

ESTTA Tracking number: **ESTTA582027**

Filing date: **01/15/2014**

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

Name	Vitasoy International Holdings Limited
Granted to Date of previous extension	01/15/2014
Address	1 Kin Wong Street Tuen Mun, HONG KONG
Domestic Representative	Doreen L. Costa Baker Botts L.L.P. 30 Rockefeller Plaza New York, NY 10112 UNITED STATES doreen.costa@bakerbotts.com, suzanne.hengl@bakerbotts.com, nytmd@bakerbotts.com Phone:212-408-2500

Applicant Information

Application No	85643555	Publication date	09/17/2013
Opposition Filing Date	01/15/2014	Opposition Period Ends	01/15/2014
Applicant	Caffe Vita, Inc. 1005 East Pike Street Seattle, WA 98122 WA		

Goods/Services Affected by Opposition

Class 030. First Use: 1995/01/01 First Use In Commerce: 1995/01/01
All goods and services in the class are opposed, namely: Coffee

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1833973	Application Date	06/17/1993
Registration Date	05/03/1994	Foreign Priority Date	NONE
Word Mark	VITA		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 030. First use: First Use: 1993/06/24 First Use In Commerce: 1993/06/24 [coffee and] tea drinks

U.S. Registration No.	1893224	Application Date	11/05/1993
Registration Date	05/09/1995	Foreign Priority Date	NONE
Word Mark	VITA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 1980/10/15 First Use In Commerce: 1980/10/15 [soy-based beverage used as a milk substitute] Class 032. First use: First Use: 1980/10/15 First Use In Commerce: 1980/10/15 fruit juices, vegetable juices [, and soft drinks]		

U.S. Registration No.	1147761	Application Date	11/29/1978
Registration Date	02/24/1981	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 0 First Use In Commerce: 0 Vegetable Based Milk Substitute Made from Soya Beans		

U.S. Registration No.	1747259	Application Date	11/12/1991
Registration Date	01/19/1993	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 029. First use: First Use: 1980/10/15 First Use In Commerce: 1980/10/15 vegetable based food beverage used as amilk substitute made from soya beans; tofu; and [canned, dried,] soybean curd Class 032. First use: First Use: 1980/10/15 First Use In Commerce: 1980/10/15 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

U.S. Registration No.	1900795	Application Date	06/17/1993
Registration Date	06/20/1995	Foreign Priority Date	NONE

Word Mark	NONE
Design Mark	
Description of Mark	NONE
Goods/Services	Class 030. First use: First Use: 1993/06/24 First Use In Commerce: 1993/06/24 [coffee and] tea drinks

U.S. Registration No.	1990485	Application Date	11/19/1993
Registration Date	07/30/1996	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 030. First use: First Use: 1995/08/02 First Use In Commerce: 1995/08/02 soybean curd desserts, namely pudding [and custard]

U.S. Registration No.	4454517	Application Date	05/07/2013
Registration Date	12/24/2013	Foreign Priority Date	NONE
Word Mark	VITA		
Design Mark			
Description of Mark	The mark consists of the word "vita" with a leaf over the letter "i".		
Goods/Services	Class 032. First use: First Use: 2013/05/01 First Use In Commerce: 2013/05/01 fruit drinks and fruit juices		

Attachments	73194964#TMSN.gif(bytes) 74220829#TMSN.gif(bytes) 74403399#TMSN.gif(bytes) 75975019#TMSN.gif(bytes) 85924878#TMSN.jpeg(bytes) 1.15.14 Notice of Opposition.PDF(182596 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Suzanne Hengl/
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Name	Suzanne Hengl
Date	01/15/2014

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

IN THE MATTER OF APPLICATION

Applicant: Caffe Vita, Inc.
Mark: VITA
Serial No.: 85/643,555
Filed: June 5, 2012
Published in
the Official Gazette: September 17, 2013

	X	
VITASOY INTERNATIONAL	:	
HOLDINGS LIMITED,	:	
	:	
Opposer,	:	Opposition No. ____, __
	:	
v.	:	
	:	
CAFFE VITA, INC.,	:	
	:	
Applicant.	:	
	:	
	:	
	X	

NOTICE OF OPPOSITION

Opposer, Vitasoy International Holdings Limited, a Hong Kong corporation located and doing business at 1 Kin Wong Street, Tuen Mun, New Territories, Hong Kong (hereinafter referred to as "Vitasoy" or "Opposer") believes that it will be damaged by the registration of Application Serial No. 85/643,555, filed on June 5, 2012 for the designation VITA in connection with coffee in International Class 30, as explained in detail below.



Vitasoy, having been previously granted an extension of time to oppose, hereby opposes the foregoing application. The specific grounds for this opposition are as follows:




1. Vitasoy is a leading global food and beverage company. Since at least as early as the 1940s, Vitasoy has been engaged in the manufacture and sale of a variety of edible

products, including teas, coffees, juices, soymilks, tofu and soy products. Opposer's products are distributed to and enjoyed by consumers all over the world and are supported by extensive advertising and promotional efforts.

2. Since at least as early as 1980, Vitasoy, directly or through its licensees and related companies, has been offering its products in the U.S. in connection with the mark VITA and variants. Such mark and variants thereof have been used by Opposer, directly or through its licensees and related companies, from first use continuously to date.

3. Opposer duly registered the mark VITA and variants thereof in the United States Patent and Trademark Office as follows:


Reg. No/ First Use	Trademark	Reg. Date	Goods/Services
1833973 Jun. 24, 1993	VITA	May 3, 1994	(Int'l Class: 30) tea drinks
1893224 Oct. 15, 1980	VITA	May 9, 1995	(Int'l Class: 32) fruit juices, vegetable juices
1147761 n/a	 Translation "VITA MILK"	Feb. 24, 2981	(Int'l Class: 29) vegetable based milk substitute made from soya beans
1747259 Oct. 15, 1980	 Translation "WEI TA" which means "VITA"	Jan. 19, 1993	(Int'l Class: 29) vegetable based food beverage used as a milk substitute made from soya beans; tofu; and soybean curd. (Int'l Class: 32) 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

Reg. No/ First Use	Trademark	Reg. Date	Goods/Services
1900795 Jun. 24, 1993	 Translation “WEI TA” which means “VITA”	Jun. 20, 1995	(Int’l Class: 30) tea drinks
1990485 Aug. 2, 1995	 Translation “WEI TA” which means “VITA”	Jul. 30, 1996	(Int’l Class: 30) soybean curd desserts, namely pudding
4454517 May 1, 2013		Dec. 24, 2013	(Int’l Class: 32) fruit drinks and fruit juices

4. Each of the foregoing marks is currently in use in commerce and each such registration is valid, subsisting, and in full force and effect. Many of the above marks are also incontestable. The foregoing marks are collectively referred to herein as “Opposer’s VITA Marks.”

5. Since long prior to Applicant’s filing of the application-in-opposition, Opposer has used its VITA Marks, not only in connection with a wide range beverage and food products, but also with other related or complementary products and in advertising and promotional materials, printed matter and publications. Over the course of the past 30 years, Opposer’s products sold and rendered under Opposer’s VITA Marks have achieved tremendous commercial acceptance and success. Opposer has, by virtue of incredibly extensive usage, advertising and promotion, built up a very high level of consumer and trade recognition symbolized by its VITA Marks. Due to tremendous sales success, extensive public exposure to and awareness by consumers, the VITA Marks, which are inherently distinctive, have also acquired and now possess an extremely favorable reputation and distinctiveness, signifying Opposer as the source of beverage products of high quality.

6. As a result of the long and extensive use and promotion of Opposer's VITA Marks in United States interstate commerce, such marks have become well and favorably known to the relevant public, enjoy enormous secondary meaning and goodwill, are strong and distinctive marks, and represent valuable assets of Opposer's business.

7. On January 24, 2013, Opposer filed Application Serial No. 85/830,929 to register the mark  for tea-based beverages; tea-based beverages with fruit flavorings in International Class 30, based on a date of first use in United States interstate commerce of November 30, 2011.

8. On information and belief, on June 5, 2012, Applicant, Caffe Vita, Inc., having a place of business at 1005 East Pike Street, Seattle, Washington 98122 (hereinafter "Applicant"), filed Application Serial No. 85/643,555 to register the mark VITA for "coffee" in International Class 30, based on an alleged date of first use in United States interstate commerce of January 1, 1995.

9. On May 14, 2013, the Examining Attorney issued an Office Action advising that, if Applicant's application-in-opposition proceeds to registration, Opposer's Application Serial No. 85/830,929 will be refused registration based on a likelihood of confusion with Applicant's mark.

10. Opposer has priority of trademark use over Applicant because Opposer and/or its licensees or related companies have used and federally registered the marks VITA, VITASOY and variants for closely similar products in the United States prior to Applicant's use in commerce of the claimed mark, VITA, and prior to the filing date of the application-in-opposition.

11. In view of the Examining Attorney's refusal of registration to Opposer's mark pending disposition of the application-in-opposition on the asserted ground that there is a likelihood of confusion between the application-in-opposition and Opposer's VITA mark as used in connection with tea-based beverages and tea-based beverages with fruit flavorings, Opposer will be harmed by registration of the application-in-opposition. Specifically, Opposer will be damaged because it will be denied registration of its U.S. Application Serial No. 85/830,929 in derogation of Opposer's statutory rights.

12. Moreover, if the Examining Attorney's refusal of registration to Opposer's VITA mark as shown in U.S. Application Serial No. 85/830,929 pending disposition of the application-in-opposition is legally correct, Applicant's mark so resembles Opposer's VITA Marks as to be likely to cause confusion, to cause mistake, or to deceive, with consequent injury to Opposer and the public.

13. Accordingly, registration of Applicant's claimed mark, VITA, is barred by the provisions of Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the grounds that Applicant's mark consists of or comprises a mark which so resembles Opposer's VITA Marks, which have been in prior use and are also the subject of prior registrations, as to be likely, when used in connection with the alleged products of Applicant, to cause confusion, mistake and/or deception, all to the damage of Opposer.

14. Finally, if the Examining Attorney is correct that there is a likelihood of confusion between Applicant's alleged mark, VITA, and Opposer's U.S. Application Serial No. 85/830,929, Opposer will be damaged by the issuance of a registration sought by Applicant within the meaning of 15 U.S.C. §1063 because such registration would support and assist Applicant in the confusing, misleading and/or deceptive use of Applicant's alleged mark, VITA,


and would give color of exclusive statutory rights to Applicant in violation and derogation of the prior and superior rights of Opposer in and to Opposer's VITA Marks.

WHEREFORE, Opposer prays that this opposition be sustained in its favor, that registration be denied to Applicant on its Application Serial No. 85/643,555, and that the Board grant all further relief to Opposer that is necessary and just in these circumstances.

Respectfully submitted,

BAKER BOTTS L.L.P.

Date: January 15, 2014


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Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that on this 15th day of January, 2014 a copy of the foregoing, NOTICE OF OPPOSITION, was served on Applicant via First Class Mail, in an envelope with sufficient postage addressed to:

Leslie C. Ruitter, Esq.
Stokes Lawrence, P.S.
1420 Fifth Avenue, Suite 3000
Seattle, WA 98101-2393

By: 
Suzanne M. Hengl