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TRADEMARK

UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD



In the matter of Trademark Registration No. 2,701,493
Registered on March 25, 2003

05-05-2003

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #22

HORMEL FOODS CORPORATION and
HORMEL FOODS, LLC
Petitioners,

)
) Cancellation No. _____
)

) Mark: SPAM ARREST
)

v.

) Registration No. 2,701,493
)

SPAM ARREST, LLC.

) Filed: November 27, 2001
)

Registrant.

) Registered: March 25, 2003
)
)

PETITION FOR CANCELLATION

Petitioners, Hormel Foods Corporation, a Delaware corporation, and Hormel Foods, LLC, a Minnesota limited liability company ("Petitioners"), having their principal place of business at 1 Hormel Place, Austin, Minnesota 55912-3680, believe that they are damaged by the registration of the mark shown in U.S. Trademark Registration No. 2,701,493 issued March 25, 2003, the owner of record of which is Spam Arrest, LLC., ("Applicant"), a Washington limited liability company (hereinafter referred to as "Registrant") with a place of business at 9714 23rd Avenue NW, Seattle, WA 98117, and hereby petition for cancellation of said registration of the mark.

The grounds for cancellation are as follows:

1. Registrant has obtained under the provisions of the Trademark Act of 1946, as amended, registration on the Principal Register of the trademark SPAM ARREST for "Computer

software, namely, software designed to eliminate unsolicited commercial electronic mail” in International Class 9. The date of first use alleged by Registrant is August 24, 2002.

2. Petitioners are the owners of the registered trademark SPAM and the family of SPAM trademarks. Hormel Foods has used the trademark SPAM for more than sixty years, and that use has expanded over the years to include a variety of goods and services. From its first use in connection with canned meat product, Hormel Foods has registered the SPAM trademark for use in connection with t-shirts; wearing apparel; caps; kitchen hand tools, namely slicers; jewelry, namely watch, necklace, earrings, and tie tack; playing cards, pencils and pens, mugs and insulated beverage containers, tennis balls, golf balls, money banks, toys; and entertainment services, namely participating in automobile races; poultry, processed meats, and deviled luncheon meat spread. 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.

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. 2,059,462; SPAMBURGER for processed meat, Registration No. 1,819,104; 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. 2,561,571; 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. 2,478,066.

4. Petitioners also use and own all right, title, and interest in the SPAM trademark used in connection with a variety of other goods and services, including clocks, knives, recipe books,

giftwrap, mousepads, and entertainment celebrations. Petitioners also have and maintain a SPAM website to promote their goods and services at www.spam.com.

5. There is no issue of priority concerning adoption and use by Petitioners of their federally registered mark and any alleged use of the mark SPAM ARREST by Registrant. Petitioners have continuously used and extensively advertised the trademark SPAM and the SPAM family of marks throughout the United States (as well as in foreign commerce) for many years. This use pre-dates Registrant's claimed first use date of August 24, 2002, by many years. The SPAM trademark is famous, highly distinctive and recognized by the public as identifying the goods and services of Petitioners.

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

7. Petitioners' marks have been used throughout the U.S., have been advertised and promoted by Petitioners, and the marks have developed and represent valuable, substantial, and exclusive goodwill and reputation inuring to the benefit of Petitioners. This goodwill and reputation is harmed by the use and registration of the mark SPAM ARREST registered by Registrant. Petitioners' marks are arbitrary and fanciful with trademark significance to purchasers and potential purchasers.

8. Registrant's SPAM ARREST mark so resembles Petitioners' SPAM trademark and their SPAM family of marks as to be likely, when applied to the Registrant's services, to cause confusion, mistake, or to deceive as to the source of origin of Registrant's services by creating the erroneous impression that those services originate with, are sponsored by, approved or endorsed by, licensed by, affiliated or associated with, or in some other way legitimately connected to Petitioners.

9. The registration of the SPAM ARREST mark to Registrant is contrary to 15 U.S.C. § 1052 (d) and violates or diminishes the prior and superior rights of Petitioners in their SPAM trademark and the family of SPAM marks.

10. The registration of the SPAM ARREST mark to Registrant is also contrary to 15 U.S.C. §§ 1052 and 1125 (c) and dilutes the distinctive quality of Petitioners' SPAM trademark and family of SPAM marks.

11. The use and continued registration by Registrant of the mark SPAM ARREST is likely to cause confusion or to cause mistake or deception in the marketplace, and among purchasers and potential purchasers, with Petitioners' previously used and duly registered mark SPAM and their family of SPAM marks, resulting in damage to Petitioners.

12. The use and continued registration by Registrant of the mark SPAM ARREST dilutes the distinctive quality of Petitioners' previously used and duly registered mark SPAM and their family of SPAM marks, resulting in damage to Petitioners.

13. In the alternative, SPAM ARREST is generic or merely descriptive of Registrant's services. The mark SPAM ARREST describes the purpose, function, and use of the service with which it is used. The registration of SPAM ARREST is contrary to 15 U.S.C. § 1052(e)(1).

14. Petitioners are damaged by Registrant's registration of the SPAM ARREST mark because Registrant has obtained statutory rights in the mark in violation and in derogation of the established prior rights of Petitioners in their SPAM trademark and family of SPAM marks.

WHEREFORE, Petitioners pray that Registration No. 2,701,493 be cancelled under Section 14, subparagraph 3 of the Lanham Act, 15 U.S.C. § 1064 and that this Petition for Cancellation be sustained in favor of Petitioners.

Please direct all correspondence to:

Allen W. Hinderaker
MERCHANT & GOULD P.C.
PO Box 2910
Minneapolis, MN 55402-9944

The Petitioners herein appoint Allen Hinderaker; William D. Schultz; Scott W. Johnston, Reg. No. 39,721; Brian H. Batzli, Reg. No. 32,960; John L. Beard, Reg. No. 27,612; Linda M. Byrne, Reg. No. 32,404; John A. Clifford, Reg. No. 30,247; Kristina M. Foudray; Gregory C. Golla; Curtis B. Hamre, Reg. No. 29,165; Anna Manville; Daniel W. McDonald, Reg. No. 32,044; Gregory A. Sebald, Reg. No. 33,280; and Paul A. Welter, Reg. No. 20,890, their attorneys to transact all business in the U.S. Patent and Trademark Office related to this matter with full power of substitution.

Accompanying the duplicate signed copies of this Petition for Cancellation is the required fee of \$600.00. Please charge any excess fees or credit any overpayment to the Deposit Account No. 13-2725 of Petitioners' counsel noted below.

Respectfully submitted,

Dated: May 1, 2003

HORMEL FOODS CORPORATION and
HORMEL FOODS, LLC

By their attorneys,



Allen W. Hinderaker
William D. Schultz
Merchant & Gould P.C.
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Minneapolis, MN 55402
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CERTIFICATE OF MAILING

I hereby certify that this PETITION FOR CANCELLATION is being deposited with the U.S. Postal Service by First Class Mail, in an envelope addressed to the Commissioner for Trademarks, Box TTAB FEE, 2900 Crystal Drive, Arlington, VA 22202-3513 on this 1st day of May, 2003.



Allen W. Hinderaker

TTAB

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A Professional Corporation

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HORMEL FOODS, LLC)
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SPAM ARREST, LLC) Mark: SPAM ARREST
Registrant)



05-05-2003

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Mark: SPAM ARREST
Registration No.: 2,701,493
Docket Number: 3370.217USTB
Registered: March 25, 2003

Filing Date: November 27, 2001

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope addressed to: Commissioner for Trademarks, Box TTAB, 2900 Crystal Drive, Arlington, VA 22202-3513, on May 1, 2003.
By: Carol A. Schipper
Name: Carol A. Schipper

Commissioner for Trademarks
Box TTAB
2900 Crystal Drive
Arlington, VA 22202-3513

05 JUN 17 01 59:31

Dear Commissioner:

We are transmitting herewith the attached:

- Return postcard.
- Transmittal Sheet in duplicate containing Certificate Under 37 C.F.R. 1.8
- Petition for Cancellation (1 Original and 1 Copy)
- Check in the amount of \$600.00 to cover Petition (2 Petitioners).

Please charge any additional fees or credit overpayment to Deposit Account No. 13-2725. A duplicate copy of this sheet is enclosed.

By: Allen Hinderaker
Name: Allen Hinderaker
AWH:cas

(CONTESTED MATTER)