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

HORMEL FOODS CORPORATION, and )  
HORMEL FOODS, LLC, )  
 )  
 Petitioners, )  
 )  
 v. )  
 )  
 SPAM ARREST LLC, )  
 )  
 Registrant. )  
\_\_\_\_\_ )

Cancellation No. 92/042,143  
Mark: SPAM ARREST  
Reg. No. 2,701,493  
Registered March 25, 2003



U.S. Patent & Trademark Office  
Box TTAB NO FEE  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

06-01-2004  
U.S. Patent & TMOtc/TM Mail Rcpt Dt. #22

**MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE  
OF SPAMCOP.NET, INC. IN SUPPORT OF SPAM ARREST LLC**

SpamCop.Net, Inc., a Delaware corporation, hereby moves the Trademark Trial & Appeal Board for leave to file a brief *amicus curiae* in support of the motion for summary judgment of registrant Spam Arrest LLC in this proceeding. A proposed brief accompanies this motion. Leave should be granted for the following reasons.

The Board may, in its discretion, receive and consider an amicus brief if the Board finds that such a brief is warranted under the circumstances of a particular case. Trademark Board Manual of Practice §538. In so deciding, the Board may consider whether the proposed brief will aid the Board in resolving issues of law, whether the moving party is effectively seeking in a role in the proceeding beyond arguing questions of law, and is effectively arguing factual matters, among other things. *Id.*; see *Harjo v. Pro-Football, Inc.*, 45 USPQ2d 1789, 1791 (TTAB 1998).

All these issues should be favorably resolved here, and the amicus brief should be received. As the proposed amicus brief shows, SpamCop.Net, Inc. presents arguments of law relating to generic marks, dual-use terms, and public policy issues that will aid the Board in resolving the case. Further, the proposed brief does not argue contested facts, and does not present a partisan perspective that prejudices Hormel. While SpamCop.Net, Inc. is similarly situated with respect to Spam Arrest, in that SpamCop.Net, Inc. uses “spam” in a trademark that is the subject of an opposition by Hormel (as do at least eleven other parties), SpamCop.Net, Inc. has no business relationship or other affiliation with Spam Arrest. The case analysis, public policy issues and legislative history issues addressed by SpamCop.Net, Inc. in its amicus brief will prove helpful to the Board, and probably would not come before the Board without the amicus brief.

An amicus brief should be filed within the time allowed the party whose position the brief serves to support. TBMP § 538. The present amicus brief seeks to support a motion for summary judgment of Spam Arrest, and is filed within the period allowed for that motion and brief. Accordingly, this motion and the accompanying brief are timely filed.

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For all the foregoing reasons, the Board should grant the present motion and grant leave to file the proposed amicus brief presented concurrently herewith.

Respectfully submitted,

SPAMCOP.NET, INC.

Dated: May 28, 2004

By   
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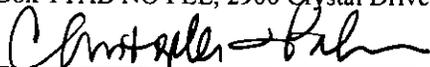
**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the within *Motion for Leave to File Brief Amicus Curiae* is being served by first-class mail, with postage affixed thereon and fully prepaid, upon the following attorney of record for Petitioner: Allen W. Hinderaker, Merchant & Gould P.C., P.O. Box 2910, Minneapolis, MN 55402-9944, and for Registrant: Derek A. Newman, Newman & Newman, 505 Fifth Avenue, Suite 610, Seattle, WA 98104, on this 28th day of May, 2004.

  
Christopher J. Palermo

**CERTIFICATE OF MAILING**

I hereby certify that the within *Motion for Leave to File Brief Amicus Curiae* is being deposited with the United States Postal Service by first-class mail in an envelope addressed to Commissioner for Trademarks, Box TTAB NO FEE, 2900 Crystal Drive, Arlington, VA 22202-3513, this 28th day of May, 2004.

  
Christopher J. Palermo

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
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**BRIEF AMICUS CURIAE OF SPAMCOP.NET, INC.**  
**IN SUPPORT OF**  
**MOTION FOR SUMMARY JUDGMENT OF SPAM ARREST LLC**

I. STATEMENT OF AMICUS CURIAE

SpamCop.Net, Inc. is a Delaware corporation engaged in the business of collecting information about senders of unsolicited commercial e-mail (“spam”) and distributing that information to network administrators and other parties that have a need to control spam. The SPAMCOP brand information service of SpamCop.Net, Inc. is available on the internet at the web site [www.spamcop.net](http://www.spamcop.net). SpamCop. Net, Inc. is a wholly-owned subsidiary of IronPort Systems, Inc., a privately-held firm headquartered in San Bruno, California ([www.ironport.com](http://www.ironport.com)). Neither SpamCop.Net nor IronPort have a business relationship or other affiliation with the registrant Spam Arrest LLC. However, petitioner Hormel is opposing SpamCop.Net’s application to register SPAMCOP for spam-prevention services.

## II. STATEMENT OF THE ISSUES

SpamCop.Net, Inc. takes no position on the findings of fact on which Hormel's claims may turn, but SpamCop.Net, Inc. does accept and adopt the statement of facts in the brief of Spam Arrest for purposes of this amicus brief. SpamCop.Net, Inc. files this amicus brief for purposes of addressing whether an owner of trademark rights with respect to one meaning of a dual-use generic term may not control use of a second meaning of the term, and to advise the Board about third parties whose applications, registrations or rights may be affected by the outcome of this case.

## III. SUMMARY OF THE ARGUMENT

The Board should dismiss the cancellation petition of Hormel with respect to U.S. Reg. No. 2,701,493, for SPAM ARREST, and the co-pending opposition proceeding (No. 92/153,159) of Hormel relating to Spam Arrest LLC's application. An owner of trademark rights in respect of one meaning of a dual-use term that has a second, generic meaning cannot prevent or restrict commercial use of the second meaning by another party with respect to goods or services relating to the second meaning. There is no need to consider dilution, likelihood of confusion, or other theories of relief pressed by the trademark owner, because a party has no enforceable trademark rights under any theory in a generic term. While SPAM may function as a mark for certain products of Hormel, the term "spam" is indisputably generic with respect to unsolicited commercial email. Thus, "spam" has become a dual-use term, and Hormel may not deprive others of the right to describe products or services relating to unsolicited commercial email using the term "spam," even in new trademarks, trade names and other designations for products or services relating to unsolicited commercial email. Prior cases, public policy and legislative

history require such a result. Numerous third parties have applications, registrations or rights that incorporate “spam,” indicating the widespread commercial reliance on and usefulness of the generic meaning of the term. Therefore, the Board should hold that when a trademark for a first product or service is transformed by any process into a generic term for an entirely different second product or service, thereby becoming a dual-use term, the trademark owner has no right to relief under any section of the Lanham Act that the Board is empowered to adjudicate, because the term cannot function as a mark for the second product or service.

#### IV. ARGUMENT

A. **The Rule of *Lucasfilm* and *Illinois High School* Require a Finding That An Owner of a Trademark for One Product Cannot Prevent Use of the Same Term that is Generic for Another Product, Even as Part of a Trademark for the Other Product.**

The facts of this case are unusual, but not unprecedented. Stated in a general manner, a first party--Hormel--adopted and used a term as a trademark for a first product. Through the action of a British comedy team, the mass media, and a large community of computer users—that is, actions beyond the control of Hormel—the term acquired an entirely different meaning, and entered the English language as a generic noun identifying unsolicited commercial email, something completely unrelated to the Hormel product. Numerous third parties then adopted the generic noun as part of new trademarks referring in part to unsolicited commercial email. Hormel now seeks to prevent registration of such marks.

Prior cases have resolved what courts should do when the public takes a trademark and gives it a generic meaning that is new. The United States District Court for the District of Columbia considered precisely that situation in *Lucasfilm, Ltd. v. High Frontier*, 622 F.Supp. 931, 227 USPQ 931 (D.D.C. 1985). *Lucasfilm* involved a claim of infringement by the producers

of the STAR WARS movies against political advocacy groups that used the term “star wars” to refer to the Strategic Defense Initiative promoted by the Reagan Administration. The court held that because the term “star wars” had acquired a “double meaning,” Lucasfilm could not prevent use of the term to refer to SDI. *Id.*, 227 USPQ at 970. “Trademark laws regulate unfair competition, not the parallel development of new dictionary meanings in the everyday give and take of human discourse,” the court observed. *Id.*, 227 USPQ at 969.

While *Lucasfilm* is informative and applies a common-sense rationale that is fully applicable here, the facts and legal context of *Lucasfilm* differ from the present case in several ways: the terms “star” and “wars” existed in the English language before Lucasfilm gave them trademark significance in relation to the STAR WARS films and related merchandise; the defendants used the term “star wars” in a non-commercial manner as part of political discourse; and Congress had not yet introduced anti-dilution provisions into the Lanham Act, 15 U.S.C. § 1125(c). See *Lucasfilm*, 227 USPQ at 967-68. (Hormel pleads dilution as one claim for relief in the present case.)

However, none of these complications are found in a case decided by one of the most learned jurists in the United States, Chief Judge Richard A. Posner of the United States Court of Appeals for the Seventh Circuit, who refused to enforce rights in a generic, dual-use term<sup>1</sup> under facts strikingly similar to those in this cancellation petition. *Illinois High School Ass’n v. GTE Vantage, Inc.*, 99 F.3d 244, 40 USPQ2d 1633 (7th Cir. 1996), *cert. den.* 117 S.Ct. 1083 (1997). There, the plaintiff had adopted the term “March Madness” for an annual high school basketball

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<sup>1</sup> Professor McCarthy addresses dual-use terms, *McCarthy on Trademarks*, §12:51, but there refers to cases involving marks that are generic to one population segment and not to another, for the *same category or class of goods*. Here, spam in reference to email has no relationship to the principal goods for which Hormel may use SPAM as a mark. McCarthy’s analysis is analogous, but not directly on point.

tournament. Network television broadcasts subsequently began using the term to refer to the National Collegiate Athletic Association (NCAA) tournament, and other generic uses arose (for example, terming an automobile sale as a “March Madness” event). The defendant, an NCAA licensee, used “March Madness” in packaging for a CD-ROM computer game. *Id.* at 1634-36. Thus the case is directly on point because it involved commercial use, it considered a term that became generic after its initial distinctive use by one party, and because the federal anti-dilution statute had been adopted. Chief Judge Posner distilled the applicable rule as follows:

“Let ‘March Madness’ be called not a quasi-generic term, or a term on its way to becoming generic, but a dual-use term. Whatever you call it, it’s a name that the public has affixed to something other than, as well as, the Illinois high school basketball tournament. A trademark owner is not allowed to withdraw from the public domain a name that the public is using to denote someone else’s good or service, leaving that someone and his customers speechless ... for the sake of protecting effective communication [the issue] should be resolved against trademark protection, thus assimilating dual-use or multiple use terms to generic terms.”

*Id.* at 1636. The court then analyzed *Lucasfilm* and presciently predicted, albeit in dicta, the proper result in the present case:

“If someone bought rights to the SDI from the U.S. government and sold the anti-missile program to another country under the name ‘Star Wars,’ nothing in the *Lucasfilm* opinion or in the principles of trademark law would entitle Lucasfilm to enjoin that use of the name. The name would have become attached by the public to another product as well as to the movies, just as happened here.”

*Id.* In other words, even if *Lucasfilm* had not involved non-commercial, political use, the result should be the same.

Taken together, *Lucasfilm* and *Illinois High School* provide the correct analytical framework for a decision in this case. An owner of trademark rights in respect of one usage of a dual-use term cannot prevent another from using the term commercially for its other meaning. There is no need to consider dilution, likelihood of confusion, or other theories, because generic

terms and dual-use terms are treated the same under all such theories; there is no trademark and therefore no protection.<sup>2</sup> Cf. *McCarthy on Trademarks*, §§12:1, 12:2. The trademark owner has no enforceable remedy against commercial uses of the second meaning of the term. See *Harley-Davidson, Inc. v. Grottanelli*, 49 USPQ2d 1458, 1462 (2d Cir. 1999).

**B. Principles of Public Policy Require the Same Result.**

Sound public policy supports this rule--as Chief Judge Posner noted, “protecting effective communication” requires it. Spam Arrest, SpamCop.Net, and numerous other parties need to be able to use the generic term “spam” as part of their trade name and trademarks in order to suggest to pertinent consumers that their products relate to internet spam prevention. The alternative—adopting names and brands such as “Unsolicited Commercial E-mail Cop”—would be ineffective and would mock the commercial reality that all pertinent consumers refer to unsolicited commercial email as “spam.” Indeed, because “spam” merely names a thing addressed by the products of Spam Arrest and SpamCop.Net, Inc., use of “spam” in marks such as SPAM ARREST, SPAMCOP and others is “the type of purely ‘nominative’ function that is not prohibited by trademark law.” *Lockheed Martin Corp. v. Network Solutions Inc.*, 44 USPQ2d 1865 (C.D. Cal. 1997) (holding NSI not subject to suit for trademark infringement based on use of domain names to name internet servers) (citing *New Kids on the Block v. News America Pub., Inc.*, 971 F.2d 302, 307, 23 USPQ2d 1534 (9th Cir. 1992)).

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<sup>2</sup> Dispensing with analysis of likelihood of confusion or dilution in cases involving generic or dual-use terms would properly conserve judicial resources. Indeed, an analysis of these theories in dual-use cases almost always would waste the Board’s time and resources. If a term serving as a mark for one class of goods is generic in reference to a second class of goods, the two classes of goods are *per se* unrelated, undercutting a key factor in the classic *Du Pont* confusion analysis. Further, the fact that a term is generic for any goods means that the term is almost certainly not inherently distinctive for purposes of determining dilution. See *Toro, Inc. v. ToroHead, Inc.*, 61 USPQ2d 1164, (TTAB 2001).

A contrary rule also would unfairly confer control of a generic term on a private party, Hormel, that is not involved in making or selling the goods and services identified by the generic term. Such a rule would have numerous far-reaching consequences. For example, tremendous uncertainty in brand development would occur. Parties seeking to clear use of a new trademark would have to consider whether any element of the mark is a dual-use term, and determine if any other party has trademark rights in a second meaning of the term for unrelated goods. The cost of clearance searches would increase significantly. For parties unable to absorb such costs, the likely result of such a rule would be a chilling effect on commercial speech. Further, there may be many others who want to adopt marks containing “spam” and relating to unsolicited commercial email prevention services and the like who have elected not to use such terms for fear of litigation with Hormel.

Granting the present cancellation petition on the basis of rights of Hormel in SPAM for canned meat and other products unrelated to the second, generic meaning of “spam” also would effectively introduce a new theory of protection into the Lanham Act without due consideration by Congress. The only cases on point both refuse to enlarge the Lanham Act to empower parties like Hormel to restrict use of generic terms. The Seventh Circuit, in another opinion of Chief Judge Posner, declined to enlarge the scope of dilution protection to generic terms in a similar situation. *Ty, Inc. v. Perryman*, 64 USPQ2d 1689, 1693-94 (7th Cir. 2002). Further, in an opinion with an extensive and careful analysis of the legislative history of the Dilution Act, the Second Circuit concluded: “Against a background of policies that strongly disfavor marks lacking inherent distinctiveness, according them only narrow protection, we think it highly unlikely that Congress intended to extend to such marks the expanded rights conferred by the Dilution Act ... It seems unlikely that Congress could have intended that the holders of ... non-distinctive marks

would be entitled to claim exclusivity for them throughout all areas of commerce.” *TCPIP Holding Co., Inc. v. Haar Communications Inc.*, (2d. Cir. 1999). The Second Circuit reached this conclusion after noting that the only marks cited in the legislative history of the Dilution Act as possible beneficiaries of the Act all were highly distinctive, arbitrary, and fanciful marks. *Id.*, citing H.R. Rep. No. 104-374, at 3, reprinted in 1995 U.S.C.C.A.N. 1029, 1030.

Similarly, the Board should decline Hormel’s invitation to act as a legislative body. Congress is the only entity that could properly consider whether the nation’s trademark laws should control use of generic terms.

Moreover, numerous other parties are situated similarly to applicant Spam Arrest, including SpamCop.Net, Inc., in that the petitioner here, Hormel, is also opposing these parties’ efforts to register marks containing the generic term “spam” in reference to mass unsolicited commercial e-mail. However, Hormel’s efforts to oppose applications or cancel registrations that use “spam” in reference to unsolicited email is completely inconsistent with Hormel’s “Statement on SPAM Use” and its negligent “genericide” of “spam.” The Board should not, by a decision favorable to Hormel, encourage this sort of two-faced commercial behavior. The affected parties include at least twelve companies and individuals: SpamCop.Net, Inc, applicant for SPAMCOP in Opp. No. 91/125,885; Brightmail, Inc., applicant for MAKING SPAM HISTORY, Opp. No. 91/160,632; Server Authority, Inc., applicant for SPAM CHECKPOINT, No. 78/234,945; Network Associates, Inc., registrant for SPAMKILLER, Canc. No. 92/042,611; Michael T. Glaspie, applicant for SPAM TERMINATOR, Opp. No. 91/158,161 and Opp. No. 91/159,423; Panicware, Inc., applicant for SPAM WASHER, No. 76/414,318; John Gotts, applicant for GOT SPAM?, No. 78/132,264; The Incentive Company, applicant for YOU’VE GOT SPAM, No. 78/132,563, SPAM ASSASSIN, Opp. No. 91,155,651; SPAM SUBTRACT,

No. 78/132,582; Watchguard Technologies, Inc., registrant for SPAMSCREEN, Canc. No. 92/032,240; The Email Channel, Inc., applicant for SLAMMING IS SPAMMING, No. 75/836,937; Mindspring Enterprises, Inc., applicant for SPAMINATOR, Opp. No. 91/119,706; and Earthlink Network, Inc., applicant for SPAM SENTRY, No. 75/556,121.

The widespread commercial use by these parties and others of “spam” to refer to unsolicited email is a powerful indicator of the importance of “spam” as a nominative and generic term in reference to unsolicited email. Enforcing rights of Hormel in SPAM as applied to unsolicited email would be patently unfair to all parties that have relied on the generic meaning of the term in adopting and using their corporate names, brands and marks. The result would be as egregious as the concern expressed by the Second Circuit in *TCPIP Holding Co.*, where enforcement of a descriptive mark under the Dilution Act would have meant that “[i]nnumerable good-faith junior users of the same weak marks, who have developed goodwill in these marks, would be denied further use of their marks to their detriment and that of their customers.” *TCPIP Holding Co., supra*.

As a practical matter, a decision as urged in this brief also has the potential to promptly sweep all the foregoing cases from the Board’s docket, because the applicants and registrants probably will seek summary judgment on the basis that Hormel lacks enforceable rights. The result would be a proper and significant conservation of judicial resources for numerous cases that otherwise would require considerable time and involve considerable costs to litigate and resolve.

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V. CONCLUSIONS

For all the foregoing reasons, the Board should dismiss the cancellation petition of Hormel with respect to Spam Arrest's registration for SPAM ARREST. Because of the importance of this issue to many other parties, the Board should hold that when a trademark for one product or service is transformed by any process into a generic term for an entirely different product or service, the trademark owner has no right to relief under any section of the Lanham Act that the Board is empowered to adjudicate.

Respectively submitted,

SPAMCOP.NET, INC.

Dated: May 28, 2004

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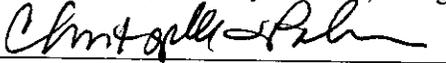
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