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Paper No.

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Packaging Service Company, Inc.

v.

Picnic Brand, Inc.

Cancellation No. 29,508

Tim Cook of Bracewell & Patterson, L.L.P. for Packaging Service Company, Inc.

Steven J. Wadyka, Jr. of Greenberg Traurig, LLP for Picnic Brand, Inc.

Before Simms, Hohein and Bucher, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Packaging Service Company, Inc. has petitioned to cancel the registration owned by Picnic Brand, Inc. for the



mark "HAGMANN'S PICNIC BRAND" and design, as reproduced below, for "firewood; lump charcoal; [and] lighter fluid" in International Class 4.¹ As its ground for cancellation, petitioner alleges among other things that respondent's mark, when used in connection with respondent's goods, so resembles the mark "PICNIC, which petitioner has previously used and registered for "charcoal lighter fluid,"² as to be likely to cause confusion, mistake or deception.

Respondent, in its answer, has denied the salient allegations of the petition to cancel, including the assertion by petitioner that the marks at issue "so resemble each other as to be likely, when used in connection with the respective goods of the parties, to cause confusion" In its counterclaim for cancellation of petitioner's pleaded registration,³ respondent alleges, however, that it "first

¹ Reg. No. 1,952,390, issued on January 30, 1996 from an application filed on June 13, 1994, which disclaims the word "BRAND" and sets forth a date of first use anywhere and in commerce of August 1991. Although such registration also covers a "chemical preparation used to melt ice; [and] bagged rock salt" in International Class 1, the petition to cancel is directed only against the goods in International Class 4 of the registration.

² Reg. No. 977,599, issued on January 29, 1974 from an application filed on March 19, 1973, which sets forth a date of first use anywhere and in commerce of April 27, 1967; renewed.

³ For the reasons explained elsewhere in this opinion, the Board is without jurisdiction to entertain such a counterclaim and the allowance thereof was an error which will be rectified.

began commercial use of [its registered mark] HAGMANN'S PICNIC BRAND ... in the 1940s" and has continuously used such mark; that respondent thus has priority of use of its mark inasmuch as petitioner's registration alleges a date of first use for petitioner's "PICNIC" mark of April 4, 1967; and that, "[i]n view of the listing of ... 'charcoal lighter fluid' in both registrations, confusion is likely in the marketplace as to 'charcoal lighter fluid.'"

Petitioner, in its answer to the counterclaim, has admitted, among other things, that confusion is likely, but has denied respondent's allegation of priority of use of the mark "HAGMANN'S PICNIC BRAND."

Neither petitioner nor respondent took any testimony or otherwise introduced any evidence. Only petitioner filed a brief and neither party requested an oral hearing.

Turning first to the counterclaim, we note that while petitioner is correct in its observation that respondent cannot prevail therein since the allegation that respondent has priority of use of the mark "HAGMANN'S PICNIC BRAND" is "not supported by any evidence" (brief at 7), it is also the case that, more fundamentally, the counterclaim must be dismissed as a nullity because the Board is without jurisdiction to cancel a registration which is over five years

old on the ground of priority of use and likelihood of confusion. Specifically, at the time this proceeding was commenced on October 18, 1999, petitioner's pleaded registration for its "PICNIC" mark was already more than five years old. As such, it was no longer subject to cancellation on any ground which could exclusively be brought pursuant to Section 14(1) of the Trademark Act, which would include a claim of priority of use and likelihood of confusion.

Instead, because petitioner's registration is one which was over five years old, the grounds for cancellation thereof are restricted to one or more of those set forth in Section 14(3) of the Trademark Act. Inasmuch as a claim of priority of use and likelihood of confusion is not among such grounds, it was error for the Board to have allowed the counterclaim.

Accordingly, because the counterclaim is legally insufficient, it is hereby dismissed as a nullity (and the fee therefor will be refunded to respondent in due course). See, e.g., *Strang Corp. v. Stouffer Corp.*, 16 USPQ2d 1309, 1310-11 (TTAB 1990); and *Kemin Industries, Inc. v. Watkins Products, Inc.*, 192 USPQ 327, 328-29 (TTAB 1976).

With respect to the petition to cancel respondent's registration, it is obvious from petitioner's brief that the sole evidence relied upon by petitioner to sustain its burden of proof by a preponderance of the evidence is the fact that,

in light of the counterclaim, petitioner regards its pleaded registration to be automatically of record by virtue of Trademark Rule 2.122(b)(1).⁴ Such rule provides, in pertinent part, that: "The file ... of each registration against which a petition or counterclaim for cancellation is filed forms part of the record of the proceeding without any action by the parties and reference may be made to the file for any relevant and competent purpose."

Petitioner argues that proof that its pleaded registration is subsisting and owned by petitioner is sufficient to meet its burden of establishing both that it has

⁴ In particular, under the heading "DESCRIPTION OF THE RECORD," petitioner states that:

The record in this case consists of the pleading [sic] and documents automatically of record pursuant to the rules governing these proceedings, including petition to cancel, the answer and the respective registrations and the [underlying] applications therefore [sic] of the parties. Thus, the decision in this case may be based solely on the registrations of the parties and the proper application of law to the undisputed facts recited therein."

(Brief at 1.) Further, under the heading "RECITATION OF FACTS," petitioner notes among other things that its pleaded registration issued on January 29, 1974 from an application filed on March 19, 1973; that it filed its petition to cancel respondent's registration (which issued on January 30, 1996 from an application filed on June 13, 1994) on October 1, 1999 (although, as we pointed out earlier, such petition was actually received by the Board on October 18, 1999); that respondent filed an answer and counterclaim; that petitioner timely filed its answer to the counterclaim; and that "[t]he record consists of the noted pleadings and the respective registrations of the parties and the [underlying] applications therefore [sic], by operation of 37 C.F.R. [section] 2.122." (Brief at 4.)

priority of use of its "PICNIC" mark for charcoal lighter fluid and that contemporaneous use by petitioner of such mark in connection with its goods and use by respondent of the "HAGMANN'S PICNIC BRAND" and design mark for firewood, lump charcoal and lighter fluid is likely to cause confusion. In particular, petitioner maintains that it "is entitled to priority" because the "filing date for its registration predates that of Respondent," citing *Columbia Steel Tank Co. v. Union Tank & Supply Co.*, 277 F.2d 192, 125 USPQ 406, 407 (CCPA 1960).⁵ (Brief at 7.)

As to the question of likelihood of confusion, petitioner asserts that the pertinent factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973), for determining whether a likelihood of confusion exists, favor petitioner. Petitioner argues, in this regard, that "simple inspection shows that the word 'picnic'" in respondent's "HAGMANN'S PICNIC BRAND" and design

⁵ It is pointed out that the Board, in this regard, has held that in the absence of testimony or other evidence relating to the dates of first use of the respective marks of the parties, priority vis-à-vis such marks lies with the petitioner where the record reveals that the registration for the petitioner's pleaded mark shows not only that the registration is subsisting and owned by the petitioner, but that the filing date of the application which matured into such registration is earlier than the filing date of the application which resulted in the respondent's involved registration for its mark. See, e.g., *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1428-29 (TTAB 1993) at n. 13; and *American Standard Inc. v. AQM Corp.*, 208 USPQ 840, 841-42 (TTAB 1980).

mark "is by far the dominant feature" thereof, given that such word appears "in letters which are much larger than the words 'Hagmann's Brand,'" and that respondent's mark is therefore substantially "identical" to petitioner's "PICNIC" mark.

(Brief at 5.) With respect to the parties' goods, petitioner maintains that the respective registrations "both list lighter fluid ... and it is also well known that firewood and charcoal are also typically displayed together for sale, and [thus] are closely related goods to lighter fluid in the minds of consumers." (Brief at 6.) Moreover, petitioner contends, "it must be assumed that the identical goods of the ... parties travel in the same channels of trade." (Brief at 6.) In view thereof, and because "the board may take judicial notice that lighter fluid is an inexpensive item [s]old typically next to charcoal in grocery stores and similar retail stores and that consumers of such products do not exhibit careful and sophisticated study of the products prior to such purchases," petitioner concludes that the record demonstrates that there is a likelihood of confusion. (Brief at 6.)

While Trademark Rule 2.122(b)(1) serves, in the case of a proper counterclaim, to make the subject registration automatically of record, in this instance respondent's counterclaim, as noted above, is legally insufficient and

hence has been dismissed as a nullity. As a consequence thereof, petitioner's pleaded registration is not automatically of record. Nevertheless, it is obvious that petitioner elected not to take appropriate action to make its pleaded registration properly of record, such as by filing a notice of reliance on a copy thereof showing that the registration is subsisting and owned by petitioner,⁶ in view of the Board's allowance of respondent's counterclaim and in reliance on Trademark Rule 2.122(b)(1).

Accordingly, and since in the absence of the counterclaim petitioner cannot prevail in this proceeding unless it introduces sufficient evidence in its behalf to establish its claim of priority of use and likelihood of confusion,⁷ a final decision on such claim is deferred and testimony periods, commencing with petitioner's initial testimony period, are reset as indicated below for the limited purpose of allowing petitioner to make its pleaded

⁶ For a discussion of the ways in which a plaintiff in an *inter partes* proceeding may properly make a pleaded registration of record, see TBMP Section 703.02(a).

⁷ Whether reliance by a plaintiff on its pleaded registration alone is sufficient evidence to meet its burden of proof by a preponderance of the evidence is, of course, dependent upon the circumstances of each case. See, e.g., *Merritt Foods v. Associated Citrus Packers, Inc.*, 222 USPQ 255, 256 (TTAB 1984); *Pharmacia Inc. v. Asahi Medical Co., Ltd.*, 222 USPQ 84, 86 (TTAB 1984); *Herman Miller, Inc. v. Lane Co., Inc.*, 221 USPQ 922, 924 (TTAB 1984); and *Hyde Park Footwear Co., Inc. v. Hampshire-Designers, Inc.*, 197 USPQ 639, 641-42 (TTAB 1977).

registration properly of record,⁸ failing which the petition for cancellation will be dismissed with prejudice.

IN EACH INSTANCE, a copy of the transcript of any testimony, together with copies of documentary exhibits, must be served on the adverse party **WITHIN THIRTY DAYS** after completion of the taking of testimony. Trademark Rule 2.125(a).

Testimony period for petitioner, for the limited purpose of making its pleaded registration properly of record, to close: (opening thirty days prior thereto)	March 27, 2002
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Testimony period for respondent to close: (opening thirty days prior thereto)	May 28, 2002
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Rebuttal testimony period for petitioner to close: (opening fifteen days prior thereto)	July 12, 2002
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In the event that evidence is introduced by respondent in response to petitioner's evidence, supplemental

⁸ To be clear, it is pointed out that if, instead of making its pleaded registration properly of record by filing, during its rescheduled initial testimony period, a notice of reliance thereon which is accompanied by a certified copy showing both the current status of and current title to the registration, petitioner elects to make such registration of record by introducing a copy thereof as an exhibit to testimony by a witness having knowledge of the current status of and title to the registration, the testimony is to be limited to establishing that the registration is subsisting and is owned by petitioner. See Trademark Rule 2.122(d)(2). Likewise, any evidence which may be offered by respondent during its reset testimony period must be restricted to rebutting petitioner's evidence, just as any further evidence offered by petitioner during

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briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b).

Decision: The counterclaim is dismissed as a nullity (with the fee therefor to be refunded in due course) and further consideration of the petition to cancel is deferred.

its rescheduled rebuttal testimony period is to be limited to rebutting respondent's evidence.