

This Opinion is Not a  
Precedent of the TTAB

Oral Hearing: March 23, 2017

Mailed: September 30, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Omaha Steaks International, Inc.*

*v.*

*Greater Omaha Packing Co., Inc.*

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Opposition No. 91213527  
Cancellation No. 92059629  
Cancellation No. 92059455  
(as consolidated)<sup>1</sup>  
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ON REMAND FROM THE UNITED STATES COURT OF APPEALS FOR THE  
FEDERAL CIRCUIT

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Nora M. Kane  
for Omaha Steaks International, Inc.

I. Stephen Samuels of Samuel & Hiebert LLC  
for Greater Omaha Packing Co., Inc.

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<sup>1</sup> The record in these consolidated proceedings is maintained in Opposition No. 91213527 and all citations are to that proceeding unless otherwise noted. TTABVUE refers to the Board's electronic docket. Citations in this opinion are to the TTABVUE entry number and, where applicable, the electronic page number where the document appears. For material or testimony that has been designated confidential, the TTABVUE docket entry number where such material or testimony is located is referenced.

Before Thurmon,<sup>2</sup> Deputy Chief Administrative Trademark Judge,  
Taylor and Kuczma, Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

## I. Background

The original proceeding was consolidated and involved an opposition and two cancellation actions brought by Omaha Steaks International, Inc. (hereafter “Omaha Steaks” or “Plaintiff”) against three marks owned by Greater Omaha Packing Co., Inc. (hereafter “Omaha Packing” or “Defendant”). Plaintiff filed a notice of opposition against Defendant’s application to register the mark GREATER OMAHA PROVIDING THE HIGHEST QUALITY BEEF and design (shown below)



(hereafter GREATER OMAHA), for “meat, including boxed beef primal cuts” in International Class 29,<sup>3</sup> and petitions to cancel Defendant’s Registration No. 3998763 (Cancellation No. 92059629) for the mark U.S. Beef 1881 OMAHA HEREFORD CORN FED and design (shown below)

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<sup>2</sup> Judge Masiello sat on the panel for the Board’s September 30, 2017 decision. Judge Masiello has since retired, and Deputy Chief Administrative Judge Thurmon has been substituted for him on the panel deciding this case. The change in composition of the panel does not necessitate a retrial of this case. *In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1, 4 (Fed. Cir. 1985); *Hunt Control Sys. Inc. v. Koninklijke Philips Elect. N.V.*, 98 USPQ2d 1558, 1560 n.1 (TTAB 2011).

<sup>3</sup> Application Serial No. 85897951 filed April 8, 2013, and asserting a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). The words “Greater Omaha Providing the Highest Quality Beef” have been disclaimed. The application also includes the following description: The mark consists of the words “GREATER OMAHA” [which] are placed to the right of the profile of a steer’s head. The words “PROVIDING THE HIGHEST QUALITY BEEF” are below “GREATER OMAHA.”



for “Hereford beef” in Class 29;<sup>4</sup> and Registration No. 4006768 (Cancellation No. 92059455) for the mark OMAHA NATURAL ANGUS CORN FED MINIMALLY PROCESSED AND NO ARTIFICIAL INGREDIENTS and design (shown below)



for “Angus beef” in Class 29.<sup>5</sup>

Plaintiff pleaded in each of the three proceedings priority and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), and dilution

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<sup>4</sup> Issued July 19, 2009; Section 8 affidavit accepted. The mark consists of the words “Omaha Hereford” in white with a maroon border below a maroon and white graphic of a steer, appearing below the year “1881”, all encircled by a black oval border outlined in maroon and containing the words “U.S. BEEF” at the top and “CORN FED” at the bottom. The color(s) black, white, maroon is/are claimed as a feature of the mark. The white outline, gray background, and the shape of the gray background are not claimed as a feature of the mark. “U.S. BEEF”, “1881”, “OMAHA HEREFORD”, and “CORN FED” are disclaimed.

<sup>5</sup> Issued August 2, 2011; Section 8 affidavit accepted. The mark consists of a gold shield enclosing gray lines extending out from the center behind the word “OMAHA” in yellow with red outline above the word “Natural” in yellow with red outline above the word “ANGUS” in yellow appearing on a red banner above the words “CORN FED” in red surrounding a yellow circle containing a black silhouette image of a steer above the words “Minimally Processed and No Artificial Ingredients” in yellow. The rectangular shape of the black background is not claimed as a feature of the mark. “OMAHA NATURAL ANGUS”, “CORN FED”, and “MINIMALLY PROCESSED AND NO ARTIFICIAL INGREDIENTS” are disclaimed.

of the “famous designation OMAHA STEAKS” under Trademark Act Section 43(c), 15 U.S.C. § 1125(c).<sup>6</sup>

Plaintiff also alleged common law rights in OMAHA STEAKS as a trademark, alleging that it has continuously used the mark OMAHA STEAKS on food, including meat, dating back to at least as early as 1952.

The pleaded registrations Plaintiff focused on in its brief are set out below:<sup>7</sup>

**Registration No. 1458802** for the mark OMAHA STEAKS (in typed form and with “Steaks” disclaimed) is registered on the Principal Register pursuant to Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), for “retail mail-order and retail food store services in the field of gourmet food products, kitchen apparel and kitchen utensils” in International Class 42;<sup>8</sup>

**Registration No. 1674686** for the mark OMAHA STEAKS (in typed form and with “Steaks” disclaimed) is registered on the Principal Register

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<sup>6</sup> Plaintiff’s dilution claim was deemed waived in all three proceedings because it did not pursue the claim at trial. *See Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc. dba Watermark Cruises*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013), *aff’d mem.*, 565 F. App’x 900 (Fed. Cir. 2014).

<sup>7</sup> Plaintiff attached to its Notice of Opposition a “Schedule of Marks” listing all of the pleaded registrations and applications, along with printouts for each listed registration from the Trademark Electronic Search System (TESS) database showing current status and title. Plaintiff pleaded virtually the same marks in all three proceedings, as the pleading and the Schedule of Marks attached to each pleading so reflected. In its Notice of Opposition, Plaintiff additionally alleged ownership of Registration Nos. 1005036, 1005057 and 1007997, but these registrations did not appear on the Schedule of Marks and their corresponding TESS printouts were not made of record. The Petitions for Cancellation additionally included claims of ownership of Registration Nos. 4250892, 4250830 and 4325113. Corresponding TESS printouts of those registrations were made of record with the Notice of Opposition. While these TESS printouts only accompanied the Plaintiff’s pleading in the opposition, we consider them of record for all three consolidated cases pending in this proceeding, as they have been so treated by the parties.

<sup>8</sup> Issued September 22, 1987; second renewal. The registration claims 1968 as the date of first use of the mark anywhere and June 1976 as the date of first use of the mark in commerce. The filing date of the underlying application is August 25, 1986.

pursuant to Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), for “retail food store services” in International Class 42;<sup>9</sup>

**Registration No. 2002499** for the mark OMAHA STEAKS ANGUS (in typed form and with “Steaks” and “Angus” disclaimed) is registered on the Principal Register pursuant to Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), for “fresh and frozen boxed steaks, and fresh and frozen cuts of meat” in International Class 29;<sup>10</sup>

**Registration No. 3774260** for the mark OMAHA STEAKS (in standard characters and with “Steaks” disclaimed) is registered on the Principal Register pursuant to Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), as to the word OMAHA for, *inter alia* “frozen entrees consisting primarily of meat, fish, poultry, seafood or vegetables; frozen meals consisting primarily of meat, fish, poultry, seafood or vegetables; meat; poultry; pork; frankfurters; bratwurst; hamburgers; sausages; soups; seafood; crabs; shrimp; lobsters; salmon; veal; processed lamb; frozen appetizers consisting primarily of chicken or seafood; beef jerky; prepared nuts; [omelets;] meatballs; dips; frozen vegetables” in International Class 29;<sup>11</sup> and

**Registration No. 4172329** for the mark OMAHA FRESH ANGUS BY OMAHA STEAKS (in standard characters and with “Fresh Angus” and “Steaks” disclaimed) is registered on the Principal Register pursuant to Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), as to the word OMAHA for “fresh

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<sup>9</sup> Issued February 4, 1991; second renewal. The registration claims 1968 as the date of first use of the mark anywhere and June 1976 as the date of first use of the mark in commerce. The filing date of the underlying application is April 19, 1991.

<sup>10</sup> Issued September 24, 1996; second renewal. The registration claims September 6, 1995 as the date of first use of the mark and in commerce. The filing date of the underlying application is April 19, 1991.

<sup>11</sup> Issued April 13, 2010; renewed. The registration claims December 31, 1968 as the date of first use of the mark anywhere and June 30, 1976 as the date of first use of the mark in commerce. The filing date of the underlying application is October 15, 2010. The registration also includes additional goods in Class 30 and services in Class 35.

and frozen boxed steaks, and fresh and frozen cuts of meat” in International Class 29.<sup>12</sup>

Defendant denied the salient allegations in each of the three proceedings.<sup>13</sup>

In a decision issued September 30, 2017, the Board after trial and on the merits, dismissed Opposition No. 91213527 and sustained Cancellation Nos. 92059629 and 92059455.

Plaintiff appealed the Board’s dismissal of Opposition No. 91213527 to the U.S. Court of Appeals for the Federal Circuit. In a decision issued November 15, 2018, the Court of Appeals, having before it the full record that had been before the Board, vacated the Board’s decision that there is no likelihood of confusion between the parties’ marks, and remanded the case for further proceedings consistent with its opinion. *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686 (Fed. Cir. 2018). The Court directed, among other things, that the Board: 1) “conduct a proper analysis” under *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002) of the *DuPont* fame factor,<sup>14</sup> *id.* at 1692; 2) “reweigh the limited, relevant evidence of third-party use,” *id.* at 1695; and 3) conduct “further analysis” of the first *DuPont* factor, because the Board’s findings regarding third-party use have been vacated by the decision. *Id.* at 1696.

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<sup>12</sup> Issued July 10, 2012, Section 8 Affidavit accepted; Section 15 Affidavit acknowledged. The registration claims April 2, 2012 as the date of first use of the mark anywhere and in commerce. The filing date of the underlying application is October 15, 2010.

<sup>13</sup> In Cancellation No. 92059455, Greater Omaha asserted, and pursued, the affirmative defense of laches.

<sup>14</sup> The court is referring to the likelihood of confusion factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”).

## II. Preliminary Matters

### A. Motion to Supplement Record

Following remand, Plaintiff moved for leave to supplement the proceeding record. By its motion, Plaintiff seeks leave to admit into evidence the declaration of its Senior Vice-President and Chief Marketing Officer, Todd Simon and, pursuant to Fed. R. Evid. 201, requests the Board to take judicial notice of Exhibits 1-4 accompanying the Simon declaration. Plaintiff adds that the evidence it seeks to make of record “came into existence after entry of this Board’s September 30, 2017 Opinion and is being offered in support of *DuPont* factor five, strength/fame of the mark.” 67 TTABVue 2.

Greater Omaha has opposed the motion and request for judicial notice, arguing that the record in this case closed on May 16, 2016 and any evidence Plaintiff now seeks to file is not in compliance with Trademark Rule 2.123(k), 37 C.F.R. § 123(k), and that Plaintiff has not identified any fact subject to judicial notice.

Plaintiff’s request to introduce the Simon declaration and exhibits thereto is manifestly untimely. The record in this case closed several years ago and the case has already been through a complete trial and appeal. “Cases construing ‘newly discovered evidence’ uniformly hold that the new evidence must be of facts in existence at the time of the trial, but only discovered later, to entitle a party to relief.” *Pramil S.R.L. v. Farah*, 93 USPQ2d 1093, 1095 (TTAB 2009) (citing generally 11 C. Wright & A. Miller, Federal Practice and Procedure §2859 (2d ed. 1995); 12 J. Moore, Moore’s Federal Practice § 60.42[3] (3d ed. 2009) (internal citations omitted)). See also *See Packard Press Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 56 USPQ2d 1351,

1356 (Fed. Cir. 2000) (Court declined to consider whether to take judicial notice of fame where request for judicial notice was made for first time at oral argument on appeal). In this case, all of the evidence Plaintiff now seeks to add came into existence after a full trial at the Board. Accordingly, the request to supplement the record is denied.

We also deny Plaintiff's request that the Board take judicial notice of Exhibits 1-4 to the Simon declaration, which consists of examples where "Omaha Steaks has appeared or been featured in several mainstream media." As Defendant points out, such media references are not "facts" that are subject to judicial notice. "The only kind of fact that may be judicially noticed by the Board is a fact that is 'not subject to reasonable dispute in that it is either (1) generally known within the territorial jurisdiction of the trial court or (2) capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned.'" TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") Section 704.12 (2020), and the authorities cited therein, including Fed. R. Evid. 201(b).

In this case, the excerpts purportedly evidencing unsolicited media exposure are from TV game shows, newspaper crossword puzzles, movies, and magazine articles. Such excerpts are not facts that are generally known in the Board's jurisdiction or capable of determination by sources whose accuracy cannot be reasonably questioned and, thus, are not subject to judicial notice. *See, e.g., In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1286 (TTAB 2006) (Board denied request for judicial notice that Moulin Rouge is a famous Parisian nightclub and that its name served as title of a

film starring Nicole Kidman that was nominated for an Academy Award); *In re Viventia Biotech Inc.*, 80 USPQ2d 1376, 1377 (TTAB 2006) (Board did not take judicial notice of Internet search); *In re Red Bull GmbH*, USPQ2d 1375, 1379 n.7 (TTAB 2006) (Board would not take judicial notice of “scholarly reviews” of an essay).

Plaintiff is trying to supplement its trial record on disputed issues (i.e., the commercial strength or fame of its mark). Such an attempt is entirely inappropriate at this stage of the proceeding.

We accordingly give no further consideration to the October 11, 2019 declaration of Todd Simon and its accompanying exhibits.

## **B. Evidentiary Objections**

During the Board trial, Plaintiff and Defendant made multiple objections against testimony and evidence submitted by the other. We address only those objections affected by the decision of the Court of Appeals, i.e., objections Nos. 1 and 2, and otherwise reiterate our earlier rulings for the convenience of the parties.

### **1. Defendant’s Fifth Notice of Reliance**

Plaintiff objected to the portions of Defendant’s fifth notice of reliance that pertain to what it characterizes as “evidence of third-party uses of dissimilar marks on dissimilar goods,” arguing that they are irrelevant. This objection goes solely to relevance; the Board is quite capable of making such determinations and we consider the third-party use evidence for whatever probative value it may have. *See e.g., Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1373 (Fed. Cir. 2005) (“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.”). *See also Juice Generation, Inc. v. GS Enters. LLC*, 115 USPQ2d 1671 (Fed. Cir. 2015); *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 116 USPQ2d 1129 (Fed. Cir. 2015) (same). Plaintiff’s objection is therefore overruled.

## 2. Poret Testimony and Exhibits

Citing Trademark Rule 2.121(b)(1), which requires Plaintiff to present its case-in-chief during its testimony period, and Trademark Rule 2.121(c), which states that the rebuttal testimony period is only for rebuttal testimony, Defendant objects to the Poret testimony and exhibits in their entirety on the ground that it is improper rebuttal. The exhibits include both a survey and rebuttal survey commissioned by Plaintiff to establish acquired distinctiveness of the terms “Omaha Steaks” and “Omaha.” Plaintiff posits that it “rightfully elicited” the testimony of Hal Poret, to rebut the previous undisclosed testimony of Ms. Peetz, by whose testimony, Defendant attempted to controvert Plaintiff’s evidence that its OMAHA STEAK marks have acquired secondary meaning.

Rebuttal is improper, and should be excluded, if it constitutes evidence that should have been submitted during Plaintiff’s main testimony period to support Plaintiff’s case-in-chief. *Wet Seal Inc. v. FD Management, Inc.*, 82 USPQ2d 1629, 1632 (TTAB 2007); *Ritz Hotel Limited v. Ritz Closet Seat Corp.*, 17 USPQ2d 1466, 1468-9 (TTAB 1990).

After considering the testimony of Defendant's witnesses and Plaintiff's rebuttal witness, we are of the opinion that the Poret testimony and survey are not improper rebuttal. Plaintiff has alleged, in pertinent part, that:<sup>15</sup>

By virtue of the high degree of acquired distinctiveness of the Omaha Steaks Marks, 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 ..."

During its testimony period, Defendant introduced evidence of third-party use of trademarks and trade names that include the word "OMAHA," in an effort to demonstrate that the terms "OMAHA STEAKS" and "OMAHA" would not be attributable to a single source because of such third-party use. Mr. Poret testified that the purpose of his survey was to test whether the term "Omaha Steaks" and the term "Omaha" on their own have acquired secondary meaning associated with a single source. Such testimony and evidence would counter Defendant's evidence of any alleged weakness of those terms.

We therefore find the Poret testimony and exhibits are proper rebuttal. Accordingly, Defendant's objection is overruled.

We add, however, that the survey is entitled to little probative value because it is fundamentally flawed. Mr. Poret, Senior Vice President at ORC International, a

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<sup>15</sup> Notice of Opposition ¶ 22; 1 TTABVUE 8.

marketing research firm, testified that he was tasked with designing and conducting a survey to test whether the term “Omaha Steaks” and the term “Omaha” on their own have acquired secondary meaning. Mr. Poret designed an online survey that was performed sometime prior to May 2015, when the initial report issued<sup>16</sup> in which Respondents who purchased meat in the past 12 months, or were likely to purchase meat products in the next 12 months, were asked a series of standard questions to assess whether they associate the term “Omaha Steaks” in the one case or just “Omaha” in the other, with a single source.<sup>17</sup>

In order to qualify for the survey, Respondents had to answer that they purchased or were likely to purchase meat products through a gift or specialty food store or kiosk, through a gift or specialty foods website, by mail order, or through a television shopping network such as HSN or QVC.<sup>18</sup> This was done, Mr. Poret explained, so that each survey Respondent “was a purchaser through one of those channels which was designed to represent the channels through which Omaha Steaks specifically markets its products.”<sup>19</sup>

While maintaining its objections to the Poret testimony and exhibits, Defendant, in the event the Board allowed this evidence into the record, argued that:<sup>20</sup>

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<sup>16</sup> A supplemental report issued in August 2015, in response to a rebuttal report of Robert Klein (not of record).

<sup>17</sup> 44 TTABVUE 8-9.

<sup>18</sup> Participants who responded that they purchased their meat through an online grocery store, a big chain or local grocery store or a supermarket or smaller market were excluded. Id. at 123-125.

<sup>19</sup> 44 TTABVUE 10.

<sup>20</sup> 49 TTABVUE 66-67.

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.

We agree. Secondary meaning does not have to be proven among the general public, if a product is targeted at a specific segment of the population.<sup>21</sup> Here, Plaintiff's goods generally are identified as meat and beef, as are Defendant's. As discussed, *infra*, because there are no restrictions in the identifications of goods as to classes of customers, the relevant public would comprise ordinary consumers who eat meat and beef, not just Plaintiff's current customer base as Plaintiff would have us believe. To exclude a large segment of meat eaters because they purchase their meats from grocery stores and markets, and not specialty kiosks and websites, fatally narrows the survey universe and skews the results in favor of Plaintiff. Accordingly, the Poret survey has no probative value.<sup>22</sup>

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<sup>21</sup> 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 15:46 (5<sup>th</sup> ed. 2020) (“While the ‘focus’ of secondary meaning is ‘the consuming public,’ it need not be proven among the *general* public if a product is targeted at only a specific segment of the general public.”) (Emphasis supplied).

<sup>22</sup> This finding was confirmed on appeal. *See Omaha Steaks v. Greater Omaha*, 128 USPQ2d at 1692. In making this finding, we point out, as did the Federal Circuit, that Plaintiff's reliance on *Brunswick Corp. v. Spinit Reel Co.*, 832 F.2d 513, 523 n.6 (10th Cir. 1987) is distinguishable. There, the inclusive survey covered “persons over 14 years who have fished in fresh water in the last twelve months.” *Id.* The Tenth Circuit concluded the trial court did not abuse its discretion by admitting the survey, especially since there was “no evidence to show that such a universe would not be a fair sample of those who are likely to purchase spincast reels.” *Id.* Unlike in *Brunswick*, in this case “the undisputed facts confirm the Poret

3. Todd Simon Testimony and Exhibits 1-9

Defendant has objected to portions of the testimony of Todd Simon and Exhibits 1-9.<sup>23</sup> Exhibits 1-7 and 9 to Mr. Simon's testimony were not placed in the record. Accordingly, Defendant's objections to these exhibits are moot.<sup>24</sup> Defendant further objects as speculation, lack of personal knowledge and competence and hearsay the part of Mr. Simon's testimony concerning the non-proffered exhibits, which relate to the following topics:

Sales and advertising figures on the basis of lack of personal knowledge, hearsay and speculation;

Trade show attendance on the basis of lack of personal knowledge, hearsay, speculation and opinion;

Digital marketing on the basis of hearsay, speculation and opinion;

Various reports from Finn Partners, Plaintiff's New York public relations agency, about public relations efforts for the holiday season, Father's day and the 2014 PR Annual Report as inadmissible hearsay and because it lacks foundation and personal knowledge;

Plaintiff's advertising strategies as inadmissible hearsay, and lack of foundation and personal knowledge; and

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survey did not come close to providing a reliable sample of consumers likely to purchase meat." *Omaha Steaks v. Greater Omaha*, 128 USPQ at 1696 n.1.

<sup>23</sup> The Exhibits were described in the Exhibit Index as follows: Exhibit 1 – Schedule of Marks; Exhibit 2 – Opposer's [Plaintiff's] Answers to Applicant's First Set of Interrogatories; Exhibit 3 – Trade Show Information; Exhibit 4 – Holiday Season: 2014/2015 Summary Report by Finn Partners; Exhibit 5 – Father's Day: 2014/2015 Summary Report by Finn Partners; Exhibit 6 – Finn Partners 2014 PR Report for Omaha Steaks; Exhibit 7 – Omaha Steak Company Information; Exhibit 8 News Item Report; and Exhibit 9 – Photograph.

<sup>24</sup> We note that the schedule of marks (Exhibit 1), is already of record as it is a duplicate of Exhibit A to Plaintiff's petitions in these consolidated proceedings.

Circumstances surrounding a photograph of a plaque presented to Plaintiff.

None of the testimony Defendant seeks to exclude is outcome determinative. The Board is capable of weighing the relevance and strength or weakness of the objected-to testimony, including any inherent limitations, and this precludes the need to strike it. Given these facts, coupled with the number of objections, we see no compelling reason to discuss the specific objections. As necessary and appropriate, we will point out any limitations applied to the testimony or otherwise note that it cannot be relied upon in the manner sought. Accordingly, the objections are overruled.

4. Todd Simon Testimony and Exhibit 8

Defendant has also objected to Exhibit 8, an excerpted report regarding a comprehensive media listing of all news items that contain references to “Omaha Steaks,” and the associated testimony (much of which Defendant alleges consisted of Mr. Simon’s reading from the exhibit). Defendant argues that the exhibit is not a business record, lacks foundation and was not properly authenticated and that the witness had no personal knowledge of who compiled it or the methodology, as is required under Fed. R. Evid. 602. Plaintiff counters Defendant’s argument, asserting that Mr. Simon’s testimony was competent and based upon personal knowledge. Although Mr. Simon did not know offhand who created the document, the “front page” revealed that it was compiled by Omaha Creative Group, Plaintiff’s in-house advertising agency responsible for the marketing for all of Omaha Steaks’ affiliated companies, tasked with creating the document. Mr. Simon testified that he was familiar with the Omaha Creative Group and had personal information about the

steps they took to compile the report, i.e., by subscribing to a clipping service, and that the reports were compiled on an as needed basis. T. Simon test., pp. 80-85.<sup>25</sup> We find that Mr. Simon, in his position as Plaintiff's senior vice president of sales and marketing, had sufficient knowledge and competence to introduce into the record the report compiled by Plaintiff's in-house advertising agency in the regular course of business. Because Defendant has not specified what elements are lacking, we cannot ascertain whether Plaintiff's summary meets all the requirements of Fed. R. Evid. 1006. Accordingly, Defendant's objections are overruled. Nevertheless, in keeping with the discussion above, we will accord the testimony and evidence the appropriate probative weight.

5. Bruce Simon Testimony and Exhibits 2, 9 and 10 and Plaintiff's History

At the outset, we note that Exhibits 2 and 9 to B. Simon's testimony are the same exhibits Plaintiff sought to introduce in connection with the T. Simon testimony. As indicated, Plaintiff did not submit these exhibits into the record. As regards to the testimony concerning these exhibits, Defendant again seeks to exclude it on the basis of lack of foundation, lack of personal knowledge, lack of competence, opinion and speculation. Citing Fed. R. Evid. 602, 701 and 802, Defendant objects to the introduction of various cease and desists letters, as well as the testimony pertaining to them, again on the grounds that no foundation has been laid, lack of personal knowledge and lack of competence, opinion and speculation. Defendant similarly

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<sup>25</sup> 33 TTABVUE 209-214.

objects to B. Simon's testimony regarding company history on those grounds, as well as on the ground that it is hearsay. Again, because none of the testimony is outcome determinative, and because the objections go to probative value as opposed to admissibility, we accord the testimony the appropriate weight.

#### 6. Peetz Testimony

Defendant, during its testimony period, took the testimony deposition of Terri Peetz, identified as a paralegal with the law firm of Suiter Swantz PC. Ms. Peetz' testimony addresses the results from her investigation to find companies in food or food-related industries which are located in or near Omaha, Nebraska, the names of which begin with or prominently feature the word "Omaha." Plaintiff objects to Ms. Peetz' testimony as constituting improper *ex parte* discovery from a non-party witnesses, hearsay, and violation of the witness-advocate rule.<sup>26</sup> With regard to Plaintiff's objection on the ground of improper *ex parte* discovery, Ms. Peetz provided testimony, not discovery, and her testimony was subject to cross-examination. We also find that Ms. Peetz testimony does not constitute hearsay because it does not include out-of-court statements made by other persons. Last, Ms. Peetz is not in violation of the witness-advocate rule because she is neither a lawyer nor an advocate for Defendant in these consolidated proceedings. Accordingly, Plaintiff's objection to the Peetz testimony is overruled.

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<sup>26</sup> To the extent that Plaintiff objected to the Peetz testimony, taken March 18, 2016, based on Defendant's failure to identify her in initial disclosures, the objection is moot. By stipulation filed March 24, 2016, "[b]oth parties stipulated that neither party will make any objection of any kind to the other party's witnesses who have testified thus far in the proceeding based on any lack of identifying them in initial disclosures, and that all such objections made thus far are hereby irrevocably withdrawn." 36 TTABVUE 2.

We have considered all of Plaintiff's and Defendant's evidence. In doing so, we have kept in mind the various objections raised by the parties, and we have accorded whatever probative value the subject testimony and exhibits merit.<sup>27</sup>

### **C. Plaintiff's Request for Judicial Notice**

In view of the findings of the Court of Appeals, we address Plaintiff's requests that we take judicial notice of previously-filed lawsuits. Citing Fed. R. Evid. 201(c) and Trademark Rule 2.122, Plaintiff, in its brief, indicates that "Omaha Steaks has filed numerous lawsuits against perceived infringers, of which this Court must take judicial notice... ." <sup>28</sup> Of the sixteen lawsuits referenced by Plaintiff, in all but one instance, Plaintiff merely listed the case, by caption and docket number. For the litigation styled *Omaha Steaks International, Inc. v. Interbay Food Company, LLC*, 8:14 – cv-15 (D. Neb), Plaintiff included the parenthetical: "(suing for trademark infringement for, inter alia, Defendant's advertising of its product on its own website and at Amazon Fresh as 'Omaha Natural Angus' and 'Greater Omaha')." No other material is included with the request.

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<sup>27</sup> As to the hearsay objections, we note that the Board does not generally strike properly taken and filed testimony or exhibits based on substantive objections such as hearsay. Rather, such objections are taken into consideration in determining the probative value of the evidence. See *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1326 (TTAB 1992).

<sup>28</sup> The lawsuits include, by way of example: *Omaha Steaks International, Inc. v. Pathak*, 03-cv-01401 (C.D. Cal); *Omaha Steaks International, Inc. v. Midwest Best Choice Distributors, LLC*, 13-4095 (N.D. Iowa); *Omaha Steaks International, Inc. v. Fairbury Steaks, Inc.*, 07-cv-02578 (C.D. Cal.); *Omaha Steaks International, Inc. v. Turner New Zealand, Inc.*, 05-cv-00605 (S.D. Cal.); and *Omaha Steaks International, Inc. v. Simpson*, 99-cv-00712 (S.D. W. VA).

As noted, under Fed. R. Evid. 201(b)(2), a tribunal “may judicially notice a fact that is not subject to reasonable dispute because it . . . can be accurately and readily determined from sources whose accuracy cannot reasonably be questioned.” A tribunal “must take judicial notice if a party requests it” and “the court is supplied with the necessary information.” Fed. R. Evid. 201(c)(2). Here, while Plaintiff identified the lawsuits by case name and docket number, it failed to supply the Board with any material, *e.g.*, the pleadings, to substantiate its claim. That said, to the extent Plaintiff is asking us to take judicial notice of the fact that Plaintiff filed sixteen lawsuits, as styled in its brief, against various entities, we do so. *See Omaha Steaks v. Greater Omaha*, 128 USPQ2d at 1693 (quoting *United States v. Jones*, 29 F.3d 1549, 1553 (11<sup>th</sup> Cir. 1994) (“The Court may take judicial notice of a document filed in another court not for the truth of the matters asserted in the other litigation, but rather to establish the fact of such litigation and related filings.” (internal citations omitted))).

However, the mere fact that these lawsuits were filed has no probative value in our decision concerning the *DuPont* fame factor or any other issue. That is, the party requesting judicial notice cannot simply contend that certain statements or, as in this case, filings were made containing material that has not been provided and expect the Board to consider the assertion established. Moreover, “[t]he Board is not required to scour, not just the dockets, but the multiple pleadings referenced in those dockets to determine the substance of the litigations referenced.” *Id.* at 1694.

Under these circumstances, we vacate our original ruling, and Plaintiff's request for judicial notice is granted but only to the extent indicated above.

### **III. The Record**

The record is the same as the one before the Board in the original trial, and is repeated below:

By operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the record includes the pleadings and the files of the involved application and registrations. In addition, the parties introduced the following properly adduced evidence.

#### **A. Plaintiff's testimony and evidence:**

1. Testimony deposition, with exhibits, of Bruce Simon, Plaintiff's president and CEO ("B. Simon test."). 33 TTABVUE.

2. Testimony deposition, with exhibits, of Todd Simon, Plaintiff's senior vice president of sales and marketing ("T. Simon test."). 33 and 34 TTABVUE.

3. Testimony deposition, with exhibits, of Plaintiff's expert witness, Hal Poret, Senior Vice President of ORC International, a marketing firm ("Poret test."). 44 TTABVUE.

#### **B. Defendant's testimony and evidence**

1. Defendant's First Notice of Reliance on a listing of, and corresponding copies taken from the United States Patent and Trademark Office's (USPTO) Trademark Electronic Search System (TESS) database of 118 applications and registrations (both live and dead) for marks that include the word "OMAHA," and in which that term is disclaimed (29 TTABVUE).

2. Defendant's Second Notice of Reliance on the following (27 TTABVUE):

- a. Certificates issued by the state of Nebraska certifying that Defendant filed Articles of Incorporation on July 2, 1956, and is in existence as of February 10, 2016, and that the Articles and all amendments thereto are attached as of February 10, 2017; and
- b. Certified copies of Defendant's trademark registrations, Nos. 4690144 and 4721723.

3. Defendant's Third Notice of Reliance on Plaintiff's November 12, 2014, July 17, 2015, and June 25, 2015 responses to Defendant's requests for admissions (deemed admitted by Board order issued September 28, 2016) (20 TTABVUE).

4. Defendant's Fourth Notice of Reliance on the following printed publications and Internet web pages to show that (1) Defendant was located at 5102 South 26<sup>th</sup> Street in Omaha, Nebraska from 1927 until 1972; (2) was using the company name Greater Omaha Packing Co. during that period; and that Herman Cohen and Pennie Davis were listed as managers or principals of Defendant during that period (30 TTABVUE):

- Polk City Directories Website printout dated April 4, 2015;
- Polk Omaha City Directories dated 1928, 1929, 1931 - 1934, 1936, 1938, 1940, 1942, 1945, 1946, 1949, 1951, 1954 and 1955;
- Omaha World Herald Wikipedia Entry (printout dated February 19, 2016); and
- Omaha World Herald Historical Archive excerpts dated January 11, 1927, September 24, 1944, October 14, 1945, July 28, 1947, July 20, 1951, September 29, 1952, February 12, 1953, May 31, 1953, July 19, 1953, December 25, 1955, January 30, 1958, May 17, 1960, June 18, 1960 and October 24, 1972.

5. Defendant's Fifth Notice of Reliance on the following printed publications and Internet materials (31 TTABVUE):

- the obituaries of Herman Cohen and Pennie Z. Davis published in the Omaha World Herald newspaper;
- newspaper and Internet articles discussing Omaha as a place beef comes from and that various companies selling beef and beef related goods use Omaha in their company names;
- a website printout from a seller of Defendant's beef under the Greater Omaha mark; and
- articles discussing the history of Defendant and its use of the Greater Omaha trademark.

6. Testimony deposition, with exhibits, of Carol Mesenbrink, Defendant's credit manager since 2003 and, from 1999 to 2003, an invoicing, accounts receivable, and inventory control specialist for Defendant ("Mesenbrink test.") (38 TTABVUE).

7. Testimony deposition, with exhibits, of Angelo Fili, Defendant's executive vice-president responsible for development of a beef fabrication division, and formerly employed by various meat packing facilities as, e.g., a journeyman butcher, a utility man, a meat cutter, plant manager, and field representative ("Fili test.") (39 TTABVUE).

8. Testimony deposition, with exhibits, of Terri Peetz, a paralegal employed by the law firm of Suiter Swantz ("Peetz test.") (40 and 41 TTABVUE).

9. Testimony deposition, with exhibits, of Henry Davis, grandson of Defendant's founder and current president and, previously employed by Defendant on a part-time basis between 1965 through 1972 to, among other things, shroud beef,

take out the shroud pins, and stamp the beef with the name “Greater Omaha” (Davis test.) (42 TTABVUE).

#### **IV. The Parties**

##### **A. Plaintiff**

According to the testimony of Bruce Allen Simon, a descendant of Plaintiff’s founders, Plaintiff began as Table Supply Meat Company in 1917. (B. Simon test. p. 9, T. Simon test. p. 4).<sup>29</sup> About 1959, Plaintiff started doing business as Omaha Steaks. (B. Simon test. p. 10).<sup>30</sup> Plaintiff employs about 1,800 hundred people year round, and during the peak December holidays, Plaintiff employs around 4,300 employees and processes 100,000 orders a day. (B. Simon test. p. 7).<sup>31</sup> Plaintiff acquires subprimals from which it makes its products from a variety of suppliers including Tyson, Cargill, Swift, JBS, National Beef, Greater Omaha Beef and Defendant Greater Omaha Packing. (*Id.* at 38).<sup>32</sup> Plaintiff acquires “much less” than ten percent (10%) of its product from Defendant. (*Id.* at 40).<sup>33</sup>

Plaintiff “rigorously” polices its trademarks by routinely searching the Internet for infringing uses, digitally marking photographic images, issuing cease and desist letters and by pursuing legal action. (*Id.* at 13 and 29-32; Exhs. 10 - 25).<sup>34</sup>

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<sup>29</sup> 33 TTABVUE 11, 133.

<sup>30</sup> *Id.* at 12.

<sup>31</sup> *Id.* at 9.

<sup>32</sup> *Id.* at 40.

<sup>33</sup> *Id.* at 42.

<sup>34</sup> *Id.* at 15 and 31-34, Exhs. 10-25.

## B. Defendant

In 1920, Defendant's predecessor was formed as an unincorporated company in Omaha, Nebraska by Herman Cohen using the business name "Greater Omaha Packing Company." (Davis test. 17-18).<sup>35</sup> In 1956, Herman Cohen and Pennie Davis, the owners of Greater Omaha Packing Company, formed a Nebraska Corporation called "Greater Omaha Packing Co., Inc., at the same location. (Defendant's Second NOR, NR 1).<sup>36</sup> Defendant and its predecessor have continuously used "Greater Omaha Packing Company" in the beef business in Omaha, Nebraska from 1920 to present. Defendant has continuously used the GREATER OMAHA (with steer head

design) trademark (  ) on boxed beef from 1992 to the present, and

the GREATER OMAHA (with steer head design) mark (  ) from at least as early as February, 2014 to the present. (Fili test. at p. 33, exh. 10; *Id.* at 67, exh. 24).<sup>37</sup> Prior to 1992, Defendant sold hanging beef, i.e., beef carcasses; beef carcasses are no longer available. (Fili test. pp 16, 83). The boxed beef, which is beef fabricated from whole carcasses, is sold to hotels, restaurants, food service institutions and other wholesalers. (Fili test. p. 20). Defendant has a 10,000 pound minimum purchase requirement for its beef products. (Fili test. pp. 72-73). Defendant has continuously sold beef to Plaintiff from 1966 to the present, (Defendant's Third

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<sup>35</sup> 42 TTABVUE 18-19.

<sup>36</sup> 27 TTABVUE 1-34. NR is an internal designation used by Defendant.

<sup>37</sup> 39 TTABVUE 34, 68-70, 115-120, 159.

NOR, NR-5, Request No. 8 - Admitted).<sup>38</sup> From 1992 to 2015, Defendant sold and shipped beef in containers bearing the GREATER OMAHA (with steer head design) mark, resulting in annual revenues increasing from in excess of \$100,000,000 (in 1992) to in excess of \$1,700,000,000 (in 2015). (Davis test. pp. 64-65).<sup>39</sup> From 1992-2015, Defendant required its customers to make minimum purchases of 10,000 pounds, which means that minimum purchases were not less than \$10,000.<sup>40</sup>

Defendant's witnesses, Henry Davis and Angelo Fili both testified that they had never observed or heard of any instances of actual confusion as to the source of their product. (Davis test. p. 69-70; Fili test. p. 79).<sup>41</sup>

#### **V. Entitlement to Bring a Statutory Cause of Action<sup>42</sup> and Priority**

To establish entitlement to bring a statutory cause of action under Section 13 of the Trademark Act, a plaintiff must demonstrate a real interest in the proceeding and a reasonable belief of damage. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 at \*3 (Fed. Cir. 2020); see also *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058

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<sup>38</sup> 28 TTABVUE 4.

<sup>39</sup> 42 TTABVUE 65-66.

<sup>40</sup> 39 TTABVUE 73-74.

<sup>41</sup> 42 TTABVUE 70; 39 TTABVUE 80.

<sup>42</sup> Our decisions have previously analyzed the requirements of Section 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063-64, under the rubric of "standing." Mindful of the Supreme Court's direction in *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26 (2014), we now refer to this inquiry as entitlement to bring a statutory cause of action. Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 remain equally applicable.

(Fed. Cir. 2014); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727 (Fed. Cir. 2012); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). Here, Plaintiff's entitlement to oppose registration is demonstrated through printouts from the Trademark Electronic Search System ("TESS") database of the United States Patent and Trademark Office ("USPTO"), made of record with the pleadings in the notice of opposition, showing that it is the owner of its pleaded registrations and that those registrations are valid and subsisting. *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *N.Y. Yankees P'ship v. IET Prods. & Servs., Inc.*, 114 USPQ2d 1497, 1501 (TTAB 2015). Because Plaintiff's pleaded registrations are properly of record, priority is not in issue in the opposition with respect to those marks for the goods and services listed therein. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

As did the parties, we focus our analysis of the issue of likelihood of confusion between Defendant's mark and Plaintiff's mark in Registration No. 3774260, OMAHA STEAKS (in standard characters and with "Steaks" disclaimed) for, in pertinent part, "meat" in International Class 29, as this mark is the closest to Defendant's involved mark and is most likely to support a finding of likelihood of confusion. *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1073 n.14 (TTAB 2011) (limiting analysis to those registrations most likely to support a finding of likelihood of confusion); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010) (same).

## VI. Discussion

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019) (Board considers each *DuPont* factor for which there is evidence and argument). When analyzing these factors, the overriding concern is not only to prevent buyer confusion as to the source of the goods and services, but also to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993).

### A. The Goods/Channels of Trade/Classes of Purchasers

We first consider the relatedness of the goods. In making our determination regarding the relatedness of the goods, we must look to the goods as identified in the application and the pleaded registrations. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys., Inc. v. Hous. Computers Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)); *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011).

Where the goods in an application or pleaded registration are broadly identified, such that there are no restrictions as to trade channels and purchasers, it is presumed

that the recitation of goods encompasses not only all goods of the nature and type described therein, but that the identified goods are provided in all channels of trade which would be normal therefor, and that they would be purchased by all potential customers thereof. *See, e.g., See In re Solid State Design Inc.*, 125 USPQ2d 1409, 1412-15 (TTAB 2018) (where the goods in an application or registration are broadly described, they are deemed to encompass all the goods of the nature and type described therein); *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015) (same); *In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”).

As identified, Plaintiff’s broadly worded “meat” encompasses Defendant’s more narrowly identified “meat, including boxed beef primal cuts.” Thus, for purposes of our likelihood of confusion analysis, we find the respective goods legally identical.

Moreover, given the legal identity of goods, we must presume that they would be offered in the same trade channels for such goods, and to the same classes of purchasers, including ordinary consumers seeking meat products. *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968); *Am. Lebanese Syrian Associated Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011). *See also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (the Board was entitled to rely on this legal presumption in determining likelihood of confusion).

In view of the above, the *DuPont* factors of the similarity of the goods, the channels of trade and classes of purchasers favor Plaintiff.

### **B. The Conditions Under Which and Buyers to Whom Sales are Made**

We next consider the conditions under which, and buyers to whom, the parties' respective goods are sold. Defendant contends that both parties' goods are relatively expensive and would be purchased with care by sophisticated customers. Because the respective identifications include "meat," without any limitations to a particular price point, we must treat the goods as including both inexpensive and expensive meat products, and accordingly presume that purchasers for "meat" include ordinary consumers who may purchase meat on impulse. *See Stone Lion v. Lion Capital*, 110 USPQ2d at 1163 (affirming that the Board properly considered all potential purchasers for recited services, including both sophisticated and unsophisticated investors, since precedent requires consumer care for likelihood of confusion decisions be based "on the least sophisticated potential purchasers").

We thus find this *DuPont* factor neutral.

### **C. Strength of the Pleaded Mark**

We next examine the strength of Plaintiff's pleaded mark to determine the scope of protection to be accorded. The strength of a mark rests on the extent to which "a significant portion of the relevant consuming public . . . recognizes the mark as a source indicator." *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (citing *Palm Bay Imps. v. Veuve Clicquot* 73 USPQ2d at 1694). In determining the strength of a mark, we consider

both inherent strength, based on the nature of the mark itself, and commercial strength or recognition. *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1476 (TTAB 2014); *see also In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”). The fifth *DuPont* factor, the “fame” of the prior mark, and the sixth *DuPont* factor, the number and nature of similar marks in use for similar goods, *DuPont*, 177 USPQ at 567, may be considered in tandem to determine the strength of Plaintiff’s mark and the scope of protection to which it is entitled. *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017).

1. Commercial Strength of Plaintiff’s OMAHA STEAK Mark

This *DuPont* factor requires us to consider the commercial strength of Plaintiff’s mark. Fame, an extreme form of commercial strength, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. The fame of a mark is not a binary factor in the context of a likelihood of confusion analysis. *Joseph Phelps v. Fairmont Holdings*, 122 USPQ2d at 1734. Rather, likelihood of confusion fame “varies along a spectrum from very strong to very weak.” *See Palm Bay v. Veuve Clicquot* 73 USPQ2d at 1694 (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059 (Fed. Cir. 2003)). Fame for likelihood of confusion purposes arises as long as a “significant portion of the relevant consuming public ... recognizes the mark as a source indicator.” *Id.* However, fame is insufficient, standing alone, to establish likelihood of confusion. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372 ,

217 USPQ 505, 507 (Fed. Cir. 1983) (“Likely ... to cause confusion means more than the likelihood that the public will recall a famous mark on seeing the same mark used by another.”).

Fame may be measured indirectly by the volume of sales and advertising expenditures of the goods and services identified by the marks at issue, “the length of time those indicia of commercial awareness have been evident,” widespread critical assessments, and through notice by independent sources of the products identified by the marks, as well as the general reputation of the products and services. *Bose Corp. v. QSC Audio Prods.*, 63 USPQ2d at 1305-1306 and 1309 (recognizing indirect evidence as appropriate proof of commercial strength).

Plaintiff’s claim that its pleaded OMAHA STEAKS marks are famous is based primarily on testimony of Todd Simon, Plaintiff’s Senior Vice President of Sales and Marketing. According to Mr. Simon, Plaintiff spent over \$45 million in 2011, and over \$50 million in 2012 and in 2013, on domestic advertising of its beef products. (T. Simon test. pp. 16-19).<sup>43</sup> While these numbers may be substantial, Plaintiff did not supply specific sales figures or testify as to market share. “Raw numbers of product sales and advertising expenses may have sufficed in the past to prove fame of a mark, but raw numbers alone in today’s world may be misleading. ... Consequently, some context in which to place raw statistics is reasonable.” *Bose Corp. v. QSC Audio Products*, 63 USPQ2d at 1309. In our earlier decision, and in reliance on *Bose*, we found it significant that there was no “contextual” evidence about Plaintiff’s sales figures and

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<sup>43</sup> 33 TTABVUE; TSDR 145-148.

advertising expenditures, and insufficient information regarding the public exposure to the OMAHA STEAKS marks. The Court of Appeals, in vacating and remanding the Board's decision, found that our earlier decision "took an overly restrictive view of evidence related to Omaha Steaks' sales figures, advertising expenditures, and related evidence of the relevant public's exposure to its branded meat products bearing on the relative fame of the mark." *Omaha Steaks v. Greater Omaha Packing*, 128 USPQ2d at 1692. As the Court of Appeals further observed, "[t]hough *Bose* expressly approves of using market share, it does not require it." *Id.* at 1690. Other contextual evidence may suffice, *id.* at 1690, such as detailing Plaintiff's advertising, promotion, marketing, and market recognition of goods bearing its mark.

We accordingly revisit the evidence of record regarding fame. In addition to the findings of fact set forth in the background section of this decision, and the advertising expenditures noted above, we point out that it is undisputed that every one of Plaintiff's pleaded OMAHA STEAKS marks include the phrase "OMAHA STEAKS."<sup>44</sup> In addition, Mr. Simon testified that Plaintiff advertises via catalog and direct mail, a daily blast e-mail, customer calls, and on social media platforms, including Twitter, Instagram, Pinterest and Facebook, where Plaintiff has over 300,000 followers. Plaintiff's direct mail advertising program operates on a rotating basis with about 2 million customers that are solicited throughout the year. (*Id.* at 18-26, 79-80).<sup>45</sup> Plaintiff also advertises by national radio and television campaigns,

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<sup>44</sup> 1 TTABVUE.

<sup>45</sup> 33 TTABVUE; TSDR 147-155, 208-209.

free standing print campaigns, and has been mentioned in national magazines, including *Time*, *Newsweek*, *Playboy* and *PC Magazine*,<sup>46</sup> and newspapers, including *USA Today*, the *Wall Street Journal*, the *New York Times* and the *LA Times*. Todd Simon has personally promoted Plaintiff's goods and services under the Omaha Steaks mark on the following television shows: "Fox & Friends," "Hell's Kitchen," "Celebrity Apprentice" and "The View." (*Id.* at 28).<sup>47</sup> Plaintiff's products have been featured on "The Oprah Winfrey Show," "The Ellen DeGeneres Show," "Food Factory," "Unwrapped," and "Military Makeover." (*Id.* at 29-30, 33).<sup>48</sup>

Omaha Steaks also has been mentioned in the films *Dodgeball* and *Flipper*, and in television shows, including "The West Wing," "Seinfeld," "The George Lopez Show" and "Dennis Miller Live." (*Id.* at 53-56).<sup>49</sup>

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<sup>46</sup> *Id.* at 79-80. The sampling of media listings, (B. Simon test. exh. 8) 34 TTABVUE, has less probative value because there is no information whatsoever regarding the specific nature of the media reference. The listing only provides the name of the publication, radio broadcast or television station, including streaming services, and a title for the referenced "hit."

<sup>47</sup> *Id.* at 157.

<sup>48</sup> *Id.* at 158-159, 162.

<sup>49</sup> *Id.* at 182-185. Plaintiff also attempts to introduce additional Wikipedia evidence purportedly demonstrating that "Omaha Steaks" has been featured on other television programs, and included a hyperlink to the Wikipedia website. First, we have made clear that providing hyperlinks to Internet materials is insufficient to make such materials of record. *See In re HSB Solomon Assocs., LLC*, 102 USPQ2d 1269, 1274 (TTAB 2012) (stating that "a reference to a website's internet address is not sufficient to make the content of that website or any pages from that website of record"); *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010) (noting that because of the transitory nature of Internet postings, websites referenced only by links may later be modified or deleted). Second, the Board is hesitant to take judicial notice of evidence from Wikipedia, as its source material is continuously subject to change by collaborative user-input. *See In re Jimmy Moore LLC*, 119 USPQ1d 1764, 1768 (TTAB 2016).

Plaintiff has attended multiple trade shows, including PPSI in Las Vegas, the Realtors Conference in San Diego (*Id.* at 39-41),<sup>50</sup> and has had a presence at a number of festivals, food fairs and tastings, such as the New York Wine & Food Festival and the South Beach Festival. (*Id.* at 42).<sup>51</sup> Omaha Steaks' goods and services are promoted under the Omaha Steaks mark through concessions, and some signage, at venues in Omaha, e.g., the CenturyLink Center arena, TD Ameritrade Park, Ralston arena, Storm Chasers Stadium and the Omaha Henry Doorly Zoo. (*Id.* at 43-46).<sup>52</sup>

Plaintiff has 75 stores in 25 states, including Omaha, New York, Illinois, Florida, Georgia, Ohio, Kentucky, Missouri, Nebraska, California, Colorado, Nevada, Arizona, Texas, Pennsylvania and New Jersey, as well as two kiosks at the Omaha airport. (*Id.* at 18 and 47-48).<sup>53</sup> The kiosks have appeared in nationally-released films "Up in the Air" and "About Schmidt." (*Id.* at 53).<sup>54</sup> Plaintiff also sells its products online on Amazon. (*Id.* at 32).<sup>55</sup>

Having evaluated the evidence of fame in its totality, we find that Plaintiff's OMAHA STEAKS mark, as a whole, has achieved, overall, a significant level of fame. While there are no particulars regarding the advertising expenditures or any specific sales figures, we can glean from the advertising figures provided, which are not

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<sup>50</sup> *Id.* at 168-170.

<sup>51</sup> *Id.* at 171.

<sup>52</sup> *Id.* at 172 - 175.

<sup>53</sup> *Id.* at 147, 176-177.

<sup>54</sup> *Id.* at 182.

<sup>55</sup> *Id.* at 161.

insignificant, and the specifics regarding Plaintiff's marketing and promotional activities coupled with the considerable amount of unsolicited media attention, that Plaintiff's OMAHA STEAKS mark has garnered considerable consumer recognition, which correlates with substantial sales. Moreover, further context demonstrating consumer recognition is found in Plaintiff's long period of use of the OMAHA STEAKS mark, its 75 geographically diverse stores, and its varied and extensive modes of advertising.

Defendant argues 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.'" Defendant's br. p. 21.<sup>56</sup> Defendant takes the position that rather than being "famous" or "strong," Plaintiff's OMAHA STEAKS marks are extremely weak because there are many companies, some of which are in the beef or food business, currently located in Omaha, Nebraska that are using trademarks or trade names in which the first word is "Omaha."<sup>57</sup> *Id.* at 23-24. Pointing to *Jack Wolfskin v. New Millennium Sports*, 116 USPQ2d at 1136, Defendant maintains that when there are numerous similar marks in use by third-party sources in related fields, such evidence may establish a common term to be a weak source indicator that is only entitled to a narrow scope of protection. To support this position, Defendant submitted evidence of third-party uses of marks and company names containing the word OMAHA purportedly in

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<sup>56</sup> 49 TTABVUE 22.

<sup>57</sup> *Id.* at 24-25.

connection with beef and food products and services. Defendant posits that the “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 confusion as to source.” Defendant’s br. p. 25.<sup>58</sup> Through the Peetz testimony and exhibits, Defendant made of record evidence of the following third-party uses of OMAHA-formative marks to identify businesses in the vicinity of Omaha, Nebraska:<sup>59</sup>

- Omaha Tower Café for a café located in a large office building in Omaha;
- Omaha Oriental Food & Gifts for a specialty store selling oriental foods, grocery goods, and gifts;
- Omaha Popcorn for a store located in a strip mall selling various flavors of popcorn, drinks and popcorn containers;
- Omaha Tap House for a casual restaurant located in downtown Omaha;
- Omaha Wine Company, a specialty store selling various wines, alcoholic beverages;
- “OmahaFastFoods.com,” a “grocery delivery service for the Omaha metro area;
- “Omaha Prime,” an “elegant steakhouse” in Omaha;
- “Omaha Picnic Pros,” a “catering service specializing in barbecuing and grilling located in southern Omaha; and
- Omaha Culinary Tours for a bus tour featuring some of Omaha’s most well-known steakhouses.

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<sup>58</sup> 49 TTABVUE 26.

<sup>59</sup> 40 TTABVUE, 41 TTABVUE.

Defendant also made of record through the testimony, and exhibits, of Carol Mesenbrink, Defendant's credit manager, evidence that Defendant sold beef to companies named Omaha Beef Company, Inc.<sup>60</sup> and Omaha Meat Processors, Inc. of Ohio, Nebraska.<sup>61</sup>

Defendant also introduced printouts from various websites showing third-party use of OMAHA in company names for businesses that sell meat and other food products.<sup>62</sup> The printouts show that B.I.G. Meats Omaha, Omaha Meat Processors, Inc., and Omaha Beef Company sell raw meat in bulk, including beef. The printouts also show restaurant use of OMAHA in connection with beef products. For example, the website for Husker BBQ states that it uses only the "finest meats" which includes "Omaha Beef," and a review of Cascio's Steak House is titled "This place is why its calle [sic] Omaha Beef."

Plaintiff challenges the evidence, arguing that none of the businesses identified in the Peetz testimony "provid[ed] individual, uncooked beef products or otherwise compete with Omaha Steaks."<sup>63</sup> Plaintiff further contends that third-party uses are not entitled to any weight without probative evidence demonstrating the nature and extent of use, actual sales, and the like.

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<sup>60</sup> 38 TTABVUE 18-20

<sup>61</sup> *Id.* at 20-22.

<sup>62</sup> 31 TTABVUE. We have not considered the printout showing third-party use of OMAHA in connection with Vic's Omaha Popcorn in this decision because such use is not in a related industry.

<sup>63</sup> 48 TTABVUE 25.

The Federal Circuit has held that evidence of third-party use “can show that customers have been educated to distinguish between different marks on the basis of minute distinctions.” *Jack Wolfskin v. New Millennium Sports*, 116 USPQ2d at 1136 (quoting *Juice Generation, Inc. v. GS Enters.*, 115 USPQ2d at 1674). Contrary to Plaintiff’s understanding, the Federal Circuit further held that evidence of extensive use and registration of a term by others as a mark can be “powerful on its face, even where the specific extent and impact of the usage has not been established.” *Jack Wolfskin v. New Millennium Sports*, 116 USPQ at 1136 (internal quotes omitted). “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.” *Juice Generation v. GS Enters.*, 115 USPQ2d at 1674.

Upon review, we find the evidence introduced through the Peetz testimony does not show use of OMAHA-formative marks in connection with goods or services related to meat, and Defendant has not submitted evidence to show that the goods or services highlighted in that evidence, e.g., oriental foods and gifts, popcorn, restaurant and café services, may be considered “similar” to the meat in the cited registration. See *Omaha Steaks v. Greater Omaha Packing* 128 USPQ2d at 1693-94 (quoting *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992) (internal citation omitted) (“[T]he relevant *du Pont* inquiry is ‘[t]he number and nature of similar marks in use on similar goods.’”). As such, they have no probative value in this decision.

Defendant's relevant evidence, namely the trade name use of B.I.G. Meats Omaha, Omaha Meat Processors, Inc., and Omaha Beef Company in connection with beef-related businesses, fails to demonstrate such extensive use of OMAHA-formative marks, as contemplated by the sixth *DuPont* factor. Moreover, even if we were to consider the two restaurant uses showing OMAHA-formative marks in connection with beef as a menu item, the five third-party uses here are far too few in number to be "extensive" evidence of weakness that is "powerful on its face," *Jack Wolfskin v. New Millennium Sports*, 116 USPQ2d at 1136, and there is no accompanying showing of any long duration or widespread exposure of the referenced uses that might enhance their probative value. *See also Juice Generation v. GS Enters.*, 115 USPQ2d at 1674 & n.1 (referring to evidence of "a considerable number," 26 third-party marks). We thus find that the third-party uses fail to evidence any commercial weakness of the OMAHA STEAKS mark.

In the absence of a finding of any commercial weakness in the cited mark, we find that Plaintiff's OMAHA STEAKS mark, as a whole, has achieved a strong degree of fame on the spectrum of "very strong to very weak." *Joseph Phelps v. Fairmont Holdings*, 122 USPQ2d at 1734.

## 2. Inherent Strength

To evaluate the inherent or conceptual strength of Plaintiff's OMAHA STEAKS mark, "we evaluate its intrinsic nature, that is, where it lies along the generic-descriptive-suggestive-arbitrary (or fanciful) continuum of words." *In re Davia*, 110 USPQ2d 1810, 1815 (TTAB 2014). "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.” *Juice Generation v. GS Enters.*, 115 USPQ2d at 1675.

Defendant made of record 118 third-party applications and registrations (both live and dead) for marks that include the word “OMAHA,” and in which that term is disclaimed.<sup>64</sup> “[T]hird-party registrations may be probative of conceptual strength or weakness as they ‘may be considered to demonstrate the meaning of a word which comprises the mark, or a portion thereof, to show that there is a well-known and commonly understood meaning of that word and that the mark has been chosen to convey that meaning. ... The conclusion to be drawn in such a case is that there is an inherent weakness in a mark comprised in whole or in part of the word in question and that, therefore, the question of likelihood of confusion is colored by that weakness to the extent that only slight differences in the marks may be sufficient to distinguish one from the other.’” *Sock It To Me, Inc. v. Aiping Fan*, 2020 USPQ2d 10611 at \*9 (TTAB 2000) (quoting *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); see also *Juice Generation v. GS Enters.*, 115 USPQ2d at 1675 (“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.”).

On review, none of the third-party registrations have any value in this proceeding. The overwhelming majority of the registrations are cancelled. A cancelled or expired

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<sup>64</sup> 29 TTABVUE. The applications, most of which are cancelled, show only that they have been filed. See *Interpayment Services Ltd. v. Docters & Thiede*, 66 USPQ2d 1463 (TTAB 2003).

registration has no probative value other than to show that it once issued and it is not entitled to any of the statutory presumptions of Section 7(b) of the Trademark Act. *In Re Ginc UK Limited*, 90 USPQ2d 1472, 1480 (TTAB 2007). *See also Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) (“a cancelled registration does not provide constructive notice of anything.”). The remaining live registrations cover goods and/or services that are unrelated to the goods at issue here. *See In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1751 (Fed. Cir. 2017) (disregarding third-party registrations for other types of goods where the proffering party had neither proven nor explained that they were related to the goods in the cited registration); *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009) (the third-party registrations are of limited probative value because the goods identified in the registrations appear to be in fields which are removed from the goods at issue).

Nonetheless, Plaintiff’s Registration issued based on a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), and with a disclaimer of the generic term “steaks.”<sup>65</sup> Accordingly, the mark is not inherently distinctive. *Yamaha Int’l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988); *see also Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009). We also take judicial

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<sup>65</sup> We take judicial notice of the definition of “steak” defined in MERRIAM-WEBSTER as “1a: a slice of meat cut from a fleshy part of a beef carcass.” [www.merriam.webster.com](http://www.merriam.webster.com), retrieved September 29, 2020. The Board may take judicial notice of dictionary definitions, including online dictionaries which exist in printed format. *See In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014); *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002).

notice of OMAHA, which is defined in MERRIAM-WEBSTER under the category “geographical name” as a “city on the Missouri River in eastern Nebraska.”<sup>66</sup> We accordingly find that OMAHA is geographically descriptive of the location of a city, and conclude that OMAHA is conceptually weak as a source indicator.

The record corroborates this finding and also shows that the City of Omaha is widely known as a place beef comes from. For example, an article by Denis Horgan, *Courant Travel Editor*, is titled “A Gem Of The Midwest Omaha Nebraska It’s Known For Its Beef, But There’s A Lot More To City That Was Crossroad To Western Expansion” and states, in part, “Omaha is known for its beef, of course.”<sup>67</sup> The “What is” article in *Food & Spirits Magazine*, a free magazine distributed in the Omaha metro area, states “... Omaha is known for its beef ... .”<sup>68</sup> Moreover, the relevant third-party uses of OMAHA- formative marks of record show geographic use of the word OMAHA in trademarks or trade names used in connection with meat.

Notwithstanding our finding that OMAHA STEAKS, as a whole, is entitled to a high degree of protection on the fame continuum, we find the component word OMAHA to be geographically descriptive and, thus, we make clear that Plaintiff has not demonstrated exclusive rights to the word OMAHA by itself. Similarly, the word STEAKS, alone, is highly descriptive if not generic, as used in connection with Plaintiff’s identified meat and, accordingly, it is a less significant component of

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<sup>66</sup> [www.merriam.webster.com/dictionary/Omaha](http://www.merriam.webster.com/dictionary/Omaha), retrieved September 15, 2020.

<sup>67</sup> 31 TTABVUE 8.

<sup>68</sup> *Id.* at 18.

Plaintiff's mark. See *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (finding the disclaimed word CAFÉ the less significant part of the mark THE DELTA CAFÉ). Consequently, we do not find that Plaintiff's OMAHA STEAKS mark bars registration of every mark including the component word OMAHA; it will only bar registration of marks "as to which the resemblance to [Defendant's marks] is striking enough to cause one seeing it to assume that there is some connection, association or sponsorship between the two." *Anthony's Pizza & Pasta Int'l Inc. v. Anthony's Pizza Holding Co.*, 95 USPQ2d 1271, 1278 (TTAB 2009), *aff'd*, 415 Fed. Appx. 222 (Fed. Cir. 2010) (quoting *Pizza Inn, Inc. v. Russo*, 221 USPQ 281, 283 (TTAB 1983)).

#### **D. The Marks**

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion v. Lion Capital*, 110 USPQ2d at 1160 (quoting *Palm Bay. v. Veuve Clicquot*, 73 USPQ2d at 1691. When the goods are legally identical, the degree of similarity between the marks necessary to support a determination that confusion is likely declines. See *Bridgestone Americas Tire Operations, LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012); *In re Viterra Inc.*, 101 USPQ2d at 1908; *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010). Here, that precept is balanced by our finding that the word OMAHA is inherently weak, and therefore only entitled to a narrow scope of protection.

With these principles in mind, we compare Defendant's mark, shown below,



with Petitioner's typed OMAHA STEAKS mark. Although we must compare the marks in their entireties, one feature of a mark may be more significant than another and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *See In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985) ("There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.").

Further, where both words and a design comprise the mark, the words are normally accorded greater weight because they are more likely to make an impression upon purchasers, would be remembered by them, and would be used by them to request the goods and/or services. *In re Viterra Inc.*, 101 USPQ2d at 1908, *citing CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983) ("in a composite mark comprising a design and words, the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed"); *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1430-31 (TTAB 2013); *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987). *See also Giant Food, Inc. v. Nation's Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983).

Considering Plaintiff's mark, it is dominated by the geographically descriptive word OMAHA, as the word STEAKS is generic and has been disclaimed. Disclaimed

matter that is descriptive or generic of a party's goods is typically less significant or less dominant when comparing marks. See *Citigroup Inc. v. Capital City Bank Group Inc.*, 98 USPQ2d 1253, 1257 (Fed. Cir. 2011); *Dixie Rests.*, 41 USPQ2d at 1533-34 (finding DELTA the dominant part of the mark THE DELTA CAFÉ because CAFÉ was disclaimed"). Greater weight is often given to the dominant feature when determining whether marks are confusingly similar. See *In re Nat'l Data Corp.*, 224 USPQ at 751.

Defendant's mark is dominated by the words GREATER OMAHA; they are the first words in the mark, are visually larger than the laudatory slogan, "PROVIDING THE HIGHEST QUALITY BEEF," and are the words that would be used to call for the goods. While we do not find the steer head design, alone, sufficient to distinguish the two marks, it is an element of visual difference that is not present in Plaintiff's mark. Defendant also has disclaimed all of the wording in its mark because it is laudatory; however, that does not remove those words from the mark, or reduce the visual dominance of the words GREATER OMAHA. As stated by our primary reviewing court,

... it is well settled that the disclaimed material still forms a part of the mark and cannot be ignored in determining likelihood of confusion. Such disclaimers are not helpful in preventing likelihood of confusion in the mind of the consumer, because he is unaware of their existence. Therefore, the disclaimed portions must be considered in determining the likelihood of confusion. (citations omitted)

*Giant Food v. Nation's Foodservice*, 218 USPQ2d at 395; see also *In re Nat'l Data Corp.*, 224 USPQ at 751-752; *V-M Corp. v. Mayfair Sound Prd., Inc.*, 480 F.2d 898, 178 USPQ 477, 477-478 (CCPA 1973). As noted above, notwithstanding the

disclaimer, the words GREATER OMAHA can still be dominant, visually, and because they would be used to call for the goods, when discussed orally.

Although the wording GREATER OMAHA and OMAHA STEAKS look and sound alike to the extent that OMAHA is present in both marks, the marks are specifically different. *See Jack Wolfskin v. New Millennium Sports*, 116 USPQ2d at 1134-35. The word GREATER is a prominent point of difference that causes Defendant's mark to differ in appearance and sound from Plaintiff's mark. The additional matter in the two marks, i.e., the slogan and steer head design in Defendant's mark and the generic term STEAKS in Plaintiff's mark, while less dominant, also contribute to the differences in appearance and sound between them.

As regards meaning, in both marks the word OMAHA connotes a geographic location. The addition of GREATER to Defendant's mark imparts to it a meaning of a metropolitan region; whereas the addition of STEAK to Applicant's mark imparts to it a meaning of food, particularly steak from Omaha.

Although there are similarities between the marks, the marks are specifically different in sound, appearance and meaning, and these differences, including the absence of the word STEAKS in Defendant's mark, outweigh the similarities, resulting in different overall commercial impressions. The only similarity is the geographically descriptive word OMAHA, which for reasons noted above, is not likely to be regarded as the proprietary or exclusive mark of any single provider of meat.

The *DuPont* factor of similarity of the marks thus favors a finding of no likelihood of confusion.

### **E. Actual Confusion**

Defendant's assertion, confirmed by Plaintiff, that the parties are unaware of any instances of actual confusion between the marks is entitled to very little weight. First, it is not necessary to show actual confusion in order to establish likelihood of confusion. *Herbko Int'l Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. (2002)); *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990), *aff'g HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989). Second, the marks have been in contemporaneous use for only a short time, since 2014. Thus, the opportunity for actual confusion to have occurred in the marketplace is minimal. *See Cunningham v. Laser Golf*, 55 USPQ2d at 1847. Accordingly, the eighth *DuPont* factor, the length of time during and conditions under which there has been contemporaneous use without actual confusion, is neutral.

Defendant maintains that its opposed mark includes the two words GREATER OMAHA which it has used as a trademark for beef, and as the first two words of its company name since 1920. Defendant further maintains that Plaintiff claims to have been using the OMAHA STEAKS mark on meat since 1968 and has admitted that it has been aware of the existence of Defendant since as least as early as 1996. As a result, there have been decades of concurrent use without actual confusion. We find Defendant's argument unavailing for two reasons: (1) Defendant's mark at issue in this proceeding is a composite word and design mark and not the two-word mark GREATER OMAHA; and (2) because the record raises a question of whether

Defendant is moving into a new market space, we cannot ascertain whether there has been a meaningful opportunity for contemporaneous use of the respective marks in connection with the identified goods.

**F. 13th *DuPont* Factor – Bad Faith Adoption**

Under the thirteenth *DuPont* factor, evidence of an applicant's bad faith adoption of its mark is relevant to our likelihood of confusion analysis. *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1890 (TTAB 2008). See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991) ("Whether there is evidence of intent to trade on the goodwill of another is a factor to be considered, but the absence of such evidence does not avoid a ruling of likelihood of confusion."); *Jacobs v. International Multifoods Corp.*, 668 F.2d 1234, 212 USPQ 641, 643 (CCPA 1982) (Nies, J., concurring opinion) ("The absence of intent to confuse would not preclude a finding of likelihood of confusion, but had such intent been shown (which it has not), it would be a factor to weigh against the newcomer."); *Lever Bros. Co. v. Riodela Chemical Co.*, 41 F.2d 408, 5 USPQ 152, 154-55 (CCPA 1930) ("[W]e have a right, in determining the question of likelihood of confusion or mistake, to consider the motive in adopting the mark as indicating an opinion, upon the part of one vitally interested, that confusion or mistake would likely result from the use of the mark."). In this case, there is no evidence of record of any intent by Defendant to trade on the goodwill of Plaintiff. Accordingly, this *DuPont* factor is neutral.

### G. Conclusion

We have considered all of the evidence made of record pertaining to the likelihood of confusion issue, as well as all of the arguments related thereto. We find that the likely perception of OMAHA as a geographic indicator is a factor entitled to significant weight in our likelihood of confusion analysis. This fact, together with the differences in the marks, including the absence of the word STEAKS in Defendant's mark, outweighs the legal identity of the goods, the presumed identical trade channels, and the fame that Plaintiff has demonstrated in the mark OMAHA STEAKS.

We conclude that consumers familiar with Plaintiff's "meat" sold under the OMAHA STEAKS mark are **not** likely to mistakenly believe, upon encountering

Defendant's mark  for "meat, including boxed beef primal cuts," that the goods originate from or are associated with or sponsored by the same entity.

Decision: The notice of opposition is dismissed.