

Jason Whitney in INTA Bulletin: Trademark Trial and Appeal Board Failed to Properly Evaluate Fame and Third-Party Usage

By Jason W. Whitney | March 8, 2019

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In *Omaha Steaks International, Inc. v. Greater Omaha Packing Co., Inc.*, No. 2018-1152 (Fed. Cir. Nov. 15, 2018), the U.S. Court of Appeals for the Federal Circuit held the Trademark Trial and Appeal Board (TTAB) erred in analyzing two likelihood of confusion factors: fame and third-party usage.

The opinion arose from opposition proceedings filed by Omaha Steaks International, Inc., which owned multiple registrations of the OMAHA STEAKS word mark, against Greater Omaha Packing Co., Inc., which applied to register the GREATER OMAHA PROVIDING THE HIGHEST QUALITY BEEF work mark. In the oppositions, the TTAB found no likelihood of confusion between the parties' marks, concluding in part that Omaha Steaks' marks lacked fame, and that third-party use showed the word "Omaha" was weak and entitled to only narrow protection. Slip Op. at 4.

On appeal, the Federal Circuit found the TTAB improperly disregarded Omaha Steaks' sales and advertising figures as evidence of fame. Specifically, the TTAB misinterpreted *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367 (Fed. Cir. 2002), as requiring evidence of "market share" before considering such figures. "Though Bose expressly approves of using market share," the court explained, "it does not require it." Slip Op. at 7. Rather, under Bose, evidence of the "type of advertising" can give sufficient context for raw advertising numbers. *Id.* Because Omaha Steaks' evidence established both the amounts and "type of advertisements and promotions it uses to gain sales," the TTAB should not have discounted the sales numbers and advertising expenditures. Slip Op. at 6-9.

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