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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Trademark Application Serial No. 76-265,943
Filed June 1, 2001
For the mark, MINNESOTA WILD
Published in the *Official Gazette* on May 14, 2002 at page TM 494.

U.S. Patent & TMO/TM Mail Rcpt. Dt. #57
09-06-2002

MINNESOTA WILD HOCKEY)
CLUB, LP)
Opposer,)
vs.)
MINNESOTA SPECIALTY CROPS,)
INCORPORATED)
Applicant.)

Opposition No. _____

NOTICE OF OPPOSITION

TO: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Box TTAB Fee, Arlington, VA 22202-3513.

In the matter of the application of Minnesota Specialty Crops, Incorporated ("Applicant") for the registration of MINNESOTA WILD, Application Serial No. 76-265,943, published in the *Official Gazette* of May 14, 2002, at page TM 494 thereof, Minnesota Wild Hockey Club, LP, ("Opposer") a limited partnership organized under the laws of the State of Minnesota, the sole general partner of which is Naegele Sports, LLC, a Minnesota limited liability company having its principal place of business at 317 Washington Street, St. Paul, Minnesota 55102, believes that it is or will be damaged by the registration of the mark, MINNESOTA WILD, shown in Serial No. 76-265,943 and hereby opposes the application.

The grounds for this Opposition are as follows:

THE PARTIES

1. Minnesota Wild Hockey Club, LP ("Opposer") is a limited partnership duly organized and existing under the laws of the State of Minnesota, the sole general partner of which is Naegele Sports, LLC, a Minnesota limited liability company with its principal place of business at 317 Washington Street, St. Paul, Minnesota 55102.

2. Upon information and belief Minnesota Specialty Crops, Incorporated ("Applicant") is a corporation duly organized and existing under the laws of the State of Minnesota with its principal place of business at 69 Airport Boulevard, McGregor, Minnesota 55760.

TRADEMARK APPLICATIONS OF THE PARTIES

3. Opposer is the owner of the following trademark applications and registrations:

Trademark	Appl. No. or Reg. No.	Filing Date or Reg. Date	Inter. Class Goods/Services	Present Status
WILD	75/367,406	03-Oct-1997	Classes 25 and 41: Clothing consisting of hockey game exhibition merchandise, namely, bandannas, beach coverups, belts, body suits, boxer shorts, caps, cloth bibs, coats, dresses, ear muffs, footwear, gloves, hats, headbands, hosiery, housecoats, jackets, jerseys, leggings, leotards, mittens, nightshirts, pajamas, pants, rain coats, rainwear, robes, scarves, shirts, shorts, skirts, socks, suits, sun visors, suspenders, sweaters, sweatpants, sweatshirts, swimsuits, swim trunks, T-shirts, ties, togues, underwear, vests, warm-up suits and wristbands (Class 25); and entertainment services, namely, providing professional hockey exhibitions (Class 41).	Published for opposition on 27-Oct-1998. Minnesota Specialty Crops, Inc. filed Notice of Opposition with TTAB on 15-Jun-1999 (Opposition No. 115,009).

Trademark	Appl. No. or Reg. No.	Filing Date or Reg. Date	Inter. Class Goods/Services	Present Status
MINNESOTA WILD	75/367,439	03-Oct-1997	Class 25: Clothing, namely, bandannas, beach coverups, belts, body suits, boxer shorts, cloth bibs, coats, dresses, ear muffs, footwear, gloves, headbands, hosiery, housecoats, jackets, jerseys, leggings, leotards, mittens, nightshirts, pajamas, pants, rain coats, rainwear, robes, scarves, shorts, skirts, socks, suits, sun visors, suspenders, sweatpants, swimsuits, swim trunks, ties, togues, underwear, vests, warm-up suits and wristbands.	Published for opposition on 17-Nov-1998. Minnesota Specialty Crops, Inc. filed Notice of Opposition with TTAB on 15-Jun-1999 (Opposition No. 115,009).
MINNESOTA WILD	75/441,359	26-Feb-1998	Class 36: Credit card services. Dates of First Use: 06-Mar-1998	Published for opposition on 03-Mar-1999. Minnesota Specialty Crops, Inc. filed Notice of Opposition with TTAB on 15-Jun-1999 (Opposition No. 115,009).
MINNESOTA WILD and Design 	75/480,133	06-May-1998	Class 36: Credit card services. Dates of First Use: 06-Mar-1998	Published for opposition on 04-May-1999. Minnesota Specialty Crops, Inc. filed Notice of Opposition with TTAB on 15-Jun-1999 (Opposition No. 115,009). Registration cancelled on 29-Dec-1999 (registration inadvertently issued after a Notice of Opposition was filed with TTAB).

Trademark	Appl. No. or Reg. No.	Filing Date or Reg. Date	Inter. Class Goods/Services	Present Status
MINNESOTA WILD	75/977,397	03-Oct-1997	Class 25: Clothing, namely, caps, hats, shirts, sweaters, sweatshirts, and T-shirts. Dates of First Use: 22-Jan-1998	Published for opposition on 27-Oct-1998. Minnesota Specialty Crops, Inc. filed Notice of Opposition with TTAB on 15-Jun-1999 (Opposition No. 115,009).
WYLD	1,909,347	01-Aug-1995	Class 25: Athletic, casual, and outdoor clothing; namely, shorts, T-shirts, sweatshirts, sweatpants, hats, swimwear, jackets, bandannas, socks, polo shirts, jerseys. Dates of First Use: 01-Jul-1994	Registered on 01-Aug-1995.
MINNESOTA WILD	2,451,238	15-May-2001	Class 41: Entertainment services, namely, providing professional hockey exhibitions.	Registered on 15-May-2001.
MINNESOTA WILD	2,456,465	29-May-2001	Class 41: Entertainment services, namely, providing professional hockey exhibitions. Dates of First Use: 30-Sep-1998	Registered on 29-May-2001.
WILD	2,481,111	28-Aug-2001	41: Entertainment services, namely, providing professional hockey exhibitions.	Registered on 28-Aug-2001.
MINNESOTA WILD and Design 	75/470,561	20-Apr-1998	Class 25: Clothing, namely, caps, coats, hats, jackets, shirts, sweaters, sweatshirts, and T-shirts. Dates of First Use: 22-Jan-1998	Pending. Action on application suspended on 22-Jul-1999 by applications filed by Minnesota Specialty Crops.
MINNESOTA WILD and Design 	75/470,562	20-Apr-1998	Class 25: Clothing, namely, bandannas, beach coverups, belts, body suits, boxer shorts, cloth bibs, dresses, ear muffs, footwear, gloves, headbands, hosiery, housecoats, jerseys, leggings, leotards, mittens, nightshirts, pajamas, pants, rain coats, rainwear, robes, scarves, shorts, skirts, socks, suits, sun visors, suspenders, sweatpants, swimsuits, swim trunks, ties, toques, underwear, vests, warm-up suits and wristbands.	Pending. Action on application suspended on 22-Jul-1999 by applications filed by Minnesota Specialty Crops.

Trademark	Appl. No. or Reg. No.	Filing Date or Reg. Date	Inter. Class Goods/Services	Present Status
MINNESOTA WILD and Design 	2,487,996	11-Sep-2001	Class 41: Entertainment services, namely, providing professional hockey exhibitions.	Registered on 11-Sep-2001.
WILD OF MINNESOTA	75/621,525	15-Jan-1999	Class 25: Clothing, namely, bandannas, beach coverups, belts, body suits, boxer shorts, caps, cloth bibs, coats, dresses, ear muffs, footwear, gloves, hats, headbands, hosiery, housecoats, jackets, jerseys, leggings, leotards, mittens, nightshirts, pajamas, pants, rain coats, rainwear, robes, scarves, shirts, shorts, skirts, socks, suits, sun visors, suspenders, sweaters, sweatpants, sweatshirts, swimsuits, swim trunks, T-shirts, ties, toques, underwear, vests, warm-up suits and wristbands.	Published for opposition on 17-Dec-1999. Minnesota Specialty Crops, Inc. filed Notice of Opposition with TTAB and mailed 28-Jun-2000 (Opposition No. 119,143).
WILD OF MINNESOTA	75/621,526	15-Jan-1999	Class 36: Credit card services.	Published for opposition on 09-Nov-1999. Minnesota Specialty Crops, Inc. filed Notice of Opposition with TTAB and mailed 28-Jun-2000 (Opposition No. 119,143).
WILD MINNESOTA	2,470,194	17-Jul-2001	Class 41: Entertainment services, namely, providing professional hockey exhibitions.	Registered on 17-Jul-2001.
MINNESOTA JUNIOR WILD	75/648,286	25-Feb-1999	Class 25: Clothing, namely, bandannas, beach coverups, belts, body suits, boxer shorts, caps, cloth bibs, coats, dresses, ear muffs, footwear, gloves, hats, headbands, hosiery, housecoats, jackets, jerseys, leggings, leotards, mittens, nightshirts, pajamas, pants, rain coats, rainwear, robes, scarves, shirts, shorts, skirts, socks, suits, sun visors, suspenders, sweaters, sweatpants, sweatshirts, swimsuits, swim trunks, T-shirts, ties, toques, underwear, vests, warm-up suits and wristbands.	Pending. Action on application suspended on 02-Feb-2000 by applications filed by Minnesota Specialty Crops.

Trademark	Appl. No. or Reg. No.	Filing Date or Reg. Date	Inter. Class Goods/Services	Present Status
MINNESOTA JUNIOR WILD	75/648,287	25-Feb-1999	41: Entertainment services, namely, providing hockey exhibitions.	Pending. Notice of Allowance issued on 29-Feb-2000.
MINNESOTA FUTURE WILD	75/674,143	05-Apr-1999	Class 41: Entertainment services, namely, providing hockey exhibitions.	Pending. Notice of Allowance issued on 06-Jun-2000.
MINNESOTA FUTURE WILD	75/674,144	05-Apr-1999	Class 25: Clothing, namely, bandannas, beach coverups, belts, body suits, boxer shorts, caps, cloth bibs, coats, dresses, ear muffs, footwear, gloves, hats, headbands, hosiery, housecoats, jackets, jerseys, leggings, leotards, mittens, nightshirts, pajamas, pants, rain coats, rainwear, robes, scarves, shirts, shorts, skirts, socks, suits, sun visors, suspenders, sweaters, sweatpants, sweatshirts, swimsuits, swim trunks, T-shirts, ties, toques, underwear, vests, warm-up suits and wristbands.	Pending
WILD STREET	76/333,453	01-Nov-2001	Class 41: Organizing and administering community based street hockey programs and competitions for youths.	Pending. Application will be published for opposition.
WILD ABOUT YOUTH	28,164	15-Jan-1999	Class 41: Entertainment and education services, namely, promoting the growth of amateur hockey. Dates of First Use: 19-Nov-1998	Registered. Minnesota State trademark registration.

4. Applicant Minnesota Specialty Crops has filed the following trademark applications for use of the following marks on the following described goods and services:

Trademark	Appl. No. or Reg. No.	Filing Date or Reg. Date	International Class Goods/Services	Present Status
	2,371,974	01-Aug-2000	Class 18: book bags, satchels, canes, and walking sticks.	Registered on 01-Aug-2000.
	2,369,795	25-Jul-2000	Class 3: potpourri and sachets.	Registered on 25-Jul-2000.

Trademark	Appl. No. or Reg. No.	Filing Date or Reg. Date	International Class Goods/Services	Present Status
MINNESOTA WILD	75/437,660	20-Feb-1998	Class 14: jewelry.	Minnesota Wild Hockey Club, LP filed Consolidated Notice of Opposition with TTAB on 12-Apr-2000 (Opposition No. 119,048).
MINNESOTA WILD	75/437,853	20-Feb-1998	Class 16: pens, art reproductions, postcards, greeting cards, recipe books, cook books, printed paper gift boxes, stickers, bumper stickers, and pamphlets in the field of specialty foods, gifts, and clothing.	Minnesota Wild Hockey Club, LP filed Consolidated Notice of Opposition with TTAB on 12-Apr-2000 (Opposition No. 119,048).
	2,374,207	08-Aug-2000	Class 16: art reproductions, postcards, greeting cards, recipe books, cook books, printed paper gift boxes, stickers, bumper stickers, and pamphlets in the field of specialty foods, gifts, and clothing.	Registered on 08-Aug-2000.
MINNESOTA WILD	75/437,851	20-Feb-1998	Class 18: satchels, canes, and walking sticks.	Minnesota Wild Hockey Club, LP filed Consolidated Notice of Opposition with TTAB on 12-Apr-2000 (Opposition No. 119,048).
MINNESOTA WILD	75/437,874	20-Feb-1998	Class 21: mugs, birch bark baskets, woven wood baskets, bird feeders, wine bottle cradles, and wine racks.	Minnesota Wild Hockey Club, LP filed Consolidated Notice of Opposition with TTAB on 12-Apr-2000 (Opposition No. 119,048).
	2,325,250	07-Mar-2000	Class 21: mugs, birch bark baskets, woven baskets, bird feeders, wine bottle cradles, and wine racks.	Registered on 07-Mar-2000.
	2,376,479	15-Aug-2000	Class 26: ornamental novelty pins and buttons.	Registered on 15-Aug-2000.
MINNESOTA WILD	75/437,464	20-Feb-1998	Class 26: ornamental novelty pins and buttons.	Minnesota Wild Hockey Club, LP filed Consolidated Notice of Opposition with TTAB on 12-Apr-2000 (Opposition No. 119,048).

Trademark	Appl. No. or Reg. No.	Filing Date or Reg. Date	International Class Goods/Services	Present Status
	2,367,454	18-Jul-2000	Class 14: jewelry.	Registered on 18-Jul-2000.
	2,380,294	29-Aug-2000	Class 9: decorative magnets.	Registered on 29-Aug-2000.
MINNESOTA WILD	75/437,466	20-Feb-1998	Class 28: Christmas tree ornaments and sportsmen' s fishing bags.	Minnesota Wild Hockey Club, LP filed Consolidated Notice of Opposition with TTAB on 12-Apr-2000 (Opposition No. 119,048).
MINNESOTA WILD	75/437,647	20-Feb-1998	Class 6: metal key chains, metal key rings, and metal clothes hooks.	Minnesota Wild Hockey Club, LP filed Consolidated Notice of Opposition with TTAB on 12-Apr-2000 (Opposition No. 119,048).
MINNESOTA WILD	75/437,649	20-Feb-1998	Class 3: potpourri and sachets.	Minnesota Wild Hockey Club, LP filed Consolidated Notice of Opposition with TTAB on 12-Apr-2000 (Opposition No. 119,048).
	2,407,599	28-Nov-2000	Class 21: drinking glasses, beverage glassware, and glass beverage ware.	Registered on 28-Nov-2000.
MINNESOTA WILD	75/437,212	19-Feb-1998	Class 21: drinking glasses, beverage glassware, glass beverage ware, and bottle openers.	Minnesota Wild Hockey Club, LP filed Consolidated Notice of Opposition with TTAB on 12-Apr-2000 (Opposition No. 119,048).
	75/437,467	20-Feb-1998	Class 28: Christmas tree ornaments and sportsmen' s fishing bags.	Pending. Notice of Allowance issued on 08-Aug-2000.
	2,376,480	15-Aug-2000	Class 6: metal key chains, metal key rings, and metal clothes hooks.	Registered on 15-Aug-2000.

Trademark	Appl. No. or Reg. No.	Filing Date or Reg. Date	International Class Goods/Services	Present Status
MINNESOTA WILD	75/437,662	20-Feb-1998	Class 9: decorative magnets.	Minnesota Wild Hockey Club, LP filed Consolidated Notice of Opposition with TTAB on 12-Apr-2000 (Opposition No. 119,048).
 MINNESOTA WILD	75/427,037	02-Feb-1998	Class 25: clothing, namely, shirts, sweatshirts, and hats.	Pending. Action on application suspended on 05-May-1999 by applications filed by Minnesota Wild Hockey Club, LP.
MINNESOTA WILD	75/427,036	02-Feb-1998	Class 25: clothing, namely, shirts, sweatshirts, and hats.	Pending. Action on application suspended on 04-Jun-1999 by applications filed by Minnesota Wild Hockey Club, LP.
 MINNESOTA WILD	75/425,348	29-Jan-1998	Class 35: retail gift shop services; mail order and telephone order services featuring specialty foods, gifts, and clothing.	Pending. Action on application suspended on 05-May-1999 by applications filed by Minnesota Wild Hockey Club, LP.
MINNESOTA WILD	2,441,734	10-Apr-2001	Class 29: food Products, namely, jellies. Class 30: table syrup, maple syrup, fruit syrups, honey, and pancake mixes. Class 33: alcoholic beverages, namely, wine.	Registered on 10-Apr-2001.
 MINNESOTA WILD	2,374,196	08-Aug-2000	Class 29: food Products, namely, jellies. Class 30: table syrup, maple syrup, fruit syrups, honey, and pancake mixes. Class 33: alcoholic beverages, namely, wine.	Registered on 08-Aug-2000.
MINNESOTA WILD	75/425,333	29-Jan-1998	Class 35: retail gift shop services; mail order and telephone order services featuring specialty foods, gifts, and clothing.	Pending. Action on application suspended on 27-May-1999 by applications filed by Minnesota Wild Hockey Club, LP.
MINNESOTA WILD	76/265,943	01-Jun-2001	Class 30: processed cereal used as a breakfast or snack food.	Published for opposition on 14-May-2002.

RELATED PROCEEDING BETWEEN THE PARTIES

5. Opposer has opposed various applications filed by Applicant for MINNESOTA WILD as detailed in paragraph 4. That opposition proceeding was assigned Opposition No. 119,048.

6. Applicant has opposed certain of Opposer's trademark applications in opposition proceedings as detailed in paragraph 3. Those opposition proceedings were assigned Opposition Nos. 115,009 and 119,143.

7. The three opposition proceedings described in paragraphs 5 and 6 have been consolidated by the Board under Opposition No. 115,909.

8. Applicant subsequently filed a trademark infringement lawsuit against Opposer in the United States District Court for the District of Minnesota captioned: *Minnesota Specialty Crops, Inc. vs. Minnesota Wild Hockey Club, L.P. and NHL Enterprises, L.P.*, Case No. 00-CV-2317 JRT/RLE (U.S. Dist. Ct., Dist. Minn.)(hereafter referred to as "the Lawsuit"). As a result of the filing of the Lawsuit, the opposition proceeding between the parties have been suspended. The Lawsuit is still pending between the parties.

9. On July 26, 2002, the District Court entered a Memorandum Opinion and Order on the parties' cross motions for summary judgment wherein the court found that Applicant's trademark is not inherently distinctive. A true and correct copy of the Court's Memorandum Opinion and Order is attached hereto as Exhibit 1.

REQUEST FOR CONSOLIDATION

10. Opposer requests that this current opposition proceeding be consolidated with the other opposition proceedings between the parties under Opposition No. 115,909.

FURTHER GROUNDS FOR THE OPPOSITION

11. Applicant Minnesota Specialty Crops has claimed in its opposition proceedings and in the Lawsuit that there is a likelihood of confusion between the Applicant's marks and those of Opposer. Applicant has failed to make any distinction between word marks and design marks and has failed to take into account how the marks are actually used in commerce.

12. On information and belief, Applicant Minnesota Specialty Crops has made only token, and not trademark use of the marks at issue on the goods stated in the application that is a subject of this opposition proceeding. On information and belief, Applicant has no right or priority on the mark MINNESOTA WILD for those goods based on its token use.

13. Opposer's marks are of great value to Opposer as identification of source in connection with its business, to identify and distinguish Opposer's goods, services and business from the goods, services and business of others, and it symbolizes the goodwill of Opposer's business.

14. Applicant is not entitled to the exclusive use of the words "Minnesota" and "wild" alone (without respect to design elements) on the goods set forth in its trademark application that is the subject of this action because Applicant's mark is not inherently distinctive for the goods described in the application and Applicant has failed to establish acquired distinctiveness or secondary meaning in the mark. Opposer will be damaged if Applicant is permitted to obtain the registration it is seeking.

15. Opposer's marks have become famous as a result of their broad use and publicity the Opposer has received.

16. Applicant's use of the mark (other than Applicant's design mark) on goods and services adopted by Applicant after Opposer's mark became famous may cause dilution of Opposer's famous mark.

17. Upon information and belief Applicant has committed fraud and made intentional material misrepresentations and omitted material information in prosecuting its trademark applications, before the United States Patent and Trademark Office. As an overview, Applicant has engaged in the following deceptive conduct in prosecuting its trademark applications: (A) Applicant stated under oath in prosecuting its trademark applications that the word "MINNESOTA" has become distinctive for its business, although Applicant has admitted that it has no claim to the exclusive use of "MINNESOTA" and that Applicant was aware of other companies using "MINNESOTA" on food as well as other goods and services; (B) Applicant asserted in the prosecution of its trademark applications that the term "wild" is not descriptive of its products even though Applicant actively markets its products as being made from wild ingredients; and (C) Applicant failed to submit a single jelly label in support of its trademark applications as a specimen because Applicant's jelly labels would have revealed to the examining attorney that Applicant's use of "wild" is merely descriptive, contrary to the assertions of Applicant in prosecuting its applications.

18. On or about January 29, 1998, shortly after the announcement of Opposer's name for its hockey club, Applicant filed a pair of federal trademark applications for its food and wine products. These were the first federal trademark applications ever filed by Applicant. One application was for the word mark MINNESOTA WILD (Serial No. 75/425,335). This application ultimately matured into Registration No. 2,441,734. The second was for the

Applicant's logo (Serial No. 75/425,334). Applicant also filed a pair of trademark applications for mail order and retail stores services that same day.

19. In or about February 1998, Applicant filed an additional twenty-two trademark applications for a variety of other merchandise. These subsequent applications were also filed in pairs - one application for the Applicant's logo and one application for the word mark MINNESOTA WILD.

20. Applicant's food and beverage applications were multi-class applications filed in International Classes 29, 30 and 33. The applications described the goods as follows:

Food Products, Including Jelly in International Class 29; Syrup, Honey, Rice and Pancake Mixes in International Class 30; Alcoholic Beverages, Including Wine in International Class 33.

All of Applicant's other trademark applications were filed as single class applications.

21. Applicant submitted actual product labels for International Classes 30 and 33 for its food and beverage trademark application. For International Class 29, however, Applicant did not submit a product label from one of its many jars of jelly, but instead submitted a "sticker" which bore nothing more than the Applicant's logo.

22. Applicant's jelly labels use the terms "Minnesota" and "wild" descriptively.

23. The examining attorney for Applicant's food and wine trademark applications initially refused registration. The basis for the examining attorney's refusal for the word mark is stated in a June 18, 1998 office action:

The examining attorney refuses registration on the Principal Register because the mark is primarily geographically descriptive of the applicant's goods. Trademark Act Section 2(e)(2), 15 U.S.C. Section 1052(e)(2); TMEP section 1210.05.

The primary significance of the term "Minnesota" is geographic, and applicant's goods come from the geographic place named in

the mark. Therefore, a public association of the goods with the place is presumed. *In re California Pizza Kitchen*, 10 USPQ2d 1704 (TTAB 1989); *In re Handler Fenton Westerns, Inc.*, 214 USPQ 848 (TTAB 1982).

The addition of a generic or highly descriptive term to a geographic term does not obviate a determination of geographic descriptiveness. *In re BankAmerica Corp.*, 231 USPQ 873 (TTAB 1986); *In re Cambridge Digital Systems*, 1 USPQ2d 1659 (TTAB 1986). The term "wild" describes a characteristic of the goods, specifically, the rice which can be a variety known as wild rice.

24. In Applicant's separate application to register its logo, the examining attorney requested that Applicant "disclaim" any rights in "MINNESOTA" or "WILD" apart from the mark as shown. The disclaimer suggested by the examining attorney was "No claim is made to the exclusive right to use MINNESOTA WILD apart from the mark as shown."

25. Upon information and belief, Applicant's attorney telephoned the examining attorney to discuss the office action. On or about June 29, 1998, Applicant filed a written response to the office action. Applicant's response to the office action contained two representations that were necessarily material to the examining attorney's decision to allow the applications. First, Applicant "amend[ed] its application to claim acquired distinctiveness of the 'MINNESOTA' portion of its mark under Section 2(f) of the Lanham Act." 15 U.S.C. § 1052(f).

26. Applicant's president has admitted in his deposition taken in the Lawsuit between the parties, however, that he has no claim to trademark ownership rights in the word "MINNESOTA."

Q You would not personally contend that you have the ownership rights to the name Minnesota, though, would you?

A To Minnesota? No.

J. Erckenbrack Depo. p. 138.

27. The second material misrepresentation that the Applicant, through its attorney, made to the examining attorney was that "the term 'wild' is not merely descriptive of the food products remaining in the description of goods." Applicant had deleted "rice" from its description of goods because "wild" is generic for wild rice.

28. Applicant's jelly labels, which were never submitted to the USPTO, refer to the "wild" ingredients of Applicant's goods. The labels further refer to the geographic origin of the goods as the "Wilds of Minnesota."

29. Applicant's claim of acquired distinctiveness under Section 2(f) of the Trademark Act was knowingly false because Applicant has admitted that it does not have exclusive right to "Minnesota."

30. Applicant's 2(f) claim of acquired distinctiveness is, as a matter of law, an admission that the matter claimed is not inherently distinctive.

31. Applicant's president, Jay Erckenbrack, submitted a verified declaration to the USPTO under penalty of perjury that the term "MINNESOTA" alone had become distinctive of his goods. Erckenbrack's declaration asserted:

The term MINNESOTA as appearing in Applicant's mark has become distinctive of Applicant's "food products, namely, jellies" in International Class 29; "table syrup, maple syrup, fruit syrups, honey, and pancake mixes" in International Class 30; and "alcoholic beverages, namely, wine" in International Class 33; through Applicant's substantially exclusive and continuous use in commerce in connection with the goods listed in International Classes 29 and 30 for at least five years immediately before the date of this statement.

32. Applicant has not asserted acquired distinctiveness as to the entire mark. The claim of acquired distinctiveness is in the word "Minnesota" alone. As such, Applicant is

asserting that "Minnesota" itself, separate and apart from the remainder of the mark, is distinctive of Applicant's goods.

33. Applicant had conducted a full Thomson & Thomson trademark search on or about January 28, 1998, well prior to its 2(f) declarations. That search revealed numerous other companies using "Minnesota" on food, beverages and clothing. Applicant did not disclose this information to the examining attorney.

34. In addition to the numerous other food product references in the search, the search revealed a federal trademark registration for BYERLY'S MINNESOTA and design (Reg. No. 1,231,243)(a true and correct copy of the TESS printout for this registration is attached hereto as Exhibit 2) registered in 1983 for "food gift packs consisting of meat, cheese, **jams and jellies...**" (emphasis added). The applicant for that mark properly agreed to disclaim "MINNESOTA" apart from the mark as shown.

35. Applicant's own goods are sold at Byerly's stores and have been included in Byerly's gift packs. In addition, Applicant's law firm is the same firm that obtained the BYERLY'S MINNESOTA registration. Accordingly, there was no proper basis for Applicant's assertion that it has made exclusive use of the term "MINNESOTA." In fact, as noted above, Applicant's president has conceded in sworn testimony that Applicant lacks ownership rights in "MINNESOTA."

36. The Court of Customs and Patent Appeals, ruling specifically on a claim of acquired distinctiveness for the geographic term "Minnesota," has held that "in view of the obviously geographical nature of the word "Minnesota" and the fact that it has been widely applied to various goods by both parties involved in these proceedings, a mere affidavit by an applicant for registration asserting a conclusion as to the exclusive use of the word as a

trademark is not a sufficient compliance with the provisions of 2(f).” Minnesota Mining & Manufacturing v. Minnesota Linseed Oil Paint Co., 108 USPQ 314, 321 (Court of Cust. & Pat. App. 1956); see Bruce Foods Corp. v. B.F. Trappey’s Sons, Inc., 192 USPQ 725, 728 (TTAB 1976)(company could not claim trademark rights in “LOUISIANA” for hot sauce despite forty years of use where its use had not been exclusive).

37. Applicant submitted similar 2(f) declarations in support of each of its twenty-six trademark applications. The dependence of Applicant’s trademark claims on its food and wine products and sales is admitted by Applicant in its trademark applications for other goods. In each of its other trademark applications Applicant’s 2(f) declarations admit the dependence on Applicant’s food and wine business. Those declarations state as follows:

2. The term MINNESOTA, as appearing in Applicant’s mark, has become distinctive of Applicant’s retail gift shop services and mail order and telephone order services featuring specialty foods, gifts, and clothing through Applicant’s substantially exclusive lawful and continuous use in commerce in connection with those services for at least the five years immediately before the date of this statement.

3. Applicant believes that this previously created distinctiveness will transfer to Applicant’s use of the term MINNESOTA in connection with the [goods] described in the present application.

Applicant has conceded that any claim of trademark rights in any other goods only arise through its prior food and wine business.

38. In the trademark application that is the subject of this opposition filing, the examining attorney required a disclaimer of “Minnesota” apart from the mark as shown.

39. By Examiner’s Amendment, Applicant claimed acquired distinctiveness under Section 2(f) in part for the term “Minnesota.” Applicant asserted that the term “Minnesota” had

become distinctive of its goods as evidenced by ownership of U.S. Registration No. 2,441,734 on the Principal Register for the same mark for related goods.

40. Even if Applicant's 2(f) claim was not intentionally false, that claim is an admission that the portion of the mark that is the subject of the claim is not inherently distinctive.

41. Had the examining attorney been provided an actual jelly jar label that Applicant used, the descriptiveness of the mark would have been apparent. Applicant's jelly jars all used the term "MINNESOTA WILD" descriptively to identify the contents of the jar. The jelly jars each contained the following descriptive product names:

PURE MINNESOTA WILD HAWTHORN JELLY
PURE MINNESOTA WILD PLUM JELLY
PURE MINNESOTA WILD ROSEHIP JELLY
PURE MINNESOTA WILD CHOKECHERRY JELLY
PURE MINNESOTA WILD HIGHBRUSH CRANBERRY JELLY
PURE MINNESOTA WILD GRAPE JELLY
PURE MINNESOTA WILD PLUM JELLY

In addition, each of the labels contained the following descriptive language:

MN WILD™ SYRUPS, JELLIES, SAUCES AND JAMS . . .
Hand Harvested from the pristine wilderness of Minnesota, all of our Wild Berry products are of the highest quality – the best that Nature has to offer. Subject to the whims of nature, the availability of our wild products will vary each year, according to their natural growing cycles.
As we harvest from the abundant, wild foods of Minnesota, it will always be our goal to bring you the very best of . . . Minnesota Wild.™

42. Upon information and belief, Applicant intentionally misled the examining attorney by not submitting one of its actual jelly jar labels, and this action by Applicant had a material impact in the examining attorney's review of the application and the eventual issuance of the trademark registration.

43. The overwhelming majority of Applicant's business stems from its food and wine sales. The registration procured for these goods forms the basis of Applicant's 2(f) claim in this application and Applicant's flawed claim to trademark rights.

44. Applicant admits in its trademark applications for the remaining goods that its claim to trademark rights stem from its prior food and wine business.

45. Because Applicant's claim to trademark rights in the food and wine products fails, its claim to rights in other goods that are complementary and subordinate to those goods must also necessarily fail.

WHEREFORE, Opposer Minnesota Wild Hockey Club, LP respectfully requests that the application of Minnesota Specialty Crops to register the mark MINNESOTA WILD for the goods described in the application be refused.

**LEONARD, STREET AND DEINARD
PROFESSIONAL ASSOCIATION**

By: 

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I hereby certify that this paper and fee is being deposited with the United States Postal Services "Express Mail Post Office to Addressee" service under 37 CFR §1.10 on the date indicated above and is addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Box TTAB Fee, Arlington, VA 22202-3513.



Eric D. Paulsrud

UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA

MINNESOTA SPECIALTY CROPS,
INC.,

Civil No. 00-2317 (JRT/FLN)

Plaintiff,

v.

MEMORANDUM OPINION AND
ORDER

MINNESOTA WILD HOCKEY CLUB,
LP and NHL ENTERPRISES, LP,

Defendants.

Peter M. Lancaster and Gregory M. Krakau, DORSEY & WHITNEY LLP,
50 South Sixth Street, Suite 1500, Minneapolis, MN 55402, for plaintiff.

Lorin J. Reisner and Christopher J. Klatell, DEBEVOISE & PLIMPTON,
919 Third Avenue, New York, New York 10022 and Frederick W. Morris
and Timothy P. Griffin, LEONARD, STREET AND DEINARD, PA, 150
South Fifth Street, Suite 2300, Minneapolis, MN 55402, for defendants.

Plaintiff Minnesota Specialty Crops ("MSC") has sued defendants, the Minnesota Wild Hockey Club and NHL Enterprises, for infringement of MSC's rights in the trademark MINNESOTA WILD. Specifically, MSC is suing for the following: trademark infringement under § 32 of the Lanham Act, 15 U.S.C. § 1114(1); unfair competition and common law trademark infringement under § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a); infringement of common law trademark rights; violation of the

FILED
RICHARD D. SLETTEN, CLERK
JUDGMENT ENTD.
DEPUTY CLERK

EXHIBIT 1

Notice of Opposition

Mark: MINNESOTA WILD (Appl. No. 76-265,943)

Applicant: Minnesota Specialty Crops, Incorporated

Opposer: Minnesota Wild Hockey Club, LP

Minnesota Uniform Deceptive Trade Practices Act, Minn. Stat. § 325D.44; and common law unfair competition.

MSC seeks: (1) an injunction preventing defendants from using MINNESOTA WILD on any food or beverages or with respect to sales within grocery stores, liquor stores, or food/beverage trade shows that would cause confusion with MSC's mark; (2) an injunction preventing defendants from using MINNESOTA WILD in a way that would cause confusion in MSC's "market area;" (3) a declaration that MSC possesses prior common law trademark rights in MINNESOTA WILD for food, beverages, clothing, and retail stores within its market territories; and (4) an accounting and payment of defendants' profits attained as a result of the alleged infringement. The Hockey Club counterclaimed, seeking declaratory judgment that it has the right to use MINNESOTA WILD in connection with its goods and services.

This matter is now before the Court on three motions: (1) defendants' motion to exclude testimony by MSC's expert, Dr. Ivan Ross; (2) defendants' motion for summary judgment; and (3) MSC's motion for partial summary judgment to establish its trademark rights and to dismiss certain of defendants' affirmative defenses. For the reasons discussed below, the Court denies defendants' motion to exclude plaintiff's expert, grants defendants' motion for summary judgment in part and denies it in part, and grants plaintiff's motion for partial summary judgment in part and denies it in part.

BACKGROUND

Plaintiff MSC is a corporation based in McGregor, Minnesota. Since 1990, MSC has produced a variety of specialty food products that incorporate native and "wild" Minnesota plants and berries, including jams, jellies, and wines. MSC also sells clothing and other novelty items bearing its MINNESOTA WILD mark and logo. These products are sold through the company's catalog, its retail store in McGregor, gift shops, liquor stores, and grocery stores. In 2000, MSC's total sales of food and wine products was \$559,992.69, and its total sales of "miscellaneous taxable" items (key chains, stickers, etc.) was \$31,364.99. MSC does not have total figures for its sales of clothing. MSC's MINNESOTA WILD mark consists of the words "Minnesota Wild" in block capital letters, along with its "tall trees" logo, featuring a picture of pine trees.

Defendant Minnesota Wild Hockey Club ("Hockey Club" or "Club") is a professional hockey franchise based in St. Paul, Minnesota, and is a member of the National Hockey League ("NHL"). Defendant NHL Enterprises is responsible for the licensing and protection of marks and logos belonging to the NHL and its member clubs. In order to promote itself, the Hockey Club sells a range of merchandise bearing the team's mark. The Hockey Club has used two marks that incorporate the words "Minnesota Wild:" the outline of an animal head, with an inset of a sun, sunset, stream, and trees, and a logo featuring the word "Minnesota" in symmetrical capital letters, next to the word "wild" in stylized script.

In August 1997, the Hockey Club's management was in the process of selecting a name for the team, and determined that "Minnesota Wild" was its leading choice. The

Club ordered a trademark search in various categories of products traditionally associated with NHL teams. The search report, which examined records from the U.S. Patent and Trademark Office ("PTO"), common law databases, and other on-line sources, did not find any reference to MSC or its use of MINNESOTA WILD. In November 1997, WHC publicized six potential names for the team, including "Minnesota Wild."

The Hockey Club claims it learned in late 1997 that MSC was using the mark MINNESOTA WILD for its products. The Club states it then consulted trademark counsel, who assured the Club's management that MSC's use of MINNESOTA WILD would not cause a likelihood of confusion, and that the Hockey Club's use of the name would be lawful.

On January 28, 1998, the Hockey Club publicly announced that the team's name would be the "Minnesota Wild." The same day, MSC sent a letter to the Club, objecting to its use of MINNESOTA WILD and claiming infringement of MSC's trademarks. The Hockey Club claims that upon receiving this objection, it consulted again with attorneys, who assured management that the Hockey Club's name was legal and proper.

Beginning in January 1998, MSC applied for several federal trademark registrations from the PTO. Over the course of 2000 and 2001, MSC received federal trademark registrations for its word and "tall trees" marks for wine, jellies, syrups, honey, and pancake mixes. MSC also received federal registration of the "tall trees" mark for a variety of gift items. The Hockey Club opposed MSC's applications for registration of its word mark for these gift items, and the opposition proceedings have been suspended pending the outcome of this lawsuit.

ANALYSIS

Defendants' Motion to Exclude Expert Testimony

Defendants oppose admitting the testimony and survey of Dr. Ivan Ross, claiming that the survey is seriously flawed, would not be helpful to the trier of fact, and would violate the spirit of *Daubert v. Merrell Dow Pharmaceuticals*, 509 U.S. 579 (1993).¹ Defendants point to many alleged flaws in the study, arguing that the composition of the sample, the tone and content of the questions, and the method of tabulation all favor MSC. Defendants cite numerous cases in which courts have excluded surveys due to errors similar to those that allegedly plague Dr. Ross's report, but they cite no Eighth Circuit law in support of excluding the survey. (See Def. Mem. Supporting Motion to Preclude Expert Testimony at 2.)

In the Eighth Circuit, consumer confusion surveys are not generally excluded due to flaws in the survey. See *Insty*Bit, Inc. v. Poly-Tech Indus., Inc.*, 95 F.3d 663, 671 (8th Cir. 1996). Rather, technical flaws in consumer confusion studies should bear on the weight accorded them, not on their admissibility. *Id.*; *Conagra, Inc. v. George A. Hormel & Co.*, 990 F.2d 368, 370 (8th Cir. 1993) (affirming district court's decision to give a consumer survey less evidentiary weight due to its technical flaws); *SquirtCo v. Seven-Up Co.*, 628 F.2d 1086, 1091 (8th Cir. 1980). See also *Mutual of Omaha Ins. Co. v.*

¹ In *Daubert*, the Supreme Court held that determining the admissibility of expert scientific testimony "entails an assessment of whether the reasoning or methodology underlying the testimony is scientifically valid and of whether that reasoning or methodology properly can be applied to the facts in issue." *Daubert v. Merrell Dow Pharmaceuticals*, 509 U.S. 579, 592-93 (1993).

Novak, 836 F.2d 397, 400-01 (8th Cir. 1988) (holding that a properly conducted survey should be given substantial weight).

Defendants make several allegations about Dr. Ross's survey, which, if true, would seriously undermine his credibility. MSC likewise offers explanations which, if true, would demonstrate that some deficiencies are inevitable, while other alleged deficiencies are in fact strengths. The relative merits of each argument can be borne out on cross-examination, with credibility determinations and weighing of the evidence left to the trier of fact. See generally J. Thomas McCarthy, *5 McCarthy on Trademarks* § 32:178 (4th ed.) ("The proper approach is to view [survey] evidence with some understanding of the difficulty of devising and running a survey and to use any technical defects only to lessen evidentiary weight, not to reject the results out-of-hand.") Therefore, the Court will deny defendants' motion to exclude Dr. Ross's testimony.

Motions for Summary Judgment

I. Standard of Review

Rule 56(c) of the Federal Rules of Civil Procedure provides that summary judgment "shall be rendered forthwith if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Fed. R. Civ. P. 56. Only disputes over facts that might affect the outcome of the suit under the governing substantive law will properly preclude the entry of summary judgment. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248

(1986). Summary judgment is not appropriate if the dispute about a material fact is genuine, that is, if the evidence is such that a reasonable jury could return a verdict for the nonmoving party. *Id.* Summary judgment is to be granted only where the evidence is such that no reasonable jury could return a verdict for the nonmoving party. *Id.*

The moving party bears the burden of bringing forward sufficient evidence to establish that there are no genuine issues of material fact and that the movant is entitled to judgment as a matter of law. *Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986). The nonmoving party is entitled to the benefit of all reasonable inferences to be drawn from the underlying facts in the record. *Vette Co. v. Aetna Casualty & Surety Co.*, 612 F.2d 1076, 1077 (8th Cir. 1980). However, the nonmoving party may not merely rest upon allegations or denials in its pleadings, but it must set forth specific facts by affidavits or otherwise showing that there is a genuine issue for trial. *Burst v. Adolph Coors Co.*, 650 F.2d 930, 932 (8th Cir. 1981).

II. Defendants' Motion for Summary Judgment

To succeed on its claims of trademark infringement under the Lanham Act,² MSC must show that it had a protected common law trademark in MINNESOTA WILD, and that defendants' use of the mark is likely to confuse consumers as to the source of MSC's products. *Hubbard Feeds, Inc. v. Animal Feed Supplement, Inc.*, 182 F.3d 598, 601 (8th

² The parties make no distinction between the Lanham Act and the Minnesota Uniform Deceptive Trade Practices Act in their supporting memoranda, and address MSC's claims together under the Lanham Act and the judicial opinions interpreting it. The Court accordingly addresses both motions under the Lanham Act.

Cir. 1999); *Co-Rect Products, Inc. v. Marvy! Advertising Photography, Inc.*, 780 F.2d 1324, 1330 (8th Cir. 1985). Defendants argue that MSC cannot demonstrate its rights to MINNESOTA WILD because it cannot prove secondary meaning, and that MSC cannot demonstrate a likelihood of confusion. MSC argues that its MINNESOTA WILD mark is inherently distinctive, and alternatively that it need not show any additional proof of secondary meaning, because its mark is federally registered. MSC further argues that even if it cannot rely on a presumption of secondary meaning, the mark has acquired secondary meaning through years of use. MSC also contends that there is a significant likelihood of confusion between its MINNESOTA WILD mark and that of defendants.

A. Secondary Meaning

1. Inherent Distinctiveness and Presumptions

The Lanham Act protects only distinctive marks. *Co-Rect Prod.*, 780 F.2d at 1329. To determine whether a mark is distinctive, courts generally place the mark in one of four categories: generic, descriptive, suggestive, or arbitrary. *Id.*

“Marks which are merely descriptive of a product are not inherently distinctive. When used to describe a product, they do not inherently identify a particular source, and hence cannot be protected. However, descriptive marks may acquire the distinctiveness which will allow them to be protected under the [Lanham] Act. . . . This acquired distinctiveness is generally called “secondary meaning.”

Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 769 (1992). The Court must first address whether MSC’s MINNESOTA WILD mark is inherently distinctive, or whether it can be presumed to have secondary meaning. If either of these is true, MSC need not

produce any additional evidence of secondary meaning for purposes of summary judgment.

MSC applied for its first federal trademark registrations in January 1998. The PTO initially rejected these registrations in June 1998 because "Minnesota" described the geographical origins of MSC's products, and "wild" described the characteristics of MSC's wild rice products. (See Second Palsrud Dec. Ex. D.) MSC responded by amending its application and offering proof under § 2(f) of the Lanham Act that the word "Minnesota" had acquired secondary meaning.³ MSC also requested that rice be removed from the products covered by the mark. (Second Palsrud Dec. Ex. G.) The PTO's examining attorney apparently approved these amendments, and the mark was eventually registered.

MSC first contends that its mark is inherently distinctive, because the PTO accepted its registration for MINNESOTA WILD without proof of secondary meaning. In support, MSC notes that the PTO did not require proof of secondary meaning for the word "wild," and required proof of secondary meaning only for "Minnesota." The Court rejects this reasoning, and finds no evidence to support MSC's claim. The record demonstrates that the PTO agreed to register MINNESOTA WILD only after seeing

³ Section 2(f) of the Lanham Act provides in relevant part:

The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made.

15 U.S.C. § 1052(f)

proof under § 2(f) that the word "Minnesota" had acquired secondary meaning. Clearly, the complete mark could not have been registered without the component "Minnesota." The Court finds implausible MSC's argument that because one portion of the mark caused no problems, the entire mark is inherently distinctive. Indeed, submission of material under § 2(f) "amounts to a concession" that the mark is not inherently distinctive. *Aromatique, Inc. v. Gold Seal*, 28 F.3d 863, 869 (8th Cir. 1994); *McCarthy on Trademarks and Unfair Competition* § 15:68.

MSC seems to argue that because the PTO reversed its initial decision to require a disclaimer for "wild," the entire mark must be inherently distinctive. This conclusion is also incorrect. It is "inappropriate to give the presence or absence of a disclaimer [on a trademark] any legal significance." *In re National Data Corp.*, 753 F.2d 1056, 1059 (Fed. Cir. 1985) (noting that PTO's power to require disclaimers is discretionary and its practice in this regard has been inconsistent). Indeed, "the absence of a disclaimer does not . . . mean that a word or phrase in a registration is, or has become, distinctive in the registered mark. . . ." *Id.* Thus, MSC may not rely on its PTO registration even to show that the word "wild" is inherently distinctive, much less the entire MINNESOTA WILD mark. The Court finds no evidence to support MSC's argument that the PTO accepted its mark as inherently distinctive.

MSC next argues that because its MINNESOTA WILD mark is federally registered, it may rely on a presumption that the mark has acquired secondary meaning. Defendants argue that MINNESOTA WILD is descriptive, evoking the geographical

origin and characteristics of MSC's products, and therefore MSC must present evidence of secondary meaning.

Registration of a mark with the PTO creates a rebuttable presumption that the mark is valid and has secondary meaning. *Aromatique*, 28 F.3d at 869; 15 U.S.C. § 1115(a). In cases where the PTO did not accept the mark as inherently distinctive, but accepted proof of acquired secondary meaning under § 2(f), "the timing of the effectiveness of that presumption is crucial." *Aromatique*, 28 F.3d at 870. In such cases, the presumption operates only after the registrations become effective. *Id.* Here, as in *Aromatique*, the PTO's examining attorney rejected MSC's mark as descriptive, and MSC obtained registration by presenting evidence of secondary meaning pursuant to § 2(f).⁴ It appears that the earliest date on which an MSC patent became effective was March 7, 2000. (See Krakau Dec. in Support of Pl. Motion Ex. D.) It is undisputed that the Hockey Club announced its name to be the "Minnesota Wild" several months earlier, on January 22, 1998. Accordingly, MSC's mark is presumed to acquire secondary meaning only as of March 7, 2000. *Id.* Defendants' use of MINNESOTA WILD prior to MSC's registration is therefore sufficient to prevent MSC from entitlement to any presumption of secondary meaning. *Co-Rect Prod.*, 780 F.2d at 1330 ("The user must ... show that secondary meaning existed prior to the date on which the defendant commenced using the same or similar mark.").

⁴ As discussed above, the Court finds it of no import that the PTO required proof of secondary meaning for "Minnesota," but not for "wild." It is clear that without some proof of secondary meaning, MSC would not have received its registration for MINNESOTA WILD.

The Court therefore determines that MSC may rely on no presumptions of secondary meaning for purposes of these motions. Accordingly, MSC must present evidence of secondary meaning.

2. Evidence of Secondary Meaning

To establish secondary meaning, MSC must show that through "long and exclusive use and advertising in the sale of the user's goods, the mark has become so associated in the public mind with such goods that it serves to identify the source of the goods and to distinguish them from the goods of others." *First Bank v. First Bank System, Inc.*, 84 F.3d 1040, 1045 (8th Cir. 1996); *Co-Rect Prod.*, 780 F.2d at 1330. "The primary inquiry in determining whether [a] mark has attained secondary meaning is whether the mark has become associated with a particular source in the consumer's mind." *First Bank*, 84 F.3d at 1045; *Co-Rect Prod.*, 780 F.2d at 1332-33.

Defendants argue that MSC's MINNESOTA WILD mark has not attained secondary meaning because it has not become associated with MSC in consumers' minds. Defendants claim that MSC has produced no direct evidence that consumers have ever identified MINNESOTA WILD with MSC. MSC argues that its mark has acquired secondary meaning through years of use. MSC also contends that in a "reverse confusion" case such as this,⁵ the evidentiary burden upon a smaller, senior user to

⁵ "Reverse confusion occurs when a larger, more powerful company uses the trademark of a smaller less powerful senior owner and thereby causes likely confusion as to the source of the senior user's goods or services." *Mars Musical Adventures, Inc. v. Mars, Inc.*, 159 F. Supp. 2d 1146, 1149 (D. Minn. 2001) (quoting *Rainforest Café, Inc. v. Amazon, Inc.*, 86 F. Supp. 2d 886, 897 (D. Minn. 1999) (quotation marks omitted)). See also *Fisons Horticulture, inc. v. Vigoro Indus., Inc.*, 30 F.3d 466, 474 (3d Cir. 1994).

establish secondary meaning is somewhat lower than in normal cases. See *Commerce Nat'l Ins. Serv., Inc. v. Commerce Ins. Agency, Inc.*, 214 F.3d 432, 444 (3d Cir. 2000).

As an initial matter, the Court rejects MSC's contention that the evidentiary burden is reduced in a reverse confusion case. It is unclear, first of all, whether the Eighth Circuit has adopted the doctrine of reverse confusion, as only one Court of Appeals case even mentions the doctrine (albeit approvingly). See *Minnesota Pet Breeders, Inc. v. Schell & Kampeter, Inc.*, 41 F.3d 1242, 1246 (8th Cir. 1994). Second, even if this Court determines that the Eighth Circuit has adopted the reverse confusion doctrine generally, no district court or appeals panel in the Eighth Circuit has discussed the doctrine as it pertains to secondary meaning.⁶ Therefore, the Court concludes that MSC must meet the traditional standard of proof for secondary meaning.

"As evidence that a mark has acquired secondary meaning, courts will accept direct evidence of customer confusion, or because direct evidence may be difficult to find, evidence from consumer surveys showing likelihood of confusion." *Cellular Sales, Inc. v. MacKay*, 942 F.2d 483, 486 (8th Cir. 1991). Other factors that may be considered include advertising, amount of sales, established place in the market, and proof of intentional copying. *Stuart Hall Co., Inc. v. Ampad Corp.*, 51 F.3d 780, 789 (8th Cir. 1995); *McCarthy on Trademarks* § 15:30.

⁶ Only five other courts have discussed the reverse confusion doctrine. See *Mars Musical Adventures*, 159 F. Supp. 2d at 1149-50; *Rainforest Cafe*, 86 F. Supp. 2d at 897-98; *Dream Team Collectibles, Inc. v. NBA Properties, Inc.*, 958 F. Supp. 1401, 1408 (E.D. Mo. 1997); *Minnesota Pet Breeders, Inc. v. Schell & Kampeter, Inc.*, 843 F. Supp. 506, 512 n.5 (D. Minn. 1993); *Scott v. Mego Int'l, Inc.*, 519 F. Supp. 1118, 1136 n.21 (D. Minn. 1981).

MSC presents no direct evidence that consumers identify MINNESOTA WILD with MSC. It does present evidence, in the form of affidavits from its owner Jay Erckenbrack, that MSC used the mark for eight years throughout Minnesota before the Hockey Club arrived, that MSC has spent more than \$180,000 promoting its mark, and that MSC's brand has received media attention in Minnesota. Although advertising is a "relevant factor in determining whether a mark has acquired a secondary meaning, it is the effect of such advertising that is important, not its extent." *Co-Rect Prod.*, 780 F.2d at 1332 (emphasis original). Although MSC has devoted much discussion to its media attention and advertising, it has produced no evidence that this advertising has led consumers to identify MINNESOTA WILD with MSC. MSC has presented sales figures, but these do not demonstrate that consumers identify MINNESOTA WILD with MSC. MSC has also presented evidence of its established place in the market. This evidence, however, comes from the declarations of MSC's owner, Mr. Erckenbrack, or from other MSC employees. This type of testimony is not sufficient to establish secondary meaning. *See id.* at 1333 ("More is needed to establish [secondary meaning] than merely the self-serving testimony of the plaintiff that some of his customers were confused."). MSC also presents no evidence that the Hockey Club intentionally copied its mark. Although MSC does allege that the Hockey Club knew of its mark when it announced the team name, MSC offers no proof that the team attempted to pass off its products as those of MSC. *See Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654, 663 (7th Cir. 1995) ("Copying is only evidence of secondary meaning if the defendant's intent in copying is to confuse consumers and pass off his product as the plaintiff's."); *Yankee*

Candle Co., Inc. v. Bridgewater Candle Co., LLC, 259 F.3d 25, 45 (1st Cir. 2001) (“[T]he relevant intent is not just the intent to copy, but to ‘pass off’ one’s goods as those of another.”)

Finally, MSC presents as evidence the consumer survey conducted by Dr. Ross. Although this survey is directed at likelihood of confusion, not secondary meaning, the Court may consider the results that present evidence of secondary meaning. *See Stuart Hall*, 51 F.3d at 789 (holding that even though a consumer survey focuses on confusion, a district court “should also examine whether the survey evidence contributes to a showing of secondary meaning”); *Cellular Sales*, 942 F.2d at 486 (holding that courts may accept “evidence from consumer surveys showing likelihood of confusion” to show secondary meaning); *Co-Rect Prod.*, 780 F.2d at 1333 (stating that evidence of confusion can also be evidence of secondary meaning).⁷

As discussed below in Part II.B.5, this survey presents evidence of actual confusion. Although MSC presents little additional evidence of secondary meaning, the survey’s evidence of actual confusion creates a sufficient issue of material fact to defeat defendants’ motion for summary judgment. *See McCarthy on Trademarks* § 15:11 (“If

⁷ Defendants repeatedly argue that MSC’s failure to conduct a “secondary meaning survey” should lead to summary judgment. In the cases that defendants cite, the plaintiffs presented no survey evidence of any kind. *See Cellular Sales, Inc. v. MacKay*, 942 F.2d 483, 486 (8th Cir. 1991) (finding that “no survey or any other evidence has been shown” to establish secondary meaning); *Jeld-Wen, Inc. v. Dalco Indus., Inc.*, 1999 WL 1024002 at *3 (8th Cir. Nov. 10, 1999) (noting that “[p]laintiff presented no customer surveys or any other evidence from third-party witnesses that customers” associated plaintiff with the mark in question). Here, however, *Cellular Sales* prevents MSC’s failure to conduct a survey from being fatal to its case. *See Cellular Sales*, 942 F.2d at 486 (holding that courts may accept “evidence from consumer surveys showing likelihood of confusion” as evidence of secondary meaning).

there is some customer confusion in fact, then it follows that there must also be some secondary meaning.”). Therefore, for purposes of this motion, the Court concludes that MSC has produced sufficient evidence of secondary meaning.

B. Likelihood of Confusion

The Court considers six factors to determine whether MSC has demonstrated likelihood of confusion: (1) the strength of MSC’s mark; (2) the similarity between MSC’s mark and that of defendants; (3) the degree of competition between the products; (4) the defendants’ intent to “pass off” their goods as MSC’s; (5) incidents of actual confusion; and (6) overlap in the channels of commerce. *Luigino’s, Inc. v. Stouffer Corp.*, 170 F.3d 827, 830 (8th Cir. 1999).

1. Strength of the Mark

MSC argues that because this is a case of “reverse confusion,” the strength analysis must be modified. Instead of analyzing the strength of its senior mark, MSC argues, the Court should examine the strength of defendants’ junior mark to see if it could overwhelm MSC’s smaller, senior mark. As discussed above, the Eighth Circuit has not explicitly adopted the doctrine of reverse confusion. Although some district courts have discussed the doctrine, none of them has analyzed strength in the way MSC proposes. These courts have modified the strength analysis, however, analyzing the strength of the senior mark at the time of the alleged infringement (in this case, January 1998, when the Hockey Club announced its name), rather than on the basis of the strength resulting from the allegedly infringing use. *See Mars Musical Adventures, Inc. v. Mars, Inc.*, 159 F.

Supp. 2d 1146, 1150 (D. Minn. 2001); *Rainforest Café*, 86 F. Supp. 2d at 898; *Dream Team Collectibles, Inc. v. NBA Properties, Inc.*, 958 F. Supp. 1401, 1411-12 (E.D. Mo. 1997). See *Fisons Horticulture, Inc. v. Vigoro Indus.*, 30 F.3d 466, 478 (3d Cir. 1994).

To determine the strength of MSC's mark, the Court must classify it as either generic, descriptive, suggestive, or arbitrary. *Duluth News-Tribune v. Mesabi Publishing Co., Inc.*, 84 F.3d 1093, 1096 (8th Cir. 1996). As discussed above, MSC's mark should be classified as "descriptive," because it was only able to obtain PTO registration by showing proof of secondary meaning under § 2(f) of the Lanham Act. MSC's registrations did not become effective until March 7, 2000 at the earliest. Therefore, at the time of the alleged infringement, January 1998, MSC's mark could only be described as descriptive, and therefore relatively weak.

2. Similarity

Next, the Court must examine whether the two MINNESOTA WILD marks are similar. The Court determines that they are not. MSC notes that the marks are similar because they use the exact same wording, and that both logos incorporate trees. "Rather than consider the similarities between the component parts of the marks," however, the Court must "evaluate the impression that each mark in its entirety is likely to have to a purchaser exercising the attention usually given by purchasers of such products." *Id.* at 1097. Although the marks do have features in common, the Court finds that the marks are not similar. Upon evaluating the impression that each mark gives, the Court determines that a customer who usually purchases hockey-related products would not get the impression that MSC's merchandise comes from the Hockey Club, and that a

purchaser of wild food products and merchandise would not believe that the hockey-related products come from MSC.

3. Degree of Competition

The Court next determines that the products of MSC and plaintiff do not compete with each other in the marketplace. MSC claims that because both parties produce some of the same products, such as t-shirts, stickers, key chains, etc., they do compete with each other. MSC also asserts that the parties compete because MSC produces wine, while the Hockey Club has sponsorships with beer companies. The record makes abundantly clear that MSC's products are sold and associated with gourmet foods and other Minnesota cultural products, while the Hockey Club's products are sold and associated with professional hockey. The Court finds it unreasonable to assert that merely because both parties sell t-shirts, or have associations with alcoholic beverages (i.e., MSC produces plum wine while the Hockey Club has a sponsorship relationship with Bud Light beer), they must be in competition.

4. Intent to "Pass Off"

MSC argues that the standard for "intent to pass off" must also be modified in reverse confusion cases. MSC contends that the Court should find intent to pass off if "despite acting innocently, [the Hockey Club] was careless in not conducting proper research to avoid infringement prior to development of [MSC's] trademark." *Mars Musical Adventures*, 159 F. Supp. at 1152. Several district courts in the Eighth Circuit have adopted this standard, which comes from the Third Circuit's decision in *Fisons*

Horticulture. See 30 F.3d at 478. See also *Mars Musical Adventures*, 159 F. Supp. 2d at 1152; *Rainforest Café*, 86 F. Supp. 2d at 900; *Dream Team Collectibles*, 958 F. Supp. at 1415. This Court declines to follow the *Fisons* standard, because the Third Circuit essentially abandoned it in *A & H Sportswear, Inc. v. Victoria's Secret Stores, Inc.*, 237 F.3d 198, 232-33 (3d Cir. 2000). In that case, the Third Circuit noted that "there is no reason to ascribe higher penalties to a lower degree of fault because a particular case involves reverse, rather than direct, confusion." *Id.* at 233. Accordingly, the court held that it was "reluctant to adopt [the] interpretation" that "mere carelessness, as opposed to deliberate intent to confuse, would weigh in a plaintiff's favor in a reverse confusion case." *Id.* at 232. This Court will therefore apply the traditional standard, and examine whether defendants intended to mislead consumers about the origin of its products. See *Luigino's*, 170 F.3d at 831; *First Nat'l Bank, In Sioux Falls v. First Nat'l Bank, South Dakota*, 153 F.3d 885, 888 (8th Cir. 1998). Under this standard, the Court finds that although MSC has presented evidence defendants may have known about MSC's mark, it has not shown that the Hockey Club intended to mislead or confuse customers.

5. Actual Confusion

Although courts must consider all the relevant factors when determining likelihood of confusion, evidence of actual confusion is "positive proof" of such likelihood. *SquirtCo*, 628 F.2d at 1091; *Northland Ins. Co. v. Blaylock*, 115 F. Supp. 2d 1108, 1121 (D. Minn. 2000). MSC has presented evidence of actual confusion in Dr. Ross's survey. See *Mutual of Omaha*, 836 F.2d at 400 (holding that survey evidence may serve as evidence of actual confusion). See also *Stuart Hall*, 52 F.3d at 790. As

noted above, defendants dispute the accuracy and reliability of this survey. Having already determined that the survey is admissible, the Court notes that the survey's accuracy and the weight it should receive are ultimately issues for the trier of fact to resolve. The Court now determines only that the survey results are sufficient to raise a genuine issue of material fact for the purposes of summary judgment.

6. Channels of Commerce

The Court determines that the overlap of the parties' products in the channels of commerce are minimal. The Hockey Club's products are targeted at people seeking hockey and sports merchandise, and are sold primarily at sports-related stores and venues. MSC's products are not targeted at these markets, but are intended to evoke a "country image of home-made products" and "the image of a trip to Grandma's house, where everything comes from just outside the back door." (Amended Compl. ¶ 8.) The Court concludes that even if the products are occasionally sold in the same stores, the fact that the parties aim for such different markets means that this factor does not appreciably contribute to any likelihood of confusion.

Having thus considered all the relevant factors, the Court concludes that MSC has demonstrated a likelihood of confusion, largely through its survey evidence. Because MSC has also produced evidence of secondary meaning, the Court will deny defendant's motion for summary judgment on the issues of trademark infringement.

C. Claim for Profits and Jury Demand

Finally, defendants argue that MSC's claim for profits should be dismissed, and its demand for a trial by jury stricken. MSC has not sought monetary damages beyond its claim for defendants' profits. (See Amended Compl. at 14-16.) An accounting of profits is available in an trademark infringement case only if the plaintiff proves "willful, deliberate infringement or deception." *Minnesota Pet Breeders*, 41 F.3d at 1247. See also Restatement (3d) of Unfair Competition § 37 (1995) (stating that accounting of profits is permitted only if the defendant intended to cause confusion or deception). As discussed above, the Court finds no evidence that the Hockey Club intended to mislead consumers into believing that its products originated with MSC. On the contrary, the record suggests that the Hockey Club knew of MSC's marks, but believed in good faith that its use would not infringe upon them. See Restatement (3d) of Unfair Competition § 37, Comment e (stating that an accounting of profits should be limited to cases with "acts intended to create confusion or to deceive prospective purchasers."). See also *McCarthy on Trademarks* § 30:62. The Court will therefore grant defendant's motion for summary judgment on the claim for profits.

All of MSC's remaining claims are clearly equitable, and the Court therefore also must grant defendant's motion to strike MSC's jury demand. Alternatively, even if MSC were allowed to pursue its claim for accounting of profits, MSC would not be entitled to a trial by jury on its accounting claim. MSC argues that the U.S. Supreme Court's decision in *Dairy Queen, Inc. v. Wood*, 369 U.S. 469 (1965) entitles it to a jury trial. In *Wood*, however, the Court noted that even though the claim was styled as an

“accounting,” it must really be construed as a contract action or as a claim for trademark damages. *Id.* at 476-77. The Court concluded that despite the claim’s self-imposed title, it was “wholly legal in its nature however the complaint is construed.” *Id.* at 477. In the present case, there is no dispute that the claim is purely an equitable claim for profits. Therefore, the Court grants defendants’ motion to strike MSC’s jury demand.

III. MSC’s Motion for Partial Summary Judgment

MSC seeks partial summary judgment to establish two main points: (1) that it owns valid and protectable trademark rights for MINNESOTA WILD; and (2) that defendants’ affirmative defenses are unsupported by evidence and should be dismissed.⁸

A. Trademark Rights

The issue of MSC’s trademark rights must be considered in light of the Court’s analysis in Part II of this Opinion. In order to obtain summary judgment on the question of its trademark rights, MSC would have to show, beyond any issue of material fact, that its mark was distinctive either inherently or by acquiring secondary meaning. The Court has already determined that MSC’s mark is not inherently distinctive, and that MSC cannot rely on any presumptions that its mark has acquired secondary meaning. *See* Part II.A.1. It is true that MSC has raised sufficient evidence to show a material dispute over whether its trademark rights are protectable, *see* Part II.A.2, but this is far from the showing needed to obtain summary judgment. The Court determines that there is a

⁸ The parties’ briefs also raised the issue of a trademark for WYLD. At oral argument it became apparent that the parties have abandoned this issue, and the Court considers it moot.

genuine issue of material fact on the question of whether MSC has protectable trademark rights in MINNESOTA WILD, and denies MSC's motion on this point.

B. Affirmative Defenses

MSC challenges the following affirmative defenses raised by defendants: waiver, acquiescence, estoppel, laches, and unclean hands. "Waiver requires evidence of a voluntary and intentional relinquishment or abandonment of a known right. . . ." *Haghighi v. Russian-American Broadcasting Co.*, 173 F.3d 1086, 1088 (8th Cir. 1999). Defendants base their waiver and acquiescence claims upon MSC's suggestions in the pleadings that it does not object to defendants using MINNESOTA WILD in connection with a Hockey Club. It is clear to the Court that MSC did not intend to relinquish its rights to MINNESOTA WILD in these statements, but that the statements were part of arguments that MSC's attempted in good faith to resolve the dispute. There is no evidence of waiver.

The defense of acquiescence requires proof of three elements: (1) that MSC actively represented that it would not assert a right or a claim; (2) that the delay between MSC's active representation and assertion of its right or claim was not excusable; and (3) that the delay caused defendant undue prejudice. *Coach House Restaurant, Inc. v. Coach and Six Restaurants, Inc.*, 934 F.2d 1551, 1558 (11th Cir. 1991); *McCarthy on Trademarks* § 31:41. Again, defendant has produced no evidence that MSC actively represented that it would not assert its claim. Indeed, defendants can hardly argue that MSC made such representations, when the statements that allegedly constitute

acquiescence are contained in pleadings of this very lawsuit. Therefore, like the affirmative defense of waiver, the acquiescence claim is without merit.

The defenses of estoppel and laches are interrelated and require only passive consent to use of an allegedly infringing mark. *Id.* To prevail on their estoppel defense, defendants must show that: (1) they were misled by MSC's conduct to believe that MSC did not intend to enforce its trademark; (2) they relied on that conduct; and (3) they will be materially prejudiced if MSC is permitted to enforce its trademark rights. *Minnesota Mining & Mfg. Co. v. Beautone Specialties Co., Ltd.*, 82 F. Supp. 2d 997, 1005 (D. Minn. 2000) (citing *A.C. Aukerman Co. v. R.L. Chaides Constr. Co.*, 960 F.2d 1020, 1041 (Fed. Cir. 1992) (en banc)). Defendants argue that because the finalist names for the Hockey Club were announced prior to January 22, 1998 – the date MSC sent its demand letter – MSC must have known about the potential for infringement, and MSC's delay in enforcing its rights should permit the defense of estoppel. This argument is without merit. Even if MSC knew that the Hockey Club was planning to choose "Minnesota Wild" as its name, MSC's choice to assert its rights on the day the official name was announced does not prove that defendants relied on MSC's conduct. Indeed, the record demonstrates that the Hockey Club's plans were never affected one way or another by MSC's MINNESOTA WILD mark. The Court finds no evidence that defendants relied upon MSC's action or inaction, and for that reason the affirmative defense of estoppel must fail.

Defendants point to the same factual basis for their laches claim. To prevail on this defense, defendants must demonstrate that: (1) MSC inexcusably delayed in asserting

its trademark claim; and (2) defendants suffered undue prejudice because of that delay. *Hubbard Feeds*, 182 F.3d at 601-02; *Minnesota Mining*, 82 F. Supp. 2d at 1003. Defendants note that they spent a great deal of time and money to develop the "Minnesota Wild" identity, and they were therefore prejudiced by MSC's decision to wait until the announcement day to proclaim its opposition. The Court cannot conclude that MSC's failure to oppose the Club's use of MINNESOTA WILD before it was certain of the infringement constitutes "inexcusable" delay, especially when MSC asserted its rights on the same day the name was announced. *See, e.g., Hubbard Feeds*, 182 F.3d at 602 (finding that laches applied when the plaintiff delayed asserting its rights for nine years). Therefore, the Court finds that MSC's delay is not sufficient to support its defense of laches.

The final affirmative defense at issue is that of "unclean hands," which seems to be intertwined with defendants' allegation that MSC sought its trademark registrations in bad faith. Specifically, defendants argue that MSC misled the PTO and the public, and attempted to capitalize on the Hockey Club's goodwill. The Court finds this allegation to be without merit. Defendants present no specific evidence to support this affirmative defense. Rather, they make a variety of unsubstantiated allegations, attempting to make ordinary proceedings and activities appear sinister. Because the Court finds these, and the other affirmative defenses mentioned above, to be without evidentiary support, MSC's motion for partial summary judgment will be granted on this ground, and the affirmative defenses of waiver, acquiescence, estoppel, laches, and unclean hands will be dismissed.

To summarize, the Court denies defendants' motion for summary judgment on the trademark infringement claims, but grants the motion on the claim for profits. The Court also grants defendant's motion to strike MSC's jury demand. The Court denies MSC's motion for partial summary judgment on the question of its trademark rights, but grants the motion striking defendants' affirmative defenses.

ORDER

Based on the foregoing, all the records, files, and proceedings herein, **IT IS HEREBY ORDERED** that:

1. Defendants' Motion to Preclude Expert Testimony of Ivan Ross [Docket No. 50] is **DENIED**.
2. Defendants' Motion for Summary Judgment [Docket No. 57] is **DENIED in part and GRANTED in part**, as set forth in Part II of this Opinion.
3. Plaintiff's Motion for Partial Summary Judgment [Docket No. 106] is **DENIED in part and GRANTED in part**, as set forth in Part III of this Opinion.

DATED: *July 26, 2002*
at Minneapolis, Minnesota.



JOHN R. TUNHEIM
United States District Judge



UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Electronic Search System (TESS)

TESS was last updated on Fri Aug 30 04:33:27 EDT 2002

PTO HOME TRADEMARK TESS HOME NEW USER STRUCTURED FREE FORM BROWSE DICT BOTTOM HELP

Logout

Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

Check Status

(TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)



Word Mark BYERLY'S MINNESOTA
 Goods and Services IC 029. US 046. G & S: Food Gift Packs Consisting of Meat, Cheese, Jams and Jellies. FIRST USE: 19801200. FIRST USE IN COMMERCE: 19801200
 IC 030. US 046. G & S: Food Gift Packs Consisting of Crackers, Mustard and Honey. FIRST USE: 19801200. FIRST USE IN COMMERCE: 19801200
 Mark Drawing Code (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
 Design Search Code 020101 031508 031524 050102 050110 180701 260103 260117
 Serial Number 73298009
 Filing Date February 20, 1981
 Published for Opposition December 21, 1982
 Registration Number 1231243
 Registration Date March 15, 1983
 Owner (REGISTRANT) Byerly's, Inc. CORPORATION MINNESOTA 7171 France Ave., S. Edina MINNESOTA 55427

EXHIBIT 2

Assignment Recorded

ASSIGNMENT RECORDED

Notice of Opposition
 Mark: MINNESOTA WILD (Appl. No. 76-265,943)
 Applicant: Minnesota Specialty Crops, Incorporated
 Opposer: Minnesota Wild Hockey Club, LP

Attorney of Record	DORSEY & WHITNEY
Disclaimer	No claim is made to the exclusive right to use the word "Minnesota", apart from the mark as shown.
Description of Mark	The mark consists of a design of a grove of trees, a loon, and a canoe and paddler above the words "Byerly's Minnesota".
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR).
Live/Dead Indicator	LIVE

PTO HOME	TRADEMARK	TESS HOME	NEW USER	STRUCTURED	FREE FORM	Browse dict	TOP	HELP
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Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 08/30/2002 12:28:21 ET

Serial Number: 73298009

Registration Number: 1231243

Mark



(words only): BYERLY'S MINNESOTA

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 1988-12-12

Filing Date: 1981-02-20

Registration Date: 1983-03-15

Law Office Assigned: TMEO Law Office # 2

CURRENT APPLICANT(S)/OWNER(S)

1. Byerly's, Inc.

Address:

Byerly's, Inc.
7171 France Ave., S.
Edina, MN 55435
United States

State or Country of Incorporation: Minnesota

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

Food Gift Packs Consisting of Meat, Cheese, Jams and Jellies

International Class: 029

First Use Date: 19801200

First Use in Commerce Date: 19801200

Basis: 1(a)

Food Gift Packs Consisting of Crackers, Mustard and Honey

International Class: 030

First Use Date: 19801200

First Use in Commerce Date: 19801200

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: No claim is made to the exclusive right to use the word "Minnesota", apart from the mark as shown.

Description of Mark: The mark consists of a design of a grove of trees, a loon, and a canoe and paddler above the words "Byerly's Minnesota".

PROSECUTION HISTORY

1988-12-12 - Section 8 (6-year) accepted & Section 15 acknowledged

1988-11-14 - Section 8 (6-year) and Section 15 Filed

1983-03-15 - Registered - Principal Register

1982-12-21 - Published for opposition

1982-11-09 - Notice of publication

1982-10-12 - Approved for Pub - Principal Register (Initial exam)

1981-12-15 - Non-final action mailed

1981-08-28 - Case file assigned to examining attorney

1981-05-19 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

DORSEY & WHITNEY (Attorney of record)

DORSEY & WHITNEY
2200 FIRST BANK PLACE EAST
MINNEAPOLIS, MN 55402
United States

LEONARD, STREET AND DEINARD 150 S. 5th Street, Suite 2300, Minneapolis, MN 55402 (612) 335-1500

Check No. 167725

INVOICE	G/L NUMBER	DESCRIPTION	AMOUNT
005470	2001000000000000		300.00

CHECK FACE HAS A COLORED BACKGROUND ON WHITE PAPER

LEONARD, STREET AND DEINARD
PROFESSIONAL ASSOCIATION
150 SOUTH FIFTH STREET, SUITE 2300
MINNEAPOLIS, MINNESOTA 55402
(612) 335-1500

National City Bank
of Minneapolis
Minneapolis, MN 55480
17-115/910

167725

DATE
09/05/02

AMOUNT
\$ 300.00

THREE HUNDRED AND 00/100 Dollar(s)

LEONARD, STREET AND DEINARD
THREE SIGNATURES REQUIRED IF AMOUNT
OVER \$5,000.00



PAY TO THE ORDER OF
Commissioner of Patents and Trademarks

THIS DOCUMENT CONTAINS A SECURITY WATERMARK ON BACK - HOLD AT AN ANGLE TO VIEW

167725 0910011571 1079549



Carlsbad Caverns National Park, NM

**ERIC D. PAULSRUD
LEONARD, STREET AND DEINARD
PROFESSIONAL ASSOCIATION
150 SOUTH FIFTH STREET SUITE 2300
MINNEAPOLIS, MN 55402**

RECEIPT OF FILING

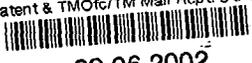
U.S. Patent and Trademark Office -- please date stamp and mail this postage-paid, pre-addressed receipt. Thank you.

Trademark Ser. No./Reg. No./Opp. No.: 76/265,943
Applicant/Registrant/Party: Minnesota Wild Hockey Club, LP v. Minnesota Specialty Crops, Incorporated

Mark: MINNESOTA WILD
Our File No.: 43475-2

We have enclosed the following:

- Fee (Check for \$300.00)**
- Specimens
- Application and Drawing Page
- Amendment to Allege Use
- Statement of Use (SOU)
- Response
- Notice of Appeal
- Sec. 8 Affidavit
- Renewal
- New Power of Attorney
- Assignment
- Notice of Opposition along with Exhibits 1 and 2**
- Other:
- SOU Request for Ext. of Time
- Request for Reconsideration
- Appeal Brief/Reply Brief
- Sec. 8 /15 Combined Affidavit
- Correspondence Address Change
- Sec. 7 Amendment/Correction
- Request for Ext. of Time to Oppose
- Petition for Cancellation



09-06-2002

LEONARD, STREET AND DEINARD

PROFESSIONAL ASSOCIATION

September 6, 2002

Eric D. Paulsrud
612-335-1448
eric.paulsrud@leonard.com

VIA EXPRESS MAIL

Box TTAB - FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Re: Application Serial No. 76-265,943
Mark: MINNESOTA WILD
Applicant: Minnesota Specialty
Crops, Incorporated
Opposer: Minnesota Wild Hockey
Club, LP
Our File No.: 43475-2

CERTIFICATE OF MAILING BY EXPRESS MAIL

Express Mail mailing label number EM209963656US

I hereby certify that this correspondence is addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 and is being deposited with the United States Postal Service as "Express Mail Post Office to Addressee" service on

September 6, 2002

Kitty A. McKenzie

(Printed or typed name of the person mailing the paper or fee)

Kitty A. McKenzie
(Signature of the person mailing the paper or fee)

September 6, 2002

(Date of Signature)

Dear Commissioner:

Enclosed for filing are the following:

1. Original and two copies of a Notice of Opposition along with Exhibits 1 and 2; and
2. A check in the amount of \$300 in payment of the filing fee.

The enclosed return-receipt postcard indicates the elements of this mailing. Please date stamp this card and return it to us for our records. This filing is being submitted by "Express Mail" with certificate, in accordance with 37 C.F.R. § 1.10.

Please note that at paragraphs 5 through 7 of the Notice of Opposition we identify other related opposition proceedings between the parties. Paragraph 10 of the Notice of Opposition contains a request to consolidate this newly filed opposition with pending Opposition No. 115,909. Opposition No. 115,909 has been stayed pending the ongoing District Court litigation between the parties.

02 NOV -5 PM 9:30
MAIL ROOM

Commissioner for Trademarks
September 6, 2002
Page 2

Sincerely,

LEONARD, STREET AND DEINARD

A handwritten signature in black ink, appearing to read "Eric D. Paulsrud". The signature is fluid and cursive, with a large initial "E" and "P".

Eric D. Paulsrud

EDP/kam: 2255503

Enclosures

cc: Richard G. Pepin, Jr., Esq. (w/enc.)
Mary J. Sotis, Esq. (w/enc.)
Lorin L. Reisner, Esq. (w/enc.)