

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Hearing:  
20 August 2008

Mailed:  
21 November 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Igloo Products Corp.

v.

Kool Pak, Inc.<sup>1</sup>

Opposition No. 91095892  
to application Serial No. 74467785

James R. Robinson of King & Spalding LLP for Igloo Products Corp.

Michael A. Grow of Arent Fox LLP for Kool Pak, Inc.

Before Grendel, Drost, and Taylor, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

Kool Pak, Inc. (applicant) has applied to register the mark KOOL PAK in typed or standard character form on the Principal Register under the provision of Section 2(f) of the Trademark Act (15 U.S.C. § 1052(f)) for the following goods:

Insulated carrying cases for audio and video cassettes, compact discs and camera equipment in Class 9

Insulated tote bags for travel, books, and various other sundry items, fanny packs, shoe bags, drawstring fabric bags, and non-insulated tote bags in Class 18

<sup>1</sup> By change of name from Brantex, Inc. See Reel/Frame No. 2092/0570.

Insulated carrying bags for beverage container six-packs, beverage container eight-packs, beverage container twelve-packs, and for use as lunch bags; insulated lunch bags; insulated carrying bags for single bottles; and soft insulated holding sleeves for beverage cans, beverage bottles, and wine and champagne bottles in Class 21.<sup>2</sup>

On November 18, 1994, opposer, Igloo Products Corp., filed a notice of opposition to the registration of applicant's mark on the grounds that (Notice of Opposition at 2 (paragraph numbers omitted)):

The term "cool pack" is merely descriptive of or is a common or usual name for insulated containers intended to keep ice, food and beverages cool.

The term "KOOL PAK" is the phonetic equivalent of the term "cool pack."

The Applicant through its attorneys has alleged that it has acquired valuable property rights in the federally registered mark "KOOL PAK" and that Opposer's use of the term "cool pack" constitutes trademark infringement of the Applicant's rights.

Opposer has a right to use the term "cool pack" in its descriptive or generic context to describe or refer to its cool packs.

On January 30, 2001, opposer amended its notice of opposition to add the ground of collateral estoppel and res

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<sup>2</sup> Serial No. 74467785, filed on December 9, 1993. The application identifies the dates of first use anywhere and in commerce for all classes as August 29, 1983. Applicant (Brief at 9 n. 5) points out that the USPTO electronic records incorrectly indicates the dates of first use for Class 21 are 1993 instead of 1983.

judicata. Applicant denied the salient allegations of the notices of opposition.

The Record

The record consists of the file of the involved application; applicant's notices of reliances dated November 20, 2006, November 1, 2001, and October 2, 2001; the testimony deposition of Marc Zingler, applicant's president dated January 1, 2007; opposer's notice of reliance dated November 28, 1995; and the testimony deposition of Lee Stranathan, opposer's vice president of marketing dated October 31, 1995. Opposer also filed an untimely notice of reliance on June 13, 2007. On July 30, 2007, the board denied "opposer's request to reopen its testimony period for the limited purpose of filing a notice of reliance." Order at 3. To the extent that the documents in the untimely notice of reliance include papers from this proceeding, they are already of record and we can consider them.

Both parties have filed briefs, and an oral hearing was held on August 20, 2008.

Procedural Background

After this opposition was instituted on July 18, 1996, the proceedings were suspended pending disposition of a civil action. The proceeding involved a civil action that was filed in the U.S. District for the Southern District of

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Texas. See *Igloo Products Corp. v. Brantex, Inc.*, Civil Action No. H-96-1620 (S.D. Tex. filed May 20, 1996).

On May 20, 1998, the District Court entered a final judgment as a result of a unanimous jury verdict (slip op. at 2-3, paragraph notations omitted) that provided in pertinent part:

The words "KOOL PACK" as used by Kool Pak on or in connection with its soft-sided portable coolers have not acquired secondary meaning.

Kool Pak does not own, and is not entitled to register, the word mark "KOOL PAK" on or in connection with its soft-sided portable coolers...

Kool Pak shall amend its federal trademark application Serial Number 74/467,785, by deleting any reference to the use of the word mark "KOOL PAK" on soft-sided portable coolers, if such a reference is made on the application. If such a reference is not made on the application, Kool Pak shall include the following disclaimer:

"No claim is made on the exclusive right to use the words 'Kool Pak' on soft-sided portable coolers, apart from the mark as shown."<sup>3</sup>

The District Court's decision was affirmed by the Fifth Circuit on February 11, 2000. *Igloo Products Corp. v. Brantex Inc.*, 202 F.3d 814, 53 USPQ2d 1753 (5th Cir. 2000).

On April 19, 1999, during the pendency of its appeal to the Fifth Circuit, applicant filed the following disclaimer with board:

No claim is made to the exclusive right to use the words "Kool" and "Pak" on soft-sided portable coolers apart from the mark shown in the drawing.

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<sup>3</sup> The Court also ordered a similar disclaimer in applicant's Registration No. 1841697.

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On March 1, 2000, the board rejected the disclaimer because "it constitutes a disclaimer of applicant's entire mark and [is] inconsistent with applicant's claim of distinctiveness in the application file." Order at 1. In addition, "Applicant states that if it is successful on appeal, it will request the disclaimer be deleted from this application and any resulting registration." Order at 1-2. Therefore, the board deferred further action on the case. Order at 1-2. The board adhered to its decision in an Order dated November 29, 2000.

On February 22, 2001, applicant again submitted a disclaimer. This time the disclaimer read:

No claim is made to the exclusive right to use the words "Kool Pak" on soft-sided portable coolers, apart from the mark as shown.

The board denied this request to enter the disclaimer in an Order dated August 16, 2001. In that Order (p. 2), applicant's request to enter the disclaimer was denied because "soft-sided coolers are not among the goods identified in the application and to disclaim the words KOOL PAK constitutes a disclaimer of the entire mark which is the subject of this application and opposition and cannot be entered."

Opposer (Brief at 7) has now "withdrawn its opposition to the registration of the term KOOL PAK in Classes 9 and 18."

Standing

Opposer is a competitor of applicant. Both are in the same business. See Zingler Ex. 59 and Stranathan dep. at 8 (The term cool pack "describes a line of soft-sided products that we sell").

It is recognized that a party need not be a manufacturer or seller of the goods in connection with which a descriptive, misdescriptive, or merely ornamental designation is used in order to object to the registration thereof. It is sufficient that the party objecting to such registration be engaged in the manufacture and/or sale of the same or related goods and that the product in question be one that could be produced in the normal expansion of that person's business. If the designation in question is found to be merely descriptive, merely ornamental or the like, damage is presumed since a registration thereof with the statutory presumptions afforded the registration would be inconsistent with the right of another person to use these designations or designs in connection with the same or similar goods as it would have the right to do when and if it so chooses... Thus, opposer as a competitor of applicant is a proper party to challenge applicant's right of registration.

*Federal Glass Co. v. Corning Glass Works*, 162 USPQ 279, 282-83 (TTAB 1969). See also *McCarthy on Trademarks and Unfair Competition* (4<sup>th</sup> ed. August 2008) § 20:11 ("Standing is presumed when the mark sought to be registered is allegedly descriptive of the goods and the opposer is one who has a sufficient interest in using the descriptive term in his business").

Therefore, we find that opposer has standing to oppose the involved application.

Issues

Opposer maintains (Brief at 2) that the issue in this proceeding is:

Whether Applicant Kool Pak, Inc. is entitled to a registration on the Principal Register of the mark KOOL PAK in connection with the goods recited in Class 21 identified in U.S. trademark application serial number 74/467,785 on the basis of acquired distinctiveness.

Applicant agrees (Brief at 4):

The primary issue before the board is whether Kool Pak's mark, KOOL PAK, which has been in continuous and substantially exclusive use in connection with insulated bags and other products for nearly twenty-four years, and has been extensively marketed and sold nationwide, has acquired secondary meaning as of today, thereby justifying registration of the mark shown in Appln. Ser. No. 74/467,785 on the Principal Register.

We add that another issue is, inasmuch as the U.S. District Court for the Southern District of Texas and the Fifth Circuit have already addressed issues related to this application, whether their determination should be implemented by the board irrespective of the board's previous rulings.

Disclaimer

We will begin by revisiting the issue of whether applicant's requested disclaimer of the term KOOL PAK for soft-sided portable coolers should be entered. We do this inasmuch as the board originally suspended its proceedings because a civil action was commenced between the parties and one of the matters that the civil action determined was the registrability of the application in this proceeding. To

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the extent that a civil action in a Federal district court involves issues in common with those in a proceeding before the Board, the decision of the Federal district court is binding upon the Board, while the decision of the Board is not binding upon the court. See *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 650 F. Supp. 563, 2 USPQ2d 1208, 1210 (D. Minn. 1986):

[T]he proceedings and determinations of the PTO are of limited importance in a federal court proceeding:

Generally, a court defers to the exercise of an administrative agency's primary jurisdiction to have the benefit of the agency's expertise in the assessment of disputed facts that are not open for reconsideration by the court ... But when registration decisions are litigated in a district court ... the proceeding is virtually de novo, since additional cross-examination and presentation of additional testimony is permitted. The record made in the PTO is admitted into evidence, but the fact finding of that office is not conclusive, nor is the court's consideration limited to that record.

*Continental Connector Corp. v. Continental Specialties Corp.*, 413 F. Supp. 1347 (Conn. 1976) (citations omitted). See also *Questor Corp. v. Wold Industries, Inc.*, 194 USPQ 141 (D. Minn. 1976) ("The value of a Patent Office determination of the right to register is ... not res judicata or binding on this Court."); *Sam S. Goldstein Industries, Inc. v. Botany Industries, Inc.*, 301 F. Supp. 728, 731 (S.D.N.Y. 1969) ("While it may be commendable ... to permit a specialized agency to render its opinion in order to gain the benefit of that administrative expertise, in a registered trademark cancellation action the court must consider the issues, in effect, de novo.") The district court, on the other hand, can conclusively determine the issues common to the two proceedings. E.g. *Sonora Cosmetics, Inc. v. L'Oreal S.A.*, 631 F. Supp. 626 (S.D.N.Y. 1986) (Stay denied because district court could conclusively determine claims. "Moreover, ... the Commissioner of Patents has held that, inasmuch as TTAB determinations

of the validity of registration are merely advisory to the courts, it is preferable for the TTAB to stay its own proceedings where parallel litigation occurs in the district court." *Id.* at 629 (citing *The Other Telephone Co. v. Connecticut National Telephone Co.*, 181 USPQ 779, 782 (Comm'r. 1974)), *aff'd*, 795 F.2d 27 (2d Cir. 1986).

See also *Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950 (2d Cir. 1988).

Also, it has long been held that "a lower court is bound to respect the mandate of an appellate tribunal and cannot reconsider questions which the mandate has laid at rest." *FCC v. Pottsville Broadcasting Co.*, 309 U.S. 134, 140 (1940). Indeed, Trademark Act Section 37 (15 U.S.C. § 1119) provides that:

In any action involving a registered mark the court may determine the right to registration, order the cancellation of registrations, in whole or in part, restore cancelled registrations, and otherwise rectify the register with respect to the registrations of any party to the action. Decrees and orders shall be certified by the court to the Director, who shall make appropriate entry upon the records of the Patent and Trademark Office, and shall be controlled thereby.<sup>4</sup>

In this case, the interlocutory attorney has issued several orders refusing to enter the disclaimer. "However, at final hearing, the Board panel to which the case is assigned for decision may review an interlocutory ruling and reverse it, if appropriate." TBMP § 518 (2d ed. rev. 2004).

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<sup>4</sup> Inasmuch as the board suspended action on this case pending the disposition of the civil action and the case law recognizes the binding nature of the Federal court's order, the fact that the order was not "certified by the court to the Director" does not give us a license to ignore the order.

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*See also Harley-Davidson Motor Company, Inc. v. Pierce Foods Corp.*, 231 USPQ 857, 859 n.13 (TTAB 1986). Therefore, we will reexamine the order denying applicant's request to enter a disclaimer of the term KOOL PAK as required by the Court.

15 U.S.C. § 1056 provides:

(a) The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable. An applicant may voluntarily disclaim a component of a mark sought to be registered.

(b) No disclaimer, including those made under subsection (e) of section 1057 of this title, shall prejudice or affect the applicant's or registrant's rights then existing or thereafter arising in the disclaimed matter, or his right of registration on another application if the disclaimed matter be or shall have become distinctive of his goods or services.

In this case, the District Court determined that the mark KOOL PACK for soft-sided portable coolers had not acquired secondary meaning and that applicant was not entitled to register the word mark KOOL PAK on or in connection with its soft-sided portable coolers. As a result of that determination, the District Court ordered that applicant either delete any reference to the use of the word mark KOOL PAK on soft-sided portable coolers in this application or if there were no reference to soft-sided portable coolers, it was to include the following disclaimer:

No claim is made on the exclusive right to use the words "Kool Pak" on soft-sided portable coolers, apart from the mark as shown.

Applicant has now done exactly what the District Court has ordered. Since there is no reference to "soft-sided portable coolers" in the application, it has submitted a disclaimer in the format set out in the Court's order. While the board previously held that the submitted disclaimer was a disclaimer of applicant's entire mark and inconsistent with applicant's claim of distinctiveness in the application file, it is clear that applicant is seeking registration for its mark in three classes. Two of these classes are apparently not affected by the disclaimer. While the Court determined that applicant's mark had not acquired distinctiveness for soft-sided portable coolers<sup>5</sup>, the application contains goods that are not soft-sided portable coolers for which the application's claim of acquired distinctiveness is unaffected.

The District Court has required applicant to disclaim an unregistrable component of its mark. 15 U.S.C. § 1056. While the USPTO has policies on the disclaimers that have been upheld by the Federal Circuit,<sup>6</sup> the policies expressed in the TMEP are "not binding on this Board, and it is

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<sup>5</sup> Applicant admits that it "is seeking registration of its marks for goods that fall within the phrase used by the court, 'soft side portable coolers' (e.g., 'insulated carrying bags for beverage container six-packs, beverage container eight-packs, insulated lunch bags etc.')" Response to Order To Show Cause submitted May 9, 2000 at 1.

<sup>6</sup> See *Dena Corp. v. Belvedere International Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991).

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certainly not binding upon a court." *Capital Speakers Inc. v. Capital Speakers Club of Washington D.C. Inc.*, 41 USPQ2d 1030, 1035 (TTAB 1996). See also *West Florida Seafood, Inc. v. Jet Restaurants, Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1664 n.8 (Fed. Cir. 1994). It is clear that since "a mark which must be entirely disclaimed has no 'otherwise registrable' parts. Therefore, such marks do not qualify as composite marks for which the Commissioner may require a disclaimer." *Dena Corp.*, 21 USPQ2d at 1051. In this application, the Office has not required a disclaimer of the term "Kool Pak."

A pre-Lanham decision of the Court of Custom and Patent Appeals held:

Since that decision the Patent Office and the courts have recognized the right of registration in proper cases where parts of a proposed mark have been disclaimed, but we have not been cited to any case in which the right of registration has been upheld by any court where the issue involved a mark disclaimed in its entirety. In the absence of any persuasive authority to the contrary, we feel constrained to uphold the view of the commissioner in this case.

*In re Midy Laboratories, Inc.*, 104 F.2d 617, 42 USPQ 17, 18 (CCPA 1939). While this policy was incorporated into the Lanham Act,<sup>7</sup> there were some limitations to this policy, such as *Ex parte Pillsbury Flour Mills Co.*, 23 USPQ 168 (Comm'r Pat. 1934) (Applicant for the mark MINITMIX where the Commissioner held that: "A descriptive term is any one that would normally and naturally be employed by a

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<sup>7</sup> *Dena Corp.*, 21 USPQ2d at 1049.

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manufacturer in describing the particular goods upon which the mark is used. Would 'MINITMIX' be so employed? I do not believe so, particularly, if the applicant is required to disclaim the word 'MINIT' apart from the word 'MIX' and the word "MIX" apart from the word 'MINIT,' and I require the applicant to do so").

In this case, we have an unusual situation. The board had suspended the opposition proceeding because of a civil action between the parties. The court, after a jury verdict, did address the issues that were before the board and ordered applicant to submit a disclaimer of the term "Kool Pak," if there was no reference to soft-sided portable coolers in its application. The district court's decision was affirmed by the Fifth Circuit. There is no indication that opposer requested that the district court order be modified. Eventually, applicant submitted the disclaimer in the form that the District Court required.

Under the unique facts here, we reconsider the submission of the disclaimer. It is clear that this type of disclaimer would not be required by the Director or appropriate under most circumstances in other inter partes or ex parte cases. However, the statutory requirements for a disclaimer are not so absolute that it would prohibit us from accepting the court-ordered disclaimer here. The parties have litigated an issue, which had been pending

before the board, to a conclusion in Federal court. The board, if possible, should not permit parties to re-litigate issues that have been conclusively decided by the courts. As a result, we defer to the authority of the Federal courts to rectify the register and we accept the applicant's disclaimer. Therefore, applicant's disclaimer that "No claim is made to the exclusive right to use the words 'Kool Pak' on soft-sided portable coolers, apart from the mark as shown" will be entered into the record of the application.<sup>8</sup>

Acquired Distinctiveness

We next address the issue of whether applicant's mark KOOL PAK has acquired distinctiveness. Inasmuch as applicant has sought registration under the provision of Section 2(f), there is no issue that the mark is merely descriptive. *See Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) ("Where, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the statute accepts a lack of inherent distinctiveness as an established fact").

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<sup>8</sup> We note that the USPTO has accepted a similarly-worded disclaimer for soft-sided portable coolers, which were not listed in applicant's registration (No. 1841697). The goods in Class 21 were listed as "insulated carrying bags for beverage container six-packs, beverage container eight-packs, beverage container twelve-packs and for use as lunch bags; insulated carrying bags for single bottles; and soft insulated holding sleeves for beverage cans, beverage bottles, and wine and champagne bottles."

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An opposer challenging a mark on the ground that a mark has not acquired distinctiveness has the "initial burden of challenging or rebutting the applicant's evidence of distinctiveness made of record during prosecution which led to publication of the proposed mark." *Yamaha*, 6 USPQ2d at 1004. In this case, opposer has met its burden, at a minimum, by showing that the district court has determined that the mark in this application had not acquired distinctiveness. However, "applicant has the ultimate burden of showing acquired distinctiveness regardless of whether the lack of inherent distinctiveness or the applicability of Section 2(e) was shown by the opposer during the opposition or conceded by the applicant prior to the opposition." *Id.* at 1008.

We add that the burden increases as the descriptiveness of the mark increases. *Yamaha* at 1008 (Federal Circuit has commented that "logically that standard becomes more difficult to meet as the mark's descriptiveness increases").

We also note that the jury specifically found that the "words "KOOL PACK" as used by Kool Pak on or in connection with its soft-sided portable coolers have not acquired secondary meaning." Furthermore, we have already indicated that applicant's disclaimer of the term KOOL PACK is acceptable. Section 6(b) of the Trademark Act specifically provides that "No disclaimer ... shall prejudice or affect the

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applicant's ... rights then existing or thereafter arising in the disclaimed matter, or his right of registration on *another application* if the disclaimed matter be or shall have become distinctive of his goods or services" (emphasis added). "It is clear that a disclaimer does not preclude registrant, as a matter of law, *from later demonstrating in another application*, for example, rights in the disclaimed matter if it can show that the disclaimed words have, with time and use, become distinctive of such goods or services." *In re DNI Holdings Ltd.*, 77 USPQ2d 1435, 1442 (TTAB 2005) (emphasis added).

Applicant argues that its "attempts to comply with the District Court's 1998 disclaimer order do not preclude a finding of acquired distinctiveness." Brief at 16. We agree that applicant is not precluded from subsequently showing that its mark has acquired distinctiveness, however, applicant has not filed another application. Its application, filed December 9, 1993, remains before the board. As we previously discussed, we have accepted applicant's disclaimer of the term KOOL PAK that was submitted as a result of the district court order. Applicant is free to submit another application to assert that its mark has acquired distinctiveness. It may not provide the court-ordered disclaimer and argue, in this application, that the disclaimed matter has acquired

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distinctiveness. Therefore, the issue of whether applicant's mark has acquired distinctiveness for the goods in Class 21 is moot.

Decision: Inasmuch as opposer is no longer opposing the goods in Class 9 and 18 and acceptance of the disclaimer has mooted the issue of acquired distinctiveness in Class 21, the opposition is dismissed as moot.