

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

Hearing:
April 26, 2007

Mailed:
August 17, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

ProMark Brands Inc.

v.

Schwan's IP LLP

Opposition No. 91159653
to application Serial No. 76402450
filed on May 1, 2002

Thomas H. Curtin and Gianfranco Mitrione of Lathrop & Gage
L.C. for ProMark Brands Inc.

Scott W. Johnston and Gregory C. Golla of Merchant & Gould
P.C. for Schwan's IP LLP

Before Seeherman, Kuhlke and Cataldo, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

ProMark Brands Inc. has opposed the application of
Schwan's IP LLP to register SMARTPIZZA for pizza.¹ As
grounds for opposition, opposer has alleged that, since
prior to applicant's claimed date of first use, opposer and

¹ Application Serial No. 76402450, filed May 1, 2002, asserting
first use and first use in commerce on February 23, 2001.

Opposition No. 91159653

its predecessors and licensee have sold a variety of food products, including frozen entrees, under the mark SMART ONES; that opposer is the owner of two registrations, Nos. 1911590 and 2204080 for SMART ONES; that since prior to applicant's claimed date of first use opposer has used the mark SMART ONES for pizza products; that applicant's mark SMARTPIZZA for pizza is confusingly similar to opposer's SMART ONES trademark; and that applicant's use of SMARTPIZZA for pizza is likely to cause confusion or to cause mistake or to deceive purchasers.

In its answer applicant denied the salient allegations in the notice of opposition, and asserted various affirmative defenses, including estoppel, waiver and unclean hands,² and well as other "defenses" that go to the likelihood of confusion claim.³ Applicant also counterclaimed to cancel opposer's unpleaded registration No. 1871763, on the ground of fraud, asserting that, although the registration included the item "pizza," at the time opposer filed its Statement of Use on April 8, 1994 in support of the underlying application, opposer was not using the mark SMART ONES on pizza, and that opposer did not use

² Applicant did not pursue these affirmative defenses in its brief, so we deem them to be waived.

³ To the extent applicant has discussed these "defenses" in its brief, they are not "affirmative defenses" but relate to the ground of likelihood of confusion and we have therefore considered them in that context.

Opposition No. 91159653

the mark SMART ONES on pizza before 2002; and that the portion of opposer's Statement of Use that it was using the mark SMART ONES on pizza was false and opposer knew it to be false.

Opposer answered the counterclaim by denying the salient allegations, except that it "alleges that the use in commerce of SMART ONES for pizza commenced on November 30, 1997." Opposer also stated that it filed a voluntary surrender of the registration.

In view of the voluntary surrender of the registration, and the fact that applicant (the counterclaim petitioner) did not consent to it, on March 28, 2005 the Board granted the counterclaim and entered judgment against opposer in the counterclaim. Thus, the only issue before the Board in this opposition proceeding is that of priority/likelihood of confusion between opposer's marks and applicant's mark.

The case has been fully briefed,⁴ and both parties were represented at a hearing before the Board.

The record includes the pleadings; the file of the opposed application;⁵ the testimony, with exhibits, of

⁴ In its brief opposer failed to provide USPQ citations for certain of the decisions listed in its Table of Authorities. "When cases are cited in a brief, the case citation should include a citation to *The United States Patent Quarterly* (USPQ), if the case has appeared in that publication." TBMP §801.03.

⁵ It is noted that applicant submitted portions of this file under a notice of reliance. Because the application file is of record by operation of the rule, such submission was not necessary.

Opposition No. 91159653

opposer's witnesses Marion Findlay, an employee of H.J. Heinz Company and Senior Manager of Consumer Promotions, and Michael Hsu, Vice President of Meals and Potatoes for Heinz North America; and the testimony, with exhibits, of applicant's witness, Katherine A. McGillivray, applicant's category marketing manager. Opposer has submitted, under notice of reliance, printed materials obtained through a search of the Lexis/Nexis database; certain of applicant's responses to opposer's requests for admission; certain of applicant's responses to opposer's interrogatories, including documents that were produced in response to interrogatories; printouts from the USPTO TTABVUE database showing the status of two oppositions brought by opposer against third parties' applications; and status and title copies of opposer's two pleaded registrations, as well as two additional registrations, all for SMART ONES in typed form, as follows:⁶

SMART ONES for "frozen entrees consisting primarily of chicken, beef, fish and/or vegetables" (Class 29) and "frozen entrees consisting primarily of pasta and/or rice alone or in combination with other foods" (Class 30);⁷

⁶ Although the latter two registrations were not pleaded in the notice of opposition, applicant has treated them as being of record, and we therefore deem the notice of opposition to be amended pursuant to F.R.C.P. 15(b). See p. 3 of applicant's trial brief: "The first Notice of Reliance, filed November 14, 2005, makes of record ProMark's U.S. Trademark Registration Nos. 1,911,590, 2,204,080, 2,916,538 and 2,916,539."

⁷ Registration No. 1911590, issued August 15, 1995; Section 8 & 15 affidavits accepted and acknowledged; renewed.

Opposition No. 91159653

SMART ONES for "frozen desserts consisting of milk based or milk substitute based desserts, cakes, pies and mousses: (Class 30);⁸

SMART ONES for "pizza" (Class 30);⁹ and

SMART ONES for "pre-cooked ready-to-eat frozen bread or wrap having a meat and/or vegetable filling with or without cheese" (Class 30).¹⁰

Applicant has submitted, under notice of reliance, opposer's responses to applicant's requests for admission and its responses to certain of applicant's interrogatories, including documents products in response to those interrogatories; certain documents produced by opposer in response to applicant's document production request, and authenticated by opposer in its response to a request for admission;¹¹ several books (printed publications) having the word "SMART" in their titles; and copies of 112 third-party registrations and applications for marks containing the word or element "SMART" and copies of portions of the

⁸ Registration No. 2204080, issued November 17, 1998; Section 8 & 15 affidavits accepted and acknowledged.

⁹ Registration No. 2916538, issued January 4, 2005.

¹⁰ Registration No. 2916539, issued January 4, 2005

¹¹ At footnote 7 of its brief, and again in its reply brief, opposer has objected to search reports that applicant submitted under its notice of reliance, as constituting hearsay and not having been properly authenticated. However, they were authenticated by opposer's response to Applicant's Request for Admission No. 48. Thus, the search reports are properly of record for whatever probative value they may have. As such, they are proof that the various marks were listed on the search reports, but not proof that the registrations are subsisting or the marks shown therein are in use.

Opposition No. 91159653

registration files for two of opposer's registrations (official records).

During its rebuttal testimony period opposer submitted a supplemental notice of reliance consisting of dictionary definitions of the word "pizza"; third-party registrations for marks containing the word "pizza" for goods which include the word "pizza" in their identification, and which include a disclaimer of "pizza"; and a copy of an application for the mark SMART PIZZA filed by a third party. Opposer states that these materials are to rebut applicant's evidence of third-party registration and use of SMART marks and thereby show that SMART is the origin-indicating part of applicant's mark. Applicant has objected to this evidence as being improper rebuttal. We overrule the objection. Applicant has asserted, based on its evidence of third-party registration and use, that SMART is a descriptive term that should be given no more importance than PIZZA, and opposer's evidence is therefore appropriate rebuttal.

We add that even if we did not consider this evidence, it would not affect our decision herein. There can be no doubt that "pizza" is a generic term. Both opposer and applicant have identified their goods as "pizza" in their respective registration and application, and both have used "pizza" generically in the advertising and promotional materials they have made of record. Their witnesses have

Opposition No. 91159653

also referred to their products as "pizza." Further, even if the dictionary definitions were not of record, the Board may still take judicial notice of them. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). As for the third-party application file, applicant argues that because opposer submitted it during the rebuttal testimony period, applicant was precluded from submitting evidence regarding applicant's protest of this application. However, a third-party application is probative only to show that the application was filed. Thus, applicant can suffer no prejudice by not being able to submit evidence regarding its own activities with respect to the application.

Applicant has also objected, on the ground of hearsay, to Exhibits 60 and 61, which were introduced with the testimony of opposer's witness Michael Hsu. These exhibits purport to show gross sales, broken down by item, for opposer's SMART ONES products, for FY 1998 (exhibit 60) and FY 1999-2004 (Exhibit 61). We overrule this objection. Mr. Hsu testified that these exhibits report information taken from Heinz's "data warehouse which is built off our internal sales records," test., p. 21, and answered affirmatively the question as to whether "these sales records are maintained by Heinz in the ordinary course of business" test., p. 18.

Opposition No. 91159653

Although opposer's attorney could have elicited more details from Mr. Hsu regarding how the summaries shown in exhibits 60 and 61 were obtained, we consider the testimony sufficient to show that the underlying data is part of Heinz's records kept in the ordinary course of business, and that the exhibits are a summary of that information. In any event, Ms. Findlay testified as to the general dollar sales for the last five years for SMART ONES products in general and for SMART ONES pizza products, so even if we did not consider the detailed breakdown shown in exhibits 60 and 61, it would not affect our decision herein because the record still reflects that opposer has made extensive sales of its SMART ONES products.¹² It also appears that applicant's purpose in challenging this evidence relates to the issue of priority. Applicant asserts that the "documents do not show widespread national use of the SMART ONES mark on pizza products before Schwan's date of first use," brief, p. 17. However, as discussed infra, opposer is not required to prove common law rights for pizza because it owns a

¹² We note that during Ms. Findlay's testimony deposition applicant raised certain objections to her testimony, but these objections were not maintained by applicant in its trial brief, so they are deemed waived. Applicant has also asserted that there are inconsistencies in the numbers provided by Ms. Findlay and Mr. Hsu. However, the only inconsistency is that Ms. Findlay at one point in her testimony (p. 20) apparently confused the numbers for the dollar sales of SMART ONES pizza with the case sales. Shortly thereafter she referred to the dollar and case sales of the pizza (p. 28), and these figures and those Mr. Hsu testified to are substantially the same.

Opposition No. 91159653

registration for SMART ONES for pizza. Thus, even if we did not consider the specific figures set forth in Exhibits 60 and 61, it would not affect our decision on the issue of priority.

Finally, we note that opposer, at footnote 2 of its reply brief, reiterates an objection that it had raised during Ms. McGillivray's testimony deposition. We have given this objection no consideration. While a party must reiterate an objection in its brief or it will be deemed to be waived, by waiting until its reply brief to reiterate its objection opposer has afforded applicant no opportunity to respond.

The record shows that opposer, which is a wholly-owned subsidiary of the H.J. Heinz Company, is the owner of the above-listed registrations, and that opposer has licensed the use of the mark to Heinz North America, which uses it as part of its Weight Watchers International group. Because Heinz is the only user of the mark, unless otherwise noted, hereafter our references to opposer's activities with respect to use and promotion of the mark refer to Heinz's activities. Opposer began using the mark SMART ONES in 1992 for a line of frozen food products targeted to individuals who are committed to a healthy life style. The mark WEIGHT WATCHERS also prominently appears on the packaging for the products. The mark is currently used for a complete line of

Opposition No. 91159653

food items--entrees, "bowls," pizza, sandwiches, desserts and breakfasts. The SMART ONES products have two price points. The Bistro Selections group is the higher-tier line, with a price point of \$3.19, while the lower tier price point is from \$2.59-\$2.99.

Opposer began using the SMART ONES mark for frozen pizza in November 1997, in both its high-tier and lower-tier line. It sells a variety of pizzas, including cheese, vegetable, sausage and pepperoni. The goods are sold primarily through grocery stores, including chain stores such as Safeway and Kroger's, and independents such as Wegman's and Giant Eagle. Twenty percent are sold in mass market stores such as Wal-Mart and Super Target, with the remaining 1-2% in club stores such as Costco.¹³

Opposer advertises its SMART ONES products through television, with spot ads on both network and cable television, in particular on ESPN and ABC in connection with opposer's sponsorship of the U.S. Figure Skating Association and Skate America. Opposer also promotes the brand through Internet, direct mail and in-store advertising, and in print media, in particular, through free-standing inserts, which

¹³ Opposer's sales figures were designated as confidential, so we will not set them out in this opinion.

Opposition No. 91159653

are coupon supplements in newspapers. A substantial amount of money is spent each year for coupon redemption.¹⁴

Applicant uses SMARTPIZZA as a trademark for frozen pizza that is sold in the school food service market. It began using the mark on February 23, 2001, and promotes the product as being healthier than other pizza products, e.g., lower in fat and sodium, and higher in fiber. The product is bought by school food service directors, and school children in grades kindergarten to 12 are the ultimate consumers. The pizza is typically served as part of an entire meal, which may cost in the \$1.50 range; it may also be offered a la carte as a snack item. Applicant advertises to food services directors, including through emails and at trade shows; applicant also produces posters which can be found in school cafeterias and be seen by the students, and nutrition fact sheets that may be given to students and their parents. About 2000 posters were printed in 2004, and at least 10,000 sheets were given out at a trade show in 2005. Schools may also place applicant's SMART PIZZA mark on the menus which are made available to the students and their parents.¹⁵

¹⁴ Again, opposer's advertising and promotion figures were marked confidential.

¹⁵ Applicant has marked its sales and advertising figures as confidential.

Opposition No. 91159653

In view of the fact that status and title copies of opposer's four registrations, as set forth above, are of record, priority is not in issue. *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Applicant contends that opposer "does not have a prior federal registration for pizza, and must prove common law use prior to Schwan's registration date." Brief, p. 15. This statement is incorrect. First, applicant does not have a registration. Second, it is apparently applicant's belief that the filing date of the application maturing into opposer's registration must predate any use made by the applicant. See footnote 4 of applicant's brief, at p. 34. ("the registration would only grant rights back to the filing date, which is after Schwan's filing and first use dates"). However, as the King Candy case states, if the opposer owns a registration, priority is not in issue. In any event, the record shows that opposer began using the mark SMART ONES in 1992 for frozen food products, and specifically for frozen pizza in November 1997, prior to applicant's first use in 2001.

This brings us to the issue of likelihood of confusion. Our determination of this issue is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In*

Opposition No. 91159653

re Majestic Distilling Co., Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

We turn first to the du Pont factor of the similarity of the goods. Here the goods, which are identified as "pizza" in opposer's registration No. 2916538 and in applicant's application, are legally identical. Thus, they must be deemed to be sold in the same channels of trade and to the same purchasers. We note that at present applicant's goods are, in fact, sold only in the school food service market. However, "the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed." *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). See also, *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). In addition, opposer also has registrations for and uses its SMART ONES mark on other closely related goods to pizza, including such Italian meal entrees as chicken fettuccine and shrimp marinara. The du Pont factors of the similarity of goods and channels of trade thus favor opposer.

Opposition No. 91159653

In addition, the factor of the conditions of purchase favors opposer. Pizza is a rather inexpensive food item that is bought by the general public. Opposer's boxes of frozen pizza retail in the \$3.00 range, which is inexpensive, and may be purchased on impulse. Although opposer's target customer is a person who is interested in a healthy lifestyle, pizza may be purchased by anyone, including people who will not necessarily examine the box to determine how healthful the product is. Applicant's pizza is currently bought by school districts for use in school cafeterias, so presumably the purchasers of applicant's product are more sophisticated and discriminating purchasers. However, because, as we have already stated, applicant's identification of goods contains no limitations as to channels of trade and types of purchasers, we must deem applicant's pizza to be sold through all channels appropriate for such goods, and to all appropriate purchasers. Thus, we must treat applicant's goods as items that can be bought by the general public as an impulse purchase.

We next consider the du Pont factor of the similarity of the marks. In considering this factor, we must also consider the factors of the strength of opposer's mark, and the evidence of third-party use because all three factors are heavily interrelated. We are presented with an

Opposition No. 91159653

interesting situation in that, while there is evidence that opposer has a strong mark, the word SMART, which is the element that is common to opposer's and applicant's mark, is a highly suggestive term.

With respect to the strength of opposer's mark, we are somewhat hampered in our discussion of this factor because opposer has marked its sales and advertising figures as confidential. We can say that opposer's sales of its SMART ONES products over the past five years, and its expenditures for advertising and promoting the products, are substantial, and are sufficient to demonstrate that opposer's mark SMART ONES is a strong mark for prepared frozen foods. We point out, though, that opposer does not claim that its mark is famous. Opposer did not plead that its mark is famous and in its brief opposer claimed only that its mark is a "strong mark." The Board confirmed at the oral hearing that opposer does not assert that its mark is famous. Thus, while we consider opposer's mark to be a strong one, it does not deserve the expanded scope of protection that is accorded to a famous mark. Compare, *Kenner Parker Toys Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

Although the evidence shows that the entire mark, SMART ONES, has achieved a degree of strength, at the same time we recognize that the word SMART has a highly suggestive

Opposition No. 91159653

significance. Applicant has made of record an extremely large number of third-party registrations for marks containing the word SMART for food products. For example, Registration No. 2597933 is for SMARTWRAP for "meat, poultry and/or beans filled together with additional ingredients and rolled inside a tortilla; Registration No. 1367966 is for SMARTFOOD for popcorn; Registration No. 1462095 is for SMART CUTS (CUTS disclaimed) for poultry; and Registration No. 1675998 is for SMARTBURGER for meat. These registrations are not evidence that the marks shown therein are in use, or that the public is familiar with them. In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993). However, third-party registrations may be used in the manner of dictionary definitions, to show that a term has a particular significance or meaning within an industry. See Tektronix, Inc. v. Daktronics, Inc., 187 USPQ 585 (TTAB 1975). The large number of registered marks containing the word SMART for food products is evidence that SMART is a highly suggestive term for such goods. This suggestive meaning is further supported by the excerpts of various books applicant submitted, with titles such as THE EVERYTHING SMART NUTRITION MINI BOOK, with the subtitle "What's healthy, what's not...the best food for you and your family" (Applicant's notice of reliance exhibit 39); EAT SMART Diet and Nutrition Guide (Exhibit 40); FOOD SMART!, with the

surtitled "Eat Your Way to Better Health" (exhibit 41); THE SMART BAKING COOKBOOK, with the subtitle "More than 180 recipes for heavenly, healthful eating" (exhibit 43).¹⁶ In fact, even opposer admits that "the term SMART suggests a healthier, better-for-you food product." Brief, p. 19.¹⁷

¹⁶ Applicant not only submitted copies of excerpts of these books under its notice of reliance, but the book titles were also identified by applicant's witness, Ms. McGillivray, at her deposition, as resulting from searches of Amazon.com and ebay.com. Opposer has made several criticisms of the exhibits, including that Ms. McGillivray did not also conduct searches using the Yahoo! and Google search engines. Such a criticism is simply not valid. Opposer could have done searches of other websites or used its preferred search engines and submitted such evidence in rebuttal if it believed that doing so would discredit the validity of Ms. McGillivray's search. In any event, the excerpts were properly submitted by applicant under notice of reliance pursuant to Trademark Rule 2.122(e) as printed publications, which are self-authenticating. Moreover, the exhibits submitted by Ms. McGillivray were authenticated by her as being the results of searches she had undertaken. Although neither Ms. McGillivray's searches nor the printed publications themselves show the extent of exposure of the books to the public, they are competent to show the manner in which SMART is used by the authors and would be understood by the readers/purchasers of the books.

¹⁷ Throughout its brief, applicant generally claims that the word SMART is descriptive of healthful food products. For example, applicant states, as a topic heading, "Consumers Have an Existing Awareness that the Term 'Smart' on Food Products Describes Healthy, Good-For-You Goods and Services." Brief, p. 9. However, the evidence of record does not establish that "SMART" is merely descriptive of food products, but is only highly suggestive. This evidence includes third-party registrations for "SMART" marks submitted by applicant, in which a descriptive or generic word combined with "SMART" is disclaimed, but the word SMART is not, thus indicating that the USPTO views "SMART" as the distinctive element that "carries" the mark. See, for example, Registration No. 2947154 for SMART CHICKEN, with CHICKEN disclaimed, for poultry; Registration No. 2926666 for GREAT TASTE SMART SNACK and design, with GREAT TASTE and SNACK disclaimed, for potato chips and tortilla chips; and Registration No. 2107921 for SNACK SMART, with SNACK disclaimed, for, inter alia, snack cakes, crackers and granola bars.

Opposition No. 91159653

In addition, applicant has submitted evidence of third-party use of a number of "SMART" marks. They include START SMART cereal from KELLOGG'S; SMART POP! for ORVILLE REDENBACHER'S popping corn; SMART BALANCE for both a buttery spread and popcorn; Q-SMART for a snack bar by The Quaker Oats Company; HEALTH SMART for ice cream; SMART DELI for ham-flavored meatless slices; SMART BACON for a meatless product; and SMART DOGS! for meatless franks. The latter three products all have the same house mark, LIGHTLIFE, but the other brands all reflect separate sources for the goods.¹⁸

The number of third-party uses of SMART marks suggests that consumers are able to distinguish between different SMART marks based on relatively small differences in the marks.¹⁹

¹⁸ These exhibits were made of record during the testimony deposition of Ms. McGillivray. In its brief applicant states that "these same products were purchased by counsel of record at a third grocery store on October 27, 2005, and again made of record in the deposition of Mr. Hsu and Ms. Findlay." Brief, p. 10. Information about counsel's purchasing goods is not in the record and has not been considered, although we have considered the testimony of the witnesses as to whether they had seen the products before.

¹⁹ Opposer argues that applicant provided no information about the extent of sales of these third-party products, but even opposer's witnesses testified that they were aware of some of them. Opposer also argues that the third-party "SMART" marks are for goods other than frozen pizza, and are therefore irrelevant. However, they are relevant to show whether consumers can distinguish among "SMART" marks for food products. Moreover, much of the evidence regarding the strength of opposer's SMART ONES mark derives from its use and advertising for food products other than pizza. Opposer cannot rely on these activities for its non-pizza products and at the same time claim that third-party use of marks for non-pizza food products is irrelevant.

Opposition No. 91159653

We must thus decide, as we compare opposer's mark SMART ONES with applicant's mark SMARTPIZZA, what role these competing considerations should have. It is obvious that, despite the strength of opposer's mark, opposer does not have exclusive rights to the word SMART, and the protection to be accorded to SMART ONES does not extend to prevent others from using any marks that have the word SMART. On the other hand, applicant's mark consists solely of the word SMART, combined with PIZZA, the generic name of the goods, which applicant itself has identified as "pizza." In the case of the various third-party uses of SMART marks made of record by applicant, each combines SMART with another word that consumers can use to distinguish the marks, e.g., SMART with START in SMART START, SMART with BALANCE in SMART BALANCE.²⁰ But the generic word PIZZA added to SMART does not provide such a distinguishing feature. That is, because PIZZA is the generic term for the goods, consumers will view applicant's mark as being essentially the word SMART, with the generic name of the goods added to it. In saying this, we recognize that we must compare the marks in their entirety, but it is a well-established principle that, in articulating reasons for reaching a conclusion on the issue

²⁰ We note that there are third-party uses of SMART BACON and SMART DOG! that, at first blush, appear to be the word SMART combined with a generic term. However, the goods involved are not bacon or hot dogs, but are meatless products. As a result, BACON and DOG are not generic terms for those goods.

of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). A generic term, by definition, has no source-indicating value. Moreover, applicant emphasizes the "SMART" portion of its mark in its promotional materials. For example, Bates No. SP00031 has the prominent headline "SWITCH TO SMART" (emphasis in original), and uses the phrase "Consider the SMART Choice!" (emphasis in original).²¹

We also consider that when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines. Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed.

²¹ Applicant asserts that "the fact that SMARTPIZZA comprises two descriptive terms does not impart additional brand significance to 'smart'." Brief, p. 27. It appears to be applicant's position that its mark consists of two descriptive terms, and that SMART would not be the dominant part of its mark. Aside from the oddness of this claim, with applicant essentially admitting that its mark is merely descriptive, we are not persuaded that SMART has lesser or the same significance as PIZZA in the mark SMARTPIZZA. As we have already stated, the evidence of record does not establish that the word SMART is descriptive of food products. Further, the word PIZZA is not just descriptive of applicant's goods, but is the generic name of them. Thus, SMART is the source-identifying portion of applicant's mark, and must be given greater weight when the marks are compared.

Cir. 1992). Given that opposer's and applicant's goods are identical, and despite the specific differences in the marks caused by the word ONES in opposer's mark and PIZZA in applicant's mark, we find that the additional generic term PIZZA in applicant's mark SMARTPIZZA is simply insufficient to distinguish this SMART mark from opposer's SMART ONES mark.

Accordingly, although the du Pont factor of the number of similar third-party marks in use favors applicant, overall the factor of the similarity of the marks tends to favor opposer.²² We also must take into consideration that applicant could, based on its identification of "pizza," use its mark on frozen pizza similar to opposer's, and both parties' products might be found next to or near each other in supermarket freezers. Because the goods can be purchased on impulse, a consumer might well see the word SMART and "grab" applicant's SMARTPIZZA box thinking that it was opposer's SMART ONES pizza, or vice versa.

The next du Pont factor we consider is that of the lack of instances of actual confusion. We do not give this factor much weight in this case, because applicant sells its goods in a limited channel of trade, to school districts

²² In reaching this conclusion we have considered but reject opposer's position that SMART is the dominant part of its mark; rather, we think that consumers will view the mark as SMART ONES, and therefore we have given equal weight to both elements in the mark.

Opposition No. 91159653

which then heat and serve the pizza to school children. Because of the current differences in actual channels of trade, the relatively limited length of time applicant has used its mark, and the fact that evidence of actual confusion is generally notoriously difficult to obtain, we cannot conclude from the lack of evidence of actual confusion that confusion is not likely. Thus, we treat this du Pont factor as neutral.²³

The only other du Pont factor on which there has been evidence and/or argument is that of the extent of potential confusion. Opposer's arguments with respect to this factor revolve around its investment in its mark, and "the potential of harm to the SMART ONE [sic] mark" if applicant were to expand its channel of trade to retail supermarkets. Brief, p. 31. Although the amount of opposer's investment is not directly relevant to this factor, we agree that because pizza is a general consumer item that can be bought

²³ Applicant has argued, in connection with this factor, that neither its application was refused by the Trademark Examining Attorney on the basis of opposer's prior registration for SMART ONES for pizza, nor was opposer's application for SMART ONES for pizza, which matured into Registration No. 2916538, refused on the basis of applicant's prior pending application. Applicant would apparently have us draw some conclusion about likelihood of confusion between the parties' marks based on what Examining Attorneys did when they examined the respective applications. However, the actions of Examining Attorneys have no relevance in this context. If we were to be guided by an Examining Attorney's conclusion about likelihood of confusion, there would be no point in having an opposition proceeding. Suffice it to say that it is the responsibility of the Board to determine the issue of likelihood of confusion based on the entire record adduced during

Opposition No. 91159653

by virtually everyone, if applicant were to sell pizza under the mark SMARTPIZZA there is the potential to confuse a large number of people. Therefore, this factor favors opposer.

Accordingly, although we reiterate that opposer is not entitled to protection against the registration of any and all marks containing the word SMART for food products, here we find that a consideration of all the relevant du Pont factors favors a finding of likelihood of confusion. To the extent that there is any doubt on this issue, it is well established that such doubt must be resolved in favor of the registrant and prior user. *Formica Corporation v. The Newman Corporation*, 158 USPQ 104 (CCPA 1968).

Decision: The opposition is sustained.

the opposition proceeding, which record is substantially larger than the evidence the Examining Attorneys considered.