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JQ

THIS DISPOSITION IS NOT
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Zelco Industries, Inc.
v.
Diamond Brands Incorporated

Cancellation No. 20,485

Robert B.G. Horowitz and Donna A. Tobin of Cooper & Dunham
for Zelco Industries, Inc.

Paul M. Denk for Diamond Brands Incorporated.

Before Quinn, Hohein and Bottorff, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

Zelco Industries, Inc. has petitioned to cancel a
registration owned by Diamond Brands Incorporated of the
mark SUPERMATCH for "firestarting briquettes for use with
barbecue grills, wood stoves or fireplaces."¹ As its ground
for cancellation, petitioner claims, under Section 2(d) of
the Trademark Act, that respondent's mark, when applied to
respondent's goods, so resembles petitioner's previously

¹ Registration No. 1,662,173, issued October 29, 1991; Section 8
affidavit accepted.

used mark SUPERMATCH for lighters for barbecues, fireplaces, gas ovens, wood stoves and other products which require a long-reaching flame source, as to be likely to cause confusion.² In this connection, petitioner alleges that its application to register the mark SUPERMATCH for its lighter has been refused under Section 2(d) on the basis of respondent's registration.

Respondent, in its answer, denied the essential allegations of the petition for cancellation. Respondent also raised "affirmative defenses," which essentially comprise further denials of the petition.

The record consists of the pleadings; the file of the involved registration; trial testimony, with related exhibits, taken by each party; and dictionary definitions of the terms "super" and "match" introduced by petitioner's notice of reliance.³ Both parties filed briefs on the case, and both were represented by counsel at an oral hearing held before the Board.

Petitioner, according to the testimony of Noel Zeller, its chairman and president, designs, manufactures and

² The petition for cancellation also included claims of uncontrolled licensing (resulting in abandonment), lack of ownership and fraud. The Board, in an order dated April 11, 1997, disposed of these claims in respondent's favor. The Board at that time indicated that the case would go to trial on the remaining ground of priority and likelihood of confusion.

³ The notice of reliance on certain exhibits introduced during John Young's testimony deposition is superfluous inasmuch as they already formed part of the record. Trademark Rule 2.123.

distributes a variety of consumer products. One of these products is a long-reach lighter with a butane source, priced in the \$20-\$30 range, used especially to light fires for barbecues, fireplaces and wood stoves. The product, which has been marketed successively under the marks SUPERMATCH, SUPERMATCH XL and SUPERMATCH FXL,⁴ is sold to the general consuming public in supermarkets, drug stores, and hardware stores, as well as through camping stores and mail order catalogs (both in its own catalog and in the catalogs of third parties such as Eddie Bauer). The product is advertised in newspapers and magazines. Promotional efforts also include appearances at trade shows and listing the product for sale on petitioner's web page. Petitioner also employs a public relations firm which is charged with contacting editors, publishers, and radio and television stations in efforts to garner publicity about petitioner's products. Although sales and advertising figures have been designated "confidential," we can say that petitioner has actively promoted its product, and that it has enjoyed success with the product.

Respondent sells, in addition to matches, a firestarter product used to light a fireplace fire, charcoal barbecue

⁴ According to Mr. Zeller, "XL" means "extra long" and "FXL" means "flexible extra long." We also take judicial notice of the listing in *Acronyms, Initialisms & Abbreviations Dictionary* (25th ed. 1999) of "XL" meaning "extra long [size]."

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fire, wood stove fire and camp fire. According to John Young, respondent's vice president for sales and marketing, respondent's firestarter product is a pressed-board product made from sawdust and pulp which is soaked in a paraffin base. A match head is put on one end of the product; this combustible tip is ignited through friction. The product is designed to burn for twelve minutes and to provide enough heat and fire to start the various fires mentioned above. The product sells in the \$1.59-\$1.79 range for an eight-count pack of firestarters. Respondent's sales of the product to the general public are primarily through grocery stores, wholesalers and discount houses. Annual sales are approximately \$1.4 million. Respondent promotes its product through advertising in newspapers, and in other materials such as brochure and flyers. Annual advertising expenditures are about \$200,000.

Before turning our attention to the merits of the petition, we direct our focus to the motion to amend the petition pursuant to Fed. R. Civ. P. 15(b). The motion was fully briefed by the parties, and the Board, in accordance with its usual practice, deferred ruling on the motion until final hearing.

Petitioner's motion to amend seeks to add a claim of mere descriptiveness to the petition for cancellation. The

motion to amend and supporting materials were filed after the testimony deposition of Mr. Young, with petitioner alleging that the motion was brought "because it has just come to light that respondent's goods are in fact matches which are large in size." Petitioner contends that the issue of mere descriptiveness was tried by the implied consent of the parties. Petitioner specifically points to certain portions of Mr. Young's testimony wherein he states that respondent's product is a match, a "big match"--"[a] match that has got super heat to it and it is super big." (dep., pp.18-19, 90-92) Petitioner maintains that there was no way for it to know that respondent's product is a "big match" until the time of Mr. Young's testimony. Respondent has objected to the motion.

The motion to amend is denied as not well taken. Our reading of the record, paying particular attention to the portions highlighted by petitioner in its motion, convinces us that the issue of mere descriptiveness was never tried, either expressly or implicitly, by the parties. Respondent was not sufficiently put on notice that mere descriptiveness was being raised. Fed. R. Civ. P. 15(b); and *Colony Foods, Inc. v. Sagemark, Ltd.*, 735 F.2d 1336, 222 USPQ 185 (Fed. Cir. 1984). Accordingly, we decline to consider the non-pleaded issue of mere descriptiveness.

We now turn to the merits of the petition for cancellation. The first issue for us to consider is priority of use.

Mr. Zeller testified at some length about the chronology of petitioner's use of the SUPERMATCH marks. Mr. Zeller stated that petitioner commenced its business in long-reach firestarting lighters in 1980 when it became apparent to him that the future of the cigarette lighter business looked dim. Around that same time, petitioner acquired another business, Westminster Industries, which was already involved in sales of electric "match" lighters under the mark SUPERMATCH. When petitioner began to think of a name for its new long-reach firestarting lighter, Westminster's principal, Ben Reiss, then a product manager for petitioner, suggested that the product be called SUPERMATCH: "Look, why don't we just call it Supermatch. We have already got the name Supermatch. We have been using it for a long time. It's a great name. Let's use the name Supermatch." (Zeller dep., p. 21) Petitioner launched a nationwide sales campaign for its long-reach lighter by way of a mailer in 1980. The product also was advertised in newspapers and magazines, and was promoted at trade shows. In 1983, a second model of the lighter was introduced under the mark SUPERMATCH XL.

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Around 1982, petitioner learned that a third party, BAM Butane (BAM), was using the mark SUPERMATCH in connection with cigarette lighters. BAM also owned a registration of the mark, namely Reg. No. 1,144,468. Petitioner and BAM entered into an agreement whereby petitioner continued using the mark to petitioner's own benefit. The agreement consenting to petitioner's use also provided that "[s]hould BAM cease use of the Trademark for a period of two years, all rights in the Trademark and Registration 1,144,468 shall revert to [petitioner]." In 1990, the registration was canceled for failure to file a Section 8 affidavit of continued use.

Sales of petitioner's SUPERMATCH brand lighter continued until "1992 or 1993, something like that" when petitioner curtailed its production of the SUPERMATCH product due to the enactment of federal government regulations to improve the safety of disposable cigarette lighters. According to Mr. Zeller, these regulations, coupled with product liability insurance concerns, compelled petitioner to come out with a new, safer model. Petitioner developed an idea for a child resistant model, essentially a long-reach lighter with a safety lock. Mr. Zeller testified that it was too expensive to retool the then-current model of its lighter, so plans were made to develop a new product. It took longer than planned to develop the new product, and

the new product was launched in 1993-1994 under the mark SUPERMATCH FLX.

Mr. Zeller testified in some detail about petitioner's activities surrounding the development of the new product while production of the older product was curtailed. Although the older product was no longer being shipped to distributors in 1993-94, there was inventory in the field and, according to Mr. Zeller, the SUPERMATCH XL brand lighters were sold continuously during this time. (dep., p. 88) In connection with Mr. Zeller's testimony, petitioner introduced exhibits documenting costs associated with the development and redesign of the new product. During this development phase, petitioner was still appearing at trade shows to promote its SUPERMATCH product: "We were showing the SUPERMATCH [product] during the time we were developing the new model, but we were promising to ship the new model when it came off the line." (Zeller, pp. 109-110) Sales of the new model, sold under the mark SUPERMATCH FXL, have continued since that time.

Mr. Zeller gave further testimony regarding the years 1993-1994. Referring to a summary of annual sales (exhibit 38), Mr. Zeller acknowledged that no sales are shown for 1993 and 1994, and that advertising expenditures for 1992-1994 (exhibit 37) were decreased. With respect to the lack of sales, Mr. Zeller testified that the sales figures

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reflect sales to distributors, so that even though the sales summary shows zero for the years 1993 and 1994, petitioner's SUPERMATCH lighters were being sold by distributors and were still covered by product liability insurance. (Zeller dep., pp. 88-89; 118) According to Mr. Zeller, a sale is recorded by petitioner when the product is shipped to a distributor, but that "[i]t would be anywhere from one month to 12 months before it moves through the channels" when the product is sold off the shelf to the ultimate consumer. (dep., p. 88) Petitioner also continued to repair SUPERMATCH products during that period of time. As to the decrease in advertising expenditures, Mr. Zeller explained "[w]hen we decided to change the model, we didn't see any sense in continuing to advertise the old model, and as we were having difficulty shipping the new model, we were holding off--we didn't want to start creating a demand for the new model that couldn't be filled, so we held off our spending during that period..." (dep., p. 116) Mr. Zeller claims that petitioner never had an intention to abandon its SUPERMATCH mark. (dep., pp. 91-92)

According to Mr. Young, respondent did not commence its use of the mark SUPERMATCH until September 1990.

We find that petitioner's activities detailed above establish its priority of use of the mark SUPERMATCH dating back to a time prior to the earliest date upon which

respondent has established. The changes from SUPERMATCH to SUPERMATCH XL to the present SUPERMATCH FXL neither created a new mark nor changed the commercial impression created by the older mark. The XL and FXL portions added to SUPERMATCH were merely in the nature of model designations. The continuing common element of petitioner's mark, that is, SUPERMATCH, has engendered a continuing overall commercial impression through the years.

In finding that priority rests with petitioner, we readily recognize that petitioner made a decision in the early 1990's to cease production of its older model of SUPERMATCH XL brand lighter. However, the uncontradicted testimony and exhibits show that sales of the older product continued, while at the same time petitioner engaged in concrete efforts in the design and development of the new SUPERMATCH FXL product. In sum, contrary to respondent's arguments, there was no abandonment.⁵ Rather, the record establishes petitioner's continued use of the SUPERMATCH mark since long prior to respondent's first use.

With respect to likelihood of confusion, our determination under Section 2(d) is based on an analysis of

⁵ So as to be clear, this issue was not raised as an affirmative defense in the answer. Rather, the alleged abandonment was first raised in respondent's final brief on the case. Nonetheless, it is clear that this issue was tried by the parties, and petitioner has fully responded on the merits to the charge of abandonment. Accordingly, we deem the pleadings to be amended to conform to the evidence pursuant to Fed. R. Civ. P. 15(b).

all of the probative facts in evidence that are relevant to the factors bearing on this 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. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Turning first to the marks, petitioner's marks have evolved from SUPERMATCH in the early days to SUPERMATCH XL and now SUPERMATCH FXL. Respondent's mark is SUPERMATCH. We find that petitioner's SUPERMATCH marks and respondent's mark SUPERMATCH are substantially identical, with petitioner's presently used mark differing only by the addition of the FXL portion (which, as noted earlier, means "flexible extra long) in petitioner's mark. Clearly, the dominant portion of petitioner's mark is SUPERMATCH which is identical to respondent's mark. This is the term which would be used by consumers in calling for the product. Although we have compared the marks in their entirety, there is nothing improper in giving more weight to a particular portion of a mark if it would be remembered and relied upon to identify the goods. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Simply put, the marks are substantially identical in sound, appearance and meaning so that, if the marks were used in

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connection with the same or related goods, purchasers would be confused. In this connection, the Board has stated that "[i]f the marks are the same or almost so, it is only necessary that there be a viable relationship between the goods or services in order to support a holding of likelihood of confusion." In re Concordia International Forwarding Corp., 222 USPQ 355, 356 (TTAB 1983).

Insofar as the goods are concerned, the issue to be determined under Section 2(d) of the Act, in cases such as this, is not whether the goods in question are likely to be confused, but rather whether there is a likelihood that purchasers or potential purchasers thereof will be misled into the mistaken belief that they emanate from the same source. It is for this reason that the goods need not be identical or competitive in nature in order to support a finding of likelihood of confusion, it being sufficient for the purpose that the goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under circumstances that could give rise, because of the similarities between the marks used thereon, to the mistaken belief that they originate from or are in some way associated with the same source. Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423 (TTAB 1993).

We acknowledge that petitioner's long-reach lighter and respondent's firestarting briquettes are specifically different products. We find, however, that the record establishes that the products are related for purposes of our likelihood of confusion analysis. Both products are used to start fires, and both are used in fireplaces and barbecue grills. Advertising for the respective products has highlighted these two uses. Some articles in the press have suggested petitioner's product as an alternative to a match. Further, as shown by the record, the parties' goods travel in identical channels of trade and are purchased by the same classes of purchasers.

As pointed out by respondent, the goods have different price points. Nonetheless, although petitioner's product costs more than respondent's, it is still relatively inexpensive. It is unlikely that consumers will exercise anything more than ordinary care in purchasing the items; rather, given the nature of the products, consumers may well purchase them on impulse.

Some of the other duPont factors to which the parties have referred require comment.

Although we find that the mark SUPERMATCH is somewhat suggestive when used in connection with the parties' products, the record is devoid of any third-party registrations or uses of SUPERMATCH or similar marks in

connection with goods of the types involved herein. This factor weighs in petitioner's favor.

Petitioner relies on one incident as evidence of actual confusion. The one phone call referred to by Mr. Zeller (dep., pp. 155-56) hardly qualifies as probative evidence establishing the existence of actual confusion in the marketplace. Thus, we have reached our decision without giving any weight to petitioner's evidence. In any event, actual confusion need not be shown; the test is the likelihood of confusion.

Finally, to the extent that any of respondent's arguments casts doubt on our conclusion, we resolve those doubts, as we must, in favor of the prior user. *Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1 (CCPA 1977).

We conclude that purchasers familiar with petitioner's long-reach lighter sold under its mark SUPERMATCH FXL would be likely to believe, upon encountering applicant's mark SUPERMATCH for firestarting briquettes for use with barbecue grills, wood stoves and fireplaces, that the goods originated with or are somehow associated with or sponsored by the same entity.

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Decision: The petition for cancellation is granted.
Registration No. 1,662,173 will be canceled in due course.

T. J. Quinn

G. D. Hohein

C. M. Bottorff
Administrative Trademark
Judges, Trademark Trial
and Appeal Board