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SEPT 27,99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Kal Kan Foods, Inc.
v.
Hacht Sales and Marketing, Ltd.

Opposition No. 97,609 to application Serial No. 74/465,632
filed on December 6, 1993

John A. Krause and Timothy J. Kelly of Fitzpatrick, Celia, Harper & Scinto for Kal Kan Foods, Inc.

Mark A. Cantor & John S. Artz of Brooks & Kushman P.C. for Hacht Sales and Marketing, Ltd.

Before Quinn, Hohein and Bucher, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Hacht Sales and Marketing, Ltd. has filed an application to register the mark "PEDIGREE PARK" for "pet supplies; namely, rawhide chews, animal leashes and collars".[1]

Kal Kan Foods, Inc. has opposed registration on the ground that it "is and has been for many years a well known manufacturer and seller of pet food and related pet products";

[1] Ser. No. 74/465,632, filed on December 6, 1993, which alleges dates of first use of July, 1984.

that it "is the owner of numerous ... registrations for the trademark PEDIGREE and variations thereof," including:

(1) the mark "PEDIGREE," as reproduced below,

for "canned dog food";[2]

(2) the mark "PEDIGREE" for "pet food";[3]

(3) the mark "PEDIGREE MEALTIME" for "dog food";[4]

(4) the mark "PEDIGREE" and design, as illustrated below,

for "wall calendars sold by mail order featuring large color photographs of various breeds of dogs";[5] and

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[2] Reg. No. 284,342, issued on June 23, 1931 and amended on May 28, 1996, which sets forth dates of first use of November 20, 1930; third renewal.

[3] Reg. No. 1,386,983, issued on March 18, 1986, which sets forth dates of first use of February 28, 1985; combined affidavit §§8 and 15.

[4] Reg. No. 1,521,182, issued on January 17, 1989, which sets forth dates of first use of March 7, 1988; combined affidavit §§8 and 15.

[5] Reg. No. 1,574,846, issued on January 2, 1990, which sets forth dates of first use of October 13, 1990; affidavit §8.

(5) the mark "PEDIGREE AWARD" and design, as depicted below,

for "educational services; namely, encouraging excellence among dog breeders by compiling records of the winners of the best of breed/variety honors at sanctioned dog shows, and honoring those winners each year with a special award;[6]

that opposer, "since a date long prior to the date on which Applicant began using the mark which is the subject of the instant application, and continuously to the present date, has extensively used, promoted and advertised in interstate commerce its PEDIGREE trademark"; that opposer's "extensive use, promotion and advertising has included use of the PEDIGREE trademark and variations thereof on various goods related to dogs and dog food, as well as on other goods related to pets and pet care"; that "[a]s a result of this extensive use, sales, advertising and promotion by opposer, the PEDIGREE trademark and the PEDIGREE

[6] Reg. No. 1,718,960, issued on September 22, 1992, which sets forth dates of first use of April, 1989; combined affidavit §§8 and 15. The word "AWARD" is disclaimed.

family of trademarks, have become exclusively associated with Opposer"; that "the goods in connection with which Applicant uses its mark are closely related to, travel in the same channels of trade as, and are marketed to the same classes of consumers as those on which Opposer has been and presently is using its PEDIGREE trademarks"; and that, accordingly, applicant's "substantially similar" mark, when used in connection with applicant's goods, "is likely to cause consumers to be confused, mistaken or deceived as to the source, origin or sponsorship of Applicant's goods, and to believe that Applicant's goods emanate from Opposer, or that Applicant is in some way related to Opposer."

Applicant, in its answer, has denied the salient allegations of the notice of opposition. In addition, as affirmative defenses, applicant alleges that it "is the owner of canceled U.S. Registration No. 1,450,801 for the mark 'PEDIGREE PARK' for pet supplies; namely, rawhides, animal leashes and collars"; that the parties "have used their respective marks concurrently for at least eleven (11) years with no confusion"; that opposer "had actual and/or constructive knowledge of Applicant's canceled U.S. registration and its continuous use of its 'PEDIGREE PARK' mark and has inexcusably delayed in taking action with respect thereto"; that "[a]s a result of Opposer's failure to act, Opposer has acquiesced in Applicant's continuous use of the mark 'PEDIGREE PARK' for the goods identified, and is further guilty of laches"; and that opposer "is estopped from asserting its rights against Applicant at this time" because,

"based upon Opposer's inaction, Applicant relied to its detriment and continuously used and marketed its products sold under the mark 'PEDIGREE PARK.'"

The record includes the pleadings; the file of the involved application; and, as part of opposer's case-in-chief, the testimony, with exhibits, of its external relations manager, Alice Nathanson. Opposer, as the rest of its case-in-chief, submitted a notice of reliance upon (i) certified copies of its previously mentioned registrations, as well as certified copies of registrations for the following:

(1) the mark "PEDIGREE" and design, as shown below,

for (a) "pet food"[7] and (b) "periodically published journal pertaining to health care of pets";[8]

(2) the mark "PEDIGREE" for "beds for household pets";[9] and

[7] Reg. No. 1,631,808, issued on January 15, 1991, which sets forth dates of first use of June, 1989; combined affidavit §§8 and 15.

[8] Reg. No. 1,679,350, issued on March 17, 1992, which sets forth dates of first use of March, 1989; combined affidavit §§8 and 15.

[9] Reg. No. 1,709,352, issued on August 18, 1992, which sets forth dates of first use of December 20, 1991. However, inasmuch as such

(3) the mark "PEDIGREE EXELPET" and design, as reproduced below,

for "toys for pets";[10]

which copies show, in each instance, that the registrations are subsisting and owned by opposer,[11] and (b) certified copies of various assignment documents "reflect[ing] the assignment of U.S. ... Registration No. 284,342 to Opposer." Applicant, as part of its case-in-chief, submitted the testimony, with exhibits, of its president and founder, James R. Hacht.[12] As the remainder of its case-in-chief, applicant filed a notice of reliance on a certified copy of its canceled Registration No. 1,450,801 for the mark "PEDIGREE PARK" for "pet supplies--namely, rawhides, animal leashes and collars" and a supplemental notice of reliance on (a) opposer's answers to applicant's first set of interrogatories and (b) a certified copy of "a transcript of a hearing dated July 25,

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registration has been canceled pursuant to Section 8 of the Trademark Act, it will not be given further consideration.

[10] Reg. No. 1,917,355, issued on September 5, 1995, which sets forth dates of first use of December 15, 1994.

[11] Inasmuch as applicant, in its brief, concurs that opposer may rely on registrations for marks which were not pleaded in the notice of opposition as filed, the pleadings are hereby deemed to be amended to conform to the evidence of record in accordance with Fed. R. Civ. P. 15(b). It is pointed out, however, that even if the pleadings were not deemed to be so amended, the result in this case would still be the same.

[12] While opposer, in its main brief, has reiterated only the objections which it raised at the deposition to applicant's exhibits 5 through 12, such objections are plainly without any merit and are accordingly overruled. Moreover, even if the exhibits objected to were to be

1996, between the parties in a related lawsuit, now dismissed, on Kal Kan's Motion to Dismiss."[13] Briefs have been filed and an oral hearing, attended by counsel for the parties, was held.

Opposer's priority of the marks which are the subjects of its extant pleaded registrations is not in issue inasmuch as the certified copies of such registrations show that the registrations, as noted previously, are subsisting and owned by opposer. See King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).[14] In addition, applicant has admitted in its brief that, "for purposes of this

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excluded, their absence from the record would not change the outcome of this case.

[13] Although applicant, in its supplemental notice of reliance, also sought to rely on its answers to opposer's first set of interrogatories, applicant subsequently withdrew its reliance thereon in response to opposer's motion to strike portions of the supplemental notice of reliance. The Board, in its April 14, 1997 ruling on the motion to strike, stated among other things that:

> Insofar as the transcript of the hearing is concerned, we agree that the transcript must be considered as falling within the category of an official record, as provided for under Trademark Rule 2.122(e), and not as testimony as would be governed by [Trademark] Rule 2.122(f). Applicant has failed, however, to comply with the requirements for submitting an official record under a notice of reliance in that the copy of the transcript which has been filed has not been authenticated in accordance with the Federal Rules of Evidence. Moreover, there is no statement in the notice of reliance as to the relevance of the transcript to the present proceeding.

Nevertheless, applicant was allowed time "to perfect its supplemental notice of reliance by submitting a certified copy of the transcript," along with "a statement of its relevance," which requirements were timely complied with by applicant. Thus, such transcript is of record and, according to applicant, it is relevant in that counsel for opposer "essentially admitted that there was no likelihood of confusion between the parties[']marks when he indicated that he had no objection to Hacht's use of the mark PEDIGREE PARK."

[14] Thus, contrary to the assertions in applicant's brief, this proceeding is not subject to dismissal for failure of opposer to establish priority of use of such marks.

proceeding only, [it] does not contest that the parties' goods travel through the same channels of trade, [and] are marketed to the same class of purchasers," although it does maintain that the parties' goods are otherwise unrelated. The only real issues to be determined, therefore, are whether (i) applicant's "PEDIGREE PARK" mark, when used in connection with pet supplies, namely, rawhide chews, animal leashes and collars, so resembles one or more of opposer's prior "PEDIGREE" and/or "PEDIGREE"-formative marks for its pet foods and other pet products that confusion is likely as to the source or sponsorship of the parties' goods;[15]

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[15] Although opposer, as noted previously, has pleaded a family of "PEDIGREE" marks and refers in its main and reply briefs to a family of registered marks, we observe, in this regard, that as stated in J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1891-92 (Fed. Cir. 1991):

> A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be a recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods. ....
>
> Recognition of the family is achieved when the pattern of usage of the common element is sufficient to be indicative of the origin of the family. It is thus necessary to consider the use, advertisement, and distinctiveness of the marks, including assessment of the contribution of the common feature to the recognition of the marks as of common origin.

While applicant, in its brief, has not challenged opposer's assertions of a family of registered "PEDIGREE" marks, it simply cannot be said on this record that opposer has demonstrated the existence of such a family. Nothing in the record evidences that opposer's marks have been promoted in a manner sufficient to create a recognition or awareness among the purchasing public of the common ownership thereof so that a family of marks, characterized by the term "PEDIGREE" as its distinguishing element, in fact exists. See, e.g., La Maur, Inc. v. Bagwells Enterprises, Inc., 199 USPQ 601, 606 (TTAB 1978) and Polaroid Corp. v. American Screen Process Equipment Co., 166 USPQ 151, 154 (TTAB 1970). Furthermore, the mere ownership of a

and (ii) if so, whether applicant has established its affirmative defense of laches.[16]

According to the record,[17] opposer is and has been a manufacturer and distributor of pet foods and other pet products. Since acquiring its "PEDIGREE" mark for canned dog food by assignment from Strongheart Products, Inc. on July 16, 1985, opposer has continuously used such mark "[s]ince about 1986" and has expanded the use thereof into a line of pet foods and pet products which it sells under its "PEDIGREE" and "PEDIGREE"-formative marks. (Nathanson dep. at 11.) Specifically, according to its witness, Ms. Nathanson, who as opposer's

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number of marks sharing a common feature, or even ownership of many registrations therefor, is alone insufficient to demonstrate that a family of marks exists. See, e.g., Hester Industries, Inc. v. Tyson Foods, Inc., 2 USPQ2d 1646, 1647 (TTAB 1987); Consolidated Foods Corp. v. Sherwood Medical Industries Inc., 177 USPQ 279, 282 (TTAB 1973); Polaroid Corp. v. American Screen Process Equipment Co., supra; and Polaroid Corp. v. Richard Mfg. Co., 341 F.2d 150, 144 USPQ 419, 421 (CCPA 1965). Accordingly, inasmuch as opposer has not established its assertions of a family of "PEDIGREE" marks, and since in any event it also is obvious that opposer's educational services are the least related of its goods and services to applicant's products, the issue of likelihood of confusion must be determined by comparing applicant's mark for its goods with each of the marks for which opposer has priority with respect to its various products.

[16] Although applicant, as indicated earlier, pleaded a variety of equitable defenses, it has not tried or argued in its brief any of such defenses other than the affirmative defense of laches. In view thereof, all of its equitable affirmative defenses are deemed to have been waived except for laches.

[17] While both the Nathanson and Hacht deposition transcripts have been designated as confidential in their entireties, the only matters which can be considered to be truly confidential are the dollar amounts of sales and advertising figures disclosed therein. Plainly, for instance, the parties' advertisements and packaging materials have been disseminated to the purchasing public and, like the other aspects of the parties' use of their respective marks, are not confidential matters. Accordingly, and notwithstanding the fact that opposer's main brief discloses the actual amounts of its sales and advertising as testified to by its witness, we have treated only the parties' sales and advertising figures as confidential business information and have set forth such information in this opinion in round numbers.

external relations manager is responsible for developing and managing its public relations, direct mail programs, media advertising campaigns and trademark portfolio, opposer principally sells dog food, dog snacks and dog toys. Opposer markets such products primarily to dog owners and dog breeders. Its various "PEDIGREE" pet foods "are sold nationally in grocery stores, mass merchandising stores like K-Mart, Wal-Mart, club stores, non[-]grocery stores like pet super stores, pet stores, farm and feed stores, hardware stores, [and] drugstores." (Id. at 13.) Opposer's pet products, such as its "PEDIGREE EXELPET" dog toys, are distributed "in non[-]grocery stores throughout the country." (Id. at 53.) Opposer uses its marks on labels and other packaging for its goods.

While opposer's exact sales figures and advertising and promotional expenditures are regarded as confidential, sales of its "PEDIGREE" brand products for each of the eight years prior to 1996 have averaged on the order of nearly half a billion dollars per year. Annual sales have increased steadily. Its advertising and promotional expenditures during the same eight-year period have been steadily climbing and have averaged around 100 million dollars each year. Most of opposer's advertising of its "PEDIGREE" and "PEDIGREE"-formative marks, such as "PEDIGREE MEALTIME," consists of national television commercials, print advertisements in magazines and some radio ads, while its promotional materials include freestanding newspaper inserts, direct mail and point-of-sale fliers, in-store displays, coupons

and local marketing activities such as newsletters and dog shows. Opposer also uses its various "PEDIGREE" marks on sales brochures which are presented to retailers of its products and, "for several years," its "PEDIGREE" and ribbon design mark has appeared in connection with its sponsorship of a stock racing car "in the areas surrounding racetracks where Winston Cup Series--NASCAR races are held." (Id. at 43.) In addition, opposer has run an infomercial for its "PEDIGREE" puppy food, to which 189,000 people responded in 1996 to obtain literature and a free sample of such food, and for the past eight years since 1996 has published its Pedigree Breeder Forum magazine, which it distributes quarterly to 30,000 dog breeders in its breeder services program.

Opposer first heard of applicant's "PEDIGREE PARK" mark when, sometime subsequent to the publication thereof in the Official Gazette on January 3, 1995, opposer's "attorneys brought to our attention [the fact] that an application for the mark had been filed."[18] (Id. at 68.) Opposer, until this proceeding, has never asserted its rights in its "PEDIGREE" marks against applicant because it claims not to have had actual knowledge of applicant's use of the "PEDIGREE PARK" mark. Moreover, according to Ms. Nathanson, she has never seen applicant's "PEDIGREE PARK"

[18] However, in answer to applicant's Interrogatory No. 5, Ms. Nathanson indicated that "[i]n reviewing documents related to its registered Pedigree trademark, Opposer found a reference to Pedigree Park in a search report dated August 19, 1986" which "was set forth in the 'Common Law Library Search' of a Thomson & Thomson search report" requested by its attorneys, but in her testimony she was unable to recall whether opposer knew about such in 1986 or otherwise provide further details.

products in the marketplace. Opposer also asserts that it "has no record of any knowledge of the publication" in the Official Gazette on May 12, 1987 of the application which matured on August 4, 1987 into applicant's now canceled Registration No. 1,450,801 for the mark "PEDIGREE PARK". (Answer to Applicant's Interrogatory No. 7.)

Opposer has not licensed or authorized any third parties to use its "PEDIGREE" mark and the record does not reveal any third-party use of marks which consist of or include the word "PEDIGREE". In addition, opposer concedes that it is not aware of any instances of actual confusion with respect to its "PEDIGREE" brand products and applicant's "PEDIGREE PARK" goods. Opposer also acknowledges that, while it started selling dog toys (e.g., squeaky toys, funny balls, and similar chew toys) under its "PEDIGREE" mark in 1995, it does not sell rawhide chews for dogs like applicant does. Instead, the chews which opposer sells under its "PEDIGREE" mark are snack products for dogs, such as biscuits and treats.

Applicant, which was founded by its president, James R. Hacht, around 1980 as an importer of seasonal merchandise for such occasions as Easter, Christmas and Halloween, subsequently evolved, at a customer's request for certain pet merchandise, into a seller of pet supplies and products by the early 1980s. The first of such products sold by applicant was a rawhide dog chew, which applicant began offering about 1980 under the mark "CANINE CHOICE". After selling such mark in the early 1980s, applicant adopted and began using the mark "PEDIGREE PARK" for

its rawhide dog chews at least as early as July, 1984. Although applicant admits to becoming aware of opposer's use of its "PEDIGREE" mark by the late 1980s, Mr. Hacht was not aware of opposer's use of the "PEDIGREE" mark at the time applicant adopted its "PEDIGREE PARK" mark. Applicant federally registered such mark for "pet supplies--namely, rawhides, animal leashes and collars," receiving Registration No. 1,450,801 on August 4, 1987. However, due to an inadvertent failure to file an affidavit under Section 8 of the Trademark Act, such registration was canceled.[19]

Applicant, despite the cancellation of its registration for the "PEDIGREE PARK" mark, has continuously used such mark in connection with rawhide chews for dogs and has also sold animal leashes and collars under the mark. In fact, since 1984, Mr. Hacht testified that the products sold by applicant under its mark have included "[a]ll different pet supplies, rawhide chew bones, rawhide chews in general, latex toys, rubber toys, [and] cat toys. And more recently pork products, pig ears and pork skin rawhides, the whole gambit of pet supplies ... [and] pet products--collars and leads [sic]." (Hacht dep. at 20.) Applicant markets its products "through a trade show, [and] through representatives or direct contacts" and sells its goods in drugstores, groceries, pet stores and mass merchandisers, such as K-Mart. Applicant uses its mark by placing it on header cards

[19] At the time the Section 8 affidavit was due, another company was handling all bill payments, including legal fees, for applicant. Such company, despite repeated and timely requests by applicant that its attorneys be paid so that the Section 8 affidavit could be filed, by the time the fee had been paid and was properly credited to applicant's account, its registration was canceled. At no time, however, has applicant had any intent to abandon its subject mark.

for the packaging of its products and on sales sheets distributed to retailers.

Applicant distributes and sells its merchandise nationally. Annual gross sales for the years from 1988 through 1995 of its "PEDIGREE PARK" products, although confidential, have ranged from a high of over one and one quarter million dollars to a low of under two hundred thousand dollars. Advertising figures during such period, which include advertising allowances as well as direct expenditures, have been meager, running from a high of over ten thousand dollars to none at all in two separate years. Applicant, however, claims that its mark has been continuously advertised since July, 1984. Applicant does occasional media advertising of its "PEDIGREE PARK" products by placing ads in customers' fliers and by giving certain of its customers a percentage price break to use as an advertising allowance.

Like opposer, applicant is unaware of any incidents of actual confusion with respect to the parties' use of their respective marks. Moreover, until this proceeding arose, applicant had never received any objection to use of its "PEDIGREE PARK" mark from opposer, a period spanning approximately a dozen years. Nevertheless, Mr. Hacht essentially conceded on cross-examination the closely related nature of dog foods and rawhide chews, noting that the independent sales representatives who sell its goods to retailers would typically offer both products. Specifically, he testified that:

> Q Okay. .... Do any of the sales reps that work with your company also work for dog food companies?
>
> A I'm sure they probably do.
>
> Q Any idea what companies?
>
> A No. That's a guess on my part but it would make sense that if a guy has a dog food line he is also likely to have a rawhide line and other things to go in and show the same buyer ....

(Id. at 121.)

Finally, the record establishes that there has been no detrimental reliance, or other material prejudice, experienced by applicant as a result of opposer's failure to sue applicant for trademark infringement. In particular, when asked on cross-examination if "you have any understanding that the nature of this opposition proceeding is not that you would no longer as Hacht Sales be able to use the name Pedigree Park, [but that] it is strictly a question of the registration of the name Pedigree Park" (id. at 127), Mr. Hacht replied, among other things, that:

> I mean I'm not convinced - yes, I think bottom line, I think that if they were to be able to get away with it, yes, they would sure try to stop me from using it, yes, that's what I really - I think - believe in my heart that one step leads to another, ... that they will keep pushing it as far as they can. And I just think they're out of line because obviously ... I've had a registered trademark on it. I mean you know that, they know that. I think they're just harassing me and - well, I guess we'll just let the chips fall where they may.

(Id. at 129.)

Moreover, in a declaratory judgment action brought by applicant against opposer during this proceeding, and in which

applicant sought a finding of no likelihood of confusion between the respective marks of the parties herein, such action was dismissed on opposer's motion as not justiciable in view of the representation of opposer's counsel that opposer presently had no intention of suing applicant for trademark infringement. Contrary to applicant's contention that counsel for opposer admitted that there is no likelihood of confusion, opposer's counsel actually told the Court that, in an attempt to settle this opposition, opposer proposed the following covenant not to sue:

> MR. KRAUSE: Here's what we offered him, your Honor. We offered him this covenant in an agreement to settle the opposition, and counsel [for applicant] refused it and said ... it's not broad enough. We said, well, here's a blank line. You fill in the rest of the products you want to have in that covenant, and we'll be happy to entertain that.
>
> Here's what the covenant proposed as a settlement of the opposition:
>
> "Kal Kan agrees not to object to Hacht Sales' use of the name Pedigree Park for pet supplies; namely, rawhide chews, animal leashes and collars ..." That's what they tried to register.
>
> THE COURT: And that's what they say in their pleadings here.
>
> MR. KRAUSE: And we say, "... provided that such use corresponds to use shown in Exhibit A," one of their own labels, "and except that such use by Hacht shall not bear the orange circle symbol."
>
> So, your honor, we have agreed to let them do exactly what they're doing now.

(Transcript of Hearing on Motion to Dismiss, Case No. 96-71525, held in the United States District Court for the Eastern District of Michigan, Southern Division, on July 25, 1996, at 10-11.)

Applicant's counsel, however, advised the Court that applicant did not desire to limit either the format in which it would use its "PEDIGREE PARK" mark or the particular goods in connection with which the mark could be used. Applicant's counsel also reiterated his belief that "my client, in the position, they're in, has a reasonable apprehension that if they continue using Pedigree Park, at some point, they're going to be charged in an infringement case by Kal Kan". (Id. at 13.) The Court noted and opposer's counsel confirmed, however, that:

> THE COURT: Well, Kal Kan's already said until, at least, the trademark and patent office makes their ruling, they have no intention of filing a lawsuit or taking any other kind of legal action until they've moved it over there; is that correct?
>
> MR: KRAUSE: That's correct, your Honor. Based on what they're doing now, that's absolutely correct. We have no intention of suing them.

(Id. at 13.) The Court consequently dismissed the declaratory judgment action for lack of an actual controversy, stating that:

> THE COURT: Okay. In this matter ... I just don't think it's ripe for the Court at this point, that there is a good, adequate remedy that's probably much better than this Court to decide the controversy, and there's no actual controversy in terms of lawsuits, in terms of intimidation and so forth.
>
> I understand ... there's a lot to be lost by the plaintiffs in this particular matter, but I think that in terms of being here, certainly, it belongs in the patent and

trademark office and not here, and, therefore, the Court will grant the motion.

Turning first to the issue of likelihood of confusion, we find upon consideration of 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), that confusion as to source or affiliation is likely to occur. As a starting point, it is plain that applicant's pet supplies, namely, rawhide chews, animal leashes and collars, are closely related to opposer's pet foods and other pet products such as toys. The record establishes, as applicant has conceded, that the parties' pet supplies and products travel through the same channels of trade, such as grocery stores, mass merchandising stores like K-Mart, pet stores and drugstores, and are marketed to the same class of purchasers, namely, ordinary consumers. Moreover, the parties' goods are relatively inexpensive, impulse-type items which would usually be purchased without the need for deliberation or careful attention. Clearly, if such pet products were to be sold under identical or similar marks, confusion as to the origin or affiliation thereof would be likely to occur.

Applicant contends, however, that confusion is not likely because its "PEDIGREE PARK mark is dissimilar in sound from Opposer's mark PEDIGREE." Specifically, applicant asserts that its mark is two words while opposer's "PEDIGREE" mark is only one word and that, while both marks contain the same first word, "the more dominant portion of Applicant's mark is the word PARK." We agree with opposer, however, that when considered in

their entireties, the applicant's "PEDIGREE PARK" mark is substantially similar, in both sound and appearance, to each of opposer's "PEDIGREE" and "PEDIGREE"-formative marks. In particular, we concur with opposer that "[t]he presence of the 'Park' portion of Applicant's mark is not sufficient to distinguish the marks and avoid a likelihood of confusion". In each instance, the word "PEDIGREE" is either the sole or dominant portion of opposer's marks, inasmuch as it would be utilized by consumers in looking or asking for opposer's goods, and such word is also the dominant feature of applicant's mark, since it is the first and thus most significant portion thereof. Here, as opposer persuasively points out, applicant "has appropriated the entire source-identifying aspect of Opposer's registered trademarks," and, we find, the overall commercial impression engendered by each of the parties' marks is substantially identical, notwithstanding the presence of the word "PARK" in applicant's mark. Consequently, the contemporaneous use of the respective marks in connection with the parties' closely related goods would be likely to cause confusion as to the source or sponsorship of their pet supplies and products.

Our conclusion in this regard is strengthened by the fact that no other entities in the pet food and pet supplies field utilize a mark which consists of or includes the term "PEDIGREE". In addition, the evidence of sales and advertising in the record supports, and counsel for applicant conceded at the oral hearing, that opposer's "PEDIGREE" marks are famous for dog food. As such, opposer's "PEDIGREE" dog food marks are strong

marks which are entitled to a correspondingly broad scope of protection from imitation. See Kenner Parker Toys Inc. v. Rose Art Industries Inc., 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992), cert. denied, 506 U.S. 862, 113 S.Ct. 181 (1992) ["The fifth *duPont* factor, fame of the prior mark, plays a dominant role in cases featuring a famous or strong mark. Famous or strong marks enjoy a wide latitude of legal protection"]. Moreover, even if opposer's "PEDIGREE" marks and formatives thereof are not regarded as famous, the record demonstrates that opposer has had substantial nationwide sales of pet foods and other pet products under such marks and has expended appreciable amounts on advertising and promoting its marks over an extended period of time. In view thereof, opposer's "PEDIGREE" and "PEDIGREE"-formative marks must, at a minimum, be considered to be relatively well known marks which, having achieved a substantial measure of strength and recognition as indicia of source and quality for its goods, are therefore entitled to a broad ambit of protection.

Finally, the fact that neither party is aware of any instances of actual confusion does not undercut our conclusion that ordinary consumers could reasonably believe, for example, that applicant's rawhide chews, animal leashes and collars, when sold under its "PEDIGREE PARK" mark, are part of a new or expanded line of pet supplies emanating from or sponsored by the same entity which markets pet food and other pet products under the "PEDIGREE" and "PEDIGREE"-formative marks. Although both parties presented testimony that they have enjoyed nationwide

sales of their respective goods, the record fails to reveal that the volume of applicant's sales, when considered along with its meager advertising and promotional expenditures, has been so extensive that, if confusion were likely, it would be expected to have occurred. The lack of any incidents of actual confusion is also not dispositive inasmuch as evidence thereof is notoriously difficult to come by, particularly in the case of inexpensive products,[20] and in any event the test under Section 2(d) of the Trademark Act is likelihood of confusion rather than actual confusion. See, e.g., Gillette Canada Inc. v. Ranir Corp., 23 USPQ2d 1768, 1774 (TTAB 1992) and cases cited therein.

This accordingly brings us to consideration of applicant's affirmative defense of laches.[21] While neither party has cited or otherwise discussed the following case, which was not decided until eleven days after opposer filed its initial brief, the Board in Aquion Partners L.P. v. Envirogard Products Ltd., 43 USPQ2d 1371, 1373 (TTAB 1997), stated with respect to the defense of laches that:

> A *prima facie* defense of laches requires a showing of (1) unreasonable delay in asserting one's rights against another, and (2) material prejudice to the latter as a result of the delay. *Lincoln Logs Ltd. v. Lincoln Pre-cut Log Homes, Inc.*, 971 F.2d 732, 23 USPQ2d 1701, 1703 (Fed. Cir. 1992). In the context of a trademark opposition or cancellation proceeding, this defense must be

[20] See, e.g., Helene Curtis Industries Inc. v. Suave Shoe Corp., 13 USPQ2d 1618, 1623 (TTAB 1989).

[21] Although not explicitly referred to as such in applicant's brief, applicant has repeatedly argued the facts constituting the defense in its brief and, thus, we do not consider the defense to have been waived.

> tied to a party's registration of a mark rather than to its use of the mark. *National Cable Television [Association, Inc. v. American Cinema Editors, Inc.*, 937 F.2d 1572, 1580, 19 USPQ2d 1424, 1431 (Fed. Cir. 1991)] ... at 1432. The burden of proof is on the party that raises the affirmative defense. Although the burden of coming forward with exculpatory evidence may shift to the other party, the ultimate burden of proof does not change. *A.C. Aukerman Co. v. R.L. Chaides Construction Co.*, 960 F.2d 1020, 1028, 22 USPQ2d 1321, 1333 (Fed. Cir. 1992) (en banc). .... The mere passage of time does not constitute laches. *Advanced Cardiovascular Systems v. SciMed Life Systems*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993).

With respect to the element of the period of delay, the Board in *Aquion Partners* specifically noted that (footnotes omitted):

> As indicated in *National Cable Television*, 19 USPQ2d at 1432, "laches begins to run from the time action could be taken against the acquisition by another of a set of rights to which objection is later made." In an opposition or cancellation proceeding, where the objection is to the issuance of a registration of a mark, laches starts to run when the mark in question is published for opposition. *National Cable Television*, supra. Inasmuch as opposer has acted at its first opportunity to object to registration of applicant's current RAINFRESH mark, applicant might appear, at first blush, to have no basis for a laches defense against opposer respecting the application in issue. However, under certain circumstances, a laches defense in an opposition proceeding may be based upon opposer's failure to object to an applicant's earlier registration of [the same or] substantially the same mark for [the same or] substantially the same goods. *See*, *Lincoln Logs*, 23 USPQ2d at 1703, citing *Copperweld Corp. v. Astralloy-Vulcan Corp.*, 196 USPQ 585, 591 (TTAB 1971).
>
> In the present case, we do not see any inequity in allowing applicant to assert, and attempt to prove, the defense of laches. The

> mark applicant now seeks to register was, according to applicant's pleading and ... evidence, the subject of a prior registration which existed from 1971 until 1991, when it expired due to applicant's inadvertent failure to renew it. The important point is that the mark applicant now seeks to register was published for opposition in 1971 and thereafter was registered for 20 years without objections from opposer.

Id.

As to the additional element of material prejudice which is required to establish laches, the Board in *Aquion Partners* further pointed out that:

> As noted above, mere delay in asserting a trademark right does not constitute laches. Rather, a party asserting laches must show not only unreasonable delay but also circumstances compelling enough to give rise to an estoppel, that is, that the party asserting the defense has relied upon the delay to its detriment. *Charrette Corp. v. Bowater Communication Papers Inc.*, 13 USPQ2d 2040, 2043 (TTAB 1989); *Weyerhauser Co. v. Temporaries Inc.*, 222 USPQ 250, 252 (TTAB 1984); and *Burroughs Wellcome Co. v. Warner-Lambert Co.*, 203 USPQ 201, 209 (TTAB 1979).
>
> Here, the only evidence offered by applicant which bears on the issue of material prejudice is the declaration of its president, which attests, inter alia, to applicant's own use of its mark since 1980, and furnishes applicant's sales figures under the mark from 1980 to 1995. An examination of the sales figures shows that applicant's annual sales for each of the years from 1984 to 1995 were roughly half the amount of its annual sales for each of the years 1981, 1982, and 1983. This evidence, without more, is insufficient to show ... whether applicant has been materially prejudiced by opposer's delay (if unreasonable delay is established) in objecting to registration of the mark RAINFRESH and design by applicant.

Id. at 1374.

In the present case, even assuming that opposer's failure to object to the earlier application by applicant which matured into its now canceled registration for the same mark for the same goods during the life of such registration constitutes an unreasonable delay in asserting opposer's rights, applicant has failed to demonstrate that it has detrimentally relied or otherwise suffered material prejudice as the result of such delay. To the contrary, the record reflects that applicant fully expects opposer to continue to assert its rights in its "PEDIGREE" and "PEDIGREE"-formative marks and there has been no showing that applicant has altered its business activities, or that its sales and/or advertising have been detrimentally affected, as a result of opposer's asserted delay. In consequence thereof, applicant has failed to establish its affirmative defense of laches.

Decision: The opposition is sustained and registration to applicant is refused.

T. J. Quinn

G. D. Hohein

D. E. Bucher
Administrative Trademark Judges,
Trademark Trial and Appeal Board