

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB

JULY 3, 1997

Hearing:  
November 20, 1996

Paper No. 37  
EJS

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Rudolf Wild GmbH & Co. KG

v.

TransNational, Inc.

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Opposition No. 91,754  
to application Serial No. 74/286,888  
filed on June 22, 1992

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Susan A. Richards of Fish & Richardson, P.C. for Rudolf Wild  
GmbH & Co. KG.

Gary D. Krugman of Sughrue, Mion, Zinn, MacPeak & Seas for  
TransNational, Inc.

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Before Simms, Seeherman and Walters, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Rudolf Wild GmbH & Co. KG has opposed the application  
of TransNational, Inc. to register CALIFORNIA SUN as a  
trademark for cola and other carbonated soda beverages.<sup>1</sup> As  
grounds for opposition, opposer has alleged that it first

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<sup>1</sup> Application Serial No. 74/286,888, filed June 22, 1992, based  
on an asserted bona fide intention to use the mark in commerce.

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used the mark CAPRI SUN for fruit drinks as early as August 31, 1978, which date is earlier than the June 22, 1992 filing date of applicant's intent-to-use application; that it has continuously used the mark in connection with fruit drinks since 1978; that it owns a number of registrations for marks consisting of or containing the words CAPRI SUN for fruit drinks; that each of these marks is part of a family of marks;<sup>2</sup> that opposer began using its CAPRI SUN family of marks prior to the filing date of applicant's CALIFORNIA SUN application; that applicant's mark CALIFORNIA SUN so resembles opposer's CAPRI SUN family of marks as to be likely, when used on or in connection with applicant's goods, to cause confusion, or to cause mistake, or to deceive; and that CALIFORNIA in CALIFORNIA SUN identifies a geographic area, as do the names MAUI and PACIFIC which are elements of names used as flavor designations in the CAPRI SUN line of fruit drinks.

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

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<sup>2</sup> Although opposer alleged a family of marks in its notice of opposition, it made no reference to such a claim in its brief and, indeed, it presented no evidence of the existence of a family of marks, i.e., that it has promoted its marks together in such a manner that the public would regard a particular element of the marks as the family surname. It appears that opposer has merely used "family of marks" as a phrase to refer to its various CAPRI SUN marks. In any event, to the extent that opposer was attempting to claim a family of marks, as that term is understood in trademark law, we deem that claim to have been waived.

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The record includes the pleadings; the file of the opposed application; the testimony, with exhibits, of Robert Sanguily, an associate product manager of Kraft Foods, Inc. Opposer made of record, pursuant to notices of reliance, status and title copies of the following registrations (with the design marks shown in very reduced size) owned by opposer:<sup>3</sup>

MARK	GOODS
CAPRI-SUN	fruit drinks containing water and orange juice <sup>4</sup>
CAPRI SUN APPLE and design	fruit drinks containing water and apple juice <sup>5</sup>

<sup>3</sup> The first eight of the listed registrations were pleaded in the notice of opposition. Another of the registrations which was pleaded in the notice of opposition and submitted under a notice of reliance was subsequently cancelled for failure to file a Section 8 affidavit of use. We have not listed this registration since opposer cannot rely on any rights in it. Opposer also submitted under a notice of reliance copies of certain of its applications. Applicant has not objected to their submission, and we have treated the pleadings as being amended pursuant to Rule 15(b) of the Federal Rules of Civil Procedure to include these applications, four of which matured into registrations after opposer's notice of reliance was filed, and which we have listed above as registrations. A fifth application was abandoned for failure to file a statement of use.

<sup>4</sup> Registration No. 1,130,086, issued January 29, 1980; Section 8 affidavit accepted; Section 15 affidavit received.

<sup>5</sup> Registration No. 1,187,978, issued January 26, 1982; Section 8 affidavit accepted; Section 15 affidavit received; "Natural Fruit Drink," "Apple," and the representation of apples disclaimed.

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CAPRI SUN ORANGE and design	fruit drinks containing water and orange juice <sup>6</sup>
CAPRI SUN FRUIT PUNCH and design	fruit juice drinks containing water <sup>7</sup>
CAPRI SUN GRAPE DRINK and design	fruit drink containing water and grape juices <sup>8</sup>

<sup>6</sup> Registration No. 1,199,783, issued June 29, 1982; Section 8 affidavit accepted; Section 15 affidavit received; "Natural Fruit Drink," "Orange" and the representation of oranges disclaimed.

<sup>7</sup> Registration No. 1,279,154, issued May 22, 1984; Section 8 affidavit accepted; Section 15 affidavit received; "Fruit Punch" disclaimed.

<sup>8</sup> Registration No. 1,287,165, issued July 24, 1984; Section 8 affidavit accepted; Section 15 affidavit received; "Grape Drink" and the representation of grapes disclaimed.

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CAPRI SUN and design	fruit drink containing lemon juice and water <sup>9</sup>
CAPRI SUN MAUI PUNCH and design	non-alcoholic fruit juice drink <sup>10</sup>
CAPRI SUN and design	fruit drink containing juice and water <sup>11</sup>
MAUI PUNCH	non-alcoholic fruit drinks or ice drinks <sup>12</sup>
CAPRI SUN MAUI PUNCH	non-alcoholic fruit drinks or ice drinks <sup>13</sup>

<sup>9</sup> Registration No. 1,303,000, issued October 30, 1984; Section 8 affidavit accepted; Section 15 affidavit received; the design of lemons is disclaimed.

<sup>10</sup> Registration No. 1,567,441, issued November 21, 1989; Section 8 affidavit accepted; Section 15 affidavit received; "Maui Punch" disclaimed.

<sup>11</sup> Registration No. 1,660,010, issued October 8, 1991.

<sup>12</sup> Registration No. 1,874,097, issued January 17, 1995.

<p>CAPRI SUN MAUI PUNCH and design</p>	<p>beverages, namely soft drinks, fruit drinks, juice drinks or fruit punch<sup>14</sup></p>
<p>CAPRI SUN ALL NATURAL (stylized)</p>	<p>beverages, namely soft drinks, fruit drinks or fruit punch<sup>15</sup></p>

Opposer also submitted a notice of reliance on certain applications and registrations owned by opposer's licensee, Capri Sun, Inc. for the marks PACIFIC COOLER<sup>16</sup> , MOUNTAIN COOLER<sup>17</sup>, SURFER COOLER<sup>18</sup> and SAFARI PUNCH,<sup>19</sup> all for goods identified as "fruit drinks containing water, fruit juice, soft drinks, soda waters and aerated waters."<sup>20</sup>

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<sup>13</sup> Registration No. 1,969,093, issued April 23, 1996; Section 2(f) as to "Maui Punch."

<sup>14</sup> Registration No. 1,972,251, issued May 7, 1996; Section 2(f) as to "Maui Punch."

<sup>15</sup> Registration No. 1,990,220, issued July 30, 1996; "All Natural" disclaimed.

<sup>16</sup> Registration No. 1,866,532, issued December 6, 1994; "Cooler" disclaimed.

<sup>17</sup> Registration No. 1,869,857, issued December 27, 1994; "Cooler" disclaimed.

<sup>18</sup> Registration No. 1,909,411, issued August 1, 1995; "Cooler" disclaimed.

<sup>19</sup> Registration No. 1,928,917, issued October 24, 1995; "Punch" disclaimed.

<sup>20</sup> Two of the applications submitted with the notice of reliance have since matured into registrations, and we have accordingly listed them as registrations. Applicant has objected to the registrations owned by Capri Sun, Inc. because this company is not a party to the opposition. This objection is not well taken. The registrations are, in fact, official records, and therefore they are appropriate subject matter for a

In addition, opposer has submitted a notice of reliance on applicant's responses to certain of its interrogatories.<sup>21</sup>

Applicant has relied on opposer's responses to certain of applicant's interrogatories, and has made of record numerous third-party registrations for marks which include the term "SUN " as a suffix.

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notice of reliance. See Trademark Rule 2.122(e). Moreover, because opposer has shown that it is in privity with the owner of the registrations, and that its claim of damage with respect to the ground of likelihood of confusion is also based on these registrations, it may rely on these registrations owned by its exclusive licensee. See **Jewelers Vigilance Comm., Inc. v. Ullenberg Corp.**, 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987).

<sup>21</sup> This notice of reliance states that opposer is relying on certain specimens of applicant's packaging and promotional matter which were provided to opposer with applicant's responses to certain of opposer's interrogatories and document production requests. Applicant has objected to the introduction of these materials because responses to document production requests cannot be made of record pursuant to a notice of reliance. See Trademark Rule 2.120(j)(3)(ii). Applicant's objection is well taken. We have carefully considered applicant's responses to the interrogatories, and find that the materials were not submitted in response to these questions, but were provided in response to the document production requests. Further, we are not persuaded by opposer's argument that applicant has waived its right to object to these materials by waiting until the filing of its brief to raise the objection. Objections which would not be curable if seasonably raised can be raised for the first time in the party's brief. In this case, the rules do not permit the filing of a notice of reliance on documents produced in response to document production requests. As for opposer's assertion that these materials were also made of record during the testimony of its witness, that witness did not identify these materials (nor is there reason to believe that he would be in a position to authenticate the materials). On the contrary, it was opposer's attorney who referred to these exhibits, and it was he who stated that they were produced by applicant, and that they would be made of record by notice of reliance.

Thus, although the responses to the interrogatories are properly of record, the materials submitted with the notice of reliance are not. We would also add that, even if these materials were considered of record, they would not change our decision herein.

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The parties have fully briefed the case, and both were represented at an oral hearing before the Board.

Opposer's witness testified that he is an associate product manager with Kraft Foods, Inc., and that "in 1990 Kraft Foods purchased the right to distribute the CAPRI SUN trademark product in both name and package form in the United States under a licensing agreement." He further stated that Capri Sun, Inc. is a wholly owned subsidiary of Kraft Foods, and is the company that has the license from opposer.

CAPRI SUN is a trademark used for a single serve, ready-to-drink juice drink beverage which comes in 6 3/4 ounce pouches into which one inserts a straw. There are currently twelve flavors of this product, with the names STRAWBERRY COOLER, MAUI PUNCH, YO-YOGI, PACIFIC COOLER, FRUIT PUNCH, RED BERRY, GRAPE, WILD CHERRY, MOUNTAIN COOLER, SURFER COOLER, SAFARI PUNCH and ORANGE. The pouches are sold packaged in a 10-pack cardboard carton. The primary consumers of the goods are children aged six to twelve, and the primary purchasers of the product are the mothers of these children.

According to Kraft Foods' business records, the CAPRI SUN product has been distributed in the United States since 1979. It is sold throughout the United States, primarily in grocery stores, but also in mass merchandisers such as Wal-Mart; warehouse accounts such as Sam's or Price Club; food service resellers who service restaurants, hotel

chains, schools and institutions; and U.S. military commissaries. Applicant's wholesale sales of its CAPRI SUN fruit juice drinks rose from \$65.5 million in 1989 to \$161.4 million in 1994.<sup>22</sup> In fact, its CAPRI SUN fruit punch flavor is the best-selling flavor in the entire juice drink single-serve sales category.

Opposer currently advertises the CAPRI SUN beverages on television, and again its promotional figures are extensive, with expenditures during the period of 1989 through 1994 being, with the exception of 1992 and 1993, in excess of \$1 million.<sup>23</sup> CAPRI SUN pouches are packaged as part of Oscar Mayer Lunchables food packs, and these Lunchables items have been advertised in Sunday newspaper advertising supplements. The beverages are also promoted through point of sale ads, and aisle displays.

Applicant has not put in any evidence as to its own marketing and sales; we note that the application was based on an asserted intention to use the mark.

Priority is not in issue in view of opposer's registrations. See **King Candy Co. v. Eunice King's Kitchen, Inc.**, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Moreover, the evidence shows that opposer began using its CAPRI SUN marks, as well as many of its flavor marks, prior to the

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<sup>22</sup> Although opposer submitted its sales and advertising figures as "confidential" material, it referred to the above figures in its (non-confidential) brief. Accordingly, we see no reason not to repeat these figures in our opinion.

<sup>23</sup> See footnote 4.

filing date of applicant's application which, in the absence of any other evidence of use, is the earliest date on which applicant can rely.

With respect to the issue of likelihood of confusion, we turn first to a consideration of the marks. The only common elements of opposer's CAPRI SUN marks and applicant's CALIFORNIA SUN mark is that both start with the letter "C," and have SUN as the second word. SUN, however, is a suggestive term for beverages, as shown by the numerous third-party registrations made of record by applicant.<sup>24</sup> While these registrations do not prove that the marks shown in the registrations are in use (and, indeed, some of the registrations have been cancelled or have expired), they are competent, in the same manner as dictionary definitions, to show that a particular term has a particular significance for those in the beverage industry, and that the term has been adopted by those in the field to convey that significance. See **Mead John & Company v. Peter Eckes**, 197 USPQ 187 (TTAB 1977). Accordingly, the mere fact that SUN has been included in applicant's and opposer's marks is not,

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<sup>24</sup> These registrations include TEX SUN for canned fruit juices for food purposes; WHOLE SUN for canned single strength citrus fruit juices and frozen concentrates; DAILY SUN for canned and frozen citrus juices; ROYAL SUN for orange flavored food drink; DAILY SUN for canned and frozen citrus juices; SOUTHERN SUN for fresh and reconstituted orange juice and fresh and reconstituted fruit and vegetable juices; ALLSUN for concentrated fruit juice; HAWAIIAN SUN for fruit drinks containing water and fruit punch containing water; FLORIDA SUN for citrus-flavored fruit juices and frozen fruit juice concentrate; GEORGIA SUN and design for frozen concentrated fruit juices; ORCHARD SUN for fruit juice drinks containing water; and MOUNTAIN SUN for natural fruit juice drinks.

of itself, a sufficient basis on which to find likelihood of confusion. See, **Cutter Laboratories, Inc. v. Air Products and Chemicals, Inc.**, 189 USPQ 108 (TTAB 1975).

When the marks are considered in their entirety, we find that they are different in appearance, pronunciation and connotation. We are not persuaded by opposer's argument that the marks convey similar commercial impressions. As the dictionary definition referred to by opposer states,<sup>25</sup> "Capri" is "an island in ... the Bay of Naples," which is part of Italy. California, on the other hand, is a state of the United States. The connotation between an Italian island and a state of the United States is very different. Nor do we think that opposer's use of MAUI PUNCH or CAPRI SUN MAUI PUNCH as "geographically suggestive flavor designations" causes its marks and applicant's mark to have similar commercial impressions. The mark MAUI PUNCH has the geographic significance of Hawaii, while CAPRI SUN MAUI PUNCH will either conjure up the combination of Italy and Hawaii, or will seem to be merely an odd juxtaposition of geographic places. In neither case do these marks suggest the "feeling of the west coast of the United States," as opposer suggests.

Opposer also points to its flavor designation PACIFIC COOLER in support of its position that its marks refer to

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<sup>25</sup> The Board may take judicial notice of dictionary definitions. **University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.**, 213 USPQ 594 (TTAB 1982), *aff'd.* 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

the west coast of the United States and particularly to California. It is manifest that there are significant differences between the mark CALIFORNIA SUN and the mark PACIFIC COOLER per se. Nor do we find that when PACIFIC COOLER is used as a flavor designation with CAPRI SUN, the overall impression of these two marks conjures up California, such that CALIFORNIA SUN and CAPRI SUN PACIFIC COOLER can be said to be similar in appearance, pronunciation, connotation or commercial impression. While we recognize that the state of California is located on the Pacific Ocean, "Pacific" is not the equivalent of "California." To the extent that the flavor designation PACIFIC COOLER on opposer's CAPRI SUN juice packages would have a geographic connotation, it would be of the Pacific Ocean and not California per se. Moreover, because this flavor designation is used with CAPRI SUN, it will, in the same manner as CAPRI SUN MAUI PUNCH, either conjure up the combination of Italy and the Pacific Ocean, or will seem to be merely an odd juxtaposition of geographic places.

Because of the significant differences in the marks, we find that applicant's use of CALIFORNIA SUN for cola and other carbonated soda beverages is not likely to cause confusion with opposer's marks for its identified goods. While we have considered all the other relevant duPont factors, in this case we find that the differences between the marks are so great that this factor outweighs all the

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others. See **Kellogg Company v. Pack-em Enterprises, Inc.**,  
951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

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Decision: The opposition is dismissed.

R. L. Simms

E. J. Seeherman

C. E. Walters  
Administrative Trademark Judges  
Trademark Trial and Appeal Board