

ESTTA Tracking number: **ESTTA46646**

Filing date: **09/28/2005**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

### Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

#### Opposer Information

<b>Name</b>	VITASOY INTERNATIONAL HOLDINGS LIMITED
<b>Granted to Date of previous extension</b>	09/28/2005
<b>Address</b>	1 Kin Wong Street Tuen Mun New Territories, HONG KONG

<b>Attorney information</b>	CAROLE F. BARRETT HOWARD, RICE, NEMEROVSKI, CANADY, FALK & THREE EMBARCADERO CENTER, SEVENTH FL SAN FRANCISCO, CA 94111-4024 UNITED STATES trademark@howardrice.com Phone:415.434.1600
-----------------------------	---

#### Applicant Information

<b>Application No</b>	79000958	<b>Publication date</b>	05/31/2005
<b>Opposition Filing Date</b>	09/28/2005	<b>Opposition Period Ends</b>	09/28/2005
<b>International Registration No.</b>	0802633	<b>International Registration Date</b>	03/05/2003

<b>Applicant</b>	Pedro Maria Barroeta Urquiza Calle San Juan de la Cruz 3 -Portal 2, 1 <sup>o</sup> B E-28223 Pozuelo de Alarc3n (Madrid), SPAIN
------------------	--

**Goods/Services Affected by Opposition**

Class 030. All goods and seVICES in the class are opposed, namely: Tea; tea-based beverages
--

**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

**Marks Cited by Opposer as Basis for Opposition**

<b>U.S. Registration No.</b>	1833973	<b>Application Date</b>	06/17/1993
<b>Registration Date</b>	05/03/1994		
<b>Word Mark</b>	VITA		
<b>Goods/Services</b>	Class 030. First use: First Use: 19930624First Use In Commerce: 19930624 [ coffee and ] tea drinks		

<b>U.S. Registration No.</b>	1893224	<b>Application Date</b>	11/05/1993
<b>Registration Date</b>	05/09/1995		
<b>Word Mark</b>	VITA		
<b>Goods/Services</b>	Class 029. First use: First Use: 19801015First Use In Commerce: 19801015 [ soy-based beverage used as a milk substitute ]		

	Class 032. First use: First Use: 19801015First Use In Commerce: 19801015 fruit juices, vegetable juices [, and soft drinks]		
--	--	--	--

<b>U.S. Registration No.</b>	1147761	<b>Application Date</b>	11/29/1978
------------------------------	---------	-------------------------	------------

<b>Registration Date</b>	02/24/1981		
--------------------------	------------	--	--

<b>Goods/Services</b>	Class 029. First use: Vegetable Based Milk Substitute Made from Soya Beans		
-----------------------	---	--	--

<b>U.S. Registration No.</b>	1900795	<b>Application Date</b>	06/17/1993
------------------------------	---------	-------------------------	------------

<b>Registration Date</b>	06/20/1995		
--------------------------	------------	--	--

<b>Goods/Services</b>	Class 030. First use: First Use: 19930624First Use In Commerce: 19930624 [ coffee and ] tea drinks		
-----------------------	---	--	--

<b>U.S. Registration No.</b>	1747259	<b>Application Date</b>	11/12/1991
------------------------------	---------	-------------------------	------------

<b>Registration Date</b>	01/19/1993		
--------------------------	------------	--	--

<b>Goods/Services</b>	Class 029. First use: First Use: 19801015First Use In Commerce: 19801015 vegetable based food beverage used as a milk substitute made from soya beans; tofu; and [canned, dried,] soybean curd Class 032. First use: First Use: 19801015First Use In Commerce: 19801015 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		
-----------------------	--	--	--

<b>U.S. Registration No.</b>	1990485	<b>Application Date</b>	11/19/1993
<b>Registration Date</b>	07/30/1996		
<b>Goods/Services</b>	Class 030. First use: First Use: 19950802First Use In Commerce: 19950802 soybean curd desserts, namely pudding and custard		

<b>U.S. Registration No.</b>	2765529	<b>Application Date</b>	02/23/2001
<b>Registration Date</b>	09/16/2003		
<b>Word Mark</b>	VITASOY		
<b>Goods/Services</b>	Class 029. First use: First Use: 19870500First Use In Commerce: 19870500 Fresh tofu; soy beverages, namely, soy based beverage used as a milk substitute Class 030. First use: First Use: 19950800First Use In Commerce: 19950800 Tofu desserts, namely, tofu based puddings and custards made with soy; soy beverages, namely, teas made with soy		

<b>U.S. Registration No.</b>	2574498	<b>Application Date</b>	10/19/2000
<b>Registration Date</b>	05/28/2002		
<b>Word Mark</b>	VITASOY		
<b>Goods/Services</b>	Class 029. First use: First Use: 19800800First Use In Commerce: 19800800 soya bean milk		

<b>U.S. Registration No.</b>	1868942	<b>Application Date</b>	05/17/1991
------------------------------	---------	-------------------------	------------

<b>Registration Date</b>	12/20/1994
<b>Word Mark</b>	VITASOY
<b>Goods/Services</b>	Class 029. First use: First Use: 19910400First Use In Commerce: 19910400 tofu

<b>U.S. Registration No.</b>	1968713	<b>Application Date</b>	05/17/1991
<b>Registration Date</b>	04/16/1996		
<b>Word Mark</b>	VITASOY		
<b>Goods/Services</b>	Class 030. First use: First Use: 19950802First Use In Commerce: 19950802 soybean-based pudding and custard [ , ice cream and frozen yogurt, non-dairy noodles and pasta ]		

<b>U.S. Registration No.</b>	1830741	<b>Application Date</b>	11/12/1991
<b>Registration Date</b>	04/12/1994		
<b>Goods/Services</b>	Class 032. First use: First Use: 19800000First Use In Commerce: 19800000 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, extracts of fruits and soybeans for making non-alcoholic, non-carbonated drinks; namely, fruit and vegetable juice beverages]		

<b>U.S. Application/Registration No.</b>	NONE	<b>Application Date</b>	NONE
<b>Registration Date</b>	NONE		

<b>Word Mark</b>	For purposes of this Opposition pleading, Opposer's VITA marks, marks which transliterate into VITA, Opposer's VITASOY marks, and the mark which transliterates into VITASOY, will be referred to collectively as "Opposer's VITA Marks."
<b>Goods/Services</b>	tea drinks, fruit juices, vegetable juices, vegetable based milk substitute made from soya beans, vegetable based food beverage used as a milk substitute made from soya beans; tofu; soybean curd, 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, soybean curd desserts, namely pudding and custard, fresh tofu, soy beverages, namely, soy based beverage used as a milk substitute, tofu desserts, namely, tofu based puddings and custards made with soy; soy beverages, namely, teas made with soy, soya bean milk, tofu, soybean-based pudding and custard.

<b>Attachments</b>	73194964#TMSN.gif ( 1 page ) 74403399#TMSN.gif ( 1 page ) 74220829#TMSN.gif ( 1 page ) 75975019#TMSN.gif ( 1 page ) 76975715#TMSN.gif ( 1 page ) 76152525#TMSN.gif ( 1 page ) 74220828#TMSN.gif ( 1 page ) 79000958.pdf ( 9 pages )
--------------------	--

<b>Signature</b>	/CFB_lmd/
<b>Name</b>	CAROLE F. BARRETT
<b>Date</b>	09/28/2005

維他奶

維他



維他

維也

**VITASOY**

**VITASOY**

維他耶

Certificate of Mailing

I hereby certify that this paper is being submitted electronically to the Trademark Trial and Appeal Board, 2900 Crystal Drive, Arlington, VA 22202, on the date shown below.

By and through Opposer's attorney, the Trademark Office is authorized by Carole F. Barrett, Attorney for Opposer, to charge the requisite filing fees to the Deposit Account of Howard, Rice Nemerovski, Canady, Falk & Rabkin, Account No. 08-2792.

/CFB/  
Carole F. Barrett

September 28, 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD

VITASOY INTERNATIONAL  
HOLDINGS LIMITED,

Opposer,

v.

PEDRO MARIA BARROETA URQUIZA.,

Applicant.

Mark: VITATEA

Serial No. 79/000,958

Filed: November 20, 2003

Published: May 31, 2005

Opposition No. \_\_\_\_\_

NOTICE OF OPPOSITION

Vitasoy International Holdings Limited, a Hong Kong corporation, located and doing business at 1 Kin Wong Street, Tuen Mun, New Territories, Hong Kong ("Vitasoy" or "Opposer"), believes that it will be damaged by the registration of the mark VITATEA shown in Application Serial No. 79/000,958 and hereby opposes the same.

As grounds for opposition, Opposer alleges:

1. Pedro Maria Barroeta Urquiza (“Applicant”), filed a trademark application with the United States Patent and Trademark Office (“PTO”) on November 30, 2003 Application Serial No. 79/000,958 (“the Application”), to register the mark VITATEA (“Applicant’s VITATEA Mark”) for use in connection with tea and tea-based beverages in International Class 30.

2. The Application is based on the Applicant’s International Registration No. 0802633 with an International Registration Date of March 5, 2003.

3. The Application was published for opposition in the *Official Gazette* on May 31, 2005. On June 6, 2005, Opposer filed a request for a 90-day extension to oppose the Application, which the Trademark Trial and Appeal Board (“Board”) granted.

4. On information and belief, Applicant has not made use of Applicant’s VITATEA Mark in United States interstate or intrastate commerce or international commerce with the United States.

5. On information and belief, Applicant has not used Applicant’s VITATEA Mark in advertising in the United States.

6. On information and belief, Applicant has not made any use of Applicant’s VITATEA Mark within the United States in connection with the goods named in the Application or related goods or services.

7. Opposer is a manufacturer of food and beverage products, including tea and tea beverages, bottled water, fruit juices, vegetable juices, soft drinks, and soymilk beverages. Opposer’s products are distributed throughout the world, including throughout the United States.

8. Opposer advertises and sells food and beverage products throughout the United States bearing the VITA mark (“Opposer’s VITA Mark”), the VITASOY mark (“Opposer’s VITASOY Mark”), and other highly similar marks.

9. Since at least as early as 1980, Opposer has sold non-carbonated, non-alcoholic beverage products throughout the United States, such as fruit and vegetable

juice beverages in connection with Opposer's VITA Mark, Opposer's VITASOY Mark, and other highly similar marks.

10. Since at least as early as 1993, Opposer has continuously sold tea and tea beverage products throughout the United States in connection with Opposer's VITA Mark, Opposer's VITASOY Mark, and other highly similar marks.

11. Since at least as early as 1980, Opposer has sold other beverage products throughout the United States, such as fruit juices, vegetable juices, and soymilk beverages in connection with Opposer's VITA Mark, Opposer's VITASOY Mark, and other highly similar marks.

12. Opposer is the owner of U.S. Registration No. 1833973 for the mark VITA issued on May 3, 1994, which covers tea drinks in international class 030. Opposer filed the affidavit of use and a request for incontestability with the PTO pursuant to Section 15 of the Lanham Act (15 U.S.C. §1065) on March 15, 2000, which was accepted and acknowledged by the PTO on June 2, 2000, rendering Opposer's rights in this registered mark incontestable. Opposer filed the Section 8 affidavit of use and Section 9 application for renewal on March 31, 2004, which was accepted and granted by the PTO on May 17, 2004. A copy of the TARR record showing the current active status of this registration is attached as Exhibit A.

13. Opposer is the owner of U.S. Registration No. 1893224 for the mark VITA issued on May 9, 1995, which covers fruit juices and vegetable juices in international class 032. Opposer filed the affidavit of use and a request for incontestability with the PTO pursuant to Section 15 of the Lanham Act (15 U.S.C. §1065) on May 3, 2001, which was accepted and acknowledged by the PTO on July 6, 2001, rendering Opposer's rights in this registered mark incontestable. Opposer filed the affidavit of use and application for renewal on March 14, 2005, which was accepted and granted by the PTO on May 5, 2005. A copy of the TARR record showing the current status of this registration is attached as Exhibit B.



14. Opposer is the owner of U.S. Registration No. 1147761, for the mark VITA MILK in Chinese characters, the first two of the three Chinese characters of the mark, from left to right, being "Vita" phonetically and the third character is "Milk", which covers vegetable based milk substitute made from soya beans, in International Class 029. Opposer filed the affidavit of use and request for incontestability with the PTO pursuant to Section 15 of the Lanham Act (15 U.S.C. §1065) on March 27, 1986, which was accepted and acknowledged by the PTO on June 26, 1986, rendering Opposer's rights in this registered mark incontestable. Opposer filed the affidavit of use and application for renewal with the PTO on February 6, 2001, which was accepted and granted on May 19, 2001. A copy of the TARR record showing the current active status of this registration is attached as Exhibit C.

15. Opposer is the owner of U.S. Registration No. 1900795 for the mark consisting of Chinese characters, which mean VITA in English. This registration covers tea drinks in International Class 030. Opposer filed the affidavit of use and request for incontestability with the PTO pursuant to Section 15 of the Lanham Act (15 U.S.C. §1065) on February 6, 2001, which was accepted and acknowledged by the PTO on May 5, 2001, rendering Opposer's rights in this registered mark incontestable. Opposer filed the affidavit of use and application for renewal with the PTO on June 22, 2004, which was accepted and granted by the PTO on September 6, 2004. A copy of the TARR record showing the current active status of this registration is attached as Exhibit D.

16. Opposer is the owner of U.S. Registration No. 1747259 for the mark consisting of Chinese characters, which transliterate to WEI TA, and which means VITA in English. This registration covers vegetable based food beverage used as a milk substitute made from soya beans, tofu, and soybean curd, in international class 29, and 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, in international class 030. Opposer filed the affidavit of use and request for incontestability with the PTO pursuant to Section 15 of the Lanham Act (15 U.S.C. §1065) on March 19, 1998, which was accepted and acknowledged by the PTO on July 21, 1998, rendering Opposer's rights in this registered mark incontestable. Opposer filed the affidavit of use and application for renewal with the PTO on August 12, 2002, which was accepted and granted by the PTO on October 31, 2002. A copy of the TARR record showing the current active status of this registration is attached as Exhibit E.

17. Opposer is the owner of U.S. Registration No. 1990485 for the mark consisting of Chinese characters, which mean VITA in English. This registration covers soybean curd desserts, namely pudding and custard in International Class 030. Opposer filed the affidavit of use and request for incontestability with the PTO pursuant to Section 15 of the Lanham Act (15 U.S.C. §1065) on December 18, 2001, which was accepted and acknowledged by the PTO on February 22, 2002, rendering Opposer's rights in this registered mark incontestable. A copy of the TARR record showing the current active status of this registration is attached as Exhibit F.

18. Opposer is the owner of U.S. Registration No. 2765529 issued on September 16, 2003 for the mark VITASOY and design. This registration covers fresh tofu; soy beverages, namely, soy based beverage used as a milk substitute, in international class 29, and tofu desserts, namely, tofu based puddings and custards made with soy; soy beverages, namely, teas made with soy, in international class 30. A copy of the TARR record showing the current active status of this registration is attached as Exhibit G.

19. Opposer is the owner of U.S. Registration No. 2574498 issued May 28, 2002 for the mark VITASOY, which covers soya bean milk in International Class 029. A copy of the TARR record showing the current active status of this registration is attached as Exhibit H.

20. Opposer is the owner of U.S. Registration No. 1868942 for the mark VITASOY, which covers tofu in International Class 029. Opposer filed the affidavit of use and request for incontestability with the PTO pursuant to Section 15 of the Lanham Act (15 U.S.C. §1065) on March 16, 2000, which was accepted and acknowledged by the PTO on October 4, 2000, rendering Opposer's rights in this registered mark incontestable. Opposer filed the affidavit of use and application for renewal on March 31, 2004, which was accepted and granted by the PTO on April 27, 2004. A copy of the TARR record showing the current active status of this registration is attached as Exhibit I.

21. Opposer is the owner of U.S. Registration No. 1968713 for the mark VITASOY, which covers soybean-based pudding and custard in International Class 030. Opposer filed the affidavit of use and request for incontestability with the PTO pursuant to Section 15 of the Lanham Act (15 U.S.C. §1065) on January 18, 2002, which was accepted and acknowledged by the PTO on March 20, 2002, rendering Opposer's rights in this registered mark incontestable. A copy of the TARR record showing the current active status of this registration is attached as Exhibit J.

22. Opposer is the owner of U.S. Registration No. 1830741, for the mark Vitasoy in Chinese Characters, which transliterates to "wac tab nab" which means "Vitasoy" in English, which covers soybean-based non-carbonated, non-alcoholic drinks; namely, fruit and vegetable juice beverages, in International Class 032. Opposer filed the affidavit of use and request for incontestability with the PTO pursuant to Section 15 of the Lanham Act (15 U.S.C. §1065) on July 19, 1999, which was accepted and acknowledged by the PTO on November 6, 1999, rendering Opposer's rights in this registered mark incontestable. Opposer filed the affidavit of use and application for renewal with the PTO on March 18, 2004, which was accepted and granted on April 30, 2004. A copy of the TARR record showing the current active status of this registration is attached as Exhibit L.

23. For purposes of this Opposition pleading, Opposer's VITA marks, referenced in paragraphs 12 and 13, Opposer's marks which transliterate into VITA, referenced in paragraphs 14, 15, 16 and 17, Opposer's VITASOY marks, referenced in paragraphs 18, 19, 20 and 21, and Opposer's mark which transliterates into VITASOY, referenced in paragraph 22, will be referred to collectively as "Opposer's VITA Marks."

24. Since at least as early as 1993, Opposer has extensively advertised Opposer's beverage products sold in connection with Opposer's VITA Marks throughout the United States, including Opposer's tea and tea beverages, through the use of print, radio, television, point-of-purchase advertising, and Internet advertising.

25. Opposer's products bearing Opposer's VITA Marks, including Opposer's tea and tea beverages, have been and are currently sold throughout the United States at major supermarkets, health-food stores, and smaller specialty-food stores, as well as through online retail point of purchase sales sites.

26. Consumers of Opposer's products associate Opposer's VITA Marks with Opposer's products, which significantly include tea, tea beverages, and other non-carbonated, non-alcoholic beverages.

27. As a result of Opposer's extensive advertising and use of Opposer's VITA Marks in connection with food products and non-carbonated, non-alcoholic beverages, including tea and tea beverages, Opposer's VITA Marks have acquired extensive goodwill throughout the United States, are associated in the minds of the general public with Opposer, and constitute famous marks.

28. Applicant's VITATEA Mark incorporates Opposer's VITA mark in combination with the generic term TEA, and Applicant's VITATEA Mark is highly similar in text, sound, and appearance to Opposer's VITA Marks. Applicant's registration and use of Applicant's VITATEA Mark would likely create confusion, mistake, or deception in the minds of prospective purchasers as to the origin or source of Applicant's goods.

29. The goods covered by the Application are closely related to the goods covered by Opposer's registrations for Opposer's VITA Marks, specifically Opposer's tea, tea beverages and other non-alcoholic, non-carbonated beverages, as well as products advertised and sold by Opposer that are not specifically named in these registrations. The goods covered by the Application are likely to be sold in the same channels of trade, in the same stores and in the same sections of such stores, and to the same customers as the goods offered by Opposer under Opposer's VITA Marks.

30. Applicant's VITATEA Mark so resembles Opposer's VITA Marks, such that purchasers familiar with Opposer's products are likely to believe, mistakenly, that Applicant's goods are sponsored by, authorized, endorsed, or otherwise approved by Opposer, within the meaning of Section 2 of the Lanham Act, 15 U.S.C. §1052(d).

31. Applicant's VITATEA Mark so resembles Opposer's VITA Marks, such that the sale of products by Applicant bearing the VITA mark would cause dilution to the distinctive quality of Opposer's VITA Marks, within the meaning of Section 43 of the Lanham Act, 15 U.S.C §1125(c).

WHEREFORE, Opposer respectfully requests that registration of the mark shown in Application Serial No. 79/000,958 be refused and that this Opposition be sustained in favor of Opposer.

Please deduct the filing fee of \$300.00 from Deposit Account No. 082792. Please deduct any additional fees that may be due, or credit any overpayment, to the same deposit account.

DATED: September 28, 2005

CAROLE F. BARRETT  
JEFFREY M. ROSENFELD  
HOWARD, RICE, NEMEROVSKI,  
CANADY, FALK & RABKIN  
A Professional Corporation  
Three Embarcadero Center, Seventh Floor  
San Francisco, California 94111  
Telephone: 415/434-1600  
Facsimile: 415/217-5910

/CFB lmd/  
CAROLE F. BARRETT

Attorneys for Opposer Vitasoy International  
Holdings Limited