

ESTTA Tracking number: **ESTTA65367**

Filing date: **02/07/2006**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Vitasoy International Holdings Limited		
Entity	Corporation	Citizenship	Hong Kong
Address	1 Kin Wong Street Tuen Mun New Territories, HONG KONG		

Attorney information	Carole F. Barrett Howard Rice et alia Three Embarcadero Center, 7th Floor San Francisco, CA 94111-4024 UNITED STATES trademark@howardrice.com Phone:415.434.1600		
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Registration Subject to Cancellation

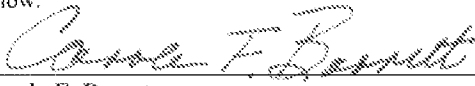
Registration No	3023852	Registration date	12/06/2005
International Registration No.	NONE	International Registration Date	NONE
Registrant	Pedro Maria Barroeta Urquiza Calle San Juan de la Cruz 3 -Portal 2, 1° B E-28223 Pozuelo de Alarcon (Madrid), SPAIN		
Goods/Services Subject to Cancellation	Class 030 Goods/Services: Tea; tea-based beverages		

Attachments	VITATEA-Petition to Cancel.pdf (9 pages)
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Signature	/CFB_lmd/
Name	Carole F. Barrett
Date	02/07/2006

Certificate of Mailing

I hereby certify that this correspondence is being deposited electronically the Trademark Trial and Appeal Board on the date shown below.



Carole F. Barrett

Dated: February 7, 2006

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

VITASOY INTERNATIONAL
HOLDINGS LIMITED,

PETITIONER,

v.

PEDRO MARIA BARROETA URQUIZA.,

REGISTRANT
(RESPONDENT).

Mark: VITATEA

Registration No. 3,023,852

Issued: December 6, 2005

Petition To Cancel No. _____

PETITION TO CANCEL

Vitasoy International Holdings Limited, a Hong Kong corporation, located and doing business at 1 Kin Wong Street, Tuen Mun, New Territories, Hong Kong (“Vitasoy” or “Petitioner”), believes that it will be damaged by the continued registration of the mark VITATEA, shown in United States Trademark Registration No. 3,023,852 and hereby petitions the Trademark Trial and Appeal Board to cancel the same.

As grounds for its Petition To Cancel, Petitioner alleges:

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

2. The Application was based on the Registrant's International Registration No. 0802633 with an International Registration Date of March 5, 2003.

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

4. On September 28, 2005, Petitioner filed a Notice Of Opposition with respect to the Application. On October 21, 2005, the Board dismissed the Opposition proceeding without prejudice, finding that the PTO had failed to provide the notice required under the Madrid Protocol to the Trademark Act § 66(a), 15 U.S.C. § 1141f.

5. On December 6, 2005, the PTO issued a certificate of registration to the Registrant for the mark VITATEA for use in connection with tea and tea-based beverages in International Class 30, Registration No. 3,023,852 ("Registration").

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

7. On information and belief, Registrant has not used Registrant's VITATEA Mark in advertising in the United States.

8. On information and belief, Registrant has not made any use of Registrant's VITATEA Mark within the United States in connection with the goods named in the Registration or related goods or services.

9. Petitioner is a manufacturer of food and beverage products, including tea and tea beverages, bottled water, fruit juices, vegetable juices, soft drinks, and soymilk

beverages. Petitioner's products are distributed throughout the world, including throughout the United States.

10. Petitioner advertises and sells food and beverage products throughout the United States bearing the VITA mark ("Petitioner's VITA Mark"), the VITASOY mark ("Petitioner's VITASOY Mark"), and other highly similar marks.

11. Since at least as early as 1980, Petitioner has sold non-carbonated, non-alcoholic beverage products throughout the United States, such as fruit and vegetable juice beverages in connection with Petitioner's VITA Mark, Petitioner's VITASOY Mark, and other highly similar marks.

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

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

14. Petitioner is the owner of U.S. Registration No. 1833973 for the mark VITA issued on May 3, 1994, which covers tea drinks in international class 030. Petitioner filed the affidavit of use and a request for incontestability with the PTO pursuant to Section 15 of the Lanham Act (15 U.S.C. §1065) on March 15, 2000, which was accepted and acknowledged by the PTO on June 2, 2000, rendering Petitioner's rights in this registered mark incontestable. Petitioner filed the Section 8 affidavit of use and Section 9 application for renewal on March 31, 2004, which was accepted and granted by the PTO on May 17, 2004. The registration is valid and subsisting..

15. Petitioner is the owner of U.S. Registration No. 1893224 for the mark VITA issued on May 9, 1995, which covers fruit juices and vegetable juices in international class 032. Petitioner filed the affidavit of use and a request for

incontestability with the PTO pursuant to Section 15 of the Lanham Act (15 U.S.C. §1065) on May 3, 2001, which was accepted and acknowledged by the PTO on July 6, 2001, rendering Petitioner's rights in this registered mark incontestable. Petitioner filed the affidavit of use and application for renewal on March 14, 2005, which was accepted and granted by the PTO on May 5, 2005. The registration is valid and subsisting.

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

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

18. Petitioner is the owner of U.S. Registration No. 1747259 for the mark consisting of Chinese characters, which transliterate to WEI TA, and which means VITA in English. This registration covers vegetable based food beverage used as a milk

substitute made from soya beans, tofu, and soybean curd, in international class 29, and soybean based, non-carbonated, non-alcoholic drinks; namely, fruit and vegetable juice beverages, concentrates for making non-alcoholic, non-carbonated drinks, namely, fruit and vegetable juice beverages, and extracts of fruits and soybeans for making non-alcoholic, non-carbonated drinks; namely, fruit and vegetable juice beverages, in international class 030. Petitioner filed the affidavit of use and request for incontestability with the PTO pursuant to Section 15 of the Lanham Act (15 U.S.C. §1065) on March 19, 1998, which was accepted and acknowledged by the PTO on July 21, 1998, rendering Petitioner's rights in this registered mark incontestable. Petitioner filed the affidavit of use and application for renewal with the PTO on August 12, 2002, which was accepted and granted by the PTO on October 31, 2002. The registration is valid and subsisting.

19. Petitioner is the owner of U.S. Registration No. 1990485 for the mark consisting of Chinese characters, which mean VITA in English. This registration covers soybean curd desserts, namely pudding and custard in International Class 030. Petitioner filed the affidavit of use and request for incontestability with the PTO pursuant to Section 15 of the Lanham Act (15 U.S.C. §1065) on December 18, 2001, which was accepted and acknowledged by the PTO on February 22, 2002, rendering Petitioner's rights in this registered mark incontestable. The registration is valid and subsisting.

20. Petitioner is the owner of U.S. Registration No. 1147761, for the mark VITA MILK in Chinese characters, the first two of the three Chinese characters of the mark, from left to right, being "Vita" phonetically and the third character is "Milk", which covers vegetable based milk substitute made from soya beans, in International Class 029. Petitioner filed the affidavit of use and request for incontestability with the PTO pursuant to Section 15 of the Lanham Act (15 U.S.C. §1065) on March 27, 1986, which was accepted and acknowledged by the PTO on June 26, 1986, rendering Petitioner's rights in this registered mark incontestable. Petitioner filed the affidavit of

use and application for renewal with the PTO on February 6, 2001, which was accepted and granted on May 19, 2001. The registration is valid and subsisting.

21. Petitioner is the owner of U.S. Registration No. 2765529 issued on September 16, 2003 for the mark VITASOY and design. This registration covers fresh tofu; soy beverages, namely, soy based beverage used as a milk substitute, in international class 29, and tofu desserts, namely, tofu based puddings and custards made with soy; soy beverages, namely, teas made with soy, in international class 30. The registration is valid and subsisting.

22. Petitioner is the owner of U.S. Registration No. 2574498 issued May 28, 2002 for the mark VITASOY, which covers soya bean milk in International Class 029. The registration is valid and subsisting.

23. Petitioner is the owner of U.S. Registration No. 1868942 for the mark VITASOY, which covers tofu in International Class 029. Petitioner filed the affidavit of use and request for incontestability with the PTO pursuant to Section 15 of the Lanham Act (15 U.S.C. §1065) on March 16, 2000, which was accepted and acknowledged by the PTO on October 4, 2000, rendering Petitioner's rights in this registered mark incontestable. Petitioner filed the affidavit of use and application for renewal on March 31, 2004, which was accepted and granted by the PTO on April 27, 2004. The registration is valid and subsisting.

24. Petitioner is the owner of U.S. Registration No. 1968713 for the mark VITASOY, which covers soybean-based pudding and custard in International Class 030. Petitioner filed the affidavit of use and request for incontestability with the PTO pursuant to Section 15 of the Lanham Act (15 U.S.C. §1065) on January 18, 2002, which was accepted and acknowledged by the PTO on March 20, 2002, rendering Petitioner's rights in this registered mark incontestable. The registration is valid and subsisting.

25. Petitioner is the owner of U.S. Registration No. 1830741, for the mark Vitasoy in Chinese Characters, which transliterates to "wac tab nab" which means

"Vitasoy" in English, which covers soybean-based non-carbonated, non-alcoholic drinks; namely, fruit and vegetable juice beverages, in International Class 032. Petitioner filed the affidavit of use and request for incontestability with the PTO pursuant to Section 15 of the Lanham Act (15 U.S.C. §1065) on July 19, 1999, which was accepted and acknowledged by the PTO on November 6, 1999, rendering Petitioner's rights in this registered mark incontestable. Petitioner filed the affidavit of use and application for renewal with the PTO on March 18, 2004, which was accepted and granted on April 30, 2004. The registration is valid and subsisting.

26. For purposes of this Opposition pleading, Petitioner's VITA marks, referenced in paragraphs 14 and 15, Petitioner's marks which transliterate into VITA, referenced in paragraphs 16, 17, 18, 19 and 20, Petitioner's VITASOY marks, referenced in paragraphs 21, 22, 23 and 24, and Petitioner's mark which transliterates into VITASOY, referenced in paragraph 25, will be referred to collectively as "Petitioner's VITA Marks."

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

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

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

30. As a result of Petitioner's extensive advertising and use of Petitioner's VITA Marks in connection with food products and non-carbonated, non-alcoholic

beverages, including tea and tea beverages, Petitioner's VITA Marks have acquired extensive goodwill throughout the United States, are associated in the minds of the general public with Petitioner, and constitute famous marks.

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

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

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

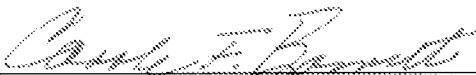
34. Registrant's VITATEA Mark so resembles Petitioner's VITA Marks, such that the sale of products by Registrant bearing the VITA mark would cause dilution to the distinctive quality of Petitioner's VITA Marks, within the meaning of Section 43 of the Lanham Act, 15 U.S.C §1125(c).

WHEREFORE, Petitioner respectfully requests that registration of the mark shown in Registration No. 3023852 be cancelled and that this Petition To Cancel be sustained in favor of Petitioner.

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

DATED: February 7, 2006

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