

TTAB

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

In the Matter of Trademark Registration No. 2,701,493  
Published in the Official Gazette (Trademarks) on May 25, 2003

HORMEL FOODS CORPORATION, and  
HORMEL FOODS, LLC,

Petitioners,

v.

SPAM ARREST LLC,

Applicant.

**Cancellation No. 92042134**

**Mark: SPAM ARREST**

**Registration No. 2,701,493**

**File: November 27, 2001**

**Registered: March 25, 2003**



03-29-2004  
U.S. Patent & TMO/c/TM Mail Rpt 1 Dt. #78

BOX TTAB NO FEE  
Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

CERTIFICATE UNDER 37 C.F.R. § 1.8: Express Mail mailing label number [ **EU984741940US**

The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service, "Express Mail Post Office to Addressee" in an envelope addressed to: BOX TTAB NO FEE, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513, on March 29, 2004.

By:   
Sara Hill

**APPLICANT'S ANSWER TO PETITION FOR CANCELLATION**

Applicant, Spam Arrest LLC, hereby files this Answer in response to the Petition for Cancellation filed by Hormel Foods Corporation and Hormel Foods, LLC with the Trademark

CANCELLATION NO. 92042134  
APPLICANT'S ANSWER - PAGE 1 of 7

**NEWMAN & NEWMAN, ATTORNEYS AT LAW, LLP**  
505 Fifth Avenue South, Suite 610  
Seattle, Washington 98104  
phone: (206) 274-2800  
fax: (206) 274-2801

Trial and Appeal Board, and dated May 1, 2003. Spam Arrest LLC (“Spam Arrest”) answers the Petition for Cancellation (“Cancellation”) as follows:

1. The averments of Paragraph 1 of the Cancellation (herein referred to as a “Paragraph”) are admitted.

2. In answer to the averments of Paragraph 2, Spam Arrest admits that Hormel Foods Corporation and Hormel Foods, LLC (“Petitioners”) are the owners of the registered trademark SPAM and the family of SPAM trademarks, that the United States Registrations include Nos. 755,187, 1,338,031, 1,415,969, 1,498,745, 1,505,620, 1,716,102, 1,985,602, 2,057,484, 2,373,313, and 2,639,240. However, Spam Arrest, is without knowledge or information sufficient to form a belief as to the truth of the remaining averments of Paragraph 2, and based thereon denies all remaining averments of Paragraph 2.

3. The averments of Paragraph 3 are admitted.

4. In answer to the averments of Paragraph 4, Spam Arrest admits to the existence of a website accessible via the Uniform Resource Locator <<http://www.spam.com>> (the “Site”). Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining averments set forth in Paragraph 4, and based thereon denies each and every averment.

5. Spam Arrest is without knowledge or information sufficient to form a belief as to the truth of the averments in Paragraph 5, and based thereon Spam Arrest denies each and all of these averments.

6. The averments of Paragraph 6 are admitted.

7. The averments of Paragraph 7 are denied.
8. The averments of Paragraph 8 are denied.
9. The averments of Paragraph 9 are denied.
10. The averments of Paragraph 10 are denied.
11. The averments of Paragraph 11 are denied.
12. The averments of Paragraph 12 are denied.
13. The averments of Paragraph 13 are denied.
14. The averments of Paragraph 14 are denied.

#### **AFFIRMATIVE DEFENSES**

In further answer to the Petition, Spam Arrest asserts the following affirmative defenses:

##### **Spam is Generic When Used to Describe Unsolicited E-mail**

15. As evidenced by entries in several dictionaries, and references in periodicals, newspaper reports, and articles, the term “spam” has become widely used by the general public to refer to and denote unsolicited commercial e-mail (“UCE”).

16. The term “spam” is widely used by legislators, commentators, judges, and industry experts to describe UCE.

17. The term “spam” when used in connection with UCE, and any products or services relating to UCE, is generic and therefore, not by itself entitled to any trademark or service mark protection when used to describe UCE or when used with reference to any products or services relating to UCE.

18. Spam Arrest should thus be entitled to use the term “spam” as part of the “SPAM ARREST” mark since in this context the term “spam” is being used only to denote or describe UCE.

**Acquiescence and Estoppel**

19. Petitioners have acquiesced in Spam Arrest’s and others’ use of the term “spam” with respect to UCE, by posting statements on the Site that Petitioners do not object to use of the term “spam” to describe UCE.

20. Petitioners have acquiesced in Spam Arrest’s and others’ use of the term “spam” with respect to UCE by making statements through its representatives to the effect that Petitioners do not object to use of the term “spam” to describe UCE.

21. Petitioners should be equitably estopped from asserting trademark or service mark rights in the term “spam” with respect to UCE and any related products or services. Petitioners have made statements that Petitioners do not object to the use of this term to describe UCE, Spam Arrest has reasonably and detrimentally relied on such statements and, due to Spam Arrest’s reasonable and detrimental reliance on Petitioners’ statements, material prejudice would result if Petitioners were now allowed to assert rights in the term “spam” with respect to UCE.

**No Likelihood of Confusion**

22. There is no likelihood of confusion between the origin of Petitioners’ products and services and the products and services of Spam Arrest.

23. Petitioners have registered the “SPAM” mark and family of marks with respect to

food products, clothing and entertainment services. Spam Arrest seeks to register the “SPAM ARREST”<sup>1</sup> mark with respect to software, technology and related services for the purpose of blocking and filtering UCE.

24. Because the products and services of Spam Arrest and Petitioners are dissimilar, there is no likelihood that consumers would believe that Petitioners are associated in any way with Spam Arrest or Spam Arrest’s products or services. Nor is there any likelihood that consumers would believe that Petitioners endorse Spam Arrest or any of Spam Arrest’s products or services.

25. The products and services of Spam Arrest and Petitioners are marketed through different and distinct marketing channels. Petitioners’ products are primarily marketed through channels where food and food-related products are generally marketed. Spam Arrest’s products and services, on the other hand, are marketed through channels where computers, software and related services are marketed. Because there is no overlap of marketing channels, there is no likelihood of confusion with respect to Spam Arrest and its relationship to Petitioners or with respect to any Spam Arrest products or services.

26. The products and services of Spam Arrest and Petitioners are distributed through vastly different channels. Petitioners products are primarily distributed through channels where food and food-related products are distributed. Spam Arrest’s products and services are distributed through channels where computers, software, and related products and services are

---

<sup>1</sup> While Spam Arrest denotes the “SPAM ARREST” mark in all capital letters (due to protocol), Spam Arrest uses the mark in all lower case letters (*e.g.*, “spam arrest”) and denotes the same in its application.

distributed. Because there is no overlap of distribution channels, there is no likelihood of confusion with respect to Spam Arrest and its relationship to Petitioners or with respect to any Spam Arrest products or services.

**RELIEF REQUESTED**

27. Spam Arrest respectfully requests that the Petition be dismissed and that Spam Arrest be granted its attorney's fees and costs in defending against the Petition.

Dated this 29<sup>th</sup> day of March, 2004.

Respectfully Submitted

**NEWMAN & NEWMAN  
ATTORNEYS AT LAW, LLP**

By: 

Derek A. Newman, WSBA No. 26967  
Venkat Balasubramani, WSBA No. 28269

505 Fifth Avenue South, Suite 610  
Seattle, WA 98104  
(206) 274-2800 Telephone  
(206) 274-2801 Facsimile  
Attorneys for Registrant, Spam Arrest, LLC


**PROOF OF SERVICE**

The person whose signature appears below confirms that **APPLICANT'S ANSWER TO THE PETITION FOR CANCELLATION** (the attached document) has been served upon the other parties as set forth herein. The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service, "Express Mail Post Office to Addressee" in an envelope addressed to:

WILLIAM D. SHULTZ  
Merchant & Gould P.C.  
P.O. Box 2910  
Minneapolis, MN 55402  
612/332-5300

Express Mail mailing label number EM984741953 US 800

By: \_\_\_\_\_

  
Venkat Balasubramani