

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

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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sigma Alimentos, S.A. de C.V.

Serial Nos. 78572313 and 78572318

Albert B. Kimball, Jr., of Bracewell & Patterson, L.L.P.
for Sigma Alimentos, S.A. de C.V.

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Office 105 (Thomas G. Howell, Managing Attorney).

Before Bucher, Holtzman and Zervas, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Sigma Alimentos, S.A. de C.V., a Mexican corporation,
seeks registration on the Principal Register of the marks
SOLE and **SOLE LIGHT** in the special forms shown below:

The word "SOLE" is rendered in a bold, stylized, black font. The letters are thick and blocky, with a slightly irregular, hand-drawn appearance. The "O" is particularly prominent, being larger and more rounded than the other letters.The word "SOLE" is rendered in the same bold, stylized, black font as the first mark. Below it, the word "Light" is written in a smaller, italicized, black font.

for goods identified in the applications, as amended, as
"soy based beverages not being milk substitutes" in
International Class 32.¹

¹ Application Serial No. 78572313 for the mark *SOLE* (stylized) was filed on February 22, 2005 based under Section 44(e) of the Trademark Act upon applicant's Mexican registration number

These cases are before the Board on appeal from the final refusals of the Trademark Examining Attorney to register these marks based upon Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). The Trademark Examining Attorney has found that Applicant's marks, when used in connection with the identified goods, so resemble the following mark:

SOLÉ

registered for "spring water" in Int. Class 32,² as to be likely to cause confusion, to cause mistake or to deceive.

Applicant and the Trademark Examining Attorney have fully briefed the cases. At the request of the Trademark Examining Attorney, these two appeals have been consolidated. We affirm the refusals to register.

Applicant argues that there is no likelihood of confusion given that the connotation of the identical term, "solé," changes when used in connection with the respective

843455, issued on July 20, 2004. Similarly, application Serial No. 78572318 for the mark SOLÉ LIGHT (*stylized*) was filed on February 22, 2005 based under Section 44(e) of the Trademark Act upon applicant's Mexican registration number 863274, issued on December 9, 2004.

² Registration No. 2179791 issued on August 11, 1998 based on an application filed on February 22, 1995 claiming first use anywhere and first use in commerce at least as early as January 1992; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

goods; that there is no relationship between the products; and that evidence of extensive third party use of marks containing the word "sole" demonstrates that the cited mark is an extremely weak mark.

By contrast, the Trademark Examining Attorney contends that the sound, appearance and connotation of Applicant's **SOLE** mark is identical to the cited **SOLÉ** mark.

Similarly, the Trademark Examining Attorney argues that the dominant feature of applicant's stylized mark **SOLE**
Light is the same "Solé" inasmuch as the descriptive word, "Light," has been disclaimed in Applicant's second mark. She points out that on this record, there is no demonstration that the word "solé" is either weak or diluted for the identified goods. She contends that the record does show that the involved goods are related and will be sold through the same channels of trade to the same classes of ordinary consumers.

Preliminary matter

Applicant offered new evidence with its appeal brief not made of record prior to the appeal. The Trademark Examining Attorney has correctly objected to the tardy submissions of this material. Under 37 C.F.R. § 2.142, the current record should have been complete prior to the

filing of the appeal. Therefore, we will not consider Exhibit A, a copy of U.S. Reg. No. 2694736 [SOLEVITA for fruit juice beverages] and Exhibit F, a TESS printout of the summary results of a search for applications and registrations for marks containing the term (or prefix) "Sole" for goods in International Class 32.

Likelihood of Confusion

We turn then to a consideration of the issue of likelihood of confusion. Our determination of likelihood of confusion is based upon our analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key, although not exclusive, considerations are the similarities between the marks and the relationship between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). *See also In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The marks

We turn first to the *du Pont* factor that focuses on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

In making this determination, our focus should be placed on the recollection of the average consumer who normally retains a general rather than a specific impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

We agree with the Trademark Examining Attorney that Applicant's **SOLE** mark is identical to the cited **SOLE** mark. These marks are identical in sound, appearance, connotation and commercial impression. As to sound and appearance, these stylized marks have the same four letters in the same order. Significantly, both have a distinctive accent mark over the final letter "e."

As to connotations, applicant has constructed a complicated explanation for why they are different. In short, Applicant postulates that the first two letters of its mark, S-O- suggest soja (or soya), and the final letters, -olé, bring to mind a word of cheer in Spanish,

together thereby suggesting "a soy beverage product with noteworthy or commendable character or contents ... " Yet, the very same mark, when used by Registrant in connection with "spring water," has the connotation, according to Applicant, of sunlight or clarity - the word SOLÉ as "sun."

We are not persuaded by this reasoning. Whether used with Registrant's product or Applicant's product, the term "Solé" is arguably arbitrary or fanciful. There are suggestions from third-party registrations in the record that perhaps SOLE (*without* the accent mark) is Italian for "sun." However, we find that Applicant appears to be reaching with this elaborate construct of two distinct, suggestive connotations for the same mark when applied to the respective goods.

This is not a case where the connotation of the term is deemed to be clearly different as applied to the respective goods.³ For example, the Board found that the mark PLAYERS on men's underwear and shoes would not result in consumer confusion as to the source of the goods. See *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984):

"PLAYERS" for shoes implies a fit, style, color and durability adapted to outdoor activities. "PLAYERS" for men's underwear

³ Applicant cites to *In re Sears, Roebuck and Co.*, 2 USPQ2d 1312 (TTAB 1987) [CROSS-OVER, when applied to brassieres, is suggestive of the construction of the bras, and hence is not likely to be confused with CROSSOVER for women's outerwear].

implies something else, primarily indoors in nature.

In the instant case, however, "Solé" appears to be a fanciful or coined term - creating exactly the same connotation for soy-based beverages as for water.

Accordingly, we find that the **SOLE** mark is identical to the cited **SOLÉ** mark in sound, appearance, connotation and commercial impression. Presumably the low-fat version of this product will be marketed under the mark **SOLE** Light .

While the addition of the highly descriptive term, "Light," below the term "Solé," and in somewhat smaller letters, creates obvious differences in both sound and appearance, we agree with the Trademark Examining Attorney that the connotations and commercial impressions remain the same.

Alleged Weakness of "Sole"

Applicant has submitted for the record a listing taken from the United States Patent and Trademark Office's TESS database of both registrations and applications (Exhibit E). This exhibit shows that nearly three hundred (294) marks contain the word "sole." However, for a variety of reasons discussed below, this is not a demonstration that Registrant's mark should be given a narrowed scope of protection.

First, a perusal of this list demonstrates that there are very few examples of the word "solé" (having the accent mark on the final letter "e"). Most are simply the word "sole." These latter examples are drawn from marks used in connection with all forty-five classes of goods and services - with a disproportionate share of them having to do with footwear and related services. In any case, Applicant's listing includes pending applications, which have absolutely no probative value. Even third-party registrations are entitled to little weight in this context - and as pointed out by the Trademark Examining Attorney, Applicant has merely submitted a listing rather than providing TESS printouts of any individual registrations. Accordingly, as to the *du Pont* factor focusing on the number and nature of similar marks in use on similar goods, we have to conclude this factor supports a finding of likelihood of confusion herein.

Relationship of the goods

Accordingly, we turn to the similarity or dissimilarity and nature of the goods as described in the application and cited registration. With both Registrant and Applicant using substantially the same designation, "the relationship between the goods on which the parties use their marks need not be as great or as close as in the

situation where the marks are not identical or strikingly similar." *Ancor, Inc. v. Ancor Industries, Inc.*, 210 USPQ 70, 78 (TTAB 1981). See also *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993) ["[E]ven when goods or services are not competitive or intrinsically related, the use of identical marks can lead to an assumption that there is a common source."].

In order to support a holding of likelihood of confusion, it is sufficient that the respective goods are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. See *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). We agree with Applicant that our analysis must focus on the way the goods are encountered in the marketplace by typical consumers and whether they will be confused as to the source of the products. See 3 J. Thomas McCarthy, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION*, § 23:58 (4th ed. 2004) [a tribunal must "attempt to recreate the conditions under which prospective purchasers make their choices" so as to

arrive at a "realistic" evaluation of likelihood of confusion].

Other than the obvious fact that both products are liquids, Applicant argues that there is no relationship between Registrant's water and its soy-based beverages. Applicant is correct in noting, for example, that we certainly have no *per se* rule that all beverages are related. However, the Trademark Examining Attorney has supplied for the record a half-dozen third-party registrations showing the same mark registered in connection with both goods:



for, *inter alia*, " ... light beverages in the nature of non-alcoholic drinks ... soy based beverage used as a milk substitute ... water, namely, spring water, drinking water, aerated water ... instant soy drink powder" in Int. Class 32;⁴

⁴ Registration No. 2402321 issued to AFC Trading & Wholesale Inc. on November 7, 2000 based upon an application filed on May 21, 1997 claiming first use anywhere and first use in commerce at least as early as May 1981; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.



for, *inter alia*, " ... mineral water, aerated water, soda water ... soy bean juice" in International Class 32;⁵

GLACEAU SOY WATER

for "non-alcoholic beverages, namely bottled drinking water containing soy protein and isoflavones" in International Class 32;⁶

100% PURE YUM

for "soy-based food beverages ..." in Inter. Class 29;
"spring water ..." in International Class 32;⁷

金萊香 Golden king

for, *inter alia*, " ... soy bean based beverages" in International Class 29;
" ... drinking water with herbal flavoring ... mineral water ..." in International Class 32;⁸

⁵ Registration No. 2540776 issued on February 19, 2002 based upon an application filed on March 9, 1998 claiming first use anywhere and first use in commerce at least as early as August 31, 2001. The Chinese characters in the mark are translated into the English-language as "Beijing," "together," "benevolence" and "hall."

⁶ Registration No. 2566682 issued on May 7, 2002 based upon an application filed on May 19, 2000 claiming first use anywhere and first use in commerce at least as early as November 19, 1999. No claim is made to the words "Soy" and "Water" apart from the mark as shown.

⁷ Registration No. 2703078 issued on April 1, 2003 based upon an application filed on March 20, 2001 later claiming first use anywhere and first use in commerce at least as early as October 1, 2001.

⁸ Registration No. 2724628 issued on June 10, 2003 based upon an application filed on August 25, 1999 claiming first use anywhere at least as early as June 1998 and first use in commerce at least as early as July 1999. The English transliteration of the Chinese characters is "Jin, Lai and Shiang."

CALFOOD

for, *inter alia*, " ... soy bean milk" in International Class 29; and "mineral and aerated water and other non-alcoholic drinks ..." in International Class 32.⁹

Additionally, among the articles the Trademark Examining Attorney placed into the record is a study reported in several online locations showing that healthy beverages include lots of water and several servings of nonfat, fortified soy beverages, or the like:

Best Drinks For Watching Your Waistline

If you're watching your weight to no avail, it might not be the food you eat that is causing you to get fat. It could be what you drink.

Even healthy drinks, such as 100 percent fruit juice and milk, can make us fat if we drink too much of them, especially since most American adults consume a whopping 21 percent of their daily calories from beverages, twice as much as the 10 percent recommended by the World Health Organization. That led a blue-ribbon panel of six leading nutrition experts to devise healthy beverage guidelines that list what we can drink and what we should avoid. The idea is to help you realize how many extra calories you consume just by what you drink.

The group recommends that people should drink more water and limit or eliminate high-calorie beverages with little or no nutritional value. In addition, unsweetened tea and coffee, skim or low-fat milk and artificially-sweetened beverages are fine in moderation. Anything with sugar—soft drinks, sports drinks, fruit drinks and sweetened tea and coffee—should be avoided.

Healthy Beverage Guidelines: What You Can Drink

Water: Women should drink at least four servings of water and men should drink at least six servings a day. As much as possible, your beverage needs should come from water.

Unsweetened coffee and tea, iced and hot: Up to eight servings a day of tea and up to four servings of coffee. Do limit caffeine intake to no more than 400 milligrams a day, which is about 32 ounces of coffee and 64 ounces of tea.

⁹ Registration No. 2967385 issued on July 12, 2005 based upon an application filed on July 7, 2000 later claiming first use anywhere at least as early as July 1, 2003 and first use in commerce at least as early as July 13, 2003.

Nonfat milk or 1 percent fat milk and fortified soy beverages: Up to two servings. Children and adolescents should drink this much every day...¹⁰

Finally, as to the related *du Pont* factors of channels of trade and the anticipated classes of purchasers, the Trademark Examining Attorney has provided advertisements and online ordering forms from supermarkets such as Giant/Peapod, Safeway, MannaHarvest.net, MyWebGrocer.com, etc., showing all kinds of non-alcoholic beverages listed together, e.g., alphabetically by type. While it is not clear from this evidence that these respective beverages would necessarily be sold in the "same aisles" (the Trademark Examining Attorney's conclusion) in a brick-and-mortar grocery market, it is clear that they are promoted side-by-side, they do move through the same general channels of trade, and may well be seen as alternatives during the same shopping trip when the average consumer may be looking for healthy, bottled beverages. There is no indication that the goods are expensive or that prospective purchasers are sophisticated. On the contrary, these beverages would both seem to be firmly in the category of impulse items.

¹⁰ Healthy Beverage Guidelines reported by the AMERICAN JOURNAL OF CLINICAL NUTRITION, available at <http://www.beverageguidancepanel.org> (accessed by the Trademark Examining Attorney on March 30, 2006).

Conclusion

Applicant's marks are both substantially the same as Registrant's cited mark, the goods are related and appear to move through the same channels of trade to the same classes of ordinary purchasers. Accordingly, we find that there is a likelihood of confusion herein.

Decision: The refusals to register these marks based upon Section 2(d) of the Lanham Act are hereby affirmed.