



Federal Circuit Rejects "Reasonable Manners" Test For Determining Scope of Standard Character Mark During Ex Parte Examination

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Viterra Inc. applied to register XCEED in standard character form for "agricultural seed." The examining attorney refused registration, and the Board affirmed, based on likelihood of confusion with the following registered mark for "agricultural seeds."



On appeal to the Federal Circuit, Viterra conceded that the goods were the same, but it argued that there was no likelihood of confusion as a result of differences in the marks. Viterra contended that its proposed standard character mark should not be construed so broadly as to cover the distinctive form of the registered mark. The court disagreed and affirmed the Board's decision refusing registration. *In re Viterra Inc.*, 101 U.S.P.Q.2d 1905 (Fed. Cir. March 6, 2012).

As the court observed, an application to register a standard character mark is "without claim to any particular font style, size, or color." 37 C.F.R. § 2.52(a). Traditionally, the Board used the "reasonable manners" test to determine the scope of a standard character mark. That is, it considered all *reasonable* depictions of the mark when comparing it to another mark to determine the presence or absence of likelihood of confusion. However, the Federal Circuit rejected this "reasonable manners" test in *Citigroup v. Capital City Bank Group, Inc.*, 637 F.3d 1344 (Fed. Cir. 2011), an inter partes proceeding involving competing standard character marks. In *Viterra*, the court held that the "reasonable manners" test is also improper when comparing a standard character mark and a word/design composite mark in the context of *ex parte* examination.



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The court explained, quoting *Citigroup*: "The T.T.A.B. should not first determine whether certain depictions are 'reasonable' and then apply the *Du Pont* analysis to only a subset of variations of a standard character mark." Rather, "the T.T.A.B. should simply use the *DuPont* factors to determine the likelihood of confusion between depictions of standard character marks that vary in font style, size, and color and the other mark." The court found no basis for limiting *Citigroup* to comparisons of word marks, and no basis for distinguishing between *inter partes* proceedings and *ex parte* examination.

In view of the foregoing, the court concluded, the Board was correct to find likelihood of confusion between the marks at issue. After all, the applicant's XCEED mark could be depicted as a capital "X" followed by "ceed" in small letters, making it similar to the registered mark. Insofar as the T.T.A.B. applied the more restrictive and outdated "reasonable manners" test, it was harmless error.

Trademark users must remember *Viterra* when considering new marks, and trademark practitioners must keep *Viterra* in mind during clearance. A registered word/design composite mark might create a conflict with a would-be applicant's standard character mark – even if the applicant would never consider depicting its mark in that fashion.

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