighed by the other evidence showing that the word "limited" is highly descriptive, and the absence of any direct evidence showing recognition of the word by consumers as a source indicator for applicant's goods. *See In re Packaging Specialists, Inc.*, 221 USPQ 917, 920 (TTAB 1984) (use of mark for sixteen years deemed "a substantial period but not necessarily conclusive or persuasive on the Section 2(f) showing"). Although we recognize there is evidence showing Applicant's use of the word LIMITED on its goods in a prominent manner, that fact, in and of itself, does not establish that consumers perceive the word as an indication of source of the goods, rather than as a merely descriptive word. Not every word which appears on an entity's goods, regardless of how prominently it is displayed, functions as a trademark. Mere intent that a term function as a trademark is not enough in and of itself. *In re Morganroth*, 208 USPQ 284, 287 (TTAB 1980) ("Wishing does not make a trademark or service mark be."). Applicant's intent that the designation LIMITED serve as an indicator of source is of no moment.

Up until 2009, sales were made by Applicant's predecessors in interest. The

record shows, however, that all sales by Donruss were under the unitary logo mark LEAF LIMITED, as shown at right, not just the word LIMITED *per se*. Leaf also was a sports card



manufacturer that was acquired by Donruss. (Welling dep., p. 50). The record is devoid of evidence showing any independent trademark significance for the word LIMITED during the time of the predecessors' use. *See Bose Corp. v. QSC Audio Prods.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002).

We have considered Applicant's sales, but a problem exists with Applicant's sales revenue figures, given that they represent sales in *both* the United States and Canada, with no breakdown regarding the extent of these sales in this country. Moreover, although Applicant may be a leader in the industry, the amounts are raw numbers, providing no context showing Applicant's market share. *See Target Brands Inc. v. Hughes*, 85 USPQ2d 1676, 1681 (TTAB 2007) ("The sales figures for 14 years, standing alone and without any context in the trade, are not so impressive as to elevate applicant's highly descriptive designation to the status of a distinctive mark."). Further, the raw numbers, although showing the popularity of Applicant's goods, do not necessarily evidence consumers' recognition of the proposed mark as a source indicator, that is, the achievement of distinctiveness. *See In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999); *In re Bongrain Int'l Corp.*, 13 USPQ2d at 1729. *See also In re Candy Bouquet Int'l, Inc.*, 73 USPQ2d 1883, 1888-89 (TTAB 2004).

Applicant's specific advertising expenditures since 2001 are confidential. Although we have considered Applicant's advertising and promotional efforts, Applicant's numbers are hardly impressive, falling far below levels deemed persuasive in other cases involving the acquired distinctiveness of marks. *Cf. In re Country Music Ass'n Inc.*, 100 USPQ2d 1824, 1834 (TTAB 2011). In any event, the ultimate test in determining whether a designation has acquired distinctiveness is applicant's success, rather than its efforts, in educating the public to associate the proposed mark with a single source. *In re Pennzoil Prods. Co.*, 20 USPQ2d 1753, 1760-61 (TTAB 1991). But, as is evident from our decision herein, the record is devoid of evidence to establish that Applicant's promotional efforts have borne fruit.

The record is devoid of any evidence of consumer advertising under the proposed mark through television, radio, print media or the Internet. (Welling dep., p. 96). The only advertisement of record is a set of promotional brochures for certain of Applicant's card collections during 2009-2013. The record fails to show, however, the number of brochures actually distributed. (Welling dep., pp. 88-89; Ex. No. 36).

The record includes pages from Applicant's blog, showing comments from visitors wherein they ostensibly use the word LIMITED as a trademark for Applicant's goods. There is no evidence, however, as to the number of users of, or visitors to, the blog. (Ex. Nos. 37-50).

Applicant argues that "[a]s a result of the extensive marketing, distribution, and sales of Panini's products bearing Panini's LIMITED mark, a substantial number of consumers and potential consumers now recognize that mark as distinguishing

Panini's sports trading cards and identifying Panini as the source of such products.” (Brief, p. 23). At bottom, however, we see a fundamental flaw with Applicant's case: we have no direct consumer testimony, no consumer surveys, and no evidence of unsolicited media coverage. As Mr. Welling testified:

Q: Okay. I'd like to ask, are you aware of any sports trading card collectors or consumers generally having expressed recognition of the term Limited as a trademark or perhaps a[n] indicator of quality of Panini's trading cards via online postings or otherwise?

Object to the form, compound. You can answer.

A: No, not directly.

Q: Or do you have any knowledge of collectors having expressed recognition of Limited as some sort of source identifier, brand via online postings or otherwise for Panini's trading cards?

A: Generally, yes. Specifically, no.
(Welling dep., p. 53)

In short, we find that Applicant has failed to establish that the designation LIMITED has acquired distinctiveness as a source-indicator for Applicant's sports trading cards. Rather, the record establishes that the word is a highly descriptive term which identifies a significant feature of the goods, namely, Applicant's sports trading cards are limited in number (i.e., a limited edition) so as to enhance the cards' appeal to collectors and increase the cards' value to collectors. Although we have considered all of the evidence of acquired distinctiveness, this evidence must be weighed against the highly descriptive nature of the word comprising Applicant's proposed mark. Given that the proposed mark is highly descriptive, much more

evidence, especially in the form of direct evidence from the relevant purchasing public, than what Applicant has submitted would be necessary to show that the designation LIMITED has become distinctive for Applicant's sports trading cards. *See, e.g., In re Country Music Assoc. Inc.*, 100 USPQ2d at 1834 ("Teflon" consumer survey showed 85% of respondents believed term COUNTRY MUSIC ASSOCIATION is a brand name and, thus, is probative evidence of acquired distinctiveness).

We have considered all of the evidence made of record pertaining to the issues in this case, as well as all of the arguments related thereto, including any evidence and/or arguments not specifically discussed in this opinion. We find that the word LIMITED is highly descriptive as applied to Applicant's sports trading cards. Accordingly, Applicant's burden of proving acquired distinctiveness is likewise very high. *See In re Steelbuilding.com*, 75 USPQ2d at 1424 ("The proposed mark is highly descriptive. Therefore, applicant had the burden to show a concomitantly high level of secondary meaning."). We find that Applicant has failed to carry that burden.

Decision: The opposition is sustained, and registration to Applicant is refused.