

**THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB**

Hearing:  
February 23, 2007

Mailed:  
November 21, 2007

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**  
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Hormel Foods Corporation and Hormel Foods, LLC

v.

Spam Arrest, LLC  
\_\_\_\_\_

Cancellation No.92042134  
\_\_\_\_\_

Allen W. Hinderaker and William D. Shultz of Merchant & Gould P.C. for Hormel Foods Corporation and Hormel Foods, LLC.

Derek A. Newman and Randall Moeller of Newman & Newman, Attorneys at Law, LLP for Spam Arrest, LLC.  
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Before Sams, Seeherman and Rogers, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Hormel Foods Corporation and Hormel Foods, LLC (hereafter collectively referred to as "petitioner") have petitioned to cancel the registration of Spam Arrest, LLC for SPAM ARREST, with the word SPAM disclaimed, for "computer software, namely software designed to eliminate

unsolicited commercial electronic mail.”<sup>1</sup> Petitioner has brought this action on the grounds of likelihood of confusion and dilution.<sup>2</sup> Specifically, petitioner has alleged that petitioner is the owner of the registered trademark SPAM and a family of SPAM trademarks; that petitioner has used the trademark SPAM for more than sixty years for a canned meat product and has expanded its use of the mark over the years to include a variety of goods and services; that petitioner has registered SPAM for items such as processed meats, wearing apparel, hand kitchen slicers, jewelry, playing cards, pens, mugs, tennis balls and toys and the service of participating in automobile races; that petitioner owns a SPAM family of marks; that petitioner uses SPAM with a variety of goods and services including clocks, knives, recipe books, mouse pads and entertainment celebrations; that petitioner has used SPAM and its SPAM family of marks since prior to applicant’s claimed date of first use of August 24, 2002; that petitioner’s SPAM mark is famous; that respondent’s SPAM ARREST mark so resembles petitioner’s SPAM mark and its family of SPAM marks as to be

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<sup>1</sup> Registration No. 2701493, issued March 25, 2003, based on an intent-to-use application that was filed on November 27, 2001.

<sup>2</sup> The petition also recited an alternative ground of mere descriptiveness or genericness, but petitioner stated in its trial brief, at footnote 1, that it “is not advancing the mere descriptiveness claim.” Although petitioner also states that it “chooses to prosecute this cancellation on the grounds of likely confusion and likely dilution without prejudice to its claim of mere descriptiveness,” we treat petitioner’s failure to prosecute this ground as a waiver of it.

likely, when applied to respondent's goods, to cause confusion or mistake or to deceive; and that respondent's SPAM ARREST mark dilutes the distinctive quality of petitioner's previously used and registered mark SPAM and its family of SPAM marks.

In answer to the petition, respondent has admitted the averments of paragraphs 3 and 6 of the petition for cancellation, which read as follows:

3. Hormel Foods is also the owner of trademark registrations for marks that are derivative of the SPAM trademark, making up the SPAM family of marks. These marks include SPAMARAMA for entertainment services, Registration No. 2059462; SPAMBURGER for processed meat, Registration No. 1819104; SPAM JAM for entertainment services in the nature of an annual festival featuring a variety of activities, namely exhibitions, cooking and other contests, and music, Registration No. 2561571; and SPAMTASTIC for mail order catalog services in the field of clothing, footwear, headwear, jewelry, home, kitchen, sporting goods, paper goods and printed matter, and children's toys, Registration No. 2478066;

6. Applicant's SPAM ARREST mark is composed of Petitioners' entire SPAM mark with the term "arrest" immediately following Petitioners' mark.

Respondent has also admitted that petitioner is the owner "of the registered trademark SPAM and the family of SPAM trademarks, that the United States Registrations include Nos. 775187, 1338031, 1415969, 1298745, 1505620, 1716102, 1985602, 2057484, 2373313 and 2639240"; and that petitioner

has a website at www.spam.com. Respondent has otherwise denied the salient allegations of the petition for cancellation. Respondent has also asserted as affirmative defenses amplifications of its denial of likelihood of confusion; that "spam," when used in connection with unsolicited commercial email, is generic; and acquiescence and estoppel. Specifically, respondent alleges that petitioner has acquiesced in respondent's and others' use of the term "spam" with respect to unsolicited commercial email by posting statements on its website and through its representatives to the effect that petitioner does not object to use of the term "spam" to describe unsolicited commercial email; that respondent has detrimentally relied on such statements; and that petitioner should be equitably estopped from asserting trademark or service mark rights in the term "spam" with respect to unsolicited commercial emails and any related products and services.

**Procedural Issues**

In its trial brief petitioner asserts that respondent's affirmative defenses should be stricken. However, the basis of petitioner's position with respect to respondent's defense of acquiescence and estoppel is that the defense should fail for lack of proof, not that the defense should be stricken because it is not a valid defense. The Board

does not strike an affirmative defense solely for lack of sufficient support.

As for the affirmative defense that SPAM is a generic term, petitioner argues that a pleading of genericness is merely a pleading that third parties use a term, and that third-party use does not establish an affirmative defense.<sup>3</sup> However, respondent is not asserting that others use SPAM as a mark, but that the term is generic. Thus, respondent is not asserting that petitioner has failed to object to third parties' use of marks containing the word SPAM, which might be viewed as an assertion that petitioner's mark is entitled to a limited scope of protection. Nor is respondent asserting that petitioner's mark is generic, which of course would have to be asserted as a counterclaim, only that "spam" has a generic meaning. The evidence petitioner itself submitted, as well as the testimony of its own witnesses, shows that "spam" means unsolicited commercial email, so it would appear that petitioner is objecting to the form, rather than the substance, of respondent's defense. Even if this defense does not fit into the

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<sup>3</sup> Petitioner relies on three non-precedential Board decisions. Prior to January 23, 2007, the Board's policy had been that decisions which were not designated as "citable as precedent" were not citable authority. See *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1275 n. 9 (TTAB 1992). On January 23, 2007, a notice in the Official Gazette stated that henceforth the Board would permit citation to any TTAB disposition, although a decision designated as not precedential is not binding upon the TTAB.

category of a true affirmative defense, it serves to put petitioner on notice as to why respondent believes there is no likelihood of confusion and dilution, and is thus an amplification of respondent's denial of the claims. The Board does not strike such amplifications.

Accordingly, we do not strike either of these asserted defenses.

With respect to the pleaded ground of dilution, we note that petitioner's claim fails to assert that petitioner's mark became famous prior to the filing date of the application which subsequently resulted in issuance of the registration that is the subject of this proceeding. However, because respondent has not raised an objection to this omission, but has substantively argued the ground of dilution, and because petitioner has submitted evidence as to the fame of its mark prior to respondent's filing date, we deem the pleadings to be amended to include such an allegation. See Fed. R. Civ. Proc. 15(b). In addition, petitioner did not plead ownership of Registration No. 3022539 for SPAM for "downloadable software, namely screen savers," because this registration had not issued at the time the petition for cancellation was filed. However, petitioner made the application of record with its notice of reliance filed August 29, 2005, and submitted a printout of

information for the registration taken from the USPTO TARR<sup>4</sup> database with its supplemental notice of reliance filed on December 14, 2005. Respondent has treated this registration as being of record, and has discussed the effect of petitioner's use of the mark for such goods. Accordingly, we deem the petition for cancellation to be amended pursuant to Fed. R. Civ. Proc. 15(b) to include this registration.

As noted above, petitioner, in submitting a copy of Registration No. 3022539, did not submit a copy of the registration prepared and issued by the USPTO showing current status of and current title to the registration, but submitted a printout from the TARR database. Although Rule 2.122(d)(1) of the Trademark Rules was amended, effective August 31, 2007, to allow a plaintiff to make its registrations of record by submitting a "current printout of information from the electronic database records of the USPTO showing the current status and title of the registration," trial and briefing in this proceeding was completed prior to that date. Accordingly, the amended rule is not applicable, since it does not have retroactive effect. However, respondent has treated not only this registration, but all the materials submitted by petitioner as being of record ("depositions and exhibits described by

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<sup>4</sup> TARR stands for Trademark Applications and Registrations Retrieval.

Petitioners Hormel Foods Corporation and Hormel Foods, LLC... in Petitioners' Trial Brief ... at 9-10"). Respondent's brief, p. 10. These pages of petitioner's trial brief list all of the materials submitted with petitioner's notices of reliance, including materials that would normally not be considered acceptable for submission by notice of reliance.<sup>5</sup> As a result, we deem all of the materials submitted by petitioner to be stipulated into the record.

During the course of the testimony depositions each party raised various objections and/or motions to strike the testimony and exhibits of the other's witnesses. Because

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<sup>5</sup> It appears that petitioner treated its notice of reliance as a vehicle for advising the Board and respondent as to all evidence on which it would rely in support of its case. For example, petitioner stated at paragraph 27 that it had taken or planned to take the testimony depositions of several individuals, but did not submit them with the notice. Indeed, the notice of reliance was signed and filed on August 29, 2005, although the testimony deposition of Ellen Kohl did not take place until August 30, 2005. Petitioner also submitted a copy of the file of respondent's registration, although such material is automatically of record pursuant to Trademark Rule 2.122(b). Many of the exhibits petitioner submitted with its notice of reliance were duplicate copies of exhibits that were made of record during the various testimony depositions, with petitioner explaining that "Exhibits 1-212 were the subject of Petitioner's testimony depositions. The exhibits set forth in this Notice of Reliance are offered for the independent basis set forth in each paragraph." p. 1, n. 1. However, once an exhibit is properly made of record, it may be referred to or relied on by any party to a proceeding for any purpose without further action, and it was therefore unnecessary for petitioner to submit duplicate filings.

In addition, we note that petitioner sometimes marked the same exhibits with more than one number, essentially introducing a single exhibit twice during the course of two depositions but with different numbers (although in other depositions, previously marked exhibits were referred to by the number under which they were originally introduced). The Board frowns on the submission of duplicate exhibits and petitioner has wrongly burdened the Board by not taking care to avoid duplications in the record.

these objections were not maintained in the parties' trial briefs (with the exception of two motions to strike which the Board decided in its order of January 12, 2007<sup>6</sup>), the objections have been deemed to be waived. However, the Board has still considered the probative value of the testimony and exhibits in making its decision herein. For example, although books and newspaper articles are of record, they are not competent to prove the truth of the statements made in those publications. See authorities collected in Section 704.08 of the Trademark Trial and Appeal Board Manual of Procedure (TBMP) (2d ed. rev. 2004). Thus, we have considered these materials only to show public exposure to the statements, unless witnesses have testified as to the truth of particular statements.

We have also given very limited probative value to the testimony of Ivan Ross, an expert witness who gave his opinion as to the fame of the mark SPAM. Much of the basis for his opinion is not of record herein. For example, he testified that he relied on the declaration of Nicholas Meyer (test. p. 22) in forming his opinion. Although Dr. Ross identified the declaration as an exhibit to his

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<sup>6</sup> The parties cross-moved to strike or exclude testimony and exhibits relative to a survey conducted by petitioner and the responsive testimony and report offered by respondent. The Board denied the motions, but stated that the probative value to be accorded to such evidence would be considered at final hearing. We do so infra.

testimony, no one in a position to know the facts recited in the declaration ever testified during the testimony period that the statements in the declaration were true and continued to be true. Compare, *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993) (declaration of witness submitted in connection with summary judgment motion was part of record for trial where witness identified and attested to accuracy of it during testimony period). More importantly, although Dr. Ross stated, at p. 20 of his deposition, that he was not "expressing a legal opinion," it is clear that his opinion as to the fame of petitioner's mark was in the context of trademark law. He referenced trademark cases and trademark treatises, and stated that he was adopting "the concept or the construct of fame as I understand it being utilized in trademark parlance." The determination of whether a mark is famous in terms of trademark law and concepts is something that is within the province of the courts and the Board to decide, and we decline to adopt or give probative weight to what is, in effect, a legal conclusion by an "expert" on such an issue.

**The Record**

The record consists of the testimony and exhibits and other material listed at pages 9 and 10 of petitioner's

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trial brief and pages 9 and 10 of respondent's trial brief. In particular, it includes the pleadings; the file of the registration sought to be cancelled; the testimony depositions, with exhibits, of opposer's witnesses George Mantis, Shawn Radford, Ivan Ross, Gregory Carpenter, Nicholas Meyer, Jeffrey Grev, Lance Pogones, Ellen Kohl and Kevin Jones (including Mr. Jones's rebuttal testimony deposition), and of respondent's witnesses Brian Cartmell and Lea Knight; printed publications; third-party registrations and third-party application files; each party's responses to the other's discovery requests, including responses made by the parties in an opposition brought by petitioner against respondent's application for SPAM ARREST for services;<sup>7</sup> transcripts of discovery depositions; and petitioner's registrations<sup>8</sup> for SPAM for deviled luncheon meat spread;<sup>9</sup> t-shirts;<sup>10</sup> caps;<sup>11</sup> wearing apparel;<sup>12</sup> kitchen hand tools, namely slicers;<sup>13</sup> processed

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<sup>7</sup> This opposition proceeding, No. 91153159, was suspended on September 30, 2003, upon stipulated motion of the parties, pending a determination in the present cancellation proceeding.

<sup>8</sup> These registrations are all owned by petitioner Hormel Foods LLC.

<sup>9</sup> Registration No. 755187, issued August 20, 1963; Section 8 & 15 affidavits accepted and acknowledged; renewed twice.

<sup>10</sup> Registration No. 1338031, issued May 28, 1985; Section 8 & 15 affidavits accepted and acknowledged; renewed.

<sup>11</sup> Registration No. 1415969, issued November 14, 1986; Section 8 & 15 affidavits accepted and acknowledged; renewed.

<sup>12</sup> Registration No. 1498745, issued August 2, 1988; Section 8 & 15 affidavits accepted and acknowledged.

<sup>13</sup> Registration No. 1505620, issued September 27, 1988; Section 8 & 15 affidavits accepted and acknowledged.

meat;<sup>14</sup> magnets, jewelry, namely watch, necklace, earrings and tie tack, playing cards, pencils, pens, and note cube, mug and insulated beverage containers;<sup>15</sup> entertainment services, namely participating in automobile races;<sup>16</sup> poultry;<sup>17</sup> retail gift shop services and educational and entertainment services, namely providing museum services featuring exhibits, memorabilia, and various multimedia presentations;<sup>18</sup> and downloadable software, namely screen savers;<sup>19</sup> and for SPAMBURGER for processed meat;<sup>20</sup> SPAMARAMA for entertainment services in the nature of an annual festival featuring a variety of activities, namely,

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<sup>14</sup> Registration No. 1716102, issued September 15, 1992; Section 8 & 15 affidavits accepted and acknowledged; renewed.

<sup>15</sup> Registration No. 1985602, issued July 9, 1996; Section 8 & 15 affidavits accepted and acknowledged; renewed. The status and title copy was furnished by the USPTO in June 2005, during petitioner's testimony period and prior to the renewal of the registration. In accordance with Board policy, we have confirmed that Office records reflect the renewal of the registration. See TBMP §704.03(b)(1)(A) (2d ed. rev. 2004) and cases cited at footnote 142. In checking the status of the registration, we have also confirmed that Section 8 & 15 affidavits were accepted and acknowledged, respectively, although this information inexplicably does not appear on the copy of the registration prepared by the USPTO.

<sup>16</sup> Registration No. 2057484, issued April 29, 1997; Section 8 & 15 affidavits accepted and acknowledged; renewed. The status and title copy was furnished by the USPTO in June 2005, during petitioner's testimony period and prior to the renewal of the registration. We have confirmed that Office records reflect the renewal of the registration.

<sup>17</sup> Registration No. 2373313, issued August 1, 2000; Section 8 & 15 affidavits accepted and acknowledged.

<sup>18</sup> Registration No. 2639240, issued October 22, 2002.

<sup>19</sup> Registration No. 3022539, issued December 6, 2005.

<sup>20</sup> Registration No. 1819104, issued February 1, 1994; Section 8 & 15 affidavits accepted and acknowledged; renewed.

exhibitions, cooking and other contests, and music;<sup>21</sup> SPAMTASTIC for mail order catalog services in the field of clothing, footwear, headwear, jewelry, home, kitchen, sporting goods, paper goods and printed matter, and children's toys;<sup>22</sup> and SPAM JAM for entertainment services in the nature of an annual festival featuring a variety of activities, namely exhibitions, cooking and other contests, and music.<sup>23</sup>

It is noted that the discovery depositions of Nicholas Meyer and Kevin Jones that were submitted by respondent bear a statement that they are "confidential," although they were not in fact filed under seal. The Board has treated these depositions as being confidential for the present, but because it is the general policy of the Board that all papers in proceedings be public, the parties are allowed thirty days in which to submit redacted versions of these depositions, failing which they will be treated as part of the public record. We also note that portions of the

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<sup>21</sup> Registration No. 2059462, issued May 6, 1997; Section 8 & 15 affidavits accepted and acknowledged; renewed. The status and title copy was furnished by the USPTO in June 2005, during petitioner's testimony period and prior to the renewal of the registration. We have confirmed that Office records reflect the renewal of the registration.

<sup>22</sup> Registration No. 2478066, issued August 14, 2001; Section 8 & 15 affidavits accepted and acknowledged. The status and title copy was furnished by the USPTO in June 2005, during petitioner's testimony period and prior to the filing of the Section 8 and 15 affidavits. We have confirmed that Office records reflect the filing of these affidavits.

<sup>23</sup> Registration No. 2561571, issued April 16, 2002.

testimony depositions and certain exhibits identified therein were submitted under seal, although some of the information contained in the so-called confidential materials could not, in fact, reasonably be characterized as confidential. For example, in the deposition of Nicholas Meyer the number of cans of SPAM meat that have been sold has been redacted, although there is a public "counter" displaying this number at the Spam Museum. To the extent that information that has been marked as "confidential" is necessary for us to discuss in our opinion, we have done so, although we have tried to be sensitive about not revealing truly confidential information. However, the survey conducted by George Mantis, and which was submitted under seal, is the basis for petitioner's claim of dilution, and it is the evidence on which much of the testimony of petitioner's expert witnesses is based. Therefore, any discussion of the probative value of this survey necessarily requires a discussion of some of the information in the survey. Similarly, an alleged incident of actual confusion is based on a "verbatim" report, Exhibit 193, which petitioner has marked as confidential. Again, we cannot discuss the probative value of this evidence without discussing it herein, and therefore we have done so.

The parties have fully briefed the case, and both were represented at an oral hearing before the Board.

**Facts**

Petitioner Hormel Foods LLC is a wholly-owned subsidiary of petitioner Hormel Foods Corp. and is the owner of petitioner's intellectual property, which it licenses back to Hormel Foods Corp. Petitioner adopted the trademark SPAM for a canned luncheon meat product which is made from pork and ham, and the name is derived from "SPiced hAM." Since 1937, when the product was introduced, 6.3 billion cans of SPAM luncheon meat have been produced. During World War 2 SPAM luncheon meat was provided to both U.S. and Allied soldiers, and to civilians in Europe, and many famous people, such as President Eisenhower, Prime Minister Margaret Thatcher and Premier Nikita Khrushchev, have written about their experiences regarding SPAM luncheon meat during that period.

Petitioner's SPAM luncheon meat is sold in virtually every retail outlet that carries food, including grocery stores, mass merchandising stores such as Wal-Mart and Target, club stores such as Costco, and convenience stores.

Petitioner promotes its SPAM meat product in various ways. In addition to television, radio, print and billboard advertising, it sponsors athletes or athletic contests (currently it sponsors a race car driver named Jesse Smith); it sends SPAMMOBILES, trucks built to resemble a can of SPAM, throughout the country, where they host block parties,

or appear at grocery stores or sporting events and distribute SPAMPLES (samples of SPAM product); it does in-store demonstrations; distributes coupons; sponsors recipe contests at local and state fairs and national contests for recipes using SPAM meat (one winner, who created a SPAM cheesecake recipe, appeared on the "Tonight Show"); has sponsored festivals called SPAM JAM and SPAMARAMA; and operates the SPAM Museum in Austin, MN, which town has the nickname of SPAMTown USA, a nickname that appears on postal marks used on mail sent from Austin. In addition, in 1998 petitioner started the SPAM Fan Club, which currently operates on-line and can be joined without charge.

Two cans of SPAM, an original can and the modern version, are on display at the Smithsonian Museum of American History in Washington, DC, and a can of SPAM was part of a Library of Congress "Heritage" exhibit in which various household items were featured. Petitioner's SPAM trademark or product also has received mentions on various television programs and in movies. The opening of the SPAM Museum was featured on the "Today Show" in June 2002; a segment on the "David Letterman Show" had a product called "SPAM on a rope"; "Northern Exposure" had an astronaut saying that he was considered "SPAM in the can"; a quiz on the Rosie O'Donnell show called "Pam [Anderson] or SPAM" asked "What is more popular in Hawaii than anywhere else in

the world?"; and an episode of "MASH" showed a SPAM lamb. Petitioner has also engaged in co-promotion with the Broadway musical "Spamalot." The trademark SPAM is included in a lyric in the show, and a large can of SPAM appears at that point. In connection with the opening, petitioner created a special edition "Honey Grail" can of SPAM, which has characters from Spamalot appearing on the labeling.

Petitioner's sales and advertising figures, as well as brand awareness studies, have been submitted under seal. However, because respondent has admitted the fame of the SPAM mark in terms of the issue of likelihood of confusion, see applicant's response to opposer's request for admission No. 33 in Opp. No. 91153159, there is no need for us to refer to these figures, and we will say only that they are extremely large.

In 1991 petitioner started selling collateral products-merchandise bearing SPAM trademarks. It began with T-shirts and flip flops, but then expanded to a multitude of products, including various apparel, kitchen items, jewelry and office supplies. The 2000 SPAMTASTIC gift catalog displays such items as caps, shirts, flannel pants, ties, backpacks, sunglasses, tennis balls, clocks, cutting boards, mugs, paper clips, letter openers, mouse pads, light switch plates, Swiss army knives, snowdomes, toy banks, balloons and golf umbrellas with the mark SPAM or representations of

the SPAM can on them, as well as a SPAM CAM disposable camera and earrings in the shape of a SPAM can. These products are available for order on-line or through petitioner's toll free telephone number or SPAMTASTIC catalog, or at the gift shop of the SPAM Museum. The operator of the SPAM gift shop testified that he sometimes sells items to stores for resale, but there is no information as the extent of these re-sales or the particular items sold.

In addition, petitioner has licensed the SPAM mark for use on lottery tickets, including tickets sold in South Dakota and Minnesota, and on slot machines.

Respondent was founded in September 2001. Its product and services are offered under the mark SPAM ARREST, and their purpose is to help their customers avoid spam. Emails from known addressees are permitted to go directly into the customer's inbox. Unrecognized addressees are asked to verify that they are an actual person, rather than a computer that is sending bulk commercial emails. Verified messages then go into the customer's inbox, while unverified messages go into another box, where the customer can review them if he or she wishes. Messages that remain in this latter box are automatically deleted after seven days.

There is some question as to when respondent first used its mark in connection with its software. Respondent's

founder testified that it first used its mark in May 2002, when its first customer tried its services, and that its first sale occurred in August 2002. However, we need not concern ourselves with the exact date in 2002 on which respondent used its mark for software because it is clear that it is the filing date of respondent's intent-to-use application, November 27, 2001, that is the earliest date on which respondent can rely for priority purposes.

Respondent offers its software and its services through the Internet, both directly through its website and through affiliates--companies with whom it has a contractual relationship--who offer it through their websites. Respondent publicizes its goods and services through various types of Internet advertising, including banner ads on the websites of others; it has also done some radio advertising on the Howard Stern show, and had prepared a television commercial which was, at the time of its CEO's testimony in 2005, about to be shown on the Discovery Channel. Its primary marketing is through the challenge response that is part of respondent's spam-filtering service; that is, people are directed to respondent's website in order to verify that their email message is not spam, and in this way they are exposed to respondent's website and its product/services. Respondent and its SPAM ARREST product have also received mentions in various print media and website articles.

In 2003 respondent's sales were in the \$200,000 range; at the time of Mr. Cartmell's testimony deposition in October 2005 respondent had spent between \$400,000 and \$500,000 for marketing.

The word "spam" is a recognized generic term for unsolicited commercial email. There are various stories about how this term came to be adopted, including that it was a term used on computer game-playing sites to describe different types of abusive behavior, and that it is an acronym for "sending public announcement messages." However, the widely-reported origin, which appears in Merriam-Webster's Collegiate Dictionary, 11<sup>th</sup> ed. © 2003, is that it is derived from "a skit on the British television series *Monty Python's Flying Circus* in which chanting of the word *Spam* overrides the other dialogue." Whatever its origin, "spam" is well recognized today as the generic term for such email. The definition of "spam" in the Merriam-Webster dictionary is "unsolicited usu. commercial e-mail sent to a large number of addresses." See also, definition in Random House Webster's College Dictionary © 2001: "a disruptive, esp. commercial message posted on a computer network or sent as e-mail." Numerous media stories use it as the generic term, and even federal legislation is called the CANSPAM Act, CANSPAM being an acronym for the awkwardly named "Controlling the Assault of Non-Solicited Pornography

and Marketing Act of 2003," which was obviously devised in order to result in the acronym CANSPAM.

**Analysis**

**Standing**

Petitioner has demonstrated its standing by virtue of the registrations it has made of record, and its evidence of common law rights in the mark SPAM, thus showing it is not a mere intermeddler. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

**Priority**

Because this is a cancellation proceeding, and both parties own registrations, priority is in issue. *Brewski Beer Co. v. Brewski Brothers Inc.*, 47 USPQ2d 1281 (TTAB 1998); Cf. *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Respondent began using its mark after the filing of its intent-to-use application, so the earliest date on which it can rely is the November 27, 2001 filing date of that application. Petitioner can rely on the filing date of the applications that matured into its various pleaded registrations that are of record; with the exception of Registration No. 3022539 for SPAM for a screen saver, those dates precede, often by a significant period of time, respondent's constructive use

date. Moreover, the evidence shows that petitioner began using the mark SPAM for all of its registered goods prior to the November 27, 2001 filing date of respondent's application.

There is been some discussion between the parties with respect to petitioner's use of the mark for a screen saver. According to the testimony of Kevin Jones, the mark was first used in 1994 by an individual at Indiana University, who created a screen saver of flying cans of SPAM and requested permission from petitioner to use the design. It is not clear to us that the use at the university constitutes actual trademark use of the mark SPAM for a screen saver. However, Mr. Jones testified that the screen saver was available to be downloaded from the spam.com website in the fall of 1997, when the website "first went up." Test., p. 15. Thus, petitioner has demonstrated its priority with respect to the mark SPAM for the screen saver. We recognize that the screen saver is available at no charge, but it is not necessary to actually sell a product in order to obtain trademark rights.<sup>24</sup> In any event, as we discuss infra in our analysis of the du Pont factor of the

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<sup>24</sup> In its brief respondent makes the comment that petitioner's registration for SPAM for screen savers is subject to cancellation because "Hormel's trademark claims relating to screen savers are purely defensive, and constitute nothing more than litigation strategy." p. 33. Because respondent did not bring a counterclaim to cancel petitioner's registration, we give no consideration to this attack.

relatedness of the goods, whether or not petitioner has priority with respect to the mark for screen savers has no effect on our decision herein.

Petitioner has also presented evidence of prior common law use of SPAM for a wide variety of collateral merchandise items, including mouse pads, in addition to those items for which it has obtained registrations. These goods are sold primarily through petitioner's online catalog, its toll free telephone number, and its gift shop associated with the SPAM Museum in Austin, MN.

In addition, petitioner has asserted a family of marks based on the term SPAM, e.g., SPAMTASTIC, SPAMARAMA, SPAM BURGER. In order to demonstrate priority with respect to this asserted family, petitioner must show that the family was created, i.e., would have been recognized as a family, prior to the November 27, 2001 filing date of the application which resulted in issuance of respondent's registration. In its answer respondent has admitted that petitioner's registered SPAM-derivative marks make up a family of marks. Paragraph 3. In view of this admission, we accept that petitioner has a family of marks consisting at least of these registered marks, and also note that a family may be expanded by the later inclusion of additional

marks.<sup>25</sup> Petitioner's catalog and fan club newsletters from prior to 2001 include references to SPAM, SPAMTASTIC and SPAM BURGER, and given respondent's admission that petitioner has used its registered SPAM-derivative marks as a family, we find that petitioner has established prior use of a family of SPAM marks.

#### **Likelihood of confusion**

The issue of likelihood of confusion is determined by considering the factors set out in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), for which there is evidence of record. However, this case presents a very unusual situation in terms of that analysis. Fame is one of the du Pont factors, and where fame is present, it plays a major role. *Kenner Parker Toys Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). Here, it is undisputed that petitioner's trademark SPAM is a famous mark in terms of the likelihood of confusion analysis. At the same time, it is also undisputed that "spam" is a recognized word, a generic term for unsolicited commercial email, and that respondent uses

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<sup>25</sup> We note, however, that many of the so-called "marks" that petitioner claims are not marks at all, but are merely terms used in petitioner's advertising or other promotional materials. See The Amazing SPAM Joke Book, by Kevin Kestner, which petitioner's in-house counsel pointed to as an example of SPAM-derivative marks which make up its family of marks. This book consists primarily of joke riddles which use variations of "Spam" in the answers, such as "Q: What is believed to be George Hormel's favorite breed of dog? A: The Cocker SPAMIEL."

and has registered its mark SPAM ARREST for software that blocks spam. This dichotomy between the fame of petitioner's trademark and the generic meaning of that same term must inform our analysis of the du Pont factors.

The first factor we consider is the similarity of the marks. Obviously, the word SPAM in respondent's mark and SPAM in petitioner's mark is identical, and to that extent the marks are similar in appearance and pronunciation. However, when it comes to the meaning of the marks, they are very different. Although petitioner's mark SPAM was derived from "spiced ham," it must be considered an invented word rather than a suggestive term, and therefore it has no meaning other than that of a trademark for petitioner's goods. On the other hand, because "spam" is a generic term for unsolicited commercial email, and applicant's goods are identified as "computer software, namely, software designed to eliminate unsolicited commercial electronic mail," as it is used in respondent's mark SPAM has the connotation of the generic term, referring to unsolicited email, and the entire mark has the connotation of software that stops or filters spam/unsolicited commercial email. Because of this difference in connotation of "spam" in the respective marks, the marks as a whole are different in connotation and commercial impression. Further, we consider these differences to outweigh the similarities in appearance and

pronunciation resulting from the common element "spam." See *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459 (Fed. Cir. 1998) (CRYSTAL CREEK for wine not likely to cause confusion with CRISTAL for champagne); *In re Sears, Roebuck and Co.*, 2 USPQ2d 1312 (TTAB 1987) (CROSS-OVER for bras not likely to cause confusion with CROSSOVER for ladies' sportswear); *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984) (PLAYERS for men's underwear not likely to cause confusion with PLAYERS for shoes); *In re Sydel Lingerie Co., Inc.*, 197 USPQ 629 (TTAB 1977) (BOTTOMS UP for ladies' and children's underwear not likely to cause confusion with BOTTOMS UP for men's suits, coats and trousers).

Moreover, respondent's mark SPAM ARREST differs from petitioner's family of SPAM marks for the same reasons, i.e., the difference in meaning and commercial impression. In addition, SPAM ARREST does not have the same overall look as the members of petitioner's family of SPAM marks. Although petitioner claims that its family of marks consists of the word SPAM followed by a second word, we disagree. In petitioner's marks, SPAM is either followed by a generic term, e.g., SPAMMOBILE, SPAM JAM, or it replaces a syllable in a known word or phrase with "SPAM," such as SPAMBURGER, SPAMTASTIC. This latter usage of SPAM is reinforced by the use of such terms (as opposed to marks) in petitioner's

advertising, recipes, and the like, e.g., SPAMPLES, SPAMBASSADORS. SPAM ARREST, on the other hand, would not be viewed as a phrase in which SPAM has been substituted for another term or phrase, nor is it followed by a generic term. Rather, as stated above, the word SPAM in SPAM ARREST would be understood as the generic word "spam," meaning unsolicited commercial email, and ARREST would be seen as a verb. Thus, SPAM ARREST would not be perceived as being a part of petitioner's family of marks.

This du Pont factor favors respondent.

With respect to the factor of the similarity of the goods and services, there are two points that we must consider. The first is the similarity of petitioner's computer products to respondent's computer software. Petitioner has shown prior common law use of SPAM for a computer mouse and computer wallpaper, and common law use as well as a registration for SPAM for "computer software, namely, a screen saver." Petitioner also has pointed to various gaming devices that employ computer software and feature the SPAM mark.

The mere fact that respondent's goods are a type of computer software and petitioner's goods can be used with computers, or contain computer software, or even are a type of computer software, is not a sufficient basis on which to find these items related. The mere fact that a term--

"computer" or even "computer software"--can be found to describe the goods of the parties does not make them similar. See *Harvey Hubbell Incorporated v. Tokyo Seimitsu Co., Ltd.*, 188 USPQ 517, 520 (TTAB 1975) ("The mere fact that the term 'electronic' can be used to describe any product that includes an electronic device does not make a television set similar to an electronic microscope, or an electronic automotive ignition system similar to telemetering devices.") See also, *General Electric Company v. Graham Magnetics Incorporated*, 197 USPQ 690 (TTAB 1977); *In re Cotter and Company*, 179 USPQ 828 (TTAB 1973). Screen saver computer software and computer software to filter unsolicited commercial email are so different in their nature and purpose that, without more, we cannot conclude that consumers would assume that these goods are related.

Petitioner also uses its mark SPAM for a very wide range of goods. The evidence shows that SPAM is a merchandising mark, and that consumers buy the disparate items because they bear the trademark SPAM (or a variation thereof, such as a picture of the SPAM can). Lance Pogones testified that "pretty much it seems anything we can put SPAM on will sell." Test., p. 6. As a result, consumers are likely to view many very different items that bear the mark SPAM as being related to petitioner's luncheon meat.

However, when used in connection with computer software to filter unsolicited commercial email, the word "spam" would be viewed as having its generic meaning of unsolicited email, and therefore such computer software would not be viewed as a collateral product of petitioner's. As a result, we cannot find respondent's computer software that is designed to eliminate unsolicited commercial electronic mail as being related to petitioner's various goods or services, despite the broad range of collateral uses of its mark.

As for the goods for which petitioner has obtained registrations, we have considered them not only as collateral goods, but as items in their own right, as they are identified on the face of the registrations. In either category, petitioner has not demonstrated that consumers will view these various items, e.g., apparel, pens, mugs, jewelry, as related to computer software designed to eliminate unsolicited commercial electronic mail.

Thus, in the case of the particular software at issue herein, we find that respondent's computer software is not related to petitioner's products or services.

The next du Pont factor we consider is the channels of trade. Respondent has made the point that it offers its software through its own website and those of its affiliates, but in determining likelihood of confusion we

must deem the goods to travel in all channels of trade that are appropriate for such computer software. This would include computer stores, Internet websites, and mass merchandisers such as Wal-Mart. In addition to grocery stores and the like, petitioner's luncheon meat is also sold at mass merchandisers, including Wal-Mart. However, although these items can be sold in a mass merchandise store like Wal-Mart, there is no evidence that canned luncheon meat and email filtering software is sold together, or that people buying one item would come in contact with the other.

Neither party has discussed the potential channels of trade for petitioner's other goods that are the subject of its registrations. Thus, we have no evidence as to whether these items would be sold in the same channels of trade; certainly there is nothing to suggest that such items would be sold in the same stores with the exception of mass merchandisers that sell virtually everything. However, as with luncheon meat and email filtering software, we have no basis on which to conclude that any of petitioner's identified goods would be displayed in proximity to software of the type identified in respondent's registration, or that consumers for the various goods identified in petitioner's registrations would come in contact with such software.

As for those items for which petitioner has common law rights, the channels of trade for these goods are primarily

limited to sales from petitioner's catalog, its website, its toll-free telephone number, and its museum gift shop.<sup>26</sup>

Respondent's software is also offered through the Internet, but we do not regard the fact that both parties' goods are offered through this medium as evidencing that they are sold through the same channels of trade. They are sold on different websites, with petitioner's collateral goods being sold through its own website, while spam-filtering software is not sold on this site.

The only evidence of petitioner's goods and spam filtering software being sold on the same website is Exhibit 195 to Jeffrey Grev's testimony, which is the result of a search for "spam" on the Sam's Club website.<sup>27</sup> This search

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<sup>26</sup> Mr. Pogones, whose company operates the Spam Museum gift shop, testified that he also sold SPAM-licensed products "wholesale to different retailers in places that resell SPAM stuff themselves," test., p. 15. However, the evidence regarding such sales is very limited, and does not indicate the items sold nor the extent of the sales. We have only the following testimony, pp. 15-16, from Mr. Pogones:

I guess there is companies across the country, different locations, Hawaii is really popular with SPAM, and there is companies in Hawaii that call us and they can order on a wholesale basis... We sell the SPAM-branded merchandise to them and they resell it in their stores. There is also Mall of America, we sell a lot of SPAM stuff, too, there is a place in Alaska, smaller retailers, different places that resell it."

This testimony is too vague for us to conclude that computer software designed to eliminate unsolicited commercial electronic mail and the unidentified SPAM-branded merchandise referred to in Mr. Pogones's testimony would be sold in the same stores.

<sup>27</sup> A search for "spam" on the Wal-Mart website did not retrieve petitioner's meat product (Exhibit 194); the closest it came were some cookbooks featuring SPAM meat as an ingredient and a "biography" of SPAM; the same search on the Target website did not retrieve petitioner's meat product either, only the SPAM cookbook. It did, however, retrieve some third-party use of SPAM

retrieved items of petitioner's canned luncheon meat (which indicated that they were available only for in-store pickup) and software which filters spam. The fact that a single website, for what is in effect an on-line superstore or mass merchandise store, offers both types of products is meager evidence that consumers would encounter both, or that luncheon meat and computer software for filtering spam are normally offered in the same channels of trade.

Accordingly, we find that this du Pont factor does not favor either party.

As for the conditions under which and buyers to whom sales are made, both parties' goods are consumer items. All of petitioner's goods, whether its primary meat products or its collateral items, are bought by the general public. They include many inexpensive items which would not be purchased with great care. The consumers for respondent's product include anyone who uses email. Such consumers must be considered to include the general public, although they may be considered somewhat more sophisticated in terms of checking the nature of the product which they will load on their computers. Thus, to the extent that the class of purchasers of both parties' goods are the same and that they are the public at large, this factor favors petitioner.

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for a CD and DVD, namely, what appears to be a musical group called the Spam Allstars.

However, to the extent that consumers of spam-filtering software will be careful about the software that they download or purchase for their computers, and will understand the generic meaning of "spam" when they see it in a mark for such software, this factor favors respondent.

This brings us to the fifth du Pont factor, that of the fame of petitioner's mark. As noted previously, petitioner has demonstrated, and respondent has acknowledged, that its mark SPAM is famous for canned luncheon meat. Even dictionary definitions that are of record list "Spam" as "1. *Trademark*. A canned food product consisting esp. of pork formed into a solid block," Random House Webster's College Dictionary © 2001; "*trademark* used for a canned meat product," Merriam-Webster's Collegiate Dictionary, 11<sup>th</sup> ed. © 2003. It is because of the fame of this mark that petitioner has successfully expanded its mark to use on collateral products, i.e., has used it as a merchandising mark by which consumers purchase other products because of the very fact that SPAM is printed on them. There is no question that, as a famous and therefore strong mark, SPAM is entitled to a broad scope of protection. However, the fame of the mark does not entitle petitioner to a monopoly on the use of SPAM as a trademark for all goods and services. If the du Pont factor of fame were interpreted in such a manner, owners of famous marks would essentially have

a right in gross in a term. However, as the Court said in *The University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505, 507 (Fed. Cir. 1983)):

The fame of the University's name is insufficient in itself to establish likelihood of confusion under § 2(d). "Likely \* \* \* to cause confusion" means more than the likelihood that the public will recall a famous mark on seeing the same mark used by another. It must also be established that there is a reasonable basis for the public to attribute the particular product or service of another to the source of the goods or services associated with the famous mark. To hold otherwise would result in recognizing a right in gross, which is contrary to principles of trademark law and to concepts embodied in 15 USC § 1052(d).

Here, although there has been testimony, based on the survey conducted by George Mantis, that consumers associate SPAM ARREST with SPAM, at best that association is clearly of the "brings to mind" variety, rather than evidence that consumers believe that computer software designed to eliminate unsolicited commercial electronic mail that is sold under the mark SPAM ARREST emanates from or is sponsored by petitioner. The survey itself was not even designed to determine whether there was a likelihood of confusion between respondent's mark and petitioner's mark(s); rather, its stated purpose was to assess "whether the name 'SPAM ARREST' has attained secondary meaning and

whether it dilutes the distinctiveness of Hormel's SPAM trademark." Exhibit 1.<sup>28</sup> Survey respondents were first shown a card with the words "SPAM ARREST" and, below that term, "Computer Software," and asked whether "the product shown on this card is put out by one company, more than one company, no company, or don't know." Only after follow-up questions on the issue of "secondary meaning" were a second series of questions put, i.e.:

Totally separate and apart from the company that puts out this product, does the name of this product bring to mind any other products or brands?

If the answer was in the affirmative, respondents were then asked:

What products or brands come to mind?

It is clear from these questions that the interpretation of the survey results that is most favorable to petitioner<sup>29</sup> is that, for those interviewees who mentioned SPAM luncheon meat, SPAM ARREST merely recalled petitioner's mark and/or product.

Thus, although the fame of petitioner's mark certainly favors petitioner herein, petitioner has not shown how that

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<sup>28</sup> Apparently the portion of the survey designed to assess secondary meaning related to the originally pleaded ground that respondent's mark was merely descriptive or generic. That ground, as noted previously, has been waived by petitioner, and we make no comment as to the probative value of the survey as it might relate to that ground.

<sup>29</sup> We discuss, in our analysis of the dilution ground, other problems with the survey.

fame has carried over to computer software designed to eliminate unsolicited commercial electronic mail, or that consumers would associate such software with the source of petitioner's SPAM and SPAM-derivative products and services. In fact, as discussed below with respect to the du Pont factor of the number and nature of similar marks in use on similar goods or services, the evidence shows that petitioner's mark is not a strong mark for such goods.

Respondent has submitted evidence that numerous products and services for the filtering of unsolicited commercial email are offered under trademarks that include the word SPAM. At his testimony deposition respondent's founder and CEO, Brian Cartmell, identified printouts from almost 100 websites using such trademarks. The marks include SPAM KILLER, SPAM STOP, SPAM BUTCHER, SPAM SLEUTH, SPAM K O, SPAM GRIP and SPAM SHREDDER, and are for various "solutions" to spam, which may be software or services or a combination thereof. Our analysis of this factor of third-party use, and the evidence regarding it, is somewhat different from the usual situation. Frequently the Board has given little weight to evidence of third-party use without testimony regarding the extent of such use, because we could not determine whether the public had been exposed to the marks. However, in the case of these computer solutions, as opposed to what may be a local restaurant or a

product sold in a limited area, a normal channel of trade for these goods and services is the Internet, and therefore anyone with Internet access who is looking for a way to block or filter spam may be exposed to the marks. The second "anomaly" regarding this factor is that normally evidence that a term common to the marks at issue is frequently used by third parties shows that a plaintiff's mark is weak and entitled to a limited scope of protection. That is, because consumers have been exposed to multiple uses of the element that is common to the parties' marks, they are more likely to be able distinguish the marks based on relatively small differences. Here, however, petitioner's trademark SPAM has been shown to be a famous mark, and is obviously a strong mark in general. What the third-party use shows in this case is that, in the field of email filtering/spam blocking solutions, the trademark SPAM is not a strong mark because the term "spam" is used by so many third parties for its generic meaning. This du Pont factor favors respondent.<sup>30</sup>

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<sup>30</sup> We recognize that petitioner has made efforts to police its mark and has written cease and desist letters to many third parties about their use of SPAM in their trademarks. While such policing is commendable, and we are sympathetic to the fact that petitioner's resources do not permit it to take action against every party that uses SPAM in its trademark, the fact remains that in terms of public exposure, there are numerous marks in this field that contain the word "spam," and therefore petitioner's mark SPAM is not a strong mark with respect to such goods and services.

We examine together the next du Pont factors, the nature and extent of any actual confusion and the length of time during and conditions under which there has been concurrent use without evidence of actual confusion. The only arguable evidence of actual confusion consists of a verbatim report taken by petitioner's employees. These verbatim reports are prepared by petitioner's consumer affairs department, and can be reports of either telephone conversations, emails or letters. The particular "verbatim" is on a report dated December 1, 2002 to December 15, 2003, and reads in its entirety as follows:

Message: I do not understand how this will stop my spam. Will you please [sic] stop my spam? Your other web site will not work for me. I went to <http://www.spamarrest.com> and they do not even have live help. Where can I stop this? Please stop it. Why do I have to pay to stop spam? Please stop it completely! Your food is good but your advertising to stop it does not have live help. Do you want me to wait for help? This is so wrong. Carma [sic] will get you.

Exhibit 193 to the testimony deposition of Nicholas Meyer. Mr. Meyer could give no further information about this message; he could not identify whether it came in by email, phone or letter, or any information as to who wrote it, or an address or telephone number. Although he thought that there might be more information on the message in the consumer affairs department, including whether or not a

response was sent, the only information he had was the exhibit itself.

We do not regard this message as evidencing an incident of actual confusion. Based on the limited information petitioner has provided, we cannot even ascertain that it was sent by a customer, or that it was a serious complaint and not a joke. There are just too many unknowns to give it real probative value. Thus, the factor of actual confusion is neutral.

So, too, is the factor of the lack of actual confusion. At the time of trial respondent had been operating for a limited period of time. Although respondent's CEO testified that millions of people have visited its website, these visits are primarily so that the person can verify that the email message it has sent to a customer of respondent's is not spam, and it is not clear to what extent the sender actually examines the website, rather than merely typing in a word to show that a computer is not the source of the message. As a result, there has not been sufficient concurrent use without confusion for us to conclude that this factor should favor respondent.

In terms of the du Pont factor of the variety of goods on which a mark is or is not used, as we have said, petitioner's mark SPAM is not only a famous mark for its luncheon meat, but is used as a merchandising mark on a wide

variety of products. In this respect, this factor favors petitioner.

The only other factor that has been discussed by the parties is the extent to which [respondent] has a right to exclude others from use of its mark on its goods. Petitioner argues that, because it has prior rights in the mark SPAM, petitioner can exclude respondent "from causing confusion of its famous SPAM mark," and therefore respondent has no right to exclude others. Brief, p. 42. Respondent, on the other hand, argues that because it has a registration for its mark, it is entitled to exclude others from using its mark or a confusingly similar mark in connection with its identified goods. As the factor is listed in the du Pont decision, it refers to the extent that the applicant has a right to exclude others, since du Pont was an ex parte proceeding in which the applicant was seeking to register its mark, and registration had been refused by the Office in view of a previously registered mark. The present proceeding is a cancellation action, and therefore, obviously, respondent owns a registration. Although registrations are entitled to the presumptions set forth in Section 7(b) of the Statute, here the very purpose of this proceeding is to cancel respondent's registration. In such circumstances, respondent cannot simply rely on its registration as prima facie evidence of the registrant's

exclusive right to use the mark in commerce on the goods identified in the registration, in the face of petitioner's evidence challenging that right. This du Pont factor is neutral.

After considering all of the du Pont factors on which we have evidence or argument, we find that petitioner has failed to prove that respondent's mark SPAM ARREST for "computer software, namely software designed to eliminate unsolicited commercial electronic mail" is likely to cause confusion with petitioner's mark SPAM and its SPAM-derivative marks for its various goods. In particular, because the word "spam" in respondent's mark will be viewed as having its generic meaning of unsolicited commercial electronic mail, the marks as a whole are different in connotation and commercial impression. Differences in the marks alone can be dispositive in finding no likelihood of confusion. See *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991) Here, as detailed above, there are additional factors that favor a finding of no likelihood of confusion. While we have given great weight to the fame of petitioner's mark, that fame does not extend to computer software for filtering spam. Simply put, the scope of protection of petitioner's mark, while extremely broad, does not extend to prevent the use of SPAM ARREST for spam filtering software, since consumers will

understand SPAM as used in respondent's mark in its generic sense rather than as referring to petitioner's mark(s).

**Dilution**

The second ground for cancellation is that of dilution. As an initial matter, we note that respondent, relying on *Moseley v. V. Secret Catalogue, Inc.*, 537 US 418, 123 S.Ct. 1115, 65 USPQ2d 1801 (2003), has asserted that petitioner's claim must fail because petitioner never produced any evidence of actual dilution. However, the October 6, 2006 amendments to the Lanham Act, made after the Moseley decision, make it clear that the standard to be applied in ascertaining dilution is "likely to cause dilution," not "actual dilution." See Section 43(c) of the Trademark Act, 15 U.S.C. §1125(c):

Dilution by Blurring; Dilution by Tarnishment.--

- (1) Injunctive relief.--Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.  
(emphasis added)

Although this proceeding was tried and briefed prior to the amendment of the Lanham Act, the standard applicable in TTAB proceedings both prior to and after the amendment of the Act was and is likelihood of dilution, whether or not the defendant's mark is in use. *NASDAQ Stock Market Inc. v. Antartica S.r.l.*, 69 USPQ2d 1718, 1734 (TTAB 2003).<sup>31</sup>

Petitioner has asserted dilution by blurring and dilution by tarnishment. Because petitioner devotes more of its argument to the former assertion, we will address that first.

In order to succeed on a claim of dilution, a plaintiff must prove that its mark is famous and distinctive. Fame for dilution purposes is different from fame for likelihood of confusion. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005); *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1170 (TTAB 2001). Further, the plaintiff must show that its mark became famous prior to the first use or constructive first use of the defendant's mark. In the present case, therefore, petitioner must establish that its mark became famous prior to November 27, 2001, the filing

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<sup>31</sup> Although the NASDAQ decision held evidence of actual dilution is not required in a Board case, respondent cites a Board decision marked "not citable as precedent" as stating that the NASDAQ decision did not address the question of whether actual dilution must be demonstrated where the defendant's mark is in use, as it is here. Even so, that decision did not state that, as respondent claims, actual dilution must be shown.

date of the intent-to-use application that resulted in issuance of the registration that is the subject of this proceeding.

As noted previously, respondent has admitted the fame of petitioner's mark only for purposes of the likelihood of confusion analysis, and not for purposes of dilution. However, we find based on the evidence of record that, prior to 2001, petitioner's mark SPAM had achieved the degree of fame with respect to canned meat that is necessary for a dilution claim. At that point, petitioner had used the mark for such goods for over 60 years; had achieved an extremely large volume of sales that were still very high even in the period shortly before respondent's adoption of its mark; and had engaged in significant promotion and advertising of its mark throughout the entire period of its use. In addition, the various uses or mentions of petitioner's mark and its meat product, e.g., in the Smithsonian Museum, in a Library of Congress display, on numerous television programs, all demonstrate that the mark and product are recognized by the public. This recognition is also shown by the brand awareness studies that petitioner made of record, showing an extremely high "aided" brand awareness even among non-users of petitioner's canned meat.

In addition to proving fame, petitioner must prove that its mark is distinctive. *Toro Co. v. ToroHead Inc.*, supra. As the Board stated, id. at 1177:

To be vulnerable to dilution, a mark must be not only famous, but also so distinctive that the public would associate the term with the owner of the famous mark even when it encounters the term apart from the owner's goods or services, i.e., devoid of its trademark context. H.R. REP. No. 104-374, at 3 (1995) ("the mark signifies something unique, singular, or particular"). Also, courts have indicated that a mark can be famous but not particularly distinctive. See, e.g., *Sporty's Farm L.L.C. v. Sportsman's Market Inc.*, 202 F.3d 489, 497, 53 USPQ2d 1570, 1576 (2d Cir. 2000) ("[E]ven a famous mark may be so ordinary, or descriptive as to be notable for its lack of distinctiveness"); *TCPIP Holding Co. v. Haar Communications Inc.*, 244 F.3d 88, 96, 57 USPQ2d 1971, 1975 (2d Cir. 2001) (footnote omitted) ("Some of the holders of these inherently weak marks are huge companies; as a function of their commercial dominance their marks have become famous. It seems unlikely that Congress could have intended that the holders of such non-distinctive marks would be entitled to exclusivity for them throughout all areas of commerce").

Thus, in order to prove dilution, "the mark's owner must demonstrate that the common or proper noun uses of the term and third-party uses of the mark are now eclipsed by the owner's use of the mark. What was once a common noun, a surname, a simple trademark, etc., is now a term the public primarily associates with the famous mark. To achieve this level of fame and distinctiveness, the party must

demonstrate that the mark has become the principal meaning of the word." *Id.* at 1180.

The evidence shows that "spam," in addition to being petitioner's trademark, has a well-recognized meaning as a generic term for unsolicited commercial email; the term is used by consumers, the media, Congress, state legislatures and those who sell solutions for such unwanted email. Thus, it does not have the requisite degree of distinctiveness to support a finding of dilution, at least vis-à-vis respondent's use of the term as part of the mark SPAM ARREST for computer software designed to eliminate unsolicited commercial email. Even petitioner's expert witness Gregory Carpenter, a professor in Northwestern University's business school, recognized that "a second meaning would diminish the uniqueness" of the SPAM brand, *test.* p. 38, and the more "spam" is used as a generic term, "the greater the impact on the SPAM brand." p. 29.<sup>32</sup>

The situation we have here is somewhat analogous to that in *Hasbro Inc. v. Clue Computing Inc.*, 66 F. Supp.2d 117, 131, 52 USPQ2d 1402, 1413 (D. Mass. 1999), *aff'd*, 232 F.3d 1, 56 USPQ2d 1766 (1st Cir. 2000), in which "Clue" was

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<sup>32</sup> Mr. Carpenter also testified, based on the Mantis survey, that such damage had not yet occurred to petitioner's mark. In particular, it appears from Mr. Carpenter's testimony that he viewed the results of the survey as being representative of or projectible to all consumers. Because of the flaws in that survey, as discussed *infra*, we give no probative value to the conclusions Mr. Carpenter reached based solely on that survey.

found to be a common word with many meanings and the "defendant's use of the word 'clue' is entirely consistent with the common usage of the word." We acknowledge that, as opposed to CLUE, which was a common word at the time the plaintiff adopted it as a mark, here petitioner created the trademark SPAM, and it became a generic word many years later and after (and perhaps was adopted by others as a generic term because of) the vast success it enjoyed as a trademark for petitioner's canned meat. However, although it may be unfortunate for petitioner that its mark has become a generic word for unsolicited commercial email, that is what has happened. As a result, SPAM is not a distinctive mark of petitioner and its goods and services when it is used in connection with email, or with goods or services that deal with unsolicited commercial email. In other words, the fact that "spam" has become a generic term for unsolicited commercial email is what diluted the distinctiveness of petitioner's mark, and this dilution occurred prior to respondent's adoption of the mark SPAM ARREST.

In addressing the fact that "spam" is a generic term (and presumably to differentiate the dilution caused by generic usage of the mark versus purported dilution when used in respondent's trademark), petitioner has taken the position that the use of "spam" is acceptable when it is

used as an ordinary generic term, but that it is not acceptable when SPAM is used as part of a trademark. Its expert witness Gregory Carpenter testified that there is a distinction between the use of "spam" as a generic term and use in a commercial context, test. pp. 34-35:

As a word in the language, no organization is actively seeking to create associations surrounding that. ... So there's no individual with an economic incentive to promote a particular word in the English language. And so therefore, the associations--the word will mean what it--what the public comes to believe it ought to mean. But it won't--there won't be another commercial enterprise seeking to create a set of associations that may interfere or diminish the value of the Hormel brand per se.

Although we understand the distinction that petitioner is making, we do not believe that this is a significant difference, or one that is drawn by the statute or the case law. If a term is generic, others should have the right to use it, even as a disclaimed term in a trademark, to describe the goods or services with which the mark is used. And as we stated in our discussion of likelihood of confusion, respondent is using the term "spam" in the mark SPAM ARREST in its generic sense, and that is the meaning that would be perceived by consumers.

This is not to suggest, however, that simply because a mark has a generic meaning in other contexts it can never be considered distinctive in terms of proving dilution. We are

saying only that, when a trademark has an alternative generic meaning, and it is being used in a second mark to project that generic meaning, there can be no dilution of the original mark under the statute because that mark is not distinctive with respect to the goods which the generic term describes. This would be the case whether the trademark owner invented a mark and the mark subsequently became a generic term, as is the case here, or the trademark owner chose an ordinary word that is arbitrary for its goods and through its efforts caused the mark to become distinctive for those goods.

In assessing petitioner's claim of dilution, we have considered the survey conducted by The Mantis Group, Inc., and the testimony of George Mantis with respect to that survey. It is this evidence on which petitioner primarily relies in asserting that respondent's mark will dilute petitioner's mark. The survey was a "mall intercept" survey, in which people over the age of 18 found in eight different shopping malls, two in each of the four census regions of the country, were requested to participate. In order to qualify as a participant, an interviewee had to answer that, in the past 60 days or within the next 60 days, he or she had used or was likely to use the Internet to send and receive e-mail and had purchased or was likely to purchase a canned meat product, and had purchased or was

likely to purchase "computer software related to their use of the Internet, such as software to protect their data or filter E-mail." Mantis test. exhibit 1. Of the 159 people questioned about SPAM ARREST, the Mantis report concluded that 71 indicated in some way that SPAM ARREST brought to mind petitioner's product or trademark. We note that more than one fifth of the answers that were submitted as part of this group mention, in addition to petitioner's mark SPAM or meat, various third-party trademarks, e.g., NetZero, Microsoft and McAfee, or various other products or items, including computer software, pop-ups, and email programs. Thus, the Mantis report's calculation that for 44.7% of survey respondents SPAM ARREST brought to mind petitioner or its meat product is not as impressive as it would appear from the conclusion in the report.

Respondent submitted the testimony of its own expert witness, Lea Knight, with respect to the validity of the survey. Her testimony shows what we have frequently seen when we have a "battle of the experts": no survey is perfect. Several of her comments really speak more to ways the survey could have been improved, rather than indicating major flaws, and some of her comments, while valid for a marketing survey, do not take into account trademark principles that must be applied by the Board. However, we

find certain of her criticisms valid, and we have our own additional concerns about the survey.

First, as Ms. Knight pointed out and as Mr. Mantis recognized, a mall intercept survey does not use a random sample of the population whose views are sought. Thus, the results of the survey are not projectible. The survey results tell us about the opinions of the people who participated in the survey, but we cannot extrapolate from them what the results would be if a survey could be taken of everyone in the United States who fit the screening criteria. We acknowledge that mall intercept surveys are a recognized survey technique, and that they have been considered in trademark proceedings, but their value is limited. Here, where the number of respondents to the dilution questions is quite small (159), the survey provides limited information about consumer views. Further, even the people who were actually interviewed were not necessarily representative of the people who were approached to participate in the survey. Although equal numbers of people from each age group and gender and location were "intercepted" in each of the malls, the vast majority of them did not meet the screening criteria. Thus, the number of actual interviews could have been primarily from one mall or from a single geographic region. The survey report fails to indicate the number of interviewees from each mall. Nor

does the report indicate the day of the week or the time of day that the interviews were conducted. Obviously, these factors have an impact on demographics.

Those who participated in the survey had purchased in the preceding sixty days, or intended to purchase in the next sixty days, both a canned meat product and "computer software related to their use of the Internet, such as software to protect their data or filter their E-mail." The computer software identified in respondent's registration has a very specific, limited purpose--to eliminate unsolicited commercial electronic mail. The generic term "spam" means "unsolicited commercial electronic mail," and the question of whether consumers would draw an association between the mark SPAM ARREST and petitioner's mark SPAM must be determined in connection with this specific type of computer software, not a general category of computer software related to use of the Internet.<sup>33</sup> Thus, it is not clear that the participants in the survey constituted the relevant group of purchasers.

We also have concerns about the questions in the survey. As noted in our discussion of fame with respect to likelihood of confusion, the questions regarding dilution were asked after questions whose purpose was to determine

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<sup>33</sup> As Ms. Knight noted, it is not clear how participants would interpret "computer software related to their use of the Internet."

"secondary meaning" of the defendant's mark. We cannot ascertain whether these earlier questions had any effect on the interviewees' responses. And we also are concerned with the introduction to the question on dilution, i.e., "Totally separate and apart from the company that puts out the product...." Mr. Mantis, during his discovery deposition, explained that in order to do a survey on dilution, one must test in the context of the defendant's product category, but the introduction to the question on dilution might well have been interpreted by the participants as a direction to ignore the product category. Aside from that problem, the prompt that the survey respondents were shown, a card with SPAM ARREST in all capital letters and "Computer Software" below it, could have resulted in the respondents considering all types of computer software, when "spam" has a generic meaning only in connection with computer software for a specific purpose. "Computer software" is overly broad to be used as a description of the product category for respondent's goods. Petitioner itself has recognized, quoting from Toro, supra at 1183, that "dilution by blurring occurs 'when a substantial percentage of consumers, upon seeing the junior party's use of a mark **on its goods**, are immediately reminded of the famous mark and associate the junior party's use with the owner of the famous mark....'" Brief, p. 46 (emphasis added). Using the descriptor

"computer software" does not adequately advise the survey respondents what the junior party's goods are.

We also have a concern about whether consumers were merely guessing or trying to come up with an answer to please the interviewer. At the beginning of the questions relating to "secondary meaning," the participants were told, "In a moment I'm going to hand you a card which shows the name of a product. I will then ask you some questions. For each of my questions, if you don't know or don't have an answer, please don't guess." However, this caution was not repeated at the point the interviewees were questioned about dilution, and again, the introduction to the dilution question, "Totally separate and apart from the company that puts out this product...", might well have been viewed as a request to guess. In this connection, we note that the question on dilution, "Totally separate and apart from the company that puts out this product, does the name of this product bring to mind any other products or brands?," did not include "if any" or a similar phrase which would be considered permission for the participant to say "no." In contrast, the question on "secondary meaning" began with such an indicator of permission to say no, i.e., "if you have an opinion." As a result, participants may have simply tried to come up with an answer to please the interviewer. Certainly at least one of the responses indicates to us that

the interviewee was just guessing: "(Hormel) What do you want to know. The ham or Spam. Is that what you want to know." See response No. 100.<sup>34</sup>

Most important to the question of whether dilution is likely, the survey results do not tell us whether people would reference petitioner's mark and product any time they saw "SPAM" alone or because respondent's complete mark SPAM ARREST causes such an association. In this connection, Ms. Knight pointed out that the survey did not control for this factor--that is to say, it failed to take this possibility out of the equation--and Mr. Mantis admitted as much during his discovery deposition. Mantis disc. p. 106. The absence of a control is of particular note since the survey did use a control in the "secondary meaning" portion, and Mr. Mantis has testified that a control is a way to eliminate "noise." At least two of the responses that petitioner has listed as indicating dilution show that the interviewees, in answering whether the name of the product brings to mind other products or brands, were looking only to the word SPAM in respondent's mark, rather than to the mark itself. Response No. 104: "Other products as far as the name Spam. As far as a meat product. Arrest like an allergy product."

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<sup>34</sup> The survey report did not include the actual filled-out questionnaires, only typed answers that were grouped into tables. We have reproduced the response as listed in the report, including the punctuation provided in the table.

Response No. 84: "Yes, the spam part." Thus, the survey responses purportedly indicating an association between defendant's mark and "meat," or petitioner, or petitioner's mark, are equally consistent with the conclusion that it is the generic word "spam," and not respondent's mark SPAM ARREST, that creates the association with petitioner's trademark SPAM and its canned meat product.

This conclusion, that people make a connection between spam email and petitioner's mark and/or product, is supported by the media references to petitioner's mark in articles about unsolicited email. The record includes a large number of articles, broadcast segments and the like about unsolicited commercial email in which a can of petitioner's meat product is used as a visual illustration. Petitioner acknowledges "the frequent use of the SPAM trademark and SPAM product image by the public when discussing the subject of unsolicited commercial email." Reply brief, p. 22. Even federal legislation regarding unsolicited email is named the CANSPAM Act. Although petitioner has written to various media protesting the use of its product in these stories, the fact remains that there has been public exposure connecting petitioner's trademark and product with unsolicited commercial email (spam).

In summary, we have so many concerns about the survey that we accord it little probative value. Further, to the

extent that the testimony of petitioner's various expert witnesses rely heavily on the results of the survey, that testimony, too, has limited value.

Aside from failing to prove the distinctiveness of its mark with respect to products and services relating to unsolicited commercial email or spam, petitioner has failed to prove that the involved marks are essentially the same. As the Board stated in Toro, and as reiterated in Carefirst of Maryland Inc. v. FirstHealth of the Carolinas Inc., 77 USPQ2d 1492, 1514 (TTAB 2005), aff'd 479 F.3d 825, 81 USPQ2d 1919 (Fed. Cir. 2007), to support an action for dilution by blurring, the marks must be similar enough that a significant segment of the target group would see the two marks as essentially the same. The connotation of SPAM in respondent's mark is unsolicited commercial email because it is used in connection with a product that filters such email. Thus, respondent's mark is different from petitioner's mark in connotation and commercial impression, and therefore the marks are not essentially the same.

In view of the foregoing, we find that petitioner has failed to prove either that petitioner's mark is distinctive when consumers encounter the mark in the context of unsolicited commercial email or products or services that address this problem, or that respondent's mark causes dilution by blurring.

Petitioner also argues that respondent's mark causes dilution by tarnishment. Petitioner bases this claim on a few Internet postings that allege respondent engages in sending spam emails and/or that its software is spyware, and therefore the association of petitioner's mark with respondent's software tarnishes petitioner's mark. The postings on which petitioner relies cannot be used as proof of the truth of the statements made therein. Moreover, the number of these negative postings is so limited (and some have been retracted) that we cannot conclude that the public regards respondent's product as inferior or offensive.

In conclusion, we find that petitioner has failed to prove dilution, whether by blurring or tarnishment.

**Affirmative Defenses**

In view of our finding that petitioner has failed to prove its pleaded grounds of likelihood of confusion or dilution, we need not reach respondent's affirmative defenses. However, in the interest of rendering a complete opinion, we discuss them briefly. With respect to respondent's claim that "spam" is a generic term for unsolicited commercial email, we have considered this claim in our analysis of the grounds of likelihood of confusion and dilution. As for the affirmative defense of acquiescence and estoppel, respondent bases this defense on a position statement that appeared on petitioner's website

at the time respondent filed its intent-to-use application in November 2001. This statement essentially said that "we do not object to use of this slang term [spam] to describe UCE [unsolicited commercial email], although we do object to the use of our product image in association with that term." The evidence shows that respondent was not aware of petitioner's position at the time it filed its application, and became aware of it only after June 13, 2002, when respondent received a cease and desist letter from petitioner.

As a general rule, the equitable defense of acquiescence in an opposition or cancellation proceeding does not begin to run until the mark is published for opposition. *Krause v. Krause Publications Inc.*, 76 USPQ2d 1904 (TTAB 2005) Cf. *National Cable Television Association, Inc. v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991) [laches runs from the time from which action could be taken against the trademark rights inhering from registration].

Petitioner brought this cancellation proceeding on May 5, 2003, approximately nine months after the publication date of the underlying application on August 6, 2002, and just one and one-half months after issuance of the registration on March 25, 2003. Moreover, petitioner advised respondent of its objection to the use of SPAM

ARREST for its services in June 2002, shortly after respondent's application for SPAM ARREST for services was published for opposition. This relatively short period, with respect to use of the mark for either the goods or services, cannot be viewed as an unreasonable delay.

Moreover, although petitioner's policy statement that was on-line in 2001 did not specifically state that petitioner objects to third parties using SPAM as a part of their trademarks, as a later version of the statement does make clear ("we do object to the use of the word 'spam' as a trademark"), we do not read the 2001 statement as advising third parties that petitioner does *not* have an objection to the registration of such marks. Moreover, it is clear that respondent did not rely even on a mistaken interpretation of this policy statement when it adopted its mark, since it was not aware of the position statement until after its application was filed, and after the March 2002 date that it now asserts was the date of first use of its mark for its goods.

Accordingly, if petitioner had demonstrated that it was entitled to judgment on either its claim of likelihood of confusion or its claim of dilution, we would find that proof of either claim would not be barred by acquiescence.

**Decision**

Petitioner having failed to prove its pleaded grounds of likelihood of confusion and dilution, the petition for cancellation is dismissed.

Rogers, Administrative Trademark Judge, concurring:

I firmly agree with the assessment of the majority but add a few observations about the Mantis survey.

As the Board stated in the Toro decision, for a famous mark to be vulnerable to dilution, it must be "so distinctive that the public would associate the term with the owner of the famous mark even when it encounters the term apart from the owner's goods or services, i.e., devoid of its trademark context." In the case at hand, the word SPAM is devoid of its context as a trademark for plaintiff's goods when it is instead "spam," i.e., the term for unwanted commercial email. Accordingly, the survey respondents should have been qualified as understanding that "spam" is unwanted commercial email. Then the survey questions would have ensured that respondents were individuals who understood the word "spam" devoid of its context as a trademark for plaintiff's goods.

In addition, not only did the Mantis survey fail to ensure that respondents understood the term "spam" in its

generic context, but the conditions used to qualify respondents could very well have qualified individuals who were *not* purchasers, users, or prospective purchasers or users of defendant's products. This is because one *could* qualify as a survey respondent if, within the prior or next 60 days, one (1) had or was likely to send and receive email, (2) had purchased or was likely to purchase a canned meat product, and (3) had purchased or was likely to purchase software to protect data when using the Internet. On this last point of qualification, the respondent only had to have purchased or be likely to purchase software to protect data or filter email. And as the majority has observed, the stimulus card did not refer to email filtering software as the product associated with the mark SPAM ARREST.

Finally, by requiring survey respondents to have purchased or be likely to purchase a canned meat product, the survey likely skewed the results to favor collection of responses from individuals who would be more likely to draw an association with plaintiff. From the record it appears that plaintiff's canned meat products must be preeminent in their field. Thus, any purchaser or prospective purchaser of canned meat would be much more likely to be aware of plaintiff than individuals who were not purchasers or prospective purchasers of such products. By ensuring a

group of survey respondents much more likely to be familiar with plaintiff, the survey increased the likelihood of associations with plaintiff among the respondents.

Plaintiff has conducted brand awareness surveys showing awareness of its mark and/or products even among individuals who do not purchase or use the products. Evidence of an association of the generic term "spam" with plaintiff among survey respondents qualified as understanding the meaning of the generic term and who were not purchasers or users of plaintiff's products would have been powerful evidence; but it was not the type of evidence provided in this case.