

THIS OPINION IS NOT A PRECEDENT
OF THE TTAB

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

Butler

Mailed: February 12, 2009

Opposition No. 91180742
Cancellation No. 92048446

DR. PEPPER/SEVEN UP, INC.

v.

KRUSH GLOBAL LIMITED

Before Rogers, Taylor, and Ritchie, Administrative Trademark
Judges.

By the Board:

The above-captioned proceedings were consolidated on January 22, 2008. The discovery period closed on October 10, 2008. This case now comes up on plaintiff's fully briefed motion, filed November 7, 2008, for summary judgment in its favor on its priority of use and likelihood of confusion claim, asserted in each proceeding.

Opposition No. 91180742

Defendant seeks to register the following mark



for "restaurant, catering, snack bar and café services; provision
of prepared food; food and drink preparation and presentation

services; bar services; catering services for the provision of food and drink; preparation of food stuffs or meals for consumption off the premises; sandwich and salad bar services; wine bar services" in Class 43.¹ Also, the application originally included, and was published for, goods in Classes 29 and 32. The notice of opposition addressed these classes, as well as defendant's Class 43 services. The two goods classes subsequently were deleted, however, and we address this subject *infra*.

As grounds for the opposition, plaintiff alleges that defendant's mark, when used in connection with the recited goods and services, so resembles plaintiff's previously used and registered marks as to be likely to cause confusion, mistake or to deceive.

Plaintiff pleads ownership of the following marks: CRUSH for "non-alcoholic, maltless beverages and concentrates and compounds for making same";² ORANGE CRUSH for "non-alcoholic, maltless orange-flavored beverages and concentrates and compounds for making same";³ CRUSH for "shorts, visors, jackets, caps";⁴

¹ Application Serial No. 79033050, filed on October 10, 2006 as a request for extension of protection pursuant to Trademark Act §66(a).

² Registration No. 0187791, issued on August 12, 1924, claiming a date of first use anywhere and a date of first use in commerce of 1915. Fourth renewal.

³ Registration No. 0683361, issued on August 11, 1959, claiming a date of first use anywhere and a date of first use in commerce of June 15, 1916. Second renewal.

⁴ Registration No. 1424931, issued on January 13, 1987, claiming a date of first use anywhere and a date of first use in commerce of January 1, 1985. First renewal.

 for "soft drinks and concentrates for making the same";⁵ CRUSH for "soft candies";⁶ CRUSH for "confectionery, namely candy";⁷ and  for "cosmetic products, namely lip balm and lip gloss."⁸ For each pleaded registration, plaintiff attached to its notice of opposition a printout of information from the electronic database records of the USPTO showing the current status and title of the registration. Accordingly, such registrations are received into evidence and are made part of the record for all purposes of this proceeding. Trademark Rule 2.122(d)(1).

In its answer, defendant denies the salient allegations of the notice of opposition.

A. Judgment entered against defendant as to Classes 29 and 32

The opposition proceeding commenced on November 12, 2007 with the filing of the notice of opposition against all three published classes. Trademark Rule 2.101(a). On March 20, 2008, the International Bureau ("IB") transmitted to the USPTO a "Restriction of Protection of Goods and Services in an International Registration," by which the USPTO was notified that

⁵ Registration No. 2418265, issued on January 2, 2001, claiming a date of first use anywhere and a date of first use in commerce of June 1, 1999. Trademark Act §8 accepted, §15 acknowledged.

⁶ Registration No. 2536979, issued on February 5, 2002, claiming a date of first use anywhere and a date of first use in commerce of September 1999. Trademark Act §8 accepted, §15 acknowledged.

⁷ Registration No. 2895772, issued on October 19, 2004, claiming a date of first use anywhere and a date of first use in commerce of October 31, 1999.

⁸ Registration No. 3209282, issued on February 13, 2007, claiming a date of first use anywhere and a date of first use in commerce of August 10, 1981.

Classes 29 and 32 had been "removed" from the International Registration upon which the involved extension of protection is based. As a consequence, the USPTO deleted the goods identified in Classes 29 and 32 from the extension application involved herein.

In view of the modification of both defendant's International Registration and extension application after commencement of the opposition, plaintiff requests that judgment be entered against defendant as to Classes 29 and 32.

Trademark Rule 2.135 provides that if, in an *inter partes* proceeding, the applicant files an abandonment without the written consent of every adverse party to the proceeding, judgment shall be entered against applicant.

In view thereof, and because plaintiff's written consent to the effective abandonment of two classes in the extension application is not of record, judgment is hereby entered against defendant in Classes 29 and 32 only, the opposition is sustained and registration to applicant is refused for those classes.

B. Priority and standing

Insofar as plaintiff has introduced printouts from the USPTO's electronic database records showing that its pleaded registrations are valid and subsisting and are owned by plaintiff, priority is not an issue with respect to the opposition proceeding, and plaintiff has proven its standing. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400,

182 USPQ 108, 110 (CCPA 1974). See also *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); and *Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Cancellation No. 92048446

Defendant is the owner of the registered mark shown below for the same Class 43 services as listed in the opposed extension application.⁹

CRUSSH

As grounds for the petition to cancel, plaintiff alleges priority of use and likelihood of confusion. Plaintiff alleges ownership of the same registered marks pleaded in its notice of opposition, *supra*. Plaintiff attached to its petition to cancel a printout of information from the USPTO's electronic database records showing the current status and title of each registration. Each registration is valid and subsisting and is owned by plaintiff. The registrations are received into evidence and are part of the record for all purposes of this proceeding. Trademark Rule 2.122(d)(1). Just as in the opposition, plaintiff's proof of its pleaded registrations is sufficient to prove its standing in the cancellation case.

⁹ Registration No. 3275548, issued on August 7, 2007 pursuant to Trademark Act §66(a). It appears the application resulting in this registration was filed just in the one services class.

In its answer, defendant admits that it has not used the mark in the United States.¹⁰ Defendant otherwise denies the salient allegations of the petition to cancel.

Plaintiff's summary judgment motion¹¹

Plaintiff's summary judgment motion is supported by three declarations. Andrew D. Springate, senior vice president of brand marketing for plaintiff's parent corporation describes, among other things, the plaintiff's history, plaintiff's CRUSH brand today,¹² and his knowledge of the market and relatedness of the parties' goods and services. Laura Popp-Rosenberg, plaintiff's attorney, introduces, among other things, copies of defendant's responses to plaintiff's written discovery requests, a printout from defendant's website, the results of her searches of the USPTO's TESS database (limited to live applications or registrations filed under Section 1(a) of the Trademark Act) showing the existence of such applications and registrations including both goods in Classes 29, 30 and 32, and "restaurant, catering, snack, bar or café" services in Classes 42 and 43; and

¹⁰ Paragraph No. 9 of defendant's answer to the petition to cancel.

¹¹ Plaintiff submitted its summary judgment motion and its reply brief under seal and, appropriately, filed redacted copies for the public record. See TBMP §412.04 (2d ed. rev. 2004). Defendant submitted its response under seal but has not yet submitted a redacted copy for the public record. Defendant is allowed until **THIRTY DAYS** from the mailing date of this order in which to submit a redacted version, failing which the Board may make defendant's response part of the public record. Both parties have submitted evidence under seal pursuant to the protective order in place. See Trademark Rule 2.27(e) and 2.120(f). The Board has taken all materials into consideration in its determination herein even though some evidence is not specifically discussed, in accordance with its designation as confidential or proprietary.

¹² Among other things, Mr. Springate introduces evidence of channels of trade, sales volume, sales figures, licensing, advertising and promotion, consumer awareness, and policing of the trademark.

her search of the TESS database for registered marks in Classes 5, 30 and 32 including the term CRUSH. As to the latter, Ms. Popp-Rosenberg states that, other than plaintiff's registered marks, there were no other CRUSH-inclusive marks registered in such classes. Mario Ortiz, a paralegal with plaintiff's law firm, introduces the results of his Internet searches and his in-store investigations showing multiple third-party brands used in connection with both beverage or food products sold in stores and other retail venues and restaurant services.¹³

In support of its motion, plaintiff argues that it is undisputed that it has prior rights in the CRUSH marks. Plaintiff explains that ORANGE CRUSH soda was invented in Chicago in 1906; that two individuals partnered to form the Orange Crush Company in 1916; and that the CRUSH mark has been used on a variety of licensed goods since at least as early as 2003. Mr. Springate states that "CRUSH soda has been marketed nationwide since at least as early as the mid-1920's."¹⁴ Plaintiff points out that defendant admits it has not yet used its CRUSH marks in connection with any goods or services in the United States and, thus, the earliest date upon which defendant may rely is October 5, 2006, *i.e.*, the filing date of the earlier of its

¹³ The brands introduced are: BEN & JERRY'S; BOB EVANS; BOSTON MARKET; CARVEL; CALIFORNIA PIZZA KITCHEN; DUNKIN' DONUTS; GODIVA; HAAGAN-DAZS; HOOTERS; MARGARITAVILLE; MRS. FIELDS; NATHAN'S FAMOUS; STARBUCKS; TACO BELL; T.G.I. FRIDAY'S; WHITE CASTLE; and WOLFGANG PUCK.

¹⁴ Springate declaration paragraph No. 6.

International Registrations, which formed the basis for the application that matured into U.S. Registration No. 3275548.

Plaintiff argues that the parties' respective marks are confusingly similar in sight, sound, connotation and commercial impression, with the word portions of the parties' marks being virtually identical. Plaintiff contends that the design element in defendant's opposed mark and the stylization of some of plaintiff's marks do not negate the similarities of those marks. Plaintiff contends that its marks are distinctive, strong and famous; that its marks are used extensively, being sold in virtually every channel of trade in which consumers would expect to find soda; that its marks have been in use for over a century, contributing to their renown; and that advertising of its marks has extended to all types of media. Plaintiff contends that its goods and defendant's services are related, pointing out that defendant originally sought to register its CRUSSH and design mark for specific beverage products, and relying on the evidence introduced by Ms. Popp-Rosenberg and Mr. Ortiz, and the statement of Mr. Springate indicating that plaintiff's A&W and STEWART'S brands are used both on soda and in connection with casual and fast food restaurants. Plaintiff contends that the trade channels and consumers are the same and overlap.

Defendant's response is supported by three declarations and accompanying exhibits. James Learmond, defendant's founder, chairman and a director, describes defendant's history,

development and concept;¹⁵ admits defendant has not yet opened a restaurant/juice bar in the United States but confirms defendant's intent to do so; introduces, among other things, on-line dictionary definitions of the word "crush," indicating one of its meanings to be "to extract or obtain by pressing or squeezing: crush juice from a grape"; Internet printouts showing that of some recipes for "crush" cocktails (e.g., grape crush drink, blueberry crush); Internet printouts showing that some blenders sold to make smoothies are referred to as "crush drink blenders"; and his statements that "... the ORANGE CRUSH brand is not known in the United Kingdom," that he had "... never heard of ORANGE CRUSH brand soda as a consumer," that "FANTA is the best known orange soda in Europe," and that "[i]n the U.K., orange soda is commonly referred to as 'orange squash' or 'orangeade'."

Defendant submitted two declarations of William C. Wright, defendant's attorney. Mr. Wright introduces numerous Internet printouts, including those from plaintiff's website, copies of plaintiff's responses to some of defendant's discovery requests, and copies of images for some of the logos for various orange soda products sold in the United States. Mr. Wright's second declaration is submitted under seal. Its content may generally

¹⁵ More specifically, Mr. Learmond indicates that defendant opened its first location in England in 1998; has expanded to twenty-four establishments in the United Kingdom (UK) since then, forming the largest chain of juice and food bars in the UK; that its stand-alone restaurants sell seasonal, healthy food and beverages to health conscious consumers; and that its products are made to order.

be described as copies of two confidential documents produced by plaintiff.

In its response, defendant argues that the parties' respective marks differ in sight and sound, with defendant's marks having a playful look and sound because the second "s" suggests that the "sh" sound may continue. Defendant argues that the parties' marks also differ in connotation and commercial impression, with its marks suggesting crushed fruit, crushed ice or blenders¹⁶ while plaintiff's marks are weak, being composed in whole of a term that identifies the nature of the drink with some marks also including a term which describes the flavor of the drink.¹⁷ Defendant disputes plaintiff's position that its marks are famous, even while acknowledging that plaintiff's trademark may have been in use since the early 1900's, on the basis that consumers today do not recognize either ORANGE CRUSH or CRUSH as famous. Defendant argues that plaintiff provided no evidence of fame for its CRUSH marks and what evidence it did provide is directly relevant only to its ORANGE CRUSH marks and appears

¹⁶ Any arguments by defendant as to how plaintiff displays its marks in the market place are of little probative value insofar as plaintiff has registrations for CRUSH and ORANGE CRUSH in standard character form. Thus, plaintiff is not limited to the form in which its registered marks may actually be displayed. See Trademark Rule 2.52(a).

¹⁷ The Board regards defendant's arguments that the terms CRUSH and ORANGE CRUSH are "descriptive" as arguments asserting that the marks are weak and entitled to a narrow scope of protection, and not as a collateral attack on opposer's pleaded registrations. See *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563 (CCPA 1973). Any actual argument that plaintiff's registered marks are descriptive is unavailable absent a compulsory counterclaim to cancel such registrations. The Board notes, too, that at least some of the registrations are incontestable and, thus, cannot be cancelled on a claim that the term is descriptive. Trademark Act §§14 and 15.

stale. Defendant argues that the goods and services are distinguishable because its restaurants sell healthy food and beverages to health-conscious consumers while carbonated soda, plaintiff's goods, are considered to be unhealthy. Defendant argues that the channels of trade differ because, as it does in the UK, defendant intends to offer its services as stand alone restaurants while plaintiff offers its goods in other venues such as big-box merchandisers, supermarkets, grocery stores, and vending machines (among others). Defendant states it does not offer any juice products through third-party retailers because to do so would require pasteurization, which defendant finds unacceptable given the concept of its services. Defendant does not believe there will be cross over consumers for the respective goods and services because health conscious consumers find soda inherently unhealthy.

Defendant argues that plaintiff has not established the unique considerations for finding likelihood of confusion between food and/or beverages and restaurants. Relying on the holdings of *Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993) and *Jacobs v. International Multifoods Corp.*, 668 F.2d 1234, 212 USPQ 641 (CCPA), defendant argues that plaintiff has failed to show "something more than that similar or even identical marks are used for food products and for restaurant services." More particularly, defendant

argues that plaintiff has failed to show that 1) the parties' marks are identical and 2) plaintiff's marks are famous.

In reply, plaintiff argues that it has established the absence of any genuine issues of material fact with respect to its standing, priority, and likelihood of confusion and that it is entitled to judgment as a matter of law. Plaintiff remarks that the cases relied upon by defendant simply confirm that all the *DuPont* factors¹⁸ are to be considered in cases involving food products and restaurant services, as they are to be considered in every likelihood of confusion case. Plaintiff points out that defendant's recited services are broader than the aspect of its services (restaurants) defendant discusses; that respondent has no limits on its recitations as to channels of trade or intended consumers; and that respondent's services focus on beverage products, making "the beverage-centric restaurant services" more closely related to plaintiff's goods. Defendant relies upon *In re Coors Brewing Co.*, 68 USPQ2d 1059 (Fed. Cir. 2003) for its finding that beer and restaurant services are not related, based on the evidence presented in that case. Plaintiff, however, argues that the court concluded that the "case would be different ... if the registrant's mark had been for a brewpub or for a restaurant services and beer. In that case, the goods and services associated with the two marks would clearly be related

¹⁸ *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563 (CCPA 1973).

and the case for a likelihood of confusion therefore much stronger." *Coors Brewing Co.*, 68 USPQ2d at 1064. Plaintiff argues that the facts of these consolidated proceedings fall within the scope discussed by the court because defendant's services focus on the beverages.

On a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issue of material fact and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56. A genuine dispute with respect to a material fact exists if sufficient evidence is presented that a reasonable fact finder could decide the question in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts as to whether any particular factual issues are genuinely in dispute must be resolved in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

A. Priority

In view of Mr. Springate's statement that "CRUSH soda has been marketed nationwide since at least as early as the mid-1920's," defendant's several admissions that it has not yet used the mark in the United States, and defendant's constructive use date of no earlier than October 5, 2006, there is no genuine issue as to priority with respect to the cancellation proceeding.

As to the opposition proceeding, and as discussed earlier in this order, as a matter of law, priority is not in issue, but even if it were, or to the extent plaintiff is relying on use of its marks as opposed to registration of them, the record shows no genuine issue as to plaintiff's priority. Accordingly, plaintiff's motion for summary judgment is **granted** in its favor with respect to the issue of priority.

B. Likelihood of confusion

After consideration of the parties' submissions and arguments, we find that genuine issues of material fact exist with respect to the similarities of the parties' respective marks, the strength of the involved marks¹⁹ and the relatedness of the parties' involved goods and services.

Accordingly, plaintiff's motion for summary judgment is **denied** with respect to the issue of likelihood of confusion.

Proceedings are resumed. Trial dates are reset as follows:

THE PERIOD FOR DISCOVERY TO CLOSE:	CLOSED
30-day testimony period for party in position of plaintiff to close	April 1, 2009
30-day testimony period for party in position of defendant to close:	May 31, 2009

¹⁹ The Board notes in passing that there is conflicting evidence with respect to the strength of the term CRUSH, particularly in view of plaintiff's showings and the meanings of the term, including the dictionary meaning of the term as follows: "2. To extract or obtain by pressing or squeezing [*crush juice from tomatoes.*"] See Webster's II New Riverside University Dictionary 332 (1984). The Board may take judicial notice of dictionary definitions. See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

15-day rebuttal testimony period
to close:

July 15, 2009

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.
