

# World Trademark Review *Daily*

**Owner of descriptive trademark has no protectable rights in the mark  
United States - McDermott Will & Emery LLP**

**Confusion**

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In *Knights Armament Co v Optical Systems Tech Inc* (Case 09-14480, September 2 2011), addressing the issue of the descriptiveness of the trademark UNIVERSAL NIGHT SIGHT, the US Court of Appeals for the Eleventh Circuit has affirmed the district court's holding that the trademark was descriptive and lacked secondary meaning, thus preventing any rights to sue for trademark infringement.

The parties disputed the ownership of two trademarks used in the manufacturing and marketing of clip-on night vision devices: UNIVERSAL NIGHT SIGHT and UNS. The parties were originally partners in developing, manufacturing and marketing these night vision devices, but had a falling out. Defendant Optical Systems Technology Inc was the original manufacturer and contracted with plaintiff Knights Armament Co to market and distribute the products.

After the falling out, the parties sued each other for trademark infringement and trade secret misappropriation, among other counts. It was undisputed that the defendant was the senior user of the marks. The district court, after a bench trial, found that the plaintiff did not infringe the defendant's trademarks because the marks were merely descriptive and had not achieved secondary meaning. The district court also granted summary judgment for the plaintiff against the defendant's counterclaims of trade secret misappropriation based on the running of the statute of limitations. Both parties appealed.

The Eleventh Circuit affirmed. Concerning the trademark issues on appeal, the Eleventh Circuit held that Universal Night Sight and UNS were used interchangeably and were not independent marks. The court held that the relevant community (military and government purchasers of night vision products) can readily perceive the nature of the product - that is, having "night sight" or the ability to see at night, without the consumers having to use his or her imagination. Thus, 'night sight' was a descriptive term used to refer to goods that enable snipers to observe targets at night. The court found that the addition of the word 'universal' did not distinguish the overall mark. The court then determined that the trademark had not acquired secondary meaning, because there was no indication that the trademark belonged to the defendant and not the plaintiff, so the consumers had no reason to associate the mark with either company. Therefore, the defendant could not prevail on its trademark infringement claims.

Concerning the defendant's trade secret misappropriation issues, the Eleventh Circuit held that the defendant did not bring its claims within the three-year statute of limitations of the Florida Uniform Trade Secrets Act. The defendant argued that it had only heard rumours of the misappropriation, but that no concrete evidence had triggered the running of the statute. The court noted, but made no holding, that other circuits have typically found that suspicions and concerns regarding trade secret misappropriation were insufficient to trigger the running of the statute. The court determined, however, that the defendant had admitted during discovery that it was aware of the trade secret misappropriation more than three years prior to filing the counterclaims, and thus held the claims barred.

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