

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Hearing: March 23, 2017

Mailed: September 30, 2017

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.*

—  
Opposition No. 91213527  
Cancellation No. 92059629  
Cancellation No. 92059455

—  
CONSOLIDATED PROCEEDINGS<sup>1</sup>

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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Before Taylor, Kuczma and Masiello, Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

This is a consolidated proceeding involving an opposition and two cancellation actions brought by Omaha Steaks International, Inc. (hereafter “Plaintiff” or “Omaha

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<sup>1</sup> The record in these consolidated proceedings, which were consolidated by the order issued February 13, 2015, is maintained in Opposition No. 91213527 and all citations are to that proceeding unless otherwise noted.

Steaks”) against three marks owned by Greater Omaha Packing Co., Inc. (hereafter “Defendant” or “Omaha Packing”). Plaintiff opposes 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>2</sup> and seeks to cancel Defendant’s Registration No. 3998763 (Cancellation No. 92059629) for the mark U.S. Beef 1881 OMAHA HEREFORD CORNFED and design (shown below)



(hereafter “OMAHA HEREFORD”) for “Hereford beef” in Class 29;<sup>3</sup> and Registration No. 4006768 (Cancellation No. 92059455) for the mark OMAHA NATURAL ANGUS

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<sup>2</sup> Application Serial No. 85897951 filed April 8, 2013 and asserting a bona fide intention to use the mark in commerce based upon Applicant’s allegation of 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”.

<sup>3</sup> Issued July 19, 2009; Section 8 affidavit accepted. “U.S. BEEF,” “1881,” “OMAHA HEREFORD,” and “CORNFED” have been disclaimed. The registration includes the following description: “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”,

CORN FED MINIMALLY PROCESSED AND NO ARTIFICIAL INGREDIENTS and design (shown below)



(hereafter “OMAHA NATURAL ANGUS”) for “Angus beef” in Class 29.<sup>4</sup>

Omaha Steaks has pleaded in each of the three proceedings priority and likelihood of confusion under Section 2(d) of the Act, 15 U.S.C. §1052(d), and dilution under Section 43(c) of the Act, 15 U.S.C. § 1125(c).<sup>5</sup> Plaintiff, in particular, alleges that Defendant’s marks, when used in connection with the identified goods, so

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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 white outline, gray background, and the shape of the gray background are not claimed as a feature of the mark.” “The color(s) black, white, marron is/are claimed as a feature of the mark.” The filing date of the underlying application is September 10, 2009, and April 4, 2011 is claimed as the date of first use of the mark anywhere and in commerce.

<sup>4</sup> Issued August 2, 2011; Section 8 affidavit accepted. “OMAHA NATURAL ANGUS,” “CORN FED,” and “MINIMALLY PROCESSED AND NO ARTIFICIAL INGREDIENTS” disclaimed. The registration includes the following description and color statements: “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.” “The color(s) gold, yellow, red, black, gray is/are claimed as a feature of the mark.” The filing date of the underlying application is October 20, 2009, and May 2010 is claimed as the date of first use of the mark anywhere and in commerce.

<sup>5</sup> Omaha Steaks’ dilution claim is 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).

resemble its previously used and registered marks that incorporate the words OMAHA STEAKS, OMAHA FRESH ANGUS BY OMAHA STEAKS or OMAHA STEAKS ANGUS (in standard characters alone or in combination with other words and/or design elements), including the marks in the registrations and applications listed in the “Schedule of Marks” below, as to be likely to cause confusion. Plaintiff further alleges that “[b]y 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 ... .”

Plaintiff also claims 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 made particular note of in its brief are set out below, followed by a “Schedule of Marks” listing all of the pleaded registrations and applications, which was prepared by Plaintiff and attached as Exhibit A to the Notice of Opposition, along with printouts for each listed registration from the

Trademark Electronic Search System ("TESS") database showing current status and title:<sup>6</sup>

1. 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>7</sup>

2. Registration No. 1674686 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 food store services" in International Class 42;<sup>8</sup>

3. 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

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<sup>6</sup> 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 the 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. The TESS printouts only accompanied the Plaintiff's pleading in the opposition, but we consider them of record for all three consolidated cases pending in this proceeding, as they have been so treated by the parties.

<sup>7</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.

<sup>8</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.

and frozen boxed steaks, and fresh and frozen cuts of meat” in International Class 29;<sup>9</sup>

4. 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>10</sup> and

5. 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 and frozen boxed steaks, and fresh and frozen cuts of meat” in International Class 29.<sup>11</sup>

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<sup>9</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>10</sup> Issued April 13, 2010. 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.

<sup>11</sup> Issued July 10, 2012. 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.

**SCHEDULE OF MARKS**

| Serial Number | Reg. Number | Reg. or Allowance Date | Mark  | Goods/Services   |  |
|---------------|-------------|------------------------|---|--|--|
| 73616747      | 1458802     | 1987-09-22             | OMAHA STEAKS  | <b>International Class:</b> 042<br>retail mail-order and retail food store services in the field of gourmet food products, kitchen apparel and kitchen utensils  | <b>First Use Date:</b><br>1968-00-00<br><br><b>First Use in Commerce Date:</b><br>1976-06-00 |
| 73697700      | 1515602     | 1988-12-06             | OMAHA STEAKS  | <b>International Class:</b> 029<br>meat sold to hotels, restaurants and institutions   | <b>First Use Date:</b><br>1968-00-00<br><b>First Use in Commerce Date:</b><br>1976-06-00     |
| 73711908      | 1555215     | 1989-09-05             | OMAHA STEAKS<br>FOODSERVICE   | <b>International Class:</b> 042<br>wholesale distributorship services in the field of food   | <b>First Use Date:</b><br>1987-12-17<br><br><b>First Use in Commerce Date:</b><br>1988-01-15 |
| 74158733      | 1674686     | 1992-02-04             | OMAHA STEAKS  | <b>International Class:</b> 042<br>retail food store services  | <b>First Use Date:</b><br>1968-00-00<br><br><b>First Use in Commerce Date:</b><br>1976-06-00 |
| 74669660      | 2002499     | 1996-09-24             | OMAHA STEAKS<br>ANGUS   | <b>International Class:</b> 029<br>fresh and frozen boxed steaks, and fresh and frozen cuts of meat  | <b>First Use Date:</b><br>1995-09-06<br><br><b>First Use in Commerce Date:</b><br>1995-09-06 |
| 75634292      | 2414603     | 2000-12-19             | OMAHASTEAKS.COM   | <b>International Class:</b> 042<br>providing information in the field of food and food preparation by means of a global computer network   | <b>First Use Date:</b><br>2000-05-25<br><br><b>First Use in Commerce Date:</b><br>2000-05-25 |
| 78207792      | 2840193     | 2004-05-11             | PREMIUM<br>HEARTLAND<br>QUALITY OMAHA<br>STEAKS SINCE 1917<br><br> | <b>International Class:</b> 029<br>Meat, Hot dogs, Hamburger patties, Corned beef, Ham, Liver, Bacon, Pork, Processed lamb, Turkey, Roast beef, Soups, Chicken, Fish, Processed Potatoes, Frozen vegetables, fish dip, and frozen meals consisting primarily of meat, fish, poultry or vegetables.<br><br><b>International Class:</b> 030<br>Bakery desserts, Frozen meals consisting primarily of pasta or rice, Steak seasoning, Bread, Butter sauce, Hollandaise sauce, Bearnaise sauce, Peppercorn | <b>First Use Date:</b><br>1996-01-01<br><br><b>First Use in Commerce Date:</b><br>1996-01-01 |

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|----------|---------|------------|--|---|---|
|          |         |            |  | <p>sauce, Bordelaise sauce, Gravy.</p> <p><b>International Class:</b> 035<br/>Electronic retailing services via computer featuring food and food related items; Mail order catalog services featuring food and food related items; Telephone shop-at-home services in the field of food and food related items.</p>   |   |
| 78207757 | 2893159 | 2004-10-12 | <p>PREMIUM<br/>HEARTLAND<br/>QUALITY OMAHA<br/>STEAKS STORES</p>  | <p><b>International Class:</b> 035<br/>retail food store services</p>   | <p><b>First Use Date:</b><br/>2002-12-19</p> <p><b>First Use in<br/>Commerce Date:</b><br/>2002-12-19</p>   |
| 77566409 | 3758608 | 2010-03-09 | <p>OMAHA STEAKS<br/>PRIVATE RESERVE</p>                           | <p><b>International Class:</b> 029<br/>Meat</p>   | <p><b>First Use Date:</b><br/>2008-09-29</p> <p><b>First Use in<br/>Commerce Date:</b><br/>2008-09-29</p>   |
| 77613754 | 3768689 | 2010-03-30 | <p>HEARTLAND<br/>QUALITY OMAHA<br/>STEAKS SINCE 1917</p>         | <p><b>International Class:</b> 029<br/>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.</p> <p><b>International Class:</b> 030<br/>sauces; bakery desserts; frozen entrees consisting primarily of pasta or rice; spring rolls; frozen meals consisting primarily of pasta or rice; rice cakes; seasonings; mustard; horseradish; cakes; cream puffs; cookies; cookie dough; breakfast burritos; tarts.</p> <p><b>International Class:</b> 035<br/>on-line retail store services featuring food and food related items; mail order catalog services featuring food and food related items, telephone shop-at-home services in the field of food and food related items;</p> | <p><b>First Use Date:</b><br/>2009-04-30 (Class 29 and 30)</p> <p>2009-04-15 (Class 35)</p> <p><b>First Use in<br/>Commerce Date:</b><br/>2009-04-30 (Class 29 and 30)</p> <p>2009-04-15 (Class 35)</p> |

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| 77613768 | 3768690 | 2010-03-30 | <p>HEARTLAND<br/>QUALITY OMAHA<br/>STEAKS SINCE 1917</p>    | <p>retail store services featuring food and food-related items</p> <p><b>International Class: 029</b><br/>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.</p> <p><b>International Class: 030</b><br/>sauces; bakery desserts; frozen entrees consisting primarily of pasta or rice; spring rolls; frozen meals consisting primarily of pasta or rice; rice cakes; seasonings; mustard; horseradish; cakes; cream puffs; cookies; cookie dough; breakfast burritos; tarts</p> <p><b>International Class: 035</b><br/>on-line retail store services featuring food and food related items; mail order catalog services featuring food and food related items, telephone shop-at-home services in the field of food and food related items; retail store services featuring food and food-related items</p> | <p><b>First Use Date:</b><br/>2009-03-31<br/>(Class 29 and 30)</p> <p>2009-03-03 (Class 35)</p> <p><b>First Use in Commerce Date:</b><br/>2009-03-31<br/>(Class 29 and 30)</p> <p>2009-03-03 (Class 35)</p>         |
| 77613775 | 3768691 | 2010-03-30 | <p>HEARTLAND<br/>QUALITY OMAHA<br/>STEAKS SINCE 1917</p>  | <p><b>International Class: 029</b><br/>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.</p> <p><b>International Class: 030</b><br/>sauces; bakery desserts; frozen entrees consisting primarily of pasta or rice; spring rolls; frozen meals consisting primarily of pasta or rice; rice cakes; seasonings; mustard;</p>  | <p><b>First Use Date:</b><br/>2009-03-31<br/>(Class 29 and 30)</p> <p>2009-03-03<br/>(Class 35)</p> <p><b>First Use in Commerce Date:</b><br/>2009-03-31<br/>(Class 29 and 30)</p> <p>2009-03-03<br/>(Class 35)</p> |

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|          |         |            |  | <p>horseradish; cakes; cream puffs; cookies; cookie dough; breakfast burritos; tarts.</p> <p><b>International Class:</b> 035<br/>on-line retail store services featuring food and food related items; mail order catalog services featuring food and food related items, telephone shop-at-home services in the field of food and food related items; retail store services featuring food and food-related items</p>   |   |
| 77613789 | 3768693 | 2010-03-30 | <p>HEARTLAND<br/>QUALITY OMAHA<br/>STEAKS SINCE 1917</p>  | <p><b>International Class:</b> 029<br/>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.</p> <p><b>International Class:</b> 030<br/>sauces; bakery desserts; frozen entrees consisting primarily of pasta or rice; spring rolls; frozen meals consisting primarily of pasta or rice; rice cakes; seasonings; mustard; horseradish; cakes; cream puffs; cookies; cookie dough; breakfast burritos; tarts.</p> <p><b>International Class:</b> 035<br/>on-line retail store services featuring food and food related items; mail order catalog services featuring food and food related items, telephone shop-at-home services in the field of food and food related items; retail store services featuring food and food-related items</p> | <p><b>First Use Date:</b><br/>2009-04-30<br/>(Class 29 and 30)</p> <p>2009-04-15<br/>(Class 35)</p> <p><b>First Use in<br/>Commerce Date:</b><br/>2009-04-30<br/>(Class 29 and 30)</p> <p>2009-04-15<br/>(Class 35)</p> |
| 77731765 | 3774260 | 2010-04-13 | <p>OMAHA STEAKS</p>  | <p><b>International Class:</b> 029<br/>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</p>  | <p><b>First Use Date:</b><br/>1968-12-31 (Class 29<br/>and 35)</p> <p>1996-09-01 (Class<br/>30)</p> <p><b>First Use in<br/>Commerce Date:</b><br/>1976-06-30 (Class 29<br/>and 35)</p>                                  |

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|          |         |            |  | <p>primarily of chicken or seafood; beef jerky; prepared nuts; omelets; meatballs; dips; frozen vegetables.</p> <p><b>International Class: 030</b><br/>sauces; bakery desserts; frozen entrees consisting primarily of pasta or rice; spring rolls; frozen meals consisting primarily of pasta or rice; rice cakes; seasonings; mustard; horseradish; cakes; cream puffs; cookies; cookie dough; breakfast burritos; tarts.</p> <p><b>International Class: 035</b><br/>on-line retail store services featuring food and food related items; mail order catalog services featuring food and food related items, telephone shop-at-home services in the field of food and food related items; retail store services featuring food and food-related items.</p> | 1996-09-01 (Class 30)   |
| 77853788 | 3799411 | 2010-06-08 | <p>OMAHA STEAKS PRIVATE RESERVE</p>                 | <p><b>International Class: 030</b><br/>Seasonings</p> <p><b>International Class: 035</b><br/>on-line retail store services featuring food and food related items; mail order catalog services featuring food and food related items; telephone shop-at-home services in the field of food and food related items</p>   | <p><b>First Use Date:</b><br/>2009-04-01 (Class 30)</p> <p>2008-10-01 (Class 35)</p> <p><b>First Use in Commerce Date:</b><br/>2009-04-01 (Class 30)</p> <p>2008-10-01 (Class 35)</p> |
| 77613760 | 3857498 | 2010-10-05 | <p>HEARTLAND QUALITY OMAHA STEAKS SINCE 1917</p>  | <p><b>International Class: 035</b><br/>on-line retail store services featuring food and food related items; mail order catalog services featuring food and food related items, telephone shop-at-home services in the field of food and food related items; retail store services featuring food and food-related items.</p>   | <p><b>First Use Date:</b><br/>2009-04-30</p> <p><b>First Use in Commerce Date:</b><br/>2009-04-30</p>   |
| 85153479 | 4172329 | 2012-07-10 | <p>OMAHA FRESH ANGUS BY OMAHA STEAKS</p>   | <p><b>International Class: 029</b><br/>angus meat</p>  | <p><b>First Use Date:</b><br/>2012-04-02</p> <p><b>First Use in Commerce Date:</b><br/>2012-04-02</p>   |
| 85153496 | 4172330 | 2012-07-10 | <p>OMAHA FRESH BY OMAHA STEAKS</p>   | <p><b>International Class: 029</b><br/>Meat</p>  | <p><b>First Use Date:</b><br/>2012-04-02</p> <p><b>First Use in Commerce Date:</b><br/>2012-04-02</p>   |

|          |         |                                   |  |   |  |
|----------|---------|-----------------------------------|--|---|--|
| 85153474 |         | Notice of Allowance<br>05-31-2011 | OMAHA FRESH BY<br>OMAHA STEAKS   | <b>International Class:</b> 035<br>Mail order catalog services featuring food and food related items; On-line retail store services featuring food and food related items; Retail stores featuring food and food related items; Wholesale food distributorship services                                   |  |
| 85153488 |         | Notice of Allowance<br>05-31-2011 | OMAHA FRESH<br>ANGUS BY OMAHA<br>STEAKS  | <b>International Class:</b> 035<br>Mail order catalog services featuring food and food related items; On-line retail store services featuring food and food related items; Retail stores featuring food and food related items; Wholesale food distributorship services                                   |  |
| 85319059 | 4250829 | 2012-11-27                        | OMAHA STEAKS   | <b>International Class:</b> 035<br>Food kiosk services<br><br><b>International Class:</b> 043<br>Food preparation services; Preparation of food and beverages; Providing of food and drink; Serving of food and drink/beverages   |  |
| 85319082 | 4250830 | 2012-11-27                        | HEARTLAND<br>QUALITY OMAHA<br>STEAKS SINCE 1917<br><br> | <b>International Class:</b> 035<br>Food kiosk services<br><br><b>International Class:</b> 043<br>Food preparation services; Preparation of food and beverages; Providing of food and drink; Serving of food and drink/beverages   |  |
| 85361435 | 4321575 | 2013-04-16                        | OMAHA STEAKS<br>PRIVATE RESERVE<br><br>                 | <b>International Class:</b> 029<br>baked potatoes   |  |
| 85383653 |         | Notice of Allowance<br>02-28-12   | OMAHA STEAKS<br>PRIVATE RESERVE<br><br>                 | <b>International Class:</b> 030<br>Bakery desserts; Barbecue sauce; Bread; Breakfast burritos; Cakes; Cheesecake; Cookie dough; Cookies; Cream puffs; Flavored vinegar; Frozen foods, namely, grain and bread based appetizers, hors d'oeuvres and canapés; Frozen meals consisting primarily of pasta or |  |

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|----------|---------|------------------------------|---|---|--|
|          |         |                              |   | rice; Gravy; Horseradish; Hot dog sandwiches; Ketchup; Macaroni salads; Mustard; Packaged meals consisting primarily of pasta or rice; Pasta salads; Prepared meals consisting primarily of pasta or rice; Rice cakes; Salad dressings; Sauces; Spring rolls; Tarts   |  |
| 85383663 | 4325113 | 2013-04-23                   | <p>OMAHA STEAKS PRIVATE RESERVE</p>    | <p><b>International Class:</b> 029<br/>                 Bacon; beef; beef jerky; beef stick snack foods; bratwurst; cheese; chicken; corned beef; crab cakes; crabs; dips; fish filets; fish; frankfurters; frozen appetizers consisting primarily of chicken or seafood; frozen entrees consisting primarily of meat, fish, poultry or vegetables; frozen meals consisting primarily of meat, fish, poultry or vegetables; frozen pre-packaged entrees consisting primarily of seafood; frozen vegetables; ham; hash brown potatoes; uncooked hamburger patties; hot dogs; liver; mashed potatoes; meatballs; omelets; packaged meals consisting primarily of meat, fish, poultry or vegetables; pork; potato fries; potato skins; poultry; pre-cut vegetable salad; prepared foods, namely, side dishes and casseroles mainly consisting of vegetables, potatoes, beans or fruit; prepared meals consisting primarily of meat, fish, poultry or vegetables; prepared nuts; processed lamb; processed potatoes; roast beef; salads except macaroni, rice and pasta salads; salmon; sausages; seafood; shellfish; soups; turkey; veal</p> |  |
| 85383667 |         | Notice of Allowance 02-28-12 | <p>OMAHA STEAKS PRIVATE RESERVE</p>  | <p><b>International Class:</b> 035<br/>                 Customer loyalty services and customer club services, for commercial, promotional and advertising purposes; Administration of an incentive award program enabling participants to obtain discounts and complimentary awards on goods and services through membership; Mobile retail store services featuring food and food related items; Providing incentive award programs for customers by offering discounts on goods for the purpose of promoting and awarding loyalty; Retail store services featuring food and food related items</p>  |  |

Greater Omaha has denied the salient allegations in each of the three proceedings and, additionally as to Cancellation No. 92059455, has pleaded the affirmative defense of laches.<sup>12</sup>

## **Evidentiary Matters**

### *Evidentiary Objections*

Both Omaha Steaks and Greater Omaha have interposed multiple objections against testimony and evidence submitted by the other.

#### 1. Peetz Testimony

Greater Omaha, 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 consists of 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." Omaha Steaks 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>13</sup> With regard to Plaintiff's objection on the ground of improper *ex parte* discovery, Ms. Peetz provided

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<sup>12</sup> Because Defendant did not pursue the laches affirmative defense asserted in Cancellation No. 92059629, it is deemed waived. *Alcatraz Media, Inc. v. Chesapeake Marine Tour*, 107 USPQ2d at 1753 n.6. The remaining "affirmative defenses" set forth in each of the three proceedings are merely amplifications of Defendant's denials and have been treated as such.

<sup>13</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.

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.

### 2. Defendant's Fifth Notice of Reliance

Omaha Steaks also 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. We overrule this objection inasmuch as "evidence of third-party use bears on the strength or weakness of an opposer's [plaintiff's] mark." *Juice Generation, Inc. v. GS Enters. LLC*, 115 USPQ2d 1671 (Fed. Cir. 2015); *see also Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 116 USPQ2d 1129 (Fed. Cir. 2015). Plaintiff's objection is therefore overruled.

### 3. Todd Simon Testimony and Exhibits 1-9

Omaha Packing has objected to portions of the testimony of Todd Simon and Exhibits 1-9.<sup>14</sup> Exhibits 1-7 and 9 to Mr. Simon's testimony were not placed in the

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<sup>14</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.

record. Accordingly, Defendant's objections to these exhibits are moot.<sup>15</sup> Defendant further objects, as noted below, to Mr. Simon's testimony relating to 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

Circumstances surrounding a photograph of a plaque presented to Plaintiff as speculation, lack of personal knowledge and competence and hearsay.

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.

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<sup>15</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.

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 position, arguing 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 the 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>16</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 the report compiled by Plaintiff’s in-house advertising agency in the regular course of business into the record. Because Defendant has not specified what elements are lacking, we cannot ascertain whether Plaintiff’s summary meets all the requirements of Fed. R. Evid.

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<sup>16</sup> 33 TTABVUE 209 – 214.

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 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 objects to B. Simon's testimony regarding company history on those grounds, as well as 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. 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 STEAKS 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 is not improper rebuttal. Plaintiff has alleged, in pertinent part, that:<sup>17</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 ...”

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<sup>17</sup> Notice of Opposition ¶ 22; 1 TTABVUE 8. The petitions for cancellation include very similar allegations at ¶ 15 of each petition; 1 TTABVUE 17 (92059629) and 1 TTABVUE 18 (92059455).

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 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 which was performed sometime prior to May 2015, when the initial report issued<sup>18</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>19</sup>

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<sup>18</sup> A supplemental report issued in August 2015, in response to a rebuttal report of Robert Klein (not of record).

<sup>19</sup> 44 TTABVUE 8-9.

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>20</sup> This was done, Mr. Poret explained, so that each survey participant “was a purchaser through one of those channels which was designed to represent the channels through which Omaha Steaks specifically markets its products.”<sup>21</sup>

While maintaining its objections to the Poret testimony and exhibits, Defendant, in the event the Board allowed this evidence into the record, asserted that:

Plaintiff’s survey was fundamentally flawed and is entitled to no probative value because it asked its survey questions to a narrowly defined universe of respondents that was much too narrow and under-inclusive because it intentionally eliminated from the universe of respondents the vast majority of meat purchasers, such as those purchasing from grocery stores or any retailer other than Plaintiff. Because Plaintiff’s survey universe was so narrow, the survey results were slanted to support the goal of the survey, and Hal Poret’s opinions were therefore invalid.

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>22</sup> Here, Plaintiff’s

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<sup>20</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>21</sup> 44 TTABVUE 10.

<sup>22</sup> 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 15:46 (4<sup>th</sup> ed. 2017) (“While the ‘focus’ of secondary meaning is ‘the consuming public,’ it need not be proven

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.

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>23</sup>

*Plaintiff's Request for Judicial Notice*

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... ." In all but one instance, Plaintiff merely listed the case, by caption. 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,

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among the *general* public if a product is targeted at only a specific segment of the general public.") (emphasis supplied).

<sup>23</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).

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.

Fed. R. Evid. 201(c) provides, in pertinent part, that "[t]he court ... (2) must take judicial notice if a party requests it and the court is supplied with the necessary information." Here, while Plaintiff has made its request, it failed to supply the Board with any material, e.g., the pleadings, to substantiate its claim. Notwithstanding that the rule requires that the party requesting a tribunal to take judicial notice supply the subject material to the tribunal, it is common sense to do so; the requesting party cannot simply contend that certain statements or, as in this case, filings were made in material that has not been provided and expect the Board to consider the assertion established. Under these circumstances, Plaintiff's request for judicial notice is denied.

### **The Record**

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.

#### *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.

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 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):

- a. Polk City Directories Website printout dated April 4, 2015;
- b. Polk Omaha City Directories dated 1928, 1929, 1931 - 1934, 1936, 1938, 1940, 1942, 1945, 1946, 1949, 1951, 1954 and 1955;
- c. Omaha World Herald Wikipedia Entry (printout dated February 19, 2016); and
- d. 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):

- a. the obituaries of Herman Cohen and Pennie Z. Davis published in the Omaha World Herald newspaper;
- b. 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;
- c. a website printout from a seller of Defendant's beef under the Greater Omaha mark; and
- d. 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.

Plaintiff and Defendant filed briefs, and Petitioner filed a reply brief. Both parties were represented at an oral hearing before this panel on March 23, 2017.

## **Background**

### ***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. 9, T. Simon test. p. 4).<sup>24</sup> About 1959, Plaintiff started doing business as Omaha Steaks. (*Id.* at 10).<sup>25</sup> Plaintiff employs about 1,800 hundred people year round, and during the peak December holidays, Plaintiff employs around 4,300 employees and processes

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<sup>24</sup> 33 TTABVUE 11, 133.

<sup>25</sup> *Id.* at 12.

100,000 orders a day. (B. Simon test. p. 7).<sup>26</sup> Plaintiff does not slaughter animals but acquires “subprimals” or larger cuts of meat, such as the loin or bovine loin, for further processing to “clean them up, make them pretty, make them more steak-ready, take the tendons off,” and then packages the processed meat for sale to its consumers under the Omaha Steaks Angus trademark. (B. Simon test. pp. 35-38).<sup>27</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). Plaintiff acquires “much less” than ten percent (10%) of its product from Defendant. (*Id.* at 40).<sup>28</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; Exs. 10 - 25)<sup>29</sup>. Despite the personal relationship between Plaintiff’s principal, Bruce Simon and Defendant’s principal, Henry Davis, Plaintiff instituted these proceedings to defend its trademarks.<sup>30</sup>

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<sup>26</sup> *Id.* at 9.

<sup>27</sup> *Id.* at 37-40.

<sup>28</sup> *Id.* at 42.

<sup>29</sup> *Id.* at 15 and 31-34, Exh. 10-25.

<sup>30</sup> 33 TTABVUE 45-46. Mr. Simon particularly testified that:

Q. Yes. So given your friendship with Henry [Davis] and your high opinion of his plant, why did you initiate -- why did you direct my law firm to initiate this proceeding?

A. Because a trademark is a trademark, and we have to defend our trademarks. There’s just no ifs, ands, or buts about it. ...

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>31</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>32</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,

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...

A. ... Look, if there was any other way to settle this -- we suggested, what do you call it, the common use, the shared --

Q. Co-existence?

A. Co-existence. You know, if Henry would have agreed -- Henry is not in our business. He doesn't do -- traditionally he hadn't been in the steak cutting business. I understand he is now. As long as he sticks to food service, that's just fine. But when he moves into the direct-to-consumer business, we're going to have defend to our trademark. ...

<sup>31</sup> 42 TTABVUE 18-19.

<sup>32</sup> 27 TTABVUE 1-34.

exh. 24).<sup>33</sup> Prior to 1992, Defendant sold hanging beef, i.e., beef carcasses; beef carcasses are no longer available. (Fili test. pp 16, 83).<sup>34</sup> 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).<sup>35</sup> Defendant has a 10,000 pound minimum purchase requirement for its beef products. (Fili test. pp. 72-73).<sup>36</sup> In late 2005 or early 2006, Defendant began planning a new program for minimally-processed Angus beef which contained no artificial products, and thought a new trademark would be helpful to the new Angus beef marketing program. A branded program call Omaha Natural Angus was created and a new logo designed. (Fili test. p 46).<sup>37</sup> Defendant has continuously sold beef to Plaintiff from 1966 to the present, (Defendant's Third NOR, NR-5, Request No. 8 - Admitted),<sup>38</sup> and further, has continuously sold Omaha Natural Angus Logo-branded Angus beef to Plaintiff from approximately 2006 to at least 2014). (Fili test. pp. 50-51).<sup>39</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

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<sup>33</sup> 39 TTABVUE 34, 68-70, 115-120, 159.

<sup>34</sup> *Id.* at 17, 84.

<sup>35</sup> *Id.* at 21.

<sup>36</sup> *Id.* at 73-74.

<sup>37</sup> *Id.* at 47. The "new logo" is identical to the mark in involved registration No. 4006768,



Mr. Fili further testified that when the new logo was created, Defendant did not have Plaintiff's company name or trademarks in mind. *Id.*

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

<sup>39</sup> 39 TTABVUE 51-52.

\$100,000,000 (in 1992) to in excess of \$1,700,000,000 (in 2015). (Davis test. pp. 64-65).<sup>40</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>41</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>42</sup>

### **Standing**

Standing is a threshold issue that must be proven by a plaintiff in every *inter partes* case. See *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 1401 (2015); and *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). To establish standing in an opposition or a cancellation proceeding, a plaintiff must show both a real interest in the proceeding as well as a reasonable belief of damage. *Empresa Cubana Del Tabaco v. Gen. Cigar*, 111 USPQ2d at 1062; *Ritchie v. Simpson*, 50 USPQ2d at 1025. Here, Plaintiff has 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, that it is the owner of its pleaded registrations and that those

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<sup>40</sup> 42 TTABVUE 65-66.

<sup>41</sup> 39 TTABVUE 73-74.

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

registrations are valid and subsisting. Because those registrations are properly of record, Plaintiff has established its standing. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

### **Priority**

To establish priority on a likelihood of confusion claim brought under Trademark Act Section 2(d), a party must prove that, vis-à-vis the other party, it owns "a mark or trade name previously used in the United States ... and not abandoned...." Trademark Act Section 2, 15 U.S.C. § 1052. A party may establish its own prior proprietary rights in a mark through ownership of a registration, actual use or through use analogous to trademark use, *See Trademark Act §§ 2(d) and 45*, 15 U.S.C. Section 1052(d) and 1127; *T.A.B. Sys. v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996), *vacating Pactel Teletrac v. T.A.B. Sys.*, 32 USPQ2d 1668 (TTAB 1994). Priority is not in issue in the opposition with respect to Plaintiff's pleaded marks for the goods and services listed in those registrations. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

As regards the cancellation proceedings, because both parties own registrations, Plaintiff must prove priority of use in order to prevail on its claim of priority and likelihood of confusion. *M.C.I. Foods, Inc. v. Bunte*, 96 USPQ2d 1544, 1550 (TTAB 2010) (in a cancellation proceeding where both parties own registrations, priority is always an issue because both parties are entitled to the presumptions accorded a registration under Section 7(c) of the Trademark Act, 15 U.S.C. §1057(c)).

*See also, Brewski Beer Co. v. Brewski Brothers Inc.*, 47 USPQ2d 1281, 1284 (TTAB 1998) (“Of course, petitioner or respondent may rely on its registration for the limited purpose of proving that its mark was in use as of the application filing date.”). Similarly, Defendant may rely on September 10, 2009 as its constructive first use date with respect to the mark in Registration No. 3998763 (OMAHA HEREFORD) and October 20, 2009 with respect to the mark in Registration No. 4006768 (OMAHA NATURAL ANGUS). Because Plaintiff properly introduced its pleaded registrations into the trial record, it prevails as to priority as regards to the marks and the goods and services recited therein, on the basis of its earlier filing dates of the underlying applications for the registrations made of record in this proceeding, except as to the marks (and the goods and services) recited in Registration Nos. 3799411, 4172329, 4172230, 4250829, 4250830, 4321575, and 4325113 (matured from application Serial No. 85383663), as those filing dates are later than Defendant’s September 10, 2009 and October 20, 2009 constructive first use dates.<sup>43</sup> Plaintiff also established that it started doing business as Omaha Steaks in 1959. Notably, Defendant did not challenge Plaintiff’s priority.

### **Likelihood of Confusion**

Our determination of the issue of likelihood of confusion is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ

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<sup>43</sup> The fact that Plaintiff does not have priority as to the marks (and goods and services) does not affect our decision because Plaintiff has clearly establish its priority of use of very similar marks and identical, or related goods and services.

563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). We consider these factors and any likelihood of confusion factors about which the parties introduced evidence or argued, and treat the remaining factors as neutral.

We focus our analysis on pleaded Registration Nos. 2002499 for the mark OMAHA STEAKS ANGUS for “fresh and frozen boxed steaks, and fresh and frozen cuts of meat” and Registration No. 3774260 for the mark OMAHA STEAKS (in standard characters and with “Steaks” disclaimed) for, *inter alia* “meat” in International Class 29, as these are the marks for which Plaintiff has priority and are the marks that are closest to Defendant’s involved marks, and the registrations cover goods that, when considered vis-à-vis the goods identified in the involved application and registrations, are most likely to support a finding of likelihood of confusion. If confusion is likely between Defendant’s marks and the marks in the ’499 and ’260 registrations, there is no need for us to consider the likelihood of confusion with the other cited marks. On the other hand, if there is no likelihood of confusion between Defendant’s marks and the marks in the ’499 and ’260 registrations, then there would be no likelihood of confusion with the other pleaded marks. *See, e.g., In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

We will consider the issue of likelihood of confusion with respect to each proceeding in turn.

**Opposition No. 91213527 (GREATER OMAHA)**

With respect to the Opposition proceeding, the parties focused their arguments on Plaintiff's pleaded registration No. 3774260 for the mark OMAHA STEAKS for "meat."

*The Goods/Channels of Trade/Classes of Purchasers*

We first consider the second *du Pont* factor, 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 described, 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., In re Elbaum*, 211 USPQ 639 (TTAB 1981).

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 *du Pont* factors of the similarity of the goods, the channels of trade and classes of purchasers favor Plaintiff.

*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 the respective 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 Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014) (quoting *Octocom Sys., Inc. v. Houston Computers Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)) (affirming that TTAB properly considered all potential investors for recited services, which included sophisticated investors, but that

precedent requires consumer care for likelihood-of-confusion decision to be based “on the least sophisticated potential purchasers”).

We thus find this *du Pont* factor neutral.

*Fame of Plaintiff's Marks*

This *du Pont* factor requires us to consider the fame of Plaintiff's marks. Fame, 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. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

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.*, 63 USPQ2d at 1305-1306 and 1309. However, raw numbers alone may be misleading. Thus, some context in which to place raw statistics may be necessary (e.g., the substantiality of the sales or advertising figures for comparable types of products or services). *Bose Corp.*, 63 USPQ2d at 1309.

In addition to the findings of fact set forth in the background section of this decision, Plaintiff has supported its claim that its pleaded OMAHA STEAK marks

are famous primarily with the 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 2013, on domestic advertising of its beef products. (T. Simon test. pp. 16-19).<sup>44</sup> 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, 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>

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<sup>44</sup> 33 TTABVUE 145-148.

<sup>45</sup> *Id.* at 147-155, 208-209.

<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.

Plaintiff has attended multiple trade shows, including PPSI in Las Vegas, the Realtors Conference in San Diego (*Id.* at 39-41),<sup>49</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>50</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>51</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>52</sup> The kiosks have appeared in nationally-released films "Up in the Air" and "About Schmidt." (*Id.* at 53).<sup>53</sup> Plaintiff also sells its products on Amazon. (*Id.* at 32).<sup>54</sup>

Omaha Steaks has also 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>55</sup>

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<sup>49</sup> *Id.* at 168-170.

<sup>50</sup> *Id.* at 171.

<sup>51</sup> *Id.* at 172 - 175.

<sup>52</sup> *Id.* at 147, 176-177.

<sup>53</sup> *Id.* at 182.

<sup>54</sup> *Id.* at 161.

<sup>55</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

Defendant counters Plaintiff's position, not only arguing that Plaintiff's evidence is entitled to little probative weight, for the reasons discussed in the evidentiary objections, but also 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.'"

Although Petitioner's evidence appears impressive at first blush, we find that much of the testimony lacks context and, thus, fails to convey to us the extent to which customers recognize Plaintiff's OMAHA STEAKS marks. As regards the sales and advertising figures, while they appear impressive, Plaintiff has not provided any context for them, i.e., how they translate into evidence of market share for Plaintiff's goods. As the Federal Circuit has stated, "[r]aw 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.* 63 USPQ2d at 1309. Similarly, while there is testimony that OMAHA STEAKS has been featured in prominent magazines, on this record, we are unclear how often the marks appear in those magazines and, thus, if the exposure translated into notoriety.

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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).

In addition, the record is vague as to how public exposure to OMAHA STEAKS branded concessions in local venues translates to widespread recognition of Plaintiff's marks or how such exposure affects public perception. Plaintiff simply has provided no examples of its advertising content showing how the OMAHA STEAKS marks are used across the various referenced media, or any other evidence corroborating Plaintiff's testimony. As a result, we are uncertain as to which of the OMAHA STEAKS marks are being advertised or otherwise exposed to potential consumers, and how they are being perceived by those consumers. The question remains: Are Plaintiff's marks being displayed in a manner that leads to widespread recognition?

"In view of the extreme deference that is accorded to a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, we think that it is the duty of a plaintiff asserting that its mark is famous to clearly prove it." *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d 1811, 1819 (TTAB 2005). While Plaintiff has shown that its marks have demonstrated a reasonable degree of recognition, the evidence is not sufficient to support a finding that the marks are famous and thus entitled to the extensive breadth of protection accorded a truly famous mark, particularly in light of the fact that Petitioner's OMAHA STEAKS marks are not inherently distinctive.

*Number and Nature of Third-Party Uses/Strength of Petitioner's Mark*

The sixth *du Pont* factor requires us to consider evidence pertaining to the number and nature of similar marks in use on similar goods. "The purpose of a defendant introducing third-party uses is to show that customers have become so

conditioned by a plethora of such similar marks that customers ‘have been educated to distinguish between different such marks on the bases of minute distinctions.’” *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005).

Defendant takes the position that rather than being “famous” or “strong,” Plaintiff’s OMAHA STEAKS marks are extremely weak because there are many companies currently located in Omaha, Nebraska that are using trademarks or trade names in which the first word is “Omaha,” many of which are in the beef or food business. Citing *Jack Wolfskin v. New Millennium Sports*, 116 USPQ2d at 1136, Defendant contends that when there are numerous similar marks in use by third-party sources in related fields, such evidence may be considered 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 in 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>56</sup> Through the Peetz testimony and exhibits, Defendant made of record evidence of the following third-party uses of “Omaha” in the vicinity of Omaha, Nebraska:<sup>57</sup>

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<sup>56</sup> 49 TTABVUE 26.

<sup>57</sup> 40 TTABVUE, 41 TTABVUE.

- “Omaha Tower Café,” a “quaint café located in a large office building
- “Omaha Oriental Food & Gifts,” a specialty store selling oriental foods, grocery goods, and gifts
- “Omaha Popcorn,” a store located in a strip mall selling various flavors of popcorn, drinks and popcorn containers”
- “Omaha Tap House,” 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”
- “Omaha Culinary Tours,” a “[b]us tour featuring some of Omaha’s most well-known steakhouses”

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>58</sup> and Omaha Meat Processors, Inc. of Ohio, Nebraska.<sup>59</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>60</sup> The printouts show that B.I.G. Meats Omaha, Omaha Meat Processors,

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<sup>58</sup> 38 TTABVUE 18-20

<sup>59</sup> *Id.* at 20-22.

<sup>60</sup> 31 TTABVUE.

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.” Another printout shows third-party use of OMAHA in connection with Vic’s Omaha Popcorn.

Defendant also points to articles that show the City of Omaha is widely known as the 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>61</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>62</sup>

Defendant also points to evidence showing that Defendant and its predecessor have continually used the GREATER OMAHA trademark on beef for 96 years from 1920 to the present;<sup>63</sup> that Plaintiff has admitted that it has purchased (such trademarked) beef from Defendant in every year since the 1950’s;<sup>64</sup> that annual sales of GREATER OMAHA trademarked beef from 1992 to 2015 increased from in excess of \$100,000,000 (in 1992) to in excess of \$1,700,000,000 (in 2015). (Davis test. pp. 64-

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<sup>61</sup> Id. at 8.

<sup>62</sup> Id. at 18.

<sup>63</sup> 42 TTABVUE 38.

<sup>64</sup> 28 TTABVUE 15.

65)<sup>65</sup>; and therefore consumers have been conditioned over the course of 96 years to associate the GREATER OMAHA mark with Defendant, further proving that Plaintiff's OMAHA STEAKS marks are weak.<sup>66</sup>

Plaintiff challenges the evidence, arguing that none of the businesses identified in the Petz testimony provided individual, uncooked beef products or otherwise compete with Plaintiff. 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.

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. LLC*, 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

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

<sup>66</sup> Defendant also maintains that its use of the GREATER OMAHA trademark had begun 48 years prior to any alleged use of the OMAHA STEAKS trademark by Plaintiff. To the extent that Defendant is arguing that it has priority, Defendant is attacking the validity of Plaintiff's registration. The proper action for attacking the validity of a registration is a cancellation action. *Fiserv, Inc. v. Elec. Transaction Sys. Corp.*, 113 USPQ2d 1913, 1919 n.7 (TTAB 2015) (stating that absent a counterclaim, an applicant may not pursue an impermissible collateral attack on an opposer's registration); see also *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997).

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.

In this case, while the evidence is not overwhelming, it is sufficient to support a finding that the designation OMAHA, when used in a mark, may be perceived as an indication of the geographic location of the producer of the goods or the geographic origin of the goods themselves. Because many companies may be located in OMAHA, the power of this term to indicate a single commercial source is reduced.

This leads us to conclude that “OMAHA” is, conceptually, somewhat weak as a source indicator because the word “OMAHA” is geographically descriptive of the location of a city. As a result, a mark comprising, in whole or in part, the word OMAHA for such goods and services is entitled to only a narrow scope of protection. In other words, Defendant’s OMAHA STEAKS marks are not entitled to such a broad scope of protection that they bar registration of every mark comprising, in whole or in part, the word “OMAHA”; they will only bar the 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 (TTAB1983)).

*The Marks*

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 110 USPQ2d at 1160 (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 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 term OMAHA is somewhat 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 National 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 word “OMAHA,” as the word “Steaks” is generic and has been disclaimed. Disclaimed matter that is descriptive or laudatory 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,” 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 has also 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 term 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, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 218, USPQ2d 390, 395 (Fed. Cir. 1983); *see also In re National Data Corp.*, 224 USPQ at 751-752; *V-M 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 words GREATER OMAHA and OMAHA 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.

In short, although there are similarities between the marks, the marks are specifically different in sound, appearance and meaning. When the geographically descriptive term "Omaha" is viewed with the evidence of third-party uses of OMAHA trademarks and trade names, these differences outweigh the similarities, resulting in different overall commercial impressions.

The *du Pont* factor of similarity of the marks thus favor a finding of no likelihood of confusion.

#### 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 Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000). Accordingly, the eighth *du Pont* 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 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) The mark at issue in this proceeding is a composite word and design and not the two words, 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 GREATER OMAHA in connection with the identified goods.

#### *Bad Faith Adoption*

Under the thirteenth *du Pont* factor, evidence of an applicant's bad faith adoption of his 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.”); and *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 *du Pont* factor is neutral.

### 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, including any evidence and/or arguments not specifically discussed in this opinion. 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 factor, together with the differences in the marks, outweighs the legal identity of goods and the presumed identical trade channels, and the degree of renown that Plaintiff has demonstrated, and we see Plaintiff’s claim as only a speculative, theoretical possibility. See *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21

USPQ2d 1388, 1391 (Fed. Cir. 1992), citing *Witco Chemical Co. v. Whitfield Chemical Co., Inc.*, 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), *aff'g* 153 ISPQ 412 (TTAB 1967).

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.

**Cancellation No. 92059455 (OMAHA NATURAL ANGUS)**

With respect to this Cancellation, the parties focused their arguments on Plaintiff's pleaded registration No. 2002499 for the mark OMAHA STEAKS ANGUS for "fresh and frozen boxed steaks, and fresh and frozen cuts of meat."

*The Goods/Channels of Trade/Classes of Purchasers*

We begin with the goods, channels of trade and classes of purchasers. We must make our determinations under these factors based on the goods as they are recited in the respective registrations. *See Octocom Systems Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the

particular channels of trade or the class of purchasers to which sales of the goods are directed.”); *In re Elbaum*, 211 USPQ at 640.

Where the goods in a registration are broadly described, 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, id.*

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

We are unpersuaded by Defendant’s essential contention that the goods are somewhat dissimilar because they are not identical. The respective goods need not be identical or directly competitive in order for there to be a likelihood of confusion. Rather, they need only be related in some manner or the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993). Here, Plaintiff’s steaks and meat could be comprised of “angus beef.”

Because the goods are legally identical and because there are no limitations as to channels of trade or classes of purchasers in the registrations, we must presume

that the parties' meat will be sold in the same channels of trade and will be bought by the same classes of purchasers. *In re Viterra Inc.*, 101 USPQ2d at 1908 (the Board was entitled to rely on this legal presumption in determining likelihood of confusion). *See also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Canadian Imperial Bank, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003); *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994). In view of the above, the *du Pont* factors of the similarity of the goods, the channels of trade, and classes of purchasers strongly favor a finding of likelihood of confusion.

Conditions of Sale

Again Defendant maintains that both parties' customers are likely to exercise care in their decisions to purchase relatively expensive goods. For the reasons stated earlier in this decision, because the respective identifications include "meat" or "beef," 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 those goods include ordinary consumers who may purchase them on impulse. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014) (quoting *Octocom Sys., Inc. v. Houston Computers Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990))

Fame

Defendant contends that Plaintiff has failed to submit sufficient evidence to establish fame and, that instead of being famous, Plaintiff's marks are extremely

weak and entitled to only the narrowest scope of protection. As we found earlier in this opinion, while Plaintiff has shown that its marks have demonstrated a reasonable degree of recognition, the evidence is not sufficient to support a finding that the marks are famous and thus entitled to the extensive breadth of protection accorded a truly famous mark, particularly in light of the fact that Petitioner's OMAHA STEAKS marks are not inherently distinctive.

*Number and Nature of Third-Party Uses/Strength of Plead Mark*

Defendant, citing to *Juice Generation* and *Jack Wolfskin*, maintains that the “common term ‘OMAHA’ in the parties’ respective marks is such a weak formative that consumers will look to the many distinguishing features in the respective marks and would be unlikely to be confused as to source. Again, as previously discussed, “OMAHA” is, conceptually, somewhat weak as a source indicator because the word “OMAHA” is geographically descriptive of the location of a city. As a result, a mark comprising, in whole or in part, the word OMAHA for such goods and services is entitled to only a narrow scope of protection.

*Similarity of the Marks*

We now compare Plaintiff's OMAHA STEAKS ANGUS mark with Defendant's OMAHA NATURAL ANGUS mark shown below,



and compare them, as we must, in their entirety for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital v. Lion Capital* 110 USPQ2d at 1160 (quoting *Palm Bay. v. Veuve Clicquot*, 73 USPQ2d at 1691). When the goods are legally identical, as they are here, the degree of similarity between the marks necessary to support a determination that confusion is likely declines. *In re Viterra Inc.*, 101 USPQ2d at 1908.

Defendant contends that there is a “tremendous” visual difference between the appearances, in the entirety, of the two marks; its mark having five elements, including a distinctive and claimed multi-colored gold, yellow, red, black and gray shield design, and that such dissimilar appearances create dissimilar commercial impressions. Plaintiff, by comparison, contends that “the marks are so similar in appearance, with an identical ‘OMAHA’ and the prominence thereof in all of the marks, sound and overall commercial impression.”

As stated previously, it is not improper to give more weight to a dominant feature in determining the commercial impression created by a mark as long as the ultimate conclusion is based on the marks in their entirety. *See In re National Data Corp.*, 224 USPQ at 751. Further, with a composite mark comprising a design and words, it is the wording that would make a greater impression on purchasers and is the portion

that is more likely to be remembered as the source-signifying portion of a mark. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593 (TTAB 2001) (“words are normally accorded greater weight because they would be used by purchasers to request the goods”).

In this case, Defendant’s mark is dominated by the words OMAHA NATURAL ANGUS; they are the most prominent element of the mark, are visually larger than the text “CORN FED” and “MINIMALLY PROCESSED AND NO ARTIFICIAL INGREDIENTS,” and more distinct than the cow and shield designs. In addition, all of the literal elements have been disclaimed because they describe either the goods themselves or a feature thereof. The wording “CORN FED” and “MINIMALLY PROCESSED AND NO ARTIFICIAL INGREDIENTS” clearly describes how the beef was raised and is not source signifying, and therefore, not a dominant element. *See In re National Data Corp.*, 224 USPQ at 751 (“That a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of the mark.”). Moreover, we do not find the design sufficient to distinguish Defendant’s s mark from the pleaded mark. While noticeable, the depiction of the cow is smaller than the dominant wording OMAHA NATURAL ANGUS and merely serves to augment that wording. Similarly, the shield design, serves as a backdrop for the literal and cow design element, notwithstanding the coloration.

As acknowledged, Defendant has also included a disclaimer of the words OMAHA NATURAL ANGUS, but that does not remove those words from the mark

or reduce their visual dominance of the composite mark. The dominant portion of Defendant's mark is highly similar to the pleaded mark OMAHA STEAKS ANGUS – which also includes a disclaimer of the words STEAKS and ANGUS, in appearance, sound, connotation and commercial impression. In terms of appearance and sound, both marks begin with the word “Omaha” and end with the word “Angus.” The middle words, “Natural” and “Steaks,” respectively, do not distinguish the marks because they merely describe or are generic for the attendant goods. In addition, because the pleaded mark is registered in typed or standard characters, it may be presented in any style, regardless of font, size, or color. *See In re Viterra Inc.*, 101 USPQ2d at 1909. Therefore, Plaintiff's mark could be displayed in lettering resembling that of the Defendant's mark. Defendant essentially argues that its mark is not capable of causing confusion because the term “OMAHA” is in common usage. While we have found that the pleaded mark is entitled to a more narrow scope of protection due to the geographic significance of OMAHA, we do not find any element of Defendant's mark that is sufficient to distinguish it from Plaintiff's mark.

Even weak marks are entitled to protection. *See Matsushita Electric Company v. National Steel Co.*, 442 F.2d 1383, 170 USPQ 98, 99 (CCPA 1971) (“Even though a mark may be ‘weak’ in the sense of being a common word in common use as a trademark, it is entitled to be protected sufficiently to prevent confusion from source arising”). At issue here are very similar marks in light of the shared, common dominant words, “Omaha” and “Angus,” for legally identical goods. Under these

circumstances, the mere weakness of the term “OMAHA” does not obviate a likelihood of confusion.

As noted previously, the dominant, albeit disclaimed, portion of Defendant’s mark is highly similar to the pleaded mark in appearance, sound, connotation and overall commercial impression. While we have not overlooked the design element or Defendant’s arguments regarding the weakness of the term OMAHA, we nonetheless conclude that the marks, when considered in their entirety, are substantially similar due to the shared terms OMAHA and ANGUS. Thus, the factor of the similarity of the marks favors a finding of likelihood of confusion.

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. As explained, it is not necessary to show actual confusion in order to establish likelihood of confusion. *Herbko Int’l Inc. v. Kappa Books Inc.*, 64 USPQ2d at 1380. Accordingly, this factor is neutral.

Bad Faith Adoption

Under the thirteenth *du Pont* factor, evidence of an applicant’s bad faith adoption of his mark is relevant to our likelihood of confusion analysis. *L.C. Licensing Inc. v. Berman*, 86 USPQ2d at 1890. In this case, there is no evidence of record of any intent by Defendant to trade on the goodwill of Plaintiff. Accordingly, this *du Pont* factor is neutral.

Conclusion

When we consider the record, the relevant likelihood of confusion factors, and all of the arguments and evidence relating thereto, including those arguments and evidence not specifically addressed in this decision, we conclude that because the parties' respective marks are very similar, the goods legally identical and presumed to move in the same channels of trade and be sold to the same classes of consumers, Defendant's mark OMAHA NATURAL ANGUS and design for "angus beef" is likely to cause confusion with Plaintiff's OMAHA STEAKS ANGUS mark for "fresh and frozen boxed steaks, and fresh and frozen cuts of meat." We find so notwithstanding any weakness attributed to Plaintiff's OMAHA STEAKS ANGUS mark.

Laches

This brings us at last to consider Defendant's affirmative defense of laches. In order to prevail on the affirmative defense of laches, a defendant must establish that there was undue or unreasonable delay by the plaintiff in asserting its rights, and material prejudice as a result of the delay. *See Bridgestone/Firestone Research Inc. v. Automobile Club de l'Ouest de la France*, 245 F.3d 1359, 58 USPQ2d 1460, 1462 (Fed. Cir. 2001); *Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes, Inc.* 971 F.2d 732, 23 USPQ 1701, 1703 (Fed. Cir. 1991).

As regards the undue delay, Defendant noted that Defendant's trademark application that matured into the involved registration was published for opposition on August 24, 2010 and Plaintiff filed its petition for cancellation on June 26, 2014. Thus, Plaintiff's delay in filing was slightly more than three years and ten months. During that period, Plaintiff has been purchasing and receiving Angus beef in

shipping boxes bearing the Defendant's mark and, in fact, has been purchasing beef in boxes bearing the OMAHA NATURAL ANGUS mark since 2006 – a period of eight years. Plaintiff never communicated with anyone connected to Defendant to object to Defendant's use of the mark, before filing the petition for cancellation. Thus, Petitioner had actual knowledge of Defendant's use of the mark for approximately eight years prior to filing the petition for cancellation.

As to the additional element of material prejudice required to establish laches, Defendant contends that Plaintiff's unexplained silence and undue and unreasonable delay in filing the petition would directly result in economic prejudice to Defendant, if the cancellation were granted. Defendant's president testified that Defendant continuously increased and expanded its investment in Defendant's plant and promoted the OMAHA NATURAL ANGUS logo. Such increased investment added to the injury.

Plaintiff responds that "because the parties historically never competed with each other, and because of the principal's personal friendship, there was never a reason to object to this mark. Only upon Defendant's entry into a new market – Omaha Steaks' territory -- did need arise."

1. Was There an Unreasonable Delay?

The first step in this inquiry is to determine the date from which laches begins to run. As the Board stated in *Ava Ruha Corp. v. Mother's Nutritional Ctr., Inc.*, 113 USPQ2d 1575, 1580 (TTAB 2015):

A petitioner must be shown to have had actual knowledge or constructive notice of a registrant's trademark use to

establish a date of notice from which delay can be measured. *Loma Linda Food Co. v. Thomson & Taylor Spice Co.*, 279 F.2d 522, 126 USPQ 261, 263 (CCPA 1960); *Jansen Enters. Inc. v. Rind*, 85 USPQ2d 1104, 1114 (TTAB 2007); *Teledyne Tech., Inc. v. Western Skyways, Inc.*, 78 USPQ2d 1203, 1210 (TTAB), *aff'd*, 208 F. App'x 886 (Fed. Cir. Dec. 6, 2006). "In the absence of actual knowledge [of trademark use] prior to the close of the opposition period, the date of registration is the operative date for laches," as it provides constructive notice to petitioner of the registrant's claim of ownership. *Teledyne*, 78 USPQ2d at 1210, n.10 and the authorities cited therein; *see also Jansen Enterprises*, 85 USPQ2d at 1114 (publication in *Official Gazette* does not provide constructive notice). If there is actual knowledge of a defendant and its mark prior to publication for opposition, the date of publication is the operative date for laches. *National Cable Tel. Ass'n*, 937 F.2d 1572, 19 USPQ2d at 1432 ("in this case laches, with respect to protesting the issuance of the registration for the mark, could not possibly start to run prior to October 16, 1984, when Cable's application for registration was published for opposition"). Thus, in a cancellation proceeding, laches begins to run no earlier than the date the involved mark was published for opposition (if there was actual knowledge), and no later than the issue date of the registration (when Plaintiff is put on constructive notice, *see* 15 U.S.C. § 1072).

In this case, the petition for cancellation was filed on June 26, 2014. The earliest date for determining undue delay is August 24, 2010, the date of publication of the underlying application. Plaintiff did not dispute Defendant's claim that it had actual knowledge of the trademark at issue as of 2006, when Defendant commenced shipping meat to Plaintiff in boxes bearing the OMAHA NATURAL ANGUS logo, and further testified that it had purchased and continues to purchase beef from Defendant since that time. Accordingly, laches began to run as of the publication date of the underlying application and we calculate the length of the delay at around three years and ten months. While this is not an extremely long delay, shorter time periods have

supported a laches defense. *See, e.g., Teledyne*, 78 USPQ2d at 1203 (3 years, 8 months of unexplained delay held sufficient for laches); *Trans Union Corp. v. Trans Leasing Int'l, Inc.*, 200 USPQ 748, 756 (TTAB 1978) (finding laches based on a two and half year period of delay).

Having determined that the delay supports a laches defense, we address whether the delay was reasonable. In this regard, Plaintiff argues the doctrine of progressive encroachment, namely that Plaintiff had no reason to seek cancellation until Defendant moved into Plaintiff's market space.

## 2. Doctrine of Progressive Encroachment

The doctrine of progressive encroachment “focuses the court’s attention on the question of whether the defendant, after beginning its use of the mark, redirected its business so that it more squarely competed with plaintiff and thereby increased the likelihood of public confusion of the marks.” *Jansen Enterprises*, 85 USPQ2d at 1116 (quoting *ProFitness Physical Therapy Center v. Pro-Fit Orthopedic and Sports Physical Therapy P.C.*, 314 F.3d 62, 65 USPQ2d 1195, 1199-1200 (2d Cir. 2002)). For example, “where a defendant begins use of a trademark or trade dress in the market, and then directs its marketing or manufacturing efforts such that it is placed more squarely in competition with the plaintiff, the plaintiff's delay is excused.” *Chattanooga Mfg., Inc. v. Nike Inc.*, 301 F.3d 789, 64 USPQ2d 1140, 1143 (7th Cir. 2002).

As evidence of encroachment, Mr. Bruce Simon testified as follows:<sup>67</sup>

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<sup>67</sup> 33 TTABVUE 45-46.

Q. Yes. So given your friendship with Henry [Davis] and your high opinion of his plant, why did you initiate -- why did you direct my law firm to initiate this proceeding?

A. Because a trademark is a trademark, and we have to defend our trademarks. There's just no ifs, ands, or buts about it. ...

...

A. ... Look, if there was any other way to settle this -- we suggested, what do you call it, the common use, the shared --

Q. Co-existence?

A. Co-existence. You know, if Henry would have agreed -- Henry is not in our business. He doesn't do -- traditionally he hadn't been in the steak cutting business. I understand he is now. As long as he sticks to food service, that's just fine. But when he moves into the direct-to-consumer business, we're going to have defend our trademark. ...

In addition, the record reveals that prior to January 1, 2015, Defendant had not sold any beef products, including those ready to be cooked and eaten by the purchaser, directly to nonemployee members of the general public or through retail stores owned or operated by it. (Fili test. p. 72).<sup>68</sup> However, over Christmas of 2015, Defendant began offering for sale a product to individual customers that is intended for them to cook and eat. (Id. at 91).<sup>69</sup> While Defendant has a 10,000 pound minimum purchase requirement with its "normal" customers, no such requirement was made

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<sup>68</sup> 39 TTABVUE 73.

<sup>69</sup> Id. at 92.

for the Christmas offering. The target market for those sales was “[j]ust regular customers that are looking for a product.” (*Id.* at 93).<sup>70</sup>

We also note the testimony of Henry Davis, who indicated that expansion into the retail market was possible. Mr. Davis specifically testified that:<sup>71</sup>

Q. Is Greater Omaha Packing currently selling any product in the retail market?

A. Yes.

Q. Tell me about that, please.

A. We sell to grocery stores.

Q. Do you have plans for the future to enter into that type of market?

A. Well, we’re in the retail market. We sell to grocery stores.

Q. And, I’m sorry, I’ll define – just for my purposes of my question – retail market: A person such as myself being able to purchase steaks directly from you in small quantities.

A. Not directly here at this point, no.

Q. Do you have current plans to enter into that market in the near future?

A. We consider markets all the time.

Q. But I didn’t ask what you considered I asked if you had plans.

A. That means, that means the same thing to me.

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<sup>70</sup> *Id.* at 94.

<sup>71</sup> 43 TTABVUE 79-81.

Q. Do you have a written business plan for entering into perhaps having an online presence to sell to individual consumers?

A. We don't have a written business plan for that that I am aware of.

We find this testimony sufficient to show that Defendant is, at a minimum, contemplating a redirection of its traditional wholesale business into the "individual" retail market space, the market traditionally held by Plaintiff. As such, Plaintiff's delay in commencing this proceeding is excused, and the equitable defense of laches does not apply in this case.

Finally, even if Defendant had established laches, which it did not, if confusion is inevitable, then the defense of laches is not applicable under any circumstances. *Ultra-White Co., Inc. v. Johnson Chemical Industries, Inc.*, 465 F.2d 891, 175 USPQ 166 (CCPA 1972); *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1131 (TTAB 1990) ("It is not necessary to discuss this theory because it is well established that equitable defenses such as laches will not be considered and applied where, as here, the marks of the parties are identical and the goods are the same or essentially the same."). This is so because any injury to Defendant caused by Petitioner's delay is outweighed by the public's interest in preventing confusion in the marketplace. *Turner v. Hops Grill & Bar, Inc.*, 52 USPQ 1310, 1313 (TTAB 1999), citing *Coach House Restaurant Inc. v. Coach and Six Restaurants, Inc.*, 934 F.2d 1551, 19 USPQ 1401, 1409 (11<sup>th</sup> Cir. 1991). In the present case, the record clearly establishes inevitable confusion. That is, the marks are substantially similar and the goods are legally identical.

**Cancellation No. 92059629 (OMAHA HEREFORD)**

With respect to this Cancellation, the parties focused their arguments on Plaintiff's pleaded Registration No. 3774260 for the mark OMAHA STEAKS for "meat."

*The Goods/Channels of Trade/Classes of Purchasers*

We begin with the goods, channels of trade and classes of purchasers. We must make our determinations under these factors based on the goods as they are recited in the respective registrations. *Octocom Systems v. Houston Computers* 16 USPQ2d at 1787 ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed."); *In re Elbaum*, 211 USPQ at 640.

Where the goods in the registration are broadly described, 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, id.*

As identified, Plaintiff's broadly worded "meat" encompasses Defendant's more narrowly identified "hereford beef." Thus, for purposes of our likelihood of confusion analysis, we find the respective goods legally identical.

We are unpersuaded by Defendant's essential contention that the goods are only somewhat related because they are not identical. The respective goods need not be identical or directly competitive in order for there to be a likelihood of confusion. Rather, they need only be related in some manner or the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d at 1785.

Because the goods are legally identical and because there are no limitations as to channels of trade or classes of purchasers in the registrations, we must presume that the parties' meat will be sold in the same channels of trade and will be bought by the same classes of purchasers. *In re Viterra Inc.*, 101 USPQ2d at 1908 (the Board was entitled to rely on this legal presumption in determining likelihood of confusion). *See also Hewlett-Packard Co. v. Packard Press Inc.*, 62 USPQ2d at 1005; *Genesco Inc. v. Martz*, 66 USPQ2d at 1268. In view of the above, the *du Pont* factors of the similarity of the goods, the channels of trade, and classes of purchasers strongly favor a finding of likelihood of confusion.

Conditions of Sale

Again, Defendant maintains that both parties' customers are likely to exercise care in their decisions to purchase relatively expensive goods. For the reasons stated earlier in this decision, 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 Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014) (quoting *Octocom Sys., Inc. v. Houston Computers Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

*Fame*

Defendant contends that Plaintiff has failed to submit sufficient evidence to establish fame and, that instead of being famous, Plaintiff’s marks are extremely weak and entitled to only the narrowest scope of protection. As we found earlier in this opinion, while Plaintiff has shown that its marks have demonstrated a reasonable degree of recognition, the evidence is not sufficient to support a finding that the marks are famous and thus entitled to the extensive breadth of protection accorded a truly famous mark, particularly in light of the fact that Petitioner’s OMAHA STEAKS marks are not inherently distinctive.

*Number and Nature of Third-Party Uses/Strength of Pleaded Mark*

Defendant, citing to *Juice Generation* and *Jack Wolfskin*, maintains that the “common term ‘OMAHA’ in the parties’ respective marks is such a weak formative that consumers will look to the many distinguishing features in the respective marks and would be unlikely to be confused as to source. As discussed earlier in this opinion, “OMAHA” is, conceptually, somewhat weak as a source indicator because the word “OMAHA” is geographically descriptive of the location of a city. As a result, a mark comprising, in whole or in part, the word OMAHA for such goods and services is entitled to only a narrow scope of protection.

Similarity of the Marks

We now compare Plaintiff's OMAHA STEAKS mark with Defendant's OMAHA HERFORD mark shown below,



and compare them, as we must, in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital v. Lion Capital* 110 USPQ2d at 1160 (quoting *Palm Bay. v. Veuve Clicquot*, 73 USPQ2d at 1691). When the goods are legally identical, as they are here, the degree of similarity between the marks necessary to support a determination that confusion is likely declines. *In re Viterra Inc.*, 101 USPQ2d at 1908. We also take into account our finding that Plaintiff's mark is only entitled to a narrow scope of protection.

Defendant contends that there is a "tremendous" visual difference between the appearances, in the entireties, of the two marks; its mark having five elements, including a distinctive and claimed multi-colored design, and that such dissimilar appearances create dissimilar commercial impressions. Plaintiff, by comparison, contends that "the marks are so similar in appearance, with an identical 'OMAHA' and the prominence thereof in all of the marks, sound and overall commercial impression."

As stated previously, it is not improper to give more weight to a dominant feature in determining the commercial impression created by a mark as long as the ultimate conclusion is based on the marks in their entirety. *See In re National Data Corp.*, 224 USPQ at 751. Further, with a composite mark comprising a design and words, it is the wording that would make a greater impression on purchasers and is the portion that is more likely to be remembered as the source-signifying portion of a mark. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d at 1593 (“words are normally accorded greater weight because they would be used by purchasers to request the goods”).

In this case, Defendant’s mark is dominated visually by the words OMAHA HEREFORD; they are the most prominent elements of the mark, are visually larger than the text “U.S.BEEF,” “1881” and “CORN FED” and the steer profile design. In addition, all of the literal elements have been disclaimed because they describe either the goods themselves or a feature thereof. The wording “CORN FED” clearly describes how the beef was raised; “U.S.BEEF” describes the goods themselves; and “1881”<sup>72</sup> represents an unknown date. As such, these elements are not source identifying, and therefore, none are dominant elements. *See In re National Data Corp.*, 224 USPQ at 751 (“That a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of the mark.”). Moreover, we do not find the design sufficient

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<sup>72</sup> “1881” has also been disclaimed notwithstanding Defendant’s contention that it is an arbitrary date.

to distinguish Defendant's mark from the pleaded mark. While clearly noticeable, the depiction blends into the wording and background, and serves to reinforce the words OMAHA HEREFORD. Similarly, the "oval border outline, coloration notwithstanding, merely frames the mark's elements.

As acknowledged, Defendant also has included a disclaimer of the words OMAHA HEREFORD, but that does not remove those words from the mark or reduce their visual dominance of the composite mark. OMAHA dominates the visually dominant portion of Defendant's mark because "Hereford" is generic for the identified goods. Similarly, OMAHA dominates the pleaded OMAHA STEAKS mark because "Steaks" is generic, and has been disclaimed, for Plaintiff's identified goods. In terms of appearance and sound, the dominant portion of both marks are identical. In addition, because the pleaded mark is registered in typed or standard characters, it may be presented in any style, regardless of font, size, or color. *See In re Viterra Inc.*, 101 USPQ2d at 1909 (Fed. Cir. 2012). Therefore, Plaintiff's mark could be displayed in lettering resembling that of the Defendant's mark. Defendant essentially argues that its mark is not capable of causing confusion because the term "OMAHA" is in common usage. While we have found that the pleaded mark is entitled to a more narrow scope of protection due to the geographic nature of the term OMAHA, we do not find any element of Defendant's mark that is sufficient to distinguish it from Plaintiff's mark.

Even weak marks are entitled to protection. *See Matsushita Electric Company v. National Steel Co.*, 170 USPQ at 99 ("Even though a mark may be 'weak' in the

sense of being a common word in common use as a trademark, it is entitled to be protected sufficiently to prevent confusion from source arising”). At issue here are very similar marks in light of the shared, identical dominant words for legally identical goods. Under these circumstances, the mere weakness of the word “OMAHA” does not obviate a likelihood of confusion.

While we have not overlooked the additional wording, the design element or Defendant’s arguments regarding the weakness of the term OMAHA, we nonetheless conclude that the marks, when considered in their entirety, are substantially similar in appearance, sound, connotation and commercial impression due to the shared term OMAHA. Thus, the factor of the similarity of the marks favors a finding of likelihood of confusion.

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. As explained, it is not necessary to show actual confusion in order to establish likelihood of confusion. *Herbko Int’l Inc. v. Kappa Books Inc.*, 64 USPQ2d at 1380. Accordingly, this factor is neutral.

Bad Faith Adoption

Under the thirteenth *du Pont* factor, evidence of an applicant’s bad faith adoption of his mark is relevant to our likelihood of confusion analysis. *L.C. Licensing Inc. v. Berman*, 86 USPQ2d at 1890. In this case, there is no evidence of record of any

Opposition No. 91213527; Cancellation Nos. 92059629 and 92059455

intent by Defendant to trade on the goodwill of Plaintiff. Accordingly, this *du Pont* factor is neutral.

Conclusion

When we consider the record, the relevant likelihood of confusion factors, and all of the arguments and evidence relating thereto, including those arguments and evidence not specifically addressed in this decision, we conclude that because the parties' respective marks are very similar, the goods legally identical and presumed to move in the same channels of trade and be sold to the same classes of consumers, Defendant's mark OMAHA HEREFORD and design for "hereford beef" is likely to cause confusion with Plaintiff's OMAHA STEAKS mark for "meat."

**Decision:**

Opposition No. 91213527 is dismissed and application Serial No. 85897951 will issue.

Cancellation No. 92059629 is sustained and Registration No. 4006768 will be cancelled in due course.

Cancellation No. 92059455 is sustained Registration No. 3998763 will be cancelled in due course.