

Hearing:
March 5, 1998

Paper No. 47
ejs

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB MARCH 9, 99
U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Signature Brands, Inc.¹

v.

Robert Lehrer Associates

Opposition No. 93,894
to application Serial No. 74/396,735
filed on June 1, 1993

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

John D. Fairchild and Stanley C. Macel, III of Connolly & Hutz for Robert Lehrer Associates, Inc.

Before Seeherman, Quinn and Hohein, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

¹ The opposition was originally brought by Mr. Coffee, inc. As a result of a corporate merger by which Mr. Coffee, inc. became a division of Health o meter, Inc., Health o meter, Inc. was substituted as the opposer on January 9, 1995. On October 1, 1997 opposer moved to substitute Signature Brands, Inc. as the opposer because Health o meter, Inc. and Signature Brands, Inc. merged, and all rights to the MR. COFFEE mark and business and associated good will became the property of Signature Brands, Inc. In view thereof, the motion is granted, and Signature Brands, Inc. has been substituted as the opposer.

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Signature Brands, Inc. has opposed the application of Robert Lehrer Associates, Inc. to register MR. FILTER as a trademark for "adsorbent filters for preparing hot or cold beverages with reduced contaminants."² The opposition was initially brought on the ground of likelihood of confusion, opposer alleging that it has used the trademark MR. COFFEE in its business since prior to the filing of applicant's intent-to-use application on June 1, 1993; that it uses the trademark MR. COFFEE for a variety of products, including coffee makers, iced tea makers, coffee bean grinders, mug warmers, coffee filters, and water filtering devices; that it owns registrations for the mark MR. COFFEE for coffee brewers and disposable coffee filters, warming plates, decanters, coffee, and cleaning compositions for coffee and/or tea brewing apparatus, and owns an application for MR. COFFEE for, inter alia, water filters which was filed prior to the filing of applicant's intent-to-use application; and that applicant's use of MR. FILTER for its identified goods is likely to cause confusion or mistake or to deceive.

Subsequently, the notice of opposition was amended, upon motion granted by the Board, to add the ground that applicant did not have a bona fide intention to use the mark in commerce on its identified goods when it filed its

² Application Serial No. 74/396,735, filed June 1, 1993, and asserting a bona fide intention to use the mark in commerce.

application. Opposer alleged that applicant failed to provide documentation supporting its claimed intention to use the mark; that applicant stated that it had not planned its usage of the MR. FILTER mark on the goods; and that simultaneously with the filing of its application, applicant filed another application for BREWMATE for the identical goods and has commenced use in commerce of that mark.

Applicant has denied the salient allegations of the notice of opposition, as amended.³

The record includes the pleadings; the file of the opposed application; the testimony, with exhibits, of opposer's witnesses Torrey A. Glass and John McCann, and applicant's witnesses Robert Lehrer and Dennis Dionisi⁴.

³ In addition, applicant asserted, affirmatively, that opposer's actions in commencing use of the mark MR. FILTER after learning of applicant's attempt to register MR. FILTER constitute bad faith and unclean hands. However, applicant did not pursue this claim in its brief. Accordingly, we have deemed this defense to have been waived.

⁴ Opposer filed a motion to strike Mr. Dionisi's testimony, and Exhibits A, B, C, D, E, L and M, which were placed into evidence as part of that testimony. Applicant opposed the motion, and opposer filed a reply brief which the Board, in its discretion, has considered. The motion is granted, to the extent that Mr. Dionisi's testimony regarding his participation in the selection of the mark MR. FILTER has not been considered because Mr. Dionisi was not identified in response to opposer's Interrogatory No. 5 to identify each person having knowledge or information relating to the initial selection, adoption and contemplated or actual date of first use of the mark MR. FILTER. Applicant cannot claim that it interpreted this interrogatory as referring only to the "most knowledgeable person," and then call Mr. Dionisi for testimony on this point. In addition, Exhibits L and M have not been considered. Applicant first produced these exhibits at Mr. Dionisi's deposition, explaining that Mr. Dionisi discovered them in his own files a week before his deposition, gave them to Dr. Lehrer, and that they were first

Opposer has made of record, under a notice of reliance, applicant's responses to opposer's interrogatories and requests for admission; excerpts of articles taken from the NEXIS data base,⁵ and copies of its pleaded registrations⁶ for MR. COFFEE for coffee brewers and disposable coffee filters⁷; decanters⁸; electric domestic warming plates⁹;

disclosed to applicant's attorney the morning of the deposition. Although applicant characterizes the production of the exhibits and a decision "not to withhold them irrespective of their tardy production," (brief in opposition to motion to strike, p. 10), we find that applicant cannot rely on documents in support of its own case when those documents were not produced in response to discovery requests. We would also point out that even if this portion of the testimony and exhibits were considered, it would not affect our decision herein because Dr. Lehrer's testimony confirmed or was duplicative of the evidence given by Mr. Dionisi.

The remainder of Mr. Dionisi's testimony has been considered. Opposer has asked that applicant be precluded from offering into evidence any information regarding how applicant planned to use the mark because, it asserts, applicant did not provide that information in response to opposer's discovery requests. However, we find credible applicant's explanation that its responses to interrogatories provided information which was correct at the time the responses were sought. For example, applicant states that it responded to Interrogatory No. 21, indicating that "Applicant has not presently planned its usage of the mark" because, once this opposition was filed, it put its efforts to make commercial use of the mark on hold.

⁵ Certain of the documents submitted with the notice of reliance are not appropriate subject matter for a notice of reliance, specifically, the NEXIS excerpts whose source is identified as "investext." However, because applicant has treated these excerpts as of record, we will deem them to have been stipulated into evidence.

⁶ Copies of these registrations were filed before the recordation of the change of name of opposer to Signature Brands, Inc. The Board takes judicial notice that Office records now show that title is held in Signature Brands, Inc. See TBMP § 703.02(a).

⁷ Registration No. 1,018,778, issued August 26, 1975 Sections 8 and 15 affidavits accepted and acknowledged; renewed. The word COFFEE has been disclaimed.

coffee¹⁰; cleaning compositions for coffee and/or tea brewing apparatus¹¹; and 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.¹²

Applicant has submitted, with a notice of reliance, opposer's responses to certain of its interrogatories, an interlocutory decision of the Board in the present proceeding, and certain of applicant's requests for production of documents, and opposer's responses thereto.¹³

⁸ Registration No. 1,089,737, issued April 18, 1978; Sections 8 and 15 affidavit filed. Although the certified copy was filed prior to the renewal date, Office records show that the registration has been renewed. The word COFFEE has been disclaimed.

⁹ Registration No. 1,142,407, issued December 9, 1980; Sections 8 and 15 affidavits accepted and acknowledged. The word COFFEE has been disclaimed.

¹⁰ Registration NO. 1,343,074, issued June 18, 1985; Sections 8 and 15 affidavits accepted and acknowledged. The word COFFEE has been disclaimed.

¹¹ Registration No. 1,651,275, issued July 23, 1991. Office records show that subsequent to the filing of the certified copy of this registration, Sections 8 and 15 affidavits were accepted and acknowledged.

¹² Registration No. 1,875,877, issued January 24, 1995. This registration issued after the opposition proceeding commenced, but the underlying application was pleaded in the notice of opposition.

¹³ Document production requests and responses thereto cannot be made of record pursuant to a notice of reliance. However, opposer has treated this material as being of record, and we therefore deem it to have been stipulated into evidence.

The parties have fully briefed the case,¹⁴ and both were represented at an oral hearing before the Board.

Priority is not in issue in view of opposer's registrations, which it has made of record. **King Candy Company v. Eunice King's Kitchen, Inc.**, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Moreover, the evidence shows that

¹⁴ One month after the filing of its main brief, opposer made a motion requesting that the Board accept its brief even though the brief in its entirety, including the cover and signature pages, exceeded the 55 page limit set in Trademark Rule 2.128(b) by 3 pages. Applicant did not oppose the motion. Although Rule 2.128(b) provides that prior leave of the Board is required to file a brief exceeding the 55 page limit, in this case the Board notes that the length of the Table of Contents is due, in part, to opposer's setting forth the page of each subpoint in the facts, the law, and arguments; that opposer has, in its Table of Authorities, listed statutory and treatise references, although not specifically required to do so by rule; that opposer has provided a cover page, although not specifically required to do so by rule; and that one page consists solely of opposer's signature. Because the material required by the rule did not exceed the 55 page limit, and because applicant has not opposed the motion, the Board will exercise its discretion and accept opposer's brief as filed.

Applicant has moved to strike certain references made by opposer in its reply brief. Those references are to a particular application and registration opposer asserts are owned by opposer, and which applicant, in its motion, has stated have been, respectively, abandoned and cancelled. Opposer has acknowledged in its reply brief that the application and registration were never made of record, but opposer states that it must refer to them in order to refute what it contends is applicant's "unfounded statement" that "the MR. FILTER test program 'is the only instance in which Opposer has offered a product under a mark with a MR. prefix.'" Reply brief, p. 10, quoting applicant's brief, p. 13. Applicant's objection is well taken, in that opposer did not make the referenced application and registration of record, and only evidence which has properly been made of record may be considered. However, obviously applicant's statements, too, must be read in the context of the record; therefore, the reference to the MR. FILTER test program being the only instance in which opposer has offered a product under a MR. prefix, must be interpreted as referring to the only instance which is of record in which opposer has offered a product under such a mark.

opposer has been using the marks MR. COFFEE on, inter alia, coffee brewers and filters since before the June 1, 1993 filing of applicant's intent-to-use application, the earliest date on which applicant can rely. Applicant has itself acknowledged that "Opposer's MR. COFFEE mark was adopted, used and registered for coffee makers and coffee filters and certain related appliances long prior to Applicant's intent to use MR. FILTER for coffee and other filters." Brief, p. 5.

This brings us to the issue of likelihood of confusion. In determining this issue, we have considered all of the relevant factors as set forth in **E.I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

First, applicant's identified goods--adsorbent filters for preparing hot or cold beverages with reduced contaminants--must be deemed to be identical in part to opposer's goods, in that applicant's identification encompasses the disposable coffee filters identified in opposer's Registration No. 1,018,778 for MR. COFFEE. Further, applicant's filters are closely related to opposer's MR. COFFEE coffee brewers, since these coffee brewers use filters for preparing hot beverages.

There is no dispute that the opposer's and applicant's filters would be sold through the same channels of trade to

the same class of consumers, namely the general public. As applicant has stated in its brief, p. 4,

"such filters are sold through grocery stores, drug stores, hardware stores, mass merchandizing (sic) chains, specialty retailers, and the like. Coffee filters are usually purchased by people who use small coffee making appliances at home and in business establishments."

Moreover, the evidence of record shows that opposer's coffee brewers are also sold in these same channels of trade to the same class of consumers.

Applicant has conceded that the parties' filters are "inexpensive disposable paper or cloth consumer products" which "are sold at the retail level as repeat purchase commodities for low competitive prices..." Brief, p. 4.

Opposer's evidence shows that its filters cost between 50¢ and \$3.00 per carton. It can be assumed that such low-cost items are not purchased with a great deal of care or deliberation.

We also find that opposer's MR. COFFEE mark is famous for coffee brewers and for coffee filters. Opposer began using MR. COFFEE as a trademark for coffee brewers in 1975, and has used the mark on filters since the mid-1970's. Sales of coffee brewers under the MR. COFFEE mark ranged from \$62.4 million in 1990 to \$115 million in 1995, while sales of coffee filters ranged from \$16.5 million to \$24.7 million during that same period, although sales decreased

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slightly from the high in 1993. MR. COFFEE products are sold throughout the United States, including discounters such as Wal-Mart, membership clubs such as Sam's Club, cataloguers such as Service Merchandise, specialty retailers such as Bed, Bath and Beyond, department stores, grocery stores, drug stores and hardware stores. The primary outlet for MR. COFFEE filters are grocery stores, but they are also sold in convenience stores, mass merchandisers, drug stores, and the like. MR. COFFEE products are sold in over 50,000 outlets; in just the east region 10,000 grocery stores carry MR. COFFEE filters. In 1995 MR. COFFEE brand automatic drip coffeemakers had 33% of the market; moreover, it has never had less than a 30% market share, and has had as much as 40%. The total market share for MR. COFFEE filters in 1995 was 26.4%, which was the highest share for any one brand.

MR. COFFEE products are advertised heavily. Advertising expenditures for opposer's MR. COFFEE products (opposer does not keep separate records for each product) have totaled more than \$90 million from 1990 to 1995, with figures in excess of \$14 million in virtually each year.

Many of opposer's advertising campaigns have featured the famous baseball player Joe DiMaggio. National advertising media include consumer magazines such as "Time," "People," "Good Housekeeping" and "Women's Day", radio and television. Co-op advertising with retail stores such as

Wal-Mart and Target play a major role in promoting MR. COFFEE brewers. MR. COFFEE filters are advertised primarily in newspapers, generally as part of inserts in Sunday papers. Such advertisements would appear in every prominent newspaper in every region of the country, and would amount to almost 52 million coupons in each run.

We turn next to a consideration of the marks, keeping in mind two points:

1) The fame of a mark plays a dominant role in cases featuring a famous or strong mark because famous or strong marks enjoy a wide latitude of legal protection. **Kenner Parker Toys Inc. v. Rose Art Industries, Inc.**, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992);

2) When marks would appear on virtually identical goods or services, as they do here, the degree of similarity necessary to support a conclusion of likely confusion declines. **Century 21 Real Estate Corp. v. Century Life of America**, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Obviously there are differences between opposer's mark MR. COFFEE and applicant's mark MR. FILTER. The word COFFEE is clearly different from the word FILTER. However, the marks are not the individual words COFFEE and FILTER, but MR. COFFEE and MR. FILTER. When we compare the marks in their entireties, we find that the differences in the second words are not sufficient to distinguish the marks. Both marks consist of the word MR. followed by, in the case of MR. COFFEE for coffee filters and coffee brewers, a generic

adjective and, in the case of MR. FILTER for filters, a generic noun. Thus, they have similar compositions, and convey a similar commercial impression. Purchasers familiar with opposer's MR. COFFEE brewers and filters are likely to believe, when they see MR. FILTER on the identical goods, coffee filters, that this mark is a variant of opposer's MR. COFFEE mark, adopted by opposer as a trademark for its coffee filters. This is especially true because, as we indicated previously, coffee filters are inexpensive items which are not likely to be purchased with a great degree of care or thought.

In further support of our finding that confusion is likely, we note that there is no evidence of record of any third-party use or registration of other "MR." marks.¹⁵ Thus, in addition to the strength/fame of the MR. COFFEE mark which opposer has shown, there is nothing to show that the public is familiar with other MR. marks, such that they would be likely to distinguish such marks based on the other words in the mark. (And we reiterate that it is not just on the basis of the common element MR. in the parties' marks that we have found likelihood of confusion; it is the overall construction of the marks.)

¹⁵ In its brief applicant has made reference to other "MR." marks but, as opposer has pointed out, registrations for such marks were never made of record, nor was any testimony introduced about their use.

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The only duPont factor which applicant asserts to be in its favor (other than its contention about the differences in the marks), is the lack of evidence of actual confusion. Applicant's position has a slight twist, though. Applicant does not base its argument on lack of actual confusion between opposer's use of the MR. COFFEE mark and applicant's use of the MR. FILTER mark, since applicant has not yet started to use its mark. Instead, applicant relies on opposer's own use of a MR. FILTER mark.

The evidence shows that around January 1994 (shortly after applicant's application was published for opposition), opposer started selling coffee filters under the mark MR. FILTER. These filters bore no reference to opposer's then-trade name, nor to MR. COFFEE. Approximately 1,000 "sell sheets" for the MR. FILTER product, touting the benefits of the program and providing ordering information, were distributed to retail accounts such as discounters, drug stores and grocery stores. The MR. FILTER filters were sold nationally, and were still for sale at the time John McCann, the business development manager of opposer's Mr. Coffee division, testified in October 1996. Mr. McCann was aware that the filters were sold by a few grocery accounts, and that Ace Hardware had purchased a couple of hundred cases having 24 packages in a case.

Opposer has characterized its MR. FILTER program as an attempt to capture more of the market by making available a "branded" product which would be a tier between the MR. COFFEE branded filters and private label filters. Applicant, on the other hand, contends that the program was actually undertaken by opposer as an attempt to discover whether there was confusion between MR. COFFEE filters and filters having no ostensible connection with opposer which were sold under the mark MR. FILTER. Applicant further contends that, because no evidence of actual confusion had been reported to opposer's witnesses, the program in fact demonstrates that under actual marketing conditions confusion is not likely to occur when the parties' marks are used on coffee filters.

We need not determine the motive for the program to find that the lack of evidence of actual confusion does not compel a finding of no likelihood of confusion. As has often been stated, the test under Section 2(d) of the statute is likelihood of confusion, not actual confusion. Therefore, it is not necessary to submit evidence of actual confusion in order to prove likelihood of confusion. Evidence of actual confusion is notoriously difficult to obtain, and this would seem to be even more difficult in the case of coffee filters. As we noted previously, filters are inexpensive items, and even if people were confused they

might not take the trouble to complain. Also, if the MR. FILTER filters were of a similar quality to MR. COFFEE filters, as seems possible in view of the fact that opposer was producing them, customers may not have had any reason to indicate confusion.

More importantly, the information which we have about opposer's program to sell MR. FILTER filters is not sufficient for us to infer from the lack of evidence of actual confusion that confusion is not likely. From Mr. McCann's testimony, it appears that the sales of opposer's MR. FILTER filters have been minimal.¹⁶ Thus, we cannot conclude that there has been a sufficient opportunity for confusion to occur.

The lack of evidence of actual confusion, therefore, does not outweigh the remaining duPont factors which favor opposer. Accordingly, we find that applicant's intended use of MR. FILTER for adsorbent filters for preparing hot or cold beverages with reduced contaminants is likely to cause confusion with opposer's mark MR. COFFEE for coffee filters and coffee brewers.

In view of our finding of likelihood of confusion in favor of opposer, we will deal with the second ground of

¹⁶ We note that applicant requested information during discovery regarding opposer's adoption and use of the MR. FILTER mark, and that opposer objected thereto on the ground that it was not relevant. Applicant never filed a motion to compel responses to these discovery requests.

opposition in a summary fashion. Opposer contends that applicant lacked a bona fide intent to use its mark when it filed its application because applicant legally could not market products and had no firm plans to use the mark. We disagree. Although applicant itself is incorporated as a consulting company and therefore cannot manufacture or sell products, Dr. Lehrer's testimony shows that MR. FILTER filters were intended to be sold by Sorbit, Inc. under license from applicant. Further, applicant has submitted evidence that it obtained UPC product codes for MR. FILTER filters in 1993, shortly after the filing of its application on June 1, 1993. These bar codes identify Sorbit, Inc. as the source of the products to which they are applied.

Sorbit, Inc. was incorporated by Dr. Lehrer to serve as the development, production and marketing arms for filter products which Dr. Lehrer had developed and for which he had received a patent. Dr. Lehrer is the owner of both Sorbit, Inc. and of applicant, a corporation which Dr. Lehrer formed, and of which he is the sole officer and employee.

Opposer appears to argue that any activities undertaken by Sorbit, Inc. do not inure to the benefit of applicant because they are not related companies, nor was Sorbit, Inc. a licensee of applicant until December 1994. Opposer is correct that use of a trademark by an unrelated company may not inure to the benefit of another company. However, even

if we assume that applicant and Sorbit, Inc. are not related companies, applicant is not attempting to rely on Sorbit, Inc.'s use of MR. FILTER--use which, as applicant has pointed out, has not yet begun. Given the relationship between applicant, Dr. Lehrer and Sorbit, Inc., we believe that the obtaining of bar codes for use in the eventual sale of MR. FILTER filters, as well as the other documents submitted reflecting activities by Sorbit, Inc., can be accepted as evidence of a bona fide intent by applicant to use the mark through the company which was intended to be its licensee.

Accordingly, we find that opposer has failed to prove that applicant lacked a bona fide intent to use the mark MR. FILTER.

Decision: The opposition on the ground of likelihood of confusion is sustained, and the opposition is dismissed with respect to the ground that applicant lacked a bona fide intention to use its mark.

E. J. Seeherman

T. J. Quinn

G. D. Hohein
Administrative Trademark Judges
Trademark Trial and Appeal Board