

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451**

Lykos

Mailed: March 22, 2006
Cancellation No. 92042937
Sysco Corporation
v.
Princess Paper, Inc.

Before Hohein, Hairston and Zervas, Administrative Trademark Judges.

By the Board:

On January 20, 2004, Sysco Corporation ("petitioner") filed a petition to cancel the registration of Princess Paper ("respondent") for the mark IMPERIAL for "paper products, namely, napkins, facial tissue, bathroom tissue, paper towels" in International Class 16.¹ As grounds for cancellation, petitioner alleges priority of use of the mark IMPERIAL "on a variety of goods . . . particularly, paper products, namely, napkins, facial tissue, bathroom tissue, and paper towels," and that use of the parties' respective marks in connection with their goods is likely to cause confusion.

¹ Registration No. 2449142, issued on May 8, 2001, which sets forth August 2, 1999 as the date of first use anywhere and in commerce.

Cancellation No. Error! Reference source not found.

In its answer to the petition for cancellation, respondent denied the salient allegations thereof and asserted various affirmative defenses, including that "[p]etitioner's use of the word IMPERIAL is not entitled to trademark status because it is laudatory and therefore merely descriptive."

This case now comes up for consideration of (1) respondent's motion for summary judgment, filed December 3, 2004; (2) petitioner's motion for extension of time to answer respondent's second set of interrogatories, filed December 14, 2004; (3) respondent's motion for sanctions in response to petitioner's motion for extension of time to answer respondent's second set of interrogatories, filed January 3, 2005; (4) petitioner's motion for extension of time to respond to respondent's motion for summary judgment, filed December 21, 2004; (5) respondent's motion for sanctions in response to petitioner's motion for extension of time to respond to respondent's motion for summary judgment, filed January 3, 2005; (6) petitioner's cross-motion for summary judgment, filed February 10, 2005; and (7) respondent's combined motion to strike petitioner's responsive brief to respondent's motion for summary judgment as well as the affidavits of Chris Shepardson and Mariusz Martula, and motion for sanctions in the form of judgment, filed February 23, 2005. The motions are contested, and

Cancellation No. Error! Reference source not found.

where applicable, the Board has exercised its discretion to consider any reply briefs filed in support of a particular motion. See Trademark Rule 2.127(a).

I. Petitioner's Motion for Extension of Time to Respond to Respondent's Motion for Summary Judgment; Respondent's Motion to Strike Petitioner's Responsive Brief as Untimely; and Respondent's Motion for Sanctions

First we will consider (1) petitioner's motion for extension of time to respond to respondent's motion for summary judgment, (2) respondent's motion to strike petitioner's responsive brief as untimely, and (3) respondent's motion for sanctions. Petitioner requested a 30-day extension of time until February 5, 2005, to respond to respondent's motion for summary judgment, citing the following reason:

Petitioner will be unable to prepare a full and complete [r]esponse and [b]rief by that date, because several persons needed to assist with preparing and signing accurate [a]ffidavits will be unavailable during the Christmas holidays.

In opposition thereto, respondent contends that motions to extend are not routinely granted; that petitioner's motion merely states in a cursory fashion that the necessary persons are unavailable due to the Christmas holiday; that nothing in petitioner's motion sets forth the names of the intended affiants, their positions, and holiday vacation schedules; that petitioner has failed to explain the nature of the testimony that it intends to submit from these individuals; and that as such, petitioner has failed to

Cancellation No. Error! Reference source not found.

demonstrate the requisite good cause to warrant an extension of time. Alternatively, respondent has requested that the Board deny petitioner's motion for extension of time as a sanction under Trademark Rule 2.120(g)(1) for petitioner's failure to produce additional witnesses in response to respondent's previously noticed deposition pursuant to Fed. R. Civ. P. 30(b)(6).

As correctly noted by respondent, the appropriate standard for allowing an extension of a prescribed period prior to the expiration of the time period is "good cause." See Fed. R. Civ. P. 6(b) and TBMP § 509 (2nd ed. rev. 2004) and authorities cited therein. To the extent, if any, that respondent intends to suggest that extensions of time are rarely granted, respondent's interpretation of the case law is misplaced. To the contrary, the Board generally is liberal in granting extensions of time before the period to act has elapsed so long as the moving party has not been guilty of negligence or bad faith and the privilege of extensions is not abused. See, e.g., *American Vitamin Products Inc., v. DowBrands Inc.*, 22 USPQ2d 1313 (TTAB 1992); and *Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 147 (TTAB 1985).

We find that in this particular instance, petitioner has demonstrated the requisite good cause to warrant an extension of time to file a responsive brief to respondent's

Cancellation No. Error! Reference source not found.

motion for summary judgment. The absence of key individuals necessary for the preparation of a responsive brief constitutes good cause for requesting an extension of time. We further note that this is petitioner's first and only request for extension of time to file a responsive brief, that the request is for a relatively short extension of only 30 days, that the request was made well prior to the deadline as originally set, and that petitioner did indeed file a brief within the requested time frame, all of which evidence petitioner's good faith and diligence.

Respondent has also moved for sanctions under Trademark Rule 2.120(g)(1) on the ground that petitioner now seeks additional time to submit the affidavits of witnesses it failed to produce in response to respondent's duly noticed Fed. R. Civ. P. 30(b)(6) deposition served August 9, 2004. As a sanction, respondent requests that the Board deny petitioner's motion to extend its time to reply to respondent's motion for summary judgment.

The Board declines to impose a sanction under Trademark Rule 2.120(g)(1) on petitioner for its purported failure to produce additional witnesses in response to respondent's previously noticed Rule 30(b)(6) deposition. By way of background, petitioner initially refused to produce any Rule 30(b)(6) witnesses and moved for a protective order, contending that the notice failed to describe "with

Cancellation No. Error! Reference source not found.

reasonable particularity" the matters to be covered during the deposition, and that because petitioner is "a large corporation with a complex organizational structure," it would be unduly burdensome for petitioner "to make an intelligent designation of one or more agents to testify in its behalf." On August 19, 2004, the Board denied petitioner's motion for protective order, finding that it was improper for petitioner to object to the production of witnesses on these grounds. Following the issuance of the Board's order, petitioner did produce one corporate representative² as a witness in response to respondent's Rule 30(b)(6) deposition. Trademark Rule 2.120(g) does not apply here because the prior Board order did not specify the number of Rule 30(b)(6) witnesses to be produced. Thus, the production of only one witness in response to the Rule 30(b)(6) deposition did not in any way violate the Board's August 19, 2004 order.³

² The witness produced was Mr. Chris Shepardson, Senior Director of Merchandising for petitioner.

³ Alternatively, if petitioner is allowed to produce the affidavits of previously undesignated witnesses, respondent requests that petitioner be required to produce those witnesses for depositions in Oakland, California, at petitioner's expense. As will be evident later in this order, while petitioner has submitted the affidavit of one previously undesignated witness, Mariusz Martula, Senior Merchandiser - Disposables for petitioner, the production of this witness for a deposition is unnecessary since his testimony is not pivotal to the Board's ruling regarding the parties' respective motions for summary judgment.

Cancellation No. Error! Reference source not found.

In view of the foregoing, petitioner's motion for an extension of time to respond to respondent's motion for summary judgment is granted. The brief in opposition to respondent's motion for summary judgment that petitioner filed by certificate of mailing on February 7, 2005 is therefore timely filed. Respondent's motion to strike petitioner's responsive brief as untimely and motion for sanctions are denied.⁴

II. Respondent's Motion For Summary Judgment; Petitioner's Cross-Motion For Summary Judgment; Respondent's Motion to strike the affidavits of Chris Shepardson and Mariusz Martula

The Board now turns to a review of the parties' respective arguments as to summary judgment.

Respondent has moved for summary judgment on the grounds of priority and likelihood of confusion. More specifically, on the issue of priority, respondent maintains that it first used its IMPERIAL mark in interstate commerce

⁴ Subsequent to petitioner's filing of both its response to respondent's motion for summary judgment and cross-motion for summary judgment, respondent reiterated its contention that petitioner's responsive brief should be stricken from the record on the new basis that no affidavits were filed in support of petitioner's brief. Respondent also requested dismissal of the case as a sanction for petitioner's alleged subterfuge. The renewed motion for sanctions is denied. The Board notes that while the affidavits were submitted with petitioner's two page cross-motion for summary judgment, petitioner filed a combined brief responding to respondent's motion for summary judgment and outlining its arguments in support of its cross-motion for summary judgment. We find that this demonstrates that petitioner was not disingenuous in requesting an extension of time. Respondent's *ex post facto* analysis of this issue essentially amounts to elevating form over substance.

Cancellation No. Error! Reference source not found.

"in February or March 1999"; that since that time, it has continuously used its mark in interstate commerce on paper goods, including paper towels, napkins and bathroom tissue; that petitioner has produced only three pieces of advertising that show use of its IMPERIAL designation on paper goods prior to respondent's date of first use; and that petitioner uses the term IMPERIAL in a descriptive, self-laudatory manner and has not shown acquired distinctiveness prior to respondent's date of first use. On the issue of likelihood of confusion, respondent contends that the marks at issue are dissimilar because petitioner's use of the term IMPERIAL is always accompanied by petitioner's house mark SYSCO; that although the parties target the same customers, they have mutually exclusive trade channels (respondent markets through its wholesalers, distributors and manufacturer's representatives while petitioner markets through its own trade channels); that there is no evidence of actual confusion; that numerous competing goods use the term IMPERIAL, thereby diluting petitioner's rights in the mark; and that the purchasers are sophisticated.

As evidence in support of its motion for summary judgment, respondent has submitted the declaration (with exhibits) of its counsel, I. Braun Degenshein, with various exhibits attached thereto, including a copy of respondent's

Cancellation No. Error! Reference source not found.

involved registration obtained from the Office's TESS web site; excerpts from the discovery deposition transcript of Mr. Chris Shepardson, Senior Director of Merchandising for petitioner; excerpts from the discovery deposition transcript of Mr. Abraham Hakimi, a corporate representative for respondent; various authenticated print-outs from the Internet from petitioner's web site; respondent's first set of interrogatories and petitioner's initial responses and first and second amended responses thereto; respondent's second set of interrogatories and petitioner's responses thereto; and various documentary evidence produced by petitioner displaying use of its mark.

Petitioner, in response to respondent's motion for summary judgment, and in support of its cross-motion for summary judgment on its claim of priority of use and likelihood of confusion, argues that contrary to respondent's assertions, petitioner has presented undisputed documentary evidence of prior use; that petitioner's IMPERIAL mark is not descriptive, and even assuming that it is descriptive, it has acquired secondary meaning; that while petitioner does in many instances use its IMPERIAL mark in connection with its house mark SYSCO, it also uses the mark alone; that the parties' goods are identical; that where the marks and goods at issue are identical, likelihood of confusion is "inevitable;" that because respondent's

Cancellation No. Error! Reference source not found.

registration is not restricted to any particular trade channel, it is presumed that the goods travel in all normal and usual trade channels therefor; that petitioner's mark IMPERIAL is strong and distinctive for use in connection with paper products; that there are few similar third-party marks in use on similar goods; that the period of contemporaneous use has been relatively short; and that the products in question are sold to customers of varying sophistication.

In support of its position, petitioner has submitted the affidavit of Mr. Chris Shepardson, Senior Director of Merchandising for petitioner, with various exhibits attached thereto; the affidavit of Mr. Mariusz Martula, Senior Merchandiser - Disposables for petitioner, with various exhibits attached thereto; and "notice of reliance" third party registrations.⁵

In response to petitioner's cross-motion for summary judgment, and in reply in support of its own motion for summary judgment, respondent argues that petitioner has not made prior use of its IMPERIAL mark in a prominent manner; that the fact that the involved registration is not restricted to any particular trade channels is irrelevant

⁵ Petitioner also submitted the pleadings in this proceeding as exhibits. Petitioner is reminded that these papers, by their very nature, already form part of the record in this proceeding. Accordingly, petitioner is requested to refrain from attaching portions thereof to future filings.

Cancellation No. Error! Reference source not found.

because respondent does not have access to petitioner's own trade channels; that petitioner's mark is weak; and that the parties have coexisted for several years without instances of confusion.

Before further discussing the merits of the parties' respective summary judgment motions, we will consider respondent's motion to strike the affidavits of Mr. Chris Shepardson and Mr. Mariusz Martula. Respondent has moved to strike the affidavits on the grounds that they constitute "shams" insofar as they now suggest that the term IMPERIAL has been used to identify a "brand;" that the affiants failed to provide sufficient factual support to establish that the affiants have personal knowledge of the facts stated; and that the affidavits lack foundation.

In response, petitioner argues that the affidavits are entirely proper, but in the event that the Board finds that they are unacceptable, petitioner has submitted substitute affidavits which contain additional background facts to explain the basis for personal knowledge of each affiant, as well as explaining the method by which petitioner calculated its annual sales of paper products under the IMPERIAL mark.

Respondent's motion to strike is denied. The original affidavits are not "shams" since the information contained therein is consistent with the information provided during the taking of the discovery deposition of Mr. Shepardson as

Cancellation No. Error! Reference source not found.

well as petitioner's other documentary evidence. In addition, the Board finds that contrary to respondent's assertions, the affiants did provide sufficient factual support to establish that they have personal knowledge of the facts stated therein, and that the affidavits contain the requisite foundation.

Notwithstanding the above, while the original affidavits are acceptable, the Board will consider the amended affidavits. Under Fed. R. Civ. P. 56(e), the Board may permit a party to supplement its summary judgment affidavits or to submit additional affidavits. See *Shalom Children's Wear, Inc. v. In-Wear A/S*, 26 USPQ2d 1516 (TTAB 1993). We exercise our discretion under the rule in favor of considering and accepting the amended affidavits filed with petitioner's reply brief as well as the exhibits introduced therewith.

We now discuss whether summary judgment is warranted in this case. Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317,

Cancellation No. Error! Reference source not found.

106 S.Ct. 2548 (1986). If the nonmoving party fails to make a sufficient showing on an essential element of its case with respect to which it would have the burden of proof at trial, judgment as a matter of law may be entered in favor of the moving party. See Fed. R. Civ. P. 56(c); *Celotex Corp., supra*, at 322-23. The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. See *Opryland USA, Inc., v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). When the moving party's motion is supported by evidence sufficient to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely-disputed facts that must be resolved at trial. The nonmoving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine issue of material fact for trial.

Based on the submissions of the parties, we find that petitioner has met its burden of demonstrating that there

Cancellation No. Error! Reference source not found.

are no genuine issues of material fact, and that petitioner is entitled to judgment as a matter of law.

A party moving for summary judgment in its favor on a Section 2(d) claim must establish that there is no genuine dispute that (1) it has standing to maintain the proceeding; (2) that it is the prior user of its pleaded mark; and (3) that contemporaneous use of the parties' respective marks on their respective goods would be likely to cause confusion, mistake or to deceive consumers. *See Hornblower & Weeks, Inc., v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733 (TTAB 2001).

A. Standing

With regard to whether petitioner has standing to maintain this proceeding, we note that respondent has not challenged petitioner's standing to cancel the involved registration. As discussed in more detail below, we find that the evidence of petitioner's prior use of the IMPERIAL mark is sufficient to establish petitioner's standing to bring this case. As such, no genuine issue of material fact exists on the issue of standing.

Cancellation No. Error! Reference source not found.

B. Priority

We turn next to the issue of whether there is a genuine issue of material fact regarding petitioner's asserted priority of use. To establish priority on a likelihood of confusion claim brought under Trademark Act Section 2(d), a party must prove that, vis-a-vis the other party, it owns "a mark or trade name previously used in the United States ... and not abandoned...." Trademark Act Section 2, 15 U.S.C. Section 1052. A plaintiff may establish its own prior proprietary rights in a mark through actual use or through use analogous to trademark use, such as use in advertising brochures, trade publications, catalogues, newspaper advertisements and Internet websites which creates a public awareness of the designation as a trademark identifying the party as a source. See Trademark Act Sections 2(d) and 45, 15 U.S.C. Section 1052(d) and 1127; *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996), vacating *Pactel Teletrac v. T.A.B. Systems*, 32 USPQ2d 1668 (TTAB 1994).

The crux of the parties' dispute on this issue lies in their disagreement regarding the probative value of petitioner's evidence of prior use. The most relevant documentary evidence consists of the following items produced by petitioner during discovery and submitted by

Cancellation No. Error! Reference source not found.

respondent as Exhibit U to its counsel's declaration in support of its motion for summary judgment:

(1) A two-page advertisement which appeared in petitioner's publication entitled "Sysco's Menus Today" featuring a roll of toilet paper with the mark IMPERIAL appearing on the packaging dated Fall 1995;

(2) A three-page product brochure displaying a photograph of a box of facial tissue bearing the IMPERIAL mark with a 1996 copyright date; and

(3) an eight-page publication entitled "SYSCO CORPORATION Cleaning chronicle" showing the mark IMPERIAL on a box of tissue dated Winter 1998.

At the outset, the Board rejects respondent's contention that petitioner's evidence of prior use falls short because petitioner uses the term "imperial" in a descriptive, self-laudatory manner and has not shown that its use of the term has acquired secondary meaning prior to respondent's first use. Respondent points to the following language from petitioner's advertising material:

With SYSCO, Quality is a matter of choice. Our premium Toilet Tissue is available in three quality levels, while our soft, delicate Facial Tissue is available in two . . .

Luxuriously soft, SYSCO Imperial Tissue is truly the industry standard for premium, unsurpassed quality. Quite simply, it's the best; and

Attractive designs in three quality levels, choose from Imperial, luxuriously soft . . .

Cancellation No. Error! Reference source not found.

While petitioner does use laudatory language to tout the superior qualities of its products, this language in no way undermines the trademark usage of the term IMPERIAL as an inherently distinctive mark. Thus, petitioner is not required to establish that the term has acquired distinctiveness.

Indeed, we find that contrary to respondent's assertions, the evidence of prior use relied on by petitioner is sufficiently probative. In particular, with respect to the first submission of documentary evidence, made through the discovery deposition and affidavit of Chris Shepardson, petitioner has corroborated and established that it made its first actual use of the IMPERIAL mark in 1995 by selling its paper products under that mark and has continuously used the mark since then. Mr. Shepardson authenticated the 1995 publication and stated under oath that the publication was distributed to all of petitioner's customers at that time -- approximately 255,000. Mr. Shepardson also averred that in 1990 he "became personally aware" that petitioner was selling paper products, including napkins, facial tissue, bathroom tissue and paper towels, under the mark IMPERIAL, and that through June 30, 2004, petitioner's total sales of paper products under the brand name IMPERIAL totaled \$55 million. The remaining two pieces of documentary evidence have probative weight as well. Each

Cancellation No. Error! Reference source not found.

displays the mark IMPERIAL in a manner demonstrating actual or technical trademark usage (i.e. on packaging for the product).

We now turn to respondent's evidence of use. The earliest date respondent can rely on is February or March 1999, as established by the deposition testimony given by Mr. Hakimi.

We therefore find that petitioner has established that there is no genuine issue of fact that it is the prior user of its pleaded IMPERIAL mark.

C. Likelihood of Confusion

Turning to the issue of likelihood of confusion, we are guided by the factors set forth in the case of *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Our determination of likelihood of confusion is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion.⁶

(i). *Similarity of the Parties' Marks*

It is clear that there is no genuine issue of material fact that the marks at issue are identical and consist of the following single word mark -- IMPERIAL. Respondent's

⁶ Our primary reviewing Court has held that only those *du Pont* factors shown to be material or relevant in the particular case and which have evidence submitted thereon are to be considered. See *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

Cancellation No. Error! Reference source not found.

contention that petitioner does not use its IMPERIAL mark alone, but rather uses its mark in connection with its house mark SYSCO, is belied by the record evidence. The three examples of trademark use discussed previously in the section on the issue of priority of use clearly display the IMPERIAL mark as a single word mark. This factor therefore weighs heavily in favor of petitioner.

(ii). *Similarity of the Parties' Goods*

With regard to the similarity of the goods at issue, it is well settled that the question of likelihood of confusion must be determined based on an analysis of the goods recited in respondent's registration vis-à-vis the goods recited in petitioner's petition to cancel, rather than what respondent's goods are asserted or shown to actually be.

See, e.g., Octocom Systems Inc. v. Houston Computer Services, Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

As such, the goods identified in respondent's involved registration, i.e., "paper products, namely, napkins, facial tissue, bathroom tissue, paper towels" are identical to petitioner's goods which, as shown by the evidence, are paper towels, napkins, and bathroom tissue. Indeed, we note that respondent does not dispute that the parties' respective goods are identical.

Cancellation No. Error! Reference source not found.

(iii). *Channels of Trade*

Because the goods in question are identical, respondent relies heavily on the factor regarding the channels of trade, contending that the parties market their goods in distinct trade channels. In this case, however, the involved registration is unrestricted. The Board therefore must presume that respondent's goods are marketed or will be marketed in all the normal channels of trade for the identified goods and to all the usual classes of purchasers of such goods. See *Kangol Ltd. v. KangaROOS U.S.A.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992); see also *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Tiffany & Co. v. Classic Motor Carriages Inc.*, 10 USPQ2d 1835 (TTAB 1989). Respondent's assertion that the parties market their products in mutually exclusive trade channels is therefore unavailing since there is no such restriction in respondent's identification of goods.

(iv). *Buyer Conditions*

Respondent relies on the deposition of Mr. Shepardson to support its assertion that petitioner's purchasers are not ordinary consumers, but rather sophisticated

Cancellation No. Error! Reference source not found.

professional buyers.⁷ Assuming such is the case, even sophisticated persons would be susceptible to source confusion, particularly under circumstances where, as here, the goods are identical and are sold under the same marks. *See Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289 (CCPA 1962). In addition, insofar as there are no limitations in the identification of goods regarding the purchasers, we must assume that it encompasses all purchasers, including those buying on the retail level who are not sophisticated.

(v). *Variety of Goods on Which a Mark is Used*

Respondent's contends that petitioner's use of the IMPERIAL mark on a wide variety of goods dilutes petitioner's rights in the mark because there are numerous competing goods that use the IMPERIAL trademark yet coexist in the marketplace. Respondent's argument is misplaced. The fact that petitioner uses the mark on a wide variety of goods actually increases the likelihood of confusion.

(vi). *Contemporaneous Use and Lack of Actual Confusion*

With regard to respondent's arguments as to the parties contemporaneous use and lack of actual confusion, we find

⁷ Virtually all of petitioner's consumers are institutional buyers - "commercial, nonretail purchasers who purchase in bulk, such as hotels, restaurants, and other food service providers, but not purchasers for the purpose of resale such as supermarkets . . ." Exhibit T (Petitioner's Responses to Registrant's Second Set of Interrogatories, Response to Interrogatory No. 6) to Degenshein Declaration.

Cancellation No. Error! Reference source not found.

that the absence of actual confusion under these circumstances is not sufficient to raise a genuine issue because petitioner is not required to prove actual confusion in order to make a prima facie showing of likelihood of confusion. *See McDonald's Corp. v. McClain*, 37 USPQ2d 1274 (TTAB 1995).

Based on the foregoing, we find that there is no genuine issue of material fact for trial. Moreover, as a matter of law, our finding that confusion is likely is consistent with the case law holding that in circumstances where the marks are identical and used on identical goods, confusion is not only likely but inevitable. *See Reflange Inc. v. R-Con Int'l*, 17 USPQ2d 1125 (TTAB 1990). We therefore find that there is no genuine issue of material fact and that confusion is likely to result as a matter of law.

In view of the foregoing, petitioner's cross-motion for summary judgment is granted, and respondent's motion for summary judgment is denied. Judgment is hereby entered against respondent, the petition to cancel is granted, and Registration No. 2449142 will be cancelled in due course.

In light of our ruling on the parties' respective motions for summary judgment, the remaining motions pending before the Board in this case are moot.

Cancellation No. Error! Reference source not found.