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

Ryan

Mailed: March 31, 2005

Cancellation No. 92042134

Hormel Foods Corporation

and

Hormel Foods, LLC

v.

Spam Arrest LLC

**Before Seeherman, Hairston, and Holtzman,
Administrative Trademark Judges.**

By the Board:

Respondent Spam Arrest LLC is the owner of Registration No. 2701493 for the mark SPAM ARREST in typed form. Respondent's registration, which issued on March 25, 2003, covers "computer software, namely, software designed to eliminate unsolicited commercial electronic mail" in International class 9. The claimed date of first use identified in the registration is August 24, 2002.

On May 5, 2003, Hormel Foods Corporation and Hormel Foods, LLC jointly petitioned to cancel respondent's registration. As grounds for cancellation, petitioners allege: (i) likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. §1052(d)

with petitioners' previously used and registered SPAM mark and family of SPAM marks; (ii) dilution under 15 U.S.C. §1125(c); and (iii) in the alternative, that SPAM ARREST is generic or merely descriptive of respondent's services under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1).

In the petition to cancel, petitioners claim ownership of ten registrations for the mark SPAM for a variety of meat products and collateral goods/services ranging from "t-shirts" to museum services."¹ Other registered marks relied on by

¹ Registration No. 0755187, registered August 20, 1963 for "deviled luncheon meat spread" in International class 29; Registration No. 1338031, registered May 28, 1985 for "t-shirts" in International class 25; Registration No. 1415969, registered November 4, 1986 for "caps" in International class 25; Registration No. 1498745, registered August 2, 1988 for "wearing apparel" in International class 25; Registration No. 1505620, registered September 27, 1988 for "kitchen hand tools, namely slicers" in International class 23; Registration No. 1716102, registered September 15, 1992 for processed meat" in International class 29; Registration No. 1985602, registered July 9, 1996 for "magnets" in International class 9, "jewelry, namely watch, necklace, earrings, and tie tack" in International class 14, "playing cards, pencils, pens, and note cube" in International class 16, "mug and insulated beverage containers" in International class 21, and "tennis balls, golf balls, money banks, and toys" in International class 28; Registration No. 2057484, registered April 29, 1997 for "entertainment services, namely participating in automobile races" in International class 41; Registration No. 2373313, registered August 1, 2000 for "poultry" in International class 29; and Registration No. 2639240, registered October 22, 2002 for "retail gift shop services" in International Class 35 and "educational and entertainment services, namely, providing museum services featuring exhibits, memorabilia, and various multimedia presentations" in International class 41.

petitioners are SPAMARAMA,² SPAMBURGER,³ and SPAM JAM.⁴

In its answer, respondent admits that petitioners are the owners of their pleaded registrations and respondent's mark "is composed of petitioner's entire SPAM mark with the term 'ARREST' immediately following petitioners' mark." Respondent denies all other salient allegations in the petition to cancel. In addition, respondent asserts the affirmative defenses of acquiescence and estoppel. As amplifications of respondent's denials, respondent further contends that the term "spam" is generic when used to describe unsolicited e-mail.

This case now comes up for consideration of:

(1) respondent's May 27, 2004 motion for summary judgment on all pleaded grounds and on its affirmative defenses of acquiescence and estoppel; and (2) the June 1, 2004 motion for leave to file a brief amicus curiae in support of respondent's summary judgment motion, filed by SpamCop.Net, Inc. ("SpamCop"). Petitioners have opposed both of these motions.

We have carefully considered the briefs and evidence submitted in connection with the pending motions. In the

² Registration No. 2059462, registered May 6, 1997 for "entertainment services in the nature of an annual festival featuring a variety of activities, namely, exhibitions, cooking and other contests, and music" in International class 41.

³ Registration No. 1819104, registered February 1, 1994 for "processed meat" in International class 29.

⁴ Registration No. 2561571, registered April 16, 2002 for "entertainment services in the nature of an annual festival featuring a variety of activities, namely exhibitions, cooking and other contests, and music" in International class 41.

interest of moving this case forward, we shall forego an exhaustive review of the arguments and evidence filed herein and presume the parties' familiarity with the record.

As a preliminary matter, we consider whether to grant leave to SpamCop to file an *amicus* brief in support of respondent's motion for summary judgment.

The privilege of being heard *amicus* rests in the discretion of the court or, in this case, the Board. See *Harjo v. Pro Football, Inc.* 45 USPQ2d 1789, 1791 (TTAB 1998), citing *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 5 USPQ2d 1067 (TTAB 1987). In determining whether to grant leave, the Board considers whether the proposed brief will aid the Board in resolving issues of law, whether the moving party is effectively seeking a role in the proceeding beyond arguing questions of law, and whether the moving party is asserting prejudicial and partisan arguments of fact. See *Harjo*, *supra* at 1791. Motions for leave to file an *amicus* brief are seldom filed in Board proceedings, and the granting thereof by the Board is even more rare. See TBMP §538 (2d. ed. rev. 2004).

By its motion for leave, SpamCop asserts that its brief is helpful to the Board by its analyses of the case facts, public policy, and legislative history. Petitioners disagree, arguing, among other things, that SpamCop's brief is a partisan's advocacy of law and facts insofar as SpamCop is the defendant in a related

proceeding in which petitioners, as opposers, have filed a notice of opposition against SpamCop's mark, SPAMCOP.⁵

As we consider the involvement of SpamCop in a related proceeding involving similar issues of law and fact, we are mindful of petitioners' concern with the partisan role of SpamCop herein. Unquestionably, SpamCop's brief represents an improper attempt to intervene and persuade the Board to subscribe to a factual position that would unduly prejudice the petitioners in this case and in the related opposition proceeding as well.

In view thereof, the motion for leave to file a brief *amicus curiae* is denied. A courtesy copy of this decision shall be forwarded to SpamCop.

We turn next to respondent's summary judgment motion on the issues of likelihood of confusion, dilution, genericness, descriptiveness, acquiescence, and estoppel. Summary judgment is appropriate in cases where the moving party establishes that there are no genuine issues of material fact which require resolution at trial and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). The evidence of record must be viewed in the light most favorable to the nonmoving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). If the moving party meets its burden, the nonmoving party

⁵ See Opposition No. 91125885 in which Hormel Foods LLC and Hormel Food Company, Inc. plead essentially the same grounds for opposition which form the basis for the petition to cancel in this proceeding.

must submit countering evidence sufficient to raise a genuine issue of fact for trial.

With the above guidelines, we find that this case is not ripe for decision on summary judgment.⁶ At a minimum, we find the following genuine issues of material fact with respect to each of these issues.

In terms of likelihood of confusion, we find genuine issues of material fact as to the commercial impression of the mark used on respondent's goods, whether the fame of petitioners' mark extends to goods other than meat products, and whether the parties' respective goods will be perceived by consumers as related, given the wide variety of petitioners' SPAM goods and services.⁷

Turning to dilution, we find genuine issues in terms of tarnishment and blurring. We find that the parties' dueling expert opinions regarding the survey conducted by petitioners' expert, George Mantis, are sufficient to raise a genuine issue of material fact as to petitioners' alleged economic harm or "lessening" of the capacity of petitioners' SPAM mark to identify its goods and services.⁸ See *NASDAQ Stock Market Inc. v.*

⁶ The parties are reminded that the burden on summary judgment differs from the burden of proof at trial.

⁷ See, e.g., petitioners' Declarations of Shawn Radford, George Mantis, Nicholas Meyer, and Stan Petzel, with Exhibits, and respondent's motion for summary judgment, Exhibits 1 through 8.

⁸ See petitioners' Declaration of George Mantis (Exhibit 1) and Declaration of Gregory Carpenter (Exhibit 1.) See also respondent's Declaration of Lea Knight (Exhibit B) and Exhibit 26 to respondent's motion for summary judgment.

Antartica S.r.l, 69 USPQ2d. 1718 (TTAB 2003); and *Toro Co., v. ToroHead Inc.*, 61 USPQ2d. 1164 (TTAB 2001).

As we look to the evidence of third-party use of the terms "arrest" and "spam" in the computer field, we find petitioners' have produced evidence sufficient to raise a genuine issue of material fact as to the genericness and/or descriptiveness of respondent's mark.⁹

Moreover, we find genuine issues of material fact as to both acquiescence and estoppel, given petitioners' website evidence regarding its trademark policing policy and petitioners' evidence of its enforcement efforts.¹⁰

Accordingly, respondent's motion for summary judgment is denied in all respects.¹¹ See Fed. R. Civ. P. 56.

Discovery is closed; trial dates are **reset** as indicated below.¹²

⁹ See petitioners' Declaration of William Schultz, Exhibit 3 (dictionary definition of "arrest"), Exhibit 8 (samples of the terms "arrest" and "spam" used together on the Internet at www.nutritionadvisor.com, www.zdnet.com, and in results of a Yahoo search), and Exhibit 12 at pages 38 and 39. Regarding the meaning of the term "spam," see also respondent's answer and affirmative defenses, paragraphs 15 and 17 and respondent's motion for summary judgment, Exhibit 8.

¹⁰ See petitioners' Declaration of Kevin Jones, Exhibits 3, 4 and 6.

¹¹ The parties are reminded that the evidence submitted in connection with a motion for summary judgment is ordinarily of record only for purposes of that motion. If the case goes to trial, the summary judgment evidence may not form part of the evidentiary record to be considered at final hearing unless it is properly introduced in evidence during the appropriate testimony period. TBMP §528.05(a) (2d. ed. rev. 2004).

¹² If the parties seek to extend the trial schedule in this case, any future consented motions to extend should set forth all dates in the format shown in this order. See Trademark Rule 2.121(d).

DISCOVERY PERIOD TO CLOSE: **closed**

30-day testimony period for party in the position of plaintiff to close: **June 7, 2005**

30-day testimony period for party in the position of the defendant to close: **August 6, 2005**

15-day rebuttal period for party in the position of the plaintiff to close: **September 20, 2005**

IN EACH INSTANCE, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within **thirty days** after completion of the taking of testimony. Trademark Rule 2.125. Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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Notice Regarding TTAB Electronic Resources and New Rules

- TTAB forms for electronic filing of extensions of time to oppose, notices of opposition, and inter partes filings are now available at <http://estta.uspto.gov>. Images of TTAB proceeding files can be viewed using TTABVue at <http://ttabvue.uspto.gov>.
- Parties should also be aware of changes in the rules affecting trademark matters, including rules of practice before the TTAB. See Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. R. 55,748 (September 26, 2003) (effective November 2, 2003) Reorganization of Correspondence and Other Provisions, 68 Fed. Reg. 48,286 (August 13, 2003) (effective September 12, 2003). Notices concerning the rules changes are available at www.uspto.gov.
- The second edition of the Trademark Trial and Appeal Board Manual of Procedure (TBMP) has been posted on the USPTO web site at www.uspto.gov/web/offices/dcom/ttab/tbmp/.