

ESTTA Tracking number: **ESTTA1227826**

Filing date: **08/09/2022**

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

**Notice of Opposition**

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

**Opposer information**

Name	Goya Foods, Inc.
Granted to date of previous extension	08/10/2022
Address	350 COUNTY ROAD JERSEY CITY, NJ 07307 UNITED STATES

Attorney information	A. JOHN P. MANCINI MAYER BROWN LLP P.O. BOX 2828 CHICAGO, IL 07307 UNITED STATES Primary email: ipdocket@mayerbrown.com Secondary email(s): jmancini@mayerbrown.com, acarroll@mayerbrown.com, vruizmartinez@mayerbrown.com (212) 506-2295
Docket no.	21684902

**Applicant information**

Application no.	90777590	Publication date	04/12/2022
Opposition filing date	08/09/2022	Opposition period ends	08/10/2022
Applicant	Gaya, Norma 8302 WINECUP HILL SAN ANTONIO, TX 78256 UNITED STATES		

**Goods/services affected by opposition**

Class 030. First Use: Jan 1, 2016 First Use In Commerce: Jan 1, 2016  
All goods and services in the class are opposed, namely: Vanilla beans, vanilla extract, vanillapaste, vanilla powder, processed vanilla seeds for use as flavorings, vanilla flavorings for food or beverages


**Grounds for opposition**

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)

**Marks cited by opposer as basis for opposition**

U.S. registration no.	764033	Application date	01/15/1963
-----------------------	--------	------------------	------------

Register	Principal		
Registration date	01/28/1964	Foreign priority date	NONE
Word mark	GOYA		
Design mark			
Description of mark	NONE		
Goods/services	Class U046 (International Class 029, 030). First use: First Use: Aug 1939 First Use In Commerce: Aug 1939 Coffee, and Edible Olive Oil		

U.S. registration no.	962193	Application date	07/14/1972
Register	Principal		
Registration date	06/26/1973	Foreign priority date	NONE
Word mark	GOYA		
Design mark			
Description of mark	NONE		
Goods/services	Class U046 (International Class 001, 005, 029, 030, 031, 032). First use: First Use: Aug 1939 First Use In Commerce: Aug 1939 BEEF STEW, VIENNA SAUSAGE, CANNED FRUITJUICES, CEREAL, CORN MEAL, HOMINY, CRACKERS, EDIBLE OILS, CORN OIL, OLIVE OIL, FRUIT SYRUP, [ SESAME SEED SYRUP, ]GRAPEJUICE, JELLIES AND PRE-SERVES, MAYONNAISE, OLIVES, RICE, SOUPS, SPAGHETTI, SPICES, SALT, PEPPER, OREGANO, VINEGAR, FLAVORING EXTRACTS, MEAT SAUCE, SWEET CHOCOLATE, TOMATO SAUCE, CHEESE, CREAM OF COCONUT, CANNED VEGETABLES, PAPAYA NECTAR, PEACH NECTAR, GUAVA NECTAR, SPAGHETTI AND MEAT BALLS, MEAT SAUCE AND CON-DIMENT, BREADFUIT; PREPARED SEA FOOD-NAMELY, SHRIMP, SPICED SHRIMP, AND [ LOBSTER GUMBO, ]CANNED FISH, PASTELES, PUERTO RICAN SANCOCHO, FRUIT COCKTAIL, PREPARED COCONUT,AND FLAN CUSTARD		


U.S. registration no.	2502127	Application date	04/14/2000
Register	Principal		
Registration date	10/30/2001	Foreign priority date	NONE
Word mark	GOYA		
Design mark			


Description of mark	NONE
Goods/services	Class 029. First use: First Use: Aug 1939 First Use In Commerce: Aug 1939 Processed fruits and vegetables; dried fruits and vegetables; meats; seafood and fish; [ applesauce and cranberry sauce; ] processed olives; dried corn husks; snack foods, namely, plantain chips, potato chips, yucca chips and pork rinds; processed nuts and processed edible seeds; jams, jellies and fruit preserves; [ pickles; ] processed garlic, processed artichokes; processed pimentos; tomato paste; processed hot peppers; soups; meat extracts, and bouillon; edible oils and fats; prepared entrees consisting primarily of meat, poultry, fish or vegetables;milk; cheese; and lard

U.S. registration no.	3570054	Application date	08/05/2008
Register	Principal		
Registration date	02/03/2009	Foreign priority date	NONE
Word mark	GOYA		
Design mark			
Description of mark	NONE		
Goods/services	<p>Class 029. First use: First Use: Aug 1939 First Use In Commerce: Aug 1939 Applesauce; Artichoke paste; Bouillon; Cheese; Cheese food; Chili; Cranberry sauce; Dairy products excluding ice cream,ice milk and frozen yogurt; Dried fruitand vegetables; Dried fruit mixes; Dried fruits; Dried meat; Edible fats; Edible oils; Fish; Fish croquettes; Frozen fruits; Frozen vegetables; Fruit paste; Fruit preserves; Fruit-based snack food; Instant or pre-cooked soup; Jams; Lard; Meat; Meat extracts; Milk; Olive oil; Pickled vegetables; Pork; Pork rinds; Poultry; Preserved fruits; Processed artichokes; Processed coconut; Processed meat; Processed olives; Processed vegetables; Seafood; Snack mix consisting primarily of processed fruits, processed nuts and/or raisins; Soups; Vegetable chips; Vegetable oils; Vegetable-based snack foods; vegetable, fish, and meat croquettes</p> <p>Class 030. First use: First Use: Aug 1939 First Use In Commerce: Aug 1939 Alimentary paste; Bakery desserts; Bakery goods; Barbecue sauce; Burritos; Candy; Capers; Chocolate; Chocolates and chocolate based ready to eat candies and snacks; Cocoa; Coffee; Corn fritters; Custards; Dumplings; Empanadas; Enchiladas; Fajitas; Fish dumplings; Flour; Food seasonings; Frozen confections; Grain-basedfood beverages; Grain-based snack foods; Hominy; Honey; Hot sauce; Marinades; Mixes for bakery goods; [ Mixes for making baking batters; ] Mixes for making batter for hushpuppies; Mixes for making batters for fried foods; Noodles; Pastries; Pepper; Picante sauce; Rice; Rice-based snack foods; Salsa; Sauces; Seasoned coating for meat, fish, poultry; Seasonedcoating mixtures for foods; Seasonings;Snack cakes; Spices; Taco chips; Tacos;Tamales; Tapioca; Tomato sauce; Tortilla chips; Tortillas; Vinegar; Wine vinegar</p> <p>Class 032. First use: First Use: Apr 6, 1959 First Use In Commerce: Apr 6, 1959 Fruit nectars; Fruits drinks and fruit juices; Non-alcoholic malt beverage; Soft drinks; Syrups for making soft drinks;Vegetable juice</p>		

U.S. registration no.	1354559	Application date	06/18/1984
Register	Principal		
Registration date	08/13/1985	Foreign priority	NONE

		date	
Word mark	GOYA		
Design mark			
Description of mark	NONE		
Goods/services	Class 032. First use: First Use: Apr 6, 1959 First Use In Commerce: Apr 6, 1959 MALTA, NAMELY A NON-ALCOHOLIC MALT BEVERAGES		

U.S. registration no.	3825092	Application date	01/04/2010
Register	Principal		
Registration date	07/27/2010	Foreign priority date	NONE
Word mark	GOYA		
Design mark			
Description of mark	NONE		
Goods/services	Class 035. First use: First Use: Oct 7, 2005 First Use In Commerce: Oct 7, 2005 Computerized on-line retail store services in the field of foods and beverages;Retail grocery stores; Retail store services featuring foods and beverages		

U.S. registration no.	4884552	Application date	04/01/2015
Register	Principal		
Registration date	01/12/2016	Foreign priority date	NONE
Word mark	GOYA		
Design mark			
Description of mark	NONE		
Goods/services	Class 035. First use: First Use: Apr 1960 First Use In Commerce: Apr 1960		

	<p>Distributorship services in the field of foods and beverages; Wholesale food distributorship services</p> <p>Class 039. First use: First Use: Aug 1939 First Use In Commerce: Aug 1939</p> <p>Delivery of goods; Distribution services, namely, delivery of foods and beverages; Packing, crating and warehousing services; Storage and delivery of goods; Transport and delivery of goods; Warehousing services; Warehousing services, namely, storage, distribution, pick-up, packing, and shipping of foods and beverages</p>
--	---

Attachments	<p>72429883#TMSN.png( bytes )</p> <p>77904649#TMSN.png( bytes )</p> <p>86584487#TMSN.png( bytes )</p> <p>NOO for GAYA in Class 30.pdf(300366 bytes )</p>
-------------	--

Signature	/amyecarroll/
Name	Amy E. Carroll
Date	08/09/2022

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

In re Serial No. 90/777,590  
Mark: GAYA  
Published: April 12, 2022

Goya Foods, Inc.,	)	
Opposer,	)	
v.	)	Opposition No. _____
Norma Gaya,	)	
Applicant.	)	
	)	

**NOTICE OF OPPOSITION**

Goya Foods, Inc. (hereinafter, “Opposer”) believes that it will be damaged by the registration of the mark GAYA (hereinafter, the “GAYA Mark”) that is the subject of trademark application Serial No. 90/777,590 (hereinafter, the “GAYA Application”), which was filed with the United States Patent and Trademark Office (“USPTO”) on June 16, 2021, by applicant Norma Gaya (hereinafter, “Applicant”) in connection with “vanilla beans, vanilla extract, vanilla paste, vanilla powder, processed vanilla seeds for use as flavorings, vanilla flavorings for food or beverages” in International Class 30 (hereinafter, “Applicant’s Goods”). Opposer hereby opposes the GAYA Application.

As grounds for the Opposition, it is alleged that:

1. Opposer is a corporation organized under the laws of Delaware, with a principal place of business at 350 County Road, Jersey City, New Jersey 07307. Opposer is a leading and premier source for authentic Latino cuisine and has over the course of more than eighty years attained global notoriety for providing high-quality food and beverage products.

2. Opposer has long-standing use of the mark GOYA and marks that primarily consist of GOYA (collectively, the “GOYA Marks”) in the United States in connection with a wide variety of food and beverage products, including vanilla-flavored confectioneries and flavoring extracts, among other related goods, and has continuously advertised and promoted certain of the GOYA Marks in connection with such foodstuff for over eighty years.

3. As a result of the use, promotion, and advertising of the inherently distinctive GOYA Marks, these marks have become well known to the trade and to the general consuming public in the United States, and have accordingly acquired significant goodwill and fame. The GOYA Marks identify and distinguish Opposer’s goods and services from the goods and services of others, and identify the source and origin thereof to both the trade and the public.

4. Opposer owns numerous trademark registrations for the GOYA Marks, including but not limited to registrations covering a variety of food, beverages, flavoring extracts, bakery goods, and; syrups for making soft drinks similar to those identified as Applicant’s Goods. The details of some of these registrations are as follows:<sup>1</sup>

<b>Mark</b>	<b>Reg. No.</b>	<b>Selected Goods and Services</b>	<b>Reg. Date</b>
GOYA*	764,033	<b>IC 29 &amp; 30:</b> “coffee, and edible olive oil”	January 28, 1964
GOYA*	962,193	<b>IC 29, 30 &amp; 32:</b> “beef stew, Vienna sausage, canned fruit juices, cereal, corn meal, hominy, crackers, edible oils, corn oil, olive oil, fruit syrup, grape juice, jellies and preserves, mayonnaise, olives, rice, soups, spaghetti, spices, salt, pepper, oregano, vinegar, flavoring extracts, meat sauce, sweet chocolate, tomato sauce, cheese, cream of coconut, canned vegetables, papaya nectar, peach nectar, guava nectar, spaghetti and meat balls, meat sauce and condiment, breadfruit; prepared sea food-namely, shrimp, spiced shrimp, and canned fish, pasteles, Puerto Rican sancocho, fruit cocktail, prepared coconut, and flan custard”	June 26, 1973

<sup>1</sup> An asterisk (\*) denotes that the registration is incontestable pursuant to 15 U.S.C. §1065.

Mark	Reg. No.	Selected Goods and Services	Reg. Date
GOYA*	2,502,127	<p><b>IC 29:</b> “processed fruits and vegetables; dried fruits and vegetables; meats; seafood and fish; applesauce and cranberry sauce; processed olives; dried corn husks; snack foods, namely, plantain chips, potato chips, yucca chips and pork rinds; processed nuts and processed edible seeds; jams, jellies and fruit preserves; pickles; processed garlic, processed artichokes; processed pimentos; tomato paste; processed hot peppers; soups; meat extracts, and bouillon; edible oils and fats; prepared entrees consisting primarily of meat, poultry, fish or vegetables; milk; cheese; and lard”</p>	October 30, 2001
GOYA*	3,570,054	<p><b>IC 29:</b> “applesauce; artichoke paste; bouillon; cheese; cheese food; chili; cranberry sauce; dairy products excluding ice cream, ice milk and frozen yogurt; dried fruit and vegetables; dried fruit mixes; dried fruits; dried meat; edible fats; edible oils; fish; fish croquettes; frozen fruits; frozen vegetables; fruit paste; fruit preserves; fruit-based snack food; instant or pre-cooked soup; jams; lard; meat; meat extracts; milk; olive oil; pickled vegetables; pork; pork rinds; poultry; preserved fruits; processed artichokes; processed coconut; processed meat; processed olives; processed vegetables; seafood; snack mix consisting primarily of processed fruits, processed nuts and/or raisins; soups; vegetable chips; vegetable oils; vegetable-based snack foods; vegetable, fish, and meat croquettes”</p> <p><b>IC 30:</b> “alimentary paste; bakery desserts; bakery goods; barbecue sauce; burritos; candy; capers; chocolate; chocolates and chocolate based ready to eat candies and snacks; cocoa; coffee; corn fritters; custards; dumplings; empanadas; enchiladas; fajitas; fish dumplings; flour; food seasonings; frozen confections; grain-based food beverages; grain-based snack foods; hominy; honey; hot sauce; marinades; mixes for bakery goods; mixes for making batter for hushpuppies; mixes for making batters for fried foods; noodles; pastries; pepper; picante sauce; rice; rice-based snack foods; salsa; sauces; seasoned coating for meat, fish, poultry; seasoned coating mixtures for foods; seasonings; snack cakes; spices; taco chips; tacos; tamales; tapioca; tomato sauce; tortilla chips; tortillas; vinegar; wine vinegar”</p> <p><b>IC 32:</b> “fruit nectars; fruits drinks and fruit juices; non-alcoholic malt beverage; soft drinks; syrups for making soft drinks; vegetable juice”</p>	February 3, 2009



<b>Mark</b>	<b>Reg. No.</b>	<b>Selected Goods and Services</b>	<b>Reg. Date</b>
GOYA*	1,354,559	<b>IC 32:</b> “malta, namely a non-alcoholic malt beverages”	August 13, 1985
GOYA*	3,825,092	<b>IC 35:</b> “computerized on-line retail store services in the field of foods and beverages; retail grocery stores; retail store services featuring foods and beverages”	July 27, 2010
GOYA*	4,884,552	<b>IC 35:</b> “distributorship services in the field of foods and beverages; Wholesale food distributorship services”  <b>IC 39:</b> “delivery of goods; distribution services, namely, delivery of foods and beverages; packing, crating and warehousing services; Storage and delivery of goods; transport and delivery of goods; warehousing services; warehousing services, namely, storage, distribution, pick-up, packing, and shipping of foods and beverages”	January 12, 2016

5. The foregoing registrations are valid and subsisting and the marks reflected therein have been used by Opposer in interstate commerce since a time prior to the filing date of the GAYA Application. Moreover, the GOYA Marks have been used by Opposer prior to any use of the GAYA Mark by Applicant.

6. The federal registrations identified above provided, at the very least, constructive notice to Applicant of Opposer’s rights in and to the GOYA Marks. Given Goya’s longstanding and widespread use of the famous GOYA Marks, it is likely that Applicant had knowledge of Goya’s senior rights at the time of filing of the GAYA Application.

7. Despite Opposer’s prior use and registration of the GOYA Marks, Applicant filed the GAYA Application on June 16, 2021, to register the GAYA Mark in connection with Applicant’s Goods.

8. The grant of a registration to Applicant for the GAYA Mark should be denied on the grounds of Opposer’s prior use and registration of the GOYA Marks in connection with the goods and services identified above, given the visual, aural and overall similarities between the

GOYA Marks and the GAYA Mark and the relatedness of each party's corresponding goods and, in the case of Goya, relevant services.

9. In particular, each mark contains only four letters of which the first and the last two are identical, namely "G" and "YA," and otherwise differ by only one vowel. In this regard, the GAYA Mark and the GOYA Marks are highly similar both when viewed and when spoken. Given that the terms GOYA and GAYA arguably do not convey any particular meaning, these visual and aural similarities between the marks are particularly significant and strongly support Opposer's opposition.

10. In light of the foregoing, Applicant's GAYA Mark is confusingly similar to the GOYA Marks, and the use and registration of the GAYA Mark in connection with Applicant's Goods is likely to cause confusion or mistake in the minds of the relevant purchasing public and to lead the public and prospective purchasers to erroneously assume, and thus be misled or deceived into believing, that Applicant's Goods are endorsed by, licensed by, sponsored by or otherwise affiliated or connected with Opposer, all to the irreparable damage and injury of Opposer and the purchasing public.

11. The grant of a registration to Applicant for the GAYA Application should be denied based on a likelihood of confusion as a result of the prior existing GOYA Marks that are used in connection with related goods and services.

12. The GAYA Mark sought to be registered is further likely to cause dilution of the distinctive qualities of certain of the registered GOYA Marks, which would cause irreparable damage and injury to Opposer and the purchasing public.

13. For the foregoing reasons, Opposer believes and alleges that it is being, and will continue to be, damaged by the registration of the GAYA Application. Accordingly, the GAYA Application should be refused registration pursuant to 15 U.S.C. § 1052(d).

**WHEREFORE**, Opposer files this Notice of Opposition and respectfully requests that the GAYA Application be denied, such that no registration be issued thereon to Applicant, and for any additional relief deemed just and proper by the Trademark Trial and Appeal Board.

Dated: August 9, 2022

/amyecarroll/

A. John P. Mancini

Amy E. Carroll

MAYER BROWN LLP

1221 Avenue of the Americas

New York, New York 10020

(212) 506-2500

[ipdocket@mayerbrown.com](mailto:ipdocket@mayerbrown.com)

[jmancini@mayerbrown.com](mailto:jmancini@mayerbrown.com)

[acarroll@mayerbrown.com](mailto:acarroll@mayerbrown.com)

*Attorneys for Opposer, Goya Foods, Inc.*