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16 MAR 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Slim N' Trim, Inc. v. Walgreen Co.

Cancellation No. 92032743 to Registration No. 2,479,423
registered August 21, 2001.

Rose A. Hickman of Christie, Parker & Hale, LLP for Slim N' Trim, Inc.

Robert R. Delaney, Jr. for Walgreen Co.

Before Hanak, Chapman and Rogers, Administrative Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

On October 9, 2001 Slim N' Trim, Inc. (petitioner) filed a Petition for Cancellation seeking to cancel Registration No. 2,479,423 which issued to Walgreen Co. (respondent) on August 21, 2001. This registration is for the mark SLIM FOR LE$$ depicted in typed drawing form for "dietary supplements." In its Petition for Cancellation, petitioner alleged that long before respondent first claimed that it used its mark SLIM FOR LE$$ (i.e. April 10, 2000), petitioner had both used and registered various SLIM marks including SLIM, SLIM FREEZ, SLIM CHEEZ, SLIMLINE, SLIM N' TRIM and SLIM N' LIGHT for various food products

such as non-fat milk, low fat milk, low fat cottage cheese, low fat yogurt and ice milk. Continuing, petitioner alleged that registrant's use of SLIM FOR LE$$ for dietary supplements "will deceive the purchasing public and potential purchasers into believing that the [respondent's] products are sponsored, approved or sold by petitioner." (Petition for Cancellation paragraph 12).

Respondent filed an answer which, with one exception, denied the pertinent allegations of the petition for cancellation. The one exception is that respondent admitted the allegation set forth in paragraph 13 of the Petition for Cancellation, namely, that respondent had made no use of the mark SLIM FOR LE$$ prior to the year 2000. In addition, respondent set forth the affirmative defense that because petitioner did not oppose respondent's application to register SLIM FOR LE$$, that therefore petitioner should be estopped from filing this cancellation proceeding.

Petitioner filed an opening and a reply brief, and respondent filed a brief. Neither party requested an oral hearing. The record in this case is summarized at page 6 of petitioner's brief, and it includes certified status and title copies of petitioner's various registrations for its SLIM marks as well as the stipulated testimony of George

Mills, a long-time employee of petitioner. Applicant made of record no evidence. Of course, the application file which resulted in the registration of SLIM FOR LE$$ is part of the record.

At the outset, we will deal with two preliminary matters. First, with regard to respondent's affirmative defense that petitioner is estopped from bringing this cancellation proceeding, we find this defense to be totally without merit. Because respondent made of record no evidence, it has not demonstrated that it has in any way been damaged by the fact that petitioner chose not to file an opposition proceeding, but rather chose to file this cancellation proceeding. Moreover, we note that the registration for SLIM FOR LE$$ issued on August 21, 2001 and that the Petition for Cancellation was filed on October 9, 2001 less than two months after the registration issued. A predecessor court to our primary reviewing Court has held that a period of six months between when a registration issues and when a cancellation proceeding is filed "has never been enough" to sustain a defense of estoppal, laches or acquiescence. Ralston Purina Co. v. Midwest Cordage Co., 373 F.2d 1015, 153 USPQ 73, 76 (CCPA 1967).

Second, we note that in the Petition for Cancellation petitioner never formally pled the "family of marks"

doctrine. However, reading the Petition for Cancellation in its entirety, it is clear that the marks which petitioner claimed superior rights in all consist of or begin with the word SLIM. Moreover, at page 11 of its opening brief, petitioner claims a "family of marks" containing the surname SLIM. In its brief, respondent never objected to petitioner's arguing that it possessed a "family of marks." Accordingly, we will address petitioner's "family of marks" argument on its merits.

To be quite blunt, petitioner has utterly failed to prove that it possesses a SLIM "family of marks." To elaborate, George Mills, previously identified as an employee of petitioner, testified that in 1953 he was hired by Bellbrook Dairy, a small processor and distributor of dairy products in the San Francisco, California area. Mr. Mills further testified that commencing in 1949, Bellbrook Dairy first utilized the mark SLIM for skim milk. In the early 1950's, Bellbrook Dairy commenced use of the mark SLIM CHEEZ for cottage cheese and the mark SLIM FREEZ for ice milk. According to Mr. Mills, in 1955 Bellbrook Dairy was sold. The "processing and distributing part of Bellbrook Dairy was sold to Challenge Cream & Butter." However, according to Mr. Mills, Bellbrook Dairy's SLIM trademarks were not sold to Challenge Cream & Butter

Company, but were instead sold to Edlo Enterprises, Inc. Mr. Mills became a vice president of Edlo Enterprises in 1955. In 1984 the assets of Edlo Enterprises (i.e. the SLIM trademarks) were acquired by petitioner Slim N'Trim, Inc. Mr. Mills testified that in 1984 he was made a vice president of petitioner and that he has worked for petitioner in some capacity ever since.

Mr. Mills has never contended that either Edlo Enterprises or petitioner ever manufactured any products. Rather, Edlo Enterprises and later petitioner licensed the use of the SLIM trademarks to others, primarily local dairy companies.

In the intervening years, petitioner adopted other SLIM trademarks such as SLIM N'LITE, SLIM N'TRIM and SLIMLINE which it licensed to various dairy companies. The record reflects that these dairy companies did not have to take from petitioner a license to use all of the various SLIM trademarks. Rather, an individual dairy company could license simply one of the various SLIM marks.

The record further reflects that petitioner's licensees did not present petitioner's SLIM trademarks in any uniform fashion. For example, one of petitioner's licensees was Crystal Cream and Butter Co. of Sacramento, California. Crystal Cream and Butter Co. did utilize

petitioner's SLIM trademark. However, Crystal Cream and Butter's packaging reveals that Crystal utilized petitioner's mark SLIM in a subordinate fashion. Exhibit 26 to the Mills deposition is an empty, one quart container for CRYSTAL fat free milk. The mark CRYSTAL appears in the most prominent fashion. In a somewhat less prominent fashion appears the generic term "fat free milk." In a decidedly less prominent fashion appears petitioner's mark SLIM. Crystal's trade dress for its fat free milk consists primarily of the background color pink with the lettering being in white. Other exhibits to the Mills deposition show that other licensees of petitioner utilized distinctively different trade dresses whenever they featured one or more of petitioner's SLIM trademarks.

Thus, a consumer seeing petitioner's mark SLIM as used by one of petitioner's licensees would not necessarily associate petitioner's mark SLIM as it was used with a distinctively different trade dress by another of petitioner's licensees. Moreover, consumers would certainly not view petitioner's <u>various</u> SLIM trademarks as emanating from the same "family" given the fact that (1) petitioner's licensees utilize their own distinctive trade dresses, and (2) there is no proof that petitioner's

licensees took licenses to utilize all of petitioner's SLIM trademarks.

In addition, petitioner has not contended that it, as essentially a trademark licensor, has expended any sums in advertising or promoting any of its SLIM trademarks, much less that it has expended any sums in advertising and promoting its various SLIM trademarks together as a family. Moreover, petitioner's licensees have expended very minimal amounts in promoting petitioner's trademarks. For example, in the most recent year for which data is available (2001), all of petitioner's licensees expended less than $430,000 in promoting one or more of petitioner's SLIM trademarks.

A party plaintiff faces a very high hurdle in showing that it has established a "family of marks." 2 J. McCarthy, McCarthy on Trademarks and Unfair Competition, Section 23:61 at page 23-139 (4th ed. 2002). For example, a predecessor court to our primary reviewing Court held that Polaroid Corporation failed to establish a family of POLA marks despite the fact that Polaroid's sales of its various POLA products exceeded more than $100 million in 1961. Polaroid Corp. v. Richard Mfg. Co., 341 F.2d 150, 144 USPQ 419 (CCPA 1965).

Given the fact that petitioner has totally failed to establish that it has a SLIM "family of marks," we will

confine our likelihood of confusion analysis to a comparison of respondent's mark SLIM FOR LE$$ for dietary supplements with petitioner's marks SLIM, SLIM N'TRIM, and SLIM N'LIGHT all previously used and registered for non-fat milk or low fat milk. We will confine our analysis to the foregoing three marks owned by petitioner because, according to petitioner, only these three marks have been used in conjunction with non-fat or low fat milk and because petitioner contends that non-fat or low fat milk are the closest of its licensees' products to respondent's dietary supplements. In this regard, petitioner notes that respondent's specimen of use for SLIM FOR LE$$ shows that respondent's dietary supplement is a "ready to drink meal" that comes in eleven fluid ounce containers. Thus, as petitioner contends, respondent's liquid dietary supplement is closer to non-fat milk and low fat milk than it is to petitioner's other products such as low fat yogurt and low fat cottage cheese. (Petitioner's brief page 14).

Before beginning our likelihood of confusion analysis between respondent's mark SLIM FOR LE$$ and petitioner's marks SLIM, SLIM N'TRIM and SLIM N'LIGHT, we should note that priority rests with petitioner inasmuch as the record reflects that petitioner has made use of SLIM, SLIM N'TRIM and SLIM N' LIGHT long before respondent first used SLIM

FOR LE$$ in 2000, and respondent does not contend to the contrary.

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

Considering first the goods, petitioner has totally failed to establish that any company manufactures and/or markets, on the one hand, dietary supplements, and, on the other hand, non-fat milk, low fat milk or any other type of milk. Petitioner has certainly not established that any company manufactures and/or markets under the same mark both dietary supplements and non-fat milk, low fat milk or milk of any type. Petitioner has argued, although not proven, that dietary supplements and milk (non-fat, low fat or otherwise) can be sold in the same channels of trade such as grocery stores and large drug stores. Despite petitioner's failure of proof, we do not dispute petitioner's contention. However, the fact that the same products can be sold in super markets, large drug stores or

other major stores does not prove that these products are related. Such stores carry a wide variety of products including a wide array of edible items as well as non-edible items. This does not mean that dietary supplements and non-fat milk, low fat milk and milk of any type are related.

Petitioner has also argued, again without evidentiary proof, that a consumer could purchase both dietary supplements and non-fat milk, low fat milk and milk. However, this does not establish that dietary supplements are in any way related to milk of any type. This same consumer could go to a grocery store and purchase green beans, fresh fish, motor oil and dietary supplements. This simply does not establish that any of these products are related.

Finally, in an effort to establish a relationship between dietary supplements (respondent's goods) and the goods of petitioner (non-fat milk and low fat milk) which petitioner contends are most closely related to respondent's goods, petitioner notes that respondent's specimen of use indicates that one of the ingredients (amongst many other ingredients) in respondent's product is fat free milk. The fact that one of the <u>ingredients</u> in respondent's product is fat free milk does not mean that

respondent's dietary supplements are products which are related to non-fat milk, low fat milk or milk of any type, the very products of petitioner which petitioner contends are most closely related to respondent's product. Respondent's own specimen of use (a SLIM FOR LE$$ label affixed to an eleven fluid ounce container) shows that respondent's SLIM FOR LE$$ dietary supplement contains numerous other ingredients, and includes 24 vitamins and minerals.

In short, we find that petitioner has established that respondent's dietary supplements and petitioner's non-fat milk and low fat milk are at most only minimally related.

Turning to a consideration of the marks, we note that the only term common to respondent's mark and petitioner's three marks in question (or any of petitioner's marks) is the word "slim." As applied to dietary supplements, on the one hand, and non-fat milk or low fat milk, on the other hand, the word "slim" is extremely highly suggestive. We take judicial notice of the fact that the word "slim" is defined as follows: "small in girth in proportion to height or length; slender." Moreover, variations of the word "slim," namely "slimmed" and "slimming," are defined as "to make or become slim." Webster's New World Dictionary (1975). Thus, as applied to dietary supplements and non-

fat and low fat milk the word "slim" is indeed extremely highly suggestive.

Given the fact that the only component common to respondent's mark and petitioner's marks is the very highly suggestive term "slim," we find that there exists no likelihood of confusion in light of the fact that taken in their entireties, respondent's mark SLIM FOR LE$$ and petitioner's marks SLIM, SLIM N'TRIM and SLIM N'LIGHT are decidedly different in terms of visual appearance, pronunciation and, most importantly, connotation.

The differences in visual appearance and pronunciation are obvious, and need hardly be explained. Likewise, the difference in connotation is likewise highly obvious. However, with regard to the issue of connotation, we note that petitioner itself has acknowledged that the FOR LE$$ portion of respondent's mark has a decidedly different connotation than that of any of petitioner's marks when petitioner states that the FOR LE$$ portion of respondent's mark implies that respondent's "product costs less than petitioner's product." (Petitioner's brief page 15) By its own admission, petitioner has conceded that consumers would differentiate petitioner's marks from respondent's mark SLIM FOR LE$$.

Finally, as further evidence of the weakness of the word "slim" as applied to dietary supplements or non-fat and low fat milk, we note that on respondent's specimen of use for its SLIM FOR LE$$ dietary supplement, there appears the following language: "Compare to SLIM FAST®*." The asterisk then refers to the following statement appearing on the SLIM FOR LE$$ label: "This product is not manufactured or distributed by Slim Fast Foods Company. SLIM FAST® is a registered trademark of Slim Fast Foods Company." Thus, at least one other company (Slim Fast Foods Company) is using a mark containing the word "slim" for a product (SLIM FAST) which appears to be more similar to respondent's product than are petitioner's non-fat and low fat milk products.

In sum, given the fact that petitioner has failed to prove that any of its products and respondent's dietary supplements are more than minimally related, and the additional fact that respondent's mark SLIM FOR LE$$, with the final two SS depicted as dollar signs, is distinctly different in terms of visual appearance, pronunciation and connotation from any of petitioner's marks, we find that there exists no likelihood of confusion.

Decision: The petition to cancel is denied.