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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Vitasoy International Holdings Limited
v.
Grupo Corporative Teype, S.L.

Opposition Nos. 91159326 and 91160172

Carole F. Barrett of Howard Rice Nemerovski Canady Falk & Rabkin for Vitasoy International Holdings Limited.

Howard N. Aronson of Lackenbach Siegel for Grupo Corporative Teype, S.L.

Before Walters, Rogers and Bergsman, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Vitasoy International Holdings Limited filed oppositions to the applications of Grupo Corporative Teype, S.L. to register the marks shown below:

VIVA SOY (standard characters) for "soy-based food beverage used as a milk substitute," in International Class 29, and for "non-alcoholic beverages made with fruit juice and soy; fruit beverages having fruit juice and soy," in

International Class 32.[1] The application includes a disclaimer of SOY apart from the mark as a whole and an English translation of VIVA as "alive." This application is the subject of Opposition No. 91159326.

for "soy-based food beverage used as a milk substitute," in International Class 29, and for "non-alcoholic beverages made with fruit juice and soy; fruit beverages having fruit juice and soy," in International Class 32.[2] The application includes a disclaimer of SOY apart from the mark as a whole and an English translation of VIVE as "alive." This application is the subject of Opposition No. 91160172.

As grounds for opposition in each case, opposer asserts that applicant's mark, when applied to applicant's goods so resembles opposer's previously used and registered marks shown below as to be likely to cause confusion, under Section 2(d) of the Trademark Act.[3]

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[1] Application Serial No. 78207777 ('777), filed January 28, 2003, based upon an allegation of a bona fide intention to use the mark in commerce in connection with the identified goods.

[2] Application Serial No. 78206255('255), filed January 23, 2003, based upon an allegation of a bona fide intention to use the mark in commerce in connection with the identified goods.

[3] Opposer also pleaded ownership of Registration no. 1818116 for the mark VITASOY (expired) and application Serial No. 76215286 for the mark VITASOY and design (abandoned). Because Registration No. 1818116 has expired, we have given it no consideration. Because an application is only evidence that an application has been filed and, in any event, Serial No. 76215286 has been abandoned, we have given that application no consideration.

Registration Number, Status and Information	**Goods**	**Mark**
1868942 Registered 12/20/1994; Renewed; Section 15 affidavit filed and acknowledged	Tofu, in International Class 29	VITASOY
2574498 Registered 5/28/2002; Section 8 & 15 affidavits accepted and acknowledged	Soya bean milk, in International Class 29	VITASOY
1830741 Registered 4/12/1994; Renewed; Section 15 affidavit filed and acknowledged. "The foreign characters in the mark transliterate to 'wac tab nab' which means 'vitasoy' in English."	Soybean-based non-carbonated, non-alcoholic drinks; namely, fruit and vegetable juice beverages, in International Class 32	維他奶
2765529 Registered 9/16/2003	Fresh tofu; soy beverages, namely, soy based beverage used as a milk substitute, in International Class 29; Tofu desserts, namely, tofu based puddings and custards made with soy; soy beverages, namely, teas made with soy, in International Class 30	VITASOY

In opposition no. 91160172 only, opposer asserts the following additional registrations:

Registration No., Status and Information	**Goods**	**Mark**
1833973	Tea drinks, in International Class 32	VITA

Registered 5/3/1994; Renewed; Section 15 affidavit filed and acknowledged		
1893224 Registered 5/9/1995; Renewed; Section 15 affidavit filed and acknowledged	Fruit juices, vegetable juices, in International Class 32	VITA

Applicant, in each of its answers, denied the salient allegations of the respective notices of opposition.

The Record

The record in these consolidated cases consists of the pleadings in both proceedings; the files of the involved applications; certified status and title copies of the pleaded, active registrations, all made of record by opposer's notice of reliance; and the testimony depositions on written questions by opposer of Ah Hing (Paggie) Tong, opposer's corporate secretary, and Angela Ip, opposer's subsidiary's National Sales and Marketing Manager, Ethnic Division, both with accompanying exhibits. Applicant filed no testimony or other evidence and only opposer filed a brief.

Factual Findings

Vitasoy USA Inc. ("VUSA") is opposer's wholly-owned subsidiary with offices and manufacturing facilities in the United States. VUSA manufactures, markets, distributes and sells opposer's food and beverage products in the United States, focusing on soy-based food and beverage products,

including soy milk. VUSA also imports VITA teas and juice drinks from its parent for sale in the United States. VUSA has been selling soy milk and other soy-based beverages in the United States under the VITASOY mark, including in Chinese characters, since 1980. From the same date, VUSA has been selling tea and juice drinks in the United States under the VITA mark, including in Chinese characters. The VITASOY line has been expanded since 1980 to include tofu.

Opposer's products are sold in supermarkets, including Whole Foods, Costco and Walmart, smaller specialty stores, including 99 Ranch Market, and health food stores. Opposer's products range in price from approximately $.99 to $2.29. Opposer conducts extensive advertising in a variety of media, including print, television, radio, point-of-purchase and online. Opposer advertises extensively, e.g., it spent $2.5 million in advertising in the past fiscal year.[4]

Analysis

Because opposer has properly made its pleaded registrations of record, we find that opposer has established its standing to oppose registration of applicant's marks. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton*

[4] While opposer alleges in its brief that its marks are famous and the evidence shows substantial advertising expenses, we find the record insufficient to support a finding that opposer's marks are famous.

Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Moreover, because opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in this case as to the marks and goods covered by said registrations. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

In considering the question of likelihood of confusion, it is our opinion that the most pertinent of opposer's marks are Registration No. 2574498 ('498) for the mark VITASOY in standard character format for soybean milk, and Registration No. 2765529 ('529) for the mark VITASOY and design for a variety of soy and tofu-based products, including a soy-based beverage used as a milk substitute and teas made with soy. Therefore in the remainder of our analysis, we will focus our discussion on these marks and registrations.

Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In*

re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

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." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). *See also In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

With respect to the goods of the parties, we observe that there is a substantial overlap in the goods identified in the applications and in the '498 and '529 registrations. First, both of the applications and opposer's '498 registration for the mark VITASOY and '529 registration for the stylized mark VITASOY, include a soy-based beverage used as a milk substitute. Applicant's goods in International Class 29 are identical to the same goods in opposer's registrations and closely related to the soy-based, non-alcoholic fruit juice beverages in International Class 32. Thus, we conclude that the applications and opposer's registrations include goods that are either identical or closely related.[5]

[5] The '529 registration includes tofu and tofu desserts, and we note that the record does not establish a relationship between these goods and applicant's goods. However, that is of no moment as the '529

Further, both opposer's and applicant's identifications of goods are broadly worded, without any limitations as to channels of trade or classes of purchasers. We therefore must presume that the goods of applicant and opposer are sold in all of the normal channels of trade to all of the usual purchasers for goods of the type identified. *See Canadian Imperial Bank v. Wells Fargo*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). In other words, we conclude that the channels of trade and classes of purchasers of the parties' goods are the same. Additionally, we note that the classes of purchasers encompass all general consumers; and that these are not expensive products that will be subject to close scrutiny upon purchase.

Considering, now, the marks involved herein, we note that where marks appear on identical goods, the degree of similarity of the marks necessary to support a conclusion of likelihood of confusion decreases. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992). Moreover, while we must base our determination on a comparison of the marks in their entireties, we are guided, equally, by the well established principle that, in articulating reasons for reaching a

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registration also contains goods that are identical to some of the goods in the two applications. See *Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found if there is likely to be confusion with respect to any items that come within the identification of goods in the application).

conclusion on the issue of confusion, "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." *In re National Data Corp.*, 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Considering, first, applicant's two marks, the mark in the '777 application consists of the term VIVA SOY in standard character format. The mark in the '255 application consists of the term VIVE SOY in stylized form with the word VIVE above the word SOY, with both words appearing in lower case letters in a nondistinctive font style, and with a leaf design incorporated into the "Y" in SOY and underlining that term. Both VIVA and VIVE translate into English as "alive."

Opposer's marks consist of the term VITASOY in standard character format and in a stylized form. Opposer's stylized mark includes nondistinctive script, a slight arch to the wording, and a design of leaves on a branch in the "O" of SOY.

Both the standard character and stylized marks of the parties have differences in sound, appearance and connotation. For example, the two words VIVA/VIVE and SOY are separated in applicant's marks, whereas opposer's marks are a single word, VITASOY; and VIVA/VIVE in applicant's

marks has a distinct meaning, while the VITA portion of opposer's marks is not an English word, although it may suggest the word "vitamin."

However, there are also substantial similarities in the marks. The word portion of applicant's standard character mark, VIVA SOY, differs from the word portion of opposer's marks, VITASOY, by only a single letter in the middle of the mark and by the space between the two words. We find these distinctions are of little significance.

Both applicant's VIVE SOY design mark and opposer's marks consist of a four-letter word beginning with "VI," followed by a consonant/vowel combination, and this combination is followed by the word SOY. Further, the significant design element in the parties' respective design marks consists, conceptually, of what is probably a soybean plant leaf or leaves. We note 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 their overall commercial impressions 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). In this context,

we find that the similarities among the marks outweigh the dissimilarities. Therefore, we find the overall commercial impressions of the parties' marks are substantially similar.

With respect to opposer's '498 and '529 registrations, having considered the record and the relevant likelihood of confusion factors, we conclude that in view of the substantial similarities in the commercial impressions of applicant's two VIVA/VIVE SOY marks and registrant's VITASOY marks, their contemporaneous use on the identical or closely related goods involved in these two oppositions is likely to cause confusion as to the source or sponsorship of such goods.

Decision: Both of the oppositions are sustained.