

This Opinion is not a
Precedent of the TTAB

Mailed: November 30, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board

—
Vitasoy International Holdings Limited
v.
Caffe Vita, Inc.

—
Opposition No. 91214495
to Application Serial No. 85643555

—
Doreen L. Costa, Suzanne M. Hengl, and Julie Beth Albert of Baker Botts L.L.P. for
Vitasoy International Holdings Limited.

Leslie C. Ruiter and Theresa H. Wang of Stokes Lawrence, P.S. for Caffe Vita, Inc.

—
Before Zervas, Kuczma and Lynch,
Administrative Trademark Judges.



Opinion by Lynch, Administrative Trademark Judge:

Caffe Vita, Inc. (“Applicant” or “Caffe Vita”) seeks registration on the Principal Register of the mark VITA (in standard characters) for coffee in International Class

30 (“Application”).¹ Vitasoy International Holdings Limited (“Opposer” or “Vitasoy”) opposed registration under § 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), as likely to cause confusion with its following registered marks:

Mark	Reg. No.	Reg. Date	First Use	Goods
VITA	1833973	May 3, 1994	Jun. 24, 1992	Tea drinks (Class 30).
VITA	1893224	May 9, 1995	Oct. 15, 1980	Fruit juices, vegetable juices (Class 32).
維他 Translation of record: The foreign characters in the mark transliterate to “WEI TA” and this means “VITA” in English.	1747259	Jan. 19, 1993	Oct. 15, 1980	Vegetable based food beverage used as a milk substitute made from soya beans; tofu; and soybean curd (Class 29); Soybean based, non-carbonated, non-alcoholic drinks; namely, fruit and vegetable juice beverages; concentrates for making non-alcoholic, non-carbonated drinks, namely, fruit and vegetable juice beverages; and extracts of fruits and soybeans for making non-alcoholic, non-carbonated drinks; namely, fruit and vegetable juice beverages (Class 32).
維他 Translation of record: The Chinese characters in the mark translate to “VITA.”	1900795	Jun. 20, 1995	Jun. 24, 1993	Tea drinks (Class 30).

¹ Application Serial No. 85643555, filed June 5, 2012, includes a claim of first use in commerce on January 1, 1995.

 Translation of record: The Chinese characters in the mark are translated in English as "VITA."	1990485	Jul. 30, 1996	Aug. 2, 1995	Soybean curd desserts, namely pudding (Class 30).
	4454517	Dec. 24, 2013	May 1, 2013	Fruit drinks and fruit juices (Class 32).

In its answer, Applicant denies the salient allegations in the notice of opposition.²

I. Standing and Priority

Opposer must prove standing by showing a real interest in the outcome of the proceeding and a reasonable basis for believing that it would suffer damage if the mark is registered. *See* 15 U.S.C. § 1063; *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1026 (Fed. Cir. 1999). Opposer's pleaded registrations showing current status and title set forth above and made of record through its Notice of Reliance establish its standing.³ *See Coach Services v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727-28 (Fed. Cir. 2012).

Because opposer has properly made its pleaded registrations of record, § 2(d) priority is not an issue in this case as to the marks and the goods covered by these registration. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182

² 4 TTABVUE.

³ 5 TTABVUE at 10-79.

USPQ 108, 110 (CCPA 1974); *Miss Universe L.P. v. Community Marketing Inc.*, 82 USPQ2d 1562, 1566 (TTAB 2007).

II. Evidentiary Issues and the Record

Opposer moves to strike numerous exhibits in Applicant's Notice of Reliance and Supplemental Notice of Reliance.⁴ Applicant counters each of the grounds of the motion to strike.⁵ Even if we were to rule for Applicant on all points raised in the motion to strike and consider all of Applicant's evidence, we nonetheless would not find in Applicant's favor on the merits. In light of that and given the number and nature of Opposer's objections and arguments in its motion to strike, in the interest of administrative efficiency, we deny the motion to strike and consider all of Applicant's exhibits. *See Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1326 (TTAB 2011) (evidentiary estoppel sanction may be denied where infractions do not prejudice opponent).

We address Opposer's request in its Trial Brief for judicial notice of the fact that "prominent beverage chains like Dunkin' Donuts and Starbucks regularly offer both coffee and tea products," for which Opposer provided links to their respective websites.⁶ Judicial notice may be taken of facts not subject to reasonable dispute because they are generally known or "can be accurately and readily determined from sources whose accuracy cannot reasonably be questioned." Fed. R. Evid. 201. While the Board frequently exercises its discretion to take judicial notice of

⁴ 10 TTABVUE (Opposer's Motion to Strike).

⁵ 11 TTABVUE (Applicant's Response to Opposer's Motion to Strike).

⁶ 18 TTABVUE at 16.

dictionary definitions or entries from reference works, particularly given the late timing of the request⁷ and in view of the nature of this factual assertion about the retail activity of particular entities, we do not deem it appropriate for judicial notice. The factual assertion does not appear to be generally known, and the internet URLs provided for particular retail websites do not constitute the types of sources whose accuracy cannot reasonably be questioned, as contemplated by the rule. *See UMG Recordings, Inc. v. Mattel, Inc.*, 100 USPQ2d 1868, 1874 (TTAB 2011) (rejecting request for judicial notice of webpages); *Motion Picture Ass'n of Am., Inc. v. Respect Sportswear, Inc.*, 83 USPQ2d 1555, 1558 (TTAB 2007) (denying judicial notice of internet search engine results and eBay postings).

Thus, the record consists of: the pleadings; the file of the opposed application, trademark application Serial No. 85643555; Exhibits 1-44 from Opposer's Notice of Reliance; Exhibits 1-16 from Applicant's Notice of Reliance; Exhibit 17 from Applicant's Supplemental Notice of Reliance; and the testimony deposition of Michael McConnell, President of Applicant, and accompanying exhibits.

III. Applicable Law

The determination under § 2(d) involves an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *duPont*, 177 USPQ at 567; *see also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). A likelihood of confusion analysis often focuses primarily on the

⁷ *See* TBMP § 704.12(b) (June 2015) (requests for judicial notice “should be made during the requesting party’s testimony period, by notice of reliance accompanied by the necessary information.”).

similarities between the marks and the similarities between the goods and services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). With respect to the marks, we must compare them “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, 1691 (Fed. Cir. 2005) (quoting *duPont*, 177 USPQ at 567). As to the goods, we must determine whether their degree of relatedness rises to such a level that consumers would mistakenly believe the parties’ goods emanate from the same source. The comparison of goods must be assessed as they are identified in the application and registrations. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

IV. Analysis

We focus our analysis on Opposer’s Registration No. 1833973 for the standard character mark VITA for tea drinks (hereinafter, the Registration) because if we find no likelihood of confusion with the mark in the Registration, then it follows there would be no likelihood of confusion with the marks in the other pleaded registrations, in which the marks and/or the goods bear less similarity to the mark

and goods in the Application. *See In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

Similarity of the Marks VITA and VITA

Turning first to the similarity of the marks, this factor favors likely confusion because the marks are identical. *Majestic Distilling*, 65 USPQ2d at 1204. “[E]ven when goods or services are not competitive or intrinsically related, the use of identical marks can lead to the assumption that there is a common source,’ *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993).” *Id.* While acknowledging that the marks consist of the same word, Applicant makes misguided arguments that VITA and VITA differ in appearance and sound.⁸ Applicant attempts to rely on particular renditions of the standard character marks at issue and associated trade dress with which they are sometimes used to limit the depiction of the marks and to argue that the appearance differs. However, we reject Applicant’s proffered distinctions because “[r]egistrations with typed drawings are not limited to any particular rendition of the mark and, in particular, are not limited to the mark as it is used in commerce”. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000). “It is settled ... that distinction in trade dress cannot weigh against likelihood of confusion with respect to the registration of a simple word mark The reason is that such dress might well be changed at any time; only the word mark itself is to be registered.”

⁸ Given our focus on the standard character VITA registration, we need not reach the arguments relating to Opposer’s other registrations that include Chinese characters.

Kimberly-Clark Corp. v. H. Douglas Enters., 774 F.2d 1144, 227 USPQ 541, 543 (Fed. Cir. 1985).

Applicant contends that the identical VITA marks differ in sound because Opposer's mark would be pronounced with a long "I" sound, while its mark would be pronounced with a short "I" sound. As support for this factual contention, Applicant first points to the alleged transliteration of Chinese characters that appear in Opposer's *other* registrations of marks but not the standard character VITA Registration on which we base our analysis. Thus, the Chinese character considerations are irrelevant. *See id.* Applicant also points to a design it calls a "Pulcinella," an "Italian character" that is not part of the mark in the Application, but that Applicant claims to use on at least some of its coffee packaging. According to Applicant, the design proves that consumers would pronounce VITA in the Italian manner.⁹ As an initial matter, Applicant provides no proof that the design of an older man in a hat would be recognizable by consumers as the Italian Pulcinella character.¹⁰ In addition, we decline to limit either the mark in the Application or the Registration based on particular examples of their use in commerce. *See id.* Turning back to the proper consideration of the identical VITA standard character

⁹ 19 TTABVUE at 13-15.

¹⁰ In fact, the figure lacks some of the typical characteristics attributed to the stock Pulcinella character of the commedia dell'arte, who is "depicted as large, shambling, and stupid-looking, dressed in a loose white shirt and very full trousers." We take judicial notice of the *Encyclopedia Britannica Online* entry for "Punch" or "Pulcinella" (accessed November 19, 2015 at <http://www.britannica.com/topic/Punch-puppet-character>). Moreover, outside a theatrical context, the features of Applicant's character design seem rather nondescript and unlikely to be recognized by consumers as pointing uniquely to the Italian version of the stock character, who apparently also has similar adaptations in other European countries. *See id.*

marks, we conclude that they sound identical, as we remain mindful that “there is no correct pronunciation of a trademark, and consumers may pronounce a mark differently than intended by the brand owner.” *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012).

Clearly, the identical nature of these marks in appearance, sound, and commercial impression weighs heavily in favor of likely confusion.

Number and Nature of Similar Marks in Use on Similar Goods

Applicant argues that the *duPont* factor focusing on the number and nature of similar marks in use on similar goods means that the VITA mark in the Registration must be considered “weak and entitled to a narrow scope of protection.”¹¹ Applicant introduced a number of printouts of search results, registrations and applications from the USPTO database in support of its claim. Applicant indicates that it intends its TESS listings and “representative” printouts of some registrations to show “widespread registration of marks utilizing the word ‘vita’ in conjunction with food products, drinks and edible goods,” and responds that this is an acceptable way to show the term is weak.¹² Even where the record lacks proof of actual third-party *use* and the extent of third-party use, third-party registration evidence may show that a term carries a highly suggestive connotation in the relevant industry and therefore may be considered somewhat weak. *Juice Generation, Inc. v. GS Enterprises LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015); *Jack Wolfskin Ausrüstung Fur Draussen GmbH v. New Millennium*

¹¹ 19 TTABVUE at 10.

¹² 11 TTABVUE at 6 (Applicant’s Response to Opposer’s Motion to Strike at p. 5).

Sports, S.L.U., 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015). However, many of Applicant's examples concern marks registered under §66(a) or §44(e) for which no maintenance documents evincing use have been filed, *see Mucky Duck*, 6 USPQ2d at 1470, n.6 (registrations issued pursuant to Trademark Act § 44 "have very little, if any, persuasive value" for this purpose) or pending applications filed under the §1(b) intent to use basis with no use allegation filed, *see Wet Seal, Inc. v. FD Management*, 82 USPQ2d 1629, 1634 (TTAB 2007) ("An application is not evidence of anything except that the application was filed on a certain date.").¹³ The probative value of such evidence remains minimal. Similarly, the TESS listings offered by Applicant do not serve to introduce the listed registrations or applications, and therefore also have little, if any, persuasive value. *See Edom Laboratories Inc. v. Lichter*, 102 USPQ2d 1546, 1550 (TTAB 2012). Ultimately, active registrations in evidence that include the term VITA and for which the record includes a claim of use, consist of: five registrations in International Class 29 for goods such as fish products, canned tomatoes and olive oil;¹⁴ four registrations in International Class 30 for goods such as pasta, pasta sauces, bakery desserts, chocolate, and, in one registration for VITA FREE and design, herbal tea and coffee;¹⁵ and ten registrations in International Class 32 for goods such as powders

¹³ For example, Registration Nos. 3927925, 4359701, and 4647018 registered under §66(a) and lack any affidavit of use under §71. Reg. Nos. 4572574 and 4416991 registered under §44(e) and lack an affidavit of use under §8. Application Serial Nos. 86054540, 86189602 and 85467383, intent to use applications, have no statement of use filings.

¹⁴ 8 TTABVUE 208-238.

¹⁵ *Id.* at 251-273; VITA FREE and design Registration No. 4614781 covers a variety of food products, including caffeine-free coffee and herbal tea.

used in the preparation of fruit and tea flavored drinks, juices, smoothies, syrups for making soft drinks, coconut water, meal replacement drinks, energy drinks, and soda pops.¹⁶

Considering our focus on the Registration, which identifies only tea drinks, we note that with the exception of a single registration, Applicant's third-party registration evidence does not involve the same goods as are in the Registration. Thus, unlike in *Juice Generation* and *Jack Wolfskin*, where the third-party evidence involved the very same restaurant services and clothing at issue, here the third-party registration evidence relied upon relates to a broader range of goods, a variety of food and beverage products. Although weakness may be shown by extensive use on similar, as well as identical goods, we do not agree with Applicant that many of these goods qualify as similar. Separately, in arguing against relatedness, Applicant itself describes various beverages as "entirely different products marketed to different consumers."¹⁷ We find this evidence only somewhat probative as to alleged suggestiveness of the term in relation to tea drinks. In addition, the third-party evidence here appears less voluminous than that in *Juice Generation*, which addressed at least 26 uses or registrations of the same phrase for restaurant services.¹⁸ Finally, unlike the Application and Registration at issue in this case, the vast majority of these third-party registrations do not consist solely of the term

¹⁶ *Id.* at 286-318.

¹⁷ 19 TTABVUE at 17.

¹⁸ Neither the Court nor the Board in *Jack Wolfskin* provided a number of registrations or uses under consideration, though the Court referred to the evidence as "voluminous." *Jack Wolfskin*, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015).

VITA. Instead, they include other distinguishing matter, such as additional wording or a design. Thus, given the smaller number of 19 active registrations with claims of use in commerce and the lesser degree of relevancy to the marks and goods at issue, we find the evidence for this *duPont* factor weighs only very slightly against likely confusion.

Relatedness of the Coffee and Tea Drinks

Goods need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that the goods are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which would give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each party's goods. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and the cases cited therein. If the marks of the respective parties are identical as they are here, the relationship between the goods need not be as close to support a finding of likelihood of confusion. *In re Shell Oil Co.*, 26 USPQ2d at 1689.

Turning to the relatedness of Applicant's coffee to Opposer's tea drinks, the evidence includes: 38 active use-based registrations covering both coffee and tea;¹⁹ testimony by Applicant's president that Applicant's CAFFE VITA retail outlets sell

¹⁹ 5 TTABVUE at 80-159.

both coffee and tea;²⁰ and a Wikipedia entry about Opposer submitted by Applicant that indicates Opposer's products include both teas and coffee drinks.²¹ Third-party registrations which cover the same types of goods and are based on use in commerce suggest that the listed goods may emanate from the same source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993). Applicant makes the obvious point that they are different products, but goes on to argue that although a U.S. store might sell both coffee and tea drinks, "coffee beans and tea leaves come from different countries and have been distributed in vastly different channels of trade for centuries."²² First, Applicant points to no supporting evidence and makes no showing that consumers necessarily distinguish source based on the geographic origin of goods. Second, Applicant's characterizations of the goods as coffee *beans* (rather than "coffee") and tea *leaves* (rather than "tea drinks") that are not reflected in the identifications of goods in the Application and Registration may not be considered. *Octocom*, 16 USPQ2d at 1787 (identifications are controlling). We find that the evidence of Applicant's and Opposer's sales of both goods and the third-party registrations suggesting that numerous entities may provide coffee and tea under the same mark suffice to demonstrate the relatedness of coffee and tea. Thus, this factor weighs in favor of likely confusion.

²⁰ 15 TTABVUE at 49 (McConnell deposition).

²¹ 8 TTABVUE at 346-351.

²² 19 TTABVUE at 17.

Trade Channels

We presume that Opposer's "tea drinks" and Applicant's "coffee," for which the identifications contain no trade channel restrictions, travel through all usual channels of trade. *See Cunningham*, 55 USPQ2d at 1846. The trade channels for both products include wholesale sales to coffee and tea retailers and retail sales to member of the general public.²³ Applicant's claims about the trade channels, such as that "the vast majority of Applicant's coffee beans are sold at the wholesale level," or that Opposer "operates in Asian channels of trade for soy products,"²⁴ fail to withstand scrutiny for the same reason. "The authority is legion that 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*, 16 USPQ2d at 1787. Applicant's President even acknowledged that it sells both coffee and tea together in its retail outlets.²⁵ Thus, we conclude that the channels of trade for these goods are similar, and this factor weighs in favor of likely confusion.

Actual Confusion Factors

Based exclusively on testimony by its President, Applicant also argues that it knows of no instances of actual confusion with Opposer during its approximately 20

²³ 15 TTABVUE at 24-27, 49-50.

²⁴ 19 TTABVUE at 18, 19; *see also* 15 TTABVUE at 24 (Applicant's President estimating that 70% of its business is wholesale and 30% is retail).

²⁵ 15 TTABVUE at 49.

years of sales under the VITA mark.²⁶ See *duPont*, 177 USPQ at 567 (identifying seventh and eighth *duPont* factors as “the nature and extent of any actual confusion,” and “the length of time during and conditions under which there has been concurrent use without evidence of actual confusion”). However, “uncorroborated statements of no known instances of actual confusion are of little evidentiary value.” *In re Majestic Distilling Co.*, 65 USPQ2d at 1205; see also *In re Bissett-Berman Corp.*, 476 F.2d 640, 177 USPQ 528, 530 (CCPA 1973) (stating that self-serving testimony of appellant’s corporate president’s unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion); *Herbko Int’l v. Kappa Books*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (“[A] showing of actual confusion is not necessary to establish a likelihood of confusion”). Accordingly, given the nature of the evidence, we find this factor neutral.

Conclusion

The marks are identical, the goods are related, and they travel in the same trade channels. Even taking into account the third-party registration evidence as to VITA, it does not overcome the likely confusion. Considering that the Application and Registration are not for marks with a shared term along with other distinguishing matter, but rather are identical marks consisting solely of the term VITA, used on very similar goods, this factor does not outweigh the others. The neutral lack of actual confusion factors support neither conclusion. Applicant and Opposer have not

²⁶ 19 TTABVUE at 8; 15 TTABVUE at 25.

presented evidence or argument as to other *duPont* factors and, accordingly, we also treat those factors as neutral. Balancing the relevant factors, we consider the Application likely to result in consumer confusion based on the Registration.

Decision: The opposition is sustained and registration to Applicant is refused.