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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Zheng Cai

Serial No. 78821249

Zheng Cai, *pro se*.

James W. MacFarlane[1], Trademark Examining Attorney, Law Office 104 (Chris Doninger, Managing Attorney).

Before Hairston, Zervas and Taylor, Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Zheng Cai has filed an application to register on the Principal Register the mark TAI CHI GREEN TEA and design, shown below,

for goods ultimately identified as "Woolong tea, Black tea; beverages made of Woolong tea and Black tea; Green tea,

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[1] The application was assigned to the current examining attorney for consideration of the request for reconsideration and to write the brief.

beverages made of green tea" in International Class 30.[2] "GREEN TEA" and the non-Latin characters that mean "GREEN TEA" have been disclaimed.

The examining attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark is likely to be confused with the mark in U.S. Registration No. 2449580, TAI CHI and design, shown below,

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[2] Serial No. 78821249, filed February 23, 2006, and alleging a bona fide intention to use the mark in commerce on woolong and black teas and beverages, and July 18, 2005 as the date of first use of the mark anywhere and in commerce on green tea and green tea beverage. [We note that the wording "Based on Intent to Use" and "Based on Use In Commerce" is included in the identification of goods. However, for purposes of clarity, we have omitted it from the recitation above.] The application also contains the following description, color, translation and transliteration statements: "The mark consists of an image adopted from the Tai Chi graph, Taijitu, but the black part of the Tai Chi graph is changed to green. The image looks like two drops of water, one is up and one is down, and there are two tiny dots in each part of the two sides. The color green appears on the right side of the Tai Chi graph and the color white appears on the left side of the graph. The tiny dot on the left side of the graph is at the top of that portion of the graph and it is in green. The tiny dot on the right side of the graph is at the bottom of that portion of the graph and it is in white. Surrounding the top portion of the circle formed by the Tai Chi graph are the words 'Tai Chi Green Tea' in green and at the bottom of the circle are the words Tai Chi Green Tea in green again, but this time the words are written in Chinese characters."; "The colors green and white are claimed as a feature of the mark."; The foreign wording in the mark translates into English as Tai Chi Green Tea."; and "The non-Latin characters in the mark transliterate to "Tai Chee Lyu Cha."

for "herbal food supplements; and food supplements consisting of ginseng and/or royal jelly, namely ginseng extractum and ginseng royal jelly" in International Class 5; and "herbal teas; herbal food beverages" in International Class 30.[3]

When the refusal was made final, applicant appealed and requested reconsideration of the final refusal. On December 6, 2007, the examining attorney denied the request for reconsideration and, on December 15, 2007, this appeal was resumed. Briefs were filed by both applicant and the examining attorney. For the reasons discussed below, we affirm the refusal to register.

We initially note that inasmuch as both applicant and the examining attorney focused their discussion of the relatedness of the goods on applicant's recited goods vis-à-vis the herbal teas and herbal food beverages identified in the cited registration, we will do the same.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative

[3] Registration No. 2449580, issued May 8, 2001, Section 8 Affidavit accepted, Section 15 Affidavit acknowledged.

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 considerations are the similarities between the marks and the similarities 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).

We first consider whether applicant's "woolong tea; black tea; beverages made of woolong tea and black tea; green tea, [and] beverages made of green tea" and registrant's "herbal teas; [and] herbal food beverages" are related. In analyzing the relatedness of these goods, it is not necessary that the goods of applicant and the registrant be similar or even competitive to support a finding of likelihood of confusion. It is sufficient that the respective goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under conditions which could, because of the marks used therewith, give rise to a mistaken belief that they

originate from or are in some way associated with the same source. In re Melville Corp., 18 USPQ2d 1386 (TTAB 1991).

The examining attorneys have made of record twenty third-party registrations to establish the relatedness of the goods. These use-based registrations show that each entity adopted a single mark for woolong, black and/or green teas and beverages, on the one hand, and herbal teas and herbal food beverages, on the other. Third-party registrations that individually cover different items and that are based on use in commerce serve to suggest that the listed goods and services are of a type that may emanate from a single source. *See* In re Mucky Duck Mustard Co., 6 USPQ2d at 1467, 1470 n.6 (TTAB 1988) (Although third-party registrations are "not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may nonetheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source"). *See also* In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1786 (TTAB 1993).

These registrations include:

Registration No. 3044179 for "black tea and green tea" and "herb tea for food purposes and herbal tea for food purposes";

Registration No. 3024481 for *inter alia* "black tea and green tea" and "herb tea for food purposes and herbal tea for food purposes";

Registration No. 3050641 for, *inter alia*, "black tea and green tea" and "herb tea and herbal teal";

Registration No. 3116863 for, *inter alia*, "black tea and green tea" and "herbal tea"; and

Registration No. 3094553 for, *inter alia*, "black tea and green tea" and "herb tea and herbal tea";

Registration No. 3180831 for, *inter alia*, "black tea and green tea" and "herb tea and herbal tea";

Registration No. 3183823 for, *inter alia*, "black tea and green tea" and "herb tea and herbal tea";

Registration No. 2857720 for, *inter alia*, "black tea" and "herb and herbal tea";

Registration No. 3330791 for, *inter alia*, "green tea" and "herbal tea"; and

Registration No. 3320523 for, *inter alia*, "black tea and green tea" and "herb tea and herbal tea."[4]

The third-party registrations suggest that black, green and herbal teas emanate from the same source. Accordingly we find that the goods are commercially related such that, if identified by similar marks, confusion as to source is likely.

Applicant has advanced several arguments in an attempt to distinguish his goods from those of the registrant and

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[4] The other registrations of record are: Registration Nos. 3260259, 3183821, 3336887, 3167015, 3309640, 3304641, 3255810, 3307348, and 3310012. We also note that we have not relied on Registration No. 2494288 because it was cancelled on July 4, 2008 pursuant to Section 8 of the Trademark Act.

we address each one in turn. First, applicant questions the probative value of the third-party registrations to demonstrate the relatedness of the goods. We find this argument unavailing. As pointed out by the examining attorney, "this type of evidence has long been accepted by the Board as proof … that goods may come from the same source. *See, e.g., In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d at 1470. The more registrations that incorporate the goods at issue, the stronger the inference that consumers may perceive the goods as emanating from the same source." (Br. at unnumbered p. 10). The nineteen registrations of record clearly support the inference that the goods are related.

Next, applicant contends that his goods and registrant's goods are "totally different and mutually exclusive"; applicant's teas are derived from the Camellia Sinensis plant, the source of all tea, whereas registrant's herbal tea, although identified as tea, is instead an herbal infusion of leaves, roots, seeds, or flowers of other plants except the Camellia Sinensis plant. (Reply br. p. 18). We reiterate that the goods of the parties need not be identical to find a likelihood of confusion; they need only be related in a manner which leads to a

mistaken belief that they emanate from the same source. In re Mucky Duck Mustard Co., *supra.*

Applicant also argues that FDA regulations requiring herbal teas to be labeled with certain information obviates the likelihood of confusion. Registrant's disclosure on the product packaging of the precise kinds of herbs in his herbal teas does not obviate consumer confusion as to the source of the respective goods. The question to be determined in this case is not whether the goods are likely to be confused but rather whether there is a likelihood of confusion as to the source of the goods because of the marks used thereon. In re Rexal Inc., 223 USPQ 830, 831 (TTAB 1984).

Finally, to the extent that applicant is arguing that the examining attorney inappropriately claims that his identified goods are within registrant's logical zone of expansion, we have not relied on this contention by the examining attorney as it is unnecessary to our resolution of this appeal. *See* In re 1st USA Realty Professionals Inc., 84 USPQ2d 1581, 1854 (TTAB 2007) ("[W]e look [in an ex parte proceeding] at the question of the relatedness of the [goods or] services identified in applicant's application and those in the cited registration based on whether consumers are likely to believe that the [goods or]

services emanate from a single source, rather than whether the Examining Attorney has shown that the registrant herein has or is likely to expand its particular business to include the [goods or] services of applicant.")

Further, in the absence of any limitations in the identification of goods as to channels of trade and classes of purchasers in the application and the cited registration, we must presume that the goods will be offered in all normal channels of trade for such goods, e.g., grocery stores, gourmet shops and tea shops, and will be purchased by the normal classes of purchasers, including ordinary consumers. In re Elbaum, 211 USPQ 639 (TTAB 1981).

In view of the above, the *du Pont* factors of the relatedness of the goods, channels of trade and classes of purchasers favor a finding of likelihood of confusion.

Turning then to a consideration of the marks, we must determine whether applicant's mark and registrant's mark, when compared in their entireties, are similar or dissimilar in terms of sound, appearance, connotation and commercial impression. Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). Although we must compare the marks in their entireties, one feature of a mark may be more significant

than another and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985) ("There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable."). 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 that confusion as to the source of the goods 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).

Applicant's mark is

and the cited mark is

. Applicant essentially maintains that the marks are strikingly different in appearance, sound and meaning, and accordingly the overall commercial impressions differ. Applicant particularly argues that the design portion of

his mark, as well as the color green, are more likely to be impressed upon a purchaser's memory. Applicant also argues that "the true meaning of 'Tai Chi' in Tai Chi Green Tea, which is an adjective and means 'ultimate supreme', or 'the extremely high.' Also, the attorney fails to notice that 'Tai Chi' is a direct translation of Chinese word [sic]." (Br. at p. 2).

The examining attorney, conversely, contends that the marks are highly similar in appearance, sound and meaning thus creating similar commercial impressions. More specifically, he argues that the marks are similar in commercial impression because they share the identical, dominant wording "TAI CHI."

We find applicant's mark substantially similar to the cited mark in terms of appearance, sound, connotation and commercial impression. As regards the appearance of the marks, both marks are similar as to the shared wording "Tai Chi," and both include similar designs featuring what the record shows to be the "Tai Chi Graph," "which represents not only the definition of Tai Chi, but also a concept of yin-yang." (Appendix I to Applicant's Response to the Refusal of Registration, filed December 19, 2006)[5]. The

[5] Citing to an article found at: http://www.etc.cmu.edu/projects/mastermotion/TaiChi.htm.

minor differences in the designs do not serve to distinguish the marks. As regards applicant's mark, contrary to applicant's assertion, the disclaimed term "GREEN TEA" does not distinguish applicant's mark from the cited mark. Rather it clearly describes the type of tea sold by applicant, and it is not source signifying. *See* In re National Data Corp., 224 USPQ at 751 ("That a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of the mark."). Nor are the Chinese characters source-identifying inasmuch as they translate to the English words TAI CHI GREEN TEA and, accordingly, would be analyzed in the same manner as the English words. We also do not find the color green to be a distinguishing feature. Since the cited registration includes no claim of color, we must consider the possibility that the registrant's mark may be rendered in the color green. TMEP § 807.14(d)(i)(5th ed. 2007) (and the authority cited therein).

As regards the sound of the marks, both are similar insofar as the wording "Tia Chi" is concerned. The presence of the disclaimed words "Green Tea" in applicant's mark does nothing to distinguish the marks in any

significant way. See In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ 1531, 1534 (Fed. Cir. 1997).

As to the connotation of the marks, applicant maintains that there is no likelihood of confusion because the wording "tai chi" is an adjective, meaning "the Supreme Ultimate," "the very top," and "[o]nce it is placed in front of any noun, it became [sic] descriptive." (Reply br. at p. 6). In addition, though acknowledging that the term is also an abbreviation of "Tai Chi Chaun," a physical exercise popular in China, applicant contends that consumers will know that its mark means "The Supreme Ultimate Green Tea."

Applicant supported this position with, *inter alia*, a definition taken from the online version of the Oxford English Dictionary, which defines "Tai Chi" as follows (emphasis supplied):

> **T'ai Chi** Also Tai Chi, t'ai chi, etc. [ad. Chinese taifi, f. tai extreme+ji limit] **1. In Toaism and Neo=Confusionism, the Supreme Ultimate (See quota. 1955). Also, the symbol that represents this."** 2. In full T'ai Chi Ch'uan, a Chinese martial art, believed to have been devised by a Taoist priest in the Sung dynasty (960-1279), promoting meditative as well as physical proficiency.

By this, we presume that applicant is arguing that the literal portion of its mark connotes a top of the line green tea, while the cited mark connotes a Chinese martial

arts exercise. Even if we assume that the marks had somewhat different connotations, the differences would not outweigh the similarity in appearance and sound.

To the extent that applicant also argues that the wording "tai chi" is laudatory and suggestive of something ultimate and/or supreme, and therefore marks that incorporate the term are entitled to only a limited scope of protection, we find such argument unpersuasive. Again even assuming that the wording "tai chi" has some laudatory suggestiveness, even suggestive marks are deserving of protection, in particular here where the goods are closely related and the marks are so similar.[6] King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974); and Hollister Incorporated v. IdentAPet, Inc., 193 USPQ 439 (TTAB 1976). In any case, applicant did not establish that purchasers would attach the laudatory

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[6] Moreover, during prosecution, applicant argued that the wording "TAI CHI" is a "big" word in Chinese and in Chinese culture meaning "best" or "top," and suggested that the Board require registrant to immediately disclaim the wording "TAI CHI," as no one should be allowed to register the word for its exclusive use. To the extent that applicant is asserting that the TAI CHI portion of registrant's mark is descriptive, such a claim is an impermissible collateral attack on the cited registration and will not be entertained in this appeal. In re Dixie Restaurants, 41 USPQ2d at 1534; and In re Peebles Inc., 23 USPQ2d 1795, 1797 n.5 (TTAB 1992). See TMEP §207.01(d)(iv)(5th ed. 2007).

significance rather than martial arts significance to the wording "tai chi."

As noted previously, the marks are similar in appearance, having the wording TAI CHI and a variation of the "Tai Chi Graph" in common. As such, purchasers of herbal teas and herbal food beverages who are familiar with registrant's mark may view applicant's mark as a variant thereof, and that such mark identifies a new line of teas sponsored by or approved by registrant. While differences admittedly exist between the marks when viewed on the basis of a side-by-side comparison, for reasons discussed above, we find that they are substantially similar in appearance, sound and connotation and convey the same overall commercial impression. Accordingly, the *du Pont* factor of the similarity of the marks favors a finding of likelihood of confusion.

After careful consideration of the arguments and all of the evidence of record, even if those arguments and evidence have not been specifically referenced in this decision, we conclude that in view of the substantial similarity in the commercial impressions of applicant's mark and the cited mark, their contemporaneous use on related goods is likely to cause confusion as to the source or sponsorship of such goods.

Last, to the extent that any of the arguments made by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed.