Commissioner of Patents and Trademarks
Patent and Trademark Office (P.T.O.)

GENERAL MILLS, INC.
v.
HEALTH VALLEY FOODS
May 1, 1992
***1** Hearing: March 10, 1992

Opposition No. 76,303 to application Serial No. 73/605,592, filed June 23, 1986.

Richard M. Berman and Patti L. Zenk for General Mills, Inc.

Stephen L. Baker, Ben C. Friedman and John M. Ranells of the firm Baker & Friedman for Health Valley Foods.

Before Cissel, Seeherman and Quinn

Commissioners

Opinion by Quinn

Member

An application has been filed by Health Valley Foods to register the mark FIBER 7 FLAKES for "ready to eat breakfast cereal." [FN1]

Registration has been opposed by General Mills, Inc. on the ground that applicant's mark, when applied to applicant's goods, so resembles opposer's previously used and registered mark FIBER ONE for "ready to eat breakfast cereal," [FN2] as to be likely to cause confusion, or to cause mistake, or to deceive.

Applicant, in its answer, denied the claim of likelihood of confusion, and amplified its denial in allegations captioned as "affirmative defenses." Pursuant to a motion granted by the Board in June 1989, applicant subsequently amended its answer to assert a counterclaim to cancel opposer's pleaded registration. As grounds for cancellation applicant asserted that the token use upon which opposer's application to register the mark FIBER ONE was based was unlawful since the packaging failed to comply with Food and Drug Administration labeling requirements; that the specimens in support of opposer's application were drawing board specimens not intended to be used in bona fide commercial sales; that the product shipped in the first token sales was not of the same inherent and identifiable character as the product intended to be ultimately sold under the mark; and that opposer's registered mark is merely descriptive. [FN3]

Opposer, in reply to the counterclaim, essentially denied the allegations therein.

The record consists of the pleadings; the file of the involved application; opposer's pleaded registration; trial testimony taken by each party, together with related exhibits; [FN4] excerpts from printed publications made of record in opposer's notice of reliance; opposer's responses to certain interrogatories, photocopies of third-party registrations and applied-for marks, and file histories of opposer's pleaded registration and a registration owned by applicant, all introduced by way of applicant's notices of reliance. Both parties filed briefs on the case and both parties were represented by counsel at an oral hearing held before the Board.

Opposer, among its diverse activities, is engaged in the marketing and sale of various brands of ready-to-eat breakfast cereals, including FIBER ONE for a high-fiber, low-salt, no-added-sugar cereal. A major consumers' magazine, in comparing various cereals, rated opposer's cereal sold under the mark FIBER ONE as the number-one cereal in terms of "nutritional quality." Opposer's cereal is sold in grocery stores, wholesale-price discount stores, restaurants, school cafeterias and the like. In the period 1984-1990, total sales volume of FIBER ONE brand cereal exceeded $79.6 million, representing over 55.6 million units. For the same years, total advertising expenditures approached $44 million. Opposer has advertised its cereal on television and radio, and in the print media such as magazines and trade publications. Opposer also has promoted its product through coupons.

***2** The record is mainly silent on applicant's business activities. There is no evidence of the sales and advertising expenditures under applicant's mark. The packages for applicant's cereal claim that the cereal is "from seven sprouted grains" and that the cereal has a "superior balance of fiber" with no sugar or salt added. Applicant owns Supplemental Registration No. 1,211,115 for the mark SPROUTS 7 for breakfast cereal.

In looking at the merits of this case we must first direct our attention to applicant's counterclaim to cancel the pleaded registration, namely Registration No. 1,335,787. [FN5]

The first ground we shall consider involves opposer's purported token use. Applicant has concentrated its attack relative to the claims that opposer failed to comply with labeling regulations and that the product initially shipped was not of the same inherent and identifiable character as the product ultimately intended to be sold, both of which grounds are discussed infra. However, applicant also questions, in essence, the sufficiency of opposer's initial use to establish property rights in the mark FIBER ONE for cereal, taking issue with the specimens filed in support of opposer's application. [FN6]

As the law existed in the United States at the time opposer's initial shipment was made in 1984, trademark rights arose through use of a mark in connection with a particular product or service. Thus, Section 1 of the Trademark Act of 1946 (Section 1(a) of the Trademark Act, as amended by the Trademark Law Revision Act of 1988), provided for the registration of a mark "used in commerce" if certain requirements were met. In an application filed prior to the effective date of the Trademark Law Revision Act amendments, as this one was, the fact that a shipment of goods may have been designed to lay a foundation for

registration does not, per se, invalidate any application or registration based thereon. Rather, a token sale or a single shipment in commerce, with the color of a bona fide transaction, may be sufficient to support an application for registration provided that it is followed by other shipments or accompanied by activities or circumstances which would indicate a continuing effort or intent to continue such use and place the product on the market on a commercial scale. See: Ralston Purina Co. v. On-Cor Frozen Foods, Inc., 746 F.2d 801, 223 USPQ 979 (Fed.Cir.1984); and Fort Howard Paper Co. v. Kimberly-Clark Corp., 390 F.2d 1015, 157 USPQ 55 (CCPA1968).

Opposer rented shelf space from three different grocery stores located in California, Illinois and Pennsylvania. On October 24, 1984, opposer shipped six packages of cereal to each store. Each package weighed four ounces and was sold to the stores for twenty-five cents. We conclude that opposer's shipment of eighteen packages bearing the mark FIBER ONE on October 24, 1984 was sufficient to serve as a foundation for opposer's application for registration filed on October 29, 1984. Opposer's initial shipment on October 24, 1984 was a regular sales transaction in accordance with opposer's long established token shipment program for establishing trademark rights. The initial shipment was followed a mere four months later by nationwide shipments of the FIBER ONE brand cereal, clearly indicating opposer's intent to make continuous shipments. Opposer sold over 600,000 packages of its cereal during the first year in the marketplace, accounting for sales in excess of one million dollars. This subsequent use clearly validates the initial token use such that the mark was "used in commerce" on October 24, 1984. See: Corporate Fitness Programs Inc. v. Weider Health and Fitness Inc., 2 USPQ2d 1682, 1688 (TTAB1987).

***3** The next ground for cancellation is that opposer's initial use was unlawful since the packages shipped did not comply with the labeling requirements of the Food and Drug Administration (FDA). Applicant concludes that this (assertedly) unlawful use, which formed the basis of opposer's application, renders the subsequently issued registration void ab initio. Opposer contends, on the other hand, that although opposer is guilty of a technical violation of the Food, Drug and Cosmetic Act, the labeling omission was inadvertent. Opposer goes on to assert that its failure to fully comply with FDA labeling requirements pertained to only eighteen packages of cereal and that the mistake was rectified a mere four months later when opposer commenced national distribution of FIBER ONE brand cereal. Opposer essentially concludes that the effect of its noncompliance with FDA labeling requirements was de minimis.

Applicant has alleged that opposer violated 21 USC § 343(f) of the Federal Food, Drug, and Cosmetic Act because the packages shipped in October 1984 were misbranded. More specifically, applicant alleges that these packages did not include nutritional information as required by 21 CFR § 101.9 et seq. Applicant views the noncompliance as rendering the initial shipment unlawful.

Opposer readily concedes that the eighteen boxes comprising opposer's initial shipment did not bear the nutritional information required by FDA regulations. Although opposer acknowledges its inadvertent failure to comply fully with these regulations, we agree with opposer that its technical noncompliance should not result in the Draconian result of

cancellation of its registration.

As the Board has stated in the past, the better practice in trying to determine whether use of a mark is lawful under one or more of the myriad regulatory acts is to hold a use in commerce unlawful only when the issue of compliance has previously been determined (with a finding of noncompliance) by a court or government agency having competent jurisdiction under the statute involved, or where there has been a per se violation of a statute regulating the sale of a party's goods. See: Santinine Societa v. P.A.B. Produits, 209 USPQ 958 (TTAB1981); and Kellogg Co. v. New Generation Foods, Inc., 6 USPQ2d 2045 (TTAB1988).

In this case, there apparently has been no final determination of noncompliance by any competent court or agency regarding opposer's initial shipments of its FIBER ONE brand cereal. Applicant, in its counterclaim, has not asserted that such a determination has been made. Rather, applicant essentially has attempted to show that opposer's initial shipment was a per se violation of FDA regulations.

We find that applicant, as the charging party, has not met its burden of proof relating to this portion of the counterclaim. Applicant's only evidence in support of its claim consists of copies of the relevant portions of the statute and regulations. Where, as here, a party seeks to show that use by the adverse party was unlawful by virtue of noncompliance with a labeling statutory provision, it is incumbent upon the party charging that the use was unlawful to demonstrate by clear and convincing evidence more than that the use in question was not in compliance with applicable law. Such party must prove also that the non-compliance was material, that is, was of such gravity and significance that the usage must be considered unlawful--so tainted that, as a matter of law, it could create no trademark rights--warranting cancellation of the registration of the mark involved. This view is, we believe, entirely consistent with the Board's prior decisions on this question in the Kellogg and Santinine cases, supra. While the Board, in the Kellogg case, found, upon summary judgment, that no per se violation of the regulatory statutes had occurred, the Board clearly indicated that the significance or materiality of the asserted violation was a requirement without which the registration involved therein would not be cancelled. The Board recounted, in its opinion, that in an earlier order relating to the summary judgment motion, the Board had allowed the charging party in that case time to brief the issue of whether the undisputed facts surrounding the initial shipment of the goods by Kellogg "... was in compliance with applicable law and whether this asserted non-compliance [sic] was of such significance that any use of the 'NUTRI-GRAIN' mark by Kellogg prior to the application filing date would be considered unlawful...." Kellogg, supra at 2046. The Board added that in its earlier order the Board indicated that if the moving party "... failed to demonstrate by clear and convincing evidence that the undisputed facts regarding Kellogg's first use of the 'NUTRI-GRAIN' mark constituted such a material non-compliance [sic] with a regulatory statute as to render unlawful Kellogg's shipment of goods prior to the application filing date, the Board would dismiss the counterclaim by way of summary judgment." Id.

***4** Similarly, the Santinine decision notes that there must be some nexus between the use of the mark and the alleged violation before the unlawfulness of a shipment can be said to result in the invalidity of a

registration. See Santinine, supra at 967. [FN7] As pointed out by member Kera in his concurring opinion in the Santinine case at p. 967, while some unlawful uses are of such a nature (e.g., use of a mark in connection with an illegal drug) that it would be unthinkable to register a mark, other uses should not result in refusal of registration (or cancellation of a registration) because of some purely collateral defect.

It is clear from even a cursory review of the relevant labeling regulatory statutes that many requirements are purely technical in nature and that violations of such requirements may be relatively harmless and may be subsequently corrected. [FN8] While our decision herein will require the Board to make a case by case determination of the importance or materiality of the labeling requirement which a party may have violated, we believe that such a case by case determination is preferable to a blanket policy of finding every possible technical violation to result in cancellation of a registration, no matter how minor or harmless the violation may be. Such a rigid approach serves the interests of neither justice nor common sense and such an approach is not mandated by the case law on this matter. [FN9]

We find that, in the instant case, applicant's claim fails for lack of proof. In Santinine, supra at 965, the Board stated that "the proofs submitted by the party [charging noncompliance] must leave no room for doubt, speculation, surmise, or interpretation." We have no idea how FDA generally views noncompliance with technical labeling requirements. There is nothing in the record to indicate that FDA would view inadvertent noncompliance with a single technical requirement as in opposer's case to be of such gravity and significance that the violation renders the initial prefiling use unlawful, thereby voiding opposer's registration. Inasmuch as the record is silent, we can only speculate on the significance attached to the noncompliance--we decline to do so when the result might mean the cancellation of a party's registration with the valuable rights appurtenant thereto.

In the absence of clear and convincing proofs, we decline to find that the omission of nutritional information on opposer's initial packages was of such gravity and significance that the October 1984 shipment affords no basis for opposer's registration. As a postscript, we note that the packages used by opposer prior to the application filing date were otherwise in compliance with FDA regulations. The packages complied with the requirements relating to ingredients and the name and address of the distributor (opposer). [FN10] Moreover, it is undisputed that opposer's national shipments four months later were in full compliance with the nutritional labeling requirement.

***5** Another ground for cancellation is that the cereal sold by opposer in its shipment on October 24, 1984 was not of the same inherent identifiable character as the cereal ultimately sold by opposer under the mark FIBER ONE. Thus, applicant contends, the registration is void ab initio.

Colleen Sarenpa, a paralegal in trademarks for opposer, testified about opposer's October 1984 shipment which she asserts was made for purposes of establishing trademark use. Ms. Sarenpa testified that the FIBER ONE packages comprising the initial shipment actually contained opposer's WHEATIES brand cereal. Ms. Sarenpa was unsure if the actual

FIBER ONE product that went out to the marketplace nationwide in February 1985 was in existence in October 1984 (Sarenpa dep., p. 53). Nonetheless, Ms. Sarenpa stated that the actual FIBER ONE brand cereal product was not shipped for "security reasons" (Sarenpa dep., pp. 53-54). [FN11] Ms. Sarenpa stated that the WHEATIES brand cereal already marketed by opposer was shipped instead since it was "compatible" with the FIBER ONE brand cereal in that both are high in fiber (Sarenpa dep, p. 41).

The explanation for the initial shipment of WHEATIES brand cereal in packages marked FIBER ONE is entirely reasonable. Ms. Sarenpa testified that it is a common practice for opposer to ship a somewhat different product in a token shipment for security reasons. It has been held that goods used in an initial shipment need not be identical to the goods the mark is intended ultimately to identify. With an eye to the realities of the marketplace, the Federal Circuit has adopted the test of whether or not the "inherent and identifiable character" of a product under development which is intended to be ultimately marketed under the mark in question is the same as that of the product used in a token shipment, as described in the application. See: Ralston Purina Co. v. On-Cor Frozen Foods, Inc., supra [dry cat food has the same inherent and identifiable character as the new dry or wet cat food product which the mark was ultimately intended to identify]. Opposer's initial shipment in October 1984 was of a cereal product that contained fiber--the product ultimately sold nationally was a cereal product that contained fiber. The two products (that is, WHEATIES and FIBER ONE) would appear to be formulated of similar ingredients, share similar qualities and certainly travel through the same channels of trade to the same classes of purchasers.

In sum, we are persuaded that the ultimate FIBER ONE brand ready-to-eat breakfast cereal did not change the inherent and identifiable character of the ready-to-eat breakfast cereal used in opposer's initial shipment, notwithstanding the fact that opposer was already marketing the cereal under a different mark, namely WHEATIES.

Accordingly, the counterclaim is dismissed.

We now turn to consider opposer's claim that applicant's mark FIBER 7 FLAKES for cereal so resembles opposer's mark FIBER ONE for cereal as to be likely to cause confusion, mistake or deception. In view of opposer's ownership of a valid and subsisting registration, there is no issue with respect to opposer's priority. See: King Candy Co., Inc. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA1974). In any event, the evidence clearly establishes opposer's earlier use.

***6** For purposes of our analysis, the parties' products are legally identical. Both parties identify their respective products as "ready to eat breakfast cereal" and the record would indicate that the products are sold in the same stores (located even on the same aisle) to the same classes of purchasers. Moreover, the products are relatively inexpensive and Sarah Caruso, opposer's marketing manager for FIBER ONE brand cereal, testified that purchasers show little reluctance to switch brands "at the drop of a cents-off coupon." (Caruso dep., p. 96). We accordingly focus our attention, as have the parties, on the similarities between the marks FIBER ONE and FIBER 7 FLAKES. We find that, notwithstanding the identity of the goods, the marks are

sufficiently dissimilar such that consumers are not likely to be confused. Our reasons follow, taking into account the relevant factors as set out in In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA1973).

It hardly need be stated that the term "fiber" appearing in the parties' marks is a readily understood and commonly used generic term in the food industry. [FN12] In recent years there has been increasing focus on the importance of fiber in a person's daily diet. In raising the health consciousness of consumers, food manufacturers and health professionals have touted the benefits of a high-fiber diet, with emphasis on the reduced risk of colorectal cancer and lower cholesterol levels. In recognition of the genericness of "fiber" as applied to cereals, it is not surprising that each party disclaimed the term apart from the mark. Furthermore, Ms. Caruso essentially stated that opposer has no exclusive rights in the term "fiber" per se. (Caruso dep., p. 82). Ms. Caruso agreed with the statement that "opposer has never attempted or claimed trademark rights in the word FIBER, nor has opposer claimed.... that the public associates the term FIBER with opposer." (Caruso dep., p. 81).

The record includes 171 third-party registrations of and applications for marks comprising, in part, the term "fiber" in the food products and dietary food supplement industries. [FN13] Although the registrations are not evidence of use, the registrations show the sense in which the term "fiber" is employed in the marketplace, similar to a dictionary definition. Regarding third-party use, Stephen Baker, one of applicant's attorneys, submitted his affidavit testimony attesting to widespread use of the term "fiber" for food products, including cereals. The exhibits relating to Mr. Baker's testimony show numerous third-party uses of "fiber" in connection with food products. In light of the above, we do not believe there is any doubt but that the field of "fiber" marks for foods (including cereals) is a crowded field. See: 1 J.T. McCarthy, Trademarks and Unfair Competition, supra at § 11:26. Lest there be any doubt, Ms. Caruso acknowledged that "other manufacturers of cereal products use the term FIBER on a regular basis." (Caruso dep., p. 82).

***7** With respect to the term "one," Ms. Caruso testified that this number in opposer's mark "has many positive connotations of high quality, being the best, being--it's of, you know, a very gold medal standard." (Caruso dep., p. 81). When used in opposer's mark to identify cereal, the ONE portion takes on a laudatory meaning. [FN14] Opposer's advertisements play on the laudatory nature of "one" (e.g., "The One With More Fiber").

Opposer, in the face of the above record, goes on to contend that its mark FIBER ONE is "well known" in the cereal field. Certainly, opposer's sales figures suggest that opposer has enjoyed considerable success with its cereal sold under the FIBER ONE mark. Opposer's advertising expenditures likewise are substantial. Ms. Caruso claims that opposer's cereal can be found in approximately four percent of American households, meaning over 7.5 million homes. (Caruso dep., p. 125). Opposer also has submitted unsolicited letters from consumers wherein they praise the quality of FIBER ONE brand cereal. (Opposer's ex. G28).

Ms. Caruso at the same time estimated that consumers can choose among approximately 175-200 different brands of cereal and that 1988 sales of all cereals in this country approached $7 billion. Ms. Caruso testified that opposer's FIBER ONE brand cereal attained, as of May 1990, a .35 percent share of the ready-to-eat cereal market. (Caruso dep., p. 124). While opposer's sales and advertising numbers are impressive and would suggest that opposer's mark is, in opposer's words, "well known", we can only speculate about the actual impact of opposer's mark on the minds of consumers. Based on the record before us, we find that opposer has failed to show that its mark is so "famous" in the cereal industry as to preclude the registration sought by applicant. Compare: Kenner Parker Toys Inc. v. Rose Art Industries, Inc., --- F.2d ----, --- USPQ2d ----, Appeal No. 91-1399 (Fed.Cir. April 15, 1992).

In considering the involved marks, we recognize, of course, the commonality of the marks' format, that is, the word FIBER plus a number. The term "flakes" in applicant's mark does little, if anything, to distinguish the marks. As applicant's packaging shows, the mark is also prominently displayed as FIBER 7 without the FLAKES portion. While the marks have a similar format, opposer itself has contended that it is not claiming rights to all numbers combined with the term "fiber." (Caruso dep., p. 80). Opposer is straining in arguing that the numbers one and seven, when shown in numeral form ("1" and "7"), look alike. It is undisputed that opposer never has used the numeral "1", but rather always has used the word ONE in its mark. Not only are 1 and 7 different numbers, but an added difference in this case is that opposer uses the word "one", whereas applicant uses the numeral "7." In addition, the marks have different connotations. FIBER ONE suggests, as noted above, that opposer's cereal is superior, as, for example, by having more fiber than other cereals. Applicant's mark FIBER 7 FLAKES suggests, on the other hand, something different, namely that seven types of grain or sources of fiber are in the cereal.

***8** While we earlier discussed each component of opposer's mark, we fully appreciate the fact that the mark in its entirety is FIBER ONE. We emphasize that we have considered the marks as a whole. In sum, the marks, when considered in their entireties, engender different overall commercial impressions. [FN15] See: Kellogg Co. v. Pack 'em Enterprises Inc., --- F.2d ----, 21 USPQ2d 1142 (Fed.Cir.1991), aff'g 14 USPQ2d 1545 (TTAB1990); and In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818 (Fed.Cir.1986).

We reiterate that an important factor in our analysis is the evidence of widespread use of the term "fiber" in connection with cereals and other food products. This evidence suggests that consumers have become so conditioned by the large number of FIBER marks for food products that customers are accustomed to distinguishing between different FIBER marks, even on the basis of small differences. See, e.g.: Standard Brands, Inc. v. RJR Foods, Inc., 192 USPQ 383 (TTAB1976).

Finally, the absence of any actual confusion, while weighing in applicant's favor, is not a crucial factor for us in reaching our decision. Since applicant failed to submit any evidence regarding the extent of its use of its mark, [FN16] we are unable to determine whether or not there has been a meaningful opportunity for confusion to occur in the marketplace.

We find that, notwithstanding the identity of the goods, the du Pont factors, on balance, favor applicant. Thus, we conclude that confusion is unlikely in this case.

Decision: The counterclaim for cancellation is dismissed. The opposition is dismissed.

R.F. Cissel

E.J. Seeherman

T.J. Quinn

Members, Trademark Trial and Appeal Board

FN1. Application Serial No. 73/605,592, filed June 23, 1986, alleging dates of first use of June 16, 1986. Applicant has disclaimed the words "Fiber" and "Flakes" apart from the mark.

FN2. Registration No. 1,335,787 (based on application Serial No. 73/506,223, filed October 29, 1984), issued May 14, 1985, Section 8 affidavit filed and accepted. The word "Fiber" is disclaimed apart from the mark.

FN3. Applicant's briefs are silent on this last ground. In response to the Board's inquiry at the oral hearing, applicant indicated that applicant had dropped its claim that opposer's registered mark is merely descriptive. We accordingly give no consideration to this contention.

FN4. The testimony of Stephen Baker, one of applicant's attorneys, was submitted by affidavit pursuant to a stipulation with opposer.

FN5. As an initial matter, we note that opposer argues that applicant is "not damaged" by opposer's registration and that applicant has no standing to attack the validity of the registration. Contrary to opposer's argument, it is clear from applicant's position as the defendant in this opposition that it has an interest in this controversy beyond that of the general public. General Mills, Inc. v. Nature's Way Products, Inc., 202 USPQ 840 (TTAB1979).

FN6. While applicant couched its argument in terms of the "simplistic" or "drawing board" nature of the specimens, the essence of the argument constitutes an attack on opposer's token use. In any event, the Board has stated in the past that the question of the sufficiency of the specimens is not a proper ground for opposition [or, in this case, cancellation]. See: Century 21 Real Estate Corp. v. Century Life of America, 10 USPQ2d 2034, 2035 (TTAB1989).

FN7. The Santinine case consists of the opinion of member Rice and the separate concurring opinions of (then) members Lefkowitz and Kera. Since there are three separate opinions, all three are considered to be of equal weight.

FN8. The Board notes that the Office's current ex parte examination practice in this area conforms to the views expressed in Kellogg, supra and this opinion. Section B.5 of Examination Guide No. 1-91, issued March 28, 1991, reads as follows:

Inquiries Concerning Compliance with Other Laws

Trademark Rule 2.69, 37 C.F.R. § 2.69, permits the Office to inquire concerning compliance with other Federal laws to confirm that the applicant's use of the mark in commerce is lawful. The Office has routinely made inquiries concerning compliance with certain federal laws, such as laws governing the labeling of foods, drugs and cosmetics. See TMEP § 901 et seq. The Office will discontinue making such inquiries on a routine basis.

The examining attorney should only inquire concerning compliance with other Federal laws or refuse registration based on the absence of lawful use in commerce when a court or the responsible Federal agency has issued a finding of noncompliance under the relevant statute or where there has been a per se violation of the relevant statute. Cf. Kellogg Co. v. New Generation Foods Inc., 6 USPQ2d 2045 (TTAB1988); Medtrodonic [sic], Inc. v. Pacesetter Systems, Inc., 222 USPQ 80 (TTAB1984).

For the purpose of determining whether to issue such an inquiry, the Office will not regard apparent technical violations, such as labeling irregularities on specimens, as per se violations. For example, if a package fails to show all required labeling information, the examining attorney should not take any action. Likewise, the Office will no longer routinely solicit information regarding label approval under The Federal Alcohol Administration Act or similar acts. Per se violations necessitating an inquiry or refusal are those where a clear violation of law, such as the sale or transportation of a controlled substance in violation of law, is evident in the record.

In pending cases, the examining attorney should not pursue any previous inquiry further unless the record indicates a per se violation of a substantive nature or a specific finding of noncompliance as noted above.

FN9. The parties have cited two additional Board decisions, both of which are unpublished. In the past, the Board has, on one hand, stated that it will not consider as applicable precedents its prior unpublished decisions. See, e.g.: In re American Olean Tile Co., 1 USPQ2d 1823, 1825 (TTAB1986); and Marcon, Ltd. v. Merle Norman Cosmetics, Inc., 221 USPQ 644, 645 n. 4 (TTAB1984). The Board likewise has stated that it will not consider as applicable precedents those prior decisions published only in digest form. See, e.g.: Roberts Proprietaries, Inc. v. Rumby International, Inc., 212 USPQ 302, 303 (TTAB1981). On the other hand, in two other published opinions, the Board allowed Trademark Examining Attorneys of the Office to cite, as applicable precedent, unpublished Board decisions. In each of those cases, the Trademark Examining Attorney has submitted a complete copy of the unpublished decision. See: In re Jeep Corp., 222 USPQ 333, 335 n. 2 (TTAB1984); and In re Mitsubishi Jidosha Kogyo Kabushiki Kaisha,

19 USPQ2d 1633, 1635 n. 3 (TTAB1991). We parenthetically note that in the instant case, copies of the prior unpublished Board decisions were not supplied.

With a view toward clearing up any confusion engendered by the above-cited cases, the Board feels compelled to set a firm policy on whether to allow, in ex parte appeal cases and/or inter partes proceedings, the citation, as legal precedent, of unpublished Board decisions or prior Board decisions published only in digest form.

Upon reflection the Board has decided that citation of "unpublished" or "digest" Board decisions as precedent will no longer be allowed. In the future, the Board will disregard citation as precedent of any unpublished or digest decision. Even if a complete copy of the unpublished or digest decision is submitted, the Board will disregard citation as precedent thereof. An exception exists, of course, for those situations in which a party is asserting issues of claim preclusion, issue preclusion, judicial estoppel, law of the case or the like based on a decision of the Board rendered in a nonprecedential (i.e., unpublished or digest) decision. In those situations, the Board necessarily will consider the prior decision (assuming that a complete copy is submitted) to determine the preclusive effect, if any, of that decision.

We agree with the following commentary found in 1 J.T. McCarthy, Trademarks and Unfair Competition, § 20:26 (2d ed. 1984):

> [The Board's allowance of citation to unpublished Board decisions] is an unfair practice to follow because it gives an advantage to the litigant and attorney who can afford the time and resources to locate, file and index these "unpublished" decisions.

Decisions are not published because, in virtually all cases, they do not add significantly to the body of existing law and/or they are not of widespread legal interest. By deciding that a decision will not be recommended for publication, the Board has in effect declared that the decision has no value as legal precedent. With respect to prior decisions published only in digest form, the Board reasons that such decisions are meaningless as precedent because they fail to report the facts on which the decisions were based. Thus, the Board sees no compelling reason to allow unpublished or digest decisions to be cited as precedent. This view is more in line with the view of other courts, including the Federal Circuit. The Federal Circuit currently marks each of its unpublished decisions with a notation to the effect that the decision is not citable as precedent. See: Fed.Cir.R. 47.8.

Although the Board may determine, at the time of issuance, that a decision does not merit publication, any interested person may request that the decision be published, giving reasons therefor. Assuming that the Board is persuaded that a valid reason exists for publication, the decision will be marked accordingly, thereby becoming a precedential disposition.

FN10. It thus seems reasonable to assume that if a purchaser of any of the eighteen original packages had a question regarding nutritional qualities after scanning the ingredients, the purchaser, in fact, would have been able to contact opposer to ascertain that information.

FN11. Opposer was concerned about a possible breach of security if its competitors were to obtain the actual FIBER ONE brand product in the token shipment program before opposer began to market the

productnationwide.

FN12. Opposer describes "dietary fiber" as "a complex carbohydrate.... the part of the plant material that cannot be digested and absorbed into the bloodstream." (opposer's ex. G29).

FN13. Applicant included registrations covering laxatives in view of Ms. Caruso's reference to opposer's cereal as "a medicinal product.... basically a laxative." (Caruso dep., p. 84).

FN14. The Board, when considering the laudatory nature of "1" in an earlier proceeding, stated:

The fact that the numeral "1" is widely used to indicate superiority is common knowledge of which we can take judicial notice. Hertz System, Inc. v. A-Drive Corporation, 222 USPQ 625, 630 at n. 14 (TTAB1984).

FN15. "If a common portion of the two conflicting marks is a public domain generic word, the emphasis of enquiry should be upon the confusing similarity of the nongeneric portion, with the ultimate issue determined by the confusing similarity of the total impression of both marks." 2 J.T. McCarthy, Trademarks and Unfair Competition, supra at § 23:15 G.

FN16. The only evidence of use is found in Ms. Caruso's statement that she personally has seen the parties' products sold in the same stores on the same aisle. (Caruso dep., p. 126).

24 U.S.P.Q.2d 1270

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