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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Signature Brands, Inc. substituted for
Health o Meter, Inc.

v.

Dallas Technologies Corporation

Opposition No. 96,032
to application Serial No. 74/469,776
filed on December 16, 1993

Mark Kusner of D. Peter Hochberg Co., L.P.A. for Signature
Brands, Inc. substituted for Health o Meter, Inc.

D. Bruce Gardiner of Gardiner Law Firm for Dallas
Technologies Corporation.

Before Seeherman, Hairston and Walters, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by Dallas Technologies
Corporation to register the mark MR. BEER for "beer
manufacturing kit, consisting of a large clear plastic
fermenting bottle, 6 P.E.T. plastic bottles with lids, 4

Opposition No. 96,032

pounds of malt extract, one packet of yeast, and instructions."¹

Registration has been opposed by Signature Brands, Inc. on the ground of likelihood of confusion between applicant's mark and opposer's previously used and registered mark MR. COFFEE for "coffee brewers and disposable coffee filters"²; "decanter"³; "electric domestic warming plates"⁴; "coffee"⁵; "cleaning compositions for coffee and/or tea brewing apparatus"⁶; "kitchen appliances; namely, water filtering units for producing potable water for domestic use, electric juicers, electric mug and carafe warmers, and electric hand held blenders"⁷; and "kitchen appliances; namely electric cappuccino and espresso makers for domestic use; dessicating units for producing dried foods; [and] electric potato bakers."⁸ Also, opposer, in an amended opposition alleges that applicant has intended to deceive the public through misuse of the federal registration symbol and statements in

¹ Application Serial No. 74/469,776 filed December 16, 1993, alleging a bona fide intention to use the mark in commerce. The term "Beer" is disclaimed apart from the mark as shown.

² Registration No. 1,018,778 issued August 26, 1975; renewed. The term "Coffee" is disclaimed apart from the mark as shown.

³ Registration No. 1,089,737 issued April 18, 1978; Sections 8 & 15 affidavit filed. The term "Coffee" is disclaimed apart from the mark as shown.

⁴ Registration No. 1,142,407 issued December 9, 1980; Sections 8 & 15 affidavit filed. The term "Coffee" is disclaimed apart from the mark as shown.

⁵ Registration No. 1,343,074 issued June 18, 1985; Sections 8 & 15 affidavit filed. The term "Coffee" is disclaimed apart from the mark as shown.

⁶ Registration No. 1,651,275 issued July 23, 1991.

⁷ Registration No. 1,875,877 issued January 24, 1995.

Opposition No. 96,032

advertising and product materials that MR. BEER is a registered trademark. Applicant, in its answer, denied the allegations with respect to likelihood of confusion. The answer was deemed amended to deny that applicant had an intent to deceive the public.

The record consists of the pleadings; the file of the involved application; and trial testimony taken by both parties (with related exhibits). Opposer submitted under notices of reliance, inter alia, certified copies of its pleaded registrations; applicant's answers to several of opposer's interrogatories and requests for admissions; status and information sheets issued by the PTO for certain of the third-party registrations relied on by applicant which show that such registrations have been canceled or have expired; the file wrapper and contents of two abandoned trademark applications for marks consisting of "MR."; copies of newspaper and magazine articles about opposer's products; and copies of advertisements of opposer's and applicant's products. Applicant submitted under notice of reliance copies of third-party registrations of marks consisting of "MR." and its responses to other of opposer's interrogatories and requests for admission.⁹

⁸ Registration No. 1,914,763 issued August 29, 1995.

⁹ Opposer objected to applicant's submission of these responses on the grounds that applicant may not rely on its own responses and that the responses constitute hearsay. Applicant, however, maintains that pursuant to Trademark Rule 2.120(j)(5) the

Opposition No. 96,032

Both parties filed briefs on the case, but no oral hearing was requested.

The record indicates that opposer's predecessor first used the MR. COFFEE mark in 1970 on coffee. Opposer currently markets under the MR. COFFEE mark coffee makers, espresso/cappuccino makers, warming plates, thermal carafes, coffee filters, ice tea makers, hot tea makers, bread makers, food dehydrators and water filters. MR. COFFEE products are sold nationwide in mass merchandisers, department stores and through catalogs and television marketing. Opposer distributes MR. COFFEE products to department stores through a distributor named PHD Inc. PHD Inc. has sold MR. COFFEE products to department stores for approximately nineteen years.

responses should in fairness be considered so as to not make misleading the responses which were offered by opposer in its notice of reliance. The purpose of the fairness provision of Rule 2.120(j)(5) is to allow an answering party to avoid an unfair interpretation of responses relied on by the propounding party which contain less than all of the relevant information. The responses relied on by opposer concern when applicant first used the registration symbol, who was responsible for the use, and whether the registration symbol was currently in use. The responses relied on by applicant concern when applicant became aware that the use of the registration symbol was improper, what action applicant took to cease use, and the identification of documents pertaining to applicant's use of the registration symbol. We believe that, in fairness, applicant should be allowed to rely on these responses which contain information relevant to its alleged misuse of the registration symbol. Also, opposer's objection to the responses on hearsay grounds is not well-taken.

Opposition No. 96,032

For the period 1990 through 1995 opposer's sales of MR. COFFEE products exceeded \$800,000,000. In 1995 MR. COFFEE coffee makers were the largest selling brand of automatic drip coffee makers in the United States, comprising 31% of all automatic drip coffee makers sold. For the same year, opposer's espresso/cappuccino maker was one of the top four selling brands in the United States.

MR. COFFEE products are advertised to consumers through television and magazine advertising. MR. COFFEE advertisements have appeared in many well-known magazines such as People, Better Homes & Gardens, and Food & Wine. For the period 1990 through 1995, opposer spent over \$89,000,000 in advertising products with the MR. COFFEE mark.¹⁰

In an effort to police its mark, opposer has opposed registration of other applications for marks consisting of "MR." for kitchen appliances.

Although an intent to use application, the record shows that applicant began sales of its beer manufacturing kit as early as March 1995. Applicant advertises in magazines, through direct mail pieces to retailers, and at trade shows. Applicant's beer making kits are sold in mass merchandisers

¹⁰ Applicant has objected to the information concerning opposer's sales and advertising as being hearsay. However, inasmuch as opposer's witness, John Lange, testified that the information was compiled from records kept in the regular course of opposer's business, applicant's objection is not well taken.

Opposition No. 96,032

and department stores. PHD, Inc. is also the distributor of applicant's beer making kits to department stores. The record shows that the parties' goods are sold in some of the same stores and have been featured in some of the same store advertisements.

Inasmuch as certified copies of opposer's pleaded registrations are of record, there is no issue with respect to opposer's priority. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

We turn then to the issue of likelihood of confusion.

Opposer maintains that the respective goods of the parties are closely related because they are housewares. However, in determining whether two or more products are closely related, it is not enough that the products may be classified in the same category or that a term can be found that describes the products. See *In re Cotter and Company*, 179 USPQ 828 (TTAB 1973) and *In re The Barash Company, Inc.*, 132 USPQ 548 (TTAB 1962). Rather, the circumstances surrounding the marketing of the goods must be such that the marks are likely to be encountered by the same persons under conditions that could give rise to the mistaken belief that they are in some way associated with the same source. *Monsanto Co. v. Enviro-Chem Corp.*, 199 USPQ 590 (TTAB 1978). We recognize that opposer's coffee and tea makers, other

Opposition No. 96,032

kitchen appliances and accessories and applicant's beer making kit are marketed through the same trade channels and may be purchased by the same ultimate end users. However, there are marked differences between opposer's coffee and tea makers, other kitchen appliances and accessories and applicant's beer making kit. The parties' goods are very different in nature and are used for distinct purposes. Applicant's product is a kit consisting of specialized equipment and ingredients for making beer. Opposer's goods, on the other hand, are electrical devices and accessories which are used to prepare food and coffee and tea. There is no evidence that opposer sells any of the equipment or ingredients contained in applicant's kit. Nor is there evidence that other manufacturers of kitchen appliances market beer making kits as a spin-off from their products. Moreover, the fact that both applicant's kit and opposer's coffee and tea makers "brew" beverages does not establish a relationship between these goods, such that consumers would believe that the goods come from the same source simply because they are sold under marks which begin with "MR." followed by a generic term.

Turning then to the marks, opposer contends that its MR. COFFEE mark is famous and therefore entitled to a broad scope of protection. Applicant concedes that the mark is well known, but argues that the fame of the MR. COFFEE mark

Opposition No. 96,032

is limited to "coffee related appliances." Applicant's point is borne out by opposer's sales figures for the period 1990 through 1995. Opposer's total sales of products under the MR. COFFEE mark was approximately \$800,000,000; opposer's coffee makers, filters and accessories accounted for well over half of that amount. In view thereof, and in the absence of other evidence (e.g., advertising expenditures showing widespread exposure of the MR. COFFEE mark in connection with opposer's other products), it would appear that the fame of opposer's MR. COFFEE mark is indeed limited to the field of coffee makers.

Further, we note that while opposer's witness, Mr. Lange, testified that opposer sells automatic hot tea makers under the mark MRS. TEA, opposer did not plead use of this mark or any other marks consisting of a title (i.e., MR. or MRS.) followed by a generic or highly descriptive term in the notice of opposition. Moreover, Mr. Lange testified that MRS. TEA is generally followed with the designation "by MR. COFFEE." Thus, this is not a situation where opposer is relying on a line of marks which follow the same pattern.

We find, therefore, that notwithstanding the fame of opposer's mark, in view of the differences between opposer's and applicant's goods, confusion is unlikely. See e.g. *Burns Philip Food Inc. v. Modern Products Inc.*, 24 USPQ2d 1157 (TTAB 1992) [While fame of a mark is entitled to

Opposition No. 96,032

substantial weight in determining likelihood of confusion, other factors may be more significant]; and *Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460 (TTAB 1992) [Fame is not the only factor that must be considered in likelihood of confusion analysis; otherwise owner of famous mark would have a right in gross].

In reaching our decision, we have given little weight to the third-party registrations submitted by applicant. Many of the registrations have been canceled or have expired. Also, there is no evidence of actual use, and in the absence such evidence, the third-party registrations are entitled to little weight on the question of likelihood of confusion. See *Plantronics Inc. v. Starcom Incorporated*, 213 USPQ 699 (TTAB 1982).

We turn finally to the second issue, applicant's alleged misuse of the registration symbol and applicant's use of the statement that MR. BEER is a registered trademark. As applicant points out, a statement such as "registered trademark" is not an official or statutory symbol of federal registration, and thus the use of this statement is not a basis for denying registration. According to applicant's responses to opposer's interrogatories and requests for admissions, applicant did use the registration symbol on labels and in at least one advertisement. Applicant states that it gave its printer

Opposition No. 96,032

the go ahead to use the registration symbol after expiration of the period for filing an opposition and prior to notification of the instant opposition. Further, applicant states that it notified its printer to change all labels and advertisements after being advised by opposer that use of the registration symbol was improper. Under the circumstances, we cannot say that applicant's use of the registration symbol was intended to mislead or defraud prospective purchasers. See Knorr-Nahrmittel Aktiengesellschaft v. Havland International, Inc., 206 USPQ 827 (TTAB 1980).

Decision: The opposition is dismissed.

E. J. Seeherman

P. T. Hairston

C. E. Walters
Administrative Trademark
Judges, Trademark Trial and
Appeal Board