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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Goya Foods, Inc.
v.
Holland Coffee, Inc.

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Cancellation No. 92030908

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John M. Rannells of Baker and Rannells for Goya Foods, Inc.

George H. Willekes for Holland Coffee, Inc.

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Before Quinn, Rogers and Zervas, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Goya Foods, Inc. petitioned to cancel, on October 30, 2000, a registration owned by Holland Coffee, Inc. for the mark GAYO MOUNTAIN COFFEE ("COFFEE" disclaimed) covering "coffee beans."[1] The registration issued pursuant to a claim of acquired distinctiveness.

As grounds for cancellation, petitioner alleged that respondent's mark, as used in connection with respondent's goods, so resembles petitioner's previously used and registered GOYA marks for a wide variety of food and

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[1] Registration No. 2313558, issued February 1, 2000; Section 8 affidavit accepted.

beverage products, including coffee, that confusion is likely to occur in the marketplace. Petitioner also alleged the following grounds: that respondent's mark dilutes the distinctive quality of petitioner's marks; that respondent's mark is generic; and that respondent's mark is primarily geographically descriptive, and that the mark has not acquired distinctiveness.

Respondent, in its answer, denied the salient allegations of the petition for cancellation.[2]

The record consists of the pleadings; the file of the registration sought to be cancelled; trial testimony, with related exhibits, taken by petitioner; and status and title copies of certain of petitioner's registrations, and excerpts from printed publications, all introduced by way of petitioner's notices of reliance. Respondent did not take testimony or offer any other evidence.[3] Only petitioner filed a brief. An oral hearing was not requested.

Petitioner was founded in 1939. According to the testimony of Conrad Colon, petitioner's vice president of sales and marketing, petitioner has become the number-one

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[2] Respondent also set forth allegations captioned as "affirmative defenses" in its answer. Inasmuch as respondent did not pursue these defenses at trial, we consider them waived.

[3] Evidence submitted in connection with a motion for summary judgment is of record only for purposes of that motion. Thus, in this case, the evidence submitted by the parties in connection with the earlier motion for summary judgment does not form part of the evidentiary record to be considered at final hearing. Hard Rock Café Licensing Corp. v. Elsea, 48 USPQ2d 1400, 1404 (TTAB 1998). See TBMP § 528.05(a)(2d ed. rev. 2004).

rated Hispanic company in the United States. Mr. Colon testified that the company's stature earned it a place in an exhibit at the Smithsonian Institute's National Museum of American History. Petitioner sells a wide variety of food and beverage products, including coffee, throughout the United States. Petitioner's coffee, as well as its other food and beverage products, is sold through every type of retail food outlet, ranging from mom-and-pop stores to major supermarket chains. Petitioner's sales figures for the last four years average over $500 million annually, with annual sales of coffee averaging about $3.7 million. Petitioner's products, including coffee, are promoted under the GOYA marks through print media, television and radio advertisements, and through appearances at trade shows. Over the years, petitioner also has utilized coupons, in-store demonstrations, its Internet website, billboards, and ads on the sides of trucks, as well as the distribution of promotional products such as cookbooks, clothing and toys. In addition, petitioner, in conjunction with its GOYA marks, has sponsored various community and charitable events. Petitioner's most recent annual advertising expenditures exceeded $11 million and, in a recent five-year period, the annual expenditures averaged $7.5 million. In 2002, the only year given for such expenditures in connection with coffee, petitioner spent $160,000.

There is no information about respondent or its business activities. Respondent's claim of acquired distinctiveness of its mark for coffee under Section 2(f) was based solely on a declaration of seven years of substantially exclusive and continuous use of the mark, including a statement that respondent had sold 5,000 tons of product under the mark.

Given the evidence of petitioner's extensive use of its GOYA marks on a wide variety of food and beverage products, petitioner has established its standing to bring the claims raised in the petition for cancellation.

Priority

Inasmuch as both petitioner and respondent own registrations, petitioner does not necessarily have priority simply because it owns a registration. National Rural Electric Cooperative Ass'n. v. Suzlon Wind Energy Corp., 78 USPQ2d 1881, 1883 (TTAB 2006); and Brewski Beer Co. v. Brewski Brothers, Inc., 47 USPQ2d 1281, 1284 (TTAB 1998). In the present case, because respondent has not submitted any evidence of an earlier priority date, the earliest date upon which it can rely is the filing date of its application (August 21, 1998).[4] Intersat Corp. v. International

[4] Given that respondent has claimed acquired distinctiveness, even this date may be problematic for purposes of respondent's priority date. See: Hoover Co. v. Royal Appliance Manufacturing Co., 238 F.3d 1357, 57 USPQ2d 1720, 1721-22 (Fed. Cir. 2001); Towers v. Advent Software Inc., 17 USPQ2d 1471 (TTAB 1989),

Telecommunications Satellite Organization, 226 USPQ 154, 156 n. 5 (TTAB 1985). Not only are the issuance dates of most of petitioner's registrations earlier than this filing date, but Mr. Colon's testimony establishes petitioner's use of the mark GOYA for various food and beverage products, including coffee, long prior to August 21, 1998.

Accordingly, petitioner has established priority of use.

Likelihood of Confusion

Our determination under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), is based on an analysis of all of the 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). Petitioner must establish that there is a likelihood of confusion by a preponderance of the evidence. In any likelihood of confusion analysis, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). These, and other du Pont factors deemed pertinent in the proceeding now before us, are discussed below.

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aff'd, 913 F.2d 942, 16 USPQ2d 1039 (Fed. Cir. 1990); and Perma Ceram Enterprises Inc. v. Preco Industries Ltd., 23 USPQ2d 1134, 1138 (TTAB 1992).

With respect to the goods, we focus on the fact that petitioner sells coffee under its mark. As often stated, Board proceedings are concerned with registrability and not use of a mark and, thus, the common identification of goods in the involved registrations frames the issue. Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A., 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Among petitioner's many registrations, two are for the mark GOYA covering "coffee."[5] As identified, "coffee" is legally identical to respondent's "coffee beans" for purposes of our likelihood of confusion determination. This factor weighs heavily in petitioner's favor.

In the absence of any limitations in the parties' identifications of goods, we must presume that the goods move through all reasonable trade channels for such goods to all usual classes of consumers for such goods. Schieffelin & Co. v. Molson Companies Ltd., 9 USPQ2d 2069, 2073 (TTAB 1989); Morton-Norwich Products, Inc. v. N. Siperstein, Inc., 222 USPQ 735, 736 (TTAB 1984); and In re Elbaum, 211 USPQ 639, 640 (TTAB 1981)["[W]here the goods in a cited registration are broadly described and there are no limitations in the identifications of goods as to their

[5] Registration No. 764033, issued January 28, 1964; renewed; and Registration No. 1689199, issued May 26, 1992; renewed.

nature, type, channels of trade or classes of purchasers, it is presumed that the scope of the registration encompasses all goods of the nature and type described, that the identified goods move in all channels of trade that would be normal for such goods, and that the goods would be purchased by all potential customers."]. Accordingly, we presume that the parties' coffee and coffee beans are sold in the same trade channels to the same classes of purchasers. The purchasers would include ordinary ones who would exercise nothing more than ordinary care when buying coffee. These factors weigh in petitioner's favor.

Further, coffee is a relatively inexpensive item that is subject to impulse purchase and frequent replacement. This factor contributes to the likelihood of confusion among consumers in the marketplace.

We next turn to determine whether petitioner's mark GOYA and respondent's mark GAYO MOUNTAIN COFFEE, when compared in their entireties in terms of appearance, sound, connotation, and commercial impression, are similar or dissimilar. Palm Bay Import, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 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 terms of their overall commercial impression that

confusion as to the source of the goods offered under the respective marks is likely to result. San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp., 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); and Spoons Restaurants Inc. v. Morrison Inc., 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992).

Additionally, where, as in the present case, the marks are applied to legally identical goods, the degree of similarity between the marks which is necessary to support a finding of likely confusion declines. Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1994).

Respondent's mark GAYO MOUNTAIN COFFEE begins with a word similar to petitioner's mark GOYA in terms of sound and appearance. The words are similarly constructed with two syllables; the only difference between GAYO and GOYA is the transposition of the vowels "A" and "O."

Because "COFFEE" is a generic term for respondent's goods, and therefore has no source-identifying significance, and further because "MOUNTAIN" describes or suggests the origin of the coffee (that coffee beans are grown in mountainous regions), GAYO is the dominant element of respondent's mark. While we acknowledge that, in determining the issue of likelihood of confusion, the marks

must be considered in their entireties, it is well established that there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark. See In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). When we consider the marks in their entireties, but give appropriate weight to the dominant element GAYO in respondent's mark, we find that respondent's mark is similar to petitioner's mark. In finding that the marks are similar, we have kept in mind the fallibility of human memory. 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. Scott Paper Co., 190 USPQ 106 (TTAB 1975).

In sum, the marks are similar in sound, appearance and overall commercial impression. These similarities outweigh any differences there might be in terms of meaning (if, in fact, respondent's mark has any geographic meaning--see discussion infra).

Mr. Colon testified about the notoriety of petitioner's mark. Petitioner has been selling food and beverage products under its mark for over 65 years; it currently sells more than 1100 products. As noted earlier, petitioner's annual sales are significant, and it has extensively promoted its mark and goods sold thereunder.

Further, the record is devoid of any third-party uses or registrations of GOYA or similar marks. In sum, the record establishes that petitioner's mark is, in petitioner's words, "strong and distinctive." (Brief, p. 22).

We conclude that consumers familiar with petitioner's coffee sold under the mark GOYA would be likely to believe, upon encountering respondent's coffee beans sold under the mark GAYO MOUNTAIN COFFEE, that the goods originate with or are associated with or sponsored by the same entity.

Dilution

Having determined that petitioner is entitled to prevail in this cancellation proceeding based upon its Section 2(d) claim of likelihood of confusion, we need not reach the merits of petitioner's dilution claim. See American Paging Inc. v. American Mobilphone Inc., 13 USPQ2d 2036, 2039-40 (TTAB 1989), *aff'd without opinion*, 17 USPQ2d 1726 (Fed. Cir. 1990).

Geographical Descriptiveness/Insufficient 2(f)

Petitioner contends that the registered mark GAYO MOUNTAIN COFFEE is primarily geographically descriptive, and that the mark lacks acquired distinctiveness. Respondent's claim of acquired distinctiveness of the mark GAYO MOUNTAIN COFFEE was supported by the declaration of George Willekes, respondent's president. Mr. Willekes states that respondent's mark has been in substantially exclusive and

continuous use for a period of over seven years since at least as early as March 14, 1992, and that during those seven years, respondent sold over 5,000 tons of goods under the mark.

The only evidence introduced by petitioner in support of this claim is listed in its third notice of reliance. The evidence comprises excerpts from printed publications.[6]

We initially note that printed publications made of record by notice of reliance under Trademark Rule 2.122(e) are admissible and probative only for what they show on their face, not for the truth of the matters contained therein, unless a competent witness has testified to the truth of such matters. See, e.g., Logicon, Inc. v. Logisticon, Inc., 205 USPQ 767, 768 n. 6 (TTAB 1980). See also TBMP § 704.08 (2d ed. rev. 2004). Accordingly, there is a hearsay problem with petitioner's evidence, namely, that petitioner has relied upon the printed publications to prove the truth of the matter asserted, that is, that GAYO MOUNTAIN is a geographic location where coffee beans are

[6] Petitioner, in its brief, refers to certain other evidence that the examining attorney introduced in the underlying application in support of the geographical descriptiveness refusal to register the mark. Petitioner failed, however, to directly introduce this evidence in the cancellation proceeding. Although the file of the registration sought to be cancelled automatically is part of the record before us, the documents to which petitioner refers were not properly introduced by petitioner as evidence in the cancellation proceeding. See British Seagull Ltd. V. Brunswick Corp., 28 USPQ2d 1197, 1200 (TTAB 1993), *aff'd*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994), *cert. denied*, 514 U.S. 1050 (1995). See also TBMP § 704.04 (2d ed. rev. 2004).

grown, and that consumers would make a goods/place association between respondent's mark and coffee beans.[7]

Moreover, and in any event, we find that the petitioner's evidence is not of such quality or quantity to show that respondent did not make a sufficient showing of acquired distinctiveness under Section 2(f). It initially should be noted that where a respondent owns a registration based on acquired distinctiveness, the statute accepts a lack of distinctiveness as an established fact. Yamaha International Corp. v. Hoshino Gakki Co., 840 F.2d 1571, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988). Thus, petitioner was not required to advance evidence of geographical descriptiveness, but rather could concentrate its case on the question of acquired distinctiveness. Further, as explained in Yamaha, when matter proposed for registration under Section 2(f) is approved by the USPTO for publication, there is a presumption that the examining attorney found a prima facie case of acquired distinctiveness. Id., 6 USPQ2d at 1004. In an inter partes proceeding, the plaintiff has the initial burden to establish prima facie that the applicant did not satisfy the acquired distinctiveness requirement of Section 2(f). Id., 6 USPQ2d at 1005. As

[7] Petitioner relies upon the same evidence to support its claim of genericness. Suffice it to say, the evidence falls far short of the "clear evidence" that is required to establish genericness. See In re Merrill Lynch, Pierce, Fenner & Smith Inc., 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987).

further explained in Yamaha, "[I]f the [plaintiff] does present its prima facie case challenging the sufficiency of [defendant's] proof of acquired distinctiveness, the [defendant] may then find it necessary to present additional evidence and argument to rebut or overcome the [plaintiff's] showing." Id. See Duramax Marine, LLC v. R.W. Fernstrum & Co., ___USPQ2d___ (Opp. No. 91119899, TTAB Aug. 4, 2006).

In the present case, we find that petitioner failed to make its prima facie case; thus, respondent was under no burden to rebut petitioner's showing.

Conclusion

The petition for cancellation is granted on the ground of priority and likelihood of confusion. The petition is denied on the ground of geographical descriptiveness and insufficient claim of acquired distinctiveness. The petition is denied on the ground of genericness.

Registration No. 2313558 will be cancelled in due course.