

**THIS OPINION
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THE TTAB**

Mailed: January 16, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

The Republic of Tea, Inc.
v.
Herbal Republic Inc.

Cancellation No. 92043748
to Registration No. 2885604
issued on September 21, 2004

Jeffrey L. Michelman of Stinson Morrison Hecker for The
Republic of Tea, Inc.

Kathryn J. Fritz of Fenwick & West for Herbal Republic Inc.

Before Quinn, Walters and Bergsman, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

The Republic of Tea, Inc. filed its petition to cancel
the registration of Herbal Republic Inc. for the mark shown
below for "tea and herbal teas; iced tea beverages; tea-
based beverages with fruit flavoring; tea-based beverages
with milk; liquid and powdered tea beverage mixes; baked
goods, namely, cookies, muffins, scones, biscuits, pastries

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and breads; chocolate, candy and frozen confections," in International Class 30.¹

HerbalRepublic

As grounds for the petition, petitioner asserts that respondent's mark, when applied to respondent's goods, so resembles petitioner's previously used and registered marks noted below as to be likely to cause confusion, under Section 2(d) of the Trademark Act.

- Registration No. 1797903² for the mark shown below for "clothing; namely, men's and women's shirts, sweat shirts, pants, slacks, shoes, jackets and coats," in International Class 25. The registration includes a disclaimer of TEA apart from the mark as a whole.



The REPUBLIC of TEA

¹ Registration No. 2886604, issued September 21, 2004.

² Registered October 12, 1993. Renewed. Section 15 affidavit acknowledged.

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- Registration No. 1848818³ for the mark THE REPUBLIC OF TEA in standard character format for "art prints, storage boxes and bags, adhesive decals and posters," in International Class 16; "clothing; namely, men's and women's shirts," in International Class 25; and "tea," in International Class 30. The registration includes a disclaimer of TEA apart from the mark as a whole.
 - Registration No. 2071181⁴ for the mark REPUBLIC CHAI for "tea," in International Class 30 and "tea flavored soft drinks," in International Class 32. The registration includes a disclaimer of CHAI apart from the mark as a whole and a translation of CHAI as "tea" in English.
 - Registration No. 2502199⁵ for the mark IMPERIAL REPUBLIC for "tea," in International Class 30.
- Respondent, in its answer, denied the salient allegations of the claim.⁶

The Record

³ Registered August 9, 1994. Renewed. Section 15 affidavit acknowledged.

⁴ Registered June 17, 1997. Renewed. Section 15 affidavit acknowledged.

⁵ Registered October 30, 2001. Sections 8 and 15 affidavits accepted and acknowledged.

⁶ While respondent asserted the affirmative defenses of laches, estoppel and acquiescence, respondent did not pursue these defenses and therefore we consider the defenses to have been withdrawn and we have given these defenses no further consideration.

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The record consists of the pleadings; the file of the involved registration; and the testimony deposition by petitioner of Ronald T. Rubin, petitioner's owner, with accompanying exhibits. We note that the majority of the exhibits attached to Mr. Rubin's deposition are illegible photocopies. We have considered the exhibits to the extent that we can read them. However, the illegible exhibits or illegible portions of exhibits are, obviously, of no probative value. Petitioner also attached evidence to its brief. All evidence must be submitted during the appropriate trial period and, thus, this evidence is untimely and has been given no consideration. TBMP §704.05(b) (2d ed. rev. 2004).

Respondent submitted no testimony or other evidence. Only petitioner filed a brief on the case.

The Parties

There is no information about respondent in the record other than the statement in the application underlying its registration that respondent is a Canadian corporation.

Petitioner failed to make its pleaded registrations of record or otherwise establish the status and title of these registrations.

Through the testimony deposition of Ronald Rubin, petitioner has established that it is a California corporation that produces and sells various types of teas,

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including a bottled tea drink. From Mr. Rubin's statements, we can conclude that petitioner uses the mark THE REPUBLIC OF TEA in connection with its products; that Mr. Rubin's predecessors as owners of the business obtained a federal registration of this mark in May 1992⁷; that when Mr. Rubin purchased the business on February 23, 1995, the company was producing and selling tea; and that Mr. Rubin expanded the business to include many different types of teas, including herbal and organic teas, bottled and boxed tea drinks, and other products, such as tea cooking oil. Mr. Rubin stated that both petitioner and respondent offer ginger peach tea. In the year prior to Mr. Rubin's deposition, petitioner accrued \$10 million in sales of tea products. Petitioner's products are available through its mail order catalog, at its website, and at retailers such as Whole Foods, Cost Plus World Market and Wegman's Central Market.

Analysis

Because petitioner has established use of THE REPUBLIC OF TEA as a mark in connection with tea, and because petitioner's likelihood of confusion claim is not frivolous, we find that petitioner has established its standing in this cancellation proceeding. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton*

⁷ The record does not identify the specific goods recited in the registration or indicate current status and title of the registration.

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Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Next, we must determine whether petitioner or respondent has priority. The evidence is sufficient to conclude that petitioner has a first use date of the mark THE REPUBLIC OF TEA at least as early as the date Mr. Rubin purchased the ongoing business of petitioner, i.e., February 23, 1995. This date is prior to both the filing date of respondent's underlying application, September 10, 2003, and its registration date, September 21, 2004. Therefore, petitioner has established its priority.

Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in

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the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). See also *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

With respect to the goods of the parties, petitioner uses its mark in connection with teas, including herbal teas, and bottled tea drinks. These items are identical to the "herbal teas" and essentially identical to the "tea-based beverages ..." recited in respondent's identification of goods. In view of the identity of these goods, it is unnecessary to consider what, if any, relationship petitioner's goods have to the other goods recited in the registration, all of which are in the same class. Thus, we conclude that the goods of the parties are legally identical.

Turning to the marks, it is well settled that the degree of similarity in the respective marks necessary to find likelihood of confusion is less when the goods of the parties are the same and are directly competitive than if goods were not the same. *Real Estate One, Inc. v. Real Estate 100 Enterprises Corporation*, 212 USPQ 957, 959 (TTAB 1981); *ECI Division of E-Systems, Inc. v. Environmental Communications Incorporation*, 207 USPQ 443, 449 (TTAB 1980). Also, we note that while we must base our determination on a

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comparison of the marks in their entireties, we are guided, equally, by the well established principle that, in articulating reasons for reaching a conclusion on the issue of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.*, 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

In connection with petitioner's goods, tea, the term TEA in its mark, THE REPUBLIC OF TEA, is certainly generic, while the term REPUBLIC is arbitrary. In connection with respondent's goods, including herbal teas, the term HERBAL in its stylized mark, HERBALREPUBLIC, is at least merely descriptive and respondent's mark also includes the arbitrary term REPUBLIC. REPUBLIC is clearly the dominant term in both marks.

Respondent's mark consists of the words HERBAL and REPUBLIC telescoped to form a single word. However, the separate impressions and connotations of the words is emphasized by the fact that the word HERBAL appears in a much darker type than the word REPUBLIC. The font in which both words appear is, itself, nondistinctive.

Regarding the connotations of the marks, petitioner's mark, THE REPUBLIC OF TEA, suggests, whimsically, a country

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of tea. In connection with herbal tea, respondent's mark, HERBALREPUBLIC, also suggests, whimsically, an herbal tea country. Thus, the connotations of the marks are substantially similar. We find that the overall commercial impressions of the marks are substantially similar.

In a cancellation proceeding, we note that "a presumption of validity attaches to a [trade]mark registration, and the party seeking cancellation must rebut this presumption by a preponderance of the evidence." *West Florida Seafood Inc. v. Jet Restaurants Inc.*, 31 F.3d 1122, 31 USPQ 1660, 1662 (Fed. Cir. 1994). See also *Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989). We hold that petitioner has met its burden. In view of the substantial similarity in the commercial impressions of petitioner's mark, THE REPUBLIC OF TEA, and respondent's stylized mark, HERBALREPUBLIC, their contemporaneous use on the identical goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

Decision: The petition to cancel is granted.