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Paper No. 39
HRW

11/15/00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Slim N' Trim, Inc.

v.

Mehadrin Dairy Corp.

Cancellation No. 25,986

Charles H. Thomas of Cislo & Thomas LLP for Slim N' Trim,
Inc.

JoAnne M. Denison of Denison & Assocs., PC for
Mehadrin Dairy Corp.

Before Seeherman, Wendel and Rogers, Administrative
Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Slim N' Trim, Inc. has filed a petition to cancel
Registration No. 1,990,294 for the mark SLIM 80 for
"dairy products, namely yogurt."¹

In the petition to cancel, Slim N' Trim, Inc.
(petitioner) alleges that petitioner is the owner of the

¹ Registration No. 1,990,294, issued July 30, 1996 from an
application filed under Section 1(b) on April 25, 1994, claiming
in its statement of use a first use date and first use in
commerce date of August 1994.

marks SLIM, SLIM CHEEZ, SLIM N' LIGHT, SLIM N' TRIM and SLIMLINE, all of which have been used for food products for weight conscious consumers, these products including low fat yogurt, non-fat milk, low fat cottage cheese, and ice milk, since long prior to 1994; that petitioner is the owner of the mark SLIM FREEZ which has been used for low fat frozen yogurt mix and other foods since long prior to 1994; that petitioner is the owner of several registrations for the above referenced marks;² that petitioner and its predecessors have licensed the use of

² The most relevant of these registrations are:

Registration No. 604,012, issued March 29, 1955, for the mark SLIM FREEZ for frozen ice milk dessert; second renewal;

Registration No. 608,411, issued July 5, 1955, for the mark SLIM CHEEZ (stylized) for cottage cheese; second renewal;

Registration No. 915,987, issued July 6, 1971, for the mark SLIM and design for non-fat milk; first renewal;

Registration No. 920,794, issued September 21, 1971, for the mark SLIM N' TRIM (stylized) for low fat milk, low fat cottage cheese, low fat yogurt, and ice milk; first renewal;

Registration No. 929,698, issued February 22, 1972, for the mark SLIM N' LIGHT (stylized) for low fat milk, ice milk, low fat cottage cheese, and low fat yogurt; first renewal;

Registration No. 996,908, issued October 29, 1974, for the mark SLIM N' TRIM (stylized) for conducting a dietary weight control program; first renewal;

Registration No. 1,342,986, issued June 18, 1985, for the mark SLIM N' TRIM (stylized) for cheese; Section 8 & 15 affidavits;

Registration No. 1,459,397, issued September 29, 1987, for the mark SLIM N' TRIM (stylized) for light sour cream and ultra pasteurized milk for coffee; Section 8 & 15 affidavits;

Registration No. 1,741,514, issued December 22, 1992, for the mark SLIM N' TRIM for reduced calorie butter; Section 8 & 15 affidavits; and

Registration No. 1,851,150, issued August 23, 1994, for the mark SLIMLINE for low fat cottage cheese and low fat yogurt.

its marks in connection with the production, marketing and sale of various dietary foods and beverages and the conduct of weight control programs; and that respondent's mark SLIM 80 will cause confusion and deception in that the purchasing public will believe respondent's yogurt products are sponsored, approved, or sold by petitioner.

Respondent, in its answer, has denied the salient allegations of the petition to cancel and has set forth the affirmative defenses of laches and acquiescence,³ based on allegations of petitioner's failure to timely object to registration of respondent's mark. Respondent alleges that its application was published for opposition November 15, 1994; that petitioner failed to file a timely notice of opposition; that since the mark was not opposed respondent began and later expanded use of its mark; that petitioner filed an untimely notice of opposition on August 30, 1996 and did not file a petition to cancel until March 1997.

The Record

The record consists of the file of the involved registration; the stipulated testimony and accompanying exhibits of George Mills, Vice President of petitioner; the stipulated testimony and accompanying exhibits of

³ We note that respondent has pursued only the laches defense.

Samuel Leifer, President of respondent; and the status and title copies of petitioner's thirteen pleaded registrations, made of record by petitioner's notice of reliance. Both parties filed briefs, but an oral hearing was not requested.

The record shows that the sole function of petitioner is to manage the licensing of its trademarks to dairies or others who manufacture and sell products under the marks, in the same manner as did its predecessors, Bellbrook Dairy and Edlo Enterprises, Inc., from whom it obtained by assignment many of its marks. Under petitioner's licensing program, petitioner provides the licensee with a package design, product specifications, merchandising and advertising tools, and petitioner conducts quality control to ensure adherence to specifications. The licensee has the option of adding its brand name to its particular package design, along with the mark licensed from petitioner.

Petitioner's marks are used on low calorie, low fat food items, predominantly dairy products, and are sold in various areas of the United States in supermarkets and other retail grocery outlets. Petitioner's licensees sold over 4.5 million units of cheese and yogurt combined

and over 19 million units of milk in the year 1997 (a unit of cheese is 8 oz., a unit of yogurt is 6-8 oz. and a unit of milk is a quart). Petitioner and its licensees engage in many forms of advertising, including cooperative advertising with supermarkets in newspapers, merchandising promotions, point-of-sale materials, television advertising and the like. Mr. Mills, in his stipulated testimony, estimated the advertising expenditures by the licensees alone in 1997 at approximately \$473,000.

Mr. Mills testified that petitioner has used its mark SLIM not only on non-fat milk, but also on non-fat yogurt, with the first use thereof being in 1992. He identified yogurt cartons bearing the SLIM mark used by licensee Clover Stornetta in the San Francisco area from 1992 (Exhibits 23 and 24) and one bearing the SLIM mark used by licensee Crystal in 1992 in northern California.

Respondent is a small company specializing in kosher dairy products and operates in the New York metropolitan area as well as upstate New York. Respondent's dairy products are manufactured under the strictest Orthodox standards and accordingly are priced approximately 15% more than non-kosher dairy products. Respondent filed its intent-to-use application in April 1994 and began

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limited use of its SLIM 80 mark in August 1994, with sales of about 200,000 units of yogurt that year. The mark was published for opposition on November 15, 1994. When no opposition was filed to its mark by December 1994, respondent increased usage of its mark and has had sales of approximately 500,000 units for each year from 1995 to 1998.

The Petition for Cancellation

There is no issue as to priority. The status and title copies of petitioner's registrations which have been made of record establish filing dates for the underlying applications which are earlier than respondent's filing date of its intent-to-use application, the earliest date upon which respondent may rely. Furthermore, the testimony of George Mills corroborates petitioner's use of its marks well prior to respondent's filing date.

Turning to the issue of likelihood of confusion, we take under consideration all of the du Pont factors which are relevant under the present circumstances and for which there is evidence of record. See *E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

We look first to the goods of the parties and the similarity or dissimilarity thereof.

Petitioner has made evidence of record of its use of its common law SLIM mark on non-fat yogurt since a time prior to the filing of applicant's application.

Petitioner's registrations for its marks cover several low fat dairy products. Most significant for our present analysis, petitioner has registered its mark SLIM for non-fat milk, and its marks SLIM N' TRIM, SLIM N' LIGHT and SLIMLINE for, inter alia, low fat yogurt.

Although respondent argues that petitioner has failed to properly establish common law rights in the mark SLIM for yogurt, we do not agree. The stipulated testimony of George Mills substantiates use of the mark SLIM for yogurt by two of petitioner's licensees in certain areas of California well prior to the earliest date of use upon which respondent may rely. Respondent's arguments that petitioner has not proven either dates of first use in interstate commerce or that it is the proper owner of the mark are to no avail. In the first place, use in interstate commerce is not necessary under Section 2(d); all that is necessary is that a mark has been "previously used in the United States by another and not abandoned." Prior use by petitioner has been established

and respondent has presented neither argument nor evidence that petitioner has abandoned this use of its SLIM mark. Moreover, petitioner has established that both Clover Stornetta and Crystal are licensees of petitioner and thus the cartons which have been made of record bearing the SLIM mark as used by the licensees constitute evidence of use which inures to petitioner's benefit.

Respondent's goods, as identified in its registration, are yogurt. Although respondent argues that its yogurt differs from petitioner's low fat yogurt in that respondent's product is manufactured in accordance with the strictest Orthodox Jewish standards, this difference is not reflected in the identification of goods.⁴ It is well established that when evaluating likelihood of confusion in proceedings concerning the registrability of marks, we consider the goods as identified in an involved registration, regardless of any

⁴ Although respondent, in its brief, has stated that it is willing to amend its identification of goods to specify "Kosher" or "Kasruth" yogurt, no consideration can be given to this untimely offer. Had respondent wished to rely upon the provisions of Section 18 whereby restriction of its application might be considered as a means of avoiding likelihood of confusion, respondent should have proffered an amendment to this effect earlier in the proceeding such that petitioner would be put on notice and the issue fully tried. See *Reflange Inc. v R-Con International*, 17 USPQ2d 1125 (TTAB 1990); *Space Base Inc.*

evidence of record as to the particular nature of the goods. See *Miles Laboratories Inc. v. Naturally Vitamins Supplements Inc.*, 1 USPQ2d 1445 (TTAB 1987) and the cases cited therein. Accordingly, respondent's yogurt must be presumed to be identical to petitioner's yogurt.

Even if petitioner could not rely upon its common law rights in SLIM for yogurt, which is not the case, petitioner has registered the same mark for non-fat milk. In addition, petitioner has two registrations for marks (SLIM N'TRIM and SLIM N'LIGHT) for both low fat milk and low fat yogurt, along with other items. Petitioner has made of record several newspaper advertisements featuring both products bearing the same mark in the same ad (e.g., Exhibit 69) and a photograph of a store display of milk and yogurt in close proximity to each other in the dairy case (Exhibit 72). We consider this sufficient evidence to show that yogurt and non-fat milk are closely related products and that customers would be likely to assume that both products emanate from a single source, if a similar mark is used thereon.

Respondent's further arguments as to the differences in channels of trade and class of customers because its yogurt is a kosher product are also to no avail. As has

v. Stadis Corp., 17 USPQ2d 1216 (TTAB 1990). No such amendment

been frequently stated, in the absence of any limitations in the identification of goods in the involved registration as to channels of trade, we must presume that the goods travel in all the normal channels of trade for such goods. See Kangol Ltd. v. KangaROOS U.S.A., 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992). Respondent's yogurt, as identified in its registration, cannot be construed, as respondent argues, as being sold exclusively in small kosher grocery stores. In a similar vein, respondent's customers cannot be restricted to persons seeking a kosher product. The channels of trade and the classes of customers for respondent's yogurt must be presumed to encompass all supermarkets and other retail outlets in which yogurt and related dairy products are sold and all customers who purchase such products. Moreover, there is no reason why kosher yogurt would not be found in the same supermarkets as non-kosher products such as petitioner's. In this connection, we take judicial notice that many supermarkets offer both kosher and non-kosher products.

No particular degree of sophistication can be presumed for the purchasers of these low cost items; even

was submitted.

if respondent's yogurt sells for a 15% higher price, this is not a major difference in cost.

Respondent also argues that the parties' goods are sold in geographically remote areas, with respondent's sales being in New York State and petitioner's sales primarily on the West Coast. This argument is equally unpersuasive. Federal registration creates the presumption that respondent has the exclusive right to use its mark throughout the United States and any present geographic limitation in markets is irrelevant. See *Coach House Restaurant Inc. v. Coach and Six Restaurants Inc.*, 934 F.2d 1551, 19 USPQ2d 1401 (11th Cir. 1991).

Thus, we turn to a highly significant factor in this proceeding, the similarities or dissimilarities of the marks of the parties. We make this comparison keeping in mind the well-established principle that the degree of similarity necessary to support a conclusion of likelihood of confusion decreases when the marks are being used on virtually identical goods. See *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

Because it is the closest of petitioner's marks to respondent's mark SLIM 80, we have focused our consideration on petitioner's mark SLIM, which includes

both its common law rights in the mark for non-fat yogurt and its registration of the mark for non-fat milk.

For purposes of comparison, petitioner's mark must be viewed as the word SLIM; as shown below, the design element of the mark as used and as registered is minimal.

Respondent's mark consists of the identical word, SLIM, and the number 80. Despite respondent's arguments to the contrary, we do not find the addition of this number sufficient to distinguish the marks. The commercial impressions created by the marks as a whole are highly similar.

Although respondent insists that "80" is the dominant component of its mark and must be given greater weight, we fail to see how the number 80 would be viewed as other than the calorie count of respondent's yogurt. The specimens of record show that the calorie count of 80 is set forth on the front label, in close proximity to the mark SLIM 80. Even if we consider the mark SLIM 80 without referring to its presentation on the carton, we believe that customers would perceive the mark as a variation of petitioner's mark SLIM being used for a

particular type of yogurt. With calorie count being of such great significance in connection with food products for weight-conscious consumers, the correlation of the number 80 and calorie count would appear to be inevitable.

Applicant's argument that the term "slim" is frequently used in connection with weight loss products, and thus is highly suggestive, or that "a glut of companies are using marks containing a 'slim' component" has not been substantiated.⁵ Although SLIM may have some suggestive significance when used with a low calorie product, we consider the number 80, as used in respondent's mark, to be far more suggestive than the term SLIM, despite respondent's contentions otherwise. We think the situation here is analogous to those prior cases in which the predecessor of our principal reviewing court held the components "vita" in VITA-SLIM, and "sta" in STA-SLIM to be the elements with lesser significance

⁵ Attachment A to respondent's brief, referring to third-party marks, is not in evidence because it was not submitted during respondent's testimony period, as pointed out by petitioner in its reply brief, and accordingly has been given no consideration. The search report introduced by respondent's witness is not evidence of use of, or familiarity of the public with, the marks in the applications and registrations listed therein. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22USPQ2d 1542 (Fed. Cir. 1992). Even the three marks which respondent specifically relies upon have not been shown to be in use.

in the marks and thus found a likelihood of confusion of each mark with petitioner's mark SLIM.⁶ See, respectively, *Bellbrook Dairies, Inc. v. Hawthorn-Mellody Farms Dairy, Inc.*, 253 F.2d 431, 117 USPQ 213 (CCPA 1958) and *Bellbrook Dairies, Inc. v. Bowman Dairy Co.*, 273 F.2d 620, 124 USPQ 316 (CCPA 1960).

Respondent's arguments with respect to the differences in trade dress and the display of the respective marks are immaterial. Respondent's registration is for the mark SLIM 80 in typed form and thus respondent is free to use its mark in any format. Respondent is in no way restricted to its present display in which the term SLIM is not as prominent as the number 80. As our principal reviewing court has stated, for a word mark we ordinarily do not look to the trade dress, which may be changed at any time. See *Specialty Brands Inc. v. Coffee Bean Distributors Inc.*, 748 F.2d 669, 223 USPQ 1282 (Fed. Cir. 1984). Although it is true that trade dress may be viewed as evidence that two marks project similar commercial impressions, the converse is not true. Whether or not respondent's present display of its mark emphasizes the number 80 is immaterial; the

⁶ We note that the court specifically held that the term "slim" was only suggestive when used with skim milk and not descriptive.

display could be changed tomorrow to one much more similar to that used for petitioner's SLIM mark.

Respondent has also raised the factor of actual confusion, pointing out that at the time of submission of its brief the respective marks had been in use for almost five years with no reported instances of actual confusion. Respondent has stated, however, that its selling arena is limited to New York State whereas petitioner's sales appear to be concentrated on the West Coast. Although this geographic disparity cannot support respondent's claim of the absence of any likelihood of confusion, it obviously explains the absence of actual confusion up until the present time. Thus, we can accord little significance to this factor in our determination of likelihood of confusion.

Weighing the factors shown to be relevant to our present determination of likelihood of confusion, we find the balance to fall solidly in petitioner's favor. We rely in particular on the similarity of commercial impressions of the respective marks and the identity or close relationship, of the goods with which these marks are being used.

Respondent has raised, however, the affirmative defense of laches, arguing that petitioner's delay in filing its claim against respondent's mark was unreasonable and that respondent's reliance upon this failure of petitioner and its expansion of sales under its mark would result in material prejudice to respondent if it were required to discontinue use of its mark. Petitioner, in response, contends that respondent has failed to carry its burden of proof with respect to this defense; that if respondent's position were adopted, the entire remedy of filing a petition for cancellation would be rendered meaningless.

As set forth in *Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes Inc.*, 971 F.2d 732, 23 USPQ2d 1701 (Fed. Cir. 1992), the elements of laches are (1) unreasonable delay in assertion of one's rights against another; and (2) material prejudice to the other attributable to this delay. As applied to a cancellation proceeding, the defense is tied to the party's registration of its mark and the time from which laches starts to run is the date the mark is published for opposition. See *National Cable Television Association Inc. v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991).

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Respondent's mark was published for opposition as an intent-to-use application on November 15, 1994.

Petitioner failed to file a notice of opposition during the thirty day period. Respondent filed its statement of use on February 7, 1996 and the registration issued July 30, 1996. Petitioner, apparently in the mistaken belief that respondent's mark had been published for opposition on this latter date, filed a notice of opposition on August 30, 1996. The notice was refused as untimely and returned to petitioner. Petitioner then filed the present petition to cancel on January 27, 1997.⁷

As stated above, petitioner must be considered to have been on notice of respondent's mark as of the date of publication for opposition, November 15, 1994. Since petitioner missed the time to file an opposition, however, petitioner's only remedy was to file a petition for cancellation after issuance of the registration.

The fact that there was a delay of over two years between the date of publication of the application and the filing of the petition to cancel cannot be attributed to petitioner's inaction. Respondent did not file its statement of use until almost fifteen months after the publication date. Thus, fifteen months of the two year

⁷ Respondent's reference to March 1997 reflects the time when

delay in the issuance of the registration was solely because of respondent's failure to file its statement of use until February 7, 1996, even though respondent claims to have begun use of its mark in August 1994 and to have expanded its use in December 1994.

The only time delay which can be attributed to petitioner is from July 30, 1996, when the registration issued, until the petition to cancel was filed on January 27, 1997. We do not consider this six-month delay unreasonable, especially in view of petitioner's attempt, albeit untimely, to file an opposition. Were we to hold otherwise, the remedy afforded under the Trademark Act for cancellation would be virtually eliminated. Accordingly, we find that respondent has failed to establish an unreasonable delay on the part of petitioner, the first element in a laches defense. Thus we need not consider the element of material prejudice to respondent.

Decision: The petition to cancel is granted.

E. J. Seeherman

the petition was served on respondent by the Board.

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H. R. Wendel

G. F. Rogers

Administrative Trademark Judges,
Trademark Trial and Appeal Board