

From: cjordan@stinsonmoheck.com
Sent: Tue 6/10/03 04:27 PM
Subject: Applebee's v. Stouffer's - Opposition No. 111,517 - Corrected pages for Applebee's Rebuttal Brief

Dear Annie:

It is probably too late for you to make inserts this afternoon, but I hope you will have time tomorrow morning because you get there so early. Again, thanks for all your help with this. I know this has been a nuisance for you, and I appreciate your gracious assistance.

Connie Jordan

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<<DTMDOCS-#763679-v1-Corrected_Pages_Only_of_Reply_Brief_SKILLET_SENSATIONS_to_be_emailed_to_TTAB.DOC>> <<DTMDOCS-#762342-v1-Ltr_to_Annie_Burroughs_at_TTAB_-_SKILLET_SENSATIONS.DOC>> <<DTMDOCS-#760132-v1-Opposer's_Consented_Motion_to_File_Substitute_Pages.DOC>>

F. Stouffer's has misstated the issues before the Board.

Stouffer's has stated that "priority based upon a use other than the alleged 1996 use of the mark 'Skillet SSSensations!' (stylized)" is not an issue before the Board (Stouffer's Brief p. 9). This is incorrect. Applebee's has pleaded common law use in the mark in block letter form, as well as rights in the stylized mark. Under the Federal Rules of Civil Procedure, all that is required is for notice to be given of the issues to be tried. Stouffer's has been on notice from the filing of Applebee's Notice of Opposition that Applebee's claimed rights in a stylized version of its mark as well as the mark without regard to style. This issue was covered in discovery and in testimony and has been tried to the Board.

Applebee's also objects to Stouffer's characterization of issues "identified by the Board" (Stouffer's Brief p. 8) as including the issue of tacking. While the Board acknowledged that Stouffer's **contended** that tacking was an issue, it is Stouffer's that persists in describing this as a "tacking" case. Because Applebee's is proceeding under common law rights in its mark, both stylized and without regard to style, this is clearly an analogous use case, not a tacking case.

II. REBUTTING THE POINTS IN STOUFFER'S BRIEF

A. Preliminary

Applebee's disagrees with many of the factual interpretations and arguments presented in Stouffer's brief and believes that Applebee's position was succinctly set forth in the main brief and in the record before the Board. However, in the following areas Stouffer's has made such gross misstatements as to necessitate Applebee's reply in order that the Board not be misled by Stouffer's unsupported allegations, suppositions and innuendo and attorney testimony.

B. Use by Apple South inured to benefit of Applebee's

Apple South was a licensee of Applebee's. Apple South's restaurants *existed* because of license agreements with Applebee's. Use of marks by licensees inures to the benefit of licensors

secondary meaning or through "whatever other type of use may have developed a trade identity." Citing to *Otto Roth & Co. v. Universal Foods Corp.*, 209 U.S.P.Q. 40, 43 (C.C.P.A. 1981).

In *Shalom Children's Wear Inc. v. In-Wear A/S*, 26 U.S.P.Q. 2d 1516, 1519 (TTAB 1993), the Board held: "No distinction is made concerning whether such use must be use which could be the basis for registration (i.e., 'technical' trademark use), constructive use created by filing an intent-to-use application, or the kind of use known as 'use analogous to trademark use,' which has long been sufficient to establish prior rights in a trademark. On the question of analogous use, see *National Cable Television Association, Inc. v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991)."

Stouffer's has alleged that Applebee's mark is merely descriptive because all of the SKILLET SENSATIONS meals are "sensational." (Stouffer's Brief p. 20). While Applebee's appreciates this acknowledgement, it disagrees with Stouffer's assessment of descriptiveness. In the third party registrations submitted by Stouffer's (Applicant's Third Notice of Reliance), the word "sensations" has not been disclaimed in a single registration, nor did any of the registrations proceed on the basis of a claim of 2(f) acquired distinctiveness. In keeping with this policy, the Trademark Office did not require Applebee's to disclaim "sensations" in pending application Serial No. 75/308,648, although both Applebee's and Stouffer's were required to disclaim the word "skillet." Although the registrations submitted by Stouffer's are not evidence of use, the registrations are prima facie evidence that the registered marks were considered by the Trademark Office to be inherently distinctive without a showing of acquired distinctiveness. Therefore, by comparison with the other "SENSATIONS" registrations, it is clear that the Trademark Office does not consider the phrase "SKILLET SENSATIONS" to be merely descriptive.

- A. That's correct.
- Q. And nowhere in that document is there any mention of the name Skillet Sensations being the name for the IQF product, correct?
- A. That is correct.
- Q. In all of the other exhibits that you discussed, there is no indication in any of those exhibits as to what the wording was on the product that was given to the interviewee in the March 1997 test, correct?
- A. The language on the product?
- Q. Yes. My question is, there is nothing in any of these exhibits that indicates whether that language—if any language even appeared or not, correct?
- A. Yes. From what I can recall, yes, I do not remember seeing anything in here that talked to that language.
- Q. And did you ever even see the product yourself in the package before it was given to the interviewee?
- A. Personally, no.
- Q. Because in fact the product was shipped directly from Stouffer's to the interview locations, correct?
- A. That is correct.
- Q. And when you testified that the name Skillet Sensations was used with the product which the recipients received in the March 1997 test, you were referring to the fact that the product was referred to as Skillet Sensations during the oral interview, correct?
- A. Yes, in the concept statement or the concept board that was shown to the consumer.

Paul DeVries, Stouffer's Director of Marketing Information, testified as follows on November 14, 2000 (DeVries, p. 36):

- Q. And again, at this point in time [January 28, 1997], the BASES Group was referring to the product as Stouffer's Homestyle Skillets, isn't that correct?
- A. Yes, in the first sentence there [referring to Ex. 27].

Inc., Opposition No. 84,567, slip op. at 10 (TTAB September 29, 1995), *TBC Corp. v. Holsa Inc.*, 44 U.S.P.Q. 2d 1315, 1316 (Fed. Cir. 1997).

Applebee's further objects to Stouffer's characterization in its Third Notice of Reliance to "sensations" as "a common laudatory word for food items." Stouffer's has absolutely no support for this assertion and certainly the Trademark Office has not issued such a proclamation. The Board should ignore this unsupported argument.

J. The marks are confusingly similar

Stouffer's is attempting to register its mark for "frozen prepared dinner mix consisting primarily of meat, vegetables and potatoes with rice or pasta." There are no restrictions as to channels of trade and, in fact, the description does not even limit the sales to grocery stores or supermarkets. Where an application does not contain any limitations, it is presumed to cover all normal trade channels and customers of all types. *Octocom Systems Inc. v. Houston Computers Services Inc.*, 16 U.S.P.Q.2d 1783, 1787 (Fed Cir. 1990).

The Court has held that a single DuPont factor may be dispositive of likelihood of confusion. *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 47 U.S.P.Q. 2d 1459 (Fed Cir. 1998). In this case, the marks are identical, the consumers are identical, the channels of trade are unlimited. Many restaurants now sell their products in grocery stores (Iantosca Disc. Dep. 2/8/2000 pp. 96-97). Applebee's has sold its products in grocery stores (Applebee's Brief p. 19; Applebee's Exhibit 31). Both Applebee's and Stouffer's products are, as stated in *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 223 U.S.P.Q. 1281, 1282 (Fed Cir. 1984) "relatively inexpensive, comestible goods subject to frequent replacement. Purchasers of such products have been held to a lesser standard of purchasing care."

K. Lack of showing of actual confusion is not determinative

Stouffer's attempts to find significance in the fact that there has been no actual confusion in this matter (Stouffer's Brief pp. 31-32). Nothing can be assumed from this fact. Both Applebee's and Stouffer's are leaders in their fields with good reputations. If a consumer mistakenly bought a product from one source, believing it to be from the other source and the product was satisfactory, it is unlikely the issue of confusion would ever come up.

A plaintiff is not required to prove actual confusion for the Board to find that marks are confusingly similar. *Eclipse Associates Ltd. v. Data General Corp.*, 13 U.S.P.Q. 2d 1885, 1888 (9th Cir. 1990). Stouffer's has admitted that restaurants sell their specialty products in grocery stores (Iantosca Disc. Dep. pp. 96-97), and that grocery stores offer prepared meals for consumers to take home (Iantosca Disc. Dep. p. 97). Restaurants are increasingly catering to the carryout trade. Groceries frequently sell deli items, some of which have to be warmed up or minimally cooked. The marks are identical in sight, sound and connotation, and the products are related. Where there is any doubt as to confusion, the issue must be resolved against the newcomer. *In re Hyper Shoppes (Ohio) Inc.*, 6 U.S.P.Q. 2d 1025, 1026 (Fed. Cir. 1988).

III. SUMMARY

Accordingly, having replied to the points raised in Stouffer's Brief, and having continued to demonstrate that Applebee's has priority of use and that confusion is likely, Opposer Applebee's International, Inc., requests that the Board sustain the opposition and deny registration to Applicant Stouffer's of the mark SKILLET SENSATIONS.

Respectfully submitted,

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ATTORNEYS FOR OPPOSER

CERTIFICATE OF SERVICE

I hereby certify that a copy of the above and foregoing Corrected Reply Brief of Opposer Applebee's International, Inc. was served upon Applicant's attorney by depositing the same in the United States mail, first class postage prepaid, on this _____ day of June, 2003, addressed to:

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June 5, 2003

FEDERAL EXPRESS

Ms. Annie Burroughs
Trademark Trial & Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Re: Applebee's International, Inc. v. The Stouffer Corporation
Opposition No. 111,517
Mark: SKILLET SENSATIONS

Dear Ms. Burroughs:

Pursuant to our telephone discussion this afternoon, I am enclosing three sets of corrected pages 5, 9, 11, 14, 15 and 16 to be inserted in Applebee's (Opposer's) Reply Brief. These corrected pages are to be inserted in the three copies of the original Reply Brief in lieu of substituting the Corrected Reply Briefs sent earlier.

I apologize for any inconvenience to you or to the members of the Board.

Very truly yours,

STINSON MORRISON HECKER LLP

Constance M. Jordan

CMJ:mmi

Enclosures

cc: Mr. Robert V. Vickers (w/encs.)

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DTMDOCS 762342v1

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

APPLEBEE'S INTERNATIONAL, INC.)	
)	
Opposer,)	Opposition No. 111,517
)	
vs.)	Serial No. 75/301,628
)	
THE STOUFFER CORPORATION)	Mark: SKILLET SENSATIONS
)	
Applicant.)	

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**OPPOSER'S CONSENTED MOTION TO FILE
SUBSTITUTE PAGES IN OPPOSER'S REPLY BRIEF**

Opposer APPLEBEE'S INTERNATIONAL, INC. requests that it be permitted to file substitute pages 5, 9, 11, 14, 15 and 16 in its Reply Brief. These substitute pages correct errors and omissions in Opposer's original Reply Brief, as follows:

Page 5 – "**(cite)**" changed to "(Stouffer's Brief p. 9)."

Page 9 - "corp." changed to "Corp." "By" changed to "by"

Page 11 - "[January 28, 1977]" changed to "[January 28, 1997]"

Page 14 – "limited" changed to "limit"

Certificate of Mailing Under 37 C.F.R. 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as express mail in an envelope addressed to Box TTAB NO FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on:

Date: _____

Signature: _____

The Director is hereby authorized to charge any additional amount required, or credit any overpayment, to Deposit Account No. 19-4409.

"(cite)" changed to "(Iantosca Disc. Dep. 2/8/2000 pp. 96-97)"

Page 15 - "(Iantosca pp. 96-97)" changed to "(Iantosca Disc. Dep. pp. 96-97)"

"(Iantosca p. 97)" changed to "(Iantosca Disc. Dep. p. 97)".

Page 16 - "David J. Wharton" changed to "J. David Wharton"

This request is made for good cause to insert cites inadvertently omitted, to make other cites more specific, and to correct typographical errors. Attorney for Applicant, Robert V. Vickers of Fay, Sharpe, Fagan, Minnich & Mckee, LLP, has consented by telephone to substitution of the pages, with the understanding that his consent does not waive any issue, and especially the issues raised in Applicant's Motion to Strike previously filed in this action.

Accordingly, Opposer requests that the Board rule favorably on this motion and accept the corrected pages submitted herewith by Opposer.

Respectfully submitted,

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ATTORNEYS FOR OPPOSER

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Opposer's Consented Motion to File Substitute Pages in Opposer's Reply Brief with proposed substitute pages was placed in the United States mail, first class postage prepaid, this _____ day of June, 2003, addressed to:

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