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Hearing: July 17, 2001

Paper No. 80
TJQ

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Gus Sclafani Corporation
v.
Violet Packing Company

Opposition No. 106,710
to application Serial No. 75/083,203
filed on April 3, 1996

Cancellation Nos. 25,837 and 27,434

Peter W. Peterson, Kelly Reynolds and Robert Curcio of DeLio & Peterson for Gus Sclafani Corporation.

Robert DeVos, B. Parker Livingston, Jr. and Bassam N. Ibrahim of Burns, Doane, Swecker & Mathis for Violet Packing Company.

Before Quinn, Walters and Drost, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

In these consolidated proceedings, Gus Sclafani Corporation (opposer) has opposed an application and sought to cancel two registrations owned by Violet Packing Company

(applicant). The involved application is to register the mark SCLAFANI (typed form) for "cheeses, diced tomatoes, olive oil, blended oils for cooking, tomato filet, tomato paste, tomato puree, whole peeled tomatoes, tuna fish, and processed fruit, olives, mushrooms, and artichokes" (in International Class 29) and "pasta, tomato sauce and vinegar" (in International Class 30).[1] The registrations sought to be canceled are for the mark SCLAFANI (typed form) for "processed vegetables" (in International Class 29) and "pizza sauce and spaghetti sauce" (in International Class 30)[2] and for "canned tomatoes."[3]

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[1] Application Serial No. 75/083,203, filed April 3, 1996, alleging a bona fide intention to use the mark in commerce. Based on its alleged use of SCLAFANI for food products for ninety-six years and its ownership of Registration No. 1,733,345, applicant claims acquired distinctiveness under Section 2(f) of the Trademark Act.

[2] Registration No. 1,733,345, issued November 17, 1992, under the provisions of Section 2(f) of the Act. During this litigation, applicant filed, on December 10, 1998, an amendment to change the dates of first use set forth in this registration. The registration claims October 1926 as the date of first use and first use in commerce of the mark in connection with the goods in International Class 30, namely pizza sauce and spaghetti sauce. Based on testimony adduced at trial, applicant seeks to amend the date to "since at least as early as 1948." Opposer objected to the motion, and the Board deferred ruling on the motion until final hearing. Although the record is confusing as to priority, opposer appears to concede use by applicant at least as early as 1945 (brief, pp. 41-42). Inasmuch as applicant seeks to amend to later dates of use, and since the record supports such use, the amendment is accepted. The dates of first use for International Class 30 will be amended to 1948.

[3] Registration No. 2,078,857, issued July 15, 1997, under the provisions of Section 2(f).

In its pleadings, opposer relies on common law rights, asserting priority and likelihood of confusion under Section 2(d) of the Act. More specifically, opposer alleges that applicant's mark, when applied to applicant's goods, so resembles opposer's previously used mark SCLAFANI for a variety of food items, including cheeses, canned tomatoes, olive oil, tomato paste, canned vegetables, pasta, tomato sauce and vinegar, as to be likely to cause confusion.[4] Opposer claims use of SCLAFANI "from a time prior to October 1926."[5]

Applicant, in its answers, denied the salient allegations of priority and likelihood of confusion. Applicant also set forth affirmative defenses, including acquiescence, laches and estoppel. The affirmative defenses are based on applicant's long ownership of two prior registrations, now expired.[6]

The record in this case is voluminous and includes the pleadings; the files of the involved application and registrations; trial testimony, with related exhibits,

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[4] The pleadings do not include any claim of rights based on use of the trade name "Gus Sclafani Corporation."

[5] In its brief (p. 37), opposer claims use of the mark on products "by at least 1917 and not later than 1921-1922."

[6] Applicant owned registrations of SCLAFANI and design for "canned vegetables and canned fish" (Registration No. 288,218, issued October 20, 1931) and SCLAFANI BRAND and design for "olive oil" (Registration No. 289,928, issued December 15, 1931). After being renewed twice, the registrations were allowed to lapse.

taken by each party; and official records and excerpts from printed publications introduced by the parties' notices of reliance. The parties filed lengthy briefs, and both were represented by counsel at an oral hearing held before this panel.

Although the record is extensive, the probative value of the record has been significantly reduced by a variety of factors, inter alia: material witnesses who were principals of the parties and who had personal knowledge of the business of the respective parties, including adoption of their marks, died prior to this litigation; lost business records regarding early uses of the marks; informally-run family businesses with no formal documentation tracing their succession; and imperfect or selective memories of alleged business activities that happened as long ago as eighty years. These factors have combined to add to the complexity of determining the respective rights of the parties based on a confusing and incomplete record. Further, on critical points regarding first uses of the marks, the briefs speak in vague and ambiguous generalities (especially regarding the issue of tacking).

To get a flavor of these proceedings, it is significant to note, at the outset, that the parties are by

no means strangers. Quite the contrary, not only are the parties familiar with each other's uses of the identical SCLAFANI mark, but they have had cordial business and personal relationships over a period of several decades. Indeed, the record shows that the parties continue to do business with one another even as late as this proceeding. As set forth in greater detail below, opposer continues to buy applicant's SCLAFANI brand spaghetti sauce for opposer's resale to its institutional customers. This long-standing relationship, spanning decades, makes the current litigation all the more difficult to resolve.

As indicated above, applicant owned SCLAFANI registrations dating back to 1931.[7] These registrations went unchallenged (including at the time of republication of the marks in 1949) by opposer or anyone else for sixty years, at which time they were allowed to expire when

[7] One of the registrations included the following statement: "For the purposes of this registration only, exclusive use of the word 'Sclafani' is claimed only in association with the other features of the mark as shown." The Act of 1905 prohibited registration of surnames, and a surname was not registrable unless it was shown that it had been used exclusively by the applicant as a trademark for the period of 10 years prior to February 20, 1905 or was in special form. "Names which had acquired a secondary significance were not registrable unless they were used during the ten-year period or were printed, written, impressed or woven in some particular manner. In the latter case, even after registration, protection was limited to the distinctive manner of display, and no rights were recognized in the name as such." Daphne Robert, *The New Trade-Mark Manual: A Handbook on Protection of Trade-Marks in Interstate Commerce* (1947) at p. 52.

applicant filed to register SCLAFANI in typed form (later issuing as Registration No. 1,733,345). In 1935, opposer secured registrations of the mark LINA, and in 1941, of BUON GIORNO to cover certain food products; no attempt was ever made to register SCLAFANI until recently.

It appears that the parties' relationship began to deteriorate in the early to mid 1990's with the deaths of the two fathers running the respective businesses, Luciano J. Sclafani, Sr. (opposer) and Dominic Sclafani (applicant). The business operations were then passed on to other family members. Although we decline to discuss this point in detail in view of some of the hearsay problems with the testimony, as well as the fact that some of the testimony involves settlement overtures, suffice it to say that the parties, under the direction of the now-deceased fathers, operated in a contemporaneous and competitive environment for many years, yet with nary a problem between the two. As Luciano V. Sclafani, Jr. testified:

> Well, by in large, over the years they had a business very analogous to us. We were good competitors. We sold, they sold. We had business relations with them. In fact, it was friendly to the point where sometimes on cheese shipments we would bring cheese in the same container, freight it together, share the cost. It was a close

> relationship. Although we were competitors it was always on a very friendly basis. And there was never a question of attacking the other. There was respect between the two parties, which there still is. (p. 302)

Both parties testified about the close relationship between the late fathers; Luciano V. Sclafani, Jr. even testified that Dominic Sclafani (of applicant) was "since my father died [in 1991], in some instances almost like a second father." (p. 347) Luciano V. Sclafani, Jr. testified that "my late father and late Dominic had a very close relationship. It was never an adversarial relationship. They were very close and, historically, [applicant] did their thing and [opposer], we did our thing." (p. 345) The testimony and the parties' business relationship reveal that they had an understanding between themselves relative to their respective uses of the SCLAFANI mark. Again, in the words of Luciano V. Sclafani, Jr., "they [applicant] did their thing, we did our thing." (p. 350)

The Board cannot help but note at the outset that the parties' "live and let live" posture that guided their relationship for many years might have served them well herein in a settlement of their differences. In the words of Luciano V. Sclafani, Jr., "Only idiots litigate, unless you can't work out something." (p. 415) Nevertheless, the

parties chose to litigate, and we are left to decide the case.

Evidentiary Objections

We first direct our attention to an evidentiary skirmish between the parties. Opposer, in its reply brief, objected to certain testimony and evidence relied upon by applicant in its brief. The bulk of opposer's objections are grounded on hearsay, especially with respect to testimony and evidence regarding applicant's early business activities. When this issue was raised earlier in the proceeding in connection with the parties' cross motions for summary judgment, the Board, in its order dated April 16, 1999, ruled that "[d]efendant's witnesses are competent to testify to those matters of which they have personal knowledge, including their personal knowledge of company history based upon their personal and repeated review of and familiarity with company business records." The Board went on to state that "printed publications submitted by defendant are admissible in accordance with the above standard" and that "documents and photographs are considered admissible to the extent they are based on the personal knowledge of the witnesses who identified them."

We have reviewed the record with an eye on the hearsay problems identified by opposer. We reaffirm the Board's

earlier ruling that any statements made which were not based on the personal knowledge of the witnesses are hearsay and, thus, inadmissible. The hearsay problem extends to certain documents as well, especially exhibit nos. 144 and 147 (newspaper articles that chronicle the history of applicant's business).

Accordingly, we have not accorded any probative value to the testimony and evidence that suffers from hearsay.

Priority

The crux of the controversy in this case is priority of use of the mark SCLAFANI on food products. The parties have litigated this case essentially on the issue of "traditional" priority, that is, who was the first to use the mark SCLAFANI. In doing so, however, the parties overlooked a critical legal point in this case, namely that the mark at issue, SCLAFANI, is primarily merely a surname.[8] 15 U.S.C. §1052(e)(4).

[8] The involved registrations and applications all claimed the benefits of Section 2(f). Such claim is tantamount to an admission that the name lacks inherent distinctiveness. Yamaha International Corp. v. Hoshino Gakki Co., 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988); and In re Cabot Corp., 15 USPQ2d 1224 (TTAB 1990). Many of the principals of the parties carry the surname "Sclafani." Lest there be any doubt about the surname significance, the various directories of record show many listings of "Sclafani" surnames. Further, there is nothing of record to suggest any meaning of the name other than as a surname. Although it appears that opposer's pending applications (currently suspended) do not include a claim under Section 2(f), it is clear from this record that opposer's mark suffers from the

Surnames have been placed into that category of non-inherently distinctive terms which require proof of acquired distinctiveness for protection. 2 J.T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, §13:2 (4th ed. 2001). Stated somewhat differently in the context of the issues of priority and likelihood of confusion herein, surnames like SCLAFANI are one of the classes of marks that do not have the status of a protectable mark upon mere adoption and use. Rather, surnames acquire legally protectable status only after they have had such an impact upon a substantial part of the buying public as to have acquired distinctiveness. See: In re I. Lewis Cigar Mfg. Co., 205 F.2d 204, 98 USPQ 265 (CCPA 1953). Thus, the priority contest in the instant case is not one of who used the mark first chronologically; rather, the test is which party first acquired distinctiveness in its mark.[9] See:

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same infirmity, that is, that it is primarily merely a surname. The record clearly establishes that SCLAFANI is primarily merely a surname, and we have no choice but to conclude that the parties' marks are not inherently distinctive.

[9] We recognize that opposer has challenged registration on the basis of priority and likelihood of confusion, not the adequacy of applicant's claim of acquired distinctiveness. Nor has applicant raised as an affirmative defense that opposer lacks proprietary rights in its mark due to SCLAFANI being primarily merely a surname. Notwithstanding these omissions, given that it is clear that the term SCLAFANI is primarily merely a surname, priority rests with the one who establishes the earlier date of acquired distinctiveness under Section 2(f). And, proof of a prior proprietary right is, of course, a requirement for opposer to prevail here.

Hoover Co. v. Royal Appliance Manufacturing Co., 238 F.3d 1357, 57 USPQ2d 1720, 1721-22 (Fed. Cir. 2001); Towers v. Advent Software Inc., 17 USPQ2d 1471 (TTAB 1989), *aff'd*, 913 F.2d 942, 16 USPQ2d 1039 (Fed. Cir. 1990); Perma Ceram Enterprises Inc. v. Preco Industries Ltd., 23 USPQ2d 1134, 1138 (TTAB 1992); and *McCarthy on Trademarks and Unfair Competition*, supra at §16:34. A mark on which a Section 2(d) claim rests must be distinctive, either inherently or through the acquisition of secondary meaning, and since the mark at issue herein is not inherently distinctive, the critical question is who was the first to acquire distinctiveness for its mark. Otto Roth & Company, Inc. v. Universal Foods Corp., 640 F.2d 1317, 209 USPQ 40 (CCPA 1981); Levi Strauss & Co. v. R. Josephs Sportswear Inc., 36 USPQ2d 1328, 1330 (TTAB 1994); and Shalom Children's Wear Inc. v. In-Wear A/S, 26 USPQ2d 1516, 1520 (TTAB 1993).

Unfortunately, neither party has couched in its brief, let alone litigated at trial, the merits of the priority contest in terms of who established the earlier date of acquired distinctiveness. Opposer, having the burden of proof, was obligated to prove that its mark SCLAFANI, through use in connection with certain products, was the mark to first acquire distinctiveness. We find that the record is hopelessly confused and incomplete on this point,

undoubtedly due, in no small part, to the fact that this element of proof was overlooked by the parties. Given that priority of acquired distinctiveness is a legal requirement of opposer's Section 2(d) claim herein, we are constrained to find that opposer has failed to sustain its burden of proof in showing priority of acquired distinctiveness and, therefore, the claim must fail.[10]

In saying this, we acknowledge that the acquired distinctiveness of surnames generally is demonstrated with a minimum of evidence, in some cases with only five years of use. However, in a priority dispute between two non-inherently distinctive marks, it is possible that the second user's mark may be the first one to acquire distinctiveness, as for example, due to extensive sales and advertising involving the second user's mark. The extensive use may result in the purchasing public's recognition of the second user's name as a source indicator before the same perception develops for the first user's mark.

[10] Even if this priority contest involved marks that were inherently distinctive, the record is every bit as unclear and incomplete as to which party first used the mark, and we find that opposer has not met its burden of proof that it used SCLAFANI prior to applicant. As indicated above, the record suffers from lack of documentation and memories of events decades ago, some dating back to the early 1900s.

In view of the highly unusual factual background of this case, even if the priority issue had been tried in terms of acquired distinctiveness, there is a problem with any claim by opposer that its mark acquired distinctiveness before applicant's mark.

The parties for many years have contemporaneously used, in open and notorious fashion, the identical mark SCLAFANI in connection with identical or closely related food items. Also, as alluded to earlier, opposer even continues to purchase SCLAFANI brand spaghetti sauce from applicant for resale under the mark SCLAFANI. We refer to the testimony of opposer's president, Luciano V. Sclafani, Jr.:

> We have been using their [applicant's] prepared spaghetti sauce for how many years? Got to be at least about, a guess, I'd say ten years...We buy a certain--I would have to guess. Just guessing, probably say about, on a yearly basis, over a thousand cases per year in the last--I would say in the last couple years. (p. 177)
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> Now, we do buy their No. 10 size, which is the institutional size, because we, Gus Sclafani Corp., do not have a 6/10 institutional style spaghetti sauce...Today we still buy 6/10 spaghetti sauce...We do buy the 6/10 spaghetti sauce in a No. 10 can container for the institutional trade, not for the consumer market. (pp. 395-96)

Donald L. Sclafani, applicant's vice president and treasurer, testified on behalf of applicant on this point:

> They've bought Sclafani No. 10 Spaghetti Sauce from us...It's food service and it was purchased for resale...At least a thousand cases a year. I think the last order we got from them was sometime this year--may have been in February or March. I believe it was 336 cases of No. 10 Sclafani Spaghetti Sauce. (pp. 105-06)

Applicant's exhibit no. 158 is the type of can (prominently displaying the SCLAFANI mark) involved in such sales.[11] Donald L. Sclafani testified that this can is a smaller version of the same type can that is sold to opposer.

Luciano V. Sclafani, Jr. and Donald L. Sclafani both testified that the parties' relationship has extended to sales of opposer's product to applicant as well. Luciano V. Sclafani, Jr. identified sales of various of its SCLAFANI brand products to applicant during the years 1992-96. (pp. 112-115). Donald L. Sclafani indicated that applicant bought items from opposer for Christmas baskets.

The marketplace reality is that the parties have been using and continue to use the identical mark for identical or closely related goods, and that opposer has sold applicant's SCLAFANI brand spaghetti sauce in applicant's

[11] The can indicates that the product is "Distributed by Don Pepino Sales Co., Inc." of New Jersey. According to Donald

cans to opposer's institutional customers. Given this situation, which apparently has existed for years, it is questionable whether either party could claim that its use has been "substantially exclusive" so that acquired distinctiveness has been achieved. In saying this, we hasten to reiterate that while proof of prior proprietary rights is critical to opposer's case, opposer has not attacked the sufficiency of applicant's claim of acquired distinctiveness and, thus, this issue is not before us.[12] The claim simply was neither pleaded nor tried. See: Yamaha International Corp. v. Hoshino Gakki Co. Ltd., supra

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Sclafani, applicant uses this name as a trade name in connection with some of its business activities. (pp. 8-9).

[12] In any event, at least with respect to applicant's two involved registrations, applicant is entitled to a *prima facie* presumption of acquired distinctiveness. See, e.g.: Arrow Fastener Co. v. Stanley Works, 59 F.3d 384, 35 USPQ2d 1449 (2d Cir. 1995); and Section 7(b) of the Act ["[a] certificate of registration of a mark upon the principal register...shall be *prima facie* evidence of the validity of the registration, registrant's ownership of the mark, and of registrant's exclusive right to use the mark in commerce."]. Cf. (with respect to applicant's two expired registrations): Action Temporary Services Inc. v. Labor Force Inc., 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989), citing Anderson, Clayton & Co. v. Krier, 478 F.2d 1246, 178 USPQ 46, 47 (CCPA 1973) ["recognizing that whatever benefits a federal registration confers are lost when that registration is canceled"]. If an opposer presents a "prima facie case challenging the sufficiency of applicant's proof of acquired distinctiveness, the applicant may then find it necessary to present additional evidence and argument to rebut or overcome the opposer's showing and to establish that the mark has acquired distinctiveness." Yamaha International Corp. v. Hoshino Gakki Co. Ltd., supra at 1005. It is the applicant, as the party asserting acquired distinctiveness, that has the ultimate burden of persuasion on the issue of acquired distinctiveness. Id. at 1006.

at 1005 [“To prevent the immediate registration of the mark, the opposer has the initial burden to establish prima facie that the applicant did not satisfy the acquired distinctiveness requirement of Section 2(f). If opposer does not provide sufficient grounds to at least place the matter in issue, the situation is indistinguishable from one in which no opposition was filed. Under such circumstances, there is insufficient basis in the record to indicate that the applicant’s mark, contrary to the examiner’s prior determination, has *not* ‘become distinctive of the applicant’s goods in commerce.’” (emphasis in original)(citations omitted)].

In sum, opposer, as plaintiff in these proceedings, had the burden of showing that its mark had acquired distinctiveness before applicant’s mark acquired distinctiveness, that is, that opposer had established prior proprietary rights to enable it to prevail on its Section 2(d) claim. The burden was not met in this case.

In this connection, we note language from our primary reviewing court:

> In respect of registration, there must be a trademark, i.e., purchasers in the marketplace must be able to recognize that a term or device has or has acquired such distinctiveness that it may be relied on as indicating one source of quality control and thus one

> quality standard. When the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term or device, an application for registration under Section 2(f) cannot be successful, for distinctiveness on which purchasers may rely is lacking under such circumstances.

Levi Strauss & Co. v. Genesco, Inc., 742 F.2d 1401, 222 USPQ 939, 940-941 (Fed. Cir. 1984). The Board likewise has found that significant use by others is detrimental to a claim of acquired distinctiveness. Worse yet is the situation, as in the present case, where a party is selling as their own the goods of another party claiming acquired distinctiveness. See: Edward Weck Inc. v. IM Inc., 17 USPQ2d 1142, 1145 (TTAB 1990); and British Seagull Ltd. Brunswick Corp., 28 USPQ2d 1197, 1203 (TTAB 1993)["When the party which claims that matter has become distinctive of its goods is faced with use by others of the same or similar matter on the same goods, that party has a difficult burden to meet. When such a party has sold its own goods, bearing a [mark] which it asserts has become distinctive of its goods, to third parties for resale to the consuming public as the products of those third parties, such practice detracts even further from the alleged distinctiveness of the [mark] as that party's

trademark.”], *aff’d*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994). Compare: L.D. Kichler Co. v. Davoil, Inc., 192 F.3d 1349, 52 USPQ2d 1307 (Fed. Cir. 1999)[“substantially exclusive” use in statute “makes allowance for use by others which may be inconsequential or infringing and which therefore does not necessarily invalidate the applicant’s claim”].

In summary, opposer’s claim must be dismissed due to opposer’s failure to prove an element of its claim, that is, that it has priority of acquired distinctiveness. Further, given applicant’s contemporaneous use, opposer’s use has not been “substantially exclusive” such that acquired distinctiveness has been established at any time.

Likelihood of Confusion

Given that opposer’s priority claim fails for lack of proof, that is, that we are unable to find that opposer had proprietary rights in the name SCLAFANI prior to the establishment of proprietary rights by applicant, the likelihood of confusion claim, of course, must fail.[13] For the sake of completeness, however, we will go on to address the merits of the Section 2(d) claim as if opposer’s

[13] Concomitant with this notion is the basic principle that if there is no acquired distinctiveness, there is no mark to protect and confusion is not possible. See: McCarthy, *McCarthy on Trademarks and Unfair Competition*, supra at §1511.

priority of acquired distinctiveness had been established.

Applicant, in its brief, accuses opposer of giving "only a cursory treatment" to the likelihood of confusion analysis. Given the identity between the marks and the virtual identity or substantial similarity between the goods, we find little to be gained from a detailed discussion of likelihood of confusion. This case is all about priority, with neither side expending a great deal of effort on the likelihood of confusion issue.

Our determination under Section 2(d) is based on an analysis of all of the 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 and/or services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

In this case, the marks are identical in sound, appearance and meaning. Further, the goods are all food products, with opposer's common law rights extending to a variety of food products, some of which are identical to applicant's products (e.g., canned tomato products). The parties' products otherwise are substantially similar.

Further, the goods travel in the same channels of trade, namely grocery stores. In point of fact, the products have been sold in the very same grocery stores. Another factor is that the goods are bought, in substantial part, by the same class of purchasers, namely ordinary consumers. The goods are relatively inexpensive and are purchased with only ordinary care.

One of the other du Pont factors highlighted by opposer is actual confusion. Doanld L. Sclafani testified about the existence of "maybe a dozen instances of confusion," but did not give the specifics pertaining thereto. Luciano V. Sclafani, Jr. testified that over the years he has received phone calls from customers chastising him for the salty or tinny taste of products they purchased. He directed the calls to applicant for the reason that, according to Mr. Sclafani, applicant's crushed tomato product has a much higher sodium content than does opposer's product.

Other than this testimony, the record includes only two documented instances that arguably show actual confusion, despite what appears to be many years of overlapping use. Both parties introduced testimony regarding a retail customer in Louisiana who purchased a case of opposer's crushed tomatoes. Some of the cans were

swollen or bloated and some “exploded” when she opened them. After a search on the Internet for a “Sclafani” entity, the customer contacted applicant and expressed her dissatisfaction with the product. Upon the return of these products to applicant, applicant discovered that they were, in fact, opposer’s product.

The second instance was discussed by Luciano V. Sclafani, Jr. He testified about an advertisement covering opposer’s products that opposer ran with a grocery store named Stop & Shop. The advertisement depicted a variety of opposer’s products. The advertisement also includes, however, a depiction of a can meant to be opposer’s product when, in point of fact, the pictured can was of applicant’s crushed tomatoes. Upon notifying the retailer, opposer was informed that there had been a mistake.

Given the many years of contemporaneous use of the identical marks for identical or virtually identical products in the same and/or contiguous geographical areas for decades, we tend to agree with applicant that only two instances of actual confusion, given the marketplace realities, is de minimis.

Normally, we would have expected that evidence of actual confusion would have been extensive. It would appear, however, that the parties’ informal business

cooperation (especially opposer's sales of applicant's spaghetti sauce) reduced the instances of actual confusion. Consumers may simply have thought, quite reasonably (albeit mistakenly), that the parties' products emanated from a common source.

Because of the parties' apparent estrangement, we are not confident that there would be no likelihood of confusion now. Upon consideration of the relevant du Pont factors in the context of the highly unusual fact situation herein, we find that the contemporaneous use of the parties' marks is likely to cause confusion.

Inevitability of Confusion

Given the du Pont factors weighing overwhelmingly in favor of confusion, it is clear that confusion is inevitable. In the past, confusion has been deemed inevitable in situations where, as here, identical marks are used in connection with the same or substantially similar goods.[14] See: Reflange Inc. v. R-Con International, 17 USPQ2d 1125, 1131 (TTAB 1990). In saying this, we are mindful of the absence in the record of significant instances of actual confusion. In many

[14] Looking back to our finding on the matter of opposer's proprietary rights, the facts that make confusion inevitable here also make acquired distinctiveness problematic.

situations, a finding of inevitable confusion is likely to be supported by multiple instances of actual confusion. As just indicated above, however, we suspect that the absence in the record of more instances of actual confusion may easily be explained by both the parties' relationship and most consumers' thinking, albeit mistakenly, that there is a common source of the parties' goods. This is never more true than with applicant's SCLAFANI brand spaghetti sauce that is bought by opposer and then resold to institutional customers.

LACHES

Applicant has raised the defense of laches based on its long ownership of two prior registrations, now expired. See: Aquion Partners L.P. v. Envirogard Products Ltd., 43 USPQ2d 1371 (TTAB 1997) citing Lincoln Logs Ltd. v. Lincoln Precut Log Homes, Inc., 971 F.2d 732, 23 USPQ2d 1701 (Fed. Cir. 1992), citing Copperweld Corp. v. Astralloy-Vulcan Corp., 196 USPQ 585 (TTAB 1971)[Under certain circumstances, a laches defense in a Board proceeding may be based upon a plaintiff's failure to object to a defendant's earlier registration of substantially the same mark for substantially the same goods.]. Laches, even if proven, will not prevent cancellation, however, where the marks and goods or services of the parties are

substantially similar and it is determined that confusion is inevitable. This is because any injury to a respondent caused by a petitioner's delay is outweighed by the public's interest in preventing confusion in the marketplace. Consequently, if there is an inevitability of confusion, laches is not applicable and thus does not bar the claim. See: McCarthy, *McCarthy on Trademarks and Unfair Competition*, supra §20:77.

As just indicated above, we find that confusion is inevitable and, accordingly, we need not address the equitable defense of laches.[15] See: Coach House Restaurant Inc. v. Coach and Six Restaurants, Inc., 934 F.2d 1551, 19 USPQ2d 1401, 1409 (11th Cir. 1991); and Reflange Inc. v. R-Con International, supra.

Other Issues

As indicated earlier, the only issues pleaded by opposer are priority and likelihood of confusion. Further,

[15] We would add that inasmuch as applicant's prior registrations are in special form whereas the involved registrations and application are in typed form (thereby broader in scope), it would appear that the marks are not legal equivalents. Further, the goods in the involved registrations and application are different, in large part, from the goods listed in the prior registrations. In sum, given the differences in the marks and the goods, a laches defense based on the prior registrations would not be available here. See: Van Dyne-Crotty, Inc. v. Wear-Guard Corp., 926 F.2d 1156, 17 USPQ2d 1866 (Fed. Cir. 1991); and Pro-Cuts v. Schilz-Price Enterprises, Inc., 27 USPQ2d 1224 (TTAB 1993).

in its brief (p. 32), opposer similarly identified the issues: "1. Whether registrant has established that it has a prior right to the mark SCLAFANI at a point in time prior to petitioner's first use. 2. Whether registrant has demonstrated use of the mark SCLAFANI as a trademark at a time prior to petitioner in a manner sufficient to entitle registrant to registration of the mark." No specific mention is made of abandonment. However, some of opposer's remarks (see, e.g., brief, pp. 26 and 50), in discussing priority, were directed to an alleged abandonment of applicant's mark on non-tomato products.

Applicant, in its brief (p. 8), sets forth a "statement of issues" which includes the following: "Whether Petitioner/Opposer Gus Sclafani Corporation has failed to establish that Registrant abandoned rights in the SCLAFANI mark." The brief goes on to discuss the abandonment issue.

In its reply brief, opposer devotes about one page (p. 22) to the abandonment issue.

There is testimony from applicant relating to the cessation of use of its mark SCLAFANI on certain products such as olive oil and canned anchovies. (Leo F. Sclafani dep., pp. 128-132). In considering abandonment of the two registered marks, however, a determination is made based on

the specific goods listed in the involved registrations. In this case, the goods listed in Registration No. 1,733,345 are "pizza sauce; spaghetti sauce; and processed vegetables" and in Registration No. 2,078,857 are "crushed tomatoes."

We find that the record establishes that there has been no abandonment of applicant's mark SCLAFANI for the above-mentioned four tomato-based products.[16] Rather, the record shows applicant's continuous use through the years of the mark SCLAFANI on tomato-based products.

Opposer also hints that there is a problem with the chain of title. Suffice it to say, that despite various changes in ownership of the mark through the years, the record shows that a series of related family-run businesses have owned the mark. The involved registrations currently are owned by Violet Packing Co., an entity that has owned the mark since prior to the filing of the underlying applications. Any use by related companies has inured to applicant's benefit.

[16] Opposer appears to concede that any abandonment relates to applicant's "non-tomato products." In saying this, we note opposer's remark that tomatoes are a "fruit." Although we recognize that tomatoes, as defined in the dictionary, are technically classified as a "fruit," we are inclined to view the identification "processed vegetables" as encompassing tomatoes. Further, the discussion relating to goods listed in applicant's prior registrations is irrelevant to any abandonment of the currently existing registrations.

Additional Remarks

The record, as indicated above, is voluminous, and the parties have expended much effort in litigating this case. However, because of the parties' peaceful coexistence over so many years, the maintenance of the parties' positions is a proper result.

As a postscript to this litigation, we note Professor McCarthy's discussion about various courts' attempts at compromise in litigation involving personal names. See generally: McCarthy, *McCarthy on Trademarks and Unfair Competition*, supra at §13:9. In his discussion, Professor McCarthy highlights a conflict between two competing policies: the policy of protecting the senior user and the consumer from injury resulting from a likelihood of confusion where similar marks are used versus the policy of recognizing the limited "right" of a person to use his or her own personal name as a trade symbol. Professor McCarthy goes on to state that the conflict is most often resolved by a compromise or qualified injunction, also noting that the concept that there should be some qualified right to use one's own name as a mark has resulted in a great reluctance of judges to issue an absolute injunction against any use of a personal name mark. He also observes that "the majority of cases result in an injunction

requiring some change in format, the addition of prefixes or suffixes, or disclaimers, while permitting the junior user to retain, in some form, the use of his own name." In the present case, the Board lacks the power to fashion such a remedy. However, it is possible (especially given the parties' business relationship and many years of overlapping use), that this sort of resolution would be viable here in the appropriate forum.

Decision: The petitions for cancellation are denied. The opposition is dismissed.