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

Proceeding	91214495
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**In the Matter of Trademark Application Serial No. 85/643,555**

For the Mark : VITA  
Filed : June 5, 2012  
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VITASOY INTERNATIONAL :  
HOLDINGS LIMITED, :  
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Opposer, :  
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 :  
v. : Opposition No. 91214495  
 :  
CAFFE VITA, INC., :  
 :  
 :  
Applicant. :  
----- X

**OPPOSER VITASOY INTERNATIONAL HOLDINGS LIMITED'S  
TRIAL BRIEF IN SUPPORT OF ITS OPPOSITION TO  
U.S. TRADEMARK APPLICATION SERIAL NO. 85/643,555 FOR THE MARK VITA**

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## **I. PRELIMINARY STATEMENT**

Vitasoy International Holdings Limited (“Vitasoy” or “Opposer”) owns the mark VITA in connection with beverages. It has sold fruit juices under this mark in the United States since at least as early as 1980 and has sold tea under the mark since at least as early as 1992. In addition, Vitasoy’s VITA mark is the subject of incontestable federal trademark registrations. Now, over 20 years after Vitasoy commenced sales of its VITA tea products in the U.S. and secured federal registrations for its mark, Applicant, Caffè Vita, Inc. (“Caffè Vita” or “Applicant”) seeks to register the identical mark for a highly-related product, namely coffee. Because registration of Caffè Vita’s U.S. Application Serial No. 85/643,555 for its purported mark VITA is likely to cause confusion with Vitasoy’s VITA marks and damage Opposer—indeed, Vitasoy has already suffered as a result of this application given that Vitasoy’s pending application for VITA (stylized) for tea drinks has been preliminarily refused registration by the Patent and Trademark Office based on a purported likelihood of confusion with the subject application—registration of Caffè Vita’s VITA mark must be denied.

## **II. DESCRIPTION OF THE RECORD**

The evidence of record comprises the Board’s orders, pleadings, Notices of Reliance (with exhibits) made of record by the Parties, the testimony deposition of Michael McConnell and its respective exhibits, and the file history for Applicant’s VITA application, Serial No. 85/643,555.

### **A. Opposer’s Evidence**

1. Opposer filed with the Board on December 22, 2014 a Notice of Reliance accompanied by Vitasoy Exhibits 1 through 44, consisting of Certificates of Registration and corresponding TSDR status and TESS printouts for registrations owned by Opposer (Exhibits 1–

6), and printouts of certain third party Certificates of Registration (Exhibits 7–44). All of the foregoing are incorporated herein by reference.

**B. Applicant’s Evidence**

1. Applicant filed with the Board on March 20, 2015 a Notice of Reliance accompanied by Caffe Vita Exhibits 1 through 16.

2. After the close of its testimony period, Applicant filed with the Board on April 7, 2015 a document entitled “Caffe Vita, Inc.’s Supplemental Notice of Reliance” including materials identified as Exhibit 17.

3. Applicant filed with the Board on June 3, 2015 a transcript of the testimony deposition of Michael P. McConnell, along with Exhibits 1 through 6, dated March 11, 2015 (hereinafter McConnell T.).

Opposer filed and served with the Board on April 17, 2015 a Motion to Strike certain Exhibits in Applicant’s Notice of Reliance and Applicant’s Supplemental Notice of Reliance, including its objections to the curable defects in the Notice of Reliance. The motion has been fully briefed; Applicant filed and served a Response on May 7, 2015, and Opposer filed and served a Reply on May 27, 2015. Applicant has not made any effort to correct the defects identified in the Motion to Strike. Opposer maintains all objections and arguments in its Motion to Strike and Reply, and requests that the objectionable materials be excluded from the record. Pursuant to TBMP §§ 707.02(c), 707.03(c) and 801.03, these objections, along with additional objections to Applicant’s Notices of Reliance and testimony, are included as Appendix A.

**III. STATEMENT OF THE ISSUES**


The issue to be determined at trial is whether the applied-for mark VITA for “coffee” in International Class 30 is likely to cause confusion, mistake or otherwise deceive

consumers under Section 2(d) of the United States Trademark (“Lanham”) Act as to the source of the goods, or as to an affiliation or connection with Vitasoy or its VITA marks.




**IV. RECITATION OF THE FACTS**

**A. Vitasoy’s Longstanding Ownership and Use of Its VITA Marks.**

Vitasoy has continuously and exclusively used its VITA marks in connection with a wide range of beverages, foods, and other complementary products in the United States since as early as 1980. *See* Bd. Docket No. 1 at ¶ 2; *see also* Pl.’s Not, of Reliance, Bd. Docket No. 5 at Ex. 2 (U.S. Reg. No. 1,893,224), *id.* at Ex. 4 (U.S. Reg. No. 1,747,259). The products offered by Vitasoy under its VITA mark include tea drinks, which have been sold in the United States since at least as early as 1992. *See* Bd. Docket No. 1 at ¶ 2; Bd. Docket No. 5 at Ex. 1 (U.S. Reg. No. 1,833,973). Beyond its well-established common law trademark rights, Vitasoy also owns numerous United States trademark registrations for VITA and variants, including the following (hereinafter the “VITA Marks”):

<b>Mark</b>	<b>Reg. No.</b>	<b>Reg. Date</b>	<b>First Use</b>	<b>Goods</b>
VITA	1,833,973	May 3, 1994	Jun. 24, 1992	Tea drinks (Class 30).
VITA	1,893,224	May 9, 1995	Oct. 15, 1980	Fruit juices, vegetable juices (Class 32).
 Translation “WEI TA” which means “VITA”	1,747,259	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).
 Translation “WEI TA” which means “VITA”	1,900,795	Jun. 20, 1995	Jun. 24, 1993	Tea drinks (Class 30).
 Translation “WEI TA” which means “VITA”	1,990,485	Jul. 30, 1996	Aug. 2, 1995	Soybean curd desserts, namely pudding (Class 30).
	4,454,517	Dec. 24, 2013	May 1, 2013	Fruit drinks and fruit juices (Class 32).

See Bd. Docket No. 1 at ¶ 3; *see also* Pl.’s Not. of Reliance, Bd. Docket No. 5 at Exs. 1–6. All of these registrations are valid, subsisting, and in full force and effect, and many of the above registrations are incontestable pursuant to Section 15 of the Lanham Act, 15 U.S.C. § 1065. Vitasoy’s registrations serve as prima facie evidence of its exclusive right to use these marks in commerce on or in connection with the products identified in such registrations. *See* 15. U.S.C. § 1115(a).

**B. Applicant’s VITA Application.**

Despite the presence of Vitasoy’s VITA Marks on the trademark register, on June 5, 2012, Applicant filed a trademark application for the word mark VITA in connection with “coffee”. The application claims a first use date of January 1, 1995 and contains no translation statement or other indication that the mark comprises non-English wording. *See* Def.’s Not. of Reliance, Bd. Docket No. 8 at Ex. 1 (U.S. App. Ser. No. 86/643,555).

**C. Rejection of Opposer's Application Based on the Subject Application.**

On January 24, 2013, Vitasoy filed Application Serial No. 85/830,929 to register the mark  for tea-based beverages and 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. *See* Bd. Docket No. 1 at ¶ 7. Notwithstanding Vitasoy's prior registration for the word mark VITA covering tea drinks, the Examining Attorney issued an Office Action advising that, if Applicant's application-in-opposition proceeds to registration, Vitasoy's Application Serial No. 85/830,929 would be refused registration based on a likelihood of confusion with Applicant's mark. *See id.* at ¶ 9.

**V. ARGUMENT**

In order to successfully oppose the application-at-issue on the grounds of confusing similarity, Vitasoy must establish that its rights in the VITA mark predate those of Applicant and that registration of Applicant's purported mark VITA is likely to cause confusion with Vitasoy's VITA mark. 15 U.S.C. § 1052(d). Vitasoy has priority by virtue of (1) its use of the VITA mark on beverages in the United States for over twenty years and (2) its incontestable United States trademark registrations for VITA that predate the application at issue. Moreover, confusion is inevitable given that the parties' marks are identical and used in connection with closely related products, namely coffee and tea. It is beyond cavil that coffee and tea are goods that regularly originate from the same source: the United States trademark register is replete with third party registrations for marks covering both coffee and tea, and Applicant's own testimony and evidence demonstrates that coffee and tea are sold together, including by Applicant and at Applicant's own retail locations. Despite Vitasoy's longstanding rights in the VITA mark, Applicant now seeks registration for an identical mark for closely-related goods, inviting

consumer confusion and implying a relationship with Vitasoy that simply does not exist. As such, Applicant's application to register VITA must be denied.

**A. Vitasoy has Standing and Priority.**

As discussed above, Vitasoy owns several registrations for VITA in connection with beverages that predate the application-at-issue, almost all of which are incontestable, including but not limited to U.S. Reg. No. 1,833,973 for VITA in standard characters covering tea drinks which was issued on May 3, 1994. *See* Pl.'s Not. of Reliance, Bd. Docket No. 5 at Ex. 1 (U.S. Reg. No. 1,833,973). Further, Vitasoy's use of its VITA marks on beverages in the United States, directly or through its licensees and/or related companies, dates back to at least as early as 1980. *See* Bd. Docket No. 1 at ¶ 2; *see also, e.g.*, Pl.'s Not. of Reliance, Bd. Docket No. 5 at Ex. 2 (U.S. Reg. No. 1,893,224), *id.* at Ex. 4 (U.S. Reg. No. 1,747,259). Vitasoy's United States trademark registrations demonstrate that it is the owner of record and that its registrations are valid and subsisting, and establish Vitasoy's standing and priority. *See Schering-Plough Healthcare Prods., Inc. v. Ing-Jing Huang*, 84 U.S.P.Q.2d 1323 (T.T.A.B. 2007) (“[I]n view of opposer's ownership of valid and subsisting registrations, there is no issue regarding opposer's priority.”); *David Crystal, Inc. v. Shelburne Shirt Co., Inc.*, 465 F.2d 926, 927, 175 U.S.P.Q. 112 (C.C.P.A. 1972) (“The question of priority does not arise against a registered trademark in an opposition proceeding.”).

**B. Applicant's VITA Mark Is Likely to Cause Confusion with Opposer's VITA Marks.**

Likelihood of confusion between two marks is determined on a case-by-case basis, using an analysis of thirteen contributing factors enumerated in *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). The most relevant factors in this proceeding are (1) the similarity between the parties' marks and (2) the

similarity between the parties' products. It is well-established that these two factors are the key considerations in the likelihood of confusion analysis. *See In re Microsoft*, 68 U.S.P.Q.2d 1195, 1197 (T.T.A.B. 2003) (upholding refusal to register OFFICE.NET in light of likelihood of confusion with OFFICENET, primarily due to the close visual and aural similarities of the marks and similar nature of the associated goods); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 U.S.P.Q. 24 (C.C.P.A. 1976) (“The fundamental inquiry mandated by s[sic] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

### **1. The Marks Are Identical.**

The first *DuPont* factor in evaluating likelihood of confusion is “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *DuPont*, 476 F.2d at 1361, 177 U.S.P.Q. at 567. It is indisputable that Applicant’s purported mark VITA is identical to Vitasoy’s registered VITA mark. Where a party uses an identical mark on competitive goods, it is typically considered an “open and shut” case. *See* 4 J. Thomas McCarthy, *McCarthy On Trademarks and Unfair Competition*, § 23:20 at 23–149 (4th ed. 2015) (“Such cases [where parties use and/or seek registration of and identical mark on related goods] are ‘open and shut’ . . . . Most businesspeople know enough not to adopt a mark identical to that already in use in the same market.”). Applicant’s VITA mark adopts Vitasoy’s VITA mark in its entirety and contains absolutely no distinguishing matter. “[O]ne who adopts a mark similar to the mark of another for closely related goods acts at his peril.” *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 1405, 168 U.S.P.Q. 110 (C.C.P.A. 1970). Here, Applicant has not only selected a mark that is similar to Vitasoy’s VITA Marks: it has elected to use a mark that *exactly duplicates* Vitasoy’s longstanding VITA Marks. As

discussed in further detail below, “even 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 U.S.P.Q.2d 1687 (Fed. Cir. 1993).

Because the parties’ marks are identical, this factor weighs strongly in favor of Vitasoy on the issue of likelihood of confusion.

**2. The Identified Goods, Coffee and Tea, Are Closely Related and/or Complementary.**

Vitasoy uses and owns registrations for VITA in connection with tea drinks, as well as a variety of other beverage and food products. Applicant seeks registration of the identical mark, VITA, for coffee. While the parties’ respective goods are not the same, they do not need to be in order to establish a likelihood of confusion. *See* TMEP § 1207.01(a)(i) (goods need not be identical or directly competitive for the Board to find a likelihood of confusion); *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 U.S.P.Q. 476, 480 (C.C.P.A. 1975) (“[T]he law has long protected the legitimate interests of trademark owners and consumers from confusion among noncompetitive, but related, products bearing confusingly similar marks.”). Moreover, it is well-settled that if marks are highly similar, a lesser degree of similarity will be required between the associated goods and services to support a finding of confusion. *See In re Opus One, Inc.*, 60 U.S.P.Q.2d 1812, 2001 WL 1182924 at \*3 (T.T.A.B. 2001) (upholding refusal to register OPUS ONE for “restaurant services” in light of existing registration for OPUS ONE for “wine”). Because the risk of confusion resulting from contemporaneous use of identical marks is so high, the Board has held that, in circumstances such as those presented here, “there need only be a viable relationship between the goods to find that there is a likelihood of confusion.” *L’Oreal S.A. & L’Oreal USA, Inc. v. Marcon*, 102 U.S.P.Q.2d 1434, 1439 (T.T.A.B. 2012).

The presence of numerous trademark registrations filed with the U.S. Patent and Trademark Office indicates that coffee and tea are frequently marketed and sold under a single mark. The existence of use-based third party registrations covering these items reflects their closely-related nature and suggests that the identified goods or services may emanate from a single source, and that consumers reasonably expect such products to come from the same source. *See In re Albert Trostel & Sons Co*, 29 U.S.P.Q.2d 1783 (T.T.A.B. 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 U.S.P.Q.2d 1467 (T.T.A.B. 1988); *Black & Decker Mfg. Co. v. Bright Star Indus.*, 220 U.S.P.Q. 890, 892 (T.T.A.B. 1983) (finding goods to be related where consumers could reasonably expect the parties' WORKMATE flashlights and WORKMATE portable workbenches and accessories to originate from the same source). By way of example, Vitasoy's Notice of Reliance includes 38 valid and subsisting registrations that cover both coffee and tea, demonstrating the common concurrent sale of coffee and tea products under the same mark by the same entity. *See* Pl.'s Not. of Reliance, Bd. Docket No. 5 at Exs. 7–44.

The large number of registrations covering both coffee and tea also serves as objective evidence that Applicant's goods fall within Vitasoy's natural zone of expansion. *See ConAgra Foods RDM Inc. v. Candwich Food Corp.*, 2008 WL 3211817, at \*5 (T.T.A.B. Jul. 17, 2008). As McCarthy has noted, "a trademark owner should be given rights in his trademark, not only for the goods it actually sells, but for all product markets into which it might reasonably be expected to expand in the future". 4 J. Thomas McCarthy, *McCarthy On Trademarks and Unfair Competition*, § 24:17 at 24–55 (4th ed. 2015); *see also Mason Eng'g and Design Corp. v. Mateson Chem. Corp.*, 225 U.S.P.Q. 956, 962 (T.T.A.B. 1985) ("[T]he first user of a mark in connection with particular goods or services possesses superior rights in the mark not only as against subsequent users of the same or similar mark for the same or similar goods or services,

but also as against subsequent users of the same or similar mark for any goods or services which purchasers might reasonably expect to emanate from it in the normal expansion of its business under the mark”) (citations omitted). Allowing Applicant to obtain a federal registration for VITA, as proposed, would deprive Vitasoy of its ability to enforce its rights and prevent it from introducing products within its natural zone of expansion under its longstanding VITA mark.

The Board has repeatedly held that a likelihood of confusion exists where similar marks are used in connection with beverages that are less closely linked than tea and coffee. For example, in *In re Bueno Alimentos, S.A. de C.V.*, 2012 WL 2166296 (T.T.A.B. May 29, 2012), the Board affirmed a refusal to register COCO LOCO for “fruit juices” on the grounds that the mark was likely to cause confusion with a pre-existing registration for THE CRAZY COFFEE COMPANY COCO LOCO ESPRESSO & Design for “coffee; tea”.<sup>1</sup> In light of the Board’s decision in that case, it is logical to conclude that confusion will also be likely when coffee and tea are sold under the *exact same mark*. Indeed, that Board has already concluded as much in *In re WMGA, Inc.*, 2000 WL 714198 at \*4 (T.T.A.B. May 30, 2000), where it affirmed a refusal to register SANTA LUCIA for coffee beans based on a likelihood of confusion with a prior registration for SANTA LUCIA in connection with mineral waters. In that case, the Board determined that the parties’ respective goods were “closely related beverage products” based, in part, on third-party registrations covering both parties’ goods.

While there is no *per se* rule that all beverages are related, coffee and tea are similar by nature and exceedingly likely to be encountered together in the marketplace as they move through the same channels of trade to the same classes of ordinary purchasers. *See In re Sigma Alimentos, S.A. de C.V.*, 2007 WL 2019711 at \*4-5 (T.T.A.B. Jul. 3, 2007) (evaluating the

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<sup>1</sup> As required by TBMP § 101.03, all unpublished non-precedential decisions cited in this Brief are appended hereto as Appendix B.

relatedness of certain beverages and finding water to be related to soy-based beverages for likelihood of confusion purposes). Both coffee and tea are beverages made from brewing or steeping plant products in water. See *Coffee Definition*, MERRIAM-WEBSTER.COM, <http://www.merriam-webster.com/dictionary/coffee> (last visited June 23, 2015) (defining “coffee” as “a dark brown drink made from ground coffee beans and boiled water”); *Tea Definition*, MERRIAM-WEBSTER.COM, <http://www.merriam-webster.com/dictionary/tea> (last visited June 23, 2015) (defining “tea” as “a drink that is made by soaking the dried leaves of an Asian plant in hot water”).<sup>2</sup>

Applicant’s own President, Michael McConnell, testified to the highly related nature of coffee and tea, admitting that Applicant’s own CAFFE VITA retail locations sell both products:

Q. And what is the primary business of Caffe Vita Inc.?

A. We import coffee, roast coffee and sell coffee.

...

Q. Sir, you currently sell tea in your Caffe Vita retail outlets, correct?

A. Correct.

Q. And you've been selling tea through those outlets for some time?

A. Correct.

See McConnell T., Bd. Docket No. 15 at 7:2–5, 48:1–6. Applicant’s proffered evidence also includes a document demonstrating that Vitasoy itself offers both coffee and tea products. See Def.’s Not. of Reliance, Bd. Docket No. 8 at Ex. 14 (“Vitasoy also offers . . . Vita Supreme Coffee drink.”). In addition, it is generally known that prominent beverage chains like Dunkin’ Donuts and Starbucks regularly offer both coffee and tea products,<sup>3</sup> emphasizing consumer

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<sup>2</sup> The Board may take notice of dictionary definitions from online sources. See, e.g., *Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 U.S.P.Q.2d 1066, 1075 n.17 (T.T.A.B. 2011); TBMP § 704.12(a).

<sup>3</sup> See *Hot Beverages*, DUNKIN’ DONUTS, <http://www.dunkindonuts.com/dunkindonuts/en/menu/beverages/hotbeverages.html> (last visited Jun. 29, 2015), *Drinks*, STARBUCKS, <http://www.starbucks.com/menu/drinks> (last visited Jun. 29, 2015). The Board may take judicial notice of a fact that “(1) is generally known within the trial court’s territorial jurisdiction; or (2) can be accurately and readily determined from sources whose accuracy cannot reasonably be questioned.” FED. R. EVID.



awareness that these goods emanate from the same source. As the Board has recognized, goods are related where they are sold by the same company or commonly used or purchased together. *See General Mills, Inc. v. Fage Dairy Processing Industry, S.A.*, 100 U.S.P.Q.2d 1584 (T.T.A.B. 2011) (“[T]he evidence of record clearly establishes a close relationship between opposers’ ready-to-eat cereal and applicant’s yogurt given consumers’ longstanding mixing of these types of products and the circumstances surrounding their marketing.”).

The record—and common sense—unequivocally demonstrate that coffee and tea are closely related goods. Applicant has selected a mark for coffee that is identical to Vitasoy’s preexisting registrations for related beverages and other complementary goods, and has done so at its own peril. *See In re iVibe Coffee, Inc.*, 2014 WL 7496058 at \*5 (T.T.A.B. Dec. 17, 2014) (refusing to register IV for coffee, tea and other goods in Class 30 based on a likelihood of confusion with IV MUG for “coffee; coffee beans; ground coffee beans; roasted coffee beans”). As such, Applicant’s VITA application should not be allowed to proceed to registration.

### **3. The Trademark Office’s Prior Determination Supports a Finding of Likelihood of Confusion.**

In addition to its existing registrations for the VITA Marks, Vitasoy filed for a stylized version of its VITA mark, in both English and Chinese characters, covering tea-based beverages and tea-based beverages with fruit flavorings. *See* Bd. Docket No. 1 at ¶ 7. During the prosecution of this application, the Trademark Examining Attorney issued an Office Action advising that, if Applicant’s application-in-opposition proceeds to registration, Vitasoy’s Application Serial No. 85/830,929 would be refused registration based on a likelihood of confusion with Applicant’s mark. *See id.* at ¶ 9. In other words, the Examiner believed that

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201; TBMP § 704.12(a). It is appropriate to take judicial notice of well-known facts. *See, e.g., Plus Prods. v. Sterling Food Co., Inc.*, 188 U.S.P.Q. 586 (T.T.A.B. 1975) (“Judicial notice can be taken of the well known fact that food supplements and fortifiers are commonly used in producing bakery products. Retail bakeries and commercial bakeries are likewise the primary purchasers of applicant's pre-mixed flour product.”).

registration of Applicant's purported mark VITA for coffee and registration of Vitasoy's stylized VITA mark with Chinese characters for tea-based beverages was likely to result in confusion. The Examiner's preliminary refusal, when coupled with the facts and arguments presented above, establish that confusion is very likely to occur if Applicant's purported VITA mark is registered. *See Induct-o-Matic Corp. v. Inductotherm Corp.*, 747 F.2d 358, 366 (6th Cir. 1984) (finding trademark examiner's initial refusal to register on basis of likelihood of confusion significant to the court's likelihood of confusion analysis). Further, given the Examining Attorney's refusal to register Opposer's mark pending disposition of the application-in-opposition, Opposer will undoubtedly be harmed by registration of the application-in-opposition.

## VI. CONCLUSION

In view of the foregoing, much of which is undisputed, consumers who encounter Applicant's purported VITA mark in connection with coffee are likely to be confused into thinking that those products emanate from, or are sponsored by, a single entity—Vitasoy—which has historically marketed and sold related beverage products under the VITA Marks. Applicant, looking to enter the market well after Vitasoy, has an affirmative duty to select a mark that is not likely to cause confusion as to source, sponsorship or affiliation with any established mark. *See Steelcase Inc. v. Steelcare Inc.*, 219 U.S.P.Q. 433, 437 (T.T.A.B. 1983) (finding that newcomer who failed to select a mark “sufficiently far afield” from a preexisting mark “is subject to having any doubts on the question . . . resolved adversely to its claims of registrable rights”). As stated above, “[i]t is well settled that one who adopts a mark similar to a mark of another for closely related goods acts at his peril . . . .” *Carlisle Chem. Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 U.S.P.Q. 110, 112 (C.C.P.A. 1970). To the extent that there is any doubt on the issue of likelihood of confusion, it must be resolved in Opposer's favor, as the senior user. *See*

*Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 878, 23 U.S.P.Q.2d 1698, 1701 (Fed. Cir. 1992); *Kimberly-Clark Corp. v. H. Douglas Enters., Ltd.*, 774 F.2d 1144, 227 U.S.P.Q. 541, 543 (Fed. Cir. 1985); *In re Shell Oil Co.*, 992 F.2d 1204, 1209, 26 U.S.P.Q.2d 1687, 1691 (Fed. Cir. 1993).

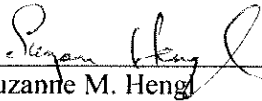
In sum, Applicant's applied-for mark VITA is likely to cause confusion with Vitasoy's VITA Marks. Accordingly, Vitasoy respectfully requests that the Board deny registration of the instant application.

Respectfully submitted,

BAKER BOTTS L.L.P.

Dated: July 2, 2015

By:

  
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Attorneys for Opposer,  
VITASOY INTERNATIONAL HOLDINGS LIMITED.

**CERTIFICATE OF SERVICE**

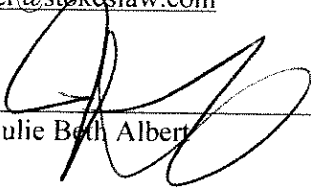
I hereby certify that a copy of the foregoing, OPPOSER VITASOY INTERNATIONAL HOLDINGS LIMITED'S TRIAL BRIEF IN SUPPORT OF ITS OPPOSITION TO U.S. TRADEMARK APPLICATION SERIAL NO. 85/643,555 FOR THE MARK VITA, was served on Applicant's attorney of record, via first class mail with a courtesy copy via e-mail, addressed to:

Leslie C. Ruitter  
Stokes Lawrence PS  
1420 Fifth Avenue, Suite 3000  
Seattle, WA 98101-2393  
Leslie.Ruitter@stokeslaw.com

Dated: \_\_\_\_\_

1/2/15

By: \_\_\_\_\_

  
Julie Beth Albert

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

**In the Matter of Trademark Application Serial No. 85/643,555**

For the Mark : VITA  
Filed : June 5, 2012  
Published in the  
Official Gazette : September 17, 2013

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VITASOY INTERNATIONAL :  
HOLDINGS LIMITED, :  
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 Opposer, :  
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 v. : Opposition No. 91214495  
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 CAFFE VITA, INC., :  
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 Applicant. :  
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**APPENDIX A TO OPPOSER'S TRIAL BRIEF:  
STATEMENT OF EVIDENTIARY OBJECTIONS**

## Appendix A

Opposer herein incorporates in their entirety all objections and arguments submitted in its Motion to Strike, filed and served on April 17, 2015, and its Reply, filed and served on May 7, 2015. These arguments are referenced in the chart below, along with supplemental objections on substantive grounds, now timely raised pursuant to TBMP § 707.02(c).

Opposer notes that Applicant has submitted the testimonial deposition of Michael McConnell in its entirety, rather than proffering only those portions of the transcript on which Applicant intends to rely. To comport with TBMP § 707.03(a) and avoid filing objections that are potentially not outcome-determinative or that may not have an effect on Opposer or Applicant's position, Opposer herein reserves all rights to object to the McConnell deposition, including, but not limited to the witness' competency, the competency, relevancy, and/or materiality of the testimony, and/or whether the proffered testimony constitutes hearsay or improper rebuttal. *See* TBMP § 707.03(c) (Objections to Trial Testimony Depositions On Other Procedural Grounds and on Substantive Grounds).

<b>Exhibit</b>	<b>Description</b>	<b>Objections</b>
Bd. Docket No. 8, Def.'s Not. of Reliance -Exhibit 2	TSDR printout of Applicant's abandoned App. Ser. No. 75/556,333 for CAFFE VITA	<u>Relevance</u> - Applicant seeks to use this evidence to demonstrate "Vitasoy's notice of Caffe Vita's use of the VITA mark." Vitasoy's notice is irrelevant to the question of likelihood of confusion, particularly as Vitasoy adopted its VITA marks well before Applicant. The stated purpose cannot be achieved using this

	<p>COFFEE ROASTING CO. &amp; Design (abandoned Nov. 1, 1999).</p>	<p>evidence, as (1) the proffered application was for an entirely different mark - <i>CAFFE VITA COFFEE ROASTING CO. &amp; Design</i> - and not <i>VITA</i>; (2) absent substantiation of use, an application or registration is not evidence that a mark was or is in use; and (3) the application never proceeded to registration and is entitled to only “very limited probative value”. <i>See Frito-Lay North America, Inc. v. Princeton Vanguard, LLC</i>, 109 U.S.P.Q.2d 1949, 1956 n.9 (T.T.A.B. 2014) (“The applications are not evidence of anything except that they were filed.”); <i>see also</i> TBMP § 704.03(b)(2) (Application Not Subject of Proceeding).</p>
<p>Bd. Docket No. 8, Def.’s Not. of Reliance -Exhibits 4–6</p>	<p>Printouts of TESS search results, TSDR printouts, and “representative” registrations that purport to show registration of marks utilizing the word “vita” in Classes 29, 30, and 32.</p>	<p><u>Procedural</u> - Opposer restates and maintains all objections and arguments submitted in its Motion to Strike and Reply. <i>See</i> Bd. Docket No. 10 at 7–10; Bd. Docket No. 13 at 6–8.</p> <p><u>Relevance</u> - Applicant enters this evidence for the purpose of showing “widespread <i>registration</i> of marks utilizing the word ‘vita’” in connection with the general categories of goods in each class. (Emphasis added). The proffered evidence is cumulative and of no probative value on this point. <i>See</i> TBMP § 702.05 (Overly Large Records). Further, Exhibit 4 includes pending/ abandoned</p>

		<p>applications and expired/cancelled registrations, marks covering entirely unrelated products, and marks that contain significant distinguishing matter. <i>See Frito-Lay</i>, 109 U.S.P.Q.2d at 1956 n.9 (T.T.A.B. 2014) (applications only demonstrate that such applications were filed; cancelled and expired registrations are not probative). The mere fact that there may be another registration which includes the term “vita” for an unrelated product in Class 29, 30 or 32 is of no moment, as the classification of goods has no bearing on the question of likelihood of confusion. <i>See Jean Patou, Inc. v. Theon Inc.</i>, 9 F.3d 971, 975, 29 U.S.P.Q.2d 1771, 1774 (Fed. Cir. 1993). In addition, Applicant’s claim that Exhibit 5 is relevant to show the “widespread registration of marks utilizing the word ‘vita’ in conjunction with coffee and tea products” is simply wrong. This exhibit is comprised of TESS search results and “representative” TSDR printouts showing third party marks incorporating “vita” in Class 30, including marks like VITA NUOVA for pasta sauces or PASTA VITA for pasta. These registrations are completely irrelevant. Finally, to the extent that Applicant seeks to rely on third party registrations that happen to be included in Exhibits 4-6, Applicant has</p>
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		failed to properly introduce the Certificates of Registration for all registered marks. <i>See</i> TMBP § 704.03(b)(1)(B) (Third-Party Registration).
Bd. Docket No. 8, Def.'s Not. of Reliance -Exhibit 7	Printouts of translation of the word “vita” from Italian to English obtained from the Collins dictionary online.	<u><i>Procedural</i></u> - Opposer restates and maintains all objections and arguments submitted in its Motion to Strike and Reply. Bd. Docket No. 10 at 10–11; Bd. Docket No. 13 at 8.  <u><i>Relevance</i></u> - Applicant owns an application for the word mark VITA that contains no translation statement, limitation, or other indication that consumers would associate the mark with the Italian language or culture. Applicant has provided no evidence of consumers’ impression of its products that would suggest any connection with Italy. The mere presence of this definition is of no moment as to the question of likelihood of confusion. <i>See</i> TBMP § 1207.01(b)(vi).
Bd. Docket No. 8, Def.'s Not. of Reliance -Exhibits 8, 9	Printouts of “potential Chinese character translations for the term WEI TA” from the website Chinese-Tools.com.	<u><i>Procedural</i></u> - Opposer restates and maintains all objections and arguments submitted in its Motion to Strike and Reply. Bd. Docket No. 10 at 11–12; Bd. Docket No. 13 at 8.  <u><i>Relevance</i></u> - Applicant proffers this exhibit “[t]o show that the Chinese translation and resulting design mark of Vitasoy’s VITA mark in Registration Nos. 1747259,

		<p>1900795 and 1990485 ‘WEI TA’ does not confer upon Vitasoy exclusive right to the English translation of the word mark VITA.” This is not only false, as marks in different languages can still be confusingly similar, but entirely irrelevant as Vitasoy owns, and has made of record, pre-existing registrations for the word mark VITA in connection with closely related goods. <i>See</i> TBMP § 1207.01(b)(vi); Bd. Docket No. 5, Pls. Not. of Reliance at Exs. 1, 2.</p> <p><u>Hearsay</u> - Applicant identifies these exhibits merely as “potential” translations, yet attempts to use them to support the truth of the statements therein, namely that these are accurate translations of Vitasoy’s marks. As such, these exhibits should be excluded.</p>
<p>Bd. Docket No. 8, Def.’s Not. of Reliance - Exhibits 10–13</p>	<p>Printouts from Vitasoy’s website and excerpts from its 2013/2014 Annual Report.</p>	<p><u>Procedural</u> - Opposer restates and maintains all objections and arguments submitted in its Motion to Strike and Reply. Bd. Docket No. 10 at 12–13; Bd. Docket No. 13 at 8–9. <i>See</i> TBMP § 527.01(e) (Estoppel Sanction).</p> <p><u>Relevance</u> - According to Applicant, these exhibits “are relevant to show that Caffè Vita’s and Vitasoy’s customers do not overlap in the retail markets, that consumers would not encounter the respective marks in the same venue, and that</p>

		<p>there would be no likelihood of confusion”. However, the only information in these exhibits concerning Vitasoy’s trade channels pertains to the countries in which Vitasoy’s products are sold, including the United States. Therefore, to the extent that these exhibits speak to trade channels, they demonstrate that Applicant’s and Opposer’s VITA products are both sold in the United States.</p>
<p>Bd. Docket No. 8, Def.’s Not. of Reliance - Exhibit 14</p>	<p>A Wikipedia entry that purports to provide information about Vitasoy.</p>	<p><u>Procedural</u> - Opposer restates and maintains all objections and arguments submitted in its Motion to Strike and Reply. Bd. Docket No. 10 at 12–13; Bd. Docket No. 13 at 8–9. <i>See</i> TBMP § 527.01(e) (Estoppel Sanction)</p> <p><u>Relevance</u> - Applicant proffers this evidence “to show that Vitasoy does not self-identify as a coffee company, nor does the public perceive Vitasoy to be a purveyor of coffee products.” This exhibit is not proper for this purpose. First, a Wikipedia entry is not written by the subject of such entry, so the article has no bearing on how Vitasoy “self-identifies.” Moreover, a “short synopsis of Vitasoy’s company history and the scope of its product line” does not show how the public perceives Vitasoy - this would require an extensive, detailed customer survey. Caffè Vita’s stated purpose is also contradictory, as the very article cited</p>

		lists “Vita Supreme Coffee Drink” among Vitasoy’s products.
Bd. Docket No. 8, Def.’s Not. of Reliance - Exhibits 15, 16	Chart of various third-party trademark applications and registrations covering coffee and tea; selected TSDR printouts and registrations of certain applications and registrations identified in said chart.	<p><u>Procedural</u> - Opposer restates and maintains all objections and arguments submitted in its Motion to Strike and Reply. Bd. Docket No. 10 at 13; Bd. Docket No. 13 at 9–10.</p> <p><u>Relevance</u> - When prompted in Opposer’s Motion to Strike to provide a statement of relevance for these Exhibits, Applicant responded that these Exhibits were proffered “as evidence of the widespread use of similar marks for both coffee and tea in the marketplace.” See Def.’s Opp./Resp. to Motion, Bd. Docket No. 11 at 10. Exhibits 15 and 16 are cumulative, misleading, and irrelevant to Applicant’s stated purpose and the proceeding in general. See TBMP § 702.05 (Overly Large Records). Third party registrations, even if properly made of record, are not probative of use in the marketplace, and the chart in Exhibit 15 is replete with unregistered marks, including pending applications, intent-to-use applications, abandoned applications, and cancelled registrations. See TMBP § 704.03(b)(1)(B) (Third-Party Registration) (“when third-party registrations are made of record, the party offering them may not rely on the Trademark Act § 7(b), 15 U.S.C. §</p>

		<p>1057(b), presumptions; normally, third-party registrations are offered merely to show that they issued, and a plain copy of the registration is sufficient for that purpose.”); <i>Frito-Lay</i>, 109 U.S.P.Q.2d at 1956 n.9 (T.T.A.B. 2014) (applications only demonstrate that such applications were filed; cancelled and expired registrations are not probative). Additionally, based on the “status” dates and information provided in the chart, many of the marks that Applicant claims coexist “in the marketplace” were in use years, if not decades, apart (if they were ever in use at all). As such, Exhibits 15 and 16 are of no probative value and should be excluded.</p> <p><u>Hearsay</u> - Exhibit 15 is merely a synthesis of published documents, and provides no credible evidence of the context it purportedly illustrates. As such, it should be excluded on hearsay grounds. See <i>R.J. Reynolds Tobacco Co. v. Brown &amp; Williamson Tobacco Corp.</i>, 226 U.S.P.Q. 169, 174–75 (T.T.A.B. 1985) (finding that printouts from databases which themselves comprise abstracts or syntheses of published documents unlike the actual text of the documents, are hearsay as to the context of a term).</p>
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<p>Bd. Docket No. 9, Def.'s Supp. Not. of Reliance - Exhibit 17</p>	<p>Printout of archived version of Applicant's website.</p>	<p><u>Procedural</u> - Opposer restates and maintains all objections and arguments submitted in its Motion to Strike and Reply. Bd. Docket No. 10 at 4–7; Bd. Docket No. 13 at 4–6. <i>See also</i> TBMP § 707.02(b)(1) (Objections to Notices of Reliance On Ground of Untimeliness).</p> <p><u>Relevance</u> - Applicant proffers this evidence “to show Caffè Vita’s long-term and continuous use of the stand-alone mark “VITA” to promote its coffee products.” The document shows only a snapshot of the way Applicant’s website allegedly appeared on November 11, 1998 at 7:03 PM and is not probative of “long-term” or “continuous” use in any way.</p>
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2012 WL 2166296 (Trademark Tr. & App. Bd.)

THIS OPINION IS NOT A PRECEDENT OF THE T.T.A.B.

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

IN RE BUENO ALIMENTOS, S.A. DE C.V.

Serial No. 76676618

May 29, 2012

Hearing: December 7, 2011

\*1 [Theodore A. Breiner](#) of Breiner & Breiner, L.L.C. for Bueno Alimentos, S.A. de C.V.

[S. Michael Gaafar](#)

Trademark Examining Attorney

Law Office 116

([Michael W. Baird](#), Managing Attorney)

Before [Kuhlke](#), [Bergsman](#) and [Wellington](#)

Administrative Trademark Judges

Opinion by [Bergsman](#)

Administrative Trademark Judge:

Bueno Alimentos, S.A. de C.V. (“applicant”) filed an intent-to-use application for the mark COCO LOCO, in standard character form, for “fruit juices,” in Class 32. Applicant provided an English translation for “Coco Loco” as “The Crazy Coconut.”

The examining attorney refused registration under Section 2(d) of the Trademark Act of 1946, [15 U.S.C. § 1052\(d\)](#), on the ground that applicant's mark, when used in connection with the fruit juices, so resembles the registered mark THE CRAZY COFFEE COMPANY COCO LOCO ESRESSO and design, shown below, for “coffee; tea,” in Class 30, as to be likely to cause confusion.<sup>1</sup>



The registration includes the following translation statement: “The foreign wording in the mark [COCO LOCO ESPRESSO] translates into English as ‘CRAZY COFFEE.’” Also, registrant disclaimed the exclusive right to use “Coffee,” “Coco,” and “Espresso.”

#### Preliminary Issue

In the first Office action (August 24, 2007), the examining attorney noted two prior filed applications listed below that may be a Section 2(d) bar to registration:



1. Serial No. 77012018 for the mark THE CRAZY COFFEE COMPANY COCO LOCO ESPRESSO and design for “coffee; tea,” in Class 30, and “coffee shops,” in Class 43, filed on October 2, 2006;<sup>2</sup> and

2. Serial No. 78382691 for the mark COCOLOCO, in standard character form, for “alcoholic liquors, namely, coconut liqueur,” in Class 33, filed on March 11, 2004.

In its February 25, 2008 response, applicant argued that the marks in the noted applications do not so resemble applicant's mark as to be likely to cause confusion.

In the next Office action (March 11, 2008), the examining attorney suspended action in the application pending the disposition of application Serial No. 78382691 (the earliest filed application). The examining attorney did not reference application Serial No. 77012018.

On July 16, 2009, applicant notified the examining attorney that application Serial No. 78382691 was abandoned and requested that its application be approved for publication.

\*2 In an Office action dated August 17, 2009, the examining attorney notified applicant that application Serial No. 77012018 had been registered as Registration No. 3589548 and cited the mark THE CRAZY COFFEE COMPANY COCO LOCO ESPRESSO and design as a Section 2(d) bar to registration.

In applicant's February 17, 2010 response, applicant argued that when the examining attorney suspended action in the application based on the disposition of application Serial No. 78382691 without referencing application Serial No. 77012018, the examining attorney implicitly “withdrew the possible citation to the mark in the '548 registration in the Office action mailed March 11, 2008. Accordingly, the trademark attorney had previously considered the issue and agreed that there is no likelihood of confusion between applicant's mark and the mark in the '548 registration.”<sup>3</sup> The examining attorney did not address this argument in his next Office action (March 17, 2010). Applicant renewed the argument in its September 17, 2010 response. The examining attorney did not address the argument in his October 14, 2010 Office action. Applicant renewed the argument in its brief and the examining attorney addressed the issue, for the first time, in his brief.

[Trademark Rule 2.83\(a\)](#), [37 CFR § 2.83\(a\)](#), provides that “[w]henever an application is made for registration of a mark which so resembles another mark or marks pending registration as to be likely to cause confusion or mistake or to deceive, the mark with the earliest effective filing date will be published in the *Official Gazette* for opposition if eligible for the Principal Register, or issued a certificate of registration if eligible for the Supplemental Register.”

[Trademark Rule 2.83\(c\)](#) provides that “[a]ction on the conflicting application which is not published in the *Official Gazette* for opposition ... will be suspended by the Examiner of Trademarks until the published or issued application is registered or abandoned.”

The Trademark Manual of Examining Procedure (8th ed. 2011) discusses in general terms the process examining attorneys should follow when there are pending applications of marks that may be likely to cause confusion, but it does not explicitly direct examining attorneys to identify all such applications in the suspension order.<sup>4</sup>

In the circumstances before us, application Serial No. 78382691 had a filing date of March 11, 2004 and application Serial No. 77012018 had a filing date of October 2, 2006. When the examining attorney suspended action in the application at issue pending the disposition of Serial No. 78382691, without referencing the other pending application, the examining attorney may have just listed the first filed application. Moreover, the examining attorney may have determined that applicant's mark was more likely to cause confusion with COCOLOCO for coconut liqueurs than with THE CRAZY COFFEE COMPANY COCO

LOCO ESPRESSO and design mark. However, when application Serial No. 78382691 was abandoned, the examining attorney determined that the mark in the other application remained a valid Section 2(d) bar.

\*3 In spite of the examining attorney not identifying application Serial No. 78382691 as a basis for suspension, applicant was not harmed by this omission. While the better practice is for an examining attorney to list all pending applications in the suspension order that may form a basis for refusal, applicant was given an opportunity to argue against a refusal based on the application that matured into the cited registration. In sum, applicant was not prejudiced by the omission of the application serial number in the suspension order and there is no reason to reverse the ultimate refusal to registration. Under these circumstances, there is no reason to prohibit the examining attorney from continuing to prosecute the application. In other words, there is no estoppel. See *In re Recorded Books Inc.*, 42 USPQ2d 1275, 1280 n.5 (TTAB 1997).

During the prosecution of the application in *Recorded Books Inc.*, the examining attorney refused to register applicant's mark on the ground that it was merely descriptive, but invited applicant to amend its application to the Supplemental Register. When applicant amended its application to the Supplemental Register, the examining attorney refused registration on the ground that the mark was generic. The applicant in that case argued that the examining attorney was estopped from refusing registration on the ground that the mark is generic because the examining attorney invited applicant to amend its application to the Supplemental Register. Acknowledging the inconsistency in examination, the Board declined to find an estoppel where the examining attorney changed her mind after further research. Likewise, in this case, the examining attorney adapted to the changing circumstances and issued what he thought was an appropriate refusal. In this regard, the USPTO has a duty to issue valid registrations and has broad authority to correct errors made by examining attorneys. See *Last Best Beef LLC v. Dudas*, 506 F.3d 333, 340, 84 USPQ2d 1699, 1704 (4th Cir. 2007) (“[F]ederal agencies, including the USPTO, have broad authority to correct their prior errors.”); see also *BlackLight Power Inc. v. Rogan*, 295 F.3d 1269, 63 USPQ2d 1534 (Fed. Cir. 2002) (affirming that USPTO officials acted within their authority in a reasonable manner to withdraw a patent from issuance in order to fulfill the USPTO's mission to issue valid patents, even after Notice of Allowance, payment of the issue fee, and notification of the issue date, and with publication of the drawing and claim in the *Official Gazette*). Thus, if the examining attorney discovered that a mistake made during examination would result in issuance of a registration in violation of the Trademark Act or applicable rules, the examining attorney must issue any necessary requirements or refusals, even if they could or should have been previously raised. Accordingly, we find that the examining attorney followed proper examination procedure and the USPTO is not estopped from refusing registration on the basis of likelihood of confusion.

#### Likelihood of Confusion

\*4 Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

A. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

We turn first to the *du Pont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1987). In analyzing the similarity or dissimilarity of the marks, we are mindful that the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD*

*Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1835, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). In making this determination, we must consider the recollection of the average purchaser who normally retains only a general, rather than a specific, impression of the marks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). In this case, the average purchaser is an average consumer who purchases fruit juices, coffee and tea and frequents coffee shops.

The marks are similar to the extent that they both include the term COCO LOCO. In fact, registrant's mark, THE CRAZY COFFEE COMPANY COCO LOCO ESPRESSO and design, incorporates the entirety of applicant's mark. While the mere fact that the marks share common elements does not compel us to find that the marks are similar, it is a factor in comparing the overall commercial impressions engendered by the marks as perceived by consumers. See *Helga, Inc. v. Helga Howie, Inc.*, 182 USPQ 629 (TTAB 1974) (junior party's mark HELGA so resembles the senior party's mark HELGA HOWIE as to be likely to cause confusion).

\*5 As indicated above, applicant translates COCO LOCO as "The Crazy Coconut" and registrant translates COCO LOCO ESPRESSO as "Crazy Coffee." In the August 24, 2007 Office action, the examining attorney submitted dictionary definitions of the word "Coco" that is defined as "Plants Food: *Same as coconut.*"<sup>5</sup> The word "Loco" is defined as a slang term for "an insane person; maniac."<sup>6</sup> We do not know how registrant derived its translation of the term "Coco Loco Espresso" as "Crazy Coffee" because "coffee" in Spanish is "café."<sup>7</sup> Because "Crazy Coffee" is not a literal translation of the term "Coco Loco Espresso," we presume that the "Crazy Coffee" translation is the commercial impression that registrant seeks to engender with consumers. In any event, the term COCO LOCO ESPRESSO, as part of registrant's mark, used in connection with coffee, tea and coffee shops and the term COCO LOCO used in connection with fruit juices are distinctive, memorable terms when used in connection with their respective goods and services and comprise strong elements of both marks. Applicant argues that the term "The Crazy Coffee Company" is the dominant element of registrant's mark.

Applicant submitted the specimen of use filed by registrant, shown below, during the prosecution of registrant's application.



According to applicant, “The wording ‘coco loco espresso’ are secondary features of the trademark and part of the logo with the parrot design. This wording is merely redundant of the wording ‘Crazy Coffee.’”<sup>8</sup>

Applicant's argument assumes that there must be a dominant element in registrant's mark and does not take into account the possibility that registrant's mark is comprised of two memorable and distinctive elements. In this case, we find that registrant's mark is comprised of two such memorable and distinctive elements: the term THE CRAZY COFFEE COMPANY and the COCO LOCO ESPRESSO logo.

When consumers encounter the memorable and distinctive COCO LOCO marks at issue in this appeal, consumers are likely to believe that the products and services emanate from the same source because they will mistakenly believe that COCO LOCO ESPRESSO is the coffee product line of the COCO LOCO brand of products.

In view of the foregoing, when we compare the marks in their entireties, we find that, despite their differences, they are similar in terms of appearance, sound, meaning and commercial impression.

**B. The similarity or dissimilarity and nature of the goods, channels of trade and classes of consumers.**

It is well settled that applicant's goods and the registrant's goods do not have to be identical or directly competitive to support a finding that there is a likelihood of confusion. It is sufficient if the respective products are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used in connection therewith, give rise to the mistaken belief that they emanate from or are associated with a single source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

\*6 To support his position that the applicant's fruit juices and the registrant's coffee and tea products are related, the Examining Attorney has submitted numerous use-based, third-party registrations for goods listed in both the application and registration at issue.<sup>9</sup> Third-party registrations which individually cover a number of different goods that are based on use in commerce may have some probative value to the extent that they serve to suggest that the listed goods are of a type which may emanate from the same source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d at 1785-1786; *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). The registrations listed below are representative.<sup>10</sup>

Mark	Reg. No.	Goods/Services
O CO CO	2861019	Coffee; fruit juices
CALIFORNIA PIZZA KITCHEN	3099870	Coffee, tea; fruit juices
ST-MARC CAFÉ	3576853	Coffee; fruit juices
ZAVIDA COFFEE	3593871	Coffee, tea; fruit juices
BERRY BOX	3139964	Coffee; fruit juices
YOVANA	3230950	Coffee, tea; fruit juices

The examining attorney also submitted excerpts from various websites advertising the sale of tea and fruit juices under the same mark (*i.e.*, SNAPPLE, AriZona, SoBe, TURKEY HILL, TURNER DAIRY FARMS, OAKHURST, SUNCUP, MAYER BROS., MINUTE MAID, NANTUCKET NECTARS, SCHNEIDER'S, WINS and RUBY KIST).<sup>11</sup> This evidence shows that coffee, tea, and fruit juices move in the same channels of trade and that the goods are sold to the same classes of consumers.

Applicant argues that applicant's fruit juices and registrant's coffee and tea products are completely different. However, the issue is not whether consumers would confuse the goods themselves, but rather whether they would be confused as to the source of the goods. *In re Rexel Inc.*, 223 USPQ 830, 831 (TTAB 1984). We find that the evidence submitted by the examining attorney referenced above shows that the goods of applicant and registrant are sufficiently related that consumers would be likely to assume, upon encountering the goods under the marks at issue, that the goods originate from, are sponsored or authorized by, or are otherwise connected to the same source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

\*7 In view of the foregoing, we find that applicant's fruit juices and registrant's coffee and tea products are related, move in the same channels of trade, and are sold to the same classes of consumers.

#### D. Balancing the factors.

In view of the facts that the marks are similar, the goods are related, move in the same channels of trade and are sold to the same consumers, we find that applicant's mark COCO LOCO for "fruit juices" is likely to cause confusion with the mark THE CRAZY COFFEE COMPANY COCO LOCO ESPRESSO and design for "coffee; tea."

**Decision:** The refusal to register is affirmed.

#### Footnotes

- 1 Registration No. 3589548, issued March 17, 2009. The registration also includes "coffee shops," in Class 43, but the examining attorney did not include the services in the likelihood of confusion refusal.
- 2 The mark in this application was ultimately cited as a Section 2(d) bar to registration and is the subject of this appeal. Serial No. 76676618
- 3 February 17, 2010 Office action, p. 4.
- 4 See TMEP §§ 716.02(c), 1208.01 and 1208.02.
- 5 *Encarta.msn.com/dictionary*. See also *Merriam-Webster OnLine (m-w.com)*.
- 6 *The Random House Dictionary of the English Language (Unabridged)*, p. 1129 (2nd ed. 1987). The Board may take judicial notice of dictionary evidence. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).
- 7 *Cassell's Spanish Dictionary*, p. 900 (1959).
- 8 Applicant's Brief, p. 9.
- 9 March 17, 2010 Office action.
- 10 We have not included the entire description of goods for each of the registrations. Only the goods in both applicant's application and registrant's registration are listed.
- 11 October 14, 2010 Office action.

2012 WL 2166296 (Trademark Tr. & App. Bd.)

2000 WL 714198 (Trademark Tr. & App. Bd.)

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

IN RE WMGA, INC.

Serial No. 75/306,785

May 30, 2000

\*1 [Leslye S. Fenton](#) of Odin, Feldman & Pittleman, P.C. for WMGA, Inc.

[Susan Leslie DuBois](#), Trademark Examining Attorney

Law Office 111

([Craig Taylor](#), Managing Attorney).

Before Hanak, Wendel and [Rogers](#)

Administrative Trademark Judges.

Opinion by Wendel

Administrative Trademark Judge:

WMGA, Inc. has filed an application to register the mark SANTA LUCIA for ““coffee beans, whole and ground.””<sup>1</sup>

Registration has been finally refused under Section 2(d) of the Trademark Act on the ground of likelihood of confusion with the marks SANTA LUCIA<sup>2</sup> and SANTA LUCIA and design,<sup>3</sup> as shown below, both of which have been registered by the same entity for “mineral waters.”



**SANTA LUCIA**

Applicant and the Examining Attorney have filed briefs, but no oral hearing was requested.

We make our determination of likelihood of confusion on the basis of those of the du Pont factors<sup>4</sup> which are relevant under the present circumstances. Two key considerations in our analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods with which the marks are being used or are intended to be used. See [In re Azteca Restaurant Enterprises, Inc.](#), 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

Applicant's mark SANTA LUCIA and registrant's mark SANTA LUCIA (Registration No. 1,888,761) are obviously identical. Moreover, we agree with the Examining Attorney that even in registrant's second mark, SANTA LUCIA and design, SANTA LUCIA is the dominant portion of the mark and the portion which will be relied upon by consumers in calling for the goods in the marketplace. As a general rule, design elements of a mark are of lesser import, because it is the word portion of a mark,

rather than any design feature, unless highly distinctive, which is more likely to be remembered and relied upon by customers in calling for the goods. See [Ceccato v. Manifattura Lane Gaetano Marzotto & Fugli S.p.A.](#), 32 USPQ2d 1192 (TTAB 1994); [In re Appetito Provisions Co.](#), 3 USPQ2d 1553 (TTAB 1987).

Applicant has acknowledged that the respective marks are similar in sight and sound, but argues that a new meaning has been attributed to its mark in the marketplace by the association of the mark with applicant's particular product. Applicant claims that the meaning of quality which its product has brought to the mark SANTA LUCIA is sufficient to avoid confusion. Applicant states that its coffee beans come from a single plantation in Nicaragua and are sold to the finest restaurants, hotels, gourmet supermarkets and coffee shops. Applicant relies heavily upon the rulings made by the District Court in [Southern Foods Group L.P. v. Ben & Jerry's Homemade Inc.](#), 48 USPQ2d 1220 (D. Utah 1998) as support for its contention that identical marks can be used on the same product, much less the different products involved here, without the likelihood of confusion.

\*2 The *Southern Foods* case was an infringement and unfair competition action in which an injunction was sought barring the defendants' further use of the mark TOTALLY NUTS for ice cream. The District Court considered not only the marks and the goods of the parties, which were the same, but other factors involved in the actual marketing of the goods, particularly the trade dress, noting the distinct visual differences in the packaging used by the two parties.

By contrast, the present appeal involves the right of applicant to register its mark, in view of the statutory bar under Section 2(d) when there is the likelihood of confusion with a previously registered mark. The registration sought is for the word mark SANTA LUCIA in a typed drawing, which leaves applicant free to use the mark in any format. Since the trade dress used in conjunction with the mark may be changed at whim, the trade dress at any given time is normally not considered in determining likelihood of confusion. An exception may be made if the trade dress provides evidence that there is a likelihood of confusion, i.e., that the commercial impression created by the mark as it is being used is confusingly similar to the other mark. See [Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.](#), 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984). The alternative, however, is not true. The absence of a likelihood of confusion cannot be established on the basis of the present trade dress of the respective products, in view of its transitory nature.

In any event, applicant is arguing that confusion is avoided here by the mere fact that the products involved are different products which must be packaged differently, not by any distinctive style of trade dress. The similarity or dissimilarity of the goods and their packages, however, are factors separate from the similarity of the marks per se. Applicant's mark and registrant's mark SANTA LUCIA are identical and thus necessarily create the identical commercial impression. Even though registrant's second mark has an additional design feature, we find the overall commercial impression of this mark highly similar to applicant's mark. The fact that applicant's coffee beans bearing the mark SANTA LUCIA have achieved a high degree of recognition in the marketplace as a quality product is immaterial, if the previously registered marks are confusingly similar to applicant's mark.

Turning to the goods, we note that the Examining Attorney has made of record copies of several third-party registrations showing the adoption by the same entity of the same mark for both mineral waters and coffee. She relies upon this evidence to support her argument that the goods are related products which may be found in the same commercial setting and, if being marketed under the same mark, may well be assumed by purchasers to originate from the same source. She also points out that coffee beans are used to make coffee; that both coffee and mineral waters are beverages and may be used interchangeably; and that these are common items which are purchased without any particular expertise.

\*3 Applicant argues that there is an obvious difference in the goods, namely, applicant's coffee beans are staples and registrant's mineral waters a "light fluid," and that as such, the products would be not normally be sold in the same areas in food stores. Applicant contends that the goods are not only marketed in visually distinct packaging, but there is also a price differential, registrant's mineral waters being significantly less expensive. Applicant also points to the affidavit of its president William Gutierrez as support for its arguments that its coffee beans travel in different channels of trade and are sold to a different class of purchasers. In this affidavit Mr. Gutierrez states that applicant sells its "premium" coffee beans, which come from one specific

plantation in Nicaragua, to a specialized market, the food and hospitality industry, and that the purchasers of this coffee are extremely discriminating.

AS a general principle, the issue of likelihood of confusion must be determined on the basis of the goods as identified in the application and in the cited registration(s). [Canadian Imperial Bank of Commerce v. Wells Fargo Bank](#), 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Thus, despite applicant's arguments as to the quality or price of its coffee beans, the goods as identified in the application cover all grades of coffee beans, regardless of origin or cost. Furthermore, if there are no restrictions in the application or registration(s) as to channels of trade, the parties' goods must be assumed to travel in all the normal channels of trade for goods of this nature. See [Kangol Ltd. v. KangaROOS U.S.A. Inc.](#), 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992). There being no restrictions in applicant's application as to the particular market in which applicant claims to sell its coffee beans, we must assume that the goods travel in all the normal channels for coffee beans, which includes general retail outlets.

Accordingly, we make our determination of the similarity or dissimilarity of the goods by a comparison simply of coffee beans, whole and ground, and mineral waters. As a general principle, it is not necessary that the goods be similar or even competitive to support a holding of likelihood of confusion, it is sufficient if the respective goods are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give raise to the mistaken belief that they emanate, or are associated with, the same source. See [In re Albert Trostel & Sons](#), 29 USPQ2d 1783 (TTAB 1993) and the cases cited therein. When the goods are food products, the use of identical marks which are not descriptive or highly suggestive in itself weighs heavily on the side of likelihood of confusion. See [In re Martin's Famous Pastry Shoppe, Inc.](#), 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); [In re Vroman Foods, Inc.](#), 224 USPQ 242 (TTAB 1984) and the cases cited therein.

\*4 Here, besides bearing identical (or nearly identical) non-suggestive marks, the goods are closely related beverage products. While applicant's coffee beans may be the raw ingredient for a coffee drink, both products would be purchased for consumption as beverages. See [In re Pan-0-Gold Baking Co.](#), 20 USPQ2d 1761 (TTAB 1991) [muffin mix and baked bread and rolls closely related bread products]. The two products might very well be encountered by the same purchasers in the same retail outlets, regardless of the specific location of each product in a particular store, and be purchased at the same time for use either together, at a party or family gathering, or for use singularly, depending upon the beverage desired at a particular time. Although the third-party registrations made of record by the Examining Attorney are not evidence that the marks shown therein are actually in use, they are adequate to suggest that both coffee products and mineral waters may reasonably be expected to emanate from a single source, along with other beverage products. See [In re Albert Trostel & Sons Co.](#), *supra*. This being the case, we find confusion highly likely if the identical marks SANTA LUCIA, or the highly similar marks SANTA LUCIA and SANTA LUCIA and design, are used on applicant's coffee beans and registrant's mineral waters.

Decision: The refusal under Section 2(d) is affirmed.

E. W. Hanak

H. R. Wendel

G. F. Rogers

Administrative Trademark Judges, Trademark Trial and Appeal Board

#### Footnotes

- 1 Serial No. 75/306,785, filed June 11, 1997, based on an allegation of a bona fide intent to use the mark in commerce. The application as filed recited a number of coffee and tea products, but the identification of goods was ultimately limited to the above.
- 2 Registration No. 1,888,761, issued April 11, 1995.



- 3 Registration No. 1,894,254, issued May 16, 1995. The statement is made that the lining in the mark is a feature of the mark and is not intended to indicate color.
- 4 In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).  
2000 WL 714198 (Trademark Tr. & App. Bd.)

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2008 WL 3211817 (Trademark Tr. & App. Bd.)

THIS DECISION IS NOT A PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

ConAgra Foods RDM, Inc. f/k/a ConAgra Brands, Inc.

v.

Candwich Food Corporation

Opposition No. 91170341 against Serial No. 78337608

July 17, 2008

\*1 Christopher M. Bikus, Michaela A. Smith, Patrick C. Stephenson and Tracy Deutmeyer of McGrath North Mullin & Kratz, PC LLO for ConAgra Foods RDM, Inc.

Julie K. Morriss of Morriss O'Bryant Compagni, P.C. for Candwich Food Corporation

Before Quinn, Bucher and Drost

Administrative Trademark Judges

Opinion by Bucher

Administrative Trademark Judge:

Candwich Food Corporation seeks registration on the Principal Register of the mark **CANDWICH** (*in standard character format*) for goods identified in the application, as amended, as follows:

“food items packaged in cans, namely, vegetable-based snack foods” in International Class 29; and

“food items packaged in cans, namely meat-based sandwiches, candy, popcorn, candy popcorn and dessert puddings” in International Class 30.<sup>1</sup>

ConAgra Brands, Inc. (by merger, now known as ConAgra Foods RDM, Inc.) has opposed this application on the ground of priority of use and likelihood of confusion, alleging that applicant's mark, when used in connection with the identified goods, so resembles its **MANWICH** mark, which is the subject of two registrations, as follows:

**MANWICH** for “sandwich sauce” in International Class 30;<sup>2</sup> and

**MANWICH** for “spice and seasoning mixes for meats” also in International Class 30.<sup>3</sup>

as to be likely to cause confusion, to cause mistake or to deceive, under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d). As a second ground for opposition, opposer alleges that applicant's **CANDWICH** mark should be refused registration because allowing such registration would result in dilution of the distinctive quality of opposer's **MANWICH** mark in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

Applicant, in its answer, denied all the salient allegations of these claims.

### ***I. THE RECORD***

By operation of Trademark Rule 2.122, 37 CFR § 2.122, the record includes the pleadings and the file of the involved application.

\*2 The record also includes the following testimony and evidence:

A. Opposer's Evidence

1. Testimony Deposition of Joseph Anthony Bybel, Vice President of Marketing for a portfolio of brands, including **MANWICH**, taken on August 6, 2007 (with Exhibit Nos. 1-4) ("Bybel Dep.");
2. Opposer's First Notice of Reliance filed on August 27, 2007 on ConAgra's pleaded Registration No. 0888780;
3. Opposer's Second Notice of Reliance filed on August 27, 2007 on ConAgra's pleaded Registration No. 1349839.
4. Opposer's Third Notice of Reliance filed on August 27, 2007 on the discovery deposition of Mark R. Kirkland taken on February 27, 2007 ("Kirkland Dep.");
5. Opposer's Fourth Notice of Reliance filed on August 27, 2007 on printed publications; and
6. Opposer's Fifth Notice of Reliance filed on August 27, 2007 on third party Registration Nos. 2899796; 2928755; 2156879; 1222755; and 3229262.

B. Applicant's Evidence:

1. Applicant's First Notice of Reliance filed on October 24, 2007 on printed publications;
2. Applicant's Second Notice of Reliance filed on October 24, 2007 on the discovery deposition of Mark R. Kirkland (with Exhibit Nos. 1-6); and
3. Applicant's Third Notice of Reliance filed on October 24, 2007 on certain additional portions of the discovery deposition of Mark R. Kirkland earlier relied upon by opposer.

## **II. FACTUAL FINDINGS**

The record establishes all of the following facts in this case.

According to the testimony of Mr. Bybel, opposer began sales of sloppy Joe sandwich sauce under the **MANWICH** mark in 1969 (through its predecessor in interest). Hence, the **MANWICH** mark has been in continuous use on these sauces for almost forty years. As seen above, opposer owns two incontestable registrations for the **MANWICH** trademark.

Annual sales in 2007 reached approximately \$75 million, making the **MANWICH** brand one of the largest selling sloppy Joe sandwich sauces in the country. Opposer expends \$10 million annually on promoting its **MANWICH** branded products nation-wide. This effort includes television advertising, free-standing inserts and coupons in local newspapers, advertisements in retailers' circulars and over the Internet, as well as movie tie-ins that include joint promotions with DVD's such as "*Shrek*."

A typical can of **MANWICH** sauce costs approximately \$1.50 and the primary customer of the **MANWICH** brand sauce is the individual responsible for purchasing household groceries. Opposer has also marketed under the **MANWICH** brand a ready-to-eat, refrigerated product having fully-cooked ground beef.

Applicant seeks to register the mark **CANDWICH** for use with shelf-stable, ready-to-eat, sandwiches that are contained within vending-sized cans. While the identification of goods lists meat-based sandwiches, the sample labels in the record were for peanut butter and jelly sandwiches. Other types of sandwiches under development include barbecue chicken, barbecue beef, pizza, French toast and bacon & cheddar. Applicant also contemplates that the vendable-sized cans will contain vegetable-based snacks such as potato chips and crackers, as well as dessert puddings, etc. In addition to being sold through vending machines, applicant's canned products will likely be sold in retail stores. The ultimate consumers are projected to be primarily persons looking for a convenient, on-the-go food having a long shelf life and no need for refrigeration.

### III. ANALYSIS

#### A. Standing

\*3 Opposer's standing is a threshold inquiry made by the Board in every *inter partes* case. In *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999), the Federal Circuit has enunciated a liberal threshold for determining standing, i.e., whether one's belief that one will be (is) damaged by the registration is reasonable and reflects a real interest in the case. See also *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987); and *Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Opposer has submitted evidence of its ownership of its **MANWICH** registrations. We consider this evidence as sufficient to establish opposer's interest and, therefore, standing, in this proceeding.

#### B. Priority

Because opposer has established that it owns valid and subsisting registrations of its pleaded mark, priority is not an issue. See *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); and *Carl Karcher Enterprises Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125 (TTAB 1995).

#### C. Likelihood of Confusion

We turn, then, to the issue of likelihood of confusion under Section 2(d) of the Trademark Act. Our determination must be based upon our analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. 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 Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). 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 the essential characteristics of the goods and differences in the marks.” 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).

#### *Fame*

As to the strength of opposer's involved mark, the record shows that opposer's **MANWICH** mark is truly wellknown. Opposer has enjoyed almost forty years of continuous usage of the **MANWICH** mark for sloppy Joe sauce. It expends approximately \$10 million annually in promotional costs, and during fiscal year 2007, opposer exceeded \$75 million in annual sales. There is no evidence in the record of any third-party use of similar marks for related goods. Accordingly, we find that the **MANWICH** mark is strong and entitled to a broad scope of protection.

\*4 More significantly, for our purposes, the *du Pont* factor focusing on the fame of the prior mark plays a dominant role in the process of balancing the *du Pont* factors in cases featuring a strong mark. *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992); see also *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005); *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367,

63 USPQ2d 1303 (Fed. Cir. 2002); and *Recot, Inc. v. M. C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000). As the fame of a mark increases, the degree of similarity between the marks necessary to support a conclusion of likely confusion declines. *Bose Corp.*, 63 USPQ2d at 1309.

Moreover, the Federal Circuit has stated repeatedly that there is no excuse for even approaching the well-known trademark of a competitor. See *Nina Ricci S.A.R.L. v. E.T.F. Enterprises*, 889 F.2d 1070, 1074, 12 USPQ 1901, 1904 (Fed. Cir. 1989), inasmuch as “[a] strong mark ... casts a long shadow which competitors must avoid”; and *Kenner Parker Toys Inc.*, 22 USPQ2d at 1456.

We agree with opposer that this evidence confirms that the **MANWICH** mark is famous. The evidence in this case certainly exceeds the extensive public recognition and renown found sufficient to establish fame in other cases.<sup>4</sup>

There is no implication in this record that applicant chose its mark to trade on the goodwill developed by opposer, but applicant's president, Mark R. Kirkland, admitted that he had known of the **MANWICH** brand for many years prior to the filing date of this application.

In view of the above, we find that the *du Pont* factor focusing on the fame of the mark weighs in favor of finding a likelihood of confusion herein.

#### *Relatedness of the goods*

We turn, next, to the relatedness of the goods as listed in the cited registrations and in the involved application. It is well-established that goods need not be identical or even competitive in order to support a determination of likelihood of confusion. Rather, it is enough that goods are related in some manner such that their marketing would be likely to be seen by the same persons which give rise to a mistaken belief that the goods are associated. *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). Furthermore, the Board must base its determination of whether there is a relationship between the goods of the parties on the basis of the goods as identified in the respective application and registrations. *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1788 (Fed. Cir. 1990).

\*5 Applicant has characterized its intended products as vendable food items such as sandwiches, snacks such as chips and desserts such as puddings, all of which would be “packaged in cans.”

Registrant's '780 Registration covers “sandwich sauce.” As shown in the record, this is a tomato-based sauce for making sloppy Joe sandwiches when mixed with ground beef.

Applicant's identification of goods specifically enumerates “meat-based sandwiches.” A sample label shows **CANDWICH** used in connection with a barbeque chicken sandwich. Applicant's president testified about his interest in pursuing barbeque beef and barbeque chicken sandwich pockets. In fact, applicant's president mused during his trial testimony that he thought to himself, as he was driving to the deposition, that it might be mutually beneficial to co-brand with opposer, creating the **CANDWICH** brand beef sandwich pocket using **MANWICH** brand sauce.

Moreover, the existence of the following third-party registrations for sandwich sauces as well as sandwiches and vendable snacks, all offered under the same mark, further supports the conclusion that the goods described in the **CANDWICH** application fall within the natural zone of expansion for goods described in the **MANWICH** registrations:

**STOUFFER'S**

for “prepared, preserved foods-namely, meats; fish; shellfish; poultry; vegetables; fruits; [and] soufflés” in International Class 29;

“prepared, preserved foods-namely, pizza; crepes; sandwiches; [and] sauces” in International Class 30;<sup>5</sup>

#### TRADER JOE'S

for, *inter alia*, “... barbecue sauce, ... candy coated popcorn, ... caramel popcorn, ... cereal-based snack food, ... cheese flavored puffed corn snacks, ... corn chips, corn curls, ... cracker and cheese combinations, crackers, ... flour-based chips, ... grain-based chips, ... pizza sauce, popped popcorn, ... pretzels, ... processed popcorn, puddings, puffed corn snacks, ... rice-based snack foods, ... sandwiches, sauces, ... snack mix consisting primarily of crackers and/or pretzels and/or candied nuts and/or popped popcorn, ... taco chips, ... tortilla chips, ... and wheat-based snack foods” in International Class 30;<sup>6</sup>

#### A TASTE OF INDONESIA

for, *inter alia*, “processed foods, namely, ... banana chips; ... beef jerky; processed blueberries; banana chips; ... cassava chips; ... yucca chips; ... cheese and cracker combinations; ... shelf stable meat, fish, poultry or vegetables; ... fruit-based snack food; ... jams; jellies; ... marmalade; ... food package combinations consisting primarily of cheese, meat, seafood, vegetable and/or processed fruit; ... peanut butter; pork rinds; ... potato chips; potato crisps; ... snack mix consisting primarily of processed fruits; processed nuts and/or raisins; ... cheese spreads; meat-based spreads; ... tomato paste; tomato puree; canned, cooked and otherwise processed tomatoes; vegetable-based spreads; processed, fresh, and canned vegetables; ...” in International Class 29;

“food products and ingredients of foods, namely, ... barbecue sauce; ... candied popped popcorn; ... candy coated popcorn; ... caramel popcorn; caramels; ... cereal based snack food; cereal-based energy snack food bars; ... cheese flavored puffed corn snacks; ... corn chips; corn curls; ... cracker and cheese combinations; crackers; ... flour-based chips; ... glazed popcorn; ... grain-based chips; ... granola-based snack bars; ... hamburger sandwiches; ... popped popcorn; ... pretzels; ... processed popcorn; ... puddings; puffed corn snacks; ... rice-based snack foods; ... granola-based snack bars; sloppy Joe sauce; sloppy Joe seasoning mix; ... tomato sauce; ... tortilla chips; ... wheat-based snack foods; ...: in Intl. Class 30;<sup>7</sup>

#### PLANET COOK

for, *inter alia*, “... fruit and soy based snack food, fruit chips, ... fruit-based snack food, ... jams, jellies, ... marmalade, ... processed nuts, ... peanut butter, ... potato chips, ... potato-based snack foods, ... cheese or chicken sandwich spread, ... snack mix consisting primarily of processed fruits, processed nuts and/or raisins; ... soy-based snack foods, ... vegetable-based spreads, ...” in Intl. Class 29;

“... bakery goods, *barbecue sauce*, ... candy coated popcorn, ... caramel popcorn, ... cereal based *snack food*, cheese flavoured puffed corn *snacks*, ... corn chips, ... cracker and cheese combinations, crackers, ... food package combination consisting primarily of bread, crackers and or cookies, ... granola-based *snack bars*, ... microwave popcorn, ... popped popcorn, ... puddings, ... ready-to-eat cereal derived food bars, ... *sandwiches*, *sauces*, ... *tomato sauce*, ... *tortilla chips*, tortilla shells, ...” in International Class 30;<sup>8</sup>

## JIMANO'S

for “*barbecue dry rub*; *barbecue sauce*; ... pizza sauce; ravioli; *sandwiches*; *sauces for barbecued meat*; ... spaghetti sauce; frozen, prepared, packaged meals consisting primarily of pasta or rice” in International Class 30.<sup>9</sup>

### *Channels of Trade*

\*6 Under applicant's business model, the unique feature of packaging these goods is putting combinations of sandwich pockets, chips and/or a dessert pudding in vendable cans. Hence, the founder and president of applicant envisions that many of these goods will eventually be marketed through vending machines. However, applicant's president also testified that he thought retail operations, including bigbox, discount stores, would be key components of the initial marketing strategy. This latter effort would involve a trade channel that overlaps with opposer's traditional retail channels of trade. Even in the absence of such testimony, any asserted limitation in the actual trade channels of applicant cannot be considered. *In re Bercut- Vandervoort & Co.*, 229 USPQ 763, 764-65 (TTAB 1986) [extrinsic evidence and argument suggesting trade-channel restrictions not specified in application rejected]. Neither the involved application nor the registrations at issue include any restrictions as to the channels of trade. Therefore, it must be assumed that the goods as they are identified in the application for registration would travel in all appropriate trade channels to all potential purchasers of such goods. See *Cunningham v. Laser Golf Corp.* 55 USPQ2d 1842, 1844 (Fed. Cir. 2000).

### *Conditions under which sales are made, and to whom*

Similarly, the evidence in the record reveals that the intended purchaser of applicant's **CANDWICH** product will be “anyone that intends to purchase a food item,” and more specifically, the individual responsible for purchasing household groceries. See opposer's Third Notice of Reliance, Kirkland Dep. at 22-23, 41; applicant's Second Notice of Reliance, Kirkland Dep. at 41-42. This is the same consumer to whom opposer targets its products.

Moreover, both the involved products are inexpensive - ranging between one and two dollars apiece - clearly qualifying them as “impulse items.” When goods are purchased on impulse and without a great deal of care, consumers pay limited attention to the purchase of such goods and are thus more susceptible to confusion. “It has often been stated that purchasers of such products are held to a lesser standard of purchasing care and thus, are more likely to be confused as to the source of the goods.” *Wet Seal, Inc. v. FD Management, Inc.*, 82 USPQ2d 1629 (TTAB 2007) [sustaining the opposition on the grounds of likelihood of confusion, in part, because the parties' goods were susceptible to impulse purchase and frequent replacement; also citing to *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.* 748 F.2d 669, 223 USPQ2d 1281 (Fed. Cir. 1984)].

### *The Marks*

We turn next to examine the similarity or dissimilarity of the parties' marks in their entireties as to appearance, sound, connotation and commercial impression. See *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d at 1692. In particular, opposer argues that the parties' marks are confusingly similar as to sight, sound and meaning.

\*7 Under this *du Pont* factor, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions such that confusion as to the source of the goods offered under the respective marks is a likely result. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Comparing the marks, we agree with opposer that the linguistic component of applicant's mark and opposer's mark are similar in appearance and substantially identical in pronunciation. Both terms contain the same number of syllables and have the same stress pattern, with the primary accent on the initial syllable and the second syllable of each being identical. As to appearance and sound, the most noticeable difference between the marks is the fact that applicant's mark starts with the letter "C" while opposer's mark begins with the letter "M." In this context, slight differences in the sound of similar marks do not avoid a likelihood of confusion. *G.D. Searle & Co. v. Chas. Pfizer & Co.*, 265 F.2d 385, 387, 121 USPQ 74 (7<sup>th</sup> Cir. 1959) [finding **BONAMINE** and **DRAMAMINE** confusingly similar despite differences in the prefixes of both words]; see also *Interlego AG V. Abrams/Gentile Entertainment Inc.*, 63 USPQ2d 1862 (TTAB 2002) [finding **MEGO** confusingly similar to **LEGO**]; *American Cyanamid Co. v. U.S. Rubber Co.*, 356 F.2d 1008, 148 USPQ 729 (CCPA 1966) [given the similarity in sound and spelling, **PHYGON** confusingly similar to **CYGON**).

Certainly, no trademark owner can guarantee that the public will pronounce its mark perfectly. *Frances Denney, Inc. v. ViVe Parfums Ltd.*, 190 USPQ 302 (TTAB 1976) [**ViVe** and fleur de lis design for perfume products are likely to cause confusion with **VIVA** cosmetic products]; *Nina Ricci S.A.R.L. v. Haymaker Sports, Inc.*, 134 USPQ 26 (TTAB 1962) [applicant's **RICCI OF HAYMAKER** is confusingly similar to opposer's **NINA RICCI** and **RICCI**]; *In re Electrons, Inc.*, 144 USPQ 442 (TTAB 1964) [applicant's **Di-El-Trol** is confusingly similar to registrant's **DIALTRON**]; *In re Energy Telecommunications & Electrical Association*, 222 USPQ 350 (TTAB 1983) [**INTELECT** likely to be confused with the **ENTELEC** design shown at right: In fact, applicant's president acknowledged that **CANDWICH** and **MANWICH** sound alike. (Opposer's Third Notice of Reliance, Kirkland Dep. at 39).

On the other hand, we do not find a strong similarity in connotation. To the extent the common suffix -WICH may convey a relationship with sandwiches, prospective consumers may be inclined to look to the first syllable for distinguishing matter. In this context, opposer's mark may suggest a sandwich suitable for a "man," while applicant's proposed mark suggests a sandwich in a "can."

\*8 Hence, while the beginning consonants have a different appearance, these words sound very much alike when spoken. We find that this similarity in sound and appearance outweighs the dissimilarity in connotation.

While we cannot be sure what commercial impressions these respective marks will create, given the relatedness of the goods, we find it possible that consumers acquainted with opposer's **MANWICH** sauces, upon first encountering applicant's **CANDWICH** barbeque beef sandwich pockets, for example, may find the respective commercial impressions similar enough to assume that this may well be a logical brand extension by opposer.

We note that the record does not reveal the frequency with which manufacturers and merchants choose -WICH formative marks in connection with sandwich-related products. However, we should hasten to note that in finding these two marks in their entireties to be confusingly similar, we are clearly *not* finding that any one party could create for itself proprietary rights in the -WICH suffix in connection with the manufacturing and/or merchandising of sandwiches.

***Resolving any Doubt against applicant***



Further, all doubt with respect to whether confusion, mistake or deception is likely must be resolved against the applicant. *Uncle Ben's, Inc. v. Stubenberg, Int'l, Inc.*, 47 USPQ 1310 (TTAB 1998) [finding a likelihood of confusion between **UNCLE BEN'S** and **BEN'S BREAD**].

In this case, it is clear that applicant adopted its mark knowing full well of opposer's well-known **MANWICH** mark. (Opposer's Third Notice of Reliance, Kirkland Dep. at 35). Applicant acknowledged that the goods offered under its mark could be used in conjunction with the goods offered under the **MANWICH** mark. (Opposer's Third Notice of Reliance, Kirkland Dep. at 38). "It is a well established principle that one who adopts a mark similar to the mark of another for the same or closely related goods or services does so at his own peril, and any doubt as to likelihood of confusion must be resolved against the newcomer and in favor of the prior registrant." *Starbucks U.S. Brands, LLC v. Ruben*, 78 USPQ2d 1741 (TTAB 2006). In this case, we find that applicant's mark is simply too similar to opposer's mark and as such, any doubt which may exist, must be resolved against applicant.

#### *D. Dilution*

Finally, we note that opposer also charges that given the demonstrated prior fame of opposer's **MANWICH** mark, applicant's use of its **CANDWICH** mark is likely to cause dilution of opposer's mark under the Federal Trademark Dilution Act of 1995. However, given our determination that opposer has priority of use and that there is a likelihood of confusion herein, we find it unnecessary to reach a determination on the question of dilution in this proceeding.

*Decision:* The opposition is sustained based on the ground of likelihood of confusion under Section 2(d) of the Lanham Act, and registration to applicant is hereby refused.

#### Footnotes

- 1 Application Serial No. 78337608 was filed on December 8, 2003 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.
- 2 Registration No. 0888780 issued to Hunt-Wesson Foods, Inc. on March 31, 1970; second renewal. According to the records of the Assignment Services Division of the United States Patent and Trademark Office, this registration was assigned to Conagra Foods RDM, Inc. during May 2007, recorded at Reel 3579, Frame 0821.
- 3 Registration No. 1349839 issued to Hunt-Wesson Foods, Inc. on July 16, 1985; renewed. According to the records of the Assignment Services Division of the United States Patent and Trademark Office, this registration was assigned to Conagra Foods RDM, Inc., during May 2007, recorded at Reel 3579, Frame 0821.
- 4 See *Bose Corp.*, 63 USPO2d at 1308 [**ACOUSTIC WAVE** mark famous based on seventeen years of use, annual sales over \$50 million, annual advertising in excess of \$5 million, and extensive media coverage]; *Nina Ricci, S.A.R.L. v. E.T.F. Enters., Inc.*, 12 USPQ2d at 1902 [**NINA RICCI** famous for perfume, clothing and accessories based on \$200 million in sales, over \$37 million in advertising, and over 27 years of use]; *Kimberly-Clark Corp. v. H. Douglas Enter., Ltd.*, 774 F.2d 1144, 227 USPQ 541, 542 (Fed. Cir. 1985) [**HUGGIES** famous for diapers based on over \$300 million in sales over nine years and \$15 million in advertising in a single year]; *Specialty Brands Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984) [**SPICE ISLANDS** for teas, spices and seasonings famous based on use for 40 years, \$25 million annual sales for spices, \$12 million sales for tea between 1959 and 1981, and "several million" in advertising].
- 5 Registration No. 1222755 issued on January 4, 1983; renewed.
- 6 Registration No. 2156879 issued on May 12, 1998; renewed.
- 7 Registration No. 2899796 issued on November 2, 2004.
- 8 Registration No. 2928755 issued on March 1, 2005.
- 9 Registration No. 3229262 issued on April 17, 2007.

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2007 WL 2019711 (Trademark Tr. & App. Bd.)

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

IN RE SIGMA ALIMENTOS, S.A. DE C.V.

SERIAL 78572313 AND 78572318

July 3, 2007

\*1 [Albert B. Kimball, Jr.](#), of [Bracewell & Patterson, L.L.P.](#) for Sigma Alimentos, S.A. de C.V.

[Pamela N. Hirschman](#), Trademark Examining Attorney

Law 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, black, serif font with a grainy, stippled texture. The letters are closely spaced and have a slightly irregular, hand-drawn appearance.The word "SOLE" is rendered in the same bold, black, serif font with a grainy texture as the first mark. Below it, the word "Light" is written in a smaller, black, cursive script font.

for goods identified in the applications, as amended, as “soy based beverages not being milk substitutes” in International Class 32.<sup>1</sup>

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:

The word "SOLE" is rendered in a clean, black, serif font. The letters are widely spaced and have a classic, formal appearance.

registered for “spring water” in Int. Class 32,<sup>2</sup> 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 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



mark is identical to the cited



mark. Similarly, the Trademark Examining Attorney argues that the dominant feature of applicant's stylized mark



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**

\*2 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

A stylized, bold, black font of the word "SOLE". The letters are thick and blocky. The final letter "E" has a small, dark, leaf-like flourish or accent mark above its top right corner.

mark is identical to the cited

A stylized, bold, black font of the word "SOLE", identical to the one above. The letters are thick and blocky. The final letter "E" has a small, dark, leaf-like flourish or accent mark above its top right corner.

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 *SOLE* 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.

\*3 This is not a case where the connotation of the term is deemed to be clearly different as applied to the respective goods.<sup>3</sup> 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 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



mark is identical to the cited



mark in sound, appearance, connotation and commercial impression. Presumably the low-fat version of this product will be marketed under the mark

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.” *Amcor, Inc. v. Amcor 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.”].

\*4 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 (4<sup>th</sup> 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;<sup>4</sup>



for, *inter alia*, “ ... mineral water, aerated water, soda water ... soy bean juice” in International Class 32;<sup>5</sup>

**金莱香 Golden king**

for, *inter alia*, “ ... soy bean based beverages” in International Class 29;

“ ... drinking water with herbal flavoring ... mineral water ...” in International Class 32;<sup>8</sup>

**GLACEAU SOY WATER**

for “non-alcoholic beverages, namely bottled drinking water containing soy protein and isoflavones” in International Class 32;<sup>6</sup>

**100% PURE YUM**

for “soy-based food beverages ...” in Inter. Class 29; “spring water ...” in International Class 32;<sup>7</sup>

**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.<sup>9</sup>

\*5 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.

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

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.

#### Conclusion

**\*6** 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.

#### Footnotes

<sup>1</sup> Application Serial No. 78572313 for the mark SOLÉ (*stylized*) was filed on February 22, 2005 based under Section 44(e) of the Trademark Act upon applicant's Mexican registration number 843455, issued on July 20, 2004. Similarly, application Serial No.



78572318 for the mark **SOLE 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.
- 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].
- 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.
- 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."
- 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.
- 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).

2007 WL 2019711 (Trademark Tr. & App. Bd.)

2014 WL 7496058 (Trademark Tr. & App. Bd.)

This Opinion is not a Precedent of the TTAB

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

IN RE IVIBE COFFEE, INC.

Serial No. 86137545

December 17, 2014

\*1 [Scott T. Kannady](#) of Brown & Kannady LLC for iVibe Coffee, Inc.

[Paul C. Crowley](#)

Trademark Examining Attorney

Law Office 112

([Angela Bishop Wilson](#), Managing Attorney)

Before [Seeherman](#), [Cataldo](#) and Masiello

Administrative Trademark Judges

Opinion by [Cataldo](#)

Administrative Trademark Judge:

Applicant, iVibe Coffee, Inc., filed an application to register on the Principal Register the mark shown below for, as amended, “coffee, coffee and tea; coffee based beverages; coffee beverages with milk; coffee-based beverage containing milk; coffee-based iced beverages; iced coffee; prepared coffee and coffee-based beverages; roasted coffee beans,” in International Class 30:<sup>1</sup>



The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act on the ground of likelihood of confusion with the mark IV MUG, in standard characters, previously registered on the Principal Register for “coffee; coffee beans; ground coffee beans; roasted coffee beans,” in International Class 30.<sup>2</sup>

When the refusal was made final, Applicant appealed and filed a request for reconsideration. When the request for reconsideration was denied, this appeal commenced. Applicant and the Examining Attorney filed main briefs.

## Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *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, two key, though not exclusive, considerations are the similarities between the marks and the similarities between the goods 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 Rest. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

### *The Goods and Their Trade Channels and Classes of Purchasers*

We turn now to our consideration of the identified goods. In making our determination under the second *du Pont* factor, we look to the goods as identified in the involved application and cited registration. See *Octocom Sys., Inc. v. Houston Comp. Serv. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“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 the sales of goods are directed.”). See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) (“Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.”).

\*2 In this case, Applicant's “coffee, coffee and tea; coffee based beverages; coffee beverages with milk; coffee-based beverage containing milk; coffee-based iced beverages; iced coffee; prepared coffee and coffee-based beverages; roasted coffee beans” are, in part, identical to Registrant's ““coffee; coffee beans; ground coffee beans; roasted coffee beans.” Based upon the respective identifications of goods, both Applicant and Registrant provide ““coffee” and “roasted coffee beans” under their respective marks. As a result, there is no need for us to consider whether Applicant's and Registrant's other coffee-related goods are similar. In the context of our analysis under Section 2(d), it is sufficient if likelihood of confusion is found with respect to use of the mark on any item that comes within the description of goods in the application or registration. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); and *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1398 (TTAB 2007).<sup>3</sup>

Applicant argues that its goods move in distinct channels of trade and that the Internet evidence proffered by the Examining Attorney does not support his contention that Registrant's goods move in the same trade channels. Applicant contends that “the examining attorney has not presented any actual evidence of Registrant's business operations and is not entitled to presume or expect the Trademark Trial and Appeal Board to presume that the operations of others are proof of the manner in which Registrant operates its business.”<sup>4</sup> Applicant's argument is unpersuasive. Rather, it is well-established that when an applicant and registrant recite goods that are identical, they must be presumed to travel in the same channels of trade and be sold to the same classes of consumers. See *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001 (Fed. Cir. 2002); and *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010). Because of this presumption, it is unnecessary for the Examining Attorney to submit evidence that the trade channels for such goods are related.

The identity of the goods, trade channels and classes of purchasers are factors that weigh heavily in favor of a finding of likelihood of confusion.

### *The Marks*

We turn then to the first *du Pont* factor, i.e., whether Applicant's mark,



and the mark in the cited registration, IV MUG, are similar or dissimilar when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). We note initially that the test under the first *du Pont* factor is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

\*3 We note in addition that, “[w]hen marks would appear on virtually identical ... [goods or] services, the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines.” See *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1994). See also *ECI Div. of E-Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443 (TTAB 1980).

In this case, Applicant's mark consists of the term IV in stylized script. Registrant's mark consists of the wording IV MUG in standard characters. The marks are similar in sound to the extent that the sole word in Applicant's mark, “IV,” is the first word in Registrant's mark. *Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed in the mind of a purchaser and remembered”). See also *Century 21 Real Estate Corp. v. Century Life of America*, 23 USPQ2d at 1700 (upon encountering the marks, consumers must first notice the identical lead word). As to appearance, the stylized form of the lettering IV in Applicant's mark is not sufficient to distinguish it from the IV portion of the cited registered mark, because the cited mark is in standard character form and is not limited to any particular font, size, style, color, or other graphic presentation. *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257 (Fed. Cir. 2010). Thus, we must consider that Registrant might display its mark with a lower-case letter “i” and an upper-case letter “V.”

With regard to the term shared by the marks, IV, we note that, whatever meaning it is intended to convey, it could be interpreted by consumers as having the same meaning in both marks.<sup>5</sup> During prosecution, the Examining Attorney made of record the following definition of “MUG” - “a large drinking cup with a handle” and “the liquid that is contained in a mug.”<sup>6</sup> Thus, the term MUG, being strongly suggestive of coffee, has limited capacity to distinguish Registrant's mark from Applicant's mark, as Applicant's goods, like those of Registrant, may be served in a mug. Accordingly, despite the additional word MUG in Registrant's mark, we find that the marks are similar in connotation and commercial impression. As used in connection with Applicant's and Registrant's in-part identical goods, consumers may view the marks as variants of one another, pointing to a common source.

\*4 We recognize the obvious differences between the marks. However, for the reasons discussed above, we find that the difference in appearance is not sufficient to distinguish them. We also find that the difference in sound is outweighed by the similarity between Applicant's stylized "IV" mark and Registrant's IV MUG mark. As discussed above, when Applicant's mark and the cited mark are viewed in their entirety, we find their similarities in sound, connotation and commercial impression outweigh the difference in appearance.

Applicant argues that its mark "is a logo representing the full name of its business - iVibe Coffee, Inc. - and is used as such in Applicant's marketing materials."<sup>7</sup> However, in making our determination regarding the similarity of the marks, we must consider the marks as they appear in the involved application and cited registration. Applicant cites to no authority for its apparent position that we must consider extrinsic marketing materials or trade names that are not a part of the mark at issue.

Applicant further argues without any evidence that "Registrant's mark is not strong and there is very little to no public recognition of the mark known to Applicant."<sup>8</sup> Simply put, without any supporting evidence, we can give no weight to Applicant's mere assertion that the mark in the cited registration is weak and entitled to a narrow scope of protection. We observe in addition that it is not necessary for the Examining Attorney to demonstrate that a cited mark possesses any degree of public recognition for purposes of an ex parte determination of a refusal to register under Section 2(d), only that the cited mark be registered.

As a result of the similarities between the marks in sound, connotation and commercial impression, this *du Pont* factor further favors a finding of likelihood of confusion.

#### *Actual Confusion*

Another *du Pont* factor discussed by Applicant and the Examining Attorney is the lack of instances of actual confusion. The involved application is based on Applicant's bona fide intent to use the mark in commerce. Nonetheless, Applicant has submitted evidence that it is using its mark in connection with the identified goods. Applicant asserts that "the examining attorney has not been able to prove any actual confusion, and the Applicant asserts that, in fact, there is an absence of any actual confusion."<sup>9</sup>

However, as pointed out by the Examining Attorney, it is not necessary to show actual confusion in order to establish likelihood of confusion. See *Weiss Assoc. Inc. v. HRL Assoc. Inc.* 902 F.2d 1546, 223 USPQ 1025 (Fed. Cir. 1990). Particularly in an ex parte proceeding, where we have no evidence regarding the extent or manner of use of Registrant's mark (nor any other input from Registrant), Applicant's assertion of the absence of actual confusion is of little probative value in our determination on the issue of likelihood of confusion because the Board cannot readily determine whether there has been a significant opportunity for actual confusion to have occurred, such that the absence of confusion is meaningful. See *In re Opus One Inc.*, 60 USPQ2d 1812, 1817 (TTAB 2001); *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026 (TTAB 1984). As our principal reviewing court said in *In re Majestic Distilling Co.*, 65 USPQ2d at 1205:

\*5 With regard to the seventh *DuPont* factor, we agree with the Board that Majestic's uncorroborated statements of no known instances of actual confusion are of little evidentiary value. See *In re Bissett-Berman Corp.*, 476 F.2d 640, 642, 177 USPQ 528, (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). A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight, *J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 964, (CCPA 1965), especially in an *ex parte* context.

#### *Consumer Sophistication*

Finally, Applicant urges us to consider consumer sophistication. There is nothing in the record that evidences any particular sophistication of the consumers of the relevant goods, which consist of coffee, tea, and coffee-based products, i.e., items that may be purchased by the general public. To the extent we accept that some of the purchasers of these products exercise greater care than other consumers of these general consumer products, even a careful consumer of these in-part identical goods is not likely to note the differences in the marks. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 948-949 (Fed. Cir. 2000). Furthermore, even if purchasers were to notice the difference in the marks, they are not likely to ascribe it to differences in the source of the goods, but will see the marks as variations of each other, pointing to a single source. Accordingly, we deem this *du Pont* factor also to favor a finding of likelihood of confusion.

#### *Balancing the Factors*

Neither Applicant nor the Examining Attorney has discussed any of the remaining *du Pont* factors. We note, nonetheless, that none seems to be applicable, inasmuch as we have no evidence with respect to them.

We find that particularly in light of the in-part identical nature of the goods, their trade channels and purchasers, and the similarities between the marks, a likelihood of confusion exists between the mark and goods identified the involved application and the mark and goods in the cited registration. It is well established that one who adopts a mark similar to the mark of another for the same or closely related goods or services does so at his own peril. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed Cir. 1988); and *W.R. Grace & Co. v. Herbert J. Meyer Indust., Inc.*, 190 USPQ 308 (TTAB 1976).

**\*6 Decision:** The refusal to register under Section 2(d) of the Trademark Act is affirmed as to the goods identified in International Class 30.

Application Serial No. 86137545 will proceed to publication as to the services recited in International Classes 35 and 43.

#### Footnotes

- 1 Application Serial No. 86137545 was filed on December 6, 2013 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). “The mark consists of a stylized lower case letter ‘i’ and a stylized capital letter ‘V.’” The application further recites services in International Classes 35 and 43 that are not subject to the instant refusal to register.
- 2 Registration No. 4257614 issued on December 11, 2012.
- 3 We observe nonetheless that the Examining Attorney submitted evidence in the form of screenshots from Internet webpages and copies of third-party registrations to buttress his argument that these goods are closely related and may emanate from a common source.
- 4 Applicant's brief, p. 8.
- 5 We find it unnecessary to rely on the dictionary definition submitted by the Examining Attorney with his brief in our determination herein. Accordingly, his request to take judicial notice of such definition is moot and his arguments based thereupon have not been considered.
- 6 Examining Attorney's May 23, 2014 denial of Applicant's request for reconsideration. The definition also was retrieved from Merriam-webster.com/dictionary.
- 7 Applicant's brief, p. 5.
- 8 *Id.*
- 9 *Id.* at 9.

2014 WL 7496058 (Trademark Tr. & App. Bd.)

747 F.2d 358  
United States Court of Appeals,  
Sixth Circuit.

INDUCT-O-MATIC  
CORPORATION, Plaintiff-Appellant,  
v.  
INDUCTOTHERM CORPORATION,  
Defendant-Appellee.

No. 83-1271. | Argued Feb. 20,  
1984. | Decided Oct. 31, 1984.

Plaintiff brought action seeking declaration that its use of “INDUCT-O-MATIC” did not result in any trademark infringement, unfair competition, or false designation of origin in regard to defendant's registered trademark “INDUCTO.” Defendant counterclaimed contending that usage did result in those violations of law. The United States District Court for the Eastern District of Michigan, James Harvey, J., granted defendant an injunction prohibiting plaintiff's further use of mark, and plaintiff appealed. The Court of Appeals, Wellford, Circuit Judge, held that: (1) district court findings of only slight differences between the marks was not clearly erroneous nor was its finding that plaintiff's term was weak and nondistinctive; (2) finding that plaintiff knew of defendant's earlier mark was clearly erroneous; and (3) since several conclusions on which district court relied in making its decision were clearly erroneous, remand was required.

Remanded.

West Headnotes (12)

[1] **Trademarks**

🔑 Nature of Confusion

**Trademarks**

🔑 Infringement

Under the Lanham Act, test of trademark infringement is likelihood of confusion as to source of origin. Lanham Trade-Mark Act, § 32, 15 U.S.C.A. § 1114.

1 Cases that cite this headnote

[2] **Federal Courts**

🔑 Intellectual property

**Trademarks**

🔑 Similarity; likelihood of confusion

Determination of what is state of affairs regarding each factor considered by lower court in determining whether there was likelihood of confusion, for purposes of determining whether there was violation of the Lanham Act, is a finding of fact reviewed on a clearly erroneous standard, but further determination of likelihood of confusion based on those factors is a legal conclusion. Lanham Trade-Mark Act, § 32, 15 U.S.C.A. § 1114.

2 Cases that cite this headnote

[3] **Trademarks**

🔑 Particular cases

In an action seeking declaration that plaintiff's use of name “INDUCT-O-MATIC” did not result in any trademark infringement, unfair competition, or false designation of origin in regard to defendant's registered trademark “INDUCTO,” finding of district court that the differences in lettering and hyphenating of name were very slight and likely to cause confusion was not clearly erroneous. Lanham Trade-Mark Act, § 32, 15 U.S.C.A. § 1114.

10 Cases that cite this headnote

[4] **Trademarks**

🔑 Particular cases

In action seeking declaration that plaintiff's use of name “INDUCT-O-MATIC” did not result in any trademark infringement, unfair competition, or false designation of origin in regard to defendant's registered trademark “INDUCTO,” district court's finding that the marks were used in similar goods, consisting of induction heating equipment and melting equipment, was not clearly erroneous. Lanham Trade-Mark Act, § 32, 15 U.S.C.A. § 1114.

1 Cases that cite this headnote

**[5] Trademarks**

🔑 [Markets and territories; competition](#)

Direct competition between products is not a prerequisite to protective relief under the Lanham Trade-Mark Act. Lanham Trade-Mark Act, § 32, [15 U.S.C.A. § 1114](#).

[4 Cases that cite this headnote](#)

**[6] Trademarks**

🔑 [Marks protected](#)

In action seeking declaration that plaintiff's use of name "INDUCT-O-MATIC" did not result in any trademark infringement, unfair competition, or false designation of origin in regard to defendant's registered trademark "INDUCTO," district court's finding that plaintiff's term was weak and nondistinctive was not clearly erroneous. Lanham Trade-Mark Act, § 32, [15 U.S.C.A. § 1114](#).

[2 Cases that cite this headnote](#)

**[7] Trademarks**

🔑 [Arbitrary or fanciful terms or marks](#)

In action seeking declaration that plaintiff's use of name "INDUCT-O-MATIC" did not result in any trademark infringement, unfair competition, or false designation of origin in regard to defendant's registered trademark "INDUCTO," district court erred in finding that "INDUCTO" was a "coined" word which implied that it was a fanciful or arbitrary term. Lanham Trade-Mark Act, § 32, [15 U.S.C.A. § 1114](#).

[21 Cases that cite this headnote](#)

**[8] Trademarks**

🔑 [Suggestive terms or marks](#)

Generally, proof of secondary meaning is not required with regard to a suggestive term, for purposes of proving trademark infringement under the Lanham Trade-Mark Act. Lanham Trade-Mark Act, § 32, [15 U.S.C.A. § 1114](#).

[24 Cases that cite this headnote](#)

**[9] Trademarks**

🔑 [Particular cases](#)

**Trademarks**

🔑 [Knowledge, intent, and motive; bad faith](#)

In action seeking declaration that plaintiff's use of name "INDUCT-O-MATIC" did not result in any trademark infringement, unfair competition, or false designation of origin in regard to defendant's registered trademark "INDUCTO," record did not support finding that plaintiff had knowledge of defendant's trademark when plaintiff adopted its name; thus, plaintiff was entitled to use the mark in counties in Michigan where it was the first local user. Lanham Trade-Mark Act, § 32, [15 U.S.C.A. § 1114](#).

[1 Cases that cite this headnote](#)

**[10] Trademarks**

🔑 [Knowledge, intent, and motives; bad faith](#)

**Trademarks**

🔑 [Knowledge, intent, and motive; bad faith](#)

In action seeking declaration that plaintiff's use of name "INDUCT-O-MATIC" did not result in any trademark infringement, unfair competition, or false designation of origin in regard to defendant's registered trademark "INDUCTO," district court erred in concluding that plaintiff could not invoke statute providing a defense for those parties whose use of mark was adopted without knowledge of registrant's prior use and has been continuously used by such party or those in privity with him from a date prior to registration of mark since record did not support finding that plaintiff knew of defendant's earlier mark. Lanham Trade-Mark Act, §§ 32, 33(b)(5), [15 U.S.C.A. §§ 1114, 1115\(b\)\(5\)](#).

[10 Cases that cite this headnote](#)

**[11] Federal Courts**

🔑 [Defective proceedings](#)

In action seeking declaration that plaintiff's use of name "INDUCT-O-MATIC" did not result in any trademark infringement, unfair competition, or false designation of origin in regard to defendant's registered trademark "INDUCTO,"



since several conclusions on which district court relied in making decision were clearly erroneous, remand was required. Lanham Trade-Mark Act, § 32, 15 U.S.C.A. § 1114.

[Cases that cite this headnote](#)

## [12] Trademarks

 [Alphabetical listing](#)

INDUCTO.

[Cases that cite this headnote](#)

## Attorneys and Law Firms

\*360 Michael R. Dinnin (argued), Harness, Dickey & Pierce, Birmingham, Mich., for plaintiff-appellant.

Arthur H. Seidel (argued), Seidel, Gonda, Goldhammer, P.C., Philadelphia, Pa., for defendant-appellee.

Before KENNEDY and WELLFORD, Circuit Judges, and RUBIN, District Judge.\*

## Opinion

WELLFORD, Circuit Judge.

In June 1978, Inductotherm, defendant-appellee, filed a trademark opposition proceeding in the United States Patent Office to protest the grant of a trademark registration to plaintiff-appellant for its mark “INDUCT-O-MATIC” (IOM). The Trademark Examiner, however, already had ruled in May 1978 that the mark “INDUCT-O-MATIC” was entitled to registration over Inductotherm's registered mark, “INDUCTO.”<sup>1</sup> In October 1978, Inductotherm filed suit against IOM in the United States District Court of New Jersey, which dismissed the suit for lack of jurisdiction. IOM then filed an action for declaratory judgment in the United States District Court of Michigan on February 1, 1979, seeking a determination that IOM's use of “INDUCT-O-MATIC” did not result in any trademark infringement, unfair competition, or false designation of origin in regard to Inductotherm's registered trademark, “INDUCTO.” Inductotherm, counterclaiming, contended that such usage did result in these violations of law. IOM appeals from the judgment of the district court granting Inductotherm

an injunction prohibiting IOM's further use of the mark “INDUCT-O-MATIC.”

Inductotherm began repairing and servicing induction heating and melting equipment in 1953 under that name. In 1954, \*361 Inductotherm began using the term “INDUCTO” and the tradename “Inductotherm” on its equipment and since 1957 has been manufacturing and selling this equipment throughout the United States, including the State of Michigan. On July 14, 1964, Inductotherm became the owner of United States Trademark Registration No. 773,193 for the trademark, “INDUCTO.”

IOM, chartered as a Michigan corporation, began doing business under the tradename “Induct-O-Matic” and began using the mark “INDUCT-O-MATIC” on or about January 4, 1961. Prior to 1969, its business consisted primarily of rebuilding and repairing induction equipment; thereafter, it began selling induction heating equipment in various states under its tradename and mark.

[1] [2] The district court first considered and granted relief on Inductotherm's counterclaim of trademark infringement by IOM in violation of the Lanham Act, 15 U.S.C. § 1114. Under the Act, the test of trademark infringement is “likelihood of confusion” as to the source of origin. *See, e.g., WSM, Inc. v. Tennessee Sales Co.*, 709 F.2d 1084, 1086 (6th Cir.1983). This Court has adopted a two-level test for reviewing lower court findings of likelihood of confusion:

[T]he determination of what is the state of affairs regarding each factor ... [considered by the lower court in determining whether there is a likelihood of confusion] is a finding of fact reviewed on the clearly erroneous standard, but the further determination of the likelihood of confusion based on those factors is a legal conclusion.

*Frisch's Restaurants, Inc. v. Elby's Big Boy*, 670 F.2d 642, 651 (6th Cir.), cert. denied 459 U.S. 916, 103 S.Ct. 231, 74 L.Ed.2d 182 (1982) (quoting *Alpha Industries, Inc. v. Alpha Steel Tube & Shapes, Inc.*, 616 F.2d 440, 443-44 (9th Cir.1980)).

In reaching its holding that there was a likelihood of confusion between Inductotherm's trademark, “INDUCTO,” and IOM's tradename and mark, “INDUCT-O-MATIC,” the district court considered the following list of factors, which are in

substantial conformity with those relevant factors on this issue set forth by this Circuit in *Frisch's Restaurant*, 670 F.2d at 648:

- 1) the degree of similarity between the marks in appearance, sound, and connotation;
- 2) the similarity of goods or services for which the marks are used;
- 3) the area and manner of concurrent use;
- 4) the strength of the defendant's mark;
- 5) the sophistication of the purchasers of the relevant goods;
- 6) plaintiff's intent;
- 7) and any instances of actual confusion.

[3] The district court found a high degree of similarity between “INDUCTO” and “INDUCT-O-MATIC,” noting that “a sophisticated witness and possible purchaser ... indicated that ‘INDUCT-O-MATIC’ would connote a product produced by [Inductotherm].” The court also found that “the differences in lettering and hyphenating are very slight, and likely to cause confusion.”

This finding is not clearly erroneous.

IOM contends that the differences in spelling, number of syllables, the use of hyphens, and sound and visual appearance establish little likelihood of confusion between the marks at issue. We agree with the district court that these differences are slight and unlikely to prevent confusion. The use of hyphens distinguishes between the two marks only on a visual level since this difference is absent when the words are spoken. Other distinguishing factors cited by IOM depend solely on the addition of “MATIC” to its trademark. We agree with the district court that this is a weak and nondistinctive term. The latter aspect of our holding is discussed more fully in our review of the district court's ruling in regard to the strength of Inductotherm's trademark.

[4] The District court's finding that the marks in question are used on similar goods also is not clearly erroneous. The \*362 district court correctly noted that IOM sells primarily induction heating equipment, whereas Inductotherm sells primarily induction melting equipment. Since most of Inductotherm's equipment can also be used for induction

heating, the effect of the differences in the equipment is greatly lessened. Moreover, Inductotherm does sell some induction *heating* equipment and also performs virtually all of the services offered by IOM.

[5] IOM's argument that it does not directly compete with Inductotherm is belied by its failure to contest the district court's finding in regard to concurrent use that “both parties sell in the same states, have some identical customers, and have the same competitors.” Moreover, the similarity of goods and services offered by IOM and Inductotherm indicates the probability of direct competition. In any event, “direct competition between the products is not a prerequisite to protective relief.” *Continental Motors Corp. v. Continental Aviation Corp.*, 375 F.2d 857, 861 (5th Cir.1967).

[6] In regard to the fourth factor, the district court found that “INDUCTO” was a strong mark, “distinctive in its tendency to identify the goods sold under that mark as emanating from ... [Inductotherm].” In reaching this conclusion, the district court found that “INDUCTO” was a coined word with no dictionary or technical meaning, under which Inductotherm has had a large volume of sales and has established an excellent reputation. In contrast, it found IOM's mark to be “weak and undistinctive,” noting that “[t]he ‘matic’ suffix indicates automatic, and is widely used in trademarks for this purpose.”

[7] IOM argues that the district court erred in failing to recognize that “induct” is a common English word, meaning to lead in, introduce or induce, that is suggestive of induction, and refers to a number of trademark registrations incorporating the word “induct” by third parties engaged in the electromagnetic induction field. We agree with the district court that these registrations do not, on the whole,<sup>2</sup> dilute any distinctive nature “INDUCTO” may have since these registrations do not involve products that compete with IOM and Inductotherm. *See, e.g., Price-Pfister Brass Mfg. Co. v. Milwaukee Faucets, Inc.*, 311 F.2d 817, 818 (C.C.P.A.1963). We find, however, that the district court was in error in its finding that “INDUCTO” was a “coined” word, which implies that it is an arbitrary or fanciful term. As noted in *Miller Brewing Co. v. G. Heileman Brewing Co.*, 561 F.2d 75, 79 (7th Cir.1977), *cert. denied* 434 U.S. 1025, 98 S.Ct. 751, 54 L.Ed.2d 772 (1978) (citations omitted):

A term for which trademark protection is claimed will fit somewhere in the spectrum which ranges through (1)

generic or common descriptive and (2) merely descriptive to (3) suggestive and (4) arbitrary or fanciful.

A generic or common descriptive term is one which is commonly used as the name or description of a kind of goods. It cannot become a trademark under any circumstances.

A merely descriptive term specifically describes a characteristic or ingredient of an article. It can, by acquiring a secondary meaning, *i.e.*, becoming “distinctive of the applicant’s goods” ..., become a valid trademark.

A suggestive term suggests rather than describes an ingredient or characteristic of the goods and requires the observer or listener to use imagination and perception to determine the nature of the goods. Such a term can be protected \*363 without proof of a secondary meaning.

An arbitrary or fanciful term enjoys the same full protection as a suggestive term but is far enough removed from the merely descriptive not to be vulnerable to possible attack as being merely descriptive rather than suggestive.

This Circuit in *Solventol Chemical Products v. Langfield*, 134 F.2d 899 (6th Cir.), *cert. denied* 320 U.S. 743, 64 S.Ct. 44, 88 L.Ed. 441 (1943), clearly held that trademarks at issue must be broken down into their component parts in order to determine their appropriate class in the trademark spectrum. As between “Sonventol” and “Solvite,” the marks at issue in *Langfield*, the court ruled that the component common to each term was descriptive:

Neither of the marks in question is of that class known as arbitrary or fanciful. Each falls quite clearly into the class of suggestive marks characteristic of the product exemplified. *Morgan’s Sons Co. v. Ward*, 7 Cir., 152 F. 690, 12 L.R.A., N.S., 729. Such trade-marks may be valid but as to them the field is open to other traders to employ equally suggestive marks provided only that

they be not deceptively similar. *Ostermoor & Co. v. Rose Spring & Mattress Co.*, 55 App.D.C. 307, 5 F.2d 268; *Citrus Soap Company v. Royal Lemon Products Company*, 8 Cir., 2 F.2d 972. The word “solvent” is purely descriptive of any cleaning compound whether semi-solid or liquid and “Sol” has been used so long by businesses as part of a trade-mark name for cleaning compounds that neither use of the prefix “Solvent” nor the prefix “Sol” may be so exclusively appropriated by one manufacturer or tradesman as to wholly deny its use in any manner by others. The idea sought to be conveyed to the mind of the purchaser by the respective trade-marks of the parties to these proceedings is that each is selling a solvent for use in cleaning, and while the prefix “Sol” or “Solvent” is common to both marks, each is but descriptive of the product indicated, and being of common right, neither party can claim the exclusive use of either, alone or as the dominating element of a compound word.....

*Id.* at 902–03.

In the instant case, analysis of the component parts of the marks at issue clearly indicates that “INDUCTO” is not an arbitrary or fanciful term. The district court was in error to the extent that it implied otherwise in ruling that “INDUCTO” had no dictionary or technical meaning.

The dominant common component in each mark at issue is “induct.” As noted earlier, this word has a known meaning, to lead, introduce or induce. We agree with IOM that this term is a suggestive one in that it suggests to the imaginative that each company is engaged in the electromagnetic induction field, as opposed to describing a particular product for a particular use, as in *Langfield*.

The court in *Langfield* further directed that “descriptive letters, syllables or phrases” be eliminated in determining whether two trademarks are deceptively similar. 134 F.2d at 903. In applying this test to the case before it, the court found:

The suffixes “vite” [in Solvite] and “tol” [in Solventol] distinguish one combination from the other and give an identifying character to the trade designation which makes it unlikely that one trade-mark could, with the exercise of ordinary care, be mistaken for or be confused with the other. They look unlike, are spelled differently and are phonetically dissimilar.

*Id.* at 903.

In the instant case, “o” is a descriptive vowel common to “INDUCTO” and “INDUCT-O-MATIC” and must therefore be deleted under our ruling in *Langfield*. Thus, only the term “matic” distinguishes the two marks. “Matic” is clearly a descriptive phrase, and, as found by the district court, indicates automation. As such, it also requires deletion. Accordingly, unlike the situation in *Langfield*, there is no “identifying character to the trade designations” \*364 of “INDUCTO” and “INDUCT-O-MATIC,” other than the suggestive term common to both, “induct,” that makes it unlikely that one trademark will be mistaken for another.<sup>3</sup>

Application of the *Langfield* test leads to the conclusion that “INDUCT-O-MATIC” is deceptively similar to “INDUCTO.” Our discussion and application of this test with regard to the fourth factor of trademark strength are in response to defendant’s argument that “INDUCTO,” because it contains “induct,” is a weak trademark, and indicate the district court’s error in determining that “INDUCTO” was a strong mark because it had no dictionary or technical meaning.

[8] Generally, proof of secondary meaning is not required with regard to a suggestive term, *Miller*, 561 F.2d at 79, nor by the owner of a registered trademark, *Roto-Rooter Corp. v. O’Neal*, 513 F.2d 44, 46–47 (5th Cir.1975). We note, however, that the other bases for the district court’s finding that “INDUCTO” was a strong mark, the heavy advertising by Inductotherm employing its trademark over a number of years and the well established reputation of Inductotherm as a leader in the induction field, is supported by the record, but this is insufficient to support a conclusion of a strong mark under all the circumstances.

We also point out that at least one court has indicated that if a mark has become incontestable under 15 U.S.C. § 1115(a),<sup>4</sup> its lack of distinctiveness cannot be raised in litigation. See *Union Carbide Corp. v. Ever-Ready, Inc.*, 531 F.2d 366, 377, 381 (7th Cir.), cert. denied, 429 U.S. 830, 97 S.Ct. 91, 50 L.Ed.2d 94 (1976). But cf. *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 718 F.2d 327, 331 (9th Cir.1983) (“The law in this circuit ... is different [from *Union Carbide, supra*]. [A] registrant [cannot] use the incontestable status of its mark ... offensively, as a sword to enjoin another’s use.”), cert. granted to resolve conflict, 465 U.S. 1078, 104 S.Ct. 1438, 79 L.Ed.2d 760 (1984). Finally, we note that:

[W]hether a mark is regarded as “strong” or “weak”, “original, arbitrary, fanciful” or “generic, descriptive, geographic” is but one of the elements to be considered in determining whether confusion is likely to result.

*Continental Motors Corp.*, 375 F.2d at 861.

In regard to the fifth factor, the court found that the purchasing of a “large order is done by sophisticated buyers” who “would not be readily confused,” but that those persons handling the purchase “of components and parts are not as sophisticated and thus would likely be confused.” It has been observed that the “expertise of purchasers does not always assure the absence of confusion.” *Communications Satellite Corp. v. Comcet, Inc.*, 429 F.2d 1245, 1252 (4th Cir.), cert. denied 400 U.S. 942, 91 S.Ct. 240, 27 L.Ed.2d 245 (1970). Further, as noted in *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 264 (C.C.P.A.1962):

[I]n most instances technicians would use the products of either party and they are a discriminating group of people but that does not eliminate the likelihood of purchaser confusion here. Being skilled in their own art does not necessarily preclude their mistaking one trademark for another when the marks are as similar \*365 as those here in issue, and cover merchandise in the same general field.

We have some question as to whether this factor was adequately analyzed by the district court, but in finding that the marks at issue are similar and cover competing goods, we also find under the foregoing authority that the district court was not clearly erroneous in concluding that the factor of

purchaser sophistication “also militates against [IOM].” This is a close question and not a determinative factor in this case.

In regard to the important sixth factor, the district court found that IOM’s “intent was not clear,” but that IOM knew of Inductotherm’s trademark when IOM adopted its name. The court concluded:

It is the law [*see, e.g., USM, Inc.*, 709 F.2d at 1087 n. 1] that a jr. user is charged with the obligation to avoid the adoption of a trademark which might be confused with a sr. mark .... Where plaintiff knew of the sr. mark and nevertheless proceeded to adopt a similar mark, he assumes a risk, and all doubt should be resolved in favor of the senior user.

IOM argues initially that the district court made no finding that it had knowledge of Inductotherm’s trademark. The district court in the following Finding of Fact referred to IOM’s knowledge of Inductotherm rather than its knowledge of “INDUCTO”:

84. Given the sales volume of defendant, its advertising and reputation, and also considering the contradictory testimony surrounding the selection of the name Induct-O-Matic, the court finds that D. DeArment [President of IOM] *knew of Inductotherm* when the name Induct-O-Matic was selected.

(Emphasis added).

[9] In its Conclusions of Law, however, the court twice referred to IOM’s knowledge of the *trademark*, “INDUCTO,” making reference to Finding of Fact ## 84. We conclude, however, that the record does not support a finding that IOM had knowledge of Inductotherm’s trademark when IOM adopted its name.

The district court did not make a factual finding that IOM knew of the “INDUCTO” mark, only that Mr. DeArment, IOM’s president, knew of Inductotherm. Even if we assume that its failure to include knowledge of “INDUCTO” in its factual finding was merely inadvertent, since it did conclude as a matter of law that IOM knew of Inductotherm’s trademark

when it adopted its name, there is no sufficient basis for such a finding. The district court bases its finding first on the sales volume of defendant-appellee. Inductotherm began selling “INDUCTO” trademark equipment in 1957 and sold such marked equipment in Michigan beginning in 1958. Its national sales volume in 1959 was only \$1,093,479 and in 1960, \$1,616,988. Michigan sales were 8% to 10% of the total, or less than \$160,000 in the larger sales volume year. Those two years are critical since IOM adopted its name before its incorporation on January 4, 1961. The district judge also concluded, inconsistently, that Inductotherm did not learn of IOM until 1975, even though the latter had over one million dollars in annual sales by 1970, primarily in Michigan.

To support its finding and conclusion of knowledge, the district court also relied on advertising. It made a finding that Inductotherm began advertising in *Metal Progress*, a trade journal, in 1960, and that Mr. DeArment had subscribed to *Metal Progress* for twenty years. However, the earliest *Metal Progress* advertisement in evidence was in the December 1960 issue which came out in 1961. Thus, it provides no basis for finding Mr. DeArment knew of Inductotherm or “INDUCTO” before January 4, 1961. Inductotherm’s total advertising budget for 1958 was only \$17,900; in 1959, \$13,800; and in 1960, \$20,000. Those sums would hardly provide a basis for an assumption or a reasonable inference of knowledge of Inductotherm in 1960.

Finally, the district court relied on the contradictory testimony surrounding the selection of the name “INDUCT-O-MATIC.” Three witnesses testified about the \*366 selection of the corporate name prior to incorporation. All denied they had heard of Inductotherm or its mark “INDUCTO.” The three did not agree on all the persons present at the meeting when the name was adopted and there was some disagreement as to the specific person who suggested that they adopt “INDUCT-O-MATIC.” The meeting had occurred more than twenty years before the trial. It was for the trial judge to weigh their credibility but it was undisputed that the corporate name was registered on January 4, 1961, and so must have been adopted *before* that date. It was immaterial which of those present when the name was adopted suggested the name, since there was simply no evidence that any of them knew of Inductotherm or its mark “INDUCTO.” Merely because there was some disagreement about a meeting twenty years before does not provide a basis for finding that one of those present knew of Inductotherm and, more importantly, of “INDUCTO.”

The district court's finding that Mr. DeArment knew of the trademark "INDUCTO" in January 1961 is therefore clearly erroneous. IOM has established its good faith usage and is entitled to use the mark "INDUCT-O-MATIC" in Macomb County, Michigan and other Michigan counties where it was first local user.

[10] We are also disposed to agree with IOM's argument that the district court employed an incorrect *rationale* in finding that IOM was not entitled to the "good faith prior use" defense, 15 U.S.C. § 1115(b)(5), to the Act's incontestability provision, 15 U.S.C. § 1065.

Section 1065 provides:

The right of the registrant to use [its] registered mark in commerce for the goods or services on or in connection with which such registered mark has been in continuous use for five consecutive years subsequent to the date of such registration and is still in use in commerce, is incontestable.

Section 1115(b)(5) provides (emphasis added):

(b) If the right to use the registered mark has become incontestable under section 1065 of this title, the registration shall be conclusive evidence of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the affidavit filed under the provisions of said section 1065 subject to any conditions or limitations stated therein ... except when one of the following defenses or defects is established:

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(5) That the mark whose use by a party is charged as an infringement was *adopted without knowledge of the registrant's prior use* and has been continuously used by such party or those in privity with him from a date prior to registration of the mark under this chapter or publication of the registered mark under subsection (c) of section 1062 of this title: Provided, however, that this defense or defect shall apply only for the area in which such continuous prior use is proved....

In *Old Dutch Foods, Inc. v. Dan Dee Pretzel & Potato Chip Co.*, 477 F.2d 150 (6th Cir.1973), this Court held that the adoption and use of a mark in certain areas by one whose use antedated the registration of a similar mark by another but post-dated the registrant's use in other areas has exclusive rights under 15 U.S.C. § 1115(b)(3) to use its mark in the area it has preempted through use of its mark, *when that mark was adopted without knowledge of the prior use in other areas by the registrant*. This defense seems available to IOM because, as earlier determined, the district court was clearly erroneous in finding that IOM had knowledge of Inductotherm's mark when it incorporated in Michigan and began employing its mark. Accordingly, the district court's ultimate conclusion that IOM could not invoke the § 1115(b)(5) defense was not correct.

In regard to the seventh factor, the district court found:

[T]here was no evidence of actual confusion. Although this is a significant \*367 consideration, this finding is far from determinative, since it is not clear how such confusion would actually come to light.

[11] IOM concedes, as it must, that "actual confusion need not be established in order to find trademark infringement," but argues that "the absence of any actual confusion over more than 21 years is strong evidence that there is no likelihood of confusion." We find it significant that the Trademark Examiner initially refused to register IOM's mark in 1978 because of likelihood of confusion between IOM's mark and Inductotherm's previously registered mark. *See supra* note 1. Since we have found that several conclusions on which the district court relied in making a decision are clearly erroneous, we conclude albeit reluctantly that we should remand this controversy to the district court for further consideration in light of these holdings.

The district court also found that IOM violated 15 U.S.C. § 1125(a) pertaining to the false designation of origin counterclaim raised by IOM, and that IOM violated Michigan common law relating to unfair competition. Because we have concluded that we must remand this controversy for the reasons discussed, we also remand for reconsideration the district court's judgment for Inductotherm on these counterclaims.

The final argument raised by IOM, that Inductotherm is barred from injunctive relief by laches, will need to be reconsidered on remand as well. This court noted in *United States v. Weintraub*, 613 F.2d 612, 619 (6th Cir.1979), cert. denied 447 U.S. 905, 100 S.Ct. 2987, 64 L.Ed.2d 854 (1980) (quoting *Costello v. United States*, 365 U.S. 265, 282, 81 S.Ct. 534, 543, 5 L.Ed.2d 551 (1961)):

“Laches requires proof of (1) lack of diligence by the party against whom the defense is asserted, and (2) prejudice to the party asserting the defense.” ... [L]aches is an equitable defense and ... it can certainly be raised only by one who comes into equity with clean hands.

The Supreme Court in *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 419, 36 S.Ct. 357, 362, 60 L.Ed. 713 (1916), further noted:

As to laches and acquiescence,  
it has been repeatedly held, in

[trademark] cases where defendants acted fraudulently or with knowledge of plaintiffs' rights, that relief by injunction would be accorded ....

Since we have held that the district court was in error in ruling that IOM had knowledge of Inductotherm's use of “INDUCTO” when it adopted its mark, this argument may be found to have merit.

Accordingly, we remand this controversy to the district court for further proceedings consistent with this opinion.

#### All Citations

747 F.2d 358, 224 U.S.P.Q. 119

#### Footnotes

- \* The Honorable Carl B. Rubin, Chief Judge, U.S. District Court for the Southern District of Ohio, sitting by designation.
- 1 The Trademark Examiner initially rejected IOM's registration application on the ground that the mark “INDUCT-O-MATIC” was confusingly similar to Inductotherm's “INDUCTO” trademark. The application was approved on IOM's assertion by affidavit that its goods did not compete with those sold by Inductotherm.
- 2 One third party registration, “Inductron,” by TOCCO Company does appear to relate to products that are in competition with those of IOM, but IOM produced no evidence that the Inductron products were well promoted or recognized by consumers. See *Scarves By Vera, Inc. v. Todo Imports, Ltd.*, 544 F.2d 1167, 1173–74 (2d Cir.1976).
- 3 A situation similar to the instant one was presented in *Price-Pfister*, 311 F.2d at 818, in which the court made the following ruling in regard to the marks, “ADJUSTO” and “ADJUSTA-FIT”:  
With respect to appearance, meaning, and sound, the dominant portions of the trademarks differ from each other by the substitution in the suffix portions of an “A” in appellant's mark for the “O” in appellee's mark and the addition of the descriptive term “FIT” to appellant's mark. We think these differences do not obviate the likelihood of confusion, mistake or deception of purchasers arising from appellant's use of its mark on its goods. The addition of the term “FIT” to appellant's mark creates an impression that it might well be related to appellee's “ADJUSTO” family of goods.
- 4 This statute contains a number of defenses to incontestability, one of which is discussed, *infra*, wherein we conclude that Inductotherm's trademark has become incontestable.