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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

7-Eleven, Inc.
v.
Mark D. Morrison

Opposition No. 91154687
to application Serial No. 76360248

Charles R. Mandly, Jr. of Foley & Lardner LLP for 7-Eleven, Inc.

Norman P. Soloway of Hayes Soloway P.C. for Mark D. Morrison.

Before Hairston, Grendel, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On January 18, 2002, applicant Mark D. Morrison filed an intent-to-use application to register on the Principal Register the mark SLURP-EZE (in typed or standard character form) for goods identified as "dog bowls, cat bowls, ferret bowls" in Class 21. Serial No. 76360248. On June 11, 2002, the mark was published for opposition and, after two extensions of time to oppose, on December 9, 2002, opposer (7-Eleven, Inc.) filed a notice of opposition. Opposer alleges that it owns numerous registrations for the marks

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SLURP or SLURPEE for various goods. Specifically, opposer alleges that since "long prior to the filing of the application opposed herein, 7-Eleven has used trademarks, composed, in whole or in part, of the term 'Slurp' for a wide variety of products, including, but not limited to: plastic beverage containers, clothing, candy, bubble gum, soft drinks and frozen confections." Notice of Opposition at 1. Opposer alleges that it has obtained registrations¹ for the following marks:

I.

0829177

SLURPEE

Reg. Date: May 23, 1967

Second renewal

For: Fruit flavored, semi-frozen soft drinks (Class 32)

II.

1507444

SLURP

Reg. Date: October 4, 1988

§§ 8 & 15 affidavits

For: Flavored, semi-frozen soft drinks for consumption on or off the premises (Class 32)

III.

1647002

SUPER SLURPEE

Reg. Date: June 4, 1991

Renewed

For: Flavored, semi-frozen carbonated soft drinks for consumption on or off the premises (Class 32)

"Super" disclaimed

IV.

2236874

SLURPEE SPLITZ-O

Reg. Date: April 6, 1999

¹ Opposer also referred to several other registrations that were subsequently cancelled (Nos. 2256135, 2265759, 2288228, and 2362165).

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For: Flavored, semi-frozen carbonated soft drinks for consumption on or off the premises (Class 32)

V.

2240848

SLURPEE

Reg. Date: April 20, 1999

§§ 8 & 15 affidavits

For: Clothing, namely T-shirts (Class 25)

Furthermore, opposer maintains that "[r]egistration of the Applicant's aforesaid SLURP-EZE mark for the Goods is likely to confuse the public as to the source of Applicant's products in violation of Section 2(d)." Notice of Opposition at 3.

Applicant denied the salient allegations of opposer's notice of opposition.

The Record

The record consists of the pleadings; the file of the involved application; the testimonial and rebuttal depositions of Jean Olsen, a paralegal at Foley & Lardner LLP (opposer's counsel), with exhibits; the testimonial deposition of Jay Wilkins, opposer's category manager, with exhibits; the testimonial deposition, with exhibits, of George Mantis (opposer's survey expert); notices of reliance of opposer submitting status and title copies of its and third-parties registrations and applications, publications, census records, applicant's admissions and discovery responses; and applicant's notices of reliance on opposer's admissions and on publications.

Preliminary Matters

Because of opposer's proof of ownership and use of its registered marks, we find that opposer has established its standing to oppose. See, e.g., *Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Also, priority is not an issue here in view of opposer's ownership of at least five registrations for its SLURP and SLURPEE marks. See *King Candy Co. v. Eunice King's Kitchen*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Evidentiary Objections

Both parties raised several evidentiary objections. Opposer objects to applicant's notice of reliance on excerpts from opposer's deposition of opposer's witness (Jay Wilkins) on the ground that the specifically noticed sections are not actual witness testimony. Inasmuch as applicant has not relied on these statements, the objections are moot since the entire deposition is otherwise of record. We also overrule opposer's objection to applicant's reliance on the testimony of opposer's witness Wilkins that opposer claims is applicant's attempt "to elicit a legal opinion from a lay witness" on the question of actual confusion. Actual confusion is a factual question and not a legal opinion. See, e.g., *Fishking Processors Inc. v. Fisher King Seafoods Ltd.*, 83 USPQ2d 1762, 1763 n.1 (TTAB 2007) ("We

denied such motion on January 15, 2005, finding genuine issues of material fact as to petitioner's common law rights with respect to the mark FISHKING, the similarity of the parties' marks, the extent of actual confusion..."). In addition, opposer also maintains that the witness was confused, and while we agree that the witness appears to have been confused by the question, that fact goes to the weight to be given the testimony. Regarding Mr. Wilkins' testimony on pp. 69-77, we overrule the objection based on the ground that applicant was seeking to obtain legal opinions from a lay witness. Questions regarding whether a company is affiliated with another company or whether it has a license to use a trademark are not necessarily requesting a legal opinion. To the extent that the witness's other answers were typically "I don't know" and applicant does not rely on this part of the testimony, this objection also appears to be moot. Finally, we overrule opposer's objection to the rephrased question on p. 82 that asked:

Are any of the products depicted in any of those pictures of the possibly several hundred pages of materials in front of us, are any of those products intended by 7-Eleven for use in connection with any pet?

Opposer objected (Brief at 28) to the question on the ground that it was vague and ambiguous and "hopelessly compound." The witness responded: "Not to my knowledge." While the question referred to numerous pages of evidence, applicant

was simply asking the witness if he was aware of any product of opposer that was intended for use by animals. We do not view this type of question as "hopelessly compound" or otherwise objectionable and we overrule opposer's objection.

Applicant has also objected to some of opposer's evidence. The most notable objection is his motion to strike the trial testimony of George Mantis, who conducted a survey for opposer. The undisputed facts, taken from opposer's opposition to the motion to strike and the board's orders, are set out below:

September 30, 2005

Opposer responds to applicant's request for production of documents relating to expert testimony by informing applicant that it had no responsive documents. Applicant did not serve any interrogatory concerning expert witnesses.

March 30, 2007

Opposer's motion for summary judgment is denied.

June 1, 2007

Opposer's testimony period opened.

Early June 2007

Opposer retains Mr. Mantis to conduct a consumer reaction test.

June 18, 2007

Opposer informs applicant that it intends to call Mr. Wilkins and Ms. Olsen and that it "was contemplating a potential third deposition."

June 22, 2007

Opposer's testimony period is extended from July 1, 2007 to July 20, 2007. The order also sets the deposition of "witness Olsen, and any third witness, in Chicago on July 18, 2007." The deposition of Mr. Wilkins was set for July 17, 2007, in Dallas, Texas.

"early the week of July 9, 2007"

Opposer makes a final decision to offer testimony of Mr. Mantis.

July 11, 2007

Opposer serves by facsimile and overnight courier a notice of deposition of George Mantis. The notice states that opposer "will take the testimony deposition of the following named individual... Mr. George Mantis The Mantis Group, Inc."

July 13, 2007, Friday

Mr. Mantis completes his expert report.

July 14, 2007, Saturday

Opposer serves by next business day courier service 1300 pages of material together with a supplemental response to applicant's request for documents.

Applicant submits that "on the afternoon of Monday July 16, 2007, the office of Hayes Soloway in Tucson, Arizona received approximately one thousand three hundred fifty two pages of survey papers and a purported expert report."

Motion to Strike at 4. Opposer had scheduled the deposition of one of its witnesses in Dallas, Texas, the next day (the 17th) and the deposition of Mr. Mantis was scheduled at 10:00 a.m. the day after that in Chicago. This schedule was in conformity to the board's order of June 22, 2007.

Applicant argues that it "had no realistic opportunity even to read Mr. Mantis's material, let alone to analyze and effectively prepare cross examination for Mantis' marketing survey and expert opinions." Motion to Strike at 5.

Opposer argues that Mr. Mantis's trial testimony deposition should not be stricken because opposer "provided a full seven (7) days written notice of the deposition ...

[and] Applicant was on notice for over a month of 7-Eleven's intent to call up to three witnesses." Opposition to Motion at 10. Opposer also argues that cases such as *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280 (TTAB 1998) and *Hamilton Burr Publishing Co. v. E.W. Communications, Inc.*, 216 USPQ 802 (TTAB 1982) support its argument that applicant received reasonable notice. See 37 CFR § 2.123(c) ("Before the depositions of witnesses shall be taken by a party, due notice in writing shall be given to the opposing party").² In *Penguin Books*, the board "exercise[d] its discretion to consider this testimony. In view of the nature of the testimony presented, we do not believe that the relatively short notice was prejudicial." 48 USPQ2d at 1284. In *Hamilton Burr*, the board agreed that the notice was short but it pointed out that the deposition was "taken a short distance from the offices of applicant's attorneys" and

² We add that the USPTO's rules now require that "[d]isclosure of expert testimony must occur in the manner and sequence provided in Federal Rule of Civil Procedure 26(a)(2)." 72 Fed. Reg. 42242, 42260 (August 1, 2007). However, this change applies to proceedings that were filed on or after November 1, 2007. 72 Fed. Reg. at 42242. *Accord HighBeam Marketing LLC v. Highbeam Research LLC*, 85 USPQ2d 1902, 1906 n.4 (TTAB 2008) (While "Federal Rule 26(b)(4) now does apply to Board proceedings, its application is not retroactive. Thus, even if we presume that it would be reasonable and expected for applicant to pay some fee for the time Ms. Saurage would have to spend at the deposition, opposer's reliance on Rule 26(b)(4)(C) is misplaced"). Therefore, cases dealing with mandatory disclosure of experts in Federal court are "largely inapposite" inasmuch as "Fed. R. Civ. P. 26 mandatory disclosure requirements [are] not applicable to Board proceedings" in cases such as this. *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America Inc.*, 74 USPQ2d 1672, 1679 n.14 (TTAB 2005).

"applicant's counsel has pointed to no specific prejudice that it sustained as a result of this short notice." 216 USPQ at 804 n.6. We do not read these cases as establishing that minimal notice of an expert witness is always appropriate. We add that the board has held that "[w]hether notice is reasonable is determined under the individual circumstances of each case." *Duke University v. Haggard Clothing Co.*, 54 USPQ2d 1443, 1444 (TTAB 2000). In that case, which did not involve expert witnesses, the board also held that: "Given the more than adequate thirty-day period allowed for trial for each party in inter partes proceedings before the Board, there must be a compelling need to require adverse counsel to prepare with such haste at the close of a party's testimony period." *Id.* See also *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1653 (TTAB 2007) (Opposer's "notice of six days was reasonable").

Here, on June 22, 2007, the board order included a provision that opposer could call a third witness in Chicago on July 18, 2007. On July 11, 2007, opposer informed applicant that it was calling George Mantis of the Mantis Group, Inc. as its witness. However, at no point did opposer inform applicant that the witness was an expert witness until applicant received thirteen hundred pages of documents on the afternoon of the 16th, the day before depositions were scheduled to begin in Texas the next day.

Although opposer never took the simple step of informing applicant that Mr. Mantis was an expert witness, it now argues (Opposition to Motion at 6) that the responsibility was apparently applicant's to determine:

7-Eleven notes that even if Applicant's counsel did not wish to make such an inquiry of 7-Eleven's counsel, Applicant had other ways to identify the probable subject matter of Mr. Mantis' testimony. For example, a simple GOOGLE search engine search of "'George Mantis' + Chicago" would have disclosed that Mr. Mantis had lectured on use of consumer survey evidence in trademark proceedings.

However, despite the fact that opposer did not provide applicant any indication that it was contemplating calling an expert witness, applicant apparently expressed no interest in discovering who the potential third witness was after the board order of June 22, 2007, scheduled this potential deposition or even after being informed of the witness's name and affiliation a week before the deposition. Also, inasmuch as applicant had not submitted an interrogatory on the question of an expert witness, opposer was under no duty to supplement a discovery response as soon as it decided to call an expert. Furthermore, while applicant did "object to the introduction into evidence of Opposer's Trial Exhibit 20" and to "any expert testimony of the witness," it did not seek any other accommodation regarding cross-examination of the witness. Mantis dep. at 12-15. See, e.g., *Penguin Books*, 48 USPQ2d at 1284 ("In response, applicant maintains that he gave opposer notice as

early as possible. Moreover, during the deposition, applicant's attorney agreed to give opposer access to the witness to remedy any potential problem, including allowing opposer another opportunity in which to cross-examine applicant's expert witness"). Here, when we consider all the factors in this case, we conclude that the notice was adequate and we deny applicant's motion to strike the deposition of Mr. Mantis.

Applicant also moves to strike the testimony of Jay Wilkins (dep. at p. 52, lines 4-10) "who (without foundation or prior disclosure) proffered 'expert testimony' trial testimony as to 'likelihood of confusion.'" Motion to Strike at 1. The testimony of Mr. Wilkins reads:

The Slurpee brand I believe is so iconic and representative of our product. And the use of the Slurpee brand through other Slurpee products, I think there's a high likelihood that a consumer could be confused by seeing a version of Slurpee put on a product and it would be interpreted that it was an extension of ours.

The "opinions of witnesses, including those qualified as expert witnesses, on the question of likelihood of confusion are entitled to little if any weight and should not be substituted for the opinion of the tribunal charged with the responsibility for the ultimate opinion on the question."

Mennen Co. v. Yamanouchi Pharmaceutical Co., Ltd., 203 USPQ 302, 305 (TTAB 1979). To the extent that this excerpt constitutes expert testimony on the issue of likelihood of

confusion, we sustain the objection and give this testimony little weight. *Land-O-Nod Co. v. Paulison*, 220 USPQ 61, 63-64 (TTAB 1983):

Further, the Board has consistently held that although opinion testimony on the question of likelihood of confusion is admissible, it is entitled to little or no weight. On the other hand, factual information relating to use of opposer's marks and advertising thereunder manifestly constitutes evidence to be considered in resolving the issue before us. Therefore, applicant's objection is sustained only to the extent that the opinion testimony on the issue of likelihood of confusion has been given little consideration in our determination of this case.

Applicant "has also objected to certain trial testimony of Opposer's company witness Jay Wilkins, on the ground that this witness proffered certain marketing, advertising and sales composite data compromising a "Summary of Voluminous Documents," but refused to disclose to Applicant during cross-examination, upon explicit request, the voluminous documents upon which his testimony was predicated." Brief at 2, referring to Wilkins dep. at 42, 44, 46-47, and 53-57.

Opposer responds by arguing that the objected-to testimony concerns:

1. 7-Eleven costs for SLURPEE marks advertising.
2. 7-Eleven's pet product sales.
3. internet traffic to 7-Eleven's websites

Opposer maintains that "Wilkins testified as to each of the Testimony Categories based on personal knowledge." Reply Brief at 16.

When we review the testimony, we agree with opposer that the testimony is based on the witness's personal knowledge:

Q. And do you have any knowledge as to whether or not the level of advertising expenditures for Slurpee branded products subsequent to 2002 have been maintained at this level?

A. Yes. I do. It's the responsibility of the category managers that fall under my jurisdiction.

Wilkins at 42.

Q. Let me ask you a slightly different question. Do you have any information about the number of consumers who visit your web sites?

A. We track consumers - you can - you can track consumers two ways. Total visitors and unique visitors. We track unique visitors because it shows new activity. And in 2007 our -- our average is running at 108,000 visitors per month.

Wilkins at 44.

Q. And does 7-Eleven monitor the number of unique hits that are received by its web sites?

A. Yes, we do.

Q. And in your response - in your capacity as category manager for Slurpee, do you receive information with respect to those hits with relationship to online materials for Slurpee?

A. Yes, we do.

Q. And is that the basis of the testimony you're giving here today, are the business records of 7-Eleven that describe these unique hits?

A. Yes. Yes, it is.

Wilkins at 45.

Q. Did you prepare Exhibit 19?

A. I did not prepare Exhibit 19. I verified the information that was on Exhibit 19.

Q. How did you verify it?

A. I pulled the data within our information system to validate that that number was correct.

Q. Off your computer?

A. Correct.

Wilkins dep. at 54.

Therefore, we overrule applicant's objection. The witness's testimony is not a summary of a voluminous record, it is information given about a business by someone with personal knowledge.

We add that opposer, in its notice of opposition, refers to its ownership of nine registrations and one application. Four of these registrations have expired. With its notice of reliance, opposer included status and title copies of five of the registrations that were pled (Nos. 829177; 1507444; 1647002; 2236874; and 2240848) as well as No. 2660731, which was identified as Application Serial No. 76298363 but has subsequently issued as No. 2660731. In addition, opposer also included status and title copies of the following registrations that were not identified in the notice of opposition: Nos. 2689393; 2794922; 2830269; 2938850; 3079803; 3151476; 3193253; and 3221508. Opposer relies on these registrations in its Brief at pages 5-6. Applicant (Brief at 3 n.2) has responded by

noting that "Opposer's marks covering gum and candy, a toy SLURPEE maker, and several others included on pgs. 4 and 5 were filed after Applicant's Application. Nevertheless, all of these products are directly related to the SLURPEE beverage. Most of the remaining marks and the evidence supplied by opposer lists the following goods and services: 'semi-frozen soft drinks.'" We hold that the issues raised by these additional registrations were tried by implied consent. TBMP § 507.03(b) (2d ed. rev. 2004). See also *Nike Inc. v. WNBA Enterprises LLC*, 85 USPQ2d 1187, 1193 n.7 (TTAB 2007) ("[A]pplicant has not objected to opposer's reliance on the three unpleaded registrations. Accordingly, we treat these unpleaded registrations as having been tried by implied consent of the parties").

These registrations include:

VI.

SLURP AND GULP

2660731

Reg. Date: December 10, 2002

For: Plastic beverage containers (Class 21) and Soft drinks (Class 32)

VII.

2689393

SLURPEE SPLITZ-O

Reg. Date: February 18, 2003

For: Bubble gum and chewing gum (Class 30)

VIII.

2794922

SLURPEE INFUSED GUM

Reg. Date: December 16, 2003

For: Chewing gum (Class 30)

"Gum" disclaimed

IX.

2830269

SUPER SLURPEE STRATA

Reg. Date: April 6, 2004

For: Semi-frozen soft drinks (Class 32)

"Super" disclaimed

X.

2938850

CANDEE SLURPEE

Reg. Date: April 5, 2005

For: Confectionary products, namely candy (Class 30)

"Candy" disclaimed

XI.

3079803

SLURPEE

Reg. Date: April 11, 2006

For: Toy battery operated beverage maker (Class 28)

XII.

3151476

SLURPEE

Reg. Date: October 3, 2006

For: Confectionery products, namely candy (Class 30)

XIII.

3193253

SLURPEE FREEZER POPS

Reg. Date: January 2, 2007

For: Frozen confections (Class 30)

"Freezer Pops" disclaimed

XIV.

3221508

SLURPEE SPORTS

Reg. Date: March 27, 2007

For: Beverage containers, namely plastic bottles sold empty
(Class 21)

"Sports" disclaimed³

³ "In an opposition, the board must consider existing registrations of subsequent-user opposers." *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Likelihood of Confusion

We now move on to the central issue in this case, whether there is a likelihood of confusion. When considering this issue, we rely on the thirteen factors set out by the Court of Appeals for the Federal Circuit and its predecessor, the Court of Custom and Patent Appeals, in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) and *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003), to the extent that there is relevant evidence.

We begin by comparing the marks. "The first *DuPont* factor requires examination of 'the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.'" *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). In this case, applicant's mark is SLURP-EZE, while opposer's marks are based on the terms SLURPEE and SLURP. Applicant's and opposer's marks do not include any stylization or design so it must be assumed that there is no difference between the marks on this basis. *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983) ("[T]he argument concerning a difference in type style is not viable where one party asserts rights in no particular display. By

presenting its mark merely in a typed drawing, a *difference* cannot legally be asserted by that party").

Opposer owns registrations for the mark SLURPEE alone for semi-frozen soft drinks, T-shirts, toy battery beverage maker, and candy. The only difference in appearance between opposer's SLURPEE mark and applicant's SLURP-EZE mark is the presence of the letter "Z" in applicant's mark and the hyphen. The presence or absence of a hyphen is not a significant difference. See *Goodyear Tire & Rubber Co. v. Dayco Corp.*, 201 USPQ 485, 488 n.4 (TTAB 1978) ("[T]he mark 'FAST-FINDER' with a hyphen (which mark is in legal contemplation substantially identical to the mark 'FAST-FINDER' without a hyphen..."). See also *Harvey Hubbell, Inc. v. Red Rope Industries, Inc.*, 191 USPQ 119, 123 (TTAB 1976) ("[T]he marks 'DATA' and 'DATA . LOK', although used by the parties in different graphic presentations, create the same general commercial impression and are, for all purposes herein, legally identical"). Thus, the difference in the appearance of the marks is relatively minor and many purchasers may not even notice. The pronunciation of the marks is also very similar. Indeed, for many purchasers, the marks may sound virtually the same or perhaps SLURP-EZE may be recognized as the plural form of SLURPEE. See Opposer's Brief at 18 (The "aural impression of Applicant's SLURP-EZE marks is identical to the aural impression of a

pluralized form of 7-Eleven's mark - SLURPEES"). Indeed, there are numerous examples of members of the public using a plural form of opposer's mark. See, e.g., *Chicago Sun-Times*, November 19, 2001 ("**Slurpees** have been around since 1965..."); *Tampa Tribune*, August 16, 1996 ((Nearly 5 billion **Slurpees** have been sold"); and *Puget Sound Business Journal*, May 28, 1993 ("Robin Pavlish, merchandiser for the Northwest division of Southland Corp., ... hails the Acorto 990 as the best thing for sales since **Slurpees**"). Therefore, even if the marks are pronounced as a singular and a plural, this would not distinguish the marks. *Wilson v. Delauney*, 245 F.2d 877, 114 USPQ 339, 341 (CCPA 1957) ("It is evident that there is no material difference, in a trademark sense, between the singular and plural forms of the word "Zombie" and they will therefore be regarded here as the same mark").

Quizzically, applicant admits that "SLURPEE is a fanciful name for ... a slurpee, or as Opposer would prefer a 'semi-frozen soft drink.'" Brief at 9 (punctuation in original). Applicant argues that "the SLURP-EZE mark is highly suggestive of the product's use, i.e., a bowl that eases the mess that results from pets slurping up food and water." *Id.* Inasmuch as neither mark is a common English word and they are both based on the word "SLURP," it is unlikely that purchasers would discern any significant difference between the meanings of the marks SLURPEE and

SLURP-EZE. We point out that our "focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks." *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1848 (TTAB 2004).

Finally, the commercial impressions of these marks are also very similar if not virtually identical. There is virtually no difference between the marks. Therefore, we conclude that the similarities of the marks' sound, appearance, meaning, and commercial impression outweigh any potential differences. *Mennen Co.*, 203 USPQ at 305 ("Considering the marks 'MINON' and 'MENNEN' in such light and taking into account that average consumers are not infallible in their recollection of the many trademarks that they are exposed to through the various communications media, much less the spelling thereof, it is our opinion that the marks are similar in appearance and are reasonably susceptible of a similar pronunciation and that therefore purchasers would be likely to assume that applicant's product, when offered, is another 'MENNEN' product").

Furthermore, when both parties are using or intend to use virtually identical designation, "the relationship between the goods on which the parties use their marks need not be as great or as close as in the situation where the marks are not identical or strikingly similar." *Amcor, Inc.*

v. Amcor Industries, Inc., 210 USPQ 70, 78 (TTAB 1981). See also *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993) ("[E]ven when goods or services are not competitive or intrinsically related, the use of identical marks can lead to an assumption that there is a common source").

Opposer has also submitted status and title copies of its registrations for SLURP for semi-frozen soft drinks for consumption on or off the premises and SLURP AND GULP for plastic beverage containers and soft drinks. The term "Slurp" is the first term in these marks and dominates these marks and applicant's SLURP-EZE mark. *Palm Bay Imports*, 73 USPQ2d at 1692 ("To be sure, CLICQUOT is an important term in the mark, but VEUVE nevertheless remains a 'prominent feature' as the first word in the mark and the first word to appear on the label. Not only is VEUVE prominent in the commercial impression created by VCP's marks, it also constitutes 'the dominant feature' in the commercial impression created by Palm Bay's mark"). Applicant's mark has taken the entire registered mark and added the term "Eze" to it, which merely emphasizes the "Slurp" portion of the mark. The SLURP AND GULP mark and SLURP-EZE marks both emphasize the act of "Slurping." Inasmuch as the dominant portion of these marks is identical, the similarities in

sound, appearance, meaning, and commercial impressions of the marks outweigh their differences.

Another factor that we consider is the question of fame or public recognition and renown. The Federal Circuit "has acknowledged that fame of the prior mark, another *du Pont* factor, 'plays a dominant role in cases featuring a famous or strong mark.'" *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), quoting, *Kenner Parker Toys v. Rose Art Industries*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). "Famous marks thus enjoy a wide latitude of legal protection." *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000) (FIDO LAY for "natural agricultural products, namely, edible dog treats" confusingly similar to FRITO-LAY for snack foods). Applicant acknowledges that "Opposer has established through hundreds or [sic] LEXIS articles that the term SLURPEE has become a well-known mark synonymous for Opposer's goods, the 'semi-frozen soft drink' for human consumption, and perhaps related beverage containers, straws or other products used in conjunction with human consumption of beverages." Brief at 9.

Opposer has submitted the following evidence to show the public recognition and renown for its marks. In general, "there's over 32,000 7-Elevens. And we actually

hit a milestone just recently where we surpassed McDonalds as having more retail outlets." Wilkins at 9. In the United States there are approximately 6,000 stores. *Id.* at 10. "The Slurpee product has been available under that brand since 1966." *Id.* at 10. Mr. Wilkins identified numerous cups for its semi-frozen soft drink that are "representative of the kinds of promotional cups that 7-Eleven has used." Wilkins at 19. Many of these cups contain the marks SLURPEE and SLURP. Wilkins Ex. 1. In addition to using the mark on soft drinks, opposer has also used the SLURPEE mark on straws, key chains, T-shirts, novelty items, watches, hats shirts, and shoes. Wilkins dep. at 25 and Ex. 5. Opposer sells a toy SLURPEE machine at such retailers as Wal-Mart. Wilkins at 27. Since the SLURPEE soft drink was introduced, opposer has sold billions of these beverages and the annual sales generate millions of dollars in sales. Opposer's Brief at 3; Wilkins dep. at 28. Opposer has advertised its SLURPEE brand soft drinks in television, radio, print, and internet advertisements. Copies of many of these advertisements have been made of record. It also spends in excess of five million dollars in advertising the SLURPEE brand annually. Wilkins dep. at 42. SLURPEE drinks have been sold in cups that, in addition to the SLURPEE mark, also promoted the World Wrestling Federation, the X GAMES on ESPN, "Hulk Only in theaters,"

"'Superman Returns' in Theaters June 30," and "Superman IV." Wilkins Exhibits 4-5. See also Wilkins Ex. 15 ("The Simpsons Movie Collectible Slurpee Cups and Magnetic Straws").

In addition, opposer has submitted hundreds of articles from newspapers and other publications that show that the term SLURPEE associated with opposer has received significant press recognition. Some examples (with bold added) are set out below.

For the fifth year, Denver police officers are distributing coupons for a free 12-ounce **Slurpee** from 7-Eleven to schoolchildren exhibiting positive behavior.
Denver Post, September 19, 1999.

For Tonya Rucker, visiting 7-Eleven is a family affair - for a **Slurpee** for herself, morning coffee for her husband, and after-school potato chips for her children.
Virginian-Pilot, September 19, 1999.

Did you know that you can now get wine at 7-Eleven? Not just Thunderbird. Actual wine. Chardonnay and stuff. For real. You can walk in your local convenience store and get beef jerky, a lottery ticket and a fine \$6 Merlot. That is highly suspicious.

If they cared about my feelings at 7-Eleven, they would at least come up with an arrangement where people can feel comfortable. Hey, hook the wine to the **Slurpee** machine. **Slurpee** Zinfandel, that's the future.
Charleston Daily Mail (West Virginia), November 14, 2001.

Scientists may not have cured the common cold, but after years of research, they have figured out a way to make a diet **Slurpee**, which could show up in Chicago as early as this spring.

It wasn't easy. **Slurpees** have been around since 1965, and since the mid-1980's scientists at 7-Eleven

have been trying to come up with a low-cal version of the carbonated beverage.

Chicago Sun-Times, November 19, 2001.

If you didn't know Bob Stanford, you probably knew his creations.

Ever had a **Slurpee**? He named it.

Remember this one? "Oh, thank heaven for 7-Eleven."

He thought of it.

Dallas Morning News, December 8, 2001.

Every student who drove home from Dakota High School Thursday was wearing a seat belt. So were the passengers.

That's because Macomb County Sheriff Mark Hackel and several police officers were at the parking lot exit to hand out coupons for free **Slurpees** at Seven-11 stores and to remind students to buckle up.

Detroit News, December 7, 2001.

Dallas-based 7-Eleven is testing a new sugar-free **Slurpee** formula at 106 stores in the Detroit area and 35 in Kansas City, Mo., before a scheduled roll out to the rest of the country next summer, the Wall Street Journal reported.

National Petroleum News, December 1, 2001.

For the past bazillion years ... well, as long as I can remember, my family has taken advantage of the few things open on Christmas Day: 7-Eleven (for Coke **Slurpees** to sneak into the movie)...

Washington Post, December 24, 2001.

Here's an update on the 7-Eleven **Slurpee** war between Coke and Pepsi. Pepsi **Slurpees** you may recall, have been test-marketed here since last summer, much to the ire of Coke fans such as myself.

St. Petersburg Times, January 20, 2002.

Consider the **Slurpee** - a sugary slush synonymous with 7-Eleven for about 35 years. The super-sweet cherry version has 177 calories per 12 ounces - and that's the teensy size. More than 11 million thigh-busting **Slurpees** are sold every month.

Dallas Morning News, January 5, 2002.

Click onto the "Where's Barry?" icon and check out the latest Barry Sanders sightings. Maybe he and Elvis are in charge of **Slurpees** at a 7-Eleven in Kalamazoo.

Detroit Free Press, December 29, 2001.

Durst [Fred Durst of Limp Bizkit] wore his trademark red baseball cap (Flipped around Ken Griffey Jr. style), black T-shirt and khaki pants. He could be the guy trafficking **Slurpees** at a 7-Eleven because nothing about him said "rock star."

Seattle Post-Intelligencer, October 19, 1999.

The newlywed couple helps Church of the Open Door Pastor Bob Christopulos work with homeless girls. Christopulos, a Baptist minister who performed the ceremony, has a sort of foster home set up for the troubled teens. After the ceremony, the couple feed each other cake and had a **Slurpee** toast.

Deseret News (Salt Lake City), October 17, 1999.

History's soft-focus lens obscures the dish. It is either a bowl of sherbet or a sharbat, a drink of rose water chilled with snow collected from the mountains of Lebanon. Either way, it is one of the first, and greatest, examples of East-West culinary exchange, and a seminal moment in the grand tradition of frozen desserts, one of the most universal of all foods. The Arabic word becomes the French "sorbet" and the Italian "sorbetto." The offspring of that Lebanese slush include the 7-Eleven **Slurpee** and ice cream in every form, from vanilla to jalapeno.

New York Times, December 29, 1999.

Or, as Alexi Lalas could be asking himself: How can I sign a million-dollar soccer contract if it means living in a place with no 7-Eleven **Slurpee** around the corner?

Orange County Register, July 20, 1994.

"We went to the ballpark last night and within eight seconds all these people are yelling, 'Kato, Kato,'" says 98 Rock newsman Bob Lopez. "How does this guy ever go to a 7-Eleven for a **Slurpee** anymore?"

Baltimore Sun, June 6, 1995.

The evidence of record demonstrates that opposer's

SLURPEE mark has received significant public recognition and

renown.⁴ As a result of this recognition, its SLURPEE mark is well known and this factor weighs heavily in opposer's favor.

We also point out that this case is different from a somewhat similar case that involved opposer. *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715 (TTAB 2007). In that case, the board held that opposer's "BIG GULP trademark has a very high degree of public recognition and renown." *Id.* at 1723. However, the applicant's mark GULPY in that case was not virtually identical to opposer's famous mark. Furthermore, "Gulp is a suggestive designation in the fountain drink field" (83 USPQ2d at 1721), while the term SLURPEE is arbitrary or at most only slightly suggestive.

The next factor we consider is whether the applicant's and opposer's goods are related. We must compare the goods as described in the application and the registrations to determine if there is a likelihood of confusion. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1493, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). Therefore, applicant's goods include all types of cat, dog, or ferret bowls not just "lipped pet-bowl[s] meant to ease the mess associated with pet feeding and watering" (Brief at 9) or pet bowls that cost between \$11 and \$16" (Brief at 11). Opposer has

⁴ This evidence of public recognition and renown is primarily directed to opposer's SLURPEE mark and not its other "Slurp-" marks.

submitted evidence that pet bowls can cost as little as \$2.99. Olsen Exhibits 21 and 22.

"In order to find that there is a likelihood of confusion, it is not necessary that the goods or services on or in connection with which the marks are used be identical or even competitive. It is enough if there is a relationship between them such that persons encountering them under their respective marks are likely to assume that they originate at the same source or that there is some association between their sources." *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1898 (TTAB 1989). See also *In re Opus One Inc.*, 60 USPQ2d 1812, 1814-15 (TTAB 2001).

Applicant's goods are dog bowls, cat bowls, and ferret bowls. Opposer's goods for the mark SLURPEE include fruit flavored, semi frozen soft drinks (No. 0829177) and T-shirts (No. 2240848). Opposer has also obtained a registration for the mark SLURP AND GULP (No. 2660731) for plastic beverage containers.⁵ Opposer has continued to expand the use of its marks on other products with its more recent registrations SLURPEE SPLITZ-O for gum, CANDEE SLURPEE for candy, SLURPEE FREEZER POPS for frozen confections, and SLURPEE SPORTS for beverage containers,

⁵ Applicant accuses opposer of filing for this mark "six months after the date of publication" of his mark in the Official Gazette. Brief at 11 (emphasis omitted). However, opposer's underlying application was filed on August 10, 2001, more than five months before applicant had even filed his application.

namely plastic bottles sold empty. While opposer has never offered a pet food product under the SLURPEE mark, (Wilkins dep. at 50), its stores sell significant quantities of pet food and cat litter (Wilkins dep. at 48). Opposer has offered evidence that shows that beverage containers for humans and bowls for pets are marketed under the same mark or slogan. See Olsen Ex. 23 (LIFE IS GOOD mug and pet bowl); Ex. 25 (SIGNATURE mug and pet bowl); Ex. 26 (OUR NAME IS MUD dog food bowl and mug); Ex. 28 (BIG SKY CANINE dog food bowl and mug); Ex. 29 (KASEY KAHNE pet bowl and mug); and Ex. 31 (TROJANS (USC) mug and dog bowl). Opposer also included some registrations to show that there is a relationship between pet bowls and mugs, cups, or glasses. See Registration Nos. 2683137, 2915536, 3252132, and 3259041.⁶ *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993).

We add that opposer's expert, Mr. Mantis, testified that: "Yes, indeed, there's likelihood of confusion. At least 19 percent of our survey respondents demonstrate

⁶ Opposer's reference to applications and expired registrations are not entitled to any weight. *Glamorene Products Corp. v. Earl Grissmer Co., Inc.*, 203 USPQ 1090, 1092 n.5 (TTAB 1979) ("The filing of a notice of reliance upon third-party applications is a futile act because copies of those applications or the publication thereof in the Official Gazette is evidence only of the filing of the applications and nothing else") and *Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) ("[A] cancelled registration does not provide constructive notice of anything").

confusion." Mantis dep. at 38. The survey requested respondents to view the term SLURP-EZE on a card and it asked them what company or companies makes or puts out dog bowls or pet bowls with the name on the card.⁷ While the survey sample was small (162 respondents), it is still entitled to some weight. *In re Spirits International, N.V.*, 86 USPQ2d 1078, 1089 (TTAB 2008) ("[W]here as here, the number of participants is rather small (231), the survey provides limited information about consumer views").

While this evidence is not extensive, it, at least, suggests that applicant's pet bowls and opposer's soft drinks, beverage containers, and other goods are related in the mind of the consuming public as to the origin of the goods. *Compare Wechsler*, 83 USPQ2d at 1724 ("[T]here is no evidence in the record that any companies use the same trademarks for products for human consumption and products for animal consumption or for accessories for animals") *with Recot*, 54 USPQ2d at 1898 ("The Board erred when it refused to consider the lay evidence that several large companies produce and sell both pet and human food in deciding whether a consumer would reasonably believe that FIDO LAY dog treats originated from the same source as FRITO-LAY human snacks").

⁷ See also Mantis Ex. 19 at 8 ("Based on the results of this study, it is my opinion that the concurrent use of the trademark SLURPEE by 7-Eleven for beverages and other products and the mark SLURP-EZE for a pet bowl product is likely to cause confusion").

Regarding channels of trade, we begin by noting that there are no limits in the channels of trade in the identification of goods and, therefore, we must presume that the goods move through all the normal channels of trade for those goods. *Morton-Norwich Products, Inc. v. N. Siperstein, Inc.*, 222 USPQ 735, 736 (TTAB 1984) ("Since there is no limitation in applicant's identification of goods, we must presume that applicant's paints move in all channels of trade that would be normal for such goods, and that the goods would be purchased by all potential customers"). Therefore, we cannot accept applicant's argument (Brief at 12-13) that "opposer controls the only channel of trade where a customer would likely be confused under these circumstances - their own stores... Opposer simply does not have to stock Applicant's pet bowls." There are no limits to opposer's channels of trade in its identification of goods, and we do not limit opposer's goods to those that are sold only in its stores. We must assume that its goods are sold in other stores where applicant's bowls can also be sold.

Opposer has included evidence that retailers do sell both food items as well as pet bowls. Olsen Exhibits 21 and 22. See also Olsen Exhibits 35 and 36 (other pet products and food items). Opposer itself sells a wide variety of human and pet food. We do add that the fact that products

are sold in the same stores does not necessarily demonstrate that the goods are related even if the general channels of trade may overlap. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("A wide variety of products, not only from different manufacturers within an industry but also from diverse industries, have been brought together in the modern supermarket for the convenience of the consumer. The mere existence of such an environment should not foreclose further inquiry into the likelihood of confusion arising from the use of similar marks on any goods so displayed"). But here, the evidence supports the conclusion that there would be at least some similarity in the channels of trade.

We add that the purchasers would overlap in this case inasmuch as pet owners who were interested in a pet bowl would also include individuals who were interested in purchasing opposer's soft drinks, T-shirts, plastic beverage containers, and other promotional items associated with its SLURPEE and SLURP AND GULP drinks.

Finally, applicant argues that "the complete absence of any actual confusion by any actual human being is probative and telling." Brief at 16. While there is no evidence of actual confusion, we cannot give this factor much weight. We have little evidence of applicant's actual use and we note that his application was based on an intent to use.

See also Applicant's Supplemental Response to Opposer's First Set of Interrogatories to Applicant, p.3 ("While products bearing the mark (broadest products) have been displayed at pet product industry shows..., Applicant has not as yet sold branded products"). It would be surprising if there was evidence of actual confusion under these circumstances. Of course, the question is whether there is a likelihood of confusion, not actual confusion. *Majestic Distilling*, 65 USPQ2d at 1205 ("A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight").

In this case, applicant has chosen a trademark that is virtually the same as opposer's well-known mark SLURPEE. Opposer has used and registered the mark for a variety of consumer products most notably soft drinks. The evidence shows that the term SLURPEE is widely recognized as a mark associated with opposer. While applicant's pet bowls are different than opposer's soft drinks, T-Shirts, and other items, our case law requires that we must resolve doubts in registrant's favor. *In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes*, 487 F.2d 918, 179 USPQ 729, 729-30 (CCPA 1973); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

Furthermore, the Federal Circuit and its predecessor have held that "there is no excuse for even approaching the well-known trademark of a competitor and that all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially where the established mark is one which is famous." *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1904 (Fed. Cir. 1989), quoting, *Planter's Nut & Chocolate Co. v. Crown Nut Co., Inc.*, 305 F.2d 916, 134 USPQ 504, 511 (CCPA 1962) (internal punctuation marks omitted). Opposer's evidence supports the conclusion that the goods of the parties are at least associated in some way so that consumers are likely to assume that their sources are related.

Under these circumstances, we hold that applicant's mark SLURP-EZE when used on cat bowls, dog bowls, and ferret bowls, would be likely to cause confusion in view of opposer's registered SLURPEE and various SLURP marks for the identified goods.

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