

# NOTES

## *In re Louisiana Fish Fry Products*: Shifting the Weight of Acquired Distinctiveness for Descriptive Terms in Trademark Law

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### I. OVERVIEW OF THE CASE

Louisiana Fish Fry Products, Ltd. (Louisiana Fish Fry) filed a use-based trademark application with the United States Patent and Trademark Office (USPTO) for the mark “LOUISIANA FISH FRY PRODUCTS BRING THE TASTE OF LOUISIANA HOME!” to identify some of its products, including marinade, sauce mixes, and gumbo.<sup>1</sup> During prosecution, the examining attorney refused to register the mark without a disclaimer of the term “FISH FRY PRODUCTS” because the term was not “independently registrable.”<sup>2</sup> In order to show that the term was independently registrable, Louisiana Fish Fry submitted the following evidence: (1) proof that it had used the mark “LOUISIANA FISH FRY PRODUCTS” for over thirty years, (2) sales and advertising data related to products bearing “LOUISIANA FISH FRY PRODUCTS,” and (3) previous registrations that contained the mark, “LOUISIANA FISH FRY PRODUCTS.”<sup>3</sup>

The examining attorney responded that the term “FISH FRY PRODUCTS” was not independently registrable because it was “generic,” and because it had not “acquired distinctiveness.”<sup>4</sup> Furthermore, the examining attorney held that the term was “generic” because the relevant public understood the term to refer to sauces, marinades and spices used on or with fried fish.<sup>5</sup> Additionally, the

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1. *In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 1334 (Fed. Cir. 2015).

2. *Id.*

3. *Id.* The previous registrations were for the mark LOUISIANA FISH FRY PRODUCTS, Registration No. 2801892, in standard character form, and for the mark LOUISIANA FISH FRY PRODUCTS, Registration No. 2827058, and design. In both of these registrations, Louisiana Fish Fry disclaimed the exclusive right to use the term “Products.” *In re La. Fish Fry Prods., Ltd.*, No. 77816809 2013 WL 3191197, at \*2 (T.T.A.B. May 24, 2013).

4. *In re La. Fish Fry Prods.*, 797 F.3d at 1334.

5. *Id.*

examining attorney concluded that Louisiana Fish Fry did not show that the term had “acquired distinctiveness” because the evidence it submitted was for the term “LOUISIANA FISH FRY PRODUCTS” and not for the specific term in question here, “FISH FRY PRODUCTS.”<sup>6</sup> Louisiana Fish Fry then appealed to the USPTO’s Trademark Trial and Appeal Board (Board), which affirmed the examining attorney’s decision.<sup>7</sup> The United States Court of Appeals for the Federal Circuit *held* that when substantial evidence supports the determination that a term has not acquired distinctiveness, it need not also examine whether that term is generic before denying trademark registration on the basis that the term is not independently registrable. *In re Louisiana Fish Fry Products, Ltd.*, 797 F.3d 1332 (Fed. Cir. 2015).

## II. BACKGROUND

A trademark is a mark used by a person to “identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others.”<sup>8</sup> The Lanham Act gives a seller or producer the exclusive right to register a trademark.<sup>9</sup> Generally, the goals of providing trademark protection are to prevent consumer confusion of products, and to protect a producer from unfair competition by assuring that it reaps the financial rewards associated with its product.<sup>10</sup> The Act also provides that a trademark applicant may be required to disclaim “an unregistrable component of a mark otherwise registrable,” and that the applicant may voluntarily disclaim that component for a mark to be registered.<sup>11</sup> Furthermore, the USPTO can condition the registration of an applicant’s mark on such a disclaimer.<sup>12</sup> This disclaimer assures that an applicant cannot claim exclusive rights to these unregistrable components of a mark.<sup>13</sup>

The United States Supreme Court has acknowledged that terms can be classified as one of five general categories of “distinctiveness”: generic, descriptive, suggestive, arbitrary, or fanciful.<sup>14</sup> In identifying

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6. *Id.*

7. *Id.* at 1335. The Board expanded on the examining attorney’s reasoning for the “genericness” issue, holding that the term “FISH FRY PRODUCTS” is generic because the terms “FISH FRY” and “PRODUCTS” retain their “generic significance” when combined. *Id.*

8. 15 U.S.C. § 1127 (2012).

9. *Id.* § 1502; *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995).

10. *Qualitex*, 515 U.S. at 163-64.

11. 15 U.S.C. § 1056(a).

12. *In re Stereotaxis, Inc.*, 429 F.3d 1039, 1041 (Fed. Cir. 2005).

13. *In re Wada*, 194 F.3d 1297, 1300-01 (Fed. Cir. 1999).

14. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992).

these five distinctions, the Supreme Court has recognized that terms of the latter three categories are “inherently distinctive and are entitled to protection.”<sup>15</sup> On the other hand, “generic” terms are not registrable as trademarks.<sup>16</sup> Generic terms are “[m]arks that constitute a common descriptive name[,] . . . one[s] that refer[] to the genus of which the particular product is a species.”<sup>17</sup> The burden of proof is on the Board to determine whether a term is “generic.”<sup>18</sup> Courts refuse to register generic terms as trademarks, and a registered mark may be canceled at any time if it is later determined to be generic.<sup>19</sup> Unlike the other four terms, classification of a term as “descriptive” does not automatically determine whether it is registrable as a trademark.<sup>20</sup>

Section 2(e) of the Lanham Act allows for the refusal of a mark’s registration if it is “merely descriptive” of the applicant’s goods.<sup>21</sup> A term is “merely descriptive” if it “describes the qualities or characteristics of a good or service.”<sup>22</sup> Despite the restriction of section 2(e), an applicant’s descriptive mark may be registered if it “has become distinctive of the applicant’s goods in commerce.”<sup>23</sup> Furthermore, in determining whether a mark has become distinctive, the USPTO “may accept as prima facie evidence . . . proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made.”<sup>24</sup> Taken together, these provisions of the Lanham Act dictate that a “merely descriptive” term is not registrable unless it has “acquired distinctiveness” in the market through its use in connection with the applicant’s goods.<sup>25</sup>

The Supreme Court has clarified that a mark can be protected under trademark law if it has acquired distinctiveness through “secondary

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15. *Id.*

16. *Id.*

17. *Park ’N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194 (1985).

18. *See In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 1361 (Fed. Cir. 2009). “Genericness” is a factual determination that must be supported by “substantial evidence.” *Id.*

19. *Park ’N Fly*, 469 U.S. at 194; *see also In re Merrill Lynch*, 828 F.2d 1567, 1569 (Fed. Cir. 1987) (“Generic terms, by definition incapable of indicating source, are the antithesis of trademarks, and can never attain trademark status.”).

20. *Park ’N Fly*, 469 U.S. at 194.

21. 15 U.S.C. § 1052(e)(1) (2012).

22. *Park ’N Fly*, 469 U.S. at 194; *see also In re Oppedahl*, 373 F.3d 1171, 1173 (Fed. Cir. 2004) (“A mark is merely descriptive if ‘it consist[s] merely of words descriptive of the qualities, ingredients or characteristics of’ the goods or services related to the mark.” (quoting *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 534 (1920))).

23. 15 U.S.C. § 1052(f). This provision further supports the purpose of a trademark to protect a producer’s exclusive right to the value of his or her distinctive product in the market without unfair competition.

24. *Id.*

25. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992).

meaning.”<sup>26</sup> In order to establish that a mark has acquired secondary meaning, an applicant must prove that “in the minds of the public, the primary significance of a [mark] is to identify the source of the product rather than the product itself.”<sup>27</sup> The Lanham Act provides examples of evidence of acquired distinctiveness, including “proof of substantially exclusive and continuous use . . . by the applicant in commerce for the five years” before the claim of distinctiveness is made.<sup>28</sup> Additionally, the Federal Circuit has held that applicants can bring forth evidence of advertising expenditures, sales success, length and exclusivity of use, unsolicited media coverage, and consumer studies to prove that a mark has acquired distinctiveness.<sup>29</sup>

While courts have recognized that “descriptive” terms may acquire distinctiveness under section 2(f) of the Lanham Act, they refuse to allow “generic” terms to acquire distinctiveness.<sup>30</sup> The paramount case in deciding that “generic” terms are not subject to the section 2(f) exception of “acquired distinctiveness” is *H. Marvin Ginn Corp. v. International Ass’n of Fire Chiefs, Inc.*<sup>31</sup> There, the Federal Circuit laid out the rationale for why a “generic” term cannot acquire distinctiveness under the Lanham Act:

A generic term is the common descriptive name of a class of goods or services, and . . . it can never be registered as a trademark because such a term is “merely descriptive” within the meaning of § 2(e)(1) [of the Lanham Act] and is incapable of acquiring de jure distinctiveness under § 2(f). The generic name of a thing is in fact the ultimate in descriptiveness.<sup>32</sup>

In other words, because a generic term is the “ultimate in descriptiveness,” it cannot ever take on a secondary meaning to have acquired distinctiveness under the Lanham Act.<sup>33</sup>

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26. *Id.*

27. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 211 (2000) (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 (1982)). It is important to note that unlike for “genericness,” the burden of proof is on the trademark applicant to prove that its term has acquired distinctiveness. *In re Steelbuilding.com*, 415 F.3d 1293, 1297 (Fed. Cir. 2005).

28. 15 U.S.C. § 1052 (f).

29. *In re Steelbuilding.com*, 415 F.3d at 1300.

30. *See, e.g., In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 1569 (Fed. Cir. 1987) (reasoning that allowing trademark protection for generic terms would grant the owner “the mark of a monopoly” because competitors would not be able to describe goods as what they are if generic terms were exclusively provided to a first user); *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 1559 (Fed. Cir. 1985) (holding that a common descriptive name is not a trademark because it “is not capable of distinguishing an applicant’s goods”).

31. 782 F.2d 987 (Fed. Cir. 1986).

32. *Id.* at 989.

33. *Id.*

Thus, a court must determine whether a descriptive term is “generic” so as to decide whether it is appropriate to examine whether that term may acquire distinctiveness under the Act. The *Marvin Ginn* court set forth a two-step inquiry for determining whether a term is generic: (1) “what is the genus of goods or services at issue?” and (2) “is the term sought to be registered . . . understood by the relevant public primarily to refer to that genus of goods or services?”<sup>34</sup> This test is meant to shed light on the “meaning [of the term] to the usual buyer or other relevant members of the public.”<sup>35</sup> If the public associates the term to refer to the “genus of goods or services in question,” then the term is generic, is barred from acquiring distinctiveness, and cannot be registered as a trademark.<sup>36</sup>

In other Federal Circuit cases, the court has followed the *Marvin Ginn* framework in determining first whether a term is generic, and then whether it has acquired sufficient distinctiveness to be registrable.<sup>37</sup> For instance, in *In re Hotels.com, L.P.*, the court determined that the term “HOTELS.COM” was generic and unregistrable because it did not acquire distinctiveness.<sup>38</sup> There, the court was ultimately determining whether adding the clearly generic term “hotels,” with a “.com” designation, negated the genericness of the independently generic term.<sup>39</sup> The court reasoned that the sum of terms, “HOTELS.COM,” was still compositely generic in describing the genus of the site’s services (i.e., that “applicant operates a commercial website . . . that provides information about hotels”).<sup>40</sup> Another case in the Federal Circuit, *In re Steelbuilding.com*, exemplifies the next stage in the analysis.<sup>41</sup> The court first determined that the mark “STEELBUILDING.COM” was not generic because it was not the genus of the goods or services that the website was selling.<sup>42</sup> Next, the court examined whether the evidence

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34. *Id.* at 990.

35. *Id.* at 989.

36. *Id.*

37. *See In re Hotels.com*, 573 F.3d 1300 (Fed. Cir. 2009); *In re Steelbuilding.com*, 415 F.2d 1293 (Fed. Cir. 2005); *In re Dial-O-Mattress Operating Corp.*, 240 F.3d 1341 (Fed. Cir. 2001).

38. *In re Hotels.com*, 573 F.3d at 1306.

39. *Id.* at 1303.

40. *Id.* at 1304; *see also In re 1800Mattress.com IP, LLC*, 586 F.3d 1359 (Fed. Cir. 2009) (holding that substantial evidence supported the Board’s conclusion that the mark “MATTRESS.COM” is generic).

41. 415 F.3d 1293.

42. *Id.* at 1298. The court first characterized the applicant’s site as not only simply a “catalog” for steel building, but also a service that enables customers to create, price, and purchase a unique building design. *Id.* It then clarified that “the record does not show substantial

presented by the applicant sufficiently met the burden of proof for acquired distinctiveness.<sup>43</sup> After examining the evidence, including advertising, sales, and name recognition data, the court ultimately concluded that none of the evidence presented established “a concomitantly high level of secondary meaning” for the mark in question, and therefore affirmed the denial of registration.<sup>44</sup> *In re Dial-a-Mattress Operating Corp.* went through the framework and not only determined that the term in question (“1-888-M-A-T-R-E-S-S”) was not generic, but also that it had acquired distinctiveness and was therefore subject to trademark protection.<sup>45</sup> First, the court held that substantial evidence did not support the conclusion that the mark was generic because there was no record evidence that the relevant public understood that term to refer to all “shop-at-home telephone mattress retailers.”<sup>46</sup> On the question of acquired distinctive-ness, the court concluded that the evidence of the applicant’s previously registered marks, which were “legally equivalent” to the mark in question, established prima facie evidence of acquired distinctiveness to support registration of the term pursuant to section 2(f) of the Lanham Act.<sup>47</sup> These cases not only exemplify the established functionality of the *Marvin Ginn* framework, but also the consistency of its use when courts are determining whether a term is merely descriptive or has acquired distinctiveness sufficient to merit trademark protection.

### III. THE COURT’S DECISION

In the noted case, the Federal Circuit circumvented the traditional application of *Marvin Ginn* by focusing only on whether the term had “acquired distinctiveness” to determine that the mark was subject to a disclaimer.<sup>48</sup> First, the Court determined that it did not need to make a showing of “genericness” after concluding that the “highly descriptive” term had acquired distinctiveness.<sup>49</sup> Next, it agreed with the Board that substantial evidence supported the conclusion that Louisiana Fish Fry had not established that the term had acquired distinctiveness.<sup>50</sup> Last, the

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evidence that ‘STEELBUILDING,’ in its common usage, is a compound word used to mean either ‘steel building’ or ‘steel buildings.’” *Id.*

43. *Id.* at 1300.

44. *Id.* at 1300-01.

45. 240 F.3d 1341, 1348 (Fed. Cir. 2001).

46. *Id.* at 1346.

47. *Id.* at 1347-48.

48. *In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 1336 (Fed. Cir. 2015).

49. *Id.*

50. *Id.*

Court concluded that the Board's decision did not violate the "reasoned decisionmaking" doctrine because the Board supported its decision with detailed reasoning.<sup>51</sup>

After setting the statutory and precedential framework, the Court determined that it did "not need to reach the Board's genericness determination because . . . substantial evidence supports the Board's determination that Louisiana Fish Fry failed to show that "FISH FRY PRODUCTS" has acquired distinctiveness."<sup>52</sup> While the Court did cite to *Marvin Ginn's* holding that a generic mark cannot acquire distinctiveness, it ultimately decided not to follow the same framework other courts have utilized to determine whether a descriptive term may be registrable under section 2(f) of the Lanham Act.<sup>53</sup> Instead of first determining whether the term was "generic" or "merely descriptive," the Court decided that because the term "FISH FRY PRODUCTS" was at the very least "highly descriptive," determining that it had not acquired distinctiveness was sufficient to require a disclaimer.<sup>54</sup> It noted that since the term was "highly descriptive" the applicant had a more difficult burden to establish a secondary meaning, which it ultimately was unable to meet.<sup>55</sup>

The Court next examined the evidence that Louisiana Fish Fry put forth to prove that the term had acquired distinctiveness.<sup>56</sup> Louisiana Fish Fry's evidence included declarations from its president and five registrations that included the term "FISH FRY PRODUCTS."<sup>57</sup> In one of these declarations, the company's President stated that Louisiana Fish Fry's "substantially exclusive and continuous use" of the mark for at least the past five years had established that it had become distinctive.<sup>58</sup> The Court noted that although such evidence may be used as prima facie evidence of acquired distinctiveness, the statute does not require the USPTO to do so; therefore, the Board was within its discretion not to accept this evidence.<sup>59</sup> Additionally, although Louisiana Fish Fry put forth data of gross sales and advertising expenditures, the Court concluded that this data was in reference to uses of the mark "LOUISIANA FISH FRY PRODUCTS" and did not establish that the

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51. *Id.* at 1337.

52. *Id.* at 1336.

53. *Id.*

54. *Id.*

55. *Id.* at 1336-37.

56. *Id.* at 1336.

57. *Id.*

58. *Id.*

59. *Id.* at 1336-37.

term “FISH FRY PRODUCTS” alone had acquired distinctiveness.<sup>60</sup> Additionally, the Federal Circuit determined that evidence of Louisiana Fish Fry’s previous five registrations did not have a bearing on the acquired distinctiveness of the specific term at issue in the noted case (i.e., “FISH FRY PRODUCTS”).<sup>61</sup> Taken altogether, the Court determined that this evidence did not support Louisiana Fish Fry’s claim that the term in question had sufficiently acquired distinctiveness to support registration.<sup>62</sup>

Lastly, the Court raised and dismissed Louisiana Fish Fry’s final point of contention that the Board’s decision violated the “reasoned decisionmaking” doctrine.<sup>63</sup> Since the Board provided detailed reasons for its determination that the term “FISH FRY PRODUCTS” had not acquired distinctiveness, the Court held that its decision did not violate this doctrine.<sup>64</sup> After dismissing that last point of contention, the Court held that Louisiana Fish Fry did not fulfill its burden of showing that “FISH FRY PRODUCTS” had acquired distinctiveness and affirmed the USPTO’s decision to refuse to register the mark without a disclaimer of the term.<sup>65</sup>

Circuit Judge Newman wrote a concurring opinion in the noted case criticizing the Court’s decision to deny the registration only because it had not acquired distinctiveness.<sup>66</sup> Newman explained that “[t]he panel majority’s focus solely on ‘acquired distinctiveness’ presupposes that trademark status is here available; that is, that ‘fish fry products’ is not a generic or common descriptive name for these products, and would not be so recognized by the consuming public.”<sup>67</sup> The concurring opinion then detailed the Board’s examination of “FISH FRY PRODUCTS” as a “generic” term, and approved its conclusion that the relevant public understood “the term to identify a type of sauce, marinade or spice used for fish fries.”<sup>68</sup> Judge Newman further clarified that the important

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60. *Id.* at 1337.

61. *Id.* The court elaborated that three of those registrations were for the mark “LOUISIANA FISH FRY PRODUCTS BRING THE TASTE OF LOUISIANA HOME!” while the other two registrations were for the mark “LOUISIANA FISH FRY.” *Id.*

62. *Id.*

63. *Id.* The “reasoned decisionmaking” doctrine simply provides that agency decision must be logical and rational, such that it is sufficiently supported by the reasons that the agency adduces. *Allentown Mack Sales & Serv., Inc. v. NLRB*, 522 U.S. 359, 374 (1998).

64. 797 F.3d at 1337.

65. *Id.*

66. *Id.* at 1338 (Newman, J., concurring).

67. *Id.*

68. *Id.* at 1340 (quoting *In re La. Fish Prods. Ltd.*, No. 77816809, 2013 WL 3191197, at \*4 (T.T.A.B. May 24, 2013)).

question on appeal was whether the term in question was “generic” or “merely descriptive,” and that the Court’s ruling should have “clearly stated” this conclusion in going through the weight of evidence of acquired distinctiveness.<sup>69</sup>

#### IV. ANALYSIS

The majority’s decision in the noted case may have significant ramifications on the way in which examining attorneys, the USPTO, and ultimately courts examine descriptive terms in trademark law. While on the facts of the case the Court was unable to conclude that the term had acquired distinctiveness, it essentially opened the door for an argument around the traditional “generic”-“merely distinctive” dichotomy. This would allow an applicant whose descriptive term has acquired distinctiveness to completely avoid the question of “genericness” en route to gaining exclusive trademark rights to that term.

Although the Lanham Act sets out the general rule that a descriptive term can only be protectable if it has become distinctive, it does not limit this to “merely descriptive” terms.<sup>70</sup> While it is clear that the determination that a term is or has become “generic” may provide a basis for cancelling a trademark, it is less clear what happens when a formerly “generic” term has acquired sufficient distinctiveness to transgress it into a “merely descriptive” term subject to registration.<sup>71</sup> The majority’s reasoning suggests that an applicant may use the “acquired distinctiveness” argument to salvage a descriptive term from the “generic” abyss in order to gain trademark protection of that term.

This not only alters the framework of analysis for descriptive terms, but from a practical standpoint, it shifts the burden of proof from the Board to the applicant in asserting its right to trademark protection. This is because an applicant has the burden to prove that a term has acquired distinctiveness and the Board has the burden to prove that a term is “generic.”<sup>72</sup> Thus, an applicant with strong supporting evidence that the term in question has acquired a strong secondary meaning would be able to attain trademark protection through a presumption of applicability to section 2(f) of the Lanham Act.

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69. *Id.* at 1341.

70. 15 U.S.C. § 1052 (f) (2012).

71. See generally Marc C. Levy, *From Genericism to Trademark Significance: Deconstructing the De Facto Secondary Meaning Doctrine*, 95 TRADEMARK REP. 1197 (2005) (describing the difficulty that courts have in determining whether a trademark can be “captured” from a term that was once generic).

72. *In re Steelbuilding.com*, 415 F.3d 1293, 1296 (Fed. Cir. 2005); *Yamaha Int’l Corp. v. Hoshino Goloki Co.*, 840 F.2d 1572, 1578-79 (Fed. Cir. 1988).

The concurrence's formulation of the issues, and ultimately its conclusions, appear to be more consistent with precedential authority.<sup>73</sup> Following the traditional framework, established after the *Marvin Ginn* decision, a court would first determine whether a term was "merely descriptive" before deciding if it had sufficiently "acquired distinctiveness" to merit registration under section 2(f) of the Lanham Act.<sup>74</sup> The noted case alters this framework by making a presumption that the term in question is "merely descriptive" and therefore subject to protection based solely on an applicant's showing of "acquired distinctiveness." While this may be beneficial in allowing applicants to "recapture" a term whose "generic" classification may be obsolete, it has the potential to undermine one of the main purposes of trademark law. Allowing for an applicant to gain the exclusive rights to use a "generic" term based solely on "acquired distinctiveness" gives that applicant a competitive advantage by foreclosing the use of that term from others in the market wishing to merely describe their goods to consumers.

Jacob E. Kronish\*

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73. 797 F.3d at 1338 (Newman, J., dissenting).

74. See, e.g., *In re Hotels.com L.P.*, 573 F.3d 1300 (Fed. Cir. 2009); *In re Steelbuilding.com*, 415 F.3d 1293 (Fed. Cir. 2005); *In re Dial-a-Mattress Operating Corp.*, 240 F.3d 1341 (Fed. Cir. 2001).

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