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

Proceeding	91213527
Party	Defendant Greater Omaha Packing Co., Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Omaha Steaks International, Inc.
Plaintiff
v.
Greater Omaha Packing Co., Inc.
Defendant

Opposition No. 91213527 (Parent)
Cancellation No. 92059629
Cancellation No. 92059455

DEFENDANT GREATER OMAHA PACKING CO., INC.’S MAIN BRIEF

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2. Identification of Parties and Nature of Cases

This is a consolidated proceeding involving:

(a) Opposition No. 91213527, filed by Omaha Steaks International, Inc. of Omaha, Nebraska (hereafter called “Plaintiff OSI”) against Greater Omaha Packing Co., Inc. of Omaha, Nebraska (hereafter called “Defendant GOP”) involving Application Ser. No. 85897951 for the following mark (hereafter called the “Steer Head Logo”);



(b) Cancellation No. 92059455, filed by Plaintiff OSI against Defendant GOP involving Registration No. 4006768 for the following mark (hereafter called the “Omaha Natural Angus Logo”); and



(c) Cancellation No. 92059629, filed by Plaintiff OSI against Defendant GOP involving Registration No. 3998763 the following mark (hereafter called the “1881 Omaha Hereford Logo”).



The central issue in all of the proceedings is the likelihood of confusion. Cancellation No. 92059455 involving the Omaha Natural Angus Logo also includes Defendant GOP’s affirmative defenses of laches and acquiescence.

3. Description of the Record

The record is summarized in the following table:

Date	Description	TTABVue
11/15/2013	Plaintiff OSI’s Notice of Opposition	1
06/26/2014	Plaintiff OSI’s two Petitions for Cancellation	1
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Date	Description	TTABVue
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4. Issues Presented

The central issue in these consolidated proceedings is whether Defendant GOP's three marks, as shown in its published application and its two registrations, so resemble Plaintiff OSI's marks of record as to be likely to cause confusion, or to cause mistake, or to deceive. § 2(d) of the Trademark Act.

A related issue in Cancellation No. 92059455 is whether Plaintiff OSI's undue delay before filing the petition for cancellation constituted acquiescence and/or laches. § 19 of the Trademark Act.

5. Facts

Defendant GOP's evidence of record consists of five notices of reliance and four testimonial depositions (including their exhibits). Defendant's evidence establishes the following facts. In 1920, Defendant GOP's predecessor was formed as an unincorporated company in Omaha, Nebraska by Herman Cohen using the business name "Greater Omaha Packing Company." (42 TTABVue 18-19/Davis Depo. at page 17, line 18 to page 18, line 1). In 1956, Herman Cohen and Pennie Z. Davis, the owners of Greater Omaha Packing Company, formed a Nebraska corporation called "Greater Omaha Packing Co., Inc." at the same Omaha, Nebraska location. (27 TTABVue 1-34/Defendant's Second

Notice of Reliance, NR-1, Bates No. GOP-1004, and NR-2, Bates Nos. GOP-1005-1034). Simultaneously, Herman Cohen and Pennie Z. Davis sold all of the assets of the unincorporated business called Greater Omaha Packing Company to the newly formed Greater Omaha Packing Co., Inc. (42 TTABVue 46-48/Davis Depo. at page 45, line 8 to page 47, line 8, and especially Exhibit GOP-64 which is 42 TTABVue 164-167). Defendant GOP and its predecessor continuously used the “Greater Omaha Packing Company” company name in the beef business in Omaha, Nebraska from 1920 to the present. (42 TTABVue 15 and 63/Davis Depo. at page 14, lines 12-20; and page 62, lines 8-12; and 30 TTABVue/Defendant’s Fourth Notice of Reliance in its entirety).

Defendant GOP and its predecessor continuously used the GREATER OMAHA trademark on hanging beef from approximately 1920 to 2000. (42 TTABVue 38-39/Davis Depo. at page 37, line 16 to page 38, line 23). Defendant GOP also continuously used the GREATER OMAHA trademark on boxed beef from at least as early as 1983 to 1992. (39 TTABVue 15-16/Fili Depo. at page 14, line 13 to page 15, line 14). In addition, Defendant GOP continuously used the GREATER OMAHA (with steer head design) trademark on boxed beef from 1992 to the present (i.e. at least to the March 16, 2016 date on which Defendant’s witness Angelo Fili testified). Angelo Fili testified that Defendant used the GREATER OMAHA (with steer head design) trademark shown in Exhibit GOP-10 (39 TTABVue 115-120) from 1992 until at least July, 2014. (39 TTABVue 34/Fili Depo. at page 33, lines 2-24). Angelo Fili testified that Defendant used the GREATER OMAHA (with steer head design) trademark shown in Exhibit GOP-24 (39 TTABVue 159) from at least as early as February, 2014 to the present. (39 TTABVue 68-70/Fili Depo. at page 67, line 14 to page 69, line 1).

Defendant GOP continuously sold beef to Plaintiff OSI from 1966 to the present. (28 TTABVue 4/Defendant’s Third Notice of Reliance NR-5, Request No. 8 – Admitted, Bates No. GOP-1043). Defendant GOP also continuously used the GREATER OMAHA (with steer head design) trademark on boxed beef sold to Plaintiff OSI from 1992 to at least July, 2014. (39 TTABVue 34-35/Fili Depo. at page 33, line 25 to page 34, line 9). In addition, Defendant GOP continuously sold Omaha Natural Angus

Logo-branded Angus beef to Plaintiff OSI from approximately 2006 to at least 2014. (39 TTABVue 51-52/Fili Depo. at page 50, line 24 to page 51, line 4).

In addition to Defendant GOP's one application and two registrations which are involved in this consolidated proceeding, Defendant GOP made of record its Registration No. 4690144 for GREATER OMAHA, claiming use since at least as early as 1992. (27 TTABVue 35-37/Defendant's Second Notice of Reliance NR-3, Bates Nos. GOP-1035-1037). Defendant GOP also made of record its Registration No. 4721723 for OMAHA NATURAL ANGUS BY GREATER OMAHA PACKING CO., claiming use since January 13, 2015. (27 TTABVue 38-40/Defendant's Second Notice of Reliance, NR-4, Bates Nos. GOP-1038-1040).

From 1992 to 2015, Defendant GOP sold and shipped beef in containers bearing the GREATER OMAHA (with steer head design) trademark, resulting in annual revenues increasing from in excess of \$100,000,000 (in 1992) to in excess of \$1,700,000,000 (in 2015). (42 TTABVue 65-66/Davis Depo. at page 64, line 3 to page 65, line 13). From 1992 to 2015, Defendant required its customers to make minimum purchases of 10,000 pounds, which means that minimum purchases were not less than \$10,000. (39 TTABVue 73-74/Fili Depo. at page 72, line 22 to page 73, line 20).

Omaha, Nebraska has long been a city "which is known for its beef." (31 TTABVue 8-20/Defendant's Fifth Notice of Reliance, NR-43 through NR-48, Bates Nos. GOP-1138-1150). Omaha is the largest city in Nebraska. (28 TTABVue 5/Defendant's Third Notice of Reliance, NR-5 - Request No. 18 - Admitted, Bates No. GOP-1044). Omaha, Nebraska was a large meatpacking industry center from approximately 1955 to approximately 1991. (28 TTABVue 5/Defendant's Third Notice of Reliance, NR-5 - Request No. 20 - Admitted, Bates No. GOP-1044). Defendant GOP and its predecessor have been located in Omaha, Nebraska for all of their 96 years of existence. (42 TTABVue 62-63/Davis Depo. at page 61, line 22 to page 62, line 1). Plaintiff OSI and its predecessor have always been located in Omaha, Nebraska. (28 TTABVue 4/Defendant's Third Notice of Reliance, NR-5 - Request No. 12 - Admitted, Bates No. GOP-1043). At least one of the reasons why the word "Omaha" in Plaintiff OSI's mark was

originally chosen by Plaintiff was because Plaintiff was located in Omaha, Nebraska. (28 TTABVue 4/Defendant's Third Notice of Reliance, NR-5 – Request No. 14 – Admitted, Bates No. GOP-1043). Plaintiff OSI does not own any federal trademark registrations (and has never filed any applications) for the word “Omaha” as a single word trademark. (28 TTABVue 14/Defendant's Third Notice of Reliance, NR-6 – Requests 23 and 24 – Admitted, Bates No. GOP-1053). Many companies in food-related businesses, that are located in Omaha, Nebraska, use the name “Omaha” in their company names or in their trademarks. (40 & 41 TTABVue 1-165 & 1-70/Peetz Depo. in its entirety including its exhibits). The geographical city name “Omaha” has been disclaimed in at least 118 third party trademark registrations and applications. (29 TTABVue 1-243/Defendant's First Notice of Reliance, Bates Nos. GOP-0773 – 0776 and the following 118 TESS printouts).

Plaintiff OSI admitted in many different ways that Plaintiff is not aware of any evidence of actual confusion between the parties' marks. (28 TTABVue 3, 6 & 12/ Defendant's Third Notice of Reliance, NR-5, Request Nos. 1, 32, 33 – Admitted, Bates Nos. 1042 and 1045, and NR-6, Request No. 1 – Admitted, Bates No. 1051). Defendant GOP's witnesses Henry Davis and Angelo Fili both testified that they had never observed or heard of any instances of actual confusion as to source. (42 TTABVue 70/Davis Depo. at page 69, line 8 to page 70, line 4; and 39 TTABVue 80/Fili Depo. at page 79, lines 7-17).

Plaintiff OSI did not offer any admissible evidence showing significant use, sales or advertising of any of Plaintiff's marks. Plaintiff OSI did not offer any admissible evidence showing that any of its marks have become strong or famous. *See*, Appendix - Separate Statement Regarding Evidentiary Objections, attached to this brief beginning on page 55.

Plaintiff OSI's Main Brief sets forth in the first paragraph on page 12 (48 TTABVue 17) the alleged “Factual Background” on which Plaintiff relies as the evidence in support of the arguments made in its Main Brief. Plaintiff's Main Brief alleges that "Omaha Steaks International, Inc. ("Omaha Steaks") has grown from its humble 1917 beginnings to a nationwide presence. Todd Simon Dep. 4:2-19." However, Todd Simon said nothing in his testimony (33 TTABVue 133/Todd Simon Dep. at page 4)

about a “nationwide presence.” Plaintiff’s Brief continues in the first paragraph on page 12 with many alleged facts that are supposedly supported by Todd Simon’s testimony at “Todd Simon Dep. At 99:1-102:13.” However, Todd Simon's entire testimony at 33 TTABVue 228-231/Todd Simon Depo. at pages 99-102 concerned the Exhibit 9 plaque, and Defendant GOP objected to both Exhibit 9 and to Todd Simon’s testimony relating to Exhibit 9 on the grounds of hearsay, lack of personal knowledge and speculation. Furthermore, during the Todd Simon deposition, Defendant GOP objected to all of Todd Simon’s testimony and exhibits relating to advertising, marketing and length of time that Plaintiff OSI has used its trademark and/or been in business, on the same grounds of hearsay, lack of personal knowledge and speculation. Defendant GOP’s objections are specified in the attached Appendix - Separate Statement Regarding Evidentiary Objections.

6. Argument

The evidence clearly shows that there is no likelihood of confusion in any of the three cases because of (a) the strikingly different appearances of the parties’ respective marks; (b) the fact that the only significant commonality between the parties’ respective marks is the well-known geographically descriptive city name “Omaha;” (c) the large number of third party uses of marks and company names which include the city name “Omaha;” (d) Defendant GOP and its predecessor’s continuous use of GREATER OMAHA as a trademark for beef for 96 years (from 1920 to the present); (e) Defendant GOP’s continuous use of GREATER OMAHA (with steer head design) as a trademark for beef for at least 22 years (from 1992 to at least July, 2014); (f) Defendant GOP and its predecessor’s continuous use of the two words “Greater Omaha” in their company names for 96 years (from 1920 to the present); (g) Defendant GOP and its predecessor’s continuous location of its headquarters and all of its buildings in the city of Omaha for 96 years (from 1920 to the present); (h) the large number (118) of third party registrations and applications of marks in which the geographically descriptive city name “Omaha” has been disclaimed; (i) the sophistication of both parties’ customers and the care with which they make their purchases of both parties’ expensive products; (j) Plaintiff OSI’s purchasing of GREATER OMAHA-

trademarked beef from Defendant GOP for at least 47 years (from 1966 to 2013) without any objection by Plaintiff to Defendant GOP's use of the GREATER OMAHA trademark; and (k) the absence of any evidence of actual confusion as to source.

In addition, the evidence shows that Plaintiff OSI's undue delay in filing its petition for cancellation of Registration No. 4006768 for the Omaha Natural Angus Logo constitutes laches and/or acquiescence.

Plaintiff bears the burden of proof on the issue of likelihood of confusion in both opposition and cancellation proceedings. *Hoover Co. v. Royal Appliance Mfg. Co.*, 238 F.3d 1357, 57 USPQ2d 1720, 1722 (Fed. Cir. 2001); *Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989).

There is a generally accepted method of analyzing the likelihood of confusion issue, by applying a number of different "factors" to the totality of the facts of the case. In the Federal Circuit, the *duPont* factors are used, and the PTO applies the *duPont* factor test in the adjudication of contested cases. *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

We shall now apply the facts, as shown in the record, to the *duPont* factors, and then argue that, upon a consideration of all of the evidence, there is no likelihood of confusion as to any of the three marks at issue.

I. The Opposition - Defendant GOP's Steer Head Logo



OMAHA STEAKS

Factor 1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

1.1. Appearance - There is a tremendous visual difference between the appearance, in their entirety, of Defendant GOP's Steer Head Logo mark and Plaintiff OSI's OMAHA STEAKS mark. Defendant GOP's opposed Steer Head Logo mark contains three elements.

The first element is the large and prominent ferocious-looking steer head design, which is completely unlike any aspect of Plaintiff OSI's OMAHA STEAKS mark. Plaintiff OSI's OMAHA STEAKS mark does not include a steer head (or any remotely similar graphical element), whereas Defendant's steer head is the largest and first-seen element of Defendant GOP's Steer Head Logo mark.

The second element in large bold print is the two sequential words GREATER OMAHA. Plaintiff OSI's OMAHA STEAKS mark does not include the word GREATER which is the first textual word in Defendant GOP's Steer Head Logo mark.

The third element in smaller print is the five words PROVIDING THE HIGHEST QUALITY BEEF. Those five words are completely unlike any aspect of Plaintiff OSI's OMAHA STEAKS mark.

The only visual component which is common to the parties' respective marks is the word OMAHA.

Plaintiff OSI's OMAHA STEAKS mark does not include any graphics or words which are remotely similar to Defendant GOP's mark's graphics and words, except for the geographically descriptive city name "OMAHA."

Plaintiff's testimonial witness Todd Simon admitted that Plaintiff had never used a design of a steer head in any trademark; and had never used the words GREATER OMAHA in any trademark; and had never used the words PROVIDING THE HIGHEST QUALITY BEEF in any trademark. (33 TTABVue 235/Plaintiff's Todd Simon Depo. page 106, lines 4-18).

The test for likelihood of confusion is whether Defendant GOP's Steer Head Logo mark, in its entirety, is likely to cause confusion with Plaintiff OSI's OMAHA STEAKS mark, in its entirety. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Mason Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). In

their entireties, there is virtually no similarity of appearance between Defendant GOP's and Plaintiff OSI's marks.

Therefore, an application of the *duPont* appearance factor to the evidence results in a conclusion that Defendant GOP's Steer Head Logo mark and Plaintiff OSI's OMAHA STEAKS mark, when compared in their entireties, have such dissimilar appearances that this factor strongly favors Defendant GOP.

1.2. Sound - Defendant GOP's opposed mark contains the seven pronounceable words GREATER, OMAHA, PROVIDING, THE, HIGHEST, QUALITY and BEEF, consisting of 15 syllables. Plaintiff OSI's OMAHA STEAKS mark contains the two pronounceable words OMAHA and STEAKS, consisting of four syllables. In their entireties, there is virtually no similarity of sound between the two parties' marks.

Therefore, applying the *duPont* sound factor to the evidence results in a conclusion that Defendant GOP's Steer Head Logo mark and Plaintiff OSI's OMAHA STEAKS mark are so dissimilar regarding sound that this factor strongly favors Defendant GOP.

1.3. Connotation (meaning) - Defendant GOP's opposed mark prominently presents to the customer the image of a large ferocious-looking steer head with horns. Then, in large bold letters, Defendant's opposed mark projects to the customer the two words GREATER OMAHA, in which the first word GREATER immediately follows and reinforces the image of the large ferocious-looking steer head with horns. The second word OMAHA connotes that Defendant is located in Omaha, Nebraska. Then, in smaller letters, Defendant's opposed mark displays the five words PROVIDING THE HIGHEST QUALITY BEEF. These five words (and especially the word BEEF) reinforce the prominent image of the steer head of a beef-producing steer. In contrast, Plaintiff OSI's OMAHA STEAKS mark does not include a steer's head design, or include a meaning similar to PROVIDING THE HIGHEST QUALITY BEEF. Instead, Plaintiff's mark denotes steaks (i.e. slices of meat) which come from Omaha, Nebraska.

The only similarity in meaning between the parties' marks is the connotation that the source of the goods is located in Omaha, Nebraska.

Omaha is the well-known name of the largest city in Nebraska. (28 TTABVUE 5/Defendant's Third Notice of Reliance, NR-5 – Request No. 18 – Admitted, Bates No. GOP-1044). Both parties have, and have always had, their headquarters in Omaha. (42 TTABVue 62-63/Davis Depo. at page 61, line 22 to page 62, line 1; and 28 TTABVue 4/Defendant's Third Notice of Reliance, NR-5 – Request No. 12, Admitted – Bates No. GOP-1043). Omaha is also well-known as a city which is known for its beef. (31 TTABVue 8-20/Defendant's Fifth Notice of Reliance, NR-43 through NR-48, Bates Nos. GOP-1138-1150). In its opposed application, Defendant GOP has disclaimed exclusive rights in the geographically descriptive city name OMAHA. Others in 118 registrations and applications have similarly disclaimed exclusive rights in the geographically descriptive city name OMAHA. (29 TTABVue 1-243/, Defendant's First Notice of Reliance, Bates Nos. GOP-0773-0776 plus 118 TESS printouts). As the Board stated in *Red Carpet Corp. v. Johnstown Enterprises Inc.*, 7 USPQ2d 1404, 1406 (TTAB 1988): "Because marks, including any suggestive portions thereof, must be considered in their entirety, the mere presence of a common, suggestive element in two marks is usually not enough support upon which to base a finding that confusion is likely. *Tektronix, Inc. v. Daktronics, Inc.*, 189 USPQ 693 (CCPA 1976)."

In the present case, the fact that the only common term "OMAHA" in the parties' respective marks is a well-known, geographically descriptive city name means that, when the parties' marks are considered in their entirety, customers will look to other distinguishing elements in the parties' marks as indicators of source, and the mere presence of the completely descriptive city name "OMAHA" in both parties' marks will not cause customers to become confused as to source.

Therefore, applying the *duPont* connotation factor to the evidence results in a conclusion that Defendant GOP's Steer Head Logo mark and Plaintiff OSI's OMAHA STEAKS mark have such dissimilar connotations in their entirety that this factor strongly favors Defendant GOP.

1.4. Commercial impression - *duPont* suggests that this factor is the sum of the conclusions of 1.1; 1.2; and 1.3 – Defendant GOP’s Steer Head Logo has a completely different appearance from Plaintiff OSI’s mark; and has a completely different sound from Plaintiff OSI’s mark; and has a completely different connotation from Plaintiff OSI’s mark.

Therefore, applying the *duPont* commercial impression factor to the evidence results in a conclusion that Defendant GOP’s and Plaintiff OSI’s marks create such dissimilar commercial impressions that this factor strongly favors Defendant GOP. This dissimilarity conclusion is so strong and overwhelming that the Board could properly decide to dismiss the opposition based on this factor alone, as the Board did in *Kellogg Co. v. Pack’em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (“We know of no reason why, in a particular case, a single *duPont* factor may not be dispositive.”) The Court of Appeals for the Federal Circuit, in *Oakville Hills Cellar, Inc. v. Georgallis Holdings, LLC*, 119 USPQ2d 1286, 1290 (Fed. Cir. 2016), recently affirmed the Board’s finding of no likelihood of confusion based solely on the first *duPont* factor, despite all of the other *duPont* factors’ favoring the opposer or being neutral. The Court of Appeals said: “As we have held, ‘a single *DuPont* factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks.’ *Odom’s Tenn. Pride Sausage, Inc. v. FF Acquisition, L.L.C.*, 600 F.3d 1343, 1346-47 (Fed. Cir. 2010).”

Plaintiff OSI, in its Main Brief, appears to rest its entire case against all three of Defendant GOP’s trademarks on the unsupported argument that, because all three of Defendant’s trademarks include the word “Omaha,” it simply follows that Defendant’s three trademarks will cause confusion as to source. However, when the only common term in the parties’ marks, i.e. “Omaha,” is highly geographically descriptive and inherently weak, customers are not likely to be confused as to source. A party which chooses an inherently weak trademark is entitled to only a narrow scope of protection. *Sure-Fit Products Co. v. Saltzon Drapery Co.*, 254 F.2d 158, 117 USPQ 295, 297 (CCPA 1958); *Bass Pro Trademarks LLC v. Sportsman’s Warehouse Inc.*, 89 USPQ2d 1844, 1857 (TTAB 2008).

Factor 2. The similarity or dissimilarity and nature of the goods or services.

Defendant GOP's goods, as identified in the opposed application, are "meat, including boxed beef primal cuts." Plaintiff OSI's goods, as stated in Plaintiff's OMAHA STEAKS registrations, include meat.

Therefore, applying the 2nd *duPont* factor to the evidence results in a conclusion that Defendant GOP's goods and Plaintiff OSI's goods are similar. This factor favors Plaintiff OSI.

Factor 3. The similarity or dissimilarity of established, likely-to-continue trade channels.

There are no limitations as to trade channels in either the opposed application or in a number of Plaintiff's registrations.

Therefore, applying the 3rd *duPont* factor to the evidence results in a conclusion that Defendant GOP's and Plaintiff OSI's trade channels are similar. This factor favors Plaintiff OSI.

Factor 4. The conditions under which, and buyers to whom, sales are made, i.e., impulse vs. careful, sophisticated purchasing.

Defendant GOP's trademarked beef products are purchased by careful and sophisticated customers. As Defendant's Executive Vice President Angelo Fili testified at 39 TTABVue 74-76 and 108-110/Fili Depo. at page 73, line 21 to page 75, line 16 and Exhibits GOP-1-3 with regard to the GREATER OMAHA mark and the three marks involved in this consolidated proceeding:

Q. Mr. Fili, please describe the type of customer that Defendant GOP has been selling its beef to under each and every one of its trademarks since 1992.

A. Our typical customers are careful in what they buy. They're very thoughtful of the products they bring into their facility. They're very sophisticated buyers and purveyors of beef products.

Q. Would you say they take little care or great care in deciding whether or not to make a purchase?

MS. KANE: Objection. Foundation.

Q. To the best of your own personal knowledge.

MS. KANE: Same objection.

A. I believe that our customers are very careful in what they purchase.

Q. Have you been involved with customers who make purchases?

A. Yes, I have been.

Q. Based on your own personal knowledge, would you say that your company's customers for its trademarked beef make quick and impulsive purchases?

A. No, they do not.

Q. Mr. Fili, does your description of your company's customers for its trademarked beef products apply to those customers purchasing Greater Omaha branded beef?

A. Yes, it does.

Q. Does your description of your company's customers apply to those customers purchasing beef products on or in connection with which the Exhibit GOP-2 trademark is used?

A. Yes, it does.

Q. Does your description of your company's customers apply to those customers purchasing beef on or in connection with which the Exhibit GOP-3 trademark is used?

A. Yes, it does.

Q. Does your description of your company's customers apply to those customers purchasing beef products on or in connection with which the Exhibit GOP-1 trademark is used?

A. Yes, it does.

As Defendant's President Henry Davis testified at 42 TTABVue 64-65/Davis Depo. at page 63, line 9 to page 64, line 2 regarding those marks:

Q. Based on your own personal knowledge gained from your communications with your company's customers, please describe the sophistication level of your company's customers who have been purchasing your company's beef products since 1973 under each and every one of your company's trademarks including the three trademarks at issue in this proceeding.

A. They are very sophisticated, knowledgeable buyers of beef and the markets. They understand the trade of beef. They understand the values of beef. A load of beef can range from \$80,000 to \$600,000. They make decisions based on relevant facts. They're well-thought-out decisions. They are -- they're a sophisticated group of buyers.

Q. Would you say that your company's customers make quick and impulsive purchases?

A. Never.

Both parties' trademarked products are relatively expensive, not cheap, items. As Defendant GOP's Executive Vice President Fili testified at 39 TTABVue 73-74/Fili Depo. at page 72, line 22 to page 73, line 20:

Q. Does Greater Omaha Packing Company have a minimum purchase requirement when it sells beef products to a customer?

A. Yes, we do.

Q. And what is that minimum purchase requirement?

A. 10,000 pounds.

Q. Very roughly, what is the minimum dollar amount that a purchase of 10,000 pounds of beef would cost?

A. If beef were a dollar a pound, that would be \$10,000. If it was \$3 a pound, it would be \$30,000.

Q. To the best of your knowledge, has Greater Omaha recently sold any beef at a price less than \$1 per pound?

A. No, we have not.

Q. Are you saying that your company currently requires that when each of your customers makes a purchase of beef under any of your company's trademarks, that the purchase total amount must be a minimum of at least \$10,000?

A. Yes, we do.

Similarly, Plaintiff OSI's products are purchased with care by sophisticated customers. Plaintiff OSI's Senior Vice President Todd Simon testified that the average consumer order for beef products "totals about \$110." (33 TTABVue 261/Plaintiff's Todd Simon Depo. at page 132, lines 19-23).

Thus, the evidence shows that the purchasing decisions by both parties' customers are serious, careful and well-considered. Selections and purchases of both parties' expensive beef products are not made on impulse, but rather are made only after substantial deliberation and a careful consideration of many factors. No competent evidence was introduced which even suggested that Defendant GOP's or Plaintiff OSI's customers made impulsive purchasing decisions.

Therefore, applying the 4th *duPont* factor to the evidence results in a conclusion that Defendant GOP's and Plaintiff OSI's customers and potential customers are sophisticated, careful and deliberate in making their purchasing decisions, and are totally unlike impulse purchasers of inexpensive unimportant goods. This factor strongly favors Defendant GOP.

Factor 5. The fame of the prior marks (sales, advertising, length of use).

Plaintiff OSI presented no admissible evidence of significant sales, advertising expenditures or length of trademark use in connection with OMAHA STEAKS-branded meat to customers (*See*, Appendix). It is only by presenting admissible evidence of extensive sales, advertising expenditures and long trademark use that Plaintiff could have sought to demonstrate that its mark has become famous or strong. However, Plaintiff did not present any such admissible evidence and therefore did not prove that its mark has become famous or strong in the minds of purchasers of meat.

On page 18 of Plaintiff's Brief (48 TTABVue 23), Plaintiff OSI inaccurately relies upon its own answer to Defendant's Request No. 12 that "Opposer (including its predecessor or predecessors) has been located in Omaha, Nebraska for approximately ninety-seven years" to inaccurately support the Plaintiff's claim in its Brief on page 18 that "Omaha Steaks and its predecessor companies have been in business for nearly 100 years." Obviously, a company's "location" is not the same as "being in business," and an unnamed company's location proves nothing about use of a particular trademark or the nature of any goods supposedly sold or distributed.

Also, on page 18 of Plaintiff's Brief (48 TTABVue 23), Plaintiff inaccurately claims that Todd Simon testified (at 33 TTABVue 228-231/Todd Simon Depo. at page 99, line 1 to page 102, line 13) that "Omaha Steaks has advertised its goods and services under the 'Omaha Steaks' mark since as early as 1958." However, instead of supporting the quoted claim in Plaintiff's brief, Todd Simon merely testified that he observed a plaque (the objected-to Exhibit 9) which contains language suggesting advertising of some type in *The New Yorker Magazine*. As stated in the Appendix to this brief, Defendant objected to Exhibit 9 on the grounds of hearsay and lack of authenticity. Indeed, all of Todd Simon's testimony

about Exhibit 9 was objected to on the grounds of hearsay, lack of personal knowledge and speculation, as well as on other grounds (such as Todd Simon's having been born considerably after 1958).

Of course, the fact that Plaintiff owns registration for the OMAHA STEAKS mark does not mean that the mark is strong, or is known at all to consumers in the marketplace, who are in all likelihood unaware (and uninterested) as to whether or not a mark is registered. The simple act of registration has no impact on public perception of a trademark, which is where the strength of a trademark is found. Registration alone is incompetent to establish the nature and extent of use. *Hyde Park Footwear Co., Inc. v. Hampshire-Designers, Inc.*, 197 USPQ 639, 641 (TTAB 1977). (“The registrations alone are incompetent to establish any facts with regard to the nature or extent of opposer’s use and advertising of its trademarks or any reputation they enjoy or what purchasers’ reactions to them may be.”)

In connection with a number of Plaintiff OSI’s registrations for OMAHA STEAKS, Plaintiff OSI filed affidavits under § 15 of the Trademark Act and, as a result, “the right of registrant to use such registered mark in commerce for the goods or services on or in connection with which such registered mark has been in continuous use for five consecutive years subsequent to the date of such registration and is still in use in commerce, shall be incontestable.” However, the fact that use of a mark is incontestable (a fact that is undoubtedly unknown to consumers) does not mean the mark has any marketplace strength. As stated in *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031, 1036 (TTAB 2010):

(opposer’s registration is not evidence of the nature and extent of opposer’s use and advertising of its mark and, thus, is not probative of consumer reaction to the mark no matter how long it has been registered). Accordingly, the fact that opposer’s federally-registered mark has achieved incontestable status means that it is conclusively considered to be valid, but it does not dictate that the mark is “strong” for purposes of determining likelihood of confusion. *McCarthy on Trademarks and Unfair Competition* §§ 11:82 and 32:155 (4th ed. 2009).

As Professor McCarthy states: “Thus, the true relative strength of a mark can only fully be determined by weighing two aspects of strength: (1) Conceptual Strength: the placement of the mark on the spectrum of marks: and (2) Commercial Strength: the marketplace recognition value of the mark. 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11:83 at 11-251 (4th ed. 2014).”

Because the OMAHA STEAKS mark was registered under Section 2(f) of the Act, Plaintiff OSI conceded that the mark is geographically descriptive and is not an inherently distinctive mark. *Cold War Museum Inc. v. Cold War Air Museum Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009) (“an applicant’s reliance on Section 2(f) during prosecution presumes that the mark is descriptive”). Therefore, under Professor McCarthy’s first aspect of strength, the OMAHA STEAKS mark is relatively weak, not strong. Furthermore, because Plaintiff OSI failed to present any admissible evidence of the marketplace recognition value of the mark, under Professor McCarthy’s second aspect of strength, the OMAHA STEAKS mark is weak, not strong.

Not only did the Plaintiff wholly fail to prove that the OMAHA STEAKS mark is famous or strong, but the evidence shows that the OMAHA STEAKS mark is an extremely weak mark because it is comprised of the well-known, geographically descriptive city name “Omaha,” coupled with the generic and disclaimed name of the goods “steaks.” Plaintiff OSI admitted that there has never been an adjudication by the PTO or by any federal or state court that Plaintiff’s mark is or was “famous.” (28 TTABVue 15/Defendant’s Third Notice of Reliance, NR-6, Request No. 37 – Admitted, Bates No. GOP-1054).

As shown by all of the facts set forth previously in the paragraph running from the bottom of page 8 to the top of page 9 of this brief, there is nothing distinctive about either of the two words OMAHA or STEAKS. There is nothing distinctive or arbitrary about the two-word combination OMAHA STEAKS, which literally means steaks from Omaha, just as IDAHO POTATOES means potatoes from Idaho, and FLORIDA GRAPEFRUITS means grapefruits from Florida. A weak trademark is not entitled to anything more than a narrow scope of protection. It is not entitled to broad protection. As the CCPA stated in 1958:

It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. The essence of all we have said is that in the former case there is not the possibility of confusion that exists in the latter case. *Sure-Fit Products Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 117 USPQ 295, 297 (CCPA 1958); *Accord, In re Hartz Hotel Services Inc.*, 102 USPQ2d 1150 (TTAB 2012).

The evidence shows that the term OMAHA STEAKS, rather than being “famous” or “strong,” is an extremely weak mark deserving only the narrowest scope of protection.

As pointed out in the objections set forth in the Appendix, Plaintiff OSI did not offer any admissible documentary or other evidence establishing Plaintiff’s specific amounts of sales of beef in the United States under its pleaded marks. Nor did Plaintiff OSI offer any admissible documentary or other evidence establishing Plaintiff’s specific amounts of advertising expenses for beef to customers in the United States under its pleaded marks. Plaintiff’s two lay witnesses, Todd Simon and Bruce Simon, testified, over Defendant GOP’s objections, that in a general sense Plaintiff’s sales and advertising of meat and many other different food products were considerable, but all such testimony, and all of the proffered exhibits, constituted objected-to opinions and speculation, and were based upon objected-to unauthenticated hearsay documents created by persons (some known and some unknown) who were not made available for cross-examination.

Plaintiff OSI’s two lay witnesses testified in general and unspecific terms, subject to Defendant’s objections, that Plaintiff’s trademarks have been widely advertised. Even if such objected-to alleged advertising could arguably have resulted in Plaintiff’s trademarks’ becoming somewhat familiar to an unknown number of customers, Plaintiff submitted no admissible evidence of any kind proving that any of Plaintiff’s trademarks have become well-known for meat to customers in the United States, and certainly no admissible evidence of any kind proving that any of Plaintiff’s trademarks have achieved any strength whatsoever for meat.

Plaintiff OSI admitted that at least one of the reasons why the word “Omaha” in its OMAHA STEAKS mark was originally chosen was because Plaintiff was located in Omaha, Nebraska. (TTABVue 4/Defendant’s Third Notice of Reliance, NR-5, Request No. 14 – Admitted, Bates No. GOP-1043). Plaintiff OSI admitted that it has never registered the single word OMAHA as a trademark. (28 TTABVue 14/Defendant’s Third Notice of Reliance, NR- 6, Request No. 23 – Admitted, Bates No. GOP-1053). Plaintiff OSI admitted that it has never even sought to register the single word OMAHA as a

trademark. (28 TTABVue 14/ Defendant's Third Notice of Reliance, NR- 6, Request No. 24 – Admitted, Bates No. GOP-1053). Plaintiff OSI offered no evidence of any kind that it ever used the single word OMAHA as a trademark. Therefore, Plaintiff cannot have established any trademark rights in the single word OMAHA. § 1 of the Trademark Act provides that only “[T]he owner of a trademark used in commerce may request registration of its trademark...” As stated in *Person's Co. Ltd. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1482 (Fed. Cir. 1990): “In *United Drug Co. v. Rectanus Co.*, 248 U.S. 90 (1918), the Supreme Court of the United States determined that ‘[t]here is no such thing as property in a trademark except as a right appurtenant to an established business or trade in connection with which the mark is employed.’” Accordingly, Plaintiff OSI has established no trademark or any other rights in the single word “Omaha.”

None of Plaintiff OSI's registrations for marks which include the two words “Omaha Steaks” were registrable without resort to reliance on § 2(f) of the Act, thereby conceding that the well-known geographically descriptive city name “Omaha” in its marks was not an inherently distinctive indicator of source. For the same reason, Defendant GOP has never registered any mark that includes the geographically descriptive city name “Omaha,” without disclaiming rights to that city name, apart from the entire mark.

As further evidence of the weakness of the geographically descriptive city name “Omaha,” Defendant GOP introduced into evidence 118 trademark registrations and applications for marks which have included the word “Omaha,” in which the geographically descriptive city name “Omaha” has been disclaimed because it is geographically descriptive. (29 TTABVue 1-243/Defendant's First Notice of Reliance, Bates No. GOP-0773-0776 and the following 118 TESS printouts).

Therefore, applying the 5th *duPont* factor to the evidence results in a conclusion that Plaintiff OSI's OMAHA STEAKS mark is definitely neither famous nor strong. Instead, it is an extremely weak mark entitled to only the narrowest scope of protection. Therefore, this factor strongly favors Defendant GOP.

Factor 6. The number and nature of similar marks in use on similar goods.

There are many companies currently located in Omaha, Nebraska that are using trademarks or trade names in which the first word is “Omaha.” Many such companies are in beef or food businesses. (40 & 41 TTABVue 1-165 & 1-70/Terri Peetz’ Deposition including its exhibits; and 31 TTABVue 20-51/ Defendant’s Fifth Notice of Reliance, NR-49 to NR-59, Bates Nos. GOP-1151-1184). When there are numerous similar marks in use by third-party sources in related fields, the plaintiff’s mark must be considered to be a weak source indicator that is entitled only to a narrow scope of protection. *Jack Wolfskin Ausrüstung für Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129 (Fed. Cir. 2015); *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

The Terri Peetz Deposition testimony and exhibits show third party uses of marks and company names containing the word OMAHA in connection with beef and other food. (40 & 41 TTABVue/Peetz Depo.). This extensive evidence of third party use of similar marks for the same or related goods establishes the marketplace weakness of Plaintiff’s OMAHA STEAKS mark.

In addition, Defendant’s testimony deposition witness Carol Mesenbrink testified that Defendant GOP sold beef to a company named Omaha Beef Company, Inc. (38 TTABVue 18-20/ Mesenbrink Depo. page 17, lines 3 to page 19, line 8; and 38 TTABVue 200-206/Mesenbrink Exhibits GOP-31 and 32, Bates Nos. GOP-432-434, 440, and 1125-1127). Ms. Mesenbrink also testified that Defendant GOP sold beef to a company named Omaha Meat Processors, Inc. of Omaha, Nebraska. (38 TTABVue 20-22/Mesenbrink Depo. page 19, line 9 to page 21, line 12; and 38 TTABVue 207-219/ Mesenbrink Exhibits GOP-33 and 34, Bates Nos. GOP-376-377, 398, and 1128-1137). Ms. Mesenbrink’s testimony and exhibits are further strong proof of third party uses of names similar to OMAHA STEAKS for similar goods.

Defendant GOP's evidence shows that typical buyers and potential buyers of beef and other food products have grown quite accustomed to seeing the city name "Omaha" used in trademarks and trade names for beef and food products by many third parties, all without any confusion as to source.

Therefore, when third parties (including Defendant GOP) use the term "Omaha," without following that descriptive city name term with the term "Steaks," in connection with beef products, customers and potential customers have been conditioned by such extensive third party use of the word "Omaha" to presume that the parties are located in Omaha, Nebraska. Consequently, such customers are not likely to become confused as to the specific source of the product involved merely because of the appearance of the word "Omaha."

The Federal Circuit has stated that "evidence of third-party use of similar marks on similar goods 'can show that customers have been educated to distinguish between different marks on the basis of minute distinctions.'" *Jack Wolfskin Ausrüstung für Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d, 1129, 1136 (Fed. Cir. 2015), quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015). Such evidence is "powerful on its face, even where the specific extent and impact of the usage has not been established."

In the present case, the evidence of third party use demonstrates that the term "Omaha Steaks" is conceptually weak as a source indicator for meat because the term "Omaha" is entirely geographically descriptive and is also the geographic location of a city "which is known for its beef." (31 TTABVue 8-20/ Defendant's Fifth Notice of Reliance, NR-43 through NR-48, Bates Nos. GOP-1138-1150). Of course, the disclaimed term "Steaks" is the generic description of slices of meat. Accordingly, the two-word term "Omaha Steaks" is conceptually weak and is, therefore, entitled to a "comparatively narrower range of protection." *Juice Generation*, 115 USPQ2d at 1674. As the Federal Circuit stated regarding third party uses in its recent *Juice Generation* opinion at pages 1674-1675:

As the Board understood, sufficient evidence of third party use of similar marks can "show that customers . . . 'have been educated to distinguish between different . . . marks on the basis of minute distinctions.'" 2 McCarthy on Trademarks and Unfair Competition § 11:88 (4th ed. 2015) (quoting *Standard Brands, Inc. v. RJR Foods, Inc.*,

192 U.S.P.Q. 383 (T.T.A.B. 1976)). More broadly, evidence of third-party use bears on the strength or weakness of an opposer's mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1373 (Fed. Cir. 2005). The weaker an opposer's mark, the closer an applicant's mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection. *Id.* ("Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection."); *In re Coors Brewing Co.*, 343 F.3d 1340, 1345 [68 USPQ2d 1059] (Fed. Cir. 2003) (third-party use can establish that mark is not strong); *Fleetwood Co. v. Mende*, 298 F.2d 797, 799 (CCPA 1962) ("Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights.")

....

The "specifics" as to the extent and impact of use of the third parties' marks may not have been proven, but in the circumstances here, Juice Generation's evidence is nonetheless powerful on its face. The fact that a considerable number of third parties use similar marks was shown in uncontradicted testimony.

Likewise, third party registrations may demonstrate that a given mark has little strength as a source indicator, according to *Juice Generation*, 115 USPQ2d at 1674-75:

In addition, "[a] real evidentiary value of third party registrations per se is to show the sense in which . . . a mark is used in ordinary parlance." 2 McCarthy on Trademarks and Unfair Competition § 11:90 (4th ed. 2015) (emphasis added). "Third party registrations are relevant to prove that some segment of the composite marks which both contesting parties use has a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak." *Id.*; see *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917 [189 USPQ 693] (CCPA 1976) (even if "there is no evidence of actual use" of "third-party registrations," such registrations "may be given some weight to show the meaning of a mark in the same way that dictionaries are used"). Marks that are descriptive or highly suggestive are entitled to a narrower scope of protection, *i.e.*, are less likely to generate confusion over source identification, than their more fanciful counterparts. *See, e.g., Nat'l Data Corp. v. Computer Sys. Eng'g, Inc.*, 940 F.2d 676, at *2 (Fed. Cir. 1991) (unpublished); *Drackett Co. v. H. Kohnstamm & Co.*, 404 F.2d 1399, 1400 [160 USPQ 407] (CCPA 1969) ("The scope of protection afforded such highly suggestive marks is necessarily narrow and confusion is not likely to result from the use of two marks carrying the same suggestion as to the use of closely similar goods.")

In accordance with the holdings of the *Juice Generation* and the *Jack Wolfskin* cases, the common term in the parties' marks, "OMAHA," is so weak that consumers will focus on the differences in the marks and will be unlikely to be confused as to the source of the goods sold thereunder.

Furthermore, in the present case, there is an unusual and perhaps even more meaningful type of "third-party use" of the word "Omaha" on similar goods. Defendant GOP presented a great deal of

evidence proving that Defendant and its predecessor have continuously used the GREATER OMAHA trademark on beef for 96 years from 1920 to the present. Defendant's testimony witness Henry Davis established that Defendant continuously used the GREATER OMAHA trademark on beef from 1920 to 2000. (42 TTABVue 38-19/Davis Depo. at page 37, line 16 to page 38, line 23). Defendant's testimony witness Angelo Fili established that Defendant continuously used the GREATER OMAHA (with steer head design) trademark on beef from 1992 to at least March 16, 2016 ("the present"). (39 TTABVue 34/Fili Depo. at page 33, lines 2-24; and 39 TTABVue 68-70/Fili Depo. at page 67, line 14 to page 69, line 1). This is direct evidence that Defendant continuously used the GREATER OMAHA trademark on beef for 96 years from 1920 to the present.

Plaintiff OSI admitted that it has purchased (such trademarked) beef from Defendant GOP in every year since the 1950s. (28 TTABVue 15/Defendant's Third Notice of Reliance, NR-6, Request No. 36 – Admitted, Bates No. GOP-1054).

Defendant's witness Henry Davis testified that Defendant's annual sales of GREATER OMAHA-trademarked beef from 1992 to 2015 rose from in excess of \$100,000,000 to \$1.7 billion and always exceeded \$100,000,000 per year. (42 TTABVue 65-66/Davis Depo. at page 64, line 3 to page 65, line 13).

In view of Defendant's uncontroverted evidence, there can be no doubt that customers have been conditioned over the course of 96 years to associate the GREATER OMAHA trademark with Defendant GOP. Defendant GOP's continuous use of the GREATER OMAHA trademark on beef for 96 years was begun at least 48 years prior to any alleged use of the OMAHA STEAKS trademark by Plaintiff OSI – use which Plaintiff has alleged, but which Plaintiff has not proven. Therefore, Defendant GOP's continuous use of the two words GREATER OMAHA as a trademark for beef since 1920 further proves that Plaintiff's OMAHA STEAKS trademark is weak, is not entitled to a broad scope of protection and, even more importantly, is not likely to result in customer confusion as to source vis-à-vis Defendant's mark.

Therefore, applying the 6th *duPont* factor to the evidence results in a conclusion that Plaintiff Omaha Steaks' OMAHA STEAKS mark is weak and is entitled to only a narrow scope of protection. Therefore, this factor strongly favors Defendant GOP.

Factor 7. The nature and extent of any actual confusion.

On page 23 of Plaintiff's Brief (48 TTABVue 28), Plaintiff OSI correctly concedes that "There is no dispute that the record lacks any evidence of actual confusion." Plaintiff OSI admitted in many different ways that Plaintiff was not aware of any evidence of actual confusion between the parties' marks. (28 TTABVue 3, 6 & 12/ Defendant's Third Notice of Reliance, NR-5, Request Nos. 1, 32, 33 – Admitted, Bates Nos. 1042 and 1045, and NR-6, Request No. 1 – Admitted, Bates No. 1051).

Defendant GOP's witnesses Henry Davis and Angelo Fili both testified that they had never observed or ever heard of any instances of actual confusion as to source. (42 TTABVue 70/ Davis Depo. at page 69, line 8 to page 70, line 4; and 39 TTABVue 80/Fili Depo. at page 79, lines 7-17).

Therefore, applying the 7th *duPont* factor to the evidence results in a conclusion that there has been no actual confusion. Therefore, this factor strongly favors Defendant GOP.

Factor 8. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.

Defendant GOP's opposed mark includes the two words GREATER OMAHA. Defendant has used these two words as a trademark for beef by Defendant GOP since 1920. (42 TTABVue 38-39/Davis Depo. at page 37, line 16 to page 38, line 23; and 39 TTABVue 34/Fili Depo. at page 33, lines 2-24; and 39 TTABVue 68-70/Fili Depo. at page 67, line 14 to page 69, line 1). In addition, these two words have been used as the first two words of Defendant GOP's company name since 1920. (42 TTABVue 15 and 63/Davis Depo. at page 14, lines 12-20, and page 62, line 5, 8-12, and 30; and 30 TTABVue 1-66/Defendant's Fourth Notice of Reliance, NR-9, Bates Nos. GOP-0768-0772, 0002-0077, 0764-0767, 0001, 0044, 0049, 0054, 0071, 0067, 0065, 0064, 0063, 0078, 0107, 0116, 0115 and 0137). Plaintiff OSI, in its U.S. Registration No. 1515602, claims that it has been using the OMAHA STEAKS mark on meat

since 1968. (1 TTABVue 24-25). Plaintiff OSI admitted that it has been aware of the existence of Defendant GOP since at least as early as 1966. (28 TTABVue 4/Defendant's Third Notice of Reliance, NR-5, Request No. 7 – Admitted, Bates No. GOP-1043), and that Plaintiff has been aware that Defendant's name has begun with the words "Greater Omaha Packing" since at least as early as 1965. (28 TTABVue 14/Defendant's Third Notice of Reliance, NR-6, Request No. 35 – Admitted, Bates No. GOP-1053). Plaintiff OSI admitted that it has purchased beef from Defendant GOP in every decade beginning with the decade opening January 1, 1950. (28 TTABVue 14/Defendant's Third Notice of Reliance, NR-6, Request No. 36 – Admitted, Bates No. GOP-1054). Plaintiff OSI admitted that, prior to November 15, 2013, it never made any objection to Defendant GOP about Defendant's corporate name or to the first three words in Defendant's corporate name. (28 TTABVue 13/Defendant's Third Notice of Reliance, NR-6, Request Nos. 5 and 6 – Admitted, Bates No. 1052). Plaintiff OSI admitted that it is not aware of any instances of actual customer confusion occurring arising because of the simultaneous use of Defendant GOP's opposed mark and Plaintiff OSI's marks. (28 TTABVue 3/Defendant's Third Notice of Reliance, NR-5, Request No. 1 – Admitted, Bates No. GOP-1042). Defendant GOP similarly stated that it is not aware of any instances of actual customer confusion. (39 TTABVue 79/Defendant's Fili Depo. page 78, line 24 to page 79, line 17).

This is evidence of many decades of concurrent use (a) of the two words "Greater Omaha" as a name and mark by Defendant GOP, and (b) of Plaintiff OSI's claimed use of its "Omaha Steaks" name and mark since 1968, all without any evidence of actual confusion, as admitted by Plaintiff OSI, and as testified to by the Defendant GOP's witnesses.

Therefore, applying the 8th *duPont* factor to the evidence results in a conclusion that there has been a very long period of time during which the GREATER OMAHA portion of Defendant's opposed mark and Plaintiff's OMAHA STEAKS mark were concurrently used without any objection by Plaintiff OSI, and without any evidence of any actual confusion, all as admitted by Plaintiff OSI. Therefore, this factor strongly favors Defendant GOP.

Factor 9. The variety of goods on which a mark is or is not used (house mark, family mark, product mark).

The challenged application covers “Meat, including boxed primal cuts.” There is little or no evidence of record whether Defendant’s opposed Steer Head Logo mark is a house mark, family mark or product mark. There is little or no admissible evidence of record whether Plaintiff’s OMAHA STEAKS mark is a house mark, family mark or product mark. On page 23 of Plaintiff’s Brief (48 TTABVue 28), Plaintiff inaccurately relies upon Todd Simon’s testimony at 33 TTABVue 257/Todd Simon Depo. at page 128, lines 16-21, as stating that “‘Omaha Steaks’ appears on every single package sold by Omaha Steaks.” In fact, Todd Simon testified that some of Plaintiff’s marketing expenditures for Omaha Steaks-branded products are for products which are not beef products. Mr. Simon did not mention packaging. A factor ordinarily comes into play only to the extent that the record contains competent evidence pertaining to it. *In re Great Lakes Canning, Inc.*, 227 USPQ 483, 486 (TTAB 1985).

Therefore, this factor is neutral.

Factor 10. The market interface between Defendant GOP and the owner of a prior mark.

The goods in Defendant GOP’s Application are not limited as to market. **Therefore**, applying the *duPont* market interface factor results in a conclusion that there is market interface between the parties. This factor favors Plaintiff OSI.

Factor 11. The extent to which Defendant GOP has a right to exclude others from use of its mark on its goods.

Defendant GOP owns Registration No. 4690144 for the GREATER OMAHA trademark. (27 TTABVue 36-38/Defendant GOP’s Second Notice of Reliance, NR-3, Bates Nos. GOP-1035 – 1037). Defendant’s officers Henry Davis and Angelo Fili testified that the GREATER OMAHA trademark has been used on beef for 96 years. (42 TTABVue 38-39/Davis Depo. at page 37, line 16 to page 38, line 23; and 39 TTABVUE 34/Fili Depo. at page 33, lines 2-24). Accordingly, Defendant GOP has the right,

based on federal law and on common law, to exclude others from using both the opposed mark as well as the GREATER OMAHA mark in connection with beef.

Therefore, applying the 11th *duPont* factor to the evidence results in a conclusion that Defendant GOP fully has this right to exclude others from use of its mark on its goods. Therefore, this factor strongly favors Defendant GOP.

Factor 12. The extent of potential confusion, i.e., whether de minimis or substantial.

Because Defendant GOP's opposed mark contains, as a prominent portion, the registered and long-used GREATER OMAHA trademark, as well as many other dissimilar elements, there is no potential confusion. The fact that there has been no actual confusion as to source for at least 50 years, as discussed previously in the section on Factor 7, beginning on page 28 of this brief, is strong evidence that Defendant's opposed mark, which includes other elements that are nowhere found in any of Plaintiff's marks, has at most a *de minimis* likelihood of potential confusion.

Therefore, applying the 12th *duPont* potential confusion factor to the evidence results in a conclusion that the extent of potential confusion is *de minimis*. Therefore, this factor strongly favors Defendant GOP.

Factor 13. Any other established fact probative of the effect of use.

The intent of the "defendant" in adopting its mark may be considered for the purpose of the confusion analysis. *DC Comics v. Pan American Grain Mfg. Co., Inc.*, 77 USPQ2d 1220 (TTAB 2005). Plaintiff OSI presented absolutely no evidence of any kind showing that Defendant GOP ever sought to copy any of Plaintiff's marks. On the contrary, Defendant GOP's witnesses Angelo Fili and Henry Davis testified at length, and Defendant introduced many documents, clearly showing how Defendant GOP, in complete good faith, created its opposed mark with no thought of Plaintiff OSI's marks or names. (39 TTABVue 23/Fili Depo. at page 22, lines 10-15; and 42 TTABVue 53/Davis Depo. at page 52, lines 4-19). Plaintiff OSI offered no evidence even suggesting that Defendant GOP had a bad faith intent, and all of the evidence demonstrates Defendant's complete good faith in creating and adopting its opposed mark.

The comparative quality of the parties' goods may be considered for the purpose of the *duPont* confusion analysis. *Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460, 1465 (TTAB 1992) (in which the Board rejected opposer's arguments that applicant's products were inferior and would fail.) In the present case, Plaintiff OSI's President Bruce Simon testified about the quality of Defendant's beef in the following manner:

Q. So do you have an opinion on Greater Omaha Packing's plant, and its operation?

A. Their plant is second to none in the United States. I've visited a lot of kill floors before...

MR. SAMUELS: I'm sorry, you visited a lot of what?

THE WITNESS: Kill floors, slaughterhouses.

A. – and Henry's slaughter facility is the best I've ever seen. I mean, it is the cleanest, it is absolutely straight up and down as good as it gets. (33 TTABVue 45 / Plaintiff's Bruce Simon Depo. at page 43, lines 7-19).

Therefore, applying the 13th *duPont* factor to the evidence results in a conclusion that Defendant GOP had a good-faith intent when creating and adopting its opposed mark, and has offered goods of the highest quality under its mark. This factor strongly favors Defendant GOP.

7. Conclusion

Balancing the *duPont* factors, Defendant GOP submits that Plaintiff OSI has failed to carry its burden of proof to establish the likelihood of confusion. The opposed mark is so dissimilar from Plaintiff OSI's mark that confusion is not likely. Therefore, the Board is urged to decide this case in favor of Defendant GOP, and to dismiss the opposition.

II. The First Cancellation - Defendant GOP's Omaha Natural Angus Logo



OMAHA STEAKS ANGUS

Factor 1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

1.1. Appearance - There is a tremendous visual difference between the appearance, in their entireties, of Defendant GOP's Omaha Natural Angus Logo mark and Plaintiff OSI's OMAHA STEAKS ANGUS mark. Defendant GOP's registered Omaha Natural Angus Logo trademark for Angus beef contains five elements.

The first element is the three words "OMAHA Natural ANGUS." The second element is the two additional words "CORN FED." The third element is the prominent illustration of a steer. The fourth element is the six words "MINIMALLY PROCESSED AND NO ARTIFICIAL INGREDIENTS." The fifth and dominating element is a very distinctive and claimed multi-colored gold, yellow, red, black and gray shield design. There are only two common elements between the parties' marks. The first common element is the well-known geographically descriptive city name "Omaha," which is the city in which both parties have always had their headquarters. (42 TTABVue 62-63/Davis Depo. at page 61, line 22 to page 62, line 1; and 28 TTABVue 4/Defendant's Third Notice of Reliance, NR-5 – Request No. 12 – Admitted, Bates No. GOP-1043). The second common element is the entirely descriptive common word "ANGUS" which is a type of beef. Both parties disclaimed the generic term ANGUS in their registrations. Defendant GOP also disclaimed the geographically descriptive name OMAHA in its registration.

On the other hand, Plaintiff OSI's OMAHA STEAKS ANGUS mark does not include the second, third, fourth or fifth elements of Defendant GOP's Omaha Natural Angus Logo.

Plaintiff OSI's OMAHA STEAKS ANGUS mark does not include the words "Natural" or "CORN FED." Plaintiff's mark does not include an illustration of a steer (or any remotely similar graphical element), whereas the illustration of a steer is a prominent element of Defendant GOP's Omaha Natural Angus Logo mark. Plaintiff's mark does not include the words "MINIMALLY PROCESSED AND NO ARTIFICIAL INGREDIENTS." Importantly, Plaintiff OSI's OMAHA STEAKS ANGUS

mark does not include the extremely prominent and distinctive and dominating and claimed multi-colored gold shield design. The test for likelihood of confusion is whether Defendant GOP's mark, in its entirety, is likely to cause confusion with Plaintiff OSI's mark, in its entirety. In their entireties, there is virtually no similarity of appearance between the two parties' marks.

Therefore, applying the *duPont* appearance factor to the evidence results in a conclusion that Defendant GOP's Natural Angus Logo mark and Plaintiff OSI's OMAHA STEAKS ANGUS mark, when compared in their entireties, have such dissimilar appearances that this factor strongly favors Defendant GOP. Defendant GOP also submits that this appearance dissimilarity conclusion is so strong and overwhelming that the Board could decide to dismiss this cancellation based on this *duPont* Appearance factor alone, as the Board did in *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991).

1.2. Sound - Defendant GOP's registered Omaha Natural Angus Logo mark contains the eleven pronounceable words OMAHA, NATURAL, ANGUS, CORN, FED, MINIMALLY, PROCESSED, AND, NO, ARTIFICIAL AND INGREDIENTS. Plaintiff OSI's OMAHA STEAKS ANGUS mark contains the three pronounceable words OMAHA, STEAKS and ANGUS. In their entireties, there is little similarity of sound between the two parties' marks.

Therefore, Defendant GOP submits that applying the *duPont* sound factor to the evidence results in a conclusion that Defendant GOP's Omaha Natural Angus Logo mark and Plaintiff OSI's OMAHA STEAKS marks are so dissimilar regarding sound that this factor favors Defendant GOP.

1.3. Connotation (meaning) - Defendant GOP's registered Omaha Natural Angus Logo mark instantly and prominently projects to the customer an extremely distinctive, dominating and claimed multi-colored gold shield design. In addition, Defendant GOP's registered mark contains the words "Natural" and "CORN FED" and "Minimally Processed and No Artificial Ingredients" and a yellow circle containing a black silhouette image of a steer. In contrast, Plaintiff OSI's OMAHA STEAKS ANGUS mark means a steak (a slice of meat) that comes from Omaha, Nebraska. Plaintiff disclaimed the generic words

STEAKS and ANGUS in its registration. Defendant GOP's extremely prominent, distinctive, dominating and claimed multi-colored gold shield design trademark creates a completely different connotation from that created by Plaintiff OSI's three descriptive words trademark.

Therefore, applying the *duPont* connotation factor to the evidence results in a conclusion that Defendant GOP's Omaha Natural Angus Logo mark and Plaintiff OSI's OMAHA STEAKS ANGUS mark have such dissimilar connotations in their entireties that this factor favors Defendant GOP.

1.4. Commercial impression - *duPont* suggests that this factor is the sum of the conclusions of 1.1; 1.2; and 1.3 – Defendant GOP's registered mark has a completely different appearance from Plaintiff OSI's mark; and has a completely different sound from Plaintiff OSI's mark; and has a completely different connotation from Plaintiff OSI's mark.

Therefore, applying the *duPont* commercial impression factor to the evidence results in a conclusion that Defendant GOP's and Plaintiff OSI's marks create such dissimilar commercial impressions that this factor strongly favors Defendant GOP. Indeed, Defendant submits that the dissimilarities of the parties' marks are so vast that the Board should decide to dismiss the cancellation proceeding based on this first *duPont* factor alone. *See, Kellogg Co. v. Pack'em Enterprises Inc.* and *Oakville Hills Cellar, Inc., dba Dalla Valle Vineyards v. Georgallis Holdings*, above.

Factor 2. The similarity or dissimilarity and nature of the goods or services.

The goods in Defendant GOP's Omaha Natural Angus Logo registration are "Angus beef." Plaintiff OSI admitted that Plaintiff does not use its mark on or in connection with Angus beef. (28 TTABVue 17/Defendant's Third Notice of Reliance, NR-7, Request No. 8 – Admitted, Bates No. GOP-1056).

Therefore, applying the 2nd *duPont* similarity of goods factor to the evidence results in a conclusion that Defendant GOP's goods and Plaintiff OSI's goods are somewhat dissimilar, so this factor favors Defendant GOP, or might be considered neutral.

Factor 3. The similarity or dissimilarity of established, likely-to-continue trade channels.

Defendant GOP's challenged Registration No. 4006768 for the Omaha Natural Angus Logo covers only Angus beef. Plaintiff OSI admitted that it does not use its mark on or in connection with Angus beef. (28 TTABVue 17/Defendant's Third Notice of Reliance, NR-7, Request No. 8 – Admitted, Bates No. GOP-1056).

Therefore, applying the 3rd *duPont* trade channel factor to the evidence results in a conclusion that Defendant GOP's and Plaintiff OSI's trade channels for its different goods are somewhat dissimilar, so this factor favors Defendant GOP, or might be considered neutral.

Factor 4. The conditions under which, and buyers to whom, sales are made, i.e., impulse vs. careful, sophisticated purchasing.

As set forth previously in the Factor 4 discussion regarding Defendant's Steer Head Logo mark beginning on page 16 of this brief, the evidence shows that both parties' customers are likely to exercise care in their decisions to purchase relatively expensive goods. Please consider the Factor 4 discussion beginning on page 16 of this brief to apply to this discussion regarding Defendant's Omaha Natural Angus Logo trademark.

Accordingly, Defendant submits that the evidence shows that the purchasing decisions by both parties' customers are serious, careful and well-considered decisions, and are made by sophisticated buyers. Selecting and purchasing both parties' expensive beef products are not impulse decisions. Such purchasing decisions are made only after substantial deliberation and careful consideration of many factors. No competent evidence was introduced which even suggested that Defendant GOP's or Plaintiff OSI's customers made impulsive purchasing decisions.

Therefore, applying the 4th *duPont* factor to the evidence results in a conclusion that the purchasing decision-makers for both parties' expensive goods are sophisticated, careful and deliberate, and are totally unlike impulse purchasers of inexpensive unimportant goods, so this factor strongly favors Defendant GOP.

Factor 5. The fame of the prior marks (sales, advertising, length of use).

As discussed previously in the Factor 5 discussion beginning on page 19 of this brief and in the attached Appendix, Plaintiff OSI presented no admissible evidence of significant sales or advertising or length of use of the OMAHA STEAKS mark or the OMAHA STEAKS ANGUS mark for branded meat. It is only by presenting admissible evidence of such extensive sales, advertising and long use that Plaintiff OSI could have sought to prove that its marks have become famous or strong.

Therefore, applying the 5th *duPont* factor to the evidence results in a conclusion that Plaintiff's OMAHA STEAKS and OMAHA STEAKS ANGUS marks are definitely not famous or strong. Instead, they are extremely weak and entitled to only the narrowest scope of protection. Therefore, this factor strongly favors Defendant GOP

Factor 6. The number and nature of similar marks in use on similar goods.

There are many companies currently located in Omaha, Nebraska that are using trademarks or trade names in which the first word is "Omaha." Many such companies are in beef or food businesses. (40 and 41 TTABVue 1-165 & 1-70/Peetz Deposition including its exhibits; and 31 TTABVue 20-51/Defendant's Fifth Notice of Reliance, NR-49 to NR-59, Bates Nos. GOP-1151-1184). Because there are numerous similar marks in use by third-party sources in related fields, Plaintiff OSI's marks are, at best, weak as indicators of a single source, and are entitled only to a narrow scope of protection. Please consider everything said in the Factor 6 discussion beginning on page 24 of this brief to apply to this discussion regarding Defendant's Omaha Natural Angus Logo trademark. As shown by the *Juice Generation* and the *Jack Wolfskin* cases, the common term "OMAHA" in the parties' respective marks is such a weak formative that consumers will look to the many distinguishing features in the respective marks and would be unlikely to be confused as to source.

As previously discussed beginning on page 26 of this brief, in the present case, there is an unusual and perhaps even more meaningful type of "third-party use" of the word "Omaha" on similar goods. Defendant GOP presented a great deal of evidence proving that Defendant has continuously used the GREATER OMAHA trademark on beef for 96 years from 1920 to the present.

In view of Defendant's uncontroverted evidence, there can be no doubt that customers have been conditioned over the course of 96 years to associate the GREATER OMAHA trademark, when used for beef, with Defendant GOP. Defendant's continuous use for 96 years of its GREATER OMAHA trademark on beef, which began in 1920, was begun at least 48 years prior to any alleged (but unproven) use of the OMAHA STEAKS trademark. Therefore, Defendant GOP's continuous use of the two words GREATER OMAHA as a trademark for beef since 1920 constitutes additional powerful evidence that Plaintiff's OMAHA STEAKS trademark is weak and is not entitled to a broad scope of protection.

Therefore, applying the 6th *duPont* factor to the evidence results in a conclusion that Plaintiff's OMAHA STEAKS mark is weak and is entitled to only a narrow scope of protection. Therefore, this factor strongly favors Defendant GOP.

Factor 7. The nature and extent of any actual confusion.

On page 23 of Plaintiff's Brief (48 TTABVue 28), Plaintiff OSI correctly concedes that "There is no dispute that the record lacks any evidence of actual confusion." Plaintiff Omaha Steaks admitted in many other ways that Plaintiff was not aware of any evidence of actual confusion between the parties' marks. (28 TTABVue 6 & 12/Defendant's Third Notice of Reliance, NR-5, Request No. 33 – Admitted, Bates No. GOP-1045; NR-6, Request No. 2 – Admitted, Bates No. GOP-1052).

Defendant GOP's witnesses Henry Davis and Angelo Fili both testified that they had never observed or ever heard of any instances of actual confusion as to source. (42 TTABVue 67/Davis Depo. at page 66, lines 12-22; and 39 TTABVue 77-78/Fili Depo. at page 76, line 24 to page 77, line 9).

Therefore, applying the 7th *duPont* factor to the evidence results in a conclusion that there has been no actual confusion. Therefore, this factor strongly favors Defendant GOP.

Factor 8. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.

Defendant GOP's registered Omaha Natural Angus Logo mark has been continuously used as a trademark for beef since 2006. (39 TTABVue 51/Fili Depo. at page 50, lines 16-20). Thus, there have

been approximately eight years of concurrent use of Defendant's registered Omaha Natural Angus Logo mark with Plaintiff's OMAHA STEAKS and OMAHA STEAKS ANGUS marks, all with absolutely no evidence of any actual confusion as to source. Plaintiff OSI admitted that it is not aware of any instances of actual customer confusion occurring because of the simultaneous use of Defendant GOP's registered Omaha Natural Angus Logo trademark and Plaintiff OSI's marks. (28 TTABVue 6 & 13/Defendant's Third Notice of Reliance, NR-5, Request No. 33 – Admitted, Bates No. GOP-1045; and NR-6, Request No. 2 – Admitted, Bates No. GOP-1052). Defendant's witnesses Henry Davis and Angelo Fili similarly testified that Defendant was not aware of any instances of actual customer confusion between Defendant's registered Omaha Natural Angus Logo mark and any of Plaintiff's trademarks (*See*, previous Factor 7 discussion beginning on page 28 of this brief). Plaintiff admitted that it never made any objection to Defendant GOP about Defendant's Omaha Natural Angus Logo mark prior to June 26, 2014. (28 TTABVue 4/Defendant's Third Notice of Reliance, NR-6, Request No. 7 – Admitted, Bates No. GOP-1052).

Therefore, applying the 8th *duPont* factor to the evidence results in a conclusion that there has been an eight year period of time during which Defendant's registered Omaha Natural Angus Logo mark and Plaintiff's marks were concurrently used without any evidence of any actual confusion as to source, or any objection by Plaintiff, all as admitted by Plaintiff OSI. Therefore, this factor strongly favors Defendant GOP.

Factor 9. The variety of goods on which a mark is or is not used (house mark, family mark, product mark).

Defendant's challenged registration covers only "Angus beef." Defendant's Executive Vice President Angelo Fili testified that Defendant Omaha Natural Angus logo trademark was used only on Angus beef products and not on any other beef products. (39 TTABVue 82/Fili Depo. at page 81, lines 12-23). Thus, Defendant GOP's mark cannot be a house mark used on a variety of goods. It is a product mark.

Therefore, applying the 9th *duPont* factor to the evidence results in a conclusion that, because Defendant GOP's mark is not a house mark, but rather is a product mark, this factor favors Defendant GOP.

Factor 10. The market interface between Defendant GOP and the owner of a prior mark.

The goods in Defendant GOP's Omaha Natural Angus Logo registration are only Angus beef. Plaintiff OSI has admitted that it does not sell Angus beef. (28 TTABVue 17/Defendant's Third Notice of Reliance, NR-7, Request No. 8 – Admitted, Bates No. GOP-1056).

Therefore, applying the 10th *duPont* factor to the evidence results in a conclusion that, because there is little or no market interface between the parties, this factor favors Defendant GOP.

Factor 11. The extent to which Defendant GOP has a right to exclude others from use of its mark on its goods.

Defendant GOP owns the challenged Registration No. 4006768 for the Omaha Natural Angus Logo trademark. Defendant's officer Angelo Fili testified that the Omaha Natural Angus Logo trademark has been used on Angus beef for eight years from 2006 to July, 2014. (39 TTABVue 51/Fili Depo. at page 50, line 16-20). Accordingly, Defendant GOP has the right, based on federal law and on common law, to exclude others from using Defendant GOP's registered Omaha Natural Angus Logo trademark in connection with Angus beef.

Therefore, applying the 11th *duPont* factor to the evidence results in a conclusion that, because Defendant GOP has the right to exclude others from use of its mark, this factor strongly favors Defendant GOP.

Factor 12. The extent of potential confusion, i.e., whether *de minimis* or substantial potential confusion.

Because Defendant GOP's registered Omaha Natural Angus Logo trademark includes, as a prominent portion, a very distinctive and claimed multi-colored gold, yellow, red, black and gray gold shield design, as well as many other distinguishing elements, Defendant GOP submits that there is no

meaningful potential for confusion. The fact that there has been no actual confusion as to source for at least eight years is strong evidence that Defendant's registered mark, which includes the very distinctive and claimed multi-colored shield design and other elements that are nowhere found in any of Plaintiff's marks, has at most a *de minimis* likelihood of causing potential confusion.

Therefore, applying the 12th *duPont* factor to the evidence results in a conclusion that the extent of potential confusion is *de minimis*. Therefore, this factor strongly favors Defendant GOP.

Factor 13. Any other established fact probative of the effect of use.

As previously discussed beginning on page 31 of this brief, the intent of the "defendant" in adopting its mark may be considered for the purpose of the confusion analysis. Plaintiff OSI presented absolutely no evidence showing that Defendant GOP ever sought to copy any of Plaintiff's marks. On the contrary, Defendant GOP's witness Angelo Fili testified at length, and Defendant introduced many documents, clearly showing how Defendant, in complete good faith, created its registered Omaha Natural Angus Logo trademark with no thought of Plaintiff OSI's marks or names. (39 TTABVue 47/Fili Depo. at page 46, lines 3-17). Plaintiff OSI has offered no evidence even suggesting that Defendant GOP had a bad faith intent, and all of the evidence demonstrates Defendant's complete good faith in creating and adopting its Omaha Natural Angus Logo trademark.

Moreover, as discussed beginning on page 32 of this brief, Defendant's goods are of the highest quality, as confirmed by the testimony of Plaintiff's President Bruce Simon.

Therefore, applying the 13th *duPont* defendant's intent and quality factors to the evidence results in a conclusion that Defendant GOP had a good faith intent when creating and adopting its Omaha Natural Angus Logo trademark, and the quality of Defendant's goods is extremely high. Therefore, this factor strongly favors Defendant GOP.

7. Conclusion

Balancing the *duPont* factors, Defendant GOP submits that Plaintiff OSI has again failed to carry its burden of proof. Defendant GOP's registered Omaha Natural Angus Logo mark does not so resemble

Plaintiff OSI's marks as to be likely to cause confusion. Therefore, the Board should decide this case in favor of Defendant GOP, and dismiss this cancellation proceeding.

Plaintiff Omaha Steaks' Petition for Cancellation Claim against Registration No. 4006768 for the Omaha Natural Angus Logo trademark Is Barred under the Doctrines of Laches and Acquiescence

§ 19 of the Trademark Act provides that "In all inter partes proceedings equitable principles of laches, estoppel and acquiescence, where applicable, may be considered and applied." Defendant GOP has, as an affirmative defense, asserted that Plaintiff OSI's delay in filing the subject Petition for Cancellation constitutes acquiescence and/or laches.

Defendant GOP's Omaha Natural Angus Logo trademark application was published for opposition on **August 24, 2010** and the registration was issued on **August 2, 2011**. If there is actual knowledge by plaintiff of a defendant and its mark prior to publication for opposition, the date of publication is the operative date for laches. *Turner v. Hops Grill & Bar Inc.*, 52 USPQ2d 1310, 1312 (TTAB 1999) ("Respondent correctly contends the constructive notice runs from the date of publication... *National Cable Television Association, Inc. v. American Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991).").

In the instant proceeding, the mark was published for opposition on **August 24, 2010** and Plaintiff OSI filed its petition for cancellation on **June 26, 2014**. Thus, the delay in Plaintiff OSI's filing its petition for cancellation was slightly more than three years and ten months.

In fact, the evidence proves that Plaintiff OSI has been continuously purchasing and receiving Angus beef from Defendant GOP in shipping boxes bearing Defendant GOP's Omaha Natural Angus Logo trademark in each and every year since at least as early as the year 2006. (39 TTABVue 51-52/Fili Depo. at page 50, line 24 through page 51, line 4). Before filing its petition for cancellation, Plaintiff OSI had never communicated with anyone connected with Defendant GOP to object to Defendant's use or registration of Defendant's Omaha Natural Angus Logo trademark. (42 TTABVue 66-67/Davis Depo. at page 65, line 14 to page 66, line 11). Thus, even though Plaintiff OSI had actual knowledge of Defendant

GOP's actual use of its Omaha Natural Angus Logo mark for approximately eight years prior to filing its petition for cancellation in 2014, Plaintiff never made any objection to Defendant during that eight year period. Plaintiff OSI has offered no evidence explaining or justifying its silence or its undue and unreasonable delay in filing the petition for cancellation.

Plaintiff OSI's unexplained silence and undue and unreasonable delay in filing its petition for cancellation would directly result in economic prejudice to Defendant GOP, if the petition for cancellation were granted. Defendant's President Henry Davis testified that Defendant continuously increased and expanded its investment in Defendant's plant, employees, sales and marketing over a prolonged period of time in order to develop and promote the Omaha Natural Angus Logo trademark. (42 TTABVue 67-68/Davis Depo. at page 66, line 23 to page 67, line 9). Such increased investment adds weight to the evidence of prejudice. *Bridgestone/Firestone Research Inc. v. Automobile Club de l'Ouest de la France*, 245 F.3d 1359, 58 USPQ2d 1460 (Fed. Cir. 2001); *Ava Ruha Corp. DBA Mother's Market & Kitchen v. Mother's Nutritional Center, Inc.*, 113 USPQ2d 1575 (TTAB 2015) (ruling that a delay of three years and two months could support a defense of laches); *Teledyne Technologies Inc. v. Western Skyways Inc.*, 78 USPQ2d 1203 (TTAB 2006), *aff'd unpublished opinion*, Appeal Nos. 2006-1366 and 1367 (Fed. Cir. Dec. 6, 2006) (the unexplained delay of three years and seven months was held to constitute laches).

In conclusion, Plaintiff's extremely long and unexplained eight years of silence and three years and ten months of delay in filing a petition for cancellation constitute undue delay with resulting detriment and prejudice to Defendant. Defendant would suffer prejudicial economic injury to its valuable business and goodwill involving its Omaha Natural Angus Logo trademark if Plaintiff were at this very late date permitted to cancel Defendant's registration.

This is not a case in which the likelihood of confusion arising from Defendant GOP's use of its registered mark on Angus beef is inevitable, thus rendering laches inapplicable. The substantial differences in the parties' respective marks are so significant that there is no basis for holding that

confusion is so inevitable here that the equitable defenses of laches and acquiescence must be barred. *Ultra-White Co., Inc. v. Johnson Chemical Industries, Inc.*, 65 F.2d 891, 175 USPQ 166 (CCPA 1972); *Christian Broadcasting Network, Inc. v. ABS-CBN International*, 84 USPQ2d 1560 (TTAB 2007).

Accordingly, based on all of the evidence of record, it is submitted that the claim made in Plaintiff OSI's petition for cancellation of Reg. No. 4006768 is barred by the doctrines of laches and acquiescence.

III. The Second Cancellation - Defendant GOP's 1881 Omaha Hereford Logo



OMAHA STEAKS

Factor 1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

1.1. Appearance - There is a tremendous visual difference between the appearances, in their entireties, of Defendant GOP's 1881 Omaha Hereford Logo trademark and Plaintiff's OMAHA STEAKS mark. Defendant GOP's registered 1881 Omaha Hereford Logo trademark contains five elements.

The first element is the year date 1881 which is a completely distinctive and arbitrary term, which is completely unlike any aspect of Plaintiff's OMAHA STEAKS mark.

The second element is the large and prominent illustration of a Hereford steer, which is completely unlike any aspect of Plaintiff's OMAHA STEAKS mark. Plaintiff OSI's mark does not include a Hereford steer (or any remotely similar graphical element), whereas the illustration of a Hereford steer is the largest element of Defendant GOP's 1881 Omaha Hereford Logo mark.

The third element in large bold print is the two sequential words "Omaha Hereford." Plaintiff's OMAHA STEAKS mark does not include the word "Hereford," which is extremely prominently displayed in Defendant GOP's 1881 Omaha Hereford Logo mark.

The fourth element in smaller print is the four words “U.S. BEEF” (at the top of the mark) and “CORN FED” (at the bottom of the mark). Those four words are completely unlike any aspect of Plaintiff’s OMAHA STEAKS mark.

The fifth and dominating element is a very distinctive and claimed multi-colored design consisting of a black oval border outlined in maroon and containing a large illustration of a Hereford steer. The colors black, white and maroon are claimed as features of the mark. This multi-colored design is completely unlike any aspect of Plaintiff’s OMAHA STEAKS mark.

There is only one common element between the parties’ marks, namely the well-known geographically descriptive city name “Omaha,” which is the city in which both parties have always had their headquarters. Defendant GOP disclaimed the geographically descriptive name OMAHA in its registration.

Plaintiff’s OMAHA STEAKS mark does not include the first, second, fourth or fifth elements of Defendant GOP’s 1881 Omaha Hereford Logo.

Plaintiff’s OMAHA STEAKS mark does not include the words “1881” or “Hereford” or “U.S. BEEF” or “CORN FED.” Plaintiff’s mark does not include an illustration of a Hereford steer (or any remotely similar graphical element), whereas the illustration of a Hereford steer is a prominent element of Defendant GOP’s 1881 Omaha Hereford Logo mark. Importantly, Plaintiff OSI’s OMAHA STEAKS mark does not include Defendant’s prominent, distinctive and dominant multi-colored oval design. The test for likelihood of confusion is whether Defendant GOP’s mark, in its entirety, is likely to cause confusion with Plaintiff OSI’s mark, in its entirety. Considered in their entireties, there is virtually no similarity of appearance between the two parties’ marks.

Therefore, applying the *duPont* appearance factor to the evidence results in a conclusion that Defendant GOP’s 1881 Omaha Hereford Logo mark and Plaintiff Omaha Steaks’ OMAHA STEAKS mark, when compared in their entireties, have such dissimilar appearances that this factor strongly favors Defendant GOP. Defendant GOP also submits that this appearance dissimilarity conclusion is so strong

and overwhelming that the Board could decide to dismiss this cancellation based on this *duPont* Appearance factor alone, as the Board did in *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991).

1.2. Sound - Defendant GOP's registered 1881 Omaha Hereford Logo mark contains the seven pronounceable words 1881, OMAHA, HEREFORD, CORN, FED, U.S. and BEEF. Plaintiff Omaha Steaks' OMAHA STEAKS marks all contain the two pronounceable words OMAHA STEAKS and sometimes other words and/or graphics. Considered in their entirety, there is no similarity of sound between the two parties' marks.

Therefore, applying the *duPont* sound factor to the evidence results in a conclusion that Defendant GOP's 1881 Omaha Hereford Logo mark and Plaintiff Omaha Steaks' OMAHA STEAKS marks are so dissimilar regarding sound that this factor strongly favors Defendant GOP.

1.3. Connotation (meaning) - Defendant GOP's registered 1881 Omaha Hereford Logo mark instantly and prominently projects to the customer an extremely distinctive and dominating multi-colored black, white and maroon oval design. Then, in large letters, Defendant's mark proclaims the words "Omaha Hereford" beneath a prominently displayed depiction of a Hereford steer. Above the Hereford steer is the arbitrary year date "1881." Above and below the Hereford steer are the words "U.S. BEEF" and "CORN FED." The words "Hereford," "U.S. BEEF," and "CORN FED" reinforce the prominent image of the Hereford steer. Plaintiff OSI has admitted that it does not sell Hereford beef. (28 TTABVue 17/Defendant's Third Notice of Reliance, NR-7, Request No. 9 – Admitted, Bates No. GOP-1056). In complete contrast, the two descriptive words OMAHA STEAKS in Plaintiff's mark mean that the steaks (slices of meat) come from Omaha. Plaintiff disclaimed the generic word STEAKS in all of its OMAHA STEAKS registrations. The only similarity of meaning between the parties' marks is the connotation that the source of the goods is located in Omaha, Nebraska.

Therefore, applying the *duPont* connotation factor to the evidence results in a conclusion that Defendant GOP's 1881 Omaha Hereford Logo mark and Plaintiff OSI's OMAHA STEAKS mark have such dissimilar connotations in their entirety that this factor strongly favors Defendant GOP.

1.4. Commercial impression - *duPont* suggests that this factor is the sum of the conclusions of 1.1; 1.2; and 1.3 – Defendant GOP's registered mark has a completely different appearance from Plaintiff OSI's mark; and has a completely different sound from Plaintiff OSI's mark; and has a completely different connotation from Plaintiff OSI's mark.

Therefore, applying the *duPont* commercial impression factor to the evidence results in a conclusion that Defendant GOP's trademark and Plaintiff OSI's mark create such dissimilar commercial impressions that this factor strongly favors Defendant GOP.

Factor 2. The similarity or dissimilarity and nature of the goods or services.

The goods in Defendant GOP's 1881 Omaha Hereford Logo registration are "Hereford beef." Plaintiff OSI admitted that Plaintiff does not use its OMAHA STEAKS mark on or in connection with Hereford beef. (28 TTABVue 17/Defendant's Third Notice of Reliance, NR-7, Request No. 9 – Admitted, Bates No. GOP-1056).

Therefore, applying the 2nd *duPont* factor to the evidence results in a conclusion that Defendant GOP's goods and Plaintiff OSI's goods are somewhat dissimilar, so this factor favors Defendant GOP, or might be considered neutral.

Factor 3. The similarity or dissimilarity of established, likely-to-continue trade channels.

Defendant GOP's challenged Registration No. 3998763 for the 1881 Omaha Hereford Logo covers only Hereford beef. Plaintiff OSI admitted that it does not use its OMAHA STEAKS mark as a trademark on or in connection with Hereford beef. (28 TTABVue 17/Defendant's Third Notice of Reliance, NR-7, Request No. 9 – Admitted, Bates No. GOP-1056).

Therefore, applying the 3rd *duPont* factor to the evidence results in a conclusion that Defendant GOP's and Plaintiff OSI's trade channels for its different goods are somewhat dissimilar, so this factor favors Defendant GOP, or might be considered neutral.

Factor 4. The conditions under which, and buyers to whom, sales are made, i.e., impulse vs. careful, sophisticated purchasing.

As set forth previously in the Factor 4 discussion regarding Defendant's Steer Head Logo mark beginning on page 16 of this brief, Defendant GOP's Hereford beef products bearing Defendant's 1881 Omaha Hereford Logo trademark are purchased by careful and sophisticated customers.

The evidence shows that both parties' customers make purchasing decisions that are serious, careful and well-considered decisions. Selecting and purchasing both parties' expensive beef products are not impulse decisions. Such purchasing decisions are made only after substantial deliberation and careful consideration of many factors. No competent evidence was introduced which even suggested that Defendant GOP's or Plaintiff OSI's customers make impulsive purchasing decisions.

Therefore, applying the 4th *duPont* factor to the evidence results in a conclusion that Defendant GOP's and Plaintiff OSI's customers' make purchasing decisions that are sophisticated, careful and deliberate, and are totally unlike impulse purchases of inexpensive unimportant goods. This factor strongly favors Defendant GOP.

Factor 5. The fame of the prior marks (sales, advertising, length of use).

As discussed previously in the Factor 5 discussion beginning on page 19 of this brief and in the attached Appendix, Plaintiff OSI presented no admissible evidence of significant sales or advertising or length of use of the OMAHA STEAKS mark for branded meat. It is only by presenting admissible evidence of such extensive sales, advertising and long use that Plaintiff OSI could have sought to prove that its mark has become famous or strong.

Therefore, applying the 5th *duPont* factor to the evidence results in a conclusion that Plaintiff's OMAHA STEAKS mark is definitely not famous or strong. Instead, it is extremely weak and entitled to only the narrowest scope of protection. Therefore, this factor strongly favors Defendant GOP.

Factor 6. The number and nature of similar marks in use on similar goods.

There are many companies currently located in Omaha, Nebraska that are using trademarks or trade names in which the first word is "Omaha." Many such companies are in beef or food businesses. (40 and 41 TTABVue 1-165 & 1-70/Terri Peetz' Deposition including its Exhibits; and 31 TTABVue 20-51/Defendant's Fifth Notice of Reliance, NR-49 to NR-59, Bates Nos. GOP-1151-1184). Because there are numerous similar marks in use by third-party sources in related fields, Plaintiff OSI's mark is, at best, weak as an indicator of a single source, and is entitled only to a narrow scope of protection. Please consider everything said in the Factor 6 discussion beginning on page 24 of this brief to apply to this discussion regarding Defendant's 1881 Omaha Hereford Logo trademark. As shown by the *Juice Generation* and *Jack Wolfskin* cases, the common term "OMAHA" in the parties' respective marks is such a weak formative that consumers will look to the many distinguishing features in the respective marks and would be unlikely to be confused as to source.

As previously discussed beginning on page 26 of this brief, in the present case, there is an unusual and perhaps even more meaningful type of "third-party use" of the word "Omaha" on similar goods. Defendant GOP presented a great deal of evidence proving that Defendant GOP has continuously used the GREATER OMAHA trademark on beef for 96 years from 1920 to the present.

In view of Defendant's uncontroverted evidence, there can be no doubt that customers have been conditioned over the course of 96 years to associate the GREATER OMAHA trademark in connection with beef with Defendant GOP. Defendant GOP's continuous use of the GREATER OMAHA trademark on beef for 96 years, which began in 1920, was begun at least 48 years prior to any alleged (but unproven) use of the OMAHA STEAKS trademark. Therefore, Defendant GOP's continuous use of the two words GREATER OMAHA as a trademark for beef since 1920 constitutes additional powerful

evidence that Plaintiff's OMAHA STEAKS trademark is weak and is not entitled to a broad scope of protection.

Therefore, applying the 6th *duPont* factor to the evidence results in a conclusion that Plaintiff's OMAHA STEAKS mark is weak and is entitled to only a narrow scope of protection. Therefore, this factor strongly favors Defendant GOP.

Factor 7. The nature and extent of any actual confusion.

On page 23 of Plaintiff's Brief (48 TTABVue 28), Plaintiff OSI correctly concedes that "There is no dispute that the record lacks any evidence of actual confusion." Plaintiff Omaha Steaks admitted in many other ways that Plaintiff was not aware of any evidence of actual confusion between the parties' marks. (28 TTABVue 6 & 12/Defendant's Third Notice of Reliance, NR-5, Request No. 33 – Admitted, Bates No. GOP-1045; NR-6, Request No. 3 – Admitted, Bates No. GOP-1052).

Defendant GOP's witnesses Henry Davis and Angelo Fili both testified that they had never observed or ever heard of any instances of actual confusion as to source. (42 TTABVue 69/Davis Depo. at page 68, lines 8-18; and 39 TTABVue 79/Fili Depo. at page 78, lines 13-23).

Therefore, applying the 7th *duPont* factor to the evidence results in a conclusion that there has been no actual confusion. Therefore, this factor strongly favors Defendant GOP.

Factor 8. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.

Defendant's officer Angelo Fili testified on March 16, 2016 that Defendant GOP has actually used its challenged 1881 Omaha Hereford Logo trademark on point of purchase materials since at least as early as June 4, 2012 to the present. (39 TTABVue 66/ Fili Depo. at page 65, lines 6-17). That means that there have been approximately four years of actual concurrent use of Defendant's registered 1881 Omaha Hereford Logo mark and Plaintiff's OMAHA STEAKS mark with absolutely no evidence of actual confusion as to source. Plaintiff OSI admitted that it is not aware of any actual customer confusion occurring because of the simultaneous use of Defendant GOP's registered 1881 Omaha Hereford Logo

trademark and Plaintiff OSI's OMAHA STEAKS trademark. (28 TTABVue 6 & 13/Defendant's Notice of Reliance, NR-5, Request No. 33 – Admitted, Bates No. GOP-1045; and NR-6, Request No. 3 – Admitted, Bates No. GOP-1052). Defendant GOP's witnesses Henry Davis and Angelo Fili testified that Defendant was not aware of any instances of actual customer confusion between Defendant's registered 1881 Omaha Hereford Logo mark and any of Plaintiff's trademarks (see the previous Factor 7 discussion beginning on page 28 of this brief). Plaintiff admitted that it never made any objection to Defendant GOP about Defendant's 1881 Omaha Hereford Logo mark prior to June 26, 2014. (28 TTABVue 5/Defendant's Third Notice of Reliance, NR-6, Request No. 8 – Admitted, Bates No. GOP-1053).

Therefore, applying the 8th *duPont* factor to the evidence results in a conclusion that there has been an approximately four year period of time during which both parties concurrently used their respective marks without either party's becoming aware of any actual confusion. This factor strongly favors Defendant GOP.

Factor 9. The variety of goods on which a mark is or is not used (house mark, family mark, product mark).

The challenged registration covers only "Hereford beef." Defendant's Executive Vice President Angelo Fili testified that Defendant's 1881 Omaha Hereford Logo trademark was used only on Hereford beef products and not on any other beef products. (39 TTABVue 82-83/Fili Depo. at page 81, line 24 to page 82, line 8). Therefore, Defendant GOP's mark cannot be a house mark used on a variety of goods. It is a product mark.

Therefore, applying the 9th *duPont* factor to the evidence results in a conclusion that, because Defendant GOP's mark is not a house mark, but rather is a product mark, this factor favors Defendant GOP.

Factor 10. The market interface between Defendant GOP and the owner of a prior mark.

The goods in Defendant GOP's 1881 Omaha Hereford Logo registration are only Hereford beef. Plaintiff OSI has admitted that it does not sell Hereford beef. (28 TTABVue 17/Defendant's Third Notice of Reliance, NR-7, Request No. 9 – Admitted, Bates No. GOP-1056).

Therefore, applying the 10th *duPont* factor to the evidence results in a conclusion that, because there is little or no market interface between the parties, this factor favors Defendant GOP.

Factor 11. The extent to which Defendant GOP has a right to exclude others from use of its mark on its goods.

Defendant GOP owns the challenged Registration No. 3998763 for the 1881 Omaha Hereford Logo trademark. Defendant's officer Angelo Fili testified that the 1881 Omaha Hereford Logo trademark has been used on Hereford beef for almost four years from at least as early as June 4, 2012 to the present (March 16, 2016). (39 TTABVue 66/Fili Depo. at page 65, lines 6-17). Accordingly, Defendant GOP has the right, based on federal law and on common law, to exclude others from using Defendant GOP's registered 1881 Omaha Hereford Logo trademark in connection with Hereford beef.

Therefore, applying the 11th *duPont* factor to the evidence results in a conclusion that, because Defendant GOP has the right to exclude others from use of its mark, this factor strongly favors Defendant GOP.

Factor 12. The extent of potential confusion, i.e., whether *de minimis* or substantial.

Because Defendant GOP's registered 1881 Omaha Hereford Logo trademark includes, as a prominent portion, a very distinctive and claimed multi-colored black, white and maroon-colored oval design, as well as many other distinguishing elements, Defendant GOP submits that there is no meaningful potential for confusion. The fact that there has been no actual confusion as to source for almost four years of concurrent use of the parties' marks is strong evidence that Defendant's registered mark, which includes the very distinctive and claimed multi-colored oval design and other elements that are nowhere found in Plaintiff's mark, has at most a *de minimis* likelihood of causing potential confusion.

Therefore, applying the 12th *duPont* factor to the evidence results in a conclusion that the extent of potential confusion is *de minimis*. Therefore, this factor strongly favors Defendant GOP.

Factor 13. Any other established fact probative of the effect of use.

As discussed previously on page 31 of this brief, the intent of the “defendant” in adopting its mark may be considered for the purpose of the confusion analysis. Plaintiff OSI presented absolutely no evidence that Defendant GOP ever sought to copy any of Plaintiff’s marks. On the contrary, Defendant GOP’s witness Angelo Fili testified at length, and Defendant introduced many documents, clearly showing how Defendant, in complete good faith, created its registered 1881 Omaha Hereford Logo trademark with no thought of Plaintiff OSI’s marks or names. (39 TTABVue 63-64/Fili Depo. at page 62, line 14 to page 63, line 4). Plaintiff OSI has offered no evidence even suggesting that Defendant GOP had a bad faith intent, and all of the evidence demonstrates Defendant’s complete good faith in creating and adopting its 1881 Omaha Hereford Logo trademark.

Moreover, as discussed beginning on page 32 of this brief, Defendant’s goods are of the highest quality, as confirmed by the testimony of Plaintiff’s President Bruce Simon.

Therefore, applying the 13th *duPont* defendant’s intent and quality factors to the evidence results in a conclusion that Defendant GOP had a good faith intent when creating and adopting its 1881 Omaha Hereford Logo trademark, and the quality of Defendant’s goods is extremely high. Therefore, this factor strongly favors Defendant GOP.

7. Conclusion

Balancing the *duPont* factors, Defendant GOP submits that Plaintiff OSI has again failed to carry its burden of proof. Defendant GOP’s registered 1881 Omaha Hereford Logo mark does not so resemble Plaintiff’s OMAHA STEAKS mark as to be likely to cause confusion. Therefore, the Board should decide this case in favor of Defendant GOP, and dismiss the cancellation.

Respectfully submitted,

August 30, 2016



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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing document was served upon the attorney of record for the other party by e-mail on August 30, 2016.



I. Stephen Samuels

153.16G

APPENDIX – SEPARATE STATEMENT REGARDING EVIDENTIARY OBJECTIONS

Plaintiff Omaha Steaks International’s Objections

In Plaintiff OSI’s Main Brief, Plaintiff failed to preserve any of Plaintiff’s objections to Defendant GOP’s evidence, which Plaintiff made during Defendant’s testimony period, except for two objections. Therefore, Plaintiff has waived all of Plaintiff’s objections to Defendant’s evidence, except for those two preserved (maintained) objections. TBMP § 707.04.

Plaintiff preserved the following two objections to:

(Objection 1) Terri Peetz’ testimony given during her testimonial deposition (40 TTABVue 1-46/Peetz Depo. at pages 1-45), but did not preserve any objections to the exhibits offered during Ms. Peetz’ deposition.

On page 20 of its Main Brief on (33 TTABVue 25), Plaintiff stated: “Omaha Steaks objected to this testimony as it constituted improper *ex parte* discovery from non-party witnesses (Greater Omaha did not give notice of Ms. Peetz’ activities), hearsay, and violation of the witness-advocate rule. *Id.* at 3:10-5:24.”

(a) **“Improper ex parte discovery from non-party witness (Greater Omaha did not give notice of Ms. Peetz’ activities)”** – On March 24, 2016, both parties to this proceeding filed a Stipulation with the Board (36 TTABVue 1-3) stating: “Both parties stipulate that neither party will make any objection of any kind to the other party’s witnesses who have testified thus far in this proceeding based on any lack of identifying them in initial disclosures, and that all such objections made thus far are hereby irrevocably withdrawn.” On April 7, 2016, the Board noted and accepted the parties’ Stipulation. (43 TTABVue 1-2). Therefore, Plaintiff’s preserved objection to Ms. Peetz’ March 18, 2016 testimony based upon Defendant’s not giving notice of Ms. Peetz’ activities has been irrevocably withdrawn and/or waived in accordance with the parties’ Stipulation which was accepted by the Board. In addition, Ms. Peetz’ testimony did not constitute “discovery” in any way.

(b) **“Hearsay”** – Ms. Peetz’ testimony did not constitute hearsay because Ms. Peetz’ testimony included no out-of-court statements made by other persons. Fed. R. Evid. 801-802. With regard to the unobjected-to exhibits to the Peetz deposition, they were not offered to show that their contents were truthful, but rather they were offered to show that the unobjected-to exhibits existed and were available to consumers. Fed. R. Evid. 801(c)(2).

(c) **“Violation of ‘Witness-Advocate Rule’”** – Some states and other jurisdictions have rules against a lawyer’s serving as both an advocate and a witness in the same case. Ms. Peetz is not a lawyer. She is a paralegal. (40 TTABVue 9/Peetz Depo. at page 8, lines 19-22). Additionally, Ms. Peetz is not serving as an advocate in this case.

(Objection 2) Defendant’s Fifth Notice of Reliance (31 TTABVue 1-64). On page 22 of its Main Brief (33 TTABVue 27), Plaintiff stated: “This ‘evidence’ of third party uses of dissimilar marks on dissimilar goods has no relevance.” In response, Defendant submits that *duPont* Factor No. 6 specifically provides that third party uses are considered as evidence in determining likelihood of confusion. Thus, the many third party uses contained in Defendant’s Fifth Notice of Reliance are relevant and their value is for the Board to decide.

Defendant GOP’s Objections

Todd Simon’s Deposition

During Plaintiff OSI’s testimony deposition of Todd Simon (33 TTABVue 130-288), Defendant GOP made objections and hereby maintains its objections to the admission into evidence of the following exhibits and testimony:

Todd Simon Deposition Exhibit 1 (Schedule of Trademarks) – Defendant GOP objected to the admission of Exhibit 1 at 33 TTABVue 137-138/Todd Simon Depo. at page 8, line 18 to page 9, line 25 on a number of grounds. Exhibit 1 constitutes hearsay (Fed. R. Evid. 801-802) because it is an out-of-court statement made by another person (not by Todd Simon) that was offered to prove the truth of that statement. (33 TTABVue 242-243/Todd Simon Depo. at page 113, line 20 to page 114, line 16). Todd

Simon's testimony regarding Exhibit 1 is not admissible because Todd Simon testified that he did not himself create, and lacks the personal knowledge of the identity of the creator of, Exhibit 1. Fed. R. Evid. 602. Todd Simon speculated that Exhibit 1 was created by Karen Shirk or Nancy Morris or Denise Mazour. (33 TTABVue 136-138/Todd Simon Depo. at page 7, line 20 to page 9, line 25). Todd Simon also testified that he could not personally swear that all of the information contained in Exhibit 1 was completely accurate. (33 TTABVue 243/Todd Simon Depo. at page 114, lines 13-16). In addition, Todd Simon's testimony about Exhibit 1 on 33 TTABVue 136-139/Todd Simon Depo. at page 7, line 20 to page 10, line 21 is not admissible because it constitutes opinion and speculation. Fed. R. Evid. 701. Most importantly, Plaintiff OSI's attorney Nora Kane stated on 33 TTABVue 138/Todd Simon Depo. at page 9, lines 14-21: "And I'm not offering it [Exhibit 1] for more substantive purposes than just to show that Mr. Simon is familiar with Omaha Steaks' marks portfolio only to talk about the advertising that he's done in conjunction with them. I plan to introduce more substantive information by Notice of Reliance and through Mr. Bruce Simon tomorrow." Defendant GOP's attorney Stephen Samuels then stated: "I'll maintain my objection until that happens." Accordingly, Defendant submits that Plaintiff substantially withdrew Plaintiff's offer of Exhibit 1.

Todd Simon Deposition Exhibit 2 (Plaintiff's Omaha Steaks International's Answer to Defendant GOP's Interrogatory No. 31) – At 33 TTABVue 140/Todd Simon Depo. at page 11, lines 1-18, Defendant GOP's attorney Samuels objected to the admission of Exhibit 2 (which was not filed with the TTAB), on the ground that Exhibit 2 is Plaintiff's discovery response (an answer to an interrogatory) offered by Plaintiff, which is prohibited by TBMP § 704.10 ("Ordinarily, an answer to an interrogatory, or an admission to a request for admission, may be submitted and made part of the record by only the inquiring party.") At 33 TTABVue 140/Todd Simon Depo. at page 11, lines 7-12, Plaintiff OSI's attorney Kane stated "There we go. Answer to interrogatory number 31 I'll represent to you was prepared by me and sworn to by you. Can you tell us in interrogatory number 31 if the answer to the annual domestic advertising budget is correct for the years shown?" At that point, Defendant GOP's attorney

Samuels objected at 33 TTABVue 142-144/Todd Simon Depo. at page 11, line 19 to page 15, line 12 to both the admission of Exhibit 2 and to Todd Simon's testimony about Exhibit 2 on a number of grounds. At 33 TTABVue 242/Todd Simon Depo. at page 114, lines 10-13, Todd Simon testified that he did not prepare the advertising records for his company. Therefore, Todd Simon lacked the personal knowledge to answer the question because he did not create Exhibit 2 (Attorney Kane created it) and Todd Simon did not have personal knowledge of the methodology or the detailed advertising totals in Exhibit 2. Fed. R. Evid. 602. At 33 TTABVue 246/Todd Simon Depo. at page 117, lines 8-16, Todd Simon testified that his "personal knowledge" of the financial information in the answer to Interrogatory 31 on Exhibit 2 came "From our financial team at our company." That is not personal knowledge which lays the foundation for admissible testimony about advertising expenses. Fed. R. Evid. 602. That is hearsay which is prohibited by Fed. R. Evid. 802. At 33 TTABVue 226-227/Todd Simon Depo. at page 97, line 15 to page 98, line 2, Defendant's attorney Samuels objected to Todd Simon's reading from Exhibit 2, and Plaintiff's attorney Kane responded that Mr. Simon was "relying upon [Plaintiff's] answers to interrogatories." Such reliance is prohibited by TBMP § 704.10.

Exhibit 2 does not constitute a business record. Fed. R. Evid. 803(6). Exhibit 2 and Todd Simon's testimony both constitute inadmissible hearsay (Fed. R. Evid. 802) because the financial advertising expense information contained in the answer to Interrogatory 31 was gotten "from our financial team at our company" and not from Todd Simon's own personal knowledge. (See, 33 TTABVue 246/Todd Simon Depo. at page 117, lines 8-16.)

Finally, Defendant's attorney Samuels objected (33 TTABVue 141-144/Todd Simon Depo. at page 12, line 10 to page 15, line 12) to the admission of Exhibit 2 and to Todd Simon's testimony about Exhibit 2 on the ground of relevance (Fed. R. Evid. 401) because the financial advertising expense figures contained in Exhibit 2 included not only advertising for beef, but also advertising for all types of non-meat food products, and because the financial advertising expense figures included not only advertising in the United States, but also advertising worldwide. (33 TTABVue 258-259/Todd Simon Depo. at page

129, line 3 to page 130, line 21).

Todd Simon Deposition Exhibit 3 (Website Printout Listing Tradeshows) – At 33 TTABVue 166-168/Todd Simon Depo. at page 37, line 18 to page 39, line 10, Defendant GOP’s attorney Samuels objected to the admission of Exhibit 3 (which was not filed with the TTAB), and to Todd Simon’s testimony about Exhibit 3, on a number of grounds. Exhibit 3 is a website printout which was not created by Todd Simon and which was created by “our incentive and business—our business-to-business sales team.” (33 TTABVue 168/Todd Simon Depo. at page 39, lines 3-24). Todd Simon stated that he never attended any of the trade shows listed on Exhibit 3. Todd Simon’s testimony about Exhibit 3 is inadmissible because he lacked personal knowledge (Fed. R. Evid. 602) and because both Exhibit 3 and Todd Simon’s testimony constitute hearsay. Fed. R. Evid. 802. Todd Simon’s testimony about Exhibit 3 also constitutes speculation and opinion. Fed. R. Evid. 701.

Todd Simon Deposition Testimony (Regarding Digital Marketing) – At 33 TTABVue 188-194/Todd Simon Depo. at page 60, line 15 to page 65, line 3, Defendant’s attorney Samuels objected to Todd Simon’s testimony about digital marketing on a number of grounds.

All of Todd Simon’s testimony regarding digital marketing constitutes hearsay which is prohibited by Fed. R. Evid. 802. Todd Simon testified that the director of digital marketing gave him information which Todd Simon repeated from memory. (33 TTABVue 192-194/Todd Simon Depo. at page 63, line 13 to page 65, line 3). No business records were offered. Todd Simon’s testimony also constitutes inadmissible speculation and opinion. Fed. R. Evid. 701.

Todd Simon Deposition Exhibit 4 (Finn Partners – Holiday Season) – At 33 TTABVue 194-200/Todd Simon Depo. at page 65, line 17 to page 71, line 19, Defendant’s attorney Samuels objected to Exhibit 4 (which was not filed with the TTAB), and to Todd Simon’s testimony about Exhibit 4, on a number of grounds. Exhibit 4, which Todd Simon testified was prepared by “our PR agency in New York, Finn Partners,” constitutes inadmissible hearsay. Fed. R. Evid. 802. Exhibit 4 was not properly authenticated as required by Fed. R. Evid. 901. Exhibit 4 is not a business record under Fed. R. Evid.

803(6). No foundation was laid to show that the witness had personal knowledge about the methodology or the detailed totals of Exhibit 4, as required by Fed. R. Evid. 602. Exhibit 4 is not a summary which meets the requirements of Fed. R. Evid. 1006 because it was never made available for Defendant's examination or copying.

Todd Simon Deposition Exhibit 5 (Finn Partners – Father's Day) – At 33 TTABVue 200-201/Todd Simon Depo. at page 71, line 21 to page 72, line 1, Defendant's attorney Samuels objected to Exhibit 5 (which was not filed with the TTAB), and to Todd Simon's testimony about Exhibit 5, for all of the same reasons he objected to the similar Exhibit 4 and related testimony.

Todd Simon Deposition Exhibit 6 (Finn Partners – 2014 Annual PR Report) – At 33 TTABVue 202-205/Todd Simon Depo. at page 73, line 22 to page 26, line 4, Defendant's attorney Samuels objected to Exhibit 6 (which was not filed with the TTAB), and to Todd Simon's testimony about Exhibit 6, for all of the same reasons he objected to the similar Exhibits 4 and 5 and their related testimony.

Todd Simon Deposition Exhibit 7 – (Advertising Piece) – At 33 TTABVue 207/Todd Simon Depo. at page 78, line 9 to page 78, line 25, Defendant's attorney Samuels objected to Exhibit 7 (which was not filed with the TTAB), and to Todd Simon's related testimony about Exhibit 7, for all of the same reasons he objected to Exhibits 4, 5 and 6, and their related testimony. At 33 TTABVue 254-255/Todd Simon Depo. at page 125, line 15 to page 126, line 18, Todd Simon testified that he did not individually instruct the preparer of Exhibit 7, and Todd Simon stated that he was relying on the inadmissible hearsay statements of his "team" (Fed. R. Evid. 802) as the basis for his saying that the numerical information in Exhibit 7 is correct, not on his own personal knowledge. Fed. R. Evid. 602.

Todd Simon Deposition Exhibit 8 – (News Item Report) – At 33 TTABVue 210-223/Todd Simon Depo. at page 81, line 7 to page 94, line 13, Defendant's attorney Samuels objected to Exhibit 8 (which was not filed with the TTAB), and to Todd Simon's related testimony about Exhibit 8 (much of Todd Simon's testimony consisted of his reading from Exhibit 8), for all of the same reasons Defendant's

attorney Samuels objected to Exhibits 4 and 5, and their related testimony, plus on the ground of the lack of authentication (Fed. R. Evid. 901) because Todd Simon stated on 33 TTABVue 211/Todd Simon Depo. at page 82, lines 19-20 that he did not know who compiled Exhibit 8. Attorney Samuels objected that Exhibit 8 is not a business record. Fed. R. Evid. 803(6). Both Exhibit 8 and Todd Simon's testimony about Exhibit 8 are inadmissible on the grounds of Todd Simon's speculation (Fed. R. Evid. 701); Todd Simon's lack of personal knowledge (Fed. R. Evid. 602); Todd Simon's lack of competence (Fed. R. Evid. 602); hearsay (Fed. R. Evid. 802); and because Exhibit 8 was not a summary which meets all of the requirements of Fed R. Evid. 1006.

Todd Simon Deposition Exhibit 9 (Photograph of Plaque) – At 33 TTABVue 225-230/Todd Simon Depo. at page 96, line 3 to page 101, line 12, Mr. Samuels objected to Exhibit 9 (which was not filed with the TTAB), and to Todd Simon's related testimony about Exhibit 9, on the grounds of Todd Simon's speculation (Fed. R. Evid. 701); Todd Simon's reading from the previously objected-to Plaintiff's Answer to Interrogatory 31 at 33 TTABVue 226-227/Todd Simon Depo. at page 97, line 15 to page 98, line 2; Todd Simon's lack of personal knowledge (Fed. R. Evid. 602); Todd Simon's lack of competence (Fed. R. of Evid. 602); speculation (Fed. R. Evid. 701); hearsay (Fed. R. Evid. 802); and lack of authentication (Fed. R. Evid. 901).

Bruce Simon's Deposition

During Plaintiff OSI's testimony deposition of Bruce Simon (33 TTABVue 2-129), Defendant GOP made objections and hereby maintains its objections to the admission into evidence of the following exhibits and testimony:

Bruce Simon's Testimony about Plaintiff's History – At 33 TTABVue 137-139/Bruce Simon Depo. at page 8, line 23 to page 10, line 24, Plaintiff's attorney Nora Kane asked Plaintiff's witness Bruce Simon: "How did Omaha Steaks begin, do you know?" Defendant's attorney Stephen Samuels objected to the question as calling for speculation and opinion (Fed. R. Evid. 701); and because the witness had no personal knowledge, had no competence and because no foundation had been laid (Fed. R. Evid. 602);

and because the witness' testimony would constitute hearsay (Fed. R. Evid. 802). Attorney Samuels stated that he was making a running line of such objections to all such testimony by the witness during the deposition on the subject of Plaintiff's history.

Bruce Simon Deposition Exhibit 9 (Photograph of Plaque) - At 33 TTABVue 139-142/Bruce Simon Depo. at page 10, line 25 to page 13, line 10, Defendant's attorney Samuels objected to Exhibit 9 (which was not filed with the TTAB), and to Bruce Simon's testimony about Exhibit 9, on the same grounds to which Exhibit 9 was objected when it was earlier offered during the Todd Simon deposition, including that no foundation had been laid, lack of personal knowledge and lack of competence (Fed. R. Evid. 602); opinion and speculation (Fed. R. Evid. 701); and lack of authentication (Fed. R. Evid. 901).

Bruce Simon Deposition Exhibits 10-25 (Cease and Desist Letters) - At 33 TTABVue 142-156/Bruce Simon Depo. at page 13, line 18 to page 27, line 13, Defendant's attorney Samuels objected to Exhibits 10-25, and to the witness' testimony about Exhibits 10-25, on the grounds that no foundation had been laid, lack of personal knowledge and lack of competence (Fed. R. Evid. 602); opinion and speculation (Fed. R. Evid. 701); and hearsay (Fed. R. Evid. 802). The witness did not testify from his own personal knowledge about the circumstances causing the letters to be written by another person; or about the marks allegedly used by the addressees of the letters; or about whether the addressees ever responded to the letters; or about whether the addressees ever agreed to comply with the demands contained in the letters; or about whether the letters had any effect with regard to causing the addressees to actually cease and desist from the complained-about conduct. The witness Bruce Simon was asked: "At whose direction did she [Denise Mazour who signed Exhibits 10-25] send this letter [Exhibit 10], if you know?" Bruce Simon then answered: "Probably Karen—Karen handles this kind of thing for us at either my or Todd's direction." Defendant's attorney Samuels then objected under Fed. R. Evid. 602, 701, 802 and 901. (33 TTABVue 143/Bruce Simon Depo. at page 14, lines 6-16).

Bruce Simon Deposition Exhibit 2 (Answer to Interrogatory 31) - At 33 TTABVue 156-158/Bruce Simon Deposition at page 27, line 14 to page 29, line 2, Defendant's attorney Samuels

objected to Exhibit 2 (which was not filed with the TTAB), and the witness' testimony (actually the witness' reading from Exhibit 2) about a list of cases in Exhibit 2 on the same grounds to which Exhibit 2 was objected, when it was offered during the earlier Todd Simon deposition, including TBMP § 704.10; and that no foundation had been laid, lack of personal knowledge and lack of competence (Fed. R. Evid. 602); opinion and speculation (Fed. R. Evid. 701); hearsay (Fed. R. Evid. 802); and relevance (Fed. R. Evid. 401).

Bruce Simon Deposition Testimony about Plaintiff's History – At 33 TTABVue 163-165/Bruce Simon Depo. at page 44, line 14 to page 46, line 14, Plaintiff's attorney Kane asked witness Bruce Simon: "What did Henry [Henry Davis, Defendant's President] say?" Defendant's attorney Samuels objected to the question and to the witness' very long and unresponsive answer on the grounds of hearsay (Fed. R. Evid. 802); opinion and speculation (Fed. R. Evid. 701); and competence, because no foundation had been laid, and lack of personal knowledge (Fed. R. Evid. 602). Bruce Simon's extremely unspecific comments about "our [unidentified] trademark" and spending "hundreds of millions of dollars developing our [unidentified] brand over the years since my Uncle Fred began placing [unidentified] ads in the New Yorker magazine in 1958 [before the witness began working for Plaintiff] do not constitute admissible evidence under Fed. R. Evid. 602, 701 and/or 802, and should be excluded from consideration.

Hal Poret's Deposition

During Plaintiff OSI's rebuttal testimony deposition of Hal Poret (44 TTABVUE 1-247), Defendant GOP made objections and hereby maintains its objections to the deposition in its entirety, and specifically to the admission into evidence of all of the Poret testimony and exhibits. Defendant attended the objected-to deposition under protest, which protest is hereby maintained, on the ground that the deposition was improper rebuttal. *See*, Trademark Rule 2.123(e)(3). As the deposition began, Defendant's attorney Samuels made the following statement at 44 TTABVue 6-8/Hal Poret Depo. at page 4, line 15 to page 6, line 22:

"Q. And I believe Mr. Samuels would like to make a statement for the record.
MR. SAMUELS: Thank you, Ms. Kane. Defendant GOP hereby objects to the

deposition testimony of Hal Poret, which is about to be taken, and hereby objects to all of the Poret deposition exhibits about to be offered. Defendant requests that the entire Poret testimony and all of the Poret exhibits be excluded from consideration by the board on two grounds:

One; Trademark Rule 2.121(b)(1) requires plaintiff to present its case-in-chief during its testimony period. Trademark Rule 2.121(c) states that the rebuttal testimony period is solely for rebuttal evidence. The Poret deposition testimony and exhibits are evidence in support of Plaintiff's case-in-chief and cannot properly be initially presented during Plaintiff's rebuttal testimony period.

And, two, the Poret testimony and exhibits do not rebut any of Defendant's evidence presented during Defendant's testimony period. Therefore, the Poret deposition testimony and exhibits constitute improper rebuttal testimony.

The foregoing objections are intended to be continuing objections which will continue from the opening until the close of the Hal Poret deposition. For this reason, the Defendant will not be repeating these continuing objections during the taking of the Poret deposition. However, by not repeating these continuing objections during the deposition, Defendant is not withdrawing these continuing objections.

Defendant will renew these objections in Defendant's main brief. Also, in Defendant's main brief, Defendant will more fully explain and provide case support for Defendant's request that the entire Poret testimony and all of the Poret exhibits be excluded from consideration. Thank you."

Hal Poret testified at 44 TTABVue 9/Hal Poret Depo. at page 7, line 3-8 that Plaintiff OSI's attorney Nancy Morris tasked him to design and conduct: "a survey to test whether the term "Omaha Steaks" and the term "Omaha" on its own have acquired secondary meaning." Exhibit 29 is Hal Poret's Expert Report dated May 2015. Exhibit 30 is Hal Poret's Supplemental Expert Report dated August 2015. The Plaintiff's Testimony Period ran from December 23, 2015 until January 22, 2016. Hal Poret's testimony deposition took place on April 27, 2016 during Plaintiff's Rebuttal Period which ran from April 21, 2016 to May 6, 2016.

In Plaintiff OSI's Notice of Opposition in this case, Plaintiff alleged in Paragraph 22 at 1 TTABVue 8/Notice of Opposition at page 5 that:

"By virtue of the high degree of acquired distinctiveness of the Omaha Steaks Marks [emphasis added], the long duration of extensive use of the Omaha Steaks Marks in connection with the goods and services with which the Omaha Steaks Marks have been used, ... the Omaha Steaks Marks have become well-known and famous by the general consuming public and the trade of the United States, as well as internationally, who have come to associate the goods offered and sold under the Omaha Steaks Marks with a single source and as distinctive indicators of the origin of Opposer's goods and services ..."

Accordingly, Plaintiff alleged in its Notice of Opposition that, as part of its case-in-chief, it would prove likelihood of confusion as to source by proving the acquired distinctiveness of the Omaha Steaks Marks, and by proving that those marks have become distinctive indicators of origin. These two underlined descriptors are synonyms for the “acquisition of secondary meaning” which Plaintiff’s witness Hal Poret testified was the purpose of the survey he was engaged to conduct. As Defendant’s attorney Samuels stated, during the Hal Poret deposition at 44 TTABVue 7/Hal Poret Depo. at page 5, lines 4-14, “Trademark Rule 2.121(b)(1) requires plaintiff to present its case-in-chief during its testimony period.” The Poret deposition testimony [given on April 27, 2016] and the Poret survey report exhibits [dated May 2015 and August 2015 – notably, both survey reports being dated many months prior to Plaintiff’s Testimony Period, which ran from December 23, 2015 to January 22, 2016], are evidence in support of Plaintiff’s case-in-chief and cannot properly be initially presented during Plaintiff’s rebuttal testimony period. Rebuttal is improper if it constitutes evidence that should have been submitted during Plaintiff’s main testimony period because it supports Plaintiff’s case-in-chief. Such improper rebuttal should be excluded from the record and given no consideration. *Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1632 (TTAB 2007); *Ritz Hotel Limited v. Ritz Closet Seat Corp.*, 17 USQP2d 1466, 1468-9 (TTAB 1990); *General Electric Co. v. Graham Magnetics Inc.*, 197 USPQ 690, 692 n. 5 (TTAB 1977).

Because Plaintiff waited to present Plaintiff’s long-existing survey evidence for the first time during Plaintiff’s rebuttal period, Defendant has been deprived of the opportunity to meet and rebut Plaintiff’s survey evidence. If Plaintiff’s case-in-chief survey evidence is permitted by the Board to be presented for the first time during Plaintiff’s rebuttal period, Defendant will be unfairly prejudiced because Defendant will not have had the opportunity to present its own survey expert as a witness to rebut Plaintiff’s belated survey evidence.

However, because Defendant cannot presently know how the Board will subsequently rule on Defendant’s objections to the Hal Poret deposition and exhibits, Defendant here submits (under protest and without waiving any of its objections) that Plaintiff’s survey was fundamentally flawed and is entitled

to no probative value because it asked its survey questions to a narrowly defined universe of respondents that was much too narrow and under-inclusive because it intentionally eliminated from the universe of respondents the vast majority of meat purchasers, such as those purchasing from grocery stores or any retailer other than Plaintiff. Because Plaintiff's survey universe was so narrow, the survey results were slanted to support the goal of the survey, and Hal Poret's opinions were therefore invalid. Also, Defendant points out that, because Plaintiff's survey did not show respondents any of Defendant's three trademarks, Hal Poret's opinions are irrelevant to the issue of the likelihood of confusion as to source.

Plaintiff's witness Hal Poret did NOT testify in rebuttal to Defendant's witness Terri Peetz' testimony or evidence (or to any of the other Defendant's witnesses' testimony or evidence). On cross-examination, Hal Poret testified at 44 TTABVue 30/Hal Poret Depo. at page 28, lines 2-14:

Q. Have you read the deposition in this case of Terri Peetz?

A. No.

Q. Your opinion, on page 26 of your survey, that the term "Omaha Steaks" has acquired a strong secondary meaning as an identifier of a single source of meat products does not rebut any of Terri Peetz's deposition testimony; isn't that correct?

A. I don't know because I haven't read it.

Q. Thank you.

Defendant GOP objects to and requests the exclusion of the entire Hal Poret deposition, including the Poret testimony, and all of the Poret exhibits, on the ground that they constitute improper rebuttal evidence. More specifically, not only were they untimely submitted, but they do not constitute rebuttal of any of Defendant's evidence at all. Hal Poret testified that he had never even read the Terri Peetz deposition (or any of Defendant's other witnesses' depositions). Hal Poret's testimony did not refute, deny or rebut any of Ms. Peetz' testimony or evidence. The Poret exhibits were prepared and dated many months *before* Ms. Peetz' deposition so they could not possibly refute, deny or rebut Ms. Peetz' evidence. At 44 TTABVue 22-27/Hal Poret Depo. at page 20, line 13 to page 25, line 10, Plaintiff's attorney Kane asked Plaintiff's witness Hal Poret several hypothetical questions, to which Defendant's attorney Samuels objected, seeking Hal Poret's speculation whether Hal Poret's survey reports would have changed if, hypothetically, he had known in 2015 what attorney Kane claimed that Ms. Peetz had said in her 2016

deposition. Over Defendant's attorney's objections, Hal Poret speculated, in response to attorney Kane's hypothetical questions, that he would not have made any changes in the objected-to exhibits. Defendant GOP submits that, because Hal Poret's testimony and exhibits did not rebut, refute or deny any of Terri Peetz' testimony or exhibits (or any of Defendant's other witnesses' testimony or exhibits), the entire Hal Poret deposition testimony and exhibits should be excluded from the record on the ground that they constitute improper rebuttal. *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1958 (TTAB 2008).

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