

Holy Mackerel Salmon! Rare Trademark Dilution Win

by Robert B. Burlingame

For the first time in years, the U.S. Patent and Trademark Office's Trademark Trial and Appeal Board ("TTAB") on June 11 issued a precedential decision sustaining an opposition based on a likelihood of trademark dilution. The decision (see <http://ttabvue.uspto.gov/ttabvue/ttabvue-91166701-OPP-99.pdf>) gives owners of well-known marks renewed hope of halting the unauthorized registration of similar marks without having to establish a likelihood of confusion. This rare outcome also illustrates the critical role that evidence—such as a well-designed consumer survey—plays in trademark dilution claims.

Important Practice Pointers

- Keep accurate records detailing the full extent of the use of your trademarks.
- Frequently monitor any authorized use of your trademarks by others (and document such monitoring efforts).
- Consider what steps to take against unauthorized use of your trademarks by others.
- Obtain trademark registrations (U.S. and abroad) covering your goods/services.
- Trademark fame is dependent on extensive, long-standing use and promotion.
- Hire reputable, experienced trademark survey companies to help prove fame.
- Consult a trademark attorney before using, applying to register, or challenging, a mark.

"THE OTHER RED MEAT" Held Likely to Dilute "THE OTHER WHITE MEAT"

On February 4, 2004, Supreme Lobster and Seafood Company filed a U.S. trademark application seeking to register the mark THE OTHER RED MEAT for "fresh and frozen salmon." The Trademark Office Examining Attorney did not raise any objections to registration, and the application was published in July 2005, at which time the National Pork Board and the National Pork Producers Council both came forward to oppose the application. The opposition was officially filed in September 2005, and the TTAB's historic decision was issued nearly six years later.

In their opposition, the National Pork Board and the National Pork Producers Council argued that: (i) the mark THE OTHER RED MEAT for "fresh and frozen salmon" so resembles the opposers' mark THE OTHER WHITE MEAT (which has been used and registered for "promoting the interests of members of the pork industry" and various other goods and services other than fish) as to be likely to cause confusion, to cause mistake or to deceive under 15 U.S.C. § 1052(d); and (ii) registration of the mark THE OTHER RED MEAT for "fresh and frozen salmon" would result in a likelihood of dilution under 15 U.S.C. § 1125(c).

Likelihood-of-confusion claims are quite common in U.S. trademark oppositions, and even in oppositions involving both likelihood-of-confusion and likelihood of dilution claims, the TTAB has typically rendered its decisions based on likelihood-of-confusion without making a determination on the likelihood-of-dilution claim. Consequently, the TTAB's decision in this case is truly unique in that the TTAB refrained from making a determination on the likelihood-of-confusion claim and instead sustained the opposition based on the likelihood-of-dilution claim.

The Test for Likelihood of Dilution by Blurring

The TTAB considered three key questions in determining whether there was a likelihood of dilution by blurring:

1. Is the opposer's mark famous (among a broad spectrum of the general consuming public)?
2. Did the opposer's mark become famous prior to the date of the application being attacked?
3. Is the opposed mark likely to blur the distinctiveness of the opposer's famous mark?

Based on the substantial evidence discussed below, the TTAB found that the opposers' mark THE OTHER WHITE MEAT is famous and became so prior to the 2004 filing date of the trademark application for THE OTHER RED MEAT. As to whether the mark THE OTHER RED MEAT would likely blur the distinctiveness of the famous mark THE OTHER WHITE MEAT, the TTAB evaluated the non-exclusive statutory factors set forth in 15 U.S.C. § 1125(c)(2)(B):

- the degree of similarity between the opposed mark and the famous mark;
- the degree of distinctiveness of the famous mark;
- the extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark;
- the degree of recognition of the famous mark;

- whether the owner of the opposed mark intended to create an association with the famous mark; and
- whether there has been any actual association in the marketplace between the opposed mark and the famous mark.

After weighing and considering such factors, the TTAB found that there was a likelihood of dilution by blurring.

The Key: Extensive Use and Promotion + Careful Supporting Surveys

As only famous marks enjoy protection against dilution, it is important to consider how to establish fame. In the present case (as in nearly all trademark dilution cases), the finding of likelihood of dilution hinged largely on substantial evidence of extensive use and promotion of the opposers' mark, combined with professional trademark surveys illustrating widespread consumer recognition of the opposers' mark.

The TTAB noted that the mark THE OTHER WHITE MEAT was extensively used and promoted via:

- Nationwide ads starting in early 1987.
- Print ads, radio, television, billboards, taxi cabs, transit shelters.
- Websites (with the mark appearing on numerous pages in each site + heavy web traffic).
- \$500 million in "demand enhancement activity".
- \$50 million in promotional and marketing activities by state associations.
- Co-branded ad campaigns with retailers and well-known food manufacturers.
- In-store promotional items (floor displays, recipe cards, promotional banners, etc.).
- Celebrity spokespersons.
- Sale/distribution of collateral merchandise (cookbooks, t-shirts, cooking utensils, etc.).
- Ads by supermarkets in their weekly newspaper circulars.
- Harvard Business School used the campaign for years as a case study.
- College textbooks, news reports and other third-party publications.
- References to the mark in popular culture (TV shows, game shows, comic strips, etc.).

The opposers also bolstered this evidence with consumer surveys, including surveys that were conducted prior to the opposition and, perhaps most importantly, prior to the filing date of the opposed application:

- Since 1987, the opposers had conducted semi-annual tracking surveys through independent research firms, which surveys consistently showed that 85% or more of consumers nationwide were aware of the mark THE OTHER WHITE MEAT in connection with pork.

- In 2000, Northwestern University conducted a study that found that the mark THE OTHER WHITE MEAT was the fifth most-recognized advertising slogan in America among the general adult population at that time. The university created a list of 25 popular slogans and conducted more than 1,000 phone interviews where, for each of the 25 slogans, the interviewer asked the respondent whether he/she recognized the slogan, and if the answer was yes, the respondent was asked to what brand, product or industry he/she attributed the slogan. The survey was arguably neutral in that it was not designed with the mark THE OTHER RED MEAT in mind, and it also helped the opposers satisfy the test for likelihood of dilution by demonstrating that the mark THE OTHER WHITE MEAT had achieved fame before the application for THE OTHER RED MEAT was filed.
- In 2007 (and in connection with the opposition), Applied Marketing Science, Inc. conducted a study that found that more than 35% of the survey respondents associated the Supreme Lobster and Seafood Company's mark THE OTHER RED MEAT with the opposers' mark THE OTHER WHITE MEAT or the pork products the opposers' mark promotes. A recording of the phrase THE OTHER RED MEAT was played, and the respondent was asked whether, thinking about the slogan he/she had just heard, any other advertising slogans or phrases came to mind. If the respondent answered yes, he/she was asked what other advertising slogan or phrase came to mind.

Given their importance in proving fame in trademark dilution cases, surveys are often vigorously attacked with respect to their methodology and reliability. While it may seem simple to create a survey that queries whether consumers have heard of a mark or associate it with another, pitfalls abound with respect to the questions, interview techniques, target audiences and the like. Indeed, in the present case, the TTAB emphasized that the study by Northwestern University "was conducted by a well-regarded market research firm according to generally accepted survey procedures" and that the study by Applied Marketing Science, Inc. was conducted "by qualified persons following proper interview procedures, and in a manner that ensured objectivity." Such factors are critical to support survey results showing fame of a mark.

Conclusion

An improper or inadequate survey or a lack of sufficient evidence and supporting arguments regarding fame could result in a harmful decision declaring that your mark is not famous. Therefore, it is crucial that proactive steps be taken and that trademark owners seek sound legal advice from a trademark attorney, especially before attacking, or defending against, another's mark on the grounds of dilution.

If you have any questions regarding the content of this advisory, please contact the Pillsbury attorney with whom you regularly work or the author below.

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