

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

2/7/01

Hearing:
October 5, 2000

Paper No. 19
DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Societe Des Produits Nestle S.A.

v.

La Cibeles, Inc.

Opposition No. 112,805
to application Serial No. 75/451,701
filed on March 17, 1998

Gary D. Krugman and Leigh Ann Lindquist of Sughrue Mion Zinn
MacPeak & Seas, P.L.L.C. for Societe Des Produits Nestle S.A.

Bernard Malina of Malina & Wolson for La Cibeles, Inc.

Before Seeherman, Bucher and Rogers, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Societe Des Produits Nestle S.A. has opposed the application of La Cibeles, Inc. to register MASCAFE as a trademark for "coffee and coffee products, namely, coffee beans, ground coffee and instant coffee."¹ As grounds for opposition, opposer has alleged that since long prior to the March 17, 1998 filing date of applicant's intent-to-use application, opposer has continuously used the trademark NESCAFÉ for coffee and coffee extracts; that as a result of

¹ Serial No. 75/451,701 filed on March 17, 1998, asserting a *bona fide* intention to use the mark in commerce.

extensive advertising and promotion its mark is famous; that it owns the following incontestable trademark registrations for NESCAFÉ for coffee and coffee extracts:



Coffees, coffee extracts, decaffeinated coffees, and decaffeinated coffee extracts, with or without the admixture of other food ingredients. ²



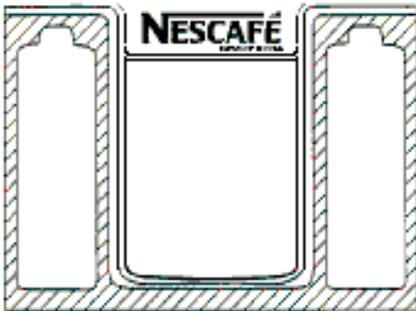
Coffee ³



Instant coffee ⁴



Decaffeinated instant coffee ⁵



Coffee ⁶

² Reg. No. 379,117 issued on July 2, 1940; third renewal effective July 2, 2000.

³ Reg. No. 843,369 issued on July 30, 1968; second renewal effective July 30, 1988.

⁴ Reg. No. 1,152,592 issued on April 28, 1981; §8 affidavit accepted and §15 affidavit acknowledged.

⁵ Reg. No. 1,235,383 issued on April 19, 1983; §8 affidavit accepted and §15 affidavit acknowledged.

⁶ Reg. No. 1,382,559, issued on February 11, 1986; §8 affidavit accepted and §15 affidavit acknowledged.

and that applicant's use of MASCAFE for coffee and coffee products is likely to cause confusion with opposer's previously used and registered mark NESCAFÉ.

In its answer, applicant has denied the salient allegations of the notice of opposition.

The record includes the pleadings; the file of the opposed application; opposer's notice of reliance on the above listed registrations; and the testimony, with exhibits, of opposer's witness, Martin Bishop, marketing director of coffee for Nestle U.S.A., a wholly-owned subsidiary of opposer.

Opposer alone filed a brief and appeared at a hearing before the Board.

The record shows that opposer has used the mark NESCAFÉ in the United States as a trademark for coffee continuously since 1939. NESCAFÉ coffee products are sold nationwide in supermarkets, club stores, convenience stores, and to restaurants and hotels. Opposer's NESCAFÉ coffee products are often marketed in eight-ounce packages, retailing for approximately four dollars. The NESCAFÉ mark is featured prominently on the front and back of each of the various labels. In recent years, sales in the United States of NESCAFÉ coffee have ranged from \$35 to \$40 million per year, and have been supported by \$10 million in annual marketing expenditures. Marketing surveys conducted for opposer demonstrate that more

than 50% of the consumers in the United States are aware of the NESCAFÉ brand of instant coffee.

Currently NESCAFÉ coffee products are promoted using radio and television commercials, through advertisements placed in nationwide print media, and through a variety of consumer promotions such as freestanding inserts, coupons and samplings.

Priority is not in issue in view of opposer's pleaded registrations for NESCAFÉ, copies of which have been made of record, establishing that the registrations are subsisting and owned by opposer. Moreover, opposer has established that it first began using the NESCAFÉ mark on coffee and coffee extracts in 1939, long before the filing of applicant's intent-to-use application on March 17, 1998.

This brings us to the question of likelihood of confusion. In making this determination, we have considered all the factors set forth in In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), which are relevant to this case. Our determination is that confusion is likely.

Turning first to the goods, they are substantially identical. Applicant's application and opposer's registrations include goods identified as "coffee" and "instant coffee," without any restrictions or limitations. Because there are no limitations as to the channels of trade in applicant's application or in opposer's registrations, we must assume that the parties' goods would be sold in the same channels of trade

and to the same class of consumers. See Canadian Imperial Bank of Commerce v. Wells Fargo Bank, NA, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) [the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in an opposer's registration].

As to the du Pont factor focusing on the conditions under which and buyers to whom sales are made, the evidence shows that packages of instant coffee are inexpensive, and are sold to members of the general public rather than to sophisticated purchasers. As a result, the purchase of retail quantities of coffee would not be the subject of a great deal of thought or analysis.

We turn next to the du Pont factor focusing on the fame of the prior mark. As a result of opposer's sales and promotional activity, and the survey demonstrating recognition of the mark, we find opposer's NESCAFÉ mark is a famous mark. Fame, of course, plays a dominant role in cases featuring a well-known or strong mark, as such marks enjoy a wide latitude of legal protection. As the Court said in Kenner Parker Toys Inc. v. Rose Art Industries, Inc., 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992), "the Lanham Act's tolerance for similarity between competing marks varies inversely with the fame of the prior mark."

With these points in mind, we turn to a consideration of the parties' marks, keeping in mind as well that "when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." See Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

When spoken, we conclude that the two-syllable word MASCAFÉ would sound quite similar to the two-syllable word NESCAFÉ. The first syllables of the marks begin with the almost indistinguishable letters "M" and "N," and both end with the letter "S." The final syllables of the marks (-CAFÉ) would be pronounced identically. It is well settled that similarity in sound alone may be sufficient to support a finding of likelihood of confusion. See Krim-Ko Corp. v. Coca-Cola Co., 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) [sustaining the Board's finding of likelihood of confusion between VEEP for carbonated flavored beverages sold as soft drinks and for use as mixers and BEEP for a fruit juice drink base]. This factor is especially critical given the degree to which opposer has for many years committed significant portions of its advertising expenditures to the medium of radio.

The marks are also similar in appearance. Both marks have seven letters. The first letters in these marks are similarly constructed consonants and the final five letters of the two

marks are identical. The additional accent mark in opposer's trademark does not serve to visually distinguish the marks.

In its answer to the notice of opposition, applicant argues in its "third affirmative defense" that "[t]he term CAFÉ, which is the only element common to both Applicant's and Opposer's marks ... is and has been used and registered in conjunction with other elements, by numerous other parties, for coffee and coffee products..." Clearly, as one of the du Pont likelihood of confusion factors, "[t]he number and nature of similar marks in use on similar goods" is a relevant inquiry. However, applicant has not submitted any evidence to show third-party use and/or registration of marks having a CAFÉ suffix used in connection with coffee; and although it is obvious no one could obtain exclusive rights to the generic word, COFFEE, or its foreign language equivalent, CAFÉ, applicant has used this term not simply as a generic term but as a portion of a single word mark in the identical manner as it is used in opposer's mark.

On this record, after weighing all the du Pont factors, we find that the mark MASCAFE is likely to cause confusion with NESCAFÉ for coffee and coffee products.

Decision: The opposition is sustained.