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THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

JUNE 7, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Kimberly-Clark Tissue Company
v.
The Scott Fetzer Company

Opposition No. 94,387
to application Serial No. 74/423,659
filed on August 12, 1993

Jeffery A. Handelman of Brinks Hofer Gilson & Lione for
Kimberly-Clark Tissue Company.

Robert P. Ducatman, Timothy P. Fraelich and Deborah R.
Schwartz of Jones, Day, Reavis & Pogue for The Scot Fetzer
Company.

Before Cissel, Walters and Quinn, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by The Scot Fetzer
Company to register the mark SCOT'S TUFF for "carpet
shampoos and carpet cleaning preparations."¹

Registration has been opposed by Kimberly-Clark Tissue
Company under Section 2(d) of the Trademark Act. Opposer

alleges that applicant's mark, if applied to applicant's goods, would so resemble opposer's previously used and registered SCOTT marks and SCOTT formative marks for various cleaning, wiping, scrubbing and absorbing products as to be likely to cause confusion.²

Applicant, in its answer to the amended opposition, denied the salient allegations.

The record consists of the pleadings; the file of the involved application; trial testimony, with related exhibits, taken by each party;³ certified copies of forty-three of opposer's pleaded registrations, portions of discovery depositions with related exhibits, and dictionary definitions, all introduced by opposer's notices of reliance; and discovery depositions with related exhibits, opposer's responses to interrogatories and requests for admissions, and excerpts from phone directories, all made of record by way of applicant's notices of reliance. Opposer and applicant filed briefs on the case, and both were

¹ Application Serial No. 74/423,659, filed August 12, 1993, alleging a bona fide intention to use the mark in commerce.

² In its amended pleading, opposer also claimed ownership of registrations of the mark SANI-TUFF for hand soap, dispensers and disposable wipers. Although the registrations were properly made of record, no mention of them was made in either of opposer's briefs or at the oral hearing. Further, applicant's statement that opposer no longer uses the mark stands un rebutted. It would appear that opposer essentially gave up on its likelihood of confusion claim with respect to this mark. We hasten to add, however, that we reach the same result on likelihood of confusion between SANI-TUFF and applicant's mark as between opposer's SCOTT marks and applicant's mark: no likelihood of confusion.

represented by counsel at an oral hearing held before the Board.

Opposer was founded in 1879 and, since that time, has continued to sell, with great success, various cleaning, wiping, scrubbing and absorbing paper and cloth products under its SCOTT marks. Opposer's registrations date back to 1915 and, in addition to the SCOTT mark, opposer owns registrations for marks such as SCOTT FOLD, SCOTTCLOTH, SCOTTEX, SCOTTISSUE, SCOTTOWELS, SCOTTPLUS, SCOTTFRESH, SCOTT SELECT and SCOTTPURE. Opposer has divided its business into three primary segments: the consumer business; the do-it-yourself business; and the away from home business. Opposer's products have been sold through mass merchandisers, grocery and drug stores, warehouse clubs, and hardware stores. The products are bought by various classes of purchasers, including ordinary consumers, as well as institutional customers such as hotels, office buildings, health care facilities and restaurants. Opposer has extensively promoted its products in a wide variety of media, including television, radio, newspapers, magazines, trade journals, catalogs and direct mailings, and through participation at trade shows. Sales and advertising figures are very impressive, but a confidentiality agreement precludes us from reciting the specifics.

³ Opposer's testimony of Edward T. O'Brien, Jr. was submitted in

Applicant was founded in 1914 by George Scott and Carl Fetzer. Since that time, applicant has been engaged in the manufacture and sale of vacuum cleaners. Another entity, Scot Laboratories, was formed in 1964 and sold carpet cleaning preparations to applicant for use with its vacuum cleaning machines which apparently included a carpet shampooer. Scot Laboratories became a division of applicant in 1971. Applicant began selling carpet cleaning preparations under the mark SCOT'S TUFF in 1993. The goods have been promoted in newspapers and trade journals.⁴

A procedural matter requires our attention before we turn to the merits of the likelihood of confusion claim. After the filing of the parties' briefs, but before the oral hearing was held, applicant moved to strike several of opposer's registrations on the grounds that some of the registrations were canceled by the Office, and that others were abandoned. Thus, applicant argued, these registrations

affidavit form pursuant to the parties' agreement.

⁴ The record shows that in addition to the carpet cleaners, applicant sells a variety of other household cleaners under the SCOT'S TUFF mark. These cleaners include kitchen and bathroom cleaners, and glass and surface cleaners. In the present case, however, applicant is seeking to register its trademark for carpet shampoos and carpet cleaning preparations only. Our determination in this proceeding must be based on a consideration of the identified goods in the involved application, and not whether confusion is likely in connection with goods not listed in the application before us here. *Saks & Co. v. Snack Food Association*, 12 USPQ2d 1833, 1836 (TTAB 1989). The dismissal of the present opposition in no way precludes the Board from reaching a different result, based on a different record, if the parties were to litigate applicant's right to registration of

were immaterial and should be stricken from the record. Opposer objected to the motion to strike, but also confirmed that four of the registrations were canceled under Section 8. The Board, in an order dated February 5, 1998, denied the motion to strike. Applicant also filed a motion to amend the pleadings to conform to the evidence pursuant to Fed. R. Civ. P. 15(b). The Board, in the same order, deferred consideration of the motion until final hearing. It is this Fed. R. Civ. P. 15(b) matter that requires our consideration.

Applicant has moved to amend its answer to include counterclaims to conform to the evidence presented at trial. Applicant contends that certain portions of the testimony of record establish that twelve of opposer's registrations have been abandoned and that, therefore, the registrations should be canceled. Applicant further contends that the issue of abandonment was tried with the consent of the parties. Applicant points to portions of the testimony of Robert Behan, and asserts that Mr. Behan, "without equivocation and without objection from [opposer], that [opposer] is no longer offering goods in connection with twelve subject trademark registrations and that it has divested itself of the capability of manufacturing such goods." Applicant goes

SCOT'S TUFF as a trademark for any of its other types of household cleaners.

on to state that while it raised the abandonment issue in its brief, opposer's reply brief is silent on the issue.

Opposer objects to the motion, arguing that the issue of abandonment was not tried by the express or implied consent of the parties. Opposer also directs the Board's attention to the fact that applicant filed, on July 25, 1997, twelve separate petitions to cancel the registrations.⁵

Essentially for the reasons set forth in more detail in opposer's brief in opposition to the motion, applicant's motion is not well taken. Opposer was not put on notice that the validity of its registrations was being challenged until after the trial had concluded in this case and opposer's brief had been filed.

Our review of the record convinces us that the issue of abandonment was not tried, either by express or implied consent of the parties, as contemplated by Fed. R. Civ. P. 15(b). *Colony Foods, Inc. v. Sagemark, Ltd.*, 735 F.2d 1336, 222 USPQ 185 (Fed. Cir. 1984). The mere introduction of responses to a few questions on cross examination falls far short in this case of establishing that the issue was tried. To allow amendment at this late juncture would result in undue prejudice to opposer. *ABC Moving Co., Inc. v. Brown*, 218 USPQ 336, 339 (TTAB 1983). Inasmuch as it appears that

opposer was not on notice that abandonment of twelve of its registrations was an issue in this case, the motion to amend is denied.

This interlocutory ruling results in a somewhat unusual procedural situation in this case. That is to say, although this case is at final hearing, there remains a cloud over twelve of opposer's registrations by virtue of the pendency of the consolidated cancellation proceedings. Generally, when an opposer's registration is sought to be canceled, that matter is taken up first, usually as a compulsory counterclaim in the opposition, before proceeding to the merits of the opposition.⁶ Nonetheless, due to the late stage of this proceeding and the early stage of the cancellation proceedings, the Board is inclined to issue a final decision in the present case. In doing so, while we obviously are aware that twelve of opposer's registrations remain under attack, we will decide the likelihood of confusion issue herein as if these twelve registrations survived the cancellation proceedings, thereby remaining valid and subsisting registrations. We now turn to the likelihood of confusion issue in this case.

⁵ Cancellation proceedings were instituted, and the proceedings were consolidated by the Board.

⁶ We note that opposer, as respondent in the cancellation proceedings, urged that the petitions be dismissed essentially on the basis that applicant's challenge to the registrations could have and should have been timely raised as compulsory counterclaims in this opposition. Although the Board denied

In view of opposer's ownership of valid and subsisting registrations for its pleaded marks, there is no issue with respect to opposer's priority.⁷ *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). In any event, the record clearly establishes that opposer began using its SCOTT marks long prior to the filing date of applicant's intent-to-use application.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re *E. I du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. We will first turn our attention to these factors, and then will consider the remaining relevant du Pont factors.

opposer's motion on February 12, 1999, opposer has filed a request for reconsideration of that decision.

⁷ The Board's check of Office records shows that some of opposer's registrations of record have been canceled. When a federal registration owned by a party has been properly made of record in an inter partes proceeding, and there are changes in the status of the registration between the time it was made of record and the time the case is decided, the Board, in deciding the case, will take judicial notice of, and rely upon, the current status of the registration, as shown by the Office records. *Royal Hawaiian Perfumes, Ltd. v. Diamond Head Products of Hawaii, Inc.*, 204 USPQ 144 (TTAB 1979); and *TBMP* § 703.02(a). The following registrations introduced by way of opposer's notice of reliance have been canceled: Registration Nos. 1,615,762; 1,630,017; 1,648,827; 1,651,305; 1,650,698; 1,652,446; 1,659,371;

Insofar as the goods are concerned, the essence of opposer's arguments is that the goods "are closely related in that they are complementary products that are used together to remove stains and messes from carpets." In making this point, opposer particularly notes applicant's spot remover products, such as the pet stain and odor carpet cleaner and the food stain carpet cleaner, which are used by blotting the soiled area with a towel or cloth. Stephen Platt, opposer's vice president, sales, testified about opposer's sales demonstrations where opposer's heavy-duty towels are dunked in water, wrung out and then used to remove stains from carpet, and that the towels do not shred or fall apart. In this connection, some of opposer's products are promoted as "tough enough to work with cleaning agents."

Opposer also highlights its joint marketing efforts under opposer's SCOTT mark with at least two third parties.⁸ One involved the joint marketing of opposer's SCOTT shop towels with the cleaning product SIMPLE GREEN sold by Sunshine Makers, Inc. The testimony establishes that the SIMPLE GREEN brand product has a carpet cleaning

1,691,598; and 1,694,452. These registrations have not been considered in reaching our decision.

⁸ Applicant quibbles with some of the details concerning these efforts and urges the Board to disregard Mr. Platt's testimony. Contrary to applicant's remarks, we find Mr. Platt's testimony, as well as that of the witnesses from the two third parties, to be credible.

application. In this promotion, a roll of opposer's shop towels was packaged and sold together with SIMPLE GREEN brand cleaner in True Value hardware stores. Although the two companies engaged in discussions regarding further joint promotions, nothing ever materialized.⁹

The other effort undertaken by opposer involved Church & Dwight Co., Inc., which sells various household cleaning products under the mark ARM & HAMMER. There is testimony to the effect that the companies discussed a project for a household cleaner to be jointly branded under the companies' marks. No such product ever came to the market, however.

We acknowledge that the record establishes that the parties' goods travel in some of the same channels of trade for household products and are bought by the same classes of purchasers for such products. Also, the goods are relatively inexpensive and are purchased with nothing more than ordinary care. Nevertheless, Mr. Platt testified that opposer's goods essentially are paper products. (dep., pp. 56-60) Further, none of opposer's registrations covers household cleaning preparations.

Simply put, the parties' goods are specifically different. Although the above evidence supports opposer's

⁹ Mark Rhodes, opposer's district team leader in Atlanta, Georgia, also testified that retailers try to group similar items for display. In this connection, Mr. Rhodes pointed to exhibit no. 164, which shows 409 brand cleaner on shelves just above paper towels as part of a single display in a retail store.

claim that its products and household cleaners are complementary, it hardly establishes that consumers would have a basis for assuming that both emanate from the same source, or that there is an industry practice of such joint promotions or that consumers have become accustomed to such a practice. In this connection, while opposer's joint promotion with Sunshine Makers was characterized as a "success," the record lacks any details (e.g. sales or duration) about the promotion, thereby making it impossible to gauge the exposure to consumers in the marketplace. Other than this single promotion, it appears that other efforts have not moved beyond the discussion phase.

More to the point is that the evidence falls short in establishing a basis upon which to conclude that consumers would be likely to believe that paper towels and similar products used for cleaning and wiping on the one hand, and carpet cleaning preparations on the other, emanate from the same source. The record is devoid of even one instance where the same entity makes both types of products. To the extent that other products are marketed under opposer's SCOTT marks, such as dropcloths and air fresheners, we likewise find that the record is lacking in establishing a nexus between those products and applicant's carpet cleaning products such that consumers, upon encountering the parties' marks, would attribute a common source to them.

We next turn to compare opposer's SCOTT marks (both SCOTT and SCOTT formative marks) to applicant's mark SCOT'S TUFF. Although there is a similarity between the marks in that SCOTT and SCOT'S sound alike, we find that when the marks are considered in their entirety, on balance, the differences outweigh the similarities. Although the TUFF portion of applicant's mark is clearly subordinate to the SCOT'S portion, it nevertheless forms part of the mark and cannot be ignored. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983). Further, the SCOT'S portion of applicant's mark is spelled differently (one fewer letter "t") from opposer's SCOTT mark. As to opposer's argument that consumers will assume that SCOT'S TUFF is just another variant of opposer's SCOTT and SCOTT formative marks, the differences between the marks and the goods sold thereunder lead us to conclude that confusion is unlikely to occur in the marketplace.

With respect to the absence of actual confusion between the marks, we find that applicant has overstated its case. Applicant would have us place significant weight on this factor due to "over eighty years of concurrent use of marks incorporating 'Scott' or 'Scot' by the parties to this opposition." What opposer correctly points out, however, is that applicant is referring to its use of the designation "The Scott & Fetzer Company" in connection with applicant's

sale of vacuum cleaners. Applicant sales of its carpet cleaner under the involved mark SCOT'S TUFF, however, did not commence until 1993. In any event, although neither party is aware of any instances of actual confusion, proof of actual confusion, often very difficult to obtain, is not required to show a likelihood of confusion.

Another factor concerns the fame of opposer's SCOTT mark. Fame, of course, is a significant factor in the determination of likelihood of confusion, and can play a dominant role in cases featuring a famous mark. Kenner Parker Toys Inc. v. Rose Art Industries Inc., 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). There is no question but that opposer has enjoyed huge success with its paper products. As noted earlier, although a confidentiality agreement prevents us from setting forth opposer's sales volume and advertising expenditures, suffice it to say that they are, by any standard, enormous. Given these figures and the many years of use of the SCOTT mark, we have no problem concluding that this mark is famous as used in connection with paper towels, facial tissues, toilet paper and closely related products sold by it. The evidence of third-party uses shown by applicant does very little to diminish this fame inasmuch as virtually all of the uses involve goods and/or services different from the ones of the

parties in this case. Moreover, applicant has not supplied any evidence bearing on the extent of these uses.

At the same time, we also recognize that SCOTT is a fairly common surname and appears in the names of many businesses as shown by the telephone directory listings submitted by applicant. The commonality of the surname "Scott" tends, we think, to contribute to the limitation of the fame of opposer's mark to those products mentioned above.

While we find that opposer's SCOTT mark is a famous mark for cleaning, wiping, scrubbing and absorbing paper products, we do not view the mark in the same fashion in relation to non-paper or non-cloth items such as carpet shampoos and carpet cleaning preparations. There is no evidence on which we can find that opposer's SCOTT marks for its various cleaning, wiping, scrubbing and absorbing products are so famous that the fame carries over to non-paper (or non-cloth) items such as carpet cleaning preparations. There simply is no evidence establishing public awareness and transference of the trademark function of opposer's SCOTT marks to carpet cleaners by virtue of the fame of opposer's mark for its products. *G.H. Mumm & Cie v. Desnoes & Geddes Ltd.*, 917 F.2d 1292, 16 USPQ2d 1635, 1639 (Fed. Cir. 1990); *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939 (Fed. Cir. 1984); and *Bausch & Lomb*

Inc. v. Leupold & Stevens Inc., 6 USPQ2d 1475 (TTAB 1988). Thus, to the extent that fame can be accorded to opposer's SCOTT marks, the fame is confined to its cleaning, wiping, scrubbing and absorbing paper and cloth products, and does not extend to carpet cleaners at this time.

Further, the fact that applicant's mark may call to mind opposer's mark is not dispositive. Likelihood of confusion under Section 2(d) means more than the likelihood that the public will recall a mark on seeing the mark of another. It must also be established that "there is a reasonable basis for the public to attribute the particular product or service of another to the source of the goods or services associated with the famous mark." *University of Notre Dame Du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505, 507 (Fed. Cir. 1983), *aff'g* 213 USPQ 594 (TTAB 1982). See also: *Jacobs v. International Multifoods Corp.*, 668 F.2d 1234, 212 USPQ 641, 642 (CCPA 1982), *aff'g* 211 USPQ 165 (TTAB 1981); *In re Ferrero*, 479 F.2d 1395, 178 USPQ 167 (CCPA 1973); *Recot Inc. v. Becton*, 50 USPQ2d 1439 (TTAB 1998); *Viacom International Inc. v. Komm*, 46 USPQ2d 1233 (TTAB 1998); *Original Appalachian Artworks, Inc. v. Streeter*, 3 USPQ 1717 (TTAB 1987); and *American Express Co. v. Payless Cashways, Inc.*, 222 USPQ 907 (TTAB 1984). Here, the record falls short of establishing the reasonable basis contemplated by the Court.

Based on the record before us, we see the likelihood of confusion claim asserted by opposer as amounting to only a speculative, theoretical possibility. We suppose that somebody, somewhere, someday, may be confused, but the likelihood is remote. Language used by our primary reviewing court is helpful in resolving the likelihood of confusion controversy in this case:

We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.

Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992), *citing* Witco Chemical Co. v. Whitfield Chemical Co., Inc., 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), *aff'g* 153 USPQ 412 (TTAB 1967).

Finally, there is no evidence of any bad faith by applicant in adopting its mark SCOT'S TUFF. Scot Laboratories, which became a division of applicant several years ago, sold carpet cleaning products to applicant for use with applicant's vacuum cleaning machines (which also included a carpet shampooer). According to the testimony of Patrick Dowling and Robert Shumay, both employed by applicant, Scot Laboratories selected its business name to trade on its association with its primary customer at that time, applicant (The Scott Fetzer Company).

In making our determination in this case, we cannot help but take special note of the case of *Scott Paper Co. v. Scott's Liquid Gold, Inc.*, 589 F.2d 1225, 200 USPQ 421 (3d Cir. 1978). See also: *S.C. Johnson & Son, Inc. v. Johnson*, 266 F.2d 129, 121 USPQ 63 (6th Cir. 1959), *cert. denied* 361 US 820; and *S.C. Johnson & Son, Inc. v. Johnson*, 175 F.2d 176 (2d Cir. 1949). Although there is not, of course, any estoppel effect (see Board's decision on summary judgment, dated February 12, 1996), the decision tends to support the result reached herein. Based on its SCOTT mark, opposer brought a trademark infringement action in federal district court, challenging a third-party's (Scott's Liquid Gold, Inc.) use of its registered mark SCOTT'S LIQUID GOLD for furniture polish. In pertinent part, the appellate court found that despite the facts that the goods moved through the same channels of trade to the same classes of purchasers, that the goods were inexpensive, that paper towels and furniture polish were functionally related and often used together, that household cleaners might be a logical area for opposer's expansion, and that both marks include the name SCOTT, there was not such a likelihood of confusion sufficient to warrant injunctive relief against the defendant's use of its mark. In reversing, the court of appeals found that the lower court ignored the absence of evidence showing that other paper companies sold liquid cleaners. The court also stated that "selection of a mark with a common surname naturally entails a risk of some

uncertainty and the law will not assure absolute protection."

Suffice it to say that while the decision is not binding on this Board, it is, nonetheless, instructional, given the overall factual context of the two cases. Further, although opposer contends that marketing has changed since the court's opinion in that products today are co-branded and are the subjects of joint promotions, evidence showing these practices to be commonplace is lacking.

Given the voluminous record in this case and the lengthy briefs, the Board is compelled to make one final point. Both parties' briefs have made and debated, and we have considered, arguments other than those specifically mentioned in this opinion. We find it unnecessary, however, to comment on each and every one.

In sum, the cumulative differences between the parties' marks and the goods sold thereunder persuade us that confusion is unlikely to occur in the marketplace.

Decision: The opposition is dismissed.

R. F. Cissel

T. J. Quinn

Opposition No. 94,387

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