

THIS OPINION
IS NOT A PRECEDENT
OF THE TTAB

Mailed: August 26, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Oakville Hills Cellar, Inc.

v.

Victor F. Maya

Opposition No. 91163751
to application Serial No. 78364405
filed on February 7, 2004

J. Scott Gerien of Dickenson, Peatman & Fogarty for Oakville Hills Cellar, Inc.

Victor F. Maya, *pro se*.

Before Grendel, Zervas and Taylor, Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Victor Maya has filed an application to register on the Principal Register the mark MAIA (in standard character form) for "wine." in Class 33.¹

¹ Serial No. 78364405, filed on February 7, 2004, and asserting January 1, 1998 as the date of first use of the mark anywhere and January 1, 2004 as the date of first use of the mark in commerce.

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Registration has been opposed by Oakville Hills Cellar. Opposer, in its amended notice of opposition, specifically alleges, *inter alia*, that "since as early as 1990, well before any filing date or date of first use upon which Applicant can rely, Opposer adopted and continuously used the mark MAYA in connection with wine" (Opposition ¶ 1); that it "is the owner of Registration No. 2,508,401² for the mark MAYA [in "typed" form³] for wine in International Class 33, goods similar to those identified in Applicant's application" (Opposition ¶ 2); and that applicant's mark so resembles its previously used and registered mark MAYA, as to be likely, when applied to the goods of applicant, to cause confusion, or to cause mistake, or to deceive.⁴

Opposer also alleges that "based on Applicant's failure to use the mark MAIA in commerce, Applicant is not entitled to registration of its mark pursuant to Section 1(a) as alleged in Applicant's application, and application Serial No. 78/364,405 should therefore be denied." (Opposition ¶ 10).

² Registration 2508401 issued November 20, 2001, Section 8 Affidavit accepted, Section 15 Affidavit acknowledged.

³ The former reference to what the Office now refers to as "standard character" form.

⁴ Opposer also claimed ownership of Registration No. 2274626 for the mark MAYA and design. However, that registration has been cancelled under Trademark Act § 8 for opposer's failure to file an affidavit of continued use. Opposer's claim in view of this registration is therefore moot.

Applicant, in its answer, admits that opposer is the owner of Registration No. 2508401, but has denied the remaining essential allegations of the notice of opposition.⁵

THE RECORD

The record includes the pleadings and the file of involved application Serial No. 78364405. During their testimony periods, both opposer and applicant filed notices of reliance; opposer filing one during its testimony period and one during its rebuttal testimony period and applicant filing five during his testimony period. Although only applicant has raised a number of objections to opposer's evidence, we find that a discussion of the evidence, submitted by both opposer and applicant during their

⁵ Applicant also pleaded certain affirmative defenses, which are in the nature of elaborations of his denials and have been considered only to that extent. In addition, "in order to avoid the inconvenience of trial and for the benefit of all parties involved," applicant offered to (1) restrict his use of the MAIA mark to not include the wine grapes Cabernet Sauvignon and Cabernet Franc and (2) to amend the basis of his application if the Board determines that he did not declare the correct basis. Inasmuch as trial has been completed, we will not consider these proffered amendments. Notably, acceptance of the amendment to the identification of goods would not have changed our decision herein on opposer's Section 2(d) claim.

We also note that applicant, in its brief, requested the Board to "intervene to mediate a reasonable, mutually agreeable, and legally sound compromise settlement that will bring this matter to its final conclusion." (Brief at p. 28) Such a request in a final brief is both untimely and inappropriate.

respective testimony periods, is necessary because much of the material sought to be introduced is not admissible via notice of reliance.⁶ We also note that applicant, prior to briefing in this case, moved to strike opposer's notice of reliance filed January 8, 2008.

Applicant's Motion to Strike

We first address applicant's motion to strike opposer's notice of reliance, filed January 8, 2008 during opposer's scheduled rebuttal testimony period. Applicant argues that the documents accompanied by the notice of reliance are improper rebuttal because applicant took no testimony, and that the notice of reliance is procedurally defective. On March 25, 2008, the Board denied the motion insofar as it is based on a procedural defect, finding that opposer sufficiently explained the relevance of the attached material. We now consider whether the documents accompanying the notice constitute improper rebuttal. Opposer responded to the motion, arguing that the content of the rebuttal notice of reliance directly addressed evidence submitted by applicant during his testimony period.

A party may, on rebuttal, introduce facts and witnesses to deny, explain or discredit facts and witnesses adduced by

⁶ Further, the evidence attached to opposer's brief is untimely and has not been considered herein. See Trademark Manual of Procedure ("TBMP") § 704.05(b) (2d ed. rev. 2004) (and the cases cited therein).

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the defendant. See *Carefirst of Maryland Inc. v. FirstHealth of the Carolina Inc.*, 77 USPQ2d 1492, 1498 (TTAB 2005). Opposer's notice of reliance introduces excerpts from the book Wine Atlas of California by James Halliday, published in the United States in 1993 by the Penguin Group, Penguin Books USA Inc. Opposer indicates in the notice that the excerpts would be relied upon to rebut the assertion in "Item One" of applicant's notice of reliance⁷, filed November 23, 2007, regarding the similarity of the marks MAYA and MAYACAMUS for wine, and to demonstrate that the

⁷ Item One [Exhibit 1] consists of a copy of opposer's supplemental responses to applicant's second set of interrogatories, nos. 1 and 4. Applicant indicates that the responses are relied upon, in part, to demonstrate that Opposer does not consider the trademark Mayacamus for wine to be confusing or harmful to the use of its MAYA mark.

Interrogatory 1:

Does Opposer consider the registered trademark MAYACAMUS, Registration No. 1050905, for wine, to be harmful to the commercial use of the mark MAYA, for wine, or in any way confusingly similar to consumers while distinguishing between the two.

Supplemental Response:

Opposer objects to this interrogatory on the grounds that it seeks information which is neither relevant nor likely to lead to the discovery of admissible evidence. Subject to and without waiving this objection, Opposer states that Opposer lacks sufficient information to fully evaluate the potential for harm or consumer confusion between the referenced marks; however, Opposer can state that to date it is unaware of any instances of consumer confusion between them.

term "Mayacamus" describes and refers to a well documented wine-growing region of California.

Applicant appears to be under the misapprehension that opposer may only rebut evidence in the form of testimony. That is not the case. Evidence in support or defense of claims in a Board proceeding may be made of record by several means, including a notice of reliance. See generally, TBMP Chapter 700 (2d ed. rev. 2004). We find that the evidence attached to opposer's rebuttal notice of reliance as to the geographical meaning of the term "Mayacamus" in relation to wine explains opposer's position with regard to the MAYACAMUS trademark, introduced by applicant in his November 23, 2007 notice of reliance.

Accordingly, applicant's motion to strike is denied.

Notices of Reliance

In a Board proceeding, certain materials may be made of record pursuant to a notice of reliance. However, the categories of materials which may be introduced under a notice of reliance are limited. They consist only of an adverse party's discovery deposition, answer to an interrogatory or admission to a request for admission⁸; printed publications⁹; and official records.¹⁰ Within this framework, we consider the evidence of record.

⁸ See Trademark Rule 2.120(j)(3)(i).

⁹ See Trademark Rule 2.122(e).

¹⁰ *Id.*

Opposer's Notices of Reliance

1. Opposer's notice of reliance, filed November 13, 2007, on (1) portions of the discovery deposition transcript of applicant [Exhibit 1]; (2) a copy prepared and issued by the Patent and Trademark Office showing current status and title of pleaded Registration No. 2508401 [Exhibit 2]; (3) an excerpt from The Women's Encyclopedia of Myths and Secrets [Exhibit 3]; (4) definitions and pronunciation keys for the terms "maya" and "maia" [Exhibits 4 and 5]; (5) web pages from two websites [Exhibits 6 and 7]; and (6) copies of articles from Wine Spectator magazine [Exhibits 8 through 15].

2. Opposer's rebuttal notice of reliance, filed January 8, 2008, on excerpts from the Wine Atlas of California.

Applicant's Notices of Reliance

1. Applicant's notice of reliance, filed November 5, 2007, on (1) excerpts from the Oxford English Dictionary [Exhibit 1]; (2) copies of web pages from various websites, including Wikipedia [Exhibits 2, 3, 5, 7, 10, and 11]; (3) an unreferenced copy of a John Keats poem [Exhibit 4]; (4) opposer's responses to applicant's first set of interrogatories nos. 8 and 9 and fourth set of interrogatories nos. 11, 12, 13 and 14 [Exhibits 6 and 8]; (5) a printout from the Trademark Electronic Search System

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(TESS) of Registration No. 1050905 [Exhibit 9]; (6) opposer's responses to applicant's first request for admissions no. 9 [Exhibit 12]; and (7) opposer's supplemental responses to applicant's first request for admissions nos. 2 and 3 and fourth set of interrogatories no. 11 [Exhibit 13].

2. Applicant's notice of reliance, filed November 13, 2007, on (1) copies of newspaper and periodical articles about MAYA wine [Exhibits 1, 3 and 4]; and (2) a copy of a letter from applicant to opposer [Exhibit 2].

3. Applicant's notice of reliance, filed November 15, 2007, on (1) a copy of the annual report to the State of North Carolina for Maia, LLC [Exhibit 1]; (2) copies of a Watershed Protection Permit and a zoning permit issued by Burke County, North Carolina [Exhibits 2 and 3]; (3) copies of wine labels for MAIA wine [Exhibit 4]; (4) copies of packing lists for farm equipment, labeling supplies and storage supplies [Exhibit Nos. 5, 8 and 10]; (5) copies of invoices for bottling supplies and plant tissue [Exhibit Nos. 6 and 7]; and (c) a copy of a purchase contract for nursery supplies [Exhibit 9].

4. Applicant's notice of reliance, filed November 26, 2007, on (1) opposer's supplemental responses to applicant's second set of interrogatories 1 and 4 [Exhibit 1]; and (2) a printout from the website for the Theoi Project [Exhibit 2].

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5. Applicant's notice of reliance (also filed November 26, 2007) on documents marked confidential, namely, (1) opposer's responses to applicant's first set of interrogatories nos. 2, 3, 4, 6 and 7 [Exhibit 1]; and (2) opposer's response to applicant's first request for production of documents, nos. 1, 2, 3 and 10 [Exhibit 2].

Trademark Rule 2.122(e)¹¹ allows for the submission of "printed publications" or "official records" by a notice of reliance because they are self-authenticating, may be submitted by notice of reliance. We therefore find as follows:

(1) The Internet excerpts consisting primarily of web pages from various websites submitted by both parties are not self-authenticating in nature and, thus, are not admissible by notice of reliance. *Raccioppi v. Apogee Inc.*, 47 USPQ 1368, 1370 (TTAB 1998). Accordingly, Exhibits 6 and 7 of opposer's notice of reliance, filed November 13, 2007, as well as Exhibits 2, 3, 5, 7, 10 and 11 of applicant's notice of reliance, filed November 5, 2007, are not properly

¹¹ Trademark Rule 2.122(e) provides, in part, as follows:

Printed publications and official records.
Printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue, may be introduced in evidence by filing a notice of reliance on the material being offered.

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of record and therefore have not been considered in this decision.

(2) Copies of applicant's wine labels, packing slips, invoices and a purchasing contract are not self-authenticating printed publications or official records and may not be made of record by notice of reliance.

Accordingly, Exhibits 4 through 9 of applicant's notice of reliance, filed November 15, 2007, are not properly of record and therefore have not been considered in this decision.

(3) The unreferenced copy of the Keats poem is neither a printed publication nor an official record and accordingly may not be made of record by notice of reliance.

Accordingly, Exhibit 4 of applicant's November 5, 2007 notice of reliance is not properly of record and therefore has not been considered.

Last, we consider applicant's evidentiary objections. We need not, however, consider the objections to those documents which we have found to be not properly of record because they cannot be submitted via notice of reliance. Accordingly, we will not further consider applicant's objections to Exhibits Nos. 6 and 7 of opposer's notice of reliance.¹² Hence, the only remaining objection is to

¹² In addition, applicant's objection to opposer's rebuttal notice of reliance on the ground that it is improper

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exhibit 3 of applicant's notice of reliance, i.e., the excerpt from the Women's Encyclopedia of Myths and Secrets, on the grounds of "incompetence and/or hearsay." These objections are overruled. Although, a printed publication is usually only admissible for what it shows on its face, the excerpt falls within an exception to the hearsay rule. That is, the Board may properly take judicial notice, for the truth of the matter stated therein, of information appearing in standard reference works, such as encyclopedias and treatises. See e.g., *In re Hartop & Brandes*, 311 F.2d 249, 135 USPQ 419, 420 n.6 (CCPA 1962). We find that opposer, by its notice of reliance, is essentially requesting the Board to take judicial notice of the factual information contained in the excerpts from the Women's Encyclopedia of Myths and Secrets, and we have taken judicial notice and have considered the excerpt for its appropriate probative value.

With respect to the material, as outlined above, that we have not considered in this decision, we note that even if we had considered those submissions, they would not have changed our outcome with respect to opposer's claims.

rebuttal and immaterial is moot, inasmuch as we addressed the issue in our decision on applicant's motion to strike.

DISCUSSION

Opposer's Standing and Priority of Use

We now consider the merits of opposer's Section 2(d) claim. Inasmuch as opposer has properly made its pleaded registration of record, we find that opposer has established its standing to oppose registration of applicant's mark. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *Lipton Industries, Inc. v Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 105 (CCPA 1982). Moreover, because opposer's pleaded registration for the MAYA mark is of record, Section 2(d) priority is not an issue in this case as to the goods identified therein. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all the probative 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). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §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.*

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Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We first consider the *du Pont* factors which pertain to the similarity or dissimilarity of the goods, channels of trade and classes of purchasers. It is well settled that likelihood of confusion is determined on the basis of the goods as identified in the application and in the pleaded registration. *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002). Herein, the goods identified in the application are "wine." The goods identified in opposer's pleaded registration are "wine." Thus, the goods are legally identical.

Despite the identity of the goods, applicant attempts to claim that the comparison of the goods should not be based on the respective identifications but rather on the basis of "actual use" of the respective marks on or in relation to wine products." Applicant particularly argues that there is no likelihood of confusion because opposer's mark is used "exclusively" on a wine that is a blend of the red grapes Cabernet Sauvignon and Cabernet Franc and is produced in the Napa Valley of California, whereas its mark is not, and never has been, used in connection with that well known blend or in connection with any grapes from that distinct wine producing region. This argument is unavailing. An applicant may not restrict the scope of the

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goods covered in the cited registration by argument or extrinsic evidence. See *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986).

Applicant similarly attempts to claim that the parties' respective goods travel in different trade channels and to different classes of consumers. However, because the identical identifications of goods in the pleaded registration and applicant's application are not restricted as to channels of trade or classes of purchasers, we must presume that both opposer's wine and applicant's wine will travel in the same channels of trade and have the same methods of distribution, including high-end boutiques, wine shops and grocery stores, and will be offered to the same consumers, namely ordinary purchasers seeking wine. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

We thus find the *du Pont* factors of the similarity of the goods, channels of trade and classes of purchasers strongly favor opposer.

With respect to the conditions under which the parties' goods will be purchased, applicant contends that given the sophistication of opposer's customers [due to higher-end pricing and limited availability of opposer's wine], they are "fully cognizant of the 'Maya' brand, as distinguished from any others." (Brief p. 14). As noted above, in the absence of any limitations in the identification of the

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pleaded registration, it must be presumed that opposer's wine will include inexpensive varieties that will be purchased by ordinary consumers. These ordinary consumers would be expected to exercise no more than ordinary care when selecting opposer's wine.

Accordingly, this *du Pont* factor is neutral or, at best, slightly favors opposer.

We next consider the similarity of the marks, keeping in mind that when marks would appear on identical goods, as they do here, the degree of similarity necessary to support a conclusion of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). In determining the similarity or dissimilarity of the marks, we must consider the marks in their entireties in terms of sound, appearance, meaning and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). 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 their entireties 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. *Sealed Air Corp. v.*

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Scott Paper Co., 190 USPQ 106 (TTAB 1975). That is, the purchaser's fallibility of memory over a period of time must be kept in mind. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); and *Spoons Restaurant Inc. v. Morrison Inc.*, 23 USPQ2d 1735 (TTAB 1991), aff'd unpub'd (Fed. Cir., June 5, 1992).

Obviously, the marks differ in appearance. Opposer's pleaded mark is MAYA and applicant's applied-for mark is MAIA. However, the difference between the two is not particularly significant when we consider the overall similarities. The marks are similarly constructed. Each mark contains two syllables comprised of four letters - three in common, and both begin with the letters "MA" and end with the letter "A." The only difference being them is that the third letter in opposer's mark is a "Y," while the third letter in applicant's mark is an "I." It is unlikely that consumers will focus on this difference because the different letters are imbedded in the middle of both marks. Applicant argues that the marks are distinctly different in appearance because his mark "is in the standard character mark, which is lower case, wherein the letters 'i' and 'y' are distinctly different in appearance" and because he "is not applying for registration of a design at this time." (Brief at p. 10). As opposer points out, the fact that applicant seeks registration of his mark in standard

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character format, as does opposer, means that neither party is limited to any particular manner of display. See *Phillips Petroleum Co. v. C. J. Webb, Inc.* 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971) (When a word mark is registered in typed form, the Board must consider all reasonable modes of display that could be represented.). Thus, both parties could display their marks in similar lettering. In addition, neither party's mark includes a design element. As a result, any design element that opposer may utilize in the marketplace does not limit the scope of its pleaded registered MAYA mark in any way. Quite simply, the difference in the parties' marks is not so significant that it is likely to be noted or remembered by purchasers upon seeing the marks at different times.

In addition, MAYA and MAIA may be pronounced the same. While the marks could be pronounced differently, as applicant urges, it is settled that there is no correct pronunciation of a trademark, as it is impossible to predict how the public will pronounce a particular mark. *Kabushiki Kaisha Hattori Tokeiten v. Acuotto*, 228 USPQ 461 (TTAB 1985). Thus, even if marks may be pronounced differently, they also may be pronounced in the same manner. Therefore, for our purposes, the parties' marks are phonetically identical.

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Further, as regards the connotation and commercial impression of the marks, given the substantial similarity in the appearance of both marks and identity in sound between the two, and the because both opposer's mark MAYA and applicant's mark MAIA are arbitrary in relation to wine, we find the marks substantially similar in connotation and overall commercial impression.

Applicant maintains that the marks have distinctly different meanings and origins as either common nouns or proper nouns. Applicant particularly contends that The Oxford English Dictionary defines the common noun "maia" as "a spider-crab" and the common noun "maya" as "Illusion: a prominent term in Hindu philosophy." (Exhibit 1, Applicant's not. of rel., filed November 5, 2007); and that the proper noun "Maia" has its origin in Greek mythology and identifies the mother of Hermes, one of the seven Pleiades, whereas "Maya" has its origin in India and identifies the mother of Buddha. Opposer, on the other hand, maintains that the terms "maia" and "maya" have an overlap in meaning, notwithstanding their different origins. Both terms, opposer contends, "are religious references to the virgin mothers of well-known spiritual or historical persons, and both MAYA and MAIA were individuals regarded in their respective cultures as goddesses in their own right." (Brief at p. 5). As noted above, and confirmed by the

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parties' arguments and evidence, both MAYA and MAIA are arbitrary for wine and, accordingly, it is unlikely that consumers will appreciate any difference in connotations or commercial impressions of the parties' respective marks.

Thus, the *du Pont* factor of similarity of the marks favors opposer.

The next *du Pont* factor to consider is the strength of opposer's MAYA mark. Opposer contends that its mark is arbitrary, and therefore strong and entitled to a wide scope of protection. Opposer also maintains that its MAYA mark is well-known among the relevant purchasing public, namely, consumers of wine. Opposer particularly contends that:

During Opposer's continuous use of its MAYA mark on wine for the past sixteen years, the wine has come to be regarded as one of California's top red wines, receiving a substantial amount of unsolicited media attention and public recognition ... Most recently, Opposer's MAYA wine was named one of Napa Valley's Top 50 Cabernets by Wine Spectator magazine in 2006, being named the seventh best Napa Valley Cabernet for the period 1990-2003.

(Brief at p. 12, citing to Exhs. 8-15 of Opposer's not. of rel., filed November 13, 2007 and Exhs. 1, 3 and 4 of Applicant's not. of rel., filed November 13, 2007). While opposer's MAYA wine has been rated by Wine Spectator magazine as a top California wine for many years, and has been touted in several publications as a superior wine, the

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record does not support a finding that opposer's wine is famous.

Thus, the *du Pont* factor of fame is neutral.

Considering next the number and nature of similar marks in use on similar goods, applicant has made of record a TESS copy of a single third-party registration [Registration No. 1050905] for the mark MAYACAMUS for "wine." Applicant maintains that:

When the Board considers that a Registered Trademark exists that is identical to Opposer's Maya mark in every conceivable respect, that it holds priority over Opposer's mark, and that Opposer never opposed it, the Board will conclude that Opposer's action against Applicant's Maia mark is arbitrary and inexplicable, and the Applicant prevails in the sixth test.

(Brief at p. 16). While third-party registrations may be used to demonstrate that a portion of a mark is suggestive or descriptive, they are not evidence that the marks shown therein are in use or that the public is aware of them. See *AMF Incorporated v. American Leisure Products, Inc.*, 177 USPQ 268, 269 (CCPA 1973) ["little weight is to be given such registrations in evaluating whether there is likelihood of confusion."]. In any event, the MAYACAMUS mark in the sole proffered third-party registration is not as similar to applicant's pleaded mark as is applicant's mark. As our principal reviewing court noted in *Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001), "[e]ven if some

prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind this Board or this court."

Further, to the extent that applicant is arguing that opposer's failure to oppose registration of the MAYACAMUS mark entitles it to registration of his mark, we find such argument unpersuasive. This proceeding involves opposer's opposition to applicant's registration. Opposer's failure to oppose a registration of a substantially different mark is irrelevant.

This *du Pont* factor thus favors opposer.

Last, applicant has admitted that he has yet to use the MAIA mark in commerce in connection with the sale of his wine.¹³ Accordingly, and contrary to applicant's contention, the *du Pont* factors of the nature and extent of any actual confusion and the length of time during and conditions under which there has been concurrent use without evidence of actual confusion are neutral.

When all of the relevant *du Pont* factors are considered, we conclude that contemporaneous use by applicant of the mark MAIA for wine is likely to cause

¹³ Applicant stated in his deposition that he has never shipped, sold or commercially produced wine under the MAIA mark. (Opposer's not. of rel., Exhibit 1, citing to the Maya deposition pp. 8-10, 13-15, 21, 24, 33-34, 37 and 39).

confusion with opposer's use of its MAYA mark with respect to wine.

NON-USE OF THE MAIA MARK IN COMMERCE

We now address the issue of whether applicant is entitled to registration of its mark pursuant to Section 1(a) of the Trademark Act. Opposer maintains that applicant failed to make a bona fide use of his MAIA mark in commerce prior to the filing of his use-based application for registration of the MAIA mark under Section 1(a) and, thus, the opposition should be sustained.

Applicant, on the other hand, "acknowledges that its [sic] use basis falls in a 'gray area' of interpretation" and request the Board to consider the entirety of the circumstances. (Brief, p. 23). Applicant explains that:

Federal permitting is required before wine can be sold or shipped across state lines. Such permitting is not practical until the quantity of wine produced is sufficient to warrant it. Consequently, use under these circumstances is limited to applying the mark to wine labels, maintaining an internet website and corresponding domain name, conducting business transactions that do not involve the sale of alcoholic beverages, and transporting wine within the state of production for promotional purposes.

(Id.)

Pursuant to Section 45 of the Trademark Act, "... a mark shall be deemed to be in use in commerce on goods when- (A) it is placed in any manner on the goods or their containers

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or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods of their sale, and (B) the goods are sold or transported in commerce.” 15 U.S.C. § 1127(1). As indicated previously, applicant, during his August 14, 2006 deposition, admitted that he had yet to sell, ship or commercially produce any wine under the MAIA mark. (Exh. 1 to opposer’s not. of rel., filed November 13, 2007, citing to the Maya deposition, pp. 14, 24 and 33). We thus find that, at least as of August 14, 2006, applicant had not used his MAIA mark in commerce as defined by Section 45. Because applicant had not used his mark as of the filing date of his use-based application, applicant was not entitled to seek registration under Trademark Act Section 1(a).¹⁴

Decision: The opposition is sustained as to both opposer’s Section 2(d) claim and its claim based on applicant’s failure to make bona fide use of its mark in commerce prior to his filing for registration of the MAIA mark under section 1(a).

¹⁴ Applicant requested, in the event the Board found that he misinterpreted the rule regarding use in commerce, that he be allowed to amend his application basis to Section 1(b). Opposer indicates that it does not consent to the requested amendment. We find the request inappropriate at this late stage of the proceeding. Moreover, inasmuch as we have found the parties’ respective marks confusingly similar, the request is moot.